PART A

4x5 M = 20 marks (4 questions)

Q.1 A and B are co-inventors of a tracking device. Later A files an application for a patent in his own name, B comes to know about this fact from the Journal of the Patent office. What action B can take to redress this injustice inflicted upon him by A?

Answer:

If an application for a patent has been made with an exclusion of the name of any inventor, it is possible to intervene and seek redressal. When excluded, an inventor so excluded may make a claim to be included in the application, under the provision of Sec. 28(3) of the Act, which states:

"If any person other than a person in respect of whom a request in relation to the application in question has been made under sub-section (2) desires to be mentioned as aforesaid, he may make a claim in the prescribed manner in that behalf."

Such a claim has to be made by B in Form 8, setting out the circumstances for making the claim, and payment of ₹800. A copy of the statements and the claim will be sent by the Controller to A, as well as to any person interested (as considered by the Controller) (Sec 28(6), Rule 67).

Further, Sec 28(6) also stipulates that such a claimant be heard before the Controller makes a decision. The procedure for hearing will be conducted as per Rule 69.

Q.2 Y owns an Indian Patent. X requests for a licence under the patent from Y. Y imposes certain conditions such that X cannot acquire such articles which are not covered by the Patent from any person other than Y. Y also imposes a condition of exclusive grant back in the licence. As an agent do you think these conditions are appropriate? Please give your answer vis-à-vis the relevant provisions of the patents act.

Answer:

The Patents Act clearly stipulates certain conditions to be unlawful, when imposed by a patentee on a licensee. The conditions mentioned above have found express mention as being restrictive conditions that are to be avoided under Sec 140 (1) of the Act. Sec 140(1)(a) prohibits the patentee from regulating/restricting the purchase of articles (other than those that the patent covers) by the licensee. Sec 140(1)(d) clearly instructs avoidance by the patentee from imposing an exclusive grant back. Hence, these conditions imposed by Y on X will be deemed unlawful.

Q.3 **An inventor/applicant has filed an application for patent in India and approaches you immediately thereafter for filing international application under PCT with specific questions on the following:**

a) Whether he can claim priority of his application filed in India and within what time

b) When he can file a national phase application from PCT route.

c) After filing of national phase application, what would be the fate of this previous application?

Please advise him as per the provisions of PCT and the Indian Patents Act.

Answer:

a) To claim priority from an earlier application filed in India, an applicant has to file an international application under PCT within 12 months [Sec 135(3)]. Thereafter, the earlier application will be treated as the basic application.

b) In accordance with Articles 22 of the PCT, an applicant can claim priority from an earlier filed application within 30 months of the filing of said application. Article 22(3) further states that national laws can supersede the aforementioned. In this light, Rule 20(4)(i) of the Indian Patents Act extends this time further by a month. So, within 31 months of his basic application, the inventor can file his national phase application and claim priority from his basic application upon submission of the required priority documents.

c) A request for examination under Section 11B shall be made only for one of the applications filed in India. [Section 135(3)] Therefore, in the absence of not filing a request for examination the previous application shall be treated as withdrawn by the applicant [Section 11B(4)].

Q.4 **Write a short note on the benefits provided for startups and small entities under the Patents Rules.**

Answer

In the recently amended Patents Rules, a number of provisions have been made available for startups and small entities. Small entities are defined under Rule 2(fa), and startups are defined under Rule 2(fb). For claiming the status of a small entity/startup, an applicant needs to submit details in Form 28, and no fee is prescribed for the same. By claiming this status, all applicants can enjoy reduced fees for whatever services are chargeable. Startups have the added advantage of being able to avail of expedited examination of their application as per Rule 24C, upon payment of an enhanced fee. This would considerably reduce the time taken for examination.

Q.5 Section 3(d) of Indian Patents Act, 1970 was amended which includes an explanation as follows:

"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;

Explain the term "efficacy" in the light of the judgment of Supreme Court and other relevant orders by different courts in the matter of Novartis vs Union of India involving an anti-cancer compound

Answer

Background:

Novartis sought patent protection for the β-crystalline form of imatinib mesylate (marketed as Glivec™/Gleevec™) in India. The crystalline form of imatinib mesylate was a new form of a known substance, imatinib, Upon pre-grant opposition, the Controller rejected the invention as being not novel or inventive, and in contravention of Section 3(d) of the Patents Act. Novartis appealed the decision before the High Court, which transferred the case to the Intellectual Property Appellate Board. The IPAB reversed the Controller's decision on the issue of novelty and non-obviousness, but held that it was still unpatentable under Section 3(d). Novartis filed a special leave petition in the Supreme Court against the order of the IPAB.

Supreme Court decision:

The Supreme Court revisited the grounds of novelty, non-obviousness (under Secs. 2(1)(j), 2(1)(ja)), and patentability (under Sec. 3(d)), and rejected the patent on all these grounds. Novartis argued that the compound demonstrated efficacy by virtue of its increased stability, and also supplied an affidavit to demonstrate increased bioavailability. The Court clarified that 'efficacy', as defined by 3(d) in the case of pharmaceutical substances, related to 'therapeutic efficacy', which needs to be demonstrated, and not assumed based on a proxy measure like bioavailability. Other properties such as thermal stability, increased flow, or lower hygroscopicity, which may also be beneficial, but will not factor into efficacy. Since there was no demonstration of increased therapeutic efficacy, the invention was held unpatentable under Sec. 3(d).

