

THE INTELLECTUAL
PROPERTY
REVIEW

TENTH EDITION

Editor
Dominick A Conde

THE LAWREVIEWS

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For further information please contact Nick.Barette@thelawreviews.co.uk

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PREFACE

The coronavirus pandemic has impacted all aspects of life over the past year, requiring governments, businesses and individuals to adapt. The world's interconnectedness and reliance on international trade remained clear – and were even magnified – in the face of the border restrictions and shutdowns imposed in response to the global health crisis. Meanwhile, some developments that had been in progress for years continued, including the United Kingdom's exit from the European Union and Phase 1 of the United States–China trade agreement. Against this backdrop, intellectual property practitioners must navigate a variety of legal systems and intellectual property laws in which many differences remain, despite some movements toward harmonisation.

The coming years will bring further questions. Will the change of leadership in the United States result in new international policies, including policies on trade relations with China, where intellectual property protection has been a contentious issue? German ratification of the Unified Patent Court Agreement remains elusive, delayed by further constitutional challenges. And time will tell how adjustments made in response to the pandemic will change how law firms operate going forward.

To aid practitioners in the ever-changing environment of global intellectual property, we now present the tenth edition of *The Intellectual Property Review*. In this edition, we present 18 chapters that provide an overview of the forms of intellectual property coverage available in each particular jurisdiction, along with an update of its most recent developments. Each chapter is written and assembled by leading practitioners in that jurisdiction. While all involved have striven to make this review both accurate and comprehensive, it is necessarily a summary and overview, and we strongly recommend that the reader seek the advice of experienced advisers for any specific intellectual property matter. Contact information for the authors of each chapter is provided at the end of this review.

Dominick A Conde

Venable LLP

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INDIA

Pravin Anand, Shrawan Chopra and Vibhav Mithal¹

I FORMS OF INTELLECTUAL PROPERTY PROTECTION

Intellectual property protection in India includes patents, industrial design, copyright, trademark, geographical indications, plant varieties, trade secrets and confidential information. Intellectual property law is largely codified, except for trade secrets and confidential information, which are governed by common law principles and the law of contract. As India is a common law country, interpretation of the statutes by the courts is important and reference to judicial precedents is indispensable for a complete understanding of the law.

The key statutes on intellectual property in India are:

- a* the Patents Act 1970;
- b* the Trade Marks Act 1999;
- c* the Copyright Act 1957;
- d* the Designs Act 2000;
- e* the Geographical Indication of Goods (Registration and Protection) Act 1999;
- f* the Semiconductor Integrated Circuits Layout-Design Act 2000; and
- g* the Protection of Plant Varieties and Farmers' Rights Act 2001.

Intellectual property rights in India are broadly classified into the following categories.

i Patents

A patent is an exclusive right granted to the patentee of an invention that is a novel product or process that involves an inventive step and is capable of industrial application.²

The term of a patent is 20 years starting from the date of the patent application.³ After the term of the patent expires, the invention becomes part of the public domain and the patentee ceases to have exclusive rights over the subject matter of the patent.

1 Pravin Anand is the managing partner, Shrawan Chopra is a partner and Vibhav Mithal is a managing associate at Anand and Anand.

2 Section 2(1)(j) of the Patents Act 1970. The definition of 'invention', as stated in Section 2(1)(j) is in accordance with Article 27(1) of Agreement of Trade Related Aspects of Intellectual Property Rights (TRIPS).

3 Section 53 of the Patents Act 1970. The term of the patent is in accordance with Article 33 of TRIPS.

ii Registered designs

An industrial design⁴ may be protected in respect of specific classes of articles under the Designs Act 2000 if it is granted registration by the Controller General of Patents, Design and Trade Marks.

A design may be granted registration upon an application from a person claiming to be the proprietor⁵ of any new or original design that has not been previously published in any country.⁶ Upon being granted a registration, the registered proprietor of the design has a 'copyright in the design', which subsists for 10 years. The term of the copyright in a design may be extended by five years upon payment of a prescribed fee by the registered proprietor.⁷

iii Layout-designs of integrated circuits

The Semiconductor and Integrated Circuits Layout-Design Act 2000 provides statutory protection to semiconductor integrated circuits layouts⁸ for 10 years upon registration under the Act. The Semiconductor and Integrated Circuits Layout-Design Act 2000 was enacted to give effect to Section 6 of Part II of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). A layout-design may be registered if it is original, distinctive and distinguishable from other registered layout-designs. It must also not have been commercially exploited in India or other convention countries.⁹

The registered proprietor of a layout-design has the exclusive right to use the layout-design for a term of 10 years from the date of the application for registration or from the year of its first commercial exploitation anywhere in the world, whichever is earlier.¹⁰

4 Under Section 2(d) of the Designs Act 2000, 'design' means 'only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two-dimensional or three-dimensional forms or in both, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything that is in substance a mere mechanical device, and does not include any trademark as defined in clause (v) of subsection (1) of Section 2 of the Trade and Merchandise Marks Act 1958 or property mark as defined in Section 479 of the Indian Penal Code 1860 or any artistic work as defined in clause (c) of Section 2 of the Copyright Act 1957'.

5 Section 2(j) of the Designs Act 2000, defines 'proprietor of a new or original design' as '(i) where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed; (ii) where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and (iii) in any other case, means the author of the design; and where the property in or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.'

6 Section 5 of the Designs Act 2000. The requirement of 'new' or original for a design is in accordance with Article 25(1) of TRIPS.

7 Section 11 of the Designs Act 2000.

8 Section 2(d) of the Semiconductor Integrated Circuits Layout-Design Act 2000 defines 'Semiconductor integrated circuit' as a 'product having transistors and other circuitry elements which are inseparably formed on a semiconductor material or an insulating material or inside the semiconductor material and designed to perform an electronic circuitry function'. Further, Section 2(h) defines 'layout-design' as a 'layout of transistors, and other circuitry elements and includes lead wires connecting such elements and expressed in any manner in a semiconductor integrated circuit'.

9 Section 7 of the Semiconductor Integrated Circuits Layout-Design Act 2000.

10 Section 15 of the Semiconductor Integrated Circuits Layout-Design Act 2000.

iv Copyright and related rights

The Copyright Act 1957 provides for the protection of exclusive rights in the reproduction and exploitation of original literary,¹¹ dramatic,¹² musical¹³ and artistic works;¹⁴ cinematograph films;¹⁵ and sound recordings.^{16,17} The nature of a copyright varies with the nature of the different works that are protected by it.

A copyright subsists in a work from its very creation. Copyright registration is not a prerequisite to enjoying copyright protection in India, but it serves as prima facie proof of ownership of copyright before a court.¹⁸

The copyright in a work typically subsists during the lifetime of its author and for 60 years after the year of the author's death, but there are variations to this rule in different classes of copyrights: for example, the term of a copyright in cinematograph films and sound recordings is 60 years from the year of publication.¹⁹

The Copyright Act also provides for the protection of broadcast reproduction rights,²⁰ performer's rights,²¹ author's special rights (i.e., the moral rights of an author)²² and performer's moral rights.

India is a member of the Berne Convention of 1886 (as modified in Paris in 1971), the Universal Copyright Convention of 1951 and TRIPS. Although India is not a member of the Rome Convention of 1961, the Copyright Act is compliant with its provisions.

11 Under Section 2(o) of the Copyright Act 1957, 'literary work' 'includes computer programs, tables and compilations including computer [databases]'.

12 Under Section 2(h) of the Copyright Act 1957, 'dramatic work', 'includes any piece for recitation, choreographic work or entertainment in dumb show, the scenic arrangement or acting, form of which is fixed in writing or otherwise but does not include a cinematographic film'.

13 Under Section 2(p) of the Copyright Act 1957, 'musical work' means 'a work consisting of music and includes any graphical notation of such work but does not include any words or any action intended to be sung, spoken or performed with the music'.

14 Under Section 2(c) of the Copyright Act 1957, 'artistic work' 'means (i) a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality; (ii) a work of architecture; and any other work of artistic craftsmanship'.

15 Under Section 2(f) of the Copyright Act 1957, 'cinematograph film' means any work of visual recording on any medium produced through a process from which a moving image may be produced by any means and includes a sound recording accompanying such visual recording and 'cinematograph' shall be construed as including any work produced by any process analogous to cinematography including video films.

16 Under Section 2(xx) of the Copyright Act 1957, 'sound recording' means a recording of sounds from which such sounds may be produced regardless of the medium on which such recording is made or the method by which the sounds are produced.

17 Section 14 of the Copyright Act 1957 outlines the various exclusive rights that are conferred upon works that are covered by the Copyright Act 1957.

18 Section 48 of the Copyright Act 1957.

19 Chapter V of the Copyright Act 1957, namely Sections 22 to 29, provides for the term of copyright for different types of work.

