

Intellectual Property
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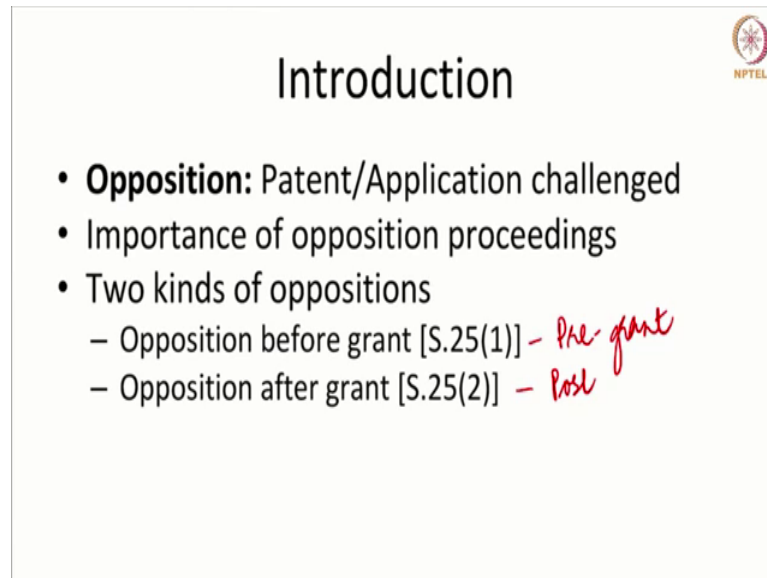
Lecture – 32
Opposition to Patents

Opposition, opposition refers to a process by which a patent application or a granted patent can be opposed on specified grounds and the consequence of an opposition is if successful, it would lead to the rejection of the application or it would lead to the revocation of the granted patent. Now these consequences are different, in the case of an application because the application is still under consideration and no rights have crystallized with regard to that application.

If an application is opposed successfully, it results in the rejection of the application, the application is rejected, whereas, when a patent that is granted is opposed there are already rights that a person can exercise with regard to a granted patent. We saw that the rights under section 48, which gives a patentee, the right holder the right to stop others from making, selling, offering for sale, importing and using can be exercised with regard to a granted patent.

So, when an granted patent is successfully opposed we would say that the patent was revoked based on an opposition. So, this distinction is something which we need to bear in mind. An application that is opposed successfully would lead to the rejection of the application and a patent that is opposed successfully would result in the revocation of the patent, the patent will now be revoked from the records.

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The slide is titled "Introduction" and features the NPTEL logo in the top right corner. It contains a bulleted list of topics related to patent opposition. The list includes: "Opposition: Patent/Application challenged", "Importance of opposition proceedings", and "Two kinds of oppositions". Under "Two kinds of oppositions", there are two sub-points: "Opposition before grant [S.25(1)]" with the handwritten note "- Pre grant" in red, and "Opposition after grant [S.25(2)]" with the handwritten note "- Post" in red.

- **Opposition:** Patent/Application challenged
- Importance of opposition proceedings
- Two kinds of oppositions
 - Opposition before grant [S.25(1)] - *Pre grant*
 - Opposition after grant [S.25(2)] - *Post*

So, opposition can happen either with regard to a granted patent or an application patent application, in both cases the patent or the application is challenged and the opposition happens only before the patent office. There are other procedures like a revocation which can happen before the intellectual property appellate board, a body which takes appeals from the patent office or there are invalidity proceedings say in the form of a counter claim which can be raised before the high court in an infringement suit. So, that would again result in the revocation of a granted patent.


So, the opposition procedure is different because the opposition procedure happens at the patent office. There are some distinct advantages here, because the opposition happens at the patent office and because the patent office is the body that grants patent rights. It is easier to take technical arguments and to prove technical grounds for opposing a patent or for challenging a patent.

Whereas, the intellectual property appellate board or the high court though they may have the assistance of a technical member or they may be able to get scientific advises to advise them, it is not the same as the granting body. The patent office being the granting body, the ability to appreciate technical arguments and to look into records pertaining to the patent are more comprehensive than the appellate bodies like the intellectual property appellate board or the high court.

