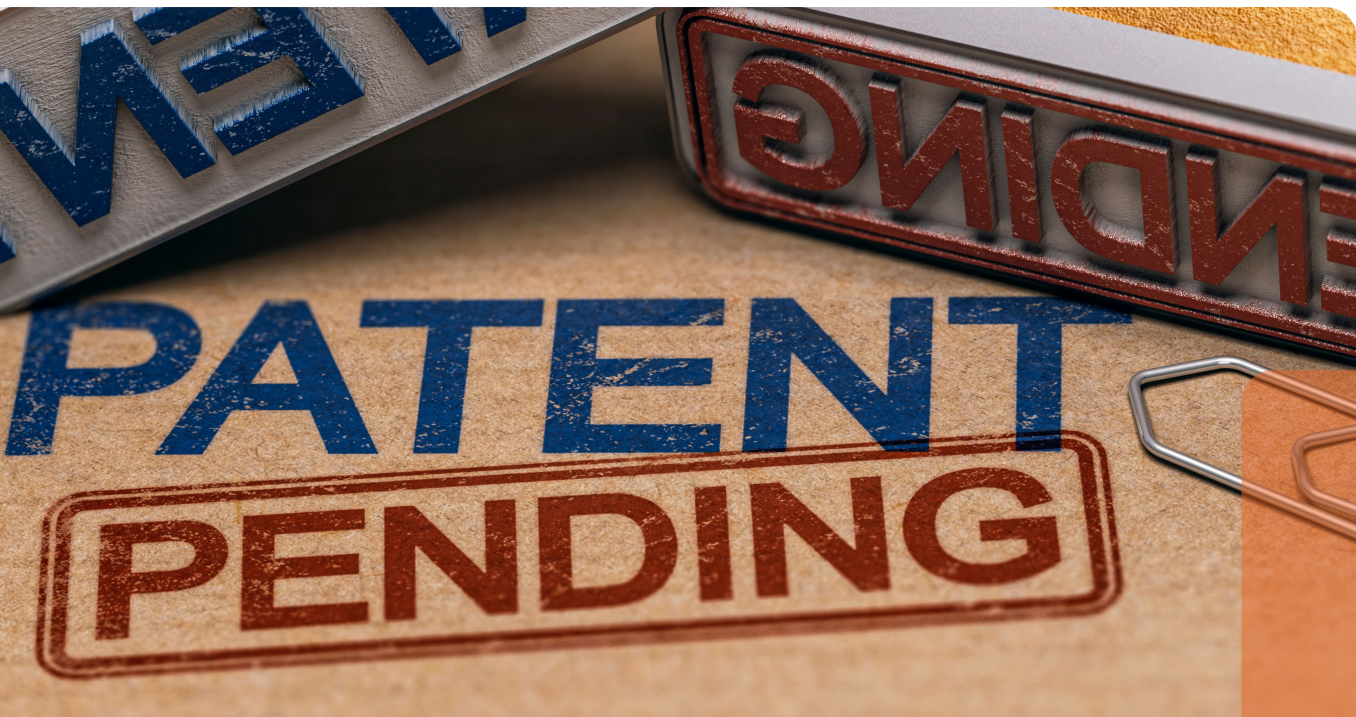


**International
Comparative
Legal Guides**



Patents

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Contributing Editor:
Katharine Stephens
Bird & Bird LLP

glg Global Legal Group

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1 Patent Enforcement

1.1 Before what tribunals can a patent be enforced against an infringer? Is there a choice between tribunals and what would influence a claimant's choice?

A patent can be enforced against an infringer only in Civil Courts and not below the Court of a District Judge. For Chennai, Delhi, Kolkata and Mumbai, a patentee can file a suit for infringement even in the High Court if the claimant chooses to value the suit greater than the limit prescribed by each High Court. For example, a suit for infringement of a patent would be filed only before the Delhi High Court if the value of the suit exceeds INR 2 Crores (approximately USD 0.25 million). However, as the value of the suit increases, so does the value of the Court fee, and this could influence the claimant's choice between a District and High Court in aforesaid jurisdictions.

Although a claimant can choose between a District and High Court, such a choice becomes redundant once the defendant files a counterclaim seeking revocation of the patent. In such a scenario, the suit is heard by the High Court regardless of where the claimant chose to file it first. For instance, if the claimant files a suit for infringement before a District Judge, the case would be transferred to the concerned High Court if the defendant files a counterclaim seeking revocation of the subject patent.

A claimant may file a suit for an infringement at (a) the place where the cause of action has arisen, or (b) the residence or place of business where the defendant is located. Thus, apart from choosing between a District and High Court, it is important to determine the Court(s) that would have territorial jurisdiction over the case. Multiple territorial jurisdictions may arise where the causes of action, *viz.* acts of infringement, have occurred in several places. The Court at each place has jurisdiction to try the suit.

1.2 Can the parties be required to undertake mediation before commencing court proceedings? Is mediation or arbitration a commonly used alternative to court proceedings?

Parties may undertake mediation, a commonly used alternative, before commencing court proceedings. Under Section 12-A of the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts (Amendment) Act, 2018, pre-suit mediation is mandatory if there is no urgent interim relief sought by the plaintiff.

Arbitration is also a commonly used alternative when the parties have agreed to arbitration under an agreement between them.

1.3 Who is permitted to represent parties to a patent dispute in court?

An Advocate under the Advocates Act, 1961, the plaintiff in person, or a recognised agent such as a person holding power-of-attorney for a party, are permitted to represent parties to a patent dispute in court.

1.4 What has to be done to commence proceedings, what court fees have to be paid and how long does it generally take for proceedings to reach trial from commencement?

