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

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The Bombay High Court recently dismissed a writ petition challenging the order of the IPAB turning down the Petitioner's pre-grant opposition filed after acceptance of an appeal against order of the Controller refusing a patent application. 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

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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.



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