



# INTELLECTUAL PROPERTY AND TECHNOLOGY LAW UPDATES

S&A IP-Tech

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# PATENT PENDING UNDER THE INDIAN PATENT LAW

*SHILPI KUMARI*

## INTRODUCTION

‘Patent Pending’ means that an inventor has filed a patent application on the invention with the Indian Patent Office, but the IPO has not necessarily patented the invention yet. A primary benefit of patent pending is that it establishes a priority date. Also, provisional patent rights are granted to the inventor/applicant after publication.

In simple terms, ‘Patent Pending’ refers to a patent application (provisional or non-provisional patent application) that is pending before the Patent Office - which means that the application has been filed with the Patent Office and it is pending, as the patent has yet not been granted or issued. ‘Patent Pending’ can also be termed as ‘Patent applied for’.

As soon as the patent application is filed at the Patent Office, the invention can state ‘Patent Pending’. Once the application is submitted for patent, nobody can steal, sell, or use your invention without your permission. If this happens, they are infringing on your patent, assuming it gets issued or granted. However, you cannot sue until the patent gets issued or granted.

## BENEFITS OF ‘PATENT PENDING’

- 1. Establishes a priority date:** The primary benefit of patent pending status is that it establishes a priority date for the inventor.
- 2. Inventors can begin marketing the invention:** After filing the patent application at IPO and establishing patent pending status,

the applicant/inventor can safely market the invention. Also, the inventor can publish a website, demonstrate the invention to others, and offer the invention for sale.

- 3. Warning to competitors:** It also sends a warning to competitors. If they try to copy your product, they may be stopped in the future after you do get your patent.
- 4. Inventor can license and sell the patent application:** Patent pending technology can be licensed or sold. Even if the technology is not patented or licensed, the patent application provides a benefit to the licensee or buyer because it establishes priority.
- 5. Creates prior art:** When a patent application is filed, it becomes prior art for any subsequent patent application filed after your filing date.

## WARNING

A patent is the only way to stop others from infringing on your work or innovation. The sooner you file a patent application, the better. You are protected from ‘patent pending’ infringement from the day your application is submitted.

The applicants enjoy the rights and privileges same as granted patent holders, effective from the date of publication of the patent application. Also, during the pendency of the patent application, the applicant can send a warning letter to potential infringers that the invention used by them is the subject of a pending patent application, and that once the patent is granted,

they would be liable for infringement. The infringer is therefore, liable to pay damages to the patentee for the unauthorized use of the invention from the date of publication, once the patent is legally granted to the applicant.

However, it should be noted that ‘Patent Pending’ status does not give right to sue the infringer or the competitor. If the inventor sees someone who has copied their product, then the inventor can send a stern warning that the inventor has submitted a patent application. However, this warning can be considered just as a notification. Competitors are not liable for patent infringement if the application is merely pending. ‘Patent Pending’ status just gives the provisional rights to the inventor/applicant, these rights are enforceable only after the grant of the patent. However, competitors can, in the future be liable for patent infringement if the following requirements are satisfied:

1. The patent application must have been published under the pre-grant publication rules.
2. The claims in the patent are similar or identical to the claims in the pre-grant publication.
3. The competitor has received warning notice.
4. The patent has been granted.

A pre-grant opposition may be filed on one or more grounds available for the purpose under the patent law. One should, therefore, consider sending a warning letter only when one is very sure about the patentability of pending claims in India. If the applicant is confident that the invention claimed in the patent application can successfully survive a pre-

grant opposition attack, it is prudent to send the warning letter during the pendency of the patent application itself, so that later the applicant can claim damages from the publication date.

This would foreclose the potential infringers’ claim of “innocent infringement” to avoid or mitigate damages. Innocent infringement is an act of infringement caused without knowledge or awareness of such infringement. Therefore, in a suit for patent infringement, damages or account of profit is not granted against the defendant who is able to prove that at the date of infringement, the defendant was unaware of the patent and had no reasonable grounds for believing that the patent existed.

