INTELLECTUAL PROPERTY - INDIA

Court issues contrasting rulings on duty of disclosure in patent applications

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Introduction

The Indian Patent and Trademark Office (IPO) has established a number of rules concerning the submission of material information known to a patent applicant (eg, prior art patents or publications, applications and commonly owned patents or publications). These rules define an applicant's duty of disclosure. In India, patents may be legally challenged and potentially held to be unenforceable based on a failure during prosecution before the IPO to comply with this duty.

Under the Patents Act 1970, it is essential that information known to be material to patentability and examination of a patent application be brought to the attention of the IPO. This duty of disclosure rests squarely on the inventor, attorney or agent who prepares or prosecutes the particular patent application. This effectively means that the inventor, attorney or agent must be made aware of the duty of disclosure.

Mandatory disclosures

All information that is "material to the patentability" of the application must be disclosed to the IPO. For applications filed in India and those filed abroad by way of the Paris Convention or the Patent Cooperation Treaty (PCT), or for applications filed first outside India that enter India by way of the convention or the PCT, Section 8 of the act specifies the information that must be disclosed by the applicant as follows:

> *"Information and undertaking regarding foreign applications-*
>
> *(1) Where an applicant for a patent under this Act is prosecuting...* an application for a patent *in any country outside India* in respect of the same or substantially the same invention,... he shall file along with his application *or subsequently within the prescribed period as the Controller may allow—*
>
> > *(a)* a statement setting out detailed particulars of such application*; and*
> >
> > *(b) an undertaking that, up to the date of grant of patent in India, ...*keep the Controller informed... of detailed particulars as required under clause (a) *in respect of every other application* relating to the same or substantially the same invention*, if any, filed in any country outside India subsequently to the filing of the statement referred to in the aforesaid clause, within the prescribed time.*
>
> *(2) At any time* after an application for patent is filed in India *and* till the grant of a patent *or refusal to grant of a patent...*, the Controller may also require the applicant to furnish details,

... relating to the processing of the application in a country outside India." (emphasis added)

Judicial interpretation

Under Section 8(1), the term "the same or substantially the same invention" is used. However, this term has not been specifically defined under the act. Furthermore, contrasting positions have been laid out in case law issued by the Intellectual Property Appellate Board and the high courts and practical guidelines issued by the IPO. The matter is further compounded by the variable stance of the courts in applying Section 8.

In *Chemtura Corporation v Union of India*(1) the Delhi High Court vacated an injunction for non-compliance with Section 8 requirements by the applicant. The applicant had withheld adverse US and European patent office actions for counterpart US and European applications and failed to provide the same to the examiner at the IPO. Consequently, the court held that all foreign search reports must be filed with the IPO.

However, in *F Hoffmann-La Roche Ltd, Switzerland v Cipla Ltd, Mumbai*(2) the Delhi High Court did not revoke the patent, even though the rights holder had not disclosed the details of similar patent applications in other jurisdictions. The rights holder (Roche) argued that there was no mandatory requirement under the act to provide details of a patent application that was filed after the Indian application had been filed.

Roche had been granted Indian Patent 196,774 (the ''774' patent). In a counter action in a suit for infringement, Cipla alleged that the '774 patent was invalid because Roche did not disclose the details of US Patent 6,900,221 (the ''221' patent), which was "substantially the same".

The priority date for the '774 patent was March 30 1995, whereas the earliest priority date for the '221 patent was November 11 1999. The only connection between the Indian '774 patent and the US '221 patent was that they dealt with the same subject matter (ie, quinazoline derivatives). Furthermore, in opposition proceedings before the controller of patents at the IPO, Cipla cited a later patent application filed by Roche (841/DEL/1996) entitled "Quinazoline Derivatives" as being similar, the same or substantially the same. This application later became Indian Patent IN/PCT/2002/507/DEL (the ''507' patent). The '507 patent had a priority date of April 27 1995. Cipla contended that Roche should have known about the later filed patent application, as it dealt with the same subject matter and the applicant was the same, thereby fulfilling the first part of the scope of Section 8. The US counterpart of the Indian '507 patent was US Patent 5,770,599.

However, the court took a different stance. With respect to the disclosure requirement for Section 8, the court held that Roche was required to submit the '221 patent prosecution history to the IPO while prosecuting the '774 application, as it had similar content. The court observed:

> "*This is more so, when the specification of subsequently filed patent as US'221 exhibited as DW 1/9* contained the same information relating to efficacy and the stability of the earlier patent *whatever inference the Patent Controller could have drawn either in favor of the patentee or against him, that by itself does not absolve the responsibility of the plaintiffs as applicant for patent to disclose such information before the Controller*." (emphasis added)

Materiality standard

Under US patent law, 'material information' has been defined as follows:

> "*Information is considered 'material to patentability' if it (1) establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim, or (2) refutes, or is inconsistent with, a position the applicant takes in either (i) opposing an argument of unpatentability relied upon by the patent office, or (ii) asserting an argument of patentability.*
>
> *A* prima facie *case of unpatentability is one which compels a conclusion that the claims are unpatentable under the preponderance of the evidence standard when the claims are given their broadest reasonable interpretation consistent with the specification, and before any*

> *consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.*"(3)

In India, this standard has been further bolstered by the intent of the legislature in formulating Section 8. The Report on the Revision of Patent Law issued by Justice Ayyangar in September 1959 formed the basis for Section 8 and provided for the information that should be submitted to the IPO. The report stated that:

> "*the objections if any, raised by the patent office of 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 [must be submitted to the IPO].*" (emphasis added)

The legislature's intent was that such information would form the basis on which the question of patentability would turn, known as the materiality standard or the 'but for' test.

Comment

It is clear from the above decisions that it is better to be cautious than to risk revocation of a patent on procedural grounds. However, decisions from different forums, although still pending, suggest that an applicant should disclose all material information in its control to the IPO.

The judgment in *Hoffmann-La Roche* appears to create an obligation for the applicant to make disclosures in the application that are material to the patentability of the application. Therefore, practitioners must submit the details of the PCT or priority application at the time of filing the application before the IPO (or at national phase entry). The IPO should also be kept informed of developments in different jurisdictions, and detailed office actions and translations thereof should be provided to the IPO.

In addition, prior art that has been cited against the application should be provided in its entirety. This includes the international preliminary report on patentability and the international search report. Where the applicant files a continuation, continuation in part or divisional application in a jurisdiction other than India before grant of the Indian patent, the applicant is also duty bound to provide details of the divisional, continuation or continuation-in-part applications to the IPO before the application becomes a patent, notwithstanding the number of examination reports issued by the IPO.

It is usual for the IPO to request information from key jurisdictions (eg, US, Europe, Japan) under Section 8(2). Once the examiner has asked for this information, the applicant must provide detailed office actions reports from these jurisdictions to the IPO.

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Endnotes

(1) MANU/DE/1880/2009.

(2) MANU/DE/4182/2012.

(3) The US Patent Office Procedures at 37 CFR, Sections 1.56 and 1.555, www.uspto.gov/web/offices/pac/mpep/s2001.html.