



EXCO MEETING, CAPE TOWN
13 & 18 APRIL 2015

COUNTRY REPORT	
TITLE: Country report for INDIA	
DRAWN UP BY: SHARAD VADEHRA, Delegate	
TABLED TO: FICPI delegates	
PURPOSE: For information and consideration	
SNIPPET: News from and activities of the FICPI national group in [INDIA] since the Barcelona ExCo in November 2014.	

SECTION A: ACTIVITIES OF FICPI ASSOCIATION/SECTION

The information supplied in Section A will remain confidential on FICPI's website after the ExCo (will require a password).

SECTION B: CHANGES IN LAW

Information supplied under Sections B and C will be published on FICPI's website after the ExCo and will be available to the public.

B1. LEGISLATION

1. Please provide details of any changes to IP legislation (patent, trade mark, design and other) in your country implemented or due to be implemented since you reported last in October 2014.

Design (Amendment) Rules, 2014

The Government of India notified Design (Amendment) Rules 2014, which came into force w.e.f. 30 December, 2014.

By way of the notification of the above mentioned amended Rules the official fee has been increased in almost all categories and for all matters involving official fee before the Indian Patent Office.

Further, now the Applicants have been divided into three categories "natural person"; "other than natural person" and "Small Entity".

To claim the benefit of lower official fees for *small entity*, a Form-24 (mandatorily along with a proof in support of such claim) has to be filed.

B2. MAJOR CASES

2. Please provide brief details of any new case law in the field of patents, trademarks, design or other IP of general interest.

PATENTS:

NITTO DENKO V. UNION OF INDIA.

From the report of second committee, the Nitto Denko case which has been addressing reforms in the patent examination process in India, appears to have taken on a 'Make in India' flavor.

The second committee appointed on the instructions of the High Court has suggested that the Patent Act be amended to allow for expedited patent examination if the applicant has started



manufacturing the invention in India or undertakes to start manufacturing in India within two years from requesting expedited examination.

In *Nitto Denko v. Union of India*, Delhi High Court delivered a decision in October 2014, suggesting reforms to address the issue of patent application pendency in the Patent Office. Based on the suggestions of a Government appointed Committee, Justice Vibhu Bakhru laid down instructions to increase manpower in the office, increase funding, explore alternative means of recruiting Patent Officers, etc. The High Court had also instructed the government to constitute a second committee to examine the following issues:

- Whether waiver of maintenance fee for the delayed period or other measures could be considered to compensate patentees for the time consumed in the process?
- Whether examination of patents could be done out of turn under existing provisions of the Patent Act, 1970 and if so, under what circumstances?

The second committee arrived at the following conclusions:

With respect to waiver of maintenance fee for delayed examination, the Committee concluded that it is not feasible as such a practice is non-existent everywhere in the world except the US. Besides, such a measure is unnecessary as the inventor is not precluded from marketing and seeking other regulatory approvals when the patent application is still pending.

As for out of turn examination, the Committee noted that it should normally not be allowed unless it is in the public interest, as the Patent Act, 1970 and Rules thereunder do not have provisions allowing it. However, the Committee suggests that an amendment be made to the Patent Rules to allow for out of turn examination if the applicant sets up local manufacturing capabilities utilizing the invention.

a judgement dated 30th January 2015, upheld the contentions of Gilead Sciences **GILEAD PHARMASSET, LLC VERSUS UNION OF INDIA & ANR**

Delhi High Court, in regarding their Hepatitis C Virus drug, Sovaldi. Gilead in its writ petition had questioned the procedure adopted by the patent office in dealing with their application rather than the substantive merits of their application.

Facts: Gilead applied for a patent on sofosbuvir (branded as Sovaldi) and received a First Examination Report. Natco Pharma and the advocacy group IMAK filed pre-grant oppositions against Gilead's application. The main issue is that while Section 14 mandates that the applicant be given a chance to be heard, pre-grant opposition under Section 25 contains no such imperative.

Further, IMAK sought a simultaneous hearing regarding the issues raised under both sections – exactly the relief being sought by Gilead in its writ petition. The patent office, however, did not issue notice to Gilead in the matter of the pre-grant opposition. A hearing was conducted, and the impugned order was passed in January 2015.