## **CONCLUSION**

‘Patent pending’ protection is one of the confusing aspects of patent pending status under the Indian patent law. The limitation is that there is no guarantee that a ‘patent pending’ invention will result in a patent. A patent applicant has to bear the risk of losing market or business while waiting for a patent to hopefully be granted against the potential for copycat products to come on the market if the patent applicant sells product mentioning the ‘patent pending’ invention while the patent application is awaiting examination and possible issuance into a patent. It is important to note that ‘patent pending’ status does not protect the invention, and the application itself does not provide the inventor or applicant any legal protection per se. The ‘patent pending’ essentially proclaims a notice that the patent process is in motion, and it may provide potential infringers a warning that steps are being taken to protect the invention.

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# REJECTIONS UNDER SECTION 46 AND SECTION 13 OF THE INDIAN PATENT ACT

TUSHAR KOHLI

<sup>1</sup>Recently, in a case a First Examination Report was issued against a patent application, wherein the Patent Office had raised objection under section 46(2) of the Patent Acts, 1970 under the heading “Other Requirements” which recited:

*“It is appearing that the subject matter of the present application is similar with another Indian patent application no. XXXXXXXX. However, according to 46(2) “a patent shall be granted for one invention only”. Therefore, one out of these two applications may be allowed”*

The Applicant for the instant application (Application 1) and the cited application (Application 2) is same and the two applications were filed in a gap of 2 months. Both the applications were standalone applications having different subject matter. The specification of Application 1 neither discloses nor teaches anything related to the subject matter of Application 2 and further does not claim priority from Application 2. Both the applications were examined by the Kolkata office by different Controllers/ Examiners and response to FER for both the applications is awaited.

## STATUTORY PROVISION – SECTION 46 (2)

The rejection for claims in a patent application for having their scope overlapping with that of another patent/application having earlier filing and/or

priority date, amounts to rejection for ‘anticipation’, and section 46(2) may not be a proper statutory provision under which such a rejection can be raised. Section 46 reads as follows:

(1) Every patent shall be in the prescribed form and shall have effect throughout India; and

(2) A patent shall be granted for one invention only:

Provided that it shall not be competent for any person in a suit or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

The first impression on reading the language of section 46(2) is that the section is more directed towards the concept of ‘unity of invention’. The terms making this perception evident are ‘a patent’ and ‘one invention only’ as used therein. Further, from the language of the proviso that, should ‘more than one invention’ be granted ‘one patent’, the same, shall not be a ground for any objection thereon including in any invalidity challenge.

Therefore, section 46(2) provides that in an ordinary course of proceedings, only one invention shall be granted one patent. However, the language of the section leaves a scope for a discretion for the Controller that more than one invention may also be granted one patent. Nowhere it suggests, expressly or impliedly, that a patent shall not be granted for an invention if the subject matter of claims contained in an application is ‘similar’ with another Indian application.

<sup>1</sup> <https://spicyip.com/2020/11/section-462-one-patent-per-invention-or-one-invention-per-patent.html>

On the contrary, clause (b) of section 13 provides a statutory basis for “one patent per invention” as section 46 (2) encourages “one invention per patent” and fails to provide necessary statutory basis for raising the “one patent per invention” rejection.

**“Section 13: Search for anticipation by previous publication and by prior claim.”**

*(1) The examiner to whom an application for a patent is referred under section 12 shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification—*

*(b) is claimed in any claim of any other complete specification published on or after the date of filing of the applicant’s complete specification, being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.”*

**CONCLUSION**

Form the above submissions, it is quite evident that claim rejection for “anticipation” is not a valid ground when raised under section 46(2). Further, any rejection under section 46(2) can only be raised for “unity of invention” alone or in combination with section 10(5).

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# OVERVIEW OF DESIGN PROTECTION IN INDIA

*SHIKHA SRIVASTAVA*

## INTRODUCTION

An industrial design is an intellectual property that is used to protect visual features or appearance of a product that is, shape, color of the product or ornamentation.