Opposition proceedings are important because they offer the first chance to raise a challenge for a patent because it happens at the patent office, a pre-grant opposition or an opposition before the grant can be instituted effectively in such a way that the opposition can stall the grant of the patent itself. Now, this is critical when an unjustified patent is about to be granted in instances, where a person needs to quickly challenge a pending application the patent office offers opposition proceedings for doing that.

Countries normally have post grant opposition, but India is an exception which has both post grant as well as pre-grant opposition. So, we have a mechanism by which an application can be opposed as we have mentioned there are 2 types of oppositions and the oppositions are under different provisions, the opposition before the grant is also referred to as pre-grant opposition and the opposition after the grant is also referred to as post grant opposition, now let us look at pre-grant opposition or opposition before the grant.

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Opposition Before Grant

- Nature of pre-grant opposition
 - Summary in nature
 - Not inter-partes proceedings
- Status of opponent
 - Any person can make a representation
- Procedure of pre-grant opposition [R.55(1)]
 - Written representation [F. 7A]
 - Time bound procedure

Now, the nature of the pre-grant opposition is distinct and different from a post grant opposition, we will find that the preceding proceedings are summary in nature summary as an very brief compared to a post grant procedure and pre-grant opposition is not recorded as in inter - partes proceeding. Now inter- partes is a legal terminology which is used when 2 parties are fighting of pitted against each other. Opposition is not a proceeding which is inter- partes though a third party intervenes into the patent office.

An opposition is triggered by a third party the access any person can file an opposition though it is triggered by a third party.

The third party merely supplies information as to why a patent should not be granted and the third party or whom we call a pre-grant opponent raises objections with the evidence showing why a patent should not be granted. Now the preceding is largely between the applicant and the patent office the third party does the job of an friend of the court amicus query he asses the patent office. So, he is a friend of the patent office he asses the patent office or the courts have used the language he aids the examination so, he helps the examination of the patent.

So, in that sense a pre-grant opponent is not regarded as a party and hence pre-grant opposition or opposition before the grant is not regarded as inter- partes proceedings that also bring some detail on the status of the opponent an opponent is a person who can make a representation, but he does not have rights of a party. For instance, the opponent if he fails in the pre-grant opposition does not have a right to appeal.

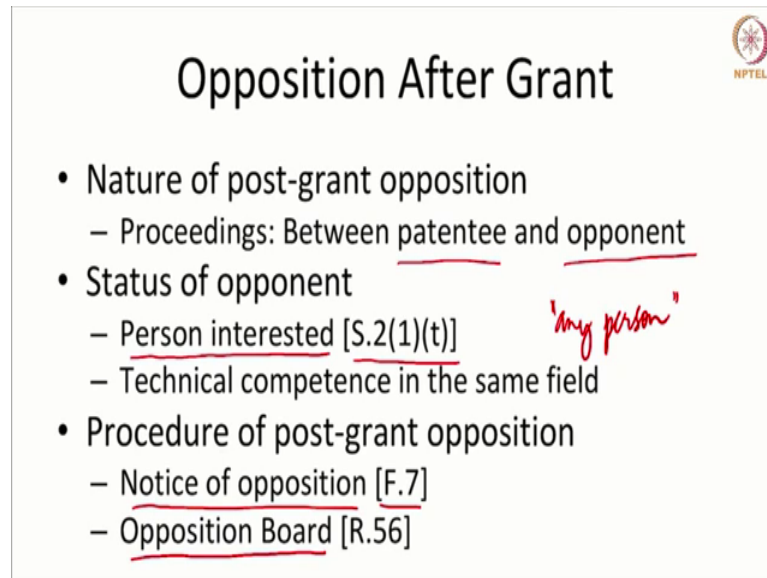
An opponent to fails in the pre-grant opposition after the patent is a granted may file a post grant opposition that is possible but an opponent does not have the right to appeal. Now the right to appeal is normally given to a party. If you litigate in the district court and you are the defendant in a suit and you are not successful in the suit you have a right to appeal to the high court. Now this is an inherent way by which we understand whether somebody is a party to the preceding, the pre-grant opponent does not have this right to appeal, so, we do cannot considered the pregnant opponent has a party to the preceding.

