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## EDITORIAL

### INCREASE IN CASES OF REMITTANCE/RETURNS TO CONTROLLER BY HIGH COURTS

The office of the DPIIT (Department for Promotion of Industry and Internal Trade) and the Indian Patent Office, under the office of the CGPDTM (Controller General of Patents, Designs and Trade Marks), have been taking effective steps to recruit Patent Examiners ever since the "Nitto-Denko" case-based committee's recommendations were implemented in 2016. Consequently, the number of newly appointed Controllers has been increasing in recent years. While the senior Controllers in the Indian Patent Office have gained knowledge and status on par with international Patent Offices such as JPO, USPTO, and EPO, they are making well-reasoned decisions for grant or rejection. However, the newly promoted, relatively less experienced Controllers are issuing distressingly distorted or deficient orders of rejection, often without proper reasoning or on narrow technical deficiencies or grounds. They frequently fail to distinguish prior art from inventive features.

The current trend of rejections by the newly appointed controllers needs to be reversed or revisited by the Controller General's office or DPIIT. The Indian Patent Act (Patent Act, 1970) has very stringent provisions such as Section 3 (a) to (p) (inventions not patentable). As such, it is extremely difficult to get a patent granted in India. The patentability criteria of Novelty and 'Inventive Step' are to be applied on a fair and reasonable basis. This is practiced by experienced Examiners and Controllers. Furthermore, there are technical grounds such as requests for condonation of delay or requests for filing additional supporting documents. Once the Controller asks the Client (or Patent Agent) to file such requests along with the payment of fees, it is reasonable to expect him/her to accept the request once the fees are paid as per his order. Of late, the newly promoted Controllers are rejecting such requests even after they themselves have asked the applicant to file with payment of fees.

Such rejections are challengeable in the High Court. However, Indian inventors, start-ups, and/or Indian MSME Applicants don't have the deep pockets to pursue an Appeal in High Courts against such perverse orders. Invariably, the High Court comes down heavily on such orders of controllers and remits the rejection back to the same controller or another. Many rejections of Patent Applications have been sent back to the patent office by High Courts in recent times. Few recent cases are cited herein;

#### 1. **Mitsubishi Case:**

Patent Application no. 6745/CHENP/2015 was rejected by the Controller for alleged lack of "inventive step" and "lack of unity of invention". The High Court came down heavily on the Controller for not considering valid supportive evidence for inventive step/unity of invention and for issuing an order in the absence of any reasoning to support the by the Patent office.

#### 2. **Saint-Gobain**

In another case, Saint-Gobain's patent application no. 2458/DELNP/2013 was rejected by the Controller for lack of inventive step and the claim amendments being out of scope of the claimed invention. The Delhi High Court remanded the matter back to the controller to take a fresh look and issue for grant through a reasoned order within four weeks.

#### 3. **MAN Truck & Bus SE:**

Similar to many other cases, this case relating to Patent Application no. 1241/DEL/2009 was rejected by the Controller for lack of inventive step, through

an order which was not well-reasoned. The rejection order had not made any analysis to establish obviousness or lack of inventive step. The Application was remanded back to the Controller for reconsideration and to issue a fresh order based on the evidence and arguments adduced.

In recent times, a large number of patent applications by Indian Applicants are being rejected on technical grounds, even after payment of fees with requests, in spite of the fact that the applicant had acted in consonance with the order of the Controller. Furthermore, orders for rejection are being issued increasingly without adequate analysis, through unreasoned orders. Indian applicants cannot afford to challenge such orders in High Courts due to financial constraints. It is requested that DPIIT and the office of the CGPDTM will look into these aberrations and take corrective steps.

#### 4. **Star Scientific**

##### **Controllers must issue "Reasoned Order".**

Even if a patent application is rejected on technical grounds, such as not attending the hearing (for whatever reason), the Controller requires to issue a "Reasoned Order" and not a crisp order as in this case.

In this unique case, the Applicant is a global corporation, leader in hydrogen research. Their PCT Application No.PCT/AU2018/050895 led to grant of patents in nine other countries. Indian Patent Application No.202017011947 was followed up by a request for examination on 25<sup>th</sup> June 2021.

FER was issued on 23rd August 2021 and hearing was called for on 8th December 2023. The Patent Agent (on behalf of the Applicant) did not attend the hearing. When the Controller sought reason for not attending, the Agent informed the Controller that “financial difficulties” led to not attending the hearing. The Controller issued a crisp rejection order as follows.

