

N.D.O.H. 23/04/2018

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Recd
20/4/18

BEFORE THE HIGH COURT OF DELHI AT NEW DELHI

(CIVIL WRIT JURISDICTION)

WRIT PETITION (CIVIL) No.5590 OF 2015

1226

IN THE MATTER OF :

Shamnad Basheer

.....Petitioner

Versus

Union of India & Ors.

.....Respondent

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Respondent/IOI

THROUGH

for Madhika

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DELHI HIGH COURT, NEW DELHI - 110 005
ENO.D-474-R/1998
PH.:011-23381256, MOB.: 9811191920

NEW DELHI
DATED: 20.04.2018

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IN THE HIGH COURT OF DELHI AT NEW DELHI

WRIT PETITION (CIVIL) NO. 5590 OF 2015

IN THE MATTER OF:

Shamnad Basheer

..... Petitioner

Versus

Union of India & Others

..... Respondent

AFFIDAVIT

I, Dr. Suman Shrey Singh S/o Dr. Vijay Pal Singh, Aged 56 years, Indian Inhabitant, presently working as Deputy Controller of Patents and Designs in the office of Patent Office Delhi under Office of Controller General of Patents, Design and Trade Marks Department of Industrial Policy & Promotion, Ministry of Commerce & Industry, Government of India, and am authorised to file the present affidavit on behalf of the Respondent and do hereby, state on solemnly affirm and state as under :

1. That the deponent is filing present affidavit in compliance with the directions issued by this Hon'ble Court during the course of hearing on 15.03.2018 as below:
"Para 6. We direct the respondent no.1 to place before this Court a reasonable time line within which the consultation would be completed, suggestions received examined and such amendments as may be deemed necessary would be effected under the Patents Act 1970. Such affidavit shall be filed within one week of 21st March, 2018, when the stakeholders meeting is proposed to be convened.

Para 7. For enabling effective participation, let the comments received be immediately posted on the website."

That respectfully submitted before this honourable court that in continuation of circular, subject to stakeholders meeting regarding issues related to working of patents under the Patent Act, 1970 dated 01/03/2018, respondent has further issued circular for extension of date to receive comments up to 23rd March 2018 and then meeting on 6th April 2018.

3. That respectfully submitted that office of Controller General of Patents, Designs and Trademarks; respondent has posted the compilation of all the representation as received from stakeholders in official website on 2nd April, 2018. Respondent has also prepared a summary of such comments and uploaded the same in official website along with compiled comments of stakeholders.



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- 4. That respectfully submitted that meeting as scheduled held at Intellectual Property Office, Dwarka, New Delhi at 3:00 PM. This meeting was attended by 43 stakeholders including counsel of petitioner as well as the interveners in the present petition. List of Participants is submitted as **Annexure-1**.
- 5. That respectfully submitted that minutes of the meeting are attached as **Annexure-2**.
- 6. That respectfully submitted that reasonable timelines as directed in para 6 of order dated 15th March 2018 are attached as **Annexure-3**.

Mallika
 identified the deponent who
 has signed in my presence



Suman Shrey Singh
 DEPONENT

डॉ सुमन श्रेय सिंह/Dr. Suman Shrey Singh
 उप नियंत्रक एकलव एवं अभिकल्प
 Dy. Controller of Patents & Designs
 भारत सरकार/Govt. of India
 एकलव कार्यालय, दिल्ली/The Patent Office
 द्वारका नई दिल्ली/Dwarka, New Delhi

VERIFICATION 20 FEB 2018

I, Dr. Suman Shrey Singh, the above named deponent, do hereby verify that the contents of the above affidavit are true and correct, and nothing material has been concealed therefrom. Nor, any part of it is false.

Verified at New Delhi on this the 20 day of February 2018.

CERTIFIED THAT THE DEPONENT
 Sd/- / Sent / Km :
 Sd/- / No. / So.
 I do hereby certify that
 His / Her identity is proved by
 Do not
 That
 have been
 him are true & correct.

Suman Shrey Singh
 DEPONENT

डॉ सुमन श्रेय सिंह/Dr. Suman Shrey Singh
 उप नियंत्रक एकलव एवं अभिकल्प
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 भारत सरकार/Govt. of India
 एकलव कार्यालय, दिल्ली/The Patent Office
 द्वारका नई दिल्ली/Dwarka, New Delhi

