



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 updates on defining Patent Law under Indian Patents Act.

COURT EMPHASIZES DETAILED REASONING IN PATENT REFUSAL ORDERS

A recent Delhi High Court judgment has reaffirmed the necessity for well-reasoned refusal orders from the Indian Patent Office, even in cases where applicants miss procedural deadlines.

Case Background

- First Examination Report (FER) issued: February 15, 2019
- Response to FER filed: August 13, 2019
- First hearing held: March 29, 2022
- Written submissions filed: May 13, 2022

Subsequent Events

- Second hearing scheduled and held on May 12, 2023
- Appellant requested one-month extension for filing written submissions
- Extension granted until June 17, 2023
- Actual submission filed: July 25, 2023

The Controller refused the application, citing failure to file submissions within the time limit.

Court's Observations and Decision

The Delhi High Court highlighted several crucial points:

1. The refusal was based solely on procedural non-compliance, not on the merits of the case.
2. Such refusals based on procedural deficiencies could significantly impact the appellant's invention.

The Court ruled that:

- The Controller should have issued a detailed order considering the FER response and first hearing submissions, despite the late second hearing submission.
- The matter was remanded to the Assistant Controller of Patents for expeditious decision, preferably within three months.

Key Takeaways

1. Patent Office must issue detailed, well-reasoned orders even if applicants miss procedural deadlines or hearings.
2. Missing a procedural deadline does not automatically invalidate a patent application.
3. The Patent Office is required to consider all available submissions, including FER responses and previous written submissions, when making decisions.

This judgment reinforces the importance of substantive review in patent applications, emphasizing that procedural lapses should not overshadow the merits of an invention in the patent granting process.

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