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# The Question of Rules of Expert Opinion and IPD: A Discussion in the Context of the New Himachal Pradesh Intellectual Property Division and Comparative Developments Across Emerging Indian IPDs

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## Abstract

*India's IP Law regime has undergone a transformative change since the abolition of the IPAB in 2021. The State High Courts are in the process of developing IPDs as part of the State High Courts. The Delhi HC was the first High Court to develop such a division. Soon, the Madras HC and the Calcutta HC followed suit. Himachal Pradesh HC is the latest High Court to develop such a division. These IP divisions have their own rules. These IPD rules seem more or less congruent from afar. Expert opinion is an integral part of IP jurisprudence, being relevant in the IP office to the IP Courts. However, the IPD rules, when viewed in the context of the rules applicable to the experts or expert engagement, fissures appear. The objective of this article is to identify these fissures or incongruencies in the rules. With the increase in commercial and overall economic growth, India is at the cusp of being a leading innovator in the World. The Courts of such a leading innovator may incorporate the best practices of the world, but ought to maintain uniformity of rules in the national courts. This comment will include a study of the IPD and its rules in the infancy of its development, so that India's IP future may lead to a future of consistency and credibility.*

**Keywords:** *Expert Opinion, Intellectual Property Division, Rules, Hot-tubbing, Confidentiality Clubs.*

## 1.0 Introduction

Hon'ble Justice Pratibha Singh (2024), in a public lecture on how Commercial Courts are transforming India's Judiciary, observed that on an annual basis, the Intellectual Property Division (IPD) of the Delhi High Court was having more disposals than filings and eighty (80) percent of the cases transferred from the Intellectual Property Appellate Board (IPAB) have been disposed of within the last 5 years! She went on to observe that having dedicated benches or specialised divisions was helping and was the best way for the country to go forward, as the economy grows.

The speech of Hon'ble Justice Singh is significant owing to the pathbreaking change in the IP procedural law that is being brought forth in India's IP Courts since 2022 till today. Ahmad (2024) notes that the notification of the Himachal Pradesh Intellectual Property Division (HP-IPD) represents a significant addition to India's evolving post-IPAB adjudicatory framework. The Himachal Pradesh High Court (2022) notified the HP IPD Rules on 9th July 2024.

Following the abolition of the IPAB on April 4, 2021, by the Tribunals Reforms (Rationalisation and Conditions of Service) Ordinance 2021, different State High Courts responded by setting up the IPD within their respective high courts. The Delhi High Court became the first High Court to create an IPD on February 28, 2022 (World Intellectual Property Organisation [WIPO], 2021).

Soon, other High Courts followed suit. The Madras High Court became the second (Gour, 2023), the Calcutta High Court the third (SpicyIP, 2024), and finally the Himachal Pradesh High Court the fourth Court (Ahmad, 2024) to have moved towards formalising a similar adjudicatory mechanism, involving an IPD.

Experts are a fascinating concept in IP litigation. They are engaged at every stage from the conception of the IP right, the registration of the right, the dispute arising out of that said right and the consequent resolution of the same. Experts can be scientific advisors, party-appointed experts, court-appointed experts, or amici curiae as experts. Although all the areas of law have witnessed deliberation with experts, nowhere more fascinating has the engagement been than in the IP adjudication regime.

Now, all the IPD rules, aptly promulgated in their respective high courts, might seem congruent and coherent. But when observed through the lens of the rules applied to experts, researchers and expert engagement techniques, the fissures become highly observable. It is here that the article shall examine the institutional design of the HP-IPD, and at the same time, the development of other emerging IPDs in India shall be studied to gauge the extent of dissonance, if any, in the promulgation of their rules. This has to be kept in mind that post the abolition of the IPAB, the IPDs are contributing to the development of a new era of IP jurisprudence. A study in the infancy of their development may lead to a future of consistency and credibility.

## 2.0 The Institutional Design of HP IPD: the Newest

The Himachal Pradesh High Court formally announced its Intellectual Property Division (IPD) Rules on July 9, 2024; however, in a separate notification, July 6, 2024, is mentioned as the relevant date (High Court of Himachal Pradesh, 2024). These regulations were created with the authority to regulate IPR concerns, except those delegated to the Division Bench, granted under Section 23 of the State of Himachal Pradesh Act, 1970, Section 129 of the Code of Civil Procedure, Article 225 of the Indian Constitution, and other enabling legislation. These rules came to be known as the '*Himachal Pradesh High Court Intellectual Property Division Rules 2022*' (HPHC-IPD Rules, 2022).

