
Understanding Section 8 of the Indian Patents Act and its implications

Section 8 of the Indian Patents Act, 1970 has recently raised concerns amongst the Patent applicants in India. Although, requirement under section 8 has always been there under the Indian Patents Act, however, the same was not rigorously enforced by the Patent office. Section 8 requires the Patentee to file information at the Indian Patent office from time to time stating whether he has made any application for a patent for the same or substantially same invention in any foreign country or countries, to furnish particulars of any such applications, objections raised and the amendments effected to the specifications.

Section 8 of the Indian Patents Act, refers to 'Information and undertaking regarding foreign applications' and comprises of two mandatory requirements:

- Sec. 8 (1). submission of information pertaining to corresponding foreign applications along with an undertaking that up to the date of grant of patent in India, Controller would be informed in writing, from time to time, detailed particulars in respect of any application filed in a country outside India by way of Form 3 on voluntary basis, within six months from the filing date of the application or within six month from the date of filing the application in the foreign country and
- Sec. 8 (2). submission of documents pertaining to processing of application in other Foreign Patent offices and especially in relation to aspects relating to patentability of the invention on request of the Controller within six month from such request of the Controller.

Failure to disclose this information makes the grounds for opposing the grant of the patents as under Section 25(1) (h) of the Act, opposing the granted patent as under Section 25(2) (h) of the Act or revocation of granted patent by the Intellectual Property Appellate Board. Submitting the information of other patent offices as regards novelty, non-obvious, utility and other observations, when such information was readily available to the applicant, only when asked by the examiner may seriously jeopardize the interest of the patentee as the failure to do so is a standalone ground for opposition and

revocation of a granted patent. Therefore, the Patent applicant is required to furnish any and all foreign search reports from “any country outside India” in its possession at the time of its reply to the patent office.

In a recent case of revocation petition filed by Fresenius Kabi Oncology Limited filed against Patent No. IN 221171 entitled “Quinazoline Ditosylate Salt Compounds”(corresponds to ‘Lapatinib’ and marketed as Tyverb™ and Tykerb™) of Glaxo Group Limited, Hon’ble Smt. Justice Prabha Sridevan, Chairman, Intellectual Property Appellate Board (IPAB) highlighted the importance of the Section 8 and showed the willingness of the forum to reject or revoke a patent on the ground of non-compliance alone. “What should be furnished by the Patentee shall be furnished by the Patentee”.

Our Comment

For opposition/revocation on Section 8 grounds, it must be pleaded and proved that the lapse is with regarding applications in respect of the same or substantially the same invention and the burden to prove that a failure to comply with such disclosure was material to the determination of patentability lies on the opponent or revocation petitioner.

As the courts and forums are following an almost ‘zero tolerance’ with respect to non-compliance with Section 8, the patentee must take due care and should be forthcoming in making disclosures with regard to material particulars. The particulars may include name of the country where the application is being prosecuted, the application number, date of filing of the application, its status, date of publication and date of grant and each Office action/Examination report should be shared which could have a material effect on the determination of novelty and non-obviousness by the examiner in India for each claim being prosecuted in the Indian Patent Office.

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