INTRODUCTION

The importance of intellectual property in India is well established at all levels—statutory, administrative and judicial. India ratified the agreement establishing the World Trade Organization (WTO). This Agreement, inter-alia, contains an Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), which came into force from 1st January 1995. It lays down minimum standards for protection and enforcement of intellectual property rights in member countries, which are required to promote effective and adequate protection of intellectual property rights with a view to reducing distortions and impediments to international trade. The obligations under the TRIPS Agreement relate to provision of minimum standard of protection within the member countries’ legal systems and practices.

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

1856 The Act VI of 1856 on protection of inventions based on the British Patent Law of 1852. Certain exclusive privileges granted to inventors of new manufacturers for a period of 14 years.

1859 The Act modified as Act XV; Patent Monopolies called exclusive privileges (making, selling and using inventions in India and authorizing others to do so for 14 years from date of filing specification.

1872 The Patents and Designs Protection Act.

1883 The Protection of Inventions Act.

1888 Consolidated as The Inventions & Designs Act.

1911 The Indian Patents & Designs Act.


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 Act IX of 1857 subsequently repealed the Act since it had been enacted without the approval of the sovereign.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

The Act of 1859 provided protection for invention only and not for designs whereas; United Kingdom had been protecting designs from 1842 onwards. To remove this lacuna, the ‘Patterns and Designs Protection Act’ (Act XIII) was passed in 1872. This Act amended the 1859 Act to include any new and original pattern or design or the application of such pattern to any substance or article of manufacture within the meaning of ‘new manufacture’.

The Act XV of 1859 was further amended in 1883 by XVI of 1883 to introduce a provision to protect novelty of the invention, which prior to making application for their protection was disclosed in the Exhibitions of
India. A grace period of 6 months was provided for filing such applications after the date of the opening of such Exhibition.

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

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

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

The Committee submitted its interim report on 4th August, 1949 with recommendations for prevention of misuse or abuse of patent right in India and for amendments to sections 22, 23 & 23A of the Patents & Designs Act, 1911 on the lines of the United Kingdom Acts of 1919 and 1949. Based on the recommendation of the Committee, the 1911 Act was amended in 1950 (Act XXXII of 1950) in relation to working of inventions and compulsory licence/revocation.

In 1952, an amendment was made to provide compulsory licence in relation to patents in respect of food and medicines, insecticide, germicide or fungicide and a process for producing substance or any invention relating to surgical or curative devices, through Act LXX of 1952. The compulsory licence was also available on notification by the Central Government. Based on the recommendations of the Committee, a bill was introduced in the Parliament in 1953 (Bill No.59 of 1953). However, the bill lapsed on dissolution of the Lok Sabha.

In 1957, the Government of India appointed Justice N. Rajagopala Ayyangar Committee to examine the question of revision of the Patent Law and advise government accordingly. The report of the Committee, which comprised of two parts, was submitted in September 1959. The first part dealt with general aspects of the patent law and the second part gave detailed note on the several clauses of the lapsed bill of 1953. The first part also dealt
with evils of the patent system and solution with recommendations in regard to the law. The committee recommended retention of the patent system, despite its shortcomings. This report recommended major changes in the law, which formed the basis of the introduction of the Patents Bill, 1965. This bill was introduced in the Lok Sabha on 21st September 1965, which, however, lapsed.

In 1967, an amended bill was introduced which was referred to a Joint Parliamentary Committee and on the final recommendation of the Committee, the Patents Act, 1970 was passed. This Act repealed and replaced the 1911 Act so far as the patents law was concerned. However, the 1911 Act continued to be applicable to designs. Most of the provisions of the 1970 Act were brought into force on 20th April 1972 with the publication of the Patents Rules, 1972.

**SALIENT FEATURES OF THE PATENTS ACT 1970**

- Elaborate definition of invention.

- No product patents for substances intended for use as food, drugs and medicines including the product of chemical processes.

- Codifying certain inventions as non-patentable.

- Furnishing of information made mandatory for foreign application.

- Absolute novelty criteria adopted in case of publication.

- Grounds for opposition to the grant of a patent expanded.

- Certain categories exempted of prior publication, prior communication and prior use from anticipation.
• Provisions for secrecy of inventions relevant for defense purposes.

• Provisions for use of inventions for the purpose of Government or for research or instruction to pupils.

• Reduction in the term of patents relating to process in respect of substances capable of being used as food or as medicine or drugs.

• Grounds for revocation of a patent enlarged.

• Provision for non-working as ground for compulsory licences, licences of right, and revocation of patents.

• Additional powers to Central Government to use an invention for purposes of government including Government undertakings.

• Preventing the abuse of patent rights by making restrictive conditions in licence agreements/contract as void.

• Provisions for appeal to High Court on certain decisions of the Controller.

• Provisions for opening of branches of the Patent Office.

