

Demystifying India's Patent Regime



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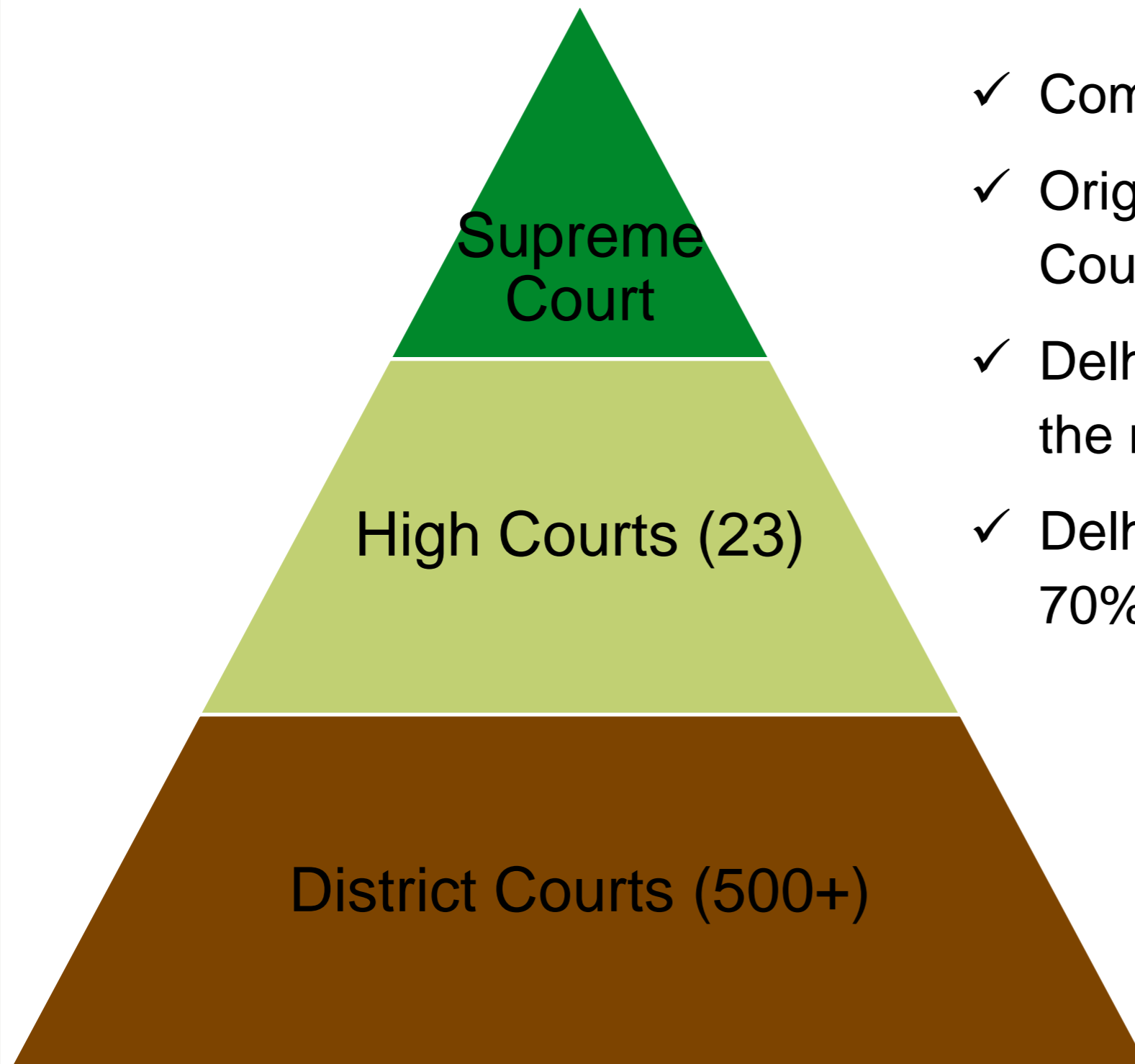
BRICS IP FORUM

