

Updates in Indian Patent Law and Practice (2019-2021)

Sharad Vadehra (Managing Partner)

Kanchan Vadehra (Senior Partner)

Kanu Priya (Partner)

1. Indian Patent Office Statistics (Financial Year 2018 – 19 and 2019-20)

Years	2015-16	2016-17	2017-18	2018 – 19	2019 – 20
Filed	46,904	45,444	47,854	50,659	56,284
Examined	16,851	28,967	60,330	85,426	80,088
Granted	6,326	9,847	13,045	15,283	24,936
Disposal (granted+ refused/ Abandoned)	21,987	30,271	47,695	50,884	55,945

The Financial Year (FY) 2018 – 19 witnessed a year-on-year increase of 6.06% in patent filings, a whopping 29.3% increase in the number of patent applications examined, a 14.68% increase in the number of patent applications granted, and a 6.33% increase in the number of patent applications disposed of, i.e., the number of patent applications granted, refused and abandoned.

FY 2019-20 saw a year-on-year increase of 9.9% in patent filings, a decrease of 6.6% in the examination of patent applications,

an increase of 38.7% in the number of applications granted, and an increase of 9.04% in the number of applications disposed of, i.e., the number of applications granted, rejected, and abandoned.¹

¹ The Annual Report of the Indian Patent Office for the year 2019 – 20 has not been published in view of the COVID-19 Pandemic. However, the statistics have been published by the Department for Promotion of Industry and Internal Trade (DPIIT)'s Cell for IPR Promotion and Management (CIPAM).

Reduction of processing fee for small entities/MSME [Micro Small Medium Enterprises], reduction in timeline for examination of patent application from 36-52 months in May 2019 to 10-26 months in December 2020, ‘Make in India’ program of Government Of India and the fact that 80% rebate was granted to 4,905 patent applications may be counted as some of the reasons for the impressive grant rate of patent applications in the FY 2019 – 20.

2. Patents (Amendment) Rules, 2019

The Patents (Amendment) Rules, 2019 were notified by the Government of India on September 17, 2019. The Ministry of Commerce and Industry had originally published the Draft of the proposed amendments on December 4, 2018, inviting objections and suggestions from all stakeholders.

2.1 Amendment to Rule 6

The amendment to Rule 6 mandated that all documents shall be filed only by electronic transmission duly authenticated. In case the Controller asks for an original document, the same shall be submitted at the Indian Patent Office within 15 days, failing which such documents shall be deemed not to have been filed.

2.2 Entities Eligible for Expedited Examination

Rule 24C of the Indian Patents Rules, which provide for expedited examination of patent applications has been amended to include the following categories of applicants who are now eligible for expedited examination under the Indian Patents (Amendment) Rules, 2019:

- ✓ Start-ups;
- ✓ Small Entities;
- ✓ At least one female Applicant, in case of natural persons;
- ✓ Departments of Government;
- ✓ Institutions established by a Central, Provincial or State Act, owned or controlled by the Government;
- ✓ Government companies as defined in Clause (45) of Section 2 of the Indian Companies Act, 2013
- ✓ Institutions wholly or substantially financed by the Government;
- ✓ The applicant is eligible under an arrangement for processing a patent application under an agreement between Indian Patent Office and a foreign Patent Office.
- ✓ Applications in which India has been indicated as the competent International Searching Authority or elected as an International Preliminary Examining Authority in the corresponding international application

Additionally, the expedited examination may be requested in the applications about a sector which is notified by the Central Government based on a request from the head of a department of the Central Government;

2.3 Revised Fee Schedule

The official fees for transmittal of International Applications (for e-PCT filing) and preparation of certified copies of priority documents and re-transmission through WIPO DAS have been waived.

3. Patent Prosecution Highway

A Bilateral Patent Prosecution Highway (PPH) program between India and Japan commenced on December 05, 2019, on a pilot basis for three years. To this effect, the Indian Patent Office (IPO) published the Procedure Guidelines to file a PPH request under the Patent Prosecution Highway Pilot Program.

The number of requests under the PPH in the IPO is limited to 100 cases per year, on a first come first serve basis. An applicant who has filed a patent application, either alone or jointly with any other applicant, may not file more than 10 PPH requests to IPO per year.

