

International **Comparative** Legal Guides



Patents **2021**

A practical cross-border insight into patent law

11th Edition

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1 Patent Enforcement

1.1 Before what tribunals can a patent be enforced against an infringer? Is there a choice between tribunals and what would influence a claimant's choice?

A patent can be enforced against an infringer only in civil courts and not below the court of a district judge. For Delhi, Chennai, Mumbai, and Kolkata, a patentee can file a suit for infringement even in the High Court if the claimant chooses to value the suit greater than the limit prescribed by each High Court. For example, a suit for infringement of a patent would be filed only before the Delhi High Court if the value of the suit exceeds Rs. 2 Crores (approximately USD 0.29 million). However, as the value of the suit increases, so does the value of the court fee and this could influence the claimant's choice between a District Court and the High Court in aforesaid jurisdictions.

Although a claimant can choose between a District Court and a High Court, as mentioned above, such choice becomes redundant once the defendant files a counter-claim seeking revocation of the patent. In such a scenario, the suit is to be heard by the High Court regardless of where the claimant chose to file it first. For instance, if the claimant files a suit for infringement before a district judge, the case would be transferred to the concerned High Court if the defendant files a counter-claim seeking revocation of the subject patent.

A claimant may file a suit for infringement at: a) the place where the cause of action has arisen; or b) the residence or place of business of the defendant is located. Thus, apart from choosing between a district court and a High Court, it is important to determine the court(s) that would have territorial jurisdiction over the case. Multiple territorial jurisdictions may arise where the causes of action, *viz.* acts of infringement, have occurred in several places. The court at each place has jurisdiction to try the suit. Whereas a suit for infringement can be filed in multiple courts on the basis of their territorial jurisdiction, the claimant may choose any one of them based on the claimant's convenience.

1.2 Can the parties be required to undertake mediation before commencing court proceedings? Is mediation or arbitration a commonly used alternative to court proceedings?

Parties may undertake mediation before commencing court proceedings. Using mediation during a case is a commonly used alternative. As regards pre-suit mediation, under Section 12-A of the recent Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts (Amendment) Act, 2018, pre-suit mediation is mandatory if there is no urgent interim relief sought by the plaintiff.

Arbitration is a commonly used alternative to court proceedings when the parties have agreed to arbitration under an agreement between them.

1.3 Who is permitted to represent parties to a patent dispute in court?

An advocate under the Advocates Act, 1961 or the plaintiff in person, or a recognised agent such as a person holding power-of-attorney for a party, are permitted to represent parties to a patent dispute in court.

1.4 What has to be done to commence proceedings, what court fees have to be paid and how long does it generally take for proceedings to reach trial from commencement?

After deciding the appropriate court, i.e. a District Court or a High Court having territorial jurisdiction in the case, the suit with the requisite court fee affixed to it is presented before such court along with an application seeking interim relief(s) such as *ex parte* injunction, etc. It is necessary to file all documents (either original or photocopies) along with the suit upon which the claimant relies and which are in power, possession, control, and custody of the claimant. However, in case of urgent filing, the claimant may seek leave to rely on additional documents, which are to be filed within 30 days of filing the suit.

The court fee depends on the value of the suit and could range from 1% to 10% of the value depending on the jurisdiction. The value of the suit includes the amount of damages and value of other reliefs claimed.

Ideally, proceedings should reach trial within one to two years, especially since the enactment of the Commercial Courts Act, 2015. However, for practical purposes, a claimant should expect commencement of trial two to three years following the initiation of a suit.

1.5 Can a party be compelled to disclose relevant documents or materials to its adversary either before or after commencing proceedings, and if so, how?

The relevant documents or materials are required to be disclosed to the adversary only after the proceedings have commenced. As mentioned before, all the documents on which a party relies must be filed in the proceedings and given to the adversary.

However, under recent amendments to the Delhi High Court Rules, all documents/information considered confidential by the Court shall be permitted to be filed in a sealed envelope to be kept in the safe custody of the Registrar General. These documents can only be shown to three Advocates (excluding in-house counsels) and two external experts nominated by the opposite party.

