

**IN THE HIGH COURT OF DELHI AT NEW DELHI**

Reserved on: 29<sup>th</sup> April and 3<sup>rd</sup> June, 2010  
Decision on: 15<sup>th</sup> July, 2010

**W.P. (C) No. 3516 of 2007**

DR. (Miss) SNEHLATA C. GUPTE ..... Petitioner  
Through: Mr. Pravin Anand and Mr. J. Sagar  
with Mr. Sagar Chandra, Advocates.

versus

UNION OF INDIA & ORS. .... Respondents  
Through: Mr. Ruchir Mishra with  
Mr. Rahul Jain, Advocates for R-1 to R-4.  
Ms. Pratibha M. Singh, Advocate for R-5.

**W.P. (C) No. 3517 of 2007**

DR. (Miss) SNEHLATA C. GUPTE ..... Petitioner  
Through: Mr. Pravin Anand and Mr. J. Sagar  
with Mr. Sagar Chandra, Advocates.

versus

UNION OF INDIA & ORS. .... Respondents  
Through: Mr. Ruchir Mishra with  
Mr. Rahul Jain, Advocates for R-1 to R-4.  
Ms. Pratibha M. Singh, Advocate for R-5.

**W.P. (C) No. 5422 of 2007**

DR. GIRISH J. RINDANI ..... Petitioner  
Through: Mr. Pravin Anand and Mr. J. Sagar  
with Mr. Sagar Chandra, Advocates.

versus

UNION OF INDIA & ORS. .... Respondents  
Through: Mr. Ruchir Mishra with  
Mr. Rahul Jain, Advocates for R-1 to R-4.  
Ms. Pratibha M. Singh, Advocate for R-5.

**W.P. (C) No. 5423 of 2007**

DR. (Miss) SNEHLATA C. GUPTE ..... Petitioner  
Through: Mr. Pravin Anand and Mr. J. Sagar  
with Mr. Sagar Chandra, Advocates.

*W.P.(C) Nos. 3516, 3517, 5422, 5423 of 2007 & 10399, 10400 & 10450 of 2009 & 1020 of 2010*

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a  
 versus

UNION OF INDIA & ORS. .... Respondents  
 Through: Mr. Ruchir Mishra with  
 Mr. Rahul Jain, Advocates for R-1 to R-4.  
 Ms. Pratibha M. Singh, Advocate for R-5.

b

**W.P. (C) No. 10399 of 2009**

ZEPHYR BIOMEDICALS .... Petitioner  
 Through: Mr. Sanjeev Kumar Tiwari,  
 Advocate.

c

versus

LALIT MAHAJAN & ANR. .... Respondents  
 Through: Mr. Maninder Singh, Senior  
 Advocate with  
 Ms. Saya Chaudhary and  
 Mr. Jaspreet Singh, Advocate for R-1.  
 Mr. A.S. Chandhiok, ASG with  
 Mr. Jatan Singh, CGSC for R-2.

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**W.P. (C) No. 10400 of 2009**

ZEPHYR BIOMEDICALS .... Petitioner  
 Through: Mr. Sanjeev Kumar Tiwari,  
 Advocate.

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versus

LALIT MAHAJAN & ANR. .... Respondents  
 Through: Ms. Saya Chaudhary and  
 Mr. Jaspreet Singh, Advocate for R-1.  
 Mr. A.S. Chandhiok, ASG with  
 Mr. Jatan Singh, CGSC for R-2.

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**W.P. (C) No. 10450 of 2009**

ZEPHYR BIOMEDICALS .... Petitioner  
 Through: Mr. Sanjeev Kumar Tiwari,  
 Advocate.

versus

LALIT MAHAJAN & ANR. .... Respondents  
 Through: Mr. Maninder Singh, Senior  
 Advocate with Ms. Saya Chaudhary and Mr.

*W.P.(C) Nos. 3516, 3517, 5422, 5423 of 2007 & 10399, 10400 & 10450 of 2009 & 1020 of 2010*

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a

Jaspreet Singh, Advocate for R-1.  
Mr. A.S. Chandhiok, ASG with Mr. Jatan  
Singh, Advocate for R-2.

**AND**

b

**W.P. (C) No. 1020 of 2010**

TIBOTEC PHARMACEUTICALS ..... Petitioner  
Through: Mr. Rajiv Nayyar and Mr. Sudhir  
Nandrajog, Senior Advocates with Mr. Pragyan  
Pradip Sharma and Mr. Rupesh Gupta,  
Advocates.

c

versus

THE ASSISTANT CONTROLLER OF PATENTS,  
DESIGNS & TRADE MARKS & ORS. .... Respondents  
Through: Mr. A.K. Bhardwaj with  
Ms. Jagrati Singh, Advocates for R-1 & R-2.  
Mr. S. Majumdar with  
Mr. Saurabh Banerjee, Advocate for R-3.

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**CORAM: JUSTICE S. MURALIDHAR**

1. Whether reporters of local paper may be allowed  
to see the judgment? Yes
2. To be referred to the reporter or not? Yes
3. Whether the judgment should be referred in the digest? Yes

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**J U D G M E N T**

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1. The short but interesting question of law common to all these petitions: When can a patent be said to be granted under the Patents Act, 1970 ('Act')? The question arises in the context of the dismissal of pre-grant oppositions by the Controller of Patents ('Controller') on the ground that they were time-barred under Section 21 of the Act.

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2. The factual background in each set of petitions is necessary to be set out in order to appreciate how the question arises for determination in

*W.P.(C) Nos. 3516, 3517, 5422, 5423 of 2007 & 10399, 10400 & 10450 of 2009 & 1020 of 2010*

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a each of them.

***Writ Petition (C) Nos. 3516, 3517, 5422 and 5423 of 2007 (1<sup>st</sup> Set of Petitions)***

b 3. J. Mitra & Company Respondent No.5 in W.P. (C) No. 3516 of 2007  
c filed two patent Application Nos. 590/Del/2000 and 593/Del/2000 in the  
Office of the Controller on 14<sup>th</sup> June 2000. The patent specifications  
involved in the two applications were published in the official gazette on  
d 20<sup>th</sup> November 2004 in terms of Section 11A of the Act. At that stage,  
Section 25 of the Act had not been amended. Under Section 25 of the  
pre-amended Act, an opposition to the grant of patent had to be filed  
e within four months from that day i.e., the date of advertisement  
(publication) which period could be extended by one month upon the  
Controller being satisfied by the reasons given for such delay.

f 4. Span Diagnostics Ltd. ('SDL') filed a pre-grant opposition which  
came to be rejected by the Controller on 23<sup>rd</sup> August 2006. The  
operative portion of the order passed by the Controller reads as under:

g "In view of the above discussion and in consideration  
of the submissions of both the parties. I hereby order  
to grant [Patent No. 194639] on Patent Application No.  
h 590/Del/2000 with the following condition:

The Applicants shall give cross reference to the patent  
application no. 593/Del/2000 on page 2 of the  
complete specification and submit the  
amended/retyped page(s) within a week from the date  
of these order. The Opposition on Patent Application  
No. 590/Del/2000 (194639) is disposed of in above

***W.P.(C) Nos. 3516, 3517,5422, 5423 of 2007 & 10399, 10400 & 10450 of 2009 & 1020 of 2010***

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a terms. No order to cost.”

b 5. In terms of Section 43 of the Act, where the application for a patent  
has been found to be in order for grant of patent and if the application  
c has either not been refused by the Controller or has not been found in  
contravention of the Act, the patent shall be granted as expeditiously as  
possible “with the seal of the patent office and the date on which the  
d patent is granted shall be entered in the Register”. Under Section 43(2),  
upon the grant of patent, the Controller “shall publish the fact that the  
patent has been granted and thereupon the application, specification and  
e other documents related thereto shall be open for public inspection”.  
Under Rule 55(5) of the Patents Rules 2003 (‘Rules’), the Controller will  
examine the statement and evidence filed by the applicant (for the grant  
f of patent) and may either refuse to grant the patent or require the  
complete specification to be amended to his satisfaction before the patent  
is granted. Under Rule 55 (6), the Controller shall, after considering the  
g representation (i.e. the pre-grant opposition, if any) and submissions  
made during the hearing if so requested, “proceed further simultaneously  
either rejecting the representation and granting the patent or accepting  
h the representation and refusing the grant of patent on that application,  
ordinarily within one month from the completion of the above  
proceedings”.

