* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

% **Judgment reserved on: 10 October 2023**
Written Submissions filed on: 20 October 2023
Judgment pronounced on: 09 January 2024

\+ LPA 50/2023

NOVARTIS AG ..... Appellant

Through: Mr. Hemant Singh, Ms. Mamta Rani Jha, Mr. Siddhant Sharma, Mr. Abhay Tandon and Ms. Garima Mehta, Advs.

versus

NATCO PHARMA LIMITED & ANR. ..... Respondents

Through: Mr. J. Sai Deepak, Mr. Guruswamy Nataraj, Mr. Shashikant Yadav and Mr. Rahul Bhujbal, Advs. for R-1.

Mr. Harish Vaidyanathan Shankar, CGSC along with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat, Mr. Alexander Mathai Paikaday, Mr. M. Sriram and Mr. Krishnan V., Advs. for R-2.

Ms. Rajeshwari H., Mr. Tahir A.J., Ms. Raj Latha Kotni and Mr. Anirudh Ramanathan, Advs. for Interveners- Dr. Charanjit Kumar Sehgal and Dr. Kanchan Kohli.

Mr. Rajiv Nayar, Sr. Adv. with Ms. Bitika Sharma, Ms. Vrinda Pathak, Mr. George Vithayathil and Mr. Manjunathan, Advs. for

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Intervener- Indian Pharmaceutical Alliance.

CORAM:
HON'BLE MR. JUSTICE YASHWANT VARMA
HON'BLE MR. JUSTICE DHARMESH SHARMA

J U D G M E N T

YASHWANT VARMA, J.

S. No.	Particulars	Paragraph Nos.
A.	PREFACE	1-3
B.	ESSENTIAL FACTS	4-10
C.	THE STATUTORY PROVISIONS-PRE AND POST AMENDMENT	11
D.	CONTENTIONS OF NOVARTIS	12-33
E.	NATCO'S SUBMISSIONS	34-42
F.	STAND OF INDIAN PHARMACEUTICAL ALLIANCE	43-52
G.	THE OPPOSITION BY DR. KANCHAN KOHLI	53-54
H.	IMPACT OF AMENDED SECTION 57	55-57
I.	THE EXAMINATION PROCESS	58-66
J.	OPPOSITION PROCEEDINGS	67-69
K.	AMENDMENT OF THE PATENT APPLICATION	70-75
L.	FACETS OF PRE GRANT OPPOSITION	76-92

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

M.	THE HEARING UNDER RULE 55	93-96
N.	THE NATURAL JUSTICE PRINCIPLES	97-100
O.	THE RIGHTS OF AN OPPONENT-A GLOBAL PERSPECTIVE	101-113
P.	THE IMPORT OF SECTION 57	114-117
Q.	BALANCING OF INTERESTS	118-122
R.	THE IMPUGNED JUDGMENT-A BRIEF CRITIQUE	123-127
S.	CONCLUSIONS	128
T.	OPERATIVE DIRECTIONS	129

A. PREFACE

1. The present Letters Patent Appeal raises the important question of the extent of engagement of a pre-grant opponent under the **Patents Act, 1970**[1] in the course of proceedings initiated by the Controller requiring the applicant for a patent to amend or modify the application, the complete specifications thereof or any other related document.

2. **NATCO Pharma Limited**[2], the original writ petitioner, had assailed the order of the **Controller of Patents**[3] dated 14 December 2022 in terms of which certain amendments in **Indian Patent Application No. IN414518**[4] filed by the appellant as directed were allowed on the ground that the said order came to be passed without

[1] Act
[2] NATCO
[3] Controller
[4] IN'518

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19:08:38

NATCO being afforded an opportunity of hearing.

3. The submission essentially appears to have been that a pre-grant opponent would have the right to represent against both voluntary amendments as well as those that may be directed by the Controller. According to NATCO**,** the consideration of the application alongside the representations of opposition are not liable to be viewed as operating in separate silos. The proceedings, according to NATCO, clearly merge and thus obligating the Controller to place all pre-grant opponents on notice of any amendments that may be directed by it. It is the aforenoted submissions and the view so canvassed which has been accepted by the learned Single Judge leading to the institution of the present appeal.

B. ESSENTIAL FACTS

4. In order to examine the backdrop in which the matter came to be placed before the learned Single Judge, we deem it opposite to take note of the following important events as set out in the Written Note of Submissions tendered on behalf of the appellant: -

"Date	**Events**
08.11.2006	The subject patent IN'518, originated from PCT application no. PCT/US2006/043710 dated 08.11.2006, which was filed as Indian national phase application bearing no. 4412/DELNP/2007 on 08.06.2007 before the Controller of Patents (Respondent No. 2).
24.08.2007	The application was published inviting pre-grant oppositions. The application was examined under Sections 12 and 13 vide a First Examination Report

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Signing Date:09.01.2024
19:08:38

	(FER) dated 30.01.2015.
27.05.2016	The Appellant was granted Section 14 hearing on 27.05.2016 vide a Notice of Hearing dated 06.05.2016. However, before any order could be passed by the Controller on the examination and the hearing pursuant thereto, first PGO was filed by Indian Pharmaceutical Alliance (IPA) on 26.05.2016.
06.09.2016	The 2nd PGO was filed by Respondent No. 1 (NATCO).
23.08.2017	The 3rd PGO was filed by Kumar Sushobhan.
13.06.2019	The 4th PGO was filed by Dr. Reddy.
06.12.2019	1st Notice of hearing in relation to 1st to 4th PGO was issued for hearing scheduled on 08th – 13th January 2020 [Adjourned at request of one of the opponents].
14.02.2020	2nd Notice of hearing in relation 1st to 4th PGO was issued for hearing scheduled on 16th – 19th March 2020.
25.02.2020	5th PGO filed by Hiren Darji [In view of 5th PGO, scheduled hearing of 16th – 19th March 2020 was adjourned, and notice dated 26.02.2020 issued on 5th PGO].
17.09.2020	3rd Notice of hearing in relation 1st to 5th PGO was issued for hearing scheduled on 26th – 30th October 2020 [adjourned at request of Respondent No. 1 (NATCO)].
18.09.2020	6th PGO filed by G. Srinivasa Rao.
03.02.2021	IPAB vide order dated 03.02.2021 in OA/1/2021/PT/DEL directed Controller to dispose of all the oppositions within three months.
08.04.2021	4th Notice of hearing in relation 1st to 6th PGO was issued for hearing scheduled on 12th – 19th May 2021.
07.05.2021	NATCO filed an application requesting cross – examination of Novartis experts on their affidavits five days before the scheduled hearing.

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Signing Date:09.01.2024
19:08:38

12th to 19th May 2021	Hearings held on 1st to 6th PGOs, and order reserved by the Controller.
16.09.2021	Order passed by the Controller rejecting NATCO's request for cross-examination. Writ bearing no. WP (C)-IPD 91/2021 filed by NATCO on 27.09.2021 challenging the said order.
20.05.2022	7th PGO filed by Dr. Charanjit Kumar Sehgal.
12.07.2022	Judgment passed by this Hon'ble Court in NATCO's writ W.P. (C)-IPD 91/2021 granting NATCO permission to file rebuttal evidence and directing Controller to hear NATCO on 05.09.2022 and dispose of all PGOs by 15.11.2022.
26.08.2022	5th Notice of hearing in relation to 7th PGO was issued for hearing scheduled on 07.09.2022.
02.09.2022	8th PGO filed by Dr. Ketakee S. Durvee.
05.09.2022	Second hearing granted to NATCO, and order reserved by the Controller.
07.09.2022	Hearing held in 7th PGO, and order reserved by the Controller.
21.10.2022 & 31.10.2022	6th Notice of hearing in relation to 8th PGO was issued for hearing scheduled on 03.11.2022.
03.11.2022	Hearing held in 8th PGO, and order reserved by the Controller – 9th PGO filed by Mrs. Hemavathi R.
04.11.2022	10th PGO filed by Dr. Kanchan Kohli"

5. As would be manifest from the seminal events leading up to the grant of the patent, hearing on all **Pre-Grant Oppositions**[5] were concluded on 03 November 2022. The Controller is stated to have framed directions for the appellant to carry out amendments in the

[5] PGOs'

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19:08:38

patent application in terms of a Notice dated 25 November 2022. The appellant acceded to that directive and submitted amended claims on 05 December 2022. In the hearing which ensued before the Controller, the appellant agreed to amend Claim 4 and reword Claim 5 and consequently the patent came to be granted on 14 December 2022.

6. Apart from the sequence of events which have been alluded to hereinabove, for the completeness of the record we take note of the following additional facts. Aggrieved by the inordinate delay caused in the conclusion of the PGO proceedings and the repeated adjournments which beset the same, the appellant approached the **Intellectual Property Appellate Board**[6] for appropriate directions being issued to the Patent Office for expeditious consideration of its application. The IPAB in terms of an order dated 03 February 2021 directed the Patent Office to take up all objections serially and dispose of the same with expedition. Soon thereafter and more particularly on 07 May 2021, NATCO moved an application seeking an opportunity to cross examine the experts of the appellant whose affidavits were being relied upon in support of the patent application. The Controller without ruling upon the same proceeded to take up the PGOs' and commenced a hearing which ensued between 13 to 18 May 2021. This led to NATCO approaching this Court by way of W.P. (C) 5558 of 2021 which came to be disposed of by a learned Single Judge on 27 May 2021 with the following operative directions: -

> *"**8**. The writ petition is therefore disposed of with the following*

[6] IPAB

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19:08:38

directions, with the consent of learned counsel:
a) ***The Controller is directed to dispose of the application dated 07.05.2021 filed by Natco for cross-examination of the expert witnesses cited by Novartis, expeditiously and preferably within two weeks from today. In the event the Controller considers it necessary, further hearing may be granted to the parties for this purpose.***
b) ***In the event the aforesaid application is decided against Natco, the final decision of Novartis' patent application not be pronounced for a period of 10 days after communication of the order to Natco.***
c) In the event the application is decided in favour of Natco, the matter be fixed for cross examination after hearing learned counsel for the parties with regard to the schedule and modalities for the cross-examination. The Controller will take the submissions into account and pass appropriate orders, in accordance with law.
d) With regard to other pending interlocutory applications referred to by Mr. Grover, I find that the present petition does not concern any other application. However, in order to expedite the final disposal of the patent application, the parties are at liberty to make their submissions before the Controller in this regard, who will pass appropriate orders.
e) After the consideration of the aforesaid application and disposal thereof, the Controller will also endeavour to dispose of the patent application filed by Novartis, as expeditiously as possible and practicable.
f) Learned counsel for the parties assure the Court that their clients will cooperate in the expeditious implementation of the aforesaid directions, and disposal of the proceedings before the Controller."

7. It becomes pertinent to note that at the time when the aforesaid writ petition came to be disposed of, the Controller had not passed any final orders on the patent application or on the PGOs' which had been filed. On 16 September 2021, the Controller proceeded to reject the application of NATCO for cross examination. This led to NATCO petitioning this Court again by way of W.P. (C)-IPD 91 of 2021. The said writ petition was disposed of finally on 12 July 2022. While emphasizing on the imperative of the PGO process being concluded

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19:08:38

systematically and with expedition, the learned Judge observed as under: -

> "**16.** Heard ld. counsels for the parties. The chronology of events, in the present writ, clearly shows that the proceedings in the patent application and the pre-grant opposition have been delayed substantially. Blame for the delay cannot be attributed to any one factor or reason, but in the opinion of this Court both parties are to blame. On the one hand, the applicant continues to amend its claims from time to time over a period of five years between 2016 to 2021. On the other hand, the patent application has been exposed to multiple oppositions by several parties due to delay in the examination process. In the opinion of this Court, there ought to be a systematic manner in which proceedings in pre-grant oppositions are conducted. Repeated filing of pre-grant oppositions due to non-existence of any time limits for filing a pre grant opposition and delay in adjudication of one pre-grant opposition, usually results in further pre-grant oppositions being filed leading to further delays in grant of patent. The patent application has the chance of being caught up in the swirl of pre-grant oppositions by Opponents. Amendments by the Applicant who gets wiser with each objection being taken, leads to further delays.
>
> **17**. It is the settled position in law, as held in ***M/s UCB Farchim SA v. M/s Cipla Ltd. [W.P.(C) No. 332/2010 order dated 08th February, 2010]*** that a pre-grant opposition proceeding is in aid of the examination of the patent application. The relevant part of this judgment is set out below:
>
>> ***"Distinction between pre-grant and post-grant opposition***
>> *13. In the first instance a distinction has to be drawn between a pre-grant opposition and a post-grant opposition. <u>While a pre-grant opposition can be filed under Section 25 (1) of the Patents Act at any time after the publication of the patent application but before the grant of a patent, a post-grant opposition under Section 25(2) of the Patents Act has to be filed before the expiry of one year from the date of the publication of the grant of patent. A second significant difference, after the amendment of 2005, is that a pregrant opposition can be filed by 'any person' whereas a post-grant opposition under</u>*

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19:08:38

Section 25(2) can be filed only by 'any person interested'. It may be noticed that the application for revocation of a patent in terms of Section 64 of the Patents Act can also to be filed only by 'any person interested'. In other words, the post-grant opposition and the application for revocation cannot be filed by just about any person who is not shown to be a person who is 'interested'. A third significant difference is that the representation at the stage of pre-grant is considered by the Controller himself. Rule 55 of the Patents Rules requires the Controller to consider the 'statement and evidence filed by the applicant' and thereafter either refuse to grant the patent or require the complete specification to be amended to his satisfaction. Of course, in that event notice will be given to the applicant for grant of patent who can file his reply and evidence. ***This Court finds merit in the contention that the pre-grant opposition is in fact 'in aid of the examination' of the patent application by the Controller****. The procedure is however different aspect as far as the post-grant opposition is concerned. There in terms of Section 25 (3), the Controller has to constitute an Opposition Board consisting of such officers as he may determine and refer to such Opposition Board the notice of opposition along with other documents for its examination and recommendations. After receiving the recommendations of the Opposition Board, the Controller gives the patentee and the opponent an opportunity of being heard. The Controller then takes a decision to maintain, amend or revoke the patent. The fourth major difference between the pre-grant and the post-grant opposition is that while in terms of Section 117 A an appeal to the IPAB is maintainable against the order of the Controller in a post-grant opposition under Section 25(4) of the Patents Act, an appeal has not been expressly been made available against an order made under Section 25(1) of the Patents Act."*

18. The language used in Section 25(1) of the Act is in contrast with the language used in Section 25(2) of the Act. A pre-grant opposition is a `representation by way of opposition' in writing by "any

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19:08:38

person". Whereas, Section 25(2) of the Act is a `notice of opposition' by "any person interested". A Representation under Section 25(1) of the Act does not strictly follow the norms laid down under the Code of Civil Procedure. However, since Rule 55(4) of the Rules contemplates filing a reply statement and evidence, if the applicant wishes to, it can be said that the proceedings is adjudicatory as the same is adversarial in nature."

8. However, insofar as amendments to the patent application and the rights of an opponent in the examination process, the learned Judge significantly observed thus: -

"**19.** The proceeding in a pre-grant opposition and simultaneous examination of a patent application, however, cannot also result in a situation where the pre grant opponent is kept in dark about the developments taking place in the examination process. For example, when amendments are filed by the Applicant, an immediate decision ought to be taken on allowing or disallowing the amendment so that there is transparency and clarity as to what are the claims being considered by the Controller. A short and brief order should be passed in respect of the amendments which should be uploaded on the website of the Patent Office so that everyone concerned would know the decision on the amendment. In any event, if an amendment is being carried out during the pendency of a pre-grant opposition, the ruling on the amendment ought to be sent to the pre-grant opponent as well. Sometime amendments are carried out during the course of hearings across the table as well, when the patent agent of the Applicant attends the hearing before the Controller. In such a scenario, the Controller ought to examine the said amendments and convey the decision to the Applicant, and if the Opponent is present, even to the Opponent."

9. The writ petition was ultimately disposed of in the following terms: -

"**21.** The Applicant justifies filing of the expert's affidavit on the ground that the Opponent had filed certain additional documents. Be that as it may, the fact is that three substantive affidavits have been filed by the Applicant along with an amended set of claims on 6th June, 2021. Rulings on the amendment are yet to be issued by the Patent Office. Thus, in the opinion of the Court, an opportunity

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19:08:38

ought to be granted to the Opponent to rebut the evidence of the Applicant. The Opponent- Natco has agreed to not insist on its prayer seeking cross examination of Applicant's witnesses- Dr. Michael Motto, Dr. Allan S. Myerson and Dr. Gauri Billa, if it is given an opportunity to file affidavits of its own experts in rebuttal. The said arrangement is not objected to by the Applicant. In the above background, and in order to expedite the decision on the application and the pre-grant opposition, the following directions are issued:

i) the Opponent is permitted to file affidavits of its own experts in rebuttal to the three expert affidavits filed by the Applicant, within a period of four weeks.
ii) If any documents are filed by the Opponent along with the said expert affidavits, the same shall be dealt with by the Applicant by way of additional written submissions within one week thereafter, without any further documents being filed by the Applicant.
iii) The Opponent is also permitted to file its additional written submissions within two weeks after filing of additional written submissions by the Applicant. The written submissions filed by both the parties shall be considered by the Controller for final decision in the pre-grant opposition;
iv) Parties shall appear before the Patent Office on 12th September, 2022 at 2:30 p.m. Both the Applicant and the Opponent shall be given one hour each to make their submissions.
v) The situation as it exists today is that there has been no ruling on any of the amendments which have been filed by the Applicant. Thus, before the commencement of oral hearing in the pre-grant opposition, the Controller shall communicate orally to both the parties as to which of the amendments are being allowed and which would be the final set of claims which is being considered for grant.
vi) On the said date, after hearing the parties for one hour each, the final decision on the application/pre-grant opposition shall be given by the Patent Office on or before 15th November, 2022. The final decision rendered shall be communicated to all the parties and shall also be uploaded on the website of the Patent Office;
vii) It is clarified that the hearing of any other opposition proceeding which has already concluded is not being re-opened by this Court;"

10. Of equal significance was the caveat which stood entered in para 22 of that order and the same is extracted hereinbelow: -

"**22.** The observations made in respect of amendments in the present

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Signing Date:09.01.2024
19:08:38

order shall not be applicable to amendments directed by the Controller under Section 15 of the Act."

C. THE STATUTORY PROVISIONS- PRE AND POST AMENDMENT

11. Before proceeding to notice the rival submissions, which were addressed and for the purposes of rendering a context to the same, we deem it appropriate to set out some of the relevant provisions which would have a bearing on the issues raised. For the purposes of elucidation, we extract the provisions of Sections 25, 57 and 117A of the Act as they underwent significant changes in terms of amendments introduced from time to time: -

Section 25 of the Patents Act, 1970

Section 25 as enacted	**Section 25 as amended by the 2002 Amendment Act**	**Section 25 as amended by the 2005 Amendment Act**	**Section 25 as it stands now.**
25. Opposition to grant of patent. — (1) At any time within four: months from the date of advertisement of the acceptance of a complete specification under this Act (or within such further period not exceeding one month in the aggregate as the Controller may allow on application made to him in the prescribed manner before the expiry of the four months aforesaid) any	**25. Opposition to grant of patent**. — (1) At any time within four: months from the date of advertisement of the acceptance of a complete specification under this Act (or within such further period not exceeding one month in the aggregate as the Controller may allow on application made to him in the	**25. 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 on the ground— (*a*) that the applicant for the patent or the person under or through whom he	**25. 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 on the ground— (*a*) that the applicant for the patent or the

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person interested may give notice to the Controller of opposition to the grant of the patent on any of the following grounds, namely: - (a) that the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims; (b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim; (i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; (ii) in India or elsewhere, in any other document: Provided that the ground specific in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 29; (c) that the invention so	prescribed manner before the expiry of the four months aforesaid) any person interested may give notice to the Controller of opposition to the grant of the patent on any of the following grounds, namely: - (a) that the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims; (b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim; (i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; (ii) in India or elsewhere, in any	claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims; (*b*) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim— (*i*) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or (*ii*) in India or elsewhere, in any other document: Provided that the ground specified in sub-clause (*ii*) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of Section 29; (*c*) that the invention so far as claimed in any claim of the complete specification is claimed in a claim	person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims; (*b*) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim— (*i*) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or (*ii*) in India or elsewhere, in any other document: Provided that the ground specified in sub-clause (*ii*) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or

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19:08:38

far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant's claim; (d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim. *Explanation*-For the purposes of this clause, an invention relating to a process for which a patent is claimed shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only; (e) that the invention so far as claimed in any claim of the complete	other document: Provided that the ground specific in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 29; (c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant's claim; (d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the	of a complete specification published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant's claim; (*d*) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim. *Explanation*.—For the purposes of this clause, an invention relating to a process for which a patent is claimed shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or	sub-section (3) of Section 29; (*c*) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant's claim; (*d*) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim. *Explanation*.—For the purposes of this clause, an invention relating to a process for which a patent is claimed shall be deemed to have

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19:08:38

specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the applicant's claim; (f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act; (g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed; (h) that the applicant has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge; (i) that in the case of a convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a	priority date of that claim. *Explanation*-For the purposes of this clause, an invention relating to a process for which a patent is claimed shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only; (e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the	experiment only; (*e*) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (*b*) or having regard to what was used in India before the priority date of the applicant's claim; (*f*) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act; (*g*) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed; (*h*) that the applicant has failed to disclose to the Controller the information required by Section 8 or has furnished the information which in any material particular was false to his knowledge; (*i*) that in the case of	been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only; (*e*) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (*b*) or having regard to what was used in India before the priority date of the applicant's claim; (*f*) that the subject of any claim of the complete specification is not an invention within the

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19:08:38

person from whom he derives title, but on no other ground. (2). Where any such notice of opposition is duly given, the Controller shall notify the applicant and shall give to the applicant and the opponent an opportunity to be heard before deciding the case. (3) The grant of a patent shall not be refused on the ground stated in clause (e) of sub-section (1) if no patent has been granted in pursuance of the application mentioned in that clause; and for the purpose of any inquiry under clause (d) or clause (e) of that sub-section, no account shall be taken of any secret use.	priority date of the applicant's claim; (f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act; (g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed; (h) that the applicant has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge; (i) that in the case of a convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a	convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title; (*j*) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention; (*k*) that the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere, but on no other ground and the Controller shall, if requested by such person for being heard, hear him and dispose of such representation in such manner and	meaning of this Act, or is not patentable under this Act; (*g*) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed; (*h*) that the applicant has failed to disclose to the Controller the information required by Section 8 or has furnished the information which in any material particular was false to his knowledge; (*i*) that in the case of convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

	person from whom he derives title, but on no other ground. (j) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention; (k) that the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere (2). Where any such notice of opposition is duly given, the Controller shall notify the applicant and may, if so desired, give to the applicant and the opponent an opportunity to be heard before deciding the case. (3) The grant of a patent shall not be	within such period as may be prescribed. (2) At any time after the grant of patent but before the expiry of a period of one year from the date of publication of grant of a patent, any person interested may give notice of opposition to the Controller in the prescribed manner on any of the following grounds, namely: — (*a*) that the patentee or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims; (*b*) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim— (*i*) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or	title; (*j*) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention; (*k*) that the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere, but on no other ground and the Controller shall, if requested by such person for being heard, hear him and dispose of such representation in such manner and within such period as may be prescribed. (2) At any time after the grant of