The court accepted Gilead's claim that the order of patent office was influenced by the pre-grant oppositions. The court noted that the material contained in the pre-grant oppositions were available to the patent office during the pendency of the Section 14 proceedings. The court analysed that regardless of whether the patent office chooses to utilise arguments raised in pre-grant oppositions, the mere availability of this material in the patent office's records represents a possibility of influencing the final order of the patent office. The court held that such influence would be unduly prejudicial to the applicant's interest. Further, the court noted that combining the pre-grant and the



Section 14 proceedings, giving Gilead an opportunity to be heard on both counts, would have saved the patent office time and effort, while mitigating allegations of bias.

The court has remanded the case back to the patent office for a fresh decision, after holding hearings for both Section 14 and Section 25 proceedings, and issuing notice to all parties including Gilead.

SYMED LABS LTD. versus GLENMARK PHARMACEUTICALS LTD. AND ANR.

Symed Labs won an interim injunction on 19th January, 2015, against manufacture of the drug 'linezolid' of Glenmark Pharmaceuticals, by way of the suit patented process. The impugned drug is an anti-bacterial drug used for the treatment of pneumonia, among other infections. This order makes Glenmark the fifth pharmaceutical company to be enjoined from selling the drug. The most significant aspect of the case is the award of multiple injunctions in a case involving the alleged infringement of two *process* patent (Patents No. IN213062 and IN213063).

Glenmark filed an appeal against this injunction order which was heard by a Division Bench of the Delhi High Court. The appeal has been admitted, the order of the Single Judge has been stayed and the matter is listed for arguments on April 6.

NOVARTIS AG & ANR versus CIPLA LTD

Delhi high court has granted temporary injunction against Cipla, after Novartis sued Cipla alleging infringement of its Onbrez patents. Cipla had launched a low cost generic version of Onbrez and petitioned to DIPP requesting them to revoke Novartis 'patents. Cipla argued that chronic obstructive pulmonary disease has reached "epidemic" proportions and the Central Govt should exercise its powers under Section 92(3) (compulsory license under special circumstances of national emergency, extreme urgency) and Section 66 (patents which are prejudicial to the public) to revoke Novartis' Onbrez patents.

Onbrez is protected by 5 patents in India – IN222346 (product patent- expiring in 2020); IN214320 (composition patent- expiring in 2021); IN230049, IN210047 and IN230312 (process patents- expiring in 2024).

This judgement placed reliance on the Roche vs. Cipla and observed that, if there is a strong prima facie case and the validity is not further seriously questioned, then there is a clear way out to grant injunction.

The main question considered by the court was whether the Court will allow a party to infringe the registered patent which is prima facie held to be valid, the infringement is established and there is no credible defence raised by the other side?

The answer to this question is "NO". The Court would never encourage the infringement in view of the exclusive and statutory rights granted under section 48 of the Act. The effect of registered patent is defined in the statute and the same is not capable of being misunderstood. The statutory and monopoly rights cannot be reduced to a nullity as by virtue of section 48 of the Act till the term of validity of the suit patents. The court further observed that merely citing grounds and conditions for compulsory licensing do not absolve the defendant to infringe the registered patent.



SHENZHEN ONEPLUS TECHNOLOGY CO LTD versus MICROMAX INFORMATICS LIMITED

An injunction was granted against OnePlus in a suit initiated by Micromax for the prevention of the breach of an exclusive license agreement with Cyanogen for the CyanogenMod OS.

Cyanogen licensed CyanogenMod OS to OnePlus globally by means of non-exclusive license. Subsequently Micromax obtained exclusive license for Core OS. Cyanogen terminated agreement with OnePlus a while ago. OnePlus continued to proceed with its launch plans in India. Cyanogen indicated that it would not provide support services for devices launched by OnePlus but later relented. Micromax sued in Delhi High Court seeking to injunct OnePlus from going ahead with its sales as this would necessarily frustrate their agreement with Cyanogen.

Court observed that exclusive right is conferred upon Micromax to use CyanogenMod OS in India in supercession of other agreements. The relevant contract under which OnePlus could have sued Cyanogen for rights initially granted to it, had dispute resolution clauses making the applicable law and the courts of jurisdiction to be that of the US. Court observed that OnePlus had to be injuncted to prevent irreparable harm to Micromax. The order injuncted OnePlus from marketing, selling and shipping its mobiles in India, thereby amounting to interference in Micromax's business and from interfering and/or infringing Micromax's license. OnePlus was however allowed to dispose off their existing stock.

