

Delhi High Court
Glaverbel S.A. vs Dave Rose & Ors. on 2 November, 2011
Author: A. K. Pathak
IN THE HIGH COURT OF DELHI AT NEW DELHI

+ CS (OS) 594/2007

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Reserved on: 29th September, 2011

Decided on: 2nd November, 2011

GLAVERBEL S.A.PLAINTIFF Through: Mr. Sudhir Chandra, Sr.

Advocate with Mr. Hemant

Singh, Ms. Mamta Jha and

Mr. Manish K. Mishra,

Advocates

Vs.

DAVE ROSE & ORS.DEFENDANTS Through: Mr. Rajeev K. Virmani, Sr.

Advocate with Ms. Pratibha M.

Singh, Ms. Bitika Sharma and

Ms. Surbhi Popli, Advocates

Coram:

HON'BLE MR. JUSTICE A.K. PATHAK

1. Whether the Reporters of local papers No may be allowed to see the judgment?
2. To be referred to Reporter or not? No
3. Whether the judgment should be No reported in the Digest?

A.K. PATHAK, J.

IA No. 12535/2011 (u/Sec. 151 CPC by Plaintiff)

1. By way of present application under Section 151 of the Code of Civil Procedure, 1908 (CPC for short), plaintiff seeks following three reliefs:-

CS (OS) No. 594/2007 Page 1 of 15 "(i) Certified copy of order dated 10th

September, 2009 passed by this Court in CS(OS) No. 593/2007 be taken on record;

(ii) Permit the claim so amended as claim in the present suit;

(iii) Plaintiff be permitted to place on record the certified copy of amended patent no. 190380 as and when received from the patent office."

2. Briefly stated facts of the case, relevant for the purpose of disposal of the present application, are that the plaintiff has filed this suit, inter alia, for permanent injunction to the effect that the defendants be restrained from manufacturing, selling and offering for sale copper free mirrors amounting to infringement of the plaintiff's patent registered under registration No. 190380. It is alleged that the plaintiff invented/developed and got patented "Mirox New Generation Ecological Mirrors" (MNGE mirrors for short) and launched the same in the month of September, 1998. In India patent was granted vide Registration No. 190380 after thorough examination by the experts in the Indian Patent Office. Mirror was manufactured by using environment friendly process without using copper or lead layer.

3. Claim No. 1, as contained in the registered patent of the plaintiff, reads as under:-

"1) A Mirror with no copper layer comprising:

i) a vitreous substance,

CS (OS) No. 594/2007 Page 2 of 15 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,

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

iv) at least one paint layer covering said silver coating layer."

4. The process of manufacturing the above referred product, as mentioned in Claim No. 1, had also been patented and details of the same have been provided in the registered patent, a certified copy whereof has been placed on record along with the plaint. Relevant claim nos. 9 and 10 in this regard reads as under :- "9. A process for the manufacture of a mirror as claimed in claim 1 said process comprising (i) sensitizing a surface of a glass substrate by bringing it into contact with a sensitizing solution and activating the surface in an

activating step, in which the surface is brought into contact with an activating solution, whereby the activating solution contains ions of at least one of the metals of bismuth (III), chromium (II), gold (III), indium (III), nickel (II), palladium (II), platinum (II), rhodium (III), ruthenium (III), titanium (III), vanadium (III) and zinc (II), (ii) a silvering step, in which said surface is brought into contact with a silvering solution and optionally comprising contacting the silver CS (OS) No. 594/2007 Page 3 of 15 coating layer with a solution containing ions of at least one of the group consisting of Cr(II), V(II or III), Ti(II or III), Fe(II), In(I or II), Sn (II), Cu(I) and Al(III) and/or contacting the silver coating layer with a silane; and

(iii) a step for covering the resulting silver layer with one or more protective paint layers;

10. A process as claimed in Claim 9, wherein, in said sensitization step said surface is contacted with a sensitizing solution comprising tin (II) chloride."

