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WORLD INTELLECTUAL PROPERTY REVIEW

BRIC REPORT 2011



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SECTION 8: END OF HIBERNATION

Section 8 of the Patents Act, 1970, is the provision in the Indian statute that casts upon the applicant a 'duty of disclosure' to provide information on details of applications pursued in other countries. Shukadev Khurajam and Ranjna Mehta-Dutt describe how after many years in the wilderness, the section has recently increased in importance.

It may be said that the provision has served its purpose in the statute in a low-profile and non-controversial manner. Until recently, it was an almost distant country cousin with respect to the celebrated provision Section 3(d), which anyone who has an interest in Indian patent law would invariably have heard about. Much of the focus and attention on the erstwhile overlooked provision may be attributed largely due to the wave of opposition and infringement proceedings that flooded the patent landscape in India, post product patent regime. This is unsurprisingly due to the fact that non-compliance with Section 8 requirements is a ground of refusing an application or revoking a patent. This article endeavours to briefly examine court observations in recent cases that will influence the way the provision is interpreted compared to the original intent of the legislature and/or the current practice.





"SECTION 8(1)(B) REQUIRES THAT THE APPLICANT SHOULD UNDERTAKE TO KEEP THE CONTROLLER INFORMED IN WRITING, FROM TIME TO TIME, OF DETAILED PARTICULARS AS REQUIRED UNDER CLAUSE (A) IN RESPECT OF EVERY OTHER APPLICATION RELATING TO THE SAME OR SUBSTANTIALLY THE SAME INVENTION, IF ANY, FILED IN ANY COUNTRY OUTSIDE INDIA SUBSEQUENT TO THE FILING OF THE STATEMENT REFERRED TO IN CLAUSE (A)."

FORM 3
THE PATENTS ACT, 1970
[39 OF 1970]

THE PATENTS (AMENDMENT) RULES, 2006
STATEMENT & UNDERTAKING UNDER
SECTION 8
[See Section 8 and Rule 12]

I/We, _____

hereby declare:

(i) that I/We have not made any application for the same/substantially the same invention outside India.

OR

(ii) that I/We have made this application No. _____ dated _____ alone/jointly with _____, made for the same/substantially same invention application(s) for patent in the other countries, the particulars of which are given below:

Date of application	Application No.	Status of the application	Date of Publication
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(iii) that the rights in the application(s) has/have been assigned to: _____

that I/We undertake that up to the date of grant of the patent, by the Controller, I/We would keep him informed in writing the details regarding corresponding applications for patents filed outside India within six months from the date of filing of such application.

Dated this _____ day of _____, 2010.

[Signature of the Applicant(s)/Authorized Agent]

Section 8 of the Act is reproduced below:

Information on foreign applications

"(1) Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where

to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file along with this application [or subsequently [within the prescribed period as the Controller may allow]]-

- a statement setting out detailed particulars of such application; and
- an undertaking that [up to the date of grant of patent in India], he would keep the Controller informed in writing, from time to time, of [detailed particulars as required under] clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequently to the filing of the statement referred to in the aforesaid clause, within the prescribed time.

(2) At any time after an application for patent is filed in India and till the grant of a patent or refusal to grant of a patent made thereon, the Controller may also require the applicant to furnish details, as may be described, relating to the processing of the application in a country outside India, and in that even the applicant shall furnish to the Controller information available to him within such period as may be prescribed."

The corresponding rule (Rule 12) is no less important, which defines the time lines and prescribed form—Form 3 (opposite)—to comply with the requirement of Section 8.

Discussion

Section 8(1)(a) requires that the applicant should along with his application (or subsequently within the prescribed period of six months) file a statement setting out detailed particulars of applications in other countries.

Section 8(1)(b) requires that the applicant should undertake to keep the controller informed in writing, from time to time, of detailed particulars as required under clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequent to the filing of the statement referred to in clause (a).

Under Section 8(2) of the act, the applicant is under an obligation to furnish information relating to the prosecution (objections with respect to novelty and patentability, copy of granted claims, etc.) of the application within six months of the date of such communication by the patent office. The information is to be furnished only when called upon by the controller.

But precisely which foreign applications are to be submitted to the controller have not been defined

unambiguously. The phrase 'same or substantially the same invention' in Section 8 is clearly unclear in its statutory purport. The undertaking in Form 3 obligates the applicant to inform the controller about only the details of 'corresponding applications'. Interestingly, there is no definition for the phrase 'corresponding applications' in the act. By practice and general patent knowledge and understanding, an application is considered a corresponding application if it has a common priority claim.

Recent observations of the competent courts have not exactly endorsed the practice prevailing so far.

Roche v. Cipla

The Division Bench of the Delhi High Court in this case was adjudicating an appeal (filed by Roche) against the judgment of a single judge whereby the request for grant of an *ad interim* injunction to restrain Cipla from manufacturing, offering for sale, selling and exporting the generic version of Roche's drug 'Tarceva' was declined.

The High Court observed: "This made the full disclosure by the plaintiffs of all the facts pertaining not only to the 'umbrella' compound but the crystal or other forms of the product to the Controller of Patents imperative."

As will be easily appreciated, an application for a basic compound and a subsequent application for a crystal form of the compound may not share the same priority and the latter application may be filed years after the first application. This interpretation may cast a cumbersome and unfeasible duty on the applicant.

Chemtura Corporation v. Union of India

In this case, the Delhi High Court vacated the interim injunction granted in favour of Chemtura, clearly influenced by Chemtura's failure to meet its obligation under Section 8, but did clarify that the opinion formed at this pre-trial stage is *prima facie* and is not intended to influence either the final outcome of the suit or any proceedings involving the parties in any other forum including the Intellectual Property Appellate Board (IPAB).

The court made an observation on the phrase 'time to time' appearing in Section 8(1)(b) stating: "The expression 'time to time' meant a periodicity of furnishing information akin to updating the Controller on the current status of the applications filed in other countries."

Recapitulating Section 8(1)(b) *supra*, it is apparent that the phrase 'time to time' does not

connote an obligation on the applicant to provide updated information on the status of applications that have been filed earlier. Rather, it pertains to a simple undertaking by the applicant to keep the controller informed of details of new applications filed from time to time, subsequent to the filing of the application in India. Patent office practice may have already embraced this almost obtuse observation.

Conclusion

The observations made by the competent courts have less than thrown light on an otherwise simple provision that has been largely ignored in the past. With the relentless fervour of opponents wielding this unseemly *Brahmastra* (divine weapon) in opposition and revocation battles dotting the Indian patent landscape, it will not be a surprise to see instances of legitimate patent applications and patents being refused or revoked on grounds of non-compliance with Section 8, albeit with doubt over the veracity of the final order. Section 8 is doubtless going to cause more controversy.

Shukadev Khurajam is a consultant at Remfry & Sagar. He can be contacted at: remfry-sagar@remfry.com



Shukadev Khurajam holds bachelor of sciences and law degrees from the University of Delhi. He is also a patent attorney and has experience in various facets of patent practice, prosecution, opposition and litigation. He has handled high-profile litigation matters before the competent authorities.

Ranjna Mehta-Dutt is a partner at Remfry & Sagar. She can be contacted at: remfry-sagar@remfry.com



Ranjna Mehta-Dutt has been in the legal profession since 1992 and in the field of intellectual property rights for 15 years. She has a bachelor of sciences in biology and chemistry and holds master in law degrees. She has experience in drafting patent specification and handling patent applications in fields of technology such as chemistry, biotechnology and pharmaceuticals. She has been invited by various institutes to deliver lectures on IP laws.

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