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Expert Analysis Chapters

- 1** **The First Year of the Unified Patent Court**
Trevor Cook, Bird & Bird LLP
- 8** **Practical Guidelines for Assessing Patent Quality**
David V. Sanker, SankerIP
- 13** ***Chevron* is Dead, Long Live *Chevron***
Ken Adamo, Law Office of KRAdamo
Eugene Goryunov, Haynes and Boone
- 16** **A “Road Just as Fair”: Potential Pathways for the Adoption and Use of Artificial Intelligence in Patent Drafting**
Dunstan H. Barnes, Wil Rao & Andrew W. Mills, McAndrews, Held & Malloy

Q&A Chapters

- 21** **Argentina**
Martin Bensadon, Ignacio Sánchez Echagüe & Eugenio Hoss, Marval, O’Farrell & Mairal
- 28** **Belgium**
Philippe Campolini, Louis Bidaine & Clémence Jonckheere, Stibbe
- 36** **Canada**
Melanie Szwercs & Parnian Soltanipannah, Smart & Biggar LP
- 44** **China**
Dr. Gordon Gao, Dr. Xiaoyi (Sherry) Yao, Maohua Wang & Dr. Xingbin Li, King & Wood Mallesons
- 53** **Croatia**
Iva Kuštrak Managić & Dina Korper Žemva, Korper & Partneri
- 61** **Finland**
Ben Rapinoja, Lasse Laaksonen, Jemina Bonsdorff & Minna Muukkonen, Borenus Attorneys Ltd
- 69** **France**
Catherine Mateu, Armengaud Guerlain
- 79** **Germany**
Dr. Johannes Ahme, Dr. Heinz-Peter Muth & Lars Manke, Uexküll & Stolberg
- 89** **Greece**
Eleni Kokkini, PPT Legal
- 96** **India**
Manisha Singh & Joginder Singh, LexOrbis
- 109** **Israel**
Adv. Lior Glassman & Adv. Jakob (Koby) Kasulin, Gilat, Bareket & Co., Reinhold Cohn Group
- 119** **Italy**
Luciano Vasques, DDPV Studio Legale
- 129** **Japan**
Kenji Tosaki, Nagashima Ohno & Tsunematsu
- 137** **Korea**
Yoon Suk Shin, Dong-Hwan Kim, Gon-Uk Huh & Kyu-Bok Lim, Lee International IP & Law
- 148** **Mexico**
Sergio L. Olivares, Daniel Sánchez & Rommy Morales, OLIVARES
- 159** **Pakistan**
Hameeda Asif & Samreen Khan, Bharucha & Co.
- 167** **Philippines**
Vida M. Panganiban-Alindogan, SyCip Salazar Hernandez & Gatmaitan
- 175** **South Africa**
Elaine Bergenthuin, Bergenthuin Inc.
- 183** **Spain**
Colm Ahern, Elzaburu
- 190** **Taiwan**
J. K. Lin & H. G. Chen, TIPLo Attorneys-at-Law
- 200** **Thailand**
Kamolchanok Sinhaseni & Pawarisa (Fon) Suwannachote, ZICOLaw (Thailand) Limited
- 209** **Ukraine**
Oleg Zhukhevych, Advance Partners
- 218** **United Arab Emirates**
Mohammad AlShraideh, Dr. Mohammad Zaidan & Salem Rawabdeh, PRIMECASE
- 226** **United Kingdom**
Katharine Stephens & Patrick Brown, Bird & Bird LLP
- 239** **USA**
Ken Adamo, Law Office of KRAdamo
Eugene Goryunov, Haynes and Boone

India



Manisha Singh



Joginder Singh

LexOrbis

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 Chennai, Delhi, Kolkata and Mumbai, a patentee can file a suit for patent 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 Crore (approximately USD 0.25 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 and High Court in aforesaid jurisdictions.

Although a claimant can choose between a District and High Court, such a choice becomes redundant once the defendant files a counterclaim seeking revocation of the patent. In such a scenario, the suit is 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 counterclaim seeking revocation of the subject patent.

A claimant may file a suit for an infringement at (a) the place where the cause of action has arisen, or (b) the residence or place of business where 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.

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

Parties may undertake mediation, a commonly used alternative, before commencing court proceedings. Under Section 12-A of the 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 also a commonly used alternative when the parties have agreed to arbitration under an agreement between them. In other words, the disputes arising solely from a contract may be treated like a contractual dispute irrespective of whether such a contract pertains to licensing/assignment of IP and therefore are arbitrable. However, if the disputes are related to determination of the statutory or proprietary rights of the owner of the IP, such disputes are not arbitrable as the right to be asserted is *in rem* and not *in personam*.

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

An Advocate under the Advocates Act, 1961, 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 having territorial jurisdiction over the case, the suit with the requisite court fee is presented along with an application seeking interim relief(s), such as an *ex parte* injunction. All documents must be filed (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 must be filed within 30 days of filing the suit.

