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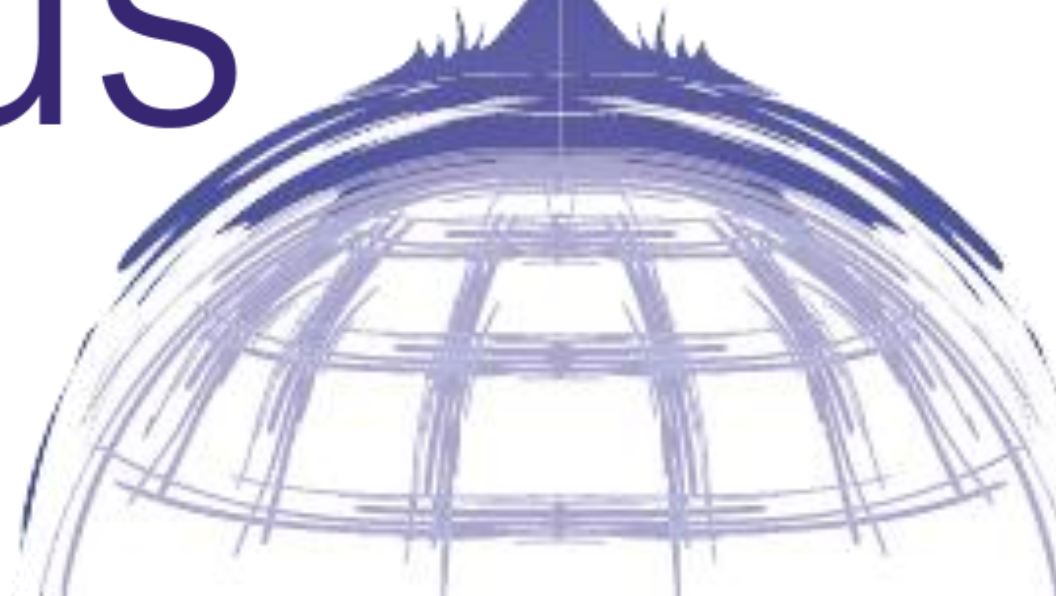


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Articles

Assessment of the inventive step in India

By Eeshita Das and Archana Viswanathan

The first article in this issue of IPR Amicus examines a recent Delhi High Court decision against an order passed by the Controller of Patents and Designs refusing the grant of the Appellant's patent application for lacking inventive step. The article further highlights the fundamental principles discussed by the High Court for analysis of an 'inventive step' in India. The article notes how the High Court discussed the various approaches available for determining the inventive step which were followed across various jurisdictions, and laid down some of the fundamental principles for analysing inventive step. The authors note that the High Court established that simplicity in the inventive concept of an invention cannot be the sole basis for rejecting a patent application. Additionally, the time that has passed between the publication of the cited documents and the filing of a patent application is also an important factor to be considered. According to them, improved approach would be for Controllers and Examiners to judiciously follow the guidelines and assess the inventiveness of an invention considering all the important factors

Assessment of the inventive step in India

By Eeshita Das and Archana Viswanathan

Introduction

This article examines the decision made by the Hon'ble High Court of Delhi (**'High Court'**) on an appeal (2022/DHC/004697) filed under Section 117A(2) of the Patents Act, 1970 (**'Patents Act'**). The appeal was filed by Avery Dennison Corporation (**'Appellant'**) seeking to set aside an order passed by the Controller of Patents and Designs (**'Respondent'**) refusing the grant of the Appellant's patent application for lacking inventive step. The High Court, after considering the facts of the case, decided that the assessment of the claimed invention by the Respondent was erroneous and directed that the patent application may proceed for a grant. The article further highlights the fundamental principles discussed by the High Court for analysis of an 'inventive step' in India.

Facts of the case

The Appellant filed a patent application titled 'Notched Fastener' bearing an application number 5160/DELNP/2013 (**'Application'**), which is a National Phase application arising out of PCT application number PCT/US2011/062189. A First Examination Report (**'FER'**) with a statement of objections was issued, wherein the Respondent primarily objected to the inventive step of the invention claimed in the Application under Section 2(1)(ja) of the Patents Act in view of D1: GB2053296A (published on 4 February

1981), D2: WO 94/10044A1 (published on 11 May 1994), and D3: US4456123A (published on 26 June 1984).

The Appellant filed its response to the FER along with amended claims. It was argued that the inventive step of the Application was based on four features of the fastener; namely, the creation of the notch, the shape of the notch, the position of the notch and the direction of the notch in relation to the cross-pieces; while the technical advancement of the Application lay in consistent cutting or severing of the fasteners from the fastener stock.