**List of Participants: Stakeholders meeting held on 6th April 2018 at IPO Delhi
on Working of Patents**

S.N.	Stakeholder name	Location	Category
1	Venkatesh Krishnamoorthy , Country Manager- India, BSA- The Software Alliance	Delhi	Industry
2	Dr. S.K. Murthy , Core-Committee Member, In-House IP professionals (I-HIPP) forum	Bangalore	IP Lawyers Group
3	Archana Shankar, Anand & Anand	Delhi	IPR Professionals Firm
4	Aparna Kareer, Obhan & Associates	New Delhi	IPR Professionals Firm
5	Mr. Sarjinder Sethi, (TCS), CII	Delhi	Industry Association
6	Anubha Sinha ,Centre for Internet and Society (CIS) India	Delhi	IP related Organisation
7	Hrishikesh Raychaudhury ,Corporate Law Group	Delhi	IPR Professionals Firm
8	Dr. Mahendra Thakre, Mylan IP Legal Team, Mylan Laboratories Limited	Hyderabad	Industry
9	Mr. Dipanjan Som,, De Penning & De Penning	Chennai	IPR Professionals Firm
10	Dr. Raj S. Davé , IPR Chair Professor for Excellence at Gujarat, National Law University	Ahmedabad	Academician
11	Leena Menghaney Delhi Network of Positive People and Medecins Sans Frontieres(MSF) – Access Campaign,	Delhi	Forum for MSF- Access Campaign
12	Ms Priyam Lizmary Cherian		Lawyers' Collective
13	Dipankar Barkakati Federation of Indian Chambers of Commerce and Industry	Delhi	Industry Association
14	Ms. Nilam Gadani, H. K. Acharya & Company,	Ahmedabad	IPR Professionals Firm
15	Suman Kumar Bhattacharya , Hindustan Unilever Ltd.	Mumbai	Industry
16	Matthew ROSE , Senior IP Counsel , Huawei Technologies Co Ltd	China	Industry
17	Mr. Tanaka, Japan Intellectual Property Association "JIPA",	Japan	Industry IP Association - Japan
18	Mr. Sukahara, Japanese Intellectual Property Group (JIPG), -JETRO	New Delhi	Industry IP Association
19	Mr. Jyoti sagar, K & S Partners	Gurgaon	IPR Professionals Firm
20	Lall Lahiri & Salhotra	Delhi	IPR Professionals Firm
21	Dr. Malathi Lakshmikumaran of Laxmikumaran & Sridhdaran	Bangalore	IPR Professionals Firm
22	Manisha Singh, Managing Partner, Lexorbis IP Attorneys	Delhi	IPR Professionals Firm
23	Narendra R. Thappeta, Law Firm of Narendra Thappeta	Bangalore	IPR Professionals Firm
24	M. Adinarayana, Company Secretary & V.P. NATCO PHARMA LIMITED	Hyderabad	Industry

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25	Dr. Ajaykumar Sharma Director, OPPI	Delhi	Industry Organisation (Pharma)
26	Dr. Deepa Tiku Jay A. Erstling Of Counsel Patterson Thunete IP	Delhi	Patent Agent (USA)
27	Ranjana Mehta Dutt Remfry and Sagar	Delhi	IPR professionals Firm
28	Mr. Majumdar, S. Majumdar & Co.	Kolkata	IPP Professionals Firm
29	Mr. Kunal Setiya, S.S. Rana and Co.	Delhi	IPR professionals Firm
30	Mr. Anoop Jain Samsung India Electronics Pvt. Ltd,	Noida	Industry
31	Adv. Sai Vinod (representative of Prof. Shamnad Bashir)	Delhi	Academician
32	Devanshu Khanna, Singh & Singh Law Firm LLP	Delhi	IPR Professionals Firm
33	Sunita K Sreedharan, SKS LAW ASSOCIATES,	Delhi	IPR Professionals Firm
34	Komal Katha, Senior Counsel, United States Patent and Trademark Office- Office of South Asia	Delhi	US Government
35	Yogesh Pai ,Assistant Professor, NLU Delhi	Delhi	Academician
36	Representative from ASSOCHAM	Delhi	Industry association
37	Kanu priya, Representative ,Kan and Krishme	Delhi	IPP Professionals Firm
38	Anju Khanna, Lal & Sethi	Delhi	IPP Professionals Firm
39	Dr. Sheetal Chpra Erricson	Delhi	Industry
40	Mayuree Sengupta, Regional Centre for Biotechnology, NCR Biotech Science Cluster	Faridabad	R & D Organisation
41	Naveen Varma, ZeusIP	Delhi	IPP Professionals Firm
42	D Calab Gabriel, FICPI INDIA (LEX IP Care)	Delhi	IPP Professionals Firm
43	Rajiv Kr. Choudhry	Delhi	Patent attorney

[End of Documents]

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Annexures-2Minutes of meeting of stakeholders held at IPO Delhi on 6th April 2018 regarding provisions on Working of Patents in patents Act and Rules

A meeting of stakeholders who have submitted comments/suggestions on the provisions regarding Working of Patents provided under section 146 of the Patents Act read with Rule 131 of Patent Rules, Form 27 and penal provisions under section 122 was held at IPO, Delhi on 6th April 2018.

