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Expedited Examination under Indian Patent Law

-Manish Kumar

Introduction

Patent rights have always played a vital role in encouraging innovations across the globe. To keep pace with the standard time globally for granting a patent, the Patent Rules were amended in 2016 to introduce the provision of expedited examination for an applicant who has indicated India as a competent ISA or IPEA or the applicant is a Startup. The Draft Amendment rules published on December 04, 2018, have further expanded the category of applicants who may request for expedited examination. Let's first understand what expedited examination is under the Indian Patent Law.

Expedited Examination

A request for expedited examination is an application filed by an applicant requesting the Indian Patent Office to accelerate the examination of the patent application under rule 24C of the Patent Rules, 2003. The request for expedited examination is different from the express request for examination filed for the PCT National Phase application at any time before thirty-one months under rule 20(4)(ii) of the Patent Rules, 2003. The applications for expedited examination will be allotted to a queue, which is different from the ordinary examination queue, and already has thousands of applications awaiting examination. Hence, the applications for which expedited examination is requested will be allotted to an examiner for

examination substantially sooner than the applications that have been queued for normal examination.

Who qualify for Expedited Examination?

According to draft rules, an applicant who fulfills any of the following criteria can apply for expedited examination:

- The applicant has chosen India as an International Searching Authority (ISA) or as an International Preliminary Examining Authority (IPEA) in a corresponding PCT application.
- The applicant is a Start-up as defined in rule 2(fb) of the Patent Rules, 2003; or
- The applicant is a small entity as defined in rule 2(fa) of the Patent Rules, 2003; or
- The applicant is a female natural person; or
- The applicant is a government undertaking in accordance with section 2(1) (h) of the Patent Act, 1970 in case of an Indian applicant, or is a similar entity in case of a foreign applicant; or
- The applicant is eligible under an arrangement for processing an international application pursuant to an agreement between Indian patent office with another participating patent office.

Expedited Examination Procedure

According to rule 24C of the Patent Rules, 2003, an applicant can file a request for expedited examination by filing Form 18A as specified in the second schedule of Patent Rules, 2003, along with the fee as

mentioned in the first schedule only by electronic transmission duly authenticated with 48 months from the date of priority or date of filing of application whichever is earlier.

In addition to the above, a request for expedited examination shall be accompanied by a request for early publication under rule 24A of the Patent Rules, 2003, except where an application has been published or a request for publication has already been filed. Further, a request for normal examination can be converted into a request for expedited examination by paying the relevant fee and submitting the requisite document.

Once the request for examination has been filed and the application has been published, the Controller shall refer the request for expedited examination along with the application to the examiner in the order of filing of such requests. Then the examiner is required to examine the patent application and make his report within one month but not exceeding two months from the date of reference of the application to him. The Controller, then, is required to dispose

off such report of the examiner within one month of receipt of report and the first statement of objections, if required, are to be issued within fifteen days from the date of disposal of the report by the Controller.

A reply to the first statement of objection is to be filed within 6 months from the date of the examination report or within an extended period of 3 months. However, it is advised to file the response at the earliest as it would be examined in the order in which it is received by the patent office.

Further, the Controller is required to dispose-off the application of expedited examination within a period of three months from the date of receipt of the last response to the first examination report or within three months from the last date to put the application in order for grant. However, this time limit shall not be applicable in case where pre-grant opposition is filed.

Conclusion

The step to broaden the category of applicants who can apply for expedited examination is an encouraging step for inventors to get their invention patented expeditiously.

Madras High Court: Time and Resource Saver?

-Mohit Kohli

There is a recent update regarding the Indian Patent law where an Intellectual Property Appellate Board (IPAB) order has been validated by Madras High Court by dismissing a writ petition challenging an order that effectively upheld a Patent.

Background of the Case:

Kibow Biotech, founded in 1997, is a US based company specializing in development and commercialization of dietary supplements. Renadyl is the flagship product of the company that augments kidney function and reduces the need for patients to undergo dialysis was under inspection here.

