

# The Patents Act, 1970

February 25, 2013

[39 of 1970, dt. 19-9-1970]

[As amended by Patents (Amdt.) Act, 2005 (15 of 2005), dt. 4-4-2005]

An Act to amend and consolidate the law relating to patents

Be it enacted by Parliament in the Twenty first Year of the Republic of India as follows:

## Chapter 1 – Preliminary

### Section 1. Short title, extent and commencement

(1) This Act may be called the Patents Act, 1970.

(2) It extends to the whole of India.

(3) It shall come into force on such date as the Central Government may, by notification in the Official Gazette, appoint:

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

### Section 2. Definitions and interpretation

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

<sup>1</sup>[(a) "Appellate Board" means the Appellate Board referred to in section 116;

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

<sup>2</sup>[(aba) "Budapest Treaty" means the Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the Purposes of Patent Procedure done at Budapest on 28th day of April, 1977, as amended and modified from time to time;]

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

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

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

<sup>3</sup>[(d) "convention country" means a country or a country which is member of a group of countries or a union of countries or an Inter-governmental organisation [referred to as a convention country in section 133;]]

(e) "district court" has the meaning assigned to that expression by the CPC, 1908;

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

(g) [Clause (g) omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005]

(h) "government undertaking" means any industrial undertaking carried on—

(i) by a department of the government; or

(ii) by a corporation established by a Central, Provincial or State Act, which is owned or controlled by the government; or

(iii) by a government company as defined in section 617 of the Companies Act, 1956 (1 of 1956) <sup>4</sup>[;or]

<sup>4</sup>[(iv) by an institution wholly or substantially financed by the Government;] [Certain words omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005]

<sup>5</sup>[(i) "High Court", in relation to a State or Union territory, means the High Court having territorial jurisdiction in that State or Union territory, as the case may be;]

<sup>6</sup>[(ia) "international application" means an application for patent made in accordance with the Patent Cooperation Treaty;]

<sup>7</sup>[(j) "invention" means a new product or process involving an inventive step and capable of industrial application;

<sup>5</sup>[(ja) "inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art;]

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

<sup>5</sup>[(l) "new invention" means any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of

filing of patent application with complete specification, i.e. the subject matter has not fallen in public domain or that it does not form part of the state of the art;

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

<sup>4</sup>[(ia) "pharmaceutical substance" means any new entity involving one or more inventive steps;]

<sup>5</sup>[(la) "Opposition Board" means an Opposition Board constituted under sub-section (4) of section 25;]

(n) "patent agent" means a person for the time being registered under this Act as a patent agent;

(o) "patented article" and "patented process" mean respectively an article or process in respect of which a patent is in force;

<sup>6</sup>[(oa) "Patent Co-operation Treaty" means the Patent Cooperation Treaty done at Washington on the 19th day of June, 1970 as amended and modified from time to time;]

(p) "patentee" means the person for the time being entered on the register as the grantee or proprietor of the patent;

(q) "patent of addition" means a patent granted in accordance with section 54;

(r) "patent office" means the patent office referred to in section 74;

(s) "person" includes the government;

(t) "person interested" includes a person engaged in, or in promoting, research in the same field as that to which the invention relates;

<sup>8</sup>[(u) "prescribed" means,—

(A) in relation to proceedings before a High Court, prescribed by rules made by the High Court;

(B) in relation to proceedings before the Appellate Board, prescribed by rules made by the Appellate Board; and

(C) in other cases, prescribed by rules made under this Act;]

(v) "prescribed manner" includes the payment of the prescribed fee;

(w) "priority date" has the meaning assigned to it by section 11;

(x) "register" means the register of patents referred to in section 67;

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

(2) In this Act, unless the context otherwise requires, any reference—

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

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

## COMMENTS

### Appellate Board

Section 116 of the Act provides that the Appellate Board established under section 83 of the Trade Marks Act, 1999 shall be the Appellate Board for the purposes of the Act and the said Appellate Board shall exercise the jurisdiction, power and authority conferred on it by or under the Act. Section 83 of the Trade Marks Act, 1999 provides that the Central Government shall, by notification in the Official Gazette, establish an Appellate Board to be known as the Intellectual Property Appellate Board to exercise the jurisdiction, powers and authority conferred on it by or under that Act. The provisions for composition of the said Board are contained in section 84 of the said Act.

### Assignee

Assignment is the act of transferring to another all or part of one's property, interest or rights. It is a transfer or making over to another of the whole of any property, real or personal, in possession or in action, or of any estate or right therein. It includes transfers of all kinds of property, including negotiable instruments. In other words, it is the transfer by a party of all the rights to some kind of property, usually intangible property such as rights in a lease, mortgage, agreement of sale or a partnership. Tangible property is more often transferred by possession and by instruments conveying title such as a deed or a bill of sale. —Black's Law Dictionary. "Assignment" means the transfer of the claim, right or property to another. The Commissioner of Gift Tax, Madras v. N.S. Getty Chettiar, AIR 1971 SC2410.

An "assignee" is a person to whom an assignment is made; grantee. Assignee in fact is one to whom an assignment has been made in fact by the party having the right; and assignee in law is one in whom the law vests the right, as an executor or administrator.

Assignee means a person appointed by another to do any act or perform any business; also a person who takes some right, title or interest in things by an assignment from an assignor. They are divided into—(1) assignees by deed, as when a lessee of a term sells or assigns it to another, and (2) assignees by law, as when property devolves upon an executor without any specific appointment, the executor is assignee in law to the testator.—Wharton's Law Lexicon.

### Capable of industrial application

An invention, in order to be patentable, must be capable of being made or used in some kind of industry. In this context, "industry" should be understood in its broadest sense as including any useful, practical activity as distinct from purely intellectual or aesthetic activity, and does not necessarily imply the use of a machine or the manufacture of an article. An "invention" within the meaning of the Act is an invention for a manner of new manufacture that is in some way associated with trade and commerce; meaning traffic in goods, i.e., exchange of commodities for money or other commodities—Sri Gajalakshmi Ginning Factory Ltd. v. CIT (1952) 22ITR 502 (Mad). Trade or commerce is carried with profit motive. The expression "invention" has, therefore, been defined in the Patents Act, 1970 to mean manner of manufacture; machine; substance produced by manufacture. The invention relates to the skill (art), series of action

(process) or the particular way (method) or the way (manner) of making a product or thing. It also relates to machine or apparatus by which a thing is made and also the product which is the result of act of making. All these are associated with "manufacture", which word:

- denotes either a thing made which is useful for its own sake and vendible as such; or
- means an engine or instrument to be employed either in the making of some previously known article or in some useful purpose or extending to new process to be carried on by known implements or elements acting upon known substances and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better or more useful kind. [See R. v. Wheeler (1819) 26 & Aid345, quoted with approval in BombayAgarwal Co. v. RamchandAIR 1953 Nag. 154]. The focus in on "manufacture".

#### Controller

Under section 3(1) of the Trade Marks Act, 1999, the Central Government may, by Notification in the Official Gazette, appoint a person to be known as the Controller-General of Patents, Designs and Trade Marks, who shall be the Registrar of Trade Marks for the purposes of that Act. The said officer shall be the Controller for the purposes of the Patents Act also.

#### Convention application

Convention is an agreement or compact; especially, international agreement; e.g. Geneva Convention. It is an assembly or meeting of members or representatives of political, legislative, fraternal, etc. organisations.

Under section 135 of the Patents Act, where a person has made an application for a patent in respect of an invention in a convention country and that person or the legal representative or assignee of that person makes an application under the Act for a patent within 12 months after the date on which the basic application was made, the priority date of a claim of the complete specification being a claim based on matter disclosed in the basic application, is the date of the basic application.

#### Convention country

With regard to international arrangements in respect of patents, with a view to the fulfilment of a treaty, convention or arrangement with any country outside India which affords to applicants for patents in India or to citizens of India similar privileges as are granted to its own citizens in respect of the grant of patents and protection of patent rights, the Central Government may declare such country to be a convention country for the purposes of the Act, vide section 133.

#### District Court

Section 2(4) of the Code of Civil Procedure, 1908 says that, "district" means the local limits of the jurisdiction of a Principal Civil Court of original jurisdiction (called a "District Court") and includes the local limits of the ordinary original civil jurisdiction of a High Court.

#### Exclusive licence

The expression "exclusive" is explicit and significant when the expression is explicit, it is conclusive, alike in what it says and in what it does not say. This is corroborated by the use of the expression "claim" for all purposes—Charan Lal Sahu v. Union of India AIR 1990 SC 1480 (In the context of Bhopal Gas Leak Disaster (Processing of Claims) Act, 1985).

Exclusive licence is the exclusive right granted by patent holder to licensee to use, manufacture, and sell patented article. It is the permission to do a thing and contract not to give leave to any one else to do the same thing—*Overman Cushion Tire Co. v. Goodyear Tire and Rubber Co.* C.C.A. N. Y. 59 F. 2d 998, 999. It is a licence which binds the licensor not to enlarge thereafter the scope of other licences already granted, or increase the number of licences, is an exclusive licence—*Mechanical Ice Tray Corporation v. General Motors Corporation*, C.C.A.N. Y. 144 F. 2d 720,275.

An "exclusive licensee" is one granted exclusive right and licence to use, manufacture, and sell patented article; one having exclusive right to use patented method and apparatus in designated territory.—*De/te/ v. Chisholm*, C.C.A.N.Y. 42 F. 2d 172, 173; *Paul E. Hawkinson Co. v. Carnell*, C.C.A. Pa. 119 F. 2d 396, 398

#### Food

Food is a nutritive material absorbed or taken into the body of an organism which serves for purposes of growth, work or repair and for the maintenance of the vital processes.— *Webster's International Dictionary*.

Under section 2(v) of the Prevention of Food Adulteration Act, 1954, "Food" means any article used as food or drink for human consumption other than drugs and water and includes—

- (a) any article which ordinarily enters into, or is used in the composition or preparation of human food, and
- (b) any flavouring matter or condiments.

Within the meaning of the Prevention of Food Adulteration Rules, 1955, "food" means the composite preparations which normally go to constitute a meal.—*Collector of Central Excise v. Parle Exports (Pvt.) Ltd.* AIR 1989 SC 644

The expression 'food' has generally been understood to mean nutritive material absorbed or taken into the body of an organism which serves for purposes of growth, work or repair and for the maintenance of the vital process. What human beings consume is styled as food and what animals consume is described as animal feed. This distinction has to be borne in mind. Expression 'food-stuffs' is made of two expressions, 'food' plus 'stuff'. In other words, the stuff which is used as food would be foodstuff. Therefore, foodstuff is that which is taken into the system to maintain life and growth and to supply waste of tissue. If the raw foodstuff with a view to making it consumable by human beings undergoes a change of its conditions by the process of cooking, the derivative is none the less foodstuff.—*Welcome Hotel v. State of Andhra Pradesh*, AIR 1983 SC 1015:

Food means an article which normally a man eats or drinks to nourish his body and also an article which normally is not considered food but which normally enters into or is used in the composition or preparation of human food.—*Khedar Lal v. State of U.P.* 1981 FAJ 192 (All)

#### Government undertaking

Undertaking means business, project or works undertaken; something undertaken; a promise, a pledge. Under section 2(v) of the Monopolies and Restrictive Trade Practices Act, 1969, "undertaking" means an undertaking which is engaged in the production, supply, distribution or control of goods of any description or the provision of service of any kind.

Undertaking means the entire organization. A company whether it has a plant or whether it has an organization is considered as one whole unit, and the entire business of the going concern is

embraced within the word 'undertaking'.—*Rustom Cavasjee Cooper v Union of India* AIR 1970 SC 564: (1970) 1 SCJ 564: (1970)2 SCA 37.

The term "undertaking" must be defined as any business or any work or project resulting in material goods or material services and which one engages in or attempts as an enterprise analogous to business or trade.—*Secretary, Madras Gymkhana Club Employees' Union v. Management of the Gymkhana Club*, AIR 1968 SC 554.

The word "undertaking" as used in Section 25-FFF of the Industrial Disputes Act used its ordinary sense, connoting thereby any work, enterprise, project or business undertaking. It is not intended to cover the entire industry or business of the employer.—*Workmen of the Straw Board Manufacturing Co. Ltd. v. Straw Board Manufacturing Co. Ltd.*, AIR 1974 SC 1132.

According to its dictionary meaning as given by Webster, "undertaking" means anything undertaken; any business, work or project which one engages in or attempts; an enterprise.—*The Workmen of Indian Standards Institution v. The Management of Indian Standards Institution*, AIR 1976 SC 145.]

### Invention

Invention is the act or operation of finding out something new; the process of contriving and producing something not previously known or existing, by the exercise of independent investigation and experiment. Also the article or contrivance or composition so invented—*Smith v. Nichols*, 88 U.S. (21 Wall.) 112, 22 LEd. 566; *Hollister v. Mfg. Co.*, 113 U.S. 59, 5 S.Ct. 717, 28 LEd. 901.

Invention is a concept; a thing involved in the mind; it is not a revelation of something which exists and was unknown, but is creation of something which did not exist before, possessing elements of novelty and utility in kind and measure different from and greater than what the art might expect from skilled workers—*Pursche v. Atlas Scraper & Engineering Co. C.A. Cal.*, 300 F.2d 467, 472. The finding out—The contriving, the creating of something which did not exist, and was not known before, and which can be made useful and advantageous in the pursuits of life, or which can add to the enjoyment of mankind. Not every improvement is invention; but to entitle a thing to protection it must be the product of some exercise of the inventive faculties and it must involve something more than what is obvious to persons skilled in the art to which it relates. Mere adaptation of known process to clearly analogous use is not invention.—*Firestone Tire and Rubber Co. v. U.S. Rubber Co.*, C.C.A. Ohio, 79 F.2d 948, 952, 953.

Inventive skill has been defined as that intuitive faculty of the mind put forth in the search for new results, or new methods, creating what had not before existed, or bringing to light what lay hidden from vision; it differs from a suggestion of that common experience which arose spontaneously and by a necessity of human reasoning in the minds of those who had become acquainted with the circumstances with which they had to deal.—*Hollister v. Mfg. Co.*, 113 U.S. 59, 5 S.Ct. 717, 28 L.Ed. 901. Invention, in the nature of improvements, is the double mental act of discerning, in existing machines, processes or articles, some deficiency, and pointing out the means of overcoming it.

Under section 2(8) of the Patents and Designs Act, 1911, "invention" means any manner of new manufacture and includes an improvement and an allied invention. Unlike the Patents Act, 1970, the 1911 Act does not specify the requirement of being useful in the definition of "invention". But courts have always taken the view that a patentable invention, apart from being a new manufacture, must also be useful. The foundation for this judicial interpretation is to be found in the fact that section 26(1)(f) of the 1911 Act recognises lack of utility as one of the grounds on which a patent can be revoked.—*Bishwanath Prasad Radhey Shyam v, Hindustan Metal Industries* AIR 1982 SC 1444.

## Legal representative

The term "legal representative" in its broadest sense means one who stands in place of, and represents the interests, of another. He is a person who oversees the legal affairs of another.

A "legal representative" ordinarily means a person who in law represents the estate of a deceased person or a person on whom the estate devolves on the death of an individual.—Gujarat State Road Transport Corporation v. Ramanbhai Prabhat Bhai, AIR 1987 SC 1690: "Legal representatives" include heirs as well as persons who represent the state even without title either as executors or administrators in possession of the estate of the deceased.—Custodian of Branches of BANCO National Ultramarino v. Nalini Bai Naique, AIR 1989 SC 1589:

Legal representative is a person who in law represents the estate of a deceased person, and includes any person who intermeddles with the estate of the deceased and where a party sues or is sued in a representative character, the person on whom the estate devolves on the death of the party so suing or sued.—Civil Procedure Code 1908, s. 2(11); Arbitration Act 1940, s. 2(d); Gift-Tax Act 1958, s. 2(xvi) (b).

The term conceives of two distinct categories. Firstly, the heirs or persons, who in law represent the estate of the deceased person. However, at par with them and in a class by itself is any person who intermeddles with the estate of the deceased. Such a person is equally a legal representative.—Sudama Devi v Jogendra Choudhury AIR 1987 Pat 239. Medicine or drug

Drug includes all medicines for internal or external use of human beings or animals and all substances intended to be used for or in the diagnosis, treatment, mitigation or prevention of disease in human beings or animals.—Sk. Amir v. State of Maharashtra AIR 1974 SC 469

Under section 3(b) of the Drugs and Cosmetics Act, 1940, "drug" includes—

(i) all medicines for internal or external use of human beings or animals and all substances intended to be used for or in the diagnosis, treatment, mitigation or prevention of disease in human beings or animals; and

(ii) such substances (other than food) intended to affect the structure or any function of the human body or intended to be used for the destruction of vermins or insects which cause disease in human beings or animals, as may be specified from time to time by the Central Government by notification in the Official Gazette.

'Drug' includes—

(i) all medicines for internal or external use of human beings or animals and all substances intended to be used for or in the treatment, mitigation or prevention of disease in human beings or animals other than medicines and substances exclusively used or prepared for use in accordance with the Ayurvedic or Unani systems of medicine; and

(ii) such substance (other than food) intended to affect the structure or any function of the human body or intended to be used for the destruction of vermins or insects which cause disease in human beings or animals, as may be specified from time to time by the Central Government by notification in the Official Gazette. Drugs Act 1940, s. 3(b).

'Drug' includes—

(i) a medicine for the internal or external use of human beings or animals;



(ii) any substance intended to be used for or in the diagnosis, cure, mitigation, treatment or prevention of disease in human beings or animals;

(iii) any article, other than food, intended to affect or influence in any way the structure or any organic function of the body of human beings or animals; (iv) any article intended for use as a component of any medicine, substance or article, referred to in sub-clauses (i), (ii) and (iii).  
Drugs and Magic Remedies (Objectional Advertisements) Act, 1954, s. 2(b).

'Drug' means any drug as defined in clause (b) of section 3 of the Drugs Act, 1940 (XXIII of 1940), in respect of which a declaration has been made under s. 3. Drugs (Control) Act 1950.

#### Patent

Patent is a grant or right to exclude others from making, using or selling one's invention and includes right to license others to make, use or sell it.

It is an official document conferring a right or privilege, letters patent; writing securing to an inventor for a term of years the exclusive right to make, use and sell his invention; the monopoly or right so granted.—Webster's Ninth New Collegiate Dictionary.

The effect of the grant of patent is quid pro quo, quid'ts the knowledge disclosed to the public and quo is the monopoly granted for the term of the patent. Section 12, Patents and Designs Act sets out that a Patent once granted confers upon the patentee the exclusive privilege of making, selling and using the invention throughout India and of authorising others so to do. This is quo. The quid is compliance with the various provisions resulting in the grant of patent.—Raj Parkash v Mangat Ram Choudhary AIR 1978 Del 1:

#### Patentee

"Patentee" is he to whom a patent has been granted. The term is usually applied to one who has obtained letters patent for a new invention.

Patentee includes assignee of patent whose name is entered into the register of patents.—Luxmi Dutta v. Nankaus AIR 1964 All 27

#### Person

In general usage, a human being (i.e. natural person), though by statute term may include labor organizations, partnerships, associations, corporations, legal representatives, trustees, trustees in bankruptcy, or receivers.

'Person' shall include any company or association or body of individuals, whether incorporated or not.—General Clauses Act 1897, s. 3(42); Indian Penal Code 1860, s. 11. The definition of the term in the General Clauses Act is not exhaustive. It is hardly a definition. It only indicates the intention of legislature to treat artificial persons as persons.—Jabbar v State of UP. AIR 1966 All 590.

Section 11, I.P.C. defining a person includes within its ambit a company or association or body of persons whether incorporated or not. It may seem prima facie that a corporate body or a body of unincorporated persons is punishable as an ordinary individual. But, the clause "unless there is anything repugnant to the subject or context" must always be understood to exist in the context of the definition given in Penal Code. So a corporate body or a company shall not be indictable for offences which can be committed only by a human individual (e.g., rape, bigamy etc.) or for offences which must be punished by imprisonment (e.g. cheating).—Sfave of Maharashtra v Syndicate Bank AIR 1964 Bom 95: (1964) 2 Cr U 276.

In general, a corporation is in the same position in relation to criminal liability as a natural person and may be convicted of common law and statutory offences including those requiring mens rea. There are, however, crimes which a corporation is incapable of committing or of which a corporation cannot be found guilty as principal; nor can a corporation be convicted of a crime for which death or imprisonment are the only punishments.

Criminal liability of a corporation arises where an offence is committed in the course of corporation's business by a person in control of its affairs to such a degree that it may fairly be said to think and act through him so that his actions and intent are the actions and intent of the corporation.—Halsbury's Laws of England, 4th Ed. Vol. 11, para 34, p. 30.

