



# INTELLECTUAL PROPERTY AND TECHNOLOGY LAW UPDATES

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## Indian Patent Office Incentivizes Women Applicants in its Draft Rules 2018

- Heena Lamba

WIPO, in its report<sup>1</sup> “*World Intellectual Property Day 2018 Celebrates Women’s Accomplishments: New WIPO Figures Show Highest-Ever Rate of Women Inventors, but Gender Gap Persists*” presented on April 26, 2018, in Geneva, gave a picture of status of women in patenting in the year 2017. According to the report, although the status of women as patent applicants (Nationally or Internationally) has improved a lot in some countries like Republic of Korea and China where almost every second application comes with women as sole/one of the inventors, still most other countries need to go a long way to achieve the same. An excerpt from the report is shown in the table given below which gives country wise proportion (%) of women who are active as inventors in different countries.

| S.No . | Country       | Share (%) of PCT applications with women inventors in 2017 |
|--------|---------------|--|
| 1.     | Rep. of Korea | 50.29371   |
| 2.     | China         | 47.91108   |
| 3.     | Belgium       | 35.69132   |
| 4.     | Spain         | 35.42977   |
| 5.     | U.S.          | 32.84788   |

<sup>1</sup> World Intellectual Property Day 2018 Celebrates Women’s Accomplishments: New WIPO Figures Show Highest-Ever Rate of Women Inventors, but Gender Gap Persists. Available on:

|     |             |          |
|-----|-------------|----------|
| 6.  | France      | 32.53552 |
| 7.  | India       | 28.33212 |
| 8.  | Netherlands | 28.31270 |
| 9.  | Switzerland | 28.07512 |
| 10. | Israel      | 26.34593 |
| 11. | Finland     | 25.34837 |
| 12. | Canada      | 24.84389 |
| 13. | Denmark     | 24.05063 |
| 14. | U.K.        | 23.85815 |
| 15. | Sweden      | 23.60365 |
| 16. | Australia   | 21.57418 |
| 17. | Japan       | 20.00454 |
| 18. | Germany     | 18.99479 |
| 19. | Italy       | 18.64139 |
| 20. | Austria     | 15.91073 |

Even though the above data shows India on 7<sup>th</sup> position still in reality the country witnesses gender inequality in International filings. In order to uplift the status of women, an attempt has been made by the Indian Patent Office, which is first of its kind in the field of Intellectual Property Rights. This attempt is evident from the draft of Amendments in Patent Rules<sup>2</sup> in 2018 published on December

[https://www.wipo.int/pressroom/en/articles/2018/article\\_0003.html](https://www.wipo.int/pressroom/en/articles/2018/article_0003.html)

<sup>2</sup> Draft of Patent Rules 2018. Available at <https://dipp.gov.in/whats-new/draft-patent-rules-2018>

10, 2018. The amendments are brought in by the Central Government under the aegis of section 159 of the Patents Act, 1970. The said draft is meant to be enforced after the expiry of a period of thirty days from the date on which copies of the Gazette of India, in which this notification is published, are made available to the public. This time period is given for inviting objections and suggestions from the persons most likely to get effected by enforcement of the published draft, which are then carefully considered by the Central Government and accordingly amendments are thereafter enforced.

According to the draft, following amendments have been proposed in the Patent Rules 2003:

- Rule 18 has been amended with the addition of a clause with respect to International applications. The said amendment restricts filing, leaving, making or giving all documents including scanned copies only by electronic transmission, which should be duly authenticated by the applicant or agent. It further provides the provision to submit the originals within a period of 15 days, after which it will not considered to be filed.
- An important amendment has been suggested in sub-rule (1) of rule 24 C regarding the cases where examination can be expedited before issuance of FER. Central Government has now allowed the following to avail the facility of expediting their patent application in order for grant, apart from start-ups and applications delegating India as International Searching Authority (ISA) or International Preliminary Examining

Authority (IPEA) while filing PCT application:

- Small entity;
- Natural person (where the applicant or at least one of the applicants is female);
- Government undertakings;
- Applicants eligible under agreements between Indian Patent Office and other participating Patent Offices.
- Submission of Form 28 (information to be submitted by a small entity or start-up) along with Form 18A (request for expedited examination of application for patent) is also proposed to be mandated if the applicant avails expedited examination, under all the cases except where India has been elected as ISA or IPEA for an International application.
- Another important amendment is in respect of pre-grant opposition, wherein Controller will, by order, constitute a bench of two members to dispose of the application for post grant opposition. It has also been notified that in case of ambiguity in decision of the bench, a third member can be nominated to be a part of that bench where-after decision taken by the majority will be considered as final.