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

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

• Further codification of non-patentable inventions.
• Term of patent for all technology made as 20 years.
• Provisions for reversal of burden of proof in case of process patents.
• Provisions relating to compulsory licences to meet public health concerns.
• Licence of right provision deleted.
• Introduction of system of deferred examination.
• Publication of applications after 18 months from the date of filing made mandatory.
• Provisions for process patent for microorganisms.
• Appellate Board established.
• Provisions for parallel imports.
• Provision for exemption from infringement proceedings for use of a patented invention for obtaining regulatory approval for a product based on that patented invention.
• Provision relating to protection of biodiversity and traditional knowledge.
The third amendment to the Patents Act, 1970 was introduced through the Patents (Amendment) Ordinance, 2004 with effect from 1st January 2005. This Ordinance was later replaced by the Patents (Amendment) Act, 2005 (Act 15 of 2005) on 4th April 2005, which was brought into force from 1st January 2005.

**SALIENT FEATURES OF PATENTS (AMENDMENT) ACT 2005**

- Extension of product patents to all fields of technology including food, drugs, chemicals and microorganisms.
- Provisions relating to Exclusive Marketing Rights (EMRs) deleted.
- Introduced provisions relating to grant of compulsory licence for export of medicines to countries, which have insufficient or no manufacturing capacity to meet emergent public health situations.
- Modification in the provisions relating to opposition procedures with a view to streamlining the system by having both pre-grant and post-grant opposition in the Patent Office.
- Strengthened provisions relating to national security to guard against patenting abroad of dual use technologies.
- Rationalization of provisions relating to time-lines with a view to introduce flexibility and reduce the processing time for patent application.

**ADMINISTRATIVE STRUCTURE OF THE PATENT OFFICE**

Patent system in India is administered under the superintendence of the Controller General of Patents, Designs and Trademarks (CGPDTM). The Office of CGPDTM is a subordinate office of the Department of Industrial
Policy and Promotion, Ministry of Commerce and Industry and comprises the statutory offices of Patent Office, Trade Marks Registry and Geographical Indication Registry. The Controller General’s headquarters is located at Mumbai. There are four Patent Offices in India. The Head Office is at Kolkata and other Patent Offices are located at Chennai, Delhi and Mumbai. The CGPDTM delegates his powers regarding various procedures for patent grant to Senior Joint Controller of Patents & Designs, Joint Controllers of Patents & Designs, Deputy Controllers of Patents & Designs and Assistant Controllers of Patents & Designs. Examiners of Patents & Designs do examination of patent applications.

Organizational details with hierarchical position of Intellectual Property offices are given in Figure 1.
FIGURE 1
ORGANISATION CHART OF IP OFFICES

A hierarchical chart of the Patent Officers is presented in Figure 2.

**FIGURE 2**

**HIERARCHICAL CHART OF PATENT OFFICERS**

The Controller General of Patents, Designs and Trade Marks

↑

Senior Joint Controller of Patents and Designs

↑

Joint Controller of Patents and Designs

↑

Deputy Controller of Patents and Designs

↑

Assistant Controller of Patents and Designs

↑

Examiner of Patents and Designs

*Source: CGPDTM Annual Report 2007-2008*

There are four Patent Offices in India. Their place of location and territorial jurisdictions are presented in Table 3.1.
TABLE 3.1
PATENT OFFICES IN INDIA AND THEIR JURISDICTION

<table>
<thead>
<tr>
<th>Patent Office</th>
<th>Territorial Jurisdiction</th>
</tr>
</thead>
<tbody>
<tr>
<td>Mumbai</td>
<td>The States of Gujarat, Maharashtra, Madhya Pradesh, Goa, Chhattisgarh, the Union Territories of Daman &amp; Diu and Dadra &amp; Nagar Haveli.</td>
</tr>
<tr>
<td>Chennai</td>
<td>The States of Andhra Pradesh, Karnataka, Kerala, Tamil Nadu and the Union Territories of Pondicherry and Lakshdweep.</td>
</tr>
<tr>
<td>Kolkata</td>
<td>Rest of India.</td>
</tr>
</tbody>
</table>


Application for the patent has to be filed in the respective Patent Office. The territorial jurisdiction is decided based on whether any of the following occurrences falls within the territory:

a) Place of residence, domicile or business of the applicant.

b) Place from where the invention actually originated.

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

PATENT

A patent is granted for an invention. An invention is defined in section 2(1) (j) as “a new product or process involving an inventive step and capable of industrial application.”
The term "patent" originates from the Latin word patere which means "to lay open" (i.e. make available for public inspection) and the term letters patent, which originally denoted royal decrees granting exclusive rights to certain individuals or businesses.

A patent is a set of exclusive rights granted by a state to a patentee (the inventor or assignee) for a fixed period of time in exchange for the regulated, public disclosure of certain details of a device, method, process or composition of matter (substance) (known as an invention), which is new, inventive, and useful or industrially applicable.

A patent is basically a deal between an inventor and the government in which the inventor is given a short-term monopoly in return for allowing the invention to be made public to aid in the advancement of the general public’s knowledge.

The exclusive right granted to a patentee in most countries is the right to prevent or exclude others from making, using, selling, offering to sell or importing the claimed invention. The patentee may have to comply with other laws and regulations to make use of the claimed invention. So, for example, a pharmaceutical company may obtain a patent on a new drug but will be unable to market the drug without regulatory approval. The criteria for an invention to be patentable are novel, an inventive step and must be capable of industrial application.
Further, the invention should not fall under any of the categories of “Inventions Not Patentable” mentioned under sections (3) and (4) of the Patents Act, 1970.