Under section 2(31) of the Income Tax Act, 1961 "person" includes—

- (i) an individual,
- (ii) a Hindu undivided family,
- (iii) a company,
- (iv) a firm,
- (v) an association of persons or a body of individuals, whether incorporated or not,
- (vi) a local authority, and
- (vii) every artificial juridical person, not falling within any of the preceding sub-clauses. Income-tax Act 1961, s. 2(31).

In Order 30, Rule 10, Code of Civil Procedure 1908, the word 'person' does not include a company, because such a construction will be repugnant to the context.—Modi Vanaspati v Khaitan Jute Mills AIR 1969 Cat 496.

The General Clauses Act, 1897 defines that "person" shall include any company, or association or body of individuals whether incorporated or not". The word "person" in section 4 of the Indian Partnership Act which has replaced section 239 of the Indian Contract Act contemplates only natural or artificial, that is, legal persons and therefore a firm, is not a person and as such is not entitled to enter into Partnership with another firm or Hindu undivided family or individual.—Dulichand Laxminarayan v. Commissioner of Income Tax, Nagpur, AIR 1956SC 354:

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1. Substituted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.
2. Inserted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
3. Substituted for "notified as such under sub-section (1) of section 133" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
4. Inserted by Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
5. Substituted, *ibid*.
6. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide SO 561(E), dt. 20-5-2003.
7. Substituted, *ibid*.

8. Substituted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide SO 561(E), dt. 20-5-2003.

## Chapter II – Inventions not Patentable

### Section 3. What are not inventions

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

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

<sup>1</sup>[(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;]

(c) the mere discovery of a scientific principle or the formulation of an abstract theory <sup>2</sup>[or discovery of any living thing or non-living substance occurring innatur;]

<sup>3</sup>[(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;]

(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;

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

(g) [Omitted by Patents (Amdt.) Ad, 2002, w.e.f. 20-5-2003 vide S.O.561(E), dt. 20-5-2003]

(h) a method of agriculture or horticulture;

(i) any process for the medicinal, surgical, curative, prophylactic <sup>4</sup>[diagnostic, therapeutic] or other treatment of human beings or any process for a similar treatment of animals <sup>5</sup>[xxxxx] to render them free of disease or to increase their economic value or that of their products.

<sup>4</sup>[(j) plants and animals in whole or any part thereof other than micro-organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;

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

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

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

(n) a presentation of information;

(o) topography of integrated circuits;

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

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1. Substituted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.
2. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.
3. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
4. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E),dt. 20-5-2003.
5. Words "or plants" omitted, by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

## Section 4. Inventions relating to atomic energy not patentable

No patent shall be granted in respect of an invention relating to atomic energy falling within sub-section (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962).

## Section 5. [Omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005]

[Omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005]

# Chapter III – Applications for Patents

## Section 6. Persons entitled to apply for patents

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

- (a) by any person claiming to be the true and first inventor of the invention;
- (b) by any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application;
- (c) by the legal representative of any deceased person who immediately before his death was entitled to make such an application.

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

## Section 7. Form of application

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

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

<sup>2</sup>[(1B) The filing date of an application referred to in sub-section (1A) and its complete specification processed by the patent office as designated office or elected office shall be the international filing date accorded under the Patent Cooperation Treaty.]

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

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

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

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1 Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E),dt. 20-5-2003.

2. Inserted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

3. Substituted for "ownei" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

4. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 8. Information and undertaking regarding foreign applications

(1) 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 subsequently <sup>2</sup>[within the prescribed period as the Controller may allow]]—

<sup>3</sup>[(a) a statement setting out detailed particulars or such application; and]

(b) an undertaking that, <sup>4</sup>[up to the date of grant of patent in India,] he would keep the Controller informed in writing, from time to time, of <sup>5</sup>[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 the prescribed time.

<sup>1</sup>[(2) At any time after an application for patent is filed in India and till the grant of a patent or refusal to grant of a patent 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 to the Controller information available to him within such period as may be prescribed.]

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1. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
  2. Substituted for "within such period as the Controller may, for good and sufficient reasons, allow" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
  3. Substituted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.
  4. Substituted for "up to the date of the acceptance of his complete specification filed in India" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
  5. Substituted for "details of the nature referred to in" by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E),dt. 20-5-2003.

## Section 9. Provisional and complete specifications

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

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

<sup>2</sup>[PROVIDED that the period of time specified under sub-section (1) shall be reckoned from the date of filing of the earliest provisional specification.]

<sup>1</sup>[(3) Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) is accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant so requests at any time within twelve months from the date of filing of the application, direct that such specification shall be treated, for the purposes of this Act, as a provisional specification and proceed with the application accordingly.]

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

### COMMENTS

Mere arrangement or rearrangement or duplication of a known device cannot be patented.—  
Standipack Pvt. Ltd. v. Oswal Trading Co. Ltd. 1999 (19) PTC 479 (Del)

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1. Substituted by the Patents (Amdt.) Act 2005, w.e.f. 1-1-2005.
  2. Inserted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

3. Substituted for "the acceptance of the complete specification" by the Patents (Amdt.) Act, 2005 w.e.f. 1-1-2005.

## Section 10. Contents of specifications

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

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

(3) If, in any particular case, the Controller considers that an application should be further supplemented by a model or sample of anything illustrating the invention or alleged to constitute an invention, such model or sample as he may require shall be furnished <sup>1</sup>[before the application is found in order for grant of a patent] but such model or sample shall not be deemed to form part of the specification.

(4) Every complete specification shall—

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

(b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and

(c) end with a claim or claims defining the scope of the invention for which protection is claimed.

<sup>2</sup>[(d) be accompanied by an abstract to provide technical information on the invention:

PROVIDED that—

(i) the Controller may amend the abstract for providing better information to third parties; and

(ii) if the applicant mentions a biological material in the specification which may not be described in such a way as to satisfy clauses (a) and (b), and if such material is not available to the public, the application shall be completed by depositing <sup>3</sup>[the material to an international depository authority under the Budapest Treaty] and by fulfilling the following conditions, namely:—

<sup>4</sup>[(A) the deposit of the material shall be made not later than the date of filing the patent application in India and a reference thereof shall be made in the specification within the prescribed period;]

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

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

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

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

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

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

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

#### COMMENTS

Where the invention has not been properly described and will not function in the way claimed by the applicants, the opponents succeed even when they fail to establish "prior publication" as well as "prior public knowledge" and, therefore, the application for grant of patent is liable to be rejected.—*Abid Kagalwala v. Edgar Haddley Co. (P) Ltd.* 1984 PTC 234 (PO)

Where the invention claimed by the plaintiff involves nothing which is outside the probable capability of skilled craftsman having regard to what was already known in the country and there being no new manner of manufacture or a distinctive improvement on the old contrivance involving novelty or inventive step, *ex parte* injunction granted is liable to be vacated.—*Surendra Lal Mahendra v. Jain Glazers* 1981 PTC 112 (Del)

It is incumbent under section 10(4) to fully and particularly describe the invention and its operation or use and the method by which it is to be performed and disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection ending with a claim or claims defining the scope of the invention for which protection is claimed.—*Ram Narain Kher v. Ambassador Industries* PTC (Suppl.) (1) 180 (Del).

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1. Subs, for "before the acceptance of the application" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

3. Substituted for "the material to an authorised depository institution as may be notified by the Central Government in the Official Gazette" by the Patents (Amdt) Act, 2005, w.e.f. 1-1-2005.

4. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

5. Substituted by Patents (Amdt.) Act. 2002, w.e.f. 20-5-2003 vide S.O. 561 (E), dt. 20-5-2003.

## Section 11. Priority dates of claims of a complete specification

(1) There shall be a priority date for each claim of a complete specification.



(2) Where a complete specification is filed in pursuance of a single application accompanied by—

(a) a provisional specification; or

(b) a specification which is treated by virtue of a direction under sub-section (3) of section 9 as a provisional specification,

and the claim is fairly based on the matter disclosed in the specification referred to in clause (a) or clause (b), the priority date of that claim shall be the date of the filing of the relevant specification.

(3) Where the complete specification is filed or proceeded with in pursuance of two or more applications accompanied by such specifications as are mentioned in sub-section (2) and the claim is fairly based on the matter disclosed—

(a) in one of those specifications, the priority date of that claim shall be the date of filing of the application accompanied by that specification;

(b) partly in one and partly in another, the priority date of that claim shall be the date of the filing of the application accompanied by the specification of the later date.

<sup>1</sup>[(3A) Where a complete specification based on a previously filed application in India has been filed within twelve months from the date of that application and the claim is fairly based on the matter disclosed in the previously filed application, the priority date of that claim shall be the date of the previously filed application in which the matter was first disclosed.]

(4) Where the complete specification has been filed in pursuance of a further application made by virtue of sub-section (1) of section 16 and the claim is fairly based on the matter disclosed in any of the earlier specifications, provisional or complete, as the case may be, the priority date of that claim shall be the date of the filing of that specification in which the matter was first disclosed.

(5) Where, under the foregoing provisions of this section, any claim of a complete specification would, but for the provisions of that sub-section, have two or more priority dates, the priority date of that claim shall be the earlier or earliest of those dates.

(6) In any case to which sub-sections (2), (3), H(3A)]; (4) and (5) do not apply, the priority date of a claim shall, subject to the provisions of section 137, be the date of filing of the complete specification.

(7) The reference to the date of the filing of the application or of the complete specification in this section shall, in cases where there has been a post-dating under section 9 or section 17 or, as the case may be, an ante-dating under section 16, be a reference to the date as so post-dated or ante-dated.

(8) A claim in a complete specification of a patent shall not be invalid by reason only of —

(a) the publication or use of the invention so far as claimed in that claim on or after the priority date of such claim; or

(b) the grant of another patent which claims the invention, so far as claimed in the first mentioned claim, in a claim of the same or a later priority date.

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1. Inserted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Chapter IV – [Publication and Examination of Applications]

### Section 11 A. Publication of applications

<sup>1</sup>[PUBLICATION AND EXAMINATION OF APPLICATIONS]

<sup>2</sup>[Publication of applications. <sup>3</sup>[(1) Save as otherwise provided, no application for patent shall ordinarily be open to the public for such period as may be prescribed.

(2) The applicant may, in the prescribed manner, request the Controller to publish his application at any time before the expiry of the period prescribed under sub-section (1) and subject to the provisions of sub-section (3), the Controller shall publish such application as soon as possible.

(3) Every application for a patent shall, on the expiry of the period specified under subsection (1), be published, except in cases where the application—

(a) in which secrecy direction is imposed under section 35; or

(b) has been abandoned under sub-section (1) of section 9; or

(c) has been withdrawn three months prior to the period specified under sub-section (1).]

(4) In case a secrecy direction has been given in respect of an application under section 35, then it shall be published after the expiry of the period <sup>4</sup>[prescribed under sub-section (1)] or when the secrecy direction has ceased to operate, whichever is later.

(5) The publication of every application under this section shall include the particulars of the date of application, number of application, name and address of the applicant identifying the application and an abstract.

(6) Upon publication of an application for a patent under this section—

(a) the depository institution shall make the biological material mentioned in the specification available to the public;

(b) the patent office may, on payment of such fee as may be prescribed, make the specification and drawings, if any, of such application available to the public.

<sup>5</sup>[(7) On and from the date of publication of the application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for the invention had been granted on the date of publication of the application:

PROVIDED that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been granted:

PROVIDED FURTHER that the rights of a patentee in respect of applications made under sub-section (2) of section 5 before the 1st day of January, 2005 shall accrue from the date of grant of the patent:

PROVIDED ALSO that after a patent is granted in respect of applications made under sub-section (2) of section 5, the patent-holder shall only be entitled to receive reasonable royalty from such enterprises which have made significant investment and were producing and marketing the concerned product prior to 1-1-2005 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.]

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1. Substituted for "Examination of Applications" by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561 (E), dt. 20-5-2003.

2. Inserted, *ibid*.

3. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

4. Substituted for "of eighteen months" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

5. Inserted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 11 B. Request for examination

<sup>1</sup>[(1) No application for a patent shall be examined unless the applicant or any other interested person makes a request in the prescribed manner for such examination within the prescribed period.]

<sup>2</sup>[(2) xxx]

<sup>1</sup>[(3) In case of an application in respect of a claim for a patent filed under sub-section (2) of section 5 before the 1st day of January, 2005 a request for its examination shall be made in the prescribed manner and within the prescribed period by the applicant or any other interested person.]

(4) In case the applicant or any other interested person does not make a request for examination of the application for a patent within the period as specified under sub-section (1) <sup>3</sup>[x x x] or sub-section (3), the application shall be treated as withdrawn by the applicant:

<sup>1</sup>[PROVIDED that—

(i) the applicant may, at any time after filing the application but before the grant of a patent, withdraw the application by making a request in the prescribed manner; and

(ii) in a case where secrecy direction has been issued under section 35, the request for examination may be made within the prescribed period from the date of revocation of the secrecy direction.]

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1. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

3. "or sub-section (2)" omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 12. Examination of application

(1) When a request for examination has been made in respect of an application for a patent in the prescribed manner<sup>1</sup> [under sub-section (1) or sub-section (3) of section 11B, the application and specification and other documents related thereto shall be referred at the earliest by the Controller] to an examiner for making a report to him in respect of the following matters, namely,—

(a) whether the application and the <sup>2</sup>[specification and other documents relating thereto] are in accordance with the requirements of this Act and of any rules made thereunder;

(b) whether there is any lawful ground of objection to the grant of the patent under this Act in pursuance of the application;

(c) the result of investigations made under section 13; and

(d) any other matter which may be prescribed.

(2) The examiner to whom the application and the <sup>3</sup>[specification and other documents relating thereto] are referred under sub-section (1) shall ordinarily make the report to the Controller within <sup>4</sup>[such period as may be prescribed].

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1. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Substituted for "specification relating thereto" by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561 (E),dt. 20-5-2003.

3. Substituted for "a period of eighteen months from the date of such reference" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

4. Words "as the Controller may direct" omitted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561 (E),dt. 20-5-2003.

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

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

(a) has been anticipated by publication before the date of filing of the applicant's complete specification in any specification filed in pursuance of an application for a patent made in India and dated on or after the 1st day of January, 1912;

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

(2) The examiner shall, in addition, make an investigation [x x x] for the purpose of ascertaining, whether the invention, so far as claimed in any claim of the complete specification,

has been anticipated by publication in India or elsewhere in any document other than those mentioned in sub-section (1) before the date of filing of the applicant's complete specification.

(3) Where a complete specification is amended under the provisions of this Act before <sup>1</sup>[the grant of a patent], the amended specification shall be examined and investigated in like manner as the original specification.

(4) The examination and investigations required under section 12 and this section shall not be deemed in any way to warrant the validity of any patent, and no liability shall be incurred by the Central Government or any officer thereof by reason of, or in connection with, any such examination or investigation or any report or other proceedings consequent thereon.

#### COMMENTS

Prior registration of patent in another country prima facie constitutes prior publication and is liable to be rejected.—*Lintech Electronics (P) Ltd. v. Marvel Engineering Co.* 1995 (35) DRJ 11

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1. Substituted for "it has been accepted" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 14. Consideration of the report of examiner by Controller

<sup>1</sup>[Consideration of the report of examiner by Controller. Where, in respect of an application for a patent, the report of the examiner received by the Controller is adverse to the applicant or requires any amendment of the application, the specification or other documents to ensure compliance with the provisions of this Act or of the rules made thereunder, the Controller, before proceeding to dispose of the application in accordance with the provisions hereinafter appearing, shall communicate as expeditiously as possible the gist of the objections to the applicant and shall, if so required by the applicant within the prescribed period, give him an opportunity of being heard.]

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1. Substituted for existing sections 14 and 15 by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 15. Power of Controller to refuse or require amended applications, etc., in certain cases

Where the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may refuse the application or may require the application, specification or the other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application and refuse the application on failure to do so.]

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

(1) A person who has made an application for a patent under this Act may, at any time <sup>1</sup>[before the grant of the patent], if he so desires, or with a view to remedy the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one

invention, file a further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first-mentioned application.

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

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

<sup>2</sup>[Explanation: For the purposes of this Act, the further application and the complete specification accompanying it shall be deemed to have been filed on the date on which the first mentioned application had been filed, and the further application shall be proceeded with as a substantive application and be examined when the request for examination is filed within the prescribed period.]

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1. Substituted for "before the acceptance of the complete specification" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Substituted by the Patents (Amdt.) Act. 2005, w.e.f. 1-1-2005.

## Section 17. Power of Controller to make orders respecting dating of application

(1) Subject to the provisions of section 9, at any time after the filing of an application and <sup>1</sup>[before the grant of the patent] under this Act, the Controller may, at the request of the applicant made in the prescribed manner, direct that the application shall be post-dated to such date as may be specified in the request, and proceed with the application accordingly:

PROVIDED that no application shall be post-dated under this sub-section to a date later than six months from the date on which it was actually made or would, but for the provisions of this sub-section, be deemed to have been made..

<sup>2</sup>[(2) Where an application or specification (including drawings) or any other document is required to be amended under section 15, the application or specification or other document shall, if the Controller so directs, be deemed to have been made on the date on which the requirement is complied with or where the application or specification or other document is returned to the applicant on the date on which it is re-filed after complying with the requirement.]

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1. Substituted for "before acceptance of the complete specification" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Substituted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561 (E), dt. 20-5-2003.

## Section 18. Powers of Controller in cases of anticipation

(1) Where it appears to the Controller that the invention so far as claimed in any claim of the complete specification has been anticipated in the manner referred to in clause (a) of subsection

(1) or sub-section (2) of section 13, he may refuse <sup>1</sup>[the application] unless the applicant —

(a) shows to the satisfaction of the Controller that the priority date of the claim of his complete specification is not later than the date on which the relevant document was published; or

(b) amends his complete specification to the satisfaction of the Controller.

(2) If it appears to the Controller that the invention is claimed in a claim of any other complete specification referred to in clause (b) of sub-section (1) of section 13, he may, subject to the provisions hereinafter contained, direct that a reference to that other specification shall be inserted by way of notice to the public in the applicant's complete specification unless within such time as may be prescribed—

(a) the applicant shows to the satisfaction of the Controller that the priority date of his claim is not later than the priority date of the claim of the said other specification; or

(b) the complete specification is amended to the satisfaction of the Controller;

(3) If it appears to the Controller, as a result of an investigation under section 13 or otherwise —

(a) that the invention so far as claimed in any claim of the applicant's complete specification has been claimed in any other complete specification referred to in clause (a) of sub-section (1) of section 13; and

(b) that such other complete specification was published on or after the priority date of the applicant's claim, then, unless it is shown to the satisfaction of the Controller that the priority date of the applicant's claim is not later than the priority date of the claim of that specification, the provisions of sub-section (2) shall apply thereto in the same manner as they apply to a specification published on or after the date of filing of the applicant's complete specification.

<sup>2</sup>[(4) xxx]

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1. Substituted for "to accept the complete specification" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 19. Powers of Controller in case of potential infringement

(1) If, in consequence of the investigation required <sup>1</sup>[under this Act] it appears to the Controller that an invention in respect of which an application for a patent has been made cannot be performed without substantial risk of infringement of a claim of any other patent, he may direct that a reference to that other patent shall be inserted in the applicant's complete specification by way of notice to the public, unless within such time as may be prescribed—

(a) the applicant shows to the satisfaction of the Controller that there are reasonable grounds for contesting the validity of the said claim of the other patent; or

(b) the complete specification is amended to the satisfaction of the Controller.

(2) Where, after a reference to another patent has been inserted in a complete specification in pursuance of a direction under sub-section (1)—

(a) that other patent is revoked or otherwise ceases to be in force; or

(b) the specification of that other patent is amended by the deletion of the relevant claim; or

(c) it is found, in proceedings before the court of the Controller, that the relevant claim of that other patent is invalid or is not infringed by any working of the applicant's invention.

the Controller may, on the application of the applicant, delete the reference to that other patent.

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1. Substituted for "by the foregoing provisions of this Act or of proceedings under section 25" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 20. Powers of Controller to make orders regarding substitution of applicants, etc.

(1) If the Controller is satisfied on a claim made in the prescribed manner at any time before a patent has been granted, that by virtue of any assignment or agreement in writing made by the applicant or one of the applicants for the patent or by operation of law, the claimant would, if the patent were then granted, be entitled thereto or to the interest of the applicant therein, or to an undivided share of the patent or of that interest, the Controller may, subject to the provisions of this section, direct that the application shall proceed in the name of the claimant or in the names of the claimants and the applicant or the other joint applicant or applicants, accordingly as the case may require.