20 Section 37 of the Copyright Act 1957.

21 Section 38 of the Copyright Act 1957.

22 Section 57 of the Copyright Act 1957.

v Trademarks

A trademark is defined in the Trade Marks Act 1999 as a visual representation, or mark, that helps the consumer identify the source or provider of any goods or services. It can be represented graphically and is capable of distinguishing the goods and services of one person from those of others and may include the shape of goods, their packaging and combination of colours, among other things.²³ A mark may be a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of a good, packaging or combination of colours or any combination thereof.²⁴

Registration of a trademark confers upon the registered proprietor the right to exclusively use the trademark in connection with goods and services in respect of which it is registered, and entitles the registered proprietor to seek relief in respect of infringement.²⁵ No person is entitled to institute any proceeding to prevent, or to recover damages for infringement of unregistered trademarks, but an action against a person for passing off goods or services as the goods or services of another would still lie.²⁶

Registration of a trademark is valid for 10 years and may be renewed thereafter from time to time upon payment of a renewal fee prescribed under the Trade Marks Act 1999.²⁷

The Trademarks Rules 2017 came into effect on 6 March 2017 introducing amendments that impacted trademark filing and prosecution. Notable amendments include:

- a* the number of forms reduced from 74 to eight;
- b* applicants are classified into four categories (i.e., individual, start-up, small enterprise²⁸ and others);
- c* a procedure to apply for having a mark declared as well known has been introduced;²⁹
- d* the official fee has increased, with special relief to individual, small enterprise and start-up entities;³⁰ and

23 Section 2(1)(zb) of the Trade Marks Act 1999.

24 Section 2(1)(m) of the Trade Marks Act 1999.

25 Section 28 of the Trade Marks Act 1999.

26 Section 27 of the Trade Marks Act 1999.

27 Section 25 of the Trade Marks Act 1999.

28 The definition for 'small enterprise' and 'start-up' has been given under the Rules 2(1)(v) and 2(1)(x). For identifying an entity as a 'small enterprise' and 'start-up', certain criteria have been given:

Rule 2(1)(v) 'Small enterprise means: (i) in case of an enterprise engaged in the manufacture or production of goods, an enterprise where the investment in plant and machinery does not exceed the limit specified for a medium enterprise under clause (a) of sub-section (1) of section 7 of the Micro, Small and Medium Enterprises Development Act 2006 (27 of 2006); and (ii) In case of an enterprise engaged in providing or rendering of services, an enterprise where the investment in equipment is not more than the limit specified for a medium enterprise under clause (b) of sub-section (1) of section 7 of the Micro, Small and Medium Enterprises Development Act 2006. Rule 2(1)(x) 'Start-up means: (i) an entity in India recognised as a start-up by the competent authority under Startup India initiative, (ii) In case of a foreign entity, an entity fulfilling the criteria for turnover and period of incorporation/registration as per Startup India Initiative and submitting declaration to that effect.'

29 Rule 124 of the Trade Marks Rules 2017 states that any person may file a request for determination of a trademark as a well-known mark along with an official fee and must be accompanied by a statement of case as well as all evidence and documents relied on by the applicant in his claim.

30 Such relief has been given only at the stage of filing an application. These entities would pay 50 per cent less government fee compared to the fee that was applicable prior to the amendment.

e a requirement for an MP3 format and graphical representation of the notations of a sound mark has been introduced.³¹

vi Geographical indications

Geographical indications are protected under the Geographical Indication of Goods (Registration and Protection) Act 1999. Under this Act, any association of persons or producers or any organisation or authority that represents the interests of producers of certain goods³² may apply for registration of geographical indication in relation to the goods.³³ A geographical indication is an indication that identifies goods as originating, or being manufactured, from a particular geographical region or territory where a given quality, reputation or other characteristic of those goods is attributed to its geographical origin.³⁴

The registration of a geographical indication is valid for 10 years and may be renewed from time to time by way of an application by the registered proprietor.³⁵ Registration of authorised users is also renewed in the same manner.³⁶ Only authorised users are entitled to exclusive use of a geographical indication.

A valid geographical indication entitles the registered proprietor and the authorised users to obtain relief in respect of infringement of the geographical indication.³⁷

The Geographical Indications Registry is located in Chennai and since its establishment, the registry has granted registrations to 361 geographical indications.³⁸

vii Confidential information and trade secrets

Indian law on trade secrets and business information has not been codified under statute. Trade secrets are protected in India through contract law and the equitable doctrine of breach of confidence. In cases where confidential information and trade secrets are not protected by a contract, the person seeking to enforce the confidentiality or secrecy of information can do so only if certain conditions are fulfilled:

a the information must be confidential;

31 Rule 26 (5) reads 'Where an application for the registration of a trademark consists of a sound as a trademark, the reproduction of the same shall be submitted in the MP3 format not exceeding 30 seconds' length recorded on a medium which allows for easy and clearly audible replaying accompanied with a graphical representation of its notations.'

32 Under Section 2(f) of the Geographical Indication of Goods (Registration and Protection) Act 1999, 'goods' means any agricultural, natural or manufactured goods or any goods of handicraft or of industry and includes food stuff.

33 Section 11 of the Geographical Indication of Goods (Registration and Protection) Act 1999.

34 Under Section 2(e) of the Geographical Indication of Goods (Registration and Protection) Act 1999, 'geographical indication', in relation to goods, means an indication that identifies such goods as agricultural goods, natural goods or manufactured goods as originating, or manufactured in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of such goods is essentially attributable to its geographical origin and in cases where such goods are manufactured goods one of the activities of either the production or of processing or preparation of the goods concerned takes place in such territory, region or locality, as the case may be.

35 Section 18 of the Geographical Indication of Goods (Registration and Protection) Act 1999.

36 Section 18 of the Geographical Indication of Goods (Registration and Protection) Act 1999.

37 Section 22 of the Geographical Indication of Goods (Registration and Protection) Act 1999.

38 See www.ipindia.nic.in/writereaddata/Portal/Images/pdf/GI_Application_Register_10-09-2019.pdf.

- b the information must have been disclosed in circumstances from which an obligation of secrecy arises; and
- c the confidant should attempt to use or disclose the information.

Indian courts have observed that confidential information must be protected because a confidant is under a duty of confidentiality or fiduciary duty towards a confider, which if dishonoured would lead to the confidant gaining unfair advantage over the confider who offered the information in trust.³⁹

There are no specific statutory provisions that protect trade secrets or confidential information under Indian criminal law. There are provisions under the Indian Penal Code 1860 relating to criminal breach of trust, cheating, burglary, extortion, etc. that might be applied in a case where confidential information is misused.⁴⁰ For example, it is an offence for a public servant to misuse his or her position with the intent of causing injury to any person. This provision is so broad that if a government officer is given documents containing trade secrets, it is an offence for that officer to misuse his or her position and disclose the secrets, beyond the proper discharge of his or her duty.⁴¹

Similarly, the Right to Information Act⁴² prohibits the disclosure of information including commercial confidences, trade secrets or intellectual property, the disclosure of which would harm the competitive position of a third party.⁴³ However, the exception to this rule is that the competent authority may disclose such information if the larger public interest warrants the disclosure.⁴⁴

viii Plant varieties and farmers' rights

The Protection of Plant Varieties and Farmers' Rights Act 2001 was enacted to comply with Article 27 of TRIPS. The legislation protects plant varieties by establishing the rights of farmers and breeders over the plant genetic resources that are being used to create new varieties of plants. It aims to provide for the establishment of an effective system for protection of plant varieties.

Protection under the Act does not include microorganisms.⁴⁵ To be granted registration, a plant variety must be novel, distinctive, uniform and stable.⁴⁶ An application for registration

39 *John Richard Brady v. Chemical Process Equip Pvt Ltd*, AIR 1987 Delhi 372; *Konrad Wiedemann GmbH v. Standard Castings Pvt Ltd*, [1985] (10) IPLR 243.

40 Melvin F Jager, *Trade Secrets throughout the World* (2010), Chapter 19.6.

41 Section 166 of the Indian Penal Code 1860.

42 The Right to Information Act 2005 provides every Indian citizen with the right to secure access to information under the control of public authorities, to promote transparency and accountability in the working of every public authority.

43 Section 8(1) of the Right to Information Act 2005.

44 Section 8(2) of the Right to Information Act 2005.

45 Section 2(za) defines 'variety' as 'a plant grouping except microorganism within a single botanical taxon of the lowest known rank, which can be (i) defined by the expression of the characteristics resulting from a given genotype of that plant grouping; (ii) distinguished from any other plant grouping by expression of at least one of the said characteristics; and (iii) considered as a unit with regard to its suitability for being propagated, which remains unchanged after such propagation, and includes propagating material of such variety, extant variety, transgenic variety, farmers' variety and essentially derived variety'.

46 Section 15 of the Protection of Plant Varieties and Farmers' Rights Act 2001.

under this legislation can be made to the Plant Varieties Registry.⁴⁷ The registrar will then advertise the application for oppositions and give both parties a hearing before deciding on the application.⁴⁸

The aggregate term of protection in the case of a variety of trees or a variety of vines is 18 years,⁴⁹ 15 years from the date of notification of the variety in the case of extant varieties⁵⁰ and in all other cases it is 15 years from the date of registration of the variety.⁵¹

The legislation grants provisional protection to a breeder whereby the registrar shall have power to issue such directions to protect the interests of a breeder against any abusive act committed by any third party during the period between the filing of an application for registration and the decision taken by the authority on that application.⁵²

A right granted under the legislation is infringed when a non-breeder or a person who is not an agent or licensee of a registered variety, sells, exports, imports or produces such variety without authorisation.⁵³ Infringement also occurs when any person uses, sells, exports, imports or produces another variety under a name identical or deceptively similar to a registered name so as to cause confusion among the public.⁵⁴

II RECENT DEVELOPMENTS

Decisions

*AstraZeneca AB & Anr. v. Emcure Pharmaceuticals Limited*⁵⁵

On 15 January 2020, the Delhi High Court adjudicated upon interim injunction applications in two suits filed by AstraZeneca against Emcure Pharmaceuticals Limited and MSN Laboratories Limited respectively. AstraZeneca had asserted three types of patents in the law suits: a species patent (IN'209907), a crystalline patent (IN'247984) and a formulation patent (IN'272674). The arguments for interim injunction were limited to AstraZeneca's claim on the species patent (i.e., IN'907) and no arguments were addressed on the crystalline patent or the formulation patent.⁵⁶

The defendants' primary argument was that the species patent IN'209907 stood anticipated by the genus patent IN'241229, which was in the form of a Markush Claim/Formula – specifically, that the claim of the plaintiffs under the species patent IN'907 was covered under claims 1 and 4 of the genus patent IN'229. Further, the defendants raised an argument that Section 3(d) of the Patents Act 1970 applied in the case as the plaintiffs had failed to show enhancement of efficacy of IN'907 over IN'229.

