

## A Practical Approach to Fulfilling Section 8 Requirements

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### Background

Section 8 of the Indian *Patents Act, 1970*<sup>1</sup> mandates applicant(s) filing an application for a patent in India to furnish information pertaining to applications for a patent for 'the same or substantially the same invention' filed in any country outside India. Section 8 consists of two subsections that each create specific obligations on the applicant(s).

Section 8(1)(a)<sup>2</sup> read with Rules 12(1) and 12(1A) of the *Patents Rules*<sup>3</sup> requires the applicant(s) to provide 'a statement setting out detailed particulars of such application(s)' in the prescribed 'Form 3' at the time of lodging the application in India or subsequently within six months.

Section 8(1)(b)<sup>4</sup> read with Rule 12(2) of the *Patents Rules*<sup>5</sup> further requires the applicant(s) to undertake to furnish information of 'every other application,' if any, filed elsewhere subsequent to the filing of the statement under Section 8(1)(a) within six months of filing such new application.

Section 8(2)<sup>6</sup> read with Rule 12(3) of the *Patents Rules*<sup>7</sup> requires the applicant(s) to 'furnish details, as may be prescribed, relating to the processing of the application in a country outside India' upon requisition by the Controller within six months of such a request. The obligations under Sections 8(1)(b) and 8(2) of the *Patents Act* are to be carried out up to the disposal (grant or refusal) of the application for the patent in India. Table 1 below summarizes these requirements.

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<sup>1</sup> *The Patents Act 1970*, as amended by the *Patents (Amendment) Act 2005* (Act 15 of 2005) at Section 8 [*Patents Act*].

<sup>2</sup> *Ibid.* at Section 8(1)(a).

<sup>3</sup> *The Patents Rules, 2003* at Sections 12(1) and 12(1A) [*Patents Rules*].

<sup>4</sup> *Patents Act, supra* note 1, at Section 8(1)(b).

<sup>5</sup> *Patents Rules, supra* note 3, at Section 12(2).

<sup>6</sup> *Patents Act, supra* note 1, at Section 8(2).

<sup>7</sup> *Patents Rules, supra* note 3, at Section 12(3).

### *Practical Considerations*

The obligations under Sections 8(1) and 8(2) are different. It is important to note that the obligations under Section 8(1) automatically arise upon filing an application for patent in India. The applicant(s) is required to provide the statement under Section 8(1)(a) at the time of filing the Indian patent application or within six months thereafter. The applicant(s) is also required to undertake to provide details of any new filings outside India under Section 8(1)(b) within six months of such new filing. Thus, once the requisite information has been provided in the prescribed Form 3 at the time of filing the application in India or within six months thereafter, there is no need to resubmit an updated Form 3, for example, to merely update a change in 'status' of a previously disclosed application. However, when any new application(s) for 'the same or substantially the same invention' is made elsewhere, it also follows that Form 3 has to be updated to include details regarding such new application(s). At this time, although not legally mandated, applicant(s) may consider updating the 'status' information of previously listed applications as well.

**Table 1:** Summary of Requirements under Section 8 of the *Patents Act*

<b>Section</b>	<b>Obligation</b>	<b>When to comply?</b>	<b>How to comply?</b>
8(1)(a)	Furnish a statement setting out detailed particulars of applications for a patent for 'the same or substantially the same invention' filed in any country outside India.	At the time of filing the application for patent in India or within six months thereafter.	Furnish the requisite details in prescribed Form 3.
8(1)(b)	Undertaking to furnish information of 'every other application,' if any, filed elsewhere subsequent to the filing of the statement under Section 8(1)(a).	Within six months of filing such new application.	Furnish the new application information by updating Form 3. Status of previously included applications may be updated, if desired.
8(2)	Furnish details, as may be prescribed, relating to the processing of the application in a country	Within six months of the Controller's requisition.	No prescribed format. But provide all relevant details as requisitioned by the Controller, including but

outside India' upon requisition by the Controller.

not limited to, copies of Office Actions, Notice of Allowances/Rejections, allowed/granted claims etc. Form 3 with updated status may also be submitted, if desired.

In contrast, the obligation under Section 8(2) arises only 'when so requested by the Controller.' The time limit to comply, once a request has been made, is six months from the date of the request by the Controller. There is no obligation on the applicant(s) to voluntarily submit details relating to the processing of related foreign applications. Thus, the obligations under Section 8(2), modelled after the Canadian *Patent Rules*, arise only when a specific request is made by the Controller and are analogous to a Rule 29 requisition by a Canadian Examiner. The obligations are not like the duty 'to disclose to the Office all information known to that individual to be material to patentability' imposed by 37 CFR 1.56 in the USA.

The *Patents Act* or the *Patents Rules* do not define the 'same or substantially same inventions.' Accordingly, it is important that the applicant(s) takes a considered view as to which applications qualify in order to fulfil their obligations under the Section 8 disclosure requirements. Typically, applications sharing a common priority date; Paris convention or PCT national stage family members; continuation applications; divisional applications; and continuation-in-part applications; may all be considered as related applications for the purposes of fulfilling the Section 8 disclosure requirements.

