



AUDIRI VOX

a client-centric ip practice

MIDDLE EAST – ASIA – AFRICA

AVIP

Newsletter

Issue 13

January 2024

In This Issue

- EDITORIAL
- WELCOMING 2024: UAE'S BOLD LEAP INTO THE FUTURE OF PATENTS LAW WITH THE NEW SET OF AMENDMENTS
- IP UPDATES

Editorial

Dear Friends & Colleagues,
Wishing each one of you a joyous and prosperous New Year 2024! May this year bring boundless joy, success, and warmth to our global fraternity.

As we step into the new year, Audiri Vox is thrilled to commemorate a significant milestone – the completion of the first anniversary of our newsletter, “AVIP”. Over the past year, we have dedicated ourselves to providing informative articles, valuable insights, and timely updates spanning various IP jurisdictions in the Middle East, India, and Pakistan. The overwhelming positive reception from our colleagues worldwide has been heartening, and we express our gratitude for the invaluable feedback received from both colleagues and clients, which has played a pivotal role in enhancing the current version of our newsletter.

Our team of seasoned lawyers and professionals has consistently

delivered comprehensive legal solutions, covering the spectrum of intellectual property, including trademarks, patents, copyrights, designs, and trade secrets. We take immense pride in our achievements thus far and remain steadfast in our commitment to surpass expectations in the coming year.

As we embark on this new year, we bring attention to a momentous development in the UAE. The Government has undertaken a significant overhaul of the patents law, introducing amendments that position the UAE Patents Law on par with leading jurisdictions worldwide. Our featured article delves into these noteworthy amendments, set to take effect from January 15, 2024.

We are enthusiastic about continuing this journey and eagerly anticipate sharing our wealth of knowledge and insights with our esteemed clients and subscribers.
Sincerely,



Sarmad Hasan Manto
Managing Partner - Audiri Vox





Sarmad Hasan Manto



Divyendu Verma

WELCOMING 2024: UAE'S BOLD LEAP INTO THE FUTURE OF PATENTS LAW WITH THE NEW SET OF AMENDMENTS

INTRODUCTION

As the United Arab Emirates (UAE) strides boldly into the year 2024, the nation stands at the intersection of a dynamic business landscape and a commitment to global innovation. In the last three decades, the UAE has undergone a profound metamorphosis, emerging as the 26th best nation for doing business, as per the World Bank Group. This transformation is not only evident in its economic prowess but also in its ascendancy in the Global Competitiveness Index and the Global Innovation Index. With an exponential increase in patent applications – from approximately 8,000 in 2010 to surpassing 25,000 in 2020 – the UAE is not just a global competitor but a vanguard in promoting innovation and safeguarding intellectual property.

Recent Major Amendments in the UAE Patents Law:

I. 2021 Amendments:

In 2021, the UAE embarked on a significant journey of legal reform with the issuance of Federal Law No. 11 of 2021. This sweeping legislative revision, published in the Official Gazette on May 31, 2021, encompasses patents, industrial designs, integrated circuits, undisclosed

information, and utility certificates.

In 2021 amendments of the Patents Law, for the first time, the definition of inventive step was introduced. As per the definition, an invention is considered to involve an inventive step when it is not axiomatic (obvious) in the opinion of an ordinary craftsman. A patent can be granted for a new application, modification or an addition made to an invention which existed earlier.

A noteworthy amendment involved the introduction of a twelve-month grace period for the disclosure of inventions before filing a patent application in the UAE, as stipulated in Article 5(4). Additionally, Article 14 ushered in expedited examination procedures for specific patent categories. This article outlines provisions for urgent applications, allowing the Ministry to prioritize the examination of certain patent or utility certificate applications over others, irrespective of submission or examination dates, provided it does not compromise priority applications.

Another significant amendment pertained to the establishment of “Divisional Patent Applications” under Article 16. A modification to Article 11(8) now permits the filing of patent applications in either English or Arabic. In cases where one of these languages is unavailable at the time of filing, a provision in Article 11(9) allows for late filing within 90 days.