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AGENDA

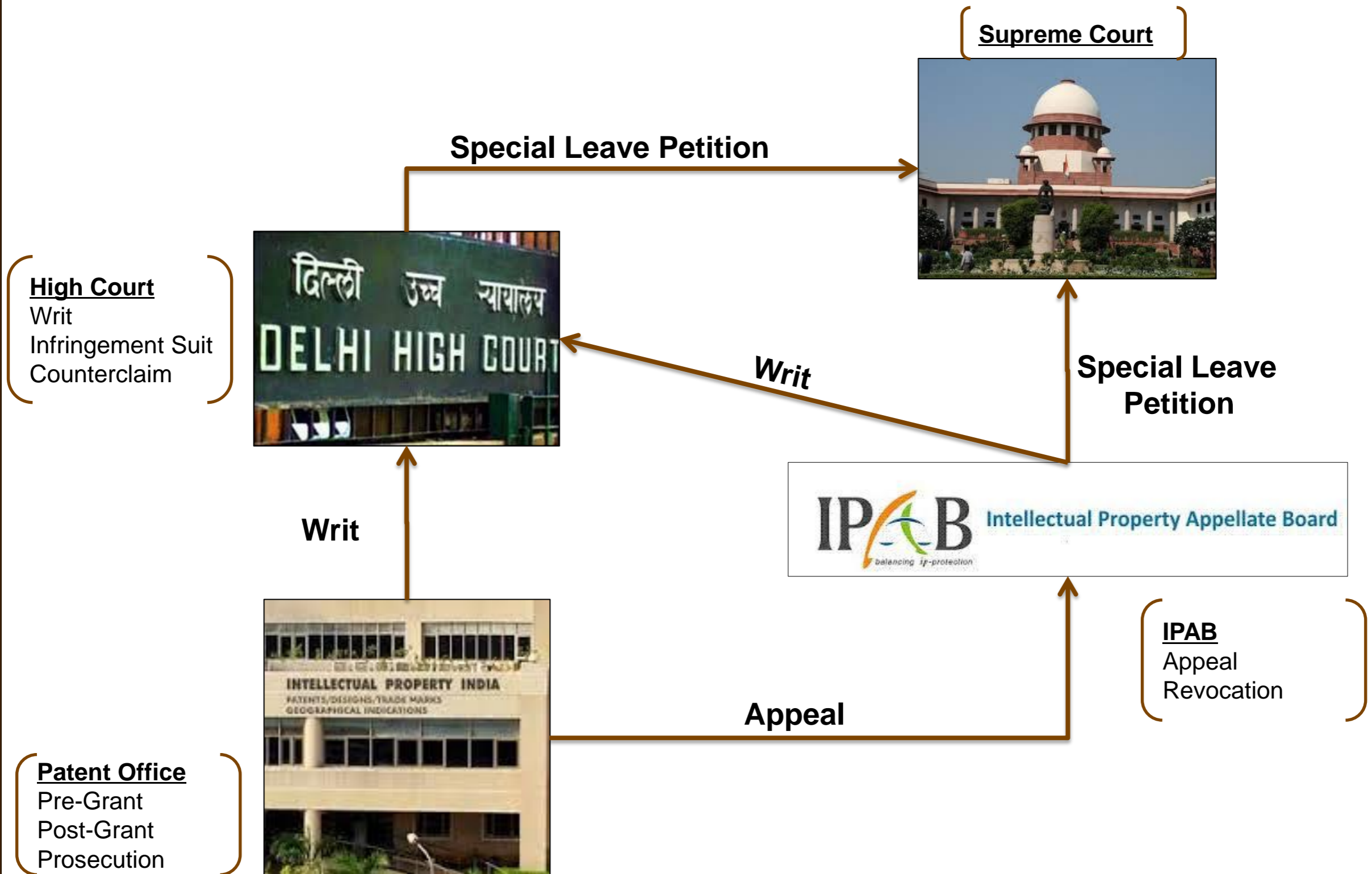
- ❑ A Snapshot of India's Enforcement System
- ❑ Recent Decisions Impacting Patent Prosecution
 - ✓ Proof of Right
 - ✓ Section 8 Reporting
- ❑ The Litigation Landscape
 - ✓ Lay of The Land
 - ✓ FRAND is Here.....

