



Pre-Grant Opposition Filed After IPAB Admits an Appeal Challenging Refusal of a Patent Application Held Not Maintainable

News & Updates • November 11, 2020

The Bombay High Court recently dismissed a writ petition challenging an IPAB order, holding that a pre-grant opposition in patent appeals is not maintainable once an appeal against the Controller's refusal has been accepted and allowed.

Brief Facts

The Respondent, Pfizer Products Inc., filed an application entitled 'Chiral Salt Solution' based on PCT application number PCT/IB02/01905 at the Indian Patent Office on October 27, 2003. The application was refused by the Indian Patent Office on March 27, 2014 following which an application requesting a review of the refusal order and then an appeal against the refusal order were filed. Following the grant of the application in Europe on October 27, 2014, the IPAB directed the Patent Office to examine the application afresh. The Patent Office re-examined the application and rejected it yet again on 3rd September 2015. An appeal against said refusal was filed at the Intellectual Property Appellate Board (IPAB) on September 14, 2015 and the hearing of the appeal was concluded on August 10, 2020. Meanwhile the Petitioner, namely, Dhavan Deyora filed a pre-grant opposition on August 18, 2020 at the Indian Patent Office and intimated the IPAB regarding the filing of the pre-grant opposition on the same date. The IPAB on August 21, 2020 dismissed the order refusing the application and also rejected the contentions of the Petitioner, holding that once an appeal is kept for pronouncement of reasons an application to the effect that an order should not be pronounced cannot be entertained.

The Petitioner approached the Bombay High Court with a writ petition against the order of IPAB dated August 21, 2020 on September 22, 2020 contesting that finding of the IPAB that no pre-grant opposition can be filed once an application has been rejected by the Controller of Patents, is contrary to the scheme of the Patents Act.

Decision of the Bombay High Court

On Factual Assertions of the Petitioner

The Petitioner had asserted that there was no reference to the appeal being allowed on August 10, 2020 in any handwritten endorsement or record of the IPAB in view of which the appeal should be considered to have been allowed only on August 21, 2020.

The Bombay High Court noted that in para 61 of the order of the IPAB, it has been noted by the tribunal that the hearing was concluded on August 10, 2020 and the appeal was allowed and was fixed for pronouncing the reasons on August 21, 2020.

Noting a Supreme Court decision wherein it was held that when the court records as to what transpired before the court, it is conclusive of the fact stated, the Bombay High Court held that since the Petitioner has not placed anything on record to establish that the IPAB erroneously recorded allowance of the appeal on August 10, 2020 and reserving of the order for pronouncing reasons on August 21, 2020, the statement in the judgment of the IPAB dated August 21, 2020 must be accepted.

On Law

On law, the contention of the Petitioner was that any person has a right to oppose a patent application after it has been published but not granted and that a patent is not granted until it is sealed as per Section 43. In light of the same, the IPAB could not have directed the Patent Office to grant the patent even when they were notified of the filing of the pre-grant opposition.

The Bombay High Court ruled as follows:

On the stage at which pre-grant opposition can be filed:

The Court held that Section 25(1) read with Rule 55 direct that the applications seeking patent and pre-grant opposition have to be decided simultaneously and there is no separate hearing on the pre-grant opposition. Therefore, the right to file a pre-grant opposition u/s 25(1) commences with the publication of the application and continues till the matter is decided by the Controller but no further.

Before the amendment of 2005, a pre-grant opposition could only be filed by a person interested. The amendment of 2005 extended this right to any person in order to bring transparency in the proceedings before the Controller. Pre-grant oppositions assist the Controller in deciding the patent application and once the Controller decides the application, the scheme ends as far as the pre-grant opposition is concerned.

The Patents Act does not postulate following the same procedure before the Appellate Board. Appeal is not a continuation of the proceedings before the Controller which are not akin to a civil suit between Plaintiff and Defendant. When the Petitioner filed their pre-grant opposition, there was no application pending before the Controller in view of which the pre-grant opposition could not have

been entertained.

On the Petitioner's contention that the patent is granted when it is sealed and since the patent had not been sealed in accordance with Section 43, the pre-grant opposition was maintainable, the Court held that:

The order of the IPAB allowing the appeal and directing the Controller to grant a patent was binding on the Controller and the Controller was duty bound to enforce the order of the IPAB by virtue of Section 117D(2) of the Patents Act.

After the Controller has rejected a patent application but the IPAB allows said application in an appeal and directs the Controller to grant a patent, the matter moves beyond the first part of Section 43 and the patent stands granted. Only the ministerial acts of sealing of patent and entry in the register of patents remain which the Controller is duty bound to perform.

If after the order of the IPAB, the Controller accepts a pre-grant opposition, it may give rise to endless oppositions and such an interpretation will violate the scheme of the Act.

On conduct of the Petitioner

The Court noted that the locus standi u/s 25(1) is not to create individual rights as such but to provide access to any person to assist the Controller in taking the correct decision.

Taking note that the Petitioner did not produce anything to support his credentials in invoking the writ jurisdiction of the Court and produced no statement on oath inspite of the Court questioning his credentials, and further that the Petitioner had filed several pre-grant oppositions, wherein he had raised detailed scientific grounds, the Court questioned how the Petitioner had intricate knowledge of the field of pharmaceuticals when he was in fact engaged in the diamond business. The Court thus expressed their doubt about the credentials of the Petitioner and found merit in Pfizer's argument that he was in fact 'a habitual frontman put up by those who intend to only delay the grant of patents'.

The conduct of the Petitioner in challenging what transpired in the hearing before the IPAB on August 10, 2020 could mean two things-

One, that the Petitioner was not present during the hearing and if so, he cannot question the reference in the judgment of August 21, 2020; or

Two, if the Petitioner was present during the hearing then he was keeping watch on the matter and the moment a decision in favour of the application was declared, the Petitioner rushed to file a pre-grant opposition.

The Court found either scenario to reflect poorly on the Petitioner and concluded that the conduct of the Petitioner was an abuse of the process of law.

In conclusion, the Court found the Petitioner's pre-grant opposition not maintainable in law and

imposed a fine of INR 25,000 in view of the conduct of the Petitioner and to convey the message that the right to oppose under section 25(1) must not be abused.

RELATED INDUSTRIES[DIGITAL PERSONAL DATA PROTECTION](#)[ARTIFICIAL INTELLIGENCE](#)