6. It is the case of the Respondent No.5 J. Mitra & Co. that when on 23<sup>rd</sup>  
August 2006 the Controller rejected the pre-grant opposition filed by

a SDL and in fact in the order used the words “I hereby order to grant  
patent...”, this was simultaneous with the rejection of the pre-grant  
opposition in terms of Rule 55(6) of the Rules and, therefore, 23<sup>rd</sup> August  
b 2006 was the date on which the patent was granted to J. Mitra &  
Company.

c 7. On the very next day, i.e. 24<sup>th</sup> August 2006 Dr. Snehlata Gupte, the  
Petitioner in W.P. (C) No. 3516 of 2007, filed a pre-grant opposition *vis-*  
d *a-vis* Patent No. 194639 filed by J. Mitra & Co. According to Dr. Gupte,  
in terms of the amendments introduced in Section 25(1) of the Act by  
e way of the Patents (Amendment) Act, 2005 with effect from 1<sup>st</sup> January  
2005, the time period for filing a pre-grant opposition stood extended till  
the grant of the patent. According to the Petitioner, the patent was not  
granted till such time it was not sealed and entered in the Register in  
f terms of Section 43(1) of the Act. It is stated that as on the date of the  
filing of the pre-grant opposition by Dr. Gupte, i.e. 24<sup>th</sup> August 2006, the  
patent in favour of J. Mitra & Company had not been granted since it had  
g not yet been sealed and entered in the Register.

h 8. On 5<sup>th</sup> September 2006, Dr. Girish Rindani, the Petitioner in Writ  
Petition (C) No. 5422 of 2007 filed a pre-grant opposition *vis-à-vis* the  
patent application of J.Mitra & Co..

9. It is not in dispute that the Patent No. 194638 granted to J. Mitra &  
Company was entered in the Register on 22<sup>nd</sup> September 2006. Patent

a No. 194639 granted to it was entered in the Register on 27<sup>th</sup> September  
2006. Certified copies of the relevant entries in the Register have been  
placed on record. In terms of Section 43(2) of the Act, the said two  
b petitions of J. Mitra & Company were published in the Journal of the  
Patent Office dated 17<sup>th</sup> November 2006.

c 10. On 16<sup>th</sup> October 2006, the pre-grant opposition of both Petitioners  
were rejected by the Controller on the ground of maintainability. This  
was done, however, without affording the two Petitioners an opportunity  
d of being heard. On 31<sup>st</sup> October 2006, both Petitioners wrote to the  
Controller seeking a hearing before rejection of the pre-grant  
e oppositions. On 23<sup>rd</sup> January 2007, the Controller granted the Petitioners  
a hearing. Thereafter on 30<sup>th</sup> April 2007 and 3<sup>rd</sup> May 2007, written  
statements were filed and submissions were advanced by both the  
f Petitioners before the Controller.

g 11. Writ Petition (C) Nos. 3516 and 3517 of 2007 were filed by Dr.  
Snehlata Gupte challenging the order dated 16<sup>th</sup> October 2006 with  
reference to the Patent No. 194639 and 194638 respectively. On 22<sup>nd</sup>  
h May 2007, the Controller passed fresh orders rejecting the pre-grant  
oppositions of the Petitioners on the ground that the oppositions were  
time-barred. Both Petitioners i.e. Dr. Rindani and Dr. Gupte challenged  
the said order dated 22<sup>nd</sup> May 2007 by filing Writ Petition (C) Nos. 5422  
and 5423 of 2007 respectively.

a 12. The above petitions have been resisted by Respondent No. 5 J. Mitra  
& Co. It is contended that the order of the Controller was consistent with  
the correct position in law. According to Respondent No.5, the filing of  
b the two pre-grant oppositions by Dr. Gupte and Dr. Rindani was also an  
abuse of the process of law. It is alleged by J. Mitra & Co. that SDL,  
which is in the business of sale and purchase of various pharmaceuticals  
c products, is a habitual infringer and is deliberately and consciously  
violating various intellectual properties of J. Mitra & Co. SDL is alleged  
to be continuing to infringe the rights of Respondent No.5 with impunity.  
d It is contended that each and every product in respect of which J. Mitra  
& Co. has applied for and/or has been granted a patent is either being  
opposed or infringed by SDL.  
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f 13. Patent No. 194368 is for an invention titled "A Device for the  
detection of antibodies of Hepatitis C virus in human serum and plasma".  
Patent No. 194639 is for an invention titled "A device for the detection  
of Hepatitis C virus". After the grant of the aforementioned patents in its  
g favour, J. Mitra & Co. filed Civil Suit (OS) No. 22020 of 2006 in this  
Court against Kesar Medicaments (KM) and SDL for patent  
infringement. By a judgment dated 22<sup>nd</sup> February 2008, this Court  
h granted an injunction restraining KM and SDL from manufacturing,  
selling, offering for sale their HCV Signal or any other product which  
was in infringement of J. Mitra & Co's Patent No. 194638. It is stated  
that in the said suit SDL has filed a counter claim for revocation of the  
patent.



a ***Submissions of Counsel in the 1<sup>st</sup> Set of petitions [W.P. (C) No. 3516 of 2007 etc.]***

b 14. Appearing for J. Mitra & Co., Ms.Pratibha Singh, learned counsel,  
submitted that both Dr. Snehlata Gupte and Dr. Rindani are connected to  
c SDL. Dr. Gupte is stated to be running the Surat Raktadan Kendra, the  
Chairman of which is Mr. Pradeep K. Desai who is the  
Chairman/Managing Director of SDL. It is stated that Dr. Gupte was  
d aware of SDL's opposition to J. Mitra & Co's patents. Ms. Singh pointed  
out that upon the said pre-grant opposition being rejected on 23<sup>rd</sup> August  
2006 the patent had to proceed for registration. However, to continue the  
serial oppositions, first Dr.Gupte filed a pre-grant opposition on the very  
e next day i.e. 24<sup>th</sup> August 2006. Dr. Rindani, who is also stated to be  
connected to SDL, filed a separate pre-grant opposition on 5<sup>th</sup> September  
2006. It is submitted that the filing of serial oppositions by persons  
f connected to SDL after its pre-grant opposition had been rejected was  
malafide and if such applications were permitted to be entertained, there  
would be no end to the filing of such pre-grant oppositions particularly  
g since after the amendment to Section 25(1) in 2005, a pre-grant  
opposition can be filed by 'any person'. It is submitted that if the stand  
of the Petitioners is accepted, it would defeat the objective of the Act  
h which is to grant a patent rather than refusing it.