(2) No such direction as aforesaid shall be given by virtue of any assignment or agreement made by one of two or more joint applicants for a patent except with the consent of the other joint applicant or applicants.

(3) No such direction as aforesaid shall be given by virtue of any assignment or agreement for the assignment of the benefit of an invention unless—

(a) the invention is identified therein by reference to the number of the application for the patent; or

(b) there is produced to the Controller an acknowledgment by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made; or

(c) the rights of the claimant in respect of the invention have been finally established by the decision of a court; or

(d) the Controller gives directions for enabling the application to proceed or for regulating the manner in which it should be proceeded with under sub-section (5).

(4) Where one of two or more joint applicants for a patent dies at any time before the patent has been granted, the Controller may, upon a request in that behalf made by the survivor or survivors and with the consent of the legal representative of the deceased, direct that the application shall proceed in the name of the survivor or survivors alone.



(5) If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the Controller; may, upon application made to him in the prescribed manner by any of the parties, and after giving to all parties concerned an opportunity to be heard, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be proceeded with, or for both those purposes, as the case may require.

## Section 21. Time for putting application in order for grant

<sup>1</sup>[Time for putting application in order for grant. (1) An application for a patent shall be deemed to have been abandoned unless, within such period as may be prescribed, the applicant has complied with all the requirements imposed on him by or under this Act, whether in connection with the complete specification or otherwise in relation to the application from the date on which the first statement of objections to the application or complete specification or other documents related thereto is forwarded to the applicant by the Controller.

Explanation : Where the application for a patent or any specification or, in the case of a convention application or an application filed under the Patent Cooperation Treaty designating India any document filed as part of the application has been returned to the applicant by the Controller in the course of the proceedings, the applicant shall not be deemed to have complied with such requirements unless and until he has refiled it or the applicant proves to the satisfaction of the Controller that for the reasons beyond his control such document could not be re-filed.

(2) If at the expiration of the period as prescribed under sub-section (1),—

(a) an appeal to the High Court is pending in respect of the application for the patent for the main invention; or

(b) in the case of an application for a patent of addition, an appeal to the High Court is pending in respect of either that application or the application for the main invention, the time within which the requirements of the Controller shall be complied with shall, on an application made by the applicant before the expiration of the period as prescribed under sub-section (1), be extended until such date as the High Court may determine.

(3) If the time within which the appeal mentioned in sub-section (2) may be instituted has not expired, the Controller may extend the period as prescribed under sub-section (1), to such further period as he may determine:

PROVIDED that if an appeal has been filed during the said further period, and the High Court has granted any extension of time for complying with the requirements of the Controller, then the requirements may be complied with within the time granted by the Court.]

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1. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 22. OMITTED

<sup>1</sup>[xxx]

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1. Sections 22 to 24 omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 23. OMITTED

<sup>1</sup>[xxx]

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1. Sections 22 to 24 omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 24. OMITTED

<sup>1</sup>[xxx]

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1. Sections 22 to 24 omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

# Chapter V – [Opposition Proceedings to Grant of Patents]

## Section 25. Opposition to the patent

<sup>1</sup>[x x x]

<sup>2</sup>[OPPOSITION PROCEEDINGS TO GRANT OF PATENTS]

<sup>3</sup>[Opposition to the patent. (1) Where an application for a patent has been published but a patent has not been granted, any person may, in writing, represent by way of opposition to the Controller against the grant of patent on the ground—

(a) that the applicant for the patent or the person under or through whom he' claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim—

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January 1912; or

(ii) in India or elsewhere, in any other document:

PROVIDED that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 29;

(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant's claim;

(d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

Explanation : For the purposes of this clause, an invention relating to a process for which a patent is claimed shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before }., that date except where such importation has been for the purpose of reasonable trial or experiment only;

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what : was used in India before the priority date of the applicant's claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act; .

(g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(h) that the 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.

(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 the claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim—

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document:

PROVIDED that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of subsection (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 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.

(3)(a) Where any such notice of opposition is duly given under sub-section (2), the Controller shall notify the patentee.

(b) On receipt of such notice of opposition, the Controller shall, by order in writing, constitute a Board to be known as the Opposition Board consisting of such officers as he may determine and refer such notice of opposition along with the documents to that Board for examination and submission of its recommendations to the Controller.

(c) Every Opposition Board constituted under clause (b) shall conduct the : examination in accordance with such procedure as may be prescribed.

(4) On receipt of the recommendation of the Opposition Board and after giving the patentee and the opponent an opportunity of being heard, the Controller shall order either to maintain or to amend or to revoke the patent.

(5) While passing an order under sub-section (4) in respect of the ground mentioned in clause (d) or clause (e) of sub-section (2), the Controller shall not take into account any personal document or secret trial or secret use.

(6) In case the Controller issues an order under sub-section (4) that the patent shall be maintained subject to amendment of the specification or any other document, the patent shall stand amended accordingly.

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1. Chapter IVA containing sections 24A to 24F omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
2. Substituted for "OPPOSITION TO GRANT OF PATENT" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
3. Existing sections 25 and 26 substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 26. In cases of "obtaining" Controller may treat the patent as the patent of opponent

(1) Where in any opposition proceeding under this Act the Controller finds that—

(a) the invention, so far as claimed in any claim of the complete specification, was obtained from the opponent in the manner set out in clause (a) of sub-section (2) of section 25 and revokes the patent on that ground, he may, on request by such opponent made in the prescribed manner, direct that the patent shall stand amended in the name of the opponent;

(b) a part of an invention described in the complete specification was so obtained from the opponent, he may pass an order requiring that the specification be amended by the exclusion of that part of the invention.

(2) Where an opponent has, before the date of the order of the Controller requiring the amendment of a complete specification referred to in clause (b) of sub-section (1), filed an application for a patent for an invention which included the whole or a part of the invention held to have been obtained from him and such application is pending, the Controller may treat such application and specification insofar as they relate to the invention held to have been obtained from him, as having been filed, for the purposes of this Act relating to the priority dates of claims of the complete specification, on the date on which the corresponding document was or was deemed to have been filed by the patentee in the earlier application but for all other purposes the application of the opponent shall be proceeded with as an application for a patent under this Act.]

## Section 27. [xxx]

<sup>1</sup>[x x x]

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1. Omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 28. Mention of inventor as such in patent

(1) If the controller is satisfied, upon a request or claim made in accordance with the provisions of this section—

(a) that the person in respect of or by whom the request or claim is made is the' inventor of an invention in respect of which application for a patent has been made, or of a substantial part of that invention; and

(b) that the application for the patent is a direct consequence of his being the inventor, the Controller shall, subject to the provisions of this section, cause him to be mentioned as inventor in any patent granted in pursuance of the application in the complete specification and in the register of patents:

PROVIDED that the mention of any person as inventor under this section shall not confer or derogate from any rights under the patent.

(2) A request that any person shall be mentioned as aforesaid may be made in the prescribed manner by the applicant for the patent or (where the person alleged to be the inventor is not the applicant or one of the applicants) by the applicant and that person.

(3) If any person [other than a person in respect of whom a request in relation to the application in question has been made under sub-section (2),] desires to be mentioned as aforesaid, he may make a claim in the prescribed manner in that behalf.

<sup>2</sup>[(4) A request or claim under the foregoing provisions of this section shall be made before the grant of patent.]

<sup>1</sup>[(5) xxx]

(6) <sup>3</sup>[Where] a claim is made under sub-section (3), the Controller shall give notice of the claim to every applicant for the patent (not being the claimant) and to any other person whom the Controller may consider to be interested; and before deciding upon any request or claim made under sub-section (2) or sub-section (3), the Controller shall, if required, hear the person in respect of or by whom the request or claim is made, and, in the case of a claim under sub-section (3), any person to whom notice of the claim has been given as aforesaid.

(7) Where any person has been mentioned as inventor in pursuance of this section, any other person who alleges that he ought not to have been so mentioned may at any time apply to the Controller for a certificate to that effect, and the Controller may, after hearing, if required, any person whom he may consider to be interested, issue such a certificate, and if he does so, he shall rectify the specification and the register accordingly.

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1. Omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

3. Substituted for "Subject to the provisions of sub-section (5), where" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Chapter VI – Anticipation

### Section 29. Anticipation by previous publication

(1) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published in a specification filed in pursuance of an application for a patent made in India and dated before the 1st day of January, 1912.

(2) Subject as hereinafter provided, an invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published before the priority date of the relevant claim of the specification, if the patentee or the applicant for the patent proves—

(a) that the matter published was obtained from him, or (where he is not himself the true and first inventor) from any person from whom he derives title and was published without his consent or the consent of any such person; and

(b) where the patentee or the applicant for the patent or any person from whom he derives title learned of the publication before the date of the application for the patent, or in the case of a convention application, before the date of the application for protection in a convention country, that the application or the application in the convention country, as the case may be, was made as soon, as reasonably practicable thereafter:

PROVIDED that this sub-section shall not apply if the invention was before the priority date of the claim commercially worked in India, otherwise than for the purpose of reasonable trial, either by the patentee or the applicant for the patent or any person from whom he derives title or by any other person with the consent of the patentee or the applicant for the patent or any person from whom he derives title.

(3) Where a complete specification is filed in pursuance of an application for a patent made by a person being the true and first inventor or deriving title from him, an invention claimed in that specification shall not be deemed to have been anticipated by reason only of any other application for a patent in respect of the same invention made in contravention of the rights of that person, or by reason only that after the date of filing of that other application the invention was used or published, without the consent of that person, by the applicant in respect of that other application, or by any other person in consequence of any disclosure of any invention by that applicant.

## Section 30. Anticipation by previous communication to government

An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of the communication of the invention to the government or to any person authorised 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.

## Section 31. Anticipation by public display, etc.

An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of—

(a) the display of the invention with the consent of the true and first inventor or a person deriving title from him at an industrial or other exhibition to which the provisions of this section have been extended by the Central Government by notification, in the Official Gazette, or the use thereof with his consent for the purpose of such an exhibition in the place where it is held; or

(b) the publication of any description of the invention in consequence of the display or use of the invention at any such exhibition as aforesaid; or

(c) the use of the invention, after it has been displayed or used at any such exhibition as aforesaid and during the period of the exhibition, by any person without the consent of the true

and first inventor or a person deriving title from him; or

(d) the description of the invention in a paper read by the true and first inventor before a learned society or published with his consent in the transactions of such a society, if the application for the patent is made by the true and first inventor or a person deriving title from him <sup>1</sup>[not later than twelve months] after the opening of the exhibition or the reading or publication of the paper, as the case may be.

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1. Substituted for "not later than six months" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 32. Anticipation by public working

An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that at any time within one year before the priority date of the relevant claim of the specification, the invention was publicly worked in India—

(a) by the patentee or applicant for the patent or any person from whom he derives title; or

(b) by any other person with the consent of the patentee or applicant for the patent or any person from whom he derives title, if the working was effected for the purpose of reasonable trial only and if it was reasonably necessary, having regard to the nature of the invention, that the working for that purpose should be effected in public.

## Section 33. Anticipation by use and publication after provisional specification

(1) Where a complete specification is filed or proceeded with in pursuance of an application which was accompanied by a provisional specification or where a complete specification filed along with an application is treated by virtue of a direction under sub-section (3) of section 9 as a provisional specification, then, notwithstanding anything contained in this Act, the Controller shall not refuse to grant the patent, and the patent shall not be revoked or invalidated, by reason only that any matter described in the provisional specification or in the specification treated as aforesaid as a provisional specification was used in India or published in India or elsewhere at any time after the date of the filing of that specification.

(2) Where a complete specification is filed in pursuance of a convention application, then, notwithstanding anything contained in this Act, the Controller shall not refuse to grant the patent, and the patent shall not be revoked or invalidated, by reason only that any matter disclosed in any application for protection in a convention country upon which the convention application is founded was used in India or published in India or elsewhere at any time after the date of that application for protection.

## Section 34. No anticipation if circumstances are only as described in sections 29, 30, 31 and 32

Notwithstanding anything contained in this Act, the Controller shall not refuse <sup>1</sup>[x x x] to grant a patent, and a patent shall not be revoked or invalidated by reason only of any circumstances which, by virtue of section 29 or section 30 or section 31 or section 32 do not constitute an anticipation of the invention claimed in the specification.

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1. Words "to accept complete specification for a patent or" omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Chapter VII – Provisions for Secrecy of Certain Inventions

### Section 35. Secrecy directions relating to inventions relevant for defence purposes

(1) Where, in respect of an application made before or after the commencement of this Act for a patent, it appears to the Controller that the invention is one of a class notified to him by the Central Government as relevant for defence purposes, or, where otherwise the invention appears to him to be so relevant, he may give directions for prohibiting or restricting the publication of information with respect to the invention or the communication of such information <sup>1</sup>[xxx].

(2) Where the Controller gives any such directions as are referred to in sub-section (1), he shall give notice of the application and of the directions to the Central Government, and the Central Government shall, upon receipt of such notice, consider whether the publication of the invention would be prejudicial to the defence of India, and if upon such consideration, it appears to it that the publication of the invention would not so prejudice, give notice to the Controller to that effect, who shall thereupon revoke the directions and notify the applicant accordingly.

(3) Without prejudice to the provisions contained in sub-section (1), where the Central Government is of opinion that an invention in respect of which the Controller has not given any directions under sub-section (1), is relevant for defence purposes, it may at any time before <sup>2</sup>[grant of patent] notify the Controller to that effect, and thereupon the provisions of that subsection shall apply as if the invention were one of the class notified by the Central Government of the directions issued by him.

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1. Words "to any person or class of persons specified in the directions" omitted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561 (E), dt. 20-5-2003.

2. Substituted for "acceptance of the complete specification" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

### Section 36. Secrecy directions to be periodically reviewed

<sup>1</sup>[(1) The question whether an invention in respect of which directions have been given under section 35 continues to be relevant for defence purposes shall be re-considered by the Central Government at intervals of <sup>2</sup>[six] months or on a request made by the applicant which is found to be reasonable by the Controller, and if, on such re-consideration, it appears to the Central Government that the publication of the invention would no longer be prejudicial to the defence of India or in case of an application filed by a foreign applicant it is found that the invention is published outside India it shall forthwith give notice to the Controller to revoke the direction and the Controller shall thereupon revoke the directions previously given by him.]

(2) The result of every re-consideration under sub-section (1), shall be communicated to the applicant within such time and in such manner as may be prescribed.

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1. Substituted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561 (E), dt. 20-5-2003.
2. Substituted for "twelve" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 37. Consequences of secrecy directions

(1) So long as any directions under section 35 are in force in respect of an application—

(a) the Controller shall not pass an order refusing <sup>1</sup>[to grant] the same; and

(b) notwithstanding anything contained in this Act, no appeal shall lie from any order of the Controller passed in respect thereof:

<sup>2</sup>[PROVIDED that the application may, subject to the directions, proceed upto the stage of grant of the patent, but the application and the specification found to be in order for grant of the patent shall not be published, and no patent shall be granted in pursuance of that application.]

(2) Where a complete specification filed in pursuance of an application for a patent for an invention in respect of which directions have been given under section 35 <sup>3</sup>[is found to be in order for grant of the patent] during the continuance in force of the directions, then—

(a) if, during the continuance in force of the directions; any use of the invention is made by or on behalf of, or to the order of the government, the provisions of sections 100,101 and 103 shall apply in relation to that use as if the patent had been granted for the invention; and

(b) if it appears to the Central Government that the applicant for the patent has suffered hardship by reason of the continuance in force of the directions the Central Government may make to him such payment (if any) by way of solatium as appears to the Central Government to be reasonable having regard to the novelty and utility of the invention and the purpose for which it is designed, and to any other relevant circumstances.

(3) Where a patent is granted in pursuance of an application in respect of which directions have been given under section 35, no renewal fee shall be payable in respect of any period during which those directions were in force.

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1. Substituted for "to accept" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
2. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
3. Substituted for "is accepted" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 38. Revocation of secrecy directions and extension of time

When any direction given under section 35 is revoked by the Controller, then, notwithstanding any provisions 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 to be done by or under this Act in connection with the application, whether or not that time has previously expired.

## Section 39. Residents not to apply for patents outside India without prior permission

<sup>1</sup>[Residents not to apply for patents outside India without prior permission. (1) No person resident in India shall, except under the authority of a written permit sought in the manner prescribed and granted by or on behalf of the Controller, make or cause to be made any application outside India for the grant of a patent for an invention unless—

(a) an application for a patent for the same invention has been made in India, not less than six weeks before the application outside India; and

(b) either no direction has been given under sub-section (1) of section 35 in relation to the application in India, or all such directions have been revoked.

(2) The Controller shall dispose of every such application within such period as may be prescribed:

PROVIDED that if the invention is relevant for defence purpose or atomic energy, the Controller shall not grant permit without the prior consent of the Central Government.

(3) This section shall not apply in relation to an invention for which an application for protection has first been filed in a country outside India by a person resident outside India.]

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1. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 40. Liability for contravention of section 35 or section 39

Without prejudice to the provisions contained in Chapter XX, if in respect of an application for a patent any person contravenes any direction as to secrecy given by the Controller under section 35, or makes or causes to be made an application for grant of a patent outside India in contravention of section 39 the application for patent under this Act shall be deemed to have been abandoned and the patent granted, if any, shall be liable to be revoked under section 64.

## Section 41. Finality of orders of Controller and Central Government

All orders of the Controller giving directions as to secrecy as well as all orders of the Central Government under this Chapter shall be final and shall not be called in question in any court on any ground whatsoever.

## Section 42. Saving respecting disclosure to government

Nothing in this Act shall be held to prevent the disclosure by the Controller of information concerning an application for a patent or a specification filed in pursuance thereof to the Central Government for the purpose of the application or specification being examined for considering whether an order under this Chapter should be made or whether an order so made should be revoked.

## Chapter VIII – [Grant of Patents and Rights Conferred Thereby]

### Section 43. Grant of patents

<sup>1</sup>[GRANT OF PATENTS AND RIGHTS CONFERRED THEREBY]

<sup>2</sup>[Grant of patents. (1) Where an application for a patent has been found to be in order for grant of the patent and either—

(a) the application has not been refused by the Controller by virtue of any power vested in him by this Act; or

(b) the application has not been found to be in contravention of any of the provisions of this Act, the patent shall be granted as expeditiously as possible to the applicant or, in the case of a joint application, to the applicants jointly, with the seal of the patent office and the date on which the patent is granted shall be entered in the register.

(2) On the grant of patent, the Controller shall publish the fact that the patent has been granted and thereupon the application, specification and other documents related thereto shall be open for public inspection.]

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1. Substituted for "GRANT AND SEALING OF PATENTS AND RIGHTS CONFERRED THEREBY" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

### Section 44. Amendment of patent granted to deceased applicant

Where, at any time after a patent has been <sup>1</sup>[granted] in pursuance of an application under this Act, the Controller is satisfied that the person to whom the patent was granted had died, or, in the case of a body corporate, had ceased to exist, before the patent was <sup>1</sup>[granted], the Controller may amend the patent by substituting for the name of that person the name of the person to whom the patent ought to have been granted, and the patent shall be deemed always to have had effect, accordingly.

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1. Substituted for "sealed" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

### Section 45. Date of patent

<sup>1</sup>[(1) Subject to the other provisions contained in this Act, every patent shall be dated as of the date on which the application for patent was filed.]

(2) The date of every patent be entered in the register.

(3) Notwithstanding anything contained in this section, no suit or other proceeding shall be commenced or prosecuted in respect of an infringement committed before <sup>2</sup>[the date of

publication of the application].

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1. Substituted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.
2. Substituted for "the date of advertisement of the acceptance of the complete specification" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 46. Form, extent and effect of patent

- (1) Every patent shall be in the prescribed form and shall have effect throughout India.
- (2) A patent shall be granted for one invention only:

PROVIDED that it shall not be competent for any person in a suit or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

## Section 47. Grant of patents to be subject to certain conditions

The grant of a patent under this Act shall be subject to the condition that—

- (1) any machine, apparatus or other article in respect of which the patent is granted or any article made by using a process in respect of which the patent is granted, may be imported or made by or on behalf of the government for the purpose merely of its own use;
- (2) any process in respect of which the patent is granted may be used by or on behalf of the government for the purpose merely of its own use;
- (3) any machine, apparatus or other article in respect of which the patent is granted or any article made by the use of the process in respect of which the patent is granted, may be made or used, and any process in respect of which the patent is granted may be used, by any person, for the purpose merely of experiment or research including the imparting of instructions to pupils; and
- (4) in the case of a patent in respect of any medicine or drug, the medicine or drug may be imported by the government for the purpose merely of its own use or for distribution in any dispensary, hospital or other medical institution maintained by or on behalf of the government or any other dispensary, hospital or medical institution which the Central Government may, having regard to the public service that such dispensary, hospital or medical institution renders, specify in this behalf by notification in the Official Gazette.