La Renon, an indigenous Indian company based out of Gujarat, challenged the validity of two patents. In 2013, in La Renon vs Kibow Biotech before IPAB, the process patent no. (205478) was rejected by the IPAB in favor of La Renon. But product patent no. (224100) was upheld in the favor of Kibows. According to an official statement by the Kibows, a product patent is more valuable to them as compared to a process patent, as it permits them to prevent third parties from making a copy of the product, irrespective of the process they used to arrive at the product.

In a writ petition challenging the IPAB order, La Renon approached Madras High Court on the following grounds:

- That there was no novelty in the invention.
- The product is obtained by a mere admixture of ingredients resulting in aggregation of the properties of the components, therefore, it is barred from being patented.
- The patent neither directly nor explicitly discloses a composition comprising a combination of Streptococcus thermophilus with other ingredients viz., vitamin, mineral, carbohydrate, protein and fats, as claimed, but talks of some other unconnected combinations.
- The patent was obtained by a false suggestion and material suppression of facts, claiming that the claimed composition increases kidney function and it can be used for kidney patients.
- The patent was obtained by making a false representation that the prior patent applications were pending, when in reality prior patent applications were refused in the US.
- The patent specification does not disclose as to how the composition increases kidney functions.

On January 10, 2019, the court effectively upheld the IPAB order and ruled against La Renon.

COURT VERDICT: “There is a distinction between the scope of review in a writ jurisdiction and an appeal. The former review is far more limited than the latter.” The court added that a person challenging a patent must produce evidence (prior art) and argue how the prior art anticipates the patent. Merely throwing a ton of prior art is not enough and also stated that a person who had the opportunity to adduce evidence and make arguments before the IPAB to contest validity of patent and didn’t avail of the opportunity suitably cannot now come and demand a remand.

This is what the court ruled in this regard:

“143. We are not exercising Appellate Court’s Jurisdiction under Article 226 of the Constitution of India. On the other hand, we have to examine the impugned order from the perspective of a Court exercising supervisory jurisdiction under Article 226 of the Constitution of India. The scope of writ petition against an order of the third respondent Appellate Board is limited. We can only examine whether there was any infirmity in the procedure adopted by the third respondent Appellate Tribunal while passing the impugned order.

144. We do not find any infirmity in the procedure adopted by the third respondent Appellate Tribunal while passing the impugned order. The impugned order also cannot be termed to be a palpably erroneous order on account of error on the face of record. We therefore find no grounds to intervene.”

145. We are therefore inclined to dismiss the above writ petition and accordingly dismiss the writ petition. No cost.

Highlighting the difference in scope of review and appeal for patent matters, this decision is a reminder on provisional procedure to avoid wastage of time, resources and uncertainty in enforcement of rights.

Penalties and Reliefs under Indian Patents Act, 2000

-Aayush Sharma

Chapter XX [Sections 118-124] of the Patents Act, 1970, deals with the provisions of penalties. Various parameters have been laid down by the Patent office to impose penalties on any act forbidden by Patent law. These penalties are in the form of either fine, imprisonment or both. Parameters laid down are providing false information to patent office, unauthorized claims of patent rights, failure to furnish information related to working of patent, wrongful use of word patent office, practice by unauthorized person i.e. non-patent agents, offence by companies etc. Further, the article will also discuss the reliefs in an action for infringement as defined under section 108 of the Patents Act, 1970.

- **Contravention of secrecy provisions relating to certain inventions:** In this case, if any person fails to comply with the directions given under section 35 or makes an application for grant of patent in contravention of section 39 of the Patents Act, 1970, then he shall be liable for punishment with imprisonment for a term which may extend to 2 years or with fine or with both.
- **Falsification of entries in register etc:** If any person makes false entry in the Register of Patent, or writes falsely purporting to be a copy of an entry in such a register, knowingly or unknowingly, he shall be punishable with imprisonment for a term which may

extend to 2 years or with fine or with both.

- **Unauthorized claim of Patents rights:** If any person falsely claims or represents any article sold by him as patented in India or if the article is stamped, engraved or impressed on or otherwise applied to the article, or the word “patent” or “patented” or some other word expressing or implying that the patent of the article has been obtained in India, or that an article is the subject of an application for a patent in India, or if the article is stamped, engraved or impressed on or otherwise applied to the article, or the word “patent” or “patented” or some other word expressing or implying that the patent of the article has been made in India, he shall be punishable with fine which may extend to Rupees One lakh.
- **Wrongful use of words “patent office”:** If any person uses on his place of business or on any of the documents issued by him, the word patent office or in any other way which would lead to belief that his place of business or document issued by him are related to or connected with the patent office, then such offence shall be punishable with imprisonment for a term which may extend to 6 months or with fine, or with both.