INDIA – LEGAL SYSTEM

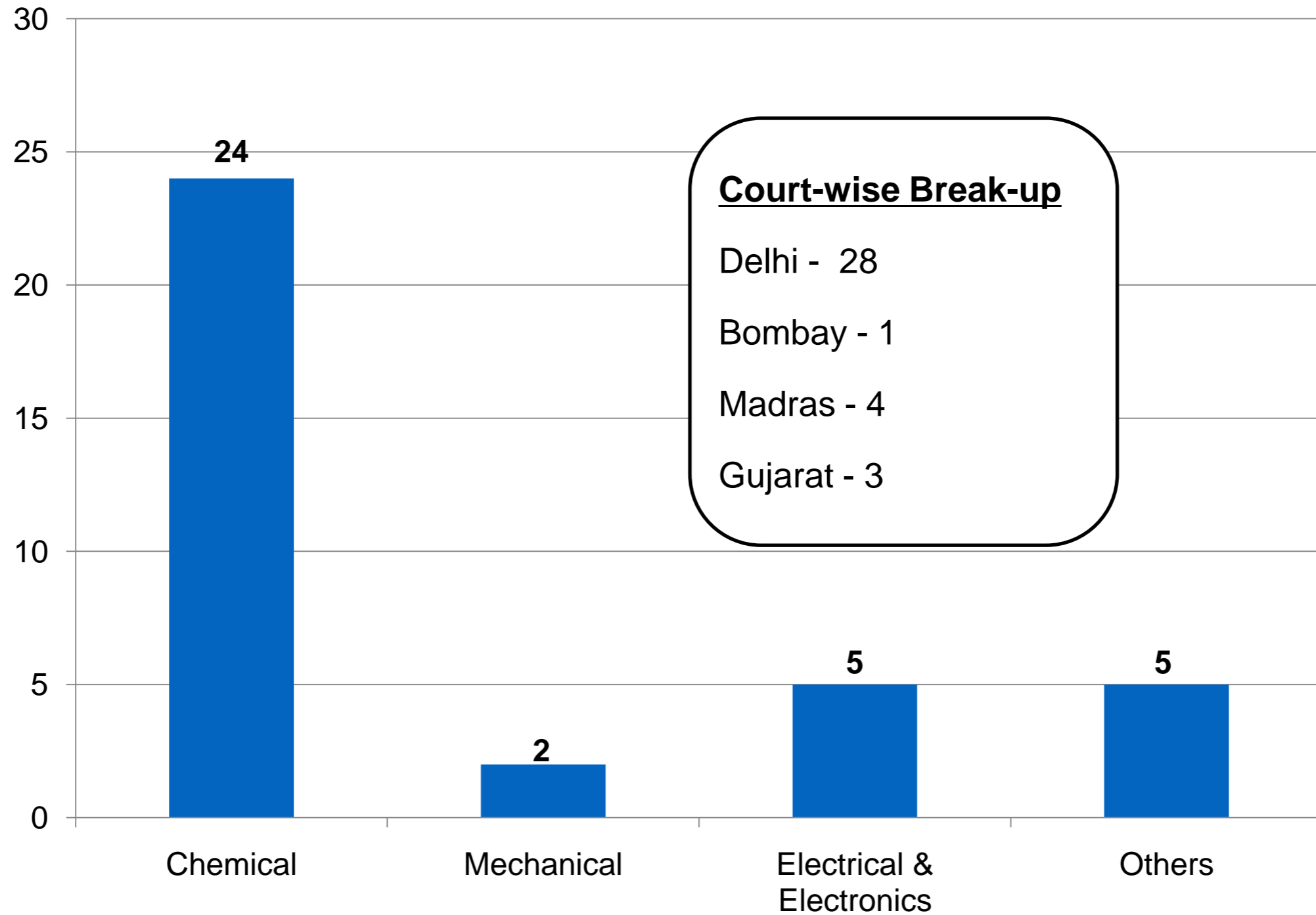


- ✓ Common Law Jurisdiction
- ✓ Original Jurisdiction with 6 High Courts
- ✓ Delhi, Bombay and Madras are the most popular and/or important
- ✓ Delhi High Court handles approx. 70% of all IP contentious matters

IP COURTS AND TRIBUNALS



2013 – 2014 HIGH COURT ACTIVITY



PATENT PROSECUTION - RECENT DECISIONS

1. Proof of Right requirement
2. Section 8 Details

PROOF OF RIGHT




What is it?

Evidence of the right of the Applicant to the invention.

Why is it important?

Non-compliance is **a** ground for revocation of the patent.

PROOF OF RIGHT



Previous Practice:

- No proof of right to be established if applicant in India is same as applicant in the priority convention country
- *Rationale* - Applicant deemed entitled to rights in the application in India

Recent Development:

- ***NTT Docomo Vs Controller of Patents & Designs, IPAB (2013)***
- Held it is mandatory to furnish proof of right
- Applicant directed to submit proof of right
- Applicant filed the proof of right along with petition under Rule 137 – Patent granted

Our Advice:

- Should be filed within six months of filing date **OR** upon communication from the Controller
- Relevant document(s):
 - Executed Form 1
 - Deed of assignment
 - Form PCT IB 371 (only for PCT applications)