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

	refused on the ground stated in clause (e) of sub-section (1) if no patent has been granted in pursuance of the application mentioned in that clause; and for the purpose of any inquiry under clause (d) or clause (e) of that sub-section, no account shall be taken of any personal document or secret trial or secret use.	(*ii*) in India or elsewhere, in any other document: Provided that the ground specified in sub-clause (*ii*) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of Section 29; (*c*) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the claim of the patentee and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the claim of the patentee; (*d*) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that	patent but before the expiry of a period of one year from the date of publication of grant of a patent, any person interested may give notice of opposition to the Controller in the prescribed manner on any of the following grounds, namely:— (*a*) that the patentee or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims; (*b*) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim— (*i*) in any specification filed in pursuance of an application for a patent made in

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

		claim. *Explanation*.—For the purposes of this clause, an invention relating to a process for which a patent is granted shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only; (*e*) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (*b*) or having regard to what was used in India before the priority date of the claim; (*f*) that the subject of any claim of the complete specification is not an invention within the meaning of this	India on or after the 1st day of January, 1912; or (*ii*) in India or elsewhere, in any other document: Provided that the ground specified in sub-clause (*ii*) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of Section 29; (*c*) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the claim of the patentee and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the claim of the patentee;

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

		Act, or is not patentable under this Act; (*g*) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed; (*h*) that the patentee has failed to disclose to the Controller the information required by Section 8 or has furnished the information which in any material particular was false to his knowledge; (*i*) that in the case of a patent granted on convention application, the application for patent was not made within twelve months from the date of the first application for protection for the invention made in a convention country or in India by the patentee or a person from whom he derives title; (*j*) that the complete specification does not disclose or wrongly mentions the source and geographical origin of biological	(*d*) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim. *Explanation*.— For the purposes of this clause, an invention relating to a process for which a patent is granted shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only; (*e*) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

		material used for the invention; (*k*) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere, but on no other ground. (3)(*a*) Where any such notice of opposition is duly given under sub-section (2), the Controller shall notify the patentee. (*b*) On receipt of such notice of opposition, the Controller shall, by order in writing, constitute a Board to be known as the Opposition Board consisting of such officers as he may determine and refer such notice of opposition along with the documents to that Board for examination and submission of its recommendations to the Controller. (*c*) Every	involve any inventive step, having regard to the matter published as mentioned in clause (*b*) or having regard to what was used in India before the priority date of the claim; (*f*) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act; (*g*) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed; (*h*) that the patentee has failed to disclose to the Controller the information required by Section 8 or has furnished the information which in any material

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

		Opposition Board constituted under clause (*b*) shall conduct the examination in accordance with such procedure as may be prescribed. (4) On receipt of the recommendation of the Opposition Board and after giving the patentee and the opponent an opportunity of being heard, the Controller shall order either to maintain or to amend or to revoke the patent. (5) While passing an order under sub-section (4) in respect of the ground mentioned in clause (*d*) or clause (*e*) of sub-section (2), the Controller shall not take into account any personal document or secret trial or secret use. (6) In case the Controller issues an order under sub-section (4) that the patent shall be maintained subject to amendment of the specification or any other document, the patent shall stand amended accordingly	particular was false to his knowledge; (*i*) that in the case of a patent granted on convention application, the application for patent was not made within twelve months from the date of the first application for protection for the invention made in a convention country or in India by the patentee or a person from whom he derives title; (*j*) that the complete specification does not disclose or wrongly mentions the source and geographical origin of biological material used for the invention; (*k*) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

			the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere, but on no other ground. (3)(*a*) Where any such notice of opposition is duly given under sub-section (2), the Controller shall notify the patentee. (*b*) On receipt of such notice of opposition, the Controller shall, by order in writing, constitute a Board to be known as the Opposition Board consisting of such officers as he may determine and refer such notice of opposition along with the documents to that Board for examination and submission of its recommendations to the Controller. (*c*) Every Opposition Board constituted under clause (*b*) shall conduct the

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

			examination in accordance with such procedure as may be prescribed. (4) On receipt of the recommendation of the Opposition Board and after giving the patentee and the opponent an opportunity of being heard, the Controller shall order either to maintain or to amend or to revoke the patent. (5) While passing an order under sub-section (4) in respect of the ground mentioned in clause (*d*) or clause (*e*) of sub-section (2), the Controller shall not take into account any personal document or secret trial or secret use. (6) In case the Controller issues an order under sub-section (4) that the patent shall be maintained subject to amendment of the

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

			specification or any other document, the patent shall stand amended accordingly.

Section 57 of the Patents Act, 1970

Section 57 as enacted vide the Patents Act, 1970	**Section 57, as amended by the 2002 Amendment Act**	**Section 57, as amended by the 2005 Amendment Act**
57. Amendment of application and specification before Controller- (1) Subject to the provisions of Section 59, the Controller may, upon application made under this section in the prescribed manner by an applicant for a patent or by a patentee, allow the application for the patent or the complete specification to be amended subject to such conditions, if any, as the Controller thinks fit: Provided that the Controller shall not pass any order allowing or refusing an application to amend an application for a patent or a specification under this section while any suit	**57. Amendment of application and specification [<u>or any document related thereto</u>] before Controller.** (1) Subject to the provisions of Section 59, the Controller may, upon application made under this section in the prescribed manner by an applicant for a patent or by a patentee, allow the application for the patent or the complete specification [<u>or any document related thereto</u>] to be amended subject to such conditions, if any, as the Controller thinks fit: Provided that the Controller shall not pass any order allowing or refusing an application to amend an application for a patent or a specification	**57. Amendment of application and specification [<u>or any document related thereto</u>] before Controller.** (1) Subject to the provisions of Section 59, the Controller may, upon application made under this section in the prescribed manner by an applicant for a patent or by a patentee, allow the application for the patent or the complete specification [<u>or any document related thereto</u>] to be amended subject to such conditions, if any, as the Controller thinks fit: Provided that the Controller shall not pass any order allowing or refusing an application to amend an application for a patent or a specification [<u>or any document related thereto</u>] under this section while any suit before a court for the

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

before a court for the infringement of the patent or any proceeding before the High Court for the revocation of the patent is pending, whether the suit or proceeding commenced before or after the filing of the application to amend. (2) Every application for leave to amend an application for a patent or a specification under this section shall state the nature of the proposed amendment, and shall give full particulars of the reasons for which the application is made. (3) Every application for leave to amend an application for a patent or a specification under this section made after the acceptance of the complete specification and the nature of the proposed amendment shall be advertised in the prescribed manner. (4) Where an application is advertised under sub-section (3), any person interested may, within the prescribed period after the advertisement thereof, give notice to	[or any document related thereto] under this section while any suit before a court for the infringement of the patent or any proceeding before the High Court for the revocation of the patent is pending, whether the suit or proceeding commenced before or after the filing of the application to amend. (2) Every application for leave to amend an application for a patent [or a complete specification or any document related thereto] under this section shall state the nature of the proposed amendment, and shall give full particulars of the reasons for which the application is made. (3) Any application for leave to amend an application for a patent or a complete specification or a document relating thereto under this section made after the acceptance of the complete specification and the nature of the proposed amendment may be advertised in the Official Gazette if the amendment, in the opinion of the Controller, is substantive. (4) Where an application is advertised under sub-section (3), any person interested may, within the	infringement of the patent or any proceeding before the High Court for the revocation of the patent is pending, whether the suit or proceeding commenced before or after the filing of the application to amend. [*No change made between the 2002 and 2005 Amendments*] (2) Every application for leave to amend an application for a patent [or a complete specification or any document related thereto] under this section shall state the nature of the proposed amendment, and shall give full particulars of the reasons for which the application is made. [*No changes made between the 2002 and 2005 Amendments*] (3) Any application for leave to amend an application for a patent or a complete specification or a document related thereto under this section made after the grant of patent and the nature of the proposed amendment may be published. (4) Where an application is [published] under sub-section (3), any person interested may, within the prescribed period after the [publication] thereof, give notice to the Controller of opposition thereto; and where such a notice is given within the period aforesaid, the

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

the Controller of opposition thereto; and where such a notice is given within the period aforesaid, the Controller shall notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case. (5) An amendment under this section of a complete specification may be, or include, an amendment of the priority date of a claim. (6) The provisions of this section shall be without prejudice to the right of an applicant for a patent to amend his specification to comply with the directions of the Controller issued before the acceptance of the complete specification or in the course of proceedings in opposition to the grant of a patent.	prescribed period after the advertisement thereof, give notice to the Controller of opposition thereto; and where such a notice is given within the period aforesaid, the Controller shall notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case. [*No changes made vide the 2002 Amendment Act*] (5) An amendment under this section of a complete specification may be, or include, an amendment of the priority date of a claim. *[No changes made vide the 2002 Amendment Act]* (6) The provisions of this section shall be without prejudice to the right of an applicant for a patent to amend his specification or any document related thereto to comply with the directions of the Controller issued before the acceptance of the complete specification along with other documents filed by the applicant or in the course of proceedings in opposition to the grant of a patent.”	Controller shall notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case. (5) An amendment under this section of a complete specification may be, or include, an amendment of the priority date of a claim. [*No changes made to (5) since its enactment*] (6) The provisions of this section shall be without prejudice to the right of an applicant for a patent to amend his specification or any other document related thereto to comply with the directions of the Controller issued before the grant of a patent.

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

Section 117A of the Patents Act, 1970

Section 117A as enacted	**Section 117A, as amended by the 2002 Amendment Act**	**Section 117A, as amended by the 2005 Amendment Act**	**Section 117A, as it stands now, vide the 2021 Tribunal Reforms Act**
Came into force in the year of 2002. The provision was not present in the original Act.	117-A. *Appeals to Appellate Board*. — (1) Save as otherwise expressly provided in sub-section (2), no appeal shall lie from any decision, order or direction made or issued under this Act by the Central Government, or from any act or order of the Controller for the purpose of giving effect to any such decision, order or direction. (2) An appeal shall lie to the Appellate Board from any decision, order or direction of the Controller or Central Government under Section 15, Section 16, Section 17, Section 18, Section 19, Section 20, Section 25, Section 27, Section 28, Section 51, Section 54, Section 57,	117-A. *Appeals to Appellate Board*. — (1) Save as otherwise expressly provided in sub-section (2), no appeal shall lie from any decision, order or direction made or issued under this Act by the Central Government, or from any act or order of the Controller for the purpose of giving effect to any such decision, order or direction. [*No changes brought about by the 2005 Amendment*] (2) An appeal shall lie to the Appellate Board from any decision, order or direction of the Controller or Central Government under Section 15, Section 16, Section 17, Section 18, Section 19, Section 20, [<u>sub-section (4) of Section 25, Section 28</u>,] Section 51, Section 54, Section 57, Section 60, Section 61, Section 63, Section 66, sub-section (3) of Section 69, Section 78, sub-sections	117-A. *Appeals to High Court-* (1) Save as otherwise expressly provided in sub-section (2), no appeal shall lie from any decision, order or direction made or issued under this Act by the Central Government, or from any act or order of the Controller for the purpose of giving effect to any such decision, order or direction. (2) An appeal shall lie to the **<u>[High Court]</u>** from any decision, order or direction of the Controller or Central Government under Section 15, Section 16, Section 17, Section 18, Section 19, Section 20, [sub-section (4) of Section 25, Section 28,] Section 51, Section 54, Section 57, Section 60, Section 61, Section 63, Section 66, sub-

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

	Section 60, Section 61, Section 63, Section 66, sub-section (3) of Section 69, Section 78, sub-sections (1) to (5) of Section 84, Section 85, Section 88, Section 91, Section 92 and Section 94. (3) Every appeal under this section shall be in the prescribed form and shall be verified in such manner as may be prescribed and shall be accompanied by a copy of the decision, order or direction appealed against and by such fees as may be prescribed. (4) Every appeal shall be made within three months from the date of the decision, order or direction, as the case may be, of the Controller or the Central Government or within such further time as the Appellate Board may, in accordance with the rules made	(1) to (5) of Section 84, Section 85, Section 88, Section 91, Section 92 and Section 94. (3) Every appeal under this section shall be in the prescribed form and shall be verified in such manner as may be prescribed and shall be accompanied by a copy of the decision, order or direction appealed against and by such fees as may be prescribed. [*No changes brought about by the 2005 Amendment*] (4) Every appeal shall be made within three months from the date of the decision, order or direction, as the case may be, of the Controller or the Central Government or within such further time as the Appellate Board may, in accordance with the rules made by it, allow. [*No changes brought about by the 2005 Amendment*]	section (3) of Section 69, Section 78, sub-sections (1) to (5) of Section 84, Section 85, Section 88, Section 91, Section 92 and Section 94. (3) Every appeal under this section shall be in the prescribed form and shall be verified in such manner as may be prescribed and shall be accompanied by a copy of the decision, order or direction appealed against and by such fees as may be prescribed. [*No changes brought about in this section vide the 2021 Act*] (4) Every appeal shall be made within three months from the date of the decision, order or direction, as the case may be, of the Controller or the Central Government or within such further time as the **[High Court]** may, in accordance with the rules made by it allow.

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

	by it, allow.		

D. CONTENTIONS OF NOVARTIS

12. Assailing the view taken by the learned Single Judge, Mr. Singh, learned counsel, addressed the following submissions on the appeal. It was the submission of Mr. Singh that the facts surrounding the consideration and disposal of the patent application is a stark and glaring example of how the PGO opportunity was abused by the respondents. The appellant contends that the opponents connived with each other so as to inordinately delay the grant of the patent and which fact is evident from the timing of the filing of each PGO aimed at ensuring that the opposition proceedings do not ever reach a point of conclusion. According to Mr. Singh, the adoption of such a device by serial opponents violates the very ethos underlying Section 43 of the Act and thus frustrating the legislative command of expeditious grant. Mr. Singh highlighted the fact that the filing of serial oppositions led to the grant being delayed by more than 16 years when computed from the time when the application was originally made. The torturous process has led to more than 16 years out of the maximum term of 20 years that a patent could have enjoyed in terms of Section 53 of the Act having been spent in prosecution proceedings before the Controller. Mr. Singh submitted that despite the long and protracted PGO proceedings, the grant has ultimately come to be set aside by the judgment impugned and that too on grounds which are wholly untenable.

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

13. Since the decision rendered by the learned Single Judge essentially proceeds on a finding that the proceedings as undertaken by the Controller were in violation of the principles of natural justice, we deem it apposite to note the following submissions that were addressed by Mr. Singh in this regard. Mr. Singh at the outset submitted that the learned Judge has clearly erred in upholding the challenge that was raised by NATCO and has failed to bear in mind the scheme of the Act and the **Patents Rules, 2003**[7]. It was submitted that the learned Single Judge has proceeded on the premise that when an opposition is filed, the examination and opposition proceedings merge and thus conferring a right upon an opponent to be accorded audience even in proceedings which may have originated pursuant to a directive framed by the Controller based on an independent examination of the patent application in terms of Sections 14 and 15 of the Act.

14. According to learned counsel, the interpretation as placed by the learned Single Judge on the scheme of Sections 12 to 15 of the Act read along with Rules 24B, 28 and 28A is clearly erroneous and fails to bear in mind the statutory distinction which stands constructed between the "*examination procedure*" regulated by the aforenoted provisions on the one hand and Section 25(1) of the Act read along with Rule 55 and which governs the "*opposition procedure*" on the other.

15. It was submitted that the learned Single Judge also failed to bear in consideration the deleterious effect that would ensue in case a protracted "*pre-grant opposition procedure*" were to unfold. According

[7] the Rules

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

to learned counsel, according a judicial imprimatur to such a process would clearly violate the legislative intent underlying Sections 43 and 53 of the Act**.** Mr. Singh submitting that the rights that may be claimed by an opponent at the pre grant stage were lucidly enunciated by a learned Judge of the Court in **UCB Farchim Sa Vs. Cipla Ltd. & Ors.**[8] where the following pertinent observations came to be rendered: -

> "**13.** In the first instance a distinction has to be drawn between a pre-grant opposition and a post-grant opposition. While a pre-grant opposition can be filed under Section 25(1) of the Patents Act at any time after the publication of the patent application but before the grant of a patent, a post-grant opposition under Section 25(2) of the Patents Act has to be filed before the expiry of one year from the date of the publication of the grant of patent. A second significant difference, after the amendment of 2005, is that a pre-grant opposition can be filed by "any person" whereas a post-grant opposition under Section 25(2) can be filed only by "any person interested". It may be noticed that the application for revocation of a patent in terms of Section 64 of the Patents Act can also to be filed only by "any person interested". In other words, the post-grant opposition and the application for revocation cannot be filed by just about any person who is not shown to be a person who is interested. A third significant difference is that the representation at the stage of pre-grant is considered by the Controller himself. Rule 55 of the Patents Rules requires the Controller to consider the "statement and evidence filed by the applicant" and thereafter either refuse to grant the patent or require the complete specification to be amended to his satisfaction. Of course, in that event notice will be given to the applicant for grant of patent who can file his reply and evidence. This Court finds merit in the contention that the pre-grant opposition is in fact "in aid of the examination" of the patent application by the Controller. The procedure is however different aspect as far as the post-grant opposition is concerned. There in terms of Section 25(3), the Controller has to constitute an Opposition Board consisting of such officers as he may determine and refer to such Opposition Board the notice of opposition along with other documents for its examination and recommendations. After receiving the recommendations of the Opposition Board, the Controller gives the

[8] 2010 SCC OnLine Del 523

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

patentee and the opponent an opportunity of being heard. The Controller then takes a decision to maintain, amend or revoke the patent. The fourth major difference between the pre-grant and the post-grant opposition is that while in terms of Section 117A an appeal to the IPAB is maintainable against the order of the Controller in a post-grant opposition under Section 25(4) of the Patents Act, an appeal has not been expressly been made available against an order made under Section 25(1) of the Patents Act.

14. There are two possible situations arising from the order passed by the Controller in a pre-grant opposition. Where the pre-grant opposition is rejected, the aggrieved person would obviously be the person who has filed the pre-grant opposition. Where the Controller accepts the pre-grant opposition and therefore refuses the grant of patent or suggests amendments which are then not carried out by the applicant resulting in the refusal of the grant of patent, the aggrieved person obviously would be the applicant for the patent. Where the pre-grant opposition is rejected and patent is granted

15. In the first eventuality, where the pre-grant opposition is rejected, it is apparent from the decision in J. Mitra and from a reading of Section 25 with Section 117A that as long as the person who has filed that opposition happens to be a person interested, he would, after 1st January, 2005 [the date with effect from which Section 25 (2) came into force although the provision was introduced only on 4th April, 2005] have the remedy of filing a post-grant opposition. He can, after 2nd April, 2007, also file an application before the IPAB under Section 64 of the Patents Act for revocation of the patent. In other words, as explained by the Supreme Court in J. Mitra & Co. as long as that person is able to show that he is a person "interested", he is not without a remedy after his pre-grant opposition is rejected. He in fact has two remedies. Even if his post-grant opposition is rejected, he can thereafter file an appeal to the IPAB under Section 117A. Against the decision of the IPAB in either event he will have the remedy of seeking judicial review in accordance with law by filing a petition in the High Court. At this juncture it may be noticed that in an order dated 2nd March, 2009 in SLP (C) No. 3522 of 2009 (*Indian Network for People with HIV/AIDS* v. *F. Hoffman-La Roche*) the Supreme Court permitted the unsuccessful pre-grant opposer, who had challenged the rejection of his opposition by the Controller, to participate in the post-grant stage.

16. The law is well settled that notwithstanding that a High Court has the power and the jurisdiction under Article 226 of the

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

Constitution to interfere with the orders of any statutory authority which is of a quasi-judicial nature, it will decline to exercise such jurisdiction where there is an efficacious alternative statutory remedy available to the aggrieved person. See *e.g.*, *Special Director* v. *Mohd. Ghulam Ghouse*, (2004) 3 SCC 440 [para 5 at page 443]; *Uttaranchal Forest Development Corp.* v. *Jabar Singh*, (2007) 2 SCC 112 [paras 43-45 at page 137]; *U.P. State Spinning Company Ltd.* v. *R.S. Pandey*, (2005) 8 SCC 264 [paras 11-24 at pages 270-275]; *Titaghur Paper Mills Company Ltd.* v. *State of Orissa*, (1983) 2 SCC 433 [para 6 at pages 437-438; paras 8 & 9 at page 439; para 12 at page 441]; *Karnataka Chemical Industries* v. *Union of India*, (2000) 10 SCC 13 [para 2 at page 14]; *Assistant Collector of Central Excise* v. *Jainson Hosiery Industries*, (1979) 4 SCC 22 [para 1 at page 23] and *U.P. State Bridge Ltd.* v. *U.P. Rajya Setu Nigam S. Karamchari Sangh*, (2004) 4 SCC 268 [para 11 at pages 275-276; para 17 at page 278].

17. Counsel for the parties have drawn the attention of this Court to a recent decision of the Division Bench of the Bombay High Court in *Glochem Industries Ltd.* v. *Cadila Healthcare Ltd.*, (its decision dated 6th November, 2009 in Writ Petition No. 1605 of 2009). Although in that case the petitioner whose pre-grant opposition had been rejected was obviously a person interested, the High Court overruled the objections as to maintainability since it took the view that the Controller's order in that case suffered from obvious jurisdictional errors. The Bombay High Court nevertheless noted that "it is a matter of prudence and discretion as to whether this Court should entertain the writ petition or not" and that in the facts and circumstances of that case it was "not proper to non-suit the petitioners at the threshold on this count." To this Court it appears that the settled law as explained in several decisions of the Supreme Court (which incidentally have not been adverted to by the Bombay High Court in Glochem) makes it clear that this Court should not entertain the writ petition, not because it does not have the power or jurisdiction, but because the petitioner has an efficacious alternative statutory remedy to exhaust.

18. <u>To summarise this part of the discussion, as regards persons who have not succeeded in the pre-grant opposition stage to prevent the grant of a patent, and are persons "interested" within the meaning of Section 25(2) and Section 64 of the Patents Act, their remedy against the rejection of their pre-grant opposition is to file a post-grant opposition under Section 25(2) and await the decision of the Controller. If they are still aggrieved by that decision under Section 25(4) of the Patents Act, they can file an appeal before the IPAB in</u>

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19:08:38

terms of Section 117A of the Patents Act.

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20. In the first place this Court would like to observe that none of the applicants who have filed a pre-grant opposition in these cases, and whose applications have either been accepted or rejected, are persons who are not interested persons. Therefore this question is purely academic as far as this batch of petitions is considered. Secondly, prior to the amendment in 2005, a pre-grant opposition could be filed only by an interested person and not a third party. The right of "any" person to file a pre-grant opposition was granted only with effect from 1st January, 2005 when the re-cast Section 25(1) became effective. Given the differences in the pre-grant and post-grant oppositions, the Legislature appears to have consciously denied to a third party a further statutory remedy of a post-grant opposition in the event of such third party not succeeding in the pre-grant stage to prevent the grant of patent. Since there is no challenge to the constitutional validity of the re-cast Section 25 by any third party in these proceedings, this Court is not called upon to decide that issue. Nevertheless, as regards the maintainability of a writ petition by such third party pre-grant opposer against the Controller's order rejecting the opposition, this Court would like to observe that the power under Article 226 of the Constitution is wide and can be exercised on the facts and circumstances of a given case where it appears to this Court that there is no other efficacious remedy available or that the interests of justice require this Court to interfere.

