

# **The Patent Ordinance, 2004 – the law must be further augmented**

**Presentation at**

**CII/NIPO Panel Discussion**

**March 9, 2005**

## **In my view the following issues require (re) consideration**

- (1) Pre-grant Representation (opposition) system
- (2) Foreign Filing License
- (3) Working Requirement – obligations
- (4) Dateline for Publication and RFE
- (5) Re-Publication of PCT Application
- (6) Patentable subject matter – computer software inventions
- (7) Non-Patentable subject matter Method of Treatment
- (8) Patentable Subject Matter – second medical use or new use

# **Pre-Grant Representation System & Post-grant Opposition**

**As per the Ordinance the heading of the new Chapter V is “REPRESENTATION AND OPPOSITION PROCEEDINGS”**

**That means we are talking about a Representation system prior to grant like the one available under the EPC**

**\* Look at the title of the new Rules – it says “Opposition by Representation”!**

**\* Section 25(1) as amended by the Ordinance enables any “person” not “person interested” to file Representation.**

# **No Representation – It is “Pre-Grant Opposition”!**

- \* **The Ordinance makes it a “a Proceedings by way of Representation” – that the Controller of Patents may consider during the Examination of a patent application**
- \* **The Rules, however, makes it an evidentiary proceeding. It mandates that the person making the “Representation” must submit a statement in support of his case supported by evidence!**
- \* **The person submitting the Representation (rather mooting the Opposition) has the right to be heard!**

## **Section 25(1) of the Ordinance**

- \* If the answer is that the Controller will give the Applicant a chance to do all that – then what is the difference between the new system and the opposition proceeding which was already available.**
- \* Then what is the sanctity of having a post-grant opposition again. You give a person twice the same right in law to oppose a patent application and then again a patent!**
- \* Note here that the third person has two more rights – first to get the patent revoked and secondly to raise a counter claim of invalidity of patent in action for infringement**

# Working Statement

It seems we look at the 'entire' institution of patents from the narrow perspective of pharmaceutical and chemical inventions.

The Ordinance amended Section 122 of the Patents Act, 1970. As per the amended provision if a Patentee does not file a Working Statement the penalty is **Ten lakh Rupees!**

Now how should one file a Working Statement – in Form 27. Look at the form.



## **Need to move beyond pharma – at least in drafting the Act and the Rules**

**In many areas of technology (as for example telecommunications) it is rather impossible to individuate inventions and quantify the “quantum and value” of the patented product. A clear case of having ‘pharmaceutical inventions on top of the draftsman’s mind!!**

