

Intellectual Property advocacy in the fields of:

- IP Infrastructure
- IP Valuation
- M & A
- IP Policy
- Technology Transfer
- Innovation Research
- Patent Law
- Licensing
- Data Management
- Copyright
- Collaborations
- Balance for Rights & Obligations

For Private Circulation Only

## WISHING YOU ALL A VERY HAPPY, CRACKERLESS, SMOKELESS, PEACEFUL, SAFE & HEALTHY DIWALI 2020



### A Ray of Light

On 2nd November, 2020 Hon'ble Mr. Justice Rajiv Shakhder of the Delhi High Court passed a remarkable order in Dapagliflozin infringement suit giving big boon to patients and big boost to generics. Just like in the case of Erlotinib wherein Hon'ble Mr. Justice Ravindra Bhat took into consideration "public interest", Hon'ble Mr. Justice Rajiv Shakhder also endorsed "public interest" while noting the difference in prices of drugs ranges between 250% to 350%. Hence, Defendants were allowed to manufacture and market generics which would be far cheaper. The Court also noted the admission by the Plaintiff in several paragraphs of the Plaint including the Prayer that Dapagliflozin was covered by the claims of genus patent IN'147. Hence, the entire principal claim of IN'625 is vulnerable to revocation.



**Justice Rajiv Shakhder**

While refusing to grant interim injunction against Intas Pharmaceuticals Limited And Alkem Laboratories Limited, the Defendants were directed to place on Court's record every quarter the details, quantum, and value of drug manufactured and sold as also indirect and direct taxes paid in that behalf.

Source: <http://delhihighcourt.nic.in/index.asp>



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## Patents (Amendment) Rules, 2020

The Indian Patent Office published Patents (Amendment) Rules, 2020 on 22<sup>nd</sup> October, 2020. These rules have amended Rule 21 relating to Priority Document and Rule 131 relating to '*Statement Regarding The Working Of Patented Invention(S) On A Commercial Scale In India*' on Form 27. Pursuant to the amendment of Rule 131, the Patentee as well as any of the Licensee will have to individually furnish statement on Form 27 for every financial year (as against earlier calendar year) and the same is to be submitted within six months from the expiry of each such financial year (as against earlier first quarter). However, Co-Patentees may file jointly file Form 27. Further, Patentee no longer has to submit information on whether reasonable requirement of the public are being met.

Source: <http://www.ipindia.nic.in/newsdetail.htm?713>

## Delhi High Court invites comments on draft of the proposed

### “The High Court of Delhi Rules Governing Patent Suits, 2020

The Delhi High Court Patent Rules, 2020 shall govern the procedure for adjudication of all patent suits. The Rules shall govern all patent suits and actions and the procedure set out in these Rules shall prevail over the Delhi High Court (Original Side) Rules, 2018, insofar as they are inconsistent with the Delhi High Court (Original Side) Rules, 2018. The present Rules are in addition to and not in derogation to the provisions of Code of Civil Procedure, 1908 and the Commercial Courts Act, 2015 as may be applicable to Patent suits (substantive provisions contained in The Patents Act, 1970.) and actions.

Source:

[http://delhihighcourt.nic.in/writereaddata/Upload/PublicNotices/PublicNotice\\_G3SK9Q0PX99.PDF](http://delhihighcourt.nic.in/writereaddata/Upload/PublicNotices/PublicNotice_G3SK9Q0PX99.PDF)



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### Intellectual Property response to the COVID-19 pandemic at the WTO

On 15-16 October, 2020 some 40 members engaged in a substantive discussion on a proposal submitted by India and South Africa for a temporary waiver of certain TRIPS obligations they said would facilitate an appropriate response to COVID-19. The proposal suggests a waiver for all WTO members on the implementation, application and enforcement of Sections 1, 4, 5, and 7 under Part II of the TRIPS Agreement in relation to the “prevention, containment or treatment” of COVID-19. India and South Africa proposed *“WTO Members to work together to ensure that intellectual property rights such as patents, industrial designs, copyright and protection of undisclosed information do not create barriers to the timely access to affordable medical products including vaccines and medicines or to scaling-up of research, development, manufacturing and supply of medical products essential to combat COVID-19”*.

