

Patent opposition in India: recent trends

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The recent influx of patent filings in India may be attributed to the revolution in the Indian Patent System on 1st January 2005, when India signed the Trade Related Aspects Intellectual Property Rights (TRIPS) agreement, wherein Section 25 of The Act was amended in light of the TRIPS agreement to introduce an "integrated" system of both pre-grant and post-grant opposition in India.

Under pre-grant opposition any person can represent for opposition, in writing, to the Patent Office against the grant of a patent after the application for a patent has been published but before a patent has been granted. The pre-grant opposition procedure acts as a protective shield to check the validity of patent applications before a patent is granted on them. Additionally, pre-grant opposition acts as a business strategy, whereby competitors exploit it as an opportunity for opposing unjustified protective rights.

Post-grant opposition may be brought at any time after the grant of patent but before the expiry of a period of one year from the date of publication of grant of patent. Any person interested may give notice of opposition to the Patent office. This type of opposition is similar to the opposition proceedings under the European Patent Office (EPO) as the opposition is made after grant.

The grounds for both pre and post-grant opposition are identical and there is nothing to preclude a pre-grant opponent from subsequently filing a post-grant opposition. However, despite the similarities there are also several procedural differences between the two types of opposition.

The primary difference between pre-grant and post-grant opposition is that whilst the pre-grant proceedings may be initiated by "any person", only a "person interested" can institute a post-grant opposition. The *Indian Patents Act* defines a "person interested" as including a person engaged in, or in promoting, research in the same

field as that to which the invention relates.

Another striking difference between the pre-grant and post-grant opposition is that infringement proceedings cannot be initiated during pre-grant opposition as the patent is still in the application stage, whereas in case of post-grant opposition, infringement proceedings may be instituted.

Moreover, the Indian Patents Act does not explicitly allow the opponent to be heard in a pre-grant opposition. The opponent has to make a request for hearing and the rules do not detail how a hearing is to be conducted. The opponent's right to be heard depends solely upon the discretion of the Controller, who decides the same based upon the merit of the opposition. Additionally, the rules are also not clear whether the opponent will be heard in the presence of the applicant. In contrast, the opponent in a post-grant opposition can proceed with the case irrespective of the merit of the notice of opposition.

Furthermore, as per the stand taken by the Intellectual Property Appellate Board (IPAB) on numerous occasions, there is no remedy against an order of the Controller in a pre-grant opposition except to file a writ petition under the Indian Constitution.

However, a recent order by the Madras High Court provided some clarity with regards to the existing ambiguities in the pre-grant opposition proceedings. Rediff.com India Ltd. had filed a Pre Grant Opposition against grant of patent to Yahoo! Inc. for a patent application pertaining to a computer network search system, which was published on 20 April 2004 in Patents Journal No.16 of 2007. The Controller accepted the representation and refused to grant patent by holding that the invention of the applicant does not pass the novelty and patentability test. Challenging said order, an appeal was preferred by Yahoo before IPAB.

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However, said appeal was refused to be entertained by the IPAB on the ground that no appeal under Section 117-A would lie against an order under Section 25(1) of the Patents Act, 1970. Challenging said order of refusal to entertain the appeal filed by Yahoo, a writ petition was filed before the High Court of Madras.

Consequently, setting aside the order of the IPAB, Madras High Court has held that an appeal under section 25 of the Patent Act lies under Section 117 A and that while hearing such an appeal the party which had filed a Pre-Grant Opposition should be given a hearing before arriving at a decision on the Opposition, thereby providing clarities with regards to above-mentioned ambiguities.

As far as pharmaceutical industry is concerned, a broad analysis of some basic trends in the strategies of the generic pharmaceutical industry in filing such oppositions illustrates that the highest number of oppositions amongst generic companies have been filed by Cipla, followed by Ranbaxy. Moving further down the ladder, next comes Torrents, followed by NATCO. Other generic companies include

Glenmark, Matrix, Ajanta, Hetero and Wockhardt.

Therefore, as may be seen, the two-stage patent opposition process has particularly affected the pharmaceutical industry, as the patent applicants are now vulnerable to multiple pre-grant oppositions filed by competitors, or even by a single competitor, since there is nothing to stop a party which has filed a pre-grant opposition from subsequently filing an opposition once the patent has been granted. As a result, it is not uncommon that continuous and repeated opposition proceedings have been launched against the same patent application. The resulting delays are a major cause of concern for the patent applicant, as the patent term begins to run from the date of filing of the application. This wave of opposition proceedings is also adding to the backlog of patent prosecutions at the Indian Patent Office. Given that revocation and litigation are also available options to challenge a patent, the delay in grant may be regarded as bias against the patentee.



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