



INTELLECTUAL

PROPERTY **INDIA**

PATENTS / DESIGNS / TRADEMARKS /  
GEOGRAPHICAL INDICATIONS

# MANUAL OF PATENT PRACTICE AND PROCEDURE

## PATENT OFFICE, INDIA

2005

[Note: This is a draft manual. Any suggestion, indication of error etc. may be sent to the Controller General of Patents, Designs and Trademarks, Old CGO Building, 101, M.K. Road, Mumbai -400020 by **20<sup>th</sup> June, 2005.**]

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**[The contents of this manual including the guidelines are merely for the purpose of illustrations and not meant for legal purposes. In case of any conflict, legal provisions of the Patents Act will prevail].**

## **OPENING REMARKS**

This manual is intended to give guidelines relating to the practice and procedure to be followed in examination of patent applications in India with a view to establish a uniformity and homogeneity in the processing of the applications in patent offices. Existing manual of the patent office is now being up dated to include new provisions of the law viz. The Patents Act, 1970 as amended by the Patents (Amendment) Act of 1999, the Patents amendment Act 2002, and further, by the Patents (Amendment) Ordinance 2004 Act 2005.

It also aims to make industries, R&D organizations, individual researchers and inventors familiar with the patent system in India and to provide a user-friendly system for obtaining as well as maintaining patents under the existing patent law. It is expected that this manual will be of considerable use to the target user who are engaged in innovative and inventive activities in developing and marketing new products and technologies.

Reference to decisions of the Courts of India and other countries has been given. The decisions of our Courts provide us guidance in the application of law and those of other countries are useful in understanding as to how they have interpreted their law in their legal and social environment.

Due care has been taken to avoid errors and confine to the relevant standards, but there may be some shortcomings. Any indications of errors and suggestions to improve the quality will be appreciated.

**S.CHANDRASEKARAN**  
**Controller General of Patents, Designs &Trade Marks**

# CHAPTER I

## INTRODUCTION

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Patents are granted by the Government, for the commercial exploitation of an invention for a specific period of time in consideration of the disclosure of the invention so that on expiry of the terms of the patent the information can benefit the public at large.

In order to invent something new and to develop it to a stage that is commercially viable huge investments in terms of money and labour are necessary in addition to the intellectual activity. But when the invention is revealed, it comes to public domain and hence the inventor has to meet with competition from his rival manufactures and therefore the return of investment is not guaranteed. That is why many people try to work the invention secretly but the risk of his invention being subjected to 'reverse engineering' persists. Therefore, the importance of patent system lies in that it averts an impasse to technical advancement, which might occur otherwise. The patent system also provides a social benefit as it bestows monetary reward for revealing technological innovation along with accolades for the inventor (*Patent is an award for the inventor and a reward for the investor*). The grant of patent for an invention attracts investment because the commercial exploitation of the invention is possible to its fullest extent during the term of patent. Another major advantage of the patent system is that it promotes 'invent around' concept. Patent is granted only when the invention and its operation or use and the method by which it is to be performed are fully disclosed. When the patentee launches the product (in which the invention is incorporated) in the market, his competitors may lose the market if the product is technically advanced and cheap as compared to the existing one. The patentee can prevent others from manufacturing the same product without his authorization and can resort to legal means to enforce his right. But the competitors have an option to 'invent around' the patented product by conducting further research around to bring out a better invention, which may result in cheaper and better product. It paves the way for healthy competition among manufacturers that results in day-to-day improvement of technology. Ultimately, it contributes to the economic growth of the country and thereby enhancing living standard of the people.

By virtue of the grant, patentee gets the exclusive right to prevent the third parties (not having his consent) from the act of making, using, offering for sale, selling or importing the patented product or process within the territory of grant.

Indian Patent Act provides the measure for an effective patent system, which brings about incentives for technological advancement in the country.

## BACKGROUND OF INDIAN PATENT SYSTEM & LAW

1. The first provision in the nature of patent rights in India, which was at that time under the British rule, was enacted in 1856. Under this Act, the monopolies were styled " exclusive privileges ". This Act was repealed in toto in 1857 as it was introduced without the prior sanction of the Queen. Soon after that in 1859 another Act free from the defects of 1857 was passed. In 1872 the provision of the Act of 1859 were further added by the provision of " The Patents and Designs Protection Act ", which solely related to designs. The Act of 1872 was further supplemented in 1883. In 1888 all the Acts of 1859, 1872 and 1883 were superseded by Act V of 1888. This was further revised and replaced by the Indian Patents and Designs Act, 1911. This was amended from time to time in 1920, 1930, and 1945.
2. After independence it was felt that the Indian Patents and Designs Act, 1911 was not fulfilling its objective. As such, a committee under the Chairmanship of Dr. Bakshi Tek Chand, a retired Judge of Lahore High Court was appointed in 1949 with a view to ensure that the Patent system was more conducive to national interest and to suggest modifications and alterations to the existing Act suitable for making the country self-reliant in technology. Based on the interim report the Act was modified, regarding working of the inventions in 1952, and in 1953 the Controller was authorized to grant licenses on foods, medicines etc. A bill based on the recommendations of this Committee was introduced in the Parliament in 1953, but it lapsed due to dissolution of the Lok Sabha.
3. In 1957, Govt. of India further appointed Justice N. Rajagopala Ayyangar to examine and review the Patent law in India who submitted his report in September 1959 recommending the retention of Patent System despite its shortcomings. The Patent Bill, 1965 based mainly on his recommendations and incorporating a few changes, in particular relating to Patents for food, drug, medicines, was introduced in the lower house of Parliament on 21st September, 1965. The bill was passed by the Parliament and the Patents Act 1970 came into force on 20<sup>th</sup> April 1972 along with Patent Rules 1972. This law was suited to changed political situation and economic needs for providing impetus to technological development by promoting inventive activities in the country.
4. The Patents Act, 1970 is a landmark in the industrial development of India. The basic philosophy of the Act is that patents are granted to encourage inventions and to secure that these inventions are worked on a commercial scale without undue delay; and patents are granted not merely to enable patentee to enjoy a monopoly for the importation of the patented article into the country. The said philosophy is being implemented through compulsory licensing, registration of only process patents for food, medicine or drug, pesticides and substances produced by chemical processes which, apart from chemical substances normally understood, also include items such as alloys, optical glass, semi-conductors, inter metallic compounds etc. It may, however, be noted that products vital for our economy such as agriculture & horticulture products, atomic energy

inventions and all living things are not patentable. Thus, the Patents Act 1970 was expected to provide a reasonable balance between adequate and effective protection of patents on the one hand and the technology development, public interest and specific needs of the country on the other hand.

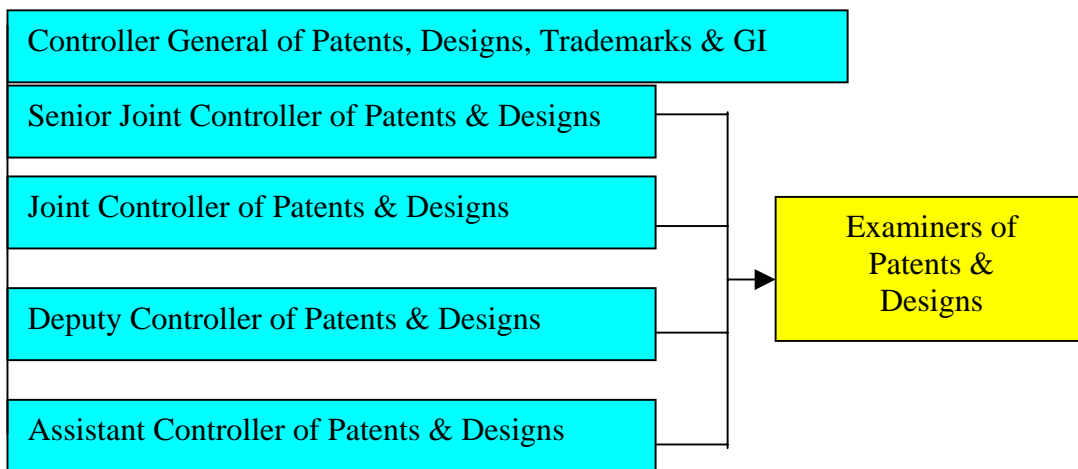
5. Uruguay round of GATT negotiations paved the way for WTO. Therefore India was put under the contractual obligation to amend its patents act in compliance with the provisions of TRIPS. India had to meet the first set of requirements on 1-1-1995. This was to give a pipeline protection till the country starts giving product patent. It came to force on 26<sup>th</sup> March 1999 retrospective from 1-1-1995. It lays down the provisions for filing of application for product patent in the field of drugs or medicines with effect from 01.01.1995 and grant of Exclusive Marketing Rights on those products.
6. India amended its Patents Act again in 2002 to meet with the second set of obligations (Term of Patent etc.), which had to be effected from 1-1-2000. This amendment, which provides for 20 years term for the patent, Reversal of burden of proof etc. came into force on 20<sup>th</sup> May, 2003. The Third Amendment of the Patents Act 1970, by way of the Patents (Amendment) Ordinance 2004 came into force on 1<sup>st</sup> January, 2005 incorporating the provisions for granting product patent in all fields of Technology including chemicals, food, drugs & agrochemicals and **this Ordinance is replaced by the Patents (Amendment) Act 2005 which is in force now having effect from 1-1-2005 .**
7. Under the Patents Act, the Government of India is empowered to make rules for implementing the Act and regulating the Patent Administration. Accordingly, the Government brought into force Patents Rules, 1972 w.e.f. 20.4.1972. These Rules were amended on 2.6.99 and replaced by the Patents Rules 2003 w.e.f. 20.5.2003 and further it is amended by the Patents (Amendment) Rules 2005, which is in force now; this includes provisions relating to time-lines with a view to introducing flexibility and reducing processing time gradually for patent applications, and simplifying and rationalizing procedure for grant of the patent.
8. There are four Schedules to the Patents (Amendment) Rules 2005; the First Schedule prescribes the fees to be paid; the Second Schedule specifies the list of forms and the texts of various forms required in connection with various activities under the Patents Act are set out in this schedule. These forms are to be used wherever required and if needed, they can be modified with the consent of the Controller. The Third Schedule prescribes form of Patent to be issued on Grant of the Patent. The Fourth Schedule prescribes costs to be awarded in various proceedings before the Controller under the Act.



## **ESTABLISHMENT OF PATENT ADMINISTRATION IN INDIA**

Patent system in India is administered under the superintendence of the Controller General of Patents, Designs, Trademarks and Geographical Indications. The Office of the Controller General functions under the Department of Industrial Policy and Promotion, Ministry of Commerce and Industry. Controller General's office is in Mumbai. There are four patent offices in India. The Head Office is located at Kolkata and other Patent Offices are located at Delhi, Mumbai and Chennai. The Controller General delegates his powers to Sr. Joint Controller, Joint Controllers, Deputy Controllers and Assistant Controllers. Examiners of patents in each office discharge their duties according to the direction of the Controllers.

### Hierarchy of Officers in Patent office



## CHAPTER II

### PATENTABLE SUBJECT MATTER

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#### 2.1 Patentable Inventions:

A patent can be granted for an invention which may be related to any process or product. The word "Invention " has been defined under the Patents Act 1970 as amended from time to time.

*"An **invention** means a new product or process involving an inventive step and capable of industrial application" (S. 2(1)(j))*

**" new invention" is defined 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;**

Where,

***Capable of industrial application**, in relation to an invention, means that the invention is capable of being made or used in an industry (S.2 (1)(ac))*

Therefore, the criteria for an invention to be patentable are,

- (1) An invention must be novel
- (2) has an inventive step and
- (3) is capable of industrial application

#### 2.2 Novelty of the invention:

A novel invention is one, which has not been disclosed, in the prior art where prior art means everything that has been published, presented or otherwise disclosed to the public on the date of patent (The prior art includes documents in foreign languages disclosed in any format in any country of the world.) For an invention to be judged as novel, the disclosed information should not be available in the 'prior art'. This means that there should not be any prior disclosure of any information contained in the application for patent (anywhere in the public domain, either written or in any other form, or in any language) before the date on which the application is first filed i.e. the 'priority date'.

Therefore, an invention shall be considered to be new, if it does not form part of the prior art. Although the term prior art has not been defined under the Indian Patents Act, it shall be determined by the provisions of section 13 read with the provisions of sections 29 to 34.

(a) An invention shall not be considered to be novel if it has been anticipated by publication before the date of the filing of the application in any of the specification filed in pursuance of application for patent in India on or after the 1<sup>st</sup> day of January 1912.

(b) An invention shall not be considered to be novel if it has been anticipated by publication made before the date of filing of the application in any of the documents in any country.

(c) An invention shall not be considered to be novel if it has been claimed in any claim of any other complete specification filed in India which is filed before the application but published after said application.

(d) An invention shall not be considered to be novel if it has been anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.

### 2.3 Inventive step (Non-obviousness)

**Inventive step is a feature of an invention that involves technical advance as compared to existing knowledge or having economic significance or both, making the invention non obvious to a person skilled in art. Here definition of inventive step has been enlarged to include economic significance of the invention apart from already existing criteria for determining inventivestep.**

An invention shall not be considered as involving an inventive step, if, having regard to the state of the art, it is obvious to a person skilled in the art.

To judge the inventive step, the following question is to be borne in mind- "Would a non-inventive mind have thought of the alleged invention?". If the answer is "No", then the invention is non-obvious.

For the purpose of determination of inventive step the prior art shall include the prior publication in relevant field.

The term "**obvious**" means that which 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 should be 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.

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

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

The invention must 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.

If a claim comprises mere juxtaposition of parts or components, for example, a composition comprising known ingredients, such a juxtaposition is likely to be obvious, unless it leads to some effect, say synergistic effect.

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

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

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. It is not generally necessary to show that the prior art does not have the same effect as the product of the invention or that there is some "inventive distance" between the invention and the prior art.

While determining the inventive step in the invention, following may be considered by examiner:

- (a) 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) differences between the relevant prior art and the claimed invention
- (d) defining the technical problem to be solved as the object on 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.

## **2.4 Industrial Applicability: -**

An invention is capable of industrial application if it satisfies three conditions,

Cumulatively:

- Can be made;
- Can be used in at least one field of activity;
- Can be reproduced with the same characteristics as many times as necessary

1. An invention to be patentable must be useful. If the subject matter is devoid of utility it does not satisfy the requirement of invention.
2. For the purpose of utility the element of commercial or pecuniary success has no relation to the question of utility in patent law.
3. The usefulness of an alleged invention depends not on whether by following the directions in the complete specification all the results not necessary for commercial success can be obtained, but on whether by such directions the effects that the application/patentee professed to produce could be obtained.
4. The meaning of usefulness is therefore useful for the purpose indicated by the applicant or patentee whether a non-commercial utility is involved.
5. The usefulness of the invention is to be judged, by the reference to the state of things at the date of filing of the patent application, if the invention was then useful, the fact that subsequent improvements have replaced the patented invention render it obsolete and commercially of no value, does not invalidate the patent.
6. Speculation or imaginary industrial uses are not considered to satisfy the industrial application requirement.

## 2.5 Unity of Invention:

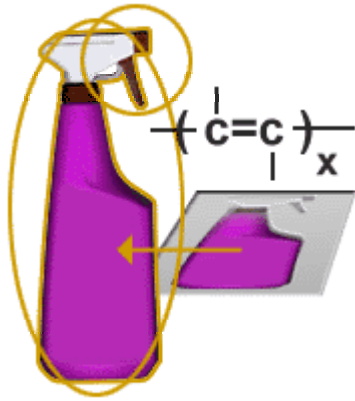
*“The claim or claims of a complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept shall be ,... ..” (S. 10(5))*

It means that all the claims in the application for patent must refer to the same inventive idea. i.e. they must all share one inventive concept.

### **Different categories of independent claims stating unity of invention:**

- Product, process for its manufacture and use of the product
- Process and apparatus for carrying out the process
- Product, process for its manufacture and apparatus for carrying out the  
Process

**EXAMPLE (1)** If one has invented a new kind of spray bottle patents may be granted for -



- The bottle itself (a product)
- A chemical in the plastic (chemical composition)
- The spraying mechanism (an apparatus)
- How you extruded the plastic (a process)

**EXAMPLE (2)** Similarly Gene Sequence-

- New gene sequence A
- A method of expressing sequence A
- An antibody made to the protein of sequence A
- A kit made from the antibody to sequence A

All of these claims are linked by the inventive concept that sequence A is new and inventive. Therefore anything based on sequence A must share this property too.

**EXAMPLE (3)** Similarly biopolymer produced from a genetically modified organism

- Biopolymer
  - Process for manufacture of biopolymer and use of the polymer
  - Biopolymer, process for its manufacture and its use or application.
- These things constitute unity of invention

**2.6 Sufficiency of Disclosure**

“Every complete specification shall –

- a) fully and particularly describe the invention and its operation or use and 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 .....
- ” (S. 10(4))

It means that the complete specification (techno-legal document describing the invention) should disclose the invention completely so that a person skilled in the art can perform the invention. Complete specification shall contain the details of deposition and the source and geographical origin of the biological material if such material is mentioned in specification.

## 2.7 CLARITY OF CLAIMS

“ The claim or claims of a complete specification shall be clear and succinct and shall be fairly based on the matter disclosed in the specification” (S. 10(5))

It therefore involves the investigation of-

- a) Whether the claims are clearly or properly worded
- b) Whether the claims are succinct
  - i) Are they of unnecessary repetition?
  - ii) Are they verbose?
  - iii) Are they large in number?
  - iv) Are they redundant?
- c) Whether the claims sufficiently define the invention
- d) Whether the claims are fairly based on the matter disclosed in the specification and supported by description and consistent with the description.

## **2.8 NOT PATENTABLE INVENTIONS**

There are some products and processes, which are not patentable in India They are classified into two categories in the patent act

- a) Those which are not inventions (S.3)
- b) Invention relating to atomic Energy (S.4)

### Various types of non-patentable inventions under Section 3 are as follows-

#### **3(a) An invention which is frivolous or which claims anything obvious contrary to well established natural laws.**

Merely making in one piece, articles, previously made in two or more pieces is frivolous. Mere usefulness is not sufficient (**Indian vacuum brake co. ltd vs. Laurd (AUR 1962 CAK 152)**).

Perpetual motion machine alleged to be giving output without any input is not patentable as it is contrary to natural law.

#### **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**

- (i) The invention, the use of which is contrary to the law for the time being in force or use of which is prohibited, is not patentable e.g. any device, apparatus or machine for thefts or committing or injuring human beings.
- (ii) If the inventions, the use of which is found to be injurious to public health are also not patentable e.g. Method of adulteration of food.



**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;**

- (i) Claim for discovery of scientific principle is not patentable, but such a principle when used with process of manufacture resulting into a substance, or an article, is patentable.
- (ii) Scientific theory is a statement about the natural world. These theories themselves are not patentable no matter how radical or revolutionary insight they provide, but if they lead to practical application in the process of manufacture of article or substance, may well be patentable.

The claim for formulation of abstract theory is not patentable on the ground that they do not result in a product or process. There is a difference between discovery & invention. The discovery adds to the amount of human knowledge by disclosing something, which has not been seen before, whereas an invention also adds to the human knowledge by suggesting an act, to be done and is not patentable.

- (iii) Although a new method of calculation is not an invention but new application for performing that method resulting into a process or product, or new apparatus for carrying out that method can be considered patentable. But it must be distinguished from non calculating application by technical features for e.g. A guide rule differing from known rules only in the scales is not 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.

- I. Mere discovery of new property is not patentable invention e.g. a mere discovery of a new property of the substance such as aspirin for use of treatment of some other disease cannot be considered patentable in mere use of Aspirin for cardio-vascular disease, which was earlier used for analgesic purpose, is not patentable. However, a new and alternative method for preparing Aspirin is patentable.

- II. New use for a known substance is also not patentable; it means 2nd or 3rd use for a known substance cannot be allowed.
- III. 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.

"Metric time showing Device" (101/Bom/72) was held not patentable.

The

device comprises a normal clock or watch having usual hands for indicating hours, minutes and seconds, wherein dial or like visual numerical indicators are divided into 10 large divisions for hours, hours divisions are divided into 100 divisions indicating minutes and each minute divided into 100 parts representing seconds. It was held to be a mere use of known device hence not patentable.

**[Note: Before amendment of Section 3 (d) by the Patents (Amendments) Ordinance 2004 it reads as "mere discovery of any new property or new use for a known substance or mere use of a known process, machine or apparatus..."The insertion of the word "mere" before 'new use for a known substance' in this clause by the Patents (Amendment) Ordinance 2004, is for the purpose of drafting clarity only as without it the sub-section would have remained ambiguous. This does not restrict the non-patentability and give rise to ambiguity and possible misuse. There is no need of giving wider meaning to it.]**

- 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:**

Example:

(i) A mixture of sugar and some colorants 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.

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. Hence they are patentable.

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.

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.

(ii) Anti-perspirants compositions for application to human skin (63/Bom/75) was held not patentable. The said composition comprises of: (a) non-cellulosic moisture absorbing polymer capable of absorbing moisture at least equivalent to its weight, and (b) a carrier. The composition was held mere admixture for the reason that the composition has got the total sum of the properties of two components namely, the properties of absorbent polymer to absorb moisture or to absorb perspiration on being applied to human skin, which has not been in any way influenced by the presence of said carrier to act as carrier or diluents.

(iii) 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 reasons that the composition is mere admixture of two drug components resulting into aggregation of properties thereof since Paracetamol is well known for treatment of fever and other one for treatment of pain.

However, if the mixture of drugs can give some unexpected results or synergistic properties in the treatment, then the process of preparation of such composition may be considered patentable.

