



PATENTS RECAP 2023

A Brief Summary of Patent Reforms,
Initiatives, and Rulings in India

The year 2023 has witnessed several progressive reforms and initiatives from the Indian Patent Office to address issues related to patent procedures and to promote patent filings in the country. One such prominent reform is the introduction of “The draft Patents (Amendment) Rules, 2023”. The draft rules are a positive step to address the delays in the patent process, reduce the overall grant time, clarify divisional applications and simplify the process for meeting the working of patent requirements (for a detailed review of these draft rules, refer to our article [here](#)). Additionally, the Patent Office released a notification to recruit 553 additional Examiners to meet the growing needs and successfully conducted an examination to initiate the recruitment process. The Jan Vishwas (Amendment of Provisions) Act, 2023 enactment further clarified penalties in patent matters under sections 120-124 and 124B of the Patent Act.

National IP Conference, 2023, was organized by the Office of the Controller General of Patents, Designs, and Trademarks (CGPDTM). The conference was focused on the WIPO-India Action Plan and India’s global leadership in IP filings. A few initiatives like the Indian IP Diagnostics Tool and a master’s programme for IP Professionals were also discussed. Another noteworthy initiative came from the Department of Biotechnology (DBT) which issued Intellectual Property Guidelines regulating the ownership and transfer of intellectual properties from DBT-funded institutions.

India’s IP framework continues to evolve with the establishment of the Intellectual Property Division (IPD) at the Madras High Court, after the already established IPD at the Delhi High Court. The High Court at Calcutta also published the draft IPR Division Rules to set up the third dedicated IPD in the country. The courts have also passed several judgements in 2023 – A few reiterating, clarifying and bold rulings setting the direction for the future in patent-related matters. The following is a list of curated judgments in 2023 related to patents, which we thought were noteworthy and interesting to read.

1. Assessing Patentability of Computer Related Inventions (CRI)

The Delhi High Court clarified that the mere implementation of algorithms should not automatically render an invention ineligible for a patent under section 3(k). Instead, the focus should be on the technical effects and contributions provided by the invention.

The court noted the examples of both patent-eligible and non-eligible inventions in the CRI Guidelines.

[Microsoft Technology Licensing, LLC v. The Assistant Controller of Patents and Designs, C.A. (COMM.IPD – PAT) 29/2022, Delhi High Court]

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2. The Importance of Providing Clear and Reasoned Grounds for Patent Refusal

The Appellant argued that the controller used the words “novel” and “inventive” interchangeably. The Hon’ble High Court held that the refusal order lacked proper reasoning, failing to demonstrate how the cited prior art defeated the novelty of the invention and remanded a fresh examination.

[Guangdong Oppo Mobile v. The Controller of Patents, AID NO. 20/2022, Calcutta High Court]

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3. Pro-tem Orders in Standard-Essential Patent (SEP) Infringement

The Delhi High Court directed Oppo to deposit 23% of the proceeds from their sales in India as a pro-tem deposit. The High Court clarified that the pro-tem deposit order is not linked to an injunction and is a measure to safeguard appellant interest.

[Nokia Technologies OY v. Guangdong Oppo Mobile Telecommunications Corpn. Ltd., FAO(OS) (COMM) 321/2022 & CM APPL. 53576-53579/2022, Delhi High Court]

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4. The Interpretation and Scope of Product-By-Process Patent Claims in India

The judgment clarified that product-by-process claims in patent cases are limited to the specific process claimed in the patent, and the monopoly right does not extend to the product as a whole. The court also emphasized the importance of consistent representations by patentees and highlighted that patent protection is tied to the disclosed process.

[Vifor International Ltd. and Anr. v. MSN Laboratories Pvt. Ltd. and Anr., CS(COMM) 261/2021, Delhi High Court]

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5. The Applicability of Section 10 of The Code of Civil Procedure, 1908 (CPC) to Revocation Petition under Section 64 of the Patents Act, 1970.

The Hon'ble Delhi High Court emphasize the distinction between revocation proceedings and infringement suits, clarifying that a revocation petition is not considered a 'suit' for Section 10 of the CPC. The decision is based on the principles of procedural timelines and the relief obtained in each type of proceeding.

[Dr. Reddys Laboratories Limited and Anr. v. The Controller of Patents and Ors., C.O.(COMM.IPD-PAT) 3/2021, Delhi High Court]

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6. Independent Filing of Divisional Applications

The Hon'ble Delhi High Court analysed the structure of Sec. 16(1) and opined that applicants could independently file divisional applications and there is no need for the claims to include multiple inventions, contrary to the Boehringer Ingelheim ruling.

[Syngenta Limited v. Controller of Patents and Designs, C.A. (COMM. IPD-PAT) 471/2022, Delhi High Court]

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7. Clarification on Scope of Divisional Applications by Divisional Bench

The Divisional Bench clarified that divisional applications are admissible based on disclosures within the specifications, aligning with legislative intent offering a more flexible approach to the filing of divisional applications and acknowledging situations where multiple inventions are disclosed in but not explicitly claimed the parent application.