Refusal or failure to supply information: In any case, if the person fails to furnish or refuses any information which is false, and which he

either knows or does not believe to be true, as required by the Central Government under section 100(5) of the Patents Act, 1970, or any information related to working of patents which is required to be furnished under section 146 of the Patents Act, 1970, he shall be punishable with fine which may extend to 10-lakh rupees. In case of providing false information as required under section 146, the offence shall be punishable with imprisonment which may extend to 6 months or with fine, or with both.

- **Practice by non-registered patent agents:** If any person contravenes the provisions of section 129, he shall be punishable with fine which may extend to Rupees one lakh for first offence and Rupees Five lakhs for second offence.
- **Offence by companies:** If any company as well as every person in charge of and responsible to that company found responsible for the conduct of his/ their business at the time of commission of the offence shall be deemed to be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

Relief in an action for infringement:

Section 108 of the Patents Act, 1970, which provides the reliefs which a court may grant in any suit for infringement includes an injunction subject to such terms, if any, as the court thinks fit and damages or an account of profits. An order for delivery or destruction of infringer's articles may also

be passed. The court may also order that the goods which are found to be infringing and materials and implements(tools), the predominant use of which is in the creation of infringing goods, shall be seized, forfeited or destroyed, as the court deems fit under the circumstances of the case without the payment of any compensation.

Injunction

An injunction is an order of a court prohibiting someone from doing some specified act or commanding someone to undo some wrong or injury. Generally, it is a preventive and protective remedy aimed at preventing future wrongs. Mainly injunctions are of two kinds:

1. Temporary/Interlocutory injunctions

Temporary injunctions are the court orders which are in force for a specified time or until further orders of the court. An interlocutory injunction may be granted at any time during the proceedings of the suit. The plaintiff may, at the commencement of the suit or any time during the suit, move the court for grant of an interim injunction to restrain the defendant from committing and continuing to commit the acts of alleged infringement.

2. Final/Permanent Injunctions

Final/permanent injunction is such injunction which is granted at the termination of the trial. The time for which the final injunction is in force is the remaining term of the patent at the time of grant of final injunction.

Damages or Accounts of Profits

A successful plaintiff in a suit for infringement is entitled to the relief of damages or account of profits. However, both reliefs cannot be granted together. There are certain cases when damages or account of profits cannot be granted. In a suit for infringement of a patent, damages or an account of profits shall not be granted against the defendant who proves the infringement was innocent and that at the date of the infringement the defendant had no reasonable grounds for believing that the patent existed.

Section 108 provides that the court may either award damages or account of profits but both of them cannot be claimed together. The plaintiff has to prefer either of the two. The account of profits is determined on the basis of actual use of the patentee's invention by the infringer during the period of commission of the act of infringement. Account of profits is the part of profits which can be attributed to the use of the patentee's invention by the infringer.

Conclusion

Penalties have been introduced in the Patents Act to safeguard the interest of patents from illegal activities. Till now we haven't seen any case where patent office has issued penalties or has found someone guilty of any misdeed as defined under the act. The penalties are in the form of fine or imprisonment or both.

A Dive into India's Innovation Sea

-Monika Shailesh

The academic community of India was taken aback by the statement of Mr. Narayan Murthy when he said that no invention, technology or idea from India had set the world on fire in the last 60 years. The matter is under fierce discussion and many believe that India is lacking far behind on innovation index. In an attempt to write the Indian success story and to achieve the dream growth, people have a firm belief in the MAKE IN INDIA initiative but there are arguments that without innovation and frugal engineering practices the whole concept may fail to conceptualize. India even failed to secure a position in the Bloomberg Innovation Index 2015¹, so the question that how India will intellectualize the MAKE IN INDIA initiative is getting bigger day by day.

