

ADVISORY NOTE

Section 8 Requirements at the Indian Patent Office

Recent Court, IPAB (Intellectual Property Appellate Board) and Patent Office decisions in India vis-à-vis compliance with Section 8 requirements under the Indian Patents Act has brought this section into a sharp focus and has become the bête-noir of many applicants/patentees. This section requires the applicant to inform the Patent Office regarding filings in other jurisdictions corresponding to the same or substantially the same invention as filed in India. There is a stipulated time frame for filing such information. In addition to that the applicant is required to keep the Patent Office informed about the processing of such applications during the pendency of the application in India up till the grant. Keeping in view the gravity this issue has attained, we have prepared a short note that will help explain the requirements under this section.

Section 8 of the Indian Patents Act is reproduced hereunder:

"8. Information and undertaking regarding foreign applications.—

(1) Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file along with his application or subsequently within the prescribed period as the Controller may allow—

(a) a statement setting out detailed particulars of such application; and

(b) an undertaking that, up to the date of grant of patent in India, he would keep the Controller informed in writing, from time to time, of detailed particulars as required under clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequently to the filing of the statement referred to in the aforesaid clause, within the prescribed time.

(2) At any time after an application for patent is filed in India and till the grant of a patent or refusal to grant of a patent made thereon, the Controller may also require the applicant to furnish details, as may be prescribed, relating to the processing of the application in a country outside India, and in that event the applicant shall furnish to the Controller information available to him within such period as may be prescribed."

There are two aspects to Section 8 filings. One is the voluntary disclosure as required under section 8 (1) and the other is disclosure as per request from the Controller under Section 8(2).

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It is pertinent to add here that failure to disclose information under Section 8 is a ground for revocation of a patent under section 64(m) that reads as:

“64. Revocation of patents.—(1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act, may, be revoked on a petition of any person interested or of the Central Government by the Appellate Board or on a counter-claim in a suit for infringement of the patent by the High Court on any of the following grounds, that is to say—

*.....
(m) that the applicant for the patent has failed to disclose to the Controller the information required by section 8 or has furnished information which in any material particular was false to his knowledge;”*

It is a ground for pre-grant opposition under section 25(1)(h) that reads as follows:

“25. Opposition to the patent. – (1)Where an application for a patent has been published but a patent has not been granted, any person may, in writing, represent by way of opposition to the Controller against the grant of patent on the ground—

*.....
(h) that the applicant 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;”*

It is also a ground for post grant opposition under section 25(2)(h) that reads as follows:

“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:—

*.....
(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;”*

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The issue of non-compliance or partial compliance with the requirements of this section has come before the Courts in a number of cases (Chemtura Corporation vs. Union of India, Roche vs. Cipla, Tata Chemicals vs. Hindustan Lever, Richter Gedeon vs. Cipla) and a few patents in India have been revoked in the recent past for partial non-compliance of such requirement.

The disclosure under section 8(1a) requires that the applicant, while filing Patent application in India, within the prescribed time limit of six months (Rule 12 (1a)), file the details of the applications filed in other countries pertaining to the same or substantially the same invention. The details include: name of the country, date of application, application number, status of the application, date of publication and date of grant.

Under Section 8(1b) the applicant undertakes to furnish the **detailed particulars** from **time to time** up to the grant of the patent, within six months of filing in any other country (Rule 12(b)). It may be noted that even if the invention is assigned to another entity in another country, still the applicant is required to keep the Patent Office informed of such an application. In Chemtura vs. Union of India the Court asserted that it “did not hinge on the Controller asking for particulars but the applicant keeping the Controller informed from time to time. The expression time to time meant a periodicity of furnishing information akin to updating the Controller on the current status of the applications filed in other countries. It is not, as suggested by the learned Senior counsel for the plaintiff, a mere furnishing of information whether the application is pending or dismissed.”

Section 8(2) disclosure is, however under the instructions of the Controller, which normally arises during the examination of the application in the examination report. This disclosure includes information relating to objections, if any, in respect of novelty and patentability of the invention and any other information as may be required by the Controller.

In Richter vs. Cipla, the Controller observed that “even though substantial updated information on the corresponding application filed in foreign countries were expected to be available like the information in JP and USA, the same was not informed to the Indian Patent Office. I view this irregularity by patentee as violation of provision as required under Section 8 of Patents Act. I conclude that such a ground of opposition is validly established by the opponent.” Though from the Order it appears that the applicant

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had abandoned (voluntarily) the JP and USA applications after the grant of Indian patent and the applicant is obliged to update the Patent Office only up to the grant, but it appears that the Controller had objections to the prosecution history of the applications not being submitted at the Patent Office.

Once again in *Sugen Inc. vs. CGPDTM* the IPAB asserted that “what has been furnished by the Patentee/Appellant is alone relevant to decide this issue and not what is available on the internet” (emphasis by the IPAB).

In view of the above-mentioned decisions we advise the following:

The applicant must furnish the details (name of the country, date of application, application number, status of the application, date of publication and date of grant), within six months of filing in India (Rule 12(a)). As noted above, even if the invention is assigned to another entity in another country, still the applicant is required to keep the Patent Office informed of such an application. Further, please send us copies of all search and examination reports including claims as allowed in respect of any family applications including CIPs, divisionals, refilings etc. as an applicant is under a continued obligation to provide such details. Additionally, please note that in the Examination Report the Examiners often require the applicant to submit the translations of the granted applications if the same are in a language other than English.

Accordingly, we require our esteemed clients to furnish the aforesaid details as and when the same are issued or any new filing is made.

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