1.6 What are the steps each party must take pre-trial? Is any technical evidence produced, and if so, how?

Pre-trial procedures include the collection of evidence of infringement to support the claims. The evidence of infringement may either be collected by the claimant or through an investigator. An affidavit of the person who has conducted the investigation and collected the evidence is required to be filed along with such evidence to *prima facie* establish the infringement. This investigator may be called in as a witness later in the trial. Technical evidence in the form of an affidavit with documentary evidence and other evidence may also be produced to establish how the infringing product reads onto the claims of the patent.

1.7 How are arguments and evidence presented at the trial? Can a party change its pleaded arguments before and/or at trial?

The arguments, both for any interim relief and the final relief, are orally addressed to the Court by each party. Normally, the plaintiff begins the arguments followed by the defendant. Subsequently, the plaintiff may argue in rebuttal. The parties are also allowed to submit written arguments in support of their case, which forms part of the record. A copy of each of such written argument is also required to be furnished to the opposite party.

The trial may commence either before the Court or the Court may form a commission to examine witnesses. It has been observed that examination of witnesses before a commission is faster compared to examinations before the court, although there is an extra cost burden for such commissions. The examination in chief of a witness is by way of an affidavit, who is further cross-examined by the opposite party. Such witnesses may also be allowed re-examination. The documents and other materials relied upon by such witnesses are taken on record if found to be relevant and admissible. Any objection towards admissibility and mode of proof of any evidence is noted during the trial and decided by the Court during final arguments.

The Court may also appoint technical/scientific advisors to assist the Court in addition to the expert witnesses summoned by the parties. As regards expert witnesses, Delhi High Court has even allowed 'hot-tubbing', in that the experts of both sides are, *inter alia*, examined together by the Court.

1.8 How long does the trial generally last and how long is it before a judgment is made available?

The length of the trial depends on various factors such as the number of witnesses of each party, whether the examination is before a commission or a Court, the time taken in cross-examination of each witness, etc. Due to these factors, a trial may take three to five years, which may be reduced substantially if the examination is done before a commission.

After the trial and final arguments, Courts fix a date for the pronouncement of judgment. It may, however, take a few days to obtain a certified copy of the judgment and a few weeks or a month before a decree sheet is drawn.

1.9 Is there any alternative shorter, flexible or streamlined procedure available? If so, what are the criteria for eligibility and what is the impact on procedure and overall timing to trial?

As already mentioned hereinbefore, the trial may be expedited by choosing to examine the witnesses before a commission appointed by the Court. In this procedure, the Court appoints another Advocate or a retired Judge as a commissioner before whom the witnesses would be examined and the entire evidence would be adduced. Since the Commissioners can fix hearings as per the convenience of the parties and the witnesses, there are fewer adjournments and the examination may even take place continuously, reducing the duration of the entire trial.

For expert witnesses, Delhi High Court has allowed the technique of 'hot-tubbing' by which expert witnesses give evidence simultaneously in each other's presence and in front of the Judge, who puts the same question to each expert witness. This makes it possible to identify key issues of a dispute and possibly evolve a common resolution for all of them. Since the expert witnesses need not undergo lengthy procedures of examination and cross-examination separately, the time of trial can be reduced significantly.

Apart from the above, the identification of important witnesses and making them available in a timely manner also reduces the duration of a trial.

1.10 Are judgments made available to the public? If not as a matter of course, can third parties request copies of the judgment?

Judgments are pronounced in open court and are also published in leading journals. Third parties can request copies of judgments.

1.11 Are courts obliged to follow precedents from previous similar cases as a matter of binding or persuasive authority? Are decisions of any other jurisdictions of persuasive authority?

The precedents from the Supreme Court on previous similar cases are a binding authority. What is binding is *ratio decidendi*, i.e. reasons for deciding the legal point, and *obiter dicta*, i.e. decision on points not necessary to decide.

The precedents from High Courts are not binding but have persuasive authority. However, precedents from a High Court are treated binding for the courts subordinate to that High Court unless contrary to any precedent from the Supreme Court or another High Court. It is, however, necessary in every case that the precedents are not distinguishable on facts.

As regards foreign judgments, the same only have persuasive value.

1.12 Are there specialist judges or hearing officers, and if so, do they have a technical background?

No, there are no specialist judges or hearing officers in Court.

1.13 What interest must a party have to bring (i) infringement, (ii) revocation, and (iii) declaratory proceedings?

A patentee or, if the patentee refuses, a registered exclusive licensee or a compulsory licensee may bring an action against infringement.

