

Pharmacyclics Llc vs Union Of India And Ors. on 20 November, 2019

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Bench: Prathiba M. Singh

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* IN THE HIGH COURT OF DELHI AT NEW DELHI
Date of decision: 20th November, 2019
+ W.P.(C) 12105/2019 & CM APPLs. 49593/2019, 49594/2019, 49595/2019
PHARMACYCLICS LLC Petitioner
Through: Mr. Pravin Anand, Ms. Archana
Shanker, Mr. Dhruv Anand & Ms.
Udita Patro, Advocates (M-9313399860)
versus
UNION OF INDIA AND ORS. Respondents
Through: Ms. Maninder Acharya, ASG with
Mr. Kirtiman Singh, CGSC, Mr.
Harshal Choudhary, Ms. Ikshita
Singh & Mr. Viplav Acharya,
Advocates for UOI (M-9650009641)
Ms. Rajeshwari H., Mr. Saif Rahman
Ansari & Mr. Swapnil Gaur,
Advocates for R-3 (M-7409531351)
CORAM:
JUSTICE PRATHIBA M. SINGH
Prathiba M. Singh, J. (Oral)

1. The present petition has been filed challenging the impugned order dated 6th November, 2019, passed by the Joint Controller of Patents and Designs (hereinafter, "Controller"), by which the Petitioner s/Patentee s (hereinafter, "Patentee") interlocutory petition, seeking rejection of Respondent No.3 s/Opponent s (hereinafter, "Opponent") documents and evidence, has been dismissed, and the matter has been fixed for final hearing of the post-grant opposition on 22nd November, 2019.

2. The brief background is that the Patentee was granted Indian Patent No.262968. The publication of the grant took place on 3rd October, 2014. On 24th September, 2015, the Opponent - M/s. Laurus Lab Pvt. Ltd. filed a post- grant opposition under Section 25(2) of the Patents Act, 1970 (hereinafter, "Act"), along with the evidence of Dr. CH. V. Ramana Rao, the Opponent s Head of the Intellectual Property Management Division. The Patentee filed its response to the said opposition, along with the evidence of an expert Dr. Alexander James Bridges, on 23rd December, 2015.

3. The Opposition Board, which was constituted by the Controller, thereafter, submitted its recommendation. The said recommendation was forwarded to the parties on 14th September, 2017, and the matter was fixed for hearing on 16th November, 2017. The Opponent filed a request for adjournment of the hearing scheduled on 16 November, 2017 on the ground of personal difficulty.

4. Vide notice dated 14th August, 2019, the hearing in the post-grant opposition was fixed for 25th September, 2019. At that stage, a flurry of activity took place, wherein the Opponent sought to file additional documents on 10th September, 2019, and further evidence on 19th September, 2019. In view of the fresh documents and evidence filed, and due to difficulty of counsel, the Patentee sought an adjournment of the hearing scheduled on 25th September, 2019.

5. Thereafter, the Patentee took the position that the fresh documents and evidence filed by the Opponent ought not to be taken on record, as the same were belatedly filed and contrary to the Patents Rules, 2003 (hereinafter, "Rules"). Miscellaneous petitions praying for the additional documents/evidence to not be taken on record, were filed by the Patentee.

6. The interlocutory petition was heard, and vide order dated 6th November, 2019, the Controller has come to the conclusion that the documents and evidence filed by the Opponent would be taken on record, and would be considered at the time of final adjudication. The Patentee sought an adjournment on 7th November, 2019, and the matter has remained pending since then. In the meantime, the Patentee has also filed a response to the additional documents/evidence filed by the Opponent.

7. The grievance of the Patentee is that there is a scheme which is prescribed under the Rules, read with Section 25(2) to (4) of the Act. The Controller has given this scheme a go-by, and the post-grant opposition, despite being pending since 2015, has still not been decided by the Controller. Ld. counsel submits that a perusal of Rules 55A to 62 reveals that there is a particular procedure that has to be followed, and at every stage, timelines have been provided in order to ensure that there is no delay in the decision of the post-grant opposition. It is further submitted that even though Rules 137 and 138 give leeway for taking evidence on record even at a later stage, the same ought not to be exercised in a manner detrimental to the Patentee's interest. On behalf of the Patentee, it has been submitted that the phrase "at the hearing" in Rule 62(4) should be interpreted as the first hearing and not subsequent hearings, inasmuch as adjournments are being sought by Opponent before the Patent Office and the period of adjournment is being used to file fresh documents and evidence. Thus, it is submitted that evidence and documents should be frozen once the first date of hearing is fixed. If, for any reason, the hearing is adjourned, further evidence ought not to be permitted.

