

Managing IP Challenges in India

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1. Context/Overview

- 1.2 Billion people and increasing
 - favorable demographics and increasing income base
- Secured independence from British Government in 1947
- Indian Patents and Designs Act, 1911, (Act II of 1911)
 - 1950 Amendments: Compulsory Licenses
- The Patents Act, 1970
 - Based on studies/deliberations from 1957

2. Patents Act, 1970 (Key Features)

- Four Branches of Patent Office (Delhi, Calcutta, Mumbai, Chennai)
- No product patents for substances intended for use as food, drugs and medicines
- Patent eligible subject matter legislated
- Patent term
 - 14 years from grant date
 - Exception: 7 years for methods/processes for making food/ drug/ medicine
- Compulsory licensing
 - Upon non-working for 3 years from grant of patent; OR
 - Public requirements not met at reasonable price

Patents Act, 1970 Cont..

- Absolute novelty requirement generally
 - One year grace period for
 - Experimental public use or
 - Disclosure in front of a learned society
 - Government approved industrial exhibitions
- Requirement of foreign filing license in case of inventors/companies resident in India and applying for non-India patents
- Duty to disclose information on all non-India filings if India patent application filed for substantially same invention
- Annual reporting of commercial working of the invention in India

3. Patents (Amendment) Act, 1999

- Brought into force retrospectively from 1st January, 1995
- Permitted filing of product patents in the areas of drugs, pharmaceuticals and agro chemicals
- Examination of the patents only after 31st December, 2004
- Exclusive Marketing Rights (EMRs) to Applicants

4. Patents (Amendment) Act, 2002

- Exclusions to Patentable subject matter expanded
 - computer program per se and business methods
 - 'process' for medicinal, curative, diagnostics, etc., for both humans and animals
 - traditional knowledge
- Micro-organisms patent eligible
- Uniform term of 20 years for all patents
- Mandatory publication of applications

Cont..

Patents (Amendment) Oct' 02 cont..

- Establishment of appellate board within the Patent Office
- Request for examination required prior to substantive examination

5. Patents (Amendment) Act, 2005

- Product patents for all fields of technology including food, drugs, chemicals
- Section 3(d): Controversial
 - Does it violate of TRIPs or provide a standard for obviousness?
- Deletion of the provisions relating to Exclusive Marketing Rights (EMRs)

Cont...