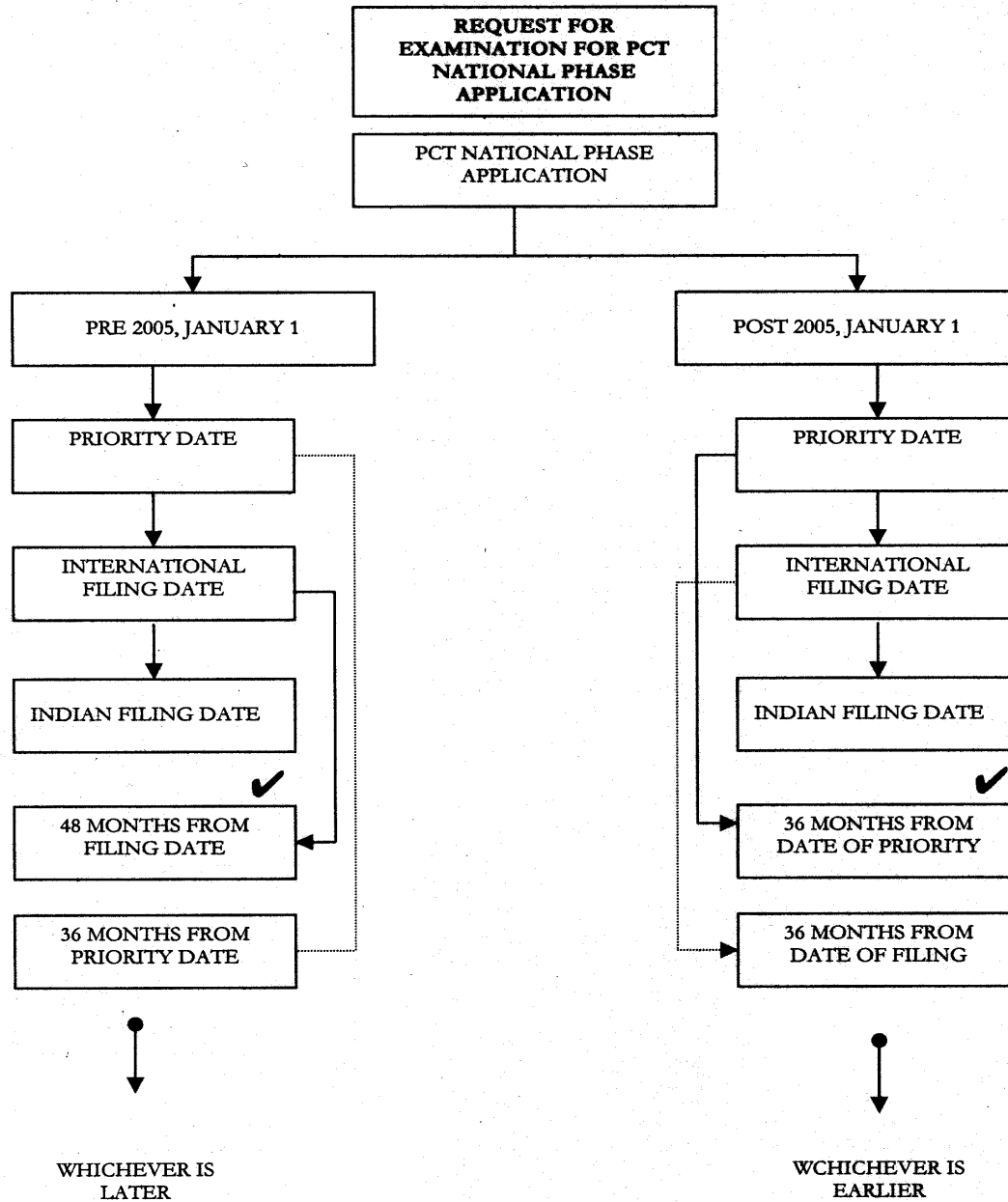
# **An interesting procedural flaw!