A petition for revocation of a patent may be filed only by a “person interested” or the Central Government. A “person interested” includes a person engaged in, or promoting research in the same field as that to which the invention relates.

Any person may establish a suit for a declaration of non-infringement. In case of groundless threats of infringement proceedings against any person, such a person can establish a suit for a declaration to the effect that such threats are unjustifiable.

1.14 If declarations are available, can they (i) address non-infringement, and/or (ii) claim coverage over a technical standard or hypothetical activity?

The declarations are available and address non-infringement.

Courts have even made declarations claiming coverage over a technical standard; however, such declarations have been made in a suit of infringement and not separately.

1.15 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of, but not all of, the infringing product or process?

Yes, a party can be liable for infringement as a secondary infringer or for the supply of a part of an infringing product or process if the predominant use of the same creates infringing goods.

1.16 Can a party be liable for infringement of a process patent by importing the product when the process is carried on outside the jurisdiction?

Yes, a party can be liable for infringement of a process patent by the importation of a product provided such product is obtained directly by that process even though the process is carried on outside the jurisdiction.

1.17 Does the scope of protection of a patent claim extend to non-literal equivalents (a) in the context of challenges to validity, and (b) in relation to infringement?

There are no clear precedents on the doctrine of equivalents.

Having said that, Delhi High Court has held in one case that if the infringing goods are made with the same object in view, which is attained by the patented article, then the minor variation does not mean that there is no piracy, and such person is guilty of infringement if he makes what is in substance the equivalent of the patented article and some trifling and unessential variations have to be ignored.

1.18 Can a defence of patent invalidity be raised, and if so, how? Are there restrictions on such a defence e.g. where there is a pending opposition? Are the issues of validity and infringement heard in the same proceedings or are they bifurcated?

A defence of patent invalidity can be raised in a suit for infringement by filing a counter-claim. Once a counter-claim is filed, the suit, if it is not already pending before the High Court, is transferred to the High Court and only the High Court would decide on the validity of the patent even where there is pending opposition or revocation petition between the same parties before any other forum. However, the Court may also take a position to wait for the other forum (Patent Office or IPAB) to decide the question of invalidity.

The issues of validity and infringement are heard in the same proceedings before the High Court if the validity of a patent is challenged in a counter-claim.

1.19 Is it a defence to infringement by equivalence that the equivalent would have lacked novelty or inventive step over the prior art at the priority date of the patent (the “*Formstein* defence”)?

There is no clear precedent on the ‘*Formstein* defence’ in India.

1.20 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?

The other grounds for invalidity of a patent are:

- a. The invention has been obtained wrongfully.
- b. The invention has been publicly known or it has been publicly used in India before the priority date.
- c. The invention is in accordance with a non-patentable subject matter.
- d. The complete specification is not sufficiently described.
- e. The applicant has not complied with the requirement of Section 8 or has provided materially false information.
- f. The application was not filed within 12 months of filing the first application in a convention country.
- g. The complete specification does not disclose or wrongly mentions the source or geographical origin of biological material.
- h. The invention is anticipated with regard to traditional knowledge of any community, anywhere in the world.

1.21 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?

No, infringement proceedings are not stayed for the pending resolution of validity. However, in certain situations, the Courts may take a position to direct Patent Office or IPAB to first decide the issue of validity.

1.22 What other grounds of defence can be raised in addition to non-infringement or invalidity?

In a suit for infringement, Indian Patent law does not provide any other ground of defence in addition to non-infringement and invalidity.

1.23 (a) Are preliminary injunctions available on (i) an *ex parte* basis, or (ii) an *inter partes* basis? In each case, what is the basis on which they are granted and is there a requirement for a bond? Is it possible to file protective letters with the court to protect against *ex parte* injunctions? (b) Are final injunctions available? (c) Is a public interest defence available to prevent the grant of injunctions where the infringed patent is for a life-saving drug or medical device?

Preliminary injunctions are available on both an *ex parte* and *inter partes* basis. The basis on which injunctions are granted is the determination of which party has successfully established in its favour: (i) a *prima facie* case; (ii) balance of convenience; and (iii) irreparable loss and injury.

Yes, it is possible to file protective letters (caveats) with the court to protect against *ex parte* injunctions.

Yes, final injunctions are also available.

