

## **Patent of Addition: An Indian Perspective**

Rishikesh Singh Faujdar\*  
Riyazuddin khan\*\*

### **Introduction**

Patent of addition is an application made for a patent in respect of any improvement or modification of an invention described or disclosed in the complete specification already applied for or has a patent. In order to be patentable an improvement, should be something more than a mere workshop improvement and must independently satisfy the test of invention.

As the term implies, a patent of addition is granted as an addition to a pre-existing invention described or disclosed in the complete specification. The invention so described or disclosed is known as the 'main invention'. As a patent of addition can be granted only on the basis of an earlier application or in a granted patent, the grant of the patent of addition cannot precede the grant of the main invention. For the same reason, the date of filing of the application for a patent of addition should be the same as or later than the date of filing of the application of the main invention.

It is obvious therefore that only the patentee of the main invention is entitled to improve or modify the main invention for otherwise it would permit anybody to benefit from it by exploiting the main invention. A stranger to the main invention cannot apply for a patent of addition in respect of any modification or improvement of the main intention.

A patent of addition cannot be granted before the main patent is granted. If the main patent is revoked, the patentee may request the conversion of the patent of addition into an independent patent for the remainder of the term of the main patent, subject to the payment of maintenance fees. Patents of addition have the same term as patents for the main invention (in cases of conversion, patents of addition have only the term remaining from the original patent)<sup>1</sup>.

---

\*Research Scholar, Faculty of Law, Jamia Millia Islamia, New Delhi.

\*\* Research Scholar, Faculty of Law, Jamia Millia Islamia, New Delhi.

<sup>1</sup> <http://www.epo.org/patents/patent-information/east-asian/helpdesk/india/faq.html#a15>

## **Conditions for grant of patent of Addition**

- The applicant for the patent of addition should be the same as that of the earlier application or the patentee, as the case may be. The inventor may not be necessarily same.
- If the patent of addition is in respect of an application, the later application should be pending before the Controller.
- If the patent of addition is in respect of a patent, the patent should be in force.

In addition to the above conditions, the date of filing of the application in respect of the patent of addition has to be the same or later than the date of filing of the main application.

It should be noted that the invention disclosed and claimed in the patent of addition should be novel. But it is not necessarily involve inventive seep. This is because, in the course of working of hit invention covered in a pat-exit application or patent, the applicant or the patentee, as the case may be, may effect modifications or improvements which may themselves not possess sufficient inventiveness (inventive step) to qualify for protecting by way of an independent patent but is sufficient when considered in combination with the invention disclosed in the main application or patent, as the case may be. Such an applicant or patentee cannot be placed in a disadvantageous position by not allowing him to protect the modifications effected. Therefore, such improvements can be made the subject matter of a patent of addition.

The procedure of filing and processing the application for a patent of addition is the same as that followed in respect of an ordinary application for patent.

In an application for a patent of addition, a question arises as to how the invention proposed is an improvement or modification of the invention claimed in the applicant's previous application, Patent, as the case may be. It has been held that the proper comparison is not between the sum of the characteristics claimed in the respective main invention and proposed

patent of addition, but between the novel contributions which each specification has made to the art.

In Order to understand the meanings of the words "modification" and "improvements". It has been held that a modification is a variation, whether by addition, omission, or alteration to secure better performance, whilst retaining some characteristic part.

What seems to be abundantly clear is that mere presence of a number of elements common to both the inventions if common also in the known art, is not sufficient to make one invention an improvement of or addition to the other.

It may be noted that the power of the Controller for allowing the conversion of the patent/application as a patent of addition or not is discretionary in nature. This is because of the word "may" appearing in this Section, even though all the criteria has been complied with. Therefore, the allowance of the request cannot be taken as granted.

### **Subject matter of Patent of Addition**

The invention which is to be made the subject matter of the proposed patent of addition should be directly the improvement in or modification of the invention disclosed or described in the earlier application or the patent. In other words, in the claims incorporated in the patent of addition should not be distinct when compared with claims of the main application or patent as the case may be. The application for a patent of addition has to be filled in the same manner as in the case of an ordinary application. Accordingly, the form to be used is the form 1 incorporating appropriate amendments. The fees payable are also the same. In the complete specification in respect of a patent of addition it is required to contain a specific reference to the number of the main patent, or the application for main patent as the case may be, and a definite statement to the effect that the invention comprises an improvement in, or modification of, the invention claimed in specification of the main patent granted or applied for<sup>2</sup>.