15. Ms. Singh pointed out that in the rejoinder to its counter affidavit, the  
Petitioners do not deny that Dr. Gupte is connected to SDL. It is only  
stated that such averments are misleading "and that they have no bearing  
on the present case". It is further pointed out that the petitioners contend

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a in the rejoinder that “it is immaterial for the purposes of the present writ  
petition whether a person who files a pre-grant opposition is recorded to  
or not recorded who is interested in the concerned patent being opposed”.

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16. Referring to the decision in *K.D. Sharma (2008) 12 SCC 481*,  
Ms.Singh submitted that the Petitioners have, by not disclosing their  
relationship with SDL, not come to the Court with clean hands and,  
therefore are disentitled to the reliefs prayed for in the writ petitions.  
Referring to the decisions in *Bhagwanji Vishavji Thakkar v.*  
*Pravinchandra Jivanbhai Patadia (1995) 2 GLR 1438* and  
*Entertainment Network (India) Ltd. v. Super Cassette Industries Ltd.*  
*(2008) 13 SCC 30* it is submitted that a purposive construction would  
have to be adopted and it has to be held that in terms of Rule 55 (6) of  
the Rules read with Section 43 (1) of the Act the patent is granted once  
an order to that effect is passed by the Controller simultaneous with the  
rejection of the first set of pre-grant oppositions which are decided by the  
Controller. It is submitted that there has to be an outer time limit for  
filing a pre-grant opposition which in any event cannot be beyond the  
date of the Controller passing an order on file granting the patent. The  
sealing and entering of the patent in the Register are mere ministerial acts  
which make no difference to the date of the grant of the patent.

17. Ms. Singh refers to an order dated 2<sup>nd</sup> March 2009 passed by the  
Supreme Court in SLP (Civil) No. 3522 of 2009 (*Indian Network For*  
*People with HIV/Aids v. F. Hoffmann-La Roche AG*) which arose from

*W.P.(C) Nos. 3516, 3517, 5422, 5423 of 2007 & 10399, 10400 & 10450 of 2009 & 1020 of 2010*

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a an order dated 30<sup>th</sup> January 2009 passed by the Assistant Controller of  
Patents. This was heard with SLP (Civil) No. 29857 of 2008 filed against  
b the judgment dated 2<sup>nd</sup> December 2008 of the Madras High Court  
reported as *Indian Network For People with HIV/Aids v. F. Hoffmann-  
La Roche AG MIPR 2009 (2) 0036*. By the said judgment the Madras  
c High Court set aside an order granting Roche a patent without disposing  
of the pre-grant oppositions filed by the Indian Network for People with  
HIV/Aids under Section 25(1) of the Act. Thereafter by an order dated  
d 30<sup>th</sup> January 2009, the Assistant Controller rejected the pre-grant  
opposition. The Supreme Court, without going into the merits of the  
contentions that the Petitioners were deprived of an opportunity of  
e raising before the Controller numerous contentions on merits, observed  
that they could be given permission to file an affidavit and raise all  
contentions at the stage of post-grant oppositions which had already been  
f filed and were pending before the Controller. On the strength of the  
above order, it is submitted by learned counsel for J. Mitra & Co. that  
SDL itself could file post-grant opposition before the Controller and,  
g therefore, no prejudice was caused by the grant of patent to the  
Respondent No. 5 by the order dated 23<sup>rd</sup> August 2006. In any event,  
SDL has also filed a counter-claim in the suit seeking revocation of the  
h patent.

18. Mr. Pravin Anand and Mr. J. Sagar, learned counsel for Dr. Gupte  
and Dr. Rindani, on the other hand, pointed out to the plea raised in the  
plaint in C.S. (OS) No.2020 of 2006 filed by the Respondent No.5 J.

a Mitra & Co. there is a clear admission to the effect that the patent had  
been granted on 22<sup>nd</sup> September 2006. This was therefore the  
understanding of J.Mitra & Co. itself.

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19. Learned counsel for the Petitioners also attacked the bonafides of J.  
Mitra & Co. alleging that it was an infringer which had applied for and  
obtained a plethora of patents which were in fact copies of patents and  
products available worldwide and in India. It is submitted that the two  
patents in question relate to a third and fourth generation device for the  
detection of HCV antibodies in the human serum and plasma. Both the  
patents were imitations of a patent obtained by a US company, EY  
Laboratories, in 1991. However, since EY Laboratories did not have a  
patent in India, proceedings could not be instituted against J. Mitra & Co.  
for infringement.

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20. It is submitted by learned counsel for the petitioners that all claims of  
J. Mitra & Co. filed in the United States Patent Office had been rejected  
on the grounds of obviousness and insufficiency. It is pointed out by Mr.  
Anand that Respondent No. 5 had originally applied for the patents in  
question with 14 claims followed by reduction of claims to 7 after which  
the patent was published for opposition with the said 7 claims. When the  
patent was granted on 22<sup>nd</sup> September 2006, it was granted for 4 claims.  
Claim 1 of the 4 claims is stated to be different from the published Claim  
1. Even after acknowledging this to be a mistake in its order dated 23<sup>rd</sup>  
August 2006, the Patent Office has not published the claims for

a opposition. It is stated that after the order dated 23<sup>rd</sup> August 2006, the  
patent office was under obligation not to grant the patent within three  
months of the statutory period of appeal so that an aggrieved party could  
b file an appeal. It is alleged that the entire process of grant of patent was  
done in a quick and clandestine manner so that no one would know about  
the same.

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21. It is submitted by Mr. Anand that the diagnostics kit industry is a  
very small and close knit and “everyone knows everyone in this field”.  
d Claiming to be among the leading scientists in their field, the Petitioners  
state that “it is not only their duty but also their responsibility to ensure  
e that no unscrupulous trader usurps rights of other parties or malafidely  
stops other parties involved in this field.” It is submitted that the  
intention of the Petitioners is “not to stall the grant of patents but to try  
f and ensure that no wrongful patents are granted to unscrupulous traders  
in the interest of the public”. It is submitted that a patent is a complete  
monopolistic right and should be granted only after due consideration. It  
g is for this reason that the legislature has built in various safeguards like  
pre-grant opposition, post-grant opposition, revocations, counter-claim  
for revocations and defences of revocation in a suit for infringement. It  
h is stated that the words of the statute are clear and till such time the grant  
of the patent is made known by the publication in the official gazette, it  
cannot be said to have been granted in law. It is also pointed out that the  
interpretation canvassed by counsel for respondent No.5 was contrary to  
the current practice of the Controller’s office and would lead to a great

a deal of avoidable confusion.

