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MANUAL

OF

PATENT PRACTICE AND PROCEDURE

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Manual of Patent Practice & Procedure

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PREFACE

This Manual is intended to provide detailed information to the public and users of Patent System on the practices and procedures followed by Patent Office for processing of patent applications. The Manual incorporates provisions of the Patents Act, 1970 as amended by the Patents (Amendment) Act, 2005 and the Patents Rules, 2003 as amended by the Patents (Amendment) Rules, 2006.

The format of the Manual is to reproduce successive sections and relevant rules of the Patents Act and Patents Rules followed by explanation and past decisions of the Patent Office, wherever available in general. However, for convenience of users, related topics have been consolidated in one place, e.g., patentable subject matter in chapter III. Citations from decisions of the courts of India and other countries have been included to provide guidance and help the users.

The Manual does not constitute rule making and hence do not have the force and effect of law. Statements made in the Manual are not in themselves an authority for any action by an officer of the Patent Office. While the Manual may be regarded as a handbook, it does not impose any particular line of action and may not be quoted to that end.

The Manual will be updated periodically in order to reflect important judgments, decisions and changes in practice and to correct errors, if any. Due care has been taken to avoid mistakes. However, if any shortcomings are noticed by the users, suggestions to improve the Manual will be appreciated and the same may be sent within thirty days.

(V. RAVI)
Controller General of Patents, Designs & Trade Marks
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CHAPTER I

INTRODUCTION

1.1 A patent is granted as an exclusive right by the Government for an invention for a limited period of time in consideration of disclosure of the invention by an applicant. A patentee enjoys exclusive right to prevent a third party from an unauthorized act of making, using, offering for sale, selling or importing the patented product or process within the country during the term of the patent. A patented invention becomes free for public use after expiry of the term of the patent or when the patent ceases to have effect on account of non-payment of renewal fee.

1.2 History of Indian Patent System

1.2.1 The first legislation in India relating to patents was the Act VI of 1856. The objective of this legislation was to encourage inventions of new and useful manufactures and to induce inventors to disclose secret of their inventions. The Act was subsequently repealed by Act IX of 1857 since it had been enacted without the approval of the sovereign. Fresh legislation for granting ‘exclusive privileges’ was introduced in 1859 as Act XV of 1859. This legislation contained certain modifications of the earlier legislation, namely, grant of exclusive privileges to useful inventions only and extension of priority period from 6 to 12 months. The Act excluded importers from the definition of inventor. The 1856 Act was based on the United Kingdom Act of 1852 with certain departures including allowing assignees to make application in India and also taking prior public use or publication in India or United Kingdom for the purpose of ascertaining novelty.

1.2.2 The Act of 1859 provided protection for invention only and not for designs whereas United Kingdom had been protecting designs from 1842 onwards. To remove this lacuna, the ‘Patterns and Designs Protection Act’ (Act XIII) was passed in 1872. This Act amended the 1859 Act to include any new and original pattern or design or the application of such pattern to any substance or article of manufacture within the meaning of ‘new manufacture’. The Act XV of 1859 was further amended in 1883 by XVI of 1883 to introduce a provision to protect novelty of the invention, which prior to making application for their protection were disclosed in the Exhibitions of India. A grace period of 6 months was provided for filing such applications after the date of the opening of such Exhibition.

1.2.3 In 1888, new legislation was introduced to consolidate and amend the law
relating to invention and designs in conformity with the amendments made in the UK law. The modifications introduced in the Indian law, by Act V of 1888, over the UK legislation, *inter alia*, includes:

- Shifting of authority to administer the Act from the Home department to Secretary to Government of India;
- Extension of the jurisdiction of the Act to other courts apart from High Courts of Madras, Calcutta and Bombay;
- Reduction in the fee from Rs. 100 to Rs. 10 only at filing stages;
- Graduation of fee as to amend approximately with the increasing value with the invention acquires as it becomes more commonly known and used.
- Provision for detailed disclosure of the invention, including best mode of working the invention in full clear, concise and exact terms so as to enable any person skilled in the art or science to make use of the invention;
- Provision of powers to call for a model of the invention;
- Change of time for filing petition in respect of patent granted in United Kingdom from 12 months from the ‘letters patent’ to 12 months from the ‘date of sealing’;
- Powers to extend the term of exclusive privileges by 7 years ordinarily and 14 years in exceptional cases.
- Provision for granting compulsory licence where invention is not made accessible to public, on reasonable terms;
- Appointment of Agents to encourage filing by foreign inventor;
- Introduction of provision for protection of new or original design;
- Provision for counting the grace period for filing application for invention displayed in the Exhibition from the date of admission of the invention into the Exhibition instead of the date of the opening of the Exhibition.

1.2.4 In 1911, the Indian Patents and Designs Act, 1911, (Act II of 1911) was brought in replacing all the previous legislations on patents and designs. This Act brought patent administration under the management of Controller of Patents for the first time. This Act was amended in 1920 to provide for entering into reciprocal arrangements with UK and other countries for securing priority. In 1930, further amendments were made to incorporate, *inter-alia*, provisions relating to grant of secret patents, patent of addition, use of invention by Government, powers of the Controller to rectify register of patent and increase of term of the patent from 14 years to 16 years. In 1945, another amendment was made to provide for filing of provisional specification and submission of complete specification within nine months.

1.2.5 After Independence, it was felt that the Indian Patents & Designs Act, 1911 was not fulfilling its objective. It was found desirable to enact comprehensive patent law owing to substantial changes in political and economic conditions in the country. Accordingly, the Government of India constituted a committee under the Chairmanship of Justice (Dr.) Bakshi Tek Chand, a
retired Judge of Lahore High Court, in 1949, to review the patent law in India in order to ensure that the patent system is conducive to the national interest. The terms of reference included —

a) to survey and report on the working of the patent system in India;
b) to examine the existing patent legislation in India and to make recommendations for improving it, particularly with reference to the provisions concerned with the prevention of abuse of patent rights;
c) to consider whether any special restrictions should be imposed on patent regarding food and medicine;
d) to suggest steps for ensuring effective publicity to the patent system and to patent literature, particularly regarding patents obtained by Indian inventors;
e) to consider the necessity and feasibility of setting up a National Patents Trust;
f) to consider the desirability or otherwise of regulating the profession of patent agents;
g) to examine the working of the Patent Office and the services rendered by it to the public and make suitable recommendations for improvement; and
h) to report generally on any improvement that the Committee thinks fit to recommend for enabling the Indian Patent System to be more conducive to national interest by encouraging invention and the commercial development and use of inventions.

1.2.6 The Committee submitted its interim report on 4th August, 1949 with recommendations for prevention of misuse or abuse of patent right in India and for amendments to sections 22, 23 & 23A of the Patents & Designs Act, 1911 on the lines of the United Kingdom Acts of 1919 and 1949. The main recommendations of the Committee were as follows:-

(a) Any interested person may apply for a compulsory licence or revocation of the patent on any of the following grounds, namely —

(i) patented invention, being capable of being commercially worked in India, is not being commercially worked therein to the fullest possible extent;
(ii) demand for the patented article in India is not being met to an adequate extent or on reasonable terms;
(iii) commercial working of the invention in India is being prevented or hindered by the importation of the patented articles; and
(iv) the refusal of the patentee to grant a licence or licences on reasonable terms, whereby the commercial or industrial activities in India are prevented or hindered;

(b) for obtaining relief against abuse of patent rights, an application can be made to the Controller of Patents and Designs any time after the sealing of the patent and the order of the Controller to be appealable before the
appellate authority which should be an ad-hoc Special Tribunal nominated by the Central Government consisting of –

(i) a sitting or retired judge of a High Court (as the President),
(ii) a barrister or advocate of not less than ten years standing, preferably conversant with patent law and procedure, and
(iii) a technical expert in the particular subject with which the patent in question is concerned

The functions of the Special Tribunal should be judicatory and not advisory, and its decisions should be final and it should have the power to award costs.

1.2.7 The committee also observed that the Patents Act should contain clear indication to ensure that food and medicine and surgical and curative devices are made available to the public at the cheapest price commensurate with giving reasonable compensation to the patentee.

1.2.8 Based on the above recommendation of the Committee, the 1911 Act was amended in 1950 (Act XXXII of 1950) in relation to working of inventions and compulsory licence/revocation. Following grounds were provided for making applications for compulsory licence:

(a) patented invention, being capable of being commercially worked in India, is not being commercially worked therein to the fullest possible extent;
(b) demand for the patented article in India is not being met to an adequate extent or on reasonable terms;
(c) commercial working of the invention in India is being prevented or hindered by the importation of the patented articles;
(d) the refusal of the patentee to grant a licence or licences on reasonable terms, the commercial or industrial activities in India are prevented or hindered;
(e) a market for the export of the patented article manufactured in India is not being supplied;
(f) the working or efficient working in India of any other patented invention which makes a substantial contribution to the establishment or development of commercial or industrial activities in India is unfairly prejudiced; and
(g) conditions of licence unfairly prejudiced the establishment or development of commercial or industrial activities in India.

The time period prescribed for making the applications was “at any time after expiration of three years from the date of sealing.” The application could also be made by the licencee. The term, ‘patented article’ included any article made by a patented process. Other provisions were related to endorsement of the patent with the words ‘licence of right’ on an application by the Government so that the Controller could grant licences. In 1952, an amendment was made to provide
compulsory licence in relation to patents in respect of food and medicines, insecticide, germicide or fungicide and a process for producing substance or any invention relating to surgical or curative devices, through Act LXX of 1952. The compulsory licence was also available on notification by the Central Government. Based on the recommendations of the Committee, a bill was introduced in the Parliament in 1953 (Bill No.59 of 1953). However, the bill lapsed on dissolution of the Lok Sabha.

1.2.9 In 1957, the Government of India appointed Justice N. Rajagopala Ayyangar Committee to examine the question of revision of the Patent Law and advise government accordingly. The report of the Committee, which comprised of two parts, was submitted in September, 1959. The first part dealt with general aspects of the patent law and the second part gave detailed note on the several clauses of the lapsed bill of 1953. The first part also dealt with evils of the patent system and solution with recommendations in regard to the law. The committee recommended retention of the patent system, despite its shortcomings. This report recommended major changes in the law which formed the basis of the introduction of the Patents Bill, 1965. This bill was introduced in the Lok Sabha on 21st September, 1965, which, however, lapsed. In 1967, an amended bill was introduced which was referred to a Joint Parliamentary Committee and on the final recommendation of the Committee, the Patents Act, 1970 was passed. This Act repealed and replaced the 1911 Act so far as the patents law was concerned. However, the 1911 Act continued to be applicable to designs. Most of the provisions of the 1970 Act were brought into force on 20th April, 1972 with the publication of the Patents Rules, 1972.

1.2.10 The salient features of the Patents Act, 1970 are:

- Elaborate definition of invention
- No product patents for substances intended for use as food, drugs and medicines including the product of chemical processes
- Codification of certain inventions as non-patentable
- Mandatory furnishing of information regarding foreign application
- Adoption of absolute novelty criteria in case of publication
- Expansion of the grounds for opposition to the grant of a patent
- Exemption of certain categories of prior publication, prior communication and prior use from anticipation
- Provisions for secrecy of inventions relevant for defence purposes
- Provision for use of inventions for the purpose of Government or for research or instruction to pupils
- Reduction in the term of patents relating to process in respect of substances capable of being used as food or as medicine or drugs
- Enlargement of the grounds for revocation of a patent
- Provision for non-working as ground for compulsory licences, licences of right, and revocation of patents
- Additional powers to Central Government to use an invention for purposes of government including Government undertakings
- Prevention of abuse of patent rights by making restrictive conditions in licence agreements/contract as void
• Provision for appeal to High Court on certain decisions of the Controller
• Provision for opening of branches of the Patent Office.

1.2.11 This Act remained in force for about 24 years till December 1994 without any change. An ordinance effecting certain changes in the Act was issued on 31st December 1994, which ceased to operate after six months. Subsequently, another ordinance was issued in 1999. This ordinance was later replaced by the Patents (Amendment) Act, 1999 that was brought into force retrospectively from 1st January, 1995. The amended Act provided for filing of applications for product patents in the areas of drugs, pharmaceuticals and agro chemicals though such patents were not allowed. However, such applications were to be examined only after 31st December, 2004. Meanwhile, the applicants could be allowed Exclusive Marketing Rights (EMRs) to sell or distribute these products in India, subject to fulfilment of certain conditions.

1.2.11 The second amendment to the 1970 Act was made through the Patents (Amendment) Act, 2002 (Act 38 of 2002). This Act came into force on 20th May, 2003 with the introduction of the new Patents Rules, 2003 by replacing the earlier Patents Rules, 1972. Salient features of the Patents (Amendment) Act, 2002 were:

• Further codification of non patentable inventions
• 20 years term of patent for all technology
• Provision for reversal of burden of proof in case of process patents
• Provisions of compulsory licences to meet public health concerns
• Deletion of provision of licence of right
• Introduction of system of deferred examination
• Mandatory publication of applications after 18 months from the date of filing
• Provision for process patent for micro organisms
• Establishment of Appellate Board
• Provision for parallel imports
• Provision for exemption from infringement proceedings for use of a patented invention for obtaining regulatory approval for a product based on that patented invention
• Provision to protect biodiversity and traditional knowledge.

1.2.13 The third amendment to the Patents Act, 1970 was introduced through the Patents (Amendment) Ordinance, 2004 w.e.f. 1st January, 2005. This Ordinance was later replaced by the Patents (Amendment) Act, 2005 (Act 15 of 2005) on 4th April, 2005 which was brought into force from 1st January, 2005. The salient features of this amendment are:

• Extension of product patents to all fields of technology including food, drugs, chemicals and micro organisms
• Deletion of the provisions relating to Exclusive Marketing Rights (EMRs)
• Introduction of a provision for enabling grant of compulsory licence for export of medicines to countries which have insufficient or no manufacturing capacity to meet emergent public health situations
• Modification in the provisions relating to opposition procedures with a view to streamlining the system by having both pre-grant and post-grant opposition in the Patent Office
• Strengthening the provisions relating to national security to guard against patenting abroad of dual use technologies
• Rationalisation of provisions relating to time-lines with a view to introducing flexibility and reducing the processing time for patent application.

1.3 Patents Rules

1.3.1 Section 159 of the Patents Act, 1970 empowers the Central Government to make rules for implementing the Act and regulating patent administration. Accordingly, the Patents Rules, 1972 were notified and brought into force w.e.f. 20th April, 1972. These Rules were amended from time to time till 20th May, 2003 when new Patents Rules, 2003 were brought into force by replacing the 1972 rules. These Rules were further amended by the Patents (Amendment) Rules, 2005 and the Patents (Amendment) Rules, 2006. The last amendments were made effective from 5th May, 2006.

1.3.2 There are four Schedules to the Patents Rules which provide details of fees and forms pertaining to various types of actions required under Patents Act and Rules:

- The First Schedule prescribes fees to be paid.
- The Second Schedule specifies the list of forms and the texts of various forms which are to be used wherever required in connection with various activities under the Patents Act.
- The Third Schedule prescribes the Form of the patent to be issued on the grant of patent.
- The Fourth Schedule prescribes costs to be awarded in various proceedings before the Controller under the Act.

1.4 Administrative Structure of the Patent Office

1.4.1 Patent system in India is administered under the superintendence of the Controller General of Patents, Designs and Trademarks (CGPDTM), appointed under sub-section (1) of Section 3 of the Trade Marks Act, 1999. The Office of the Controller General of Patents, Designs and Trade Marks is a subordinate office of the Department of Industrial Policy and Promotion, Ministry of Commerce and Industry and comprises the statutory offices of Patent Office,
Trade Marks Registry and Geographical Indication Registry. The Controller General’s Headquarters is located at Mumbai. There are four Patent Offices in India. The Head Office is at Kolkata and other Patent Offices are located at Chennai, Delhi and Mumbai. The Controller General of Patents, Designs and Trade Marks delegates his powers regarding various procedures for patent grant to Senior Joint Controller of Patents & Designs, Joint Controllers of Patents & Designs, Deputy Controllers of Patents & Designs and Assistant Controllers of Patents & Designs. Examination of patent applications is done by Examiners of Patents & Designs.
CHAPTER – II

PREAMBLE AND DEFINITIONS

2.1 The Patents Act, 1970 (39 of 1970)

An Act to amend and consolidate the law relating to patents.
Be it enacted by Parliament in the Twenty-First Year of the Republic of India as follows:--

2.1.1 The Patents Act was enacted by the Government of India in the year 1970 in pursuance of its powers under Entry 49 of the List I of Schedule VII of the Constitution of India. List I contains the list of the items in the Union List and Entry 49 reads, “Patents, inventions and designs; copyright; trade-marks and merchandise marks.” The Act was notified on 19th September, 1970 as Act 39 of 1970.

2.1.2 The word ‘amend’ is used to indicate the fact that patent law was in existence before the enactment of the Patents Act, 1970. The history of patent legislations in India is given in Chapter-I. Enactment of a new legislation while repealing the previous legislations does not de-legitimise the patents granted and other action taken under the previous law [see section 162(3) and (5) of the Patents Act, 1970].

2.1.3 In the statement of objects and reasons of the Patent Bill, 1970, it is stated, “a need for a comprehensive law so as to ensure more effectively that patent rights are not worked to the detriment of the consumer or to the prejudice of trade or the industrial development of the country was felt as early as 1948”. This gives fair indication to the intention of the Act. The patents law is also kept in line with the “development of technological capability in India, coupled with the need for integrating the Intellectual Property system with international practices and intellectual property regimes,” as stated in the statement of objects and reasons of the Patents (Second Amendment) Bill, 1999.

2.1.4 As observed by the Supreme Court in Bishwanath Prasad Radhey Shyam v. H.M. Industries [A.I.R. 1982 S.C. 1444 at paragraph 17], “The object of the patent law is to encourage scientific research, new technology and industrial progress. Grant of exclusive privilege to own, use or sell the method or the product patented for the limited period, stimulates new inventions of commercial utility. The price of the grant of the monopoly is the disclosure of the invention at the Patent Office, which after the expiry of the fixed period of the monopoly passes into public domain.”
2.2 **Section 1. Short title, extent and commencement.**—

(1) This Act may be called the Patents Act, 1970.
(2) It extends to the whole of India.
(3) It shall come into force on such date as the Central Government may, by notification in the Official Gazette, appoint.

Provided that different dates may be appointed for different provisions of this Act, and any reference in any such provision to the commencement of this Act shall be construed as a reference to the coming into force of that provision.

2.2.1 The applicability of the Patents Act extends to the whole of India. A patent granted as per the Act can only be enforced in the territorial limits of India only, subject to the provisions of section 49 of the Act. Patents granted as per this Act only are valid in India.

2.2.2 Proviso to sub-section 3 enables the Government to bring into force different provisions of the Act at different times. For instance, provisions relating to Appellate Board vide sections 116-117H were brought into force from 2nd April, 2007 only although other provisions had been brought into force earlier. The Patent Office is required to act under the provisions of a particular section only from the date those provisions are brought into force.

2.1 **Definitions**

**Section 2 Definitions and interpretation.**—

(1) In this Act, unless the context otherwise requires—

(a) "Appellate Board" means the Appellate Board referred to in section 116;

2.3.1 The reference is to the Intellectual Property Appellate Board (IPAB), Chennai. Provisions relating to the IPAB were brought into force with effect from 2nd April, 2007.

(ab) "assignee" includes an assignee of the assignee and the legal representative of a deceased assignee and references to the assignee of any person include references to the assignee of the legal representative or assignee of that person;

(aba) "Budapest Treaty" means the Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the purposes of Patent Procedure done at Budapest on 28th day of April, 1977, as amended and modified from time to time;
2.3.2. India became a member of the Budapest Treaty on 17\textsuperscript{th} December, 2001.

\( (ac) \quad \) "capable of industrial application", in relation to an invention, means that the invention is capable of being made or used in an industry;

2.3.3. The term ‘industrial application’ was introduced in the Patents Act through an amendment in 2002. As per the definition of ‘invention’ prior to the amendment, an invention had to be new and useful for grant of patent. As per Section 64(1)(g), lack of utility is a ground for revoking a patent. In \textit{Lakhapati Rai \& Ors. v. Srikissen Dass \& Ors.} \((1917)\), it was held that ‘utility’ does not mean improvement. It means practicability. The test of utility is whether the invention will work and whether it will do what is claimed for it.

\( (b) \quad \) "Controller" means the Controller General of Patents, Designs and Trade Marks referred to in section 73;

\( (c) \quad \) "convention application" means an application for a patent made by virtue of section 135;

\( (d) \quad \) "convention country" means a country or a country which is member of a group of countries or a union of countries or an Intergovernmental organization referred to as a convention country in section 133;

\( (e) \quad \) "district court" has the meaning assigned to that expression by the Code of Civil Procedure, 1908 (5 of 1908);

2.3.4 Sub-section 4 of section 2 of the Code of Civil Procedure, 1908 reads as under:

"district” means the local limits of the jurisdiction of a principal Civil Court of original jurisdiction (hereinafter called a “District Court”), and includes the local limits of the ordinary original civil jurisdiction of a High Court;

\( (f) \quad \) "exclusive licence" means a licence from a patentee which confers on the licensee, or on the licensee and persons authorised by him, to the exclusion of all other persons (including the patentee), any right in respect of the patented invention, and exclusive licensee shall be construed accordingly;

\( (g) \quad \) omitted w.e.f.1-1-2005

2.3.5 The omitted clause \( (g) \) read, “food’ means any article of nourishment for human consumption and also includes any substance intended for the use of infants, invalids or convalescents as an article of food or drink.”.

\( (h) \quad \) "Government undertaking” means any industrial undertaking carried on—

\( \text{ i. } \) by a department of the Government, or

\( \text{ ii. } \) by a corporation established by a Central, Provincial or State Act, which is owned or controlled by the Government, or
iii. by a Government company as defined in section 617 of the Companies Act, 1956 (1 of 1956), or

iv. by an institution wholly or substantially financed by the Government;

2.3.6 Section 617 of the Companies Act, 1956 provides that a Government company means “any company in which not less than 51% of the paid-up share capital is held by the Central Government or by any State Government or governments partly by the Central Government or partly by one or more State governments in includes a company which is subsidiary of the Government Company”. Thus, as stated by the Supreme Court in its judgement on Civil Writ Petition No. 171 of 2003 in Centre for Public Interest Litigation v. Union of India & Anr. decided on 16th September, 2003, holding of only 51% or more of the shares in a company either by the Central Government or State Government makes a company a government company.

(h) “High Court”, in relation to a State or Union territory, means the High Court having territorial jurisdiction in that State or Union territory, as the case may be;

(i) "international application" means an application for patent made in accordance with the Patent Cooperation Treaty;

2.3.7 Patent Co-operation Treaty is a treaty administered by the World Intellectual Property Organization (WIPO), a specialized agency of the United Nations Organization (UNO) . India became a member of the Patent Co-operation Treaty on 7th December, 1998.

(j) "invention" means a new product or process involving an inventive step and capable of industrial application;

2.3.8 Considering the question what is an ‘invention’, it was held in Raj Parkash v. Mangat Ram Choudhary, that “invention is to find out or discover something not found or discovered by anyone before and it is not necessary that the invention should be anything complicated and the essential thing is that the inventor was the first one to adopt it and the principle therefore is that every simple invention that is claimed, so long as it is something novel or new, would be an invention and the claims and the specifications have to be read in that light and a new invention may consist of a new combination of all integers so as to produce a new or important result or may consist of altogether new integers and the claims for anticipation by the defendant has to be either by prior user or by prior publication”. It was further observed that “whether a patent sets out an invention is to be determined by a true and fair construction of the specifications and the claims and in construing the specifications it would be erroneous to rely too much on the title thereof because the title cannot control the actual claim and a misleading title similarly is of no consequence and the words of the specifications should be given their ordinary meaning but where necessary must be construed in the sense in which they are used in a particular trade or sphere in which the invention is sought to have been made and it is the pith and marrow of the
invention that has to be looked into and one should not get bogged down or involved in the detailed specifications and claims made by the parties who claim to be patentee or alleged violators”.

(ja) “inventive step” means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art;

(k) “legal representative” means a person who in law represents the estate of a deceased person;

(l) “new invention” means any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification, i.e., the subject matter has not fallen in public domain or that it does not form part of the state of the art;

(la) “Opposition Board” means an Opposition Board constituted under sub-section (4) of section 25;

(m) “patent” means a patent for any invention granted under this Act;

2.3.9 A patent has been held to be a movable property by the Supreme Court in Appeal (Civil) 4552 Of 1998 in the matter of M/S. Sunrise Associates v. Government of NCT of Delhi & Ors, on 28th April, 2006. The court, after having considered the definition of "goods" in the Constitution, in the Sales of Goods Act 1930, the Central Sales Tax Act, 1956, the Tamil Nadu General Sales Tax Act, 1959, the Karnataka Sales Tax Act, 1957, as well as the Kerala General Sales Tax Act, 1963, said that all these definitions provided that goods mean inter alia all kinds of moveable property. The definition of property in several authorities was thereafter considered and it was concluded that the material on record showed a uniform emphasis on the expansive manner in which the expression 'property' was understood. It was noted that debts, contracts and other choses in action were chattels no less than furniture or stock in trade. Similarly, patents, copyrights and other rights in rem were also included within the meaning of movable property.

2.3.10 In Writ Petition (Civil) 12598 Of 1985 in the matter of Shri Kirshna Gyanoday Sugar Ltd. & Anr. v. State of Bihar, decided on 18th February, 2003, the Supreme Court referred to R.C.Cooper's Case in the following words: “in its normal connotation "property" means "highest right a man can have to anything, being that right which depend on another's courtesy: It includes ownership, estates and interests in corporeal things, and also rights such as trade-marks, copyrights, patents and even rights in personam capable of transfer or transmission, such as debts; and signifies a beneficial right to or a thing considered as having a money value.”

2.3.11 Unlike other property rights, a patent right may be revoked, amended or abandoned.
(n) "patent agent" means a person for the time being registered under this Act as a patent agent;
(o) "patented article" and "patented process" means respectively an article or process in respect of which a patent is in force;
(oa) "Patent Cooperation Treaty" means the Patent Cooperation Treaty done at Washington on the 19th day of June, 1970 as amended and modified from time to time;
(p) "patentee" means the person for the time being entered on the register as the grantee or proprietor of the patent;
(q) "patent of addition" means a patent granted in accordance with section 54; "patent office" means the patent office referred to in section 74;

2.3.12 The head office of the Patent Office is located at Kolkata and the branch offices at Chennai, Delhi and Mumbai.

(s) "person" includes the Government;
(t) "person interested" includes a person engaged in, or in promoting, research in the same field as that to which the invention relates;
(ta) "pharmaceutical substance" means any new entity involving one or more inventive steps;
(u) "prescribed" means,—

(A) in relation to proceedings before a High Court, prescribed by rules made by the High Court;
(B) in relation to proceedings before the Appellate Board, prescribed by rules made by the Appellate Board; and
(C) in other cases, prescribed by rules made under this Act;

(v) "prescribed manner" includes the payment of the prescribed fee;
(w) "priority date" has the meaning assigned to it by section 11;
(x) "register" means the register of patents referred to in section 67;
(y) "true and first inventor" does not include either the first importer of an invention into India, or a person to whom an invention is first communicated from outside India.

2.3.13 In the matter of application for patent No. 122013 and in the opposition proceedings under section 25 between Ganesh Mulji Rikabchand (applicant) v. Mischmetal and Flints Limited (opponent) DPD, VOL.1, P.126, the Controller held that the application was not allowable because the applicant has filed the application after being communicated from abroad. Section 2(1)(y) specifically excludes from the definition of “true and first inventor” a person to whom an invention had been communicated from outside India. Under section 6, only a “true and first inventor” or his legal successor in the title may apply for patent.
(2) In this Act, unless the context otherwise requires, any reference—

(a) to the Controller shall be construed as including a reference to any officer discharging the functions of the Controller in pursuance of section 73;

(b) to the patent office shall be construed as including a reference to any branch office of the patent office.

2.3.14 The definitions given in the above section are to be kept in view while interpreting the provisions of other sections of the Act.

2.4 Definitions in the Patent Rules

2.4.1 The Patents Rules define certain additional terms as below:--

Rule 2. Definitions.-

In these rules, unless the context otherwise requires,—

(a) “Act” means the Patents Act, 1970 (39 of 1970);
(b) “appropriate office” means the appropriate office of the patent office as specified in rule 4;
(c) “article” includes any substance or material, and any plant, machinery or apparatus, whether affixed to land or not;
(d) “Form” means a Form specified in the Second Schedule;
(e) “Schedule” means Schedule to these rules;
(f) “section” means a section of the Act;
(g) words and expressions used, but not defined in these rules, shall have the meanings respectively assigned to them in the Act.

2.4.2 The Patents Rules also provide certain definitions under Chapter-III relating to international applications under the Patent Cooperation Treaty.

Rule 17. Definitions.-

In this Chapter, unless the context otherwise requires,—

(a) “Article” means an Article of the Treaty;
(b) “Treaty” or “PCT” means the Patent Cooperation Treaty;
(c) All other words and expressions used herein and not defined but defined in the PCT shall have the same meaning as assigned to them in that Treaty.

2.4.3 Definitions and interpretations underwent changes and additions during various amendments to the Act and Rules to meet with the requirements of the changing scenario.
CHAPTER – III

PATENTABLE SUBJECT MATTER

Section 2. Definitions and interpretation.—

(j) "invention" means a new product or process involving an inventive step and capable of industrial application;

(ja) "inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art;

(l) "new invention" means any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification, i.e., the subject matter has not fallen in public domain or that it does not form part of the state of the art;

(m) "patent" means a patent for any invention granted under this Act;

3.1 Introduction

3.1.1 A patent is granted for an invention. An invention is defined in section 2(1)(j) as “a new product or process involving an inventive step and capable of industrial application.” Therefore, the criteria for an invention to be patentable are –

(i) it must be novel;
(ii) it must have an inventive step; and
(iii) it must be capable of industrial application.

Further, the invention should not fall under any of the categories of “Inventions Not Patentable” mentioned under sections (3) and (4) of the Patents Act, 1970.

3.2 Novelty of Invention

3.2.1 General Principle: An invention is considered new (novel) if it has not been anticipated by publication in any document any where in the world or used in the country or prior claimed in an application for patent in India or form part of the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere before the date of filing of patent application or date of priority, that is, the subject matter has not fallen in the public domain or that it does not form part of the state of the art.
Although the term ‘state of the art’ has not been defined under the Patents Act, the following general principles are applied by the Patent Office to determine the novelty of an invention during the examination procedure by applying provisions of section 13, read with the provisions of sections 29 to 34:

An invention is not considered to be novel

(a) if it has been anticipated by publication before the date of filing of the application in any of the specifications filed in pursuance of application for patent in India on or after 1st January, 1912.

(b) if it has been anticipated by publication made before the date of filing or the date of priority of the application in any of the documents in any country; or

(c) if it has been claimed in any claim of any other complete specification filed in India, which was filed before the date of application though published after the date of that application.

3.3 Determination of Novelty

3.3.1 In order to establish the novelty of an invention, search for anticipation by previous publication and by prior claim in relation to the subject matter of the invention for which the patent has been applied for is conducted by the examiner in the patent and non-patent literature to ascertain whether the invention has been anticipated by previous publication and prior claiming. This is a part of office action by the Patent Office towards conducting examination of patent applications.

3.3.2 Novelty is determined before inventive step because the creative contribution of the inventor can be assessed only by knowing the novel elements of the invention.

3.3.3 An invention defined in a claim lacks novelty if the specified combination of features have already been anticipated in a previous disclosure.

3.3.4 In order to demonstrate lack of novelty, the anticipatory disclosure must be entirely contained within a single document. If more than one document is cited, each must stand on its own. The cumulative effect of the disclosures cannot be taken into consideration nor can the lack of novelty be established by forming a mosaic of elements taken from several documents. This may be done only when arguing obviousness (Ammonia's Application, 49 RPC 409). However, if a cited document refers to a disclosure in another document in such a way as to indicate that, that disclosure is intended to be included in that of the cited document, then the two are read together as though they were a single document.

3.3.5 The state of the art in the case of an invention is taken to comprise all matter (whether a product, a process or information about either available in India or
elsewhere) which has at any time before the priority date of that invention been made available to the public by publication of description or by use in India.

3.3.6 Special care is taken when relying on dimensions derived from drawings. Although features shown solely in a drawing form part of the state of the art when a skilled person could derive a technical teaching from them without further description, it is generally not possible to derive a technical teaching by measuring dimensions in a diagrammatic representation and the dimensions under these circumstances do not, therefore, form part of the state of the art. [T204/83 (OJEPO 10/85)]

3.3.7 In the matter of Graf & CIE AG and Maschinenfabrik Rieter Ag v. Nitto Shoji Limited during pre-grant opposition proceedings of Application No. 422/Cal/2000 under section 25(1), the Controller held, “...a prior art drawing may be taken into consideration as a prior art disclosure if it discloses the essential features of the impugned claim in a sufficiently and clearly understandable manner to a skilled person and also if the drawing is such that it provides an enabling disclosure either explicitly or implicitly.”

3.3.8 A matter is considered as part of the state of the art on the date it first becomes available to the public, wherever in the world that may be, and in whatever manner or language the disclosure is made. There is no limit on the age of the disclosure.

3.3.9 Different claims may have different priority dates of documents, such as patent specifications, textbooks or technical journals which have been published in the conventional sense of that term such as the date of public sale, availability in libraries, etc.

3.3.10 Any document is regarded as having been published, and thus forming part of the state of the art, if it can be inspected as of right by the public, whether on payment of a fee or not; this includes, for example, the contents of the ‘open’ part of the file of a patent application once the application has been published.

3.3.11 Prior publication does not however depend on the degree of dissemination. The communication to a single member of the public without inhibiting fetter is enough to amount to making available to the public (Bristol-Myers Co's Application, [1969] RPC 146). There is no need even to show that a member of the public has actually seen the document. For example, in Monsanto Brignac’s Application, ([1971] RPC 153), it was held that a company had published a document by supplying it to its salesmen, since it had been given to them with no restriction on disclosure; indeed it had been put into their hands with the intention that they should make the information available to the public.

3.3.12 The invention is taken as lacking in novelty if information about anything falling within its scope has already been disclosed. Thus, for example, if a claim specifies alternatives or defines the invention by reference to a range of values (e.g. of composition, temperature, etc), then the invention is
not new if one of these alternatives, or if a single example falling within this range, is already known. Thus, a specific example is sufficient to destroy the novelty of a claim to the same thing defined generically. For example, disclosure of a metal coil spring anticipates a claim to resilient means. On the other hand, a generic disclosure does not impugn the novelty of a more specific claim, so that an earlier reference to a metal coil spring cannot be used to attack the novelty of a claim specifying such a spring made of copper. In some cases, however, the disclosure of a comparatively small and restricted field of possible alternatives might properly be held to be a disclosure of each and every member; for example, ‘fluid’ may be taken to disclose both liquid and gas, if the context warrants it, and a reference to an electric motor may be regarded as disclosing the use of both series and shunt-wound types.

3.4 Illustrative Cases

3.4.1 The subject matter disclosed prior to the filing of a patent application has been taken as destroying the novelty of the invention. Of course, to constitute a prior disclosure of a patent, the matter relied upon as prior art must disclose subject matter which, if performed, would necessarily result in infringement of the patent. This infringement test is detailed by the Court of Appeal in *General Tire & Rubber Company v. Firestone Tyre & Rubber Company Limited*, [1972] RPC 457, at page 485:

“If the prior inventor's publication contains a clear description of, or clear instructions to do or make, something that would infringe the patentee's claim if carried out after the grant of the patentee's patent, the patentee's claim will have been shown to lack the necessary novelty, that is to say, it will have been anticipated.

“If, on the other hand, the prior publication contains a direction which is capable of being carried out in a manner which would infringe the patentee's claim, but would be at least as likely to be carried out in a way which would not do so, the patentee's claim will not have been anticipated, although it may fail on the ground of obviousness. To anticipate the patentee's claim the prior publication must contain clear and unmistakable directions to do what the patentee claims to have invented ... A signpost, however clear, upon the road to the patentee’s invention will not suffice. The prior inventor must be clearly shown to have planted his flag at the precise destination before the patentee.”

3.4.2 The Court of Appeal applied this (disclosure of subject matter) test in *Glaverbel SA v. British Coal Corporation* [1995] RPC 255 where it was also held that it is not necessary for the prior art to be equal in practical utility or to disclose the same invention in all respects as the patent in suit.

3.4.3 It was held in the case of *Gujarat Reclalm & Rubber Products Ltd. v. Kamani Metallic Oxides Ltd.* (1983 PTC 105 (Bombay) that in a plea of prior public knowledge and prior public use by opponents, they have to establish that the invention claimed in any of the claims of the applicants (complete
specification) was a public knowledge and that the invention was in use publicly in India before the priority date of the claim i.e. 4th February, 1976. The opponents have not given any evidence in support of this ground except referring to the documents relied upon by them under the ground of prior publication. While considering ground of prior publication, documents relied upon by the opponents are not relevant as they do not anticipate the applicants' invention. Opponents have, therefore, failed to establish their case.

3.4.4 In the matter of M/s. Crompton Greaves Ltd. Mumbai v. M/s. Bharat Heavy Electricals Ltd. Hyderabad, on patent application No.221/BOM/96 (184657), it was held by the Controller that the ground that the invention was publicly known or publicly used in India was not established by the opponent since the photo copies submitted by the opponent stated mainly the terms and conditions of a contract to supply 3900 KVA and 5400 KVA traction transformers. The photocopies of work order did not define any constructional features of the traction transformer. A mere statement by the opponent company that they are the first in the field of manufacturing alone cannot stop the applicant company from obtaining a patent unless the opponents establish that they were manufacturing an identical product before the date of filing.

3.4.5 In the case of Monsanto company v. Coramandal Indag Products (P) Ltd. (1986) (1 SCC 642: AIR 1986 712: 1986 PTC 195 SC) it was held that the invention was publicly known since its formula was published in the report of the International Rice Research Institute in the year 1968 and its common name Butachlor was published in the same report in the year 1969.

3.4.6 In T 0814/04, a process for the production of trypsin in a filamentous fungus of an Aspergillus species was claimed. In a cited document it was disclosed that ‘trypsin like protease’ was isolated from a strain of Fusarium oxysporum, a culture which had been deposited at the DSM under the accession number DSM 2672. The protease was characterized by its amino acid sequence consisting of 224 amino acids which was represented in the sequence listing by the sequence listed as SEQ, ID NO:2. The same protease was acknowledged to be a trypsin and this trypsin was found to be equally homologous to trypsins from Strptomycyes griseus, Serythraeus and to bovine trypsin. Further, it was stated that the gene encoding the trypsinogen corresponding to that trypsin from Fusarium oxysporum with a signal peptide was expressed by the process as claimed in the present invention, i.e., by the same fungal expression vector p777 was used to prepare an expression vector that is co-transformed into the particular strain IFO 4177 of Aspergillus oryzae together with plasmid pToC90 or with plasmid pToC186. Both plasmids carrying the amdS gene from Aspergillus nidulans. The subject matter as claimed was held as not novel.

3.4.7 In Kirin-Amgen Inc. v. Roche Diagnostics GmbH [2002] RPC 1, it was held that “the law of patents is ultimately concerned with practicality”, and so a prior art experiment which, when performed, reliably produced a particular result “more than 99 percent of the occasions on which it is conducted” would be regarded for the purposes of disclosure as “inevitably” leading to the result in question. It follows that a claim which defines an invention by reference to parameters, for example, of a process or a
product, is anticipated by a disclosure, which when put into practice would necessarily fall within the scope of the claim, even if the disclosure does not refer to these particular parameters.

3.4.8 In T 303/86 (CPC Int) [1993] EPOR 241, the Technical Board of Appeal of the EPO considered the anticipation arising from two cook-book recipes of a process for making flavour concentrates from vegetable or animal substances by extraction with fat solvents under pressure in the presence of water. The claim specified certain parameters for the ratio between the vapour pressure of the water in the meat or vegetables and the vapour pressure of the free water. It was observed: "it is sufficient to destroy the novelty of the claimed process that this process and the known process are identical with respect to the starting material and reaction conditions since processes identical in these features must inevitably yield identical products." Furthermore, it did not matter that the cook had not realised that he was not only frying a chicken, but also making a "flavour concentrate" in the surplus oil. It was enough, as the Board said, that "some flavour of the fried chicken is extracted into the oil during the frying process even if this is not the desired result of that process."

3.4.9 In *Merrell Dow Pharmaceuticals Inc v. H N Norton & Co Ltd* [1996] RPC 76, the court held that the state of the art is not confined to knowledge of the chemical composition of the product. It is the invention which must be new and which must therefore not be part of the state of the art. It is part of the state of the art if the information which has been disclosed enables the public to know the product under a description sufficient to work the invention. Thus, in *Merrell Dow*, which centred on a claim to an acid metabolite formed in the liver after administration of terfenadine (itself the subject of an earlier patent), the acid metabolite was held to be anticipated not by prior use but because it was the inevitable result of carrying out the directions in the earlier terfenadine patent.

3.4.10 In *Norton Healthcare Ltd v. Beecham Group Plc* (BL C/62/95), The Court held that a prior suggestion of a combination of sodium or potassium clavulanate with amoxycillin or ampicillin trihydrate (four possible combinations only) was a disclosure of each of the combinations.

3.4.11 In *Union Carbide Corp. v. BP Chemicals Ltd* [1998] RPC 1 The Court held that "the information given by a direction not to do X because it will have adverse consequences is not equivalent to a direction to do X because it has beneficial consequences or does not have the supposed adverse consequences" and so novelty will not be impugned by an earlier disclosure which in effect gives clear directions not to do that which is claimed in a later application. It was observed that "an invention can lie in finding out that which, in the art thought ought not be done, ought to be done."

3.4.12 In *SmithKline Beecham Plc’s (Paroxetine Methanesulfonate) Patent* [2006] RPC 10, it was held that infringement of a patent must not merely be a
possible or even likely consequence of performing the invention disclosed by the prior disclosure; it must be necessarily entailed. If there is more than one possible consequence, one cannot say that performing the disclosed invention will infringe. The flag has not been planted on the patented invention, although a person performing the invention disclosed by the prior art may carry it there by accident or (if he is aware of the patented invention) by design. Indeed it may be obvious to do so. Therefore, a disclosure which is capable of being carried out in a manner which falls within the claim, but is also capable of being carried out in a different manner, does not anticipate, although it may form the basis of an obviousness attack. In this case, the court Lord Hoffmann summarized the disclosure requirement as follows: “anticipation requires prior disclosure of subject-matter which, when performed, must necessarily infringe the patented invention”.

3.4.13 If the prior publication is contained in a document, it may not be necessary that members of the public should have actually read the document. It is enough if the document is accessible to the public without much trouble (Lallubhai Chakubhai v. Chimanlal Chunilal & Co. A.I.R. 1936 Bom. 99).

3.4.14 An invention is deemed to be made publicly known if a document containing an adequate description of it, whether issued as a general publication or not, has in the course of ordinary business and without imposing any secrecy, reached an appreciable section of the public interested in the art to which the invention relates (Decision of the Controller (1938) Re. Patent Application No. 23077).

3.4.15 The specification which is relied upon as an anticipation of the invention should convey the same knowledge as the specification of the invention itself. (Pope Alliance Corp. v. Spanish River Pulp & Paper Mills Ltd., A.I.R. 1929 P.C. 38).

3.4.16 A document is not considered as a proper anticipation unless it gives the public the same information as the one presented in the applicant’s specification. A mosaic of extracts culled from several documents have not been accepted as constituting a relevant anticipation (Decision of the Controller (1942) Re. Patent Application No. 27709).

3.4.17 A ‘mosaic’ of separate steps, each known in manufacture, is not sufficient to constitute ‘anticipation’ as to warrant the refusal of grant of a patent, though they may have a bearing upon the question of quantum of ingenuity which arises when a court is called upon to consider whether there is ‘subject matter’ for a patent in the invention (Decision of the Deputy Controller (1946) Re. Patent Application No. 32384.)

3.4.18 In Pope Alliance Corp. v. Spanish River Pulp & Paper Mills Ltd., A.I.R. 1929 P.C. 38, it was held that in order to render a document as a prior publication, it must be shown that it contains all that is material to instruct the public on how to put the invention in practice.

3.4.19 As per the decision of the Controller upheld by the Central Government (1944) Re. Patent Application No. 29089 in order to be effective prior knowledge of an invention the prior publication should contain such information as would enable one conversant with the art, to which the invention relates, to perceive
the very discovery and to carry it into practical use.

3.4.2 As per the decision of the Controller (1945) Re. Patent Application No. 29180, the disclosure of a document to two or more selected individuals in Government service does not appear to be sufficient to constitute public knowledge of that document.

3.5 **Enabling Prior Art**

3.5.1 Establishment of anticipation by the prior art requires that the prior invention should be sufficiently disclosed so that a person skilled in the art is able to work the invention without undue burden of experimentation.

3.5.2 Determination of enablement of a prior disclosure for the purpose of anticipation stands on the same footing as the test of enablement of the patent itself for the purpose of sufficiency. However, depending on the facts of the case the application of the test would differ. In the case of sufficiency, the skilled person is attempting to perform a claimed invention setting the goal in mind, whereas in the case of prior art, the subject matter may have been disclosed in the invention but not identified as such. The ordinary skilled person must be able to perform the invention in order to satisfy the requirement of disclosure. Thus, the requirement of sufficiency of the disclosure and enablement with regard to prior art are different. In particular, the role of the person skilled in the art is different. In the case of sufficiency, the skilled person is taken to be trying to understand what the author meant. His common general knowledge forms the background in construing the disclosure, with the patent being construed on similar principles. Once this is performed, in determining whether or not the disclosure amounts to infringe when the person skilled in the art has no further role to play. On the other hand, for enablement, the person skilled in the art is assumed to be willing to make trial and error experiments to get it to work, and the question is not what the skilled person would think the disclosure meant, but rather whether he would be able to work the disclosed invention.


3.6 **Prior Public Use**

3.6.1 Prior public use of the invention in India before the date of filing of application destroys the novelty of the invention. However, there is an exception to this general rule. The Act provides that if an invention has been publicly worked in India within one year before the priority date by the patentee or applicant for the patent or by any third person from whom he derives the title or by the person who has obtained a consent to work the invention and such working of invention was only for the purpose of reasonable trial and it was necessary to effect such trial or working in public in view of the nature of the invention then such working of invention does not anticipate the invention (Section 32).

Few Illustrative Cases are presented in the following paragraphs:
3.6.2 In *Lallubhai Chakubhai v. Chimanlal Chunilal & Co.* A.I.R., 1936 Bom. 99, it was held that public user did not mean a user by the public but a user in a public manner. It was further held that the use of an invention for purposes of trade, whether by the inventor himself or by others, would constitute public user of the invention. It was also held that public sale of articles is strong evidence that the user is commercial and not experimental. But to constitute evidence of public user, the sale must be open and in the ordinary way of business.

3.6.3 In patent application No. 23077, the Controller held that an invention should be deemed to be publicly used if in the course of regular business (as distinguished from experimental user), the invention has been used without observing any secrecy about it, in any place to which persons without confidential relationship are allowed access.

3.6.4 In *Lallubhai Chakubhai v. Shamaldas Sankalchand* A.I.R., 1934. Bom. 407, it was held that if an article manufactured under a secret process is of such a character that any body by examining it can find out the secret of that manufacture, then the sale of that article in public would amount to public user of the process. It was also held that secret use of an invention by the inventor himself for experimental purposes or the manufacture of an invention for the inventor by a manufacturer, who is under injunction to keep the invention secret, will not make the patent invalid.

3.6.5 In *Monsanto Co. v. Coromandel Indag Products (P) Ltd.* 1986 A.I.R. 712, it was held that “to satisfy the requirement of being publicly known as used in clauses (e) and (f) of section 64(1), it is not necessary that it should widely be used to the knowledge of the consumer public. It is sufficient if it is known to the persons who are engaged in the pursuit of knowledge of the patented product or process either as men of science or men of commerce or consumers.”

3.6.6 In patent application No.23077, it was held by the Controller that an invention should be deemed to be made publicly known if a document containing an adequate description of it, whether issued as a general publication or not, had in the course of ordinary business and without imposing any secrecy, reached an appreciable section of the public interested in the art to which the invention relates.

3.6.7 In patent application No.29180, it was held by the Controller that disclosure of a document to two or more selected individuals in Government service did not appear to be sufficient to constitute “public knowledge” of the said document.

3.6.8 In *Lux Traffic Controls Ltd v Pile Signals Ltd and Faronwise Ltd*, [1993] RPC 107, the court recognized that what was made available to the public often differed according to whether the public had an article in their possession to handle, measure and test or whether they could merely look at it. Depending on the circumstances a skilled person might be able to determine how an article was constructed and operated or
nothing material might be disclosed.

3.6.9 If an article or a material is unconditionally supplied to a member of the public, possibly as the result of just a single sale (T482/89 OJEPO 11/92), it is regarded as making available information to the public if that information could be obtained by dismantling or analysing the article or material or even destruction of the article (G1/92 OJEPO 5/93).

3.6.10 Novelty is destroyed by prior use of a product if analysis of the product using available techniques shows the skilled person that it falls within the scope of the claims (T952/92 OJEPO 11/1995).

3.6.11 In the case of Ram Narain Kher v. Ambassador Industries, (AIR 1976 Del 87.), it was held that at the time the patent is granted to a party it is essential that the party claiming patent should specify what particular features of his device distinguish it from those which had gone before and show the nature of the improvement which is said to constitute the invention. A person claiming a patent has not only to allege the improvement in art in the form but also that the improvement effected a new and very useful addition to the existing state of knowledge. The novelty of the invention has to be succinctly stated in the claim. It is no doubt true that the claim made is addressed to the skilled persons in the art or trade and not to a common man yet there can be no escape from the fact that the novelty of the claim or the advantage derived by the invention has to be succinctly stated in the claim and must not be left to an inference raised on a general review of the specification. It is equally true that even when the invention 'was not itself new', its combination with the other elements of the system producing the advantageous results; would be a sufficient element of novelty to support the patent. It may be only a small step but that may be a step forward and that is all that is necessary so far as the subject-matter is concerned.

3.6.12 In Staridipack Private Limited v. Oswal Trading Co. Ltd (1999 (19) PTC 479 (Del)) the invention was related to thickness of the layers of pouch. The issue was about the thickness of plastic film/layer depends upon the tolerance of the contents in the pouch. It was held that the invention is merely an arrangement and rearrangement of the items and cannot be termed as a novel concept and does not have any novelty. Such arrangement and rearrangement of mixture of the materials cannot become an invention, for it is only an improvement by adding microns as per the strength of the layers. Thus, prima facie the invention claimed by the plaintiff in respect of the thickness of the layers of the aforesaid pouch cannot be called an invention as envisaged within the definition clause of the Patents Act. Besides, the documentary evidence placed on record prima facie indicates that the claim made by the plaintiff is already known in the trade and the patent was pre-published.

3.6.13 In Milliken Denmark AS v. Walk Off Mats Ltd and anr [1996] FSR 292, the court held that the hiring of mats to customers who were free to inspect them amounted to anticipatory prior use even though the mats relied on perforations not visible to the naked eye for their function. While there was no reason to suppose that any customer should have conducted tests which would have revealed the perforations, a skilled person called on to
investigate the mats would none the less have discovered them. The knowledge of the perforations would enable the skilled person to perform the invention. It was irrelevant that he would not know of its virtues. Moreover, if the process by which the article or material has been made can be deduced with certainty from such examination, that would also form part of the state of the art.

3.6.14 In T84/83 1979-85 EPO R 796, it was held that if a machine is displayed or operated where it can be seen by a member of the public, such as at an exhibition, on the highway, or in a part of a factory to which persons not bound to secrecy are admitted, then all information which a person skilled in the art might be able to gather is regarded as having been disclosed and therefore loses novelty. On the other hand, use of a battery in cars on the highway by employees who were well aware that the design was confidential did not amount to disclosure of the battery (J Lucas (Batteries) Ltd v. Gaedor Ltd, [1978] RPC 297).

3.6.15 In patent application No.26209, the Controller held that prior use of machine for profit in private premises amounts to public use within the meaning of section 9(1) (d) of the Patents and Designs Act, 1991, if the machine is worked in the ordinary way and under no conditions of secrecy.

3.6.16 In patent application No.27208, it was held that in proving prior use of an invention described in a patent specification it is not enough merely to allege that a “machine similar to the applicant’s machine” has been used, without giving a fair description of the machine actually used.

3.6.17 In patent application No.31894, it was held that it would be most unfair to refuse a patent to an applicant merely because his rivals alleged that they had used a device “similar to the Applicant’s device”, if the Controller was not afforded a fair opportunity to judge for himself whether the device alleged to have been used by them is in fact similar to the Applicant’s device.

3.6.18 In Bilcare Limited v. Amartara (P) Ltd. (IA Nos. 10848/2006, 13971/2006 and 11160/2006 in CSOS No.1847/2006 relating to patent No.197823), it was observed, “whether an alleged invention involves novelty and an inventive step, is a mixed question of law and fact, depending largely on the circumstances of the case. Although no absolute that is informally applicable in all circumstances can be devised, certain broad criteria can be indicated. Whether the manner of manufacture patented was publicly known, used and practised in the country before or at the date of the patent ?. If the answer to the question is ‘Yes’, it will negate novelty or ‘subject matter’. Prior public knowledge of the alleged invention which would disqualify the grant of patent can be by word of mouth or by publication through books or other media. If the public once become possessed of an invention, says Hindmarch on Patents, by any means whatsoever, no subsequent patent for it can be granted either to the true or first inventor himself or any other person, for the public cannot be deprived of the right to use the invention… the public already possessing everything that he could give “ [Source www.judis.nic.in].
3.6.19 The use of an invention for purposes of trade, whether by the inventor himself or by others, may constitute public user of the invention (Lallubhai Chakubhai v. Chimanlal Chunilal & Co. A.I.R. 1936 Bom. 99).

3.6.20 Public sale of an article is strong evidence that the user is commercial and not experimental. But to constitute evidence of public user, the sale must be open and in the ordinary way of business. (Lallubhai Chakubhai v. Chimanlal Chunilal & Co. A.I.R. 1936 Bom. 99)

3.6.21 In invention should be deemed to be publicly used if in the course of regular business (as distinguished from experimental user), the invention has been used without observing any secrecy about it, in any place to which persons without confidential relationship are allowed access [Decision of the Controller (1938) Re. Patent Application No. 23077].

3.7 Prior Claiming

Section 13. Search for anticipation by previous publication and by prior claim.

(1) The examiner to whom an application for a patent is referred under section 12 shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification –

... ... (b) is claimed in any claim of any other complete specification published on or after the date of filing of the applicant’s complete specification, being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.

3.7.1 In order to prove prior claiming of the invention, compliance with the following conditions is examined:

(i) that the application ‘X’ where the invention has been claimed prior to the application ‘Y’ claiming alleged invention, has been filed in India

(ii) the application ‘X’ must have been filed earlier to the date of filing or priority date of application ‘Y’ in question

(iii) the application(x) should have been published on or after the date of application(y) in question.

3.7.2 In the matter of application for patent No. 123140, Centron Industrial Alliance Private Limited v. Harbans Lal Malhotra and Sons Private limited, [DPD, Vol.1, p 133], application filed on 15th September, 1969 in respect of “Improvements in or relating to blades of razors and like instruments.” The claim1 was a method of manufacturing, superior quality blades of razors and like instruments as therein defined, which included coating the blades with polytetrafluoroethylene, characterised in that the said method consisted of atomic or molecular deposition in vacuum of a thin film of particles of a
corrosion resistant material on the cutting edge or edges of the blades of the said instruments before coating the said blades with said polytetrafluoroethylene. Claim 1 of the prior filed application 120345 filed on 14th March, 1969 cited for prior claiming was a method of manufacturing superior quality blades of razors and like instruments as herein defined, which consists atomic or molecular deposition in vacuum of a thin film of particles of a corrosion resistant material on the cutting edge or edges of the blades of the said instruments and thereafter coating the said blade with polytetrafluoroethylene. Controller found the application completely anticipated by prior claiming.

3.7.3 Three more applications such as 120651 and 120652 both of 31st March, 1969 and 118127 of 16th October, 1968 were found anticipating by prior claiming in part. Application No. 120651 claimed Rhodium as deposited material on the cutting edges of the blade instead of a general expression “corrosion resistant material” of impugned claim. The only difference of ‘651 was the use of Rhodium as a thin film of particle deposited. The Controller observed that the characteristic property of Rhodium was identical with the property of corrosion resistant material and concluded that the claim at issue was anticipated by cited document in part by prior claiming. Similarly, 120652 used platinum and was held as anticipating in part by prior claiming. Application No. 118127 used razor blades made of carbon steel or hardened stainless steel having a coating of chromium. This was also held as anticipating in part by prior claiming.

3.8 Novelty in case of selection inventions

3.8 A prior disclosure in general terms embracing a number of alternatives may amount to no more than a mere suggestion that any of the members, including any specifically exemplified, might be used and may, therefore, is regarded as not anticipating a claim to a specific one of the members. An invention so claimed is generally referred to as a "selection" invention and is required to meet the following criteria:

(a) the selection is based on some substantial advantage gained or some substantial disadvantage avoided,
(b) substantially all the selected members necessarily possess the advantage in question, and
(c) the selection is in respect of a quality of special character which can fairly be peculiar to the selected group. However, this is not necessarily nullified if it transpires that some other members of the class from which the selection is made have this quality, but the claim may be invalid if it is found that the quality is common to many other members in addition to those selected (IG Farbenindustrie AG's Patent, 47 RPC 289 P.322).

3.9 Inventive Step (Non-Obviousness)

3.9.1 After establishing the novelty, an invention is assessed for inventive step. The invention is not considered to involve an inventive step, if it is obvious to a person skilled in the art on the date of priority. Inventive step is assessed on
Inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art. [Section 2(1)(ja)]

3.9.2 Further, section 2(1)(l) defines “new invention” as “any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification, i.e. the subject matter has not fallen in public domain or that it does not form part of the state of the art.”

3.10 Important Features of Assessment of Inventive Step

3.10.1 The Supreme Court laid down the following criteria for assessing inventive step in M/s. Bishwanath Prasad Radhey Shyam Appellant v. M/s. Hindustan Metal Industries, “It is important that in order to be patentable an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy the test of invention or an ‘inventive step’. To be patentable the improvement or the combination must produce a new result, or a new article or a better or cheaper article than before. The combination of old known integers may be so combined that by their working interrelation they produce a new process or improved result. Mere collection of more than one integers or things, not involving the exercise of any inventive faculty, does not qualify for the grant of a patent.” [AIR 1982 Supreme Court 1444]

3.10.2 In Canadian General Electric Co. Ltd., v. Fada Radio Ltd. A.I.R., 1930. PC.I., it was observed that under the general law of patents, an invention which consists of a small inventive step but having regard to the conditions of the art, constitute a step forward, be good subject matter for a patent.

3.10.3 In Gillette Industries Ltd., v. Yeshwant Bros. A.I.R., 1938. Bom. 347, it was held that mere simplicity was not necessarily an objection to the subject matter of an invention, though matters of ordinary skilled designing or mere workshop improvements were not inventions.

3.10.4 When the invention is just an automatic or obvious extension of prior art, the invention lacks in inventive step.

3.10.5 To judge the inventive step, the question to be answered is-

“Would a person with ordinary skills in the art have thought of the alleged invention?” If the answer is ‘No’, then the invention is non-obvious. The question, “Is there an inventive step?” arises only if there is novelty in the invention. If the invention makes available to the person skilled in the art something that he would not reach by normal exercise of his skill; then the
inventor has made a contribution to the art which justifies the grant of a patent. This does not mean that an invention has to be technically complex. This can be very simple too.

3.10.6 Just as an invention will lack novelty if the claim to it would re-monopolize something already disclosed, likewise it will be regarded as obvious if a claim to it would inhibit the rights of a skilled workman to carry out routine modifications of what is already in the public domain.

3.10.7 The term "obvious" means that the invention does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art. For this purpose a person skilled in the art is presumed to be an ordinary practitioner aware of what was general common knowledge in the relevant art at the relevant date. In some cases the person skilled in the art may be thought of as a group or team of persons rather than as a single person.

3.10.8 Some examples to illustrate the points mentioned above are presented in the following paragraphs.

3.10.9 A patent application which was under opposition related to a process for extracting *neem* oil from *neem* seeds comprising the steps of (a) treating crushed *neem* seeds in a soxhlet solvent extraction containing polar solvent at a temperature between 40c and 60c to obtain an oil cake free from bitter and odoriferous constituents (b) drying the oil cake by solvent extraction using hexane wherein the ethanol has 80-90% concentration. The opponent filed an opposition on the basis of prior published documents from the book entitled *The Oil Extraction* disclosing therein extraction of kernels (seeds) with 70% of alcohol to remove bitter and odiferous compounds followed by hexane extraction to recover good quality of oil. The argument of opponent based on the evidence of the expert who had worked in the field of extraction for 30 years was that such type of extraction is always done between 40c and 60c. The invention was held obvious on the basis of the expert opinion as the person skilled in that can carry out extraction as use of soxhlet apparatus at 40 to 60 degree centigrade was very common in the oil extraction industry.

3.10.10 Another case decided by the Patent Office was related to a hardening composition comprising (i) an unsaturated polyester resin (ii) hardening accelerator containing cobalt metal soap and (iii) methyl ethyl ketone peroxide as hardener. Two documents were submitted by the opponent wherein document one was disclosing a hardening composition comprising (i) unsaturated polyester resin, (ii) hardening accelerator containing three component cobalt metal soap, calcium metal soap & copper metal soap and (iii) tertiary butyl per-benzoate as a hardener. Document two was disclosing the method of hardening of unsaturated polyester resin using peroxides such as methyl ethyl ketone peroxide, tertiary butyl per benzoate which can function as a hardener. The Controller held the invention obvious in view of the disclosure in the two cited documents as it was obvious to a person skilled in the art to use tertiary butyl per benzoate as hardener in the hardening composition.
3.11 Mosaicing Multiple Documents

a. When assessing the inventive step, combining the teachings of different documents within the prior art [mosaics] is permissible, if it is obvious to do so at the time of filing or priority date of patent application, to the person skilled in the art.

b. In Technograph v. Mills and Rockley(1972 RPC 346 at p-355(HL), it was observed that “when dealing with obviousness, unlike novelty, it is permissible out of relevant documents, but it must be mosaic which can be put together by an unimaginative man with no inventive capacity.”

c. All the information in any set of documents can be combined provided they are all in the same art. In Dow Chemical Company (Mildner's Patent), [1973] RPC 804, the court indicated that in order to establish obviousness in such a case it is necessary to be able to conclude that the documents are the ones which the seeker after information would come across and would consider together.

d. If the invention can be produced by combining the teaching of one document with common general knowledge or with standard practice in the art, then, even if the inventor has not conceived it, nor the applicant presented it in such terms, there is a strong presumption that such a combination would be obvious to the skilled person. If, in his application, the applicant refers to prior art as “conventional”, this may be taken to indicate that the prior art is common general knowledge (NEC Corporation's Application (BL O/038/00).

e. When a problem defined with reference to the prior art and as disclosed in a primary document would necessitate the skilled person to take help from the individual solutions available in different secondary documents, in the same or related fields to provide part of the solution to the objective problem, the inventive step is assessed taking into account these documents also.

f. Where the documents are from different technical fields, the question is whether the problem would have prompted search in those fields. It is reasonable to expect a person skilled in the art, unable to fulfil a need in the relevant field, to look for suitable parallels in a neighbouring field so closely related that he would take developments therein into account, or in the broader general field in which the same or similar problems extensively arise and of which he must be expected to be aware (Decision T 176/84, OJEPO 2/86).

g. In Dow Chemical Company (Mildner's Patent [1973] RPC 804, an invention residing in an electrical cable in which a plastics jacket was securely bonded to a metal shield using a specified copolymer was held to be obvious in the light of one document disclosing all the features of the cable but not mentioning the adhesive copolymer and other documents disclosing the copolymer. Although these latter documents did not refer to cable manufacture, they did refer to the
copolymer as having high moisture resistance and being suitable for bonding plastics to metal, both essential properties in adhesives for use in cables. It was, therefore, reasonable to expect the skilled person concerned with the problem of adhering plastics to metal in cables to have found and considered these documents.

h. When a problem defined by reference to the closest prior art, as disclosed in a primary document, would necessitate the skilled person to take help from the individual solutions available in different secondary documents, in the same or related fields to provide part of the solution to the objective problem, the inventive step is assessed taking into account these documents also.

i. The invention has to be considered as a whole for consideration of inventive step. It is thus not sufficient to draw the conclusion that a claimed invention is obvious merely because individual parts of the claim taken separately are known or might be found to be obvious.

j. If a claim relates to a composition comprising known ingredients, it is likely to be obvious, unless the mixture/combination leads to some new effect, say, for example, synergistic effect.

k. If an invention lies merely in verifying the previous predictions, without substantially adding anything for advancement in the art, the inventive step is lacking.

l. In general, where an invention comprises a collection of known or obvious parts, it must be shown before raising the objection for obviousness that it was obvious to combine these parts.

m. Where an invention can be thought of as the result of a selection from a number of alternatives, to demonstrate that the invention is not obvious, it is usually only necessary to show that it solves a technical problem in a surprising or unexpected way.

3.12  **Ex-Post Facto Analysis in relation to Inventive Step**

3.12.1 The examiner (or any other person) who is considering the question of whether or not an invention is obvious has to bear in mind that it is an ex-post facto analysis. He can be very easily misled by a line of reasoning involving taking the solution and working backwards to the problem by a succession of easy steps. In considering a prior publication, the examiner has to avoid looking at the document under the influence of the application he is examining, and should attempt to place himself in the shoes of the skilled person faced with the problem at hand.

3.12.2 In the *Windsurfing International Inc. v. Tabur Marine (Great Britain) Ltd.* [1985] RPC 59, the Court of Appeal held that the question of obviousness “has to be answered, not by looking with the benefit of hindsight at what is known now and what was known at the priority date and
asking whether the former flows naturally and obviously from the latter, but by hypothesizing what would have been obvious at the priority date to a person skilled in the art to which the patent in suit relates”.

3.13 **Inventive Step in relation to combination invention**

3.13.1 In assessing the inventive step involved in an invention based on a combination of features, consideration is given to whether or not the state of the art was such as to suggest to a skilled person precisely the combination of features claimed. Thus the question is not whether the skilled person, with access to the entire prior art, could have made the combination according to the invention, but whether he actually would have done so in expectation of an improvement.

3.13.2 The fact that an individual feature or a number of features were known from prior art does not conclusively show the obviousness of a combination (T 37/85, T 666/93, T 1018/96); but whether the state of the art would lead a skilled person to this particular overall combination of possibly already known features. In such a case, it would be impossible for a combination consisting exclusively of known individual features to involve an inventive step (T 388/89, T 717/90, T 869/96).

3.13.3 A mere aggregation of features has to be distinguished from a combination invention. The existence of a combination invention requires that the relationship between the features or groups of features be one of functional reciprocity or that they show a combinative effect beyond the sum of their individual effects.

3.13.4 In T 406/98, the EPO Board found that as a rule, particularly when large numbers of citations were involved, it was necessary to ask why the skilled person would consider documents in that specific combination, and whether, not knowing the invention, he had reason to do so. In that case, a complete solution to the problem required deliberate selection from a large number of citations.

3.13.5 A combination invention is to be judged on the basis of whether these features or sets of features are functionally interdependent, i.e. mutually influence each other to achieve a technical success over and above the sum of their respective individual effects as assumed in the case of a combination of features.

3.13.6 It was held in T 597/93 and T 687/94 that there was no inventive step in combining the two feature of the claim both known per se, since they related to the solving of two entirely separate partial problems and the solutions could be assessed separately against the prior art.

3.14 **Determination of Inventive Step**

3.14.1 The following aspects are looked into while determining inventive step in the alleged invention:
A) **Issues involved in assessment of Inventive Step**

(a) What was the problem which the patented development addressed?
(b) How long had that problem existed?
(c) How significant was the problem seen to be?
(d) How widely known was the problem and how many were likely to seeking a solution?
(e) What prior art would have been likely to be known to all or most of those who would have been expected to be involved in finding a solution?
(f) What other solutions were put forward in the period leading up to the publication of the patentee's development?
(g) To what extent were there factors which would have held back the exploitation of the solution even if it was technically obvious?
(h) How well had the patentee's development been received?
(i) To what extent could it be shown that the whole or much of the commercial success was due to the technical merits of the development? (*Haverman v. Jackal* (1999) FSR 685 at 699-701).

B) **Steps in Determination of Inventive Step**

(a) Determining scope and content of the prior art to which the invention pertains;
(b) Assessing the technical result (or effect) and economic value achieved by the claimed invention;
(c) Assessing differences between the relevant prior art and the claimed invention
(d) Defining the technical problem to be solved as the object of the invention to achieve the result;
(e) Final determination of non-obviousness, which is made by deciding whether a person of ordinary skill could bridge the differences between the relevant prior art and the claims at issue.

C) **Assessing Inventive Step**

In assessing an inventive step, mosaics is permissible, if it is obvious to do so at the time of filing or priority date of patent application, to the skilled person in the art, as stated in para. 3.11 *supra*. The applicant may, for example, have presented his invention as a combination of features A, B, C, and D which he admits as known in combination, with a further feature E which it would undoubtedly be inventive to add to the acknowledged combination. It may be that a prior document discloses the combination of features A and E, and that the addition of the remaining features B, C, D is then the most natural way of completing the disclosure in the prior document and therefore obvious.
3.15 Person Skilled in the Art

3.15.1 The person skilled in the art is presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date (average skilled person). He is also be presumed to have had access to everything in the state of the art, in particular the documents cited in the search report, and to have had at his disposal the normal means and capacity for routine work and experimentation. Such person need not possess any inventive capability. It was the presence of such capability in the inventor, which set him apart from the notional skilled person. His attitude is considered to be conservative. He would never go against an established prejudice, nor try to enter unpredictable areas nor take incalculable risks.

3.15.2 The skilled person can be expected to look for suggestions in neighbouring fields if the same or similar problems arise in such fields. The skilled person can be expected to look for suggestions in a general technical field if he is aware of such fields. The notional skilled person would perform a transfer of technology from a neighbouring field to his specific field of interest, if this transfer involved routine experimental work comprising only routine trials. In Tetra Molectric Ltd v. Japan Imports Ltd ([1976] RPC 547) the Court of Appeal held that a claim to a smoker's lighter using piezoelectric ignition was obvious. Since the possibility of using piezoelectricity in a lighter would have occurred to the industry, a skilled lighter manufacturer, himself not an expert in piezoelectricity, could reasonably be expected to seek advice from those who were. If such experts had been consulted, they would have advised that the suggestion was definitely worth trying, and they could have solved such problems as arose. The hypothetical skilled man in this case was therefore a team which included persons skilled in piezoelectricity, and not simply persons engaged in the lighter industry.

3.15.3 The skilled man need not be expected to try all combinations unless he has a problem in mind and particular combinations might assist him in solving it; he is not to be expected to take steps or try processes which he would not regard as worthwhile as a possible means of achieving or assisting in practice the objective which he has in view (see the judgment of the Court of Appeal in Hallen Co v. Brabantia (UK) Ltd [1991] RPC 195).

3.15.4 In advanced technical fields, the competent "skilled person" could be taken to be a group of people as "skilled person" from the relevant technical branches such as a research or production team.

3.15.5 The person skilled in the art is normally not supposed to be aware of patent or technical literature in a remote technical field. In appropriate circumstances, however, the knowledge of a team consisting of persons having different areas of expertise can be taken into account (T 141/87, T 99/89). Solutions of general technical problems in non-specific (general) fields are considered to be part of the general technical knowledge. This would be the case in particular if an expert in one particular field was appropriate for solving one part of the problem, while for another part one would need to look to another expert in a different area (T 986/96). Thus, in real life the semiconductor expert would consult a plasma specialist if his problem concerned about
providing a technical improvement to an ion-generating plasma apparatus (T 424/90) or the average skilled person in electronics, particularly if he did not have an adequate knowledge of programming languages himself, might be expected to consult a computer programmer if a publication contained sufficient indications that further details of the facts described therein were to be found in a program listing attached as an annex thereto (T 164/92) or in advanced laser technology, the "skilled person" may be as a production team of three experts in physics, electronics and chemistry respectively (T 222/86).

3.15.6 The average skilled person would not engage in creative thinking (T 500/91). Yet, he or she could be expected to react in a way common to all skilled persons at any time, such as an assumption or hypothesis about a possible obstacle to the successful realisation of a project. For example, in T 412/93 the patent related to the production of erythropoietin. The parties agreed that in this particular case the skilled person should be treated as a team of three, composed of one PhD scholar with several years' experience in the aspect of gene technology or biochemistry under consideration and two laboratory technicians fully acquainted with the known techniques relevant to that aspect. The composition of the team might vary depending on the knowledge and skills required by the particular aspect dealt with.

3.15.7 In T 455/91 (OJ 1995, 684) the EPO Board set out considerations on the skilled person's likely attitude to possible changes, modifications or adjustments in known products (e.g. a plasmid) or procedures (e.g. an experimental protocol). Its aim was to answer, objectively and avoiding any ex post facto analysis, the question whether it would be obvious to the skilled person to make the claimed changes in a structure or procedure. The skilled person in this field was well aware that even a small structural change in a product (e.g. a vector, protein, or DNA sequence) or procedure (e.g. a purification process) could produce dramatic functional changes. He would, therefore, adopt a conservative attitude. For example, he would neither go against an established prejudice, nor venture into "sacrosanct" or unpredictable areas, nor take incalculable risks (T 441/93).

3.15.8 In application number 94/CAL/2002 (Applicant: Sanjiv Agarwal, Fairfest Media Private Limited), the Controller held, “… the contention of the agent of the applicant that the examiner or the Controller is not supposed to be a person skilled in the art is not well founded. On the contrary we find that the Act imposes it on them that they should put themselves at the place of person skilled in the art not only to determine the inventiveness but also to determine the novelty and sufficiency of disclosure of the alleged invention.”

3.16 Lack of Inventive Step

3.16.1 Some examples of lack of inventive steps are given below:

a) When invention lies only in providing equivalents (mechanical, electrical or chemical) to the known art. For example, use of hydraulic motor instead of electric motor in a pump.
b) When the prior art is incomplete and the invention lies in “filling the gap”, which would naturally or readily occur to the skilled person. For example, the invention is a building structure made from aluminium. The prior art discloses such a structure of light weight material but does not mention aluminium.

c) When the invention consists of a new use of well-known material employing the known properties of that material. For example, a washing composition containing detergent which is a known compound having property of lowering the surface tension of water; the property being known as the essential one for detergents.

d) When an invention consists of a new use of well-known material employing the known properties of that material, inventive step is lacking. For example, a washing composition containing detergent which is a known compound having property of lowering the surface tension of water; the property being known as the essential one for detergents.

e) Substitution of a recently developed material in a known device whose properties make it suitable for that use as earlier. For example, an electric cable comprises a polyethylene sheath bonded to a metallic shield by an adhesive. The invention lies in the use of a particular newly developed adhesive known to have the property of being suitable for metal bonding.

f) Selecting a particular range of parameters from a limited range of possibilities, which is obvious The invention can be arrived at as a mere a simple extrapolation in a straightforward way from the known art.

g) Use of a known technique in a closely analogous situation. For example, application of a pulse control technique to an electric motor driving an auxiliary mechanisms of an industrial truck such as a fork-lift truck, where the use of this technique is already known for the electric propulsion motor of the truck.

h) Juxtaposition of known devices or processes not producing any non-obvious working inter-relationship.

3.17 Indicators of Inventive Step

3.17.1 While assessing an inventive steps, various indicators could be employed.

a. Distance: It is to be decided as to how much is the distance between the subject-matter of the invention and the prior-art. If such distance is large, establishing the inventive step is easier.

b. Surprising Effect: The inventive step may be present if there is a surprising or unexpected effect. However, if the measures which lead to this effect, are
near at hand by themselves, a surprising effect is not sufficient for granting a patent.

c. **Long Felt Need**: If the claim solves a "long felt need", there is a presumption that a claim is not obvious as other inventors might have also tried to solve it but could not provide the solution to fulfil the need.

d. **Failure of Others**: If other inventors have tried to solve a problem and were not successful, the claim will likely involve an inventive.

e. **Complexity of Work**: If the work undertaken by the inventor in order to produce the invention was particularly complex, and not readily carried out, that is an indication that it was not a matter of routine. In such cases the invention can be non-obvious.

f. **Commercial Success**: Commercial success is indicative (but not conclusive) of an inventive step.

g. Cheaper and more economical Product and simplicity of the proposed technological solution.

h. Prior art motivation.

### 3.18 Long Standing Problem

3.18.1 The fact that no-one has followed a particular path before does not of course dispose of an objection of obviousness; otherwise any invention which was new would automatically be inventive. However, the reasons why this has not been done before may well be important, in establishing inventive step.

(i) If the inventor has solved a long-standing problem by using in a conventional way the materials or techniques which have only recently become available then this is not inventive.

(ii) It is also not inventive to respond to a change in economic circumstances. For example if a product has not been made from a particular material or by a particular process for reason of cost, and the material or process becomes cheaper or the market value of the product increases, it is not inventive to take advantage of this.

(iii) If a newly-arisen problem is solved by the use of available resources in an obvious way, then there is no inventive step (unless the inventor has been the first to identify the problem).

(iv) But if the inventor has solved a long-recognised problem by means which others could have used but did not, then there may be an inventive step (Minnesota Mining & Manufacturing Co v. Rennicks Ltd [1992] RPC 331).

3.18.2 In *Chiron Corp v. Organon Teknika Ltd* [1994] FSR 202, a claim to a polypeptide comprising an antigenic determinant of the hepatitis C virus
was found to be non-obvious because despite the attempts of numerous research groups over a 10 year period to identify the agent responsible for Non-A, Non-B Hepatitis (later named as Hepatitis C), the patentees succeeded in a unique fashion by adopting a known technique which would not have been obvious to try in the circumstances.

3.19 Fulfilling Need

3.19.1 Evidence that an invention fulfils a long-felt want and has been commercially successful is ordinarily taken into account in assessing obviousness. The decisions in *Hickman v. Andrews*, [1983] RPC 147, *PLG Research Ltd v. Ardon International Ltd*, [1993] FSR 197) and *Optical Coating Laboratory Inc. v Pilkington P.E. Ltd*. [1995] RPC 145, P.166, uphold this principle. At the same time, it is important to have evidences as to the long-felt want or unsuccessful attempts to solve a particular problem, time taken in developing the prior art and the advantage stemming from the invention. It is possible that commercial success of the invention may be attributable to factors achieved independently of the invention, such as the quality or price of the product, or to superior marketing.

3.19.2 In *Tetra Moletric Ltd v. Japan Imports Ltd*, [1976] RPC 547, on the other hand, it was held that the commercial success of a cigarette lighter was due in large part to hammer mechanisms developed since the date of the invention; although in the application claim 1 covered lighters which had enjoyed commercial success, it also covered lighters which could never do so, and no features which might ensure success were recited.

3.20 Advantages of invention

3.20.1 Taking a cue from *[T119/82, OJEPO 5/84 ]* it can be inferred that if an invention claims a variation from the prior art but which has no advantages, or is even disadvantageous, it does not meet the criterion of inventive step. The position is of course different if the applicant has discovered that a variation thought to be disadvantageous is in fact not so, or if from a large number of variants which would have been regarded as no more than feasible alternatives with no advantages, the applicant has selected a variant with an unexpected advantage.

3.21 Obvious to try

3.21.1 An invention was related to the use of particular flocculating agents in asbestos cement manufacturing. It was held that, filtration processes being common to many industries, two cited documents, although addressed primarily to the mining and paper industries respectively, were likely to be read by those concerned with the asbestos cement industry, and that such readers would have realised that there was a newly-introduced flocculating agent which it was well worth trying out in their filtration process *[Johns-Manville Corporations Patent, [1967] RPC 479 P 494].*

3.21.2 An effect which was revealed by following the obvious course of action did not make the action non-obvious. It was wrong to ask whether you would
have predicted the effect [Bristol-Myers Squibb Co v. Baker Norton Pharmaceuticals Inc [1999] RPC 253]. However, mere possible inclusion of something within a research programme on the basis that more will be found out basis you will find out more and something might turn up is not enough to show obviousness. If it were otherwise there would be few inventions that were patentable. The ‘obvious to try’ test really only works where it is more-or-less self-evident that what is being tested ought to work” For example, in Saint-Gobain PAM SA v. Fusion Provida Ltd and Electrosteel Castings Ltd [2005] EWCA Civ 177, [2005] IP & T 880, it was observed that the cited prior art pointed to the possibility that using a Zn/Al alloy as a coating for a cast iron pipe to be buried in soil might be beneficial by showing results for this alloy coating for buried steel plates. In this case it was held that it was not however possible for the skilled person to predict success, so the invention was not obvious.