Under the Pilot Program, the IPO can receive patent applications only in the technical fields of Electrical, Electronics, Computer Science, Information Technology, Physics, Civil, Mechanical, Textiles, Automobiles, and Metallurgy, while the JPO may receive patent applications of all fields.

4. India and South Africa's Joint Proposal to Waive TRIPS Provisions

On October 2, 2020, India and South Africa, in a joint proposal moved the World Trade Organization (WTO) for “*a waiver from the implementation, application, and enforcement of Sections 1, 4, 5, and 7 of Part II of the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement about prevention, containment or treatment of COVID-19*”, for a limited period “*until widespread vaccination is in place globally, and the majority of the world's population has developed immunity.*” The proposal raised concerns about the limited availability (and shortage) of diagnostics, therapeutics, and vaccines for COVID-19, including medical products such as diagnostic kits, medical masks, protective equipment, ventilators, etc.

Following the revision of the original Proposal which was deemed as too broad, disagreement continues to persist on whether a Waiver is the most appropriate and effective way to address shortages of vaccines and other COVID-related products. The General Counsel of the World Trade Organization (WTO) is expected to come up with a Ministerial Declaration on this matter near the end of the year 2021.

5. Patents (Amendment) Rules, 2020

On October 19, 2020, the Ministry of Commerce and Industry notified the Patents (Amendment) Rules, 2020.

5.1 Revised Form 27

Section 146 of the Indian Patents Act, 1970 and Rule 131 of the Indian Patents Rules, 2003 require Patentees/Licensees to submit a statement regarding the working of the patented invention on a commercial scale in India in the prescribed Form 27. The period for which the working statement has to be submitted has been changed from the calendar year to the Financial year, i.e., from April 1 to March 31 of the subsequent year. Under the new Rules, Form 27 may be submitted within six months from the end of the Financial Year, i.e., by September 30. Further, every patentee and every licensee (exclusive or otherwise) is required to file this Form.

The revised Form 27 is a simpler version of its predecessor and allows a single Form 27 to be filed for multiple related patents if the approximate revenue/value accrued from one patented invention cannot be derived separately from that accrued from related patents.

5.2 Amendment to Rule 21

As per the amended Rules, in case of national phase applications, where the applicant has not complied with the requirements of paragraphs (a), (b), or (b-bis) of PCT rule 17.1 and subject to paragraph (d) of the said rule 17.1, the applicant shall file the certified copy of priority application within 31 months from the priority date.

Further, the amended Rules specify that where sub-paragraph (i) or subparagraph (ii) of paragraph (e) of PCT rule 51bis.1 is applicable, an English translation of priority application duly verified by the applicant or the person duly authorized by him shall be filed within the 31 months from the priority date.

6. Patents (2nd Amendment) Rules, 2020

On November 4, 2020, the Patents (2nd Amendment) Rules, 2020 came into force, whereby fees applicable to small entities for filing and prosecuting Indian patent applications have been reduced and made at par with those of natural persons/start-ups

7. Extension of Limitation Period

On March 23, 2020, the Hon'ble Supreme Court of India in the matter of *Suo Motu* Writ Petition (Civil) No(s). 3/2020 ordered that the period of limitation as prescribed under any general or special laws in respect of all judicial or quasi-judicial proceedings, whether condonable or not, shall stand extended w.e.f. 15-03-2020 till further orders.

In an order dated April 27, 2021, the Supreme Court of India restored its order dated March 23, 2020, and extended the limitation period of all judicial or quasi-judicial proceedings until further orders.

To this effect, the Office of the Controller General issued a public notice on May 21, 2021, stating that the timelines/periods for the completion of various acts/proceedings, filing of any reply/document, evidence, payment of fees, etc., falling due after March 15, 2020 (the date on which the limitation period was first extended by the Supreme Court), shall be the date as decided/ordered by the Hon'ble Supreme Court.

On September 23, 2021, the Supreme Court taking note of the improved pandemic situation in the country recalled the *Suo Motu* extension of the limitation period. The Court ordered that in computing the period of limitation, for any suit, appeal, application, or proceeding, the period from March 15, 2020, till October 02, 2021, shall stand excluded.

8. Dissolution of the Intellectual Property Appeal Board (IPAB) of India

As of April 04, 2021, the Intellectual Property Appellate Board of India stands abolished by way of the Tribunals Reforms (Rationalisation and Conditions of Service) Ordinance. All pending and future appeals will now be dealt with by the High Court.

