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## FILE FOREIGN APPLICATION PROSECUTION HISTORY WITH INDIAN PATENT OFFICE

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During the prosecution of the Indian patent, one provision (Section 8), which has attained importance is the requirement of filing information about foreign patent applications in relation to the same or substantially the same invention. Noncompliance of this provision is a ground for pre-grant opposition, post-grant opposition and revocation of a patent, irrespective of the fact that the invention is novel, non-obvious and useful.

The courts and tribunals in the recent past in India have revoked the patents for non-compliance with Section 8.

This article analyzes the relevant statutory provisions and the learning from recent decisions.

# What is the Section 8 Requirement?

Section 8 of the Indian Patents Act, 1970 comprises of two mandatory requirements: voluntary filing of information (Section 8 (1)) and filing of information upon request by the Controller (Section 8(2)) in relation to patent applications filed outside India for the same or substantially the same invention.

## Voluntary filing:

- At the time of filing of the Indian Patent Application (“IPA”) Form 3 is required to be filed with Indian Patent office:
  - Providing the following information about foreign filing : the name of the country where the application is being prosecuted, the application number, date of filing of the application, status of the application, date of publication and date of grant; and
  - Giving an undertaking that up to the date of grant of patent in India applicant would keep the patent office informed in writing the details regarding corresponding applications filed outside India.
- From the date of filing of the IPA till the grant of the Indian patent, the applicant is required to file the above information in relation to any new filing done outside India, within 6 months of such filing.<sup>1</sup>

The obligation to file this information is not only in relation to the patent application that the patent applicant in India may itself be prosecuting outside India but also applies to same or substantially the same patent applications being prosecuted by a person other than the applicant, where to his knowledge, such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file along with his application. Thus, for example if a patent application for same or substantially the same invention has been assigned by the Indian patent applicant to a third party in the US, information regarding the same also has to be filed with patent office by the patent applicant in India.

## Information to be filed upon request by the Controller:

Any time after an application for patent has been filed in India, the controller can request details regarding the processing of the patent application in a country outside India and in such an event the applicant has to furnish the information within a period of six months from the date of receiving such request from the controller.<sup>2</sup> Such a request is typically made by the controller through an examination report.

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1. Rule 12(2) of the Patent Rules, 2003.

2. Rule 12(3).

# How to comply with the requirements of Section 8?

On reading of Section 8, several issues arise:

- How the expression “substantially same invention” should be interpreted?
- Is there difference in the information to be provided under Section 8(1) and 8(2)?
- Does “details regarding the processing of application in a country outside India” include examination reports, prior art, office action or other documents involved in the prosecution of the corresponding patent outside India.
- If yes, then the amount of information that has to be provided especially in cases of PCT applications, since most of these applications enter national phase in multiple countries, will be voluminous plus translations where required will have to be provided.

The High Courts in India, Intellectual Property Appellate Board (IPAB) and the controller in opposition and revocation matters in the recent past have addressed the issue of compliance with Section 8 of the Patents Act, 1970. It is essential to briefly discuss these cases, in order to determine the best possible way to comply with Section 8.

## Chemtura Corporation vs. Union of India<sup>3</sup>

Chemtura Corporation (“Chemtura”) was granted Indian Patent No. 213608 on January 9, 2008. Union of India (“UOI”) alleged that Chemtura had failed to make a Section 8 disclosure on their own but also blatantly mislead the Patent Office when the Patent Office through its letter dated October 20, 2004 had called upon Chemtura to disclose *“details regarding the search and/or examination report including claims of the application allowed.... in respect of same or substantially same invention filed in any one of the major patent office such as USPTO, EPO and JPO etc”*. In its response Chemtura did not submit any relevant information. In fact Chemtura had replied by a letter dated October 17, 2005 that there had been no further development and thus no further information was required to be submitted.

According to Chemtura as on October 20, 2004 there was no further development with regard to the same or substantially the same invention outside India. Chemtura contended that the search and the examination report are required to be furnished only if it has resulted in allowing of claims by the foreign Patent Office. The Delhi High Court did not accept this argument. The High Court observed that the patent applicant was required to furnish any and all foreign search reports in its possession at the time of its reply to the patent office i.e. as on October 17, 2005. The court referred to the US patent office (USPTO) prosecution history and stated that USPTO had issued multiple office actions repeatedly rejecting Chemtura’s patent application until the claims were finally narrowed down to an acceptable limit and all these amendments took place before October 17, 2005. Similarly, broad claims in its European application had been narrowed down due to several prior art citations and the same was also not disclosed. The Delhi High Court held that an applicant was required to periodically update the Controller on the current status of the corresponding foreign applications and that mere furnishing of information on the status of the application did not satisfy the requirements of Section 8 (2) of the Act.

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3. 2009(41)PTC260(Del).