***Writ Petition (C) Nos. 10399, 10400 and 10450 of 2009 [2<sup>nd</sup> set of petitions]***

b 22. The relevant facts are that Lalit Mahajan Respondent No.1 in all the  
c above writ petitions filed three patent applications for grant of patents  
d being Application Nos. 1688/Del/2007, 1689/Del/2007 on 8<sup>th</sup> August  
e 2007. In Application No. 1688 of 2007, the invention related to a device  
f for analysing the presence of Dengue IgG antibodies in human serum  
g and plasma. Application No. 1689 of 2007 related to the invention of a  
h kit for analysing the presence of dengue IgM antibodies in the human  
serum or plasma. Lalit Mahajan also filed two other applications being  
74/Del/2005 and 75/Del/2005 on 12<sup>th</sup> January 2005 in relation to a Pan  
Malaria Stix and a Tetra Malaria Stix respectively for testing of malaria.

f 23. Lalit Mahajan's Application No. 1688/Del/2007 was published in the  
g Journal on 31<sup>st</sup> August 2007. The patent was granted and was also sealed  
h on 16<sup>th</sup> October 2008. A pre-grant opposition was filed by the petitioner  
Zephyr Biomedicals ('Zephyr') on 12<sup>th</sup> December 2008. The pre-grant  
opposition was rejected on 4<sup>th</sup> March 2009. This order was challenged by  
Zephyr in Writ Petition (C) No. 10399 of 2009.

24. Lalit Mahajan's Application No. 1689/Del/2007 was published on 7<sup>th</sup>  
September 2007. The patent was granted and sealed on 16<sup>th</sup> October  
2008. The pre-grant opposition was filed by Zephyr on 12<sup>th</sup> December  
2008. It was rejected on 4<sup>th</sup> March 2009. This order was challenged by

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a Zephyr in Writ Petition (C) No. 10400 of 2009.

b 25. Lalit Mahajan's Applications No. 74/Del/2005 and 75/Del/2005 were  
published on 2<sup>nd</sup> June 2006. The patent was granted and sealed on 16<sup>th</sup>  
c October 2008. The pre-grant opposition was filed by Zephyr on 28<sup>th</sup>  
November 2008. It was rejected by the Controller on 16<sup>th</sup> March 2009.  
This order was challenged by Zephyr by filing Writ Petition (C) No.  
10450 of 2009.

d *Submissions in the 2<sup>nd</sup> Set of petitions (by Zephyr)*

e 26. The arguments advanced by Mr. Sanjeev Kumar Tiwari, learned  
counsel appearing for Zephyr against the orders of the Controller  
rejecting its pre-grant application on the ground of limitation were more  
or less similar to the arguments advanced by counsel appearing for Dr.  
f Snehlata Gupte and Dr. Girish Rindani in relation to the patents granted  
to J. Mitra & Co.

g 27. In resisting the petitions, it was submitted by Mr. Maninder Singh,  
learned Senior counsel appearing for Lalit Mahajan that after the  
Amendment to the Act in 2005, the time period for filing a pre-grant  
h opposition may have been removed but a reasonable interpretation has to  
be given to the amended Section 25 keeping in view the context. He  
places emphasis on the words "unless the context otherwise requires"  
occurring in the opening portion of Section 2 (1) of the Act and submits  
that the locus to challenge a patent that has been granted gets restricted to

a a person interested. He submitted that considering that the grant of a  
patent is a recognition of the creative work of the inventor, and has to  
pass a fairly rigorous examination procedure through several stages  
b which by its very nature is time consuming, a reasonable period as  
opposed to an indefinite open-ended period has to be given for the filing  
of a pre-grant opposition, which is by any person.

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28. Mr. Maninder Singh pointed out that the scheme of the Act and the  
Rules indicated that the several acts leading to the grant of the patent  
d certificate were to be performed within specific time periods. Referring  
to Rule 74 (2) of the Rules he submitted that a patent certificate is to be  
ordinarily issued within seven days from the date of grant of patent under  
e Section 43. Under Rule 24, the period for which an application for patent  
shall not ordinarily be open to public under Section 11A(1) shall be 18  
f months from the date of filing of application or the date of priority of  
application, whichever is earlier. In terms of Rule 24-B (1)(i) a request  
for examination under Section 11B of the Act is made within 48 months  
g from the date of priority of the application or from the date of filing of  
the application whichever is earlier. Under Rule 24-B(2) (i), the period  
within which the Controller shall refer the application and specification  
h and other documents to the Examiner where such request for  
examination has been made shall ordinarily be within one month from  
the date of its publication or within one month from the date of  
examination, whichever is later. Under Rule 24-B (2)(ii), the Examiner  
should ordinarily submit the report within one month but not exceeding



a three months from the date of reference and thereafter the Controller  
should, in accordance with Rule 24-B (2)(iii), dispose of the report  
within one month of its receipt. Under Rule 24-B (3), the first  
b examination report is sent to the applicant within six months from the  
date of request for examination or publication whichever is later and  
under Rule 24-B (4), the time for putting an application in order for grant  
c under Section 21 shall be twelve months from the date on which the first  
statement of objection is issued to the applicant to comply with the  
requirements. It is submitted that given the specified time limits  
d prescribed at the stage of scrutiny of the applications for grant of patent  
and given the fact that the grant of a patent relates back to the date on  
which the application is filed, the patentee actually loses much of this  
e period for working the patent. Given the fact that an application for  
grant of patent can get published only after a period of 18 months and  
f that the Controller cannot take up the application for examination for a  
period of six months after its publication, it is necessary to read a  
reasonable time limit for filing a pre-grant opposition. Reference is made  
g to the decisions in *Surjit Singh Kalra v. Union of India (1991) 2 SCC*  
*87* and *Directorate of Enforcement v. Deepak Mahajan AIR 1994 SC*  
*1775*.

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***Writ Petition (C) No. 1020 of 2010***

29. The petitioner Tibotec Pharmaceuticals ('Tibotec') filed its application for grant of patent on 11<sup>th</sup> June 2004 for an invention titled 'Combination of Cytochrome P<sub>450</sub> Dependent Protease Inhibitors'. The

a first examination report was issued on 14<sup>th</sup> March 2007. The application  
was published on 30<sup>th</sup> November 2007 in terms of Section 11A of the  
Act. After considering the response of the Petitioner in reply to the first  
b examination report, the Controller issued a letter to the Petitioner on 28<sup>th</sup>  
March 2008 to the following effect:

c “Your above Application for patent has been found  
in order for grant. However, the Patent Certificate  
will be issued only after processing of the  
Application under Section 11(a) [*sic 11A*] and  
d completion of the statutory limit and disposal of  
pre-grant opposition, if any, under Section 25(1) of  
the Act.”

e 30. The petitioner’s case is that on 30<sup>th</sup> May 2008, the mandatory period  
of six months in terms of Rule 55(1-A) of the Rules and the three  
conditions in the aforementioned letter stood satisfied. According to the  
f Petitioner, the patent was deemed to have been granted from such date.

g 31. On 26<sup>th</sup> June 2008, Cipla Ltd. filed a pre-grant representation/  
opposition. This was notified to the Petitioner from the Delhi Office of  
the Controller. The Petitioner, by its letter dated 21<sup>st</sup> October 2008,  
pointed out to the Controller that the pre-grant opposition was time-  
h barred. The Petitioner also filed an interlocutory petition dated 10<sup>th</sup>  
November 2008 praying for issuance of a patent certificate in its favour  
and for rejecting the opposition filed by Cipla Ltd. Thereafter the  
Petitioner also filed an affidavit of evidence on 7<sup>th</sup> January 2009 of one  
Professor David John Back.

a 32. The Petitioner and Cipla Ltd. were heard by the Assistant Controller  
of Patents on 9<sup>th</sup> January 2009 and written submissions were filed by  
them on 27<sup>th</sup> March 2009. By an order dated 30<sup>th</sup> March 2009, the  
b Assistant Controller allowed the pre-grant opposition and refused to the  
Petitioner the grant of the patent on the ground of lack of inventive step.  
The Controller's order dated 30<sup>th</sup> March 2009 has been challenged by  
c Tibotec in this petition. Among the grounds raised in this petition is that  
the pre-grant opposition filed after 30<sup>th</sup> May 2008 was not maintainable.