The procedure for pre-grant position is stipulated in rule 55; a written representation has to be submitted. There is a particular form for it now and the procedure is a time bomb procedure. The procedure largely moves in this pattern the pre-grant opponent files his objections along with the evidence the copy of the opposition along with the evidence is sent to the applicant, the applicant gives his response on the opposition and then there is a hearing the hearing occurs before the controller.

The controller can call the applicant, the controller can also call the opponent, if the opponent insists on a hearing the law states that hearing is not automatic a person has to request for a hearing. So, if the opponent has requested for a hearing and the controller would hear the person and then follow it up with a written order. So, there is a written

procedure so, there is a written representation followed by a response by the applicant and both the written representation and the response will have it is evidence, there is a hearing and the hearing is followed by a written order now all these things happen in a time bomb fashion and for this reason we regard pre-grant opposition has a time bound proceeding.

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The slide is titled "Opposition After Grant" and features the NPTEL logo in the top right corner. It contains a bulleted list with several sub-points. The following table summarizes the content of the slide, including handwritten annotations in red:

Category	Sub-point	Handwritten Annotation
• Nature of post-grant opposition	– Proceedings: Between patentee and opponent	
	• Status of opponent	
– Person interested [S.2(1)(t)]		'my person'
	– Technical competence in the same field	
• Procedure of post-grant opposition	– Notice of opposition [F.7]	
	– Opposition Board [R.56]	

When we compare opposition after the grant, we find that the post grant opposition is between 2 parties, what we can call and inter- partes proceeding party one being the patentee against whose patent the opponent files and opposition. Now they have party status because regardless of who succeeds the other party can take up the matter an appeal that is one way for us to understand whether they have party status.

Now one distinguishing feature between the pre-grant and the post grant is that the post grant opposition has to be by a person interested and a person interested is defined under the act has a person who has a research interest it includes a person with a research interest.

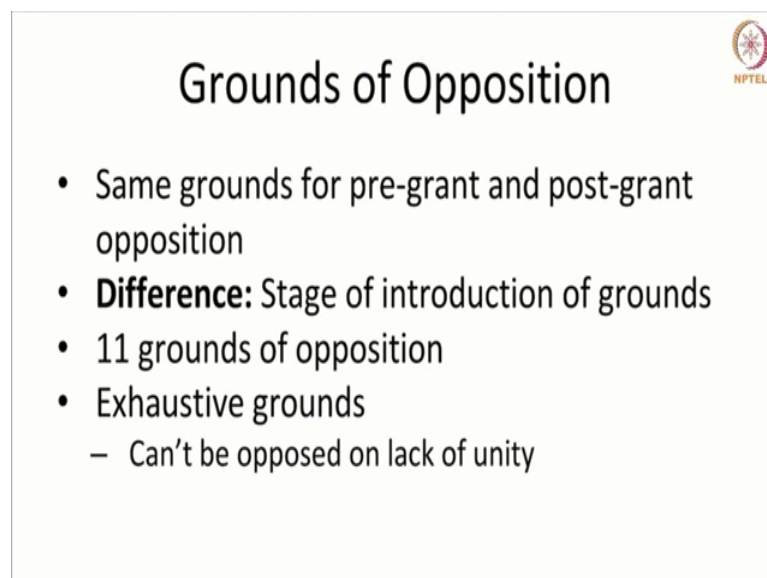
Now, pre-grant opposition on the other hand can be filed by any person. So, this is a difference between pre-grant and post grant opposition. Now this would require a person to have some technical competence in the field so that is why a person interested is defined as a person having your research interest in the act. The procedure is also different from pre-grant opposition, the opponent has to file a notice of opposition there

is a form for that and after the notice of opposition is filed and the reply is received from the patentee and opposition board is constituted. Now there is no opposition board in pre-grant opposition now the opposition board comprises of 3 examiners who have not dealt with the patent before.