OnePlus appealed this before the Division Bench of the Delhi High Court which vacated the ad-interim injunction.

The court noted that there are many aspects of the dispute that require pleadings to be presented, an opportunity for which was not granted to OnePlus. The Court noted that the termination of the agreement between OnePlus and Cyanogen, the exact nature of the goods/software covered by the agreement, the question as to whether damages would be a sufficient remedy for breach, etc., are questions that have to be supported by detailed pleadings based on law and fact. Only upon a perusal of these pleadings would a judge be able to decide on the application, considering that these often involve complex questions of law and fact.

XIAOMI VERSUS ERICSSON

On the appeal of Xiaomi, against the ex-parte injunction granted by Single Judge Bench, the new Division Bench gave an order which provides some respite for Xiaomi. Xiaomi is allowed to sell its devices in India, subject to a number of conditions. These conditions specify that Xiaomi can only sell devices that carry chips imported from "Qualcomm Inc., who is licensee of Ericsson. Further, Xiaomi has to deposit Rs. 100 for every device sold in India or which it sells till January 5, 2015.

Earlier, an ex parte injunction order was granted by a Single Judge of the Delhi High Court against Xiaomi for infringement of Ericsson's patents. The patents in question are Standard, Essential Patents (SEPs) which are subject to FRAND (Fair, Reasonable and Non-Discriminatory) terms. The patents allegedly relate to AMR technology, 2G and 3G technologies. These appear to be the same set of technology patents under which Ericsson had earlier sued two Indian telecom companies, Micromax and Intex.

Bayer Corporation Vs. Union Of India & Ors. Supreme Court of India [Special Leave To Appeal (C) No(S). 30145/2014 (Arising Out Of Impugned Final Judgment And Order Dated 15/07/2014 In Wp No. 1323/2013 Passed By The High Court Of Bombay)

The Supreme Court dismissed Bayer's Special Leave Petition against the decision of the Bombay High Court upholding the grant of a compulsory license for Bayer's anticancer drug Nexavar.

While dismissing the SLP of Bayer, the Supreme Court noted that:



“In the facts of the present case, we are not inclined to interfere. The Special Leave Petition is dismissed, keeping all questions of law open.”

With this decision of the Supreme Court, all the forums available to Bayer to challenge the granted compulsory license have exhausted.

MAJ. (RETD) SUKESH BEHL V. KONINKLIJKE PHILLIPS ELECTRONICS

In 2012, Koninklijke Phillips Electronics (KPE) filed suit for permanent injunction restraining Sukesh Behl (SB) from infringing its patent. SB denied the allegation and sought to revoke KPE’s patent u/S 64(1)(m) by submitting that KPE had not complied with Section 8 of Indian Patents Act, 1970. Section 64 specifies that Patent may be revoked on “any of the following grounds.....”. Thus even if a single ground u/S 64 is satisfied, Patent may be revoked.

KPE filed Affidavit in Indian Patent Office stating that they had submitted details of foreign applications in 1999, 2002 and 2004. However, certain details regarding foreign filings were inadvertently omitted and the same were not material to the patent.

Division Bench of Delhi High Court held that applying the rule of ‘literal interpretation’, Section 8 uses the word ‘shall’ and is therefore a mandatory provision. Section 64 uses the word ‘may’ which indicates that the provision is directory and also leads to the presumption that the power to revoke a patent is discretionary.

As part of this discretion, it is necessary to check whether omission to disclose information under Section 8 was deliberate/intentional or whether it was a mere clerical/bona fide error. Such a determination would impact the finding for/against revocation under Section 64(1)(m).

The appeal was dismissed and the Patent was not revoked u/S 64(1)(m).

For the FIRST time ever, Court has brought “INTENTION” into picture while dealing with Section 8. By bringing concepts of ‘deliberate/intentional/material’ omissions, the court has taken Section 8 closer to the inequitable conduct defense used in the US.

TRADEMARKS

Make My Trip (India) Pvt. Ltd. v. Make My Tours Private Ltd. & Ors.

