



INTELLECTUAL PROPERTY INDIA
PATENTS | DESIGNS | TRADEMARKS |
GEOGRAPHICAL INDICATIONS

MANUAL
OF
PATENT PRACTICE AND PROCEDURE
THE PATENT OFFICE, INDIA



Intellectual Property Office, Mumbai



Intellectual Property Office, Delhi



Intellectual Property Office, Chennai



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Manual of Patent Practice & Procedure

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PREFACE

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

The format of the Manual is to reproduce successive sections and relevant rules of the Patents Act and Patents Rules followed by explanation and past decisions of the Patent Office, wherever available. References to decisions of the courts of India and other countries have been included to provide guidance and help the users.

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

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

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

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CHAPTER I

Introduction

The Patent System in India

1.1 A patent is granted as an exclusive right by the Government for an invention, for a limited period of time in consideration of disclosure of the invention by an applicant. A patentee enjoys exclusive right to prevent the third party from 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, by non-payment of any renewal fee.

1.2 History of Indian Patent System

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

1.2.2 In 1872, the Act of 1859 was revisited to provide protection relating to designs. It was renamed as “The Patterns and Designs Protection Act” under Act XIII of 1872. The Act of 1872 was amended in 1883 (XVI of 1883) to introduce a provision to protect novelty of the invention, which prior to making application for their protection were disclosed in the **Exhibition of India (?)**. A grace period of 6 months was provided for filing such applications after the date of the opening of such Exhibition.

1.2.3 This Act remained in force for about 30 years without any change but in the year 1883, certain modifications in the patent law were made in United Kingdom (UK) and it was considered that those modifications should also be incorporated in the Indian law. 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 U.K. law. The modifications introduced in the Indian law, by Act V of 1888, over the UK legislation, *inter alia*, includes:

- Shifting of authority to administer the Act from the Home department to Secretary to Government of India;

- Extension of the jurisdiction of the Act to other courts apart from High Courts of Madras, Calcutta and Bombay;
- Reduction in the fee;
- Provision for detailed disclosure of the invention, including best mode of working the invention in full clear, concise and exact terms so as to enable any person skilled in the art or science to make use of the invention;
- Provision of powers to call for a model of the invention;
- Change of time for filing petition in respect of patent granted in United Kingdom from 12 months from the 'letters patent' to 12 months from the 'date of sealing';
- Extension of term of exclusive privileges to -----
- Provision for granting compulsory licence where invention is not made accessible to public, on reasonable terms;
- Appointment of Agents to encourage filing by foreign inventor;
- Introduction of provision for protection of new or original design;
- Provision for counting the grace period for filing application for invention displayed in the Exhibition from the date of admission of the invention into the Exhibition instead of the date of the opening of the Exhibition.

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

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

- a) to survey and report on the working of the patent system in India;
- b) to examine the existing patent legislation in India and to make recommendations for improving it, particularly with reference to the provisions concerned with the prevention of abuse of patent rights;
- c) to consider whether any special restrictions should be imposed on patent regarding food and medicine;
- d) to suggest steps for ensuring effective publicity to the patent system and to patent literature, particularly as regards patents obtained by Indian inventors;
- e) to consider the necessity and feasibility of setting up a National Patents Trust;

- f) to consider the desirability or otherwise of regulating the profession of patent agents
- g) to examine the working of the Patent Office and the services rendered by it to the public and make suitable recommendations for improvement; and
- h) to report generally on any improvement that the Committee thinks fit to recommend for enabling the Indian Patent System to be more conducive to national interest by encouraging invention and the commercial development and use of inventions.

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

- (a) Any interested person may apply for a compulsory licence or revocation of the patent on any of the following grounds, namely—
 - (i) patented invention, being capable of being commercially worked in India, is not being commercially worked therein to the fullest possible extent;
 - (ii) demand for the patented article in India is not being met to an adequate extent or on reasonable terms;
 - (iii) commercial working of the invention in India is being prevented or hindered by the importation of the patented articles; and
 - (iv) the refusal of the patentee to grant a licence or licences on reasonable terms, whereby the commercial or industrial activities in India are prevented or hindered;
- (b) for obtaining relief against abuse of patent rights, an application can be made to the Controller of Patents and Designs any time after the sealing of the patent and the order of the Controller to be appealable before the appellate authority which should be an ad-hoc Special Tribunal nominated by the Central Government consisting of –
 - (i) a sitting or retired judge of a High Court (as the President),
 - (ii) a barrister or advocate of not less than ten years standing, preferably conversant with patent law and procedure, and
 - (iii) a technical expert in the particular subject with which the patent in question is concerned.

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

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

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

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

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

1.2.9 In 1957, the Government of India appointed Justice N. Rajagopala Ayyangar Committee to examine the question of revision of the Patent Law and advise government accordingly. The report of the Committee, which comprised of two parts, was submitted in September, 1959. The first part dealt with general aspects of the patent law and the second part gave detailed note on the several clauses of the lapsed bill of 1953. The first part also dealt with evils of the patent system and solution with recommendations in regards 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 publication of the Patent Rules, 1972.

1.2.10 The salient features of the Patents Act 1970 are--

- Elaborated definition of invention

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

1.2.11 This Act remained in force for about 24 years without any change till December 1994. 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 31-12-2004. Meanwhile, the applicants could be allowed Exclusive Marketing Rights (EMR) to sell or distribute these products in India, subject to fulfilment of certain conditions.

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

- Further codification of non patentable inventions
- 20 years term of patent for all technology
- Provision for reversal of burden of proof in case of process patents
- Provisions of compulsory licences to meet public health concerns
- Deletion of provision of licence of right
- Introduction of system of deferred examination
- Mandatory publication of applications after 18 months from the date of filing
- Provision for process patent for micro organisms
- Establishment of Appellate Board
- Provision for parallel imports

- Provision for exemption from infringement proceedings for use of a patented invention for obtaining regulatory approval for a product based on that patented invention
- Provision to protect biodiversity and traditional knowledge.

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

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

1.3 Patents Rules

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

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

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

1.4 Administrative Structure of the Patent Office

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

CHAPTER - II

PREAMBLE AND DEFINITIONS

2.1 The Patents Act, 1970 (39 of 1970)

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

- 2.1.1** The Patents Act was enacted by the Government of India in the year 1970 in pursuance of its powers under Entry 49 of the List I of Schedule VII of the Constitution of India. List I contains the list of the items in the Union List and Entry 49 reads, “Patents, inventions and designs; copyright; trade-marks and merchandise marks.” The Act was notified on 19th September 1970 as Act 39 of 1970.
- 2.1.2** The word ‘amend’ is used to indicate the fact that patent law was in existence before the enactment of the Patents Act, 1970. The history of patent legislations in India is given in Chapter-I. Enactment of a new legislation while repealing the previous legislations does not de-legitimise the patents granted and other action taken under the previous law [see section 162(3) and (5)].
- 2.1.3** In the statement of objects and reasons of the Patent Bill, 1970, it is stated, “a need for a comprehensive law so as to ensure more effectively that patent rights are not worked to the detriment of the consumer or to the prejudice of trade or the industrial development of the country was felt as early as 1948”. This gives fair indication to the intention of the Act. The patents law is also kept in line with the “development of technological capability in India, coupled with the need for integrating the Intellectual Property system with international practices and intellectual property regimes,” as stated in the statement of objects and reasons of the Patents (Second Amendment) Bill, 1999. “The object of the patent law is to encourage scientific research, new technology and industrial progress. Grant of exclusive privilege to own, use or sell the method or the product patented for the limited period, stimulates new inventions of commercial utility. The price of the grant of the monopoly is the disclosure of the invention at the Patent Office, which after the expiry of the fixed period of the monopoly passes into public domain.” [Bishwanath Prasad Radhey Shyam vs. H.M. Industries A.I.R. 1982 S.C. 1444 at paragraph 17].

2.2 Section 1 : Short title, extent and commencement.—

- (1) *This Act may be called the Patents Act, 1970.*
- (2) *It extends to the whole of India.*
- (3) *It shall come into force on such date as the Central Government may, by notification in the Official Gazette, appoint
Provided that different dates may be appointed for different provisions of this Act, and any reference in any such provision to*

the commencement of this Act shall be construed as a reference to the coming into force of that provision.

- 2.2.1** The applicability of the Patents Act extends to the whole of India. A patent granted as per the Act can only be enforced in the territorial limits of India, subject to the provisions of section 49 of the Act. Patents granted as per this Act only are valid in India.
- 2.2.2** Proviso to sub section 3 enables the Government to bring into force different provisions of the Act at different times. For instance, provisions relating to Appellate Board *vide* sections 116-117H were brought into force from 2nd April, 2007 although other provisions had been brought into force earlier. The Patent Office is required to act under the provisions of a particular section only from the date those provisions are brought into force.

2.3 Definitions

Section 2. Definitions and interpretation.—

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

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

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

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

(aba) "Budapest Treaty" means the Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the purposes of Patent Procedure done at Budapest on 28th day of April, 1977, as amended and modified from time to time;

2.3.2. India became a member of this Treaty on 17th Dec., 2001-----

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

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

- (b) *"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;*
- d) *"convention country" means a country or a country which is member of a group of countries or a union of countries or an Intergovernmental organization preferred to as a convention country in section 133;*
- (e) *"district court" has the meaning assigned to that expression by the Code of Civil Procedure, 1908 (5 of 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) *omitted w.e.f.1-1-2005*

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

- (h) *"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),⁴[or]*
 - (iv) *by an institution wholly or substantially financed by the Government;*
- (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;*
- (ia) *"international application" means an application for patent made in accordance with the Patent Cooperation Treaty;*

2.3.5 India became a member of the Patent Cooperation Treaty on **7th December, 1998.**

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

2.3.6 Considering the question what is an ‘invention’. It was held in *Raj Parkash vs, Mangat Ram Choudhary* as under:

“Invention is to find out or discover something not found or discovered by anyone before and it is not necessary that the invention should be anything complicated and the essential thing is that the inventor was the first one to adopt it and the principle therefore is that every simple invention that is

claimed, so long as it is something novel or new, would be an invention and the claims and the specifications have to be read in that light and a new invention may consist of a new combination of all integers so as to produce a new or important result or may consist of altogether new integers and the claims for anticipation by the defendant has to be either by prior user or by prior publication”

It was further observed that ‘whether a patent sets out an invention is to be determined by a true and fair construction of the specifications and the claims and in construing the specifications it would be erroneous to rely too much on the title thereof because the title cannot control the actual claim and a misleading title similarly is of no consequence and the words of the specifications should be given their ordinary meaning but where necessary must be construed in the sense in which they are used in a particular trade or sphere in which the invention is sought to have been made and it is the pith and marrow of the invention that has to be looked into and one should not get bogged down or involved in the detailed specifications and claims made by the parties who claim to be patentee or alleged violators.

- (ja) *"inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art;*
- (k) *"legal representative" means a person who in law represents the estate of a deceased person;*
- (l) *"new invention" means any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification, i.e., the subject matter has not fallen in public domain or that it does not form part of the state of the art;*
- (la) *"Opposition Board" means an Opposition Board constituted under sub-section (4) of section 25;*
- (m) *"patent" means a patent for any invention granted under this Act;*

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

2.3.8 In Writ Petition (Civil) 12598 Of 1985 in the matter of Shri Kirshna Gyanoday Sugar Ltd. & Anr. Vs. State Of Bihar, the Supreme Court referred to R.C.Cooper's Case in the following words:

In its normal connotation "property" means "highest right a man can have to anything, being that right which depend on another's courtesy: It includes ownership, estates and interests in corporeal things, and also rights such as trade-marks, copyrights, patents and even rights in personam capable of transfer or transmission, such as debts; and signifies a beneficial right to or a thing considered as having a money value." (Date Of Judgment: 18th February, 2003.)

2.3.9 Unlike other property rights, a patent right may be revoked, amended or abandoned.

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

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

- (s) *"person" includes the Government;*
- (t) *"person interested" includes a person engaged in, or in promoting, research in the same field as that to which the invention relates;*
- (ta) *"pharmaceutical substance" means any new entity involving one or more inventive steps;*
- (u) *"prescribed" means,—*
 - (A) *in relation to proceedings before a High Court, prescribed by rules made by the High Court;*
 - (B) *in relation to proceedings before the Appellate Board, prescribed by rules made by the Appellate Board; and*
 - (C) *in other cases, prescribed by rules made under this Act;*
- (v) *"prescribed manner" includes the payment of the prescribed fee;*
- (w) *"priority date" has the meaning assigned to it by section 11;*
- (x) *"register" means the register of patents referred to in section 67;*

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

2.3.11 In the matter of application for patent no. 122013 and in the opposition proceeding under Section 25 between Ganesh Mulji Rikabchand (applicant) v Mischmetal and Flints Limited (opponent) DPD, VOL.1, P.126, the Controller held that the application was not allowable because the applicant has filed the application after being communicated from abroad. Section 2(1)(y) specifically excludes from the definition of "true and first inventor" a person to whom an invention has been communicated from outside India. Under Section 6 only a "true and first inventor" or his legal successor in title may apply for patent.

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

- (a) *to the Controller shall be construed as including a reference to any officer discharging the functions of the Controller in pursuance of section 73;*
- (b) *to the patent office shall be construed as including a reference to any branch office of the patent office.*

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

2.4 Definitions in the Patent Rules

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

Rule 2: Definitions

In these rules, unless the context otherwise requires,--

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

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

Rule 17: Definitions

In this Chapter, unless the context otherwise requires,--

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

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

CHAPTER – III

PATENTABLE SUBJECT MATTER

3.1 Introduction

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

- a. It must be novel
- b. It must have an inventive step and
- c. It must be capable of industrial application.

Further, the invention should not fall under any of the categories of “Inventions- non-patentable” mentioned under Sections (3) and (4) of the Patents Act, 1970.

3.2 Novelty of Invention

3.2.1 General Principle:-- An invention is new (novel) if it has not been anticipated by publication in any document any where in the world or used in the country or prior claimed in an application for patent in India or form part of the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere before the date of filing of patent application or date of priority, that is, the subject matter has not fallen in the public domain or that it does not form part of the state of the art.

3.2.2 Although the term “State of art” has not been defined under the Patents Act, the following general principles are applied to determine the novelty of the invention during the examination procedure by applying provisions of section 13, read with the provisions of sections 29 to 34 (see Chapter IV also).

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

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

3.3 Determination of Novelty

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

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

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

3.3.4 In order to demonstrate lack of novelty the anticipatory disclosure must be entirely comprised within a single document. If more than one document is cited, each must stand on its own. The cumulative effect of the disclosures cannot be taken into consideration nor can the lack of novelty be established by forming a mosaic of elements taken from several documents. This may be done only when arguing obviousness (Ammonia's Application, 49 RPC 409)

However, if a cited document refers to a disclosure in another document in such a way as to indicate that this disclosure is intended to be included in that of the cited document, then the two may be read together as though they were a single document.

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

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

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

3.3.73.3.8 Matter becomes part of the state of the art on the date it first becomes available to the public, wherever in the world this may be, and whatever manner or language the disclosure takes place. There is no limit on the age of the disclosure.

3.3.83.3.9 Different claims may have different priority dates of documents, such as patent specifications, textbooks or technical journals which have been published in the conventional sense of that term, for example, by being on sale or available in libraries.

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

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

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

3.4 Illustrative Cases

Example 1:

The subject matter disclosed prior to the filing of patent application will destroy the novelty of the invention. To constitute a prior disclosure of a

patent, the matter relied upon as prior art must disclose subject matter which, if performed, would necessarily result in infringement of the patent. This infringement test is detailed by the Court of Appeal in *General Tire & Rubber Company v Firestone Tyre & Rubber Company Limited*, [1972] RPC 457, at pages 485 " If the prior inventor's publication contains a clear description of, or clear instructions to do or make, something that would infringe the patentee's claim if carried out after the grant of the patentee's patent, the patentee's claim will have been shown to lack the necessary novelty, that is to say, it will have been anticipated"

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

Example 2 :

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

Example 3 :

It was held in the case of *Gujarat Reclaim & Rubber Products Ltd.v.Kamani Metallic Oxides Ltd.*, (1983 PTC 105 (Bombay), that in a plea of prior public knowledge and prior public use by opponents, the opponents have to establish that the invention claimed in any of the claims of the applicants (complete specification) was a public knowledge and that the invention was in use publicly in India before the priority date of the claim *i.e.* 4-2-1976. The opponents have not given any evidence in support of this ground except referring to the documents relied upon by them under the ground of prior publication. While considering ground of prior publication, documents relied upon by the opponents are not relevant as they do not anticipate the applicants' invention. Opponents have therefore failed to establish their case in this ground.

Example 4 :

In the matter of *M/s. Crompton Greaves Ltd. Mumbai V/s. M/s. Bharat Heavy Electricals Ltd. Hyderabad*, patent application No.221/BOM/96 (184657), it was held by the Controller that the ground that the invention was publicly known or publicly used in India was not established by the opponent since the photo copies submitted by the opponent stated mainly the terms and conditions

of a contract to supply 3900 KVA & 5400 KVA traction transformers. The photocopies of work order did not define any constructional features of the traction transformer. Only by stating that they are the first in the field of manufacturing, the applicant company cannot be stopped from obtaining a patent unless the opponents establish that they were manufacturing an identical product before the date of filing.

Example 5 :

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

Example 6 :

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

Example 7 :

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

Example 8 :

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

Example 9 :

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

Example 10 :

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

Example 11 :

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

done."

Example 12 :

In SmithKline Beecham Plc's (Paratoxetine Methanesulfonate) Patent [2006] RPC 10, it was held that, infringement of a patent must not merely be a possible or even likely consequence of performing the invention disclosed by the prior disclosure; it must be necessarily entailed. If there is more than one possible consequence, one cannot say that performing the disclosed invention will infringe. The flag has not been planted on the patented invention, although a person performing the invention disclosed by the prior art may carry it there by accident or (if he is aware of the patented invention) by design. Indeed it may be obvious to do so.

Therefore, a disclosure which is capable of being carried out in a manner which falls within the claim, but is also capable of being carried out in a different manner, does not anticipate - although it may form the basis of an obviousness attack. In this case, Lord Hoffmann summarized the disclosure requirement as follows: "anticipation requires prior disclosure of subject-matter which, when performed, must necessarily infringe the patented invention".

Example 13:

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

Example 14:

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

Example 15:

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

Example 16:

A document will not be a proper anticipation unless it gives the public the same information as that given by the applicants specification a mosaic of extracts called from several documents would not constitute a relevant anticipation. (

Example 17:

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

Example 18:

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

Example 19:

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

Example 20:

The disclosure of a document to two or more selected individuals in Government service does not appear to be sufficient to constitute public knowledge of the said document. (Decision of the Controller (1945) Re. Patent Application No. 29180).

3.5 Enabling Prior Art

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

3.5.2 Determination of enablement of a prior disclosure for the purpose of anticipation stands on the same footing as the test of enablement of the patent itself for the purpose of sufficiency. However, depending on the facts of the case the application of the test would differ. In the case of sufficiency the skilled person is attempting to perform a claimed invention setting the goal in mind, whereas in the case of prior art the subject-matter may have been disclosed in the invention but not identified it as such [*SmithKline Beecham Plc's (Paratoxetine Methanesulfonate) Patent* [2006] RPC 10]. The ordinary skilled person must be able to perform the invention, which satisfies the requirement of disclosure.

3.5.3 Thus the requirement of sufficiency of the disclosure and enablement with

regard to prior art is different. In particular, the role of the person skilled in the art is different. In the case of sufficiency, the skilled person is taken to be trying to understand what the author meant. His common general knowledge forms the background in construing the disclosure, with the patent being construed on similar principles. Once this is performed, to determine whether or not the disclosure would infringe, the person skilled in the art has no further part to play. On the other hand, for enablement, the person skilled in the art is assumed to be willing to make trial and error experiments to get it to work, and the question is not what the skilled person would think the disclosure meant, but rather whether he would be able to work the disclosed invention.

3.6 PRIOR PUBLIC USE

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

3.6.2 **Public user does not mean a user by the public but a user in a public manner (Lallubhai Chakubhai v. Chimanlal Chunilal & Co. 37 Bom L.R. 665).**

Example 1:

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

Example 2:

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

Example 3:

In *Lallubhai Chakubhai v. Shamaldas Sankalchand* A.I.R., 1934. Bom. 407, it

was held that if an article manufactured under a secret process is of such a character that any body by examining it can find out the secret of that manufacture, then the sale of that article in public would amount to public user of the process. It was also held that secret use of an invention by the inventor himself for experimental purposes of the manufacture of an invention for the inventor by a manufacturer, who is under injunction to keep the invention secret will not make the patent invalid.

Example 4:

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

Example 5:

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

Example 6:

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

Example 7:

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

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

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

Example 8:

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

Example 9:

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

Example 10:

In Milliken Denmark AS v Walk Off Mats Ltd and anr [1996] FSR 292 Jacob J held that the hiring of mats to customers who were free to inspect them amounted to anticipatory prior use even though the mats relied on perforations not visible to the naked eye for their function. While there was no reason to suppose that any customer should have conducted tests which would have revealed the perforations, a skilled person called on to investigate the mats would none the less have discovered them. The knowledge of the

perforations would enable the skilled person to perform the invention. It was irrelevant that he would not know of its virtues. Moreover, if the process by which the article or material has been made can be deduced with certainty from such examination, that would also form part of the state of the art.

Example 11:

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

Example 12:

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

Example 13:

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

Example 14:

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

Example 15:

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

Example 16:

The use of an invention for purposes of trade, whether by the inventor himself or by others may constitute public user of the invention (*Lallubhai Chakubhai v. Chimanlal Chunilal & Co.* A.I.R. 1936 Bom. 99)

Example 17:

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

Example 18:

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

3.7 Prior Claiming

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

- (1) The examiner to whom an application for a patent is referred under section 12 shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification –
- (b) is claimed in any claim of any other complete specification published on or after the date of filing of the applicant’s complete specification, being a

specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.

3.7.1 In order to prove prior claiming of the invention, following conditions should be complied with:--

(i) that the application(x) where the invention has been claimed prior to the application(y) claiming alleged invention, has been filed in India

(ii) the application(x) must have been filed earlier to the date of filing or priority date of application(y) in question

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

3.7.2 In the matter of application for patent no. 123140, Centron Industrial Alliance Private Limited v Harbans Lal Malhotra and Sons Private limited, [DPD, Vol.1, p 133], application filed on 15th September 1969 in respect of “Improvements in or relating to blades of razors and like instruments.” Claimed in Claim1:A method of manufacturing. superior quality blades of razors and like instruments as herein defined, which includes coating the blades **with** polytetrafluoroethylene, characterised in that the said method consists of atomic or molecular deposition in vacuum of a thin film of particles of a corrosion resistant material on the cutting edge or edges of the blades of the said instruments before coating the said blades with said polytetrafluoroethylene.

Prior filed application 120345 filed on 14th March 1969 cited for prior claiming claimed in claim 1: A method of manufacturing. superior quality blades of razors and like instruments as herein defined, which consists atomic or molecular deposition in vacuum of a thin film of particles of a corrosion resistant material on the cutting edge or edges of the blades of the said instruments and thereafter coating the said blade with polytetrafluoroethylene.

Controller found the application completely anticipated by prior claiming

Prior art filed application 120651 of 31st March 1969 was found anticipating by prior claiming in part. 120651 claimed Rhodium as deposited material on the cutting edges of the blade instead of a general expression “corrosion resistant material” of impugned claim. The only difference of ‘651 was the use of Rhodium as a thin film of particle deposited. The Controller observed that the characteristic property of Rhodium is identical with the identical property of corrosion resistant material. This lead to the conclusion that the claim at issue was anticipated by cited document in part by prior claiming.

In the similar manner 120652 (31st March 1969) used platinum and was held as anticipating in part by prior claiming.

118127 (16th October 1968) used razor blades made of carbon steel or hardened stainless steel having a coating of chromium. This was also, held as anticipating in part by prior claiming.

3.8 Novelty in case of selection inventions:

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

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

3.9 INVENTIVE STEP (NON-OBVIOUSNESS)

- 3.9.1 After establishing the novelty, an invention is assessed for inventive step. The invention is not considered to involve an inventive step, if it is obvious to a person skilled in the art on the date of priority. This is assessed on the basis of published documents or otherwise. Inventive Step is defined in the Act as under:

Section 2(1)(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.

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

3.10 Important Features of Assessment of Inventive Step :

- 3.10.1 The Supreme Court laid down the following criteria for assessing inventive step in *M/s. Bishwanath Prasad Radhey Shyam Appellant v. M/s. Hindustan Metal Industries, Respondent*: "It is important that in order to be patentable an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy the test of invention or an 'inventive step'. To be patentable the improvement or the combination must produce a new result, or a new article or a better or cheaper article than before. The combination of old known integers may be so combined that by their working interrelation they produce a new process or improved result. Mere collection of more than one integers or things, not involving the exercise of any inventive faculty, does not qualify for the grant of a patent." [AIR 1982 Supreme Court 1444]
- 3.10.2 In *Canadian General Electric Co. Ltd., v. Fada Radio Ltd. A.I.R., 1930. P.C.I.*, it was held that under the general law of patents, an invention, which consists of a small inventive step but having regard to the conditions of the art, constitutes a step forward, may be good subject matter for a patent.
- 3.10.3 There should be intellectual effort with respect to prior art technology to develop the invention. Whereas the novelty considers whether the invention is new with respect to prior art. The determination of inventive step goes further and determine the quantum of improvement is sufficient to warrant a grant of patent. By virtue of this determination a meritorious invention will be differentiated from mere workshop improvement in the area of technology under consideration. For determination of novelty an exact citation in a single

document is necessary. In the case of obviousness many documents can be considered.

- 3.10.4 In *Gillette Industries Ltd., v. Yeshwant Bros.* A.I.R., 1938. Bom. 347., it was held that mere simplicity is not necessarily an objection to the subject matter of an invention, though matters of ordinary skilled designing or mere workshop improvements are not inventions.
- 3.10.5 When the invention is just an automatic or obvious extension of Prior Art, the invention lacks in inventive step.
- 3.10.6 To judge the inventive step, the question to be answered is-
“ Would a person with ordinary skills in the art have thought of the alleged invention?” If the answer is No, then the invention is non- obvious. The question, “Is there an inventive step?” arises only if there is novelty in the invention.
- 3.10.7 The question is therefore, does the invention make available to the person skilled in the art something that he would not reach by normal exercise of his skill? If so, the inventor has made a contribution to the art which provides the consideration justifying the grant of a patent. This is not to say that it must be technically complex; simplicity does not count against an invention . But there is no invention in appreciating commercial features alone , for example in realizing that there is a market for a new product, however surprising this may be.
- 3.10.8 Just as an invention will lack novelty if the claim to it would re-monopolize something already disclosed, likewise it will be regarded as obvious if a claim to it would inhibit the rights of a skilled workman to carry out routine modifications of what is already in the public domain
- 3.10.9 For anticipation it is seen that it would be wrong to enable the patentee to prevent a man from doing what he has lawfully done before the patent was granted. In a similar way, the consideration behind obviousness is that it would be wrong to prevent a man from doing something which is merely an obvious extension of what he has been doing or of what was known in the art before the priority date of the patent granted [1985] RPC 59, p. 77)
- 3.10.10 The term "obvious" means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the Person Skilled in the Art.
- 3.10.11 For this purpose a Person Skilled in the Art should be presumed to be an ordinary practitioner aware of what was general common knowledge in the relevant art at the relevant date. In some cases the Person Skilled in the Art may be thought of as a group or team of persons rather than as a single person.
- 3.10.12 Some examples to illustrate the points mentioned above are given below:

Example 1:

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

Example 2:

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

3.11 Mosaicing multiple Documents

- a. When assessing the inventive step, combining the teachings of different documents within the prior art [mosaics] is permissible, if it is obvious to do so at the time of filing or priority date of patent application, to the person skilled in the art.
- b. In *Technograph vs Mills and Rockley* (1972 RPC 346 at p-355(HL)), it was observed that "when dealing with obviousness, unlike novelty, it is permissible out of relevant documents, but it must be mosaic which can be put together by an unimaginative man with no inventive capacity."
- c. All the information in any set of documents can be combined

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

- d. If the invention can be produced by combining the teaching of one document with common general knowledge or with standard practice in the art, then even if the inventor has not conceived it nor the applicant presented it in such terms, there is a strong presumption that such a combination would be obvious to the skilled person. If, in his application, the applicant refers to prior art as “conventional”, this may be taken to indicate that the prior art is common general knowledge (*NEC Corporation's Application* (BL O/038/00))
- e. When a problem defined with reference to the prior art and as disclosed in a primary document would necessitate the skilled person to take help from the individual solutions available in different secondary documents, in the same or related fields to provide part of the solution to the objective problem, the inventive step may be assessed taking into account these documents also.
- f. Where the documents are from different technical fields, the question is whether the problem would have prompted search in those fields. It is reasonable to expect a person skilled in the art, unable to fulfill a need in the relevant field, to look for suitable parallels in a neighboring field so closely related that he would take developments therein into account, or in the broader general field in which the same or similar problems extensively arise and of which he must be expected to be aware (Decision T 176/84, OJEPO 2/86).
- g. In *Dow Chemical Company (Mildner's Patent)* [1973] RPC 804, an invention residing in an electrical cable in which a plastics jacket was securely bonded to a metal shield using a specified copolymer was held to be obvious in the light of one document disclosing all the features of the cable but not mentioning the adhesive copolymer, and other documents disclosing the copolymer. Although these latter documents did not refer to cable manufacture, they did refer to the copolymer as having high moisture resistance and being suitable for bonding plastics to metal, both essential properties in adhesives for use in cables. It was therefore reasonable to expect the skilled person concerned with the problem of adhering plastics to metal in cables to have found and considered these documents.
- h. When a problem defined by reference to the closest prior art, as disclosed in a primary document, would necessitate the skilled person to take help from the individual solutions available in different secondary documents, in the same or related fields to provide part of the solution to the objective problem, the inventive step may be assessed taking into account of these documents also.

- i. The invention must be considered as a whole for consideration of inventive step. It is thus not sufficient to draw the conclusion that a claimed invention is obvious merely because individual parts of the claim taken separately are known or might be found to be obvious.
- j. If a claim relates to a composition comprising known ingredients, it is likely to be obvious, unless the mixture/combination leads to some new effect, say, for example, synergistic effect.
- k. If an invention lies merely in verifying the previous predictions, without substantially adding anything for advancement in the art, the inventive step is lacking.
- l. In general, where an invention comprises a collection of known or obvious parts, it must be shown before raising the objection for obviousness that it was obvious to combine these parts.
- m. Where an invention can be thought of as the result of a selection from a number of alternatives, to demonstrate that the invention is not obvious, it is usually only necessary to show that it solves a technical problem in a surprising or unexpected way.

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

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

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

3.13 Inventive Step in relation to combination invention

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

- ii) The fact that an individual feature or a number of features were known from prior art does not conclusively show the obviousness of a combination (T 37/85, T 666/93, T 1018/96); but whether the state of the art would lead a skilled person to this particular overall combination of possibly already known features. In such a case, it would be impossible for a combination consisting exclusively of known individual features to involve an inventive step (T 388/89, T 717/90, T 869/96).
- iii) A mere aggregation of features must be distinguished from a combination invention. The existence of a combination invention requires that the relationship between the features or groups of features be one of functional reciprocity or that they show a combinative effect beyond the sum of their individual effects.
- iv) In T 406/98 the board found that as a rule, particularly when large numbers of citations were involved, it was necessary to ask why the skilled person would consider documents in that specific combination, and whether, not knowing the invention, he had reason to do so. In this case, a complete solution to the problem required deliberate selection from a large number of citations.
- v) A combination invention is to be judged whether these features or sets of features are functionally interdependent, i.e. mutually influence each other to achieve a technical success over and above the sum of their respective individual effects as assumed in the case of a combination of features
- vi) It was held that there was no inventive step in combining the claim's two features, both known per se, since they related to the solving of two entirely separate partial problems and the solutions could be assessed separately against the prior art [T 597/93, T 687/94]

3.14 Determination of Inventive Step :

A) Issues involved in assessment of Inventive Step

The following aspects need to be looked into while determining inventive step in the alleged invention :

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

success was due to the technical merits of the development? (Haverman vs Jackal (1999) FSR 685 at 699-701)

B) Steps in Determination of Inventive Step:

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

C) Assessing Inventive Step:

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

The applicant may, for example, have presented his invention as a combination of features A, B, C, and D which he admits as known in combination, with a further feature E which it would undoubtedly be inventive to add to the acknowledged combination.

It may be however that a prior document discloses the combination of features A and E, and that the addition of the remaining features B, C, D is then the most natural way of completing the disclosure in the prior document and therefore obvious.

3.15 Person Skilled in the Art

- i) The person skilled in the art should be presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date (average skilled person).
- ii) He should also be presumed to have had access to everything in the state of the art, in particular the documents cited in the search report, and to have had at his disposal the normal means and capacity for routine work and experimentation
- iii) Such person should not possess any inventive capability. It was the presence of such capability in the inventor, which set him apart from the notional skilled person. His attitude is considered to be conservative. He would never go

against an established prejudice, nor try to enter unpredictable areas nor take incalculable risks.

- iv) The skilled person can be expected to look for suggestions in neighbouring fields if the same or similar problems arise in such fields. The skilled person can be expected to look for suggestions in a general technical field if he is aware of such fields. The notional skilled person would perform a transfer of technology from a neighbouring field to his specific field of interest, if this transfer involved routine experimental work comprising only routine trials

Example 1

In *Tetra Molectric Ltd v Japan Imports Ltd* ([1976] RPC 547) the Court of Appeal held that a claim to a smoker's lighter using piezoelectric ignition was obvious. Since the possibility of using piezoelectricity in a lighter would have occurred to the industry, a skilled lighter manufacturer, himself not an expert in piezoelectricity, could reasonably be expected to seek advice from those who were. If such experts had been consulted, they would have advised that the suggestion was definitely worth trying, and they could have solved such problems as arose. The hypothetical skilled man in this case was therefore a team which included persons skilled in piezoelectricity, and not simply persons engaged in the lighter industry.

- v) The skilled man should not be expected to try all combinations unless he has a problem in mind and particular combinations might assist him in solving it; he is not to be expected to take steps or try processes which he would not regard as worthwhile as a possible means of achieving or assisting in practice the objective which he has in view (see the judgment of the Court of Appeal in *Hallen Co v Brabantia (UK) Ltd* [1991] RPC 195.
- vi) In advanced technical fields the competent "skilled person" could be taken to be a group of people as "skilled person" from the relevant technical branches such as a research or production team.
- vii) The person skilled in the art is normally not assumed to be aware of patent or technical literature in a remote technical field. In appropriate circumstances, however, the knowledge of a team consisting of persons having different areas of expertise can be taken into account (T 141/87, T 99/89). Solutions of general technical problems in non-specific (general) fields are considered to be part of the general technical knowledge

This would be the case in particular if an expert in one particular field was appropriate for solving one part of the problem, while for another part one would need to look to another expert in a different area (T 986/96).

Thus, in real life the semiconductor expert would consult a plasma specialist if his problem concerned providing a technical improvement to an ion-generating plasma apparatus (T 424/90) or the average skilled person in electronics, particularly if he did not have an adequate knowledge of programming languages himself, might be expected to consult a computer programmer if a publication contained sufficient indications that further details

of the facts described therein were to be found in a program listing attached as an annex thereto (164/92) or in advanced laser technology, the "skilled person" may be as a production team of three experts in physics, electronics and chemistry respectively (T 222/86)

- viii) The average skilled person would not engage in creative thinking (T 500/91). Yet he or she could be expected to react in a way common to all skilled persons at any time, namely that an assumption or hypothesis about a possible obstacle to the successful realisation of a project

Example: 1

In T 412/93 the patent related to the production of erythropoietin. The parties agreed that in this particular case the skilled person should be treated as a team of three, composed of one PhD researcher with several years' experience in the aspect of gene technology or biochemistry under consideration, assisted by two laboratory technicians fully acquainted with the known techniques relevant to that aspect. The composition of the team might vary depending on the knowledge and skills required by the particular aspect dealt with.

Example: 2

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

Example:3

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

3.16 Lack of Inventive Step : Examples

- a. When invention lies only in providing equivalents (mechanical, electrical or chemical) to the known art:

~~b-~~*For example-* Use of hydraulic motor instead of electric motor in a pump

e.b. When the Prior Art is incomplete and the invention lies in “Filling the gap”, which would naturally or readily occur to the skilled person

e.f. *For example*- The invention is a building structure made from Aluminium. The prior art discloses such a structure of light weight material but does not mention Aluminium

e.c. Invention consists of a new use of well-known material employing the known properties of that material

e.g. *For example* - Washing composition containing detergent which is a known compound having property of lowering the surface tension of water; the property being known as the essential one for detergents

e.d. When an invention consists of a new use of well-known material employing the known properties of that material, inventive step is lacking

For example: A washing composition containing detergent which is a known compound having property of lowering the surface tension of water; the property being known as the essential one for detergents

k.e. Substitution of a recently developed material in a known device whose properties make it suitable for that use as earlier

l.f. *For example* - An electric cable comprises a polyethylene sheath bonded to a metallic shield by an adhesive. The invention lies in the use of a particular newly developed adhesive known to have the property of being suitable for metal bonding

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

n.g. Use of a known technique in a closely analogous situation

o.f. *For example*-Application of a pulse control technique to an electric motor driving an auxiliary mechanisms of an industrial truck such as a fork –lift truck , where the use of this technique is already known for the electric propulsion motor of the truck.

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

3.17 Indicators of Inventive Step

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

- b. **Surprising Effect:** The inventive step may be present if there is a surprising or unexpected effect. However, if the measures which lead to this effect are near at hand by themselves, a surprising effect is not sufficient for granting a patent.
 - c. **Long Felt Need:** If the claim solves a "long felt need", there is a presumption that a claim is not obvious as other inventors might have also tried to solve it but could not provide the solution to fulfil the need.
 - e. **Failure of Others:** If other inventors have tried to solve a problem and were not successful, the claim will likely involve an inventive.
 - g. **Complexity of Work:** If the work undertaken by the inventor in order to produce the invention was particularly complex, and not readily carried out, that is an indication that it was not a matter of routine. In such cases the invention can be non-obvious.
 - i. **Commercial Success:** Commercial success is indicative (but not conclusive) of an inventive step.
 - k. Cheaper and more economical Product and simplicity of the proposed technological solution.
- l. Prior art motivation.

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

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

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

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

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

Example:

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

¶3.19 Fulfilling Need: Evidence that an invention fulfils a long-felt want and has been commercially successful may be taken into account in assessing obviousness (*Hickman v Andrews*, [1983] RPC 147 and *PLG Research Ltd v Ardon International Ltd*, [1993] FSR 197), *Optical Coating Laboratory Inc. v Pilkington P.E. Ltd.* [1995] RPC 145, P.166.

It is important to have an evidence of a long-felt want or unsuccessful attempts to solve a particular problem, any evidence as to novelty, years of delay in developing the prior art and an advantage stemming from the invention. Sometimes commercial success of the invention may be attributable to factors achieved independently of the invention, such as the quality or price of the product, or to superior marketing.

Example:

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

¶3.20 Advantages of invention: Where a variation from published matter proposed by the applicant has no advantages, or is even disadvantageous, although it can be argued that the resulting inferior procedure is not obvious in the sense that no skilled man would regard it as obvious to do something inferior, the application should nevertheless, if the variation is one whose possibility a skilled man would appreciate, be refused on the ground that there is no inventive step. [T119/82, OJEPO 5/84]. The position is of course different if the applicant has discovered that a variation thought to be disadvantageous is in fact not so, or if from a large number of variants which would have been regarded as no more than feasible alternatives with no advantages, the applicant has selected a variant with an unexpected advantage.

¶3.21 Obvious to try: Where a skilled worker in a particular field could be expected to know of a use of material to achieve a certain result in that field, an invention which is concerned with the use of that material to achieve the same result in a part of that field, which had not been previously disclosed, is obvious if a person versed in the art would assess the likelihood of success sufficient to warrant a trial.

Example:

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

An effect which was revealed by following the obvious course of action did not make the action non-obvious. It was wrong to ask whether you would have predicted the effect [*Bristol-Myers Squibb Co v Baker Norton Pharmaceuticals Inc* [1999] RPC 253]

However, mere possible inclusion of something within a research program on the basis you will find out more and something might turn up is not enough to show obviousness. If it were otherwise there would be few inventions that were patentable. The ‘obvious to try’ test really only works where it is more-or-less self-evident that what is being tested ought to work” **For example**, the cited prior art pointed to the possibility that using a Zn/Al alloy as a coating for a cast iron pipe to be buried in soil might be beneficial by showing results for this alloy coating for buried steel plates. It was not however possible for the skilled person to predict success, so the invention was not obvious. [In *Saint-Gobain PAM SA v Fusion Provida Ltd and Electrosteel Castings Ltd* [2005] EWCA Civ 177, [2005] IP & T 880]

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

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

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

Example 1:

In *Bayer AG (Batz's) European Application* [1982] RPC 321, carbonless copying paper was characterised by microcapsules made of a particular polymer, which was already known for forming coatings on textiles, leather, wool and metal. Even if these were thought to be neighbouring fields, there was no reason to expect that improved results would be obtained by the use of this material (as the results of comparative experiments showed they were), and thus it was not obvious to select it from the enormous number possible.

Example 2:

In *Olin Mathieson Chemical Corporation v Biorex Laboratories Ltd*, [1970] RPC 157 at page 192, it was held not to be obvious that a useful drug would be obtained by substituting -CF₃ for -Cl in a known drug, given the large amount of prior material, leading in a number of different directions, which was before the skilled person at the date of the invention.