47 Sections 12, 14 and 16 of the Protection of Plant Varieties and Farmers' Rights Act 2001.

48 Section 21 of the Protection of Plant Varieties and Farmers' Rights Act 2001.

49 Section 24(6)(i) of the Protection of Plant Varieties and Farmers' Rights Act 2001.

50 Section 24(6)(ii) of the Protection of Plant Varieties and Farmers' Rights Act 2001.

51 Section 24(6)(iii) of the Protection of Plant Varieties and Farmers' Rights Act 2001.

52 Section 24(5), Protection of Plant Varieties and Farmers' Rights Act 2001.

53 Section 64(a) of the Protection of Plant Varieties and Farmers' Rights Act 2001.

54 Section 64 (b) of the Protection of Plant Varieties and Farmers' Rights Act 2001.

55 *AstraZeneca AB & Anr v. Emcure Pharmaceuticals Limited*, CS(COMM) 561 of 2019 and *AstraZeneca AB & Anr v. MSN Laboratories Limited*, CS(COMM) 562 of 2019, Delhi High Court, joint decision dated 15 January 2020.

56 id at Paragraph 6 read with Paragraph 39.

Rejecting each of the defendants' contention, the Hon'ble Court held that the species patent IN'907 was not anticipated by the genus patent IN'229; that the pleadings on record showed that the species patent IN'907 had enhanced efficacy over IN'229 and that while the invention claimed in IN'907 (i.e., the compound Ticagrelor) was covered within the Markush Claim/Structure of the genus patent IN'229, IN'229 did not specifically disclose Ticagrelor. The specific findings in this regard were as follows:

- a on Section 3(d), the Hon'ble Court held that in view of the plaintiffs' specific pleadings stating the compound Ticagrelor claimed by IN'907 was of high potency, high metabolic stability and demonstrated bioavailability, it could not be said that IN'907 did not result in an invention with enhanced efficacy;⁵⁷
- b explaining the law of anticipation by previous publication under Section 13 of the Patents Act, the Hon'ble Court held that an inquiry ought to be focused on whether on the date of filing of the patent applicant's complete specification, there is a prior art published in India or elsewhere. Applying that to the present case, the Hon'ble Court held that the date of priority of IN'907 was 4 December 1998, whereas the date of publication of IN'229 was later on 4 February 1999. In view of this, the Hon'ble Court held that it could not be said that IN'907 was anticipated by IN'229;⁵⁸ and
- c the Hon'ble Court held that while Ticagrelor was covered under the Markush structure of IN'229, it was not disclosed in claim 8 of IN'229 nor disclosed in any of the claims of IN'229.⁵⁹ The Hon'ble Court also stated that teachings did not suggest that a stable, active and less toxic compound, akin to Ticagrelor, would be formulated using the individual permutation and combinations disclosed in IN'229.⁶⁰ Accordingly, the Hon'ble Court held that the compound Ticagrelor was produced and marketed under IN'907 even though its formula is covered under the Markush formula (i.e., IN'229).

Novartis AG v. The Controller General of Patents, Designs and Trademarks & Ors⁶¹

Novartis' patent IN'276026 was revoked in a post-grant opposition and an appeal was filed before the Intellectual Property Appellate Board (IPAB). Setting aside the post-grant opposition order and restoring the patent back on the register, this decision of the IPAB is relevant for the following aspects.

First, the Hon'ble Tribunal held that as the opponent had not paid the requisite fee as of the date of filing the post-grant opposition, the Learned Controller should not have taken the post-grant opposition on record.⁶² Highlighting the importance of adjudicating on substantive issues, rather than focusing on procedural aspects, it is pertinent to note that despite this lacuna the Hon'ble Tribunal proceeded to adjudicate on the appeal on merits.

Second, the Hon'ble Tribunal examined the *Novartis* decision of the Hon'ble Supreme Court from the aspect of coverage and disclosure, and held that if an attack on coverage

57 *Supra* note 55 at Paragraph 25.

58 *id* at Paragraph 28.

59 *id* at Paragraph 29.

60 *id* at Paragraph 32.

61 OA/20/2019/PT/DEL, decision dated 29 September 2020 passed by the Hon'ble Intellectual Property Appellate Board.

62 *id* at Paragraph 12.5.

versus disclosure was made, then logically, this argument would not apply to a subsequent patent that describes and claims a specific subject matter as that would be contrary to what the Supreme Court had held.⁶³

Third, a generic disclosure cannot defeat the novelty of a specific claim.⁶⁴ Simply put, if there is a generic disclosure of an invention in a document then that document cannot be used to invalidate a specific claim for the purposes of novelty.

Fourth, the Hon'ble Tribunal held that patent term extension documents cannot be used to determine the novelty of a subsequent patent.⁶⁵

Finally, the Hon'ble Tribunal held that if a particular aspect was covered in a document but not disclosed in that document then the said document could not be considered for an invalidity analysis.⁶⁶

FMC Corporation & Anr v. Natco Pharma Limited⁶⁷

The Hon'ble Delhi High Court in the *FMC* case adjudicated upon certain aspects of Intellectual Property law disputes. It is pertinent to note that IPR disputes have been recognised as 'commercial disputes' by the Commercial Courts Act and this Act modified Indian procedural law in so far as it applies to IPR disputes. On this point, the Hon'ble Court held that while the Commercial Courts Act charted a different regime for commercial disputes and that such disputes required a greater degree of circumspection, but when it came to amending pleadings (documents such as the complaint) the Commercial Courts Act did not change the earlier practice. The Hon'ble Court held that the legislature in its wisdom did not deem it fit to adopt a different regime to amend pleadings for commercial disputes, and for that reason the older regime and principles of amendment continue to apply.⁶⁸

Further, rejecting the defendants' contention, the Hon'ble Court also held that the concept of *forum non conveniens* was not applicable to civil suits.⁶⁹ This finding was premised on the concept that a plaintiff of a file lawsuit is the *dominus litus*, implying that it has the choice to choose its forum. In view of the same, the Hon'ble Court held that despite a proceeding that was instituted by the defendants for declaration of non-infringement prior to the institution of the suit for patent infringement, the suit for patent infringement would continue.

Dhaval Diyora v. Union of India & Ors⁷⁰

Addressing the issue of pre-grant oppositions holding up the grant of patents, the Bombay High Court in a seminal decision clarified the purpose of a pre-grant opposition procedure provided for in Section 25(1) of the Patents Act 1970. The petitioner had filed a pre-grant opposition before the Patent Office and as it had been rejected approached the Bombay High

63 id at Paragraph 19.4.

64 id at Paragraph 20.6.

65 id at Paragraph 21.21.

66 id at Paragraph 19.8.

67 CS(COMM) 611 of 2019, decision dated 15 July 2020 of the Delhi High Court.

68 id at Paragraphs 18 and 19.

69 id at Paragraph 43.

70 WP(L) No. 3718 of 2020 before the Bombay High Court, decision dated 5 November 2020.

Court challenging the decision. Acknowledging the overall background and facts of the case, along with examination of the pre-grant procedure in the Patents Act, the Bombay High Court gave the following key findings.

First, the Bombay High Court clarified that overall the purpose of a pre-grant opposition was to assist the Learned Controller.

Second, and most importantly, the Hon'ble Court clarified the *locus standi* of filing a pre-grant opposition. Emphasising that the overall process of a pre-grant opposition is to assist the Learned Controller, the Hon'ble Court held that the right to file a pre-grant opposition is not an individual right. It is a right provided to 'any person' who seeks to assist the Controller of Patents in reaching a decision about a patent. Such a valuable right granted by the legislature is not to be abused.⁷¹

Finally, acknowledging the practice of filing *benami*⁷² oppositions in order to throttle legitimate competition, the Hon'ble Court expressed disapproval of this practice and accordingly proceeded to impose costs on the petitioner.⁷³ A factor that played a part in this finding was that the Hon'ble Court was not persuaded by the credentials of the petitioner to file the pre-grant opposition, indicating that the Hon'ble Court was of the view that the person who files a pre-grant opposition must have some credibility to file the same.⁷⁴

Pharmacyclics LLC v. Controller General of Patents, Designs, Trademark and Geographical Indications & Ors⁷⁵

In another very important decision rendered by the IPAB in 2020, and dealing with the aspect of post-grant oppositions, the IPAB clarified the process significantly, which would aid in future cases. Pharmacyclics' patent had been revoked in the post-grant opposition proceeding and therefore Pharmacyclics approached the IPAB. The Hon'ble Tribunal set aside the order of the Controller of Patents and restored the patent to the register. From a jurisprudence perspective, the decision is important for the following factors.

First, adjudicating upon the aspect of evidence that is filed in the post-grant opposition proceedings, the Hon'ble Tribunal specifically held that whatever evidence is to be filed by either party in a post-grant opposition, the same must be filed prior to the date when the Controller has fixed a hearing. Accordingly, after a date of hearing has been fixed, no evidence by either party is admissible as per the provisions of the Patents Act and the Rules made thereunder.⁷⁶

Second, clarifying the importance of the role of an Opposition Board in a post-grant opposition process, the Hon'ble Tribunal held that it was mandatory for the Controller of Patents to take the recommendation of the Opposition Board into consideration, and if the Controller disagreed with the views, then the reasoning should be provided in writing.

