

Legal Issues in 'Patent Opposition and Practice'

Issue: Is the Appointment of Hearings Necessary for the Determination of Pre-Grant Opposition Proceedings for Patents?

Introduction

- ❖ A patent grants an exclusive right to the inventor to make and/or sell his invention or product. Therefore, it is essential that only those inventions which satisfy the patentability criteria shall be patented.
- ❖ Opposition proceedings are structured to restrain wrongful obtaining of patents and claiming of the frivolous or petty inventions.
- ❖ Under the Indian Patent Act, 1970, there are two stages when an opposition may be filed - a pre-grant opposition or a post-grant opposition provision, depending upon the stage of the patent.
- ❖ Section 25(1) of the Patents Act, 1970, and Rule 55 of the Patents Rules, 2003, deal with the pre-grant opposition procedure in India.
- ❖ Pre-grant opposition can be filed after the publication of the patent application and before the grant of the patent.

Pre-Grant Opposition: Relevant Legal Provisions

❖ Section 25, The Patents Act, 1970 –

“Opposition to the patent.— “(1) Where an application for a patent has been published but a patent has not been granted, any person may, in writing, represent by way of opposition to the Controller against the grant of patent.....”

❖ Rule 55, The Patents Rules, 2003 –

*“Opposition to the patent.— (1) Representation for opposition under sub-section (1) of section 25 shall be filed in Form 7(A) at the appropriate office with a copy to the applicant, and shall include a statement and evidence, if any, in support of the representation and a request for hearing, **if so desired**...*

(5) On consideration of the statement and evidence filed by the applicant, the representation including the statement and evidence filed by the opponent, submissions made by the parties, and after hearing the parties, if so requested, the Controller may either reject the representation or require the complete specification and other documents to be amended to his satisfaction before the patent is granted or refuse to grant a patent on the application, by passing a speaking order to simultaneously decide on the application and the representation ordinarily within one month from the completion of above proceedings.” [Emphasis supplied]

Analysis of Section 25(1), The Patents Act, 1970

- ❖ Section 25(1) of the Indian Patent Act, 1970 lays down the law relating to pre-grant opposition in India.
- ❖ A patent application is open to pre-grant opposition, from the date of being published in the patent journal up to its grant.
- ❖ Under the said provisions, the opposition to the grant of a patent can be filed by ‘*any person*’, in writing, any time after the publication of the patent application and before it is granted. [Emphasis supplied]
- ❖ Section 25(1) clauses (a) to (k) of the Patents Act, 1970, lays down an exhaustive list of the grounds based on which the patent application can be opposed.

4

Procedure for Pre-Grant Opposition under Rule 55, The Patents Rules, 2003

- ❖ The procedure for pre-grant opposition is provided under Rule 55 of Patents Rules, 2003. As per the said rule, to initiate a Pre-Grant Opposition, the aggrieved party must submit their opposition representation to the Controller in writing.
- ❖ Upon consideration of the representation, if the Controller finds merit in the representation, the applicant (of the patent application) is notified of the same.
- ❖ Once the applicant receives the notice, he/she may file their statement and evidence, if any, in support of the patent application.
- ❖ A hearing, **if requested by the parties**, may be appointed by the Controller to decide the matter ahead. [Emphasis supplied]
- ❖ Finally, the Controller will consider the submissions made by the applicant and the opponent and decide the matter accordingly.
- ❖ If the Controller finds merit in the opposition, he/she may refuse the grant of the patent.
- ❖ On the contrary, if the Controller finds no merit in the opposition, he/she may grant the patent **directly**, or suggest some amendments and grant the patent accordingly. [Emphasis supplied]

Issues in the Pre-Grant Opposition Procedure

- ❖ Section 25(1) of the Act does not explicitly allow the the opponent to a patent application, the opportunity to be heard in a pre-grant opposition.
- ❖ The opponent has to make a request for appointment of a hearing before the Controller.
- ❖ Further, no detailed procedure regarding the conducting of a hearing has been provided under under the Act.
- ❖ The opponent's right to be heard solely depends upon the discretion of the Controller, who decides the same based upon the merit of the opposition.
- ❖ The question that arises is that whether an opposition proceeding can be completed without granting the opponent an opportunity to be heard?
- ❖ The said question was answered by the Madras High Court in the case of Indian Network for *People Living with HIV/AIDS v. Union of India*, [(2009) 3 MLJ 791] which shall be discussed further.

