Agc Flat Glass Europe Sa vs Anand Mahajan And Ors. on 10 September, 2009

Author: Manmohan Singh

Bench: Manmohan Singh

.* HIGH COURT OF DELHI : NEW DELHI

+ I.A. No. 13519/2007 in CS (OS) No. 593/2007

Reserved on: April 23, 2009
% Decided on: September 10, 2009

AGC Flat Glass Europe SA ...Plaintiff
Through : Mr. Pravin Anand with Ms. Swathi Sukumar and Ms. Tusha Malhotra, Advs.

Versus
Anand Mahajan and Ors. ...Defendants
Through : Ms. Rajeshwari H., Adv.

Coram:

HON'BLE MR. JUSTICE MANMOHAN SINGH

1. Whether the Reporters of local papers may be allowed to see the judgment? Yes

2. To be referred to Reporter or not? Yes

3. Whether the judgment should be reported in the Digest? Yes

MANMOHAN SINGH, J.

1. The plaintiff has filed I.A. No. 13519/2007 under Sections 57 and 58 of the Patent s Act, 1970 read with Section 151 of the Civil Procedure Code, 1908 for an amendment in Claim 1 of its specifications. The present suit has been filed by the plaintiff for permanent injunction restraining infringement of Indian patent no. 190380, rendition of accounts, delivery up and damages.

2. The brief facts of the case are that the plaintiff claims to be a global leader of glass and mirror technologies. The plaintiff invented a product called „Mirox New Generation Ecological Mirrors (hereinafter referred to as „MNGE), which is a mirror without a copper or lead layer, is obtained through an environmentally friendly process and is available at the traditional selling price. The said

invention of the plaintiff is patented under Indian Patent No. 190380 being "a mirror with no copper layer and process for manufacturing the same."

3. The claims of the plaintiff s above-mentioned registered patent read as under:

> "1) A Mirror with no copper layer comprising:
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> i) a vitreous substance,
> ii) at least one material selected from the group
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> consisting of bismuth, chromium, gold, indium, nickel, palladium, platinum, rhodium, ruthenium, titanium, vanadium and zinc at the surface of the said substrate,
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> iii) a silver coating layer on the surface of the said substrate, said silver layer optionally comprising at least one material selected from the group consisting of tin, chromium, vanadium, titanium, iron, indium, copper, and aluminum present at the surface of the silver coating layer and/or traces of silane; and
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> iv) at least one paint layer covering said silver coating layer.

The process of manufacturing the above-said product as mentioned in Claim 1 has also been patented and the details of the same have been provided in the plaint.

4. The plaintiff s mirrors are unique as they have copper free metal coatings and the protection paint used is lead free. This offers improved corrosion resistance in the mirror therefore affording in the mirror longevity of existence. In around early 2006, the plaintiff came across the defendants mirrors being manufactured and sold under the name „SGG Miralite Evolution . The testing of a sample of the defendants product by a senior research scientist in the scientific analysis department of the plaintiff s R&D centre in Belgium proved that the defendants product is the same as the plaintiff s and therefore is an infringement of the plaintiff s registered patent.

5. The defendants have put up various arguments and objections against the plaintiff s case. Broadly, the defendants have contended that the plaintiff waived its rights to object to the defendants use of the above-stated mirror technology by virtue of its agreement with defendant no. 2 dated 18th December, 2003. Further, the plaintiff s patent has been wrongly obtained as the said „inventive mirrors are anticipated by prior art. Further still, the plaintiff s suit is barred by limitation as contrary to the plaintiff s averment that it came across the defendants product in 2006, the plaintiff was aware of the same since 2001-03.

6. In the present application, the plaintiff has stated that it has gone through the prior art citations filed by the defendants and wishes to amend its Claim 1 in Indian Patent no. 190380 and insert "a sensitizing material, typically tin" in clause (ii). The plaintiff has averred that the amendment sought satisfies all the requirements of Section 59 of the Patents Act, 1970 as it is by way of an explanation clarifying the scope of the plaintiff s invention in the light of the aforesaid prior art. Further, the

amendment pertains to matter already disclosed in the specifications and does not fall outside the scope of the un-amended specifications. The plaintiff has submitted that the amendment is necessary for proper adjudication of the dispute between parties and also that the same would cause no prejudice to the defendants as the amended claim sought is narrower in scope than the original claim.

