

IN THE HIGH COURT OF SINDH, KARACHI

M.A.No.07 and 61 of 2010

(Hilton Pharma (Pvt.) Ltd. v/s. UCB, SA and another)

M.A.No.08 to 33 of 2010

(Pakistan Pharmaceutical Manufacturers v/s. The Controller of Patents and another)

M.A.No.62 of 2010

(Getz Pharma (Pvt.) Ltd. v/s. Merck Frosst Canada & Co and another)

M.A.No.77 of 2010

(Sami Pharmaceutical (Pvt.) Ltd. v/s. Merck Frost & Co and another).

M.A.No.78 of 2010

(AGP (Pvt. Ltd. v/s. Merck Frost and Co. and another)

M.A.No.47 of 2012

(Otsuka Pharmaceutical Co. Ltd. v/s. The Controller of Patents and another)

Before: Mr. Justice Zulfiqar Ahmad Khan

Date of Hearing : 20.02.2017
Date of Order : 31.05.2017
Appellants : Through Mirza Mehmood Baig, Advocate
Respondents : Mrs. Amna Salman, Advocate for Respondent No.1.
Mr. Salim Ghulam Hussain, Advocate for Respondent No.2 (the Controller of Patents)
Mr. Qamar-ud-din, Advocate for Respondent No.2 in M.As No.15 and 22 of 2010.
Mr. Khwaja Shoaib Mansoor, Advocate

JUDGMENT

Zulfiqar Ahmad Khan, J.:- The order passed by the Controller of Patents dated 15.01.2010 is impugned through the instant Miscellaneous Appeals, where Patents filed by 32 entities, which *inter-alia* included UCB

A. A Belgium, Pfizer Products, Inc. USA, Merck & Co. Inc. USA, LES Laboratories Servier France, F. Hoffmann-La Roche AG, Switzerland, Chiesi Farmaceutici SpA, Italy, SmithKline Beecham Biological S.A Belgium, Janssen Pharmaceutical N.V. Belgium, Novartis A.G., Switzerland, SmithKline Beecham Corporation USA, Astra Aktiebolag Sweden, Bayer Healthcare AG. Germany, Bristol-Myers Squibb Company USA, Warner-Lambert Company, USA, Zeneca Limited and University Court of the University Aberdeen, F. Hoffmann–La Roche AG Switzerland, AstraZeneca AB Sweden and Almirall Prodesfarma SA, Spain when advertised in the Patent Gazette (Part-V) were opposed by the Appellants on the prescribed Form P-7, however, without accompanying the statement setting out fully the nature of the opponent's interest and the facts upon which he relies and the relief which he seeks, as required under Rule 18(1)(c) of the Patent Rules, 2003 (hereinafter referred to as "the Rules"), which oppositions were held by the impugned order to be made in violation of the applicable rules and were dismissed, hence the instant appeals were preferred.

2. Brief facts of the case are that the Respondents filed Black Box as well as regular process per se applications for grant of patents in respect of their respective inventions under section 13 of the Patent Ordinance, 2000 (hereinafter referred to as the "Ordinance") under the scheme envisaged by the Ordinance and Rules. The applications were examined under section 16, thereafter the same were accepted under section 21 and the said acceptance, under section 21, was advertised in the Gazette of Pakistan Part-V for Opposition under section 23. Section 23 requires any Opposition to be filed at any time within four months from the date of advertisement of the acceptance of a complete specification. The operative part of section 23 is reproduced hereunder:

23. Opposition to the grant of patent.- (1). *At any time within four months from the date of advertisement of the acceptance of a complete specification under this*

Ordinance, any person may give notice to the Controller of opposition to the grant of patent on any of the following grounds.....:"

The manner in which applications ought to be opposed is described in details under Rule 18 of the Rules, which is reproduced hereunder:

18. Opposition to grant of patent:- (1) A notice of opposition to the grant of a patent,

- (a) shall be given in the form as set out in Form P-7;*
- (b) shall state the ground or grounds on which the opponent intends to oppose the grant, and*
- (c) shall be accompanied by a statement in duplicate setting out fully the nature of the opponent's interest, the facts upon which he relies and the relief which he seeks.*

(2) A copy of the notice and of the statement shall be sent by the Controller to the applicant.

(3) If the applicant desires to proceed with his application, he shall, within two months of the receipt of such copies, file a counterstatement setting out fully the grounds upon which the opposition is contested and deliver to the opponent a copy thereof.

(4) The opponent may within two months from the receipt of the copy of the counterstatement file evidence in support of his case and shall deliver to the applicant a copy of the evidence.

