



10 November 2021

Registrar General
High Court of Delhi
Sher Shah Road
New Delhi, Delhi 110503
India

VIA EMAIL: jr-rules.dhc@gov.in

Re: Delhi High Court Intellectual Property Rights Division Rules, 2021

To the High Court of Delhi:

The Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the request for comments on the draft Intellectual Property Rights Division Rules (hereinafter, the “Draft Rules”).

IPO is an international trade association representing a “big tent” of diverse companies, law firms, service providers and individuals in all industries and fields of technology that own, or are interested in, intellectual property (IP) rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; and disseminating information to the public on the importance of IP rights.

IPO’s mission is to promote high quality and enforceable intellectual property rights and predictable legal systems for all industries and technologies. Our vision is that this will result in the global acceleration of innovation, creativity, and investment necessary to improve lives.

IPO recognizes the importance of the Rules in providing for a just, fair and efficient process for the resolution of IP-related disputes. IPO’s comments on the Draft Rules are provided below for your consideration.

General Comments

The Draft Rules are silent about the procedure with respect to the matters which were pending before the IPAB as of April 4, 2021 (when the IPAB was abolished). It is our understanding that approximately 3000 cases were to be transferred to the High Court of Delhi from the IPAB. These cases were subject to a different set of procedural rules and were at different stages of progress.

IPO suggests that the Draft Rules should set out the procedure for not only the transfer of such pending cases, but also for the reconciliation thereof under the new set of rules. The definition of “*IPR matters or cases or proceedings or disputes*” under Rule

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Amgen, Inc.

General Counsel
Laura Leyden
Akin Gump Strauss
Hauer & Feld LLP

Executive Director
Jessica K. Landacre

2(l) of the Draft Rules does not seem to specifically include the matters which were pending before the IPAB. It only refers to the IPR matters “*which were hitherto maintainable*” before the IPAB. It is, therefore, recommended that a clarification be provided with respect to the matters pending before the IPAB with details of the procedure for the adjudication of such matters by the Delhi High Court Intellectual Property Rights Division (“IPD” or “IP Division”).

Rule 2(n)

IPO finds the reference to “*High Court of Delhi Rules Governing Patent Suits, 2021*” under Rule 2(n) of the Draft Rules unclear at this time, as it is our understanding that final Rules have not yet been published by the High Court. Draft rules governing patent suits were published on October 9, 2020 (seeking comments thereto) but, to the best of IPO’s knowledge, the final Rules are yet to be published in the Official Gazette.

Rule 6(vi)

This draft rule leaves no option for filing of any evidence in appellate matters. It is recommended that additional evidence be permitted in appeals with just exceptions as per Order XLI Rule 27 of the Code of Civil Procedure (CPC). Accordingly, IPO suggests that additional evidence may be permitted in the appeals if:

- the judicial/quasi-judicial authority from whose decree/order the appeal is referred has refused to admit evidence which ought to have been admitted, or
- the party seeking to produce additional evidence establishes that, notwithstanding the exercise of due diligence, such evidence was not within his knowledge or that it could not, after the exercise of due diligence, be produced by the party at the time the appealed decree/order was passed or
- the IP Division requires any document to be produced or any witness to be examined to enable it to pronounce judgment.

Rule 6(viii)

It is recommended that, in appeal matters, the Respondent(s) be provided an opportunity to file cross-objections as a matter of right, as provided under Order XLI Rule 22 of the CPC.

Rule 6(ix)

The provision as currently drafted appears to be ambiguous. If the Reply is not by way of right, then the mention of timelines with the phrase “*whichever is earlier*” may be confusing. It is recommended that the Rule be amended as below:

Reply, if so directed, shall be filed within the period prescribed by the Court ~~or within 60 days from the service of the appeal or from the date of first appearance in the appeal whichever is earlier.~~

Rule 7(i)

Rule 7 provides the procedure for Original Petitions. It is recommended that, along with the Original Petition, the petitioner also be allowed to file a list of all documents and photocopies thereof in its power, possession, control, or custody, akin to the Order XI of the CPC as applicable to the Commercial Courts or Commercial Divisions of High Court.

Rule 7(x)

The provision as currently drafted appears to be ambiguous. The phrase “*Reply, if so directed, ...*” suggests that the Reply can be filed only upon direction of the Court, which is not the case for Original Petitions (covered in Rule 7). IPO recommends that this be clarified and that the procedure and timelines for filing the Reply and evidence be laid out in the Rules.

Rule 16

Errors in service, inadvertent or otherwise, are not uncommon, and it may result in undue hardship if an adverse Order is issued against the Respondent on the first date of hearing without any knowledge of the Respondent(s). Accordingly, it is recommended that the Rule be amended to read as:

In all matters filed before the IPD, advance copy shall be served at the address for service and also through email at least 48 hours in advance, upon the Respondents including the counsels/agents, and the Plaintiff be required to submit proof of service under an Affidavit. If an appearance is not entered by the Respondent for the first hearing, at least one more opportunity shall be provided to the Respondent before an adverse order.

Rule 19

It is proposed that in case of an intervention by a third party, an opportunity should be provided to the parties in the matter to object to such intervention. Evidence and arguments from the parties on the question of intervention is likely to allow the Court to make a more informed decision. Moreover, due process is best served when the parties are able to object to an intervention.

Accordingly, IPO suggests the Rule be amended to read:

In the matters listed before the IPD, intervention by the third parties may be permitted suo moto or on an application by any person. Such person shall seek to intervene by means of an application stating the nature of interest before the IPD. The IPD may refuse or grant leave after hearing, if so required, the

parties concerned on the application as well as parties in the matter, on such terms and conditions as it deems fit.

Rule 26

As per Rule 4, every IPR proceeding is to be adjudicated by a single judge. While Rule 26 enables the Court to appoint experts, it is not mandatory for the Court to do so. It is recommended that it be made mandatory for the Courts to appoint at least one expert, preferably in the relevant technology, while adjudicating patent matters. Accordingly, IPO suggests the following be added to Rule 26:

In matters related to patents and involving substantive review of the technology, at least one technical member from the panel, preferably of the relevant technology, must be engaged to assist the court.

IPO thanks the Delhi High Court IP Division for its attention to IPO's comments submitted herein, and welcomes further dialogue and opportunity to provide additional comments.

Sincerely,

A handwritten signature in blue ink, appearing to read "Daniel J. Staudt". The signature is fluid and cursive, with a prominent horizontal stroke across the middle.

Daniel J. Staudt
President