Section 3.-- What are not inventions.—

The following are not inventions within the meaning of this Act,--

(d) the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

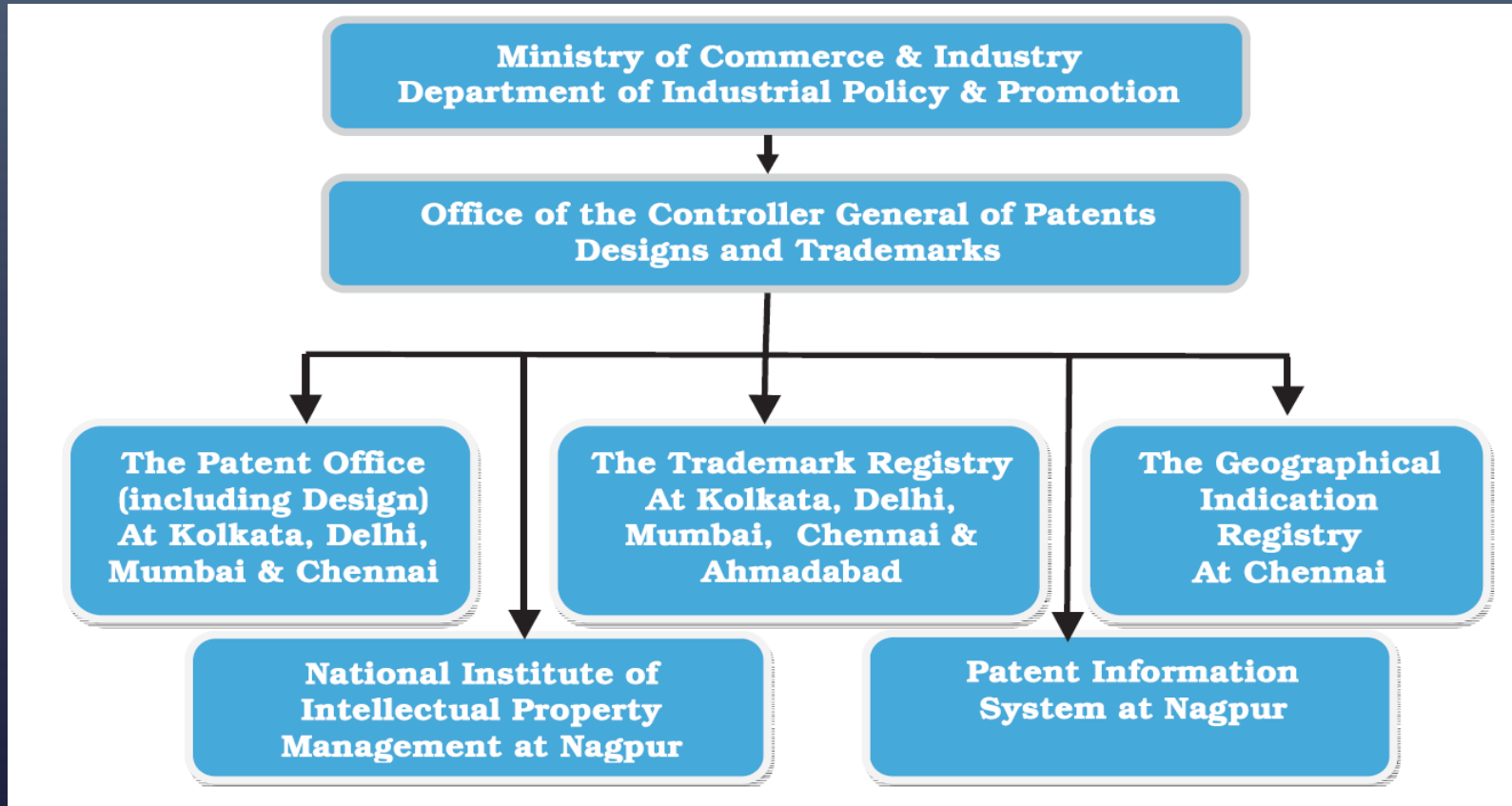
Explanation.--

For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy.

Patents (Amendment) Act, 2005 Cont..

- Compulsory license for export of medicines to countries which have insufficient or no manufacturing capacity to meet emergent public health situations
- Pre-grant oppositions by anyone and post-grant oppositions by only persons interested (within 1 year of grant date)
- Patent application required to be placed in condition for grant within 1 year of first examination report

7. Organization Chart



7. Statistics

Trend in Patent Applications

Year	2003-04	2004-05	2005-06	2006-07	2007-08	2008-09	2009-10
Filed	12613	17466	24505	28940	35218	36812	34287
Examined	10709	14813	11,569	14119	11751	10296	6069
Granted	2469	1911	4320	7539	15316	16061	6168

Statistics

Top 10 Major Indian Applicants for patents from Pharmaceutical Industry

Sl. No.	Name of Pharmaceutical Industry	Applications filed
1.	RANBAXY LABORATORIES LIMITED	37
2	WOCKHARDT RESEARCH CENTRE	33
3	CIPLA LIMITED	21
4	HETERO RESEARCH FOUNDATION	11
5	SULUR, SUBRAMANIAM VANANGAMUDI	11
6	CONCEPT MEDICAL RESEARCH PRIVATE LIMITED	10
7	RUBICON RESEARCH PVT LTD	08
8	STEMPEUTICS RESEARCH PVT. LTD.	08
9	ENVISION SCIENTIFIC PRIVATE LIMITED	07
10	SUN PHARMA ADVANCED RESEARCH COMPANY LIMITED	07

Statistics

Top 5 Major Indian applicants for patents in the field of Information Technology

Sl. No.	Name of Companies	Applications filed
1.	INFOSYS TECHNOLOGIES LIMITED	23
2.	LG SOFT INDIA PRIVATE LIMITED	07
3.	CENTRE FOR DEVELOPMENT OF ADVANCED COMPUTING (C-DAC)	06
4.	NEWGEN SOFTWARE TECHNOLOGIES LIMITED	06
5.	SAMSUNG INDIA SOFTWARE OPERATIONS Pvt. Ltd.	06