The intent of Indian Patent Office to bring more women in picture is clear from the second amendment stated above. Expedited examination of Patent Application has been brought in Patent Rules, 2003, in its 2016 amendment, where this benefit was given only to start-ups and applications delegating India as ISA/IPEA during PCT filing. The current amendment adds four more types of applicant,

which has made this feature more relevant to the groups, who might need to avail quicker prosecution of their applications to enjoy exclusive rights from them. It is expected that this amendment will bring in or motivate more women researchers to enter into the field of innovation, such that status of India could be improved in terms of women researchers filing applications for patents.

## Patent Troll - Patent against Innovation

- Monika Shailesh

### Introduction

A Patent Troll uses a Patent as a lawful weapon, rather than making new products or evolving with new ideas. Patent trolls are individuals or companies that are in the business of litigations. As the patent offices across the world are seeing a large number of patent applications, many times patent offices do issue a patent for ideas that are not Novel or Radical -these patents have very broad applications in our day to day life and include common sense ideas. Patent trolls use their patent titles to try to compel individuals, businesses and non-profits to pay them fees for use of ordinary items of daily uses like office equipment, printers, Wi-Fi routers and these days a new trend of threatening Mobile Phone App developers is also in business.

### Patent Trolling from Indian Perspective

Indian patent system has seen a paradigm shift where it has transformed itself from a system where monopoly rights over intellectual property rights are balanced against the public interest. There have been many instances where the Indian courts have sent a strong message that any act of using the patents in negative sense will not be tolerated. Indian patent laws do not specifically prevent the patent trolls, however there are various provisions that significantly prohibit Non-Performing Entities or patent trolls.

Patent trolls maintain a bucket of patent till the technology matures and then start various

litigation against the users. Section 146 of Indian patent act ensures that patent(s) is commercially utilized or worked in India. If the patentee fails to submit the proof for the same the subject patent is made available to the public by invoking compulsory licensing for the same. The time frame as prescribed by the Indian patent act is not enough for the patent trolls to act since the time is not enough for patent troll to acquire the required patents and the technology is also not matured.

### Section 146, patent Act

*1. "The Controller may, at any time during the continuance of the patent, by notice in writing, require a patentee or a licensee, exclusive or otherwise, to furnish to him within two months from the date of such notice or within such further time as the Controller may allow, such information or such periodical statements as to the extent to which the patented invention has been commercially worked in India as may be specified in the notice"*<sup>3</sup>

*2. " Without prejudice to the provisions of sub-section (1), every patentee and every licensee (whether exclusive or otherwise) shall furnish in such manner and form and at such intervals (not being less than six months) as may be prescribed statements as to the extent to which the patented invention has been worked on a commercial scale in India"*

*3. "The Controller may publish the information received by him under sub-section (1) or sub-section (2) in such manner as may be prescribed."*

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<http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps146.html>

Patent trolls utilize the fact that the patent infringement cases could be extended over longer periods and results in substantial loss in production and revenue. It is due to the reason that patents are complex to understand, lack of technical knowledge may extend such periods to great extent. Section 115 of the patent act allows appointment of scientific advisers with deep technological knowledge for speedy trials. It also helps the courts to identify dubious patents and to revoke them.

#### Section 115 of Indian Patent Act

(1) *“In any suit for infringement or in any proceeding before a court under this Act, the court may at any time, and whether or not an application has been made by any party for that purpose, appoint an independent scientific adviser, to assist the court or to inquire and report upon any such question of fact or of opinion (not involving a question of interpretation of law) as it may formulate for the purpose.”*

(2) *“The remuneration of the scientific adviser shall be fixed by the court and shall include the costs of making a report and a proper daily fee for any day on which the scientific adviser may be required to attend before the court, and such remuneration shall be defrayed out of moneys provided by Parliament by law for the purpose.”*

Dubious patents are another favorite of patent trolls, these are used by patent trolls to enter litigations. Indian patent system counters these kinds of patents with section 3(d). However, disagreement continues to rage over significant issues affecting rights holders, such as Section 3(d) of the Patent Act, which is unique to India. Section 3(d) makes it very

difficult for the patent trolls to get dubious patents and of the Evergreening of the patents.

