

IN THE HIGH COURT OF DELHI AT NEW DELHI

WRIT PETITION (C) NO. 5590 OF 2015

IN THE MATTER OF:

SHAMNAD BASHEER

... PETITIONER

VERSUS

UNION OF INDIA & OTHERS

...RESPONDENTS

FURTHER AFFIDAVIT ON BEHALF OF RESPONDENT NO. 4

I, Narendra Reddy Thappeta, son of T. Sri Chandrasekhara Reddy, aged about 53 years, resident of 158, Phase 1, Adarsh Palm Meadows, Ramagundanahalli, Bangalore – 560066, do hereby solemnly affirm and state as under:

1. That I am the Respondent No. 4 herein; I am well acquainted with the facts and circumstances of the case and am as such competent to affirm the present affidavit. I state that I have already filed a detailed reply to the above writ petition, supporting the Petitioner's contentions as regards the vague and often irrelevant/inappropriate nature of Form 27 of the Patent Rules, 2003 to the various variety of inventions, particularly in the field of information and communication technologies.



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2. I state that I am filing the present additional reply, with a view to supplementing my reply dated 12th February 2016 filed in the above proceedings, so as to place on record certain additional facts and documents that have taken place after the filing of my reply. The contents of my first reply are reiterated but are not being repeated herein for the sake of brevity.
3. This additional submission is made primarily for the purpose of drawing the attention of the Hon'ble Court to the challenges faced by the Patentees with electronic filings of working statements (form-27).
4. As a background to this additional submission, I note that the Ministry of Commerce and Industry on 26th October 2015 issued a draft of 'The Patents (Amendment), Rules, 2015' (hereinafter '**Draft Rules**') and invited suggestions and/or objections from members of the public. As set out in my first reply, I participated in the consultation process and submitted concerns regarding the format of Form 27 to the authorities. A copy of the Answering Respondent's submissions at that time are already placed on record at ANNEXURE R4/7. A copy of the draft form of the then proposed Draft Rules is herewith submitted as **ANNEXURE R4/8**,



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which overlaps in many respects with the currently operative form which was introduced via the Patents Rules 2003 (hereafter '**Original Form**'). In view of the inputs from the stakeholders, the Patent Office reverted to the prior form (i.e., Original Form), instead of addressing the concerns expressed by the various stakeholders that were applicable also with respect to the Original Form.

5. The Patent Rules 2003 were further amended by Patents (Amendment) Rules, 2016 with effect from 16-5-2016. Rule 6 (1-A) of the amended rules mandates that patent agents file all documents, including form-27, only by electronic transmission duly authenticated. This has practically meant that the agents are mandated to submit Form-27 only using the forms designed and provided by the Patent Office on the e-filing portal. As the Patent Office rolled out the electronic version of form-27, the patentees have become painfully aware of the various practical problems with the choice of design of the electronic version of form-27 controlled only by the Patent Office, and not by the patentees.

6. The fundamental problem with the electronic version of form-27 is the absence of flexibilities to the Patentees, which clearly



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thwart the pertinent disclosures the patentees would wish to provide, as applicable to their specific technology and business context, consistent with the objectives of the Patents Act 1970. For example, one may visualize a less than thumb size component (or merely a digital design of the same) provided by one technologist in their area of specialization eventually gets sold to an end-customer in India in the form of a much bigger computer system. In the applicable channels of trade, the component may change hands of several parties as the pertinent products are incrementally developed before the product is eventually sold in India. Many of the intermediate parties from the designer of the thumb size component to the eventual seller of the large computer system, may not operate in India nor have direct relationship with the designer of the thumb size component. Assuming the patent is directed to the thumb size component, the patentee should be able to disclose the working of her/his invention based on the general availability of the computers s/he is aware of, consistent with the objectives of the Patents Act 1970. Should the patentee of the thumb size component be forced to instead record different information,



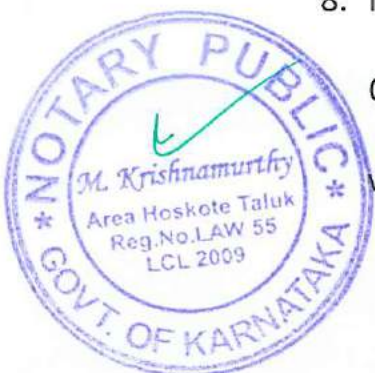
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that would be inaccurate information contrary to the objectives of the Patents Act. The electronic form-27, by its rigid design in requiring various entries, could thus thwart even the law abiding and good intentioned patentees from being able to disclose the pertinent information and aid the objectives of the Patents Act.