So, this is more like in additional review by a different set of examiners, the opposition board submits its report the report is not binding on the controller. The controller is the person who sits and adjudicates the opposition, the controller listens to the parties they can they will be a hearing and they will be prior notice of the hearing and upon the hearing the controller will decide whether to revoke the patent, if there is our grounds for revocation or whether to amend the patent, if the objections are of such a nature that they can be amended or whether to allow the patent to continue which means whether to reject the opposition.

So, the consequences of a pre-grant opposition are either the patent gets granted or the patent application gets rejected. Whereas the post grant opposition they could be 3 consequences, the patent may get revoked, the patent may get amended or the patent may be allowed to continue. So, let us look at the grounds of opposition, the grounds of opposition a common for both pre-grant and post grant opposition.

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The slide is titled "Grounds of Opposition" and features the NPTEL logo in the top right corner. It contains a bulleted list of four main points, with the second point having a sub-point.

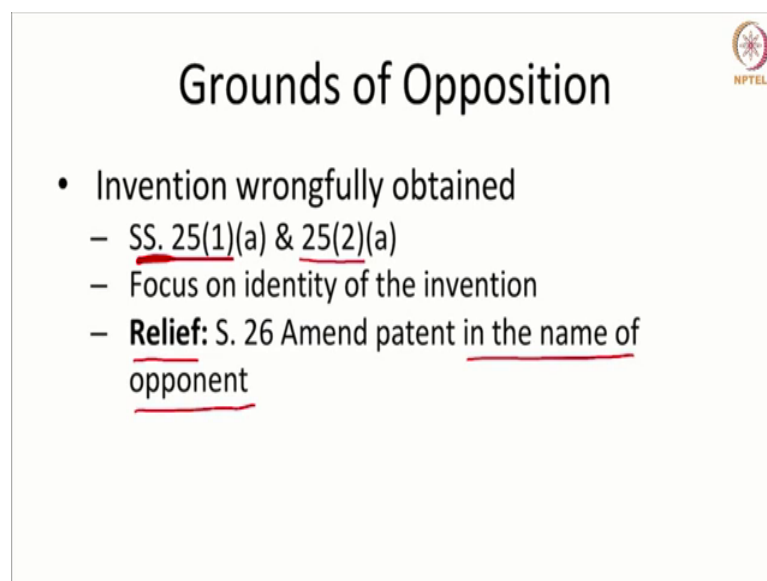
- Same grounds for pre-grant and post-grant opposition
- **Difference:** Stage of introduction of grounds
- 11 grounds of opposition
- Exhaustive grounds
 - Can't be opposed on lack of unity

The only difference is that the stage in which the grounds are introduced in a pre-grant as the word stands the opposition grounds are introduced before the grant of the patent and

in a post grant they are introduced after the patent is granted though these proceedings happen in different points in time the grounds remain the same.

The post grant opposition can be filed one year after the patent is granted. So, there is a timeline for filing the post grant where as a pre-grant opposition can be filed anytime after the patent is published, but before the grant of the patent. There are 11 grounds and the grounds are meant to be exhaustive meaning which you cannot add new grounds of opposition which are not covered in the 11 grounds.

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The slide is titled "Grounds of Opposition" and features the NPTEL logo in the top right corner. It contains a bulleted list of grounds for opposition:

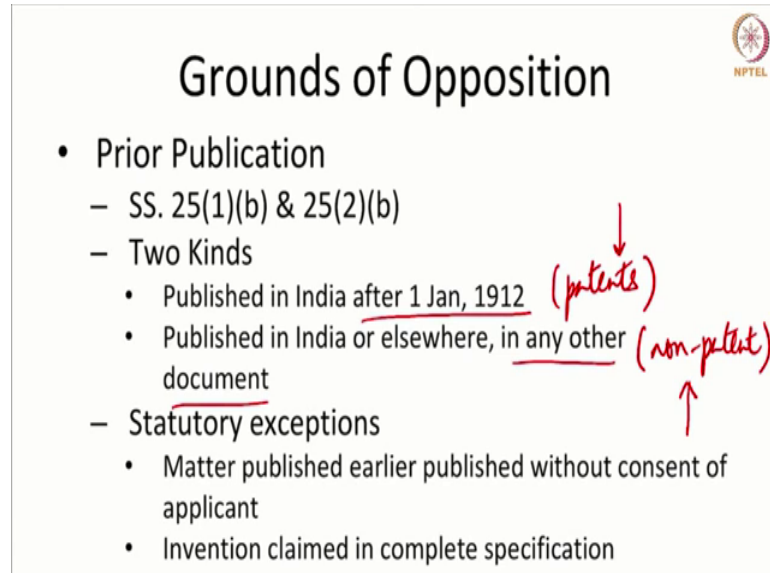
- Invention wrongfully obtained
 - SS. 25(1)(a) & 25(2)(a)
 - Focus on identity of the invention
 - Relief: S. 26 Amend patent in the name of opponent