21. Therefore where a pre-grant opposition under Section 25(1) is filed by a person who is a third party and not a person interested in the sense of the term under Section 25(2) or Section 64 of the Patents Act, and such pre-grant opposition is rejected by the Controller, it would be for this Court when approached by such third party pre-grant opposer under Article 226 of the Constitution to determine if in the facts and circumstances, the petition requires to be entertained. Pre-grant opposition is accepted and the grant of patent is refused

22. In the second eventuality where the pre-grant opposition is accepted and the grant of patent is refused by the Controller, although the decision is one taken under Section 25(1), it is in effect a decision relatable to and under Section 15 of the Patents Act. An appeal is provided under Section 117A of the Patents Act against the decision of the Controller under Section 15 of the Patents Act. It appears to this Court that the observation in J. Mitra in para 24 that "the Appellate Board after 2nd April, 2007 is entitled to hear appeals

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

only arising from orders passed by the Controller under Section 25(4) *i.e.* in cases of orders passed in post-grant opposition" has to be understood in the context of that case where the Court was only considering whether against the rejection of a pre-grant opposition an appeal lay to the High Court or to the IPAB. Considering that the appeal in that case had been filed in the High Court on 17th October, 2006 prior to Section 117A being notified, the Supreme Court in J. Mitra & Co. held that the said appeal would continue before the High Court. The question whether an appeal would lie against the refusal by the Controller to grant a patent after accepting the pre-grant opposition under Section 25(1) of the Patents Act did not arise for consideration in J. Mitra & Co. The further question whether such refusal to grant patent would in fact be relatable to Section 15 of the Patents Act also did not arise for consideration. Consequently, there was no occasion for the Supreme Court in J. Mitra & Co. to decide whether in such event an appeal would be available to the applicant for patent before the IPAB."

16. Learned counsel then drew our attention to another judgment which reiterated the principles laid down in *UCB Farchim* and commended for our consideration the following passages from the decision in **Mylan Laboratories Limited Vs. Union of India & Ors.**[9]:-

"**6.** In the opinion of this Court, the pre-grant opposition was, therefore, decided on merits and following the scheme of the Act, as laid down in *UCB Farchim* (supra), the remedy of the Petitioner would be to either file a post-grant opposition or an application for revocation. Thus, the present petition would not be liable to be entertained.

7. Under Section 25(2) of the Act, the post-grant opposition can be filed by *"any person interested"* within a period of one year from the date of publication of grant of the patent. Considering that the Petitioner is a *"person interested"*, the Petitioner is permitted to file a post-grant opposition, which shall be decided in accordance with the provisions of Section 25 of the Act, after constituting an Opposition Board.

8. The Petitioner shall file the post-grant opposition within a period

[9] 2019 SCC OnLine Del 10319

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

of two months from today. Thereafter, the pleadings shall be completed in accordance with the Act. In any event, the post-grant opposition, if filed within a period of two months, shall be decided within a period of one year from today. The parties are permitted to file any additional documents, pleadings and evidence, which they consider appropriate, at the relevant stage. All rights and contentions of the Petitioner and Respondent No. 3 are left open."

17. Mr. Singh then sought to highlight the distinction which has come to be statutorily engrafted between "*pre grant opposition"* and *"post grant opposition*" by virtue of the **Patents (Amendment) Act, 2005 [Act 15 of 2005]**[10] and which was duly recognized by the Court in **Dr. (Miss) Snehlata C. Gupte Vs. Union of India & Ors.**[11] Learned counsel laid emphasis on the following observations as appearing in that decision:-

"**40.** There are specific time limits for the steps to be taken for the acceptance of the complete specification for publication by the Controller. This is followed by a request made by the applicant for examination in terms of Section 11-B of the Act. This is followed by the examination of the application under Section 12 of the Act which has to take place within the specified time limit as prescribed in Rule 24-B of the Rules. Without going into the specific details of this time period, for the purposes of the present petitions it is sufficient to note that where it is intended that there should be a specific time limit within which a step has to be taken either by the applicant for the grant of patent or by the Controller then such time limit is clearly indicated in the Act and the Rules.

41. There is another provision which is relevant in this context. Under Rule 55(1-A), no patent shall be granted before the expiry of a period of six months from the date of publication of the application under Section 11A. As a result, at least for a period of 2 years after filing of the application for grant of patent, no patent can be granted. It is during this period that the steps for examination of the patent in terms of Section 12 and thereafter the consideration by the Controller of the report of the Examiner under Section 14 followed

[10] Amending Act, 2005
[11] 2010 SCC OnLine Del 2374

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

by amendments, if any, are all undertaken. It is during this time also that the pre-grant opposition is expected to be filed.

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43. There is a further time restriction. Under Rule 24, the period for which an application for patent "shall not ordinarily be open to public under sub-section (1) of Section 11-A shall be 18 months from the date of filing of the application or the date of the priority of the application, whichever is earlier." In effect, therefore, it will not be possible for a person seeking to object to the grant of a patent to make 'representation' earlier than a period of 18 months after the date of the filing of such application. In any event since in terms of Rule 55(1-A) no patent can be granted before the expiry of a period of six months from the date of publication and the Controller is expected to publish the application within one month from the date of expiry of the said period, there is at least a period of six months thereafter for the opposer to file the representation.

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47. The scheme of the Patents Act, therefore, is such that there are several hurdles to cross before the grant of a patent can be said to be final. There are two other provisions that require to be noticed. Under Section 53, term of every patent "shall be 20 years from the date of filing of the application for the patent" Under Section 45 "every patent shall be dated as of the date on which the application for patent was filed" Since this date cannot possibly be changed, a patent holder may end up not being able to work the patent during the time when it remains challenged, or its grant is stayed or when the patent holder is not confident to exploit it commercially till all the challenges to its validity are overcome. Since there is already a loss of time for the patent holder in the above processes, the time period envisaged by Section 25(1) of the Act for filing of a pre-grant opposition cannot possibly be liberally construed, notwithstanding that there is no specific time period mentioned therein. The outer limit is the date on which the patent is granted.

48. A careful look at Section 43 of the Act shows that in the first place an application for patent has to be found "to be in order for grant" This includes the period during which complete specification is accepted for publication in terms of Section 11A followed by the examination of the patent which takes place within the time-frame set out in Rule 24-B of the Rules. A refusal at that stage will be governed by Section 15 of the Act. If the patent is not refused at that stage and no pre-grant opposition has been filed, the patent proceeds

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

for registration.

49. Where any pre-grant opposition is filed in the form of a representation under Section 25(1) of the Act, then it has to be examined following the procedure outlined in Rule 55 (1). The representation should include a statement of evidence and a request for hearing. Under Rule 55 (2), the Controller is to consider such representation "only when a request for examination of an application has been filed" A notice is given to the applicant "for grant of patent" where the Controller forms an opinion, upon considering the pre-grant opposition, that the patent should be refused or amended. This happens under Rule 55 (3). The applicant for grant of patent then responds to the notice by filing his statement of evidence under Rule 55(4) within three months from the date of the notice. Under Rule 55 (5), the Controller may, on consideration of the statement and evidence filed by the applicant, either refuse to grant a patent or require the complete specification to be amended before the patent is granted.

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51. It is plain, therefore, that once the pre-grant opposition is decided, the Controller simultaneously proceeds to either reject such representation and grant the patent or accept the representation and refuse the patent. The language of Rule 55 (6) leaves no manner of doubt that these two actions i.e. the consideration of the representation and the final decision on the application for grant of patent take place simultaneously.

52. It is possible that there are more than one representations by way of pre-grant opposition. Ideally, the Controller will bunch them together, hear them sequentially and express a final opinion on each of them as far as practicable, on the same date. It is like a court hearing a batch of petitions seeking similar relief. It is possible that even after the hearing on one bunch of pre-grant oppositions has concluded and order has been reserved thereon, another pre-grant opposition or a set of oppositions is filed prior to the pronouncement by the Controller of the decision on the first set of pre-grant oppositions. Then the scheme of the Act requires the Controller to deal with such subsequently filed pre-grant oppositions as well. However, once a final decision is pronounced on the pre-grant oppositions, the Controller should, consistent with the requirement of Rule 55 (6) simultaneously pronounce the decision on the application for grant of patent. The Controller should clearly state, simultaneously, that the application is found in order and that the patent is being granted.

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

53. Reverting to Section 43 (1), the language used is that "a patent shall be granted as expeditiously as possible." Therefore the patent has to be granted once it is found that either the application has not been refused in terms of Section 25(1) read with Rule 55 (6) or it has not been found in contravention of any provision of the Act. In other words, at this stage the Controller is not expected to delay the pronouncement of the final decision. The thrust of Section 43 (1) and Rule 55 (6) is that of expeditious decision making by the Controller. Section 43 (1) indicates that the "patent shall be granted…..with the seal of the patent office and the date on which the patent is granted shall be entered in the Register" When read continuously, the language of Section 43 (1) does appear to indicate that it is the decision taken by the Controller on file which is the determining event for ascertaining 'the date of grant of patent.' The sealing of the patent and the entering of the patent in the Register obviously follows the act of the Controller passing an order to the effect that the patent has been granted. In other words, the sealing of the patent and the entering of the patent in the Register are, given the language of Section 43 (1) of the Act, intended to be ministerial acts evidencing the grant of patent, which is at a stage anterior to those ministerial acts.

54. Section 43 (2) talks of the publishing by the Controller of "the fact that the patent has been granted" The language of Section 43 (2) is plain. The act of publication clearly follows the grant of patent. Per force the grant of patent is anterior to the publication and has to necessarily be at a point earlier to the publication. It is, therefore, not possible to agree with the submissions made on behalf of the pre-grant opposers in the present batch of cases that the patent cannot be said to have been granted till this fact is published in the official gazette. Given that the interpretation of the provision has to be contextual, this Court holds that the date of grant of patent is the date on which the Controller passes an order to that effect on the file. This Court now proceeds to deal with the apprehended practical problems that the office of the Controller may face on account of the interpretation placed by this Court on Section 43 of the Act.

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57. There is one other aspect which requires to be adverted to, which is the wording of the order granting patent. The Controller should pass the 'final order' saying that "the patent is hereby granted" only after all amendments have been carried out to the satisfaction of the Controller by the applicant. The Controller will, therefore, not dispose of the application or pass a final order till such time the

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

Applicant has not carried out the amendments to the satisfaction of the Controller. It will have to be a time-bound order for that purpose. A failure to carry out the amendment to the specification as directed by the Controller or Assistant Controller within the time granted might result in rejection of the patent which contingency is covered under S. 15 of the Act.

58. In order to minimise any unnecessary time-gap between the signing by the Controller or Assistant Controller of the final order granting patent and the 'publishing' of such order, it is directed that every final order granting the patent passed by the Controller or the Assistant Controller, as the case may be, should be digitally signed by the Controller or the Assistant Controller and placed on the website of the Controller on the very same day without any unnecessary delay. The procedure in this regard be streamlined for being followed uniformly by all the officers and necessary instructions/practice directions should be issued by the Controller.

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76. The Controller of Patents will, within a period of two weeks from today issue necessary practice directions/instructions to all officers and concerned authorities in terms of this judgment and particularly in terms of what has been held by this Court in paras 55 to 58 thereof. Such practice directions/instructions will also be placed simultaneously on the website of the Controller of Patents. They will be prospective in the sense they will not result in the reopening of orders granting patent that have attained finality."

18. Additionally, Mr. Singh drew our attention to the note of caution which came to be entered in *Snehlata C. Gupte* while dealing with the subject of "*serial oppositions*" and appears in the following passages of that decision: -

"**62.** Accepting the submissions of pre-grant opposers in the present batch of cases that till such time the grant of patent is not entered in the Register, and notwithstanding that an order has already been passed on file by the Controller granting a patent, they can continue to file the pre-grant representations in terms of Section 25 (1) might result in the phenomenon of 'serial oppositions', as has happened in the case of the applications filed opposing the patents applied for by J. Mitra & Company. Within a day after the Controller rejected the

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

pre-grant opposition filed by SDL, Dr. Gupte filed a pre-grant opposition. Soon thereafter Dr. Rindani filed his pre-grant opposition. In other words, if this Court were to hold that the date of the grant of patent is only the date on which the factum of such grant is entered in the Register, then there would be no end to filing of pre-grant oppositions as long as on account of some delay on the administrative side the factum of grant of patent is not entered in the Register. Given the scheme of the Act, and the number of hurdles an applicant for grant of a patent has to overcome, even if the application is found to be 'in order for grant', it is not possible to accept the interpretation put forth by the pre-grant opposers.

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64. In adopting the above interpretation of Section 43 and other related provisions of the Act this Court has kept in view the following observations of the Supreme court in Entertainment Network (India) Ltd. v. Super Cassette Industries Ltd. (2008) 13 SCC 30, in paras 137 and 139, which though made in the context of the Copyright Act may well apply to the present cases as well:

> "137. Furthermore, the court while interpreting a statute will put itself in the armchair of the reasonable legislature, all statutes must be presumed to be reasonable. It is now trite law that literal interpretation should be avoided when it leads to absurdity.....
>
> 139. In this case, however, the meaning of the statute is neither clear nor sensible. It is a statute where a purposive construction is warranted. It is a case where sub-section (2) should be kept confined to clause (a) for that purpose. The statute has to be read down. It is not a case of improper interpolation so as to take away a primary purpose of the legislative intent. It is expedient to give effect to the intent of the statute. This itself says that creases can be ironed out. While undertaking the said exercise, the Court's endeavour would be to give a meaning to the provisions and not render it otiose...."

65. This court, for the aforementioned reasons, holds that for the purposes of Section 43 (1) of the Act, the patent is 'granted' on the date on which the Controller passes a final order to that effect on the file."

19. Reverting then to the statutory provisions relating to the

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

"*examination of a patent application*", Mr. Singh addressed the following submissions. It was contended that the *examination of a patent application* is governed by the provisions placed in Chapter IV of the Act and more particularly Sections 14 and 15 thereof read along with Rules 24B, 28 and 28A. According to Mr. Singh, a holistic reading of the aforesaid provisions would clearly establish that the statute does not envisage a hearing or participation of the opponent in the "*process of examination*". According to learned counsel, the examination of an application leading to a grant or refusal of patent is a statutory duty independently cast upon the Controller and thus not contemplative of an opportunity of hearing being granted to an opponent. Mr. Singh submitted that the examination of the application and the power and discretion exercisable in respect thereof stands conferred upon the Controller exclusively and the said exercise proceeds irrespective of the objections that may or may not be preferred. It was submitted that while the representations of opposition may act as an "*aid to the examination process"*, the same does not detract from the independent duty and obligation cast upon the Controller to be satisfied that the application merits grant.

20. It is in the aforesaid backdrop that Mr. Singh submitted that an opponent cannot claim a right of hearing where amendments are proposed by the Controller on an independent examination and evaluation of the patent application. The submission essentially was that the *examination of the patent application* is a self-contained and self-determining process which has to be necessarily undertaken by the

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

Controller even if no PGOs' be filed. This, according to Mr. Singh, would establish that the theory of merger of the *examination* and *opposition process*es as was canvassed is not only erroneous but also wholly untenable.

21. It was further contended that the *pre-grant opposition* is limited to grounds enumerated in Section 25(1) of the Act. However, it was urged that it would still be open to the Controller to examine and evaluate the application on various grounds other than those prescribed in Section 25(1) of the Act. This too, according to Mr. Singh, would underline the statutory intent of *pre-grant oppositions* being envisaged as merely facilitating or informing the *examination process*.

22. It was further highlighted by Mr. Singh that prior to the enforcement of Amending Act, 2005, Section 25(1) envisaged that "*any person interested*" could file a PGO on grounds set out therein. Section 117A also envisaged a right of appeal against an order of rejection of the PGO. It was by virtue of the Amending Act, 2005 that the statute bifurcated the "*pre-grant*" and "*post-grant opposition*" proceedings. Consequently, while a PGO could be laid by "*any person*" under Section 25(1), a *post-grant opposition* can be raised only by a "*person interested*". According to Mr. Singh, the scope of proceedings as envisaged under Section 25(1) as it stands post its amendment would thus lend credence to the view which was expressed in *UCB Farchim* of the PGO being merely in *aid of examination* as opposed to proceedings which may be recognised as adversarial.

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

23. It was further submitted that Section 117A, as it stands post its amendment in 2005 no longer provisions for an appeal against any order that may be passed under Section 25 and which may culminate in the rejection of a representation of opposition. The right of appeal, Mr. Singh pointed out, now stands confined and limited to orders that may be passed by the Controller under Section 25(4). It was submitted that although the Act no longer confers a right of appeal against rejection of a PGO, the Legislature has provided for a remedy of *post-grant opposition* to *any person interested* and who may be affected by the grant of a patent. Since that remedy and route of redressal stands duly preserved, Mr. Singh would contend, the same not only constitutes a salutary safeguard created in favour of a *person interested* but also sufficiently protects the right of challenge. According to Mr. Singh, this dual opportunity which is vested in a *person interested*, is a part of the larger scheme of the Act aimed at balancing the objective of expeditious grant of a patent and securing the rights that may be claimed by a person affected and who could seek revocation of the grant by way of a *post-grant opposition*.

24. Mr. Singh further submitted that *UCB Farchim* had while examining the scheme of the Act in the context of PGOs' taken note of its following salient features and objectives: -

a. Patent must be granted expeditiously.

b. The numerous hurdles that a patentee has to overcome before the grant of a patent.

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

c. The right of an opponent being sufficiently protected in terms of Section 25(2).

d. The imperatives of avoiding serial oppositions came only at delaying the grant.

e. The statutory obligation of a simultaneous order being framed by the Controller disposing of all pre-grant oppositions and the application under Section 15 itself.

f. The pre grant opposition being only an aid of examination.

g. The remedy of a pre-grant opponent in case of rejection to either raise a post-grant opposition and;

h. The principles of purposive interpretation being employed in order to give effect to the legislative intent and policy.

It was submitted that the aforesaid aspects would also warrant acceptance of the contention of the appellant.

25. Proceeding then to the provisions made in Rule 55, it was the submission of Mr. Singh that an opponent is not accorded a right of hearing merely because an opposition may have been tendered under Rule 55(3). Learned counsel submitted that it is only after the Controller issues notice to an applicant in terms of Rule 55(5) that the proceedings become contested and a right of hearing springs into existence. Mr. Singh further highlighted the fact that even after the opponent and the applicant have been heard, it is still open for the Controller to either reject the pre-grant representation or require the

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

complete specification to be amended to its satisfaction before the patent is granted, or refuse to grant the patent itself. It was in the aforesaid light that Mr. Singh submitted that even where the Controller rejects the pre-grant representation, it does not *ipso facto* lead to the grant of the patent. This, Mr. Singh submitted, in light of the indubitable fact that the Controller may notwithstanding having rejected the PGO, come to the conclusion that the patent application either deserves to be rejected or be of the opinion that amendments to its satisfaction must be made to the patent application. According to Mr. Singh, this part of the functioning of the Controller is in discharge of the statutory duty of examination which stands placed upon that authority and proceeds disconnected from the *opposition process*.

26. Mr. Singh further submitted that the legislative command as embodied in Rule 55(5) mandates the Controller to simultaneously dispose of all PGOs' as well as the application itself. In view of the above, he would contend that the opponent has a right of hearing only in *opposition proceedings* as contemplated under Section 25(1) of the Act read along with Rule 55(5) as opposed to a right of hearing in the Section 14 proceedings and which relate to the *examination process* which has to be undertaken by the Controller.

27. It was further contended that an opponent may claim a right of hearing only in respect of the grounds of opposition as raised and upon which notice may have been issued in accordance with Rule 55(3). The issuance of a notice under the aforesaid Rule enables the applicant to contest the objection by filing its reply statement and adducing

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

evidence as per Rule 55(4). This too would indicate that once the opponent has been heard on grounds of opposition as urged, there would be no justification for the opponent being afforded an opportunity of hearing nor would the law countenance such a right.

28. Proceeding then to deal with the procedure for amendment, Mr. Singh urged the following submissions for our consideration. It was submitted that the direction to amend the specification to the Controller's satisfaction is one exercised by that authority by virtue of the power vested in it in terms of Section 15 of the Act. It was submitted that the directions of the Controller to carry out amendments to its satisfaction is one which is governed by Section 57(6) of the Act. According to learned counsel, the direction to amend is essentially a power which the Controller can exercise in the course of examination. It is for the aforesaid reason that such amendments and directives of the Controller stand placed on a pedestal separate and distinct from voluntary amendments that may be mooted by the applicant and the aforesaid position clearly comes to the fore upon a reading of Section 57(6) of the Act. Mr. Singh submitted that Sections 57(1) and 57(6) deal with separate and unassociated contingencies. According to learned counsel while the former is concerned with voluntary amendments sought by an applicant, the latter is concerned with amendments which the applicant is compelled to carry out pursuant to directives that may be framed by the Controller. According to Mr. Singh, this too is clearly indicative of the different routes which the statute envisages such amendments to follow.

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

29. It was further submitted by Mr. Singh that the remit and scope of the *examination process* can be further evinced from Section 14 of the Act and which obliges the Controller to place the applicant alone on notice. According to Mr. Singh, even Section 14 of the Act does not contemplate an opportunity of hearing being accorded to an opponent. It was submitted by Mr. Singh that the aforesaid position in law is fortified by the judgment rendered by a learned Single Judge in **Haryana Pesticides Manufactures Association Vs. Willowood Chemicals Private Limited**[12], where while ruling upon the rights of an opponent, the Court had held thus: -

> "**3.** The first examination report (FER) was issued on 20-7-2020 by the Deputy Controller of Patents and Designs, Patent Office, Delhi and it required to file a response to the examination report. The petitioner filed objections to the same.
>
> **4.** Form 13 dated 18-9-2019 was again filed by the respondents thereby amending their claims from 1-27 to 1-25; the amended claims are given at pp. 89 and 90 of the amended writ petition.
>
> **5.** The hearing was granted to the petitioner qua these amended claims and it concluded on 13-1-2020. Both the parties were directed to file written submissions. The respondents sent a copy of their written submissions to the Controller with a copy to the petitioner herein. However, later at the back of the petitioner on 27-1-2020, the respondents yet again sought to amend their claims from 1-25 to 1-19 but the copy of such amendment application/written submissions were never served upon the petitioner herein and neither any Form 13 was filed. The impugned order was then passed.
>
> xxx xxx xxx
>
> **7.** The learned counsel for petitioner referred to *Neon Laboratories (P) Ltd. v. Troikaa Pharma Ltd.* wherein the court held:
>
> > "43. <u>It is, therefore, clear that the opportunity provided in Section 25(1) is not an empty formality. The legislature in its</u>

[12] 2022 SCC OnLine Del 2848

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

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. The grounds are also enumerated in the provision. 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. The distinction made by Mr Kadam that opportunity is restricted only to the contents of the original application and there is no requirement of giving further hearing; makes the exercise meaningless and it would be then very easy to defeat Section 25(1). In this context, it must be understood that the opposition under Section 25(1) is to the "grant of a patent". The grant is on an application made in that behalf, which itself is duly published. 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, as in this case, 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. That is the scheme of Section 25(1) and Rule 55 which are to be considered and read together.

52**.** In our view, in this case, it is not necessary to examine in further details, the aspect as to whether the breach of principles of natural justice would vitiate the proceedings to such an extent as would render the final order void. As far as our courts are concerned, the settled view is that if the principles of natural justice are violated, the order is procedurally ultra vires and therefore, suffers from a jurisdictional error. Such an error is required to be corrected and is capable of being corrected by a writ of certiorari under Article 226 of the Constitution of India. The power of judicial review is conferred precisely to set right such errors. Therefore, we can safely conclude that in this case the impugned order does not create any right in favour of Respondent 1 and the grant of patent, therefore, cannot be said to be valid.