71 id at Paragraph 33.

72 For the definition of *benami*, see Section 1(9) of the Benami Transaction (Prohibition) Amendment Act 2016, which states that "[a] transaction or an arrangement where a property is transferred to or is held by a person, the consideration of such property has been provided, or paid by another person' is a *benami* transaction. Put another way, a *benami* opposition is one where it is difficult to identify who is the actual opponent of the patent. The person who has filed the opposition is only to support the activities of this unidentified person.

73 *Supra* note 134 at Paragraph 37.

74 id at Paragraph 36.

75 OA/46/2020/PT/DEL, decision dated 29 September 2020 before the IPAB.

76 id at Paragraph 9.7.

The Hon'ble Tribunal further held that with the recommendation of an Opposition Board, the Controller is in a better position to decide a post-grant opposition even though the recommendations are not binding on the Controller. Contextualising this finding in the larger context, the Hon'ble Tribunal held that if this process was not being followed, then the whole process of having an Opposition Board is likely to lose its meaning.⁷⁷

Allani Ferid v. Assistant Controller of Patents & Designs⁷⁸

The IPAB, in a path-breaking development for Indian patent law jurisprudence, interpreted Section 3(k) of the Patents Act, a patent eligibility provision that bars 'computer programs per se' from being granted patents, and granted a patent to Mr Allani holding that his invention was not barred by Section 3(k) of the Patents Act.

Mr Allani had filed a patent application for 'Method and Device for Accessing Information Sources and Services on the Web'. The patent application was filed on 29 December 2000 and claimed priority from 30 December 1999.⁷⁹ An appeal was filed before the IPAB against the order of February 2020 passed by the Controller of Patents.

Mr Allani's invention related to a mechanism to carry out searches on the internet. The invention refined a particular search query first locally on a device and when the search query was well construed and defined, then that refined search query was emitted to the internet. Analysing the invention, the Hon'ble Tribunal held that the invention related to a mechanism of carrying out a search. Moreover, by delaying emitting the final request to the internet through local implementation of preliminary selection steps that formed a well-construed query, the Hon'ble Tribunal held that the invention gained a technical effect.⁸⁰ The Hon'ble Tribunal also held that the technical problem thus solved by the invention was a critical addition to the functionality of the internet in 1999.⁸¹

The Hon'ble Tribunal further affirmed that to determine patent eligibility under Section 3(k), the focus has to be on determining the technical effect, and the fact that a computer program is used as a part of the invention did not provide a bar to patentability. The invention had to be examined as a whole with respect to its technical contribution and the technical effect achieved by it. Elucidating further on the aspect of technical effect, the Hon'ble Tribunal held that the Computer Related Inventions Guidelines 2013 issued by the Patent Office provided coherent guidance in terms of the indicators of 'technical effect'.⁸² Applying those indicators, the Hon'ble Tribunal held that Mr Allani's invention met indicators such as higher speed, more economic use of memory and a more efficient data base strategy. Accordingly, possessing technical effect, a patent was granted.⁸³

77 id at Paragraph 9.12.

78 OA/17/2020/PT/DEL, decision dated 20 July 2020 before the IPAB.

79 A patent was denied by the Patent Office to the said application in 2008 and thereafter by the IPAB in 2013. Thereafter, the decision was challenged by Mr Allani before the Hon'ble Delhi High Court, arguing that the rejection of the patent by the IPAB in 2013 was incorrect, and accordingly the 2013 decision was set aside by the Hon'ble Delhi High Court on 12 December 2020 and the matter was sent back once again to the Patent Office. The Patent Office issued yet another rejection in February 2020. The February 2020 decision of the patent office was challenged by Mr Allani before the IPAB in May 2020.

80 *Supra* note 145 at Paragraph 24.

81 id at paragraph 29.

82 id at paragraph 31.

83 id at paragraph 33 and 34.

Interdigital Technology Corporation & Ors v. Xiaomi Corporation & Ors⁸⁴

In the first order of its kind, the Hon'ble Delhi High Court granted ad interim relief to a plaintiff in a patent infringement suit by staying the enforcement of an order passed by a court of foreign jurisdiction. The plaintiffs before the Delhi High Court had moved an application seeking to restrain the defendants from enforcing an order that had been passed by the Wuhan Intermediate People's Court dated 23 September 2020.⁸⁵ The Wuhan Intermediate People's Court had passed an anti-suit injunction order restraining the plaintiffs before the Delhi High Court from instituting and enforcing a suit for infringement before any fora.

The Hon'ble Delhi Court held that if any decision passed by any fora, such as the Wuhan Court, resulted in substantial injustice to the right of an Indian citizen, in India, to the extent a defendant in a lawsuit seeks to restrain the plaintiff of a lawsuit, then the courts can interfere. In the above case, the court interfered by not permitting the defendant, Xiaomi, from enforcing the anti-suit injunction that was granted by the Wuhan Court against the plaintiff, Interdigital, and thus allowed the plaintiff to continue its case filed before the Delhi High Court.⁸⁶

The Hon'ble Court further clarified that the order passed by it was a relief provided to the plaintiffs in order to restrain the enforcement of the anti-suit injunction passed by the Wuhan Court and accordingly indicated that the exact terminology used to describe the Hon'ble Court's order was irrelevant.⁸⁷ The court's observations were premised on the fact that a party who is entitled to file a proceeding before an Indian court was also entitled to prosecute the said proceeding.⁸⁸

The Hon'ble Court also agreed with Interdigital's contentions that the present suit did not interfere with the proceedings of the Wuhan Court,⁸⁹ and thereafter held that the principle of comity of courts was not being violated, as the principle had no application where any order of the foreign court violated public policy in India,⁹⁰ breached customary international law or resulted in manifest injustice.⁹¹

Conversely, the Hon'ble Court held that the Wuhan Court's order to restrain Interdigital from filing lawsuits before any courts in China or any other countries and regions, and compel the plaintiff to suspend or withdraw already initiated legal proceedings, would, prima facie, not be permissible.⁹² In fact, the Hon'ble Court stated that it was not open to any court to pass an order, prohibiting a court in another country to exercise jurisdiction lawfully vested in it,⁹³ and the pendency of proceedings before foreign jurisdictions would not inhibit the Hon'ble Court to pass the present order.⁹⁴

84 Decision dated 9th October 2020, in I.A. 8772/2020 of CS (COMM) 295/2020.

85 id at Paragraph 2.

86 id at Paragraph 41 read with 43.

87 id at Paragraph 51.

88 id at Paragraph 44.

89 id at Paragraph 60(iii).

90 id at Paragraph 75.

91 id at Paragraph 66.5.

92 id at Paragraph 60(v).

93 id at Paragraph 76.

94 id at Paragraph 64.

III OBTAINING PROTECTION

i Patents

An invention may be granted a patent under the Patents Act 1970 when the three necessary conditions are fulfilled: it should be novel, involve an inventive step, and be capable of industrial application.⁹⁵ The determination of whether these tests are satisfied is determined by the Controller of Patents who examines each patent application.

Sections 3 and 4 of the Patents Act provides an exhaustive list of inventions that do not qualify as eligible subject matter for patent protection in India. If an invention falls within the ambit of these sections, no patent shall be granted, even if these inventions were to satisfy the criteria of novelty, inventive step and industrial application. The Delhi High Court has held that for subject matter falling within the scope of Section 3, an analysis applying those three criteria under Section 2(1)(j) need not be employed.⁹⁶ For instance, inventions relating to atomic energy;⁹⁷ plants and animals in whole or part including seeds, varieties and species and essentially biological processes for the production or propagation of plants;⁹⁸ computer programs⁹⁹ per se or algorithms; and mathematical or business methods are not patentable in India.¹⁰⁰ Processes and products relating to the medical treatment of humans and animals are also not patentable in India.¹⁰¹ However, patenting new forms of already known substances is subject to the patent applicant proving an enhancement in the known efficacy of the new form of the existing substance when compared to the efficacy of the known substances.¹⁰² Hence, Swiss-style claims are not permissible under the Patents Act. In *Novartis v. Union of India* (2013), the Supreme Court held that the test of efficacy in the case of pharmaceutical substances can only be therapeutic efficacy.

The Patents Act permits both pre-grant and post-grant oppositions that are filed before the Patent Office. A pre-grant opposition can be filed by 'any person' before a patent is granted.¹⁰³ The scope of a post-grant opposition is narrower since a post-grant opposition can only be filed within one year of the grant of the patent and only by 'any person interested'.^{104, 105} The procedure governing the opposition proceedings is laid out in Chapter VI of the Patents Rules 2003. The Act vests the Controller of the Patent Office with certain powers of a civil court. A party filing a pre-grant or a post-grant opposition has the right to be heard by the Patent Office before it renders its decision. The decision of the Patent Office in post-grant

95 Section 2(1)(j) of the Patents Act defines 'invention' whereas, Section 2(1)(l), Section 2(1)(ja) and Section 2(1)(ac) define 'novelty', 'inventive step' and 'industrial application' respectively.

96 *F Hoffmann-La Roche Ltd v. Cipla Ltd*, 2015, RFA(OS) 92 of 2012 and RFA(OS) 103 of 2012. Decision dated 27 November 2015.

97 Section 4 of the Patents Act 1970.

98 Section 3(j) of the Patents Act 1970.

99 Computer programs can be protected under the Copyright Act 1957. Computer programs are protected in India irrespective of the forms in which they occur. Thus, irrespective of whether they are in object code version, source code version or hardware, they are protected. Computer databases are also protected on the basis that even 'sweat of the brow' is worth protection.