However, the Respondent maintained the objection to the inventive step by issuing a Hearing Notice, following which a hearing was conducted and thereafter written submissions were filed by the Appellant.

Thereafter, the Respondent refused to grant the Application on the ground of lack of an inventive step while specifically relying on documents D2 and D3. Aggrieved by the decision of the Respondent, the Appellant filed the appeal, seeking to set aside the refusal order issued by the Respondent.

While arguing the matter, the Appellant's counsel relied on the specification of the Application, the written submission and the amended claims therein to establish the inventive step of the invention, arguing that the technical advancement of the invention lies in overcoming the variation in the length of the fastener being cut due to elasticity, which is achieved by using the claimed

notches. The counter argument provided by the Respondent was that from the disclosure of D2, a person skilled in the art can easily arrive at the claimed invention by merely changing the shape of the notch described in D2 which constitutes a workshop improvement, placing reliance on the impugned order. Therefore, the invention does not involve an inventive step.

The main issue before the High Court was whether there was a shortfall of an inventive step given the disclosures made in the documents D1 to D3, specifically D2 and D3.

Emergence of various approaches towards Inventive Step analysis

The High Court, while making a decision on the matter, discussed the various approaches available for determining the inventive step which were followed across various jurisdictions, mentioning the following in particular:

1. **'Obvious to try' approach:** Rather than a test for analysing the inventive step itself, this is a rationale used to support the finding of lack of inventive step. The examination guidelines for determining obviousness under 35 U.S.C. 103 as issued by the United States Patent and Trademark Office (USPTO) defines 'obvious to try' as "*choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;*", in view of the Supreme Court's decision on *KSR International Co.*

v. Teleflex Inc. (2007)¹ wherein the Supreme Court held that 'obvious to try' was a valid rationale for an obviousness finding.

2. **Problem/solution approach:** This approach is primarily employed by the European Patent Office (EPO), and it involves three stages, as listed under the guidelines for examination in the EPO, namely, (i) *determining the "closest prior art"*, (ii) *establishing the "objective technical problem" to be solved, and (iii) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to a person skilled in the art.* The Division Bench in *Roche v. Cipla* (2016)² also discusses this test.
3. **Could-would approach:** This approach has also been listed under the guidelines for examination in the EPO, as part of the third stage of the problem/solution approach (considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person). The question arises that whether there is any teaching in the prior art as a whole that **would** and not simply **could** have prompted a skilled person, with the knowledge of the objective technical problem, to either modify or adapt the closest prior art to arrive at the subject matter of the claims.

¹ *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. 398, 82 USPQ2d 1385 (2007); <https://supreme.justia.com/cases/federal/us/550/398/>

² *F. Hoffmann-La Roche Ltd. and Ors. v. Cipla Ltd.*, 2016(65) PTC 1 (Del); <https://indiankanoon.org/doc/131401110/>

4. Teaching-Suggestion-Motivation (TSM) test: This test originated in the USA and was set forth in *Graham v. John Deere Co.* (1966)³, according to which the factual inquiries to be addressed in determining obviousness are, namely, determining the scope and content of the prior art; ascertaining the differences between the claimed invention and the prior art; and resolving the level of ordinary skill in the pertinent art. The US Supreme Court's decision in *KSR International Co. v. Teleflex Inc.*¹ provided further flexibility to the application of this test for assessing the obviousness of an invention.

The High Court further lays down a timeline on how the approaches towards assessment of inventive step evolved over the years and in different circumstances on a case-to-case basis, additionally discussing the five-step approach for assessing inventive step which is followed in India, as prescribed by the order of the Division Bench in *Roche v. Cipla* (2016)², that includes the avoidance of hindsight analysis while assessing the inventive step of an invention. With regards to hindsight analysis, an important case which was also discussed was the *Bristol-Myers Squibb Holdings Ireland Unlimited Company & Ors. v. BDR Pharmaceuticals International Pvt. Ltd. & Anr.*; CS(COMM) 27/2020⁴, wherein the High Court ruled that the party claiming obviousness must be able to demonstrate not only the prior art exists but how the person of ordinary skill in the art would have been led to combine the relevant

components from the mosaic of prior art, without prior knowledge of the invention.