The registration and protection of industrial designs in India is administered by the Designs Act, 2000, and corresponding Designs Rules, 2001, which came into force on May 11, 2001, repealing the earlier Act of 1911. The Design Rules, 2001, was further amended by Designs (Amendment) Rules 2008 and Designs (Amendment) Rules 2014. The last amendment in Designs Rules came in force on December 30, 2014, which incorporates a new category of applicants as small entity in addition to natural person and other than small entity.<sup>2</sup>

As per Section 2(d) of the Designs Act, 2000<sup>3</sup>, “design” means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensions or three dimensions or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of section 2 of the Trade and

Merchandise Marks Act, 1958 (43 of 1958) or property mark as defined in section 479 of the Indian Penal Code (45 of 1860) or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957 (14 of 1957).

As per Section 2 (a)5 of the Act, “article” means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately.

## WHO CAN APPLY FOR DESIGN REGISTRATION?

Any person (natural or juridical), claiming to be the proprietor of any new or original design, can file for registration of such design.

## ESSENTIAL REQUIREMENTS FOR DESIGN REGISTRATION

- The design should be new or original.
- It should not be disclosed to the public anywhere by publication.
- It should be distinguishable from known design.
- It should be applicable to an article of manufacture.
- Features must be distinct and visible on a finished article.
- Design must not be obscene or contrary to public order or morality.
- Design should not include any Trade Mark

<sup>2</sup> <https://www.ipindia.gov.in/designs.htm>

<sup>3</sup> <https://www.ipindia.gov.in/writereaddata/images/pdf/act-of-2000.pdf>

or Property Mark or artistic works as defined under the Copyright Act, 1957.

### Importance of registering Design

- A design is what makes a product/article look attractive and appealing to the eyes. It affects customer's choice in selecting a particular product because of its appearance, thereby, enhancing commercial value of the product and also company's brand value.
- Registered design ensures the owner of the design an exclusive right against unauthorized copying or imitation of the design by third parties. This helps to ensure that the design of the product is exclusive to the owner and the customer can at once identify the design of the product as that of the owner.
- Design rights can be sold or licensed which generate revenue for the rights owner.

The concept of industrial design focuses on the appearance of a product and not its technicality or functionality. This means that assuming the content of Pepsi and Coca-Cola beverages were same, Pepsi will not be refused design registration solely because Pepsi produces the same content as that of Coca-Cola. The Patent and Designs Registry (the "Registry") is concerned about the aesthetic design of the bottle i.e., to ensure that Pepsi has not come to register the same type of bottle Coca-Cola uses, since Coca-Cola has already registered its bottle design.<sup>4</sup>

### TERM OF DESIGN REGISTRATION

Design registration is for a term of ten years from the date of registration (in cases where claim to priority

has been allowed, the duration is 10 years from the priority date) which can be extended further up to 5 years upon a request made within the said protection period. Therefore, the total period any design can be registered for protection is 15 years.

**Locarno Agreement** - India became the 57th member of the Locarno Agreement in June 2019. Indian design law has usually/largely followed Locarno Classification (even when India was not a signatory to this agreement). But after the Locarno agreement, articles will be classified in accordance with Locarno system. This will be very beneficial for applicants as now there will be single classification system in India and other countries who are parties to the treaty.

Design is very crucial as it helps in differentiating one's product from its competitor. India has a well-defined system for the registration of industrial designs and is in line with international standards.

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<sup>4</sup> <https://www.mondaq.com/nigeria/trademark/912624/industrial-designs-benefits-of-registration>



# EFFECTS OF USING SYMBOL ® IN INDIA

NEELAM DAHIYA

The symbol ® is generally placed with a trademark to denote it as a registered mark. In India, it is not mandated to use any symbol or expression in order to recognize that a mark is registered. However, in other countries like the USA, the trademark owners may miss-out on some benefits of ownership, if the symbol ® is not used on the packaging of their product.

In India, the use of symbol ® or any other word or expression denoting registration is essentially optional i.e., they are not necessary to enforce the trademarks, though a symbol may be helpful in letting others know about your trademark rights and prevents infringers from taking advantage of not paying damages under Section 135(3)(b) of the Trademarks Act, 1999.

