

A patently anomalous provision

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With the coming into force of the Patent (Amendment) Act, 2005, India has joined the league of nations that provide a world class intellectual property (IP) protection regime intended to give a fillip to innovation.

The process patents under the erstwhile Patent Act, 1970 gave virtually no incentive to the innovator as the generics could reverse-engineer and come out with copycat products. The grant of the product patent has removed this glaring anomaly. The Government must now ensure the implementation of the new Act in a manner that the innovator is encouraged and he continues to explore new frontiers.

NEW AND IMPROVED?

Is the patent machinery geared to ensure speedy grant of patent? The government has invested heavily in the modernisation and computerisation of patent offices in the four metros, significantly increasing the number of patent examiners.

The Patent (Amendment) Rules prescribe "time-lines" for various stages involved in the grant of patent — publication of the application, examination and submission of the report, putting the application in order for patent grant, etc.

And yet, nearly two years after the new regime came into force, the results are not encouraging. This is primarily due to the process of patent grant getting hamstrung by a spate of pre-grant oppositions.

The Patent (Amendment) Act, allows anyone to oppose a patent application — by filing a pre-grant opposition — within six months from the date of its publication or any time before patent grant, whichever is later. This provision in the Act — it was not there in the Patent (Amendment) Ordinance 2004 of December 26, 2004 — makes the six months time limit redundant; indeed, it makes the time-line limitless!

Thus, for an application published, say, on January 1, 2007, though the six month deadline will expire on June 30, 2007 under the extant provision, the patent office cannot shut the door on pre-grant opposition applications filed after this date. But how long will it keep the doors open?

The time-frame can stretch up to the date of the patent grant; it depends on how the case progresses. Suppose the likely date of patent grant is December 31, 2007. The office can continue to entertain opposition applications till that date.

Will the office stop receiving pre-grant opposition applications after this? The answer is a categorical 'No'. Having received an opposition

representation, say, on December 30, 2007, the patent office will unavoidably take time to dispose of this. And, by the time it gets ready to grant the patent — say, on June 30, 2008 — there is every possibility of another person coming forward to submit a pre-grant opposition. Under the provision, the patent office cannot refuse. The process could go on indefinitely!

NO APPEAL

The provision on pre-grant opposition suffers from another flaw. In case the Controller's decision goes against the applicant, the latter cannot file an appeal. The applicant can only go for a writ in the court, which is a long drawn process. This only compounds the delay.

The provisions for pre-grant op-

There are several reasons why the government should delete the provision for pre-grant opposition from the Patent (Amendment) Act, 2005.

position alone are capable of bringing to naught the positive impact of other measures.

This has serious consequences for both society and the innovator. Society will not be able to benefit from inventions as the innovator will not commercialise it (for reasons of it being copied) until the patent is granted. The more the delay, the greater the loss.

For the innovator, since the patent term is reckoned from the date of filing of the application, any delay in the grant of patent will correspondingly reduce the effective period of patent protection available.

Contemplate a scenario in which the innovator loses the entire patent term (exclusivity period) of 20 years, in fighting out the pre-grant opposition battles.

The provision for pre-grant opposition is out of tune with global trends. In recent years, even countries such as China, Brazil, Taiwan and Korea have amended their laws to provide for only post-grant opposition of patent applications. Why should we not follow suit?

FLAWED ARGUMENT

The argument that the provision for pre-grant opposition is meant to check grant of "frivolous" patents is flawed. The underlying presumption that an applicant seeking a patent has

dubious intentions is without basis.

Even assuming that there is the possibility of a frivolous patent grant or a patent wrongfully granted, this can be taken care of by the provision for post-grant opposition under the Act, which can be filed within a year from date of grant of the patent.

The Act allows for both pre-grant and post-grant opposition (besides revocation of patent) — all on same grounds.

The concurrent existence of these provisions gives an impression of an innovator being viewed as a convict whom the law enforcers are trying to corner.

These provisions are tantamount to a Damocles sword hanging above the innovator over the entire life-cycle of the patent — from the date of publication of the application to any time up to the date of grant and any time even after the grant of the patent.

The government should delete the provision for pre-grant opposition from the Act.

If retained, it must be suitably amended to provide for a clear-cut, unbreachable deadline, beyond which no pre-grant opposition should be permitted.

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