54. The argument of Mr Kadam that the patent is granted for 20 years and substantial period has been lapsed, so also, Respondent 1 has in furtherance of grant, extensively applied for and has been granted the patent for 29 countries; need not detain us. The argument that the procedural rules create

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

difficulties for persons like Respondent 1 to apply and seek the patent, also cannot be of any assistance. Once we find that the statutory mandate has been breached and violated, then, Respondent 1 will suffer prejudice if the clock has to be set back, is indeed no answer. Mr Kadam then submits that we should not set aside the grant even if we conclude that the same is issued without adherence to the principles of natural justice. In other words, while remitting the matter back to the Patent Controller we should not disturb the patent granted in favour of Respondent 1 because that would have serious consequences on the trade operations. We are unable to accede to this request. If the grant does not confer any legal right as it is vitiated by non-observance of the principles of natural justice, then, to continue the patent as granted, would put a premium on the illegality of the authorities. That can never be the intention of the legislature. Hence, we have no hesitation in rejecting this plea of the learned Advocate General."

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11. The learned counsel for the petitioner had argued in *Best Agrolife Ltd. v. Controller of Patents*, wherein the controller had allowed the amendment to the claims two days prior to passing of impugned order without notifying the petitioner which is in complete violation of the principles of natural justice and also in *Indian Network for People Living with HIV/AIDS v. Union of India* (Madras) (DB), the court held as under:

"55. The remedy at the post-grant stage cannot be equated with the remedy at the pre-grant stage. The insufficiency of the opportunity of hearing at the pre-grant stage cannot be made good by grant of opportunity at the post-grant stage. Since, statute has given remedy at both the stages, it must be made available at both the stages. One cannot be a substitute for the other. An unfair trial cannot be cured by a fair appeal. (See Institute of Chartered Accountants of India v. L.K. Ratna)".

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25. The amendment from 1-27 to 1-25 claims were made pursuant to objections raised by the Controller in the first examination report dated 20-6-2019 under Section 14 of the Patents Act, 1970. However, the Controller continued his objections; notified it to both the parties vide notice of hearing dated 25-11-2019 issued by the

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

Controller for hearing of objections as well as pre-grant opposition. Thus amended Claims 1-25 and subsequently 1-19 were submitted pursuant to the directions of the Controller per examination report dated 20-6-2019 and hearing notice dated 25-11-2019 under Section 15 read with Rule 55(5) of Patents Act. No Form 13 was submitted. Even otherwise, there is no requirement to submit Form 13 as amendment was made pursuant to the directions of the Controller in exercise of his power and discretion under Section 15 read with Rule 55(5).

26. Since the amendments were made at the asking of the Controller and in the course of examination of application under Section 14, hence no notice was issued by the Controller to the petitioner. Further it is important to note petitioner never raised any objection to the amended Claims 1-25 when it submitted its written submissions dated 28-1-2020. The amended Claims 1-25 were subject-matter of hearing notice dated 25-11-2019 issued to both the parties, fixing the hearing of Controller's objection as well as pre-grant opposition.

27. The Patents Act, 1970 and Patents Rules, 2003 envisage : (a) voluntary amendment sought to be made by an applicant in a specification or a patent document; and (b) the amendment of the specification required to be made by the Controller to his satisfaction. For a voluntary amendment the procedure prescribed is under Sections 57(1) and 57(2) of the Patents Act, 1970 which involve filing of application in the manner prescribed in Rules 81 and 82 of the Rules of Form 13 with payment of prescribed fee vide Entry 20 of Table I of the First Schedule of the Patents Rules, 2003. Such procedure does not apply to the amendment made in the specification to comply with the direction of the Controller issued before the grant of Patent under Sections 14, 15 and Rule 55(5).

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32. Thus, the amendment made during opposition stands on a different footing than the amendment required at the instance of the Controller. In Best Agrolife Ltd. case the impugned order was set aside not only because of an amendment but also on merits. It was held the impugned order was: (a) without any reasoning; and (b) the scope of claim was increased in the amendment as range of thickness was increased from 0.025-05% to 0.05-0.25%. However, the scope of the claims in this case has rather been reduced/merged. Hence to my mind no prejudice is caused to the petitioner with reduced claim from 1-25 to 1-19."

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

30. Mr. Singh further submitted that the decisions which were pressed in aid by the respondents, namely, **Best Agrolife Limited Vs. Deputy Controller of Patents and Another**[13] and **Neon Laboratories Pvt. Ltd. Vs. Troikaa Pharma Limited**[14] are also clearly distinguishable, since both were concerned with voluntary amendments and thus referable to Section 57(1) of the Act. In view of the above, it was submitted that this Court should affirm and reiterate the view taken in *UCB Farchim, Mylan Laboratories and Snehlata Gupte*. Mr. Singh submitted that acceptance of a contrarian view would cause grave prejudice to patent applicants, completely derail the *examination process* and militate against the underlying legislative objective of expeditious disposal of patent applications.

31. Mr. Singh then stated that while the appellant concedes to a right of hearing inhering in favour of an opponent in the case of voluntary amendments that may be introduced by an applicant, the same cannot possibly extend to a right to participate in proceedings which may originate from directives framed by the Controller to amend the application. It was submitted that the Controller had in exercise of powers conferred by Section 14 of the Act issued a notice to the appellant on 25 November 2022 to carry out certain amendments to the claims to its satisfaction after the hearing on the PGOs' had been concluded on 03 November 2022. Mr. Singh pointed out that the Controller required the appellant to delete claims 4 and 5 and thus

[13] 2022 SCC OnLine Del 1982
[14] 2010 SCC OnLine Bom. 1799

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

scheduled a hearing on 02 December 2022. On culmination of that hearing, the Controller allowed retention of claims 4 and 5 albeit with certain amendments. The said claims 4 and 5 as amended were ultimately submitted by the appellant on 05 December 2022. It was on the culmination of this long and arduous journey that the application ultimately came to be granted on 14 December 2022.

32. It was contended by Mr. Singh that the Controller had duly taken into consideration all oppositions as raised while passing the order dated 14 December 2022. Mr. Singh highlighted the fact that as would be evident from a reading of the impugned order itself, the merits of the decision of the Controller was an aspect which was neither raised nor argued before the learned Single Judge. In fact, according to learned counsel, the Single Judge itself had desisted from evaluating the merits of the ultimate decision taken by the Controller and thus restricting the scope of proceedings to natural justice violations alone. According to Mr. Singh, this itself should have constituted sufficient ground for the writ petition not being entertained, since *any person interested* had an alternative and efficacious remedy of mounting a *post-grant opposition*.

33. Insofar as the PGO submitted by the intervener, Dr. Kanchan Kohli is concerned, it was pointed out by Mr. Singh that the same came to be tendered after the conclusion of PGO hearing on 03 November 2022. Mr. Singh submitted that the filing of that opposition a day after hearing on PGOs' had been concluded clearly evidences the mala fide and ulterior motives of that intervener and lending credence to the assertion of the appellant that it was essentially aimed at preventing the

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

Controller from passing orders even after a lapse of 16 years from the date of application and with only four years of the 20-year term being left. It was further pointed out by Mr. Singh that despite the said opposition having been belatedly filed, the Controller in all fairness took due notice of the same and found that Dr. Kanchan Kohli had raised grounds identical to those which had been urged by the other opponents. Those objections, in any case, had been duly examined and evaluated by the Controller. In view of the aforesaid, Mr. Singh would submit that the Controller had acted in accordance with the procedure prescribed under the Act as well as the Rules and had granted the patent application after the appellant had agreed to amend the application to its satisfaction. It was further submitted that NATCO had been granted sufficient opportunity to address its opposition and which was considered and heard by the Controller in hearings which stretched over two full days. Mr. Singh submitted that the challenge which was raised by NATCO in the writ petition did not even satisfy the manifest injustice test and which alone would have warranted interference by the learned Single Judge in exercise of powers conferred by Article 226 of the Constitution. Mr. Singh lamented that the grant already stands delayed by over 16 years out of the entire 20-year term which could have been claimed by the appellant and the impugned order thus causing irreparable prejudice to it.

E. NATCO's SUBMISSIONS

34. Controverting the aforenoted submissions Mr. Sai Deepak, learned counsel appearing for the first respondent urged the following

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

arguments. Mr. Sai Deepak submitted that the moment a PGO comes to be filed and the opponent enters the fray, the opposition proceedings merge and the *lis* becomes adversarial. In view of the above, it was his submission that the opponent must necessarily be involved at every stage of the proceedings. According to learned counsel, the aforesaid would not only be in consonance with the statutory scheme of the Act but also be compliant with the principles of natural justice. It was further submitted that the window which is created in terms of Section 25(1) of the Act enables an opponent to submit a PGO at any time up to the stage of grant. According to learned counsel there would, therefore, be no justification for the opponent to be excluded or insulated from the amendments that may be suggested by the Controller in the course of the *examination process*. Mr. Sai Deepak also laid stress upon the fact that the PGO applicant has no right of appeal under Section 117A of the Act. This, according to learned counsel, would reinforce the submission of the respondents that all opponents must be accorded due opportunity to participate in every facet of the *examination process*. Mr. Sai Deepak also highlighted the fact that *UCB Farchim* while noting the absence of an appeal being provisioned for in Section 117A had traced orders that may be passed on a PGO and against the applicant being traceable to Section 15 of the Act. It was in the aforesaid context that it was contended that this too would clearly indicate that the Section 25(1) proceedings merge with Section 15 and thus the contention to the contrary as addressed by the appellants liable to be negated. It was also submitted by Mr. Sai Deepak that all

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

amendments whether made suo moto by the applicant or those directed by the Controller are liable to be published on the official website. This according to Mr. Sai Deepak would be an additional element indicative of the right of the opponent to participate in proceedings that may be drawn by the Controller.

35. Proceeding then to the provisions contained in Rule 55(1-A) Mr. Sai Deepak submitted that the aforesaid provision mandates that no patent shall be granted before the expiry of six months from the date of its publication. According to Mr. Sai Deepak the aforesaid window stands constructed in order to enable the opponent to file its representation by way of opposition and be afforded sufficient opportunity to oppose the grant of the patent. All these steps, according to Mr. Sai Deepak, stand statutorily laid in place to assist and aid the Controller in the *examination of the patent application*.

36. It was submitted that Rule 55(3) obliges the Controller to consider the representation that may be submitted by an opponent and to issue notice thereon if in its opinion the said representation raises issues warranting consideration. Learned counsel submitted that if the Controller upon consideration of the representation come to form the opinion that a case has been made out either for the application to be rejected or amendments being directed in the complete specification, to issue notice to the applicant. Taking the Court through the various steps envisaged in Rule 55, Mr. Sai Deepak highlighted the fact that the inquiry which the Controller undertakes in connection with a representation is comprehensive and would involve consideration of

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

various facets such as the representation including the statement and evidence filed by the opponent, submissions addressed by parties and the statement and evidence that may be led by the applicant itself. According to learned counsel it is on a consideration of all of the above that the Controller ultimately proceeds to either reject the representation or alternatively require the complete specification and other documents to be amended to its satisfaction before the patent is granted or refused. It is in the aforesaid backdrop that learned counsel submitted that till such time as the patent is granted, the PGO remains alive and consequently the opponent being recognized to have the right to participate at each and every stage of the proceedings.

37. It was submitted that Rule 55(5) uses the expression "*after hearing the parties*". According to Mr. Sai Deepak the adoption of the aforesaid words in the plural would also be indicative of the adversarial nature of the inquiry and thus making it abundantly clear that the principles of natural justice as applicable to any other *lis* of an adversarial character applying with equal force to the subject proceedings.

38. It was further submitted by Mr. Sai Deepak that the power to require an amendment as enshrined in Section 15 of the Act would be deprived of character if the material which is placed before the Controller in terms of Rule 55 were to be excluded from consideration. The submission essentially was that the decision on the question of whether a specification requires amendment or not would be indelibly connected to the inquiry conducted under Rules 55(3) and 55(5). This

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

too, according to Mr. Sai Deepak, is a reiteration of the statute recognizing the right of the opponent to be made a party at all stages of the *examination process*. Mr. Sai Deepak submitted that the right of participation as claimed by NATCO is further strengthened by the observations appearing in the **Ayyangar Committee Report**[15] on revision of the patent law and which had highlighted the balance liable to be struck between the monopoly secured by grant of a patent and public interest on the other. Mr. Sai Deepak laid stress upon the following passages as appearing in that report:-

> "**210.** Stated broadly an opposition proceeding constitutes an extension of the investigation undertaken by the Examiner. No doubt there are some grounds open in an opposition proceeding which are not the subject of scrutiny by the Examiner, for instance the ground of prior public user but these are matters of mere detail. What I desire to emphasise is that the history of the patent legislation of the U.K. shows that new matters for examination, and necessarily for opposition have been added from time to time and there has never been any change in the reverse direction, of diminishing the scope of examination or opposition. It is in the light of this history that I consider the proposal of the Committee a retrograde one. I might at this stage refer to the extension of the grounds of opposition in the U.K. by the Patents Act of 1949 by which an objection on the score of "obviousness" or "lack of subject-matter" was brought in. This was based on the acceptance of the recommendation of the Swan Committee. In their second interim report the Committee referred to the representations made to them that the scope of the grounds of opposition ought to be enlarged, to comprehend "subject matter". They accepted the force of these representations and expressed themselves thus:— "To grant a patent, even though it may be subsequently revoked, for something which quite obviously possesses no inventive merit whatever, is prima facie contrary to public policy and contrary to the purpose of the patent law, whose object has always been to encourage genuine inventions without imposing undue restraint upon normal industrial development. Against this, it is urged by those who object to any extension of the

[15] Ayyangar Report

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

Comptroller's powers in this direction, that little or no harm is done by the continuance of such a practice. We are not convinced of the truth of this plea. The evidence we have heard satisfies us of the fact that people are deterred by the risk that legal proceedings for infringement may involve so serious an expense to the defendant as to deter him from challenging the patent. Thus, an obviously invalid patent may act as a formidable deterrent, and discourage a manufacturer from pursuing research, or from adopting improvements in methods of manufacture which involve nothing more than the application of the normal technique and skill of those experienced in the art." "The Patent Offices of the principal industrial countries, particularly those of the United States, Germany, Sweden and Holland have power to refuse applications for patents, which, in their opinion, are lacking in subject matter....Several witnesses have expressed the view that patents granted by the Patent Offices of countries which in addition to making a wide investigation for novelty, take the question of subject-matter into account have a higher validity value and therefore a better chance of commercial exploitation than the patents granted in countries where the question of subject matter is not considered.... Incidentally it may be observed that the investigation for novelty, which today is an accepted and valued feature of our patent system, was when first proposed before the Fry Committee of 1900, strongly opposed by a number of witnesses as likely to be an expensive and dangerous innovation....As a logical corollary to our recommendation that the Comptroller should have power to reject an application on the ground of lack of subject-matter, it follows that he should similarly have power to refuse the grant of a patent on the same ground in opposition proceedings.

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213. In cases where an opposition is entered, the grant of a patent would necessarily be delayed, but the question is one of balancing the benefit which accrues to the public from a successful opposition eliminating a possible invalid patent and the inconvenience or hardship caused to an applicant for a legally patentable invention not being quickly sealed because of an opposition. In considering this it has to be borne in mind that under the law the rights of a patentee start from the publication of the complete specification though a suit for infringement could not be filed till the patent is granted. After setting off the one against the other, patent laws in most of the countries of the World which follow the examination system, have provided for an opposition as conducive to public interests and I am unable to see any condition in India to militate against the

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

application of this rule. I consider that the views of the Committee were greatly coloured by those assumptions none of which I consider wellfounded—first, that a very large number of applications were opposed; secondly, that most, if not all, of them were unsuccessful and thirdly, these oppositions were mala fide, and that this procedure has been utilised to blackmail bona fide applicants, particularly those with slender resources, the assumption being that the parties who raised the opposition were rich corporations who blocked the immediate grant of patents by demanding improper concessions as a ground for withdrawing their opposition. I do not find from any of the memoranda submitted to the Committee any representation regarding mala fide use of opposition proceedings."

39. Learned counsel then submitted that no examination of the application which may have a bearing upon the PGO filed by an opponent can possibly be undertaken by the Controller without placing the opponent on notice. It was his submission that in the absence of the Act expressly or by necessary implication excluding application of the principles of natural justice, those inherent rules of procedure and fair-play must be recognized to apply with full vigor. Mr. Sai Deepak also sought to draw sustenance from the following observations as appearing in the judgment rendered *inter partes* on 12 July 2022:-

"19. The proceeding in a pre-grant opposition and simultaneous examination of a patent application, however, cannot also result in a situation where the pre grant opponent is kept in dark about the developments taking place in the examination process. For example, when amendments are filed by the Applicant, an immediate decision ought to be taken on allowing or disallowing the amendment so that there is transparency and clarity as to what are the claims being considered by the Controller. A short and brief order should be passed in respect of the amendments which should be uploaded on the website of the Patent Office so that everyone concerned would know the decision on the amendment. In any event, if an amendment is being carried out during the pendency of a pre-grant opposition, the ruling on the amendment ought to be sent to the pre-grant opponent as well. Sometime amendments are

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

> carried out during the course of hearings across the table as well, when the patent agent of the Applicant attends the hearing before the Controller. In such a scenario, the Controller ought to examine the said amendments and convey the decision to the Applicant, and if the Opponent is present, even to the Opponent."

40. It was further contended that the interpretation liable to be accorded to the statutory provisions aforenoted and the rights that may be claimed by an opponent were exhaustively considered and explained by the Bombay High Court in **Neon Laboratories Pvt. Ltd. & Ors. vs. Troikaa Pharma Limited & Ors**[16]. Mr. Sai Deepak stressed upon the following passages of that decision:

> "**43.** It is, therefore, clear 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. The grounds are also enumerated in the provision. 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. The distinction made by Mr. Kadam that opportunity is restricted only to the contents of the original application and there is no requirement of giving further hearing; makes the exercise meaningless and it would be then very easy to defeat Section 25(1). In this context, it must be understood that the opposition under Section 25(1) is to the "grant of a patent" The grant is on an application made in that behalf, which itself is duly published. 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, as in this case, 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. That is the scheme of Section 25(1) and Rule 55 which are to be considered and read together.

[16] 2010 SCC OnLine Bom 1799

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

44. The requirement of hearing, if requested, would be nullified if the Controller is only obliged to hear the person opposing the grant on the contents of the original application. As has been done in the instant case, the Applicant would go on amending the original application after initial hearing, the patent would be granted on the basis of such amended claims and that too behind the back of any person objecting or opposing the grant. In other words, the Controller may call upon the Applicant to amend the application or provide detailed specifications. That he may do by inviting attention of the Applicant to the contents of the original application and documents supporting the same. In compliance with such communication from the Controller, the original Applicant may promptly furnish set of amendment to the original application and also forward further specifications by way of documents. The person opposing the grant would have no knowledge of such a step taken by the Controller. He would be taken by surprise thereafter, if the grant is made on the basis of the amended claims. If Mr. Kadam's argument is to be accepted, then, the only opportunity to object to such a course is to apply for revocation of grant in terms of Section 25(2). However, revocation is also restricted and the grounds of revocation are set out in sub-clauses (a) to (k) of Section 25(2). Therefore, alleging that the patent was wrongfully obtained and must, therefore, be revoked, is no opportunity contemplated by Section 25(1). That is an opportunity prior to the grant. The grant may be revoked on the same grounds under Section 25(2) but by that itself and without anything more, it cannot be held that the only remedy available to the persons like the Petitioner to challenge the grant on the basis of the amended specifications is to apply for revocation in terms of Section 25(2). Before us on facts it is not disputed by the Controller that the amendment was made to the original application. The Petitioner has demonstrated by way of affidavits in rejoinder and further affidavits that there was indeed a departure from the original claim. The distinction as pointed out, in the statement annexed to the rejoinder, between the original and amended claims, would go to show that the Petitioner had no opportunity to meet the contents of the amended claims at all.

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52. In our view, in this case, it is not necessary to examine in further details, the aspect as to whether the breach of principles of natural justice would vitiate the proceedings to such an extent as would render the final order void. As far as our Courts are concerned, the settled view is that if the principles of natural justice are violated, the order is procedurally ultra-vires and therefore,

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

> suffers from a jurisdictional error. Such an error is required to be corrected and is capable of being corrected by a writ of certiorari under Article 226 of the Constitution of India. The power of judicial review is conferred precisely to set right such errors. Therefore, we can safely conclude that in this case the impugned order does not create any right in favour of the Respondent No. 1 and the grant of patent, therefore, cannot be said to be valid."

41. In view of the above learned counsel submitted that whenever any amendment is carried out by an applicant, be it voluntary or one made pursuant to a directive of the Controller, it would require the opponent being afforded due opportunity to oppose and any amendment which proceeds towards grant without notice to the opponent would be violative of the principles of natural justice. On facts it was submitted by Mr. Sai Deepak that a close reading of the Notice dated 25 November 2022 would establish that the Controller did not require any amendments and the objections which were raised were with respect to Sections 2(1)(j) and 3(d) of the Act. In view of the above, learned counsel would contend that the amendments suggested by the appellant must be viewed as voluntary as opposed to those which may have been mandated by the Controller in exercise of powers conferred by Section 15 of the Act. In view of the above, learned counsel submitted that Sections 57 and 59 of the Act were clearly attracted and the acceptance of the amendments without any notice to the opponents was a procedure which is clearly violative of the Act and Rules and rightly quashed by the learned Single Judge. Mr. Sai Deepak also sought to distinguish the decision rendered by the Court in *Haryana Pesticides* by highlighting the fact that the amendments carried out by the applicant in that case were in compliance of directions issued by the Controller.

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

42. Proceeding then to underline the prejudice caused to NATCO, Mr. Sai Deepak submitted that in the hearing which was conducted on 05 September 2022 there were eight claims of which claim 4 related to the crystalline form of the alleged invention claimed in claim 1 while claim 5 was a use claim. It was submitted that after the claims came to be amended on 14 December 2022, claim 4 was deleted. However, according to Mr. Sai Deepak, no corresponding amendment to claim 1 in the form of a disclaimer was introduced. It was in the aforesaid context that it was submitted that since the crystalline form still remained within the scope of claim 1, the objection of the Controller and resting on Section 3(d) of the Act was still not overcome. Mr. Sai Deepak submitted that the submission of the appellant that deletion of claim 4 does not affect the scope of claim 1 and thus no prejudice being caused is clearly erroneous and is asserted in ignorance of the principal contention of the respondent that it had been denied the opportunity to present its views before the Controller with respect to deletion of claim 4 and the absence of a corresponding limitation in claim 1. It was in light of the aforesaid submissions that Mr. Sai Deepak urged us to dismiss the appeal.

F. STAND OF INDIAN PHARMACEUTICAL ALLIANCE

43. Appearing for the intervener, Indian Pharmaceutical Alliance, Mr. Nayar, learned senior counsel addressed the following submissions. It was at the outset pointed out by Mr. Nayar that undisputedly the notice under Section 14 of the Act came to be issued by the Controller after hearing on the PGOs' had been concluded and orders stood

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

reserved. It was submitted by learned senior counsel that this in itself was proof of a violation of the principles of natural justice and the adoption of a procedure contrary to the statutory mandate. Mr. Nayar highlighted the fact that even if Section 14 of the Act were to be strictly interpreted, the principles of natural justice would require that all amended claims be brought to the notice of opponents and thus affording them an opportunity to place additional objections for the consideration of the Controller. According to Mr. Nayar for the purposes of the PGO proceedings being conferred context and meaning, it was imperative for the Controller to have placed the opponents on notice.

44. It was the submission of Mr. Nayar that the distinction which is sought to be canvassed by the appellant between voluntary amendments and those directed by the Controller is not only artificial but also erroneous and irrational. According to learned senior counsel, the rationale for an opportunity of hearing to the opponent remains the same irrespective of the trigger event pertaining to the proposed amendment. Mr. Nayar contended that till such time as the opposition proceedings have not been finally adjudicated upon, no claims for amendment can possibly be accepted or directed without the opponent being afforded a chance to object.