Impact and Context:

Glivec™ was a blockbuster drug for Novartis (>1 billion USD/year in revenue). The move to patent imatinib mesylate came close on the heels of the end of the 20 year patent term on imatinib. This was viewed as a manouevre to extend Novartis' monopoly on this anti-cancer drug, in a practice known as 'evergreening'. The judgment in the Novartis case was seen as a landmark precisely for this reason, in curbing such questionable practices by big pharma companies.

Q.6 A invents a medicine which is a combination of components A, B and C. Component C is a powder of herb which occurs in hilly terrain of Assam and adjoining areas. As a Patent agent advise him regarding the essential procedural and substantial aspects of patenting such combinations.

Answer

There are some particular aspects of this invention that will need special consideration while applying for a patent.

a) Combination

When considering inventions that are a combination of components, we need to ensure that isn't in contravention of Sec 3(e) of the Patents Act. Section 3 outlines inventions that are not patentable according to Indian law, and 3(e) specifically states:

"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;"

To cross the bar for patentability set by 3(e), it is necessary that the effect of this combination is not simply additive, and synergistic effects, or a distinctive advantage, emerges out of this particular combination.

b) Herbal component

Component C, being a herb, might also attract the provisions of Sec. 3(p), that deems the following as not patentable:

"an invention which, in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components."

In this case, it can present some difficulties in patenting compositions containing C, if it were already known from traditional knowledge. Examiners at the Patent Office will undertake a search for this component in the Traditional Knowledge Digital Library, which is a repository of traditional herbal medicines and formulations. Not limited to this, a granted patent can be subsequently challenged on the ground of being part of orally transmitted traditional knowledge too, if such is the case (Secs. 25(1)(k), 25(2)(k), and 64(1)(q)).

c) Source of herb

Form 1, which is required to be submitted along with every application for a patent, also stipulates that where the source is India, requisite permission from the relevant authority needs to be obtained. In this case, the National Biodiversity Authority needs to give permission (as per Section 6 of the Biodiversity Act, 2002) for the invention to be found to be in order for grant (but not required before application). A request for permission can be filed in Form III, and upon payment of the fee of ₹500 at the office of the National Biodiversity Authority of India.

After considering the above, we can go ahead with patenting the combination.

Q.7 A patent was granted to X on a communication system. After getting the patent X serves a notice of infringement upon Y on the ground that he was infringing the patent granted to X. Y approaches you for suitable advice. Please explain to Y the remedies under the Patents Act.

Answer:

There are many possible routes that we can take in response to this notice of infringement. Firstly, we need to see if the infringement claims are baseless, if the system that you are using is considerably different or beyond the scope of X's invention as claimed, and would not constitute an infringement. If that is the case, Sec. 106 of the Patents Act allows us to sue X for serving a notice for infringement, this being a groundless threat. In such a case, the reliefs we may obtain include an injunction against continuance of the notice, declaration that such threats were unjustified, and for damages sustained thereby.

The Court may also make a declaration as to non-infringement. In this case, we have to write to X requesting for an acknowledgment of non-infringement, after detailing or describing the system that we are in possession, perhaps drawing out distinctions from his claimed invention that are beyond the scope of his claims. In case X does not acknowledge this request, and refuses or neglects it, a suit for such declaration might be brought to Court, as per the provisions of Sec 105 of the Act. In this case though, we will also have to bear the cost of all parties for the Court proceedings (Sec. 105(2)), so it might not be our best option.

On the other hand, it is also entirely possible that the nature of your use entails it not to be considered as infringement. If you are using the invention in some capacity officially recognized by the Government, and in dispensing its duties and for its own use, you will not be liable for infringement (Sec 107 & Secs. 47(1), 47(2)). Likewise, if use of your wireless system is purely for research, experiment, or imparting instructions to pupils, it would not constitute infringement (Sec. 47(3)). Finally, if you were using your system solely for development and submission of information required under any law in force (say, to comply with some regulations on communication devices/systems), this wouldn't constitute an infringement (as per Sec. 107A).

While the above avenues relied on exempting use of your system from constituting an act of infringement, the other option would be to attempt revocation of X's patent (or invalidation of claims therein) as a ground for defence (Sec. 107). For this, we can make a counterclaim in the High Court if X initiates court proceedings for infringement. The following can all be grounds for revocation of a patent under Section 64(1):

"(a). that the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in India;

(b). that the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefore;
(c). that the patent was obtained wrongfully in contravention of the rights of the petitioner or any person under or through whom he claims;
(d). that the subject of any claim of the complete specification is not an invention within the meaning of this Act;
(e). that the invention so far as claimed in any claim of the complete specification is not new, having regard to what was publicly known or
(f). that the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step, having regard to what was publicly known or publicly used in India or what was published in India or elsewhere before the priority date of the claim;
(g). that the invention, so far as claimed in any claim of the complete specification, is not useful;
(h). that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection;
(i). that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;
(j). that the patent was obtained on a false suggestion or representation;
(k). that the subject of any claim of the complete specification is not patentable under this Act;
(l). that the invention so far as claimed in any claim of the complete specification was secretly used in India, otherwise than as mentioned in sub-section (3), before the priority date of the claim;
(m). that the applicant for the patent has failed to disclose to the Controller the information required by section 8 or has furnished information which in any material particular was false to his knowledge;
(n). that the applicant contravened any direction for secrecy passed under section 35 or made or caused to be made an application for the grant of a patent outside India in contravention of section 39
(o). that leave to amend the complete specification under section 57 or section 58 was obtained by fraud;
(p). that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;
(q). that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere."
Based on further details that you provide, we can pursue a necessary course of action.