100 Section 3(k) of the Patents Act 1970.

101 Section 3(i) of the Patents Act 1970

102 Section 3(d) of the Patents Act 1970.

103 Section 25(1) of the Patents Act 1970.

104 Section 2(t) of the Patents Act defines a 'person interested' as 'a person engaged in, or in promoting, research in the same field as that to which the invention relates'.

105 Section 25(2) of the Patents Act 1970.

opposition proceedings can be appealed before the IPAB. Additionally, any 'person interested' can directly challenge the validity of a patent through a revocation petition before the IPAB under Section 64 of the Patents Act 1970. The orders of the Patent Office and the IPAB in various opposition proceedings can be accessed on the website of the Patent Office.

ii Trademarks

In trademark law, any mark, device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination of these that is used or proposed to be used in relation to any goods may be granted registration if the goods of the proprietor of the said mark are capable of being distinguished in the course of trade from those of another. The term 'mark' is broad enough to include the shape of goods, packaging or combination of colours, or any combination of the same. Additionally, the Act also allows service marks to be registered as well. The Trade Marks Act 1999 also provides for multi-class applications. The Trademark Registry has also started registering sound marks since 2008.

An application for registration of a trademark is filed at an office of the Trademark Registry, which has its main office in Mumbai with branch offices in Delhi, Kolkata, Chennai and Ahmedabad. Every application is scrutinised by the Examiner of Trademarks under the provisions of the Trade Marks Act, to ensure that Sections 9 and 11 of the Trade Marks Act are not applicable.¹⁰⁶ Thereafter, every application is advertised by the Trademark Registry before it is registered. Any person wishing to oppose the mark may do so within three months of the date of registration or within a further period not exceeding one month. The Registrar shall then grant both parties a hearing before deciding on the application.

iii Designs

An application for design is made, under the Designs Act 2000, to the Controller of Designs specifying the class in which it is sought to be registered. A design will not be registered under the Designs Act if:

- a it is not new or original;
- b it has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration;
- c it is not significantly distinguishable from known designs or combination of known designs; or
- d it comprises or contains scandalous or obscene matter.¹⁰⁷

iv Copyright

A copyright subsists in a work from its very creation. Copyright registration under the Copyright Act 1957 is not a prerequisite to enjoying copyright protection in India. However, registration of a copyright serves as prima facie proof of ownership of copyright in a court.

106 Section 9 and 11 of the Trade Marks Act 1999 relate to absolute and relative grounds for refusal of a trademark respectively. Under these provisions, a trademark could be refused registration, for instance, if it is 'devoid of distinctive character'; if it 'consists of an indication that may designate the kind, quality of a geographical origin' or consists of marks 'that have become customary in the current language or in the bona-fide and established practises of the trade.

107 Section 4 of the Designs Act 2000.

v Plant varieties

A new plant variety shall be registered under the Protection of Plant Varieties and Farmers' Rights Act if it conforms to the criteria of novelty, distinctiveness, uniformity and stability.¹⁰⁸ An extant variety shall be registered under this Act within a specified period if it conforms to such criteria of distinctiveness, uniformity and stability as shall be specified under the regulations.¹⁰⁹ Every application for registration shall:

- a* be with respect to a variety;
- b* state the denomination assigned to such variety by the applicant;
- c* be accompanied by an affidavit sworn by the applicant that such variety does not contain any gene or gene sequence involving terminator technology;
- d* be in such form as may be specified by regulations;
- e* contain a complete passport data of the parental lines from which the variety has been derived along with the geographical location in India from where the genetic material has been taken and all such information relating to the contribution, if any, of any farmer, village community, institution or organisation in breeding, evolving or developing the variety;
- f* be accompanied by a statement containing a brief description of the variety bringing out its characteristics of novelty, distinctiveness, uniformity and stability as required for registration;
- g* be accompanied by such fees as may be prescribed;
- h* contain a declaration that the genetic material or parental material acquired for breeding, evolving or developing the variety has been lawfully acquired; and
- i* be accompanied by such other particulars as may be prescribed.¹¹⁰

vi Geographical indications

Any association of persons or producers or any organisation or authority established by or under any law for the time being in force representing the interest of the producers of the concerned goods, who are desirous of registering a geographical indication in relation to such goods, can apply for registration of a geographical indication with the following:

- a* a statement as to how the geographical indication serves to designate the goods as originating from the concerned territory of the country or region or locality in the country, as the case may be, in respect of specific quality, reputation or other characteristics of which are due exclusively or essentially to the geographical, environment, with its inherent natural and human factors, and the production, processing or preparation of which takes place in such territory, region or locality, as the case may be;
- b* the class of goods to which the geographical indication shall apply;
- c* the geographical map of the territory of the country or region or locality in the country in which the goods originate or are being manufactured;
- d* the particulars regarding the appearance of the geographical indication as to whether it is comprised of the words or figurative elements or both;

108 Section 15(1) of the Protection of Plant Varieties and Farmers' Rights Act 2001.

109 Section 15(2) of the Protection of Plant Varieties and Farmers' Rights Act 2001.

110 Section 18(1) of the Protection of Plant Varieties and Farmers' Rights Act 2001.

- e a statement containing such particulars of the producers of the concerned goods, if any, proposed to be initially registered with the registration of the geographical indication as may be prescribed; and
- f such other particulars as may be prescribed.¹¹¹

IV ENFORCEMENT OF RIGHTS

i Possible venues for enforcement

The Indian judiciary is essentially a three-tier system with approximately 600 district courts hearing cases in the first instance, 24 high courts, and the Supreme Court¹¹² at the apex. The Supreme Court is the court of final appeal and sits in Delhi.¹¹³ High courts are the highest judicial bodies in a state and have superintendence over all courts and tribunals within their territorial jurisdiction.¹¹⁴

District courts generally have an unlimited pecuniary jurisdiction on the civil side. However, the Delhi, Bombay, Calcutta, Madras, Shimla, and Jammu and Kashmir. High Courts also have a first instance jurisdiction where IP disputes above a certain pecuniary level can be entertained directly by the High Court. For instance, the Delhi High Court can currently entertain fresh IP suits, as the court of first instance, if the suit value is more than US\$150,000.

High courts also exercise writ jurisdiction, invoked for the violation of fundamental rights and other legal rights of citizens and non-citizens alike. Writs are issued by courts against public bodies and writ jurisdiction can be directly invoked against decisions of various IP registries such as the Patent Office, Trademarks Registry etc., when there is a violation of principles of natural justice or other principles enshrined in the Constitution. Moreover, appeals may lie before the writ court against the final decision of the IPAB, which is the first appellate authority against the orders of the IP registries (except in copyright matters, where the first appellate body is the Copyright Board).

ii Requirements for jurisdiction and venue

Jurisdiction may depend upon the relevant territory of the court, and the pecuniary value and subject matter of the dispute. Each of these determinants are independently considered for a court to assume jurisdiction.

Under the Code of Civil Procedure, an Indian court would have jurisdiction over a matter if the alleged infringement took place or the cause of action arose within its territorial jurisdiction, or if the defendant or any of the defendants actually and voluntarily resides, carries on business, or personally works for gain, within its territorial jurisdiction.¹¹⁵ The location of the plaintiff is not a consideration. In *Sholay Media Entertainment Ltd v. Yogesh Patel*,¹¹⁶ the Division Bench of the Delhi High Court held that even an infinitesimal fraction of a cause of action will confer jurisdiction.

111 Section 11 of the Geographical Indications of Goods (Registration and Protection) Act 1999.

112 Article 124(1) of the Constitution of India 1950.

113 Article 131 of the Constitution of India 1950.

114 Article 227 of the Constitution of India 1950.

115 Section 20 of the Code of Civil Procedure 1908.

116 FAO (OS) No. 222 of 2010, order of the Delhi High Court dated 13 March 2014. In this case, the court held that the respondent was actively promoting business in New Delhi through CDs distributed along

However, in an action for infringement of a registered trademark or for infringement of copyright, the civil court within whose jurisdiction the claimant actually and voluntarily resides, or carries on business or personally works for gain, also has jurisdiction.¹¹⁷

In *Bristol-Myers Squibb Company and another v. VC Bhutada and others*,¹¹⁸ the Delhi High Court held that to determine that a defendant ‘carries on business’, the plaintiff has to prima facie show through facts enumerated in the plaint that there is an apprehension of ‘offer for sale’, which gives rise to a cause of action. The veracity of the apprehension cannot be challenged at the preliminary stage and would have to be determined at trial.

In cases where the validity of the registration of an intellectual property right is disputed, Indian courts will have jurisdiction only if the registration is granted in India. It would therefore not be possible to question the validity of a registration of an intellectual property right granted in a foreign jurisdiction before an Indian court.

However, it would be possible for a foreign entity to challenge the validity or registration of an intellectual property right granted in India. Further, even if rectification proceedings instituted by a defendant in a foreign court are pending, these will not preclude an Indian court from granting interlocutory relief in favour of the claimant in trademark matters.

Moreover, to increase the efficiency and speed of trial in IP disputes, the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act 2015 categorised IP disputes as commercial disputes and modified procedural law to expedite and manage their timeline. The Act directed the creation of commercial divisions within high courts and currently, the Delhi and Bombay High Courts have set up commercial divisions to manage IP suits.

Furthermore, to avoid multiplicity of proceedings, the Supreme Court has held that a party who has already sought revocation of a patent before the IPAB is precluded from filing a counterclaim challenging the validity of the same patent in a suit for infringement of the patent.¹¹⁹

Additionally, Section 104 of the Patents Act 1970 and Section 22(4) of the Designs Act provide that if the defendant has challenged the validity of the patent through a counterclaim and challenged the validity of a design by way of a defence¹²⁰ in a patent and design infringement suit respectively, then such suits are liable to be transferred to the High Court for adjudication.

with the December issue of *IT* magazine, which was extensively circulated in Delhi and that the CD when loaded displayed the website ‘www.sholay.com’ with prominence such that any user would click on the link to the respondent’s website and in turn could then avail themselves of various services such as e-greetings or e-chat and goods such as DVDs sold by the respondent. Further, the respondent’s website is a virtual store with the ‘essential interactive features’ that permits a visitor to order goods or services and communicate with the respondents via email.