45. Mr. Nayar while addressing submissions on the aforenoted lines also drew our attention to the following decisions rendered by the Appeals Tribunal in England albeit in the context of the Patents Act, 1949. Mr. Nayar firstly referred to **Gottfried Reuter's Patent**

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

Application[17]. We deem it apposite to extract the following passages from that decision hereinbelow:

> "Amendment is of course entirely a matter of discretion. In my view in circumstances such as these it must be entirely wrong for any tribunal to proceed to consider fresh amendments unless the fullest opportunity has been given to all parties 15 concerned to reconsider their position in relation to the fresh amendments, which may of course necessarily involve an adjournment of the proceedings and may involve the imposition of some terms as to costs. It was in my view quite wrong ever to have proceeded to consider the less restricted amendments that were offered by counsel at the hearing.
>
> The superintending examiner in fact found that these amendments were not acceptable for reasons which I have already indicated. I have been asked by the only opponent who argued the point on appeal to uphold his decision. I am however going to reject this appeal upon this broader ground, that it would be quite wrong ever to encourage an applicant to proceed in the way this applicant did in fact proceed. I am aware of the fact that he himself appreciated that there were difficulties in the first instance. He pointed out, I think with some justice, that he was placed in an embarrassing position by the conditional acceptance. Subsequent to the conditional acceptance and prior to the hearing it appears to me that the matter had become unconditional, both so far as he and the other opponents were concerned, and I do not think in all the circumstances it would necessarily ever have been right to allow him to resile from the more limited claim which he originally offered in the counterstatement. I am however quite clear in this that as a matter of discretion it would be wholly wrong for me on appeal to allow him to proceed with the less restricted amendment which he now seeks to secure, and upon this ground I dismiss his appeal.
>
> The question is then inevitably going to arise as to how this matter is further to proceed. It may be that after a further consideration of this decision and the interim decision-the applicant must be able to consider what further amendment if any he wants-the applicant will put forward some limited amendment, not less 40 limited than the original amendment which they offered in their counterstatement which will prove acceptable to I.C.I. and possibly, for all I can tell, to the other opponent. It may be he will desire to take some other course. I would however say only this. So far as the

[17] Reports of Patent, Design and Trade Mark Cases, Volume 90, Issue 4, 31 May 1973, Pages 83–90

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

position of I.C.I. is concerned I consider that they are still opponents to this appeal and unless hereafter the applicant produces some limited amendment which they are prepared to accept, if the hearing be allowed to proceed upon some other basis they should be given full opportunity to enter upon the securing of such evidence as they may feel the circumstances require. In the same way if the matter is to proceed along some broader basis the opponents Farbenfabriken Bayer must have the like opportunity to reconsider and if necessary enlarge upon the evidence they have already filed."

46. Mr. Nayar also referred to **Mansfeld Hutten-Kombinat's Application**[18] the relevant parts whereof are extracted hereinbelow: -

"It then became necessary for the hearing officer to examine the objections of prior publication and obviousness, and, with the laudable desire to saving time and effort in the further prosecution of the application, he treated the specification as notionally amended in the five respects which he had approved, but, instead of omitting entirely the amendment (3) which he had refused, he substituted for it a restriction which he originated. This enabled him to feel satisfied that the objection of prior publication 'had been overcome and, as the opponents had not argued the objection of obviousness against the specification as it originally stood, or as the applicants had sought to amend it, he felt justified in dismissing both grounds of opposition.

It is plain that 'herein lies the potentiality of an unfairness to the parties, to the applicant in that he is saddled with an amendment he may not welcome, and more particularly to the opponent who has 'had no opportunity to develop his objection to the specification containing this newly proposed amendment, It is I think plain that an opponent is entitled to know the form of the document being considered for grant 'before his opposition is dismissed. Particularly is this so in the present case, for, as the hearing officer found, the only possible distinction from the cited publication rested in the tangential introduction of the oxygen containing gas, so that both the objections of lack of novelty and inventiveness would necessarily turn upon the effectiveness of the proposed amendment to define it, and the scope of the distinction when so defined.

In the circumstances, the dismissal of the opposition, whether

[18] Reports of Patent, Design and Trade Mark Cases, Volume 85, Issue 13, 28 November 1968, Pages 377–383

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

> it was intended to be actual or conditional, should be revoked. The hearing officer's directions with regard to the consideration of an application for further 'amendment should still be proceeded with. As to the future course of the proceedings, the hearing officer has rightly reserved determination to himself. Provided it includes a hearing at which the parties may develop the issues raised in the opposition in relation to a precisely formulated specification, I should regard it as adequate."

47. Mr. Nayar then sought to buttress his submissions by inviting our attention to the judgment in **VEB Pentacon Dresden Kamera-und Kinowerke's Application**[19] and to the following observations as appearing then: -

> "As the proposals were put forward, they were commented on by the opponents.
>
> At one time and another there were hearings and eventually a point was reached at which a hearing took place upon proposals which had been put forward by the applicants which were described by the superintending examiner in the decision as "conceptually similar" to certain amendments upon which he gave his final decision. It is quite plain, and indeed it is accepted by the applicants that at the last hearing before the final decision no precise amendment had been formulated which argument could be directed upon the issue as to whether the specification as amended would overcome the objections of prior publication and obviousness. The complaint of the opponents in this case is that they have not been afforded the opportunity which they should have had to deal with any final form of amendment at all."

48. It would be appropriate to pause here and note that the decisions cited by Mr. Nayyar were rendered in the context of the Patents Act, 1949. However, and which fact was fairly conceded by Mr. Nayyar, the regime relating to third party opposition has itself undergone a significant legislative change as would be evident from a reading of the

[19] Reports of Patent, Design and Trade Mark Cases, Volume 88, Issue 15, 18 November 1971, Pages 368–373

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

relevant provisions which form part of the Patents Act, 1977. Of significant import are the provisions contained in Section 21(2) and which declares that the mere filing of observations would not lead to such an applicant becoming ***"…..a party to proceedings under this Act before the comptroller."*** We deem it apposite to extract the provisions which would have some bearing on this aspect hereinbelow: -

> "**19 General power to amend application before grant.**
> (1)At any time before a patent is granted in pursuance of an application the applicant may, in accordance with the prescribed conditions and subject to section 76 below, amend the application of his own volition.
> (2)The comptroller may, without an application being made to him for the purpose, amend the specification and abstract contained in an application for a patent so as to acknowledge a registered trade mark.
>
> **21 Observations by third party on patentability.**
> (1)Where an application for a patent has been published but a patent has not been granted to the applicant, any other person may make observations in writing to the comptroller on the question whether the invention is a patentable invention, stating reasons for the observations, and the comptroller shall consider the observations in accordance with rules.
> (2)It is hereby declared that a person does not become a party to any proceedings under this Act before the comptroller by reason only that he makes observations under this section.
>
> **27 General power to amend specification after grant.**
> (1)Subject to the following provisions of this section and to section 76 below, the comptroller may, on an application made by the proprietor of a patent, allow the specification of the patent to be amended subject to such conditions, if any, as he thinks fit.
> (2)No such amendment shall be allowed under this section where there are pending before the court or the comptroller proceedings in which the validity of the patent may be put in issue.
> (3)An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

> (4)The comptroller may, without an application being made to him for the purpose, amend the specification of a patent so as to acknowledge a registered trade-mark.
> (5)A person may give notice to the comptroller of his opposition to an application under this section by the proprietor of a patent, and if he does so the comptroller shall notify the proprietor and consider the opposition in deciding whether to grant the application.
> (6)In considering whether or not to allow an application under this section, the comptroller shall have regard to any relevant principles applicable under the European Patent Convention.]"

49. Mr. Nayar then submitted that the allegation of the opponents having delayed the conclusion of the examination proceedings is factually incorrect and an argument of prejudice. According to learned senior counsel, the consideration of the grant was delayed on account of the numerous amendments sought by the appellant itself and which fact had been duly noticed in the previous round of litigation. The aforesaid submission was addressed in the backdrop of the learned Single Judge having found in the judgment rendered on 12 July 2022 that both parties were to be blamed for the delay which occurred in the grant of the patent and that the appellant was equally culpable in contributing to the delay on account of the multiple amendments that were proposed by it. In any case, according to learned senior counsel the *Ayyangar Report* itself had taken note of the delay which is likely to occur while a patent application is being scrutinized. However, according to Mr. Nayar the salutary purpose which underscores the *opposition process* is far greater and clearly outweighs the time that may be spent in the course of consideration of the patent application.

50. The decision of the Single Judge in **NATCO Pharma vs. Union**

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

of India[20] was also pressed into aid with Mr. Nayar highlighting the observations appearing therein and where the learned Judge had an occasion to observe that a PGO and simultaneous examination of a patent application cannot result in a situation where the pre-grant opponent is kept in the dark with respect to developments taking place in the *examination process*. The participation of the opponent in all facets relating to the *examination process* would, according to Mr. Nayar, also act in aid of transparency and clarity and thus facilitate the Controller in arriving at a correct and just decision.

51. On facts, Mr. Nayar submitted that providing an opportunity to the opponents to oppose a particular set of amendments and thereafter a unilateral hearing being held cannot possibly be countenanced and the Court would thus be justified in holding that the principles of natural justice had in fact been violated. Mr. Nayar also placed heavy reliance on Rule 55 and more particularly sub-rules (3), (4) & (5) thereof and submitted that the aforenoted statutory provisions are indicative of the legislative intent being to keep the opponent informed of all developments after a PGO is filed and till it is ultimately disposed of. Mr. Nayar laid stress on Rule 55(4) and which also envisages copies of all filings being provided to the opponent. Learned senior counsel also highlighted the provisions enshrined in Rule 55(5) and which mandates the Controller to take a final decision after considering submissions and upon affording an opportunity of hearing to parties. According to Mr. Nayar, the very fact that the Controller is to decide all PGOs' as well as

[20] W.P. (C)- IPD 91 of 2021

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

the application itself simultaneously would underscore the imperative of the Court recognizing the right of the opponent to be placed on notice.

52. While summing up, Mr. Nayar submitted that the obligation of the Controller to place the opponent on notice may be tested in the background of various contingencies that may ensue in the course of the *examination process*. According to Mr. Nayar where no objections are filed at all there would really be no need to issue a notice. However, once objections come to be preferred, opponents enter the fray and in such a contingency there would exist no justification for their exclusion from any component of the *examination process*. Mr. Nayar further submitted that the amendments introduced in Section 57(3) are intended only to ensure that the process of PGO does not become unwieldy. Learned senior counsel submitted that amendments in any case do not take away the right of those who had already moved objections under Section 25(1) of the Act.

G. THE OPPOSITION BY DR. KANCHAN KOHLI

53. Ms. Rajeshwari, learned counsel appearing for Dr. Kanchan Kohli, drew our attention to the undisputed fact that although the said applicant had filed objections on 04 November 2022, no opportunity of hearing was afforded to the objector. Learned counsel submitted that although the PGO hearing was concluded on 03 November 2022, admittedly the Controller issued a notice under Section 14 only on 25 November 2022 and whereafter amended claims were submitted by the

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

appellant on 05 December 2022. Ms Rajeshwari underlined the fact that the application ultimately came to be granted only on 14 December 2022. According to learned counsel, there was thus no justification for the Controller having devised an opportunity of hearing to the applicant.

54. Ms. Rajeshwari further submitted that the acceptance of the contentions as canvassed by the appellant would essentially amount to the Court holding or recognizing an exclusion of the natural justice principle. It was her submission that the law in fact mandates to the contrary and has consistently held that the principles of natural justice must inform all statutory provisions unless the Legislature chooses to specifically exclude them.

H. IMPACT OF AMENDED SECTION 57

55. It becomes pertinent to note that during the course of oral submissions, certain issues were raised revolving around the amendments which came to be introduced in Section 57. The manner in which Section 57 came to be amended from time to time has already been noticed in the prefatory parts of this judgment and is thus not being repeated here.

56. Mr. Guruswamy Nataraj, however, submitted that notwithstanding the amendments so introduced, they would not detract from the right of an opponent to participate at every stage of the *examination process*. Mr. Nataraj submitted that in order to appreciate the imperatives underlying the amendments which came to be

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

introduced in 2005 in that provision, it is necessary to bear in mind the fact that the unamended Act was a restrictive legislation and not in conformity with India's commitment to amend its patent legislation and bring it in line with the TRIPS Section of the General Agreement on Trade and Tariffs. Mr. Nataraj highlighted the fact that under the unamended Patent Act, claims as accepted or amended became known to the public only after advertisement of acceptance and thus could be opposed only thereafter and that too only by a *person interested*. The amendments which came to be introduced between 1999 and 2005, according to Mr. Nataraj, were aimed at balancing the rights of patents applicants and those of third parties. This, according to learned counsel, would be manifest from the following significant changes which came to be introduced:

> "a. Providing patent protection for all categories of technologies [Sec. 5 was deleted in toto]
>
> b. 20 years patent protection from date of filing [Sec. 53 (1), UPA].
>
> c. Automatic publication, i.e., advertisement of what is sought to be protected [Sec. 11A, UPA] – and this includes all details subsequently as well including any claim amendments at any stage, any examination reports under Sec. 14, any hearing notice u/sec 14 and Sec. 15, any responses including any amendments to claims etc., in response, any oppositions filed etc. [in fact all matters which form part of the official file were public except the report of the Examiner u/Sec. 14 to the Controller [Sec. 144, UPA as well as Sec. 145, UPA]. Please see ANNEXURE c – Patent Office Journal of 06.10.2023 – Extracts – submitted herewith as a sample of what is published now.
>
> d. Critically, while product patents were introduced, safeguards against evergreening were also introduced vide Sec. 3(d), sec. 53(4) etc., and the introduction of the PreGO mechanism u/Section 25(I) regulated by the procedure in Rule 55 (originally Rules 55(1) to 55(6), now Rule 55(1) to 55(5)].

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

> e. Equally critically, while PoGO was limited to "person interested" there is no such limitation as to who can assist the Controller/IPO during examination via a Sec. 25(1) proceeding i.e., in a PreGO-this can be "any person".

57. According to Mr. Nataraj it is for the aforesaid reason that Section 57(3) and (4) refer to publication of amendments after grant. It is in the aforesaid backdrop that learned counsel contended that the statute now contemplates a person having the right to be made aware of amendments that are being proposed at any stage. This right, according to Mr. Nataraj, would extend even after a PGO hearing has concluded and orders may have been reserved. According to learned counsel the changes introduced in sub-sections (3) and (4) of Section 57 are only designed to make adequate provisions bearing in mind the 18 months period within which claims are to be made public. Mr. Nataraj additionally assailed the proceedings as drawn by the Controller and insofar as it chose not to upload the Hearing Notice of 02 December 2022 or the amendments which were offered by the appellant. It was submitted that undisputedly those documents were placed in the public domain only after the final decision had been uploaded and thus being evidence of an egregious violation of the Act and the Rules.

I. THE EXAMINATION PROCESS

58. Having noticed the erudite submissions that were addressed before us, we at the outset deem it appropriate to discern the underlying principles of the statute, the legislative history and the salient statutory provisions on the anvil of which the question posited would have to be answered.

59. Chapter IV of the Act incorporates various provisions pertaining

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

to publication and examination of applications. Section 11A of the Act prescribes that no application for a patent shall ordinarily be opened to the public for such period as may be prescribed. In terms of Section 11A (2) & 11A (3), the applicant is enabled to request the Controller to publish its application at any time prior to the expiry of the period prescribed in terms of sub-section (1) of Section 11A. Subject to the contingencies which are spoken of in sub-section (3), the application comes to be published. The prescription of periods which are spoken of in Section 11A (1) are governed by Rules 24 and 24A. Rule 24 stipulates that the period for which the application for grant of a patent shall not ordinarily be opened to the public shall be 18 months. A request for publication as contemplated under Section 11A (2) is to be made in Form 9 as appended to those Rules. Section 11A(5) then speaks of the particulars which must accompany every application made for advertisement. Section 11A of the Act reads thus:

> **11A. Publication of applications**.—
>
> (1) Save as otherwise provided, no application for patent shall ordinarily be open to the public for such period as may be prescribed.
>
> (2) The applicant may, in the prescribed manner, request the Controller to publish his application at any time before the expiry of the period prescribed under sub-section (1) and subject to the provisions of sub-section (3), the Controller shall publish such application as soon as possible.
>
> (3) Every application for a patent shall, on the expiry of the period specified under sub-section (1), be published, except in cases where the application—
>
> (*a*) in which secrecy direction is imposed under Section 35; or

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

(*b*) has been abandoned under sub-section (1) of Section 9; or

(*c*) has been withdrawn three months prior to the period specified under sub-section (1).]

(4) In case a secrecy direction has been given in respect of an application under Section 35, then it shall be published after the expiry of the period [prescribed under sub-section (1)] or when the secrecy direction has ceased to operate, whichever is later.

(5) The publication of every application under this section shall include the particulars of the date of application, number of application, name and address of the applicant identifying the application and an abstract.

(6) Upon publication of an application for a patent under this section—

(*a*) the depository institution shall make the biological material mentioned in the specification available to the public;

(*b*) the patent office may, on payment of such fee as may be prescribed, make the specification and drawings, if any, of such application available to the public.

[(7) On and from the date of publication of the application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for the invention had been granted on the date of publication of the application:

Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been granted:

Provided further that the rights of a patentee in respect of applications made under sub-section (2) of Section 5 before the 1st day of January, 2005 shall accrue from the date of grant of the patent:

Provided also that after a patent is granted in respect of applications made under sub-section (2) of Section 5, the patent-holder shall only be entitled to receive reasonable royalty from such enterprises which have made significant investment and were producing and marketing the concerned product prior to the 1st day of January, 2005 and which continue to manufacture the product covered by the patent on the date of grant of the patent and no infringement proceedings shall be instituted against such enterprises."

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

60. The process of examination commences upon a request in that regard being made by the applicant in the prescribed manner and in accordance with Section 11B of the Act. Section 11B of the Act is reproduced hereunder:

> "**11-B. Request for examination**.—
>
> (1) No application for a patent shall be examined unless the applicant or any other interested person makes a request in the prescribed manner for such examination within the prescribed period.]
>
> (2) [* * *]
>
> (3) In case of an application in respect of a claim for a patent filed under sub-section (2) of Section 5 before the 1st day of January, 2005 a request for its examination shall be made in the prescribed manner and within the prescribed period by the applicant or any other interested person.
>
> (4) In case the applicant or any other interested person does not make a request for examination of the application for a patent within the period as specified under sub-section (1) 60[* * *] or sub-section (3), the application shall be treated as withdrawn by the applicant:
>
> Provided that—
>
> > (i) the applicant may, at any time after filing the application but before the grant of a patent, withdraw the application by making a request in the prescribed manner; and
> >
> > (ii) in a case where secrecy direction has been issued under Section 35, the request for examination may be made within the prescribed period from the date of revocation of the secrecy direction."

61. On the receipt of such a request, the Controller by virtue of Section 12 of the Act, refers the application to an examiner for submission of a report in respect of the matters prescribed therein. Section 12 of the Act stands incorporated in the following terms:

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

"**12. Examination of application**.—

(1) When a request for examination has been made in respect of an application for a patent in the prescribed manner under sub-section (1) or sub-section (3) of Section 11B, the application and specification and other documents relating thereto] shall be referred 64[at the earliest] by the Controller to an examiner for making a report to him in respect of the following matters, namely:—

(a) whether the application and the specification 65[and other documents] relating thereto are in accordance with the requirements of this Act and of any rules made thereunder;

(b) whether there is any lawful ground of objection to the grant of the patent under this Act in pursuance of the application;

(c) the result of investigations made under Section 13; and

(d) any other matter which may be prescribed.

(2) The examiner to whom the application and the specification [and other documents relating thereto] are referred under sub-section (1) shall ordinarily make the report to the Controller within 67[such period as may be prescribed."

62. Pursuant to that reference and in accord with Section 12(1)(c) of the Act, the examiner is obliged to undertake an investigation to ascertain whether the application would fall foul of anticipation by previous publication or by a prior claim. Section 13 of the Act is reproduced hereinbelow:

"**13. Search for anticipation by previous publication and by prior claim.—** The examiner to whom an application for a patent is referred under Section 12 shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification—

(a) has been anticipated by publication before the date of filing of the applicant's complete specification in any specification filed in pursuance of an application for a

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

patent made in India and dated on or after the 1st day of January, 1912;

(b) is claimed in any claim of any other complete specification published on or after the date of filing of the applicant's complete specification, being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.

(2) The examiner shall, in addition, make such investigation [* * *] for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been anticipated by publication in India or elsewhere in any document other than those mentioned in sub-section (1) before the date of filing of the applicant's complete specification.

(3) Where a complete specification is amended under the provisions of this Act before [the grant of a patent], the amended specification shall be examined and investigated in like manner as the original specification.

(4) The examination and investigations required under Section 12 and this section shall not be deemed in any way to warrant the validity of any patent, and no liability shall be incurred by the Central Government or any officer thereof by reason of, or in connection with, any such examination or investigation or any report or other proceedings consequent thereon."

63. Section 14 of the Act then sets out the procedure that is liable to be followed by the Controller and the directions that may be issued by that authority once a report of the examiner is received. That provision stands couched in the following terms:

"**14. Consideration of the report of examiner by Controller**.— Where, in respect of an application for a patent, the report of the examiner received by the Controller is adverse to the applicant or requires any amendment of the application, the specification or other documents to ensure compliance with the provisions of this Act or of the rules made thereunder, the Controller, before proceeding to dispose of the application in accordance with the provisions hereinafter appearing, shall communicate as expeditiously as possible the gist of the objections to the applicant and shall, if so required by the applicant within the prescribed

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

period, give him an opportunity of being heard."

64. As would be manifest from a reading of Section 14, the Controller may require the applicant to attend to the objections that may have been noticed and form part of the **First Examination Report**[21] as also to take remedial action in case the FER recommends appropriate amendments being carried out either to the application or the specification and other documents accompanying the same. The power to frame a direction to amend, as contemplated under Section 14, essentially flows from the report of the examiner. However, and independent thereof, the Controller could direct amendments to an application in terms of Section 15 if it be satisfied that such modifications are warranted and would obviate a refusal of the application as a consequence of the applicant failing to abide by those directives. The said provision reads as under:

> "**15. Power of Controller to refuse or require amended applications, etc., in certain cases**.—Where the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may refuse the application or may require the application, specification or the other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application and refuse the application on failure to do so.]"