67 stakeholders from different fields i.e. IPR law firms, industry associations from the country and abroad, individuals, domestic and foreign industries, IPR activists, academicians, IP chairs etc. had sent their comments in response to the circular and 43 stakeholders, either themselves or through representatives, attended the meeting which was chaired by the CGPDTM.

Responses/suggestions "as received" from stakeholders were published in IPO website before the meeting date i.e. on 2nd April 2018 along with the Gist of Stakeholders' Comments in tabulated form, so that the comments of stakeholders are available to all, which would be helpful in facilitating discussions during the meeting.

At the outset, the Chair clarified that the scheduled meeting was to know the views of stakeholders on how to streamline the process of reporting regarding provisions of Working of Patents within the existing legislative frame work. It was clarified that the amendment of Patents Act is not under consideration. However, amendment to rules or Form 27 by way of addition/deletion/modification are to be discussed in the meeting and to be finalized after wider consensus in future.

Majority of Stakeholders presented their views in the meeting regarding provisions for Working of Patents under section 146 of the Patents Act read with rule 131 of Patent Rules, Form 27 and penal provisions under section 122.

Gist of major issues raised /suggestions made in respect of Working of Patents during the meeting are as follows:

1. Section 146 read with Rule 131:

i. Majority of stakeholders stated that :

Section 146(1) gives discretionary powers to Controller to call for any information related to patent in force and, such periodical statements as required, through a notice. Therefore, the controller, rather than calling all information through Form 27, shall use discretion under section 146 (1) to call only requisite information related to the patent.

Section 146(2) puts an obligation on patentee/licensee to furnish information, as may be prescribed. Therefore, the prescribed form i.e. Form 27 should be simple and easy so that all patentees/licensees can fulfill the said obligation. Detailed suggestions on Form 27 are separately listed below.

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The Controller shall use discretion given under section 146 (1) and 146 (2) so as to ensure that confidential information regarding patentee/licensee is not put in public domain unless required /specified by the statutory authority. These suggestions may be suitably incorporated and Rule 131 may be amended accordingly.

- ii. However, some stakeholders expressed that all relevant information should be sought from patentee/ licensee and put in public domain, as envisaged by Section 146 .

2. Form 27:

There were differences of opinion among the stakeholders in this regard. Some wanted abolishment of Form 27 stating that no other country has such provision of specific form like our Form 27. However, majority of stakeholders wanted that the current Form 27 should be amended in respect of the scope of details sought from the patentee/licensee against different paras of Form 27.

- i. **Some stakeholders wanted that the requirements should be made stricter in order to have full information in Form 27.**

Stakeholders observed that the crucial information that is expected in Form 27 is skipped by many stakeholders due to rather vague structure of Form 27 which is insufficient to ensure that the patentees and licensees make a full and complete disclosure of the patent working information. Form 27 suffers from considerable ambiguity and omits to ask patentees for a number of important particulars that are necessary for an effective assessment of the commercial working of patented inventions. Due to these defects, Form 27 facilitates strategic non-disclosure of complete working information by patentees which is grossly incomplete, incomprehensible or inaccurate.

Further, it was stated that para 3 of form 27 merely asks patentees and licencees to "give whatever details are available", without mandating such disclosure in stronger terms, given that, it is a statutory mandate under section 146 of the Patents Act to disclose the full extent of commercial working of the patent. Owing to this wording, patentees and licensees have strategically provided rather vague and non-specific information that makes it impossible to determine the extent of working.

- that Form 27 should ask for more information on drug related patents.
- that Form 27 must be revised and should begin by asking whether the patent has been licenced in the first place. If so, it must then ask for more details, such as the names of licensees and broad terms of licence. It was stated that not all aspects of a license can be hidden away under the guise of confidentiality, rather, particulars such as the name of licensee/s must compulsorily be disclosed under sections 67-69 of the Patents Act. Other details can be disclosed only to the extent necessary to demonstrate that the patent has been worked.

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- that confidential licensing terms can be redacted at the option of the Patent Office and the statutory framework does provide leeway for this. Instead, Form 27 ought to call for more particular information. In particular, the patentee ought to be asked to submit :a) estimated demand of the patented invention or product; b) extent to which the demand has been met (i.e. availability); and c) details of any special schemes or steps undertaken by the patentee to satisfy the demand.

ii. **Most other stakeholders stated that the requirements are inappropriate, unnecessary, impractical and burdensome to stakeholders and want the Form – 27 to be revised to make it a simple , clear, practical, useful, concise and unambiguous.**

Important amendments sought by stakeholders in this regard are as follows:

- Form 27 should be in the form of self-declaration as to whether the patent is being worked or not worked; the information required to be submitted for non-drug patents under Form 27 should be minimal—preferably none; the option that "patentee/licensee can mention the disclosed information could be partial information" shall be added in Form 27;
- confidential information should not be published ; discretion to publish the information submitted by the Patentee available to the Controller should be used;
- one Form 27 may suffice for multiple patents if the working statement for each such multiple patents is the same; provision should be available where working of a patent may depend on other patents/ products; process patents should be removed from the ambit of working requirement;
- obligation to file Form 27 should be either on patentee or licensee and not on both;
- reporting frequency of Form 27 should be every three years;
- IPC classification should be used to analyse the information provided across all technologies;
- Rules/Guidelines on what information should be made available to the public for submitting Form 27;
- the revised Form 27 should have two sections viz., (i) one for first time filing (for patents granted within the last three years) and (ii) another section for those cases where the working statement had already been filed in the previous year and being continued).
- "the reasons for not working", " country-wise details of importation", "requirement of quantum and value of the patented product", "details of licenses and sub-licenses" and "statement as to whether public requirement are met" should either be removed from Form 27 or simplified in such a way to reduce the burden on stakeholders and remove uncertainty, impracticability and vagueness of the information asked for.

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- online Form 27 should be rectified in line with the physical Form and the requirement should be same in both the versions and, hence, the drop list options and selection options on online Form 27 should be relooked.

3. Section 122:

- i. Some stakeholders stated that the provisions regarding penalty was appropriate and that the Patent Office should set up an internal committee which would annually review whether the statement of working has been filed and take action on failure to comply with the requirement under Section 146. Further, Patent Office may also consider taking cognizance of failure to file Form-27 on the basis of any complaint by any person who bonafide believes that Form 27 has not been filed.
- ii. Some stakeholders demanded that the current penal provisions as given in Section 122 (1)(b) and Section 122 (2) must be abolished as it is too harsh.
- iii. Some stakeholders suggested various other alternatives to the provision in section 122, such as, revocation of patent can be prescribed instead of imprisonment in case of false declaration, non-compliance of the working requirement is a ground for a compulsory license which should be a sufficient deterrent to the patentee, provision should be made for delayed submission of Form 27 by paying extra fee and Form-4 may be modified to include provision for late submission of Form-27 . if patentee fails or erroneously submits any incorrect information he should be able to get it rectified by filing the Petition under Rule 137.

After submission by all stakeholders , since it was observed that the majority of stakeholders want the Form 27 to be amended, the Chair called upon the stakeholders to submit the draft of revised version of Form 27 incorporating the amendments/changes, as they want in the revised Form 27.

The meeting ended with the vote of thanks.

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Annexure-3

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Proposed Timelines for effecting changes in the provisions regarding working of patents in the Patents Rules

1. Stakeholder consultation meeting was scheduled to be held on 21-3-2018 and stakeholders were requested to submit their comments up to 16-03-2018 on the provisions for working of patents under Section 146 of the Patents Act 1970 read with Rule 131 of Patent Rules 2003 including Form 27, and penal provisions provided in Section 122. Consequent to this, requests from various stakeholder/ attorney associations were received for extending the last date for submission of comments stating that several members from different countries are desirous to submit comments in this regard. In view of this and also to ensure wider stakeholder consultation, the last date for submission of comments was extended till 23rd March 2018 and, accordingly, stakeholder consultation meeting was held on 6th April 2018 at Intellectual Property Office, New Delhi.
2. As per Order dated 15/03/2018 of the Hon'ble Delhi High Court on WPC NO. 5590 of 15, the Respondent No.1 (Government of India) is required to file the affidavit regarding the timelines within which consultation would be completed, suggestions received examined and such amendments as may be deemed necessary would be effected under the Patents Act 1970.
3. Accordingly, the following sequential timelines to complete all the actions to be taken by the office of CGPDTM/Ministry related to this matter are submitted.

Sl. No.	Action by the Office of CGPDTM/DIPP	Likely time required
1	Stakeholders' suggestions received	Before 23-3-2018
2	Stakeholders' suggestions/ comments published in the IPO website prior to the Meeting	02-04-2018
3	Stakeholder consultation meeting held at Delhi	06-04-2018
4	Receiving further suggestions and study of international practices regarding working of patents information.	1 month
5	Preparation of Draft of Amendments to the existing Rule 131 of Patent rule /Form 27 by CGPDTM to the Ministry	1 month
6	Approval by Competent Authority to the draft amendment to Rules/Form 27	1 month
7	Gazette Notification of Draft amendment to Rules/Form 27	2 months
8	Receiving comments/suggestions from Stakeholders and consultation meeting on Draft amendment Rules/Form 27	

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	on Draft amendment Rules/Form 27	
9	Final Draft of the amended Rules/Form 27 to be submitted to competent Authority	1 Month
10	Vetting of the amended Rules/Form 27 by Law Ministry and inter-ministerial consultation	2 Months
11	Competent Authority approval and Gazette notification of a mended Rules/Form 27	1 month
12	Unforeseen delay , if any	2 months

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