8. It is further submitted that under Rule 62(4), if any publication is sought to be relied upon, sufficient cause has to be shown as to why it could not be filed earlier, though discretion would still lie with the Controller to decide whether the publication ought to be taken on record or not. In order to ensure that publications which are filed at a late stage, i.e., just five days before the hearing, do not derail the hearing, the relevant portions of these publications ought to be highlighted at the time when service is made, in order to ensure that the party served is not put through the rigour of examining the document end-to-end at such short notice.

9. Finally, it is urged that when documents and evidence, especially under Rule 59, are filed, the same should be confined to the Patentee's evidence and anything beyond the Patentee's evidence ought not to be taken on record.

10. On the other hand, ld. counsel for the Opponent submits that a perusal of Rule 60, as also Rule 62 (4), shows that even 5 days prior to the hearing date, fresh publications can be relied upon by the Opponent. Ld. counsel further submits that the Controller can also grant leave for filing of evidence under Rules 60 and 137. It is further submitted that the scheme governing post-grant opposition is not strict, as in the Commercial Courts Act, 2015, and the purpose of the Rules is to enable documents, if relevant for deciding the validity of the patent, to be taken on record right till the culmination of the proceedings. Ld. counsel for Opponent, submits that the scheme of the Act vests enormous discretion in the Controller to decide as to which documents ought to be taken on record and at what stage. Ld. counsel urges that the nature of grounds which are raised by the Opponent for opposing the grant of patents being quite broad in nature, for example, prior public use, source of original biological material, prior knowledge, etc., collection of documents and evidence is a continuous process which ought to be flexible till the final hearing is concluded before the Controller.

11. It is submitted that instead of reducing the discretion of the Controller, who is hearing the post-grant opposition, as in the EU, an overall time-limit can be fixed for deciding the post-grant opposition, instead of micro-managing the same at every stage. Reliance is placed on the guidelines passed by the European Patent Office, dated 1st July, 2016, according to which opposition cases should be attempted to be disposed of in around 15 months.

12. Ld. counsel further submits that in the European Patent Office, even at the stage of oral hearing of the opposition, fresh documents are permitted to be relied upon by the parties. Ld. counsel relies upon the document titled "Opposition System" published by WIPO, which also permits filing of documents in an opposition proceeding at a late stage.

13. Reliance is also placed on the opposition procedure document published by WIPO, to submit that even WIPO records the role that an opposition plays in the patenting system and submits that usually a 6 to 12-month period is the duration in which the oppositions are to be decided.

14. It is further urged that the Controller always has the discretion to impose costs, even heavy costs, under Section 77, if a party is unreasonably delaying the matter by filing documents, or for whatever reason, including taking of adjournments.

15. The ld. ASG, submits that under Rule 129A, the number of adjournments that can be granted have already been curbed and the said provision itself takes care of the apprehension of the Patentee that the matter would be indefinitely adjourned and delayed.

16. In rejoinder, it is submitted by ld. counsel for the Petitioner that the application moved in this case for taking on record additional documents does not give any valid or plausible reasons for not filing the same at the first stage. He further submits that the Rules ought to be interpreted in a

manner so as to bar filing of documents and evidence once notice of hearing is issued. Adjournment of hearing cannot re-open the timelines under Rules 60 and 62.

Analysis and Conclusions

17. Under the existing scheme of the Patents Act, 1970 (hereinafter referred to as the "Act", oppositions can be filed at two stages i.e. at the pre- grant stage - i.e., before the grant of patent and at the post-grant stage - i.e., after the grant of patent. The grounds for filing pre-grant oppositions are stipulated in Section 25(1) of the Act. The grounds for filing post-grant oppositions are stipulated in Section 25(2) of the Act. A pre-grant opposition can be filed by any person whereas a post-grant opposition can be filed by any "person interested". Sections 25(2) to (6) dealing with post-grant oppositions are reproduced herein below:

The Patents Act, 1970 "25. Opposition to the patent.--

(2) At any time after the grant of patent but before the expiry of a period of one year from the date of publication of grant of a patent, any person interested may give notice of opposition to the Controller in the prescribed manner on any of the following grounds, namely:--

(a) that the patentee or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims; (b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim--

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document:

Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 29;

(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the claim of the patentee and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the claim of the patentee;

(d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

Explanation.--For the purposes of this clause, an invention relating to a process for which a patent is granted shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only;

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the applicant's claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(h) that the patentee has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge;

(i) that in the case of a patent granted on a convention application, the application for patent was not made within twelve months from the date of the first application for protection for the invention made in a convention country or in India by the patentee or a person from whom he derives title;

(j) that the complete specification does not disclose or wrongly mentions the source and geographical origin of biological material used for the invention;

(k) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere, but on no other ground.