## Section 48. Rights of patentees

<sup>1</sup>[Rights of patentees. Subject to the other provisions contained in this Act and the conditions specified in section 47, a patent granted under this Act shall confer upon the patentee—

- (a) where the subject matter of the patent is a product, the exclusive right to prevent third parties, who do not have his consent, from the act of making, using, offering for sale, selling or importing for those purposes that product in India:

(b) where the subject matter of the patent is a process the exclusive right to prevent third parties, who do not have his consent, from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India:

<sup>2</sup>[x x x]

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1. Substituted by the Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide SO 561(E), dt. 20-5-2003.

2. Proviso omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 49. Patent rights not infringed when used on foreign vessels, etc. temporarily or accidentally in India

Patent rights not infringed when used on foreign vessels, etc. temporarily or accidentally in India. (1) Where a vessel or aircraft registered in a foreign country or a land vehicle owned by a person ordinarily resident in such country comes into India (including the territorial waters thereof) temporarily or accidentally only, the rights conferred by a patent for an invention shall not be deemed to be infringed by the use of the invention—

(a) in the body of the vessel or in the machinery, tackle, apparatus or other – accessories thereof, so far as the invention is used on board the vessel and for its actual needs only; or

(b) in the construction or working of the aircraft or land vehicle or of the accessories thereof, as the case may be.

(2) This section shall not extend to vessels, aircraft or land vehicles owned by persons ordinarily resident in a foreign country the law of which do not confer corresponding rights with respect to the use of inventions in vessels, aircraft or land vehicles owned by persons ordinarily resident in India while in the ports or within the territorial waters of that foreign country or otherwise within the jurisdiction of its courts.

## Section 50. Rights of co-owners of patents

(1) Where a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent.

(2) Subject to the provisions contained in this section and in section 51, where two or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to <sup>1</sup>[the rights conferred by section 48] for his own benefit without accounting to the other person or persons.

(3) Subject to the provisions contained in this section and in section 51 and to any agreement for the time being in force, where two or more persons are registered as grantee or proprietor of a patent, then, a licence under the patent shall not be granted and a share in the patent shall not be assigned by one of such persons except with the consent of the other person or persons.

(4) Where a patented article is sold by one of two or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming through him shall be entitled to deal with the article in the same manner as if the article had been sold by a sole patentee.

(5) Subject to the provisions contained in this section, the rules of law applicable to the ownership and devolution of movable property generally shall apply in relation to patents, and nothing contained in sub-section (1) or sub-section (2) shall affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or their rights or obligations as such.

(6) Nothing in this section shall affect the rights of the assignees of a partial interest in a patent created before the commencement of this Act.

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1. Substituted for "make, use, exercise and sell the patented invention" by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O.561(E), dt. 20-5-2003.

## Section 51. Power of Controller to give directions to co-owners

(1) Where two or more persons are registered as grantee or proprietor of a patent, the Controller may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licence under the patent, or the exercise of any right under section 50 in relation thereto, as he thinks fit.

(2) If any person registered as grantee or proprietor of a patent fails to execute any instrument or to do any other thing required for the carrying out of any direction given under this section within fourteen days after being requested in writing so to do by any of the other persons so registered, the Controller may upon application made to him in the prescribed manner by any such other person give directions empowering any person to execute that instrument or to do that in the name and on behalf of the person in default.

(3) Before giving any directions in pursuance of an application under this section, the Controller shall give an opportunity to be heard—

(a) in the case of an application under sub-section (1), to the other person or persons registered as grantee or proprietor of the patent;

(b) in the case of an application under sub-section (2), to the person in default.

(4) No direction shall be given under this section so as to affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or of their rights or obligations as such, or which is inconsistent with the terms of any agreement between persons registered as grantee or proprietor of the patent.

## Section 52. Grant of patent to true and first inventor where it has been obtained by another in fraud of him

(1) <sup>1</sup>[Where the patent has been revoked under section 64] on the ground that the patent was obtained wrongfully and in contravention of the rights of the petitioner or any person under or through whom he claims, or, where in a petition for revocation, the <sup>2</sup>[Appellate Board or court], instead of revoking the patent, directs the complete specification to be amended by the exclusion of a claim or claims in consequence of a finding that the invention covered by such claim or claims had been obtained from the petitioner, the <sup>2</sup>[Appellate Board or court] may, by order passed in the same proceeding, permit the grant to the petitioner of the whole or such

part of the invention which the court finds has been wrongfully obtained by the patentee, in lieu of the patent so revoked or is excluded by amendment.

(2) Where any such order is passed, the Controller shall, on request by the petitioner made in the prescribed manner grant to him—

(i) in cases where the <sup>3</sup>[Appellate Board or court] permits the whole of the patent to be granted, a new patent bearing the same date and number as the patent revoked;

(ii) in cases where the <sup>3</sup>[Appellate Board or court] permits a part only of the patent to be granted, a new patent for such part bearing the same date as the patent revoked and numbered in such manner as may be prescribed:

PROVIDED that the Controller may, as a condition of such grant, require the petitioner to file a new and complete specification to the satisfaction of the Controller describing and claiming that part of the invention for which the patent is to be granted.

(3) No suit shall be brought for any infringement of a patent granted under this section committed before the actual date on which such patent was granted.

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1. Substituted for "Where a patent has been revoked" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Substituted for "court" by the Patents (Amdt.) Act, 2005, effective date to be notified.

3. Substituted for "court" by the Patents (Amdt.) Act, 2005, effective date to be notified.

## Section 53. Term of patent

<sup>1</sup>[(1) Subject to the provisions of this Act, the term of every patent granted, after the commencement of the Patents (Amendment) Act, 2002, and the term of every patent which has not expired and has not ceased to have effect, on the date of such commencement, under this Act, shall be twenty years from the date of filing of the application for the patent.]

<sup>2</sup>[Explanation : For the purposes of this sub-section, the term of patent in case of International applications filed under the Patent Cooperation Treaty designating India, shall be twenty years from the international filing date accorded under the Patent Cooperation Treaty.]

(2) A patent shall cease to have effect notwithstanding anything therein or in this Act on the expiration of the period prescribed for the payment of any renewal fee, if that fee is not paid within the prescribed period <sup>3</sup>[or within such extended period as may be prescribed].

<sup>4</sup>[(3) xxx]

<sup>5</sup>[(4) Notwithstanding anything contained in any other law for the time being in force, on cessation of the patent right due to non-payment of renewal fee or on the expiry of the term of patent, the subject matter covered by the said patent shall not be entitled to any protection.]

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1. Substituted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

2. Inserted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.



3. Substituted for "or within that period as extended under this section" by the Patents (Amdt) Act, 2005, w.e.f. 1-1-2005.

4. Omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

5. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

## Chapter IX – Patents of Addition

### Section 54. Patents of addition

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

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

(3) A patent shall not be granted as a patent of addition unless the date of filing of the <sup>1</sup>[application] was the same as or later than the date of filing of the <sup>1</sup>[application] in respect of the main invention.

<sup>2</sup>[(4) A patent of addition shall not be granted before grant of the patent for the main invention.]

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1. Substituted for "complete specification" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

### Section 55. Term of patents of addition

(1) A patent of addition shall be granted for a term equal to that of the patent for the main invention, or so much thereof as has not expired, and shall remain in force during that term or until the previous cesser of the patent for the main invention and no longer:

PROVIDED that if the patent for the main invention is revoked under this Act, the court, or, as the case may be, the Controller, on request made to him by the patentee in the prescribed manner, may order that the patent of addition shall become an independent patent for the remainder of the term for the patent for the main invention and thereupon the patent shall continue in force as an independent patent accordingly.

(2) No renewal fees shall be payable in respect of a patent of addition, but if any such patent becomes an independent patent under sub-section (1), the same fees shall thereafter be payable, upon the same dates, as if the patent had been originally granted as an independent patent.

## Section 56. Validity of patents of addition

(1) The grant of a patent of addition shall not be refused, and a patent granted as a patent of addition shall not be revoked or invalidated, on the ground only that the invention claimed in the complete specification does not involve any inventive step having regard to any publication or use of—

(a) the main invention described in the complete specification relating thereto; or .

(b) any improvement in or modification of the main invention described in the complete specification of a patent of addition to the patent for the main invention or of an application for such a patent of addition, and the validity of a patent of addition shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

(2) For the removal of doubts it is hereby declared that in determining the novelty of the invention claimed in the complete specification filed in pursuance of an application for a patent of addition regard shall be had also to the complete specification in which the main invention is described.

## Chapter X – Amendment of Applications and Specifications

### Section 57. Amendment of application and specification before Controller

(1) Subject to the provisions of section 59, the Controller may, upon application made under this section in the prescribed manner by an applicant for a patent or by a patentee, allow the application for the patent or the complete specification <sup>1</sup>[or any document relating thereto] to be amended subject to such conditions, if any, as the Controller thinks fit:

PROVIDED that the Controller shall not pass any order allowing or refusing an application to amend an application for a patent or a specification <sup>1</sup>[or any document relating thereto] under this section while any suit before a court for the infringement of the patent or any proceeding before the High Court for the revocation of the patent is pending, whether the suit or proceeding commenced before or after the filing of the application to amend.

(2) Every application for leave to amend an application for a patent <sup>2</sup>[or a complete specification or any document relating thereto] under this section shall state the nature of the proposed amendment, and shall give full particulars of the reasons for which the application is made.

<sup>3</sup>[(3) Any application for leave to amend an application for a patent or a complete specification or a document related thereto under this section made after the grant of patent and the nature of the proposed amendment may be published.]

(4) Where an application is <sup>4</sup>[published] under sub-section (3), any person interested may, within the prescribed period after the <sup>5</sup>[publication] thereof, give notice to the Controller of opposition thereto; and where such a notice is given within the period aforesaid, the Controller shall notify the person by whom the application under this section is made and shall give to the person and to the opponent an opportunity to be heard before he decides the case.

(5) An amendment under this section of a complete specification may be, or include, an amendment of the priority date of a claim.

<sup>3</sup>[(6) The provisions of this section shall be without prejudice to the right of an applicant for a patent to amend his specification or any other document related thereto to comply with the directions of the Controller issued before the grant of a patent.]

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1. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.
2. Substituted for "or a specification", by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.
3. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
4. Substituted for "advertised" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
5. Substituted for "advertisement" by the Patent (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 58. Amendment of specification before Appellate Board or High Court

<sup>1</sup>[Amendment of specification before Appellate Board or High Court. (1) In any proceeding before the Appellate Board or the High Court for the revocation of a patent, the Appellate Board or the High Court, as the case may be, may, subject to the provisions contained in section 59, allow the patentee to amend his complete specification in such manner and subject to such terms as to costs, advertisement or otherwise, as the Appellate Board or the High Court may think fit, and if, in any proceedings for revocation, the Appellate Board or the High Court decides that the patent is invalid, it may allow the specification to be amended under this section instead of revoking the patent.

(2) Where an application for an order under this section is made to the Appellate Board or the High Court, the applicant shall give notice of the application to the Controller, and the Controller shall be entitled to appear and be heard, and shall appear if so directed by the Appellate Board or the High Court.

(3) Copies of all orders of the Appellate Board or the High Court allowing the patentee to amend the specification shall be transmitted by the Appellate Board or the High Court to the Controller who shall, on receipt thereof, cause an entry thereof and reference thereto to be made in the register.]

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1. Substituted, *ibid*, w.e.f. the date to be notified.

## Section 59. Supplementary provisions as to amendment of application or specification

<sup>1</sup>[(1) No amendment of an application for a patent or a complete specification or any document relating thereto shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of incorporation of actual fact, and no amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or that any claim of the specification as

amended would not fall wholly within the scope of a claim of the specification before the amendment.]

<sup>2</sup>[(2) Where after the date of grant of patent any amendment of the specification or any other documents related thereto is allowed by the Controller or by the Appellate Board or the High Court, as the case may be,—

(a) the amendment shall for all purposes be deemed to form part of the specification along with other documents related thereto;

(b) the fact that the specification or any other documents related thereto has been amended shall be published as expeditiously as possible; and

(c) the right of the applicant or patentee to make amendment shall not be called in question except on the ground of fraud.]

(3) In construing the specification as amended, reference may be made to the specification as originally accepted.

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1. Substituted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

2. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. the date to be notified.

## Chapter XI – Restoration of Lapsed Patents

### Section 60. Applications for restoration of lapsed patents

(1) Where a patent has ceased to have effect by reason of failure to pay any renewal fee within the <sup>1</sup>[period prescribed under section 53 or within such period as may be allowed under sub-section (4) of section 142], the patentee or his legal representative, and where the patent was held by two or more persons jointly, then, with the leave of the Controller, one or more of them without joining the others, may, within <sup>2</sup>[eighteen months] from the date on which the patent ceased to have effect, make an application for the restoration of the patent.

[Omitted by Patents (Arndt.) Act, 2002, w.e.f. 20-5-2003 vide S.O.561(E), dt. 20-5-2003]

(3) An application under this section shall contain a statement, verified in the prescribed manner, fully setting out the circumstances which led to the failure to pay the prescribed fee, and the Controller may require from the applicant such further evidence as he may think necessary.

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1. Substituted for “prescribed period or within that period as extended under sub-section (3) of section53” by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Substituted for “one year” by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

### Section 61. Procedure for disposal of applications for restoration of lapsed patents

(1) If, after hearing the applicant in cases where the applicant so desires or the Controller thinks fit, the Controller is prima facie satisfied that the failure to pay the renewal fee was unintentional and that there has been no undue delay in the making of the application, he shall <sup>1</sup>[ublish] the application in the prescribed manner; and within the prescribed period any person interested may give notice to the Controller of opposition thereto on either or both of the following grounds, that is to say—

(a) that the failure to pay the renewal fee was not unintentional; or ;

(b) that there has been undue delay in the making of the application.

(2) If notice of opposition is given within the period aforesaid, the Controller shall notify the applicant and shall give to him and to the opponent an opportunity to be heard before he decides the case.

(3) If no notice of opposition is given within the period aforesaid or if in the case of opposition, the decision of the Controller is in favour of the applicant, the Controller shall, upon payment of any unpaid renewal fee and such additional fee as may be prescribed, restore the patent and any patent of addition specified in the application which has ceased to have effect on the cesser, of that patent.

(4) The Controller may, if he thinks fit, as a condition of restoring the patent, require that an entry shall be made in the register of any document or matter which, under the provisions of this Act, has to be entered in the register but which has not been so entered.

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1. Substituted for "advertise" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 62. Rights of patentees of lapsed patents which have been restored

(1) Where a patent is restored, the rights of the patentee shall be subject to such provisions as may be prescribed and to such other provisions as the Controller thinks fit to impose for the protection or compensation of persons who may have begun to avail themselves of, or have taken definite steps by contract or otherwise to avail themselves of, the patented invention between the date when the patent ceased to have effect and the date of the <sup>1</sup>[publication] of the application for restoration of the patent under this chapter.

(2) No suit or other proceeding shall be commenced or prosecuted in respect of an infringement of a patent committed between the date on which the patent ceased to have effect and the date of <sup>1</sup>[publication] of the application for restoration of the patent.

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1. Substituted for "advertisement" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Chapter XII – Surrender and Revocation of Patents

### Section 63. Surrender of patents

(1) A patentee may, at any time by giving notice in the prescribed manner to the Controller, offer to surrender his patent.

(2) Where such an offer is made, the Controller shall <sup>1</sup>[publish] the offer in the prescribed manner, and also notify every person other than the patentee whose name appears in the register as having an interest in the patent.

(3) Any person interested may, within the prescribed period after such <sup>2</sup>[publi-cation], give notice to the Controller of opposition to the surrender, and where any such notice is given the Controller shall notify the patentee.

(4) If the Controller is satisfied after hearing the patentee and any opponent, if desirous of being heard, that the patent may properly be surrendered, he may accept the offer and, by order, revoke the patent.

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1. Substituted for "advertise" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Substituted for "advertisement" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 64. Revocation of patents

(1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act, may, <sup>1</sup>[be revoked on a petition of any person interested or of the Central Government by the Appellate Board or on a counterclaim 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 pa tent was granted on the application of a person not entitled under the provisions of this Act to apply therefor: <sup>2</sup>[xxxx]

(c) that the patent was obtained wrongfully in contravention of the 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 : <sup>2</sup>[xxxx]

(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; <sup>2</sup>[xxx]

(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<sup>3</sup>[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.

<sup>3</sup>[(p) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;

(q) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.]'

(2) For the purposes of clauses (e) and (f) of sub-section (1),—

(a) no account shall be taken of <sup>4</sup>[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 (1) 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 authorized as aforesaid or to the government undertakings; 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 interest therein and it shall not be necessary to serve a notice on any other person.

#### COMMENTS

To be entitled to the grant of an ad interim injunction, the plaintiff has to show existence of a prima facie case, balance of convenience in his favour, and irreparable injury. Sec. 107 of the Act clearly provides that in any suit for injunction, every ground on which it may be revoked shall be available as a ground of defence.—*Franz Zaver Huemer v. New Yesh Engineers* 1996 PTC (16) (Del) 164

To satisfy the requirement of being publicly known as used in clauses (e) and (f) of s. 64(1), it is not necessary that it should be widely used to the knowledge of the consumer public. It is sufficient if it is known to the persons who are engaged in the pursuit of the knowledge of the patented product or process either as men of science or men of commerce or consumers.—*Monsanto Company v. Coramandal Indag Products (P) Ltd.* AIR 1986 SC 712

There is a distinction maintained as between the defence raised to a suit for infringement of a patent (vide s. 107) on the one hand and the revocation sought of a patent on the other (vide s. 64). The grounds may be the same, but still there is no inconsistency on account of the suit being defended as liable to dismissal in a particular case and a case where the defendant seeks also that the patent asserted by the plaintiff be revoked. It is only when there is a counterclaim seeking revocation of the patent that the jurisdiction of the District Court is ousted. The proviso to s. 104 being in the nature of an exception to the general rule, it has to be strictly construed. There is no express claim on the part of the defendant for revocation whereof infringement is alleged by the plaintiff. That the defendant pleads that the patent set up by the plaintiff is invalid amounts only to the defendant raising a ground for the relief sought by the plaintiff being declined; it does not follow necessarily that the defendant also seeks by way of a counterclaim that the patent be revoked. The defendant has not asserted in the pleadings anywhere that they are the patentee or that they are entitled to be registered as such. The grounds raised are cumulatively and also individually by way of defence to the plaintiff's action.— *Fabcon Corporation v. Industrial Engineering Corporation* AIR 1987 All 338

In *Ram Narain Kher v. Ambassador Industries PTC (Suppl.)* (1) 180 (Del), the defendant pleaded that the invention and the advantages claimed by the plaintiff had not been adequately described in the patent and adequately claimed in the claim to bring it within the ambit of the term "invention" within the meaning of the Act. The High Court held that the defendants having specifically raised the ground that claims made by the plaintiff in the patent were vague and did not describe the invention clearly and properly, are competent to claim revocation of the patent on that ground in the terms of section 64(1) of the Act.

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1. Substituted for "on the petition of any person interested or of the Central Government or on a counter-claim in a suit for infringement of the patent, be revoked by the High Court" by the Patents (Amdt.) Act, 2005, w.e.f. the date to be notified.



2. Proviso omitted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O.561(E), dt. 20-5-2003.

3. Inserted by Patents (Amdt) Act, 2002, w.e.f. 20-5-2003 vide S.O.561(E), dt. 20-5-2003.

4. Substituted for "secret use", *ibid*.

## Section 65. Revocation of patent or amendment of complete specification on directions from Government in cases relating to atomic energy

<sup>1</sup>[Revocation of patent or amendment of complete specification on directions from Government in cases relating to atomic energy. (1) Where at any time after grant of a patent, the Central Government is satisfied that a patent is for an invention relating to atomic energy for which no patent can be granted under sub-section (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962), it may direct the Controller to revoke the patent, and thereupon the Controller, after giving notice, to the patentee and every other person whose name has been entered in the register as having an interest in the patent, and after giving them an opportunity of being heard, may revoke the patent.

(2) In any proceedings under sub-section (1), the Controller may allow the patentee to amend the complete specification in such manner as he considers necessary instead of revoking the patent.]

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1. Substituted for existing sub-sec. (4) by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

## Section 66. Revocation of patent in public interest

Where the Central Government is of opinion that a patent or the mode in which it is exercised is mischievous to the State or generally prejudicial to the public, it may, after giving the patentee an opportunity to be heard, make a declaration to that effect in the Official Gazette and thereupon the patent shall be deemed to be revoked.