d ***Submissions of Counsel in Tibotec's petition***

e 33. Mr. Rajiv Nayyar, learned Senior counsel appearing for the Petitioner  
Tibotec submitted that there was a distinction between the 'issuance' of a  
patent certificate under Rule 74 and the 'grant' of patent for the purposes  
of Section 43. He also referred to the impugned order passed by the  
f Assistant Controller where it was observed that "there was no  
impediment on 30<sup>th</sup> May 2008 to the issuance of the patent certificate and  
that the Patent Office should have done so within seven days of 30<sup>th</sup> May  
g 2008 as the application was published on 30<sup>th</sup> November 2007 and six  
months period was over on 30<sup>th</sup> May 2008". It was further observed in  
the impugned order that the grant of patent by the Controller and the  
h subsequent issuance of letters of patent have taken more time than it  
could have taken ordinarily but that did not preclude the filing of a pre-  
grant opposition. It is accordingly submitted that for all practical  
purposes the effective date of grant of the patent should be 30<sup>th</sup> May  
2008 or the very next day thereafter.

a 34. Mr. Majumdar, learned counsel appearing for Cipla Ltd. submitted  
that at the stage of filing of the application and its examination in initial  
phase by the Controller, there was no third party. The Controller acts as  
b a fact finding authority. Section 3 of the Act sets out the grounds for  
refusal. If the patent is refused, the order is relatable to Section 15 of the  
Act. The Controller could ask for an amendment to be made even at that  
c stage. The intimation that the patent is in order is not by itself a grant of  
patent. This is an order relatable to Section 15 of the Act. According to  
him, the stage of Section 43 for grant of patent is reached only after  
d completion of the processes envisaged by Section 15 of the Act. Under  
Section 45, the date of patent is already a fixed date since under Section  
e 45 (1) “every patent shall be dated as of the date on which the application  
for patent was filed”. It is this date that is entered in the Register. He  
pointed out that under Rule 80 to keep a patent in force, the renewal fees  
f specified in the First Schedule shall be payable at the expiration of the  
second year from the date of the patent and the period for payment of  
renewal fees may be extended up to six months. So the date of patent  
g becomes critical for the payment of renewal fees. Where an applicant  
has not paid renewal fees, it means that he is aware that he has not been  
granted a patent.

h 35. Mr. Majumdar pointed out that Under Rule 122, the Controller can  
correct clerical errors. Likewise, under Section 146 the Controller can  
call for information regarding the commercial working of the patent  
within two months from the date of such notice. Notwithstanding this,

a under Section 146(2) every patent holder has to furnish statements in  
such manner and form and in not less than six months as may be  
prescribed as to the extent to which the patented invention has been  
b worked on a commercial scale in India. If no such reports are filed, then  
it is plain that no patent has been granted. The working of the patent  
arises only where it is granted. Mr. Majumdar pointed out that under  
c Rule 130 an application for review of the Controller's order has to be  
made within one month from the date of communication of the decision  
to the applicant.

d  
36. It is submitted by Mr. Majumdar that in the instant case there was no  
presumption of grant of patent only on the basis of the letter dated 28<sup>th</sup>  
e March 2008 as it was only an informal intimation to the Petitioner which  
was in fact not required to be made in law. It is only as a long standing  
f practice that the Controller has been issuing such communications but  
there is no guarantee that patent would be granted only on account of  
such communication. Secondly, without the completion of the procedure  
g envisaged under Section 25(1) and Section 11A, there can be no grant of  
a patent. It is submitted that for the purposes of the Act "the date of  
grant of the patent is the date on which the Respondent authorities pass  
h the order of grant. It is only after such an order is passed, that a patent is  
treated as granted no matter when the certificate of grant is issued or  
when the grant is recorded or notified." It is accordingly submitted that  
as on the date of the filing of pre-grant opposition, no grant of patent had  
taken place as envisaged by the Act.

a 37. The writ petition is also resisted on the ground of laches. It is stated  
that the Petitioner chose to challenge the order dated 30<sup>th</sup> March 2009  
only on 22<sup>nd</sup> January 2010. Reliance is placed on the judgment of the  
b Supreme Court in *State of M.P. v. Nandlal Jaiswal (1986) 4 SCC 566*.

***When can a patent be said to be granted?***

c 38. The common question that arises in all these petitions is when can it  
be said that a patent has been granted? Section 2 (1) of the Act opens  
with the words “unless the context otherwise requires”. This has to be  
d read with Section 2 (1) (m) which defines a ‘patent’ as “a patent for any  
invention granted under this Act”. The date of grant of patent is critical  
e for determining the time within which a pre-grant opposition has to be  
filed in terms of Section 25(1) of the Act. After the amendment to the  
Act and in particular to Section 25 (1) with effect from 1<sup>st</sup> January 2005,  
f a significant change has been brought in this regard. Prior to its  
amendment, under Section 25(1) the pre-grant opposition had to be filed  
within four months from the date of advertisement of the acceptance of  
g the complete specification. This advertisement in the official gazette of  
the acceptance of complete specification was under Section 23 of the  
Act, prior to its amendment. A further maximum period of one month  
h could be allowed by the Controller for making the pre-grant opposition.  
Such pre-grant opposition could be made only by a “person interested”.

39. The significant change brought about by the amendment to Section  
25 in 2005 is that the pre-grant ‘representation’ (or opposition) against

a the grant of patent can be made by “any person”. The publication of the  
complete specification now takes place under Section 11A of the Act.  
Under Rule 24 of the Patent Rules 2003 the publication happens not  
b earlier than 18 months from the date of filing of the application or the  
date of priority of the application, whichever is earlier.

c 40. There are specific time limits for the steps to be taken for the  
acceptance of the complete specification for publication by the  
Controller. This is followed by a request made by the applicant for  
d examination in terms of Section 11-B of the Act. This is followed by the  
examination of the application under Section 12 of the Act which has to  
take place within the specified time limit as prescribed in Rule 24-B of  
e the Rules. Without going into the specific details of this time period, for  
the purposes of the present petitions it is sufficient to note that where it is  
f intended that there should be a specific time limit within which a step has  
to be taken either by the applicant for the grant of patent or by the  
Controller then such time limit is clearly indicated in the Act and the  
g Rules.

h 41. There is another provision which is relevant in this context. Under  
Rule 55(1-A), no patent shall be granted before the expiry of a period of  
six months from the date of publication of the application under Section  
11A. As a result, at least for a period of 2 years after filing of the  
application for grant of patent, no patent can be granted. It is during this  
period that the steps for examination of the patent in terms of Section 12

a and thereafter the consideration by the Controller of the report of the  
Examiner under Section 14 followed by amendments, if any, are all  
undertaken. It is during this time also that the pre-grant opposition is  
b expected to be filed.