(5) Within two months from the receipt of the copy of the opponent's evidence or, if the opponent does not file any evidence, within two months from the expiration of the time within which the opponent's evidence might have been filed, the applicant may file evidence in support of his case and shall deliver to the opponent a copy of the evidence; and within two months from the receipt of the copy of the applicant's evidence, the opponent may file evidence confined to matters strictly in reply and shall deliver to the applicant a copy of the evidence.

(6) No further evidence shall be filed by either party except by leave or direction of the Controller.

(7) Copies of all documents referred to in the notice of opposition or in any statement or evidence filed in connection with the opposition, shall be furnished in duplicate for the Controller's use unless he otherwise directs. Such copies shall accompany the notice, statement or evidence in which they are referred to.

(8) Where specification or other document in a foreign language is referred to, a translation thereof, verified by statutory declaration or otherwise to the satisfaction of the Controller, and two copies of the translation, shall also be furnished.

(9) On completion of the evidence if any, or at such other time as he may deem fit, the Controller shall appoint a time for the

hearing of the case, and shall give the parties at least thirty days' notice of the appointment.

(10) If either party desires to be heard he shall within ten days of receipt of the notice under sub-rule (9) above notify the Controller in the form as set out in Form P-8 and the Controller may refuse to hear either party who has not filed the said form prior to the date of hearing.

(11) If either party intends to refer at the hearing to any publication not already mentioned in the proceedings, he shall give to the other party and to the Controller at least ten days' notice of his intention, together with details of each publication to which he intends to refer.

(12) After hearing the party or parties desiring to be heard or, if neither party desires to be heard, then without a hearing, the Controller shall decide the case and notify his decision to the parties.

(13) If in consequence of the proceedings the Controller directs that a reference to another patent shall be inserted in the applicant's specification under sub-section (1) of section 17, the reference shall be as prescribed by rule 15.

(14) If the applicant notifies the Controller that he does not desire to proceed with the application, the Controller in deciding whether costs should be awarded to the opponent shall consider whether proceedings might have been avoided if the opponent had given reasonable notice to the applicant before the opposition was filed."

3. As it is evident from the review of the foregoing that while section 23 requires opposition to be filed within four months from the date of advertisement under Rule 18, such an opposition has to be in the prescribed Form P-7 and said notice of opposition as per Rule 18(1)(c) is required to be accompanied by (i) a statement setting out fully the nature of the opponent's interest, (ii) the facts upon which he relies and (iii) the relief which he seeks. The case at hand is that the present Appellants (Opponents before the Patent Office) had filed the opposition applications on the prescribed Form P-7, however, the said Form P-7 did not accompany the requisite statements mandated under Rule 18(1)(c), however, when this fatal deficiency was noted, the Opponents later on filed these statements, but till that time, the statutory limit prescribed under section 23 of four months had already expired. In the backdrop of this, the

impugned order was passed, where the learned Controller of Patents refused to consider the statement filed after the expiry of statutory limit of four months and dismissed the applications filed on Form P-7 for opposition as these were deficient of the 18(1)(c) statement.

4. Learned counsel for the Appellants while admitting the fact that the requisite 18(1)(c) statement was not accompanied with Form P-7, however, submitted that these were filed alongwith the application for extension of time made on Form P-4 under sections 16(6), 27(3), 32(2), 88(1) and Rules 18(8), 14(6), 14(7), 21(2), 24(3) and Rule 62. A perusal of governing Rule 62 makes it clear that the Controller in prescribed circumstances has powers to enlarge time prescribed by these Rules for a maximum period of three months. Full text of Rule 62 is reproduced hereunder:

“62. General powers to extend time:- *The time prescribed by these rules for doing any act or taking any proceeding thereunder may be enlarged by the Controller if he thinks fit and upon such terms as he may direct. Provided that no such extension of time granted under this rule shall exceed a period of more than one month at a time, provided that total period of such enlargements shall not exceed three months against the statutory period prescribed. Every application for extension of time under this rule shall be made in the form as set out in Form P-4.”*

5. From the above, it is worth noting that while there are powers granted under Rule 62 to enlarge time, but such powers are only in relation to extension of time prescribed by the Rules and not the time prescribed by the Ordinance. Since Rules are always subservient to an Act, section 21 of the Ordinance, 2000 in clear terms provide a period of four months for filing of opposition, therefore, the Controller took notice of this limitation and passed the impugned order, stating that no extension of time could have been granted beyond the statutory time prescribed under section 21 for four months through Rule 62.

6. A detailed analysis of the Form P-4 was made during the course of hearing before the counsel of the respective parties to show what

possibility envisaged for extension of time through Form P-4, are only restricted to the circumstances arising out of Sections 16(6), 27(3), 32(2) and 88(1) of the Ordinance. There is clearly no mention that Form P-4 could be used to seek any extension of time as allegedly sought by the present Appellants under section 21 of the Ordinance, 2000.

