



A BULLETIN
FROM
TIFAC

INTELLECTUAL PROPERTY RIGHTS (IPR)

VOL 5 NO. 11 NOVEMBER, 1999

Can Repairs Infringe Patents?

It is generally assumed that repairing a part of a machine would not lead to infringement of a patent relating to the part. Well, it may not be so at all times. The extent of repair and whether it can be treated equivalent to 'making' or 'using' without the consent of the patent owner would determine whether the act is an act of infringement or not. A case law decided by the UK Court of Appeal has brought out some new dimensions in this regard.

United Wire Limited (UWL) sued Screen Repair Services (Scotland) Limited, in the UK Court in 1996 for infringing its two patents related to the construction of mesh screens used in vibratory sifting machines largely used by the oil exploration industry. These screens are used for filtering unwanted solids from drilling lubricant. UWL manufactures screens, which consist of a frame over which two meshes are stretched. These meshes are vibrated to prevent choking of the screens by unwanted solids.

Screen Repair repaired used screens originating from UWL to be used again. The repair involved dismantling of the screen, cleaning of the meshes, painting of the frame and re-assembling of parts. When the patent infringement proceedings started, Screen Repair took a stand that it was not a case of infringement and the original patents awarded to UWL were invalid. (*Invalidity of patents is quite a common plea used by*

....Industries engaged in reconditioning of equipment and selling them in India or a foreign country would need to pay due attention to the fact that existing patents are not infringed by their act of reconditioning...

defendants in patent infringement cases.) At the Divisional Patents Court level, it was held that the patents were valid but the act of Screen Repair was not an act of infringement. However, the matter was subsequently taken by UWL to the Court of Appeal. Interestingly, the patents were held valid and infringed by the Court of Appeal.

According to the UK Patents

Act 1977, an infringement takes place if a person makes, disposes of, uses or imports the product, covered by a patent(s) or keeps it whether for disposal or otherwise without the consent of the proprietor of the patent. The question to be answered was whether repairs were covered under the above provision. It is commonly understood that, a patentee exhausts his patent rights once he sells the product and the buyer of the product is free to do whatever he wants to do with the article, including repairs. However, by selling the product the patentee does not agree to infringing acts being carried out. The Court took a view that in this case the repair amounted to manufacture (which includes making, using etc), hence the relevant patents were infringed.

There are some important lessons to be learnt from this case law by the industries in India.

1. Before taking up repair (major) of a patented product, ensure that the repair does not amount to 'making', 'selling' or 'distributing' of the patented product in India. It is therefore first and foremost to
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Do Repair Infringe...

find out if the product under consideration is patented or not.

2. The situation may be a little more complex if one is repairing a part of a machine because it is usually difficult to ascertain if parts are patented separately or not. Depending on the stakes involved a buyer is well advised to ascertain these facts at the time of purchase of the machine. If necessary enter into an agreement for the purpose of repairs.
3. In case of a licensed technology this aspect should be duly taken care of at the time of signing the contract/ agreement. Buyer of machineries/plants would benefit by attending to this aspect.
4. Industries engaged in reconditioning of equipment and selling them in India or a foreign country would need to pay due attention to the fact that existing patents are not infringed by their act of reconditioning.

The fact that the decision will only have its effect in the UK should not be viewed as inconsequential as this case law can be cited as an example if such cases are brought to the Indian courts. The chances of such events taking place in India cannot be ruled out completely as many foreign companies are obtaining Indian patents for their products.

Case Study

Use of Television Network and Internet in E-commerce

Many e-commerce related patents are for business methods using computer networks. While reading such patent documents, some questions come to mind like what's new about it or wasn't something similar anticipated? However, patent offices awarding such patents view it differently. Software patents are considered process patents and this interpretation has emerged from court decisions. The land mark decision was the US Supreme Court 1981 decision in the *Diamond Vs Diehr* case allowing patenting of software. More recently, in 1998, in *State Street Bank & Trust Co Vs Signature Financial Group Inc* case, the US Court of Appeals held that business methods can be patentable subject matter; it confirmed the patentability of software patents covering internet-related methods of doing business. Many more patents would emerge related to business methods on internet which may be very broad in nature forcing new comers to pay royalties and compensation for using those methods.

The patent being discussed in these columns deals with a business method through combination of television network and internet. The patent was granted to an individual by the United States Patent and Trademark Office (USPTO) in 1999. As commonly practised by all the patenting systems, the inventor has to disclose the prior

art as extensively as possible. The patent document cites many US patents to establish the novelty and non-obviousness of the invention.