The scope of jurisdiction is similar to other High Court IPDs. The structural design of the HP-IPD appeared to be integrated within the existing roster system of the High Court. There was no indication of permanent or specially trained benches. The jurisdiction of the IPD is defined as being adjudicated by a single judge, except those that were to be decided by the division bench vide section 13 of the Commercial Court Act, 2015. Other features of the rules seem to have been heavily drawn from the Delhi High Court IPD Rules 2022.

In the issues involving experts directly, Rule 31 gives the IPD the authority to consult experts as needed. However, the goal of the expert's opinion here is to persuade the court, not to bind it. Here, the rule resonates not only with the pre-existing IPAB regime, but also the developing IP jurisprudence in the Delhi High Court in contemporary times, which in turn reflects the principles applicable to experts in UK Courts as laid down in the UK Civil Procedure Rules, Civil Practice Direction 35 (UK Civil Procedure Rules, 1998).

The IPD may continue to retain a panel of experts to help with this, which will be reviewed regularly. A declaration attesting to the lack of any conflicts of interest and reaffirming their dedication to offering fair and unbiased help must be submitted by experts chosen from this panel. The compensation for these experts will be decided by the Court.

Additionally, the IPD may occasionally prescribe and alter the procedural framework controlling expert involvement. Ancillary to this requirement is the provision for the law researchers, for *'techno-legal aspects'*. The process of appointment of the law researcher (LC) is similar to the experts. It has been made a mandate that the law researcher ought to possess a degree in *'any'* technical field or specialisation in any IPR subject matter, or have experience in the field of intellectual property. '*Higher*' payment might be approved by the Chief Justice. These LCs may be appointed to the Division Benches as and when appropriate.

Now coming to the aspect of expert engagement techniques, interestingly, the HP-IPD, 2022, Rule 19, allowed for the creation of confidentiality clubs and the redaction of *'confidential matters'* as deemed by the Court. The rules stated that, according to the High Court of Himachal Pradesh (Original Side) Rules, 1997, the Court may, at any time, establish a confidentiality club with specialists, outside and internal legal counsel, and

the parties' authorised representatives. To maintain the integrity of the supplied *'confidential'* information, these representatives must not be involved in the parties' daily administration or activities. It is completely restricted for members of such a club to reveal, share, or use any sensitive or private information they come into contact with during the procedures. Furthermore, the rules state that the Court has the authority to order the redaction of material or documents that are considered secret upon application. When submitting a redacted document, an application supporting the confidentiality claim must be included, along with an unredacted copy of the document in a sealed cover.

## 3.0 Legislative History of the IPDs

The 161st Report of the Department-Related Parliamentary Standing Committee on Commerce provided a critical review of the abolition of the IPAB (Rajya Sabha, 2021) Notably, despite the Committee's concern for IPAB's poor performance, because of the ongoing delays in the appointment of important staff members, including members and chairpersons and problems that *"plagued proper functioning"* and hindered the *"speedy disposal of IPR appeals and rectification applications"*, the Committee was critical of its abolition. The Department was of the belief that by raising pendency and negatively impacting disposal speed, this decision might put more strain on an already overburdened judiciary.

The Parliamentary Standing Committee was further distressed to see that the Government did not carry out any Judicial Impact Assessments (JIA) or actively interact with stakeholders before eliminating the said tribunals (read the IPAB), and thereby strongly advised that the government conduct a JIA along with an extensive stakeholder consultation. Strikingly, it was advised that, *"IPAB should be re-established, rather than being abolished and should be empowered and strengthened with more structural autonomy, infrastructural and administrative reforms, as well as ensuring timely appointment of officials and experienced manpower."*

Thereafter, despite the emphatic recommendations, the Tribunal Reforms Act, 2021, was passed, and the IPAB stood dissolved. However, the Committee in a following report on the action taken (Rajya Sabha, 2022), opined that the Government should take the initiative to encourage the setting-up of IPD in the High Courts for providing an alternative solution to resolve IPR cases, mirroring the *'dedicated IP Bench'* established by the Delhi High Court. Speaking of institutional assistance in developing a pool of IPR Professionals and experts in spheres such as policy and law, strategy development, administration, enforcement, as well as enhancing institutional capacities such as policy development, teaching, training and research and skill building; the Government established the Rajiv Gandhi National Institute of Intellectual Property Management (RGNIIPM) at Nagpur as a National center of excellence for training, management, research, education in the field of Intellectual Property Rights.

