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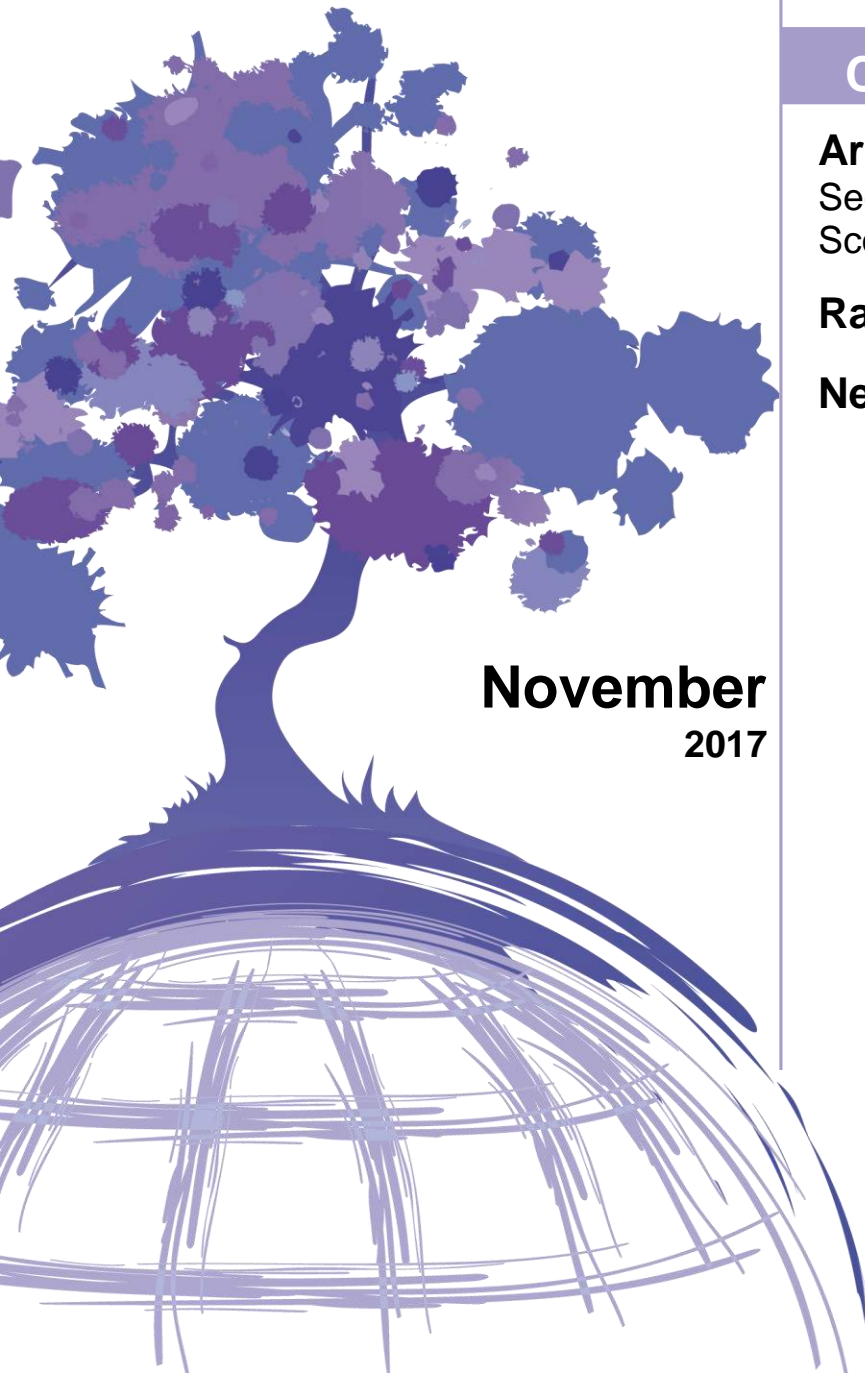
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Article

Section 59 of the Patents Act, 1970 – Scope of amendments

By Aruna Verma

Introduction

Amendments of patent applications may involve amending any portion of either the complete specification, or any information pertaining to such patent application. Such amendments may be made at any time during a life cycle of a patent application. These amendments may be made either voluntarily or may be made to overcome objections raised by the Controller, for example through a First Examination Report (FER). The manner in which such amendments may be made are covered in Sections 57 and 59 of the Patents Act, 1970¹ (the Act). Besides prescribing the formal procedure for making such amendments, the aforesaid provisions also lay down various conditions that need to be fulfilled for such amendments to be permissible.