3.21.3 Contribution to the art disclosed by the patent specification is also crucial in considering whether something is obvious to try. In Angiotech Pharmaceuticals Inc’s [2006] RPC 28, the court held that the contribution to the art made by the specification had to be assessed in order to decide whether it was sufficient to show that something was an obvious candidate for testing without any expectation of success, or whether it was necessary to show that the skilled person must have had an expectation of success sufficient to induce him to use it in practice.

3.21.4 If the specification gave no indication of the likelihood of success, side-effects or efficacy, the invention was likely to be held obvious. For example, in an application decided in [2007] RPC 20, the patent specification disclosed that taxol could be incorporated on a stent (a tubular device which acts as scaffolding to hold a diseased artery open), but gave no suggestion that this would be safe or prevent restenosis (closure of the lumen of the artery caused by proliferation of smooth muscle cells). Therefore, a claim to a taxol-coated stent was held to be invalid as it was concluded to be obvious to a skilled person that taxol should be incorporated onto a stent with a view to seeing if it prevents restenosis and is safe.

3.22 Selection

3.22.1 Although there is no inventive step if it is clear from the prior art that taking that step is likely to lead to success, there may be invention if that is only one of many courses possible, and there is no reason to infer from the prior art that this one is more likely than the others to be profitable.

3.22.2 In Bayer AG (Baatz’s) European Application [1982] RPC 321, carbonless copying paper was characterised by microcapsules made of a particular polymer, which was already known for forming coatings on textiles, leather, wool and metal. Even if these were thought to be neighbouring fields, there was no reason to expect that improved results would be obtained by the use of this material (as the results of comparative experiments showed they were), and thus it was not obvious to select it from the enormous number possible.
3.22.3 In *Olin Mathieson Chemical Corporation v. Biorex Laboratories Ltd*, [1970] RPC 157 at page 192, it was held not to be obvious that a useful drug would be obtained by substituting -CF₃ for -Cl in a known drug, given the large amount of prior material, leading in a number of different directions, which was before the skilled person at the date of the invention.

3.22.4 A "selection" invention should meet the criterion that the selection is based on some substantial advantage gained or some substantial disadvantage avoided. All the selected members must possess the advantage in question and selection must be in respect of a quality of special character which can fairly be said to be peculiar to the selected group. This is not necessarily nullified if it transpires that some other members of the class from which the selection is made have this quality, but the claim may be invalid if it is found that the quality is common to many other members in addition to those selected [47 RPC 289, P 322-3]

3.22.5 The advantage relied upon to justify a selection invention should be clearly disclosed if it would not otherwise be apparent to a person skilled in the art. For example, in *Glaxo Group Ltd's Patent* [2004] RPC 43, the Patents Court held that unexpected bonus effects not described in the specification could not form the basis of a valid claim to a selection invention. If there is no statement of advantage in the specification at the time of filing it may not normally be added later, although such a statement (which will of course be open to public inspection) may be filed and may be taken into account.

3.22.6 Although the size of the class from which a member or members have been chosen is not relevant to the question of novelty of a selection invention, it may be relevant to the question of obviousness (*Du Pont de Nemours &c (Witsiepe's) Application*, [1982] FSR 303, P 310). In the *Du Pont* case, the relevance of a document describing a composition with a general formula to a claim to a particular composition falling within that formula was considered.

3.22.7 The technical significance of the parameters by which the product or process is selected should be considered. Where unusual parameters are used in a claim it may be difficult to prove whether or not the prior art would have inevitably exhibited those parameters, but in *Raychem Corp.'s Patents* [1998] RPC 31 it was held that "although it may not be obvious, in the common use of that word, to limit a claim by reference to some particular meaningless and arbitrary parameter, that had nothing to do with patentability. Patents are not given for skill in inventing technically meaningless parameters." If a product or process with obviously desirable characteristics happens to fall within the limits of such claims then they cover what is obvious and will thus be invalid.

3.22.8 In *Union Carbide Corporation (Hostettler's) Application*, [1972] RPC 601, P 609, it was observed that if in fact the step taken was an obvious step, it remains an obvious step however astonishing the result of taking it may be. An added benefit, however great, will not find a valid patent if the
claimed innovation is obvious for another purpose.

3.22.9 In *Hallen Co v. Brabantia (UK) Ltd* [1991] RPC 195, it was held to be obvious to coat a corkscrew of self-pulling type with PTFE to facilitate its penetration into a cork; the claimed invention was not saved by the non-obvious additional advantage of facilitating extraction of the cork from the bottle (although it might have been saved as a selection patent if the specification had contained clear assertions that the corkscrew in question turned the use of PTFE to special advantage over other corkscrews in the extraction stage, thus overcoming a problem of all previous self-pullers).

3.22.10 In general, an otherwise obvious combination is not saved from a finding of obviousness by some unexpected advantage caused by an unpredictable co-operation between the elements of the combination (see *Glaxo Group Ltd’s Patent* [2004] RPC 43).

3.23 Overcoming Technical Prejudice

3.23.1 An invention may be regarded as non-obvious if it goes against the generally accepted views and practices in the art. In *Appliances Ltd v. Hoover Ltd* [2001] RPC 26, it was held that the common general knowledge held by the skilled person may have both positive and negative aspects, and it is necessary to take account of both; in other words, it is necessary to take into consideration what the skilled person would consider doing and what the skilled person would be prejudiced against doing, as a result of that knowledge. If the common general knowledge was such that the skilled person did not perceive a problem with the prior art, it becomes “considerably more difficult” to establish the obviousness of taking a particular step which would bring that prior art within the scope of the claims in question. In the case in question it was held that the common general knowledge of the skilled person at the relevant time, along with a lack of a perceived problem, would mean that the skilled person would never have considered using anything other than bag technology in a vacuum cleaner. Further examples are if persons skilled in the art would regard certain materials or techniques as unsuitable for a particular purpose, then if the inventor has found that this prejudice is not well-founded, then he has made an inventive contribution to the art. Likewise the omission of a step hitherto thought to be necessary may constitute an inventive step.

3.23.2 A rooted objection to the regular use of b2-antagonists in the treatment of asthma, which was the subject of an ongoing dispute amongst specialist physicians, was not ascribed to the skilled person. Another situation is where scientific opinion is out of accord with what is done in the market, as occurred in *Ancare New Zealand Ltd’s Patent* [2003] RPC 8 for a sheep drench comprising two known agents, one active against roundworms and one active against tapeworms. In this case, the patentee argued that an inventive step lay in including the tapeworm agent because there was scientific hostility against treating tapeworms in sheep. However, it was common practice for New Zealand farmers to treat their lambs for
3.23.3 There is also no invention in merely tolerating the disadvantages which have deterred others. For example, if an inexpensive plastics material is thought unsuitable for making tools because it is not durable, there is no invention in using it to make a cheap screwdriver intended only for light work and accepting that it will have only a short life.

3.23.4 Some of these points may be illustrated by a hypothetical example: Suppose that it has been stated for years in textbooks that a particular class of chemical reaction, carried out under elevated pressure, gives poor yields, and an inventor now claims the synthesis of a particular compound by such a process. If all he has done is to take advantage of the high price commanded by the product, or the cheapness of the starting materials, and has decided to accept the disadvantage of low yield, then that is not inventive; it is an obvious response to prevailing economic circumstances. On the other hand, if the inventor has discovered that good yields can be obtained by the use of still higher pressures, a fact not suggested in the prior art, then that would be inventive. But if higher yields would be expected at difficult-to-obtain pressures, and the inventor has merely taken advantage of new techniques making such pressures more available, then that is not inventive. Finally, if the inventor has discovered that the standard accepted views on the low yields, while being normally true for this reaction, are not in fact true for this particular compound, then there is inventive step in the choice of this process.

3.24 Case Studies on Assessment of Inventive Step

3.24.1 In the case of *Rickett & Colman of India Ltd. v. Godrej Hi Care Ltd.*, (2001 PTC 637 (PO)), Application of M/s. Rickitt & Colman of India Ltd., the patent "A Mosquito/Insect Repellent Device" was challenged by opponents on various grounds of section 25 of the Act including lack of inventive step. The issue in this case was, "whether the applicant's devices involve any inventive step and the opponents has lead any evidence as to patentability". It was held that the alleged device was obvious and clearly did not involve any inventive step. Further the opponents had not adduced any evidence regarding grounds of patentability. So, it was construed that opponents had dropped the aforesaid grounds. As the opposition had been successful on the ground of section 25(1)(e), the ground 25(1)(a), i.e. wrongfully obtained was not discussed and the grant of patent was refused.
3.24.2 In the case of application No. IN/PCT/2002/00020/DEL, it was concluded under section 25(1), that invention as claimed in finally revised claims 1 to 49 in the patent application did not involve any "inventive step" having regard to the prior art citations JP-8059512 published on 5th March, 1996 and US Patent 5,885,617 published on 23rd March, 1999. Therefore, it could not be considered as an invention under section 2(l)(j) of the Patents Act, as it is a mere admixture and therefore not patentable under section 3(e) of the Patents Act. It was held that “the selection of particular range of ingredients from the ranges already known prior art in this case cannot amount to establish the inventive step and the variations in the amounts of the known ingredients appear merely workshop improvements achieved by a person skilled in the art without performing any substantial experiments and can not be said a technical advancement of an existing knowledge which is required by the definition of the "inventive step" as mentioned in section 2(l)(ja) of the Patents Act, 1970.” For the ground under section 3(e), it was held that “the existence of already known characteristics of composition with known ingredients cannot be termed as synergy among the ingredients of claimed composition”

3.24.3 In the case of Patent No. 173953 (223/BOM/1991), the invention was related to “process for making a soap composition containing glycerol”. Opposition was lodged on the grounds of prior publication, prior public knowledge, obviousness, not an invention within the meaning of the Act and also for not sufficiently defining the invention. It was held that the ingredients recited in the principal claim had a very specific and narrow range of proportions, which were not taught by cited documents. Cited document did not teach how to obtain the right balance of salt and glycerol in order to avoid a soap which is too hard or too soft. Also, in the cited documents there was no mention of balancing the quantities of glycerol or salt against the quantities of total fatty matter. Therefore, the opponents failed to establish the grounds.

3.24.4 In the case of Patent No. 183455 (203/BOM/1997), the invention related to a process for preparation of injectable Nimesulide composition. Opposition was lodged on the ground of obviousness, among other grounds such as prior publication and prior public knowledge. In view of the cited Sri Lankan Patent, the alleged invention stood anticipated as the cited document disclosed the invention or disclose information in such a way as to make it part of the state of the art. The claim lacked in novelty if information about anything falling within its scope had already been disclosed in the prior art. Thus, for example, if a claim specified alternative, or defined the invention by reference of range of values, then the invention was not new if one of these alternatives, or if a single example falling within this range, was already known. Thus a specific example was sufficient to destroy the novelty of a claim when the same is defined generically. The grant of patent was refused on the above grounds.

3.24.5 In the case of *Ajay Industrial Corporation v. Shiro Kamas of Iberaki City* (AIR 1983 Del 496.), the specification and claims had all to be read together and reasonably and benevolently construed. In the absence of any technical or expert evidence either indicating that these statements were wrong or that the
article produced incorporated no new devices to get over these defects, it could not be held that the patent embodied no new discovery or invention. It was held that the appellant had not discharged the onus that lay on it to establish that the respondent's patent could not have been registered and, therefore, needed to be revoked.

3.24.6 In the case of *Monsanto Company v. Coramandal Indag Products (P) Ltd.*, (1986) (1 SCC 642: AIR 1986 712: 1986 PTC 195 SC) Herbicide CP 53619 (Butachlor) was publicly known before Patent Number 125381 was granted. Its formula and use had already been made known to the public by the report of the International Rice Research Institute for the year 1968. No one claimed any patent or any other exclusive right in Butachlor. To satisfy the requirement of being publicly known as used in clauses (e) and (f) of section 64(1), it is not necessary that it should be widely used to the knowledge of the consumer public. It is sufficient if it is known to the persons who are engaged in the pursuit of the knowledge of the patented product or process either as men of science or men of commerce or consumers. The section of the public, who as men or science or men of commerce, were interested in knowing about Herbicides which would destroy weeds but not rice, must have been aware of the discovery of Butachlor. There was no secret about the active agent Butachlor as claimed by the plaintiffs since there was no patent for Butachlor, as admitted by the plaintiffs. Emulsification was the well-known and common process by which any Herbicide could be used. Neither Butachlor nor the process of Emulsification was capable of being claimed by the plaintiffs as their exclusive property. The solvent and the emulsifier were not secrets and they were admittedly not secrets and they were ordinary market products. From the beginning to the end, there was no secret and there was no invention by the plaintiffs. The ingredients, the active ingredients, the solvent and the emulsifier, were known, the process was known, the product was known and the use was known. The plaintiffs were merely camouflaging a substance whose discovery was known throughout the world and trying to enfold it in their specification relating to Patent Number 125381. The patent was held to be liable to be revoked.

3.24.7 In *Franz Zaver Huemer v. New Yesh Engineers*, (1996 PTC (16) 164 Del.) the court observed that the plaintiff was not an inventor of the patent device as the device was already being used in machines for several years in several countries especially in India. The defendant had set out several details to show that the machines were already being manufactured for over one and a half decade vide para 9 to 16 of the affidavit, leading to an inference that there was nothing new in the plaintiff's device. The court also observed that arrangement or rearrangement of the already known device did not amount to an invention.

3.24.8 In *Surendra Lai Mahendra v. Jain Glazers* [1981 PTC 112 Del.] it was held that the plaintiff's patent was nothing more than an indigenous combination of certain integers which formed part of Morance machine designed to be a less expensive and cheaper apparatus. The court observed that while it might be termed as simplification of the apparatus to some extent but it was difficult *ex facie* to say that it involved an exercise of inventive step or
inventive faculty. The applicant had produced a workable machine but it incorporated almost all the integers and components of Morance machine. So it could not be said that he had added a scintilla of invention to produce the same. On his own showing the plaintiff had to handle a couple of Morance machines which were not found to be workable in India and therefore, his services had to be secured by the parties concerned as a skilled technician to put the same in working order. The court, therefore, noted that the plaintiff after having tried his hand on Morance machines, was able to devise an apparatus of his own by virtually copying the same process and making some alterations and adjustments here and there so as to obviate the necessity of sophisticated and costly integers used by Morance.

3.24.9 What constitutes an inventive step may depend on the nature of the invention. This issue was considered in Biogen Inc v. Medeva plc [1997] RPC 1 (at page 34) as follows: Whenever anything inventive is done for the first time it is the result of the addition of a new idea to the existing stock of knowledge. Sometimes, it is the idea of using established techniques to do something which no one had previously thought of doing. In that case the inventive idea will be doing the new thing. Sometimes it is finding a way of doing something which people had wanted to do but could not think how. The inventive idea would be the way of achieving the goal. In yet other cases, many people may have a general idea of how they might achieve a goal but not know how to solve a particular problem which stands in their way. If someone devises a way of solving the problem, his inventive step will be that solution, but not the goal itself or the general method of achieving it.

3.25 Industrial Applicability

3.25.1 The third criteria of patentability is that the invention should be capable of industrial application. It is defined in Section 2 (1) (ac) of the Patents Act, 1970.

Section 2 (1) (ac)

“Capable of Industrial application”, in relation to an invention, means that the invention is capable of being made or used in an industry.

3.25.2 If the subject matter is devoid of industrial application it does not satisfy the definition of “invention” for the purpose of the Act. Ordinarily, "Industry" is taken in its broad sense as including any useful and practical, as distinct from intellectual or aesthetic activity. It does not necessarily imply the use of a machine or the manufacture of a product and covers such thing as a process for dispersing fog or a process of converting energy from one form to another.

3.25.3 Vague and speculative indication of possible objectives that might or might not be achievable by carrying out further research with the tool as described may not be sufficient for fulfilment of the requirement of industrial
applicability. The purpose of granting a patent is not to reserve an unexplored field of research for an applicant.

3.25.4 Methods of testing are generally regarded as capable of industrial application if the test is applicable to the improvement or control of a product, apparatus or process which itself is capable of industrial application. It is therefore advisable to indicate the purpose of the test if this is not otherwise apparent.

3.25.5 Processes or articles alleged to operate in a manner which is clearly contrary to well-established physical laws, such as perpetual motion machines, are regarded as not having industrial application, as was held in Paez's Application (BL O/176/83) and Webb's Application (BL O/84/88).

3.25.6 An invention for a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body is not taken to be capable of industrial application.

3.25.7 Parts /pieces of the human or animal body to be used in transplants are objected as not being capable of industrial application.

3.26 Case studies on Industrial applicability

3.26.1 In Chiron Corp v. Murex Diagnostics Ltd and other [1996] RPC 535 (page 607), it was held that the requirement that the invention can be made or used “in any kind of industry” so as to be “capable of industrial application” carries the connotation of trade or manufacture in its widest sense and whether or not for profit and, further, that no industry exists in that sense to make or use that which is useless for any known purpose.

3.26.2 Views of the High Court of Australia in NRDC's Application, [1961] RPC 134, give a good guide to the meaning to be attributed to industrial application. There must be a product, but this need not be an article or substance, but must be something in which a new and useful effect, be it creation or alteration, may be observed. It may, for example, be a building, a tract or stratum of land, an electrical oscillation, but it must be useful in practical affairs. A method of eradicating weeds was held to give rise to a product (an improved crop) because this was an artificially created state of affairs; moreover it was one whose significance was economic.

3.26.3 In Melia's Application (BL O/153/92), where an application relating to a scheme for exchanging all or part of a prison sentence for corporal punishment was held to lack industrial applicability and also to be a method for doing business.

3.26.4 In John Lahiri Khan’s Application (BL O/356/06) a method for effecting introductions with a view to making friends was held not to be industrially
applicable, even though it could be carried out by a commercial enterprise. It was also found to be excluded as a method of doing business.

3.26.5 In *Eastman Kodak Co. v. American Photo Booths Inc.* (BLO/457/02), the issue was a patent for a photo-booth camera, it was held that the folded optical path as described and claimed could not give rise to the claimed narrowing of the depth of field. As a result, the hearing officer held that the invention could not work as described and claimed, and so lacked both industrial applicability and sufficiency of disclosure. Objecting to insufficiency may be particularly appropriate if the claims do not refer to the intended function or purpose of the invention, for example if a “flying gyroscope” is claimed merely as an article having a particular specified construction.
CHAPTER IV

INVENTIONS NOT PATENTABLE

Section 3. What are not inventions.-

The following are not inventions within the meaning of this Act, -

(a) an invention which is frivolous or which claims anything obviously contrary to well established natural laws;

(b) an invention the primary or intended use or commercial exploitation of which could be contrary public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment;

(c) the mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substances occurring in nature;

(d) the mere discovery of a new form of a substance which does not result in the enhancement of a known efficacy of that substance or the mere discovery of a new property or new use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

Explanation: For the purpose of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy

(d) a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;

(e) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;

(f) Omitted.

(g) a method of agriculture or horticulture;

(h) any process for the medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products.
(j) plants and animals in whole or any part thereof other than micro-
organisms but including seeds, varieties and species and essentially
biological processes for production or propagation of plants and
animals;

(k) a mathematical or business method or a computer program per se or
algorithms;

(l) a literary, dramatic, musical or artistic work or any other aesthetic
creation whatsoever including cinematographic works and television
productions;

(m) a mere scheme or rule or method of performing mental act or method of
playing a game;

(n) a presentation of information;

(o) topography of integrated circuits;

(p) an invention which in effect, is traditional knowledge or which is an
aggregation or duplication of known properties or traditionally known
component or components.

4.1 The section “Inventions - non-patentable” describes certain products and
processes, which are not to be regarded as patentable inventions as per the
Act. These statutory exclusions are illustrated in the following paragraphs.

3(a) “An invention which is frivolous or which claims anything obviously
contrary to well

4.2 Some examples of a frivolous nature and contrary to natural laws are:-

a. A machine purporting to produce perpetual motion.

b. A machine alleged to be giving output without any input.

c. “A method of showing time on the basis of metric system” wherein dial
of time piece having three hands for indicating, hour, minutes and
seconds was divided into 10 parts for hours, each hour into 100 minutes
and each minute into 100 seconds. The invention was held frivolous and
not considered a patentable invention. (Indian patent application No.
101/Bom/72).

d. Merely making in one piece, articles previously made in two or more
pieces is frivolous. Mere usefulness is not sufficient [Indian Vacuum
Brake’ Company Ltd v. Laurd (AIR 1962, Cal 152)].

e. A machine allegedly giving 100% performance.
3(b) “An invention the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment.”

4.3 Some examples are:

(i) An invention, the use of which is contrary to the law which is in force, or use of which is prohibited such as,

a. Any device, apparatus or machine or method for committing theft/burglary,
b. Any machine or method for counterfeiting of currency notes,
c. Any device or method for gambling,
d. An invention the use of which can cause injury to human beings, plants and animals.

(ii) Inventions, the established or intended use or commercial exploitation of which is found to be injurious to public, animal or plant life or health, such as, a method of adulteration of food.

(iii) An invention, the present or intended use of which is likely to violate the well accepted and settled social, cultural, legal norms of morality, e.g. method of cloning

(iv) An invention, the primary or proposed use of which would disturb the public order e.g. a device for house-breaking.

(v) Terminator gene technology

3(c) “The mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substances occurring in nature”

4.4.1 There is a difference between discovery and invention. A discovery adds to the amount of human knowledge by disclosing something already existent, which has not been seen before, whereas an invention adds to the human knowledge by creating a new product or processes involving a technical advance as compared to the existing knowledge.

4.4.2 A claim for discovery of scientific principle is not considered patentable, but such a principle when used with process of manufacture resulting into a substance or an article may be patentable.

4.4.3 A scientific theory is a statement about the natural world. These theories themselves are not considered patentable, no matter how radical or revolutionary an insight they may provide, since they do not result in a product or process. However, if the theories lead to practical application in the process of manufacture of article or substance, they may well be patentable. A claim for formulation of abstract theory is not patentable. For example, the fact that
known material or article is found to have a hitherto unknown property is a discovery and not an invention. But if the discovery leads to the conclusion that the material can be used for making a particular article or in a particular process, then the article or process could be patentable.

4.4.4 Finding out that a particular known material is able to withstand mechanical shock is a discovery and therefore not patentable, but a claim to a railway sleeper made of the material would not fall foul of this exclusion, and would be allowable if it passed the tests for novelty and inventive step. Similarly, finding of a new substance or micro-organism occurring freely in nature is a discovery and not an invention e.g. in Kirin-Amgen v. Hoechst Marion Roussel [2005] RPC 9.

4.4.5 A claim as relating to a method of analyzing samples which were subject to chromatographic and spectrometric analysis techniques such that a multivariate statistical analysis technique was employed to make it easier to identify time locations where the characteristics of samples were different. The contribution was identified as being “A method for comparing two samples by an analytical technique which uses chromatography and then spectrometry, followed by a particular sequence of data analysis techniques, to give results which enable the retention time at which the samples differ to be identified.” [Waters Investments Limited’s Application (BL O/146/07)]. It was held that the contribution lay in technical field of sample analysis using chromatography and spectrometric techniques and hence the invention was patentable.

3(d) **The mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.**

*Explanation:* For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy.

4.5.1 Mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance is not patentable. According to the proviso to this sub-section, a known substance in its new form such as amorphous to crystalline or crystalline to amorphous or hygroscopic to dried, one isomer to other isomer, metabolite, complex, combination of plurality of forms, salts, hydrates, polymorphs, esters, ethers, or in new particle size, shall be considered same as of known substances unless such new forms significantly differ in the properties with regard to efficacy.

4.5.2 In order to be patentable, any salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance, they must differ
significantly in the properties with regard to efficacy. The requirement here
that namely the new form must result in enhancement of known efficacy of
known substance and that in order to be distinct from the known substance,
the new form must differ in the properties with regard to efficacy.

4.5.3 The examiner makes comparison with regard to properties or enhancement of
efficacy between the known substance and the new form of known substance.
In case the new form is further converted into another new form, the
comparison is made between the already existing form and another new form
but not between the base compound and another new form.

4.5.4 The comparison with regard to properties or enhancement of efficacy is
required to be made at the time of date of filing of the application or priority
date if the application is claiming the priority of any earlier application but not
at the stage of subsequent development.

4.5.5 The efficacy need not be quantified in terms of numerical value to determine
whether the product is efficacious because it is not possible to have a standard
numerical value for efficacy for all products including pharmaceutical
products.

4.5.6 In regard to ‘efficacy’ in pharmaceutical products, the Madras High Court
observed: “going by the meaning for the word “efficacy” and “therapeutic” ...
..., what the patent applicant is expected to show is, how effective the new
discovery made would be in healing a disease/ having a good effect on the
body? In other words, the patent applicant is definitely aware as to what is
the “therapeutic effect” of the drug for which he had already got a patent and
what is the difference between the therapeutic effect of the patented drug and
the drug in respect of which patent is asked for.”

“Due to the advanced technology in all fields of science, it is possible to show
by giving necessary comparative details based on such science that the
discovery of a new form of a known substance had resulted in the
enhancement of the known efficacy of the original substance and the
derivatives so derived will not be the same substance, since the properties of
the derivatives differ significantly with regard to efficacy.” (Novartis AG v.
Union of India W.P. 24760/06).

4.5.7 Some of the examples of new forms are given below without limiting the scope
of the application of the provisions of the Act.

(i) Isomers: Isomers are different compounds that have the same molecular
formula which may be broadly divided into two kinds, namely,

- structural isomers or positional isomers and,
- stereo isomers.

Structural isomers or positional isomers may be structurally similar or
dissimilar compounds. The simplest examples are butane and
isobutane and ethanol and dimethyl ether. In the former case the
compounds are having structural and functional similarity.
However, in the second set of compounds, although they have the same molecular formula but are structurally and functionally different. Such isomers even having close similarity may be considered to be novel over the prior art. Isomers having the same empirical formula but having structural differences may be considered novel and may not normally offend “obviousness” as they are structurally different.

Example:
Cyclohexyl styrene is not considered prima facie obvious over prior art isohexyl styrene.

(ii) Stereo Isomers: - Stereo isomers are prima facie obvious.

Once a compound having a chiral center is known, its enantiomers are obvious because a person skilled in the art knows that a compound having a chiral center exists in two optically active forms. Hence, a product patent may not be granted for the enantiomer form. However, when a new compound is claimed having chiral center(s) for the first time, such a new compound may be patentable.

In a case where an (S)-enantiomer of a compound, capable of exhibiting better efficacy over the (R)-enantiomer, for instance producing enhanced anti-diabetic effects is claimed, wherein the said claim is not allowable when the same chemical compound possessing anti-diabetic property is known from the prior art.

(iii) Homologues: Homologues normally display add-on property. They are structurally similar and provide the example of Structure – Function linearity and may lack inventive step. However the cases are to be decided on case to case basis.

E.g. Polymerization process using a sterically hindered amine was held non-obvious over a similar prior art process because the prior art disclosed a large number of unhindered amines.

Further, prior art structures do not have to be true homologs or isomers to render structurally similar compounds prima facie obvious.

E.g. Claims and Prior art were for heterocyclic carbamoyloxmino compounds having pesticidal activity. The only structural difference was that the ring structures of the claimed compounds had two carbon atoms between two sulphur atoms whereas the prior art ring structures had either one or three carbon atoms between two sulphur atoms. The court held that although the prior art compounds were not true homologs or isomers of the claimed compounds, the similarity between the chemical structures and properties is sufficiently close that one of ordinary skill in the art
would have been motivated to make the claimed compounds in searching for new pesticides.

(iv) **Polymorphs:** Some compounds are present in polymorphic forms, i.e., they crystallize in diverse forms. Such forms can be deemed within the prior art and therefore not patentable. However, process patent may be allowed for the new polymorph, if the polymorph is prepared by novel process involving inventive step. Some therapeutically active ingredients, present in polymorphic forms, may have different properties that are more or less significant in terms of their therapeutic use. Such forms can be deemed within the prior art, and therefore, non-patentable if they were inevitably obtained following the process of the basic patent on the active ingredient or if they were covered by a previous product patent.

(v) **Metabolites:** Metabolites are the compounds that are formed inside a living body during metabolic reaction. The types of metabolites are:

(i) Active metabolites formed from inactive precursors (e.g. DOPA & Cyclophosphamide)

(ii) Active metabolites formed from precursors that show mechanism of action that is different from that of parent compound (e.g. Buspirone & 1-pyrimidyl piperzine Fenflouromine & norfenfleuromine)

(iii) Active metabolites which contribute to the duration of action of the parent compound (e.g. Hexamethylmelamine & Clobazam)

(iv) Active metabolites that show antagonistic effect on the activity of the parent compound (e.g. Trezodone & m-chlorophenyl pierzine, Aspirin & salicylate)

A metabolite is not patentable since giving the drug to a patient naturally and inevitably results in formation of that metabolite.

(vi) **Prodrugs:** Prodrugs are inactive compounds that can produce an active ingredient when metabolized in the body. Hence prodrugs and metabolites are interlinked. When metabolyzed in the body, inactive compounds(pro-drug) can produce a therapeutically active ingredient. It must be determined whether the patent on the compound covers the prodrug and the extent to which claims relating to certain compounds should also be allowed to include their prodrugs. The inventive aspects of a prodrug may be decided based on the merits of the case.

(vii) **Hydrates and other Substances:**

Hydrates, acid addition salts and other derivatives, which are routinely prepared, prima facie lack an inventive step. However, where there is a problem like stability, absorption etc., and there is
a long standing problem in preparing the derivatives, patentability of such process may be considered.

(viii) Purification Compounds

Mere purification of known material is not patentable as they are considered the purified compound. However, the purification process or the purified compound which never existed before due to inherent long standing problem can be considered patentable.

4.5.8 Mere discovery of new property of a known substance

A mere discovery of a new property of known substance is not considered patentable. For instance, the paracetamol has antipyretic property. Further discovery of new property of paracetamol as analgesic can not be patented. Similarly, ethyl alcohol is used as solvent but further discovery of its new property as anti knocking, thereby making it usable as fuel, can not be considered patentable.

4.5.9 Mere discovery of any new use of known substance

A mere discovery of new property of known substance is not considered patentable. For instance, new use of Aspirin for treatment of the cardiovascular disease, which was earlier used for analgesic purpose, is not patentable. However, a new and alternative process for preparing Aspirin is patentable. Similarly, the new use of methyl alcohol as antifreeze in automobiles. The use of methanol as a solvent is known in the prior art. A new use has been claimed in this claim as antifreeze which is not allowable. Further, a new use of Chloroquine for Sarcoidosis (a fungal disease) and for Infectious mononucleosis (a viral disease) and for Diabetic neuritis (inflammation of nerves) is not patentable.

4.5.10 The mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant:- Mere use of a known process is not patentable unless such known process results in a new product or employs at least one new reactant. Similarly mere use of known apparatus or machine for another purpose is also not considered patentable.

4.5.11 In 101/Bom/72 "Metric time showing device" was held not patentable. The device comprised a normal clock or watch having usual hands for indicating hours, minutes and seconds; wherein dial or like visual numerical indicators were divided into 10 large divisions for hours, hours divisions are divided into 100 divisions indicating minutes and each minute is divided into 100 parts representing seconds. It was held to be a mere use of known device and hence, not patentable.

4.5.12 In a claim relating to a food-packing machine used for packing the desired amount of talcum powder, since it did not characterize any changes in the food-packing machine, it was presumed that the same machine had been used for the purpose of packing talcum powder. Therefore, it was understood from
the claim that the same packing machine, which was in vogue, was used for packing the material other than food. Hence this was not allowed.

4.5.13 In a patent application No. 782/Cal/1981, dated 13th July, 1981, an invention related to pharmaceutical composition exhibiting anti-phlogistic, antipyretic and analgesic activity and high gastroenteric tolerance in unit doses form which contained imidazol salicylate as the active ingredient in the amount of 100-600 mg and an inert carrier was claimed which was later amended to a process for the preparation of novel composition containing imidazole salicylate having formula 1, as the active principle. The invention was characterized in a product that was previously obtained by reacting, mole by mole, acetylsalicylic acid with imidazole in an inert organic solvent and that, using the solid product obtained in the reaction after purification by recrystallization, homogenous composition were produced with pharmaceutically acceptable vehicles suitable for oral, parental or topical administration. It was held by the Controller that the active compound such as imidazole salicylate was known in the art and applicant could not develop any special property or even improve upon the property of the compound to be mixed up with the usual carrier to form the composition. Furthermore, the description contained no indication of using any special type of solvent for its purification by re-crystallization and, therefore, the invention was not patentable under section 3(d) of the Act. (Decisions on Patent and Designs vol. (4) published by Patent Office Technical Society, page 21).

4.5.14 In the application for patent No. 134883, dated 8th March, 1972, a method of control of post-embryonic development stages of coleoptera and Diptera inhabiting in the soil was claimed. The invention was characterized by applying to the particular soil a toxic amount of a compound selected from the group consisting of o,o-diethyl S-(tert butylthio) methyl phosphorodithoate and o,o-diethyl S-[(1,,1-dimethypropyl)thio]methyl phosphorodithicate. It was amended to a method for preparing a long effective pastical preparation useful in the control of the postembryonic stages of coleoptera and diptera inhabiting the soil having long residual pesticidal activity and unobjectionable odour which comprised treating sorptive or non-sorptive granular particles of a material like di-atomite or silica with 5% to 25% of o,o-diethyl 3-(tert-butylthio) methyl phospho-rodithicate and when preferred (a) applying a super coating of an inert material like clay or talc on the treated granular non-sorptive material or (b) applying a deactivator to the surface of the sorptive material before treating with the said phosphorodithicate, using one or more conventional solvents. It was held by the Controller that materials and solvent specified in the claim were conventional and customary application well known in the pesticidal art. Further, the method for preparation of formulation was conventional and gave a pesticidally active compound, which every person skilled in the pesticidal art would make as a formulation by applying active compound by conventional method to the conventional applicators for using the pesticidal active compound. Accordingly, a method of making a formulation by applying a conventional method a pesticidal compound to a conventional applicator was only steps in the use of compound or substance for treating the patient. Therefore invention fall within section 3(d) as the mere non substance or non compound.
4.5.15 In the case of M/s. Astra Aktiebolag [Patent Application No. 1354/del/1998], the Controller in his decision dated 12th June, 2007, held that the claimed invention is not patentable under section 3(d) of the Patent Act 1970, as “present pharmaceutical formulation is a selection from the prior art formulation due to the specific selection of HPMC of cloud point above 45.6°C having similar medicinal use and with the same therapeutic efficacy… the benefit claimed by the applicant in the present application is not accruable to the user in terms of therapeutic quality of the product but to the manufacturer only in terms of consistency in the production of formulation…”.

4.5.16 Patent application No. 1577/Del/1996 was refused, *inter alia*, under the provisions of section 3(d) of the Patents Act, 1970. The Controller in his decision dated 12th June, 2007 held that “the present invention provides a new form of known substance either in anhydrous or hydrated form III of Atorvastatine having same therapeutic activity and in the same field. It only claims some improvement in physical property, which does not make any change in therapeutic efficacy of the compound as compared to the prior art compound. Therefore this new form does not qualify the requirement under section 3(d).”

3(e) *A substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;*

4.6.1 In the patent application No. 782/Cal/1981, dated 13th July, 1981 referred to in para 4.5.13, it was held by the Controller that the pharmaceutical vehicle having the primary intended function of acting as vehicle or carrier or diluent performed the very function when incorporated in the composition. There was no explicit disclosure or experimental data to indicate that the presence of the carrier in any way influenced the antiphlogistic, antipyretic and analgesic activity of the active ingredients. Therefore, the invention was held not allowable under Section 3(e) of the Act as well as and merely an admixture.

4.6.2 A mixture of sugar and some colourants in water to produce a soft drink is a mere admixture resulting into aggregation of the properties. Similarly, a mixture of different types of medicament or medicine to cure multiple diseases is also a mere admixture of substances and is not a patentable invention.

4.6.3 However, an admixture resulting into synergistic properties of a mixture is not considered as mere admixture, e.g., soap, detergent, lubricants and polymer composition etc.

4.6.4 A process for producing a substance by admixing, which is resulting into the aggregation of the properties of the components thereof, is also not patentable invention.

4.6.5 In assessing the inventive step involved in an invention based on a combination of features, consideration must be given to whether or not the state of the art was such as to suggest to a skilled person precisely the combination of features claimed. The fact that an individual feature or a number of features were known does not conclusively show the obviousness of a combination.
4.6.6 A mere aggregation of features must be distinguished from a combination invention. The existence of a combination invention requires that the relationship between the features or groups of features be one of functional reciprocity or that they show a combinative effect beyond the sum of their individual effects. The features should be functionally linked together which was the actual characteristic of a combination invention.

4.6.7 A composition of two drugs, i.e. Paracetamol and Ibuprofen for curing fever and pain or process of preparation thereof is not patentable for the reason that the composition is a mere admixture of two drug components resulting into aggregation of properties thereof; since Paracetamol is well known for treatment of fever and Ibuprofen for treatment of pain. However, if the mixture of drugs exhibits some unexpected results or synergistic properties in their action, then such composition is considered as patentable subject matter.

4.6.8 In general all the substances which are produced by mere admixing, or a process of producing such substances should satisfy the requirements of synergistic effect in order to be patentable. The synergistic effect should be clearly brought out in the description and examples by way of comparison at the time of filing of the application and should be stressed in the principal claim.

4.6.9 In the matter of an application for Patent No. 63/Bom/75 (Decisions on Patents and Designs, vol.1, published by The Patent Office Technical Society p.17), Hindustan Lever Limited, applied for patent for an invention relating to an antiperspirant composition. It was held by the Controller that an admixture having only the aggregation of the individual properties of the components thereof is not an invention within the meaning of the Act and is thus not patentable. A process for producing such an admixture is also not patentable. In case the presence of one or more components of the composition influence the properties of the other components of the composition with the result that the ultimate properties of the composition would be different from the aggregation of the individual properties of the components thereof, such an admixture would be patentable under the Patents Act, 1970.[Page 26, point 10]

4.6.10 In the patent No. 143270 for the invention entitled "A fertiliser composition", it was held that alleged invention falls within sub-section(e) of Section 3 of the Act and the opponent had established the fourth ground of opposition, i.e. "not an invention or not patentable as the crop nutrient properties of the constituents like zinc sulphate, manganese sulphate, copper sulphate and magnesium sulphate were known as seen from know-how report and the steps of grinding, mixing and homogenizing were conventionally used in manufacture of the fertiliser.

3(f) The mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way.

4.7.1. It was observed in Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries [1978] Insc 255 (13th December, 1978) that it is important to bear in mind that in order to be patentable an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy the test of
invention or an 'inventive step'. To be patentable the improvement or the combination must produce a new result, or a new article or a better or cheaper article than before. The combination of old known integers may be so combined that by their working inter relation they produce a new process or improved result. Mere collocation of more than one integers or things, not involving the exercise of any inventive faculty, does not qualify for the grant of a patent.

4.7.2 It was observed in *Lallubhai Chakubhai v. Chimanlal and Co.* (AIR 1936 Bom 99): A new and useful application of an old principle may be good subject-matter. An improvement on something known may also afford subject-matter; so also a different combination of matters already known. A patentable combination is one in which the component elements are so combined as to produce a new result or arrive at an old result in a better or more expeditious or more economical manner. If the result produced by the combination is either a new article or a better or cheaper article than before, the combination may afford subject-matter of a patent.

4.7.3 In the application for patent No. 228/Del/77 for an invention relating to a compact device for measuring the settlement characteristic of buildings and the like civil engineering structure comprising a set of base plates to be fixed at desired parts of the buildings having mounted thereon, a water level, a tilt meter and means to measure crack-width developing in structure over a desired interval were claimed. It was held by the Controller that the compact device comprising a water level, tilt meter and crack-width meter measuring means, all three well known in the art prior to this application and working independently of one another in a known manner with no modifications in their functioning.

4.7.4 A mere juxtaposition of known devices in which each device functions independently is not considered patentable. It is accepted as sound law that mere placing side-by-side old integers so that each performs its own function independently of the others is not a patentable combination (*British Celanese Ltd. v. Courtaulds Ltd* (52) RFC 171), e.g. a floor mill provided with sieving means. However, where the old integers when placed together have some working interrelation, producing a new or improved results, then there is a patentable subject matter in the working interrelation brought about by the collection of the integers.

4.7.5 A mere juxtaposition of features, already known before the priority date, which have been chosen arbitrarily from amongst a number of a different combinations, which could be chosen, is not a patentable invention.

4.7.6 Further, when two or more features of an apparatus or device are known, and they are juxtaposed without any inter dependence on their functioning of the apparatus or device, they should be held to have been already known (*Rampratap v. Bhabha Atomic Research Center*, 1976 IPLR 28 P. 35)], e.g., an umbrella with fan(388/Bom/73), Bucket fitted with torch, Clock and transistor in a single cabinet. These are not patentable subject matter, since they are nothing but mere arrangement and rearrangement of items without having any working interrelationship between them and functioning independently of each other.
4.7.7 Another example is of a play-cum-educational device (1532/Cal/76). The device comprises of a chart, a set of tokens for players and one or more dice. It was held not patentable under the provisions of this section since the chart, token and dice, all are working independently of each other and there is no interrelation between them.

4.7.8 In the case of the *Franz Zaver Huemer v. New Yesh Engineers*, (1996 PTC (16) 164 Del.) it was held that the plaintiff could not claim the to be an inventor of the patent device as the device is already being used in machines for several years in several countries especially in India vide para 9 to 16 of the affidavit, the defendant has set out several details of the machines already being manufactured for over one and a half decade leading to an inference that there was nothing new in the plaintiff's device. Arrangement or rearrangement of the already known device does not amount to an invention. As sufficient ground exists for revocation of the plaintiff's patent, the defendant has a very good defence to the plaintiff's suit.

4.7.9 In the case of *1985 (5) PTC 71 (Del)*, the application for grant of patent was in respect of apparatus for producing metallic bellows. During the opposition proceedings it was held that both hydraulic machine and roll forming machine were undoubtedly the separate machines functioning independently of other there being no novel feature stated by the applicant. Hence, the ground that there was no invention was accepted as the applicant was seeking the patent right on known types of hydraulic forming and roll forming machines which is not allowable.

4.7.10 In the matter of an application made by Figurette and Cosmetics Private Limited (Applicant) for application No. 388/Bom/73, dated 28th November, 1973 filed for an invention entitled “Improvements in or relating to umbrellas or Parasols and the like fitted with cooling devices” and the complete specification relates to umbrellas or parasols which provides ventilation and circulation of air in addition to providing protection to rain or sun, and the claims were mainly objected to “section 3(f) of The Patent Act, 1970. The principal claim read as “An umbrella, parasol and the like, comprising an electric motor having a fan propeller fitted on its shaft and housed at the top of the umbrella, parasol, arranged to blow air downwardly and an electric current supply means for the said electric motor”. The applicant argued that the interrelation between the two known devices is that the electric motor is mounted at the upper end of the central rod of the umbrella and that the electric motor cannot start functioning unless the umbrella is opened. The Controller held that it can be seen from the drawings accompanying the complete specification, the housing in which the electric motor is located is above the cloth covering the umbrella and thus would function irrespective of the fact whether the umbrella is in opened or closed condition. Moreover, simply mounting the electric motor at the central rod of the umbrella merely amounts to an inter-relation as regards to the placing of known devices and does not amount to an interrelation as regards to the functioning of the known devices…. …. , accordingly, I am of the opinion that both the known devices in the applicants invention namely the umbrella and the electric motor function independently of each other in their usual known way and as such there is no interrelation in their functioning and the invention falls within the purview of section 3(f) of Patent Act and thus not patentable.
4.7.11 A new combination may be the subject matter of a patent although every part of the combination, *per se*, is old for here the new article is not the parts themselves but the assembling and working of the parts, together. (*Lallubhai Chakkubhai v. Shamaldas Sankalchand Shah*, A.I.R 1934 Bom. 407).

4.7.12 The merit of a new combination very much depends upon the result produced. Where a slight alteration turns that which was practically useless into what is useful and important, it is fit subject matter for a patent ((*Lallubhai Chakkubhai v. Shamaldas Sankalchand Shah*, A.I.R 1934 Bom. 407).

4.7.13 In opposition to Patent No 139046 for invention "Safety Razor blade", it was held that as regards the opponents' allegation that 'the applicants' invention 'claiming anything obviously contrary to well established natural laws' that opponents had not discharged their onus to prove their allegation. However in this matter it was held that even though the applicants' invention might appear to be a new combination of known devices, but the application of the combination is clearly meant to achieve an useful purpose in a better and simple way, and therefore, the applicants' combination was not a mere arrangement or re-arrangement of the known devices acting independently of one another in a known way, and therefore, was a good subject matter for a patent.

4.7.14 The examiner may have to make detailed comparison of the features of prior art and the new invention to decide about the patentability of the improvements. In patent No. 144813 the application was for the invention “Apparatus for the utilization of high-pressure steam produced in a pressure vessel particularly in a domestic pressure cooker. One of the grounds of opposition was that the coffee attachment “Esteem” sold by M/s. S. Mangal Singh & Co., Meerut prior to 16th December, 1975 i.e. filing date had most of the features of the invention and, therefore the invention was in prior use. The Controller obtained that the applicants invention comprised in combination (i) a domestic pressure cooker having an additional vent provided and located on the lid of the said cooker; (ii) said vent having a screw threaded or slotted outlet in seal-tight engagement with said vent; (iii) control means for controlling the supply of high pressure steam; (iv) a conduit pipe; (v) one end of said conduit pipe being in connected in seal tight engagement with said screw threaded or slotted outlet for conveying the high pressure steam and supply means connected to the other end of said conduit pipe. He further observed that the coffee attachment ‘Esteem’ was press fitted on the hole or vent in the centre of the lid of a pressure cooker by removing the weight valve and its supporting unit whereas in applicant’s invention additional vent was provided in the lid and the whole construction of the applicant’s apparatus was different. In the “Esteem” the weight valve was fitted on the top of the attachment to build up the pressure in the pressure cooker whereas in the applicant’s invention weight valve remains at its own place. According be concluded that the coffee attachment ‘Esteem’ sold by M/s. S. Mangal Singh & Co., Meerut prior to the 16th December, 1975 was not the same as claimed by the applicant in his complete specification. Therefore, the question of prior use of applicant’s invention does not arise.
3(h) A method of agriculture or horticulture.

4.8.1 A method of producing a new form of a known plant, even if it involved a modification of the conditions under which natural phenomena would pursue their inevitable course, is not patentable. (N.V. Philips Gloeiammpenfabrieken's Application 71 RFC 192).

4.8.2 A method of producing improved soil from the soil with nematodes by treating the soil with a preparation containing specified phosphorathioates was held not patentable (Virginia Carolina Chemical Corporation application 1958 RFC 38).

4.8.3 A method of producing mushroom plant (64/Cal/79) and a method for cultivation of an algae (445/Del/93) were held not patentable.

3(i) Any process for the medicinal, surgical, curative, prophylactic, diagnostic therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products.

4.9.1 A method of treatment of malignant tumour cells and method of removal of dental plaque and caries are not patentable, since they are held as treatment of human beings. Also, treatment of sheep for increasing wool yield (1958 RPC 85) was held as not patentable.

4.9.2 An invention of a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body shall not be taken to be capable of industrial application.

4.9.3 The art of curing illness cannot be said to be patentable.

4.9.4 The term “therapy” includes prevention as well as treatment or cure of disease. Therefore, the process relating to therapy is also not patentable as held in Unilever Limited (Davis') Application, [1983] RPC 219. Although some medical dictionaries pointed towards a narrow interpretation of the term, other works of reference, including non-specialist dictionaries, indicated a more general meaning; this was preferred in this case, following the principle that words in statutes dealing with matters relating to the general public are presumed to be used in their popular, rather than their narrowly legal or technical, sense. However, for a treatment to constitute therapy, there must be a direct link between the treatment and disease state being cured, prevented or alleviated, (BL O/248/04). It appears that any medical treatment of a disease, ailment, injury or disability, i.e., anything that is wrong with a patient and for which he would consult a doctor, as well as prophylactic treatments such as vaccination and inoculation, is to be regarded as therapy. The same considerations apply for animals as for human patients, so that for example prophylaxis and immunotherapy in animals are regarded as therapy[T 24/91]

4.9.5 Prophylactic treatment, aimed at maintaining health by preventing ill effects that would otherwise arise, amounts to a method for treatment by therapy. Both
prophylactic and curative methods of treating disease are covered by the word therapy, since both are directed to the maintenance or restoration of health. The same consideration applies for animals as well as for human beings. For example, prophylactic immuno-therapy in animals are regarded as therapy.

4.9.6 An application of substance to human body purely for cosmetic purposes is not a treatment or therapy. On the other hand, the application to the skin of an ointment designed to be effective to remove keratoges from the skin would be the instance of medical treatment. Here, “Treatment” in relevant senses means that the purpose of application of a process or substance to the body must be to arrest or cure of a disease or diseased condition or correcting some malfunction or amelioration of some incapacity or disability (Joos v. Commissioner of Patent (1973) RPC 59).

4.9.7 Application of substances to the body for purely cosmetic purposes is not therapy. In allowing claims to a process for improving the strength and elasticity of human hair and finger nails, the High Court of Australia observed that, while a process for the treatment of the human body as a means of curing or preventing a disease or other disorder was not patentable, those who apply chemical preparations to the skin to prevent sunburn in climates which enjoy sunshine and moderate air temperatures can scarcely be regarded either as, in a relevant sense, treating their bodies or as undergoing treatment. On the other hand, the application to the skin of an ointment designed and effective to remove keratoges from the skin would be an instance of medical treatment. To be treatment in the relevant sense, it seems to me that the purpose of the application to the body whether of a substance or a process must be the arrest or cure of a disease or diseased condition or the correction of some malfunction or the amelioration of some incapacity or disability (Joos v. Commissioner of Patents, [1973] RPC 59).

4.9.8 It was held in Lee Pharmaceuticals application [(1978) RPC 51] that, since one of the reasons of grinding pits and fissures in teeth was to prevent the onset of dental decay, the purpose of the treatment was therapeutic rather than cosmetic.

4.9.9 Patent may however be obtained for surgical, therapeutic or diagnostic instrument or apparatus. Also the manufacture of prostheses or artificial limbs and taking measurements therefor on the human body are patentable.

4.9.10 In Oral Health Products Inc (Halstead's) Application, [1977] RPC 612, claims to a method of removing dental plaque and/or caries were refused as was a claim to a method of cleaning teeth which embraced both curative and cosmetic effects. This decision has been followed under the 1977 Act in ICI Ltd's Application No 7827383 (BL O/73/82), where a claim was refused to a method of cleaning teeth which removed both plaque and stains. It was argued that when applied to perfectly healthy teeth the method was purely cosmetic, but the hearing officer observed that practically all medical treatments which are preventative in nature (such as vaccination) must at times be applied to people who would have remained healthy anyway, but they remained medical treatments
4.9.11 In T 290/86 the Board held that the use of a lanthanum-containing composition for cleaning plaque and/or stains from human teeth...will always inevitably have a therapeutic effect (at least in the prophylactic sense) as well as a cosmetic effect. Thus the invention as here claimed is not directed solely to a cosmetic effect, but is also necessarily defining a treatment of the human body by therapy and hence excluded from patentability.

4.9.12 Methods of treatment of the human or animal body by surgery are excluded. ‘Surgery’ is defined as the treatment of disease or injury by operation or manipulation. It is not limited to cutting the body but includes manipulation such as the setting of broken bones or relocating dislocated joints (sometimes called "closed surgery"), and also dental surgery. In general, any operation on the body, which required the skill and knowledge of a surgeon, would be regarded as surgery and includes non-curative treatments such as cosmetic treatment, the termination of pregnancy, castration, sterilization, artificial insemination, embryo transplants, treatments for experimental and research purposes and the removal of organs, skin or bone marrow from a living donor are, if carried out by surgery, regarded as surgical treatments. Once it has been decided that a method constitutes surgery, therapy or diagnosis practised on the human or animal body, it is necessarily non-patentable. For example, methods of abortion, induction of labour, control of oestrus or menstrual regulation are always therapy, irrespective of the reason for the treatment.

4.9.13 In Unilever Limited (Davis1) Application, [1983] RPC 219, it was observed that any method of surgical treatment, whether curative, prophylactic or cosmetic, is not patentable. This view was upheld in another case also, while refusing to allow claims to a method of implanting an embryo transplant from a donor mammal into the uterus of a recipient mammal, since the method would necessarily have to be carried out by a surgeon or veterinary surgeon.

4.9.14 Methods of diagnosis practised on the human or animal body are excluded. Methods of diagnosis performed on tissues or fluids, which have been permanently removed from the body are, therefore, not excluded from patentability.

4.9.15 Diagnosis is the identification of the nature of a medical illness, usually by investigating its history and symptoms and by applying tests. Determination of the general physical state of an individual (e.g. a fitness test) is not considered to be diagnostic if it is not intended to identify or uncover a pathology. Section relates to methods of diagnosis practised on the human or animal body; diagnosis in itself is a method of performing a mental act and is excluded from patentability. Typically, the process of diagnosis involves a number of steps leading towards identification of a condition. For a claim to fall under this prohibition, it must include both the deductive step of making the diagnosis and preceding steps constructive for making that diagnosis involving specific interactions of a technical nature with the human or animal body. The exclusion is therefore a narrow one, and also requires all the method steps of a technical nature to be practised on the body. In determining whether or not a method is a diagnostic, the Board held that it is irrelevant whether it is necessary for a medical or veterinary
practitioner to be involved. Furthermore, a method is “practised on the human or animal body” if it involves any interaction which necessitates the presence of the patient, so will include both invasive and non-invasive methods. Methods of diagnosis performed on tissues or fluids which have been permanently removed from the body are not excluded. "Body" should be taken to mean living body, and a method practised on a dead body, for example in order to determine the cause of death, would not be exclude.

4.9.16 Methods of therapy carried out on materials temporarily removed from the body, for example, when blood is circulated through an apparatus while remaining in living communication with the body, are not patentable (cf Calmic Engineering Co Ltd's Application, [1973] RPC 684).

4.9.17 In Ciba-Geigy AG's Application, (BL 0/30/85) the objection was raised to certain claims for a method of controlling parasitic helminthes (worms which may develop in the animal body, for example, in the intestinal tract of animals such as sheep) by the use of a particular (novel and inventive) antihelmintic composition. The applicants contended that the composition when administered to an animal would prevent the reproduction of the helminthes and kill them should they infest the animal, but without affecting the animal's body, and that its use was therefore not "therapy". However, the applicants' specification made it clear that an infestation of helminthes worms can result in restricted growth, damage to the animals and even death, if not properly treated. Moreover, the application made no mention of controlling helminthes by the use of the composition in any environment other than the animal body. The hearing officer considered that such an infestation was therefore a disease requiring medical treatment of the animal and that such treatment, whether curative or preventative, constituted therapy practiced on the animal body and consequently held that the claims in question were not allowable.

4.9.18 In the case of M/s. AGA Medical Corporation, USA [Patent Application No.1283/DEL/2004], the Controller held that “The purpose of the invention is to provide a method for determining the nominal or stretched diameter of an internal opening or defect within a patient and particularly determining the stretched diameter of a septal defect within the heart of a patient is inseparably connected with the method of treatment” and, therefore, it is not patentable under section 3(i) of the Patent Act 1970.

4.9.19 In an application No. 1377/Del/1999 the claimed invention was related to a method for in vitro production of isolated langerhans islets endocrine cells free from fibroblasts so as to be suitable for transplantation. The process discloses the steps of culturing and proliferating the cells and back and forth aspiration to separate fibroblast from the cells, which will be capable of differentiating into insulin producing cells. The applicant argued that (1)the process is novel and has utility as fibroblast free langerhans islets are useful in the enhanced production of insulin, to control diabetes,(2) Calcutta High Court has already allowed patenting of a substance containing living organisms, and(3)Indian Patent law does not bar the grant patent for such invention. However the Controller refused the application under section 15 on the grounds that the
invention claimed is not patentable under section 3(i) as a method of treatment of human being, since langerhans islets are freshly taken from the body of patient in order to treat them to remove fibroblast so as to increase secretion of insulin. The end product of the process is nothing but a cluster of cells or piece of tissues of human body. The principles laid down in Calcutta High Court are not applicable as the end product of the process of present invention is not commercial entity and cannot be passed on from one person to another upon the transaction of purchase or sale.

3(j) **Plants and animals in whole or any part thereof other than micro-organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals**

4.10.1 As per this sub-section, while plants and animals or any part of the plant or animal is not patentable, an exception is made in the case of micro-organisms. However, any discovered micro-organism from the nature is not patentable.

4.10.2 In *Dimminaco – A.G v. Controller of Patents & Designs and others* (AID No.1 of 2001) the issue involved was the patenting of the process for preparation of infectious bursitis vaccine, which is invented for protecting poultry against infectious bursitis. The Controller held that the process of separation of the vaccine which has living entity cannot be considered a manufacture and hence not patentable under section 2(1)(j) of the Patents Act. He also held that since the vaccine contains living organism it cannot be patented. The court held that the matter involved is of a *new* process of preparation of vaccine under specific scientific conditions and the said vaccine is *useful* for protecting poultry against contagious bursitis infection and there is no statutory bar to accept a manner of manufacture as a patentable even if the end products contain living organism.

4.10.3 Plant varieties are provided protection in India under the provisions of the Protection of Plant Varieties and Farmers’ Rights Act, 2002.

3(k) **A mathematical or business method or a computer programme *per se* or algorithms are not patentable.**

4.11.1 A computer implemented invention mean any invention the performance of which involves the use of computer, computer network or other programmable apparatus, or an invention one or more features which are realized wholly or partially by means of a computer programme/programmes.

4.11.2 Computer programmes are a set of instructions for controlling a sequence of operations of a data processing system. It closely resembles a mathematical method. It may be expressed in various forms e.g., a series of verbal statements, a flowchart, an algorithm, or other coded form and maybe presented in a form suitable for direct entry into a particular computer, or may require transcription into a different format (computer language). It may
merely be written on paper or recorded on some machine readable medium such as magnetic tape or disc or optically scanned record, or it maybe permanently recorded in a control store forming part of a computer.

4.11.3 If the patent application relates only to a machine i.e., hardware based invention, the best mode of operation may be described along with the suitable illustrations. However, in the case of a process related inventions, the necessary sequence of steps should clearly be described so as to distinguish the invention from the prior art with the help of the flowcharts. The source/pseudo/object codes may be incorporated in the description optionally.

4.11.4 In order to distinguish the invention from the prior art, relevant prior art is also required to be given in the specification. It is always essential to analyze the invention in the light of what is described and the prior art, in order to identify the contribution to the art and hence determine whether this advancement resides in, or necessarily includes, technological features and technical application or is solely intellectual in its content. A hardware implementation performing a novel function is not patentable if that particular hardware system is known or is obvious irrespective of the function performed.

4.11.5 Applications related to computer inventions may broadly fall under the following categories:

(a) Method/process:
(b) Apparatus/system:
(c) Computer program product.

The following aspects should be looked into while dealing with such applications.

4.11.6 The method claim should clearly define the steps involved in carrying out the invention. It should have a technical character. In other words, it should solve a technical problem. The claims should incorporate the details regarding the mode of the implementation of the invention via hardware or software, for better clarity. The claim orienting towards a “process/method” should contain a hardware or machine limitation. Technical applicability of the software claimed as a process or method claim, is required to be defined in relation with the particular hardware components. Thus, the “software per se” is differentiated from the software having its technical application in the industry. A claim directed to a technical process which process is carried out under the control of a programme (whether by means of hardware or software), cannot be regarded as relating to a computer programme as such. For example, “a method for processing seismic data, comprising the steps of collecting the time varying seismic detector output signals for a plurality of seismic sensors placed in a cable.” Here the signals are collected from a definite recited structure and hence allowable.

4.11.7 The apparatus claim should clearly define the inventive constructional hardware features. The claim for an apparatus should incorporate a “process
limitation” for an apparatus, where “limitation” means defining the specific application and not the general application. As a general rule, a novel solution to a problem relating to the internal operations of a computer, although comprising a program or subroutine, will necessarily involve technological features of the computer hardware or the manner in which it operates and hence may be patentable. For example, in a computer comprising means for storing signal data and a first resistor for storing data, the clause starting with “for” describes the function or process carried out by the apparatus, and form the part of “process limitation” here.

4.11.8 The claims relating to software programme product are nothing but computer programme per se simply expressed on a computer readable storage medium and as such are not allowable. For example, if the new feature comprises a set of instructions (programme) designed to control a known computer to cause it to perform desired operations, without special adoption or modification of its hardware or organization, then no matter whether claimed as “a computer arranged to operate etc” or as “a method of operating a computer”, etc., is not patentable and hence excluded from patentability. The claim might stipulate that the instructions were encoded in a particular way on a particular known medium but this would not affect the issue. e.g., A program to evaluate the value of PI or to find the square root of a number are held not allowable. An invention consisting of hardware along with software or computer program in order to perform the function of the hardware may be considered patentable. e.g., embedded systems.

4.11.10 A mathematical method is one which is carried out on numbers and provides a result in numerical form (the mathematical method or algorithm therefore being merely an abstract concept prescribing how to operate on the numbers) and not patentable. However, its application may well be patentable, for example, in Vicom/Computer-related invention [1987] 1 OJEPO 14 (T208/84) the invention concerned a mathematical method for manipulating data representing an image, leading to an enhanced digital image. Claims to a method of digitally filtering data performed on a conventional general purpose computer were rejected, since those claims were held to define an abstract concept not distinguished from a mathematical method. However, claims to a method of image processing which used the mathematical method to operate on numbers representing an image can be allowed. The reasoning was that the image processing performed was a technical (i.e. non-excluded) process which related to technical quality of the image and that a claim directed to a technical process in which the method used does not seek protection for the mathematical method as such. Therefore the allowable claims as such went beyond a mathematical method.

4.11.11 The patent application No.558/DELNP/2005 related to method of operating the credential management processor. This was refused as it was found to be attracting the provisions of section 3(k) as the alleged method was relating to ‘receiving’, ‘de-referencing’ and ‘storing’ being purely a computer implemented software application. As well as the enhancement of security as claimed in method claims was already disclosed in the cited document and is obvious to a person skilled in the art.
3(l) A literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions.

4.12.1 Writings, music, works of fine arts, paintings, sculptures, computer programmes, electronic databases, books, pamphlets, lectures, addresses, sermons, dramatic-musical works, choreographic works, cinematographic works, drawing, architecture, engraving, lithography, photographic works, applied art, illustrations, maps, plans, sketches, three-dimensional works relating to geography, topography, translations, adaptations, arrangements of music, multimedia productions, etc. are not patentable. Such works fall within the domain of the Copyright Act, 1957.

3(m) Schemes, rules and methods for performing mental acts, playing games.

4.13.1 Method of performing mental act or method of playing game or a mere scheme or rule are as such excluded from patentability, because they are considered as outcome of mere mental process.

a. Method of learning a language.
b. Method of playing chess.
c. Method of teaching.
d. Method of learning
e. Method of operating a machine or equipment as per the set of instructions

3(n) A presentation of information.

4.14.1 Any manner, means or method of expressing information whether visual, audible or tangible by words, codes, signals, symbols, diagrams or any other mode of representation is not patentable. For example, a speech instruction means in the form of printed text where horizontal underlining indicated stress and vertical separating lines divided the works into rhythmic groups is held not patentable.

4.14.2 In the matter of application No. 94/Cal/2002, the Controller held, that patent system was meant for protecting only one kind of creativity, i.e., technological creativity and since the claimed invention related to business method and method of presenting information, it was not allowed.

3(o) Topography of integrated circuits.

4.15.1 Since protection of Layout Designs of Integrated Circuits is governed separately under the Semiconductor Integrated Circuit Lay-out Designs Act, 2000, three-dimensional configuration of the electronic circuits used in microchips and semiconductor chips is not patentable.
3(p) An invention which in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components.

4.16.1 Traditional Knowledge, being knowledge already existing, is not patentable. An example is the anti septic property of turmeric for wound healing. Another example is the pesticidal and insecticidal properties of neem

4.17 Inventions Relating To Atomic Energy

Section 4: “No Patent shall be granted in respect of an invention relating to atomic energy falling within subsection (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962)”

4.17.1 No patent shall be granted for the invention which in the opinion of Central Government is useful for or related to the production, control, use or disposal of atomic energy or prospecting mining extraction, production, physical and chemical treatment fabrication, enrichment, canning or use of any prescribed substance or radioactive substance or the insuring of safety in atomic energy operation.

4.17.2 According to Section 20(1) of Atomic Energy Act, atomic energy means energy released from atomic nuclei as a result of any process including the fission and fusion processes. Under this Act, "prescribed substances" means any substance including any mineral which the Central Government may, by notification, prescribe, being a substance which in its opinion is or may be used for the production or use of atomic energy or research into matters connected therewith and includes uranium, plutonium, thorium, beryllium, deuterium or any of these respective derivative or compounds or any other materials containing any of the aforesaid substances. The Act defines the term "radioactive substances" or "radioactive material" as any substance or material, which spontaneously emits, radiation in excess of the levels prescribed by notification by the Central Government.

4.17.3 Prescribed Substances, Prescribed equipment and Technology ” have been notified by the Government of India, Department of Atomic Energy vide S.O.61(E), published in the Gazette of India (extraordinary, Part II, Section 3, sub-section (ii), dated 20th January, 2006. A copy of the Notification is presented below.

S.O. 61(E).- In pursuance of clauses (f) and (g) of sub-section (1) of Section 2 and Section 3 of the Atomic Energy Act, 1962 (No.33 of 1962) and in supersession of the notifications of the Government of India in the Department of Atomic Energy vide numbers S.O.211 (E) dated the 15th March, 1995 and S.O.212(E) dated the 15th March, 1995, the Central Government hereby notifies the substances, equipment and technology specified in the Schedule appended hereto as Prescribed Substances, Prescribed Equipment and Technology.
Category – 0: Nuclear materials, nuclear-related other materials, equipment and technology.

OA Prescribed substances

OA1 Source Material

OA101 Uranium containing the mixture of isotopes occurring in nature

OA102 Uranium depleted in the isotope 235.

OA103 Thorium

OA104 Any of the foregoing in the form of metal, alloy, chemical compound, or concentrate or any substance.

OA105 Any other material containing one or more of the foregoing.

Prescribed quantitative limits: as given below and in any period of 12 months:

a. Uranium (containing the mixture of isotopes in nature) exceeding 100 kilograms.

b. Depleted uranium (uranium depleted in the isotope 235 below that occurring in nature) exceeding 1000 kilograms.

c. Thorium exceeding 1000 kilograms.

OA2 Special Fissionable Material

OA201 Plutonium-239

OA202 Uranium-233

OA203 Uranium enriched in the isotopes 235 or 233

OA204 Neptunium.

OA205 Any material containing one or more of the foregoing

OA206 Such other fissionable material determined by the Central Government from time to time, but the term “special fissionable material” which does not include source material.

Note: Any quantity of special fissionable material is prescribed substance.
OA3  Other Materials.
‘Other Materials’ means non-nuclear materials for reactors, nuclear related dual-use materials indicate below and such materials as determined by the Central Government from time to time.

OA301  Deuterium, heavy water (deuterium oxide) and any other deuterium compound, in which the ratio of deuterium to hydrogen atoms exceeds 1:5000, in quantities exceeding 5 kilograms of deuterium in one consignment or 25 kilograms of deuterium in any period of 12 months.

OA302  Nuclear grade graphite / carbon, having a purity level better than 5 parts per million (ppm) boron equivalent and with a density greater than 1.5 gram/cc in quantities exceeding 30 metric tons in any period of 12 months.

OA303  Zirconium with hafnium content of less than 1 part to 500 parts of zirconium by weight (i.e. less than 2000 ppm) in the form of metal, its alloys, compounds, manufactures thereof, waste or scrap of any of the foregoing.

OA304  Beryllium, its compound, alloys and its minerals/concentrates including Beryl but excluding:
   a. beryllium windows used for x-ray machines and gamma rays detectors and
   b. beryl in the form of emeralds or aquamarines.

OA305  Lithium enriched in the Lithium-6 (6Li) isotope to greater than its natural isotope abundance (i.e. more than 7.5%) and the products or devices containing enriched lithium such as elemental lithium, alloys, compounds, mixtures containing lithium, manufactures thereof, waste or scrap of any of the foregoing.

OA306  Niobium and Tantalum, their metals, alloys and minerals including columbite and tantalite.

OA307  Titanium alloys having both of the following characteristics:
   a. ‘Capable of’ an ultimate tensile strength of 900 Mpa or more at 293 K (20º); and
   b. In the form of tubes or cylindrical solid forms (including forgings) with an outside diameter of more than 75 mm.

   Technical note: The phrase ‘capable of’ encompasses titanium alloys before or after heat treatment.

OA308  Tritium, tritium compounds or mixtures containing tritium in which the ratio of tritium to hydrogen atoms exceeds 1 part in 1000, except when utilized in such quantities and for such
purposes as for organic labeled compounds, Gas Filled Sources
and as Tritiated Water for radiotracer studies.

OA309  Hafnium:
Hafnium metal, alloys containing more than 60% hafnium by
weight, hafnium compounds containing more than 60% hafnium
by weight, manufacturers thereof, and waste or scrap of any of
the foregoing.

OA310  Radium-226:
Radium-226 (226Ra), radium-226 alloys, radium-226
compounds, mixtures containing radium-226, manufactures
thereof, and products or devices containing any of the foregoing,
except medical applicators and a product or device containing
less than 0.37 GBq (10mCi) of Ra-226 in any form.

OA311  Boron
Boron enriched in the Boron-10(10B) isotope to greater than its
natural isotopic abundance as follows:
Elemental boron, compounds, mixtures containing boron,
manufactures thereof, waste or scrap of any of the foregoing.

OA312  Helium-3
Helium-3 (³He), mixtures containing helium-3, and products or
devices containing any of the foregoing.

Note: A product or device containing less than 1 gm of Helium-3
is excluded.

OA313  Alpha-emitting radionuclides:

Alpha-emitting radionuclides having an alpha half-life of 10
days or greater but less than 200 years, in the following forms:
a. Elemental;
b. Compounds having a total alpha activity of 37 GBq per kg or
greater;
c. Mixtures having a total alpha activity of 37GBq per kg or
greater;
d. Products or devices containing any of the foregoing.

Alpha emitters controlled by this item include:
Actinium-225  Actinium-227  Americium-242m
Californium-248  Californium-250  Californium-252
Californium-253  Californium-254  Carium-240
Curium-241  Curium-242  Curium-243
Curium-244  Einsteinium-252  Einsteinium-253
Einsteinium-254  Einsteinium-255  Fermium-257
Gadolinium-148  Mendelevium-258  Neptunium-235
Plutonium-236  Plutonium-237  Plutonium-238
Plutonium-241  Polonium-209  Polonium-210
Polonium-208  Radium-223  Thorium-228
Thorium-227  Uranium-230  Uranium-232
OA314 *Titanium ores and concentrates (Ilmenite, Rutile and Leucoxene)

OA315 *Zirconium, its alloys and compounds and minerals/concentrates including zircon

*Note: These items (OA314 and OA315) shall remain prescribed substances only till such time the Policy on Exploitation of Beach Sand Minerals notified vide Resolution number 8/1(1)/97-PSU/1422 dated the 6th October, 1998 is adopted/revised/modified by the Ministry of Mines or till the 1st January 2007, whichever occurs earlier and shall cease to be so thereafter.

OB    Prescribed Equipment

OB001 Nuclear Reactors; associated equipment, components and systems specially designed, prepared, or adapted or used or intended to be used in such reactors as follows:

a. Complete nuclear reactors
b. Nuclear reactor vessels
c. Nuclear reactor fuel charging and discharging machines
d. Nuclear reactor control rods and equipment
e. Nuclear reactor pressure tubes
f. Zirconium tubes and assemblies of tubes in which hafnium to zirconium ratio is 1:500 or less
g. Primary coolant pumps
h. Nuclear reactor internals
i. Heat exchangers (steam generators) for use in the primary coolant circuit of a nuclear reactor
j. Neutron detection and measuring instruments for determining neutron flux levels within the core of a nuclear reactor

OB002 Plants for processing, production, concentration, conversion or recovery of Prescribed Substances (such as uranium, plutonium, thorium, deuterium, heavy water, tritium, lithium); associated equipment, components and system, specially designed, prepared or adapted or used or intended to be used in such plants including but not limited to:

a. Plants for production or concentration of deuterium, heavy water
   1. Water-Hydrogen Sulphide Exchange Towers
   2. Blowers and Compressors for hydrogen-sulphide gas circulation
   3. Ammonia-Hydrogen Exchange Towers greater than or equal to 35m in height with diameters of 1.5m to 2.5m
   4. Tower Internals and Stage Pumps
   5. Ammonia Crackers with operating pressures greater than or equal to 3 MPa
   6. Infrared Absorption Analyzers capable of ‘on-line’ hydrogen/deuterium ratio analysis
7. Catalytic Burners for conversion of enriched deuterium gas into heavy water
8. Complete heavy water upgrade systems or columns therefore

9.
   b. Plants for the conversion of uranium
   c. Plants for the conversion of plutonium
   d. Tritium facilities or plants, and equipments therefore
   e. Lithium isotope separation facilities of plants, and equipment therefore.

OB003 Plants for reprocessing of irradiated nuclear fuel and equipment, components and systems specially designed, prepared or adapted or used or intended to be used in such plants, including but not limited to:

   a. Irradiated fuel element chopping machines designed for remote operation
   b. Dissolvers capable of withstanding hot and highly corrosive for dissolution of irradiated nuclear fuel and which can be removed loaded and maintained.
   c. Solvent extractors and solvent extraction equipment resistant to the corrosive effect of nitric acid.
   d. Chemical holding or storage vessels resistant to the corrosive effect of nitric acid.
   e. Industrial equipment including assemblies and components as follows:

      1. High density (lead glass or other) radiation shielding windows
      2. Radiation hardened TV cameras, or lenses therefore
      3. ‘Robots’ or ‘end effectors’ specially designed for handling high explosives; and control units therefore
      4. Remote manipulators that can be used to provide remote actions in radiochemical separation operations or hot cells

OB004 Plants for treatment, handling, storage and transportation of radioactive wastes from nuclear reactors or from plants for processing Source Materials or Special Fissionable Material or from nuclear reprocessing plants; irradiated nuclear fuel; Special Fissionable Materials, and equipment specially designed, prepared, adapted, or intended to be used therefore.

OB005 All systems, associated equipment, components for separation or enrichment of isotopes of uranium, plutonium, lithium or boron, other than analytical instruments, specially designed, prepared, adapted, used or intended to be used therefor as follows:

   a. Gas centrifuges and assemblies and components specially designed or prepared for use in gas Centrifuges
   b. Specially designed or prepared auxiliary systems, equipment and components for gas centrifuge enrichment plants
c. Specially designed or prepared assemblies and components for use in gaseous diffusion enrichment

d. Specially designed or prepared auxiliary system, equipment and components for use in gaseous diffusion enrichment.

e. Specially designed or prepared systems, equipment and components for use in aerodynamic enrichment plants

f. Specially designed or prepared systems, equipment and components for use in chemical exchange or ion exchange enrichment plants

g. Specially designed or prepared systems, equipment and components for use in laser-based enrichment plants

h. Specially designed or prepared systems, equipment and components for use in plasma separation enrichment plants.

i. Specially designed or prepared systems, equipment and components for use in electromagnetic enrichment plants.

**OB006** Plants for the fabrication of nuclear reactor fuel elements, and equipment specially designed or prepared therefore including but not limited to:

a. fully automatic pellet inspection stations specially designed or prepared for checking final dimensions and surface defects of the fuel pellets;

b. automatic welding machines specially designed or prepared for welding end caps onto the fuel pins (or rods);

c. automatic test and inspection stations specially designed or prepared for checking the integrity of completed fuel pins (or rods).

Item ‘c’ typically includes equipment for: 1) x-ray examination of pin (or rod) end cap welds, 2) helium leak detection from pressurized pins (or rods), and 3) gamma-ray scanning of the pins (or rods) to check for correct loading of the fuel pellets inside.

**OB007** Plants or systems for production, handling, storage and transportation of Radioisotopes in quantities exceeding 100 Curies (3.7 X 10^12 Becquerel).

**OB008** Neutron generators including neutron chain reacting assemblies and fusion assemblies of all kinds for producing fissile materials.

**OC Technology**

Technology and software for the development, production or use of prescribed substances or prescribed equipment specified in OA or OB

*Note:* The numbering system followed in this Schedule is in harmony with the numbering system followed in the Special Chemicals, Organisms, Materials, Equipment and Technology (SC MET) List in Appendix – 3 of Schedule 2 of ITC (HS) Classification.

4.17.4 It is the office practice that whether an invention will fall under the provision of atomic energy or not is to be decided by the Department of Atomic Energy and the office will process the application based on the recommendation of that Department.
CHAPTER V

APPLICATION FOR PATENTS

Section 6. Persons entitled to apply for patents.-

(1) Subject to the provisions contained in section 134, an application for a patent for an invention may be made by any of the following persons, that is to say,—

(a) by any person claiming to be the true and first inventor of the invention;

(b) by any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application;

(c) by the legal representative of any deceased person who immediately before his death was entitled to make such an application.

(2) An application under sub-section (1) may be made by any of the persons referred to therein either alone or jointly with any other person.

Section 2(1) (y): "true and first inventor" does not include either the first importer of an invention into India, or a person to whom an invention is first communicated from outside India.

Section 2(1) (s): "person" includes the Government;

Section 2(1) (ab): "assignee" includes an assignee of the assignee and the legal representative of a deceased assignee and references to the assignee of any person include references to the assignee of the legal representative or assignee of that person; (see also Section 68)

Section 2(1) (k): "legal representative" means a person who in law represents the estate of a deceased person;

5.1 Persons Entitled To Apply For A Patent

5.1.1 An application for a patent for an invention may be made by any of the following persons either alone or jointly with another

- True and first inventor
- True and first inventor's assignee
- Legal representative of deceased true and first inventor or his/her assignee.

5.1.2 The term "person" as defined in the Patents Act includes Government. [Section 2(1)(s)].
5.1.3 The term “person” as defined in the General Clauses Act 1897 includes any company or association or body of individual, whether incorporated or not in the case of a limited partnership, the application may be in the names of all personally responsible partners.

5.1.4 True and first inventor does not include either the first importer of an invention into India or a person to whom an invention is first communicated from outside India (Section 2(1)(y)). The applicant is required to disclose the name, address and nationality of the true and first inventor.

5.1.5 Assignee can be a natural person or other than natural person like registered company, research organization, educational institute or Government (Section 2(1)(s)).

5.1.6 Assignee includes assignee of the assignee also (Section 2(1)(ab)).

5.1.7 ‘Proof of right’ to apply such as assignment deed should be submitted by the assignee. Proof of Right is required even when the applicant in convention country/ PCT international application is the same as that in India.

5.1.8 Legal representative means a person who in law represents the estate of a deceased person (Section 2(1)(k)). In such a case, the person should file death certificate along with other appropriate legal instruments as proof of right.

5.1.9 Convention country means any country, which is a signatory or party, or group of countries or union of countries or intergovernmental organizations which are signatories or parties to an international, regional or bi-lateral treaty, convention or arrangement, of which India is also a party. A convention country/countries for the purpose of the Act (Section 133), is one which accords the same rights in respect of the grant of patents and protection of patent rights to citizens of India, as it accords to its own nationals. (Section 133 & Section 134).

5.1.10 It was held in the case of Shinning Industries v. Shri Krishna Industries, that a firm can apply for a patent as assignee; [AIR 1975 All 231].

5.1.11 In the case of the Dyer Meakin Breweries Ltd. v. Scotch Whisky Association, (AIR 1980 Del 125.), it was held that section 68 of the Act provides that the Assignment Deed, when registered, shall have effect from the date of its execution. The court observed that as soon as the entry of registration of the deed was made by the Patent Office on 21st June, 1979, the plaintiff became the assignee of the patent in question with effect from the date of execution of the deed i.e. 22nd May, 1979. Section 68 of the Act provides that the assignment of a patent shall not be valid unless the same were in writing and the agreement between the parties concerned is reduced to the form of a document embodying all the terms and conditions governing their rights and obligations and the application for registration of such deed is filed with the Controller within six months of the execution of the document.