117 Section 134(2) of the Trade Marks Act 1999 and Section 62(2) of the Copyright Act 1957.

118 Suit No. CS (OS) 2801 of 2012. Order of the Delhi High Court dated 11 October 2013.

119 *Alloys Wobben v. Yogesh Mehra and others*, SLP No. 6456 of 2012 before the Supreme Court of India.

120 Validity of a design is challenged if the defendant pleads any of the grounds enumerated in Section 19 of the Designs Act to pleading invalidation of the design.

iii Obtaining relevant evidence of infringement and discovery

Anton Piller orders

A party in a civil suit may move the court for an *Anton Piller* order if it seeks detention, preservation or inspection of any property that is the subject matter of the suit. When allowing an application of this nature, the court may authorise any person to enter the property and take samples that may be necessary for the purpose of obtaining full information or evidence.¹²¹ Thus, in a civil action for infringement, the court commissioner can be appointed *ex parte* to visit the defendant's premises, search and seize the infringing goods. These goods may either be taken into custody or left on trust with the defendants after they are sealed.

Usually, the court appoints a commissioner, who may be a lawyer or a member or employee of the court, to carry out the directions of the court in an *Anton Piller* order. Commissioners may also be appointed for a scientific investigation or for making local investigations that the court may find necessary.¹²²

A court commissioner is given wide powers while conducting an investigation, is 'an extended arm and agent of the court' and is 'effectively the eyes and ears of the court'.¹²³

John Doe orders

Great care is taken when actions are instituted against parties that run small concerns in markets where numerous parties are engaged in selling counterfeit goods or other specimens of trademark, copyright or design infringement. This is because often such parties work in tandem and in close proximity with one another and if trying to obtain the precise details and identities of one such party leads to suspicion in a market, the entire market of infringers would disappear before the action is even instituted.

Hence, Indian courts also issue orders against unidentified parties or *John Does*. This has proved extremely useful in anti-counterfeiting actions and actions against copyright and broadcast piracy. Once the defendants have been identified, the court allows the plaintiff to formally include them into the suit.

Norwich Pharmacal orders

A *Norwich Pharmacal* order may be sought from Indian courts after proceedings have commenced, seeking information or documentation from a third party that may be in a position to assist the court in the IP suit.

In *Souza Cruz SA v. NK Jain*,¹²⁴ the Delhi High Court directed the Commissioner of Customs and Excise at Hyderabad to disclose the complete details of infringing cigarettes being exported to Ukraine. This order has been followed in *Shaw Wallace v. Gemini Traders*,¹²⁵ where the customs and excise authorities were directed to disclose details of infringing whisky moving from one state to another in violation of a court order.

121 Order 39 Rule 7 of the Code of Civil Procedure 1908.

122 Order 26 of the Code of Civil Procedure 1908.

123 *Louis Vuitton Malletier v. Omi and another*, CCP(O) 10 of 2018 in CS(COMM) No. 291 of 2018. Order of the Delhi High Court dated 7 August 2018.

124 (1995) 3 IPA 28.

125 (1993) 8 IPA 31.

In *Bridgestone Corporation v. Tolins Tyres Pvt Ltd*,¹²⁶ the court directed the Public Information Officer at Land Customs Port, Bihar to produce records pertaining to the export of tires by the defendants.

Discovery

Discovery is possible only after legal proceedings have commenced. Under the provisions of Order XI Rules 1 and 2 of the Code of Civil Procedure 1908, discovery can be by interrogatories, delivered with the leave of the court, for the examination of the opposite parties. So long as interrogatories are relevant, they can be allowed.

iv Trial decision-maker

The trial decision-maker varies depending on the forum where the proceedings are pending. In the district courts, the evidence led by the parties is recorded by the presiding judge. In the High Court, however, the evidence is recorded either before a joint registrar (who is basically a junior or subordinate judge), or the parties may opt to request the court to appoint court commissioners to record evidence to expedite the process. In the latter, the High Court appoints judicial officers (local commissioners), typically retired judges, to record depositions of the witnesses of the parties. The local commissioner can then fix consecutive dates for the cross-examination of witnesses and this ensures that foreign witnesses do not have to repeatedly travel to India for depositions, and evidence can be recorded in a short span of time. Court commissioners are ‘an extended arm and agent of the Court’ and ‘effectively the eyes and ears of the Court’.¹²⁷

Section 115 of the Patents Act 1970 also provides that in any suit for infringement or other proceedings under the Act, the court may appoint an independent scientific adviser to assist the court or to inquire and report upon any such question of fact or opinion that does not involve a question of interpretation of law, as it may formulate for the purpose.

v Structure of the trial

The presentation of evidence at the trial is governed by the provisions of the Indian Evidence Act 1872. Traditionally, evidence at a trial is given orally in the form of statements of witnesses or on the basis of documents in cases where the witness producing the documents is not authorised or required to give oral evidence. Third parties such as consumers or dealers, who are desirable witnesses, are rarely willing to give evidence in a court.

Evidence is given on the issues framed by the court with the help of both parties, after the admission and denial of documents. When the issues are framed, it is indicated whether the onus of proof of a particular issue lies with the plaintiff or the defendant and preparation for the trial commences accordingly.

Expert evidence is allowed in patent and copyright infringement cases or others that involve a complex aspect of intellectual property; for example, to explain the ambit of satellite broadcasting rights.

A trial may often take years if there are numerous witnesses. Therefore, cases in which there are only two or three witnesses on either side have a better chance of early disposal.

¹²⁶ CS (COMM) No. 375 of 2016. Order of the Delhi High Court dated 16 March 2017.

¹²⁷ *Louis Vuitton Malletier v. Omi and another*, CCP(O) 10 of 2018 in CS(COMM) No. 291 of 2018. Order of the Delhi High Court dated 7 August 2018.

The statements of a witness given in a judicial proceeding or before any person authorised by law to take the same, can be used in a subsequent judicial proceeding between the same parties or their representatives or at a later stage of the same proceeding in certain circumstances.

vi Infringement

The Patents Act 1970 is silent on what qualifies as an infringement of a patent. Section 48, however, vests certain exclusive rights upon the patentee or his or her agent. Violation of the rights conferred on the patentee under the Act would therefore constitute infringement. In a patent infringement suit, the court assesses both the liability of the defendant as well as the quantum of damages. In most patent infringement cases, the defendant institutes a counterclaim challenging the validity of the suit patent, which must also be determined by the court in the same trial. In other words, Indian courts are empowered to decide issues of invalidity in infringement actions.¹²⁸ In an infringement suit, the defendant may raise the issue of validity of a patent in two ways:

- a as its defence to the plaintiff's claim of infringement;¹²⁹ or
- b by instituting a counterclaim challenging the validity of the patent.¹³⁰

Literal infringement

The first step in patent infringement assessment requires determination of the rights conferred by the patent. For this, the court engages in claim construction, namely an exercise that involves understanding the 'scope and meaning of the [patent] claims including its terms'.¹³¹ To construe a patent claim, the court first reads it as 'ordinary English sentences without incorporating into them extracts from the body of the specification or changing their meaning by reference to the language used in the body of the specification'.¹³² The Delhi High Court in the *Roche*¹³³ case relied upon *Edward H Philips v. AWH Corporation*¹³⁴ and observed that to read patent claims differently from their ordinary and general meaning would be 'unjust to the public, as well as would be an evasion of the law'.¹³⁵ The court further held that only when there is a doubt as to meaning a patent claim, could reference be made to the patent specification as the patent specification may then 'aid in solving or ascertaining the true intent and meaning of the language employed in the claims'.¹³⁶ Elaborating further, the court held that if claim terms still remain ambiguous, reference could also be made to the

128 Sections 64, 104, and 107 of the Patents Act 1970.

129 Sections 107 of the Patents Act 1970.

130 Sections 64 and 104 of the Patents Act 1970.

131 *F Hoffmann-La Roche Ltd v. Cipla Ltd*, 2015, RFA(OS) 92 of 2012 and RFA(OS) 103 of 2012. Decision dated 27 November 2015 at Paragraph 67(xiv).

132 *F Hoffmann-La Roche Ltd v. Cipla Ltd*, 2015, RFA(OS) 92 of 2012 and RFA(OS) 103 of 2012. Decision dated 27 November 2015 at Paragraph 66.

133 *F Hoffmann-La Roche Ltd v. Cipla Ltd*, 2015, RFA(OS) 92 of 2012 and RFA(OS) 103 of 2012. Decision dated 27 November 2015.

134 415 F.3d 1303.

135 *F Hoffmann-La Roche Ltd v. Cipla Ltd*, 2015, RFA(OS) 92 of 2012 and RFA(OS) 103 of 2012. Decision dated 27 November 2015 at Paragraph 66.

136 *F Hoffmann-La Roche Ltd v. Cipla Ltd*, 2015, RFA(OS) 92 of 2012 and RFA(OS) 103 of 2012. Decision dated 27 November 2015 at Paragraph 66.

prosecution history of the patent, inventor testimony, dictionaries and treatises.¹³⁷ It clarified that extrinsic evidence such as inventor testimony, dictionaries and treatises would have lesser weight as compared to intrinsic evidence such as prosecution history.¹³⁸

The infringement analysis then proceeds with a comparison of the elements of the claim and the elements of the defendant's product or process. If the defendant's product or process is covered by the claims as construed, infringement is established.