Concerning the exclusion of patentable subject matter, the amended Patents Law introduced the exclusion of “software” from patentability by amending Article 7(d). Another noteworthy exclusion involved “Natural substances”, as amended in Article 7(e). Specifically, Article 7(e) delineates that “Natural substances” obtained through purification or separation from natural resources fall outside the patentability criteria. However, the “method” of purifying or separating such natural substances from their natural resources remains within the scope of patentability.

II. 2022 Amendments:

Among various challenges faced by foreign applicants seeking to file patents and industrial designs in the UAE, the requirement for document legalization, including Power of Attorney and Deed of Assignment, posed a significant obstacle. The most noteworthy amendment in UAE Patent Law, introduced in 2022, addressed this hurdle. Specifically, on September 21, 2022, the Ministry of Economy issued a circular email detailing new legalization requirement for Powers of Attorney (PoA) related to patents and industrial designs.

The amendments bring about a crucial change by eliminating the necessity for Consulate legalization of POAs and other requisite documents. The revised law stipulates that notarization of such documents is now sufficient. Additionally, the amendments clarified that a stamp from a UAE public entity, such as government

organizations or national universities, is considered equivalent to notarization.

Another significant modification involves a simplification of the requirements for proving the right of invention by the applicants. The amended law specifies that if the inventor is an employee of a UAE company, they can now submit a certificate of employment or a copy of the employment contract as evidence, alleviating the previous necessity for a deed of assignment.

III. 2023 Amendments:

On November 13, 2023, the UAE issued Cabinet Resolution No. (112) of 2023, signifying a substantial shift in the legal landscape. This resolution introduces amendments to certain provisions outlined in Cabinet Resolution No. (20) of 2020. The official publication of the resolution occurred in the UAE Gazette 763 on November 15, 2023, with a scheduled effective date of January 15, 2024, two months after its publication.

These amendments represent a noteworthy evolution in the registration of patents, utility models, and industrial designs in the UAE. A key aspect of these changes is the introduction of new fees for services, including accelerated examination, re-examination for minor office actions, and post-grant examination. The primary objective of these modifications is to streamline the patent examination process, ultimately enhancing the efficiency of the industrial property system within the UAE.

Key Amendments:

a) Official Filing Fee based on Applicant type:

A crucial provision within Federal Law 11/2021 involves the introduction of official fees based on the type of applicant. This strategic step aligns with established practices in other significant jurisdictions, such as the USA and India, where office fees for various filing activities are categorized into distinct groups. In a similar vein, the UAE amended law delineates four distinct categories of applicant types, as detailed below:

- I. natural persons/Individuals
- II. companies
- III. academic institutions
- IV. small and medium enterprises (SMEs)

For example, below table depicts the changes in the filing fee of patents & industrial designs pre-amendment and post-amendment:

BEFORE AMENDMENT		AFTER AMENDMENT (effective from 15-Jan-2024)	
Applicant Type	Official Filing Fee (AED)	Applicant Type	Official Filing Fee (AED)
Company/Legal Entity	2000	Company/Legal Entity	2000
		Small and medium enterprises (SMEs)	1000
		Academic institutions	1000
Individual	1000	Individual	1000

b) Limitation Imposed on the number of Claims on Patents:

A pivotal aspect of Federal Law 11/2021 involves the imposition of limits on the number of claims for patents. The revised law sets a maximum cap of 50 claims per patent. Ministerial Decision 112/2023 responds to this limitation by introducing category-wise fee structure, featuring three distinct examination fees correlated with the number of claims. Accordingly, the substantive examination is now based on the below claim categories:

- I. Category-1 (1-10 Claims) – Official Fee 7000 AED
- II. Category-2 (11-30 Claims) - Official Fee 8000 AED
- III. Category-3 (31-50 Claims) – Official Fee 9000 AED

Importantly, the framework allows for the submission of requests to increase the number of claims from one category to another. This tiered approach aligns seamlessly with international best practices, ensuring that the fee structure is both fair and reflective of the resources needed for the examination process.