5.1.12 In the matter of an application for patent No. 551/Del/78, 1DPD, 39, the Controller held that the expression “without prejudice to provisions
contained in Section 6” should be interpreted only as to mean without detriment to the applicant’s right to file an ordinary application”.

**Rule 4. Appropriate office.-**

(1) The appropriate office of the patent office shall—

(i) for all the proceedings under the Act, be the head office of the patent office or the branch office, as the case may be, within whose territorial limits—

(a) the applicant or first mentioned applicant in case of joint applicants for a patent, normally resides or has his domicile or has a place of business or the place from where the invention actually originated; or

(b) the applicant for a patent or party in a proceeding if he has no place of business or domicile in India, the address for service in India given by such applicant or party is situated; and

(2) The appropriate office once decided in respect of any proceedings under the Act shall not ordinarily be changed.

**Rule 5. Address for service-**

Every person, concerned in any proceedings to which the Act or these rules relate and every patentee, shall furnish to the Controller an address for service in India and that address may be treated for all purposes connected with such proceedings or patent as the address of the person concerned in the proceedings or of the patentee. Unless such an address is given, the Controller shall be under no obligation either to proceed or deal with any proceeding, or patent or to send any notice that may be required to be given under the Act or these rules and the Controller may take suo motu decision in the matter.

**5.2. Where to Apply?**

5.2.1 There are four Patent Offices in India. Their place of location and territorial jurisdictions are presented in the table below:

<table>
<thead>
<tr>
<th>Patent Office</th>
<th>Territorial Jurisdiction</th>
</tr>
</thead>
<tbody>
<tr>
<td>Mumbai</td>
<td>The States of Gujarat, Maharashtra, Madhya Pradesh, Goa, Chhattisgarh, the Union Territories of Daman &amp; Diu and Dadra &amp; Nagar Haveli.</td>
</tr>
<tr>
<td>Chennai</td>
<td>The States of Andhra Pradesh, Karnataka, Kerala, Tamil Nadu and the Union Territories of Pondicherry and Lakshadweep.</td>
</tr>
<tr>
<td>Kolkata</td>
<td>Rest of India.</td>
</tr>
</tbody>
</table>
5.2.2 Application for the patent has to be filed in the respective Patent Office. The territorial jurisdiction is decided based on whether any of the following occurrences falls within the territory

a) Place of residence, domicile or business of the applicant (first mentioned applicant in the case of joint applicants)

b) Place from where the invention actually originated.

c) Address for service in India given by the applicant when he has no place of business or domicile in India. (Rule 5).

5.2.3 An appropriate office once decided will not be changed ordinarily

5.2.4 A foreign applicant is required to shall give an address for service in India and the jurisdiction will be accordingly decided.

5.3 Filing of Application for Patent

Section 7. Form of application.

(1) Every application for a patent shall be for one invention only and shall be made in the prescribed form and filed in the patent office.

(1A) Every international application under the Patent Cooperation Treaty for a patent, as may be filed designating India shall be deemed to be an application under this Act, if a corresponding application has also been filed before the Controller in India.

(1B) The filing date of an application referred to in sub-section (1A) and its complete specification processed by the patent office as designated office or elected office shall be the international filing date accorded under the Patent Cooperation Treaty.

(2) Where the application is made by virtue of an assignment of the right to apply for a patent for the invention, there shall be furnished with the application, or within such period as may be prescribed after the filing of the application, proof of the right to make the application.

(3) Every application under this section shall state that the applicant is in possession of the invention and shall name the person claiming to be the true and first inventor; and where the person so claiming is not the applicant or one of the applicants, the application shall contain a declaration that the applicant believes the person so named to be the true and first inventor.

(4) Every such application (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) shall be accompanied by a provisional or a complete specification.

Any application, notice or other document authorised or required to be filed, left, made or given at the patent office, or to the Controller or to any other person under the Act or these rules, may be tendered by hand or sent by a letter addressed to the Controller at the appropriate office or to that person through post or registered post or speed post or courier service or by electronic transmission duly authenticated. If it is sent by post or registered post or speed post or courier service or by electronic transmission duly authenticated, it shall be deemed to have been filed, left, made or given at the time when the mail containing the same would have been delivered in the ordinary course of post or registered post or speed post or courier service, or by electronic transmission duly authenticated, as the case may be. In proving such sending, it shall be sufficient to show that the mail was properly addressed and transmitted.

Any written communication addressed to a patentee at his address as it appears on the register of patents or at his address for service given under rule 5, or to any applicant or opponent in any proceedings under the Act or these rules, at the address appearing on the application or notice of opposition, or given for service, shall be deemed to be properly addressed.

All notices and all written communications addressed to a patentee, or to any applicant or opponent in any proceedings under the Act or these rules, and all documents forwarded to the patentee or to the said applicant or opponent, shall, except when they are sent by special messenger, be sent by registered post or speed post or courier service or by electronic transmission duly authenticated.

The date of a notice or a written communication addressed to a patentee or to any applicant or opponent in any proceedings under the Act and these rules shall be the date of dispatch of the said notice or written communication, by registered post or speed post or courier or fax or electronic transmission duly authenticated, as the case may be, unless otherwise specified under the Act or these rules.

In case of delay in receipt of a document or a communication sent by the patent office to a party to any proceedings under the Act or these rules, the delay in transmitting or resubmitting a document to the patent office or doing any act by the party may be condoned by the Controller if a petition for such condonation of delay is made by the party to the Controller immediately after the receipt of the document or a communication along with a statement regarding the circumstances of the fact and evidence in support of the statement:

Provided that the delay condoned by the Controller shall not exceed the period between the date on which the party was supposed to have received the document or communication by ordinary course of mail or electronic transmission and the actual date of receipt of the same.

Whether “Any other person under the Act” under the ambit of rule 6 includes, the “Patent Agent” apart from the Controller and the Patent Office when read with Section 2(1)(s) was considered (in the case)*. The Controller held that the expression “any other person under the Act or Rules” in rule 6 would mean that whenever there is a bi-party or multi-party proceedings viz. an
opposition under section 25, 61, or 92 of the Act, the parties to the proceedings are required to serve certain documents such as statements and evidence on each other, under intimation to the Controller and also on the Controller. In the course of any of the said proceedings if any document has been sent by one party to the other party and to the Controller by post sufficiently in advance, then if there is a postal delay as a result of which the other party or the Controller receives the said documents late, the delay involved will be condoned by the Controller under Rule 6 and the documents will be taken on record and deemed to have been received on the due date. Accordingly, I cannot accept …………….with regard to the expression “any other person under the Act or the Rules” as including Patent agent to whom his client has send the documents.”

5.3.2 Patent application can also be filed electronically from any remote location through e-filing system. A detailed user manual is available on the website: https://www.ipindiaonline.gov.in/on%5Fline/ipo_user_manual.pdf

**Rule 7. Fee.-**

(1) The fees payable under section 142 in respect of the grant of patents and applications there for, and in respect of other matters for which fees are required to be payable under the Act shall be as specified in the First Schedule.

(2) (a) The fees, payable under the Act may either be paid in cash or through electronic means or may be sent by bank draft or cheque payable to the Controller of Patents and drawn on a scheduled bank at the place where the appropriate office is situated. If the draft or cheque is sent by post, the fees shall be deemed to have been paid on the date on which the draft or cheque would have reached the Controller in the ordinary course of mail.

(b) Cheques or drafts not including the correct amount of commission and cheques on which the full value specified therein cannot be collected in cash shall be accepted only at the discretion of the Controller.

(c) Where a fee is payable in respect of a document, the entire fee shall accompany the document.

(3) In case an application processed by a natural person is fully or partly transferred to a person other than a natural person, the difference, if any, in the scale of fee(s) between the fee(s) charged from a natural person and the fee(s) chargeable from the person other than the natural person in the same matter shall be paid by the new applicant with the request for transfer.

(4) Fees once paid in respect of any proceeding shall not ordinarily be refunded irrespective of whether the proceeding has taken place or not.

(5) (i) Subject to the approval of the Controller, any person may deposit money in advance and request the Controller to realise any fee payable by him from the said deposit and in such case the date of the receipt of the request to realise the fee or the date on which the request to realise the fee is deemed to have been received, whichever is earlier, shall be taken as the date of payment of the fee:
Provided that the requisite amount of money is available at the credit of the person making such request.

(ii) Subject to the approval of the Controller, any person may discontinue the deposit of money in advance and in such case the balance, if any, shall be refunded.

Rule 8. Forms.-
(1) The Forms set forth in the Second Schedule with such variations as the circumstances of each case may require shall be used for the purposes mentioned therein.

(2) Where no Form is so specified for any purpose, the applicant may adopt any Form specified in the Second Schedule with such modifications and variations as may be required.

Rule 9. Size, etc., of documents.-

(1) All documents and copies of documents, except affidavits and drawings, sent to or left at the patent office or otherwise furnished to the Controller shall be written or typewritten or printed either in Hindi or in English language (unless otherwise directed or allowed by the Controller) in large and legible characters with deep indelible ink with lines widely spaced upon one side only of strong white paper of a size A4 of approximately 29.7 centimetres by 21 centimetres with a margin of at least 4 centimetres on the top and left hand part and 3cm on the bottom and right hand part thereof. Any signature which is not legible or which is written in a script other than Hindi or English shall be accompanied by a transcription of the name either in Hindi or in English in block letters:

Provided that any document including drawing, if any, may also be filed in electronic form along with a copy of it on white paper:

Provided further that in case the application for patent discloses sequence listing of nucleotides and/or amino acids, the same shall be filed in electronic form.

(2) Additional copies of all documents shall be filed at the appropriate office, if required by the Controller.

(3) Names and addresses of applicants and other persons shall be given in full together with their nationality and such other particulars, if any, as are necessary for identification.

Rule 10. Period within which proof of the right under section 7(2) to make the application shall be furnished.—

Where, in an application for a patent made by virtue of an assignment of the right to apply for the patent for the invention, if the proof of the right to make the application is not furnished with the
application, the applicant shall within a period of six months after filing of such application furnish such proof.

Explanation.—For the purposes of this rule, the six months period in case of an application corresponding to an international application in which India is designated shall be reckoned from the actual date on which the corresponding application is filed in India.

Rule 11. Order of recording applications.-
The applications filed in a year shall constitute a series identified by the year of such filing. In case of an application filed corresponding to an international application in which India is designated, such application shall constitute a series distinct from the rest of the applications identified by the year of filing of corresponding applications in India.

Rule 12. Information and Undertaking regarding foreign applications.-

(1) The statement and undertaking required to be filed by an applicant for a patent under sub-section (1) of section 8 shall be made in Form 3.

(1A) The period within which the applicant shall file the statement and undertaking under sub-section (1) of section 8 shall be six months from the date of filing the application.

Explanation.—For the purpose of this rule, the period of six months in case of an application corresponding to an international application in which India is designated shall be reckoned from the actual date on which the corresponding application is filed in India.

(2) The time within which the applicant for a patent shall keep the Controller informed of the details in respect of other applications filed in any country in the undertaking to be given by him under clause (b) of sub-section (1) of section 8 shall be six months from the date of such filing.

(3) When so required by the Controller under sub-section (2) of section 8, the applicant shall furnish information relating to objections, if any, in respect of novelty and patentability of the invention and any other particulars as the Controller may require which may include claims of application allowed within six months from the date of such communication by the Controller.

Section 9. Provisional and Complete specifications.-

(1) Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) is accompanied by a provisional specification, a complete specification shall be filed within twelve months from the date of filing of the application, and if the complete specification is not so filed, the application shall be deemed to be abandoned.

(2) Where two or more applications in the name of the same applicant are accompanied by provisional specifications in respect of inventions which are
cognate or of which one is a modification of another and the Controller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may allow one complete specification to be filed in respect of all such provisional specifications.

Provided that the period of time specified under sub-section (1) shall be reckoned from the date of filing of the earliest provisional specification.

(3) Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) is accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant so requests at any time within twelve months from the date of filing of the application, direct that such specification shall be treated, for the purposes of this Act, as a provisional specification and proceed with the application accordingly.

(4) Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under sub-section (3) as a provisional specification, the Controller may, if the applicant so requests at any time before grant of patent, cancel the provisional specification and post-date the application to the date of filing of the complete specification.

Section 10. Contents of specifications.—

(1) Every specification, whether provisional of complete, shall describe the invention and shall begin with a title sufficiently indicating the subject-matter to which the invention relates.

(2) Subject to any rules that may be made in this behalf under this Act, drawings may, and shall, if the Controller so requires, be supplied for the purposes of any specification, whether complete or provisional; and any drawings so supplied shall, unless the Controller otherwise directs, be deemed to form part of the specification, and references in this Act to a specification shall be construed accordingly.

(3) If, in any particular case, the Controller considers that an application should be further supplemented by a model or sample of anything illustrating the invention or alleged to constitute an invention, such model or sample as he may require shall be furnished before the application is found in order for grant of a patent, but such model or sample shall not be deemed to form part of the specification.

(4) Every complete specification shall—

(a) fully and particularly describe the invention and its operation or use and the method by which it is to be performed;

(b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and
(c) end with a claim or claims defining the scope of the invention for which protection is claimed;

(d) be accompanied by an abstract to provide technical information on the invention:

Provided that;

(i) the Controller may amend the abstract for providing better information to third parties; and (ii) if the applicant mentions a biological material in the specification which may not be described in such a way as to satisfy clauses (a) and (b), and if such material is not available to the public, the application shall be completed by depositing the material to an international depository authority under the Budapest Treaty and by fulfilling the following conditions, namely:—

(A) the deposit of the material shall be made not later than the date of filing the patent application in India and a reference thereof shall be made in the specification within the prescribed period;

(B) all the available characteristics of the material required for it to be correctly identified or indicated are included in the specification including the name, address of the depository institution and the date and number of the deposit of the material at the institution;

(C) access to the material is available in the depository institution only after the date of the application of patent in India or if a priority is claimed after the date of the priority;

(D) disclose the source and geographical origin of the biological material in the specification, when used in an invention.

(4-A) In case of an international application designating India, the title, description, drawings, abstract and claims filed with the application shall be taken as the complete specification for the purposes of this Act.

(5) The claim or claims of a complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification.

(6) A declaration as to the inventorship of the invention shall, in such cases as may be prescribed, be furnished in the prescribed form with the complete specification or within such period as may be prescribed after the filing of that specification.

(7) Subject to the foregoing provisions of this section, a complete specification filed after a provisional specification may include claims in respect of developments of, or additions to, the invention which was described in the provisional specification, being developments or additions in respect of which the applicant would be entitled under the provisions of section 6 to make a separate application for a patent.
Rule 13. Specifications.-

(1) Every specification, whether provisional or complete, shall be made in Form 2.

(2) A specification in respect of a divisional application under section 16 shall contain specific reference to the number of the original application from which the divisional application is made.

(3) A specification in respect of a patent of addition under section 54 shall contain a specific reference to the number of the main patent, or the application for the main patent, as the case may be, and a definite statement that the invention comprises an improvement in, or a modification of, the invention claimed in the specification of the main patent granted or applied for.

(4) Where the invention requires explanation through drawings, such drawings shall be prepared in accordance with the provisions of rule 15 and shall be supplied with, and referred to in detail, in the specification:

Provided that in the case of a complete specification, if the applicant desires to adopt the drawings filed with his provisional specification as the drawings or part of the drawings for the complete specification, it shall be sufficient to refer to them in the complete specification as those left with the provisional specification.

(5) Irrelevant or other matter, not necessary, in the opinion of the Controller, for elucidation of the invention, shall be excluded from the title, description, claims and drawings.

(6) Except in the case of an application (other than a convention application or an application filed under the Patent Cooperation Treaty designating India) which is accompanied by a complete specification, a declaration as to the inventorship of the invention, shall be filed in Form 5 with the complete specification or at any time before the expiration of one month from the date of filing of the complete specification, as the Controller may allow on an application made in Form 4.

Explanation,—For the purposes of this rule, the date of filing of the complete specification with respect to an application corresponding to an international application in which India is designated shall be reckoned from the actual date on which the corresponding application is filed in India.

(7) (a) The abstract as specified under clause (d) of sub-section (4) of section 10, accompanying the specification shall commence with the title of the invention. The title of the invention shall disclose the specific features of the invention normally in not more than fifteen words.
(b) The abstract shall contain a concise summary of the matter contained in the specification. The summary shall indicate clearly the technical field to which the invention belongs, technical problem to which the invention relates and the solution to the problem through the invention and principal use or uses of the invention. Where necessary, the abstract shall contain the chemical formula, which characterises the invention.

(c) The abstract may not contain more than one hundred and fifty words.

(d) If the specification contains any drawing, the applicant shall indicate on the abstract the figure, or exceptionally, the figures of the drawings which may accompany the abstract when published. Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by the reference sign used in that drawing.

(e) The abstract shall be so drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical field, in particular by making it possible to assess whether there is a need to consult the specification itself.

(8) The period within which reference to the deposit shall be made in the specification under sub-clause (A) of clause (ii) of sub-section (4) of section 10 shall be three months from the date of filing of the application.

Section 16. Power of Controller to make orders respecting division of application.-

(1) A person who has made an application for a patent under this Act may, at any time [before the grant of the patent], if he so desires, or with a view to remedy the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first mentioned application.

(2) The further application under sub-section (1) shall be accompanied by a complete specification, but such complete specification shall not include any matter not in substance disclosed in the complete specification filed in pursuance of the first mentioned application.

(3) The Controller may require such amendment of the complete specification filed in pursuance of either the original or the further application as may be necessary to ensure that neither of the said complete specifications includes a claim for any matter claimed in the other.

Explanation.—For the purposes of this Act, the further application and the complete specification accompanying it shall be deemed to have been filed on the date on which the first mentioned application had been filed, and the further application shall be proceeded with as a substantive application and be examined when the request for examination is filed within the prescribed period

Section 54. Patents of addition.—

(1) Subject to the provisions contained in this section, where an application is made for a patent in respect of any improvement in or
modification of an invention described or disclosed in the complete specification filed therefor (in this Act referred to as the "main invention") and the applicant also applies or has applied for a patent for that invention or is the patentee in respect thereof, the Controller may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.

(2) Subject to the provisions contained in this section, where an invention, being an improvement in or modification of another invention, is the subject of an independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention, the Controller may, if the patentee so requests, by order, revoke the patent for the improvement or modification and grant to the patentee a patent of addition in respect thereof, bearing the same date as the date of the patent so revoked.

(3) A patent shall not be granted as a patent of addition unless the date of filing of the application was the same as or later than the date of filing of the application in respect of the main invention.

(4) A patent of addition shall not be granted before grant of the patent for the main invention.

Section 135. Convention Applications.-

(1) Without prejudice to the provisions contained in section 6, where a person has made an application for a patent in respect of an invention in a convention country (hereinafter referred to as the "basic application"), and that person or the legal representative or assignee of that person makes an application under this Act for a patent within twelve months after the date on which the basic application was made, the priority date of a claim of the complete specification, being a claim based on matter disclosed in the basic application, is the date of making of the basic application.

Explanation—Where applications have been made for similar protection in respect of an invention in two or more convention countries, the period of twelve months referred to in this sub-section shall be reckoned from the date on which the earlier or earliest of the said applications was made.

(2) Where applications for protection have been made in one or more convention countries in respect of two or more inventions which are cognate or of which one is a modification of another, a single convention application may, subject to the provisions contained in section 10, be made in respect of those inventions at any time within twelve months from the date of the earliest of the said applications for protection:

Provided that the fee payable on the making of any such application shall be the same as if separate applications have been made in respect of each of the said inventions, and the requirements of clause (b) of sub-section (1) of section 136 shall, in the case of any such application, apply separately to the applications for protection in respect of each of the said inventions.

(3) In case of an application filed under the Patent Cooperation Treaty designating India and claiming priority from a previously filed application in India, the provisions of sub-sections (1) and (2) shall apply as if the previously filed application were the basic application:
Provided that a request for examination under section 11B shall be made only for one of the applications filed in India.

5.3.3 In the matter of Danieli AC Officine Meccaniche SPA v. Contoller of Patents and Designs (AID No. 19 of 1998), the High Court of Calcutta held that section 135 requires the basic application to be an “application of patent in respect of invention in a convention country. On a literal interpretation, the phrase plainly means that the basic application is made in order to qualify the applicant for a priority claim under section 135. In other words, an application made to a country, which may subsequently be declared, as a convention country will not do. “Further, the court also held that the provisions of sections 2(d) and 133 are not expressed in a language, which can be construed as operating retrospective. The applicants right flows from the provision of section 135 read with section 133(1) of the Patent Act. The notification was not given retrospective effect and the privileges of reciprocity were therefore extended to the 72 countries including Italy for the first time in 1995. The appellant’s basic application was made in 1994 when Italy was not a convention country. Therefore, the application under section 135 could not be proceeded with.

5.3.4 In the matter of a petition made under rule 6 of the Patent Rules filed by International Chemical Company Limited (Applicant) for application No. 912/Cal/81 the Controller held that “when the provisions of any statute are definite and clear cut, the question of applying principles of natural justice does not arise. Under Section 135 of the Act a convention application has to be made within 12 months from the date of the basic application. So it is the duty of the applicants to take care of all eventualities and see that their convention applications are filed within the periods stipulated in Section 135 of the Act. In fact, Section 135 provides ample time to the applicants to guard against almost any eventuality. Hence the principle of natural justice cannot be applied and the period of 12 months provided in Section 135 cannot be extended.”

5.3.5 Priority date is not allowed after withdrawal of basic application for an application made under section 135: as held in the case of application No. 986/Cal/79 filed on 21st September, 1979 as convention application based on U.K. application No. 37624/1979. However, the basic U.K. application was withdrawn before filing of the Indian application. The applicant argued that the priority of the withdrawn application should be allowed on the basis of the U.K. application as the same has the filing date and number and was mentioned in the statement of undertaking. The Controller however, held that existence of application in the convention country at least ‘on the date of filing’ the application in India was sine qua non for the claim of priority. Since the application in the convention country has been withdrawn prior to the date of filing of application India the requirement of under section 135 had not been met and, in fact, in the eye of law, there was no application in the convention country in consequence of withdrawal. Therefore, the priority date on the basis of withdrawn application could not be allowed.

Rule 15. Drawings.-
(1) Drawings, when furnished under section 10 by the applicants otherwise than on requisition made by the Controller, shall accompany the specifications to which they relate.

(2) No drawings or sketch, which would require a special illustration of the specification, shall appear in the specification itself.

(3) At least one copy of the drawing shall be prepared neatly and clearly on a durable paper sheet.

(4) Drawings shall be on standard A4 size sheets with a clear margin of at least 4 cm on the top and left hand and 3 cm at the bottom and right hand of every sheet.

(5) Drawings shall be on a scale sufficiently large to show the inventions clearly and dimensions shall not be marked on the drawings.

(6) Drawings shall be sequentially or systematically numbered and shall bear—
   (i) in the left hand top corner, the name of the applicant;
   (ii) in the right hand top corner, the number of the sheets of drawings, and the consecutive number of each sheet; and
   (iii) in the right hand bottom corner, the signature of the applicant or his agent.

(7) No descriptive matter shall appear on the drawings except in the flow diagrams.

Rule 16. Models —
(1) Models or samples shall be furnished under section 10 only when required by the Controller.

5.3.6 In the matter of an application for patent No. 551/Del/78, 1DPD, the Controller held that the expression without prejudice to provisions contained in section 6 “should be interpreted only as to mean “without detriment to the applicant’s to file an ordinary application “

5.4 Types Of Patent Applications

5.4.1 The following types of applications for patent can be filed:

- Ordinary Application
- Convention Application
- PCT International Application
- PCT National Phase Application
- Application for Patent of Addition
- Divisional Application

The ensuing paragraphs explain these different type of applications.
5.4.2 An application for patent filed in the Patent Office without claiming any priority of application made in a convention country or without any reference to any other application under process in the office is called an ordinary application. Such an application can be filed by an inventor himself (as an applicant) or by a person to whom the invention is assigned by the inventor (an assignee is the applicant), without claiming any priority of application made in a convention country or without referring to any other application being processed in the Patent Office. The applicant can be either from India or from abroad.

5.4.3 When an applicant files the application for a patent, claiming a priority date based on the same or substantially similar application filed in one or more of the convention countries, it is called a convention application. In order to get convention status, an applicant should file the application in the Indian Patent Office within twelve months from the date of first filing of a similar application in the convention country. The priority document [Section 138 (1)] and its verified English translation (if required) [Section 138 (2)] also should be submitted by the applicant. A convention application shall be accompanied by a complete specification.

5.4.4 When two or more applications for patents constituting one invention have been made in one or more convention countries, one application may be made within twelve months from the date on which the earlier or earliest of those applications was made. Multiple fees has to be remitted for claiming multiple priorities (Section 137), so that other applications filed earlier in the convention countries, will be deemed to have been published in India. An applicant of convention application shall furnish when required by the Controller, the copies of specification or documents (priority documents) certified by the official chief of the patent office of the convention country.

5.4.5 PCT is an international filing system for patents in which the applicant gets an international filing date in all the designated countries, conferring the late entry (up to 31 months) to the national offices without affecting the priority date. This is a simple and economical procedure for the applicants seeking protection for their inventions in many countries. Indian Patent Office is a Receiving Office for international applications by nationals or residents of India (see rules 17 to 23). An international application shall be filed with the appropriate office under rule 4 in triplicate either in English or in Hindi language [Rule 19(1)].

5.4.6 An international application [Section 2 (1)(ia)], made according to the Patent Cooperation Treaty [Section 2 (1)(oa)], designating India can enter national phase within 31 months from the priority date of international application or date of filing of international application whichever is earlier. Such an application filed before the Controller in the Indian Patent Office claiming the priority and international filing date is called PCT national phase application. Applicant can enter national phase with a request made in Form 1. The title, description, drawings, abstract and claims filed with the application shall be taken as the complete specification for the purposes of filing in India (Section 10 (4A)). The filing date of the application shall be the international filing date accorded under the Patent Cooperation Treaty [Section 7(1)(B)].
5.4.7 Although it is obligatory on the part of International Bureau of WIPO to send pamphlets to the designated offices for convenience and faster processing, the applicant shall submit the necessary documents in duplicate upon entry into national phase. The Patent Office may ask for any other documents, which are necessary in addition to what was submitted along with the application. Certified copies of the priority documents are to be filed within 3 months from the date of communication from the Patent Office.

5.4.8 When an applicant feels that he has come across an invention which is a slight modification of the invention for which he has already applied for/ or has patent, the applicant can go for patent of addition since the invention does not involve a substantial inventive step. It is also possible to convert an independent patent to a patent of addition at a later date if the subject matter was an improvement in or modification to a main invention for which he holds a patent. There is no need to pay separate renewal fee for the patent of addition during the term of the main patent. A patent of addition expires along with the main patent unless it is made independent according to the provisions in Section 54. However a patent of addition will not be granted unless the date filing of application was the same or later than the date of filing of the complete specification in respect of the main invention. It should be noted that a patent of addition will not be granted before granting of the patent for the main invention.

5.5 Specification And Drawings

5.5.1 The prime requirement of the patent law is to protect the invention disclosed in the specification. The specification is a techno-legal document containing scientific information constituting patent rights. The specification, thus, forms a crucial part of the patent documents. It is mandatory on the part of the inventor to disclose clearly and completely various features constituting the invention. Under the patent law, the disclosure is in the form of provisional and complete specification as the case may be. Various features of these specifications are discussed in this section.

5.5.2 When the applicant finds that his invention has reached a presentable form but not the final shape, he may prepare a disclosure of the invention in the form of a written description and submit it to patent office as a provisional specification which describes the invention. A provisional specification helps to establish the priority of the applicant over any other person who is likely to file an application for patent in respect of the same invention being developed concurrently. The applicant also gets twelve months time to fully develop the invention and ascertain its market potential without the fear of losing the priority right over the invention. Immediately on receiving the provisional specification the patent office accords a filing date for the application and provides a period up to twelve months for filing the complete specification, during which the applicant can fully develop his invention by himself or with the help of others who are interested in the economic value of the patent. No extension of time is permissible for filing complete specification.

5.5.3 The provisional or complete specification is required to be submitted in Form - 2 along with the application Form 1 and other documents in duplicate along
with the prescribed fee as given in the First Schedule. The first page of the Form 2 should contain-

(a) Title of the invention,
(b) Name, address and nationality of each of the applicants for the patent
(c) Preamble to the description.

5.5.4 A provisional specification is not a rough draft or a skeleton of the complete specification. The complete specification, which follows a provisional specification, does not replace the latter. Both are permanent and separate documents. Main features of the provisional specification are:

(a) A provisional specification should essentially contain the title and description of the invention and shall start with a preamble ‘The following specification describes the invention.’ Claims should not be included in the provisional specification, since it is not the purpose of Provisional Specification to claim legal right, but, to obtain priority of invention.

(b) The description should start from the second page starting with the field of invention and containing the background of the invention, object of the invention, statement of the principle underlying the invention and general statement of the actual invention. It is advisable to include in the provisional specification as much information as the applicant has at the time of filing, but in any case the description should be adequate to identify the invention from the prior art.

(c) It should be noted that, the provisional specification cannot be filed if the application is a divisional or convention application or an application filed under the Patent Cooperation Treaty designating India. In such cases, only a complete specification is required to be filed [section 9(1)].

(d) When an application for a patent is accompanied by a provisional specification, the complete specification (in Form 2) must be filed within twelve months from the date of filing of provisional specification, failing which the said application will be automatically abandoned.

(e) Nevertheless, the applicant may file a request for postdating of the application. Such a request should be filed before expiry of 12 months period from the date of filing of provisional specification. If the same applicant has filed more than one applications, accompanied by provisional specifications, which are cognate (related) or a modification of one another, the applicant can make a request on plain paper for filing a single complete specification in respect of all such provisional specifications. The complete specification should be filed within the period of twelve months taken from the date when the earliest of these provisional specifications was filed (section 9(2)).

(f) Where an application for a patent purporting to be a complete specification has been filed, then the applicant can convert it into a provisional specification by making a request (no form or fees required)
to the Controller and must file the complete specification within twelve months from the date of filing of application (section 9 (3)).

(g) In case, the complete specification was filed in pursuance of an application with a provisional specification or a complete specification has been treated as provisional specification under Section 9(3), then application with such a provisional specification can be post dated to the date of filing of the complete specification and then the provisional specification will be treated as cancelled [section 9 (4)].

5.5.5 The complete specification is a techno-legal document which fully and particularly describes the invention and discloses the best method of performing it. Main features of complete specification are

i) The Complete Specification must be framed with utmost good faith and must not contain any false representation or description of the invention or any material part of it, which would otherwise mislead the public. The complete specification must not be framed in ambiguous languages but must be as clear and concise as the nature of the subject would admit.

ii) The complete specification must be intelligible to an ordinary workman possessing the ordinary skill and knowledge of that branch or the useful art to which the invention relates. It is not required to describe the invention and the manner in which it is to be performed so fully as to instruct persons wholly ignorant of the subject matter.

iii) If the complete specification describes anything, which is not new, it must be clearly distinguished from the novel features of the invention.

iv) An amendment by way of modifications and variations of the description if any, must fall within the scope of the description

v) If the inventor does not disclose all the relevant information or mislead the public or gives a false description of the invention, the patent would be liable to be revoked.

vi) The detailed description should be supplemented by drawings in all cases in which the inventions are capable of being illustrated.

vii) It is not enough if a mere list of the various parts that make up the apparatus or device is given. The mode of construction of the apparatus and the function of its different parts should be described.

5.5.6 The description should start from the second page of Form 2 followed by statement of claims for which protection is sought and end with the date and signature of the Applicant or his authorized agent.
5.5.7 An abstract should be attached separately to the complete specification. Drawings, if any, referred in the specification shall be submitted along with the specification.

5.5.8 The following documents are to be attached along with complete specification:

a) Statement and Undertaking regarding foreign filing details in respect of same invention (Form 3) (Sections 8(1) and rule 12).

b) Declaration as to Inventorship (Form 5): In case of a convention application, PCT National Phase application and when complete specification is filed after provisional [Section 10(6) and rule 13(6)]. It should be filed within one month from the date of filing.

c) Priority Document should be submitted within three months from the date when required by the Controller (Section 138(1)). If the document is not in English, then a translated copy should be furnished [(Section 138(2)].

d) Power of Attorney (Form 26) (if the application is made through a patent agent) [Rule 135(1)].

e) Proof of Right (if the application is made by the assignee (S.7 (2) & R 10) (Proof right to apply can be produced either in the body of the application (Declaration by the Inventor(s) /Applicant(s) in the convention country in Form 1) or by way of separate assignment deed. If the application is made by the legal representative ‘death certificate or probate or certificate of inheritance’ of the deceased should be filed as proof of right. Proof of right shall be submitted within six months from the date of application.

f) If the applicant wishes, he can request for early publication on Form 9 along with the prescribed fee.

g) A request for examination on Form 18 along with the prescribed fees should be submitted so that the application is taken up for examination.

5.5.9 In case of an international application designating India, the title, description, drawings, abstract and claims filed with the international application shall be taken as the complete specification filed in India for the purposes of this Act.

5.5.10 It is the duty of the applicant to inform to the Patent Office filing particulars of same or similar application for patent filed outside India at the time of filing patent application in India. If there is no foreign filing, the applicant can give NIL statement. Further, the applicant should keep the office informed of subsequent filing as per the provisions of the Act.
5.5.11 Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file the following statement setting out detailed particulars of such application including the name of the country, application number, date of application, status of such application etc and undertaking in Form 3, along with his application or within six months from the date of filing of the application [(Section 8(1) rule 12(1A)]. The date of entry in the national phase shall be mentioned in form 3 against “Date of application” column in case of PCT national phase applications. The period of six months in case of an application corresponding to an international application is reckoned from the actual date on which the corresponding application is filed in that country and not from the International filing date. As per the amended Act the time period for filing form 3 is six months, which can be extended further by the Controller for a period of 1 month. [Section 8(1), rule(12), rule (138)].

5.5.12 The period of 6 months in case of an application corresponding to an international application in which India is designated is reckoned from the actual date on which the corresponding application is filed in India. Here is an illustration

- International filing date – 20\textsuperscript{th} May,1999
- Date of filing in India – 20\textsuperscript{th} May,2001
- Six months period u/r 12 (1A) is reckoned from 20\textsuperscript{th} May,2001 and not from 20\textsuperscript{th} May,1999.

5.5.13 An undertaking that up to the date of the grant of patent in India, the applicant would keep the Controller informed in writing, from time to time, the detailed particulars as required under clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India, subsequently to the filing of the statement referred to in the aforesaid clause, within six months of such filing (rule 12(2),Section 8(1)).

5.3.14 At any time after an application for patent is filed in India and till the grant of patent or refusal to grant of patent is made thereon, the Controller may also require the applicant to furnish details as may be prescribed relating to the processing of the application in a country outside India, and in that event the applicant shall furnish information available to him to the Controller within six months from the date of receipt of the communication requiring such furnishing of information [Section 8(2)]. Such particulars include information relating to objections, if any, in respect of novelty and patentability of the invention and any other particulars as the Controller may require which may include claims of application allowed.

5.6 Contents Of Complete Specification

5.6.1 Complete Specification is required to have the following components:
These components are described in the following paragraphs

(a) **Title** : The title should give a fair indication of the art or industry to which the invention relates. It should be brief, free from fancy expressions, free from ambiguity and as precise and definite as possible but it need not go into the details of the invention itself and should be normally within 15 words. It should verbally agree with the title stated in application. The followings are not allowable in the title: Inventor’s name; the word ‘Patent’; words in other languages; the abbreviation “etc”; fancy words, e.g., “Washwell Soap”, “Universal Rest Easy Patent Chair”. The following titles do not appear to be objectionable: Improved folding chair; railway rail chair; improvements in pneumatic tyres; motorcar differential gear; filaments for electric lamps; etc.

(b) **Preamble** : The following preamble should be given on the first page of Form 2 along with other details like title of the invention, name, address and nationality of the applicant(s): “The following specification particularly describes the invention and the manner in which it is to performed”.

c) **Name, address and nationality** : Full name and address along with nationality of the applicant should be given. The address could be of either place of business or residence.

(d & e) **Field of the invention and use of Invention** : The description should preferably begin with a short general statement of the invention so as to show its scope, and to indicate briefly the subject matter to which the invention relates, e.g. “*This invention relates to ..................*”. It should be defined in general terms and also described with particularity, for example, by giving specific examples.

Advantages of the invention should be mentioned to bring out clearly the areas of application and preferable use of the invention. The applicant can substantiate industrial applicability of the invention in this part and call for protection against duplication of invention in the related fields by specifying scope and ambit of the invention. If, in any particular case, the Controller considers that an
application should be further supplemented by a model or sample of anything such model or sample as he may require shall be furnished before the grant of a patent, but such model or sample shall not be deemed to form part of the specification.

(f and g) Prior Art and problem to be solved: This part should indicate the status of the technology in the field of invention with reference to experiments going on in the field, patents and pending patent applications in the specific art. When the invention relates to an improvement on an existing apparatus or process, a short statement of the closest prior art may also be given. However, the description should fully and particularly describe the invention, by clearly distinguishing it from such a closest prior art, if available.

h) Object of the Invention: The purpose of this part is to clearly bring out the necessity of the invention. It shall say clearly the technical problems associated with the existing technology and the solution for that, bringing out the obvious differences between the claimed invention and the prior art. The solution sought by the invention should be clearly brought out as object(s) of inventions with statements like “It has already been proposed ………………” followed by the objects which the inventions has in view e.g. “The principal object of this invention is ……………..”, “Another object of this invention is ……………..”, “A further object of this invention is …………….” etc.

i) Statement of Invention: The description should include a statement of invention before giving the details of the invention and the method of performing it. The statement should clearly set forth the distinguishing novel features of the invention for which protection is desired. This part is intended to declare different aspects of the invention in verbatim with the independent claims and to complement the omnibus claim in situations of infringement proceedings. It usually starts like, “Accordingly the invention provides an apparatus consisting of ---------- which is characterized in that --------------“. Other aspects and processes, if any, can also be stated e.g. “There is also provided a method of preparing ----------” etc.

j) Detailed Description of Invention (with reference to drawings, if any)

i) Description of an invention is required to be furnished in sufficient detail so as to give a complete picture of the invention and follows the Statement of invention. The nature of improvements or modifications effected with respect to the prior art should be clearly and sufficiently described. The details of invention described here should be sufficient for a person skilled in the art to perform the invention by developing necessary technical know-how by himself. It can include examples / drawings or both for clearly describing and ascertaining the nature of invention. Sufficient number of examples must be included in the description especially in the case of chemical inventions.

ii) Reference to the drawings should be specific and preferably in the following form: “This invention is illustrated in the accompanying
drawings, throughout which like reference letters indicate corresponding parts in the various figures”.

ii) The specification in respect of a Patent of Addition should contain at the beginning of the description, a definite statement indicating an improvement in or modification of, the original invention, and the serial number of the application for patent in respect of the original invention should be quoted. The specifications should also contain a short statement of the invention as disclosed in the earlier specification.

iv) Terms in other languages, if any, used in the description should be accompanied by their English equivalents. The use of vague slang words and colloquialisms is objectionable and should be avoided

v) If the invention is using biological material, such a material shall be deposited for the completion of the application when such material is not available to the public and can not be described adequately as per the provisions of the act. The deposition shall be made with the International Depository Authority under the Budapest Treaty, on or before the date of filing/priority. The International Depository Authority in India is Microbial Type Culture Collection and Gene Bank (MTCC) – Chandigarh

http://ipindia.nic.in/ipr/patent/d_inst_456.pdf. For further information on Microbial Type Culture Collection and Gene Bank (MTCC) please visit –

http://wdcm.nig.ac.jp/CCINFO/CCINFO.xml?773];
http://www.imtech.res.in/mtcc]

vi) Reference of such material shall be made in the specification within three months from the date of filing giving all the available characteristics of the material required for it to be correctly identified or indicated including the name, address of the depository institution and the date and number of the deposit of the material at the institution.

vii) Further, the source and geographical origin of the biological material specified in the specification also should be disclosed therein.

viii) Sequence listing may also be numbered in the specification if necessary in the case of Biotechnology Inventions.

ix) Sequence listing should be given in electronic form.

x) Access to the material is available in the depository institution only after the date of the application of patent in India or after the date of the priority, if a priority is claimed

k) Best Method of Working: The Act specifically requires as per section 0(4)(a) and 10(4) (b) that the complete specification must describe the best
method of performing the invention known to the applicant as per all his knowledge relating thereto, including that, which he may have acquired during the period of provisional protection prior to the date of filing the complete specification.

1) Statement of Claims: Claims constitutes a techno-legal part of the complete specification. The description should end with a claim(s) when a complete specification is filed. In case of provisional specification, there is no need to file claims. Important features and construction of claims is discussed in detail in the next section.

m) Signature with date: Below the signature the name(s) of the applicant(s)/or the authorized registered patent agent be written legibly alongwith the date.

n) Drawings: The complete specification should be followed by drawings that are referred in the specification. Drawing should be filed on a standard A4 size sheet in duplicate. Drawing should be preferably drawn in black Indian indelible ink or durable paper with margin of 2.5 cm on each side, in upright position with respect to top & bottom position of the sheet. At left-hand top corner of the sheet the name of the applicant should be mentioned. Total number of sheets and consequential sheet number should be mentioned at the right hand top corner of each sheet. At the right-hand bottom, the signature of the applicant/agent should be given along with the name of signatory thereunder. A reference letter/numerals as used in the description should also be used in denoting the corresponding component/part in the figure(s). No descriptive matter should appear on drawings, except under certain cases, such as, flow chart, chemical and other reaction, etc. The same letters or numerals should be used in different figures for the same parts. In complicated drawings or when there is no room to write the reference letters in their proper places, the letters should be shown outside the figures and connected by fine lines with the parts to which they refer.

o) Abstract:

i) An abstract should provide brief technical information on the invention. It should start with the “Title of the invention” and should give concise summary of the invention, preferably within 150 words. An abstract should be given on a separate page after claim(s).

ii) It has to be prepared in such a way that one can understand the technical field to which the invention belongs, technical problem and solution to the problem through the invention and principal uses of the invention.

iii) If necessary, the most relevant figure of the drawings should also be included along with features of the invention (depicted with reference numbers in brackets) in the abstract, particularly, in case of engineering inventions. Where necessary, the abstract shall contain the chemical formula, which characterises the invention.

iv) The abstract is supposed to serve as an efficient instrument for the purposes of searching in the particular technical field and to assess whether there is a need to consult the specification itself.
However, it cannot be used for the purpose of interpreting the scope of protection in legal proceedings.

v) The Controller may amend the abstract for providing better information to third parties

5.7 Submission of Documents in the Patents Office

5.7.1 All documents and copies of document to be furnished in the patent office shall be written or typewritten or printed either in Hindi or in English language in large and legible characters with deep indelible ink with lines widely spaced upon one side only of strong white paper of a size A4 with a margin of at least 4 centimetres on the top and left hand part and 3cm on the bottom and right hand part thereof. Any signature which is not legible or which is written in a script other than Hindi or English shall be accompanied by a transcription of the name either in Hindi or in English in block letters (rule 8).

5.7.2 In case the application for patent discloses sequence listing of nucleotides and/or amino acids, the same shall be filed in electronic form.

5.7.3 Leaving and serving documents [rule 6];

a) Any application, notice or other document required to be furnished at the patent office may be tendered by hand or sent by a letter addressed to the Controller at the appropriate office through post or registered post or speed post or courier service or by electronic transmission duly authenticated. It shall be deemed to have been filed, left, made or given at the time when the mail containing the same would have been delivered in the ordinary course.

b) Any written communication addressed to a patentee at his address on the register of patents or at his address for service or to any applicant or opponent in any proceedings under the Act or these rules, at the address appearing on the application or notice of opposition, or given for service, shall be sent by registered post or speed post or courier service or by electronic transmission duly authenticated except when they are sent by special messenger.

c) The date of such notice or written communication shall be the date of dispatch.

d) The delay in transmitting or resubmitting a document to the patent office or doing any act by the party may be condoned by the Controller if a petition for such condonation of delay is made by the party to the Controller immediately after the receipt of the document or a communication along with a statement regarding the circumstances of the fact and evidence in support of the statement.

e) Such period of delay condoned by the Controller shall not exceed the period between the date on which the party was supposed to have received the document or communication by ordinary course of
mail or electronic transmission and the actual date of receipt of the same.

f) Usually immediately on receiving the application, patent office accords an application number to it such that the applications filed in a year constitute a series identified by the year of such filing. PCT National Phase applications constitute a different series (rule 11).

5.8 Claims In Complete Specification

5.8.1 General Principles and Object of Claims: Claims are considered to be the most important part of the patent document. In a complete specification the description is followed by the Statement of Claims. Since the claims constitute the legal part for claiming the protection of the patent rights, it is imperative that the claims should be drafted carefully to cover all the aspects of the protection being sought. while observing the following points:

(a) Each claim should be in a single sentence and should be clearly and worded
(b) Claim(s) should be succinct and should not involve unnecessary repetition
(c) A claim (s) should not be verbose.
(d) A claim is the statement of technical facts expressed in legal terms defining the scope of the invention sought to be protected.
(e) No monopoly is obtained for any matter described in the complete specification unless it is claimed in the claims. What is not claimed in the ‘claims’ stands disclaimed, and falls open to the public use, even if the matter is disclosed in the description.
(f) Claims define the boundaries of legal protection sought by the patentee and form a protective fence around the invention which is defined by the words and phrases in the claims.
(g) The object of claims is to define clearly the scope of the invention with conciseness, precision and accuracy the monopoly claimed, so that others may know the exact boundaries of the area of protection in which they should not trespass.
(h) Their primary object of claims is to limit and not to extend the monopoly unduly and, simultaneously, also let others know when they are infringing on the rights of the patentee.
(i) Each claim is evaluated on its own merit and, therefore, if one of the claims is objected, it does not mean that the rest of the claims are invalid. It is therefore important to make claims on all of the invention to ensure that the applicant gets the widest possible protection.
5.8.2 Scope of Claims:

(a) As the value of a patent depends largely upon the scope of the claims, special care is necessary to ensure that the claims are drafted to include neither more nor less than what the applicant desires to protect by his patent.

(b) Claims must not be too extensive so as to embrace more than what the applicant has in fact invented. A claim, which is too wide, encroaches upon the subject matter, which may be in public domain or belong to others.

(c) However a claim must not be too narrow also because such a claim would not be sufficiently effective in preventing infringement of the patent. An infringer would go scot-free, if the claim were too narrow and, hence, the full benefit of invention may not accrue to the inventor.

(d) Having many claims, where each one has a different scope, allows the applicant to have legal title to several aspects of the invention. In a good drafting, it begins with broad claims and develops towards claims that are narrower in scope. In general, a narrow claim specifies more details than a broader claim.

(e) Passages which confuse the scope of the invention or claims that are unspecific (e.g. those claiming “Any novel matter...”) should not be filed.

(f) A claim shall be for the protection of either a product or process or apparatus or all of them, as the case may be, and shall be in one sentence according to the standard practice.

5.8.3 Features and Characteristics of Claims:

a. The description of invention in the complete specification is to be followed by a “statement of claims” preceded by the prescribed preamble, “I or we claim” as the case may be.

b. Claims should start from the fresh page after full description of the invention with the claims serially numbered.

c. There is no restriction to the number of claims to be incorporated in the specification. But the applicant has to pay additional fee, if there are more than ten claims. (See the First Schedule)

d. A claim(s) of a complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept and, shall be clear and succinct and fairly based on the matter disclosed in the specification (section 10 (5)).

e. A claim must be clear, complete and supported by description. A claim must be clear in the sense that it should not cause the reader to speculate about the claim. For example, if the words like “thin”, “strong”, “a major
part”, “such as”, “when required” or “any” are used, then it forces the reader to make a subjective judgment and not an objective observation, unless such expression follows any definite values.

f. A claim must be specific and not vague, ambiguous, speculative or hypothetical in nature. Each claim should be complete so that it covers the inventive feature and enough elements around it to put the invention in the proper context.

g. Claims must be supported by the description (fairly based on the description). This means that all the characteristics of the invention, that form the part of the claims must be fully explained in the description.

h. In addition, any term, which is used in the claims, must be either found in the description or clearly inferred from the description.

i. Trade marks are an indication of the origin rather than the composition or content of goods, and should not be used in patent applications where a generic term can be used instead. Trade marks are only permitted in claims where it can be shown that their use is unavoidable and does not introduce ambiguity. Where marks that are registered are mentioned, they should be acknowledged as such. If a trade mark is not registered, its owner should be indicated.

5.8.4 Structure of Claims

a) A claim usually consists of three parts:
   - Introductory phrase,
   - Body of the claim, and
   - Link that joins the two segments.

b) The introductory phrase identifies the category of the invention and sometimes the purpose (For example, a machine for waxing paper, a composition for fertilizing soil).

c) The body of the claim is the specific legal description of the exact invention, which is sought to be protected.

d) The linking consists of words and phrases such as:
   - Which comprises
   - Including
   - Consisting of
   - Consisting essentially of

e) If the invention is an improvement to a product existing in the market, the claims should set the boundary very clearly by characterizing the invention with respect to the prior art. In those cases, the claim will have two parts separated by the word ‘characterized by’ or ‘wherein’. The part coming before ‘characterized by’ is the prior art while that comes after will be the features of the invention. It
is equally applicable in the case of a process which is modification of the existing process. For Example: In the following example, “A data input device” is the introductory phrase, “comprising” is the linking word, and the rest of the claim is the body. “A data input device comprising; an input surface adapted to be locally exposed to a pressure or pressure force, a sensor means disposed below the input surface for detecting the position of the pressure or pressure force on the input surface and for outputting an output signal representing said position and; an evaluating means for evaluating the output signal of the sensor means.”

f) Structure of Claims should be on the following lines:

i) Independent Claim: This is the first claim which is also called the ‘Principal Claim’ should clearly define the essential novel features of the most preferred embodiment of the process, apparatus, device or the product that constitutes the invention and should be properly characterized with respect to the ‘prior art’, defining all the technical features essential to the invention or inventive concept. This should include the core integers as well as sufficient details of interrelationship, operation or utility to establish that the invention achieves the intended objectives and

ii) Dependent Claim(s): Dependent claims should be clubbed with the independent claims (or within themselves) to include all the features of the independent claim and characterized by additional non-essential features and even the minute aspects and optional features.

iii) Further independent claims are only justified where the inventive concept covers more than one category, e.g. apparatus, process, product, complementary versions within one category constituting unity of invention, e.g. plug and socket, transmitter and receiver, which work only together. Therefore, wherever possible, claims should not contain:

- Multiple unrelated inventions that would clearly give rise to a plurality objection.
- Multiple independent claims in any one category, even if only one inventive concept is present.
- Claims which are in principle unsearchable by reason of the number of alternatives embraced, or the choice of characterising parameters or desiderata.
- Dependent claims that are not fully limited by the terms of the preceding independent claim, e.g. dependent claims which omit, modify or substitute a feature of an independent claim.

iv) Omnibus Claim: A claim known as ‘omnibus claim’ worded, for example, as “An apparatus substantially as herein above described in the specification with reference to the accompanying drawings” can be added as the last claim to get an integral protection of what is described
in the specification and drawings. It is allowed only if the statement of
invention is incorporated in the specification.

5.8.5 Claim Specimens: The following examples, as sample claims, which have
been granted by the Patent Office, are given for the purpose of providing help
to the applicant in drawing up the Claims. They must, however, be regarded
as samples of varying quality, selected more or less at random and no
guarantee is given that they would be effective in a court of law.

i) Indian Specification No. 39285.
Title – “Wrapper for a package and method of preparing the same”.
“We claim :-

1. A wrapper for a package, having a tear-tape united to its outer surface, the
area of the wrapper to which the tear-type is united encircling the package
and being bounded along at least one edge by perforations.
2. A wrapper as claimed in Claim I in which a narrow area of the tear tape,
spaced from each edge of the tear-tape, is united to a narrow area of the
wrapper defined on each side by a line of perforations which are covered by
the outer portions of the tear-tape, the perforations facilitating tearing of the
wrapper to remove the portion bounded to the tear-tape.”

ii) Indian Patent Specification No.38069.
Title – “Improvements in or relating to gramophone records.
“We claim :-

1. A gramophone record in which the surface of the record containing the
record grooves comprises 12 to 15 per cent of amorphous carbon,
thermoplastic material and a filler consisting of non-fibrous natural mineral
material.
2. A gramophone record according to Claim I, wherein the percentage of filler
employed in the record is from 1 to 70 per cent.
3. A record according to Claim 1 or 2, wherein the percentage of thermoplastic
material is 20 to 60 per cent.

iii) [Indian Patent Specification No. 34515.
Title- “Improvements in or relating to tin Openers”.
“We claim,

1. A tool for opening metal containers, the tool comprising a spindle spit
throughout its length, means for rotating the spindle, means on spindle for
guiding the tool during an opening operation, which means also serves to
facilitate the removal of the waste metal coiled around the spindle, and
further means on the spindle for preventing the distortion of the spindle
during and opening operation.

2. A tool according to Claim 1, wherein the means for guiding the tool and
facilitating the removal of the waste metal and the means for preventing the
distortion of the spindle comprise two separate plates slidable and removable
mounted on the spindle”.

iv) The following example pertains to claims to a combination of plurality of
legs in an umbrella tent frame:

1. An umbrella tent frame having plurality of legs, each leg comprising a lower
portion, an upper portion, and a pivot connector interconnecting the lower
and upper portions; a clevis assembly comprising an upper clevis members, a
lower clevis member, and stop means supported by the lower clevis member
and projecting toward the upper clevis member and constructed and arranged
to engage the upper clevis member to limit movement of the lower clevis
member toward the upper clevis member; a plurality of radial pivot members
each fixed to a different one of the upper leg portions; and a plurality of
brace members each having one end pivoted to one of the radial pivot
members and the other end pivoted to the lower clevis member; wherein the
leg portions have transverse cross sections in the form of a rectangle with
longer sides and shorter sides, the longer sides of the cross sections of the
lower leg sections extending toward the interior of the tent frame when the
frame is erected.

2. Umbrella as defined in claim 1, wherein the shorter sides of the cross
sections of the upper leg portions extend toward the interior of the tent frame
when the frame is erected, whereby the upper leg portions could bend more
freely toward the upper clevis member as the tent frame is erected.

3. Umbrella as defined in claim 2, wherein the pivot connectors interconnecting
the lower and upper leg portions are each in the form of an integral
polymeric piece of generally U-shaped transverse cross section and the side
walls thereof include portions spaced more closely together to accommodate
the lower leg portion and portion spaced more widely to accommodate the
upper portion.

4. An umbrella tent of claim 3 wherein said upper clevis member comprises a
downwardly opening socket adapted to receive a post member extending
from the lower clevis member.

5. An umbrella tent of claim 2 wherein said upper clevis member comprises a
downwardly opening socket adapted to receive a post member extending
from the lower clevis member.

6. An umbrella tent frame of claim 1 wherein said lower leg portions further
comprise means to engage a floor portion of a tent when the tent frame is
erected.
7. An umbrella tent of claim 6 wherein said upper clevis member comprises a downwardly opening socket adapted to receive a post member extending from the lower clevis member.

8. An umbrella tent frame of claim 1 wherein said clevis members are molded from polymeric material.

9. An umbrella tent of claim 8 wherein said upper clevis member comprises a downwardly opening socket adapted to receive a post member extending from the lower clevis member.

10. An umbrella tent frame comprising a plurality of legs each including a lower portion and an upper leg portion, the leg portions having transverse cross sections in the form of a rectangle having longer sides and shorter sides, the lower and upper leg portions being pivotally interconnected with the longer sides of their cross sections at right angles to each other. (Independent claim)

11. An umbrella tent frame of claim 10 further comprising a clevis assembly comprising an upper clevis member and a lower clevis member, and wherein the upper leg portion is connected to the upper clevis member, and wherein the shorter sides of the cross sections of the upper leg portions extend toward the interior of the tent frame when the frame is erected, whereby the upper leg portions can bend more freely toward the upper clevis member as the tent frame is erected.

12. An umbrella tent frame of claim 11 further comprising pivot members interconnecting the lower and upper leg portions and wherein the pivot connectors interconnecting the lower and upper leg portions are each in the form of an integral polymeric piece of generally U-shaped transverse cross section and the side walls thereof include portions spaced more closely together to accommodate the lower leg portion and a portions spaced more widely to accommodate the upper leg portion.

13. An umbrella tent frame of claim 11 wherein said clevis members are moulded from polymeric material.

14. An umbrella tent of claim 11 wherein said upper clevis member comprises a downwardly opening socket adapted to receive a post member extending from the lower clevis member.

15. An umbrella tent frame of claim 10 wherein said lower leg portions further comprise means to engage a floor portion of a tent when the tent frame is erected.

5.8.6 How to Assess Clarity of Claims? : The following illustrations may be useful in judging clarity of claims:

i) A structure comprising a semiconductor substrate made of silicon, said structure further characterized by comprising a near-amorphous film comprising ZrO2. Here the claim does not have a precise or well-recognized meaning for a skilled person. The term ‘near-amorphous’ used in the claim is
vague and unclear and leaves the reader in doubt as to the meaning of the technical feature to which it refers, thereby rendering the definition of the subject-matter of said claim unclear.

ii) A Diesel engine comprising an engine block and a cylinder head made of an Aluminium-Titanium alloy having a melting point between 1000 K and 1100 K.

The syntax of the claim is open to different interpretation: Either the engine block as well as the cylinder head are made of the alloy, or only the cylinder head is made of the alloy.

iii) A digital photo-camera comprising a VLSI processing unit and a CCD image sensor, characterized in that it is adapted to operate at temperatures down to 200 K. The camera is defined in terms of the object to be achieved (operation at very low temperatures) rather than in terms of the technical features (e.g. selected semiconductor materials, thermal insulation, etc.) that achieve the desired object. The claim attempts to define the subject matter in terms of the result to be achieved. In this instance, however such formulation is not allowable because it appears possible to define the subject-matter in more concrete terms, i.e. in terms of how the effect is to be achieved.

5.8.7 In the case of Anup Engineering Ltd. v. Bharat Heavy Electricals Ltd. (1985 PTC 71), in regard to the ground of 'unfair description' the opponents have stated that important data like the dimension of the bellows produced and hydraulic pressure within the hydraulic forming machine have not been disclosed in the specification. Having regard to the fact that the invention claimed in statement of claims relates not to bellows but to apparatus for manufacturing bellows, these materials are not essential features of the invention. In regard to other defects like omission of reference numerals in the drawings accompanying complete specification and support of some claimed feature in the description; these defects are not of such nature as to make the alleged invention not clear or render the statement of claims ambiguous. These defects could have been corrected by effecting minor amendments in the description. The complete specification does not sufficiently and clearly describe the invention. The opponents, accordingly, have established this ground.

5.8.8 In Ram Narain Kher v. M/s. Ambassador Industries New Delhi and another [AIR 1976 Delhi 87], it was observed: When an invention is not itself new, the particular use of it for the purpose described in combination with the other elements of the system producing the advantageous results would be a sufficient element of novelty to support the Patent and in a claim for Patent pertaining to air cooler the claimant must specify what particular features of his device distinguish it from those which had gone before and show the nature of the improvement which is said to constitute the invention and the claim that there would be 25 per cent additional advantage of added cooled air by fixing the fan at the top of the cooler than in the customary way hitherto known in the front of the cooler must be succinctly stated in the
Claim before the Patent authority and must not be left to an inference raised on a general review of the specification.

5.8.9. Certain statements are not to be regarded as claims: Some illustrations are given below:

i) The statements of the following form given are not to be regarded as claims, in as much as, they do not define the invention:

   a) I claim to be the inventor of this appliance,
   b) I claim a patent and that no one else shall use my invention without leave.
   c) I claim that the machine described above is quite new and has never been seen or used before.
   d) I claim some reward.

ii) Also, the claims should not be made, as in the examples given below, for illustrating the efficiency or advantages of the invention:

   a) I claim that this device is better and cheaper and more effectual than anything known.
   b) I claim that my process or machine will do such and such things.
   c) I claim the following advantages.
   d) I claim an improved sewing machine.
   e) I claim a mechanism for converting heat into electrical energy without any loss of efficiency.
   f) I claim a new method of making silk waterproof.

iii) Where products are claimed, the invention will not be properly defined if merely the properties of the products are referred to, as in the following example:

   “I claim a lubricating oil which is of specific gravity…. and boiling point.”

iv) The claims, such as “I claim an improved sewing machine as described or as illustrated” or “I claim the invention described in the specification”, which merely refer back to the description are not sufficiently definitive unless the description contains an explicit statement of distinguishing features which are characteristics of the invention.

5.8.10 Markush-Type Claims

A Markush claim refers to a chemical structure by means of symbols indicating substituent groups. In such a claim, one or more parts of the claimed compound comprise multiple functionally equivalent chemical entities. For example: “The process for the manufacture of dyes which comprise coupling with a halogen substituted pyrazolone, a di-azotized unsulphonated material selected from the group consisting of aniline, homologues of aniline and halogen substitution
products of aniline.” Markush type claims allow important innovations to be patented. For example, when a new organic compound, that has a novel structure never obtained before, is invented and can have many possible substituents that could be used, one can effectively group these possible substituents in a Markush type of claims. So one can claim the basic structure along with substituents like halogens, alcohols, hydrocarbons, etc. However, such group of compounds are allowable when supported by a single and definitive process.

With chemical structures, it is often possible to use many substituents in a given structure. The result is that you have a few to hundreds of possible formulations; and each possible substitution location could be a different substituent. There are often changes in the substituent groups that do not change the original use of the compound and, thus, can be thought of as part of the original invention.

5.8.11 Unity Of Invention: Section 10(5)

A single inventive concept may be recognized between independent claims of different categories as in the following examples:

(a) A claim for a product and claim for a process specially adapted for manufacture of the product;

(b) A claim for a process and claim for an apparatus or means specifically designed for carrying out the process;

(c) A claim for a product, claim for a process specially adapted for manufacture of the product and claim for an apparatus or means specifically designed for carrying out the process. However, the above criteria can not be generalized and there may be occasions where all such claims may not be allowed in a single application based on the circumstances of the case.

(d) Unity between product and process claims requires that the process inherently results in the product when the novel product is obtained by the claimed process.

(e) Unity between process and apparatus or means requires that the apparatus or means have been specifically designed for carrying the process, or at least a step of the process, but without excluding any other possible use.

(f) Single inventive concept is permitted if the invention cannot readily be covered by a single generic claim.

Some illustrations are given below.
(i) A claim, “A mould for casting an article, a method of making that mould, a process of casting the article by using the said mould and the article will constitute a single inventive concept”.

(ii) A locking system containing plug and socket wherein separate independent claims for a plug and socket is allowable. Likewise a broadcasting system comprising transmitter and receiver.

(iii) If one has invented a new kind of spray bottle, the invention can be claimed in the same application for:
   (a) The spray bottle itself (a product)
   (b) Method of making the spray bottle (a process)
   (c) Apparatus used for making the said spray bottle.

(iv) When a genetically modified Gene Sequence/Amino Acid Sequence is novel, involves an inventive step and has industrial application, the following can be claimed.
   (a) Gene sequence/Amino Acid sequence
   (b) A method of expressing above sequence
   (c) An antibody against that protein/sequence
   (d) A kit made from the antibody/sequence

All of these claims are linked by the inventive concept if the genetically modified sequence is new, inventive and has industrial application.

(v) A drug or pharmaceutical product, if it is novel, inventive and has industrial application, can be claimed for the following:
   (a) a drug or pharmaceutical product,
   (b) modified drug or pharmaceutical of a known compound, if proved to be more efficacious than the known compound
   (c) a process of making the product as defined in (a) or (b).
   (d) formulation containing the drug (a) or (b).

(vi) In case of a herbal, chemical or pharmaceutical or a medicinal composition the following can be claimed:
   (a) a product by itself, if it is novel
   (b) a process of extraction and/or process of mixing the ingredients either pre-prepared or extracted.
   (c) Apparatus, if novel, either for the process of extraction and/or for the process of preparation.
(vii) In case of non-drug or non-pharmaceutical chemical, the following can be claimed:

(a) product, if it is novel
(b) process of making the chemical
(c) apparatus for the preparation of a chemical, if it is novel.

However, application of a chemical e.g. when a catalyst is claimed as product, the process wherein the above catalyst is used for performing a chemical process, shall be taken as plurality of invention.

(viii) A Biopolymer produced from a genetically modified bacterium can be claimed for the following (Accession Number of the bacterium & Name of the International Depository Authority should be mentioned in the complete specification):

(a) Biopolymer, if it is novel
(b) Genetically modified bacteria for producing the above said Biopolymer, if it is novel
(c) Process of manufacturing genetically modified bacteria
(d) Process for manufacturing the said biopolymer.

5.8.12 For further reading on the concept of unity of invention the “PCT Applicants Guidelines –International phase” may be referred at following URL


5.9 Sufficiency Of Disclosure

5.9.1 The Complete Specification describing the invention is a techno-legal document. It should disclose the invention completely to meet the requirement of the Patents Act and should also enable a person possessing average skill in the art to work the invention without assistance of the patentee. This is possible when the complete specification describes the invention fully and particularly and describes its operation and/or method by which it is to be performed. It is also essential that the best method for performing the invention, which is known to the applicant is disclosed in the Complete Specification. [S. (10)(4)].

5.9.2 If the applicant mentions biological material in the invention and it is not possible to describe the same in the complete specification, requirement of sufficiency of disclosure can be completed by depositing such material in an International Depository Authority under the Budapest Treaty. The same shall be deposited not later than the date of filing, however, the reference number to the deposit shall be made in the specification within 3 months from the date of filing the application. The complete specification shall contain the details of such deposition and the source and geographical origin of the biological material.
5.9.3 It is thus clear that the complete specification, should disclose the invention completely so that a person skilled in the art can perform the invention. The technical advance, synergistic effect and efficacy of the claimed invention must be substantiated properly in the body of specification as well as by way of suitable examples.

5.9.4 In Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries, (AIR 1982 SC 1444.), it was held that “Right way to construe a specification is not to read the claims' first and then see what the full description of the invention is, but first to read the description of the invention in order that the mind may be prepared for what it is, that the invention is to be claimed, for the patentee cannot claim more than he desires to patent.”

5.9.5 The ordinary skilled person must be able to perform the invention which satisfies the requirement of disclosure. The test for enablement of a prior disclosure for the purpose of anticipation is the same as the test of enablement of the patent itself for the purpose of sufficiency [ held in SmithKline Beecham Plc's (Paroxetine Methanesulfonate) Patent [2006] RPC 10 ].

5.9.6 There may however be differences in the application of this test to the facts; for example, because in the case of sufficiency the skilled person is attempting to perform a claimed invention and has that goal in mind, whereas in the case of prior art the subject-matter may have disclosed the invention but not identified it as such and it is to be judged from the point of view of the person skilled in the art.

5.9.7 Clarity of Disclosure:

i) Description of invention is addressed to a person skilled in the art who is doing his best to understand it and do not cast doubts on the scope of the invention. For example, in Press Metal Corporation Limited V. Noshir Sorabji Pochkhanawalla (1982 PTC 259 (Bom)), it was held that –

“It is the duty of a patentee to state clearly and distinctly the nature and limits of what he claims. If the language used by the patentee is obscure and ambiguous, no patent can be granted, and it is immaterial whether the obscurity in the language is due to design or carelessness or want of skill. It is undoubtedly true that the language used in describing an invention would depend upon the class of person versed in the art and who intend to act upon the specifications. In the present case, the invention is described in an obscure and ambiguous language, and on this ground, the patent is liable to be refused”.

ii) Since disclosure of the invention is the consideration in return for which the applicant is granted a monopoly the highest degree of good faith is called for, and the disclosure should be clear, precise, honest and open. A designedly ambiguous description or one that is wanting in distinctness, either by negligence or unskilfulness, will invalidate a patent (British Ore Concentration Syndicate Ltd v Minerals Separation Ltd, 27 RPC 47; Cincinnati Grinders (Inc) v. BSA Tools
iii) A specification should not contain superfluous or irrelevant matter (Francis’ Application, 27 RPC 87).

iv) Complicated mathematical calculations and analyses are undesirable unless they are necessary to a full understanding of the invention. The curtailment of an inordinately long specification may be requested (LD Corporation’s Applications, 66 RPC 4), but this should be done only in the most extreme cases.

v) The description should not contain passages which confuse the scope of the invention. Therefore, phrases such as “the invention should be taken to include any modifications, whether novel or not...” are unacceptable.

vi) Where particular description or drawings do not exemplify the invention claimed, for example, where they are included by way of explaining the invention or for comparison or where they relate to prior art, the description should make this clear.

5.9.8 Technical or Specialized Terms

i) The description should be as clear and straightforward as possible, with the avoidance of unnecessary technical jargon. Since it is addressed to persons skilled in the art, it will be desirable that for its use by him the technical terms which are well known in that art should be used.

ii) Little known or specially formulated technical terms may be used provided they are adequately defined and that there is no generally recognised equivalent.

iii) Foreign terms may be used where there is no English equivalent.

iv) Terms already having an established meaning should not be used differently, if this is likely to cause confusion. But in some circumstances it may be appropriate for a term to be borrowed from an analogous art.

v) If a specification contains a reference to a proprietary article or specific product, the composition of which is not well known, the description should state the composition of the article or the way in which it is prepared. If the applicant maintains that the information is well known in the art, or if the specification so states, and the examiner is unable to verify this, evidence in support of the contention may be required.

vi) The use of proper names or similar words to refer to materials or articles is undesirable in so far as such words merely denote origin, or where they may relate to a range of different products. The product
should be sufficiently identified, without reliance on the word, to enable the invention to be carried out by the skilled person. Such words which have generally accepted meanings as standard descriptive terms may however be used without further explanation; examples are Bowden cable, Belleville washer, zip fastener.

vii) A trade mark should not be used in a specification since it is an indication of origin rather than of composition or content and on that account cannot properly be used to describe an article. If a registered trade mark is used it should generally be accompanied by wording showing that it is a trade mark, since its use as a descriptive term without acknowledgement may be prejudicial to the rights of its owner.

5.9.9 Completeness of Disclosure

i) At least one embodiment of the invention or at least one method of performing the invention must be described. However, where the claims cover a broad field several examples or alternative embodiments or variations extending over the area to be protected by the claims may be necessary.

ii) The disclosure must be sufficient to enable whole width of the claimed invention to be performed. It was held that the disclosure of a single embodiment will not always satisfy the requirement regardless of the width of the claim [Biogen Inc v. Medeva plc [1997] RPC 1].

iii) It was held in Kirin-Amgen Inc v. Hoechst Marion Roussel [2005] RPC 9 that whether the specification is sufficient or not was highly sensitive to the nature of the invention. To determine this question, the first step was to identify the invention and decide what it claimed to enable the skilled man to do. It was then possible to ask whether the specification enabled him to do it.

iv) In Minnesota Mining & Manufacturing Co’s (Suspension Aerosol Formulation) Patent [1999] RPC 135 it was held that a specification is also insufficient if it provides no teaching relating to the criteria according to which the skilled man is taken to be using the invention.

v) What will suffice to satisfy the criterion that the disclosure must be sufficient across the whole width of the claimed invention will vary depending upon the nature of the claim. Thus, for example, when there is more than one product which is claimed, the question has to be asked whether the invention of one product is the invention of the other, unless they are different inventions and each must be sufficiently described. A similar conclusion had been reached by the Court of Appeal in the case and Chiron Corp. and ors v. Murex Diagnostics Ltd and ors [1996] RPC 535 (pages 612 and 613).
5.10 International Applications Under PCT

Section 10(4)A:

In case of an international application designating India, the title, description, drawings, abstract and claims filed with the application shall be taken as the complete specification for the purposes of this Act.

Rule 17: Definitions:

In this Chapter, unless the context otherwise requires:

(a) "Article" means an Article of the Treaty;
(b) "Treaty" or "PCT" means the Patent Cooperation Treaty.
(c) All other words and expressions used herein and not defined but defined in the PCT shall have the same meaning as assigned to them in that Treaty.

Rule 18: Appropriate office in relation to international applications:

(1) The receiving office, designated office and elected office for the purposes of international applications filed under the Treaty shall be the appropriate office in accordance with rule 4.
(2) The head office of the patent office shall be the appropriate office for dealing with the International Bureau of the World Intellectual Property Organisation, International Searching Authorities and International Preliminary Examining Authorities.
(3) An international application under the Treaty shall be filed at and processed by the appropriate office in accordance with the provisions of this Chapter, the Treaty and the regulations established under the PCT.
(4) Notwithstanding anything contained in sub-rule (2), on receipt of an international application, the appropriate office shall transmit one copy as record copy of such application to International Bureau of the World Intellectual Property Organisation and another copy as search copy to Competent International Searching Authority. The appropriate office shall simultaneously furnish complete details of such application to the head office of the patent offices.

Rule 19. International applications filed with appropriate office as receiving office:

(1) An international application shall be filed with the appropriate office in triplicate either in English or in Hindi language.
(2) The fees payable in respect of an international application filed with the appropriate office shall be, in addition to the fees as specified in the regulations under the Treaty, the fees as specified in the First Schedule.

(3) Where an international application filed with the appropriate office has not been filed as specified under sub-rule (1) and the applicant desires that the appropriate office should prepare the additional copies required, the fee for making such copies shall be paid by the applicant.

(4) On receipt of a request from the applicant and on payment of the prescribed fee by him, the appropriate office shall prepare a certified copy of the priority document and promptly transmit the same to the International Bureau of the World Intellectual Property Organisation for the purpose of an international application filed with the appropriate office with an intimation to the applicant and the head office.

Rule 20. International applications designating or designating and electing India:

(1) An application corresponding to an international application under the Patent Cooperation Treaty under section 7(1A) may be made in Form 1.

(2) The Patent Office shall not commence processing of an application filed corresponding to international application designating India before the expiration of the time limit prescribed under sub-rule (4)(i).

(3) An applicant in respect of an international application designating India shall, before the time limit prescribed in sub-rule (4)(i),—

(a) pay the prescribed national fee and other fees to the patent office in the manner prescribed under these rules and under the regulations made under the Treaty;

(b) and where the international application was either not filed or has not been published in English, file with the patent office, a translation of the application in English, duly verified by the applicant or the person duly authorised by him that the contents thereof are correct and complete.

(4) (i) The time limit referred to in sub-rule (2) shall be thirty one months from the priority date as referred to in Article 2(xi);

(ii) Notwithstanding anything contained in clause (i), the Patent Office may, on the express request filed in Form 18 along with the fee specified in First Schedule, process or examine the application at any time before thirty one months.

(5) The translation of the international application referred to in sub-rule (3) shall include a translation in English of—

(i) the description;

(ii) the claims as filed;

(iii) any text matter of the drawings;

(iv) the abstract; and
(v) in case the applicant has not elected India and if the claims have been amended under Article 19, then the amended claims together with any statement filed under the said Article;

(vi) in case the applicant has elected India and any amendments to the description, the claims and text matter of the drawings that are annexed to the international preliminary examination report.

(6) If the applicant fails to file a translation of the amended claims and annexure referred to in sub-rule (5), even after invitation from the appropriate office to do so, within a time limit as may be fixed by that office having regard to the time left for meeting the requirements, the amended claims and annexure shall be disregarded in the course of further processing the application by the appropriate office.

(7) The applicant in respect of an international application designating India shall when complying with sub-rule (3), preferably use Forms set out in the Second Schedule before the appropriate office as designated office.

Rule 21. Filing of priority document:

(1) Where the applicant in respect of an international application designating India has not complied with the requirements of paragraph (a) or paragraph (b) of rule 17.1 of the regulations under the Treaty, the applicant shall file with the patent office the priority document referred to in that rule before the expiration of the time limit referred to in sub-rule (4) of rule 20.

(2) Where priority document referred to in sub-rule (1) is not in the English language, an English translation thereof duly verified by the applicant or the person duly authorised by him shall be filed within the time limit specified in sub-rule (4) of rule 20.

(4) Where the applicant does not comply with the requirements of sub-rule (1) or sub-rule (2), the appropriate office shall invite the applicant to file the priority document or the translation thereof as the case may be, within three months from the date of such invitation, and if the applicant fails to do so, the claim of the applicant for the priority shall be disregarded for the purposes of the Act.

Rule 22: Effect of non-compliance with certain requirements:

An international application designating India shall be deemed to be withdrawn if the applicant does not comply with the requirements of rule 20.

Rule 23: The requirements under this Chapter to be supplemental of the regulations, etc., under the Treaty:

(1) The provisions of this Chapter shall be supplemental to the PCT and the regulation and the administrative instructions made there under.

(2) In case of a conflict between any provisions of the rules contained in this Chapter and provisions of the Treaty and the regulations and the
administrative instructions made there under, the provisions of the Treaty and the regulations and administrative instructions made there under shall apply in relation to international applications.

5.10.1 The Patent Cooperation Treaty (PCT) is an agreement for international cooperation in the field of patents. It is the most significant advancement in international cooperation in this field since the adoption of the Paris Convention itself. It is, however, largely a treaty for rationalization and cooperation with regard to the filing, searching and examination of patent applications and the dissemination of the technical information contained therein. The PCT does not provide for the grant of “international patents”. The task and responsibility for granting patents remains exclusively in the hands of the Patent Offices of, or acting for, the countries where protection is sought (the “regional Offices”). PCT is a special agreement under the Paris Convention open only to states, which are members of the Paris convention and is administered by International Bureau (IB) under World Intellectual Property Organization (WIPO), Geneva.

5.10.2 On 7th September 1998, India deposited its instrument of accession to the PCT and on 7th December 1998 thus became a member of the PCT, as the 98th Contracting State of PCT. The Patent Offices at Kolkata, Mumbai, Chennai and New Delhi are receiving the PCT applications.

5.10.3 The principal objective of the PCT is to simplify the patent system over the previously established means of applying for patent protection in several countries for inventions and to render it more effective and more economical in the interest of the users and the national patent offices, that have responsibility for administering PCT. Before introduction of the PCT system, virtually the only means by which protection of an invention could be obtained in several countries was to file a separate application in each country. Each of the application is dealt with in isolation, and thus, involves repetition of the work of the filing and examination in each country.

5.10.4 PCT facilitates the following in order to achieve the objectives:

i. establishment of an international system which enables the filing of a single application with a single Patent Office (“Receiving Office”), or the “International Application”, in one language, having effect in each of the countries which are party to the PCT which the applicant names (“designates”) in his application;

ii. provision to the formal examination of the international application by a single Patent Office, acting as the Receiving Office;

iii. international search of every international application which results in a report, citing the relevant prior art (published patent documents and other publications, relating to previous inventions) which may have to be taken into account in deciding whether the invention may be patentable; that report is made available first to the applicant and is later published; (An exhaustive written opinion on patentability is also provided by ISA).

iv. provision of centralized international publication of International Applications along with the related international search reports including
written opinion, declaration, priority document, translation, international examination report, as may be applicable to the particular application.

v. provision of the option of an international preliminary examination of an international application, which enables national offices to decide whether or not to grant a patent to the applicant.

5.10.5 The procedure described under PCT involves two steps of processing the international application. The “International Phase” deals with conducting the search and allowing the applicant to amend the claims, if required. It also optionally deals with the international preliminary examination. Thereafter, the applicant has to enter the national phase (within the prescribed time limits). The grant of patent is the task of the designated / elected offices, that is, the national offices or regional offices.

5.10.6 Under the PCT system, by the time the international application reaches the national / designated Office, it has already been searched by the International Searching Authority and possibly examined by an International Preliminary Examining Authority, thus providing the national Patent Offices with the important benefit of reducing their work loads since they have the benefit of these international phase centralized procedures and, thus, need not duplicate those efforts. Further, objectives of the PCT are to facilitate and accelerate access by industries and other interested sectors to technical information related to inventions and to assist developing countries on gaining access to technology.

5.10.7 Filing of the International Application:

a) Request form (PCT / RO / 101)

(i) International application must be filed with any of the receiving offices i.e. Patent office, Kolkata (RO/IN), New Delhi Mumbai, and Chennai or International Bureau (RO/IB) of WIPO. The request form and the documents attached therewith should be in triplicate. An application for the same invention has to be filed in India not less than six weeks before filing the International application or necessary permission under section 39 should be taken before filing the international application. The request for permission (U/S 39) for making patent application outside India including PCT international application should be made in form 25 with the prescribed fee as given in First Schedule (sub rule 1 of rule 71) and the Controller shall dispose the said request ordinarily within a period of 21 days from the date of filing of such request (sub rule 2 of rule 71).