After deciding the appropriate court having territorial jurisdiction over the case, the suit with the requisite court fee is presented along with an application seeking interim relief(s), such as an *ex parte* injunction. All documents must be filed (either original or photocopies) along with the suit upon which the claimant relies and which are in power, possession, control, and custody of the claimant. However, in case of urgent filing, the claimant may seek leave to rely on additional documents, which must be filed within 30 days of filing the suit.

The Court fee depends on the value of the suit and may range from 1–10% of the value depending on the jurisdiction. The value of the suit includes the amount of damages, the subject matter value, and value of other reliefs claimed.

Ideally, proceedings should reach trial within one to two years, especially after the enactment of the Commercial Courts Act, 2015. However, practically, a claimant should expect the commencement of the trial between two to three years following the initiation of a suit.

1.5 Can a party be compelled to disclose relevant documents or materials to its adversary either before or after commencing proceedings, and if so, how?

Relevant documents or materials are disclosed to the adversary only after the proceedings have commenced. However, under recent amendments to the Delhi High Court Rules, all documents/information considered confidential by the Court shall be permitted to be filed in a sealed envelope kept in the safe custody of the Registrar General. These documents can only be shown to three Advocates (excluding in-house counsels) and two external experts nominated by the opposite party.

1.6 What are the steps each party must take pre-trial? Is any technical evidence produced, and if so, how?

Pre-trial procedures include the collection of evidence of infringement to support the claims. The evidence of infringement may be collected by the claimant or an investigator. An affidavit of the person who has conducted the investigation and collected the evidence must be filed with such evidence to *prima facie* establish the infringement. This investigator may be called in as a witness later in the trial. Technical evidence in the form of an affidavit with documentary evidence and other evidence may also be produced to establish how the infringing product reads in terms of the claims of the patent.

1.7 How are arguments and evidence presented at the trial? Can a party change its pleaded arguments before and/or at trial?

The arguments, both for any interim relief or final relief, are orally addressed to the Court by each party. Normally, the plaintiff begins the arguments followed by the defendant. Subsequently, the plaintiff may argue in rebuttal. The parties may also submit written arguments, and a copy of each such written argument must be furnished to the opposite party.

The trial may commence either before the Court or a commission formed by the Court to examine witnesses. Generally, examination of witnesses before a commission is faster compared to examinations before the Court, although there is an extra cost burden for such commissions. The examination in chief of a witness is by way of an affidavit, which is further cross-examined by the opposite party. Such witnesses may also be permitted re-examination. The documents and other materials relied upon by such witnesses are taken on record if found to be relevant and admissible. Any objection towards admissibility and mode of proof of any evidence is noted during the trial and decided by the Court during the final arguments.

The Court may also appoint technical/scientific advisors to assist the Court in addition to the expert witnesses summoned by the parties. As regards expert witnesses, Delhi High Court has even permitted “hot-tubbing”, in that the experts of both sides are, *inter alia*, examined together by the Court.

1.8 How long does the trial generally last and how long is it before a judgment is made available?

The length of the trial depends on various factors, such as the number of witnesses of each party, whether the examination is before a commission or a Court, the time taken in cross-examination of each witness, etc. Due to these factors, a trial may take three to five years, which may be reduced substantially if the examination is carried out before a commission.

After the trial and final arguments, Courts fix a date for the pronouncement of a judgment. It may, however, take a few days to obtain a certified copy of the judgment and a few weeks or a month before a decree sheet is drawn.

1.9 Is there any alternative shorter, flexible or streamlined procedure available? If so, what are the criteria for eligibility and what is the impact on procedure and overall timing to trial?

As already mentioned above, the trial may be expedited by choosing to examine the witnesses before a commission appointed by the Court. In this procedure, the Court appoints

another Advocate or a retired Judge as a commissioner before whom the witnesses would be examined and the entire evidence would be adduced. Since the Commissioners can fix hearings at the convenience of the parties and the witnesses, there are fewer adjournments and the examination may even take place continuously, reducing the duration of the entire trial.

For expert witnesses, the Delhi High Court has permitted the technique of “hot-tubbing” by which expert witnesses give evidence simultaneously in each other’s presence and in front of the Judge, who puts the same question to each expert witness. This makes it possible to identify key issues of a dispute and possibly evolve a common resolution for all of them. Since the expert witnesses need not undergo lengthy procedures of examination and cross-examination separately, the duration of the trial can be reduced significantly.

Apart from the above, the identification of important witnesses and making them available promptly also reduces the duration of a trial.

1.10 Are judgments made available to the public? If not as a matter of course, can third parties request copies of the judgment?

Judgments are pronounced in an open court, as well as being published in leading journals. Third parties can request copies of the judgments.

1.11 Are courts obliged to follow precedents from previous similar cases as a matter of binding or persuasive authority? Are decisions of any other jurisdictions of persuasive authority?

The precedents from the Supreme Court on previous similar cases are a binding authority. What is binding is *ratio decidendi*, i.e., reasons for deciding the legal point, and *obiter dicta*, i.e., decisions on points not necessary to decide.

The precedents from High Courts are not binding but have persuasive authority. However, precedents from a High Court are treated as binding for the Courts subordinate to that High Court unless contrary to any precedent from the Supreme Court or another High Court. It is, however, necessary in every case that precedents are not distinguishable on facts.

Regarding foreign judgments, the same only have persuasive value.

1.12 Are there specialist judges or hearing officers, and if so, do they have a technical background?

No, there are no specialist judges or hearing officers in Court. However, in 2021, the Intellectual Property Division (IP Division) was created in the High Court of Delhi. The IP Division deals with all matters relating to IP rights including fresh and pending IP. These cases include appeals against the decisions of the Patent/Trademark/Copyright Offices, revocation/cancellation actions and applications for rectification of the patents/trademark registers.