## RESTRICTION

**Section 107(1)** of the Indian Trademarks Act strictly prohibits the use of any representation or expression including the symbol ® with a mark which is unregistered to make it appear as registered. In fact, it is a punishable offence and the person committing the act is liable to be punished with:

1. Imprisonment up to 3 years; or
2. Fine; or
3. Both.<sup>5</sup>

However, **Section 107(3)** provides that where the mark is registered under the law of the country

outside India, the use of the word, symbol or other expression to denote such registration in foreign country is permissible. If a person makes a statement or representation that a mark is registered, without implying that it is registered in India, then the Registrar will not invoke Section 107 if he is satisfied that the mark is in fact registered in another country and that the reference to registration is a reference to such registration in that country.<sup>6</sup>

In other words, where the mark in question is registered under the law of any foreign country, the use of the word “registered” or any other expression conveying the same meaning in relation to such mark is permissible provided it is used in the manner specified in Section 107(3) so as to correctly refer to the fact of its registration abroad. The exception also applies to a trademark registered in a foreign country if it is used only in relation to goods to be exported to that country.

In *Wright Crossley v William Dobbin* (1898) – the defendants who were merchants in Belfast used the words “Trade Mark – Royal – Registered” on one side of their box of baking powder and the words “Manufactured by Royal Banking Powder Company, New York” on the front side. The mark was registered in the USA. It was also registered in the UK but expunged a few weeks before sale and it was held that this was a misrepresentation of the mark as

<sup>5</sup> <https://www.quora.com/Can-I-use-the-registered-trademark-symbol-if-its-not-trademarked-Is-this-illegal>

<sup>6</sup> <https://ipindia.gov.in/writereaddata/images/pdf/proposed-tm-manual-for-comments.pdf>

registered in UK and the defendants were prosecuted under Section 105 of the UK Patents Act 1883.<sup>7</sup>

## **CONCLUSION**

Any representation which does not truly reflect the position or status of the mark will amount to a false representation which is a punishable offence in India. However, the Indian Trademarks Act, allows the use of a word or symbol or other expression to denote the mark registered for the unregistered mark if the said mark is registered in foreign countries and used in the manner specified in Section 107(3) of the Indian Trademarks Act, 1999, so as to clearly and truly refer to the fact of registration abroad and without implying that it is registered in India.

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<sup>7</sup> P. Narayanan

# CHALLENGES FACED WITH TIKTOK/INSTAGRAM CONTENT IN IPR

*PARUL SRIVASTAVA*

TikTok has fast become the killer app dominating the screen time of the new generation. This user-generated short form mobile video app is reportedly valued at \$75 billion, with over 800 million combined downloads from Google Play and the Apple App Store and over 600 million monthly active users in China alone.

Similarly, Instagram has become the go-to standard for sharing photos and videos with your social media contacts. It is owned by Facebook and is used in a similar capacity for publishing and promoting content among your social media circles. Although it has been around for some time, its valuation has now skyrocketed and is estimated to be over \$100 billion.

With ever increasing popularity of Tiktok, Instagram and similar platforms like Snapchat etc. the need of the hour is to identify and establish standards that prevent the platform from orchestrating plagarization of the content, protect existing brands, while at the same time also promote honest content makers allowing them the creative liberty they need to create novel content. One key aspect of these social media giants is that they typically attract a younger crowd (between 18-36 years old) which is also the target audience for many corporate brands. Given the fast pace of competition in today's world, brands need to come up with novel marketing techniques every day to broaden their audience engagement. Hence, as soon as some artist/creator on one of these platforms starts getting popular (aka social media influencer),

they are roped in with these corporate entities to promote their products for marketing. Additionally, these corporate entities also maintain their own social presence on these platforms to promote their brands.

TikTok for example allows a user to publish 15 second video clips that are then available publicly on its platform. Most of the time while creating these videos, users normally use unlicensed music which creates a copyright infringement case with music companies. Consequently, the music industry around the world has been trying to negotiate agreements with TikTok and its parent company, Beijing-based Bytedance. As can be seen, while on one hand a platform like TikTok gives an artist an opportunity to share their content with the world in a hassle-free way, it can also open doors to issues of unintended plagiarism or outright copyright infringements.