## Chapter XIII – Register of Patents

### Section 67. Register of patents and particulars to be entered therein

(1) There shall be kept at the patent office a register of patents, wherein shall be entered —

(a) the names and addresses of grantees of patents;

(b) notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, and revocations of patents; and

(c) particulars of such other matters affecting the validity or proprietorship of patents as may be prescribed.

(2) No notice of any trust, whether express, implied or constructive, shall be entered in the register, and the Controller shall not be affected by any such notice.

(3) Subject to the superintendence and direction of the Central Government, the register shall be kept under the control and management of the Controller.

<sup>1</sup>[(4) Notwithstanding anything contained in sub-section (1), it shall be lawful for the Controller to keep the register of patents or any part thereof in computer floppies, diskettes or any other electronic form subject to such safeguards as may be prescribed.]

(5) Notwithstanding anything contained in the Indian Evidence Act, 1872, a copy of, or extracts from, the register of patents, certified to be a true copy under the hand of the Controller or any officer duly authorised by the Controller in this behalf shall, in all legal proceedings, be admissible in evidence.

(6) In the event the register is kept wholly or partly in computer floppies, diskettes or any other electronic form,—

(a) reference in this Act to an entry in the register shall be deemed to include reference to a record of particulars kept in computer floppies, diskettes or c. any other electronic form and comprising the register or part of the register;

(b) references in this Act to particulars being registered or entered in the register shall be deemed to include references to the keeping of record of those particulars comprising the register or part of the register in computer floppies, diskettes or any other electronic form; and

(c) references in this Act to the rectification of the register are to be read as including references to the rectification of the record of particulars kept in computer floppies, diskettes or any other electronic form and comprising the register or part of the register.]

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1. Substituted for existing sub-sec. (4) by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

## **Section 68. Assignments, etc. not to be valid unless in writing and duly executed**

<sup>1</sup>[Assignments, etc. not to be valid unless in writing and duly executed. An assignment of a patent or of a share in a patent, a mortgage, licence or the creation of any other interest in a patent shall not be valid unless the same were in writing and the agreement between the parties concerned is reduced to the form of a document embodying all the terms and conditions governing their rights and obligations and duly executed.]

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1. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## **Section 69. Registration of assignments, transmissions, etc.**

(1) Where any person becomes entitled by assignment, transmission or operation of law to a patent or to a share in a patent or becomes entitled as a mortgagee, licensee or otherwise to any other interest in a patent, he shall apply in writing in the prescribed manner to the

Controller for the registration of his title or, as the case may be of notice of his interest in the register.

(2) Without prejudice to the provisions of sub-section (1), an application for the registration of the title of any person becoming entitled by assignment to a patent or a share in a patent or becoming entitled by virtue of a mortgage, licence or other instrument to any other interest in a patent may be made in the prescribed manner by the assignor, mortgagor, licensor or other party to that instrument, as the case may be.

(3) Where an application is made under this section for the registration of the title of any person, the Controller shall, upon proof of title to his satisfaction,—

(a) where that person is entitled to a patent or a share in a patent, register him in the register as proprietor or co-proprietor of the patent, and enter in the register particulars of the instrument or event by which he derives title; or ,

(b) where that person is entitled to any other interest in the patent, enter in the register notice of his interest, with particulars of the instrument, if any, creating it:

PROVIDED that if there is any dispute between the parties whether the assignment, mortgage, licence, transmission, operation of law or any other such transaction has validly vested in such person a title to the patent or any share or interest therein, the Controller may refuse to take any action under clause (a), or, as the case may be, under clause (b), until the rights of the parties have been determined by a competent court.

(4) There shall be supplied to the Controller in the prescribed manner for being filed in the patent office copies of all agreements, licences and other documents affecting the title to any patent of any licence thereunder authenticated in the prescribed manner and also such other documents as may be prescribed relevant to the subject-matter:

PROVIDED that in the case of a licence granted under a patent, the Controller shall, if so requested by the patentee or licensee, take steps for securing that the terms of the licence are not disclosed to any person except under the order of a court.

(5) Except for the purposes of an application under sub-section (1) or of an application to rectify the register, a document in respect of which no entry has been made in the register under sub-section (3) shall not be admitted by the Controller or by any court as evidence of the title of any person to a patent or to a share or interest therein unless the Controller or the court, for reasons to be recorded in writing, otherwise directs.

## Section 70. Power of registered grantee or proprietor to deal with patent

Subject to the provisions contained in this Act relating to co-ownership of patents and subject also to any rights vested in any other person of which notice is entered in the register, the person or persons registered as grantee or proprietor of patent shall have power to assign, grant licences under, or otherwise deal with the patent and to give effectual receipts for consideration for any such assignment, licence or dealing:

PROVIDED that any equities in respect of the patent may be enforced in like manner as in respect of any other movable property.

## Section 71. Rectification of register by [Appellate Board]

Rectification of register by <sup>1</sup>[Appellate Board]. (1) The <sup>1</sup>[Appellate Board] may, on the application of any person aggrieved—

(a)- by the absence or omission from the register of any entry; or

(b) by any entry made in the register without sufficient cause; or

(c) by any entry wrongly remaining on the register; or

(d) by any error or defect in any entry in the register, make such order for the making, variation or deletion, of any entry therein as it may think fit.

(2) In any proceeding under this section the <sup>1</sup>[Appellate Board] may decide any question that may be necessary or expedient to decide in connection with the rectification of the register.

(3) Notice of any application to the <sup>1</sup>[Appellate Board] under this section shall be given in the prescribed manner to the Controller who shall be entitled to appear and be heard on the application, and shall appear if so directed by the <sup>2</sup>[Board].

(4) Any order of the <sup>1</sup>[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.

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1. Substituted for "High Court" by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

2. Substituted for "Court", ibid.

## Section 72. Register to be open for inspection

(1) Subject to the provisions contained in this Act and any rules made thereunder, the register shall at all convenient times be open to inspection by the public; and certified copies, sealed with the seal of the patent office, of any entry in the register shall be given to any person requiring them on payment of the prescribed fee.

(2) The register shall be prima facie evidence of any matters required or authorised by or under this Act to be entered therein.

<sup>1</sup>[(3) If the record or particulars is kept in computer floppies or diskettes or in any other electronic form, sub-sections (1) and (2) shall be deemed to have been complied with if the public is given access to such computer floppies, diskettes or any other electronic form or printouts of such record of particulars for inspection.]

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1. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

## Chapter XIV – Patent Office and its Establishment

### Section 73. Controller and other officers

(1) The Controller General of Patents, Designs and Trade Marks appointed under subsection (1) of <sup>1</sup>[section 3 of the Trade Marks Act, 1999] shall be the Controller of Patents for the purposes of this Act.

(2) For the purposes of this Act the Central Government may appoint as many examiners and other officers and with such designations as it thinks fit.

(3) Subject to the provisions of this Act, the officers appointed under sub-section (2) shall discharge under the superintendence and directions of the Controller such functions of the Controller under this Act as he may, from time to time, by general or special order in writing, authorise them to discharge.

(4) Without prejudice to the generality of the provisions of sub-section (3), the Controller may, by order in writing and for reasons to be recorded therein withdraw any matter pending before an officer appointed under sub-section (2) and deal with such matter himself either de novo or from the stage it was so withdrawn or transfer the same to another officer appointed under sub-section (2) who may, subject to special directions in the order of transfer, proceed with the matter either de novo or from the stage it was so transferred.

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1. Substituted for "section 4 of the Trade and Merchandise Marks Act, 1958", by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O.561(E), dt. 20-5-2003.

## Section 74. Patent office and its branches

(1) For the purposes of this Act, there shall be an office which shall be known as the patent office.

<sup>1</sup>[(2) The Central Government may, by notification in the Official Gazette, specify the name of the Patent Office.]

(3) The head office of the patent office shall be at such place as the Central Government may specify, and for the purpose of facilitating the registration of patents there may be established, at such other places as the Central Government may think fit, branch offices of the patent office.

(4) There shall be a seal of the patent office.

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1. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 75. Restriction on employees of patent office as to right or interest in patents

All officers and employees of the patent office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by that office.

## Section 76. Officers and employees not to furnish information, etc.

An officer or employee in the patent office shall not, except when required or authorised by this Act or under a direction in writing of the <sup>1</sup>[Central Government or Appellate Board] or the Controller or by order of a court—

- (a) furnish information on a matter which is being, or has been, dealt with under this Act <sup>2</sup>[x x x]; or
- (b) prepare to assist in the preparation of a document required or permitted by or under this Act +[x x x] to be lodged in the patent office; or
- (c) conduct a search in the records of the patent office.

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1. Substituted for "Central Government" by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561 (E), dt. 20-5-2003.
2. Words "or under the Indian Patents and Designs Act, 1911" omitted, *ibid*.

## Chapter XV – Powers of Controller Generally

### Section 77. Controller to have certain powers of a civil court

(1) Subject to any rules made in this behalf, the Controller in any proceedings before him under this Act have the powers of a civil court while trying a suit under the Code of Civil Procedure, 1908 (5 of 1908) in respect of the following matters, namely,—

- (a) summoning and enforcing the attendance of any person and examining him on oath;
- (b) requiring the discovery and production of any document;
- (c) receiving evidence on affidavits;
- (d) issuing commissions for the examination of witnesses of documents;
- (e) awarding costs;
- (f) reviewing his own decision on application made within the prescribed time and in the prescribed manner;
- (g) setting aside an order passed *ex parte* on application made within the prescribed time and in the prescribed manner;
- (h) any other matter which may be prescribed.

(2) Any order for costs awarded by the Controller in exercise of the powers conferred upon him under sub-section (1) shall be executable as a decree of a civil court.

### Section 78. Power of Controller to correct clerical errors, etc.

(1) Without prejudice to the provisions contained in sections 57 and 59 as regards amendment of applications for patents or complete specifications <sup>1</sup>[or other documents relating thereto] and subject to the provisions of section 44, the Controller may, in accordance with the provisions of

this section, correct any clerical error in any patent or in any specification or other document filed in pursuance of such application or in any application for a patent or any clerical error in any matter which is entered in the register.

(2) A correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.

(3) Where the Controller proposes to make any such correction as aforesaid otherwise than in pursuance of a request made under this section, he shall give notice of the proposal to the patentee or the applicant for the patent, as the case may be, and to any other person who appears to him to be concerned, and shall give them an opportunity to be heard before making the correction.

(4) Where a request is made under this section for the correction of any error in a patent or application for a patent or any document filed in pursuance of such an application, and it appears to the Controller that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons affected thereby, he shall require notice of the nature of the proposed correction to be <sup>2</sup>[published] in the prescribed manner.

(5) Within the prescribed time after any such <sup>3</sup>[publication] as aforesaid any person interested may give notice to the Controller of opposition to the request, and, where such notice of opposition is given, the Controller shall give notice thereof to the person by whom the request was made, and shall give to him and to the opponent an opportunity to be heard before he decides the case.

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1. Inserted, *ibid*.

2. Substituted for "advertised" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

3. Substituted for "advertisement" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 79. Evidence how to be given and powers of Controller in respect thereof

Subject to any rules made in this behalf, in any proceeding under this Act before the Controller, evidence shall be given by affidavit in the absence of directions by the Controller to the contrary, but in any case in which the Controller thinks it right so to do, he may take oral evidence in lieu of, or in addition to, evidence by affidavit, or may allow any party to be cross-examined on the contents of his affidavit.

## Section 80. Exercise of discretionary powers by Controller

Without prejudice to any provision contained in this Act requiring the Controller to hear any party to the proceedings thereunder or to give any such party an opportunity to be heard, the Controller shall give to any applicant for a patent, or for amendment of a specification (if within the prescribed time the applicant so requires) an opportunity to be heard before exercising adversely to the applicant any discretion vested in the Controller by or under this Act:

<sup>1</sup>[PROVIDED that the party desiring a hearing makes the request for such hearing to the Controller at least ten days in advance of the expiry of the time-limit specified in respect of the proceeding.]

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1. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O.561 (E), dt. 20-5-2003.

## Section 81. Disposal by Controller of applications for extension of time

Where under the provisions of this Act or the rules made thereunder the Controller may extend the time for doing any act, nothing in this Act shall be deemed to require him to give notice to or hear the party interested in opposing the extension, nor shall any appeal lie from any order of the Controller granting such extension.

## Chapter XVI – Working of Patents, Compulsory Licences and Revocation

### Section 82. Definitions of “patented articles” and “patentee”

<sup>1</sup>[CHAPTER XVI

WORKING OF PATENTS, COMPULSORY LICENCES AND REVOCATION

In this Chapter, unless the context otherwise requires,—

- (a) “patented article” includes any article made by a patented process; and
- (b) “patentee” includes an exclusive licensee.

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1. As amended by Section 39 of “The Patents (Amendment) Act, 2002”. (No. 38 of 2002).

### Section 83. General principles applicable to working of patented inventions

Without prejudice to the other provisions contained in this Act, in exercising the powers conferred by this Chapter, regard shall be had to the following general considerations, namely,—

- (a) that patents are granted to encourage inventions and to secure that the inventions are worked in India on a commercial scale and to the fullest extent that is reasonably practicable without undue delay;
- (b) that they are not granted merely to enable patentees to enjoy a monopoly for the importation of the patented article;
- (c) that the protection and enforcement of patent rights contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations;
- (d) that patents granted do not impede protection of public health and nutrition and should act as instrument to promote public interest specially in sectors of vital importance for socio-



economic and technological development of India;

(e) that patents granted do not in any way prohibit Central Government in taking measures to protect public health;

(f) that the patent right is not abused by the patentee or person deriving title or interest on patent from the patentee, and the patentee or a person deriving title or interest on patent from the patentee does not resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology; and

(g) that patents are granted to make the benefit of the patented invention available at reasonably affordable prices to the public.

## Section 84. Compulsory licences

(1) At any time after the expiration of three years from the date of the <sup>1</sup>[grant] of a patent, any person interested may make an application to the Controller for grant of compulsory licence on patent on any of the following grounds, namely:—

(a) that the reasonable requirements of the public with respect to the patented invention have not been satisfied, or

(b) that the patented invention is not available to the public at a reasonably affordable price, or

(c) that the patented invention is not worked in the territory of India.

(2) An application under this section may be made by any person notwithstanding that he is already the holder of a licence under the patent and no person shall be estopped from alleging that the reasonable requirements of the public with respect to the patented invention are not satisfied or that the patented invention is not worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price by reason of any admission made by him, whether in such a licence or otherwise or by reason of his having accepted such a licence.

(3) Every application under sub-section (1) shall contain a statement setting out the nature of the applicant's interest together with such particulars as may be prescribed and the facts upon which the application is based.

(4) The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied or that the patented invention is not worked in the territory of India or that the patented invention is not available to the public at a reasonably 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, —

(i) the nature of the invention, the time which has elapsed since the sealing of the patent and the measures already taken by the patentee or any licensee to make full use of the invention;

(jj) the ability of the applicant to work the invention to the public advantage;

(iii) the capacity of the applicant to undertake the risk in providing capital and working the invention, if the application were granted;

(iv) as to whether the applicant has made efforts to obtain a licence from the patentee on reasonable terms and conditions and such efforts have not been successful within a reasonable period as the Controller may deem fit: PROVIDED that this clause shall not be applicable in case of national emergency or other circumstances of extreme urgency or in case of public non-commercial use or on establishment of a ground of anti-competitive practices adopted by the patentee,

but shall not be required to take into account matters subsequent to the making of the application.

<sup>2</sup>[Explanation : For the purposes of clause (iv), "reasonable period" shall be construed as a period not ordinarily exceeding a period of six months.]

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

(a) if, by reason of the refusal of the patentee to grant a licence or licences on reasonable terms,—

(i) an existing trade or industry or the development thereof or the establishment of any new trade or industry in India or the trade or industry in India or the trade or industry of any person or class of persons trading or manufacturing in India is prejudiced; or

(ii) the demand for the patented article has not been met to an adequate extent or on reasonable terms; or

(iii) a market for export of the patented article manufactured in India is not being supplied or developed; or

(iv) the establishment or development of commercial activities in India is prejudiced; or

(b) if, by reason of conditions imposed by the patentee upon the grant of licences under the patent or upon the purchase, hire or use of the patented article or process, the manufacture, use or sale of materials not protected by the patent, or the establishment or development of any trade or industry in India, is prejudiced; or

(c) if the patentee imposes a condition upon the grant of licences under the patent to provide exclusive grant back, prevention to challenges to the validity of patent or coercive package licensing; or

(d) if the patented invention is not being worked in the territory of India on a commercial scale to an adequate extent or is not being so worked to the fullest extent that is reasonably practicable; or

(e) if the working of the patented invention in 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

(iii) other persons against whom the patentee is not taking or has not taken proceedings for infringement.

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1. Substituted for "sealing" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Inserted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 85. Revocation of patents by the Controller for non-working

(1) Where, in respect of a patent, a compulsory licence has been granted, the Central Government or any person interested may, after the expiration of two years from the date of the order granting the first compulsory licence, apply to the Controller for an order revoking the patent on the ground that the patented invention has not been worked in the territory of India or that reasonable requirements of the public with respect to the patented invention have not been satisfied or that the patented invention is not available to the public at a reasonably affordable price.

(2) Every application under sub-section (1) shall contain such particulars as may be prescribed, the facts upon which the application is based, and, in the case of an application other than by the Central Government, shall also set out the nature of the applicant's interest.

(3) The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied or that patented invention has not been worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price, may make an order revoking the patent.

(4) Every application under sub-section (1) shall ordinarily be decided within one year of its being presented to the Controller.

## Section 86. Power of Controller to adjourn applications for compulsory licences, etc., in certain cases

(1) Where an application under section 84 or section 85, as the case may be, is made on the grounds that the patented invention has not been worked in the territory of India or on the ground mentioned in clause (d) of sub-section (7) of section 84 and the Controller is satisfied that the time which has elapsed since the sealing of the patent has for any reason been insufficient to enable the invention to be worked on a commercial scale to an adequate extent or to enable the invention to be so worked to the fullest extent that is reasonably practicable, he may, by order, adjourn the further hearing of the application for such period not exceeding twelve months in the aggregate as appears to him to be sufficient for the invention to be so worked:

PROVIDED that in any case where the patentee establishes that the reason why a patented invention could not be worked as aforesaid before the date of the application was due to any State or Central Act or any rule or regulation made thereunder or any order of the Government imposed otherwise than by way of a condition for the working of the invention in the territory of India or for the disposal of the patented articles or of the articles made by the process or by the use of the patented plant, machinery, or apparatus, then, the period of adjournment ordered under this sub-section shall be reckoned from the date on which the period during which the working of the invention was prevented by such Act, rule or regulation or order of Government as computed from the date of the application, expires.

(2) No adjournment under sub-section (1) shall be ordered unless the Controller is satisfied that the patentee has taken with promptitude adequate or reasonable steps to start the working of the invention in the territory of India on a commercial scale and to an adequate extent.

## Section 87. Procedure for dealing with applications under sections 84 and 85

(1) Where the Controller is satisfied, upon consideration of an application under section 84, or section 85, that a prima facie case has been made out for the making of an order, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which the application is made, and <sup>1</sup>[shall publish the application in the Official journal].

(2) The patentee or any other person desiring to oppose the application may, within such time as may be prescribed or within such further time as the Controller may on application (made either before or after the expiration of the prescribed time) allow, give to the Controller notice of opposition.

(3) Any such notice of opposition shall contain a statement setting out the grounds on which the application is opposed.

(4) Where any such notice of opposition is duly given, the Controller shall notify the applicant, and shall give to the applicant and the opponent an opportunity to be heard before deciding the case.

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1. Substituted for "shall advertise the application in the Official Gazette" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 88. Powers of Controller in granting compulsory licences

(1) Where the Controller is satisfied on an application made under section 84 that the manufacture, use or sale of materials not protected by the patent is prejudiced by reason of conditions imposed by the patentee upon the grant of licences under the patent, or upon the purchase, hire or use of the patented article or process, he may, subject to the provisions of that section, order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant.

(2) Where an application under section 84 is made by a person being the holder of a licence under the patent, the Controller may, if he makes an order for the grant of a licence to the applicant, order the existing licence to be cancelled, or may, if he thinks fit, instead of making an order for the grant of a licence to the applicant, order the existing licence to be amended.

(3) Where two or more patents are held by the same patentee and an applicant for a compulsory licence establishes that the reasonable requirements of the public have not been satisfied with respect to some only of the said patents, then, if the Controller is satisfied that the applicant cannot efficiently or satisfactorily work the licence granted to him under those patents without infringing the other patents held by the patentee and if those patents involve important technical advancement or considerable economic significance in relation to the other patents, he may, by order, direct the grant of a licence in respect of the other patents also to enable the licensee to work the patent or patents in regard to which a licence is granted under section 84.

