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**Patent of addition –  
A thread of monopoly or a string of progress**

Deepanshu Verma

## INTRODUCTION

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A patent is a form of [intellectual property](#) that gives its owner the legal right to exclude others from making, using, selling and importing an [invention](#) for a limited period of years, in exchange for publishing an [enabling public disclosure](#) of the invention. In most countries patent rights fall under [civil law](#) and the patent holder needs to sue someone [infringing the patent](#) in order to enforce his or her rights. In some [industries](#) patents are an essential form of [competitive advantage](#); in others they are irrelevant.<sup>1</sup>

The Supreme Court observed in *Bishwanath Prasad Radhey Shyam v. H.M. Industries*,<sup>2</sup> "The object of the patent law is to encourage scientific research, new technology and industrial progress."

## HISTORY OF PATENT LAW

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The legal protection in the form of patents in India is more than one and half century old as Patent protection in India was first introduced in 18<sup>th</sup> century. The history of patent rights can be traced way back in 1856 when certain exclusive privileges were granted to inventors of new manufacturers for a period of 14 years under The Act VI of 1856 based on the British Patent Law of 1852. The first independent patent legislation in British India was in the form of Indian Patents and Designs Act 1911. The British made law prevailed over India even after independence till 1970 when Independent India passed its own patent legislation called Indian Patent Act of 1970.

The Indian Patent Act of 1970 in original was specially designed to meet the special requirements of India to encourage rapid indigenous industrial growth and to prevent monopoly position through a well-regulated provisions and has played a vital role in economic and industrial development of India which was no doubt a necessity for a country like India. The main objective of the Indian Patent Act of 1970 as the Act itself describes is that the patents are granted to encourage invention and to secure that the inventions are worked in India on commercial scale and to the extent that is reasonably practicable without undue delay and that they are not granted merely to enable patentee to enjoy a monopoly for the importation of the patented article.

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<sup>1</sup> WIPO Intellectual Property Handbook: Policy, Law and Use, Chapter 2

<sup>2</sup> A.I.R. 1982 S.C. 1444 at paragraph 17

## **SUBJECT MATTER OF PATENTS**

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Sec 2(1) (j) of the Indian Patent Act of 1970 state 'invention' means any new and useful –

- i. Art, process, method or manner of manufacture.
- ii. Machine, apparatus or other article
- iii. Substance produced by manufacture, and includes any new and useful improvement of any of them, and an alleged invention

As provided, these 'inventions' or 'inventive steps' are what are patentable.

In order to be patentable, an 'invention' must satisfy the following conditions -

### **NOVELTY, OR NEWNESS**

The 'invention' must be new, and this featured is assessed in a global context.

### **INVENTIVENESS**

It refers to the features of an invention which make it significant, or not obvious to a skilled person.

A very simple invention can also qualify for a patent, if there is an inventive step involved.

### **USEFULNESS**

An 'invention' must be useful, and it must possess industrial applicability for the grant of a patent.

In *Lallubhai Chakubhai v Chimanlal & Co.*<sup>3</sup> it was held that a new and useful application of an old principle can also be good subject matter of a patent.

Patent of Addition traces its origin from Section 15A of the Indian Patents and Designs Act, 1911 that was introduced by the Indian Patents and Designs Act, (Act VII of 1930), and carried the same provision as in the U.K. Patents Act of 1907. This was modified later as a consequence of the recommendations put forth by the Lord Swan Committee (1948). Later, the Ayyangar Committee report titled "Report on the revisions in the patent law" suggested addition of a clause to empower applications for a Patent of Addition, in line with Section 26 of the UK Patent Act, 1949.

After arriving at an invention and obtaining patent on it, there remains a scope of improvement or modification of such invention. The improvements or modifications may take place as an ordinary process of improving an invention, or as a result of feedback received from the market or from the industry. The improvement or modification over the original patented product or process may be protected by a "Patent of Addition" in India. Patent of Addition comes into picture

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<sup>3</sup> AIR 1936 BOM 99



for protecting the novel, industrial applicability and non-inventive improvements or modifications to an already filed or granted patent application.

'Patent of Addition' is a weapon for the protection of products or processes, and their improvements and variations in India, as per the Patents Act, 1970. Modifications which may have been missed out in the main patent can be covered by this, without any renewal fee being charged for the same.

## **CHARACTERISTICS OF PATENT OF ADDITION**

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Section 54 of the Patents Act, 1970<sup>4</sup> states that –

(1) Subject to the provisions contained in this section, where an application is made for a patent in respect of any improvement in or modification of an invention described or disclosed in the complete specification filed therefor (in this Act referred to as the "main invention") and the applicant also applies or has applied for a patent for that invention or is the patentee in respect thereof, the Controller may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.

(2) Subject to the provisions contained in this section, where an invention, being an improvement in or modification of another invention, is the subject of an independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention, the Controller may, if the patentee so requests, by order, revoke the patent for the improvement or modification and grant to the patentee a patent of addition in respect thereof, bearing the same date as the date of the patent so revoked.

(3) A patent shall not be granted as a patent of addition unless the date of filing of the application was the same as or later than the date of filing of the application in respect of the main invention.

(4) A patent of addition shall not be granted before grant of the patent for the main invention.

The above provision implies for the following characteristics to be made out –

- The applicant must be the same for the main patent and the modification or improvement applied for.
- A patent of addition must be on the same date, or on a date after the filing of the main application.
- Patent of Addition can be revoked by the patentee's request.