The Delhi High Court granted an interim relief on December 23, 2014 in favour of online travel company Make My Trip (India) Pvt. Ltd., which runs the popular website makemytrip.com, restraining the defendants from using plaintiff’s trademark and logo. The defendants run an online travel website by the name of makemytours.com.

The plaintiff on learning about the existence of a website with a deceptively similar domain name as to its own and also, on getting to know that the defendants are using a logo deceptively similar to its own, instituted a suit for infringement and passing off against the defendants.

The plaintiff contended that it is the registered proprietor of the MMT marks in India. Further, it had obtained copyright registrations in MMT logos. The plaintiff further pleaded that it had made substantial investments in advertising its MMT marks and logos. The plaintiff also stressed on the fact that its website was one of India’s most accessed and used online booking and planning site. The plaintiff finally pleaded that owing to prior adoption, substantial expenditure on promotion, long, continuous and extensive use, its MMT marks had acquired a secondary meaning in the business and trade qualifying them as well-known marks.

Accepting the contentions of the plaintiff, the Court granted interim relief to the plaintiff and restrained the defendants from using the MMT marks and logo of the plaintiff until the next date of hearing.



Lupin Ltd. v. Johnson and Johnson

The Full Bench of the Bombay High Court resolving the conflict between two Division Benches of the High Court, finally held that Civil Courts are entitled to delve into the question of the validity of the trade mark and deny the grant of an injunction if it is shown that the registration of the trademark is “ex facie illegal, fraudulent or shocks the conscience of the Court”.

Deere & Co. & Anr. v. S. Harcharan Singh & Anr.

The High Court of Delhi on December 05, 2014 granted interim relief to the plaintiffs and restrained the defendants from manufacturing, selling, offering for sale, advertising, directly or indirectly dealing in any manner with agricultural products and/or any other goods and/or services using the plaintiffs' word mark "John Deere", the logo, the registered trademark including trade dress and the colour combination thereof and any other mark deceptively similar thereto.

It was contended by the plaintiff No. 1 that they are the registered proprietor of trademarks in relation to the unique Green and Yellow colour scheme and logo. The plaintiffs further contended that the manner of use of colour combination by the defendants is deceptively similar to that of the plaintiffs and such deceptively similar adoption by the defendants (of the plaintiffs' trademark and trade dress) is bound to confuse the consumers. The Court, upholding the contentions of the plaintiffs, held that the colour/colour-combination can be treated as trademarks if these are distinctive and exclusively associated with the trader, and accordingly granted an interim injunction in favour of the plaintiffs.

Educare Ltd. v S.K. Sachdev

The plaintiff claims to have been using the trademark ‘Shri Ram School’, in relation to educational institutions, since the year 1988. The plaintiff claims that its mark has established tremendous goodwill and reputation. The plaintiff has filed a trademark registration for ShriRam School in 2008 (No.1696277 in Class 41) which is still pending.

The plaintiff recently came to know that the defendant has started using the mark ShreeRam World School in relation to its educational institution and has also adopted the domain name ‘www.shreeram.in’.

The plaintiff contended that there was phonetic and conceptual similarity between the plaintiff's and defendant's marks. The plaintiff further contended that the defendant was not a concurrent user of the mark as he adopted the mark in the year 2001 whereas the plaintiff's mark is in use since the year 1988. Also, the plaintiff contended that the adoption of the mark by the defendant was dishonest as the defendant was not a new entrant to the field of education. The plaintiff stressed on the alleged dishonest adoption of the mark by the defendant by claiming that the defendant's website (www.shreeram.in) was silent on the particulars of the management of the school in comparison to its other websites where such details were prominently displayed.

Defendant disputed the plaintiff's prayer for injunction stating that the plaintiff had concealed material facts related to the trademark application. The defendant argued that the fact that the mark ‘SHRI RAM’ was common to the field of schools and education, and the mark being the name of a Hindu deity, generally used by Hindus for their business ventures, had made the mark *publici juris*.

After hearing the plaintiff's counter to the defendant's arguments, the court rejected the arguments of the defendant and allowed the injunction against the defendant to continue.

Proctor & Gamble Manufacturing v. Anchor Health & Beauty Care Pvt. Ltd.

