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Article

A Practical approach to fulfilling Section 8 requirements

By **Mukundan Chakrapani**

Background

Section 8 of the Indian *Patents Act, 1970*¹ 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)² read with Rules 12(1) and 12(1A) of the *Patents Rules*³ 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)⁴ read with Rule 12(2) of the *Patents Rules*⁵ 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)⁶ read with Rule 12(3) of the *Patents Rules*⁷ 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.

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

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

² *Ibid.* at Section 8(1)(a).

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

⁴ *Patents Act*, *supra* note 1, at Section 8(1)(b).

⁵ *Patents Rules*, *supra* note 3, at Section 12(2).

⁶ *Patents Act*, *supra* note 1, at Section 8(2).

⁷ *Patents Rules*, *supra* note 3, at Section 12(3).

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*

Section	Obligation	When to comply?	How to comply?
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 outside India’ upon requisition by the Controller.	Within six months of the Controller’s requisition.	No prescribed format. But provide all relevant details as requisitioned by the Controller, including but 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.⁸ Non-compliance is also a ground for revocation of a granted patent.⁹ Following a period of uncertainty in the interpretation of the obligations under Section 8, the Delhi High Court¹⁰ has settled the position that willful suppression of information material

to the patentability is required to 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.¹¹ The time limit for furnishing information under Section 8(2) is six months from the date of requisition of such information by the Controller.¹² Both these time limits may be extended by up to one month at the discretion of the Controller.¹³

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.¹⁴ 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

⁸ *Patents Act*, *supra* note 1, at Section 25(1)(h).

⁹ *Ibid.*, at Section 64(1)(m).

¹⁰ *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.

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

¹² *Ibid.*, at Section 12(3).

¹³ *Ibid.*, at Section 138.

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

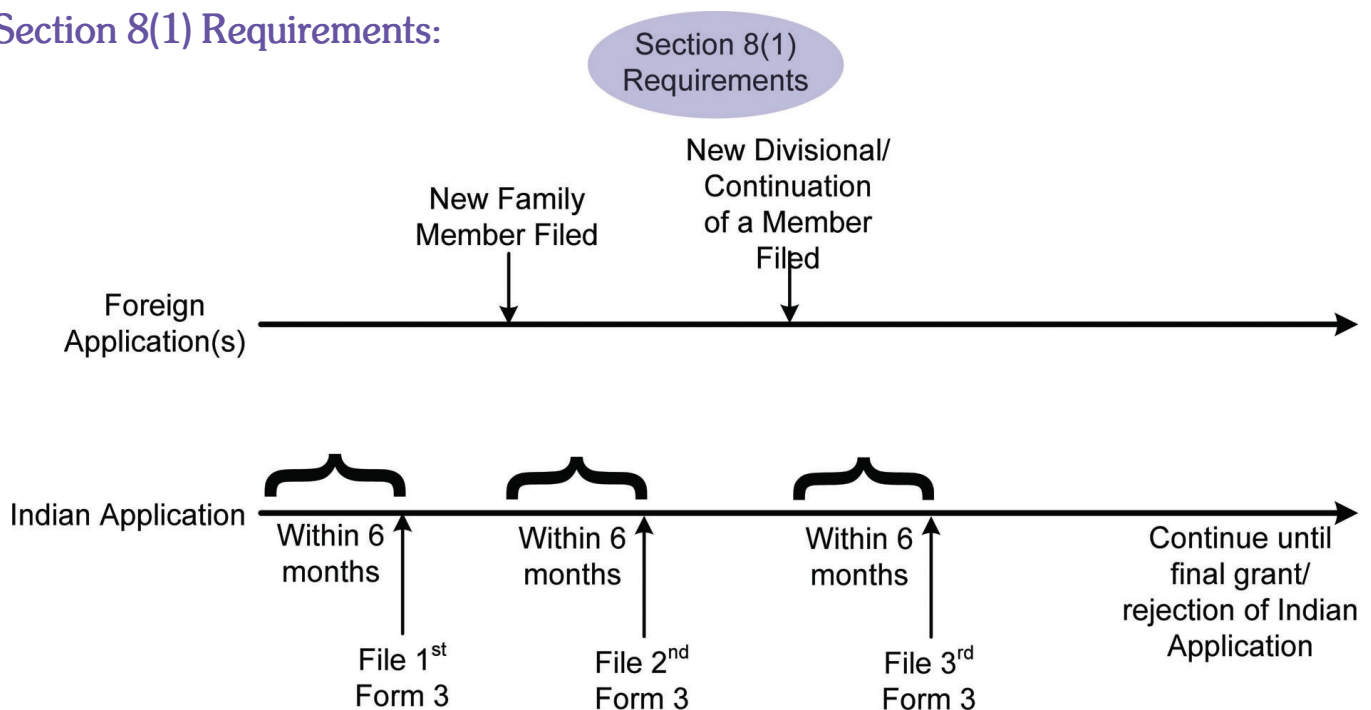
FER is submitted subsequent to furnishing of Section 8(2) information, it is recommended as a good practice that any previously provided Section 8(2) information be updated as well, if required. An update may be necessitated, for example, on account of a new office action, notices of allowances or rejections 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.¹⁵ 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 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:



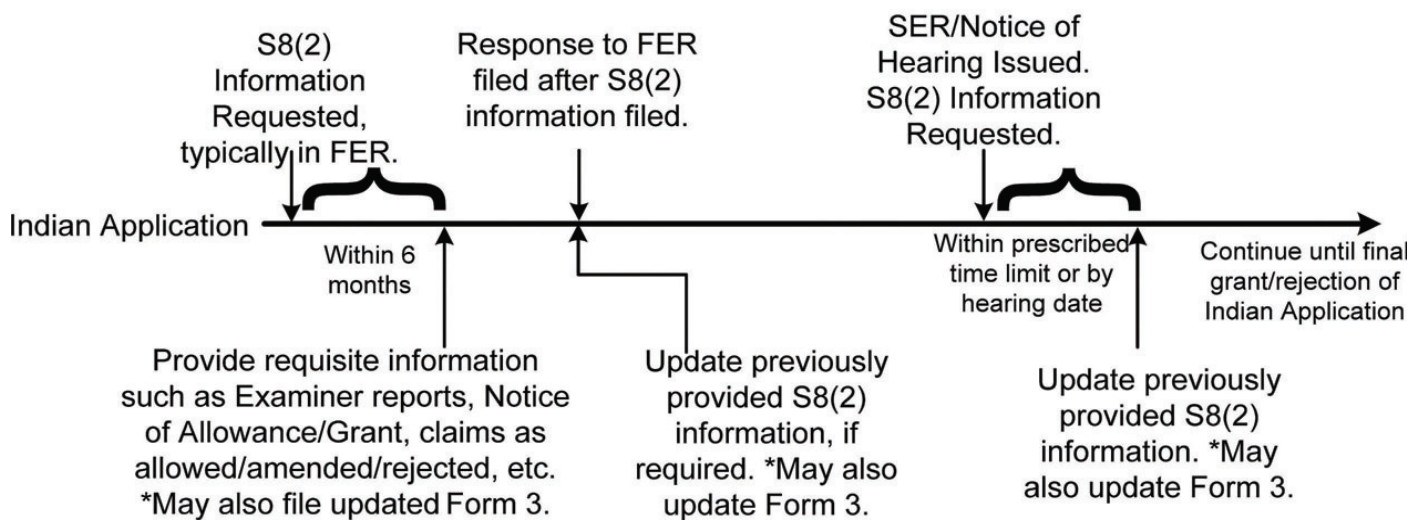
Notes:

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.

¹⁵ *Ibid.*, at Sections 24B(5) and 24B(6).

Section 8(2) Requirements:

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.

[The author is Director, IPR Practice, Lakshmikumaran & Sridharan, New Delhi]

Statutory Updates

Number of requests for expedited examination limited to 1000

As per Public Notice dated 14-6-2016, the number of requests for expedited examination of applications to be received by the patent

office has been limited to 1000. An applicant may request for expedited examination on certain grounds. For instance, if the applicant has designated the Indian Patent Office as the International Searching authority or

it is a startup and so on. Under expedited examination procedure the Controller refers the application to the Examiner who should submit his report not later than 2 months from date of reference. The Controller should dispose the report within one month from date of receipt. Rule 24 C (13) of Patent Rules, 2003 provides that the Controller may limit this number of requests to be received in the year.

Guidelines issued for facilitators and start-ups for processing applications for

patent, trademarks and designs

The list of facilitators of patent for start-ups was issued on 6-6-2016. By way of Public Notice dated 8-6-2016, it has been clarified that a start-up willing to file patent application shall select a facilitator from the approved list and opt for one out of the 3 facilitators suggested by the Head of the respective Patent office of the jurisdiction. For design and trademark, the list of facilitators approved for patent shall be applicable.

Ratio Decidendi

Disparaging advertisement – Delhi HC grants interim relief

Delhi High Court has granted a limited interim injunction restraining the defendant from airing in its advertisement pertaining to a hair removal cream, the blue coloured razor manufactured by the plaintiff under a trademark. The court in this regard observed that there is immediate co-relation on seeing the razors in the defendant's advertisement as that of the plaintiff, inasmuch as in the fleeting snaps of the advertisement it is not expected that the ordinary consumer will place any emphasis on the shape of the razors. It was noted that the color of the product is most prominent in a short video advertisement and not minute differences. Further, the Court also restrained the defendant from claiming in the advertisement, that the hair removal cream of the defendant is twice as good as when compared to hair removal by a razor belonging to the plaintiff. However, any restraint on the defendant on its claim that use of the razor

leaves stubble, was denied by the Court observing that the same is a matter of trial and that the said facts had to be proved either way. [*Gillette India Limited v. Reckitt Benckiser (India) Pvt. Ltd.* - CS(OS) 251/2016, Delhi high Court, decided on 1-6-2016]