7. In their reply, the defendants have contended that the present application has not been filed at the appropriate forum as provided under Section 57 of the Patents Act, 1970. It is further contended that the amendment sought by the plaintiff is not by way of explanation but is only a last attempt on the former s part to evade revocation of its wrongly registered patent. The amendment adds new matter to Claim 1 and varies its scope, i.e. the proposed amendment falls beyond the scope of the claim of the specification before amendment, which the defendants have submitted is impermissible in law. Also, the defendant has referred to para 9 of the plaint wherein the plaintiff has specified its inventive product and nowhere has „tin been used as a sensitizing material or otherwise. Further, the plaintiff s contention of narrowing down of the scope of its Claim is bogus as the sought amendment is an addition and therefore enlarges the said scope. The defendants have also contended that the amendment sought is not at all necessary for proper and effective adjudication of disputes between the parties.

8. The defendants have stated that with the proposed amendment, the plaintiff wishes to create a new monopoly as regards a new product as the proposed amendment would result in changing of the product originally patented. Further, the amendment has been sought to allegedly to overcome/clarify prior art, but no such prior art has been specified in the application.

9. Another argument of the defendants is that the plaintiff has filed another suit being CS (OS) No. 594/2007 against some other party for infringement of the same patent as in the present suit. An application under Order 39 Rule 1 and 2 has also been filed in that suit. However, no amendment seeking to explain/clarify the said patent has been filed in that case. The last contention put forward by the defendants is that the amendment which is the subject matter of the present application has been sought after 12 years of grant of the patent and plaintiff must have had knowledge as regards usage of tin in its product. Despite this, the plaintiff did not amend its claim previously and in fact is suing people on the basis of the unamended patent which according to him now, is unclear/ambiguous etc. Further, inclusion of tin in the process would render the product unpatentable as the same has been in public domain since decades and the same has been sought only with the aim of bringing the defendants product within the ambit of its amended registered patent.

10. As regards the last contention of the defendants, the plaintiff without admitting that the said contention is true has submitted that the scope of the present application is not whether the amended claim would be a valid one but whether the amendment can be allowed under Sections 57, 58 and 59 of the Patents Act, 1970.

11. I have gone through the submissions of the parties and carefully studied the case law referred by them and otherwise. Section 58 and 59 of the Patents Act, 1970 state as under:

> Section 58 : (1) In any proceeding before the High Court for the revocation of a patent, the High Court may, subject to the provisions contained in section 59, allow the patentee to amend his complete specification in such manner and subject to such terms as to costs, advertisement or otherwise, as the High Court may think fit, and if in any proceedings for revocation the High Court decides that the patent is invalid, it may allow the specification to be amended under this section instead of revoking the patent.
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> (2) Where an application for an order under this section is made to the High Court, the applicant shall give notice of the application to the Controller, and the Controller shall be entitled to appear and be heard, and shall appear if so directed by the High Court.
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> (3) Copies of all orders of the High Court allowing the patentee to amend the specification shall be transmitted by the High Court to the Controller who shall on receipt thereof cause an entry thereof and reference thereto to be made in the register.

Section 59 : (1) No amendment of an application for a patent or a complete specification shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of correcting an obvious mistake, and 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 disclosed in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

(2) Where after the date of advertisement of acceptance of a complete specification, any amendment of the specification is allowed by the Controller or by the High Court, -

a. the amendment shall for all purposes be deemed to form part of the specification;

b. the fact that the specification has been amended shall be advertised in the Official Gazette; and c. the right of the applicant or patentee to make amendment shall not be called in question except on the ground of fraud.

(3) In construing the specification as amended, reference may be made to the specification as originally accepted.