1.13 What interest must a party have to bring (i) infringement, (ii) revocation, and (iii) declaratory proceedings?

A patentee or, if the patentee refuses, a registered exclusive licensee, or a compulsory licensee may bring an action against infringement.

A petition for revocation of a patent may be filed only by a “person interested” or the Central Government. A “person interested” includes a person engaged in or promoting research in the same field as that to which the invention relates.

Any person may establish a suit for a declaration of non-infringement. In case of groundless threats of infringement proceedings against any person, such a person can establish a suit for a declaration to the effect that such threats are unjustifiable.

1.14 If declarations are available, can they (i) address non-infringement, and/or (ii) claim coverage over a technical standard or hypothetical activity?

The declarations are available and address non-infringement.

Courts have even made declarations claiming coverage over a technical standard; however, such declarations have been made in a suit of infringement and not separately.

1.15 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of, but not all of, the infringing product or process?

Yes, a party can be liable for infringement as a secondary infringer or for the supply of a part of an infringing product or process if the predominant use of the same creates infringing goods.

1.16 Can a party be liable for infringement of a process patent by importing the product when the process is carried on outside the jurisdiction?

Yes, a party can be liable for infringement of a process patent by the importation of a product provided such product is obtained directly by that process even though the process is carried on outside the jurisdiction.

1.17 Does the scope of protection of a patent claim extend to non-literal equivalents (a) in the context of challenges to validity, and (b) in relation to infringement?

There are no clear precedents on the doctrine of equivalents. Having said that, the Delhi High Court has held in one case that if the infringing goods are made with the same object in view, which is attained by the patented article, then the minor variation does not mean that there is no piracy, and such person is guilty of infringement if he makes, what is in substance the equivalent of the patented article, some trifling and unessential variations can in this case then be ignored.

1.18 Can a defence of patent invalidity be raised, and if so, how? Are there restrictions on such a defence e.g. where there is a pending opposition? Are the issues of validity and infringement heard in the same proceedings or are they bifurcated?

A defence of patent invalidity can be raised in a suit for infringement by filing a counterclaim. Once a counterclaim is filed, the suit, if it is not already pending before the High Court, is transferred to the High Court and only the High Court can decide on the validity of the patent even where there is pending opposition or revocation petition between the same parties before any other forum. However, the Court may also take a position

to wait for the other forum (Patent Office) to decide the question of invalidity.

The issues of validity and infringement are heard in the same proceedings before the High Court if the validity of a patent is challenged in a counterclaim.

1.19 Is it a defence to infringement by equivalence that the equivalent would have lacked novelty or inventive step over the prior art at the priority date of the patent (the “Formstein defence”)?

There is no clear precedent on the “Formstein defence” in India.

1.20 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?

The other grounds for invalidity of a patent are:

- (a) The invention has been obtained wrongfully.
- (b) The invention is publicly known, or it has been publicly used in India before the priority date.
- (c) The invention is in accordance with a non-patentable subject matter.
- (d) The complete specification is not sufficiently described.
- (e) The applicant has not complied with the requirement of Section 8 or has provided materially false information.
- (f) The application was not filed within 12 months of filing the first application in a convention country.
- (g) The complete specification does not disclose or wrongly mention the source or geographical origin of biological material.
- (h) The invention is anticipated with regard to traditional knowledge of any community, anywhere in the world.

1.21 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?

No, infringement proceedings are not stayed pending resolution of validity. However, in certain situations, the Courts may take a position to direct the Patent Office to first decide the issue of validity or may club proceedings before different courts for the same patent, and wait to first decide on the validity of the patent by one of the Courts.

1.22 What other grounds of defence can be raised in addition to non-infringement or invalidity?

In a suit for infringement, Indian patent law does not provide any other ground of defence in addition to non-infringement and invalidity.

1.23 (a) Are preliminary injunctions available on (i) an *ex parte* basis, or (ii) an *inter partes* basis? In each case, what is the basis on which they are granted and is there a requirement for a bond? Is it possible to file protective letters with the court to protect against *ex parte* injunctions? (b) Are final injunctions available? (c) Is a public interest defence available to prevent the grant of injunctions where the infringed patent is for a life-saving drug or medical device?

Preliminary injunctions are available on both an *ex parte* and *inter partes* basis. The injunctions are granted on determination of which party has successfully established in its favour: (i) a *prima*

facie case; (ii) balance of convenience; and (iii) irreparable loss and injury.

It is possible to file protective letters (*caveats*) with the Court to protect against *ex parte* injunctions.

Furthermore, final injunctions are also available.

There have been differing decisions of various High Courts on public interest as a defence to prevent the granting of injunctions. However, the Supreme Court of India in *Colgate Palmolive (India) Ltd vs Hindustan Lever Ltd* held that: “[t]he decision whether or not to grant an interlocutory injunction has to be taken at a time when the existence of the legal right assailed by the plaintiff and its alleged violation are both contested and uncertain and remain uncertain till they are established at the trial on evidence... (v) [t]he issue is to be looked from the point of view as to whether on the refusal of the injunction, the plaintiff would suffer irreparable loss and injury keeping in view the strength of the parties case; (vi) [b]alance of convenience or inconvenience ought to be considered as an important requirement even if there is a serious question or prima facie case in support of the grant; (vii) [w]hether the grant or refusal of an injunction will adversely affect the interest of the general public which can or cannot be compensated otherwise.” (Emphasis added.)

1.24 Are damages or an account of profits assessed with the issues of infringement/validity or separately? On what basis are damages or an account of profits assessed? Are punitive/flagrancy damages available?

Yes, damages or an account of profits are assessed with the issues of infringement/validity. The basis of damages could be actual damages, a rendition of accounts, royalty rates, interest, and even punitive. Yes, punitive damages are available, although in rare cases where intentional and flagrant infringement is apparent.

