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Article

Post-dating of patent applications and its implications

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Introduction

Post-dating means to change the priority date of a patent application to a later date. The Indian Patents Act facilitates a patent application, whether provisional or non-provisional, to be post-dated under Section 17 of the Patents Act, 1970, to a maximum of six months, from the date of making of such application, provided that the request for post-dating has been filed by the applicant before the grant of the patent. Similar provisions of post-dating a patent application also exist in New Zealand and United Kingdom. However, the United States of America does not have any provision for post-dating of patent applications.

A double edged sword

Justice N. Rajagopala Ayyangar in his “Report on the revision of the patents law” suggested addition of the provision for post-dating of a patent application, in line with the provisions provided in the then UK Patent Act. In certain cases, post-dating of a patent application may provide the applicants with an extension of time to complete certain post-filing formalities of the patent application. However the applicant should ensure that the invention covered by the patent application has not been publically disclosed either by the applicant himself or by any third party before post-dating the application. It is preferable if a thorough search of patent and non-patent literature is conducted to ensure that there is no disclosure of similar subject matter as that of the invention, by any third party, in the intervening period.

Analysis of the Indian statute

In situations where an applicant has filed a provisional specification followed by a complete after provisional (CAP) specification, the applicant, under Section 9(4), may request the Controller, any time before the grant of the patent, to cancel the provisional specification and post-date the provisional specification to the date of filing of the CAP. Under Section 17(1), the applicant has the option of filing a request to the Controller to post-date any application by a maximum period of six months from the original filing date. Such post-dating is subject to the provisions of Section 9.

Does post-dating shift deadlines imposed by Section 9(1)?

A common dilemma faced by applicants while post-dating a provisional specification is whether the deadline for filing the CAP application will be calculated from the original filing date or the post-dated date. It should be noted that Section 9(1) states that a CAP specification should be filed within 12 months of the filing date of the provisional application. Shifting of the CAP filing deadline by post-dating the provisional application is an issue not yet addressed by the IPAB or the courts.

Referring to the history of Section 9(1), the amendments in 2005 deleted the portion of the then Section 9(1) which provided that complete specification may be filed at any time after twelve months but within 15 months from the filing of provisional specification if a request to that effect

was made to the Controller and prescribed fee was paid.

The deletion may be interpreted to indicate that the legislative intent was to impose a strict deadline of 12 months for filing of the CAP application from the filing date of the provisional specification. The courts may interpret that since Section 17 is subject to the provisions of Section 9, a post-dating under Section 17 will not extend the deadline imposed by Section 9(1). It is preferable if applicants file the CAP application within 12 months of the original filing date of the provisional application to avoid probable pitfalls.

Can a provisional application be post-dated under Section 17 if a complete application has been filed already?

Another interesting issue which arises is whether the applicant can post-date the provisional application under Section 17, if a CAP application has already been filed. In 1999, the Delhi High Court in *Standipack Pvt. Ltd. v. Oswal Trading Co. Ltd.* cited the then Section 9 and Section 17 and stated “The aforesaid provisions make it crystal clear that post-dating of the patent can be done only to the date of filing of the complete specification”. The amendments to Section 9 and Section 17 thereafter extended the deadline for filing a request of post-dating from any time before the acceptance of the complete specification to any time before the grant of the patent. This amendment may not change the interpretation made by the Delhi High Court regarding the interplay of the two sections. The implication of the decision of the Delhi High Court can be understood only after a detailed analysis of the facts and will be covered in a subsequent issue.

Implications on PCT/Convention filings

In situations where an applicant has missed the 12 month deadline for filing a convention application or PCT application taking priority from an Indian application, a popular approach is to post-date the priority Indian application. However, the same may not yield the intended result. For the sake of brevity, the implication of post-dating convention filings is considered in the context of practice by the United States Patent and Trademark Office (USPTO), the European Patent Office (EPO) and the World Intellectual Property Organization (WIPO).

USPTO

With reference to the practices adopted by the USPTO, § 201.13 of the Manual of Patent Examining Procedure (MPEP) states that “*if the original filing date is more than one year prior to the U.S. filing no right of priority can be based upon the application*”. One of the most cited treatise “Chisum on Patents” states: “*In re Clamp (1966), the applicant filed a provisional specification on February 8, 1963, but thereafter post-dated it to March 6, 1963. The applicant filed in the United States on March 5, 1964. The Commissioner of Patents held that the United States application was not timely for purposes of Section 119. The original actual filing date is determinative. The Paris Convention “never contemplated the arbitrary creation of an artificial date’.*” Article 4(C) (4) of the Convention and the third paragraph of Section 119, on abandoned applications suggest that “*the effect of starting the year running by the proper filing of a proper application cannot otherwise be eradicated*”.

Thus, the deadline to file the US convention application remains 12 months from the date of the original filing and not from the new filing date that may be assigned to the post-dated patent application.

EPO

As per Article 87(4) of the European Patent Convention (EPC), the post-dated patent application may be considered as a priority application, *provided that, at the date of filing the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding.* The previous application may not thereafter serve as a basis for claiming a right of priority.