12. In support of the plaintiff s contention as regards the scope of the amended claim, the plaintiff has cited Baker Perkins Ltd.'s Application (1958) RPC 267 decided by Mr. Justice Lloyd-Jacob. While deciding whether or not the amendment of the patent ought to be allowed, it was observed as follows (at page 273):

> "As regards the first point, Mr. Lochner referred to a number of reported cases in which an amendment which imported into a claim a limiting feature from the description was refused on the ground that the amended claim would claim a new combination - an invention different from that originally claimed. These cases were decided under the Acts prior to the 1949 Act, when one provision was that an amended claim must not claim an invention substantially larger than or different from that of the original claim, a provision not to be found in Section 31 of the 1949 Act...
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> The section is clear that an amended claim may not be larger than the original claim - it must fall wholly within its scope - but so long as it does this, there is no requirement that it shall not be different...
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> A very common form of amendment when a claim for a piece of mechanism proves to have been drawn too widely is the addition to the claim of some additional feature of construction so that the scope of the original combination is cut down to that of a sub-combination. For example, amendments which allow an appendant claim to be combined with the main claim are constantly allowed provided that the sub-combination is, in truth, a narrowing down of the original combination and not the formulation of an entirely different one...
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> If limitation to a sub-combination, properly falling within the scope of the original wider combination, discards or eliminates from the invention claimed everything except this sub-combination, I think such amendment must come within the meaning of disclaimer..."

When appealed against, this issue was affirmed by the learned judge in the following words (at page 276):

> " ...amendment so as to limit the scope of the specification to a sub-combination which was within the original claim is disclaimer, and the absence of an appendant claim in the original document as to such sub-combination cannot of itself be a reason for refusing amendment."

12 A. The plaintiff has also referred to Merck & Co. Inc.'s Application (1952) 69 RPC 285 wherein the words "or by an obvious chemical equivalent thereof" were sought to be added to a claim by amendment. The following portion therein is relevant (at page 288) :

> "...The amendment sought merely expresses with clarity what a true construction of the specification would inevitably secure to the unamended document, and they lead neither to the claiming nor description of new matter, nor to any variation in the scope of the claims."

12 B. The plaintiff also cited Gillette Safety Razor Company v. Luna Safety Razor Company Ltd. (1910) 27 RPC 527 wherein the word „safety was allowed to be added by way of amendment/disclaimer to razor in the relevant specification as it was observed that the word „razor was used as a genus and the word „safety razor as the species. 12 C. The Polymer's Corporation's Patent (Amendment P.A.T) (1972) RPC 39 has also been referred to by the plaintiff while placing emphasis on the meaning of „explanation in the context of patent amendment. The pertinent portion of the same is produced hereinbelow:

> "...it can be used for the purpose of turning an ambiguous specification into a clear specification but not for the purpose of turning an insufficient description into a sufficient description. I think the test as to whether or not an amendment can properly be regarded as being by way of explanation can be applied on the same lines...The deletion of these words turns what can be regarded as an unambiguous specification into a clear specification."

13. As per the defendants, the first three cases referred to by the plaintiff are not applicable to the present case as none of them concern adding of any new material to a claim which is not already part of the original claim. Further, the last judgment referred to by the plaintiff concerns deletion of words and not addition. The defendants have relied upon the following cases :

> 13 A. In support of their contention that the plaintiff s application should be dismissed for want of disclosure of prior art in light of which the amendment is claimed to be sought, the defendants have relied upon Waddingtons Ltd.'s Patent (1986) RPC 158 wherein it was held as follows (at page 158):
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> "(3) Where amendments were proposed to distinguish an invention from prior art, the Comptroller must have particulars of that prior art so that he might take it into account in the exercise of his discretion."

13 B. In support of their contention that the plaintiff is trying to include tin in its patent claim to take unfair advantage of its knowledge of the fact that tin is present in the defendants product and lacking in the former s product and so as to manipulate the defendants product into infringing its registered patent, the defendants have relied upon Smith Kline & French Laborotaries Ltd. v. Evans Medical Ltd., 1989 (1) FSR

561. It has been observed in this case that (at page 569), " The discretion as to whether or not to allow amendment is a wide one and the cases illustrate some principles which are applicable to the present case. First, the onus to establish that amendment should be allowed is upon the patentee and full disclosure must be made of all relevant matters. If there is failure to disclose all relevant matters, amendment will be refused. Secondly, amendment will be allowed provided the amendments are permitted under the Act and no circumstances arise which would lead the court to refuse the amendment. Thirdly, it is in the public interest that amendment is sought promptly. Thus, in cases where a patentee delays for an unreasonable period before seeking amendment, it will

not be allowed unless the patentee shows reasonable grounds for his delay... Fourthly, a patentee who seeks to obtain an unfair advantage from a patent, which he knows or should have known should be amended, will not be allowed to amend. Fifthly, the court is concerned with the conduct of the patentee and not with the merit of the invention."