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

(i) A mere juxtaposition of known devices in which each device functions independently are not 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., Vs Courtaulds Ltd (52) RFC 171) e.g.: a floor mill provided with sieving means).

However where the old integers where placed together have some working inter relation producing a new or improved results, then there is a patentable subject matter in the idea of the working interrelation brought about the collocation of the integers.

(ii) A mere juxtaposition of features already known before the priority date which have arbitrarily been chosen from among a number of a different combinations which could be chosen is not a patentable invention. 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 should be held to have been already known (Rampratap vs. Bhabha Atomic Research Center, 1976 IPLR 28 P. 35)] Umbrella with fan (388/Bom/73), Bucket fitted with torch, Clock and transistor in a single cabinet. They are not patentable since they are nothing but mere arrangement and rearrangement without having any working interrelationship between them and functioning independently of each other.

iii) Another example is of 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.

**3(h) A method of agriculture or horticulture.**

- (i) 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 Gloeiampnenfabrieken's Application 71 RFC 192**).
- (ii) A method of producing improved soil from 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**).
- (iii) A method of producing mushroom plant and a method for cultivation of an algae (264/Cal/79) were held not patentable [445/Del/93].

**3(i) Any process for the medicinal, surgical, curative, prophylactic diagnostic therapeutic or other treatment of human being 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.**

- (i) A method of treatment of malignant tumor cells and method of removal of dental plaque and carries are not patentable. Since they are held to be treatment of human beings
- (ii) The art of curing illness cannot be said to be patentable  
RFC 219, the patent courts in UK held that *the* term therapy included the prevention as well as the treatment or cure of disease, therefore any process relating to therapy is also not patentable.
- (iii) Prophylactic treatment such as vaccination, inoculation is to be regarded as therapy, which include treatment. The same consideration applies for animal as well as for human beings. For example prophylactic immuno-therapy in animals are regarded as therapy.
- (iv) An application of substance to human body purely for cosmetic purpose 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 instance of medical treatment. To be treatment in relevant senses it seems that the purpose of the application to the body whether a substance or a process must be the arrest or cure of a disease or diseased condition or correcting of some malfunction or amelioration of some incapacity or disability (Joos Vs. Commissioner of Patent (1973) RFC 59).
- (v) It was held in Lee Pharmaceuticals application (1978) RFC 51 that since one of the results of grant pits and fissures in teeth was to prevent the onset of dental decay, the purpose of the treatment was therapeutic rather than cosmetics.
- (vi) Patent may however be obtained for surgical therapeutic or diagnostic instrument or apparatus.

- (vii) In *Oral Health Products Inc (Habtead's Application, (1977) RFC 612)*, the 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 *IC1 Lid's Application No 7827383 (not reported)*, 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 preventive in nature (such as vaccination) must at times be applied to people who would have remained healthy anyway, but they remained medical treatments.

Dictionary definitions of "diagnosis" clearly point to it being essentially concerned with identifying problems. The questions to be asked therefore, in order to determine whether a method constitutes diagnosis for the purposes of the Act, are

- a) Does the method, unaided by other tests, indicate whether or not a person (or animal) is suffering from a medical disorder? and
- b) Does the method identify the disorder where it is found to be present?

If both of these questions can be answered in the affirmative, the method is diagnosis and is not patentable

- (ix) Surgery is defined as the treatment of disease or injury by operation or manipulation (SOED, Stedman, and MacNalty). 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.
- (x) **In Unilever Limited (Davis<sup>1</sup>) Application, [1983] RFC 219** (see also 4.08, 4.09), Falconer J observed that any method of surgical treatment, whether curative, prophylactic or cosmetic, is not patentable. This view, which was obiter, was cited by the hearing officer in *Occidental Petroleum Corporation's Application (not reported)* in 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.
- (xi) Methods of treatment of the human or animal body by surgery or therapy are excluded, as are methods of diagnosis practiced on the human or animal body. Methods of diagnosis performed on tissues or fluids, which have been permanently removed from the body, are therefore not excluded. "Body" should be taken to mean living body, and a method practiced on a dead body, for example in order to determine the cause of death, would not be excluded. 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] RFC 684*). In *Ciba-Geigy AG's Application (not reported)*, 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.

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

**Example: Clones and new variety of plants are not patentable. But process / method of preparing Genetically Modified Organisms are patentable subject matter.**

**The Guidelines for examination of Biotechnological inventions are given in Annexure 1**

3(K) a mathematical or business method or a computer program per se or algorithms.

computer program product is claimed as "A computer program product in computer readable medium", "A computer-readable storage medium having a program recorded thereon", etc. In such cases the claims are treated as relating to software per se, irrespective of the medium of its storage and are not held patentable.

Examples in respect of other categories of subject matter are

Scheme or method of bookkeeping.

Business method in the field of accounting.

Method of tax collection.

**A contents display method for displaying contents on a screen,**

**A method for controlling an information processing apparatus, for communicating via the Internet with an external apparatus,**

**A method for transmitting data across an open communication channel on a wireless device that selectively opens and closes a communication**

**channel to a wireless network, and each wireless device including a computer platform and including a plurality of device resources that selectively utilizes a communication channel to communicate with other devices across the network**

**All the above methods though utilise computer programs for its operation, are not computer programs as such and hence allowable**

**On the other hand,**

**A method of executing a computer program, in which at least part of the copy of the program available for execution is analysed to determine whether or not any change has been made thereto, and in the event that a change is detected, a further copy of the program is retrieved and caused to be executed instead of the first copy,**

**A method for generating a new computer program using a software development tool,**

**These are the programs solely intellectual in its context and hence not allowable.**

**The Guidelines for examination of Computer-related inventions are given in Annexure 2**

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

Examples: Writings, music, works of the fine arts, paintings, sculptures, computer programs, electronic databases, books, pamphlets, other writings; lectures, addresses, sermons, dramatico-musical works, choreographic works, cinematographic works, drawing, painting, architecture, sculpture, engraving and lithography, photographic works, applied art; illustrations, maps, plans, sketches and three-dimensional works relating to geography, topography, architecture, translations, adaptations, arrangements of music, multimedia productions.

**3(m) A mere scheme or rule or method of performing mental act or method of playing game;**

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

Examples: Method of learning a language.  
Method of playing chess.  
Method of teaching.  
Method of learning  
Method of operating a machine or equipment

**3(n) A presentation of information**

Examples: 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.

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

**3(o) Topography of integrated circuits;**

Examples: Three-Dimensional configuration of the electronic circuits used in microchips and semiconductor chips.

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;



## INVENTIONS RELATING TO ATOMIC ENERGY (S.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)”*

- (i) According to Sec. 20(1) of Atomic Energy Act, as from the commencement of this Act, no patent shall be granted for the invention when in the opinion of Central Govt. are 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.
- (ii) According to Sec. 2(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.
- (iii) Under this Act "prescribed substances" means any substances including any mineral which the Central Govt. 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.
- (iv) Under the atomic energy Act, the term "radioactive substances" or "radioactive material" is defined as any substance or material, which spontaneously emits, radiation in excess of the levels prescribed by notification by the central govt.
- (v) The Secretary, Deptt. Of Scientific Research, vide his letter no. AEC/21(28)/50/68437 Dated 12/12/1950 has directed that the Central Govt. is pleased to prescribe uranium minerals of, thorium, beryllium, vanadium, lithium and other minerals containing the said metals as necessary ingredients such as urani-ferous allamiti, Triplita, Colourmbite and Tantalite as substance which in its opinion are or may be used for the production or use of atomic energy or research under Atomic Energy Act.
- (vi) The central govt. vide its letter No. AEC/27(2)/50/358 dated 28.1.1951 has declared "Ilmenite" as substance for the production or use of atomic energy.
- (vii) The Central Govt. vide its letter No. AEC/DIH/1/(7)/52/2696 dated 19.5.53 by superseding the earlier notification has prescribed the substances specified in the following schedule & any of the respective compound as substances for the production or use of atomic energy under the Atomic Energy Act.

### **THE SCHEDULE**

Uranium, Thorium, Radium, Zirconium, Graphite, Beryllium, Lithium, Deuterium, Plutonium, Neptunium, Columbite, Tantalite, Titanium ores and concentrates (Ilmenite, Rutile, Leucoxene)

The Central Govt. has power to amend the schedule and may issue a notification at any time.

## CHAPTER III

### APPLICATION FOR PATENT

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#### 3.1 Persons entitled to apply for a Patent in India (S.6)

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

- a) True and first Inventor
- b) His/her assignee
- c) Legal representative of deceased inventor or assignee.

#### Explanations

1. **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 (**S. 2(1)(y)**). The applicant should disclose the name, address and nationality of the true and first applicant
2. Assignee can be a **natural person** or other than natural person like registered company, research organization, educational institute or **Government** (S.2 (1)(s)). **Assignee** includes assignee of the assignee also (**S. 2(1)(ab)**). '**Proof of right**' to apply such as assignment deed should be submitted by the assignee.
3. **Legal representative** means a person who in law represents the estate of a deceased person (**S.2 (1)(k)**). In such a case, they should file death certificate etc. as proof of right

*The applicant must be a national of India or of a convention country.*

**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 which India is also a party to be a conventional country/countries for the purpose of the Act (U/S133) as one who 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. (**S.133 & S.134**).

4. The prescribed fee for making application of patent and other proceedings are different for a natural person and other than natural person.

### 3.2 Where to apply? (Rule. 4)

Application for the patent has to be filed in the respective patent office as mentioned below where the territorial jurisdiction is decided based on whether any of the following occurrence 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)**

A foreign applicant should give an address for service in India and the jurisdiction will be decided upon that. An applicant (Indian or foreigner) also can give his Patent Agent's address as address for serving documents if he/she wishes so.

Patent Offices	Territorial jurisdiction
Mumbai	The states of Gujarat, Maharashtra, Madhya Pradesh, Goa, Chhattisgarh, the union territories of Daman and Diu and Dadra and Nagar Haveli.
Delhi	The states of Haryana, Himachal Pradesh, Jammu and Kashmir, Punjab, Rajasthan, Uttar Pradesh, Uttaranchal, National capital territory of Delhi and the union territory of Chandigarh.
Chennai	The states of Andhra Pradesh, Kamataka, Kerala, Tamil Nadu and the union territories of Pondicherry and Lakshadweep.
Kolkata (Head office)	Rest of India

Application for patent (Form 1) **in duplicate** should be accompanied by the following documents. The fee (Rs.1000/- for natural person or Rs.4000 /- for other than natural person) can be paid within one month **(Rule 7(2)(c))**

- a) **Provisional or complete specification (Form 2)** and drawings (if any) **in duplicate (Rule 13 & Rule 15)**
- b) Statement and undertaking regarding foreign filing details in respect of the same invention (Form 3) **(S. 8(1) & R. 12)**
- c) Declaration as to Inventor ship (Form 5) (In the case of a **convention application and PCT National phase application and fling complete after provisional ) (S. 10(6) & Rule 13(6))**
- d) Priority document (if it is a convention application) **(S. 138)**
- e) Power of attorney (Form 26)(if the application is made through a patent agent) **(Rule 135(1))**
- f) 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 (Endorsement in Form1) or by way of separate assignment deed. If the

application is made by the legal representative '*death certificate*' of the deceased should be filed as proof of right. *Proof of right may be submitted within three months of application*)

### **Why 'Provisional' specification?**

When the applicant finds that his invention has reached a presentable form, then he may prepare a disclosure of the invention in the form of a written description and submit it to patent office. This disclosure is called a provisional specification. *By filing a provisional specification that simply describes the nature of the invention, the applicant attains the priority over any other person who is likely to file an application for patent in respect of the same invention being developed concurrently in some other part of the world.*

Immediately on receiving the provisional specification the patent office accords a filing date for the application and confers a period up to twelve months for filing the complete specification (*with a declaration as to inventor ship in Form5*) during which the applicant can fully develop his invention by himself or with the help of capitalists who are interested in the economic value of the patent The complete specification can also be submitted before twelve months

### **3.4 Information and undertaking regarding foreign applications**

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 along with his application or within three months from the date of filing .(U/S 8(1),U/R 12(1A)).

An application for Patent should also accompany by a statement and undertaking in form 3. If there is no foreign filing, the applicant can give NIL statement. As per the amended Act the time period for filing form 3 can be allowed by the Controller. It shall contain

(a) Statement setting out detailed particulars of such application including the name of the country, Application number and status of such application; and.

(b) An undertaking that, up to the date of the grant of his complete specification filed 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 three months of such filing (U/R12(1A)2),U/S 8(1)).

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 three months from the date of receipt of the communication requiring such furnishing of information.

In case of delay in furnishing the details beyond three months, the applicant can rectify the same by seeking extension of time in prevalent form along with a petition under rule 138.

### **3.5 General Precaution For The Applicant**

It is a common experience that through ignorance of patent law, inventors act indiscreetly and jeopardize the chance of obtaining patents for their inventions. The most common of these indiscretions is to publish their inventions in newspapers or scientific and technical journals, before applying for patents. Publication of an invention, even by the inventor himself, would (except under certain rare circumstances) constitute a bar for the subsequent patenting of it. Similarly, the use of the invention in public, or the commercial use of the invention in public or even in secrecy, prior to the date of the patent would be a fatal objection to the grant of a patent for such invention thereafter. However, the secret working of the invention by way of reasonable trial or experiment, or to the disclosure of the invention to other confidentially may not result into loss of novelty.

Another mistake, which is frequently made by inventors, is to wait until their inventions are fully developed for commercial working, before applying for patents. Delay in making application for a patent involves risks, namely, (i) that other inventors might forestall the first inventor in applying for the patent, and (ii) that there might be either an inadvertent publication of the invention by the inventor himself, or the publication thereof by others independently of him. It is, therefore, advisable to apply for a patent as soon as the inventor's idea of the nature of the invention has taken a definite shape. In this connection inventors should note that it is permissible to file an application for a patent accompanied by a "Provisional Specification".

Another matter, which should not be neglected by inventors, is the clarification of their rights with reference to those of their employers, co-workers, contractors and assistants, if any, with whom they are brought into contact in the course of the development of their inventions. Neglect in this direction may lead to costly litigation.

### **3.6 Various types of Patent Applications in India**

1. Ordinary application
2. Convention application
3. PCT international application
4. PCT National phase application
5. Application for Patent of addition
6. Divisional Application

### **Ordinary Application (S.7)**

An application for patent made in the Patent office without claiming any priority of application made in a convention country or without any reference to other application under process in the office is called an ordinary application.

### **Convention Application (S.135)**

When an applicant comes to the patent office with an application claiming a priority date based on a similar application filed in one of the convention country, it is called a convention application (By virtue of Paris convention). To get a convention status an applicant should file the application in Indian patent office within twelve months from the date of first filing of a similar application in the convention country. The priority document (**S.138 (1)**) and its English translation (if required) (**S.138 (2)**) also should be submitted by the applicant. A convention application should be accompanied by a complete specification.

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 multiple priorities** so that the other applications filed earlier in the convention countries will be deemed to have been published in India. Applicant of convention application shall furnish when required by the Controller, copies of specification or documents (**priority documents**) certified by the official chief of the patent office of the convention country. If any such specification or document is in a foreign language, a translation into English of the specification or document shall be furnished.

### **PCT International application**

PCT is an international filing system for patents in which the applicant gains 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 those applicants seeking protection for the inventions in many countries. Indian Patent office is a receiving office for international applications by nationals or residents of India. *An international application shall be filed with the appropriate office in triplicate in respect of head office and quadruplicate in respect of branch offices, either in English or in Hindi language (Rule 19(1)).*

### **PCT-National Phase Application (S.7 (1)(A))**

An international application (**S.2 (1)(ia)**) made according to Patent Cooperation Treaty (**S.2 (1)(oa)**) designating India can enter national phase within 31 months from the international filing date. This 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 on white paper. But Form 1A is preferred by the Indian Patent office during

National Phase Entry. 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 (S.10 (4A)(i)). The filing date of the application...shall be the international filing date accorded under the Patent Cooperation Treaty (S. 10(4A))

It is not mandatory for the applicant to submit the documents while entering the national phase for filing the application in the designated or elected member countries, as it is obligatory on the part of WIPO to send those things to the designated offices. However for convenience and faster processing the applicant may submit the necessary documents. Office may ask for any other documents, which are necessary in addition to what was submitted along with the application.

#### **Application for Patent of Addition (S.54)**

When an applicant feels that he has an invention, which is a slight modification on the invention for which he has already applied for/have patent in India the applicant can go for a patent of addition. The only benefit he gets is that there is no need to pay separate renewal fee for the patent of addition during the term of the main patent. Patent of addition expires along with the main patent unless it is made independent according to the provisions in **S.54**.

The Complete Specification of that application shall include specific reference to the number of 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.

#### **Divisional application (S. 16)**

When the application made by an applicant claims more than one invention, the applicant on his own request or to meet the official objection raised by Controller may divide the application and file two or more application as applicable for each of the inventions. This type of application divided out of the parent one is called divisional application. The priority date for all the divisional application will be same as that claimed by the parent application (**Ante dating**). *The complete specification of the 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.*

## CHAPTER IV

### SPECIFICATION AND DRAWINGS

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The provisional specification/complete specification is required to be submitted in Form 2. The first page of the Form 2 should contain a) The title of the invention, (b) the name, the address and nationality of each of the applicants for the patent and (c) a preamble to the description. Complete description of the invention should start from the second page of the specification (Form 2) followed by date and signature. It shall contain claims for which protection is required. An abstract should be included in the next page after date and signature. Drawings if any referred in the specification can be attached to the specification thereafter

#### 4.1 PROVISIONAL SPECIFICATION

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, independent documents.

It should essentially contain the title and description of the invention and shall start with a preamble '*The following specification describes the nature of the invention.*' Claims need not be included in the provisional specification. After the preamble there should be set forth, the *object* of the invention, a statement of the *principle or discovery* underlying the invention and a 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, but in any case the description should be adequate to identify the invention.

An application for a Patent accompanied by a provisional specification is on the condition that a complete specification (in Form 2) shall be filed within **twelve months**. However provisional specification cannot be filed if the application is a divisional or a convention application or an application filed under the Patent Cooperation Treaty designating India (Sec. 16 or Sec. 135) then it shall always be accompanied by a complete specification only. If the complete specification is not filed after filing the provisional specification within the time as specified above the said application will be abandoned and no action will be taken on it. However if the complete specification is not filed after filing the provisional specification within the time as specified above, the applicant may file a request for postdating of the application. Such request should be filed on or before expiry of 12 months period from the date of filing of provisional specification.

If the same applicant has filed more than one application accompanied by provisional specifications which are **cognate** (or related), or a modification of one another a request (no form required) by the applicant to file a single complete specification in respect of more than one provisional specification will be allowed if they constitute a single invention when taken together. The complete specification should be filed within the specified time mentioned in Section 9(1) taken from the date when the earliest of applications was filed. **(S.9 (2))**

Where an application 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 required) to the Controller within twelve months from the date of filing of application **(S.9 (3))**

At any time before the grant of patent, complete specification filed in pursuance of an application with a provisional specification, or a complete specification treated as provisional specification Under Section 9(3) the application can be post dated to the date of filing of the complete specification if such a request (no form required) is made by the applicant to the Controller, and the provisional specification will be treated as cancelled. **(S.9 (4))**

## **4.2 COMPLETE SPECIFICATION (S.10)**

Complete Specification is a techno-legal document, which fully and particularly describes the invention and the best method of performing it. It should start with a preamble “ The following specification particularly describes the nature of this invention and the manner in which it is to performed.”

It shall contain the following in not more than 30 pages beyond which each page is changeable as given in the first schedule.

### **1) 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. It should verbally agree with the title stated in application. The following are not allowable in the title: – a) The inventor’s name b) The word ‘Patent’ c) Words in other languages d) The abbreviation “etc.” e) 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.

### **2) Field of the 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, e.g. by giving specified examples.

### **3) State of the art in the field**

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 with emphasis on the ‘**prior art**’ relevant to the invention. When the invention relates to an improvement on an existing apparatus or process a short statement of *closest prior art* may also be given. However, the description should fully and particularly describe the invention, by clearly

distinguishing it from such closest prior art if available. If the applicant is not aware of any prior art such a statement may be given.

#### **4) Object of the invention (Problem & Solution)**

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 difference between the claimed invention and the prior art.

The solution sought by the invention should be clearly brought out 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.

#### **5) 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 the different aspects of the invention in *verbatim* with the claims and complements to 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 also can be stated e.g. "There is also provided a method for performing -----" etc.

#### **6) Detailed description of the invention with reference to the drawings.**

It follows the statement of invention so as to give a complete picture of the invention. The nature of the improvements or modifications effected with respect to the prior art should be clearly and sufficiently described. The details of the invention described here should be sufficient for an average person skilled in the art to perform the invention by developing the necessary technical **know how** by himself. It can include examples/drawings or both for clearly describing and ascertaining the nature of the invention. *A brief description of the drawings may be given before the detailed description.* Sufficient number of examples can be appended to the description especially in the case of chemical inventions.

If the applicant mentions a biological material in the specification whose nature can not be clearly and completely described by words and if such material is not available to the public the application should be completed by depositing the material to an authorized depository institution notified by the Central Government in the Official Gazette and by specifying all the available characteristics of the material required for it to be correctly identified or indicated in the specification including the name and address of the depository institution and the date and

number of the deposit of the material at the institution. The source and geographical origin of the biological material specified in the specification also should be disclosed therein.

The following terms are somewhat vague, and their use should be avoided from the description as far as possible: – “Special”, “design”, “suitable”, “etc”. “Whereby”, “if desired”, “and/or”, “customary methods”, “known methods”. 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.