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<sup>4</sup> Patents Act, 1970 at <http://www.ipindia.nic.in/> (Last visited on 16<sup>th</sup> March, 2020)

- Patent in addition would run concurrently and terminate with the main invention.
- In case of patent of addition, Rule 13(3) of the Patents Rules states that each such patent of addition shall include a reference to the main patent or the application for the main patent and also include a definitive statement that the invention is an improvement or modification of the invention claimed in the complete specification of the main application.

## **TERM OF PATENTS OF ADDITION**

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The term of every patent which has not expired and has not ceased to have effect, on the date of commencement shall be twenty years from the date of filing of the application for the patent.

Under Section 55 of the Act,<sup>5</sup>

- A Patent of Addition is granted for a term equal to that of the main invention, and that has not expired.
- If the patent for the main invention is revoked, the patent of addition can continue in force in an independent manner for the remaining term. However, fees of renewal shall apply upon such patent of addition coming into existence as an independent force.

## **VALIDITY OF PATENTS OF ADDITION**

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The grant of a patent of addition shall not be refused, and a patent granted as a patent of addition shall not be revoked or invalidated, on the ground only that the invention claimed in the complete specification does not involve any inventive step having regard to any publication or use of -

- a) The main invention described in the complete specification
- b) Any improvement in or modification of the main invention described in the complete specification of a patent of addition to the patent for the main invention or of an application for such a patent of addition

The validity of a patent of addition shall not be questioned on the ground that the invention ought to have been the subject of an independent patent, as per Section 56 of the Act.

Section 48 of the Indian Patents Act, 1970 states that rights conferred by patent of addition are same as those for other patents.

For instance,

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<sup>5</sup> Patents Act, 1970

- Right to sue for infringement
- Right to surrender
- Right to grant licenses

While several countries have abolished the concept of granting patents for improvements or modifications over the main invention, some countries including India, Australia and the U.S. still continue with the practice. The U.S Continuation in Part (CIP) application is one such instance similar to the Indian patent of addition concept, wherein improvements or modifications over an existing patent application can be made while the patent application is still pending for grant.

In the case of *Ravi Kamal Bali v. Kala Tech*<sup>6</sup>, the Hon'ble Bombay High court was posed with the situation dealing with indirect infringement of the plaintiff's patented product and patent of addition. The plaintiff sold his products under the trademark "TechLock". The plaintiff alleged that he came across a similar product bearing the name "SEAL TECH" which had constructional and functional features similar to that of his products. The plaintiff had sought for an injunction restraining the defendants from making of, using, selling or distributing tamper proof locks/ seals that fell within the scope of plaintiff's invention.<sup>7</sup>

With respect to the infringement issue, the contention of the plaintiff was the insistence to apply the Doctrine of Equivalents by which a device is set to infringe a claim if it performs substantially the same function in substantially the same way to obtain the same result. He submitted that it is not necessary that the infringing goods must be identical in every respect to the patented goods and it is sufficient if it is found that the essence of the invention was taken. The Defendants differentiated it by saying that the products worked on different principles.

Deciding upon the case, Justice Vasifdar favoured the plaintiff and applied the Doctrine of Equivalent while determining the issue of infringement. He opined that the two products, on comparison had the same usage/purpose, nature of material and also worked on the same principle. The Court opined that the difference of main structure of body makes no difference and it does not imply a new invention. The High Court of Bombay dismissed the argument of the defendant that the addition patent can only be granted if there is an inventive step over the application of the main patent.

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<sup>6</sup> 2008 (110) BOM L.R. 2167

<sup>7</sup> NLIU Journal of Intellectual Property Law

## CONCLUSION

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A patent is a legal monopoly, granted for a limited time by a country to the owner of an invention in exchange for public disclosure of the invention. A patent gives an inventor the exclusive right for a limited period of time to stop others from making, using, offering for sale, selling or importing the patented invention without the permission of the inventor. Merely holding a patent does not give the owner the right to use or exploit the patented invention. That right may still be affected by other laws such as health and safety regulations, food and drugs regulations or even by other existing patents. That is why a patent is called a "negative right". Patent rights last for 20 years in India and this is also generally the case globally.

In simple terms, a monopoly is a market condition where an individual owner has exclusive control of a product or service, and where this control restricts the entry of new players and also makes price manipulation possible. For instance, Apple owns several patents in the smartphone segment. But, that didn't prevent other players from entering the market or competing in the premium phone division. Instead, it solely relies on the market or the loyal customer base the brand has created for itself. A loyal Apple customer will go for an iPhone irrespective of whether or not the product is patented. Thus, patents play very little role in monopoly.

The Patent of Addition is an added advantage to the applicant in order to secure new modification in the invention or improvement. In the course of working of patent, new inventions or improvement or modifications in the invention can be claimed and rights can be acquired over the same via filing of Patent of Addition. However, the subject matter in the Patent of Addition must disclose over and above the main application or parent patent application and not merely claim over the same specification as of parent application. Mere claiming in Patent of Addition over main application from different aspect does not fulfil the purpose of Section 54 of Indian Patents Act. Henceforth, if the claims do not suitably cover the invention, the same cannot be corrected by filing a Patent of Addition.

Thus, looking at how patents do not create a monopoly generally, but only control the market to some extent, patent of addition also function in a similar manner. A patent does not guarantee you the right to exclude others from a market in some absolute sense. Patent of addition do not work as a thread of monopoly, but instead as a string of progress because they cannot be used to exploit the market. They can only be used to further the existing patent and improvise on it.