1.25 How are orders of the court enforced (whether they be for an injunction, an award of damages or for any other relief)?

The orders of the Court are enforced either through the process of execution or, if the judgment debtor has not complied with the order of the Court, proceedings of contempt of court may also be initiated.

1.26 What other form of relief can be obtained for patent infringement? Would the tribunal consider granting cross-border relief?

As regards other forms of relief, the Court may also order that the goods which are found to be infringing, as well as materials and implements, the predominant use of which is in the creation of infringing goods, shall be seized, forfeited or destroyed.

Cross-border injunctions and other relief are not granted by Indian courts.

1.27 How common is settlement of infringement proceedings prior to trial?

Yes, settlement of infringement proceedings prior to trial is very common.

1.28 After what period is a claim for patent infringement time-barred?

After three years from the last act of infringement, a claim for patent infringement becomes time barred.

1.29 Is there a right of appeal from a first instance judgment, and if so, is it a right to contest all aspects of the judgment?

Yes, there is a right of appeal from a first instance judgment in which all aspects of the judgment may be contested.

1.30 What effect does an appeal have on the award of: (i) an injunction; (ii) an enquiry as to damages or an account of profits; or (iii) an order that a patent be revoked?

An appeal itself would not stop the execution of an injunction, enquiry as to damages or order of revocation. A decree passed by the Court of first instance would be enforceable even if an appeal is filed against it. However, if the appellate court stays the operation of the decree either entirely or in some parts, the extent of the decree stayed cannot be enforced. If the appellate court stays the award of an injunction, enquiry as to damages or the order of revocation during the pendency of the appeal, these reliefs cannot be enforced.

1.31 Is an appeal by way of a review or a rehearing? Can new evidence be adduced on appeal?

The powers of the appellate court under the Code of Civil Procedure are not merely to review the decree. The powers go beyond review and include the powers to decide the case finally, to remand back the case, to frame issues and refer them for trial or even re-trial and to modify the decree. An appellate court can modify the decree by reversing the decision or arrive at an altogether new finding based on the facts of the case. In this regard, the appellate court can take additional evidence and even re-consider the evidence already adduced before the Court of first instance.

1.32 How long does it usually take for an appeal to be heard?

There is no time fixed for hearing the appeal under the Code of Civil Procedure. It usually takes two to three years in deciding an appeal. However, the time taken by an appellate court in deciding an appeal depends on the complexity of the case such that those cases in which additional evidence is permitted by leave of the Court may take a longer time to decide.

1.33 How many levels of appeal are there? Is there a right to a second level of appeal? How often in practice is there a second level of appeal in patent cases?

Yes, the law provides a second level of appeal, but it is not a matter of right *per se*. An appeal from a decree passed by a District Court

is appealable before a Single Judge of the High Court. The decree arising out of an appeal before the High Court can be appealed before the Supreme Court of India by way of a Special Leave Petition. Moreover, under the High Courts rules of different High Courts, and the Letters Patent Act, a decision arising from a Single Bench of a High Court is appealable before a Division Bench of the same High Court. Thus, a decision of a Single Judge of a High Court is appealable either before a Division Bench of the same High Court or the Supreme Court of India. However, this does not take away the option of appealing again before the Supreme Court of India by way of a Special Leave Petition against the decision of the Division Bench.

1.34 What are the typical costs of proceedings to a first instance judgment on: (i) infringement; and (ii) validity? How much of such costs are recoverable from the losing party? What are the typical costs of an appeal and are they recoverable?

It is difficult to estimate the costs of proceedings before a Court of first instance or appeal. Typically, it could cost somewhere from USD 30,000 to USD 60,000 until the interim decision on the injunction. The costs for a trial may range from USD 125,000 to USD 250,000.

The costs for appeal could be around USD 50,000 or more. Under the Commercial Courts Act, legal costs are recoverable from the losing party both in the suits and appeals. The counsel of the winning party may submit a certificate in respect of legal costs and the Court can award legal costs based on the same. However, the entire legal cost may not be recoverable as the Courts have discretion in deciding the legal costs to be awarded against the losing party.

1.35 For jurisdictions within the European Union: What is the status in your jurisdiction on ratifying the Unified Patent Court Agreement and preparing for the unitary patent package? For jurisdictions outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your jurisdiction?

For enforcement of foreign judgments, India is not part of any regime or convention. However, there are certain bilateral agreements with certain countries for reciprocal arrangements in the enforcement of judgments and decrees.

2 Patent Amendment

2.1 Can a patent be amended *ex parte* after grant, and if so, how?

A patent in India can be amended *ex parte* by the patentee by making an application to the Controller under Section 57 of the Indian Patents Act and stating therein the nature and reasons for the proposed amendment. The controller shall not allow any proposed amendment if any suit for the infringement or revocation is pending before the Court. If the Controller believes that the proposed amendment is substantive, shall publish the proposed amendments in the official journal of patents. Any person interested in opposing the application for amendment may file a notice of opposition within three months from the date of publication of the application for amendment.

2.2 Can a patent be amended in *inter partes* revocation/invalidity proceedings?

Amending a patent in *inter partes* revocation/invalidity proceedings is permitted in India for which an application should be made by the patentee to the High Court, with notice of the application being given to the Controller. The High Court may allow the amendments in the manner and with the terms they deem fit.

2.3 Are there any constraints upon the amendments that may be made?

It is the settled legal position that amendments beyond the scope of the specification and claims would not be permissible. The amendments to a patent application or a granted patent have constraints prescribed under Section 59 of the Indian Patents Act, which requires that an amendment can only be made by way of disclaimer, correction, or explanation. Section 59 also provides that no amendments other than those for the incorporation of facts shall be permitted. Another important constraint imposed by Section 59 is that amendments, the effect of which would be such that the specification as amended would claim or describe the matter that was not in substance disclosed in the specification before the amendments, or that the amended claim would not completely fall within the scope of a claim of the specification before the amendment, shall not be permitted.