What TikTok is to the music industry, Instagram is to the photography industry: a blessing and a curse both. Given that Instagram allows a user to share their unique photography acumen with the world on its platform, sometimes that content is plagiarized and ends up on other social media channels. Now not always is this action consented upon by the original author and this may lead to a copyright infringement case. Even though the platform (Instagram in this case) has enabled features on their site that prevents the users from unauthorized use of copyright materials, users continuously keep on

coming up with inventive ways to do so. Instagram authorities comply with the notice-and-takedown procedures in accordance with Section 512(c) of the United States Digital Millennium Copyright Act (DMCA), which is applicable to the reported content and removed for being violative of the U.S. copyrights.

Another aspect of IPR violation seen in recent times is the rampant imitation of official accounts of famous brands on these platforms. One can easily find duplicate accounts of original brands that look and feel a lot like actual brands on these sites which are then used to rope in a novice user into thinking that they are connecting with an official channel. These fake accounts for the most part are harmless but sometimes they indulge in promotion of fake/ imitated products at discounted rates that ultimately eats up into the profits of the brand and the sub quality of the fake product ends up hurting the brand image in the market. For example, a fake Adidas account on Instagram might be able to trick users into buying a fake product at discounted rates that ultimately is a loss of both money and image for the official brand.

It is about time that these platforms are made to own up the concerns listed above and take necessary steps in the direction of taking corrective measures to protect the intellectual property of rightful owners.

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# CASE ANALYSIS - NANDHINI DELUXE V. KARNATAKA MILK FEDERATION CORPORATION

*KHUSHBOO TOMAR*

Trademark plays a very important role in growing and expanding any business. It is a mode which links the product with a particular manufacturer. Many a times consumer does not know the name of the brand, but they can easily identify the product with the help of the logo or the trademark. It takes time for the manufacturer to establish a reputation for a registered trademark which over a period of time becomes an asset for the business. So, it is right to say that there is a need of trademark as it helps the general public in distinguishing the goods and services of one manufacturer from that of another. In the case of *Nandhini vs Karnataka Milk Federation Corporation*, the Supreme Court answered the long-disputed question whether similar trademark used for 2 different unrelated products can be used by 2 different owners.

The brief facts of the case are that Karnataka Cooperative Milk Producer Federation Ltd. started using the mark “Nandini” from 1985 and started using the mark for producing and selling of milk and milk products. On the other hand, the Appellant started using the mark “Nandhini” from 1989 and it was used for selling of various items in the restaurant. Respondent had filed objection for registration. The issue before the hon’ble court was - whether the Appellant should be allowed to register the mark “Nandhini” under Class 29 and 30 when the same mark is registered with the respondent under the same class.

The matter was taken up by the Deputy Registrar. On the basis of the facts and the evidence placed before the authority by both the parties, the Deputy Registrar approved the registration of the mark of the Appellant. The reason for grant of approval was that the Appellant’s mark “Nandhini” was w.r.t food items which included milk and milk products whereas the Respondent’s mark was registered only in respect of milk and milk products. Further it was stated that the logo of both the trademarks were different and there was no question that the mark will create confusion among the general public.

The Respondent filed an appeal before the IPAB against the order of Deputy Registrar. IPAB upheld the decision of the Deputy Registrar but it rejected the approval of registration of mark by the Appellant on 4th October 2020. The Appellant filed an appeal against the order of IPAB before the Karnataka High Court where the court upheld the decision of the IPAB and made observations that even though the line of business of the Appellant and the Respondent are totally different, both the trademarks are likely to deceive the general public.

Nandhini Deluxe filed an appeal before the Supreme Court against the order of the Karnataka High Court.

## **JUDGEMENT**

The leg Court was whether the Appellant should be allowed to use the mark “Nandhini” when the mark is already registered under the class 29 and 30 with

the Karnataka Cooperative Milk Producer Federation Ltd.