The Delhi High Court did hold that all the foreign search reports have to be filed with the patent office at the time of filling a response to the examination report. However, it seems that the judgment of the court was greatly influenced by the fact that Chemtura did not disclose the adverse USPTO and European prosecution history. This case essentially tells us that a conduct of the applicant while complying with the Section 8 requirement is very important. Thus, if the applicant has been forthcoming and has not tried to conceal any adverse examination reports, it will greatly help the applicant in establishing their case for complying with the Section 8 requirements.

## Roche vs. Cipla<sup>4</sup>

Roche was granted an Indian Patent No. 196774(IN '774) on February 23, 2007 and application for the Indian Patent was filed on March 13, 1996. 'IN 774 was a combination of Polymorph version A+B of a drug. Roche had filed an infringement action against Cipla for infringing IN '774.

In its counter claim Cipla alleged that Roche did not disclose while prosecuting IN '774 about US Patent 6900221 ( US '221) which was filed subsequent to the filing of IN '774 in 2000. Cipla contended that 'US 221 consisted of a polymorph B version of the drug and thus relates to the same or substantially the same invention and should have been disclosed to the controller as required under Section 8.

According to Roche polymorphic version B of the said compound would not come within the meaning of same or substantially the same invention. Further, Roche also contended that Polymorphic version B compound is different from IN '774 patent and therefore Roche was not required to disclose US '221 under Section 8.

A corresponding Indian patent application IN '507 for US '21 had been applied by Roche. An opposition proceeding was filed against 'IN 507 and in this proceedings the controller had held that IN '507 and IN '774 were similar or substantially similar and an order regarding the same was passed by the controller on December 15, 2008. Roche contended that they were always under the belief prior to the said order of the controller that IN '774 and US '221 are different, so they could not have filed US '221 prior to the order dated December 15, 2008 and since IN '774 was granted in February 2007, Roche did not have any obligation under section 8 to disclose US '221.

The Delhi High Court observed that “plaintiffs who claim to be one of the leading companies in medicinal research and masters in chemical science cannot be oblivious to the fact that conversion of one compound into another Polymorph version may be either same or similar to the earlier version of the compound. It is not reasonable to presume that upon the decision of the Controller in the year 2008 only, the said researchers remained in the company of plaintiffs were enlightened of the fact that both the patents are actually the same or substantially the same inventions.” Therefore, the court concluded that it cannot be said that only after the order was passed on December 15, 2008 Roche was able to understand the similarity between the IN '774 and IN '221.

Further, Roche in its infringement claim had contended that the drugs made available in the market by Cipla, was a polymorph version B of the drug and this drug fell within the scope of IN '774. The court held that in view of this Roche cannot contend while filing two applications for patents in India IN '774 and IN '507 it was not aware that both patents were for same or substantially the same invention.

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4. 2012(52)PTC1(Del).

Hence, the court held that Roche had not complied with the requirements of section 8. However, the court did not revoke the patent. The court stated that the discretion to revoke or not to revoke a patent lies with the Court and this exists by use of the word "may" under Section 64 of the Patents Act. In view of the fact that Cipla to avoid a claim of infringement had argued that both the compounds as claimed in IN '774 and IN '507 are different in their Polymorphic forms, therefore the in effect supported the position that the combination of Polymorph A and B as contained in IN '774 is distinct from Polymorphic version B which is contained in US '221.

This case clearly illustrates that it is not just the information regarding the same application that has to be filed with the patent office but also the information regarding **substantially the same patent applications** has to be filed to comply with the requirements of Section 8. It is interesting to note here that the court did not revoke the patent even though it concluded that Section 8 had not been complied by Roche. The Delhi High Court relied on the fact that Section 64 uses the word 'may' and this gives the Court discretion not to revoke the patent based on the facts.

This decision has been heavily criticized at various forums, the argument being that if the court finds under Section 64 that the patent is not novel or lacks inventive step then the court does not have any discretion not to revoke the patent and the similar reasoning also applies to non-compliance with Section 8. It is also interesting to note that Section 64 states that a patent can be revoked on "any of the following grounds". Thus, if the court finds that Section 8 has not been complied with, solely on this ground the court can revoke the patent.

### Tata Chemicals vs. Hindustan Lever<sup>5</sup>

Hindustan Lever (Lever) was granted Indian patent No. 195937 (IN '937) on August 26, 2005. Tata Chemicals (Tata) filed a revocation petition before the Intellectual Property Appellate Board (IPAB) to revoke IN '937 on multiple grounds under Section 64 including non-compliance with Section 8.

Tata contended that Lever had not filed the International Preliminary Examination Report (IPER) issued by the PCT search authority before the patent office and thus Lever had not complied with requirements under Section 8 of the Patents Act.

Lever contended that since section 8 (2) stated that information/details pertaining only to a country outside India has to be filed, IPER did not fall within this ambit because it was issued by a PCT search authority, which is an inter-government body and not a country outside India.

