
(2012) 04 IPAB CK 0010

In the Intellectual Property Appellate Board

Case No : ORA/3/2008/PT/CH

Suru International (P) Limited

APPELLANT

Vs

B. Braun Melsungen AG

RESPONDENT

Date of Decision : 19-04-2012

Acts Referred:

Patent Rules, 2003 — Rule 37, 137, 138
Patent Act, 1970 — Section 8(1)(b), 11(A)

Citation : (2012) 04 IPAB CK 0010

Hon'ble Judges : Prabha Sridevan, J; D.P.S. Parmar, Technical Member

Bench : Division Bench

Advocate : Vaibhav Vutts, Satish Parasaran

Final Decision : Disposed Of

Judgement

Prabha Sridevan, J

1. This application is filed for revocation of the patent granted on 18.8.1998 entitled ""SPRING CLIP IV CATHETER"".

2 . The learned counsel on both sides have made their submissions both on the preliminary objections which relates to the date of grant of patent and partially on merits.

3. On 21.10.2011, we issued notice to the Registry requesting the 2nd respondent to be present at the Tribunal to speak from the records regarding the issues raised in the appeal. On 23.11.2011 Shri C.N. Shashidharan and Shri K.S. Hariram, Assistant Controllers of Patent Office were present and

they assisted us by explaining the procedures adopted by the Patent Office. The officer reported that he was not aware of the grant of patent though

he was aware that the patent number has been allotted. The case was then adjourned to 30.03.2012 for production of records which were-with the

Hon'ble Delhi High Court. On 13.02.2012 when IPAB had its Circuit bench sitting at Delhi, the records were produced before us so that we could

look at the endorsements in the original.

4. In the view we are taking, we will not deal with the facts in detail. On 27.05.2005, the agents of the patentee were intimated that the application

was in order for grant but the letters would be issued after disposal of pre-grant opposition. On 10th September, 2007, Form 13 was filed in respect of

change of counsel. On 19th December 2007, the counsel for the patentee was informed that patent has been granted on the above mentioned

application and the grant of patent has been recorded in the Register of Patent Office on 3.12.2007. Reference mentioned in this letter reads ""Ref:

Patent No. 210062 (1857/MAS/1998), dated 18.8.1998 granted on 17. 9.2007"". On 19.9.2007, the counsel for the patentee filed Form 13. The covering

letter reads as follows.....""As the aforesaid Patent Application has still not proceeded to grant....."". The payment for Form 13 was made on

21.9.2007 and we can take it that the date of filing of Form 13 as 21.9.2007. On 26.11.2007, the Assistant Controller Shri C.N. Shashidharan (who

was Examiner at that time) allowed this proposed amendment of claims holding that it appears to be within the scope of claims of the specification

before amendment and hence may be allowed. Thereafter, on the same date, there is another endorsement by the Assistant Controller Shri

Viswanathan which reads ""L.P. to be issued"" Dated 26.11.2007"". In the same note it is reiterated that ""1857/MAS/98 : Proposed amendment of claims

appear to be within the scope of claims of the specification before amendment and hence may be allowed."" and signed on 26.11.2007. The number of

claims originally filed were 54 but later by filing Form 13 they were brought down to 28. In fact, the original claims were cancelled and the above 28

claims were introduced in their place. The patentee also filed another application under Rule 137 and 138 for condonation of delay under section 8(1)

(b). This was signed on 28.9.2007. Amongst other challenges to the grant of patent, one is the noncompliance of section 8(1)(b) and also the fact that

the amendment had been treated as pre-grant amendment. We are not going into other objections raised by the applicant touching the patentability of

the invention. According to the respondent, the public know about the grant only after it is notified and the patentee is also on the same footing of the

public. They also submit that allotment of number is done electronically and the endorsement that L.P. to be issued must alone be taken into reckoning.