## **DECISION**

Hearing Notice has been served to the agent for the applicant on 23.11.2023 and it was scheduled on 08.12.2023. The Agent of the Applicant did not attend the pre-scheduled hearing on the stipulated date as mentioned in the above. Therefore, all the objections raised in the hearing notice still remain outstanding.

## **ORDER**

“Hence, based on above facts and submissions, I hereby refuse to proceed further with this instant patent application number 201017011947 for grant of patent in accordance with Section 15 of the Patents Act, 1970 (as amended).

The Learned High Court of Delhi issue the following order (among other points) after hearing the parties and extensively analyzing the issues involved”.

### **Learned Delhi High Court Judgement**

“In the facts and circumstances of the present case, the impugned order dated 18th December 2023 passed by the Learned Controller cannot be sustained and is liable to be set aside.

Accordingly, the matter is remanded back to the respondent for fresh consideration”. This is one more example of rash/rush decisions (within 10 days of hearing) which led the High Court to send it back for fresh review and reasoned spoken orders.

### **Finally, USA moves to curb “patent evergreening”**

US Lawmakers have unanimously passed an Act (S-150) to restrict the number of pharma patents on any single drug. “Pharma hopping”, a practice of running down or forcing non-use of old patent-expired drugs by supporting prescriptions of newly patented drugs. The move can best be summarized as follows:

The US Senate has passed a bill that aims to prevent pharma companies from filing multiple patents around biologic drugs as a way to delay biosimilar competitors.

The bill is named Affordable Prescriptions for Patients Act of 2023 (S-150)

S-150 would limit the number of patents a pharma company can assert on a drug.

The bill authorises the Federal Trade Commission (FTC) to enforce the prohibition and imposes limits on patent litigation involving biological products.


In addition, the bill includes measures intended to curb “product hopping”, when a manufacturer winds down production of an old drug and forces patients to switch to a newer, in-patent version.

## Trade Marks Agent Examination 2025& Patent Agent Examination 2025

The Indian Patent Office has announced the schedule for the upcoming Trade Mark Agents Examination and Patent Agents Examination. The Trade Mark Agents Examination is set to take place on 4th January, 2025, while the Patent Agents Examination will be held on 5th January, 2025.

Below, you will find the link to the comprehensive guidelines for the online application process for both the Trade Marks Agent Examination and the Patent Agent Examination. These guidelines provide essential information regarding eligibility criteria, application procedures, important deadlines, and any required documentation.

[https://ipindia.gov.in/writereaddata/Portal/News/991\\_1\\_online\\_application\\_guidelines\\_2025.pdf](https://ipindia.gov.in/writereaddata/Portal/News/991_1_online_application_guidelines_2025.pdf)

<b>Patent Agent Examination (PAE) 2025 and Trademarks Agent Examination (TAE) 2025</b>		
	<b>Patent Agent Examination</b>	<b>Trademarks Agent Examination</b>
<b>Date of Examination</b>	January 5, 2025 (Sunday)	January 4, 2025 (Saturday)
<b>Syllabus</b>	<ul style="list-style-type: none"><li>•The Patents Act, 1970,</li><li>•The Patents Rules, 2003,</li><li>•The Designs Act, 2000,</li><li>•The Designs Rules, 2001 and</li><li>•Matters related to IP Jurisprudence</li></ul>	<ul style="list-style-type: none"><li>•Trade Marks Act, 1999 &amp; Trade Marks Rules, 2017(as amended),</li><li>•The Geographical Indications of Goods Act, 1999,</li><li>•The Geographical Indications of Goods Rule, 2002 and</li><li>•Matters related to IP Jurisprudence</li></ul>
<b>Exam Format</b>	<b>Two papers</b> <ul style="list-style-type: none"><li>• Paper I: Objective (2 hours)</li><li>• Paper II: Descriptive (3 hours)</li></ul>	
<b>Location</b>	13 Locations across India: Ahmedabad, Bangalore, Bhopal, Chandigarh, Chennai, Delhi, Guwahati, Hyderabad, Kolkata, Lucknow, Mumbai, Nagpur and Thiruvananthapuram.	
<b>Online registration: July 8, 2024 (noon) to August 8, 2024 (5:30 PM)</b>		
Please check the eligibility criteria before applying		

We complement the DPIIT and the CGPDTM for regularly and annually conducting the Patent and Trademark Agents examination