The Court fee depends on the value of the suit and may range from 1–10% of the value depending on the jurisdiction. The value of the suit includes the amount of damages, the subject matter value, and the value of other reliefs claimed.

Ideally, proceedings should reach trial within one to two years, especially after the enactment of the Commercial Courts Act, 2015. However, practically, a claimant should expect the commencement of the trial between 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?

Relevant documents or materials are disclosed to the adversary only after the proceedings have commenced. 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 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 be collected by the claimant or an investigator. An affidavit of the person who has conducted the investigation and collected the evidence must be filed 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 in terms of 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 or 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 may also submit written arguments, and a copy of each such written argument must be furnished to the opposite party.

The trial may commence either before the Court or a commission formed by the Court to examine witnesses. Generally, the 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, which is further cross-examined by the opposite party. Such witnesses may also be permitted 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 the 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 permitted “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 carried out before a commission.

After the trial and final arguments, Courts fix a date for the pronouncement of a 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 above, 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 at 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, the Delhi High Court has permitted 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 duration of the trial can be reduced significantly.

Apart from the above, the identification of important witnesses and making them available promptly 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 an open court, as well as being published in leading journals. Third parties can request copies of the 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 considered persuasive?

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., decisions 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 as 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 precedents are not distinguishable on facts.

Regarding 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. However, in 2021, the Intellectual Property Division (IP Division) was created in the High Court of Delhi. The IP Division deals with all matters relating to IP rights, including fresh and pending IP. These cases include appeals against the decisions of the Patent/Trademark/Copyright Offices, revocation/cancellation actions and applications for rectification of the patents/trademark registers. In April 2023, the High Court

of Madras, by way of a gazette notification, announced the creation of the IP Division, making it the second court in India with such a division after the High Court of Delhi.

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, the 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; some trifling and unessential variations can in this case then 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 counterclaim. Once a counterclaim 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 can 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) 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 counterclaim.

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 is 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 mention 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 pending resolution of validity. However, in certain situations, the Courts may take a position to direct the Patent Office to first decide the issue of validity or may club proceedings before different courts for the same patent and wait to first decide on the validity of the patent by one of the Courts.

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 injunctions are granted on 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.

It is possible to file protective letters (*caveats*) with the Court to protect against *ex parte* injunctions.

Furthermore, final injunctions are also available.

There have been differing decisions of various High Courts on public interest as a defence to prevent the granting of injunctions. However, the Supreme Court of India in *Colgate Palmolive (India) Ltd vs Hindustan Lever Ltd* held that: “[t]he 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) [t]he 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) [b]alance 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) [w]hether 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/flagrancy 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, a rendition of accounts, royalty rates, interest, and even punitive. Yes, punitive damages are available, although in rare cases where intentional and flagrant infringement is apparent.

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 relief 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 effect does an appeal have on the award of: (i) an injunction; (ii) an enquiry as to damages or an account of profits; or (iii) an order that a patent be revoked?

An appeal itself would not stop the execution of an injunction, enquiry as to damages or order of revocation. A decree passed by the Court of first instance would be enforceable even if an appeal is filed against it. However, if the appellate court stays the operation of the decree either entirely or in some parts, the extent of the decree stayed cannot be enforced. If the appellate court stays the award of an injunction, enquiry as to damages or the order of revocation during the pendency of the appeal, these reliefs cannot be enforced.

1.31 Is an appeal by way of a review or a rehearing? Can new evidence be adduced on appeal?

The powers of the appellate court under the Code of Civil Procedure are not merely to review the decree. The powers go beyond review and include the powers to decide the case, finally, to remand back the case, to frame issues and refer them for trial or even re-trial and to modify the decree. An appellate court can modify the decree by reversing the decision or arrive at an altogether new finding based on the facts of the case. In this regard, the appellate court can take additional evidence and even re-consider the evidence already adduced before the Court of first instance.

1.32 How long does it usually take for an appeal to be heard?

There is no time fixed for hearing the appeal under the Code of Civil Procedure. It usually takes two to three years to decide on an appeal. However, the time taken by an appellate court in deciding an appeal depends on the complexity of the case such that those cases in which additional evidence is permitted by leave of the Court may take a longer time to decide.

1.33 How many levels of appeal are there? Is there a right to a second level of appeal? How often in practice is there a second level of appeal in patent cases?

Yes, the law provides a second level of appeal, but it is not a matter of right *per se*. An appeal from a decree passed by a District Court is appealable before a Single Judge of the High Court. The decree arising out of an appeal before the High Court can be appealed before the Supreme Court of India by way of a Special Leave Petition. Moreover, under the High Courts rules of different High Courts and the Letters Patent Act, a decision arising from a Single Bench of a High Court is appealable before a Division Bench (DB) of the same High Court. Thus, a decision of a Single Judge of a High Court is appealable either before a DB of the same High Court or the Supreme Court of India. However, this does not take away the option of appealing again before the Supreme Court of India by way of a Special Leave Petition against the decision of the DB.

1.34 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? What are the typical costs of an appeal and are they recoverable?