However, IPAB held that IPER related to processing of an application in a country outside India and that "the word 'processing' is an all-encompassing word, it would take within it the series of actions or steps to be taken in order to achieve a particular end." Thus, the Respondent was obligated to file the IPER for complying with Section 8.

It is pertinent to note here that in this case the very patent that was discussed in IPER was also cited by the Indian examiner in the FER. However, IPAB held that this did not waive off the duty of Lever to submit all relevant information.

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5. MANU/IC/0091/2012.

The purpose of Section 8 is to provide assistance to patent office in prosecution of the Indian patent application by providing information of other patent offices as regards novelty, non-obvious, utility and other observations. In our view Section 8 requirement should be read in the light of this intent. In this matter, if the IPER was already to the knowledge of the Indian patent office, non-filing of the same should not have been considered as violation of Section 8.

## Richter Gedeon vs. Cipla<sup>6</sup>

Cipla filed a post grant opposition to the Indian Patent No. 202297 of Richter Gedeon under Section 25(2) of the Patents Act alleging multiple grounds including non-compliance with Section 8. The patentee had filed a national phase application in India on December 9, 2003 with an undertaking under Form 3. The next updated Form 3 was filed on October 25, 2004 only mentioning the patent application's entry into several countries. The Controller observed that "even though substantial updated information on the corresponding application filed in foreign countries were expected to be available like the information in JP and USA, the same was not informed to the Indian Patent Office. I view this irregularity by patentee as violation of provision as required under Section 8 of Patents Act. I conclude that such a ground of opposition is validly established by the opponent." From the facts narrated in the order it appears that the applicant had voluntarily abandoned the JP and USA applications after the grant of the Indian patent. The obligation to provide updated information with the patent office, is applicable till the Indian patent is granted and not thereafter. However, from the order of the Controller it appears that the applicant may not have kept the Patent Office updated about the information in relation to the JP and USA prosecution before the grant of patent.

## Conclusion

The objective of submitting documents under Section 8 is to assist the examiner in examining the patent application.<sup>7</sup> In most of the cases especially patent applications entering through National Phase, the patent application will be simultaneously being prosecuted in multiple countries. The search/ examination reports and office actions being generated in all such prosecutions will be voluminous and also be in multiple languages and translations of the same will also have to be provided to the Indian patent office. This essentially becomes a very expensive proposition for the patent applicants. Further, submitting a large amount of documents to the patent office does not assist the patent office in carrying out effective examination of the patent application. Thus, it is essential to determine the documents that need to be submitted to satisfy the Section 8 requirement. This task becomes more difficult since all the decisions regarding Section 8 are inconsistent and do not exactly specify what documents need to be submitted to comply with Section 8. Even the Draft Manual of Patent Practice and Procedure does not provide any guidance regarding complying with Section 8 requirements.

Some guidance with regard to this can be obtained by determining the intent of the legislature in formulating this section. "*Report on the revision of Patent Law*" by Justice Ayyangar, September, 1959 had formed the basis for the Patents Act, 1970 wherein it has been stated in the section on notes on clauses with respect to Section 8 what has to be submitted to the patent office is "the objections if any, raised by the patent office of

6. Controller's decision on a post grant opposition available at <http://164.100.176.38/decision/1119-MUMNP-2003-483/post%20grant%20opposition%20decision%20202297.pdf> (last visited 15th January 2013).

7. "*Report on the revision of Patent Law*" by Justice Ayyangar, September, 1959, page 138 available at [http://spicyip.com/docs/Rajagopala\\_Ayyangar\\_Report/Rajagopala\\_Ayyangar\\_Report\\_61-80.pdf](http://spicyip.com/docs/Rajagopala_Ayyangar_Report/Rajagopala_Ayyangar_Report_61-80.pdf) (last visited 21st January, 2013).

such countries on the ground of want of novelty and patentability or otherwise and the amendments directed to be made or actually made to the specification or claims in the foreign country”<sup>8</sup> has to be filed with Indian Patent Office. Further, the Section as recommended by Justice Ayyangar read as “an undertaking that he would up to the date of the acceptance of the complete specification, communicate to the Controller details of all objections taken, orders passed on the ground of the invention lacking novelty or patentability and the amendments effected to the specification or claims”<sup>9</sup> This clearly shows that legislature intended this information submitted by the applicant to assist the Controller in examining the patent.

This provision was introduced when the Indian patent office did not have ready access to the information in relation to foreign patents. With the advent of internet and most important patent office having their data online, access as such is not a hurdle any more.

In view thereof, the patent office should ideally come out with the clear guidance as to what is required to be submitted and when to comply with the requirements of Section 8. However, the applicant will still have to diligently analyze all the documents relating to the processing of the patent application outside India periodically to identify the documents that need to be filed before the Indian Patent Office, to avoid any challenge either during the prosecution or post grant of Indian patent.

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8. *Id*

9. *Id*