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The patent opposition process in India

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By Varun Sharma and Manish Aryan, LexOrbis

Patent opposition, if used appropriately, can act as an important tool to prevent the grant of frivolous patents. Although this goal can be achieved by way of revocation and other litigious options, opposition serves as a more cost-effective route. However, it brings to mind misuse of opposition to prevent the grant of even those patents that have great competitive value and to deliberately affect the businesses of competitors. Nevertheless, the opposition procedure has its own checks and balances to allay such fears.

If a granted patent passes the test of opposition, it acquires a much higher patent value. The patent opposition system in India is unique as it provides two kinds of patent opposition processes at two different stages of patent prosecution:

- a pre-grant opposition; and
- a post-grant opposition.

Types of patent opposition proceeding

Pre-grant opposition gives third parties the opportunity to oppose the grant of a patent just after publication of the patent application – a party need not wait until the grant itself. Post-grant opposition can be filed only after the grant of a patent, but within one year of the date of grant. A pre-grant opposition can be filed by any party, whereas a post-grant opposition can be filed only by an interested party. The interested party is one which is engaged or involved in promotion and research in the same field to which the invention relates.

Interestingly, for filing a pre-grant opposition there are no official fees involved. As it is easy, simple and cost effective, pre-grant opposition is the more common route.

Pre-grant opposition proceedings – grounds and procedure

According to Section 25(1) of the Patents Act, 1970, any person may, in writing, oppose the grant of a patent following publication of the patent application but before the grant of the patent based on the grounds stated in Sections 25(1)(a) to (k). The representation for opposition is filed in Form-7(A) along with a statement and evidence in support of the opposition. The opponent may also request a hearing if desired. The legislature has intentionally retained a six-month window before the grant of a patent from the date of publication of the application, providing third parties an opportunity to oppose the grant of a patent. However, the representation can be filed only if a request for examination of the patent application has already been filed. After consideration of the representation, if the controller decides that there is merit in the representation, he or she will give notice of the opposition to the applicant. After receiving notice, the applicant files a reply to the representation along with evidence, if any is available, within three months of receipt of the notice.

After considering the opponent's representation and the applicant's reply, along with evidence from both sides and hearing both parties, if requested, the controller may either reject the pre-grant representation and grant a patent or ask the applicant to amend the complete specification to his or her satisfaction before proceeding to grant.

Grounds for pre-grant opposition

A pre-grant opposition can be filed only on the following grounds:

- wrongful obtainment of the invention (Section 25(1)(a) of the Patents Act);

- anticipation by prior publication (anywhere in the world) (Section 25(1)(b));
- anticipation by prior claiming in India (Section 25(1)(c));
- public knowledge or public use in India before the priority date (Section 25(1)(d));
- obviousness and lack of inventive step in the invention (Section 25(1)(e));
- being an excluded subject matter (such as those *inter alia* provided in Section 3) (Section 25(1)(f));
- insufficiency of disclosure of the complete specification (Section 25(1)(g));
- non-compliance of the requirement of Section 8 or furnishing materially false information (Section 25(1)(h));
- non-filing of the application within 12 months of filing the first application in a convention country (Section 25(1)(i));
- non-disclosure or wrongful mention of the source or geographical origin of biological material (Section 25(1)(j)); and
- anticipation with regard to traditional knowledge of any community anywhere in the world (Section 25(1)(k)).

Post-grant opposition proceedings – grounds and procedure

According to Section 25(2) of the Patents Act, any person interested can file a post-grant opposition within 12 months of the date of publication of the grant of a patent on any of the grounds prescribed, by giving a notice of opposition to the controller. The grounds of post-grant opposition are identical to those for pre-grant opposition. After receipt of the notice, the controller informs the patentee of the opposition and orders an opposition board to examine the opposition and give the controller its recommendation.

Opposition board

The opposition board consists of three members, one of which is nominated by the controller to chair the board. In general, members of the board are patent examiners, except for the examiner who has dealt with the patent application.

Filing documents

A written statement of opposition and evidence is required to be filed by the opponent in duplicate copy. The opponent must specify in a written statement:

- the nature of its interest;
- the facts on which the case is based;
- the relief sought; and
- any evidence.

Within two months of receipt of notice of opposition, the patentee, if it wishes to contest, will submit a written statement along with evidence, if any is available, to the patent office, along with a copy to the opponent. If the patentee does not contest this within two months, the patent is deemed to be revoked.

Thereafter, within one month of receipt of the patentee's reply statement, the opponent may file its reply evidence to the patent office.

Further evidence, if any, can be filed with only leave of the controller.