To this effect, on July 6, 2021, the Delhi High Court announced the formation of its IP Division (IPD).

9. Patents (Amendment) Rules, 2021

On September 21st, 2021, the Ministry of Commerce and Industry notified the Patents (Amendment) Rules, 2021, whereby fees applicable to an educational institution(s) for filing and prosecuting Indian patent applications have been reduced and made at par with those of natural persons/start-ups / small entities. “Educational institution” has been defined in amended Rules as a university established or incorporated by or under Central Act, a Provincial Act, or a State Act, and includes any other educational institution as recognized by an authority designated by the Central Government or the State Government or the Union territories in this regard

10. Recent Judicial Developments

10.1 *Pharmacyclics LLC v. Union of India and Ors.*²

On 24th September 2015, *M/s. Laurus Lab Pvt. Ltd.* filed a post-grant opposition against the patentee *Pharmacyclics LLC* for its Patent No. 262968, under Section 25(2) of the Indian Patents Act, 1970.

Upon the filing of a response to the said opposition by Patentee, an Opposition Board was constituted. The Opposition Board gave its recommendation and the matter was fixed for hearing on 16th November 2017, which was subsequently adjourned to 25th September 2019 upon request of Opponent.

On 10th September 2019, the Opponent sought to file additional documents and further evidence was filed on 19th September 2019, given which, the Patentee requested for an adjournment of the scheduled hearing. The Patentee took the position that the fresh documents and evidence filed by the Opponent ought not to be taken on record, as the same was belatedly filed and contrary to the Indian Patents Rules, 2003.

Aggrieved by the result of the interlocutory petition hearing dated 6th November 2019, wherein it was held that the documents and evidence filed by the Opponent would be taken on record and would be considered at the time of final adjudication, the Patentee filed a writ petition, challenging the impugned order passed by the Joint Controller of Patents and Designs.

In this matter, Justice Pratibha Singh laid down the following general principles which ought to be followed while dealing with a post-grant opposition:

1. The Opponent and the Patentee have adequate freedom to file their initial pleadings and evidence by relying upon all the documents and expert testimonies that they wish to;
2. The Opponent’s rejoinder ought to be strictly confined to the Patentee’s evidence

² W.P.(C) 12105/2019 & CM APPLs. 49593/2019, 49594/2019, 49595/2019

3. Once the Opposition Board is constituted and the material is transmitted to the Board, further evidence is not permissible;
4. If any further evidence comes to light which either party wishes to rely upon, the same can only be done before the issuance of notice of hearing, with the leave of the Controller;
5. Only publicly available documents i.e. publications, can be considered provided they are served to the opposing party, five days before the hearing and the date/time of the publications as also the relevant portions are highlighted so that the opposite side can deal with the same at the time of the hearing. Any document the authenticity of which is in doubt would not be entertained;
6. The hearing, in the opposition, would be usually granted upon request and Opposition Board Members may also be present to elicit their views and assist the Controller in deciding the post-grant oppositions.

Having laid down the above guidelines, Court allowed the further evidence as the matter has already been fixed for the final hearing and the Opponent has already filed documents and evidence before the hearing. Also, the Patentee sought an adjournment of the hearing and therefore availed the opportunity to respond to all the documents and evidence filed by the Opponent.

The Order also stated that though the Rule does not stipulate any timelines for fixing the date of hearing, considering that patent rights have a limited term, the Opposition Board ought to give its recommendations within three months after the final Opponents' rejoinder is received. After the receipt of the recommendations of the Opposition Board, a hearing ought to be fixed within three months thereafter. An endeavor ought to be made by the Patent Office to ensure that post-grant oppositions are decided expeditiously as pendency of post-grant opposition's delays adjudication of infringement suits, if any, in respect of the patent and also keeps the rights of the Patentee under a cloud or in doubt.

10.2 Natco Pharma Limited vs Bayer Healthcare LLC and Natco Pharma Ltd vs Bristol Myers Squibb Holdings

Two separate patent infringement suits were filed against *Natco Pharma Limited* by *Bayer Healthcare LLC*³ and *Bristol Myers Squibb Holdings*⁴ seeking permanent injunction restraining infringement of Indian Patent Nos. IN 240207 and 247381 respectively. The Single Judge applying the order dated 31st May 2019 tilted *Sterlite Technologies Ltd. Vs. ZTT India Pvt. Ltd.*⁵ granted an interim injunction against *Natco* in both cases.