**

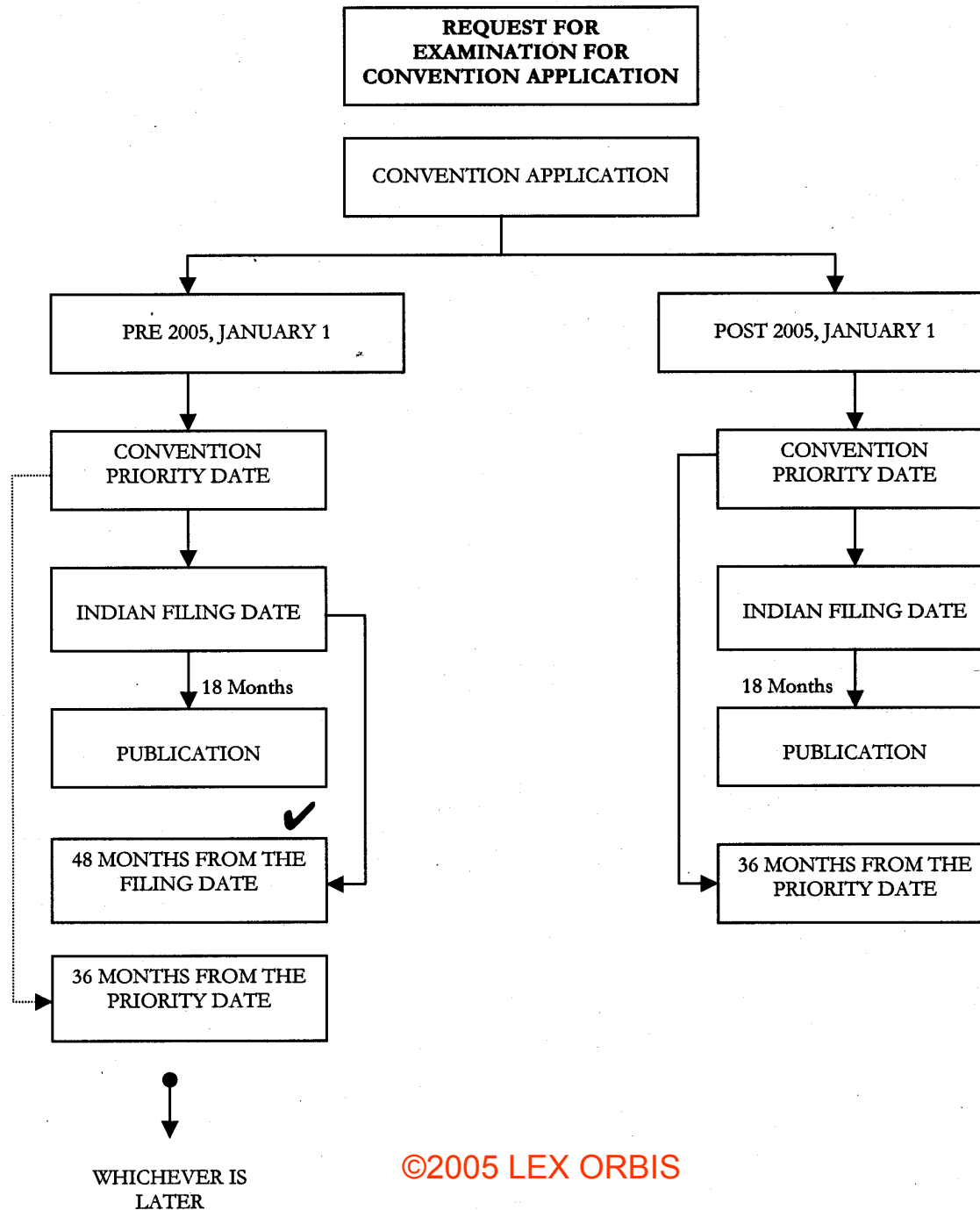
**We now have a system of 18 months  
Publication.**