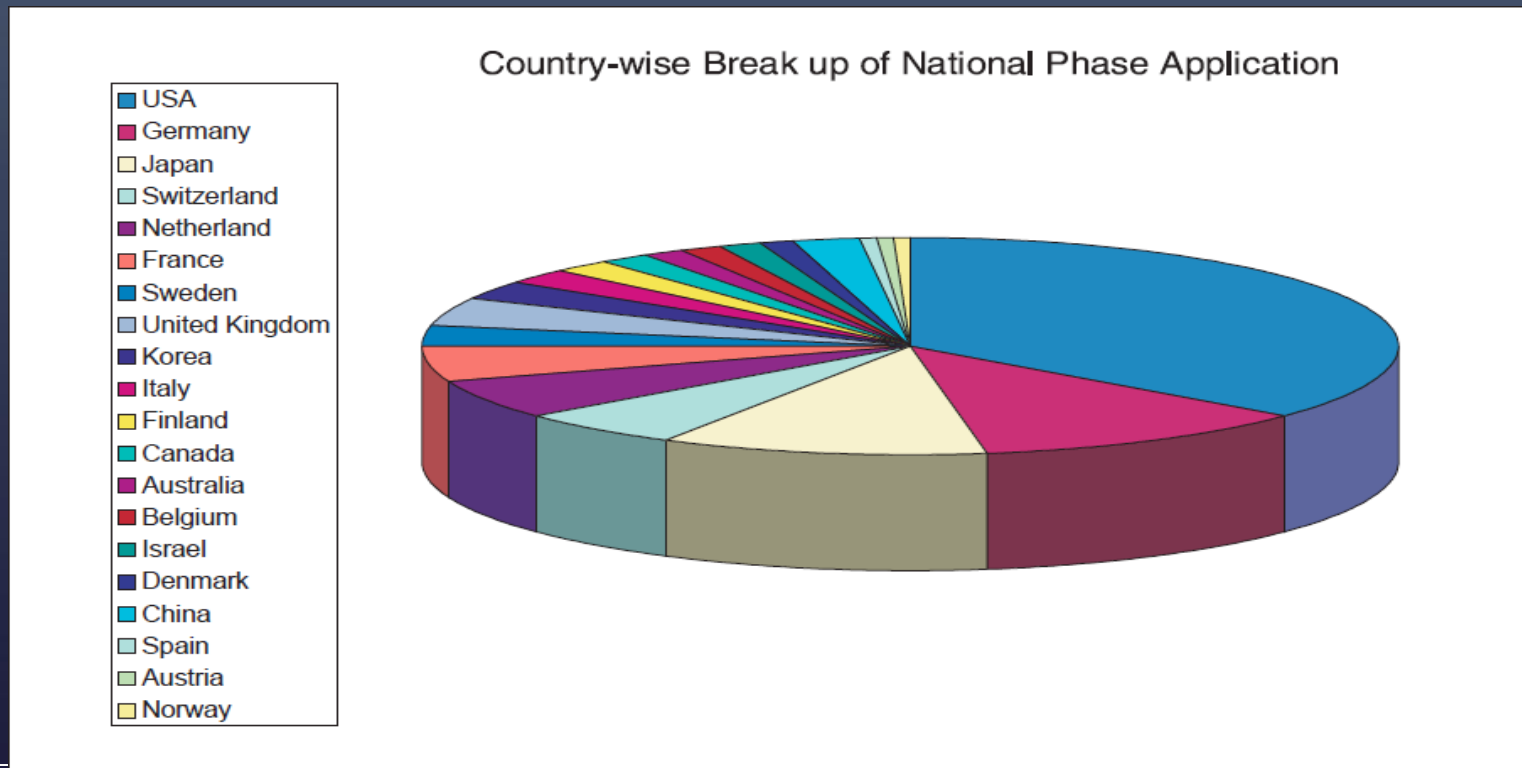
Statistics

Top 10 Foreign Applicants

Sl. NO.	Name of Organisation	Number of Applications
1	QUALCOMM INCORPORATION	852
2	KONINKLIJKE PHILIPS ELECTRONICS N.V.	725
3	SONY CORPORATION	296
4	NOKIA CORPORATION	267
5	ROBERT BOSCH GMBH	244
6	TELEFONAKTIEBOLAGET LM ERICSSON (PUBL)	242
7	SIEMENS AKTIENGESELLSCHAFT	234
8	BASF SE	222
9	MICROSOFT CORPORATION	220
10	NOVARTIS AG	203

Statistics

Number of PCT National Phase Applications filed during the Year was **23,431**



Statistics

DETAILS OF THE TECHNICAL FIELD OF SPECIALISATION OF WORKING EXAMINERS AS ON 31st MARCH 2010

BROAD TECHNICAL FIELD OF SPECIALISATION	NUMBER OF EXAMINERS
Biochemistry	05
Bio-Technology	09
Chemistry	20
Civil Engineering	02
Computer Science	06
Electrical & Electronics Engineering	13
Mechanical Engineering	06
Metallurgy	02
Microbiology	12
Physics	03
Textile Engineering	02
TOTAL	80

Challenges

- Section 3(d)
- Pre and post-grant oppositions can result in undue delay in the grant of the patent
- Patents are hard to enforce
- Damages awards for patent infringement are unheard of
- Working Requirement Statement has to be filed each year

Questions?



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