It is difficult to estimate the costs of proceedings before a Court of first instance or appeal. Typically, it could cost somewhere from USD 30,000 to USD 60,000 until the interim decision on the injunction. The costs for a trial may range from USD 125,000 to USD 250,000.

The costs for appeal could be around USD 50,000 or more. Under the Commercial Courts Act, legal costs are recoverable from the losing party both in the suits and appeals. The counsel of the winning party may submit a certificate with respect to legal costs and the Court can award legal costs based on the same. However, the entire legal cost may not be recoverable as the Courts have discretion in deciding the legal costs to be awarded against the losing party.

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. If the Controller believes that the proposed amendment is substantive, the proposed amendments shall be published in the official journal of patents. As per practice, amendments that are merely clarificatory/elaborative in nature and do not alter the scope of the invention are generally allowed. 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 permitted in India for which an application

should be made by the patentee to the High Court, with notice of the application being given to the Controller. 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?

It is a settled legal position that amendments beyond the scope of the specification and claims would not be permissible. The amendments to a patent application or a granted patent have constraints prescribed under Section 59 of the Indian Patents Act, which requires that an amendment can only be made by way of disclaimer, correction or explanation. Section 59 also provides that no amendments other than those for the incorporation of facts shall be permitted. 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 permitted.

The amendment of “product by process” claims to “process” claims is permissible under the scheme of the Indian patent law. However, the amendment of purpose-limited product claims to general product claims would be in the teeth of Section 59. Further, in one instance, the Court adopted the purposive interpretation for the determining scope of claim amendments and allowed amendments of “method for treatment” claims to “product”, which were held to be non-permissible by the Controller as per literal interpretations of Section 59. It seemingly expanded the scope of claim amendments. Thus, amendments are permissible for claims as long as the amendments are within the scope of the originally filed claims and specifications.

The High Court, hearing an appeal against a rejection order of the Patent Office, has the same powers as given to the Controller under Section 15, which includes the power to require amendment. The amendments falling outside the scope of Section 59, due to the erroneous application of non-patentability objections by the Controller, can be remedied by the High Court by requiring and allowing amendments at the appellate stage.

3 Licensing

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

Yes, terms of a patent licence may be limited under the Competition Act, 2002, if the royalty rate or other terms amount to an abuse of a 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 an exclusive grant bank, prevention of 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. Further, as per Section 68 of the Indian Patents Act, no licence is legally valid unless it is reduced to a written document containing all the terms and conditions that govern their rights and obligations. The agreement should also be duly executed, and a term sheet agreement does not qualify

as a licence agreement. Additionally, the patent licence term cannot be longer than the duration of the patent term.

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 a 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 the 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 the 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. Section 3 of the Patents Act, 1970, specifically states that the following are not inventions:

- (a) something frivolous or which claims anything contrary to well-established natural laws;
- (b) something which the primary or intended use or commercial exploitation 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 – for this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of a known substance are considered as 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; [clause (g) is 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, 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. The applicant for a patent in India is required to disclose the details of all applications filed outside India for the same or similar invention by the said applicant or the assignee of the applicant. The details of these corresponding applications are required to be furnished in Form 3 at the time of filing of the Indian application or within six months thereafter. As per the current procedure, the applicant is required to update the details of the corresponding applications by filing another Form 3 within three months from the date of issuance of the First Examination Report (FER)/Office Action in the said application.

The Controller of Patents, thereafter, is required to use accessible and available patent databases to check the details of the corresponding applications, including the prosecution history and the claims granted to such corresponding applications by other Patent Offices. In case the Controller finds that information submitted by the applicant on the corresponding

application is inadequate, then during the prosecution of the Indian application, the Controller may demand the filing of updated Form 3 by the applicant within two months of issuance of such demand. Any delay of up to three months in filing Form 3 by the applicant can be condoned or extended for another three months. There are no other duties of disclosure under Indian Patent laws except for the one detailed above.

Failure to comply with the above requirements, and more particularly, any wilful suppression of material information, may lead to the refusal to grant a patent in a pre-grant opposition proceeding. If the patent is granted, it 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 may be opposed by a 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 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 High Court or on a counterclaim 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 High Court within 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, one being under the writ jurisdiction.

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 a priority document(s), or Form PCT/IB/304 in case of an international application, as proof of entitlement to priority. The Indian Property Office (IPO) is both a participating and accessing office of the WIPO Digital Access Service with effect from 31 January 2018. An English translation of the priority documents may still be demanded by the IPO if a P-category prior art is cited. A certified priority document and/or a verified English translation thereof can be submitted within three months of notice from the IPO.

Section 7(2) of the Indian Patents Act provides for 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" must be submitted. In case of a national phase of the Patent Cooperation Treaty (PCT) application, the "proof of right" may be:

- (1) A declaration 12(i) in Form 1, duly signed by all the inventors.