### 7) Scope and/or ambit of the invention

This part of the specification should bring out the areas of application of the invention and the preferable use of the invention. The applicant can substantiate the industrial applicability of the invention in this part and call for the protection against duplication of the invention in the related fields by specifying the scope and ambit. *The advantages of the invention also can be described in this part of the specification.*

It may be ended by a statement of the form “ Although the invention has been described with reference to specific embodiments, this description is not meant to be construed in a limiting sense. Various modifications of the disclosed embodiments, as well as alternate embodiments of the invention, will become apparent to persons skilled in the art upon reference to the description of the invention. It is therefore contemplated that such modifications can be made without departing from the spirit or scope of the present invention as defined.”

### 8) Claims

The description in the Complete Specification should be followed by a clear and succinct statement of “Claims” preceded by the prescribed preamble, “I claim” or “We claim”, as the case may be. It shall preferably start from the next page after the full description of the invention with the claims serially numbered. The object of the statement of Claims is to show with conciseness, precision and accuracy as to how much of what is described in the specification has been sought the protection so that what is not claimed is open to public use.

*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 (S.10 (5))***

Statement of the form given immediately below 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.

Also Claims should *not* be made, as in the examples given below, for illustrating the efficiency or the 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.

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 Sp. Gravity . . . . . and boiling point . . . . .  
.....

Claims, such as “I claim an improved sewing machine as described or as illustrated”, “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 the distinguishing features which are characteristics of the invention.

**A separate portion has been included in this chapter after this to illustrate the scope and structure of the claims**

**9) Abstract**

An abstract should be included after the claims to provide brief technical information on the invention. It should give a concise summary of the invention preferably within 150 words and shall start from a fresh page. It has to be prepared in such a way that one can understand the technical problem and solution with its usefulness. If necessary most relevant figure of the drawings should also be included in the abstract particularly in case of Engineering inventions. However, it cannot be used for the purpose of interpreting the scope of protection in legal proceedings. The Controller may amend the abstract for providing better information to third parties.

**Numbering** *A Sequence listing also may be included in the specification if necessary in the case of Biotechnology Inventions*

**4.3 DRAWINGS**

Complete specification should be followed by Drawings that are referred in the specification. Drawing should be filed on standard A4 size sheet in duplicate. Drawing should be preferably drawn in black Indian indelible ink on thick &

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 & consequential sheet number should be mentioned at the right hand top corner. At the right-hand bottom signature of the applicant/agent should be given along with the name of signatory there under. 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 drawing except under certain cases such as flow sheet, chemical & 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.

#### **POINTS TO REMEMBER WHILE DRAFTING THE SPECIFICATION**

i) The Complete Specification must be framed with the 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 language 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 of the useful arts 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) The Complete Specification must describe the best method known to the patentee of performing the invention and 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.

(iv) If the Complete Specification describes anything, which is not new, it must clearly distinguish that which is old from that which is new, and claim only the latter.

(v) An account of the *modifications and variations*, if any, which fall within the scope of the claim, may be included in the description.

(vi) A brief statement of the *advantages* of the invention may be incorporated, if so desired.

(vii) 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 held invalid and liable to be revoked.

(viii) The detailed description should be supplemented by drawings in all cases in which the inventions are capable of being illustrated. No drawing or sketch, such as would require the preparation for the printer of a special illustration for use in the letter-press of the specification when printed, should be inserted in the specification itself. Reference to the drawings should be specific and preferably in the following form: –

This invention is illustrated in the accompanying drawings, through out which like reference letters indicate corresponding parts in the various figures.

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

(x) The specification in respect of a Patent of Addition should contain at the beginning of the description, a definite statement that the invention comprises 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 contain also a short statement of the invention as disclosed in the earlier specification.

(xi) For the biotechnological inventions, it should disclose the source & geographical origin of the biological material in the specification **not later than the date of filing of patent application in India & reference thereof shall be made in the specification within the Three months** (sec 10(4) (d)(ii) [A] & Rule 13(8))

#### 4.4 CLAIMS

Claims are that part of a complete specification which defines the boundaries of the protection sought by the patent. They provide legal protection for the invention. They form a protective boundary line (around the invention) defined by the words and phrasing in the claims. What is not claimed in the 'claims' will be considered as **disclaimer**, even if the matter is disclosed in the description.

##### **Object of the claims**

The object of the claims is to define clearly 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. Their primary object is to limit and not to extend the monopoly being granted and they let others know when they are infringing on the rights of the patentee. What is not claimed is considered **disclaimed** and therefore open to public use. In other words 'no' monopoly is obtained for any matter described in the complete specification unless it is claimed in claims.

Each claim is evaluated on its own merit and therefore if one of the claims is objected does not mean that the rest of the claims are invalid. It is therefore important to make claims on all aspects of the invention to ensure that the applicant gets the widest possible protection.

### Scope of the claims

As the value of a patent depends largely upon the scope of the claims, special care is necessary to ensure that the claims include **neither more nor less** than what the applicant desires to protect by his patent. The 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. However a claim must not be too narrow also as such a claim would not be sufficiently effective in preventing the infringement of the patent and the infringers would go scot-free if the claim were too narrow. In other words, what is not claimed is disclaimed. Hence, full benefit of the invention may not accrue to the inventor.

There is no restriction for the number of claims however, number of claims beyond 10 is chargeable.. 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.

A claim shall call for the protection of either a product or process as if it is his personal property and shall be preferably in one sentence.

E.g.1) *"An apparatus for catching mice comprising, a base member for placement on a flat surface, a spring member..."*

- 1) *"A chemical for cleaning windows comprised of 10-15% ammonia, ..."*,
- 2) *"A method for computing future life expectancies, the method comprising gathering personal data including X,Y, Z, ..."*, etc.

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 **'state of the art'(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 the modification of the existing process.

### Characteristics of the claims

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. If the words like "thin", "strong", "a major part", "such as", "when required", "any" etc. are used then it force the reader to make a subjective judgment and not an objective observation. I.e. 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.

Also the claims have to be **supported** by the description (**fairly based on the description**). This means that all the characteristics of the invention that form part of the claims must be fully explained in the description. In addition, any terms, which are used in the claims, must be either found in the description or clearly inferred from the description.

### Structure of the Claims

A claim usually consists of **three** parts: the **introductory phrase, the body of the claim, and the link that joins the two.**

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**). The body of the claim is the specific legal description of the exact invention, which is being protected.

The linking consists of words and phrases such as:

- Which comprises
- Including
- Consisting of
- Consisting essentially of

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."

#### INDEPENDENT AND DEPENDENT CLAIMS

The first claim called '**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 properly characterized with respect to the '**prior art**'. The alternate embodiment of the **inventive concept** and the optional features may be claimed in the '**subsidiary claims**'. Subsidiary claims may include independent claims or dependent claims. Independent claims are used to define an **alternate embodiment of the invention** claimed in the principal claim or **an invention supplementary** to the principal claim (*If claim1 defines coder this claim can be for decoder*) or **an invention directly linked to the principal claim** (*Product or process or apparatus constituting unity of invention*). *Dependent claims should be clubbed with the independent claims (or within themselves) to include even the minute aspects and optional features.*

A claim known as '**omnibus claim**' may define "*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, only if '**statement of invention**' is incorporated in the specification. One or Two application claims also can be included before the omnibus claim.

The following Example claims a combination of plurality of legs in an umbrella tent frame

1. The combination of a plurality of legs in an umbrella tent frame each comprising a lower portion, an upper portion, and a pivot connector interconnecting the lower and upper portions;

a clevis assembly comprising an upper clevis member, 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. The combination 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. The combination 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 portion 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.

To aid the applicant or his agent in drawing up the Claims, the following samples of claims, which have been granted by the Patent Office, are given. 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.

**Specimen Claims.** – (1) [**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-tape 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.”

(2) [**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.

**(3) [Indian Patent Specification No. 34515.**

Title – “Improvements in or relating to tin openers.”]

“We claim: –

A tool for opening metal containers, the tool comprising a spindle split 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 I, 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 slidably and removably mounted on the spindle.”

**How to assess the clarity of claims?**

The following examples will be useful in judging the clarity of claims

Example1

A structure comprising a semiconductor substrate made of silicon, said structure further characterized by comprising a near-amorphous film comprising  $ZrO_2$ .

It 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.

Example 2

A Diesel engine comprising an engine block and a cylinder head made of an Aluminum-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.

Example3

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 as 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.

## CHAPTER V

### PATENT APPLICATIONS UNDER PCT

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The Patent Cooperation Treaty 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 remain 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 also party to the Paris Convention. The PCT does not compete with but, in fact, complements the Paris convention.

#### 5.1 Introduction:

On 7<sup>th</sup> September 1998, India deposited its instrument of accession to the PCT and on 7<sup>th</sup> December 1998 thus became a member of the PCT, as the 98<sup>th</sup> Contracting State of PCT. Furthermore, nationals and residents of India are entitled to file international applications for patents under PCT at Receiving Office at Patent Office, Kolkata with effect from 9<sup>th</sup> November 1999. The Patent Office branches at Mumbai, Chennai and New Delhi are also receiving the PCT applications.

#### 5.2 Principal Objectives Of The PCT

The principal objective of the PCT is to simplify and to render more effective and more economical—in the interests of the users of the patent system and the offices that have responsibility for administering it—the previously established means of applying in several countries for patent protection for inventions. Before the 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; these applications, each being dealt within isolation, involved repetition of the work of the filing and examination in each country.

#### To achieve its objective, the PCT:

- Establishes an international system which enables the filing, with a single patent Office (the “Receiving Office”), of a single application (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;

- Provides for the formal examination of the International Application by a single patent Office, the Receiving Office;
- Subjects each International Application to an international search which results in a report citing the relevant prior art (mainly published patent documents relating to previous inventions) which may have to be taken into account in deciding whether the invention is patentable; that report is made available first to the applicant and is later published;
- Provides for centralized international publication of International Applications with the related international search reports, as well as their communication to the designated Offices; and
- Provides the option of an international preliminary examination of the International Application, which gives to the Offices, that has to decide whether or not to grant a patent, and to the applicant, a report containing an opinion as to whether the claimed invention meets certain international criteria for patentability. The procedure described in the preceding paragraph, comparing it with the traditional procedure, is illustrated by two timelines such as chapter I and chapter II of PCT. It is commonly called the “International Phase” to describe the first part of the patenting procedure, whereas one speaks of the “National Phase” to describe the last part of the patent granting procedure which, as explained in paragraph above, which is the task of the designated Offices, that is, the national Offices of, or Regional offices acting for the countries which have been designated in the International Application. (In PCT terminology, a reference to “national” Office, “national” phase and “national” fees, includes the reference to the procedure before a regional patent Office).

Under the PCT system, by the time the International Application reaches the national 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 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.

### **5.3 Functions Of The Receiving Office**

1. The first step is that the Receiving Office receives the International Application from the applicant. An application for the same invention has to be filed six weeks or necessary permission under section 39 should be taken before the filing of International Application.
2. The second step is that 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.

3.

i) The receiving Office shall accord as the international filing date the date of receipt of the international application, provided that that Office has found that in order in accordance with Article 11, at the time of receipt:

ii) (a) If the receiving Office finds that the international application did not, at the time of receipt, fulfill the requirements listed in paragraph (1), it shall, as provided in the Regulations, invite the applicant to file the required correction.

(b) If the applicant complies with the invitation, as provided in the Regulations, the receiving Office shall accord as the international filing date the date of receipt of the required correction.

4. Receiving Office checks certain formal and physical requirements (Article 14). That check by the Receiving Office may show that the International Application does not meet certain requirements as to form and content and that 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.

6. If the language of filing of the International Application is one acceptable by the Receiving Office but is not acceptable by the International Searching Authority that is to carry out the international search, the applicant is required to furnish, within one month from the filing date of the application, a translation into a language which is all of the following: (i) a language accepted by the International Searching Authority that is to carry out the international search; (ii) a language of publication; and (iii) 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 purposes 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.

7. 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 uniform international publication.

8. 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.

9. As stated, 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, Rule 16b 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 delayed or incomplete payment of fees.

10. The third 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.

11. 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

12. 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 to the International Bureau except where the search fees has not been paid on time, in which case the transmittal of the search copy takes place after that fee has been paid.

13. 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 accepted 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

**The following conditions should be fulfilled for according an international filing date:**

The applicant should be a 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);

(ii) The International Application should be in the language, or one of the languages, accepted by the Receiving Office for the purpose of filing International Applications (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);

(iii) The International Application should contain at least the following elements: (a) an indication that it is intended to be an International Application, (b) the designation of at least one Contracting State (c) the name of the applicant in a form allowing the applicant's identity to be established, (d) a part which on the face of it appears to be a claim or claims.

(iv) 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.

(v) 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.

**Monitoring of time limits**

Easy supervision and monitoring of only a few time limits and events is required by applicants, namely:

(i) Monitoring the receipt of the confirmation of receipt of the International Application by the Receiving Office;

(ii) Monitoring the time limits for payment of fees;

(iii) Checking the notification from the International Bureau confirming the receipt of the International Bureau confirming the receipt of the record copy (Form PCT/IB/301) for correctness of the designations indicated on the Form and if needed and confirm precautionary designations within 15 months from the priority date;]

(iv) 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 19 months from the priority date.

(v) Deciding, after receipt of the international search report, whether or not to file amended claims under Article 19, within the applicable time limit;

This will usually be considered only if demand for international preliminary examination is not filed;

(vi) 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 and its communication to the designated Offices (Article 20) has been effected; (vii) entering the national phase before the expiration of 30/31 months from the priority date by paying the national fees and furnishing (if required) a translation of the International Application.

## **5.4 Filing of the International Application:**

### **a ) Request form (PCT/RO/101)**

1. International Application must be filed with any of the receiving offices i.e. Patent office, Kolkata, New Delhi, Mumbai, and Chennai(RO/IN) or International bureau (RO/IB) of WIPO. The request form and the documents attached therewith should be in triplicate.

2. 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.

3. The **request** may be made on a printed form, copies of which can be obtained free of charge from the Receiving Office or from the International Bureau of WIPO. The request may also be presented as a computer printout as prescribed by Section 102(h) of the Administrative Instructions or, alternatively, as a computer printout prepared using the PCT-SAFE (PCT-EASY) software, in which case it must be accompanied by a computer diskette containing a copy in electronic form of the

data contained in the request and of the abstract. Online application filing also is possible now.

4. 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, the necessary data concerning the applicant, the inventor and the agent representing the applicant. It must be signed by the applicant or his 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.

5. 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**

1. Only one certified copy is required of each priority of the application and to be furnished within 6 months from the filing date; no copies for each designated Office are needed. The copies for the designated Offices are prepared—at no additional cost to the applicant—by the International Bureau.

2. Transmittal of the priority document need not be monitored if a request for transmittal by the Receiving Office to the International Bureau of an application filed with that Receiving Office was made in the Request Form and the applicable fee for a priority document was paid to the Receiving Office.

#### **c) Description**

1. 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.

2. The description first repeats the title of the invention. It then specifies the 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 invention 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: -**

1. Section 806 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 801 be furnished, for the purposes of the national phase, on paper.

2. For 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 form but only for the purposes of international search and/or international preliminary examination. In such cases the current system for calculating the basic fee, on the basis of 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).

3. 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 as specified by the receiving Offices (for further details pl. see PCT Applicant's Guide).

**e) Claims:**

1. 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.
2. 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 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:**

1. 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.
2. 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**

1. 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.*

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 the International Searching Authority or, if applicable, by at least one International Searching Authority, competent for the international searching of International Applications filed with that Receiving Office and one of the languages of publication (that is, Chinese, English, French, German, Japanese, Spanish or Russian), so that applicants always have the option of filing the international search or international publication purposes; 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.

2. If the language of filing of the International Application is the one acceptable by the Receiving Office but is not accepted by the International Searching Authority, the applicant is required to furnish, within one month from the date of receipt of the application, a translation into a language which is all of the following: (i) a language accepted by the International Searching Authority that is to carry out the international search; (ii) a language of publication; and (iii) a language accepted by the Receiving Office (unless the International Application is filed in a language of publication) (Rule 12.3).

3. 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 search (see Rule 48.3).

4. The request must always be filed in a language that is accepted by the Receiving Office and which is also one of the seven languages of publication

### **5.5 International Search.**

A high quality 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)**

2. If the International Application did not claim any priority, the international search report is available within nine months from the international filing date, If priority is claimed, that report is available usually during 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.

## 5.6 PCT FEES (may vary from time to time)

### Receiving Office (RO/IN) (The Patent Office, Kolkata, New Delhi, Mumbai and Chennai)

Transmittal fee: INR 2,000 [for individual(s)] , INR 8,000 [for legal entity]

ii. International Fee: USD 1134\*    USD 1211 (from 1-3-2005)

iii. Supplement per sheet in excess of 30: USD 12\*            USD 13 (from 1-3-2005)

(\* Amounts on 1 February 2005 unless otherwise indicated).

iv. Search fee: (Amounts on 1 February 2005, unless otherwise indicated)

ISA/AT - USD 182            USD 214\*\*

ISA/EP - USD 1920\*\*        USD 2,075\*

ISA/AU - USD 865

ISA/CN - USD 181

ISA/US - USD 1000         USD 300\*\*\*

ISA/SE - USD 1920         USD 2,075\*

vi. Fee for preparing certified copy of priority document and transmission of the same to IB

INR 1,000 [for individual(s)] INR 4000 [for legal entity]

(\* from 15-3-2005,

\*\* from 1-3-2005)

Failure to pay fees or underpayment of fees can be corrected under Rule 16b. An invitation to pay missing amounts will be issued by the Receiving Office. Payment can be made later, together with a late payment fee.

(\*\*\* -- Refer PCT Fee Tables [Footnotes to Fee Tables Para.18])

An Indian applicant, filing an International Application for Patent 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 basic fee, designation fee and search fee. The required fees, which must be paid to receiving office, are the Transmittal Fee, the International Fee and the Search Fee. They must all be paid to the Receiving Office. *To facilitate the payment in US Dollar, as required by International Bureau of*

*World Intellectual Property Organisation and International Searching Authority selected by the applicant, an account has been opened by India in the name of the **Controller General of Patents, Designs & Trade Marks, with the State Bank of India, New York Branch, 460, Park Avenue, New York-NY-10022 assigning account No. 2111-250821-001.***

The Transmittal Fee is for the benefit 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 left to be fixed by the Receiving Office. It is due within one month from the date of receipt of the International Application.

The International 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 fee is due within one month from the date of receipt of the International Application.

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 due within one month from the date of receipt of the International Application. The amount is fixed by the International Searching Authority.

## **5.7 Withdrawal of the application**

An International Application can be withdrawn at any time during the international phase. Where the intent of the withdrawal is to prevent publication, the notice of withdrawal must reach the International Bureau before technical preparations for international publication have been completed (that is, not later than 15 days before the date of publication).

2. A withdrawal of an International Application can be made with the condition that the withdrawal be effective only if the international publication can still be prevented.

## **5.8 Amendments:**

1. The claims can be adjusted to 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 registration 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.

## 5.9 International Preliminary Examination (Optional)

The following are Competent International Preliminary Examining Authorities [IPEAs] for the purpose of Indian applicant:]

Austrian Patent Office (AT)  
Australian Patent Office (AU)  
European Patent Office (EP)(only if ISA was AT, EP or SE)  
China Intellectual Property Office (CN)  
United States Patent & trademark office (US)  
Swedish patent Office (SE)

### 2. The use of International Preliminary Examination

- (i) Is optional for the applicant;
- (ii) Provides, in addition to the international search report, an international preliminary Examination report containing an 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 to the results of the international search report;
- (iv) Allows, with effect for all elected Offices, the amending of all parts of the 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:
- (viii) The application will be more or less ready for acceptance by the elected Offices after receiving international preliminary examination report.
- (ix) 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.

### **Preliminary examination fees (Amounts on 1 February 2005 unless otherwise indicated)**

<b>IPEA Preliminary examination fee</b>	<b>Handling fee (CHF 200)</b>
AT EUR 159	EUR 129
AU AUD 550 1000**	AUD 218
CN CNY 1,500	CNY eq CHF 200
EP EUR 1,530	EUR 129
SE SEK 5,000	SEK 1,160
US USD 600	USD 162 173 (From 1-3-2005)

(\*\* Refer PCT Fee Tables (footnotes to Fee Tables para.20.)



## 5.10 The National Phase

1) 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).

2. For entry into the national phase before a designated or elected Office (if Preliminary examination is undertaken and countries elected), it is necessary that the national fee be 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 translation into an official language be filed. The time limits for entry into the national phase are, in some Offices, even longer than 31 months.

3. The national fees to be paid are usually same as the fees required for the filing of a national or regional application. Some Offices, not in India however, levy lower national or regional filing, search or examination fees, or refund certain fees, on account of the existence of the international search report or where an international preliminary examination report has been established. This offsets, at least partly, the costs of filing an International Application.

4. Where the original drawings are of a good quality, the applicant is not required to file additional formal drawings with the Designated or Elected Offices, permitting substantial economies in some cases. It is therefore important to file drawings with the Receiving Office that fully comply with the format requirements of the Regulations under the PCT.

5. Where the priority of an earlier application is claimed and a certified copy of that application has been provided, it is not necessary to submit a certified copy of the priority document to each designated or elected Office. The International Bureau sends any required copies of the priority document to the Offices concerned.

## 5.11 Legal Remedies; Protection Against Loss Of Rights

Where, as a result of a mistake which was not timely corrected, an International Application is considered withdrawn, the applicant may request review of that decision by each of the designated Offices. In addition to requesting review, the applicant has the opportunity to submit at the same time, to each designated Office, a request for excuse of failure to comply with a time limit. The legal basis of, and the conditions for, such a request are to be found in the applicable national law or regional convention, which applies equally to International Applications. Where that law or convention provides for reinstatement, this can be requested. Where there is a possibility of requesting further processing of the application, this can also

be done. Procedural safeguards are thus available in each designated State to PCT applicants in the same way, as they are to applicants for national or regional applications not made via the PCT.

