



FORM 7-A
THE PATENTS ACT, 1970
(39 OF 1970)
AND
THE PATENTS RULE, 2003
REPRESENTATION FOR OPPOSITION TO GRANT OF PATENT
[Section 25(1); Rule 55]


I, Sheela Pawar, an Individual, having address as A/603, Gokul Kshitij, Gokul Township, Agashi Road, Bolinj, Virar (West), Thane – 401303, Maharashtra, India, hereby give representation by way of opposition in respect of National Phase Indian Patent Application No. 9668/DELNP/2007, claiming priority date May 13, 2005, filed on December 13, 2007 by The Regents of the University of California and published on June 20, 2008, on the following grounds:-

- i. Section 25(1)(h) - *that the applicant has failed to disclose to the Controller the information required by Section 8 or has furnished the information which in any material particular was false to his knowledge and*
- ii. Section 25(1)(i) - *that in the case of convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title.*

Detailed grounds of opposition and evidence in the form of Annexures (**Annexure I to Annexure V**) thereof are enclosed herewith.

Address for services in India is A/603, Gokul Kshitij, Gokul Township, Agashi Road, Bolinj, Virar (West), Thane – 401303, Maharashtra, India, email id-sheelavpawar@yahoo.co.in

Dated this 27th day of July, 2015


Sheela Pawar
(Opponent)

To,
The Controller of Patents,
The Patents Office,
Delhi

IPO DELHI 28-07-2015 15:54

BEFORE THE CONTROLLER OF PATENTS, DELHI

IN THE MATTER of Sec. 25(1) of The
Patents Act; 1970, as amended up to The
Patents (Amendment) Act, 2005

And

IN THE MATTER of Rule 55 of The
Patents Rules, 2003, as amended upto the
Patents (Amendment) Rules, 2014

And

IN THE MATTER of Patent Application
No. 9668/DELNP/2007 A having priority
date of May 13, 2005 filed by THE
REGENTS OF THE UNIVERSITY OF
CALIFORNIA

..... APPLICANT

And

IN THE MATTER of PRE-GRANT
OPPOSITION filed by SHEELA PAWAR

..... OPPONENT

**WRITTEN STATEMENT
PRE-GRANT OPPOSITION
U/S 25(1) and Rule 55
Of The Patents Act, 1970
And Rules thereunder
Patent Application No. 9668/DELNP/2007**

I, Sheela Pawar, an Individual having Indian Nationality and address at A/603, Gokul Kshitij, Gokul Township, Agashi Road, Bolinj, Virar (West), Thane – 401303, Maharashtra, India (hereinafter referred to as “Opponent”), submits that a representation by way of Pre-grant Opposition under Section 25(1) of The Patents Act, 1970 and Rule 55(1) of the Patents Rules, 2003, is being filed by the Opponent abovenamed, to oppose the National Phase Patent Application No. 9668/DELNP/2007 bearing title “*DIARYLHYDANTOIN COMPOUNDS*” filed by THE REGENTS OF THE UNIVERSITY OF CALIFORNIA.

It is submitted by the Opponent as follows:

1. LOCUS STANDI

That Representation by way of Opposition can be made by any person, in writing under Section 25(1) of The Patents Act, 1970. The Opponent is interested under Section 2(1)(t) in the field of the impugned invention.

Additionally, the Opponent is interested in the subject matter being associated with patents. Hence the Opponent has *locus standi* to initiate the present pre-grant opposition proceedings.

2. JURISDICTION

The alleged Patent Application has been filed in the Patent Office, Delhi.

The jurisdiction for this Pre-grant Opposition therefore, is the Patent Office, Delhi, where this Pre-grant Opposition is being filed.

3. Representation by way of Opposition is being filed in Form 7 (A), under Section 25(1) of The Patents Act, 1970 and under Rule 55, thereof.

4. BACKGROUND OF THE CASE

- 4.1. It is submitted by the Opponent that the impugned National Phase Patent Application No. 9668/DELNP/2007 having priority date of May 13, 2005 filed by THE REGENTS OF THE UNIVERSITY OF CALIFORNIA on December 13, 2007 bearing title "*Diarylhydantoin Compounds*" was published under Section 11(A) in the Official Journal of Indian Patent Office on June 20, 2008. The said National Phase Patent Application is derived from PCT Application No. PCT/US06/11417 (Publication No. WO 2006/124118) which was filed

on March 29, 2006. The bibliographic page is attached herewith as **Annexure I** and copy of 'as filed' complete specification of the Patent Application No. 9668/DELNP/2007 relating to WO2006/124118 retrieved from the Indian Patent Office Website is attached herewith as **Annexure II**.