(4) Where the terms and conditions of a licence have been settled by the Controller, the licensee may, at any time after he has worked the invention on a commercial scale for a period of not less than twelve months, make an application to the Controller for the revision of the terms and conditions on the ground that the terms and conditions settled have proved to be more onerous than originally expected and that in consequence thereof the licensee is unable to work the invention except at a loss:

PROVIDED that no such application shall be entertained a second time.

## **Chapter XVII – Use of Inventions for Purposes of Government and Acquisition of Inventions by Central Government**

### **Section 89. General purposes for granting compulsory licences**

The powers of the Controller upon an application made under section 84 shall be exercised with a view to securing the following general purposes, that is to say,—

- (a) that patented inventions are worked on a commercial scale in the territory of India without undue delay and to the fullest extent that is reasonably practicable;
- (b) that the interests of any person for the time being working or developing an invention in the territory of India under the protection of a patent are not unfairly prejudiced.

### **Section 90. Terms and conditions of compulsory licences**

(1) In settling the terms and conditions of a licence under section 84, the Controller shall endeavour to secure—

- (i) that the royalty and other remuneration, if any, reserved to the patentee or other person beneficially entitled to the patent, is reasonable, having regard to the nature of the invention, the expenditure incurred by the patentee in making the invention or in developing it and obtaining a patent and keeping it in force and other relevant factors;
- (ii) that the patented invention is worked to the fullest extent by the person to whom the licence is granted and with reasonable profit to him;
- (iii) that the patented articles are made available to the public at reasonably affordable prices;
- (iv) that the licence granted is a non-exclusive licence;
- (v) that the right of the licensee is non-assignable;
- (vi) that the licence is for the balance term of the patent unless a shorter term is consistent with public interest;
- <sup>1</sup>[(vii) that the licence is granted with a predominant purpose of supply in the Indian market and that the licensee may also export the patented product, if need be in accordance with the provisions of sub-clause (iii) of clause (a) of sub-section (7) of section 84;

(viii) that in the case of semi-conductor technology, the licence granted is to work the invention for public non-commercial use;

(ix) that in case the licence is granted to remedy a practice determined after judicial or administrative process to be anti-competitive, the licensee shall be permitted to export the patented product, if need be.]

(2) No licence granted by the Controller shall authorise the licensee to import the patented article or an article or substance made by a patented process from abroad where such importation would, but for such authorisation, constitute an infringement of the rights of the patentee.

(3) Notwithstanding anything contained in sub-section (2), the Central Government may, if in its opinion it is necessary so to do, in the public interest, direct the Controller at any time to authorise any licensee in respect of a patent to import the patented article or an article or substance made by a patented process from abroad (subject to such conditions as it considers necessary to impose relating among other matters to the royalty and other remuneration, if any, payable to the patentee, the quantum of import, the sale price of the imported article and the period of importation), and thereupon the Controller shall give effect to the directions.

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1. Substituted for the existing clause (vii) by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 91. Licensing of related patents

(1) Notwithstanding anything contained in the other provisions of this Chapter, at any time after the sealing of a patent, any person who has the right to work any other patented invention either as patentee or as licensee thereof, exclusive or otherwise, may apply to the Controller for the grant of a licence of the first mentioned patent on the ground that he is prevented or hindered without such licence from working the other invention efficiently or to the best advantage possible.

(2) No order under sub-section (1) shall be made unless the Controller is satisfied—

(i) that the applicant is able and willing to grant, or procure the grant to the ; patentee and his licensees if they so desire, of a licence in respect of the other invention on reasonable terms; and

(ii) that the other invention has made a substantial contribution to the establishment or development of commercial or industrial activities in the territory of India.

(3) When the Controller is satisfied that the conditions mentioned in sub-section (1) have been established by the applicant, he may make an order on such terms as he thinks fit granting a licence under the first mentioned patent and a similar order under the other patent if so requested by the proprietor of the first mentioned patent or his licensee:

PROVIDED that the licence granted by the Controller shall be non-assignable except with the assignment of the respective patents.

(4) The provisions of sections 87, 88, 89 and 90 shall apply to licences granted under this section as they apply to licences granted under section 84.

## Section 92. Special provision for compulsory licences on notifications by Central Government

(1) If the Central Government is satisfied, in respect of any patent in force in circumstances of national emergency or in circumstances of extreme urgency or in case of public non-commercial use, that it is necessary that compulsory licenses should be granted at any time after the sealing thereof to work the invention, it may make a declaration to that effect, by notification in the Official Gazette, and thereupon the following provisions shall have effect, that is to say—

(i) the Controller shall, on application made at any time after the notification by any person interested, grant to the applicant a licence under the patent on such terms and conditions as he thinks fit;

(ii) in settling the terms and conditions of a licence granted under this section, the Controller shall endeavour to secure that the articles manufactured under the patent shall be available to the public at the lowest prices consistent with the patentees deriving a reasonable advantage from their patent rights.

(2) The provisions of sees. 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 sec. 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 immunodeficiencyvirus, tuberculosis, malaria or other epidemics, he shall not apply any procedure specified in section 87 in relation to that application for grant of licence under this section:

PROVIDED that the Controller shall, as soon as may be practicable, inform the patentee of the patent relating to the application for such non-application of section 87.

## Section 92 A. Compulsory licence for export of patented pharmaceutical products in certain exceptional circumstances

<sup>1</sup>[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 product 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 licence 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.]

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1. Inserted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 93. Order for licence to operate as a deed between parties concerned

Any order for the grant of a licence under this Chapter shall operate as if it were a deed granting a licence executed by the patentee and all other necessary parties embodying the terms and conditions, if any, settled by the Controller.

## Section 94. Termination of compulsory licence

(1) On an application made by the patentee or any other person deriving title or interest in the patent, a compulsory licence granted under section 84 may be terminated by the Controller, if and when the circumstances that gave rise to the grant thereof no longer exist and such circumstances are unlikely to recur:

PROVIDED that the holder of the compulsory licence shall have the right to object to such termination.

(2) While considering an application under sub-section (1), the Controller shall take into account that the interest of the person who had previously been granted the licence is not unduly prejudiced.]

## Section 95. [xxx]

Omitted by Section 39 of "The Patents (Amendment) Act, 2002".

(No. 38 of 2002).

## Section 96. [xxx]

Omitted by Section 39 of "The Patents (Amendment) Act, 2002".

(No. 38 of 2002).

## Section 97. [xxx]

Omitted by Section 39 of "The Patents (Amendment) Act, 2002".

(No. 38 of 2002).



## Section 98. [xxx]

Omitted by Section 39 of "The Patents (Amendment) Act, 2002".

(No. 38 of 2002).

## Section 99. Meaning of use of invention for purposes of government

(1) For the purposes of this chapter, an invention is said to be used for the purposes of government if it is made, used, exercised or vended for the purposes of the Central Government, a State Government or a government undertaking.

<sup>1</sup>[(2) xxx]

(3) Nothing contained in this Chapter shall apply in respect of any such importation making or using of any machine, apparatus, or other article or of any such using of any process or of any such importation, using or distribution of any medicine or drug, as may be made by virtue of one or more of the conditions specified in section 47.

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1. Omitted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

## Section 100. Power of Central Government to use inventions for purposes of government

(1) Notwithstanding anything contained in this Act, at any time after an application for a patent has been filed at the patent office or a patent has been granted, the Central Government and any person authorised in writing by it may use the invention for the purposes of government in accordance with the provisions of this chapter.

(2) Where an invention has, before the priority date of the relevant claim of the complete specification, been duly recorded in a document, or tested or tried, by or on behalf of the government or a government undertaking, otherwise than in consequence of the communication of the invention directly or indirectly, by the patentee or by a person from whom he derives title, any use of the invention by the Central Government or any person authorised in writing by it for the purposes of government may be made free of any royalty or other remuneration to the patentee.

(3) If and so far as the invention has not been so recorded or tried or tested as aforesaid, any use of the invention made by the Central Government or any person authorised by it under sub-section (1), at any time after <sup>1</sup>[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:

<sup>2</sup>[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 <sup>3</sup>[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 for the purposes of a government undertaking, the Central Government may call for such information as may be necessary for this purpose from such undertaking.

(6) The right to make, use, exercise and vend an invention for the purposes of government under sub-section (1) shall include the <sup>4</sup>[right to sell on non-commercial basis, the goods] which have been made in exercise of that right, and a purchaser of goods so sold, and a person claiming through him, shall have the power to deal with the goods as if the Central Government or the person authorised under sub-section (1) were the patentee of the invention.

(7) Where in respect of a patent which has been the subject of an authorisation under this section, there is an exclusive licensee as is referred to in sub-section (3) of section 101, or where such patent has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention (including payments by way of minimum royalty), the notice directed to be given under sub-section (5) shall also be given to such exclusive licensee or assignor, as the case may be, and the reference to the patentee in sub-section (3) shall be deemed to include a reference to such assignor or exclusive licensee.

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1. Substituted for "the acceptance of the complete specification in respect of the patent" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Substituted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

3. Substituted for "unless it appears to the Govt. that it would be contrary to the public interest so to do" by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561 (E), dt. 20-5-2003.

4. Substituted for "right to sell the goods", *ibid*.

## Section 101. Right of third parties in respect of use of invention for purposes of government

(1) In relation to any use of a patented invention, or an invention in respect of which an application for a patent is pending, made for the purposes of government

(a) by the Central Government or any person authorised by the Central Government under section 100; or

(b) by the patentee or applicant for the patent to the order made by the Central Government,

the provisions of any licence, assignment or agreement granted or made, <sup>1</sup>[xxx] between the patentee or applicant for the patent (or any person who derives title from him or from whom he derives title) and any person other than the Central Government shall be of no effect so far as those provisions—

(i) restrict or regulate the use for the purposes of government of the invention, or of any model, document or information relating thereto, or

(ii) provide for the making of payments in respect of any use of the invention or of the model, document or information relating thereto for the purposes of government <sup>2</sup>[x x x], and the reproduction or publication of any model or document in connection with the said use for the purposes of government shall not be deemed to be an infringement of any copyright subsisting in the model or document.

(2) Where the patent, or the right to apply for or obtain the patent, has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention <sup>3</sup>[x x x] then, in relation to any use of the invention made for the purposes of government by the patentee to the order of the Central Government, sub-section (3) of section 100 shall have effect as if that use were made by virtue of an authority given under that section, and any use of the invention for the purposes of government by virtue of sub-section (3) of that section shall have effect as if the reference to the patentee included a reference to the assignor of the patent, and any sum payable by virtue of that sub-section shall be divided between the patentee and the assignor in such proportion as may be agreed upon between them or as may in default of agreement be determined by the High Court on a reference under section 103.

(3) Where by virtue of sub-section (3) of section 100, payments are required to be made by the Central Government or persons authorised under sub-section (1) of that section in respect of the use of an invention for the purposes of government, and where in respect of such patent there is an exclusive licensee authorised under his licence to use the invention for the purposes of government, such sum shall be shared by the patentee and such licensee in such proportions, if any, as may be agreed upon between them or as may in default of agreement be determined by the High Court on a reference under section 103 to be just, having regard to any expenditure incurred by the licensee—

(a) in developing the said invention; or

(b) in making payments to the patentees other than royalties or other benefits determined by reference to the use of the invention <sup>1</sup>[x x x] in consideration of the licence.

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1. Words "whether before or after the commencement of this Act" omitted, *ibid*.

2. Bracket and words "(including payments by way of minimum royalty)" omitted, *ibid*.

3. Brackets and words "(including payments by way of minimum royalty)" omitted, by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

## Section 102. Acquisition of inventions and patents by the Central Government

(1) The Central Government may, if satisfied that it is necessary that an invention which is the subject of an application for a patent or a patent should be acquired from the applicant or the patentee for a public purpose, publish a notification to that effect in the Official Gazette, and

thereupon the invention or patent and all rights in respect of the invention or patent shall, by force of this section, stand transferred to and be vested in the Central Government.

(2) Notice of the acquisition shall be given to the applicant, and, where a patent has been granted, to the patentee and other persons, if any, appearing in the register as having an interest in the patent.

(3) The Central Government shall pay to the applicant, or as the case may be, the patentee and other persons appearing on the register as having an interest in the patent such other compensation as may be agreed upon between the Central Government and the applicant or the patentee and other persons; or, as may, in default of agreement, be determined by the High Court on a reference under section 103 to be just having regard to the expenditure incurred in connection with the invention and, in the case of a patent, the term thereof, the period during which and the manner in which it has already been worked (including the profits made during such period by the patentee or by his licensee whether exclusive or otherwise) and other relevant factors.

## Section 103. Reference to High Court of disputes as to use for purposes of government

(1) Any dispute as to the exercise by the Central Government or a person authorised by it of the powers conferred by section 100, or as to terms for the use of an invention for the purposes of government thereunder or as to the right of any person to receive any part of a payment made in pursuance of sub-section (3) of that section or as to the amount of compensation payable for the acquisition of an invention or a patent under section 102, may be referred to the High Court by either party to the dispute in such manner as may be prescribed by the rules of the High Court.

(2) In any proceedings under this section to which the Central Government is a party, the Central Government may—

(a) if the patentee is a party to the proceedings, petition by way of counter-claim for revocation of the patent on any ground upon which a patent may be revoked under section 64; and

(b) whether a patentee is or is not a party to the proceedings, put in issue the validity of the patent without petitioning for its revocation.

(3) If in such proceedings as aforesaid any question arises whether an invention has been recorded, tested or tried as is mentioned in section 100, and the disclosure of any document regarding the invention, or of any evidence of the test or trial thereof, would, in the opinion of the Central Government, be prejudicial to the public interest, the disclosure may be made confidentially to the advocate of the other party or to an independent expert mutually agreed upon.

(4) In determining under this section any dispute between the Central Government and any person as to terms for the use of an invention for the purposes of government, the High Court shall have regard to any benefit or compensation which that person or any person from whom he derives title, may have received, or may be entitled to receive, directly or indirectly in respect of the use of the invention in question for the purposes of government.

(5) In any proceedings under this section, the High Court may at any time order the whole proceedings or any question or issue of fact arising therein to be referred to an official referee, commissioner or an arbitrator on such terms as the High Court may direct, and references to the High Court in the foregoing provisions of this section shall be construed accordingly.

(6) Where the invention claimed in a patent was made by a person who at time it was made was in the service of the Central Government or of a State Government or was an employee of a government undertaking and the subject-matter of the invention is certified by the relevant government or the principal officer of the government undertaking to be connected with the work done in the course of the normal duties of the government servant or employee of the government undertaking, then, notwithstanding anything contained in this section, any dispute of the nature referred to in sub-section (1) relating to the invention shall be disposed of by the Central Government conformably to the provisions of this section so far as may be applicable, but before doing so the Central Government shall give an opportunity to the patentee and such other parties as it considers have an interest in the matter to be heard.

## Chapter XVIII – Suits Concerning Infringement of Patents

### Section 104. Jurisdiction

No suit for a declaration under section 105 or for any relief under section 106 or for infringement of a patent shall be instituted in any court inferior to a district court having jurisdiction to try the suit:

PROVIDED that where a counter-claim for revocation of the patent is made by the defendant, the suit, along with the counter-claim, shall be transferred to the High Court for decision.

#### COMMENTS

There is a distinction maintained as between the defence raised to a suit for infringement of a patent (vide s. 107) on the one hand and the revocation sought of a patent on the other (vide s. 64). The grounds may be the same, but still there is no inconsistency on account of the suit being defended as liable to dismissal in a particular case and a case where the defendant seeks also that the patent asserted by the plaintiff be revoked. It is only when there is a counter claim seeking revocation of the patent that the jurisdiction of the District Court is ousted. The proviso to s. 104 being in the nature of an exception to the general rule, it has to be strictly construed. There is no express claim on the part of the defendant for revocation of the patent whereof infringement is alleged by the plaintiff. That the defendant pleads that the patent set up by the plaintiff is invalid amounts only to the defendant raising a ground for the relief sought by the plaintiff being declined; it does not follow necessarily that the defendant also seeks by way of a counterclaim that the patent be revoked. The defendant has not asserted in the pleadings anywhere that they are the patentee or that they are entitled to be registered as such. The grounds raised are cumulatively and also individually by way of defence to the plaintiff's action. —Fabcon Corporation v. Industrial Engineering Corporation AIR 1987 All 338

### Section 104 A. Burden of proof in case of suits concerning infringement

<sup>1</sup>[Burden of proof in case of suits concerning infringement. (1) In any suit for infringement of a patent, where the subject matter of patent is a process for obtaining a product, the court may direct the defendant to prove that the process used by him to obtain the product, identical to the product of the patented process, is different from the patented process if,—

(a) the subject matter of the patent is a process for obtaining a new product; or

(b) there is a substantial likelihood that the identical product is made by the process, and the patentee or a person deriving title or interest in the patent from him, has been unable through

reasonable efforts to determine the process actually used:

PROVIDED that the patentee or a person deriving title or interest in the patent from him, first proves that the product is identical to the product directly obtained by the patented process.

(2) In considering whether a party has discharged the burden imposed upon him by subsection (1), the court shall not require him to disclose any manufacturing or commercial secrets, if it appears to the court that it would be unreasonable to do so.]

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1. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O.561(E), dt. 20-5-2003.

## Section 105. Power of court to make declaration as to non-infringement

(1) Notwithstanding anything contained in section 34 of the Specific Relief Act, 1963, (47 of 1963), any person may institute a suit for a declaration that the use by him of any process, or the making, use or sale of any article by him does not, or would not, constitute an infringement of a claim of a patent against the patentee or the holder of an exclusive licence under the patent, notwithstanding that no assertion to the contrary has been made by the patentee or the licensee, if it is shown—

(a) that the plaintiff has applied in writing to the patentee or exclusive licensee for a written acknowledgment to the effect of the declaration claimed and has furnished him with full particulars in writing of the process or article in question; and

(b) that the patentee or licensee has refused or neglected to give such an acknowledgment.

(2) The costs of all parties in a suit for a declaration brought by virtue of this section shall, unless for special reasons the court thinks fit to order otherwise, be paid by the plaintiff.

(3) The validity of a claim of the specification of a patent shall not be called in question in a suit for declaration brought by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid or invalid.

(4) A suit for a declaration may be brought by virtue of this section at any time 1[after the publication of grant of a patent], and references in this section to the patentee shall be construed accordingly.

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1. Substituted for "after the date of advertisement of acceptance of the complete specification of a patent" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 106. Power of court to grant relief in cases of groundless threats of infringement proceedings

(1) Where any person (whether entitled to or interested in a patent or an application for a patent or not) threatens any other person by circulars or advertisements or by communications, oral or in writing addressed to that or any other person, with proceedings for infringement of a

patent, any person aggrieved thereby may bring a suit against him praying for the following reliefs, that is to say—

- (a) a declaration to the effect that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) such damages, if any, as he has sustained thereby.

(2) Unless in such suit the defendant proves that the acts in respect of which the proceedings were threatened constitute or, if done, would constitute, an infringement of a patent or of rights arising from the publication of a complete specification in respect of a claim of the specification not shown by the plaintiff to be invalid, the court may grant to the plaintiff all or any of the reliefs prayed for.

Explanation: A mere notification of the existence of a patent does not constitute a threat of proceeding within the meaning of this section.

## Section 107. Defences, etc. in suits for infringement

(1) In any suit for infringement of a patent, every ground on which it may be revoked under section 64 shall be available as a ground for-defence.

(2) In any suit for infringement of a patent by the making, using or importation of any machine, apparatus or other article or by the using of any process or by the importation, use or distribution of any medicine or drug, it shall be a ground for defence that such making, using, importation or distribution is in accordance with any one or more of the conditions specified in section 47.

### COMMENTS

There is a distinction maintained as between the defence raised to a suit for infringement of a patent (vide s. 107) on the one hand and the revocation sought of a patent on the other (vide s. 64). The grounds may be the same, but still there is no inconsistency on account of the suit being defended as liable to dismissal in a particular case and a case where the defendant seeks also that the patent asserted by the plaintiff be revoked. It is only when there is a counter claim seeking revocation of the patent that the jurisdiction of the District Court is ousted. The proviso to s. 104 being in the nature of an exception to the general rule, it has to be strictly construed. There is no express claim on the part of the defendant for revocation of the patent whereof infringement is alleged by the plaintiff. That the defendant pleads that the patent set up by the plaintiff is invalid amounts only to the defendant raising a ground for the relief sought by the plaintiff being declined; it does not follow necessarily that the defendant also seeks by way of a counterclaim that the patent be revoked. The defendant has not asserted in the pleadings anywhere that they are the patentee or that they are entitled to be registered as such. The grounds raised are cumulatively and also individually by way of defence to the plaintiff's action.—*Fabcon Corporation v. Industrial Engineering Corporation* AIR 1987 All 338

Where the defendant neither claims to be the owner of the patent nor has it filed any petition or counter-claim, it cannot plead that the plaintiff has no locus standi to institute proceeding for infringement of patent, merely raising the plea that the plaintiff's registration is improper.—*Schnie-der Electric Industries SA v. Telemecanique and Controls (I) Ltd.* (IA No. 8522) 2000 (20) PTC 620 (Del).

