

## **Non-disclosure of information on foreign patent application a ground for revocation of patent**

Under Section 8 of the Indian Patent Act, 1970, an applicant of a patent in India is bound to give a statement setting out detailed particulars of any corresponding foreign application in respect of the patent and also provide an undertaking that up to the date of grant of the patent in India, he would keep the Controller informed in writing from time to time of detailed particulars of such foreign application. Under Section 64(1)(m) of the Act, one of the grounds for revocation of a patent is that the applicant 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.

In a suit filed by Chemtura Corporation, an US company against the Union of India and three private party defendants being Indian companies, claiming infringement of its patent, the High Court of Delhi had the occasion to consider the validity of Chemtura Corporation's patent on the ground of non-disclosure to the Controller of Patents of complete details of its foreign patent applications filed in the United States of America and the European Union.

The suit was sparked off by a revocation application filed by the private party defendants in the suit against the plaintiff's patent before the Intellectual Property Appellate Board (IPAB), after they were served with a legal notice by the plaintiff's attorneys requiring them to cease infringing the subject patent. The invention of the patent in question related to a side bearing pad assembly for absorbing and cushioning compression forces which is used in the railway industry for manufacture of rail coaches.

According to the plaintiff, the invention was copied by the three private party defendants, who then participated in a tender floated by the Union of India for the procurement of 46,800 pieces of the said products. As the private party defendants were unable to demonstrate *prima facie* good grounds for revocation of the plaintiff's patent, the Court restrained them from manufacturing, using or offering for sale any device in infringement of the plaintiff's patent.

The defendants thereafter filed an application seeking the vacation of the aforesaid order, *inter alia*, on the ground that the plaintiff's patent was not a valid patent as it failed to disclose the information required under Section 8 of the Act to the Controller. It was contended that had those details been disclosed, the patent would never have been granted by the Controller in India. The plaintiff's defense to the said argument was that if every stage of foreign applications were to be disclosed to the Controller, it would make his task impossible and cumbersome.

After hearing the parties, the Court in its order dated August 28, 2009 vacated the interim injunction granted originally. The Court pointed out that, while vulnerability of a patent was an issue at the preliminary injunction stage, validity was an issue at trial; however, the showing of a substantial question as to invalidity of the patent required less proof than

the clear and convincing evidence necessary to establish invalidity itself. The Court pointed out that the defendants had raised a credible challenge to the validity of the patent of the plaintiff under section 8 of the Act as there was no indication that the plaintiff furnished the necessary details of its corresponding American and European patent applications to the Controller in India from time to time despite a written request from the Controller to that effect. In fact, by June 12, 2002, the plaintiff had amended the claims in its American application at least five times as it was not able to overcome the closely similar prior art citations from the US patent office. Similarly, broad claims in its European application were narrowed down due to several prior art citations. However, these aspects were not disclosed in the response to a specific request of October 20, 2004 by the Controller of Patents in India seeking the status of the plaintiff's foreign applications. The Court opined that an applicant was required to periodically update the Controller on the current status of the corresponding foreign applications and that mere furnishing of information on the status of the application did not constitute periodical updates.

The Court pointed out that under section 43(1)(b) of the Act, a patent could be granted only when the application was found not to be contrary of any provisions of the Act and that it could not be said that the omission to comply with the requirement under section 8 was not serious enough to affect the decision of the Controller to grant the patent to the Plaintiff. Accordingly, in view of the *prima facie* non-compliance by the plaintiff of the requirements of Section 8, the Court found that the ground for revocation as contained in Section 64(1)(m) of the Act was attracted.