Prior Art

One is familiar with one way and two-way communication systems. Newspapers, radio and television are one way system while telephone and video conferencing fall in the two-way category. Television broadcast does not address one individual but the broadcast is available to all those who have subscribed to the television network. Many advertisements are seen on TV and a viewer can place order for purchasing some items through telephone, fax etc. However, this system has been found to have many shortcomings and has not been very successful. In addressable advertising, for example on the internet, a user gets terribly annoyed with junk e-mail.

An interactive television (video-on-demand) system enabling viewers to select a desired amount of advertisement and receive ordered entertainment programs was reported in the US Patent 5, 532, 735. US Patent No 5, 305, 195 discloses a system for providing advertising information for online PC users during waiting time. Screen saver applications have been developed (in which a program takes over the control of the screen when computer idles) which allows delivery of news headlines and commercials from web sites. US Pat No 5, 515, 098 describes a

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Case Study

system for distributing commercials to individually addressable subscriber terminals on a network. Commercial messages to be distributed over the network contain embedded information identifying categories of recipients. A server located on the network provides each commercial with addresses of terminals to which the commercial is to be distributed. The server selects the addresses and the commercial is received by an addressable set-top box and displayed on the TV screen.

Commercial-on-demand (COD) is a civilized alternative of annoying junk mail and solicitation by phone. While advertising a product, COD goes only to those recipients, TV viewers and PC users, who currently indicate an interest in that kind of product, and does not bother all others. Unlike junk e-mail, COD does not clog the Internet bypassing it via non-addressable broadcast TV channels—cable, satellite and so on. Having power of multimedia presentation COD is affordable because it doesn't need to be inserted in a prime-time popular program; computers automatically pick it up from any channel at any transmission time.

Connected to both a TV system and the internet a recipient computer, which is a PC, facilitates home shopping via a system referred as virtual personal store (VPS). Order can be placed for selected items with a press of a key on the keyboard. However, the problem lies in regard to delivery.

Products of informational rather than physical nature such as newspapers, magazines, books, music, software can be delivered electronically via internet. However, newspaper delivery will clog the addressable network because of large amount of digital information distributed simultaneously to a large number of recipients. Obviously, there is a limitation on delivery of products on internet through addressable network.

A number of systems and products providing TV viewers with internet services are available, developed by companies like Philips Electronics, Sony Corporation and Web TV network. These products do not provide viewers with COD, VPS and virtual delivery. Moreover, these systems do not make use of one way non-addressable television lines, they use only the TV set screens as a computer monitor.

Summary of the Invention

The object of the present invention is to provide a system for delivery of commercials and other advertising information to interested recipients only. Each commercial-on-demand comprises two separate parts: a multimedia presentation of merchandise intended for human attention, and a preliminary message about the presentation intended for computer processing. Both parts are loaded in a multimedia database associated with the television system center or headend and when a presentation is scheduled for transmission the corresponding message is supplemented with

time/channel data of the transmission and transmitted prior to the presentation. At the recipient's site, each preliminary message is processed by computer that stores recipient's profile data, and if the profile indicates an interest, the corresponding advertisement is selected and its presentation is recorded at the time of transmission. The invention also provides automated home shopping system, virtual personal store that combines non-addressable television broadcast of commercial-on-demand with addressable internet e-mail service. The system presents to recipient products and services of the most personal interest because all presentations are delivered by commercial-on-demand. At recipient's request, the system automatically composes an order using recipient's name and address included in recipient's data and advertiser's e-mail address brought by commercial, and sends the order through the internet to advertiser.

A further object of the invention is to provide a home shopping system that uses advertiser's web address brought by recorded commercial to automatically link recipient's computer to advertiser's web site which is, in fact, advertiser's virtual store, so that recipient interested in a commercial can browse and make orders for products of the advertiser not included in the commercial explicitly. That is important for supermarkets, department stores and many other businesses,
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Case Study

which sell a large number of different products and never advertise all of them. The invention also provides PC users with all described above services using an intermediate internet server connected to a television system so that PCs themselves do not need to be connected to television.

A one more object of the invention is to provide fast local and global virtual delivery of newspapers, magazines, books, music, video and computer software to authorized recipients via one-way non-addressable television media using addressable two-way internet for orders, authorizations and bills. As a result, usage of slow and overcrowded internet in e-commerce is limited to relatively low-volume communications that need to be addressable while all high-volume transmission of info products and advertisements goes through fast one-way lines in order to bypass the internet and reach simultaneously an unlimited number of recipients.