While a number of developing and least developed country members welcomed the proposal as a contribution to the discussion, many were still studying it in their capitals and asked for clarification on certain points, particularly regarding its practical implementation and the possible economic and legal impact of the waiver at national level. A number of developing and developed country members opposed the waiver proposal, noting that there is no indication that intellectual property rights (IPRs) have been a genuine barrier to accessing COVID-19 related medicines and technologies. UK has responded by stating that *“Beyond hypotheticals, we have not identified clear ways in which IP has acted as a barrier to accessing vaccines, treatments, or technologies in the global response to COVID-19. A waiver to the IP rights set out in the TRIPS Agreement is an extreme measure to address an unproven problem.... There are existing mechanisms that facilitate the sharing of IP through voluntary licensing of intellectual property... For example, expanding the mandate of an existing organisation such as the Medicines Patent Pool to address needs emerging from COVID-19.”*

Given this range of positions, the Council chair, Ambassador Xolelwa Mlumbi-Peter of South Africa, said that the item would remain suspended as members continue to consider the proposal. It was agreed to revert to this agenda item at the next meeting of the Council so that these exchanges can continue, including on the basis of the updated Secretariat document of COVID-19 related IP measures.

Source: [https://www.wto.org/english/news\\_e/news20\\_e/trip\\_20oct20\\_e.htm](https://www.wto.org/english/news_e/news20_e/trip_20oct20_e.htm)  
<https://docs.wto.org/dol2fe/Pages/SS/directdoc.aspx?filename=q:/IP/C/W669.pdf&Open=True>  
<https://www.gov.uk/government/news/uk-statement-to-the-trips-council-item-15>

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### **Costs and bailable warrant against Defendant in Patent Suit**

In Pfizer Inc & Ors Vs. Ank Pharma/ Life Care Medicos & Ors., Hon'ble Delhi High Court passed order against defendants 2 and 5 for recovery of costs of the suit with professional fee and expenses, besides court fees, assessed at Rs.5,00,000/-. On previous date, the Hon'ble Delhi High Court also issued bailable warrants in the sum of Rs. 50,000/- for production of one of the Defendants before the Court. In the same suit, Hon'ble Delhi High Court also allowed the Plaintiff to enhance the valuation of the suit for the purpose of jurisdiction from Rs 1 Crore to Rs 2,00,00,600/-. Hence, the case was not liable to be transferred to subordinate court due to pecuniary jurisdiction.

### **Hon'ble IPAB restores Patent lapse caused due to the mistake of Patent Agent**

In OA/18/2014/PT/KOL, Hon'ble IPAB restored the lapse of Patent which was caused due to the mistake of the Patent Agent. Hon'ble IPAB held that the Appellant has been wrongly deprived of its rights, without any fault on its part. Hon'ble IPAB also held that the Patent Office was not correct in holding that there is no provision in Act and Rules to condone or extend the time limit for filing an application for restoration. That under Section 60 of the Act, the Controller may allow an application for restoration of lapsed patent filed even after eighteen months from the date on which the patent ceased to have effect. It is settled law that party who has a bona fide conduct should not suffer due to mistake committed by his advocate/attorney [sic].

Source: [https://www.ipab.gov.in/ipab\\_orders/kolkata/OA-18-2014-PT-KOL.pdf](https://www.ipab.gov.in/ipab_orders/kolkata/OA-18-2014-PT-KOL.pdf)

### **Hon'ble IPAB allows appeal and passes order for grant of Patent**

In OA/2/2016/PT/MUM, Hon'ble IPAB allowed appeal filed against the revocation of grant of Patent by the Indian Patent Office pursuant to a Post-grant opposition. The subject Patent was earlier rejected vide order dated 09/06/2011 and subsequently, the Review Petition was also rejected vide order dated 27/03/2014.

Source: [https://www.ipab.gov.in/ipab\\_orders/mumbai/OA-2-216-PT-MUM.pdf](https://www.ipab.gov.in/ipab_orders/mumbai/OA-2-216-PT-MUM.pdf)