The amendment of “product by process” claims to “process” claims is permissible under the scheme of the Indian patent law. However, the amendment of purpose-limited product claims to general product claims would be in the teeth of Section 59. Further, in one instance, the Court adopted the purposive interpretation for the determining scope of claim amendments and allowed amendments of “method for treatment” claims to “product”, which were held to be non-permissible by the Controller as per literal interpretations of Section 59. It, seemingly, expanded the scope of claim amendments.

The High Court, hearing an appeal against a rejection order of the Patent Office, has the same powers as given to the Controller under Section 15, which includes the power to require amendment. The amendments falling outside the scope of Section 59, due to the erroneous application of non-patentability objections by the Controller, can be remedied by the High Court by requiring and allowing amendments at the appellate stage.

3 Licensing

3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?

Yes, terms of a patent licence may be limited under the Competition Act if the royalty rate or other terms amount to an abuse of a dominant position by the patentee. Section 140 of the Indian Patents Act also prohibits certain restrictive conditions in a patent licence, such as terms relating to an exclusive grant bank, prevention of challenges to the validity of a patent, coercive package licensing or any term that prohibits the licensee from acquiring from any third party or any process or any article other than the patented process or patented article.

3.2 Can a patent be the subject of a compulsory licence, and if so, how are the terms settled and how common is this type of licence?

Yes, a patent can be the subject of a compulsory licence.

The terms are settled by the Controller, who shall endeavour to secure that:

- (i) the royalty and other remuneration, if any, reserved to the patentee or other person beneficially entitled to the patent, is reasonable, having regard to the nature of the invention, the expenditure incurred by the patentee in making the invention or in developing it and obtaining a patent and keeping it in force and other relevant factors;
- (ii) the patented invention is worked to the fullest extent by the person to whom the licence is granted and with reasonable profit to him;
- (iii) the patented articles are made available to the public at a reasonably affordable price;
- (iv) the licence granted is a non-exclusive licence;
- (v) the right of the licensee is non-assignable;
- (vi) the licence is for the balance term of the patent unless a shorter term is consistent with the public interest;
- (vii) the licence is granted with a predominant purpose of supply in the Indian market and that the licensee may also export the patented product;
- (viii) in the case of semiconductor technology, the licence granted is to work the invention for public non-commercial use; and
- (ix) in case the licence is granted to remedy a practice determined, after the judicial or administrative process, to be anti-competitive, the licensee shall be permitted to export the patented product, if necessary.

In India, only one compulsory licence has been granted.

4 Patent Term Extension

4.1 Can the term of a patent be extended, and if so, (i) on what grounds, and (ii) for how long?

No, the term of a patent cannot be extended in India.

5 Patent Prosecution and Opposition

5.1 Are all types of subject matter patentable, and if not, what types are excluded?

No, not all types of subject matter are patentable in India. Section 3 of the Patents Act, 1970, specifically states that the following are not inventions:

- (a) something frivolous or which claims anything contrary to well-established natural laws;
- (b) something which the primary or intended use or commercial exploitation could be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health, or to the environment;
- (c) the mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature;
- (d) the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance, or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine, or apparatus, unless such known process results in a new product or employs at least one new reactant.

For this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of a known substance are considered as the same substance, unless they differ significantly in properties with regard to efficacy;

- (e) 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;
- (f) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;
- (g) a method of agriculture or horticulture;
- (h) any process for the medicinal, surgical, curative, prophylactic diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products;
- (i) plants and animals in whole or any part thereof other than microorganisms but including seeds, varieties, species and essentially biological processes for production or propagation of plants and animals;
- (j) a mathematical or business method, or a computer program *per se* or algorithms;
- (k) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;
- (l) a mere scheme or rule or method of performing a mental act or method of playing a game;
- (m) a presentation of information;
- (n) topography of integrated circuits; and
- (o) an invention which, in effect, is traditional knowledge or which is an aggregation or duplication of known properties of a traditionally known component or components.

Apart from the above, inventions relating to atomic energy are not patentable as per Section 4 of the Patents Act.

5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents? If so, what are the consequences of failure to comply with the duty?

There is no duty of the applicant towards the Patent Office to disclose prejudicial prior art or documents unless the Controller specifically asks for such information. However, Section 8 of the Patents Act read with Rule 12 of the Patent Rules imposes two requirements on applicants in relation to foreign applications.

The first requirement arises from Section 8(1) read with Rule 12(1), 12(1A), and 12(2), which requires applicants to inform the Indian Patent Office about the details of all related applications voluntarily and when asked by the Patent Office through an examination report or a hearing notice. The details of the related applications already filed before the Indian patent application are to be provided at the time of filing the Indian patent application or within six months from the filing. Details of all subsequently filed related applications can be provided within six months from the date of their filing. The details of related patent applications need to be submitted to the Indian Patent Office in Form 3 and should include: the name of the country; date of application; application number; status of an application; date of publication; and date of grant.

The second requirement arises from Section 8(2) read with Rule 12(3), requiring applicants to submit: (i) claims allowed; and (ii) information relating to objections raised in related applications for all/major jurisdictions, only when specifically asked for by the Indian Patent Office. The documents under the second requirement are to be submitted within six months from the request by the Indian Patent Office. The cited references

are not required to be submitted to the Indian Patent Office on the lines of the IDS requirement of the USPTO, only the claims allowed, objections raised in office actions, etc., need to be provided to the Indian Patent Office. Recently, the Indian Patent Office has significantly reduced the demand for documents under Section 8(2) in the First Examination Reports after the introduction of WIPO's Centralized Access to Search and Examination (CASE) system.

