

Roll No.....

Time allowed : 3 hours

Maximum marks : 100

Total number of questions : 6

Total number of printed pages : 4

**NOTE** : Answer **ALL** Questions.

1. Sitca Healthcare (hereinafter referred as 'Applicant') filed a divisional patent application on 11<sup>th</sup> May, 2007 numbered as 00077/NP/2007 for an invention "CRYSTAL MODIFICATION OF ACTIVE PHARMACEUTICAL INGREDIENT" for the patent application number 00072/NP/2007 having German Priority patent application number 1404/97 dated 10<sup>th</sup> June, 2003.

It was observed during substantial examination that claims 1-10 of parent application were reproduced verbatim in the claimed invention as claims 1-10. If the subject matter of any claimed invention relates to more than one invention, applicant can file further application any time before the grant of patent u/s 16(1) of the Patents (Amendment) Act, 2005.

Since claims of the claimed invention and claims of the parent application are verbatim, hearing was offered to the applicant to decide allowability of divisional status to the claimed invention u/s 16 of the Act. The Applicant replied that the Controller can offer hearing for deciding the divisional status only after sending a gist of objections to the applicant and giving him an opportunity to file a reply. He further stated that the Controller cannot decide the divisional status unless examined and passed through sections 12, 14 and 15 of the Patents Act. There is no such direction or any other guiding principle laid down in the Act as to how a Controller should proceed with divisional status of an application.

The Controller observed that application shall define distinct subject matter when compared with claims of parent application, which is first and foremost requirement to qualify as divisional application u/s 16 of the Act. Once claims of the claimed invention fulfil the requirement for the divisional application u/s 16, it can be further allowed for substantial examination, which will save time and effort of the patent administration and also it is logical approach as well. Since subject matter of claims 1-10 is verbatim with claims 1-10 of the parent application, there is no need for conducting substantial examination to assess the novelty, inventive step and other patentability criteria for the present application. The applicant claims the same set of claims submitted in the parent application in different multiple further

applications. The Controller further observed that the reason for filing such a divisional application is to prosecute once again the same set of claims already claimed in the abandoned parent application and also to extend the life of the application. If the subject matter of claims of the further application is not distinct with the claims of the parent application, divisional status shall not be granted. It is, therefore, wilful attempt to obtain multiple patents for a single subject matter through many further applications by misusing the provision of section 16 of the Act. Even though, each and every component of the claims 1-10 of the divisional application is verbatim with the claims 1-10 of parent case, the intention of the applicant by hook or crook is to extend the life of the application utilising divisional route, that too, on the last date of submitting reply to first examination report (FER) of the parent case.

There were 10 claims at the time of filing the claimed invention where claims 1-9 related to 'modification A of the compound 1-(2, 6-difluorobenzyl)-1H-1,2,3-triazole-4-carboxamide (namide)' (hereinafter referred as 'product claims') and claim 10 related to pharmaceutical preparation.

On 15<sup>th</sup> July, 2011, the applicant amended originally filed 10 claims into 12 claims by filing Form-13 u/s 57 and u/s 81(1) of the Act and Rules. The applicant amended 'modification A of the compound namide' in all the claims 1-10 into 'crystal modification A of the compound namide' and also added two new claims relating to 'method of preparing A of the compound namide' which is neither claimed in the International application nor in the National Phase application.

In response to the FER, the applicant further amended claim 11 by incorporating many additional features including identity and quality of the solvent for recrystallisation, filtration conditions necessary to generate a suspension with initial crystal, stirring time and temperature.

The patent application was opposed by way of pre-grant representation u/s 25(1) of the Act, by Indian Pharmaceutical Alliance, a Society registered under Societies Registration Act, 1860 (hereinafter referred as 'Opponent'). After hearing notice was served, the Applicant further amended all the 'product claims' into '21 method claims as method for preparing crystal modification A of the compound namide'. In the earlier amendment, the applicant introduced new matter in claim 11 & 12 'method of preparing A of the compound namide' but the later amendment converted all the claims into 'method for preparing crystal modification A of the compound namide,' the principal claim.

: 3 :

The applicant submitted a set consisting 13 method claims which they desired to rely on during hearing, (hereinafter referred as 'amended claims').

The patent agent for the applicant submitted that Rule 55 (5) of the Patents Rules, 2003 gives power to the Controller to require the complete specification to be amended to his satisfaction during the opposition, before proceeding to refuse the application.

The patent agent for the applicant submitted that amendment of claims is a primary right conferred upon the applicant by the Patents Act and it is possible to amend the claims to avoid overlapping with the citations; and the Controller should require the same rather than proceeding to reject the application. It is further submitted that the amended claims on file now fall well within the scope of section 59.

The patent agent submitted that it is well accepted fact that 'product claims' cover in its scope the process of its manufacture as well and therefore the amendment made to claims of this application satisfies section 59 of the Act in that the amendment is made by way of 'disclaimer' wherein the scope of the product is disclaimed and the claims are now restricted to the process of its preparation. Also that the scope of the claims is not extended and no new subject matter is added. The process claims are well supported by the description especially on the page 2 and last 3 lines, page 3 and 2<sup>nd</sup> para, and in examples 1, 2, 3, 4 and 5.

Keeping the above in view, prepare your arguments for opponent of the patent, covering division of patent, right of opposition under the Patents Act and the legal provisions applicable to modification of specification.

*(50 marks)*

2. Telly Toy brought into market a play toy named as "Jump Bhola", a spring balance, in which children can stand on and jump. It became very popular among the kids. The spring was, however, made up of plastic and hence it had many practical problems.

MeraKhilona, another competitor company, came up with a similar toy with a different name "Jump Bheem" made of a material which solved all the practical problems that "Jump Bhola", had.

Keeping the above in view, answer the following :

- (i) Can MeraKhilona claim patent protection for its product ?
- (ii) Assuming that MeraKhilona adopted the same logo and style of writing as that of Telly Toy, can MeraKhilona claim trade mark protection for its product ?

*(15 marks each)*

3. Industrial design plays an important role in the trading of consumer goods or products as well as helps economic development by encouraging creativity in the industrial and manufacturing sector. Discuss the salient features of the Designs Act, 2000.

*(5 marks)*

4. A patent search is a search conducted in patent data base to check whether any invention similar to the invention in respect of which patent is obtained, already exists. Discuss the patent search, patent data base and various types of searches used in patent documentation.

*(5 marks)*

5. Write a note on 'patent co-operation treaty'.

*(5 marks)*

6. Explain 'deceptive similarity of a trade mark' with example.

*(5 marks)*