Preferred Embodiments

A block diagram of an integrated telecommunication system for e-commerce is shown in Fig. 1. A distribution center consists of a television system transmitting center (headend) 10 and associated with the headend a data processing center 12 where advertisements are prepared for transmission and stored in a multimedia database. Each commercial-on-

demand (COD) consists of at least two parts: a presentation of a product intended for human attention and a formatted record intended for computer processing. Advertisers send presentations to the data center 12 by mail or via the internet. When an advertisement is scheduled for transmission its record is retrieved from the database, supplemented with access data specifying time and channel of the transmission, and included in a preliminary message to be sent prior to the advertisement itself. Preliminary messages are transmitted on a certain channel at a certain time so that computerized video terminals 14 and personal computers 16 could receive and process all messages about all advertisements scheduled for transmission.

Each recipient's computer compares all preliminary messages with recipient's profile data so that each advertisement would be selected or rejected before it is transmitted. In other words, recipient's computer deals only with selected advertisements.

There are three reasons for distribution of advertisements via non-addressable television media bypassing the internet. They are:

1) Bandwidth: a cable line is

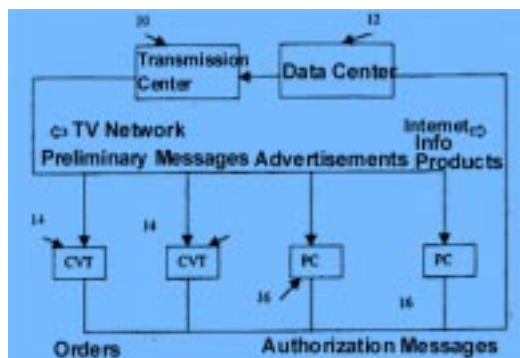


Fig 1.

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Domestic News

The Defence Research & Development Establishment (DRDE), Gwalior has filed the following two patent applications:

1. An improved process for the chemical destruction of sulfur-mustard by chemical conversion into non-toxic products, and

2. A process for the preparation of s-(w-amino-alkyl-amino) alkyl-aryl sulfide dihydrochlorides.

(DRDO Bulletin, September 99)

A patent has been granted to the Centre for Cellular & Molecular Biology (CCMB), Hyderabad for a salt-inducible expression vector system. Under the system, common salt is used as a switch to clone genes into bacteria within 20 minutes. The genetically engineered product enables the biologists to clone genes to bacteria and generate designed proteins in large numbers. The technology has been licensed to Maryland-based Life Technologies Incorporated.

(CSIR News, Vol 49 No 12, 30 Jan 99)

The Regional Research Laboratory (RRL), Bhubaneswar has filed 3 patent applications during the period 1998-99. During the same period its 2 applications have been accepted and 4 sealed. While 34 patents are already alive and 22 patent applications are in the process of being filed.

(CSIR News, Vol 49 No 12, 30 Jan 99)

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Case Study

almost 1000 times faster than a telephone line (27 Mb/s vs 28.8 Kb/s).

2) Another reason is that no annoying junk e-mail comes on the net as one sees a COD only if one's profile indicates an interest in it.

3) In a non-addressable broadcast system all recipients are connected (tuned) to the same channel and thus there is no technical limit for the number of recipients.

Fig. 2 shows another embodiment in which internet servers 18 is connected to a

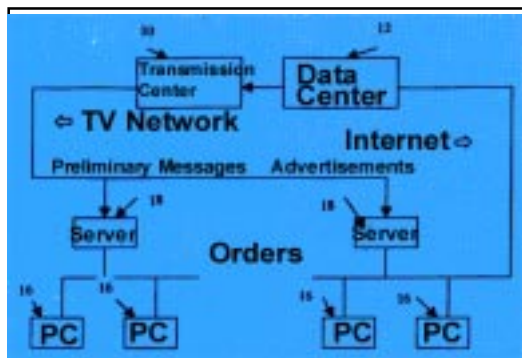


Fig 2.

television system so that recipients' computers wouldn't need to be connected to television. The system provides COD and virtual personal store (VPS) for those recipients who are not pay TV subscribers or whose pay TV provider doesn't offer COD option.

A block diagram of a computerized video terminal (CVT) 14 is shown on Fig. 3. It includes a video receiver (TV set) 22, a video recorder 24 and a channel selector (tuner) 26. A computer 28 is connected via a cable interface 30 to a

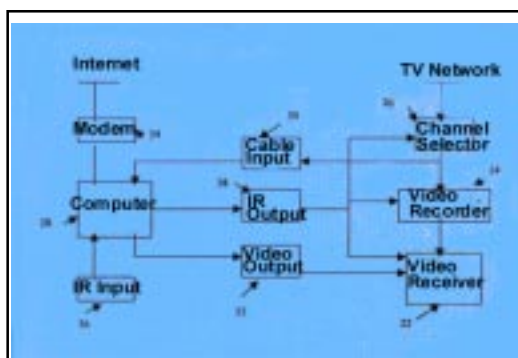


Fig 3.

television network and via a standard modem 34 to a telephone line. The computer does not have a screen and a keyboard—the most space-consuming parts of a laptop-size computer. It outputs video signal via interface 32 to the screen of television set 22. The computer receives recipient's input via infrared interface 36 and controls TV set 22, VCR 24 and channel selector 26 via infrared output 38.