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

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

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

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

Example 3:

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

Example 4 :

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

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

s.3.23 Overcoming Technical Prejudice: An invention may be regarded as non-obvious if it goes against the generally accepted views and practices in the art. In *Appliances Ltd v Hoover Ltd* [2001] RPC 26, it was held that the common general knowledge held by the skilled person may have both positive and negative aspects, and it is necessary to take account of both; in other words to take account of what the skilled person would consider doing and what the skilled person would be prejudiced against doing, as a result of that knowledge. If the common general knowledge was such that the skilled person did not perceive a problem with the prior art, it becomes "considerably more difficult" to establish the obviousness of taking a particular step which would bring that prior art within the scope of the claims in question.

In the case in question it was held that the common general knowledge of the skilled person at the relevant time, along with a lack of a perceived problem, would mean that the skilled person would never have considered using anything other than bag technology in a vacuum cleaner. Further examples are if persons skilled in the art would regard certain materials or techniques as unsuitable for a particular purpose, then if the inventor has found that this prejudice is not well-founded, then he has made an inventive contribution to the art. Likewise the omission of a step hitherto thought to be necessary may constitute an inventive step.

Example :

Thus a rooted objection to the regular use of b2-antagonists in the treatment of asthma, which was the subject of an ongoing dispute amongst specialist physicians, was not ascribed to the skilled person. Another situation is where scientific opinion is out of accord with what is done in the market, as occurred in *Ancare New Zealand Ltd's Patent* [2003] RPC 8 for a sheep drench comprising two known agents, one active against round worms and one active against tapeworms. Here, the patentee argued that an inventive step lay in including the tapeworm agent because there was scientific hostility against treating tapeworms in sheep. However, it was common practice for New Zealand farmers to treat their lambs for tapeworm at the priority date.

The Privy Council, upholding judgments of the New Zealand High Court and Court of Appeal to revoke the patent for obviousness and not involving any inventive step over what was known or used before the priority date of the claim in New Zealand, held that “the fact that scientific opinion might have thought that something was perfectly useless did not mean that practising it, or having the idea of making a preparation to do it, was an inventive step. Otherwise, anyone who adopted an obvious method for doing something which was widely practised but which the best scientific opinion thought was pointless could obtain a patent”.

There is also no invention in merely tolerating the disadvantages which have deterred others. For example, if an inexpensive plastics material is thought unsuitable for making tools because it is not durable, there is no invention in using it to make a cheap screwdriver intended only for light work and accepting that it will have only a short life.

Some of these points may be illustrated by a hypothetical example: Suppose that it has been stated for years in textbooks that a particular class of chemical reaction carried out under elevated pressure, gives poor yields, and an inventor now claims the synthesis of a particular compound by such a process. If all he has done is to take advantage of the high price commanded by the product, or the cheapness of the starting materials, and has decided to accept the disadvantage of low yield, then that is not inventive; it is an obvious response to prevailing economic circumstances. On the other hand, if the inventor has discovered that good yields can be obtained by the use of still higher pressures, a fact not suggested in the prior art, then that would be inventive. But if higher yields would be

expected at difficult-to-obtain pressures, and the inventor has merely taken advantage of new techniques making such pressures more available, then that is not inventive. Finally, if the inventor has discovered that the standard accepted views on the low yields, while being normally true for this reaction, are not in fact true for this particular compound, then there is inventive step in the choice of this process.

3.24. Case Studies --Assessment of Inventive Step :

Example 1:

In case of *Rickett & Colman of India Ltd. V Godrej Hi Care Ltd.*, (2001 PTC 637 (PO)). Application of M/s. Rickitt & Colman of India Ltd.

The patent "A Mosquito/Insect Repellant Device" - Challenged by opponents on various grounds of section 25 of the Act including lack of inventive step.

The issue in this case was , "whether the applicant's devices involve any inventive step and the opponents has lead any evidence as to patentability".

It was held that the alleged device is obvious and clearly does not involve any inventive step. Further the opponents have not adduced any evidence regarding grounds of patentability. So, it is construed that opponents have dropped the aforesaid grounds. As the opposition has been successful on the ground of section 25(1)(e), the ground 25(1)(a), i.e. wrongfully obtained need not be discussed. Hereby the grant of patent is refused.

Example 2:

In case of application *No. IN/PCT/2002/00020/DEL, U/S 25(1)* , it was concluded that invention as claimed in finally revised claims 1 to 49 in the Patent application no. IN/PCT/2002/00020/Del does not involve any "inventive step" having regard to the prior art citations JP-8059512 published on 05/03/1996 and US Patent 5,885,617 published on 23/03/1999. Therefore it cannot be considered as an invention under section 2(1)(j) of the Patents Act. As it is a mere admixture and therefore not patentable under section 3(e) of the Patents Act.

It was held that "the selection of particular range of ingredients from the ranges already known prior art in this case cannot amount to establish the inventive step and The variations in the amounts of the known ingredients appear merely workshop improvements achieved by a person skilled in the art without performing any substantial experiments and can not be said a technical advancement of an existing knowledge which is required by the definition of the "inventive step" as mentioned in section 2f(j) of the Patents Act, 2005." and for the ground u/s 3(e) that

"The existence of already known characteristics of composition with known ingredients cannot be termed as synergy among the ingredients of claimed composition"

Example 3:

In case of Patent No. 173953 (223/BOM/1991) the invention was related to “process for making a soap composition containing glycerol”. Opposition was lodged on the ground of prior publication, prior public knowledge, obviousness, not an invention within the meaning of the Act and does not sufficiently define the invention

It was held that the ingredients recited in the principal claim have a very specific and narrow range of proportions, which are not taught by cited documents. Cited document do not teach how to obtain the right balance of salt & glycerol in order to avoid a soap which is too hard or too soft. Also, in cited documents there is no mention of balancing the quantities of glycerol or salt against the quantities of total fatty matter. So opponents failed to establish the grounds.

Example 4:

In case of Patent No. 183455 (203/BOM/1997) the invention relates to a process for preparation of injectable Nimesulide composition. Opposition was lodged on the ground of obviousness among other grounds such as prior publication, prior public knowledge In view of the cited Srilankan Patent, the alleged invention stands anticipated as cited document disclosed the invention or disclose information in such a way as to make it part of the state of the art.

The claim lacks in novelty if information about anything falling within its scope has already been disclosed in the prior art. Thus, for example if a claim specifies alternative, or defines the invention by reference of range of values, then the invention is not new if one of these alternatives, or if a single example falling within this range, is already known. Thus a specific example is sufficient to destroy the novelty of a claim when the same is defined generically.

The grant of patent was refused on the above grounds

Example 5:

In case of Ajay Industrial Corporation v. Shiro Kamas of Iberaki City (AIR 1983 Del 496.) The specification and claims have all to be read together and reasonably and benevolently construed. In the absence of any technical or expert evidence either indicating that these statements are wrong or that the article produced incorporates no new devices to get over these defects, it cannot be held that the patent embodies no new discovery or invention. Appellant has not discharged the onus that lay on it to establish that the respondent's patent could not have been registered and, therefore, needs to be revoked.

Example 6:

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

Example 7:

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

Example 8 :

In *Surendra Lai Mahendra v. Jain Glazers* [1981 PTC 112 Del] it was held that the plaintiff's patent is nothing more than an indigenous combination of certain integers which form part of Morance machine designed to be less expensive and cheaper apparatus. No doubt it may be termed as simplification of the apparatus to some extent but it is difficult *ex facie* to say that it involves an exercise of inventive step or inventive faculty. No doubt he has produced a

workable machine but it incorporates almost all the integers and components of Morance machine. So it cannot be said that he has added a scintilla of invention to produce the same. On his own showing the plaintiff had to handle a couple of Morance machines which were not found to be workable in India and therefore, his services had to be secured by the parties concerned as a skilled technician to put the same in working order. It is thus no wonder that having tried his hand on Morane machines, he was able to devise an apparatus of his own by virtually copying the same process and making some alterations and adjustments here and there so as to obviate the necessity of sophisticated and costly integers used by Morance

Example 9 :

What constitutes an inventive step may depend on the nature of the invention. The matter was considered in *Biogen Inc v Medeva plc* [1997] RPC 1 (at page 34) as follows:

"Whenever anything inventive is done for the first time it is the result of the addition of a new idea to the existing stock of knowledge. Sometimes, it is the idea of using established techniques to do something which no one had previously thought of doing. In that case the inventive idea will be doing the new thing. Sometimes it is finding a way of doing something which people had wanted to do but could not think how. The inventive idea would be the way of achieving the goal. In yet other cases, many people may have a general idea of how they might achieve a goal but not know how to solve a particular problem which stands in their way. If someone devises a way of solving the problem, his inventive step will be that solution, but not the goal itself or the general method of achieving it."

Example 10 :

The invention related to an isolated nucleic acid molecule having the nucleotide sequence of either SEQ ID No 1 OR SEQ ID No 3 as shown in the sequence listing was obvious in view of 3 cited documents (T 0255/05). It was stated that the combined review of the cited documents motivates the person skilled in the art to identify further nucleic acid molecules encoding such receptor proteins but also suggests various methodologies to achieve this goal, such as homology screening, positional cloning, PCR or, as applied in the present application, computational and bioinformatic methodologies.

When the appellant has pointed out that the claim 1 is a narrower claim, the board expressed the opinion that even if the scope of claim 1 might be narrow, the claimed nucleic acid molecules would not appear to be anything but an arbitrary selection, among all other possible choices, of a fragment of the human genome encoding the Mas-related G protein-coupled receptor of one of the cited documents, the specific fragment lacking any unexpected properties or effects on which an inventive step could be based.

No arguments have been put forward by the appellant in this respect, except for the allegedly novel expression pattern of the nucleic acid molecules described in the application. However the Board notes that a possible expression of the described molecules in erythroleukemia cells and testis,

which has been computationally predicted on the basis of a virtual Northern blot and a PCR-based screening panel, does not constitute a property or an effect on which an inventive step for the claimed nucleic acid molecules could be based.

Therefore it was concluded that having regard to the teachings of the cited documents the subject matter of the claims was obvious to a person skilled in the art.

Example 11 :

It was held that the description shall be used to interpret the claims when assessing the inventive step (T 0516/06)

The alleged invention was related to Adenovirus vectors containing heterologous transcription regulatory elements wherein it is claimed that in the context of adenovirus vector, a first heterologous TRE is “different” from a second heterologous TRE when the polynucleotide sequence identity between the two heterologous TREs is less than about 95%, preferably less than about 90%, preferably less than about 85%, preferably about less than about 75%.

The Board therefore has understood that the unexpected property of “genetic stability” of the vectors is due to the presence of two different TREs with as much sequence identity as eg. 94% because of which such vectors would undergo significantly less homologous recombination than that occurring between two strictly identical TREs. Further the Board has felt the difficulty as otherwise in accordance with the case law T 16/87 [OJ EPO 1992, 212] wherein it is stated that the description shall be used to interpret the claims when assessing the inventive step.

In the instant case it is unambiguous from the description that TREs with a very high level of identity fall within the definition of “different heterologous TREs” and it was not denied that these TREs could undergo homologous recombination. Thus, not all constructs comprised within the claim possess the property – genomic stability – that would possibly justify acknowledging inventive step.

In other words, the advantageous effect argued to impart inventive step is not obtained over the scope of the claim. On claiming by the appellant that the vectors of the prior art were unstable the Board has opined that it could only serve to back up a conclusion of inventive step as regard the proposed solution if the claimed subject matter entirely consisted of vectors, which had lost this undesirable property.

For these reasons, it was concluded that the subject matter of the invention lacks inventive step.

Example 12 :

The invention is related to an enzyme capable of degrading cellulose or hemicellulose (T 1336/04) An established case law was relied upon wherein it is stated that if the inventive step of a claimed invention is based on a given

unexpected technical effect, this effect must be achievable over the whole area claimed i. e. for all products claimed. The Board felt in the instant case the alleged technical effect has only been demonstrated for a single product, namely the EGV of *H. insolens* and this effect does not serve the basis for an acknowledging inventive step to the subject matter of claim 1 as a whole. Thus it was opined that the alleged invention lacks an inventive step.

Example 13 :

A method for controlling fungi on plants by the aid of a hydrophobic extracted neem oil has been claimed which was refused for lacking in an inventive step due to availability of a prior scientific publication on the "Effect of volatiles of some plant extracts and their oils on Conidia of *Erysiphe polygoni* DC."(T 0416/01)

The report of the publication states with respect to the effect of volatiles of garlic extract and oil, neem oil and ginger (*Zingiber officinale* Rosc.) rhizome extract on conidia of powdery mildew (*Erysiphe polygoni* DC) of pea (*Pisum sativum* L.).It was also stated that the extracts and oil from neem, ginger and garlic exhibit antifungal activity. The prior publication discloses that the neem oil is extracted by Soxhlet process. However the said document does not disclose which solvent should be used.

Accordingly, the skilled person would use his / her general knowledge of the isolation of natural products from plants. This commonly takes place by means of solvent extraction and solvent elution. These are well known practices used in all laboratories of natural products and merely imply arranging the solvents to be used according to their solvent strength. Basically whatever the technique chosen it is normally started with a non-polar hydrophobic solvent as first option and then it is continued in increasing degree of polarity up to hydrophilic solvents including water.

Since no other parameters have been discussed in the alleged invention the extraction therefore includes Soxhlet extraction is also included. Therefore it was decided that the alleged invention lacks inventive step and consequently the patent was revoked.

Example 14 :

In the crucial decision T 641/00 (OJ 2003, 352) the patent in suit related to a method in a digital mobile telephone system of the GSM type in which a subscriber identity module (SIM card) was allocated at least two identities which were selectively activated by the user in order to distribute the costs between private and service calls. The board held that an invention consisting of a mixture of technical and non-technical features and having technical character as a whole was to be assessed with respect to the requirement of inventive step by only taking account of those features which contributed to that technical character. Features making no such contribution could not support the presence of inventive step.

Example 15:

In *Mutoh Industry Ltd's Application* ([1984] RPC 35) the hearing officer held that a drawing board employing magnetic bearings was obvious, since it was reasonable for the drawing-board man concerned with the problem of reducing friction to consult a bearings expert. The Patents Court however allowed an appeal, finding that users of the known device were not struggling to overcome a problem which inhibited their activities, nor were manufacturers failing to put the known device on the market because it was not sufficiently friction-free; there was therefore no reason for the manufacturer or user to look for outside assistance.

Example 16:

In *ABT Hardware Ltd's Application* (BL O/36/87), the hearing officer held the invention to be obvious. It was concerned with the use in a letter plate of a known type of magnet comprising an elastomer loaded with ferrite powder to hold a flap in sealing engagement with a frame over an opening in the frame. There were specific problems associated with prior magnetic letter plates which could arguably have led the applicants to seek specialist advice, and the general availability and widespread use of the magnets in question might also reasonably be expected to have led the applicants naturally to consider their adoption in letter plates, with or without consultation of specialists.

3.25 Industrial Applicability: -

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

Section 2 (1) (ac)

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

- i) If the subject matter is devoid of industrial application it does not satisfy the definition of “invention” for the purpose of the Act.
- ii) "Industry" should be understood in its broad sense as including any useful and practical, as distinct from intellectual or aesthetic activity. It does not necessarily imply the use of a machine or the manufacture of a product and covers such thing as a process for dispersing fog or a process of converting energy from one form to another.
- iii) Vague and speculative indication of possible objectives that might or might not be achievable by carrying out further research with the tool as described is not sufficient for fulfilment of the requirement of industrial applicability. The purpose of granting a patent is not to reserve an unexplored field of research for an applicant.

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

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

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

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

3.25.2 Case studies : Industrial applicability

Example 1:

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

Example 2:

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

Example 3:

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

Example 4:

In *John Lahiri Khan's Application* (BL O/356/06) a method for effecting introductions with a view to making friends was held not to be industrially

applicable, even though it could be carried out by a commercial enterprise. It was also found to be excluded as a method of doing business.

Example 5:

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

Example 6 :

In one of the decided cases wherein the invention is related to Novel PTP20, PCP-2, BDP1, CLK and SIRP proteins and related products and methods it was observed that the alleged invention discloses the description of proteins, structural features [amino acid sequences] and their enzymatic activities. BDP1 polypeptide is taken as example for further understanding the case herein. The amino acid sequence for BDP1 polypeptide was given as SEQ ID NO 3 in the description and the said polypeptide is found to be associated with tyrosine phosphatase activity. A method and means for making it by DNA techniques is also described. A possible role in cellular housekeeping and in certain types of cancers has been hypothesized.

Although BDP1 polypeptide could be “made & used” as a further tool, in addition to the many already available in the art, for exploring the complex cellular signal transduction pathways and their implications in the regulation of cellular processes and possibly disease states, the whole burden is left to the reader to guess or find a way to exploit it in industry by carrying out work in search for some practical application geared to financial gain, without any confidence that any practical application exists.

Since no industrial applicability could be derived from the description the Board in their judgment opined that a vague and speculative indication of possible objectives that might or might not be achievable by carrying out further research with the tool as described is not sufficient for fulfilment of the requirement of industrial applicability. The purpose of granting a patent is not to reserve an unexplored field of research for an applicant.

CHAPTER IV

INVENTIONS NOT PATENTABLE

Section 3 : What are not inventions:-

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

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

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

- (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.*
- (h) *a method of agriculture or horticulture;*
- (i) *any process for the medicinal, surgical, curative, prophylactic [diagnostic therapeutic] or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products.*

- (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 or traditionally known component or components.*

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

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

4.2 Some examples of frivolous and claims contrary to natural laws are:-For example:

- a. A machine purporting to produce perpetual motion will not be patentable because it is impossible to prepare such machine
- b. A machine alleged to be giving output without any input is not patentable as it is contrary to natural law.
- c. “A method of showing time on the basis of metric system” wherein dial of time piece having three hands for indicating, hour, minutes and seconds was divided into 10 parts for hours, each hour into 100 minutes and each minute into 100 seconds. The invention was held frivolous and not considered a patentable invention. (Indian patent application no. 101/Bom/72)
- d. Merely making in one piece, articles previously made in two or more pieces is frivolous. Mere usefulness is not sufficient [Indian Vacuum Brake’ Company Ltd vs Laurd (AIR 1962, Cal 152)].
- e.e. A machine alleged to give 100% performance is also not patentable
- d. ~~Any well established natural law like Newton’s law of gravitation is not a patentable subject matter~~

3(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.”*

4.3 Some examples are:

(i) The invention, the use of which is contrary to the law which is in force, or use of which is prohibited is not patentable.

For example:

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

(ii) Inventions, the established or intended use or commercial exploitation of which is found to be injurious to public, animal or plant life or health are not patentable

For example: Method of adulteration of food.

(iii) The invention, the present or intended use of which is likely to violate the well accepted and settled social, cultural, legal norms of morality is not allowable e.g. method of cloning

(iv) If the invention is such that the primary or proposed use of which would disturb the public order is not patentable e.g. A device for house-breaking, ~~weapons for mass destruction,~~

(v) terminator gene technology

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

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

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

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

can be used for making a particular article or in a particular process, then the article or process could be patentable.

- 4.4.4** Finding out that a particular known material is able to withstand mechanical shock is a discovery and therefore not patentable, but a claim to a railway sleeper made of the material would not fall foul of this exclusion, and would be allowable if it passed the tests for novelty and inventive step.

Similarly, finding of a new substance or micro-organism occurring freely in nature is a discovery and not an invention e.g. in *Kirin-Amgen v Hoechst Marion Roussel* [2005] RPC 9]. ~~A DNA sequence of a gene was not an invention as standing alone, though it was a “discovery as such”; but if it were necessary to isolate and extract it then a process developed for this purpose could be patentable.~~

~~4.4.7A mathematical method is one which is carried out on numbers and provides a result in numerical form (the mathematical method or algorithm therefore being merely an abstract concept prescribing how to operate on the numbers) and not patentable. However, its application may well be patentable, for example, in *Vicom/Computer related invention* [1987] 1 OJEPQ 14 (T208/84) the invention concerned a mathematical method for manipulating data representing an image, leading to an enhanced digital image.~~

~~**4.4.84.4.5** Claims to a method of digitally filtering data performed on a conventional general purpose computer were rejected, since those claims were held to define an abstract concept not distinguished from a mathematical method. However, claims to a method of image processing which used the mathematical method to operate on numbers representing an image can be allowed. The reasoning was that the image processing performed was a technical (i.e. non-excluded) process which related to technical quality of the image and that a claim directed to a technical process in which the method used does not seek protection for the mathematical method as such. Therefore the allowable claims as such went beyond a mathematical method.~~

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

Example: Any well-established natural law like Newton’s law of gravitation is not a patentable subject matter

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

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

- 4.5.1 Mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance is not patentable. According to the proviso to this sub-section, a known substance in its new form such as amorphous to crystalline or crystalline to amorphous or hygroscopic to dried, one isomer to other isomer, metabolite, complex, combination of plurality of forms, salts, hydrates, polymorphs, esters, ethers, or in new particle size, shall be considered same as of known substances unless such new forms significantly differ in the properties with regard to efficacy. Accordingly such forms could be considered patentable provided they significantly enhances known efficacy of that substance at the time of filing the application.
- 4.5.2 In order to be patentable any salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance ,they must differ significantly in the properties with regard to efficacy. The requirement here is two fold, namely the new form must result in enhancement of known efficacy of known substance and secondly, in order to be distinct from the known substance, the new form must differ in the properties with regard to efficacy
- 4.5.3 The comparison with regard to properties or enhancement of efficacy must be made between the known substance and the new form of known substance. In case the new form is further converted into another new form, the comparison must be made between the already existed form and another new form but not between the base compound and another new form.
- 4.5.4 The comparison with regard to properties or enhancement of efficacy must be made at the time of date of filing of the application or priority date in the application is claiming the priority of any earlier application but not at the stage of subsequent development.
- 4.5.5 The efficacy need not be quantified in terms of numerical value to determine whether the product is efficacious because it is not possible to have a standard numerical value for efficacy for all products including pharmaceutical products.
- 4.5.6 In regard to ‘efficacy’ in pharmaceutical products, the Madras High Court observed, “going by the meaning for the word “efficacy” and “therapeutic”, what the patent applicant is expected to show is, how effective the new discovery made would be in healing a disease/ having a good effect on the body? In other words, the patent applicant is definitely aware as to what is the “therapeutic effect” of the drug for which he had already got a patent and what is the difference between the therapeutic effect of the patented drug and the drug in respect of which patent is asked for.”
“Due to the advanced technology in all fields of science, it is possible to show by giving necessary comparative details based on such science that the discovery of a new form of a known substance had resulted in the

enhancement of the known efficacy of the original substance and the derivatives so derived will not be the same substance, since the properties of the derivatives differ significantly with regard to efficacy.” (Novartis AG Vs. Union of India W.P. 24760/06)

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

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

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

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

Example:

Cyclohexylstyrene is not considered prima facie obvious over prior art isohexyl styrene.

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

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

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

(iii) Homologues: - Homologues normally display add-on property. They are

structurally similar and provide the example of Structure – Function linearity and may lack inventive step. However the cases are to be decided on case to case basis.

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

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

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

(iv) Polymorphs: -

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

(v) Metabolites:-

Metabolites are the compounds that are formed inside a living body during metabolic reaction. The types of metabolites are-

- (i) Active metabolites formed from inactive precursors (e.g DOPA & Cyclophosphamide)
- (ii) Active metabolites formed from precursors that show mechanism of action that is different from that of parent compound (e.g Buspirone & 1-pyrimidyl piperzine Fenflouromine & norfenfleuromine)
- (iii) Active metabolites which contribute to the duration of action of the parent compound (e.g. Hexamethylmelamine & Clobazam)
- (iv) Active metabolites that show antagonistic effect on the activity of the parent compound (e.g Trezodone & m-chlorophenyl pierzine, Aspirin & salicylate)

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

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

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

(vii) Hydrates and other Substances:-

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

(viii) Purification Compounds:

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

4.5.8 **Mere discovery of new property of a known substance: -**

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

4.5.9 **Mere discovery of any new use of known substance:-**

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

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

Examples 1:

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

Examples 2:

A food-packing machine used for packing the desired amount of talcum powder. Since this claim does not characterize any changes in the said food-packing machine, it is presumed that the same machine has been used for the purpose of packing talcum powder. Therefore, it is understood from the claim that the same packing machine, which is in vogue, is used for packing the material other than food. Hence this is also not allowable

4.5.11 Biotechnological inventions

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

The following points are to be noted in this context .

1. The living entities of natural origin such as animals, plants, in whole or any parts thereof, plant varieties, seeds other than micro-organism are not patentable.
2. Any process of manufacture or production relating to such living entities is also not patentable.
- 5 Any method of treatment such as medicinal, surgical, curative, prophylactic, diagnostic and therapeutic of human beings or animals or other treatments of similar nature are not patentable.
- 6 Any living entity of artificial origin such as transgenic animals and plants and any part thereof are not patentable.

- 7 The entities of artificial origin such as micro-organism, vaccines are considered patentable.
- 8 The biological materials such as organs, tissues, cells, viruses etc. and process of preparing thereof are not patentable under Section 3 (c). The biological material such as recombinant DNA, Plasmids and processes of manufacturing thereof are patentable provided they are produced by substantive human intervention and functional aspects of said DNA or plasmid shall be defined.
- 9 Natural Gene / protein sequences are not patentable
- 10 Genetically modified Gene / DNA sequences may be patentable provided their functions are duly disclosed
- 11 The processes relating to micro-organisms or producing chemical substances using such micro-organisms may be patentable.
- 12 Essentially biological processes for the production of plants and animals such as method of crossing or breeding etc. are not patentable.
- 13 Any biological material and method of making the same which is capable of causing serious prejudice to human, animal or plant lives or health or to the environment including the use of those would be contrary to public order and morality are not patentable such as terminator gene technology.
- 14 The processes for cloning human beings or animals, processes for modifying the germ line, genetic identity of human beings or animals, uses of human or animal embryos for any purpose are not patentable as they are against public order and morality.
- 15 In case of use of biological material in the invention disclosed in the patent application the source or geographical origin of such material is required to be mentioned in the specification.
- 16 In case of use of new biological materials in the invention, disclosed in the patent application, it is necessary to deposit such materials in any of the International Depository Authorities (IDA) recognized under the BUDAPEST Treaty on or before filing of the application, in order to supplement the description for sufficiency of disclosure of the invention and reference of such deposit is to be made in the patent specification.
- 17 Any invention which in effect is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known components is not patentable.

4.5.12 In an patent application no. 782/Cal/1981₂ dated 13.07.1981₂ an invention related ~~ing~~ to pharmaceutical composition exhibiting anti-phlogistic, antipyretic and analgesic activity and high gastroenteric tolerance in unit doses ~~es~~ form which contains imidazol salicylate as the active ingredient ~~imidazol salicylate~~ in the amount of 100-600 mg and an inert carriers was

claimed which was later amended to a process for the preparation of novel composition containing imidazole salicylate having formula 1 ~~shown in the accompanying drawings~~, as the active principle ~~of antiphlogistic, antipyretic and analgesic products~~. The invention was characterized in that a product is previously obtained by reacting, mole by mole, acetylsalicylic acid with imidazole in an inert organic solvent and that, using the solid product obtained in the reaction after purification by recrystallization ~~ation~~, homogenous composition were ~~are~~ produced with pharmaceutically acceptable vehicles suitable for oral, parental or topic administration.

It was held by the Controller that the active compound such as imidazole salicylate is known in the art and applicant could not develop any special property or even improve upon the property of the compound to be mixed up with the usual carrier to form the composition. Further-more, the description contained s no indication of using any special type of solvent for its purification by re-crystallization and, therefore, the invention was ~~is~~ not patentable under section 3(d) of the Act.

Further, the pharmaceutical vehicle having the primary intended function of acting as vehicle or carrier or diluent performed s the very function when incorporated in the composition. There was ~~is~~ no explicit disclosure ~~or~~ experimental data to indicate that the presence of the carrier in any way influenced s the antiphlogistic, antipyretic and analgesic activity of the active ingredients. Therefore, the invention was held ~~is~~ not allowable under Section 3(e) of the Act as well as and same is a merely an admixture of non components ([decisions on patent and designs vol. \(4\) published by patent office technical society page 21](#))

4.5.13 In the application for patent no. 134883, dated 08.03.1972, a method of control of post-embryonic development stages of coleoptera and Diptera inhabiting in the soil was claimed. The invention was, characterized by applying to said soil a toxic amount of a compound selected from the group consisting of o,o-diethyl S-(tert butylthio) methyl phosphorodithuoate and o.o-diethyl S-[(1,,1-dimethylpropyl)thio]methyl phosphorodithicate,

~~was claimed~~ It which was amended to a method for preparing a long effective pastical preparation useful in the control of the postembryonic stages of coleoptera and ~~D~~diptera inhabiting the soil having ~~an~~ long residual ~~of~~ paesticidal activity and un-objectionable odour which compriseds treating (i) sorptive or non -sorptive granular particles of a material like di-atomite or silicas with 5% to 25% of o,o-diethyl 3-(tert-butylthio) methyl phospho-rodithicate and when preferred (a) applying a super coating of an inert material like clay or talc on the treated granular non-sorptive material or (b) applying a deactivator to the surface of the sorptive material before treating with the said phosphorodithicate, using one or more conventional solvents.

It was held by the Controller that materials and solvent specified in the claim were ~~are~~ conventional and customary application ~~ors~~ well known in the pesticidal art. Further, the method for preparation of ~~the~~ formulation was ~~are~~ conventional ~~methods~~ and gave ~~iven~~ a pestisicidally active compound, which every person skilled in the pesticidal art would ~~ill have to~~ make as a

formulation by applying active compound by conventional method to the conventional applicators for using the pesticidal active compound. Accordingly, a method of making a formulation by applying a conventional method a pesticidal compound to a conventional applicator is only steps in the use of compound or substance for treating the patient. Therefore invention falls within section 3(d) as the mere non substance or non compound.

4.5.14

In case of M/s. Astra Aktiebolag [Patent Application No. 1354/del/1998], the controller in his decision dated 12th June 2007, held that the patent application is not patentable under section 3(d) of the Patent Act 1970, as “present pharmaceutical formulation is a selection from the prior art formulation due to the specific selection of HPMC of cloud point above 45.6° C having similar medicinal use and with the same therapeutic efficacy... the benefit claimed by the applicant in the present application is not accruable to the user in terms of therapeutic quality of the product but to the manufacturer only in terms of consistency in the production of formulation...”.

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

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

4.6.1 Invention not patentable under section 3 (d) &(e) (to be also incorporated in (e) :- In a patent application no. 782/Cal/1981, dated 13.07.1981, an invention related to pharmaceutical composition exhibiting anti-phlogistic, antipyretic and analgesic activity and high gastroenteric tolerance in unit doses form which contains imidazol salicylate as the active ingredient in the amount of 100-600 mg and an inert carrier was claimed which was later amended to a process for the preparation of novel composition containing imidazole salicylate having formula 1, as the active principle . The invention was characterized in that a product is previously obtained by reacting, mole by mole, acetylsalicylic acid with imidazole in an inert organic solvent and that, using the solid product obtained in the reaction after purification by recrystalization , homogenous composition were produced with pharmaceutically acceptable vehicles suitable for oral, parental or topic administration.

It was held by the Controller that the active compound such as imidazole salicylate is known in the art and applicant could not develop any special property or even improve upon the property of the compound to be mixed up with the usual carrier to form the composition. Furthermore, the description

contained no indication of using any special type of solvent for its purification by re-crystallization and, therefore, the invention was not patentable under section 3(d) of the Act.

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

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

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

4.6.44.6.5 In assessing the inventive step involved in an invention based on a combination of features, consideration must be given to whether or not the state of the art was such as to suggest to a skilled person precisely the combination of features claimed. The fact that an individual feature or a number of features were known does not conclusively show the obviousness of a combination.

4.6.54.6.6 A mere aggregation of features must be distinguished from a combination invention. The existence of a combination invention requires that the relationship between the features or groups of features be one of functional reciprocity or that they show a combinative effect beyond the sum of their individual effects. The features should be functionally linked together which was the actual characteristic of a combination invention.

4.6.64.6.7 An anti-perspirant composition for application to human skin (63/Bom/75) was held not patentable.

4.6.74.6.8 A composition comprises of non-cellulosic moisture absorbing polymer capable of absorbing moisture at least equivalent to its weight and a carrier. The composition was held as mere admixture, for the reason that it has got total sum of the properties of two components, namely, the properties of absorbent polymer to absorb moisture or to absorb perspiration on being applied to human skin, which has not been in any way influenced by the presence of said carrier to act as carrier or diluents.

4.6.84.6.9 A composition of two drugs, i.e. Paracetamol and Ibuprofen for curing fever and pain or process of preparation thereof is not patentable for the reason that the composition is a mere admixture of two drug components resulting into aggregation of properties thereof; since Paracetamol is well known for treatment of fever and Ibuprofen for treatment of pain.

4.6.94.6.10 However, if the mixture of drugs exhibits some unexpected results or synergistic properties in their action, then such composition is considered as patentable subject matter.

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

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

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

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

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

4.7.3 In application for patent no. 228/Del/77 for an invention relating to a compact device for measuring the settlement characteristic of buildings and the like civil engineering structure comprising a set of base plates to be fixed at desired parts of the buildings having mounted thereon, a water level, a tilt meter and means to measure crack-width developing in structure over a desired interval were claimed. It was held by the Controller that the compact

device comprising a water level, tilt meter and crack-width meter measuring means, all three well known in the art prior to this application and working independently of one another in a known manner with no modifications in their functioning.

- 4.7.4 A mere juxtaposition of known devices in which each device functions independently is not patentable. It is accepted as sound law that mere placing side-by-side old integers so that each performs its own function independently of the others is not a patentable combination (*British Celanese Ltd. vs Courtaulds Ltd* (52) RFC 171), e.g. a floor mill provided with sieving means. However, where the old integers when placed together have some working interrelation, producing a new or improved results, then there is a patentable subject matter in the working interrelation brought about by the collection of the integers.
- 4.7.5 A mere juxtaposition of features, already known before the priority date, which have been chosen arbitrarily from amongst a number of a different combinations, which could be chosen, is not a patentable invention.
- 4.7.6 Further, when two or more features of an apparatus or device are known, and they are juxtaposed without any inter dependence on their functioning of the apparatus or device, they should be held to have been already known (*Rampratap vs. Bhabha Atomic Research Center*, 1976 IPLR 28 P. 35)]. e.g., an umbrella with fan(388/Bom/73), Bucket fitted with torch, Clock and transistor in a single cabinet. These are not patentable subject matter, since they are nothing but mere arrangement and rearrangement of items without having any working interrelationship between them and functioning independently of each other.
- 4.7.7 Another example is of a play-cum-educational device (1532/Cal/76). The device comprises of a chart, a set of tokens for players and one or more dice. It was held not patentable under the provisions of this section since the chart, token and dice, all are working independently of each other and there is no interrelation between them.
- 4.7.8 In case of the *Franz Zaver Huemer v. New Yesh Engineers*, (1996 PTC (16) 164 Del.) it is held that the plaintiff can not claim the to be an inventor of the patent device as the device is already being used in machines for several years in several countries especially in India vide para 9 to 16 of the affidavit, the defendant has set out several details of the machines already being manufactured for over one and a half decade leading to an inference that there was nothing new in the plaintiff's device. Arrangement or rearrangement of the already known device does not amount to an invention. As sufficient ground exists for revocation of the plaintiff's patent, the defendant has a very good defence to the plaintiff's suit.
- 4.7.9 In case of *1985 (5) PTC 71 (Del)*, the application for grant of patent was in respect of apparatus for producing metallic bellows. During the opposition proceedings it was held that both hydraulic machine and roll forming machine are undoubtedly the separate machines functioning independently of other there being no novel feature stated by the applicant. Hence, the ground that there is no invention is accepted as the applicant is seeking the patent right on known types of hydraulic forming and roll forming machines which is not allowable.
- 4.7.10 In the matter of an application made by Figurette and Cosmetics Private Limited (Applicant) for application No. 388/Bom/73. dated 28 Nov'73 filed for an invention entitled "Improvements in or relating to umbrellas or Parasols and the like fitted with cooling devices" and the complete specification relates

to umbrellas or parasols which provides ventilation and circulation of air in addition to providing protection to rain or sun, and the claims were mainly objected to “section 3(f) of The Patent Act, 1970. The principal claim read as “An umbrella, parasol and the like, comprising an electric motor having a fan propeller fitted on its shaft and housed at the top of the umbrella, parasol, arranged to blow air downwardly and an electric current supply means for the said electric motor”. The applicant argued that the interrelation between the two known devices is that the electric motor is mounted at the upper end of the central rod of the umbrella and that the electric motor cannot start functioning unless the umbrella is opened. The Controller held that it can be seen from the drawings accompanying the complete specification, the housing in which the electric motor is located is above the cloth covering the umbrella and thus would function irrespective of the fact whether the umbrella is in opened or closed condition. Moreover, simply mounting the electric motor at the central rod of the umbrella merely amounts to an inter-relation as regards to the placing of known devices and does not amount to an interrelation as regards to the functioning of the known devices... accordingly, I am of the opinion that both the known devices in the applicants invention namely the umbrella and the electric motor function independently of each other in their usual known way and as such there is no interrelation in their functioning and the invention falls within the purview of section 3(f) of Patent Act and thus not Patentable. (Para 11 Page 79, 80, 81).

[4.7.124.7.11](#) A new combination may be the subject matter of a patent although every part of the combination, *per se*, is old for here the new article is not the parts themselves but the assembling and working of the parts, together. (Lallubhai Chakkubhai vs. Shamaldas Sankalchand Shah, A.I.R 1934 Bom. 407).

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

3(h) A method of agriculture or horticulture.

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

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

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

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

- 4.9.1 A method of treatment of malignant tumour cells and method of removal of dental plaque and carries are not patentable, since they are held as treatment of human beings. Also, treatment of sheep for increasing wool yield (1958 RPC 85) was held as not patentable.
- 4.9.2 An invention of a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body shall not be taken to be capable of industrial application.
- 4.9.3 The art of curing illness cannot be said to be patentable.
- 4.9.4 The term “therapy” includes prevention as well as treatment or cure of disease. Therefore, the process relating to therapy is also not patentable as held in *Unilever Limited (Davis') Application*, [1983] RPC 219
- 4.9.5 Although some medical dictionaries pointed towards a narrow interpretation of the term, other works of reference, including non-specialist dictionaries, indicated a more general meaning; this was preferred in this case, following the principle that words in statutes dealing with matters relating to the general public are presumed to be used in their popular, rather than their narrowly legal or technical, sense. However, for a treatment to constitute therapy, there must be a direct link between the treatment and disease state being cured, prevented or alleviated, (BL O/248/04).
- 4.9.6 It appears that any medical treatment of a disease, ailment, injury or disability, i.e. anything that is wrong with a patient and for which he would consult a doctor, as well as prophylactic treatments such as vaccination and inoculation, is to be regarded as therapy. The same considerations apply for animals as for human patients, so that for example prophylaxis and immunotherapy in animals are regarded as therapy[T 24/91]
- 4.9.7 In *Ciba-Geigy AG's Application* (BL O/30/85), a method of controlling parasitic helminths (worms which may develop in the animal body, for example, in the intestinal tract of animals such as sheep) by the use of a particular (novel and inventive) anthelmintic composition was held non patentable as such an infestation was a disease requiring medical treatment of the animal and that such treatment, whether curative or preventative, constituted therapy practised on the animal body.
- 4.9.8 Prophylactic treatment, aimed at maintaining health by preventing ill effects that would otherwise arise, amounts to a method for treatment by therapy Both prophylactic and curative methods of treating disease are covered by the word therapy, since both are directed to the maintenance or restoration of health The same consideration applies for animals as well as for human beings. For example prophylatic immuno-therapy in animals are regarded as therapy.
- 4.9.9 An application of substance to human body purely for cosmetic purposes is not a treatment or therapy. On the other hand, the application to the skin of an ointment designed to be effective to remove keratoges from the skin would be the instance of medical treatment. Here, “Treatment” in relevant senses means that the purpose of application of a process or substance to the body must be to arrest or cure of a disease or diseased condition or correcting some malfunction or amelioration of some incapacity or disability (Joos Vs. Commissioner of Patent (1973) RPC 59).
- 4.9.10 Application of substances to the body for purely cosmetic purposes is not therapy. In allowing claims to a process for improving the strength and elasticity of human hair and finger nails, the High Court of Australia observed that, while a process for the treatment of the human body as a means of curing or preventing a disease or other disorder was not patentable,

"Those who apply chemical preparations to the skin to prevent sunburn in climates which enjoy sunshine and moderate air temperatures can scarcely be regarded either as, in a relevant sense, treating their bodies or as undergoing treatment. On the other hand, the application to the skin of an ointment designed and effective to remove keratoges from the skin would be an instance of medical treatment. To be treatment in the relevant sense, it seems to me that the purpose of the application to the body whether of a substance or a process must be the arrest or cure of a disease or diseased condition or the correction of some malfunction or the amelioration of some incapacity or disability" (*Joos v Commissioner of Patents*, [1973] RPC 59).