5. Plaintiff had filed CS(OS) No. 593/2007, against one Shri Anand Mahajan for permanent injunction praying therein that the defendant be restrained from infringing the Indian Patent No. 190380 of the plaintiff as also for rendition of accounts. In the said case, plaintiff also filed an application under Sections 57 and 58 of the Patents Act read with Section 151 CPC being IA No. 13519/2007 seeking amendment in the Claim No. 1. By way of amendment, plaintiff sought to insert "a sensitizing material, typically tin, and" at the beginning of clause (ii) of Claim No. 1. After the proposed amendment clause (ii) of Claim No. 1 reads as under:-

"(ii) a sensitizing material, typically tin, and 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,"

6. A Single Judge of this Court vide order dated 10th September, 2009 reported in 2009 (41) PTC 207 (Del.) titled AGC Flat Glass CS (OS) No. 594/2007 Page 4 of 15 Europe SA vs. Anand Mahajan and Ors. disposed of said application whereby allowed the aforementioned amendment. The operative portion of the order reads as under:- "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 Sections 58 and 59 of the Patent Act, 1970."

7. It is this order which is not only sought to be placed on record in this case but amended claim no. 1 is sought to be read in this case without amending the pleadings and the claim no. 1. It may be noted here that the necessary correction in the patent has yet not been carried out in the patent office, inasmuch as, the certified copy of patent obtained from the patent office on 17th March, 2010 contains unamended claim.

8. Learned senior counsel for the plaintiff has vehemently contended that the amendment in claim no. 1, as allowed vide order dated 10th September, 2009 passed in CS (OS) No. 593/2007, is CS (OS) No. 594/2007 Page 5 of 15 clarificatory in nature and does not alter the scope of invention. Claim nos. 9 and 10 of the same patent specifically mention about sensitization of the mirror by tin chloride. This fact was taken note of by the Single Judge while allowing the amendment. Clerical correction of claim no. 1 does not change the nature of the claim no. 1. Besides this, order of amendment is "in rem" and has attained finality and can be read in this case without amending the pleadings of this case. Correctness or incorrectness of the order dated 10th September, 2009 cannot be gone into in this case. Amended claim no. 1, in terms of order dated 10th September, 2009, can be read in all other proceedings without amending the pleadings in other cases. Defendants have understood the claim no. 1 as a copper free mirrors in which first step is sensitization with tin chloride. This is evident from the averments made in para nos. 17, 18 and 19 of the written statement. Defendants in their written statement, have taken a plea that a patent claim "sensitization by tin chloride" is not new, therefore, the patent is invalid. Defendants have also cited prior art like "Franz", "Shipley", "Orban" and "Buckwalter" in para 18 of the written statement and have stated that "sensitization by tin chloride" is an old concept. Thus, no formal amendment of pleading in respect of claim No.1 is required in this case. Defendants are not prejudiced in this case even if amended claim No.1, as contained in the order dated 10th CS (OS) No. 594/2007 Page 6 of 15 September, 2005 is read in this case. He has further contended that the whole purpose of opposing the present application by the defendants is to seek de novo trial. In other words, defendants will seek time to file amended written statement and recall of the plaintiff's witnesses for further cross examination. This will not do any good to anyone except that final adjudication will get delayed. In nutshell, contention of learned senior counsel for the plaintiff is that there is no need to amend the plaint. Learned Senior counsel has further contended that plaint is not required to be amended if not necessary. According to him existing pleadings are sufficient to indicate that defendant has understood the claim of plaintiff regarding sensitization by tin of the mirror manufactured by it. Subsequent event of amendment in claim No.1 can be taken note of in this case without amending the pleadings of this case. Reliance has been placed on Popat and Kotecha Property vs. State Bank of India Staff Association (2005) 7 SCC 510, Manoj Beharilal Mathur vs. Shanti Mathur AIR 1997 SC 2153, U.P. State Roadways Transport Corpn. Vs. Mrs. Shanti Devi and others AIR 1997 Del 342, A.K. Jain vs. Prem Kapoor 2008 (8) SCC 593, Hyundai Corporation vs. Rajmal Ganna 2007 (35) PTC 652, Rameshwar Lal and Anr. Vs. Raghunath Das and Ors. 1990 (4) SCC 729 and Central Academy Society School vs. Raj Kumar Ganjur AIR 2003 All 194"

