

# **Patent invalidation by way of opposition**

**By Gunjan Sharma**

## **Introduction**

In many jurisdictions around the world, lengthy and costly litigation proceedings are, in most cases, the only way by which a patent can be invalidated. The Patents Act, 1970 (hereafter referred as “the Act”), of India, however, includes provisions whereby a person/party, referred to as opponent, may oppose a patent application before grant of patent or may oppose a granted patent in the Patent Office itself. The opposition proceedings before the grant of a patent are usually referred to as pre-grant opposition and those after the grant are usually referred to as post-grant opposition.

In India the pre-grant and post-grant opposition proceedings take place before the Controller General of Patents. The major advantage of initiating opposition proceedings in the Indian Patent Office is that it is time bound and so, the interested parties do not have to go through lengthy and tedious procedures in different courts, which may also involve considerable time till the matter is decided. The costs incurred in opposition are also minimal as compared to litigation costs.

From the Patent Office’s point of view, the pre-grant opposition provides additional information to the examiner, which helps prevent grant of a patent for an invention that does not fully comply with patentability or other procedural requirements. On the other hand, post-grant opposition prevents a party or a person from enjoying the monopoly of a patent that was wrongfully granted.

In this article, we will take a look at the grounds of opposition, the procedures to be followed for pre-grant and post-grant opposition, pros and cons of using opposition for invalidation, and some trends in filing of opposition cases. In addition to the Act, reference has been made to chapters 8 and 9 of the Manual of Patent Office Practice and Procedures (MPPP), version 01.11 dated 22<sup>nd</sup> March, 2011.

## **Grounds of opposition**

The pre-grant and post-grant opposition can be initiated only on specific grounds listed in Sections 25(1) and 25(2), respectively, of the Act. No other grounds other than the grounds stated in the Act can be taken for opposing the patent. Some of the major grounds of opposition, which are common to both pre-grant and post-grant oppositions, are summarized below:

- Invention was previously published in India or elsewhere, or was previously claimed in India.
- Invention formed a part of the prior public knowledge or prior public use or traditional knowledge of any community.

- Invention is obvious and lacks inventive step.
- Invention does not constitute an invention within the meaning of the Act or the invention is not patentable under the Act.
- Failure to disclose information or furnishing false information relating to foreign filing by the applicant.

### **Pre-grant opposition**

Section 25(1) of the Act and Rule 55 of Patents Rules, 2003, provide the procedure to be followed for pre-grant opposition, also referred to as representation by way of opposition. Pre-grant opposition can be initiated by *any person*, after the application has been published and before the grant of the patent. There is no prescribed form for filing pre-grant opposition and also there is no fee involved in filing pre-grant opposition.

The Controller considers the representation only if the request for examination has been filed for the application to be opposed. In case a request for examination has not been filed by the applicant, it is possible for the opponent to first file the request for examination under Section 11B as an interested person, and then file the pre-grant opposition.

Procedures involved in pre-grant opposition can be summarized as follows:

1. An opponent can file pre-grant opposition by way of representation (in writing) to the Controller, in the appropriate patent office, against grant of the patent. The representation shall include a statement and evidences in support of the representation. The person may also request for a hearing if desired.
2. Upon receiving the representation from the opponent the Controller gives a notice to the applicant (of the patent application) along with the copy of the representation.
3. The applicant shall, if they so desire, provide reply to the representation *within three months* from the date of notice.
4. Upon receiving the reply the Controller may refuse the grant of patent or may ask for amendment of the complete specification within *one month* after receiving the reply.
5. In case a hearing is initiated, the Controller, after considering the representation and submission made during hearing may either grant the patent or refuse the grant, within one month from the completion of proceedings.

### **Post-grant opposition**

Section 25(2) of the Act and Rules 55A to 70 of Patent Rules, 2003 provide the procedure to be followed for post-grant opposition. Post-grant opposition can be initiated, on any of the specified grounds, by *any person interested*, after the grant of a patent but before a period of one year from the date of publication of grant of the patent.