65. The examination of applications is further regulated by Rule 24B which sets out the procedure for evaluation of an application as well as Rule 28 which amplifies and resonates the provisions embodied in Sections 12 and 13 of the principal Act. Rule 28 also enables the

[21] FER

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

applicant to assail any objection that may be pointed out by the Controller and question a directive requiring him to amend specifications. The Proviso to Rule 28(2) requires the intent to raise an objection being communicated ten days prior to the period prescribed in Section 21(1). Sub-Rules (3), (4) & (5) of Rule 28 set out the procedure liable to be adhered to in case a request for hearing comes to be lodged in accordance with sub-rule (2). Rule 28 is reproduced hereinbelow:

> **"28. Procedure in case of anticipation by prior publication**.— (1) If the Controller is satisfied after investigation under Section 13 that the invention so far as claimed in any claim of the complete specification has been published in any specification or other document referred to in clause (*a*) of sub-section (1) or sub-section (2) of the said section, the Controller shall communicate the gist of specific objections and the basis thereof to the applicant and the applicant shall be afforded an opportunity to amend his specification.
>
> (2) If the applicant contests any of the objections communicated to him by the Controller under sub-rule (1), or if he refiles his specification along with his observations as to whether or not the specification is to be amended, he shall be given an opportunity to be heard in the matter if he so requests:
>
> Provided that such request shall be made on a date earlier than ten days of the final date of the period [referred to] under sub-section (1) of Section 21:
>
> Provided further that a request for hearing may be allowed to be filed within such shorter period as the Controller may deem fit in the circumstances of the case.
>
> (3) If the applicant requests for a hearing under sub-rule (2) within a period of one month from the date of communication of the gist of objections, or, the Controller, considers it desirable to do so, whether or not the applicant has refiled his application, he shall forthwith fix a date and time for hearing having regard to the period remaining for putting the application in order or to the other circumstances of the case.
>
> (4) The applicant shall be given ten days' notice of any such hearing or such shorter notice as appears to the Controller to be

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

reasonable in the circumstances of the case and the applicant shall, as soon as possible, notify the Controller whether he will attend the hearing.

(5) After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Controller may specify or permit such amendment of the specification as he thinks fit to be made and may refuse to [grant the patent] unless the amendment so specified or permitted is made within such period as may be fixed.

(6) The hearing may also be held through video-conferencing or audio-visual communication devices:

Provided that such hearing shall be deemed to have taken place at the appropriate office.

Explanation.—For the purposes of this rule, the expression "communication device" shall have the same meaning as assigned to it in clause (*ha*) of sub-section (1) of Section 2 of the Information Technology Act, 2000 (21 of 2000).

(7) In all cases of hearing, written submissions and the relevant documents, if any, shall be filed within fifteen days from the date of hearing."

66. The applicant is also accorded the right to contest any objection that may be communicated to him pursuant to the receipt of the FER by the Controller. In such a situation and in terms of Rule 28A the applicant would have to follow the procedure prescribed in Rule 28. A similar opportunity to contest stands structured in Rule 29 and which comes into play pursuant to the result of the inquiry that may have been undertaken in accordance with Section 13 of the Act. In fact, in terms of Rule 29(2) the Controller is conferred with the authority to postpone the grant of patent and allow a two-month window to the applicant to remove any objections. A perusal of the aforenoted statutory provisions would establish that while the statutory regime contemplates objections or observations which may come to the fore pursuant to the submission

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

of the FER or the inquiry that may have been undertaken in terms of Section 13, it additionally vests jurisdiction in the Controller to independently require an amendment to be made in the application, the specification or any other document filed on an independent evaluation of the application by virtue of Section 15 of the Act.

J. OPPOSITION PROCEEDINGS

67. The Court then takes note of Chapter V and which pertains to *opposition proceedings* that may be initiated both pre as well as post grant of the application. Section 25, as we had an occasion to notice, has undergone significant amendments post the promulgation of the **Patents (Amendment) Act, 2002 (Act 38 of 2002)**[22] and the 2005 Amending Act. It becomes relevant to note that Section 25(1) deals with the right of *any person* to submit a PGO consequent to the publication of an application for grant. It, however, restricts the grounds on which a PGO may be raised to those specified in clauses (a) to (k) and no other. The said provision obliges the Controller, if so, requested by an opponent, to afford him an opportunity of hearing and to dispose of the representation by way of opposition in the manner and within the period as prescribed. Section 25(2) on the other hand deals with *post grant opposition* and which provision can be invoked only by a *person interested*. It becomes relevant to note here that while the *pre-grant opposition* remedy can be availed of by *any person*, the right to oppose a patent post its grant stands confined to a *person interested*. The distinction which the statute creates between *any person* and a *person*

[22] Amending Act, 2002

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

interested was lucidly explained by the Supreme Court in **Alloys Wobben & Anr. Vs Yogesh Mehra & Ors.**[23] in the following terms:

> **"21.** A corrective mechanism is also available to "any person interested", to assail the grant of a patent under Section 64(1) of the Patents Act. This is in addition, to a similar remedy provided to "any person interested", under Section 25(2) of the Patents Act. In the above scenario, it is necessary to first appreciate the true purport of the words "any person interested". The term "person interested" has been defined in Section 2(1)(*t*) of the Patents Act. Unless the context otherwise requires, in terms of Section 2(1)(*t*) aforementioned, a "person interested" would be one who is … "engaged in, or in promoting, research in the same field as that to which the invention relates". Simply stated, a "person interested" would include a person who has a direct, present and tangible interest with a patent, and the grant of the patent adversely affects his above rights. A "person interested" would include any individual who desires to make independent use of either the invention itself (which has been patented), or desires to exploit the process (which has been patented) in his individual production activity. Therefore, the term "any person interested" is not static. The same person may not be a "person interested" when the grant of the patent concerned was published, and yet on account of his activities at a later point in time, he may assume such a character or disposition. It is, therefore, that Section 64 of the Patents Act additionally vests in "any person interested", the liberty to assail the grant of a patent, by seeking its revocation. The grounds of such challenge have already been enumerated above."

68. Taking note of the aforesaid aspects, the Supreme Court in *Alloys Wobben* significantly observed that a *person interested* would be one who may be engaged in or promoting research in the field to which the invention relates. The tests which were formulated for the purposes of identifying whether an entity is a *person interested* was prescribed to be one having a direct, present and tangible interest with the patent. The expression "*person interested"* is thus liable to be construed and

[23] [(2014) 15 SCC 360]

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

accorded a restricted meaning as opposed to the phrase "*any person*" appearing in Section 25(1).

69. Under the Rules the procedure for opposition is set out in Rule 55 and which reads as follows:

> **"55. [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.]
>
> (1-A) Notwithstanding anything contained in sub-rule (1), no patent shall be granted before the expiry of a period of six months from the date of publication of the application under Section 11-A.]
>
> (2) The Controller shall consider such representation only when a request for examination of the application has been filed.
>
> (3) On consideration of the representation if the Controller is of the opinion that application for patent shall be refused or the complete specification requires amendment, he shall give a notice to the applicant to that effect.
>
> (4) On receiving the notice under sub-rule (3), the applicant shall, if he so desires, file his statement and evidence, if any, in support of his application within three months from the date of the notice, with a copy to the opponent.
>
> (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."

K. AMENDMENT OF THE PATENT APPLICATION

70. Reverting then to the issue of amendment, we find that the said

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

subject is regulated primarily by Section 57 of the Act. We had an occasion to notice how Section 57 came to be amended both by the 2002 and 2005 Amending Acts in the introductory parts of this decision. The power to amend an application, a complete specification or documents relating thereto is firstly subjected to the provisions of Section 59 of the Act. That provision stipulates that no amendment would be made except by way of a disclaimer, correction or explanation. It then regulates the right to amend by prescribing that the same would not be granted except for the purposes of incorporation of an actual fact and that no amendment of a complete specification would be allowed the effect of which would be of transforming the amended specification as claiming or describing a matter which had not been substantially disclosed or claimed prior to the amendment which was sought or where an amendment, if permitted to a claim or the specification is not found to be embodied in the original scope thereof. The power of the applicant to approach the Controller for permission to amend is thus made subject to the regulatory control of Section 59 of the Act.

71. It becomes pertinent to note that Section 57 as it stood originally in the statute book and more particularly sub-section (3) thereof stipulated that every application for leave to amend an application for grant or specification made after the acceptance of the complete specification and the nature of the proposed amendment would be advertised. Section 57(3) then came to be further amended by virtue of Amending Act, 2002 and which hedged the obligation of the Controller

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

to advertise only if it were of the opinion that the amendment proposed was substantive. However, and upon promulgation of the Amending Act, 2005, Section 57(3), which continues to deal with the subject of publication of an application for leave to amend, covers only those which may be made after the grant of a patent. Whether the use of the phrase "after the grant" would have any material bearing upon the question that arises is an issue which shall be dealt with in the latter parts of this decision.

72. Section 57(4) as it existed in its original form obliged the Controller to afford an opportunity to *any person interested* to oppose the amendment and thus envisaged the Controller holding a hearing in which both the applicant as well as the opponent may be heard. While Section 57(4) principally retains the procedure that was originally intended, it appears to have been amended structurally so as to lend clarity to the extent and scope of the proceedings. It essentially reinforced and reiterated the right of any *person interested* to submit an opposition to any amendment that may have come to be published. This, of course, would have to be appreciated bearing in mind the fact that Section 57(3) as it came to exist in the legislation post its amendment in 2002 required only those proposed amendments to be advertised which were, in the opinion of the Controller, substantive. Post the 2005 amendments, the aforenoted Rule if literally read would appear to suggest a shift towards a regime where only amendments claimed after the grant of a patent came to be made. However, and as would be evident from the discussion which follows, a mere facial or

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

literal construct may not be the correct the view to take.

73. Section 57(4) restricts the right of opposition to a *person interested*. This is in sync with Section 25(2) which deals with oppositions submitted post the grant of the application. Of equal significance is Section 57(6) and the various amendments made thereto in terms of the provisions of the 2002 and 2005 Amending Acts. It becomes pertinent to note that Section 57(6) as it stood in its unamended avatar prescribed that its provisions would be without prejudice to the right of an applicant to amend the specification in compliance with a directive issued by the Controller either before the acceptance of the complete specification or during proceedings in opposition to the grant of a patent. Section 57(6) was retained substantially by the Amending Act, 2002 except to the extent of extending its coverage further to amendments in any document relating to the specification. However, sub-section (6) of Section 57 and its exclusionary march remained the same and extended right up to any amendments and directives issued by the Controller either before the acceptance of the complete specification or during the continuance of the PGO proceedings. Sub-section (6) thereafter came to be re-structured by the Amending Act, 2005 and now provides that its provisions would operate without prejudice to the right of the applicant to either amend the specification or any document related thereto to comply with the directions of the Controller issued before the grant of a patent. It is also pertinent to note that Section 57(1) has always remained static and deals with amendments that may have been sought

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

by the patent applicant itself.

74. Speaking of amendments that may be sought or mandated prior to the grant of a patent, we also take note of Rule 55(3) and (4) and which deals with amendments that may be found to be warranted by the Controller on consideration of a representation for opposition. If such a directive comes to be framed in terms of Rule 55(4), the applicant is accorded an opportunity to file a statement of opposition along with evidence and a copy thereof being provided to the opponent. On a consideration of that statement, the evidence that may be filed by the applicant in terms of sub-rule (4) as well as the representation submitted by the opponent and upon hearing all parties concerned, the Controller may either reject the representation or require the complete specification and other related documents to be amended to its satisfaction before the patent is granted. Rule 55(5) further enables the Controller to outrightly refuse the application for grant by passing a speaking order or upon due consideration of the representations of opposition to grant the patent. However, sub-rule (5) mandates that the Controller would pass a composite order disposing of not just the representations of opposition but the principal application seeking grant of a patent itself within one month from the completion of the hearing.

75. Before closing our discussion on the statutory provisions which govern, we may only in culmination notice Section 117A. The aforesaid provision came to be introduced in the statute by virtue of the Amending Act, 2002. However, and as it stood in its original form, it envisaged appeals being preferred against all orders that may be passed

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

under Section 25. Post its amendment in 2005, however, the provision of appeal came to be restricted only to orders referable to Section 25(4). It is pertinent to note that by virtue of the Amending Act, 2002 the IPAB had also come to be constituted. The appeals under Section 117A were thus envisaged to be laid before the IPAB. Post the **Tribunal Reforms Act, 2021**[24] while Section 117A (2) continues to restrict appeals to orders passed under sub-section (4) of Section 25, the only difference is that those appeals would now lie to a High Court. It becomes relevant to note that the dichotomy between the pre and the post-grant opposition stages came to be introduced by virtue of the Amending Act, 2005. Section 25(4) undoubtedly stands restricted to post-grant oppositions. The appeal under Section 117A thus stands restricted only to such orders as may be passed on culmination of a *post-grant opposition*. Significantly the disposal of PGOs' is not envisaged to be assailed by way of an appeal. It is in the aforesaid light that we proceed to deal with the decisions of the Court in *UCB Farchim, Mylan Laboratories and Snehlata C Gupte.*

L. FACETS OF PRE GRANT OPPOSITION

76. *UCB Farchim* was the first significant decision handed down by our Court post the 2005 amendments introduced in the Act and which acknowledged the gradient shift between *pre-grant opposition* and *post-grant opposition*. The Court correctly noticed that Section 25(1) as reconstructed entitled *any person* to move a representation by way of opposition to a patent application at any time after its publication and

[24] 2021 Act

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

till it is ultimately granted. A *post-grant opposition*, on the other hand, could be submitted only after a patent had been granted subject to the additional rider of that opposition being lodged within one year of the date of publication of the grant. It was also noticed that an opposition filed at the stage of *pre-grant* is to be considered by the Controller, whereas *post-grant opposition* is to be referred by the Controller to an Opposition Board and the opposition thus considered post the Controller having received recommendations from that Board. Of equal significance were the amendments introduced in Section 117A and which after its amendment in 2005 envisaged appeals being preferred only against an order passed under Section 25(4). It was in the aforesaid backdrop that it was observed that the Legislature clearly intended to create a dichotomy between a *pre-grant opposition* and a *post-grant opposition*.

77. The aforesaid position in law came to be reiterated in *Mylan Laboratories*. In *Snehlata C. Gupte*, the Court took note of the various representations that may be submitted at the *pre-grant opposition* stage and the need to strike an appropriate balance between the right of opposition and the imperatives of a patent application being disposed of as expeditiously as possible in light of the statutory command of Section 43(1) of the Act. It also took note of the maximum term of a patent as prescribed under Section 53 of the Act and thus the added expediency of ensuring that applications are not inordinately delayed thus depriving the inventor of the benefits of the grant. It was in that context significantly observed that an opponent and the representation

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

that may be submitted merely acts as an *aid to the examination process*.

78. The aforenoted decisions found that oppositions to a grant are principally intended to aid, assist and inform the decision-making process of the Controller. In our considered opinion, *Snehlata C. Gupte* correctly understood oppositions to grant as facilitating the Controller in the examination of the patent application. The opposition to the grant thus fosters and stimulates a broader consideration of the patent application. To the aforesaid extent, the process of examination becomes inclusive and collaborative. However, and as was rightly contended by Mr. Singh, the opposition by itself is not the sole determinative of whether the patent is liable to be granted. This since the mere rejection of the opposition would not inevitably result in the grant of a patent. Take a converse case where no opposition is filed even after the publication of the patent application. That in itself would not result in the patent being granted. What we seek to emphasize is that the application is additionally liable to be examined by the Controller independently and it is the said authority which must be satisfied that the grant is merited. This would be evident from the discussion which follows.

79. Tracing our steps back to the provisions relating to examination of the application, we find that the moment an application comes to be filed in terms of Section 11B of the Act, the Controller is obliged to refer the same to an examiner. The examiner on the basis of that reference undertakes the requisite inquiry and submits a report apprising the Controller whether the application is in accord with the

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

requirements of the Act, whether there exists any lawful ground of objection to the grant of the patent, the result of investigations carried out in terms of Section 13 and any other matter that may be prescribed. The inquiry under Section 13 is directed against anticipation by publication or the subject matter of the application forming part of any other claim or complete specification published on or after the date of filing of the applicant's complete specification. In terms of Section 13(2), the examiner is to test the application not just against any publication in India but also elsewhere in any document other than those spoken of in sub-section (1).

80. Upon receipt of the report of the examiner, the Controller proceeds in accordance with Section 14 and communicates a gist of the objections that may have come to the fore to the applicant and thus providing it an opportunity of responding to the same. The action under Section 14 rests on the report of the examiner and to parts whereof which may be adverse to the applicant or require an amendment to the application, the specification or other related documents. The Controller thus moves under Section 14 solely on the basis of the FER. This is also evident from a conjoint reading of Rules 28 and 28A. It is thus manifest that the aforenoted statutory process of examination proceeds autonomously and is statutorily intended to be an assessment and appraisal undertaken by the Controller on its own motion for the purposes of formation of an opinion on whether a patent is liable to be granted.

81. Section 15 specifies the powers that a Controller may exercise in

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

respect of a patent application. The said provision vests powers in the Controller which can be invoked independent of the FER. This is evident from the aforesaid provision predicating the action being based on the satisfaction of the Controller alone. Section 15 is thus the repository of a power inhering in the Controller to either refuse the application or require the application, specification or other documents to be amended to its satisfaction. The *examination process* thus comprises of the inquiry which is undertaken by the examiner pursuant to the reference made in terms of Sections 12 and 13 of the Act whereas Section 15 independently enables the Controller to scrutinize and consider the application for grant of patent.

82. The *opposition process* on the other hand commences upon publication. It becomes pertinent to note that an opposition at the pre grant stage, in accordance with the statute as it stands today, can be submitted by any person as has been rightly noticed in the various decisions referred to above. The aforesaid expression is undoubtedly far wider than the phrase *"person interested"* and which is employed by Section 25(2) of the Act. The objections under Section 25(1) of the Act may thus come to be laid not only by a person engaged in or in promoting research in the same field as that to which the invention relates but by any individual or entity which may seek to oppose the grant on grounds specified in Section 25(1). Thus, and as was so observed by the Supreme Court in *Alloys Wobben*, a *pre grant opposition* in terms of Section 25(1) may also come to be laid by a person who may have no direct, present or tangible interest in the patent

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

or one whose rights may not be adversely affected by the grant. Insofar as the category of *any person interested* is concerned, they would in any case have the right to oppose the grant of the patent itself by virtue of Section 25(2). Thus, the representation by way of opposition under Section 25(1) has been rightly described as being in *aid of the power of examination* that is exercised by the Controller.

83. As had been rightly contended on behalf of the appellants the rejection of an opposition does not and inevitably result in a patent application being granted. The rejection of a PGO does not *ipso facto* compel or bind the Controller to grant the patent application. Notwithstanding the rejection of a representation, the Controller is legally as well as statutorily bound and obliged to examine the application based on the FER as well as on its own individual evaluation of whether the patent is liable to be granted under the law. It must also be observed that since at the *pre-grant opposition* stage, representations can be made by *any person* and not merely persons who may have a direct interest in the application, it would be incorrect to characterise the proceedings at that stage to be adversarial. Contrary to an adversarial setting, the pre-grant opposition stage opens the floor for eliciting a multitude of opinions extending beyond direct stakeholders to persons opposing the application for varied reasons. It enables the Controller to gather insights from a broad spectrum of sources as opposed to those who may have a direct stake in the matter. The *opposition procedure* structured as above leads to a comprehensive exploration of objections and perspectives aiding the Controller in

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

making an informed decision. The process is thus an open and participatory exchange ensuring that the evaluation process benefits from views expressed by a diverse body of opponents. While persons interested may also be in the fray, the Controller invites objections for the purposes of ascertaining and eliciting the views of a large cross section of persons and entities who may for varied reasons seek to oppose the grant. Viewed in that light it is manifest that it would be incorrect to view those proceedings as representing a *lis* as that phrase is legally understood.

84. We are thus of the firm opinion that notwithstanding the invitation of objections, the Controller has to be independently satisfied that the application merits acceptance. This independence is vital to uphold the credibility of the patent system ensuring that decisions are made impartially, based on the merits of the application rather than external and interested influences. The Court thus finds itself unable to sustain the theory of merger as advocated on behalf of the respondents and which found favour with the learned Single Judge. Both the Act as well as the Rules clearly envisage a dichotomy between the *examination process* and *opposition process*. While in the course of examination, the Controller may hypothetically draw sustenance from any opposition that may have been filed, it would be wholly incorrect to accept that such eventuality would also warrant the objector being accorded participation in the *examination process*.

85. We also bear in mind the provisions of Rule 55 and which speaks of representations for opposition that may be received. It is on a

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

consideration of such a representation and on the basis of which the Controller may come to form the opinion that the application for patent should be refused or the complete specification amended that it would proceed to place the applicant upon notice. The consideration under Rule 55(3) is thus confined to the contents of the representation and which in turn would be restricted to the grounds of opposition which are available to be raised in terms of clauses (a) to (k) of Section 25(1) of the Act. This would also be evident from a reading of Rule 55(4) and in terms of which the applicant is afforded an opportunity to file its statement and evidence in response to the opposition. The proceedings which are thus envisaged in sub-rules (1) to (4) of Rule 55 are confined to the grounds of opposition that may be raised by way of a representation. Those provisions cannot be interpreted as either extending to or regulating the *examination process* which the Controller has to, and in any case, independently undertake. We also note that the prescription of the applicant being placed on notice by virtue of sub-rules (3) and (4) of Rule 55 is also confined to the applicant and the opponent. The expressions *"submissions made by the parties"* and *"after hearing the parties"* must consequentially draw meaning from the above. Rule 55(5) thus cannot possibly be stretched or be interpreted as intended to regulate the *examination process*. The said provision also cannot possibly be construed as embodying a legislative intent to confer a participative right upon the opponent in the *examination process*. The right of hearing envisaged in that provision stands confined to a consideration of issues raised by the representation

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

alone.

86. The *opposition process* as envisaged under the Act has a specific and a targeted purpose. Its primary objective is to provide a platform for any person to express objections and concerns regarding a patent application. The objections received during the *opposition process* play a crucial role in enabling the Controller to have the benefit of diverse views on the question of grant including whether the application should be rejected or amendments to the complete specifications be warranted. The *opposition process* therefore serves the avowed purpose of allowing external inputs to be placed for the consideration of the Controller enabling it to make a well-informed decision regarding the grant of the patent application.

87. On the other hand, the *examination process* serves a wider and significant objective. This stage involves an in-depth assessment of the patent application, ensuring it complies with the statutory requirements for patent approval and facilitates a thorough and independent evaluation of the application by the examiner and the Controller. Maintaining a clear distinction between the *examination process* and the *opposition process* is essential to not only fulfil the underlying objectives sought to be achieved but are also fundamental in ensuring that the sanctity and efficacy of each stage is maintained.

88. This separation helps in striking a balance between the need for a rigorous examination and the task of including various perspectives in the decision-making process. The *examination process* demands a

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

focused evaluation of the patent application against set legal standards wherein the Controller is tasked with the duty to ensure that only deserving inventions are granted patent protection. On the other hand, the *opposition process* serves as a forum for external stakeholders or any person to voice concerns and provide valuable insights thus contributing to a more comprehensive evaluation of the patent application.

89. To merge the process would be to compromise the rigors of examination, since external inputs, though valuable, are best considered within the distinct and specific framework of the opposition. Merging these distinct processes would render the entire system unwieldy and counterproductive quite apart from negatively impacting the legislative policy of expeditious consideration. The separation, thus, subserves the legislative intent and allows for a more structured and organized approach where objections from various sources are factored in without disrupting the streamlined process of examination of the patent application.

90. The answer to the question which stands posited may also be examined bearing in mind the significant amendments which were made to Sections 25 and 57 by virtue of the 2002 and 2005 amendments. As Section 25 originally stood, the power to oppose an application stood conferred on a *person interested*. The expression *person interested* always existed in the statute book in terms of Section 2(1)(t). The aforesaid position continued even after the 2002 amendment and with that right of opposition being available to be

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

exercised by *any person interested*. The dichotomy between the *pre-grant opposition* and *post-grant opposition* proceedings came to be introduced only by the Amending Act, 2005. It was by virtue of these amendments that a right to oppose the grant of a patent came to be conferred on *"any person"* and such an opposition being available to be made after the patent application had been published but before it came to be granted. The post grant opposition right however came to be restricted as being available to be invoked only by a person interested. The *opposition process* thus for the first time came to be bifurcated between the pre and the post grant stages of the patent. These statutory amendments were introduced to attune the Act in line with India's commitment flowing from the TRIPS Section of the General Agreement on Trade and Tariffs. We propose to examine this aspect in greater detail in the subsequent parts of this decision where we shall also notice the provisions made in different patent statutes and the extent of rights recognised to inhere in opponents.