#### Section 3(d)

*“the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine, or apparatus unless such known process results in a new product or employs at least one new reactant.”*

## Request for Examination is Unconardonable

- Aayush Sharma

### Introduction

In this article we will discuss the importance of timeline in the patent and the observations of Patent Office when any deadline has been missed by the applicants. In one of the recent cases - *Sphaera Pharma, Pte. Ltd. and Anr. Vs Union of India*, the Hon'ble Delhi High Court decided upon the issue pertaining to the limitation period for the examination of a patent application prescribed under the Patents Act, 1970. The court once again decided on the validity of condonation of delay in the filing a request for examination of a patent application.

In the case, Sphaera Pharma (petitioner) filed a patent application (no. 3114/DEL/2012) with the Indian Patent Office on October 05, 2012. Accordingly, as per the Act, the petitioner was also required to file a request for the examination - Form 18 of the patent application within 48 months from the date of filing the initial patent application. The petitioner had also filed Form 30 with respect to the Patent Application so that the request for examination could be taken on record. However, the said request was not uploaded due to some technical reasons and as a result the patent application was shown as abandoned under Section 11B of the Act. Thereafter, the petitioner filed a review petition for its patent application which was not considered by the Patent Office. The petitioner, aggrieved by the Patent Office, filed a writ petition before the Hon'ble Delhi High Court for the restoration of the patent application. The petitioner contented that the Controller of Patents had the power under Rule 138 of the Patent Rules, 2003 ("Rules") to extend the prescribed time

period, for filing a patent examination request, for a period of one month.

The Court critically examined the language of Section 11B of the Act along with Rule 24B of the Rules and held that a plain reading of both the provisions clearly depict that there is no scope for consideration of any application for examination which is filed beyond the prescribed time period (48 Months) from the date of filing of the Patent application.

The petitioner's contention regarding power of the Controller of Patents under Rule 138 was rejected by the Court. In this regard, the Court held that a plain reading of Rule 138 would clearly show that the power of the Patent Controller to extend the prescribed time period under the said Rule does not extend to the time prescribed under Rule 24B as it expressly excludes sub-rules (1), (5) and (6) of Rule 24B. The court also opined that even if Rule 138 is ignored, no recourse is available to the Petitioner under Rule 138 as, according to Rule 138(2), it only applies to the examination requests which are made before the expiry of the prescribed time period. In the present case, the petitioner had not made any such examination request within 48 months from the date of filing of the patent application.

The Court took reference to a previous judgement in the case of *Nippon Steel Corporation v. Union of India*, wherein there was an error in entering the priority date of the patent. The relevant excerpt of the judgement is below:

*"There is a logic to the time limits set out under the Act. The scheme of the Act and the Rules require time-bound steps to be taken by applicants for grant of patent at various stages. The provisions of the Act and the Rules have to expressly reflect the legislative intent*



*to permit relaxation of time limits, absent which such relaxation cannot be read into' the provisions by a High Court exercising powers under Article 226 of the Constitution. In other words, it is not possible for this Court to accept the submission of the learned Senior counsel for the Petitioner that the time-limits under Section 11-B(1) of the Act read with Rule 24-B of the Rules, notwithstanding Section 11-B(4) of the Act, are merely directory and not mandatory. In fact, the wording of Section 11-B(4) of the Act underscores the mandatory nature of the time limit for filing an RFE in terms of Section 11-B(1) of the Act read with Rule 24-B of the Rules."*

The Court discussed the Nippon case judgment and clarified that the time-limit prescribed under the Act for filing a patent examination request is mandatory in nature and cannot be relaxed under any circumstances.

The crux of the case is that the timelines mentioned in the Act, play an important role in the complete course of the patent. And if the applicant misses to file request for examination or fails to enter the PCT national phase application or respond to the office action within the prescribed time, due to any of the reasons whether it may be due to technical error, docketing error, there is no recourse available to revive the case. The Act also mentioned regarding the powers of Controller wherein Condonation can be filed in few actions and the same can be obviated by the Controller u/s 138. However, the Condonation is applicable only in few actions. With the help of this case, the Delhi High Court has re-affirmed the issue regarding time limit for filing a request for examination of a patent application. The Court has clarified that the

time limit of 48 months is mandatory in nature and must be adhered to regardless of the delay caused due to any technical reason, any error in entering the priority date for the patent or due to any other reason. The time limits are prescribed for a purpose and thus they must be followed by the applicants strictly. However, considering the problems which arise due to technical reasons, there must some alternate recourse available to the applicants for filing the request for examination of patent application after the termination of the prescribed time period.