### **5.12 Preparation Of Patent Applications**

1. Any patent application, drafted in accordance with the requirements of the PCT, allows a maximum flexibility and benefit from the advantages of the PCT:

(i) The same application documents can then be used for filing national and/or international applicants;

(II) No adaptation of the original application is then required in a much as the PCT format is valid for all designated Offices (including the EPO, the Japanese Patent Office and the United States Patent and Trademark Office).

**Fee savings.** National fees are reduced or completely dispensed with for the procedure before some Offices which provides considerable savings, for example:

*European Patent Office (EPO):* –

European search fee waived if international search report by AT, EP, ES, SE; 20% reduction of European search fee if search report by AU, CN, JP, RU, US; – 50% reduction of European examination fee if international preliminary examination report by EP.

*German Patent Office:*

- Filing fee waived if the Office was the Receiving Office;
- Examination fee reduced if an international search report has been established.

*Hungarian Patent Office:*

- Filing fee waived if the Office was the Receiving Office;

*Japanese Patent Office:*

- Approximately 80% reduction of examination fee if international search report established by JPO;
- Approximately 20% reduction of examination fee if international search report established by ISA other than JPO.

*United Kingdom Patent Office:* refund of part of preliminary examination and search fee.

### **5.13 BASIC REQUIREMENTS TO ENTER NATIONAL PHASE IN INDIA**

Under the said basic requirements to start the national phase in India, the applicant is required to file the following with the DO/IN (Designated office) or EO/IN (Elected office) within the prescribed time limit:

(i) An application on a plain paper (Form1 may be used, however the option remains with the applicant);

(ii) National fee in INR: INR 1,000 for individual(s) INR 4000 for legal entity

*In case of more than one priority, multiple fees for every multiple priority:*

(iii) Where the international application has not been filed or published 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)), any text matter of drawings and abstract should be submitted.

(iv) 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 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 is also required.
- d) Declaration of inventor ship 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

(iii) Where the international application has not been filed or published 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)), any text matter of drawings and abstract should be submitted.

(iv) 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 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 is also required.
- d) Declaration of inventor ship by the applicant,
- e) Statement regarding 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
- i) Copy of International application or its translation

## CHAPTER VI

### PUBLICATION AND EXAMINATION OF APPLICATIONS

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#### 6.1 Publication

A) 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**). In case of PCT National phase applications processing of the application starts only after the expiry of 31 months from its priority (**R. 20(2) and R.20 (4)**) but may be taken up for examination before the said period on express request of the applicant.

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 defense purposes etc. so that the necessary procedures can be initiated in respect of those files tested positive.

#### B )Early Publication

If the applicant makes a request in Form 9 (before the expiry of 18 months) with the prescribed fee (*Rs. 2,500 for individual natural person(s) and Rs. 10,000 for legal entity other than natural person(s)*) (**S. 11A(2)& R. 23(B) R.24A**). the application will be published as soon as possible.

C) The application will not be published if secrecy direction is given under *Section .35* or has been abandoned under section 9 or has been withdrawn 3 months prior to the expiry of 18 months. In case a secrecy direction has been given it will be published after the expiry of the 18-month period or when the secrecy direction is lifted off, whichever is *later* (**S. 11A(4)**).

#### D) *The particulars of publication are (S.11A (5))*

- Date of the Application
- Number of the Application
- Name of the Applicant
- Address of the Applicant
- Abstract of the Invention

This publication will be identified by the letter 'A' along with the number of the application [**Rule 25**]

### **Also the publication will have the following effects**

- 1) The depository institution will make the biological material (mentioned in the specification) available to the public **(S.11A (6)(a))**.
- 2) The Patent office will make the specification and drawing available to the public on Payment of prescribed fee **(S.11A (6)(b) & Rule 27)**. The fee is Rs.200 for individual natural person(s) and Rs.800 for legal entity other than natural person(s).
- 3) 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 **(S.11A (7))**.  
But he shall not be entitled to institute any proceedings for infringement until the patent has been granted. Further, the rights of patentee for applications filed u/s 5(2) before 1<sup>st</sup> day of January, 2005 will accrue from the date of grant of the patent.

**Also after a patent is granted in respect of applications made under sub-section (2) of section 5 of the repealed act, 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 1<sup>st</sup> 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.**

- 4) **The applications will be taken up for examination only on request in Form 18 made after the publication of application** (within 36 months from the date of priority or from the date of filing whichever is earlier) by the *applicant* or the *person interested* **(S.2 (1)(t))** with the prescribed fee (Rs. 2,500 for natural person(s) and Rs. 10,000 for other than natural person(s)) **(S. 11B (1) & R. 24(1) 24B(1))** and with the prescribed fee (Rs. 3,500 for natural person(s) and Rs. 14,000 for legal entity other than natural person(s)) **under rule 20 (4)(ii)**. This system of examination is called **Deferred Examination** system. (Refer Rule 24(B) also)

### **Advantages of Deferred Examination System**

- 1) By making an application for patent, Applicant (Inventor) obtains Date of patent and hence priority also without paying the Fee for Examination
- 2) Applicant/ Inventor gets recognized as the owner of the Invention because of '18 month publication' even if the application is not examined.
- 3) Request for examination can be delayed up to **36 months** so that the applicant can obtain financial support to exploit invention
- 4) A person who is Interested in the commercial value of the invention can request for the examination and get the patent licensed later on by consulting the applicant.
- 5) If the Applicant wishes he can withdraw the application before '15 month' to prevent the publication so that its novelty will not be lost **(S.11B (4)(i) & R. 26(2))**

## 6.2 REQUEST FOR EXAMINATION

Request for examination can be made only after publication and within 36 months from the date of filing or date of priority of the application whichever is earlier **(S.11B (1))**. In respect of applications filed before the 1<sup>st</sup> day of January 2005 the request should be made within a period of 48 months from the date of filing of the application **(S.11B (3))**. If no request for examination is made within the prescribed period the application will be treated as withdrawn **(S.11B (4) R 24B(1)(v))** The applicant can withdraw his application any time before grant. In case where secrecy direction has been issued request may be filed within 36 months from the date of priority of the application or from the date of filing of the application, or within 6 months from the date of revocation of the secrecy direction, **whichever is later**.

## 6.3 EXAMINATION OF APPLICATIONS

Applications will be taken up for examination according to the order in which the request is made **(R. 24B(2)(i))**. The *Controller (S.2 (1)(b) & S.2 (a))* refers the application to an Examiner whether the application, specification and other documents related thereto are in compliance of the Act and Rules **(S.12(1))**. **The examiner has to make a report to the Controller within a period of 1 month from the date of such reference (S.12 (2) & R.24B(2)(ii))**. This Report is called First Examination Report (*FER*).

### A) GUIDELINES FOR FORMAL EXAMINATION

a) The papers should be kept in the following order in a file

#### **Set 1 (Office Notes and correspondence letters) [As a bundle]**

- 1) *Examination sheet and note sheets in the order according to serial No. (As a bunch)*
- 2) *Correspondence letters, serially numbered according to the order of date of receipt or issue (As a bunch)*

#### **Set 2 (Main Documents) [As a bundle]**

- 3) *All the forms or Requests including Petitions according to the order of Form No., observing the order of date filing also if there are more than one forms of the same kind.  
(As a bunch)*

4) PA or attested copy of GPA( if any) (As a bunch if there is more than one)

5) *Provisional and/or complete specification followed by Drawings if any (As a bunch)*  
(If there is more than one such specification order of date of filing should be observed.)

**Set 3 (Supporting Documents) [As a bundle]**

6) *Original Assignment deeds, or an official or notarially certified copy of the same.*  
(If there is more than one assignment deed the order of the date of filing should be observed and all the assignments should be kept together.)

7) *Certificate of 'change of name' of the company produced from the concerned authority with the translation (if required) and affidavit of the translator .The translation should be placed immediately after the certificate.*  
(If there is more than one such certificate order of date of filing should be observed)

8) *Priority documents and the translation (if required) with affidavit according to the order specified above in (7).*

9) *All the superseded documents according to the order said in (3) and (5) respecting the order of date of filing in cases of multiple amendments.*  
(As a bunch)

**Set 4 (Additional copies of Documents) [As a bundle]**

10) *All duplicate copies according to the order specified from (1) to (9)[As a bunch]*

11) *All triplicate copies (if any) according to the order in (10) [As a bunch]*

b) Initials of the assistant should be put on the file cover and note sheets.

c) Signature and name of the asst. should be put in the examination sheet after item no 58

d) Date stamp should be put on each document to reflect the date of filing.

e) Amended documents including pages of complete specification should supersede the existing ones. Also it is to be ensured that date stamp is there on the amended pages or documents.

f) All the superseded documents should be endorsed with the words '*superseded*'.

g) It is to be ensured that PA is not under stamped.

h) The supporting documents shall also be sent to the applicant along with objections and the main documents if there is no attestation or affidavit as said in (6), (7) and (8)

i) Objections U/R 137 and 138 shall be done properly. Also it should be kept in mind that the prescribed fee is different for individual and company.

j) Cross reference should be made on the file covers of co-pending applications (Cognate type, divisional and parent applications). The related applications shall be sent together to examiners

k) In the case of Form3/Form5 Xerox copy of the duly filled in form should be attached to the duplicate copies in order to reflect the changes made by the applicant.

l) Files shall be transmitted to the examiners immediately after formal examination



- m) It should be ensured that all the documents are in conformity with the act and rules
- n) It has to be ensured that Nationality and address of the applicant and the inventor are stated.
- o) Checking should also be made to confirm that all the necessary details under S.8 are furnished.
- p) Checking should also be made to know whether the agent is registered and named in PA.

## **B ) SUBSTANTIVE/ TECHNICAL EXAMINATION**

*Technical and legal matters mainly include the exploration of the following.*

- 1) 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.
- 2) Whether the invention is one, which is not patentable under Sections 3 & 4;
- 3) Whether the specification complies with the requirements of Section 10.

*The examination of the application proceeds in the following order*

- 1) *Understanding of the invention*
  - 2) *Assessment of Patentability of the subject matter*
  - 3) *Assessment of sufficiency of disclosure*
  - 4) *Check for unity of invention*
  - 5) *Appraisal of Industrial applicability*
  - 6) *Classification of the invention*
  - 7) *Determination of priority of each claim*
  - 8) *Novelty search*
  - 9) *Determination of the inventive step*
  - 10) *Judgment of the validity of claims.*
- a) The examination of industrial applicability is based on the technical documentation in the patent application dossier (description, drawings, claims and possible precise details and missing information), while the examination of novelty and inventive step requires documentary search for the assessment of prior art;
  - b) Before the examination of novelty and inventive step it is necessary to check whether the invention is fully defined, feasible and applicable-with certain effects - to a certain field;

- c) 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, which can justify it.

#### DETERMINATION OF PRIORITY DATE OF CLAIMS (S.11)

##### Priority Dates of Claims

Every claim of complete specification has got a Priority Date

##### Option 1)

Application filed with Provisional specification, then followed by Complete specification

Priority date of any Claim fairly based on the matter disclosed in Provisional shall be the date of filing of Provisional

Example : D.O.Filing (Prov )	1/1/2001
D.O.Filing ( Compl )	1/1/2002
Priority date of claim	1/1/2001

##### Option 2)

Complete specification is filed or proceeded with in respect of two or more cognate applications accompanied by Provisional specifications

Priority date of any claim fairly based on the matter disclosed in those Provisional specifications shall be the date of filing of application accompanied by that specification

Example: D.o.F	1/1/2001 (Prov )	} Cognate applications
D.o.F	6/7/2001 (Prov )	
D.o.F	1/12/2001 ( Compl )	

Priority date of claim may be 1/1/2001 or 6/7/2001

Option 2. 1 )

Priority date of any claim fairly based on the matter partly disclosed in one and partly disclosed in another specification shall be the date of filing of application accompanied by the specification of the later date

Example : D.o.F 1/2/2001 ( Prov ) } Cognate applns.  
D.o.F 5/8/2001 ( Prov ) }  
D.o.F 1/2/2002 ( compl )

Priority date of claim is 5/8/2001

Option 3)

In case of Divisional application

Priority date of any claim fairly based on the matter disclosed in Provisional or Complete of Parent case shall be the date of filing of that specification in which the matter was first disclosed

Example : D.o.F 10/3/2001 (Prov ) } Parent case  
D.o.F 15/9/2001 ( compl ) }  
D.o.F 1/1/2003 ( Compl ) } Divisional case  
D.o.Filing of Divisional is ante-dated to 10/3/2001

Priority date of claim may be 10/3/2001 or 15/9/2001

**Option 4) In case of multiple priorities in convention applications**

**Priority date of any claim having two or more priorities shall be the earlier or earliest of those dates**

**Example : D.o.F 1/1/2001 ( 1<sup>st</sup> convention country ) } Basic applications**

**D.o.F 7/10/2001 (2<sup>nd</sup> convention country)**

**D.o.F 10/11/2001 (3<sup>rd</sup> convention country)**

**D.o.F 1/1/2002 ( In India )**

**Priority date of claim is 1/1/ 2001**

Devising a search strategy is similar to the Qualitative analysis conducted in chemistry to identify the presence of an element. If we traverse through the pre-planned steps the identification is easy. The same principle is applicable in novelty search also. When we have a lot of searchable databases, the search sequence shall be determined based on the nature of the invention, applicant or country. That is why a search strategy is a vital factor for an International Search Authority who intend to provide an excellent search report.

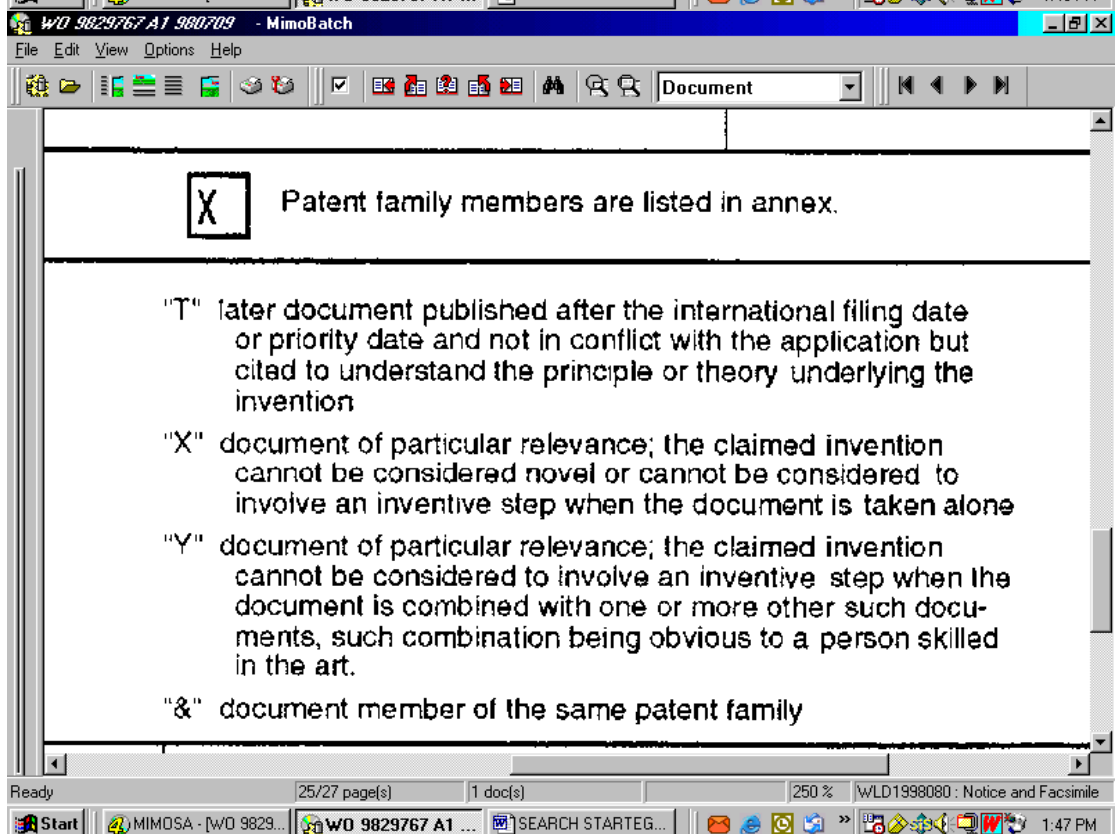
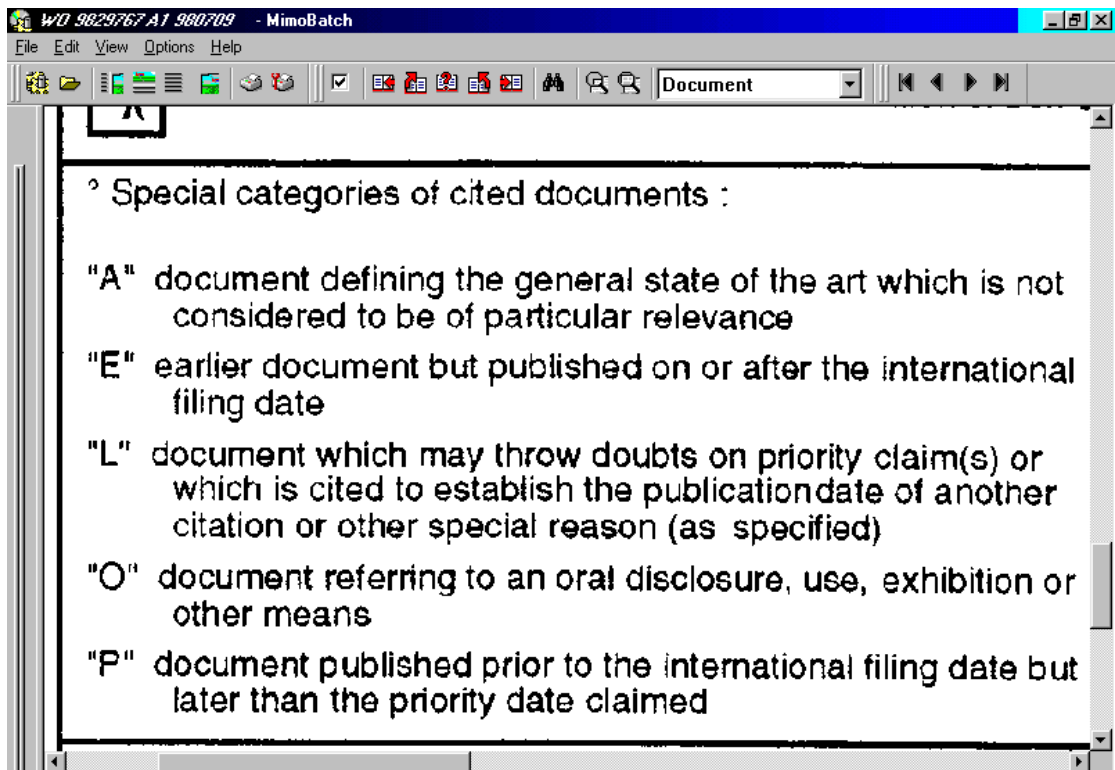
Every search for novelty should start only after the classification of the invention. While classifying, one main classification (HO2K 26/00 etc.) and two or three closely related classifications shall be determined by the Examiner. The search shall be concentrated on the relevant fields of the classification (H04L, H04Q etc.) and within such field search can be intensified by giving the 'key words' from the description. MIMOSA databases are found to be useful in determining the classification by way of search using 'key words'. Search should also be conducted in publications other than patent documents. Whichever databases are to be searched depends on the strategy.

Indian Patents Act requires **Relative Novelty** (not Absolute Novelty) for the inventions to be patentable. Therefore, the examiner should search 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.

- a) Indian patent specifications published before the date of filing of the application but on or after 01.01.1912 **(S. 13(1)(a) - Prior publication)**
- b) 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  
**(S. 13(1)(b) - Prior claiming)**
- c) Any publication in India or elsewhere effected before the filing date  
**(S. 13(2) - Prior publication)**
- d) Indian patent specifications published before the date of filing but on or after the priority date of the application under consideration.  
**(S.13 (1)(a) - Prior publication)**

But according to international standards the search should result in the following documents, which form citation for the invention.

Types - A, E, L, O, P, T, X, Y& (Description for each type of the documents are given in annexure). The citations of the type X and Y are very important as they explicitly indicate lack of novelty and obviousness .



## 6.5 WHAT ARE NOT ANTICIPATIONS (S. 29 through S. 33)

### a) Previous publication (S.29)

1. 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 1<sup>st</sup> day of January 1912
2. A previous 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 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.
3. 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 a communication for the purpose of the investigation.

### c) 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 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. 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 do not constitute anticipation if the application is made within the above-mentioned period.

d) Public working (S.32)

This deals with public working of an invention claimed in a complete specification for reasonable trial because the nature of the invention is such that it is 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.

e) Use and Publication after provisional specification (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 countries whose priority is claimed.