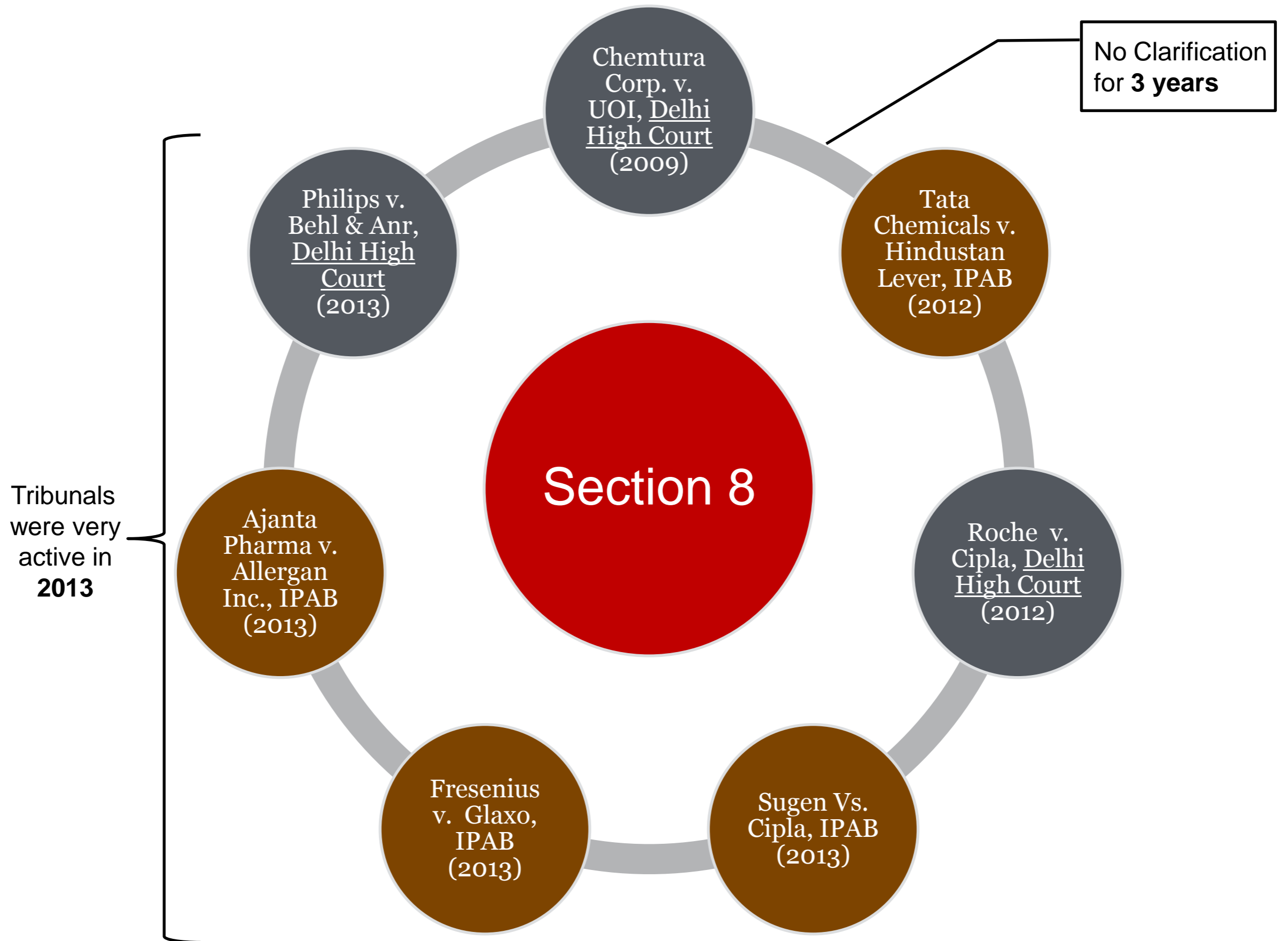
Section 8

What is it?

India's reporting requirement.

Why is it important?

Non-compliance is **a** ground for revocation of the patent.



SECTION 8 – THEN AND NOW...

2009

- ❑ *prima facie* challenge to validity of patent due to non-compliance of Section 8 requirement is grounds for denial of interim injunction. *Chemtura, 2009*