To understand whether an infringement is present in a particular case the guidelines that the court follows are:

- a read the claims first and if there is an ambiguity, then read the description and complete specification;
- b if there is still an ambiguity, then reference could be made to both intrinsic and extrinsic evidence;
- c find out what constitutes prior art;
- d find out what improvement is present in the patent claimed to be infringed, over the prior art;
- e list the broad features of the improvement (pith and marrow of the claims);
- f compare those broad features with the defendant's process or apparatus; and
- g if the defendant's process or apparatus is either identical or comes within the scope of the plaintiff's process or apparatus, there is infringement.¹³⁹

Contributory infringement

The concept of contributory infringement has not been incorporated in the statute and therefore each person or entity taking part in an act of infringement is individually liable. However, a court, if it deems fit in a particular case, may import the common law principles of vicarious liability, abetment and contributory infringement into a patent infringement dispute to impute liability to indirect or contributing infringers.

Doctrine of equivalents

Indian courts recognise the doctrine of equivalents. In an infringement suit before the Bombay High Court,¹⁴⁰ the doctrine of equivalents was discussed to settle the dispute that related to infringement of a patent for tamper-proof locks. This doctrine was also recognised by the Madras High Court in *Mariappan v. AR Safiullah and others*,¹⁴¹ in which it was held that a person is guilty of infringement if he or she makes what is, in substance, the equivalent of the patented article. The Delhi High Court, in *Raj Parkash v. Mangat Ram and others*¹⁴² held that:

[U]nessential features in an infringing article or process are of no account. If the infringing goods are made with the same object in view which is attained by the patented article, then a minor

137 id.

138 id.

139 *Farbwerke Hoechst Aktiengesellschaft v. Unichem Laboratories*, AIR 1969, Bom 255, and *Biswanath Prasad Radhey Shyam v. Hindustan Metal Indus*, AIR 1982 SC 1444.

140 *Ravi Kamal Bali v. Kala Tech and Kala Tech and Ors*, 38 PTC 435 (Bom).

141 38 PTC 341 (Mad 2008).

142 AIR 1978 Del 1.

*variation does not mean that there is no piracy. A person is guilty of infringement if he makes what is in substance the equivalent of the patented article. Some trifling or unessential variation has to be ignored.*¹⁴³

vii Defences

The defendant in a patent infringement suit can argue that the patent is invalid since it lacks novelty, is obvious or is not capable of industrial application. India also specifically bars the patentability of a new form of a known substance.

The defendant can also argue that the patentee failed to disclose corresponding applications filed in foreign jurisdictions for the same and substantially the same invention. In *Maj (Retd) Sukesh Behl and another v. Koninklijke Philips Electronics*,¹⁴⁴ the Delhi High Court has clarified that such non-disclosure must be material and intentional. The *Roche* decision has further stated that if the patentee has substantially complied with the requirement of disclosure of foreign applications, then this defence would fail.¹⁴⁵ However, the courts have usually taken a strong view against suppression of material facts. Thus, it is better to reveal too much detail than too little.

The defendant's acts are for the purposes of developing and submitting information to a regulatory body for acquiring marketing approval.

Common law defences such as laches and estoppel are also available.

While the Indian statute provides a detailed mechanism for the grant of a compulsory licence, the ability of a defendant to obtain a compulsory licence is not a defence for infringement.

viii Time to first-level decision

The time span for obtaining a decree in suit for infringement of a patent is approximately 24 to 36 months.

ix Remedies

Reliefs in a suit for infringement of patent

Section 108 of the Patents Act 1970 provides that the reliefs a court may grant in any suit for infringement include an injunction subject to such terms as the court sees fit, as well as either damages or an account of profits. In addition to this, the court may also order that goods that are found to be infringing and implements used in creating the infringing goods shall be seized, forfeited or destroyed, as the court deems fit under the circumstances of the case without payment of any compensation.

Damages and compensation

In suits for trademark infringement and patent infringement, a plaintiff is entitled to seek damages or an account of profits.¹⁴⁶

143 id. at paragraph 25.

144 (2015) 61 PTC 183 (Del).

145 *F Hoffmann-La Roche Ltd v. Cipla Ltd*, 2015, RFA(OS) 92 of 2012 and RFA(OS) 103 of 2012. Decision dated 27 November 2015 at Paragraphs 124 to 128.

146 Section 135 of the Trade Marks Act 1999 and Section 108 of the Patents Act 1970.

In a suit for copyright infringement, the claimant may be entitled to damages, accounts and even conversion damages (unless the defendant establishes that they were not aware and had no reasonable grounds to believe that copyright was being violated).¹⁴⁷

A trend of awarding damages has been particularly observed in cases pertaining to software piracy. In the case of *Microsoft Corporation v. Amritbir Singh and another*,¹⁴⁸ the plaintiff was awarded damages of 3 million rupees against the defendants for infringement of the copyright subsisting in the software programs of the plaintiff.

In *Bridgestone Corporation v. Tolins Tyres Pvt Ltd*,¹⁴⁹ the court directed the defendants who were manufacturing and exporting infringing Bridgestone tyres abroad to pay the plaintiff 3 million rupees and also to pay 500,000 rupees to legal aid. In *Sugen v. KV Prakash*,¹⁵⁰ while disposing of a contempt application, the court directed the defendants to pay 2 million rupees to a cancer research organisation in Madras.

In *Super Cassettes Industries Private Limited v. HRCN Cable Network*, CS (Comm) 48 of 2015, the Delhi High Court granted damages worth approximately 1,620,000 rupees along with attorney and court fees against a broadcaster for unauthorised broadcasting of copyrighted films.

Interim injunctions

Interim injunctions or temporary injunctions are sought in every suit for a permanent injunction in an intellectual property case, because of the length of time a case takes to get to trial. While *ex parte* interim injunctions are granted by courts in the normal course in some jurisdictions in India, there are courts that tend to be wary of granting this relief. The greatest number of *ex parte* interim injunctions are known to have been granted by the Delhi High Court.

Courts have the power to grant *Mareva* injunctions, but they are rarely given in intellectual property cases. The application for a *Mareva* injunction is naturally heard *ex parte*, as is an *Anton Piller* application.

Ad interim injunctions are granted in cases where there is prima facie proof of infringement and the balance of convenience is found to be in favour of the plaintiff owing to irreparable injury that is likely to follow if an ad interim injunction is not granted. The courts are increasingly influenced by the English decision in *American Cyanamid v. Ethicon* and are paying less attention to the strength of the plaintiff's case and more attention to the balance of convenience.

When an interim injunction is ordered against a party, settlement negotiations become extremely determinant of how the dispute may be finally settled. Anti-counterfeiting actions have proved to be very successful in cases where ad interim injunctions have been issued against defendant infringers as the likelihood of a settlement as provided for by the Code of Civil Procedure 1906,¹⁵¹ increases tremendously. This reduces the lifespan of an anti-counterfeiting action by more than half as infringing defendants are reluctant to take the matter to trial.

147 Section 56 of the Copyright Act 1957.

148 CS(OS) No. 732 of 2010.

149 CS(OS) No. 375 of 2016 before the Delhi High Court.

150 CS (COMM) No. 871 of 2016 before the Delhi High Court.

151 Order 23 Rule 3.

Delivery up of infringing material

Infringing goods, and particularly those that have been seized under an *Anton Piller* order, are considered case property during the suit and if the suit goes to trial, they are liable to be forfeited or destroyed. Claimants usually ask for delivery of infringing goods and in matters in which disputes are settled outside court it is usual for the claimant to seek the destruction of the infringing goods as a part of the standard settlement terms. Alternatively, infringing materials such as labels and packaging may also be destroyed, and goods may be returned or donated to charitable organisations.

Certificate of contested validity and other reliefs

A successful claimant in a patent, design or trademark proceeding is entitled to a certificate of validity, which may assist substantially in subsequent proceedings not only to establish validity, but also to obtain increased costs.

The court has the power to direct a defendant to change their corporate name or to publish an apology. The court can also order the defendant to disclose the name of their suppliers and customers.

When an appeal is preferred, the court has the power to grant a stay, depending upon the circumstances of each case.

x Appellate review

Hierarchy of courts

In India, a suit for infringement of trademark, copyright or patents can be filed in a court not lower than a district court. The exceptions to this are the High Courts of Delhi, Calcutta, Madras, Bombay, Shimla, and Jammu and Kashmir, which are courts having original side jurisdiction. Appeals from orders of the district court are heard by the corresponding High court having appropriate territorial jurisdiction. Similarly, an appeal against an order passed by a single judge of a high court having original side jurisdiction will therefore lie with a division bench of the same high court comprising two judges. The decisions in such appeals can be challenged up to the Supreme Court of India subject to grant of special leave by the apex court.

Appeals to the Supreme Court do not have to be based on a final determination of the law suit by a lower Court. The Supreme Court is empowered under Article 136 of the Constitution of India to entertain appeals arising from any stage of a lower court proceeding.

Standards for appeal

The Supreme Court has held in an appeal against the exercise of discretion by the single judge that the appellate court will not interfere with the exercise of discretion of the court of first instance and substitute its own discretion except where the discretion has been shown to have been exercised arbitrarily, capriciously or perversely, or where the court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions. An appeal against exercise of discretion is said to be an appeal on principle. The appellate court will not reassess the material facts and seek to reach a different conclusion different if the one reached by the court was reasonable on the material facts. The appellate court would normally not be justified in interfering with the exercise of discretion under appeal solely on the ground that if it had considered the matter at the trial stage it would have come to a different conclusion.¹⁵²

152 1990 Supp (1) SCC 727.