**PATENTABLE INVENTION**

A new product or process, involving an inventive step and capable of being made or used in an industry is called as patentable invention. It means the invention to be patentable should be technical in nature and should meet the following criteria

(i) **Novelty:** The matter disclosed in the specification is not published in India or elsewhere before the date of filing of the patent application in India.

(ii) **Inventive Step:** The invention is not obvious to a person skilled in the art in the light of the prior publication/knowledge/document.

(iii) **Industrially applicable:** Invention should possess utility, so that it can be made or used in an industry.

**INVENTIONS NOT PATENTABLE**

The following are not inventions within the meaning of this Act

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

(b) An invention the primary or intended use or commercial exploitation of which could be contrary public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment.
(c) The mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substances occurring in nature; the mere discovery of a new form of a substance which does not result in the enhancement of a known efficacy of that substance or the mere discovery of a new property or new use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

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

(e) Mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way.

(f) Omitted.

(g) A method of agriculture or horticulture.

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

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

(j) A mathematical or business method or a computer program per se or algorithms.
(k) Literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions.

(l) A mere scheme or rule or method of performing mental act or method of playing game.

(m) A presentation of information.

(n) Topography of integrated circuits.

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

**TYPES OF PATENTS**

The different types of patents are provisional patents, utility patents, plant patents and design patents.

**PROVISIONAL PATENTS (PP)**

A provisional patent application (PPA) allows filing without a formal patent claim. It establishes a filing date for the applicant. So, if anyone has an idea, and if he does not have the time and resources needed for filing a patent, then he can go for a provisional patent. This will establish the date of application. Though the actual patent should not differ significantly from the provisional patent description.

**UTILITY PATENTS**

Utility patents are the most common types of patents. They are usually valid for twenty years.
PLANT PATENTS

Plant patents can be taken for the plant varieties, which have been asexually reproduced. These patents may include mutants, hybrids, seedlings, etc. They are also valid for 20 years.

DESIGN PATENTS

Design patents refer to new original ornamental design for an article to be manufactured.

TYPES OF PATENT APPLICATIONS

The following are the different types of applications filed for obtaining patent

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

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

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

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

An international application, made according to the Patent Cooperation Treaty designating India can enter national phase within 31 months from the priority date of international application or date of filing of international application whichever is earlier. Such an application filed before the Controller in the Indian Patent Office claiming the priority and international filing date is called PCT national phase application. Applicant can enter national phase with a request made in Form 1. The title, description, drawings, abstract and claims filed with the application shall be taken as the complete specification for the purposes of filing in India. The
filing date of the application shall be the international filing date accorded under the Patent Cooperation Treaty.

When an applicant feels that he has come across an invention which is a slight modification of the invention for which he has already applied for/ or has patent, the applicant can go for patent of addition since the invention does not involve a substantial inventive step. It is also possible to convert an independent patent to a patent of addition at a later date if the subject matter was an improvement in or modification to a main invention for which he holds a patent. There is no need to pay separate renewal fee for the patent of addition during the term of the main patent. A patent of addition expires along with the main patent.

INTERNATIONAL SEARCH

The International Searching Authority establishes International Search report. For Indian applicant following are the Competent International Searching Authorities (ISAs).

- Austrian Patent Office (AT);
- Australian Patent Office (AU);
- European Patent Office (EP);
- China Intellectual Property Office (CN);
- United States Patent & Trademark Office (USPTO);
- Swedish Patent Office (SE);

If the International Application does not claim any priority, the international search report is normally available within nine months from the
international filing date. If priority is claimed, that report is available usually by the 16th month from the priority date. Even where priority is claimed, the international search report is normally available in time before publication of the International Application. This allows time for the applicant to withdraw the application before publication, if desired.

Indian Patent Office has been recognized as an International Searching Authority (ISA) and an International Preliminary Examination Authority (IPEA) at the meeting of the General Assemblies of WIPO held in September – October 2007. After the Patent Office commenced its operation as an ISA and an IPEA the office issued the international search and examination reports of the international applications filed in the Patent Office.

INTERNATIONAL TREATIES

India is a member-state of World Intellectual Property Organization (WIPO), an International Organization, responsible for the promotion of the protection of intellectual property throughout the world. India is a member of the following International Organizations and Treaties in respect of Patents:


c) Paris Convention for the protection of Industrial Property with effect from 7th December 1998.
e) Budapest Treaty with effect from 17th December 2001.

**THE PATENT PROCESS**

The patent process is generally very long, taking one to two years before an application is finally approved. During this period, the application generally travels back and forth between the applicant and the patent examiner until both sides agree as to which part of the invention is worthy of a patent. During this time, the claims may be amended or changed.

Once an agreement between the applicant and the examiner is reached, the Patent and Trademark Office approves the application and writes a brief description in a publication entitled the Official Gazette inviting opposition.