42. The fact of the acceptance of the complete specification, as indicated  
c by the applicant for grant of a patent, having been accepted for  
publication is evident from the advertisement of such specification in the  
Patents Journal in terms of Section 11A of the Act. Therefore, any  
d person who is seeking to object to the grant of the patent is expected to  
keep the track of publication of such complete specification. This Court  
has been informed that publication also takes place on the website, in  
e addition to being published in the Journal.

f 43. There is a further time restriction. Under Rule 24, the period for  
which an application for patent “shall not ordinarily be open to public  
under sub-section (1) of Section 11-A shall be 18 months from the date  
g of filing of the application or the date of the priority of the application,  
whichever is earlier.” In effect, therefore, it will not be possible for a  
person seeking to object to the grant of a patent to make ‘representation’  
h earlier than a period of 18 months after the date of the filing of such  
application. In any event since in terms of Rule 55(1-A) no patent can be  
granted before the expiry of a period of six months from the date of  
publication and the Controller is expected to publish the application  
within one month from the date of expiry of the said period, there is at



a least a period of six months thereafter for the opposer to file the  
representation.

b 44. Given the above scheme, the amendment in 2005 to Section 25 of the  
Act was apparently made with a view to extending the time period within  
c which an opposition to the grant of patent had to be made. Under the  
pre-amended Section 25, the persons interested in opposing the grant of  
d patent had to necessarily file such opposition within four months, a  
period extendable only by one month, whereas under the amended  
Section 25 that period is clearly extended at least up to six months.

e 45. Given the practical aspect of the matter, no patent is usually granted  
immediately on the expiry of six months from the date of publication of  
the application. It is usually a much longer period. The amendment in  
f Section 25 clearly, therefore, enlarges the time for filing of a pre-grant  
opposition.

g 46. The thrust of the Act is that the mere grant of patent does not ensure  
its validity. This is plain from Section 13(4) of the Act. Even the grant  
of a patent does not ensure that there will be no further challenge. Under  
h Section 25 (2) of the Act, against the grant of a patent and the rejection  
of a pre-grant opposition, a post-grant opposition can be filed by any  
person interested before the Intellectual Property Appellate Board  
(IPAB). An application for revocation can be filed before the IPAB by  
any person interested under Section 64 of the Act. If the patent holder

a files a suit for infringement the Defendant in such a suit can by way of a  
counter claim challenge the validity of grant of patent (Section 107 read  
with Section 64 of the Act).

b  
47. The scheme of the Patents Act, therefore, is such that there are  
several hurdles to cross before the grant of a patent can be said to be  
c final. There are two other provisions that require to be noticed. Under  
Section 53, term of every patent “shall be 20 years from the date of filing  
of the application for the patent”. Under Section 45 “every patent shall  
d be dated as of the date on which the application for patent was filed”.  
Since this date cannot possibly be changed, a patent holder may end up  
e not being able to work the patent during the time when it remains  
challenged, or its grant is stayed or when the patent holder is not  
confident to exploit it commercially till all the challenges to its validity  
f are overcome. Since there is already a loss of time for the patent holder  
in the above processes, the time period envisaged by Section 25(1) of the  
Act for filing of a pre-grant opposition cannot possibly be liberally  
g construed, notwithstanding that there is no specific time period  
mentioned therein. The outer limit is the date on which the patent is  
granted.

h  
48. A careful look at Section 43 of the Act shows that in the first place an  
application for patent has to be found “to be in order for grant”. This  
includes the period during which complete specification is accepted for  
publication in terms of Section 11A followed by the examination of the

a patent which takes place within the time-frame set out in Rule 24-B of the Rules. A refusal at that stage will be governed by Section 15 of the Act. If the patent is not refused at that stage and no pre-grant opposition has been filed, the patent proceeds for registration.

49. Where any pre-grant opposition is filed in the form of a representation under Section 25(1) of the Act, then it has to be examined following the procedure outlined in Rule 55 (1). The representation should include a statement of evidence and a request for hearing. Under Rule 55 (2), the Controller is to consider such representation “only when a request for examination of an application has been filed”. A notice is given to the applicant “for grant of patent” where the Controller forms an opinion, upon considering the pre-grant opposition, that the patent should be refused or amended. This happens under Rule 55 (3). The applicant for grant of patent then responds to the notice by filing his statement of evidence under Rule 55(4) within three months from the date of the notice. Under Rule 55 (5), the Controller may, on consideration of the statement and evidence filed by the applicant, either refuse to grant a patent or require the complete specification to be amended before the patent is granted.

50. Then we have Rule 55 (6) which is relied upon extensively by the learned counsel for the parties and which reads as under:

“55(6) After considering the representation and submission made during the hearing if so requested, the Controller shall proceed further simultaneously

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a                   either rejecting the representation and granting the  
patent or accepting the representation and refusing  
c                   the grant of patent on that application, ordinarily  
within one month from the completion of above  
b                   proceedings.”

51. It is plain, therefore, that once the pre-grant opposition is decided, the  
c                   Controller simultaneously proceeds to either reject such representation  
and grant the patent or accept the representation and refuse the patent.  
The language of Rule 55 (6) leaves no manner of doubt that these two  
d                   actions i.e. the consideration of the representation and the final decision  
on the application for grant of patent take place simultaneously.

e                   52. It is possible that there are more than one representations by way of  
pre-grant opposition. Ideally, the Controller will bunch them together,  
f                   hear them sequentially and express a final opinion on each of them as far  
as practicable, on the same date. It is like a court hearing a batch of  
g                   petitions seeking similar relief. It is possible that even after the hearing  
on one bunch of pre-grant oppositions has concluded and order has been  
reserved thereon, another pre-grant opposition or a set of oppositions is  
h                   filed prior to the pronouncement by the Controller of the decision on the  
first set of pre-grant oppositions. Then the scheme of the Act requires the  
Controller to deal with such subsequently filed pre-grant oppositions as  
well. However, once a final decision is pronounced on the pre-grant  
oppositions, the Controller should, consistent with the requirement of  
Rule 55 (6) simultaneously pronounce the decision on the application for

a grant of patent. The Controller should clearly state, simultaneously, that  
the application is found in order and that the patent is being granted.

b 53. Reverting to Section 43 (1), the language used is that “a patent shall  
be granted as expeditiously as possible.” Therefore the patent has to be  
c granted once it is found that either the application has not been refused in  
terms of Section 25(1) read with Rule 55 (6) or it has not been found in  
d contravention of any provision of the Act. In other words, at this stage  
the Controller is not expected to delay the pronouncement of the final  
e decision. The thrust of Section 43 (1) and Rule 55 (6) is that of  
expeditious decision making by the Controller. Section 43 (1) indicates  
that the “patent shall be granted.....with the seal of the patent office and  
the date on which the patent is granted shall be entered in the Register”.  
When read continuously, the language of Section 43 (1) does appear to  
f indicate that it is the decision taken by the Controller on file which is the  
determining event for ascertaining ‘the date of grant of patent.’ The  
sealing of the patent and the entering of the patent in the Register  
g obviously follows the act of the Controller passing an order to the effect  
that the patent has been granted. In other words, the sealing of the patent  
and the entering of the patent in the Register are, given the language of  
h Section 43 (1) of the Act, intended to be ministerial acts evidencing the  
grant of patent, which is at a stage anterior to those ministerial acts.

54. Section 43 (2) talks of the publishing by the Controller of “the fact  
that the patent has been granted”. The language of Section 43 (2) is plain.

a The act of publication clearly follows the grant of patent. Per force the  
grant of patent is anterior to the publication and has to necessarily be at a  
point earlier to the publication. It is, therefore, not possible to agree  
b with the submissions made on behalf of the pre-grant opposers in the  
present batch of cases that the patent cannot be said to have been granted  
till this fact is published in the official gazette. Given that the  
c interpretation of the provision has to be contextual, this Court holds that  
the date of grant of patent is the date on which the Controller passes an  
order to that effect on the file. This Court now proceeds to deal with the  
d apprehended practical problems that the office of the Controller may face  
on account of the interpretation placed by this Court on Section 43 of the  
Act.