Claims

The patent has 7 claims. Claim one is reproduced below:

1. A system for distribution of advertisements to interested recipients only,

comprising:

a one-way non-addressable communication medium;

a transmitter at a distribution center connected to said one-way non-addressable communication medium for transmission of advertisements presenting various products and services;

a transmitter at said distribution center connected to said one-way non-addressable communication medium for transmission of preliminary messages about said advertisements scheduled for transmission, each message

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Domestic News

The Indian Drug Manufacturer's Association (IDMA) has released a book titled, "Patents for Medicine, Balanced Patent Law-The Need of the Hour" authored by Shri N. B. Zaveri. Further details on the book can be accessed through email : idma@vsnl.com or fax : 022-4950723.

Efforts are on to revamp the patent administration with a view to bring down the backlog of patent applications. The backlog of patent applications has gone upto 32,000 as against 27,000 during the last year. The Ministry also has the plans to increase the number of patent examiners from the present 33 to at least 250.

(The Observer, 4 Nov 99)

The US pharma giant Pfizer Inc has won the patent case against the Dr. Reddy's Research Laboratory (DRL) in Russia. Pfizer had accused DRL of selling its product Stamlo reportedly similar to Pfizer's product Norvasc, used for curing heart ailments, without taking a licence from Pfizer.

(The Economic Times, 15 Nov 99)

The top eight domestic pharmaceutical companies have joined forces to form the Indian pharmaceutical Association (IPA). These include Ranbaxy Laboratories, Lupin Laboratories, Cipla, Nicholas Piramal, Wockhardt, DRL, Sun Pharma and Alembic Laboratories. Under the Presidentship of D.S. Brar,

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Fee Structure with US as a Designated/or Elected Office in a PCT Application

Readers may recall that PFC had explained the Patent Cooperation Treaty in the IPR Bulletin Vol. 4 No 8 August 1998. A patent application, filed under PCT, has the effect of a national patent application in those PCT Contracting States, which have been declared as designated states, in your original application, where you would like to protect your invention. We are now starting a series in our bulletin in which the fee structure of various PCT contracting states shall be reported along with the summary of the requirements for entry into the national phase. To start with, the summary of requirements and the fee structure of United States Patent and Trademark Office (USPTO) is being published.

A PCT application written in English must reach the USPTO within 20 months (under PCT Article 22) from the priority date if the applicant has decided to enter the national phase after the search report. It must be submitted within 30 months from the priority date if the applicant has decided to enter the national phase after the examination report. If the original application is in a language other than English, then it must be translated into English covering request, description, claims (if amended, both as originally filed and as amended, together with any statement under PCT Article 19), any text matter in the drawings and abstract under the PCT Article 22. If the translation of the amendments is not furnished, the amendments will be considered cancelled.

Applicant should only send a copy of the international application if he/she has not received Form PCT/IB/308 and the USPTO has not received a copy of the international application from the International Bureau under PCT Article 20. This may be the case where the applicant expressly requests an earlier start of the national phase under PCT Article 23 (2). No copy is required if the international application was filed with the USPTO as receiving Office.

Under special requirements of the Office (PCT Rule 51bis) an oath or declaration of the inventor must be furnished within the time limit applicable under PCT Article 22 or 39(1). Where applicable, a nucleotide and/or amino acid sequence listing and its machine-readable form, as prescribed, including the required statement (see 37 CFR 1.821 - 1.825); a sequence listing complying with the requirements has also to be furnished. Patent attorneys and patent agents registered to practice before the USPTO can act as patent agents for filing of the PCT application in the United States. A list of registered patent attorneys and agents may be obtained from: Superintendent of Documents, U.S. Government Printing Office, and Washington, D.C. 20402

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Domestic News

Managing Director of Ranbaxy, the group aims to partner the government in evolving a patents regime that will meet the obligations under the TRIPS, initiating discussions with the government on price-management and upgrading regulatory provisions.

(Business Standard, 26 Nov 99)

Lupin Laboratories in the process of restructuring its R&D set up has formed 4 groups that will work on developing non-infringing processes for drugs going off-patent internationally, new drug research, controlled release systems and process development of products for the Indian market.