**6.6 ACTIONS TO BE TAKEN IN CASES OF ANTICIPATION**

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 his the satisfaction **of the Controller.** [S. 18(1) & Rule 28]
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 his satisfaction **of the Controller.** (The Controller need not consider the validity of the prior specification when directing such a reference.). [S. 18(2) & Rule 29, 30, 31]

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]

3. 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 **(S.18 (3)).**

*Also the Controller has the 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 request from the applicant, when the said referred patent ceases, or revoked or relevant conflicting claim is deleted from the other patent. [S. 19, Rules 32 and 33]*

The investigation made under Section 13 is not deemed to be conclusive on the question of anticipation and central government or its officers incur no liability **(S.13 (4)). (Also see S.144).**



## 6.7 ISSUING FER AND PROCEDURES THEREAFTER

The gist of the objections in the report (**First Examination Report**) made by the Examiner will be communicated to the applicant. If any of the objections requires amendment of the application, specification or drawings to ensure compliance with the provisions of the Act or the Rules, they will be returned to the applicant along with the FER. The applicant will be given (if he requires) an opportunity of being heard if the report is adverse to him (**S.14 & R.24(B), R28**). The applicant will be allowed to carry out the necessary amendments in compliance with **Rule 14 (S.15)**

**The amended specification should be examined in the same way as the original specification (S.13 (3)).** There can be many correspondences between the examiner and the applicant after the issue of FER. *However the time for meeting the objections and putting the application in order is 6 months from the date of issue of FER (S.21 (1)). This time may be extended only once for a further period not exceeding 3 months by the Controller in circumstances beyond the control of the applicant when a request is made for such purpose in FORM 4 with specified fee before expiry of the above 6 months period (Sec 21(3) Rule 24 B ).* Application will be deemed **abandoned** otherwise. The cases for which FER was issued before the commencement of Patents (**Amendment**) Act 2005 the time for putting the application in order is twelve months. **Rule 24B (4)(iii).**

## 6.8 POST DATING OF THE APPLICATION (S.17) [*other than provision under S. 9(4)*]

The application for patent may be **post-dated** to a date not later than **six months** from the **date of the application** on request of the applicant (made at any time before the grant of patent) along with the prescribed fee (Rs. 500 for natural person(s) and Rs. 2000 for other than natural person(s)). *However this provision will not apply if the application is deemed abandoned as per S.9 (1). [S.17 (1)].*

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 (S.17 (2)).

## 6.9 CHANGE OF APPLICANT (S.20)

A claim for substituting an applicant/applicants has to be made in **form 6** with the prescribed fee (Rs. 500 for natural person(s) and Rs. 2000 for other than natural person(s)) along with the original **assignment/agreement** or an **official/notarized copy thereof**. The Controller may call for other proof of title or written consent of the assignor/s if required (**Rule 34**).

By virtue of a written assignment or agreement from the applicant or by operation of law the claimant(s) makes the claim that if and when the patent is granted he would become entitled to **(S.20 (1))**

- 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.)
- 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).

**The claimant may become entitled to any of the above by operation of law also.**

The direction to substitute an applicant will not be given unless all the applicants have consented to assign the said rights to the claimant **(S.20 (2))**. 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 no. 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 **(S.20(3))**. 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. **(S.20 (4) & Rule 35)**. Also see **S.20 (5) & Rule 36**.

#### **6.10 AMENDMENT OF THE APPLICATION AND SPECIFICATION (S.57)**

The applicant [or patentee **(S.2 (1)(p))**] may amend the application, complete specification or any document related thereto after taking the leave for amendment in **Form13 (Rule 81(1))**. If the amendment is requested **before the 'grant'** the fee is Rs.500 for the natural person(s) and Rs.2000 for other than natural person(s), but if the amendment is **after the 'grant'** the fee is Rs.1000 and Rs.4000 respectively.

However if the amendment is only for changing name, address, nationality etc. the fee is Rs.200 and Rs.800 respectively. This application should state the nature of the proposed amendment (*usually highlighted in red ink 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)). [Also see S.57 (6)].** If the amendment is for change of name the necessary proof for change of name should be produced by the applicant.

The amendment can be allowed only if it is by way of **disclaimer, correction or explanation** for the purpose of incorporation of actual fact. Amendment should not be allowed if the specification as amended claims or 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)). The amended pages have to be filed in duplicate by the applicant along with duly canceled original pages.

If the application for amendment is made after the grant of patent and the nature of the proposed amendment is substantive the application should be published in official journal inviting opposition by any interested person for allowing the opposition by any interested person (S.57 (3), S.57 (4) & Rule 81(3)). The amendments allowed on such an application also should be notified in the Official Journal (S.59 (2) & R 83). **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 (S.57 (1)).**

2 *Any document for the amendment of which no special provision is made in the act may be amended and **any irregularity in procedure may be condoned** by the Controller on a petition made by the applicant under **Rule 137** with the prescribed fee (Rs. 1000 for individual natural person(s) and Rs.4000 for legal entity other than natural person(s))*

3. *Also the Controller has the power to extend the time prescribed by the **Rules** for doing any act or the taking of any proceeding there under. Such extension can be given normally for not more than one month and **only once** in a particular matter (**Rule 138(1)**). Any such request has to be made by the applicant within the extendable period (Period capable of being lengthened) (**Rule 138(2)**). A petition with the prescribed fee (Rs.1000 for natural person(s) and Rs.4000 for other than natural person(s)) should be made for the purpose.*

## **6.11 GRANT OF PATENT**

The Patent may be granted by the Controller at any time, but as soon as possible after the applicant has met with all the official requirements within the period specified in section 21 (6 months from date of F.E.R.or within the extended period not exceeding 3 months ).**There is no need to make the Request for Grant separately.**

## CHAPTER VII

### SECURITY DIRECTIONS FOR INVENTIONS RELATED TO DEFENCE

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**7.1** There are certain provisions in the Act for **security directions** for certain specific type of inventions, which are **useful for defence purposes**. The respective sections empower the Central Govt. to use such inventions and also empower it to prohibit the publication of the information relating to such inventions by any person.

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 communication of such information, to specified person(s) 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. 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 will, upon receiving such information, revoke the security direction and inform the applicant (S. 35(2))

Also if the Central government considers an invention, in respect of which the Controller has issued no security direction, to be relevant for defence purpose, it may notify to that effect to the Controller before the grant of the patent will issue the security direction on receipt of such a notice and inform the Central Govt. to that effect.

Central Govt. will review the question on whether the invention continues to be relevant for defence purposes at intervals not exceeding 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 Controller will be given notice to revoke the security direction previously given by him. Also if the patent application was made by a foreign applicant and the invention was found published the security direction will be revoked. (S. 36). The result of every reconsideration will be communicated, in writing, to the applicant for patent within fifteen days of the receipt of the notice by the Controller (Rule 72(1))

#### **7.2 CONSEQUENCES OF SECURITY DIRECTION (S. 37)**

During the period when the security direction is in force, the application will not be published .

If the Central Government finds that applicant has suffered hardship by reason of continuation of such direction it may make payment of a suitable sum to the applicant by way of solatium having regard to the novelty and the utility of the invention and the purpose for which it is designed. (S. 37 (2) (b))

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)). Also *when* any direction given in respect of an invention has been revoked by the Controller, he may subject to any terms, extend the time for doing anything under the Act in respect of an application for patent for a maximum period not exceeding the period the direction were in force

### **7.3 Prohibition to Apply for Patent for inventions outside India without permission (S. 39)**

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. If an application has been made in India in respect of the same invention six weeks before making the application outside India and no secrecy direction is given under S.35 (or such direction is revoked thereafter) the applicant may proceed with filing outside India.

**If the invention is relevant for defence purposes & atomic energy, the controller shall not grant permit without the prior consent of the central Government.**

These provisions will not apply if the application for protection was first made outside India by a person resident outside India.

The request for permissions for making patent application *outside India* should be made in Form 25 with prescribed fee of Rs.1000/- for Natural Person & Rs.4000/- for legal entity (Rule 71(1)) and the Controller shall dispose the said request ordinarily within a period of three months from the date of filing of such request (Rule 71(2). Normally the permission to file abroad is granted within 7 working days if the invention is not related to defence and/or atomic energy

### **7.4 OTHER PROVISIONS**

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) (S. 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.*
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)
- 3.No provisions in the act shall prevent 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.

*4. When any directions 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 authorize to be done by or under this Act in connection with application whether or not that time has previously expired. (S.38 )*

CHAPTER VIII  
REPRESENTATION AND OPPOSITON PROCEEDINGS

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**8.1 PRE-GRANT OPPOSITION BY RESPRESENTATION :**

**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, **within 6 months from the date of such publication**, represent by way of opposition to the Controller against the grant of patent on the grounds of -

(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 1<sup>st</sup> 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 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 that 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 trail 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 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,  
but on no other ground and the Controller shall, if requested by such person for being heard, hear him and dispose of such representation in such manner and within such period as may be prescribed.

**8.2 It may noted that in this Section the term used is “including” and therefore the conditions of patentability in this clause, cover in addition to novelty, inventive step and industrial application all the substantive requirement of the Act like those in sections 3, 4 etc.**

**Accordingly the following aspects will have to be taken into account while considering the patentability in the pre-grant opposition**

**Sufficiency of description**

- (i) The Complete Specification fully and particularly describes the invention
- (ii) The Complete specification discloses the best method by which the invention is to be performed.
- (iii) The complete specification discloses the source and geographical origin of the biological material used in the invention.

**Subject matter**

- (a) The subject matter of the complete specification
  - (i) constitutes an ‘invention’ under Section 2 (i) (j) of the Patents Act.
  - (ii) has Novelty
  - (iii) involves an Inventive Step
  - (iv) and is capable of Industrial Application
- (b) Not an invention within meaning of **Section 3** of the Act:-
  - (i) Invention is frivolous or claims anything contrary to well-established natural laws;
  - (ii) Invention is contrary to public order or morality or



causes serious prejudice to human, animal or plant life or health or to the environment;

- (iii) Mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature;
- (iv) Mere discovery of any new property or mere new use for a known substance or 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;  
(it shall be corrected as per new definition)
- (v) 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;
- (vi) Mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;
- (vii) Method of agriculture or horticulture;
- (viii) Process for the medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals.
- (ix) Plants and animals in whole or any part thereof including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals.
- (x) Mathematical or business method or a computer program *per se* or algorithms.
- (xi) Literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever included cinematography works and television productions;
- (xii) Mere scheme or rule or method of performing mental act or method of playing game;
- (xiii) Presentation of information;
- (xiv) Topography of integrated circuits.
- (xv) Invention which in effect, is traditional knowledge or an aggregation or duplication of known properties of traditionally known components.

(c) Not patentable under section 4: - Invention relates to **atomic energy** falling within sub-section (1) of Section 20 of the Atomic Energy Act, 1962 (33 of 1962).

### 8.3 PROCEDURE

Any person can file opposition by the way of representation to the Controller at the appropriate office within a period not exceeding three months from the date of publication or before the grant of patent whichever is later against the grant of patent on the above mentioned grounds.

### 8.4 HEARING:-

The representation shall include a statement and evidence in support of such representation. The Controller will consider that representation only if examination request of that application has made and will give notice to the applicant if he feels application requires amendment .

The applicant should give reply to that representation along with statement and evidence in support of his reply within one month of that notice

The Controller will give opportunity of **hearing to the person making such representation** if he (the person) so desires in support of his representation under rule 55 (1) of the Patents Rules, 2003 as amended by The Patents (Amendment) Rules, 2005.

### 8.5 POST-GRANT OPPOSITION PROCEDURE (S. 25(2))

Post grant Opposition : (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 1<sup>st</sup> 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 granted 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 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 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 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.

Any interested person can oppose the grant of Patent within 12 months from the date of publication of grant of a patent by giving notice to Controller in Form-7 with a fee of Rs.1500 for natural person and Rs.6000 for legal entity. The prescribed period for filing notice of opposition is calculated from the date of publication of grant of Patent in the official journal.

#### **Numbering & title**

1. **Person interested (S. 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 a person interested.

2. The notice of opposition shall be made in Form 7 along with the fees (Rs.1500/- for Natural Person and Rs.6000/- for legal entity) and should be filed in duplicate, 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 along with notice of opposition or within 1 year from the date of publication grant of patent and shall deliver to the patentee

a copy of the statement and the evidence. The grounds on which the opposition is based should be stated in the notice of opposition itself.

**8.6 The grounds of opposition available in the post-grant proceedings under section 25(2) are;**

- a) Wrongful obtaining
- b) Prior publication in any specification filed in India on or after 1 January 1912 or prior publication in India or elsewhere in any other document.
- c) Prior claim in complete specification of an Indian Patent.
- d) Prior public use or public knowledge in India
- e) Obviousness and lack of inventive step
- f) Invention not patentable under the Act
- g) Insufficient description of the invention.
- h) Failure to disclose information relating to foreign applications
- i) If convention application, not made within the prescribed time
- j) Incorrect mentioning of source / geographical origin of biological material, if any, used in the invention
- k) The invention is anticipated with regard to Traditional Knowledge of any community any where in the world.

No ground other than the statutory grounds can be taken for opposing a grant

4) The patentee should send reply statement, which covers all grounds upon which opposition is contested to the appropriate office with a copy to the opponent within 2 months from the date of receipt of copy of the written statement and opponents evidence. (Rule 58).

5) The opponent can file reply along with the evidence to the appropriate office with a copy to the patentee within one month and evidence should be strictly confined to the matters in the patentee's evidence (Rule 59)

4) No further evidence shall be delivered by either party except with the leave or direction of the Controller. (Rule 60)

5) On receipt of notice of opposition Controller will constitute an opposition board consisting of three Members, should submit their recommendations to the Controllers after conducting examination on opponent's evidence and patentee's reply. (Refer Sec.25(3) and rule 56).

6) On the receipt of the recommendations of the opposition board along with all evidence filed by the both the parties Controller can fix a hearing but at least ten days notice should be given to the both parties. (Rule 62).

7) If any party desires to be heard they can file a request to the Controller along with fees Rs 1500(Natural person)/Rs 6000 (Legal entity).

8) After hearing and taking in to account of recommendations of opposition board, Controller will decide the opposition and notify his decision to the parties.

9) After filing of opposition, if the patentee desires to withdraw the patent, he shall inform the controller in writing and the controller depending upon the

merits of the case may decide whether costs should be awarded to the opponent.

#### **8.7 ACTION IN CASE OF WRONGFUL OBTAINING (S. 26)**

Where the Controller refuses the application on the ground of obtaining, he may, on the request made by the opponent in the prescribed manner, direct the application to proceed in the name of the opponent with the benefit of priority date attached to the application. However, if only a part of invention described in the complete specification has been obtained from the opponent, the Controller may allow specification to be amended by the exclusion of that part. The opponent may file an application under the Act accompanied by the complete specification for the invention so excluded from the applicant's specification, the opponent will get the same priority date as the earlier application for all other purposes and will be treated as an independent application under the Act.

## CHAPTER IX

### REGISTER OF PATENTS

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#### 9.1 Register of patents and particulars to be entered therein (S. 67)

- 1) Upon the grant of a patent, the Controller will arrange to enter in the register of patents, the name, address and nationality of the grantee as the patentee thereof, the title of the invention (**including the categories specified in section 5 to which the invention relates**), the date of the patent and the date of granting thereof together with address of service of the Patent.
- 2) Such other particulars as the Controller may think fit may be entered in the register in respect of notification of assignment and of transmission of patents, licenses under patents and of amendments, extensions and revocation of Patents, cessation of patents, Restoration of lapsed patents, payment of renewal fees, term of patents, surrender of Patents, compulsory licences etc.
- 3) The Controller shall also enter in the register of Patents, particulars regarding proceeding under the Act before the Controller or the courts in respect of every patent.
- 4) Upon the issue of a certificate of the payment of the prescribed renewal fee in respect of a patent, the Controller will arrange for the entry thereof in the register of patents that the fee has been paid and the date of payment of such fee as stated in the certificate.
- 5) A patentee may make a request in writing to the Controller for the alternation of his name, nationality, address or address for Service as entered in the register of patents in respect of any patent granted to him. The Controller may require such proof of the alteration as he may think fit before acting on a request to alter the name or nationality. If the Controller allows a request made under sub-rule (1) of Rule 94, he shall cause the entries in the register to be altered accordingly.

If a patentee makes a request in writing for entering an additional address for service in India and the Controller is satisfied that the request should be allowed, subject to the condition that no more than two addresses for service shall be entered in the register at any one time.

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 copies of the entries in respect of patent in the register can serve the purpose.

**9.2 Assignments, etc., not to be valid unless in writing and registered (S.69)**

1 An application for registration referred to in sub section (1) of **section 69** shall be made

(a) By a person becoming entitled to a patent or a share in it in Form 16 (second schedule) with prescribed fee (1st schedule).

(b) By a person becoming entitled as mortgagee or a licensee or otherwise to any other interest in a patent in Form 16 with prescribed fee.

2. An application referred to in sub-section (2) of section 69 shall be made by the assignor in Form- 16 with prescribed fee or by a mortgagor, licensor or other party in Form- 16with prescribed fee

3. 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- 16with prescribed fee.

4. 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 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.

5. 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 ----- —Mortgagee etc. mortgage deed etc.  
dated-----and made between-----  
-----of the one part and of the —  
----- other part".

*In Florey & Other's Patent [1962] RPC 186, the hearing officer, regarding the entitlement of co-owners of an equal undivided share in a patent, held that if the existence of an agreement to the contrary is not established beyond reasonable doubt, the patentees are entitled to equal shares in the Patent no matter what their individual efforts amounted to in relation to the whole; and each of co patentee is therefore entitled to an equal share in any benefits accruing from assignment of the Patent. He further observed as a general proportion that "Whatever their several Contributions may have been, the members of a team perusing different aspect of a research project under the direction of a team leader should, in any event, be entitled to an equal share in any benefit resulting from what must inevitably be regard as a joint effort.*

*In Patchett's Patent [1963] RPC 90, the judge held that unless there is some subsisting agreement to the contrary, a co patentee is entitled to receive some part of any payment made in respect of crown use of a patented invention and has a prima facie right to initiate a reference to the court of a dispute as to crown use and that so long as the rest of the co patentees were brought into such references for which purpose their status as co applicant or respondent would appear to be immaterial, the issues between the patentees and the crown would be susceptible of complete resolution.*

### **9.3 Rectification of register by Appellate Board (S. 71)**

The Appellate Board may, on the application of any person aggrieved make rectification in the register

- (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 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.

### **9.4 Register to be open for inspection (S. 72)**

The register will 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 will be given to any person requiring them on payment of the prescribed fee

If the record or particulars is kept in computer floppies or diskettes or in any other electronic form public will be given access to such computer floppies, diskettes or any other electronic form or printouts of such record of particulars for inspection.



## CHAPTER X

### WORKING OF PATENTS AND COMPULSORY LICENSING

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#### 10.1 Working of Invention

Patents are granted for the purpose of exploitation, which will enhance industrial development and therefore should be worked in its fullest extent within the territory of India. S.83 of Patents Act provides 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 reasonably practicable without undue delay and they are not granted merely to enable patentees to enjoy a monopoly for the importation of the patented article.”*

The Patentee and every licensee should furnish the details of working of the invention at every six months and whenever required by the Controller (S. 146)

#### 10.2 Revocation of patent for non-working (S. 85)

1) An application to the Controller for an order revoking the patent under section 85(1) may be made after the expiry of 2 years from the date of order granting the first compulsory license. The application shall be in Form 19 with the prescribed fee. Except in the case of an application made by the Central Govt., the application shall set out the nature of the applicant's interest and the terms and condition of the license the applicant is willing to accept.

2) 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 he shall notify the Central Govt. 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.

3) If the Central Government or any person interested requests for a hearing within the time allowed the Controller shall, after giving the Central Government or any person interested an opportunity of being heard, determine whether the application may be proceeded with or whether it shall be refused.

4) The Controller shall publish the application in the official journal the order made by him under section 85(3) revoking a patent. Then

- a. A 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.

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

### **10.3 COMPULSORY LICENSES (S. 84)**

The provisions for compulsory licenses are made to prevent the abuse of patent as a monopoly and to make the way for commercial exploitation of the invention by an interested person. Any person interested can make an application for grant of compulsory license for a patent after three years from the date of grant of that patent on any of the following grounds –

- a) The reasonable requirements of the public with respect to the patented invention have not been satisfied.
- b) The patented invention is not available to the public at a reasonably affordable price
- c) The patented invention is not worked in the territory of India.

The request for grant of a compulsory license can also be made by a licensee of the patent. Application for compulsory license should be made in Form 17 with the prescribed fee of Rs.1500 for natural person and Rs.6000/- for other than natural person with a statement setting out the nature of the applicant's interest and the facts upon which the application is based.

#### **A) Some Guidelines**

- 1) 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.
- 2) 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.
- 3) Reasonable requirements of the public will be deemed as not satisfied if by reason of the refusal of the patentee to grant a license 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 also are mentioned in S. 84(7)

4) In determining whether to order the grant of a license the Controller also takes account the considerations of the following (S. 84(6))

(i) The nature of the invention and the time since grant of the patent and the measures already taken by the patentee or any licensee to make full use of the invention in order to recognize whether the invention required longer time to establish adequate working. This is reflected by the power under section 86 (1) to adjourn an application to allow sufficient time for working.

(ii) 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

(iii) Whether the applicant has made any genuine efforts to obtain voluntary license from the patentee. This will demonstrate the intention of the person-seeking license that he is really interested in manufacturing the product that is protected under the patent. This provision will not apply in times of national emergency.

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 section 84, he shall notify the applicant accordingly, and unless the applicant requests to be heard in the matter, within one month of the date of such notification, the Controller shall refuse the application. 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.