(ii) The international application must contain a request, a description, one or more claims, one or more drawings (where required) and an abstract; it must comply with the prescribed physical requirements; it must be in one of the prescribed languages; finally, the required fees must be paid. These requirements will be dealt with one by one.
(iii) The Request may be made on Form PCT / RO / 101, copies of which can be obtained free of charge from the Receiving Office or from the International Bureau of WIPO or can be downloaded from WIPO website. The request may also be presented as a computer printout as prescribed by Section 102(h) of the PCT Administrative Instructions or, alternatively, as a computer printout prepared using the PCT-EASY software, in which case it must be accompanied by a computer diskette containing a copy of the data as contained in the request in electronic form and copy of the abstract.

(iv) The request must, first of all, contain a petition, that is, a request that the International Application be processed according to the PCT. It must further contain the title of the invention with necessary data concerning the applicant, the inventor and the agent representing the applicant. It must be signed by the applicant or his agent. Declaration of inventorship should be signed by the inventor(s) / the applicants in convention country as applicable and not by the agent. Where there are two or more applicants, each applicant must sign at his choice either the request or, if the request is signed by an agent, a separate power of attorney. The request should also contain details of priority (where applicable) and an indication of competent International Searching Authority.

(v) The request may contain some optional indications, in particular, a priority claim according to the Paris Convention for the Protection of Industrial Property.

b) Priority

(i) A certified copy is required for each priority of the application and the same is to be furnished within 16 months from the priority date; The copies for the designated offices are prepared by the International Bureau at no additional cost to the applicant .

(ii) A request for transmittal of a copy of the priority document filed with the Receiving Office, by the Receiving Office to the International Bureau, can be made in the Request Form and the applicable fee for a priority document paid to the Receiving Office.

c) Description

(i) The description of the invention in the International Application must disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

(ii) The description initially defines the field of invention. It then specifies pertinent technical field to which the invention relates. It indicates the so-called “background art”, that is, the technical and, in particular, patent literature, pertaining to that technical field, constituting the “prior art” or “state of the art” or known technology for the newly filed application. It discloses the intention in a way, which allows the technical problem and its solution to be understood. It states the advantageous effects of the invention as compared with the known technology. It briefly
describes the figures in the drawings. It sets forth the best mode contemplated by the applicant for carrying out the invention and any other mode he wants to include. Finally, it indicates the way in which the invention is capable of exploitation in industry.

d) Sequence Listing

Section 8(6) of PCT allows a designated Office to require that a copy of a sequence listing part filed only on an electronic medium under new Section 8(1) be furnished, on paper for the purposes of the national phase.

(i) For the applicants who do not wish to file the sequence listing part of their international applications under new Section 801, the current provisions will continue to apply, including the filing in written form only (under Rule 5.2) and the concurrent or subsequent furnishing, as provided under PCT Rule 13ter and Section 208, of the sequence listing parts in computer readable from but only for the purposes of International search and / or international preliminary examination. In such cases the current system for calculating the basis fee, on the basis for the total number of sheets of the international application including the sequence listing part, will continue to apply (see item 1(b) of the Schedule of Fees).

(ii) It is important to note that international application filed under new section 801 may only be filed with receiving Offices, which are prepared to accept them, and on such electronic media specified by the receiving Offices (for further details pl. See PCT Applicant’s Guide).

e) Claims:

(i) The claims must define the subject matter of the invention for which protection is sought. They must be clear and concise and fully supported by the description.

(ii) With respect to the structure and drafting of claims, the PCT requirements are largely similar to what is accepted in most Patent Offices.

f) Drawings:

The drawings are only required where they are necessary for the understanding of the invention. This will be the case for example for an engineering type of invention. It will not be the case when an invention cannot be drawn, as is the case for a chemical product. Here again, the requirements are similar to those of most Patent Offices.

g) Abstract:

(i) The abstract is intended to serve the purpose of technical information. The treaty says clearly that it cannot be taken into account for any other purpose. This means in particular that it cannot be used for the purpose of interpreting the scope of the protection sought.
(ii) The abstract consists of a concise summary of the disclosure of the invention as contained in the description, claims and drawings in preferably within 50 to 150 words. It must be drafted in a way, which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use of the invention.

h) Language of filing

(i) The international Application must be filed in the language, or one of the languages, which the Receiving Office accepts for that purpose (Rule 12.1(a)). If the application is filed in any receiving office in India it has to be either in English or Hindi.

(ii) Neither the Treaty nor the Regulations enumerate the languages in which International Applications may be filed. Whether a given language can be used depends on the readiness of the Receiving Office to accept International Applications in that language. Each Receiving Office must, however, accept at least one language for the filing of International Applications, which is both a language accepted by at least one international Searching Authority, competent for the international searching of International Applications filed with that Receiving Office and one of the language of publication (that is, Chinese, English, French, German, Japanese, Spanish, Russian or Arabic). In other words, either the International Application in its original language or the translation will be sufficient for the processing by the Receiving Office, for international search and for international publication.

(ii) If the language of filing of the International Application is accepted by the Receiving Office and the International Searching Authority but is not a language of publication (at present, this is the case only where the International Application is filed in Dutch and certain Nordic languages), the International Application will be published in English, the translation into that language being prepared under the responsibility of the International Searching Authority which undertakes the searches (see Rule 48.3).

(iii) The request must always be filed in a language that is accepted by the Receiving Office and which is also one of the eight languages of publication.

5.10.8 Functions of the Receiving Offices

(i) Receiving Office receives the international application from the applicant or from his authorized Agent.

(ii) Then the Receiving Office checks the International Application to determine whether it meets the prescribed requirements as to form and content of International Applications. This check is of a formal nature only and does not go into the substance of the invention. It therefore extends only to a certain
number of rather elementary requirements specified in the Treaty as forming part of that check.

(iii) a) If the requirements of article 11, viz, nationality / residence, language, format of the specification etc are fulfilled, then the international application number is allotted on the date of receipt of the application.

b) The receiving office shall accord as the international filing date; the date of receipt of the international application, provided the application is in order in accordance with Article 11 of PCT, at the time of receipt.

c) If the receiving office finds that the international application did not, at the time of receipt, fulfill the requirements listed in paragraph (a), it shall, as provided in the Regulations, invite the applicant to file the required correction(s).

d) If the applicant complies with the invitation, as provided in the regulations, the receiving office shall accord as the international filing date, the date on which the corrected copy is submitted.

(iv) Receiving Office checks certain formal and physical requirements (Article 14) as to form and content and whether the fees are not, or not fully, paid. In that case, the Receiving Office communicates with the applicant in order to give him an opportunity to correct any defect.

(v) If after correction, if any, the international application meets the requirements of article 14, the Receiving office accords the International filing date.

(vi) If the language of filing of the international application is the one acceptable by the Receiving Office but not acceptable by the International Searching Authority to carry out international search, the applicant is required to furnish, within one month from the filing date of the application, the translation into a language among the following:

- a language accepted by the International Searching Authority to carry out international search;
- a language of publication; and
- a language accepted by the Receiving Office (unless the international application is filed in a language of publication).

In cases, where the applicant fails to furnish, within the applicable time limit, a translation for the purpose of international search, the Receiving Office invites the applicant to furnish the missing translation, in certain cases subject to the payment of a late furnishing fee. A separate invitation procedure is provided for the case where the request does not comply with language requirements. Where the applicant does not furnish the missing translation within the time limit fixed in the invitation, the International application will, subject to certain safeguards for the applicant, be considered withdrawn and the Receiving Office will so declare.
(vii) Not all the requirements of the International Application are required to be examined by the Receiving Office. For instance, the Receiving Office does not deal with substantive questions such as whether the disclosure of the invention in the application is sufficient and whether the requirement of unity of invention is complied with. It also does not check all the many detailed physical requirements of the International Application. Those requirements are only checked to the extent that compliance with such requirements is necessary for the purpose of reasonably inform international publication.

(viii) Typical examples of defects, which may be corrected without affecting the international filing date, are:

- Non – payment or partial payment of fees;
- Lack of signature of the request;
- Lack of a title of the invention;
- Lack of an abstract;
- Physical defects.

(ix) In all such cases, lack of correction leads to the application being considered withdrawn, except where a physical defect would not prevent reasonably uniform international publication and except for the payment of fees. With regard to the later, PCT rule 16 bis provides that the Receiving Office must invite the applicant to pay the missing fees together with a late payment fee. If the applicant still does not pay the fees within the time limit fixed in the invitation, the Receiving Office will declare that the International Application is being considered withdrawn. This solution protects the applicant against any loss of his application due to an erroneously delay or incomplete payment of fees.

(x) The next step in the procedure before the Receiving Office is that it must transmit the “record copy” of the international Application to the International Bureau and the “search copy” to the International Searching Authority. The Receiving Office keeps a third copy, the “home copy”. The transmittals do not take place if, and as long as, national prescriptions concerning national security apply. The Receiving Office will then declare that national security provisions prevent the International Application from being treated as such.

(xi) The Receiving Office must mail the record copy promptly to the International Bureau and in any case not later than five days prior to the expiration of the 13th month from the priority date. In many cases, the International Application claims the priority of an earlier national application and is filed at the end of the 12-month priority period; the Receiving Office has only a few weeks for its processing tasks.

(xii) The search copy must be transmitted by the Receiving Office to the International Searching Authority at the time of the transmittal of the record copy of the International Bureau except, where the search fees has not been paid on time, in which case, the transmittal of search copy takes place after that fee has been paid.
(xiii) If an applicant, who is a resident or national of a PCT Contracting State, erroneously files his International Application with a national office which acts as a Receiving Office under the Treaty but which is not competent under Rule 19.1 or 19.2, having regard to the applicant’s residence and nationality, to receive that International Application, or if an applicant files his International Application with the competent Receiving Office in a language which is not acceptable by that Office under Rule 12.1 (a) but is in a language accepted under that Rule by the International Bureau as Receiving Office, the International Application will be considered to have been received by the national Office on behalf of the International Bureau as Receiving Office on the date on which it was received by the national office, and will be promptly transmitted to the International Bureau as Receiving Office (unless such transmittal is prevented by national security prescriptions). The transmittal may be subjected by the National Office to the payment of a fee equal to the transmittal fee. All other fees, already paid to that Office, will be refunded by that Office to the applicant and the applicable fees will have to be paid to the International Bureau as Receiving Office.

5.10.9 The following conditions should be fulfilled for according an international filing date:

(i) Prerequisite: A permission u/s 39 to file an application outside India should have been obtained or an application should have been filed at least six weeks earlier than the international (PCT) application and no secrecy direction should have been given u/s 35 before filing a PCT application.

(ii) The applicant should be resident or national of the Contracting State for which the Receiving Office acts, and has consequently the right to file with that Receiving Office (note, however, that the International Application is to be transmitted to the International Bureau as Receiving Office under Rule 19.4(a)(i), if that condition is not fulfilled);

(iii) The international application should be in English or Hindi (note, however, that the International Application is to be transmitted to the International Bureau as Receiving Office under rule 19.4(a)(ii), if that condition is not fulfilled.

(iv) The International Application should contain at least the following elements:
   (a) an indication that it is intended to be an International Application,
   (b) filing the request that constitutes the designation of all contracting states bound by the PCT for the grant of every kind of protection available and for the grant of both regional and national patents,
   (c) the name of the applicant in a form allowing the applicant’s identity to be established, the inventor (normally) and the agent, (if any),
   (d) a part which on the face of it appears to be a description,
   (e) a part which on the face of it appears to be claim or claims.

(v) If one of these requirements is only complied with after correction, the international filing date will be the date on which the correction was received. In other words, in these cases a defect, which is corrected later, affects the
international filing date. If all such defects are not properly corrected, the application will not be treated as an International Application.

(vi) For all the other cases, non-compliance with the formal requirements does not affect the international filing date. In other words, if the applicant corrects a defect in such cases, the international filing date remains unchanged. If the applicant does not correct, the defect properly, the International Application will, however, be considered withdrawn by the Receiving Office. Extension of the time limit fixed by the Receiving Office for the correction of defects under Article 14 may be requested.

5.10.10 Easy supervision and monitoring of only a few time limits and events is required by applicants, namely:

(i) Monitoring the time limits for payment of fees;
(ii) Checking the notification (Form PCT/IB/301) from the International Bureau for confirming the receipt of the record copy.
(iii) Deciding, after the receipt of the international search report, whether or not to file amended claims under Article 19, within the applicable time limit.
(iv) Monitoring the receipt, during the 19th month from the priority date, of the notice from the International Bureau (Form PCT /IB / 308) that the publication of the International Application has been effected.
(v) Deciding, after receipt of the international search report, whether or not to file a demand for international preliminary examination (which must be filed prior to the expiration of 22 months from the priority date.)
(vi) Entering the national phase before the expiration of 20/21 or 30/31 months from the priority date or international filing date, whichever is earlier, by paying the national fees and furnishing (if required) a translation of the International Application with duly verified for its correctness and completeness.

5.10.11 International Search

(i) International Search report is established by the International Searching Authority. For the purpose of Indian applicant following are Competent International Searching Authorities (ISAs).

- Austrian Patent Office (AT)
- Australian Patent Office (AU)
- European Patent Office (EP)
- China Intellectual Property Office (CN)
- United States Patent & Trademark Office (US)
- Swedish Patent Office (SE)

(ii) If the International Application did not claim any priority, the international search report is normally available within nine months from the international
filing date. If priority is claimed, that report is available usually by the 16th month from the priority date. Even where priority is claimed, the international search report is normally available in time before publication of the International Application. This allows time for the applicant to withdraw the application before publication, if desired.

(iii) Indian Patent Office has been recognised as an International Searching Authority and an International Preliminary Examination Authority at the meeting of the General Assemblies of WIPO held in September – October, 2007. Once the Patent Office commences operation as an ISA and an IPEA the international search and examination reports of the international applications filed in the Patent Office will be issued by the office.

5.10.12 PCT FEES (may vary from time to time)

(i) Receiving Office (RO/IN) is The Patent Office, Kolkata, New Delhi, Mumbai and Chennai

(ii) All PCT fees are subject to change periodically. For latest fees, please refer the latest PCT newsletter at URL www.wipo.int.

(a) Transmittal fee: as given in the First Schedule.
(b) International Fee and, Search Fee is given in Annexure II.
(c) Fee for preparing certified copy of priority document in respect of individual or legal entity is given in the First Schedule.

(iii) Failure to pay fees or underpayment of fees can be corrected under PCT rule 16 bis. An invitation to pay missing fees will be issued by the Receiving Office. Payment can be made within a month from International filing date or later with a late payment fee.

(iv) An Indian applicant, filing an International Application under Patent Cooperation Treaty, is required to remit the consolidated amount in US Dollar by Demand Draft, payable to the Controller of Patents at State Bank of India, New York Branch, for payment towards International Filing fee and search fee. The required fees, which must be paid to receiving Office, are the Transmittal Fee, the International Filing Fee and the Search Fee. These fees must be paid to the Receiving Office within the prescribed time.

(v) The Transmittal Fee is for the benefit of the Receiving Office. It is intended to compensate that office for the work, which is required to be performed in connection with the International Application. The amount is fixed by the Receiving Office. It is to be paid within one month from the date of receipt of the International Application.

(vi) The international filing fee is for the benefit of the International Bureau. It is intended to cover the cost of the work; the International Bureau must perform under the PCT. The amounts are fixed in the Schedule of Fees, which forms part of the regulations. The international filing fee is to be paid within one month from the date of receipt of the International Application.
(vii) The Search Fee is for the benefit of the International Searching Authority. It is intended to compensate that Authority for the work it must perform in connection with the establishment of the international search report. It is also to be paid within one month from the date of receipt of the International Application. The amount is fixed by the International Searching Authority.

5.10.13 Withdrawal of Application: An International Application can be withdrawn before technical preparations for international publication have been completed (that is, not later than 15 days before the date of publication, which is 18 months from the priority date).

5.10.14 Amendments: The claims can be corrected for conformity with the results of the international search report by amending them once (under Article 19) with effect in all designated States. Such amendments save costs for preparation of different sets of amendments and for local agents filing such amendments before designated Offices, and guarantee better provisional protection and patents in designated countries. Individual amendments before each Designated Office are also permitted in the national phase (under Article 28 or 41) and all parts of the application can be amended under Article 34(2)) during the international preliminary examination procedure under Chapter II.

5.10.15 International Preliminary Examination

A. International Preliminary Examination is useful in the following ways:

i) It is optional for the applicant;

ii) provides, in addition to the international search report, an international preliminary Examination report containing a second opinion on the usual criteria of patentability before expenses are incurred for the national phase (for translation, fees and foreign agents);

iii) helps the applicant to adapt the International Application in accordance with the results of the International Search Report;

iv) allows, with effect for all elected Offices, the amending of all parts of International Application (description, claims and drawings) during international preliminary examination;

v) The international preliminary examination report gives for minimal cost, an opinion and the probability of obtaining a patent:

vi) If the report is negative and it is decided to abandon the application, the applicant has saved all the expenses otherwise incurred before the elected Offices for the payment of national fees, the preparation of translations and the appointment of local agents. However the opinions from ISA & IPEA are non-binding opinions for the member countries.

B. The following are Competent International Preliminary Examining Authorities (IPEAs) for the purpose of Indian Applicant:

- Austrian Patent Office (AT)
The fees to be paid by the applicant when he opts for Preliminary examination to be carried out by IPEA is given in the PCT Newsletter which is available on the WIPO website, www.wipo.int

5.10.16 National Phase

(i) The national phase follows the international phase. In the national phase before processing and examination in the designated or elected Offices, the applicant must perform certain acts thereby effecting “entry into the national phase”. If the applicant does not enter the national phase, namely, if he does not perform these acts within the prescribed time limit, the International Application loses its effect in the designated or elected States concerned with the same consequences as the withdrawal of any national application in that State (Article 24).

(ii) For entry into the national phase before a designated office, it is necessary that the national fee is paid to it and, where the International Application has not been filed or published in the official language, or one of the official languages of that Office, a duly verified translation into an official language be filed. The time limit for entry into the national phase is 31 months in India.

(iii) The national fees to be paid are usually same as the fees required for the filing of a national or conventional application.

5.10.17 Basic Requirements To Enter National Phase In India

(i) Under the basic requirements to start the national phase in India, the applicant is required to file the national phase application within 31 months from the priority date or International application date, whichever earlier.

(ii) Application may be made in Form 1.

(iii) National fee in INR is to be paid as given in the First Schedule along with the application.

(iv) In case of more than one priority, multiple fees for every multiple priority is to be paid as per the First Schedule.

(v) Where the international application has not been filed or published in one of the official languages (Hindi or English), a translation of the application, description, claims (if amended, both as originally filed and amended together with any statement under PCT Article 19 and Article 39(1)), drawings, if any, and abstract should be submitted along with the application.

(vi) Additional Special Requirements:
Under the said additional special requirements (PCT Rules 51 bis), no designated Office is to require before the expiration of the applicable time limit for entering the national phase, the performance of acts other than those referred to in Article 22, namely the payment of the national fee, furnishing of a translation and, in exceptional cases, the furnishing of a copy of the international application, and indication of the name and address of the inventor. All other requirements of the national law are referred as “special requirements” and they may be complied with once national processing has started. As per DO/IN or EO/IN the special requirements of the Office are as follows:

a) Name, nationality and address of the inventor if they have not been furnished in the “Request” part of the international application,

b) Instrument of assignment or transfer where the applicant is not the inventor.

c) Document evidencing a change of name of the applicant if the change has occurred after the international filing date and has not been reflected in a notification from the International Bureau (Form PCT / IB/ 306). Form 6 and/or Form 13 are also required.

d) Declaration of inventorship by the applicant,

e) Statement regarding filing of corresponding applications in other countries,

f) Power of attorney if an agent is appointed,

g) Address for service in India (but representation by an agent is not a must)

h) Verification of translation, and Copy of International application or its translation
CHAPTER VI

PUBLICATION AND EXAMINATION OF APPLICATIONS

6.1 Publication of applications

Section 11.

(1) Save as otherwise provided, no application for patent shall ordinarily be open to the public for such period as may be prescribed.

(2) The applicant may, in the prescribed manner, request the Controller to publish his application at any time before the expiry of the period prescribed under sub-section (1) and subject to the provisions of sub-section (3), the Controller shall publish such application as soon as possible.

(3) Every application for a patent shall, on the expiry of the period specified under sub-section (1), be published, except in cases where the application—

(a) in which secrecy direction is imposed under section 35; or
(b) has been abandoned under sub-section (1) of section 9; or
(c) has been withdrawn three months prior to the period specified under sub-section (1).

(4) In case a secrecy direction has been given in respect of an application under section 35, then it shall be published after the expiry of the period prescribed under sub-section (1) or when the secrecy direction has ceased to operate, whichever is later.

(5) The publication of every application under this section shall include the particulars of the date of application, number of application, name and address of the applicant identifying the application and an abstract.

(6) Upon publication of an application for a patent under this section—

(a) the depository institution shall make the biological material mentioned in the specification available to the public;
(b) the patent office may, on payment of such fee as may be prescribed, make the specification and drawings, if any, of such application available to the public.

(7) On and from the date of publication of the application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for the invention had been granted on the date of publication of the application:

Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been granted.
Provided further that the rights of a patentee in respect of applications made under sub-section (2) of section 5 before the 1st day of January, 2005 shall accrue from the date of grant of the patent:

Provided also that after a patent is granted in respect of applications made under sub-section (2) of section 5, the patent-holder shall only be entitled to receive reasonable royalty from such enterprises which have made significant investment and were producing and marketing the concerned product prior to the 1st day of January, 2005 and which continue to manufacture the product covered by the patent on the date of grant of the patent and no infringement proceedings shall be instituted against such enterprises.

Section 143.

Restrictions upon publication of specification;
Subject to the provisions of Chapter VII, an application for a patent, and any specification filed in pursuance thereof, shall not, except with the consent of the applicant, be published by the Controller before the expiration of the period prescribed under sub-section (1) of section 11A or before the same is open to public inspection in pursuance of sub-section (3) of section 11A or section 43.

Rule 11:

Order of recording applications.
The applications filed in a year shall constitute a series identified by the year of such filing. In case of an application filed corresponding to an international application in which India is designated, such application shall constitute a series distinct from the rest of the applications identified by the year of filing of corresponding applications in India.

Rule 24:
Publication of application
The period for which an application for patent shall not ordinarily be open to public under sub-section (1) of section 11A shall be eighteen months from the date of filing of application or the date of priority of the application, whichever is earlier.

Provided that the period within which the Controller shall publish the application in the Journal shall ordinarily be one month from the date of expiry of said period, or one month from the date of request for publication under rule 24A.

Rule 24:
Request for publication;
A request for publication under sub-section (2) of section 11A shall be made in Form 9.
Rule 25:
Identification of published applications:
Publication of application under sub-sections (2) and (5) of section 11A shall be identified by the letter 'A' along with the number of application.

Rule 26:
Request for withdrawal:
A request for withdrawing the application under sub-section (4) of section 11B shall be made in writing.

Rule 27:
Inspection and supply of published documents;

After the date of publication of the application under section 11A, the application together with the complete specification and provisional specification, if any, the drawing, if any, and the abstract filed in respect of the application may be inspected at the appropriate office by making a written request to the Controller on payment of the fee in that behalf and copies thereof may be obtained on payment of fees specified in the First Schedule.

6.1.1 Numbering of Application: Patent Office accords an application number and filing date to the application immediately after filing by the applicant, such that the applications filed in a year constitute the series identified by the year of such filing. PCT National Phase applications constitute a different series (Rule 11).

6.1.2 Screening of Applications: All the applications will be screened and have International Patent Classification to categorize the invention to the respective field of technology. Simultaneously, the applications are screened to find whether the invention is relevant for defence and atomic energy purpose so that the necessary procedure can be initiated.

6.1.3 Publication of Applications: A) No application for patent shall ordinarily be open to public before the publication by Patent Office under section 11A. At the end of 18 months period, the application will be published in the official journal except in the cases where,

i) Secrecy direction is imposed u/s 35

ii) The application has been abandoned u/s 9(1)

iii) It has been withdrawn three months prior to the publication period i.e. before the end of 15th month from the date of filing or priority, whichever is earlier [S.11(A)].

In case a secrecy direction has been given, the application will be published after expiry of the 18-month period or when the secrecy direction is lifted off, whichever is later (S. 11A(4)).
6.1.4 **Early Publication:** If the applicant makes a request in Form 9 (before the expiry of 18 months from the date of priority if no priority claimed from the date of filing) with the prescribed fee (Rs.2,500/- for natural person(s) and Rs.10,000 for legal entity [other than natural person(s)]), the application will be published within one month from the date of filing of such request.

6.1.5 **Particulars of Publication:**


b) The publication U/S 11A will be identified by the letter “A” along with the Number of Application

c) Publication of patent application includes information on the following parameters as may be applicable to a particular case

   (a) Number of application
   (b) Date of filing of application
   (c) Title of invention
   (d) Publication date
   (e) International Patent Classification
   (f) Name and address of the applicant
   (g) Name of the inventor(s)
   (h) Priority details like document number, date, country, PCT application number and date, etc
   (i) Patent of Addition to / Divisional Application to: along with filing date of the parent application /
   (j) Abstract of the Invention including drawing (if any)

6.1.6 **Effects Of Publication:**

(i) After publication of the application for patent the depository institution will make the biological material (mentioned in the specification) available to the public

(ii) The Patent office will make the specification (complete as well as provisional, if any), and drawings filed in respect of the application available to the public on payment of the prescribed fee as given in the First Schedule.

(iii) The applicant shall have like privileges and rights, as if a patent for the invention had been granted from the date of publication of the application until the date of grant. But he shall not be entitled to institute any proceedings for infringement until the patent has been granted.
(v) The rights of patentee for applications filed u/s 5(2) before 1st day of January, 2005 will accrue from the date of grant of the patent.

### 6.2 EXAMINATION OF APPLICATIONS

#### Section 11 Request for examination

(1) No application for a patent shall be examined unless the applicant or any other interested person makes a request in the prescribed manner for such examination within the prescribed period.

(2) Omitted by Act 15 of 2005

(3) In case of an application in respect of a claim for a patent filed under sub-section (2) of section 5 before the 1st day of January, 2005 a request for its examination shall be made in the prescribed manner and within the prescribed period by the applicant or any other interested person.

(4) In case the applicant or any other interested person does not make a request for examination of the application for a patent within the period as specified under sub-section (1) or sub-section (3), the application shall be treated as withdrawn by the applicant:

Provided that—

(i) the applicant may, at any time after filing the application but before the grant of a patent, withdraw the application by making a request in the prescribed manner; and

(ii) in a case where secrecy direction has been issued under section 35, the request for examination may be made within the prescribed period from the date of revocation of the secrecy direction.

#### Section 12 Examination of application;

(1) When a request for examination has been made in respect of an application for a patent in the prescribed manner under sub-section (1) or sub-section (3) of section 11B, the application and specification and other documents related thereto shall be referred at the earliest by the Controller to an examiner for making a report to him in respect of the following matters, namely:—

(a) whether the application and the specification and other documents relating thereto are in accordance with the requirements of this Act and of any rules made thereunder;

(b) whether there is any lawful ground of objection to the grant of the patent under this Act in pursuance of the application;

(c) the result of investigations made under section 13; and
(d) any other matter which may be prescribed.

(2) The examiner to whom the application and the specification and other documents relating thereto are referred under sub-section (1) shall ordinarily make the report to the Controller within such period as may be prescribed.

**Rule 24 B: Examination of application.**

(1) (i) A request for examination under section 11 B shall be made in Form 18 within forty-eight months from the date of priority of the application or from the date of filing of the application, whichever is earlier;

(ii) The period within which the request for examination under sub-section 3 of section 11B to be made shall be forty-eight months from the date of priority if applicable, or forty-eight months from the date of filing of the application;

(iii) The request for examination under sub-section (4) of section 11B shall be made within forty-eight months from the date of priority or from the date of filing of the application, or within six months from the date of revocation of the secrecy direction, whichever is later;

(iv) The request for examination of application as filed according to the 'Explanation' under sub-section (3) of section 16 shall be made within forty-eight months from the date of filing of the application or from the date of priority of the first mentioned application or within six months from the date of filing of the further application, whichever is later;

(ii) The period for making request for examination under section 11B, of the applications filed before the 1st day of January, 2005 shall be the period specified under the section 11B before the commencement of the Patents (Amendment) Act, 2005 or the period specified under these rules, whichever expires later.

(2) (i) The period within which the Controller shall refer the application and specification and other documents to the examiner in respect of the applications where the request for examination has been received shall ordinarily be one month from the date its publication or one month from the date of the request for examination whichever is later:

Provided that such reference shall be made in order in which the request is filed under sub-rule (1).

(ii) The period within which the examiner shall make the report under sub-section (2) of section 12, shall ordinarily be one month but not exceeding three months from the date of reference of the application to him by the Controller;

(iii) the period within which the Controller shall dispose off the report of the examiner shall ordinarily be one month from the date of the receipt of the such report by the Controller.
A first examination report along with the application and specification shall be sent to the applicant or his authorised agent ordinarily within six months from the date or the request for examination or six months from date of publication whichever is later. In case other interested person files the request for examination, an intimation of such examination may be sent to such interested person.

The time for putting an application in order for grant under section 21 shall be twelve months from the date on which the first statement of objection is issued to the applicant to comply with the requirements.

**Section 13:**
**Search for anticipation by previous publication and by prior claim;**

(1) The examiner to whom an application for a patent is referred under section 12 shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification—

(a) has been anticipated by publication before the date of filing of the applicant's complete specification in any specification filed in pursuance of an application for a patent made in India and dated on or after the 1st day of January, 1912;

(b) is claimed in any claim of any other complete specification published on or after the date of filing of the applicant's complete specification, being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.

(2) The examiner shall, in addition, make such investigation for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been anticipated by publication in India or elsewhere in any document other than those mentioned in sub-section (1) before the date of filing of the applicant's complete specification.

(3) Where a complete specification is amended under the provisions of this Act before the grant of patent, the amended specification shall be examined and investigated in like manner as the original specification.

(4) The examination and investigations required under section 12 and this section shall not be deemed in any way to warrant the validity of any patent, and no liability shall be incurred by the Central Government or any officer thereof by reason of, or in connection with, any such examination or investigation or any report or other proceedings consequent thereon.

**Rule 28:**
**Procedure in case of anticipation by prior publication;**

(1) If the Controller is satisfied after investigation under section 13 that the invention so far as claimed in any claim of the complete specification has been published in any specification or other document referred to in clause (a) of sub-section (1) or subsection (2) of the said section, the Controller shall communicate the gist of specific objections and the basis thereof to the
applicant and the applicant shall be afforded an opportunity to amend his specification.

(2) If the applicant contests any of the objections communicated to him by the Controller under sub-rule (1), or if he refills his specification along with his observations as to whether or not the specification is to be amended, he shall be given an opportunity to be heard in the matter if he so requests:

Provided that such request shall be made on a date earlier than ten days of the final date of the period referred to under sub-section (1) of section 21:

Provided further that a request for hearing may be allowed to be filed within such shorter period as the Controller may deem fit in the circumstances of the case.

(3) If the applicant requests for a hearing under sub-rule (2) within a period of one month from the date of communication of the gist of objections, or, the Controller, considers it desirable to do so, whether or not the applicant has refilled his application, he shall forthwith fix a date and time for hearing having regard to the period remaining for putting the application in order or to the other circumstances of the case.

(4) The applicant shall be given ten days' notice of any such hearing or such shorter notice as appears to the Controller to be reasonable in the circumstances of the case and the applicant shall, as soon as possible, notify the Controller whether he will attend the hearing.

(5) After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Controller may specify or permit such amendment of the specification as he thinks fit to be made and may refuse to grant the patent unless the amendment so specified or permitted is made within such period as may be fixed.

Rule 28A:
Procedure in relation to consideration of report of examiner under section 14;

In case the applicant contests any of the objections communicated to him, the procedure specified under rule 28 may apply.

Rule 29:
Procedure in case of anticipation by prior claiming.

(1) When it is found that the invention so far as claimed in any claim of the complete specification, is claimed in any claim of any other specification falling within clause (b) of sub-section (1) of section 13, the applicant shall be so informed and shall be afforded an opportunity to amend his specification.

(2) If the applicant's specification is otherwise in order for grant and an objection under clause (b) of sub-section (1) of section 13 is outstanding, the Controller may postpone the grant of patent and allow a period of two months for removing the objection.
Rule 30:
Amendment of the complete specification in case of anticipation;

(1) If the applicant so requests at any time, or if the Controller is satisfied that the objection has not been removed within the period referred to in sub-rule (2) of rule 29, a date for hearing the applicant shall be fixed forthwith and the applicant shall be given at least ten days’ notice of the date so fixed. The applicant shall, as soon as possible, notify the Controller whether he will attend the hearing.

(2) After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Controller may specify or permit such amendment of the specification as will be to his satisfaction to be made and may direct that reference to such other specification, as he shall mention shall be inserted in the applicant’s specification unless the amendment is made or agreed to within such period as he may fix.

Section 14:
Consideration of the report of examiner by Controller:

Where, in respect of an application for a patent, the report of the examiner received by the Controller is adverse to the applicant or requires any amendment of the application, the specification or other documents to ensure compliance with the provisions of this Act or of the rules made there under, the Controller, before proceeding to dispose of the application in accordance hereinafter appearing, shall communicate as expeditiously as possible the gist of the objections to the applicant and shall, if so required by the applicant within the prescribed period, give him an opportunity of being heard.

Section 144:
Reports of examiners to be confidential.—

The reports of examiners to the Controller under this Act shall not be open to public inspection or be published by the Controller; and such reports shall not be liable to production or inspection in any legal proceeding unless the court certifies that the production or inspection is desirable in the interests of justice, and ought to be allowed.

Section 15:
Power of Controller to refuse or require amended applications, etc., in certain case:

Where the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made there under, the Controller may refuse the application or may require the application, specification or the. Other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application and refuses the application on failure to do so.
Section 16:
Power of Controller to make orders respecting division of application:

(1) A person who has made an application for a patent under this Act may, at any time before the grant of the patent, if he so desires, or with a view to remedy the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first mentioned application.

(2) The further application under sub-section (1) shall be accompanied by a complete specification, but such complete specification shall not include any matter not in substance disclosed in the complete specification filed in pursuance of the first mentioned application.

(3) The Controller may require such amendment of the complete specification filed in pursuance of either the original or the further application as may be necessary to ensure that neither of the said complete specifications includes a claim for any matter claimed in the other.

Explanation.—For the purposes of this Act, the further application and the complete specification accompanying it shall be deemed to have been filed on the date on which the first mentioned application had been filed, and the further application shall be proceeded with as a substantive application and be examined when the request for examination is filed within the prescribed period.

Section 17:
Power of Controller to make orders respecting dating of application:

(1) Subject to the provisions of section 9, at any time after the filing of an application and before the grant of the patent under this Act, the Controller may, at the request of the applicant made in the prescribed manner, direct that the application shall be post-dated to such date as may be specified in the request, and proceed with the application accordingly:

Provided that no application shall be post-dated under this sub-section to a date later than six months from the date on which it was actually made or would, but for the provisions of this sub-section, be deemed to have been made.

(2) Where an application or specification (including drawings) or any other document is required to be amended under section 15, the application or with the provisions specification or other document shall, if the Controller so directs, be deemed to have been made on the date on which the requirement is complied with or where the application or specification or other document is returned to the applicant on the date on which it is re-filed after complying with the requirement.
6.2.1 Examination Of Patent Application: After publication of application, the next stage of processing of patent application is examination as to whether the patent can be granted for the invention as contained in complete specification. Examination stage is subject to filing request for examination u/s 11(B). This system of examination is called Deferred Examination System. The basic criteria for an invention to qualify for a patent grant is that it must have novelty, inventive step and capability of industrial application and also it should not fall under any of the categories of non-patentable inventions. This chapter explains how the criteria of patentability is examined and various relevant steps involved in the patent grant procedure starting from filing patent application laid down by the provisions of the Patents Act are checked during the examination of patent application.

6.2.2 Request for Examination

i) The application will be taken up for examination only on request made by the applicant or by any other interested person in Form -18. Such a request is required to be made within 48 months from the date of priority or from the date of filing, whichever is earlier, with the prescribed fees as given in the First Schedule.

“Person interested” (section 2(1)(t) includes a person engaged in, or in promoting research in the same field as that to which the invention relates. Any person including an organization that has a manufacturing or trading interest in the goods connected with the patented article or who has a financial interest in manufacturing such goods or who possesses patents related to the same subject, is considered a person interested.

ii) Request for examination can be made by the applicant or any other person interested. In case of other than applicants filing the request, it shall be supplemented with the evidence of interest.

(iii) In case of PCT-National Phase applications(PCT-NP), processing of the application starts only after expiry of 31 month-period from its priority date (Rule 20(2) and 20(4)). However an express request can be filed for early processing or examination, any time earlier than the prescribed time of 31 months, in Form 18 along with the prescribed fee as given in First Schedule, whereupon these applications may be taken up for examination before the said period

iv) All the applications will be screened to categorize the invention to the respective field of technology and to find whether the invention is relevant for defence purposes etc. so that the necessary procedures can be initiated in respect of those applications.

v) In respect of applications filed u/s 5(2), filed before the 1st day of January 2005, the request should be made within a period of 48 months from the date of priority (if applicable) or date of filing of the application.
vi) If no request for examination is made within the prescribed period the application will be treated as withdrawn by the applicant [section 11B (4)]

vii) In case of applications in which secrecy direction is imposed, the date of filing the request shall be with in 48 months from the date of filing the application or priority or six months from the date of revocation of such secrecy direction, whichever expires later.

viii) The request for examination in case of divisional application shall be filed within 48 months from the date of filing or priority of the parent application or within six months from the date of filing the divisional application, whichever expires later. Request for divisional application shall be filed only after filing request for the parent application to ensure the requirement of section 16(3).

6.2.3 Request for Withdrawal: The applicant can, however, withdraw his application at any time after filing the application but before the grant of a patent by making a request to that effect in writing with prescribed fee under entry No.23 of the First Schedule of the Patents Rules 2003. [section 11B (4) (i), R. 26].

6.2.4 Advantages of Deferred Examination System

(a) By making an application for patent, an applicant/inventor obtains the date of patent and, hence priority also, without paying the fee for examination

(b) An applicant/inventor gets recognition as the owner of the invention because of ‘18 month publication’, even if the application is not examined.

(c) Request for examination can be delayed up to 48 months so that the applicant can obtain financial support to exploit invention.

(d) A person who is interested in the commercial value of the invention can request for examination and get the license for patent later after consultation with the applicant.

(e) If the applicant wishes, he can withdraw the application before the end of 15th month of filing an application to prevent the publication, so that its novelty will not be lost (section 11B (4)(i), 11A(3)(c))

6.2.5 Two stages of Examination of Patent Application at Patent Office

(i) Formal examination and
(ii) Substantive / Technical examination

6.2.6 Formal Examination: The application for a patent, as filed, including all the relevant documents, payments etc are checked/scrutinized to ensure that the same
are filed or submitted in conformity with the provisions of the Patents Act and Rules. [section 12 (1)(a)]

a) **Formal scrutiny/checking is carried out in respect of the following documents**-

   (i) All relevant forms, request, petitions, assignment deeds, translation etc.,
   (ii) Payment of fees and other details,
   (iii) Provisional and/or complete specification,
   (iv) Abstract,
   (v) Drawings (if any),
   (vi) Presence of meaningful claim(s) or absence of claims in a complete specification,
   (vii) Proof of right,
   (viii) Form 5 (along with complete after provisional or for filing PCT-NP/Convention application)
   (ix) Power of Attorney or attested copy of General Power of Attorney (if any)
   (x) Form 3 -information regarding foreign filing u/s 8(1).
   (xi) Whenever Form 6 is filed and assignment has taken place from individual to other than individual, difference in fee has to be called for (Rule 7(3)).

b) **Screening**

Screening is carried out for the following -

a) Technical fields of invention
b) Relevance to defence or atomic energy
c) International and Indian Classification
d) Correction/completing the abstract, if required.

c) After scrutiny of the documents, the lacunae, if any, in the application will be communicated to the applicant in FER.

### 6.2.7 Substantive /Technical Examination

a) **Substantive examination mainly involves exploring the following technical and legal matters by the examiner**-

   i. Whether the specification complies with the requirements of section 10 regarding contents of the specification
   ii. Whether the subject matter is an invention within the meaning of section 2(1) (j), based on the criteria of novelty, inventive step and industrial applicability.
   iii. Classification and conducting of search for anticipation by previous publication in any document in India and elsewhere and prior claiming in the patent applications filed in India.
   iv. Whether the invention is one, which is not patentable under sections 3 & 4 of the Patents Act.

b) **Steps involved in Substantive Examination**
i. Assessment of patentability of the subject matter
ii. Assessment of sufficiency of disclosure
iii. Check for unity of invention
iv. Appraisal of Industrial applicability
v. Classification of the invention
vi. Novelty search
vii. Determination of the inventive step
viii. Judgment of validity of claims
ix. Disclosure of geographical origin of the Biological material
x. Permission from National Bio diversity Authority.

c) Examination of Industrial Applicability is based on the technical documentation in the patent application dossier (description, drawings, claims etc.), while the examination of novelty and inventive step requires documentary search for the assessment of prior art.
d) Before examination of novelty and inventive step, it is necessary to check whether the invention is fully defined
e) Novelty is determined before inventive step because the creative contribution of the inventor can be assessed only by knowing the novel element of the invention, which can justify it.
f) The examiner conducts novelty search to see whether the invention claimed in any claim of the complete specification has been anticipated by any of the following documents for the purpose of judging the novelty and inventive step of the invention.

i. Indian patent specifications published before the date of filing of the application, but on or after 1st January, 1912 - [(section 13 (1)(a)] (Prior publication)

ii. Indian patent specifications which are filed before the date of filing of the present case or claiming a priority date earlier to the said date, but the publication of that document was effected on or after the filing date (section 13(1) (b) – (Prior claiming)

iii. Any publication in India or elsewhere in any document other than Indian Patent Specifications as mentioned above (section 13(2) Prior publication including traditional knowledge in any form.

g) For establishing novelty of the invention, the requirement holds that all the features from the independent claim should be described in a single document. When even a single feature is missing from the cited document, the claim may be considered as novel. It is also necessary that all the features be described in the same combination in the single document.

h) According to international standards the novelty search results in the following documents, which form citation for the invention. Description for each type of the documents, Types – A, E, L, O, P, and T, X, Y is given below. The citations of the type X and Y are very important as they explicitly indicate lack of novelty and obviousness as per the search report prepared by the International Authority.
i) Special Categories of Cited Documents:

<table>
<thead>
<tr>
<th>Type</th>
<th>Description of Document</th>
</tr>
</thead>
<tbody>
<tr>
<td>“A”</td>
<td>Document defining the general state of the art which is not considered to be of particular relevance</td>
</tr>
<tr>
<td>“E”</td>
<td>Earlier document but published on or after the international filing date</td>
</tr>
<tr>
<td>“L”</td>
<td>Document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)</td>
</tr>
<tr>
<td>“O”</td>
<td>Document referring to an oral disclosure, use, exhibition or other means</td>
</tr>
<tr>
<td>“P”</td>
<td>Document published prior to the international filing date but later than the priority date claimed</td>
</tr>
<tr>
<td>“T”</td>
<td>Later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention.</td>
</tr>
<tr>
<td>“X”</td>
<td>Document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone</td>
</tr>
<tr>
<td>“Y”</td>
<td>Document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents; such combination being obvious to a person skilled in the art.</td>
</tr>
<tr>
<td>“&amp;”</td>
<td>Document member of the same patent family</td>
</tr>
</tbody>
</table>
6.2.8 Procedure for Substantive Examination

(i) Applications is to be taken up for examination according to the order in which the Request for Examination has been made.

(ii) Where the request for examination has been received, the Controller shall refer the application, specification and other document to the examiner in respect of the application, ordinarily within one month from the date of publication or request for examination, whichever is later [Rule 24 B (2)]

(iii) The Controller refers the application to an examiner to make a report to him on

   i) Whether the application, specification and other document are in accordance with the requirements of the Patents Act & Rules
   ii) Whether there is any objection to grant of patent
   iii) Results of search for anticipation made under Section 13

(iv) The examiner shall make a report to the Controller on the above matters ordinarily within a period of 1 month but not exceeding three months from the date of such reference.

(v) The Controller shall dispose the report of the examiner ordinarily within one month from the date of the receipt of such report.

(vi) This Report is called the First Examination Report (FER).

(vii) The time for putting the application in order for grant is 12 months from the date of FER.

6.2.9 Issuing First Examination Report And Procedures Thereafter:

i. A gist of objections made by the examiner will be communicated to the applicant in the First examination Report (FER). A FER along with the application and specification is sent to the Applicant or his Authorized Agent ordinarily within six months from the date of request for examination or six months from the date of publication, whichever is later?

ii. In case, any other interested person files the request for examination, an intimation of such examination of the application may be sent to such interested person.

iii. If any of the objections require amendment of the application, specification or drawings to ensure compliance with the provisions of the Act or the Rules, the same will be communicated to the applicant along with the FER.

iv. The applicant will be allowed to carry out the necessary amendments of the application, specification or drawings.

v. The amended documents (retyped sheets, if necessary) along with the superseded pages, if any, duly marked, cancelled and initialled by the applicant or his agent will be returned to the Controller. Copies of any pages that have...
been added or retyped and any drawing that has been added or substantially amended shall be submitted in duplicate.

vi. The amended documents together with the specification will be examined again in the same way as the original specification (S.13 (3)).

vii. The applicant will be given an opportunity of being heard, if he so requests, when the examination report is adverse to him and he contests any of objections or refiles his specification along with his observations regarding amendments of the same (S. 14 & R.24 (B), R28). The request for such hearing should made at least 10 days before the expiry date

viii. There can be one or more correspondences after the issue of FER. However, the time for meeting the objections and putting the application in order for grant is 12 months from the date of issue of FER (S. 21(1), failing which the application will be abandoned.

ix. Examination procedure carried out under section 12 and 13 shall not be deemed in any way to warrant the validity of any patent, and no liability shall be incurred by the Central Government or any officer thereof because of any such examination or investigation or any report or other proceedings consequent thereon.

6.2.10 In 1999 (19) PTC 479, it was held that registration of patent does not entitle any presumption of validity in favour of patent in spite of investigation before its registration. Section 13(4) of the Patents Act provides that the examination and investigations required under sections 12 & 13 shall not be deemed in any way to warrant the validity of any patent, and no liability shall be incurred by the Central Government or any officer thereof by reason of, or in connection with, any such examination or investigation or any report or other proceedings consequent thereon. Thus, grant of patent in any manner does not guarantee the validity of the patent. Reference may also be made to the provisions of Section 64 of the Patents Act which deals with revocation of patents. It provides that a patent whether granted before or after the commencement of the Act, may, on the petition of any person interested or of the Central Government or on a counter-claim in a suit for infringement of the patent, be revoked by the High Court on the ground that the subject of any claim of the complete specification is not an invention within the meaning of this Act or that the invention so far as claimed in any claim of the complete specification is not new having regard to what was publicly known or publicly used in India before the priority date of the claim or to what was published in India or elsewhere in any of the documents referred to in Section 13 or that the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step, having regard to what was publicly known or publicly used in India or what was published in India or elsewhere before the priority date of the claim. Despite all the safeguards and circumspection contemplated in various provisions of the Act against grant of patent in respect of a spurious, purloined or fake invention, the Legislature minced no words in clarifying its intendment that no presumption of validity would attach to a patent granted by the Controller under the Act, notwithstanding examination and investigation made under Sections 12 & 13 there of.
6.2.11 **Practice for Examination of Patent Application:** Examination of Patent Applications is carried out in the Patent Office as per criteria set up in the EXAMINATION FORMAT as follows:

### EXAMINATION FORMAT FOR PATENT APPLICATION

<table>
<thead>
<tr>
<th>PATENT APPLICATION NO.</th>
<th>(i) NORMAL</th>
<th>(ii) PCT NATIONAL PHASE</th>
</tr>
</thead>
</table>

**Kind of Application:**

**APPLICATION**

1. Form of Application -Form 1
2. Name, Nationality and Address of Applicant
3. Title
4. Provisional / Date Complete / Date
5. Names, Nationality & address of –
   (a) Assignor -
      (i) Inventor
      (ii) Applicant in convention country
   (b) The deceased who had right to make application.
6. Endorsement by or assignment from inventor or Applicant in convention country or authority In favour of legal representative.
7. Death Certificate & proof of title Of the legal representative
8. Date & Signature
9. Duplicate
10. Miscellaneous
11. (1) Request for Examination No……………………………
    Date………………………….
    Filed by………………………
    Fee…………………………
    (2) Pre-grant Opposition
     Name of person making representation
     Date of filing of representation

**PCT NATIONAL PHASE**

**GENERAL**

12. Date of Entry in to National Phase (Chapter I/II)
13. International PCT Application No. /Publication no.
14. Date of Earliest priority of filing
15. Entry in National Phase within prescribed time  yes / no
16. Whether India Designated/Elected yes / no
17. International Search Report received yes / no
18. Preliminary Examination report received yes / no
19. Miscellaneous yes / no

CONVENTION APPLICATION

20. (1) No. Of Priority
    (2) Priority date/dates
    (3) Application made within 12 months
     From first application in a convention country

21. Certified copy/copies
22. Petition for extension of time
23. Name(s) of applicant(s) in convention country
24. No. of priorities claimed at the time
     of International filing
25. Fee paid for priority/priorities
26. Certified copy/copies filed at the time
     of entry into National Phase, Date of filing of certified copy/copies
27. Translated Priority document filed on _____________
28. Certificate of authentication of translation
29. Priority Date/dates
30. Name of Country/Inter Governmental Organisation

AUTHORISATION

31. Name, address and nationality of applicant
32. Name and address of the registered Patent agent/agents
33. Title

34. Date and signature
35. Stamped
36. Miscellaneous

STATEMENT AND UNDERTAKING (Section 8, Rule 12)

37. Prescribed form
38. Name, address and nationality of applicant
39. Title
40. Date and signature
41. Miscellaneous
42. Application, if any, made in foreign countries,
   a. Prior filing - Petition under section 8(1).
   b. Post filing - Extension under rule 138.
   c. Extension under section 8(2).........F(4)

SPECIFICATION

Provisional Specification filed on ____________________

43. Prescribed form 2
44. Name, address and nationality of the applicants
45. Title
Complete Specification filed on ____________________________

53. Prescribed, form 2
54. Name, address and nationality of applicant
55. Title
56. Preamble to description
57. Reference to drawings
58. Reference to original patent
59. Statement of claims (containing claims)
60. Date and signature
61. Duplicate
62. Miscellaneous
63. Abstract
64. Size of the document
   a. Language
   b. Electronic form
   c. Sequence in Electronic Form
   d. Numbering of pages

DECLARATION OF INVENTORSHIP

65. Prescribed form
66. Name of applicant
67. Name, address and nationality of inventors
68. Date and signature
69. Assent by the inventor

DRAWINGS

70. Not filed in time-post-dating
71. Reproducible
72. Name and signature
73. Number of sheets
74. Figures of drawings
75. Descriptive matter and measurement
76. Duplicate
77. Miscellaneous

GENERAL

78. Request for amending or correcting
   (a) Application
   (b) Specification
   (c) Drawings
79. Request for post-dating of an application
80. Specification and drawings generally unsatisfactory
PROVISIONAL / COMPLETE SPECIFICATION

81. DESCRIPTION - Clear -
   (a) Not in clear English
   (b) English equivalent necessary in respect of
   (c) Not clear in respect of where indicated in
   (d) Description in page inconsistent with
   (e) Distinguishing features as compared
       With prior art given is not clear
   (f) Drawings to be separated from specification

82. DESCRIPTION - sufficient -
   (a) Further description necessary
   (b) Revision necessary where indicated
   (c) Drawings required
   (d) Biological materials
       (i) Deposit in authorised depository Institution
       (ii) Date of Deposit
       (iii) Date/number of deposit in the specification
       (iv) Source/Geographical origin in the specification
   (e) Model or sample required

83. DESCRIPTION - references -
   (a) Reference to foreign patent applications/patents
       (i) Should be replaced by Indian specification;
       (ii) Or modified by substituting the serial number
           of the published British specification;
       (iii) Or replaced or supplemented by equivalent or
           Supplemented by equivalent description.
   (b) Co-pending application No. Necessary
   (c) Co-pending application in page to be completed
   (d) Prior patent in page insufficient
   (e) Distinguishing features with reference to Prior specification necessary
   (f) Grant deferred in view of unpublished Co-pending application

84. DESCRIPTION - Clerical errors -
   (a) In page to be corrected.

85. DRAWINGS - clear -
   (a) Figures not numbered.
   (b) Sectional lines not marked in figures.
   (c) Reference letter (numerals) not marked in figures.
   (d) Same reference letters used for different parts – (in figures)
   (e) Part denoted by reference letter in figure(s)
       Not same as that denoted by it in page.
   (f) Do / does not clearly illustrate
       Features described in pages.

86. DRAWINGS - sufficient -
   (a) Arrangement described in page or / and Claimed in claim should be illustrated.
87. **CLAIMS - clear -**
   (a) Claims not clear in respect of the expression.
   (b) Claims not clearly worded.

88. **CLAIMS - succinct -**
   (a) Unnecessary repetition
   (b)Verbose
   (c) Large number
   (d) Claim redundant.

89. **CLAIMS - definitive -**
   (a) Claims do not sufficiently define the invention.
   (b) Claim not sufficiently definitive in the absence of explicit statement of invention.

90. **CLAIMS - consistent -**
   (a) Claims not consistent with description in page.
   (b) Claims not supported by description.
   (c) Claims not fairly based on the matter disclosed in the specification.

91. **TITLE - appropriate -**
   (a) Inconsistent with description and claims

92. **TITLE - precise -**
   (a) Not precise.
   (b) Not clear in respect of word(s).
   (c) Vernacular word to be replaced.
   (d) Does not sufficiently indicate the subject.
   (e) Suitable amendments indicated.

93. **ABSTRACT**
   (a) Title
   (b) Concise summary
   (c) Size
   (d) Reference numerals of the Drawings
   (e) Searchable

94. **PATENTABILITY AND PRE-GRANT OPPOSITION**

   **(A) Sufficiency of description**
   (i) Complete Specification does not sufficiently and clearly describe the invention
   (ii) Complete specification does not describe the method by which the invention is to be performed.
   (iii) Non-disclosure or wrongful mentioning of source and geographical origin of biological material

   **(B) Subject matter**
   (a) (I) does not constitute an ‘invention’ under Section 2 (1) (j)
      (ii) Inventive step / non obvious
      (iii) Industrial application
   (b) Claims fall within the scope of Section 3
      (i) Invention frivolous / contrary to natural laws
      (ii) Contrary to public order / morality
      (iii) Prejudice to human / animal / plant life
Or health or environment

(iv) Mere discovery of a scientific principle or abstract theory or discovery of any living thing or non-living Substances occurring in nature

(v) Mere discovery of any new property / mere new use For a known substance / mere use of a known Process, machine or apparatus

\textit{Differing significantly in properties with regard to efficacy?}

(vi) Substance obtained by a mere admixture resulting only in the Aggregation of the properties or a process for producing such Substance

(vii) the mere arrangement or re-arrangement or duplication Of known devices each functioning independently

(viii) Method of agriculture / horticulture

(ix) Process for the medicinal / surgical / curative / prophylactic Diagnostic / therapeutic / other treatment of human beings Or any process for a similar treatment of animals

(x) Plants and animals in whole or any part thereof including Seeds, varieties and species / essentially biological processes For production or propagation of plants and animals

(xi) Computer programme per se other than its technical application to Industry or a combination with hardware

(xii) Mathematical method / business method / algorithms

(xiii) Literary, dramatic, musical or artistic work or any other aesthetic Creation including cinematographic works and television productions

(xiv) Mere scheme or rule or method of performing mental act / Method of playing game

(xv) A presentation of information

(xvi) Topography of integrated circuits

(vie) traditional knowledge or an aggregation or duplication of known Properties of traditionally known components

(c) Claims not allowable under section 4

(d) Is not proper for a patent of addition

(e) Statement of claim(s) not definitive in view of what admittedly known, see page of the specification

C. Novelty:

(a) Invention anticipated by

(i) prior publication

(ii) prior claiming

(b) Claim (s) of conflict(s) with claim (s) of

(c) Invention claimed in claim (s) prime facie lacking in novelty

(d) Specification not clearly worded

(e) Consideration deferred

D. Single Invention:

(a) Claims define a plurality of distinct inventions.

(b) Each claims relates to an independent invention

(c) Claim(s) relate (s) to an invention distinct from the rest

(d) Consideration deferred

95. **IDENTITY** - date -

(a) Not allowable as an earlier application in respect of identical invention was filed in
96. **IDENTITY - Subject matter**

(a) Does not constitute one invention or a group of invention so as to make a single invention. The application should be divided.

(b) Two or more applications for inventions cognate, additional fee required.

(c) The inventions disclosed in the specification filed with applications made in the convention countries are not so related as to constitute one invention or to a group of invention so as to form a single invention. The application should therefore be divided into separate applications.

(d) The inventions disclosed in the specifications filed with applications made in the convention countries are not so related as to constitute one invention or to a group of invention linked so as to form a single invention but are cognate or of which one is a modification of another accordingly, additional fees in respect of applications should be remitted immediately.

6.2.12 The Controller can take following actions as per Section 15

a) May refuse the application

When the application or specification or any other document filed does not meet the requirements of the Act or the Rules, the Controller can refuse the application for grant of patent by an order either suo-moto or after hearing the party to the application when a request for hearing is requested. The order of the Controller is appealable before the Appellate board.

b) May require the application to be amended before he proceeds further with the application

The Controller can stay the proceedings towards the grant of patent till requirements under the Act or Rules are met by the applicant to his satisfaction by way of amendments in the application or specification or any document, as the case may be. In case the applicant does not comply with the requirements within the time as prescribed under Sec.21, he may refuse the application.

6.2.13 **Divisional application (section 16)**

(i) When an application made by applicant claims more than one invention, the applicant on his own or to meet the official objection may divide the application and file two or more applications, as applicable for each of the inventions. This type of application, divided out of the parent one, is called a Divisional Application. The priority date for all the divisional applications will be same as that claimed by the Parent Application (Ante-dating).

(ii) The Complete Specification of a divisional application should not include any matter not in substance disclosed in the complete specification of the first application. The reference of parent application should be made in the body of the specification. A divisional application has to be filed before the grant for a Parent application,
In *Imperial Chemical Industries Ltd. v. Controller of Patents*, (AIR 1978 Cal 77), the case involved was the grant of a patent in respect of an invention of a catalyst which is used in the steam reforming of hydrocarbons and achieved results. The said invention, as the patent certificate stated, related to the catalyst suitable for use in hydrocarbons steam reforming process. In the case, the grant was challenged on the ground that the claimed results were not possible. The High Court considered the following well settled propositions of law —

(i) A patent must be in respect of an invention and not a discovery.
(ii) There must be one single patent in respect of one single invention.
(iii) A patent may be in respect of a substance or in respect of a-process.
(iv) It is not possible to bifurcate a patent and state that one relates to the substance and the other to the process.
(v) In order to have a complete patent the specifications and claims must be clearly and distinctly mentioned.
(vi) It is the claims and claims, alone which constitute the patent.

The High Court held that one cannot bifurcate from the processes, the result produced from such processes. A person having the right to use a process patented under the Act, also has the right to the product of such process.

**6.2.15 Divisional Application : Case Study**

Patent Application No. 251/MUMNP/2005 filed by M/s. BHA Holdings Inc. USA for the “Retention Device engaged with the filter cartridge for limiting the radial movement of the pleats in the filter media” as a divisional application of the parent application No. 490/MUMNP/2003. The divisional application was rejected by the Controller of Patents vide his order dated 11th January, 2007 u/s 15 of the Patents Act, 1970 (as amended). In the parent case, the prima facie objection for plurality of distinct inventions was raised by the Patent Office due to multiple sets of independent claims. However, the applicants contested this objection by claiming that these claims relate to a single inventive concept as required under Section 16 (3) of the Act. It was pointed out to the agents that the same features claimed in claims 1-6 of divisional application were claimed in multiple sets of claims in claims 7-33 of a parent application, which were thus redundant and accordingly they agreed to delete them. Thus, claims 1-6 only were allowed in the parent case. Later, in the divisional patent application, the applicants again filed claims 1-33 as were filed in the parent case, which attracted objection under Section 16 of the Act. The Patent Office asked to pinpoint differentiating features claimed in this divisional application with respect to the claims finally allowed in the parent application. The applicants neither provided a proper reasoning to remove this objection raised under Section 16 (3) nor pinpointed the differentiating features of instantly claimed invention with respect to those allowed in the parent case. The apparatus claims 1-12 of the divisional application corresponded to claims 1-6 of the parent application and method claims 13-19 of the divisional application corresponded to claims 7-12 of the parent application. Therefore, the divisional application did not meet the
requirement of Section 16 (3) of the Act. Accordingly, the Controller of Patents ordered refusal to grant letters of Patent for the aforesaid patent application No. 251/MUMNP/2005.

6.2.16 Post Dating Of The Application (S. 17)

a) The application for patent may be post-dated to a date not later than six months from the date of application on a request made by the applicant at any time before the grant of patent along with the prescribed fee as given in first schedule. However this provision will not apply if the application is deemed to be abandoned.

b) If the application or specification (or drawings if any) is amended under section 15 to comply with the requirements of the Act or the Rules and the Controller feels that post-dating is required, he may direct that application or specification or other documents related thereto be deemed to have been made on the date on which the requirements are complied with or the date on which it is re-filed after complying with the requirements. (section 17(2)).

6.2.17 In the case of Standipack Private Limited v. Oswal Trading Co. Ltd.(, 1999 PTC (19) 479 (Del)), it was held that post-dating of the patent could be done only to the date of filing of the complete specifications. The Controller had filed the original records relating to the grant of patent in favour of the plaintiff. These records revealed that the application for the grant of patent was originally filed by plaintiff on 11th April, 1989 and the complete specification was filed on 11th October, 1990. The Controller, however, post-dated the patent to 11th July, 1989 although complete specifications followed by the provisional specification was filed on 11th October, 1990. Thus the post-dating of the patent by the Controller to 11th July, 1989 prima facie appears to be in violation of the provisions of section 9 of the Act. The date of the patent, therefore, should have been 11th October, 1990. The patent documents referred the validity of the patent for 14 years from 11th July, 1989. Thus the validity of the patent has also been ignored by the Controller. Thus post-dating the patent to 11th July, 1989 appears to be illegal in view of the provisions of section 9(4) of the Patents Act and the provisions of section 17 are subject to section 9.

6.3 Action To Be Taken In Cases Of Anticipation [Section: 18]

Section 18.

Powers of Controller in cases of anticipation;

(1) Where it appears to the Controller that the invention so far as claimed in any claim of the complete specification has been anticipated in the manner referred to in clause (a) of sub-section (1) or sub-section (2) of section 13, he may refuse the application unless the applicant—
(a) shows to the satisfaction of the Controller that the priority date of the claim of his complete specification is not later than the date on which the relevant document was published; or

(b) amends his complete specification to the satisfaction of the Controller.

(2) If it appears to the Controller that the invention is claimed in a claim of any other complete specification referred to in clause (b) of sub-section (1) of section 13, he may, subject to the provisions hereinafter contained, direct that a reference to that other specification shall be inserted by way of notice to the public in the applicant's complete specification unless within such time as may be prescribed,—

(a) the applicant shows to the satisfaction of the Controller that the priority date of his claim is not later than the priority date of the claim of the said other specification; or

(b) the complete specification is amended to the satisfaction of the Controller.

(3) If it appears to the Controller, as a result of an investigation under section 13 or otherwise,—

(a) that the invention so far as claimed in any claim of the applicant's complete specification has been claimed in any other complete specification referred to in clause (a) of sub-section (1) of section 13; and

(b) that such other complete specification was published on or after the priority date of the applicant's claim,

then, unless it is shown to the satisfaction of the Controller that the priority date of the applicant's claim is not later than the priority date of the claim of that specification, the provisions of sub-section (2) shall apply thereto in the same manner as they apply to a specification published on or after the date of filing of the applicant's complete specification.

**Rule 29:**

**Procedure in case of anticipation by prior claiming.**

(1) When it is found that the invention so far as claimed in any claim of the complete specification, is claimed in any claim of any other specification falling within clause (b) of sub-section (1) of section 13, the applicant shall be so informed and shall be afforded an opportunity to amend his specification.
(2) If the applicant's specification is otherwise in order for grant and an objection under clause (b) of sub-section (1) of section 13 is outstanding, the Controller may postpone the grant of patent and allow a period of two months for removing the objection.

6.3.1 If the invention is anticipated by prior publication as per S.13 (1) (a) or S.13(2), the Controller may refuse the complete specification unless the applicant shows that the priority date of his claim is not later than that of the cited document or amends his complete specification to the satisfaction of the Controller. [section 18 (1) & Rule 28]

6.3.2 If the invention is anticipated by prior claiming as per S.13 (1) (b), the Controller may direct that a reference to that other specification be inserted in the applicant’s specification by way of notice to the public unless the applicant shows that the priority date of his claim is not later than that of the claim of cited document or amends the specification to the satisfaction of the Controller. (The Controller need not consider the validity of the prior specification when directing such a reference) [section 18(2) & Rule 29, 30, 31]

6.3.3 Format for incorporation of reference is “Reference has been directed, in pursuance of section 18(2) of the Patents Act 1970, to the specification filed in pursuance of application no...” [Rule 31]

If the invention is anticipated by prior publication as per S.13(1) (a) and the other complete specification was published on or after the priority date of the applicant’s claim, the remedy for the anticipation by prior claiming as explained above will equally apply to this case (section 18(3)).

6.4 Actions to be taken in case of potential infringement (section 19)

Section 19:

Powers of Controller in case of potential infringement;

(1) If, in consequence of the investigations required under this Act, it appears to the Controller that an invention in respect of which an application for a patent has been made cannot be performed without substantial risk of infringement of a claim of any other patent, he may direct that a reference to that other patent shall be inserted in the applicant's complete specification by way of notice to the public, unless within such time as may be prescribed-
(a) the applicant shows to the satisfaction of the Controller that there are reasonable grounds for contesting the validity of the said claim of the other patent; or

(b) the complete specification is amended to the satisfaction of the Controller.

(2) Where, after a reference to another patent has been inserted in a complete specification in pursuance of a direction under sub-section (1)—

(a) that other patent is revoked or otherwise ceases to be in force; or

(b) the specification of that other patent is amended by the deletion of the relevant claim; or

(c) it is found, in proceedings before the court or the Controller, that the relevant claim of that other patent is invalid or is not infringed by any working of the applicant's invention,

the Controller may, on the application of the applicant, delete the reference to that other patent.

Rule 32:
Procedure in case of potential infringement;

If in consequence of an investigation made under section 13, it appears to the Controller that the applicant's invention cannot be performed without substantial risk of infringement of a claim of another patent, the applicant shall be so informed and the procedure provided in rule 29 shall, so far as may be necessary, be applicable.

6.4.1 The Controller has power to direct the insertion (in the specification) of the reference to another patent, which could be infringed in the event of performing the invention of the application, and also for the deletion of such reference from there, on the request from the applicant, when the said referred patent ceases, or revoked or relevant conflicting claim is deleted from the other patent. [section 19, rules 32 and 33]

6.4.2 The investigation made under Section 13 is not deemed to be conclusive on the question of anticipation and the Central Government or its Officers incur no liability (section 13(4)).

6.5 Power of the Controller to make orders regarding substitution of applicant
Section 20:

Powers of Controller to make orders regarding substitution of applicants, etc:

(1) If the Controller is satisfied, on a claim made in the prescribed manner at any time before a patent has been granted, that by virtue of any assignment or agreement in writing made by the applicant or one of the applicants for the patent or by operation of law, the claimant would, if the patent were then granted, be entitled thereto or to the interest of the applicant therein, or to an undivided share of the patent or of that interest, the Controller may, subject to the provisions of this section, direct that the application shall proceed in the name of the claimant or in the names of the claimants and the applicant or the other joint applicant or applicants, accordingly as the case may require.

(2) No such direction as aforesaid shall be given by virtue of any assignment or agreement made by one of two or more joint applicants for a patent except with the consent of the other joint applicant or applicants.

(3) No such direction as aforesaid shall be given by virtue of any assignment or agreement for the assignment of the benefit of an invention unless—

(a) the invention is identified therein by reference to the number of the application for the patent; or

(b) there is produced to the Controller an acknowledgement by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made; or

(c) the rights of the claimant in respect of the invention have been finally established by the decision of a court; or

(d) the Controller gives directions for enabling the application to proceed or for regulating the manner in which it should be proceeded with under sub-section (5).

(4) Where one of two or more joint applicants for a patent dies at any time before the patent has been granted, the Controller may, upon a request in that behalf made by the survivor or survivors, and with the consent of the legal representative of the deceased, direct that the application shall proceed in the name of the survivor or survivors alone.
(5) If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the Controller may, upon application made to him in the prescribed manner by any of the parties, and after giving to all parties concerned an opportunity to be heard, give such direction as he thinks fit enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be proceeded with, or for both those purposes, as the case may require.

Rule 34:

Manner in which a claim under section 20(1) shall be made;

(1) A claim under sub-section (1) of section 20 shall be made in Form 6.

(2) The original assignment or agreement or an official copy or notarized copy thereof shall also be produced for the Controller's inspection and the Controller may call for such other proof of title or written consent as he may require.

Rule 35:

Manner in which a request may be made under section 20(4);

(1) A request under sub-section (4) of section 20 shall be made in Form 6.

(2) The request shall be accompanied by proof of death of the joint applicant and a certified copy of the probate of the will of the deceased or letters of administration in respect of his estate or any other document to prove that the person who gives the consent is the legal representative of the deceased applicant.

Rule 36:

Manner of application under section 20(5);

(1) An application under sub-section (5) of section 20 shall be made in Form 6 in duplicate and shall be accompanied by a statement setting out fully the facts upon which the applicant relies and the directions which he seeks.

(2) A copy of the application and statement shall be sent by the Controller to every other joint applicant.

6.5.1 A claim for substituting an applicant(s) has to be made in Form 6 with the prescribed fee as given in the First schedule along with the original assignment/agreement or an official copy or notarized copy thereof. The
Controller may call for other proof of title or written consent of the assignor(s), if required (Rule 34). Accordingly, the Controller, if satisfied, may direct that the application shall proceed in the name of the claimant(s).

6.5.2 By virtue of a written assignment or agreement from the applicant or by operation of law, if the claimant(s) makes the claim that, as and when the patent is granted, he may become entitled to any of the following :-

a. The patent : If there is only one applicant and he assigns the title in the patent, then the Controller, if satisfied, may direct that the application shall proceed in the name of the claimant(s).[ section 20(1)]

b. A specific interest in the patent : If there is only one applicant and he passes any of the interests in the patent by way of agreement, then the Controller, if satisfied, may direct that the application shall proceed in the name of the applicant and the claimant(s).

c. An undivided share of the patent : If there are more than one applicants and one applicant assigns his title, then the Controller, if satisfied, may direct that the application shall proceed in the name of the claimant(s) and the other joint applicant(s).

d. A specific interest in the undivided share of the patent : If there are more than one applicants and one applicant passes any of the interests in the patent by way of agreement, then the Controller, if satisfied, may direct that the application shall proceed in the name of the claimant(s), that applicant and the other joint applicant(s). (section 20(1).

The claimant may become entitled to any of the above by operation of law also.

6.5.3 The direction to substitute an applicant will not be given unless all the applicants have consented to assign the said rights to the claimant [section 20(2)].

6.5.4 Legal assignments (Rule 34(2)) produced along with Form 6 to make the Controller to give directions, should either have a reference of the patent application number in the assignment or in its absence a separate statement of the assignor that it relates to the same invention for which the patent has been filed [section 20(3)].

6.5.6 The request by the survivor/survivors for the application for Patent to proceed in their name, when one or more of the joint applicants is dead, has to be in form 6, with the consent of the legal representative(s) of the deceased applicant(s) endorsed on the request, along with a prescribed fee and a proof of death of the joint applicant/s and a document to prove the standing of the person as a legal representative who has signed the endorsement [section 20(4) & Rule 35) Also see section 20(5) & rule 36]

6.5.7 In case of opposition proceeding before the Controller, the opposition prove the ground of obtaining then the Controller has the power to substitute the
name of the opponent instead of the name of the applicant and issue an order to proceed with the application

6.6 Time for putting the application in order for grant in case when there is no pre-grant opposition Section (21)

Section 21.

Time for putting application in order for grant;

(1) An application for a patent shall be deemed to have been abandoned unless, within such period as may be prescribed, the applicant has complied with all the requirements imposed on him by or under this Act, whether in connection with the complete specification or otherwise in relation to the application from the date on which the first statement of objections to the application or complete specification or other documents related thereto is forwarded to the applicant by the Controller.

Explanation.;

Where the application for a patent or any specification or, in the case of a convention application or an application filed under the Patent Cooperation Treaty designating India any document filed as part of the application has been returned to the applicant by the Controller in the course of the proceedings, the applicant shall not be deemed to have complied with such requirements unless and until he has re-filed it or the applicant proves to the satisfaction of the Controller that for the reasons beyond his control such document could not be re-filed.

(2) If at the expiration of the period as prescribed under sub-section (1);

(a) an appeal to the High Court is pending in respect of the application for the patent for the main invention; or

(b) in the case of an application for a patent of addition, an appeal to the High Court is pending in respect of either that application or the application for the main invention, the time within which the requirements of the Controller shall be complied with shall, on an application made by the applicant before the expiration of the period as prescribed under sub-section (1), be extended until such date as the High Court may determine.

(3) If the time within which the appeal mentioned in sub-section (2) may be instituted has not expired, the Controller may extend the period as prescribed under sub-section (1), to such further period as he may determine:

Provided that if an appeal has been filed during the said further period, and the High Court has granted any extension of time for complying with the
requirements of the Controller, then the requirements may be complied with within the time granted by the Court.

6.6.1 The Patent may be granted and the Letters Patent may be issued by the Controller as soon as possible after the applicant has met with all the official requirements within the period specified in section 21. If there is an opposition, by way of representation u/s 25(1) and the opposition is disposed off with a direction to amend the application within the time prescribed under the order then the applicant is entitled to amend the specification as required by the Controller within the prescribed time. In case, the applicant fails to meet the requirements as above, the application may be abandoned.

6.6.2 A flow chart of examination procedure is presented on next page.
PROCEDURE FOR THE GRANT OF PATENT

Filing of Application → With Prov. Spec → Complete Spec Not filed → Complete Spec → Abandoned

18 Months Public → Request For Exam → FER.

Pregnant Opp → Hearing → Allowed/Reject

Obj. Not Complied Within 12 Months → Re Exam & Issue of Further Obj.

Abandoned

Hearing by Controller → Complied With All Obj.

Appeal to IPAB → Refused Under Sec 15 → Order/Decision S.15

Refused → Appeal Allowed → Patent grant

No Opposition

Renewal Fees Demand → Constitution of opp. board

Fee Not Paid → Patent ceased

Fee Paid

Grant publication

Opposition u/s25 (2)

Submit report to cont.

Hearing by Controller

Opposition Allowed

Patent Contd. till 20 yrs.

Appeal Allowed → Appeal to IPAB

Opposition Dismissed
CHAPTER VII

OPPOSITION PROCEEDINGS TO GRANT OF PATENT

7.1 Pre-Grant Opposition By Representation [section 25(1)]

Section 25: Opposition to the patent –

(1): Where an application for a patent has been published but a patent has not been granted, any person may, in writing, represent by way of opposition to the Controller against the grant of patent on the ground -

(a) that the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of complete specification has been published before the priority date of the claim –

i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

ii) in India or elsewhere, in any other document

iii) Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 29;

(c) That the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the applicant’s claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant’s claim

(d) That the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim

Explanation: - For the purpose of this clause, an invention relating to a process for which a patent is claimed shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process has already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only;
(e) That the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the applicant’s claim;

(f) That the subject matter of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act

(g) That the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed

(h) That the applicant has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge

(i) That in the case of convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title

(j) That the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention

(k) That the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere

Rule 55:

(1) Representation for opposition under sub-section ‘(f)’ of section 25 shall be filed at the appropriate office and shall include a statement and evidence, if any, in support of the representation and a request for hearing if so desired.

(1A) Notwithstanding anything contained in sub-rule (1), no patent shall be granted before the expiry of a period of six months from the date of publication of the application under section 11A.

(2) The Controller shall consider such representation only when a request for examination of the application has been filed.

(3) On consideration of the representation if the Controller is of the opinion that application for patent shall be refused or the complete specification requires amendment, he shall give a notice to the applicant to that effect along with a copy of such representation.

(4) On receiving the notice under sub-rule (3), the applicant shall, if he so desires, file his statement and evidence, if any in support of his application within three months from the date of the notice.

(5) On consideration of the statement and evidence filed by the applicant, the Controller may either refuse to grant a patent on the application or require the complete specification to be amended to his satisfaction before the patent is granted.

(6) After considering the representation and submission made during the hearing if so requested, the Controller shall proceed further simultaneously either rejecting the representation and granting the patent or accepting the representation and refusing the grant of patent on
that application, ordinarily within one month from the completion of above proceedings

7.1.1 **Grounds for Pre-grant Opposition by way of Representation u/s 25(1) are summarized as follows:**

a) Wrongfully obtaining

b) Prior publication / prior claiming

c) Prior claiming in India

d) Prior public knowledge or public use in India

e) Obviousness and lack of inventive step

f) Not an invention or the invention not patentable

g) Insufficient description of the invention

h) Failure to disclose information or furnishing false information relating to foreign filing

i) Convention application not filed within the prescribed time

j) Incorrect mention of source/geographical origin of biological material

k) Invention anticipated with regard to traditional knowledge of any community, anywhere in the world

No ground other than the statutory grounds as above can be taken for opposing the Grant of Patent under section 25(1)

7.1.2. **Proceedings under Pre-Grant Opposition:**

i. Any person can file opposition by way of representation to the Controller against the grant of patent, at the appropriate office, before the grant of patent on any of the above-mentioned grounds.

ii. The Controller shall not grant the patent before the expiry of 6 months from the date of publication under section 11 A. Therefore, a person should try to file such representation within the assured period of 6 months from the date of publication under section 11 A.

iii. The representation shall include a statement and evidence, if any, in support of such representation and a request for hearing, if so desired.

iv. The Controller shall consider the representation only after a Request for Examination for that application has been filed.
v. On consideration of representation, if the Controller is of the opinion that the application shall be refused or the complete specification requires amendment, he shall give notice to the applicant to that effect along with the copy of such representation.

vi. The applicant shall, if he so desires, give reply to that representation along with his statement and evidence, if any, in support of his application within three months from the date of the notice.

vii. The Controller shall consider the statement and evidence filed by the applicant and may either refuse the grant of patent or ask for amendment of the complete specification to his satisfaction before the grant of patent.

viii. After considering the representation and submission made during the hearing, if so requested, the Controller shall proceed further simultaneously, either rejecting the representation and granting the patent or accepting the representation and refusing the grant, ordinarily within one month from the completion of the above proceedings.

7.1.3 An application for patent was filed in India on 17th July, 1998 (at Patent Office, Chennai) by M/s Novartis AG, Switzerland, claiming Switzerland priority date of July 18, 1997 for an invention titled “Crystal Modification of A N-Phenyl-2-Pyrimidineamine derivative, processes for its manufacture and its use” and the same was allotted the Application No.1602/MAS/1998. Upon publication, the grant of patent was opposed by way of representation u/s 25(1) by M/s Natco Pharma Ltd., India on 26th May, 2005 and they also requested for hearing. The grounds for opposition were i) Anticipation by Prior Publication ii) Lack of inventive step iii) Non-patentability u/s 3(d) of the Patents Act and iv) Wrongfully claiming the Priority. Applicant filed the reply statement with evidence on 25th July, 2005 and also asked for hearing. The Controller conducted the hearing and considered various grounds for opposition in the light of submissions by both the parties and concluded as follows:

The title compound commercially, called imatinib mesylate, was already known in the US Patent No.5521184 (1993 Patent). The 1993 Patent disclosed methanesulphonic acid as one of the salt –forming groups and also states that the required acid additions salts were obtained in a customary manner. Further, claims 6 to 23 of the 1993 Patent claimed a pharmaceutically acceptable salt of the base compound. Another Document, “Nature Medicine” (5th May, 1996) also described the title compound. Also the compound, imatinib mesylate salt, inherently existed in the β-crystalline form, which is the most stable form of the salt. This fact was also clear from the results of laboratory experiments conducted by two reputed government institutions, namely, Indian Institute of Chemical Technology, Hyderabad and Indian Institute of Technology, Delhi. Hence, the claims of the application for the product and process in respect of the title compound stood anticipated by prior publication.
Since the 1993 patent disclosed the free base of the base compound, it was obvious to a person skilled in the art to prepare the corresponding pharmaceutically acceptable salts. The studies by the two laboratories mentioned above clearly demonstrated that the salt prepared using teachings and instructions of the 1993 Patent inherently exists in β-crystalline form. Hence, the product claims were obvious.