There have been differing decisions of various High Courts on public interest being available as a defence to prevent the grant of injunctions. However, the Supreme Court of India in *Colgate Palmolive (India) Ltd vs Hindustan Lever Ltd* has held that: “the decision whether or not to grant an interlocutory injunction has to be taken at a time when the existence of the legal right assailed by the plaintiff and its alleged violation are both contested and uncertain and remain uncertain till they are established at the trial on evidence...”

v) The issue is to be looked from the point of view as to whether on the refusal of the injunction the plaintiff would suffer irreparable loss and injury keeping in view the strength of the parties case; (vi) Balance of convenience or inconvenience ought to be considered as an important requirement even if there is a serious question or *prima facie* case in support of the grant; (vii) **Whether the grant or refusal of an injunction will adversely affect the interest of the general public which can or cannot be compensated otherwise (emphasis added).**”

1.24 Are damages or an account of profits assessed with the issues of infringement/validity or separately? On what basis are damages or an account of profits assessed? Are punitive damages available?

Yes, damages or an account of profits are assessed with the issues of infringement/validity. The basis of damages could be actual damages, rendition of accounts, royalty rates, interest, and even punitive.

1.25 How are orders of the court enforced (whether they be for an injunction, an award of damages or for any other relief)?

The orders of the court are enforced either through the process of execution or, if the judgment debtor has not complied with the order of the court, proceedings of contempt of court may also be initiated.

1.26 What other form of relief can be obtained for patent infringement? Would the tribunal consider granting cross-border relief?

As regards other forms of relief, the court may also order that the goods which are found to be infringing, as well as materials and implements, the predominant use of which is in the creation of infringing goods, shall be seized, forfeited or destroyed.

Cross-border injunctions and other reliefs are not granted by Indian courts.

1.27 How common is settlement of infringement proceedings prior to trial?

Yes, settlement of infringement proceedings prior to trial is very common.

1.28 After what period is a claim for patent infringement time-barred?

After three years from the last act of infringement, a claim for patent infringement becomes time-barred.

1.29 Is there a right of appeal from a first instance judgment, and if so, is it a right to contest all aspects of the judgment?

Yes, there is a right of appeal from a first instance judgment in which all aspects of the judgment may be contested.

1.30 What are the typical costs of proceedings to a first instance judgment on (i) infringement, and (ii) validity? How much of such costs are recoverable from the losing party?

The typical cost of proceedings to first instance judgment would be approximately USD 100,000–175,000, which could increase to USD 200,000 if there is an invalidation action or a senior counsel is engaged.

1.31 For jurisdictions within the European Union: What steps are being taken in your jurisdiction towards ratifying the Agreement on a Unified Patent Court, implementing the Unitary Patent Regulation (EU Regulation No. 1257/2012) and preparing for the unitary patent package? Will your country host a local division of the UPC, or participate in a regional division? For jurisdictions outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your jurisdiction?

This is not applicable.

2 Patent Amendment

2.1 Can a patent be amended *ex parte* after grant, and if so, how?

A patent in India can be amended *ex parte* by the patentee by making an application to the Controller under Section 57 of the Indian Patents Act and stating therein the nature and reasons for the proposed amendment. The controller shall not allow any proposed amendment, if any suit for the infringement or revocation is pending before the Court. The Controller, if he is of the opinion that the proposed amendment is of substantive nature, shall publish the proposed amendments in the official journal of patents. Any person interested in opposing the application for

amendment may file a notice of opposition within three months from the date of publication of the application for amendment.

2.2 Can a patent be amended in *inter partes* revocation/invalidity proceedings?

Amending a patent in *inter partes* revocation/invalidity proceedings is allowed in India for which an application should be made by the patentee to the Appellate Board or the High Court, as the case may be, and giving a notice of the application to the Controller. The Appellate Board or the High Court may allow the amendments in the manner and with the terms they deem fit.

2.3 Are there any constraints upon the amendments that may be made?

The amendments to a patent application or a granted patent have constraints prescribed under Section 59 of the Indian Patents Act, which requires that amendment can only be made by way of disclaimer, correction, or explanation. Section 59 also provides that no amendments other than those for the purpose of incorporation of actual fact shall be allowed. Another important constraint imposed by Section 59 is that amendments, the effect of which would be such that the specification as amended would claim or describe the matter that was not in substance disclosed in the specification before the amendments or that the amended claim would not completely fall within the scope of a claim of the specification before the amendment, shall not be allowed.