## **IPR Highlights for the year 2018**

Year 2018 saw some interesting developments in the field of IPR. The following list enumerates the major ones:

### **A. Highlights in Trademarks & Copyrights**

#### **○ Supreme Court of India (July 2018) - “Similar trademarks for different items not breach of law”**

The Supreme Court of India has held that there is no infringement of law if two distinctly different products are marketed by two different companies with deceptively similar trademarks. This infringement case had been ongoing for a decade between Karnataka Cooperative Milk Producers Association which has been trading milk and milk products under the trademark ‘Nandini’ since 1985 and a group adopted the name ‘Nandhini’ for its restaurant and food products business since 1989. The matter moved from the Trademark Registry to IPAB to High Court. The Hon’ble High Court had put restraints on the group from using the trademark “Nandhini”. The matter was eventually filed before the Supreme Court in the year 2015. The bench consisting of A.K. Sikri and Ashok Bhushan distinguished the goods for which the deceptively similar trademarks were being used. The Court’s decision was eased when the Restaurant group decided to give up its claim over “milk and milk products”.

#### **○ Skechers USA v. Pure Play Sports – Implications of Actual Costs and Taxation of Costs – A Notable and Welcome Change in the IP Regime**

On May 15, 2018, a suit for trade dress infringement and passing off was decreed in

favor of Skechers, in a summary judgment by a Single Judge of the Delhi High Court. The Court granted a summary judgment in favor of Skechers, the plaintiffs, despite there being no application filed by it for the same. The Court was of the opinion that it has the power to pass a decree in a suit summarily, if it is satisfied that nothing would come out of putting a party through the rigmarole of a trial along with costs.

#### **○ Glenmark Pharmaceuticals Ltd. v. Curetech Skincare**

In the case of *Glenmark Pharmaceuticals v. Curetech Skincare and Galpha Laboratories Ltd.*, the Bombay High Court awarded damages of an unparalleled amount of INR 1.5 Crore in view of the Defendant No.2, Galpha Laboratories being found guilty of habitual infringement of trademarks and copyrights. In this case, the plaintiff made an unusual choice and requested to transfer the entire amount of the exemplary damages to a charitable organization. Thus, the Court directed the payment of damages towards the Kerala Chief Minister Distress Relief Fund. This is most probably the largest order of exemplary costs in a trademark infringement case. The Galpha Laboratories’ mark CLODID-B was alleged to be infringing the plaintiff’s trademark CANDID-B. It was further alleged that Galpha Laboratories had even copied the word mark, artwork, color scheme, and trade dress of the plaintiff. Defendant No.1 Curetech Skincare is a contract manufacturer, who was manufacturing on behalf of Galpha Laboratories. Therefore, the Defendant No.1 was provided with the art-work, labels and the mark by Defendant No. 2 under a Contract Manufacturing Agreement. Interestingly, the defendants, in this case, accepted the

allegations made by the plaintiff and willingly submitted to the decree by not contesting the suit.

- **Carlsberg Breweries v. Som Distilleries-**  
*With this judgment, the court has cleared the fog over maintainability of a composite suit of infringement of design as well as passing off.*

In a recent judgment dated December 14, 2018, a five-judge bench of Delhi High Court has ruled that a plaintiff can join two causes of action - one of infringement of the registered design of the plaintiff and the second of the defendant passing off its goods, against one defendant in a composite suit. The suit in question was filed, complaining of infringement of a registered design as well as passing off (of the plaintiff's trade dress) in respect of the bottle and overall get up of the "Carlsberg" mark. The defendant objected to the frame of the suit, pointing out that *per Mohan Lal*, the two claims (for passing off and reliefs regarding design infringement) could not be combined in one suit. The question was sent to Delhi High Court for reference which constituted a special bench to decide the issue.

The issue in front of the court was to decide whether in one composite suit, there can be joinder of two causes of action, one cause of action being of infringement by the defendant of a design of the plaintiff which is registered under the Designs Act, 2000 and the second cause of action being of passing off by the defendant of his/its goods/articles as that of the plaintiff's.