Failure to comply with the above requirements, and more particularly any wilful suppression of material information, may lead to the refusal to grant a patent in a pre-grant opposition proceeding. If the patent is granted, it may be cancelled in a post-grant opposition or revoked in a revocation proceeding.

5.3 May the grant of a patent by the Patent Office be opposed by a third party, and if so, when can this be done?

Yes, the grant of a patent may be opposed by a third party. Under Section 25, the opposition proceedings are of two types:

- (a) pre-grant opposition: the pre-grant opposition can be filed by any person once the patent application is published but not yet granted; and
- (b) post-grant opposition: the post-grant opposition can be filed only by **a person interested** within one year from the publication of the grant of the patent. A person interested is a person engaged in, or in the promoting or research of, the same field of the invention.

Apart from the above, a patent may be revoked on a petition of any person interested or of the Central Government by the High Court or on a counterclaim in a suit for infringement of the patent by the High Court under Section 64.

5.4 Is there a right of appeal from a decision of the Patent Office, and if so, to whom?

Yes, an appeal against the Controller's decision may be filed before the High Court within three months from the date of the decision. However, only the applicant has the right to appeal in case of a decision on a pre-grant opposition and the opponent does not have a right to appeal due to other available remedies, one being under the writ jurisdiction.

5.5 How are disputes over entitlement to priority and ownership of the invention resolved?

The Indian patent law and rules require the applicant to furnish a certified copy of a priority document(s), or Form PCT/IB/304 in case of an international application, as proof of entitlement to priority. The Indian Property Office (IPO) is both a participating and accessing office of the WIPO Digital Access Service (DAS) with effect from January 31, 2018. An English translation of the priority documents may still be demanded by the IPO if a P-category prior art is cited. A certified priority document and/or a verified English translation thereof can be submitted within three months of notice from the IPO.

Section 7(2) of the Indian Patents Act provides for the submission of "proof of right" of the applicant for all types of applications. It prescribes that wherever the applicant has obtained rights in the invention from the true and first inventors, a "proof of right" must be submitted. In case of a national phase of Patent Cooperation Treaty (PCT) application, the "proof of right" may be:

- (1) A declaration 12(i) in Form 1, duly signed by all the inventors.

- (2) An original/notarised/certified copy of the assignment document from the inventors in favour of the applicant.
- (3) An employee–employer agreement having a clause for the assignment of IP rights.
- (4) A declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rules 4.17(ii) and 51bis.1(a)(ii) of PCT Rules). [*Note: since there is no express adoption of this provision of PCT Rules in Indian patent law, in practice, some of the controllers at the IPO do not accept this declaration and a consistent practice for acceptance of this declaration is yet to be notified by making necessary amendments in national laws.*]
- (5) If any of the above is unavailable, the applicant may consider filing a confirmatory assignment subject to the approval of the examining officer. The confirmatory assignment may be understood as an assignment, executed later, which confirms an earlier-made assignment between the parties involved.
- (6) The applicant may also consider filing an affidavit declaring the entitlement to the right to apply for a patent.

Issues with respect to entitlement to priority and ownership of the invention are mostly settled between the applicant and the Patent Office during prosecution. However, it is open for opponents to oppose the application or granted patent or apply for revocation of the granted patent on the relevant grounds. In any case, the applicant or the patentee will be allowed to file its reply and evidence, and after hearing both parties, the concerned authority, i.e., the IPO, or the Court of law, will issue its decision.

5.6 Is there a "grace period" in your jurisdiction, and if so, how long is it?

In India, a 12-month grace period is available in limited circumstances. In case the patent application is filed within 12 months from the day of the following publication/usage/display, no anticipation will be deemed to have taken place for:

- (a) Public display and use of the invention in an industrial or other exhibition (as notified by the Indian Government) with the consent of the inventor.
- (b) Any publication of the invention as a result of the events in point (a).
- (c) Use of the invention by any person without the consent of the inventor/applicant after the occurrence of an event listed in point (a).
- (d) The disclosure of the invention by the inventor before the "learned society" and publication of such disclosure with the consent of the inventor by the "learned society" as a privileged and confidential document (i.e., for private circulation among authorised members).

Given the above, any other prior publication on a patent application is not covered as a special circumstance, and the prior publication would always be considered as a prior art against the application filed in India.

Important timelines for which no grace period is available in India include the 12-month period to claim priority under the Paris Convention, the 31-month entry period for PCT national phase applications, and the 48-month period from the date of priority to request examination.

5.7 What is the term of a patent?

The term of a patent is 20 years from the date of application. In the case of a national phase application, the international filing date is the date of filing.

5.8 Is double patenting allowed?

No, double patenting is not permitted in India.

There is no provision for a continuation application in India. However, an application for a patent concerning an addition (akin to CIP applications) for improvement of the main invention, or a divisional application for an already disclosed distinct invention, may be filed.

“One Application, One Inventive Concept” is followed in India. The concept of a divisional application in the Indian patent law addresses the issues of permissibility of protection of multiple inventions disclosed in one patent application, where these multiple inventions do not constitute a single inventive concept – dubbed as the plurality of inventions. The protection of multiple inventions through the divisional application is available.

A divisional application filed with the same set of claims as that of the parent application would be objected for double patenting and any amendments to claims need to comply with the requirements of Section 59(1), i.e.: amendments must be by way of explanation, correction, or disclaimer; amendments must be for incorporation of facts only; amendments need to be supported by the specification; and amendments cannot broaden the scope of claims. Therefore, the claims of the divisional application cannot be outside the scope of the claims of the parent specification and at the same time there cannot be duplication of claims, i.e., the parent specification and the divisional specification. These are referred to as twin conditions. It is pertinent to note here that there is no advance notice of grant in India and the sudden grant of a patent can foreclose the opportunity to pursue a divisional application. Therefore, a divisional application, if required, should be filed at the earliest opportunity and preferably before responding to first office action.

