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The Registrar
The High Court at Calcutta
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Subject: Comments on the Draft Intellectual Property Rights Division Rules of the High Court at Calcutta.

This submission presents comments on the “Draft Intellectual Property Rights Division Rules of the High Court at Calcutta, (“Draft Rules”) released by the High Court at Calcutta.

The submission is divided into three parts- General Comments, Substantive Comments and Clarificatory/ Procedural Comments on the Draft Rules.

This submission is made by: Praharsh Gour, Pranav Aggarwal, Swaraj Paul Barooah, and Malobika Sen.¹ Views expressed here represent those of the authors’ alone. We are thankful for the opportunity to put forth our views.

This submission was made on January 5th, 2024 as per deadline prescribed for comments i.e. seventeen days from the release of the Draft Rules (December 19, 2023).

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TABLE OF CONTENTS

PART 1: GENERAL COMMENTS	2
PART 2: SUBSTANTIVE COMMENTS	2
A. REMOVAL OF SPECIFIC TRANSLATION TOOLS:.....	2
B. CRITERIA FOR INDEPENDENT EXPERTS:.....	3
C. RIGHT TO AUDIENCE:	4
D. INCLUSION OF PROVISIONS FOR LEGAL RESEARCHER:.....	4
E. ACCESSIBILITY AND REASONABLE ACCOMMODATIONS:.....	5
F. LACK OF MENTION OF TECHNICAL PRIMER:	5
PART 3: CLARIFICATORY/ PROCEDURAL COMMENTS	6
A. CLARIFICATION REGARDING ADDITIONAL SUBJECT MATTER FOR PROCEEDINGS.....	6
B. CLARITY OVER CRIMINAL PROCEEDINGS:	6
C. DISTINCTION OF WRIT PETITIONS:	7
D. DEFINITION OF “APPEALS”:.....	7
E. QUALIFICATION OF JUDGES:.....	8
F. INTRODUCE SPECIFIC OR MAXIMUM TIMELINES:.....	9
G. INTRODUCTION OF RELEVANT PROVISO FOR ADVANCE SERVICE:.....	9

Part 1: General Comments

The Draft Intellectual Property Rights Division Rules of the High Court at Calcutta (“Calcutta Rules” or “Proposed Rules”) were published on [December 19, 2023] with an open call for comments on the Proposed Rules within the next 17 days, i.e., Jan 05, 2024. While the call for comments on the draft rules is appreciated, it is noted that only 17 days were given to the stakeholders to submit their responses. This leaves interested stakeholders with very little time to engage with this process. In order to realize the principles of Accountability, Transparency, and Openness, it is vital for a reasonable chance to be given to the public to Deliberate, Respond and Interact with the legislative process for real inclusion and public participation. However, the same was not provided in the instant case.

Recommendation: It is recommended that an extension of 2-4 weeks be given to increase the ability for more stakeholders to participate in this democratic process, and further enrich the outcome of the same.

Part 2: Substantive Comments

A. Removal of Specific Translation Tools:

Rule 26 of the proposed rules provides an option for translation through online translation software like Google Translate or Bing Translate. However, keeping in mind the complexity of legal documents and the ill-suitedness of general translation softwares to accurately translate them, sole reliance of software would be very problematic. To translate legal documents, a certain standard like ISO 20771:2020 or ISO 17100:2015 has been established for individual translators. Such similar standards have to be identified for softwares as well to ensure appropriate translations. If such a standard is not found, or ideally, even if one is found, an approval by a certified translator should be seen as necessary to ensure the accuracy of such translations. Finally, the rules should avoid suggesting specific software like Google or Bing because firstly, it is not known on what criteria they have just mentioned them; and secondly, such a suggestion would lead to the endorsement of the softwares owned by very large private corporations that make no accountability assurances regarding their translation services. The court should avoid such unnecessary endorsements.

Recommendation:

The Rules should not consider online software as sufficient for translation of legal documents to be used for court purposes. If they must, then at least some basic well established criteria should be specified, to admit documents translated through such online softwares. Such software generated translations should be then subjected to approval by a certified translator. Additionally, the name of any specific software should not be suggested or endorsed in the Rules for translation and only the criterion should be clearly laid down and adhered to.

B. Criteria for Independent Experts:

Under Rule 22, the Proposed Calcutta Rules provide for ‘Independent Experts’. This is a well appreciated move especially considering that many IP matters are highly technical in nature. Regarding this, Rule 22 states that experts can be appointed from a list of willing individuals furnished by the parties or a list of experts that would be maintained by the department to administer and manage proceedings before the proposed Intellectual Property Rights Division (IPRD) and Intellectual Property Rights Appellate Division (IPRAD). However, the proposed Rules do not state anything about the criteria for selecting experts for these lists.