In the order in *Sterlite Technologies Limited*, Court granted an interim injunction without considering the three essential conditions for interim injunction i.e., prima facie case, the balance of convenience, and irreparable hardship. It was held that it is not possible to form an opinion, even prima facie. The other two elements viz., the balance of convenience and irreparable hardship were not even mentioned.

*Natco*⁶ appealed against the order of the Single Judge in the cases of *Bayer Healthcare LLC v. Natco Pharma Limited* and *Bristol Myers Squibb Holdings v. Natco Pharma Limited*. The Division Bench [two judges] of the Delhi High Court set aside both the interim orders and held that decision in the application of interim injunction has to necessarily indicate the view of the Court on the three essential elements i.e. *prima facie* case, the balance of convenience and irreparable harm.

³ CS(COMM) 343/2019

⁴ CS(COMM) 342/2019

⁵ CS(COMM) No.314/2019

⁶ FAO(OS) (COMM) 158/2019, CM APPL. 30589/2019 (Stay) and FAO(OS) (COMM) 160/2019 and C.M. No. 31063/2019

10.3 Astrazeneca Ab & Anr. v. Emcure Pharmaceuticals Limited and Msn Laboratories Limited⁷

In the present case, the matter before the Delhi High Court was the enforcement of species patents in India. The cases relate to the drug TICAGRELOR, a drug for treating cardiovascular events, which is covered by four patents, namely: the genus patent i.e. IN 241229 for the “Markush” formula, a species patent i.e. IN 209907, the “crystalline form” patent i.e. IN 247984, and the “finished formulation” patent i.e. IN 272674.

The plaintiff contended that the genus patents which are for Markush Formula disclosed the possibility of individual permutations and combinations of making 1.5×10^{20} compounds. Claim 8 of the Genus patent disclosed specific compounds but did not include TICAGRELOR. Plaintiff continued to carry out research and development for a more stable, active, and less toxic compound that would be most utilitarian as an effective platelet aggregation inhibitor resulting in developing the compound TICAGRELOR. According to the plaintiff, TICAGRELOR falls within the scope of claim 1 of the Species patent. Further, TICAGRELOR is specifically claimed as the third compound in claim 5 of the said patent and the process for its making has also been specifically disclosed in example 3.

Along with the arguments of non-patentability of Plaintiff’s patent(s) under Section 3(d) of the Indian Patents Act, Defendant contended that TICAGRELOR was not an invention since it was anticipated by the expired Genus Patent IN ‘229. Relying on the Supreme Court’s decision in Novartis, wherein the Supreme Court noted that the law in the country should not be developed on the lines where there is a vast gap between the coverage and disclosure of a Patent, the Defendants further submitted that once the Plaintiffs admit that the prior genus patent “covers” TICAGRELOR, their argument that this compound was not disclosed is misconceived in law. The Defendants also relied on the statements submitted by the Plaintiff on Form 27 for the genus patent, which stated that the genus patent had been worked through the manufacture of TICAGRELOR by the Plaintiffs, as well as on the statements in litigation in the United States enforcing the genus patent against third parties which were manufacturing TICAGRELOR.

The Court held that even though TICAGRELOR may be covered by a previous genus patent (for Markush formula) if the drug is produced and marketed under a species patent, the patentee is entitled to enforce the species patent. The Delhi High Court noted that in Novartis’s decision, the Supreme Court has “acknowledged” that scope of the patent should be determined from the intrinsic worth of an invention, not from the artful drafting of the claim. Further, the Court interpreted that in the Novartis case Supreme Court has not held that a species patent cannot be granted once a genus patent had been granted.

10.4 Ferid Allani v. Union of India⁸

A writ petition was filed by a citizen of Tunisia in the Delhi High Court, challenging the order of the IPAB dated 25th March 2013, by which the IPAB had dismissed the appeal filed by the Petitioner challenging the order of the Indian Patent Office refusing the patent application filed by the Petitioner, titled “*Method and device for accessing information sources and services on the web*”. The claims in the patent consisted of both method claims and device claims. The application was rejected by the Indian Patent Office on the grounds of non-patentability under Section 3(k) – which states that computer programs per se, algorithms, business methods, and mathematical methods are not

⁷ CS(COMM) 561/2019 and CS(COMM) 562/2019

⁸ W.P.(C) 7/2014 & CM APPL. 40736/2019

patentable – and lack of novelty under Section 2(1)(j) of the Indian Patents Act. The Petitioner’s appeal before the IPAB was also dismissed, which opined that the subject application did not disclose any 'technical effect' or 'technical advancement'.