- (2) An original/notarised/certified copy of the assignment document from the inventors in favour of the applicant.
- (3) An employee–employer agreement having a clause for the assignment of IP rights.
- (4) A 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 law, in practice, some of the controllers at the IPO do not accept this declaration and a consistent practice for acceptance of this declaration is yet to be notified by making necessary amendments in national laws.*]
- (5) If any of the above is unavailable, the applicant may consider filing a confirmatory assignment subject to the approval of the examining officer. The confirmatory assignment may be understood as an assignment, executed later, which confirms an earlier-made assignment between the parties involved.
- (6) The applicant may also consider filing an affidavit declaring the entitlement to the right to apply for a 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 allowed to file its reply and evidence, and after hearing both parties, the concerned authority, i.e., the IPO 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 in limited circumstances. In case the patent application is filed within 12 months from the day of the following publication/usage/display, no anticipation will be deemed to have taken place for:

- (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) Use 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).

To avail the grace period, the Applicant is now required to submit an application in the newly introduced Form 31, along with requisite evidence and paying prescribed fees of Rs. 500 (USD 6) for a natural person/startup/small entity/educational institution and Rs. 2,500 (USD 30) for others.

Given the above, any other prior publication on 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 application. In the 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 permitted in India.

There is no provision for a 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.

“One Application, One Inventive Concept” is followed in India. The concept of a divisional application in the Indian patent law addresses the issues of permissibility of protection of multiple inventions disclosed in one patent application, where these multiple inventions do not constitute a single inventive concept – dubbed as the plurality of inventions. Multiple inventions can be protected through divisional application.

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 must be by way of explanation, correction or disclaimer; amendments must be for incorporation of facts only; amendments need to be supported by the specification; and amendments cannot broaden the scope of claims. Therefore, the claims of the divisional application shall be distinct from the beginning. 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 a divisional application. Therefore, a divisional application, if required, should be filed at the earliest opportunity and preferably before responding to first office action.

5.9 For Member States within the European Union: Can a Unitary Patent, on grant, take effect in your jurisdiction? If your Member State has not yet signed or ratified the Unified Patent Court Agreement, is it likely to do so and, if so, when?

This does not apply to India.

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 formulated the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007, in consonance with the TRIPS and World Customs Organisation Model. The Indian Customs Department has the Customs Recordal system, where the rights holder records his rights. After this, the Customs Authorities help stop the cross-border movement of counterfeit or infringing goods. However, an amendment in June 2018 to the said rule omitted the word “patent” from the definition of IP. Therefore, after the amendment of the 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 a 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 and vested power in the Competition Commission of India (CCI), which prevents the abuse of a dominant position by any enterprise. However, in July 2023, the Delhi High Court in *Telefonaktiebolaget LM Ericsson v. Competition Commission of India* ruled that in an issue of abuse of dominance by a patentee in the exercise of their rights under the patent, the Patents Act, 1970, will prevail over the Competition Act, 2002. Therefore, it granted exclusive jurisdiction to the Controller General of Patents over the CCI. Reversing its single-judge decision in 2016, the High Court held that it would be contrary to legislative intent to permit the CCI to conduct inquiries into allegations of anti-competitive agreements concerning patents. Further, it posited that since the Patents Act provides the powers to deal with such agreements and is a special law in the field of patents, the CCI cannot enjoy jurisdiction.

Therefore, in view of the recent ruling, a complaint against a patentee’s abuse of a dominant position is an independent proceeding and does not affect any relief in a suit for patent infringement. However, the CCI has appealed the decision, and the final question is to be decided by the Supreme Court of India.

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 set FRAND terms (or would they do so in principle)? 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 (SEPs), technical trials on patent validity, infringement and assessment of FRAND licences are heard together if they arise from the same cause of action. Courts have recently granted FRAND injunctions and have also determined the royalty rates under the licence based on previous licence arrangements. The Courts have set the FRAND terms, including the licensing rates.

8 Current Developments

8.1 What have been the significant developments, including any leading cases, in patent law and practice in your jurisdiction in the last year?

Ever since the appellate jurisdiction of the Indian Patent office(s) was transferred to the High Court(s) after the abolition of IPAB (erstwhile Appellate Jurisdiction), IP law in India has seen unprecedented development both in terms of substantive law and procedural law and also with regard to interaction with other laws and systemic changes at the governmental level. There have been some remarkable judicial pronouncements that have settled the principle of patent law. These trends suggest a move towards broader protection, broader remedies and simpler procedures for conducting IP examinations by the patent office and handling lawsuits by the Court(s).

Some of the legal principles that have been evolved through court cases are as follows:

(1) *Avery Corporation v. Controller* (2022:DHC:4697)

Various structured tests in jurisdictions such as the US (Graham factual inquiry/KSR), the UK (Pozzoli five-step) or EP (problem-solution approach) may be applied to assess inventive steps or non-obviousness. However, the Indian statutory requirement that “invention must involve non-obvious technical advancement” is mandatory.

Secondary *indicia* (e.g. age of the prior art, long-felt want, etc.) may be used to indicate non-obviousness. These cannot replace the technical inventive step test but can complement it.