**PRE-GRANT OPPOSITION**

Grounds for Pre-grant Opposition by way of Representation u/s 25(1) are as follows: a) Wrongfully obtaining; b) Prior publication / prior claiming; c) Prior claiming in India; d) Prior public knowledge or public use in India; e) Obviousness and lack of inventive step; f) Not an invention or the invention not patentable; g) Insufficient description of the invention; h) Failure to disclose information, or furnishing false information relating to foreign filing; i) Convention application not filed within the prescribed time; j) Incorrect mention of source/geographical origin of biological material; k) Invention anticipated with regard to traditional knowledge of any community, anywhere in the world.
No ground other than the statutory grounds can be taken for opposing the Grant of Patent under section 25(1). The procedure for pre–grant opposition is shown in Figure 3.

**FIGURE 3**

**PROCEDURE FOR OPPOSITION U/S 25(1)**


**GRANT OF PATENT** (Section 43)

The patent is granted when the applicant for patent puts the application in order for grant under Section 21 of the Act and when there is no pre-grant representation within a period of six months from the date of publication and before the grant of patent or when the pre-grant opposition has been disposed of in favour of the applicant. After a patent is granted in respect of applications made under section 5(2) of the repealed Act, the patent holder is entitled to receive reasonable royalty from such enterprises which have made significant investment and were producing and marketing the product prior to 1st January 2005 and who continues to manufacture the product covered by the patent on the date of grant of the patent.
Procedure for the grant of patent is shown in Figure 4.

FIGURE 4

**FORM OF PATENT** (Rule 74)

A patent shall be in the form as specified in the Third Schedule with such modifications as the circumstances of each case may require and shall bear the number accorded to the application under rule 37.

The patent certificate shall ordinarily be issued within seven days from the date of grant of patent under section 43.

**DATE OF PATENT** (Section 45)

(1) Subject to the other provisions contained in this Act, every patent shall be dated as of the date on which the application for patent was filed. (2) The date of every patent shall be entered in the register. (3) Notwithstanding anything contained in this section, no suit or other proceeding shall be commenced or prosecuted in respect of an infringement committed before the date of publication of the application.

**EXTENT AND EFFECT OF PATENT** (Section 46)

(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.

Grounds for Post-grant Opposition u/s 25(2) are same as of the grounds in Pre-grant Opposition. The procedure for post – grant opposition is shown in Figure 5.
FIGURE 5
PROCEDURE FOR OPPOSITION U/S 25(2)

Grant → Notification → Notice of opposition and evidence → Reply evidence by opposition
→ Reply statement and evidence by applicant → Constitution of opposition Board →
Appointment of hearing → Hearing → Decision


AMENDMENT OF PATENT GRANTED TO DECEASED APPLICANT. (Section 44)

Where, at any time after a patent has been granted in pursuance of an application under this Act, the Controller is satisfied that the person to whom the patent was granted had died, or, in the case of a body corporate, had ceased to exist, before the patent was granted, the Controller may amend the patent by substituting for the name of that person, the name of the person to whom the patent ought to have been granted, and the patent shall have effect, and shall be deemed always to have had effect, accordingly.
INSPECTION OF DOCUMENTS RELATED TO GRANT OF
PATENT – (Rule 74A)

After the date of publication of a grant of a patent, the application
together with the complete specification and provisional specification, if
ey any, the drawing if any, abstract and other documents related thereto may be
inspected at the appropriate office by making a written request to the
Controller and on payment of fee and may obtain copies on payment of fee
specified in the First Schedule.

TERM OF PATENT (section 53)

The term of Patent is 20 years from the date of the application in
respect of all the patents including those for which the term had not expired
on 20th May 2003, when Patents (Amendment) Act 2002 came into force;
provided that the renewal fee is paid every year before the due date or within
the extended period (maximum six months).

In order to keep the patent in force, renewal fee as prescribed in the
First Schedule need to be paid before the expiration of the second year from
the date of patent and subsequently, before the expiration of the succeeding
year. The annual fee payable in respect of two or more years may be paid in
advance.

The section 53, in general govern the term of patent and renewal fee,
whereas the renewal fee, which has become due at the time of grant of patent,
is governed by section 142(4). When the patent is granted later than two years
from the date of filing of the application, the fee that has become due in the
meantime might be paid within three months from the date of
recording of the patent in the Register or within the extended period not later
than nine months from the date of recording. In the cases where the renewal
fee, which has become due at the time of grant and that which has become due
after the grant are very close, they may be paid together along with required
extension under section 53.

RESTORATION OF PATENT

When a patent has ceased to have effect under Section 53(2), because
of nonpayment of renewal fees within the prescribed period, the patent and
any specified patent of addition thereto, may be restored provided that the
application is made without undue delay, and within eighteen months from
the date on which it has ceased, and that the failure to pay the renewal fee
was unintentional. This eighteen-month period shall be reckoned from the
date of cessation, but no extension shall be allowed. The application must be
made by patentee or his legal representative on Form -15 and accompanied by
supporting evidence. Any patent of addition, which is to be restored, if
applicable should be specified. A separate Form -15 is required for each main
patent, but no fee is payable in respect of any patent of addition thereto.