The High Court then discussed the pivotal four-step test for determining inventive step laid down by the House of Lords in *Windsurfing International Inc. v. Tabur Marine Ltd* (1985)⁵, wherein the test involved the following steps:

1. *Identifying the inventive concept embodied in the patent application*
2. *Imputing to a normally skilled but unimaginative addressee what was the common general knowledge in the art at the priority date of the application*
3. *Identifying the differences, if any, between the matter cited and the alleged invention*
4. *Deciding whether those differences, viewed without any knowledge of the alleged invention, constituted steps that would have been obvious to the skilled person or whether they required any degree of invention*

The England and Wales Court of Appeals, in the matter of *Pozzoli Spa v. BDMO SA* (2006)⁶ provided further modifications for the test given in *Windsurfing*, followed which the Division Bench of the High Court in the matter of *Roche v. Cipla* (2016)² established the five-step analysis which is now being majorly used to analyse the inventive step of an invention. The High Court also reiterated

³ *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); <https://supreme.justia.com/cases/federal/us/383/1/>

⁴ *Bristol-Myers Squibb Holdings Ireland Unlimited Company & Ors. v. BDR Pharmaceuticals International Pvt. Ltd. & Anr.*; CS(COMM) 27/2020

⁵ *Windsurfing International Inc. v. Tabur Marine Ltd.*, [1985] RPC 59; <https://vlex.co.uk/vid/windsurfing-international-inc-v-792781809>

⁶ *Pozzoli Spa v. BDMO SA*, [2006] EWHC 1398 (Ch); <https://www.casemine.com/judgement/uk/5a8ff74860d03e7f57eaad1e>

that it is important to carry out a proper analysis of the inventive step of an invention, and that merely arriving at a bare conclusion that an invention lacks inventive step would be contrary to Section 2(1)(ja) of the Patents Act, citing *Agriboard International LLC. v. Deputy Controller of Patents & Designs* (2022)⁷.

The High Court impressed upon the fact that all the approaches and tests need to be adapted and applied according to the facts of the case. In certain scenarios, an approach combining more than one test may also be required, depending on the invention and the prior art documents to be analysed. This approach was taken by the UK Supreme Court in *Actavis v. ICOS* (2019)⁸, wherein the Court provided a non-exhaustive list of ten relevant considerations to be made while assessing obviousness.

Decision

The High Court while deciding this case laid down some of the fundamental principles for analysing inventive step, which have been discussed individually hereinbelow:

Simplicity in the invention cannot be a deterrent to patent grant

The High Court emphasized that just because an invention is simple, or that the inventive concept behind it is simple, it should

⁷ *Agriboard International LLC. v. Deputy Controller of Patents & Designs* [C.A.(COMM.IPD-PAT) 4/2022 dated 31st March, 2022]; <https://indiankanoon.org/doc/126889519/>

⁸ *Actavis v. ICOS*, [2019] UKSC 15; <https://www.supremecourt.uk/cases/uksc-2017-0214.html>

not be a reason to prevent the grant of the invention. The High Court took support from the *Vickers v. Siddell* (1890)⁹ case, wherein the House of Lords, when considering simplicity in an invention, noted that if an invention has a simple inventive concept, then during the analysis of the same, one could be deceived into believing that no inventive skill is required to arrive at it. A similar observation was made in the decision of the Privy Council on an appeal from the Supreme Court of Canada in *Pope Appliance Corp. v. Spanish River Pulp & Paper Mills Ltd.* (1929)¹⁰.

Time gap between prior arts and the invention being examined should also be accounted for while analysing obviousness

The High Court also pointed out that if a long time has passed since the publication of the prior art documents and a simple change, which no one had thought of, contributes to a significant technical advancement, then the Court would be inclined to consider the invention as non-obvious. The judgement by the UK Patents Court in *Brugger v. Medic-Aid Ltd.* (1996)¹¹, also shared the same sentiment, stating that the age of a prior art document may be an indication that a development from it is non-obvious, and therefore patentable. Also, *Terrel on Law of Patents* in its 16th

⁹ *Vickers v. Siddell* (1890) 7 R.P.C. 292;

<https://academic.oup.com/rpc/article/7/33/292/1596735>

¹⁰ *Pope Appliance Corp. v. Spanish River Pulp & Paper Mills Ltd.*, (1929) 46 R.P.C. 23; <https://www.casemine.com/judgement/in/56b4961c607dba348f016b84>

¹¹ *Brugger v. Medic-Aid Ltd.*, [1996] R.P.C. 635;