With this judgment, the court has cleared the fog over maintainability of a composite suit of infringement of design as well as passing off. The judgement upholds the fundamental rationale behind the provision of joinder of

causes of action i.e. avoiding needless multiplicity of suits. The judgment has also affirmed that remedy for passing off for a registered design can be brought if the said design is not functioning as a trademark and if the remedy of passing off is claimed for trade dress infringement or any other similar infringement. With ever escalating cost of IP litigation, the ruling in respect to the maintainability of the court, in particular, will bring massive relief to the plaintiffs. Composite suits for design infringement and passing off will also promote convenient disposal of such disputes.

- **Anand Bhushan v. Union of India**

In a significant development, a Division Bench of the Delhi HC examined the constitutionality of Rules 56(3), 56(4), 56(5), 56(6), 57(5), and Rule 61(5) of the Copyright Rules, 2013. The Rules lay down the manner in which copyright societies can frame their tariff schemes, the manner in which the tariff schemes can be challenged etc. It was argued, quite correctly, that these rules went far beyond the scope of power delegated to the government under Section 33A of the Copyright Act. The Court, however, upheld the constitutionality of the Rules. In their opinion, the Rules did not derogate the parent legislation i.e., the Copyright Act.

- **The Indian Performing Society v. Vodafone Idea Ltd**

The Calcutta HC directed Vodafone to deposit a whopping amount of Rs. 2.5 crore in a copyright infringement suit filed by IPRS. The decision raised two main issues, amongst others: (1) The nature of the "right to receive royalty" available to authors of musical and literary works and (2) Against whom this

particular right can be exercised and the enforcement mechanism for ensuring the same. The right to receive royalty is not an exclusive right under Section 14 of the Copyright Act and that it is, in effect, a contractual term used between the assignor and assignee of the copyright in underlying works, as mandated by the statute.

- **Navigators Logistics v. Kashif Qureshi**

In this case an employer alleged that a former employee was using their customer list to compete with them. With respect to copyright, the court held that the employer had failed to establish that the list was ‘original’ under the ‘skill and judgment’ standard espoused in *Eastern Book Company v D.B. Modak*. On grounds of confidentiality, the court held against the employer. It concluded that it is not possible to claim confidentiality in every customer list, since most details are available in the public domain. Therefore, the plaintiff must specifically establish the economic or commercial value of their customer list in order to protect it.

- **Tis Hazari Court, Delhi, grants punitive damages of INR 20 lacs to Super Cassettes against Sun Cable Network**

In a copyright infringement suit filed by Super Cassettes Industries Pvt. Ltd (T Series) against Chhattisgarh based cable operator, Sun Cable Network (defendant), the Tis Hazari Court, Delhi, vide an ex-parte judgment, awarded punitive damages of INR 20,00,000/- to T Series and decreed a permanent injunction against the defendant from exploiting the copyrighted works of T Series. A similar order was also obtained by T Series against Sky Cable Network and Rajasthan based operator, Brij Network.

- **Sanjay Kumar Gupta & Anr v. Sony Pictures Networks India P Ltd.**

Delhi High Court rejected the plea of copyright infringement against Sony Entertainment in relation to ‘Kaun Banega Crorepati’. The appellants, in this case, had a concept termed “Jeeto Unlimited”, where home viewers of a quiz show could participate live in a quiz show and were rewarded for answering correctly. It was alleged that, on presenting this concept to Sony, they were compelled to sign a consent letter which allowed Sony to use the concept without incurring any liability. The Court applied the ‘*scenes a faire doctrine*’ stating that since the idea was to enable home viewers to simultaneously play along with contestants, some similarities were bound to arise, but upon scrutiny, crucial differences were found in concepts of the appellant and respondent. The Court held that there was no breach of confidentiality as the appellants had signed a consent letter authorizing Sony to use the concept.