The case law of the Boards of Appeal further elaborates *“Swiss patent law allows a patent application to be postdated if it is subsequently amended. In T 132/90 the patent proprietor had claimed 11.3.1983, the original filing date of the earlier Swiss application, as the priority date for his European application dated 9.3.1984. In 1985 the Swiss Patent Office ordered that the filing date of the Swiss patent application be set at 1.7.1983 following subsequent completion of the technical documentation. The board of appeal concluded that the original application should serve as the basis for claiming a priority right and that the priority date was the filing date of the original application. The postdating order did not take effect ab-initio, and the subsequent fate of the original application was immaterial as far as the priority date was concerned.”*

Since, at the time of filing the post dated application, the original application is not withdrawn

or abandoned or refused, the original application will be considered to serve as priority application. Therefore, the deadline for filing the EP convention application will remain 12 months from the original filing and not from the new filing date that may be assigned to the post-dated patent application.

WIPO

On the other hand, the PCT provisions provide greater flexibility. As per Rule 26bis.1(c) of the PCT, *“Where the correction or addition of a priority claim causes a change in the priority date, any time limit which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date as so changed.”* Accordingly, if, at the time of post-dating the application, the deadline to file a PCT application had not expired, the deadline (time limit) to file the PCT application will be computed from the shifted priority date. In case the applicant has missed the deadline for filing a PCT application, under Rule 26bis.3, the applicant has to file a request with the Receiving Office, within two months from the twelve month deadline, for restoring the priority of the PCT application. The Receiving Office may restore priority on a case to case basis.

Implications of post-dating priority application while filing convention application in India

The Patents Act, 1970 does not explicitly address situations where a foreign priority patent application is post-dated and is subsequently filed in India. As per Section 135 when a patent application (basic application) is filed in a convention country, the applicant may, within twelve months from the date of making the basic application, file a

patent application claiming priority from the basic application, in India. A strict interpretation of this section indicates that India may not recognize priority claim of a convention application taking priority from a post-dated foreign patent application whose original filing date is more than twelve months prior than the Indian application. Of course, the other interpretation is that the post-dated application is the basic application, once post-dating is permitted. There are no judicial pronouncements on this till date.

Conclusion

Thus, applicants must exercise the option of post-dating a patent application after carefully weighing the possible implications. Post-dating is a grey area in Indian patent law and it will be interesting to see how the Indian Courts and the IPAB would interpret the provisions.

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Statutory Update

Guidelines for examination of biotech patent applications, issued

The Indian Patent Office has issued 'Guidelines for examination of biotechnology applications for patent' on 25-3-2013. Briefly tracing the history of biotechnology related patents and special issues like moral ethical concerns, expressed sequence tags and prevention of misappropriation of biological resources and traditional knowledge of India, the guidelines seek to ensure uniformity and consistency in examination. It discusses novelty, inventive step, industrial applicability, discovery of living things, enhancement of efficacy, method of agriculture, treatment and diagnosis, sufficiency of disclosure and unity of invention in the context of examination of patents in biotechnology and allied fields.

In respect of product by process claims, the guidelines state that they are admissible only if product themselves are patentable. Novelty can only be established, if technical evidences are provided showing that the modifications in the processes result in other products which are

distinct with regard to their properties over the products known in the prior art. On inventive step, the guidelines hold that if the claimed invention relates to a polynucleotide/polypeptide having mutation(s) in a known sequence of polynucleotide/polypeptide, which does not result in an unexpected property, the claimed subject matter lacks inventive step. The invention must also be capable of industrial application, it must be examined whether the invention claimed has a useful purpose, and whether the specification identifies any practical way of using it. As per the guidelines, products such as micro-organisms, nucleic acid sequences, proteins, enzymes, compounds, etc., which are directly isolated from nature, are not patentable subject-matter.

Further, the inventions relating to three-dimensional or crystal structure of a polypeptide would attract the provision of Section 3 (d) of the Patents Act unless it is proved that such polypeptide differs significantly in the properties with regard to therapeutic efficacy. On applicability of Section 3

(k) of the Patents Act, it states that determination of patentability of inventions relating to bioinformatics requires special attention. Under sufficiency of disclosure it lays down that claims to antibodies that may have therapeutic or diagnostic potential

are unsupported if a role for the target protein in a specific disease has not been identified and proved by sufficient data. The separate guideline issued in respect of traditional knowledge related subject matter will also apply.

News Nuggets

Advocating the case for patent agents

In the recent decision on Novartis' case, the Supreme Court of India observed that scope of a patent claim should not be determined by artful drafting by skilful lawyers. The drafting skill and services rendered by lawyers/patent agents was the subject of debate before the High Court of Madras. The High Court was of the view that being enrolled as an advocate is certainly a better qualification than the examination conducted by the Controllers of Patents in Patents Act (the Act) to register any one as patent agent. It declared as 'illegal, unconstitutional, ultra vires, void and unenforceable' the amendment to Section 126 of the Act which bars advocates from directly registering as patent agents and allows only those with qualification in science, engineering or technology to qualify through the patent examination. The petitioner was an advocate practising in IP laws but who could not be registered as patent agent owing to the amendment. Some interesting aspects which emerged out of the discussion are that legal acumen, drafting and interpreting are forte of lawyers, the branches of science are so diverse that a mere degree without any background in law could not ensure that

public are getting the best services available and that by prescribing such conditions, a monopoly was being created unreasonably restricting the rights of a certain class - namely advocates.