An Insight into Indian Patent Office Stats

Even endorsed records of the Indian Patent Office fashion a melancholy picture — while patent grants for foreign inventions increased by almost 300%, grants to Indian inventions rose by a measly 45%. In 2013-14, while as many as 42,951 patent applications were made, only 10,941 were made by Indian applicants. According to the patent office, maximum applications in 2012-13 were filed in mechanical (around 9,000), followed by chemical (7,000). While computer-related applications accounted for 4,500, about 4,300 were filed in the field of drugs, followed by 2,500 in electrical and close to 900 in biotech.

According to the World Intellectual Property Indicators (WIPO-2012) report, while China's contribution to the rise in patent applications globally has increased from 37.2% between 1995-2009 to 72.1% between 2009-11 India's contribution on same parameter decreased from 3.5% between 1995-2009 to 2.7% between 2009-2011. The report shows that while China topped the global list by filing 503,582 patent applications, India was ranked seventh with 42,291 applications². India scores poorly in commercializing R&D from its universities and its regulators often create antitrust and taxation steepchases in the effective exploitation of foreign-owned patents on Indian soil.

Analysis of India's Slide in the Innovation World

1. India spends way too little on research: India's total R&D budget is less \$3 billion whereas General Motors' annual R&D budget is \$10 billion.
2. Not enough research fodder number of students going for higher research education is low.
3. Lack of faith and initiatives: Indian services firms have been upgrading old products but not developing new lines and developing technology needs creation of culture that encourages risk-taking and innovation.
4. Too many ideas and too little implementation: Complete lack of will to put our money in research.

5. There are a million and half ways to improve engineering education in India, but implementation is nil.

What Can Be Done?

1. Strategically linked corporate research: Encourage and help Indian companies with revenues greater than \$50 million to create research organizations that are strategically linked to their business products.
2. Exploiting university research: It is cheap, but researchers have little understanding of business ground realities and needs of businesses. Allow tie-ups of small companies with R&D departments of universities.
3. Changing work cultures: Promotion of work culture that increases innovation, and also tries to increase the impact of innovation.
4. Rewarding good ideas and research: Rewarding risk taking and research accomplishments at all levels can help engender path breaking work in India.
5. Indian Institutional Investments in India: There is a clearly a paucity of NGOs who can help identify grass root innovations and ease their path to success.
6. The experiences and insights of Indian researchers and scientists in Europe and US need to be leveraged

better as many would like to contribute back to India.

Another picture that speaks volumes about the strength of Indian engineering is - frugal innovation - from the cheaper than auto fare Mangalayan to cheapest car Nano, we have been developing products and ideas that are highly innovative, customer and pocket friendly. Given the revolution in product-design and process-design philosophy that such innovation embodies, if used systematically it can become the fulcrum of India's domestic innovation culture. The government should join India Inc in patronizing research and training in codified frugal-engineering practices and brand it as a globally-relevant business methodology.

Government is required to not only support these kinds of innovations but also find a solution to enable them to fight the global research and development processes and to be more and more competitive.

Conclusion

India, instead of having manufacturing centered development policy, must have a balanced ecosystem of innovation and design along with manufacturing and the focus should be on both R&D and manufacturing. A design thinking approach is the call of the hour and we should adopt policies that will say "MADE IN INDIA" rather than MAKE IN INDIA - only this approach can lead us to a sustainable development path.

Public Domain-Resource of Information for General Public

-Dr. Heena Lamba

World Intellectual Property Organization (WIPO), in 2009, started Technology and Innovation Support Centers (TISC) to outreach inventors and help them improve their research and eventually improve technology commercialization and marketing through various search tools. India formally became part of this program when Department of Industrial Policy and Promotion (DIPP) made an agreement with WIPO on November 13, 2016 for establishing TISCs in India in order to promote IPR culture.

This article examines the exact meaning of the phrase 'Public Domain'. Any Intellectual Property is said to come under public domain when it comes under one of the following¹ categories:

- Abandoned Applications
- Cancelled (Withdrawn) Patents
- Successfully Opposed Patents
- Abandoned Patents
- Expired Patents (expiry of the term of 20 years from the date of filing of Patent application)

All the above-mentioned categories allow general public to utilise the knowledge offered by the patent/application for further research or for making profits. The WIPO guides on identifying and using inventions in public domain have been designed to facilitate any person/researcher who wants

to use or integrate patent knowledge, available in public domain, to get new products or commercial processes of interest.