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9. Per contra, learned senior counsel for the defendants has contended that the plaintiff is seeking amendment in claim no. 1 without amending the pleadings, which is not permissible under the law. He has further contended that in the order dated 10th September, 2009 it has been categorically mentioned that the amendment does not attract the provisions of Sections 58 and 59 of the Patents Act; meaning thereby amendment in claim no. 1 was not allowed under the said provisions of Patents Act. Accordingly, amendment can be read only in CS(OS) No.593/2007 and not in other proceedings. Amendment in claim no. 1 permitted by the Court was not recorded in the Patent Office. Certified copy of the Patent Ex.PW1/3 has been issued by the Patent Office in the month of March, 2009, which does not contain amended claim no.1. This indicates that amendment was not allowed under Sections 58 and 59 of the Patents Act. Amendment could at best be read as an amendment of claim No.1 in that particular suit and not in patent records. Learned senior counsel further submits that plaintiff has to amend claim no. 1 in this case and for the said purpose he has to file appropriate application under Order 6 Rule 17 CPC seeking amendment in claim no.1 which application is, otherwise, not permissible in this case as the trial has already commenced, inasmuch as, plaintiff's witnesses have already been cross-examined. The only contention acceptable under the law is that a CS (OS) No. 594/2007 Page 8 of 15 can be amended after the start of trial when the plaintiff had exercised due diligence and in spite of that he could not seek the amendment earlier. In the instant case, plaintiff was well aware of the order dated 10th September, 2009; whereas plaintiff's evidence was concluded in this case on 21st July, 2011, much thereafter. In any case even if such an amendment is permitted in the present suit the defendants have to respond to such amendment by filing amended written statement, inasmuch as, have to cross examine the plaintiff's witnesses on this point. Learned senior counsel for defendant has further contended that the plaintiff cannot be allowed to bring on record the amended claim no. 1 in this case indirectly so as to prejudice the defendants. Under the Patents law a patent can be obtained either in a product and/or in a process. Claims Nos.1 to 8 in the suit reflect product patents; whereas claim Nos. 9 to 20 are the process patent. By adding tin in the product claim no. 1, the plaintiff is trying to expand its monopoly even in a product having layer of tin by way of such amendment, which is not permissible under the law. Reliance has been placed on Electric and Musical Industries Ltd. and Boonton Research Corporation Ltd. Lissen, Ltd. And another 1939 (46) RPC 23.

10. I have considered the rival contentions of both the parties and I am not able to persuade myself to accept the contention of learned senior counsel for the plaintiff that the amendment in claim no. 1, CS (OS) No. 594/2007 Page 9 of 15 as permitted in CS (OS) No. 593/2007, can be read in this case without amending the pleadings of this case. It is well settled that a case is decided on the facts involved therein as are emerging from the pleadings duly proved by the evidence adduced in support thereof. No judicial notice of the facts emerging from the pleadings and the evidence led in some other case can be taken for deciding the controversy between the parties in a different case. It is the fact pleaded and the evidence led in that particular case alone which has to be considered. Judicial pronouncements can be referred to at the bar in support of a legal proposition but the facts involved therein cannot be read as the facts of such cases where such reports are referred. Subsequent events can be considered only if the same are brought on record by seeking necessary amendment in the pleadings and not by noticing the same from the facts emerging from the pleadings and the documents of other cases, which may have been referred to in the reports. Even though plaintiff is at liberty to refer and rely on the order dated 10th September, 2009 passed in CS (OS) No. 593/2007 in support of law laid down therein but the fact remains that the amended claim no. 1 cannot be read in this case. Judgment has to be pronounced in this case on the pleadings and the evidence adduced i.e. either documentary or ocular, in this case. It appears that plaintiff was conscious of this fact and for this reason only plaintiff had CS (OS) No. 594/2007 Page 10 of 15 expressed its desire to amend the pleadings initially, as is evident from the perusal of order dated 5th February, 2010. However, subsequently, on 3rd May, 2010 counsel made a statement that he does not intend to file any application for amendment. Consequently, issues were framed. Merely because amendment of the pleading would result in delay in disposal of the suit by itself cannot be made a ground to adopt a shortcut by reading the amended claim No.1 as permitted in CS (OS) No. 593/2007 in the present case, without amending the pleadings. Plaintiff cannot be permitted to achieve its objective of amending the claim no. 1 in this case indirectly.

11. If the matter is viewed from another angle then also the course adopted by the plaintiff cannot be permitted. Amendment in claim no. 1 as allowed in CS (OS) No. 593/2007 has yet not been recorded by the Patent Office in its record. Certified copy of patent, issued by the Patent Office after more than 6 months of the order dated 10th September, 2009, contains unamended claim no.1. It is this certificate which has been placed on record in this case and has been proved. Plaintiff also contains unamended claim. Evidence led by the parties, which is in consonance with the pleadings of the parties, alone can be read at the stage of final adjudication of the matter. There is no gainsaying in reiterating that evidence led beyond the pleadings cannot be looked into. Accordingly, the CS (OS) No. 594/2007 Page 11 of 15 amended claim no. 1 cannot be read in this case without plaintiff taking necessary steps to get the claim amended in this case as well.

