

***IN THE HIGH COURT OF DELHI AT NEW DELHI**

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Date of decision: 7th May, 2015

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W.P.(C) No.2867/2014

THE DELHI NETWORK OF POSITIVE PEOPLE ... Petitioner

Through: Mr. Anand Grover, Sr. Adv. with Mr.
Saurabh Chauhan, Mr. Varun Jain &
Ms. Apurba Kundu, Advs.

Versus

UNION OF INDIA & ORS.

.. Respondents

Through: Mr. Vikram Jetley, Adv. with Ms.
Chitra, Adv. for UOI.

CORAM :-

HON'BLE THE CHIEF JUSTICE

HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW

RAJIV SAHAI ENDLAW, J.

1. The petitioner has filed this petition under Article 226 of the Constitution of India, as a Public Interest Litigation (PIL), to secure the rights of persons living with HIV/AIDS, pleading, (i) that in or around mid-1990s it was discovered that certain medicines i.e. anti-retrovirals (ARVs) when taken in combination of three ARVs, can help treat HIV; (ii) however these medicines were patented in several countries and the patent-holding pharmaceutical companies were charging exorbitant prices thereof, which millions of people living with HIV/AIDS in developing and least developed countries were unable to afford; (iii) around the year 2001, Indian generic pharmaceutical companies

offered to make the same medicines at much lower costs and which resulted in fall in the prices of the said medicines and which in turn enabled the developing and least developed countries to provide treatment to persons living with HIV/AIDS; (iv) however, the pharmaceutical companies adopted *inter alia* the practice of filing multiple patent applications relating to a single medicine to put the said medicines out of reach of the people living with HIV/AIDS; (v) in a bid to limit the multiple patenting of medicines and to ensure that medicines remain unpatented, the petitioner has been filing pre and post grant oppositions to oppose patent applications relating to ARVs and other medicines of interest and the petitioner has successfully opposed patent applications for ARVs, helping to keep them off patent; (vi) while doing so, the petitioner noticed another practice adopted by pharmaceutical companies to keep the patent applications pending i.e. of filing a divisional patent application based on an earlier filed patent application – this helps keep a patent application over a particular medicine alive and creates uncertainty over the patent status of the medicines; such uncertainty is against public interest; to remedy the same, the present writ petition has been filed; (vii) Section 16 (1) of the Patents Act, 1970 enables a person who has made an application for a patent to, at any time before the grant of patent, if he so desires, or with a view to remedy the

objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first mentioned application; (viii) however Section 10(5) of the Act requires that the claims of a complete specification must relate to a single invention, or in case of a group of inventions, to a single inventive concept; (ix) that thus an application containing a claim of complete specification relating to more than one invention is not a proper patent application and liable to be rejected on this ground alone; however the remedy of correcting the application is available to the applicants under Section 16 of the Act; (x) however the concerned pharmaceutical companies/persons, with the intent to keep their patent applications alive and/or to revive the patent applications which were about to be rejected/refused, are misusing the system of filing divisional application with claim which are identical to the claims of the parent application; (xi) an analysis of prosecution history of the parent applications shows that the divisional applications were filed after the Patent Examiners had raised objections to the claims of the parent application and suffer an order of deem abandonment of the parent application while keeping the fresh application filed as a divisional application alive; (xii) due to the

aforesaid conduct of patent applicants, the petitioner has been constrained to file pre-grant oppositions under Section 25(1) of the Act to at least two divisional applications arising from one single parent application with claims identical to those in parent application; (xiii) that Section 16 of the Patent Act is intended to protect genuine inventors who disclose multiple inventions in a single application but is being abused; (xiv) that the aforesaid abuse also results in burden of repeated examination of patent application containing the very same claims that had been reviewed earlier and a consequent wastage of resources and time of the Patent Office; and, (xv) that though the petitioner represented to the respondents Union of India, Controller General of Patents and Joint Controller of Patents & Designs in this regard and whereafter the Patents Rules were amended, but without addressing the issue .

Accordingly this petition has been filed seeking, (a) a direction to the respondent no.1 Ministry of Industry and Commerce to prevent abuse of process in filing of divisional patent applications, including by amending Form-I of the Patents Act, to require a declaration from the patent applicant at the time of filing such divisional application that the parent application discloses multiple inventions not constituting one single inventive concept and that the claims of the divisional applications are not identical to that of the

parent applications; (b) a prohibition against the respondent no.2 Controller General of Patents and respondent no.3 Joint Controller of Patents & Designs from proceeding with examining and processing divisional patent applications on merits until the existence of jurisdictional fact and their maintainability as divisional patent applications are first determined; (c) a direction to the respondent no.2 Controller General of Patents to reject in *limine* all divisional applications with claims identical to that of the parent applications, without hearing the applicant on substantive issues of patentability; (d) a direction to the respondent no.2 Controller General of Patents to identify patent applicants who have abused the process and take action against them; and, (e) a direction to the respondent no.2 Controller General of Patents and respondent no.3 Joint Controller of Patents & Designs to ensure that in every patent application there is an undertaking that there is no other application filed in respect of the same inventive concept and in the event of the divisional applications to decide without issuing notice whether claim is related to same inventive concept and if so, to reject such an application.