For example, below table depicts the changes in the Examination fee (First Exam) and Re-examination of patents & industrial designs pre-amendment and post-amendment:

BEFORE AMENDMENT		AFTER AMENDMENT (effective from 15 -Jan-2024)	
FIRST EXAM		FIRST EXAM	
Applicant Type	Official Filing Fee (AED)	Applicant Type	Official Filing Fee (AED)
Company/Legal Entity	7000	Company/Legal Entity	7000-9000 (depending upon the claim categories)
		Small and medium enterprises (SMEs)	3500
		Academic institutions	3500
Individual	7000	Individual	7000-9000 (depending upon the claim categories)
RE-EXAMINATION		RE-EXAMINATION	
Company/Legal Entity	5000	Company/Legal Entity	5000
		Small and medium enterprises (SMEs)	2500
		Academic institutions	2500
Individual	5000	Individual	5000

c) Introduction of Annual Maintenance Fees:

To ensure continuous commitment to intellectual property rights by the applicant/patentee, an official fee for annual annuities has been introduced. The renewal fee increases every five years over the term of the patent. The newly introduced renewal fees are provided below for your reference:

S. No.	Annuities Year	Legal Entities	SMEs	Academic institutions	Individuals
1	Renewal Year 1	NA	NA (included in the application fee)		
2	Renewal year 2-5	200	100		
3	Renewal year 6-10	1000	500		
4	Renewal year 11-15	2500	1250		
5	Renewal year 16-20	4000	2000		

d) Introduction of Time Limit & Official Fee for revival of Lapsed Patents:

The amended regulations now provide the opportunity to reinstate lapsed patent applications, allowing restoration within a specified timeframe of nine months from the date of lapse, subject to the payment of designated fees. This intentional time constraint serves as an incentive for applicants to promptly take action in reinstating applications that may have lapsed. The Cabinet Decision accompanying this change introduces adjustments to the fees associated with requests for the restoration of applications post-lapse. It is noteworthy that this process, which was formerly free, now involves specified fees, emphasizing the importance of timely and proactive measures in reinstating lapsed patent applications.

e) Introduction of New Services:

Cabinet Decision 112/2023 brings forth substantial modifications, introducing nuanced fee adjustments for additional services as outlined in the UAE Patent Law 11/2021. Notably, these adjustments pertain to services like express examination, rectification of minor errors (as an alternative to issuing a new examination report), pre-grant & post-grant amendments, and re-examination after grant. The rationale behind these adjustments is to fortify the flexibility and efficiency within the patent prosecution process. By addressing specific aspects of the patent lifecycle, the amendments strive to create a more adaptive and streamlined framework, aligning the UAE's patent system with contemporary standards. The followings are new services:

- I. Express examination
- II. Pre-Grant Amendments of minor errors (instead of issuing a new examination report)
- III. Post Grant Amendments
- IV. Re-Examination Post Grant

f) Introduction of Penalties for delay in submission of Official Fee:

A groundbreaking initiative has been implemented, introducing a distinctive methodology to address delays in fee payments for any industrial property service. This innovative approach incorporates the imposition of

monthly penalties, ensuring that there are consequences for tardiness in fee settlement. Importantly, these penalties are capped at the equivalent of 10 months, establishing a well-structured framework designed to instill a sense of urgency and facilitate timely compliance with payment obligations for industrial property services. This forward-thinking measure aims to promote adherence to deadlines and uphold the integrity of the fee payment system within the industrial property landscape.

g) Promoting the Filings by Academic Institution:

The revised legislation in the UAE has implemented a reduction in the official fees that academic institutions are required to pay for the filing of patents and industrial designs. This strategic adjustment underscores a proactive approach by the UAE government, explicitly encouraging academic institutions to increase their participation in filing patents and industrial designs. By decreasing the financial burden through lowered official fees, the government seeks to foster an environment that stimulates greater engagement from academic institutions in the innovation and intellectual property landscape. This initiative reflects a concerted effort to promote research and development within academic spheres and enhance the nation's standing in intellectual property contributions.