## **B) Revision of the grant of compulsory license**

a. 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 of Rs.1500/- for natural person / Rs.6000/- for other than natural person 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.

b. 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.

c. 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.

d. 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.

e. 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.

f. 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 2 months 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.

g. 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.

h. No further evidence or statement shall be filed by either party without special leave of or on requisition by the Controller.

i. On completion of the above proceedings or at such other time as he may deem 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.

j. 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

#### **10.4 Compulsory Licensing of Patents relating to the manufacture of pharmaceutical products for export to countries with public health problems.**

Section 92 A of the Patent Act 1970 as amended by The Patents (Amendment) Act 2005 has been recently introduced and this section states:-

92 A. 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].

In order to get compulsory licence under 92 A, the applicant has to file application in Form 17 along with the prescribed fees of Rs.1500/- for natural person and Rs.6000/- for other natural person

**This provision is to be construed in wider sense to allow export to any country having insufficient or no manufacturing capacity in the Pharmaceutical sector whether it is a member of WTO or not. As this section is intended to address the public health problems faced by a country having insufficient or no manufacturing capacity in the pharmaceutical sector and to facilitate access to affordable medicines for the people in these countries, it should be used in good faith and not with the primary purpose of addressing other objectives in particular objectives of a purely commercial nature.**

**It may be noted that this section is an "enabling provision" for export of pharmaceutical products to any country having insufficient or no manufacturing capacity in the pharmaceutical sector in certain exceptional circumstances to address public health problems. The term "provided compulsory licence has been granted by such country" has therefore to be given a liberal meaning and it should be considered to include 'a licence in any form' from such countries also where there is no patent protection or where the drugs in question are not patented.**

## **10.5 GOVERNMENT USE OF THE INVENTIONS**

1. Anytime after filing or grant of patent, Government or any person authorized by it can use the patented invention for the purpose of Government.
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.

3. If an invention is to be used at any time after the grantance of Complete Specification by 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 be decided by High Court under section 103.
4. Government can authorize any person in respect of an invention either before or after the grant whether or not the patentee authorizes that person.
5. Where Government authorizes any person for using an invention for Govt. 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 the undertaking, Government may call for such information from the undertaking.
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.
7. In case, of an exclusive licensee as per section 101 (3) or an assignor, 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.
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.
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
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.
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
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.
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.

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 rules of High Court under Section 103 Government may ask for revocation of 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.

## 10.6 Procedure for grant of compulsory Licence:

The procedure for grant of compulsory licence is not cumbersome. An application under rule 96 of the Patents Rule 2003 as amended by The Patents (Amendment) Rules, 2005, shall be filed on the prescribed Form 17, with the prescribed fees of Rs. 1500 for natural person and Rs. 6000 for others, setting out the nature of applicant's interest, terms and conditions of the licence, that the applicant is willing to accept. 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. The Patentee if so desire, may oppose the application. Thereafter the Controller shall order the grant of licence upon such terms as he may deem fit keeping in view the provisions of Section 90 of the Patents Act. The time for the grant of Compulsory Licence in normal cases may not exceed six months.

Further in the case of availability of compulsory licence by way of notification by the Central Government under section 92 of the Act, an application also on form 17 will be filed. In the case of Section 92 (1), the provisions of Section 87 will apply and the compulsory licence 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 sub-clause (iii) of clause (a) of section 84.

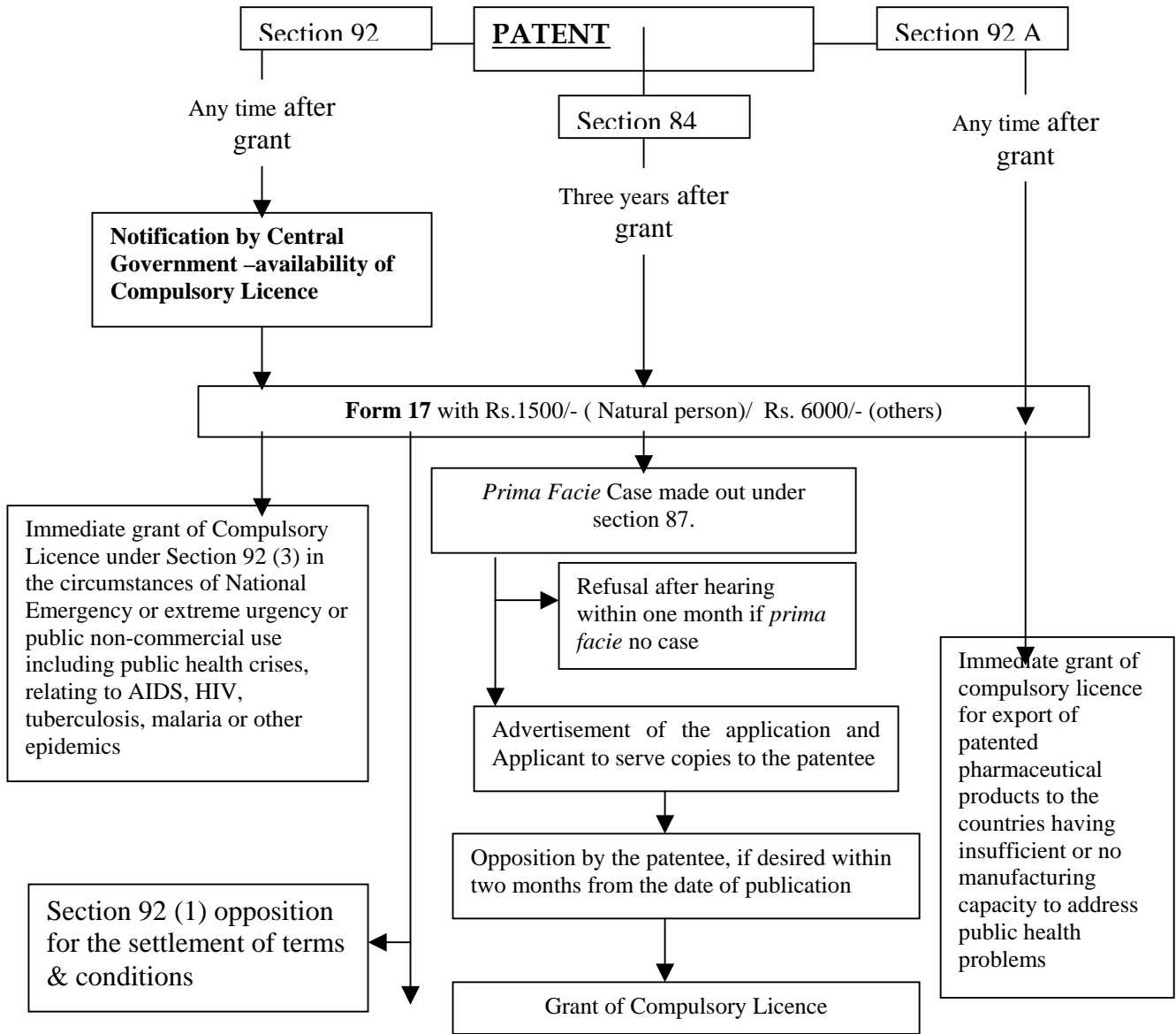
In the case of semi-conductor technology, the licence granted is to work the invention for public non-commercial use. In case the licence is granted to remedy a practice determined after judicial or administrative process to be anti-competitive, the licensee shall be permitted to export the patented product, if need be.

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 the procedure under section 87 will not apply. The Compulsory licence 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.

In case of compulsory licence for export of patented pharmaceutical products to any country having insufficient or no manufacturing capacity to address public health problem, the application will also have to be made on form 17, and the compulsory licence will be granted, immediately under Section 92 A of the Act.



## Procedure for grant of compulsory licence



## CHAPTER XI

### REVOCATION OF PATENTS

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**11.1 A Patent may be revoked by High Court on any of the grounds stated herein after, at any time during the life of the patent.**

- i) On the petition by any person interested or
- ii) On the petition by the Central Government **by the Appellate Board**
- iii) On a counter claim by the defendant in a suit of infringement.

**Subject to the provisions Contained in this Act.**

In a suit for infringement under Sec. 104 the defendant counter-claim for revocation of a Patent may revoke a Patent without any separate petition for revocation.

#### **11.2 Grounds for revocation:**

The following are the grounds of opposition

**a) Invention claimed is the subject of prior grant:**

The provision of this sub section can be applied in a case if it is shown that a claim in the Patent 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 specifies the categories of persons entitled to apply for Patents. If a person made an application for a patent, other than those mentioned in Sec. 6, the Provision of Sec 2(1)(y) applies which defines the term "true and first inventor" which excludes first importer of an invention into India or a person to whom an invention is first communicated from out side India. Accordingly people of these categories are not entitled to apply for Patent under this Act. However, if a patent was obtained under this Act by them, it could be revoked under this sub-section.

**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 for a ground for revocation based on lack of novelty. Novelty of an invention is an essential prerequisite for grant of a Patent. In fact, the very definition of invention under section 2(1)(j) states that the invention must be new. The search for novelty is carried out by the examiners under section 13 to ascertain whether any claim made in the complete specification is anticipated by any prior publication of the subject matter either in Patent specification or in any other documents published in India or elsewhere. Under Section 15 Controller can refuse any patent on the ground that the invention is not new. Accordingly, if any Patent has been obtained for an invention, which lacks in novelty, it could be revoked on this ground.

***Public Knowledge:***

Any matter may form a part of common public knowledge even if it is not published or not in 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, **whether internet information can be considered as a publication shall be specified?** 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 have no inventive step as compared to prior knowledge or prior use.

***Obviousness-***

The dictionary meaning of the word 'obvious' is "Easily perceived by the senses or grasped by the mind" 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 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". [Re: AIR 1945 ordS.er 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 useful as is evident from the definition of

invention under sec 2(1)(j). However the utility of Patent must be judged with reference to the state of art at the date of Patent. '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. Here the practical usefulness or commercial utility of the invention does not matter. [AIR 1964 All 27 at P. 33]

**h) Invention is not sufficiently described:**

This sub section provides for a ground of revocation if the invention has not been sufficiently described in the specification as specified in this section. 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 their 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 in order to protect it from infringement it need not be so simplified as well. 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) Claim not clearly defined and not fairly based.**

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 "fairly based" appears in the Act at places. In sec 10(5) provides that the claim or claim 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 of claims 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 non applicable particularly to such invention which are 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 to his knowledge, the Patent may be revoked on this ground. Here the important point is that this false information must be known to him as false. If the applicant has furnished certain information believing them to be true but happened to be false in fact, this clause of revocation may not cover in such a case.

**n) Non-compliance of secrecy direction**

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.

**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 specification was obtained by fraud it is a ground of opposition.

**p) Specification Wrongly Mentioning or Not Disclosing Geographical Origin.**

It provides that a Patent may be revoked if the applicant had wrongly mentions or does not disclose the source or Geographical origin of Biological Material used for the invention in the details (Specification).

**+Whether it is applicable to commonly available herbs in India**

**+ If the herb derived from indigenous people / community Patent office shall may ask for 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 detail claimed in the specification is anticipated by the knowledge available orally or otherwise within any local or any indigenous community in India or anywhere

There are certain exceptions to the provisions of subsection (1) namely for clause (e) and (f) related to public knowledge and prior public use. It states that if the invention was used secretly as defined in this Act, no account of such use should be taken while considering the provision of clause (e) and (f) of sub-section (1). Also if the Patent relates to an invention-for a process or product as made by a process or the product so made is imported to India shall constitute knowledge or use in India of the invention on the date of importation. However if such importation is for the purpose of reasonable trial or experiment purposes it may also be an exception.

Also S. 64 (3) provides that the exceptions to anticipation given in S. 29 to S. 34 should be considered when dealing with clause (l) of Section 64(1). There is also provision for revoking a patent on the request of central government and due to the non-compliance by applicant the requirement of S. 99 regarding Government use of the invention.

## CHAPTER XII

### **PUBLIC INTEREST PROVISIONS FOR PREVENTING ABUSE OF PATENT RIGHTS**

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#### **12.1 I Purpose of the patent system**

General principles applicable to working of patented inventions are defined in section 83 of the Patents Act, 1970 as amended by the Patents Amendment Ordinance, 2004. According to this section

Patents are granted to encourage inventions and to secure that the invention are worked in India on a commercial scale and to the fullest extent that is reasonably practicable without undue delay.

-That they are not granted merely to enable patentees to enjoy a monopoly for the importation of the patented article.

-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

-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

-That patents granted do not in any way prohibit Central Government in taking measures to protect public health.

-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

-That patents are granted to make the benefit of the patented invention available at reasonably affordable prices to the public.

It could therefore be seen that the patents are granted for **promotion of technological innovation**, patent has to be worked in India and patent granted shall not prohibit government from taking measures **to protect public health**.

#### **12.2 Remedies available in the Patent system against abuse of patent rights**

a) **Compulsory license**

b) **Revocation**

### 12.3 Compulsory license

i) **General Provision:** Controller may grant a license on an application made to him by any interested person, **three years** after the grant of the patent, if the patented invention is not worked in India or not available to the public at affordable prices or if the patented drug is not available in India. According to section 84 of the Patents Act: -

(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: -

- that the reasonable requirements how the reasonable requirements can be justified by patent office of the public with respect to the patented invention have not been satisfied, or
- that the patented invention is not available to the public at a reasonably affordable price, or
- 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 for 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 maybe 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 filed under this section, the Controller shall take into account, -



-The nature of the invention, the time which has elapsed since the grant of the patent and the measures already taken by the patentees or any licensee to make full use of the invention;

-The ability of the applicant to work the invention to the public advantage;

- The capacity of the applicant to undertake the risk in providing capital and working the invention, if application were granted;

- 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 **construed as a period not ordinarily exceeding a period of 6 months** 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.

(7) For the purposes of this Chapter, the reasonable requirements of the public shall be deemed not to have been satisfied-

- 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 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

- 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
- 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
- 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
- if the working of the patented invention in the territory of India on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by
  - (i) the patentee or persons claiming under him; or
  - (ii) persons directly or indirectly purchasing from him;
 or  
 other persons against whom the patentee is not taking or  
 has not taken proceedings for infringement.

**ii) Special provisions for compulsory licence on notification by central Government:**

Compulsory license can be granted **at anytime** after the grant of the patent in the circumstances of

1. **National Emergency**
2. **Extreme emergency or**
3. **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. In such circumstances to avoid delay the general procedure and the provision of oppositions to the grant of compulsory license is waived.**

According to section 92 of the Act:

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 granting 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 maybe practicable, inform, the patentee of the patent relating to the application for such non-application of section 87.

To avoid delay in such circumstances, the general procedure and the provisions of oppositions to the grant of compulsory license are waived.

**Under the provisions of Section 92 A (1) Compulsory licence is 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. Generally patent office may not insist for compulsory license granted by such country but it may be a general license granted by such country where there is no patent protection or where the drugs in question are not patented.**

**When an application is filed for compulsory licence for the reason as specified in the above Para, the controller may grant accordingly and publish such proceedings.**

**“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. “Pharmaceutical substance” is defined in the act as any new entity involving one or more inventive steps.**

#### **12.4 Revocation:**

**(i) General:** 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. Further High Court may revoke a patent if the patentee does not allow the Government to make use of it. 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.

Section 64 states:

##### **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 this 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;
- (b) that the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor;
- (c) that the patent was granted on the application of a person not rights of the petitioner or any person under or through whom he claims;
- (d) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;
- (e) 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;
- (f) 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:

- (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 and 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 (e) 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.

**(ii) Revocation of patent in public interest.** - 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.

### (iii) Revocation of patents for non working:

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.**

### 12.5 General provisions regarding government use of the invention:

Other than compulsory license sufficient safeguards to protect the public interest has been provided in the form of Government use.

- (a) Central government is having the power to use the inventions for purposes of government either by itself or through the state government or any government undertaking. Under section 100 of the Patents 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 by it, may use the invention for the purposes of Government. Section 100 states

Power of Central Government to use inventions for purposes of Government.-

- (1) Notwithstanding anything contained in this Act, at anytime 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 maybe 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 anytime 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 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 licence.

(b) Further the invention can be **acquired by the government for a reasonable cost and the rights transferred to and vested in the government.** In accordance with section 102 of the Patents Act, 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.

The Central Government shall pay to the patentee such compensation as may be agreed upon between the Central Government and the applicant, or the patentee or, as may, in default of agreement, be determined by the High Court on a reference.

Section 102 states

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 maybe 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.
- (c) Grant of patent is further subject to **certain conditions** like any machine apparatus or article for which a patent is granted can be made or imported by government for the purpose of its own use **without payment of any royalty**. Under section 47 of the Act, any

machine, apparatus or other article in respect of which the patent is granted may be made or used for the purpose mere of experiment or research including the imparting of instructions to pupils.

**Under this section 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.**

Section 47 states

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, maybe 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 maybe 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, maybe 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 maybe 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.

Also the government can interfere if the cost of the medicine is prohibitively high

## 12.6 Other provisions:

There is also **Bolar provision**[ **section 107 A(a)**] according to which 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 shall not be considered as a infringement of patent rights. In addition there is a provision enabling to **grant parallel import rights** by duly authorising any person under the law, in order to stabilize the price in India. **Section 107 A (b)** provides 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.

All these measures collectively safeguard the interest of the public.

## CHAPTER XIII

### PATENT AGENTS

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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 particular as may be prescribed of all persons qualified to have their names so entered according to section 126. According to rule 4 such register has to be maintained at the Head Office of the Patent Office, Calcutta. The register will contain the name, nationality address of the principal place of business, branch office address and other relevant particular as may be prescribed, if any, the qualification and the date of registration of entry as Patent agent.

#### 13.1 Qualifications for Registration as Patent Agents (S. 126)

(1) A person will be qualified to have his name entered in the register of patent agents if he fulfils the following conditions, namely:

- (a) He/she is a citizen of India;
- (b) He/she has completed the age of 21 years.;
- (c) He/she 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, -**

**Or**

(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 said above a person who has been registered as a patent agent before the commencement of Patent [amendment] Act, 2002 will be entitled to continue to be, or when required to be re-registered as a patent agent, on payment of the fee.

#### 13.2 Qualifying Examinations for Patent Agents (Rule 110)

In order to maintain high professional efficiency, the Act has provided for certain prescribed qualification for the patent agents, as mentioned above in the section 126. As per clause c (ii) of sub section 1 of section 126 there is a provision for

conducting the qualifying examination for Patent agents, which will consist of a written test and a viva voce examination.

The written Test shall be of two papers i.e. 1) Patents Act and Rules and 2) Drafting and interpretation of Patent specification and other documents of 100 marks each (*Rule 110(2)*). The qualifying marks for written paper & for the viva voce examination is fifty per cent each, and a candidate shall be declared to have passed the examination only if he obtains an aggregate of sixty percent of the qualifying marks (*Rule 110 (3)*)

### **13.3 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 will enter the candidate's name in the register of patent agents and issue to him a certificate of registration as a patent agent.

#### ***Details to be included in an application for the registration of Patent Agents (Rule 112)***

A person, who is entitled to get his name registered as Patent agent under sub section 2 of Section 126, shall also make his request on Form 22 with prescribed fee of Rs. 2000/- giving information regarding his practice as patent agent. The following details will be entered in the register.

- (a) Name and Qualification,
- (b) Address of his/her office including branch office, if any
- (c) Date of Payment of prescribed fee
- (d) Other details as may be necessary

### **13.4 Disqualification for registration as a Patent Agent (*Rule 114*)**

It provides for conditions for disqualification of a person from registration as Patent Agent:

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 undercharged insolvent;
- (iii) Being a discharged insolvent, has 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.

### **13.5 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 specified therefore in the First Schedule i.e. Rs.500 per year.

### **13.6 REGISTER OF PATENT AGENTS (S. 125)**

It is mandatory to maintain a register of patent agents for the purpose of identifying who are the persons registered as and are entitled to work as agents for the purpose of prosecuting the application for patent on behalf of the applicant. The name can be maintained in the register by paying the renewal fee every year. The qualification to be entered as patent agent and other details are described on a separate chapter.

### **13.7 Alteration of names etc. in the register of patent agents (Rule 118)**

(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 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.

### **13.8 Publication of the names of patent agents, registered under the Act (Rule 120)**

The names and addresses of persons registered as patent agents will from time to time will be published in the official journal, newspapers, trade journals and in such other manner as the Controller may deem fit. It will be also published in Annual Report of the Controller General of Patents, Designs and Trade Marks.

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.

Practice 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 country;
- (c) Giving advice other than of a scientific or technical nature as to the validity of patents or their infringement.

*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 unless* 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 **(S. 129)**

### **13.9 Removal from Register of patent agents and restoration (S. 130 and Rule 116)**

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 it thinks fit to make-

(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 removal will be effected when

- (a) A request has been received to that effect; or
- (b) When he/she is dead; or
- (c) Under the provision in S. 130
- (d) If he/she has defaulted in the payment of fees specified in rule 115

The removal of the name of any person from the register of patent agents will be notified in the Official Gazette and will be communicated to the person concerned.

As described above if a person has defaulted in the payment of fees his name will be deleted from the register of Patent Agents. But it is a practice prevailing in the patent office that for these 3 months the agent may take extension after submission of petition under rule 138 with prescribed fee but after the expiry of 3 months period, if the fee is still not paid his name is deleted from the register of Patent agents and is notified in official Gazette and shall be communicated to the person concerned.

*The Controller may, on application and on sufficient cause being shown, restore to the register the name of any person removed there from.* 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 should be made in Form 2 within two months from the date of such removal (*Rule 117(1)*). The restoration of name to the register will be notified by the Controller in the Official Gazette and will be communicated to the person concerned (*Rule 117 (3)*)

If the name of a person is entered in the register of Patents agents, his name shall be continued therein for a period of one year from the date on which his last annual fee became due (*Rule 117 (2)*)

*There is a saving provided in the act that an applicant for a patent or any persons, not being a patent agent, who is duly authorized by the applicant, 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 the proceeding under the Act except the drafting of the specification.*



## CHAPTER XIV

### MISCELLANEOUS PROVISIONS

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#### 14.1 MENTION OF INVENTOR AS SUCH IN PATENT

If the inventor desires to have his name mentioned as such in a patent, 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. The period prescribed for making the request is 2 months after the date of advertisement of acceptance of complete specification, which may be extended by another one month

The request when made by before the grant of patent the applicant for patent or jointly with another inventor, would be on form 8. 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. The Controller will give notice of the claim to the applicant and to any other person who is considered to be interested, and decide the case after hearing the parties concerned, if so required. The person making the request should furnish a sufficient number of copies of application and the statement for the purpose. The Controller will not entertain a request for mentioning the name of person as the actual deviser of invention if it appears to him that the applicant for patent has wrongly obtained the invention from the actual inventor who could succeed in an opposition based on Section 25(l)(a). 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 58 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. The form prescribed in rule 70 does not expressly refer to the register. The Controller may therefore adopt a different form for entry in the register.