Trademark infringement – High Court awards liquidated damages

The rival marks 'D-VENIZ', 'VENIZ-XR' and 'VENZ-OD' were used in respect of pharmaceutical products. The defendant did not adduce any evidence of having registered VENZ-OD. It also changed the mark to 'ZYVEN' during the pendency of proceedings. The High Court with emphasis on stricter approach while applying the test to judge the possibility of confusion of one medicinal product for another by the consumer held that the plaintiff's mark had been infringed and granted permanent injunction against use of the mark by the defendant. It also awarded liquidated damages and rendition of profits. [*Sun Pharmaceuticals Industries Ltd v. Cadila Healthcare, & Zydus*

HealthCare C.S.985/2009, Madras high Court decided on 3-6-2016]

Trademark – Acquiescence requires overt action encouraging use of rival mark

Examining the claim of infringement of mark ‘VARDHMAN’ registered as VARDHMAN PLAZA, VARDHMAN GROUP, by rival group who were members of the same family, the Delhi High Court observed that acquiescence *prima facie* does not arise in such situation because there is nothing to show the plaintiff’s action, overt or otherwise encouraging

defendant to continue using the mark. The rival parties had been engaged in litigation for long. The Court did not find force in the defendant’s argument that since the plaintiff had known the use of the mark ‘VARDHMAN’, the suit was barred by acquiescence, delay and laches. The Court said that delay and laches were a mixed question of fact and law and had to be proved conclusively. [*Vardhman Properties Ltd v. Vardhman Realtech P Ltd & Ors*, I.A. 21931/2014 in CS(OS) 3378/2014, Delhi High Court decided on 31-5-2016]

NEW DELHI

5 Link Road, Jangpura Extension,
Opp. Jangpura Metro Station,
New Delhi 110014

Phone : +91-11-4129 9811

B-6/10, Safdarjung Enclave
New Delhi - 110 029

Phone : +91-11-4129 9900

E-mail : lsdel@lakshmisri.com

MUMBAI

2nd floor, B&C Wing,

Cnergy IT Park,

Appa Saheb Marathe Marg,

(Near Century Bazar)Prabhadevi,
Mumbai - 400025.

Phone : +91-22-24392500

E-mail : lsbom@lakshmisri.com

CHENNAI

2, Wallace Garden, 2nd Street

Chennai - 600 006

Phone : +91-44-2833 4700

E-mail : lsmds@lakshmisri.com

BENGALURU

4th floor, World Trade Center

Brigade Gateway Campus

26/1, Dr. Rajkumar Road,

Malleswaram West, Bangalore-560 055.

Ph: +91(80) 49331800

Fax:+91(80) 49331899

E-mail : lsblr@lakshmisri.com

HYDERABAD

'Hastigiri', 5-9-163, Chapel Road

Opp. Methodist Church,

Nampally

Hyderabad - 500 001

Phone : +91-40-2323 4924

E-mail : lshyd@lakshmisri.com

AHMEDABAD

B-334, SAKAR-VII,

Nehru Bridge Corner,

Ashram Road,

Ahmedabad - 380 009

Phone : +91-79-4001 4500

E-mail : lsahd@lakshmisri.com

PUNE

607-609, Nucleus, 1 Church Road,

Camp, Pune - 411 001.

Phone : +91-20-6680 1900

E-mail : lspune@lakshmisri.com

KOLKATA

2nd Floor, Kanak Building

41, Chowringhee Road,

Kolkatta-700071

Phone : +91-33-4005 5570

E-mail : lskolkata@lakshmisri.com

CHANDIGARH

1st Floor, SCO No. 59,

Sector 26,

Chandigarh - 160026

Phone : +91-172-4921700

E-mail : lschd@lakshmisri.com

GURGAON

OS2 & OS3, 5th floor,

Corporate Office Tower,

Ambience Island,

Sector 25-A,

Gurgaon- 122001

Phone: +91- 0124 - 477 1300

Email: lsgurgaon@lakshmisri.com

INTERNATIONAL OFFICES :

LONDON

Lakshmikumaran & Sridharan Attorneys (U.K.) LLP

Octagon Point,

St. Paul's,

London EC2V 6AA

Phone : +44 20 3823 2165

E-mail : lslondon@lakshmisri.com

GENEVA

Lakshmikumaran & Sridharan SARL

35-37, Giuseppe Motta

1202 Geneva

Phone : +41-22-919-04-30

Fax: +41-22-919-04-31

E-mail : lsgeneva@lakshmisri.com

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