91. The PGO procedure as it stands presently is one which undoubtedly has come to be constructed by virtue of the amendments introduced in 2005. In terms of Section 25(2) as it stood up to the promulgation of the 2002 amendment, the Controller was obliged to notify the applicant and afford an opportunity of hearing to both the opponent as well as the applicant before rendering a decision. The aforesaid position is preserved even in the amended Section 25 with the Controller being obliged to afford an opportunity of hearing to both the applicant as well as the opponent before rendering a final decision on

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

the patent application. Rule 55 too came to be amended in order to mirror the changes made in Section 25 which now contemplates a pre and post grant opposition.

92. We also find ourselves unable to sustain the submission of Mr. Sai Deepak who had argued that the Section 15 power would be deprived of character if the material which is placed by way of objections in terms of Rule 55 were to be excluded from consideration. The aforesaid submission is clearly untenable since the objections are considered by the Controller independently. The power vested in the Controller by virtue of Section 15 is in any case neither guided by the opposition nor dependent upon it. The said power confers an independent power upon the Controller.

M. THE HEARING UNDER RULE 55

93. It is pertinent to note that the marginal heading of Rule 55 which prior to the Patent (Amendment) Rules, 2006 read as *"Opposition by representation against the grant of patent"* now reads as *"Opposition to the patent"*. The aforesaid amendment was necessitated in order to accommodate the changes made in Section 25 which had by now bifurcated the *opposition process* between proceedings leading up to the grant and those that may be instituted after the patent had come to be granted.

94. The other significant amendment to Rule 55 is evident from a reading of sub-rule (5) and which now obliges the Controller to simultaneously dispose of the representations of opposition and the

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

patent application. However, and as observed in the preceding parts of this decision, the "*hearing*" that is contemplated clearly appears to be confined to the representation alone, a position which clearly emerges upon a conjoint reading of sub-rules (3), (4) and (5). It is pertinent to note that sub-rule (3) visualizes the applicant being placed on notice if the Controller *"on consideration of the representation"* be *"of the opinion"* that the application for patent should either be refused or the complete specification amended. The process of a hearing thus gets triggered upon the Controller on a consideration of the representation being of the opinion that the opponent has raised issues which either warrant the patent application being rejected or the specification being amended. Once the Controller is satisfied that the representation raises questions worthy of consideration, it would proceed to place the applicant on notice enabling it to file its statement and evidence. However, these proceedings are unconcerned with issues that the Controller may have flagged in the course of the examination process. Thus, the right to oppose and to be heard is indelibly pivoted to the representation for opposition as distinct from questions that may arise from the FER or those that the Controller may identify as germane and material in the examination process.

95. It is also relevant to note that the opponent can claim a right of hearing only if the Controller is satisfied and is of the opinion that the representation merits consideration. A mere filing of a representation would not prompt or precipitate issuance of notice under Rule 55(4). The matter becomes contentious only once the Controller takes

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

cognizance of the representation and issues notice to the applicant. It is at that stage and for the aforesaid reasons that the principles of natural justice become applicable. In fact, while passing a compendious order in terms of Rule 55(5), the Controller could reject representations if it be of the opinion that they raise no substantial question or grounds worthy of consideration.

96. It is thus apparent that the right of hearing that is contemplated in Rule 55(5) is one which is concerned solely with the adjudication and disposal of the representation for opposition. The opponent cannot be countenanced to have a right of hearing in the *examination process* merely because the statute confers such an opportunity at the stage where the Controller is considering the representation. While the pre grant opposition indisputably facilitates the decision-making function of the Controller, we find ourselves unable to accept the contention that the opponent must consequentially be recognised to have the right of participation or audience in the *examination process*.

N. THE NATURAL JUSTICE PRINCIPLES

97. We are also convinced that the statutory scheme as articulated by us above does not amount to either a denial or exclusion of the natural justice principles as was contended by the respondents. As was noted in the preceding parts of this decision, the opponent stands conferred a right to raise objections once the application is advertised. However, the *examination process* comprises of an independent evaluation and assessment of the patent application. The said exercise is not dependent

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

upon an objection that may be raised. The provisions contained in Chapter IV of the Act do not envisage opponents or objectors being accorded an audience either before the examiner or the Controller. Consequently, the question of denial of a right of hearing does not arise at all. The invocation of the doctrine of the principles of natural justice being liable to be read into the statute in the absence of an express exclusion is equally misconceived when one bears in mind the scheme underlying Chapter IV. The provisions enshrined in that part are fundamentally concerned with the examination and evaluation of the patent application by the examiner and the Controller. That is an obligation placed upon the Controller and one which is disassociated from opposition proceedings which form the subject matter of Chapter V. As was noticed by us hereinbefore, the rejection of an opposition would not ipso facto lead to the grant of a patent. The statute in any case neither deprives a person from opposing the grant nor does it leave an interested person with a *fait accompli*. The rights of interested persons stand sufficiently safeguarded and preserved by Section 25(2). In both contingencies, the opponent can claim and is in fact conferred a right of hearing compliant with the principles of natural justice.

98. More fundamentally, the right of hearing as asserted by the respondents proceeds in ignorance and disregard of the nature and extent of the *opposition process*. We have already held that the representation for opposition is principally aimed at aiding and facilitating the examination of the patent application. The representation is per se neither adversarial nor contentious. The pre

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

grant opponent merely aids the Controller in a holistic examination of the patent application. Secondly, the opposition in any case is confined to the grounds specified in Section 25(1). It is thus obligatory for the Controller to hear the opponent on the grounds of challenge that are raised. However, the Controller may nonetheless be inclined to reject the patent application on grounds other than those that may have been raised by the objector. We fail to appreciate how the objector could claim a right of hearing in respect of grounds which were neither raised nor urged at its behest. It is this which convinces us to hold that the opponent can assert a right of hearing only in respect of the representation and cannot be recognised to have a right to intervene in the *examination process*.

99. In opposition proceedings, the focus primarily is on the grounds brought forward by the opponent, and thus confining the examination to the issues raised in the opposition. To illustrate, if the opposition challenges the adequacy of disclosure in the patent application, the Controller would scrutinise the application on these grounds only if there is evidence that prejudicially impacts the maintainability of the patent application. This examination is triggered by information that emerges and is deemed prima facie to affect the application for grant and the claim for a patent. Thus, the significance of opposition lies in its role in aiding the Controller in conducting a comprehensive examination of the patent application. Unlike an adversarial process, the opposition merely contributes to the overall assessment of the patent application and thus would not sustain a right of hearing being

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

claimed in the *examination process*. The opponent's right to a hearing is circumscribed by the grounds specified in Section 25(1) The right of hearing is tethered to the grounds articulated in the opposition, ensuring that the opponent has a platform to present arguments and evidence in connection with the challenges they have raised. This reinforces our view that the opponent's right to a hearing pertains specifically to the representation stage and does not grant them the entitlement to intervene in the broader *examination process*.

100. Our conclusions on this aspect are also guided by the imperative of striking an appropriate balance between the expectation of the applicant to seek expeditious consideration of its application and the element of public interest of only a true invention being extended the protective coverage of the Act. We are of the considered opinion that if every opponent were to be recognised to have a right of participation in the examination process, it would clearly derail that statutory process and inevitably adversely impact the expeditious conclusion of that process. In any case an opponent has the right to assail the grant in terms of Section 25 (2). The statute has thus struck an appropriate and needed balance between those two facets.

O. THE RIGHTS OF AN OPPONENT- A GLOBAL PERSPECTIVE

101. We further find that the exclusion of the opponent from the *examination process* is neither a unique nor an unconventional feature of our patent legislation. This would be evident upon a consideration of the provisions of the Patents Act, 1977 as applicable in the United

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

Kingdom as well as the European Patent Convention. If one were to first turn its gaze upon the English legislation, the first pari materia provision which deserves notice is Section 15A which deals with the subject of preliminary examination and the reference of the application to an examiner. Pursuant to that reference, the examiner submits a report in accordance with sub-section (3). As would be manifest from a reading of sub-sections (6) and (7) of Section 15A, the Comptroller is obliged to provide an opportunity to the applicant to respond to the observations contained in the report of the examiner or to comply with the same. In terms of Section 15A (7), the Comptroller is empowered to reject the application if the applicant fails to amend and bring the application in accord with the observations made by the examiner. Section 15A reads as follows: -

> "**15A Preliminary examination**
>
> (1) The comptroller shall refer an application for a patent to an examiner for a preliminary examination if—
>
> (a) the application has a date of filing;
>
> (b) the application has not been withdrawn or treated as withdrawn; and
>
> (c) the application fee has been paid.
>
> (2) On a preliminary examination of an application the examiner shall—
>
> (a) determine whether the application complies with those requirements of this Act and the rules which are designated by the rules as formal requirements for the purposes of this Act; and
>
> (b) determine whether any requirements under section 13(2) or 15(10) above remain to be complied with.
>
> (3) The examiner shall report to the comptroller his determinations under subsection (2) above.

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

(4) If on the preliminary examination of an application it is found that—

(a) any drawing referred to in the application, or

(b) part of the description of the invention for which the patent is sought, is missing from the application, then the examiner shall include this finding in his report under subsection (3) above.

(5) Subsections (6) to (8) below apply if a report is made to the comptroller under subsection (3) above that not all the formal requirements have been complied with.

(6) The comptroller shall specify a period during which the applicant shall have the opportunity—

(a) to make observations on the report, and

(b) to amend the application so as to comply with those requirements (subject to section 76 below).

(7) The comptroller may refuse the application if the applicant fails to amend the application as mentioned in subsection (6)(b) above before the end of the period specified by the comptroller under that subsection.

(8) Subsection (7) above does not apply if—

(a) the applicant makes observations as mentioned in subsection (6)(a) above before the end of the period specified by the comptroller under that subsection, and

(b) as a result of the observations, the comptroller is satisfied that the formal requirements have been complied with.

(9) If a report is made to the comptroller under subsection (3) above—

(a) that any requirement of section 13(2) or 15(10) above has not been complied with; or

(b) that a drawing or part of the description of the invention has been found to be missing,

then the comptroller shall notify the applicant accordingly.**]**"

102. Section 16 of the Patents Act, 1977 deals with the publication of the application while Section 17 regulates the search to be conducted by the examiner and which is similar to Section 13 of our legislation. Section 18 comprises the power of substantive examination and the

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

final report of the examiner which is submitted pursuant to the enquiry and search conducted in terms of Sections 15A and 17. Section 19 speaks of the right of the applicant to amend of its own volition and is couched in the following terms: -

> "**19 General power to amend application before grant.**
> (1)At any time before a patent is granted in pursuance of an application the applicant may, in accordance with the prescribed conditions and subject to section 76 below, amend the application of his own volition.
> (2)The comptroller may, without an application being made to him for the purpose, amend the specification and abstract contained in an application for a patent so as to acknowledge a registered trade mark."

103. Though we had an occasion to notice Section 21 in the preceding parts of this judgment, for the sake of continuity, the provision is reproduced hereinbelow to reemphasize the position in English law which prescribes that a person does not become a party to the proceedings before the Comptroller merely because he has submitted an observation in the course of the *opposition process*. Section 21 reads thus: -

> "**21 Observations by third party on patentability.**
> (1)Where an application for a patent has been published but a patent has not been granted to the applicant, any other person may make observations in writing to the comptroller on the question whether the invention is a patentable invention, stating reasons for the observations, and the comptroller shall consider the observations in accordance with rules.
> (2)It is hereby declared that a person does not become a party to any proceedings under this Act before the comptroller by reason only that he makes observations under this section."

104. While Section 21 is concerned with the *opposition process* prior

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

to grant, Section 27 makes provisions for amendment post the grant of the patent. Of significance is sub-section (5) and which enables a person to oppose the proposed amendments and which is thus similar to the procedure contemplated under Section 57 (4) of our statute. Section 27 of the Patent Act, 1977 reads as follows: -

> "**27 General power to amend specification after grant.**
> (1)Subject to the following provisions of this section and to section 76 below, the comptroller may, on an application made by the proprietor of a patent, allow the specification of the patent to be amended subject to such conditions, if any, as he thinks fit.
> (2)No such amendment shall be allowed under this section where there are pending before the court or the comptroller proceedings in which the validity of the patent may be put in issue.
> (3)An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.
> (4)The comptroller may, without an application being made to him for the purpose, amend the specification of a patent so as to acknowledge a registered trade-mark.
> (5)A person may give notice to the comptroller of his opposition to an application under this section by the proprietor of a patent, and if he does so the comptroller shall notify the proprietor and consider the opposition in deciding whether to grant the application.
> [F51(6)In considering whether or not to allow an application under this section, the comptroller shall have regard to any relevant principles applicable under the European Patent Convention.]"

105. Similarly, under the Patent Rules, 2007 the subject of pre grant amendments is regulated by Rule 31 which is reproduced hereinbelow:-

> "**Amendment of application before grant**
>
> **31.**—(1) A request to amend an application for a patent under section 19(1) must be made in writing.
>
> (2) The conditions prescribed under section 19(1) are as follows.
>
> (3) Subject to rule 66A the applicant may amend his application only within the period beginning with the date on which the

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

applicant is informed of the examiner's report under section 17(5) and ending with the date on which the comptroller sends him the first substantive examination report.

(4) But after the end of this period, the applicant may—

(a) where the first substantive examination report states that his application complies with the requirements of the Act and these Rules, amend his application once before the end of the period of two months beginning immediately after the date on which that report was sent; or

(b) where the first substantive examination report states that his application does not comply with the requirements of the Act and these Rules—

(i) amend his application once at the same time as he makes his first observations on, or amendments to, his application under section 18(3), and

(ii) if the first substantive examination report is sent before preparations for the application's publication have been completed by the Patent Office, amend his application prior to any further amendment he may make under sub-paragraph (b)(i).

(5) However, the conditions in paragraphs (3) and (4) do not apply—

(a) where the comptroller consents to the amendment; or

(b) to an amendment of a request for the grant of a patent.

(6) Where the comptroller's consent is required, or the applicant wishes to amend the request for the grant of a patent, the applicant must include the reasons for the amendment."

106. Insofar as amendments proposed post the grant of the patent are concerned, the said subject is regulated by Rule 35 and which reads as under: -

"Amendment of specification after grant

35.—(1) An application by the proprietor of a patent for the specification of the patent to be amended must—

(a) be made in writing;

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

(b) identify the proposed amendment; and
(c) state the reason for making the amendment.

(2) The application must, if it is reasonably possible, be delivered to the comptroller in electronic form or using electronic communications.

(3) The comptroller may, if he thinks fit, direct the proprietor to file a copy of the specification with the amendment applied for marked on it.

(4) Where the specification of a European patent (UK) was published in a language other than English, the proprietor must file a translation into English of the part of the specification which he is applying to amend and a translation of the amendment.

(5) The comptroller may, if he thinks fit, direct the proprietor to file a translation into English of the specification as published.

(6) Where the court or the comptroller allows the proprietor of a patent to amend the specification of the patent, the comptroller may direct him to file an amended specification which complies with the requirements of Schedule 2."

107. Rule 33 requires the Comptroller to communicate all observations received in terms of Section 21 to the applicant. The said provision is extracted hereunder: -

"Observations by third parties on patentability

33.—(1) The comptroller must send to the applicant a copy of any observations on patentability he receives under section 21.

(2) But paragraph (1) does not apply to any observation which, in the opinion of the comptroller, would—
(a) disparage any person in a way likely to damage such person; or

(b) be generally expected to encourage offensive, immoral or anti-social behaviour.
(3) The comptroller may, if he thinks fit, send to the applicant a copy of any document referred to in the observations.

(4) The comptroller must send to an examiner any observations on patentability.

(5) But paragraph (4) does not apply where the observations are

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

received after the examiner has reported under section 18(4) that an application complies with the requirements of the Act and these Rules."

108. Part 7 of the Rules lays in place various provisions regulating the hearing procedure before the Comptroller. Rules 74 to 77 are reproduced hereinbelow: -

"**Overriding objective**
74.—(1) The rules in this Part set out a procedural code with the overriding objective of enabling the comptroller to deal with cases justly.
(2) Dealing with a case justly includes, so far as is practicable—
(a) ensuring that the parties are on an equal footing;
(b) saving expense;
(c) dealing with the case in ways which are proportionate—
(i) to the amount of money involved,
(ii) to the importance of the case,
(iii) to the complexity of the issues, and
(iv) to the financial position of each party;
(d) ensuring that it is dealt with expeditiously and fairly; and
(e) allotting to it an appropriate share of the resources available to the comptroller, while taking into account the need to allot resources to other cases.
(3) The comptroller shall seek to give effect to the overriding objective when he—
(a) exercises any power given to him by this Part; or
(b) interprets any rule in this Part.
(4) The parties are required to help the comptroller to further the overriding objective.

Publication of notices
75.—(1) Subject to paragraph (2) and rule 105(5) the comptroller must advertise in the journal any event to which it is possible to object under any of the provisions mentioned in Part 2 or 3 of Schedule 3.
(2) Where an amendment to the specification of a patent is proposed by the proprietor under section 75(1) the comptroller may, if he thinks fit, advertise in the journal the proposed amendment.

Starting proceedings
76.—(1) Proceedings are started when a person files in duplicate—
(a) the relevant form; and

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

(b) his statement of grounds.

(2) Any person may give notice of opposition—

(a) in the case of section 75(2), before the end of the period of two weeks beginning immediately after the date of the relevant notice; and

(b) in the case of any of the other provisions mentioned in Part 2 of Schedule 3, before the end of the period of four weeks beginning immediately after the date of the relevant notice.

(3) For the purposes of this rule and rule 77— "relevant form" means—

(a) in relation to applications or requests under the provisions of the Medicinal Products Regulation or the Plant Protection Products Regulation mentioned in Part 1 of Schedule 3, Patents Form SP3;

(b) in relation to applications, references or requests under any other provision mentioned in Part 1 of that Schedule, Patents Form 2; and

(c) in relation to oppositions under the provisions mentioned in Part 2 of that Schedule, Patents Form 15; and "relevant notice" means the advertisement in the journal mentioned in rule 75.

(4) A statement of grounds must—

(a) include a concise statement of the facts and grounds on which the claimant relies;

(b) in the case of rule 89(5), include the grounds of objection to the draft licence;

(c) where appropriate, include the period or terms of the licence which he believes are reasonable;

(d) specify the remedy which he seeks;

(e) where it accompanies an application under the Compulsory Licensing Regulation(**a**), include any information required by that Regulation;

(f) be verified by a statement of truth; and

(g) comply with the requirements of Part 1 of Schedule 2.

Notification of the parties

77.—(1) The comptroller must notify the applicant for, or proprietor of, the patent which is the subject matter of the case that proceedings have started.

(2) In addition, the comptroller may notify any persons who appear to him to be likely to have an interest in the case that proceedings have started.

(3) But where a person mentioned in paragraph (1) or (2)—

(a) is the claimant; or

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

(b) has indicated in writing to the comptroller that he supports the claimant's case, the comptroller has no duty to notify him. notification under paragraph (1) or (2).

(4) The comptroller must send the relevant form and the statement of grounds with the notification under paragraph (1) or (2).

(5) In that notification, the comptroller must specify a period within which the persons notified may file a counter-statement.

(6) Any counter-statement must be filed in duplicate before the end of the period specified under paragraph (5).

(7) But paragraphs (5) and (6) do not apply to an opposition under any of the provisions mentioned in Part 3 of Schedule 3.

(8) In such oppositions, any counter-statement must be filed in duplicate before the end of the period of four weeks beginning immediately after the date of the relevant notice.

(9) Where—

(a) a person was notified under paragraph (1) or (2); and

(b) that person fails to file a counter-statement under paragraph (6) or (8), the comptroller shall treat him as supporting the claimant's case.

(10) The period prescribed for the purposes of giving notice to the comptroller under section 47(6) of opposition to cancellation of an entry made under section 46 that licences are available as of right is the period prescribed by paragraph (8)."

109. It is thus evident on a consideration of the various provisions made in the Patents Act, 1977 as well as the Patents Rules, 2007 that a person who has made an observation in the *opposition process* is not accorded a right of hearing before the Comptroller when it considers the examiners observations and report or while that authority is independently examining the patent application. In any case any doubt that may have been harboured in this regard are conclusively laid to rest by virtue of Section 21(2).

110. Turning then to the European Patent Convention, we notice the provisions placed in Part IV thereof and which deals with examination of the application and the procedure to be adopted up to the grant of the

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

patent. Articles 90 and 92 read as under: -

> **"Article 90**
> **Examination on filing and examination as to formal requirements**
> (1) The European Patent Office shall examine, in accordance with the Implementing Regulations, whether the application satisfies the requirements for the accordance of a date of filing.
> (2) If a date of filing cannot be accorded following the examination under paragraph 1, the application shall not be dealt with as a European patent application.
> (3) If the European patent application has been accorded a date of filing, the European Patent Office shall examine, in accordance with the Implementing Regulations, whether the requirements in Articles 14, 78 and 81, and, where applicable, Article 88, paragraph 1, and Article 133, paragraph 2, as well as any other requirement laid down in the Implementing Regulations, have been satisfied.
> (4) Where the European Patent Office in carrying out the examination under paragraphs 1 or 3 notes that there are deficiencies which may be corrected, it shall give the applicant an opportunity to correct them.
> (5) If any deficiency noted in the examination under paragraph 3 is not corrected, the European patent application shall be refused unless a different legal consequence is provided for by this Convention. Where the deficiency concerns the right of priority, this right shall be lost for the application."
>
> **Article 92**
> **Drawing up of the European search report**
> The European Patent Office shall, in accordance with the Implementing Regulations, draw up and publish a European search report in respect of the European patent application on the basis of the claims, with due regard to the description and any drawings."

111. The subject of publication and examination are governed by Articles 93 and 94 which read as follows: -

> **"Article 93**
> **Publication of the European patent application**
> (1) The European Patent Office shall publish the European patent application as soon as possible
> (a) after the expiry of a period of eighteen months from the date of filing or, if priority has been claimed, from the date of priority, or

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

(b) at the request of the applicant, before the expiry of that period.
(2) The European patent application shall be published at the same time as the specification of the European patent when the decision to grant the patent becomes effective before the expiry of the period referred to in para-graph 1(a).

Article 94
Examination of the European patent application
(1) The European Patent Office shall, in accordance with the Implementing Regulations, examine on request whether the European patent application and the invention to which it relates meet the requirements of this Convention. The request shall not be deemed to be filed until the examination fee has been paid.
(2) If no request for examination has been made in due time, the application shall be deemed to be withdrawn.
(3) If the examination reveals that the application or the invention to which it relates does not meet the requirements of this Convention, the Examining Division shall invite the applicant, as often as necessary, to file his observations and, subject to Article 123, paragraph 1, to amend the application.
(4) If the applicant fails to reply in due time to any communication from the Examining Division, the application shall be deemed to be withdrawn."

112. Of significance is Article 94(3) and which stipulates that the Examining Division shall "invite the applicant" whenever necessary to file observations or to amend the application. Here too, the objector is not accorded any participatory role in the *examination process*. Insofar as opposition is concerned, the same is regulated initially by Article 99 and which reads thus: -

"Article 99
Opposition
(1) Within nine months of the publication of the mention of the grant of the European patent in the European Patent Bulletin, any person may give no-tice to the European Patent Office of opposition to that patent, in accordance with the Implementing Regulations. Notice of opposition shall not be deemed to have been filed until the opposition fee has been paid.