### **Term of Patent of Addition**

---

<sup>2</sup> Subbaram, N.R; *Patent Law Practices & Procedures*; Wadhwa Nagpur; II Ed. (2006) Pg- 259, 260

A patent of addition remains in force only as the patent for the main invention remains in force. In other words, when the term of patent for main invention expires or lapses, the term of patent of addition also expires or lapses. [Sec. 55(1)] Example: Date of filing main application: 29th January 2006 Date of filing patent of addition: 15th November 2009 Date of expiry for both main application and patent of addition: 29th January 2026. If the patent for the main invention is revoked as per the *proviso to Sec 55(1)* this Act, the court, or, as the case may be, the Controller may order that:

- The patent of addition shall become an independent patent for the remainder of the term for the patent for the main invention [Fees 1500 INR for natural person, 6000 INR for other than natural person].
- The patent shall continue in force as an independent patent accordingly.
- The same fees shall thereafter be payable, upon the same dates, as if the patent had been originally granted as an independent patent<sup>3</sup>.

#### Renewal of Patent of Addition

No renewal fees are payable in respect of patent of addition. But if such patent becomes an independent patent the renewal fees shall thereafter be payable. Renewal fees shall be paid upon the same dates as if the patent had been originally granted as an independent patent.

Improvement must be of invention as described and not as claimed.

The expression "any improvement in or modification of an invention described or disclosed in the complete specification" used in Sec. 54(1) without any reference to the invention as claimed in that specification, makes it clear that the improvement proposed must relate to the invention as *described or disclosed* in the specification of the main invention and not limited to the invention *as claimed*. The subject of the application for the patent of addition must therefore be in respect of some further disclosure over and above that of the main invention

---

<sup>3</sup> Salient features of Indian Patent Law; available at [http://www.iprattorneys.com/patents\\_01.htm](http://www.iprattorneys.com/patents_01.htm), accessed on 20 November 2016

and that such further disclosure must constitute an improvement or modification of the main invention as described or disclosed and not merely as claimed. The claims of a patent of addition must be specifically directed to the improvement or modification in the main invention. The mere claiming in a later application of the main invention from a different aspect, or of subject-matter contained in the earlier specification but not claimed therein, does not fulfill the purpose of Sec. 54. Thus it would appear that applicants who have failed to draft their claims in a manner adequately to cover the inventions, cannot rectify the omission in the claims by filing patents of addition to cover such variations or amplifications of the monopoly claimed in their main invention as they may think necessary.

### Addition to One Patent Only

Application for patent of addition must be strictly construed as being addition to the particular invention for which a particular patent is already held and not additions to a series of inventions for which separate patents already exist.

## Doctrine of Equivalent

Doctrine of equivalents is an important legal principle under the patent law regime covering indirect infringement. In addition to literal infringement which is direct and unambiguous, an indirect infringement takes place when insubstantial or minor changes made to the patented product or process causes it to fall outside the declared scope of the patent i.e. patent claims, but, which in practical terms, remains a duplicate of the patented product/process.

The doctrine of equivalents is arguably one of the most important aspects of patent law. The protection a patent confers is meaningless if its scope is determined to be so narrow that trivial changes to a device bring it out of the bounds of the patent. One of the greatest challenges courts and legislatures therefore face in patent law is to create rules for determining patent scope that maintain the protection a patent is meant to confer while still keeping the patent monopoly within reasonable bounds. Despite the general unity in patent laws among developed countries, the difficulty of this task has led to different results in different jurisdictions. Many jurisdictions have chosen to determine patent scope under a

doctrine of equivalents, while others have maintained the position that adequate scope can be found within the meaning of a patent's claim<sup>4</sup>.

Doctrine of equivalents found mention way back in *Raj Parkash v. Mangat Ram Chowdhry and Ors*<sup>5</sup>, Quoting Lord Denning in *Beecham Group Limited v. Bristol Laboratories Ltd. and another*<sup>6</sup>, the judge in *Raj Parkash* held as below:

"Unessential features in an infringing article or process are of no account. If the infringing goods are made with the same object in view which is attained by the patented article, then a minor variation does not mean that there is no piracy. By trifling variations if the effect obtained by the defendants is the same, and we hold that it is the same, then according to the rule enunciated in the Ampicillin case, referred to above, there is a clear piracy. The idea of the plaintiff which is a novelty is clearly infringed."