<https://academic.oup.com/rpc/article-abstract/113/19/635/1610508>

Edition propound the point that the age of the prior document is critical in order to ascertain the case of obviousness. Document D2, which is the closest prior art, was published in 1994, while the Application was filed in 2013, with the corresponding PCT application filed in 2011. This resulted in a time gap of more than 18 years between the Application and the prior art documents. The complete specification of the Application discussed the drawbacks of the prior art and highlighted how the invention of the Application is advantageous over the same. In the time gap of almost 18 years, there was no other prior art document which suggested the changes as claimed in the Application. The time gap with respect to D1 and D3 is even larger since both D1 and D3 were published before D2. In addition, the High Court noted that the corresponding patent applications had been granted in other jurisdictions, such as, USA, Japan, South Korea and China, which also establishes the inventive merit of the claimed invention. Accordingly, as there was a technical advancement in the invention of the Application over the cited documents, the High Court concluded that the invention was inventive over D1-D3 and allowed the appeal, thus allowing the patent to mature to a grant.

Conclusion

The High Court's decision in this matter has established that simplicity in the inventive concept of an invention cannot be the sole basis for rejecting a patent application. Additionally, the time that has passed between the publication of the cited documents and the filing of a patent application is also an important factor to be considered while analysing the inventive step of an invention. At the time of examining the Application itself, if the Controller had taken these facts into account, the case could have proceeded to a grant much earlier, thus saving the time and resources spent by the Appellant in pursuing the appeal. Deficiencies in analysing the inventive step correctly by the Controller, more often than not, results in refusal of patent applications, thereby forcing patent applicants to file appeals. This is despite the fact that the corresponding applications in other jurisdictions have been granted. In order to avoid such unfavourable circumstances, an improved approach would be for Controllers and Examiners to judiciously follow the guidelines and assess the inventiveness of an invention considering all the important factors.

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Do the trademarks provisions permit registrar to transfer pending petitions to IPD of the Court?

By **Anoop Verma** and **R. Rajalakshmi**

The second article in this issue of the newsletter discusses another interesting Delhi High Court decision where one of the questions that came up before the IPD, Delhi was whether the Trade Marks Registry can transfer pending rectification/cancellation petitions to the IPD of the respective Hon'ble High Court. The Court observed that while the Trade Marks Act, 1999, the Trade Marks Rules, 2017 and/or Rules of the Delhi High Court Intellectual Property Rights Division Rules, 2022 ('IPD Rules') do not categorically govern the powers of the court to direct the Registrar of Trademarks to transfer any pending matters to the court, as per Rule 26 of the IPD Rules, if the court thinks it is necessary to consolidate and hear together all the matters related to the same or related subject matter before the IPD, it may direct so. Observing that parties to a litigation are also involved in cross actions before the Trade Marks Registry, the authors believe that decision of the High Court of Delhi provides a clarification and resolution to such a fact scenario in order to do complete justice and ensure speedy disposal of cases.

Do the trademarks provisions permit registrar to transfer pending petitions to IPD of the Court?

By Anoop Verma and R. Rajalakshmi

Introduction

The abolition of the Intellectual Property Appellate Board (IPAB) gave rise to a plethora of questions on the next best forum available to right holders. The Intellectual Property Division (IPD, Delhi) has led the way and demonstrated as to how effectively IP cases can be disposed off and relief(s) moulded to suit particular fact situations.

One of the questions that came up recently before the IPD, Delhi was whether the Trade Marks Registry can transfer pending rectification/cancellation petitions to the IPD of the respective Hon'ble High Court or not under the ambit of the Trade Marks Act, 1999 ('**Act**') read with the Trade Marks Rules, 2017 ('**TM Rules**')?

The case in point is *Jumeirah Beach Resort LLC v. Designarch Infrastructure Pvt. Ltd. & Anr.*¹², where the IPD of the Delhi High Court analyzed Section 125 of the Trade Marks Act, 1999 and Rule 26 of the IPD Rules in detail. The relevant provisions read as below.

"Section 125: Application for rectification of register to be made to Appellate Board in certain cases

- (1) *Where in a suit for infringement of a registered trade mark the validity of the registration of the plaintiff's trade mark is questioned by the defendant or where in any such suit the defendant raises a defence under clause (e) of sub-section (2) of section 30 and the plaintiff questions the validity of the registration of the defendant's trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined only on an application for the rectification of the register and, notwithstanding anything contained in section 47 or section 57, such application shall be made to the Appellate Board and not to the Registrar.*
- (2) *Subject to the provisions of sub-section (1), where an application for rectification of the register is made to the Registrar under section 47 or section 57, the Registrar may, if he thinks fit, refer the application at any stage of the proceedings to the Appellate Board."*

Rule 26 of the IPD Rules reads as follows:

"Consolidation of IPR subject matters or cases or proceedings or disputes – Where there are multiple

¹² C.O. (COMM.IPD-TM) 124/2022; C.O. (COMM.IPD-TM) 315/2022; CS(COMM) 124/2021 and I.A. 19885/2022

proceedings relating to the same or related IPR subject matter, irrespective of whether the said proceedings are between the same parties or not, the Court shall have the power and the discretion, wherever appropriate, to direct consolidation of proceedings, hearings, and also to direct consolidated recording of evidence/common trial and consolidated adjudication. If the Court is of the opinion that any matter pending before a Commercial Court is to be consolidated with a matter pending before the IPD, it may exercise powers of transfer under Section 24, Code of Civil Procedure, 1908 for transfer and consolidation of such matter to itself."

The Court, upon reading Rule 26, held that *"the intent and purpose of Order XXVI, howsoever it may be worded, is obviously to ensure that proceedings relating to the same or relate IPR subject matters are heard together and that, if any such proceeding(s) are pending before the IPD of this Court, all connected and related proceedings should also be taken up by it"*

The Court thus formulated two questions:

- a. whether the Registrar of Trademarks is, under the purview of the Act or the TM Rules, empowered to transfer the pending petition to the IPD of the High Court of Delhi; and
- b. whether the IPD is equipped to direct the Registrar of Trademarks to transfer the matters to itself in view of the same or related subject matters.

By its order dated 28 November 2022, the Court held that the Registrar of Trademarks under the purview of Section 125 of the

Act is empowered to refer a matter to the IPAB at any stage since the jurisdiction, authority, and powers of the IPAB have now been transferred to the High Court (of respective jurisdictions).

In addition to the above, the Hon'ble Court also held that while the Trade Marks Act, 1999, the Trade Marks Rules, 2017 and/or Rules of the Delhi High Court Intellectual Property Rights Division Rules, 2022 ('**IPD Rules**') do not categorically govern the powers of the court to direct the Registrar of Trademarks to transfer any pending matters to the court, it is obvious that as per Rule 26 of the IPD Rules, if the court thinks it is necessary to consolidate and hear together all the matters related to the same or related subject matter before the IPD, it may direct so. Given this, it is apparent that the IPD of the High Court of Delhi by virtue of the power conferred under Rule 26 of the IPD Rules, can direct the Registrar of Trademarks to transfer any matter for complete resolution of the matter.

Conclusion

It has often been seen that parties to a litigation are also involved in cross actions before the Trade Marks Registry. Such actions often lead to delay in holistic adjudication of all issues between them. The decision of the High Court of Delhi is aimed to provide a clarification and resolution to such a fact scenario in order to do complete justice and ensure speedy disposal of cases.

[The authors are Senior Associate and Partner, respectively, in IPR practice at Lakshmikumaran & Sridharan, New Delhi]



Ratio Decidendi

- Seeking relief on basis of IP Rights is action in personam – Bombay High Court
- Trademarks – Application cannot be said to be abandoned only because evidence in support of opposition received three days late – Rule 45 not happily worded – Delhi High Court
- Trademarks – Rectification – Rights under Section 124(b)(ii) are not in derogation of those available under Section 57 – Delhi High Court

Seeking relief on basis of IP Rights is action in personam

The Bombay High Court has reiterated that the Plaintiff claiming infringement of its registered mark is required to claim reliefs in the context of specific instances of infringement, relatable to individuals against whom orders can be passed by the Court. According to the Court, even in a 'John-Doe action', specific instance of infringement must be identified, although there may be lack of information regarding the details of the individuals who are responsible for such infringement. Noting that in respect of rights in Intellectual Property Law, every time the Plaintiff initiates an action and seeks remedy, it is an action *in personam* and not *in rem*, the Court recalled its earlier order wherein it had granted an omnibus direction to the Domain Name Registrars (DNRs) not to register any domain name containing the Plaintiff's mark 'SWIGGY' without prior authorization of the Plaintiff. The Court hence reiterated that each instance of infringement would require the Plaintiff to rush to the Court for a direction in separate proceedings against specific parties.

The Court however rejected the contention of the DNRs that since the entire process of registration is entirely automated and machine driven, there is no way in which they can prevent the registration of a domain name containing the registered trademark of another entity (Plaintiff here). Observing that the DNRs would have to utilize an alternative algorithm to ensure compliance, the Court agreed with the Plaintiff's plea that DNR was avoiding doing so merely because it may have to bear some financial burden in that regard.