Concluding Remarks:

In the wake of sweeping amendments to UAE patent laws from 2021 to 2023, the nation emerges as a pioneering force in cultivating innovation and intellectual property protection. From introducing a twelve-month grace period to streamlining procedures for foreign applicants, the legal revisions reflect a commitment to global competitiveness. The strategic categorization of applicant types, limitations on claims, and the introduction of new fees underscore a forward-thinking approach, aligning the UAE's intellectual property framework with international standards. Particularly noteworthy is the government's initiative to empower academic institutions through reduced official fees, signaling a commitment to cultivating a vibrant ecosystem of research and development. As the UAE positions itself on the global stage, these amendments not only reshape the legal landscape but also affirm a dedication to fostering innovation, protecting intellectual property, and driving sustained growth.

IP UPDATES

Syria: Revised Trademarks and Designs Official Fees



The Ministry of Internal Trade and Consumer Protection increased the official fees of trademarks and designs from December 03, 2023, which have been applied in Syria. According to Law No. 23/2023 dated November 21, 2023, filing, registration, records, and opposition related fees have been increased. The increased fees will be applicable on filing new applications and those applications for which registration fees have not been paid yet. The revision is effective from January 01, 2024.

GCC: GCC-South Korea signed a free trade agreement to boost to Gulf-Asia economic ties



On December 28, 2023, the Gulf Cooperation Council (GCC) entered into a significant free trade agreement (FTA) with South Korea, aimed at bolstering investment ties with key economic partners in Asia. Under the agreement, South Korea will eliminate tariffs on nearly 90% of all items, encompassing crucial products such as liquefied natural gas (LNG) and other petroleum goods. In reciprocation, the Gulf states will abolish tariffs on 76.4% of traded products and 4% of traded goods. The comprehensive FTA extends to various facets, including trade in goods, services, government procurement, collaboration among small and medium-sized enterprises (SMEs), customs procedures, and intellectual property.

Data from the London-based think tank Asia House reveals a notable surge in trade between the Gulf and South Korea, soaring from \$50 billion USD to \$78 billion USD between 2021 and 2022. Additionally, the bloc's trade with emerging Asia, encompassing China, experienced a substantial increase, reaching \$516 billion USD last year compared to \$383 billion USD in 2021. This landmark agreement underscores the region's commitment to fostering economic partnerships and capitalizing on the vast potential for collaboration between Gulf nations and Asian counterparts.

Pakistan: Pakistan signed the Marrakesh Treaty



On December 12, 2023, Pakistan formally became a member of the Marrakesh Treaty, a copyright agreement inked on June 27, 2013, in

Marrakesh, Morocco. The primary objective of this treaty is to facilitate access to published materials for individuals facing visual impairment, print disabilities, or physical limitations hindering effective reading. It achieves this goal by enabling the reproduction, distribution, and cross-border exchange of copyrighted works in braille, audio, and large print formats among participating countries. Given that Pakistan's Copyright Ordinance of 1962 prohibits the compulsory printing and reproduction of published works in braille and audio formats, all member states are now mandated to incorporate provisions/exceptions in their Copyright Laws. These provisions aim to authorize the reproduction, distribution, and accessibility of published works in formats designed for individuals with disabilities and facilitate cross-border exchanges by organizations serving these beneficiaries.

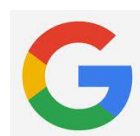


INDIA: Trademark Cases



Google LLC (Appellant) vs. Makemytrip (India) Private Limited And Ors. (Respondents)

Case No: FAO(OS) (COMM) 147/2022 & CAV 155/2022 & CM Nos. 27148/2022 & 27149/2022
Decided On: December 14, 2023



The appellants had filed the appeals impugning an ad interim order dated 27.04.2022 passed by the learned Single Judge in IA No. 6443/2022. The respondent had filed the present suit for the permanent injunction restraining infringement of its trademarks, passing off, dilution of goodwill, unfair competition and rendition of accounts of profits/damages etc. The respondent alleged that its competitor Booking.com has used its trademarks as keywords in Google Ads search engine, thus infringing its trademark. The question before the Court was whether the use of the trademarks of other companies as keywords in Google Ads infringe the trademarks' right of the proprietor. The Hon'ble Delhi Court observed that Booking.com and MakeMyTrip are popular websites, and that the chances of confusion between these two are



less. The Hon'ble Court said that a third party is allowed to pay for advertisement purposes by way of associating itself with a keyword of another party, as long as the other party is in the same line of business or industry and has a distinctive character and reputation of itself. Hence, the Hon'ble Court set aside the appeal. According to the order, a third-party trademark may be utilized in the bidding process for Google's AdWords advertising system as long as it does not confuse or deceive users regarding sponsored links and display ads.