As per section 3(d), any salt or polymorph or derivative of the known substance is not patentable unless such salt or polymorph or derivative shows enhanced efficacy of the substance. As regards efficacy, the patent specification itself states that, wherever β-crystals are used, the imatinib free base or other salts can be used. The affidavit submitted by the technical expert on behalf of the applicant demonstrated that the relative bioavailability of the free salt with that of β-crystal form of imatinib mesylate differ only by 30% and accounted this difference to their solubility in water. Thus, the specification did not bring out any improvement in the efficacy of the β-crystal form over the known substances; rather it stated that the base compound could be used equally in the treatment of diseases or in the preparation of pharmacological agents wherever the β-form is used. Thus, the product claim amounted to a mere discovery of the new form of the known substance.

The application filed in India has claimed the Swiss priority dated 18th July, 1997, but Switzerland was not a Convention country on that date. It became the Convention country in September, 1998 only. Hence, no priority of Swiss application could be claimed in respect of the Indian application.

**Decision:**

In view of the above findings and arguments made by both the parties during the hearing, the Learned Controller ruled that the Patent Application no.1602/MAS/1998 cannot proceed for grant of patent.

The decision of the Controller has been appealed against by the applicant and the matter is currently *sub-judice*.

7.1.4 In the case of application No. IN/PCT/2002/00020/DEL, U/S 25(1), it was concluded that invention as claimed in finally revised claims 1 to 49 in the patent application did not involve any "inventive step" having regard to the prior art citations JP-8059512 published on 5th March, 1996 and US Patent 5,885,617 published on 23rd March, 1999. It was held that “the selection of particular range of ingredients from the ranges already known prior art in this case cannot amount to establish the inventive step and the variations in the amounts of the known ingredients appear merely workshop improvements achieved by a person skilled in the art without performing any substantial experiments and can not be said a technical advancement of an existing knowledge which is required by the definition of the "inventive step" as mentioned in section 2(1)(ja) of the Patents Act, 1970 and that the existence of already known characteristics of composition with known ingredients cannot be termed as synergy among the ingredients of claimed composition.”
7.2 Post-Grant Opposition [section 25(2)]

Section 25. Opposition to the patent.

(2): At any time after the grant of patent but before the expiry of a period of one year from the date of publication of grant of a patent, any person interested may give notice of opposition to the Controller in the prescribed manner on any of the following grounds, namely:--

(a) that the patentee or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim;
   (i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or
   (ii) in India or elsewhere, in any other document:
   Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 29;

(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the claim of the patentee and
filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the claim of the patentee;

(d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

Explanation.—For the purposes of this clause, an invention relating to a process for which a patent is claimed shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only;

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the applicant's claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(h) that the patentee has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge;

(i) that in the case of a patent granted on a convention application, the application for patent was not made within twelve months from the date of the first application for protection for the invention made in a convention country or in India by the patentee or a person from whom he derives the title;

(j) that the complete specification does not disclose or wrongly mentions the source and geographical origin of biological material used for the invention;

(k) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere,

but on no other ground.

(3) (a) Where any such notice of opposition is duly given under sub-section (2), the Controller shall notify the patentee.
(b) On receipt of such notice of opposition, the Controller shall, by order in writing, constitute a Board to be known as the Opposition Board consisting of such officers as he may determine and refer such notice of opposition along with the documents to that Board for examination and submission of its recommendations to the Controller.

(c) Every Opposition Board constituted under clause (b) shall conduct the examination in accordance with such procedure as may be prescribed.

(4) On receipt of the recommendation of the Opposition Board and after giving the patentee and the opponent an opportunity of being heard, the Controller shall order either to maintain or to amend or to revoke the patent.

(5) While passing an order under sub-section (4) in respect of the ground mentioned in clause (d) or clause (e) of sub-section (2), the Controller shall not take into account any personal document or secret trial or secret use.

(6) In case the Controller issues an order under sub-section (4) that the patent shall be maintained subject to amendment of the specification or any other document, the patent shall stand amended accordingly.

Rule 55A. Filing of notice of opposition

The notice of opposition to be given under sub-section (2) of section 25 shall be made in Form 7 and sent to the Controller in duplicate at the appropriate office.

Rule 56. Constitution of opposition board and its proceedings

(1) On receipt of notice of opposition under rule 55A, the Controller shall, by order, constitute an Opposition Board consisting of three members and nominate one of the members as the Chairman of the Board.

(2) An examiner appointed under sub-section (2) of section 73 shall be eligible to be a member of the Opposition Board.

(3) The examiner, who has dealt with the application for patent during the proceeding for grant of patent thereon shall not be eligible as member of Opposition Board as specified in sub-rule (2) for that application.

(4) The Opposition Board shall conduct the examination of the notice of opposition along with documents filed under rules 57 to 60 referred to under sub-section (3) of section 25, submit a report with reasons on each ground taken in the notice of opposition with its joint recommendation within three months from the date on which the documents were forwarded to them.

Rule 57. filing of written statement of opposition and evidence

The opponent shall send a written statement in duplicate setting out the nature of the opponent's interest, the facts upon which he bases his case and relief which he seeks and evidence, if any, along with notice of
opposition and shall deliver to the patentee a copy of the statement and the evidence, if any.

**Rule 58. Filing of reply statement and evidence**

(1) If the patentee desires to contest the opposition, he shall leave at the appropriate office a reply statement setting out fully the grounds upon which the opposition is contested and evidence if any, in support of his case within a period of two months from the date of receipt of the copy of the written statement and opponent's evidence if any by him under rule 57 and deliver to the opponent a copy thereof.

(2) If the patentee does not desire to contest or leave his reply and evidence within the period as specified in sub-rule (1), the patent shall be deemed to have been revoked.

**Rule 59: Filing of reply evidence by opponent**

The opponent may, within one month from the date of delivery to him of a copy of the patentee's reply statement and evidence under rule 58, leave at the appropriate office evidence in reply strictly confined to matters in the patentee's evidence and shall deliver to the patentee's a copy of such evidence.

**Rule 60: Further evidence to be left with the leave of the controller**

No further evidence shall be delivered by either party except with the leave or directions of the Controller:
Provided that such leave or direction is prayed before the Controller has fixed the hearing under rule 62.

**Rule 61: Copies of documents to be supplied**

(1) Copies of all documents are referred to in the notice of opposition or in any statement or evidence filed in connection with the opposition and authenticated to the satisfaction of the Controller, shall be simultaneously furnished in duplicate unless the Controller otherwise directs

(2) Where a specification or other document in a language other than English is referred to in the notice, statement or evidence, an attested translation thereof, in duplicate, in English shall be furnished along with such notice, statement or evidence, as the case may be.

**Rule 62: Hearing**

(l) On the completion of the presentation of evidence, if any, and on receiving the recommendation of Opposition Board or at such other time as the Controller may think fit, he shall fix a date and time for the hearing of the opposition and shall give the parties not less than ten days' notice of such
hearing and may require members of Opposition Board to be present in the hearing.

(2) If either party to the proceeding desires to be heard, he shall inform the Controller by a notice along with the fee as specified in the First Schedule.

(3) The Controller may refuse to hear any party who has not given notice under sub-rule (2).

(4) If either party intends to rely on any publication at the hearing not already mentioned in the notice, statement or evidence, he shall give to the other party and to the Controller not less than five days’ notice of his intention, together with details of such publication.

(5) After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing, and after taking into consideration the recommendation of Opposition Board, the Controller shall decide the opposition and notify his decision to the parties giving reasons there for.

Rule 63: Determination of costs

If the patentee notifies the Controller that he desires to withdraw the patent after notice of opposition is given, the Controller, depending on the merits of the case, may decide whether costs should be awarded to the opponent.

Section 150:

If any party by whom notice of any opposition is given under this Act or by whom application is made to the Controller for the grant of a licence under a patent neither resides nor carries on business in India, the Controller may require him to give security for the costs of the proceedings, and in default of such security being given may treat the opposition or application as abandoned.

7.2.1 Grounds for Post-grant Opposition u/s 25(2) are summarized as follows:

a) Wrongfully obtaining

b) Prior publication / prior claiming

c) Prior claiming in India

d) Prior public knowledge or public use in India

e) Obviousness and lack of inventive step

f) Not an invention or the invention not patentable

g) Insufficient description of the invention

h) Failure to disclose information or furnishing false information relating to foreign filing
i) Convention application not filed within the prescribed time

j) Incorrect mention of source/geographical origin of biological material

k) Invention anticipated with regard to traditional knowledge of any community, anywhere in the world

7.2.2 Proceedings under Post Grant Opposition [section 25(2)]

i. Any interested person can oppose the grant of Patent under section 25(2) by giving a notice to the Controller, within one year form the date of publication of grant of a patent in the official journal. Person interested [section 2(1) (t)] includes a person engaged in, or in promoting research in the same field as that to which the invention relates. Any person including an organization that has a manufacturing or trading interest in the goods connected with the patented article or who has a financial interest in manufacturing such goods or who possesses patents relating to the same subject, is considered as person interested

ii. The notice of opposition is to be made in Form 7 and sent to the Controller in duplicate at the appropriate office along with the prescribed fee given in first schedule. The notice of opposition should be accompanied by a written statement (in duplicate) stating out the nature of opponent’s interest, the facts upon which he bases his case and the relief which he seeks and evidence, if any, in duplicate in support of his case. (Rule 57). The opponent should deliver to the patentee a copy of the statement and the evidence, if any, filed by him along with the notice of opposition.

iii. The Controller should notify the patentee regarding the filing of the opposition.

iv. Opposition Board: On receipt of the notice of opposition under rule 55A, the Controller, by order, should constitute an Opposition Board which would consist of three examiners as members, other than the examiner who has examined the application. The Controller should nominate one of the members as the chairman of the Board.

v. If the patentee desires to contest the opposition, he should send the reply statement at the appropriate office giving grounds for contesting the opposition and evidence, if any, in support of his case within a period of 2 months from the date of receipt of a copy of the written statement and opponent’s evidence by him [Rule 58]. The patentee shall deliver to the opponent a copy of reply statement and evidence. (Rule 58).

vi. If the patentee does not desire to contest or fails to send his reply and evidence within the specified period as above, the patent should be deemed to have been revoked [Rule 58 (2)].

vii. The opponent could file the evidence in reply within one month form the date of delivery to him a copy of reply statement and the evidence by the patentee;
such a reply evidence by the opponent must be strictly confined to the matters in the patentee’s evidence (Rule 59). Also, the opponent should deliver to the patentee a copy of his reply evidence.

viii. No further evidence could be delivered by either party except with the leave or direction of Controller (Rule 60). Such a leave or direction should be prayed before the date of the hearing has been fixed by the Controller.

ix. The Opposition Board would examine the notice of opposition and documents filed under Rules 57 to 60 and submit a report with reasons on each ground within 3 months from the date on which the documents were forwarded to them with its joint recommendation.

x. On receipt of the recommendations of the opposition board along with all evidence filed by both the parties, the Controller will fix a hearing but at least ten days notice should be given to both the parties (Rule 62). The Controller may require members of the Opposition Board to be present in the hearing.

xi. If any party desires to be heard he should make a request to the Controller along with prescribed fees given in first scheduled.

xii. After hearing and taking in to account the recommendations of opposition board, the Controller will decide whether costs should be awarded to the opponent.

7.2.4 In the matter of Patent No.187163, (581/BOM/1999), the opposition was lodged on the ground of obtaining and request was made to mention the opponent’s name as an inventor. The opponents who were working as a Research Assistant and whose job was that of laboratory technician and not of a scientist, did not produce any substantial evidence or witnesses to substantiate his claim as an inventor. For naming the inventor, he should have provided ideas to produce ‘germ of invention’ and made intellectual contribution in achieving the final result of research leading to a patent. One or more person involved to arrive at the conception or realization of the final product or process or merely involved in carrying out experiments does not mean that they are inventors. The inventor for the purpose of Patents law is the actual deviser of what is being claimed. So the opponent failed to prove the ground of wrongfully Obtaining a patent.

7.2.5 In the matter of Patent No.173953 (223/BOM/1991), the invention related to “Process for making a soap composition containing glycerol”. The opposition was lodged on the ground of prior publication u/s 25 (1)(b), prior public knowledge u/s 25 (1)(d), obviousness, u/s 25 (1)(e), not an invention within the meaning of the Act u/s 25 (1)(f) and not sufficiently defining the invention u/s 25 (1)(g). It was held that the ingredients recited in the principal claim had a very specific and narrow range of proportions, which were not taught by cited documents. Cited document also did not teach how to obtain the right balance of salt and glycerol in order to avoid a soap which is too hard or too soft and also did not mention about balancing quantities of glycerol or salt against the quantities of total fatty matter. The alleged
invention mentioned the prior art, problems associated with it, results of various experiments, and best method of working examples. Considering all these factors it was judged that the opponents had failed to establish the above grounds and opposition was rejected.

7.2.6 In the matter of Patent No.- 183458 (454/BOM/1998), the invention related to "A process for the preparation of a therapeutic Anti-inflammatory and analgesic composition containing Nimesulide for use transdermally" Opposition was lodged on the ground of prior publication Under Section 25 (1)(b), prior public knowledge Under Section 25(1)(d), Obviousness Under Section 25 (1)(e), not an invention within the meaning of the Act Under Section 25 (1)(f). Comparison of the alleged invention 183458 with the Sri Lanka's Patent 11012 & Nigerian Patent RP 12829 clearly showed that it did not pass the test of novelty. It is sufficient to destroy the novelty of the claimed process that this process and the known process are identical with respect to the starting material and reaction condition since process as identical in these features must inevitably yield identical products. It was held that in view of the cited SriLankan and Nigerian patents the alleged invention stood anticipated as cited document has disclosed the invention or disclosed information in such a way as to make it part of the state of the art. Grant of Patent was refused on these grounds.

7.2.7 In the case of Gujarat Reclaim & Rubber Products Ltd v. Kamani Metallic Oxides Ltd1983 (3) PTC 105 (PO), a notice of opposition to the grant of a patent to M/s. Kamani Metallic Oxides Ltd., Bombay, for their patent No. 145917, application number 43/Bom/1976, for an invention titled “A process for separation of rayon or nylon fibres from cracked waste tyres and an apparatus thereof” was filed by M/s. Gujarat Reclaim & Rubber Products Ltd., Bombay, on 15th June, 1979 having regard to the prior art citations JP-8059512 published on 5th March, 1996 and US Patent 5,885,617 published on 23rd March, 1999. Opposition to grant of patent was on the grounds of prior publication, prior public knowledge and prior public use, lack of inventive step and insufficiency of description.

The opponents being engaged in the manufacture of reclaimed rubber in which cracked waste of automobile tyre and such other rubber waste were used and had a manufacturing unit, the opponent was held as 'persons interested' as stipulated in section 25 of the Act. Opponents deposed that the types of standard machineries used for carrying out the process of separating the rubber particles from fibrous materials and the alleged invention disclosed in the applicants' complete specification was anticipated by the Exhibits. In the circumstances, a rubber technologist would know its application to cracking of rubber for separation of fibre from rubber and particularly from waste tyres and in fact it had been used for said purpose for many years.

Applicants contested all the arguments of opponents and argued that the opponents have confused the issue by saying that something used in some point of time in the reclamation industry had been claimed by the applicants. They said that applicants' invention related to in the process and apparatus for the separation of fibre from cracked tyres waste i.e. a narrow aspect of dealing with the wider subject of rubber reclamation. So far as the document relating to reclaim from natural and synthetic rubber scrap is concerned, the original which was a confidential document and therefore, it has not been published and which is not open to public. On a scrutiny of
this document the court observed that the disclosure related to the general process for reclaiming of rubber from natural and synthetic rubber scrap and slow grinder discs for precracking.

The process consisting of three stage viz. cracking, fabric separation and grinding the details given there are applicable generally in a rubber reclaiming process. The invention disclosed in the applicants' specification related to an improved process for the removal of fibre from cracked automobile tyre wastes i.e. the second aspect of the above said three stages process. The steps involved in the process claimed in the complete specification are not found in the said document. No details have been given in the publication about the process and apparatus for removal of fibre from tyre wastes, as has been disclosed in the applicants' specification. Accordingly, the disclosure contained in the said document, even if it is considered to have been published before the priority date of the applicants, the application does not anticipate the applicants' process and apparatus.

Hence, the opponents failed to establish the ground of prior publication. Similarly the opponents also failed under the ground of prior public knowledge and prior public use as the documents relied upon by the opponents are not relevant as they do not anticipate the applicant's invention. The opponents failure to provide any other evidence in support of their contention as to obviousness and lack of inventive step failed them on this ground also. Hence, there being no force in their other grounds of opposition, the opposition is dismissed.

It was held for the ground under section 2 (1)(j) that “the selection of particular range of ingredients from the ranges already known in the prior art in this case cannot amount to establish the inventive step and variations in the amounts of the known ingredients appear merely workshop improvements achieved by a person skilled in the art without performing any substantial experiments and can not be said a technical advancement of an existing knowledge which is required by the definition of the "inventive step" as mentioned in section 2(1)(ja) of the Patents Act, 2005.”

7.2.8 In the matter of Thermax Private Limited v. Deccan Sugar Industries, (1987 PTC 137.) opponents in their written statement of opposition made certain allegation which can be construed to be in support of this ground of opposition, namely, unfair description. The opponents in their written statement of opposition at page 3 para (j) thereof made certain allegations about description wherein they alleged that the specification contained several process variations. What is stated by the opponents during hearing can be construed as an implication of their written statement. Further, during hearing, the applicants were at liberty to deal with each of the opponents' allegations separately and elaborately which they have not done. The opponents clearly proved the deficiencies in the description. Hence, the ground of unfair description is established. Opponents have therefore succeeded in this ground.

7.2.9 In the matter of Jagdish Mohanlal Joshi v. Ghodavat Pan Masala Products P. Ltd. Patent No. 188090 (application no. 166/BOM/1997) among other grounds, the “insufficiency of description” was a ground for opposition under Section
25(1)(g), citing “If the applicant does not give prior art details in the specification it would mislead the Controller and the public, mouth refreshing preparations with tobacco and without tobacco are known in the art, and the applicant is not entitled for a patent unless he shows that his process is an improvement over the earlier process. For this purpose, when 47 RPC 289 was cited submitting that the patent should justify clearly why a particular selection is made, the applicant submitted that the “Non disclosure of prior art does not result in insufficiency of description, the disclosure should enable the skilled person to exercise the invention which the applicant did, and further he deemed the impugned invention was a selection patent”. The Controller agreed with the applicant’s submission and upheld the patent and dismissed the opposition.

7.2.10 In the matter of Patent No. 176382(322/BOM/1992) filed by M/s Hindustan Lever Limited titled "Toilet soap bars and the process of manufacturing the same" on 14/10/1992 having two priorities of UK dated 14th October, 1991 and 14th July, 1992. The Patent was granted on 18th May, 1996 and was opposed under Section 25 by M/s Godrej Soaps Limited. The Grounds of opposition were:

- Prior publication section 25 (1) (b)
- Prior public use and prior public knowledge section 25 (1) (d)
- Obviousness and lack of inventive step section 25 (1) (e)
- Not an invention or not a patentable invention section 25 (1) (f)
- Insufficiency and clarity of description section 25 (1) (g)
- “The applicant has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge” section 25 (1) (h)

The case was heard by the Controller on 19th September, 2003

Opponents relied upon following documents

ii) Exhibit B: Indian standard Bathing bar specification
iii) European Patent No. EP0363215 and
iv) An expert’s evidence

After the hearing it was concluded that that teachings of the exhibits were either not pertinent or insufficient to prove the grounds and the opponents could not prove any of the above grounds of opposition.

Applicants made amendments in the description and claims at the time of hearing to make their point clear and to overcome the opponents allegations. As all the amendments were within the scope of invention and have support in the description, these amendments in the claims were allowed

After considering notice of opposition, statements of both the parties, evidences from both opponents & applicants and hearing, the opposition was dismissed.
In the matter of Patent No. 179304 (124/Cal/93) filed by M/s. Rickitt & Colman of India Ltd) for "A Mosquito/Insect Repellant Device" was opposed by Godrej Hi Care Ltd under Section 25 of the Act. Hearing was held on 10th January, 2001

The applicants' invention related to a mosquito/insect repellent device comprising the: (i) a bottom cover (ii) a positive temperature co-efficient (PTC) thermister heater assembly and iii) a top cover having opening for insertion of mats for placement on said heater assembly

The proceedings of the opposition took place to decide whether the applicant's devices involve any inventive step and the opponents lead any evidence as to patentability. The opponents have challenged the alleged application for Patent No. 179304 on the grounds of Section 25 namely, anticipation by prior publication-clause (b), anticipation by prior claiming - clause (c), prior public knowledge or public use- clause (d) & obviousness and lack of inventive step- clause (e)


Controller observed that it could not be concluded that the cited documents on Patents and Designs could establish anticipation by prior publication, as by combining the integers of the mosquito repellent from the cited patent & design documents is not resulting the identical article as produced by the alleged invention.

No document had been produced or referred by the opponents regarding any claim made by the applicants containing a subject of a claim of earlier priority date in a complete specification published after the priority date of applicants' claim. The opposition therefore could not stand based on the ground of prior claiming.

While considering ground under Section 25(l)(e) i.e. obviousness and the lack of inventive step, the Controller considered and analysed the difference between cited documents and the opposed specification to have any relevance regarding obviousness and lack of inventive step.

The device 'Mosquito Repellent' under the brand name of 'Good Night' is under public knowledge and use for more than a decade. The Exhibit Ex-C2 & Ex-C3 reveal that the cordless mosquito repellent having press fit detachable top & bottom portion with arrangement of insertion of mat on heater assembly and twist-n-turn i.e. rotatable two pinned plug fitted with the device, manufactured and marketed by Transelektra Domestic Products Private Ltd. were under public knowledge and use much earlier than the date of the alleged application for Patent No. 179304. For more than a decade the rotatable plug through 90 degree
is under public knowledge & use in many domestic electrical appliances and the press fit arrangements are under public knowledge and use even much more than a decade. The press fit arrangement of the top and bottom cover as depicted in Unit (iv) in paragraph 2 wherein the projections of the top cover being press fitted with the corresponding grooves formed on the inside face of bottom cover, is a mere workshop modification. Supposing that in the application for patent in question there is a difference with the cited documents in respect of the matter wherein the plug being adopted in a detachable and rotatable manner by providing on the plug rear portion with an integrally formed tubular portion having radially extending flanges as narrated in feature (v) of the alleged application, even in that case it is mere a workshop modification.

The Applicants' counsel have stated during hearing that the alleged device has produced achievements (1) Maintaining of constant temperature of 150o C (2) can easily assemble and disassemble (3) is a compact and can be conveniently used without the necessity of any extendable cord (4) is a safer construction (5) give a regulated release of active material by regulating temperature at 150o C.

All the above stated achievements of the alleged application have been found and claimed in the cited US documents. In the above background this Tribunal find that the alleged application has its integers (i) to (v) as narrated in paragraph 2 anti by combining one feature of an earlier specification with another earlier specification and so on to secure no advantage other than addition of their respective merits. The Tribunal therefore concluded that the alleged application No. 179304 titled "A Mosquito/Insect Repellent Device" is obvious and clearly does not involve any inventive step.

The grant of patent was therefore refused.

[Rickett & Colman of India Ltd. V Godrej Hi Care Ltd.,(2001 PTC 637 (PO)).


Under the ground of prior publicly known or publicly used in India under Section 25(1)(d), the opponent submitted that they are in the field of designing and manufacturing traction transformer and developed traction transformer or 3900 KVA in the year 1974. The opponent has supplied more than 600 single-phase traction transformer of 3900 KVA to Indian Railway against their various purchase orders prior to their Patent Application No. 184657 after approval of prototype design from Indian Railway (RDSO). BHEL (Opponent) was the first to supply 5400 KVA of traction transformer to Indian Railway.

It was held by the Controller that the ground under section 25(1)(d) that the invention was publicly known or publicly used in India was not established by
the opponent – since the photo copies submitted by the opponent state mainly
the terms and conditions of a contract to supply 3900 KVA & 5400 KVA
traction transformers. The photocopies of work order did not define any
constructional features of the traction transformer. Only by stating that we are
the first in the field of manufacturing the applicant company cannot be stopped
from obtaining a patent unless the opponents establish that they are
manufacturing an identical product.

7.2.13 In case of Patent No. 184656 (Patent Application No. 221/BOM/96) the
opponents have submitted on the ground of obviousness that the alleged
invention is obvious mechanical equivalent of what been known prior to the
date of the impugned application. The opponent pleaded that transformer
technology is known in the art and claims as worded do not have inventive
steps. The opponent submitted that simply stating that the steps and features
involved in the claimed invention are obvious is not sufficient without
disclosing any prior art which would make the invention obvious to a person
skilled in the art. The Controller held that when the “invention is obviating
certain drawbacks of the conventional traction transformer, it cannot be said
that the invention is obvious” in absence of relevant prior art.

7.2.14 An opposition to the grant of a patent under Section 25 of the Patents Act, 1970
for Patent No. 151977 of M/s. Jaya Hind Industries Limited (Applicants)
for “External Rotor Assembly for a Magneto” was filed by M/s. Scooters India
Limited, filed a notice of opposition against the grant of a patent on the above
application on 12th January, 1984. The case was heard on 30th June, 1986.

Grounds of opposition were Prior publication section 25 (1) (b) , Prior public
use and prior public knowledge [section 25 (1) (d)] obviousness and lack of
inventive step section 25 (1) (e), Not an invention or not a patentable invention
section 25 (1) (f) insufficiency and clarity of description [section 25 (1) (g)]

The invention related to an external rotor assembly for a magneto comprising a
ferrous yoke fixed to a nonferrous housing having an angular disc with an even
number of lugs projecting there from, ferrite magnets (with or without their
respective poleshoes) being fixed to the said yoke the said lugs being adapted to hold
securedly between them the said ferrite magnets (with or without their respective
poleshoes) and the said housing being adapted to be mounted on to the crankshaft
of an engine.

In view of the findings in consideration of all matters stated in the written statement,
reply statement and evidence as well as the arguments furnished by the opponents
and applicants during the hearings and all the circumstances of the case, it was
concluded that the opponents have not proved the ground of prior publication
and prior public knowledge and have also not submitted any evidences to the
fact that the invention is obvious. Therefore, the opposition filed by the opponents
M/s. Scooter India Limited on application No. -151977 is dismissed

[Scooters India Ltd. v Jay Hind Industries Ltd, 1987 (7) PTC 204(PO)]
7.2.15 In the matter of Wal Chand Nagar Industries Ltd. v. Thermax Private Ltd., (1988 PTC 213) an invention entitled "A process for recovery of potassium sulphate from waste liquids such as distillery spent-wash" was involved which was posed by the opposition on ground of prior publication and prior public knowledge. However, the opposition could not be established and hence, opposition was dismissed and, patent granted.

7.2.16 In the case of Mechelonic Welders Pvt. Ltd. v. Paul Opprecht, (1988 PTC 126) an opposition was filed against grant of patent for invention 'Electrical Resistance Seam Welding Machines' on the ground of prior use which could not be established. The opposition was dismissed and patent proceeded for grant, subject to the amendment in the applicant's specification.

7.2.17 An Application for patent for an invention entitled 'A method for making a plant growth nutrient/stimulant' was filed by Hindustan Lever Limited. The acceptance of the application was notified in the Gazette of India part III, Section 2 dated 14-12-1982 after a serial number, 150203 was accorded to it.

The invention relates to “A method for making a plant growth nutrient/stimulant which comprises subjecting plant waxes like rice bran wax, camauba wax or sugarcane wax to a step of saponification obtain a mixture of saponified and non saponified matter, whereafter the non-saponified matter is separated and recovered from the said mixture by selective extraction is an organic solvent as the said plant growth nutrient/stimulant, and optionally converting said nutrient/stimulant into a stable aqueous emulsion in a conventional manner.

The alleged method consisted of only two steps and an optional step namely subjecting plant waxes like rice bran wax, camauba wax or sugarcane wax to a step of saponification to obtain a mixture of saponified matter is separated and recovered from the said mixture by selective extraction in an organic solvent as the said plant growth nutrient/stimulant, and, optionally converting said nutrient/stimulant into a stable aqueous emulsion in a conventional manner.

The opponents relied upon scientific publications and expert’s evidence. It is held that properties of unsaponified products is not a fit subject matter for the grant of a valid patent, moreover the ground of prior publication having been established, the opposition succeeds on this ground and it is ordered that the patent shall not be granted.

[Kay Laboratories v. Hindustan Lever Limited (1988 PTC 31 Mum)]

7.2.18 In the case of Abid Kagalwala v. Edgar Haddley Co. Pvt. Ltd. (1984 PTC 234) for an invention relating to 'An improved Electrical Switch', it was held that the applicant has not described as how the use of a resistor in the circuit would be able to eliminate the use of an amplifier. Also the invention has not been properly and clearly described and will not function in the way claimed by the applicants. Hence the patent grant was refused.
7.2.19 In an opposition for the patent no. 194085 [AIR 1961 GUJARAT 120 at Page 125] grounds of opposition included prior disclosure and lack of inventive step.

For the prior disclosure, it was held that “Where prior disclosure is relied upon, it is necessary to point to a clear and specific disclosure of something which can be fairly stated to be the invention of the patentee/applicant. If it is something which is said to be like the patentee's/applicant's invention, there should be a description of its use and the manner in which the patentee/applicant intends it to be used. It is not open to take a packet of prior documents, and, as it were, by means of some process of putting a puzzle together, produce what is said to be a disclosure in the nature of a combination of the various elements which have been contained in the prior documents” and that “To anticipate a patent, a prior publication or activity must contain the whole of the invention impugned, i.e. all the features by which the particular claim attacked is limited, for the anticipation must be such as to describe, or be, an infringement of the claim attacked.”

[M/s. Teva Pharmaceuticals Industries Ltd. v. M/s. Torrent Pharmaceuticals Ltd.]

7.2.20 In the matter of Patent No.- 173462 (224/BOM/1991) between M/s. Hindustan lever limited (Applicants) vs. M/s. Godrej soaps limited (Opponents). The invention related to “process for making a soap composition containing glycerol”. Opposition was on the ground of prior publication Under Section 25 (1)(b), prior public knowledge under section 25 (1)(d), obviousness under Section 25 (1)(e), not an invention within the meaning of the Act Under Section 25 (1)(f) and does not sufficiently define the invention under section 25 (1)(g).

The ingredients recited in the principal claim have a very specific & narrow range of proportions, which are not taught by cited documents. Cited document does not teach how to obtain the right balance of salt & glycerol in order to avoid a soap which is to hard or too soft. Also in cited documents there is no mention of balancing the quantities of glycerol or salt against the quantities of total fatty matter. The present invents offer solution to the problem by retraining glycerol produced during specification of triglycerides in the soap bar composition rather than removing it. Also present invention obtained surprising result that the narrow range of total fatty matter, electrolytes of glycerol been taken together in particular combination by applying combination of three steps lead to soap containing glycerol which has acceptable physical proportion. Alleged invention mention prior art, problems, associated, results of various experiments, all essential components, best method by way of working examples.

Opponent failed to establish the above grounds Hence, the patent proceeded for grant

7.2.21 In the case of 1972-1987 (7) PTC 137(PO), opposition to grant of patent in respect of 'system for concentration of distillery spent wash and method of disposal of spent” was on the grounds of prior publication, public knowledge and obviousness under Section 25 of the Patents Act, 1970. As regards preliminary objection of the
Opponents regarding locus standi of the Applicants to hold patent in their name, it is held that the applicants being a society registered under the Act, it enjoys the Status of legal entity and as such is capable of suing or being sued as well as capable of entering into a contract and accordingly the preliminary objection raised by the Opponents is rejected. As regards grounds of opposition as stated in clauses (a) to (h) of Sub-section (1) of Section 25 of the Act, it was held that the Opponents had failed to establish ground (a) regarding wrongful obtaining of invention. Similarly, the Opponents having failed to substantiate grounds (b), (c), (d) and (e) by way of documentary evidence, the same are also rejected. As regards ground (f), it is held that since subsequent claims do not have any independent status and have to be construed in conjunction with claim 1 and the opponents having failed to analyse claim 1 of the Applicants, this ground also fails. Regarding ground (g) relating to unfair description, the opponents having been successful in establishing the deficiencies in the description, it was ordered that no patent should be granted to the applicants.

7.2.22 In the matter of Patent No, 119964 between M/s Colgate Palmolive & Co. vs. M/s Hindustan Lever Limited; titled “Process and composition for removing stains from fabrics” Applicant raised the objection that the opponent have merely referred to three Indian Prior Patents by numbers without showing how the claims of any of them anticipate the invention of the opposed application. Controller held that “a mere reference is sufficient as it is my duty to see the matters contained therein and thereafter to take or reject any or all of them if they relate to something not appropriate in the proceeding”.

7.2.23 In the matter of Patent No.120345 between Ashok Ganesh Joshi vs. Harbans lal Malhotra & Sons Pvt. Ltd. For an invention titled “Improvements in or relating to blades for razor and the like instruments.” an opposition to the grant of patent filed taking grounds of prior claiming, unfair description and prior public knowledge and user in India of section 9 of Patents Act’ 1911 and after the implementation of Patent Act’1970, it was considered under the corresponding grounds of Section 25 i.e. 25(1)(b)(i), 25(1)(c), 25(1)(d) and 25(1)(g). The Controller held:

“Criteria for prior claiming

In order to establish prior claim it must be shown that the subject matter of a claim in the applicants specification forms the subject matter of a distinct claim in the cited specification. It is not sufficient if the claim is merely comprehended in the subject matter of a claim in the cited specification. This follows from the wording of the section. The comparison must be made between (and limited to) the claims in the relevant specifications that is to say, it does not suffice to support an objection under section 25(1)(e) to show that what is claimed in the application as a subject matter for protection is to be found somewhere comprehended or described in the earlier specification. For the purpose of justifying a finding of prior claim one must find a distinct claim in the earlier specification, which, as a matter of substance, is equivalent to the claim in the applicants’ specification. Before claiming to the conclusion that an invention is claimed in an earlier specification. That invention must be found to be distinctly claimed in the earlier
Taking up next the ground of ‘unfair description’, I would point out that this ground would have a considerable effect in an opposition proceeding if it be clearly established that the specification contains description and claims of the alleged invention which is ambiguous, misleading or cannot be clearly understood. From the full written statement, and the evidences submitted by the opponents it would appear, on the other hand, that what has been understood by the opponents as the alleged invention is fully consistent with the actual alleged invention that has been presented by the applicant in the specification. Furthermore, the description and the claims do not appear to be ambiguous or vague in any way and the invention as has been alleged in the claims can be clearly understood by any man in the art. So there does not appear to be much weight in this ground of ‘unfair description’ and I have to conclude that the opposition has nothing much to gain on this ground also.

Criteria for “Common General Knowledge”

It would appear therefore that when it is a question of common general knowledge i.e., knowledge available in a country for a long time, which every worker in the area is, expected to know; such knowledge would be sufficient to invalidate a patent. Again such a knowledge need not even be found in a particular document. In other words a patent application has to be accessed on the basis of not only what will be available from prior documents but also from the common general knowledge on the subject, which may or may not be available in any such document..............................Even the parameters suggested in the various steps of the process as claimed are not supported by an example or discussion to prove their superiority or specialty for consideration as a “selection”. Further, the Controller concluded that on the ground of Prior public knowledge in India as available from the documents, the prior specifications and the affidavits submitted by the opponents, the opponents have succeeded.

7.2.24 In the matter of Patent No, 124171 granted for “Improved traction and hoisting apparatus” and opposed by M/s Pulling and Lifting Machines Private Limited under section 9 of Patents Act’ 1911 and after the implementation of Patent Act’1970, it was considered under the corresponding grounds of Section 25 i.e. 25(1)(d) and 25(1)(g). The Controller held:

“In an opposition proceeding under section 25 of the Act the responsibility of the opponent does not appear to end with the levelling of certain allegations only against the applicant’s invention but he has the duty under the Act to take adequate interest to diligently pursue the opposition and to establish the grounds he relied upon. However, for not furnishing necessary particulars as aforesaid I am unable to consider the merit of this ground on the basis of what has been merely referred to in the written statement of opposition by the opponents. I hold that the
opponents have failed to discharge their onus to establish the ground of “prior public knowledge or public user in India” taken by them”.

7.2.25 In the matter of Patent No, 146120 ,the petitioners have prayed to the Controller to direct the opponents to withdraw the evidence or amend the same since the drawings annexed to his affidavit were incorrect and not true and that are accordingly the evidence filed by the opponents under rule 38 is false and further to enable the applicants to adduce their evidence under rule 39. The Controller held:

I cannot force them to amend the affidavits simply because the applicants have doubt on the drawings annexed to the affidavits filed by the opponents. The Controller has full power either to reject or to accept the affidavit fully or partly after the final hearing of the parties but cannot force the party to the proceeding to amend the affidavit. I do not agree with applicant counsel’s arguments that the Controller is empowered under section 77 and rule 113 to force the party to proceeding to amend their affidavit on merely a doubt raised by the applicants. The expression “any other matter’ under section 77(1)(h) means any other matter prescribed under the Act or the Rules allied to what are given in clauses (a) to (g) of sub-section (1) of Section 77. It cannot mean any other matter not prescribed under the Act or the Rules or matters not allied to such as specified in clause (a) to (g) of Section 77(1). Similarly the expression “to perform an act, file a document or produce evidence” of Rule 113 has to be read as allied matters. One cannot assign different meaning to each expression. Under Rule 113, if the Controller is of the opinion that it is necessary, then only he will ask the party to perform an act, file a document or produce evidence. Since the Controller cannot go into the merits of the case at this stage, he cannot form any opinion. Therefore, the question of asking the opponents to perform an act does not arise. Further since I have already said that the expression “to perform an act” is an allied expression to file a document or to produce evidence, it cannot mean that the Controller can force the party to amend the evidence. As regards applicant counsel’s argument under the Civil Procedure Code, I would state that the Controller is technically not a Court and the C.P.C. is not applicable before him (A.I.R. 1934 Cal. 725).

7.2.26 In the matter of Patent No, 140797 titled: “Electronic area Measuring Machine” with regard to the issue of “Obviousness”, the applicant stated that the object of the invention is to devise a reliable, compact and accurate area measuring machine with a simple mechanism, easy to maintain and functioning almost automatically. The Controller held that; It is obvious that the skin must pass over a rigid surface while its area is being measured and the endless conveyor and two end rollers around which said conveyor passes in the prior art of the said French specification have been replaced by two guide rollers and a slotted table in the present invention. The use of a table in conjunction with such machine has already been disclosed in the extract of Turner Machine ……It is obvious that a table, if used in such a machine has necessarily to be slotted or perforated to allow light rays from the light source to pass there through so as to
fall on the light sensitive devices located on the opposite side, otherwise Light sensitive devices will not operate when a skin or any opaque object passes over such table...........

The applicant has not made any scintilla of invention in the provision of electronic circuits claimed in the statement of claims, as the same has been admitted in the specification to be known in the art.

7.2.27 In the matter of Patent No. 150310 dated 21.06.1978 titled “Electro-erosion method an apparatus for taper cutting an electrically conductive work piece with a wire electro and the work piece so cut”. the applicant for patent raised the issue of the locus standi of the opponents on the ground that the opponents are manufacture of electrical & electronic goods for medical and industrial applications are not engaged in any manner on a commercial scale, in a manufacture, lease or sailing of wire cut or travelling wire electrical erosion machine and the applicant invention does not in any way conflict with the subject matter of the opponent business. The Controller held that the opponent justify by their activities that they have locus standi as person interested to file the opposition. This conclusion was reached by the Controller after relying on the 29 RPC(1912” “that it is sufficient for the opponent to be able to show a bonafide and existing interest at the time when the opposition is heard” and also relying on the views of U.K. Controller General that the right to oppose a patent be extended to all those who can show bonafide and satisfactory reason to oppose.

7.2.28 In the matter of Patent No. 149901 and in the matter of Substitution of name of the opponent during opposition under section 25, the application was opposed by Board of Tea Research Institute of Ceylon, Sri Lanka & Competent authority the Govt. of Sri Lanka successor of business undertaking of Colombo Commercial Company (Engineering) Ltd., Sri Lanka. The Board of Tea Research Institute of Ceylon was amalgamated with Sri Lanka tea Board by virtue of Law No. 14 of 1975 and all the rights and obligation including property of the Tea Research Board Institute should be deemed to be the right and obligation of the Board. However the provision of this law according to the notification was to come into operation on such date as may be appointed by the Minister and published. There was no proof on the record to prove that any date has been appointed by the Minister in order to operationalise the said law. Therefore, Controller held that the name of Board of Tea Research Institute of Ceylon can not be substituted by its successor namely Sri Lanka Tea Board. It was further held (the Terrel on Law Patent at page no. 171 ) that “ A different opponent can not be substituted by amendment after the expiry of the opposition period even if he acquires and interest from the original opponents . further it is intended to limit opposition proceedings to persons who possess necessary interest in the period laid down for opposition and also excluding a person who only acquired such interest subsequently even if it is acquired from a person who had it an used it at the time lodging opposition and therefore substitution of opponents asked for is not legitimate.

7.2.29 With regard to further evidence at the time of hearing of opposition under section 25, in the opposition proceedings in respect of application for patent No. 150113 the opponent filed further evidence at the time of hearing. This was objected by the applicant by filing a petition for not admitting such further evidence of the opponent. It was held by the Controller that in the practice of
Patent Office the leave for filing further evidence is freely given right up to the hearing and therefore it is right an proper both in the interest of the public and all concerned that all relevant material should be before the Controller when an opposition cases is tried. However, the applicant would be allowed to file a counter affidavit within the specified time.

7.2.30 Patent Application Nos. 369/MAS/1988 and 765/MAS/2000 were refused because of the non prosecution of application by the applicant under opposition proceedings. Whereas application No. 699/MAS/1996 was allowed to proceed for grant because of the failure of opposition. In Patent Application No. 2207/MAS/1997 (183745) the opponents were not allowed to file evidence on expiry of the prescribed time lines and the presumable extension thereof in order to avoid undue delay in the grant proceedings.

7.3 Action In Case Of Wrongful Obtaining (S. 26)

Section 26;

In cases of "obtaining" Controller may treat the patent as the patent of opponent;

(1) Where in any opposition proceeding under this Act the Controller finds that-

(a) the invention, so far as claimed in any claim of the complete specification, was obtained from the opponent in the manner set out in clause (a) of sub-section (2) of section 25 and revokes the patent on that ground, he may, on request by such opponent made in the prescribed manner, direct that the patent shall stand amended in the name of the opponent;

(b) a part of an invention described in the complete specification was so obtained from the opponent, he may pass an order requiring that the specification be amended by the exclusion of that part of the invention.

(3) Where an opponent has, before the date of the order of the Controller requiring the amendment of a complete specification referred to in clause (b) of sub-section (1), filed an application for a patent for an invention which included the whole or a part of the invention held to have been obtained from him and such application is pending, the Controller may treat such application and specification in so far as they relate to the invention held to have been obtained from him, as having been filed, for the purposes of this Act relating to the priority dates of claims of the complete specification, on the date on which the corresponding document was or was deemed to have been filed by the patentee in the earlier application but for all other purposes the application of the opponent shall be proceeded with as an application for a patent under this Act.

Rule 63A:
Request made under section 26(1):
Request under section 26(1) shall be made on Form 12 within three months from the date of the order of the Controller and shall be accompanied by a statement setting out the facts upon which the petitioner relies and relief he claims.

7.3.1 Wrongfully Obtaining:

Where the Controller refuses the application on the ground of wrong full obtaining, as a result of proceedings under section 25(2) clause (a), and revokes the patent on this ground, a request can be made by the opponent in Form 12 along with the prescribed fee and in the prescribed manner to allow the patent in the name of the opponent. The Controller, upon such request may direct the application to proceed in the name of the opponent with the benefit of priority date attached to the application and order for such an amendment. However, if only a part of the invention described in the complete specification has been obtained from the opponent, the Controller may allow specification of the patentee to be amended by exclusion of that part. A special situation is illustrated by Section 26 (2) where the application from opponent containing the whole or a part of the invention held to be obtained from him has been filed before the order of the Controller u/s 26(1) (b) for amendment of patentee’s specification on the grounds of obtaining and such application is pending. In such a case, the Controller may treat the application and specification filed by opponent containing the whole or apart of invention so excluded from applicant’s (patentee’s) specification as opponent’s application with the same priority date as the earlier application; but for all other purposes the opponent’s application will be treated as an independent application under the Act.

Procedure for Opposition U/S 25(2)

(Figure: Flow Chart showing the procedure from Grant to Decision, including Notification, Reply, Evd., Appointment of hearing, Hearing, and Decision.)
7.4 Mention Of Inventor As Such In Patent

Section 28:

(1) If the Controller is satisfied, upon a request or claim made in accordance with the provisions of this section,—

   (a) that the person in respect of or by whom the request or claim is made is the inventor of an invention in respect of which application for a patent has been made, or of a substantial part of that invention; and
   (b) that the application for the patent is a direct consequence of his being the inventor,

the Controller shall, subject to the provisions of this section, cause him to be mentioned as inventor in any patent granted in pursuance of the application in the complete specification and in the register of patents:

Provided that the mention of any person as inventor under this section shall not confer or derogate from any rights under the patent.

(2) A request that any person shall be mentioned as aforesaid may be made in the prescribed manner by the applicant for the patent or (where the person alleged to be the inventor is not the applicant or one of the applicants) by the applicant and that person.

(3) If any person other than a person in respect of whom a request in relation to the application in question has been made under sub-section (2) desires to be mentioned as aforesaid, he may make a claim in the prescribed manner in that behalf.

(4) A request or claim under the foregoing provisions of this section shall be made before the grant of patent.

(6) Where a claim is made under sub-section (3), the Controller shall give notice of the claim to every applicant for the patent (not being the claimant) and to any other person whom the Controller may consider to be interested; and before deciding upon any request or claim made under sub-section (2), or sub-section (3), the Controller shall, if required, hear the person in respect of or by whom the request or claim is made, and, in the case of a claim under sub-section (3), any person to whom notice of the claim has been given as aforesaid.

(7) Where any person has been mentioned as inventor in pursuance of this section, any other person who alleges that he ought not to have been so mentioned may at any time apply to the Controller for a certificate to that effect, and the Controller may, after hearing, if required, any person whom he may consider to be interested, issue such a certificate, and if he does so, he shall rectify the specification and the register accordingly.
Rule 66:
A request under subsection (2) of section 28 shall be made in Form 8.

Rule 67:

(1) A claim under subsection (3) of section 28 shall be made in Form 8, and shall be accompanied by a statement setting out the circumstances under which the claim is made.
(2) A copy of the claim and the statement shall be sent by the Controller to every applicant for the patent (not being the claimant) and to any other person whom the Controller may consider to be interested.

Rule 68:

(1) An application under sub-section (7) of section 28 shall be made in Form 8 and shall be accompanied by a statement setting out the circumstances under which the application is made.
(2) A copy of the application and the statement shall be sent by the Controller to each patentee or the applicant for patent, as the case may be, and to any other person whom the Controller may consider to be interested.

Rule 69:

The procedure specified in rules 55A and 57 to 63 relating to the filing of notice of opposition, written statement, reply statement, leaving evidence, hearing and cost shall, so far as may be, apply to the hearing of a claim or an application under section 28 as they apply to the opposition proceedings subject to the modification that reference to patentee shall be construed as the person making the claim, or an application, as the case may be.

Rule 70:

Any mention of the inventor under sub-section (1) of section 28 shall be made in the relevant documents in the following form namely:-

"The inventor of this invention/substantial part of this invention within the meaning of section 28 of the Patents Act, 1970, is ...of............".

7.4.1 Mention Of Inventor As Such In Patent (Section 28)

If the inventor desires to have his name mentioned as such in a patent by virtue of his being the actual inventor of the invention or a substantial part of the invention, he may make an application to that effect. The Controller if satisfied, will cause him to be mentioned as inventor in the complete specification and in the register of patents.

(a) The request shall be made at anytime before the grant of patent.
(b) The request when made by the applicant for patent alone or jointly with the person alleged to be the inventor, shall be on form 8.

(c) If the request is made by the person claiming to be the actual deviser of invention, who is not the applicant for a patent, the claim must be made on Form 8 accompanied by a statement setting out the circumstances under which the claim is made.

(d) The Controller will give notice of the claim to every applicant (not being the claimant) and to any other person who is considered to be interested, and decide the case after hearing the parties concerned, if so required. Any person to whom the Controller has sent copies of the request or claim made under Section 28 may oppose such request or claim. The procedure to be followed in dealing with such opposition is the same as prescribed in rules 55A, 57 to 63 relating to opposition to grant of patent. Where the Controller allows the request, the mention of the inventor will be made in the patent and in the complete specification in the form prescribed in rule 70. Mention of the inventor will also be made in the register of patents.

(e) If any person alleges that the person who is mentioned as the inventor ought not to have been so mentioned, he may make an application on form 8 accompanied by a statement of case for a certificate to that effect. If the Controller decides the case in favour of the person making the claim, he will issue a certificate and rectify the specification and register accordingly.
CHAPTER VIII

What Are Not Anticipations?

Section 29:

Anticipation by previous publication.—

(1) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published in a specification filed in pursuance of an application for a patent made in India and dated before the 1st day of January, 1912.

(2) Subject as hereinafter provided, an invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published before the priority date of the relevant claim of the specification, if the patentee or the applicant for the patent proves—

(a) that the matter published was obtained from him, or (where he is not himself the true and first inventor) from any person from whom he derives title, and was published without his consent or the consent of any such person; and

(b) where the patentee or the applicant for the patent or any person from whom he derives title learned of the publication before the date of the application for the patent, or, in the case of a convention application, before the date of the application for protection in a convention country, that the application or the application in the convention country, as the case may be, was made as soon as reasonably practicable thereafter:

Provided that this sub-section shall not apply if the invention was before the priority date of the claim commercially worked in India, otherwise than for the purpose of reasonable trial, either by the patentee or the applicant for the patent or any person from whom he derives title or by any other person with the consent of the patentee or the applicant for the patent or any person from whom he derives title.

(4) Where a complete specification is filed in pursuance of an application for a patent made by a person being the true and first inventor or deriving title from him, an invention claimed in that specification shall not be deemed to have been anticipated by reason only of any other application for a patent in respect of the same invention made in contravention of the rights of that person, or by reason only that after the date of filing of that other application the invention was used or published, without the consent of that person, by the applicant in respect of that other application, or by any other person in consequence of any disclosure of any invention by that applicant.

8.1.1. With regard to exception to anticipation under Section 29(2)(a), an application for patent 136965 was filed on 29/04/1972. However, a drawing No. P4219
relating to the invention was handed over to M/s. Colliery Mining Machinery company by TISCO on 6th April, 1972. The application was opposed on the ground of prior publication in view of the above drawings. It was held by the Controller that for seeking protection under section 29(2)(a), it is necessary for the applicant to prove that TISCO obtained the drawing No. P4219 from CFRI (Applicant) and published it without the consent of CFRI and there was no commercial working of the invention before the priority date of the claimed invention in the complete specification. Since there is no evidence on the record to prove that the drawing was published by TISCO without the consent of CFRI and TISCO handed over the drawing to M/s. Colliery Mining Machinery Company along with the worked order without any condition. Therefore, this kind of act amount to publication of the drawing prior to date of the filing of the application.

Section 30:
Anticipation by previous communication to Government.—

An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of the communication of the invention to the Government or to any person authorized by the Government to investigate the invention or its merits, or of anything done, in consequence of such a communication, for the purpose of investigation.

Section 31:
Anticipation by public display, etc

An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of—

(a) the display of the invention with the consent of the true and first inventor or a person deriving title from him at an industrial or other exhibition to which the provisions of this section have been extended by the Central Government by notification in the Official Gazette, or the use thereof with his consent for the purpose of such an exhibition in the place where it is held; or

(b) the publication of any description of the invention in consequence of the display or use of the invention at any such exhibition as aforesaid; or

(c) the use of the invention, after it has been displayed or used at any such exhibition as aforesaid and during the period of the exhibition, by any person without the consent of the true and first inventor or a person deriving title from him; or

(d) the description of the invention in a paper read by the true and first inventor before a learned society or published with his consent in the transactions of such a society,
if the application for the patent is made by the true and first inventor or a person deriving title from him not later than twelve months after the opening of the exhibition or the reading or publication of the paper, as the case may be

Section 32:

Anticipation by public working

An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that at any time within one year before the priority date of the relevant claim of the specification, the invention was publicly worked in India—

(a) by the patentee or applicant for the patent or any person from whom he derives title; or
(b) by any other person with the consent of the patentee or applicant for the patent or any person for whom he derives title,

if the working was effected for the purpose of reasonable trial only and if it was reasonably necessary, having regard to the nature of the invention, that the working for that purpose should be effected in public.

Section 33:

Anticipation by use and publication after provisional specification

(1) Where a complete specification is filed or proceeded with in pursuance of an application which was accompanied by a provisional specification or where a complete specification filed along with an application is treated by virtue of a direction under sub-section (3) of section 9 as a provisional specification, then, notwithstanding anything contained in this Act, the Controller shall not refuse to grant the patent, and the patent shall not be revoked or invalidated, by reason only that any matter described in the provisional specification or in the specification treated as aforesaid as a provisional specification was used in India or published in India or elsewhere at any time after the date of the filing of that specification.

(2) Where a complete specification is filed in pursuance of a convention application, then, notwithstanding anything contained in this Act, the Controller shall not refuse to grant the patent, and the patent shall not be revoked or invalidated, by reason only that any matter disclosed in any application for protection in a convention country upon which the convention application is founded was used in India or published in India or elsewhere at any time after the date of that application for protection.

Section 34:

No anticipation if circumstances are only as described in Sections 29, 30, 31 and 32

Notwithstanding anything contained in this Act, the Controller shall not refuse to grant a patent, and a patent shall not be revoked or
invalidated by reason only of any circumstances which, by virtue of section 29 or section 30 or section 31 or section 32, do not constitute an anticipation of the invention claimed in the specification.

Rule 28:
Procedure in case of anticipation by prior publication.—

(1) If the Controller is satisfied after investigation under section 13 that the invention so far as claimed in any claim of the complete specification has been published in any specification or other document referred to in clause (a) of sub-section (1) or sub-section (2) of the said section, the Controller shall communicate the gist of specific objections and the basis thereof to the applicant and the applicant shall be afforded an opportunity to amend his specification.

(2) If the applicant contests any of the objections communicated to him by the Controller under sub-rule (1), or if he refiles his specification along with his observations as to whether or not the specification is to be amended, he shall be given an opportunity to be heard in the matter if he so requests:
Provided that such request shall be made on a date earlier than ten days of the final date of the period referred to under sub-section (1) of section 21:
Provided further that a request for hearing may be allowed to be filed within such shorter period as the Controller may deem fit in the circumstances of the case.

(3) If the applicant requests for a hearing under sub-rule (2) within a period of one month from the date of communication of the gist of objections, or, the Controller, considers it desirable to do so, whether or not the applicant has refiled his application, he shall forthwith fix a date and time for hearing having regard to the period remaining for putting the application in order or to the other circumstances of the case.

(5) The applicant shall be given ten days' notice of any such hearing or such shorter notice as appears to the Controller to be reasonable in the circumstances of the case and the applicant shall, as soon as possible, notify the Controller whether he will attend the hearing.

(6) After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Controller may specify or permit such amendment of the specification as he thinks fit to be made and may refuse to grant the patent unless the amendment so specified or permitted is made within such period as may be fixed.

Rule 28A:
Procedure in relation to consideration of report of examiner under section 14.—In case the applicant contests any of the objections communicated to him, the procedure specified under rule 28 may apply.

Rule 29:
Procedure in case of anticipation by prior claiming.—

(1) When it is found that the invention so far as claimed in any claim of the complete specification, is claimed in any claim of any other specification falling within clause (b) of sub-section (1) of section 13, the
applicant shall be so informed and shall be afforded an opportunity to amend his specification.

(2) If the applicant's specification is otherwise in order for grant and an objection under clause (b) of sub-section (1) of section 13 is outstanding, the Controller may postpone the grant of patent and allow a period of two months for removing the objection.

Rule 30:
Amendment of the complete specification in case of anticipation.—

(1) If the applicant so requests at any time, or if the Controller is satisfied that the objection has not been removed within the period referred to in sub-rule (2) of rule 29, a date for hearing the applicant shall be fixed forthwith and the applicant shall be given at least ten days' notice of the date so fixed. The applicant shall, as soon as possible, notify the Controller whether he will attend the hearing.

(2) After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Controller may specify or permit such amendment of the specification as will be to his satisfaction to be made and may direct that reference to such other specification, as he shall mention shall be inserted in the applicant's specification unless the amendment is made or agreed to within such period as he may fix.

Rule 31:
Form of reference to another specification.—

When in pursuance of rule 30, the Controller directs that a reference to another specification shall be inserted in the applicant's complete specification, such reference shall be inserted after the claims and shall be in the following form, namely:

"Reference has been directed, in pursuance of section 18(2) of the Patents Act, 1970, to the specification filed in pursuance of application No……"

Rule 32:
Procedure in case of potential infringement.—

If in consequence of an investigation made under section 13, it appears to the Controller that the applicant's invention cannot be performed without substantial risk of infringement of a claim of another patent, the applicant shall be so informed and the procedure provided in rule 29 shall, so far as may be necessary, be applicable.

Rule 33:
Form of reference to another patent:

Where the Controller directs that a reference to another patent shall be inserted in the applicant's complete specification under sub-section (1) of section 19, such reference shall be inserted, after the claims in the following form, namely:
8.1.2 Not Anticipations: The invention is not anticipated i.e. novelty of an invention is not destroyed in certain exceptional conditions, specially provided in the Act in Sections 29-34.

a) Prior Publication (S. 29)

The invention claimed in the complete specification will not be considered as anticipated by a specification accompanying an application in India, which was published before the 1st day of January, 1912.

A prior publication of an invention before its priority date will not be deemed as anticipation, if the patentee or the applicant proves that the matter was obtained from him or the inventor or assignor, and that the publication was done without their knowledge, and the application for patent was therefore made immediately after learning that the publication had happened.

This provision will not apply if the invention was commercially worked in India, otherwise for the purpose of reasonable trial before the priority date of the claim by the inventor, patentee or applicant, their assignor or assignee or some one else having their consent.

An invention claimed in an application made by the inventor or his assignee should not be deemed as anticipated by another application for patent in respect of the same invention made in contravention of the rights of that person, or its publication or use by the other applicant or any other person in consequence of its disclosure by him without the consent of the first mentioned applicant.

b) Previous communication to Government (S. 30)

The invention will not be deemed as anticipated by its communication to the government or to any person authorized by the government to investigate the invention or its merits, or of anything done in consequence of such communication for the purpose of the investigation.

c) Prior Public Display etc. (S. 31)

If the application for the patent is made by the inventor or his assignee not later than twelve months after the opening of the exhibition (notified by the Central Government) where the invention is first displayed and published by the applicant or used with his consent, it will not be deemed as anticipated. The use of the invention (so displayed) by an unauthorized person during the period of exhibition also will be deemed as non-anticipation.

(d) The description of the invention in a paper read by the true and first inventor or its publication with his consent in the transactions before a learned society
also does not constitute anticipation, if the application is made within the period of twelve months.

e) Prior Public Working (S. 32)

This deals with public working of an invention claimed in a complete specification for a reasonable trial because the nature of the invention is such that it was necessary to do so. This type of public working will not be deemed as anticipation if performed within one year before the priority date by the patentee, applicant (or assignor) or by any person with their consent.

f) Use and Publication after provisional specifications (S. 33)

An invention in an application should not be considered as anticipated by public use and/or publication of the invention in India or elsewhere after the corresponding filing date of the provisional specification or the prior application in a convention country for which a priority is claimed.
CHAPTER IX

PROVISIONS OF SECRECY OF CERTAIN INVENTIONS

Section 35. Secrecy directions relating to inventions relevant for defence purposes.-

1) Where, in respect of an application made before or after the commencement of this Act for a patent, it appears to the Controller that the invention is one of a class notified to him by the Central Government as relevant for defence purposes, or, where otherwise the invention appears to him to be so relevant, he may give directions for prohibiting or restricting the publication of information with respect to the invention or the communication of such information.

2) Where the Controller gives any such directions as are referred to in subsection (1), he shall give notice of the application and of the directions to the Central Government, and the Central Government shall, upon receipt of such notice, consider whether the publication of the invention would be prejudicial to the defence of India, and if upon such consideration, it appears to it that the publication of the invention would not so prejudice, give notice to the Controller to that effect, who shall thereupon revoke the directions and notify the applicant accordingly.

3) Without prejudice to the provisions contained in sub-section (1), where the Central Government is of opinion that an invention in respect of which the Controller has not given any directions under section (1), is relevant for defence purposes, it may at any time before the grant of patent notify the Government to that effect, and thereupon the provisions of that subsection shall apply as if the invention where one of the class notified by the Central Government, and accordingly the Controller shall give notice to the central Government of the directions issued by him.

Section 36. Secrecy directions to be periodically reviewed.-

1) The question whether an invention in respect of which directions have been given under section 35 continues to be relevant for defence purposes shall be reconsidered by the Central Government at intervals of six months or on a request made by the applicant which is found to be reasonable by the Controller and if, on such reconsideration it appears to the Central Government that the publication of the invention would no longer be prejudicial to the defence of India or in case of an application filed by a foreign applicant it is found that the invention is published outside India it shall forthwith give notice to the Controller to revoke the direction and the Controllers shall thereupon revoke the directions previously given by him.
(2) The result of every re-consideration under sub-section (1), shall be communicated to the applicant within such time and in such manner as may be prescribed.

Section 37. Consequences of secrecy directions.-

(1) So long as any directions under section 35 are in force in respect of an application—
   (a) the Controller shall not pass an order refusing to grant the same; and notwithstanding anything contained in this Act, no appeal shall lie from any order of the Controller passed in respect thereof:
       Provided that the application may, subject to the directions, proceed up to the stage of grant of the patent, but the application and the specification found to be in order for grant of the patent shall not be published, and no patent shall be granted in pursuance of that application.

(2) Where a complete specification filed in pursuance of an application for a patent for an invention in respect of which directions have been given under section 35 is found to be in order for grant of the patent during the continuance in force of the directions, then—
   (a) if, during the continuance in force of the directions, any use of the invention is made by or on behalf of, or to the order of the Government, the provisions of sections 100, 101 and 103 shall apply in relation to that use as if the patent had been granted for the invention; and
   (b) if it appears to the Central Government that the applicant for the patent has suffered hardship by reason of the continuance in force of the directions, the Central Government may make to him such payment (if any) by way of solatium as appears to the Central Government to be reasonable having regard to the novelty and utility of the invention and the purpose for which it is designed, and to any other relevant circumstances.

(3) Where a patent is granted in pursuance of an application in respect of which directions have been given under section 35, no renewal fee shall be payable in respect of any period during which those directions were in force.

Section 38. Revocation of secrecy directions and extension of time.-

When any direction given under section 35 is revoked by the Controller, then, notwithstanding any provision of this Act specifying the time within which any step should be taken or any act done in connection with an application for the patent, the Controller may, subject to such conditions, if any, as he thinks fit to impose, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application whether or not that time has previously expired.

Section 39. Residents not to apply for patents outside India without prior permission.—
(1) No person resident in India shall, except under the authority of a written permit sought in the manner prescribed and granted by or on behalf of the Controller, make or cause to be made any application outside India for the grant of a patent for an invention unless—

(a) an application for a patent for the same invention has been made in India, not less than six weeks before the application outside India; and

(b) either no direction has been given under sub-section (1) of section 35 in relation to the application in India, or all such directions have been revoked.

(2) The Controller shall dispose of every such application within such period as may be prescribed:

Provided that if the invention is relevant for defence purpose or atomic energy, the Controller shall not grant permit without the prior consent of the Central Government.

(3) This section shall not apply in relation to an invention for which an application for protection has first been filed in a country outside India by a person resident outside India.

Section 40. Liability for contravention of section 35 or section 39.—

Without prejudice to the provisions contained in Chapter XX, if in respect of an application for a patent any person contravenes any direction as to secrecy given by the Controller under section 35 [or makes or causes to be made an application for grant of a patent outside India in contravention of section 39] the application for patent under this Act shall be deemed to have been abandoned and the patent granted, if any, shall be liable to be revoked under section 64.

Section 41. Finality of orders of Controller and Central Government.—

All orders of the Controller giving directions as to secrecy as well as all orders of the Central Government under this Chapter shall be final and shall not be called in question in any court on any ground whatsoever.

Section 42. Savings respecting disclosure to Government.—

Nothing in this Act shall be held to prevent the disclosure by the Controller of information concerning an application for a patent or a specification filed in pursuance thereof to the Central Government for the purpose of the application or specification being examined for considering whether an order under this Chapter should be made or whether an order so made should be revoked.

Rule 71. Permission for making patent application outside India under section 39.—

(1) The request for permission for making patent application outside India shall be made in Form 25.
(2) The time within which the Controller dispose of the request made under sub-rule (1), except in case of inventions relating to defence and atomic energy applications, shall ordinarily be within a period of twenty one days from the date of filing of such request.

Rule 72. Communication of result of reconsideration under section 36(2) -

(1) The result of every reconsideration under sub-section (1) of section 36 shall be communicated to the applicant for patent within fifteen days of the receipt of the notice by the Controller.

(2) Extension of time on revocation of secrecy directions under section 38.- The extension of time to be given for doing anything required or authorised to be done under section 38 shall not exceed the period for which directions given by the Central Government under sub-section (1) of section 35 were in force.

9.1 Secrecy Directions For Certain Inventions relevant for defence purposes (S.35)

9.1.1 The Patents Act provides for secrecy directions for certain inventions which are relevant for defence purposes. The Act empowers the Central Government to prohibit publication of the information relating to such inventions. Section 35(1) provides that the Controller may give direction for prohibiting or restricting the publication of information, relating to certain specific inventions or the communications of such information, if it appears to him that the invention in question is one of a class notified to him by Central Government as relevant for defence purposes or the Controller himself considers it to be so.

9.1.2 If such directions have been given, the Controller will give notice of the application and of the direction to the Central Government. If the Central Government considers that the publication of the invention in question would not be prejudicial to the defence of India, it will inform the Controller to that effect who, upon receiving such information, will revoke the secrecy direction and inform the applicant [S. 35(2)] accordingly.

9.1.3 Also, if the Central Government is of the opinion that the invention, in respect of which the Controller has not issued secrecy direction, it may notify to that effect to the Controller before the grant of the patent, who will issue the secrecy direction to the applicant on receipt of such a notice from Central Government and inform the government accordingly about the secrecy directions issued by the Controller.

9.1.4 The Central Government, will review the question on whether the invention continues to be relevant for defence purposes at intervals of 6 months or on a request made by the applicant which is found to be reasonable by the Controller and, if it is found that the invention is no longer prejudicial for defence of India, the Controller will be given notice to revoke the secrecy direction previously given by him.

9.1.5 If the patent application was made by a foreign applicant and the invention was found published outside India the Central Government shall forthwith give notice to the Controller to revoke the secrecy direction (S. 36).
9.1.6 The result of every reconsideration will be communicated, in writing, to the applicant within fifteen days of the receipt of the notice by the Controller [Rule 72(1)] from Central Government

9.2 Consequences Of Secrecy Direction (S.37)

9.2.1 During the period when the secrecy direction is in force, the application will not be published.

9.2.2 If, during the continuance in force of the directions, any use of the invention is made by or on behalf of, or to the order of the Government, the provisions of Section 100 (Power of Central government to use inventions for the purpose of Government), Sections 101 (Right of Third parties in respect of use of inventions for purposes of Government) and Section 103 (Reference to High Court of disputes as to use for purposes of Government) shall apply in relation to that use, as if the patent has been granted for the invention.

9.2.3 If the Central Government finds that the applicant has suffered hardship by reason of continuance of such direction, it may make payment of a suitable sum to the applicant by way of solatium, having regard to novelty and the utility of the invention and the purpose for which it is designed [S.37 (2) (b)].

9.2.4 If a patent is granted to the invention in respect of which secrecy direction have been issued, no renewal fee is payable in respect of the period during which such direction was in force [S.37 (3)].

9.2.5 When any direction under section 35 is revoked by the Controller, then, notwithstanding any provision of the Act specifying the time within which any step should be taken or any act done in connection with an application for the patent, the Controller may, subject to such conditions, if any, as he thinks fit to impose, extend the time for doing anything required or authorize to be done by or under this Act in connection with application, whether or not that time has previously expired. (S.38)

9.3 Prohibition to Apply for Patent for inventions outside India without permission (S.39)

9.3.1 This provision is made to prevent a person resident in India to make or cause to be made an application outside India for the grant of a patent for an invention without seeking prior permission from the Controller.

9.3.2 If an application has been made in India in respect of the same invention and if six weeks have elapsed and no secrecy direction is given under S.35 (or such direction is revoked thereafter), the applicant may proceed with filing outside India.

9.3.3 If the invention is relevant for defence purpose and atomic energy, the Controller shall not grant permission without the prior consent of the Central Government.

9.3.4 These provisions will not apply if the application for patent was first made outside India by a person resident outside India.
9.3.5 The request for permission for making patent application outside India should be made in Form 25 with prescribed fee (Rule 71(1)) as given in the first schedule and the Controller shall dispose the said request ordinarily within a period of 21 days from the date of filing such request [Rule 71(2)].

9.4 Other Provisions

9.4.1 If any person contravenes any direction as to secrecy issued by the Controller, the application for patent will be deemed to have been abandoned, and the patent if granted, shall be liable to be revoked under section 64 (1) (n) [as provided in section. 40]. It may be noted that these provisions are in addition to the penalty that may be imposed under section 118 of the Act which includes imprisonment for a term which may extend to 2 years or fine or both.

9.4.2 All the orders of the Controller giving directions as to secrecy as well as all orders of the Central Government under this chapter will be final and shall not be called in question in any court on any ground whatsoever. (S.41)

9.4.3 No provision in the Act prevents the Controller to disclose the information concerning an application for patent or the specification thereof to the Central Government for it to be examined for considering whether any secrecy direction or revocation thereof should be issued. Further, the Central Government may undertake the following:

   i. The Government may import or make on its own or on its behalf, any patented machine, apparatus or other article or any article made by a patented process, for the purpose of its own use.

   ii. Similarly, it can use any patented process for its own use.

   iii. The patent can be used by any persons for the purpose of experiment or research including the imparting of instruction to pupils.

9.4.4 In case of a patented medicine or drug, the same may be imported by the Government for its own use or for distribution in any dispensary, hospital or other medical institution maintained by or on behalf of the Government or any other dispensary, hospital or other medical institution which the Central Government may, having regard to the public service that such dispensary, hospital or medical institution renders, specify in this behalf by notification in the Official Gazette.
CHAPTER X

GRANT OF PATENT

Section 43. Grant of patents.-

(1) Where an application for a patent has been found to be in order for grant of the patent and either—
   (a) the application has not been refused by the Controller by virtue of any power vested in him by this Act; or
   (b) the application has not been found to be in contravention of any of the provisions of this Act,
   the patent shall be granted as expeditiously as possible to the applicant or, in the case of a joint application, to the applicants jointly, with the seal of the patent office and the date on which the patent is granted shall be entered in the register.

(2) On the grant of patent, the Controller shall publish the fact that the patent has been granted and thereupon the application, specification and other documents related thereto shall be open for public inspection.

Rule 74. Form of patent.-

(1) A patent shall be in the form as specified in the Third Schedule with such modifications as the circumstances of each case may require and shall bear the number accorded to the application under rule 37.

(2) The patent certificate shall ordinarily be issued within seven days from the date of grant of patent under section 43.

Rule 74A. Inspection of documents related to grant of patent.-

After the date of publication of a grant of a patent, the application together with the complete specification and provisional specification, if any, the drawing if any, abstract and other documents related thereto may be inspected at the appropriate office by making a written request to the Controller and on payment of fee and may obtain copies on payment of fee specified in the First Schedule.

Section 44. Amendment of patent granted to deceased applicant.-

Where, at any time after a patent has been granted in pursuance of an application under this Act, the Controller is satisfied that the person to whom the patent was granted had died, or, in the case of a body corporate, had ceased to exist, before the patent was granted, the Controller may amend the patent by substituting for the name of that person the name of the person to whom the patent ought to have been granted, and the patent shall have effect, and shall be deemed always to have had effect, accordingly.
Rule 75. Amendment of patent under section 44.-

An application under section 44 for the amendment of a patent shall be made in Form 10 along with substantiating evidence and be accompanied by the patent.

Section 45. Date of patent.-

(1) Subject to the other provisions contained in this Act, every patent shall be dated as of the date on which the application for patent was filed.

(2) The date of every patent shall be entered in the register.

(3) Notwithstanding anything contained in this section, no suit or other proceeding shall be commenced or prosecuted in respect of an infringement committed before the date of publication of the application.

Section 46:
Form, extent and effect of patent.-

(1) Every patent shall be in the prescribed form and shall have effect throughout India.

(2) A patent shall be granted for one invention only:
Provided that it shall not be competent for any person in a suit or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

Section 47:
Grant of patents to be subject to certain conditions.-

The grant of a patent under this Act shall be subject to the condition that;

(1) any machine, apparatus or other article in respect of which the patent is granted or any article made by using a process in respect of which the patent is granted, may be imported or made by or on behalf of the Government for the purpose merely of its own use;

(2) any process in respect of which the patent is granted may be used by or on behalf of the Government for the purpose merely of its own use;

(3) any machine, apparatus or other article in respect of which the patent is granted or any article made by the use of the process in respect of which the patent is granted, may be made or used, and any process in respect of which the patent is granted may be used, by any person, for the purpose merely of experiment or research including the imparting of instructions to pupils; and

(4) In the case of a patent in respect of any medicine or drug, the medicine or drug may be imported by the Government for the purpose
merely of its own use or for distribution in any dispensary, hospital or other medical institution maintained by or on behalf of the Government or any other dispensary, hospital or other medical institution which the Central Government may, having regard to the public service that such dispensary, hospital or medical institution renders, specify in this behalf by notification in the Official Gazette.

Section 48. Rights of patentees.-

Subject to the other provisions contained in this Act and the conditions specified in section 47, a patent granted under this Act shall confer upon the patentee—

(a) Where the subject matter of the patent is a product, the exclusive right to prevent third parties, who do not have his consent, from the act of making, using, offering for sale, selling or importing for those purposes that product in India;

(b) Where the subject matter of the patent is a process, the exclusive right to prevent third parties, who do not have his consent, from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India:

10.1 In the matter of K.Ramu v Adyar Ananda Bhavan and Muthulakshmi Bhavan O A No. 535 and 536 of 2006 in C.S. No. 495 of 2006 (Madras High Court), it was observed that it is an admitted fact that the plaintiff has been issued with patent rights for both process and product. The process is for preparation of low glycemic sweets for a term of 20 years from 13th February, 2003. Similarly, they are also entitled to patent for the product for 20 years from July 2004. Thus the plaintiff has discharged his initial responsibility by proving that they are protected by the certificate issued by the authorities under the Patents Act 1970. In other words the plaintiffs have established a prima facie case on the strength of their two certificates. In such circumstances Section 48 of the Patents Act, 1970 will hold the field according to which a patent granted under this Act shall confer upon the patentee the exclusive right to prevent third parties from the act of making, using, selling or importing that product in India if the subject matter of the patent is a product. Similarly, if the subject matter of the patent is a process the patentee has the exclusive right to prevent third parties from the act of using the process for sale, selling for those purposes the product obtained directly by that process in India.

Section 49. Patent rights not infringed when used on foreign vessels etc., temporarily or accidentally in India.—

(1) Where a vessel or aircraft registered in a foreign country or a land vehicle owned by a person ordinarily resident in such country comes into India (including the territorial waters thereof) temporarily or accidentally only, the rights conferred by a patent for an invention shall not be deemed to be infringed by the use of the invention—
(a) in the body of the vessel or in the machinery, tackle, apparatus or other accessories thereof, so far as the invention is used on board the vessel and for its actual needs only; or

(b) in the construction or working of the aircraft or land vehicle or of the accessories thereof,
as the case may be.

(2) This section shall not extend to vessels, aircrafts or land vehicles owned by persons ordinarily resident in a foreign country the laws of which do not confer corresponding rights with respect to the use of inventions in vessels, aircraft or land vehicles owned by persons ordinarily resident in India while in the ports or within the territorial waters of that foreign country or otherwise within the jurisdiction of its courts

Section 50. Rights of co-owners of patents.

(1) Where a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent.

(2) Subject to the provisions contained in this section and in section 51, where two or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to rights conferred by section 48 for his own benefit without accounting to the other person or persons.

(3) Subject to the provisions contained in this section and in section 51 and to any agreement for the time being in force, where two or more persons are registered as grantee or proprietor of a patent, then, a license under the patent shall not be granted and share in the patent shall not be assigned by one of such persons except with the consent of the other person or persons.

(4) Where a patented article is sold by one of two or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming through him shall be entitled to deal with the article in the same manner as if the article had been sold by a sole patentee.

(5) Subject to the provisions contained in this section, the rules of law applicable to the ownership and devolution of movable property generally shall apply in relation to patents; and nothing contained in sub-section (1) or sub-section (2) shall affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or their rights or obligations as such.

(6) Nothing in this section shall affect the rights of the assignees of a partial interest in a patent created before the commencement of this Act.

Section 51. Power of Controller to give directions to co-owners.
(1) Where two or more persons are registered as grantee or proprietor of a patent, the Controller may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licenses under the patent, or the exercise of any right under section 50 in relation thereto, as he thinks fit.

(2) If any person registered as grantee or proprietor of a patent fails to execute any instrument or to do any other thing required for the carrying out of any direction given under this section within fourteen days after being requested in writing so to do by any of the other persons so registered, the Controller may, upon application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default.

(3) Before giving any directions in pursuance of an application under this section, the Controller shall give an opportunity to be heard—

(a) in the case of an application under sub-section (1) to the other person or persons registered as grantee or proprietor of the patent;

(b) In the case of an application under sub-section (2), to the person in default.

(4) No direction shall be given under this section so as to affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or of their rights or obligations as such, or which is inconsistent with the terms of any agreement between persons registered as grantee or proprietor of the patent.

Rule 76. Manner of applying for direction under section 51(1).-

(1) An application for directions under sub-section (1) of section 51 shall be made in Form 11 and shall be accompanied by a statement setting out the facts upon which the applicant relies.

(2) A copy of the application and of the statement shall be sent by the Controller to every other person registered as grantee or proprietor of the patent.

Rule 77. Manner of application under section 51(2).-

(1) An application for directions under sub-section (2) of section 51 shall be made in Form 11 and shall be accompanied by a statement setting out the facts upon which the applicant relies.

(2) A copy of the application and statement shall be sent by the Controller to the person in default.

Rule 78. Procedure for the hearing of proceedings under section 51.-

The procedure specified in rules 55A and 57 to 63 relating to the filing of notice of opposition, written statement, reply statement, leaving evidence, hearing and
costs shall, so far as may be, apply to the hearing of an application under section 51 as they apply to the hearing of an opposition proceeding.

**Section 53. Term of patent.-**

(1) Subject to the provisions of this Act, the term of every patent granted, after the commencement of the Patents (Amendment) Act, 2002, and the term of every patent which has not expired and has not ceased to have effect, on the date of such commencement, under this Act, shall be twenty years from the date of filing of the application for the patent.

Explanation; For the purposes of this sub-section, the term of patent in case of International applications filed under the Patent Cooperation Treaty designating India, shall be twenty years from the international filing date accorded under the Patent Cooperation Treaty.

(2) A patent shall cease to have effect notwithstanding anything therein or in this Act on the expiration of the period prescribed for the payment of any renewal fee, if that fee is not paid within the prescribed period or within such extended period as may be prescribed.

(3) Omitted by Act 150f 2005

(4) Notwithstanding anything contained in any other law for the time being in force, on cessation of the patent right due to non-payment of renewal fee or on expiry of the term of patent, the subject matter covered by the said patent shall not be entitled to any protection.

**Rule 80. Renewal fees under section 53.-**

(1) To keep a patent in force, the renewal fees specified in the First Schedule shall be payable at the expiration of the second year from the date of the patent or of any succeeding year and the same shall be remitted to the patent office before the expiration of the second or the succeeding year.