(3) (a) Where any such notice of opposition is duly given under sub-section (2), the Controller shall notify the patentee.

(b) On receipt of such notice of opposition, the Controller shall, by order in writing, constitute a Board to be known as the Opposition Board consisting of such officers as he may determine and refer such notice of opposition along with the documents to that Board for examination and submission of its recommendations to the Controller.

(c) Every Opposition Board constituted under clause

(b) shall conduct the examination in accordance with such procedure as may be prescribed.

(4) On receipt of the recommendation of the Opposition Board and after giving the patentee and the opponent an opportunity of being heard, the Controller shall order either to maintain or to amend

or to revoke the patent.

(5) While passing an order under sub-section (4) in respect of the ground mentioned in clause (d) or clause

(e) of sub-section (2), the Controller shall not take into account any personal document or secret trial or secret use.

(6) In case the Controller issues an order under sub-section (4) that the patent shall be maintained subject to amendment of the specification or any other document, the patent shall stand amended accordingly. .."

18. The Rules governing oppositions are Rules 55 to 63. The Rules are relevant and are reproduced hereinbelow:

"The Patents Rules, 2003 ..

CHAPTER VI OPPOSITION PROCEEDINGS TO GRANT OF PATENTS

55. Opposition to the patent.□(1) Representation for opposition under sub-section (1) of section 25 shall be filed in Form 7(A) at the appropriate office with a copy to the applicant, and shall include a statement and evidence, if any, in support of the representation and a request for hearing, if so desired.

(1A) notwithstanding anything contained in sub-rule (1), 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.

(2) The Controller shall consider such representation only when a request for examination of the application has been filed.

(3) On consideration of the representation if the Controller is of the opinion that application for patent shall be refused or the complete specification requires amendment, he shall give a notice to the applicant to that effect.

(4) On receiving the notice under sub-rule (3), the applicant shall, if he so desires, file his statement and evidence, if any, in support of his application within three months from the date of the notice, with a copy to the opponent.

(5) On consideration of the statement and evidence filed by the applicant, the representation including the statement and evidence filed by the opponent, submissions made by the parties, and after hearing the parties, if so requested, the Controller may either reject the representation or require the complete specification and other documents to be amended to his satisfaction before the patent is granted or

refuse to grant a patent on the application, by passing a speaking order to simultaneously decide on the application and the representation ordinarily within one month from the completion of above proceedings.

55A. Filing of notice of opposition.-- The notice of opposition to be given under subsection (2) of section 25 shall be made in Form 7 and sent to the Controller in duplicate at the appropriate office.

56. Constitution of Opposition Board and its proceeding.--(1) on receipt of notice of opposition under rule 55A, the Controller shall, by order, constitute an Opposition Board consisting of three members and nominate one of the members as the Chairman of the Board.

(2) An examiner appointed under sub-section (2) of section 73 shall be eligible to be a member of the Opposition Board.

(3) The examiner, who has dealt with the application for patent during the proceeding for grant of patent thereon shall not be eligible as member of Opposition Board as specified in sub-rule (2) for that application. (4) The Opposition Board shall conduct the examination of the notice of opposition along with documents filed under rules 57 to 60 referred to under sub-section (3) of section 25, submit a report with reasons on each ground taken in the notice of opposition with its joint recommendation within three months from the date on which the documents were forwarded to them.

57. Filing of written statement of opposition and evidence.-- The opponent shall send a written statement in duplicate setting out the nature of the opponent's interest, the facts upon which he bases his case and relief which he seeks and evidence, if any, along with notice of opposition and shall deliver to the patentee a copy of the statement and the evidence, if any.

58. Filing of reply statement and evidence.--(1) If the patentee desires to contest the opposition, he shall leave at the appropriate office a reply statement setting out fully the grounds upon which the opposition is contested and evidence if any, in support of his case within a period of two months from the date of receipt of the copy of the written statement and opponent's evidence, if any by him under rule 57 and deliver to the opponent a copy thereof.

(2) If the patentee does not desire to contest or leave his reply and evidence within the period as specified in sub-rule (1), the patent shall be deemed to have been revoked.