7. The rigid design of form-27 can also force the patentees to disclose less pertinent information at the exclusion of more pertinent information, again contrary to the objectives of the Patents Act 1970. As a simplified example for illustration, a patented cloud/web based technological patent that clearly satisfies the working requirements (due to ubiquitous reach of the web) may be reported as one unit during first year of implementation and zero units (since not 'made' in the corresponding calendar year) in years thereafter, while the statutory objectives may be much better satisfied by merely naming the product with the corresponding operational status, that would be clearly identified by the public and the authorities.

8. I made a further representation dated 12th September 2017 to the Controller General of Patents, providing more detailed examples while generally explaining that the working requirements are



NO. OF CORRECTIONS: *nil*

satisfied in ways not contemplated by the current form-27 reflecting the varied ways in which technologies such as computer related inventions (CRIs) manifest (again, a character not shared in the pharmaceutical space). A true copy of my representation sent by email dated 12th September 2017 is annexed as **ANNEXURE R4/9**. I also submitted the said representation by email to the Department of Industrial Policy & Promotion and the Indian Patents Office in December 2017 in the context of a stakeholders' meeting held in New Delhi (which I did not attend). Subsequently, the Indian Patents Office issued on 02 Jan 2018, a statement setting out the various concerns raised by stakeholders and the steps initiated by the Patents Office in response. My representation has been taken note of at item 99 and the Patent Office has indicated that the said concern will be examined. True copy of the Statement issued by the Patent Office is annexed as **ANNEXURE R4/10**.

9. In summary, I thus state that the Electronic Form-27 as it presently stands, unlike its earlier version of Form 58 (particularly in paper form) of the Patent Rules, 1972, does not contemplate flexibility of response so as to take into account the wide variety



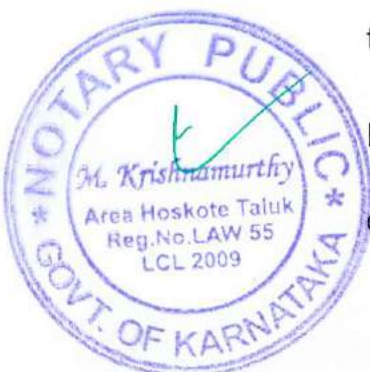
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nil

of inventions in multiple areas of technology. Furthermore, it is not possible for any patentee to stipulate on the online form that certain information is incapable of being supplied, for whatever legally permissible purpose.

10. I also draw the attention of the Hon'ble Court to critical foundational questions that the officials at Patent Office have been unable to guide the patentees over the past several years, as Form-27 practice diverged from the open-ended questions of the erstwhile Form 58 towards the present Form.

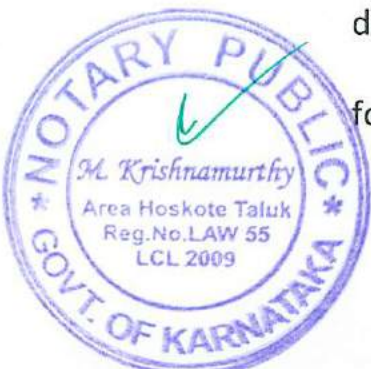
11. The first one of such foundational questions is what is 'patented invention' for the purpose of Form-27 practice. I believe that question is easy to answer with close to legal certainty in areas such as pharmaceuticals when the claim (defining the invention) covers a chemical composition. That same level of clarity is not there in areas such as information and communication technologies and accordingly presents challenges for the patentees in form-27 practice. A similar question on establishing the boundaries of patented invention comes up in 'infringement proceedings', but the courts in India have not had occasion to deal with the complexity of that question thoroughly to provide



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clear guidance in areas having character close to information and communication technologies. The patentees are accordingly forced to examine the practices in other jurisdictions in defining 'patented invention' as relevant to individual patents. For example, in US, the court conducts an extensive pre-trial hearing of 'claim construction' to establish the boundaries of the patent at dispute. That pre-trial hearing is commonly known as 'Markman Hearing', which is explained briefly in the related wiki page attached hereto as ANNEXURE R4/11. It is my understanding that very rarely do patentees go through similar rigor of claim construction merely for the purpose of annual compliance in answering form-27.