- 4.9.11 It was held in *Lee Pharmaceuticals* application [(1978) RPC 51] that, since, one of the reasons of grinding pits and fissures in teeth was to prevent the onset of dental decay, the purpose of the treatment was therapeutic rather than cosmetic.
- 4.9.12 Patent, may however be obtained for surgical, therapeutic or diagnostic instrument or apparatus. Also the manufacture of prostheses or artificial limbs and taking measurements therefor on the human body are patentable.
- 4.9.13 The claims to a method of removing dental plaque and / or caries were refused in *Oral Health Products Inc (Halstead's Application)*, (1977) RPC 612), as the claim was to a method of cleaning teeth, which embraced both curative and cosmetic effects.
- 4.9.14 This decision has been followed in another case, where a claim was refused to a method of cleaning teeth which removed both plaque and stains. It was argued that, when applied to perfectly healthy teeth, the method was purely cosmetic. But the hearing officer observed that practically all *medical* treatments which are preventive in nature (such as vaccination) must, at times, be applied to people who would have remained healthy anyway, but they remained medical treatments
- 4.9.15 In *Oral Health Products Inc (Halstead's) Application*, [1977] RPC 612, claims to a method of removing dental plaque and/or caries were refused, as was a claim to a method of cleaning teeth which embraced both curative and cosmetic effects. This decision has been followed under the 1977 Act in *ICI Ltd's Application No 7827383* (BL O/73/82), where a claim was refused to a method of cleaning teeth which removed both plaque and stains; it was argued that when applied to perfectly healthy teeth the method was purely cosmetic, but the hearing officer observed that practically all medical treatments which are preventative in nature (such as vaccination) must at times be applied to people who would have remained healthy anyway, but they remained medical treatments
- 4.9.16 In T 290/86 the Board held that the use of a lanthanum-containing composition for cleaning plaque and/or stains from human teeth...will always inevitably have a therapeutic effect (at least in the prophylactic sense) as well as a cosmetic effect. Thus the invention as here claimed is not directed solely to a cosmetic effect, but is also necessarily defining a treatment of the human body by therapy and hence excluded from patentability.
- 4.9.17 Methods of treatment of the human or animal body by surgery are excluded. 'Surgery' is defined as the treatment of disease or injury by operation or manipulation. It is not limited to cutting the body but includes manipulation such as the setting of broken bones or relocating dislocated joints (sometimes

called "closed surgery"), and also dental surgery. In general, any operation on the body, which required the skill and knowledge of a surgeon, would be regarded as surgery and includes non-curative treatments such as cosmetic treatment, the termination of pregnancy, castration, sterilization, artificial insemination, embryo transplants, treatments for experimental and research purposes and the removal of organs, skin or bone marrow from a living donor are, if carried out by surgery, regarded as surgical treatments. Once it has been decided that a method constitutes surgery, therapy or diagnosis practised on the human or animal body, it is necessarily non-patentable. For example, methods of abortion, induction of labour, control of oestrus or menstrual regulation are always therapy, irrespective of the reason for the treatment.

- 4.9.18 In *Unilever Limited (Davis1) Application*, [1983] RPC 219, it was observed that any method of surgical treatment, whether curative, prophylactic or cosmetic, is not patentable. This view was upheld in another case also, while refusing to allow claims to a method of implanting an embryo transplant from a donor mammal into the uterus of a recipient mammal, since the method would necessarily have to be carried out by a surgeon or veterinary surgeon.
- 4.9.19 Methods of diagnosis practised on the human or animal body are excluded. Methods of diagnosis performed on tissues or fluids, which have been permanently removed from the body are, therefore, not excluded from patentability.
- 4.9.20 Diagnosis is the identification of the nature of a medical illness, usually by investigating its history and symptoms and by applying tests. Determination of the general physical state of an individual (e.g. a fitness test) is not considered to be diagnostic if it is not intended to identify or uncover a pathology. Section relates to methods of diagnosis practised on the human or animal body; diagnosis in itself is a method of performing a mental act and is excluded from patentability. Typically, the process of diagnosis involves a number of steps leading towards identification of a condition. For a claim to fall under this prohibition, it must include both the deductive step of making the diagnosis and preceding steps constructive for making that diagnosis involving specific interactions of a technical nature with the human or animal body. The exclusion is therefore a narrow one, and also requires all the method steps of a technical nature to be practised on the body. In determining whether or not a method is a diagnostic, the Board held that it is irrelevant whether it is necessary for a medical or veterinary practitioner to be involved. Furthermore, a method is "practised on the human or animal body" if it involves any interaction which necessitates the presence of the patient, so will include both invasive and non-invasive methods. Methods of diagnosis performed on tissues or fluids which have been permanently removed from the body are not excluded. "Body" should be taken to mean living body, and a method practised on a dead body, for example in order to determine the cause of death, would not be excluded.
- 4.9.21 Methods of therapy carried out on materials temporarily removed from the body, for example, when blood is circulated through an apparatus while remaining in living communication with the body, are not patentable (*cf Calmic Engineering Co Ltd's Application*, [1973] RPC 684).

- 4.9.22 *In Ciba-Geigy AG's Application* , the objection was raised to certain claims for a method of controlling parasitic helminthes (worms which may develop in the animal body, for example, in the intestinal tract of animals such as sheep) by the use of a particular (novel and inventive) antihelmintic composition, The applicants contended that the composition when administered to an animal would prevent the reproduction of the helminthes and kill them should they infest the animal, but without affecting the animal's body, and that its use was therefore not "therapy". However, the applicants' specification made it clear that an infestation of helminthes worms can result in restricted growth, damage to the animals and even death, if not properly treated. Moreover, the application made no mention of controlling helminthes by the use of the composition in any environment other than the animal body. The hearing officer considered that such an infestation was therefore a disease requiring medical treatment of the animal and that such treatment, whether curative or preventative, constituted therapy practiced on the animal body and consequently held that the claims in question were not allowable.
- 4.9.23 In G 1/04 (OJ 2006, 334) the Enlarged Board of Appeal held that whilst the legislator had chosen the legal fiction of lack of industrial applicability, the exclusion from patentability of the above-mentioned methods under Art. 52(4) EPC seemed actually to be based on socio-ethical and public health considerations. Medical and veterinary practitioners should be free to take the action they considered suited to diagnosing illnesses by means of investigative methods. Consequently, the policy behind the legal fiction referred to above appeared to be aimed at ensuring that those who carry out diagnostic methods as part of the medical treatment of humans or veterinary treatment of animals were not inhibited by patents (see T 116/85).
- 4.9.24 In case of M/s. A G A Medical Corporation, USA [Patent Application No.1283/DEL/2004], the controller held that “The purpose of the invention is to provide a method for determining the nominal or stretched diameter of an internal opening or defect with in a patient and particularly determining the stretched diameter of a septal defect within the heart of a patient is inseparably connected with the method of treatment” and therefore it is not patentable under section 3(i) of the Patent Act 1970.
- 4.9.25 In an application no **1377/DEL/1999** the claimed invention was related to a method for in vitro production of isolated langerhans islets endocrine cells free from fibroblasts so as to be suitable for transplantation. The process discloses the steps of culturing and proliferating the cells and back and forth aspiration to separate fibroblast from the cells, which will be capable of differentiating into insulin producing cells. The applicant argued that (1)the process is novel and has utility as fibroblast free langerhans islets are useful in the enhanced production of insulin. to control diabetes,(2)Kolkata High Court has already allowed patenting of a substance containing living organisms and(3)Indian Patent law does not bar the grant patent for such invention. However the Controller refused the application under section 15 on the grounds that the invention claimed is not patentable under section 3(i) as a method of treatment of human being, since langerhans islets are freshly taken from the body of patient in order to treat them to remove fibroblast so as to increase secretion of insulin. The end product of the process is nothing but a cluster of cells or piece of tissues of human body. The principles laid down in Kolkata High Court are not applicable as the end product of the process of present invention is not

commercial entity and cannot be passed on from one person to another upon the transaction of purchase or sale.

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

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

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

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

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

Use the existing guidelines in Annexure II

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

Therefore the allowable claims as such went beyond a mathematical method.

4.11.2 The patent application No.558/DELNP/2005 related to method of operating the credential management processor. This was refused as it was found to be attracting the provisions of section 3(k) as the alleged method was relating to ‘receiving’, ‘de-referencing’ and ‘storing’ was-being purely a computer implemented software application. As well as the enhancement of security as claimed in method claims was already disclosed in the cited document and is obvious to a person skilled in the art.

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

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

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

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

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

3(n) A presentation of information

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

4.14.2 In the matter of ~~2-~~ Application number 94/CAL/2002, the controller held that “~~Section 15, Applicant-~~ The patent system is therefore meant for protecting only one kind of creativity, i.e., technological creativity.” Since the claimed invention related to business method and method of presenting information.

~~Placement of content in the manual as decided on 22.01.2008/ as explanation/ as example~~

~~1. [May be attached to the interpretation of Section 3]~~

3(o) Topography of integrated circuits;

~~For example :- 4.15.1 Since protection of Layout Designs of Integrated Circuits is governed separately under the Semiconductor Integrated Circuit Lay-out Designs Act, 2000,~~

~~Three-Dimensional configuration of the electronic circuits used in microchips and semiconductor chips is held not patentable.~~

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

~~4.16.1 Traditional Knowledge, being knowledge already existing, is already in public domain, and hence, not patentable, for example: Wound healing property of turmeric. The anti-septic property of turmeric for wound healing. The pesticidal, insecticidal properties of neem~~

~~However, any value addition using Traditional Knowledge leading to a new process or product, possessing novelty, inventive step and industrial applicability, can be patentable.~~

~~PATENTABILITY OF VARIOUS FORMS OF CHEMICAL SUBSTANCES:~~

~~a) Isomers~~

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

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

~~Structural Isomers or positional isomers may be structurally similar or dissimilar compounds. The simplest examples are butane and isobutane and ethanol and dimethyl ether. In the former case the compounds are having structural and functional similarity. However, In the second set of compounds, although they have the same molecular formula but are structurally and functionally different. Such isomers even having close similarity may be considered to be novel over the prior art.~~

~~Isomers having the same empirical formula but having structural differences may be considered novel and may not normally offend “obviousness” as they are structurally different.~~

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

~~b) Stereo Isomers are prima facie obvious:~~

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

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

~~e) Homologues~~

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

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

~~Another interesting example is that prior art structures do not have to be true homologs or isomers to render structurally similar compounds prima facie obvious.~~

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

~~d) Polymorphs~~

~~Some compounds are present in polymorphic forms, i.e., they crystallize in diverse forms. Such forms can be deemed within the prior art and therefore not patentable. However, process patent may be allowed for the new polymorph, if the polymorph is prepared by a novel process involving inventive step.~~

~~Some therapeutically active ingredients, present in polymorphic forms, may have different properties that are more or less significant in terms of their therapeutic use. Such forms can be deemed within the prior art, **and therefore, non-**~~

~~patentable~~ if they were inevitably obtained following the process of the basic patent on the active ingredient or if they were covered by a previous product patent.

~~e) Metabolites:~~

~~Metabolites are the compounds that are formed inside a living body during metabolic reaction. The types of metabolites are-~~

- ~~i) Active metabolites formed from inactive precursors (e.g. DOPA & Cyclophosphamide)~~
- ~~(ii) Active metabolites formed from precursors that show mechanism of action that is different from that of parent compound (e.g. Buspirone & 1-pyrimidyl piperzine Fenflouromine & norfenfleuromine)~~
- ~~(iii) Active metabolites which contribute to the duration of action of the parent compound (e.g. Hexamethylmelamine & Clobazam)~~
- ~~(iv) Active metabolites that show antagonistic effect on the activity of the parent compound (e.g. Trezodone & m-chlorophenyl pierzine, Aspirin & salicylate)~~

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

~~f) Prodrugs :~~

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

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

~~g) Hydrates And Other Substances~~

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

~~h) Purification Compounds:~~

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

~~i) Pharmaceutical Compostions~~

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

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

~~v. New use of known substance or its new use in a pharmaceutical composition is not patentable.~~

For example—

~~a) — The New use of methyl alcohol as antifreeze in automobiles-~~

~~— The Use of methanol as a solvent is known in the prior art. A New use has been claimed in this claim as antifreeze which is not allowable under section 3(d) of the Act~~

~~b) — A new use of Chloroquine for Sarcoidosis(a fungal disease) and for Infectious mononucleosis(a viral disease) and for Diabetic neuritis(inflammation of nerves) is claimed. Since the claim pertains to a new use of Chloroquine, which is an antimalarial drug known in the prior art, it is not allowable under section 3(d) of the Patents Act~~

~~c) — A food packing machine used for packing the desired amount of talcum powder. Since this claim does not characterize any changes in the said food packing machine, it is presumed that the same machine has been used for the purpose of packing talcum powder. Therefore, it is understood from the claim that the same packing machine, which is in vogue, is used for packing the material other than food. Hence this is also not allowable under section 3(d) of the Patents Act~~

~~d) — Any method of using pharmaceutical composition is not patentable~~

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

~~o Any method of agriculture or horticulture is not patentable.~~

INVENTIONS RELATING TO ATOMIC ENERGY

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

(i)4.17.1 No patent shall be granted for the invention which in the opinion of Central Govt. is useful for or related to the production, control, use or disposal of atomic energy or prospecting mining extraction, production, physical and chemical treatment fabrication, enrichment, canning or use of any prescribed substance or radioactive substance or the insuring of safety in atomic energy operation (in pursuance of S. 20(1) of Atomic Energy Act, 1962).

(ii)4.17.2 According to S. 20(1) of Atomic Energy Act, atomic energy means energy released from atomic nuclei as a result of any process including the fission and fusion processes.

4.17.3 Under this Act "prescribed substances" means any substances including any mineral which the Central Govt. may, by notification, prescribe, being a substance which in its opinion is or may be used for the production or use of atomic energy or research into matters connected therewith and includes uranium, plutonium, thorium, beryllium, deuterium or any of these respective derivative or compounds or any other materials containing any of the aforesaid substances.

4.17.4 Under the atomic energy Act, the term "radioactive substances" or "radioactive material" is defined as any substance or material, which spontaneously emits, radiation in excess of the levels prescribed by notification by the central govt.

4.17.5 As per the “ Revised Notification on Prescribed Substances, Prescribed equipment and Technology ” in the Gazette of India (extraordinary, Part II, Section 3, sub-section (ii), dated 20th January, 2006, the Department of Atomic Energy, in supersession of earlier notifications, has specified in the following as the Prescribed Substances, Prescribed equipment and Technology.

NOTIFICATION
DEPARTMENT OF ATOMIC ENERGY
(Mumbai, the 18th January 2006)

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

Category – 0: Nuclear materials, nuclear-related other materials, equipment and technology.

OA Prescribed substances

Note: Any radioactive material in Category OA shall additionally attract the provisions of the Atomic Energy (Radiation Protection) Rules, 2004 made under the Atomic Energy Act, 1962 and the provisions of Section-16 of the Atomic Energy Act, 1962.

OA1 Source Material

OA101 Uranium containing the mixture of isotopes occurring in nature

OA102 Uranium depleted in the isotope 235.

OA103 Thorium

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

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

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

- a. Uranium (containing the mixture of isotopes in nature) exceeding 100 kilograms.
- b. Depleted uranium (uranium depleted in the isotope 235 below that occurring in nature) exceeding 1000 kilograms.
- c. Thorium exceeding 1000 kilograms.

- OA2 Special Fissionable Material
- OA201 Plutonium-239
- OA202 Uranium-233
- OA203 Uranium enriched in the isotopes 235 or 233
- OA204 Neptunium.
- OA205 Any material containing one or more of the foregoing
- OA206 Such other fissionable material determined by the Central Government from time to time, but the term “special fissionable material “ which does not include source material.
- Note: Any quantity of special fissionable material is prescribed substance.
- OA3 Other Materials.
‘Other Materials’ means non-nuclear materials for reactors, nuclear related dual-use materials indicate below and such materials as determined by the Central Government from time to time.
- OA301 Deuterium, heavy water (deuterium oxide) and any other deuterium compound, in which the ratio of deuterium to hydrogen atoms exceeds 1:5000, in quantities exceeding 5 kilograms of deuterium in one consignment or 25 kilograms of deuterium in any period of 12 months.
- OA302 Nuclear grade graphite / carbon, having a purity level better than 5 parts per million (ppm) boron equivalent and with a density greater than 1.5 gram/cc in quantities exceeding 30 metric tons in any period of 12 months.
- OA303 Zirconium with hafnium content of less than 1 part to 500 parts of zirconium by weight (i.e. less than 2000 ppm) in the form of metal, its alloys, compounds, manufactures thereof, waste or scrap of any of the foregoing.
- OA304 Beryllium, its compound, alloys and its minerals/concentrates including Beryl but excluding:
- a. beryllium windows used for x-ray machines and gamma rays detectors and
 - b. beryl in the form of emeralds or aquamarines.
- OA305 Lithium enriched in the Lithium-6 (^6Li) isotope to greater than its natural isotope abundance (i.e. more than 7.5%) and the products or devices containing enriched lithium such as elemental lithium, alloys, compounds, mixtures containing lithium, manufactures thereof, waste or scrap of any of the foregoing.

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

OA307 Titanium alloys having both of the following characteristics:

- a. 'Capable of' an ultimate tensile strength of 900 Mpa or more at 293 K (20°); and
- b. In the form of tubes or cylindrical solid forms (including forgings) with an outside diameter of more than 75 mm.

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

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

OA309 Hafnium:

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

OA310 Radium-226:

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

OA311 Boron

Boron enriched in the Boron-10(¹⁰B) isotope to greater than its natural isotopic abundance as follows:

Elemental boron, compounds, mixtures containing boron, manufactures thereof, waste or scrap of any of the foregoing.

OA312 Helium-3

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

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

OA313 Alpha-emitting radionuclides:

Alpha-emitting radionuclides having an alpha half-life of 10 days or greater but less than 200 years, in the following forms:

- a. Elemental;
- b. Compounds having a total alpha activity of 37 GBq per kg or greater;

- c. Mixtures having a total alpha activity of 37GBq per kg or greater;
- d. Products or devices containing any of the foregoing.

Alpha emitters controlled by this item include:

Actinium-225	Actinium-227	Americium-242m
Californium-248	Californium-250	Californium-252
Californium-253	Californium-254	Curium-240
Curium-241	Curium-242	Curium-243
Curium-244	Einsteinium-252	Einsteinium-253
Einsteinium-254	Einsteinium-255	Fermium-257
Gadolinium-148	Mendelevium-258	Neptunium-235
Plutonium-236	Plutonium-237	Plutonium-238
Plutonium-241	Polonium-209	Polonium-210
Polonium-208	Radium-223	Thorium-228
Thorium-227	Uranium-230	Uranium-232

OA314 *Titanium ores and concentrates (Ilmenite, Rutile and Leucoxene)

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

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

OB Prescribed Equipment

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

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

OB002 Plants for processing, production, concentration, conversion or recovery of Prescribed Substances (such as uranium, plutonium, thorium, deuterium, heavy water, tritium, lithium); associated equipment, components and

system, specially designed, prepared or adapted or used or intended to be used in such plants including but not limited to:

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

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

- a. Irradiated fuel element chopping machines designed for remote operation
- b. Dissolvers capable of withstanding hot and highly corrosive for dissolution of irradiated nuclear fuel and which can be removed loaded and maintained.
- c. Solvent extractors and solvent extraction equipment resistant to the corrosive effect of nitric acid.
- d. Chemical holding or storage vessels resistant to the corrosive effect of nitric acid.
- e. Industrial equipment including assemblies and components as follows:
 1. High density (lead glass or other) radiation shielding windows
 2. Radiation hardened TV cameras, or lenses therefore
 3. 'Robots' or 'end effectors' specially designed for handling high explosives; and control units therefore
 4. Remote manipulators that can be used to provide remote actions in radiochemical separation operations or hot cells

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

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

- a. Gas centrifuges and assemblies and components specially designed or prepared for use in gas Centrifuges
- b. Specially designed or prepared auxiliary systems, equipment and components for gas centrifuge enrichment plants
- c. Specially designed or prepared assemblies and components for use in gaseous diffusion enrichment
- d. Specially designed or prepared auxiliary system, equipment and components for use in gaseous diffusion enrichment.
- e. Specially designed or prepared systems, equipment and components for use in aerodynamic enrichment plants
- f. Specially designed or prepared systems, equipment and components for use in chemical exchange or ion exchange enrichment plants
- g. Specially designed or prepared systems, equipment and components for use in laser-based enrichment plants
- h. Specially designed or prepared systems, equipment and components for use in plasma separation enrichment plants.
- i. Specially designed or prepared systems, equipment and components for use in electromagnetic enrichment plants.

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

- a. fully automatic pellet inspection stations specially designed or prepared for checking final dimensions and surface defects of the fuel pellets;
- b. automatic welding machines specially designed or prepared for welding end caps onto the fuel pins (or rods);
- c. automatic test and inspection stations specially designed or prepared for checking the integrity of completed fuel pins (or rods).

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

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

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

OC Technology

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

Note: The numbering system followed in this Schedule is in harmony with the numbering system followed in the Special Chemicals, Organisms,

N.B.

- **The Central Govt. has power to amend the schedule and may issue a notification at any time.**
- **It should not be misunderstood that the mention of any listed substances either in the pure form, mineral or any composition containing radioactive material or substance disqualifies the grant of patent. If the invention refers to the use of radioactive substances for other than atomic energy then the invention may be patentable. For example, the use of radioactive substance in elucidation, metallurgical operations etc., are patentable. The apparatus that is capable of controlling the number of emissions or controlling the radiations is also patentable.**
- **It is the office practice that whether an invention will fall under the provision of atomic energy or not is to be decided by the department of atomic energy and the office will process the application based on the recommendation**

APPLICATION FOR PATENTS

3.1 PERSONS ENTITLED TO APPLY FOR A PATENT IN INDIA

Relevant sections and Rules:

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;*

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

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

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

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

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

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

5.1.1 EXPLANATION

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

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

ii) The term "person" as defined in the Patents Act includes Government. [Section 2(1)(s)]

iii) The term "person" also defined in the General Clauses Act 1897 include any company or association or body of individual, whether incorporated or not unalthough in such cases but not a firm, partnership or body which is unincorporate, individual. In the case of a limited partnership, the application may be in the names of all personally responsible partners (see also 7.05)

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

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

v)vi) Assignee includes assignee of the assignee also (**S. 2(1)(ab)**).

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

Legal representative means a person who in law represents the estate of a deceased person (**S.2 (1)(k)**). In such a case, the person should file death certificate alongwith other appropriate legal instruments etc. as proof of right. The applicant shall be a national of India or any other country which is not notified by Government of India as countries not providing for reciprocity,

viii)

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

5.1.2 It was held that a firm can apply for a patent as assignee; *Shinning Industries v. Shri Krishna Industries*, AIR 1975 All 231.

5.1.3 *In case of the Dyer Meakin Breweries Ltd. V Scotch Whisky Association*, (AIR 1980 Del 125.), it was held that Section 68 of the Act provides that the Assignment Deed, when registered, shall have effect from the date of its execution. It is, therefore, apparent that as soon as the entry of registration of his deed was made by the Patent Office on 21st June 1979 the plaintiff became the assignee of the patent in question with effect from the date of execution of the deed *i.e.* 22nd May 1979. Section 68 of the Act provides that the assignment of

a patent shall not be valid unless the same were in writing and the agreement between the parties concerned is reduced to the form of a document embodying all the terms and conditions governing their rights and obligations and the application for registration of such deed is filed with the Controller within six months of the execution of the document. Section 68 of the Act has thus been compiled with.

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

3.2.5.2.1 Where to Apply? (Rule. 4 and 5)

Relevant Sections and Rules

Rule 4:

Appropriate office;

- (1) *The appropriate office of the patent office shall—*
 - (i) *for all the proceedings under the Act, be the head office of the patent office or the branch office, as the case may be, within whose territorial limits—*
 - (a) *the applicant or first mentioned applicant in case of joint applicants for a patent, normally resides or has his domicile or has a place of business or the place from where the invention actually originated; or*
 - (b) *the applicant for a patent or party in a proceeding if he has no place of business or domicile in India, the address for service in India given by such applicant or party is situated; and*
- (2) *The appropriate office once decided in respect of any proceedings under the Act shall not ordinarily be changed.*

Rule 5:

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

EXPLANATION

5.2.2 Filing of application: Appropriate office

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

- a) Place of residence, domicile or business of the applicant (first mentioned applicant in the case of joint applicants)
- b) Place from where the invention actually originated.
- c) Address for service in India given by the applicant when he has no place of business or domicile in India. (Rule 5).

N.B: An appropriate office once decided will not be changed ordinarily

ii) A foreign applicant shall give an address for service in India and the jurisdiction will be accordingly decided. An Indian applicant also can give his Patent Agent's address as address for serving documents if he/she wishes to do so.

Patent Office	Territorial Jurisdiction
Mumbai	The States of Gujarat, Maharashtra, Madhya Pradesh, Goa, Chhattisgarh, the Union Territories of Daman & Diu and Dadra & Nagar Haveli.
Delhi	The States of Haryana, Himachal Pradesh, Jammu and Kashmir, Punjab, Rajasthan, Uttar Pradesh, Uttarakhand, National Capital Territory of Delhi and the Union Territory of Chandigarh.
Chennai	The States of Andhra Pradesh, Karnataka, Kerala, Tamil Nadu and the Union Territories of Pondicherry and Lakshadweep.
Kolkata	Rest of India.

5.2.3 FILING OF APPLICATION FOR PATENT

Relevant sections and Rules

Section 7 : Form of application;

- (1) *Every application for a patent shall be for one invention only and shall be made in the prescribed form and filed in the patent office.*
- (1A) *Every international application under the Patent Cooperation Treaty for a patent, as may be filed designating India shall be deemed to be an application under this Act, if a corresponding application has also been filed before the Controller in India.*
- (1B) *The filing date of an application referred to in sub-section (1A) and its complete specification processed by the patent office as designated office or elected office shall be the international filing date accorded under the Patent Cooperation Treaty.*
- (2) *Where the application is made by virtue of an assignment of the right to apply for a patent for the invention, there shall be furnished with the application, or within such period as may be prescribed after the filing of the application, proof of the right to make the application.*
- (3) *Every application under this section shall state that the applicant is in possession of the invention and shall name the person claiming to be the true and first inventor; and where the person so claiming is not the applicant or one of the applicants, the application shall contain a declaration that the applicant believes the person so named to be the true and first inventor.*
- (4) *Every such application (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) shall be accompanied by a provisional or a complete specification.*

Rule 6

Leaving and serving documents;

- (1) *Any application, notice or other document authorised or required to be filed, left, made or given at the patent office, or to the Controller or to any other person under the Act or these rules, may be tendered by hand or sent by a letter addressed to the Controller at the appropriate office or to that person through post or registered post or speed post or courier service or by electronic transmission duly authenticated. If it is sent by post or registered post or speed post or courier service or by electronic transmission duly authenticated, it shall be deemed to have been filed, left, made or given at the time when the mail containing the same would have been delivered in the ordinary course of post or registered post or*

speed post or courier service, or by electronic transmission duly authenticated, as the case may be. In proving such sending, it shall be sufficient to show that the mail was properly addressed and transmitted:

- (2) *Any written communication addressed to a patentee at his address as it appears on the register of patents or at his address for service given under rule 5, or to any applicant or opponent in any proceedings under the Act or these rules, at the address appearing on the application or notice of opposition, or given for service, shall be deemed to be properly addressed.*
- (3) *All notices and all written communications addressed to a patentee, or to any applicant or opponent in any proceedings under the Act or these rules, and all documents forwarded to the patentee or to the said applicant or opponent, shall, except when they are sent by special messenger, be sent by registered post or speed post or courier service or by electronic transmission duly authenticated.*
- (4) *The date of a notice or a written communication addressed to a patentee or to any applicant or opponent in any proceedings under the Act and these rules shall be the date of dispatch of the said notice or written communication, by registered post or speed post or courier or fax or electronic transmission duly authenticated, as the case may be, unless otherwise specified under the Act or these rules.*
- (5) *In case of delay in receipt of a document or a communication sent by the patent office to a party to any proceedings under the Act or these rules, the delay in transmitting or resubmitting a document to the patent office or doing any act by the party may be condoned by the Controller if a petition for such condonation of delay is made by the party to the Controller immediately after the receipt of the document or a communication along with a statement regarding the circumstances of the fact and evidence in support of the statement:*

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

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

Rule 7: Fees;

- (1) The fees payable under section 142 in respect of the grant of patents and applications there for, and in respect of other matters for which fees are required to be payable under the Act shall be as specified in the First Schedule.*
- (2) (a) The fees, payable under the Act may either be paid in cash or through electronic means or may be sent by bank draft or cheque payable to the Controller of Patents and drawn on a scheduled bank at the place where the appropriate office is situated. If the draft or cheque is sent by post, the fees shall be deemed to have been paid on the date on which the draft or cheque would have reached the Controller in the ordinary course of mail.*
- (b) Cheques or drafts not including the correct amount of commission and cheques on which the full value specified therein cannot be collected in cash shall be accepted only at the discretion of the Controller.*
- (c) Where a fee is payable in respect of a document, the entire fee shall accompany the document.*
- (3) In case an application processed by a natural person is fully or partly transferred to a person other than a natural person, the difference, if any, in the scale of fee(s) between the fee(s) charged from a natural person and the fee(s) chargeable from the person other than the natural person in the same matter shall be paid by the new applicant with the request for transfer.*
- (4) Fees once paid in respect of any proceeding shall not ordinarily be refunded irrespective of whether the proceeding has taken place or not.*
- (5) (i) Subject to the approval of the Controller, any person may deposit money in advance and request the Controller to realise any fee payable by him from the said deposit and in such case the date of the receipt of the request to realise the fee or the date on which the request to realise the fee is deemed to have been received, whichever is earlier, shall be taken as the date of payment of the fee:*

Provided that the requisite amount of money is available at the credit of the person making such request.

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

Rule 8:
Forms

- (1) *The Forms set forth in the Second Schedule with such variations as the circumstances of each case may require shall be used for the purposes mentioned therein.*
- (2) *Where no Form is so specified for any purpose, the applicant may adopt any Form specified in the Second Schedule with such modifications and variations as may be required.*

Rule 9:

Size, etc., of documents.:

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

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

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

- (2) *Additional copies of all documents shall be filed at the appropriate office, if required by the Controller.*
- (3) *Names and addresses of applicants and other persons shall be given in full together with their nationality and such other particulars, if any, as are necessary for identification.*

Rule 10:

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

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

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

Rule 11:

Order of recording applications.

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

Rule 12:

Information and Undertaking regarding foreign applications;

- (1) The statement and undertaking required to be filed by an applicant for a patent under sub-section (1) of section 8 shall be made in Form 3.*
- (1A). The period within which the applicant shall file the statement and undertaking under sub-section (1) of section 8 shall be [^]six months] from the date of filing the application.*

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

- (2) The time within which the applicant for a patent shall keep the Controller informed of the details in respect of other applications filed in any country in the undertaking to be given by him under clause (b) of sub-section (1) of section 8 shall be ^ˆsix months from the date of such filing.*
- (3) When so required by the Controller under sub-section (2) of section 8, the applicant shall furnish information relating to objections, if any, in respect of novelty and patentability of the invention and any other particulars as the Controller may require which may include claims of application allowed within six months from the date of such communication by the Controller.*

Section 9.

Provisional and Complete specifications;

- (1) Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) is accompanied by a provisional specification, a complete specification shall*

be filed within twelve months from the date of filing of the application, and if the complete specification is not so filed, The application shall be deemed to be abandoned.

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

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

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

- (4) *Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under sub-section (3) as a provisional specification, the Controller may, if the applicant so requests at any time before ²[grant of patent], cancel the provisional specification and post-date the application to the date of filing of the complete specification.*

Section 10.

Contents of specifications;

- (1) *Every specification, whether provisional 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 before the application is found in order for grant of a patent, but such model or sample shall not be deemed to form part of the specification.*
- (4) *Every complete specification shall—*

- (a) *fully and particularly describe the invention and its operation or use and the method by which it is to be performed;*
- (b) *disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and*
- (c) *end with a claim or claims defining the scope of the invention for which protection is claimed;*
- (d) *be accompanied by an abstract to provide technical information on the invention:*

Provided that;

- (i) *the Controller may amend the abstract for providing better information to third parties; and (ii) if the applicant mentions a biological material in the specification which may not be described in such a way as to satisfy clauses (a) and (b), and if such material is not available to the public, the application shall be completed by depositing the material to an international depository authority under the Budapest Treaty and by fulfilling the following conditions, namely:—*
 - (A) *the deposit of the material shall be made not later than the date of filing the patent application in India and a reference thereof shall be made in the specification within the prescribed period;*
 - (B) *all the available characteristics of the material required for it to be correctly identified or indicated are included in the specification including the name, address of the depository institution and the date and number of the deposit of the material at the institution;*
 - (C) *access to the material is available in the depository institution only after the date of the application of patent in India or if a priority is claimed after the date of the priority;*
 - (D) *disclose the source and geographical origin of the biological material in the specification, when used in an invention.*
- (4-A) *In case of an international application designating India, the title, description, drawings, abstract and claims filed with the application shall be taken as the complete specification for the purposes of this Act.*
- (5) *The claim or claims of a complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification.*
- (6) *A declaration as to the inventorship of the invention shall, in such cases as may be prescribed, be furnished in the prescribed form with the complete specification or within such period as may be prescribed after the filing of that specification,*

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

Rule 13:

Specifications;

- (1) *Every specification, whether provisional or complete, shall be made in Form 2.*
- (2) *A specification in respect of a divisional application under section 16 shall contain specific reference to the number of the original application from which the divisional application is made.*
- (3) *A specification in respect of a patent of addition under section 54 shall contain a specific reference to the number of the main patent, or the application for the main patent, as the case may be, and a definite statement that the invention comprises an improvement in, or a modification of, the invention claimed in the specification of the main patent granted or applied for.*
- (4) *Where the invention requires explanation through drawings, such drawings shall be prepared in accordance with the provisions of rule 15 and shall be supplied with, and referred to in detail, in the specification:*

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

- (5) *Irrelevant or other matter, not necessary, in the opinion of the Controller, for elucidation of the invention, shall be excluded from the title, description, claims and drawings.*
- (6) *Except in the case of an application (other than a convention application or an application filed under the Patent Cooperation Treaty designating India) which is accompanied by a complete specification, a declaration as to the inventorship of the invention, shall be filed in Form 5 with the complete specification or at any time before the expiration of one month from the date of filing of the complete specification, as the Controller may allow on an application made in Form 4.*

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

- (7) (a) *The abstract as specified under clause (d) of sub-section (4) of section 10, accompanying the specification shall commence with the title of the*

invention. The title of the invention shall disclose the specific features of the invention normally in not more than fifteen words.

- (b) The abstract shall contain a concise summary of the matter contained in the specification. The summary shall indicate clearly the technical field to which the invention belongs, technical problem to which the invention relates and the solution to the problem through the invention and principal use or uses of the invention. Where necessary, the abstract shall contain the chemical formula, which characterises the invention.*
 - (c) The abstract may not contain more than one hundred and fifty words.*
 - (d) If the specification contains any drawing, the applicant shall indicate on the abstract the figure, or exceptionally, the figures of the drawings which may accompany the abstract when published. Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by the reference sign used in that drawing.*
 - (e) The abstract shall be so drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical field, in particular by making it possible to assess whether there is a need to consult the specification itself.*
- (8) The period within which reference to the deposit shall be made in the specification under sub-clause (A) of clause (ii) of sub-section (4) of section 10 shall be three months from the date of filing of the application.*

Section 16:

Power of Controller to make orders respecting division of application;

- (1) A person who has made an application for a patent under this Act may, at any time [before the grant of the patent], if he so desires, or with a view to remedy the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first mentioned application.*
- (2) The further application under sub-section (1) shall be accompanied by a complete specification, but such complete specification shall not include any matter not in substance disclosed in the complete specification filed in pursuance of the first mentioned application.*
- (3) The Controller may require such amendment of the complete specification filed in pursuance of either the original or the further application as may be necessary to ensure that neither of the said complete specifications includes a claim for any matter claimed in the other.*

Explanation.—For the purposes of this Act, the further application and the complete specification accompanying it shall be deemed to have been filed on the date on which the first mentioned application had been filed, and the further application shall be proceeded with as a substantive application and be

examined when the request for examination is filed within the prescribed period

Section 54:

- Patents of addition.***—(1) *Subject to the provisions contained in this section, where an application is made for a patent in respect of any improvement in or modification of an invention described or disclosed in the complete specification filed therefor (in this Act referred to as the "main invention") and the applicant also applies or has applied for a patent for that invention or is the patentee in respect thereof, the Controller may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.*
- (2) *Subject to the provisions contained in this section, where an invention, being an improvement in or modification of another invention, is the subject of an independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention, the Controller may, if the patentee so requests, by order, revoke the patent for the improvement or modification and grant to the patentee a patent of addition in respect thereof, bearing the same date as the date of the patent so revoked.*
- (3) *A patent shall not be granted as a patent of addition unless the date of filing of the application was the same as or later than the date of filing of the application in respect of the main invention.*
- (4) *A patent of addition shall not be granted before grant of the patent for the main invention.*

Section 135.

Convention Applications;

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

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

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

Provided that the fee payable on the making of any such application shall be the same as if separate applications have been made in respect of each of

the said inventions, and the requirements of clause (b) of sub-section (1) of section 136 shall, in the case of any such application, apply separately to the applications for protection in respect of each of the said inventions.

- (3) *In case of an application filed under the Patent Cooperation Treaty designating India and claiming priority from a previously filed application in India, the provisions of sub-sections (1) and (2) shall apply as if the previously filed application were the basic application:*

Provided that a request for examination under section 11B shall be made only for one of the applications filed in India.

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

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

5.2.7 Priority date not allowed after withdrawal of basic application for an application made under section 135: - An application no, 986/Cal/79 was filed on 21.09.1979 as conventional application based on U.K. application no. 37624/1979. However, the basic U.K. application was withdrawn before filing of the Indian application. The applicant argued that the priority of the withdrawn application should be allowed on the basis of said U.K. application as the same has the filing date and number and was mentioned in the statement of undertaking. The Controller of Patents however held that existence of application in the convention country at least on the date of filing the application in India is sine-quo-non for the claim of priority. Since the application in

the convention country has been withdrawn prior to the date of filing of application India the requirement of under section 135 have not been met and in fact in the eye of law there was no application in the convention country in consequence of withdrawal. Therefore, the priority date on the basis of withdrawn application could not be allowed.

Rule 15:

Drawings.

- (1) Drawings, when furnished under section 10 by the applicants otherwise than on requisition made by the Controller, shall accompany the specifications to which they relate.
- (2) No drawings or sketch, which would require a special illustration of the specification, shall appear in the specification itself.
- (3) At least one copy of the drawing shall be prepared neatly and clearly on a durable paper sheet.
- (4) Drawings shall be on standard A4 size sheets with a clear margin of at least 4 cm on the top and left hand and 3cm at the bottom and right hand of every sheet.
- (5) Drawings shall be on a scale sufficiently large to show the inventions clearly and dimensions shall not be marked on the drawings.
- (6) Drawings shall be sequentially or systematically numbered and shall bear—
 - (i) in the left hand top corner, the name of the applicant;
 - (ii) in the right hand top corner, the number of the sheets of drawings, and the consecutive number of each sheet; and
 - (iii) in the right hand bottom corner, the signature of the applicant or his agent.
- (7) No descriptive matter shall appear on the drawings except in the flow diagrams.

Rule 16.

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

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

APPLICATION FOR PATENT

5.2.9 TYPES OF PATENT APPLICATIONS

The following types of applications for patent can be filed:

1. Ordinary Application

2. **Convention Application**
3. **PCT International Application**
4. **PCT National phase Application**
5. **Application for Patent of Addition**
6. **Divisional Application**

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

An application for patent made in the Patent office without claiming any priority of application made in a convention country or without any reference to any other application under process in the office is called an ordinary application. Such an application can be filed by an inventor himself (as an applicant) or by a person to whom the invention is assigned by the inventor (an assignee is the applicant), without claiming any priority of application made in a convention country or without referring to any other application being processed in the Patent Office. The applicant can be either of Indian or foreign origin.

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

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

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

3. **PCT International application**

PCT is an International filing system for patents in which the applicant gets an international filing date in all the designated countries, conferring the late entry (up to 31 months) to the national offices without affecting the priority date. This is a simple and economical procedure for the applicants seeking protection for their inventions in many countries. Indian Patent office is a Receiving office for International Applications by nationals or residents of India. ((see **Rules 17-23 in Chapter V**))

An international application shall be filed with the appropriate office under Rule(4) in triplicate either in English or in Hindi language

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

An international application (S.2 (1)(ia)), made according to the Patent Cooperation Treaty [(S.2 (1)(oa)], designating India can enter national phase within 31 months from the priority date of international application or date of filing of international application whichever is earlier. This application filed before the Controller in the Indian patent office claiming the priority and international filing date is called PCT National Phase application. Applicant can enter national phase with a request made on a plain paper but Form 1 is preferred by the Indian Patent office during National Phase Entry. The title, description, drawings, abstract and claims filed with the application shall be taken as the complete specification for the purposes of filing in India (S.10 (4A)). The filing date of the application shall be the international filing date accorded under the Patent Cooperation Treaty [S 7(1)(B)].

Although it is obligatory on the part of IB (WIPO) to send pamphlets to the designated offices for convenience and faster processing, the applicant shall submit the necessary documents in duplicate upon entry into national phase. The Patent Office may ask for any other documents, which are necessary in addition to what was submitted along with the application. Certified copies of the priority documents are to be filed within 3 months from the date of communication from the Patent Office. (see more details in Chapter V)

5. Application for Patent of Addition (S.54)

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 / has patent the applicant can go for patent of addition since the invention does not involve a substantial inventive step. It is also possible to convert an independent patent to a patent of addition at a later date if the subject matter was an improvement in or modification to a main invention for which he holds a patent. There is no need to pay separate renewal fee for the patent of addition during the term of the main patent. A Patent of Addition expires along with the main patent unless it is made independent according to the provisions in Section 54

However a Patent of Addition will not be granted unless the date filing of Application was the same or later than the date of filing of the complete specification in respect of the main invention

It should be noted that a patent of addition will not be granted before granting of the patent for the main invention. (see Chapter IX *also*)

5.2.10 SPECIFICATION AND DRAWINGS

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

5.2.11 Provisional Specification (Section 9)

When the applicant finds that his invention has reached a presentable form but not the final shape, he may prepare a disclosure of the invention in the form of a written description and submit it to patent office as a **Provisional Specification** which describes the invention.