The opposition board examines the patent based on the documents submitted by the opponent and the reply given by the patentee and gives a recommendation to the controller with reasoning for each ground mentioned in the notice of opposition within three months of the date of the documents forwarded to it.

Previously, the opposition board's recommendation was never to be disclosed to the parties; nevertheless, this changed following *Cipla Ltd v Union of India* (SC, Civil Appeal 8479-8480, 2012). The Supreme Court held that although the Patents Act does not specifically order a recommendation in case of post-grant opposition to the parties, the opposition board must furnish its recommendation to the parties so that they can effectively strengthen their contentions before the controller during a hearing.

Hearing

After receipt of the opposition board's recommendation, the controller fixes a date and time for hearing both parties. The members of

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the opposition board are also present at the time of the hearing.

After hearing both parties, or without a hearing if neither party wishes to be heard, and considering the opposition board's recommendation, the controller orders that the patent be either maintained, amended or revoked.

Cases and decisions concerning patent opposition

When is a patent deemed to be granted?

In both pre-grant and post-grant oppositions, the date of the grant of a patent plays a very vital role, as it determines the period within which such oppositions can be filed. But what is deemed to be the date of the grant of a patent has given rise to many questions, as there is a lapse between the order of grant and its subsequent publication.

In *Sugen Inc v Cipla Ltd* (CS (OS) 3429/2012), the court determined when a patent can be said to

be granted under the Patents Act. The court ruled that in case of a pre-grant opposition, the date of the grant is the date on which the controller passed the order of grant and not the date of its publication in the *Patent Office Journal*. However, the date of the grant of a patent for filing post-grant opposition is the date on which the grant of a patent is published in the *Patent Office Journal*, as previously held in *Dr Snehlata C Gupte v Union of India* (WP (C) 3516, 3517, 5422, 5423 of 2007; 10399, 10400 and 10450 of 2009; and 1020 of 2010). The above two cases clear away the cloud surrounding the date of the grant of a patent with respect to filing patent oppositions in India.

An interesting corollary is that there appears to be a small window where no opposition may be filed (ie, from the date of the order of the grant of a patent until the date of its publication in the *Patent Office Journal*).

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Recent trends in pre-grant opposition

Although it is clear that opposition is necessary to prevent the granting of patents on frivolous inventions, it has also become an enabler of many other strategies, some of which might throw a spanner in the overall granting process of important patents.

From the viewpoint of rights holders, there has been an upsurge in anxiety surrounding the idea that potential infringers might attempt to delay the grant of those patents that conflict with their interests. This anxiety is rooted in the fact that any person can file a pre-grant opposition in a pending application, which risks prolonging the grant of a patent and may increase the burden of additional costs involved in defending this opposition.

On publication of a patent application, the applicant is deemed to acquire similar rights as would be granted on the grant of a patent on that application from the date of publication. However, the applicant cannot file any suit for infringement until a patent is actually granted. Indian law permits any person to oppose a pending application, a procedure which is more elaborate than the third-party representation found in other jurisdictions. The pre-grant opposition involves detailed pleadings where both the opponent and applicant file a statement and reply, along with elaborate evidence. The parties may thereafter opt for a hearing on such an opposition and the entire exercise may take a few months before the controller gives a final decision.

The filing of the pre-grant opposition appears to be more profound in cases where an applicant becomes assertive immediately after the publication of a patent application. In such a scenario, third parties generally realise that a suit for infringement against them is inevitable and they will try to focus on preventing the grant of a patent on such application, which includes filing a pre-grant opposition. Since any person can file an opposition, an individual who may not even have a direct nexus with the potential infringer is made to file the opposition to conceal the real motive.

Although pre-grant opposition may be a hindrance, the procedure is replete with checks and balances. Any person may file a pre-grant opposition; however, the controller first scrutinises such an opposition and only when there is some substance will a notice be sent to the applicant. An unscrupulous opponent fails to gain because on adjudication of a pre-grant opposition, the controller either refuses or grants a patent on the application, thereby sometimes shortening the time normally taken in examination of an application. In addition, costs could also be imposed on an unsuccessful opponent.

If an interested party files an opposition, which is eventually rejected, it may provide an applicant or patentee the opportunity to license the patent from a stronger bargaining position.

Comment

Compared to other invalidation processes, opposition proceedings are simpler and more cost-effective. The Patents Act prescribes both pre-grant and post-grant opposition, offering flexibility to third parties to challenge the validity of a patent following its publication until one year from its grant. The controller's role is becoming increasingly important for culling frivolous oppositions at the initial stage and preventing misuse of these procedures. ■

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