

## **The Patents (Amendment) Ordinance, 2004**

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Most significant amendment is deletion of section 5, which makes food, medicine, drugs, and products of chemical reactions patentable, providing impetus to pharmaceutical/chemical industries having strong R&D.

However, section 3(k) amendment simply formalized practice followed by patent office. Software *per se* is not patentable; but embedded in hardware is patentable. Our strong industry deserves patents for software *per se*. Its protection as copyright is insufficient because that only protects expression and not idea. But, its still a step forward.

Substitution of words “new use” with words “mere new use” in section 3(d) will help obtain patent for “non-obvious” use of substance.

However, amendment in section 10[4(A)] doesn't resolve problem. Amendment facilitates incorporation of bio-material deposition details within prescribed period provided deposition is be made before filing application. We have only one International Depository in India with several limitations. Sending material abroad faces both scientific and legal difficulties. Therefore, amendment should have provided for depositing material anytime during prosecution, like in other countries.

Proposal for post-grant opposition to replace pre-grant opposition was with logic that when less than 1% of accepted cases are opposed then why to delay grant of patent to remaining 99%. Ministry appeared to have agreed but, pressure from allies gave shape to strange amendment, providing for both pre and post grant opposition. However, overall provisions for opposition are simplified but time frames have to be defined.

Chapter IVA for EMR is been deleted. However, as transitional provision, applications pending for grant of EMR will be considered as Request for Examination for applications. Granted EMRs will remain in force till acceptance/rejection of corresponding application.

Newly inserted section 92(A) provides for grant of Compulsory licence (CL) for manufacture and export of patented pharmaceutical products, including diagnostic kits and ingredients, to countries having insufficient/no manufacturing capacity and are facing health problems, provided such countries have issued CL.

Rights for mailbox applications will be available only from date of grant of patent and not retrospectively. So, it provides protection to generic manufacturers against infringement suits, till the grant.

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