Review and Appeal – A Bird's Eye View

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This article about remedies against patent application rejection in India was first published by Managing Intellectual Property. By **Arpita Kulshrestha.** Amidst the widespread awareness for protecting inventions and securing robust patents, it is pertinent that a Patent Applicant is also aware that the rejection of patent application after examination is not the end of the road. The question is What Next? The legal maxim *ubi jus ibi remedium* which translates to "where there is a right there is a remedy", is a befitting solution to the occasion. The patent Applicant has a right to remedy when faced with the rejection of the application. The Patents Act confers upon the patent Applicant the following rights as remedies before different fora:

- the right to file Review against the order of the Learned Controller of Patents [hereinafter referred to as "Controller"] rejecting the application, before the Patent Office; and
- the right to file an Appeal against the order of the Controller, before the Intellectual Property Appellate Board [hereinafter referred to as "IPAB"]

Before examining the right to Review, it is worth noting that the Controller has, for the purpose of discharging his/her functions, the same powers as are vested in a civil court under the Code of Civil Procedure, 1908 in respect of certain matters provided under section 77 of the Patents Act. One such power conferred by the Patents Act is the power of the Controller to Review his own order on an application made before him provided under clause (f) of section 77 of the Patents Act read with Order 47 Rule 1 of the Code of Civil Procedure, 1908. The Patent Applicant can avail any of the following grounds in his application for Review before the Patent Office:

- discovery of new matter or evidence which was not within the knowledge of the applicant after exercise of due diligence or could not be produced at the time the order was passed;
- a mistake or an error apparent on the face of record;
- any other sufficient reason which is analogous to the preceding grounds

While all three grounds mentioned above are available to the Applicant, the most sought after ground in the Review petition is that of 'a mistake or error apparent on the face of record' in the order of the Controller. The question is - what could be the possible instances of such mistake or error apparent on the face of record. Before delving into such instances, it is important to note that there are several precedents that establish the law on review. In fact, the Hon'ble Supreme Court has in several decisions laid down the principles governing a Review petition, as well as, defined the grounds for Review. For example in ***Kamlesh Verma v Mayawati and Ors (2013), 8 SCC 320***, the Hon'ble Supreme Court held the following principles, amongst others: "...an error apparent on the face of record should not be an error which has to be fished out and searched"…. A review is by no means an appeal in disguise whereby an erroneous decision is re-heard and corrected but lies only for patent error" The above principles were further reiterated in ***Perry Kansagra v Smriti Madan***

Kansagra (2019) SCC Online SC 211, where the Hon'ble Supreme Court held that *"..the error must be self evident"*. The Controllers of Patent have relied upon the above decisions of the Hon'ble Supreme Court while rendering their verdict on review petitions for example, in the order of the Controller in ***Transasia Biomedicals, Mumbai v Controller of Patents in IN340/MUM/2006*** and ***Lalit Mahajan v Tulip Diagnostics in IN692/KOL/2007***. Having said this, on a perusal of the decisions of the Controller of Patents on Review petition under Section 77(1)(f) of the Patents Act, it is noted that some of such instances that constitute a mistake or error apparent on face of record are as follows:

- where the **Applicant has not received a hearing notice**;
- where the **Controller has not considered the amended claims** filed along with the hearing submissions;
- where the **Controller has based his decision on a prior art or ground without giving the Applicant an opportunity to address the same**
- **violation of principles of natural justice**

Having dealt with Review, the other remedy available to the aggrieved Applicant is that of preferring an Appeal before the IPAB against the order of Controller of Patents. Section 117A of the Patents Act provides the Applicant the right to appeal against certain orders of the Controller of Patents. The right to appeal is a broad right that allows the Applicant to raise various grounds against the findings of the order and to get his application reassessed. Again, on a perusal of the orders of the IPAB it is noted that in several instances, the IPAB has set aside orders of the Controller of Patents on various grounds such as

- **Violation of principles of natural justice:** For example in ***Telefonaktiebolaget LM Ericsson v The Controller of Patents Trademarks in OA/18/2011/PT/DEL*** the Hon'ble IPAB held that the matter should be heard afresh since the Patent Applicant was not given an opportunity to put forth his submissions, amounting to violation of principles of natural justice;
- **Vague findings and unreasoned orders:** For example in OA/18/2011/PT/DEL the Hon'ble IPAB held that the order is devoid of any reasoning on the rejection.
- **Rejecting the application on a prior art or a ground without communicating the same to the Applicant:** For example in ***Resprotect GMBH v The Controller of Patents & Designs in OA/23/2010/PT/DEL*** the Hon'ble IPAB held

"The patent office while dealing with grant of patent exercises quasi-judicial Power. They decide the right that claimed which may be opposed in a fair manner. If there is an opposition, they hear both sides and decide the matter in accordance with law. If there is no opposition till they test the application in accordance with the law of patents, allow the grant or reject it. A quasi-judicial authority is not an adversary of the patent applicant. Therefore any objection that may arise in this regard, any prior art that will be relied on must be made known to the applicant before the date of hearing."

- **Reassessment of substantive grounds.** For example in ***CSIR v Hindustan Lever Limited and Ors in OA/37/2013/PT/DEL***, the Hon'ble IPAB reassessed novelty and inventive step

In fact, in several cases the IPAB has remanded the matter back to the Patent Office with directions for hearing the matter afresh. Even though Review and Appeal are two separate proceedings, nevertheless appeal provides a wider coverage to the Applicant, while the scope of review proceedings are restrictive and limited in nature. It is noteworthy here that an appeal lies before a forum which is different from the forum that rejected the patent application, while Review by virtue of its very nature is before the same Controller who rejected the application. To conclude, a Review is a suitable remedy for patent rejections caused by self-evident errors, while on the other hand an Appeal is an excellent remedy for reassessment of the order of the Controller of Patents. This panoramic view of the remedies enables the Patent Applicant to strategize his next steps.

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