(Business Standard, 18 Nov 99)

Talks are going on between the Department of Biotechnology (DBT) and the National Law School, Bangalore to explore the possibility of setting up a patent attorney service centre for facilitating proper documentation and filing of patent applications. The DBT Secretary told this while speaking at a seminar on 'Patenting in Biotechnology' organised in collaboration with WIPO at the Rajiv Gandhi Centre for Biotechnology (RGCB).

(Business Line, 10 Nov 99)

WIPO is in the process of formulating a draft patent law treaty (PLT) which would effectively align certain formalities and procedures under the existing Patent Cooperation Treaty, as told by Mr. Gary Smith, Director-in-charge of PCT Office,

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Fee Structure with...

National Fee (in US \$)

Actions	Fees
Where an international preliminary examination fee has been paid on the international application to the USPTO	720 (360)
Where no international preliminary examination fee has been paid to the USPTO, but an international search fee has been paid for an international search by the USPTO	790 (395)
Where no international preliminary examination fee has been paid to and no international search report has been prepared by the USPTO	1,070 (535)
Where a search report on the international application has been prepared by the European Patent Office or the Japanese Patent Office	930 (465)
Where the international preliminary examination report prepared by the USPTO states that the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined in PCT Article 33 (1) to (4) have been satisfied for all the claims presented in the application entering the national phase	98 (49)
Additional claims fee for each independent claim, where there are more than three independent claims	82 (41)
Additional claims fee per claim where there are more than 20 claims	22 (11)
Surcharge for filing oath or declaration later than the time limit applicable	130 (65)
Processing fee for filing English translation of an international application after the time limit applicable under PCT	130
Patent issue fee	1,320 (660)
Maintenance fees	
For maintaining patent in force beyond four years (due by three years and six months after grant)	1,050 (525)
For maintaining patent in force beyond eight years (due seven years and six months after grant)	2,100 (1,050)
For maintaining patent in force beyond 12 years (due by 11 years and six months after grant)	3,160 (1,580)

Amounts in parentheses are for small entities.

(Source: PCT Applicant's Guide-Vol. II-National Chapter-US, January 1998; Published by World Intellectual Property Organisation)

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Domestic News

WIPO at a WIPO meet on PCT organised jointly with the Government of India and the Institute of Intellectual Property Development in Calcutta.

(Business Line, 3 Nov 99)

International News

A patent has been obtained by a US researcher for a method for implanting tiny silicon capsules carrying health transplant cells beneath a patient's skin, which take the place of malfunctioning cells by producing chemicals needed for the body. The method eliminates the need for immunosuppression, and for transplanting an entire organ when a few grams of healthy cells will do.

(PTI Science Service, Vol 18 No 18, 16-30 Sept, 99)

Fraunhofer -Gesellschaft, one of Europe's leading organisations of applied research filed 417 patent applications with the German Patent and Trademarks Office in 1998. On average, nearly two inventions are made at the Fraunhofer-Gesellschaft every working day. Of these, around 70 per cent culminate in intellectual property rights with commercial potential. The organisation holds 19th place in the 'charts' of major international organisations applying for intellectual property rights with effect in Germany. Fraunhofer is the only German research establishment in the 'top 50' international establishments.

(Research News, Fraunhofer Gesellschaft, No 8, 99)

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A US Patent Granted to an Indian Company for a Herbal Composition

Herbal compositions have been used in our country since time immemorial. Protection of new herbal compositions in other countries can open new vistas of trade for such products in those countries as well. Researchers in India actively engaged in this area can think of patenting such products since the world has now started appreciating the inherent benefits of herbal compositions. What follows in the succeeding paragraphs is a case study on a patent granted to an Indian company for a herbal composition by the United States Patent and Trademark Office (USPTO) for a herbal dry shampoo composition comprising of *Cocoa nucifera* (*Nariyal* : *Hindi*) *Hibiscus rosa sinesis* (*Rudra Pushpam* : *Sanskrit*, *Jasut* : *Hindi*) , *Sapindus trifoliatus* (*Reetha* : *Hindi*), *Trigonella foenum graceum* (*Methi* : *Hindi*) and *Bassia malabarica* (*Mahua* : *Hindi*). The patent has been awarded to a Chennai based Indian company, GEM Energy Industry Limited on 16th February 1999. The inventors of this composition are Shri Neelakantan and Shri Kameswaran.

Prior Art

Shampoos available in the market at present mainly contain inorganic chemicals. Some of the herbal shampoos, in order to retain the liquid form, use such chemicals. These inorganic chemicals make a layer on the scalp of the skull between the hair roots, which can lead, to

dandruff. Dry shampoos available in the market are insufficient in removing the sebum from the hair. Some of these dry shampoos contain starch, which sticks to the hair and is not easily removed. Some other dry shampoos have carbon and alumina, which are not biodegradable and are difficult to remove from the hair. The present invention overcomes such inefficiencies and is free from side effects.