## 4.0 The Expert Conundrum

Currently, IP enthusiasts are highly piqued by the developments in the Delhi High Court, notably, the highly interesting IPR matter, *ANI Media Pvt Ltd v. Open AI Inc and Anr*. (2024). What is even more interesting is that two amici have been appointed by the Court: Prof. (Dr.) Arul George Scaria, DPIIT-IPR Chair Professor, National Law School Bangalore, and Senior Advocate Adarsh Ramanujan. Previously, Prof. (Dr.) Scaria had been appointed as an expert by the Delhi High Court in 2022 under Rule 31 of the Delhi High Court IP Division Rules to help interpret the technicalities of Section 52 (1) (za) of the Copyright Act. (Phonographic Performance Ltd. v. Lookpart Exhibitions, 2022:DHC:4162 (Del. HC).)

The IP Courts are no strangers to the appointment of experts or amici curiae. Despite the changes in the Indian evidence law, the primary provisions regarding experts remain overall unchanged. Section 45 of the earlier Indian Evidence Act, 1872 and Section 39 of the new Act, Bharatiya Sakshya Adhiniyam, 2023, experts are described as individuals skilled in foreign law, science, or art, among other fields. For this discussion, it is essential to focus on experts within the domains of "science" and *"art,"* as these categories align most closely with the legislative intent and practical applications within IP law. However, the provisions for experts and amici or independent intervenors in the IPDs are not uniform.

Among other issues, wherein an expert intervention has been required or has been permitted by the Courts, issues such as revocation of patent (Steel Strips Wheels Limited vs. Wheels India Limited and Ors. MANU/TN/1492/2025.), infringement of patents (Merck Sharp and Dohme Corporation and Ors. vs. Glenmark

Pharmaceuticals MANU/DE/0852/2015), gauging skills of a *'skilled person'* (Enercon (India) Limited Vs. Alloys Wobben 2013, MANU/IC/0057/2013), validity of patent and compulsory licensing (Bristol-Myers Squibb Co. and Ors. v. J.D. Joshi and Ors., MANU/DE/1889/2015), patent invalidation (Upl Limited vs The Controller Of Patents Design, MANU/WB/0716/2024), 'product-by-process' claims (Vifor (International) Ltd. and Ors. vs. MSN Laboratories Pvt. Ltd. and Ors., MANU/DE/0846/2024), *etc*. Admitting experts and considering their affidavits was a practice not only in the High Courts but also in the IPAB, which also, as a practice, had one judicial member and one technical member on its bench (Mohnot, 2019).

The previously discussed Committee report speaks of the appointment of experts at all levels of IPAB, the delay of which might have affected its optimal performance, leading to the obvious disruptions in the adjudications in the IPR disputes. This, perhaps, possibly meant the appointment of scientific advisors (India, 1970), the rolls of which are maintained by the Controller. The list of scientific advisors is updated on a regular basis in accordance with Rule 103 of the Patent Rules, 2003; the most recent notice was released on April 9, 2025. In addition to having at least fifteen years of relevant experience and a degree in science, engineering, or technology (or its equivalent), applicants must have held a responsible technical or scientific position in the government or at an accredited institution. Practising attorneys and patent agents who are already appearing in court or before the patent office are discouraged from applying in order to avoid conflicts of interest. Neither the Patent Act nor the Rules specifically mention such limitations. Based on the applications submitted and the present requirements of the patent system, the CGPDTM will decide how many advisers are on the roll (Malik, 2025). The Madras High Court in Sun Mobility Private Limited v. Arumugam Rajendra Babu, 2020, had appointed scientific advisors in this manner. The Divisional Bench had upheld the single Judge's order appointing a Scientific Advisor, noting that the appellant had raised no objection to the appointment itself. The appellant's only contention was that, pending the advisor's report, the interim injunction applications should remain undecided and the suit should proceed to trial. The court rejected this argument, clarifying that since the appellant did not dispute the appointment, it was within the single Judge's discretion to decide the course of proceedings, including whether to defer interim applications. The appellant was advised to present any such procedural requests directly before the single Judge.