3 Licensing

3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?

Yes, terms of a patent licence may be limited under the Competition Act if the royalty rate or other terms amount to an abuse of dominant position by the patentee. Section 140 of the Indian Patents Act also prohibits certain restrictive conditions in a patent licence, such as terms relating to exclusive grant bank, prevention to challenges to the validity of a patent, coercive package licensing or any term that prohibits the licensee from acquiring from any third party or any process or any article other than the patented process or patented article.

3.2 Can a patent be the subject of a compulsory licence, and if so, how are the terms settled and how common is this type of licence?

Yes, a patent can be the subject of a compulsory licence.

The terms are settled by the Controller, who shall endeavour to secure that:

- (i) the royalty and other remuneration, if any, reserved to the patentee or other person beneficially entitled to the patent, is reasonable, having regard to the nature of the invention, the expenditure incurred by the patentee in making the invention or in developing it and obtaining a patent and keeping it in force and other relevant factors;
- (ii) the patented invention is worked to the fullest extent by the person to whom the licence is granted and with reasonable profit to him;
- (iii) the patented articles are made available to the public at reasonably affordable price;

- (iv) the licence granted is a non-exclusive licence;
- (v) the right of the licensee is non-assignable;
- (vi) the licence is for the balance term of the patent unless a shorter term is consistent with public interest;
- (vii) the licence is granted with a predominant purpose of supply in the Indian market and that the licensee may also export the patented product;
- (viii) in the case of semiconductor technology, the licence granted is to work the invention for public non-commercial use; and
- (ix) in case the licence is granted to remedy a practice determined, after judicial or administrative process, to be anti-competitive, the licensee shall be permitted to export the patented product, if necessary.

In India, only one compulsory licence has been granted.

4 Patent Term Extension

4.1 Can the term of a patent be extended, and if so, (i) on what grounds, and (ii) for how long?

No, the term of a patent cannot be extended in India.

5 Patent Prosecution and Opposition

5.1 Are all types of subject matter patentable, and if not, what types are excluded?

No, not all types of subject matter are patentable in India. In particular, Section 3 of the Patents Act, 1970 specifically states that the following are not inventions:

- (a) an invention which is frivolous or which claims anything obviously contrary to well-established natural laws;
- (b) an invention the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health, or to the environment;
- (c) the mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature;
- (d) the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance, or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant. Explanation: for the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy;
- (e) a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;
- (f) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;
- (g) [omitted];
- (h) a method of agriculture or horticulture;
- (i) any process for the medicinal, surgical, curative, prophylactic diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products;

- (j) plants and animals in whole or any part thereof other than microorganisms but including seeds, varieties, and species and essentially biological processes for production or propagation of plants and animals;
- (k) a mathematical or business method, or a computer program *per se* or algorithms;
- (l) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;
- (m) a mere scheme or rule or method of performing a mental act or method of playing a game;
- (n) a presentation of information;
- (o) topography of integrated circuits; and
- (p) an invention which, in effect, is traditional knowledge or which is an aggregation or duplication of known properties of a traditionally known component or components.

Apart from the above, inventions relating to atomic energy are not patentable as per Section 4 of the Patents Act.

5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents? If so, what are the consequences of failure to comply with the duty?

There is no duty of the applicant towards the patent office to disclose prejudicial prior art or documents unless the controller specifically asks for such information. However, Section 8 of the Patents Act read with Rule 12 of the Patent Rules imposes two requirements on applicants in relation to foreign applications.

The first requirement arises from Section 8(1) read with Rule 12(1), 12(1A), and 12(2), which requires applicants to inform the Indian Patent Office about the details of all related applications on a voluntary basis and also when asked by the patent office through an examination report or a hearing notice. The details of the related applications already filed before the Indian patent application are to be provided at the time of filing of the Indian patent application or within six months from the filing. Details of all subsequently filed related applications can be provided within six months from the date of their filing. The details of related patent applications need to be submitted to the Indian Patent Office in Form 3 and should include: the name of country; date of application; application number; status of application; date of publication; and date of grant.