Present Invention

The object of the present invention is to provide an efficient, non-toxic, biodegradable dry 100% herbal powder shampoo composition, having a longer shelf life without the use of synthetic chemicals for preservation. The constituents of the composition themselves act as preservatives. According to the present invention the herbal dry shampoo composition is applied to the hair in powdered form. The herbal dry shampoo composition comprises of about 6-12% by weight of a foaming accelerating agent, about 6-12% by weight of a pigment recreating agent, about 6-12% by weight of a foaming agent, about 6-12% by weight of a conditioning agent and about 52-76% by weight of preservative and hair stimulating agent. *Cocoa nucifera* or *Nariyal* acts as the foaming accelerating agent, *Hibiscus rosa sinesis* or *Rudra Pushpam* acts as the pigment recreating agent, *Sapindus trifoliatus* or *Reetha* as a foaming agent, *Trigonella foenum graceum* or *Methi* as the conditioning agent and *Bassia malabarica* or *Mahua* as the preservative and hair stimulating agent.

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International News

The United States Patent and Trademarks Office (USPTO) has floated a proposal for payment of any patent or trademark fee by credit card. Presently, the payment by credit card is limited to certain information products such as obtaining copies of patents or trademarks, or for an electronic submission involved in a trademark application. The PTO currently accepts Master Card, Visa, American Express and the Discover Card for such transaction.

(www.uspto.gov, Nov 99)

Certain changes are taking place in the United States with regard to filing fees for patents and trademarks effective from January 10, 2000 is shown in the table below:-

Trademark Fees

37 CFR SEC.	Description	Current Fee Amount	New Fee Amount (Effective 1/10/00)
2.6(a)(1)	Application for registration, per class	\$245	\$325
2.6(a)(4)	Extension for filing Statement of Use, per class	\$100	\$150
2.6(a)(5)	Application for renewal, per class	\$300	\$400
2.6(a)(13)	Filing section 15 affidavit, per class	\$100	\$200
2.6(a)(16)	Petition for cancellation, per class	\$200	\$300
2.6(a)(17)	Notice of opposition, per class	\$200	\$300

(www.uspto.gov, Nov 99)

The broad nature of the claims of e-commerce related patents could also be restricted as shown

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A US Patent Granted

Cocoa nucifera is a herb extracted from the genus Cocos of family Palmae. The kernel of the Cocoa nucifera is used in the said invention. Hibiscus rosa sinensis belongs to the genus Hibiscus from the family Malvaceae. The flowers of the plant are used in this composition. The constituents of the flowers stimulate the growth and color of the hair. Sapindus trifoliatus is a herb from the genus Sapindus from the family Sapindaceae. The leaves and seeds of the plant are used for the composition of this invention. They are dried and converted to powders and used. Trigonella foenum graecum is a herb from the genus Trigonella from the family Leguminosae. The seeds are dried and pulverized to form a powder, which is used as a component of the shampoo. The powder contains albumin, choline and trigonelline. It contains substances rich in phosphates, lecithin and nucleo-albumin. It contains considerable quantities of iron in an organic form, which enables it to be readily absorbed. Bassia malabarica, one of the major constituents in the present composition, is a herb extracted from the genus Aisandra from the family Sapotaceae. The crushed and pulverized leaves are used in the composition of this invention.

All the above mentioned constituents of the present composition are plucked and processed. The constituents are cleaned by conventional methods to remove all the superfluous dust and other foreign particles and are then dried at ambient temperatures, preferably in an open atmosphere. The dried constituents are meshed in a

pulverizer to a mesh size of 200-300. At the time of crushing the constituents, the pH is maintained at 7. A pH adjusting agent such as sodium bicarbonate is used to adjust the pH. After the desired mesh size is achieved the powdered mixture is removed from the pulverizer and packed. The mixture so prepared has a shelf life of three to four years without any contamination or fungal growth, because of the presence of a herbal preservative such as Bassia malabarica. The present composition is very economical one as all the essential ingredients are natural and are found in abundance. All the important constituents of the present invention are non-toxic according to the intended use.

Example

The following herbs are used in the preparation of a herbal dry shampoo composition comprising about 9-12% by weight of Cocoa nucifera, about 9-12% by weight of Hibiscus rosa sinensis, about 9-12% by weight of Sapindus trifoliatus, about 9-12% by weight of Trigonella foenum graecum and about 52-64% by weight of Bassia malabarica. The constituents are cleaned, dried at ambient temperatures and crushed to a mesh size of 175-275 sieve size maintaining the pH at 6-9, and finally packed.

