

# Patent Invalidation Challenge Guide (India)

Guide to challenging a competitor patent through revocation proceedings in Indian courts

## HOW TO USE THIS TEMPLATE

- |    |                                                              |
|----|--------------------------------------------------------------|
| 1. | This document: Patent Invalidation Challenge Guide (India).  |
| 2. | Fill all bracketed fields before use.                        |
| 3. | Template only — not a substitute for qualified legal advice. |

## 1. LEGAL FRAMEWORK AFTER IPAB ABOLITION

**Forum — High Court Only.** Following abolition of the IPAB by the Tribunals Reforms Act 2021, all patent revocation petitions under Section 64 of the Patents Act 1970 are filed in the relevant High Court. Revocation can also be raised as a counter-claim in any pending infringement suit. The High Court has become the sole forum for both enforcement and validity.

**Who May File.** Under Section 64(1), 'any person interested' may file a revocation petition. Courts interpret this broadly — any company in the same industry, anyone commercially affected by the patent, or anyone who wants to use the patented technology qualifies. You do not need to be an infringement defendant.

**Post-Grant Opposition vs Revocation.** Post-grant opposition (Section 25(2)): must be filed within 12 months of grant; decided by the Controller of Patents; faster and cheaper. Revocation petition (Section 64): can be filed at any time; decided by the High Court; provides a final and binding judicial decision. For strong invalidity grounds discovered after the 12-month window, Section 64 revocation is the only route.

## 2. THE STRONGEST INVALIDITY GROUNDS

**Prior Publication — Section 64(1)(b).** The most used and most powerful ground. Requires a document published anywhere in the world before the patent's priority date disclosing every element of the claim. A single well-selected prior art reference anticipating Claim 1 (the broadest independent claim) is the ideal case. The prior art must have been 'published' — available to the public — before the priority date.

**Obviousness — Section 64(1)(e).** The invention was obvious to a person skilled in the art based on matter published or publicly known before the priority date. Typically requires combining two or more prior art references. The person skilled in the art is presumed to know all prior art in the field and to be able to combine teachings in an obvious way. Show that each claim element was known and that combining them was routine, not inventive.

**Section 3 Non-Patentable Subject Matter.** Section 3(k) (computer programmes per se, mathematical methods, business methods) is extensively litigated in Indian tech patent challenges. Section 3(d) (new forms of known substances without enhanced efficacy) has been used in pharma cases. Section 3(m) prohibits patents for mere schemes or rules. If the patent's subject matter falls within any Section 3 exclusion, this is a ground for revocation irrespective of novelty.

**Insufficiency — Section 64(1)(g).** The patent specification does not describe the invention with sufficient clarity for a person skilled in the art to perform it across the full scope of the claims. This is called the 'disclosure-claim correspondence' requirement. A claim that is broader than the enabling disclosure in the specification is vulnerable to an insufficiency challenge — particularly relevant for broadly-drafted software and AI patents.

### 3. BUILDING AND PROSECUTING THE REVOCATION PETITION

**Evidence Package Required.** The petition must be supported by: a detailed statement of grounds with legal and factual arguments; certified true copies of all cited prior art with annotations; a claim chart mapping prior art to each claim challenged; and expert declarations for technically complex matters. Budget Rs. 25–75 lakhs for a contested High Court revocation including attorney fees, expert costs, and court fees.

**Cost-Benefit Analysis.** Before filing, assess: probability of success (quality of prior art); time to resolution (12–36 months typically); commercial benefit (how much does this patent threaten your business?); availability of design-around (is there a viable technical alternative?); and whether cross-licensing is commercially preferable to invalidating the patent. A strategic decision, not just a legal one.

**Running Challenge and Operations Simultaneously.** Filing a revocation petition does not grant immunity from infringement — an accused infringer must continue to monitor and manage their infringement risk while the validity challenge proceeds. Pursue design-arounds as a parallel track to reduce ongoing infringement risk during the 12–36 month challenge period.

**Settlement During Proceedings.** Most patent disputes settle during revocation proceedings as parties assess each other's strength. Common settlement outcomes: licence at commercial rates; cross-licence; co-existence agreement; settlement payment for withdrawal of petition. All settlements must be documented in a formal deed approved by your IP advocate.