13 C. Placing reliance on the same case as mentioned instantly above and in addition to the third principle contained therein, the defendants have emphasised that delay vitiates amendment of patent. Following is the relevant portion (at page 568):

> "In that passage, the judge drew attention to the fact that there is a detriment to the general public by the maintenance in an unamended form of a patent which should be amended for a substantial period of time. He also drew a distinction between two categories of delay with knowledge. In the first category is a patentee who knows of the prior art and never thought or should have thought amendment was the right course... In the second category is a patentee who becomes aware of an objection to a patent and takes no steps to amend. In both categories the patentee has knowledge of the prior art which prompted the request for amendment and filed to apply to amend for a substantial period of time. The difference between the two categories is the unreasonable conduct of the patentee, referred to as culpable by the judge, in not applying to amend when he knew or should have known that he should amend... In the second category the patentee s conduct could be excused... Thus, in a case where a patentee who is aware of the facts and either decides not to amend or takes no action, but later changes his mind, the court will refuse to exercise its discretion in his favour unless there is a good and proper reason for his failure to seek amendment promptly."

14. I have gone through the documents filed by both parties as well as their rival submissions. It is settled law that if an amendment is put forward to overcome a possible objection to validity based upon a prior publication it may be relevant to consider whether the amendment propounded meets the objection arising out of such prior publication. If it does not, the amendment should be refused. If the patentee has known of the objection on the prior publication for many years, delay in applying for amendment will itself be ground for refusal. Further, an amendment having the effect of converting a non-essential element into an essential element should not allowed as held in Windsurfing v. Tabur (1985) RPC 59 at 82 (CA). It would not be out of place here to state that previously, „tin was nowhere mentioned in Claim 1. However, in Baker Perkins Ltd.'s Application (1958) RPC 267 and AMP Incorporated v. Hellerman Ltd. (1962) RPC 55 it has been observed that amendments which limit the scope of the specification to a sub-combination which was within the original claim would be a disclaimer (which can be allowed), and the absence of an appendant claim in the original document to such sub-combination cannot of itself be a reason for refusing the amendment.

15. It is also settled law that a patentee who had chosen to make his claim in a wide and sweeping form (a „covetous claim), and who has had the advantage of the claim stated in that form for some years, may not be allowed to limit his claim by amendment to make his patent more secure. Further, where a patentee knowing the defect in the specification did not seek to amend his specification but successfully insisted on retaining it in its original form, it may be a ground for not permitting an amendment at a considerably later date when the validity of the patent was attacked by proceedings for revocation (I.G. Farbenindustrie A.G.'s Patent (1930) 47 RPC 289). But in Chrome-Alloying Co. Ltd. v. Metal Diffusions Ltd. (1962) RPC 33 it was held that where there is no evidence to indicate either that the patentee was aware of the defect in his specification or that he made use of an unjustified wide monopoly resulting from the defect to seek undue advantage from his competitors, the court may not refuse leave to amend.

16. I have gone through the judgments cited by the parties and their rival submissions. I shall now proceed to discuss the law on the subject.

17. The law which emanates from the authorities cited is quite akin to the law of amendment. The jurisdiction necessary to allow the amendment of a claim in the specification vests with the High Court, once the validity of the patent has been challenged in a patent infringement suit. The claims can be amended and such amendment may be allowed provided that is it clarificatory or elaborative in nature and also, that it does not alter the scope of the claim or introduce any new claim in the invention which was not present in the original invention. Thus, the scope of enquiry in relation to amendments in the patent claim is limited to the extent as to whether it introduces any new claim which extends the scope of the monopoly rights of the patentee.

18. Of course, the law operates differently when it comes to narrowing down or crystallizing the claims and apportioning those claims/subjects which are irrelevant and ultimately making it narrow and limiting the scope of the invention. An amendment under these circumstances is allowed and the excluded portion is disclaimed and the amendment becomes what is called a „disclaimer . The disclaimer doctrine thus means that a right holder is delimiting the scope of the invention by narrowing down the claims to its inconvenience in a way which makes the amended claims not inconsistent with the earlier claims in the original specification. This recourse of disclaimer is adopted by the right holders in order to clarify the exact scope of the invention, once they are faced with the invalidity of their patents.