Where a patent is assigned before it ceased, the assignee may make the
application only when the assignment has been registered, similarly, if a
patent was granted to a deceased person, action under Section 44 should be
completed before action for restoration is begun.
PATENT INFRINGEMENT

A patent is said to be infringed when a person or an entity makes, uses, offers to sell, or sells a patent without the authority of the patent owner. Patent infringement can happen in one of four ways – literal infringement, infringement under something called the doctrine of equivalents, inducement of infringement, and contributory infringement.

If the patent holder’s suit is successful, the court will either force the infringer to stop using the patent, or work out an agreement whereby the infringer pays royalties to the patent holder. However, patent suits are often tricky, because the alleged infringer might succeed in proving the PTO mistakenly granted the patent in the first place.

When a patent is infringed upon meaning that, for example, another party violated the exclusivity of the patent and developed the same drug the inventor will typically seek monetary compensation through a civil lawsuit and an injunction prohibiting the defendant from future infringement. In return, the accused may seek to have the patent declared invalid. Often, such disputes are resolved or avoided by entering into licensing or cross-licensing agreements, allowing each party to properly gain access to the other party’s patents.

ACTION AGAINST INFRINGEMENT

If at any time the patentee finds that somebody is infringing his patent rights he should inform in writing that his patent rights are being infringed by his commercial working of the same or related invention. The two parties
can amicably settle the problem by licensing etc. But if such settlement by
way of arbitration etc. could not be made and the infringement continued, the
patentee can sue the infringer.

The Indian Limitations Act governs the period of limitation for
bringing a suit for infringement of patent, which is three years from the date
of infringement. The limitation period for the suit, therefore, runs from the
date of infringing act and not from the date of the grant.

**REVERSAL OF BURDEN OF PROOF IN CERTAIN CASES**

In any suit for infringement of a patent, where the subject matter of
the patent is a process for obtaining a new product or there is substantial
likelihood that the identical product is made by the patented process and the
patentee could not establish through reasonable efforts to determine the
process actually used by the infringer, the court may direct the defendant to
prove that the process used by him to obtain the product, identical to the
product of the patented process, is different from the patented process,
provided that the Patentee or a person deriving title or interest in the patent
from him, first proves that the product is identical to the product directly
obtained by the patented process. In considering whether a party has
discharged the burden imposed upon him by sub-section the Court shall not
require, him to disclose any manufacturing or commercial secrets, if it appears
to the court that it would be unreasonable to do so. In a suit for infringement
under Sec. 104, the defendant of counter-claim for revocation of a Patent
may revoke a Patent without any separate petition for revocation.
SURRENDER AND REVOCATION OF PATENTS

The patentee may at any time offer to surrender his patent through an application in the prescribed format. On receipt of such an offer the Controller will publish the offer in the Official journal and also notify every person other than the Patentee whose name appears in the register as having an interest in the Patent. The three months period of opposition to the surrender of Patent will be counted from that date.

FILING OF NOTICE OF OPPOSITION

Any interested person may give notice of opposition to the surrender of Patent in Form 14 in duplicate within 3 months from the date of publication of the notice in the Official journal with the prescribed fee. The Controller shall inform the Patentee on receipt of such notice.

The procedure relating to filing of written statement, reply statement leaving evidence and hearing of the opposition under section 63 is similar to that of the opposition to the grant of Patents as specified in Rules 57 to 63. The Controller on receipt of the evidence, if any, and after giving the parties an opportunity to be heard, decide the case. In case, the Controller accepts the Patentee's offer to surrender the patent, he may direct the Patentee to surrender the patent and on the receipt of which, he shall by order, revoke it and notify such revocation in the Official journal. Any order, decision or direction of the Controller under section 63 is appealable in Appellate Board.
A Patent, whether granted before or after the commencement of the Patent (Amendments) Act 2005, may be revoked on any of the grounds stated hereinafter, at any time during the life of the patent, (i) By the High Court - on a counter-claim for revocation of the patent made by the defendant in a suit for infringement; (ii) By the Appellate Board - on the petition of any person interested or of the Central Government; (iii) By the Central Government – revocation of the patent in public interest; (iv) By the High Court – on petition of the Central Government for failure to comply with the request of the Central government to make, use or exercise the patented invention for the purpose of the central government; (v) By the Controller of Patent – revocation for non-working of the patent; (vi) By the Controller of Patent – revocation of patents related to atomic energy on direction from the Central government subject to the provisions contained in the Act.

GROUNDS OF REVOCATION

(a) The invention claimed is the subject of a patent already granted in India prior to the claimed invention - prior claiming; (b) Patentee not entitled to the patent; (c) Patent was wrongfully obtained by a person other than the person entitled: When a patent has been wrongfully obtained by any person, the person entitled to apply for a patent may file a petition under this subsection for revocation. This Petitioner however must be a person entitled to apply for the patent; (d) Subject of a claim is not an invention: If the Patent granted does not satisfy the provision of Sec 2(1) (j) it may be revoked under
this sub section; (e) Invention is lacking in novelty with regard to prior knowledge or prior use; (f) Invention is obvious or does not involve inventive step having regard to prior knowledge or prior use; (g) Invention is not useful; (h) The complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed; (i) Claims are not clearly and sufficiently defined in scope and not fairly based on the matter disclosed in the specification; (j) Patent was obtained by false suggestion or representation; (k) Subject matter of claims is not a patentable invention; (l) Claimed invention was secretly used before the priority date; (m) Failure to disclose information regarding Foreign Application; (n) Non-compliance of secrecy direction and filing outside India without prior permission; (o) Leave to Amendment of specification obtained by fraud; (p) Specification Wrongly Mentioning or Not Disclosing Geographical Origin (q) Inventions is Anticipated by traditional knowledge.

