

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

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## EDITORIAL

In his “Mann ki Baat” on 26th November 2023, Hon’ble Prime Minister, Shri Narendra Modi emphasized on the role of innovation and patents and highlighted the magnificent growth in Patent filings and grant in India. This is a most deserved acknowledgement of the contribution of Prof (Dr.) Unnat Pandit, the Controller General of Patents, Designs & Trade Marks in India. Under the emerging and surging leadership even the WIPO has been awakened and is motivated to work in tandem with the Indian IP office. Much more needs to be done and achieved for which legislative and executive support is essential and needs to be extended timely and extensively.

Link for “Film Screening Event - Tribute to Dr. Yusuf Hamied” <https://youtu.be/RQ1Tcl5IZEs>

Over the years and more recently, the High Courts have been sending back for review and for re-examining many cases, where patent applications are rejected on technical or “irrational” grounds. The Patent Office will need to set up a legal cell to advise the arguing counsels on technical aspects field wise. Even the Competition Commission of India (CCI) is expecting Patent Office to handle global issues more diligently. Recent High Court cases, where jurisdictions for filing appeals on patent orders (Dr. Reddy’s Labs vs UOI) have been challenged especially in view of Rule 4 of Patent Rules (Appropriate Office). Such orders call for reviewing not only the Rules but also the Patents Act, 1970. Dust seems to have settled over the proposed (draft) Patent Rule Amendments, 2023, which put forth hitherto unforeseen provisions such as opposition fees to be paid on the total of all official fees paid by the patent applicant.

It is almost impossible for a third party to accurately determine all the fees paid by an applicant for various office actions including in domestic and international jurisdictions. While the objective appears clear, the road map is full of pot-holes.

The Patents Rules, 2003 could receive attention in more specific areas. With all the hue and cry over pre-grant and post-grant oppositions in recent times, it may be noted that neither the Act nor the Rules define “pre-grant opposition” or “post-grant opposition” or even “opposition” to patent application. The only reference among definitions is to the Opposition Board. If at all the need for reducing the workload and speeding up the grant of patents (without increasing the team of examiners) is being felt, it may be a far better idea to table a Bill in Parliament for amendment to status-quo-ante as in 24th December 2004 Bill, where there was only post-grant opposition and no pre-grant opposition. A provision for filing “third party observations” as in most of the overseas patent jurisdictions could be introduced in place of “pre-grant opposition”, which provision was introduced as Sec. 25(1) on the floor of the Parliament.

Amendments to the Act and Rules may be proposed to meet and catch up with the advances in the

electronic and digital online filings in various sections and Rules especially starting the filing jurisdictions for patent applications have become irrelevant since almost all dust seems to have settled over the proposed (draft) Patent Rule Amendments, 2023, which put forth hitherto unforeseen provisions such as opposition fees to be paid on the total of all official fees paid by the patent applicant. Filings of patent applications are done online and goes to the central server and gets allotted for examination randomly to any one of the four (now five) Patent Offices in India. Design applications are examined only in Kolkata and Copyright applications are handled from Delhi. Occasional physical hearings are happening from respective TM Offices. It may be appropriate if Rule 4 “Appropriate Office” is amended suitably to reflect the ground (or digital) realities.

### **“shall ordinarily”**

The phrase “shall ordinarily” is incorporated in the Patents Act, 1970 for every timeline associated with any office action by the Patent Examiner or Controller. However, these timelines are “extra-ordinarily” extended in most actions expected from the Patent Office. While some patent applications (of course with Form 18A) gets granted in 6 to 8

months, there are patent applications pending for grant up to 6 to 8 years. This anomaly needs to be rectified once for all by allotting older cases to be handled on priority basis by a group of examiners in any one Patent Office.

To conclude, the revamped Indian Patent Office (and IPINDIA as a whole) have been making excellent progress. More logistic and infrastructure support (including HR) is required to be extended on a timely manner. The current, vibrant CG is fully capable of pulling up all concerned and putting up this vision through appropriate action asap. In line with the progress India is making in innovation and IP, basic minimum required legislative support is also needed to be extended, immediately after Lok Sabha elections in 2024, if not earlier.

## IP (Patent, TM & GI) related

### Decisions from High Court

- ★ In Ischemix LLC vs. Controller of Patents 22-11-2023  
the Delhi High Court held that “chemical data can be submitted (to justify enhanced bioavailability to overcome Sec.3(d) objection by the Controller) during the patent prosecution since drug development is a lengthy and complex process” and requires long time to complete and obtain results of

clinical trials. The Hon’ble Justice Prathiba Singh ordered the Controller to take the data on record and review objections to Sec.3(d) over need for enhanced efficacy.

- ★ Criteria and timelines for filing Divisional Applications have been subject of appeals over rejections by Patent Controller. Courts had taken divergent on this. Need for “plurality of inventions” to be disclosed in the Complete Specification vis-à-vis Provisional Application was recently settled by the Division Bench on appeal in the case of “Syngenta vs. Controller of Patents” (13-10-2023). It was held that Divisional Application will be “maintainable provided the plurality of inventions is disclosed in the provisional or complete specification that may have been filed”.
- ★ Granting relief to the Apollo group, the Madras High Court (Justice Abdul Quddhose) recently observed that the trademark “Apollo” was a well-known mark in the healthcare and pharmaceutical industry and was entitled to highest level of protection as the public associated the name “Apollo” only with the healthcare group. Further, permanent injunction granted restraining the defendant from infringing the registered trademarks of the plaintiff including

‘Apollo’, ‘Apollo Hospitals’, Apollo Diagnostics’ and ‘Apollo Clinic’ and its variants by using the ‘New Appolo Hospital’ and/or any other marks identical and /or deceptively similar mark in any manner whatsoever (20-11-2023)

★ Basmati Rice Geographical Indication Dispute (Trading Corporation of Pakistan Pvt Ltd vs. Government of India Ministry of Commerce and Industry) Dismissed for non-prosecution by Justice Prathiba M. Singh (28-11-2023).

### Latest IP News

★ India and France IP Offices have signed the biannual work plan for taking strategic initiatives for strengthening the IP Administration and offer benefits of IP for amplifying the impact of Indo-French business linkages.

[https://www.linkedin.com/posts/unnatpandit\\_india-and-france-ip-offices-have-signed-the-activity-7136279706760298496-TI5u?utm\\_source=share&utm\\_medium=member\\_desktop](https://www.linkedin.com/posts/unnatpandit_india-and-france-ip-offices-have-signed-the-activity-7136279706760298496-TI5u?utm_source=share&utm_medium=member_desktop)

★ 314% Growth in Patent grants. India achieved the highest ever Patent grant this year in 07 months of current FY. Journey is still ON to create a landmark this year by March 2024.

<https://www.youtube.com/watch?si=WKCbu1mkQNAKJWlh&v=2C6tmN954Qg&feature=youtu.be>

★ Indian Patent Office to employ 900 individuals: DPIIT Secretary - ET Govt

<https://icobbe.com/indian-patent-office-to-employ-900-individuals-dpiit-secretary-et-govt/>

★ Record Number of Patent Applications filed Worldwide in 2022! Main Contributors are Indian and Chinese Innovators

[https://www.linkedin.com/posts/meta-yage-ip-strategy-consulting\\_ip-news-activity-7135263487164891136-60a3?utm\\_source=share&utm\\_medium=member\\_desktop](https://www.linkedin.com/posts/meta-yage-ip-strategy-consulting_ip-news-activity-7135263487164891136-60a3?utm_source=share&utm_medium=member_desktop)