Calvin Klein Trademark Trust & Anr. (Plaintiff) vs M/s Guru Nanak International & Ors. (Defendant)

Case No: CS(COMM) 75/2020 & I.A. 1318/2023
Decided On: December 08, 2023



The present suit was filed by two plaintiffs, namely Calvin Klein and Tommy Hilfiger, seeking permanent injunction restraining infringement of trademarks and copyright. The petitioners alleged that the defendant was counterfeiting their products and using their registered logos and labels. The Hon'ble Delhi High Court had granted an ex-parte ad interim injunction. A commissioner was appointed by the Hon'ble Court to execute a commission on the defendant's premises. The commissioner has seized substantial number of counterfeit products of Calvin Klein and Tommy Hilfiger. The Hon'ble Court said that the infringement indulged by the defendant was deliberate and calculated and thus is liable to pay damages to the plaintiff. The plaintiff was allowed to seize and destroy the counterfeit products.

Frankfinn Aviation Services Private Limited (Plaintiff) vs Tata Sia Airlines Ltd. (Defendant)

Case No: CS(COMM) 54/2022, I.As. 1795/2022, 3651/2022 & 3652/2022
Decided On: December 04, 2023



In the present suit, the plaintiff claimed protection of rights in its trademark 'FLY HIGH'. The plaintiff is engaged in the business of training staff for airlines and uses the marks 'FRANKFINN' and 'FLY HIGH'. The plaintiff was aggrieved by Tata Sia Airlines for using the mark 'FLY HIGHER'. An interim order was passed on 28th October 2022, according to which it was found that the defendant was not using 'FLY HIGHER' as a trademark but is only using it as a common usage of the said expression. Considering this as a petty issue, the

defendant made a proposal by way of an email dated 26th July 2023 to the plaintiff, containing two conditions: the defendant will not file an application for registration of the mark 'FLY HIGH' or 'FLY HIGHER'; and the plaintiff agrees that use of 'FLY HIGH' and 'FLY HIGHER' by the defendant for the purpose of advertising does not result in trademark use. The Hon'ble Delhi High Court directed that the defendant to not to claim any trademark rights in the expression FLY HIGH and FLY HIGHER nor shall it file any applications for registering it as a trademark. The defendant shall not oppose the trademark FLY HIGH of the plaintiff. The defendant is free to use FLY HIGH and FLY HIGHER in a non-trademark sense as also as a part of keywords, advertising campaigns and hashtags. The decree acts in 'personam' and not in 'rem'. Hence, the Hon'ble Court passed the decree on the relevant terms agreed between the parties.

Cable News Network (Plaintiff) vs City News Network And Others (Defendants)

Case No.: CS(COMM) 272/2021 & I.A. 7235/2021
Decided On: December 04, 2023



The suit has been filed by the plaintiff against the defendant for the infringement of its trademark. The plaintiff alleged that the defendant is using a similar trademark which can potentially deceive its viewers. The plaintiff has a registered trademark for his trade as 'CNN'. Defendant operates a public website with the label "CNN City News Network". The Hon'ble Delhi High Court observed that the acronyms "Cable News Network" and "City News Network" are bound to result in confusion in the eyes of an ordinary person. The plaintiff is thus entitled to a permanent injunction against the defendant to stop the use of the trademark. The Hon'ble Court further mentioned that any similarity in marks that can result in confusion and misrepresentation in the eyes of the public is bound to scrutiny.