[*GoDaddy.com LLC v. Bundl Technologies Private Limited* – Decision dated 23 January 2023 in Commercial IP Suit (Lodging) No. 26549 of 2022, Bombay High Court]

Trademarks – Application cannot be said to be abandoned only because evidence in support of opposition received three days late – Rule 45 not happily worded

Observing that right to oppose registration of a trademark is just as sacrosanct as the right to seek registration, the Delhi High Court has held that once the application for opposition had actually been filed, it would be unfair to treat the opposition as having been abandoned only because the evidence in support of the opposition was received three days late. The Court noted that, *prima facie*, the Appellant-opponent did make efforts to 'leave' the evidence in support of the opposition with the office of the learned Registrar within the time stipulated in Rule 45(1) of the Trade Marks Rules, 2017. It observed that while procedural provisions are required to be accorded their due deference, they cannot be interpreted so rigidly as to result in evisceration of substantive rights vested in the citizens.

The Court noted that attempts at e-filing of the evidence in support of the Appellant's objections, on the last day of the prescribed time period, could not succeed as the website of the Registrar of Trademarks was non-functional, and that the objections were sent by courier the very next day. According to the Court, such an attempt, would fall within the broad embrace of the expression

'made, served, left, sent or paid to the appropriate office of the Trademarks Registry', as employed in Rule 8 of the Trade Marks Rules. It also observed that Appellant did not exhibit any callous or negligent indolence.

It may be noted that the High Court also stated that Rule 45 is very unhappily worded as it uses the expression "leave with the Registrar", to which no legal interpretation can possibly be given. The Court further stated that unfortunately, Rule 8 of the Trade Mark Rules is just as nebulous as Rule 45. [*V-Guard Industries Ltd. v. Registrar of Trademarks* – Judgement dated 6 January 2023 in C.A.(COMM.IPD-TM) 39/2022, Delhi High Court]

Trademarks – Rectification – Rights under Section 124(b)(ii) are not in derogation of those available under Section 57

The Delhi High Court has rejected the plea that Section 57 of the Trade Marks Act, 1999 ceases to be available to a Defendant in a suit, the moment the Defendant raises a plea of invalidity of the Plaintiff's trademark as a ground of defence. The High Court was of

the view that the Supreme Court decision in the Patel Field Marshal Agencies case indicated the contrary.

According to it, the right conferred on the Defendant in an infringement suit, to move the learned IPAB, or the High Court, for rectification of the register of marks is an independent right, which is independent of other rights available under the Trade Marks Act for the same purpose. It stated that while the right under Section 57, for cancellation of a mark and rectification of the register remains available, the Defendant would acquire an independent right under Clause (ii) of Section 124. The Court clarified that the right available under Clause (ii) of the second part of Section 124 is not in derogation of the right available under Section 57 but is in addition to the said right.

The High Court also noted that there is no clause in Section 57 which makes it subject to any other provision in the Trade Marks Act, and nor does one find in Section 124, any *non obstante* clause which would accord it pre-eminence over other provisions in the Trade Marks Act. [*Anubhav Jain v. Satish Kumar Jain* – Judgement dated 9 January 2023 in C.O. (COMM.IPD-TM) 55/2021, Delhi High Court]



News Nuggets

- Patents – Objections to be raised in the notice of hearing itself and not at time of hearing
- Patents – No obviousness merely because individual parts taken separately are known
- Trademarks – Similarity between device mark and word mark
- Trademarks – Classification of goods and services – Discrepancy between Section 7(1) of Trade Marks Act and Rule 20(1) of Trade Marks Rules
- Designs – Communication of computer image which was never applied to physical article do not constitute prior publication
- Patents – Amendments to claim when need to be allowed
- Trademarks – Application of registration as design – Effect on suit pattern
- Patents – Amendment of patent specification at appellate stage, permissible

Patents – Objections to be raised in the notice of hearing itself and not at time of hearing


The Delhi High Court has held that it is incumbent upon the Respondents to raise the objections under Section 3(f) of the Patents Act, 1970, in the notice of hearing itself. The Court was of the view that although the Appellant had submitted written submissions subsequent to the hearing and had not given any response *qua* Section 3(f), that does not absolve the Respondent of its obligations under the Circular dated 21 September 2011 to communicate objections prior to the hearing and provide reasonable opportunity to the applicant/ Appellant. The Circular lists out obligations of Controller on receipt of objections from Examiner. The Court in *Perkinelmer Health Sciences Inc. and Ors. v. Controller of Patents* [Order dated 4 January 2023] also stated that Appellant ought to have been made aware of all grounds of objection before the hearing and afforded sufficient opportunity to contest the same at the time of hearing.