Supreme Court of India dismissed the SLP filed by the petitioner and upheld the decision given by the Division Bench of the Delhi High Court.

The Division Bench of the Delhi High Court had ruled on two issues. First issue was whether the plaintiff's mark ‘ALLROUND PROTECTION’ was descriptive. To which, the Division Bench ruled that ‘ALLROUND PROTECTION’ cannot be stated to be descriptive because it possibly describes the quality



or property or functionality of the toothpaste, as such description is specific to the product. The second issue was whether 'ALLROUND PROTECTION' was the primary trademark of the plaintiff. To which, the Division Bench stated that an argument based on primary trademark renders the process of advertising redundant. Therefore, it ruled that the plaintiff can have two trademarks 'ANCHOR' and 'ALLROUND PROTECTION' which co-exist in relation to the same product.

M/s Sandisk Corporation v. John Doe/s (I.A.20550/2014 in CS(OS) 3205/2014 High Court of Delhi, October 17, 2015)

In another instance highlighting the recent trend of the Indian judiciary granting "John Doe orders", the Delhi High Court granted a John Doe order in favour of SanDisk Corporation and against unnamed persons, the world's largest provider of flash memory storage devices under the name SanDisk.

In the instant case, the plaintiffs SanDisk had contended that, certain unknown persons were initially selling counterfeit products under the SANDISK mark from Daryaganj, Old Delhi. After SanDisk obtained an injunction, these persons started selling counterfeits at temporary Sunday markets at Daryaganj, Old Delhi. However, SanDisk contented that it was impossible to identify the names of such persons as they were majorly impermanent operators, who sold counterfeit products and thereafter vanished to avoid the orders of injunction.

The plaintiffs had also prayed for appointment of three Local Commissioners under Order XXVI Rule 9 of CPC to visit the make-shift locations of such unnamed and undisclosed persons at Daryaganj market or such other place.

The Court granted relief to the plaintiff and appointed three Local Commissioners to seize and take into possession the counterfeit memory cards bearing SANDISK mark and make a list of particulars of those persons who were found in possession of such counterfeit products.

Shamnad Basheer vs. Union of Indian & Ors (Madras High Court, March 10, 2015): Independence of Tribunals Affirmed

In a recent judgment, Madras High Court declared certain provisions of the Trademarks Act providing for the establishment of the IPAB (Intellectual Property Appellate Board) as unconstitutional. The court held that the section providing for Indian Legal Service officers to be elected as judicial members to the tribunal was invalid in law.

Supreme Court of India in *Union of India vs. R. Gandhi* (2010), looked at the working of tribunals closely. It said that when the existing jurisdiction of a court is transferred to a tribunal, its members should be persons of a rank, capacity and status as nearly as possible equal to the rank, status and capacity of the court which was till then dealing with such matters. It wanted only persons with a judicial background, that is, those who have been or are Judges of the High Court, and lawyers with the prescribed experience, who are eligible for appointment as High Court Judges, to be considered for appointment as judicial members.

In this writ petition before the Madras High Court, one of the prayers was that the *R. Gandhi* directions be followed.

The Madras High Court also held that any committee constituted to select members to IPAB should compulsorily be predominated by judges or those with requisite judicial qualifications.

Finally, the court held that a technical member in order to become a Vice Chairman or a Chairman of IPAB, is required to have judicial qualifications.

B3. OFFICIAL PRACTICE

3. Please provide details of any changes in official patent and trade mark office practice which would be of general interest to other members.



Design:

- Office of Controller General of Patents, Designs & Trade Marks has introduced electronic filing system for the new applications for registration of Designs on March 09, 2015.
- Controller General of Patents, Designs & Trade Marks on January 27, 2015 launched the [Designs application search utility](#) in an effort at enhancing transparency in governance. Under Design application search utility, it will be possible to search for designs using various fields such as Application Number, Applicant Name, Date of filing, Classification, Applicant Country, Priority Number, Priority Country, Priority Number etc.