Compliance with the Section 8 disclosure requirements is important as non-compliance is a ground for both pre-and post-grant opposition.<sup>8</sup> Non-compliance is also a ground for revocation of a granted patent.<sup>9</sup> Following a period of uncertainty in the interpretation of the obligations under Section 8, the Delhi High Court<sup>10</sup> has settled the position that willful suppression of information material to the patentability is required to

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<sup>8</sup> *Patents Act*, *supra* note 1, at Section 25(1)(h).

<sup>9</sup> *Ibid.*, at Section 64(1)(m).

<sup>10</sup> *Koninklijke Philips Electronics N.V v. Maj. (Retd) Suresh Behl & Anr*, 2012 (52) 1 PTC (Del) at paragraph 156 and *Telefonaktiebolaget LM Ericsson vs. Intex Technologies (India) Ltd.*, High Court of Delhi, I.A. No. 6735/2014 in CS(OS) No.1045/ 2014 at paragraph 104.

violate the provisions of Section 8. The Court also clarified that the revocation of a patent for an alleged violation of Section 8 was not automatic, but was at the discretion of the High Court.

The time limit for furnishing information under Section 8(1) is six months from the date of filing the Indian application or within six months of filing a new related application elsewhere in the world.<sup>11</sup> The time limit for furnishing information under Section 8(2) is six months from the date of requisition of such information by the Controller.<sup>12</sup> Both these time limits may be extended by up to one month at the discretion of the Controller.<sup>13</sup>

Typically, a requisition for information under Section 8(2) is made by the Controller in the First Examination Report (FER). Until recently, the deadline to place the application in condition for grant was 12 months from the date of the FER.<sup>14</sup> Thus, in instances where the FER issued prior to May 16, 2016 includes a requisition for information under Section 8(2), the applicant(s) has to provide the Section 8(2) information within six months of the date of the FER, while the remaining issues could be addressed before the lapse of the 12 months. When a response to the FER is submitted subsequent to furnishing of Section 8(2) information, it is recommended as a good practice that any previously provided Section 8(2) information be updated as well, if required. An update may be necessitated, for example, on account of a new office action, notices of allowances or rejections etc. issued in the interim period.

With effect from May 16, 2016, the time limit for placing the application in condition for grant has been reduced to six months from the date of the FER, with the possibility of extension for a period of three months.<sup>15</sup> Thus, without considering any extension of time, the deadline for placing the application in condition for grant and for furnishing the Section 8(2) information now coincide. From a practical perspective, applicant(s) may now consider filing, when possible, the Section 8(2) information along with the response to the FER within six months of the date of the FER or within the first month of extension of time (as response to a Section 8(2) requisition may be extended by a month under Rule 138). Of course, in

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<sup>11</sup> *Patents Rules*, *supra* note 3, at Sections 12(1A) and 12(2).

<sup>12</sup> *Ibid.*, at Section 12(3).

<sup>13</sup> *Ibid.*, at Section 138.

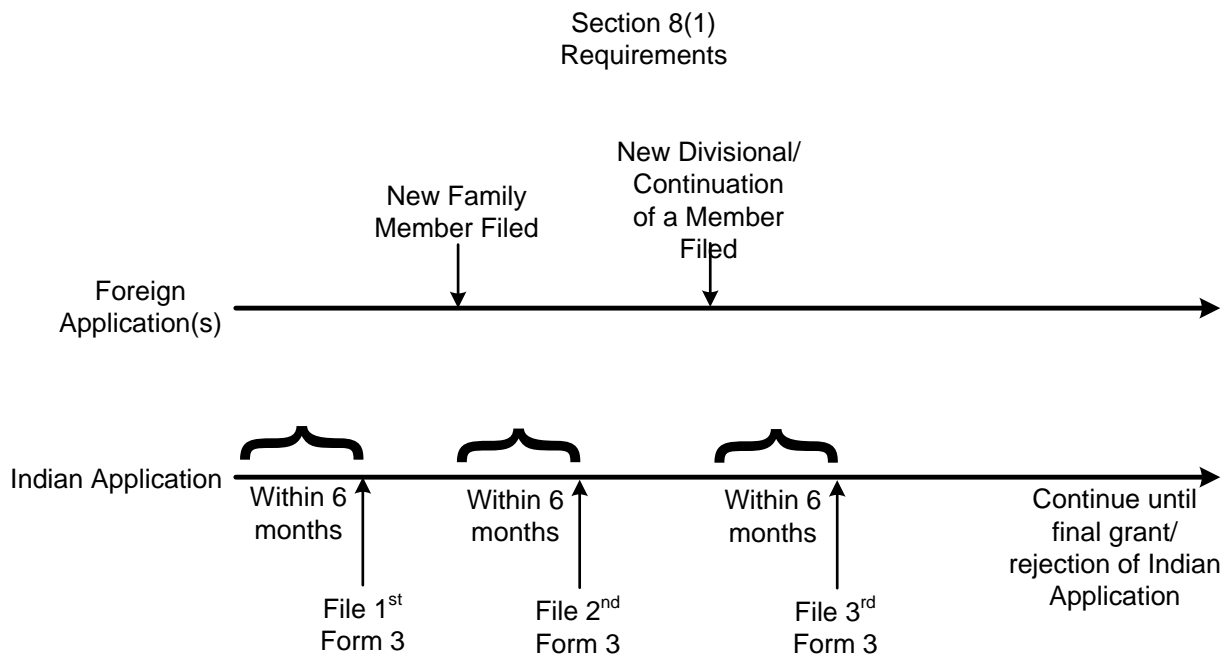
<sup>14</sup> *Ibid.*, at Section 24B(4) as it read prior to the 2016 amendments.