Relevant Case Laws

- ❖ ***Indian Network for People Living with HIV/AIDS v. Union of India [(2009) 3 MLJ 791]***
 - **Issue:** Can a patent be granted without giving a hearing to the opponent under Section 25(1) of the Patents Act, 1970 and Rule 55 of the Patents Rules, 2003?
 - **Decision:** The Division Bench of the Madras High Court first discussed the provision of Section 25(1) of the Patents Act, 1970 and Rule 55 of the Patents Rules, 2003 and observed as follows:

“A right is a legally protected interest. Therefore, when law consciously confers right on a person to object at a pre-grant stage that right must be protected in the way it has been granted, namely the right to object with a right of hearing. For a Court to dilute the said right on the basis of an interpretative process and by looking at it from a rather narrow angle, would, in our judgment, be a travesty of justice.”
 - Finally, the Court set aside the patent granted to the Petitioner and held that the Petitioner has the right to a hearing under the Patent Act and Rules.

Relevant Case Laws (Contd.)

❖ *Neon Laboratories Pvt. Ltd. v. Troikaa Pharma Limited* [2011 (45) PTC 357 (Bom)]

- **Issue:** If the person opposing the grant of a patent files his opposition and also prays that he should be heard on the amended claims as well, then, whether it is incumbent upon the authorities to grant a personal hearing to the Opponent?

- **Observations:** The Court in the present case observed that -

“the opportunity provided in Section 25(1) is not an empty formality. The Legislature in its wisdom has specifically conferred on any person a right to make representation in writing, objecting the grant of patent and that is to be made by raising specific grounds. Once the Legislature has devised such a safeguard in public interest and provided for pre-grant opposition, so also, set out the manner in which the same has to be dealt with, then, we cannot place a narrow interpretation on the said provision so as to defeat the legislative mandate.

In this context, it must be understood that the opposition under Section 25(1) is to the grant of a patent. If the opposition is raised to the grant, then, until the same is dealt with, no patent can be granted. If the original claim/application is amended, and the amendments are also opposed, then, a personal hearing to the objector on the amended claims is required to be given if specifically requested.”

Relevant Case Laws (Contd.)

- ❖ *Neon Laboratories Pvt. Ltd. v. Troikaa Pharma Limited* [2011 (45) PTC 357 (Bom)] [Contd.]
 - **Decision:** The Court held that, in this case, the Controller has not given the Petitioner any chance of hearing even though the Petitioner admittedly requested for the same. Therefore, the Petitioner's statutory right of making submissions during the hearing was denied. But the patent was granted to the Respondent by denying the Petitioner any chance to make a submission on his representation.
 - The High Court finally set aside the grant of patent and directed the Controller to give a hearing to the Petitioner with respect to the amended claims filed as well.

Relevant Case Laws (Contd.)

- ❖ **Dhaval Diyora v. Union of India [Writ Petition (L) No. 3718 of 2020, Bombay High Court, November 5, 2020]**
- In the present matter, the Court, while deliberating upon the issue whether the pre-grant opposition filed by the Petitioner is maintainable, also touched upon the mandatory nature of a hearing in the matter and observed that the Controller shall his/her decision in a pre-grant opposition proceedings after hearing the parties. The observations of the Court are as follows:

*“The Rules lays down that on consideration of the statement and evidence filed by the applicant, the representation including the statement and evidence filed by the opponent, submissions made by the parties, and **after hearing the parties**, the Controller may either reject the representation or require the complete specification and other documents to be amended to his satisfaction before the patent is granted or refuse to grant a patent on the application, by passing a speaking order. Most crucially it directs that the application and the opposition are to be to simultaneously decided...” [Emphasis supplied]*

Relevant Case Laws (Contd.)

- ❖ **Dhaval Diyora v. Union of India [Writ Petition (L) No. 3718 of 2020, Bombay High Court, November 5, 2020] [Contd.]**

“...Therefore, scheme of section 25(1) read with Rule 55 postulates that both the applications seeking patent and pre-grant opposition are to be heard by the Controller simultaneously. The language and intent are clear. There is no separate hearing on the pre-grant application. The right under section 25(1) of pre-grant opposition starts when the Patent is published and continues till the matter is decided by the Controller but no further.”

Key Takeaways

- ❖ Under Section 25(1) of the Patents Act, 1970, any person can file an opposition against a patent application before the grant of patent by the Controller.
- ❖ Rule 55 of the Patents Rules, 2003 explicitly provides for the appointment of a hearing in a pre-grant opposition proceeding, if the same is requested by the parties.
- ❖ If the Opponent requests for a hearing, the Controller shall not deny the Opponent of his right and the appointment of a hearing is mandatory in such a scenario.
- 12❖ The position of law regarding the mandatory appointment of a hearing in a pre-grant opposition is still not clear in cases where either of the parties have not requested for a hearing. In such cases, the appointment of a hearing solely depends upon the discretion of the Examiner.

THANK YOU!

Questions?

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