59. Filing of reply evidence by opponent.--The opponent may, within one month from the date of delivery to him of a copy of the patentee's reply statement and evidence under rule 58, leave at the appropriate office evidence in reply strictly confined to matters in the patentee's evidence and shall deliver to the patentee a copy of such evidence.

60. Further evidence to be left with the leave of the Controller.--No further evidence shall be delivered by either party except with the leave or directions of the Controller:

Provided that such leave or direction is prayed before the Controller has fixed the hearing under rule 62.

61. Copies of documents to be supplied.--(1) Copies of all documents referred to in the notice of opposition or in any statement or evidence filed in connection with the opposition and authenticated to the satisfaction of the Controller, shall be simultaneously furnished in duplicate unless the Controller otherwise directs. (2) Where a specification or other document in a language other than English is referred to in the notice, statement or evidence, an attested translation thereof, in duplicate, in English shall be furnished along with such notice, statement or evidence, as the case may be.

62. Hearing.--(1) On the completion of the presentation of evidence, if any, and on receiving the recommendation of Opposition Board or at such other time as the Controller may think fit, he shall fix a date and time for the hearing of the opposition and shall give the parties not less than ten days' notice of such hearing and may require members of Opposition Board to be present in the hearing.

(2) If either party to the proceeding desires to be heard, he shall inform the Controller by a notice along with the fee as specified in the First Schedule.

(3) The Controller may refuse to hear any party who has not given notice under sub-rule (2).

(4) If either party intends to rely on any publication at the hearing not already mentioned in the notice, statement or evidence, he shall give to the other party and to the Controller not less than five days' notice of his intention, together with details of such publication. (5) After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing, and after taking into consideration the recommendation of Opposition Board, the Controller shall decide the opposition and notify his decision to the parties giving reasons therefor.

63. Determination of costs. -- If the patentee notifies the Controller that he desires to withdraw the patent after notice of opposition is given, the Controller, depending on the merits of the case, may decide whether costs should be awarded to the opponent."

19. While considering the scheme of the Act, the Supreme Court in *J. Mitra and Co. Pvt. Ltd v. Asst. Controller of Patents and Designs* And Ors AIR 2009 SC 405, held as under:

"22. Applying the above tests to the present case, we find that by Patents (Amendment) Act, 2005 for the first time a dichotomy was inserted in the Patent Law by providing vide Section 25(1) for "opposition to pre- grant" and vide Section 25(2) for "opposition to post- grant" of patent.... Previously, there was no "post- grant opposition.... There is, however, a radical shift due to incorporation of Section 25(2) where an interested party is granted the right to challenge the patent after its grant....However, Section 25(1) is wider than Section 25(2) as the latter is available only to a "person aggrieved". The main difference between Section 25(1) and Section 25(2), as brought about by Patents (Amendment) Act, 2005, is that even after a

patent is granted, "post-grant opposition" can be filed under Section 25(2) for a period of one year. The reason is obvious. In relation to patents that are of recent origin, a higher scrutiny is necessary. This is the main rationale underlying Section 25(2) of the said 1970 Act. Therefore, the Legislature intended an appeal under Section 117A(2) to the Appellate Board from any decision, order or direction of the Controller, inter alia, under Section 25(4) [which refers to the power of the Controller to maintain, amend or revoke the patent]."

20. This was reiterated in *Snehlati C. Gupte vs. Union of India (UOI) and Ors.* 2010 (43) PTC 813 (Del). A pre-grant opposition is in aid of the examination of the application as held in *UCB Farchim SA and Ors. v. Cipla Ltd. and Ors.* 167(2010) DLT 459 where the High Court has held as under:

"..Distinction between pre-grant and post-grant opposition

13. In the first instance a distinction has to be drawn between a pre-grant opposition and a post-grant opposition. While a pre-grant opposition can be filed under Section 25(1) of the Patents Act at any time after the publication of the patent application but before the grant of a patent, a post-grant opposition under Section 25(2) of the Patents Act has to be filed before the expiry of one year from the date of the publication of the grant of patent. A second significant difference, after the amendment of 2005, is that a pre-grant opposition can be filed by any person. whereas a post- grant opposition under Section 25(2) can be filed only by any person interested.. It may be noticed that the application for revocation of a patent in terms of Section 64 of the Patents Act can also to be filed only by any person interested.. In other words, the post- grant opposition and the application for revocation cannot be filed by just about any person who is not shown to be a person who is interested. A third significant difference is that the representation at the stage of pre-grant is considered by the Controller himself. Rule 55 of the Patents Rules requires the Controller to consider the statement and evidence filed by the applicant. and thereafter either refuse to grant the patent or require the complete specification to be amended to his satisfaction. Of course, in that event notice will be given to the applicant for grant of patent who can file his reply and evidence. This Court finds merit in the contention that the pre-grant opposition is in fact in aid of the examination of the patent application by the Controller. The procedure is however different aspect as far as the post-grant opposition is concerned. There in terms of Section 25(3), the Controller has to constitute an Opposition Board consisting of such officers as he may determine and refer to such Opposition Board the notice of opposition along with other documents for its examination and recommendations. After receiving the recommendations of the Opposition Board, the Controller gives the patentee and the opponent an opportunity of being heard. The Controller then takes a decision to maintain, amend or revoke the patent. The fourth major difference between the pre-grant and the post-grant opposition is that while in terms of Section 117A an appeal to the IPAB is maintainable against the order of the Controller in a post-grant opposition under Section 25(4) of the Patents Act, an appeal has not been

expressly been made available against an order made under Section 25(1) of the Patents Act."

21. In *Aloys Wobben v. Yogesh Mehra*, (2014) 15 SCC 360, the Supreme Court considered in detail the procedures relating to post-grant oppositions and the overlapping nature of jurisdiction of the IPAB and the High Courts. It held:

"..17. When a challenge is raised at the pre-grant stage, under Section 25(1) of the Patents Act, the same is liable to be determined at the hands of the "Controller". An order passed by the "Controller"

can be assailed by way of an appeal before the "Appellate Board". When a challenge is raised under Section 25(2), it must be raised within one year of the publication of the grant (of patent). The same has to be examined, in the first instance, by an "Opposition Board" contemplated under Section 25(3). The recommendations made by the "Opposition Board"

are then to be placed before the "Controller" for consideration. After issuing notice to the patent-holder, and after affording an opportunity of hearing to the patent-holder, the "Controller" is required to pass the final order, on a notice of opposition filed under Section 25(2). Such order passed by the "Controller"

is assailable by way of an appeal, before the "Appellate Board". A challenge raised by "any person interested", under Section 64(1), is liable to be adjudicated, at the very first instance, by the "Appellate Board". If in response to an "infringement suit", the defendant files a "counterclaim" seeking the revocation of the patent concerned, the said process of adjudication would lie before the jurisdictional High Court [see the proviso to Sections 64(1) and 104 of the Patents Act]."

22. In *Cipla Ltd. v. Union of India*, (2012) 13 SCC 429 the Supreme Court elaborated on the role of the Opposition Board and observed as under:

"10. The procedure to be followed by the Controller is provided in Rule 62 of the Rules, which reads as follows:

"62.Hearing.--(1) On the completion of the presentation of evidence, if any, and on receiving the recommendation of Opposition Board or at such other time as the Controller may think fit, he shall fix a date and time for the hearing of the opposition and shall give the parties not less than ten days' notice of such hearing and may require members of Opposition Board to be present in the hearing.

(2) If either party to the proceeding desires to be heard, he shall inform the Controller by a notice along with the fee as specified in the First Schedule. (3) The Controller may refuse to hear any party who has not given notice under sub-rule (2). (4) If either party intends to rely on any publication at the hearing not already mentioned in the notice, statement or evidence, he shall give to the other party and to

the Controller not less than five days' notice of his intention, together with details of such publication. (5) After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing, and after taking into consideration the recommendation of Opposition Board, the Controller shall decide the opposition and notify his decision to the parties giving reasons therefor."

Sub-rule (1) of Rule 62 confers power on the Controller to require members of Opposition Board to be present in the hearing after receiving recommendation of the Opposition Board. The Controller, after hearing the parties if they so desire and after taking into consideration the recommendation of the Opposition Board, has to decide the opposition giving reasons.

23. From the settled judicial precedents quoted above and the provisions of the Act, the difference in the procedures to be followed between pre-grant and post-grant oppositions is well established. A post-grant is a proceeding that can be filed within one year after the publication of the grant of the patent. In a post-grant opposition, upon the filing of the post-grant opposition and the pleadings/evidence being completed, an Opposition Board is constituted which submits recommendations to the Controller. The said recommendations are not binding in nature¹. However, upon receipt of the recommendations of the Board and after giving hearing to the parties, the Controller may -

- 1) maintain the grant; or
- 2) amend the claims; or
- 3) revoke the patent.