For instance a patent cannot be opposed for lack of unity, unity is a feature that each application should only cover one invention if there are more than one invention it is not a ground for opposition.

When an invention is wrongfully obtained that can be a ground for revocation, now the ground for revocation in pre-grant is mentioned in 25 1 and the same ground is mentioned in 25 2. Now, this ground has the focus on the identity of the invention, if an invention is claimed by a person, but it was a wrongfully obtained by that person and an application was filed. The person from whom it was wrongfully obtained can file an action an opposition to oppose the patent and as a relief the patent can also be changed to the name of the opponent. So, because the claim here is that the patent was wrongfully obtained the person who was the rightful owner can also request the patent to be

amended in that person's name, now the relief may vary if the person is not interested in having a patent in their name.

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The slide is titled "Grounds of Opposition" and features the NPTEL logo in the top right corner. It lists the following grounds:


- Prior Publication
 - SS. 25(1)(b) & 25(2)(b)
 - Two Kinds
 - Published in India after 1 Jan, 1912 (patents)
 - Published in India or elsewhere, in any other document (non-patent)
 - Statutory exceptions
 - Matter published earlier published without consent of applicant
 - Invention claimed in complete specification

Handwritten annotations in red ink include: a downward arrow pointing to "1 Jan, 1912" with the word "(patents)" written next to it; a downward arrow pointing to "document" with the word "(non-patent)" written next to it; and an upward arrow pointing to "document" from below.

In which case they will ask for a revocation prior publication it is another ground on which a patent can be opposed. There are 2 kinds of prior publication one is published in India before first Jan 1912 that is with regard to a patent application or published in India or elsewhere in any other document. So, this covers 2 kinds of publications, it covers patents and it covers non patent document. Prior publication is an objection of a lack of novelty if the information that is covered in a patent is published before the date of filing the application then it can be a ground for revocation.

If the published information is in a patent there is a provision for that. If the published information is covered in a non patent literature then that could also be a ground for opposition. Now, there are certain statutory exceptions matter published earlier, but published without the consent will be excluded.

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Grounds of Opposition

- Prior Claiming
 - SS. 25(1)(c) & 25(2)(c)
 - Anticipation by application
 - Published in India with earlier priority date
 - **Recourse:** Controller may require amendment or insertion of a reference of earlier claim

The next ground of opposition is prior claiming, again this is a ground which pertains to lack of novelty this is a ground where the anticipation happens by another application, where the application is published in India within earlier priority date. Now one of the things you could ask in this ground is for the controller to require an amendment or an insertion of the reference of the earlier claim. So, reference could be one of the recourse that a person asks. Again a patent cannot be granted if there is an if that invention is claimed earlier, prior claiming refers to a claim made earlier in another patent application.

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Grounds of Opposition


- Prior knowledge or publicly used
 - SS. 25(1)(d) & 25(2)(d)
- Lack of Inventive step
 - SS. 25(1)(e) & 25(2)(e)
 - “Clearly” doesn’t involve any inventive step
- Subject of claim not an invention or not patentable
 - SS. 25(1)(f) & 25(2)(f) ↓ s.3 ↓ s.4

Prior knowledge or public use is another ground; this is again the ground which comes under lack of novelty. So, if there is prior knowledge or public use of an invention then that could be a ground for challenging an application. The patent application can be challenged on the ground that there was prior knowledge or the invention was used publicly.