It was observed by the apex court that the mark of the Appellant and the Respondent were totally different and in no case the logo will deceive or create confusion amongst the general public. The court noted that the Respondent had no intention to expand his business w.r.t other items mentioned in the Class 29 and 30. Supreme Court laid down the principle that the registered trademark owner can't have monopoly over the entire class when all the goods falling in such Class are not being used by the trademark owner. The decision of the Deputy Registrar was upheld by the court. However, such registration can't be granted to Appellant w.r.t milk and milk products.

### **COMMENT**

Earlier also the Supreme Court stated that the registered owner of the Trademark can't be allowed to enjoy exclusive right over the entire Class when the owner is not using all the goods in the said Class. However, when the court will be applying this principle, factors like duration of use of the mark, goodwill and distinct nature of the mark will help in determining the matter before the court. In this case, Supreme Court clearly mentioned that a registered proprietor of the trademark will not be granted exclusive right or monopoly for all the articles of the Class when all the articles are not being used by the proprietor. Thus, similar trademark can be granted for two different products.

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# CONTROLLER'S DECISION ON DENIAL OF APPLE'S PATENT APPLICATION: INTERPRETATION OF INVENTIVE STEP AND SCOPE OF AMENDMENTS TO CLAIMS

SAIPRIYA BALASUBRAMANIAN

Apple Inc. filed a patent application in 2016 for an invention titled "Organic light-emitting diode display with bottom shields". In a recent decision (IN201617022202), the said patent application was turned down by the Controller of Patent office on grounds of lack of inventive step as well as non-compliance of amendments incorporated to claims which did not stand the test of Section 59.

## BACKGROUND AND FACTS OF THE CASE

Apple Inc. (the Applicant) filed a patent application *vide* Application No. 201617022202, as a national phase application in India titled 'ORGANIC LIGHT EMITTING DIODE DISPLAY WITH BOTTOM SHIELDS' on June 28, 2016, claiming priority from U.S. Application Nos. US 61/929,907 and US 14/488,725.

The subject matter of claim 1 describes *a display comprising a substrate; a thin film transistor formed over the substrate; and a conductive shielding structure formed in the buffer layer directly below the thin-film transistor.*

The patent application was filed with 20 claims, which was examined and an FER was issued on 28<sup>th</sup> February 2019, for which the Applicant submitted its reply on 23<sup>rd</sup> August 2019. Subsequently, a hearing was held on 17<sup>th</sup> December 2019. After considering hearing submissions and accompanying documents, additional search was conducted by the

Controller and a new relevant document D5 was cited to raise objection regarding novelty. The written submissions after the hearing was considered and objections with regards to Proof of Right and executed form 1 was dropped. However, new document D5 has been found as relevant prior art.

The citation of additional document led to additional hearing on 6<sup>th</sup> July 2020. Pursuant to the hearing, hearing submissions and accompanying documents were submitted on 21<sup>st</sup> July 2020, in which the applicant has amended the claims.

After considering the submissions of the Applicant during hearing and subsequently through the written submissions, as well as the outstanding official requirements, the Controller refused to grant the Applicant's patent application *vide* an order dated 15 January 2021.

## ANALYSIS OF APPLICANT'S CLAIMS

The subject matter as described and claimed, relates to improvements in organic light-emitting diode (OLED) display generally used in small electronic devices such as mobile phones and portable computer. This display has an array of pixels based on light-emitting diodes and two thin-film transistors - drive and access. Thin-film transistor is connected to a data line via an access thin-film transistor. Thin-film transistors control application of a signal to the light-emitting diode to produce light. The access transistor may have a gate terminal that receives a



scan signal via a corresponding scan line. Image data on the data line can be loaded into the display pixel by asserting the scan signal to turn on the access transistor.

The problem solved by the present application is to resolve undesired color in conventional OLED due to an electric field (horizontal), created in certain scenarios, between the scan line and the channel region of the drive transistor, with the use of a conductive shielding structure (250) which shields the electric field causing the undesired color.

The present invention is basically a conductive shielding structure (250) formed within the buffer layer (202) directly below the thin-film transistor (106), wherein the conductive shielding structure (250) is formed from transparent conductive material, and configured to shield the thin-film transistor (106) from an electric field generated between the conductive path (230) and the thin-film transistor (106).