24. The Rules however, lay down the detailed procedure to be followed in oppositions. Rule 55 stipulates the procedure to be followed in a pre-grant opposition. Rules 55A to 63 govern post-grant oppositions. Prior to the *Sugen Inc v. Controller General of Patents, Design, Trademark and Geographical Indications* 2013 SCC OnLine IPAB 76 constitution of the Opposition Board under Rule 56, the following steps are to be followed:

- i) The Opponent has to file the written statement of opposition (`Opposition) along with his evidence;
- ii) The Patentee, if it wishes to contest the opposition has to file the reply statement (`Patentee s Reply) along with its evidence within a period of two months after receiving the opponent s opposition. If the patentee does not contest or file a reply/evidence, the patent would be deemed to be revoked;
- iii) Upon the Patentee filing its reply statement, the opponent has the opportunity to file the reply evidence (hereinafter „Opponent s Rejoinder) within one month upon receiving the patentee s reply.

However, the said rejoinder would have to be strictly confined to the matters which have been raised in the patentee's evidence. Thus, there is no permissibility for the opponent to expand the scope of the rejoinder beyond the reply filed by the Patentee;

iv) The Opposition Board constituted under Rule 56 would then consider all the documents filed by the parties and submit a report along with its joint recommendation to the Controller. Thus, the scheme of the Rules envisages that the Opposition Board ought to consider all the pleadings and documents prior to giving its recommendations. Further, the timelines which have been stipulated in the Rules also show that the same ought to be followed strictly. From the time when the patent is granted, therefore, the expectation would be that if a post-grant opposition is filed, the same would be decided in an expeditious manner.

25. Rule 61 requires that all the documents which are filed are done so in duplicate in order to ensure that the Opposition Board and the Controller have their respective copies of all the filings. Subsequent to the completion of presentation of evidence and after receiving the recommendations of the Opposition Board, a hearing is fixed under Rule 62. The notice of hearing would be issued and delivered to parties at least ten days prior to the hearing. At the hearing, the Controller may require Members of the Opposition Board to be present at the hearing. If either of the parties wishes to be heard, the fee would be paid to the Controller along with giving a notice. If no notice is received for a party to attend the hearing, the Controller can decide the opposition without a hearing but the order shall however contain the reasons for the decision. However, in oppositions, owing to the nature of the proceedings being adversarial, hearings ought to be granted, unless they are follow-on oppositions.

26. So far, there appears no ambiguity. However, Rules 60 and 62(4) have resulted in ambiguities in view of additional evidence which is sought to be filed by either the Opponent or the Patentee. As per Rule 60, after the completion of the pleadings and documents under Rule 57 to 59, a party is permitted to seek leave for filing of further evidence. Rule 60 provides that such leave can be sought only prior to the hearing being fixed. The language used in the Proviso reads: "Provided that such leave or direction is prayed before the Controller has fixed the hearing under Rule 62"

This makes it clear that filing of additional evidence would be permissible in exceptional cases with the leave or direction of the Controller, but in any event, the said filing can be done only prior to the hearing being fixed under Rule 62. Once the hearing is fixed, thus, parties are not permitted to seek leave to file further evidence.

27. The next window for evidence is provided in view of Rule 62(4) which provides that, five days prior to the hearing, a party can rely upon „any publication“ which may have not been filed earlier, provided five days' notice is given to the other party together with details of such publication.

28. The question that has, therefore, arisen is whether after the completion of the pleadings i.e. Opposition, Patentee's reply and Opponent's rejoinder (Rules 57 to 59) along with the evidence thereof, can any party file further evidence or rely on further documents.

29. On an overall reading of the scheme of Rules 55A to 63, it is clear that the Rules contemplate a two-stage decision making. Stage one is reference to the Opposition Board of all the pleadings and the evidence. Stage two is decision by the Controller which is to be rendered after receiving the recommendations of the Opposition Board and after affording a hearing, if sought. Thus, at the stage of the Controller taking a decision, the Controller is expected to have all the pleadings, documents and evidence relied upon by the parties and the recommendations made by the Board on the basis of the said material and oral submissions by the parties.

30. Thus, it is clear that under usual circumstances, there should not be any variation between the material being considered by the Opposition Board and the Controller. All the material to be relied upon by the parties ought to be presented to the Opposition Board and thereafter to the Controller.