(1A) The period for payment of renewal fees so specified in sub-rule (1) may be extended to such period not being more than six months if the request for such extension of time is made in Form 4 with the fee specified in the First Schedule.

(2) While paying the renewal fee, the number and date of the patent concerned and the year in respect of which the fee is paid shall be quoted.

(3) The annual renewal fees payable in respect of two or more years may be paid in advance.

(3) The Controller shall, after making such enquiry as he may deem necessary, credit any renewal fee and issue a certificate that the fee has been paid.

**Section 142. Fees. —**
(1) There shall be paid in respect of the grant of patents and applications therefor, and in respect of other matters in relation to the grant of patents under this Act, such fees as may be prescribed by the Central Government.

(2) Where a fee is payable in respect of the doing of an act by the Controller, the Controller shall not do that act until the fee has been paid.

(3) Where a fee is payable in respect of the filing of a document at the patent office, the fee shall be paid along with the document or within the prescribed time and the document shall be deemed not to have been filed at the office if the fee has not been paid within such time.

(4) Where a principal patent is granted later than two years from the date of the filing of the application, the fees which have become due in the meantime may be paid within a term of three months from the date of the recording of the patent in the register or within the extended period not later than nine months from the date of recording.

10.2 Grant of Patent: (Section 43)

The patent is granted when the applicant for patent puts the application in order for grant under Section 21 of the Act and when there is no pre-grant representation within a period of six months from the date of publication and before the grant of patent or when the pre-grant opposition has been disposed of in favour of the applicant. After a patent is granted in respect of applications made under section 5(2) of the repealed Act, the patent holder is entitled to receive reasonable royalty from such enterprises which have made significant investment and were producing and marketing the product prior to 1st January, 2005 and who continue to manufacture the product covered by the patent on the date of grant of the patent. No infringement proceedings could be instituted in such cases against those enterprises.

10.3 Deletion of the claims at the time of sealing under section 43 and method of tagging of animal ear not an invention under section 2(1)(j): An application for patent No.,149056(149/Bom/77) was made by Pratap Shanker Rao Borade of SPADMA Plastic and Engineering Industry Aurangabad Maharashtra on April 25,1977 for a method and apparatus for tagging an animal ear. The complete specification was accepted by the Patent Office and notification was made in the Gazette of India, dated 29th August 1981. At the time of sealing, the method claims relating to tagging of ear were objected by the Patent Office on the ground that the method of tagging is not an invention under section 2(i)(j) and therefore amendments in the title, claims and specification were required. The applicant was requested make such corrections under section 78 (2) & (3) of the Act. It was argued by the applicant that the Controller, particularly at the Head Office, has no power to delete the claims at the time of sealing of patent. If at all Controller has any power to amend the claims, that power should be exercised by the Controller at the appropriate office. The Controller held that under the provision of section 78 (2) and (3), the Controller has powers to amend the specification by providing an opportunity of being heard. Further the method of tagging of ear of the animal was not held an invention under section 2(1)(j) of the Patents Act 1970, not being a manner of manufacture. Also such methods could not be considered as an invention due to lack of industrial application of the invention.

10.4 Amendment of Patent granted to deceased applicant (S. 44)
If the patentee had died or ceased to exist in case of a corporate body, the Controller can amend the patent by substituting the name of the patentee with the name of the legal representative. An application for such amendment of a patent should be made in Form 10 with the prescribed fee as given in the First schedule and should be accompanied by evidence verifying the statements made therein and accompanied by the letters patent.

10.5 Date of patent (S. 45)

10.5.1 The date of patent is the date of filing of the application. The date will be entered in the register of Patents. The purpose of "date of patent" is for calculating the duration of a patent and reckoning the time for payment of renewal fee.

10.5.2 In spite of date of filing being the date of patent, a suit or proceeding cannot be commenced or prosecuted against infringement committed before the date of publication.

10.6 Form, Extent and Effect of Patent (section 46)

10.6.1 Every letter patent has to be in the prescribed form and will have effect throughout India and shall be granted for one invention only. The form is specified in the Third Schedule. Modifications in the form as the circumstances of each case may require are made by the Patent Office. The letter patent should bear the number accorded to the application after the grant of a complete specification. That will be the number of the patent so granted.

10.7 Conditions under which patent is granted (section 47)

10.7.1 The patent right is not an absolute right. It is fettered right and it is subjected the following constraints: any machine, apparatus or other article in respect of which the patent is granted or any article made in respect of which the patent is granted may be used, by any person, for the purpose merely of experiment or research including the imparting of instructions to the students.

10.8 Rights of Patentee (section 48)

10.8.1 The patent granted under the Act confers upon patentee the following rights, (subject to the provisions of S. 47 and other provisions in the Act)

a) In case of a patented product, the patentee shall have the exclusive right to prevent third parties, from the act of making, using, offering for sale, selling or importing for those purposes that product in India;

b) In case of a patented process, the patentee has the exclusive right to prevent third parties, from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India;

10.9 Patent rights not infringed when used on foreign vessels, etc., temporarily or accidentally in India (Section 49)

10.9.1 The use of the invention on board a vessel or aircraft registered in a foreign country or a land vehicle owned by a person ordinarily resident in such country,
which comes to India (including the territorial waters thereof) temporarily or accidentally, will not infringe the rights of the Patentee. However this will not apply to vessels, aircraft or land vehicles owned by persons ordinarily resident in a foreign country the laws of which do not confer corresponding rights with respect to the use of inventions in vessels, aircraft or land vehicles owned by person, ordinarily resident in India while in the ports or within the territorial water of that foreign country or otherwise within the jurisdiction of its courts. As there is no commercial intention, there is no violation of patent right.

10.10 Rights of Co-owners of Patents (section 50)

10.10.1 The patent right is a unitary right shared equally among the patent holders

a) When a patent is granted to two or more persons, each of those persons will be entitled to an equal undivided share in the patent, unless an agreement to the contrary is in force. All of them can enjoy their rights for his own benefit without accounting to the other person or persons, but license or assignment of their share to any other person should not be made without the consent of others.

b) When a patented article is sold by one of two or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming through him shall deal with the article in the same manner as if the article had been sold by a sole patentee.

c) For the purpose of property right, patent right is treated as movable property. The rules of law applicable to the ownership and devolution of movable property are applicable to patents. The mutual rights or obligations of trustees or of the legal representatives of a deceased person or their rights or obligations as such are not affected by the provisions in sub section (1) or (2).

10.11 Power of Controller to give directions to co-owners (section 51)

10.11.1 Where two or more persons are registered as grantee or proprietor of a patent, the Controller may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licenses under the patent, or the exercise of any right under section 50 in relation thereto, as he thinks fit [section51(1)].

10.11.2 If any person registered as grantee or proprietor of a patent fails to execute any instrument or to do any other thing required for the carrying out of any direction given under this section within fourteen days after being requested in writing to do so by any of the other persons so registered, the Controller may, upon application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default [section.51(2)].

10.11.3 An application for directions under sub-section (1) of section 51 shall be made in Form 11, in duplicate, and shall be accompanied by a statement setting out the facts upon which the applicant relies. A copy of the
application and of the statement should be sent by the Controller to every other person registered as grantee or proprietor of the patent [section.51(1)], or to the person in default [section.51(2)], as the case may be, and the applicant shall supply sufficient number of copies for that purpose.

10.11.4 Before giving any directions in pursuance of an application under this section, the Controller shall give an opportunity to be heard to the other person or persons registered as grantee or proprietor of the patent or to the person in default. No direction will be given under this section so as to affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or of their rights or obligations as such, or which is inconsistent with the terms of any agreement between person registered as grantee or proprietor of the Patent.

10.11.5 Also the Controller has the power to grant a patent to the true and first inventor with the same date and number of a patent which has been revoked on the ground that it had been obtained by the patentee in fraud section 52.

10.12 Term Of Patent (section 53)

10.12.1 The term of Patent is 20 years from the date of the application in respect of all the patents including those for which the term had not expired on 20th May, 2003, when Patents (Amendment) Act 2002 came into force; provided that the renewal fee is paid every year before the due date or within the extended period (maximum six months).

10.12.2 In order to keep the patent in force, renewal fee as prescribed in the First Schedule (entry no. 17) need to be paid before the expiration of the second year from the date of patent and, subsequently, before the expiration of the succeeding year [Rule 80 (1)]. The annual fee payable in respect of two or more years may be paid in advance.

10.12.3 The term of patent and renewal fee in general are governed by the provisions of section 53, whereas the renewal fee, which has become due at the time of grant of the patent is governed by section 142(4). When the patent is granted later than two years from the date of filing of the application, the fee that has become due in the meantime might be paid within three months from the date of recording of the patent in the Register or within the extended period not later than nine months from the date of recording. (S. 142(4)). In the cases where the renewal fee, which has become due at the time of grant and that which has become due after the grant are very close, they may be paid together along with required extension under section 53.
CHAPTER XI

PATENT OF ADDITION

Section 54. Patents of addition.—

(1) Subject to the provisions contained in this section, where an application is made for a patent in respect of any improvement in or modification of an invention described or disclosed in the complete specification filed therefor (in this Act referred to as the "main invention") and the applicant also applies or has applied for a patent for that invention or is the patentee in respect thereof, the Controller may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.

(2) Subject to the provisions contained in this section, where an invention, being an improvement in or modification of another invention, is the subject of an independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention, the Controller may, if the patentee so requests, by order, revoke the patent for the improvement or modification and grant to the patentee a patent of addition in respect thereof, bearing the same date as the date of the patent so revoked.

(3) A patent shall not be granted as a patent of addition unless the date of filing of the application was the same as or later than the date of filing of the application in respect of the main invention.

(4) A patent of addition shall not be granted before grant of the patent for the main invention.

Section 55. Term of patents of addition.-

(1) A patent of addition shall be granted for a term equal to that of the patent for the main invention, or so much thereof as has not expired, and shall remain in force during that term or until the previous cesser of the patent for the main invention and no longer:

Provided that if the patent for the main invention is revoked under this Act, the court, or, as the case may be, the Controller, on request made to him by the patentee in the prescribed manner, may order that the patent of addition shall become an independent patent for the remainder of the term for the patent for the main invention and thereupon the patent shall continue in force as an independent patent accordingly.

(2) No renewal fees shall be payable in respect of a patent of addition, but, if any such patent becomes an independent patent under sub-
section (1) the same fees shall thereafter be payable, upon the same dates, as if the patent had been originally granted as an independent patent.

Section 56. Validity of patents of addition.—

(1) The grant of a patent of addition shall not be refused, and a patent granted as a patent of addition shall not be revoked or invalidated, on the ground only that the invention claimed in the complete specification does not involve any inventive step having regard to any publication or use of—
   (a) the main invention described in the complete specification relating thereto; or
   (b) any improvement in or modification of the main invention described in the complete specification of a patent of addition to the patent for the main invention or of an application for such a patent of addition, and the validity of a patent of addition shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

(2) For the removal of doubts it is hereby declared that in determining the novelty of the invention claimed in the complete specification filed in pursuance of an application for a patent of addition regard shall be had also to the complete specification in which the main invention is described.

11.1 Patent of Addition: Important Features

11.1.1 When an applicant feels that he has come across an invention which is a slight modification of the invention for which he has already applied for or has obtained patent, the applicant can go for patent of addition since the invention does not involve a substantial inventive step. It is also possible to convert an independent patent to a patent of addition at a later date if the subject matter was an improvement in or modification to a main invention for which he holds a patent. There is no need to pay separate renewal fee for the patent of addition during the term of the main patent. A patent of addition expires along with the main patent unless it is made independent according to the provisions in Section 54.

11.1.2 However, a patent of addition will not be granted unless the date filing of Application was the same or later than the date of filing of the complete specification in respect of the main invention [section 54(1), section 54 (2) & section 54(3)].

11.1.3 It should be noted that a patent of addition will not be granted before granting of the patent for the main invention.

11.1.4 In an application for a patent of addition, the determination as to whether the invention proposed is or is not an improvement or modification of the applicant’s previous invention, has to be done by the proper comparison between the novel contributions which each specification has made to the art and not between the sum of the characteristics claimed in the respective main invention and proposed patent of addition. In other words mere presence of a
number of elements common to both inventions, is not sufficient to make one invention an improvement of or addition to the other.

11.1.5 The validity of a patent of addition will not be questioned on the ground that invention ought to have been the subject of an independent patent and on the ground that the invention claimed in the complete specification does not involve any inventive step having regard to the publication and use of the main invention (Section 56).

11.1.6 For determining the novelty of the invention claimed in the complete specification filed in pursuance of an application for patent of addition, the examiner looks into the complete specification in which the main invention is described. Thus the complete specification of the main invention could be cited for novelty as an anticipatory publication.

11.1.7 The complete specification of application for the patent of addition shall include specific reference to the number of main patent or the application number of main patent, as the case may be, and a definite statement that the invention comprises an improvement in, or a modification of the invention claimed in the specification of the main patent, granted or applied for.

11.1.8 It is important to bear in mind that in order to be patentable an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy, the test of invention or an "inventive step". To be patentable the improvement or the combination must produce a new result, or a new article or a better or cheaper article than before. The combination of old known integers may be so combined that by their working inter-relation they produce a new process or improved result. Mere collection of more than one integers or things, not involving the exercise of any inventive faculty, does not qualify for the grant of a patent. (Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries, AIR 1982 SC 1444.)

11.2 Term of Patent of Addition (section 55)

The term of the patent of addition will run for a term equal to that of the patent for main invention. If the patent for the main invention is revoked under the Act, the patent of addition shall become an independent patent for the remainder of the term of patent for the main invention if the court or Controller so orders on the request made by the patentee.

No renewal fee is payable in respect of a patent of addition so long as the main patent remains in force. However, if patent of addition becomes an independent patent, the same fee shall be payable upon the same dates as if the patent has been originally granted as an independent patent.
CHAPTER XII

AMENDMENT OF APPLICATION AND SPECIFICATION

Section 57. Amendment of application and specification or any document related thereto before Controller.—

(1) Subject to the provisions of section 59, the Controller may, upon application made under this section in the prescribed manner by an applicant for a patent or by a patentee, allow the application for the patent or the complete specification or any document related thereto to be amended subject to such conditions, if any, as the Controller thinks fit:

Provided that the Controller shall not pass any order allowing or refusing an application to amend an application for a patent or a specification or any document related thereto under this section while any suit before a court for the infringement of the patent or any proceeding before the High Court for the revocation of the patent is pending, whether the suit or proceeding commenced before or after the filing of the application to amend.

(2) Every application for leave to amend an application for a patent or a complete specification or any document related thereto under this section shall state the nature of the proposed amendment, and shall give full particulars of the reasons for which the application is made.

(3) Any application for leave to amend an application for a patent or a complete specification or a document related thereto under this section made after the grant of patent and the nature of the proposed amendment may be published.

(4) Where an application is published under sub-section (3), any person interested may, within the prescribed period after the publication thereof, give notice to the Controller of opposition thereto; and where such a notice is given within the period aforesaid, the Controller shall notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case.

(5) An amendment under this section of a complete specification may be, or include, an amendment of the priority date of a claim.

(6) The provisions of this section shall be without prejudice to the right of an applicant for a patent to amend his specification or any other document related thereto to comply with the directions of the Controller issued before the grant of a patent.
Section 58. Amendment of specification before Appellate Board or High Court.—

(1) In any proceeding before the Appellate Board or the High Court for the revocation of a patent, the Appellate Board or the High Court, as the case may be, may, subject to the provisions contained in section 59, allow the patentee to amend his complete specification in such manner and subject to such terms as to costs, advertisement or otherwise, as the Appellate Board or the High Court may think fit, and if, in any proceedings for revocation, the Appellate Board or the High Court decides that the patent is invalid, it may allow the specification to be amended under this section instead of revoking the patent.

(2) Where an application for an order under this section is made to the Appellate Board or the High Court, the applicant shall give notice of the application to the Controller, and the Controller shall be entitled to appear and be heard, and shall appear if so directed by the Appellate Board or the High Court.

(3) Copies of all orders of the Appellate Board or the High Court allowing the patentee to amend the specification shall be transmitted by the Appellate Board or the High Court to the Controller who shall, on receipt thereof, cause an entry thereof and reference thereto to be made in the register.

Section 59. Supplementary provisions as to amendment of application or specification.—

(1) No amendment of an application for a patent or a complete specification or any document related thereto shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of incorporation of actual fact, and no amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

(2) Where after the date of grant of patent any amendment of the specification or any other documents related thereto is allowed by the Controller or by the Appellate Board or the High Court, as the case may be,—

(a) the amendment shall for all purposes be deemed to form part of the specification along with other documents related thereto;

(b) the fact that the specification or any other documents related thereto has been amended shall be published as expeditiously as possible; and

(c) the right of the applicant or patentee to make amendment shall not be called in question except on the ground of fraud.

(3) In construing the specification as amended, reference may be made to the specification as originally accepted.
Rule 81. Amendment of application, specification or any document relating thereto.-

(1) An application under section 57 for the amendment of an application for a patent or a complete specification or any document related thereto shall be made in Form 13.

(2) If the application for amendment under sub-rule (1) relates to an application for a patent which has not been granted, the Controller shall determine whether and subject to what conditions, if any, the amendment shall be allowed.

(3) (a) If the application for amendment under sub-rule (1) is made after grant of patent and the nature of the proposed amendment is substantive, the application shall be published.

(b) Any person interested in opposing the application for amendment shall give a notice of opposition in Form 14 within three months from the date of publication of the application.

(c) The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 57 as they apply to the hearing of an opposition proceeding.

Rule 82. Preparation of amended specifications, etc.-

Where the Controller allows the application for a patent or the complete specification or any other document to be amended, the applicant shall, if the Controller so requires and within the time to be specified by him, leave at the appropriate office an amended application or the specification or the other document, as the case may be, in accordance with the provisions of these rules.

Rule 83. Publication of the amendment allowed.-

The amendments allowed after a patent has been granted, shall be published.

12.1 Amendments

12.1.1 A request for amendment can be filed before the ‘grant’ or after the ‘grant’ of patent on Form-13 with prescribed fee as per in the First Schedule.

12.1.2 The request should state the nature of the proposed amendment highlighted in the copy annexed and give full particulars of the reason for which the request is made [S. 57(2)]. The application can be for the amendment of priority date of a claim also [S.57 (5)].

12.1.3 The amendment can be allowed only if it is by way of disclaimer, correction or explanation. The amendment allowed in these ways shall be only for the purpose of incorporation of actual fact. Amendment should not be allowed if the specification as amended describes matter not in substance disclosed or shown in
the specification before the amendment or the amended claims do not fall wholly within the scope of a claim of the specification before the amendment (S. 59(1)).

12.1.4 The amended pages have to be filed in duplicate by the applicant along with duly cancelled original pages.

12.1.5 If the application for leave to amend an application for patent or a complete specification or a document related thereto is made after the grant of patent, the nature of the amendment proposed should be published in official journal inviting opposition by any interested person (section 57(3). Section 57(4) & rule 81(3). The leave to amend the complete specification obtained by fraud is a ground for revocation of Patent under section 64(1)(b). If the amendments are opposed by the person interested then the Controller shall give notice to the person desiring the amendments and before deciding the case, he shall give both the parties an opportunity to be heard. In case of such an opposition the procedures relating to filling of written statements, reply statements, leaving evidence, hearing and costs shall be guided by the procedures specified in rules 57 to 63. If the amendments are allowed it should be notified in the official journal (section 59(2) & R. 83).

12.1.6 But if there is any suit for the infringement or revocation of the patent in question pending before a court, Controller shall not pass any order allowing or refusing the application for amendment [section 57(1)].

12.1.7 The provisions of the section 57 shall be without prejudice to the right of an applicant to amend his specification or any other document related thereto to comply with the directions of the Controller issued before grant of a patent [section 57(6)]

12.1.8 The applicant or patentee may amend the application, complete specification or any document related thereto by making the application in the prescribed manner in Form 13 [Rule 81(1)]. The application shall state the nature of the proposed amendment (highlighted in the copy annexed) and give full particulars of the reason for which the request is made (section 57(2) and Form-13).

12.1.9 Any document for the amendment of which no special provision is made in the Act may be amended and any irregularity in procedure which in opinion of the Controller may be obviated without detriment to the interest of any person, may be corrected, if the Controller thinks fit and upon such terms as he may direct, on a petition made by the applicant under Rule 137 with the prescribed fee given in First Schedule.

12.1.10 With regard to amendment of Divisional applications, in the matter of (T 514/88, T 527/88) it was held that the subject matter of the amended application or patent (in this case the divisional application) had to be directly and unambiguously, derivable from and consistent with, the original disclosure (in this case the parent application). It is the total information content of the original application as filed that matters. In view of these decisions, the board held in T 289/95 that the question of whether or not a claim in a patent deriving from
a divisional application "covers" or "embraces" something which was not specifically disclosed in the parent application was not the proper standard of comparison for determining whether there had been an inadmissible extension of subject-matter.

12.1.11 In the matter of an application for patent no.133689, DPD, Vol.1 at 200 and in the case of Orissa Cement (applicant) v. Belpahar Refractories (opponent), it was held that in the opposition proceedings, the Controller has power to allow amendments for meeting the grounds of opposition but such an implied power is subject to some restrictions as imposed by Section 59 of the Act in which powers of amendments are expressly given. Under Section 59 of the Patents Act, 1970 an applicant for a patentee may at any time, apply to amend the complete specification by way of disclaimer, correction or explanation. Unless the amendment is for the purpose of correcting an obvious mistake, the following conditions must be fulfilled viz.

(a) The amended specification must not claim or describe matter not in substance disclosed in the specification before the amendment; and

(b) everything covered by an amended claim must have fallen within the scope of at least one claim prior to the amendment. In other words any amendment should be allowed if

(i) the amended claims cover matter disclosed "in substance" in the original specification, whether or not originally claimed; and

(ii) nothing outside the scope of the original claims comes within the amended claims.

12.1.12 In the matter of patent application No. IN/PCT/2000/00080/MUM by M/s. Smithkline Beecham Plc., Great Britain for “A Hydrate of 5-[4-[2-(N-methyl-N-(2-pyridyl)amino) ethoxy] benzyl]-thiazolidine-2,4-dione,maleic acid salt” was rejected by the Controller of Patents vide his order dated 23.07.2007 u/s 15 of the Patents Act, 1970. The main claim of this patent application claimed derivatives of thiazolidinedione (a hydrate thereof), which were objected by the concerned Examiner being non-patentable inventions prima facie as per the explanation given in Section 3(d) of the Act. In their reply the Applicants claimed that hydrate claimed in this application is novel and submitted two granted US patents 7,045,633 B2 and 6,664,278 B2 claiming that these patents were granted for the same compound. However, it was pointed out that the claimed subject matter of these two patents and the instant invention were different. Moreover, the Controller also pointed out that the applicants have also failed to describe as to how the claimed hydrate is isolated in its purified/crystalline forms. The hydrate in question was already known from the document WO 94/05659. To prove efficacy of the claimed hydrate as described on opening page 3 of the specification, enough guidance was not provided in the specification for working the invention by the person skilled in the art to obtain the claimed hydrate derivative of the thiazolidinedione.

The application was thus rejected on the basis of the objections remaining on file on the last date for meeting the requirements under the Act and even after offering a hearing in the case and the same could not be met suitably. These grounds of objections were as under:
(i) Enablement requirement under Section 10 (a) and 10 (b) are not met due to the level of unpredictability present in the relevant art and insufficient direction provided by the inventors to obtain the claimed hydrate of thiazolidinedione.

(ii) Efficacy of the claimed hydrate of thiazolidinedione could not be ascertained from the limited description provided in the specification, as required under Section 3 (d) of the Act. Requirement of Section 8 (1) (b) of the Act are not met.

12.1.13 In the matter of M/s. Tecumseh Products India Ltd. Hyderabad V/s. M/s. Kirloskar Copland Ltd. Pune and in the matter of Patent No. 186634, Application No. 207/BOM/96 , it was held by Controller that the opponents succeeded in establishing the grounds of insufficiency of description under Section 25(1)(g) description given in the specification. During the hearing proceedings the applicant proposed to amend the specification to over come the opponent’s objections but the opponent argued and submitted that the nature of amendments proposed is not allowable under Section 59 and requested that the grant of patent should be refused to this application. Since the amendments proposed by the applicant e.g. putting the words “the inlet-tube of the” before “suction muffler” and put the words “the discharge tube of the” before “discharge muffler” on page 2-3 and claims 1-3, were found to alter the scope of the invention; In the original specification “holes are on the suction and discharge muffler” and after proposed amendment “holes are placed on the inlet tube of suction muffler and discharge tube of discharge muffler”. Such amendments were found to be not allowable under Section 59(1) of the Act.

Similarly the words “tube inlet’ were proposed to be replaced by the “inlet tube” which were not found to be allowable under Section 59(1). Since “tube inlet” refer to the entry point of any tube where as “inlet tube” refer to a tube which leads some fluid inside a body or device.

12.1.14 In the matter of 232/MUM/2001, filed by M/s. Honda Giken Kogyo Kabushiki Kaisha, Japan was rejected by the Controller of Patents vide his order dated 18.11.2006 u/s 15 of the Patents Act, 1970. The concerned Examiner raised objection of lack of inventive step in view of the cited prior art documents. In reply, the Applicants failed to clearly distinguish the features of the instantly claimed invention with respect to the cited documents. The Examiner further pointed out that US4730589 clearly mentions use of electronics means to generate pulses to control the current to auto choke heater for controlling auto choke valve. Such electronics means are also known from US4348996 and pointed out that replacing the constant voltage adjustment resistors of JP 08-042398A with electronics means as an obvious solution to a man of the art, thus lacking in inventive step.
In the final hearing also minor amendments in the specification were made by the Agents to distinguish the features of the present invention as use of microcomputer to control the opening and closing of choke valve by varying current to the PTC Heater, whereas in US 4730589 the usage of a microcomputer for a PTC Heater (page 7, col.3, para 38-42), which performs the function of the pulse generating means in place of the pulse generating means circuits. Also refer to Fig.2 showing the operation of the microcomputer system. Therefore, this itself is sufficient to guide the man of art to use microcomputer for varying the pulses to vary the current supplied to the auto choke heater as recited in the characterized portion of the final amended claim 1.

In view of the above, the application lacked inventive step as defined under section 2 (1) ( ja) and thus section 2 (1) ( j) of the Act was not satisfied.

Accordingly, the Controller of Patents ordered refusal to grant letters of Patent for the aforesaid patent application No. 232/MUM/2001.

12.1.15 In the case of Patent Application No.IN/PCT/2002/01797/MUM filed by M/s. BUHLER AG, Switzerland was rejected by the Controller of Patents vide his order dated 04.10.2006 u/s 15 of the Patents Act, 1970 Initially the Examiner objected to claims 1-3 being non-patentable u/s 3(m) of the Act, claims 4-8 not sufficiently definitive of the invention and claims not clearly worded. On further amendments by the Applicants, objections under sections 10(4)(a) and 10(4)(b) were raised. Claims 2, 3, 6 and 7 was also objected for not being clear due to absence of any drawings. This was resisted by Agents by stating that pneumatic transportation of flowable goods, measure of temperature, moisture content or speed of air in a tube or pipe or any other device part and to adjust such parameters is well known in the relevant art, thus drawings are not necessary. The Applicants stated that they “wish to claim use of continuous pneumatic transport in a rice mill”, which is not yet known. This reply was found to be vague and instead of pinpointing the novel and inventive features of their claimed invention, it explains everything as a known thing.

Moreover, characterized portion of claim 1 recited adjusting temperature and moisture of the transporting air with the use of sensors. The arrangement and features of the invention were not clearly enabled as required under section 10 (4) (a) and (b) of the Act. Further, claims 2 and 3 were found to be out of the scope of the characterized portion of claim 1. Claim 4 was also not clear and not supported by the description. Claims 2, 3 & 6 also lacked inventive step in the light of a paper “Analysis of particle degradation in pneumatic conveyors utilizing a pilot sized test facility” published in the Journal of Process Mechanical Engineering, Vol-213, No.2, 1999, pages 85-91, wherein testing of air velocities, pipe bend geometries for the analysis of particle degradation is disclosed.

In view of the above, the application lacked inventive step as defined under section 2 (1) ( ja) and thus section 2 (1) ( j) of the Act was not
satisfied. It also failed to meet the enablement requirements under section 10 (4) (a) and (b) of the Act.

12.1.16 With regard to resolving the conflict in exceptional cases and in the matter of T 166/90 the board allowed an inadmissible feature in a granted claim to be replaced by other disclosed features, since this did not extend the scope of protection. The invention concerned an opaque plastic film. The product claim as granted contained a feature stating that the density of the film was less than the arithmetical density from the type and proportion of the individual components. In opposition proceedings the patent proprietor claimed a process for manufacturing the film, but without including in his process claim the density-related feature. The board examined whether this would broaden the scope of the patent, asking if the process claim features which replaced the deleted feature necessarily limited the claim to films - like that in the granted product claim - with a density less than the arithmetical one. The board concluded that, with a probability bordering on certainty, the process now claimed would produce an opaque film of a density less than that arithmetically derivable from the type and proportion of its individual components. Thus, deleting the density-related feature had not in fact extended the scope of protection.

12.1.17 In the matter of T 108/91 (OJ 1994, 228) the board concluded that it was not contravention of the Act when an incorrect technical statement which was evidently inconsistent with the totality of the disclosure was replaced by an accurate statement of the technical features involved. This case concerned a container-closure arrangement, which, according to information later included in the claim, was unstressed, whereas it was clear from the description that this part was in fact under tension i.e., amending a claim to remove an inconsistency was not contravention if the claim as corrected had the same meaning as the correct interpretation of the uncorrected claim in the light of the description. Any correction concerning description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else must have been intended than what is offered as correction.
CHAPTER XIII

RESTORATION OF LAPSED PATENTS

Section 60:
Applications for restoration of lapsed patents.—

(1) Where a patent has ceased to have effect by reason of failure to pay any renewal fee within the period prescribed under section 53 or within such period as may be allowed under sub-section (4) of section 142, the patentee or his legal representative, and where the patent was held by two or more persons jointly, then, with the leave of the Controller, one or more of them without joining the others, may, within eighteen months from the date on which the patent ceased to have effect, make an application for the restoration of the patent.

(2) Omitted by Act 38 of 2002

(3) An application under this section shall contain a statement, verified in the prescribed manner, fully setting out the circumstances which led to the failure to pay the prescribed fee, and the Controller may require from the applicant such further evidence as he may think necessary.

Section 61:
Procedure for disposal of applications for restoration of lapsed patents.—

(1) If, after hearing the applicant in cases where the applicant so desires or the Controller thinks fit, the Controller is prima facie satisfied that the failure to pay the renewal fee was unintentional and that there has been no undue delay in the making of the application, he shall publish the application in the prescribed manner; and within the prescribed period any person interested may give notice to the Controller of opposition thereto on either or both of the following grounds, that is to say,—

(a) that the failure to pay the renewal fee was not unintentional; or
(b) that there has been undue delay in the making of the application.

(2) If notice of opposition is given within the period aforesaid, the Controller shall notify the applicant, and shall give to him and to the opponent an opportunity to be heard before he decides the case.

(3) If no notice of opposition is given within the period aforesaid or if in the case of opposition, the decision of the Controller is in favour of the applicant, the Controller shall, upon payment of any unpaid renewal fee and such additional fee as may be prescribed, restore the patent and any patent of additional specified in the application which has ceased to have effect on the cesser of that patent.

(4) The Controller may, if he thinks fit as a condition of restoring the patent, require that an entry shall be made in the register of any document or
matter which, under the provisions of the Act, has to be entered in the register but which has not been so entered.

Section 62:
Rights of patentees of lapsed patents which have been restored.—

(1) Where a patent is restored, the rights of the patentee shall be subject to such provisions as may be prescribed and to such other provisions as the Controller thinks fit to impose for the protection or compensation of persons who may have begun to avail themselves of, or have taken definite steps by contract or otherwise to avail themselves of, the patented invention between the date when the patent ceased to have effect and the date of publication of the application for restoration of the patent under this Chapter.

(2) No suit or other proceeding shall be commenced or prosecuted in respect of an infringement of a patent committed between the date on which the patent ceased to have effect and the date of the publication of the application for restoration of the patent.

Rule 84:
Restoration of patents.—

(1) An application for the restoration of a patent under section 60 shall be made in Form 15.

(2) Where the Controller is satisfied that a prima facie case for the restoration of any patent has not been made out, he shall intimate the applicant accordingly and unless the applicant makes a request to be heard in the matter within one month from the date of such intimation, the Controller shall refuse the application.

(3) Where applicant requests for a hearing within the time allowed and the Controller, after giving the applicant such a hearing, is prima facie satisfied that the failure to pay the renewal fees was unintentional, he shall publish the application.

Rule 85:
Opposition to restoration under section 61.—

(1) At any time, within two months from the date of publication of the application under sub-rule (3) of rule 84, any person interested may give notice of opposition thereto in Form 14.

(2) A copy of the notice of opposition shall be sent by the Controller to the applicant.

(3) The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 60 as they apply to the hearing in the opposition proceeding.

Rule 86:
Payment of unpaid renewal fees.-

(1) Where the Controller decides in favour of the applicant, the applicant shall pay the unpaid renewal fees and the additional fee specified in the First Schedule, within a month from the date of the order of the Controller allowing the application for restoration.

(2) The Controller shall publish his decision.

Section 62:
Rights of patentees of lapsed patents which have been restored.—

(1) Where a patent is restored, the rights of the patentee shall be subject to such provisions as may be prescribed and to such other provisions as the Controller thinks fit to impose for the protection or compensation of persons who may have begun to avail themselves of, or have taken definite steps by contract or otherwise to avail themselves of, the patented invention between the date when the patent ceased to have effect and the date of publication of the application for restoration of the patent under this Chapter.

(2) No suit or other proceeding shall be commenced or prosecuted in respect of an infringement of a patent committed between the date on which the patent ceased to have effect and the date of the publication of the application for restoration of the patent.

13.1 Restoration of Patent

13.1.1 When a patent has ceased to have effect under Section 53(2), because of non-payment of renewal fees within the prescribed period, the patent and any specified patent of addition thereto, may be restored provided that the application is made without undue delay, and within eighteen months from the date on which it has ceased, and that the failure to pay the renewal fee was unintentional. This eighteen months period shall be reckoned from the date of cessation, but no extension shall be allowed. The application must be made by patentee or his legal representative on Form -15 and accompanied by supporting evidence. Any patent of addition, which is to be restored, if applicable should be specified. A separate Form -15 is required for each main patent, but no fee is payable in respect of any patent of addition thereto.

13.1.2 Where a patent was assigned before it ceased, the assignee may make the application only when the assignment has been registered, similarly, if a patent was granted to a deceased person, action under Section 44 should be completed before action for restoration is begun.

13.1.3 If a patentee has failed to register a change of name before cessation he must first apply under Rule 94 for alteration in the register. If he changed his name after cessation he must prove his identity. In both cases he must draw and sign the application in his new name but in the latter case must add 'formerly known as' to his identification.
13.2 Statements and Evidence

13.2.1 The application must include a statement fully setting out the circumstances that led to the failure to pay the renewal fee. This statement may be supported by evidence and copies of any documents referred to.

13.2.2 The evidence must support the patentee's claim that the failure to pay was unintentional that there has been no undue delay in applying for restoration.

13.2.3 The Controller may call for further evidence, which may include letters, deeds etc.

13.2.4 If a person deliberately elects not to pay a fee under an erroneous supposition that he secured no advantage by doing so, he cannot claim that the failure to pay was unintentional even though he would have wished to pay if he had known the true position (Land's Patent, 27 R.P.C.481).

13.2.5 The person who has to pay the fee is usually the patentee but may be a licensee or agent under which circumstances the Controller recognizes the acts of a person apparently for the patentee where a business arrangement is complex, is discussed in Processed Surfaces Incorporated's Patent (Restoration), [1958] R.P.C. page 480 and Witton Engineering Co. Ltd's Patent (Restoration), [1959] R.P.C. page 53.

13.2.6 In deciding whether the failure to pay renewal fee was unintentional, consideration is only to the patentee's last decision before expiry of the extended time for paying renewal fee under Section 53 (2). No attention is paid to previous changes of mind. Any post-cessation decision not to apply for restoration is fatal to the applicant.

13.2.7 The patentee's financial inconvenience is not admitted as a ground of unintentional failure, but destitution resulting in physical impossibility to pay is considered.

13.2.8 As a patentee must exercise reasonable diligence in maintaining his patent, it is not necessarily sufficient to allege innocence of undue delay, because he was ignorant of the lapsing through the fault of his 'agent'. An evidence of proved negligence in the office of the agent may however be sufficient to secure restoration.

13.2.9 If the Controller does not agree that a prima facie case for restoration has been made out, the applicant is so notified and unless the applicant states within one month that he desires to be heard the application may be refused.

13.3 Procedure for disposal of application for restoration

13.3.1 After hearing the applicant, if the Controller thinks fit and is prima facie satisfied that the failure to pay renewal fee was unintentional and there had been no undue delay in the making of application, the application will be published in prescribed manner.
13.3.2 Any person interested may give Notice of opposition to the application within two months of the date of publication in the official journal. The grounds of opposition under Section 61(1) are

i. That the failure to pay the renewal fee was not unintentional; or / and

ii. That there has been undue delay in the making of the application.

13.3.3 The Notice of opposition must be made on Form 14 in duplicate with a statement setting out the nature of the opponent's interest, the grounds of opposition, and the facts on which he relies. Then the Controller sends to the applicant a copy of the Notice and of the statement received from the opponent.

13.3.4 The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, Reply evidence, hearing and cost shall, so far as may be, apply to the hearing of the opposition under section 60 as they apply to the hearing of the opposition to the grant of patents.

13.3.5 With a notification of decision in his favour, if the applicant for restoration pays within one month from the date of order [Rule 86(1)] the amount of the unpaid renewal fees applicable at the time of actual payment, and with the specified additional fee the patent is restored and the Controller will advertise this information in the official journal accordingly [Rule 86(2)].

13.3.6 To protect the persons who have begun to use the applicant's invention between the date when the patent ceased to have effect and the date of publication of the application for restoration, every order for restoration should include the provision as set out under section 62(1) and the Controller may impose other conditions for protection and compensation of the above-mentioned persons. No suit or other proceeding shall be. Commenced or prosecuted in respect of an infringement of a patent committed between the date on which the patent ceased to have effect and the date of the publication of the application for restoration of the patent.

13.3.7 A patentee or opponent may file appeal in Appellate Board for any decision of the Controller made under Section 60 within three months from the date of the decision or within such further time as the Appellate Board may allow according to the provision of Section 117A(2) and 117A(4).
CHAPTER XIV
SURRENDER AND REVOCATION OF PATENTS

Section 63:
Surrender of patents.-

(1) A patentee may, at any time by giving notice in the prescribed manner to the Controller, offer to surrender his patent.

(2) Where such an offer is made, the Controller shall publish the offer in the prescribed manner, and also notify every person other than the patentee whose name appears in the register as having an interest in the patent.

(3) Any person interested may, within the prescribed period after such publication, give notice to the Controller of opposition to the surrender, and where any such notice is given the Controller shall notify the patentee.

(4) If the Controller is satisfied after hearing the patentee and any opponent, if desirous of being heard, that the patent may properly be surrendered, he may accept the offer and by order, revoke the patent.

Rule 87:
Surrender of Patents.-

(1) The Controller shall publish the notice of an offer given under section 63.

(2) Any person interested may, within three months from the date of publication of the notice, give notice of opposition to the Controller in Form 14 in duplicate.

(3) The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 63 as they apply to the hearing in opposition proceeding.

(4) If the Controller accepts the patentee's offer to surrender the patent, he may direct the patentee to return the patent, and on receipt of such patent, the Controller shall by order revoke it and publish the revocation of the patent.

14.1. The patentee may at any time offer to surrender his patent through an application in prescribed format. On receipt of such an offer the Controller will publish the offer in the Official journal and also notify every person (other than the Patentee) whose name appears in the register as having an interest in the Patent. The three months period of opposition to the surrender of Patent will be counted from that date.
14.1.1  Filing of Notice of Opposition: Any interested person may give notice of opposition to the surrender of Patent in Form 14 (in duplicate) within 3 months from the date of publication of the notice in the Official journal with the prescribed fee. The Controller shall inform the Patentee on receipt of such notice.

14.1.2  Hearing Procedure: The procedure relating to filing of written statement, reply statement leaving evidence and hearing of the opposition under section 63 is similar to that of the opposition to the grant of Patents as specified in Rules 57 to 63. The Controller on receipt of the evidence, if any, and after giving the parties an opportunity to be heard, decide the case.

In case, the Controller accepts the Patentee's offer to surrender the patent, he may direct the Patentee to surrender the patent and on the receipt of which, he shall by order, revoke it and notify such revocation in the Official journal. Any order, decision or direction of the Controller under section 63 is appealable in Appellate Board.

14.2  Revocation Of Patent

Section 64:
Revocation of patents.-

(1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act may, be revoked on a petition of any person interested or of the Central Government by the Appellate Board or on a counter-claim in a suit for infringement of the patent by the High Court on any of the following grounds that is to say—

(a) that the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in India;

(c) that the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor:

[proviso omitted by Act 32 of 2002]

(d) that the patent was obtained wrongfully in contravention of the rights of the petitioner or any person under or through whom he claims;

(e) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;

(f) that the invention so far as claimed in any claim of the complete specification is not new, having regard to what was publicly known or publicly used in India before the priority date of the claim or to what was published in India or elsewhere in any of the documents referred to in section 13:

[proviso omitted by Act 32 of 2002]
(g) that the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step, having regard to what was publicly known or publicly used in India or what was published in India or elsewhere before the priority date of the claim:

[proviso omitted by Act 32 of 2002]

(g) that the invention, so far as claimed in any claim of the complete specification, is not useful;

(h) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection;

(i) that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;

(j) that the patent was obtained on a false suggestion or representation;

(k) that the subject of any claim of the complete specification is not patentable under this Act;

(l) that the invention so far as claimed in any claim of the complete specification was secretly used in India, otherwise than as mentioned in sub-section (3), before the priority date of the claim;

(m) that the applicant for the patent has failed to disclose to the Controller the information required by section 8 or has furnished information which in any material particular was false to his knowledge;

(n) that the applicant contravened any direction for secrecy passed under section 35 or made or caused to be made an application for the grant of a patent outside India in contravention of section 39;

(o) that leave to amend the complete specification under section 57 or section 58 was obtained by fraud.

(p) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;

(q) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.

(2) For the purposes of clauses and (f) of sub-section (1)—

(a) no account shall be taken of personal document or secret trial or secret use; and

(b) where the patent is for a process or for a product as made by a process described or claimed, the importation into India of the product made abroad by that process shall constitute knowledge or use in India of the invention on the date of the importation, except
where such importation has been for the purpose of reasonable trial or experiment only.

(3) For the purpose of clause (l) of sub-section (1) no account shall be taken of any use of the invention—

(a) for the purpose of reasonable trial or experiment only; or

(b) by the Government or by any person authorised by the Government or by a Government undertaking, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention directly or indirectly to the Government or person authorised as aforesaid or to the Government undertaking; or

(c) by any other person, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention, and without the consent or acquiescence of the applicant or of any person from whom he derives title.

(4) Without prejudice to the provisions contained in sub-section (1) a patent may be revoked by the High Court on the petition of the Central Government, if the High Court is satisfied that the patentee has without reasonable cause failed to comply with the request of the Central Government to make, use or exercise the patented invention for the purposes of Government within the meaning of section 99 upon reasonable terms.

(5) A notice of any petition for revocation of a patent under this section shall be served on all persons appearing from the register to be proprietors of that patent or to have shares or interests therein and it shall not be necessary to serve a notice on any other person.

Section 65:

Revocation of patent or amendment of complete specification on directions from Government in cases relating to atomic energy.-

(1) Where at any time after grant of a patent, the Central Government is satisfied that a patent is for an invention relating to atomic energy for which no patent can be granted under sub-section (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962), it may direct the Controller to revoke the patent, and thereupon the Controller, after giving notice, to the patentee and every other person whose name has been entered in the register as having an interest in the patent, and after giving them an opportunity of being heard, may revoke the patent.

(2) In any proceedings under sub-section (1), the Controller may allow the patentee to amend the complete specification in such manner as he considers necessary instead of revoking the patent.

Section 66:

Revocation of patent in public interest.-
Where the Central Government is of opinion that a patent or the mode in which it is exercised is mischievous to the State or generally prejudicial to the public, it may, after giving the patentee an opportunity to be heard, make a declaration to that effect in the Official Gazette and thereupon the patent shall be deemed to be revoked.

14.2.1 Revocation of patent: General

a. Any Interested person including the government can make a petition on any of the various grounds specified for revocation of patent under section 64 of the Patents Act.

b. Further High Court may revoke a patent if the patentee does not allow the Government to make use of it.

c. According to section 64 (4), a patent may be revoked by the High Court on the petition of the Central Government, if the High Court is satisfied that the patentee has without reasonable cause failed to comply with the request of the Central Government to make, use or exercise the patented invention for the purposes of Government upon unreasonable terms.

d. A 'person interested' within the meaning of section 64 must be a person who has a direct, present and tangible commercial interest which is injured or affected by the continuance of the patent on the register; *Ajay Industrial Corporation v. Shiro Kanao of Ibaraki City*, AIR 1983 Del 496.

e. There is no statutory requirement that in a case where a suit for infringement is pending, revocation of the patent can be sought for only by way of a counter-claim and not by way of a separate and independent application; *Ajay Industrial Corporation v. Shiro Kanao of Ibaraki City*, AIR 1983 Del 496.

f. For the purpose of revocation-

   (a) no account shall be taken of personal document or secret trial or secret use; and
   (b) where the patent is for a process or for a product as made by a process described or claimed, the importation into India of the product made abroad by that process shall constitute knowledge or use in India of the invention on the date of the importation, except where such importation has been for the purpose of reasonable trial or experiment only.

g. Also, for the purpose of revocation no account shall be taken of any use of the invention-

   (i) for the purpose of reasonable trial or experiment only; or
   (ii) by the Government or by any person authorised by the Government or by a Government undertaking, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed
the invention directly or indirectly to the Government or person authorized as aforesaid or to the Government undertaking; or

(iii) by any other person, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention, and without the consent or acquiescence of the applicant or of any person from whom he derives title.

14.2.2 A Patent, whether granted before or after the commencement of the Patent (Amendments) Act, 2005, may be revoked on any of the grounds stated hereinafter, at any time during the life of the patent,

i) by the High Court - on a counter-claim for revocation of the patent made by the defendant in a suit for infringement (Section 64(1), see also section 104);

ii) by the Appellate Board - on the petition of any person interested or of the Central Government (Section 64(1), see also Section 117 A);

iii) by the Central Government – revocation of the patent in public interest (Section 66);

iv) by the High Court – on petition of the Central Government for failure to comply with the request of the Central government to make, use or exercise the patented invention for the purpose of the central government as elucidated in section 99 upon reasonable terms (Section 64(4);

[If the High Court is satisfied that the patentee has without reasonable cause failed to comply with the request of the Central Government as above, the patent may be revoked by the High Court.

A notice of any petition for revocation of a patent under this section shall be served on all persons appearing from the register to be proprietors of that patent or to have shares or interests therein (Section 64(5)]

v) by the Controller of Patent – revocation for non-working of the patent (Section 85); and

vi) by the Controller of Patent – revocation of patents related to atomic energy on direction from the Central government (Section 65);

subject to the provisions contained in the Act.

14.2.3 Grounds of Revocation:

a) The invention claimed is the subject of a patent already granted in India prior to the claimed invention - prior claiming:

The provision of this sub-section can be applied in a case, if it is shown that a claim in the patent sought to be revoked is the subject of an identical claim in a patent of earlier priority date and that the earlier claim is valid.

b) Patentee not entitled to the patent:
Section 6 of the Patents Act specifies the categories of persons entitled to apply for Patents. If a person, who has made an application for a patent, is other than those mentioned in Sec.6, read with the Provision of Sec 2(1)(y), the patent will be revoked.

c) Patent was wrongfully obtained by a person other than the person entitled:

When a patent has been wrongfully obtained by any person, the person entitled to apply for a patent may file a petition under this sub section for revocation. This Petitioner however must be a person entitled to apply for the patent.

d) Subject of a claim is not an invention:

If the Patent granted does not satisfy the provision of Sec 2(1)(j) it may be revoked under this sub section;

e) Invention is lacking in novelty with regard to prior knowledge or prior use:

This sub section provides a ground for revocation based on lack of novelty. Novelty of an invention is an essential prerequisite for grant of a Patent.

*Public Knowledge:*

Any matter may form a part of common public knowledge even if it is not published or not available in a form of a book. On the contrary, mere publication of any matter is not sufficient to establish public knowledge. A thing may be made publicly known either orally or through documents, provided that the publication is such that the concerned person is free to share the information with others.

(f) Invention is obvious or does not involve inventive step having regard to prior knowledge or prior use:

This subsection provides for revocation of a patent on the ground that the invention claimed in any claim is obvious or has no inventive step as compared to prior knowledge or prior use.

The dictionary meaning of the word 'obvious' is “easily perceived by the senses or grasped by the mind” or “easily discovered or understood” or “something which is clearly or plainly evident to a person having fair knowledge on the subject”.

The way in which the invention has been arrived at is considered to be more relevant in judging whether or not the invention is obvious. The matter of obviousness is further considered to be judged with reference to the “state of art” under public knowledge. Generally, what is claimed for a patent lies within the development of an existing trade i.e. this development could be carried out by any skilled person in that trade without any substantial inventive step then subject matter is held to be obvious. It is also evident from the foregoing discussion that obviousness" and "inventive step" are anti-copies. If a subject
matter appears to be obvious then it does not involve any "inventive step" and if any subject matter involves "inventive step", obviously it is not "obvious". [Ref: AIR 1945 orders 6 at 9.9]

g) Invention is not useful

This subsection provides for ground of revocation, when a patent has been obtained for an invention, which is not useful. It is again an essential prerequisite for a patent that the invention must be capable of being made or used in an industry. 'Not useful' means that the invention will not work i.e. either it may not operate at all or it may not provide the desired result as mentioned in the specification.

c) The complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed:

This subsection provides a ground for revocation if the invention has not been sufficiently described in the specification. The complete specification must describe an embodiment of the invention claimed in each of the claims and that the description must be sufficient to enable those in the industry concerned to put it in effect "without making further invention" and that the description must be fair and must not be unnecessarily difficult to be followed. The claim should be as clear as the subject admits but it need not be so simplified as well so that it is protected from infringement. Any hard and fast rule cannot be laid down for the sufficiency of description and should be judged individually on merit of the specification. Here, it is pertinent to mention that it is obligatory for an applicant to describe the invention sufficiently and fairly in the specification (AIR 1969 Bom 255 at PP 266).

i) Claims are not clearly and sufficiently defined in scope and not fairly based on the matter disclosed in the specification.

This sub section contains two independent grounds for revocation i.e. (i) that the scope of any claim is not sufficiently and clearly defined and (ii) the claim is not fairly based on the matter disclosed in the specification. Both these aspects are specified in sec 10 of the Act.

Meaning of "Fairly Based":
The expression provides that the claim or claims of complete specification should be fairly based on the matter disclosed in the specification. A Patent is granted in lieu of the disclosure of the invention to the public. It is, therefore, necessary that a Patentee should get the monopoly exactly sufficient to protect his invention from any possible infringement and at the same time it is also mandatory that he should not claim monopoly more than (that is necessary) of disclosed matter.

j) Patent was obtained by false suggestion or representation.

The Patent may be revoked on the ground that it was obtained on false suggestion or representation. As there is no limitation to its nature, such false
suggestion in representation may relate to the specification or to any fact or statement required to be made in connection with the grant.

k) Subject matter of claims is not a patentable invention.

There is a certain co-relation between this provision and the provision specified under sec. 64(1) (d). However this subsection would appear to be applicable particularly to such invention, which is not patentable under section 3 and section 4 of the Act.

l) Claimed invention was secretly used before the priority date

This sub-section provides for revocation on the above ground. Prior secret use will invalidate the Patent except for certain conditions specified under section 64(3) of the Act. (AIR 1945 OUDH 6ACP.9) If the secret use is for trial or experimental purposes and as mentioned in this section, the patent will be valid.

m) Failure to disclose information regarding Foreign Application

Section 8 provides for disclosure of information regarding foreign application. If the applicant has obtained a patent concealing the matters or has furnished information that is false, the Patent may be revoked on this ground.

n) Non-compliance of secrecy direction and filing outside India without prior permission

Section 35 provides for issuance of directions by the Controller prohibiting or restricting the publication of information or communication of the information relating to the inventions, which has been considered relevant for Defence purpose. If an applicant has contravened any such direction, the Patent granted shall be revoked under this ground.

If an applicant has made or caused to be made an application for the grant of a patent outside India in contravention of Section 39, the Patent granted for the same application shall be revoked under this ground.

o) Leave to Amendment of specification obtained by fraud.

The Controller is empowered to allow amendment of the application, complete specification on application made by the applicant for patent or patentee under section 57 subject to the provision of section 59. The High Court has been empowered to order for amendment of complete specification under revocation proceeding under section 58. If the permission to amend the complete specification was obtained by fraud, it is a ground for revocation.

p) Specification Wrongly Mentioning or Not Disclosing Geographical Origin.

It provides that a Patent may be revoked if the applicant had wrongly mentioned or not disclosed in the complete specification the source or Geographical origin of Biological Material used for the invention.
When it is applicable to commonly available herbs in India or if the herb is derived from indigenous people/community, then the Patent office shall ask for the permission obtained from the indigenous place/people for benefit sharing.

q) Inventions is Anticipated by traditional knowledge.

It provides grounds for a patent to be revoked if any invention claimed in the specification is anticipated by the knowledge available orally or otherwise within any local or any indigenous community in India or elsewhere.

14.2.4 Revocation of Patent in Public Interest (section 66) : As per section 66 of the Patents Act where the Central Government is of opinion that a patent or the mode in which it is exercised is mischievous to the State or generally prejudicial to the public, it may, after giving the patentee an opportunity to be heard, make a declaration to that effect in the Official Gazette and thereupon the patent shall be deemed to be revoked.

14.2.5 Revocation of Patent for non-working: The Controller can make an order to revoke a patent for non-working if the reasonable requirements of the public are not still met after the grant of compulsory license. According to section 85 of the Patents Act where, in respect of a patent, a compulsory licence has been granted, the Central Government or any person interested may, after the expiration of two years from the date of the order granting the first compulsory licence, apply to the Controller for an order revoking the patent on the ground that the patented invention has not been worked in the territory of India or that reasonable requirements of the public with respect to the patented invention has not been satisfied or that the patented invention is not available to the public at a reasonably affordable price.

14.2.6 In the matter of Monsanto Company v. Coramandal Indag Products (P) Ltd., (1986) (1 SCC 642: AIR 1986 712: 1986 PTC 195 SC), it was held that to satisfy the requirement of being publicly known as used in clauses (e) and (f) of section 64(1), it is not necessary that it should be widely used to the knowledge of the consumer public. It is sufficient if it is known to the persons who are engaged in the pursuit of the knowledge of the patented product or process either as men of science or men of commerce or consumers. The section of the public, who as men or science or men of commerce, were interested in knowing about Herbicides which would destroy weeds but not rice, must have been aware of the discovery of Butachlor. In the present case there was no secret about the active agent Butachlor as claimed by the plaintiffs since there was no patent for Butachlor, as admitted by the plaintiffs. Herbicide Butachlor was publicly known before Patent Number 125381 was granted. Its formula and use had already been made known to the public by the report of the International Rice Research Institute for the year 1968. No one claimed any patent or any other exclusive right in Butachlor. Emulsification was the well-known and common process by which any herbicide could be used. Neither
Butachlor nor the process of emulsification was capable of being claimed by the plaintiffs as their exclusive property. The solvent and the emulsifier were not secrets and they were admittedly not secrets and they were ordinary market products. From the beginning to the end, there was no secret and there was no invention by the plaintiffs. The ingredients, the active ingredients the solvent and the emulsifier, were known; the process was known, the product was known and the use was known.

A patent may be revoked on the ground that the subject of any claim of the complete specification is not an invention within the meaning of the Act. Under Section 64 (l)(e), a patent may be revoked if the invention so far as claimed in any claim of the complete specification is not new, having regard to what was publicly known as publicly used in India before the date of the claim, etc. and u/s 64(1)(f), a patent may be revoked if the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step having regard to what was publicly known or publicly used in India or what was published in India before the priority date of the claim. The plaintiffs were merely camouflaging a substance whose discovery was known throughout the world and trying to enfold it in their specification relating to patent No. 125381.

The patent was therefore, held to liable to be revoked.

14.2.7 In the matter of the Ajay Industrial Corporation v. Shiro Kamas of Iberaki City, (AIR 1983 Del 496.), it was held that the specification and claims have all to be read together and reasonably and benevolently construed. In the absence of any technical or expert evidence either indicating that these statements are wrong or that the article produced incorporates no new devices to get over these defects, it cannot be held that the patent embodies no new discovery or invention. Appellant has not discharged the onus that lay on it to establish that the respondent's patent could not have been registered and, therefore, needs to be revoked.

14.2.8 In the matter of Franz Zaver Huemer v. New Yesh Engineers, (1996 PTC (16) 164 Del.), it was held that The plaintiff is not an inventor of the patent device as the device is already being used in machines for several years in several countries especially in India vide para 9 to 16 of the affidavit, the defendant has set out several details the machines already being manufactured for over one and a half decade leading to an inference that there was nothing new in the plaintiff's device. Arrangement or rearrangement of the already known device does not amount to an invention. As sufficient ground exist for revocation of the plaintiff's patent, the defendant has a very good defence to the plaintiff's suit.

14.2.9 In the matter of Unique Transmission Co. India Ltd Vs. ESBI Transmission Pvt. Ltd, PTC (Suppl)(2) 799 (Cal), the High Court of Calcutta held that a number of indigenous manufacturers were and had been manufacturing flexible couplings of various types and that they have been describing such couplings as Vulkan couplings. The specifications and various types of couplings manufactured by the Vulcans of West Germany have been within the knowledge of the indigenous manufacturers and the consumers thereof. Even orders were placed describing flexible couplings as Vulkan couplings and the orders mentioned various types of flexible couplings as per specifications of Vulcans. What was known in India or produced in India prior to the date of his application could not be the subject matter of the grant of patent. It is apparent that since long prior to the application of the respondent No. 1, flexible
couplings have been manufactured in India and they have been described as Vulkan couplings and even the specifications and numbers given by Vulkans of West Germany had been followed by both the producers and the manufacturers in India. Even the Russian literature refers to flexible couplings as Vulkan couplings. The words Vulkan refers to flexible couplings as Vulkan coupling. The indigenous manufacturers of course put their own brand or trade names on such flexible couplings, for example, the petitioner's brand name is Unique.

The whole object of the respondent No. 1 was to oust all manufacturers of flexible couplings from their established business which they had been carrying on since a long time prior to the date of the application for grant of patent to the knowledge of the petitioner.

Flexible coupling is otherwise described in the trade as Vulkan coupling which is another name, which has been given to such couplings since a long time both in India and abroad.

The alleged improvement on something known before is neither particularized nor made specific in the complete specifications or the claims and it cannot be said that new or useful invention appears from the complete specifications or the claims. There are mere vague and uncertain allegations of improvement when the particulars as to the mechanical or chemical or other constructional particulars cannot disclose a new or useful invention specially when it is admitted that a large number of different types of flexible couplings have since long been manufactured and marketed in India by different manufacturers. It was accordingly held that the petitioner was entitled to an order for revocation of the impugned patent.

14.2.10 In the matter of revocation under section 64 and in the case of Jay Engineering Works Limited (Patentee) v. Polar Industries Limited (Petitioner) [PTC(Suppl)(2)310(Cal)], the ground was that the Patented invention [Patent being No. 155307 dated 20th February, 1981 granted by the Controller of Patents and Designs] is only a workshop improvement of something known i.e., Split type lower socket for use in ceiling fan motors, connecting down rod and shaft and does not involve any inventive step involved and also was known before priority date of a claim, hence not patentable. The patent was revoked and entries relating to patent thereof to be expunged from Register of Patents. The court held that Split type shackles have been in use since long prior to the application for the impugned patent. The claimed 'Patent' also used a similar type of mechanism both at the lower end of the rod by which the ceiling fan is hanged and also at the top of the shaft of the fan. The mechanisms have been put in a single piece on both the ends being the lower end of the rod and the upper end of the shaft of the fan.

It cannot be said in the instant case, that the patent registered is an inventive step, or that the same is more than a workshop improvement. Furthermore, it is a mere collection of more than one integers or things, not involving the exercise of any inventive faculty; as such, the same does not qualify for the grant of a patent. It is a device and/or mechanism, which had already been in use at the top end of the rod. Merely because the same device and/or mechanism has been made use of at the lower end of the rod to couple it with the upper end of the shaft of the fan by using the same mechanism and or device and merely because the two devices have been joined into a single piece on both sides, it cannot be said that it amounts to a new invention. In my opinion, it is an application of a known mechanism, which had
already been used for all practical purposes. It was obvious to a skilled worker, in the field concerned, in the state of knowledge existing at and prior to the date of the patent and was to be found in the literature and/or knowledge then available to him. Accordingly it was held that the petitioner was entitled to an order for revocation of the impugned patent.

14.2.11 In the matter of Low Heat Driers (P) Ltd. V Biju George (2001 (21) PTC 775) Kerala, it was held that once challenge is made with regard to the patent claimed by the plaintiff and its revocation is sought for by the defendants, all further things should be done only by the High Court. If interlocutory applications filed in the case are dealt with before considering the question of existence of the patent itself that will affect the rights of the defendants. What is obvious from the section is that once a counter-claim seeking revocation of patent is filed by the defendants, the District Court will lose jurisdiction to proceed with the matter any further. That deprivation of power will necessarily include the power to deal with all interlocutory applications pending as on that day. The court below has not therefore committed any error of jurisdiction in making the transfer of the case to this Court along with all pending applications. The petitioner can move for further relief as and when the case records reach this Court. The revision was dismissed.

14.2.12 In the matter of Fabson Corporation v. Industrial Engineering Corporation, (1987- PTC 312) All, the court has given guidelines about the claims regarding counter claim of patents in case of revocation of Patents. There is no inconsistency on account of the suit being defended as liable to dismissal in a particular case and a case where the defendant seeks also that the patent asserted by the plaintiff is invalid. It is only when there is a counter-claim seeking revocation of the patent that the jurisdiction of the District Court is ousted. The proviso to section 104 being in the nature of an exception to the general rule, it has to be strictly construed. There is no express claim on the part of the defendant for revocation of the patent where of infringement is alleged by the plaintiff. That the defendant pleads that the patent set up by the plaintiff is invalid amounts only to the defendant raising a ground for the relief sought by the plaintiff being declined; it does not follow necessarily that the defendant also seeks by way of a counter-claim that the patent be revoked. The defendant has not asserted in the pleadings anywhere that they are the patentee or that they are entitled to be registered as such. The grounds raised are cumulatively and also individually by way of defence to the plaintiff's action.

14.2.13 In the matter of Dhanpat Seth & Others (plaintiffs/patentee) v. Nil Kamal Plastic Crates Ltd (Defendants): 2006 (33) PTC 339(HP),

i) The petition was moved by the plaintiffs in OMP No. 530 of 2005 Civil Suit No. 69 of 2005, seeking grant of permanent prohibitory injunction restraining the defendant/respondent from infringing Patent No. 195917, in respect of a device of manually hauling of agriculture produce, granted in their favour on 11.7.2005

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ii) Patentee submitted that the invention was conceptualized/visualized by them in the year 1999. The application for grant of patent was moved on 24.5.2002 and the patent was granted on 11.7.2005 and that the patented device is an improvement over a local product known as 'Kilta' made of bamboos used for hauling agriculture produce

iii) Patented Invention: The plaintiffs' invention has the following description :-

"A device for hauling agriculture produce comprising a container of synthetic polymeric material defined by a hollow frusto-conical body open at the top and closed at the base and tapering from the operative open at the top and closed at the based and tapering from the operative open top to the base with perforated walls said perforations being essentially quadrilateral in configuration and reducing in dimensions from the operative top to the base; said wall having a contour adapted to proximate the back of a human body; and removable harnessing means secured to the container in the upper perforations, said harnessing means having straps and buckle formations adapted to be irremovably secured in and around the perforations in the said walls and looping means around the back and the shoulders of an individual, said straps and buckle components of the harnessing means being adjustable to permit the harnessing means to be secured to the container at varying locations on the wall of the container in the perforations and the looping means adapted to be adjusted to accommodate individuals of different heights and body structure."

iv) Alleged Infringement: According to the plaintiffs/petitioners, in the year 2005 the defendant/respondent infringed the patent by producing similar device/item and supplied it to the Department of Horticulture, Government of Himachal Pradesh and some private parties. The plaintiffs/petitioners have sued the defendant/respondent for damages as also for issuance of mandatory injunction, directing it not to infringe the patent and for seizure, forfeiture and distribution, without payment of any compensation of the duplicate of the patented device, supplied by the defendant to the Horticulture Department and some private persons. Through the present petition temporary injunction is sought restraining the defendant/respondent from manufacturing or selling the duplicate version of the invented device of the plaintiffs or from committing any act which may infringe the patent granted to the plaintiffs.

v) Defendant’s denial of infringement and Arguments–

The defendant denied of being involved in an infringement and argued that -

(a) the patented invention is nothing but imitation of traditional 'Kilta', the only difference being that the traditional 'Kilta' is made of bamboos, while the product of the plaintiffs is made of synthetic polymeric material.

(b) that as a matter of fact the very name of the product is deceptive inasmuch as it is not a device for manual hauling, as it is named, but is only a long basket (Kilta) meant for collection of fruits and other agriculture produce while the person doing the job remains in standing posture and the carrying of the fruit/produce, so collected to the collection centre.
(c) that as a matter of fact the defendant/respondent had prepared the design of its product, which too is a 'Kilta', in the year 2001 and submitted the drawings of the said design to Arries Moulding Co. Ltd. Taiwan in December 2001 for their advice and soon after receipt of their advice, with some technical modifications, the production started and the product was introduced in the market.

(d) that the defendant/respondent manufactured and marketed the product much before the filing of the application for patenting of its product by the plaintiffs

(e) Grounds for revocation relevant for deciding the present application are:

   a) that the so-called 'device', patented by the plaintiffs, is not an invention within the meaning of Section 2 (j) of the Patents Act, because it is not a new product;

   b) that the suit is hit by the doctrine of anticipation.

(f) The defendant has also filed an application for revocation of the patent, which according to the defendant, is in the nature of counterclaim

(g) Defendant’s Plea of Anticipation of Patented Invention:

   The defendant submitted that:-

   (a) a conference was held at Shimla at Hotel Cecil on 4.4.2002 for launching of 'Kilta', i.e. the patented article of the plaintiffs.

   (b) there is a letter, written by the plaintiffs to the Managing Director of National Horticulture Board, wherein it is claimed that the plaintiffs have launched plastic 'Kilta' in Shimla on 4.4.2002 and that the product was appreciated and approved by all, who were present at such launching

   (c) there is another letter dated 19.4.2003 at page 68. This letter is also addressed by the plaintiffs to the National Horticulture Board in which it is claimed that the plaintiffs had been marketing the 'Kilta', i.e. the patented 'device' for the last one year and the product was well accepted by the framers of Himachal Pradesh.

   (d) This letter of April 2003 clearly suggests that the patented article had been in the market at-least since April 2002. The application for getting the article patented was made on 24.5.2002. The aforesaid documents of the plaintiffs thus show that the patented article had been manufactured and introduced in the market more than a month prior to the making of the aforesaid application.

   vi) The Court’s observation:

   (a) During the hearing, the traditional 'Kilta' made of bamboos as has been in use since times immemorial, the patented 'device' of the plaintiffs and the
article manufactured and marketed by the defendant allegedly by infringing the patent granted to the plaintiffs were produced before the Court by the defendant. Just visual comparison of the three things indicated that the patented device of the plaintiffs and the product of the defendant are nothing but imitations of the traditional 'Kilta'.

(b) On being asked by the Court as to what is new about the 'device' got patented by the plaintiffs, when apparently it is like the traditional 'Kilta', the learned counsel representing the plaintiffs/petitioners submitted that the 'device' is light weight, it has adjustable nylone straps with buckle fitted to it and that these straps are a novelty in the sense that the traditional 'Kilta' is supported on the forehead by means of a rope, while the weight of the 'patented device' rests on the shoulders and this protects the user against the hazards of bearing the weight of 'Kilta' on the forehead, to which the Court, observed that it is a matter of common knowledge that even the traditional 'Kilta' is supported by the users on their shoulders, of course, by means of ropes or the straps and the users have by the experience of their forefathers learnt how to adjust it on their backs so that they remain comfortable, while plucking the fruits or collecting the agriculture produce and then walking with it to their destinations.

(c) As demonstrated hereinabove, the patented 'device' is not a new product. It is just an imitation of the traditional 'Kilta' and hence prima facie not an invention. The 'device' is made of synthetic polymeric material, which had been invented long back. The process by which the substance is moulded into various articles like baskets, buckets, mugs, jugs, furniture and so many other articles, is also too well-known. Thus, there is nothing new about the so-called 'device'.

(d) On submission by the plaintiffs/petitioners that since the patent has already been granted it should be presumed that the patented invention is novel and has not been anticipated, the court observed that Section 13 (4) of the Patents Act, 1970 says that the validity of the patent is not warranted by the grant of patent. The Hon'ble Supreme Court in M/s. Bishwanath Prasad Radhey Shyam v. M/s. Hindustan Metal Industries, (AIR 1982 SC 1444 : PTC (Suppl)(I) 731(SC)), has held as follows, vide para 33 at page 1450:-

"It is noteworthy that the grant and sealing of the patent or the decision rendered by the Controller in the case of opposition, does not guarantee the validity of the patent, which can be challenged before the High Court on various grounds in revocation or infringement proceedings."

(e) On plaintiff's final argument that Section 48 of the Patents Act, as amended by Patents (Amendment) Act, 2002, confers upon the patentee the exclusive right to prevent third parties, who do not have his consent, from making, using, offering for sale, selling or importing the patented product and that, in view of this provision, so long as the said patent is not revoked, nobody else can make, use, offer for sale etc the patented product and the implication of this statutory provisions is that the patentee is entitled to the relief of injunction by mere proof of the fact that the product is patented and that the patent has not been revoked, the Court observed that the argument
from the plaintiff side cannot be accepted, because as per Section 107 (1) of the Patents Act in any suit for infringement of patent, every ground on which it may be revoked under Section 64, is available as a ground for defence. One of the grounds for revocation of a patent under Section 64 of the Act is that “the patented product is not an invention” which, in the present case, means a new product. If in the instant suit for infringement filed by the defendant prima facie it appears from the material placed on record that the patented item is not a new product, but just an imitation of some traditional product, cast in a different material (synthetic polymeric material in this case), in that event the patentee will not be entitled to the relief of injunction, neither permanent for temporary. If the argument of the learned counsel for the plaintiffs/petitioner is accepted, that would mean that every patentee will get injunction from the Court just on filing a suit claiming therein that his product is patented and the patent has not been revoked. In other words, the Court would be acting just like a rubber stamp and granting relief without application of mind.

From the above discussion, it is clear that the plaintiff/petitioners do not have a prima facie case. Now, when they do not have a prima facie case, the question of balance of convenience being in their favour or their suffering any irreparable loss, does not arise. Consequently the O.M.P. is dismissed. The patent is revoked”.

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CHAPTER XV

REGISTER OF PATENTS

Section 67. Register of patents and particulars to be entered therein.-

(1) There shall be kept at the patent office a register of patents, wherein shall be entered—

(a) the names and addresses of grantees of patents;
(b) notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extension, and revocations of patents; and
(c) particulars of such other matters affecting the validity or proprietorship of patents as may be prescribed.

(2) No notice of any trust, whether express, implied or constructive, shall be entered in the register, and the Controller shall not be affected by any such notice.

(3) Subject to the superintendence and direction of the Central Government, the register shall be kept under the control and management of the Controller.

(4) Notwithstanding anything contained in sub-section (1), it shall be lawful for the Controller to keep the register of patents or any part thereof in computer floppies, diskettes or any other electronic form subject to such safeguards as may be prescribed.

(5) Notwithstanding anything contained in the Indian Evidence Act, 1872 (1 of 1872), a copy of, or extracts from, the register of patents, certified to be a true copy under the hand of the Controller or any officer duly authorised by the Controller in this behalf shall, in all legal proceedings, be admissible in evidence.

(6) In the event the register is kept wholly or partly in computer floppies, diskettes or any other electronic form,—

(a) reference in this Act to an entry in the register shall be deemed to include reference to a record of particulars kept in computer floppies, diskettes or any other electronic form and comprising the register or part of the register;
(b) references in this Act to particulars being registered or entered in the register shall be deemed to include references to the keeping of record of those particulars comprising the register or part of the register in computer floppies, diskettes or any other electronic form; and
(c) references in this Act to the rectification of the register are to be read as including references to the rectification of the record of particulars kept in computer floppies, diskettes or any other electronic form and comprising the register or part of the register.

Rule 88. Register of patents under section 67.-
(1) Upon the grant of patent, the Controller shall enter in the register of patents at each appropriate office, the name, address and nationality of the grantee as the patentee thereof, the title of the invention (including the categories to which the invention relates), the date of the patent and the date of grant thereof together with the address for service of the patentee.

(2) The Controller shall also enter in the register of patents particulars regarding proceedings under the Act before the Controller or Appellate Board or the courts in respect of every patent.

(3) Where the register of patents or any part thereof is in computer floppies, diskettes or any other electronic form it shall be maintained and accessed only by the person who is duly authorised by the Controller and no entry or alteration of any entry or rectification of any entry in the said register shall be made by any person who is not so authorised by the Controller.

Section 68. Assignments, etc, not to be valid unless in writing and duly executed—

An assignment of a patent or of a share in a patent, a mortgage, licence or the creation of any other interest in a patent shall not be valid unless the same were in writing and the agreement between the parties concerned is reduced to the form of a document embodying all the terms and conditions governing their rights and obligations and duly executed.

15.1.1 With regard to the kind of document for registration under section 68, a patent No. 141100 was granted to Franklin Manufacturing Company. White Consolidated Industries filed application for registration under section 68 of the Patent Act 1970 with the certificate of Secretary of State, State of Delawara certifying the copy of the certificate of ownership and merger. It was held by the Controller that the said certificate of the Secretary of State is neither an agreement between two or more parties or nor an assignment of a patent or share in patent or a mortgage of a patent or a licence under a patent or a document which creates any other interest in a patent other than by operation of law. Therefore said certificate of secretary of State is not a document as envisaged under section 68 of the Patent Act, 1970. In other words, document under registered under section 68 should be an agreement executive ‘Inter Vivos’ and should specifically at least one patent. Accordingly, a document investigating an interest in a patent on a person by operation of law i.e. a will and its probate or succession certificate is not agreement between the parties and therefore not registrable under section 68.

15.1.2 In Patent no. 136563 it was held that documents envisaged under Section 68 are agreements between two or more parties, which might be an assignment of a patent or a share in a patent, a mortgage of a patent or a licence under a patent or one which creates any other interest in a patent. In other words, a document to be registered under Section 68, should be an agreement executed ‘inter vivos’ and should specifically relate to at least one patent. In this case the document submitted for registration was certificate of the Secretary of State certifying the certificate of ownership and merger. The said certificate of the
Secretary of State was neither an agreement between two or more parties nor an assignment of a patent or share in a patent, or a mortgage of a patent or a licence under a patent or a document which created any other interest in a patent other than by operation of Law. Therefore, the certificate of Secretary of State was not held to be treated as a document as envisaged under Section 68 of the Act. Accordingly, a document investing an interest in a patent on a person by operation of law, e.g., a will and its probate or, succession certificate is not an agreement between parties and is not registrable under section 68 of the Act. The Registration of the document under Section 68 was refused.

15.1.3 In Patent No. 119891 and 126902 retrospective application under Section 68 and 69 were not allowed In these cases since the assignment in favour of Envirotech corporation were not registered under Section 68 within the period stipulated therein from the date Section 68 came into force, the entries under Section 69 became infructuous or had no effect. Consequently, Envirotech corporation could not be considered as proprietors of said patents and therefore, was considered to have no right to assign the said patents to General electric Company under Section 70 of the Act. The application for registration of documents filed by General Electric company under Section 68 & 69 was refused.

Section 69. Registration of assignments, transmissions, etc.-

(1) Where any person becomes entitled by assignment, transmission or operation of law to a patent or to a share in a patent or becomes entitled as a mortgagee, licensee or otherwise to any other interest in a patent, he shall apply in writing in the prescribed manner to the Controller for the registration of his title or, as the case may be, of notice of his interest in the register.

(2) Without prejudice to the provisions of sub-section (1), an application for the registration of the title of any person becoming entitled by assignment to a patent or a share in a patent or becoming entitled by virtue of a mortgage, licence or other instrument to any other interest in a patent may be made in the prescribed manner by the assignor, mortgagor, licensor or other party to that instrument, as the case may be.

(3) Where an application is made under this section for the registration of the title of any person the Controller shall, upon proof of title of his satisfaction,—

(a) where that person is entitled to a patent or a share in a patent, register him in the register as proprietor or co-proprietor of the patent, and enter in the register particulars of the instrument or even by which he derives title; or

(b) where that person is entitled to any other interest in the patent, enter in the register notice of his interest, with particulars of the instrument, if any, creating it:

Provided that if there is any dispute between the parties whether the assignment, mortgage, licence, transmission, operation of law or any other
such transaction has validly vested in such person a title to the patent or any share or interest therein, the Controller may refuse to take any action under clause (a) or, as the case may be, under clause (b) until the rights of the parties have been determined by a competent court.

(4) There shall be supplied to the Controller in the prescribed manner for being filed in the patent office copies of all agreements, licences and other documents affecting the title to any patent or any licence thereunder authenticated in the prescribed manner and also such other documents as may be prescribed relevant to the subject-matter:
Provided that in the case of a licence granted under a patent, the Controller shall, if so requested by the patentee or licensee, take steps for securing that the terms of the licence are not disclosed to any person except under the order of a court.

(5) Except for the purposes of an application under sub-section (1) or of an application to rectify the register, a document in respect of which no entry has been made in the register under sub-section (3) shall not be admitted by the Controller or by any court as evidence of the title of any person to a patent or to a share or interest therein unless the Controller or the court, for reasons to be recorded in writing, otherwise directs.

Section 70. Power of registered grantee or proprietor to deal with patent.-

Subject to the provisions contained in this Act relating to co-ownership of patents and subject also to any rights vested in any other person of which notice is entered in the register, the person or persons registered as grantee or proprietor of a patent shall have power to assign, grant licences under, or otherwise deal with the patent and to give effectual receipts for any consideration for any such assignment, licence or dealing:
Provided that any equities in respect of the patent may be enforced in like manner as in respect of any other movable property.

Rule 90. Registration of title and interest in patents.-

(1) An application referred to in sub-section (1) or sub-section (2) of section 69 shall be made in Form 16.

(2) An application for an entry in the register of patents of any other document purporting to affect the proprietorship of the patent by the person benefiting under the document shall be made in Form 16.

Rule 91. Presentation of assignment, etc., of patent to Controller.-

Every assignment and every other document giving effect to or being evidence of the transfer of a patent or affecting the proprietorship thereof or creating an interest therein as claimed in such application, shall, unless the Controller otherwise directs, be presented to him together with the application which shall be accompanied by two copies of the assignment or other document certified to be true copies by the applicant or his agent and the Controller may call for such other proof of title or written consent as he may require.
Rule 92. Registration of title or interest in a patent.

After the receipt of an application under sub-section (1) or sub-section (2) of section 69, the Controller shall register the title of the person concerned or his interest in a patent, as the case may be, and an entry in the following form shall be made in the register, namely:

"In pursuance of an application received on the
Proprietor ................................ Assignment................ registered as
................ licence
by virtue of ................ licence ................ Mortgagee etc.
Mortgage deed etc .................... dated ............... and made
between .of the one part and .................. of the other part."

Section 71. Rectification of register by Appellate Board.

(1) The Appellate Board may, on the application of any person aggrieved—
(a) by the absence or omission from the register of any entry; or
(b) by any entry made in the register without sufficient cause; or
(c) by any entry wrongly remaining on the register; or
(d) by any error or defect in any entry in the register,
make such order for the making, variation or deletion, of any entry therein as it may think fit.