[Syngenta Limited v. Controller of Patents and Designs, C.A. (COMM. IPD-PAT) 471/2022, Delhi High Court]

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8. Clarification on Patent Infringement in case of Product-by-process Patent

The Hon'ble Court denied a temporary injunction in favour of the plaintiffs due to the ongoing business operations of the defendants. Instead, the defendants were directed

to maintain accounts of manufacturing and sales of Ferric Carboxymaltose until the expiry of the suit patent and not to use a manufacturing process claimed by the Plaintiff.

[Vifor International Ltd. & Anr. v. Biological E Limited & Anr., CS(COMM) 434/2023, Delhi High Court]

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9. Calculation of Damages Based on the Duration of Infringement, Lost Profits and Legal Costs

The judgement emphasizes the court's thorough examination of infringement, validity, and damages in patent disputes. While awarding damages to Strix, the court's consideration of prior art, non-working claims, and the reasonable royalty approach provides insights into intellectual property protection and dispute resolution.

[Strix Ltd v. Maharaja Appliances Limited [CS(COMM) 403/2018 and CC 54/2009, Delhi High Court]

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10. Requirement of Foreign Filing Permissions, in case of a Patent of Addition

The Hon'ble Madras High Court held that compliance to Section 39 is mandatory, that requires Indian residents to obtain permission before filing patent applications abroad. The court, addressing uncertainties, deemed the Appellant's failure to seek permission for a patent of addition as a technical breach.

[Selfdot Technologies (OPC) Pvt. Ltd. v. Controller General of Patents, Designs & Trade Marks, 2023:MHC:5258, Madras High Court]

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11. Patentability Exclusions under Section 3(d) and 3(e)

The High Court overturned a rejection under Sections 3(d) and 3(e) of the Patents Act. It deemed claims patentable, citing enhanced thermostability's efficacy. The court clarified Section 3(d) is inapplicability to biochemical substances. Dealing with Section 3(e), the Court stated that the provision is not limited to admixtures of known substances.

[Novozymes v. Assistant Controller of Patents & Designs, (T) CMA (PT) No.33 of 2023 (OA/6/2017/PT/CHN), Madras High Court]

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12. High Court Jurisdiction in Patent Appeals: The Role of the Appropriate Office

The Hon'ble Delhi High Court clarified that the situs for hearing a patent appeal against a Controller's decision is determined by the location of the "appropriate office" as defined in Rules 4(1)(i) and 4(2) of the Patents Rules is where the application was initially filed.

[Filo Edtech Inc. v. Union of India & Anr., C.A.(COMM.IPD-PAT) 30/2023, Delhi High Court]

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13. Amendment of Method Claims to Product Claims has to Fall Wholly Within the Claims Before the Amendment.

Amended patent claims must be read alongside the complete specification as per Section 59(1). In the context of Section 3(i), the court allowed amendments, highlighting the importance of disclosing implant details for ocular treatment in the original claims.

[Allergan Inc. v The Controller of Patents, C.A.(COMM.IPD-PAT) 22/2021, Delhi High Court]

14. The Single Judge Denying Injunctive Relief, Interpretation of 'Coverage' and 'Disclosure'

The judge cited a prima facie case for the invalidity of the species patent and rejected the 'coverage' and 'disclosure' dichotomy. The court stated that specific disclosure in the species patent is irrelevant when a product is already covered in the genus patent.

[Boehringer Ingelheim Pharma Gmbh & Co. Kg Vs Vee Excel Drugs and Pharmaceuticals Private Ltd. & Ors., CS(COMM) 239/2019, Delhi High Court]

15. Amendment of the claims to broaden the scope of protection at the appellate stage.

In a recent case, Societe Des Produits Nestle Sa successfully challenged a Patent Office refusal by citing Section 15 of the Patents Act, which allows for patent claim amendments during appeals. The ruling has highlighted those Section 59 permits amendments at the appellate stage, subject to the Act's requirements.

[Societe Des Produits Nestle SA vs. The Controller of Patents and Design & Anr; C.A.(COMM.IPD-PAT) 22/2022, Delhi High Court]

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16. Methods of treatment of plants cannot be objected under Section 3(h).

Decco Worldwide applied for an Indian patent for its fungicidal treatment method to prevent leaf disease in banana plants. The patent was rejected by the Assistant Controller of Patents and Designs, citing section 3(h) of the Act. However, the Calcutta High Court criticized the rejection order, citing a lack of reasoning and failure to appreciate the facts.

[Decco Worldwide Post Harvest Holdings B.V & Anr. v. The Controller of Patents and Designs & Anr., AID NO. 11/2021, Calcutta, High Court]

17. Case involved patent infringement where the patentee, Enconcore, doesn't manufacture the product in India.

Despite licensing its technology and minimal domestic production, Enconcore sought an injunction against Anjani Technoplast Ltd. The court allowed Anjani Technoplast to exclusively supply the product to the Ministry of Defence and directed them to deposit Rs. 25 lakhs with the court to protect the Plaintiff's interests.

[Enconcore N.V. v. Anjani Technoplast Ltd. & Anr., CS(COMM) 382/2019, Delhi High Court]



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