31. Rule 60 provides some leeway to a party to file further evidence with the leave of the Controller. However, once the notice of hearing is given, no further evidence ought to be entertained. This is clear from a reading of Rule 60 which requires that leave for further evidence can be sought "before the Controller has fixed the hearing under Rule 62". As per Rule 60 therefore, even after the recommendations are given by the Opposition Board, it is only prior to the date of hearing being fixed that any party can seek permission to file further evidence. Thus, in the scheme of the Act, it would be always advisable for the Controller to, after receiving the recommendations of the Opposition Board, to fix a hearing expeditiously in order to ensure that there is no long time gap between the recommendations of the Opposition Board and the decision making by the Controller. Further, the filing of further evidence under Rule 60 ought to be permitted only in exceptional cases wherein a party is able to justify the non-filing of the said evidence at the prior stage of Rule 57 to 59. The party seeking to file further evidence would have to give adequate reasons for the non-filing of the same which reasons would be considered by the Controller for granting or rejecting the request.

32. Rule 62(4) gives a final opportunity for any party to rely upon any publication five days prior to the hearing. The use of the word 'publication' in Rule 62(4) is extremely significant. It relates only to a publicly available document and not to any private document such as a lab report, an expert affidavit or any other internal document. A publication would be a document which would have otherwise being publicly available for either of the parties to verify the same. The logic behind use of the word publication in Rule 62(4) is obvious. Whenever patents are filed, there is a clear expectation that patentees would be aware of any publications relating to the said field of technology. Thus, all publications are deemed to be in the knowledge of the patentee. If either the Opponent or Patentee wishes to rely on any publications five days before the hearing, the same is permitted inasmuch as parties are expected to have had knowledge of such publications and hence there would be no surprise to a party. The reason why reliance on such a publication is permitted is to ensure that no patent is wrongly granted or wrongly opposed. Considering that the scheme of the Rules has specific timelines for all the steps that are to be undertaken in a post-grant opposition, it is understood that such reliance on publication would be permissible not in usual but in exceptional cases where a publication was not placed inadvertently or was not within the party's knowledge. In any event, when such a publication is cited, since it has been cited just five days prior to the hearing, the exact portion which is relied upon ought to be highlighted to the other party. The word „details'

in Rule 62(4) would thus mean that the date and name of publication, exact portion of the publication relied upon ought to be pointed out to the opposite party who can, at short notice be able to controvert the same at the hearing.

33. The further evidence under Rule 60, thus, has to be prior to the hearing notice being given. The permission to cite any further documents is restricted to publication five days before the hearing. These two provisions, in the overall scheme of the Act and Rules, ought to be treated as exceptions and not the rule. In respect of any further evidence given by either party under Rule 62 and publication cited at the hearing, the Opposition Board would not have had an opportunity to look at the same. Thus, the presence of the Members of the Opposition Board at the hearing is permitted in order to ensure that these documents are also discussed in the presence of the Opposition Board.

34. The powers of the Controller under Rules 137 and 138 for amendment or extension for a period of one month would have to be viewed in the above context. The said powers being general in nature, the timelines given in Rules 55A to 63 would have to be maintained. Under Rule 138, only a maximum period of one month's extension is possible provided a request for extension is received prior to the expiry of the said period. While there is no doubt that the said power can be exercised by the Controller, the same ought not to be detrimental to any party and be used sparingly. This power, however, would not result in extending the period specified in Rule 62(4) for example, where publications can be cited five days prior to the hearing. If the one month period is read into this provision, the entire purpose of the scheme would be set at naught and thus while under Rule 60 further evidence can be filed, once the notice of hearing is issued, no extension can be granted.

35. The reliance of Rule 129-A by the Id. ASG is apt and supports the above interpretation inasmuch as even under Rule 129-A, a party cannot seek more than two adjournments and the said adjournment cannot be for more than 30 days. Thus, the Act and the Rules require timelines to be adhered to as strictly as possible while providing some leeway to accommodate bona fide requests by any party for either further evidence, documents or adjournments.

36. The reliance by Id. counsel for Opponent, on a practice of the European Patents Office as published in the Official Journal of 2016 and the notification dated 13th June, 2016 also show that at the time of oral hearings, only such documents which are of relevance would be considered. If any relevant document is cited at the time of oral hearing, there shall be a brief interruption to enable the other party to study the submission and any further submissions in respect of the document would be in writing. This procedure is unique to the European Patents Office.