(2) In any proceeding under this section the Appellate Board may decide any question that may be necessary or expedient to decide in connection with the rectification of the register.

(3) Notice of any application to the Appellate Board under this section shall be given in the prescribed manner to the Controller who shall be entitled to appear and be heard on the application, and shall appear if so directed by the Board.

(4) Any order of the Appellate Board under this section rectifying the register shall direct that notice of the rectification shall be served upon the Controller in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

Section 72. Register to be open for inspection.

(1) Subject to the provisions contained in this Act and any rules made thereunder, the register shall at all convenient times be open to inspection by the public; and certified copies, sealed with the seal of the patent office, of any entry in the register shall be given to any person requiring them on payment of the prescribed fee.

(2) The register shall be prima facie evidence of any matters required or authorised by or under this Act to be entered therein.

(3) If the record or particulars is kept in computer floppies or diskettes or in any other electronic form, sub-sections (1) and (2) shall be deemed to have been complied with if the public is given access to such computer floppies, diskettes or any other electronic form or printouts of such record of particulars for inspection.
Rule 95. Inspection of register of patents under section 72; and fees payable therefor.-

(1) The register of patents shall be open for public inspection during office hours on payment of the fees specified therefor in the First Schedule.

(2) When register of patents or any part thereof is in computer floppies, diskettes or any other electronic form the person authorised by the Controller under sub-rule (3) of rule 88 shall provide access to the computer floppies, diskettes or other electronic form or printouts of the records thereof.

Rule 133. Supply of certified copies and certificates under sections 72 and 147.-

Certified copies of any entry in the register, or certificates of, or extracts from patents, specifications and other public documents in the patent office, or from registers and other records including records in computer floppies, diskettes or any other electronic form kept there, may be furnished by the Controller on a request therefor made to him and on payment of the fee specified therefor in the First Schedule.

15.2 Register of Patents

a) A Register of Patents is an important document which is kept and maintained at the Patent Office at each location under the control and management of the Controller and contains all details about the patentee and patent right including the details of transfer of the right. It is regularly updated in order to incorporate the changes in respect of patent right.

b) Importance of Register of Patent is further augmented by way of the fact that the contents in the Register of Patent can be used as evidence in the Court of Law. There is no need of producing the original register in the court. The duly certified copy of the entries in respect of a patent in the Register of Patents can serve the purpose.

15.2.1 Particulars to be entered in Register of patents (S.67)

a) Upon grant of a patent, the Controller shall enter the following in the register of patents.

b) The names, addresses and nationality of the patentee, title of the invention including the categories to which the invention relates, date of the patent and date of granting thereof and address for service of the patentee.

c) The Controller shall also enter in the register of Patents, particulars regarding proceedings under the Act before the Controller or in the courts in respect of every patent.
d) The following notifications shall also be entered in the Register of Patents, namely:

i. Assignment and transmission of patents,
ii. License, mortgage etc. under patents,
iii. Amendments, extensions and revocation of patents,
iv. Cessation of patents,
v. Restoration of lapsed patents
vi. Surrender of patents
vii. Compulsory licenses and
viii. all other matters regarding validity and proprietorship of patents

e) The details of payment of the prescribed renewal fee, shall be entered in the register of patents upon issue of a certificate of the same \textit{that the fee has been paid and the date of payment of such fee as stated in certificate}.

f) No notice of any trust, whether express, implied or constructive shall be entered in the Register.

15.2.2 The Register of Patents or any part thereof can be kept in computer floppies, diskettes or any other electronic form subject to the prescribed safeguards. Maintenance, access to the Register, entry in the Register and alteration or rectification in respect of entries shall be made only by the authorized person.

15.2.3 Alteration of Address

i) A patentee may make a request in writing along with the prescribed fees as given in the First Schedule to the Controller for alteration of his name, nationality, address or address for service as entered in the register of patents in respect of any patent granted to him [Rule 94 (1)].

ii) The Controller may require such proof of the alteration as he may think fit before acting on the request. If the Controller allows such a request he shall cause the entries in the register to be altered accordingly.

iii) If a patentee makes a request in writing along with the prescribed fees for entering an additional address for service in India and the Controller is satisfied that the request should be allowed, the additional address shall be entered in the Register, subject to the condition that no more than two addresses for service shall be entered in the register at any one time.

15.2.4 Procedures Related To Entry In Register

i) Assignments, share in patent, a mortgage, licence or the creation of any other interest in a patent not to be valid unless it is in writing (S.69)

ii) An application for registration of his title or interest by virtue of assignment/transmission of patent or share in patent shall be made by –
(a) a person becoming entitled to a patent or a share in it is Form 16 (second schedule) with prescribed fee (1st schedule).
(b) a person becoming entitled as mortgagee or a licensee or otherwise to any other interest in a patent in Form 16 with prescribed fee.

iii) An application for registration of title of any person becoming entitled to a patent by virtue of assignment, mortgage, license or other instrument may be made by the assignor, mortgagor, licensor or other related party in Form 16 with the prescribed fee.

iv) An application for entry in the register of patents of the notification of any other document purporting to affect the proprietorship of the patent by the person benefiting under the document also shall be made in Form 16 with prescribed fee.

v) Presentation of assignment of patent, etc. to the Controller:

Every assignment and every other document giving effect to or being evidence of the transfer of a patent or affecting the proprietorship thereof or creating an interest therein as claimed in such application which shall be accompanied by two copies of the assignment or other document certified to be true by the applicant or his agent and the Controller may call for such other proof of title or written consent as he may require.

vi) Registration of title or interest in a patent:

After the receipt of an application under sub-section (1) or sub-section (2) of section 69, the Controller shall register the title of the person concerned or his interest in a patent, as the case may be and an entry in the following form shall be made in the register, namely-

“In pursuance of an application received on the Proprietor-Assignment Registered as licensee by virtue of license Mortgage etc. mortgage deed etc. dated and made between of the one part and of the other part”.

15.2.5 Certified Copies of Entry in Register:

Upon request along with the prescribed fees, the patent office shall supply the certified copies of any entry in the register, or certificates of, or extracts from patents, specifications and other public documents in the patent office, or from registers and other records including records in computer floppies, diskettes or any other electronic form.

15.2.6 Rectification of Register by Appellate Board (S. 71)

The Appellate Board may make rectification in the register, on the application of any person aggrieved

(a) By the absence or omission from the register of any entry; or
(b) By any entry made in the register without sufficient cause; or
(c) By any entry wrongly remaining on the register; or
(d) By any error or defect in any entry in the register, make such order for the making, variation or deletion, of any entry therein as it may think fit.

Notice of any application to the Appellate Board under this section will be given in the prescribed manner to the Controller who shall be entitled to appear and be heard on the application, and shall appear if so directed by the Board.

Any order of the Appellate Board under this provision rectifying the register shall direct that notice of the rectification shall be served upon the Controller in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

15.2.7 Register to be open for Inspection (S.72)

i) The Register of Patent will be open to inspection by the public at all convenient times; and certified copies sealed with the seal of the Patent Office, of any entry in the register, will be given to any person requiring them on payment of the prescribed fee as given in the First Schedule.

ii) If the record or particulars is kept in computer floppies or diskettes or in any other electronic form, the public will be given access to such computer floppies, diskettes or any other electronic form or printouts of such record of particulars for inspection on payment of the prescribed fee. However, the register can be accessed only by the person who is duly authorised by the Controller and no entry or alteration of any entry or rectification of any entry in the said register shall be made by any person who is not so authorised by the Controller.

15.2.8 In the matter of National Research Development Corporation v. Silicon Ceramics Ltd. (AIR 1998 Del 52.) Section 69(5) of the Patents Act, 1970 envisages that if an assignee or a licensee fails to apply for registration of a document under which an assignment of a patent has been made to him, he will be precluded from relying on the document as proof of his title to the use of the patent. This provision does not concern the title of the assignor. Even otherwise for adequate reasons to be recorded in writing, the court can always receive such a document in evidence. Even if section 69(5) of the Act is held to be applicable, this is a fit case where the agreement ought to be received in evidence as the respondent utilized the know-how for its advantage for 14 years without paying royalty. The respondent having drawn the benefit under the agreement cannot be allowed to shirk his responsibility of paying the royalty to the petitioner. In view of the above position of law, the High Court upheld the award of the arbitrator for payment of royalty for a period of 14 years from the date of manufacture of material.
Chapter XVI

Patent Office and its Establishments

Section 73. Controller and other officers.—

(1) The Controller General of Patents, Designs and Trade Marks appointed under sub-section (1) of section 3 of the Trade Marks Act, 1999 (47 of 1999), shall be the Controller of Patents for the purposes of this Act.

(2) For the purposes of this Act, the Central Government may appoint as many examiners and other officers and with such designations as it thinks fit.

(3) Subject to the provisions of this Act, the officers appointed under sub-section (2) shall discharge under the superintendence and directions of the Controller such functions of the Controller under this Act as he may, from time to time by general or special order in writing, authorise them to discharge.

(4) Without prejudice to the generality of the provisions of sub-section (3), the Controller may, by order in writing and for reasons to be recorded therein withdraw any matter pending before an officer appointed under sub-section (2) and deal with such matter himself either de novo or from the stage it was so withdrawn or transfer the same to another officer appointed under sub-section (2) who may, subject to special directions in the order of transfer, proceed with the matter either de novo or from the stage it was so transferred.

Section 74. Patent office and its branches.—

(1) For the purposes of this Act, there shall be an office which shall be known as the patent office.

(2) The Central Government may, by notification in the Official Gazette, specify the name of the Patent Office.

(3) The head office of the patent office shall be at such place as the Central Government may specify, and for the purpose of facilitating the registration of patents there may be established, at such other places as the Central Government may think fit, branch offices of the patent office.

(4) There shall be a seal of the patent office.

Section 75. Restriction on employees of patent office as to right or interest in patents.—

All officers and employees of the patent office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by that office.
Section 76. Officers and employees not to furnish information, etc.-

An officer or employee in the patent office shall not, except when required or authorised by this Act or under a direction in writing of the Central Government or Appellate Board or the Controller or by order of a court;

(a) furnish information on a matter which is being, or has been, dealt with under this Act; or

(b) prepare or assist in the preparation of a document required or permitted by or under this Act, to be lodged in the patent office; or

(c) conduct a search in the records of the patent office.

16.1 The Office of Controller General of Patents, Designs and Trade Marks is a subordinate office under Department of Industrial policy and Promotion, Ministry of Commerce and Industry, Government of India. This office is responsible for administration of the Patents Act including all matters relating to, filing, processing and grant of patents, in India apart from administering the Designs Act, the Trade marks Act and the Geographical Indication Act. The Patents Act provides for appointment of examiners and other officers, viz, Controllers for the purposes of the Act. The other officers discharge function of Controllers under the superintendence and directions of the Controller General subject to the provisions of the Act.

16.2 An hierarchical chart of the Patent Office is presented below:

The Controller General of Patents, Designs and Trade Marks

Senior Joint Controller of Patents and Designs

Joint Controller of Patents and Designs

Deputy Controller of Patents and Designs

Assistant Controller of Patents and Designs

Examiner of Patents and Designs
16.2.1 Controller of Patents:

The Controller General of Patents, Designs and Trade Marks appointed under sub-section (1) of section 3 of the Trade Marks Act, 1999, is the Controller of Patents.

16.2.2 Other officers

i) The Central Government may appoint as many examiners and other officers and with such designations as it thinks fit. Subject to the provisions of the Act, these officers shall discharge such functions of the Controller under this Act under the superintendence and directions of the Controller General of Patents, Designs and Trade Marks as he may, from time to time, by general or special order in writing, authorise them to discharge.

ii) The Controller General of Patents, Designs and Trade Marks (as a Controller of Patents) may, by order in writing and for reasons to be recorded therein, withdraw any matter pending before an officer appointed as above and deal with such matter himself either de novo or from the stage it was so withdrawn or he may transfer the same to another officer appointed who may, subject to special directions in the order of transfer, proceed with the matter either de novo or from the stage it was so transferred. (Section 73)

iii) While discharging the functions of the Controller delegated to them, the officers have to work within the provisions of the Act.

iv) The expression “under the superintendence and directions of the Controller” refers only to the administrative superintendence and such directions which do not include directions as to how and in what manner the officers should decide the particular case.

16.3 Patent office and its branches (Section 74)

The Head Office of the Patent Office is at Kolkata. There are three branch offices at Chennai, Delhi and Mumbai. The jurisdiction of the Head Office and the Branch Offices are as follows:

POB Chennai: The States of Andhra Pradesh, Kerala, Karnataka and Tamil Nadu, and UTs of Pondicherry, Lakshadweep.


POB Mumbai: The States of Maharashtra, Madhya Pradesh, Gujarat, Chattisgarh and UTs Daman & Diu, Dadar & Nagar Haveli.

PO Kolkata: Rest of India.
An applicant has to submit his application at the appropriate office.

(a) The appropriate office of the patent office shall be the head office or the branch office, as the case may be, within whose territorial limits—

(b) the applicant or first mentioned applicant in case of joint applicants for a patent, normally resides or has his domicile or has a place of business or the place from where the invention actually originated; or

(c) the applicant for a patent or party in a proceeding if he has no place of business or domicile in India, the address for service in India given by such applicant or party is situated;

(d) The appropriate office once decided in respect of any proceedings under the Act shall not ordinarily be changed.

16.2.1 In Patent Application No. 1569/MAS/1995(184618) the applicant was directed to apply for restoration of patent act to Patent Office, Kolkata as the previous proceedings was initiated there.

16.4 Restriction On Employees Of Patent Office

i) There is a restriction on the employees of Patent Office as to right or interest in patents. All officers and employees of the Patent Office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by that office. (Section 75)

ii) Except when required or authorised by the Act or under a direction in writing of the Central Government or the Appellate Board or the Controller or by order of a court, an officers or employee in the Patent Office are prohibited from any of the following: (Section 76) -

(a) furnishing information on a matter which is being, or has been, dealt with under this Act or
(b) preparing or assisting in the preparation of a document required or permitted by or under this Act to be lodged in the patent office; or
(c) conducting a search in the records of the patent office.
CHAPTER XVII

POWERS OF THE CONTROLLER GENERALLY

Section 77. Controller to have certain powers of a civil court.-

(1) Subject to any rules made in this behalf, the Controller in any proceedings before him under this Act shall have the powers of a civil court while trying a suit under the Code of Civil Procedure, 1908 (5 of 1908), in respect of the following matters, namely:—

(a) summoning and enforcing the attendance of any person and examining him on oath;
(b) requiring the discovery and production of any document;
(c) receiving evidence on affidavits;
(d) issuing commissions for the examination of witnesses or documents;
(e) awarding costs;
(f) reviewing his own decision on application made within the prescribed time and in the prescribed manner;
(g) setting aside an order passed ex parte on application made within the prescribed time and in the prescribed manner;
(h) any other matter which may be prescribed.

(2) Any order for costs awarded by the Controller in exercise of the powers conferred upon him under sub-section (1) shall be executable as a decree of a civil court.

Rule 130. Application for review of decisions or setting aside of orders of the Controller.-

(1) An application to the Controller for the review of his decision under clause (f) of sub-section (1) of section 77 shall be made in Form 24 within one month from the date of communication of such decision to the applicant or within such further period not exceeding one month thereafter as the Controller may on a request made in Form 4 allow and shall be accompanied by a statement setting forth the grounds on which the review is sought. Where the decision in question concerns any other person in addition to the applicant, the Controller shall forthwith transmit a copy of each of the application and the statement to the other person concerned.

(2) An application to the Controller for setting aside an order passed by him ex parte under clause (g) of sub-section (1) of section 77 shall be made in Form 24 within one month from the date of communication of such order to the applicant or within such further period not exceeding one month as the Controller may on a request made in Form 4 allow
and shall be accompanied by a statement setting forth the grounds on which the application is based. Where the order concerns any other person in addition to the applicant, the Controller shall, forthwith transmit a copy each of the application and the statement to the other person concerned.

Section 78. Power of Controller to correct clerical errors, etc.-

(1) Without prejudice to the provisions contained in sections 57 and 59 as regards amendment of applications for patents or complete specifications or other documents related thereto and subject to the provisions of section 44, the Controller may, in accordance with the provisions of this section, correct any clerical error in any patent or in any specification or other document filed in pursuance of such application or in any application for a patent or any clerical error in any matter which is entered in the register.

(2) A correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.

(3) Where the Controller proposes to make any such correction as aforesaid otherwise than in pursuance of a request made under this section, he shall give notice of the proposal to the patentee or the applicant for the patent, as the case may be, and to any other person who appears to him to be concerned, and shall give them an opportunity to be heard before making the correction.

(4) Where a request is made under this section for the correction of any error in a patent or application for a patent or any document filed in pursuance of such an application, and it appears to the Controller that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons affected thereby, he shall require notice of the nature of the proposed correction to be published in the prescribed manner.

(5) Within the prescribed time after any such publication as aforesaid any person interested may give notice to the Controller of opposition to the request, and, where such notice of opposition is given, the Controller shall give notice thereof to the person by whom the request was made, and shall give to him and to the opponent an opportunity to be heard before he decides the case.

Section 79. Evidence how to be given and powers of Controller in respect thereof.—

Subject to any rules made in this behalf, in any proceeding under this Act before the Controller, evidence shall be given by affidavit in the absence of directions by the Controller to the contrary, but in any case in which the Controller thinks it right so to do, he may take oral evidence in lieu of, or in addition to, evidence by an affidavit, or may allow any party to be cross-examined on the contents of his affidavit.
Section 80. Exercise of discretionary powers by Controller.—

Without prejudice to any provision contained in this Act requiring the Controller to hear any party to the proceedings thereunder or to give any such party an opportunity to be heard, the Controller shall give to any applicant for a patent, or for amendment of a specification (if within the prescribed time the applicant so requires) an opportunity to be heard before exercising adversely to the applicant any discretion vested in the Controller by or under this Act.

Provided that the party desiring a hearing makes the request for such hearing to the Controller at least ten days in advance of the expiry of the time-limit specified in respect of the proceeding.

Section 81. Disposal by Controller of applications for extension of time.—

Where under the provisions of this Act or the rules made thereunder the Controller may extend the time for doing any act, nothing in this Act shall be deemed to require him to give notice to or hear the party interested in opposing the extension, nor shall any appeal lie from any order of the Controller granting such extension.

Rule 122. Correction of clerical error.—

A request for the correction of a clerical error in any document referred to in section 78 shall be accompanied by a copy of the document highlighting the corrections clearly along with the fees payable therefor as specified in the First Schedule.

Rule 123. Manner of advertisement of the proposed correction of any error.—

Where the Controller requires a notice of the nature of the proposed correction to be advertised, the request and the nature of the proposed correction shall be published and the person making the request shall also serve copies of the request and the copies of the document showing the proposed corrections to such persons who, in the opinion of the Controller, may be interested.

Rule 124. Manner and time of opposition to the making of corrections.—

(1) Any person interested may, at any time, within three months from the date of the advertisement of the request for correction give notice of opposition to the Controller in Form 14 in duplicate.

(2) Such notice of opposition shall be accompanied by a statement in duplicate setting out the nature of the opponent's interest, the facts on which he relies and the relief which he seeks.

(3) A copy of the notice and of the statement shall be sent by the Controller to the person making the request.
(4) The procedure specified in rules 58 to 63 relating to the filing of reply statement, leaving evidence and hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 78 as they apply in the hearing of the opposition proceeding.

Rule 125. Notification of corrections.-

The Controller shall notify the person making a request for the correction and the opponent, if any, of the corrections made in the relevant document.

17.1 Powers of Controller

The Controller of Patents is conferred with various statutory powers for discharging his functions under the statute. The Controller has certain powers of the Civil Court in respect of some matters specified under section 77. For the purpose of opposition to grant of Patent, whether pre-grant or post-grant, the Controller is vested with some powers of the Court. As the Controller is the quasi-judiciary (Tribunal) Authority, the Controller is conferred with powers of a Civil Court while trying a suit under the Code of Civil Procedure (5 of 1908) in respect of the following matters.

a) Summoning and enforcing the attendance of any person and examine him on oath,

b) Requiring the discovery and production of any document.

c) Receiving evidence on affidavits

d) Issuing commissions for the examination of witnesses or documents

e) Awarding costs: any order for costs awarded by the Controller in exercise of the powers conferred upon him by this section shall be executable as a decree of a civil court

f) Reviewing his own decision:

The application should be made to the Controller on Form 24 along with the prescribed fee within one month from the date of communication of such decision. Sufficient grounds should accompany the Form 24, while making request to the Controller to review the decision. Extension of time is allowed for further period of one month when a request is made therefore by filing form 4 with the prescribed fee.

17.2 Power of Controller to correct clerical errors, etc. (Section 78)

(a) (i) The Controller has power to correct any clerical error in any patent, complete specification or other document or matter entered in the register without request or with request made by the person interested by filing the prescribed fee.

ii) The power of Controller to correct a clerical error under section 78 is without prejudice to the provisions of sections 57 and 59.
17.2.1 The Controller is empowered to correct only the clerical errors under this section. These powers are without prejudice to the provisions of section 57 and 59, which deals with the amendment of applications and specifications. The Controller must ascertain whether the case is one, which relates to clerical error or the amendment. If, what is sought for amounts to amendment and not the clerical error, he shall follow the provisions of section 57 and 59 and the corresponding rules 81 to 83.

(b) Procedure to make such corrections has been described in Rules 122 to 125:

i) A request for the correction shall be submitted along with a copy of the document highlighting the corrections clearly along with the fees payable therefore

ii) If the Controller proposes to correct the error on his own (without request) he shall give notices to the person who appears to him to be concerned and shall give him an opportunity to be heard.

iii) When a request is made to the Controller for correcting any error, if the Controller feels that the amendment to be carried out may alter the meaning and scope of the document, he shall advertise the same in the official journal in the prescribed manner.

iv) Accordingly, an applicant cannot seek an amendment of the application for patent or the complete specification under the guise of correction of a clerical error. If the proposed correction would in effect amount to an amendment, then the procedure contained in section 57 should be followed. Further, the correction sought must also satisfy the requirements of section 59.

v) Any interested person can file an opposition by filing form 14 (notice of opposition) within three months from the date of the advertisement of the request for correction for the amendment to be carried out under the provisions of this section. In such a case the Controller will proceed in a normal way as he acts under the provisions of sections 25 & 26.

17.2.2 In the matter of Pressmetal corporation limited v. Noshir Sorabji Pochkannawalla, AIR 1983 Bom 144, it was held that the Controller is empowered only to correct clerical errors and not to amend the specification.

17.2.3 With regard to fresh set of claims proposed at the time of review petition under section 77 (1)(f), an application for patent No.770/Del/78 filed by Council of Scientific and Industrial Research (CSIR) was refused to proceed further under section 15 of the Patents Act, 1970. The applicants filed a review petition against the order of the Controller on the ground that decision was erroneous, as they have not been provided any opportunity to amend the statement of claims and the fining of the Controller to refuse the application are extreme step, which could have been avoided. The petitioners have also submitted the amended set of claims before the Controller. The Controller held that amendments proposed in the claims are said to be based on the experimentation conducted subsequent
the date of application for patent. Further, non disclosure of specific reason motivating the proposed amendments it is sufficient reason for non allowance of a request for amendment in accordance with the principles of law laid down in 1956, RPC 193. It was further held that incorporation of different set of claims does not fall under any of the grounds under which a review petition lies and therefore a review petition cannot utilize as a means to reverts the facts based on which the decision under review was issued. Moreover allowance of different set of claims at this stage will tantamount to extension of time period prescribed under section 21 of the Patents Act, 1970 that the Controller is not empowered to do.

17.2.4 The Controller of Patents is not technically a court but there is a fair analogy between his position and that of a court. Therefore a writ of prohibition can be issued on him (In Re. National Carbon Co. Inc., A.I.R. 1934 Cal. 725).

17.2.5 The Civil Procedure Code is not applicable to proceedings before the Controller. The principles underlying the Code, in so far as they are principles of natural justice, must of course be observed by him (In Re. National Carbon Co. Inc., A.I.R. 1934 Cal 725).

17.2.6 The practice regarding award of costs by the Controller will be regulated by the principles laid down in Civil Procedure Code that the “Costs follow the event unless the Court for good reasons otherwise order. (Decision of the Controller (1945) Re. Patent Application No. 29914).

17.2.7 The Controller may award costs in respect of proceedings at the Patent Office only if in connection with such proceedings he has to decide any matter in dispute between the parties. (Order of the Controller (1946) Re. Patents Nos. 15363, 18739, 21285 and 23557).

17.2.8 Powers of Controller in taking the evidences (S. 79)

1) Section 77(1) (c) empowers the Controller to exercise the powers of a Civil Court in the matter of receiving evidence on affidavits.

2) The Controller also has the power of taking oral evidence in lieu of, or in addition to evidence by affidavit. He may also allow any party to be cross-examined on the contents of his affidavit. The Controller may also accept documentary evidence unaccompanied by an affidavit.

17.3 Exercise of discretionary powers by the Controller (S. 80)

This section provides the provisions related to discretionary powers of the Controller. Before exercising any discretion adversely to any applicant for a patent or for amendment of a specification, the Controller should give the party an opportunity to be heard within the prescribed period, if the applicant so requires, provided that a request is made at least ten days in advance of the expiry of the respective time limit. The Controller shall exercise the discretionary power following the principle of natural justice. The power shall not be exercised arbitrarily.
17.4 **Disposal by Controller of applications for extension of time. S.81**

The Controller is also empowered to extend the time for doing many acts under various provisions of the Act and the rules. For example under rule 138, the Controller can condone any time delay caused by the applicant and extend the time for performing such act. The Act does not require the Controller to give notice or hear the party interested in opposing the extension. No appeal from any order of the Controller granting such extension. However, his decisions shall be based on the principle of fairness and natural justice.
CHAPTER XVIII

WORKING OF PATENTS AND COMPULSORY LICENCE AND REVOCATION

Section 82. Definition of "patented articles" and "patentee".—

In this Chapter, unless the context otherwise requires,—
(a) "patented article" includes any article made by a patented process; and
(b) "patentee" includes an exclusive licensee.

Section 83. General principles applicable to working of patented inventions.—

Without prejudice to the other provisions contained in this Act, in exercising the powers conferred by this Chapter, regard shall be had to the following general considerations, namely;—
(a) that patents are granted to encourage inventions and to secure that the inventions are worked in India on a commercial scale and to the fullest extent that is reasonably practicable without undue delay;
(b) that they are not granted merely to enable patentees to enjoy a monopoly for the importation of the patented article;
(c) that the protection and enforcement of patent rights contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations;
(d) that patents granted do not impede protection of public health and nutrition and should act as instrument to promote public interest specially in sectors of vital importance for socio-economic and technological development of India;
(e) that patents granted do not in any way prohibit Central Government in taking measures to protect public health;
(f) that the patent right is not abused by the patentee or person deriving title or interest on patent from the patentee, and the patentee or a person deriving title or interest on patent from the patentee does not resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology; and
(g) that patents are granted to make the benefit of the patented invention available at reasonably affordable prices to the public.

Section 84. Compulsory licences.—
(1) At any time after the expiration of three years from the date of the grant of a patent, any person interested may make an application to the Controller for grant of compulsory licence on patent on any of the following grounds, namely:

(a) that the reasonable requirements of the public with respect to the patented invention have not been satisfied, or

(b) that the patented invention is not available to the public at a reasonably affordable price, or

(c) that the patented invention is not worked in the territory of India.

(2) An application under this section may be made by any person notwithstanding that he is already the holder of a licence under the patent and no person shall be estopped from alleging that the reasonable requirements of the public with respect to the patented invention are not satisfied or that the patented invention is not worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price by reason of any admission made by him, whether in such a licence or otherwise or by reason of his having accepted such a licence.

(3) Every application under sub-section (1) shall contain a statement setting out the nature of the applicant's interest together with such particulars as may be prescribed and the facts upon which the application is based.

(4) The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied or that the patented invention is not worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price, may grant a licence upon such terms as he may deem fit.

(5) Where the Controller directs the patentee to grant a licence he may as incidental thereto exercise the powers set out in section 88.

(6) In considering the application field under this section, the Controller shall take into account,—

(i) the nature of the invention, the time which has elapsed since the sealing of the patent and the measures already taken by the patentee or any licensee to make full use of the invention;

(ii) the ability of the applicant to work the invention to the public advantage;

(iii) the capacity of the applicant to undertake the risk in providing capital and working the invention, if the application were granted;

(iv) as to whether the applicant has made efforts to obtain a licence from the patentee on reasonable terms and conditions and such efforts have not been successful within a reasonable period as the Controller may deem fit:

Provided that this clause shall not be applicable in case of national emergency or other circumstances of extreme urgency or in case of public non-commercial use or on establishment of a ground of anticompetitive practices adopted by the patentee, but shall not be required to take into account matters subsequent to the making of the application.
Explanation.—For the purposes of clause (iv), "reasonable period" shall be construed as a period not ordinarily exceeding a period of six months.

(7) For the purposes of this Chapter, the reasonable requirements of the public shall be deemed not to have been satisfied—

(a) if, by reason of the refusal of the patentee to grant a licence or licences on reasonable terms,—

(i) an existing trade or industry or the development thereof or the establishment of any new trade or industry in India or the trade or industry in India or the trade or industry of any person or class of persons trading or manufacturing in India is prejudiced; or

(ii) the demand for the patented article has not been met to an adequate extent or on reasonable terms; or

(iii) a market for export of the patented article manufactured in India is not being supplied or developed; or

(iv) the establishment or development of commercial activities in India is prejudiced; or

(b) if, by reason of conditions imposed by the patentee upon the grant of licences under the patent or upon the purchase, hire or use of the patented article or process, the manufacture, use or sale of materials not protected by the patent, or the establishment or development of any trade or industry in India, is prejudiced; or

(c) if the patentee imposes a condition upon the grant of licences under the patent to provide exclusive grant back, prevention to challenges to the validity of patent or coercive package licensing; or

(d) if the patented invention is not being worked in the territory of India on a commercial scale to an adequate extent or is not being so worked to the fullest extent that is reasonably practicable; or

(e) if the working of the patented invention in any part of India on a commercial scale is being prevented or hindered by the importation from abroad of the patent

(i) the patentee or persons claiming

(ii) persons directly or indirectly purchasing from him; or

(iii) other persons against whom the patentee is not taking or has not taken proceedings for infringement.

Section 85. Revocation of patents by the Controller for non-working.-

(1) Where, in respect of a patent, a compulsory licence has been granted, the Central Government or any person interested may, after the expiration of two years from the date of the order granting the first compulsory licence, apply to the Controller for an order revoking the patent on the ground that the patented invention has not been worked in the territory of India or that reasonable requirements of the public with respect to the patented invention has not been satisfied or that the patented invention is not available to the public at a reasonably affordable price.

(2) Every application under sub-section (1) shall contain such particulars as may be prescribed, the facts upon which the application is based, and, in the case of an application other than by the Central Government, shall also set out the nature of the applicant's interest.
(3) The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention has not been satisfied or that patented invention has not been worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price, may make an order revoking the patent.

(4) Every application under sub-section (1) shall ordinarily be decided within one year of its being presented to the Controller.

**Rule 96. Application for compulsory licence etc.-**

An application to the Controller for an order under section 84, section 85, section 91 or section 92 or section 92A shall be in Form 17, or Form 19, as the case may be. Except in the case of an application made by the Central Government, the application shall set out the nature of the applicant's interest and terms and conditions of the licence the applicant is willing to accept.

**Rule 97. When a prima facie case is not made out.-**

1. If, upon consideration of the evidence, the Controller is satisfied that a prima facie case has not been made out for the making of an order under any of the sections referred to in rule 96, he shall notify the applicant accordingly, and unless the applicant requests to be heard in the matter, within one month from the date of such notification, the Controller shall refuse the application.

2. If the applicant requests for a hearing within the time allowed under sub-rule (1), the Controller shall, after giving the applicant an opportunity of being heard, determine whether the application may be proceeded with or whether it shall be refused.

**Rule 99. Manner of publication of the revocation order;**

The Controller shall publish the order made by him under sub-section (3) of section 85 revoking a patent.

**Section 86. Power of Controller to adjourn applications for compulsory licences, etc., in certain cases.-**

1. Where an application under section 84 or section 85, as the case may be, is made on the grounds that the patented invention has not been worked in the territory of India or on the ground mentioned in clause (d) of sub-section (7) of section 84 and the Controller is satisfied that the time which has elapsed since the sealing of the patent has for any reason been insufficient to enable the invention to be worked on a commercial scale to an adequate extent or to enable the invention to be so worked to the fullest extent that is reasonably practicable, he may, by order, adjourn the further hearing of the application for such period not exceeding twelve months in the aggregate as appears to him to be sufficient for the invention to be so worked:

Provided that in any case where the patentee establishes that the reason why a patented invention could not be worked as aforesaid before the date of the
application was due to any State or Central Act or any rule or regulation made thereunder or any order of the Government imposed otherwise than by way of a condition for the working of the invention in the territory of India or for the disposal of the patented articles or of the articles made, by the process or by the use of the patented plant, machinery, or apparatus, then, the period of adjournment ordered under this sub-section shall be reckoned from the date on which the period during which the working of the invention was prevented by such Act, rule or regulation or order of Government as computed from the date of the application, expires.

(2) No adjournment under sub-section (1) shall be ordered unless the Controller is satisfied that the patentee has taken with promptitude adequate or reasonable steps to start the working of the invention in the territory of India on a commercial scale and to an adequate extent.

Section 87. Procedure for dealing with applications under sections 84 and 85.-

(1) Where the Controller is satisfied, upon consideration of an application under section 84, or section 85, that a prima facie case has been made out for the making of an order, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which the application is made, and shall publish the application in the official journal.

(2) The patentee or any other person desiring to oppose the application may, within such time as may be prescribed or within such further time as the Controller may on application (made either before or after the expiration of the prescribed time) allow, give to the Controller notice of opposition.

(3) Any such notice of opposition shall contain a statement setting out the grounds on which the application is opposed.

(4) Where any such notice of opposition is duly given, the Controller shall notify the applicant, and shall give to the applicant and the opponent an opportunity to be heard before deciding the case.

Section 88. Powers of Controller in granting compulsory licences.—

(1) Where the Controller is satisfied an application made under section 84 that the manufacture, use or sale of materials not protected by the patent is prejudiced by reason of conditions imposed by the patentee upon the grant of licences under the patent, or upon the purchase, hire or use of the patented article or process, he may subject to the provisions of that section, order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant.

(2) Where an application under section 84 is made by a person being the holder of a licence under the patent, the Controller may, if he makes an order for the grant of a licence to the applicant, order the existing licence to be cancelled, or may, if he thinks fit, instead of making an order for the
grant of a licence to the applicant, order the existing licence to be amended.

(3) Where two or more patents are held by the same patentee and an applicant for a compulsory licence establishes that the reasonable requirements of the public have not been satisfied with respect to some only of the said patents, then, if the Controller is satisfied that the applicant cannot efficiently or satisfactorily work the licence granted to him under those patents without infringing the other patents held by the patentee and if those patents involve important technical advancement or considerable economic significance in relation to the other patents, he may, by order, direct the grant of a licence in respect of the other patents also to enable the licensee to work the patent or patents in regard to which a licence is granted under section 84.

(4) Where the terms and conditions of a licence have been settled by the Controller, the licensee may, at any time after he has worked the invention on a commercial scale for a period of not less than twelve months, make an application to the Controller for the revision of the terms and conditions on the ground that the terms and conditions settled have proved to be more onerous than originally expected and that in consequence thereof the licensee is unable to work the invention except at a loss: Provided that no such application shall be entertained a second time.

Section 89. General purposes for granting compulsory licences.-

The powers of the Controller upon an application made under section 84 shall be exercised with a view to securing the following general purposes, that is to say,—

(a) that patented inventions are worked on a commercial scale in the territory of India without undue delay and to the fullest extent that is reasonably practicable;
(b) that the interests of any person for the time being working or developing an invention in the territory of India under the protection of a patent are not unfairly prejudiced.

Section 90. Terms and conditions of compulsory licences.-

(1) In settling the terms and conditions of a licence under section 84, the Controller shall endeavour to secure-

(i) that the royalty and other remuneration, if any, reserved to the patentee or other person beneficially entitled to the patent, is reasonable, having regard to the nature of the invention, the expenditure incurred by the patentee in making the invention or in developing it and obtaining a patent and keeping it in force and other relevant factors;
(ii) that the patented invention is worked to the fullest extent by the person to whom the licence is granted and with reasonable profit to him;
(iii) that the patented articles are made available to the public at reasonably affordable prices;
(iv) that the licence granted is a non-exclusive licence;
(v) that the right of the licensee is non-assignable;
(vi) that the licence is for the balance term of the patent unless a shorter term is consistent with public interest;
(vii) that the licence is granted with a predominant purpose of supply in the Indian market and that the licensee may also export the patented product, if need be in accordance with the provisions of sub-clause (iii) of clause (a) of sub-section (7) of section 84;
(viii) that in the case of semiconductor technology, the licence granted is to work the invention for public non-commercial use;
(ix) that in case the licence is granted to remedy a practice determined after judicial or administrative process to be anti-competitive, the licensee shall be permitted to export the patented product, if need be.

(2) No licence granted by the Controller shall authorise the licensee to import the patented article or an article or substance made by a patented process from abroad where such importation would, but for such authorisation, constitute an infringement of the rights of the patentee.

(3) Notwithstanding anything contained in sub-section (2), the Central Government may, if in its opinion it is necessary so to do, in the public interest, direct the Controller at any time to authorise any licensee in respect of a patent to import the patented article or an article or substance made by a patented process from abroad (subject to such conditions as it considers necessary to impose relating among other matters to the royalty and other remuneration, if any, payable to the patentee, the quantum of import, the sale price of the imported article and the period of importation), and thereupon the Controller shall give effect to the directions.

Section 91. Licensing of related patents.-

(1) Notwithstanding anything contained in the other provisions of this Chapter, at any time after the sealing of a patent, any person who has the right to work any other patented invention either as patentee or as licensee thereof, exclusive or otherwise, may apply to the Controller for the grant of a licence of the first mentioned patent on the ground that he is prevented "or hindered without such licence from working the other invention efficiently or to the best advantage possible

(2) No order under sub-section (1) shall be made unless the Controller is satisfied—

(i) that the applicant is able and willing to grant, or procure the grant to the patentee and his licensees if they so desire, of a licence in respect of the other invention on reasonable terms; and
(ii) that the other invention has made a substantial contribution to the establishment or development of commercial or industrial activities in the territory of India.

(3) When the Controller is satisfied that the conditions mentioned in sub-section (1) have been established by the applicant, he may make an order on such terms as he thinks fit granting a licence under the first mentioned patent and a similar order under the other patent if so requested by the proprietor of the first mentioned patent or his licensee:

Provided that the licence granted by the Controller shall be non-assignable except with the assignment of the respective patents.

(4) The provisions of sections 87, 88, 89 and 90 shall apply to licences granted under this section as they apply to licences granted under section 84.

Section 92. Special provision for compulsory licences on notifications by Central Government.-

(1) If the Central Government is satisfied, in respect of any patent in force in circumstances of national emergency or in circumstances of extreme urgency or in case of public non-commercial use, that it is necessary that compulsory licenses should be granted at any time after the sealing thereof to work the invention, it may make a declaration to that effect, by notification in the Official Gazette, and thereupon the following provisions shall have effect, that is to say—

(i) the Controller shall on application made at any time after the notification by any person interested grant to the applicant a licence under the patent on such terms and conditions as he thinks fit;

(ii) in settling the terms and conditions of a licence granted under this section, the Controller shall endeavour to secure that the articles manufactured under the patent shall be available to the public at the lowest prices consistent with the patentees deriving a reasonable advantage from their patent rights.

(2) The provisions of sections 83, 87, 88, 89 and 90 shall apply in relation to the grant of licences under this section as they apply in relation to the grant of licences under section 84.

(3) Notwithstanding anything contained in sub-section (2), where the Controller is satisfied on consideration of the application referred to in clause (i) of sub-section (1) that it is necessary in—

(i) a circumstance of national emergency; or

(ii) a circumstance of extreme urgency; or

(iii) a case of public non-commercial use,

which may arise or is required, as the case may be, including public health crises, relating to Acquired Immuno Deficiency Syndrome, Human Immuno Deficiency Virus, tuberculosis, malaria or other epidemics, he shall
not apply any procedure specified in section 87 in relation to that application for grant of licence under this section:

Provided that the Controller shall, as soon as may be practicable, inform, the patentee of the patent relating to the application for such non-application of section 87.

Section 92A. Compulsory licence for export of patented pharmaceutical products in certain exceptional circumstances.-

(1) Compulsory licence shall be available for manufacture and export of patented pharmaceutical products to any country having insufficient or no manufacturing capacity in the pharmaceutical sector for the concerned product to address public health problems, provided compulsory licence has been granted by such country or such country has, by notification or otherwise, allowed importation of the patented pharmaceutical products from India.

(2) The Controller shall, on receipt of an application in the prescribed manner, grant a compulsory licence solely for manufacture and export of the concerned pharmaceutical product to such country under such terms and conditions as may be specified and published by him.

(3) The provisions of sub-sections (1) and (2) shall be without prejudice to the extent to which pharmaceutical products produced under a compulsory license can be exported under any other provision of this Act.

Explanation.—for the purposes of this section, 'pharmaceutical products' means any patented product, or product manufactured through a patented process, of the pharmaceutical sector needed to address public health problems and shall be inclusive of ingredients necessary for their manufacture and diagnostic kits required for their use.

Section 93. Order for licence to operate as a deed between parties concerned.-

Any order for the grant of a licence under this Chapter shall operate as if it were a deed granting a licence executed by the patentee and all other necessary parties embodying the terms and conditions, if any, settled by the Controller

Section 94. Termination of compulsory licence.—

(1) On an application made by the patentee or any other person deriving title or interest in the patent, a compulsory licence granted under section 84 may be terminated by the Controller, if and when the circumstances that gave rise to the grant thereof no longer exist and such circumstances are unlikely to recur:
Provided that the holder of the compulsory licence shall have the right to object to such termination.
(2) While considering an application under section (1), the Controller shall take into account that the interest of the person who had previously been granted the licence is not unduly prejudiced.


Rule 98. Notice of opposition under section 87(2).-

(1) A notice of opposition under sub-section (2) of section 87 shall be given in Form 14 and shall be sent to the Controller within two months from the date of the publication of the application under sub-section (1) of the said section.
(2) The notice of opposition referred to in sub-rule (1) shall include the terms and conditions of the licence, if any, the opponent is prepared to grant to the applicant and shall be accompanied by evidence in support of the opposition.
(3) The opponent shall serve a copy of his notice of opposition and evidence on the applicant and notify the Controller when such service has been effected.
(4) No further statement or evidence shall be delivered by either party except with the leave of or on requisition by the Controller.
(5) The Controller shall forthwith fix a date and time for the hearing of the case and shall give the parties not less than ten days' notice of such hearing.
(6) The procedure specified in sub-rules (2) to (5) of rule 62, shall, so far as may be, apply to the procedure for hearing under this rule as they apply to the hearing in opposition proceedings.

Rule 100. Application under section 88(4).-

(1) An application under sub-section (4) of section 88 for the revision of the terms and conditions of a licence which have been settled by the Controller shall be in Form 20 and shall state the facts relied upon by the applicant and the relief he seeks and shall be accompanied by evidence in support of the application.
(2) If the Controller is satisfied that a prima facie case has not been made out for the revision of the terms and conditions of the licence, he may notify the applicant accordingly and unless within a month the applicant requests to be heard in the matter, the Controller may refuse the application.
(3) The Controller, after giving the applicant an opportunity of being heard, shall determine whether the application shall be proceeded with or whether the application shall be refused.

Rule 101. Procedure to be followed in case of applications under section 88(4).-

(1) If the Controller allows the application to be proceeded with, he shall direct the applicant to serve copies of the application and of the evidence in support thereof upon the patentee or any other person appearing in the register to be interested in the patent or upon any other person on whom, in his opinion such copies should be so served.
(2) The applicant shall inform the Controller the date on which the service of copies of application and of the evidence on the patentee and other persons referred to in sub-rule (1) has been effected.

(3) The patentee or any other person on whom copies of the application and of the evidence have been served, may give to the Controller notice of opposition in Form 14 within one month from the date of such service. Such notice shall contain the grounds relied upon by the opponent and shall be accompanied by evidence in support of the opposition.

(4) The opponent shall serve copies of the notice of opposition and his evidence on the applicant and inform the Controller the date on which such service has been effected.

(5) No further evidence or statement shall be filed by either party except with special leave of or on requisition by the Controller.

(6) On completion of the above proceedings, the Controller shall forthwith fix a date and the time for the hearing of the case and shall give the parties not less than ten days' notice of such hearing.

(7) The procedure specified in sub-rules (2) to (5) of rule 62 shall, so far as may be, apply to the procedure for hearing under this rule as they apply to the hearing in opposition proceedings.

(8) If the Controller decides to revise the terms and conditions of licence he shall forthwith amend the licence granted to the applicant in such manner, as he may deem necessary.

Rule 102. Application for termination of compulsory licence under section 94.-

(1) An application for termination of compulsory licence under section 94(1) shall be made in Form 21 by the patentee or any other person deriving title or interest in the patent. The application shall be accompanied by the evidence in support of the application.

(2) The applicant shall serve a copy of the application and evidence on the holder of the compulsory licence and shall inform the Controller the date on which the service has been effected.

(3) The holder of the compulsory licence may file his objection along with evidence, if any, to the application within one month from the date of receipt of the application and evidence by him to the Controller and serve a copy thereof to the applicant.

(4) No further evidence or statement shall be filed by either party except with special leave of or on requisition by the Controller.

(5) On completion of the above proceedings, the Controller shall forthwith fix a date and the time for the hearing of the case and shall give the parties not less than ten day's notice of such hearing.

(6) The procedure specified in sub-rules (2) to (5) of rule 62 so far as may be, apply to the procedure for hearing under this rule as they apply to the hearing in opposition proceedings.

(7) If the Controller decides to terminate the compulsory licence he shall forthwith issue an order giving terms and conditions, if any, of such termination and serve copies of the order to both the parties.
18.1 Working Of Patented Invention:

18.1.1 Patents are granted for the purpose of encouraging inventions, which will enhance industrial development and, therefore, should be worked in its fullest extent within the territory of India. Section 83 of the Patents Act clearly mentions that the patents are granted to encourage inventions and to secure that the inventions are worked in India on a commercial scale and to the fullest extent reasonably practicable without undue delay.

18.1.2 The Controller has the power to call for the information such as periodical statements as to the extent to which the patented invention has been commercially worked in India, as may be specified in the notice issued to that effect at any time during the continuance of the patent (S.146(1))

18.1.3 A patentee or a licensee should furnish such information to him within two months from the date of such notice or within such further time as the Controller may allow. (S 146(1)).

18.1.4 The patentee and every licensee should furnish the details of working of the invention in Form 27 in respect of every calendar year within three months of the end of each year and within two months whenever required by the Controller [ S. 146(2), R.131(2)]

18.1.5 Failure to supply such information under section 146 is punishable with fine which may extend to ten lakh rupees S. 122(1) (b)

18.1.6 If the information or statement so furnished is false and which he either knows or has a reason to believe to be false or does not believe to be true, there is a punishment [S. 122(2)] with imprisonment up to six months, or with fine, or both.

18.1.7 In the matter of Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries [1978] INSC 255 (13 December 1978) it was observed by the supreme court that the object of Patent Law is to encourage scientific research, new technology and industrial progress. Grant of exclusive privilege to own, use or sell the method or the product patented for a limited period, stimulates new inventions of commercial utility. The price of the grant of the monopoly is the disclosure of the invention at the Patent Office, which after the expiry of the fixed period of the monopoly, passes into the public domain.

18.2 Compulsory Licences

Compulsory licences are available as a remedy against abuse of patent right, not working of patent and to address the public health concern in India.
General Principles:

18.2.1. The provisions for compulsory licences are made to prevent the abuse of patent as a monopoly and to make the way for commercial exploitation of the patented invention by an interested person.

18.2.2 Any person interested can make an application to the Controller for grant of compulsory licence for a patent after three years from the “date of grant” of that patent, if the
a) reasonable requirement of public have not been satisfied or
b) it is not available to the public at affordable price or
c) if the patented invention is not worked in India. .

The request for grant of a compulsory licence can also be made by a licensee of the patent [S.84 (2)].

18.2.3 The Controller exercises the power to grant a compulsory licence for the following general purposes—

(a) that patented inventions are worked on a commercial scale in the territory of India without undue delay and to the fullest extent that is reasonably practicable;
(b) that the interests of any person for the time being working or developing an invention in the territory of India under the protection of a patent are not unfairly prejudiced.

18.2.4 While considering the application for compulsory licence, the Controller takes into account—

(a) Nature of the invention, such as complexity of the technology;
(b) Time which has elapsed since the grant of the patent i.e. whether the working of the invention was so difficult that the patentee despite his best efforts could not work it out properly before the application of the compulsory license was filed to the patent office;
(c) The measures already taken by the patentees or any licensee to make full use of the invention;
(d) Ability of the applicant to work the invention to the public advantage;
(e) Capacity of the applicant to undertake the risk in providing capital and working the invention, if application were granted;
(f) Whether the applicant has made efforts to obtain a licence from the patentee on reasonable terms and conditions and whether such efforts have not been successful within a reasonable period construed as a period not ordinarily exceeding a period of 6 months as the Controller may deem fit (S. 84(6));

18.2.5 Except in the case of an application made by the Central Government, the application shall set out the nature of the applicant’s interest, facts upon which the application is based and the terms and condition of the license the applicant is willing to accept.
18.2.6 Grounds for Grant of Compulsory Licence : -

i) The reasonable requirements of the public with respect to the patented invention have not been satisfied,

ii) The patented invention is not available to the public at a reasonably affordable price,

iii) The patented invention is not worked in the territory of India.

(1) The Controller, if satisfied that any of the grounds exists to grant compulsory licence, may grant a license upon such terms as he may deem fit.

(2) The provision for compulsory licensing serves a very useful purpose to meet the public requirement by virtue of arising of any of the above conditions set for compulsory licensing.

(3) Failure to make patented inventions available to public at a reasonable price has to be considered keeping in mind that the reasonable price for a patented article will depend upon the circumstances of each case.

(4) Failure to work the patented invention within the territory of India will be considered with respect to the facility available in India for the working of the invention. Provision of importation of patented article is allowed. But the mere importation of patented articles when there is a possibility of manufacturing within India will be a factor that will receive consideration.

(5) Reasonable requirements of the public will be deemed as not satisfied if by reason of the refusal of the patentee to grant a licence on reasonable terms, an existing trade or industry or the development thereof or the establishment of any new trade or industry in India or the trade or industry of any person or class of persons trading or manufacturing in India is prejudiced. Other conditions mentioned in S. 84 (7).

18.2.7 Revocation of Patent for Non-working (S. 85)

(1) Where the compulsory licence for patent has been granted, an application for revocation of such patent may be made to the Controller, either by the Central Government or any person interested after expiry of 2 years period from the date of order granting the first compulsory license.

(2) The application shall be in Form 19 with the prescribed fee as given in first schedule.

(3) Every such application shall be decided within one year of its being presented to the Controller.

(4) If the Controller is satisfied that the reasonable requirements of the public have not been satisfied or that the patented invention has not been worked in the territory of India or that the patented invention is not
available to the public at a reasonably affordable price, he may make an order revoking the patent.

(5) The Controller shall publish the order made by him under section 85(3) revoking a patent in the official journal.

18.2.8 The Controller has power to adjourn an application for compulsory licence to allow sufficient time for working [section 86 (1)] to decide upon -

(i) The ability of a potential licensee (the applicant) to work the invention to the public advantage and his capacity to undertake the risk in providing the capital and working the invention.

(ii) Whether the applicant has made any efforts to obtain voluntary licence from the patentee.

This will demonstrate the intention of the person who is seeking license, that he is really interested in manufacturing the product which is protected under the patent. It is to be noted that this provision will not apply in case of national emergency.

18.2.9 Procedure for grant of compulsory licence

i) An application for compulsory license shall be filed in Form 17 with the prescribed fees as given in First schedule, setting out the nature of applicant’s interest, terms and conditions of the license as per section 84(7) and 90, that the applicant is willing to accept. (Rule 96)

ii) If the Controller is satisfied that the prima facie case has not been made out for the making of an order he shall notify the Central Government or any person interested accordingly, and unless the Central Government or any person interested requests to be heard in the matter, within one month of the date of such notification, the Controller shall refuse the application made for compulsory under Section 84 or for revocation of patent under Section 85.

iii) But if the applicant requests for a hearing within one month of notification the Controller shall, after giving the applicant an opportunity of being heard, determine whether the application may be proceeded with or whether it shall be refused.

iv) The Controller, upon consideration of the evidence, if satisfied that a prima facie case has been made out, as prescribed in section 87 of the Patents Act, shall direct the applicant to serve the copies of the application upon patentee and will publish the application in official journal.

v) The Patentee if he so desires, may oppose the application.

vi) Thereafter, the Controller shall order the grant of license upon such terms and conditions, as he may deem fit, keeping in view the provisions of terms and
conditions of compulsory licenses as described under section 90 of the Patents Act.

a. Then the notice of opposition under sub-section (2) of section 87 can be given in Form 14 in duplicate and shall be sent to the Controller within two months from the date of the advertisement of the application under sub-section (1) of the said section.

b. The notice of opposition should include the terms and conditions of the license, if any, the opponent is prepared to grant to the applicant and shall be accompanied by evidence in support of the opposition.

c. The opponent shall serve a copy of his notice of opposition and evidence on the applicant and notify the Controller when such service has been effected.

d. No further statement or evidence shall be delivered by either party except by leave of or on requisition by the Controller.

e. The Controller shall thereafter appoint a date and time for the hearing of the case and shall give the parties not less than ten day’s notice of such hearing whereupon he will decide the case.

18.2.10 In the case of Section 92 (1), the provisions of Section 87 will apply and the compulsory license shall be granted on such terms & conditions as the Controller think fit, securing that the articles manufactured under the patent shall be available to the public at the lowest prices, and the licensee may also export the patented product, if need be, in accordance with the provisions of section 84[7(a(iii))]

18.2.11 However, in the circumstances of National Emergency or Extreme urgency or public non-commercial use including public health crises, relating to Acquired Immuno Deficiency Syndrome, Human Immuno deficiency virus, tuberculosis, malaria or other epidemics, to avoid any delay in the procedure, provisions under section 87 will not apply [S 92(3)]. The Compulsory license will be granted, immediately under section 92 (3) also with the terms and conditions that the articles manufactured under the patent shall be available to the public at the lowest prices.

18.2.12 In the case of availability of compulsory license by way of notification by the Central Government under section 92 of the Act, an application will be filed also on form 17.

18.2.13 In the matter of invention relating to “Double shaft springy track spilkes” the applicant for compulsory license under section 84 Rail Udyog engaged in manufacturing railway coach and wagon components and track fittings. The Controller refused the opposition by Guest Keen Williams limited on the ground that the opponent failed to prove their interest in the patent. And while granting the license to the applicant the Controller issued the
Compulsory Licence stipulated therein the terms and conditions of the licence.

18.3 Section 92 A

Compulsory licence for export of patented pharmaceutical product in certain exceptional circumstances.

18.3.1 The section was introduced by The Patents (Amendment) Ordinance, 2004 which came into force on 1st January 2005, to provide for grant of compulsory licence by the Controller for export of patented pharmaceutical product in certain exceptional circumstances, where compulsory licence has been granted by the country to which the export is intended. This provision was further amended by The Patents (Amendment) Act, 2005, to allow grant of compulsory licence even in cases where the importing country has by notification or otherwise, allowed importation of patented pharmaceutical products from India.

18.3.2 The procedure for obtaining the compulsory licence is laid down in Rules  96 and Rule 97.

18.3.3 This provision is introduced to address the public health concerns of the countries having insufficient or no manufacturing capacity in the pharmaceutical sector to implement the decision of the TRIPS council on Para 6 of the Doha Declaration on TRIPS Agreement and Public Health. This section lays down the conditions that are required to be fulfilled, when the compulsory licences for export purposes will be available. The compulsory licence is available only for
(a) The patented pharmaceutical product
(b) Manufacture and export to any country having insufficient or no manufacturing capacity in the pharmaceutical sector
(c) The product addressing the public health problems in such country.

18.3.4 The explanation under this section technically defines the scope of the pharmaceutical product that comes under the purview of this section. The pharmaceutical product covered under this section is any patented product or product manufacture by a patented process including all such ingredients that are necessary for manufacturing of such products. The diagnostic kits required for the use of the patented product are also covered.

18.3.5 The product on which the applicant has either obtained the compulsory licence from importing country or the importing country has by notification or otherwise, has allowed Importation of patented pharmaceutical products from India.

18.3.6 The application for compulsory licence shall be filed in the office where patent has been granted. This application shall be made on Form 17. The applicant shall give the ground relied on for making the application. He shall also specify the nature of his interest and the terms and conditions of the licence he is willing to accept. This condition is not applicable, where the application is made by the Central Government.
18.3.7 The applicant shall furnish the certified copies of the documents giving details of documentary evidence in support of his interest and the ground on which the application is made. Fee for filing this application Rs. 1500/- for natural person and Rs. 6000/- for other than natural person either alone or jointly with natural person.

18.3.8 The Controller shall ascertain whether a case is made out or not for grant of compulsory licence.

18.4 Where on consideration of the evidence the Controller is satisfied that the prima facie case has been made out he shall proceed to pass an order for grant of compulsory licence with following terms and conditions:

i. Specify the product for which the licence has been granted.
ii. Specify the quantity of product to be exported based on the need of the importing country.
iii. Specify the distinguishing feature of the product and/or packages:
    The distinguishing feature of the product may be colour/shaping of the product or packages provided the Controller shall take into consideration that there is no significant impact on price.
iv. Specify the importing country and the quantity to be supplied to each country.
v. Specify the remuneration to be paid to the patentee: The Controller determines the remuneration taking into account the economic value to the country of the use that has been authorised by the Controller.
vi. The Controller shall direct the licensee to post the information relating to the quantity of the product supplied under licence to each destination with its distinguishing features on the website before the commencement of the shipment.

The Controller then publishes the following information in the official journal:

(i) Patent number
(ii) Name and address of the licensee
(iii) Quantity allowed for manufacture and export
(iv) List of the countries and the quantity to be supplied to each country.
(v) Duration of the licence.

18.5 If the prima facie case is not made out

18.5.1 Where on consideration of the evidence the Controller is satisfied that the prima facie case has not been made out he shall proceed as per the provision of rule 97

18.5.2 The procedure for dealing with the cases where the prima facie case is not made out is given in rule 97(1). According to this rule the Controller is required to notify the applicant that a prima facie case has not been made out and if the applicant so desires he may request the Controller for hearing before the Controller within one month from the date of issue of a notification. If the
applicant fails to make such a request within the specified time the Controller shall refuse the application.

18.5.3 Where the applicant make a request to the Controller for hearing, the Controller shall proceed as per the provisions of rule 97(2) and hear the applicant and pass an order for grant of licence or refusal of licence depending on the merits of the case.

18.5.4 This provision provide that the grant of compulsory licence under section 92A (1) and section 92 A(2) has no effect on the compulsory licence granted under other provisions of the Patents Act.

18.5.5 In case of compulsory license for export of patented pharmaceutical products to any country having insufficient or not manufacturing capacity to address public health problem, the application will also have to be made on form 17, and the compulsory license will be granted, immediately under Section 92 A of the Act.

18.6 Revision of grant of compulsory licence

18.6.1 An application under sub-section (4) of section 88 for the revision of the terms and conditions of a license, which have been settled by the Controller, shall be in form 20 along with the prescribed fee as given in first schedule, in duplicate, and shall state the facts relied upon by the applicant and the relief he seeks and shall be accompanied by evidence in support of the application. Such application can be made only after twelve months from the compulsory licensee has started working the invention.

18.6.2 If the Controller is satisfied that a prima facie case has not been made out of the revision of the terms and conditions of the license, he may notify the applicant accordingly and, unless within a month the applicant requests to be heard in the matter, the Controller may refuse the application (R.97(1)).

18.6.3 The Controller after giving the applicant an opportunity of being heard shall determine whether the application shall be proceeded with or whether the application shall be refused (R.97(2)).

18.6.4 If the Controller allows the application to be proceeded with, he shall direct the applicant to serve copies of the application and of the evidence in support thereof upon the patentee or any other person appearing in the register to be interested in the patent or upon any other person on whom, in his opinion, such copies should be so served [S. 87, R 98(2)].

18.6.5 The applicant shall inform the Controller the date on which the service of copies of application and of the evidence on the patentee and other persons referred to in (d) above has been effected [R.98(3)].

18.6.6 The patentee or any other person on whom copies of the application and of the evidence have been served, may give to the Controller notice of opposition in Form 14, in duplicate, within 1 month from the date of such service. Such
notice shall contain the grounds relied upon by the opponent and shall be accompanied by evidence in support of the opposition [R. 98(1)].

18.6.7 The opponent shall serve copies of the notice of opposition and his evidence on the applicant and inform the Controller the date on which such service has been effected [R. 98(3)].

18.6.8 No further evidence or statement shall be filed by either party without special leave of or on requisition by the Controller [R. 98(4)].

18.6.9 On completion of the above proceedings or at such other time as he may deemed fit, the Controller shall appoint a date and the time for the hearing of the case and shall give the parties not less than 10 days notice of such hearing [R. 98(5)].

18.6.10 If the Controller decides to revise the terms and conditions of license he shall amend the license granted to the applicant in such manner as he may deem necessary [S. 88(4)].

**TIME-LINES FOR COMPULSORY LICENSES**

<table>
<thead>
<tr>
<th>Section</th>
<th>Application</th>
<th>Application / prima facie case</th>
<th>Notification of filing of application by Controller</th>
<th>Opposition within 2 months from notification</th>
<th>Hearing &amp; decision</th>
<th>Total time</th>
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<td>3 years after grant</td>
<td>1 month</td>
<td>10 days</td>
<td>2 months</td>
<td>1 month</td>
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<td>92</td>
<td>Any time after grant</td>
<td>Of availability of Patent for Compulsory Licence by Central Government</td>
<td>92(1) (i) &amp; (ii) within 2 months (Rule 98) from notification for settlement of terms &amp; conditions</td>
<td>2 months</td>
<td>1 month</td>
<td>3 months</td>
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CHAPTER XIX

USE OF INVENTIONS FOR PURPOSES OF GOVERNMENT AND ACQUISITION OF INVENTIONS BY CENTRAL GOVERNMENT

Section 99. Meaning of use of invention for purposes of Government.-

(i) For the purposes of this Chapter, an invention is said to be used for the purposes of Government if it is made, used, exercised or vended for the purposes of the Central Government, a State Government or a Government undertaking.

(ii) Omitted by Act 38 of 2002

(iii) Nothing contained in this Chapter shall apply in respect of any such importation, making or using of any machine, apparatus or other article or of any such using of any process or of any such importation, using or distribution of any medicine or drug, as may be made by virtue of one or more of the conditions specified in section 47.

Section 100. Power of Central Government to use inventions for purposes of Government.-

(1) Notwithstanding anything contained in this Act, at any time after an application for a patent has been filed at the patent office or a patent has been granted, the Central Government and any person authorised in writing by it, may use the invention for the purposes of Government in accordance with the provisions of this Chapter.

(2) Where an invention has, before the priority date of the relevant claim of the complete specification, been duly recorded in a document, or tested or tried, by or on behalf of the Government or a Government undertaking, otherwise than in consequence of the communication of the invention directly or indirectly by the patentee or by a person from whom he derives title, any use of the invention by the Central Government or any person authorised in writing by it for the purposes of Government may be made free of any royalty or other remuneration to the patentee.

(3) If and so far as the invention has not been so recorded or tried or tested as aforesaid, any use of the invention made by the Central Government or any person authorised by it under sub-section (1), at any time after grant of the patent or in consequence of any such communication as aforesaid, shall be made upon terms as may be agreed upon either before or after the use, between the Central Government or any person authorised under sub-section (1) and the patentee, or, as may in default of agreement be determined by the High Court on a reference under section 103:
Provided that in case of any such use of any patent, the patentee shall be paid not more than adequate remuneration in the circumstances of each case, taking into account the economic value of the use of the patent.

(4) The authorisation by the Central Government in respect of an invention may be given under this section, either before or after the patent is granted and either before or after the acts in respect of which such authorisation is given or done, and may be given to any person whether or not he is authorised directly or indirectly by the applicant or the patentee to make, use, exercise or vend the invention or import the machine, apparatus or other article or medicine or drug covered by such patent.

(5) Where an invention has been used by or with the authority of the Central Government for the purposes of Government under this section, then, except in case of national emergency or other circumstances of extreme urgency or for non-commercial use, the Government shall notify the patentee as soon as practicable of the fact and furnish him with such information as to the extent of the use of the invention as he may, from time to time, reasonably require; and where the invention has been used for the purposes of a Government undertaking, the Central Government may call for such information as may be necessary for this purpose from such undertaking.

(6) The right to make, use, exercise and vend an invention for the purposes of Government under sub-section (1) shall include the right to sell on non-commercial basis, the goods have been made in exercise of that right, and a purchaser of goods so sold, and a person claiming through him, shall have the power to deal with the goods as if the Central Government or the person authorised under sub-section (1) were the patentee of the invention.

(7) Where in respect of a patent which has been the subject of an authorisation under this section, there is an exclusive licensee as is referred to in sub-section (3) of section 101, or where such patent has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention (including payments by way of minimum royalty), the notice directed to be given under sub-section (5) shall also be given to such exclusive licensee or assignor, as the case may be, and the reference to the patentee in sub-section (3) shall be deemed to include a reference to such assignor or exclusive licensee.

Section 101. Rights of third parties in respect of use of invention for purposes of Government.-

(1) In relation to any use of a patented invention, or an invention in respect of which an application for a patent is pending, made for the purposes of Government—

(a) by the Central Government or any person authorised by the Central Government under section 100; or
(b) by the patentee or applicant for the patent to the order made by the Central Government,

the provisions of any licence, assignment or agreement granted or made, between the patentee or applicant for the patent (or any person who derives title for him or from whom he derives title) and any person other than the Central Government shall be of no effect so far as those provisions—

(i) restrict or regulate the use for the purposes of Government of the invention, or of any model document or information relating thereto, or

(ii) provide for the making of payments in respect of any use of the invention or of the model, document or information relating thereto for the purposes of Government,

and the reproduction or publication of any model or document in connection with the said use for the purposes of Government shall not be deemed to be an infringement of any copyright subsisting in the model or document.

(2) Where the patent, or the right to apply for or obtain the patent, has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention, then, in relation to any use of the invention made for the purposes of Government by the patentee to the order of the Central Government, sub-section (3) of section 100 shall have effect as if that use were made by virtue of an authority given under that section; and use of the invention for the purposes of Government by virtue of sub-section (3) of that section shall have effect as if the reference to the patentee included a reference to the assignor of the patent, and any sum payable by virtue of that sub-section shall be divided between the patentee and the assignor in such proportion as may be agreed upon between them or as may in default of agreement be determined by the High Court on a reference under section 103.

(3) Where by virtue of sub-section (3) of section 100, payments are required to be made by the Central Government or persons authorised under sub-section (1) of that section in respect of the use of an invention for the purposes of Government and where in respect of such patent there is an exclusive licensee authorised under his licence to use the invention for the purposes of Government, such sum shall be shared by the patentee and such licensee in such proportions, if any, as may be agreed upon between them or as may in default of agreement be determined by the High Court on a reference under section 103 to be just, having regard to any expenditure incurred by the licensee—

(a) in developing the said invention; or

(b) in making payments to the patentees other than royalties or other benefits determined by reference to the use of the invention in consideration of the licence.

Section 102. Acquisition of inventions and patents by the Central Government—
(1) The Central Government may, if satisfied that it is necessary that an invention which is the subject of an application for a patent or a patent should be acquired from the applicant or the patentee for a public purpose, publish a notification to that effect in the Official Gazette, and thereupon the invention or patent and all rights in respect of the invention or patent shall, by force of this section, stand transferred to and be vested in the Central Government.

(2) Notice of the acquisition shall be given to the applicant, and, where a patent has been granted, to the patentee and other persons, if any, appearing in the register as having an interest in the patent.

(3) The Central Government shall pay to the applicant, or, as the case may be, the patentee and other persons appearing on the register as having an interest in the patent such compensation as may be agreed upon between the Central Government and the applicant, or the patentee and other persons; or, as may, in default of agreement, be determined by the High Court on a reference under section 103 to be just having regard to the expenditure incurred in connection with the invention and, in the case of a patent, the term thereof, the period during which and the manner in which it has already been worked (including the profits made during such period by the patentee or by his licensee whether exclusive or otherwise) and other relevant factors.

Section 103. Reference to High Court of disputes as to use for purposes of Government.—

(1) Any dispute as to the exercise by the Central Government or a person authorised by it of the powers conferred by section 100, or as to terms for the use of an invention for the purposes of Government thereunder or as to the right of any person to receive any part of a payment made in pursuance of sub-section (3) of that section or as to the amount of compensation payable for the acquisition of an invention or a patent under section 102, may be referred to the High Court by either party to the dispute in such manner as may be prescribed by the rules of the High Court.

(2) In any proceedings under this section to which the Central Government is a party, the Central Government may,—

   a) if the patentee is a party to the proceedings, petition by way of counter-claim for revocation of the patent on any ground upon which a patent may be revoked under section 64; and

   b) whether a patentee is or is not a party to the proceedings, put in issue the validity of the patent without petitioning for its revocation.

(3) If in such proceedings as aforesaid any question arises whether an invention has been recorded, tested or tried as is mentioned in section 100, and the disclosure of any document regarding the invention, or of any evidence of the test or trial thereof, would, in the opinion of the Central Government, be prejudicial to the public interest, the disclosure may be made confidentially to the advocate of the other party or to an independent expert mutually agreed upon.
(4) In determining under this section any dispute between the Central Government and any person as to terms for the use of an invention for the purposes of Government, the High Court shall have regard to any benefit or compensation which that person or any person from whom he derives title, may have received, or may be entitled to receive, directly or indirectly in respect of the use of the invention in question for the purposes of Government.

(5) In any proceedings under this section, the High Court may at any time order the whole proceedings or any question or issue of fact arising therein to be referred to an official referee, commissioner or an arbitrator on such terms as the High Court may direct, and references to the High Court in the foregoing provisions of this section shall be construed accordingly.

(6) Where the invention claimed in a patent was made by a person who at the time it was made was in the service of the Central Government or of a State Government or was an employee of a Government undertaking and the subject-matter of the invention is certified by the relevant Government or the principal officer of the Government undertaking to be connected with the work done in the course of the normal duties of the Government servant or employee of the Government undertaking, then, notwithstanding anything contained in this section, any dispute of the nature referred to in sub-section (1) relating to the invention shall be disposed of by the Central Government conformably to the provisions of this section so far as may be applicable, but before doing so the Central Government shall give an opportunity to the patentee and such other parties as it considers have an interest in the matter to be heard.

19.1 Use Of Patent For The Purpose Of Government

19.1.1 Anytime after filing or grant of patent, the Government or any person authorized by it can use the patented invention for the purpose of Government (S.99 to S.103)

19.1.2 If an invention is used before the priority date of the relevant claim of complete specification by the Government or any person authorized by it for the purpose of Government, then no royalty or remuneration need to be paid to the patentee (S. 100(2)).

19.1.3 If an invention is to be used at any time after the grant of patent by the Government or any person authorized by it for the purpose of Government, then that use should be made only on terms agreed between the Government or any person authorized and the patentee or in default of agreement will be decided by High Court (section 100(3)).

19.1.4 The Government can authorize any person in respect of an invention either before or after the grant, whether or not the patentee authorizes that person.

19.1.5 Where the Government authorizes any person for using an invention for Government purposes then, unless it is contrary to the public interest, the Central Government shall inform the patentee from time to time, the extent of use of the invention for the purpose of Government. In case of use by a Government
undertaking, then the Government may call for such information from the undertaking.

19.1.6 The right to use the invention for the purpose of Government includes the right to sell the goods and the purchaser has the power to deal with the goods as if the Government or the person authorized were the patentee of the invention.

19.1.7 In case of an exclusive licensee as per section 101 (3) or an assignor, the Central Government should also inform the exclusive licensee or assignor as the case may be, regarding the extent of use of invention for the purpose of Government.

19.1.8 In respect of an invention used by the Government for the purpose of Government, any agreement, license of assignment etc. between the patentee or applicant and any person, other than the Government, shall have no effect if the agreement restricts the use for the purpose of Government or instructs any payment in respect of any use for the purpose of Government.

19.1.9 In relation to any use of the invention made for the purpose of Government by the patentee to the order of Central Government any sum payable by virtue of section 100 (3) shall be divided between the patentee and the assignor in such proportion as may be agreed or in default be decided by high Court under section 103.

19.1.10 In case there is an exclusive licensee authorized under his license to use the invention for the purpose of Government the patentee shall share any payment and such licensee in such proportion as agreed upon or in default is decided by High Court under section 103.

19.1.11 If necessary central Government can acquire an invention from the applicant or patentee for a public purpose, by publishing a notification to that effect in the Official Gazette.

19.1.12 Notice of acquisition shall be given to the applicant or patentee as the case may be and other persons appearing in the register as having interest in that patent.

19.1.13 Compensation should be given by the Central Government to the concerned person as agreed upon between them or in default be determined by High Court under Section 103.

19.1.14 Any dispute arising out of use of an invention by the Central Government for the purpose of Government may be referred to the High Court by either party to the dispute in such manner as may be prescribed by the rules of High Court. The Government may ask for revocation of a patent or raise an issue regarding the validity of the patent. In case the Government thinks disclosure of any document regarding the invention be prejudicial to the public interest, then the Government can disclose confidentially to the advocate of other party in any proceeding at any time at the High Court.
Chapter XX

Suits Concerning Infringement of Patents

Section 104. Jurisdiction.—

No suit for a declaration under section 105 or for any relief under section 106 or for infringement of a patent shall be instituted in any court inferior to a district court having jurisdiction to try the suit:

Provided that where a counter-claim for revocation of the patent is made by the defendant, the suit, along with the counter-claim, shall be transferred to the High Court for decision.

Section 104. Burden of proof in case of suits concerning infringement.—

(1) In any suit for infringement of a patent, where the subject matter of patent is a process for obtaining a product, the court may direct the defendant to prove that the process used by him to obtain the product, identical to the product of the patented process, is different from the patented process if,—

(a) the subject matter of the patent is a process for obtaining a new product; or

(b) there is a substantial likelihood that the identical product is made by the process, and the patentee or a person deriving title or interest in the patent from him, has been unable through reasonable efforts to determine the process actually used:

Provided that the patentee or a person deriving title or interest in the patent from him first proves that the product is identical to the product directly obtained by the patented process.

(2) In considering whether a party has discharged the burden imposed upon him by sub-section (1), the court shall not require him to disclose any manufacturing or commercial secrets, if it appears to the court that it would be unreasonable to do so.

Section 105. Power of court to make declaration as to non-infringement.—

(1) Notwithstanding anything contained in section 34 of the Specific Relief Act, 1963 (47 of 1963), any person may institute a suit for a declaration that the use by him of any process, or the making, use or sale of any article by him does not, or would not, constitute an infringement of a claim of a patent against the patentee or the holder of an exclusive licence under the patent, notwithstanding that no assertion to the contrary has been made by the patentee or the licensee, if it is shown—

(a) that the plaintiff has applied in writing to the patentee or exclusive licensee for a written acknowledgements to the effect of the declaration claimed and has furnished him with full particulars in writing of the process or article in question; and
(b) that the patentee or licensee has refused or neglected to give such an acknowledgement.

(2) The costs of all parties in a suit for a declaration brought by virtue of this section shall, unless for special reasons the court thinks fit to order otherwise, be paid by the plaintiff.

(3) The validity of a claim of the specification of a patent shall not be called in question in a suit for a declaration brought by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid or invalid.

(4) A suit for a declaration may be brought by virtue of this section at any time after the publication of grant of a patent, and references in this section to the patentee shall be construed accordingly.

Section 106. Power of court to grant relief in cases of groundless threats of infringement proceeding of-

(1) Where any person (whether entitled to or interested in a patent or an application for patent or not) threatens any other person by circulars or advertisements or by communications, oral or in writing addressed to that or any other person, with proceedings for infringement of a patent, any person aggrieved thereby may bring a suit against him praying for the following reliefs, that is to say—

(a) a declaration to the effect that the threats are unjustifiable;

(b) an injunction against the continuance of the threats; and

(c) such damages, if any, as he has sustained thereby.

(2) Unless in such suit the defendant proves that the acts in respect of which the proceedings were threatened constitute or, if done, would constitute, an infringement of a patent or of rights arising from the publication of a complete specification in respect of a claim of the specification not shown by the plaintiff to be invalid the court may grant to the plaintiff all or any of the reliefs prayed for.

Explanation.—A mere notification of the existence of a patent does not constitute a threat of proceeding within the meaning of this section.

Section 107. Defences, etc., in suits for infringement.—

(1) In any suit for infringement of a patent every ground on which it may be revoked under section 64 shall be available as a ground for defence.

(2) In any suit for infringement of a patent by the making, using or importation of any machine, apparatus of other article or by the using of any process or by the importation, use or distribution of any medicine or drug, it shall be a ground for defence that such making, using, importation or distribution is in accordance with any one or more of the conditions specified in section 47.

Section 107A. Certain acts not to be considered as infringement.—
For the purposes of this Act,—
(a) any act of making, constructing, using, selling or importing a patented invention solely for uses reasonably related to the development and submission of information required under any law for the time being in force, in India, or in a country other than India, that regulates the manufacture, construction, use, sale or import of any product;

(b) importation of patented products by any person from a person who is duly authorised under the law to produce and sell or distribute the product,

shall not be considered as a infringement of patent rights.

Section 108. Reliefs in suit for infringement.—

(1) The reliefs which a court may grant in any suit for infringement include an injunction (subject to such terms, if any, as the court thinks fit) and, at the option of the plaintiff, either damages or an account of profits.

(2) The court may also order that the goods which are found to be infringing and materials and implements, the predominant use of which is in the creation of infringing goods shall be seized, forfeited or destroyed, as the court deems fit under the circumstances of the case without payment of any compensation.

Section 109. Right of exclusive licensee to take proceedings against infringement.—

(1) The holder of an exclusive licence shall have the like right as the patentee to institute a suit in respect of any infringement of the patent committed after the date of the licence, and in awarding damages or an account of profits or granting any other relief in any such suit the court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such or, as the case may be, the profits earned by means of the infringement so far as it constitutes an infringement of the rights of the exclusive licensee as such.

(2) In any suit for infringement of a patent by the holder of an exclusive licence under sub-section (1), the patentee shall, unless he has joined as a plaintiff in the suit, be added as a defendant, but a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

Section 110. Right of licensee under section 84 to take proceedings against infringement.—

Any person to whom a licence has been granted under section 84 shall be entitled to call upon the patentee to take proceedings to prevent any infringement of the patent, and, if the patentee refuses or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as though he were the patentee, making the patentee a defendant; but a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

Section 111. Restriction on power of court to grant damages or account of profits for infringement.—
(1) In a suit for infringement of patent, damages or an account of profits shall not be granted against the defendant who proves that at the date of the infringement he was not aware and had no reasonable grounds for believing that the patent existed.

Explanation.—A person shall not be deemed to have been aware or to have had reasonable grounds for believing that a patent exists by reason only of the application to an article of the word "patent", "patented" or any word or words expressing or implying that a patent has been obtained for the article, unless the number of the patent accompanies the word or words in question.

(2) In any suit for infringement of a patent the court may, if it thinks fit, refuse to grant any damages or an account of profits in respect of any infringement committed after a failure to pay any renewal fee with the prescribed period and before any extension of that period.

(3) Where an amendment of a specification by way of disclaimer, correction or explanation has been allowed under this Act after the publication of the specification, no damages or account of profits shall be granted in any proceeding in respect of the use of the invention before the date of the decision allowing the amendment, unless the court is satisfied that the specification as originally published was framed in good faith and with reasonable skill and knowledge.

(4) Nothing in this section shall affect the power of the court to grant an injunction in any suit for infringement of a patent.

Section 112. Restriction on power of court to grant injunction in certain cases.—
[Omitted by Act 38 of 2002.]

Section 113. Certificate of validity of specification and costs of subsequent suits for infringement thereof—

(1) If in any proceedings before the Appellate Board or a High Court for the revocation of a patent under section 64 and section 104, as the case may be, the validity of any claim of a specification is contested and that claim is found by the Appellate Board or the High Court to be valid, the Appellate Board or the High Court may certify that the validity of that claim was contested in those proceedings and was upheld.