A provisional specification helps to establish the priority of the applicant over any other person who is likely to file an application for patent in respect of the same invention being developed concurrently. The applicant also gets twelve months time to fully develop the invention and ascertain its market potential without the fear of losing the priority right over the invention.

Immediately on receiving the provisional specification the patent office accords a filing date for the application and provides a period up to twelve months for filing the complete specification, during which the applicant can fully develop his invention by himself or with the help of others who are interested in the economic value of the patent. No extension of time is permissible for filing complete specification.

5.2.12 Filing Provisional Specification:

The provisional or complete specification is required to be submitted in Form 2 along with the application form 1 and other documents. The first page of the Form 2 should contain-

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

A provisional specification is not a rough draft or a skeleton of the Complete specification. The Complete Specification, which follows a Provisional Specification, does not replace the latter. Both are permanent and separate documents.

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

of Provisional Specification to claim legal right, but, to obtain priority of invention.

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

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

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

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

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

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

5.2.13 Complete Specification

The Complete specification is a techno-legal document which fully and particularly describes the invention and discloses the best method of performing it.

5.2.14 Main Features of Complete Specification

- i) The Complete Specification must be framed with utmost good faith and must not contain any false representation or description of the invention or any material part of it, which would otherwise mislead the public. The Complete Specification must not be framed in ambiguous languages but must be as clear and concise as the nature of the subject would admit.
- ii) The Complete Specification must be intelligible to an ordinary workman possessing the ordinary skill and knowledge of that branch or the useful art to which the invention relates. It is not required to describe the invention and the manner in which it is to be performed so fully as to instruct persons wholly ignorant of the subject matter.
- iii) If the Complete Specification describes anything, which is not new, it must be clearly distinguished from the novel features of the invention
- iv) An amendment by way of modifications and variations of the description if any, must fall within the scope of the description
- v) If the inventor does not disclose all the relevant information or mislead the public or gives a false description of the invention, the patent would be liable to be revoked.
- vi) The detailed description should be supplemented by drawings in all cases in which the inventions are capable of being illustrated.
- vii) It is not enough if a mere list of the various parts that make up the apparatus or device is given. The mode of construction of the apparatus and the function of its different parts should be described.

5.2.15 Filing of Complete Specification:

- i) An Application for Patent is to be filed in Form 1, in duplicate along with requisite fees as given in the First Schedule and should be accompanied by the complete specification in Form 2 and other essential documents in duplicate (Rule 13 & Rule 15)
- ii) The first page of the Form 2 contains -
 - a) Title of the invention,
 - b) Name, address and nationality of each of the applicants for the patent
 - c) Preamble to the description

- iii) The description should start from the second page of Form 2 followed by statement of claims for which protection is sought and end with the date and signature of the Applicant or his authorized agent.
- iv) An abstract should be attached separately to the complete specification. Drawings, if any, referred in the specification shall be submitted along with the specification.
- v) Documents to be attached along with complete specification:
 - a) Statement and Undertaking regarding foreign filing details in respect of the same invention (Form 3) (S. 8(1) & R. 12)
 - b) Declaration as to Inventorship (Form 5) : In case of a convention application, PCT National Phase application and when complete specification is filed after provisional [S.10(6) & Rule 13(6)]. It should be filed within one month from the date of filing.
 - c) Priority Document should be submitted within three months from the date when required by the Controller (S.138(1)). If the document is not in English, then a translated copy should be furnished (S.138(2)).
 - d) **Power of Attorney (Form 26)** (if the application is made through a patent agent) (Rule 135(1))
 - f) **Proof of Right** (if the application is made by the assignee (S.7 (2) & R 10) (Proof right to apply can be produced either in the body of the application (Declaration by the Inventor(s) /Applicant(s) in the convention country in **Form 1**) or by way of separate assignment deed. If the application is made by the legal representative '*death certificate or probate or certificate of inheritance*' of the deceased should be filed as proof of right. ***Proof of right shall be submitted within six months from the date of application.***
 - g) If the applicant wishes, he can request for early publication **on Form 9** along with the prescribed fee.
 - h) A request for examination on **Form 18** along with the prescribed fees should be submitted so that the application is taken up for examination.

5.2.16 International Application [Section 10 (4-A)] :

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

5.2.17 Information and undertaking regarding foreign applications
Statutory provisions: Sec. 8 (1) and (2)Rule12(1)a,(2),

It is the duty of the applicant to inform to the patent office filing particulars of same or similar application for patent filed outside India at the time of filing patent application in India. Further the applicant should keep the office informed of subsequent filing as per the provisions of the act.

Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, **he shall file the following statement and undertaking in Form 3, along with his application or within six months from the date of filing of the application [(S 8(1),R 12(1A)].**

Statement setting out detailed particulars of such application including the name of the country, application number, date of application, status of such application etc.

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

Example:

- International filing date – 20.5.1999
- Date of filing in India – 20.5.2001
- Six months period u/r 12 (1A) is reckoned from 20.5.2001 and not from 20.5.1999.

An undertaking that, up to the date of the grant of patent in India, the applicant would keep the Controller informed in writing, from time to time, the detailed particulars as required under clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India, subsequently to the filing of the statement referred to in the aforesaid clause, **within six months of such filing (R12(2),S 8(1)).**

The date of entry in the national phase shall be mentioned in form 3 against “Date of application” column in case of PCT national phase applications.

The period of six months in case of an application corresponding to an international application is reckoned from the actual date on which the corresponding application is filed in that country and not from the International filing date.

If there is no foreign filing, the applicant can give NIL statement.

As per the amended Act the time period for filing form 3 is six months, which can be extended further by the Controller for a period of 1 month. [**S.8(1), R.(12), R. (138)**]

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

5.2.18 CONTENTS OF COMPLETE SPECIFICATION

Complete Specification is to be filed in the Patent Office along with Application Form 1. Title and preamble of Invention along with name , address, and nationality of the applicant is to be given on the first page of Form 2. Description should start on the next page . Complete Specification should have the following components

- a) Field of Invention.
- b) Use of Invention : A brief statement of the advantages of the invention
- c) Prior Art
- d) Problem to be solved.
- e) Object of Invention(may be more than one)
- f) General statement of invention
- g) Detailed Description of Invention[with reference. to drawings , if any)
- h) Best method /example of working of the invention
- i) Statement of claims.
- j) Signature with date
- k) Drawings
- l) Abstract

1) Preamble:

The following **preamble** should be given on the first page of **Form 2** along with other details like title of the invention, name, address and nationality of the applicant(s):

“ The following specification particularly describes the invention and the manner in which it is to performed”

2) Title

The title should give a fair indication of the art or industry to which the invention relates. It should be brief, free from fancy expressions, free from ambiguity and as precise and definite as possible but it need not go into the details of the invention itself and should be normally within 15 words. It should verbally agree with the title stated in application.

The followings are not allowable in the title : -

a) The inventor's name b) The word 'Patent' c) Words in other languages d) The abbreviation "etc" e) Fancy words, e.g., "Washwell Soap", "Universal Rest Easy Patent Chair".

The following titles do not appear to be objectionable: -

Improved folding chair, Railway rail chair, Improvements in pneumatic tyres, Motorcar differential gear, Filaments for electric lamps etc.

3) Field of the invention

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

4) Prior Art

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

5) Object of the Invention

The purpose of this part is to clearly bring out the necessity of the invention. It shall say clearly the technical problems associated with the existing technology and the solution for that, bringing out the obvious differences between the claimed invention and the prior art.

The solution sought by the invention should be clearly brought out as object (s) of inventions with statements like "*It has already been proposed*"

followed by the objects which the inventions has in view e.g. *“The principal object of this invention is”, “Another object of this invention is”, “A further object of this invention is” etc.*

6) Statement of Invention

The description should include a statement of invention before giving the details of the invention and the method of performing it. The statement should clearly set forth the distinguishing novel features of the invention for which protection is desired.

This part is intended to declare different aspects of the invention in verbatim with the independent claims and to complement the omnibus claim in situations of infringement proceedings.

It usually starts like, *“Accordingly the invention provides an apparatus consisting of ----- which is characterized in that -----“*. Other aspects and processes, if any, can also be stated e.g. *“There is also provided a method of preparing -----” etc.*

7) Detailed Description of Invention (with Reference to drawings, if any)

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

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

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

9) **Mention of Biological Material In Specification :**

- a) If the invention is using biological material, such a material shall be deposited for the completion of the application when such material is not available to the public and can not be described adequately as per the provisions of the act. The deposition shall be made with the International Depository Authority under the Budapest Treaty, on or before the date of filing/priority. The International Depository Authority in India is Microbial Type Culture Collection and Gene Bank (MTCC) – Chandigarh http://ipindia.nic.in/ipr/patent/d_inst_456.pdf.

Note: For further information on Microbial Type Culture Collection and Gene Bank (MTCC) please visit –
<http://wdcm.nig.ac.jp/CCINFO/CCINFO.xml?773>];
<http://www.imtech.res.in/mtcc>.]

- b) Reference of such material shall be made in the specification within three months from the date of filing giving all the available characteristics of the material required for it to be correctly identified or indicated including the name, address of the depository institution and the date and number of the deposit of the material at the institution
- (c) . Further, the source and geographical origin of the biological material specified in the specification also should be disclosed therein
- (d) Sequence listing may also be numbered in the specification if necessary in the case of Biotechnology Inventions.
- (e) Sequence listing should be given in electronic form
- (f) Access to the material is available in the depository institution only after the date of the application of patent in India or after the date of the priority, if a priority is claimed

10) **Best Method of Working :**

The Act specifically requires as per section s10(4)(a) and s 10(4) (b) that the Complete Specification must describe the best method of performing the invention known to the patentee as per all his knowledge relating thereto, including that, which he may have acquired during the period of provisional protection prior to the date of filing the Complete Specification

- 11) Terms in other languages, if any, used in the description should be accompanied by their English equivalents. The use of vague slang words and colloquialisms is objectionable and should be avoided
- 12) Advantages of the invention should be mentioned to bring out clearly the areas of application and preferable use of the invention. The applicant can substantiate

industrial applicability of the invention in this part and call for protection against duplication of invention in the related fields by specifying scope and ambit of the invention.

- 13) If, in any particular case, the Controller considers that an application should be further supplemented by a model or sample of anything such model or sample as he may require shall be furnished before the grant of a patent, but such model or sample shall not be deemed to form part of the specification.

14) Claims

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

15) DRAWINGS

The Complete Specification should be followed by drawings that are referred to in the specification. Drawing should be filed on a standard A4 size sheet in duplicate. Drawing should be preferably drawn in black Indian indelible ink or durable paper with margin of 2.5 cm on each side, in upright position with respect to top & bottom position of the sheet. At left-hand top corner of the sheet the name of the applicant should be mentioned. Total number of sheets and consequential sheet number should be mentioned at the right hand top corner of each sheet. At the right-hand bottom, the signature of the applicant/agent should be given along with the name of signatory there under.

A reference letter/numerals as used in the description should also be used in denoting the corresponding component/part in the figure (s). No descriptive matter should appear on drawings, except under certain cases, such as, flow chart, chemical & other reaction etc. The same letters or numerals should be used in different figures for the same parts. In complicated drawings or when there is no room to write the reference letters in their proper places, the letters should be shown outside the figures and connected by fine lines with the parts to which they refer.

16) Abstract [Sec.10]

- i) An abstract should provide brief technical information on the invention. It should start with the "Title of the invention" and should give concise summary of the invention ,preferably within 150 words, An abstract should be given on a separate page after claim(s).
- ii) It has to be prepared in such a way that one can understand the technical field to which the invention belongs, technical problem

and solution to the problem through the invention and principal uses of the invention.

- iii) If necessary, the most relevant figure of the drawings should also be included along with features of the invention (depicted with reference numbers in brackets) in the abstract, particularly, in case of engineering inventions. Where necessary, the abstract shall contain the chemical formula, which characterises the invention.
- iv) The abstract is supposed to serve as an efficient instrument for the purposes of searching in the particular technical field and to assess whether there is a need to consult the specification itself. However, it cannot be used for the purpose of interpreting the scope of protection in legal proceedings.
- v) The Controller may amend the abstract for providing better information to third parties

~~(v)~~.

~~(iv)~~

5.2.19 Submission of Documents in the Patents Office

- (i) All documents and copies of document to be furnished in the patent office shall be written or typewritten or printed either in Hindi or in English language in large and legible characters with deep indelible ink with lines widely spaced upon one side only of strong white paper of a size A4 with a margin of at least 4 centimetres on the top and left hand part and 3cm on the bottom and right hand part thereof. Any signature which is not legible or which is written in a script other than Hindi or English shall be accompanied by a transcription of the name either in Hindi or in English in block letters (Rule 8)
- ii) In case the application for patent discloses sequence listing of nucleotides and/or amino acids, the same shall be filed in electronic form.
- iii) Leaving and serving documents [Rule 6] ;
 - a) Any application, notice or other document required to be furnished at the patent office may be tendered by hand or sent by a letter addressed to the Controller at the appropriate office through post or registered post or speed post or courier service or by electronic transmission duly authenticated. , it shall be deemed to have been filed, left, made or given at the time when the mail containing the same would have been delivered in the ordinary course
 - b) Any written communication addressed to a patentee at his address on the register of patents or at his address for service or to any applicant or opponent in any proceedings under the Act or these rules, at the address appearing on the application or notice of opposition, or given for service, shall be sent by registered post or speed post or courier service or by electronic transmission duly authenticated except when they are sent by special messenger.

- c) The date of such notice or written communication shall be the date of dispatch
- d) The delay in transmitting or resubmitting a document to the patent office or doing any act by the party may be condoned by the Controller if a petition for such condonation of delay is made by the party to the Controller immediately after the receipt of the document or a communication along with a statement regarding the circumstances of the fact and evidence in support of the statement
- e) Such period of delay condoned by the Controller shall not exceed the period between the date on which the party was supposed to have received the document or communication by ordinary course of mail or electronic transmission and the actual date of receipt of the same.
- f) Usually immediately on receiving the application, patent office accords an application number to it such that the applications filed in a year constitute a series identified by the year of such filing. PCT National Phase applications constitute a different series (**Rule 11**).

5.3 CLAIMS IN COMPLETE SPECIFICATION

5.3.1 General Principles and Object of Claims:

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

(a) Each claim should be in a single sentence and should be clearly and worded

(b) Claim(s) should be succinct and should not involve unnecessary repetition

e(c) A claim (s) should not be verbose.

e(d) A claim is the statement of technical facts expressed in legal terms defining the scope of the invention sought to be protected.

e(e) **No monopoly is obtained for any matter described in the complete specification unless it is claimed in the claims. What is not claimed in the 'claims' stands disclaimed,** and falls open to the public use, even if the matter is disclosed in the description.

e(f) Claims define the boundaries of legal protection sought by the patentee and form a protective fence around the invention which is defined by the words and phrases in the claims.

e(g) The object of claims is **to define clearly the scope of the invention with conciseness, precision and accuracy the monopoly claimed**, so that others may know the exact boundaries of the area of protection in which they should not trespass.

e(h) Their primary object of claims is **to limit and not to extend the monopoly** unduly and, simultaneously, also let others know when they are infringing on the rights of the patentee.

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

5.3.2 Scope of Claims

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

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

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

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

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

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

5.3.4 Features and Characteristics of Claims:

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

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

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

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

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

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

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

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

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

5.3.4 Structure of Claims

i) **A claim usually consists of three parts :**

- **Introductory phrase,**
- **Body of the claim, and**
- **Link that joins the two segments.**

- The introductory phrase identifies the category of the invention and sometimes the purpose (For example, a machine for waxing paper, a composition for fertilizing soil).
- The body of the claim is the specific legal description of the exact invention, which is sought to be protected.
- The linking consists of words and phrases such as :
 - Which comprises
 - Including
 - Consisting of
 - Consisting essentially of
- **If the invention is an improvement to a product** existing in the market, the claims should set the boundary very clearly by characterizing the invention with respect to the prior art. In those cases, the claim will have two parts separated by the word '*characterized by*' or '*wherein*'. **The part coming before '*characterized by*' is the prior art while that comes after will be the features of the invention.** It is equally applicable in the case of a process which is modification of the existing process.

For Example:

In the following example, "A data input device" is the introductory phrase, "comprising" is the linking word, and the rest of the claim is the body.

"A data input device comprising; an input surface adapted to be locally exposed to a pressure or pressure force, a sensor means disposed below the input surface for detecting the position of the pressure or pressure force on the input surface and for outputting an output signal representing said position and; an evaluating means for evaluating the output signal of the sensor means"

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

a) **Independent Claim :**

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

b) **Dependent Claim(s)**

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

- c) Further independent claims are only justified where the inventive concept covers more than one category, e.g. apparatus, process, product, complementary versions within one category constituting unity of invention, e.g. plug and socket, transmitter and receiver, which work only together.

Therefore, wherever possible, claims should not contain:--

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

⊕

d) Omnibus Claim :

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

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

Example of Claims :

⊕(a) “An apparatus for catching mice comprising, a base member for placement on a flat surface, a spring member...”

e(b) “A chemical composition for cleaning windows which comprises 10-15% ammonia...”,

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

1. An umbrella tent frame having plurality of legs, -each leg comprising a lower portion, an upper portion, and a pivot connector interconnecting the lower and upper portions; a clevis assembly comprising an upper clevis members, a lower clevis member, and stop means supported by the lower clevis member and projecting toward the upper clevis member and constructed and arranged to engage the upper clevis member to limit movement of the lower clevis member toward the upper clevis member; a plurality of radial pivot members each fixed to a different one of the upper leg portions; and a plurality of brace members each having one end pivoted to one of the radial pivot members and the other end pivoted to the lower clevis member; wherein the leg portion have transverse cross sections in the form of a rectangle with longer sides and shorter sides, the longer sides of the cross sections of the lower leg sections extending toward the interior of the tent frame when the frame is erected.
2. Umbrella as defined in claim 1, wherein the shorter sides of the cross sections of the upper leg portions extend toward the interior of the tent frame when the frame is erected, whereby the upper leg portions could bend more freely toward the upper clevis member as the tent frame is erected.
3. Umbrella as defined in claim 2, wherein the pivot connectors interconnecting the lower and upper leg portions are each in the form of an integral polymeric piece of generally U-shaped transverse cross section and the side walls thereof include portions spaced more closely together to accommodate the lower leg portion and portion spaced more widely to accommodate the upper portion.
4. An umbrella tent of claim 3 wherein said upper clevis member comprises a downwardly opening socket adapted to receive a post member extending from the lower clevis member.
5. An umbrella tent of claim 2 wherein said upper clevis member comprises a downwardly opening socket adapted to receive a post member extending from the lower clevis member.
6. An umbrella tent frame of claim 1 wherein said lower leg portions further comprise means to engage a floor portion of a tent when the tent frame is erected.
7. An umbrella tent of claim 6 wherein said upper clevis member comprises a downwardly opening socket adapted to receive a post member extending from the lower clevis member.
8. An umbrella tent frame of claim 1 wherein said clevis members are molded from polymeric material.

9. An umbrella tent of claim 8 wherein said upper clevis member comprises a downwardly opening socket adapted to receive a post member extending from the lower clevis member.
10. An umbrella tent frame comprising a plurality of legs each including a lower portion and an upper leg portion, the leg portions having transverse cross sections in the form of a rectangle having longer sides and shorter sides, the lower and upper leg portions being pivotally interconnected with the longer sides of their cross sections at right angles to each other. **(Independent claim)**
11. An umbrella tent frame of claim 10 further comprising a clevis assembly comprising an upper clevis member and a lower clevis member, and wherein the upper leg portion is connected to the upper clevis member, and wherein the shorter sides of the cross sections of the upper leg portions extend toward the interior of the tent frame when the frame is erected, whereby the upper leg portions can bend more freely toward the upper clevis member as the tent frame is erected.
12. An umbrella tent frame of claim 11 further comprising pivot members interconnecting the lower and upper leg portions and wherein the pivot connectors interconnecting the lower and upper leg portions are each in the form of an integral polymeric piece of generally U-shaped transverse cross section and the side walls thereof include portions spaced more closely together to accommodate the lower leg portion and a portions spaced more widely to accommodate the upper leg portion.
13. An umbrella tent frame of claim 11 wherein said clevis members are molded from polymeric material.
14. An umbrella tent of claim 11 wherein said upper clevis member comprises a downwardly opening socket adapted to receive a post member extending from the lower clevis member.
15. An umbrella tent frame of claim 10 wherein said lower leg portions further comprise means to engage a floor portion of a tent when the tent frame is erected

5.3.6 Claim Specimens:

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

i) Indian Specification No. 39285.

Title – “Wrapper for a package and method of preparing the same”.

“We claim :-

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

ii) Indian Patent Specification No.38069.

Title – “Improvements in or relating to gramophone records.

“We claim :-

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

iii) [Indian Patent Specification No. 34515.

Title- “Improvements in or relating to tin Openers”.

“We claim,

1. A tool for opening metal containers, the tool comprising a spindle spit throughout its length, means for rotating the spindle, means on spindle for guiding the tool during an opening operation, which means also serves to facilitate the removal of the waste metal coiled around the spindle, and further means on the spindle for preventing the distortion of the spindle during and opening operation.
2. A tool according to Claim I, wherein the means for guiding the tool and facilitating the removal of the waste metal and the means for preventing the distortion of the spindle comprise two separate plates slidably and removable mounted on the spindle”.

5.3.7 How to Assess Clarity of Claims ?

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

i) Example: 1

A structure comprising a semiconductor substrate made of silicon, said structure further characterized by comprising a near-amorphous film comprising ZrO₂.

Here the claim does not have a precise or well-recognized meaning for a skilled person. The term 'near-amorphous' used in the claim is vague and unclear and leaves the reader in doubt as to the meaning of the technical feature to which it refers, thereby rendering the definition of the subject-matter of said claim unclear.

ii) Example:2

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

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

iii) Example:3

A digital photo-camera comprising a VLSI processing unit and a CCD image sensor, characterized in that it is adapted to operate at temperatures down to 200 K.

The camera is defined in terms of the object to be achieved (operation at very low temperatures) rather than in terms of the technical features (e.g. selected semiconductor materials, thermal insulation, etc.) that achieve the desired object.

The claim attempts to define the subject matter in terms of the result to be achieved. In this instance, however such formulation is not allowable because it appears possible to define the subject-matter in more concrete terms, i.e. in terms of how the effect is to be achieved.

iv) Example:4

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

specification does not sufficiently and clearly describe the invention. The opponents, accordingly, have established this ground.

5.3.8 Markush -Type Claims

A Markush claim refers to a chemical structure by means of symbols indicating substituent groups. In such a claim, one or more parts of the claimed compound comprise multiple functionally equivalent chemical entities

Example:

“The process for the manufacture of dyes which comprise coupling with a halogen substituted pyrazolone, a di-azotized unsulphonated material selected from the group consisting of aniline, homologues of aniline and halogen substitution products of aniline.”

Markush type claims allow important innovations to be patented. For example, when a new organic compound, that has a novel structure never obtained before, is invented and can have many possible substituents that could be used, one can effectively group these possible substituents in a Markush type of claims. So one can claim the basic structure along with substituents like halogens, alcohols, hydrocarbons, etc. However, such group of compounds are allowable when supported by a single and definitive process.

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

5.3.9 Certain Statements not be regarded as claims:

- i) The statements of the following form given are not to be regarded as claims, in as much as, they do not define the invention:-
 - a) I claim to be the inventor of this appliance,
 - b) I claim a patent and that no one else shall use my invention without leave.
 - c) I claim that the machine described above is quite new and has never been seen or used before.
 - d) I claim some reward.
- ii) Also, the claims should not be made, as in the examples given below, for illustrating the efficiency or advantages of the invention:-
 - a) I claim that this device is better and cheaper and more effectual than anything known.
 - b) I claim that my process or machine will do such and such things

- c) I claim the following advantages.
 - d) I claim an improved sewing machine
 - e) I claim a mechanism for converting heat into electrical energy without any loss of efficiency.
 - f) I claim a new method of making silk waterproof.
- iii) Where products are claimed, the invention will not be properly defined if merely the properties of the products are referred to, as in the following example:-
- “I claim a lubricating oil which is of specific gravity.... and boiling point.”
- iv) The claims, such as “I claim an improved sewing machine as described or as illustrated ”or “ I claim the invention described in the specification”, which merely refer back to the description are not sufficiently definitive unless the description contains an explicit statement of distinguishing features which are characteristics of the invention.

5.3.10 UNITY OF INVENTION: S 10(5)

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

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

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

e(c) a claim for a product, claim for a process specially adapted for manufacture of the product and claim for an apparatus or means specifically designed for carrying out the process.

However , the above criteria can not be generalized and there may be occasions where all such claims may not be allowed in a single application based on the circumstances of the case.

Example:1

“ A mould for casting an article, a method of making that mould, a process of casting the article by using the said mould and the article will constitute a single inventive concept”.

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

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

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

Example:2

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

Example:3

If one has invented a new kind of spray bottle, the invention can be claimed in the same application for :

- (a) The spray bottle itself (a product)
- (b) Method of making the spray bottle (a process)
- (c) Apparatus used for making the said spray bottle

Example:4

When a genetically modified Gene Sequence/ Amino Acid Sequence is novel, involves an inventive step and has industrial application, the following can be claimed.

- (a) Gene sequence / Amino Acid sequence
- (b) A method of expressing above sequence
- (c) An antibody against that protein / sequence
- (d) A kit made from the antibody / sequence

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

Example:5

A drug or pharmaceutical product, if it is novel, inventive and has industrial application, can be claimed for the following:

- (a) a drug or pharmaceutical product,
- (b) modified drug or pharmaceutical of a known compound, if proved to be more efficacious than the known compound
- (c) a process of making the product as defined in (a) or (b).
- (d) formulation containing the drug (a) or (b)

Example:6

In case of a herbal, chemical or pharmaceutical or a medicinal composition the following can be claimed:

- (a) a product by itself, if it is novel
- (b) a process of extraction and/or process of mixing the ingredients either pre-prepared or extracted.
- (c) Apparatus, if novel, either for the process of extraction and/or for the process of preparation.

Example:7

In case of non-drug or non-pharmaceutical chemical, the following can be claimed:

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

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

Example:8

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

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

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

<http://www.wipo.int/pct/guide/en/gdvoll/pdf/gdvoll.pdf>

5.4.1 SUFFICIENCY OF DISCLOSURE

- i) The Complete Specification describing the invention is a techno-legal document. It should disclose the invention completely to meet the requirement of the Patents Act and should also enable a person possessing average skill in the art to work the invention without assistance of the patentee . This is possible when the complete specification describes the invention fully and particularly and

describes its operation and/or method by which it is to be performed. It is also essential that the best method for performing the invention, which is known to the applicant is disclosed in the Complete Specification . [S. (10)(4)].

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

Example:1

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

Example:2

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

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

5.4.2 Clarity of Disclosure :

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

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

- ii) Since disclosure of the invention is the consideration in return for which the applicant is granted a monopoly the highest degree of good faith is called for, and the disclosure should be clear, precise, honest and open. A designedly ambiguous description or one that is wanting in distinctness, either by negligence or unskillfulness, will invalidate a patent (*British Ore Concentration Syndicate Ltd v Minerals Separation Ltd*, 27 RPC 47; *Cincinnati Grinders (Inc) v BSA Tools Ltd* 48 RPC 33).
- iii) A specification should not contain superfluous or irrelevant matter (*Francis' Application*, 27 RPC 87).
- iv) Complicated mathematical calculations and analyses are undesirable unless they are necessary to a full understanding of the invention. The curtailment of an inordinately long specification may be requested (*LD Corporation's Applications*, 66 RPC 4), but this should be done only in the most extreme cases.
- v) The description should not contain passages which confuse the scope of the invention. Therefore, phrases such as “the invention should be taken to include any modifications, whether novel or not...” are unacceptable.
- vi) Where particular description or drawings do not exemplify the invention claimed, for example, where they are included by way of explaining the invention or for comparison or where they relate to prior art, the description should make this clear.

5.4.3 Technical or Specialized Terms

- i) The description should be as clear and straightforward as possible, with the avoidance of unnecessary technical jargon. Since it is addressed to persons skilled in the art, it will be desirable that for its use by him the technical terms which are well known in that art should be used.
- ii) Little known or specially formulated technical terms may be used provided they are adequately defined and that there is no generally recognised equivalent.
- iii) Foreign terms may be used where there is no English equivalent.

- iv) Terms already having an established meaning should not be used differently, if this is likely to cause confusion. But in some circumstances it may be appropriate for a term to be borrowed from an analogous art.
- v) If a specification contains a reference to a proprietary article or specific product, the composition of which is not well known, the description should state the composition of the article or the way in which it is prepared. If the applicant maintains that the information is well known in the art, or if the specification so states, and the examiner is unable to verify this, evidence in support of the contention may be required.
- vi) The use of proper names or similar words to refer to materials or articles is undesirable in so far as such words merely denote origin, or where they may relate to a range of different products. The product should be sufficiently identified, without reliance on the word, to enable the invention to be carried out by the skilled person. Such words which have generally accepted meanings as standard descriptive terms may however be used without further explanation; examples are Bowden cable, Belleville washer, zip fastener.
- vii) A trade mark should not be used in a specification since it is an indication of origin rather than of composition or content and on that account cannot properly be used to describe an article. If a registered trade mark is used it should generally be accompanied by wording showing that it is a trade mark, since its use as a descriptive term without acknowledgement may be prejudicial to the rights of its owner .

5.4.4 COMPLETENESS OF DISCLOSURE

- i) At least one embodiment of the invention or at least one method of performing the invention must be described. However, where the claims cover a broad field several examples or alternative embodiments or variations extending over the area to be protected by the claims may be necessary.
- ii) The disclosure must be sufficient to enable whole width of the claimed invention to be performed. It was held that the disclosure of a single embodiment will not always satisfy the requirement regardless of the width of the claim [*Biogen Inc v Medeva plc* [1997] RPC 1].
- iii) It was held in *Kirin-Amgen Inc v Hoechst Marion Roussel* [2005] RPC 9 that whether the specification is sufficient or not was highly sensitive to the nature of the invention. To determine this question, the first step was to identify the invention and decide what it claimed to enable the skilled man to do. It was then possible to ask whether the specification enabled him to do it.
- iv) In *Minnesota Mining & Manufacturing Co's (Suspension Aerosol Formulation) Patent* [1999] RPC 135 it was held that a specification is

also insufficient if it provides no teaching relating to the criteria according to which the skilled man is taken to be using the invention.

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

5.4.5 General Guidelines For Applicant for Filing

It is a common experience that through ignorance of patent law, inventors act indiscreetly and jeopardize the chance of obtaining patents for their inventions.

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

After filing of patent applications, the applicant can use his invention commercially. However, provisional protection against infringement starts from the date of publication only. Express publication of the patent application is possible before the prescribed 18 months period under Sec. 11(A)(2) by filing a request for early publication in Form 9 along with the prescribed fees. The protection is provisional because an infringement suit can be filed only after the grant of a patent.

It is in the interest of an inventor/applicant to access the relevant prior published patent literature and other non-patent information on the subject-matter of his application already in the public domain before filing patent application so as to get the complete idea about prior art for his invention. This will provide great help in drafting the specification in a correct manner, to claim the full scope of the invention desired to be protected in an appropriate manner.

Another mistake, which is frequently made by inventors, is to wait until their inventions are fully developed for commercial working, before applying for patents. Delay in making application for a patent involves risks, namely, (i) that other inventors might forestall the first inventor in applying for the patent, and (ii) that there might be either an inadvertent publication of the invention by the inventor himself, or the publication thereof by others independently of him. It is, therefore, advisable to apply for a patent as soon

as the inventor's idea of the nature of the invention has taken a definite shape. In this connection inventors should note that it is permissible to file an application for a patent accompanied by a "Provisional Specification".

The inventors should not neglect to get clarification of their rights with reference to those of their employers, co-workers, contractors and assistants, if any, with whom they are brought into contact in the course of the development of their inventions. Negligence on this account may lead to loss of right and costly litigation.

5.4.6 INTERNATIONAL APPLICATIONS UNDER PCT

Relevant Sections and Rules:

Section 10(4)A:

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

Rule 17 : Definitions:

In this Chapter, unless the context otherwise requires:

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

Rule 18: Appropriate office in relation to international applications:

- (1) *The receiving office, designated office and elected office for the purposes of international applications filed under the Treaty shall be the appropriate office in accordance with rule 4.*
- (2) *The head office of the patent office shall be the appropriate office for dealing with the International Bureau of the World Intellectual Property Organisation, International Searching Authorities and International Preliminary Examining Authorities.*
- (3) *An international application under the Treaty shall be filed at and processed by the appropriate office in accordance with the provisions of this Chapter, the Treaty and the regulations established under the PCT.*
- (4) *Notwithstanding anything contained in sub-rule (2), on receipt of an international application, the appropriate office shall transmit one copy as record copy of such application to International Bureau of the World Intellectual Property Organisation and another copy as search copy to Competent International Searching Authority. The appropriate office shall simultaneously furnish complete details of such application to the head office of the patent offices.*

Rule 19. International applications filed with appropriate office as receiving office:

- (1) *An international application shall be filed with the appropriate office in triplicate either in English or in Hindi language.*
- (2) *The fees payable in respect of an international application filed with the appropriate office shall be, in addition to the fees as specified in the regulations under the Treaty, the fees as specified in the First Schedule.*
- (3) *Where an international application filed with the appropriate office has not been filed as specified under sub-rule (1) and the applicant desires that the appropriate office should prepare the additional copies required, the fee for making such copies shall be paid by the applicant.*
- (4) *On receipt of a request from the applicant and on payment of the prescribed fee by him, the appropriate office shall prepare a certified copy of the priority document and promptly transmit the same to the International Bureau of the World Intellectual Property Organisation for the purpose of an international application filed with the appropriate office with an intimation to the applicant and the head office.*

Rule 20. International applications designating or designating and electing India:

- (1) *An application corresponding to an international application under the Patent Cooperation Treaty under section 7(1 A) may be made in Form 1.*
- (2) *The Patent Office shall not commence processing of an application filed corresponding to international application designating India before the expiration of the time limit prescribed under sub-rule (4)(i).*
- (3) *An applicant in respect of an international application designating India shall, before the time limit prescribed in sub-rule (4)(i),—*
 - (a) *pay the prescribed national fee and other fees to the patent office in the manner prescribed under these rules and under the regulations made under the Treaty;*
 - (b) *and where the international application was either not filed or has not been published in English, file with the patent office, a translation of the application in English, duly verified by the applicant or the person duly authorised by him that the contents thereof are correct and complete.*
- (4) (i) *The time limit referred to in sub-rule (2) shall be thirty one months from the priority date as referred to in Article 2(xi);*
 - (ii) *Notwithstanding anything contained in clause (i), the Patent Office may, on the express request filed in Form 18 along with the fee specified in First Schedule, process or examine the application at any time before thirty one months.*
- (5) *The translation of the international application referred to in sub-rule (3) shall include a translation in English of,—*
 - (i) *the description;*
 - (ii) *the claims as filed;*

- (iii) *any text matter of the drawings;*
 - (iv) *the abstract; and*
 - (v) *in case the applicant has not elected India and if the claims have been amended under Article 19, then the amended claims together with any statement filed under the said Article;*
 - (vi) *in case the applicant has elected India and any amendments to the description, the claims and text matter of the drawings that are annexed to the international preliminary examination report.*
- (6) *If the applicant fails to file a translation of the amended claims and annexure referred to in sub-rule (5), even after invitation from the appropriate office to do so, within a time limit as may be fixed by that office having regard to the time left for meeting the requirements, the amended claims and annexure shall be disregarded in the course of further processing the application by the appropriate office.*
- (7) *The applicant in respect of an international application designating India shall when complying with sub-rule (3), preferably use Forms set out in the Second Schedule before the appropriate office as designated office.*

Rule 21. Filing of priority document:

- (1) *Where the applicant in respect of an international application designating India has not complied with the requirements of paragraph (a) or paragraph (b) of rule 17.1 of the regulations under the Treaty, the applicant shall file with the patent office the priority document referred to in that rule before the expiration of the time limit referred to in sub-rule (4) of rule 20.*
- (2) *Where priority document referred to in sub-rule (1) is not in the English language, an English translation thereof duly verified by the applicant or the person duly authorised by him shall be filed within the time limit specified in sub-rule (4) of rule 20.*
- (4) *Where the applicant does not comply with the requirements of sub-rule (1) or sub-rule (2), the appropriate office shall invite the applicant to file the priority document or the translation thereof/ as the case may be, within three months from the date of such invitation, and if the applicant fails to do so, the claim of the applicant for the priority shall be disregarded for the purposes of the Act.*

Rule 22: Effect of non-compliance with certain requirements:

An international application designating India shall be deemed to be withdrawn if the applicant does not comply with the requirements of rule 20.

Rule 23: The requirements under this Chapter to be supplemental of the regulations, etc., under the Treaty:

- (1) *The provisions of this Chapter shall be supplemental to the PCT and the regulation and the administrative instructions made there under.*

- (2) *In case of a conflict between any provisions of the rules contained in this Chapter and provisions of the Treaty and the regulations and the administrative instructions made there under, the provisions of the Treaty and the regulations and administrative instructions made there under shall apply in relation to international applications.*

5.4.7 Introduction: The Patent Cooperation Treaty is an agreement for international cooperation in the field of patents. It is the most significant advancement in international cooperation in this field since the adoption of the Paris Convention itself. It is, however, largely a treaty for rationalization and cooperation with regard to the filing, searching and examination of patent applications and the dissemination of the technical information contained therein. The PCT does not provide for the grant of “international patents”. The task and responsibility for granting patents remains exclusively in the hands of the Patent Offices of, or acting for, the countries where protection is sought (the “regional Offices”). PCT is a special agreement under the Paris Convention open only to states, which are members of the Paris convention and is administered by International Bureau (IB) under World Intellectual Property Organization (WIPO), Geneva.

On 7th September 1998, India deposited its instrument of accession to the PCT and on 7th December 1998 thus became a member of the PCT, as the 98th Contracting State of PCT. The Patent Offices at Kolkata, Mumbai, Chennai and New Delhi are receiving the PCT applications.

5.4.8 Principal Objectives Of The PCT

The principal objective of the PCT is to simplify the patent system over the previously established means of applying for patent protection in several countries for inventions and to render it more effective and more economical in the interest of the users and the national patent offices, that have responsibility for administering PCT. Before introduction of the PCT system, virtually the only means by which protection of an invention could be obtained in several countries was to file a separate application in each country. Each of the application is dealt with in isolation, and thus, involves repetition of the work of the filing and examination in each country.

5.4.9 PCT facilitates the following in order to achieve the objectives:

1. establishes an international system which enables the filing of a single application with a single Patent Office (“Receiving Office”), or the “International Application”, in one language, having effect in each of the countries which are party to the PCT which the applicant names (“designates”) in his application;
2. provides the formal examination of the International Application by a single Patent Office: the Receiving Office;
3. subjects each International Application to an international search which results in a report, citing the relevant prior art (published patent documents and other publications, relating to previous inventions) which may have to be taken into account in deciding whether the invention may be patentable; that report is

made available first to the applicant and is later published; An exhaustive written opinion on patentability is also provided by ISA.

4. provides centralized international publication of International Applications along with the related international search reports including written opinion, declaration, priority document, translation, international examination report, as may be applicable to the particular application.

5. provides the option of an international preliminary examination of an international application, which enables national offices to decide whether or not to grant a patent to the applicant.

5.4.10 International Application

The procedure described under PCT involves two steps of processing the international application. The “International Phase” deals with conducting the search and allowing the applicant to amend the claims, if required. It also optionally deals with the international preliminary examination. Thereafter, the applicant has to enter the national phase (within the prescribed time limits). The grant of patent is the task of the designated / elected offices, that is, the national offices or regional offices.

Under the PCT system, by the time the International Application reaches the national / designated Office, it has already been searched by the International Searching Authority and possibly examined by an International Preliminary Examining Authority, thus providing the national Patent Offices with the important benefit of reducing their work loads since they have the benefit of these international phase centralized procedures and, thus, need not duplicate those efforts. Further, objectives of the PCT are to facilitate and accelerate access by industries and other interested sectors to technical information related to inventions and to assist developing countries on gaining access to technology.

5.4.11 Functions of the Receiving Offices

1. Receiving Offices receive the International Application from the applicant or from his authorized Agent.
2. Then the Receiving Office checks the International Application to determine whether it meets the prescribed requirements as to form and content of International Applications. This check is of a formal nature only and does not go into the substance of the invention. It therefore extends only to a certain number of rather elementary requirements specified in the Treaty as forming part of that check.
3. a) If the requirements of article 11 viz nationality / residence, language, format of the specification etc are fulfilled, then the international application number is allotted on the date of receipt of the application.

- b) The receiving office shall accord as the international filing date; the date of receipt of the international application, provided the application is in order in accordance with Article 11 of PCT, at the time of receipt.
 - c) If the receiving office finds that the international application did not, at the time of receipt, fulfill the requirements listed in paragraph (a), it shall, as provided in the Regulations, invite the applicant to file the required correction(s).
 - d) If the applicant complies with the invitation, as provided in the regulations, the receiving office shall accord as the international filing date, the date on which the corrected copy is submitted.
4. Receiving Office checks certain formal and physical requirements (Article 14) as to form and content and whether the fees are not, or not fully, paid. In that case, the Receiving Office communicates with the applicant in order to give him an opportunity to correct any defect.
 5. If after correction, if any, the international application meets the requirements of article 14, the Receiving office accords the International filing date.
 6. If the language of filing of the International Application is the one acceptable by the Receiving Office but not acceptable by the International Searching Authority to carry out international search, the applicant is required to furnish, within one month from the filing date of the application, the translation into a language among the following:
 - a language accepted by the International Searching Authority to carry out international search;
 - a language of publication; and
 - a language accepted by the Receiving Office (unless the International Application is filed in a language of publication).