7. Before proceeding any further, it would be worthwhile to dissect the possibilities envisaged by Form P-4, where extension of time could be granted. These possibilities are given hereunder:

1. Section 16(6) is applicable for cases where the appellants for patent have not complied with any official objection within 18 months.
2. Section 27(3) relates to sealing of a patent by an inventor.
3. Section 32(2) relates to extension of time for payment of renewal fee by the appellant/inventor.
4. Section 88(1) pertains to the possibility of extension of time given to an inventor, who intends to claim the conventional period in respect of his patent.

8. Combined effect of the above analysis is that there is no legal possibility contained within the four corners of the Ordinance and Rules that time to file statement mandated under Rule 18(1)(c) could be extended beyond the term of four months prescribed under section 21 through mechanism administrated by Form P-4. All these factors have been taken care by the learned Controller of Patents, who passed the impugned order. It was contended on behalf of the Respondents that once the statutory limit of four months has expired in the light of 1987 MLD 509, 1995 MLD 638, 2008 SCMR 1148 and 2007 SCMR 307, rights of the applicants for patents are cemented and the window of intervention is closed. The learned counsel for the Respondents also submitted that law as laid down in 2001 SCMR 838, 1988 CLC 1358 and PLD 2002 Karachi 457 establishes that anything required by law has to be done in the

manner prescribed, otherwise it has no legality in the eyes of law, therefore, the act of filing documents required by Rule 18(1)(c) after the expiry of statutory period of four months were rightly considered as nullity by the Controller of Patents.

9. Learned counsel for the Appellants drew Court's attention the fact that Controller of Patents had initially accepted extension of time application filed on Form P-4 and allowed the present Appellants to file 18(1)(c) statement, therefore, the Controller could not have through the impugned order refused the 18(1)(c) statement.

10. To recapture, as described in the foregoing, while section 21 in clear terms restricts the period of four months for filing of opposition, Rule 18 requires that the opposition to be made on Form P-7 and the same to be accompanied by a statement setting out fully the nature of opponent's interest and the facts upon which he relies and the relief which he seeks as required under Rule 18(1)(c). Be that as it may, the statute is very clear that there is no possibility for extension of time beyond four months for filing of opposition under section 23. In this regard it is important to mention that the patent laws are very specialized and time sensitive, and have to be dealt with so. The possibility available in the general laws with regards the failure to comply with technicality would not be available under the specialized patent laws. The concept of patent revolves around the fundamental principle that inventor be granted monopoly upon his disclosure of the patent to public. The monopoly hinges on the disclosure. Monopoly and disclosure are thus two legs of a patent system and one cannot stand straight without the other. Under patent laws, while a mechanism has been provided for filing the patent by an inventor, the disclosure requirement are given the longish period of four months by the statute itself and not left to Rules. This window closes after the lapse of four months, as it could be seen from the detailed

analysis of the Rules in the foregoing that there is no legal possibility to reopen this window as the inventor's rights cement on the expiry of this four months' period, whereafter the inventor is only required to pay sealing fee and have his patent granted to him, whereafter he enjoys the monopoly upon him having made the disclosure to the public, which disclosure goes into public domain and people at large are free to use this information, except to reproduce the product or to use the process for commercial gains or in any manner violating the scheme envisaged by the patent laws.

11. In the given circumstances, the Appellants had clear opportunity to file their opposition within four months' period, which they failed to do without providing the mandatory statement under section 18(1)(c). In case when Form P-7 is filed without the statement of nature of opponent's interest and the relief which he seeks, meaning thereby the Form P-7 itself could not be considered to be of any benefit to the Opponent as no relief could be provided to him merely on the basis of Form P-7. It is also pertinent to mention that the requirement of an opposition to accompany the statement setting out nature of opponent's interest and the facts on which he relies and the relief which he seeks required under section 18(1)(c) is not only limited to legislation in Pakistan, these provisions exist in many countries around the world including New Zealand, Ireland, Japan and European Patent Office.

12. Before concluding, it is worth mentioning that if the Controller would have admitted the documents mandated to be filed alongwith Form P-7 after the expiry of the statutory period of four months under Section 21, this act would have amounted to enlarge the time limit of four months prescribed under Section 21 of which there is no legal possibility, as the Controller's power to enlarge time are only restricted to situations, which are described in the heading of Form P-7, wherefrom it could be seen that there is no power to extend the period for meeting the

requirement of Rule 18(1)(c), therefore, the Controller rightly refused the opposition filed by the present Applicants.

13. In view of the foregoing discussions, impugned order passed by the Controller of Patents dated 15.01.2010 does not require any interference of this Court. Accordingly, the instant Miscellaneous Appeals are dismissed alongwith all pending applications, with no order as to costs.

Judge