Unlike pre-grant opposition, post-grant opposition has to be filed by a *person interested* and not just any person. The expression ‘person interested’ is defined under Section 2(t) as a person/party engaged in, or promoting, research in the same field as that to which the invention (to be opposed) relates. Also, unlike pre-grant opposition, post-grant opposition has to be filed in the prescribed manner by paying a fee. The notice of post-grant opposition may be filed in Form 7.

Procedures involved in post-grant opposition can be summarized as follows:

1. Opponent submits, to the Controller, the notice of opposition. With the notice, the opponent submits nature of the opponent's interest, the facts upon which his case is laid and relief which the opponent seeks and evidences. The opponent has to deliver a copy of the submission to the patentee also.
2. Upon receiving the notice, the Controller forms an opposition board consisting of three members and nominates one of the members of the board as chairman. The examiner involved during the prosecution of the application cannot be a part of this board.
3. The patentee may challenge the opposition, by replying to the notice within *two months* from the date of receiving the notice. If the patentee does not reply to the notice within two months, the patent is deemed to be revoked. The opponent may also file evidence in reply to the response received from the patentee within *one month* from the date of delivery of reply from the patentee. No further replies may be delivered by either party until the Controller so directs.

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4. The board conducts the examination of the notice along with the replies, and submits a report on the notice *within three* months from the date when the documents were forwarded to them.

5. The Controller then schedules a hearing between both the parties. After the hearing, and taking into account the recommendation of the opposition board, the Controller decides the case as to whether the patent is to be revoked or maintained and whether costs need to be awarded to the patentee.

### **Considerations for filing oppositions**

There are various pros and cons that need to be considered while using opposition as a tool for patent invalidation. As stated, opposition proceedings are time bound and, typically, less costly and quicker than litigation proceedings.

Further, in the absence of case laws for evaluating patentability requirements, opposition proceedings may help clarify how the patent office evaluates concepts of novelty and inventive step. The pre-grant procedure may also delay the grant of patent and thus increase the overall patent costs incurred by the applicant.

However, as pre-grant opposition is not taken up by the Controller until the application is examined, and since the current pendency of applications is quite high, it may result in considerable delay before the pre-grant opposition is taken up by the Controller. Further, in case of pre-grant opposition, both the parties need not be present for the hearing and the Controller may decide the merit of the case based only on the submissions made by the parties.

Moreover, in the case of both pre-grant and post-grant oppositions, although the decision given by the Controller in an opposition proceeding can be challenged in the courts; a decision in the favor of the applicant may strengthen the validity of the patent application.

### **Trends in opposition filings**

A majority of the pre-grant and post-grant opposition cases so far have been filed by pharmaceuticals companies. However, noticing the time-bound and controlled process of opposition, other companies have also started taking advantage of the provisions for opposition. Major grounds which are being considered by opponents for opposing a patent application are novelty under Sections 25(1)(b) and 25(2)(b), and inventive step under Sections 25(1)(e) and 25(2)(e). Of late, procedural grounds, such as those laid down in Sections 25(1)(h) and 25(2)(h) regarding compliance with Section 8, are also being used as one of the major grounds for opposition.

The use of procedural grounds has come to the fore especially after the judgment given by the Delhi High Court in the case of Chemtura Corporation vs. Union of India, where the High Court held that a patent could be invalidated for the reason that the requirements of Section 8 were not fully complied with or information regarding corresponding foreign applications was withheld.

### **Conclusion**

As can be observed, the procedures provided under the Patents Act, 1970 in India for pre-grant and post-grant opposition proceedings before the Controller are time bound and quicker as compared to other forums. Further, the Controller's decisions can be used to understand how novelty and inventive step requirements are evaluated by the Patent Office. In effect, patent opposition is becoming an effective tool for companies and organizations that are interested in either stopping a patent application from being granted or revoking a patent in an economical and time efficient manner.

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