REGISTER OF PATENTS

A Register of Patents is an important document which is kept and maintained at the Patent Office at each location under the control and management of the Controller and contains all details about the patentee and patent right including the details of transfer of the right. It is regularly updated in order to incorporate the changes in respect of patent right.

(a) Upon grant of a patent, the Controller shall enter the following in the register of patents.
(b) The names, addresses and nationality of the patentee, title of the invention including the categories to which the invention relates, date of the patent and date of granting thereof and address for service of the patentee.

(c) The Controller shall also enter in the register of Patents, particulars regarding proceedings under the Act before the Controller or in the courts in respect of every patent.

(d) The following notifications shall also be entered in the Register of Patents, namely: (i) Assignment and transmission of patents, (ii) License, mortgage etc. under patents, (iii) Amendments, extensions and revocation of patents, (iv) Cessation of patents, (v) Restoration of lapsed patents, (vi) Surrender of patents, (vii) Compulsory licenses and (viii) all other matters regarding validity and proprietorship of patents.

(e) The details of payment of the prescribed renewal fee shall be entered in the register of patents upon issue of a certificate of the same that the fee has been paid and the date of payment of such fee as stated in certificate.

(f) No notice of any trust, whether express, implied or constructive shall be entered in the Register.

The Register of Patents or any part thereof can be kept in computer floppies, diskettes or any other electronic form subject to the prescribed safeguards. Maintenance, access to the Register, entry in the Register and alteration or rectification in respect of entries shall be made only by the authorized person.
ALTERATION OF ADDRESS

A patentee may make a request in writing along with the prescribed fees as given in the First Schedule to the Controller for alteration of his name, nationality, address or address for service as entered in the register of patents in respect of any patent granted to him.

PROCEDURES RELATED TO ENTRY IN REGISTER

(i) Assignments, share in patent, a mortgage, license or the creation of any other interest in a patent not to be valid unless it is in writing.

(ii) An application for registration of his title or interest by virtue of assignment/transmission of patent or share in patent shall be made by

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

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

(iii) Any person becoming entitled to a patent by virtue of assignment, mortgage, license or other instrument may be made by the assignor, mortgagor, licensor or other related party may apply for registration in Form 16 with the prescribed fee.

(iv) An application for entry in the register of patents of the notification of any other document purporting to affect the proprietorship of the patent by the person benefiting under the document also shall be made in Form 16 with prescribed fee.
(v) Presentation of assignment of patent, etc. to the Controller: Every assignment and every other document giving effect to or being evidence of the transfer of a patent or affecting the proprietorship thereof or creating an interest therein as claimed in such application which shall be accompanied by two copies of the assignment or other document certified to be true by the applicant or his agent and the Controller may call for such other proof of title or written consent as he may require.

(vi) Registration of title or interest in a patent: After the receipt of an application under sub-section (1) or sub-section (2) of section 69, the Controller shall register the title of the person concerned or his interest in a patent, as the case may be and an entry in the following form shall be made in the register, namely- “In pursuance of an application received on the Proprietor-Assignment Registered as licensee by virtue of license, mortgage deed, etc. dated and made between of the one part and of the other part”.

CERTIFIED COPIES OF ENTRY IN REGISTER

Upon request along with the prescribed fees, the patent office shall supply the certified copies of any entry in the register, or certificates of, or extracts from patents, specifications and other public documents in the patent office, or from registers and other records including records in computer floppies, diskettes or any other electronic form.

RECTIFICATION OF REGISTER BY APPELLATE BOARD

The Appellate Board may make rectification in the register, on the application of any person aggrieved
(a) By the absence or omission from the register of any entry; or
(b) By any entry made in the register without sufficient cause; or
(c) By any entry wrongly remaining on the register; or
(d) By any error or defect in any entry in the register, make such order for
the making, variation or deletion, of any entry therein as it may think fit.

REGISTER TO BE OPEN FOR INSPECTION

(i) The Register of Patent will be open to inspection by the public at
all convenient times; and certified copies sealed with the seal of the Patent
Office, of any entry in the register, will be given to any person requiring
them on payment of the prescribed fee as given in the First Schedule.

(ii) If the record or particulars are kept in computer floppies or
diskettes or in any other electronic form, the public will be given access to
such computer floppies, diskettes or any other electronic form or printouts of
such record of particulars for inspection on payment of the prescribed fee.