The second requirement arises from Section 8(2) read with Rule 12(3), which requires applicants to submit: (i) claims allowed; and (ii) information relating to objections raised in related applications for all/major jurisdictions, only when specifically asked for by the Indian Patent Office. The documents under the second requirement are to be submitted within six months from when asked by the Indian patent office. The cited references are not required to be submitted to the Indian Patent Office on the lines of the IDS requirement of USPTO, only the claims allowed and objections raised in office actions, etc., need to be provided to the Indian Patent Office. Recently, the Indian Patent Office has significantly reduced demanding the documents under Section 8(2) in the First Examination Reports after the introduction of WIPO's Centralized Access to Search and Examination (CASE) system.

Failure to comply with the above requirements, and more particularly any willful suppression of material information, may lead to the refusal to grant a patent in a pre-grant opposition proceeding, or if the patent is granted, the patent may be cancelled in a post-grant opposition or revoked in a revocation proceeding.

5.3 May the grant of a patent by the Patent Office be opposed by a third party, and if so, when can this be done?

Yes, the grant of a patent by the patent office may be opposed by the third party. Under Section 25, the opposition proceedings are of two types:

- (a) pre-grant opposition: the pre-grant opposition can be filed by any person from the public once the patent application is published but not yet granted; and
- (b) post-grant opposition: the post-grant opposition can be filed only by **a person interested** within one year from the publication of the grant of the patent. A person interested is a person engaged in, or in the promoting or research of, the same field of the invention.

Apart from the above, a patent may be revoked on a petition of any person interested or of the Central Government by the Appellate Board or on a counter-claim in a suit for infringement of the patent by the High Court under Section 64.

5.4 Is there a right of appeal from a decision of the Patent Office, and if so, to whom?

Yes, an appeal against the controller's decision may be filed before the IPAB within a period of three months from the date of the decision. However, only the applicant has the right to appeal in case of a decision on a pre-grant opposition and the opponent does not have a right to appeal due to other available remedies.

5.5 How are disputes over entitlement to priority and ownership of the invention resolved?

The Indian Patent Law and Rules require the applicant to furnish a certified copy of priority document(s) or Form PCT/IB/304 in case of an international application, which serves as the proof of entitlement to priority. The IPO is both a participating and accessing office of the WIPO Digital Access Service (DAS) with effect from January 31, 2018. English translation of priority documents may still be demanded by the IPO. A certified priority document and/or a verified English translation thereof can be submitted within three months of notice from IPO.

Section 7(2) of the Indian Patents Act provides the guiding principle on the submission of "proof of right" of the applicant for all types of applications. It prescribes that, wherever the applicant has obtained rights in the invention from the true and first inventors, a "proof of right" has to be submitted by the said applicant. In case of a national phase of PCT application, the "proof of right" could be any of the following documents:

1. Declaration 12(i) in Form 1, duly signed by all the inventors.
2. An original/notarised/certified copy of assignment document from the inventors in favour of the applicant.
3. An employee-employer agreement having a clause for assignment of IP rights.
4. Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rules 4.17(ii) and 51bis.1(a)(ii) of PCT Rules). *[Note: since there is no express adoption of this provision of PCT Rules in Indian patent laws, in practice, some of the controllers at the Indian Patent Office do not accept this declaration and a consistent practice for acceptance of this declaration is yet to be notified by making necessary amendment in national laws.]*

5. When any of the above is unavailable, the applicant may consider filing a confirmatory assignment subject to approval of examining officer. The confirmatory assignment may be understood as an assignment, executed at a later date, which confirms an earlier made assignment between the parties involved.
6. As a last resort, the applicant may also consider filing an affidavit declaring the entitlement to right to apply for patent.

Issues with respect to entitlement to priority and ownership of the invention are mostly settled between the applicant and the Patent Office during prosecution. However, it is open for opponents to oppose the application or granted patent or apply for revocation of the granted patent on the relevant grounds. In any case, the applicant or the patentee will be given an opportunity to file its reply and evidence, and after hearing both the parties, the concerned authority, i.e., IPO, IPAB, or the Court of law, will issue its decision.