12. Judgments relied upon by the plaintiff are in the context of different facts and are of no help. In none of the reports it has been laid down that facts emerging from the pleadings and evidence led in a case can be read in other cases. In Popat and Kotecha Property (supra), Order 7 Rule 11 CPC was under scrutiny and in this context Supreme Court held that the plaint has to be read as a whole and not just a part of it. In Manoj Beharilal Mathur (supra), it was held that plaint is not required to be amended, if not necessary. If issues can be decided on existing pleadings and documents, no amendment in pleading is necessary. In the said case a suit was filed for declaration to the effect that Dr. Shanti Mathur was a benamidar and the property belonged to joint family, therefore, she had no right, title and interest in the plaintiff scheduled property. Subsequently, an application for amendment of plaint was filed on the ground that Dr. Shanti Mathur was a trustee of the property for and on behalf of the plaintiffs. This application was rejected by the Trial Court as well as the High Court. In this context, Supreme Court held that it was open to the plaintiffs, even without resorting to amendment of the plaint, to press their arguments based on the legal effect of the benami transaction and CS (OS) No. 594/2007 Page 12 of 15 that Dr. Shanti Mathur is a trustee of the property for the benefit of the joint family. Since legal issue was involved, it was held that no express amendment was required. However, in this case, amendment on factual aspect allowed in a different case is sought to be read as part of the present suit, which course is not permissible under the law. In A.K. Jain (supra), landlord had filed an eviction petition on the ground of bonafide requirement. During the pendency of the petition landlord retired from service. This fact was not brought on record. Supreme Court held that the factum of retirement was not in dispute and could have been taken note of even without a formal amendment of the pleading. In Hyundai Corporation (supra), plaintiff had brought the case on the plea of infringement of registered trademark but based on registrations in the names of Group companies. During the pendency of the matter plaintiff acquired proprietary rights in its own name by virtue of registration of trademark in different classes effective from dates much prior to filing of the suit. It is in this context, while deciding an application under Order 39 Rule 1 and 2 CPC, it was observed that court can take cognizance of a subsequent event without amendment of pleadings. In Rameshwar Lal (supra), landlord had filed an eviction petition on bonafide requirement of comparative hardship but the same was not specifically pleaded, however, evidence of hardship was already on record. In these facts, it was CS (OS) No. 594/2007 Page 13 of 15 held that amendment was not required since evidence of hardship was already on record. In Central Academy Society School (supra) also, it was held that no amendment was necessary. In the said case sufficient material was on record to indicate the amount of rent deposited in court, thus, it was held that no amendment of pleading was necessary. However, facts involved in this case are totally different. Amendment of claim no. 1 has not been sought in this case nor such amendment is supported by the certified copy of patent issued by Patent Office. Only after amendment is recorded in the Patent Office it will amount to notification of amended patent to all concerned and can be said in *remâ*. The pleadings of this case as also the documents placed on record are with regard to unamended claim. Without seeking amendment of claim no. 1 in this case plaintiff seeks to refer and rely upon the amended claim no. 1 in different suit, which is not permissible, in view of the discussions made hereinbefore.

13. For the foregoing reasons, I am of the view that plaintiff though can refer the order dated 10th September, 2009 passed in CS (OS) No. 593/2007 at the time of hearing but same cannot be permitted to be taken on record as a document so as to read the amended claim No.1, in this case. Amendment in claim no. 1, as permitted in CS (OS) No. 593/2007, cannot be read as amended claim No.1 in this case. As regards permission to the plaintiff for CS (OS) No. 594/2007 Page 14 of 15 placing on record certified copy of

amended patent no. 190380 as and when received from the Patent Office, the same also cannot be granted at this stage. However, plaintiff is at liberty to file appropriate application as and when he receives the certified copy from the Patent Office.

14. Application is disposed of in the above terms. I.A. No. 13631/2011 (u/Sec. 151 CPC by Defendants) In view of disposal of I.A. No. 12535/2011 this application has become infructuous. Accordingly, application is disposed of as infructuous.

A.K. PATHAK, J.

November 02, 2011

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