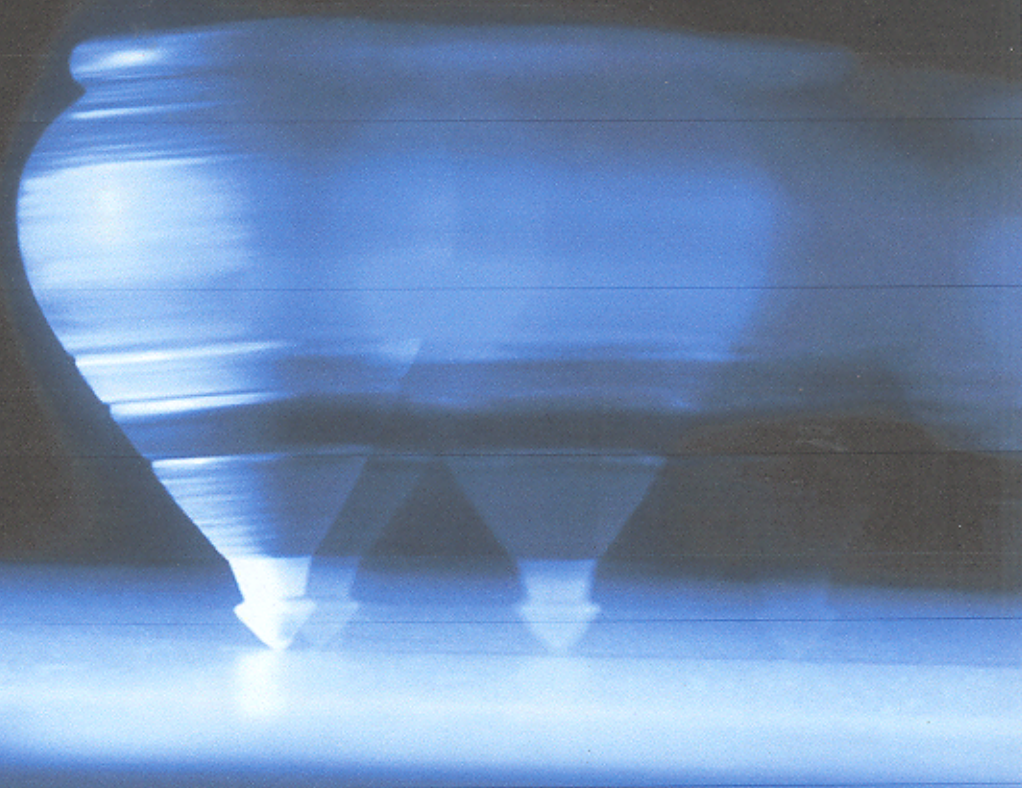


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JULY / AUGUST 2011



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DECISION IN PRE-GRANT OPPOSITION PROCEEDINGS: IS IT APPEALABLE?



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After much wait and speculation, the Indian Patent Office recently released the *Manual of Patent Practice and Procedure*. There were expectations that the procedures in the manual would mirror contemporary developments, particularly those stemming from judicial pronouncements on patent procedural law. While all hopes have not been met, the far-reaching decision of the High Court of Delhi in *UCB Farchim SA v Cipla Ltd and Ors* has been adopted. This decision concerns the maintainability of appeals before the Intellectual Property Appellate Board (IPAB) from orders passed by the controller of patents in pre-grant opposition proceedings.

One peculiar feature of Indian patent law is the provision for pre-grant oppositions. A pre-grant opposition can be filed by 'any person' as opposed to a post-grant opposition, which can only be filed by 'any person interested' (which includes a person engaged in, or promoting, research in the same field as that to which the invention relates). Further, a pre-grant opposition is considered by the controller, whereas for post-grant oppositions, the controller must constitute an opposition board to give its recommendation after examination of the notice of opposition and other documents. If desired, the order of the controller in a post-grant opposition can be appealed in the IPAB; however, curiously, there is no express provision for an appeal against a pre-grant opposition order.

In the absence of a prescribed recourse under the patent statute, in 2010, six different parties took to challenging the controller's order in pre-grant oppositions by filing writ petitions under Article 226 of the Constitution of India in the High Court of Delhi. Thereafter, the maintainability of these writ petitions came into question. Since a common question of law was raised in all six cases, the court passed a composite order in the case at hand. Observing that the consequences of rejection of a pre-grant opposition varied depending on the interest of the parties involved, it categorised its decision thus:

- Rejection of pre-grant opposition filed by a person interested, and
- Rejection of pre-grant opposition filed by a third party (any person).

In the event that a pre-grant opposition is rejected and the patent granted, a person interested has the remedy of either filing a post-grant opposition or an application for revocation of the patent before the IPAB. Even if the post-grant opposition is rejected, there lies a further remedy of filing an appeal before the IPAB. The IPAB's decision, in turn, is open for judicial review by the High Court. Recognising that, as a High Court, it had the power under Article 226 of the constitution to interfere with the orders of any quasi-judicial statutory authority, the court declined to exercise such jurisdiction in cases where an efficacious alternative remedy was already available to an aggrieved person.

"IN THE EVENT THAT A PRE-GRANT OPPOSITION IS REJECTED AND THE PATENT GRANTED, A PERSON INTERESTED HAS THE REMEDY OF EITHER FILING A POST-GRANT OPPOSITION OR AN APPLICATION FOR REVOCATION OF THE PATENT BEFORE THE IPAB."

In cases of pre-grant rejection involving a third party, in the court's view, the legislature appeared to have consciously denied a third party the additional statutory remedy of a post-grant opposition. However, the court went on to state that where no other remedy is available, if the facts and circumstances of a case so demand, the constitution permits recourse to a writ petition under Article 226 in the interest of justice.

The court also considered the situation where a pre-grant opposition was accepted and grant of patent refused. It ruled that such a decision was in effect a decision of refusal of a patent and should be understood as an order of the controller under Section 15 (which empowers the controller to refuse a patent application on certain grounds) of the statute, which in any event is appealable before the IPAB.

The *UCB* judgment has settled the clouds of uncertainty that enveloped decisions arising out of pre-grant opposition proceedings. Patent law in India is evolving gradually and witnessing commendable change, particularly *vis-à-vis* decisions that clarify existing statutory provisions. The initiative of the Patent Office in adopting the *UCB* decision in the *Manual of Patent Practice and Procedure* deserves applause and bolsters efforts to set up a utopian regime for patent protection and lawful exploitation. ■

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