Recommendation:

Clarity is required regarding the mode and criteria for adding an expert's name to the two lists of experts. It is further suggested that there should be a demarcation of the type of expert that is being brought on under different heads which indicatively can be scientific, economic, legal, or technical.

C. Right to Audience:

The proposed Rules do not include any provision to accommodate a request for the audience by any party who may have knowledge about the subject matter of the dispute. The proposed Rules only make accommodations to appoint an independent expert. However, it is suggested that the court should also accommodate requests to hear any other person like a patent agent, academician, etc. possessing the necessary knowledge about the subject matter of the dispute. Such a provision is made within the Delhi High Court IPD Rules under Rule 34.

Recommendation:

It is suggested that the proposed Rules be amended to include a provision granting patent agents and academicians a right of audience before the court. These parties shall be the ones who would know the technical subject matter of the dispute and the right shall be subjected to the satisfaction of the court first.

D. Inclusion of Provisions for Legal Researcher:

The proposed Calcutta Rules do not mention any provision for any Researcher or clerks for the Judges of the IPRD and IPRAD. Appointment of such staff equipped with handling technical and legal issues will surely serve as an asset for the division and will enable efficient functioning of the IPRD and IPRAD. Aid and assistance from these legal researchers/ law clerks will help the court in not just speedy disposal of cases but will also promote well-informed decisions for every case and not just those cases wherein independent experts will be appointed. Provision of appointing such staff members possessing technical and legal knowledge has been made under Rule 32 of the Delhi High Court IPD Rules and is also a practice followed by other courts abroad² (for example see the sections in the linked report about the Court of Appeals for the Federal Circuit, USA and the IP High Court, Japan).

² WIPO, An International Guide to Patent Case Management for Judges <<https://www.wipo.int/patent-judicial-guide/en>>

Recommendation:

It is recommended that the proposed Rules make provision for the appointment of Legal Researchers/ Clerks with relevant qualifications for the aid and assistance of the judges of the IPRD and IPRAD. Considering that such appointments are practiced across different national and international courts, the proposed Rules should also formalize the same by prescribing appropriate budget, selection criteria, and other necessary formalities.

E. Accessibility and Reasonable Accommodations:

The proposed Rules presently do not take into account accessibility issues faced by persons with disabilities while accessing court documents. Though the Calcutta High Court E-Filing Rules³, prescribed for converting a document to the Optical Character Recognition (OCR) searchable PDF document, the present Rules do not make any reference to these Rules nor re-assert the requirement to make filings in an OCR PDF Format. Additionally, there is no provision to ensure reasonable accommodation of the request of a person with disability, appearing before the IPRD. Such provisions have been made under the Delhi High Court Rules under Rule 36.

Recommendation:

It is highly recommended that the proposed Rules include provisions on accessibility and reasonable accommodations. The proposed Rules should specify the relevant format to which documents should be converted, aligning with its E-Filing Rules. Furthermore, the proposed Rules should include a mechanism empowering the court to issue directions to provide reasonable accommodation to a person with a disability recognized under the Rights of Persons with Disabilities Act, 2016.

F. Lack of mention of Technical Primer:

The proposed Calcutta Rules do not make a provision for a patent technical primer giving an introduction to the basic science involved in the suit patent. The High Court Of Delhi Rules

³ High Court At Calcutta Appellate Side <<https://www.calcuttahighcourt.gov.in/Notice-Files/general-notice/5351>>

Governing Patent Suits, 2022 includes a mechanism to file such a primer for the aid of the judges, on the direction of the court.

Recommendation:

It is recommended that the proposed Rules be amended to include a provision empowering the Court to direct a party to file a technical primer in patent cases. Inclusion of the requirement of such a primer could be useful for the purpose of the adjudication since it shall give an introduction to the basic science and/or technology covering the patent(s) preferably in simplified/non-technical language.

Part 3: Clarificatory/ Procedural Comments

A. Clarification regarding Additional Subject Matter for Proceedings.

Under Rule 2(k) of the proposed Calcutta Rules, the subject matters of the proceedings are provided. While the proposed Rule gives an inclusive definition, it has not included disputes arising out of enforcement by the customs authorities under Section 11 of the Customs Act against the import and export of goods.

Recommendation:

For clarity, the proposed Rules can specifically make a reference to the challenges against the orders passed under Section 11 of the Customs Act prohibiting importation or exportation of goods. Such a specific reference has been made in Rule 2(7)(vii) of the Madras High Court IPD Rules as well. However, no such provision has been made in the Delhi High Court IPD Rules.