Claims

The patent has 11 claims. Claim 1 is given below :

1. A herbal dry shampoo composition comprising:
 - from about 6-12% by weight of a foaming accelerating agent,
 - from about 6-12% by weight of a pigment recreating agent,

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International News

by a recent case of a Freeny patent. Mr Charles C. Freeny Jr. was granted a US patent (4,528,643) in 1985 for digital encryption. The patent specifically covered "information manufacturing machines capable of purchasing digital-data-products. Since Internet was not on the card during that time, Freeny sold the patent for about \$ 100,000 to another company, Avedas Corporation, which again sold it to E-Data Corporation for \$ 290,000. E-Data thought of making use of this patent by sending 'amnesty packets' to various companies engaged in trading over the net, stating that these companies had been infringing the Freeny patent and thus were liable to pay royalty/licensing fee to E-Data. However, this did not fetch much response. So E-Data sued 40 companies for patent infringement, out of which companies such as IBM, Vocaltec and Adobe Systems settled the case by paying some amount to E-Data. The interesting part of the whole case was that E-Data did not have any other business other than a dial-a-gift operation. The court held that in an obvious attempt to expand the scope of its patent beyond that which was intended, the plaintiff implausibly asserts that its patent covers certain uses of the Internet and the World Wide Web and applies to certain CDROM applications. It is abundantly clear to the court, however, that the patent does not

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A US Patent Granted

from about 6-12% by weight of a foaming agent,

from about 6-12% by weight of a conditioning agent and

from about 52-76% by weight of *Bassia malabarica*.

The patent document describes all the herbs by their physical characteristics. This is a good development. However, it fails to mention that some of the herbs have been traditionally used in India as shampoo or conditioning agents.

Sapindus trifoliatus (Reetha) commonly called soapnut has been used to wash hair and also as foam stabilizer in the manufacture of soapless shampoos. *Cocoa nucifera (Nariyal)* has been used for making soaps having easy lathering qualities. *Hibiscus rosa sinesis (Rudra pushpam)* has found use as colouring agent for hair and the eyebrows. *Trigonella foenum graecum (Methi)* has been used as conditioning powder for the hair while ckes made of *Bassia malabarica (Mahua)* have already been used as substitutes for soaps. (References: 1. The Wealth of India, Vol 9, 1972; 2. The Wealth of India, Vol 2, 1988; 3 The Wealth of India, Vol 5, 1991; 4. The Wealth of India, Vol 10, 1976; 5. The Wealth of India, Vol 1, 1985; 6. The Wealth of india, Vol 2, 1988). However, these characteristics of the herbs have not been mentioned in the patent document. An Indian Application on the same topic was filed by GEM Energy India Ltd "Herbal dry Shampoo composition" on 20th June 1997 vide application number 1351/MAS/97.

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Case Study

specifying content of an advertisement and its access data including a time of transmission;

a receiver of said preliminary messages at a recipient's site coupled to said one-way nonaddressable communication medium in such a way as to receive said preliminary messages about said advertisements scheduled for transmission;

selection means storing recipient's data determining recipient's interests in certain products and services, said selection means coupled to said receiver of preliminary messages for comparing said recipient's data with data included in said preliminary messages, selecting those advertisements whose content matches the recipient's interests, and storing access data of said selected advertisements;

a receiver of said advertisements coupled at said recipient's site to said one-way nonaddressable communication medium;

a recorder connected to said receiver of advertisements;

control means coupled to said selection means for obtaining said access data of said selected advertisements, and coupled to said receiver of said advertisements and said recorder for providing reception and recording of each selected advertisement at the time of its transmission as determined by said access data; and

means for presentation of advertisements coupled to said recorder for presenting recorded advertisements to recipient at a recipient's request.

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International News

support the plaintiff's broad interpretation.

(Business Line, 25 Nov 99)

A recent judgement by the European Court of Justice throws some light on the protection of a geographical indications as a trade mark. The plaintiffs, Windsurfing Chiemsee made use of the name 'Chiemsee' for the sale of sportswear since 1990. The plaintiff alleged that the use of this name by Huber and Mr. Attenberger, although having different graphic representation, is likely to cause confusion in the minds of the public because of its long use. The defendants argued that since Chimesee is an indication of geographical origin (a lake in South Germany) which must consequently remain available. Therefore, it is not capable of protection. Therefore, using it in a form different from Windsurfing cannot create any likelihood of confusion. The court held that when a mark has acquired distinctive character through use, the trademark will not be refused registration or be declared invalid. A trade mark will be deemed to have acquired distinctive character through use if it has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product or good from products or goods originating from other undertakings. In such a case, the geographical name has gained a new significance and its

Contd on...11

PCT Applications can be filed in all Branch Offices

The Department of Industrial Development, Ministry of Commerce and Industry has issued a Notification dated 19th November, 1999 whereby under Rule 20B of the Patents Rules 1972, related to the appropriate office in relation to international application under the Patent Cooperation Treaty (PCT) :

(1) The receiving office, designated office and elected office for the purposes of international applications filed under the Treaty shall be the appropriate office in accordance with the rule 4. (Earlier, the Calcutta Office of the patent Office was the only office for this purpose.)