12. The repeated reference to 'Patented Invention' in form-27 often leaves the patentee with the concern whether the Patents Act 1970 requires them to conduct a similar level of due diligence. Specifically, it is a concern whether the penal provisions of section 122 would be necessarily attracted in the absence of such due diligence in view of the references to 'Patented Invention' of form-27.



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13. The statements in the preceding two paragraphs may beg the question as to whether a patentee does not know the scope of the 'Patented Invention'. Indeed, in many complex cases, the patentee does not know that actual precise scope given the complex questions of claim interpretation that are involved (including the nuances of the interpretation of words in the claims/specification, estoppels, closer look at plethora of prior art that may or may not have been examined, etc.). The scope of a patent and the product coverage is not precisely known for another important reason. The lifespan of a patent is 20 years from the date of filing, and the inventors may have left the patentee organization before even the patent grant or worse before the invention is implemented as a product by the patentee organization. Added to this is the constant redesign of the products (which fact does not exist in pharmaceutical area) and one does not examine the details of the evolving products/versions (in potentially different group/location, etc.) normally as against each pending patent in the organization's portfolio of patents.



NO. OF CORRECTIONS.

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14. In view of the above, it is my understanding that the legal practitioners in India have guided the patentees of information and communication technologies space to provide good-faith answers based on general understanding of the "patented technology" (representing a general but reasonably precise understanding of what is sought to be patented), which is legally understood to be different from "patented invention" (which defines the precise scope of the patent grant).

15. Even assuming the answers are sought to be provided based on patented technology at a general level (disregarding the difference from 'patented invention' used in the Patents Act in relation to Working Statements), the Patent office officials in the past have been unable to answer several questions on how to provide various counts/numbers requested in Form-27 recently. As merely an illustrative example, there are often scenarios in which two devices may be implemented in collaboration for a specific purpose. The same technology can be claimed directed in an apparatus form to cover the first system, the second system, a part/component of the first system or the second system, or the combination under various provisions of the



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Patents Act 1970. In addition, the same patent application can have method claims. The claims can potentially be of slightly different scope in technical subject matter, but linked by the same inventive concept under section 10 of the Patents Act upon payment of the applicable fees. These different sets of claims are presented to take full advantage of the provisions of the Patents Act with a view to protect the inventive aspects in various ways it can manifest in the market place. It is unclear whether the patentee needs to use one form or multiple forms for each of such claims in the same patent application, in addition to the mode of measurement of units being unclear for method claims which can be directed to internal operation of the apparatus.

16. The concerns noted above can be addressed, for example, by an undertaking that the Executive branch will provide written guidance with examples in various typical factual scenarios, on how to complete online version of Form-27 they implement, particularly for all the mandatory fields. Such a practice would be clearly in line with the progressive practices the Patent Office has followed in issues related to computer related inventions (CRIs) in the past few years.



NO. OF CORRECTIONS. *nil*

17. The result of the absence of clarity both from a legal and operational point in view of above, combined with punitive measures on the books of the Patents Act 1970, has been fear, uncertainty and doubt in the minds of patentees who wish to clearly abide by the law.

18. The Hon'ble Court is accordingly respectfully urged to provide sufficient guidance and direction to ensure a system that is easily usable by the patentees to provide the most pertinent information for conveying the working details of the invention consistent with the statutory objectives.

19. Should the Hon'ble Court entertain the suggestion of an expert committee for the purpose of redesigning form-27, it is respectfully urged that representatives be included, among others felt suitable, experts from industries in various disciplines reflecting the diverse character of the patented technologies in the related business environments.

20. It is submitted that therefore, inasmuch as the Respondents 1 to 3 have themselves acknowledged the practical problems faced in filling out Form 27, particularly in relation to non-pharmaceutical inventions, and have undertaken to examine the said issue, they



must necessarily do so in a time bound fashion, so as to enable patentees and licensees to comply with their obligations for the current year, i.e. before 31 March 2018.

Naren Thappa
DEPONENT

VERIFICATION

I, the above named Deponent, do hereby solemnly affirm and verify that the contents of this affidavit are true to best of my knowledge and belief and nothing material has been concealed therefrom.

Verified on this the 16th day of January, 2018 at Bangalore.



Naren Thappa
DEPONENT

SWORN TO BEFORE ME

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NO. OF CORRECTIONS