Patent:

- On 27 February, 2015, the Controller General of Patents, Designs & Trade Marks has announced the introduction of a new search tool named INPASS. The INPASS allows full-text search to be conducted for patents as well as patent applications, allowing for search using wild-cards, truncation and Boolean operators. This enables the stakeholders to conduct an advanced search in the Indian Patent Database. With this, the IPAIRS has now officially been withdrawn.
- A public notice dated February 18, 2015 was released by the Indian Patent Office, informing the applicants that physical copies of the documents filed online are not required to be filed again at the office counter, except the following documents for which the originals are also to be filed at the respective Patent Office:
 - Power of Attorney
 - Proof of right
 - Assignments
 - Certified copies
 - Certified copy of translations
 - License agreements
 - Mortgages
 - Any other notarized document
- The Controller General launched Online Cause List of cases in Hearing for Patents at Patent Office Delhi on January 1, 2015.
- International applications filed to the Indian Patent Office as Receiving Office under the Patent Cooperation Treaty may be filed electronically using ePCT with effect from 15th November 2014.
- Controller General of Patents, Designs & Trade Marks launched "Guidelines for examination of patent applications in the field of Pharmaceuticals after extensive consultation with stakeholders on October 29, 2014.

Trademarks:

- A special drive for disposal of opposition/rectification matters on the basis of requests for withdrawal made therein was conducted by the Trademarks Registry from February 9, 2015 to February 13, 2015 and from February 18, 2015 to February 20, 2015.
- CGPDTM has released 'A draft Manual of Trade Marks Practice & Procedure' for public comments and suggestions on March 11, 2015.

B4. PROPOSALS FOR CHANGES

4. Please provide details of any proposed changes in IP laws or practice and indicate if your National Association/Section is involved in providing comments to such changes. Would it be of assistance to have input from the CET on any proposed changes?



- I. The Indian Patent Office has published a new comprehensive search and examination guidelines encompassing all areas of technology and reflecting the office practice, for which the Controller General has asked the comments from the stakeholders. Comments/suggestions, if any, on the same may be sent to the office of the Controller General of Patents, Designs and Trade Marks latest by 25th March 2015.
 - II. The IPR Think Tank set up by the Government of India submitted its first Draft of the National IPR Policy on 19th December, 2014. In the proposed IPR Policy, it has been mentioned that steps will be taken to:
 - Restructure, upgrade and grant adequate autonomy to IPOs.
 - Augment manpower.
 - Establish close cooperation between IPOs.
 - The office of CGPDTM will
 - fix and adhere to timelines for grant of registrations and disposal of opposition matters;
 - Ensure that public records in the IP office are easily available and accessible both online and offline.
 - Remove disparities among different branches of IPO and adopt standardized procedures.
 - Facilitate IP dispute resolution through different measures including:
 - Recommending designation of a specialized patent bench in High Courts
 - Promoting Alternate Dispute Resolution.
 - Creating regional benches of IPAB.
 - To fill gaps in the protective regime of IPRs such as Utility Models and Trade Secrets;
 - Facilitate creation and protection of 'small inventions' through a new law on utility models;
 - Identify important areas of study and research for future policy development, such as:
 - Protection of undisclosed information not extending to data exclusivity; Exhaustion of IP Rights.
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SECTION C: OTHER INFORMATION

Please provide details of any other information pertaining to your country or region that would be of general interest to FICPI members and other IP practitioners browsing FICPI's website.

C1. QUALIFICATION AND THE RIGHT TO REPRESENT CLIENTS BEFORE A COURT

- 1.1 Please describe the qualification process for becoming a patent attorney in your country/region.

Indian Patents Act does not define the term "Patent Attorney". Indian Patents Act allows "Patent Agent" and "Advocate" to represent an Applicant before the Indian Patent Office. However, an Advocate cannot sign any documents to be submitted in India Patent Office. Only a Patent Agent is eligible to sign patent applications to be submitted in the Indian patent office.

Section 126 of the Indian Patents Act prescribes qualification to be registered as patent agents.

Section 126: Qualifications for registration as patent agents

(1) A person shall be qualified to have his name entered in the register of patent agents if he fulfils the following conditions, namely:-

he is a citizen of India;

he has completed the age of 21 years;

he has obtained a degree in science, engineering or technology from any university established under law for the time being in force in the territory of India or possesses such other equivalent qualifications as the Central Government may specify in this behalf, and, in addition,—

(i) [Omitted]

(ii) has passed the qualifying examination prescribed for the purpose; or

(iii) has, for a total period of not less than ten years, functioned either as an examiner or discharged the functions of the Controller under section 73 or both, but ceased to hold any such capacity at the time of making the application for registration; he has paid such fee as may be prescribed.