***Previous announcement of the date of pronouncement of orders***

f 55. It was submitted that an order does not become effective till such  
time it is communicated or made known, because it then gives valuable  
rights to both the holder of the patent as well as any person interested in  
g opposing the grant of patent. While it is correct that the knowledge of an  
order granting a patent is important from the point of view of both the  
applicant for grant of patent and the opposer, it is unlikely that the  
h applicant is not present, either in person or through a representative, on  
the date on which an order is passed by the Controller or the Assistant  
Controller granting the patent. In order to obviate any difficulty on this  
score, this Court would like to impress upon the Controller and the  
Assistant Controllers to list cases for pronouncement of orders and make

a that fact known by publishing a ‘cause list’ of such cases under the  
heading “for pronouncement of orders” the previous evening both on the  
b website as well the notice Board of the Office of the Controller, just as it  
happens in the Courts. Therefore both the applicant for grant of patent as  
well as the pre-grant opposer would be aware of the date on which the  
c orders are to be pronounced. Since it will be at least the previous  
evening on which the list is available on the website and also placed on  
the notice board of the Office of the Controller, there will be sufficient  
d notice to such parties.

### ***Dealing with Review Petitions***

e 56. If an approach similar to that followed by courts in hearing cases and  
passing orders thereon is adopted, much of the problems faced by the  
Controller can be resolved. For instance, once a final order is pronounced  
f on a petition by the Court, then no further applications whether for  
intervention, impleadment, opposition or any other relief is entertained  
by such court. The only exception is the filing of a review application by  
g a party to the case. Likewise, once a final order granting patent is passed  
by the Controller on the file, there is no question of thereafter  
entertaining a pre-grant opposition as it is barred under Section 25 (1)  
h with no discretion given to the Controller. If a review petition is filed  
under Section 77 (1) (f) read with Rule 130, it will be by those who are  
parties to the order of the Controller or the Assistant Controller the  
review of which is sought. If such review petition is entertained, and the  
order is recalled then as it happens with judicial orders by courts, the

a clock is put back to the stage where the original order was passed and all  
legal consequences would flow. This by no means alters the fact that the  
date of the grant of patent is the date on which the Controller or Assistant  
b Controller passes an order on file granting the patent.

***Wording of the final order granting patent***

c 57. There is one other aspect which requires to be adverted to, which is  
the wording of the order granting patent. The Controller should pass the  
‘final order’ saying that “the patent is hereby granted” only after all  
d amendments have been carried out to the satisfaction of the Controller by  
the applicant. The Controller will, therefore, not dispose of the  
e application or pass a final order till such time the Applicant has not  
carried out the amendments to the satisfaction of the Controller. It will  
have to be a time-bound order for that purpose. A failure to carry out the  
f amendment to the specification as directed by the Controller or Assistant  
Controller within the time granted might result in rejection of the patent  
which contingency is covered under S. 15 of the Act.

***Placing the digitally signed orders on the net***

g 58. In order to minimise any unnecessary time-gap between the signing  
h by the Controller or Assistant Controller of the final order granting  
patent and the ‘publishing’ of such order, it is directed that every final  
order granting the patent passed by the Controller or the Assistant  
Controller, as the case may be, should be digitally signed by the  
Controller or the Assistant Controller and placed on the website of the



a Controller on the very same day without any unnecessary delay. The  
b procedure in this regard be streamlined for being followed uniformly by  
c all the officers and necessary instructions/practice directions should be  
d issued by the Controller.

***Rights of post-grant opposers protected***

c 59. The rights of such of those post-grant opposers who are persons  
d 'interested' are sufficiently protected under Section 25(2). Since the  
e period of limitation for filing a post-grant opposition is one month "from  
f the date of publication of grant of a patent", the legislature has, therefore,  
g already taken care of the interests of the post-grant opposers and made  
h the period of limitation run only from the date of publication of the grant  
of patent which is expected to take place in terms of Section 43 (2) of the  
Act.

f 60. It must be understood that prior to the amendment in Section 25 in  
g the year 2005, even a pre-grant opposition could be filed only by any  
h person 'interested'. It is only after the amendment in 2005 that any  
person can now file the pre-grant opposition. The Act, therefore, makes  
a distinction between an opposer at the stage of pre-grant opposition,  
who could be 'any' person, and the opposer at the post-grant stage, who  
could only be a 'person interested'. The legislative intent is that the right  
to file a post-grant opposition under Section 25 (2) is restricted to any  
person interested. The fact that the restriction of the time to file a pre-  
grant which results from the interpretation given by this court may

a impact the two classes of pre-grant opposers differently is consistent with  
the above distinction.

b 61. While restricting the time period for filing a pre-grant opposition to  
the time when such patent is granted may inconvenience “any person”  
c who wishes to file a pre-grant opposition, it is certainly not going to  
inconvenience a “person interested”. Even if such ‘interested’ person  
misses the bus at the pre-grant stage, the right of such person to oppose  
d at the post-grant stage is preserved under Section 25 (2) of the Act.  
Therefore, the interpretation placed by this Court certainly cannot  
prejudice a person interested in opposing the grant of patent. As regards  
e any person, other than a person interested, the legislative intent appears  
to restrict the scope of such person confined to the stage of pre-grant. It  
would be necessary, therefore, for such person (who may not be an  
f ‘interested’ person) to be vigilant and to watch out for the date of  
advertisement of the complete specification and understand that the  
limitation for filing a pre-grant opposition begins to run from that date  
g onwards.

***Need to discourage filing of serial oppositions***

h 62. Accepting the submissions of pre-grant opposers in the present batch  
of cases that till such time the grant of patent is not entered in the  
Register, and notwithstanding that an order has already been passed on  
file by the Controller granting a patent, they can continue to file the pre-  
grant representations in terms of Section 25 (1) might result in the

a phenomenon of ‘serial oppositions’, as has happened in the case of the  
applications filed opposing the patents applied for by J. Mitra &  
Company. Within a day after the Controller rejected the pre-grant  
b opposition filed by SDL, Dr. Gupte filed a pre-grant opposition. Soon  
thereafter Dr. Rindani filed his pre-grant opposition. In other words, if  
this Court were to hold that the date of the grant of patent is only the date  
c on which the factum of such grant is entered in the Register, then there  
would be no end to filing of pre-grant oppositions as long as on account  
of some delay on the administrative side the factum of grant of patent is  
d not entered in the Register. Given the scheme of the Act, and the number  
of hurdles an applicant for grant of a patent has to overcome, even if the  
application is found to be ‘in order for grant’, it is not possible to accept  
e the interpretation put forth by the pre-grant opposers.

f 63. Then we have one more situation as in the case of Tibotec. The mere  
communication by the Controller to the applicant for grant of patent that  
the application has been found in order subject of course to the decision  
g on pre-grant opposition, if any filed, cannot be construed as the official  
decision of the Controller granting the patent. There has to be an order  
on file passed by the Controller holding that the patent has been found in  
h order and that patent is granted. Until and unless such an order is passed  
on file, it cannot be said that the patent has been granted.