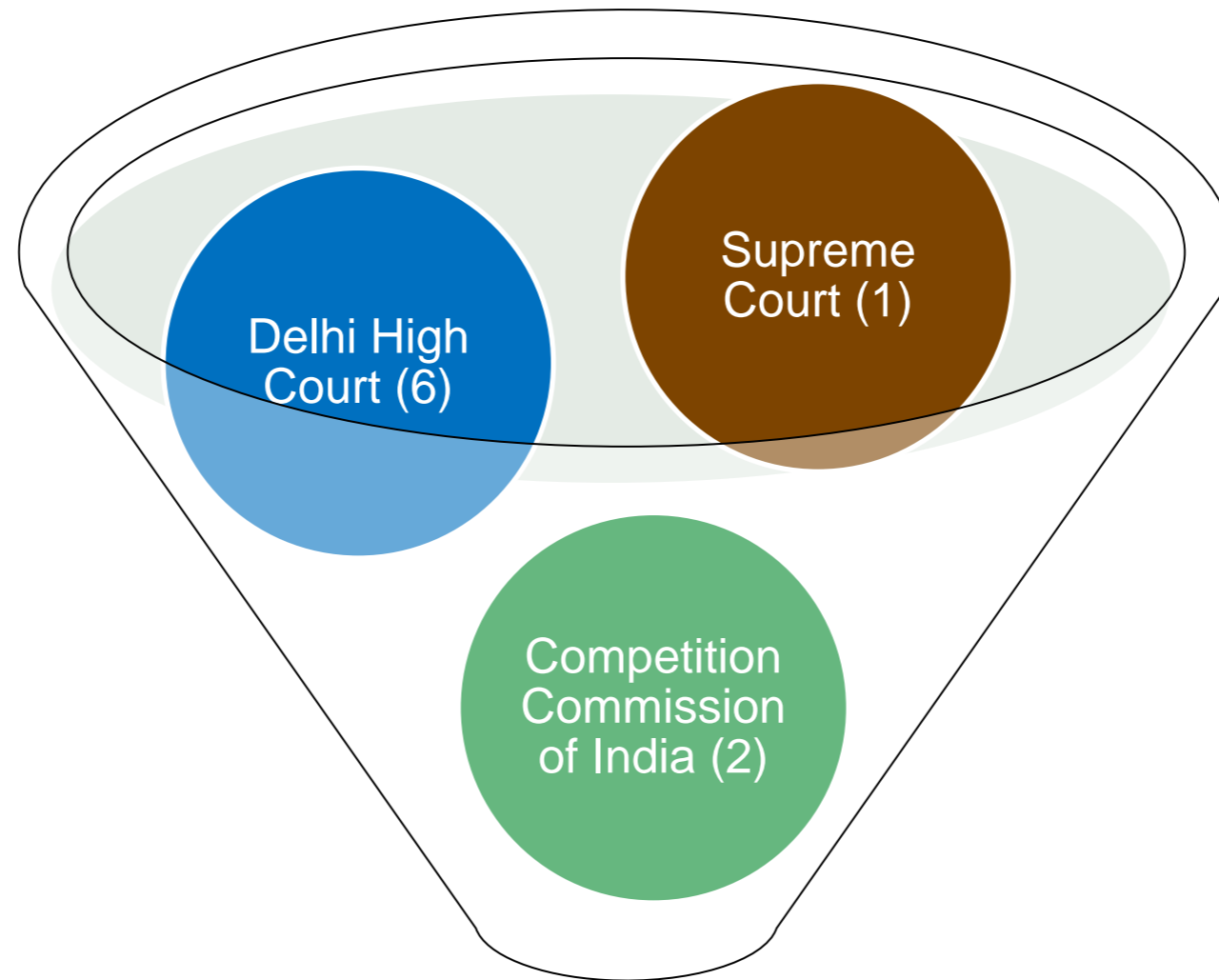
2012

- ❑ “processing” in Section 8(2) is an all encompassing word and includes all the steps taken to obtain a patent – no detail is less important than the other. *Tata Chemicals, 2012*
- ❑ compliance of Section 8 (1) requires filing details pertaining to application relating to same or substantially the same invention. *Roche, 2012*