37. However, insofar as post-grant oppositions in India are concerned, any publication which the parties wish to rely upon prior to the hearing would have to be served upon the other party, five days before the hearing. Moreover, a perusal of the notification dated 13th June, 2016 also shows that an overall time limit of 15 months has been prescribed by the EPO for decision of oppositions. If the procedure as prescribed in Rules 55 to 62 is adhered to, even in India, an endeavour could be made to decide post-grant oppositions within 15 months from the date when they are filed. The intention while deciding post-grant oppositions ought to be to ensure expeditious and effective disposal and

not shutting out of any relevant evidence.

38. All these provisions clearly go to show that enormous sanctity is placed on the two-stage decision making process in a post-grant opposition. Since by the time post-grant oppositions are filed and adjudicated, the patent application has already gone through rigorous examination along with pre- grant oppositions, if any, post-grant oppositions are passed through two stages i.e., the Opposition Board and the Controller. The endeavour of all parties and the patent office ought to be ensure that all documents and evidence pass through the two-stage process.

39. Therefore, the following general principles ought to be followed while dealing with a post-grant opposition:

- i) The Opponent and the Patentee have adequate freedom to file their initial pleadings and evidence by relying upon all the documents and expert testimonies that they wish to;
- ii) The Opponent's rejoinder in Rule 59 ought to be strictly confined to the Patentee's evidence;
- iii) Once the Opposition Board is constituted and the material is transmitted to the Board, further evidence is not permissible;
- iv) Under Rule 60, if any further evidence comes to light which either party wishes to rely upon, the same can only be done prior to the issuance of notice of hearing, with the leave of the Controller;
- v) Under Rule 62(4), only publicly available documents i.e. publications, can be considered provided they are served to the opposing party, five days prior to the hearing and the date/time of the publications as also the relevant portions are highlighted, so that the opposite side can deal with the same at the time of hearing. Any document the authenticity of which is in doubt would not be entertained;
- vii) The hearing, in the opposition would be usually granted upon request and Opposition Board Members may also be present in order to elicit their views and assist the Controller in deciding the post-grant oppositions.

40. In this background, the last question that arises is whether, if a hearing is adjourned, further evidence ought to be permitted or not prior to the next hearing. Clearly from the scheme of the Act, filing of further evidence would not be permissible after the first notice of hearing is issued. Thus, in terms of Rule 60, the hearing as contemplated in the said Rule would be the first notice of hearing. Such an interpretation would ensure that parties do not unduly delay the hearing of oppositions by seeking adjournments and utilising the adjourned period to dig up more evidence, especially as such evidence would in any case have not been considered by the Opposition Board.

41. The filing of further evidence prior to the hearing or reliance on publications under Rule 62(4) would not ordinarily permit an adjournment of the hearing. In the Controller's discretion, within a reasonable time, parties may be permitted to support their oral arguments with written submissions which would again be transmitted simultaneously and would not again be treated as documents to which responses can be filed.

42. Though the Rule does not stipulate any timelines for fixing the date of hearing, considering that patent rights have a limited term, the Opposition Board ought to give its recommendations within three months after the final Opponent's rejoinder is received under Rule 59. After the receipt of the recommendations of the Opposition Board, a hearing ought to be fixed within three months thereafter. An endeavour ought to be made by the Patent Office to ensure that post-grant oppositions are decided expeditiously as pendency of post-grant oppositions delays adjudication of infringement suits, if any, in respect of the patent and also keeps the rights of the Patentee under a cloud or in doubt.

43. In the present case, the matter has already been fixed for final hearing on 22nd November, 2019. The Opponent has filed documents and evidence prior to the hearing and the Patentee sought an adjournment of the hearing accordingly. However, now the Patentee has had an opportunity to respond to all the documents and evidence filed by the Opponent - which the Opponent has already done. Thus, this Court does not deem it appropriate to direct non-consideration of the said further evidence filed by the parties. The decision would now be rendered by the Controller after taking into consideration all the pleadings, documents and evidence including the additional evidence filed by the parties on record.

44. For future, the conduct of post-grant oppositions by the Patent office shall be in accordance with the procedures laid down herein. Long pendency of post-grant oppositions can have a cascading effect as it raises a question mark over the validity of the grant of the patent and could also severely delay adjudication of suits for infringement of patent, licensing and other forms of monetization of the patent as the overall term of patent is non-extendable i.e. 20 years. Following the above stipulated procedure would obviate delays in the adjudication of the same.

45. With these observations, the petition and all pending applications are disposed of.

PRATHIBA M. SINGH JUDGE NOVEMBER 20, 2019/DK/Rahul (Corrected and uploaded on 16th December 2019.)