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. The Controller will send a copy of application and statement to the applicant or patentee, to the person mentioned as the actual deviser and to any other

person considered to be interested. The applicant should furnish a sufficient number of copies for the purpose.

Any of these persons may oppose the application. The applicant may file his reply statement and the parties will be allowed to leave their evidence. On completion of evidence, the Controller will decide the case after hearing the parties, if required. The procedure to be followed is as stated in rules 58 to 63. If the Controller decides the case in favor of the applicant, he will issue a certificate and rectify the specification and register accordingly.

- (b) Where the applicant or one of the applicants has died before the expiration of the time within which under the provisions of this subsection the request could otherwise be made, the said request may be made at any time within twelve months after the date of the death or at such later time as the Controller may allow.

*The period within which a request for the grant of a patent may be made is extendable to a period of a maximum of three months with a request on Form 4 and prescribed fee*

#### **14.2 Amendment of Patent granted to deceased applicant (S. 44)**

The Controller may amend the patent by substituting for the name of the legal representative. An application for the amendment of a patent should be made in Form 10 with the prescribed fee of Rs.1500 for natural person and Rs.6000 for legal entity should be accompanied by evidence verifying the statements made therein.

#### **14.3 Date of patent (S. 45)**

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. The other provisions which affect the date of patent are:

- a) Antedating the complete specifications necessitated by division of application where the invention related to more than one invention under section 16.
- b) Post dating of the complete specification by order of the Controller when the specification has been amended to comply with the requirements of the office under section 17. The date of patent of addition is determined by the date of patent in respect of the main invention.

#### **14.4 Form, Extent and Effect of patent (S. 46)**

Every patent shall be in the prescribed form and shall have effect throughout India and shall be granted for one inventive concept 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 inventive concept.

A patent shall be in the form as specified in the Third Schedule with some modification as the circumstances of each case may require and shall bear the number accorded to the application after the grant of a complete specification which becomes the Patent number.

#### **14.5 Conditions under which patent is granted (S. 47)**

- 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 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.

#### **14.6 Rights of Patentees (S. 48)**

- a) Where the subject matter of the patent is a product, the exclusive right to prevent third parties, who do not have this 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 product is a process, the exclusive right to prevent third parties, who do not have his consent, from 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;

*The rights of patentee are not infringed if the invention is used on 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. 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.*

#### **14.7 Rights of co-owners of patents (S. 50)**

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.

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 be entitled to deal with the article in the same manner as if the article had been sold by a sole patentee.

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. 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.

#### **14.8 Power of Controller to give directions to co-owners (S. 51)**

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. 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 and the applicant shall supply sufficient number of copies for that purpose.

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. An application for directions under sub-section (2) 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 statement should be sent by the Controller to the person in default.

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.

**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 revoked on the ground that it had been obtained by the patentee in fraud.**

#### **14.9 TERM OF PATENT (S. 53)**

The term of patent is 20 years from the date of the application in respect of all the patents including those which has not expired on 20/05/03 when Patents (Amendment) Act 2002 came into force provided that the renewal fee is paid every year on due date or extended period (Max. **six months**). To keep the patent in force renewal fee should be paid at the expiration of the second year from the date of patent or of any succeeding year before the expiration of the second or succeeding year (Rule 80 (1)). The annual fee payable in respect of two or more years may be paid in advance. The fee to be paid is listed under entry no. 18 of the First Schedule

Whereas renewal fee, which has become due after the grant of patent shall be governed by the provisions of sec. 53 the renewal fees, which has become due at the time of grant of Patent (grant) will be governed by section 142(4). It says that when the patent is granted later than two years from the date of filing of complete specification, 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 fees, which has become due at the time of grant and which has become due after the grant are very close, may be paid together along with required extension under section 53.

#### **14.10 PATENT OF ADDITION**

When an applicant feels that he has come across an invention which is a slight modification on the invention for which he has already applied for / have 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. However Patent will not be granted as patent of addition unless the date filing of

complete specification was the same or later than the date of filing of the complete specification in respect of the main invention (S. 54(1), S. 54 (2) & S. 54(3)).

It should be noted that a **patent of addition** will not be granted before the granting of the patent for the main invention.

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 (**Sad grove V. God Frey, 37 RPC 7**).

#### **Term of Patent of addition (S. 55)**

The term of the patent of addition will run concurrently, that is, 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 application made by the patentee. No renewal fee is payable in respect of a patent of addition so long as the main patent remain 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.

#### **Validity of patent of addition (S. 56)**

*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 to the publication and use of the main invention.*

For determining the novelty of the invention claimed in the complete specification filed in pursuance of an application for patent of addition, regard should be had to 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

#### **14.11 RESTORATION OF LAPSED PATENTS (S. 60)**

When a patent has ceased to have effect under Section 53(2) because of non-payment of renewal fees, 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 any extension therefor for payment of renewal fee should be taken into consideration. The application must be made on Form 15 and accompanied by supporting evidence. Any patent of addition, which is to be restored, 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.

#### **Procedure -**

##### **The Applicant**

Patentee or his legal representative should make the application, and *where two or more persons held the patent jointly, with the Controller's leave by one or some only of them without joining the others.*

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.

If a patentee has failed to register a change of name before cessation he must first apply under *Rule 94* correct 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.

##### **The Statements and Evidence**

- a) 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.
- b) The evidence must be of a recent date as it is required that there should not be any undue delay in making the application.
- c) The evidence may cover several Patents.
- d) 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.
- e) The Controller may call for further evidence, which may include letters, deeds etc.
- f) 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**).
- g) 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.**
- h) 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.

- i) The patentee's financial inconvenience is not admitted as a ground of unintentional failure, but destitution resulting in physical impossibility to pay is considered.
- j) 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.
- k) 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.

### **Opposition to Restoration**

Any person interested may give Notice of opposition to the application within two months of the appearance of the advertisement in the official Gazette. The grounds of opposition are under Section 61(1) are

- (a) That the failure to pay the renewal fee was not unintentional; or / and
- (b) That there has been undue delay in the making of the application.

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.

The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, Reply evidence and hearing 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.

### **Conditions for Restoration**

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 in the official Gazette accordingly [Rule 86(2)].

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 the advertisement of the application for restoration, every order for restoration should include the provision as set out under section 62(1). The Controller may impose other conditions for protection and compensation of the above-mentioned person. 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 advertisement of the application for restoration of the patent.

A patentee or opponent may file appeal in *Appellate Board* from any decision of the Controller made under Section 60 within three months from the date of the decision or within such further time on the *Appellate Board may allow according to the provision of Section 117A(2) and 117A(4)*.

#### **14.12 SURRENDER OF PATENTS (S. 63)**

The patentee may at any time offer to surrender his patent through an application in any convenient format. On receipt of such an offer the Controller will advertise the offer in the Official Gazette and also inform the date of advertisement to 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.

##### **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 advertisement of the notice in the Official Gazette with prescribed fee at entry No. 20 of the First Schedule. On receipt of such a notice the Controller shall inform the Patentee regarding it.

##### **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 rule 36 to 45. 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 return the patent and on the receipt of which, he shall by order, revoke it and notify such revocation in the Official Gazette. The patent will revoke only after the receipt of the "patent" by the Controller. Any order, decision or direction of the Controller under section 63 is appealable in High Court.

#### **14.13 ROLE OF SCIENTIFIC ADVISERS**

Rule 103 (1) requires that the Controller should maintain a roll of scientific advisers for the purpose of Section 115. Rule 103 (2) prescribes certain qualification for

enrolment as a scientific adviser. There is also provision for removal of names from the roll in specified circumstances. Although, there is no statutory obligation for the purpose of Section 115 to choose the scientific advisers from the roll maintained by the Controller, in practice, courts will find it convenient to select one from the roll.

#### **14.14 Controller to have certain powers of a Civil Court (Sec 77)**

Subject to the rules made in this behalf, this section confers powers of a Civil Court on the Controller while trying a suit under the Code of Civil Procedure, 5 of 1908, in respect of the following matters.

- (a) The Controller is empowered to summon and enforce the attendance of any person and examine him on oath, on the lines of order 16 of CPC.
- (b) Every party to a suit is entitled to know the nature of his opponent's case. In such a case, either party may administer interrogatories to his opponent to obtain admission in writing from him to facilitate the proof of his own case. This is called discovery by interrogatories a means for shortening the litigation time. The Controller is empowered to direct and obtain the documents relied upon by them for proving the facts alleged.
- (c) The Controller is empowered to receive evidence on affidavits on the lines of Order 19 of CPC.
- (d) According to order 26 of Civil Procedure Code, some people are exempted from appearing in person during the suit proceeding. In such circumstances, the Controller is empowered to issue Commissions for the examination of witnesses or documents
- (e) In all proceedings before the Controller, the Controller has discretion to award costs which are reasonable having regard to all the circumstances of the case. Awarding costs is subjected to FOURTH SCHEDULE of the Patent Rules. In addition, the Controller may, in his discretion award a compensatory cost in any proceeding before him, which in his opinion is false or vexatious. He is also guided by order 35 of CPC.
- (f) The Controller can be requested to review his decision by filing form 24 with the prescribed fee within one month from the date of communication of such decision. **One-month** extension is allowable provided a request is filed before the expiry of first month. Convincing grounds should follow form 24 such as evidence through which the aggrieved party could have got a favorable decision- on which the revision is sought on examining the evidential grounds the Controller may change his opinion. The Controller's jurisdiction to review his own decision is governed by Order 47 of the Code of Civil Procedure (Rules 2,4,7 and 9).
- (g) Ex party orders may arise in opposition proceedings before the Controller when one of the parties fail to appear at the hearing. In such cases, the Controller can be requested to set aside his order and the powers should be exercised in accordance with the provisions of Order 9, Rules 13 and 14 of CPC. The affected party should make a request by filing form 24 with the prescribed fee within one month from the date of communication. Extension

of time is allowed for further period of one month when a request is made so by filing form 4 with the prescribed fees.

- (h) The Controller can exercise his power on any other matter, which may be prescribed and made in accordance with the relevant provisions of the Civil Procedure Code.

#### **14.15 Power of Controller to correct clerical errors, etc. (SECTION 78)**

The Controller has power to correct any clerical error in any patent, specification document or matter entered in the register either Suo moto or on request made by the person interested by filing the prescribed fee

- 1) If the Controller proposes to correct the error on his own (Suo moto) he shall give notices to the person, who appears to him to be concerned and shall give him an opportunity to be heard.
- (2) When a request is made to the Controller for correcting any error, if Controller feels that if 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.

The power of Controller to correct a clerical error under section 78 is without prejudice to the provisions of sections 57 and 59.

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.

- (3) Any interested person can file an opposition by filing form 14 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.

#### **14.16 Powers of Controller in taking the evidences (SECTION 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. It would therefore appear that Order 19 of the CPC dealing with affidavits is applicable to affidavit evidence except to the extent that any rule under that order is inconsistent with rule 126 of the Patent Rules.
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.

#### **14.17 Exercise of discretionary powers Controller (SECTION 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 10 days in advance of the expiry of the respective time limit.

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. While dealing with applications for extension of time the Controller is not required to give notice or an opportunity of hearing to any party interested in opposing the extension. No appeal will lie from any order granting such extension. (Section 81, Rule 138).

#### **14.18 ACTION AGAINST INFRINGEMENT**

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.

. Section 40 of 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.

The term suit is not defined in the act and it's 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.* This means the case will "stand transferred" in such cases i.e. the District Judge is left with no jurisdiction to buy so as 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.

#### **14.19 REVERSAL OF BURDEN OF PROOF IN CERTAIN CASES (S. 104(A))**

In any suit for infringement of a patent, where the subject matter of patent is a process for obtaining a new product and there is sufficiently 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.

#### **14.20 BOLAR PROVISIONS AND PARALLEL IMPORT PROVISIONS**

Some countries allow manufacturers of generic drugs to use the patented inventions to obtain marketing approval –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 provision” or “regulatory exception”. Indian patent act provides such a provision under **S. 107A(a)**.

**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

#### **14.21 APPELLATE BOARD**

An Appellate board established under the S.83 of the Trade Marks Act, 1999 is the appellate board for appeals to the decision of the Controller and other closely related matters (**S. 116**). This is constituted for speeding up in the legal proceedings in respect of decisions of the Controller by reducing the inadvertent delay occurs otherwise in proceedings before the High court in the same matters. After it has come into existence all the decisions of the Controller lie appealable to the ‘Board’ only. The Appellate board consists of Chairman, Technical Members and other staff.

Every appeal to the decision of the Controller under relevant sections as mentioned in S. 117A (2) section should be in the prescribed form accompanied by the copy of the decision, order and direction appealed against along with the fees that shall be prescribed by the Board. Also the appeal should be made within three months from the date of the decision, order or direction, as the case may be, of the Controller, or within such further time as the Appellate Board may in accordance with the rules made by it allow. Appeal can be made in respect of the decisions of the Controller under S. 17, S. 18, S. 19, S. 20, S. 25, S. 28, S. 51, S. 54, S. 57, S. 60, S. 61, S. 63, S. 66, S. 69(3), S. 78, S. 84, S. 85, S. 88, S. 91, S. 92 and S. 94

The orders passed by Central Govt. 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. It has been held that the validity of the directions issued by the Central Government under S. 20 of the Atomic Energy Act 1962 is beyond challenge in an appeal under the Patents Act, 1970, especially in view of S. 116 (1) of the said Atomic Act.

No appeal lies from an order of the Controller granting extension of time under any provision of the Act or of the rules [See 2]

#### **Transfer of pending proceedings to Board:**

S. 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 the 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 shall be transferred to the Appellate Board from such date that will be notified by the Central Government. Appellate Board may proceed with the appeals either from the beginning or from the stage it was transferred to it.

#### **Procedure for application for rectification, etc, before Appellate Board:**

An application for rectification of register shall be made to the Appellate Board in the form as may be prescribed. Orders for rectification of the registers, if so found fit, shall be passed by the Board to the Patent Office.

#### **14.22 Restriction upon publication of specification (S. 143)**

An application for patent and any specification filed in pursuance thereof will not be published by the Controller or be open to public inspection **except with the consent of the applicant**, *before eighteen months from the date of application or priority date of the application or before the same is open to public inspection in pursuance of section 11(3) or section 43..*

This condition is however subject to the provisions for secrecy of certain inventions as laid down in chapter VII of the Act.

#### **14.23 Information relating to patents (S. 153 & Rule 134)**

Information relating to applications for patents or patents granted can be obtained from the Controller by the making a request in the prescribed manner subject to the payment of prescribed fee (Rs.300 for natural person and Rs.1200 for legal entity). The nature of the information that may be obtained is specified in Rule 134 of the Patent Rules, 2003.

#### **14.24 Reports of Examination to be confidential (S. 144)**

The reports of examiners to the Controller under this Act will not be open to public inspection or be published by the Controller and such reports will 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.

#### **14.25 Reports of the Controller to be placed before the parliament**

Annual report in respect of applications for patent filed in India and the processing of such applications and the execution of the Act will be placed before the parliament.

**14.26 Duplicate of the patent (S. 154)**

If the patent is lost or destroyed, a sealed duplicate of the patent may be obtained by making a request in the prescribed manner and on payment of prescribed fee. The procedure is laid down in rule 132.

**14.27 Evidence of entries, documents, etc to be valid if certified (S. 147 & Rule 133)**

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. The Controller or any other officer of the patent office will 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.

**14.29 Power of Controller to call for information from patentees (S. 146)**

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. Then the 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. Failure to supply such information is an offence punishable under section 122.

In addition to what is said above every patentee and licensee should furnish to the Controller periodical statements as to the extent to which the patented invention has been worked on a commercial basis in India. Such statements should be furnished in the manner prescribed under Rule 131. The Controller may publish the information received by him under section (1) or sub-section (2) of S. 146

**14.30 Security for costs (S. 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.

#### **14.31 Patent to bind Government (S. 156)**

A patent shall have for all intents like effects as against Government as it has against any person, subject to the other provisions of the Act.

#### **14.32 Protection of Security of India (S. 157A)**

For the purposes of this section, the expression "security of India" means any action necessary for the security of India which-

- (i) Relates to fissionable material 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;
- (iii) Is taken in time of war or other emergency in matter of international relations.

This section has been introduced by the Amendment Act, of 1999. It provides that the Central Government will not disclose any information relating to any patentable invention or any application relating to the grant of a patent under this Act, which it considers prejudicial to the interest or security of India. The Central Government will take action including revocation of any patent, if necessary, in the interest of security of India. The section provides for action on similar line as other provisions of section 35 to 38 and 40 to 42.

#### **14.33 PENALTIES**

##### **a) Contravention of secrecy provisions relating to certain inventions (S. 118)**

If any person fails to comply with any directions given under section 35 or makes or causes to be made an application in contravention of section 39 he shall be punishable with imprisonment up to 2 years or with fine or with both. Amount of fine is not specified.

##### **b) Deals with falsification of entries in register etc (S. 119)**

If any person makes, or causes to be made, a false entry in any register kept under this Act, he shall be punishable with imprisonment for a term that may extend to 2 years or with fine or with both. Here also amount of fine is not stated. It may be stated explicitly. "Any register" may include documents other than 'Register of Patents' also like cash receipt books, numbering of patent application etc., 'Any person' includes employees of patent office.

##### **c) Deals with 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 Rs.100000. The use of words 'patent', 'Patented', 'Patent applied for', 'Patent pending', 'Patent registered' without



mentioning the name of the country means they are patented in India or patent applied for in India.

**d) Deals with wrongful use of words, "patent office" (S. 121)**

If any person uses on his place of business or any document he shall be punishable with imprisonment for a term that may extend to 6 months, or with fine, or with both.

**e) Deals with refusal or failure to supply information (S. 122)**

If any person refuses or fails to furnish information as required under section 100(5) and 146 he shall be punishable with fine which may go up to 1000000/-

**Where** 100(5) provides that any person, including central government undertakings, who is 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 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.

**f) Deals with practice by non-registered patent agents (S. 123)**

Any person practicing as patent agent without registering is liable to be punished with a fine of Rs.100000/- in the first offence and Rs.500000/- for subsequent offence.

**g) Deals with offences by companies (S. 124)**

When offence is committed by a company the company as well as every person in charge of and responsible to, the company for the conducts 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.

## ANNEXURE - I

### **Examination Guidelines for Patent Applications relating to Inventions in the field of Chemicals, Pharmaceuticals and Biotechnology.**

#### **Introduction:**

The aim of these guidelines is to help the Examiners in examining patent applications in the field of Pharmaceuticals, Agrochemicals and other chemicals particularly isomers, polymorphs, pro-drugs, active metabolites, hydrates and other chemical substances etc., as patenting the products in the field of chemicals, drugs and agrochemicals and biotechnology, has acquired great significance due to public health aspects, global techno-economic and market scenario and industrial competition in the field .

2. The claims in an application for grant of patent relating to the product may contain the following types of products:

- New drug molecules,
- Pharmaceutical preparations
- Synergistic combinations
- Combination of a new chemical entities with a known component
- Agrochemicals
- New chemical products, in general
- New products resulting through bio-technological, microbiological or biochemical process
- Microorganisms
- New products derived from natural resources

Criteria for granting products patents in a particular field i.e. chemicals, foods, pharmaceuticals or biotechnology etc. will have to be assessed carefully within the legal framework and relevant court-rulings

3. The following aspects are significant for grant of product patents

- Deciding the appropriate prior art
- Assessment of novelty of the claimed product/ process
- Determination of inventive step
- Criteria for industrial applicability
- Unity of invention within the concept of group of inventions
- Sufficiency of disclosure and scope of the claim

4. To qualify for a patent, an inventor must show that his invention is novel, manifests an inventive step i.e., the invention is non-obvious industrially applicable and also does not fall under any of the categories of non-patentable inventions

#### **5.0 Patentability of various forms of chemical substances:**

##### **5.1 Isomers**

5.1.1. 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.

5.1.2. 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. In the second set of compounds, although they have the same molecular formula but are structurally and functionally different. Such isomers even having close structural similarity may be considered to be novel over the prior art. But when such chemical compounds have close structural similarity, similar functional similarities and if it is found that the enabling methods are available, a case of obviousness may be made.

5.1.3. 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.

An example is that cyclohexylstyrene is not considered *prima facie* obvious over prior art isohexyl styrene.

5.1.4. Stereo Isomers are *prima facie* obvious. Once a racemic compound 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 product patent may not be granted for the enantiomers. When a new compound is claimed for the first time in its optically active pure form, product patent may be granted.

In a case (S)-enantiomer of a compound, capable of producing anti-diabetic effects was claimed. The cited prior art disclosed the racemate of the same compound which was claimed for the same purpose and was not allowed.

## 5.2 Homologues

5.2.1. Homologues normally display add on property. They are structurally similar and provide example of Structure - function linearity and may lack inventive step. However the cases are to be examined 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.

5.2.2. Another interesting example is that 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 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.

### 5.3 POLYMORPHS

5.3.1 Some compounds 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 a novel process involving inventive step.

5.3.2. Some therapeutically active ingredients present polymorphic forms, that is, they may crystallize in diverse forms, which 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 were covered by a previous product patent.