(2) Where any such certificate has been granted, then, if in any subsequent suit before a court for infringement of that claim of the patent or in any subsequent proceeding for revocation of the patent in so far as it relates to that claim, the patentee or other person relying on the validity of the claim obtains a final order or judgment in his favour, he shall be entitled to an order for the payment of his full costs, charges and expenses of and incidental to any such suit or proceeding properly incurred so far as they concern the claim in respect of which the certificate was granted, unless the court trying the suit or proceeding otherwise directs:

Provided that the costs as specific in this sub-section shall not be ordered when the party disputing the validity of the claim satisfies the court that he was not aware of the grant of the certificate when he raised the dispute and withdrew forthwith such defence when he became aware of such a certificate.

(4) Nothing contained in this section shall be construed as authorising the courts or the Appellate Board hearing appeals from decrees or orders in suits for infringement or petitions for revocation, as the case may be, to pass orders for costs on the scale referred to therein.

Section 114. Relief for infringement of partially valid specification.—
(1) If in proceedings for infringement of a patent it is found that any claim of the specification, being a claim in respect of which infringement is alleged, is valid, but that any other claim is invalid, the court may grant relief in respect of any valid claim which is infringed:

Provided that the court shall not grant relief except by way of injunction save in the circumstances mentioned in sub-section (2).

(3) Where the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the court shall grant relief in respect of any valid claim which is infringed subject to the discretion of the court as to costs and as to the date from which damages or an account of profits should be reckoned, and in exercising such discretion the court may take into consideration the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there.

20.1 Action Against Infringement (S. 104)

20.1.1 If at any time the patentee finds that somebody is infringing his patent rights he should inform him in writing that his patent rights are being infringed by his commercial working of the same or related invention. The two parties can amicably settle the problem by licensing etc. But if such settlement by way of arbitration etc. could not be made and the infringement continued, the patentee can sue the infringer.

20.1.2 The Indian Limitations Act governs the period of limitation for bringing a suit for infringement of patent, which is three years from the date of infringement. The limitation period for the suit, therefore, runs from the date of infringing act and not from the date of the grant.

20.1.3 The term suit is not defined in the act and its meaning is given under the code of civil procedure 1908. A suit for infringement has to be filed in a district court having jurisdiction to try the suit, the jurisdiction is governed by the C.P.C. the cause of action must have arisen in a place within the jurisdiction of the court where the suit is to be filed. Where the defendant counter claims revocation of the patent the suit along with the counter claim will be transferred to the High Court.

20.1.4 This means the case will "stand transferred" in such cases i.e. the District Judge is left with no jurisdiction to buy so as to make such order to secure the physical transfer of the records of the case in the High Court. A suit for infringement filed before a court where the defendant has pleaded invalidity is maintainable even if petition of revocation is pending before another court.

20.2 Reversal Of Burden Of Proof In Certain Cases [S. 104(A)]

20.2.1 In any suit for infringement of a patent, where the subject matter of patent is a process for obtaining a new product or there is substantial likelihood that the identical product is made by the patented process and the patentee could not establish through reasonable efforts to determine the process actually used by the infringer, the court may direct the defendant to prove that the process used by him to obtain the product, identical to the product of the patented process, is different from the patented process, provided that the Patentee or a person
deriving title or interest in the patent from him, first proves that the product is identical to the product directly obtained by the patented process. In considering whether a party has discharged the burden imposed upon him by sub-section (1) of S.104(A), the Court shall not require, him to disclose any manufacturing or commercial secrets, if it appears to the court that it would be unreasonable to do so. In a suit for infringement under Sec. 104, the defendant of counter-claim for revocation of a Patent may revoke a Patent without any separate petition for revocation.

20.2.2 In the matter of Bilcare Ltd. v. M/s The supreme Industries Ltd. with Bilcare Ltd. v. M/s Associated Capsules Pvt. Ltd., Delhi High court held The patent in question is new one. It was registered in the year 2004 The appellants filed the suit in the year 2006, i.e. after the lapse of two years only. It can not be said to be sufficiently old. There are no conflicts on the point that the patent is less than six years old. Secondly, there are tangible grounds for suspicion of the alleged invention. The trial court has meticulously checked the record with precision and clarity. All the three essential conditions viz, prima facie case, balance of convenience and irreparable loss lean on the side of the respondents Appeal being merit-less is dismissed.

20.2.3 In the matter of Lallu Bhai Chaku Bhai Jariwala v. Chimanlal & Co. AIR 1936 BOM.99 the court held that Pressure is an essential part of invented process; its absence from the defendants’ process would constitute a material difference. The use of pressure by the defendant in their process have not been satisfactorily proved and therefore, is no infringement of the combination.

20.2.4 The buying of parts of machines from license dealers and putting them together and the buying of whole machines from unlicensed dealers are acts constituting infringement (Lala Ganga Mal v. Walter Thomson & James Mylne 115 P.R. 1889).

20.2.5 A patent for a combination for some process gives protection to each part thereof which is new and material for that process (W. Butler v. Adamji Bahura A.W.N. 1903, 193.)

20.2.6 In an infringement suit, if the defendant is found to have taken the pit and marrow of the plaintiffs patent, the defendant is held to be guilty of infringement of the patent. Variations which merely serve as a screen to conceal the actual infringement cannot protect the defendant. (Thakur Rajendra Singh and others v. Sheo Ratan Singh Court of 1st Addl. Dist., Judge of Barabanki (1924). Re. Patent No. 1143/13.

20.2.7 In a patent action, the plaintiff has got to prove that his process has been counterfeited or imitated by the defendant. It is necessary for him to give particulars of the breaches constituting the alleged infringement of his patents rights. (Lallubhai Chakubhai v. Chimanlal Chunilal & Co. 37 Bom L.R. 665).
20.2.8 An assignee of a patent who has not registered the assignment under section 63 is
not a patentee within the meaning of the Act; he has, therefore, no right to bring
any suit for infringement of the patent. (In Re. Hiralal Banjara A.I.R. 1937 Cal.
365).

20.2.9 Where in a suit for damage for infringement of patent the defendant denies that
the plaintiff was the true inventor of the patent he should give the particulars
as to whom he alleges to be the true and first inventor. (Gillette Industries Ltd., v. Yeshwant Bros. A.I.R. 1938 Bom 347).

20.2.10 The question of infringement is one which the Controller cannot investigate
under the provisions of Section 9. In opposition proceedings he is concerned
only to determine if an alleged invention is sufficiently differentiated from a
prior invention so that a patent may be granted. (Decision of the Deputy

20.2.11 In the matter of 1997 (17) PTC 756 (Cal) The court held that a mere arrangement or
rearrangement of known devices each functioning independently of one another in a
known way is to prima facie an invention under Section 3 of the Patent Act, 1970.
So the plea of Gillette defence can be considered in this case as it has been properly
pledied in this case. It is obvious that the patent has not yet been exploited by the
petitioner. So there is no question of loss of employment or fall in revenue of the
plaintiff company. They apprehend that they will suffer in irreparable loss unless
injunction is granted. But it is clear that in Para 39 of the plaint it has been averred that
the damage suffered by the petitioner can be provisionally quantified. The implied
presumption is that there is some basis for assessment of the damages though the
exact figure cannot be arrived at that stage. So it cannot be said that the balance of
convenience is definitely in favour of granting interlocutory injunction.

20.3 Bolar-Like Provision And Parallel Import Provision

Some countries allow manufacturers of generic drugs to use the patented
inventions for development and submission of information required under law—
for example— from public health authorities- without the patent owners
permission and before the patent protection expires. The generic producers can
then market their version as soon as the patent expires. This provision is called
“Bolar-like provision” or “regulatory exception”. Indian Patent Act provides
such a provision under S. 107A(a).

20.4 Parallel Import.

Parallel import provisions are provided in S. 107A(b), which says that
importation of patented products by any person authorized by the Patentee will
not be considered as an infringement. Therefore it is possible to import the
patented products from the licensee of the patentee in any country with out the
permission of the Patentee. The purpose of Parallel import is to check the abuse
of patent rights and meant to control the price of patented product.
CHAPTER XXI

APPELLATE BOARD

Section 116. Appellate Board.-

(1) Subject to the provisions of this Act, the Appellate Board established under section 83 of the Trade Marks Act, 1999 shall be the Appellate Board for the purposes of this Act and the said Appellate Board shall exercise the jurisdiction, power and authority conferred on it by or under this Act:

Provided that the Technical Member of the Appellate Board for the purposes of this Act shall have the qualifications specified in sub-section (2).

(2) A person shall not be qualified for appointment as a Technical Member for the purposes of this Act unless he—

(a) has, at least five years held the post of Controller under this Act or has exercised the functions of the Controller under this Act for at least five years; or

(b) has, for at least ten years functioned as a Registered Patent Agent and possesses a degree in engineering or technology or a masters degree in science from any University established under law for the time being in force or equivalent; or

Section 117. Staff of Appellate Board.-

(1) The Central Government shall determine the nature and categories of the officers and other employees required to assist the Appellate Board in the discharge of its functions under this Act and provide the Appellate Board with such officers and other employees as it may think tit.

(2) The salaries and allowances and conditions of service of the officers and other employees of the Appellate Board shall be such as may be prescribed.

(3) The officers and other employees of the Appellate Board shall discharge their functions under the general superintendence of the Chairman of the Appellate Board in the manner as may be prescribed.

Section 117A. Appeals to Appellate Board.-

(1) Save as otherwise expressly provided in sub-section (2), no appeal shall lie from any decision, order or direction made or issued under this Act by the Central Government, or from any act or order of the Controller for the purpose of giving effect to any such decision, order or direction.

(2) An appeal shall lie to the Appellate Board from any decision, order or direction of the Controller or Central Government under section 15, section 16, section 17, section 18, section 19, section 20, sub-section (4) of section 25, section 28, section 51, section 54, section 57, section 60, section 61, section 63, section 66, sub-section (3) of section 69, section 78, sub-sections (1) to (5) of section 84, section 85, section 88, section 91, section 92 and section 94.
(3) Every appeal under this section shall be in the prescribed form and shall be verified in such manner as may be prescribed and shall be accompanied by a copy of the decision, order or direction appealed against and by such fees as may be prescribed.

(4) Every appeal shall be made within three months from the date of the decision, order or direction, as the case may be, of the Controller or the Central Government or within such further time as the Appellate Board may, in accordance with the rules made by it allow.

Section 117. Procedure and powers of Appellate Board.-

The provisions of subsections (2) to (6) of section 84, section 87, section 92, section 95 and section 96 of the Trade Marks Act, 1999 (47 of 1999) shall apply to the Appellate Board in the discharge of its functions under this Act as they apply to it in the discharge of its functions under the Trade Marks Act, 1999.

Section 117. Bar of jurisdiction of courts, etc.-

No court or other authority shall have or be entitled to, exercise any jurisdiction, powers or authority in relation to the matters referred to in sub-section (2) of section 117A or section 117D.

Section 117D. Procedure for application for rectification, etc., before Appellate Board.-

(1) An application for revocation of a patent before the Appellate Board under section 64 and an application for rectification of the register made to the Appellate Board under section 71 shall be in such form as may be prescribed.

(2) A certified copy of every order or judgment of the Appellate Board relating to a patent under this Act shall be communicated to the Controller by the Board and the Controller shall give effect to the order of the Board and shall, when so directed, amend the entries in, or rectify, the register in accordance with such order.

Section 117E. Appearance of Controller in legal proceedings.-

(1) The Controller shall have the right to appear and be heard—

(a) in any legal proceedings before the Appellate Board in which the relief sought includes alteration or rectification of the register or in which any question relating to the practice of the patent office is raised;

(b) in any appeal to the Appellate Board from an order of the Controller on an application for grant to a patent—
(i) which is not opposed, and the application is either refused by the Controller or is accepted by him subject to any amendments, modifications, conditions or limitations, or

(iv) which has been opposed and the Controller considers that his appearance is necessary in the public interest,

and the Controller shall appear in any case if so directed by the Appellate Board.

(2) Unless the Appellate Board otherwise directs, the Controller may, in lieu of appearing, submit a statement in writing signed by him, giving such particulars as he thinks proper of the proceedings before him relating to the matter in issue or of the grounds of any decision given by him or of the practice of the patent office in like cases, or of other matters relevant to the issues and within his knowledge as the Controller may deem it necessary, and such statement shall be evidence in the proceeding.

Section 117F. Costs of Controller in proceedings before Appellate Board.

In all proceedings under this Act before the Appellate Board, the costs of the Controller shall be in the discretion of the Board, but the Controller shall not be ordered to pay the costs of any of the parties.

Section 117G. Transfer of pending proceedings to Appellate Board.

All cases of appeals against any order or decision of the Controller and all cases pertaining to revocation of patent other than on a counter-claim in a suit for infringement and rectification of register pending before any High Court, shall be transferred to the Appellate Board from such date as may be notified by the Central Government in the Official Gazette and the Appellate Board may proceed with the matter either de novo or from the stage it was so transferred.

Section 117H. Power of Appellate Board to make rules.

The Appellate Board may make rules consistent with this Act as to the conduct and procedure in respect of all proceedings before it under this Act.

21.1 Appellate board

An Appellate board, established under the Section 83 of the Trade Marks Act, 1999, is the appellate board for deciding appeals to the decision of the Controller and other related matters on patents (S. 116). The Board has been constituted for speeding up legal proceedings in respect of decisions of the Controller by reducing time required in the proceedings before High Courts in the same matters.

21.2.1 The Appellate board consists of Chairman, Technical Members and other staff. The criteria for appointment as a Technical Member (Patents) is given under Section 116(2) and other details like staff are mentioned in Section 117.

21.3 Appeal Procedure:
21.3.1 Every appeal on the decision of the Controller under relevant sections as mentioned in S. 117A (2) should be in the prescribed form accompanied by the certified copy of the decision, order and direction appealed against along with the fees that prescribed by the Board.

21.3.2 Every appeal to the Board should be made within three months from the date of the decision, order or direction of the Controller or of the central Government, as the case may be or within such further time as the Appellate Board may in accordance with the rules made by it allow.

21.3.3 An appeal can be made in respect of the decisions of the Controller under Sections. 15, 16, 17, 18, 19, 20, 25(4), 28, 51, 54, 57, 60, 61, 63, 66, 69(3), 78, 84(1) to (5), 85, 88, 91, 92 and 94.

21.3.4 The orders passed by Central Government in relation to inventions relevant to defence purpose and orders of Controller giving direction of secrecy in respect of such inventions under Section 35 and revocation of Patents by the Controller under Section 65, or by the Central Govt. under Section 66, are not appealable.

21.3.5 No appeal lies from an order of the Controller granting extension of time under any provision of the Act or of the rules.

21.3.6 Transfer of pending proceedings to Board: Section 117G provides that Appellate Board is the sole authority and no other court or authority is entitled to exercise the powers in relation to the proceeding matters and all the appeals against any order or decision of the Controller. All cases pertaining to revocation of patent other than on a counter-claim in a suit for infringement and rectification of register and appeals pending before the High Court on 2nd April, 2007 shall be transferred to the Appellate Board, as per Notification No. dated of Government of India.

21.3.7 Appellate Board may proceed with the appeals either from the beginning or from the stage it was transferred to it.

21.3.8 Appearance of Controller in legal Proceeding: The Controller shall have the right to appear and be heard in-

a) the cases in which relief for alteration or rectification of register has been sought

b) the cases involving issues pertaining to practice of Patent Office

c) in any appeal to the Appellate Board from an order of the Controller on an application for grant to a patent
CHAPTER XXII

PENALTIES

Section 118. Contravention of secrecy provisions relating to certain inventions.-

If any person fails to comply with any direction given under section 35 or makes or causes to be made an application for the grant of a patent in contravention of section 39 he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.

Section 119. Falsification of entries in register, etc.-

If any person makes, or causes to be made, a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in such a register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing knowing the entry or writing to be false, he shall be punishable with imprisonment for a term which may extend to two years, or with fine or with both.

Section 120. Unauthorised claim of patent rights.-

If any person falsely represents that any article sold by him is patented in India or is the subject of an application for a patent in India, he shall be punishable with fine which may extend to one lakh rupees.

Explanation 1—For the purposes of this section, a person shall be deemed to represent—

(a) that an article is patented in India if there is stamped, engraved or impressed on, or otherwise applied to, the article the word "patent" or "patented" or some other word expressing or implying that a patent for the article has been obtained in India;

(b) that an article is the subject of an application for a patent in India, if there are stamped, engraved or impressed on, or otherwise applied to, the article the words "patent applied for", "patent pending", or some other words implying that an application for a patent for the article has been made in India.

Explanation 2—The use of words "patent", "patented", "patent applied for", "patent pending" or other words expressing or implying that an article is patented or that a patent has been applied for shall be deemed to refer to a patent in force in India, or to a pending application for a patent in India, as the case may be, unless there is an accompanying indication that the patent has been obtained or applied for in any country outside India.

Section 121. Wrongful use of words "patent office".-
If any person uses on his place of business or any document issued by him or otherwise the words "patent office" or any other words which would reasonably lead to the belief that his place of business is, or is officially connected with, the patent office, he shall be punishable with imprisonment for a term which may extend to six months, or with fine, or with both.

Section 122. Refusal or failure to supply information.-

(1) If any person refuses or fails to furnish-

(a) to the Central Government any information which he is required to furnish under sub-section (5) of section 100;

(b) to the Controller any information or statement which he is required to furnish by or under section 146,

he shall be punishable with fine which may extend to ten lakh rupees.

(2) If any person, being required to furnish any such information as is referred to in sub-section (1), furnishes information or statement which is false, and which he either knows or has reason to believe to be false or does not believe to be true, he shall be punishable with imprisonment which may extend to six months, or with fine, or with both.

Section 12. Practice by non-registered patent agents.-

If any person contravenes the provisions of section 129, he shall be punishable with fine which may extend to one lakh rupees in the case of a first offence and five lakh rupees in the case of a second or subsequent offence.

Section 124. Offences by companies.-

(1) If the person committing an offence under this Act is a company, the company as well as every person in charge of, and responsible to, the company for the conduct of its business at the time of the commission of the offence shall be deemed to be guilty of the offence and shall be liable to be proceeded against and punished accordingly:

Provided that nothing contained in this sub-section shall render any such person liable to any punishment if he proves that the offence was committed without his knowledge or that he exercised all due diligence to prevent the commission of such offence.

(2) Notwithstanding anything contained in sub-section (1), where an offence under this Act has been committed by a company and it is proved that the offence has been committed with the consent or connivance of, or that the commission of the offence is attributable to any neglect on the part of any director, manager, secretary or other officer of the company, such director, manager, secretary or other officer shall also be deemed to be
guilty of that offence and shall be liable to be proceeded against and punished accordingly.

Explanation—For the purposes of this section,—

(a) "company" means any body corporate and includes a firm or other association of individuals; and
(b) "director", in relation to a firm, means a partner in the firm.

22.1 Penalties

The Patents Act, 1970 provides civil penalties for various offences under the purview of the Act.

22.1.1 Contravention of secrecy provisions relating to certain inventions (S. 118)

If any person fails to comply with any direction given under section 35, that is, related to secrecy directions relating to inventions relevant to defence purpose or files an application in contravention of section 39 which requires that an applicant shall obtain prior permission from the Controller to apply for a patent outside India, he shall be punishable with imprisonment for a term up to 2 years or with fine or with both.

22.1.2 Falsification of entries in register etc (S. 119)

If any person makes a false entry in any register kept under the Patents Act or provides any writing or evidence as a result of which the entry in the register results into a false entry, then he is punishable with imprisonment for a term that may extend to 2 years or with fine or with both.

22.1.3 Unauthorized claim of patent rights (S. 120)

If any person falsely represents that any article sold by him is patented in India or is the subject of an application for a patent in India, he shall be punishable with fine that may extend to rupees one lakh.

The use of words 'Patent', Patented', 'Patent applied for', 'Patent pending', without mentioning the name of the country means that they are patented in India or patent applied for in India and attract the provisions of this section

22.1.4 Wrongful use of words, "Patent Office" (S. 121)

If any person uses on his place of business or any document issued by him which would reasonably lead to the belief that either his place of business is the patent office or is officially connected with the patent office, he shall be punishable with imprisonment for a term that may extend to 6 months, or with fine, or with both.

22.1.5 Refusal or failure to supply information (S. 122)

If any person refuses or fails to furnish information as required under sections 100(5) and 146 he shall be punishable with fine which may go up to rupees one lakh. Section 100(5) provides that any person including Government
undertaking using a patented invention for the purpose of Government has to furnish any information on the use of invention as required by the Central Government and S.146 provides that the patentee has to furnish a statement regarding the working of the patented invention in a commercial scale in India in form 27. This has to be done annually within 3 months of the end of each year. If he furnishes false information knowingly he shall be punishable with imprisonment that may extend to 6 months or with fine or with both.

22.1.6 Practice by non-registered patent agents (S. 123)

Any person practicing as a patent agent without registering himself as such is liable to be punished with a fine of rupees one lakh for the first offence and rupees five lakh for subsequent offence. The procedure for becoming a Patent Agent is described in the next chapter.

22.1.7 Offences by companies (S. 124)

When an offence is committed by a company, the company as well as every person such as director, manager, secretary, in charge of, and responsible to the company for the conduct of its business at the time of the commission of the offence, shall be deemed to be guilty and shall be liable to be proceeded against and punished accordingly. The punishment will not be applicable if such person that may include director including partner, manager, secretary, proves that the offence was committed without his knowledge or he has taken due care to prevent the offence.
CHAPTER XXIII

PATENT AGENTS

Section 125. Register of patent agents.-

(1) The Controller shall maintain a register to be called the register of patent agents in which shall be entered the names, addresses and other relevant particulars, as may be prescribed, of all persons qualified to have their names so entered under section 126.

(2) Notwithstanding anything contained in sub-section (1), it shall be lawful for the Controller to keep the register of patent agents in computer floppies, diskettes or any other electronic form subject to such safeguards as may be prescribed.

Rule 108. Particulars to be contained in the register of patent agents.-

The register of patent agents maintained under section 125 shall contain the name, nationality, address of the principal place of business, addresses of branch offices, if any, the qualifications and the date of registration of every registered patent agent.

(2) Where the register of patent agents is in computer floppies, diskettes or any other electronic form, it shall be maintained and accessed only by the person who is duly authorised by the Controller and no entry or alteration of any entry or rectification of any entry in the said register shall be made by any person who is not so authorised by the Controller.

(4) (i) Copies of register of patent agents shall be maintained in each of the branch offices;

(i) The register of patent agents shall also contain specimen signatures and photographs of the persons registered as patent agents.

Rule118. Alteration of names, etc., in the register of patent agents.-

(1) A patent agent may apply for the alteration of his name, address of the principal place of business and branch offices, if any, or the qualifications entered in the register of patent agents. On receipt of such application and the fee specified therefor in the First Schedule, the Controller shall cause the necessary alterations to be made in the register of patent agents.

(2) Every alteration made in the register of patent agents shall be published.

Section 126. Qualifications for registration as patent agents.-
(1) A person shall be qualified to have his name entered in the register of patent agents if he fulfils the following conditions, namely—

(a) he is a citizen of India;
(b) he has completed the age of 21 years;
(c) he has obtained a degree in science, engineering or technology from any university established under law for the time being in force in the territory of India or possesses such other equivalent qualifications as the Central Government may specify in this behalf, and, in addition,—

(ii) has passed the qualifying examination prescribed for the purpose;
or
(iii) has, for a total period of not less than ten years, functioned either as an examiner or discharged the functions of the Controller under section 73 or both, but ceased to hold any such capacity at the time of making the application for registration;
(d) he has paid such fee as may be prescribed.

(2) Notwithstanding anything contained in sub-section (1), a person who has been registered as a patent agent before the commencement of the Patents (Amendment) Act, 2005 shall be entitled to continue to be, or when required to be re-registered, as a patent agent, on payment of the fee as may be prescribed.

Rule 109. Application for registration of patent agents.-

(1) Every person who desires to be registered as a patent agent shall make an application in Form 22.

(2) The applicant shall furnish such other information as may be required by the Controller.

(3) A person desirous to appear in the qualifying examination under rule 110; shall make a request to the Controller along with the fee as specified in the First Schedule.

Rule 110. Particulars of the qualifying examination for patent agents.-

(1) The qualifying examination referred to in clause (c)(ii) of sub-section (1) of section 126 shall consist of a written test and a viva voce examination.

(2) The qualifying examination shall consist of the following papers and marks, namely:

| Paper I — Patents Act and Rules | 100 |
| Paper II — Drafting and interpretation of patent specifications and other documents | 100 |

(3) The qualifying marks for each written paper and for the viva voce examination shall be fifty per cent, each, of total marks and a candidate shall be
declared to have passed the examination only if he obtains an aggregate of sixty per cent, of the total marks.

Rule 111. Registration of patent agents.-

After a candidate passes the qualifying examination specified in rule 110 and after obtaining any further information which the Controller considers necessary he shall, on receipt of the fee specified therefore in the First Schedule, enter the candidate's name in the register of patent agents and issue to him a certificate of registration as a patent agent.

Rule 111A. Issue of duplicate certificate of patent agents.-

The Controller may issue a duplicate certificate of registration as patent agent on a request made by the person so registered as patent agent along with fee specified in the First Schedule and contain a statement setting out the circumstances in which the original certificate issued under rule 111 was lost, destroyed and cannot be produced.

Rule 112. Details to be included in an application for the registration of a patent agent.-

An application by a person entitled to be registered as a patent agent under sub-section (2) of section 126 shall also be made in Form 22.

Rule 113. Registration of patent agents under section 126 (2).-

On receipt of an application for the registration of a person as a patent agent under rule 112, the Controller may if he is satisfied that the said person fulfils the conditions specified in sub-section (2) of section 126 enter his name in the register of patent agents.

Rule 114. Disqualifications for registration as a patent agent.-

A person shall not be eligible to be registered as a patent agent, if he—

(i) has been adjudged by a competent court to be of unsound mind;
(ii) is an undischarged insolvent;
(iii) being a discharged insolvent, has not obtained from the court a certificate to the effect that his insolvency was caused by misfortune without any misconduct on his part;
(iv) has been convicted by a competent court, whether within or outside India of an offence to undergo a term of imprisonment, unless the offence of which he has been convicted has been pardoned or unless on an application made by him, the Central Government has, by order in this behalf, removed the disability;
(v) being a legal practitioner has been guilty of professional misconduct; or
(vi) being a chartered accountant, has been guilty of negligence or misconduct.

**Rule 115. Payment of fees.-**

The continuance of a person's name in the register of patent agents shall be subject to the payment of the fees specified therefor in the First Schedule.

**Section 127. Rights of patent agents.-**

Subject to the provisions contained in this Act and in any rules made thereunder, every patent agent whose name is entered in the register shall be entitled—

(a) to practice before the Controller; and

(b) to prepare all documents, transact all business and discharge such other functions as may be prescribed in connection with any proceeding before the Controller under this Act.

**Rule 135. Agency.-**

(1) The authorisation of an agent for the purposes of the Act and these rules shall be in Form 26 or in the form of a power of attorney.

(2) Where any authorisation has been made under sub-rule (1), service upon the agent of any document relating to any proceeding or matter under the Act or these rules shall be deemed to be service upon the person so authorising him and all communications directed to be made to a person in respect of any proceeding or matter may be addressed to such agent, and all appearances before the Controller relating thereto may be made by or through such agent.

(3) Notwithstanding anything contained in sub-rule (1) and (2), the Controller may, if it is considered necessary, require the personal signature or presence of an applicant, opponent or party to such proceeding or matter.

**Section 128. Subscription and verification of certain documents by patent agents.-**

(1) all applications and communications to the Controller under this Act may be signed by a patent agent authorised in writing in this behalf by the person concerned.

Provided that if such person is absent from India, they may be signed and verified on his behalf by a patent agent authorised by him in writing in that behalf.

**Section 129. Restrictions on practice as patent agents.-**
(1) No person either alone or in partnership with any other person, shall practise, describe or hold himself out as a patent agent, or permit himself to be so described or held out, unless he is registered as a patent agent or, as the case may be, unless he and all his partners are so registered.

(2) No company or other body corporate shall practise, describe itself or hold itself out as patent agents or permit itself to be so described or held out.

Explanation—
For the purposes of this section, practise as a patent agent includes any of the following acts, namely—
(a) applying for or obtaining patents in India or elsewhere;
(b) preparing specifications or other documents for the purposes of this Act or of the patent law of any other country;
(c) giving advice other than of a scientific or technical nature as to the validity of patents or their infringement.

Section 130. Removal from register of patent agents and restoration.-

(1) The Controller may remove the name of any person from the register when he is satisfied, after giving that person a reasonable opportunity of being heard and after such further inquiry, if any, as he thinks fit to make—
(i) that his name has been entered in the register by error on account of misrepresentation or suppression of material fact;
(ii) that he has been convicted of any offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity which in the opinion of the Controller renders him unfit to be kept in the register.

(2) The Controller may, on application and on sufficient cause being shown, restore to the register the name of any person removed therefrom.

Rule 116. Removal of a name from the register of patent agents.-

(1) The Controller may delete from the register of patent agents, the name of any patent agent—
(a) from whom a request has been received to that effect; or
(b) when he is dead; or
(c) when the Controller has removed the name of a person under sub section (1) of section 130; or
(d) if he has defaulted in the payment of fees specified in rule 115, by more than three months after they are due.

(2) The removal of the name of any person from the register of patent agents shall be published and shall be, where relevant forthwith communicated to the person concerned.
Rule 117. Restoration of name of persons removed from the register of patent agents—

(1) An application for the restoration of the name of any person removed from the register of patent agents under sub-section (2) of section 130 shall be made in - Form 23 within two months from the date of such removal.

(2) If the name of a person is restored to the register of patent agents, his name shall be continued therein for a period of one year from the date on which his last annual fee became due.

(3) The restoration of a name to the register of patent agents shall be published and communicated to the person concerned.

Section 131. Power of Controller to refuse to deal with certain agents.-

(1) Subject to any rules made in this behalf, the Controller may refuse to recognise as agent in respect of any business under this Act—

(a) any individual whose name has been removed from, and not restored to, the register;

(b) any person who has been convicted of an offence under section 123;

(c) any person, not being registered as a patent agent, who in the opinion of the Controller is engaged wholly or mainly in acting as agent in applying for patents in India or elsewhere in the name or for the benefit of the person by whom he is employed;

(d) any company or firm, if any person whom the Controller could refuse to recognise as agent in respect of any business under this Act, is acting as a director or manager of the company or is a partner in the firm.

(2) The Controller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in India

Rule 119. Refusal to recognise as patent agent.-

If the Controller is of the opinion that any person should not be recognised as a patent agent in respect of any business under the Act as provided in sub-section (1) of section 131 thereof, he shall communicate his reasons to that person and direct him to show cause why he should not refuse to recognise him as such agent, within such time as he may allow, and after considering the reply, if any, of that person and giving him an opportunity of being heard, the Controller may pass such orders as he may deem fit.

Rule 120. Publication of the names of patent agents, registered under the Act.—
The names and addresses of persons registered as patent agents shall from time to time be published.

**Section 132. Savings in respect of other persons authorised to act as agents.**-

Nothing in the Chapter shall be deemed to prohibit

(a) the applicant for a patent from drafting any specification or appearing or acting before the Controller, or

(b) an advocate, not being a patent agent, from taking part in any hearing before the Controller on behalf of a party who is taking part in any proceeding under this Act.

23.1 A patent specification is a techno-legal document containing detail description of advancement in technology and the legal protection sought by the inventor applicant as per the Patents Act. There is a provision in the Patents Act for appointment of a Patent Agent by the inventor/applicant to assist him in filing and other modalities in the Patent Office. A Patent agent may be appointed by the inventor/applicant to perform various actions before the patent office on behalf of the applicant and in consultation with him. Various provisions regarding power, rights and duties of patent agent are contained in this chapter.

23.1.1 In the matter of Institute of patent agents and others v. Joseph Lockwood a declaration was sought against Lockwood that he was not registered as a patent agent in pursuance of the patents, design and trademarks act, 1888 and was not entitled to describe himself as a patent agent; and consequential relief was asked for. while the first section of the act required such a registration, the act itself did not provide "for the manner in which the register is to be formed, who is to be the registrar, the formalities requisite for the registration, or any particulars in relation to it". the act left to the board of trade to make such general rules as were required for giving effect to the first section. Among the rules made by the board was one requiring certain fee to be paid on first registration, and also an annual fee, non-payment of which shall be a ground for canceling the registration. Question arose whether the rules with reference to fees were intra vires or ultra vires. The House of Lords held that the rules were intra vires.

23.2 **Register Of Patent Agents**  [(S. 125)]

a) The Controller maintains a register to be called the ‘Register of Patent Agents’ in which there will be entered the names, address and other relevant particulars as may be prescribed in respect of all persons qualified to have their names so entered.

b) It is mandatory to maintain a register of patent agents for the purpose of identifying who are the persons registered as patent agents and are entitled to work for the purpose of prosecuting the application for patent on behalf of the applicant.
c) The names can be maintained in the register by paying the renewal fee every year.

d) The register will contain the name, nationality, address of the principal place of business, branch office address and other relevant particulars as may be prescribed, if any, the qualification and the date of registration of entry as a Patent agent.

23.3 Qualifications for Registration as Patent Agents (S. 126)

(1) A person shall be qualified to have his name entered in the register of patent agents if he fulfils the following conditions, namely:

(a) he is a citizen of India;
(b) he has completed the age of 21 years;
(c) he has obtained a degree in Science, Engineering or Technology from any University established under the law for the time being in force in the territory of India or possesses such other equivalent qualifications as the Central Government may specify in this behalf, and, in addition, -

(i) has passed the qualifying examination prescribed for the purpose or
(ii) has, for a total period of not less than ten years, functioned either as an examiner or discharged the functions of the Controller under section 73, or both, but ceased to hold any such capacity at the time of making the application for registration;

(d) He has paid such fee as may be prescribed.

(2) A person who has been registered as a patent agent before the commencement of Patent [amendment] Act, 2005 shall be entitled to continue to be, or when required to be re-registered as a patent agent, on payment of the fee as may be prescribed.

23.4 Qualifying Examinations for Patent Agents (Rule 110)

i) In order to maintain high professional efficiency on the part of patent agents, the Act has provided for certain prescribed qualification for the patent agents as mentioned above. A qualifying examination for Patent Agents, which will consist of a written test and a viva voce examination.

ii) Application for qualifying examination:

Application for the qualifying examination shall be made on plain paper addressed to “The Controller of Patents” in the prescribed manner along with requisite fee in cash / cheque / D.D. in favour of “The Controller of Patents” and payable at any of the four branches and shall be submitted to the nearest Patent Office along with two copies of passport size photos and with relevant documents.
iii) The written test consists of two papers, and carries the following marks: [Rule 110(2)].

<table>
<thead>
<tr>
<th>Paper</th>
<th>Subject</th>
<th>Marks</th>
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<tbody>
<tr>
<td>Paper I</td>
<td>Patents Act and Rules</td>
<td>100</td>
</tr>
<tr>
<td>Paper II</td>
<td>Drafting and Interpretation of Patent Specification and other documents</td>
<td>100</td>
</tr>
<tr>
<td>Viva-Voce</td>
<td></td>
<td>100</td>
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</tbody>
</table>

Qualifying marks for each written paper and for viva-voce shall be fifty percent each, and a candidate shall be declared to have passed the examination only if he obtains an aggregate of sixty percent of the total marks (300 marks).

iv) The qualifying examination for Patent agents shall be held twice in a year i.e., in the month of February and August, at each of the appropriate office of the Patent Office.

### 23.5 Registration of Patent Agents (Rule 111)

After a candidate passes the qualifying examination specified in rule 110 and after obtaining any further information, which the Controller considers necessary, and on receipt of the fee, the Controller will enter the candidate’s name in the register of patent agents and issue to him a certificate of registration as a patent agent.

### 23.6 Details to be included in an application for the registration of Patent Agents (Rule112)

A person who is entitled to get his name registered as Patent Agent under Section 126(2), shall also make his request in Form 22 with the prescribed fee as given in the First Schedule and he shall provide the following information:

- Name and qualification
- Address of his/her office including branch office, if any
- Date of payment of prescribed fee
- Other details as may be necessary

### 23.7 Disqualification for registration as a Patent Agent (Rule 114)

Conditions for disqualification of a person from registration as a Patent Agent are as follows:

A person will not be eligible to be registered as a patent agent, if he-

(i) has been adjudged by a competent court to be of unsound mind;
(ii) is an undischarged insolvent;
(iii) being a discharged insolvent, has not obtained from the court a certificate to the effect that his insolvency was caused by misfortune without any misconduct on his part;
(iv) has been convicted by a competent court, whether within or outside India of an offence to undergo a term of imprisonment, unless the offence of which he has been convicted has been pardoned or unless on an application made by him, the Central Government has, by order in this behalf, removed the disability;
(v) being a legal practitioner, has been guilty of professional misconduct; or
(vi) being a chartered accountant has been guilty of negligence or misconduct

23.8 Payment of Renewal Fees (Rule 115)

For continuance of the name of a person in the register of Patent agents he/she has to make Payment of the fees as prescribed in the First Schedule.

23.9 Alteration of names etc. in the register of patent agents (Rule 118)

A Patent agent may apply for the alteration of his name, address of the principal place of business and branch offices, if any, or the qualifications entered in the register of patent agents. On receipt of such application and the fee specified therefore in the First Schedule, the Controller will cause the necessary alterations to be made in the register of patent agents. Every alteration made in the register of patent agents will be published.

23.10 Publication of the names of patent agents registered under the Act (Rule 120)

The names and addresses of persons registered as patent agents will be published regularly in the official journal, official website of Patent Office, A person whose name is entered in the register of Patent Agents can practice before the Controller and, if duly authorized, may sign all applications and communications to the Controller. His work also includes drafting of specification, making an application for Patent, making subsequent correspondence with the Patent Office, attending hearing on behalf of the applicant, filing and taking part in opposition proceeding or defending his case against such opposition filed by some other party.

23.11 Practice as a patent agent includes any of the following acts, namely:

a) Applying for or obtaining patents in India or elsewhere on behalf the applicant;
b) Preparing patent specifications or other documents for the purposes of this Act or of the patent law of any country for the applicant ;
c) Giving advice other than of a scientific or technical nature as to the validity of patents or their infringement

23.12 Restrictions on Practice as Patent Agents

(a) No person either alone or in partnership with any other person, shall practise, describe or hold himself out as a patent agent, or permit himself to be so described or held out, unless he is registered as a patent agent or, as the case may be, unless he and all his partners are so registered.

(b) No company or other body corporate should practice, describe itself or hold itself out as patent agents or permit itself to be so described or held out
Each person in the associate group if any constituted should be a registered agent and duly authorized by the concerned person on behalf they act (Section 129)

23.13 Removal from Register of Patent Agents and Restoration (S. 130 and Rule 116)

a) The Controller may remove the name of any person from the register when he is satisfied: –
   (i) that his/her name has been entered in the register by error on account of misrepresentation or suppression of material fact; or
   (ii) that he/she has been convicted of any offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity which in the opinion of the Controller renders him unfit to be kept in the register.

   The Controller shall take decision after giving that person a reasonable opportunity of being heard and after any further inquiry, as he thinks fit to make.

b) Besides, the name of the patent agent can be removed also when:
   (i) request has been received from the patent agent to that effect; or
   (ii) he/she is dead; or
   (iii) if he/she has defaulted in the payment of fees specified in the First Schedule by more than three months after they are due.

c) The removal of the name of any person from the register of patent agents shall be published and will be communicated to the person concerned.

23.14 Restoration of names of persons removed from the register of patent agents can be made by the Controller, on application made in form 23 within two months from the date of such removal

(a) The restoration of name to the register shall be published and communicated to the person concerned [Rule 117 (3)]
(b) If the name of a person is entered in the register of Patents agents, his name
(c) shall be continued therein for a period of one year from the date on which his last annual fee became due [Rule 117 (2), 120]

23.15 There is an option provided in the Act that an applicant for a patent can appear or act before the Controller, or can draft any specification. Also an advocate who is not a patent agent can take part in any hearing before the Controller on behalf of a party who is taking part in any proceeding under the Act.
CHAPTER XXIV

INTERNATIONAL ARRANGEMENTS

Section 133. Convention countries.-

Any country, which is a signatory or party or a group of countries, union of countries or intergovernmental organisations which are signatories or parties to an international, regional or bi-lateral treaty, convention or arrangement to which India is also a signatory or party and which affords to the applicants for patents in India or to citizens of India similar privileges as are granted to their own citizens or citizens to their member countries in respect of the grant of patents and protection of patent rights shall be a convention country or convention countries for the purposes of this Act.

Section 134. Notification as to countries not providing for reciprocity.-

Where any country specified by the Central Government in this behalf by notification in the Official Gazette does not accord to citizens of India the same rights in respect of the grant of patents and the protection of patent rights as it accords to its own nationals, no national of such country shall be entitled, either solely or jointly with any other person,—

(a) to apply for the grant of a patent or be registered as the proprietor of a patent;

(b) to be registered as the assignee of the proprietor of a patent; or

(c) to apply for a licence or hold any licence under a patent granted under this Act.

Section 135. Convention applications.-

(1) Without prejudice to the provisions contained in section 6, where a person has made an application for a patent in respect of an invention in a convention country (hereinafter referred to as the "basic application"), and that person or the legal representative or assignee of that person makes an application under this Act for a patent within twelve months after the date on which the basic application was made, the priority date of a claim of the complete specification, being a claim based on matter disclosed in the basic application, is the date of making of the basic application.

Explanation—Where applications have been made for similar protection in respect of an invention in two or more convention countries, the period of twelve months referred to in this sub-section shall be reckoned from the date on which the earlier or earliest of the said applications was made.
(2) Where applications for protection have been made in one or more convention countries in respect of two or more inventions which are cognate or of which one is a modification of another, a single convention application may, subject to the provisions contained in section 10, be made in respect of those inventions at any time within twelve months from the date of the earliest of the said applications for protection:

Provided that the fee payable on the making of any such application shall be the same as if separate applications have been made in respect of each of the said inventions, and the requirements of clause (b) of sub-section (1) of section 136 shall, in the case of any such application, apply separately to the applications for protection in respect of each of the said inventions.

(3) In case of an application filed under the Patent Cooperation Treaty designating India and claiming priority from a previously filed application in India, the provisions of sub-sections (1) and (2) shall apply as if the previously filed application were the basic application:

Provided that a request for examination under section 11B shall be made only for one of the applications filed in India.

Section 136. Special provisions relating to convention application.-

(1) Every convention application shall—

(a) be accompanied by a complete specification; and

(b) specify the date on which and the convention country in which the application for protection, or as the case may be, the first of such applications was made; and

(c) state that no application for protection in respect of the invention had been made in a convention country before that date by the applicant or by any person from whom he derives title.

(2) Subject to the provisions contained in section 10, a complete specification filed with a convention application may include claims in respect of developments of, or additions to the invention in respect of which the application for protection was made in a convention country, being developments or additions in respect of which the applicant would be entitled under the provisions of section 6 to make a separate application for a patent.

(3) A convention application shall not be post-dated under sub-section (1) of section 17 to a date later than the date on which under the provisions of this Act the application could have been made.

Section 137. Multiple priorities.-

(1) Where two or more applications for patents in respect of inventions have been made in one or more convention countries and those inventions are so related as to constitute one invention, one application may be made by any or all of the persons referred to in sub-section (1) of section 135 within twelve months from the date on which the earlier or earliest of those applications was made, in respect of
the inventions disclosed in the specifications which accompanied the basic applications.

(2) The priority date of a claim of the complete specification, being a claim based on matters disclosed in one or more of the basic applications, is the date on which that matter was first so disclosed.

(3) For the purposes of this Act, a matter shall be deemed to have been disclosed in a basic application for protection in a convention country if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgement of a prior art) in that application, or any documents submitted by the applicant for protection in support of and at the same time as that application but no account shall be taken of any disclosure effected by any such document unless a copy of the documents is filed at the patent office with the convention application or within such period as may be prescribed after the filing of that application.

Section 138. Supplementary provisions as to convention applications.-

(1) Where a convention application is made in accordance with the provisions of this Chapter, the applicant shall furnish, when required by the Controller, in addition to the complete specification, copies of the specifications or corresponding documents filed or deposited by the applicant in the patent office of the convention country as referred to in section 133 verified to the satisfaction of the Controller, within the prescribed period from the date of communication by the Controller.

(2) If any such specification or other document is in a foreign language, a translation into English of the specification or document, verified by affidavit or otherwise to the satisfaction of the Controller, shall be furnished when required by the Controller.

(3) For the purposes of this Act, the date on which an application was made in a convention country is such date as the Controller is satisfied, by certificate of the official chief or head of the patent office of the convention country or otherwise, is the date on which the application was made in that convention country.

(4) An international application filed under the Patent Co-operation Treaty designating India shall have effect of filing an application for patent under section 7, section 54 and section 135, as the case may be, and the title, description, claim and abstract and drawings, if any, filed in the international application shall be taken as complete specification for the purposes of this Act.

(5) The filing date of application for patent and its complete specification processed by the patent office as designated office shall be the international filing date accorded under the Patent Cooperation Treaty.

(6) Amendment, if any, proposed by the applicant for an international application designation designating India or designating and electing India
before international searching authority or preliminary examination authority shall, if the applicant so desires, be taken as an amendment made before the patent office.

Section 139. Other provisions of Act to apply to convention applications.-

Save as otherwise provided in this Chapter, all the provisions of this Act shall apply in relation to a convention application and a patent granted in pursuance thereof as they apply in relation to an ordinary application and a patent granted in pursuance thereof.

Rule 121. Period within which copies of specification etc. are to be filed.-

The period within which copies of specification or corresponding documents to be filed by the applicant under sub-section (1) of section 138 shall be three months from the date of communication by the Controller.

24.1 Convention Countries

24.1.1 With a view to the fulfillment of a treaty, convention or arrangement with any other country which affords to citizens of India similar privileges as are granted to its own citizens in respect of the grant of patents and the protection of patent rights, the Central Government may, by notification in the Official Gazette, declare such country to be a convention country for the purposes of this Act.

24.1.2 A declaration under sub-section (1) may be made for the purposes either of all or of some only of the provisions of this Act, and a country in the case of which a declaration made for the purposes of some only of the provisions of this Act is in force shall be deemed to be a convention country for the purposes of those provisions only.

24.1.3 A national from a convention country can file a convention application through convention route within one year from the date of filing the basic application in the convention country. In order to get conventional status the applicant must submit a certified copy of the application filed in the convention country.

24.2 Notification as to countries not providing for reciprocity [Section 134]

24.2.1 Where any country specified by the Central Government in this behalf by notification in the Official Gazette does not accord to citizens of India the same rights in respect of the grant of patents and the protection of patent rights as it accords to its own nationals, no national of such country shall be entitled, either solely or jointly with any other person -

a. to apply for the grant of a patent or be registered as the proprietor of a patent;

b. to be registered as the assignee of the proprietor of a patent; or
c. to apply for a licence or hold any licence under a patent granted under this Act.

24.3 Convention Applications

24.3.1 Where a person has made an application for a patent in respect of an invention in a convention country (basic application), and that person or the legal representative or assignee of that person makes an application under this Act for a patent within twelve months after the date on which the basic application was made, the priority date of a claim of the complete specification, being a claim based on matter disclosed in the basic application, is the date of making of the basic application. Where applications have been made for similar protection in respect of an invention in two or more convention countries, the period of twelve months referred to in this subsection shall be reckoned from the date on which the earlier or earliest of the said applications was made.

24.3.2 Where applications for protection have been made in one or more convention countries in respect of two or more inventions which are cognate or of which one is a modification of another, a single convention application may, be made in respect of those inventions at any time within twelve months from the date of the earliest of the said applications for protection provided it fulfils requirements as regards to the contents of complete specification as given in section 10.

24.3.3 The fee payable in respect of such application shall be the same as if separate applications have been made in respect of each of the said inventions, and the requirements of S 136 (1)(b), in the case of any such application, apply separately to the applications for protection in respect of each of the said inventions.

24.3.4 In the matter of Danieli AC Officine Meccaniche SPA v. Contoller of Patents and Designs (AID No. 19 of 1998), the questions before the division bench of Calcutta high court were whether the appeal was maintainable under section 116 of the patent act and whether the order of the Controller dismissing appellants application under section 135 of the act was inconformity with the letter and spirit of section 133 of the act or not.

a) The applicants had applied for a patent in Italy on 31st March, 1994. Italy was declared convention country, as far as India was concerned, on 3rd January, 1995. On 15th March, 1995 an application was filed by the applicant under sections 133,135 of the Act in which the applicant claimed priority on the basis of application filed in Italy as a convention country.

b) Initially, the Controller objected to recognize the priority date and later after a hearing issued a reasoned order dated 06-07-1998 stating that the applicant was not entitled to claim the priority on the basis that the basic application as the same had not been filed before a convention country because when the application was filed in Italy, Italy was not a
conventional country. The Controller accordingly held that the application shall not be proceeded as conventional application and if the applicant complied the requirements of the law, it may proceed as an ordinary application.

c) On the first question the court held that the Controller has refused to proceed with the application and has required the applicant to amend his application in the manner directed by the Controller before the Controller would proceed with the application at all. The order is clearly covered by section 15(1) and therefore is appealable under section 116(2).

d) On the second question the court held that section 135 requires the basic application to be an “application of patent in respect of invention in a convention country”. On a literal interpretation, the phrase plainly means that the basic application is made in order to qualify the applicant for a priority claim under section 135. In other words, an application made to a country, which may subsequently be declared, as a convention country will not do. Further the court also held that the provisions of sections 2(d) and 133 are not expressed in a language, which can be construed as operating retrospective.

e) The argument of the appellant that the notification under the 1970 Act as far as the six convention countries prevailing during 1911 Act, has been issued subsequent to the making of the patent application was nullified as these application where saved by the provision of section 162 of the 1970 Act.

f) The appellant’s right flows from the provision of section 135 read with section 133(1) of the Patent Act. The notification was not given retrospective effect and the privileges of reciprocity were therefore extended to the 72 countries including Italy for the first time in 1995. The appellant’s basic application was made in 1994 when Italy was not a convention country. There has, therefore, been no discrimination between the appellant and the applicants with pending applications under the 1911 Act and the tribunal rightly held that the application of the appellant under section 135 could not be proceeded with. The appeal was accordingly dismissed without any order as to costs.

24.4 Special provisions relating to convention applications [Section 136]

24.4.1 Every convention application shall -

a. be accompanied by a complete specification; and
b. specify the date on which and the convention country in which the application for protection, or as the case may be, the first of such applications was made; and

c. state that no application for protection in respect of the invention had been made in a convention country before that date by the applicant or by any person from whom he derives title.
24.4.2 Subject to the provisions contained in section 10, a complete specification filed with a convention application may include claims in respect of developments or, or additions to, the invention in respect of which the application for protection was made in a convention country, being developments or additions in respect of which the applicant would be entitled under the provisions of section 6 to make a separate application for a patent.

24.4.3 A convention application shall not be post-dated under section 17 (1) to a date later than the date on which under the provisions of this Act the application could have been made.

24.5 Multiple priorities (Section 137)

24.5.1 Where two or more applications for patents in respect of inventions have been made in one or more convention countries and those inventions are so related as to constitute one invention, one application may be made by any or all of the persons referred to in sub-section (1) of section 135 within twelve months from the date on which the earlier or earliest of those applications was made, in respect of the inventions disclosed in the specifications which accompanied the basic application.

24.5.2 The priority date of a claim of the complete specification, being a claim based on matters disclosed in one or more of the basic applications, is the date on which that matter was first so disclosed.

24.5.3 For the purposes of this Act, a matter shall be deemed to have been disclosed in a basic application for protection in a convention country if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgement of a prior art) in that application, or any documents submitted by the applicant for protection in support of and at the same time as that application, but no account shall be taken of any disclosure effected by any such document unless a copy of the document is filed at the patent office with the convention application or within such period as may be prescribed after the filing of that application.

24.6 Supplementary provisions as to convention applications Section 138

24.6.1 Where a convention application is made in accordance with the provisions of this Chapter, the applicant shall furnish, in addition to the complete specification, copies of the specifications or corresponding documents filed or deposited by the applicant in the patent office of the convention country in which the basic application was made, certified by the official chief or head of the patent office of the convention country, or otherwise verified to the satisfaction of the Controller, along with the application or within three months thereafter, or within such further period as the Controller may on good cause allow.

24.6.2 If any such specification or other document is in a foreign language, a translation into English of the specification or document, verified by affidavit or
otherwise to the satisfaction of the Controller, shall be furnished when
required by the Controller.

24.6.3 For the purpose of this Act, the date on which an application was made in a
convention country is such date as the Controller is satisfied, by
certificate of the official chief or head of the patent office of the
convention country or otherwise, in the date on which the application was
made in that convention country.
CHAPTER XXV

MISCELLANEOUS

Section 140. Avoidance of certain restrictive conditions.—

(1) It shall not be lawful to insert—
   (i) in any contract for or in relation to the sale or lease of a patented article or an article made by a patented process; or
   (ii) in licence to manufacture or use a patented article; or
   (iii) in a licence to work any process protected by a patent, a condition the effect of which may be—
      (a) to require the purchaser, lessee, or licensee to acquire from the vendor, lessor, or licensor or his nominees, or to prohibit him from acquiring or to restrict in any manner or to any extent his right to acquire from any person or to prohibit him from acquiring except from the vendor, lessor, or licensor or his nominees any article other than the patented article or an article other than that made by the patented process; or
      (b) to prohibit the purchaser, lessee or licensee from using or to restrict in any manner or to any extent the right of the purchaser, lessee or licensee, to use an article other than the patented article or an article other than that made by the patented process, which is not supplied by the vendor, lessor or licensor or his nominee; or
      (c) to prohibit the purchaser, lessee or licensee from using or to restrict in any manner or to any extent the right of the purchaser, lessee or licensee to use any process other than the patented process,
      (d) to provide exclusive grant back, prevention to challenges to validity of Patent & Coercive package licensing, and any such condition shall be void.

(2) A condition of the nature referred to in clause (a) or clause (b) or clause (c) of sub-section (1) shall not cease to be a condition falling with that sub-section merely by reason of the fact that the agreement containing it has been entered into separately, whether before or after the contract relating to the sale, lease or licence of the patented article or process.

(3) In proceedings against any person for the infringement of a patent, it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent and containing a condition declared unlawful by this section: Provided that this sub-section shall not apply if the plaintiff is not a party to the contract and proves to the satisfaction of the court that the restrictive condition was inserted in the contract without his knowledge and consent, express or implied.

(4) Nothing in this section shall—
   (a) affect a condition in a contract by which a person is prohibited from selling goods other than those of a particular person;
   (b) validate a contract which, but for this section would be invalid;
   (c) affect a condition in a contract for the lease of, or licence to use a patented article, by which the lessor or licensor reserves to himself or
his nominee the right to supply such new parts of the patented article as may be required or to put or keep it in repair.

(5) Omitted by Act 38 of 2002

Section 141. Determination of certain contracts.—

(1) Any contract for the sale or lease of a patented article or for licence to manufacture, use or work a patented article or process, or relating to any sale, lease or licence, may at anytime after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything to the contrary in the contract or in any other contract, be determined by the purchaser, lessee, or licensee, as the case may be, of the patent on giving three months notice in writing to the other party.

(2) The provisions of this section shall be without prejudice to any right of determining a contract exercisable apart from this section.

Section 142. Fees.—

(1) There shall be paid in respect of the grant of patents and applications therefor, and in respect of other matters in relation to the grant of patents under this Act, such fees as may be prescribed by the Central Government.

(2) Where a fee is payable in respect of the doing of an act by the Controller, the Controller shall not do that act until the fee has been paid.

(3) Where a fee is payable in respect of the filing of a document at the patent office, the fee shall be paid along with the document or within the prescribed time and the document shall be deemed not to have been filed at the office if the fee has not been paid within such time.

(4) Where a principal patent is granted later than two years from the date of the filing of the application, the fees which have become due in the meantime may be paid within a term of three months from the date of the recording of the patent in the register or within the extended period not later than nine months from the date of recording.

Section 143. Restrictions upon publication of specification.—

Subject to the provisions of Chapter VII, an application for a patent, and any specification filed in pursuance thereof, shall not, except with the consent of the applicant, be published by the Controller before the expiration of the period prescribed under sub-section (1) of section 11A or before the same is open to public inspection in pursuance of sub-section (3) of section 11A or section 43.

Section 144. Reports of examiners to be confidential.—

The reports of examiners to the Controller under this Act shall not be open to public inspection or be published by the Controller; and such reports shall not be liable to production or inspection in any legal proceeding unless the court certifies that the production or inspection is desirable in the interests of justice, and ought to be allowed.

Section 145. Publication of official journal.—

The Controller shall publish periodically an official journal which shall contain such information as may be required to be published by or under the provisions of this Act or any rule made thereunder.
Section 146. Power of Controller to call for information from patentees.—

(1) The Controller may, at any time during the continuance of the patent, by notice in writing, require a patentee or a licensee, exclusive or otherwise, to furnish to him within two months from the date of such notice or within such further time as the Controller may allow, such information or such periodical statements as to the extent to which the patented invention has been commercially worked in India as may be specified in the notice.

(2) Without prejudice to the provisions of sub-section (1), every patentee and every licensee (whether exclusive or otherwise) shall furnish in such manner and form and at such intervals (not being less than six months) as may be prescribed statements as to the extent to which the patented invention has been worked on a commercial scale in India.

(3) The Controller may publish the information received by him under sub-section (1) or sub-section (2) in such manner as may be prescribed.

Section 147. Evidence of entries, documents, etc.—

(1) A certificate purporting to be signed by the Controller as to any entry, matter or thing which he is authorized by this Act or any rules made thereunder to make or do, shall be prima facie evidence of the entry having been made and of the contents thereof and of the matter or thing having been done or omitted to be done.

(4) A copy of any entry in any register or of any document kept in the patent office or of any patent, or an extract from any such register or document, purporting to be certified by the Controller and sealed with the seal of the patent office shall be admitted in evidence in all courts, and in all proceedings, without further proof or production of the original.

(3) The Controller or any other officer of the patent office shall not, in any legal proceedings to which he is not a party, be compellable to produce the register or any other document in his custody, the contents of which can be proved by the production of a certified copy issued under this Act or to appear as a witness to prove the matters therein recorded unless by order of the court made for special causes.

Section 148. Declaration by infant, lunatic etc.—

(1) If any person is, by reason of minority, lunacy or other disability, incapable of making any statement or doing anything required or permitted by or under this Act, the lawful guardian, committee or manager (if any) of the person subject to the disability, or if there be none, any person appointed by any court possessing jurisdiction in respect of his property, may make such statement or a statement as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the statement or the doing of the thing.

Section 149. Service of notices, etc., by post.—
Any notice required or authorised to be given by or under this Act, and any application or other document so authorised or required to be made or filed, may be given, made or filed by post.

**Section 150. Security for costs.**—

If any party by whom notice of any opposition is given under this Act or by whom application is made to the Controller for the grant of a licence under a patent neither resides nor carries on business in India, the Controller may require him to give security for the costs of the proceedings, and in default of such security being given may treat the opposition or application as abandoned.

**Section 151. Transmission of orders of courts to Controller.**—

(1) Every order of the High Court or the Appellate Board on a petition for revocation, including orders granting certificates of validity of any claim, shall be transmitted by the High Court or the Appellate Board to the Controller who shall cause an entry thereof and reference thereto to be made in the register.

(2) Where in any suit for infringement of a patent or in any suit under section 106 the validity of any claim or a specification is contested and that claim is found by the court to be valid or not valid, as the case may be, the court shall transmit a copy of its judgment and decree to the Controller who shall on receipt thereof cause an entry in relation to such proceeding to be made in the prescribed manner in a supplemental record.

(3) The provisions of sub-sections (1) and (2) shall also apply to the court to which appeals are preferred against decisions of the Appellate Board or the courts, as the case may be, referred to in those sub-sections.

**Section 152. Transmission of copies of specifications, etc., and inspection thereof.**—

[Omitted by Act 15 of 2005]

**Section 153. Information relating to patents.**—

A person making a request to the Controller in the prescribed manner for information relating to any such matters as may be prescribed as respects any patent specified in the request or as respects any application for a patent so specified shall be entitled, subject to the payment of the prescribed fee, to have information supplied to him accordingly.

**Section 154. Loss or destruction of patents.**—

If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Controller, the Controller may at any time, on application made in the prescribed manner and on payment of the prescribed fee, cause a duplicate thereof to be sealed and delivered to the applicant.
Section 155. Reports of Controller to be placed before Parliament.—

The Central Government shall cause to be placed before both Houses of Parliament once a year a report respecting the execution of this Act by or under the Controller.

Section 156. Patent to bind Government.—

Subject to the other provisions contained in this Act, a patent shall have to all intents the like effect as against Government as it has against any person.

Section 157. Right of Government to sell or use forfeited articles.—

Nothing in this Act shall affect the power of the Government or of any person deriving title directly or indirectly from the Government to sell or use any articles forfeited under any law for the time being in force.

Section 157A. Protection of security of India.—

Notwithstanding anything contained in this Act, the Central Government shall—

(a) not disclose any information relating to any patentable invention or any application relating to the grant of patent under this Act, which it considers prejudicial to the interest of security of India;

(b) take any action including the revocation of any patent which it considers necessary in the interest of the security of India by issue of a notification in the Official Gazette to that effect.

Explanation.—For the purposes of this section, the expression "security of India" includes any action necessary for the security of India which—

(i) relates to fissionable materials or the materials from which they are derived; or

(ii) relates to the traffic in arms, ammunition and implements of war and to such traffic in other goods and materials as is carried on directly or indirectly for the purpose of supplying a military establishment; or

(iii) is taken in time of war or other emergency in international relations.

Section 158. Power of High Courts to make rules.—

The High Court may make rules consistent with this Act as to the conduct and procedure in respect of all proceedings before it under this Act.

Section 159. Power of Central Government to make rules.—

(1) The Central Government may, by notification in the Official Gazette, make rules for carrying out the purposes of this Act.

(2) Without prejudice to the generality of the foregoing power, the Central Government may make rules to provide for all or any of the following matters, namely:—

(i) the form and manner in which any application for a patent, any specifications or drawings and any other application or document may be filed in the patent office;

(ii) the period which the Controller may allow for filing of statement and undertaking for in respect of applications under sub-section (1), the period within which the details relating to processing of applications may be filed before the Controller and the details to be furnished by the applicant to the Controller under sub-section (2) of section 8;
(ib) the period within which a reference to the deposit of materials shall be made in the specification under sub-clause (A) of clause (ii) of the proviso to sub-section (4) of section 10;

(ic) the period for which application for patent shall not be open to the public under sub-section (1) and the manner in which the applicant may make a request to the Controller to publish his application under sub-section (2) of section 11A;

(id) the manner of making the request for examination for an application for patent and the period within which such examination shall be made under sub-sections (1) and (3) of section 11B;

(ie) the manner in which an application for withdrawal of an application for grant of a patent shall be made and the period within which a request for examination from the date of revocation of secrecy directions shall be made under the proviso to sub-section (4) of section 11B.

(ii) the time within which any act or thing may be done under this Act, including the manner in which and the time within which any matter may be published under this Act;

(iii) the fees which may be payable under this Act and the manner and time of payment of such fees;

(iv) the matters in respect of which the examiner may make report to the Controller;

(v) the manner in which and the period within which the Controller shall consider and dispose off a representation under sub-section (1) of section 25;

(va) the period within which the Controller is required to dispose off an application under section 39;

(vi) the form and manner in which and the time within which any notice may be given under this Act;

(vii) the provisions which may be inserted in an order for restoration of a patent for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had ceased;

(viii) the establishment of branch offices of the patent office and the regulation generally of the business of the patent office, including its branch offices;

(ix) the maintenance of the register of patents and the safeguards to be observed in the maintenance of such register in computer floppies, diskettes or any other electronic form and the matters to be entered therein;

(x) the matters in respect of which the Controller shall have powers of a civil court;

(xi) the time when and the manner in which the register and any other document open to inspection may be inspected under this Act;

(xii) the qualifications of, and the preparation of a roll of, scientific advisers for the purpose of section 115;

(xiiia) the salaries and allowances and other conditions of service of the officers and other employees of the Appellate Board under subsection (2) and the manner in which the officers and other employees of the Appellate Board shall discharge their functions under subsection (3) of section 117;

(xiiib) the form of making an appeal, the manner of verification and the fee payable under sub-section (3) of section 117A;

(xiiic) the form in which, and the particulars to be included in the application to the Appellate Board under sub-section (1) of section 1171;

(xiii) the manner in which any compensation for acquisition by Government of an invention may be paid;

(xiv) the manner in which the register of patent agents may be maintained under sub-section (1) of section 125 and the safeguards to be observed in the maintenance of such register of patent agents on computer floppies, diskettes or any other electronic form under subsection (2) of that section.
the conduct of qualifying examinations for patent agents; and matters connected with their practice and conduct, including the taking of disciplinary proceedings against patent agents for misconduct;

(xv) the regulation of the making, printing, publishing and selling of indexes to, and abridgements of, specifications and other documents in the patent office; and the inspection of indexes and abridgements and other documents;

(xvi) any other matter which has to be or may be prescribed.

(3) The power to make rules under this section shall be subject to condition of the rules being made after previous publication:

Provided that the Central Government may, if it is satisfied that the circumstances exist which render it practically not possible to comply with such condition of previous publication, dispense with such compliance.

Section 160. Rules to be placed before Parliament.—

Every rule made under this Act shall be laid, as soon as may be after it is made, before each House of Parliament while it is in session for a total period of thirty days which may be comprised in one session or in two or more successive sessions, and if, before the expiry of the session immediately following the session or the successive sessions aforesaid, both Houses agree in making any modification in the rule or both Houses agree that the rule should not be made, the rule shall thereafter have effect only in such modified form or be of no effect, as the case may be; so however, that any such modification or annulment shall be without prejudice to the validity of anything previously done under that rule.

Section 161. Special provisions with respect to certain applications deemed to have been refused under Act 2 of 1911.—

[Omitted by Act 38 of 2002.]

Section 162. Repeal of Act 2 of 1911 in so far as it relates to patents and savings.—

(1) The Indian Patents and Designs Act, 1911, in so far as it relates to patents, is hereby repealed, that is to say, the said Act shall be amended in the manner specified in the Schedule.

(2) [Omitted by Act 38 of 2002.]

(3) [Omitted by Act 38 of 2002.]

(4) The mention of particular matters in this section shall not prejudice the general application of the General Clauses Act, 1897 (10 of 1897), with respect to repeals.

(5) Notwithstanding anything contained in this Act, any suit for infringement of a patent or any proceeding for revocation of a patent, pending in any court at the commencement of this Act, may be continued and disposed of, as if this Act had not been passed.

Section 163. Amendment of Act 43 of 1958.—

[Omitted by Act 38 of 2002.]

Rule 121. Period within which copies of specification etc. are to be filed.—

The period within which copies of specification or corresponding documents to be filed by the applicant under sub-section (1) of section 138 shall be three months from the date of communication by the Controller.
Rule 121A. Address of Communications.—

All communications in relation to any proceeding under the Act or these rules shall be addressed to the Controller at the appropriate office.

Rule 126. Form, etc., of affidavits.—

(1) The affidavits required by the Act or these rules to be filed at the patent office or furnished to the Controller shall be duly sworn to in the manner as prescribed in sub-rule (3).

(2) Affidavits shall be confined to such facts as the deponent is able, of his own knowledge, to prove except in interlocutory matters, where statements of belief of the deponent may be admitted, provided that the grounds thereof are given.

(3) Affidavits shall be sworn to as follows:—

(a) in India—before any court or person having by law authority to receive evidence, or before any officer empowered by such court as aforesaid to administer oaths or to take affidavits;

(b) in any country or place outside India—before a diplomatic or consular officer, within the meaning of the Diplomatic and Consular Officers (Oaths and Fees) Act, 1948 (41 of 1948) in such country or place or before a notary of the country or place, recognised by the Central Government under section 14 of the Notaries Act, 1952 (53 of 1952), or before a judge or magistrate of the country or place.

(4) Alterations and interlineations shall, before an affidavit is sworn to or affirmed be authenticated by the initials of the person before whom the affidavit is sworn to.

Rule 127. Exhibits.—

Where there are exhibits to be filed in an opposition or any other proceedings, a copy or impression of each exhibit shall be supplied to the other party at his request and expense; if copies or impressions of the exhibits cannot conveniently be furnished, the originals shall be left with the Controller for inspection by the person interested by prior appointment. The exhibits in original if not already left with the Controller shall be produced at the hearing.

Rule 128. Directions not otherwise prescribed.—

(1) Where for the proper prosecution or completion of any proceedings under the Act or these rules, the Controller is of the opinion that it is necessary for a party to such proceedings to perform an act, file a document or produce evidence, for which provision has not been made in the Act or these rules, he may, by notice in writing, require such party to perform the act, file the document or produce the evidence specified in such notice.

(2) Where an applicant or a party to a proceeding desires to be heard or not heard, the Controller may, at any time, require him to submit his statement in writing giving such information as the Controller may deem necessary within the time specified by him.

Rule 129. Exercise of discretionary power by the Controller.—

Before exercising any discretionary power under the Act or these rules which is likely to affect an applicant for a patent or a party to a proceeding adversely, the Controller shall give such applicant or party, a hearing, after giving him or them, ten days notice of such hearing ordinarily.
Rule 131. Form and manner in which statements required under section 146(2) to be furnished.—

(1) The statements which shall be furnished by every patentee and every licensee under sub-section (2) of section 146 in Form 27 which shall be duly verified by the patentee or the licensee or his authorised agent.

(2) The statements referred to in sub-rule (1) shall be furnished in respect of every calendar year within three months of the end of each year.

(3) The Controller may publish the information received by him under sub-section (1) or sub-section (2) of section 146.

Rule 132. Form of application for the issue of duplicate patent.—

An application for the issue of a duplicate patent under section 154 shall contain a statement setting out the circumstances in which the patent was lost or destroyed or cannot be produced together with the fee as specified therefor in the First Schedule.

Rule 133. Supply of certified copies and certificates under sections 72 and 147.—

Certified copies of any entry in the register, or certificates of, or extracts from patents, specifications and other public documents in the patent office, or from registers and other records including records in computer floppies, diskettes or any other electronic form kept there, may be furnished by the Controller on a request therefor made to him and on payment of the fee specified therefor in the First Schedule.

Rule 134. Request for information under section 153.—

(1) A request for information in respect of the following matters relating to any patent or application for patent shall be admissible, namely:—

(a) as to when a complete specification following a provisional specification has been filed or an application for patent has been deemed to have been abandoned;

(aa) as to when the information under section 8 has been filed.

(b) as to when publication of application has been made under section 11A;

(c) as to when an application has been withdrawn under section 11B;

(d) as to when a request for examination has been made under section 11B;

(e) as to when the examination report has been issued under section 12;

(f) as to when an application for patent has been refused;

(g) as to when a patent has been granted;

(h) as to when a renewal fee has been paid; (i) as to when the term of a patent has expired or shall expire;

(j) as to when an entry has been made in the register or application has been made for the making of such entry; or

(k) as to when any application is made or action taken involving an entry in the register, publication in the Official Journal or otherwise, if the nature of the application or action is specified in the request.

(2) Separate request shall be made in respect of each item of information required.

(3) The fee payable on a request to be made under section 153 shall be as set out in the First Schedule.

Rule 136. Scale of costs.—
(1) In all proceedings before the Controller, he may, subject to rule 63, award costs as he considers reasonable, having regard to all the circumstances of the case:
Provided that the amount of costs awarded in respect of any matter set forth in the Fourth Schedule shall not exceed the amount specified therein.

(2) Notwithstanding anything contained in sub-rule (1), the Controller may, in his discretion award a compensatory cost in any proceeding before him which in his opinion is false or vexatious.

Rule 137. Powers of Controller generally.—
Any document for the amendment of which no special provision is made in the Act may be amended and any irregularity in procedure which in the opinion of the Controller may be obviated without detriment to the interests of any person, may be corrected if the Controller thinks fit and upon such terms as he may direct.

Rule 138. Power to extend time prescribed.—
(1) Save as otherwise provided in the rules 24B, sub-rule (4) of rule 55 and sub-rule (1A) of rule 80, the time prescribed by these rules for doing of any act or the taking of any proceeding thereunder may be extended by the Controller for a period of one month, if he thinks it fit to do so and upon such terms as he may direct.

(2) Any request for extension of time made under these rules shall be made before the expiry of prescribed period.

Rule 139. Hearing before the Controller to be in public in certain cases.—
Where the hearing before the Controller of any dispute between two or more parties relating to an application for a patent or to any matter in connection with a patent takes place after the date of the publication of the complete specification, the hearing of the dispute shall be in public unless the Controller, after consultation with the parties to the dispute who appear in person or are represented at the hearing, otherwise directs.

25.1 With regard to procedure for obtaining information under section 153, separate request are required to be filed in respect of each item of information enlisted under rule 134 with the prescribed fee according to the applicability for natural person or for other than natural person. The agents applying for such information avail either of the amounts depending upon whether their client is a natural person or other than natural person.

25.2 The request for extension of time before the Controller under rule 138 shall be filed before expiry of the prescribed period.
### ANNEXURE - I

**THE FIRST SCHEDULE**

[See Rule 7]

**FEES**

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<td>2. (ii)</td>
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<td>3.</td>
<td>On filing a statement and undertaking under section 8</td>
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<td>On request for direction under section 20(4) or 20(5)</td>
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<td>(vii)</td>
<td>before the expiration of the 8th year in respect of the 9th year;</td>
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<td>(xi)</td>
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<td>--</td>
<td>3,000</td>
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<td>(xviii)</td>
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<td>(ii)</td>
<td>after grant of patent</td>
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<td>4,000</td>
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<td>Application under sections 57(4), 61(1) and 87(2) or to surrender a patent under section 63(3) or to a request under section 78(5).</td>
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<td>23</td>
<td>Application for withdrawing the application under section 11-B(4) and rule 26(1)</td>
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<td>24</td>
<td>On application for the entry in the register of patents of the name of the person entitled to a patent or as a share or as a mortgage or as licensee or as otherwise or for the entry in the register of patents of notification of a document under section 69(1) or 69(2) and rule 90(1) or 90(2)</td>
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<td>10,00 (In respect of each patent)</td>
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<td>On application for revocation of a patent under section 85(1)</td>
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<td>On application for revision of terms and conditions of licence under section 88(4)</td>
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<td>31</td>
<td>On request for termination of compulsory licence under section 94</td>
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<td>32</td>
<td>On application for registration as a patent agent under rule 109(1) or 112</td>
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<td>33</td>
<td>On request for appearing in the qualifying examination under rule 109(3)</td>
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<td>34</td>
<td>For continuance of the name of a person in the register of patent agent.</td>
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<tr>
<td>(ii)</td>
<td>For every year excluding the 1st year to be paid on the 1st April in each year</td>
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<td>37.</td>
<td>On a request for correction of clerical error under section 78(2)</td>
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<td>On application for review or setting aside the decision/order of the Controller under sections 77(1)(f) or 77(1)(g)</td>
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<td>On application for permission for applying patent outside India under section 39 and rule 71(1)</td>
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<td>40.</td>
<td>On application for duplicate Patent under section 154, and rule 132</td>
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<td>For certifying office copies, printed each</td>
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<td>On request for inspection of register under section 72, inspection under rule 27 or rule 74A.</td>
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<td>On request for information under sections 127, 132 and 153; and rule 135</td>
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<td>ON form of authorization of patent agent</td>
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<td>On petition not otherwise provided for.</td>
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<td>Transmittal fee for international application</td>
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<td>For preparation of certified copy of priority document and for transmission of the same to the International Bureau of World Intellectual Property Organisation</td>
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<td>On statement regarding working of a patented invention on a commercial scale in India under section 148(2) and rule 131(1)</td>
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Note: All the Forms/Applications/Requests/Notice/Petitions shall be filed in duplicate unless otherwise specified in the rules.
ANNEXURE - II
FEE DETAILS [PCT]

INTERNATIONAL FEE

INTERNATIONAL FILING FEE
- *1086 USD w.e.f. 01.01.07

Each of sheets in excess of 30
- 12 USD w.e.f. 01.10.05

SEARCH FEE (As on 1 January 2007 unless otherwise indicated)

| ISA/AT   | USD 241 |
| ISA/AU   | USD 1266 w.e.f. 01.03.2007 |
| ISA/CN   | USD 260 w.e.f. 01.03.2006 |
| ISA/EP** | USD 2059 with effect from 15.09.2006 |
| ISA/SE   | USD 2059 with effect from 15.09.2006 |
| ISA/US   | USD 1000 with effect from 01.01.2004 |

PCT-EASY

REDUCTION : 78 USD With effect from 01/01/2006

* Fee reduced by 75% for Natural person from INDIA.
** Fee reduced by 75% for Natural person from INDIA.

TRANSMITTAL FEE :
INR 2000/- FOR INDIVIDUAL
INR 8000/- FOR COMPANY/LEGAL ENTITY

PRIORITY DOCUMENT FEE :
INR 1000/- FOR INDIVIDUAL
INR 4000/- FOR COMPANY/LEGAL ENTITY
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Annexure IV

CASES INCLUDED IN THE MANUAL OF PATENT PRACTICE AND PROCEDURE

2. Lakhapati Rai & Ors. v. Srikissen Dass & Ors. (1917)
3. Raj Parkash v. Mangat Ram Choudhary
4. M/S. Sunrise Associates v. Govt. Of NCT Of Delhi & Ors,
5. Shri Kirshna Gyanoday Sugar Ltd. & Anr. v. State Of Bihar
6. Ganesh Mulji Rikabchand (applicant) v. Mischmetal and Flints Limited (opponent) DPD, VOL.1, P.126,
7. Ammonia’s Application, 49 RPC 409
8. T204/83 (OJEPO 10/85 )
11. Monsanto Brignac’s Application, [1971] RPC 153, 23
18. Norton Healthcare Ltd v. Beecham Group Plc
19. Union Carbide Corp. v. BP Chemicals Ltd [1998]


31. Decision of the Controller patent application No. 23077


33. Monsanto Co. V. Coromandel Indag Products (P) Ltd. 1986 A.I.R. 712

34. Decision of Controller patent application No.23077

35. Decision of Controller patent application No.29180

36. Lux Traffic Controls Ltd v Pile Signals Ltd and Faronwise Ltd, [1993] RPC 107

37. T482/89 OJEPO 11/92

38. G1/92 OJEPO 5/93


40. Ram Narain Kher v. Ambassador Industries, (AIR 1976 Del 87.)

41. Staridipack Private Limited v. Oswal Trading Co. Ltd (1999 (19) PTC 479 (Del)
42. Milliken Denmark AS v Walk Off Mats Ltd and anr [1996] FSR 292
43. T84/83 1979-85 EPO R 796
45. Decision of the Controller patent application No.26209
46. Decision of the Controller patent application No.27208
47. Decision of the Controller patent application No.31894
51. Centron Industrial Alliance Private Limited v Harbans Lal Malhotra and Sons Private limited, [DPD, Vol.1, p 133]
52. IG Farbenindustrie AG's Patent, 47 RPC 289 P.322
56. [1985] RPC 59, p. 77-37
57. Technograph v. Mills and Rockley(1972 RPC 346 at p-355(HL)
58. Dow Chemical Company (Mildner's Patent), [1973] RPC 804
59. NEC Corporation’s Application (BL O/038/00))
60. Decision T 176/84, OJEPO 2/86
62. The Windsurfing International Inc. v. Tabur Marine (Great Britain) Ltd[1985] RPC 59,
63. T 37/85, T 666/93, T 1018/96
64. T 388/89, T 717/90, T 869/96
65. T 406/98
66. T 597/93, T 687/94
68. Tetra Molecrtic Ltd v. Japan Imports Ltd ([1976] RPC 547
70. T 141/87, T 99/89
71. T 986/96
72. T 424/90
73. T 164/92
74. T 222/86
75. T 500/91
76. T 500/91
77. T 455/91 (OJ 1995, 684
78. T 441/93
79. Sanjiv Agarwal, Fairfest Media Private Limited
80. Minnesota Mining & Manufacturing Co v Rennicks Ltd [1992] RPC 331
83. PLG Research Ltd v. Ardon International Ltd, [1993] FSR 197
86. T119/82, OJEPO 5/84
90. Angiotech Pharmaceuticals Inc’s [2006] RPC 28
91. [2007] RPC 20
92. Bayer AG (Baatz's) European Application [1982] RPC 321
93. 47 RPC 289, P 322-3
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