- 1.2 Has the patent attorney qualification process changed in any way in the past 5 years?

NO

- 1.3 Does qualification as a patent attorney permit you any right of representation before any Court in your country?

NO

- 1.4 If so are there any special requirements or restrictions?

One has to be an Advocate registered with Bar Council and is required to pass All Indian Bar Exam to represent before a court of law.

- 1.5 Are qualified lawyers in your country permitted to work in the patent field without any further qualification?

An advocate in India is permitted to represent a patent case at the IPAB and a court of law without further qualifications as well as appear before the Controller of Patents during hearing as per Section 132(b) of Indian Patents Act.

If so are there any restrictions on what they may do?

An advocate can represent before the IPAB and the Controller of Patents during hearing but cannot sign a document to be submitted in the Indian Patent Office.



If so, please describe those restrictions.

- 1.6 Please describe what privilege attaches to patent attorney communications including any restrictions.

Indian Patents Act, 1970 does not provide for privileges attached to a Patent Agent and client communication. Therefore, statutory provisions as contained in Indian Evidence Act, 1872 shall apply to such communication.

Sections 126 to 129 of the Indian Evidence Act, 1872 deals with privileges attached to professional communication between an attorney and his client. Section 126 provides that "No barrister, attorney, pleader or vakil shall at any time be permitted, unless with his client's express consent, to disclose any communication made to him in the course and for the purpose of his employment as such barrister, pleader, attorney or vakil, by or on behalf of his client, or to state the contents or condition of any document with which he has become acquainted in the course and for the purpose of his professional employment, or to disclose any advice given by him to his client in the course and for the purpose of such employment." Section 127 provides "The provisions of section 126 shall apply to interpreters, and the clerks or servants of barristers, pleaders, attorneys, and vakils".

However, proviso of Section 126 of the Indian Evidence Act, 1872 provides certain exceptions to the client attorney privilege. These exceptions include:

1. Any such communication made in furtherance of any illegal purpose; illegal purpose;
2. Any fact observed by any barrister, pleader, attorney or vakil, in the course of his employment as such, showing that any crime or fraud has been committed since the commencement of his employment.

- 1.7 Please describe the qualification process for becoming a trade mark attorney in your country/region.

The following can work as a trade mark attorney:

1. An advocate
2. A person who has passed the trademark agent examination conducted by the Trade mark registry.

- 1.8 Has the trade mark attorney qualification process changed in any way in the past 5 years?

NO

- 1.9 Does qualification as a trade mark attorney permit you any right of representation before any Court in your country?

A trade mark attorney, who is not an advocate, cannot represent before a court.

If so are there any special requirements or restrictions?

One has to be an Advocate registered with Bar Council and is required to pass All Indian Bar Exam to represent before a court of law.

- 1.10 Are qualified lawyers in your country permitted to work in the trade mark field without any further qualification?

YES

If so are there any restrictions on what they may do?

If so, please describe those restrictions.

- 1.11 Please describe what privilege attaches to trade mark attorney client communications including any restrictions.

Indian Trade Marks Act, 1999 does not provide for privileges attached to trademark attorney



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2. Any fact observed by any barrister, pleader, attorney or vakil, in the course of his employment as such, showing that any crime or fraud has been committed since the commencement of his employment.

C.2 CET AND PEC SPEAKERS

- 2.1 Would your National Section/Association be interested in obtaining assistance from FICPI, through either the CET Work and Study Group or the Professional Excellence Commission (PEC), in providing speakers for seminars organized by your national group in your country?
- 2.2 If your group does, or in the future might, require such assistance, please identify topics that might be of interest to your members, with a view to raising FICPI’s profile and providing added value from membership of FICPI in your country.

C.3 TOPICS OF INTEREST

- 3.1 Please list three IP topics that are of particular interest to you and/or your national section members.

Delay in prosecution of patent application and more particularly with regard to non issuance of first examination report within the stipulated time period.

Non adherence of 12 months deadline to place the Application in order for grant.

Delay in disposal of pre-grant and post grant oppositions.

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