Aggrieved, the Petitioner approached the Delhi High Court and argued that the specification discloses a technical effect and a technical advancement, especially as of the priority date, and that claims of his application do not relate to a mere software which is simply loaded onto a computer. It was submitted that the disclosed invention afforded more efficient database search strategies, more economical use of memory or higher speed, etc., which constituted a “technical effect” that made the rejection of the patent in contravention to the law and the relevant guidelines.

Upon hearing both the parties, the Court observed that as far as Section 3(k) is concerned, the bar on patenting was in respect of *‘computer programs per se...’* and not on all inventions which were based on computer programs. In this landmark judgment, the Court stated that *“In today’s digital world, when most inventions are based on computer programs, it would be retrograde to argue that all such inventions would not be patentable. Innovation in the field of artificial intelligence, blockchain technologies, and other digital products would be based on computer programs, however, the same would not become nonpatentable inventions – simply for that reason. It is rare to see a product that is not based on a computer program. Whether they are cars and other automobiles, microwave ovens, washing machines, refrigerators, they all have some sort of computer program in-built in them. Thus, the effect that such programs produce including in digital and electronic products is crucial in determining the test of patentability.”* It was further stated that the words ‘per se’ was incorporated to ensure that genuine inventions which are developed, based on computer programs are not refused patents.

In the light of the above, the Court directed that the Petitioner’s patent would be re-examined and a decision on the patent will be taken within two months, after granting a hearing to the patent applicant.

10.5 Interdigital Technology Corporation & Ors. v. Xiaomi Corporation & Ors.⁹

On 9th October 2020, the Delhi High Court granted an ad interim injunction against Xiaomi restraining them from pursuing or enforcing the anti-suit injunction order dated September 23, 2020, passed by the Wuhan Intermediate People’s Court until the final disposal of the proceedings. The Wuhan Intermediate People’s Court had passed an anti-suit injunction order restraining Interdigital from instituting and enforcing a suit for infringement before any forum.

Delhi High Court held that *“There is, in my view, another, and somewhat more serious, objection, to the order, dated 23rd September 2020, of the Wuhan Court, which directly involves the principle of comity of courts. By conditioning the continuance of the prosecution, by the plaintiffs, of the proceedings before this Court, with a penalty of about Rs 1 crore per day, the Wuhan Court has effectively rendered it impossible for the plaintiff to continue to prosecute these proceedings. The inexorable sequitur is that this Court is also divested of the opportunity of adjudicating on the dispute, brought before it by the plaintiffs, which it has, otherwise, the jurisdiction to hear and decide. The order of the Wuhan Court, therefore, directly negates the jurisdiction of this Court, and infringes the authority of this Court to exercise jurisdiction by the laws of this country”*.

The Court further stated that *“It is not open to any Court to pass an order, prohibiting a court, in another country, to exercise jurisdiction lawfully vested in it. Any such decision would amount to a negation of jurisdiction, which cannot be countenanced.”*

⁹ I.A. 8772/2020 in CS(COMM) 295/2020



Sharad Vadehra

Sharad Vadehra is one of the founders and presently the managing partner at Kan and Krishme. He also heads the IP litigation department. He joined the profession in 1989, and is amongst the few attorneys in the country with both technical and legal qualifications.

Sharad Vadehra specialises in intellectual property laws, media, entertainment, sweepstake and promotions, marketing, commercial disputes and litigation and has more than 31 years of experience in dealing with domestic and international companies (including Fortune 500 companies) and research institutions. Mr Vadehra has handled the prosecution of more than 30,000 patent and trademark applications. He has spoken on IP law and practice in over 500 institutions and corporate bodies in India and overseas, and is the author of the book *Indian Patent Law and Practice* published by Chosakai in Japan in Japanese.