64. In adopting the above interpretation of Section 43 and other related  
provisions of the Act this Court has kept in view the following

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a observations of the Supreme court in *Entertainment Network (India)*  
*Ltd. v. Super Cassette Industries Ltd. (2008) 13 SCC 30*, in paras 137  
and 139, which though made in the context of the Copyright Act may  
b well apply to the present cases as well:

“137. Furthermore, the court while interpreting a  
statute will put itself in the armchair of the  
c reasonable legislature, all statutes must be presumed  
to be reasonable. It is now trite law that literal  
interpretation should be avoided when it leads to  
absurdity.....

d 139. In this case, however, the meaning of the  
statute is neither clear nor sensible. It is a statute  
where a purposive construction is warranted. It is a  
e case where sub-section (2) should be kept confined  
to clause (a) for that purpose. The statute has to be  
read down. It is not a case of improper interpolation  
so as to take away a primary purpose of the  
f legislative intent. It is expedient to give effect to the  
intent of the statute. This itself says that creases can  
be ironed out. While undertaking the said exercise,  
g the Court’s endeavour would be to give a meaning to  
the provisions and not render it otiose.... ”

h 65. This court, for the aforementioned reasons, holds that for the  
purposes of Section 43 (1) of the Act, the patent is ‘granted’ on the date  
on which the Controller passes a final order to that effect on the file.

### ***Conclusions: First set of petitions***

66. The facts in the first set of petitions have already been discussed. In  
the first set of petitions, the order dated 23<sup>rd</sup> August 2006 passed by the  
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a Controller, while dismissing the pre-grant opposition that “I hereby order  
to grant patent (Patent No. 194638) on batch Application No.  
593/Del/2000” must be taken to be the date on which the patent was  
b granted. Although, as pointed out by learned counsel for the Petitioners,  
the said order requires the applicant (J.Mitra & Co.) to amend the  
specification to include a cross reference, it does not materially affect the  
c factum of the grant of patent. The fact that it was entered in the Register  
on 22<sup>nd</sup> September 2006 would not make any difference to this position.  
Further the statement by J.Mitra & Co. in the plaint in C.S. (OS)No.2020  
d of 2006 that the patent was granted on 22<sup>nd</sup> September 2006 would also  
not make a difference to the position in law. The date of the grant of the  
patent in question to J.Mitra & Co. should be taken as 23<sup>rd</sup> August 2006.  
e

67. Consequently, any pre-grant opposition filed after 23<sup>rd</sup> August 2006  
f was clearly barred under Section 25 (1) of the Act. Therefore the  
impugned orders of the Controller rejecting the pre-grant oppositions  
filed by the petitioners are valid and do not call for interference.

g  
68. Notwithstanding the above conclusion, this Court also holds that the  
filing of pre-grant opposition by Dr. Gupte and Dr. Rindani subsequent  
h to 23<sup>rd</sup> August 2006 was, apart from being not maintainable in law, also  
an abuse of the process of law. This Court is not convinced of the  
bonafides of either of the Petitioners. There has not been any effective  
denial of the fact that both Petitioners were associated with SDL in some  
capacity or the other. It is impossible to comprehend that either of these

a Petitioners was unaware of the fact that the filing of the pre-grant  
opposition by SDL or of the fact that it has been taken up for  
consideration by the Controller of Patents or of the fact that the order on  
b such pre-grant opposition were pending.

c 69. Even according to these Petitioners, the community of those  
interested in the development of the test kits is a small one and every step  
taken by each competitor would be known to the other. This itself belies  
the fact that either Dr. Gupte or Dr. Rindani was unaware of the pre-  
d grant oppositions already filed by SDL in relation to the patent  
applications of J. Mitra & Company. Given the long history of litigation  
e between the parties, it creates further doubts on the bonafides of these  
two Petitioners.

f 70. For all of the above reasons, this Court finds absolutely no merit in  
the four Writ Petition (C) Nos.3516, 3517, 5422 and 5423 of 2007 in the  
first set and they are dismissed with costs of Rs.20,000/- each which will  
g be paid by each of the Petitioners to J. Mitra & Co. within a period of  
four weeks.

h ***Conclusions: Second set of petitions***

71. In the second set of petitions by Zephyr, the patent in favour of Lalit  
Mahajan was granted and sealed on 16<sup>th</sup> October 2008 whereas the pre-  
grant opposition was filed in one case on 28<sup>th</sup> November 2008 and in two  
other cases on 12<sup>th</sup> December 2008. There can be no manner of doubt  
that the filing of such pre-grant opposition was subsequent to the grant of

***W.P.(C) Nos. 3516, 3517,5422, 5423 of 2007 & 10399, 10400 & 10450 of 2009 & 1020 of 2010***

***page 38 of 40***

a patent and was barred under Section 25(1) of the Act. There is absolutely, therefore, no error in the orders passed by the Controller rejecting the pre-grant oppositions.

b  
72. The three Writ Petition (C) Nos. 10399, 10400 and 10450 of 2009 are dismissed with costs of Rs. 20,000/- each which will be paid by the  
c  
Petitioner Zephyr to Respondent No.1 Lalit Mahajan within four weeks from today.

d  
***Conclusions in Writ Petition (C) No. 1020 of 2010***

e  
73. In view of what has been held above, the communication dated 28<sup>th</sup> March 2008 written by the Controller to the Petitioner cannot be held to be the date of grant of the patent. It was merely a communication stating that the application has been found in order for grant. It is not an order to grant patent. Therefore, when the pre-grant opposition was filed by  
f  
Cipla Ltd on 26<sup>th</sup> June 2008 there was no grant of patent by that date and, therefore, such application was maintainable in terms of Section 25(1) of  
g  
the Act. Although there is an observation by the Controller that after 30<sup>th</sup> May 2008 there was no legal impediment in the Controller passing an order for grant of patent because on that date there was no pre-grant  
h  
opposition, the fact remains that on file no such order was passed. It cannot, therefore, be said that the filing of the pre-grant opposition on 26<sup>th</sup> June 2008 by Cipla was time barred.

74. There is yet another ground for not entertaining the plea of the

a                   Petitioner. The challenge is to an order refusing the grant of patent which  
is relatable to Section 15 of the Act. This is appealable before the IPAB  
under Section 117A of the Act as has been held by this Court in *UCB*  
b                   *Farchim Sa v. Cipla Ltd. 167 (2010) DLT 459.*

75. For the aforementioned reasons, the writ petition is dismissed with  
c                   costs of Rs.20,000/- which will be paid by the Petitioner to Respondent  
Cipla Ltd. within four weeks.

d                   ***Directions to the Controller of Patents***

76. The Controller of Patents will, within a period of two weeks from  
today issue necessary practice directions/instructions to all officers and  
e                   concerned authorities in terms of this judgment and particularly in terms  
of what has been held by this Court in paras 55 to 58 thereof. Such  
f                   practice directions/ instructions will also be placed simultaneously on the  
website of the Controller of Patents. They will be prospective in the  
sense they will not result in the reopening of orders granting patent that  
g                   have attained finality.

77. A certified copy of this order will be delivered to the Controller of  
h                   Patents by a special messenger forthwith for compliance.

**S. MURALIDHAR,J.**

**JULY 15, 2010**

dn



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This is a True Court Copy™ of the judgment as appearing on the Court website.  
Publisher has only added the Page para for convenience in referencing.

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