POWERS OF CONTROLLER

The Controller of Patents is conferred with various statutory powers
for discharging his functions under the statute. The Controller has certain
powers of the Civil Court in respect of some matters specified under section
77. For the purpose of opposition to grant of Patent, whether pre-grant or
post-grant, the Controller is vested with some powers of the Court. As the
Controller is the quasi-judiciary (Tribunal) Authority, the Controller is
conferred with powers of a Civil Court while trying a suit under the Code of
Civil Procedure in respect of the following matters.
(a) Summoning and enforcing the attendance of any person and examine him on oath, (b) Requiring the discovery and production of any document, (c) Receiving evidence on affidavits, (d) Issuing commissions for the examination of witnesses or documents, (e) Awarding costs: any order for costs awarded by the Controller in exercise of the powers conferred upon him by this section shall be executable as a decree of a civil court, (f) Reviewing own decision.

The application should be made to the Controller on Form 24 along with the prescribed fee within one month from the date of communication of such decision. Sufficient grounds should accompany the Form 24, while making request to the Controller to review the decision. Extension of time is allowed for further period of one month when a request is made therefore by filing form 4 with the prescribed fee.

Some more powers vested with the controller are to correct clerical errors, taking the evidences, exercise his discretionary powers, disposal of applications for extension of time.

**WORKING OF PATENTED INVENTION**

Patents are granted for the purpose of encouraging inventions, which will enhance industrial development and, therefore, should be worked in its fullest extent within the territory of India. Section 83 of the Patents Act clearly mentions that the patents are granted to encourage inventions and to secure that the inventions are worked in India on a commercial scale and to the fullest extent reasonably practicable without undue delay.
The Controller has the power to call for the information such as periodical statements as to the extent to which the patented invention has been commercially worked in India, as may be specified in the notice issued to that effect at any time during the continuance of the patent.

A patentee or a licensee should furnish such information to him within two months from the date of such notice or within such further time as the Controller may allow. The patentee and every licensee should furnish the details of working of the invention in Form 27 in respect of every calendar year within three months of the end of each year and within two months whenever required by the Controller. Failure to supply such information under section 146 is punishable with fine, which may extend to ten lakh rupees.

COMPULSORY LICENCES

Compulsory licences are available as a remedy against abuse of patent right, not working of patent and to address the public health concern in India. The provisions for compulsory licences are made to prevent the abuse of patent as a monopoly and to make the way for commercial exploitation of the patented invention by an interested person. Any person interested can make an application to the Controller for grant of compulsory licence for a patent after three years from the “date of grant” of that patent. Time lines for compulsory licence are shown in figure 6.
### FIGURE 6

**TIME LINES FOR COMPULSORY LICENSES**

<table>
<thead>
<tr>
<th>Section</th>
<th>Application</th>
<th>Application / prima facie case</th>
<th>Notification of filing of application by Controller</th>
<th>Opposition within 2 months from notification</th>
<th>Hearing &amp; decision</th>
<th>Total time</th>
</tr>
</thead>
<tbody>
<tr>
<td>84</td>
<td>3 years after grant</td>
<td></td>
<td></td>
<td></td>
<td></td>
<td>4 months</td>
</tr>
<tr>
<td></td>
<td>Processing time</td>
<td>1 month</td>
<td>10 days</td>
<td>2 months</td>
<td>1 month</td>
<td></td>
</tr>
<tr>
<td>92</td>
<td>Any time after grant</td>
<td>Of availability of Patent for Compulsory Licence by Central Government</td>
<td>92(1) (i) &amp; (ii) within 2 months (Rule 98) from notification for settlement of terms &amp; conditions</td>
<td></td>
<td>3 months</td>
<td></td>
</tr>
<tr>
<td></td>
<td>Processing time</td>
<td>0</td>
<td>2 months</td>
<td>1 month</td>
<td></td>
<td></td>
</tr>
<tr>
<td>92(3)</td>
<td></td>
<td>No opposition</td>
<td>No hearing</td>
<td></td>
<td></td>
<td></td>
</tr>
<tr>
<td></td>
<td>Processing time</td>
<td>0</td>
<td></td>
<td>10 days</td>
<td></td>
<td></td>
</tr>
<tr>
<td>92(A)</td>
<td>Any time after grant</td>
<td>0</td>
<td>-</td>
<td>7 days</td>
<td>7 days</td>
<td></td>
</tr>
</tbody>
</table>

GROUND FOR GRANT OF COMPULSORY LICENCE

(i) The reasonable requirements of the public with respect to the patented invention have not been satisfied, (ii) The patented invention is not available to the public at a reasonably affordable price, (iii) The patented invention, is not worked in the territory of India.

(1) The Controller, if satisfied that any of the grounds exists to grant compulsory licence, may grant a license  upon such terms as he may deem fit, (2) The provision for compulsory licensing serves a very useful purpose to meet the public requirement by virtue of arising of any of the above conditions set for compulsory licensing, (3) Failure to make patented inventions available to public at a reasonable price has to be considered keeping in mind that the reasonable price for a patented article will depend upon the circumstances of each case, (4) Failure to work the patented invention within the territory of India will be considered with respect to the facility available in India for the working of the invention. Provision of importation of patented article is allowed. But the mere importation of patented articles when there is a possibility of manufacturing within India will be a factor that will receive consideration, (5) Reasonable requirements of the public will be deemed as not satisfied if by reason of the refusal of the patentee to grant a licence on reasonable terms, an existing trade or industry or the development thereof or the establishment of any new trade or industry in India or the trade or industry of any person or class of persons trading or manufacturing in India is prejudiced.
USE OF PATENT FOR THE PURPOSE OF GOVERNMENT

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

If an invention is used before the priority date of the relevant claim of complete specification by the Government or any person authorized by it for the purpose of Government, then no royalty or remuneration need to be paid to the patentee.