Mr Vadehra represented a big Japanese company in *NTT Docomo v The Asst. Controller of Patents in Madras High Court* which turned out to be a landmark case in Indian IP history. In this matter, a big and old Indian IP firm made a mistake and withdrew an application which was very im-

portant for the client. Later, the client approached Sharad Vadehra who filed a writ petition before the High Court. In the High Court, through his arguments, Mr Vadehra was able to reinstate the withdrawn application. It was the very first time in the IP history of India that a withdrawn patent application was reinstated.

Mr Vadehra has often been consulted by the government of India when any new guidelines or rules are being framed with respect to the Indian Patent Act and Rules.

Mr Vadehra was a vice president of APAA – India between 2016 and 2019 and was responsible for organising the APAA General Assembly and Council Meetings which took place in New Delhi in November 2018. He has been re-elected as vice president of APAA – India for the second term for 2020-2022.

Mr Vadehra is a founding member of the FICPI India group and has been very closely associated with it since its formation. He is one of the founding members of GALA (Global Advertising Lawyers Alliance) and was the president of its Asia-Pacific branch. He is registered with the Delhi High Court. He is a member of the following bodies: FICPI, APAA, AIPLA, AIPPI, INTA, LES and CII.



Kanchan Vadehra

Kanchan Vadehra is one of the founders and presently the managing partner at Kan and Krishme. She also heads the electronics, electrical and mechanical department of the firm.

Kanchan Vadehra specialises in intellectual property laws and has more than 25 years of experience in the field and in handling such matters for both domestic and international companies (including Fortune 500 companies) and research institutions. Kanchan has handled the prosecution of more than 10,000 patent applications. She has authored several articles and newsletters on Indian patent law and practice which have been published in leading IP magazines such as MIP. She actively engages with the government and patent office on policy formulations related to IP.

Kanchan Vadehra is a member of APAA (Asian Patent Attorneys Association), INTA (International Trademark Association) and CII (Confederation of Indian Industry). She is a regular attendee at different IP conferences such as APAA council meetings as well as INTA annual meetings.



Kanu Priya

Kanu Priya is an advocate and registered Indian patent agent. She is a partner at Kan and Krishme and has more than a decade of experience in handling IP matters for both domestic and international companies (including Fortune 500 companies). She helps companies to strategise their IP portfolios and works on landscape analysis and freedom to operate opinions. She handles drafting, prosecution and litigation of patent and trademark applications. She actively engages with the government and Indian Patent Office on policy formulations related to IP.

She advises clients on a wide variety of advertising, media and marketing law matters, including advertising regulations, social media, sweepstakes, promotions and contests.

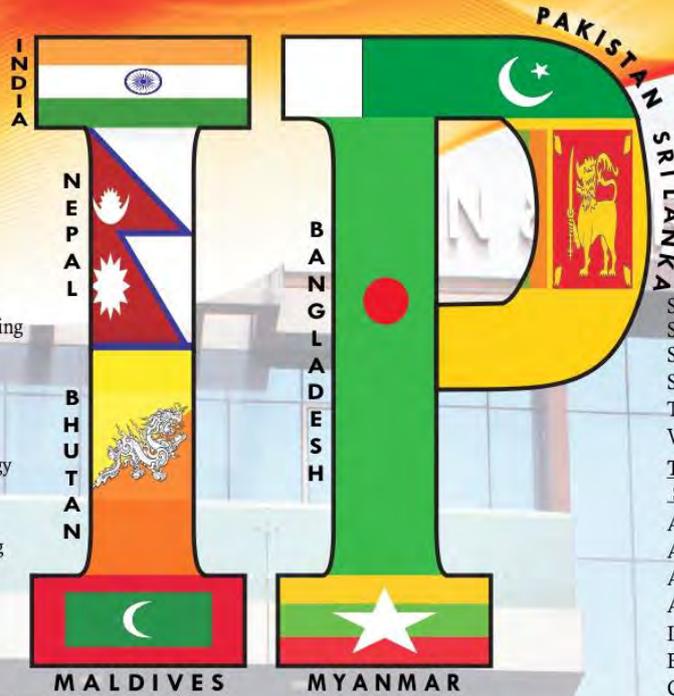
She is a member of the APAA (Asian Patent Attorneys Association) and INTA (International Trademark Association).

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Phones: +91-11-4377 6666 (100 Lines)

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Representative offices also at:



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