Johnson And Johnson Pte. Ltd. (Plaintiff) vs Mr. Abbireddi Satish Kumar And Ors. (Defendants)

Case No: CS(COMM) 801/2023 & I.A. 22015/2023, I.A. 22016/2023
Decide On: December 07, 2023



The present suit has been filed by the plaintiff against the defendant for using a similar mark and similar trade dress to its registered marks, under which the defendant manufactures and sells fruit drinks in similar flavours as to the plaintiff. The plaintiff has a proprietary ownership of the marks 'ORSL'. The plaintiff asserted that they are using the marks consistently

and have gained considerable goodwill along with great sale volume in the market. The Hon'ble Delhi High Court observed that the defendant has not only adopted the mark of the plaintiff, but they have imitated and copied the trade dress of the plaintiff. There is a clear similarity between the trade dresses of the products of the defendants and the plaintiff. The similar packaging and imagery used shows the intention of the defendant to confuse the consumer. All the necessary conditions for the grant of an injunction are fulfilled and hence the Hon'ble Court restrains the use of the said mark by the defendant and orders to stop any further circulation of the goods with the said mark.

Kohli Sports Private Limited (Plaintiff) vs Ashi Sports (defendant)

Case No: CS(COMM) 858/2023I.As. 23949/2023, 23950/2023, 23951/2023 & 23952/2023
Decided on: December 01, 2023

The plaintiff has filed the present suit seeking permanent injunction restraining passing off, infringement of copyright, unfair trade practices, rendition of accounts, damages, etc. The plaintiff manufactures and sells helmets for cricket players since 2014 under the mark 'SHREY'. The plaintiff has great reputation in the industry. The plaintiff alleged that the defendant has copied the entire design of the plaintiff's cricket helmets as well as replicated the website of the plaintiff. The Hon'ble Delhi High Court observed that the documents given by the plaintiff to show the preference of the helmet is above par. It can be seen that the helmet is preferred internationally. The fact whether the helmet has a distinctive shape, so as to be protected as a shape trademark needs to be considered. The defendant shall take down its website and change its contents. The Hon'ble Court directed the parties to mediation.



PATENT CASES:

Optimus Drugs Private Limited (Petitioner) vs Union Of India & Ors (Respondent)

Case Number: W.P.(IPD)/24/2023 and WMP(IPD)/6/2023

Decided on: December 12, 2023

In the present case, the patent has been granted for the for an invention entitled "An improved process for the preparation of Linezolid" to which "Synmed Labs Limited" (respondent) filed a post grant opposition along with the evidence. But the petitioner did not submit any evidence while filing the reply statement to the opposition. Further on, the respondent submitted additional evidence along with the rejoinder. The Opposition Board provided their recommendation on the submitted opposition and the evidence. Thereafter the petitioner filed expert affidavit, which was rejected by the Controller, hence the petitioner has approached the Hon'ble Madras High Court with writ petitioner. Meanwhile the Controller has allowed the filing of additional evidence. Hence the petitioner and respondent has filed further evidence. Thereafter the petitioner has again filed the amended claims and before considering these post grant amendments the Controller has scheduled the hearing. Thus, the Petitioner has approached the High Court to seek the directions for considering the post grant amendments and constitution of fresh opposition board.

The Hon'ble Madras High Court has considered all the arguments from both parties and stated that the additional evidence placed on record by both the parties should be considered by the opposition board. The Court directed to reconstitute the fresh opposition board and stated that "*the newly constituted Opposition Board shall examine the entire evidence and the amended claims of the petitioner and provide its recommendations within a maximum period of two months from the date of constitution of such board.*"

Priya Randolph & Rohit Chaturvedi (Appellants) vs The Deputy Controller Of Patents And Designs (Respondent)

Case Number: OA/13/2018/PT/CHN
Decided on: December 20, 2023

The current appeal has been filed by the appellants in Madras High Court against the respondent for refusing the patent application (201641026786) on grounds of

being deemed a business method under Section 3(k). Particularly, the patent application faced initial rejection, being labelled as a computer program per se during office action and subsequently as a business method during the Hearing proceeding.

The appellants contended that their invention was not merely a business method but a technical solution contributing to enhanced privacy and data protection in e-commerce. On this, the Respondent maintained the business method classification under Section 3(k).

The Hon'ble Court scrutinized Section 3(k) and the recent updated CRI Guidelines, emphasizing that a claim must substantially be categorized as a business method. It observed that while the appellant's invention might find application in a business context, its primary nature pertained to a technical process involving hardware and software for data privacy, thereby not qualifying as a business method per se. Accordingly, the Hon'ble Court set aside the impugned order, remanding back the matter to the Patent Office for reconsideration with a deadline of 4 months.