5.9 For jurisdictions within the European Union: Once the Unified Patent Court Agreement enters into force, will a Unitary Patent, on grant, take effect in your jurisdiction?

This does not apply to our jurisdiction.

6 Border Control Measures

6.1 Is there any mechanism for seizing or preventing the importation of infringing products, and if so, how quickly are such measures resolved?

The Central Government formulated the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007, in consonance with the TRIPS and World Customs Organisation Model. The Indian Customs Department has the Customs Recordal system, where the rights holder records his right. After this, the Customs Authorities help stop the cross-border movement of counterfeit or infringing goods. However, an amendment in June 2018 to the said rule omitted the word “patent” from the definition of IP. Therefore, after the amendment of the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007, the Customs Authorities no longer have jurisdiction to scrutinise the import of any product/good on the ground that the products may be infringing one or more Indian patents. The enforcement of patent rights at the border is now only possible through an order of the Court whereby a specific injunction to import infringing products is granted.

7 Antitrust Law and Inequitable Conduct

7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?

India enacted its Competition Act in 2002, which prevents the abuse of a dominant position by any enterprise. Recently, the Courts have held that a complaint against a patentee’s abuse of a dominant position is an independent proceeding and does not affect any relief in a suit for patent infringement.

7.2 What limitations are put on patent licensing due to antitrust law?

The limitations on terms of licensing under the Competition Act, 2002, may include those that prevent exorbitant and non-uniform royalty rates, any discriminatory terms that violate FRAND terms, a bar on the jurisdiction, etc.

7.3 In cases involving standard essential patents, are technical trials on patent validity and infringement heard separately from proceedings relating to the assessment of fair reasonable and non-discriminatory (FRAND) licences? Do courts set FRAND terms (or would they do so in principle)? Do courts grant FRAND injunctions, i.e. final injunctions against patent infringement unless and until defendants enter into a FRAND licence?

In cases involving standard essential patents, technical trials on patent validity, infringement, and assessment of FRAND licences are heard together if they arise from the same cause of action. Yes, courts have recently granted FRAND injunctions and have also determined the royalty rates under the licence based on previous licence arrangements. The Courts have set the FRAND terms, including the licensing rates.

8 Current Developments

8.1 What have been the significant developments in relation to patents in the last year?

Based on the recommendations of the Parliamentary Committees on Review of the IPR laws and system, the Department for Promotion of Industry and Internal Trade (DPIIT) started taking the views of stakeholders to consider significant amendments in Indian IPR laws to align them with the global standards. The Department is also taking the views of stakeholders on the long list of matters excluded from patentability under Section 3 of the Patents Act, 1970.

Amendments to the Patents Act, as a part of an umbrella reform by the Indian Government, have been proposed to abolish imprisonment for minor offences under the patent law and instead, increase fines for such offences. Penalties will be imposed only in cases where non-compliance is wilful and deliberate, which will promote ease of doing business in India for patented products and increase investment sentiment in the sector.

On April 4, 2021, the Indian Government abolished the Intellectual Property Appellate Board (IPAB), i.e., the appellate authority to entertain appeals from the decisions of the Patent, Trademark and Copyright Offices, and cancellation/revocation/nullity actions. The jurisdiction of the erstwhile IPAB

was transferred to the Commercial Divisions of High Courts at Chennai, Kolkata, Mumbai, and New Delhi. The Delhi High Court on July 7, 2021, announced the creation of the IP Division for handling all IPR matters, including those which are to be transferred from the IPAB. As of now, three Single Judge Benches of the Delhi High Court are acting as the IP Division to exclusively hear all IPR matters, including the appeals arising out of the decisions of the Controllers or Patents, Registrar of Trademarks, Controller of Designs, Registrar of Copyright, Registrar of Geographical Indications, and the Plant Variety Authority.

In 2022, the High Court of Delhi notified the IP Division Rules and the Rules Governing Patent Suits, 2022. The Rules Governing Patent Suits, 2022, provide procedures and mechanisms for simpler, effective, and efficient adjudication of patent infringement cases. It also prescribes the procedures related to pleadings, case management hearings, mediation, summary adjudication, etc. The process for the engagement of researchers to be attached to the IP Division is currently underway in the Delhi High Court.

In April 2023, the Madras High Court also launched its IP Division presided over by a Single Judge Bench and a Division Bench to deal with disputes and cases concerning IPR. The Madras High Court Intellectual Property Rights Division Rules, 2022, were also notified to govern and regulate the proceedings before the IP Division. Other High Courts may also follow the initiative of the Delhi and Madras High Courts and soon set up IP Divisions in those courts as well.

With the creation of these IP Divisions, speedy adjudication of IPR disputes, including patent cases, has been witnessed and quality judgments on technical issues and questions of law are accruing to the depository of precedents at a greater rate than before. Among these silver linings, some landmark verdicts, given in appellate jurisdiction, are inevitable to note.

- Recording of reasons for refusal of the grant has been made mandatory for the Patent Office, particularly for a finding of lack of inventive step.
- It was settled that the initial *onus probandi* for the proper identification of known substance for the lack of therapeutic efficacy invariably falls upon the Controller, not on the applicant.
- The mere expression “composition X for use in treating a disease Y” in claims may not be indicative of the method of treatment exclusion; it may only be a way of defining purpose-limited product claims. This ratio could limit stricter application and literal construction of method of treatment exclusion by the Patent Office.
- Secondary considerations (such as the long-felt need and age of the prior art etc.), which were alien to the practice hitherto under the Indian patent regime, have been declared *indignum* of non-obviousness, depending on the merit of the case.