(2) The Head Office of the Patent Office shall be the appropriate office for dealing with the International Bureau of the World Intellectual Property Organisation, International Searching Authorities and International Examining Authorities.

(3) An international application under the Treaty shall be filed and processed by the appropriate office in accordance with the provisions of this Chapter, the Treaty and the Regulations established under the PCT.

(4) On receipt of an international application, the appropriate office shall furnish complete details of such applications to the Head office of the Patent Office.

According to this Notification, the PCT application can be filed in any of the Patent Office

branches viz. Delhi, Mumbai, Chennai and the Head Office at Calcutta. All the Four offices, which include a Head Office and three Branch Offices, shall be regarded as the receiving office, designated office and elected office for the PCT application. The processing of such applications shall also take place at the respective office where the PCT application has been filed. However, the receiving office shall furnish all the details of the applications filed to the Head Office as a matter of procedure. Any type of correspondence dealing with WIPO, International Searching Authorities and International Examining Authorities, only the Head Office i.e. Calcutta Patent Office is authorized to undertake.

(Source ; *The Gazette of India, Part II, Section 3, 19 Nov. 99*)

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International News

connotation is no longer purely descriptive and justifies its registration as a trademark. In this respect, it is also important whether or not the geographical indication as such is very well known. In that event, a trademark will acquire a distinctive character only if there has been a long-standing and intensive use of the mark by the undertaking applying for registration. The court held the following to be of importance when assessing the distinctive character of a mark for which registration is desired:

- (a) the market share held by the mark,
- (b) how intense, geographically

widespread and long-standing the use of the mark has been,

- (c) the proportion of the relevant class of persons who, because of the mark, identify the goods as originating from a particular undertaking,
- (d) the amount invested by the undertaking in promoting the mark and statements from chambers of commerce and industry or other trade and professional associations.

(Windsurfing Chiemsee Vs Huber and Attenberger, European Court of Justice, May 4, 1999)

According to a recent report from British Invisibles (BI) on the international financial markets in the UK, 'other organisations' such as patent agents, contributed 201 million pounds out of the total 832 million pounds earnings generated per year in overseas from legal services within the UK.

(Patent World, Oct 99)

A US patent has been awarded to NASA for a welding technology, which provides a cheaper alternative to a laser or electron beam without sacrificing precision, speed and weld strength. The technology makes use of ternary gas plasma welding torch in addition to providing a more desirable heat-affected zone. This technology reduces weld defects, reduces welding times, enables the joining of thicker materials with relatively low heat inputs, and reduces dependency on an operator's skills.

(High-Tech Materials Alert, Vol 16 No 11, Nov 99)

PFC on the move...

1. Two more patent awareness workshops were organised during the month, in association with the Patent Information Centre, Punjab State Council for Science & Technology, Chandigarh. The first one was held at Thapar Centre for Industrial Research and Development, Patiala, on November 8, and while the second one was held at Guru Nanak Dev University, Amritsar, on November 29. The workshops had a participation of 170 scientists and technologists from various academic institutions, R & D institutions and industry.



(Workshop held in Patiala on November 8)



(Workshop held in Amritsar on November 29)

2. A patent application based on a novel rubber-silica composite was filed in India.
3. Updates of the four PFC documents, namely, Some Questions and Answers on Patents and Copyright: Sources of Patent Information and Patent Agents, Note on Patent Agents and Patent Application and Copyright Forms; and Lecture notes on Patents, were brought out.

Patents for Opposition

The number of applications published in the Gazette of India and notified for Opposition has increased considerably in last few months. Therefore, we are incorporating a supplement covering the Gazette of India from September 4 to November 27, 1999.

Please send us questions and topics you would like to see in the coming issues

NEXT ISSUE

- **PCT Fee Structure for Japan**
- **Case Study**
- **Patents for Opposition**

Published by: Patent Facilitating Centre (PFC)

Technology Information, Forecasting and Assessment Council (TIFAC)
Department of Science and Technology (DST),
Technology Bhavan, New Mehrauli Road, New Delhi - 110 016.

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Printed by Reliant Print O Graphics, New Delhi-110 020

Telefax: 692 4567, 692 9593