<sup>15</sup> *Ibid.*, at Sections 24B(5) and 24B(6).

instances where an extension of time for filing a response to the FER is sought beyond one month past the six month deadline, the two may have to be filed separately. Even so, it may be advisable that any previously provided Section 8(2) information be updated when filing a response later.

Having regard to the above discussion, applicant(s) may adopt the following approaches in order to comply with the Section 8 disclosure requirements.

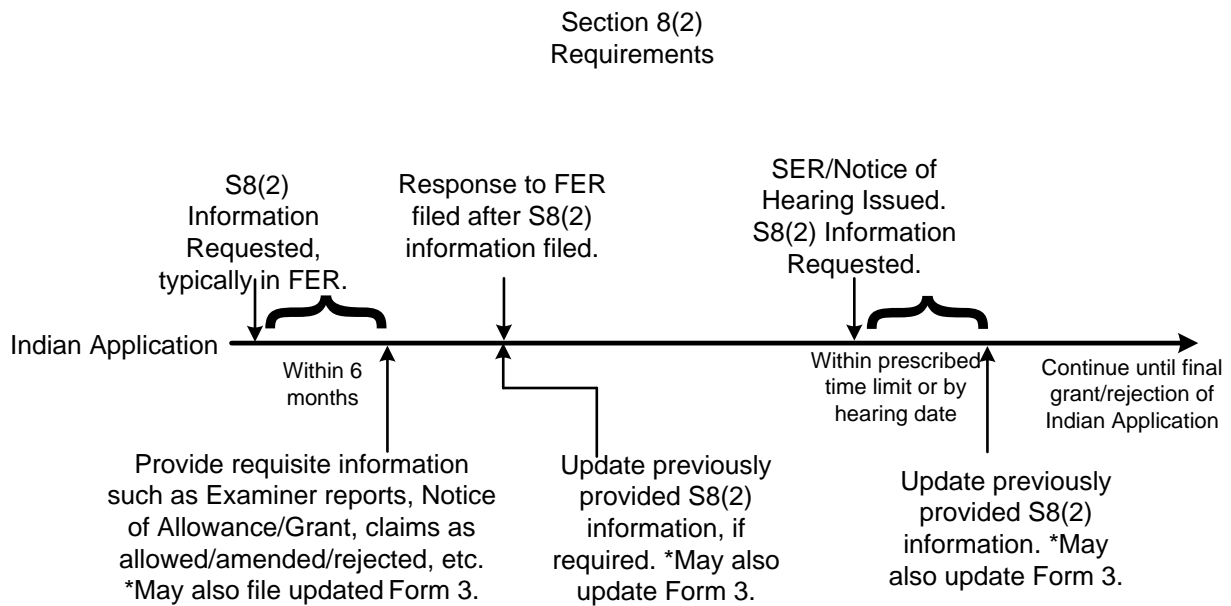
**Section 8(1) Requirements:**



**Notes:**

1. A new/updated Form 3 must be filed within 6 months of a new foreign filing.
2. Upon filing a subsequent Form 3, the "status" of previous foreign applications may be updated to reflect current status.
3. No new/updated Form 3 is required merely to update the status of a previously included foreign application.

## Section 8(2) Requirements:



### Notes:

1. Section 8(2) information is required only when requisitioned and must be filed within 6 months of such requisition.
2. When a response to FER is filed separately after S8(2) information has been filed, it may be advisable to update S8(2) information, if required, for example, when a new office action/allowance/rejection has been received in the interim.
3. \*- Although not statutorily required, when responding to a Section 8(2) request, an updated Form 3 may be filed to reflect current status of foreign applications, if the applicant(s) so desires.

### Conclusions

It is evident that the obligations under Section 8(1) are triggered by external events, such as filing a new foreign application, a divisional application, a continuation application, or a continuation-in-part application. However, the obligations under Section 8(2) are triggered by the Controller's requisition for information pertaining to related foreign applications. As such, the two obligations are not linked to each other. There is no statutory requirement to provide an updated Form 3 if there is a change in status of foreign application(s) when responding to Section 8(2) requests. However, some applicants may choose to file an updated Form 3 in an abundance of caution.

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