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Intellectual Property Attorneys

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PATENTS – OPPOSITION DISMISSED – TIME BARRED

Opposition to the grant of patent under Section 23 of the Patents Ordinance, 2000

Applicant: Boehringer Ingelheim Pharma GmbH & Co. KG

Opponent: Pakistan Pharmaceutical Manufacturers' Association

Decision: Opposition Dismissed As Time Barred

These cases relate to applications for grant of patents filed by Boehringer Ingelheim Pharma GmbH & Co. KG (Boehringer) under Application No. 924/2002 (Patent No.140594) "Telmisartan Sodium Salt" and No. 1101/2008 (Patent No.140606) "A process for preparing Telmisartan Sodium Salt". Upon acceptance of the applications as required under Section 21 of the Patents Ordinance, 2000 (the Ordinance) both applications were advertised in the Gazette of Pakistan Part V (Gazette) dated September 29, 2010 which date is printed on the Gazette.

Section 21: Acceptance of complete specification. On the acceptance of a complete specification, the Controller shall give notice thereof to the applicant and shall advertise in the official Gazette the fact that specification has been accepted and thereupon the application and the specification, and the priority documents, if any, filed in pursuance thereof shall be open to public inspection.

Section 23 of the Ordinance grants the right to any person to file notice of opposition against the applications within four months of the advertisement. This term is not extendible.

Section 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, namely:

The statutory time limit of four months for filing notices of opposition against these applications expired on January 29, 2011. On April 7, 2011 Pakistan Pharmaceutical Manufacturers' Association (PPMA) filed notices of opposition against both the applications. The ground for late filing of the oppositions by PPMA was that the Gazette was received by it on February 25, 2011 and so the statutory limit of four months should commence from this date and not from the date printed on the Gazette.

In his arguments before the Controller of Patents the Counsel of PPMA pleaded that Section 2(e) of the Ordinance defines "date of advertisement" as, "whenever appearing in this Ordinance, shall be the date on which the relevant Part V of the official Gazette is actually made available to the public". He then went on to say that the date February 25, 2011 should be the date to be considered for the purpose and not the date mentioned/printed on the Gazette i.e. September 29, 2010 as his client received the Gazette much later i.e. on February 25, 2011 so this date is deemed to be the date when the said Gazette was made available to the public and not earlier. He relied on a case law wherein it was stated that the date of advertisement should be the date on which the Gazette was dispatched to the subscribers. According to him the Gazette was dispatched in February 2011 so opposition term should be calculated from the date of February



2011. In order to prove his claim of dispatch of the Gazette in February 2011 he was given the opportunity to produce evidence but he failed to produce any documentary evidence in support of his contentions.

In his arguments the applicant's Counsel vehemently argued that the date of advertisement as defined in the Ordinance is the date mentioned on the Gazette and that date should be considered for all purposes. He therefore pleaded that the notices of opposition are time barred the same be dismissed accordingly.

In his decision the Controller observed that one of the purposes to print the date on the Gazette is to provide a uniform date for all purposes rather leaving the date to be open for everyone to chose. If such a practice is adopted everyone will claim the date of his own convenience, as the date of receipt of the Gazette, which in turn will defeat the purpose and frustrate the authorities in implementation of the law. Furthermore, in support of the contention for late receipt of the Gazette the opponent did not produce any evidence of late receipt or even any proof to show that it is a subscriber of the Gazette. Additionally, despite the fact that the opponent was provided the opportunity to demonstrate by evidence the delay in dispatch of the Gazette by the publication department of the Government of Pakistan, it failed to produce any evidence in support of this contention as well. The Controller also stated that PPMA has filed more than 500 oppositions within four months of the date publication stated on the Gazette so its plea that the date should be considered as the date on which the Gazette was received by it is untenable in law. This act of PPMA is hit by the principle of approbation and re-approbation. As such the oppositions were dismissed being time barred by 35 days. Appeal against this decision can be filed in High Court but we do not have any knowledge if any appeal has been filed.

The applicant, Boehringer Ingelheim Pharma GmbH & Co. KG was represented by Bharucha & Co. and Mr. Abdul Aziz a partner of this firm appeared in the hearing before the Controller of Patents.