Interestingly, in 2024, Justice Saurabh Bannerjee, in Syngenta v. GS Crop Science, clarified the appointment of a Scientific Advisor cum Party Expert to a new form of expert engagement technique known as the Confidentiality Clubs. The Court rendered a final ruling in this case regarding the types of members and the tiers of Confidentiality Clubs. The need for expert assistance in upholding sensitive information rules was further reinforced by the statement that the Scientific Advisor would be an essential component of both Tier I and Tier II of the Confidentiality Club. The Court said that ordering a third-party expert to be appointed is equivalent to employing an expert to support the Court rather than just asking for an outside report. Interestingly, even though the appointment had not yet been made, the Court had already structured a suggested consolidated reference for the Scientific Advisor.

## 5.0 The Incongruent Rules

Despite the evident need for expert assistance in the IPDs, the rules applying to the experts are not uniform across the IPDs. Delhi High Court IPD recognises the need for technical expertise and has provisions for the appointment of Law Researchers, attached full-time to the IPD, the Panel of Scientific Experts, and has specific provisions for Scientific Advisors. Moreover, expert engagement techniques such as hot-tubbing and confidentiality clubs (Rule 17 under Chapter VII, read with Annexure F of the Delhi High Court Original Side Rules 2018) have been statutorily created by the Delhi High Court. These are not novel mechanisms and do exist in other jurisdictions outside India (Sen, 2024). Both the Delhi High Court IPD Rules and the Calcutta High Court IPD Rules talk about this hot-tubbing method of expert engagement. Proclaimed to have originated from the Australian Courts, both American and English courts have welcomed this method of engagement of more than one expert's evidence or concurrent expert evidence. However, a Confidentiality Club is a novel mechanism in India and is being increasingly used in the Delhi High Court, as the author writes this piece. A 'hot-tub' is relatively less engaged by the Delhi IPD.

What is remarkable is that the HP-IPD has emulated the statutory provisions of a Confidentiality Club, as

provided in Delhi IPD rules (discussed above), which is a significant progress, since the Madras High Court and the Calcutta High Court do not mention such 'Clubs' at all. It does not at all mean that the Madras High Court is oblivious to the existence of such *"confidentiality clubs"*; it just accepts that it does not have the rules to form such clubs, even when sought by the parties to preserve confidential information. The Calcutta High Court, in a similar situation concerning preservation of confidential information, seek to adopt *'appropriate measures'*. Neither the Madras High Court nor HP-IPD have any provision for '*hot-tubbing*'. Here, Calcutta IPD seems to have broken the norm, and a reference to 'hot-tubbing' has been made in the Rules.

Finally, in the issue of experts, all the IPDs have dedicated provisions which allow the specialised benches of the High Courts to seek expertise as and when sought. However, here again, the provisions for law researchers find mention in Delhi IPD, HP-IPD, but are absent in Madras IPD and Calcutta IPD.

Curiously, Rule 34 of the HP-IPD talks about the participation of the *'Trade Mark Agents'* or anyone who is registered as patent agents, or any professional/ academician having the requisite knowledge of the said subject matter of the dispute, who would accordingly have a *'right of audience'* as and when permitted by the Court along with the legal representatives of the parties. This does not find mention in the other IPD Rules.

## 6.0 Conclusion

With the Karnataka High Court set to establish its own IP Division (Asia IP Law, 2024), having multiple IPDs (but crucially missing in significant High Courts, like the Bombay High Court), albeit with divergent rules, is increasingly impractical. Though the rules may seem uniform initially, on closer scrutiny, especially regarding expert engagement, they reveal inconsistencies and significant fissures. Moreover, while specialised benches exist, we still lack, holistically all over India, judges with focused training in IP law, or even a focused *daily cause list* with IP law. Moreover, most IPDs do not release regular annual reports. It makes it difficult to assess the functioning of the IPDs and even more difficult to gauge where improvements could be made or other IPDs could emulate.

As India's IP adjudicatory developments are monitored globally, including the United States Trade Representative's Special 301 Reports (2025), coherence and transparency must be maintained. Delhi IPD, with its 'ideal' rules, may weigh the risk of becoming the sole beacon of IP dispute adjudicator. But it might also risk drawing all the fireflies (read the litigators) and depleting its own hive. Other Courts are too brimming with honey (read specialised benches) as reflected in recent and robust IP pronouncements. Uniformity must become the norm across all IPDs to foster clarity, efficiency, and the advancement of a consistent and credible IPR jurisprudence.

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