*Ravi Kamal Bali v Kala Tech*<sup>7</sup>, is considered to be the first case in which Indian Court has adopted the doctrine of Equivalents. The Plaintiff has sought an injunction restraining the Defendants from making of, using, selling or distributing tamper proof locks/seals that fall within the scope of the claims of the Plaintiff's patent bearing No. 162675 and patent of addition No. 178879 so as to infringe the same and for delivery of for destruction any material infringing the said patents. Ravi Kamal alleged that the product of Kala Tech has similar constructional and functional features to his patented invention.

The Plaintiff alleges that in June, 2004 he came across similar products bearing the name "SEAL TECH" which had constructional and functional features similar to the Plaintiff's patented inventions and that on further investigation, he learnt that the same were manufactured and sold by Defendant No. 1 with the assistance of Defendant No. 3.

Defendant No. 3 had earlier worked with the Plaintiff from 1992 to 1999 as an Office Assistant and as a Works Incharge from 1999 onwards till 2002. During this time, Defendant

---

<sup>4</sup>Doctrine of equivalents: An International and Comparative perspective; available at <http://spicyipindia.blogspot.com/2009/09/doctrine-of-equivalents-international.html>, accessed on 14 November 2016.

<sup>5</sup> AIR 1978 Delhi

<sup>6</sup> 1967 (16) R.P.C. 406 (12)

<sup>7</sup> 2008(110) Bom. L.R.2167

No. 3 had unrestricted access to the technical and other conventional information relating to the Plaintiff's business including the trading and manufacturing details in respect of the said products. The Plaintiff has alleged that Defendant No. 3 has dishonestly been assisting Defendant No. 1 in the manufacture and sale of the infringing material.

The Plaintiff contends that the similarity in the Defendants products to the Plaintiff's products is such that the Defendants products could not have been designed independently of the Plaintiff's inventions. The differences are minor and inconsequential, superficial and cosmetic and are therefore of no consequence. The Plaintiff further contends that the Defendants products do the same work, in substantially the same way and accomplished substantially the same result and therefore constitute an infringement of the Plaintiff's patents.

In response, Kala Tech's counsel while asserting on the differences in the constructional and functional structure between the two products, made a counter argument comparing the inventive step between the plaintiff's patent and the patent of addition and the patents of plaintiff and defendant, and submitted that when the only difference between the plaintiff's patent and the patent of addition is the addition of 'vanes' in the patent of addition then the defendant's invention would also constitute a new invention qua the invention that is patented as the difference between the defendants invention and the plaintiff's patented invention is greater than the difference between the patent of addition and the patent itself.

The submission above equated a patent with a patent of addition which was found erroneous by the Court on the ground that this would obliterate the rights of a patentee. The patent holders of the main invention and the patent of addition being different in the instance of the patent over the main invention being revoked may see the patent of addition continuing for the remainder of the term for the patent of the main invention, unless also applied for and revoked simultaneously. However, the Court denied the relief of an interim injunction justifying it on the plaintiff's act of seeking an ad interim injunction on a representation which was incorrect in material aspect.

### **Validity of patent of addition**

The grant of a patent of addition will not be refused on the ground that the invention claimed in the complete specification does not involve any inventive step having regard to any publication or use of the main invention or any improvement or modification thereof described in the complete specification of a patent of addition or of an application for such a patent. Similarly a patent granted as a patent of addition cannot, be revoked or invalidated on the same ground. Section 56 (1) (b) would appear to cover publications whether by the patentee or third parties.

Further, the validity of a patent of addition cannot be questioned on the ground that the invention ought to have been the subject of an independent patent. In other words, the question whether or not the patent of addition in fact related to only an improvement or modification of the main invention cannot be an issue in revocation or other proceedings challenging the validity of the patent of addition, or a ground of opposition to the grant under Sec. 25. However, at the application stage there is no bar to raise this issue and even refuse the application on the ground that the alleged improvement or modification is not in fact an improvement or modification but the subject-matter of an independent invention. In the case of *Ravi Kamal Bali v Kala Tech*<sup>8</sup>, Court held the terms "improvement" and "modification" involve a reference to an existing state of affairs or article. Under the Act, the terms "improvement" and "modification" refer to a comparison of the improved or modified version of the main invention with the main invention. The validity of the patent of addition granted to the Plaintiff is not challenged including on the ground that it ought to have been the subject of an independent patent and not a patent of addition. In other words, the status of the invention as an improvement in or modification of the Plaintiff's main invention was not challenged. Sections 54 and 55 in terms establish the link between the main invention and the patent of addition. It posits that the patentee of the main invention and the patentee of the patent of addition are the same.