B. Clarity over Criminal Proceedings:

The proposed Calcutta Rules are silent on its implementation on criminal proceedings. Penal remedies are prescribed within the Trademarks Act (Section 103- 108) and Copyright Act (63-70). However, the proposed Rules are not clear whether proceedings regarding penal remedies will fall under their ambit thus allowing ambiguity. Such a clarification has been given in the Madras High Court which under Rule 2(7) explanation (iii) expressly excludes criminal proceedings arising out of the penal provisions under the different Acts. However, such direct reference has not been made in the Delhi High Court IPD Rules.

Recommendation:

It is recommended that a clear rule on whether criminal proceedings are excluded or included within the ambit of the proposed Rules should be introduced.

C. Distinction of Writ Petitions:

Rule 11 and Schedule 1 of the proposed Calcutta Rules mention ‘writ petition’. A writ petition under Article 226 of the Constitution can be of both civil or criminal nature. In intellectual property cases, as mentioned above, criminal liabilities may also be invoked under the writ jurisdiction. However, the proposed Rules do not specify whether both criminal and civil writ petitions are included herein. Under Rule 2(o)(ii) of the Delhi IPD Rules, the nature of the writ petition has been clearly provided as ‘civil’.

Recommendation:

It is suggested that the proposed Rules clarify and specify the nature of the writ petitions mentioned herein for unambiguous adjudication of the matters.

D. Definition of “Appeals”:

Rule 2(d) of the proposed Rules defines appeals as “unless the context otherwise requires, it shall mean an appeal filed before the High Court under the Acts specified in Rule 2(a) above and appeals arising out of proceedings instituted under Section 2(1)(c)(xvii) of the Commercial Courts Act, 2015”.

There are two potential issues with this definition:-

i) The definition is extremely broad and does not clearly specify the types of appeals that can be filed before the High Court under the different IP Acts. Later under Rules 10 (Appeals against the orders and judgements of courts other than a High Court) and 13 (Appeals against the orders of the IPO) the draft Rules provide some clarity on the type of appeal it concerns with. However, this clarification is required for the definition clause for appeals as well.

Recommendation:

For better understanding and clarity regarding the scope of the definition, the proposed definition can be substituted by one that states the relevant provisions for appeal under different Acts i.e. Section 91 of The Trade Marks Act, Section 72 of The Copyright Act, Section 117A of The Patents Act, Section 31 of The Geographical Indications Act, Section 56 of The Protection of Plant Varieties and Farmers' Rights Act, Section 42 of the Semiconductor and Integrated Circuits Act, Section 62 of the Information Technology Act, Sections 36 of the Designs Act, Section 130 of the Customs Act. This approach of specifying the provisions in the definition clause for “appeal” is followed by the Delhi High Court IPD Rules and the Madras High Court IPD Rules in Rule 2(d) and Rule 2(4) respectively.

ii) The present proposed definition of appeals includes proceedings “instituted under Section 2(1)(c)(xvii) of the Commercial Courts Act, 2015”. However, Section 2(1)(c)(xvii) of the Commercial Courts Act, 2015 is a definition clause and no proceedings are per se instituted under this section.

Recommendation:

It is recommended that the Rules should instead specify the relevant provision under the Commercial Courts Act for Appeals (Section 13), as done in the Madras High Court IPD Rules.

E. Qualification of Judges:

Under Rule 4 of the proposed Calcutta Rules, the judges for the IPD “shall preferably have experience in dealing with intellectual property subject matter”. Although such a first of its kind rule is surely welcome, more clarity can be brought as to what ‘experience in dealing with’ includes. Presumably, it refers to whether the judge has dealt with IP cases in the past. Would this take into account the previous practice, on IP laws, of the concerned judge (for those called to the bench, from the bar). Or will it also consider the academic qualifications of the concerned judge? Some clarity on this point will be helpful in understanding how the appointment of judges to the specialized IP benches takes place.

Recommendation:

An indicative criteria for determining the experience of a judge before their appointment to the IPD should be specified by the Rules.

F. Introduce Specific or Maximum Timelines:

Under Rules 7 to 11 of the proposed Rules, a “shall endeavour” clause has been introduced regarding expeditious disposal of proceedings. Though a noble inclusion, these clauses neither serve any concrete purpose nor per se ensure expeditious disposal of proceedings.

Recommendation:

Instead of the “shall endeavour” clause, specific or maximum timelines for disposal of proceedings could be stated in the Rules.

G. Introduction of Relevant Proviso for Advance Service:

Rule 16 of the proposed Rules requires the advance copy of the pleadings to be given directly or through email and post to the other parties. While it is appreciated that the proposed Rules are taking into account alternative methods of service, there may be cases wherein the email id of the relevant parties might not be available.

Recommendation:

For clarity, the aforesaid Rule should have a proviso stating that the advance copies of the pleadings can be serviced only through post in case the email ID of the relevant party is not available.