## Section 107 A. Certain acts not to be considered as infringement

<sup>1</sup>[Certain acts not to be considered as infringement. For the purposes of this Act,—

(a) any art of making, constructing, <sup>2</sup>[using, selling or importing] a patented invention solely for uses reasonably relating 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, <sup>3</sup>[use, sale or import] of any product;

(b) importation of patented products by any person from a person <sup>4</sup> [who is duly authorised under the law to produce and sell or distribute the product], shall not be considered as an infringement of patent rights.]

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1. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.
2. Substituted for "using or selling" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
3. Substituted for "use or sale" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
4. Substituted for "who is duly authorised by the patentee to sell or distribute the product" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 108. Reliefs in suits for infringement

<sup>1</sup>[(1)] The reliefs which a court may grant in any suit for infringement include an injunction (subject to such terms, if any, as the court thinks fit) and, at the option of the plaintiff either damages or an account of profits.]

<sup>2</sup>[(2)] The court may also order that the goods which are found to be infringing and materials and implement, the predominant use of which is in the creation of infringing goods shall be seized, forfeited or destroyed, as the court deems fit under the circumstances of the case without payment of any compensation.]

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1. Existing section 108 renumbered as sub-section (1) thereof by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.
2. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

## Section 109. Right of exclusive licensee to take proceedings against infringement

(1) The holder of an exclusive licence shall have the like right as the patentee to institute a suit in respect of any infringement of the patent committed after the date of the licence, and in awarding damages or an account of profits or granting any other relief in any such suit the court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such or, as the case may be, the profits earned by means of the infringement so far as it constitutes an infringement of the rights of the exclusive licensee as such.



(2) In any suit for infringement of a patent by the holder of an exclusive licence under sub-section (1), the patentee shall, unless he has joined as a plaintiff in the suit, be added as a defendant, but a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

## Section 110. Right of licensee under section 84 to take proceedings against infringement

Any person to whom a licence has been granted under section 84 shall be entitled to call upon the patentee to take proceedings to prevent any infringement of the patent, and, if the patentee refuses or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as though he were the patentee, making the patentee a defendant; but a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

## Section 111. Restriction on power of court to grant damages or an account of profits for infringement

(1) In a suit for infringement of a patent, damages or an account of profits shall not be granted against the defendant who proves that at the date of the infringement he was not aware and had no reasonable grounds for believing that the patent existed.

Explanation : A person shall not be deemed to have been aware or to have had reasonable grounds for believing that a patent exists by reason only of the application to an article of the word "patent", "patented" or any word or words expressing or implying that a patent has been obtained for the article, unless the number of the patent accompanies the word or words in question.

(2) In any suit for infringement of a patent the court may, if it thinks fit, refuse to grant any damages or an account of profits in respect of any infringement committed after a failure to pay any renewal fee within the prescribed period and before any extension of that period.

(3) Where an amendment of a specification by way of disclaimer, correction or explanation has been allowed under this Act after the publication of the specification, no damages or account of profits shall be granted in any proceeding in respect of the use of the invention before the date of the decision allowing the amendment, unless the court is satisfied that the specification as originally published was framed in good faith and with reasonable skill and knowledge.

(4) Nothing in this section shall affect the power of the court to grant an injunction in any suit for infringement of a patent.

## Section 112. [x x x]

<sup>1</sup>[x x x]

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1. Omitted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

## Section 113. Certificate of validity of specification and costs of subsequent suits for infringement thereof

<sup>1</sup>[(1) If in any proceedings before the Appellate Board or a High Court for the revocation of a patent under section 64 and section 104, as the case may be, the validity of any claim of a specification is contested and that claim is found by the Appellate Board or the High Court to be valid, the Appellate Board or the High Court may certify that the validity of that claim was contested in those proceedings and was upheld.]

(2) Where any such certificate has been granted, then, if any subsequent suit before a court for infringement of that claim of the patent or in any subsequent proceeding for revocation of the patent in so far as it relates to that claim, the patentee or other person relying on the validity of the claim obtains a final order or judgment in his favour, he shall be entitled to an order for the payment of his full costs, charges and expenses of and incidental to any such suit or proceeding properly incurred so far as they concern the claim in respect of which the certificate was granted, unless the court trying the suit or proceeding otherwise directs:

PROVIDED that the costs as specified in this sub-section shall not be ordered when the party disputing the validity of the claim satisfies the court that he was not aware of the grant of the certificate when he raised the dispute and withdrew forthwith such defence when he became aware of such a certificate.

<sup>1</sup>[(3) Nothing contained in this section shall be construed as authorising the courts or the Appellate Board hearing appeals from decrees or orders in suits for infringement or petitions for revocation, as the case may be, to pass orders for costs on the scale referred to therein.]

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1. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. the date to be notified.

## Section 114. Relief for infringement of partially valid specification

(1) If in proceedings for infringement of a patent it is found that any claim of the specification, being a claim in respect of which infringement is alleged, is valid but that any other claim is invalid, the court may grant relief in respect of any valid claim which is infringed:

PROVIDED that the court shall not grant relief except by way of injunction save in the circumstances mentioned in sub-section (2).

(2) Where the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the court shall grant relief in respect of any valid claim which is infringed subject to the discretion of the court as to costs and as to the date from which damages or an account of profits should be reckoned, and in exercising such discretion the court may take into consideration the conduct of the parties in inserting such invalid claim in the specification or permitting them to remain there.

## Section 115. Scientific advisers

(1) In any suit for infringement or in any proceeding before a court under this Act, the court may at any time, and whether or not an application has been made by any party for that purpose appoint an independent scientific adviser to assist the court or to inquire and report upon any such question of fact or of opinion (not involving a question of interpretation of law) as it may formulate for the purpose.

(2) The remuneration of the scientific adviser shall be fixed by the court and shall include the costs of making a report and a proper daily fee for any day on which the scientific adviser may

be required to attend before the court, and such remuneration shall be defrayed out of moneys provided by Parliament by law for the purpose.

## Chapter XIX – Appeals to the Appellate Board

### Section 116. Appellate Board

<sup>1</sup>[CHAPTER XIX

#### APPEALS TO THE APPELLATE BOARD

(1) Subject to the provisions of this Act, the Appellate Board established under section 83 of the Trade Marks Act, 1999 shall be the Appellate Board for the purposes of this Act and the said Appellate Board shall exercise the jurisdiction, power and authority conferred on it by or under this Act:

PROVIDED that the Technical Member of the Appellate Board for the purposes of this Act shall have the qualifications specified in sub-section (2).

(2) A person shall not be qualified for appointment as a Technical Member for the purposes of this Act unless he—

(a) has at least five years held the post of Controller under this Act or has exercised the functions of the Controller under this Act for at least five years; or

(b) has been for at least ten years functioned as a Registered Patent Agent and possesses a degree in engineering or technology or a masters degree in science from any University established under law for the time being in force or equivalent; or

<sup>2</sup>[(c) xxx]

#### COMMENTS

Refusal of Controller to proceed with an application under section 15 not being an order, appeal thereagainst is maintainable.—Danieli AC Officine Meccaniche SPA v. Controller of Patents 2000 (20) PTC 219 (Call)

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1. Substituted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

2. Clause (c) omitted by the Patents (Amdt.) Act, 2005, w.e.f. the date to be notified.

### Section 117. Staff of Appellate Board

(1) The Central Government shall determine the nature and categories of the officers and other employees required to assist the Appellate Board in the discharge of its functions under this Act and provide the Appellate Board with such officers and other employees as it may think fit.

(2) The salaries and allowances and conditions of service of the officers and other employees of the Appellate Board shall be such as may be prescribed.

(3) The officers and other employees of the Appellate Board shall discharge their functions under the general superintendence of the Chairman of the Appellate Board in the manner as may be prescribed.

## Section 117 A. Appeals to Appellate Board

(1) Save as otherwise expressly provided in sub-section (2), no appeal shall lie from any decision, order or direction made or issued under this Act by the Central Government, or from any act or order of the Controller for the purpose of giving effect to any such decision, order or direction.

(2) An appeal shall lie to the Appellate Board from any decision, order or direction of the Controller or Central Government under section 15, section 16, section 17, section 18, section 19, <sup>1</sup>[section 20, sub-section (4) of section 25, section 28], section 51, section 54, section 57, section 60, section 61, section 63, section 66, sub-section (3) of section 69, section 78, subsections (1) to (5) of section 84, section 85, section 88, section 91, section 92 and section 94.

(3) Every appeal under this section shall be in the prescribed form and shall be verified in such manner as may be prescribed and shall be accompanied by a copy of the decision, order or direction appealed against and by such fees as may be prescribed.

(4) Every appeal shall be made within three months from the date of the decision, order or direction, as the case may be, of the Controller or the Central Government or within such further time as the Appellate Board may, in accordance with the rules made by it, allow.

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1. Substituted for "section 20, section 25, section 27, section 28" by the Patents (Amdt.) Act, 2005, w.e.f. the date to be notified.

## Section 117 B. Procedure and powers of Appellate Board

The provisions of sub-sections (2) to (6) of section 84, section 87, section 92, section 95 and section 96 of the Trade Marks Act, 1999 shall apply to the Appellate Board in the discharge of its functions under this Act as they apply to it in the discharge of its functions under the Trade Marks Act, 1999.

## Section 117 C. Bar of jurisdiction of courts, etc

No court or other authority shall have or, be entitled to, exercise any jurisdiction, powers or authority in relation to the matters referred to in sub-section (2) of section 117A or section 117D.

## Section 117 D. Procedure for application for rectification, etc., before Appellate Board

(1) An application <sup>1</sup>[for revocation of a patent before the Appellate Board under section 64 and an application for rectification of the register] made to the Appellate Board under section 71 shall be in such form as may be prescribed.

(2) A certified copy of every order or judgment of the Appellate Board relating to a patent under this Act shall be communicated to the Controller of the Board and the Controller shall give effect

to the order of the Board and shall, when so directed, amend the entries in, or rectify, the register in accordance with such order.

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1. Substituted for "for rectification of the register" by the Patents (Amdt.) Act, 2005, w.e.f. the date to be notified.

## Section 117 E. Appearance of Controller in legal proceedings

(1) The Controller shall have the right to appear and be heard—

(a) in any legal proceedings before the Appellate Board in which the relief sought includes alteration or rectification of the register or in which any question relating to the practice of the patent office is raised;

(b) in any appeal to the Appellate Board from an order of the Controller on an application for grant to a patent—

(i) which is not opposed, and the application is either refused by the Controller or is accepted by him subject to any amendments, modifications, conditions or limitations, or

(ii) which has been opposed and the Controller considers that his appearance is necessary in the public interest, and the Controller shall appear in any case if so directed by the Appellate Board.

(2) Unless the Appellate Board otherwise directs, the Controller may, in lieu of appearing, submit a statement in writing signed by him, giving such particulars as he thinks proper of the proceedings before him relating to the matter in issue or of the grounds of any decision given by him or of the practice of the patent office in like cases, or of other matters relevant to the issues and within his knowledge as the Controller may deem it necessary, and such statement shall be evidence in the proceedings.

## Section 117 F. Costs of Controller in proceedings before Appellate Board

In all proceedings under this Act before the Appellate Board, the costs of the Controller shall be in the discretion of the Board, but the Controller shall not be ordered to pay the costs of any of the parties.

## Section 117 G. Transfer of pending proceedings to Appellate Board

<sup>1</sup>[Transfer of pending proceedings to Appellate Board. All cases of appeals against any order or decision of the Controller and all cases pertaining to revocation of patent other than on a counter-claim in a suit for infringement and rectification of register pending before any High Court, shall be transferred to the Appellate Board from such date as may be notified by the Central Government in the Official Gazette and the Appellate Board may proceed with the matter either de novo or from the stage it was so transferred.]

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1. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. the date to be notified.

## Section 117 H. Power of Appellate Board to make rules

[The Appellate Board may make rules consistent with this Act as to the conduct and procedure in respect of all proceedings before it under this Act.]

## Chapter XX – Penalties

### Section 118. Contravention of secrecy provisions relating to certain inventions

If any person fails to comply with any direction given under section 35, <sup>1</sup>[or makes or causes to be made an application for the grant of a patent in contravention of section 39] he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.

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1. Inserted, by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

### Section 119. Falsification of entries in register, etc.

If any person makes, or causes to be made, a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in such a register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing knowing the entry or writing to be false, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.

### Section 120. Unauthorised claim of patent rights

If any person falsely represents that any article sold by him is patented in India or is the subject of an application for a patent in India, he shall be punishable with fine which may extend to <sup>1</sup>[one lakh] rupees.

Explanation 1 : For the purposes of this section, a person shall be deemed to represent —

(a) that an article is patented in India if there is stamped, engraved or impressed on, or otherwise applied to, the article the word "patent" or "patented" or some other word expressing or implying that a patent for the article has been obtained in India;

(b) that an article is the subject of an application for a patent in India if there are stamped, engraved or impressed on, or otherwise applied to, the article the words "patent applied for", "patent pending", or some other words implying that an application for a patent for the article has been made in India.

Explanation 2: The use of words "patent", "patented", "patent applied for", "patent pending" or other words expressing or implying that an article is patented or that a patent has been applied for shall be deemed to refer to a patent in force in India, or to a pending application for a patent in India, as the case may be, unless there is an accompanying indication that the patent has been obtained or applied for in any country outside India.

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1. Substituted for "ten thousand" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 121. Wrongful use of words, "patent office"

If any person uses on his place of business or any document issued by him or otherwise the words "patent office" or any other words which would reasonably lead to the belief that his place of business is or is officially connected with, the patent office, he shall be punishable with imprisonment for a term which may extend to six months, or with fine, or with both.

## Section 122. Refusal or failure to supply information

(1) If any person refuses or fails to furnish—

(a) to the Central Government any information which he is required to furnish under sub-section (5) of section 100,

(b) to the Controller any information or statement which he is required to furnish by or under section 146. he shall be punishable with fine which may extend to <sup>1</sup>[ten lakh rupees]

(2) If any person, being required to furnish any such information as is referred to in subsection (1), furnishes information or statement which is false and which he either knows or has reason to believe to be false or does not believe to be true, he shall be punishable with imprisonment which may extend to six months, or with fine, or with both.

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1. Substituted for "twenty thousand rupees" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 123. Practice by non-registered patent agents

If any person contravenes the provisions of section 129, he shall be punishable with fine which may extend to <sup>1</sup>[one lakh rupees in the case of a first offence and five lakh rupees] in the case of a second or subsequent offence.

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1. Substituted for "ten thousand rupees in the case of a first offence and forty thousand rupees" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 124. Offences by companies

(1) If the person committing an offence under this Act is a company, the company as well as every person in charge of, and responsible to, the company for the conduct of its business at the time of the commission of the offence shall be deemed to be guilty of the offence and shall be liable to be proceeded against and punished accordingly:

PROVIDED that nothing contained in this sub-section shall render any such person liable to any punishment if he proves that the offence was committed without his knowledge or that he exercised all due diligence to prevent the commission of such offence.

(2) Notwithstanding anything contained in sub-section (1), where an offence under this Act has been committed by a company and it is proved that the offence has been committed with the consent or connivance of, or that the commission of the offence is attributable to any neglect on

the part of any director, manager, secretary or other officer of the company, such director, manager, secretary or other officer shall also be deemed to be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

Explanation : For the purposes of this section—

(a) "company" means any body corporate and includes a firm or other association of individuals; and

(b) "director", in relation to a firm, means a partner in the firm.

## Chapter XXI – Patent Agents

### Section 125. Register of patent agents

<sup>1</sup>[Register of patent agents. (1) The Controller shall maintain a register to be called the register of patent agents in which shall be entered the names, addresses and other relevant particulars, as may be prescribed, of all persons qualified to have their names so entered under section 126.

(2) Notwithstanding anything contained in sub-section (1), it shall be lawful for the Controller to keep the register of patent agents in computer floppies, diskettes or any other electronic form subject to such safeguards as may be prescribed.]

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1. Substituted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561 (E), dt. 20-5-2003.

### Section 126. Qualifications for registration as patent agents

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

(a) he is a citizen of India;

(b) he has completed the age of 21 years;

(c) he has obtained a <sup>1</sup>[degree in science, engineering or technology from any University established under law for the time being in force] in the territory of India or possesses such other equivalent qualifications as the Central Government may specify in this behalf, and, in addition—

<sup>2</sup>[(i) xxx]

(ii) has passed the qualifying examination prescribed for the purpose; <sup>3</sup>[or]

<sup>3</sup>[(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.

<sup>4</sup>[(2) Notwithstanding anything contained in sub-section (1), a person who has been registered as a patent agent before the commencement of <sup>5</sup>[the Patents (Amendment) Act, 2005] shall be



entitled to continue to be, or when required to be re-registered, as a patent agent, on payment of the fee as may be prescribed].

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1. Substituted for "degree from any university", *ibid*.
2. Sub-clause (i) omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.
3. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561 (E), dt. 20-5-2003.
4. Substituted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.
5. Substituted for "the Patents (Amdt.) Act, 2002" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 127. Rights of patent agents

Subject to the provisions contained in this Act and to any rules made thereunder, every patent agent whose name is entered in the register shall be entitled—

- (a) to practise before the Controller; and
- (b) to prepare all documents, transact all business and discharge such other functions as may be prescribed in connection with any proceedings before the Controller under this Act.

## Section 128. Subscription and verification of certain documents by patent agents

(1) All applications and communications to the Controller under his Act may be signed by a patent agent authorised in writing in this behalf by the person concerned.

<sup>1</sup>[(2) xxx]

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1. Omitted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

## Section 129. Restrictions on practice as patent agents

(1) No person, either alone or in partnership with any other person, shall practise, describe or hold himself out as a patent agent or permit himself to be so described or held out, unless he is registered as patent agent or, as the case may be, unless he and all his partners are so registered.

(2) No company or other body corporate shall practise, describe itself or hold itself out as patent agents or permit itself to be so described or held out.

Explanation : For the purposes of this section, practise, as a patent agent includes any of the following acts, namely,—

- (a) applying for or obtaining patents in India or elsewhere;

(b) preparing specifications or other documents for the purposes of this Act or of the patent law of any other country;

(c) giving advice other than of scientific or technical nature as to the validity of patents or their infringement.

## Section 130. Removal from register of patent agents and restoration

(1) The <sup>1</sup>[Controller] may remove the name of any person from the register when it is satisfied, after giving that person a reasonable opportunity of being heard and after such further inquiry, if any, as <sup>2</sup>[he] thinks fit to make—

(i) that his name has been entered in the register by error or on account of misrepresentation or suppression of material fact; or

(ii) that he has been convicted of any offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity which in the opinion of the <sup>3</sup>[Controller] renders him unfit to be kept in the register.

(2) The <sup>3</sup>[Controller] may, on application and on sufficient cause being shown, restore to the register the name of any person removed therefrom.

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1. Substituted for "Central Government", *ibid.*

2. Substituted for "it", *ibid.*

3. Substituted for "Central govt." by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O.561(E), dt. 20-5-2003.

## Section 131. Power of Controller to refuse to deal with certain agents

(1) Subject to any rules made in this behalf, the Controller may refuse to recognise as agent in respect of any business under this Act—

(a) any individual whose name has been removed from, and not restored to, the register;

(b) any person who has been convicted of an offence under section 123; ,

(c) any person, not being registered as a patent agent, who in the opinion of the <sup>1</sup>[Controller] is engaged wholly or mainly in acting as agent in applying for patents in India or elsewhere in the name or for the benefit of the person by whom he is employed;

(d) any company or firm, if any person whom the <sup>1</sup>[Controller] could refuse to recognise as agent in respect of any business under this Act, is acting as a director or manager of the company or is a partner in the firm.

(2) The <sup>1</sup>[Controller] shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in India.

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1. Substituted for "Central govt." by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O.561(E), dt. 20-5-2003.

