

India

45. The Indian Patent Act provides both pre-grant and post-grant opposition. Where an application for a patent has been published but a patent has not been granted, any person may, in writing, lodge an opposition with the Controller against the grant of a patent.¹ The opposition may be filed on the following grounds together with supporting evidence and a request for hearing, if so desired:

(i) the applicant 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;

(ii) the claimed invention has been published before the filing date (priority date) in a specification of an application filed in India on or after January 1, 1912, or in any other documents in India or elsewhere, provided that the disclosure does not fall under the grace period exception as contained in Chapter VI;

(iii) the claimed invention is claimed in a claim of a complete specification published on or after the filing date (priority date) of the applicant's claim and filed in pursuance of an application for a patent in India before the filing date (priority date) of the applicant's claim;

(iv) the claimed invention is publicly known or publicly used in India before the filing date (priority date). Where a claimed invention is a process invention, it shall be deemed to be publicly known or publicly used in India before the filing date (priority date) of the claim if a product made by that process had already been imported in India before that date, except where such importation has been for the purpose of reasonable trial or experiment only;

(v) the claimed invention is obvious and clearly does not involve any inventive step, having regard to the published matters referred to in (ii) or having regard to what was used in India before the filing date (priority date);

(vi) the subject of the claimed invention is neither an invention within the meaning of the Act nor patentable under the Act;

(vii) the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(viii) the applicant has failed to disclose the information required by Section 8 of the Act (information regarding corresponding foreign applications) or has furnished false information;

(ix) where priority of convention application is claimed, the application was not filed within 12 months from the priority date of first application;

(x) the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;

¹ Section 25(1) of the Patent Act 1970

(xi) the claimed invention in the complete specification is anticipated having regard to the knowledge, oral, or otherwise, available within any local or indigenous community in India or elsewhere.

46. According to Rule 55(1A), no patents shall be granted before the expiry of a period of six months from the date of publication of the application. In other words, third parties have at least six months from the publication date of the application to file a pre-grant opposition. If the Controller is of the opinion that the application should be refused or be amended, he shall notify that effect to the applicant together with a copy of the opponent's documents. In response, the applicant may file his statement and evidence in support of his application within three months from the date of the above notice from the Controller. On consideration of the statement and evidence from both parties, the Controller would decide whether a patent should be granted or not.

47. Once a patent is granted, third parties have another opportunity to file an opposition.² Such opposition can be filed by any interested person before the expiry of a period of one year from the date of publication of grant of a patent based on the same grounds as described in paragraph 45. The Controller shall notify the patentee where such notice of opposition was submitted.³ The opponent shall send a written statement setting out the nature of the opponent's interest, the facts upon which he bases his case and relief which he seeks and evidence, if any, along with notice of opposition and shall deliver to the patentee a copy of the statement and evidence, if any.⁴ The patentee is given an opportunity to respond to the opponent's claim and to submit any evidence supporting the patent within two months from the date of receipt of the copy of the opponent's statement and evidence. The patentee shall also send a copy of his response to the opponent. If the patentee does not contest within the above two months period, the patent shall be deemed to have been revoked.⁵ Once the opponent received a copy of the response made by the patentee, he may, within one month, submit evidence strictly confined to matters in the patentee's evidence, and shall deliver to the patentee a copy of such evidence.⁶

48. The post-grant opposition is examined by an Opposition Board consisting of three members. It examines all documents and evidence submitted, and submits its recommendations to the Controller. On receipt of the recommendation and after giving the patentee and the opponent an opportunity to be heard, the Controller shall order either to maintain or to amend or to revoke the patent.⁷ The Controller shall not take into account any personal document or secret trial or secret use when determining the compliance with (iv) and (v) in paragraph 45.

49. Section 26 of the Patents Act provides specific rules for the case where the opposition was successful on the grounds that the claimed invention was wrongly obtained from the opponent (see item (i) in paragraph 45 above). In such a case, the Controller may decide that the patent should be amended in the name of the opponent. Similarly, where a part of the invention described in the specification is wrongly obtained from the opponent, the

² Section 25(2) of the Patents Act 1970

³ Section 25(3) of the Patents Act 1970

⁴ Rule 57 of the Patents Rules 2003

⁵ Rule 58(2) of the Patents Rules 2003

⁶ Rule 59 of the Patents Rules 2003

⁷ Section 25(4) of the Patents Act 1970

Controller may decide that the specification be amended by the exclusion of that part of the invention.

50. The decision of the Controller regarding pre-grant opposition and post-grant opposition may be appealed to the Intellectual Property Appellate Board within three months from the date of the decision, unless the Appellate Board allows another timeframe in accordance with its rules. However, in case where patent is granted by the Controller after refusing pre-grant opposition, in such circumstances, the decision of the Controller is not appealable before Intellectual Property Appellate Board but a writ petition can be filed in the High Court against such decision.