## **B. Highlights in Patents**

- **PPH: Patent Prosecution Highway**

Patent Prosecution Highway, as the name suggests, brings fast track prosecution of patents. PPH has been followed in many Patent Offices as bilateral or trilateral agreements. One such trilateral agreement is also followed jointly by European Patent Office (EPO), the Japan Patent Office (JPO) and the United States Patent and Trademark Office (USPTO) as Trilateral-PPH. It helps speedy prosecution and examination of a patent application in one country, if it has been accepted or granted by a country which is part of that agreement. India is also taking steps in order to avail benefits of this concept. The same is evident from the

agreement signed between Japan and India on October 29, 2018, to start a pilot program of Japan-India Patent Prosecution Highway (PPH) in the first quarter of the fiscal year 2019, after making the necessary amendments in the Patent Rules. Implementing Patent Prosecution Highway in India will increase the number of patent filings in India, as it will increase the efficiency and prosecution timeline for patent applications.

- **Indian Patent Office is getting ready to go with the flow of new technologies**

Indian Patent Office, in August 2018, floated a tender inviting Expression of Interest for making use of Artificial Intelligence (AI), Blockchain, Internet of Things (IoT) and other latest technologies in Patent Processing System of IPO. The said tender showed the clear intent of the Controller General to not only consider the expeditious implementation of the procedures but also to adopt the latest technology in order to achieve efficiency and high standards of implementation. To bring in the required changes in the system, a list of bidders has recently been issued by Indian Patent Office on December 26, 2018, qualifying 10 bidders for subsequent stages after EOI for making use of AI, Blockchain, IoT and other latest technologies in Patent Processing System of IPO.

- **NBA opens window to pursue pending issues/matters under the Biological Diversity Act, 2002 (BD Act), for the patent applicants**

To facilitate and enhance implementation of the Act in public interest towards meeting the objectives of the BD Act, namely, conservation of biological diversity, sustainable use and fair and equitable sharing

of benefits from commercial use, the Central Government has directed the Authority to take decisions within a period of 100 days from the date of issuance of this Office Memorandum, including course of action for matters related to past. These directions shall come into force with immediate effect.

- **Instructions regarding WIPO Digital Access Service (DAS) under WIPO India Cooperation**

Pursuant to public notice dated March 12, 2018, regarding availability of WIPO Digital Access Service with effect from January 31, 2018, for priority documents, the following additional instructions are issued for the applicants applying for the priority documents to be supplied to IB through WIPO DAS after filing International Application.

Applicant(s)/ Authorized Agent(s) or Attorney(s) should ensure that the submitted priority documents should only be in PDF with all the fonts embedded with an exclusion for only 7 given fonts (Helvetica, Times, Courier, Symbol, Zapf Dingbats, Arial, Verdana). After receiving the access code, the Applicant(s), Authorized Agent(s) or Attorney(s) should request IB to retrieve the priority document from the DAS portal, in absence of which the priority documents will not be considered as transmitted to IB.

- **Creation of CIPAM to realize objectives of National IPR policy, especially creating awareness**

In order to bridge gap between knowledge creation and lack of awareness to get it protected or commercialized, a lot of awareness programs were conducted pan India in the year 2018. Such programs were conducted by Government organizations,



R&D Institutions, Universities and NRDC in association with Intellectual Property Offices and in collaborations with Industry Associations like FICCI, CII and ASSOCHAM. Funds have been allocated for this purpose through special projects like Cell for IPR Promotion and Management (CIPAM). CIPAM is a professional body under the aegis of Department of Industrial Policy and Promotion (DIPP) which ensures focused action on issues related to IPRs and addresses the seven identified objectives of the National IPR policy. The objectives can be read as under:

- Creating public awareness about the various aspects of IP through various outreach and promotional activities.
- Generation of IPRs by motivating people to avail the various benefits drawn from it.
- Having strong and uniform legal and legislative framework such that objectives of the program are consistent with the priorities of the nation without compromising the rights of IP owners.
- To have effective administration and management of IPR in a manner that can provide the owner with benefits of speedy processing of their applications in a cost-effective way.
- Commercialization of IP rights including IP transactions, valuation, revenue generation, licensing and technology transfer.
- Having effective enforcement and adjudication of IP laws such that issues like IP violations, piracy and counterfeiting can be dealt easily among all sections of society.

- To strengthen and improve human capital development to further create awareness via teaching, training, research and building up skilled people in IP.

○ **Following directions of High Court, importance & relevance of Form 27 for patent holders has been revealed**

The Patent Office, in March 2018, has published comments of stakeholders on bringing amendments to Patent Rules with respect to submission of Form 27 specifying workability of patents in India.