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

> (2) The opposition shall apply to the European patent in all the Contracting States in which that patent has effect.
> (3) Opponents shall be parties to the opposition proceedings as well as the proprietor of the patent.
> (4) Where a person provides evidence that in a Contracting State, following a final decision, he has been entered in the patent register of such State instead of the previous proprietor, such person shall, at his request, replace the previous proprietor in respect of such State. Notwithstanding Article 118, the previous proprietor and the person making the request shall not be regarded as joint proprietors unless both so request."

113. It becomes pertinent to note that Article 99 essentially relates to post grant opposition, as would be apparent from the language of that Article and since it employs the phrase *"……publication of the mention of the grant of the European patent……."*. Of significance is Article 99 (3) and which declares that the applicant as well as the opponents shall be party to the opposition proceedings. However, even the European Patent Convention creates a clear distinction between the rights that may be claimed by opponents at the pre and post grant stage of the patent process. This would be evident from the language in which Article 115 is couched and which though recognizing the right of a third party to present observations concerning patentability prescribes that it would not be a party to the proceedings. It becomes pertinent to note Article 115 is clearly concerned with pre grant opposition since it uses the expression *"….following the publication of the European patent application"*. It is thus abundantly clear that even the European Patent Convention does not acknowledge a right of an opponent to be heard in the course of the *examination process*. In fact, the Convention appears to have been constructed to deal with post grant oppositions alone. Article 115 is reproduced hereinbelow: -

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

> "**Article 115**
> **Observations by third parties**
> In proceedings before the European Patent Office, following the publication of the European patent application, any third party may, in accordance with the Implementing Regulations, present observations concerning the patentability of the invention to which the application or patent relates. That person shall not be a party to the proceedings."

P. THE IMPORT OF SECTION 57

114. The subject of amendment is principally regulated by Section 57 of the Act. However, the scope of the said provision and its underlying intent can be gleaned from how it came to be amended from time to time. It is relevant to note that Section 57(1) enables both *"an applicant for a patent"* as well as a *"patentee"* to seek amendment. Section 57(3) sets in place the requirement of the application for amendment being published. Section 57(3), as it stood originally, was retained substantially even after the passing of the Amending Act, 2002 except insofar as the issue of advertisement of the amendment was concerned and which procedure the Controller was obliged to follow if in its opinion the amendments were considered substantive. The right of opposition to the proposed amendments however has consistently been restricted to a person interested. However, sub-section (3) in its current manifestation speaks of an application for leave to amend *"made after the grant of patent"* being published. Sub-section (3) too came to be substituted and recast by virtue of Amending Act, 2005 and which as noticed hereinbefore consciously introduced the distinction between *any person* and a *person interested*. Notwithstanding the use of the expression *"made after the grant of patent"* in Section 57(3) and which

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

qualifies the issue of publication, in our considered opinion, any application for amendment voluntarily made would have to be made known to all persons who may have submitted representations for opposition since they would constitute parties already in the fray and thus constituting the field of opposition. This would also be necessitated by the fact that amendments introduced during the PGO process may perhaps be prompted by objections raised or reservations expressed. Thus, in order to examine whether the proposed amendments effectively remedy the opposition urged in terms of Section 25(1) read alongwith Rule 55(1), the Controller would be obliged to place the objectors on notice and afford them an opportunity of being heard. This position was conceded to even by Mr. Singh, appearing for the appellant, who fairly stated that *any person* who may have submitted a PGO by virtue of the right conferred by Section 25(1) must be recognised to have the right to be heard on any voluntary amendments that may be introduced by the applicant. The point of contention between the parties thus stood restricted to the right of an opponent to be heard where the amendment was prompted by a directive of the Controller issued in the course of the *examination process*. This issue stands squarely answered, in our considered opinion, by Section 57(6) and for reasons which are elaborated hereinafter.

115. Of immense significance are the provisions enshrined in sub-section (6) and how they underwent transformational changes in terms of the 2002 and 2005 Amending Acts. Sub-section (6), as it stood

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

arranged originally as well as post the 2002 amendment, declared that the Section 57 procedure would be without prejudice to the right of an applicant to amend the specification or any document relating thereto to comply with a direction of the Controller issued before the acceptance of the complete specification or in the course of proceedings in opposition to the grant of a patent. The phrase *"or in the course of proceedings in opposition to the grant of a patent"* has now been replaced with the expression *"to comply with the directions of the Controller issued before the grant of a patent"*.

116. Thus, an amendment proposed by the applicant in order to comply with a directive of the Controller is placed on a pedestal distinct from any voluntary amendment that the applicant may choose to introduce. Section 57(6) thus not only liberates the applicant from the rigours of contestation which follows amendments proposed at its discretion, it additionally highlights the intent of the statute to draw a clear line of distinction between amendments traceable to Section 57(1) and those covered by sub-section (6). The hearing and the adjudicatory process envisaged in Section 57 (4) of the Act would thus be limited to amendments proposed by the applicant of its own volition as opposed to amendments stimulated by a directive of the Controller.

117. Our conclusion that an amendment based upon the directions of the Controller would not fall within the ambit of Section 57(1) lends additional credence to our conclusion that the *examination process* is one which is separate and independent of proceedings of opposition. As observed hereinabove, the representation for opposition merely

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

constitutes input and material which the Controller may take into consideration while evaluating the patent application. Those representations do not absolve the Controller from examining the application and being satisfied that the patent is liable to be granted. That function is to be performed and the statutory duty discharged by the Controller irrespective of the merits or otherwise of the objection or even in a case where no objections may have been preferred. At the cost of repetition, it must be said yet again that the grant of a patent is not a natural or ineluctable consequence of rejection of an opposition.

Q. BALANCING OF INTERESTS

118. Bearing in mind the legislative command of Section 43 (1), we must also be cognizant of the imperatives of patent applications being considered and disposed of with due expedition. The legislative objective cannot be permitted to be defeated by what our Court was constrained to describe as *"serial oppositions"*. As would be manifest from the facts of the present case, the patent application came to be originally filed on 08 November 2006 and was published on 24 August 2007. The FER was drawn up and submitted on 30 January 2015. We have not been apprised of the proceedings that may have ensued between 2007 and 2015. Undisputedly, the last hearing on the PGO came to be concluded on 03 November 2022. Immediately and on the very next day a fresh PGO came to be filed by Dr. Kanchan Kohli. The said opponent has not proffered any justification for having approached the Controller after the hearing on the PGOs had concluded.

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Signing Date:09.01.2024
19:08:38

119. We are of the firm opinion that merely because a pre grant opposition can be filed up to the time that a patent is granted cannot be abused so as to delay and derail the legislative objective of expeditious consideration. We also bear in consideration the directions which had been framed by the IPAB with respect to the subject application as well as the directions framed by the learned Single Judge of our Court in the previous round of litigation advising the Controller to structure and organize the pending proceedings so as to facilitate speedy consideration of the patent application. The Court also takes note of the lament of the appellant when it was urged that sixteen out of the twenty-year maximum life of the patent was spent merely in prosecution of the patent application. We are thus unable to find any justification for sixteen years having been spent in disposal of a singular patent application.

120. While we are conscious of the respondents alleging that the appellant itself was guilty of having caused delay by moving various amendments, we do not propose to either delve on this issue or apportion blame. All that we deem necessary and are constrained to observe is that the office of the Controller would be well advised in formulating and adopting measures which would facilitate speedy consideration of patent applications consistent with the legislative mandate of Section 43 of the Act.

121. We are also of the considered opinion that both *UCB Farchim* as well as *Snehlata C. Gupte* correctly found that the Section 25 (2) remedy constitutes an adequate safeguard for rights that may be

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Signing Date:09.01.2024
19:08:38

claimed by a person interested. The right of challenge that stands preserved in respect of that class of opponents is reflective of the legislative objective of striking a fair balance between a pre grant representation for opposition and expeditious conclusion of the *examination process*. In fact, it is this facet which informs Rule 55 (5) and obliges the Controller to pass a compendious order disposing of objections and simultaneously disposing of the patent application.

122. While closing this chapter, we deem it apposite to observe that the decisions in *Neon Laboratories* as well as *Best Agrolife* related to voluntary amendments introduced by the patent applicant. As has been noticed by us in the preceding parts of this decision, the appellant has already conceded to the opponent being entitled to question any voluntary amendments that may be mooted by the applicant. We have independently found that such a right could be claimed since the opponent is already party in the opposition proceedings and would thus have to be apprised of any amendments that the applicant may seek to introduce. However, the fundamental question that we were called upon to examine was whether that right would also extend to participation in the examination process. That contention, for reasons recorded hereinabove, has already been answered in the negative. We have also found ourselves unable to accept the construct placed upon Rule 55 by the learned Single Judge. We thus hold that the aforenoted two decisions are clearly distinguishable.

R. THE IMPUGNED JUDGMENT- A BRIEF CRITIQUE

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Signing Date:09.01.2024
19:08:38

123. We also affirm and uphold the decision of this Court in *Haryana Pesticides* and are of the considered view that the learned Judge correctly noticed the distinction which must be accepted to exist between voluntary amendments and those which are predicated on a directive of the Controller. We thus find ourselves unable to uphold the view expressed by the learned Single Judge who spoke of the *examination* and *opposition* proceedings merging and reaching a point of convergence. We are also of the opinion that the learned Single Judge clearly erred in construing *NATCO Pharma* and ignoring the important caveat placed in para 22 thereof and which had in unequivocal terms provided that the observations with respect to amendments, generally made, would have no application to an amendment directed by the Controller under Section 15 of the Act.

124. The learned Single Judge has, in our respectful view, also clearly erred in holding Rule 55 (4) as being determinative of the question that stood raised. The said conclusion fails to bear in consideration that the said provision is confined to the statement and evidence that the applicant may submit pursuant to the notice that may be issued under sub-rule (3). The Rule 55 (3) notice, as is ex facie evident, is limited to the opposition filed and the Controller being satisfied that the representation merits consideration. It has no correlation to the *examination process*. The learned Judge clearly erred in construing Rule 55 (3) as constituting the *"Controllers objections"* losing sight of the fact that the objections which form the subject matter of sub-rule (3) are those which had been raised by an opponent. The view that we have

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

taken is further fortified from a conjoint reading of Rules 28 (3), 28A, 29 and 30 where too proceedings are confined to the applicant and the Controller. This buttresses our finding that the *examination process* constitutes a separate and independent pathway. Merely because the examination and opposition proceedings move parallelly would not lend credence to the argument of convergence.

125. On a more fundamental plane, we find that the challenge raised by NATCO was liable to be tested on the anvil of "*prejudice*" duly established and proven. The matter before the learned Single Judge appears to have proceeded solely on the basis of lack of notice with the respondent having not been called upon to establish prejudice and manifest injustice, and which are facets necessarily to be borne in mind while considering whether an impugned action is liable to be annulled on the ground of violation of the principles of natural justice. The impugned judgment also failed to appreciate the adequacy of the remedy created by Section 25(2) and which aspect had been duly underscored in *Snehlata C. Gupte*.

126. The record would further reflect that the decision of a coordinate Bench in *Haryana Pesticides* had been duly cited before the learned Single Judge. However, the aforesaid decision was sought to be distinguished with it being observed in para 102 that *"Unlike the present case…"* the said decision was dealing with amendments directed by the Controller. Identical was the position which obtained in the present case as would be evident from a reading of the notice dated 25 November 2022. While Mr. Sai Deepak chose to describe that notice

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

as being one issued in continued examination of the application, we find ourselves unable to concur. The said notice clearly called upon the appellant to attend to the cited objections and which would have necessarily entailed appropriate amendments being made. Merely because the notice failed to use the word "amend" explicitly would not detract from the same representing a directive of the Controller calling upon the appellant to amend and modify the patent application. The decision in *Haryana Pesticides* applied on all fours and was thus indistinguishable.

127. The learned Single Judge also appears to have rested his conclusion of convergence on the *Ayyangar Report* and which had in para 208 observed that ***"Stated broadly*** *an opposition proceeding constitutes an extension of the investigation undertaken by the Examiner."* Firstly, the aforesaid observation was made in the context of the Patent Enquiry Committee recommending deletion of opposition proceedings altogether. Secondly and more importantly, the Ayyangar Committee while evaluating that recommendation had taken note of the provisions contained in the English statute, namely, the Patents Act, 1949 and other legislations prevalent at that time. We have in the preceding parts of this decision noticed the significant changes introduced by the Patents Act, 1977 and which in terms of Section 21(2) explicitly declares that an opponent cannot claim to be a party before the Controller merely by virtue of having submitted a pre grant representation. Insofar as the aspect of balancing of public interest and the expectation of the patent applicant seeking expeditious

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

consideration, we may only observe that the said objective is clearly safeguarded in terms of the provisions of the Act referred to hereinabove.

S. CONCLUSIONS

128. In summation we deem it apposite to elucidate our conclusions as follows: -

A. The *examination process* is one which is initiated by the Controller in discharge of the statutory duty and obligation cast upon that authority. The examination of the patent application is a duty cast upon the Controller exclusively and proceeds independent of the objections that may or may not be preferred. While an objection does act in aid of the *examination process*, the same is intended to merely facilitate and assist the Controller in holistically examining the patent application. It does not detract from the independent duty and obligation cast upon the Controller to be satisfied that the application merits grant.

B. The pre-grant opposition stage opens the floor for eliciting a multitude of opinions extending beyond direct stakeholders to persons opposing the application for varied reasons. It enables the Controller to gather insights from a broad spectrum of sources as opposed to those who may have a direct stake in the matter. The *opposition procedure* structured as above leads to a comprehensive exploration of objections and perspectives

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

aiding the Controller in making an informed decision.

C. *Snehlata C. Gupte* correctly understood oppositions to grant as facilitating the Controller in the examination of the patent application. The opposition to the grant thus fosters and stimulates a broader consideration of the patent application.

D. The process is thus an open and participatory exchange ensuring that the evaluation process benefits from views expressed by a diverse body of opponents. While persons interested may also be in the fray, the Controller invites objections for the purposes of ascertaining and eliciting the views of a large cross section of persons who may for varied reasons seek to oppose the grant.

E. The *opposition process* as envisaged under the Act has a specific and a targeted purpose. Its primary objective is to provide a platform for *any person* to express objections and concerns regarding a patent application. The objections received during the *opposition process* play a crucial role enabling the Controller to have the benefit of diverse views on the question of grant including whether the application should be rejected or if amendments to the complete specifications are warranted. The *opposition process* therefore serves the avowed purpose of allowing external inputs to be placed for the consideration of the Controller enabling it to make a well-informed decision regarding the grant of the patent application.

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By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

F. However, the opposition by itself is not the sole determinative of whether the patent is liable to be granted. This since the mere rejection of the opposition would not inevitably result in the grant of a patent. The rejection of an opposition would not, ipso facto, lead to the grant of the patent or compel and bind the Controller to allow the patent application. Notwithstanding the rejection of an opposition, the Controller is legally as well as statutorily bound to independently examine the patent application based on the FER as well as on its enquiry on whether the patent is liable to be granted in law.

G. The *examination process* serves a wider and significant objective. This stage involves an in-depth assessment of the patent application, ensuring it complies with the statutory requirements for patent approval and facilitates a thorough and independent evaluation of the application by the examiner and the Controller. Maintaining a clear distinction between the *examination* and the *opposition process* is essential to not only fulfil the underlying objectives sought to be achieved but are also fundamental in ensuring that the sanctity and efficacy of each stage is maintained.

H. This separation helps in striking a balance between the need for a rigorous examination and the task of including various perspectives in the decision-making process. The *examination process* demands a focused evaluation of the patent application against set legal standards wherein the Controller is tasked

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

with the duty to ensure that only deserving inventions are granted patent protection. On the other hand, the *opposition process* serves as a forum for external stakeholders or any person to voice concerns and provide valuable insights thus contributing to a more comprehensive evaluation of the patent application.

I. To merge the process would be to compromise the rigors of examination since external inputs, though valuable, are best considered within the distinct and specific framework of the opposition. Merging these distinct processes would render the entire system unwieldy and counterproductive quite apart from negatively impacting the legislative policy of expeditious consideration. The separation, thus, subserves the legislative intent and allows for a more structured and organized approach where objections from various sources are factored in without disrupting the streamlined process of examination of the patent application.

J. The "*hearing*" that is contemplated in Rule 55 clearly appears to be confined to the representation alone, a position which clearly emerges upon a conjoint reading of sub-rules (3), (4) and (5). It is pertinent to note that sub-rule (3) visualizes the applicant being placed on notice if the Controller *"on consideration of the representation"* be *"of the opinion"* that the application for patent should either be refused or the complete specification amended. The process of a hearing thus

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

gets triggered upon the Controller on a consideration of the representation being of the opinion that the opponent has raised issues which either warrant the patent application being rejected or the specification being amended. Once the Controller is satisfied that the representation raises questions worthy of consideration, it would proceed to place the applicant on notice enabling it to file its statement and evidence.

K. However, these proceedings are unconcerned with issues that the Controller may have flagged in the course of the *examination process*. Thus, the right to oppose and to be heard is indelibly pivoted to the representation for opposition as distinct from questions that may arise from the FER or those that the Controller may identify as germane and material in the *examination process*.

L. It is also relevant to note that the opponent can claim a right of hearing only if the Controller is satisfied and is of the opinion that the representation merits consideration. A mere filing of a representation would not prompt or precipitate issuance of notice under Rule 55(4). The matter becomes contentious only once the Controller takes cognizance of the representation and issues notice to the applicant. It is at that stage and for the aforesaid reasons that the principles of natural justice become applicable.

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

M. It is thus apparent that the right of hearing that is contemplated in Rule 55(5) is one which is concerned solely with the adjudication and disposal of the representation for opposition. The opponent cannot be countenanced to have a right of hearing in the *examination process* merely because the statute confers such an opportunity at the stage where the Controller is considering the representation. While the pre grant opposition indisputably facilitates the decision-making function of the Controller, we find ourselves unable to accept the contention that the opponent must consequentially be recognised to have the right of participation or audience in the *examination process*.

N. We are also convinced that the statutory scheme as articulated by us above does not amount to either a denial or exclusion of the natural justice principles as was contended by the respondents. As was noted in the preceding parts of this decision, the opponent stands conferred a right to raise objections once the application is advertised. However, the *examination process* comprises of an independent evaluation and assessment of the patent application. The said exercise is not dependent upon an objection that may be raised. The provisions contained in Chapter IV of the Act do not envisage opponents or objectors being accorded an audience either before the examiner or the Controller. Consequently, the question of denial of a right of hearing does not arise at all.

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

O. The invocation of the doctrine of the principles of natural justice being liable to be read into the statute in the absence of an express exclusion is equally misconceived when one bears in mind the scheme underlying Chapter IV. The provisions enshrined in that part are fundamentally concerned with the examination and evaluation of the patent application by the examiner and the Controller. That is an obligation placed upon the Controller and one which is disassociated from opposition proceedings which form the subject matter of Chapter V.

P. As we observed earlier, the rejection of an opposition would not ipso facto lead to the grant of a patent. The statute in any case neither deprives a person from opposing the grant nor does it leave an interested person with a *fait accompli*. The rights of interested persons stand sufficiently safeguarded and preserved by Section 25(2). In both contingencies, the opponent can claim and is in fact conferred a right of hearing compliant with the principles of natural justice.

Q. More fundamentally, the right of hearing as asserted by the respondents proceeds in ignorance and disregard of the nature and extent of the *opposition process*. We have already held that the representation for opposition is principally aimed at aiding and facilitating the examination of the patent application. The representation is per se neither adversarial nor contentious. The pre grant opponent merely aids the Controller in a holistic examination of the patent application. Secondly,

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

the opposition in any case is confined to the grounds specified in Section 25(1). It is thus obligatory for the Controller to hear the opponent on the grounds of challenge that are raised. We fail to appreciate how the objector could claim a right of hearing in respect of grounds which were neither raised nor urged at its behest. It is this which convinces us to hold that the opponent can assert a right of hearing only in respect of the representation and cannot be recognised to have a right to intervene in the *examination process*.

R. In opposition proceedings, the focus primarily is on the grounds brought forward by the opponent, confining its examination to the issues raised in the opposition. This examination is triggered by information that emerges and is deemed prima facie to affect the application for grant and the claim for a patent. Thus, the significance of opposition lies in its role in aiding the Controller in conducting a comprehensive examination of the patent application.

S. Unlike an adversarial process, the opposition merely contributes to the overall assessment of the patent application and thus would not sustain a right of hearing being claimed in the *examination process*. The opponent's right to a hearing is circumscribed by the grounds specified in Section 25(1). The right of hearing is tethered to the grounds articulated in the opposition, ensuring that the opponent has a platform to present arguments and evidence in connection with the

Signature Not Verified
Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

challenges they have raised. This reinforces our view that the opponent's right to a hearing pertains specifically to the representation stage and does not grant them the entitlement to intervene in the broader *examination process*.

T. An amendment proposed by the applicant in order to comply with a directive of the Controller is placed on a pedestal distinct from any voluntary amendment that the applicant may choose to introduce. Section 57(6) thus not only liberates the applicant from the rigours of contestation which follows amendments proposed at its discretion, it additionally highlights the intent of the statute to draw a clear line of distinction between amendments traceable to Section 57(1) and those covered by sub-section (6). The hearing and the adjudicatory process envisaged in Section 57 (4) of the Act would thus be limited to amendments proposed by the applicant of its own volition as opposed to amendments stimulated by a directive of the Controller.

U. Our finding that an amendment based upon the directions of the Controller would not fall within the ambit of Section 57(6) lends additional credence to our conclusion that the *examination process* is one which is separate and independent of proceedings of opposition. As observed hereinabove, the representation for opposition merely constitutes input and material which the Controller may take into consideration while evaluating the patent application. Those representations

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Digitally Signed
By:KAMLESH KUMAR
Signing Date:09.01.2024
19:08:38

do not absolve the Controller from examining the application and being satisfied that the patent is liable to be granted. That function is to be performed and the statutory duty discharged by the Controller irrespective of the merits or otherwise of the objection or even in a case where no objections may have been preferred.

V. We find that the impugned judgment failed to test the allegation of violation of the natural justice principles on the bedrock of prejudice and manifest injustice. It also failed to bear in consideration the highly belated objection which was preferred by Dr. Kanchan Kohli, a day after the closure of hearing on PGOs and for which no plausible explanation was proffered. Bearing in mind the legislative mandate of Section 43(1), the Controller as well as Courts would be well advised to ensure that the pre grant opposition right is not abused and the *examination process* inordinately delayed or derailed by the filing of serial objections.

W. The learned Single Judge also misconstrued the Rule 55 hearing and which stands confined to the objections that may come to be preferred. The aforesaid Rule cannot be interpreted or recognised as seeking to either accord a participatory role upon the objector in the *examination process* or conferring a right to be heard in the course thereof.

X. For reasons noted in the body of this judgment, we are of the

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Signing Date:09.01.2024
19:08:38

firm opinion that the *examination* and *opposition process* though statutorily structured to proceed parallelly are independent and separate. It would be wholly incorrect to understand the provisions of the Act and the Rules as contemplative of convergence or merger.

T. OPERATIVE DIRECTIONS

129. Accordingly, and for the aforenoted reasons, we allow the instant appeal and set aside the impugned judgment. However, the present decision shall not detract from the right of an interested person to raise or pursue objections to the grant of the patent in terms of Section 25(2) of the Act, in accordance with law. The present judgment is also not liable to be construed as having ruled upon the merits of the grant of the subject patent. All rights and contentions of parties in that respect are kept open.

YASHWANT VARMA, J.

DHARMESH SHARMA, J.

JANUARY 09, 2024
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