2. The petition was entertained. An affidavit has been filed by the Assistant Controller of Patents & Designs, Government of India stating, (i) that there is no provision in the Act that prohibits any person from filing the division

application in the Patent Office; (ii) that under Section 11B, when a request for examination is made in respect of any patent application, the same is referred by Controller of Patents to an Examiner of Patents & Designs for making report and the issue of allowability or refusal of said application is considered based on the report of the said examination; (iii) that the amendments already carried out to the Patents Rules pursuant to the representation of the petitioner are sufficient to address the concern of the petitioner; (iv) action has also been initiated with respect to the specific complaints filed by the petitioner; and, (v) that of the 17 divisional patent applications, 16 have been either refused or abandoned or withdrawn and only one divisional patent application had proceeded to grant of patent.

3. The petitioner has filed a rejoinder reiterating its case.

4. We have heard the senior counsel for the petitioner.

5. As would be obvious from the above, the petition does not challenge any provision of the Act or the Rules made thereunder and admits that the procedure being followed, though abused by the errant patent applicants, is in accordance with the Act and the Rules. The petitioner wants us to prevent the abuse. However that, even according to the petitioner, would be possible only

by amending the Rules or by this Court issuing directions to the respondents to, while dealing with the patent applications, act in a manner not provided for or contrary to the Rules and which is beyond our jurisdiction.

6. We, in exercise of our power of judicial review, cannot legislate or even give direction to legislate. The Act, vide Section 159 thereof empowers the Central Government, to by notification in official gazette, make rules for carrying out the purpose of the Act, particularly to provide the form and manner in which any application for patent may be filed in the Patent Office and the details to be furnished by the applicant to the Controller etc. Though Section 158 empowers the High Courts also to make rules but only as to the conduct and procedure in respect of proceedings 'before it' under the Act and not in respect of proceedings before the Patent Office.

7. The senior counsel for the petitioner contended that we should direct the Government of India to, in exercise of its rule making power under the Act, make rules in consonance with the suggestions given in the petition.

8. We are afraid, we cannot do that. The Supreme Court, in *V.K. Naswa Vs. Home Secretary, Union of India* (2012) 2 SCC 542 reiterated that the Court can neither legislate nor issue a direction to the legislature to enact in a

particular manner. It was further reiterated that writ Court, in exercise of its powers under Article 226, has no power to even indirectly require the Executive to exercise its law making power. It was held that it is neither legal nor proper for the High Court to issue direction or advisory sermons to the Executive in respect of the sphere which is exclusively within the domain of the Executive under the Constitution. It was yet further held that the Court cannot assume to itself a supervisory role over the rule making powers of the Executive. It is not the duty of the Court to enlarge the scope of legislation and the Court cannot re-write, recast or reframe the legislation. The power to legislate has not been conferred on the Court. Nor can the Court give any direction for amending the statutory rules. We ourselves have followed the same view in *Mool Chand Kucheria Vs. Union of India* MANU/DE/1338/2014. Reference in this regard may also be made to *P.N. Kohli Vs. Union of India* 177 (2011) DLT 373.

9. Similarly, no directions to the statutory authorities under the Act, to in exercise of their functions under the Act act contrary to or not in consonance of the procedure laid down in the Act and the Rules, can be given. We have recently in *Intellectual Property Attorneys Association Vs. Union of India* MANU/DE/2627/2014 held that the Controller General of Patents, Designs and

Trademarks cannot direct the Registrar of Trademarks to exercise his statutory powers under the Trade Marks Act, 1999 in a particular manner contrary to or inconsistent with the Act and the Rules. The same applies equally to us.

10. Moreover, the petitioner has sought the relief in vacuum, without reference to any particular divisional application filed in abuse of Section 16 of the Act. Though instances of two such abuses have been given but the patent applicant who had indulged in such abuse has not been made a party to the petition. It is the settled principle that the Court cannot be approached in vacuum, without a cause of action. Reference in this regard can be made to our recent judgment in *Federation of Indian Mineral Industries Vs. Union of India* MANU/DE/3251/2014. Though the said rule has been diluted in the context of PILs but the same also does not permit us to deal with a statutory provision or rule in vacuum, without cause of action.

11. In the circumstances, though we find considerable merit in the grievance urged by the petitioner as well as in the suggestions made to allay the same, but find our hands to be tied and accordingly dispose of this petition with a direction to the respondents to, within a period of six months from today, treating this writ petition as a representation, take a decision whether any

further amendment in the Patents Rules is necessary to address the malady if any and if so, to take appropriate steps therefor.

No costs.

RAJIV SAHAI ENDLAW, J

CHIEF JUSTICE

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