In cases, where the applicant fails to furnish, within the applicable time limit, a translation for the purpose of international search, the Receiving Office invites the applicant to furnish the missing translation, in certain cases subject to the payment of a late furnishing fee. A separate invitation procedure is provided for the case where the request does not comply with language requirements. Where the applicant does not furnish the missing translation within the time limit fixed in the invitation, the International application will, subject to certain safeguards for the applicant, be considered withdrawn and the Receiving Office will so declare.

7. Not all the requirements of the International Application are required to be examined by the Receiving Office. For instance, the Receiving Office does not deal with substantive questions such as whether the disclosure of the invention in the application is sufficient and whether the requirement of unity of invention is complied with. It also does not check all the many detailed physical requirements of the International Application. Those requirements are only checked to the extent that compliance with such requirements is necessary for the purpose of reasonably inform international publication.

8. Typical examples of defects, which may be corrected without affecting the international filing date, are:
 - Non – payment or partial payment of fees;
 - Lack of signature of the request;
 - Lack of a title of the invention;
 - Lack of an abstract;
 - Physical defects.
9. In all such cases, lack of correction leads to the application being considered withdrawn, except where a physical defect would not prevent reasonably uniform international publication and except for the payment of fees. With regard to the later, PCT rule 16 bis provides that the Receiving Office must invite the applicant to pay the missing fees together with a late payment fee. If the applicant still does not pay the fees within the time limit fixed in the invitation, the Receiving Office will declare that the International Application is being considered withdrawn. This solution protects the applicant against any loss of his application due to an erroneously delay or incomplete payment of fees.
10. The next step in the procedure before the Receiving Office is that it must transmit the “*record copy*” of the international Application to the International Bureau and the “*search copy*” to the International Searching Authority. The Receiving Office keeps a third copy, the “*home copy*”. The transmittals do not take place if, and as long as, national prescriptions concerning national security apply. The Receiving Office will then declare that national security provisions prevent the International Application from being treated as such.
11. The Receiving Office must mail the record copy promptly to the International Bureau and in any case not later than five days prior to the expiration of the 13th month from the priority date. In many cases, the International Application claims the priority of an earlier national application and is filed at the end of the 12-month priority period; the Receiving Office has only a few weeks for its processing tasks.
12. The search copy must be transmitted by the Receiving Office to the International Searching Authority at the time of the transmittal of the record copy of the International Bureau except, where the search fees has not been paid on time, in which case, the transmittal of search copy takes place after that fee has been paid.
13. If an applicant, who is a resident or national of a PCT Contracting State, erroneously files his International Application with a national office which acts as a Receiving Office under the Treaty but which is not competent under Rule 19.1 or 19.2, having regard to **the applicant’s residence and nationality**, to receive that International Application, or if an applicant files his International Application with the competent Receiving Office in a language which is not acceptable by that Office under Rule 12.1 (a) but is in **a language** accepted under that Rule by the International Bureau as Receiving Office, the International Application will be considered to have been received by the national Office on behalf of the International Bureau as Receiving Office on the date ,on which it was received by the national office, and will be promptly transmitted to the International Bureau as Receiving Office (unless such transmittal is prevented by national security prescriptions). The transmittal may be subjected by the National Office to the

payment of a fee equal to the transmittal fee. All other fees, already paid to that Office, will be refunded by that Office to the applicant and the applicable fees will have to be paid to the International Bureau as Receiving Office.

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

- i) Prerequisite: A permission u/s 39 to file an application outside India should have been obtained or an application should have been filed at least six weeks earlier than the international (PCT) application and no secrecy direction should have been given u/s 35 before filing a PCT application.
- (ii) The applicant should be resident or national of the Contracting State for which the Receiving Office acts, and has consequently the right to file with that Receiving Office (note, however, that the International Application is to be transmitted to the International Bureau as Receiving Office under Rule 19.4(a)(i), if that condition is not fulfilled);
- iii) The International Application should be in English or Hindi (note, however, that the International Application is to be transmitted to the International Bureau as Receiving Office under Rule 19.4(a)(ii), if that condition is not fulfilled
- (iv) The International Application should contain at least the following elements:
 - (a) an indication that it is intended to be an International Application,
 - (b) filing the request that constitutes the designation of all contracting states bound by the PCT for the grant of every kind of protection available and for the grant of both regional and national patents,
 - (c) the name of the applicant in a form allowing the applicant's identity to be established, the inventor (normally) and the agent (if any)
 - d) a part which on the face of it appears to be a description,
 - (e) a part which on the face of it appears to be claim or claims.
- (v) If one of these requirements is only complied with after correction, the international filing date will be the date on which the correction was received. In other words, in these cases a defect, which is corrected later, affects the international filing date. If all such defects are not properly corrected, the application will not be treated as an International Application.
- (vi) For all the other cases, non-compliance with the formal requirements does not affect the international filing date. In other words, if the applicant corrects a defect in such cases, the international filing date remains unchanged. If the applicant does not correct, the defect properly, the International Application will, however, be considered withdrawn by the Receiving Office. Extension of the time limit fixed by the Receiving Office for the correction of defects under Article 14 may be requested.

5.4.13 Monitoring of time limits

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

- (i) Monitoring the time limits for payment of fees;
- (ii) Checking the notification (Form PCT/IB/301) from the International Bureau for confirming the receipt of the record copy.
- (iii) Deciding, after the receipt of the international search report, whether or not to file amended claims under Article 19, within the applicable time limit.
- (iv) Monitoring the receipt, during the 19th month from the priority date, of the notice from the International Bureau (Form PCT /IB / 308) that the publication of the International Application has been effected.
- (v) Deciding, after receipt of the international search report, whether or not to file a demand for international preliminary examination (which must be filed prior to the expiration of 22 months from the priority date.)
- (vi) Entering the national phase before the expiration of 20/21 or 30/31 months from the priority date or international filing date, whichever is earlier, by paying the national fees and furnishing (if required) a translation of the International Application with duly verified for its correctness and completeness.

5.4.14 Filing of the International Application:

a) Request form (PCT / RO / 101)

1. International Application must be filed with any of the receiving offices i.e Patent office, Kolkata (RO/IN), New Delhi Mumbai, and Chennai or International Bureau (RO/IB) of WIPO. The request form and the documents attached therewith should be in triplicate. An application for the same invention has to be filed in India not less than six weeks before filing the International application or necessary permission under section 39 should be taken before filing the international application. The request for permission (U/S 39) for making patent application outside India including PCT international application should be made in form 25 with the prescribed fee as given in First Schedule (sub rule 1 of rule 71) and the Controller shall dispose the said request ordinarily within a period of 21 days from the date of filing of such request (sub rule 2 of rule 71).

2. The International Application must contain a request, a description, one or more claims, one or more drawings (where required) and an abstract; it must comply with the prescribed physical requirements; it must be in one of the prescribed languages; finally, the required fees must be paid. These requirements will be dealt with one by one.

3. The **Request** may be made on Form PCT / RO / 101, copies of which can be obtained free of charge from the Receiving Office or from the International Bureau of WIPO or can be downloaded from WIPO website. The request may also be presented as a computer printout as prescribed by Section 102(h) of the PCT Administrative Instructions or, alternatively, as a computer printout prepared using the PCT-EASY software, in which case it must be accompanied by a computer diskette containing a copy of the data as contained in the request in electronic form and copy of the abstract

4. The request must, first of all, contain a petition, that is, a request that the International Application be processed according to the PCT. It must further contain the title of the invention with necessary data concerning the applicant, the inventor and the agent representing the applicant. It must be signed by the applicant or his agent. Declaration of inventorship should be signed by the inventor(s) / the applicants in convention country as applicable and not by the agent. Where there are two or more applicants, each applicant must sign at his choice either the request or, if the request is signed by an agent, a separate power of attorney. The request should also contain details of priority (where applicable) and an indication of competent International Searching Authority.

5. The request may contain some optional indications, in particular, a priority claim according to the Paris Convention for the Protection of Industrial Property.

b) Priority

1. A certified copy is required for each priority of the application and the same is to be furnished within 16 months from the priority date; The copies for the designated offices are prepared by the International Bureau at no additional cost to the applicant –.

2. A request for transmittal of a copy of the priority document filed with the Receiving Office, by the Receiving Office to the International Bureau, can be made in the Request Form and the applicable fee for a priority document paid to the Receiving Office.

c) Description

1. The description of the invention in the International Application must disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art.

2. The description initially defines the field of invention. It then specifies pertinent technical field to which the invention relates. It indicates the so-called “background art”, that is, the technical and, in particular, patent literature, pertaining to that technical field, constituting the “prior art” or “state of the art” or known technology for the newly filed application. It discloses the invention in a way, which allows the technical problem and its solution to be understood. It states the advantageous effects of the invention as compared with the known technology. It briefly describes the figures in the drawings. It sets forth the best mode contemplated by the applicant for

carrying out the invention and any other mode he wants to include. Finally, it indicates the way in which the invention is capable of exploitation in industry.

d) Sequence Listing:-

Section 806 of PCT allows a designated Office to require that a copy of a sequence listing part filed only on an electronic medium under new Section 801 be furnished, on paper for the purposes of the national phase.

1. For the applicants who do not wish to file the sequence listing part of their international applications under new Section 801, the current provisions will continue to apply, including the filing in written form only (under Rule 5.2) and the concurrent or subsequent furnishing, as provided under PCT Rule 13ter and Section 208, of the sequence listing parts in computer readable form but only for the purposes of International search and / or international preliminary examination. In such cases the current system for calculating the basis fee, on the basis for the total number of sheets of the international application including the sequence listing part, will continue to apply (see item 1(b) of the Schedule of Fees).

2. It is important to note that international application filed under new section 801 may only be filed with receiving Offices, which are prepared to accept them, and on such electronic media specified by the receiving Offices (for further details pl. See PCT Applicant's Guide).

e) Claims:

1. The claims must define the subject matter of the invention for which protection is sought. They must be clear and concise and fully supported by the description.

2. With respect to the structure and drafting of claims, the PCT requirements are largely similar to what is accepted in most Patent Offices.

f) Drawings:

The drawings are only required where they are necessary for the understanding of the invention. This will be the case for example for an engineering type of invention. It will not be the case when an invention cannot be drawn, as is the case for a chemical product. Here again, the requirements are similar to those of most Patent Offices.

g) Abstract:

1. The abstract is intended to serve the purpose of technical information. The treaty says clearly that it cannot be taken into account for any other purpose. This means in particular that it cannot be used for the purpose of interpreting the scope of the protection sought.

2. The abstract consists of a concise summary of the disclosure of the invention as contained in the description, claims and drawings in preferably within 50 to 150 words. It must be drafted in a way, which allows the clear

understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use of the invention.

h) Language of filing

1. The international Application must be filed in the language, or one of the languages, which the Receiving Office accepts for that purpose (Rule 12.1(a)). If the application is filed in any receiving office in India it has to be either in English or Hindi.

Neither the Treaty nor the Regulations enumerate the languages in which International Applications may be filed. Whether a given language can be used depends on the readiness of the Receiving Office to accept International Applications in that language. Each Receiving Office must, however, accept at least one language for the filing of International Applications, which is both a language accepted by at least one international Searching Authority, competent for the international searching of International Applications filed with that Receiving Office and one of the language of publication (that is, Chinese, English, French, German, Japanese, Spanish, Russian or Arabic). In other words, either the International Application in its original language or the translation will be sufficient for the processing by the Receiving Office, for international search and for international publication.

2. If the language of filing of the International Application is accepted by the Receiving Office and the International Searching Authority but is not a language of publication (at present, this is the case only where the International Application is filed in Dutch and certain Nordic languages), the International Application will be published in English, the translation into that language being prepared under the responsibility of the International Searching Authority which undertakes the searches (see Rule 48.3)

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

5.4.15 International Search

1. International Search report is established by the International Searching Authority. For the purpose of Indian applicant following are Competent International Searching Authorities (ISAs).

- 1. Austrian Patent Office (AT)
- 2. Australian Patent Office (AU)
- 3. European Patent Office (EP)
- 4. China Intellectual Property Office (CN)
- 5. United States Patent & Trademark Office (US)
- 6. Swedish Patent Office (SE)

2. If the International Application did not claim any priority, the international search report is normally available within nine months from the international filing date. If priority is claimed, that report is available usually by the 16th month from the priority date. Even where priority is claimed, the

international search report is normally available in time before publication of the International Application. This allows time for the applicant to withdraw the application before publication, if desired.

5.4.16 PCT FEES (may vary from time to time)

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

All PCT fees are subject to change periodically. For latest fees, please refer the latest PCT newsletter at URL www.wipo.int.

- (i) Transmittal fee: as given in **the First Schedule** .
- (ii) International Fee and, Search Fee is given in **Annexure II**.
- (iii) Fee for preparing certified copy of priority document in respect of individual or legal entity is given in the First Schedule .

Failure to pay fees or underpayment of fees can be corrected under PCT rule 16 bis. An invitation to pay missing fees will be issued by the Receiving Office. Payment can be made within a month from International filing date or later with a late payment fee.

An Indian applicant, filing an International Application under Patent Cooperation Treaty, is required to remit the consolidated amount in US Dollar by Demand Draft, payable to the Controller of Patents at State Bank of India, New York Branch, for payment towards International Filing fee and search fee. The required fees, which must be paid to receiving Office, are the Transmittal Fee, the International Filing Fee and the Search Fee. These fees must be paid to the Receiving Office within the prescribed time.

The Transmittal Fee is for the benefit of the Receiving Office. It is intended to compensate that office for the work, which is required to be performed in connection with the International Application. The amount is fixed by the Receiving Office. It is to be paid within one month from the date of receipt of the International Application.

The international filing fee is for the benefit of the International Bureau. It is intended to cover the cost of the work; the International Bureau must perform under the PCT. The amounts are fixed in the Schedule of Fees, which forms part of the regulations. The international filing fee is to be paid within one month from the date of receipt of the International Application.

The Search Fee is for the benefit of the International Searching Authority. It is intended to compensate that Authority for the work it must perform in connection with the establishment of the international search report. It is also to be paid within one month from the date of receipt of the International Application. The amount is fixed by the International Searching Authority.

5.4.17 Withdrawal of Application

An International Application can be withdrawn before technical preparations for international publication have been completed (that is, not later than 15 days before the date of publication, which is 18 months from the priority date)

5.4.18 Amendments:

The claims can be corrected for conformity with the results of the international search report by amending them once (under Article 19) with effect in all designated States. Such amendments save costs for preparation of different sets of amendments and for local agents filing such amendments before designated Offices, and guarantee better provisional protection and patents in designated countries. Individual amendments before each Designated Office are also permitted in the national phase (under Article 28 or 41) and all parts of the application can be amended under Article 34(2)) during the international preliminary examination procedure under Chapter II.

5.4.19 International Preliminary Examination (Optional)

1. International Preliminary Examination is useful in the following ways:

- i) It is optional for the applicant;
- ii) provides, in addition to the international search report, an international preliminary Examination report containing a second opinion on the usual criteria of patentability before expenses are incurred for the national phase (for translation, fees and foreign agents);
- iii) helps the applicant to adapt the International Application in accordance with the results of the International Search Report;
- iv) allows, with effect for all elected Offices, the amending of all parts of International Application (description, claims and drawings) during international preliminary examination;
- v) The international preliminary examination report gives for minimal cost, an opinion and the probability of obtaining a patent;
- vi) If the report is negative and it is decided to abandon the application, the applicant has saved all the expenses otherwise incurred before the elected Offices for the payment of national fees, the preparation of translations and the appointment of local agents. However the opinions from ISA & IPEA are non-binding opinions for the member countries

2. The following are Competent International Preliminary Examining Authorities (IPEAs) for the purpose of Indian Applicant:]

- Austrian Patent Office (AT)
- Australian Patent Office (AU)
- European Patent Office (EP) (Only if ISA was AT, EP or SE)
- China Intellectual Property Office (CN)
- United States Patent & Trademark Office (US)

- Swedish Patent Office (SE)

The fees to be paid by the applicant when he opts for Preliminary examination to be carried out by IPEA is given in the PCT Newsletter which is available on the WIPO website, www.wipo.int

5.4.20 National Phase

1. The national phase follows the international phase. In the national phase before processing and examination in the designated or elected Offices, the applicant must perform certain acts thereby effecting “entry into the national phase”. If the applicant does not enter the national phase, namely, if he does not perform these acts within the prescribed time limit, the International Application loses its effect in the designated or elected States concerned with the same consequences as the withdrawal of any national application in that State (Article 24).

2. For entry into the national phase before a designated office, it is necessary that the national fee is paid to it and, where the International Application has not been filed or published in the official language, or one of the official languages of that Office, a duly verified translation into an official language be filed. The time limit for entry into the national phase is 31 months in India.

3. The national fees to be paid are usually same as the fees required for the filing of a national or conventional application.

5.4.21 Advantages Of PCT Applications

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

(i) The same application documents can be used for filing national application;

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

5.4.22 BASIC REQUIREMENTS TO ENTER NATIONAL PHASE IN INDIA

(i) Under the basic requirements to start the national phase in India, the applicant is required to file the national phase application within 31 months from the priority date or International application date, whichever earlier.

(ii) Application may be made in Form 1.

(iii) National fee in INR is to be paid as given in the First Schedule along with the application.

(iv) In case of more than one priority, multiple fees for every multiple priority is to be paid as per the First Schedule

(v) Where the international application has not been filed or published in one of the official languages (Hindi or English), a translation of the application, description, claims (if amended, both as originally filed and amended together with any statement under PCT Article 19 and Article 39(1)), drawings, if any, and abstract should be submitted along with the application.

(vi) Additional Special Requirements:

Under the said additional special requirements (PCT Rules 51 bis), no designated Office is to require before the expiration of the applicable time limit for entering the national phase, the performance of acts other than those referred to in Article 22, namely the payment of the national fee, furnishing of a translation and, in exceptional cases, the furnishing of a copy of the international application, and indication of the name and address of the inventor. All other requirements of the national law are referred as “special requirements” and they may be complied with once national processing has started. As per DO/IN or EO/IN the special requirements of the Office are as follows:

- a) Name, nationality and address of the inventor if they have not been furnished in the “Request” part of the international application,
- b) Instrument of assignment or transfer where the applicant is not the inventor.
- c) Document evidencing a change of name of the applicant if the change has occurred after the international filing date and has not been reflected in a notification from the International Bureau (Form PCT / IB/ 306). Form 6 and/or Form 13 are also required.
- d) Declaration of inventorship by the applicant,
- e) Statement regarding filing of corresponding applications in other countries,
- f) Power of attorney if an agent is appointed,
- g) Address for service in India (but representation by an agent is not a must)
- h) Verification of translation, and Copy of International application or its translation

CHAPTER VI

PUBLICATION AND EXAMINATION OF APPLICATIONS

6.1 Publication of applications

Relevant Sections and Rules :

Section 11:

- †(1) Save as otherwise provided, no application for patent shall ordinarily be open to the public for such period as may be prescribed.*
- (2) The applicant may, in the prescribed manner, request the Controller to publish his application at any time before the expiry of the period prescribed under sub-section (1) and subject to the provisions of sub-section (3), the Controller shall publish such application as soon as possible.*
- (3) Every application for a patent shall, on the expiry of the period specified under sub-section (1), be published, except in cases where the application—*
- (a) in which secrecy direction is- imposed under section 35; or*
 - (b) has been abandoned under sub-section (1) of section 9; or*
 - (c) has been withdrawn three months prior to the period specified under sub-section (1).*
- (4) In case a secrecy direction has been given in respect of an application under section 35, then it shall be published after the expiry of the period prescribed under sub-section (1) or when the secrecy direction has ceased to operate, whichever is later.*
- (5) The publication of every application under this section shall include the particulars of the date of application, number of application, name and address of the applicant identifying the application and an abstract.*
- (6) Upon publication of an application for a patent under this section—*
- (a) the depository institution shall make the biological material mentioned in the specification available to the public;*
 - (b) the patent office may, on payment of such fee as may be prescribed, make the specification and drawings, if any, of such application available to the public.*
- (7) On and from the date of publication of the application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for the invention had been granted on the date of publication of the application:*

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

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

Provided also that after a patent is granted in respect of applications made under sub-section (2) of section 5, the patent-holder shall only be entitled to

receive reasonable royalty from such enterprises which have made significant investment and were producing and marketing the concerned product prior to the 1st day of January, 2005 and which continue to manufacture the product covered by the patent on the date of grant of the patent and no infringement proceedings shall be instituted against such enterprises.

Section 143:

Restrictions upon publication of specification;

Subject to the provisions of Chapter VII, an application for a patent, and any specification filed in pursuance thereof, shall not, except with the consent of the applicant, be published by the Controller before the expiration of the period prescribed under sub-section (1) of section 11A or before the same is open to public inspection in pursuance of sub-section (3) of section 11A or section 43.

Rule 11:

Order of recording applications.

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

Rule 24:

Publication of application

The period for which an application for patent shall not ordinarily be open to public under sub-section (1) of section 11A shall be eighteen months from the date of filing of application or the date of priority of the application, whichever is earlier.

Provided that the period within which the Controller shall publish the application in the Journal shall ordinarily be one month from the date of expiry of said period, or one month from the date of request for publication under rule 24A.

Rule 24.:

Request for publication;

A request for publication under sub-section (2) of section 11A shall be made in Form 9.

Rule 25:

Identification of published applications;

Publication of application under sub-sections (2) and (5) of section 11A shall be identified by the letter 'A' along with the number of application .

Rule 26:

Request for withdrawal;

A request for withdrawing the application under sub-section (4) of section 11B shall be made in writing.

Rule 27:

Inspection and supply of published documents;

After the date of publication of the application under section 11A, the application together with the complete specification and provisional specification, if any, the drawing, if any, and the abstract filed in respect of the application may be inspected at the appropriate office by making a written request to the Controller on payment of the fee in that behalf and copies thereof may be obtained on payment of fees specified in the First Schedule.

6.1.1 Numbering of Application:

Patent office accords an application number and filing date to the application immediately after filing by the applicant, such that the applications filed in a year constitute the series identified by the year of such filing. PCT National Phase applications constitute a different series (Rule 11).

6.1.2 Screening of Applications:

All the applications will be screened and have International Patent Classification to categorize the invention to the respective field of technology. Simultaneously, the applications are screened to find whether the invention is relevant for defence and atomic energy purpose so that the necessary procedure can be initiated.

6.1.3 Publication of Applications :

A) No application for patent shall ordinarily be open to public before the publication by Patent office under section 11A. At the end of 18 months period, the application will be published in the official journal except in the cases where,

- i) Secrecy direction is imposed **u/s 35**
- ii) The application has been abandoned **u/s 9(1)**
- iii) It has been withdrawn three months prior to the publication period i.e. before the end of 15th month from the date of filing or priority, whichever is earlier **[S.11(A)]**.

In case a secrecy direction has been given, the application will be published after expiry of the 18-month period or when the secrecy direction is lifted off, whichever is later (S. 11A(4)).

6.1.4 Early Publication:

If the applicant makes a request in Form 9 (before the expiry of 18 months from the date of priority if no priority claimed from the date of filing) with the prescribed fee (Rs.2,500/- for natural person(s) and Rs.10,000 for legal entity [other than natural person(s)]), the application will be published within one month from the date of filing of such request.

6.1.5 Particulars of Publication:

- i) Patent applications are published in the Patent Office Journal under section 11A(2) of the Patents (Amendment) Act 2005 and rule 24A of the Patents (Amendment) Rules, 2006.
- b) The publication U/S 11A will be identified by the letter “A” along with the Number of Application
- c) **Publication of patent application includes information on the following parameters as may be applicable to a particular case**

- (a) Number of Application
- (b) Date of filing of Application
- (c) Title of Invention
- (d) Publication date
- (e) International Patent classification
- (f) Name and Address of the Applicant
- (g) Name of the Inventor(s)
- (h) Priority details like Document Number, Date, Country, PCT application number and date, etc
- (i) Patent of Addition to / Divisional Application to: along with filing date of the parent application /
- (j) Abstract of the Invention including drawing (if any)

6.1.6 EFFECTS OF PUBLICATION:

1. After publication of the application for patent the depository institution will make the biological material (mentioned in the specification) available to the public
2. The Patent office will make the specification (complete as well as provisional, if any), and drawings filed in respect of the application available to the public on payment of the prescribed fee as given in the First Schedule.
3. The applicant shall have like privileges and rights, as if a patent for the invention had been granted from the date of publication of the application

until the date of grant. But he shall not be entitled to institute any proceedings for infringement until the patent has been granted.

4. The rights of patentee for applications filed u/s 5(2) before 1st day of January, 2005 will accrue from the date of grant of the patent.

6.2 EXAMINATION OF APPLICATIONS

Relevant sections and Rules :

Section 11B: Request for examination;

- (1) No application for a patent shall be examined unless the applicant or any other interested person makes a request in the prescribed manner for such examination within the prescribed period.*
- (2) Omitted by Act 15 of 2005*
- (3) In case of an application in respect of a claim for a patent filed under sub-section (2) of section 5 before the 1st day of January, 2005 a request for its examination shall be made in the prescribed manner and within the prescribed period by the applicant or any other interested person.*
- (4) In case the applicant or any other interested person does not make a request for examination of the application for a patent within the period as specified under sub-section (1) or sub-section (3), the application shall be treated as withdrawn by the applicant:*

Provided that—

- (i) the applicant may, at any time after filing the application but before the grant of a patent, withdraw the application by making a request in the prescribed manner; and*
- (ii) in a case where secrecy direction has been issued under section 35, the request for examination may be made within the prescribed period from the date of revocation of the secrecy direction.*

Section 12: Examination of application;

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

- (a) *whether the application and the specification and other documents relating there to are in accordance with the requirements of this Act and of any rules made thereunder;*
 - (b) *whether there is any lawful ground of objection to the grant of the patent under this Act in pursuance of the application;*
 - (c) *the result of investigations made under section 13; and*
 - (d) *any other matter which may be prescribed.*
- (2) *The examiner to whom the application and the specification and other documents relating thereto are referred under sub-section (1) shall ordinarily make the report to the Controller within such period as may be prescribed.*

Rule 24 B: Examination of application.;

- (1) (i) *A request for examination under section 11 B shall be made in Form 18 within forty-eight months from the date of priority of the application or from the date of filing of the application, whichever is earlier;*
 - (ii) *The period within which the request for examination under sub-section 3 of section II B to be made shall be forty-eight months from the date of priority if applicable, or forty-eight months from the date of filing of the application;*
 - (iii) *The request for examination under sub-section (4) of section 11B shall be made within forty-eight months from the date of priority or from the date of filing of the application, or within six months from the date of revocation of the secrecy direction, whichever is later;*
 - (iv) *The request for examination of application as filed according to the 'Explanation' under sub-section (3) of section 16 shall be made within forty-eight months from the date of filing of the application or from the date of priority of the first mentioned application or within six months from the date of filing of the further application, whichever is later;*
 - (ii) *The period for making request for examination under section 11B, of the applications filed before the 1st day of January, 2005 shall be the period specified under the section 11B before the commencement of the Patents (Amendment) Act, 2005 or the period specified under these rules, whichever expires later.*
- (2) (i) *The period within which the Controller shall refer the application and specification and other documents to the examiner in respect of the applications where the request for examination has been received shall ordinarily be one month from the date its publication or one month from the date of the request for examination whichever is later:*

Provided that such reference shall be made in order in which the request is filed under sub-rule (1).

- (ii) The period within which the examiner shall make the report under sub-section (2) of section 12, shall ordinarily be one month but not exceeding three months from the date of reference of the application to him by the Controller;*
- (iii) the period within which the Controller shall dispose off the report of the examiner shall ordinarily be one month from the date of the receipt of the such report by the Controller.*
- (3) A first examination report along with the application and specification shall be sent to the applicant or his authorised agent ordinarily within six months from the date or the request for examination or six months from date of publication whichever is later. In case other interested person files the request for examination, an intimation of such examination may be sent to such interested person.*
- (4) The time for putting an application in order for grant under section 21 shall be twelve months from the date on which the first statement of objection is issued to the applicant to comply with the requirements.*

Section 13:

Search for anticipation by previous publication and by prior claim;

- (1) The examiner to whom an application for a patent is referred under section 12 shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification—*
 - (a) has been anticipated by publication before the date of filing of the applicant's complete specification in any specification filed in pursuance of an application for a patent made in India and dated on or after the 1st day of January, 1912;*
 - (b) is claimed in any claim of any other complete specification published on or after the date of filing of the applicant's complete specification, being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.*
- (2) The examiner shall, in addition, make such investigation for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been anticipated by publication in India or elsewhere in any document other than those mentioned in sub-section (1) before the date of filing of the applicant's complete specification.*
- (3) Where a complete specification is amended under the provisions of this Act before the grant of patent, the amended specification shall be examined and investigated in like manner as the original specification.*
- ~~(2)~~(4) The examination and investigations required under section 12 and this section shall not be deemed in any way to warrant the validity of any patent, and*

no liability shall be incurred by the Central Government or any officer thereof by reason of, or in connection with, any such examination or investigation or any report or other proceedings consequent thereon.

Rule 28:

Procedure in case of anticipation by prior publication;

- (1) If the Controller is satisfied after investigation under section 13 that the invention so far as claimed in any claim of the complete specification has been published in any specification or other document referred to in clause (a) of sub-section (1) or subsection (2) of the said section, the Controller shall communicate the gist of specific objections and the basis thereof to the applicant and the applicant shall be afforded an opportunity to amend his specification.*
- (2) If the applicant contests any of the objections communicated to him by the Controller under sub-rule (1), or if he refiles his specification along with his observations as to whether or not the specification is to be amended, he shall be given an opportunity to be heard in the matter if he so requests:*

Provided that such request shall be made on a date earlier than ten days of the final date of the period referred to under sub-section (1) of section 21:

Provided further that a request for hearing may be allowed to be filed within such shorter period as the Controller may deem fit in the circumstances of the case.

- (3) If the applicant requests for a hearing under sub-rule (2) within a period of one month from the date of communication of the gist of objections, or, the Controller, considers it desirable to do so, whether or not the applicant has refiled his application, he shall forthwith fix a date and time for hearing having regard to the period remaining for putting the application in order or to the other circumstances of the case.*
- (4) The applicant shall be given ten days' notice of any such hearing or such shorter notice as appears to the Controller to be reasonable in the circumstances of the case and the applicant shall, as soon as possible, notify the Controller whether he will attend the hearing.*
- (5) After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Controller may specify or permit such amendment of the specification as he thinks fit to be made and may refuse to grant the patent] unless the amendment so specified or permitted is made within such period as may be fixed.*

Rule 28A:

Procedure in relation to consideration of report of examiner under section 14;

In case the applicant contests any of the objections communicated to him, the procedure specified under rule 28 may apply.

Rule 29:

Procedure in case of anticipation by prior claiming.

- (1) When it is found that the invention so far as claimed in any claim of the complete specification, is claimed in any claim of any other specification falling within clause (b) of sub-section (1) of section 13, the applicant shall be so informed and shall be afforded an opportunity to amend his specification.*
- (2) If the applicant's specification is otherwise in order for grant and an objection under clause (b) of sub-section (1) of section 13 is outstanding, the Controller may postpone the grant of patent and allow a period of two months for removing the objection.*

Rule 30.:

Amendment of the complete specification in case of anticipation;

- (1) If the applicant so requests at any time, or if the Controller is satisfied that the objection has not been removed within the period referred to in sub-rule (2) of rule 29, a date for hearing the applicant shall be fixed forthwith and the applicant shall be given at least ten days' notice of the date so fixed. The applicant shall, as soon as possible, notify the Controller whether he will attend the hearing.*
- (2) After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Controller may specify or permit such amendment of the specification as will be to his satisfaction to be made and may direct that reference to such other specification, as he shall mention shall be inserted in the applicant's specification unless the amendment is made or agreed to within such period as he may fix.*

Section 14:

Consideration of the report of examiner by Controller.;

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

Section 144:

Reports of examiners to be confidential.—

The reports of examiners to the Controller under this Act shall not be open to public inspection or be published by the Controller; and such reports shall not be liable to production or inspection in any legal proceeding unless the court certifies that the production or inspection is desirable in the interests of justice, and ought to be allowed.

Section 15:

Power of Controller to refuse or require amended applications, etc., in certain case;

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

Section 16:

Power of Controller to make orders respecting division of application;

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

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

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

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

Section 17:

Power of Controller to make orders respecting dating of application;

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

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

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

6.2.1. EXAMINATION OF PATENT APPLICATION

After publication of application, the next stage of processing of patent application is examination as to whether the patent can be granted for the invention as contained in complete specification. Examination stage is subject to filing request for examination u/s 11(B). This system of examination is called Deferred Examination System. The basic criteria for an invention to qualify for a patent grant is that it must have novelty, inventive step and capability of industrial application and also it should not fall under any of the categories of non-patentable inventions. This chapter explains how the criteria of patentability is examined and various relevant steps involved in the patent grant procedure starting from filing patent application laid down by the provisions of the Patents Act are checked during the examination of patent application.

6.2.2 Request for Examination

- i) The application will be taken up for examination only on request made by the applicant or by any other interested person in Form -18. Such a request is required to be made within 48 months from the date of priority or from the date of filing, whichever is earlier, with the prescribed fees as given in the First Schedule.

“Person interested” (S.2(1)(t)) includes a person engaged in, or in promoting research in the same field as that to which the invention relates. Any person including an organization that has a manufacturing or trading interest in the goods connected with the patented article or who has a financial interest in manufacturing such goods or who possesses patents related to the same subject, is considered a person interested.

- ii) Request for examination can be made by the applicant or any other person interested. In case of other than applicants filing the request, it shall be supplemented with the evidence of interest.

- (iii) In case of PCT-National Phase applications(PCT-NP), processing of the application starts only after expiry of 31 month -period from its priority date (Rule 20(2) and 20(4)). However an express request can be filed for early processing or examination, any time earlier than the prescribed time of 31 months, in Form 18 along with the prescribed fee as given in First Schedule, whereupon these applications may be taken up for examination before the said period
- iv) All the applications will be screened to categorize the invention to the respective field of technology and to find whether the invention is relevant for defence purposes etc. so that the necessary procedures can be initiated in respect of those applications.
- v) In respect of applications filed u/s 5(2), filed before the 1st day of January 2005, the request should be made within a period of 48 months from the date of priority (if applicable) or date of filing of the application.
- vi) If no request for examination is made within the prescribed period the application will be treated as withdrawn by the applicant [S.11B (4)]
- vii) In case of applications in which secrecy direction is imposed, the date of filing the request shall be with in 48 months from the date of filing the application or priority or six months from the date of revocation of such secrecy direction, whichever expires later.
- viii) The request for examination in case of divisional application shall be filed within 48 months from the date of filing or priority of the parent application or within six months from the date of filing the divisional application, whichever expires later. Request for divisional application shall be filed only after filing request for the parent application to ensure the requirement of section 16(3).

6.2.3 Request for Withdrawal: The applicant can, however, withdraw his application at any time after filing the application but before the grant of a patent by making a request to that effect in writing with prescribed fee under entry No.23 of the First Schedule of the Patents Rules 2003. [S.11B (4) (i), R. 26].

6.2.4 Advantages_of Deferred Examination System;

- (a)By making an application for patent, an applicant/inventor obtains the date of patent and, hence priority also, without paying the fee for examination
- (b)An applicant/inventor gets recognition as the owner of the invention because of '18 month publication', even if the application is not examined.
- (c)Request for examination can be delayed up to 48 months so that the applicant can obtain financial support to exploit invention.

(d) A person who is interested in the commercial value of the invention can request for examination and get the license for patent later after consultation with the applicant.

(e) If the applicant wishes, he can withdraw the application before the end of 15th month of filing an application to prevent the publication, so that its novelty will not be lost (S.11B (4)(i), 11A(3)(c))

4.126.2.5 Two stages of Examination of Patent Application at Patent Office

- (i) Formal examination and
- (ii)** Substantive / Technical examination

6.2.6 Formal Examination:

The application for a patent, as filed, including all the relevant documents, payments etc are checked/scrutinized to ensure that the same are filed or submitted in conformity with the provisions of the Patents Act and Rules.[Sec12 (1)(a)]

a) Formal scrutiny/checking is carried out in respect of the following documents-

- e1) All relevant forms, request, petitions, assignment deeds, translation etc.,
- e2) Payment of fees and other details,
- e3) Provisional and /or complete specification,
- e4) Abstract,
- e5) Drawings (if any),
- e6) Presence of meaningful claim(s) or absence of claims in a complete specification,
- e7) Proof of right,
- e8) Form 5 (along with complete after provisional or for filing PCT-NP/Convention application)
- e9) Power of Attorney or attested copy of General Power of Attorney (if any)
- e10) Form 3 -information regarding foreign filing u/s 8(1).
- e11) Whenever Form 6 is filed and assignment has taken place from individual to other than individual, difference in fee has to be called for (Rule 7(3)).

Screening

Screening is carried out for the following -

- ea) Technical fields of invention
- eb) Relevance to defence or atomic energy
- ec) International and Indian Classification
- ed) Correction/completing the abstract, if required.

After scrutiny of the documents, the lacunae, if any, in the application will be communicated to the applicant in FER.

6.2.7 Substantive /Technical Examination:

a) **Substantive examination mainly involves *exploring the following technical and legal matters by the examiner-***

1.i. Whether the specification complies with the requirements of section 10 regarding contents of the specification

2.ii. Whether the subject matter is an invention within the meaning of section 2(1) (j), based on the criteria of novelty, inventive step and industrial applicability.

3.iii. Classification and conducting of search for anticipation by previous publication in any document in India and elsewhere and prior claiming in the patent applications filed in India.

4.iv. Whether the invention is one, which is not patentable under sections 3 & 4 of the Patents Act.

b) Steps involved in Substantive Examination

ei. Assessment of patentability of the subject matter

eii. Assessment of sufficiency of disclosure

eiii. Check for unity of invention

eiv. Appraisal of Industrial applicability

ev. Classification of the invention

evi. Novelty search

evii. Determination of the inventive step

eviii. Judgment of validity of claims

eix. Disclosure of geographical origin of the Biological material

ex. Permission from National Bio diversity Authority.

c) Examination of Industrial Applicability is based on the technical documentation in the patent application dossier (description, drawings, claims etc.), while the examination of novelty and inventive step requires documentary search for the assessment of prior art.

d) Before examination of novelty and inventive step, it is necessary to check whether the invention is fully defined

e) Novelty **is determined before inventive step** because the creative contribution of the inventor can be assessed only by knowing the novel element of the invention, which can justify it.

f) The examiner conducts novelty search to see whether the invention claimed in any claim of the complete specification has been anticipated by any of the following documents for the purpose of judging the novelty and inventive step of the invention.

ei. Indian patent specifications published before the date of filing of the application, but on or after 1st January, 1912 - [(S.13 (1)(a)] (Prior publication)

eii. Indian patent specifications which are filed before the date of filing of the present case or claiming a priority date earlier to the said date, but the publication of that document was effected on or after the filing date (S. 13(1) (b) – (Prior claiming)

eiii. Any publication in India or elsewhere in any document other than Indian Patent Specifications as mentioned *above* (S. 13(2) Prior publication including traditional knowledge in any form.

- g) For establishing novelty of the invention, the requirement holds that all the features from the independent claim should be described in a single document. When even a single feature is missing from the cited document, the claim may be considered as novel. It is also necessary that all the features be described in the same combination in the single document.
- h) According to international standards the novelty search results in the following documents, which form citation for the invention. Description for each type of the documents, Types – A, E, L, O, P, and T, X, Y is given below. The citations of the type X and Y are very important as they explicitly indicate lack of novelty and obviousness as per the search report prepared by the International Authority.

i) Special Categories of Cited Documents: -

Type	Description of Document
“A”	Document defining the general state of the art which is not considered to be of particular relevance
“E”	Earlier document but published on or after the international filing date
“L”	Document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
“O”	Document referring to an oral disclosure, use, exhibition or other means
“P”	Document published prior to the international filing date but later than the priority date claimed
“T”	Later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention.
“X”	Document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
“Y”	Document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents; such combination being obvious to a person skilled in the art.
“&”	Document member of the same patent family

4.136.2.8 Procedure for Substantive Examination

- 1) Applications will be taken up for examination according to the order in which the Request for Examination has been made.

- 2) Where the request for examination has been received, the Controller shall refer the application, specification and other document to the examiner in respect of the application, ordinarily within one month from the date of publication or request for examination, whichever is later [Rule 24 B (2)]
- 3) The *Controller* refers the application to an Examiner to make a report to him on
 - i) Whether the application, specification and other document are in accordance with the requirements of the Patents Act & Rules
 - ii) Whether there is any objection to grant of patent
 - iii) Results of search for anticipation made under Section 13
- 4) The Examiner shall make a report to the Controller on the above matters ordinarily within a period of 1 month but not exceeding three months from the date of such reference.
- 5) The Controller shall dispose the report of the examiner ordinarily within one month from the date of the receipt of such report.
- 6) This Report is called the First Examination Report (*FER*).
- 7) The time for putting the application in order for grant is 12 months from the date of FER.

