

Opposing patent rights

Raashi Jain and Zoya Nafis of LexOrbis assess patent invalidation in India

A patent is a set of exclusive rights granted to an inventor or assignee for disclosing and working the invention in a specific jurisdiction. The three requisites for the grant of patent are novelty, industrial application, and inventive step. Once granted, the protection so accorded is for a term of 20 years from the date of application. However, it is important to note that the grant of a patent does not ensure its validity.

In India, a patent can be invalidated by taking any one of three routes: post-grant opposition, revocation petition, or counter claim in an infringement suit. In addition to these, a patent may also be invalidated by the central government on the grounds of public interest, failure to allow the government to use the invention, relation to atomic energy, and necessity in the interest of security of India.

Under section 25(2) of the Patent Act, any interested person can file a post-grant opposition before the Indian Intellectual Property Office (IIPO), although it should be filed within one year of publication of the patent's grant. Upon receiving the opposition, the IIPO notifies the patent owner and also constitutes an opposition board, which conducts an examination and submits its recommendations to the IIPO. After receiving the recommendations and giving the patent owner and the opponent an opportunity of being heard, the IIPO then gives its decision. Accordingly, it is evident that the grant of a patent by itself does not confirm the rights of the patent owner. It is only when a challenge under Section 25(2) of the act, if any, is determined in favour of the patent owner that the rights are confirmed.

Similarly, in cases where no opposition is filed within one year of publication of the patent's grant, the rights are confirmed after the expiry of the term, as held in the case of *Dr Aloys Wobben and Anr v Yogesh Mehra Ors* (AIR 2014 SC 2210).

While a post-grant opposition cannot be filed after one year, no such limitation persists in the case of a revocation petition, which can be filed at any time during the term of the patent. A revocation petition can be filed under section 64(1) of the act, by any interested person or the central government, with the IP Appellate Board (IPAB). In an infringement suit, the opponent, by way of a counter claim, can

seek revocation of the patent at dispute. For this, the opponent can avail the grounds under Section 64(1). Moreover, only the high courts have the jurisdictional power to try such cases.

A patent is granted not just to encourage technological developments but also to serve the public interest, which is an indispensable objective when granting patents, and if the public is deprived of the invention, the exclusive monopoly given to the patent owner can be revoked. This can be realised through Section 85 of the act.

Upon an application by the central government or any interested person, after two years from the date of the order granting the first compulsory licence for the invention, the IPPO may revoke the patent on the grounds that the patented invention has not been worked in India, the reasonable requirements of the public with regard to the concerned invention have not been fulfilled, or the invention is not available at a reasonably affordable price.

While there are various routes through which a patent may be invalidated, the question that comes up for consideration is whether all of them can be employed simultaneously. This conundrum was solved by the Supreme Court in *Dr Aloys Wobben and Anr v Yogesh Mehra Ors*. In this case, the respondents had filed a total of 23 revocation petitions with the IPAB. They also then filed these as counter claims in response to infringement suits instituted against them by the appellants.

The court held that a person cannot file a counter claim in an infringement suit subsequent to filing revocation petitions on the same cause of actions, or vice versa, as this is barred by the principle of *res judicata*. The use of "or" in Section 64(1) clearly brings to light the intention of the legislature that only one of the two remedies can be used and not both. The court also held that the presence of "subject to the provisions contained in this act" makes Section 64 subordinate to rest of the provisions in the act. As a result, if any interested person filed proceedings under Section 25(2) of the Patents Act, that filing would extinguish the rights available to that person under Section 64(1) of the Patents Act.

This judgement serves as an important guide, clearing up the confusion that was prevalent

before. It has systematised the patent invalidation system, protecting a patent owner from parallel proceedings. Furthermore, it has provided a patent opponent with a clear picture of which forum to approach. It also averts two different forums from passing different decisions on the same issue.

The main issue with this system is the interference of baseless proceedings, which not only harm a patent owner's rights, but in a way also distress the rights of the public. This stands true especially in the case of pharmaceutical drugs and/or medicinal compositions where the interest of the public at large is vested. The legislature has strived to strike a balance between the public interest and the rights of innovators. With patent litigation increasing in India, it would be interesting to see the position taken by Indian courts in the future. [IPPro](#)



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