**5.4 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)

5.4.1 A metabolite is **unpatentable** since giving the drug to a patient naturally and inevitably results in formation of that metabolite.

### 5.5 PRODRUGS :

5.5.1 Prodrugs are inactive compounds that can produce an active ingredient when metabolized in the body. Hence prodrugs and metabolites are interlinked. When metabolized 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 prodrug may be decided based on the merits of the case.

5.5.2 However , if there is a marked improvement over the primary drug, prodrugs may be patentable.

## **5.6. HYDRATES AND OTHER SUBSTANCES ETC:**

Hydrates, acid addition salts and other derivatives, which are routinely prepared prima facie, lack 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.

## **5.7 Purification:**

Mere purification of known material does not result in patentable subject matter due to lack of novelty and inventive step.

## **6.0 PHARMACEUTICAL COMPOSTIONS**

6.1 The pharmaceutical compositions other than mere admixtures resulting in the aggregation of properties of the ingredients, but having synergistic effect may normally be patentable.

6.2 The known pharmaceutical compositions in different new dosages and different form such as capsules, tablets, syrups, suspensions etc, are not patentable under sections 2(1)(j) , 3(d) and 3(e). of the Act

6.3 New use of known substance or it s new use in a pharmaceutical composition is not normally patentable.

6.4 Any method of using pharmaceutical composition is not patentable

## **7.0 Biotechnological inventions**

In the field of biotechnology the invention may be related to living entity of natural origin, such as animal, plant, human beings including parts thereof, living entity of artificial origin, such as micro-organism, vaccines, transgenic animals and plants etc., biological materials such as DNA, Plasmids, genes, vector, tissues, cells, replicons etc., process relating to living entities, process relating to biological material, methods of treatment of human or animal body, biological process or essentially biological process.

The living entities of natural origin such as animals, plants, in whole or any parts thereof, plant varieties, seeds, species, genes and micro-organism are not patentable.

Any process of manufacture or production relating to such living entities is also not patentable.

Any method of treatment such as medicinal, surgical, curative, prophylactic, diagnostic and therapeutic of human beings or animals or other treatments of similar nature are not patentable.

Any living entity of artificial origin such as transgenic animals and plants, any part thereof are not patentable.

The living entity of artificial origin such as micro-organism, vaccines are considered patentable.

The biological materials such as organs, tissues, cells, viruses etc. and process of preparing thereof are not patentable under Section 3 (c).

The biological material such as recombinant DNA, Plasmids and processes of manufacturing thereof are patentable

provided they are produced by substantive human intervention.

Gene sequences, DNA sequences without having disclosed their functions are not patentable for lack of inventive step and industrial application.

The processes relating to micro-organisms or producing chemical substances using such micro-organisms are patentable.

Essentially biological processes for the production of plants and animals such as method of crossing or breeding etc. are not patentable.

Any biological material and method of making the same which is capable of causing serious prejudice to human, animal or plant lives or health or to the environment including the use of those would be contrary to public order and morality are not patentable such as terminator gene technology.

The processes for cloning human beings or animals, processes for modifying the germ line, genetic identity of human beings or animals, uses of human or animal embryos for any purpose are not patentable as they are against public order and morality.

In case of use of biological material in the invention disclosed in the patent application the source or geographical origin of such material is required to be mentioned in the specification.

In case of use of new biological materials in the invention disclosed in the patent application, such materials are required to be deposited in any of the International Depositary Authorities (IDA) recognized under the BUDAPEST Treaty on or before filing of the application in order to supplement the description for sufficiency of disclosure of the invention and reference of such deposit to be made in the patent specification.

Any invention which in effect is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known components is not patentable.

## ANNEXURE II

### EXAMINATION GUIDELINES FOR PATENTABILITY OF COMPUTER-RELATED INVENTIONS

**AIM-** The aim of this document is to prepare the guidelines for examination of computer related inventions so as to evolve uniform practice within Patent Offices and thereby eliminating different interpretation of the provisions of the Act.

**SCOPE OF THE DOCUMENT:** The document incorporates various provisions of the patentability of computer related inventions. It also deals with the terms used in relation to computer related inventions. It further discusses jurisprudence evolved in granting/rejecting Patent application relating to these fields, the procedure to be adopted by the examiner. The document brings out various examples of the case laws relating to the particular field for better understanding of the issues involved. The document also contains typical examples of the content of the complete specification in respect of description, prior art description, statement of claim and related issues.

#### **Provisions of the Patent Act / Ordinance relating to inventions in this category**

##### **3.1 DEFINITION OF INVENTION**

Section 2(1) (j) A new product or process involving –  
An inventive step and  
Capable of industrial application;

##### **3.2 EXCLUSION FROM PATENTABILITY**

(k) a mathematical or business method or a computer program per se or algorithms is not patentable

(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 game;

(n) a presentation of information;

#### 4. TERMINOLOGY USED IN THE RESPECT OF COMPUTER RELATED INVENTION

**“Computer”** means any electronic, magnetic, optical or other high speed data processing device or system which performs logical, arithmetic and memory functions by manipulations of electronic, magnetic or optical impulses and includes all input, output, processing, storage, computer software or communication facilities which are connected or related to the computer in a computer system or computer network.

**Information processing:** Arithmetic and logical operations or manipulation of information in order to achieve a particular result depending on a use/purpose.

**Software:** Program for information processing on a computer.

**Program:** A set of instructions given to a computer program to make it perform a particular information-processing task or achieve a result some data is also associated with the program.

**Program listings:** Presentation of program codes printed on paper or displayed on a screen, etc.

**Procedure:** A sequence of processes or operations connected in time series to achieve an intended object

**Data structure:** Logical structure of data defined by interrelationship among data elements e.g. linked lists, trees etc.

**Hardware resources:** Physical devices or physical elements used for processing, operation or realization of functions (i.e. a computer as a physical system and constituent elements thereof, such as a CPU, memory, an input device, an output device, or other physical devices peripherals, accessories etc. connected to the computer)

**Firmware:** System software utilities etc. written onto read-only memory (ROM). It is a combination of software and **hardware**. ROMs, PROMs, and EPROMs etc. are considered firmware if they have data or programs recorded on them. It is software that is embedded in a hardware device, that allows reading and executing the software, but does not allow modification, *e.g.*, writing or deleting data

**Algorithm:** A finite set of well-defined instructions for accomplishing some task which, given an initial state, will result in a corresponding recognizable end-state. Algorithms can be implemented by computer programs with the help of suitable hardware resources.



### **Computer program product:**

In practice, the computer program product is claimed as “A computer program product in computer readable medium”, “A computer-readable storage medium having a program recorded thereon”, etc. In such cases the claims are treated as relating to software per se, irrespective of the medium of its storage and are not held patentable.

**Embedded Systems:** An embedded system is a special purpose computer system that is a component in a larger system and that relies on its own microprocessor/microcontroller/digital signal processor. An embedded system is required to meet very different requirements than a general-purpose personal computer. E.g. ATM, Mobile Phones, Washing Machines etc.

### **5.3 Computer implemented inventions**

Means any inventions the performance of which involves the use of computer, computer network or other programmable apparatus/devices, the invention one or more features of which are realized wholly or partially by means of a computer program/programs

### **5.4 Computer Programs:**

Computer programs 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 eg. a series of verbal statements, a flowchart, an algorithm, or other coded form and may be presented in a form suitable for direct entry into a particular computer, or may require transcription into a different format (computer language).

## **6. Contents of typical complete specification of computer related inventions**

### **6.1 sufficiency of disclosure**

If the patent application relates only to a machine i.e hardware based invention, the best mode of operation must 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

### **Prior art**

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 analyse the invention in the light of what is described in 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 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.

## VARIOUS CATEGORIES OF CLAIMS

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

*Method/process:*

*Apparatus/system:*

**Computer program product:**

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

### **7.1 Method/process:**

The method claim should clearly define the steps involved in carrying out the invention. It should have a **technical effect**. 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. **The** 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.

process **/method, in** which process is carried out under the control of a program (whether by means of hardware or software), cannot be regarded as relating to a computer program as such.

Examples:

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.

**A contents display method for displaying contents on a screen,**

**A method for controlling an information processing apparatus, for communicating via the Internet with an external apparatus,**

**A method for transmitting data across an open communication channel on a wireless device that selectively opens and closes a communication channel to a wireless network, and each wireless device including a computer platform and including a plurality of device resources that selectively utilizes a communication channel to communicate with other devices across the network**

**All the above methods though utilise computer programs for its operation, are not computer programs as such and hence allowable**

**On the other hand,**

**A method of executing a computer program, in which at least part of the copy of the program available for execution is analysed to determine whether or not any change has been made thereto, and in the event that a change is detected, a further copy of the program is retrieved and caused to be executed instead of the first copy,**

**A method for generating a new computer program using a software development tool,**

**These are the programs solely intellectual in its context and hence not allowable.**

## **7.2 Apparatus/system:**

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.

Example:

A computer comprising: -

-Means **for** storing signal data,

- A first register **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.

### **7.3 Computer program product:**

The claims relating to software program product are nothing but computer program per se simply expressed on a computer readable storage medium and as such are not allowable.

Example:

If the new feature comprises a set of instructions (programs) 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*.**

## **JURISPRUDENCE**

### **8.1 Pre 1981 position**

Though the Diamond vs. Diehr case opened the door for patenting of software related inventions in a big way, there had been earlier decisions wherein the patentability of software related inventions was upheld

**METHOD OF OPERATING COMPUTER** : A method of operating computer in a program entailing number of operations called 'iterations' characterized in that one iteration was initiated before the previous iterations was completed was not allowed, but a claim to the computer when programmed to operate as described above, being a claim to a machine modified in a particular way was allowed (Slee and Harris's application (1966)RPC 194.

**Gottschalk v. Benson 409 US 63 (1972)**

The issue was conversion of binary coded decimal number to pure binary numbers using a computer based on mathematical formula. In this case. It was held that Mathematical formulae involved had no substantial practical application and was not allowable.

Computer programs having the effect of controlling computers to operate in a particular way, where such programs are embodied in physical form, were held to be patentable. Burroughs corporation application (1974) RPC 147.

**Parker v. Flook 437 US 584,588 (1978)**

The issue was method claimed for updating alarm limit used in a chemical conversion of hydro- carbon. It was held that even the improved method of calculation is not a patentable subject matter.

**Diamond v. Diehr 450 Us 175(1981)** □

US became first country to formally recognize patentability of software after Supreme Court ruling in this case.

- **Invention:** Rubber curing process that was controlled by software.
- **Held** -Since the patent was for rubber curing and not software per se, it was patentable.
- It was decided that invention must be looked on as a whole & not just at what was novel about it.
- Thus computer controlled process could be patentable even if the process, whether controlled by other mean was already known, if the application of the programme used in the process was not obvious.

**Post 1981 era**

**VICOM Systems' Application (1987)**

- It was possible to achieve the invention in a suitably programmed conventional computer
- The examining div. rejected that it was mathematical method.

- Invention- method of digitally processing images in the form of a two-dimensional data array by an operator matrix

- Board held that if a mathematical method is used in a technical process , that process is carried out on a physical entity by some technical means implementing the method and provides as its result in certain change in that entity and allowed the application. The board further held that “Decisive is what technical contribution the invention makes to the known art”.

- The technical means might include a computer comprising suitable hardware or a appropriately programmed general purpose computer

**KOCH & STERZEL (T26/86 EPO OJ 1998)**

**QUESTION**-whether an x-ray apparatus incorporating a data processing unit operating in accordance with a routine was patentable?

**COURT HELD**- the claims related neither to a computer program in the form of a recording on a disc carrier nor to a known general purpose computer in combination with a program

The routine was held to produce “technical effect”. It controlled the x-ray tube so that by establishing a certain parameter priority, optimum exposure was combined with adequate protection against overloading of the x-ray tube,and thus was held patentable.

**FEW MORE CASE LAWS BOTH IN FAVOUR AND AGAINST THE PATENTABILITY OF COMPUTER RELATED INVENTIONS**

	<b>Cases</b>	<b>Invention</b>	<b>Judgement</b>
1	<i>IBM/Data processor network</i> [1990]	A network of data processors connected as nodes by communications links; in a specific example the communications links connect terminals in a banking transaction system and each node has its own program and secure data files. A transaction at one node can be handled at another so that a user of a local	The EPO Technical Board of Appeal concluded that the invention was concerned with <b>the internal workings of the processors and the transmission equipment irrespective of the nature of the data and solved a problem “which is essentially technical”</b> . They therefore allowed the application to proceed.

		<p>program is able to use resources located at remote data processors without needing to know, or to write into the program, the actual location of the resources.</p>	
4	<p><b>Texas Instruments/Language understanding system</b></p>	<p>A computer with a menu based system to enable an operator to make a multi-word input. Each time a word or phrase is entered, the computer operated to parse the resulting text entered so far as to determine the linguistic categories that could follow the entered text and to produce a menu of suitable words or phrases for presentation to the operator. When a sentence was complete and had been confirmed by the operator, the computer translated the sentence into a command executable by the computer.</p>	<p>The Board held that the invention was not primarily concerned with linguistic operations but rather with <b>allowing an operator using his own natural language to feed information into a computer and to operate the computer and that it was a technical matter.</b></p>
5	<p><b>SOHEI/General-purpose management system [1996]</b></p>	<p>A computer programmed to handle at least two different sorts of management information, specifically including financial and inventory information.</p>	<p>The Board decided that there was patentable matter on the basis that while the claims were restricted to handling financial and inventory information, these restrictions were essentially arbitrary and that what mattered was not the kind of information being processed but that there were <b>two different kinds of information which were input via a common "transfer slip" and which were handled separately by the computer.</b> As a consequence it held that the</p>

			<p>substance of the invention was the provision in a computer system of means <b>for handling files containing different kinds of information in particular, appropriate ways and that this was of a technical nature.</b> The Board went on to state that generalized claims relating to such a system or method would be allowable and that the addition to such a patentable system or method of features which of themselves would be excluded, <i>viz</i> those specifically concerning financial or inventory information, did not exclude the resulting invention from being patentable.</p>
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Cases refused:

	Cases	Inventions	Judgement
1	<b>Merril Lynch's Application [1989]</b>	A data processing system for making a trading marketing in securities.	Not allowed u/s 1(2) of UK Patents Act, 1977. It was refused as the invention was relating to method of making a trading market in securities.
2	<b>Gale's Application</b>	A Read Only Memory providing means to evaluate square root of a number by improved method.	<b>It was held that instructions to be used in a computer were not patentable. An ROM was no more than an established type of artifact in which instructions are embedded.</b> The invention is an improved means for carrying out an everyday function of computers. But the instructions do not embody a technical process, which exists outside the computer.
3	<b>Fujitsu's Application</b>	A computer programmed to display and manipulate images	Rejected on the grounds that the <b>invention was a program for a computer, finding no technical</b>



		of crystalline structures.	<b>contribution to be involved and also a method for performing a mental act.</b>
4	<b>IBM/Text processing</b>	A computer programmed to highlight homophones in an entered text, such as "there" and "their", when the rules of grammar suggested that they had been incorrectly used.	No contribution in the technical field.
5	<b>IBM/Document abstracting and retrieving</b>	A system arranged automatically to abstract documents to facilitate their subsequent use as a database that may easily be searched	The Board observed that: "..... the mere setting out ..... of the sequence of steps necessary to perform the activity in terms of functions or functional means to be realized with the aid of conventional computer hardware elements does not impart any technical considerations and can, therefore, neither lend a technical character to the activity nor to the claimed subject matter as a whole ....."
6	<b>Wang Laboratories Inc's Application [1991]</b>	An "expert system" in which a computer was programmed to "stand in" for a human expert and answer questions and give advice or suggestions. The invention lay in the way in which the "knowledge base" was organized, that is in the way in which information was stored.	The machine, the computer, remains the same even when programmed. <b>The computer and the program do not combine together to produce a new computer.</b> They remain separate and amount to a collocation rather than a combination making a different whole system. <b>The contribution is, to my mind, made by the program and no more.</b>
7	<b>IBM/Text processing [1990]</b>	A computer programmed to identify words in an entered text with a reading age higher than a given value, and to	EPO Technical Board of Appeal indicated that if a claim for an apparatus for carrying out a method does not specify any technical features beyond those already comprised in a claim

		offer alternatives to the identified word with reading ages equal to or less than the given value	relating to the method and, furthermore, does not define the apparatus in terms of its physical structure but only in functional terms corresponding to the steps of the method, the claimed apparatus does not contribute anything more to the art than the method, in spite of the fact that the claim is formulated in a different category. In such a case, if the method is excluded from patentability, so is the apparatus.
8	<b>Dell USA's Application</b>	A web-based on-line user interface for enabling a user to custom configure a computer system. The invention provides an interaction between a user and a computer, which to my mind replicates what a customer may do in a store, by telephone or in writing. The user selects options, and the computer advises whether the options are compatible, and whether they can be met within an acceptable time.	<b>That is no more than a respectable salesperson would do.</b> I would not expect to be faced with an application for a patent for a salesperson advising a client, since that is business practice, and in the present instance I hold that the computer program is performing the same role. I do not accept that the steps of advising the user that options are incompatible, or that the lead time is unacceptable represent a technical contribution,..."
9	<b>Fujitsu Limited's Application</b>	A data processing system for managing reservations (eg. of rooms)	Automation may make the method quicker, more accurate, more easily accessible to users and, in the network version, more widely available, but these are the familiar benefits of computerization, and I can see nothing further in the present case, in any of the claims proposed or in the description, which produces a modification of the technical operation of the computer system, or any special

			interaction between the software and the physical computer system which could produce a new technical result. The system is a technical system as Mr Mohun says, <b>but the technology is conventional and the system taken as a whole does not in my view involve a technical effect; that is to say it does not produce a new result in the form of a technical contribution.</b> "
10	<b>Computer generation of Chinese characters [1993]</b>	A computer program for a method of storing, processing, displaying or printing Chinese characters.	Rejected on the grounds that the method claimed was <b>not of technical nature and was merely a method of performing mental acts.</b>
11	<b>Raytheon Co.'s Appln. [1993]</b>	An apparatus for, and a method of, digitally measuring and comparing images by a series of steps.	It was held that to carry out a <b>comparison such as was done by the mind in recognizing an object but doing it electronic means was demonstrably a mental process.</b> The words "Mental Act" should be construed, as they would be understood in ordinary language.
12	<b>Hitachi's Appln [1991]</b>	Compiler The purpose is to translate a source program written in high-level into an object program which could be directly executed	It simply uniforms to "The Doctrine of Mind" and hence not patentable.
13	Gottschalk v Benson 409 U.S.63 (1972)	a faster and more efficient mathematical procedure for transforming the normal "decimal" type of numbers (base 10) into true "binary" numbers (base 2) which are simpler to process within computers. Their mathematical procedure was somewhat akin to long	a patent cannot cover all possible uses of a mathematical procedure or equation within a computer as it is tantamount to granting the inventor a patent on the mathematical procedure itself, and this was no more acceptable than granting Samuel Morse a patent covering all possible uses of magnetism to communicate, rather than a narrower patent covering only the specific way in which Morse actually used

		division, albeit	magnetism to communicate in his telegraph
14	Parker v Flook 437 U.S. 584 (1978)	The claim was for a method of updating the values of at least one alarm limit on at least one process variable where all the processes as stated in the claim were relating to "determining the various values of the process/ variables"	The application was rejected by the examiner but it was reversed by CCPA. However on petition to the supreme court, the application was rejected. The court held that the improved method of calculation even when tied to a specific end use ,is unpatentable subject matter

## 9.CONCLUSION

The statute excludes from patentability the software per se. The inventions relating to the application of the computer program or software is held patentable under the Indian Patent Act, 1970 when claimed in combination of hardware and software components of a computer which provides a "technical advancement " over the prior art. It is necessary for the applicant to describe the "technical contribution" to the prior art when the invention involves software. The technical problem, which needs to be solved by the invention, should be sufficiently described as to how the hardware is controlled by the software to overcome the previously described problem. The "technical character" of the invention should be brought out clearly in the claims.



- |  |          |
|--|----------|
| 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) Priority date/dates
- (2) Application made within 12 months  
          from first application in a convention country
- (3) No. of convention applications involved.
  
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
  46. Preamble to the description

47. Reference to inventor
48. Reference to drawings
49. Reference to original patent
50. Date and signature
51. Duplicate
52. Miscellaneous

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. Request for postponement of acceptance
81. Warning regarding time for putting the application in order of acceptance
82. Specification and drawings generally unsatisfactory

PROVISIONAL / COMPLETE SPECIFICATION

83. 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
84. 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
85. 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) Acceptance deferred in view of unpublished co-pending application.
86. DESCRIPTION - Clerical errors -
- (a) In page to be corrected.
87. 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.
88. DRAWINGS - sufficient -



- (a) Arrangement described in page or / and claimed in claim should be illustrated.
89. CLAIMS - clear -  
 (a) Claims not clear in respect of the expression.  
 (b) Claims not clearly worded.
90. CLAIMS - succinct -  
 (a) Unnecessary repetition  
 (b) Verbose  
 (c) Large number  
 (d) Claim redundant.
91. CLAIMS - definitive -  
 (a) Claims do not sufficiently define the invention.  
 (b) Claim not sufficiently definitive in the absence of explicit statement of invention.
92. 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.
93. TITLE - appropriate -  
 (a) Inconsistent with description and claims
94. 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.
95. ABSTRACT  
 (a) Title  
 (b) Concise summary  
 (c) Size  
 (d) Reference numerals of the Drawings  
 (e) Searchable

96. 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 (i) (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
  - (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
  - (xvii) 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

97. IDENTITY - date -

- (a) Not allowable as an earlier application in respect of identical invention was filed in

98. 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.