Published comments has brought in a wide range of suggestions and opinions. Suggestions include removal of the working statement requirements altogether, while some opined to remove the time frame in which it needs to be filed, while there were also a few who had the opinion of strengthening the requirements based on Form 27. Nevertheless, the Indian Patent Office has asked for a time period of 12 months to review and take decision in consent with major stakeholders as to what amendments should be brought in with respect to filing of Form 27.

- State of India – Madhya Pradesh (MP) request for ‘Basmati’ GI tag is rejected by the GI Registry

In March 2018, Geographical Indications Registry rejected the plea of MP to include 13 of its districts under GI tag of “Basmati producing areas”. Rejection was based on 2 reasons as stated below:

- Rice grown in MP is distinct and does not match the quality parameters of Basmati rice;

- MP is not popular among people as Basmati producing area.

MP, however, not convinced with the decision has filed a writ petition in the Madras High Court challenging the decision of the Registry.

- **Koninklijke Philips Electronics N.V. (Plaintiff) v Rajesh Bansal and Ors (Defendants)** -*Delhi High Court awards Damages and Cost in addition to Royalty fees in a Standard Essential patent infringement suit.*

Recently, the Delhi High Court, in the matter of Koninklijke Philips Electronics N.V. (Plaintiff) vs. Rajesh Bansal and Ors (Defendants), after duly conducting and concluding a trial in the suit decreed the suit vide order dated July 12, 2018, in favour of the Plaintiff for infringement of its standard essential patent (SEP).

The plaintiff filed a patent application in 1995 in the field of DVD video players, entitled 'Decoding device for converting a modulated signal to a series of M-bit Information Words', which was granted as patent number IN-184753 (Suit Patent) in 2001. The Suit Patent was basically for channel decoding technology used in a DVD video player.

In and around the year 2009, the Plaintiff instituted two suits (which were later consolidated) for infringement of their Suit Patent against the Defendants inter alia seeking reliefs of permanent injunction, delivery, rendition of accounts and damages. The Plaintiff submitted that any party interested in the manufacturing of DVD video players should have licensed all the SEPs of the relevant patent pool, and categorically claimed that the Suit Patent is one such SEP. The Plaintiff further claimed that the DVD video

players manufactured, assembled and sold by the Defendants employed the technology in accordance with the claims of the Suit Patent, and thus, were infringing the Suit Patent. The Defendant's products were held to be infringing as the Suit Patent was a SEP, and thus,, unauthorised use or manufacture of the DVD player incorporating the technology as claimed in the Suit Patent by the Defendants without a license amounts to infringement. Although the Defendants, relying on the doctrine of exhaustion, contended that the major components of the DVD players were procured by the Defendants from authorised licensees, the Defendants failed to prove that such licensees were the licensees of the Plaintiff. Interestingly, apart from tests carried out by the witness of the Plaintiff, there was no reliance on claim construction or claim comparison to arrive at the conclusion of infringement of the Suit Patent.

Although no injunction was granted, considering the Suit Patent expired in 2015, the Plaintiff was allowed to recover royalty at a license fee of USD 3.175 per DVD player manufactured or sold by the Defendants from institution of the lawsuit till May 27, 2010; and USD 1.90 from May 27, 2010 till the expiry of the patent viz. February 12, 2015. The variation in royalty rate was aligned with the changes in the royalty rate charged by the Plaintiff before and after May 2010. Additionally, due to the conduct of the Defendants and the fact that one of the Defendants was an ex-employee of the Plaintiff, punitive damages of INR 500,000 and actual costs including the lawyer's fees, court fees and local commissioner's fees were also granted in the Plaintiff's favour.

This is one of the first matters in which an entire trial in respect of infringement of an SEP was conducted and which resulted in the suit being decreed. While DVD technology may now be obsolete, a full trial on the enforcement of a SEP awarding punitive damages and costs in addition to the license fee even after expiry of the patent is encouraging for innovators/pioneers. However, an opportunity for bringing clarity, at least on the criteria to determine a SEP in India seems to have been lost.

### **C. Highlights in Designs**

Digital India is one of the major objectives of the Government of India. With this objective, Controller General of Patents Designs and Trademarks (CGPDTM) has launched the complete portal for Industrial Designs in India. Earlier through the e-Filing portal one could only e-file the design application; whereas from January 01, 2019, CGPDTM has added more services w.r.t. Industrial Designs in India. Applicants can now file all requisite forms along with respective fee through the e-filing system of Controller General of Patents, Designs & Trademarks.