### 4. FILING CHECKLIST

- Patent confirmed as granted and in force — IPO database check
- Locus standi confirmed — Company is a 'person interested' with rationale documented
- Grounds identified — prior publication, obviousness, Section 3, insufficiency
- All prior art references gathered, numbered, certified
- Claim chart prepared — all challenged claims mapped to prior art
- Expert declaration obtained for technical complexity
- Petition drafted by patent litigation advocate
- High Court jurisdiction confirmed — patentee's registered office state
- Budget Rs. [X] approved for full High Court proceedings
- Design-around assessment commissioned in parallel
- Board resolution authorising proceedings obtained

#### IMPORTANT NOTE

Working template for Patent Invalidation Challenge Guide (India). Verify requirements with a qualified IP advocate before use.

## STRATEGIC CONSIDERATIONS AND SETTLEMENT

**The Rational Invalidity Challenge.** Not every weak competitor patent should be challenged. The decision to file a revocation petition should be driven by: the commercial impact of the patent (does it genuinely block your products or market entry?); the likelihood of success (is there strong prior art or a clear Section 3 exclusion?); the cost-benefit ratio (Rs. 25–75 lakhs in legal fees vs the commercial value of invalidating the patent); and alternative strategies (can a design-around achieve freedom to operate more cheaply?). Challenge only when the patent creates genuine, ongoing commercial harm that cannot be solved another way.

**IPO Patent Database as a Research Tool.** Before committing to a revocation petition, conduct a thorough investigation of the patent owner's entire portfolio at the IPO database: do they have related patents or applications that would survive even if this patent is revoked?; are there divisional applications pending that cover the same technology with different claims?; are there related international applications (via PCT or direct national filings) that establish the scope the patent owner is trying to protect? Understanding the full portfolio prevents invalidating one patent while missing the underlying protection.

**Third Party Observations.** The Indian Patent Office accepts third party observations (TPOs) during examination under Section 11D of the Patents Act 1970 — an informal mechanism to draw the Controller's attention to prior art before grant. TPOs are anonymous, free, and informal. Filing a TPO during examination is not the same as a formal pre-grant opposition but can influence examination without the formality and cost. TPOs are most useful for narrowing claims during prosecution rather than preventing grant entirely.

**Coordinating Revocation With Business Strategy.** A revocation petition affects not just the patent in question but the entire relationship with the patent owner. Before filing, brief your senior management: should the business attempt to negotiate a licence before filing (preserving the relationship)?; is the patent owner a potential acquisition target, partner, or customer?; does the patent owner have a patent portfolio that could be used against the Company in retaliation?; and what is the Board's risk tolerance for a protracted High Court proceeding? The decision to challenge should be made at Board level with full awareness of the commercial context.

## INDIAN PATENT OFFICE — OPERATIONS AND BEST PRACTICES

The Indian Patent Office processes approximately 50,000 applications annually, with technology and pharmaceutical applications dominating filings. Understanding the IPO's examination guidelines and the specific examiners assigned to your technology area can meaningfully improve prosecution outcomes. Examination is conducted by technical examiners with engineering or science backgrounds — drafting

claims with technical precision and providing detailed technical rebuttals to objections is more effective than purely legal arguments. Each First Examination Report (FER) must be responded to within 6 months from issuance, extendable to 9 months on request with a fee. Extensions must be applied for before the original deadline expires. A failure to respond within the extended period results in th

e application being deemed to have been abandoned. On receiving a FER: read every objection carefully; prepare a technical rebuttal addressing each objection specifically; consider whether claim amendments are appropriate to distinguish the prior art cited; and brief your patent advocate fully on the technical distinctions between your invention and the cited prior art. The prosecution history of

a patent — all FERs and responses — is part of the public record and becomes relevant in infringement and invalidity proceedings (prosecution history estoppel). Avoid making admissions in FER responses that unnecessarily limit claim scope. For international applications filed through PCT and entering the Indian national phase, be aware that the PCT international search report and written opinion a

re considered during Indian examination. A positive PCT search report (where the ISA found no relevant prior art) facilitates Indian examination. A negative PCT search report does not prevent grant in India but requires specific technical arguments distinguishing the cited references.