5.6 Is there a “grace period” in your jurisdiction, and if so, how long is it?

In India, a 12-month grace period is available, but only in limited circumstances. In case the patent application is filed within 12 months from the day of the following types of publication/usage/display, no anticipation will be deemed to have taken place:

- (a) Public-display and use of the invention in an industrial or other exhibition (as notified by the Indian Government) with the consent of the inventor.
- (b) Any publication of the invention as a result of the events in point a).
- (c) Usage of the invention by any person without the consent of the inventor/applicant after the occurrence of an event listed in point a).
- (d) The disclosure of the invention by the inventor before the “learned society” and publication of such disclosure with the consent of the inventor by the “learned society” as a privileged and confidential document (i.e. for private circulation among authorised members).

In view of the above, any other prior publication pertaining to a patent application is not covered as a special circumstance, and the prior publication would always be considered as a prior art against the application filed in India.

Important timelines for which no grace period is available in India include the 12-month period to claim priority under the Paris Convention, the 31-month entry period for PCT national phase applications, and the 48-month period from the date of priority to request examination.

5.7 What is the term of a patent?

The term of a patent is 20 years from the date of filing an application. In case of a National Phase application, the international filing date is the date of filing.

5.8 Is double patenting allowed?

No, double patenting is not allowed in India.

There is no provision of continuation application in India. However, an application for a patent concerning an addition (akin to CIP applications) for improvement of the main

invention, or a divisional application for an already disclosed distinct invention, may be filed in India.

A divisional application filed with the same set of claims as that of the parent application would be objected for double patenting and any amendments to claims need to comply with the requirements of Section 59(1), i.e.: amendments have to be by way of explanation, correction, or disclaimer; amendments have to be for the purposes of incorporation of actual facts only; amendments need to be supported by specification; and amendments cannot broaden the scope of claims. Therefore, the claims of a divisional application need to be different from the claims of the parent application. It is pertinent to note here that there is no advance notice of grant in India and the sudden grant of a patent can foreclose the opportunity to pursue divisional application. Therefore, a divisional application if required should be filed at the earliest opportunity and preferably before responding to first office action.

6 Border Control Measures

6.1 Is there any mechanism for seizing or preventing the importation of infringing products, and if so, how quickly are such measures resolved?

The Central Government has formulated the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007 in consonance with the TRIPS and World Customs Organisation Model. The Customs department of India has the Customs Recordal system, where the rights holder records his right. After the rights holder records their right, the Customs Authorities helps to stop the cross-border movement of counterfeit or infringing goods. However, an amendment in June 2018 to the said rule has omitted the word “**patent**” from the definition of Intellectual Property. Therefore, after the amendment of Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007, the Customs Authorities no longer have jurisdiction to scrutinise the import of any product/good on the ground that the products may be infringing one or more Indian patents. The enforcement of patent rights at the border is now only possible through an order of the Court whereby specific injunction to import infringing products is granted.

7 Antitrust Law and Inequitable Conduct

7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?

India enacted its Competition Act in 2002 which prevents abuse of dominant position by any enterprise. Recently, the Courts have held that a complaint against a patentee’s abuse of dominant position is an independent proceeding and does not affect any relief in a suit for patent infringement.

7.2 What limitations are put on patent licensing due to antitrust law?

The limitations on terms of licensing under the Competition Act, 2002 may include those that prevent exorbitant and non-uniform royalty rates, any discriminatory terms that violate FRAND terms, a bar on the jurisdiction, etc.

7.3 In cases involving standard essential patents, are technical trials on patent validity and infringement heard separately from proceedings relating to the assessment of fair reasonable and non-discriminatory (FRAND) licences? Do courts grant FRAND injunctions, i.e. final injunctions against patent infringement unless and until defendants enter into a FRAND licence?

In cases involving standard essential patents, technical trials on patent validity, infringement, and assessment of fair, reasonable and non-discriminatory FRAND licences are heard together if they arise from the same cause of action. Yes, courts have recently granted FRAND injunctions and have also determined the royalty rates under the licence.