How knowledge in public domain is beneficial or why it should be utilised? Following are the benefits that can be accrued if one is utilising knowledge from IPs in the public domain²:

- Involves lesser investment of time and money in developing new product and/or product improvements to add value to inventors'/entrepreneurs' products and services;
- Minimize the risk of infringing others' IP rights;
- Can be utilized to help in the commercialization of ideas, inventions and new services and/or product offerings;
- Use or duplication is not governed by any IP regime;
- Can help the readers to make more informed management decisions regarding an invention and its future market potential.

As per the 'Guide on using information in public domain', public domain has been described as a function of geographical region and time and is given by the below mentioned formula:

$$\text{Public Domain}^3 (g,t) = U - P - C - M - ID - O + S$$

¹ WIPO Guide on Using Inventions in Public Domain

² WIPO Guide on Using Inventions in Public Domain

³ WIPO Guide on Using Inventions in Public Domain

Wherein, g = Geography; t = Time; U = Universe of known and freely accessible information; P = Patent rights; C = Copyrights; M = Mark rights; ID = Design rights; O = other rights (e.g. geographical indications, plant breeder's rights, mask works, utility models, databases, explicit traditional knowledge); S = previously secret information

While evaluating Patent rights (P), emphasis should also be given to utility models and those patents which are granted but are not enforceable owing to some legal ambiguities. Such patents may seem insignificant; however, it should be kept in mind that these do not pose any threat till they are under such legal ambiguities but infringement suit can be imposed as and when they become fully enforceable.

Collectively, the above expression defines public domain specific for a given region (g), IPR being territorial in nature, at a given point of time (t).

According to 'WIPO IP Facts and Figures 2018', there were 13.72 million patents in force worldwide in 2017, of which around 2.98 million were in force in the United States of America (U.S.), 2.1 million in China and 2 million in Japan⁴. It is pertinent to note that majority of the patents in force are in developed countries and by the virtue of patents being territorial in nature makes them readily accessible in other countries where it is not protected⁵. Subsequently, such information can be utilized by

opportunists to leverage their innovations into new products and commercialize them in market.

Accessing Public Domain Knowledge:

Public domain knowledge can be accessed through online or offline modes. Offline mode includes searching patent documents available at patent offices. This mode is time consuming and less efficient in getting relevant documents and thus, is less preferred. The preferred mode of accessing patent information is online mode. Various online databases, accessible through digital platforms, are available which provide information on IPs in public domain. But this mode is highly variable and differs from one jurisdiction to the other owing to the kind of digital services prevailing in the region.

Searching for whether a patent is in public domain or not is a task easier said than done. Mostly databases supported by Regional Patent Offices do not provide any direct option and one needs to click open every patent to check its validity. To ease researchers in finding unenforced patents, Yuenyong Nilsiam, a Ph.D. student at Michigan Tech, has come up with an open source database, the working of which has been well explained in a paper titled 'Open Source Database and Website to Provide Free and Open Access to Inactive U.S. Patents in the Public Domain in Inventions'⁶. Even NASA has its database making information of their expired patents

⁴ WIPO IP Facts and Figures 2018. Available at: https://www.wipo.int/edocs/pubdocs/en/wipo_pub_943_2018.pdf

⁵ WIPO Guide on Using Inventions in Public Domain

⁶ Search this database for inactive patents that are now in the public domain. Available at: <https://opensource.com/article/17/1/making-us-patent-system-useful-again>

available for researchers and general public⁷. However, the same can also be done individually through certain databases which offer refining search by selecting suitable time period in search results.

As evident from the above discussion, public domain serves as a reservoir of freely available knowledge for the researchers and inventors. Therefore, it is very important to consider searching the relevant public domain knowledge using available tools before marketing or commercializing a product or process, in order to get wider benefits.

⁷ NASA Makes Dozens of Patents Available in Public Domain to Benefit U.S. Industry. Available at: <https://www.nasa.gov/press-release/nasa-makes-dozens-of-patents-available-in-public-domain-to-benefit-us-industry>