(2) *Chinese University of Hong Kong & Sequenom v. Controller* (2023:MHC:4617)

- Diagnostic methods: The word “diagnostic” should be limited to diagnostic processes that disclose pathology for the treatment of human beings.
- If a method identifies a disease/condition albeit subject to confirmation by definitive tests, it would still qualify as “diagnostic” for purposes of Section 3(i) and thus, is not patentable.
- However, if an invention is *per se* incapable of identifying the existence or otherwise of a disease and further testing would be required for such a purpose, then the invention is not prohibited under Section 3(i).
- Section 3(i) does not mark any distinction between *in vitro* or *in vivo* diagnostic methods.

(3) *Syngenta v. Controller* (2023:DHC:7473-DB)

The DB of the Delhi High Court held that:

- A divisional patent application can be filed *suo moto* by the applicant or in response to an objection by the Controller. In both cases, “plurality of inventions” is required to file a divisional application.
- A divisional application is maintainable provided the “plurality of inventions” is disclosed in the provisional or complete specification filed with respect to the parent application.
- A DB judgment is statutorily consistent. The DB overruled an earlier Single Judge’s restrictive interpretation in *Boehringer* (“plurality of inventions” is to be disclosed in the claims filed in respect of a parent application).
- Further, the *Boehringer* rule of what is not claimed is disclaimed had no application in any analysis linked to the presence of a plurality of inventions.

(4) *Opentv INC v. Controller of Patents and Designs and Another* (2023 SCC OnLine Del 2771)

Wherein the Hon’ble Court observed that the following aspects ought to be considered to hold an invention patent-

able or non-patentable under Section 3(k) – under the head business method:

- (i) whether the invention is primarily for enabling conduct or administration of a particular business, i.e., sale or purchase of goods or services;
- (ii) whether the purpose of the invention is to claim exclusivity or monopoly over a manner of doing business; and
- (iii) whether the invention relates to a method of sale or purchase of goods or services or is, in fact, a computer program producing a technical effect or exhibiting technical advancement. If it is the latter, it would be patentable, but not if it is the former.

Recent leading case laws on patent infringement

(1) *Lava International Ltd. v. Telefonaktiebolaget LM Ericsson*, 2024 SCC OnLine Del 2497, decided on 28 March 2024

- In a massive victory for Ericsson, the Hon’ble Delhi High Court, in its first final ruling, awarded Rs. 244 Crore (USD ~29 million) damages along with a 5% interest rate (until the realisation of the amount) to Ericsson against Lava for infringement of its seven (one patent was revoked) SEPs.
- The FRAND royalty rate, which has been decided by the Court applicable to Lava, has been determined to be 1.05% of the net selling price of the devices sold by Lava. The Hon’ble Court discarded the calculation of the royalty rate on a Chipset basis. The Court held that in mobile devices, where telecommunication network connectivity is the core functionality, the calculation of royalties at the end-product level is the most appropriate approach, aligning with industry practices, economic efficiency and legal precedents.
- On the aspect of infringement of an SEP, the Court has recognised the application of the two-step test for establishing infringement of SEPs, which involves mapping the suit patent(s) to the standards and showing that the implementer’s device also maps to the standard. Consequently, on account of compliance with the standards for Lava’s devices, infringement of the suit patents has been held to be an inevitable outcome.

Some key takeaways:

- (i) Infringement in SEPs can be established by demonstrating the essentiality and compliance of infringing devices to the concerned standard.
- (ii) The essentiality of a patent can be demonstrated through claim charts demonstrating alignment with the relevant standard.
- (iii) Defendants are to show the use of alternate technology if they wish to challenge infringement.
- (iv) Delay in negotiations, failure to respond to offers and failures to provide counteroffers are indicative of unwilling licensees.
- (v) In SEP cases, calculation of royalty at the end-product is the most appropriate approach.
- (vi) Comparable licences are the preferred approach to determine if offers are FRAND and to determine the FRAND rate.
- (vii) Inventions that result in technical effect which transforms or enhances functionality and effectiveness of a general-purpose processor are patentable.

(2) *Communication Components Antenna Inc (CCAI) v. Mobi Antenna Technologies (Shenzhen Co. Ltd)*

The Delhi High Court awarded Rs. 217 Crore in lost profits damages to CCAI in a patent infringement suit against Mobi Antenna Technologies.

Background:

A suit for patent (IN240893) infringement was filed by the plaintiff through its predecessor (TenXc Wireless Inc.) against the defendant. The defendant filed a counterclaim alleging that the suit patent is liable to be revoked on various grounds under Section 64 of the Patents Act, 1970. In the judgment dated 10 August 2021, the Court, while rendering findings on invalidity, rejected all grounds urged by the defendants and upheld the patent. However, at the same time, the Court on its own, proceeded to analyse whether the subject patent was liable to be revoked under Sections 64(1)(h) and (k) of the Patents Act, 1970, in the context of Section 10 of the Act. On this aspect, findings were rendered against the plaintiff, and it was concluded that the subject patent, i.e., IN240893, was invalid and liable to be revoked under Section 64(1)(h) and (k) of the said Act.