On the litigation front, a division bench of the Delhi High Court approved the modified “triple identity” test and “insubstantial difference” test to assess claims based on the doctrine of equivalents in a non-literal infringement suit. In the case of process patents, it was also made clear that the doctrine of equivalents must be applied to each element of the process. While the doctrine of equivalents has been validated by courts in major jurisdictions, it was not examined thoroughly by the Indian courts until this case. Last year’s ruling of the Delhi High Court has significant precedential value in this respect. However, the defence of prosecution history estoppel in a

non-literal infringement by equivalents remains to be tested. As held in another leading case involving a pharmaceutical patent dispute, file wrapper estoppel (e.g., statements made during the prosecution of a patent application before the Controller) can make an impact during the adjudication of injunction applications. Effectively, parties are not permitted to “approbate and reprobate”.

8.2 Are there any significant developments expected in the next year?

Based on the recommendations of the Parliamentary Committee on Review of IPR laws and the multiple stakeholders’ meetings organised, various statutory, regulatory, and administrative reforms are expected in Indian IP laws for harmonisation, to boost foreign direct investment and to incentivise technology transfer in India.

Given the ever-increasing landscape of emerging technologies such as Artificial Intelligence, the Delhi High Court, while referring to recommendations of the Parliamentary Committee, expressed concern that a large number of inventions may be excluded from patentability under Section 3(k) and, therefore, suggested the DPIIT to re-examine the exclusions for computer-related inventions. It is expected that these repeated proposals will reach the corridors of policymakers on this occasion and action will be initiated.

The bio-pharma industry is keenly awaiting the judicial review of the Delhi High Court on the method of medical treatment exclusion. The scope of patentability of diagnostic method patents will be determined by the upcoming verdict that may have a bearing on many biotechnological and pharmaceutical applications.

Judicial recommendations have been made that recognise an imminent need to update the Manual of Patent Office Practice and Procedure, so that Examiners and Controllers can get better guidance on dealing with intricate matters like objections of non-patentability. The Delhi High Court has also advised the Office of the Controller General of Patents, Designs & Trade Marks (CGPDTM) to augment and strengthen the quasi-judicial capacity development program for the Controllers. The ball is in the court of the Patent Office. We anticipate an overhaul in prevailing practice and guidelines capturing recent trends set by IP Division through its decisions. If done properly and timely, this could prove to be a point of inflection for the sector.

8.3 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Some of the noticeable trends in recent years include the reduced waiting time for examination, faster disposal of IP applications, steady increase in IP applications filed, continual and progressive legislative reforms, and increase in the number of IP litigations for either enforcement or invalidation, leading to landmark judgments. All these trends signify the development of a conducive IP system in India, to incentivise technology transfer and boost foreign direct investment rapidly. So far, the success rate in appeal cases disposed of by the IP Division tilts in the favour of applicants reflecting a pro-patentability stance; however, the long trend will be revealed in years to come.



Manisha Singh is a seasoned IP professional holding a decorated career spanning over two decades and repute as one of the most distinguished lawyers in the domain. She started her career at the time when Indian IP laws and practices were undergoing substantial changes pursuant to India's obligations to comply with the TRIPS agreement. Through the years, she has been consistently involved in the betterment of the country's IP regime and has been engaged in advising Indian policymakers, implementers, and IP owners on global IP standards and enforcement systems.

She is a true strategist and has led some of the most prominent and complex cases for large multinational and domestic corporations. She is identified by her clients as a seasoned and reliable counsel for the prosecution and enforcement of all forms of IP rights, and planning and management of global patents, trademarks, and designs portfolios. She has also led numerous negotiations on behalf of her clients for both IP and non-IP litigation and dispute resolution.

Ms. Singh has served as the leading counsel for a client base in over 138 countries in their IP management and litigation matters. She has assisted numerous technology giants, *Fortune 500* companies, globally renowned universities, and public sector research institutions in the APAC region, the USA, Europe, the UK, Oceania, Latin America, and the MENA region.

Ms. Singh is also the Standing Counsel for the Reserve Bank of India at the Delhi High Court and is known for her deep understanding of corporate, banking, and financial services laws. Ms. Singh is a prolific writer and has contributed chapters in Indian IP laws to many leading publications, including Mondaq, IP Media Group, Vantage Asia, Managing IP, Asia IP, and CTC Media to name a few.

LexOrbis
709/710, Tolstoy House
15-17, Tolstoy Marg
New Delhi – 110 001
India

Tel: +91 11 2371 6565
Email: manisha@lexorbis.com
URL: www.lexorbis.com



Rajeev Kumar is a registered Indian patent attorney and holds a Master's in pharmaceutical sciences from the Delhi Pharmaceutical Sciences and Research University. Mr. Kumar leads the firm's patent filing and prosecution group and has more than 18 years of experience. He assists clients in mining and securing patent protection in India, Europe, the United States, internationally and other countries by drafting and prosecuting patents in relation to pharmaceuticals, nutraceuticals, chemical, biochemical, organic chemistry, peptide chemistry, medicinal products, medical devices, oil and gas, and nanotechnology.

He is also engaged in providing product or process clearance opinions to clients in India and providing guidance in conducting freedom-to-operate searches in other jurisdictions. He is also actively involved in providing invalidity and patentability opinions to various clients. He also provides assistance to the legal team in various contentious matters, including pre-grant oppositions, post-grant oppositions, revocations, appeals and in litigation cases before the courts.

Mr. Kumar regularly advises national and international clients on filing and prosecution strategies in India and freedom-to-operate matters. He is a regular speaker in various seminars/conferences and has published a number of articles on various patent-related subjects.

LexOrbis
709/710, Tolstoy House
15-17, Tolstoy Marg
New Delhi – 110 001
India

Tel: +91 11 2371 6565
Email: rajeev@lexorbis.com
URL: www.lexorbis.com

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