If an invention is to be used at any time after the grant of patent by the Government or any person authorized by it for the purpose of Government, then that use should be made only on terms agreed between the Government and any person authorized and the patentee or in default of agreement will be decided by High Court.

The Government can authorize any person in respect of an invention either before or after the grant, whether or not the patentee authorizes that person. Where the Government authorizes any person for using an invention for Government purposes then, unless it is contrary to the public interest, the Central Government shall inform the patentee from time to time, the extent of use of the invention for the purpose of Government. In case of use by a Government undertaking, then the Government may call for such information from the undertaking.
APPELLATE BOARD

An Appellate board, established under the Section 83 of the Trade Marks Act, 1999, is the appellate board for deciding appeals to the decision of the Controller and other related matters on patents. The Board has been constituted for speeding up legal proceedings in respect of decisions of the Controller by reducing time required in the proceedings before High Courts in the same matters. The Appellate board consists of Chairman, Technical Members and other staff.

APPEAL PROCEDURE

Every appeal on the decision of the Controller under relevant sections as mentioned should be in the prescribed form accompanied by the certified copy of the decision, order and direction appealed against along with the fees that prescribed by the Board.

Every appeal to the Board should be made within three months from the date of the decision, order or direction of the Controller or of the Central Government, as the case may be or within such further time as the Appellate Board may in accordance with the rules made by it allow.

An appeal can be made in respect of the decisions of the Controller under Sections. 15, 16, 17, 18, 19, 20, 25(4), 28, 51, 54, 57, 60, 61, 63, 66, 69(3), 78, 84(1) to 84(5), 85, 88, 91, 92 and 94.

The orders passed by Central Government in relation to inventions relevant to defence purpose and orders of Controller giving direction of secrecy in respect of such inventions under Section 35 and revocation of
Patents by the Controller under Section 65, or by the Central Government under Section 66, are not appealable. No appeal lies from an order of the Controller granting extension of time under any provision of the Act or of the rules.

Appearance of Controller in legal Proceeding: The Controller shall have the right to appear and be heard in (a) The cases in which relief for alteration or rectification of register has been sought, (b) The cases involving issues pertaining to practice of Patent Office, (c) In any appeal to the Appellate Board from an order of the Controller on an application for grant to a patent.

**PENALTIES**

The Patents Act, 1970 provides civil penalties for various offences under the purview of the Act. If any person fails to comply with any direction given under section 35, that is, related to secrecy directions relating to inventions relevant to defence purpose or files an application in contravention of section 39 which requires that an applicant shall obtain prior permission from the Controller to apply for a patent outside India, he shall be punishable with imprisonment for a term up to 2 years or with fine or with both.

**FALSIFICATION OF ENTRIES IN REGISTER ETC**

If any person makes a false entry in any register kept under the Patents Act or provides any writing or evidence as a result of which the
entry in the register results into a false entry, then he is punishable with imprisonment for a term that may extend to 2 years or with fine or with both.

**UNAUTHORIZED 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 that may extend to rupees one lakh. The use of words 'Patent', 'Patented', 'Patent applied for', 'Patent pending', without mentioning the name of the country means that they are patented in India or patent applied for in India and attract the provisions of this section.

**WRONGFUL USE OF WORDS, "PATENT OFFICE"**

If any person uses on his place of business or any document issued by him which would reasonably lead to the belief that either his place of business is the patent office or is officially connected with the patent office, he shall be punishable with imprisonment for a term that may extend to 6 months or with fine or with both.

**REFUSAL OR FAILURE TO SUPPLY INFORMATION**

If any person refuses or fails to furnish information as required under sections 100(5) and 146 he shall be punishable with fine which may go up to rupees one lakh. Section 100(5) provides that any person including Government undertaking using a patented invention for the purpose of Government has to furnish any information on the use of invention as required by the Central Government and section146 provides that the patentee has to furnish a statement regarding the working of the patented invention in a commercial scale in India in form 27. This has to be done
annually within 3 months of the end of each year. If he furnishes false information knowingly he shall be punishable with imprisonment that may extend to 6 months or with fine or with both.

**PRACTICE BY NON-REGISTERED PATENT AGENTS**

Any person practicing as a patent agent without registering himself as such is liable to be punished with a fine of rupees one lakh for the first offence and rupees five lakhs for subsequent offence.

**OFFENCES BY COMPANIES**

When an offence is committed by a company, the company as well as every person such as director, manager, secretary, in charge of, and responsible to the company for the conduct of its business at the time of the commission of the offence, shall be deemed to be guilty and shall be liable to be proceeded against and punished accordingly. The punishment will not be applicable if such person that may include director including partner, manager, secretary, proves that the offence was committed without his knowledge or he has taken due care to prevent the offence.