Appeal before the DB:

The plaintiff challenged the judgment dated 10 August 2021 before the DB. The DB order dated 1 December 2021, set aside the Single Judge's judgment and directed the Single Judge to frame a specific issue, and accordingly, an additional issue was framed, on the grounds of revocation under Sections 64(1)(h) and (k).

Remand back to a Single Judge:

It is interesting to note that when the additional issue was being framed on the grounds of revocation under Sections 64(1)(h) and (k) after remand back, the counsel for the defendant was present. However, the said counsel subsequently took discharge, and summons were re-issued to the defendant, and despite service, there is no appearance on behalf of the defendant. Thereafter, the proceeding before a Single Judge went uncontested by the defendant, who had to prove invalidity in view of Sections 64(1)(h) and (k). The Hon'ble Single Judge held that since the additional issue was premised on a question of fact, it was necessary for the defendant to make a specific pleading to that effect and lead evidence in support thereof. In the absence of such pleadings and no evidence having been led in this case, the Court could not conclusively hold that IN240893 was insufficiently disclosed.

Once the Hon'ble Court passed the judgment on the additional issue of invalidity, the suit was listed for other issues, such as infringement and relief if the infringement is proved. Again, none appeared in the further proceeding; based on the evidence produced during the examination of witnesses by the plaintiff and defendant, the Court concluded that defendant No.1's products infringe Claim 1 and Claim 10 of IN'893.

For the damages calculation, the Court considered the following factors:

- (a) Market size lost by the plaintiff in India.
- (b) Retail price of antennas in India, Canada and the USA covered by the suit patent during the infringement period.
- (c) Manufacturing cost of the antenna.

Based on the above, the Hon'ble Court awarded Rs. 217 Crore (USD ~26.1 million) as damages for lost profits in a patent infringement suit.

However, on the issue of granting a certificate of validity under Section 113 of the Patents Act, the Court held that defendant No.1 had abandoned the proceedings midway and were proceeded *ex parte*. Considering that the suit was uncontested, the Court did not grant a certificate of validity under Section 113 of the Patents Act.

8.2 Are you looking forward to any particular developments in patent law or practice in the coming year or two and what effect might they have in your jurisdiction?

Based on the recommendations of the Parliamentary Committee on Review of IPR laws and the multiple stakeholders' meetings organised, various statutory, regulatory and administrative reforms are expected in Indian IP laws for harmonisation, to boost foreign direct investment and to incentivise technology transfer in India.

Given the ever-increasing landscape of emerging technologies such as Artificial Intelligence, the Delhi High Court, while referring to recommendations of the Parliamentary Committee, expressed concern that a large number of inventions may be excluded from patentability under Section 3(k) and, therefore, suggested to the DPIIT to re-examine the exclusions for computer-related inventions. It is expected that these repeated proposals will reach the corridors of policymakers on this occasion and action will be initiated.

The bio-pharma industry is keenly awaiting the judicial review of the Delhi High Court on the method of medical treatment exclusion. The scope of patentability of diagnostic method patents will be determined by the upcoming verdict that may have a bearing on many biotechnological and pharmaceutical applications.

Judicial recommendations have been made that recognise an imminent need to update the Manual of Patent Office Practice and Procedure so that Examiners and Controllers can get better guidance on dealing with intricate matters like objections of non-patentability. The Delhi High Court has also advised the Office of the Controller General of Patents, Designs & Trade Marks to augment and strengthen the quasi-judicial capacity development program for the Controllers. The ball is in the court of the Patent Office. We anticipate an overhaul in prevailing practice and guidelines capturing recent trends set by the IP Division through its decisions. If done properly and timely, this could prove to be a point of inflection for the sector.

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

Some of the noticeable trends in recent years include the reduced waiting time for examination, faster disposal of IP applications, steady increase in IP applications filed, continual and progressive legislative reforms, and increase in the number of IP litigations for either enforcement or invalidation, leading to landmark judgments. All these trends signify the development of a conducive IP system in India to incentivise technology transfer and boost foreign direct investment rapidly. So far, the success rate in appeal cases disposed of by the IP Division tilts in favour of applicants, reflecting a pro-patentability stance; however, the long trend will be revealed in years to come.

In the case of SEP litigation, we are noticing an emerging trend where courts are ordering defendants to deposit *pro-tem* security even before deciding on an application for an interim injunction. In the recent case of *Nokia v. Oppo*, the Hon'ble DB of the Delhi High Court recognises that SEP owners are entitled to *pro-tem* security as a matter of right, and it is the obligation of the implementor company to secure the right of SEP

owners. The concept of *pro-tem* security was further applied in another SEP litigation in the case of *Atlas v. TP-Link*. Therefore, we believe that *pro-tem* deposits as an issue are only going to get more and more popular in the future.