6.2.9 Issuing First Examination Report And Procedures Thereafter:

- i. A gist of objections made by the examiner will be communicated to the applicant in the First examination Report (FER). A FER along with the application and specification is sent to the Applicant or his Authorized Agent ordinarily within six months from the date of request for examination or six months from the date of publication, whichever is later?
- ii. In case, any other interested person files the request for examination, an intimation of such examination of the application may be sent to such interested person.
- iii. If any of the objections require amendment of the application, specification or drawings to ensure compliance with the provisions of the Act or the Rules, the same will be communicated to the applicant along with the FER.
- iv. The applicant will be allowed to carry out the necessary amendments of the application, specification or drawings.
- v. The amended documents (retyped sheets, if necessary) along with the superseded pages, if any, duly marked, cancelled and initialled by the applicant or his agent will be returned to the Controller. Copies of any pages that have been added or retyped and any drawing that has been added or substantially amended shall be submitted in duplicate.
- vi. The amended documents together with the specification will be examined again in the same way as the original specification (S.13 (3)).

- vii. The applicant will be given an opportunity of being heard, if he so requests, when the examination report is adverse to him and he contests any of objections or refiles his specification along with his observations regarding amendments of the same (S. 14 & R.24 (B), R28). The request for such hearing should be made at least 10 days before the expiry date

~~viii~~viii. There can be one or more correspondences after the issue of FER. However, the time for meeting the objections and putting the application in order for grant is 12 months from the date of issue of FER (S. 21(1)), failing which the application will be abandoned.

- ix. Examination procedure carried out under section 12 and 13 shall not be deemed in any way to warrant the validity of any patent, and no liability shall be incurred by the Central Government or any officer thereof because of any such examination or investigation or any report or other proceedings consequent thereon.

6.2.10 Example: In *1999 (19) PTC 479* Registration of patent does not entitle any presumption of validity in favour of patent in spite of investigation before its registration—Patent Act, 1970—Section 12,13 & 64.

Held: Section 13(4) of the Patents Act provides that the examination and investigations required under sections 12 & 13 shall not be deemed in any way to warrant the validity of any patent, and no liability shall be incurred by the Central Government or any officer thereof by reason of, or in connection with, any such examination or investigation or any report or other proceedings consequent thereon. Thus, grant of patent in any manner does not guarantee the validity of the patent. Reference may also be made to the provisions of Section 64 of the Patents Act which deals with revocation of patents. It provides that a patent whether granted before or after the commencement of the Act, may, on the petition of any person interested or of the Central Government or on a counter-claim in a suit for infringement of the patent, be revoked by the High Court on the ground that the subject of any claim of the complete specification is not an invention within the meaning of this Act or that the invention so far as claimed in any claim of the complete specification is not new having regard to what was publicly known or publicly used in India before the priority date of the claim or to what was published in India or elsewhere in any of the documents referred to in Section 13 or that the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step, having regard to what was publicly known or publicly used in India or what was published in India or elsewhere before the priority date of the claim.

Despite all the safeguards and circumspection contemplated in various provisions of the Act against grant of patent in respect of a spurious, purloined or fake invention, the Legislature minced no words in clarifying its intendment that no presumption of validity would attach to a patent granted by the Controller under the Act, notwithstanding examination and investigation made under Sections 12 & 13 thereof

43. Prescribed form 2
44. Name, address and nationality of the applicants
45. Title
46. Preamble to the description
47. Reference to inventor
48. Reference to drawings
49. Reference to original patent
50. Date and signature
51. Duplicate
52. Miscellaneous

Complete Specification filed on _____

53. Prescribed, form 2
54. Name, address and nationality of applicant
55. Title
56. Preamble to description
57. Reference to drawings
58. Reference to original patent
59. Statement of claims (containing claims)
60. Date and signature
61. Duplicate
62. Miscellaneous
63. Abstract
64. Size of the document
 - a. Language
 - b. Electronic form
 - c. Sequence in Electronic Form
 - d. Numbering of pages

DECLARATION OF INVENTORSHIP

65. Prescribed form
66. Name of applicant
67. Name, address and nationality of inventors
68. Date and signature
69. Assent by the inventor

DRAWINGS

70. Not filed in time-post-dating
71. Reproducible
72. Name and signature
73. Number of sheets
74. Figures of drawings
75. Descriptive matter and measurement
76. Duplicate
77. Miscellaneous

GENERAL

78. Request for amending or correcting
 - (a) Application
 - (b) Specification
 - (c) Drawings
79. Request for post-dating of an application

80. Specification and drawings generally unsatisfactory

PROVISIONAL / COMPLETE SPECIFICATION

81. **DESCRIPTION - Clear -**

- (a) Not in clear English
- (b) English equivalent necessary in respect of
- (c) Not clear in respect of where indicated in
- (d) Description in page inconsistent with
- (e) Distinguishing features as compared
With prior art given is not clear
- (f) Drawings to be separated from specification

82. **DESCRIPTION - sufficient -**

- (a) Further description necessary
- (b) Revision necessary where indicated
- (c) Drawings required
- (d) Biological materials
 - (i) Deposit in authorised depository Institution
 - (ii) Date of Deposit
 - (iii) Date/number of deposit in the specification
 - (iv) Source/Geographical origin in the specification
- (e) Model or sample required

83. **DESCRIPTION - references -**

- (a) Reference to foreign patent applications/patents
 - (i) Should be replaced by Indian specification;
 - (ii) Or modified by substituting the serial number
of the published British specification;
 - (iii) Or replaced or supplemented by equivalent or
Supplemented by equivalent description.
- (b) Co-pending application No. Necessary
- (c) Co-pending application in page to be completed
- (d) Prior patent in page insufficient
- (e) Distinguishing features with reference to Prior specification necessary
- (f) Grant deferred in view of unpublished Co-pending application

84. **DESCRIPTION - Clerical errors -**

- (a) In page to be corrected.

85. **DRAWINGS - clear -**

- (a) Figures not numbered.
- (b) Sectional lines not marked in figures.
- (c) Reference letter (numerals) not marked in figures.
- (d) Same reference letters used for different parts – (in figures)
- (e) Part denoted by reference letter in figure(s)
Not same as that denoted by it in page.
- (f) Do / does not clearly illustrate
Features described in pages.

86. **DRAWINGS** - sufficient -
 (a) Arrangement described in page or / and
 Claimed in claim should be illustrated.
87. **CLAIMS** - clear -
 (a) Claims not clear in respect of the expression.
 (b) Claims not clearly worded.
88. **CLAIMS** - **succinct** -
 (a) Unnecessary repetition
 (b) Verbose
 (c) Large number
 (d) Claim redundant.
89. **CLAIMS** - **definitive** -
 (a) Claims do not sufficiently define the invention.
 (b) Claim not sufficiently definitive in the absence
 Of explicit statement of invention.
90. **CLAIMS** - **consistent** -
 (a) Claims not consistent with description in page.
 (b) Claims not supported by description.
 (c) Claims not fairly based on the matter disclosed
 In the specification.
91. **TITLE** - **appropriate** -
 (a) Inconsistent with description and claims
92. **TITLE** - **precise** -
 (a) Not precise.
 (b) Not clear in respect of word(s).
 (c) Vernacular word to be replaced.
 (d) Does not sufficiently indicate the subject.
 (e) Suitable amendments indicated.
93. **ABSTRACT**
 (a) Title
 (b) Concise summary
 (c) Size
 (d) Reference numerals of the Drawings
 (e) Searchable

94. PATENTABILITY AND PRE-GRANT OPPOSITION

(A) Sufficiency of description

- (i) Complete Specification does not sufficiently
 And clearly describe the invention
- (ii) Complete specification does not describe the method by
 Which the invention is to be performed.
- (iii) Non-disclosure or wrongful mentioning of source and
 Geographical origin of biological material

(B) Subject matter

- (a) (I) does not constitute an 'invention' under Section 2 (1) (j)
- (ii) Inventive step / non obvious
- (iii) Industrial application
- (b) Claims fall within the scope of Section 3

- (i) Invention frivolous / contrary to natural laws
- (ii) Contrary to public order / morality
 - (iii) Prejudice to human / animal / plant life
Or health or environment
 - (iv) Mere discovery of a scientific principle or abstract theory or discovery of any living thing or non-living Substances occurring in nature
 - (v) Mere discovery of any new property / mere new use
For a known substance / mere use of a known Process, machine or apparatus
Differing significantly in properties with regard to efficacy?
 - (vi) Substance obtained by a mere admixture resulting only in the Aggregation of the properties or a process for producing such Substance
 - (vii) the mere arrangement or re-arrangement or duplication
Of known devices each functioning independently
 - (viii) Method of agriculture / horticulture
 - (ix) Process for the medicinal / surgical / curative / prophylactic
Diagnostic / therapeutic / other treatment of human beings
Or any process for a similar treatment of animals
 - (x) Plants and animals in whole or any part thereof including
Seeds, varieties and species / essentially biological processes
For production or propagation of plants and animals
 - (xi) Computer programme per se other than its technical application to
Industry or a combination with hardware
 - (xii) Mathematical method / business method / algorithms
 - (xiii) Literary, dramatic, musical or artistic work or any other aesthetic
Creation including cinematographic works and television productions
 - (xiv) Mere scheme or rule or method of performing mental act /
Method of playing game
 - (xv) A presentation of information
 - (xvi) Topography of integrated circuits
 - (vie) traditional knowledge or an aggregation or duplication of known
Properties of traditionally known components
- (c) Claims not allowable under section 4
- (d) Is not proper for a patent of addition
- (e) Statement of claim(s) not definitive in view of what
admittedly known, see page of the specification

C. Novelty:

- (a) Invention anticipated by
 - (i) prior publication
 - (ii) prior claiming
- (b) Claim (s) of conflict(s) with claim (s) of
- (c) Invention claimed in claim (s) prime facie
lacking in novelty
- (d) Specification not clearly worded
- (e) Consideration deferred

D. Single Invention:

- (a) Claims define a plurality of
distinct inventions.
- (b) Each claims relates to an independent
invention
- (c) Claim(s) relate (s) to an invention
distinct from the rest

- (d) Consideration deferred
95. **IDENTITY - date -**
(a) Not allowable as an earlier application in respect of identical invention was filed in
96. **IDENTITY - Subject matter -**
(a) Does not constitute one invention or a group of invention so as to make a single invention. The application should be divided.
(b) Two or more applications for inventions cognate, additional fee required.
(c) The inventions disclosed in the specification filed with applications made in the convention countries are not so related as to constitute one invention or to a group of invention so as to form a single invention. The application should therefore be divided into separate applications.
(d) The inventions disclosed in the specifications filed with applications made in the convention countries are not so related as to constitute one invention or to a group of invention linked so as to form a single invention but are cognate or of which one is a modification of another accordingly, additional fees in respect of applications should be remitted immediately.

6.2.12 The Controller can take following actions as per Section 15

a) May refuse the application

When the application or specification or any other document filed does not meet the requirements of the Act or the Rules, the Controller can refuse the application for grant of patent by an order either suo-moto or after hearing the party to the application when a request for hearing is requested. The order of the controller is appealable before the Appellate board

b) May require the application to be amended before he proceeds further with the application

The Controller can stay the proceedings towards the grant of patent till requirements under the Act or Rules are met by the applicant to his satisfaction by way of amendments in the application or specification or any document, as the case may be. In case the applicant does not comply with the requirements within the time as prescribed under Sec.21, he may refuse the application.

4.14.6.2.13 Divisional application (S. 16)

- 4.14.1 When an application made by applicant claims more than one invention, the applicant on his own or to meet the official objection may divide the application and file two or more applications, as applicable for each of the inventions. This type of application, divided out of the parent one, is called a

Divisional Application. The priority date for all the divisional applications will be same as that claimed by the Parent Application (Ante-dating).

- 4.14.2 The Complete Specification of a divisional application should not include any matter not in substance disclosed in the complete specification of the first application. The reference of parent application should be made in the body of the specification. A divisional application has to be filed before the grant for a Parent application,

6.2.14 Example: In Imperial Chemical Industries Ltd. v. Controller of Patents, (AIR 1978 Cal 77) An Appellant was granted patent in respect of an invention of a catalyst which is used in the steam reforming of hydrocarbons and achieved results which were not, according to the appellant, possible before the invention. The said invention, as the patent certificate stated, related to the catalyst suitable for use in hydrocarbons steam reforming process.

The High Court considered the following well settled propositions of law:—

- (i) A patent must be in respect of an invention and not a discovery.
- (ii) There must be one single patent in respect of one single invention.
- (iii) A patent may be in respect of a substance or in respect of a-process.
- (iv) It is not possible to bifurcate a patent and state that one relates to the substance and the other to the process.
- (v) In order to have a complete patent the specifications and claims must be clearly and distinctly mentioned.
- (vi) It is the claims and claims, alone which constitute the patent. The High Court held that one cannot bifurcate from the processes, the result produced from such processes. A person having the right to use a process patented under the Act, he also has the right to the product of such process.

4.14.36.2.15 Divisional Application : Case Study

Patent Application **No. 251/MUMNP/2005** filed by M/s. BHA Holdings Inc. USA for the “*Retention Device engaged with the filter cartridge for limiting the radial movement of the pleats in the filter media*” as a divisional application of the parent application No. 490/MUMNP/2003.

The said divisional application was rejected by the Controller of Patents vide his order dated 11.01.2007 u/s 15 of the Patents Act, 1970 (as amended).

In the parent case, the *prima facie* objection for plurality of distinct inventions was raised by the Patent Office due to multiple sets of independent claims.

However, the Applicants contested this objection by claiming that these claims relate to a single inventive concept as required under Section 16 (3) of the Act. It was pointed out to the Agents that the same features claimed in claims 1-6 of divisional application were claimed in multiple sets of claims in claims 7-33 of a parent application, which were thus redundant and

accordingly they agreed to delete them. Thus, claims 1-6 only were allowed in the parent case.

Later, in the instant divisional patent application No.251/MUMNP/2005, the Applicants again filed claims 1-33 as were filed in the parent case, which attracted objection under Section 16 of the Act. The Patent Office asked to pinpoint differentiating features claimed in this divisional application with respect to the claims finally allowed in the parent application. The Applicants neither provided a proper reasoning to remove this objection raised under Section 16 (3) nor pinpointed the differentiating features of instantly claimed invention with respect to those allowed in the parent case. The Apparatus claims 1-12 of the instant divisional application correspond to claims 1-6 of the parent application and Method claims 13-19 of the instant divisional application correspond to claims 7-12 of the parent application.

Therefore, the divisional application did not meet the requirement of Section 16 (3) of the Act.

Accordingly, the Controller of Patents ordered refusal to grant letters of Patent for the aforesaid patent application No. 251/MUMNP/2005.

6.2.16 POST DATING OF THE APPLICATION (S. 17)

a) The application for patent may be post-dated to a date not later than six months from the date of application on a request made by the applicant at any time before the grant of patent along with the prescribed fee as given in first schedule. However this provision will not apply if the application is deemed to be abandoned

b) If the application or specification (or drawings if any) is amended under section 15 to comply with the requirements of the Act or the Rules and the Controller feels that post-dating is required, he may direct that application or specification or other documents related thereto be deemed to have been made on the date on which the requirements are complied with or the date on which it is re-filed after complying with the requirements. (S. 17(2)).

6.2.17 Example: *In case of Standipack Private Limited v. Oswal Trading Co. Ltd., 1999 PTC (19) 479 (Del).* Post-dating of the patent can be done only to the date of filing of the complete specifications. In the present case the Controller of Patents has filed the original records relating to the grant of patent in favour of the plaintiff. The said records reveal that the application for the grant of patent was originally filed by plaintiff on 11-4-1989 and the complete specification was filed on 11-10-1990. The Controller of Patents, however, post-dated the patent to 11-7-1989 although complete specifications followed by the provisional specification was filed on 11-10-1990. Thus the post-dating of the patent by the Controller to 11-7-1989 *prima facie* appears to be in violation of the provisions of section 9 of the Act. The date of the patent, therefore, should have been 11-10-1990. The patent documents referred the validity of the patent for 14 years from 11-7-1990. Thus the validity of the patent has also been ignored by the Controller of Patents. The plaintiff also, during the course of arguments, admitted that complete specifications were submitted on 11-10-1990, which is the date from which the

patent granted would be effective. Thus post-dating the patent to 11-7-1989 appears to be illegal in view of the provisions of section 9(4) of the Patents Act and the provisions of section 17 are subject to section 9.

4.166.3 ACTIONS TO BE TAKEN IN CASES OF ANTICIPATION [Section: 18]

Relevant Section and Rules

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 the application unless the applicant—*
 - (a) *shows to the satisfaction of the Controller that the priority date of the claim of his complete specification is not later than the date on which the relevant document was published; or*
 - (b) *amends his complete specification to the satisfaction of the Controller.*

- (2) *If it appears to the Controller that the invention is claimed in a claim of any other complete specification referred to in clause (b) of sub-section (1) of section 13, he may, subject to the provisions hereinafter contained, direct that a reference to that other specification shall be inserted by way of notice to the public in the applicant's complete specification unless within such time as may be prescribed,—*
 - (a) *the applicant shows to the satisfaction of the Controller that the priority date of his claim is not later than the priority date of the claim of the said other specification; or*
 - (b) *the complete specification is amended to the satisfaction of the Controller.*

- (3) *If it appears to the Controller, as a result of an investigation under section 13 or otherwise,—*
 - (a) *that the invention so far as claimed in any claim of the applicant's complete specification has been claimed in any other complete*

*specification referred to in clause (a) of sub-section (1) of section 13;
and*

*(b) that such other complete specification was published on or after the
priority date of the applicant's claim,*

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

Rule 29:

Procedure in case of anticipation by prior claiming.;

*(1)When it is found that the invention so far as claimed in any claim of
the complete specification, is claimed in any claim of any other
specification falling within clause (b) of sub-section (1) of section 13, the
applicant shall be so informed and shall be afforded an opportunity to
amend his specification.*

*(2) If the applicant's specification is otherwise in order for grant and an
objection under clause (b) of sub-section (1) of section 13 is outstanding, the
Controller may postpone the grant of patent and allow a period of two months
for removing the objection.*

6.3.1 If the invention is anticipated by prior publication *as per S.13 (1) (a) or
S.13(2)*, the Controller may refuse the complete specification unless the applicant
shows that the priority date of his claim is not later than that of the cited document
or amends his complete specification to the satisfaction of the Controller. [S.18 (1)
& Rule 28]

6.3.2 If the invention is anticipated by prior claiming as per S.13 (1) (b), the
Controller may direct that a reference to that other specification be inserted in the
applicant's specification by way of notice to the public unless the applicant shows
that the priority date of his claim is not later than that of the claim of cited
document or amends the specification to the satisfaction of the Controller. (The
Controller need not consider the validity of the prior specification when directing
such a reference) [S. 18(2) & Rule29, 30, 31]

Format for incorporation of reference is "*Reference has been directed, in
pursuance of section 18(2) of the Patents Act 1970, to the specification filed in
pursuance of application no...*" [Rule 31]

If the invention is anticipated by prior publication as per S.13(1) (a) and the other complete specification was published on or after the priority date of the applicant's claim, the remedy for the anticipation by prior claiming as explained above will equally apply to this case (S.18(3)).

6.4 Actions to be taken in case of potential infringement S.19

Section 19:

Powers of Controller in case of potential infringement;

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

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

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

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

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

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

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

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

Rule 32:

Procedure in case of potential infringement;

If in consequence of an investigation made under section 13, it appears to the Controller that the applicant's invention cannot be performed without substantial risk of infringement of a claim of another patent, the applicant shall be so informed and the procedure provided in rule 29 shall, so far as may be necessary, be applicable.

6.4.1 Also, the Controller has power to direct the insertion (in the specification) of the reference to another patent, which could be infringed in the event of performing the invention of the application, and also for the deletion of such reference from there, on the request from the applicant, when the said referred patent ceases, or revoked or relevant conflicting claim is deleted from the other patent. [S. 19, Rules 32 and 33]

6.4.2 The investigation made under Section 13 is not deemed to be conclusive on the question of anticipation and the Central Government or its Officers incur no liability (S.13(4)).

4.176.5 Power of the controller to make orders regarding substitution of applicant

Section 20:

Powers of Controller to make orders regarding substitution of applicants, etc;

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

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

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

- (a) the invention is identified therein by reference to the number of the application for the patent; or*
- (b) there is produced to the Controller an acknowledgement by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made; or*
- (c) the rights of the claimant in respect of the invention have been finally established by the decision of a court; or*
- (d) the Controller gives directions for enabling the application to proceed or for regulating the manner in which it should be proceeded with under sub-section (5).*

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

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

Rule 34:

Manner in which a claim under section 20(1) shall be made;

(1) *A claim under sub-section (1) of section 20 shall be made in Form 6.*

~~(3)~~(2) *The original assignment or agreement or an official copy or notarized copy thereof shall also be produced for the Controller's inspection and the Controller may call for such other proof of title or written consent as he may require.*

Rule 35:

Manner in which a request may be made under section 20(4);

- (1) A request under sub-section (4) of section 20 shall be made in Form 6.
- (2) The request shall be accompanied by proof of death of the joint applicant and a certified copy of the probate of the will of the deceased or letters of administration in respect of his estate or any other document to prove that the person who gives the consent is the legal representative of the deceased applicant.

Rule 36:

Manner of application under section 20(5);

- (1) An application under sub-section (5) of section 20 shall be made in Form 6 in duplicate and shall be accompanied by a statement setting out fully the facts upon which the applicant relies and the directions which he seeks.
(4)(2) A copy of the application and statement shall be sent by the Controller to every other joint applicant.

a)6.5.1 A claim for substituting an applicant(s) has to be made in **Form 6** with the prescribed fee as given in the First schedule along with the original assignment/agreement or an official copy or notarized copy thereof. The Controller may call for other proof of title or written consent of the assignor(s), if required (Rule 34). Accordingly, the Controller, if satisfied, may direct that the application shall proceed in the name of the claimant(s)

b)6.5.2 By virtue of a written assignment or agreement from the applicant or by operation of law, if the claimant(s) makes the claim that, as and when the patent is granted, he may become entitled to any of the following :-

1.a. The patent :If there is only one applicant and he assigns the title in the patent, then the Controller, if satisfied, may direct that the application shall proceed in the name of the claimant(s).[S.20(1)]

2.b. A specific interest in the patent : If there is only one applicant and he passes any of the interests in the patent by way of agreement, then the Controller, if satisfied, may direct that the application shall proceed in the name of the applicant and the claimant(s).

3.c. An undivided share of the patent :if there are more than one applicants and one applicant assigns his title, then the Controller, if satisfied, may direct that the application shall proceed in the name of the claimant(s) and the other joint applicant(s).

4.d. A specific interest in the undivided share of the patent : If there are more than one applicants and one applicant passes any of the interests in the patent by way of agreement, then the Controller, if satisfied, may direct that the application shall proceed in the name of the claimant(s), that applicant and the other joint applicant(s). (S.20(1).

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

6.5.3 The direction to substitute an applicant will not be given unless all the applicants have consented to assign the said rights to the claimant [S.20(2)].

6.5.4 Legal assignments (**Rule 34(2)**) produced along with Form 6 to make the Controller to give directions, should either have a reference of the patent application number in the assignment or in its absence a separate statement of the assignor that it relates to the same invention for which the patent has been filed [S.20(3)].

4-6.5.6 The request by the survivor/survivors for the application for Patent to proceed in their name, when one or more of the joint applicants is dead, has to be in form 6, with the consent of the legal representative(s) of the deceased applicant(s) endorsed on the request, along with a prescribed fee and a proof of death of the joint applicant/s and a document to prove the standing of the person as a legal representative who has signed the endorsement [S. 20(4) & Rule 35] Also see S. 20(5) & Rule 36]

6.5.7 In case of opposition proceeding before the controller ,the opposition prove the ground of obtaining then the controller has the power to substitute the name of the opponent instead of the name of the applicant and issue an order to proceed with the application

6.6 Time for putting the application in order for grant in case when there is no pre-grant opposition, Sec.(21)

Relevant Section and Rules

Section 21.

Time for putting application in order for grant;

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

Explanation.;

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

(2) *If at the expiration of the period as prescribed under sub section (1);*

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

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

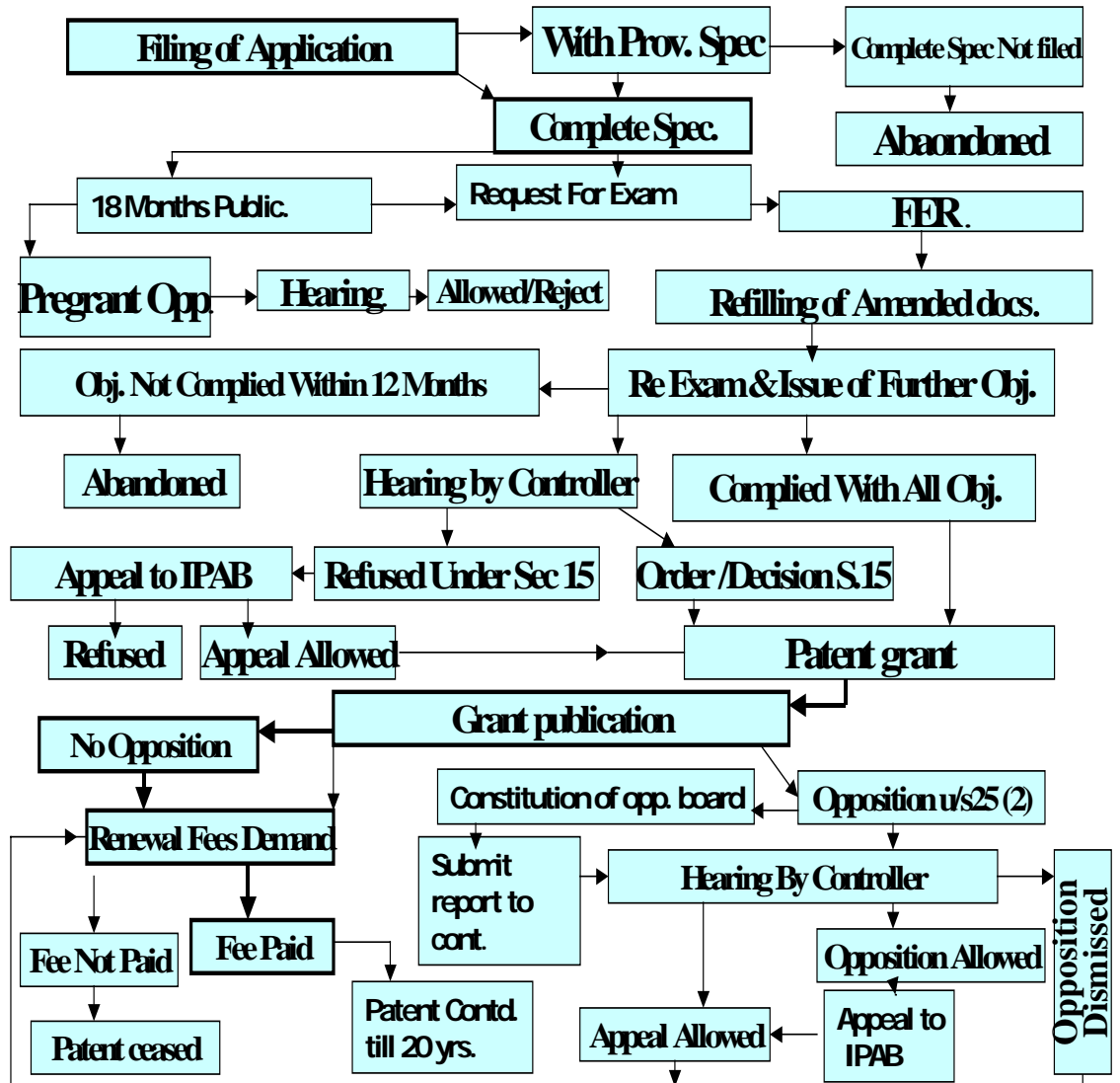
(3) *If the time within which the appeal mentioned in sub-section (2) may be instituted has not expired, the Controller may extend the period as prescribed under sub-section (1), to such further period as he may determine:*

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

6.6.1 The Patent may be granted and the Letters Patent may be issued by the Controller as soon as possible after the applicant has met with all the official requirements within the period specified in section 21 .If there is an opposition, by way of representation u/s 25(1) and the opposition is disposed off with a direction to amend the application within the time prescribed under the order then the applicant is entitled to amend the specification as required by the controller within the prescribed time.

In case, the applicant fails to meet the requirements as above, the application may be abandoned

PROCEDURE FOR THE GRANT OF PATENT



CHAPTER VII

OPPOSITION PROCEEDINGS TO GRANT OF PATENT

7.1 PRE-GRANT OPPOSITION BY REPRESENTATION [S. 25(1)]

Relevant Section and Rules :

Section 25: Opposition to the patent –

(1): Where an application for a patent has been published but a patent has not been granted, any person may, in writing, represent by way of opposition to the Controller against the grant of patent on the ground -

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

- i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or*
- ii) in India or elsewhere, in any other document*
- iii) Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 29;*

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

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

~~e.~~(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.~~(f) That the subject matter of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act

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

~~h.~~(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.~~(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.~~(j) That the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention

~~k.~~(k) That the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere

Rule 55:

(1) Representation for opposition under sub-section '(!) of section 25 shall be filed at the appropriate office and shall include a statement and evidence, if any, in support of the representation and a request for hearing if so desired.

(1A) Notwithstanding anything contained in sub-rule (1), no patent shall be granted before the expiry of a period of six months from the date of publication of the application under section 11A.

(2) The Controller shall consider such representation only when a request for examination of the application has been filed.

(3) On consideration of the representation if the Controller is of the opinion that application for patent shall be refused or the complete specification requires amendment, he shall give a notice to the applicant to that effect along with a copy of such representation.

(4) On receiving the notice under sub-rule (3), the applicant shall, if he so desires, file his statement and evidence, if any in support of his application within three months from the date of the notice.

(5) On consideration of the statement and evidence filed by the applicant, the Controller may either refuse to grant a patent on the application or require the complete specification to be amended to his satisfaction before the patent is granted.

(6) After considering the representation and submission made during the hearing if so requested, the Controller shall proceed further simultaneously either rejecting the representation and granting the

patent or accepting the representation and refusing the grant of patent on that application, ordinarily within one month from the completion of above proceedings

7.1.1 Grounds for Pre-grant Opposition by way of Representation u/s 25(1) are summarized as follows:

- a) Wrongfully obtaining
- b) Prior publication / prior claiming
- c) Prior claiming in India
- d) Prior public knowledge or public use in India
- e) Obviousness and lack of inventive step
- f) Not an invention or the invention not patentable
- g) Insufficient description of the invention
- h) Failure to disclose information or furnishing false information relating to foreign filing
- i) Convention application not filed within the prescribed time
- j) Incorrect mention of source/geographical origin of biological material
- k) Invention anticipated with regard to traditional knowledge of any community , anywhere in the world

No ground other than the statutory grounds as above can be taken for opposing the Grant of Patent under section 25(1)

7.1.2. Proceedings under Pre-Grant Opposition:

1. Any person can file opposition by way of representation to the Controller against the grant of patent, at the appropriate office, before the grant of patent on any of the above-mentioned grounds.
2. The Controller shall not grant the patent before the expiry of 6 months from the date of publication under section 11 A. Therefore, a person should try to file such representation within the assured period of 6 months from the date of publication under section 11 A.
3. The representation shall include a statement and evidence, if any, in support of such representation and a request for hearing, if so desired

4. The Controller shall consider the representation only after a Request for Examination for that application has been filed.
5. On consideration of representation, if the Controller is of the opinion that the application shall be refused or the complete specification requires amendment, he shall give notice to the applicant to that effect along with the copy of such representation.
6. The applicant shall, if he so desires, give reply to that representation along with his statement and evidence, if any, in support of his application within three months from the date of the notice.
7. The Controller shall consider the statement and evidence filed by the applicant and may either refuse the grant of patent or ask for amendment of the complete specification to his satisfaction before the grant of patent.
8. After considering the representation and submission made during the hearing, if so requested, the Controller shall proceed further simultaneously, either rejecting the representation and granting the patent or accepting the representation and refusing the grant, ordinarily **within one month** from the completion of the above proceedings.

Example1:

Case study of Pre-Grant Opposition under section 25(1) :

- **Application No.1602/MAS/1998**
 - **M/s Novartis AG, Switzerland v. Controller of Patents, India**
1. **An application for patent was filed in India on July 17, 1998 (at Patent Office, Chennai) by M/s Novartis AG, Switzerland, claiming Switzerland priority date of July 18, 1997 for an invention titled “Crystal Modification of A N-Phenyl-2-Pyrimidineamine derivative, processes for its manufacture and its use” and the same was allotted the Application No.1602/MAS/1998.**
 2. Upon publication, the grant of patent was opposed by way of representation u/s 25(1) by M/s Natco Pharma Ltd., India on 26/05/2005 and they also requested for hearing. The grounds for opposition were i) Anticipation by Prior Publication ii) Lack of inventive step iii) Non-patentability u/s 3(d) of the Patents Act and iv) Wrongfully claiming the Priority.
 3. Applicant filed the reply statement with evidence on 25/07/2005 and also asked for hearing.
 4. The Controller conducted the hearing and considered various grounds for opposition in the light of submissions by both the parties and concluded as follows:
 - 5 (i) **Anticipation by Prior Publication:**

The title compound commercially, called imatinib mesylate, which has been claimed by the applicant is already known in the US Patent No.5521184 (1993 Patent) The 1993 Patent discloses methanesulphonic acid as one of the

salt –forming groups and also states that the required acid additions salts are obtained in a customary manner. Further ,claims 6to 23 of the 1993 Patent claim a pharmaceutically acceptable salt of the base compound.. Another Document, “Nature Medicine” (May 5, 1996) also describes the title compound. Also the compound , imatinib mesylate salt inherently existed in the β -crystalline form, which is most stable form of the salt. This fact is also clear from the results of laboratory experiments conducted by two reputed government institutions, namely, Indian Institute of Chemical Technology, Hyderabad and Indian Institute of Technology, Delhi, . Hence, the claims of the present application for the product and process in respect of the title compound stand anticipated by Prior Publication

ii) Lack of inventive step:

Since the 1993 Patent disclosed the free base of the base compound, it was obvious for a person skilled in the art to prepare the corresponding pharmaceutically acceptable salts. The studies by the two laboratories mentioned above clearly demonstrated that the salt prepared using teachings and instructions of the 1993 Patent inherently exists in β -crystalline form. Hence the product claims are obvious over the aforesaid disclosure in the prior art.

iii) Non-patentability u/s 3(d) of the Patents Act: As per section 3(d), any salt or polymorph or derivative of the known substance is not patentable unless such salt or polymorph or derivative shows enhanced efficacy of the substance. As regards efficacy, the patent specification itself states that, wherever β -crystals are used, the imatinib free base or other salts can be used. The affidavit submitted by the technical expert on behalf of the applicant demonstrated that the relative bioavailability of the free salt with that of β -crystal form of imatinib mesylate differ only by 30% and accounted this difference to their solubility in water. Thus, the present specification does not bring out any improvement in the efficacy of the β -crystal form over the known substances ; rather its states that the base compound can be used equally in the treatment of diseases or in the preparation of pharmacological agents wherever the β -form is used. Thus, the product claim amounts to a mere discovery of the new form of the known substance. Hence, the subject matter of this application is not patentable u/s 3(d) of the Patents Act, 1970, as amended by Patents (Amendment) Act, 2005.

iv) Wrongfully claiming the Priority:

The application filed in India has claimed the Swiss priority dated 18/07/1997, but Switzerland was not an convention country on that date. It became the convention country only in September,1998. Hence, no priority of Swiss application can be claimed in respect of the present application.

Decision:

In view of the above findings and arguments made by both the parties during the hearing , the Learned Controller ruled that the Patent Application no.1602/MAS/1998 cannot proceed for grant of patent.

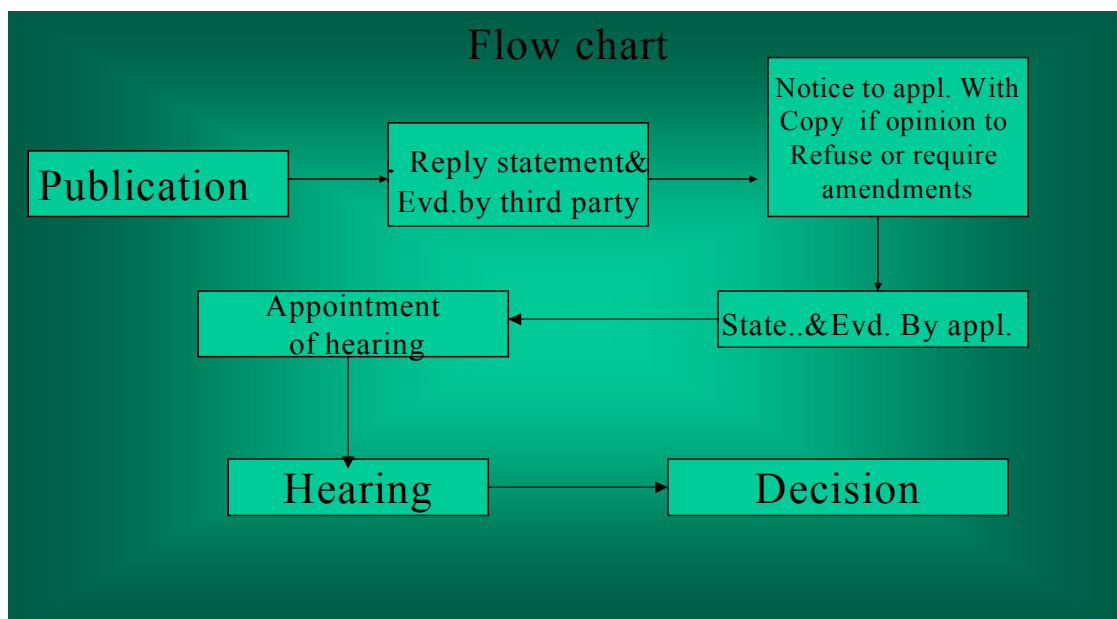
Example 2:

In case of application *No. IN/PCT/2002/00020/DEL, U/S 25(1)* , it was concluded that invention as claimed in finally revised claims 1 to 49 in the Patent application no. IN/PCT/2002/00020/Del does not involve any "inventive step" having regard to the prior art citations JP-8059512 published on 05/03/1996 and US Patent 5,885,617 published on 23/03/1999. Therefore it cannot be considered as an invention under section 2(1)(j) of the Patents Act. As it is a mere admixture and therefore not patentable under section 3(e) of the Patents Act.

It was held that “the selection of particular range of ingredients from the ranges already known prior art in this case cannot amount to establish the inventive step and The variations in the amounts of the known ingredients appear merely workshop improvements achieved by a person skilled in the art without performing any substantial experiments and can not be said a technical advancement of an existing knowledge which is required by the definition of the "inventive step" as mentioned in section 2(1)(ja) of the Patents Act, 2005.” and for the ground u/s 3(e) that “The existence of already known characteristics of composition with known ingredients cannot be termed as synergy among the ingredients of claimed composition”

Further Patent Application Nos. 1903/MAS/1996, 1904/MAS/1996 and 912/MAS/1997, were refused under the proceedings of section 25(1) on the grounds of prior publication and patent application no. 1903/MAS/1996 was refused on additional ground of insufficiency of disclosure.

Procedure for Opposition U/S 25(1)



7.2 POST-GRANT OPPOSITION [S. 25(2)]

Relevant Section and Rules :

Section 25: Opposition to the patent. -

(2): At any time after the grant of patent but before the expiry of a period of one year from the date of publication of grant of a patent, any person interested may give notice of opposition to the Controller in the prescribed manner on any of the following grounds, namely:--

- (a) that the patentee or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;*
- (b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim;*
 - (i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or*
 - (ii) in India or elsewhere, in any other document:*

Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of

the invention by virtue of sub-section (2) or sub-section (3) of section 29;

- (c) *that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the claim of the patentee and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the claim of the patentee;*
- (d) *that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.*

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

- (e) *that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the applicant's claim;*
- (f) *that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;*
- (g) *that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;*
- (h) *that the patentee has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge;*
- (i) *that in the case of a patent granted on a convention application, the application for patent was not made within twelve months from the date of the first application for protection for the invention made in a convention country or in India by the patentee or a person from whom he derives the title*
- (j) *that the complete specification does not disclose or wrongly mentions the source and geographical origin of biological material used for the invention*
- (k) *that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or*

otherwise, available within any local or indigenous community in India or elsewhere,

but on no other ground.

- (3): (a) *Where any such notice of opposition is duly given under sub-section (2), the Controller shall notify the patentee.*
- (b) *On receipt of such notice of opposition, the Controller shall, by order in writing, constitute a Board to be known as the Opposition Board consisting of such officers as he may determine and refer such notice of opposition along with the documents to that Board for examination and submission of its recommendations to the Controller.*
- (c) *Every Opposition Board constituted under clause (b) shall conduct the examination in accordance with such procedure as may be prescribed.*
- (4) *On receipt of the recommendation of the Opposition Board and after giving the patentee and the opponent an opportunity of being heard, the Controller shall order either to maintain or to amend or to revoke the patent.*
- (5) *While passing an order under sub-section (4) in respect of the ground mentioned in clause (d) or clause (e) of sub-section (2), the Controller shall not take into account any personal document or secret trial or secret use.*
- (6) *In case the Controller issues an order under sub-section (4) that the patent shall be maintained subject to amendment of the specification or any other document, the patent shall stand amended accordingly.*

Rule 55A:

The notice of opposition to be given under sub-section (2) of section 25 shall be made in Form 7 and sent to the Controller in duplicate at the appropriate office.

