



INTELLECTUAL PROPERTY SPOTLIGHT

INTRODUCTION

We are pleased to present the latest edition of our IP Law page, sharing important updates, key developments, and practical insights on Intellectual Property, all tailored to help you stay updated in the field of Indian Patent Law.

This edition covers important aspect that the Patentee should not bear the cost of error of Indian Patent Office. Curated by our IPR Law Practice Group, the page is to keep you updated about the latest developments in this dynamic field.

WHO SHOULD BEAR THE COST OF ERROR OF QUASI-JUDICIAL BODY

A Madras High Court's judgement has ruled that an innocent party should not suffer, because of the error of the quasi-judicial body.

Facts

A Patent application was filed on January 01, 2019, in the name of their company and was withdrawn on March 10, 2020. However, inadvertently, the Patent application was published by the Indian Patent Office.

Later, the Patent application with same subject matter was filed by the Applicants in their individual capacity and the First Examination Report (FER) was received citing the previously withdrawn Patent application as prior art D1.

The Appellants in their response submitted that prior art D1

was the previous Patent application that was withdrawn within the stipulated timeframe and shouldn't have been published to put the subject matter of the invention in public domain.

The Patent application was refused by the Indian Patent Office.

Key Legal Interpretation

The Court highlighted a few crucial points:

- 1) The learned Controller before passing the refusal order has not carefully considered the submissions of the Applicant.
- 2) The Court further added that the Patents Act clearly provides that if any request for withdrawal is filed within 15 months of filing the Patent application, such Patent application should not be published by the Indian Patent Office.

Court's Reasoning

The previous Patent application was withdrawn within the time-limit and therefore, the objection of lack of novelty and inventive step in view of prior art D1 is against the principles of natural justice.

Outcome

The Court instructed to remand the matter back to the Indian Patent Office stating that the innocent Patentee should not suffer on account of mistake committed by the quasi-judicial body.

Read more about the judgement here:

<https://indiankanoon.org/doc/147461851/>

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