5. GROUNDS OF OPPOSITION

The specific grounds of the present Pre-grant opposition against grant of Indian Patent Application No. 9668/DELNP/2007 are reproduced herein below:

25(1)(h) that the applicant has failed to disclose to the Controller the information required by Section 8 or has furnished the information which in any material particular was false to his knowledge;

25(1)(i) that in the case of convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title.

6. The statement and evidence, in support of the grounds of Opposition, as above are hereinafter submitted as follows:-

6.1. The Applicant furnished the information which in any material particular was false to his knowledge – 25(1)(h)

6.1.1. At the outset, it is brought to the kind attention of the Ld. Controller that the PCT Application No. PCT/US06/11417 (filed on March 29, 2006) bearing Publication No. WO2006/124118), from which the impugned National Phase Patent Application No. 9668/DELNP/2007 is derived, has 51 claims. A copy of the claims of said PCT application are attached herewith as **Annexure III**. The impugned National Phase Application was entered in India, on December 13, 2007 with 46 claims only, thereby deleting 5 claims of equivalent PCT application.

6.1.2. It is pertinent to note that the Applicant did not disclose to the Ld. Controller that the equivalent PCT application from which the impugned National Phase Application is derived, has 51 claims and that the 5 claims were deleted owing to which the “as filed” claims of the impugned National Phase patent

application were 46 claims. The Applicant, with a malafide intent, merely submitted Form 13 (Annexure IV) on December 13, 2007 (filing date of the impugned patent application), for amending the claims but did not submit the marked up copy of amended claims at the Patent Office. **The Applicant did not clearly mention the reason for amending the claims in Form-13, instead falsely and malafidely stated "We wish to revise the claims by way of correction & explanation"** Thus the presence of 51 claims in the equivalent PCT application was not precisely disclosed to the Ld. Controller. Non-submission of marked up copy was particularly objected by Ld. Controller in Point No. 8 of said FER. The said Point No. 8 is reproduced herein below.

"8. *Marked up copy of amended claims also not provided by the applicant, so the Form-13 filed on 13/12/2007 also not allowed*"

6.1.3. It is submitted that Patent Application No. 9668/DELNP/2007 is invalid and non-subsisting and merits to be rejected under Section 25(1)(h) by virtue of the following lapses under

Section 142(1)(2)(3) read with Rule 7(1)(2)(c), Rule 20(3)(a) and Rule 22 of the Patents Act, 1970.

6.1.4. It is further submitted that the fee calculation (**Annexure V**) accompanying the National Phase application and Form 13 filed on December 13, 2007 clearly shows the payment of fees, by the Applicant, for only 46 claims and not for all 51 PCT claims. The Applicants were statutory bound to pay the fees for all 51 PCT claims, eventhough the patent application was amended to 46 claims, during the filing of the application as required under Section 142 read with Rules 7, 20 and 22 of the Act. The above objection was also raised by the Ld. Controller in First Examination Report (FER) dated May 24, 2013 in Point No. 8 which is reproduced herein below:-

“8. The applicant is failed to pay the prescribed fee for all the claims what ever filed in the PCT as per section 138, 142 and rule 20(3)(a) of the Patents Act, 1970.....”

“Section 138 (4) – An international application filed under the Patent Cooperation Treaty designating India

shall have effect of filing an application for patent under Section 7, Section 54 and Section 135, as the case may be, and the title, description, claim and abstract and drawings, if any, filed in the international application shall be taken as complete specification for the purposes of this Act".

6.1.5. The Applicant paid the balance amount of fees for remaining 5 claims in response to FER on February 11, 2014. Hence there was a lapse of 9 months in payment of fees from the date of FER (May 24, 2013). It is further pertinent to note that Section 142(1)(2)(3) read with Rule 7(1)(2)(c), Rule 20(3)(a) and Rule 22 of the Act mandates the payment of prescribed fees alongwith the document, failing which the document shall be deemed to not have been filed at the Patent Office or withdrawn.

"Section 142. Fees

(1) There shall be paid in respect of the grant of patents and applications therefor, and in respect of other matters in relation to the grant of patents under this Act, such fees as may be prescribed by the Central Government.

(2) *Where a fee is payable in respect of the doing of an act by the Controller, the Controller shall not do that act until the fee has been paid.*

[(3) Where a fee is payable in respect of the filing of a document at the patent office, the fee shall be paid along with the document or within the prescribed time and the document shall be deemed not to have been filed at the office if the fee has not been paid within such time].