International exhaustion in copyright

Even as the dissenting judges voiced their reservations, the US Supreme Court recognised the principle of international exhaustion in the case of *Kirtsaeng, DBA Bluechristine v. John Wiley & Sons*. This closely watched dispute was between the student, who had imported certain textbooks and resold them in the US, and the publisher. The textbooks were sold at lower prices in Thailand by a subsidiary of the US publisher. The Supreme Court made a distinction between pirated copies, those made without proper authorisation and copies lawfully made in a foreign country but imported without authorisation. It held that protection under the First Sale doctrine was available in respect of lawfully made copies, legally obtained abroad. It was of the opinion an alternate view would give an American copyright holder permanent control over the American distribution chain in respect to copies printed abroad.

Ratio Decidendi

Registration of design abroad when not a ground for cancellation in India

Answering a reference from the division bench, the full bench of Delhi High Court opined that existence of public record in the office of Registrar of design in a convention country abroad may or may not amount to prior publication. It stated that each case has to be necessarily judged by putting the subject design with the articles side by side with the prior publication material and only after thoroughly scrutinizing the same any finding can be given of existence or non-existence of prior publication.

The High Court held that registration of a design abroad is not a ground for cancellation and if application is not made in India within 6 months of foreign registration, it would be subsequent in date to the India registered design. Interpreting 'published' and 'publication', the Court looked into it from the point of view of whether publication is by means of publishing in paper form available in public or whether it should be in tangible form. It concluded that to disqualify a claim for registration or cancel registration of a design in India, the publication abroad should be by use, in tangible form, or in some other way. The design on paper should be recognizable i.e. have the same impact on the public as a furnished article will appear when judged solely by the eye. It noted that the Act protects the original artistic effort not in the form of an idea or on its own as an artistic work, but an embodiment in a commercially produced artefact.

At issue was the correctness of ratio in *Dabur India Ltd. v. Amit Jain & Anr.* [2009 (39) PTC 104 (Del) (DB)] and *Gopal Glass Works Ltd. v. Assistant Controller of Patents & Designs* [2006 (33) PTC 434 (Cal.)]. As per these decisions mere publication of designs, specifications, drawings and /or demonstrations by the patent office in a foreign country would not in itself amount to publication rendering a design registered in India liable to cancellation. The reference sought to resolve the apparent conflict with Section 44 of the Designs Act, 2000 (the Act) which provides that a person who gets his design registered abroad under Paris Convention and applies within 6 months for registration in India, is entitled to claim priority date from date of foreign registration. As per Section 19 of the Act, prior publication in India or in any other country is a ground for cancellation of registration. [*Reckitt Benkiser India Ltd v. Wyeth Ltd*, Delhi High Court Order dated 15-3-2013]

Principles of passing off applicable to domain names

Granting permanent injunction against the defendants from using the trademark/domain name *www.tatainfotech.in*, and decreeing cancellation of the domain name, the Delhi High Court reiterated that principles of passing off would fully apply to an infringement of a domain name. In the instant case, the defendant registered the domain name and wrote to the plaintiff hoping to sell the domain name to the plaintiffs, or take unfair advantage of the distinctive character and reputation of the plaintiffs' trademark. [*Tata Sons Ltd. v. Arno Palmen*, Delhi High Court Order dated 22-3-2013]

Trademarks – Mere overlap of users not sufficient to hold goods similar

Trade mark “Dabur Uveda” has been allowed registration in relation to cleaning, polishing, scouring and abrasive preparations against opposition by “Aveda” in this class of products. The English High Court of Justice, Chancery Division was of the view that there would be a strong likelihood of an average consumer entertaining a thought that it indicated some connection between DABUR and AVEDA as it made little difference that the second word in the composite mark is UVEDA rather than AVEDA. But it noted that Aveda accepted that it had made no use of its trade mark in relation to *household or industrial* cleaning, polishing, scouring and abrasive preparations during the

relevant period, and had used the mark in relation to cleaning, polishing, scouring and abrasive preparations *for use on the body*. The court held that average consumer would not regard exfoliants, body polishers and dermabrasives (which were products of Aveda) as exemplifying a sub-category of “cleaning, polishing, scouring and abrasive preparations for the body”. The court noted that the consumer would rather regard them as examples of “skin care products, namely ... cleansing lotions” and/or “body cleansing lotions”. The court hence held that Aveda’s products were not similar to the Dabur’s Class 3 specification - their uses, physical nature and trade channels being all different, and they are neither competitive nor complementary. [*Aveda Corporation v. Dabur India Ltd.* - [2013] EWHC 589 (Ch), decision dated 18-3-2013].

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