2013

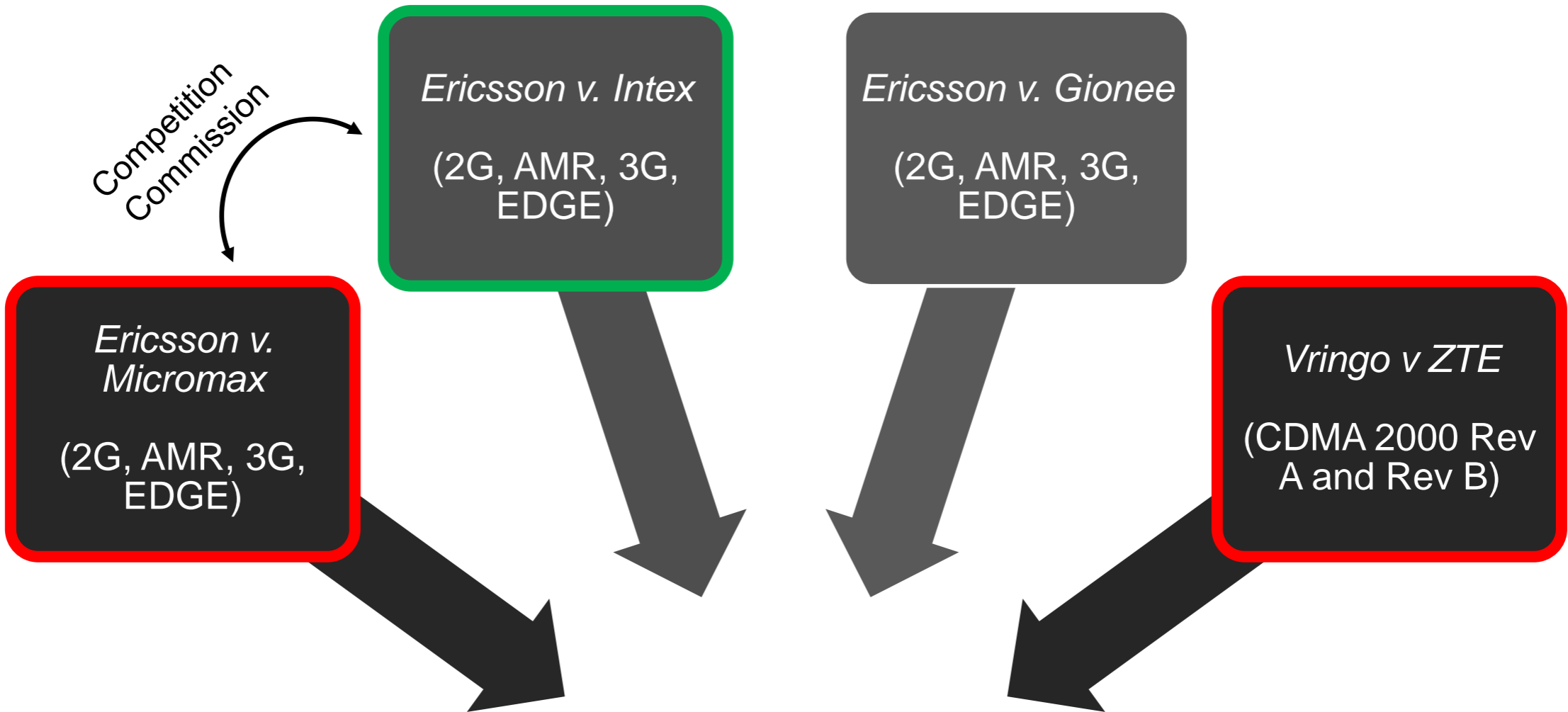
- ❑ patentee (and patent office) cannot take a stand that all details were freely available online as compliance is statutory. *Sugen, 2013*
- ❑ challenger must identify documents not submitted by patentee under Section 8(2) and the relevance thereof to the proceedings. *Fresenius, 2013*
- ❑ challenger will need to establish *materiality* and *intent* which is an issue for trial. *Philips, 2013*

LIFE AFTER *NOVARTIS* AND *BAYER*



FRAND Wars In India

Competition
Commission



FRAND Wars in India

Ericsson v. Kingtech
(AMR)

Vringo v AsusTEK
(GSM, DECT)

TAKEAWAYS FROM THE FRAND BATTLES

- ❑ Deposit of payments as per interim royalty rates is permissible during pendency of litigation. *Ericsson v. Micromax*
- ❑ There is a *prima facie* a substantial question of jurisdiction of the Competition Commission of India (CCI) to investigate actions of a patentee in SEP litigation. *Ericsson v. Micromax*
- ❑ Depending on outcome of point 2 - a complaint before the CCI alleging abuse of dominant position is available as an alternative defense. *Ericsson v. Intex; Ericsson v. Micromax*
- ❑ Expert evidence filed along with the suit documents may not be persuasive for want of relevant technical experience of the expert. *Vringo v. ZTE*

THE ROAD AHEAD....

- ❑ More IP savvy courts in India OR IP focussed benches/judges
- ❑ Settling the ambiguity in interpretation of critical provisions of Patent Law
- ❑ Consistency (proper guidance) in the test for granting *patents*
- ❑ The legal position pertaining to the jurisdiction of the CCI with respect to Patent rights



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