Rule 56:

- (1) *On receipt of notice of opposition under rule 55A, the Controller shall, by order, constitute an Opposition Board consisting of three members and nominate one of the members as the Chairman of the Board.*
- (2) *An examiner appointed under sub-section (2) of section 73 shall be eligible to be a member of the Opposition Board.*
- (3) *The examiner, who has dealt with the application for patent during the proceeding for grant of patent thereon shall not be eligible as member of Opposition Board as specified in sub-rule (2) for that application.*
- (4) *The Opposition Board shall conduct the examination of the notice of opposition along with documents filed under rules 57 to 60 referred to under sub-section (3) of section 25, submit a report with reasons on each ground taken in the notice of opposition with its joint recommendation within three months from the date on which the documents were forwarded to them.*

Rule 57:

The opponent shall send a written statement in duplicate setting out the nature of the opponent's interest, the facts upon which he bases his case and relief which he seeks and evidence, if any, along with notice of opposition and shall deliver to the patentee a copy of the statement and the evidence, if any.

Rule 58:

(1) *If the patentee desires to contest the opposition, he shall leave at the appropriate office a reply statement setting out fully the grounds upon which the opposition is contested and evidence if any, in support of his case within a period of two months from the date of receipt of the copy of the written statement and opponent's evidence if any by him under rule 57 and deliver to the opponent a copy thereof.*

(2) *If the patentee does not desire to contest or leave his reply and evidence within the period as specified in sub-rule (1), the patent shall be deemed to have been revoked.*

Rule 59:

The opponent may, within one month from the date of delivery to him of a copy of the patentee's reply statement and evidence under rule 58, leave at the appropriate office evidence in reply strictly confined to matters in the patentee's evidence and shall deliver to the patentee's a copy of such evidence.

Rule 60:

*No further evidence shall be delivered by either party except with the leave or directions of the Controller :
Provided that such leave or direction is prayed before the Controller has fixed the hearing under rule 62.*

Rule 61:

~~(2)~~(1) *Copies of all documents are referred to in the notice of opposition or in any statement or evidence filed in connection with the opposition and authenticated to the satisfaction of the Controller, shall be simultaneously furnished in duplicate unless the Controller otherwise directs*

~~(3)~~(2) *Where a specification or other document in a language other than English is referred to in the notice, statement or evidence, an attested translation*

thereof, in duplicate, in English shall be furnished along with such notice, statement or evidence, as the case may be.

Rule 62:

- (1) On the completion of the presentation of evidence, if any, and on receiving the recommendation of Opposition Board or at such other time as the Controller may think fit, he shall fix a date and time for the hearing of the opposition and shall give the parties not less than ten days' notice of such hearing and may require members of Opposition Board to be present in the hearing.*
- (2) If either party to the proceeding desires to be heard, he shall inform the Controller by a notice along with the fee as specified in the First Schedule.*
- (3) The Controller may refuse to hear any party who has not given notice under sub-rule (2).*
- (4) If either party intends to rely on any publication at the hearing not already mentioned in the notice, statement or evidence, he shall give to the other party and to the Controller not less than five days' notice of his intention, together with details of such publication.*
- (5) After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing, and after taking into consideration the recommendation of Opposition Board, the Controller shall decide the opposition and notify his decision to the parties giving reasons there for.*

Rule 63:

If the patentee notifies the Controller that he desires to withdraw the patent after notice of opposition is given, the Controller, depending on the merits of the case, may decide whether costs should be awarded to the opponent.

Section 150:

If any party by whom notice of any opposition is given under this Act or by whom application is made to the Controller for the grant of a licence under a patent neither resides nor carries on business in India, the Controller may require him to give security for the costs of the proceedings, and in default of such security being given may treat the opposition or application as abandoned.

7.2.1 Grounds for Post-grant Opposition u/s 25(2) are summarized as follows:

- a) Wrongfully obtaining
- b) Prior publication / prior claiming
- c) Prior claiming in India
- d) Prior public knowledge or public use in India

- e) Obviousness and lack of inventive step
- f) Not an invention or the invention not patentable
- g) Insufficient description of the invention
- h) Failure to disclose information or furnishing false information relating to foreign filing
- i) Convention application not filed within the prescribed time
- j) Incorrect mention of source/geographical origin of biological material
- k) Invention anticipated with regard to traditional knowledge of any community , anywhere in the world

7.2.2 Proceedings under Post Grant Opposition [S 25(2)]

1. Any interested person can oppose the grant of Patent under section 25(2) by giving a notice to the Controller, within one year form the date of publication of grant of a patent in the official journal.

Person interested [S. 2(1) (t)] includes a person engaged in, or in promoting research in the same field as that to which the invention relates. Any person including an organization that has a manufacturing or trading interest in the goods connected with the patented article or who has a financial interest in manufacturing such goods or who possesses patents relating to the same subject, is considered as person interested

2. The notice of opposition shall be made in Form 7 and sent to the Controller in duplicate at the appropriate office along with the prescribed fee given in first schedule. The notice of opposition shall be accompanied by a written statement (in duplicate) stating out the nature of opponent's interest, the facts upon which he bases his case and the relief which he seeks and evidence, if any, in duplicate in support of his case. **(Rule 57)**. The opponent shall deliver to the patentee a copy of the statement and the evidence, if any, filed by him along with the notice of opposition.
3. The Controller shall notify the patentee regarding the filing of the opposition.
4. **Opposition Board:** On receipt of the notice of opposition under rule 55A, the Controller, by order, shall constitute an Opposition Board which will consist of three examiners as members, other than the examiner who has examined the application. The Controller shall nominate one of the members as the chairman of the Board.
5. If the patentee desires to contest the opposition, he shall send the reply statement at the appropriate office giving grounds for contesting the opposition and evidence, if any, in support of his case within a period of 2 months from the date of receipt of a copy of the written statement and opponent's evidence

by him [**Rule 58**]. The patentee shall deliver to the opponent a copy of reply statement and evidence. (**Rule 58**).

6. If the patentee does not desire to contest or fails to send his reply and evidence within the specified period as above, the patent shall be deemed to have been revoked [**Rule 58 (2)**].
7. The opponent may file the evidence in reply within one month from the date of delivery to him a copy of reply statement and the evidence by the patentee; such a reply evidence by the opponent must be strictly confined to the matters in the patentee's evidence (**Rule 59**). Also, the opponent shall deliver to the patentee a copy of his reply evidence.
8. No further evidence shall be delivered by either party except with the leave or direction of Controller (**Rule 60**). Such a leave or direction shall be prayed before the date of the hearing has been fixed by the Controller.
9. The Opposition Board shall examine the notice of opposition and documents filed under **Rules 57 to 60** and submit a report with reasons on each ground within 3 months from the date on which the documents were forwarded to them with its joint recommendation.
10. On receipt of the recommendations of the opposition board along with all evidence filed by both the parties, the Controller shall fix a hearing but at least ten days notice should be given to both the parties (**Rule 62**). The Controller may require members of the Opposition Board to be present in the hearing.
11. If any party desires to be heard he shall make a request to the Controller along with prescribed fees given in first scheduled.
12. After hearing and taking in to account the recommendations of opposition board, the Controller will decide whether costs should be awarded to the opponent.

7.2.3 Cases reported for the post-grant opposition held on various grounds of section 25 (2) of Indian Patents Act are as mentioned below :

Example: 1

In the matter of Patent No.187163, (581/BOM/1999), the opposition was lodged on the ground of obtaining and request was made to mention the opponent's name as an inventor. The opponents who was working as a Research Assistant and whose job was that of laboratory technician and not as scientist did not produce any substantial evidence or witnesses to substantiate his claim as an inventor. For naming the inventor, he must have provided ideas to produce 'germ of invention' and made intellectual contribution in achieving the final result of research leading to a patent. One or more person involved to arrive at the conception or realization

of the final product or process or merely involved in carrying out experiments does not mean that they are inventors. The inventor for the purpose of Patent law is the actual deviser of what is being claimed. So the opponent failed to prove this ground. (Wrongfully Obtaining)

Example 2 :

In the matter of Patent No.- 173953 (223/BOM/1991), the invention related to "Process for making a soap composition containing glycerol". The opposition was lodged on the ground of prior publication u/s 25 (1)(b), prior public knowledge 25 (1)(d), obviousness, u/s 25 (1)(e), not an invention within the meaning of the Act u/s 25 (1)(f) and does not sufficiently define the invention u/s 25 (1)(g).

It was held that the ingredients recited in the principal claim have a very specific and narrow range of proportions, which are not taught by cited documents. Cited document also do not teach how to obtain the right balance of salt and glycerol in order to avoid a soap which is too hard or too soft and also do not mention about balancing quantities of glycerol or salt against the quantities of total fatty matter. The alleged invention mentions the prior art, problems associated with it, results of various experiments, and best method of working examples. Considering all these factors it was judged that the opponents had failed to establish the above grounds and opposition was rejected

Example3 :

In the matter of Patent No.- 183458 (454/BOM/1998);_the invention related to "A process for the preparation of a therapeutic Anti-inflammatory and analgesic composition containing Nimesulide for use transdermally" Opposition was lodged on the ground of prior publication Under Section 25 (1)(b), prior public knowledge Under Section 25(1)(d), Obviousness Under Section 25 (1)(e), not an invention within the meaning of the Act Under Section 25 (1)(f).

Comparison of the alleged invention 183458 with the Sri Lanka's Patent 11012 & Nigerian Patent RP 12829 clearly shown that it does not pass the test of the novelty It is sufficient to destroy the novelty of the claimed process that this process and the known process are identical with respect to the starting material and reaction condition since process as identical in these features must inevitably yield identical products. It was held that in view of the cited Srilankan & Nigerian Patents the alleged invention stand anticipated as cited document has disclosed the invention or disclosed information in such a way as to make it part of the state of the art.

Grant of Patent was refused on the above grounds.

Example 4 :

In the case of Gujrat Reclaim & Rubber Products Ltd V Kamani Metallic Oxides Ltd1983 (3) PTC 105 (PO), a notice of opposition to the grant of a patent to M/s. Kamani Metallic Oxides Ltd., Bombay, for their patent No. 145917, application number 43/BOM/1976 , for an invention titled "A process for separation of rayon or nylon fibres from cracked

waste tyres and an apparatus thereof” was filed by M/s. Gujarat Reclaim & Rubber Products Ltd., Bombay, on 15-6-1979 having regard to the prior art citations JP-8059512 published on 05/03/1996 and US Patent 5,885,617 published on 23/03/1999.

Opposition to grant of patent was on the grounds of prior publication, prior public knowledge and prior public use, lack of inventive step and insufficiency of description .

It is held that the opponents being engaged in the manufacture of reclaimed rubber in which cracked waste of automobile tyre and such other rubber waste are used and have a manufacturing unit, the opponent are held as 'persons interested' as stipulated in section 25 of the Act. Opponents deposed in support of the opposition that the types of standard machineries used for carrying out the process of separating the rubber particles from fibrous materials and the alleged invention disclosed in the applicants' complete specification has been anticipated by the Exhibits. In the circumstances, a rubber technologist would know its application to cracking of rubber for separation of fibre from rubber and particularly from waste tyres and in fact it has been used for said purpose for many years.

Applicants contested all the arguments of opponents and argued that the opponents have confused the issue by saying that something used in some point of time in the reclamation industry has been claimed by the applicants. He said that applicants' invention lies in the process and apparatus for the separation of fibre from cracked tyres waste i.e. a narrow aspect of dealing with the wider subject of rubber reclamation. So far as the document relating to reclaim from natural and synthetic rubber scrap is concerned, the original which was a confidential document ,and therefore, it has not been published and which is not open to public. On a scrutiny of this document the court observed that the disclosure related to the general process for reclaiming of rubber from natural and synthetic rubber scrap and slow grinder discs for precracking.

The process consisting of three stage viz. cracking, fabric separation and grinding the details given there are applicable generally in a rubber reclaiming process. The invention disclosed in the applicants' specification related to an improved process for the removal of fibre from cracked automobile tyre wastes i.e. the second aspect of the above said three stages process. The steps involved in the process claimed in the complete specification are not found in the said document. No details have been given in the publication about the process and apparatus for removal of fibre from tyre wastes, as has been disclosed in the applicants' specification. Accordingly, the disclosure contained in the said document, even if it is considered to have been published before the priority date of the applicants, the application does not anticipate the applicants' process and apparatus..

Hence, the opponents failed to establish the ground of prior publication. Similarly the opponents also failed under the ground of prior public knowledge and prior public use as the documents relied upon by the opponents are not relevant as they do not anticipate the applicant's invention. The opponents failure to provide any other evidence in support of their contention as to obviousness and lack of inventive step failed them on this ground also. Hence, there being no force in their other grounds of opposition, the opposition is dismissed .

It was held for the ground under section 2 (1)(j) that “the selection of particular range of ingredients from the ranges already known in the prior art in this case

cannot amount to establish the inventive step and variations in the amounts of the known ingredients appear merely workshop improvements achieved by a person skilled in the art without performing any substantial experiments and can not be said a technical advancement of an existing knowledge which is required by the definition of the "inventive step" as mentioned in section 2(1)(ja) of the Patents Act, 2005."

Example 5 :

In the matter of *Thermax Private Limited v. Deccan Sugar Industries*, (1987 PTC 137.) Opponents in their written statement of opposition made certain allegation which can be construed to be in support of this ground of opposition, namely, unfair description. The opponents in their written statement of opposition at page 3 para (j) thereof made certain allegations about description wherein they alleged that the specification contained several process variations. What is stated by the opponents during hearing can be construed as an implication of their written statement. Further, during hearing, the applicants were at liberty to deal with each of the opponents' allegations separately and elaborately which they have not done. The opponents clearly proved the deficiencies in the description. Hence, the ground of unfair description is established. Opponents have therefore succeeded in this ground.

Example 6 :

In the matter of *Jagdish Mohanlal Joshi V/s. Ghodavat Pan Masala Products P. Ltd.* Patent No. 188090 (application no. 166/BOM/1997) Among other grounds, the "insufficiency of description" was a ground for opposition under Section 25(1)(g), citing "If the applicant does not give prior art details in the specification it would mislead the controller and the public, mouth refreshing preparations with tobacco and without tobacco are known in the art, and the applicant is not entitled for a patent unless he shows that his process is an improvement over the earlier process. For this purpose, when 47 RPC 289 was cited submitting that the patent should justify clearly why a particular selection is made, the applicant submitted that the "Non disclosure of prior art does not result in insufficiency of description, the disclosure should enable the skilled person to exercise the invention which the applicant did, and further he deemed the impugned invention was a selection patent". The Controller agreed with the applicant's submission and upheld the patent and dismissed the opposition.

Example 7 :

In the matter of Patent No. 176382(322/BOM/1992) filed by M/s Hindustan Lever Limited titled " Toilet soap bars and the process of manufacturing the same" on 14/10/1992 having two priorities of GB dated 14/10/1991 and 14/07/1992. The Patent was granted on 18th May, 1996 and was opposed under Section 25 by M/s Godrej Soaps Limited.

3.2. Grounds of Opposition:

- Prior publication section 25 (1) (b)
- Prior public use and prior public knowledge section 25 (1) (d)
- obviousness and lack of inventive step section 25 (1) (e)
- Not an invention or not a patentable invention section 25 (1) (f)
- insufficiency and clarity of description section 25 (1) (g)
- “The applicant has failed to disclose to the controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge” section 25 (1) (h)

4.3. Proceedings: The case was heard by the controller on 19th Sep, 2003

Opponents relied upon following documents

- i) Exhibit A: Page 214 of soap Technology for the 1990's edited by Luis Spitz.
- ii) Exhibit B: Indian standard Bathing bar specification
- iii) European Patent No. EP0363215 and
- iv) An expert's evidence

After the hearing it was concluded that the teachings of the exhibits were either not pertinent or insufficient to prove the grounds and the opponents could not prove any of the above grounds of opposition.

Applicants made amendments in the description and claims at the time of hearing to make their point clear and to overcome the opponents' allegations. As all the amendments were within the scope of invention and have support in the description, these amendments in the claims were allowed.

Decision : After considering notice of opposition, statements of both the parties, evidences from both opponents & applicants and hearing, the opposition was dismissed.

Example 8 :

In the matter of Patent No. 179304 (124/Cal/93) filed by M/s. Rickitt & Colman of India Ltd) for "A Mosquito/Insect Repellent Device" was opposed by Godrej Hi Care Ltd under Section 25 of the Act. Hearing was held on 10th January, 2001

The applicants' invention related to a mosquito/insect repellent device comprising the: (i) a bottom cover (ii) a positive temperature co-efficient (PTC) thermister heater assembly and (iii) a top cover having opening for insertion of mats for placement on said heater assembly

The proceedings of the opposition took place to decide whether the applicant's devices involve any inventive step and the opponents lead any evidence as to patentability. The opponents have challenged the alleged application for Patent No. 179304 on the grounds of Section 25 namely, anticipation by prior publication- clause (b), anticipation by prior claiming - clause (c), prior public knowledge or public use- clause (d) & obviousness and lack of inventive step- clause (e)

Opponents relied upon citation of Registered Design No.56444, photographs of Registered Design No. 159918 dated 5th July, 1988 and advertisement in News paper with photographs of mosquito repellent with extended cord in the brand name

of 'Good Night' dated 06.08.1990 (Ex-C1), News paper clipping of cordless 'Good Night' dated 15.12.1989 (Ex-C2), copy of letter with photograph of 'Good Night' of Creative Unit Private Ltd. Advertising & Marketing to Godrej Hi Care Ltd. dated June 7, 1999 regarding launch date of "Good Night Cordless Machines" (Ex-C3). 5th July, 1983 & 5,038,974 dated 6th August, 1991.

Proceedings:

It can not be concluded that the cited documents on Patents and Designs can establish anticipation by prior publication, as by combining the integers of the mosquito repellent from the cited patent & design documents is not resulting the identical article as produced by the alleged invention.

No document has been produced or referred by the opponents regarding any claim made by the applicants containing a subject of a claim of earlier priority date in a complete specification published after the priority date of applicants' claim. The opposition therefore can not stand based on the ground of prior claiming.

While considering ground under Section 25(1)(e) i.e. obviousness and the lack of inventive step, the Tribunal considered and analysed the difference between cited documents and the opposed specification to have any relevance regarding obviousness and lack of inventive step

The device 'Mosquito Repellent' under the brand name of 'Good Night' is under public knowledge and use for more than a decade. The Exhibit Ex-C2 & Ex-C3 reveal that the cordless mosquito repellent having press fit detachable top & bottom portion with arrangement of insertion of mat on heater assembly and twist-n-turn i.e. rotatable two pinned plug fitted with the device, manufactured and marketed by Transelektra Domestic Products Private Ltd. were under public knowledge and use much earlier than the date of the alleged application for Patent No. 179304. For more than a decade the rotatable plug through 90 degree is under public knowledge & use in many domestic electrical appliances and the press fit arrangements are under public knowledge and use even much more than a decade. The press fit arrangement of the top and bottom cover as depicted in Unit (iv) in paragraph 2 wherein the projections of the top cover being press fitted with the corresponding grooves formed on the inside face of bottom cover, is a mere workshop modification. Supposing that in the application for patent in question there is a difference with the cited documents in respect of the matter wherein the plug being adopted in a detachable and rotatable manner by providing on the plug rear portion with a integrally formed tubular portion having radially extending flanges as narrated in feature (v) of the alleged application, even in that case it is mere a workshop modification.

The Applicants' counsel have stated during hearing that the alleged device has produced achievements (1) Maintaining of constant temperature of 150o C (2) can easily assemble and disassemble (3) is a compact and can be conveniently used without the necessity of any extendable cord (4) is a safer construction (5) give a regulated release of active material by regulating temperature at 150o C.

All the above stated achievements of the alleged application have been found and claimed in the cited US documents. In the above background this Tribunal

find that the alleged application has its integers (i) to (v) as narrated in paragraph 2 anti by combining one feature of an earlier specification with another earlier specification and so on to secure no advantage other than addition of their respective merits. The Tribunal therefore concluded that the alleged application No. 179304 titled "A Mosquito/Insect Repellent Device" is obvious and clearly does not involve any inventive step.

The grant of patent was therefore refused.

[Rickett & Colman of India Ltd. V Godrej Hi Care Ltd.,(2001 PTC 637 (PO))].

Example 9 :

In the matter of *M/s. Crompton Greaves Ltd. Mumbai (Applicant)Vs. M/s. Bharat Heavy Electricals Ltd. Hyderabad (Opponent)* Patent application No. 184657 (221/BOM/96)

This is an opposition under Section 25 of the Patents Act, 1970 to the grant of Patent to M/s. Crompton Greaves Limited, Mumbai on their application for Patent No. 184657 (221/BOM/1996) dated 19th April, 1996 . The invention related to "A single phase traction transformer for AC electric locomotive and a method of manufacturing the same".

Under the ground of prior publicly known or publicly used in India under Section 25(1)(d), the opponent submitted that they are in the field of designing and manufacturing traction transformer and developed traction transformer or 3900 KVA in the year 1974. The opponent has supplied more than 600 single-phase traction transformer of 3900 KVA to Indian Railway against their various purchase orders prior to their Patent Application No. 184657 after approval of prototype design from Indian Railway (RDSO). BHEL (Opponent) was the first to supply 5400 KVA of traction transformer to Indian Railway.

It was held by the Controller that the ground under section 25(1)(d) that the invention was publicly known or publicly used in India was not established by the opponent – since the photo copies submitted by the opponent state mainly the terms and conditions of a contract to supply 3900 KVA & 5400 KVA traction transformers. The photocopies of work order did not define any constructional features of the traction transformer. Only by stating that we are the first in the field of manufacturing the applicant company cannot be stopped from obtaining a patent unless the opponents establish that they are manufacturing an identical product.

Example 10 :

In case of Patent No. 184656 (*Patent Application No. 221/BOM/96*) the opponents have submitted on the ground of obviousness that the alleged invention is obvious mechanical equivalent of what been known prior to the date of the impugned application. The opponent pleaded that transformer technology is known in the art and claims as worded do not have inventive steps. The opponent submitted that simply stating that the steps and features involved in the claimed invention are obvious is not sufficient without disclosing any prior art which would make the invention obvious to a person skilled in the art. The Controller held that when the

“invention is obviating certain drawbacks of the conventional traction transformer, it cannot be said that the invention is obvious” in absence of relevant prior art.

Example 11 :

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This is an opposition to the grant of a patent under Section 25 of the Patents Act, 1970 for Patent No. 151977 of M/s. Jaya Hind Industries Limited (Applicants) for “External Rotor Assembly for a Magneto”

The opponent M/s. Scooters India Limited, filed a notice of opposition against the grant of a patent on the above application on 12th January, 1984. The case was heard on 30th June, 1986.

Grounds of opposition were Prior publication section 25 (1) (b) , Prior public use and prior public knowledge section 25 (1) (d), obviousness and lack of inventive step section 25 (1) (e), Not an invention or not a patentable invention section 25 (1) (f) insufficiency and clarity of description section 25 (1) (g)

The invention related to an external rotor assembly for a magneto comprising a ferrous yoke fixed to a nonferrous housing having an angular disc with an even number of lugs projecting there from, ferrite magnets (with or without their respective poleshoes) being fixed to the said yoke the said lugs being adapted to hold securedly between them the said ferrite magnets (with or without their respective poleshoes) and the said housing being adapted to be mounted on to the crankshaft of an engine.

In view of the findings in consideration of all matters stated in the written statement, reply statement and evidence as well as the arguments furnished by the opponents and applicants during the hearings and all the circumstances of the case, it was concluded that the opponents have not proved the ground of prior publication and prior public knowledge and have also not submitted any evidences to the fact that the invention is obvious. Therefore, the opposition filed by the opponents M/s. Scooter India Limited on application No. -151977 is dismissed

[Scooters India Ltd. V Jay Hind Industries Ltd, 1987 (7) PTC 204(PO)]

Example 12

In the matter of Wal Chand Nagar Industries Ltd. v. Thermax Private Ltd., (1988 PTC 213.) Invention entitled "A process for recovery of potassium sulphate from waste liquids such as distillery spent-wash", which was opposed by the opposition on ground of prior publication and prior public knowledge. However, the opposition could not be established and hence, opposition was dismissed and patent granted

Example 13

In case of *Mechelonic Welders Pvt. Ltd. v. Paul Opprecht*, (1988 PTC 126.) Application was filed for invention 'Electrical Resistance Seam Welding

Machines' on the ground of prior use which could not be established. The opposition was dismissed and patent proceeded for grant, subject to the amendment in the applicant's specification.

Example 14

An Application for patent for an invention entitled 'A method for making a plant growth nutrient/stimulant' was filed by Hindustan Lever Limited. The acceptance of the application was notified in the Gazette of India part III, Section 2 dated 14-12-1982 after a serial number, 150203 was accorded to it.

The invention relates to "A method for making a plant growth nutrient/stimulant which comprises subjecting plant waxes like rice bran wax, camauba wax or sugarcane wax to a step of saponification obtain a mixture of saponified and non saponified matter, whereafter the non-saponified matter is separated and recovered from the said mixture by selective extraction is an organic solvent as the said plant growth nutrient/stimulant, and optionally converting said nutrient/stimulant into a stable aqueous emulsion in a conventional manner.

The alleged method consisted of only two steps and an optional step namely subjecting plant waxes like rice bran wax, camauba wax or sugarcane wax to a step of saponification to obtain a mixture of saponified matter is separated and recovered from the said mixture by selective extraction in an organic solvent as the said plant growth nutrient/stimulant, and, optionally converting said nutrient/stimulant into a stable aqueous emulsion in a conventional manner

The opponents relied upon scientific publications and expert's evidence . It is held that properties of unsaponified products is not a fit subject matter for the grant of a valid patent, moreover the ground of prior publication having been established, the opposition succeeds on this ground and it is ordered that the patent shall not be granted.

[Kay Laboratories v. Hindustan Lever Limited (1988 PTC 31 Mum)]

Example 15

In the case of Abid Kagalwala v. Edgar Haddley Co. Pvt. Ltd. (1984 PTC 234) for an invention relating to 'An improved Electrical Switch', it was held that the Applicant has not described as how the use of a resistor in the circuit would be able to eliminate the use of an amplifier. Also the invention has not been properly and clearly described and will not function in the way claimed by the applicants. Hence the patent grant was refused.

Example 16

In an opposition for the patent no. 194085 [AIR 1961 GUJARAT 120 at Page 125] grounds of opposition included prior disclosure and lack of inventive step.

For the prior disclosure, it was held that “Where prior disclosure is relied upon, it is necessary to point to a clear and specific disclosure of something which can be fairly stated to be the invention of the patentee/applicant. If it is something which is said to be like the patentee's/applicant's invention, there should be a description of its use and the manner in which the patentee/applicant intends it to be used. It is not open to take a packet of prior documents, and, as it were, by means of some process of putting a puzzle together, produce what is said to be a disclosure in the nature of a combination of the various elements which have been contained in the prior documents” and that “To anticipate a patent, a prior publication or activity must contain the whole of the invention impugned, i.e. all the features by which the particular claim attacked is limited, for the anticipation must be such as to describe, or be, an infringement of the claim attacked.”

[*M/s. Teva Pharmaceuticals Industries Ltd. vs. M/s. Torrent Pharmaceuticals Ltd.*]

Example 17

In the matter of Patent No.- 173462 (224/BOM/1991) between M/s. Hindustan lever limited (Applicants) vs. M/s. Godrej soaps limited (Opponents). The invention related to “process for making a soap composition containing glycerol”. Opposition was on the ground of prior publication Under Section 25 (1)(b), prior public knowledge 25 (1)(d), obviousness Under Section 25 (1)(e), not an invention within the meaning of the Act Under Section 25 (1)(f) and does not sufficiently define the invention Under section 25 (1)(g).

The ingredients recited in the principal claim have a very specific & narrow range of proportions, which are not taught by cited documents. Cited document does not teach how to obtain the right balance of salt & glycerol in order to avoid a soap which is too hard or too soft. Also in cited documents there is no mention of balancing the quantities of glycerol or salt against the quantities of total fatty matter. The present invention offers solution to the problem by retaining glycerol produced during saponification of triglycerides in the soap bar composition rather than removing it. Also present invention obtained surprising result that the narrow range of total fatty matter, electrolytes of glycerol when taken together in particular combination by applying combination of three steps lead to soap containing glycerol which has acceptable physical proportion. Alleged invention mentions prior art, problems, associated, results of various experiments, all essential components, best method by way of working examples.

Opponent failed to establish the above grounds Hence, the patent proceeded for grant

Example 18

In case of 1972-1987 (7) PTC 137(PO), opposition to grant of patent in respect of 'system for concentration of distillery spent wash and method of disposal of spent' was on the grounds of prior publication, public knowledge and obviousness under Section 25 of the Patents Act, 1970. As regards preliminary objection of the Opponents regarding locus standi of the Applicants to hold patent in their name, it is held that the

applicants being a society registered under the Act, it enjoys the Status of legal entity and as such is capable of suing or being sued as well as capable of entering into a contract and accordingly the preliminary objection raised by the Opponents is rejected. As regards grounds of opposition as stated in clauses (a) to (h) of Sub-section (1) of Section 25 of the Act, it is held that the Opponents have failed to establish ground (a) regarding wrongful obtaining of invention. Similarly, the Opponents having failed to substantiate grounds (b), (c), (d) and (e) by way of documentary evidence, the same are also rejected. As regards ground (f), it is held that since subsequent claims do not have any independent status and have to be construed in conjunction with claim 1 and the opponents having failed to analyse claim 1 of the Applicants, this ground also fails. Regarding ground (g) relating to unfair description, the opponents having been successful in establishing the deficiencies in the description, it is ordered that no patent should be granted to the Applicants

Example 19

In the matter of Patent No, 119964 between M/s Colgate Palmolive & Co. vs. M/s Hindustan Lever Limited; titled “Process and composition for removing stains from fabrics” Applicant raised the objection that the opponent have merely referred to three Indian Prior Patents by numbers without showing how the claims of any of them anticipate the invention of the opposed application. Controller held that “a mere reference is sufficient as it is my duty to see the matters contained therein and thereafter to take or reject any or all of them if they relate to something not appropriate in the proceeding”

Example 20

In the matter of Patent No.120345 between Ashok Ganesh Joshi vs. Harbans Lal Malhotra & Sons Pvt. Ltd. For an invention titled “Improvements in or relating to blades for razor and the like instruments.” an opposition to the grant of patent filed taking grounds of prior claiming, unfair description and prior public knowledge and user in India of section 9 of Patents Act’ 1911 and after the implementation of Patent Act’1970, it was considered under the corresponding grounds of Section 25 i.e. 25(1)(b)(i), 25(1)(c), 25(1)(d) and 25(1)(g). The Controller held that :

Criteria for “Criteria for prior claiming

In order to establish prior claim it must be shown that the subject matter of a claim in the applicants specification forms the subject matter of a distinct claim in the cited specification. It is not sufficient if the claim is merely comprehended in the subject matter of a claim in the cited specification. This follows from the wording of the section. The comparison must be made between (and limited to) the claims in the relevant specifications that is to say, it does not suffice to support an objection under section 25(1)(e) to show that what is claimed in the application as a subject matter for protection is to be found somewhere comprehended or described in the earlier

specification. For the purpose of justifying a finding of prior claim one must find a distinct claim in the earlier specification, which, as a matter of substance, is equivalent to the claim in the applicants' specification. Before claiming to the conclusion that an invention is claimed in an earlier specification. That invention must be found to be distinctly claimed in the earlier specification. This principle applies to chemical selection patents as well as to patents for mechanical combination. (Para 7, Page 160, 161)

Taking up next the ground of 'unfair description', I would point out that this ground would have a considerable effect in an opposition proceeding if it be clearly established that the specification contains description and claims of the alleged invention which is ambiguous, misleading or cannot be clearly understood. From the full written statement, and the evidences submitted by the opponents it would appear, on the other hand, that what has been understood by the opponents as the alleged invention is fully consistent with the actual alleged invention that has been presented by the applicant in the specification. Furthermore, the description and the claims do not appear to be ambiguous or vague in any way and the invention as has been alleged in the claims can be clearly understood by any man in the art. So there does not appear to be much weight in this ground of 'unfair description' and I have to conclude that the opposition has nothing much to gain on this ground also.

Criteria for "Common General Knowledge"

It would appear therefore that when it is a question of common general knowledge i.e., knowledge available in a country for a long time, which every worker in the area is, expected to know; such knowledge would be sufficient to invalidate a patent. Again such a knowledge need not even be found in a p[particular document. In other words a patent application has to be accessed on the basis of not only what will be available from prior documents but also from the common general knowledge on the subject, which may or may not be available in any such document.....Even the parameters suggested in the various steps of the process as claimed are not supported by an example or discussion to prove their superiority or specialty for consideration as a "selection". Further, the Controller concluded that on the ground of Prior public knowledge in India as available from the documents, the prior specifications and the affidavits submitted by the opponents, the opponents have succeeded.

Example 21

5. In the matter of Patent No, 124171 granted for "Improved traction and hoisting apparatus" and opposed by M/s Pulling and Lifting Machines Private Limited under section 9 of Patents Act' 1911 and after the implementation of Patent Act' 1970, it was considered under the corresponding grounds of Section 25 i.e. 25(1)(d) and 25(1)(g).

The Controller held that

"In an opposition proceeding under section 25 of the Act the responsibility of the opponent does not appear to end with the levelling of certain allegations only against

the applicant's invention but he has the duty under the Act to take adequate interest to diligently pursue the opposition and to establish the grounds he relied upon. However, for not furnishing necessary particulars as aforesaid I am unable to consider the merit of this ground on the basis of what has been merely referred to in the written statement of opposition by the opponents. I hold that the opponents have failed to discharge their onus to establish the ground of "prior public knowledge or public user in India" taken by them". (Para 5, page 179)

Example 22

In the matter of Patent No, 146120 ,the petitioners have prayed to the Controller to direct the opponents to withdraw the evidence or amend the same since the drawings annexed to his affidavit were incorrect and not true and that are accordingly the evidence filed by the opponents under rule 38 is false and further to enable the applicants to adduce their evidence under rule 39. The Controller held that: I cannot force them to amend the affidavits simply because the applicants have doubt on the drawings annexed to the affidavits filed by the opponents. The controller has full power either to reject or to accept the affidavit fully or partly after the final hearing of the parties but cannot force the party to the proceeding to amend the affidavit. I do not agree with applicant counsel's arguments that the Controller is empowered under section 77 and rule 113 to force the party to proceeding to amend their affidavit on merely a doubt raised by the applicants. The expression "any other matter' under section 77(1)(h) means any other matter prescribed under the Act or the Rules allied to what are given in clauses (a) to (g) of sub-section (1) of Section 77. It cannot mean any other matter not prescribed under the Act or the Rules or matters not allied to such as specified in clause (a) to (g) of Section 77(1). Similarly the expression "to perform an act, file a document or produce evidence" of Rule 113 has to be read as allied matters. One cannot assign different meaning to each expression. Under Rule 113, if the Controller is of the opinion that it is necessary, then only he will ask the party to perform an act, file a document or produce evidence. Since the Controller cannot go into the merits of the case at this stage, he cannot form any opinion. Therefore, the question of asking the opponents to perform an act does not arise. Further since I have already said that the expression "to perform an act" is an allied expression to file a document or to produce evidence, it cannot mean that the Controller can force the party to amend the evidence. As regards applicant counsel's argument under the Civil Procedure Code, I would state that the Controller is technically not a Court and the C.P.C. is not applicable before him (A.I.R. 1934 Cal. 725).

Example 23

In the matter of Patent No, 140797 titled: "Electronic area Measuring Machine" with regard to the issue of "Obviousness", the applicant stated that the object of the invention is to devise a reliable, compact and accurate area measuring machine with a simple mechanism, easy to maintain and functioning almost automatically. The Controller held that; It is obvious that the skin must pass over a

rigid surface while its area is being measured and the endless conveyor and two end rollers around which said conveyor passes in the prior art of the said French specification have been replaced by two guide rollers and a slotted table in the present invention. The use of a table in conjunction with such machine has already been disclosed in the extract of Turner MachineIt is obvious that a table, if used in such a machine has necessarily to be slotted or perforated to allow light rays from the light source to pass there through so as to fall on the light sensitive devices located on the opposite side, otherwise Light sensitive devices will not operate when a skin or any opaque object passes over such table..... The applicant has not made any scintilla of invention in the provision of electronic circuits claimed in the statement of claims, as the same has been admitted in the specification to be known in the art.

Example 24

In the matter of Patent No. 150310 dated 21.06.1978 titled "Electro-erosion method an apparatus for taper cutting an electrically conductive work piece with a wire electro and the work piece so cut". the applicant for patent raised the issue of the locus standi of the opponents on the ground that the opponents are manufacture of electrical & electronic goods for medical and industrial applications are not engaged in any manner on a commercial scale, in a manufacture, lease or sailing of wire cut or travelling wire electrical erosion machine and the applicant invention does not in any way conflict with the subject matter of the opponent business. The Controller held that the opponent justify by their activities that they have locus standi as person interested to file the opposition. This conclusion was reached by the Controller after relying on the 29 RPC(1912" "that it is sufficient for the opponent to be able to show a bonafide and existing interest at the time when the opposition is heard" and also relying on the views of U.K. Controller General that the right to oppose a patent be extended to all those who can show bonafide and satisfactory reason to oppose.

Example 25

In the matter of Patent No. 149901 and in the matter of Substitution of name of the opponent during opposition under section 25, the application was opposed by Board of Tea Research Institute of Ceylon, Sri Lanka & Competent authority the Govt. of Sri Lanka successor of business undertaking of Colombo Commercial Company (Engineering) Ltd., Sri Lanka. The Board of Tea Research Institute of Ceylon was amalgamated with Sri Lanka tea Board by virtue of Law no. 14 of 1975 and all the rights and obligation including property of the Tea Research Board Institute should be deemed to be the right and obligation of the Board. However the provision of this law according to the notification was to come into operation on such date as may be appointed by the Minister and published, There was no proof on the record to prove that any date has been appointed by the Minister in order to

operationalise the said law. Therefore Controller held that the name of Board of Tea Research Institute of Ceylon can not be substituted by its successor namely Sri Lanka Tea Board. It was further held (the Terrel on Law Patent at page no. 171) that “ A different opponent can not be substituted by amendment after the expiry of the opposition period even if he acquires and interest from the original opponents . further it is intended to limit opposition proceedings to persons who possess necessary interest in the period laid down for opposition and also excluding a person who only acquired such interest subsequently even if it is acquired from a person who had it an used it at the time lodging opposition and therefore substitution of opponents asked for is not legitimate.

Example 25

With regard to further evidence at the time of hearing of opposition under section 25, In the opposition proceedings in respect of application for patent no. 150113 the opponent filed further evidence at the time of hearing. This was objected by the applicant by filing a petition for not admitting such further evidence of the opponent. It was held by the Controller that in the practice of Patent Office the leave for filing further evidence is freely given right up to the hearing and therefore it is right an proper both in the interest of the public and all concerned that all relevant material should be before the Controller when an opposition cases is tried. However, the applicant would be allowed to file a counter affidavit within the specified time.

Further Patent Application Nos. 369/MAS/1988 and 765/MAS/2000 were refused because of the non prosecution of application by the applicant under opposition proceedings. Whereas application no. 699/MAS/1996 was allowed to proceed for grant because of the failure of opposition. In Patent Application No. 2207/MAS/1997 (183745) the opponents were not allowed to file evidence on expiry of the prescribed time lines and the presumable extension thereof in order to avoid undue delay in the grant proceedings.

7.3 ACTION IN CASE OF WRONGFUL OBTAINING (S. 26)

Relevant Section and Rules:

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

Rule 63A:

Request made under section 26(1);

Request under section 26(1) shall be made on Form 12 within three months from the date of the order of the Controller and shall be accompanied by a statement setting out the facts upon which the petitioner relies and relief he claims.

7.3.1 Wrongfully Obtaining :

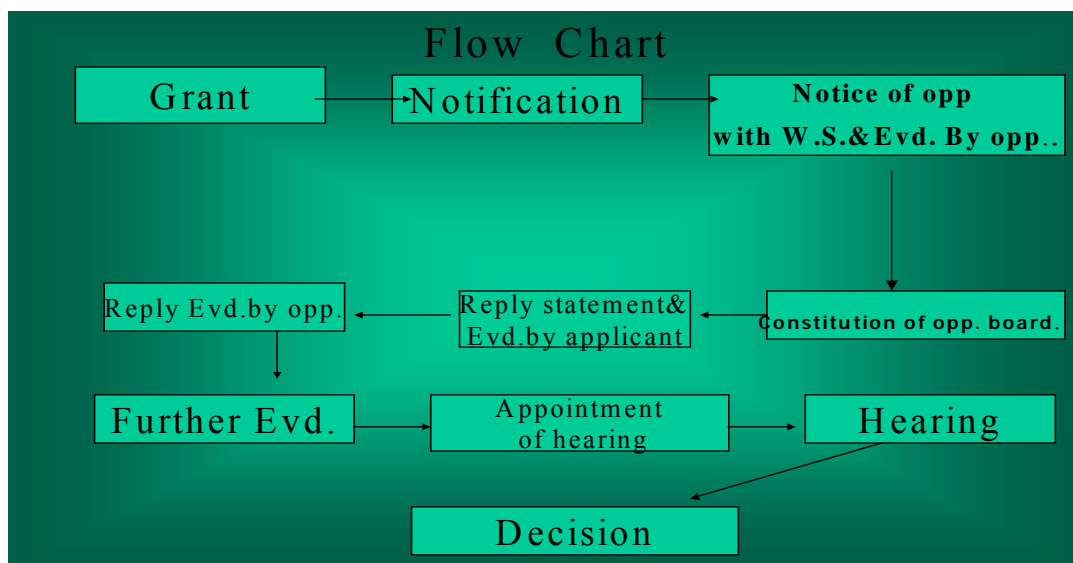
Where the Controller refuses the application on the ground of wrong full obtaining, as a result of proceedings under section 25(2) clause (a), and revokes the patent on this ground, a request can be made by the opponent in Form 12 along with the prescribed fee and in the prescribed manner to allow the patent in the name of the opponent. The controller , upon such request may direct the application to proceed in the name of the opponent with the benefit of priority date attached to the application and order for such an amendment.