Further, in view of the recent judgments in SEP patent litigation in the case of *Lava v. Ericsson*, where the Hon'ble Court decided the suit in favour of Ericsson and granted it damages to the tune of Rs. 244 Crores (USD 29.9 million) along with legal costs, we believe that India is poised to play a key role in shaping the future of SEP enforcement.

8.4 Are there any key issues in relation to patent law or practice that you feel are not addressed by the questions above which are worth mentioning here?

On 15 March 2024, the Ministry of Commerce and Industry (Department for Promotion of Industry and Internal Trade) notified the Patents (Amendment) Rules, 2024, in the Official Gazette of India, which have already come into effect from the date of publication, i.e., 15 March 2024. The amended rules aim to introduce some significant changes to align the Indian patent practice with international standards, promote innovations among innovators and protect their rights. The amendments target key areas of concern in the Indian Patent practice and procedures and are poised to stimulate an increase in patent filing and processing within the nation. Some of the key changes brought about by the Patents (Amendment) Rules, 2024, are as follows:

Due date for filing a Request for Examination (RFE) (Section 11B)

The due date to file an RFE in a patent application has been changed from 48 months to 31 months from the earliest priority date.

The new due date applies to applications filed on or after 15 March 2024. For applications filed on or before 14 March 2024, the due date will remain 48 months from the earliest priority date.

Submission of Form 3 (information about corresponding applications) (Section 8(1))

Patent applicants are now required to submit details of corresponding applications on Form 3 only twice. The first Form 3 is to be submitted along with the filing of the Indian application or within six months therefrom, and the second Form 3 is to be submitted within three months of the date of issuance of the FER.

Submission of prosecution details/documents for the corresponding applications (Section 8(2))

The amended Rules recommend that the Controller of Patents use accessible and available databases to consider information related to corresponding foreign applications. However, for the reasons to be recorded in writing, the Controller may ask the applicant to file a fresh Form 3 within two months from the date of such communication. The said two-month period is extendable, or delay in filing Form 3 within the said two-month period is condonable for a period up to three months. An application for extension or condonation of delay in filing Form 3 is to be filed on Form 4 with an official fee of Rs. 2,000 (USD 25) for natural persons/startups/small entities/educational institutions and Rs. 10,000 (USD 125) for others.

Working statement (Section 146)

Patentees are now required to file working statements for granted patents in India for every three financial years on

Form 27 and not every year as it was prescribed in the previous rules. The financial year in which the patent was granted is excluded from calculating the commencement of the filing of working statements.

Working statements should contain information on the workings of the patent for the past three financial years and should be filed by 30 September of every fourth financial year. The Controller may allow an extension of time or condone the delay in filing the working statement by three months upon filing a request on Form 4 and on payment of the official fee of Rs. 2,000 (USD 25) for natural persons/startups/small entities/educational institutions, and Rs. 10,000 (USD 125) for others.

Form 27 has also been simplified, and the patentee is no longer required to provide value or sales data accrued in India for the reported patent. The patentee can now indicate his intent to commercialise the reported patent through licensing, and for that, he can provide the contact details on Form 27.

Divisional application (Section 16)

As per the amended Rules, patent applicants can voluntarily file a divisional application claiming the subject matter that has been disclosed in earlier provisional, complete or previously filed divisional applications.

Extension for filing a response to the FER (Rules 24B and 24C)

A request for an extension of time to file a response to FER by three months can be filed at any time within the said three months. Under the previous Rules, the request was required to be filed before the expiration of the six months available for filing a response to the FER.

Grace period (Section 31)

Applicants opting to avail themselves of a 12-month grace period for filing an Indian patent application are now required to file an application on the newly introduced Form 31 with the documentary evidence based on which the grace period is claimed.

The official fee prescribed for filing an application on Form 31 is Rs. 500 (USD 6) for a natural person/startup/small entity/educational institution or Rs. 2,500 (USD 30) for others.

Pre-grant opposition (Section 25(1))

The Controller receiving a pre-grant opposition is now required to ascertain whether a *prima facie* case is made out in the representation or not. If the Controller is satisfied that no such case is made out, a notice to that effect is to be issued to the opponent, and unless the opponent requests a hearing, the Controller needs to pass an order for refusal of pre-grant opposition representation. However, if the Controller is satisfied that a *prima facie* case is made out, a notice should be issued to the applicant.

The time to file a reply statement by the applicant to the representation of pre-grant opposition is reduced from three months to two months from the date of receiving such representation from the Controller.

The amended Rules also prescribe an official fee for filing a pre-grant opposition, which is Rs. 4,000 (USD 50) for natural persons/startups/small entities/educational institutions and Rs. 20,000 (USD 250) for others.

Post-grant opposition (Section 25(2))

As per the amended Rules, the period for submission of a recommendation by an Opposition Board to the Controller has been reduced from three months to two months from the date of receiving all the requisite documentation from the Controller.

Certificate of Inventorship

A new provision has been added for inventors to obtain a Certificate of Inventorship with respect to a granted patent in India. To obtain this certificate, inventors should file an application on Form 8A, which entails an official fee of Rs. 900 (USD 11).