5 . We have called for the records from the Patent Office. The office records on 6.9.2007 read as follows: ""The application has been published under

section 11(A) on 9.6.2006 vide official Journal of the Patent Office (Issue No. 23/2006) and there is no pre-grant representation. Put up for further

consideration."" The officers have signed on 7.9.2007. This sheet further reads ""Patent number may please be allotted. Further, Post Grant (P-II)

Section may be instructed to process this application to issue the letter of Patent."" This was signed on 10.9.2007. Then it reads ""Patent number allotted

and the No. 210062."" This is signed by Ms. Punithavathi, Assistant Controller of Patents on 17.9.2007. It is therefore seen from the letters from the

Patent Office which reads the date of grant of Patent as 17.9.2007.

6 . On page 131 of the Convenience File, filed by the appellants, the extract of the Patent Register which deals with this patent is found. It shows the

Patent No. as 210062; the date of filing as 18.08.1998; and the date of grant of as 17.9.2007 at 12:07:03 Hrs.

7. Rule 37 of the Patent Rules, 2003 reads ""On grant of a Patent, the application shall be accorded a number (called Serial number) in the series of

numbers accorded to patents under the Indian Patents and Designs Act, 1911, which shall be the number of Patent so granted."" We do not think this

number can be changed at the instance of any party nor even by the officers themselves. When the officers were present before us, we asked them

how when the Patent Number has been allotted, which meant, the patent has been granted, the amendment application had been ordered as if it is a

pre-grant application and the words ""L.P. to be issued thereafter"". The officers said that allotment of the number would not be communicated to them.

8. In fact, in connection with the same matter, an enquiry has been conducted by the Controller General of Patents in 11th May, 2010 and the enquiry

report has also been produced before us. In the facts of the case, it is recorded that the application was sent for grant on 6.9.2007 and the Patent

Number was generated on 17.9.2007. The enquiry report showed that the allegations made that this amendment should not have been allowed as pre-

grant amendment was found to be true and that the manner in which it was done was not correct.

9. We are not really concerned with the disciplinary action taken against the officers but we are informed that the two officers were exonerated. The fact remains that the two applications filed by the present counsel for the patentee were only after the grant of patent and they ought not to have been dealt with as pre-grant amendments.

10. We, therefore, direct the 2nd respondent to consider the matter de novo from the stage it stood as on 21.9.2007, when the amendment applications were filed. The date of patent granted is 17.9.2007 and the applications filed thereafter shall be dealt in accordance with law as post-grant

applications. Since the original claims have been cancelled and fresh claims have been introduced by way of amendment, we have no option but to do

this. We must know in a revocation application what are the claims we have to consider for deciding the patentability.

11 . The learned counsel for the applicant submitted that there are many foreign applications and non-compliance with Section 8(1)(b) is apparent and

the patentee cannot derive any advantage even from the amendments. We are not here dealing with the applications under Form 13, or the one under

Rule 137. The records show the proof of payment of fees for Form 13. But however for the other application proof of payment has not been given but

however it is a subsequent application. The application for amendment and the application for condonation of delay under section 8(1)(b) if filed shall

be treated as post-grant applications and dealt with in accordance with the Law.

12. We are of the opinion that there should not be any recurrence of what happened in this case. The office should devise a method by which every

Examiner would know when the Form 13 is filed; whether the patent has been granted and the number has been allotted. For the procedures are

different for pre-grant amendment and post-grant amendment. This is so because there is a time gap between the date of allotment of number and the

date on which the grant of patent is communicated to the patentee. Therefore, the patentee may genuinely be under the impression that the patent has

not been granted and mention in his application that it is a pre-grant application. In this case, the patentee has written a letter to that effect. We are

also of the opinion that once the number is allotted, it may be placed on the Website immediately giving the name of the application and the title of the

invention. Rule 37 is unambiguous and clear and the date cannot be Changed we

see no reason why it cannot be made public immediately.

13. The ORA/3/2008/PT/CH is ordered accordingly.