Historical Background & Jurisprudence

The amendment provisions have their roots in the *Indian Patents and Designs Act, 1911*², which empowered an Applicant or a patentee to amend a specification ‘at any time’ by submitting a written request to the Controller. The Ayyangar Committee Report³ (the Report), noted that where the invention which emerges as a result of an amendment is different from that which was the subject matter of the specification as originally accepted, such an amendment should not be permitted. However, the Report suggested

certain changes in the wordings of the statute to bring in clarity to indicate possible amendments before and after acceptance or grant of the patent. The recommendations of the Report formed the basis of Sections 57-59 of the Act.

Scope of amendments

Section 57 of the Act provides the Applicant with an opportunity to amend an application for a patent, the complete specification, or any related document. Such amendments may be made by the Applicant, of his own accord or to comply with the directions of the Controller, at any time. It is imperative to note that the request for amendment could only be made in relation to applications that are in existence and not for applications or patents that have lapsed⁴.

Section 59 of the Act basically provides that the amendments may be made:

1. By way of disclaimer, or
2. By way of correction, or
3. By way of explanation

Thus, Section 59(1) can be broadly considered as having two parts. The first part of Section 59(1) mandates that the amendments either in relation to specification or claims can be made if they are by way of disclaimer, correction or explanation. In the second part, Section 59(1) further proposes additional conditions, namely:

1. No amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance

¹ *The Patents Act 1970*, as amended by the *Patents (Amendment) Act 2005*

² *Indian Patents and Designs Act, 1911* at Section 17

³ Shri Justice N. Rajagopala Ayyangar, Report on the Revision of the Patents Law (September 1959)

⁴ *Nippon Steel vs Union of India*

disclosed or shown in the specification before the amendment, or

2. Any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

The above-mentioned conditions as such are not additional conditions but have to be read in conjunction with the conditions laid down in the first part. More specifically, the latter portion of Section 59 as such provides the conditions which such amendments (i.e., effected by way of disclaimer, correction or explanation) must conform to. This line of interpretation has been laid down by courts also.

In case of *Enercon (India) v Alloys Wobben*⁵, the Intellectual Property Appellate Board (IPAB) rejected a request made by the Respondent for amending the claims. The IPAB in their decision held that the conditions provided in the second part of section 59 is to be read with the first part. This is to say, that even though certain amendments are made (say by way of correction), the permissibility of the amendments has to be assessed vis-à-vis the conditions laid down in the second part of Section 59. It is likely that the aspect of scope of permissible amendments, when discussed before higher forums would yield a similar result. Until then, it can be inferred that the amendments even when performed by way of correction, shall satisfy the second part of section 59.

The position with respect to interdependency of the two parts of Section 59(1) was also recognized in case of *Spice Mobiles and Another v Somasundaram Ramkumar and Others*⁶. In this case, the IPAB observed that the additional descriptive material was added during the

prosecution. The IPAB applied various tests and rejected the amendments made to the description by way of explanation. The IPAB observed that the additional descriptive material was not disclosed in the specification even implicitly. Further, the IPAB analyzed the purpose of Section 57(6) and held that the purpose is “*not to permit an Applicant to file an application which is defective in its description of the invention, such that the Applicant may subsequently make good that defect by providing additional descriptive material*”. Thus, the IPAB maintained that the various conditions in Section 59 have to be read as a whole.

Section 59(1) also provides that when any amendments are made to the claims, such amendments should fall within the scope of the originally filed claims. In patent application number 2584/KOLNP/2007⁷, the Controller held that the features introduced in the newly added claims did not fall within the scope of the originally filed claims and thus such amendments cannot be considered within the limitations imposed in Section 59, i.e., such amendments are neither by way of correction, explanation, or disclaimer.

Conclusion

An Applicant therefore needs to exercise utmost care while amending a patent application, at any stage. The amendments should be done through the permissible ways as provided in Section 59 and also should not bring in new subject matter or widen the scope of the originally filed application.