## Section 132. Saving in respect of other persons authorised to act as agents

Nothing in this chapter shall be deemed to prohibit—

- (a) the applicant for a patent <sup>1</sup>[x x x] from drafting any specification or appearing or acting before the Controller; or
- (b) an advocate, not being a patent agent, from taking part in any <sup>2</sup>[hearing before the Controller on behalf of a party who is taking part in any proceeding under this Act].

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1. Words "or any person, not being a patent agent who is duly authorised by the applicant" omitted, by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561 (E), dt. 20-5-2003.

2. Substituted for "proceedings under this Act otherwise than by way of drafting any specification", *ibid*.

## Chapter XXII – International Arrangements

### Section 133. Convention countries

<sup>1</sup>[Convention countries. Any country, which is a signatory or party or a group of countries, union of countries or inter-governmental organizations which are signatories or parties to an international, regional or bi-lateral treaty, convention or arrangement to which India is also a signatory or party and which affords to the applicants for patents in India or to citizens of India similar privileges as are granted to their own citizens or citizens to their member countries in respect of the grant of patents and protection of patent rights shall be a convention country or convention countries for the purposes of this Act.]

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1. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

### Section 134. Notification as to countries not providing for reciprocity

Where any country specified by the Central Government in this behalf by notification in the Official Gazette does not accord to citizens of India the same rights in respect of the grant of patents and the protection of patent rights as it accords to its own nationals, no national of such country shall be entitled, either solely or jointly with any other person—

- (a) to apply for the grant of a patent or be registered as the proprietor of a patent;
- (b) to be registered as the assignee of the proprietor of a patent; or

(c) to apply for a licence or hold any licence under a patent granted under this Act.

## Section 135. Convention applications

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

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

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

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

<sup>1</sup>[(3) In case of an application filed under the Patent Cooperation Treaty designating India and claiming priority from a previously filed application in India, the provisions of subsections (1) and (2) shall apply as if the previously filed application were the basic application:

PROVIDED that a request for examination under section 11B shall be made only for one of the applications filed in India.]

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1. Inserted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 136. Special provisions relating to convention applications

(1) Every convention application shall—

(a) be accompanied by a complete specification; and

(b) specify the date on which and the convention country in which the application for protection, or as the case may be, the first of such applications was made; and

(c) state that no application for protection in respect of the invention had been made in a convention country before that date by the applicant or by any person from whom he derives title.

(2) Subject to the provisions contained in section 10, a complete specification filed with a convention application may include claims in respect of developments of, or additions to, the invention in respect of which the application for protection was made in a convention country, being developments or additions in respect of which the applicant would be entitled under the provisions of section 6 to make a separate application for a patent.

(3) A convention application shall not be post-dated under sub-section (1) of section 17 to a date later than the date on which under the provisions of this Act the application could have been made.

## Section 137. Multiple priorities

(1) Where two or more applications for patents in respect of inventions have been made in one or more convention countries and those inventions are so related as to constitute one invention, one application may be made by any or all of the persons referred to in subsection (1) of section 135 within twelve months from the date on which the earlier or earliest of those applications was made, in respect of the inventions disclosed in the specifications which accompanied the basic applications.

(2) The priority date of a claim of the complete specification, being a claim based on matters disclosed in one or more of the basic applications, is the date on which that matter was first so disclosed.

(3) For the purposes of this Act, a matter shall be deemed to have been disclosed in a basic application for protection in a convention country if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgment of a prior art) in that application, or any documents submitted by the applicant for protection in support of and at the same time as that application, but no account shall be taken of any disclosure effected by any such document unless a copy of the document is filed at the patent office with the convention application or within such period as may be prescribed after the filing of that application.

## Section 138. Supplementary provisions as to convention applications

<sup>1</sup>[(1) Where a convention application is made in accordance with the provisions of this Chapter, the applicant shall furnish, when required by the Controller, in addition to the complete specification, copies of the specifications or corresponding documents filed or deposited by the applicant in the patent office of the convention country as referred to in section 133 verified to the satisfaction of the Controller, within the prescribed period from the date of communication by the Controller.]

(2) If any such specification or other document is in a foreign language, a translation into English of the specification or document, verified by affidavit or otherwise to the satisfaction of the Controller, shall be <sup>2</sup>[furnished when required by the Controller].

(3) For the purposes of this Act, the date on which an application was made in a convention country is such date as the Controller is satisfied, by certificate of the official chief or head of the patent office of the convention country or otherwise is the date on which the application was made in that convention country.

<sup>3</sup>[(4) An international application filed under <sup>3</sup>the Patent Co-operation Treaty designating India shall have effect of filing an application for patent under section 7, section 54 and section 135, as the case may be, and the title, description, claim and abstract and drawings, if any, filed in the international application shall be taken as complete specification for the purposes of this Act.

(5) The filing date of an application for patent and its complete specification processed by the patent office as designated office shall be the international filing date accorded under the Patent Cooperation Treaty.

(6) Amendment, if any, proposed by the applicant for an international application designating India or designating and electing India before international searching authority or preliminary examination authority shall, if the applicant so desires, be taken as an amendment made before the patent office.]

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1. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Substituted for "annexed to the specification or document", by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561 (E), dt. 20-5-2003.

3. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

## Section 139. Other provisions of Act to apply to convention applications

Save as otherwise provided in this chapter, all the provisions of this Act shall apply in relation to convention application and a patent granted in pursuance thereof as they apply in relation to an ordinary application and a patent granted in pursuance thereof.

## Chapter XXIII – Miscellaneous

### Section 140. Avoidance of certain restrictive conditions

(1) It shall not be lawful to insert—

(i) in any contract for or in relation to the sale or lease of a patented article or an article made by a patented process; or

(ii) in a licence to manufacture or use a patented article; or

(iii) in a licence to work any process protected by a patent, a condition the effect of which may be—

(a) to require the purchaser, lessee, or licensee to acquire from the vendor, lessor, or licensor, or his nominees, or to prohibit him from acquiring or to restrict in any manner or to any extent his right to acquire from any person or to prohibit him from acquiring except from the vendor, lessor, or licensor or his nominees, any article other than the patented article or an article other than that made by the patented process; or

(b) to prohibit the purchaser, lessee or licensee from using, or to restrict in any manner or to any extent the right of the purchaser, lessee or licensee, to use an article other than the patented article or an article other than that made by the patented process, which is not supplied by the vendor, lessor or licensor or his nominee; or

(c) to prohibit the purchaser, lessee or licensee from using or to restrict in any manner or to any extent the right of the purchaser, lessee or licensee to use any process other than the patented process, and any such condition shall be void.

<sup>1</sup>[(d) to provide exclusive grant back, prevention to challenges to validity of patent and coercive package licensing.]

(2) A condition of the nature referred to in clause (a) or clause (b) or clause (c) of subsection (1) shall not cease to be a condition falling within that sub-section merely by reason of the fact that the agreement containing it has been entered into separately, whether before or after the contract relating to the sale, lease or licence of the patented article or process.

(3) In proceedings against any person for the infringement of a patent, it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent and containing a condition declared unlawful by this section:

PROVIDED that this sub-section shall not apply if the plaintiff is not a party to the contract and proves to the satisfaction of the court that the restrictive condition was inserted in the contract without his knowledge and consent, express or implied.

(4) Nothing in this section shall—

(a) affect a condition in a contract by which a person is prohibited from selling goods other than those of a particular person;

(b) validate a contract which, but for this section, would be invalid;

(c) affect a condition in a contract for the lease of, or licence to use, a patented article, by which the lessor or licensor reserves to himself or his nominee the right to supply such new parts of the patented article as may be required or to put or keep it in repair.

<sup>2</sup>[(5) xxx]

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1. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

2. Omitted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

## Section 141. Determination of certain contracts

(1) Any contract for the sale or lease of a patented article or for licence to manufacture, use or work a patented article or process, or relating to any such sale, lease or licence, <sup>1</sup>[x x x], may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything to the contrary in the contract or in any other contract, be determined by the purchaser, lessee, or licensee, as the case may be, of the patent on giving three months' notice in writing to the other party.

(2) The provisions of this section shall be without prejudice to any right of determining a contract exercisable apart from this section.

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1. Words "whether made before or after the commencement to this Act" omitted, by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

## Section 142. Fees

(1) There shall be paid in respect of the grant of patents and applications therefor, and in respect of other matters in relation to the grants of patents under this Act, such fees as may be prescribed by the Central Government.

(2) Where a fee is payable in respect of the doing of an act by the Controller, the Controller shall not do that act until the fee has been paid.

<sup>1</sup>[(3) Where a fee is payable in respect of the filing of a document at the patent office, the fee shall be paid along with the document or within the prescribed time and the document shall be deemed not to have been filed at the office if the fee has not been paid within such time.]

(4) Where a principal patent is granted later than two years from the date of filing of the <sup>2</sup>[the application], the fees which have become due in the meantime may be paid within a term of three months from the date of the recording of the patent in the register <sup>3</sup>[or within the extended period not later than nine months from the date of recording.]

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1. Substituted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

2. Substituted for "complete specification" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

3. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

## Section 143. Restrictions upon publication of specification

<sup>1</sup>[Restrictions upon publication of specification. Subject to the provisions of Chapter VII, an application for a patent, and any specification filed in pursuance thereof, shall not, except with the consent of the applicant, be published by the Controller before the expiration of the period prescribed under sub-section (1) of section 11A or before the same is open to public inspection in pursuance of sub-section (3) of section 11A or section 43.]

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1. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 144. Reports of examiners to be confidential

The reports of examiners to the Controller under this Act shall not be open to public inspection or be published by the Controller; and such reports shall not be liable to production or inspection in any legal proceeding unless the court certifies that the production or inspection is desirable in the interest of justice, and ought to be allowed.

## Section 145. Publication of official journal

<sup>1</sup>[Publication of official journal. The Controller shall publish periodically an official journal which shall contain such information as may be required to be published by or under the provisions of this Act or any rule made thereunder.]

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1. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.



## Section 146. Power of Controller to call for information from patentees

(1) The Controller may, at any time during the continuance of the patent, by notice in writing, require a patentee or a licensee, exclusive or otherwise, to furnish to him within two months from the date of such notice or within such further time as the Controller may allow, such information or such periodical statements as to the extent to which the patented invention has been commercially worked in India as may be specified in the notice.

(2) Without prejudice to the provisions of sub-section (1), every patentee and every licensee (whether exclusive or otherwise) shall furnish in such manner and form and at such intervals (not being less than six months) as may be prescribed statements as to the extent to which the patented invention has been worked on a commercial scale in India.

(3) The Controller may publish the information received by him under sub-section (1) or sub-section (2) in such manner as may be prescribed.

## Section 147. Evidence of entries, documents, etc.

(1) A certificate purporting to be signed by the Controller as to any entry, matter or thing which he is authorised by this Act or any rules made thereunder to make or do, shall be prima facie evidence of the entry having been made and of the contents thereof and of the matter or thing having been done or omitted to be done.

(2) A copy of any entry in any register or of any document kept in the patent office or of any patent, or an extract from any such register or document, purporting to be certified by the Controller and sealed with the seal of the patent office shall be admitted in evidence in all courts, and in all proceedings, without further proof or production of the original.

(3) The Controller or any other officer of the patent office shall not, in any legal proceedings to which he is not a party, be compellable to produce the register or any other document in his custody, the contents of which can be proved by the production of a certified copy issued under this Act or to appear as a witness to prove the matters therein recorded unless by order of the court made for special causes.

## Section 148. Declaration by infant, lunatic, etc.

(1) If any person is, by reason of minority, lunacy or other disability, incapable of making any statement or doing anything required or permitted by or under this Act the lawful guardian, committee or manager (if any) of the person subject to the disability, or if there be none, any person appointed by any court possessing jurisdiction in respect of his property, may make such statement or a statement as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any person interested in the making of the statement or the doing of the thing.

## Section 149. Service of notices, etc. by post

Any notice required or authorised to be given by or under this Act, and any application or other document so authorised or required to be made or filed, may be given, made or filed by post.

## Section 150. Security for costs

If any party by whom notice of any opposition is given under this Act or by whom application is made to the Controller for the grant of a licence under a patent neither resides nor carries on business in India, the Controller may require him to give security for the cost of the proceedings, and in default of such security being given may treat the opposition or application as abandoned.

## Section 151. Transmission of orders of courts to Controller

(1) Every order of <sup>1</sup>[the High Court or the Appellate Board] on a petition for revocation, including orders granting certificates of validity of any claim, shall be transmitted by <sup>1</sup>[the High Court or the Appellate Board] to the Controller who shall cause an entry thereof and reference thereto to be made in the register.

(2) Where in any suit for infringement of a patent or in any suit under section 106 the validity of any claim or a specification is contested and that claim is found by the court to be valid or not valid, as the case may be, the court shall transmit a copy of its judgment and decree to the Controller who shall on receipt thereof cause an entry in relation to such proceeding to be made in the prescribed manner in a supplemental record.

(3) The provisions of sub-sections (1) and (2) shall also apply to the court to which appeals are preferred against decisions of the <sup>2</sup>[Appellate Board or the Courts] referred to in those sub-sections.

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1. Substituted for "the High Court" by the Patents (Amdt.) Act, 2005, w.e.f. the date to be notified.

2. Substituted for "courts" by the Patents (Amdt.) Act, 2005, w.e.f. the date to be notified.

## Section 152. [xxx]

<sup>1</sup>[xxx]

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1. Omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 153. Information relating to patents

A person making a request to the Controller in the prescribed manner for information relating to any such matters as may be prescribed as respects any patent specified in the request or as respects any application for a patent so specified shall be entitled, subject to the payment of the prescribed fee to have information supplied to him accordingly.

## Section 154. Loss or destruction of patents

If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Controller, the Controller may at any time, on application made in the prescribed manner and on payment of the prescribed fee, cause a duplicate thereof to be sealed and delivered to the applicant.

## Section 155. Reports of Controller to be placed before Parliament

The Central Government shall cause to be placed before both Houses of Parliament once a year a report respecting the execution of this Act by or under the Controller.

## Section 156. Patent to bind government

Subject to the other provisions contained in this Act, a patent shall have to all intents the like effect as against government as it has against any person.

## Section 157. Right of government to sell or use forfeited articles

Nothing in this Act shall affect the power of the government or of any person deriving title directly or indirectly from the government to sell or use any articles forfeited under any law for the time being in force.

## Section 157 A. Protection of security of India

<sup>1</sup>[Protection of security of India. Notwithstanding anything contained in this Act, the Central Government shall —

(a) not disclose any information relating to any patentable invention or any application relating to the grant of patent under this Act, which it considers prejudicial to the interest of the security of India;

(b) take any action including the revocation of any patent which it considers necessary in the interest of the security of India by issue of a notification in the official gazette to that effect.

Explanation : For the purposes of this section, the expression "security of India" includes any action necessary for the security of India which —

(i) relates to fissionable materials or the materials from which they are derived; or

(ii) relates to the traffic in arms, ammunition and implements of war -and to such traffic in other goods and materials as is carried on directly or indirectly for the purpose of supplying a military establishment; or

(iii) is taken in time of war or other emergency in international relations.]

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1. Substituted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561 (E), dt. 20-5-2003.

## Section 158. Power of High Courts to make rules

The High Court may make rules consistent with this Act as to the conduct and procedure in respect of all proceedings before it under this Act.

## Section 159. Power of Central Government to make rules

(1) The Central Government may, by notification on the Official Gazette, make rules for carrying out the purposes of this Act.

(2) Without prejudice to the generality of the forgoing power, the Central Government may make rules to provide for all or any of the following matters, namely,—

(i) the form and manner in which any application for a patent, any specifications or drawings and any other application or document may be filed in the patent office;

<sup>1</sup>[(ia)the period which the Controller may allow the filing of statement and undertaking for in respect of applications under sub-section (1), the period within which the details relating to processing of applications may be filed before the Controller and the details to be furnished by the applicant to the Controller under sub-section (2) of section 8;

(ib) the period within which a reference to the deposit of materials shall be made in the specification under sub-clause (A) of clause (ii) of the proviso to sub-section (4) of section 10;

(ic) the period for which application for patent shall not be open to the public under sub-section (1) and the manner in which the applicant may make a request to the Controller to publish his application under sub-section (2) of section 11A;

(id) the manner of making the request for examination for an application for patent and the period within which such examination shall be made under sub-sections (1) and (3) of section 11B;

(ie) the manner in which an application for withdrawal of an application for grant of a patent shall be made and the period within which a request for examination from the date of revocation of secrecy directions shall be made under the proviso to sub-section (4) of section 11B.]

(ii) the time within which any act or thing may be done under this Act, including the manner in which and the time within which any matter may be <sup>2</sup>[published] under this Act;

(iii) the fees which may be payable under this Act and the manner and time of payment of such fees;

(iv) the matters in respect of which the examiner may make a report to the Controller;

<sup>3</sup>[(v)the manner in which and the period within which the Controller shall consider and dispose off a representation under sub-section (1) of section 25;

(va) the period within which the Controller is required to dispose off an application under section 39;]

(vi) the form and manner in which and the time within which any notice may be given under this Act;

(vii) the provisions which may be inserted in an order for restoration of a patent for the protection of persons who may have availed themselves of the subjectmatter of the patent after the patent had ceased;

(viii) the establishment of branch offices of the patent office, and the regulation generally of the business of the patent office, including its branch offices;

(ix) the maintenance of the register of patents <sup>4</sup>[and the safeguards to be observed in the maintenance of such register in computer floppies, diskettes or any other electronic form] and

the matters to be entered therein;

(x) the matters in respect of which the Controller shall have powers of a civil court;

(xi) the time when and the manner in which the register and any other document open to inspection may be inspected under this Act;

(xii) the qualifications of, and the preparation of a roll of, scientific advisers for the purpose of section 115;

<sup>4</sup>[(xiiia) the salaries and allowances and other conditions of service of the officers and other employees of the Appellate Board under sub-section (2), and the manner in which the officers and other employees of the Appellate Board shall discharge their functions under sub-section (3) of section 117;

(xiiib) the form of making an appeal, the manner of verification and the fee payable under sub-section (3) of section 117A;

(xiic) the form in which, and the particulars to be included in, the application to the Appellate Board under sub-section (1) of section 117D;]

(xiii) the manner in which any compensation for acquisition by government of an invention may be paid;

(xiv) the manner in which the register of patent agents may be maintained <sup>4</sup>[under sub-section (1) of section 125 and the safeguards to be observed in the maintenance of such register of patent agents on computer floppies, diskettes or any other electronic form under sub-section (2) of that section;] the conduct of qualifying examinations for patent agents; and matters connected with their practice and conduct, including the taking of disciplinary proceedings against patent agents for misconduct;

(xv) the regulation of the making, printing, publishing and selling of indexes to, and abridgments of specifications and other documents in the patent office, and the inspection of indexes and abridgments and other documents;

(xiv) any other matter which has to be or may be prescribed.

(3) The power to make rules under this section shall be subject to condition of the rules being made after previous publication:

<sup>5</sup>[PROVIDEO that the Central Government may, if it is satisfied that circumstances exist which render it practically not possible to comply with such condition of previous publication, dispense with such compliance.]

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1. Existing clauses (ia) and (ib) substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

2. Substituted for "advertised" by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

3. Substituted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

4. Inserted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

5. Inserted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

## Section 160. Rules to be placed before Parliament

Every rule made under this Act shall be laid, as soon as may be after it is made, before each House of Parliament while it is in session for a total period of thirty days which may be comprised in one session or in two or more successive sessions and, if before the expiry of the session immediately following the session or the successive sessions aforesaid both Houses agree that the rule should not be made, the rule shall thereafter have effect only in such modified form or be of no effect, as the case may be; so, however, that any such modification or annulment shall be without prejudice to the validity of anything previously done under that rule.

## Section 161. [xxx]

<sup>1</sup>[xxx]

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1. Omitted by Patents (Amdt.) Act, 2002, w.e.f. 20-5-2003 vide S.O. 561(E), dt. 20-5-2003.

### **Section 162. Repeal of Act 2 of 1911 insofar as it relates to patents and saving**

(1) The Indian Patents and Designs Act, 1911, in so far as it relates to patents, is hereby repealed, that is to say, the said Act shall be amended in the manner specified in the schedule.

<sup>1</sup>[x x x]

(4) The mention of particular matters in this section shall not prejudice the general application of the General Clauses Act, 1897, (10 of 1897) with respect to repeals.

(5) Notwithstanding anything contained in this Act, any suit for infringement of a patent or any proceeding for revocation of a patent, pending in any court at the commencement of this Act, may be continued and disposed of, as if this Act had not been passed.

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1. Sub-sections (2) & (3) omitted, *ibid*.

## Section 163. [xxx]

<sup>1</sup>[xxx]

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1. Existing section 163 omitted by the Patents (Amdt.) Act, 2005, w.e.f. 1-1-2005.