Payment of annuity (Section 53)

The patentee can now avail of a discount of 10% on annuity fees if they opt to pay annuity through electronic mode for at least four years in advance.

Controller's power to condone irregularity (Rule 137)

The Controller's power to allow amendments in documents for which no procedure is provided or to obviate irregularities related to the following matters would not be applicable under Rule 137:

- (1) an extension of time or condonation of delay beyond three months is provided for filing Form 3;
- (2) filing of national phase applications beyond 31 months;
- (3) filing of an English translation of an international application;
- (4) filing of an English translation of a certified priority document;
- (5) time prescribed for filing a RFE, response to the FER and extension related thereto for regular examination;

- (6) time prescribed for filing a response to the FER and extension related thereto for expedited examination;
- (7) time prescribed for filing a reply statement to the pre-grant opposition;
- (8) extension for payment of annuity beyond six months;
- (9) time prescribed for filing a review of the Controller's decision and for filing an application to set aside the Controller's decision if passed *ex parte* in review proceedings; and
- (10) extension beyond six months for filing the working statement.

Controller's power to extend time prescribed under the Rules and to condone delay

The Controller has been empowered to grant an extension of time for any time period specified in the Rules or to condone any delay for a period of up to six months. A request for extension or condonation of delay under Rule 138 is required to be filed on Form 4 with payment of official fees of Rs. 10,000 (USD 125) for natural persons/startups/small entities/educational institutions and 50,000 (USD 625) for others, per month.

The amended Rules demonstrate India's commitment to establishing a robust ecosystem for the protection of IP rights that meets international standards. The amended Rules are expected to enthruse patent filers to avail themselves of protection in India.



Manisha Singh is the Founder and Managing Partner at LexOrbis, holding a decorated career spanning over 26 years. As an IP attorney trained both as a patent agent and litigator, she advises strategies and manages the building up of a strong and commercially viable patent portfolio for many Indian universities, publicly funded research institutions and large and medium-sized companies. For the past decade, she has also been working closely with Indian startups and enterprises driven by women entrepreneurs and inventors in India and globally. Under her guidance, the firm now drafts over 1,000 new patent applications for inventions originating from India in respect of a wide range of new and emerging technologies, including Artificial Intelligence, quantum computers/software, semiconductors, energy storage, EVs, etc. In her leadership role, she enjoys developing and retaining talents at the firm and developing a team that can take this journey of the firm for the times to come.

She also works closely with her clients to maximise the commercial use of their IP assets and scout partners if the assets are implemented through third parties. The firm also assists clients at each step of the commercialisation of their IP assets, starting from identifying necessary partners and negotiating and documenting licences and other transactional agreements. For numerous global companies, she advises and oversees the formation and implementation of effective litigation strategies, eventually resulting in global or Indian licensing programmes. Additionally, with other partners at the firm, she works on creating, modifying and implementing processes that ensure high quality and timely delivery of the firm's services to the clients. She also works closely with the team to identify and deploy the latest technology tools to automate such work processes without compromising our quality standards. She, along with her other colleagues, is also responsible for the practice development of the firm, and she is constantly engaged in writing case law updates every month and deeply researched papers every year on the emerging trends in the global IP space.

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Joginder Singh is a highly experienced and skilled practitioner with over 16 years of expertise in patent law. He has a proven track record of success in securing, protecting and managing patents and has knowledge and experience that covers the full cycle of patent services. Joginder has an in-depth understanding of the current legal and business environment and has successfully developed and led strategic initiatives for both established and startup businesses. He is well-versed in all aspects of patent law and policy and has a thorough understanding of the latest trends and obligations applicable in major jurisdictions. He is a registered patent agent in India and the head of Engineering Patent Practice at LexOrbis IP Attorneys & Advocates, leading a team of over 70 engineers. He holds a graduate degree in Computer Science and diplomas in Electronics and Telecommunications, Computer Applications and Microsoft .Net technology.

With strong domain expertise and practical experience, he serves domestic and international clients, including many *Fortune 500* companies. Joginder uses his exceptional communication and client management skills to actively advise clients on patent protection strategies and building strong and enforceable patent portfolios. He has the knowledge and expertise to guide the best course of action for each individual case, ensuring that companies and inventors get the most out of their patent portfolios. In addition, his expertise in the patent application drafting process guarantees clients receive high-quality service, maximum efficiency and, ultimately, a maximum return on investment in patents. He follows a comprehensive approach during patent prosecution, leading to high-quality patents and helps clients understand their patent rights and ancillary responsibilities.

He also engages in knowledge-sharing through writing articles and giving public speeches, regularly attending national and international IP conferences to network with the IP community across the globe. He is an active member of various IP associations and actively participates in various study groups and committee meetings. He was as an executive member of the APAA India national committee and has received numerous recognitions and accolades from various reputed organisations.

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The firm has dedicated teams, including attorneys, engineers, scientists, paralegals and technical specialists who handle patent, trademark and copyright matters, from filing to research, portfolio management, enforcement, protection, transaction and consultation.

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