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⁵ Order No. 174 of 2013

⁶ Order No. 140 of 2012

⁷ 2584/KOLNP/2007 - Controller's Decision in December 2013



Ratio decidendi

Mere addition of suffix or prefix to a mark does not remove likelihood of confusion

The appellant was aggrieved by the order of permanent injunction passed in favour of respondent who runs fast food restaurant and was using the name 'Adiga', 'Vasudev Adiga' and various other combinations with 'Adiga'. The respondent was prior user of the unregistered trademark (since 1993) and sought to register the same in 2004 when he discovered that the appellant was selling sweets in under the brand 'Adiga Sweets'. The High Court stated that while examining the claim of passing off in case of an unregistered trademark, due weightage has to be given *inter alia* to similarity between marks including phonetic similarity, nature of goods etc. It quoted from various studies and articles on the psychological impact of confusion in trademarks that generally a consumer would rely on pattern recognition and if sufficient number of features represented in the incoming information match the pattern of features of a pre-existing cognitive network, a consumer may associate the mark in front of him with another. Moreover, the fast food restaurant was also selling sweets. The High Court upheld the order of permanent injunction reasoning that mere addition of prefix or suffix to the words common to both marks cannot rule out confusion. [*Adiga Sweets v. Vasudev Adiga Fast Foods P Ltd*, Judgement dated 9-11-2017, Karnataka High Court]

No claim of exclusivity lies by use of mark similar to registered trademark as descriptive word

The plaintiff was registered proprietor of marks 'Swadi' and 'Swadisht' in respect of rice. It used the word 'Swaad' as part of its tagline. All three

words denote taste and were challenged as being descriptive, generic and ineligible for any claim of exclusivity. The plaintiff argued that the mark 'Swad' had been used by its predecessor and by long extensive use, it had acquired a secondary meaning. However, the Court held that since 'Swad/Swaad' was a generic term and there were many traders in rice using the mark, no claim for exclusivity could lie with the plaintiff. Moreover, the word 'Swaad' was not registered as a trade mark and it was used as common descriptive adjective. [*Jain Riceland P Ltd. v. Sagar Overseas*, Judgement dated 31-10-2017, Delhi High Court]

Shape marks serving as indication of origin

At issue was the invalidation of trademark, namely the shape of London taxi and its revocation for non-use. According to the appellants, the shape of the taxi which was recognised as licensed London taxi was distinctive and served as an indication of the origin of goods. Over the years the appellant had made minor changes to the shape but continued to advertise the taxis as the licensed London taxi. The respondents sought to introduce taxis (Metrocab) with some similar features and a host of distinct features. The appellant alleged that this amounted to infringement of its registered trademark, it would lead to confusion among the consumers both taxi owners and hirers of cabs and, also claimed tort of passing off. However, the Court of Appeal upheld the judgement of the Single Judge both on count of invalidation as well as non-use. The Court held that though the shape was well-recognised as the iconic London taxi, it did not serve as indication of origin. Though the persons who purchased taxis as well

as hirers did associate the shape with that of a licensed taxi, they did not necessarily associate it with the manufacturer of the Taxis. Hence, the shape did not serve as a trademark. Moreover, the alleged infringing shape was quite different from the registered marks and there was no possibility of confusion as to origin of goods. At best, the similarity in shape indicated that the taxi was a licensed London taxi and taking into the account the intended use, the shape (with similar features) amounted to honest use. The Court

thus concluded that even if the appellant could claim that its mark was valid, it would have to tolerate any injury caused by similarity in marks because the use was honest. As regards non-use, the Court held that second hand sales of the taxis after its production had been stopped would not amount to use of trademark. [*The London Taxi Corporation Limited v. Frazer-Nash Research Limited, Ecotive Limited*, 2017 EWCA Civ 1729]



News Nuggets

Indian Patent office commences SMS alert facility for patent applications

Patent applicants and patent agents can receive alerts by Short Messaging Service (SMS) to inform them of the various stages in patent processing. The Indian patent office has operationalised the SMS service early this month. The alerts will indicate the timelines to be adhered to avoid refusal/abandonment of application. Applicants and agent may register/update the mobile numbers to avail this facility through the Comprehensive e-filing portal of the IPO.

WIPO releases World Intellectual Property Report 2017

WIPO released the World Intellectual Property Report 2017 on November 20. The report on intangible capital in global value chains states that intangible capital contributes twice as much as buildings, machinery and other forms of tangible capital to the total value of manufactured goods. In the case of food products, motor vehicles and textiles intangible capital accounted for one half of the income.

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