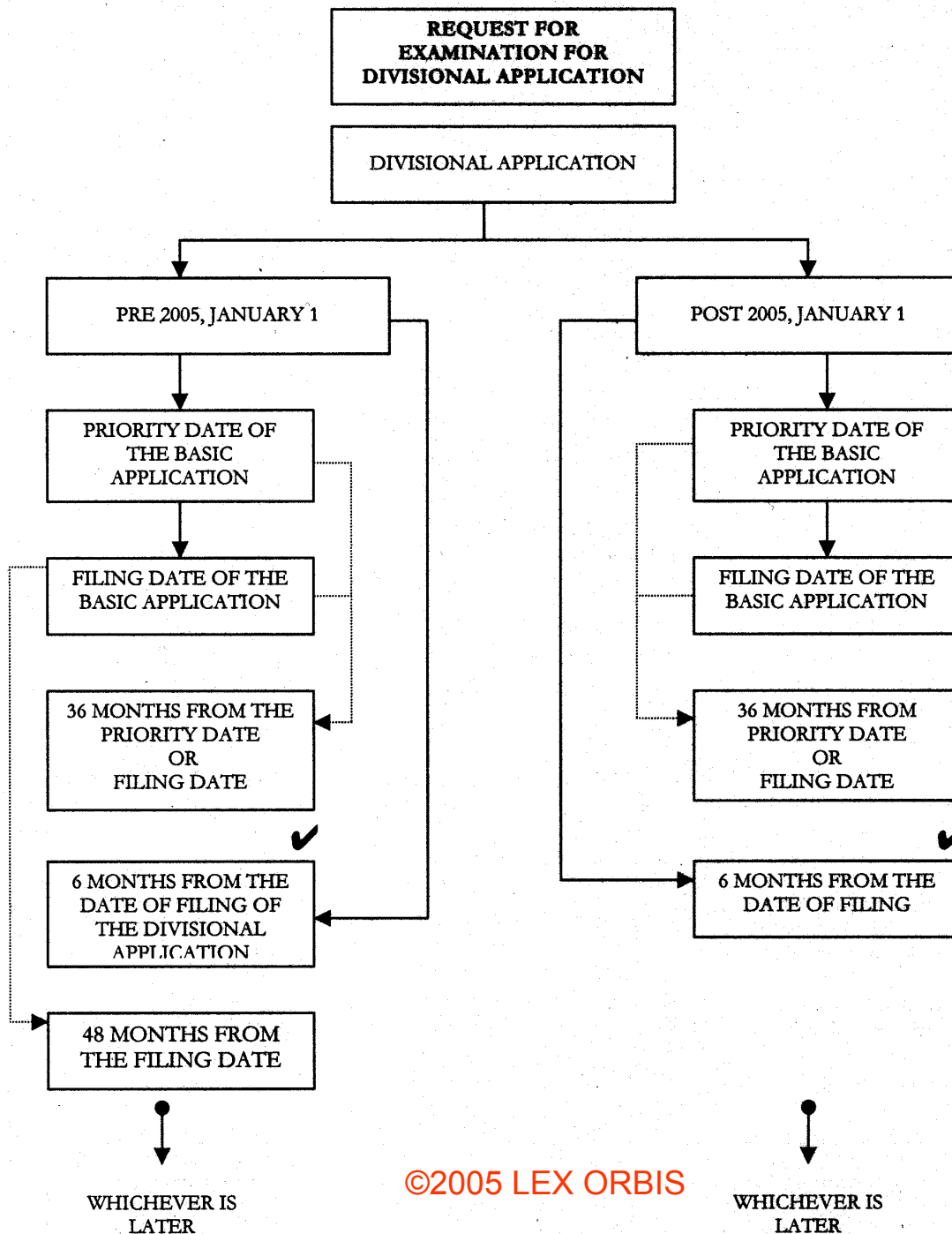
**We also have a system of Request for  
Examination (RFE).**

**We have a rather complicated deadline to file  
RFE.**

**Please see these charts –**







## The law can be further augmented

- \* A PCT National Phase Application enters NP in India on 31 months of its date of priority
- \* The projected publication date for all Indian patent applications is 18 months on filing the application in India, as I said.
- \* As per the Ordinance the Request for Examination must be filed after publication and within 36 months from priority
- \* How is this possible in PCT National Phase Applications??

# Patentability

**The Ordinance added a new Section 3(ka).**

**Does this make the question on the patentability of computer software further unclear?**

## Section 3 (k) & the new 3(ka)

There was n't this section before 2003 May. A new section 3 (k) inserted in the Act said 'what is not patentable is 'a mathematical or business method or a computer program *per se* or algorithms. This made 'what is not a computer program *per se* patentable.

- \* The Ordinance amended this provision. A new sub-section 3(ka) is introduced. What is now not patentable is “*a computer program per se other than its technical application to industry or a combination with hardware*”. Also not patentable is “a mathematical method or a business method or algorithms”.
- \* That means “a computer program’s technical application to industry or a computer program in combination with hardware is patentable” – what is that?

## **Unclear wording of Section 3k(a)**

- \* It seems we are trying to adopt a moderate route closer to the EPO standards;**
- \* EPO allows claims addressed at computer programs, if running of the program in a computer system results in a technical contribution.**
- \* The EPO has been adopting the practice of first checking if the invention involves an inventive step to qualify for patentability as in any other invention. The second step is to check if it involves a technical effect – a technical contribution.**
- \* The EPO and the UK Patent Office allows claims covering computer programs, either in themselves, or on a carrier, provided that the program when run on a computer produces a technical effect.**

# **Unclear language in Section 3(ka)**

- \* If India is trying to adopt a balanced approach (away from the US practices), the section 3(ka) needs to be reworded. The expression 'technical application to industry' is unclear and confusing.**
- \* A clearer wording can be "a computer program per se other than that having a technical contribution when run on a computer system or a combination with hardware".**

**Thank You**