Patents – No obviousness merely because individual parts taken separately are known

The Calcutta High Court has reiterated that invention cannot be termed as obvious, merely because individual parts of the claim taken separately are known or might be found to be obvious. It stated that in determining inventive steps, the invention should be considered as a whole. The impugned order passed by the Assistant Controller of Patents and Designs, rejecting the Appellant's patent application, was thus held to be erroneous inasmuch as it dissected

the subject application into two isolated elements. The matter in *Groz-Beckert KG v. Union of India* [judgement dated 18 January 2023] was remanded back to consider the application of the Appellant afresh.

Trademarks – Similarity between device mark and word mark

The Delhi High Court has held that Petitioner's  device mark (containing a pictorial depiction of a pizza, with the word 'Galleria' alongside it) is similar to the 'PIZZA GALLERIA' word mark of Respondent. Observing that both were used in respect of goods or services which were not only similar but identical, the Court was of the view that the likelihood of confusion among persons who wished to visit the eating outlets cannot be gainsaid. Noting that 'Galleria' was a term more often associated with art, and not a term of common usage for restaurants or eating joints, the Court in *Raj Kumar Sharma v. Sandeep Kumar* [Judgement dated 30 January 2023] held that an unwary consumer is much more likely to regard the former device mark as a pictorial manifestation of the latter word mark.

Trademarks – Classification of goods and services – Discrepancy between Section 7(1) of Trade Marks Act and Rule 20(1) of Trade Marks Rules

The Delhi High Court has requested the Registrar of Trademarks to examine the discrepancy between Section 7(1) of the Trade Marks Act, 1999 and Rule 20(1) of the Trade Marks Rules, 2017. The Court

in this regard noted that while Section 7(1) makes the NICE classification applicable for classification of goods and services under the Trade Marks Act only *as far as may be*, Rule 20(1) makes it *mandatory* for the classification of goods and services to abide by the NICE classification. The observations were made in the matter of *Raj Kumar Sharma v. Sandeep Kumar* [Judgement dated 30 January 2023].

Designs – Communication of computer image which was never applied to physical article do not constitute prior publication

The Delhi High Court has dismissed a review petition filed against its earlier decision holding that the mere communication, by one person to the another of a computer image, which either prior to such communication or even thereafter, was never applied to any physical article, cannot constitute prior publication within the meaning of Section 4(b) of the Designs Act. Relying on the Full Bench decision of the Court in the case of *Reckitt Benckiser*, the petitioner had argued that the finding was contrary to the full bench decision. The High Court in *Novateur Electrical & Digital Systems Pvt. Ltd. v. V-Guard Industries Ltd.* [Judgement dated 17 January 2023] was of the view that the full bench decision was not directly seized with the issue of the interpretation of the expression 'design' *vis-à-vis* the definition of the expression 'articles' in Section 2 much less to the applicability of the said definitions to Section 4 of the Designs Act.

Patents – Amendments to claim when need to be allowed

The Delhi High Court has held that where the amendment to the patent claim merely sought patenting of claims relating to the very same implants, for the method of use of which the claims had originally been filed, the Controller should allow the amendments, and needs to examine the claims as so amended, and their patentability, on merits. The Court in *Allergan Inc. v. Controller of Patents* [Judgement dated 20 January 2023] was of the view that the Controller should not have shut out the Appellant merely on the tenuous ground that the Appellant was not entitled to amend its claims in view of Section 59(1) of the Patents Act.

Trademarks – Application of registration as design – Effect on suit pattern

The Delhi High Court has held that it cannot, at the *prima facie* stage, treat the fact that the Plaintiff had at one stage applied for registration of the suit pattern as a design as a ground to non-suit the Plaintiff from interlocutory relief. The issue involved alleged infringement of tread pattern on tyres. The Court in *Apollo Tyres Limited v. Pioneer Trading Corporation* [Judgement dated 19 December 2022] held that registration of a tread pattern which is nearly identical to the suit pattern as a design would not *ipso facto* operate to disentitle the suit pattern from being regarded as a 'trademark' within the meaning of the Trade Marks Act, 1999.