However, if only a part of the invention described in the complete specification has been obtained from the opponent, the Controller may allow specification of the patentee to be amended by exclusion of that part.

A special situation is illustrated by Section 26 (2) where the application from opponent containing the whole or a part of the invention held to be obtained from

him has been filed before the order of the controller u/s 26(1) (b) for amendment of patentee's specification on the grounds of obtaining and such application is pending. In such a case, the controller may treat the application and specification filed by opponent containing the whole or apart of invention so excluded from applicant's (patentee's) specification as opponent's application with the same priority date as the earlier application; but for all other purposes the opponent's application will be treated as an independent application under the Act.

Procedure for Opposition U/S 25(2)



7.4 MENTION OF INVENTOR AS SUCH IN PATENT

Relevant Section and Rules

Section 28 :

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

- (a) that the person in respect of or by whom the request or claim is made is the inventor of an invention in respect of which application for a patent has been made, or of a substantial part of that invention; and*
- (b) that the application for the patent is a direct consequence of his being the inventor,*

the Controller shall, subject to the provisions of this section, cause him to be mentioned as inventor in any patent granted in pursuance of the application in the complete specification and in the register of patents:

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

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

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

(4) A request or claim under the foregoing provisions of this section shall be made before the grant of patent.

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

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

Rule 66:

A request under subsection (2) of section 28 shall be made in Form 8.

Rule 67:

(1) A claim under subsection (3) of section 28 shall be made in Form 8, and shall be accompanied by a statement setting out the circumstances under which the claim is made.

(2) A copy of the claim and the statement shall be sent by the Controller to every applicant for the patent (not being the claimant) and to any other person whom the Controller may consider to be interested.

Rule 68:

(1) An application under sub-section (7) of section 28 shall be made in Form 8 and shall be accompanied by a statement setting out the circumstances under which the application is made.

(2) A copy of the application and the statement shall be sent by the Controller to each patentee or the applicant for patent, as the case may be, and to any other person whom (he Controller may consider to be interested.

Rule 69:

The procedure specified in rules 55A and 57 to 63 relating to the filing of notice of opposition, written statement, reply statement, leaving evidence, hearing and cost shall, so far as may be, apply to the hearing of a claim or an application under section 28 as they apply to the opposition proceedings subject to the modification that reference to patentee shall be construed as the person making the claim, or an application, as the case may be.

Rule 70:

Any mention of the inventor under sub-section (1) of section 28 shall be made in the relevant documents in the following form namely:-

"The inventor of this invention/substantial part of this invention within the meaning of section 28 of the Patents Act, 1970, is ...of.....".

7.4.1 Procedure under section 28

Mention of Inventor as such in Patent

If the inventor desires to have his name mentioned as such in a patent by virtue of his being the actual inventor of the invention or a substantial part of the invention, he may make an application to that effect. The Controller if satisfied, will cause him to be mentioned as inventor in the complete specification and in the register of patents.

- e(a) The request shall be made at anytime before the grant of patent.
- e(b) The request when made by the applicant for patent alone or jointly with the person alleged to be the inventor, shall be on form 8.
- e(c) If the request is made by the person claiming to be the actual deviser of invention, who is not the applicant for a patent, the claim must be made on Form 8 accompanied by a statement setting out the circumstances under which the claim is made.
- e(d) The Controller will give notice of the claim to every applicant (not being the claimant) and to any other person who is considered to be interested, and decide the case after hearing the parties concerned, if so required. Any person to whom the Controller has sent copies of the request or claim made under Section 28 may oppose such request or claim. The procedure to be followed

in dealing with such opposition is the same as prescribed in rules 55A, 57 to 63 relating to opposition to grant of patent. Where the Controller allows the request, the mention of the inventor will be made in the patent and in the complete specification in the form prescribed in rule 70. Mention of the inventor will also be made in the register of patents

e(e) If any person alleges that the person who is mentioned as the inventor ought not to have been so mentioned, he may make an application on form 8 accompanied by a statement of case for a certificate to that effect. If the Controller decides the case in favour of the person making the claim, he will issue a certificate and rectify the specification and register accordingly.

CHAPTER VIII

8.1 What Are Not Anticipations (Section 29-34)

Relevant Sections and Rules :

Section 29:

Anticipation by previous publication.—

- (1) *An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published in a specification filed in pursuance of an application for a patent made in India and dated before the 1st day of January, 1912.*
- (2) *Subject as hereinafter provided, an invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published before the priority date of the relevant claim of the specification, if the patentee or the applicant for the patent proves—*
 - (a) *that the matter published was obtained from him, or (where he is not himself the true and first inventor) from any person from whom he derives title, and was published without his consent or the consent of any such person; and*
 - (b) *where the patentee or the applicant for the patent or any person from whom he derives title learned of the publication before the date of the application for the patent, or, in the case of a convention application, before the date of the application for protection in a convention country, that the application or the application in the convention country, as the case may be, was made as soon as reasonably practicable thereafter:*

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

- (4) *Where a complete specification is filed in pursuance of an application for a patent made by a person being the true and first inventor or deriving title from him, an invention claimed in that specification shall not be deemed to have been anticipated by reason only of any other application for a patent*

in respect of the same invention made in contravention of the rights of that person, or by reason only that after the date of filing of that other application the invention was used or published, without the consent of that person, by the applicant in respect of that other application, or by any other person in consequence of any disclosure of any invention by that applicant.

8.1.1. With regard to Exception to anticipation under Section 29(2)(a), an application for patent 136965 was filed on 29/04/1972. However, a drawing no. P4219 relating to the invention was handed over to M/s. Colliery Mining Machinery company by TISCO on 06.04.1972. The application was opposed on the ground of prior publication in view of the above drawings. It was held by the controller that for seeking protection under section 29(2)(a), it is necessary for the applicant to prove that TISCO obtained the drawing No. P4219 from CFRI (Applicant) and published it without the consent of CFRI and there was no commercial working of the invention before the priority date of the claimed in the complete specification. Since there is no evidence on the record to prove that the drawing was published by TOSCO without the consent of CFRI and TISCO handed over the drawing to M/s. Colliery Mining Machinery Company along with the worked order without any condition. Therefore, this kind of act amount to publication of the drawing prior to date of the filing of the application

Section 30 :

Anticipation by previous communication to Government.—

An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of the communication of the invention to the Government or to any person authorized by the Government to investigate the invention or its merits, or of anything done, in consequence of such a communication, for the purpose of investigation.

Section 31 :

Anticipation by public display, etc

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

- (d) 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*
- (e) 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*

- (f) *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*
- (g) *the description of the invention in a paper read by the true and first inventor before a learned society or published with his consent in the transactions of such a society,*

if the application for the patent is made by the true and first inventor or a person deriving title from him not later than twelve months after the opening of the exhibition or the reading or publication of the paper, as the case may be

Section 32:

Anticipation by public working

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

- (a) *by the patentee or applicant for the patent or any person from whom he derives title; or*
- (b) *by any other person with the consent of the patentee or applicant for the patent or any person for whom he derives title,*

if the working was effected for the purpose of reasonable trial only and if it was reasonably necessary, having regard to the nature of the invention, that the working for that purpose should be effected in public.

Section: 33 :

Anticipation by use and publication after provisional specification

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

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

published in India or elsewhere at any time after the date of that application for protection.

Section 34:

No anticipation if circumstances are only as described in Sections 29, 30, 31 and 32

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

Rule 28 :

Procedure in case of anticipation by prior publication.—

- (1) *If the Controller is satisfied after investigation under section 13 that the invention so far as claimed in any claim of the complete specification has been published in any specification or other document referred to in clause (a) of sub-section (1) or sub-section (2) of the said section, the Controller shall communicate the gist of specific objections and the basis thereof to the applicant and the applicant shall be afforded an opportunity to amend his specification.*
- (2) *If the applicant contests any of the objections communicated to him by the Controller under sub-rule (1), or if he refiles his specification along with his observations as to whether or not the specification is to be amended, he shall be given an opportunity to be heard in the matter if he so requests:
Provided that such request shall be made on a date earlier than ten days of the final date of the period preferred to under sub-section (1) of section 21:
Provided further that a request for hearing may be allowed to be filed within such shorter period as the Controller may deem fit in the circumstances of the case.*
- (3) *If the applicant requests for a hearing under sub-rule (2) within a period of one month from the date of communication of the gist of objections, or, the Controller, considers it desirable to do so, whether or not the applicant has refiled his application, he shall forthwith fix a date and time for hearing having regard to the period remaining for putting the application in order or to the other circumstances of the case.*
- (5) *The applicant shall be given ten days' notice of any such hearing or such shorter notice as appears to the Controller to be reasonable in the circumstances of the case and the applicant shall, as soon as possible, notify the Controller whether he will attend the hearing.*
- (6) *After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Controller may specify or permit such amendment of the specification as he thinks fit to be made and may refuse to grant the patent unless the amendment so specified or permitted is made within such period as may be fixed.*

Rule 28A:

Procedure in relation to consideration of report of examiner under section 14.—*In case the applicant contests any of the objections communicated to him, the procedure specified under rule 28 may apply.*

Rule 29:

Procedure in case of anticipation by prior claiming.—

- (1) *When it is found that the invention so far as claimed in any claim of the complete specification, is claimed in any claim of any other specification falling within clause (b) of sub-section (1) of section 13, the applicant shall be so informed and shall be afforded an opportunity to amend his specification.*
- (2) *If the applicant's specification is otherwise in order for grant and an objection under clause (b) of sub-section (1) of section 13 is outstanding, the Controller may postpone the grant of patent and allow a period of two months for removing the objection.*

Rule 30:

Amendment of the complete specification in case of anticipation.—

- (1) *If the applicant so requests at any time, or if the Controller is satisfied that the objection has not been removed within the period referred to in sub-rule (2) of rule 29, a date for hearing the applicant shall be fixed forthwith and the applicant shall be given at least ten days' notice of the date so fixed. The applicant shall, as soon as possible, notify the Controller whether he will attend the hearing.*
- (2) *After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Controller may specify or permit such amendment of the specification as will be to his satisfaction to be made and may direct that reference to such other specification, as he shall mention shall be inserted in the applicant's specification unless the amendment is made or agreed to within such period as he may fix.*

Rule 31:

Form of reference to another specification.—

When in pursuance of rule 30, the Controller directs that a reference to another specification shall be inserted in the applicant's complete specification, such reference shall be inserted after the claims and shall be in the following form, namely:

"Reference has been directed, in pursuance of section 18(2) of the Patents Act, 1970, to the specification filed in pursuance of application No....."

Rule 32:

Procedure in case of potential infringement.—

If in consequence of an investigation made under section 13 , it appears to the Controller that the applicant's invention cannot be performed without substantial risk of infringement of a claim of another patent, the applicant shall be so informed and the procedure provided in rule 29 shall, so far as may be necessary, be applicable.

Rule 33:

Form of reference to another patent;

Where the Controller directs that a reference to another patent shall be inserted in the applicant's complete specification under sub-section (1) of section 19, such reference shall be inserted, after the claims in the following form, namely:

"Reference has been directed, in pursuance of section 19(1) of the Patents Act, 1970, to Patent No-----"

8.1.2 NOT ANTICIPATIONS: The invention is not anticipated i.e. novelty of an invention is not destroyed in certain exceptional conditions , specially provided in the Act in Sections 29-34

a) Prior Publication (S. 29)

The invention claimed in the complete specification will not be considered as anticipated by a specification accompanying an application in India, which was published before the 1st day of January, 1912.

A prior publication of an invention before its priority date will not be deemed as anticipation, if the patentee or the applicant proves that the matter was obtained from him or the inventor or assignor, and that the publication was done without their knowledge, and the application for patent was therefore made immediately after learning that the publication had happened.

This provision will not apply if the invention was commercially worked in India, otherwise for the purpose of reasonable trial before the priority date of the claim by the inventor, patentee or applicant, their assignor or assignee or some one else having their consent.

An invention claimed in an application made by the inventor or his assignee should not be deemed as anticipated by another application for patent in respect of the same invention made in contravention of the rights of that person, or its publication or use by the other applicant or any other person in consequence of its disclosure by him without the consent of the first mentioned applicant.

b) Previous communication to Government (S. 30)

The invention will not be deemed as anticipated by its communication to the government or to any person authorized by the government to investigate the invention or its merits, or of anything done in consequence of such communication for the purpose of the investigation.

c) Prior Public Display etc. (S. 31)

If the application for the patent is made by the inventor or his assignee not later than twelve months after the opening of the exhibition (notified by the Central Government) where **the invention is first displayed and published** by the applicant or used with his consent, it will not be deemed as anticipated. The use of the invention (so displayed) by an unauthorized person during the period of exhibition also will be deemed as non-anticipation.

- (d) The **description of the invention in a paper read** by the true and first inventor or its publication with his consent in the transactions **before a learned society** also does not constitute anticipation, if the application is made within the period of **twelve months**.

e) Prior Public Working (S. 32)

This deals with **public working** of an invention claimed in a complete specification **for a reasonable trial** because the nature of the invention is such that it was necessary to do so. This type of public working will not be deemed as anticipation if performed within one year before the priority date by the patentee, applicant (or assignor) or by any person with their consent.

f) Use and Publication after provisional specifications (S. 33)

An invention in an application should not be considered as anticipated by public use and/or publication of the invention in India or elsewhere after the corresponding filing date of the provisional specification or the prior application in a convention country for which a priority is claimed.

Chapter IX

Provisions of Secrecy of Certain Inventions

Section 35:

Secrecy directions relating to inventions relevant for defence purposes.

- 1) Where, in respect of an application made before or after the commencement of this Act for a patent, it appears to the Controller that the invention is one of a class notified to him by the Central Government as relevant for defence purposes, or, where otherwise the invention appears to him to be so relevant, he may give directions for prohibiting or restricting the publication of information with respect to the invention or the communication of such information.*
- (2) Where the Controller gives any such directions as are referred to in 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 section (1), is relevant for defence purposes, it may at any time before the grant of patent notify the Government to that effect, and thereupon the provisions of that subsection shall apply as if the invention were one of the class notified by the Central Government, and accordingly the controller shall give notice to the central Government of the directions issued by him.*

Section 36:

Secrecy directions to be periodically reviewed;

- (1) The question whether an invention in respect of which directions have been given under section 35 continues to be relevant for defence purposes shall be reconsidered by the Central Government at intervals of six months or on a request made by the applicant which is found to be reasonable by the Controller and if, on such reconsideration it appears to the Central Government that the publication of the invention would no longer be prejudicial to the defence of India or in case of an application filed by a foreign applicant it is found that the invention is published outside India it shall forthwith give notice to the Controller to revoke the direction and the Controllers shall thereupon revoke the directions previously given by him.*
- (2) The result of every re-consideration under sub-section (1), shall be communicated to the applicant within such time and in such manner as may be prescribed.*

Section 37.

Consequences of secrecy directions;

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

(a) the Controller shall not pass an order refusing to grant the same; and notwithstanding anything contained in this Act, no appeal shall lie from any order of the Controller passed in respect thereof:

Provided that the application may, subject to the directions, proceed up to the stage of grant of the patent, but the application and the specification found to be in order for grant of the patent shall not be published, and no patent shall be granted in pursuance of that application.

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

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

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

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

Section 38.

Revocation of secrecy directions and extension of time.;

When any direction given under section 35 is revoked by the Controller, then, notwithstanding any provision of this Act specifying the time within which any step should be taken or any act done in connection with an application for the patent, the Controller may, subject to such conditions, if any, as he thinks fit to impose, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application whether or not that time has previously expired.

Section 39:

Residents not to apply for patents outside India without prior permission.—

(1) No person resident in India shall, except under the authority of a written permit sought in the manner prescribed and granted by or on behalf of the Controller,

make or cause to be made any application outside India for the grant of a patent for an invention unless—

- (a) an application for a patent for the same invention has been made in India, not less than six weeks before the application outside India; and*
 - (b) either no direction has been given under sub-section (1) of section 35 in relation to the application in India, or all such directions have been revoked.*
- (2) The Controller shall dispose of every such application within such period as may be prescribed:*

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

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

Section 40:

Liability for contravention of section 35 or section 39.—

Without prejudice to the provisions contained in Chapter XX, if in respect of an application for a patent any person contravenes any direction as to secrecy given

by the Controller under section 35 [or makes or causes to be made an application for grant of a patent outside India in contravention of section 39] the application for patent under this Act shall be deemed to have been abandoned and the patent granted, if any, shall be liable to be revoked under section 64.

Section 41:

Finality of orders of Controller and Central Government.;

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

Section 42:

Savings respecting disclosure to Government.—

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

Rule 71:

Permission for making patent application outside India under section 39;

- (1) *The request for permission for making patent application outside India shall be made in Form 25.*
- (2) *The time within which the Controller dispose of the request made under sub-rule (1), except in case of inventions relating to defence and atomic energy applications, shall ordinarily be within a period of twenty one days from the date of filing of such request.*

Rule 72:

Communication of result of reconsideration under section 36(2);

- (1) *The result of every reconsideration under sub-section (1) of section 36 shall be communicated to the applicant for patent within fifteen days of the receipt of the notice by the Controller.* (2) ***Extension of time on revocation of secrecy directions under section 3;****The extension of time to be given for doing anything required or authorised to be done under section 38 shall not exceed the period for which directions given by the Central Government under sub-section (1) of section 35 were in force*

9.1 Secrecy Directions For Certain Inventions relevant for defence purposes (S.35)

9.1.1 There are provisions in the Act for secrecy directions for certain inventions which are relevant for defence purposes (**S. 35**). The respective sections empower the Central Government to prohibit publication of the information relating to such inventions. Section 35(1) provides that the Controller may give direction for prohibiting or restricting the publication of information, relating to certain specific inventions or the communications of such information, if it appears to him that the invention in question is one of a class notified to him by Central Government as relevant for defence purposes or the Controller himself considers it to be so.

9.1.2 If such directions have been given, the Controller will give notice of the application and of the direction to the Central Government. If the Central Government considers that the publication of the invention in question would not be prejudicial to the defence of India, it will inform the Controller to that effect who, upon receiving such information, will revoke the secrecy direction and inform the applicant (S. 35(2)) accordingly.

9.1.3 Also, if the Central Government is of the opinion that the invention, in respect of which the Controller has not issued secrecy direction, it may notify to that effect to the Controller before the grant of the patent, who will issue the secrecy direction to the applicant on receipt of such a notice from Central Government and inform the government accordingly about the secrecy directions issued by the Controller.

9.1.4 The Central Government, will review the question on whether the invention continues to be relevant for defence purposes at intervals of 6 months or on a request made by the applicant which is found to be reasonable

by the Controller and, if it is found that the invention is no longer prejudicial for defence of India, the Controller will be given notice to revoke the secrecy direction previously given by him.

9.1.5 If the patent application was made by a foreign applicant and the invention was found published outside India the Central Government shall forthwith give notice to the Controller to revoke the secrecy direction (S. 36)

9.1.6 The result of every reconsideration will be communicated, in writing, to the applicant within fifteen days of the receipt of the notice by the Controller (Rule 72(1)) from Central Government

9.2 CONSEQUENCES OF SECRECY DIRECTION (S.37)

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

9.2.2 If, during the continuance in force of the directions, any use of the invention is made by or on behalf of, or to the order of the Government, the provisions of Section 100 (Power of Central government to use inventions for the purpose of Government), Sections 101 (Right of Third parties in respect of use of inventions for purposes of Government) and Section 103 (Reference to High Court of disputes as to use for purposes of Government) shall apply in relation to that use, as if the patent has been granted for the invention.

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

9.2.4 If a patent is granted to the invention in respect of which secrecy direction have been issued, no renewal fee is payable in respect of the period during which such direction was in force (S.37 (3)).

9.2.5 When any direction under section 35 is revoked by the Controller, then, notwithstanding any provision of this Act specifying the time within which any step should be taken or any act done in connection with an application for the patent, the Controller may, subject to such conditions, if any, as he thinks fit to impose, extend the time for doing anything required or authorize to be done by or under this Act in connection with application, whether or not that time has previously expired. (S.38)

9.3 Prohibition to Apply for Patent For inventions outside India without permission (S.39)

9.3.1 This provision is made to prevent a person *resident in India* to make or cause to be made an application outside India for the grant of a patent for an invention without seeking prior permission from the Controller.

9.3.2 If an application has been made in India in respect of the same invention and if six weeks has elapsed and, no secrecy direction is given under

S.35 (or such direction is revoked thereafter), the applicant may proceed with filing outside India.

9.3.3 If the invention is relevant for defence purpose & atomic energy, the Controller shall not grant permission without the prior consent of the Central Government.

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

9.3.5 The request for permission for making patent application *outside India* should be made in Form 25 with prescribed fee (Rule 71(1)) as given in the first schedule and the Controller shall dispose the said request ordinarily within a period of 21 days from the date of filing such request (Rule 71(2)).

9.4 OTHER PROVISIONS

9.4.1 If any person contravenes any direction as to secrecy issued by the Controller, the application for patent will be deemed to have been abandoned, and the patent if granted, shall be liable to be revoked under section 64 (1) (n) [as provided in section. 40]. It may be noted that these provisions are in addition to the penalty that may be imposed under section 118 of the Act which includes imprisonment for a term which may extend to 2 years or fine or both.

9.4.2 All the orders of the Controller giving directions as to secrecy as well as all orders of the Central Government under this chapter will be final and shall not be called in question in any court on any ground whatsoever. (S.41)

9.4.3 No provisions in the Act shall prevent the Controller to disclose the information concerning an application for patent or the specification thereof to the Central Government for it to be examined for considering whether any secrecy direction or revocation thereof should be issued. Further, the Central Government may undertake the followings:

I.

III. The Government may import or make on its own or on its behalf, any patented machine, apparatus or other article or any article made by a patented process, for the purpose of its own use.

III. Similarly, it can use any patented process for its own use.

IV-III. The patent can be used by any persons for the purpose of experiment or research including the imparting of instruction to pupils.

9.4.4 In case of a patented medicine or drug, the same may be imported by the Government for its own use or for distribution in any dispensary, hospital or other medical institution maintained by or on behalf of the Government or any other dispensary, hospital or other medical institution which the Central Government may, having regard to the public service that such dispensary, hospital or medical institution renders, specify in this behalf by notification in the Official Gazette.

CHAPTER X

GRANT OF PATENT

Relevant Sections and Rules.

Section 43:

Grant of patents

(1) Where an application for a patent has been found to be in order for grant of the patent and either—

- (a) the application has not been refused by the Controller by virtue of any power vested in him by this Act; or*
- (b) the application has not been found to be in contravention of any of the provisions of this Act,*

the patent shall be granted as expeditiously as possible to the applicant or, in the case of a joint application, to the applicants jointly, with the seal of the patent office and the date on which the patent is granted shall be entered in the register.

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

Rule 74:

Form of patent.-

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

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

Rule 74A:

Inspection of documents related to grant of patent.-

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

Section 44.

Amendment of patent granted to deceased applicant.-

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

Rule 75:

Amendment of patent under section 44.-

An application under section 44 for the amendment of a patent shall be made in Form 10 along with substantiating evidence and be accompanied by the patent.

Section 45:

Date of patent.-

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

Section 46:

Form, extent and effect of patent.-

- (1) Every patent shall be in the prescribed form and shall have effect throughout India*
- (2) A patent shall be granted for one invention only:
Provided that it shall not be competent for any person in a suit or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention*

Section 47:

Grant of patents to be subject to certain conditions.-

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

- (1) any machine, apparatus or other article in respect of which the patent is granted or any article made by using a process in respect of which*

the patent is granted, may be imported or made by or on behalf of the Government for the purpose merely of its own use;

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

Section 48:

Rights of patentees.-

Subject to the other provisions contained in this Act and the conditions specified in section 47, a patent granted under this Act shall confer upon the patentee-

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

10.1 In the matter of [K.Ramu Vs. Adyar Ananda Bhavan and Muthulakshmi Bhavan O A No. 535 and 536 of 2006 in C.S. No. 495 of 2006 \(Madras High Court\)](#), it was observed that it is an admitted fact that the Plaintiff has been issued with patent rights for both process and product. The process is for preparation of low glycemic sweets for a term of 20 years from 13.2.2003. Similarly they are also entitled to patent for the product for 20 years from July 2004 Thus the plaintiff has discharged his initial responsibility by proving that they are protected by the certificate issued by the authorities under the Patents Act 1970. In other words the plaintiffs have

established a prima facie case on the strength of their two certificates. In such circumstances Section 48 of the Patents Act, 1970 will hold the field according to which a patent granted under this Act shall confer upon the patentee the exclusive right to prevent third parties from the Act of making, using, selling or importing that product in India if the subject matter of the patent is a product. Similarly if the subject matter of the patent is a process the patentee has the exclusive right to prevent 3rd parties from the act of using the process for sale, selling for those purpose the product obtained directly by that process in India.

Section 49:

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

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

- (a) in the body of the vessel or in the machinery, tackle, apparatus or other accessories thereof, so far as the invention is used on board the vessel and for its actual needs only; or*
- (b) in the construction or working of the aircraft or land vehicle or of the accessories thereof,*

as the case may be.

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

Section 50:

Rights of co-owners of patents.-

- (1) Where a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent.*
- (2) Subject to the provisions contained in this section and in section 51, where two or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to rights conferred by section 48 for his own benefit without accounting to the other person or persons.*
- (3) Subject to the provisions contained in this section and in section 51 and to any agreement for the time being in force, where two or more persons are registered as grantee or proprietor of a patent, then, a license under*

the patent shall not be granted and share in the patent shall not be assigned by one of such persons except with the consent of the other person or persons.

- (4) Where a patented article is sold by one of two or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming through him shall be entitled to deal with the article in the same manner as if the article had been sold by a sole patentee.*
- (5) Subject to the provisions contained in this section, the rules of law applicable to the ownership and devolution of movable property generally shall apply in relation to patents; and nothing contained in sub-section (1) or subsection (2) shall affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or their rights or obligations as such.*
- (6) Nothing in this section shall affect the rights of the assignees of a partial interest in a patent created before the commencement of this Act.*

Section 51:

Power of Controller to give directions to co-owners.-

- (1) Where two or more persons are register as grantee or proprietor of a patent, the Controller may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licenses under the patent, or the exercise of any right under section 50 in relation thereto, as he thinks fit.*
- (2) If any person registered as grantee or proprietor of a patent fails to execute any instrument or to do any other thing required for the carrying out of any direction given under this section within fourteen days after being requested in writing so to do by any of the other persons so registered, the Controller may, upon application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default.*
- (3) Before giving any directions in pursuance of an application under this section, the Controller shall give an opportunity to be heard—*
 - (a) in the case of an application under sub-section (1) to the other person or persons registered as grantee or proprietor of the patent;*
 - (b) In the case of an application under sub-section (2), to the person in default.*
- (4) No direction shall be given under this section so as to affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or of their rights or obligations as such, or which is*

inconsistent with the terms of any agreement between persons registered as grantee or proprietor of the patent.

Rule 76:

Manner of applying for direction under section 51(1).-

- (1) An application for directions under sub-section (1) of section 51 shall be made in Form 11 and shall be accompanied by a statement setting out the facts upon which the applicant relies.*
- (2) A copy of the application and of the statement shall be sent by the Controller to every other person registered as grantee or proprietor of the patent.*

Rule 77:

Manner of application under section 51(2).-

- (1) An application for directions under sub-section (2) of section 51 shall be made in Form 11 and shall be accompanied by a statement setting out the facts upon which the applicant relies.*
- (2) A copy of the application and statement shall be sent by the Controller to the person in default.*

Rule 78:

Procedure for the hearing of proceedings under section 51.-

The procedure specified in rules 55A and 57 to 63 relating to the filing of notice of opposition, written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of an application under section 51 as they apply to the hearing of an opposition proceeding.

Section 53.

Term of patent.-

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

Explanation; For the purposes of this sub-section, the term of patent in case of International applications filed under the Patent Cooperation Treaty designating India, shall be twenty years from the international filing date accorded under the Patent Cooperation Treaty.

- (2) A patent shall cease to have effect notwithstanding anything therein or in this Act on the expiration of the period prescribed for the payment of*

any renewal fee, if that fee is not paid within the prescribed period or within such extended period as may be prescribed.

- (3) *Omitted by Act 15 Of 2005*
- (4) *Notwithstanding anything contained in any other law for the time being in force, on cessation of the patent right due to non-payment of renewal fee or on expiry of the term of patent, the subject matter covered by the said patent shall not be entitled to any protection.*

Rule 80:

Renewal fees under section 53.-

- (1) *To keep a patent in force, the renewal fees specified in the First Schedule shall be payable at the expiration of the second year from the date of the patent or of any succeeding year and the same shall be remitted to the patent office before the expiration of the second or the succeeding year.*
- (1A) *The period for payment of renewal fees so specified in sub-rule (1) may be extended to such period not being more than six months if the request for such extension of time is made in Form 4 with the fee specified in the First Schedule.*
- (2) *While paying the renewal fee, the number and date of the patent concerned and the year in respect of which the fee is paid shall be quoted.*
- (3) *The annual renewal fees payable in respect of two or more years may be paid in advance.*
- (3) *The Controller shall, after making such enquiry as he may deem necessary, credit any renewal fee and issue a certificate that the fee has been paid.*

Section 142:

Fees. —

- (1) *There shall be paid in respect of the grant of patents and applications therefor, and in respect of other matters in relation to the grant of patents under this Act, such fees as may be prescribed by the Central Government.*
- (2) *Where a fee is payable in respect of the doing of an act by the Controller, the Controller shall not do that act until the fee has been paid.*
- (3) *Where a fee is payable in respect of the filing of a document at the patent office, the fee shall be paid along with the document or within the prescribed time and the document shall be deemed not to have been filed at the office if the fee has not been paid within such time.*
- (4) *Where a principal patent is granted later than two years from the date of the filing of the application, the fees which have become due in the meantime may be paid within a term of three months from the date of the recording of the patent in the register or within the extended period not later than nine months from the date of recording.*

10.2 Grant of Patent: (Section 43)

The patent is granted when the applicant for patent put the application in order for grant under Section 21 of the Act and when there is no pre-grant representation within the stipulated period 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 shall only be entitled to receive reasonable royalty from such enterprises which have made significant investment and were producing and marketing the concerned product prior to the 1st day of January 2005, and which continue to manufacture the product covered by the patent on the date of grant of the patent and no infringement proceedings shall be instituted against such enterprises.

- 10.3 Deletion of the claims at the time of sealing under section 43 and method of tagging of animal ear not an invention under section 2(1)(j): An application for patent no., 149056(149/Bom/77) was made by Pratap Shanker Rao Borade of SPADMA Plastic and Engineering Industry Aurangabad Maharashtra on April 25, 1977 for a method and apparatus for tagging an animal ear. The complete specification was accepted by the Patent Office and notification was made in Gazette of India, Part III, Section-2 dated 29.08.1981. At the time of sealing the method claims relating to tagging of ear were objected by the Patent Office on the ground that the method of tagging is not an invention under section 2(i)(j) and accordingly the amendments in the title and claims and specification were required and therefore the applicant was informed to make such corrections under section 78 (2) &(3) of the Act. It was argued by the applicant that the Controller has no power to delete the claims at the time of sealing of patent particularly Head office. If at all Controller has power to amend the claims, this power should be exercised by the Controller at the appropriate office. The Controller held that under the provision of section 78 (2) and (3) the Controller has powers to amend the specification by providing an opportunity of being heard. Further the method of tagging of ear of the animal was not held an invention under section 2(1)(j) of the Patents Act 1970, not being a manner of manufacture. In the present context also such methods can not be considered as an invention due to lack of industrial application of the invention.

10.4 Amendment of Patent granted to deceased applicant (S. 44)

If the patentee had died or ceased to exist in case of a corporate body, the Controller may amend the patent by substituting the name of the Patentee with the name of the legal representative. An application for such amendment of a patent should be made in Form 10 with the prescribed fee as given in the First schedule and should be accompanied by evidence verifying the statements made therein and accompanied by the letters patent.

10.5 Date of patent (S. 45)

1. The date of patent is the date of filing of the application. The date will be entered in the register of Patents. The purpose of "date of patent" is for calculating the duration of a patent and reckoning the time for payment of renewal fee.
2. In spite of date of filing being the date of patent, a suit or proceeding cannot be commenced or prosecuted against infringement committed before the date of publication.

10.6 Form, Extent and Effect of Patent (S. 46)

Every patent shall be in the prescribed form and shall have effect throughout India and shall be granted for one invention only,

A patent shall be in the form as specified in the Third Schedule with such modification as the circumstances of each case may require and shall bear the number accorded to the application after the grant of a complete specification. i.e. ,the number of the patent so granted.

10.7 Conditions under which patent is granted (S. 47)

The patent right is not an obsolete right. It is fettered right and it is subjected the following constraints: any machine, apparatus or other article in respect of which the patent is granted or any article made in respect of which the patent is granted may be used, by any person, for the purpose merely of experiment or research including the imparting of instructions to the students.

10.8 Rights of Patentee (S. 48)

The patent granted under the Act confer upon patentee the following rights, (subject to the provisions of S. 47 and other provisions in the Act)

- a) In case of a patented product, the patentee shall have the exclusive right to prevent third parties, from the act of making, using, offering for sale, selling or importing for those purposes that product in India;
- b) In case of a patented process, the patentee has the exclusive right to prevent third parties, from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India;

8.710.9 Patent rights not infringed when used on foreign vessels, etc., temporarily or accidentally in India (S. 49)

The use of the invention on board a vessel or aircraft registered in a foreign country or a land vehicle owned by a person ordinarily resident in such country, which comes to India (including the territorial waters thereof) temporarily or accidentally, will not infringe the rights of the Patentee. However this will not apply to vessels, aircraft or land vehicles owned by persons ordinarily resident in a foreign country the laws of which do not confer corresponding rights with respect to the use of inventions in vessels, aircraft or land vehicles owned by person, ordinarily resident in India while in the ports or within the territorial water of that foreign country or otherwise within the jurisdiction of its courts. As there is no commercial intention, there is no violation of patent right.

10.10 Rights of Co-owners of Patents (S. 50)

The patent right is a unitary right shared equally among the patent holders

ea) When a patent is granted to two or more persons, each of those persons will be entitled to an equal undivided share in the patent, unless an agreement to the contrary is in force. All of them can enjoy their rights for his own benefit without accounting to the other person or persons, but license or assignment of their share to any other person should not be made without the consent of others.

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

ec) For the purpose of property right, patent right is treated as movable property. The rules of law applicable to the ownership and devolution of movable property are applicable to patents. The mutual rights or obligations of trustees or of the legal representatives of a deceased person or their rights or obligations as such are not affected by the provisions in sub section (1) or (2).

10.11 Power of Controller to give directions to co-owners (S. 51)

- i) Where two or more persons are registered as grantee or proprietor of a patent, the Controller may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licenses under the patent, or the exercise of any right under section 50 in relation thereto, as he thinks fit [S.51(1)].
- ii) If any person registered as grantee or proprietor of a patent fails to execute any instrument or to do any other thing required for the carrying out of any direction given under this section within fourteen days after being requested

in writing so to do by any of the other persons so registered, the Controller may, upon application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default [S.51(2)].

- (iii) An application for directions under sub-section (1) of section 51 shall be made in Form 11, in duplicate, and shall be accompanied by a statement setting out the facts upon which the applicant relies. A copy of the application and of the statement should be sent by the Controller to every other person registered as grantee or proprietor of the patent[S.51(1)], or to the person in default [S.51(2)], as the case may be , and the applicant shall supply sufficient number of copies for that purpose.
- iii) Before giving any directions in pursuance of an application under this section, the Controller shall give an opportunity to be heard to the other person or persons registered as grantee or proprietor of the patent or to the person in default. No direction will be given under this section so as to affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or of their rights or obligations as such, or which is inconsistent with the terms of any agreement between person registered as grantee or proprietor of the Patent.
- iv) Also the Controller has the power to grant a patent to the true and first inventor with the same date and number of a patent which has been revoked on the ground that it had been obtained by the patentee in fraud **S.52**

~~8.10~~10.12 TERM OF PATENT (S. 53)

- i) 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 has 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).
- ii) In order to keep the patent in force, renewal fee as given in the First Schedule (entry no. 17) should be paid before the expiration of the second year from the date of patent and , subsequently, before the expiration of the succeeding year (Rule 80 (1)). The annual fee payable in respect of two or more years may be paid in advance.
- iii) The term of patent and renewal fee in general shall be governed by the provisions of sec. 53, whereas the renewal fees, which has become due at the time of grant of Patent (grant), will be governed by section 142(4). It says that when the patent is granted later than two years from the date of filing of the application, the fee that has become due in the meantime might be paid within three months from the date of recording of the patent in the Register or within the extended period not later than nine months from the date of recording. (S. 142(4)). In the cases where the renewal fees, which has become due at the time of grant and which has become due after the grant are very close, they may be paid together along with required extension under section 53.

CHAPTER XI

PATENT OF ADDITION

Relevant Sections and Rules:

Section 54:

Patents of addition.—

- (1) *Subject to the provisions contained in this section, where an application is made for a patent in respect of any improvement in or modification of an invention described or disclosed in the complete specification filed therefor (in this Act referred to as the "main invention") and the applicant also applies or has applied for a patent for that invention or is the patentee in respect thereof, the Controller may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.*
- (2) *Subject to the provisions contained in this section, where an invention, being an improvement in or modification of another invention, is the subject of an independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention, the Controller may, if the patentee so requests, by order, revoke the patent for the improvement or modification and grant to the patentee a patent of addition in respect thereof, bearing the same date as the date of the patent so revoked.*
- (3) *A patent shall not be granted as a patent of addition unless the date of filing of the application was the same as or later than the date of filing of the application in respect of the main invention.*
- (4) *A patent of addition shall not be granted before grant of the patent for the main invention.*

Section 55:

Term of patents of addition.

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

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

term for the patent for the main invention and thereupon the patent shall continue in force as an independent patent accordingly.

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

Section 56:

Validity of patents of addition.—

- (1) The grant of a patent of addition shall not be refused, and a patent granted as a patent of addition shall not be revoked or invalidated, on the ground only that the invention claimed in the complete specification does not involve any inventive step having regard to any publication or use of—*
- (a) the main invention described in the complete specification relating thereto; or*
- (b) any improvement in or modification of the main invention described in the complete specification of a patent of addition to the patent for the main invention or of an application for such a patent of addition,*
- and the validity of a patent of addition shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.*
- (2) For the removal of doubts it is hereby declared that in determining the novelty of the invention claimed in the complete specification filed in pursuance of an application for a patent of addition regard shall be had also to the complete specification in which the main invention is described.*

11.1 Patent of Addition: Important Features

- i) When an applicant feels that he has come across an invention which is a slight modification of the invention for which he has already applied for or has obtained patent, the applicant can go for patent of addition since the invention does not involve a substantial inventive step. It is also possible to convert an independent patent to a patent of addition at a later date if the subject matter was an improvement in or modification to a main invention for which he holds a patent. There is no need to pay separate renewal fee for the patent of addition during the term of the main patent. A Patent of Addition expires along with the main patent unless it is made independent according to the provisions in Section 54.
- ii) However a Patent of Addition will not be granted unless the date filing of Application was the same or later than the date of filing of the complete specification in respect of the main invention (S. 54(1), S. 54 (2) & S. 54(3)).

- iii) It should be noted that a patent of addition will not be granted before granting of the patent for the main invention.
- iv) In an application for a patent of addition, the determination as to whether the invention proposed is or is not an improvement or modification of the applicant's previous invention, has to be done by the proper comparison between the novel contributions which each specification has made to the art and not between the sum of the characteristics claimed in the respective main invention and proposed patent of addition. In other words mere presence of a number of elements common to both inventions, is not sufficient to make one invention an improvement of or addition to the other
- iv) The validity of a patent of addition will not be questioned on the ground that invention ought to have been the subject of an independent patent and on the ground that the invention claimed in the complete specification does not involve any inventive step having regard to the publication and use of the main invention (Section 56)
- v) For determining the novelty of the invention claimed in the complete specification filed in pursuance of an application for patent of addition, regard should be had to the complete specification in which the main invention is described. Thus the complete specification of the main invention could be cited for novelty as an anticipatory publication.
- vi) The Complete Specification of application for the patent of addition shall include specific reference to the number of main patent or the application number of main patent, as the case may be, and a definite statement that the invention comprises an improvement in, or a modification of the invention claimed in the specification of the main patent, granted or applied for.

vii) When improvement is patentable:

It is important to bear in mind that in order to be patentable an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy, the test of invention or an "inventive step". To be patentable the improvement or the combination must produce a new result, or a new article or a better or cheaper article than before. The combination of old known integers may be so combined that by their working inter-relation they produce a new process or improved result. Mere collection of more than one integers or things, not involving the exercise of any inventive faculty, does not qualify for the grant to a patent; *Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries*, AIR 1982 SC 1444.

11.2 Term of Patent of Addition (S.55)

The term of the patent of addition will run for a term equal to that of the patent for main invention. If the patent for the main invention is revoked under the Act, the patent of addition shall become an independent patent for the remainder of the term of patent for the main invention if the court or Controller so orders on the request made by the patentee.

No renewal fee is payable in respect of a patent of addition so long as the main patent remain in force. However if patent of addition becomes an independent patent, the same fee shall be payable upon the same dates as if the patent has been originally granted as an independent patent.