## **DECISION AND ANALYSIS**

As per the Controller's decision, at the time of the alleged invention it would have been obvious to a person skilled in the art to arrive at the said claimed features of the present invention in light of D1-D4 and/or D5 coupled with common general knowledge in the field of designing and fabricating OLED for display, hence the claimed subject matter of the claims 1-12 is obvious and lacks inventive step under section 2(1)(ja) of the Patents Act (as amended). Further, it is held that the additional features added in claim 1, from the description take the scope of the amended claim out of the originally filed claims. Thus, the said amendments fail to meet the conditions as prescribed by section 59 of the Patents Act 1970.

Accordingly, the Controller refused to grant a patent for the claimed invention.

## **INVENTIVE STEP AND PATENTABILITY**

With regards to the substantive objection under inventive step the following observations were made by the Controller regarding D1-D5;

1. D1 & D2 discloses conductive shielding structure, both explicitly as well as implicitly, and a manufacturing method having all the technical features as defined by claim 1-12;
2. D3 and D4 disclose shielding structure to the same effect;
3. D5 relates to an OLED display panel which includes a substrate, a conductive layer, an active matrix pixel array, and several thin film transistors (TFTs).

Therefore, the Controller observed that the shielding structure of D5 is of conductive in nature and used within the context of OLED display- shortcomings of the D1-D4 as argued by the Applicant.

The Controller further quoted the hon'ble Delhi High Court in *Biswanath Prasad Radhey Shyam Vs Hindustan Metal Industries Ltd (AIR 1982 SC 1444)* with regards to obviousness test - "*Such observations made in the foreign judgements are not the guiding factors in the sense of the term as to what qualities that person skilled in the art should possess. The reading of the said qualities would mean qualifying the said statement and the test laid down by the Supreme Court*".



In view of the above, the Controller construed that the “person skilled in the art” is a person competent in designing and fabricating OLED for the display. Therefore, the Controller concluded that though D1-D4 and/or D5 may not explicitly disclose certain design features, the same may not be considered as inventive as they are implementational/design variants of disclosure by D1-D4 and/or D5 for the same purpose and are considered trivial in nature.

### SCOPE OF AMENDMENTS TO CLAIMS

The Applicant has submitted amended claims 1 to 10, in response to the hearing notice dated 22<sup>nd</sup> May 2020. The following additional features were added:

The use of word ‘**wholly**’ for indicating that conductive shielding structure (250) is formed within the buffer layer (202) directly below the thin-film transistor.

Addition of substantial matter from the 3 paragraphs of description to claim 1.

In considering the amendments incorporated the Controller quoted IPAB in ORA/07/2009/PT/CH as he applied the test conditions of Section 59; accordingly, the right to amend is conditional, and the amendment must meet the conditions provided under the Act. Section 59 of the Patents Act, 1970 (as amended) elaborates the following conditions:

An Amendment	
i)	must be by way of disclaimer, correction, or explanation;
ii)	must be for incorporation of actual fact;
iii)	will not be allowed if it describes matter not in substance disclosed or shown in the unamended specification, or any claim of the amended specification does not fall wholly within the scope of a claim of the unamended specification.

In view of the above, the Controller held the amendments carried out to the originally filed claims are beyond the scope of originally filed claims as the word “wholly” is neither present in specification nor in the originally filed claims. Therefore, the said amendments fail to meet the aforesaid conditions as prescribed in section 59 of the Patents Act 1970. Hence, the amended claims weren’t allowed by the Controller.

### CONCLUSION

It is pertinent to note that, we encounter numerous patent applications that enter Indian phase via PCT and with a priority application filed in the United States which are amended substantially based on granted claims in other jurisdictions. While a patent or an application may be amended at several stages, special care must be taken when drafting patent claims and any amendment must have support in the original specification. This decision of the Controller stands as a testimony in adapting a uniform practice in interpreting the conditions laid down under Section 59 of the Indian Patents Act.

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