Lack of inventive step is one of the strongest grounds on which any patent can be opposed. So, this again can be used either before grant or after grant and the provisions are different. Now, inventive step pertains to what is not obvious to a person skilled in the art the invention should involve in inventive step and inventive step is defined as an aspect of the invention which is not obvious to a person skilled in the art.

Another ground for opposition is the fact that the subject matter of the claim is not an invention or it is not patentable now these are exceptions to patentability covered under section 3 and section 4 of the patents act. Now exceptions of patentability we have covered this it is a long list of things that cannot be granted a patent, atomic energy inventions cannot be granted a patent under section 4. So, if you need to oppose a pending application or a granted patent sighting one of those provisions under section 3 or under section 4 then these are the grounds that you will use section 25 1 f or section 25 2 f.

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Grounds of Opposition

- Insufficiency
 - SS. 25(1)(g) & 25(2)(g)
 - Sufficiently and clearly describe the invention
 - Method of performing
- Non-disclosure of information
 - SS. 25(1)(h) & 25(2)(h)
 - Failure to disclose information under S.8


Insufficiency is also a ground for opposition, now there is a requirement under the law that the patent specification shall sufficiently and clearly describe the invention. Description of the invention is a requirement for the grant of a patent if the patent does not clearly describe the invention then the patentee has not performed his part of the bargain, but the grant of patent is a bargain where in lieu of the disclosure that the patentee makes the long efforts in a 20 year exclusive right over his invention. So, if the description is not clear or it is not sufficient to enable a person skilled in the art to make the invention that can be a ground for revocation.

So, this is an internal ground the description of the invention in the complete specification has to be of such a nature that it can allow others skilled in the art to come up with the invention so, the method of performing should be clear and distinct. Another ground for revocation is non-disclosure of information there are certain information that the patent office requires from the applicant.

If the applicant does not disclose that information or does not keep the patent office informed with regard to that information that can be a ground for opposition, now section 8 of the patents act requires an applicant to inform to keep the patent office informed of applications that the person is filed in other patent office's which are similar to the application filed in the Indian patent office.

This requirement is more of a nature to keep the patent office informed of what is happening in other patent offices for instance if an application is filed in India and similar applications for the same invention are filed in Japan, China and the United States and if Japan and the United States rejects the application for whatever reason, then the Indian patent office would like to know that those applications were rejected and it causes a duty on the applicant to inform the patent office about those objections. So, here is an obligation casted on the applicant to keep the Indian patent office informed as to what is happening in other patent offices pertaining to the same invention.

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Grounds of Opposition


- False claim to convention priority
 - SS. 25(1)(i) & 25(2)(i)
 - Two grounds
 - Time barred convention application
 - Basic application not a convention application
- Non disclosure of biological material
 - SS. 25(1)(i) & 25(2)(i)

So, non disclosure of information is a ground for challenging a patent never ground for challenging a patent under opposition is when a person claims or a falsely claims convention priority. Now convention priority is the 12 month period within which after you file basic application in a convention country you can enter any convention country within 12 months.

So, there is a timeline where in you can claim the convention priority, now if the convention priority is falsely claimed meaning which one you file an application in a convention country, but you do not enter within the 12 months in the other convention country. So, you have not kept the 12 month period you have not entered within the 12 month period or you seek priority from a country which is not a convention country.

So, this refers to a false claim to convention priority. So, it covers time, but convention applications and it also cover situation where the basic application is not a convention application. Non disclosure of biological material is again a ground for opposition, the an applicant who uses a biological material is duty bound to disclose the biological material if that is not done it can be a ground for opposing a patent.

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Grounds of Opposition

- Anticipation by traditional knowledge
 - SS. 25(1)(k) & 25(2)(k)
 - Knowledge within local or indigenous community
 - Proved by oral or documentary evidence

And finally, anticipation by traditional knowledge, if something is within the knowledge of a local or indigenous community and it can be proved by oral or documentary evidence then there can be a ground for objecting a patent. A patent can be opposed if the invention is known or anticipated by traditional knowledge.