Rule 7. Fees

(1) *The fees payable under Section 142 in respect of the grant of patents and applications therefor, and in respect of other matters for which fees are required to be payable under the Act shall be as specified in the First Schedule.*

(2)(c) – Where a fee is payable in respect of a document, the entire fee shall accompany the document.]

Rule 20. International applications designating or designating and electing India:

(3) An applicant in respect of an international application designating India shall, before the time limit prescribed in [sub-rule (4)(i)],—

(a) pay the prescribed national fee and other fees to the patent office in the manner prescribed under these rules and under the regulations made under the Treaty.

Rule 22. Effect of non-compliance with certain requirements – An international application designating India shall be deemed to be withdrawn if the applicant does not comply with the requirement of Rule 20.

6.1.6. It is, therefore, submitted that the impugned National Phase Patent Application is deemed to not have been filed at the Patent Office on December 13, 2007 or is deemed to be withdrawn thereby being not valid as well as non-subsisting by virtue of failure of payment of prescribed fees (entire 51 PCT claims) within prescribed time (31 months from the filing date of PCT application) as required under Section 142 read with Rules 7, 20 and 22 of the Act and is therefore liable to be rejected *in toto*.

6.1.7. Without prejudice to the above averments, it is submitted that since the full fee for the impugned National Phase Application No. 9668/DELNP/2007 were paid on February 11, 2014, the effective date for filing the said application would be February 11, 2014 which is more than 31 months from the filing date of equivalent PCT application (March 29, 2006). Thus the present impugned National Phase Patent Application No. 9668/DELNP/2007 is evidently to be considered not filed or withdrawn under Section 142 read with Rule 7, Rule 20 and Rule 22 for failure of prescribed fee (entire 51 PCT claims)

within prescribed time (31 months from the filing date of PCT application).

6.1.8. As provided in Section 25(1)(h) and grounds of opposition thereof, the Applicant "*has furnished information which in material particular was false to his knowledge*" in an attempt to mislead the Ld. Controller. As such, the impugned National Phase Patent Application No. 9668/DELNP/2007 is opposed and is clearly liable to be rejected under Section 25(1)(h) of the Patents Act, 1970.

6.2. The convention application was not made within prescribed time of 12 months – 25(1)(i)

6.2.1. It is pertinent to note that National Phase Application has the same status as that of convention application in India, as accorded under the Patents Act, 1970 since all the sections, rules and regulations prescribed under the Patents Act, 1970 and Patents Rules 2003 for prosecuting convention applications filed in India are equally applicable to National Phase Applications entered in India through PCT. Section 25(1)(i) clearly makes ineligible for grant of patent in case of convention application, if the application is not filed within

prescribed time (twelve months from the date of the first application) for protection for the invention made in a convention country by the applicant.

6.2.2. Hence 25(1)(i) is a fit ground for opposing the present impugned National Phase Patent Application No. 9668/DELNP/2007 being considered to be not filed within prescribed time of 31 months from the filing date of PCT application or deemed to be withdrawn as the prescribed national fees were not paid alongwith the documents within prescribed time (31 months from the date of PCT application) as mandated under Section 142 read with Rules 7, 20 and 22 of the Patents Act, 1970.

6.2.3. In view of the similar status of National Phase Application and convention application in India as accorded under the Patents Act, 1970, the impugned National Phase Application is opposed and is clearly liable to be rejected under Section 25(1)(i) of the Patents Act, 1970.

7. In light of the foregoing averments, it is submitted that the impugned

National Phase Patent Application No. 9668/DELNP/2007 is *prima facie*

invalid and ought to be rejected in entirety under Section 25(1)(h) read with Section 25(1)(i), Section 138, Rule 142(1)(2)(3) read with Rule 7(1)(2)(c), Rule 20(3)(a) and Rule 22 of the Patents Act, 1970. It is respectfully submitted that the patent application under Opposition, as such, be rejected forthwith.

8. Assuming, without admitting, that the impugned patent application is valid if new filing date of February 11, 2014 is considered, then all the counterpart applications of 9668/DELNP/2007 would predominantly act as anticipatory document evidently destroying novelty of the said new patent application dated February 11, 2014.

9. Prayers

The Opponent prays for the following reliefs:

- (1) That the Patent Application No. 9668/DELNP/2007 filed by the Applicant be refused in entirety.
- (2) That the Opponent be allowed to file further arguments and evidence against the application of the Applicant.
- (3) That the Opponent be granted an opportunity of being heard in the matter before any final order is passed.

All communications relating to these proceedings may be sent to the following address in India:-

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Dated this 27th day of July, 2015



Sheela Pawar
(Opponent)

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The Controller of Patents
The Patent Office
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