19. I shall proceed to examine the present application within the parameters of the legal position enunciated above. The original claim of the registered patent contains the following clause in Claim 1:

> "ii) at least one material selected from the group consisting of bismuth, chromium, gold, indium, nickel, palladium, platinum, rhodium, ruthenium, titanium, vanadium and zinc at the surface of the said substrate,"

The plaintiff seeks to add the words "a sensitizing material, typically tin"

in the above-mentioned clause. The said amendment has been vehemently opposed on several grounds including that the said amendment seeks to introduce a new invention and a monopoly, that the amendment is beyond the scope of the original claim, that the amendment is sought before the wrong forum, that the element sought to be added is not present and that a similar amendment is not sought in the other infringement suit filed by the plaintiff.

20. It is pertinent to note that on going through the entire specification of the registered patent, it can be easily gauged that the entire invention works upon a 3 step process which can described as follows:

a) Sensitizing process

b) Activating process

c) Silvering process The plaintiff is seeking to add the five words "a sensitizing material, typically tin" which prima facie appear to be related to the first process of the invention and does not in any way seem to lie outside the scope of the invention, thus making the amendment a clarificatory one.

21. It is settled cannon of interpretation that for construing any instrument or document, the entire document/ instrument has be to read as a whole so as to infer the intention of the parties and the same is not to be read in isolation and given an isolated meaning dehors the instrument. Thus, it is imperative to read the entire specification and to see as to whether these words "a sensitizing material, typically tin", which are intended to be added, alter the scope of the patentee s invention. The answer to this question can be easily given once Claim 1 is read along with Claim 9.

22. From the conjoint reading of the two claims along with the other claims, it is clearly discernible that the working of the invention is based on three processes named in para 20 above and the amendment seeks to clarify the scope of the sensitizing process by mentioning some sensitizing material, namely tin. Thus, it does not lead to an altogether new invention and the objections regarding the amendment being beyond the scope of the original specifications and being inconsistent with the original claim are meritless.

23. An argument was advanced that the word "tin" was not present earlier and the patentee is now seeking to introduce a new monopoly, although by using tin in the said invention it would not have the monopoly. In this respect, I would say, it is the plaintiff who is seeking the amendment which is clarifying or narrowing the invention and the merits of the claims shall be gone into at a later stage. If by any chance, the defendant has any force in the argument of tin inclusive invention having no monopoly, the same can be looked into while looking into the counter claim of the defendant. Thus, the said objection also fails.

24. It is now relevant to state and reiterate the law of amendment of plaint. The merit of the case is immaterial and cannot be looked into while considering an application for amendment, which is

clearly stated in Lakha Ram Sharma v. Balar Marketing Pvt. Ltd. 2003 (27) PTC 175 (SC). It is further trite that the correctness and falsity of the amendment cannot also be gone into at the stage of the amendment (Rajesh Kumar Aggarwal and Ors. v. K.K. Modi and Ors. (2006) 4 SCC 385). Further, in Usha Devi v. Rijwan Ahmad & Ors. AIR 2008 SC 1147 it was held as follows:-

> "As to the submissions made on behalf of the respondents that the amendment will render the suit non- maintainable because it would not only materially change the suit property but also change the cause of action it has only to be pointed out that in order to allow the prayer for amendment the merit of the amendment is hardly a relevant consideration and it will be open to the defendants-respondents to raise their objection in regard to the amended plaint by making any corresponding amendments in their written statement."

25. In view of the aforementioned discussion and well settled position of law and bearing the facts of the present case in mind, I find that the present amendment is merely a clarificatory/ elaborative one and does not alter the scope of the invention. At best, even if the defendants objections are accepted, the said amendment appears to be a disclaimer which also cannot come in the way of permitting the amendment and in fact, the same rather support the amendment. The merits of the controversy as to whether it is disclaimer or clarification will be decided at a later stage. The amendment is thus allowed as being a clarificatory one and the same does not attract the proviso of Section 58 and 59 of the Patent Act, 1970.

The amended claims shall be filed within four weeks from today.

Application disposed of accordingly.

List before court on November 3, 2009.

MANMOHAN SINGH, J.

SEPTEMBER 10, 2009 nn