### **Inventiveness and novelty in patent of addition**

---

<sup>8</sup> Note Supra 7



Section 56(1) makes it clear that in order to qualify for a patent of addition it is not necessary that the improvement or modification of the invention described in the complete specification of the main invention should be of such a nature as to qualify for an independent patent so far as inventiveness is concerned. Thus there need not be any patentable difference between the invention disclosed in the specification of the main application and that in the application for patent of addition.

The position is, however, different in regard to the question of novelty. Section 56(2) clearly lays down that in determining the novelty of the invention claimed in the complete specification in the application for a patent of addition regard should be had to the complete specification of the main invention. Thus the complete specification of the main invention could be cited for novelty as an anticipatory publication.

The claims of a patent of addition must be for a novel matter not disclosed in the specification of the main invention though the novelty of such matter need not involve any inventive step<sup>9</sup>.

Such publication would include publication by the patentee as well as by third parties. The validity of a patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

In determining the novelty of the invention claimed in the complete specification of the patent of addition, the complete specification of the main invention shall be considered. In other words, the complete specification of the main invention may be cited for anticipation by publication. The claim in a patent of addition must disclose a novel matter not disclosed in the complete specification of the main invention, though it need not involve any inventive step<sup>10</sup>.

### **Advantages of a Patent of addition**

A patentee in the course of working of his patent may affect improvements or modifications in his invention which by themselves may not possess sufficient inventiveness to qualify for

---

<sup>9</sup> Narayanan, P; Patent Law; Eastern Law House; 4<sup>th</sup> Ed.(2006) Pg- 80

<sup>10</sup> Khader, Feroz Ali; *The Law of Patents*; Lexis Nexis; I Ed (2007); Pg. 206,207.

an independent patent. Such improvements can be protected as a patent of addition to the main invention, although this protection is available only for the unexpired term of the main patent. On the other hand, no separate renewal fee is payable so long as the main patent is in force.

Although the patent of addition is tagged to the main patent, its validity is not affected by the revocation of the main patent. When the main patent is revoked, the patent of addition could be converted into an independent patent, but then it will be in force only for the remaining term of the main patent, on payment of necessary renewal fee. The validity of a patent of addition will not be questioned on the ground that the invention ought to have been the subject of an independent patent.

## **Conclusion**

The Patents Act provides for filing and granting a special type of patent called "patent of addition". If the applicant for any improvement or modification of the previous invention so desires, the Controller may grant the patent as a patent of addition. As a patent of addition can be granted only on the basis of an earlier application or in a granted patent, the grant of the patent of addition cannot precede the grant of the main invention. For the same reason, the date of filing of the application for a patent of addition should be the same as or later than the date of filing of the application of the main invention.

The term of the patent of addition will run concurrently and terminate with the main invention. No renewal fee is payable in respect of a patent of addition so long as the main patent remains in force.

The object to providing for patents of addition is to protect improvement and modification of an inventor which may be made in the course of working of his patent, which may, by itself, not be entitled for a separate patent. Such improvements and modifications are tagged along to the main invention and protected along with the main invention so long as the main invention exists. However, the validity of a patent of addition is not affected by a revocation of the main invention.

## References

### Books Referred

1. Narayanan, P; *Patent Law*; Eastern Law House; 4<sup>th</sup> Ed.(2006)
2. Subbaram, N.R; *Patent Law Practices & Procedures*; Wadhwa Nagpur; 2<sup>nd</sup> Ed.(2006)
3. Khader, Feroz Ali; *The Law of Patents*; Lexis Nexis; 1<sup>st</sup> Ed (2007)

### URL Referred



1. <http://www.epo.org/patents/patent-information/eastasian/helpdesk/india/faq.html#a15>
2. Salient features of Indian Patent Law; accessed on 20 November 2016; available at [http://www.iprattorneys.com/patents\\_01.htm](http://www.iprattorneys.com/patents_01.htm)
3. Doctrine of equivalents: An International and Comparative perspective; accessed on 14 November 2016; available at <http://spicyipindia.blogspot.com/2009/09/doctrine-of-equivalents-international.html>