Patents – Amendment of patent specification at appellate stage, permissible

The Delhi High Court has observed that there is no provision in the Patents Act which specifically bars the amendment of a patent specification at the appellate stage. Noting that amendment of patent applications and specifications are covered in Chapter X (Sections 57 to 59) of the Act, the Court observed that amendment application can be made even after the grant of patent and can even be allowed in the proceedings before the High Court at the

stage of revocation of a patent. It also, in this regard, was of the view that if the Controller has been given the power to direct an amendment to the patent application, the High Court, which is sitting in appeal over the decision of the Controller, should also have similar powers to direct the patent applicant to amend claims to its satisfaction. The High Court in *Societe Des Produits Nestle SA v. Controller of Patents and Design* [Judgement dated 3 February 2023] also stated that in appellate proceedings challenging the refusal of grant of a patent, questions of facts need to be re-examined comprehensively and therefore, a liberal view has to be taken with regard to amendment of claims.

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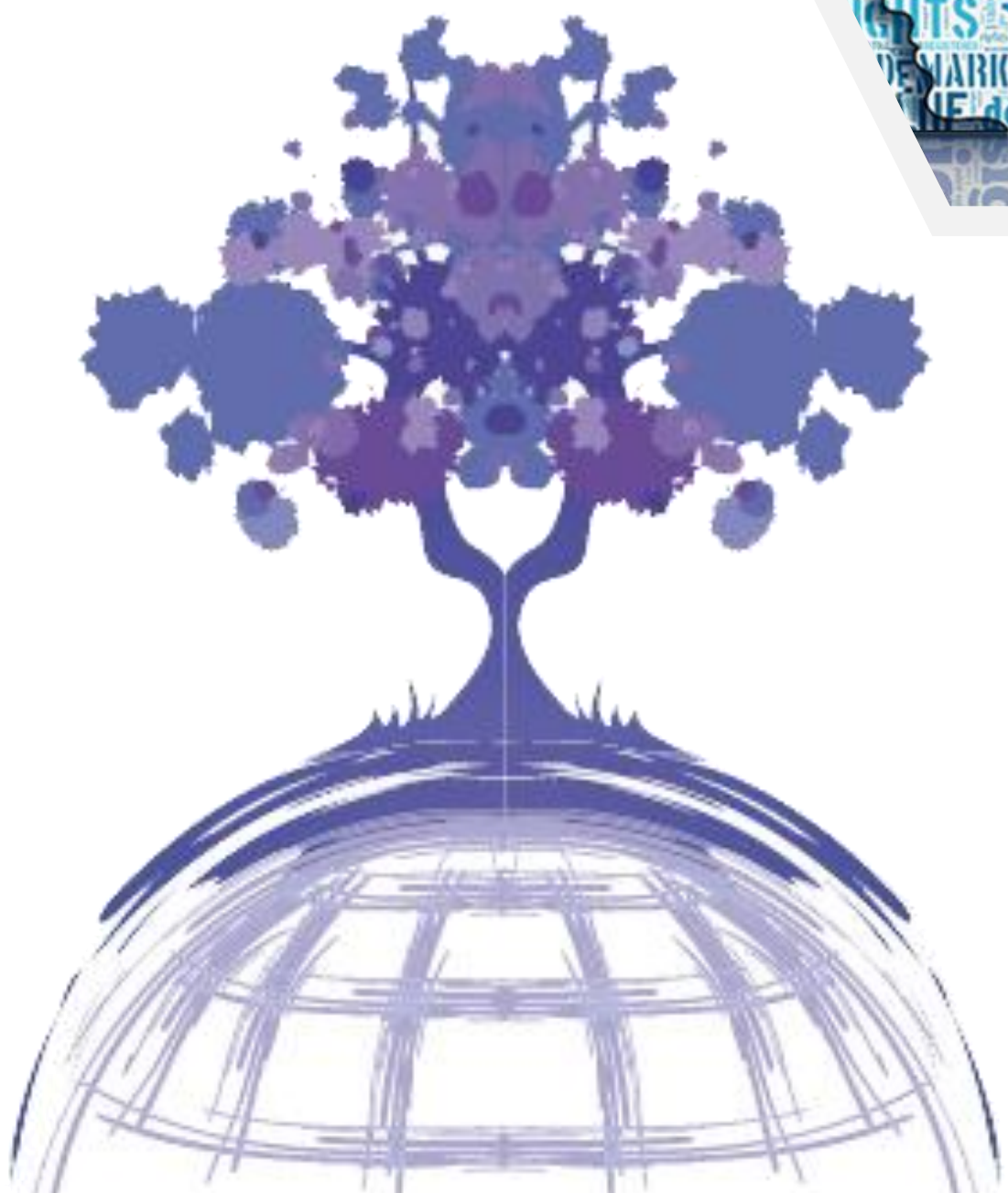
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