**Selfdot Technologies (opc) Pvt. Ltd. (pppellant) vs
Controller General Of Patents,
Designs & Trade Marks (Respondent)**

**Case Number: (T)CMA(PT)/61/2023
(OA/11/2021/PT/CHN)**

Decided on: November 28, 2023

The current appeal has been filed by the appellant against the respondent for rejecting the appellant's patent application no. 201843023004 on the ground of contravention of Section 39 of the Patents Act, 1970 (the Patents Act). The appellant had previously filed the patent application no. 2822/CHE/2014 in India thereafter filed the same application as a PCT application, the corresponding application in USPTO. The appellant later decided to file the patent of addition without obtaining permission under section 39 of the Patent Act and the appellant has obtained the grant for both US application. Therefore, the appellant has filed the Patent of addition in India, which was rejected by the respondent under section 40 stating that the patent applicant contravened Section 39 of the Indian Patents Act, 1970. The appellant argued that the permission under Section 39 was not required for this Patent of addition as the main application was firstly filed in India, and also the invention was not relevant for defence purposes or related to atomic energy to be eligible for refusal under Section 40 of the Patents Act, 1970. The respondent submitted that the mandate of Section 39 of the Patents Act is clear, and it does not admit any exception for a patent of addition.

The Hon'ble Madras High Court observed the following issue and noted that the previously the scope of section 39 was limited to inventions relevant for defence purposes or related to atomic energy and later when the scope of section 39 was expanded, the provision of Section 40 was not amended, therefore "the breach committed by the appellant would, at worst, qualify as a technical breach but would not trigger the deemed abandonment under Section 40 of the Patents Act". The Court directed the respondent to reconsider the patent application by imposing the procedural violation by taking recourse to Rule 137 of the Patents Rules 2003 or any other applicable provision, after providing a reasonable opportunity to the appellant.

**Nripendra Kashyap Esco Corporation (Appellant)
vs Asstt. Controller Of Patents And Designs
(Respondent)**

**Case Number: C.A.(COMM.IPD-PAT) 209/2022
Decided on: November 24, 2023**

The current appeal has been filed by the appellant in Delhi High Court against the respondent for refusing the divisional patent application for lack of plurality of invention. The refusal order has been issued under Section 16 of the Patents Act, stating that claim 1-4 in divisional application does not relate to claim 1-10 of the parent application. The appellant argued that the respondent did not raise this issue in the first examination report (FER) nor in hearing notice. The respondent counter argued that such practice of raising the objection during the hearing is common in Indian Patent office and the appellant has given an opportunity to respond to this objection.

The Hon'ble Court observed the following issue and noted that such procedure is not sustainable in law and stated that "If any additional objections arise during the course of hearing, the patent office would, at the very least, have to set out the said objections in writing and grant the patent applicant an opportunity to respond, in writing, thereto." The Court concluded by assigning the application to a competent Assistant Controller for de novo adjudication and to give an opportunity of hearing to the appellant.



309 Churchill Tower Business Bay, P.O. Box 415116 Dubai-United Arab Emirates
+971 4 582 6655
global@audirivox.com



www.audirivox.com

Editorial Board

Sarmad Hasan Manto
Attorney at Law
Managing Partner

Divyendu Verma
Attorney at Law
Head of Patents Dept.

Sphurti Dalodria
Content Editor

Nilesh B.
Designer

Disclaimer: This publication is intended to provide information to clients on recent developments in IPR industry. The material contained in this publication has been gathered by the lawyers at Audiri Vox for informational purposes only and is not intended to be legal advice. Specifically, the articles or quotes in this newsletter are not legal opinions and readers should not act on the basis of these articles or quotes without consulting a lawyer who could provide analysis and advice on a specific matter.

© 2023 Audiri Vox

This Newsletter is published by Audiri Vox at 309 Churchill Tower Business Bay, P.O. Box 415116 Dubai-United Arab Emirates on 3rd January, 2023.