8 Current Developments

8.1 What have been the significant developments in relation to patents in the last year?

- Patent Rules (see: http://www.ipindia.nic.in/writereaddata/Portal/News/569_1_The_Patent_Amendment_Rules_2019_.pdf) prescribing patent prosecution procedures and timelines were amended in 2019 to reduce official fees for start-ups, waiving mandatory filing of hard copies of original documents, adding additional categories of applicants who can avail expedited examination of patent applications including the applicants from the countries with which the Indian Patent Office (IPO) has signed a PPH agreement and to provide a waiver of certain official fees associated with electronic filing of PCT Applications.
- IPO successfully implemented its first PPH Pilot project (see: <http://www.ipindia.nic.in/newsdetail.htm?593>) with JPO for the first lot of 100 applications in the last financial year. From April 1, 2020, the second lot of 100 eligible applications can avail PPH requests with IPO for expedited examination.
- The Delhi High Court in the case of *Feried Allani* reiterated that the computer-related inventions demonstrating 'technical effect' or 'technical contribution' are patentable subject matters in India even though such inventions are based on a computer program.
- Discussion on amendments in the format of a working statement (see: <http://egazette.nic.in/WriteReadData/2019/204915.pdf>) to make it user friendly for technology companies, intensified in the past year. There have been several rounds of discussions with the stakeholders and a revised format is expected to be announced soon.
- A new Manual for Patent Office Practice and Procedures (see: http://www.ipindia.nic.in/writereaddata/Portal/Images/pdf/Manual_for_Patent_Office_Practice_and_Procedure_.pdf) was published to incorporate all recent changes brought in the patent practice in India.

- Scheme for Facilitating Start-Ups Intellectual Property Protection (SIPP) has been extended for three years up to March 31, 2023.
- Division Bench of the Delhi High Court in *Bayer Corporation vs. Union Of India* held that the export of a patented invention for experimental purposes is also covered under Section 107A of the Patents Act (India's Bolar exception) and thus does not amount to patent infringement.
- The Delhi High Court in *Shogun Organics Ltd vs. Gaur Hari Guchhait* held that prior disclosure of the invention during preparatory steps taken for launching a product such as disclosure to the Government, cannot be held to constitute disclosure for the purpose of anticipation unless and until there is clear public disclosure of the same.
- In view of the current situation due to COVID-19, the Supreme Court of India has extended its limitation period under all general and specific laws including IP laws from March 15, 2020, till the further orders of the Supreme Court, which is yet to be announced by the Supreme Court of India.

8.2 Are there any significant developments expected in the next year?

The Intellectual Property Appellate Board (IPAB) is expected to start disposing of long-pending patent appeal matters and is likely to take serious initiatives to reduce the backlog and keep pace with the increased rate of the disposal of patent applications by the Indian Patent Office. IPAB is considering hearing over video conferencing for reducing the backlog of pending matters.

The Indian Patent Office is also expected to further reduce the waiting time for examination to take place on a patent application and is likely to use more artificial intelligence at the pre-examination stage of patent applications in order to improve functionality with uniformity.

Various statutory, regulatory, and administrative reforms are expected in Indian Intellectual Property laws for harmonisation, to boost foreign direct investment and to incentivise technology transfer in India.

A simplified format for the working statement may be finalised, making it feasible to meaningfully fill it up for all technology areas.

8.3 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Some of the trends that have become more apparent in preceding years are: the reduced waiting time for examination; speedier disposal of patent applications; a steady increase in the number of patent applications by Indian applicants; and an increase in the number of cases going to Court for enforcement or invalidation. All these trends signify the development of a conducive IP system in India.



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Apart from representing clients during prosecution and oral hearings pertaining to patents applications before the Indian Patent Office, Joginder also assists in the prosecution of foreign patent applications. Further, he provides technical support during patent litigations and oppositions. He also handles patent analytics and search-related projects, such as patentability search, invalidity search, freedom to operate search/opinion, patent landscape, etc., involving searching for products or patent/non-patent literature. Joginder regularly speaks at various seminars/conferences and actively publishes articles, on various subjects related to patents.

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LexOrbis is a full-service Indian IP firm with offices in New Delhi, Mumbai, and Bangalore with over 190 personnel including 90 attorneys. We are ranked amongst the Top-5 IP firms and as the “fastest-growing” IP firm in India. The firm practice is divided into three broad groups i.e. (i) Patent prep & pros, (ii) Trademark/Design/Copyright, and (iii) IP enforcement and litigations. The patent practice group has over 60 patent attorneys with expertise in chemical, pharmaceutical, life sciences, and a broad range of engineering subjects. The trademark/design group has over 20 attorneys and they are managing global portfolios of a large number of global and domestic businesses. IP enforcement and litigation group have 10 seasoned litigators with vast experience and the team is led by an Advocate on record with the Supreme Court of India.

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