Introduction of new evidence

The Code of Civil Procedure 1908 permits a party to file additional evidence at an appellate stage in certain circumstances and subject to obtaining leave from the appellate court.¹⁵³

xi Alternatives to litigation

Section 89 of the Code of Civil Procedure, 1908 provides mechanisms for alternative dispute resolution (ADR) and stipulates that where it appears to the court that there exist elements of a settlement that may be acceptable to the parties, the court shall formulate the terms of settlement and give them to the parties for their observations, and after receiving the observation of the parties, the court may reformulate the terms of a possible settlement and refer the same for:

- a* arbitration;
- b* conciliation;
- c* judicial settlement including settlement through Lok Adalat; or
- d* mediation.

In India, the most common form of ADR is mediation, which has been used to great effect, especially in trademark and copyright disputes before the Delhi High Court.

Apart from the above modes of settlement of a dispute, the Delhi High Court has also introduced 'pre-suit mediation', which enables prospective litigants to have matters referred to mediation before the suit is instituted. This mechanism has been extremely successful in resolving disputes.

V TRENDS AND OUTLOOK

The evaluation of the recent legal developments, outlined above, clearly reveals the following trends.

First, the judicial decisions rendered in 2020 by different fora despite the existence of the covid-19 pandemic highlight that the regime of the enforcement of intellectual property rights is robust. The majority of the decisions and recent legal developments covered in this chapter were passed through virtual courts, by way of hearings that took place via videoconferencing. The diverse issues that the decisions touch upon highlight that IP owner rights were protected holistically during the pandemic.

Clarifying the law with respect to the applicability of Section 3(d) to disputes, the Hon'ble Court held that if a plaintiff pleads elements of Section 3(d) of the Patents Act to demonstrate enhanced efficacy in its plaint then, at least at prima facie stage, it cannot be said that there is no enhanced efficacy. This finding is of extreme relevance as it enables future litigants who seek to enforce patents, which they anticipate might be challenged on Section 3(d), to better address that aspect by pleading elements of enhanced efficacy in their plaint.

Further, courts reaffirmed the law of anticipation and applied the same in the context of genus and species patents and in one case held that the species patent was not anticipated by the genus patent because the genus patent was published after the priority date of the species patent. Such a finding is equally helpful in addressing arguments as regards genus and species patents. With regard to genus and species patent disputes, the courts in a case also

153 Order 41 Rule 27, CPC.

specifically held that a compound was covered in the genus patent but was not specifically claimed therein. Such a finding is also noteworthy as the same would enable litigants to address aspects of coverage and disclosure in future cases.

The IPAB was also very pro-active during the covid-19 pandemic and rendered some important decisions to protect the rights of IPR owners that have far-reaching ramifications. Illustratively, the Hon'ble Tribunal held that a generic disclosure cannot defeat the novelty of a subsequent patent. Further, if an aspect was covered but not disclosed in a document, then that document cannot be used for invalidity analysis. Such findings are relevant for invalidity analysis and may also aid parties in court cases.

Clarifying the status of software patents further, the IPAB granted a patent for a computer-related invention holding that prohibition under Section 3(k) of the Patents Act 1970 did not apply. The decision of IPAB provides that 'technical effect' is critical to determine patent eligibility, and the analysis applied certain factors to hold how the patent application involved demonstrated technical effect. The decision is instrumental and would aid applications seeking to file patents for computer-related inventions in India.

The decisions of the past year also touched upon the concept of pre-grant and post-grant oppositions. The courts clarified that the overall objective of pre-grant oppositions was to aid the Controller of Patents and there cannot be too much of a delay in filing the same. The courts stated that the right of a pre-grant opposition cannot be abused and came down hard on a petitioner who, according to the court's view, was abusing the process. The court held that the opposition process cannot be used to throttle legitimate competition. The decision is instrumental for it clarified the value of the pre-grant opposition under the Patents Act 1970 and introduces a necessary check against the abuse of this provision.

On the aspect of post-grant oppositions, the IPAB, clarifying the process, held that no evidence can be filed by either party once a hearing has been fixed by the Controller. The Hon'ble Tribunal also emphasised the importance of the Opposition Board and highlighted that it was mandatory for the Learned Controller to seek the views of the Opposition Board, and if the Learned Controller disagrees with those views, it has to be provided in writing. This decision also sets an important trend as it introduces an element of fair play and a check in the post-grant opposition process.

Addressing a trend where defendants, anticipating a lawsuit, would file a lawsuit for non-declaration of infringement in one forum and then use that prior instituted suit to challenge the maintainability of the suit for infringement bought by a patentee, the courts, as a check to this trend, clarified the scope and interpreted the procedural provisions in Indian law that apply in such scenarios. Simply put, the courts stated that a patentee is the *dominus litus* and has the choice of the forum where to institute the infringement suit, and that the previously instituted suit by the defendant does not impact the maintainability of the infringement suit. This decision, albeit interpreting Indian procedural laws, is also noteworthy and sets an important trend to protect the rights of patent owners.

These rapidly evolving changes ensure that IP owners' rights are duly acknowledged and are being effectively enforced by courts as well as by tribunals and have remained unaffected by the pandemic. These trends indicate that the outlook is favourable for IP owners in the times to come.

ABOUT THE AUTHORS

PRAVIN ANAND

Anand and Anand

Pravin Anand is an intellectual property lawyer with 40 years' experience. He has been awarded the AIPPI Award of Merit and recognised as a Most Innovative Lawyer by *The Financial Times*.

Some recent landmark decisions in his career include patent lawsuits that transformed the pharmaceutical and biotechnology enforcement regime in India, including *Merck v. Glenmark*, *Roche v. Cipla*, the *Monsanto* case and a large number of other suits on behalf of Pfizer, BMS, AstraZeneca, etc. He also worked on India's first anti-suit injunction order (*InterDigital v. Xiaomi*), a software patent lawsuit conferring protection (*Ferid Allani* case), the development of damages culture in a large number of cases that recognised not only punitive, but also compensatory, exemplary and aggravated damages (*Philips v. AmazeStore*), India's first post-trial SEP judgment (*Philips v. Bhagirathi*); the development of unique remedies such as the 'Tree Planting Order' (*Merck* case) and an order benefiting adolescent girls (*Hermes* case).

He is the author of *Halsbury's Laws of India on Intellectual Property* and a large number of chapters in international IP publications.

He is an ex-member of the INTA board of directors and a past president of the Indian groups of AIPPI, APAA and FICPI.

Spreading the message of IP, he has been involved in the Raj Anand Moot Court Competition since 1997; Anaryst, an IP board game; *Brainchild*, the first IP-themed play; *Adventures of Mr. IP*, an IP comic; and *IPONOMICS*, a coffee table book.

SHRAWAN CHOPRA

Anand and Anand

Shrawan has over 14 years of experience as an intellectual property litigator with Anand and Anand, and represents clients before the Intellectual Property Appellate Board, the High Court and the Supreme Court of India. He was one of the leading members on the team that won the landmark decision in *Ferid Allani v. Union of India*, giving a new spin to Section 3(k) of the Patents Act, thereby paving the way for software patenting in India.

He was an active member of the litigation team in landmark cases such as *Aloys Wobben v. Enercon India*, *Roche v. Cipla* and *Monsanto v. Nuziveedu Seeds*.

Shrawan's litigation experience spans patents, copyright, trademarks and domain name disputes. He contributes to prestigious publications including *Asia IP*, *Vantage Asia*, *The IP Law Review*, *CTLR* and *Managing the IP Lifecycle*, to name a few.

Shrawan has the following affiliations: Member, Bar Council of Delhi; Member, International Association for the Protection of Intellectual Property (AIPPI); and Joint Secretary, AIPPI India Group.

He studied law at Agra University and went on to pursue a Masters of Law from the Franklin Pierce Law Centre, University of New Hampshire. Prior to law, he completed a bachelors in political science from the University of Delhi.

VIBHAV MITHAL

Anand and Anand

Vibhav Mithal is a managing associate at Anand and Anand and practises as an IPR litigator in New Delhi, India, in diverse areas ranging from patent law and trademark law to copyright law and plant varieties. He has been an integral part of many path-breaking litigations, such as the *Aloys Wobben* dispute (Supreme Court, 2014); *Roche v. Cipla* (Delhi High Court, 2015); *Monsanto* dispute (Supreme Court, 2019) and *Ferid Allani* (Delhi High Court, 2019 and Intellectual Property Appellate Board, 2020) – a landmark decision that paves way for software patenting in India.

A multifaceted lawyer, Vibhav is a regular contributor to various publications and has written for *Managing Intellectual Property* magazine, *Computer and Telecommunications Law Review* and *Asia Business Law Journal*, and also contributed to the India chapter in *Global Patent Litigation: How and Where to Win* (3rd Edition, 2019) published by Bloomberg Law. Vibhav also is the Head of Community, MKAI, a community engaging in open conversation about important themes in artificial intelligence.

A graduate of National University of Juridical Sciences, Kolkata, Vibhav has also pursued an LLM in intellectual property law as an LLM scholar from Boston University School of Law. In October 2019, he was featured by *National Jurist* in an article titled 'Who's Who of Foreign Attorneys' among 15 prominent LLM graduates, each having been nominated by their respective US law schools.

ANAND AND ANAND

Plot No. 17A, First Channel Building
Sector 16A, Film City, Noida
201301 Uttar Pradesh
India
Tel: +91 120 4059300
Fax: +91 120 4243056
pravin@anandandanand.com
shrawan@anandandanand.com
vibhav@anandandanand.com
www.anandandanand.com

an LBR business

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