

THE PATENTS BILL, 1953

(AS INTRODUCED IN THE HOUSE OF THE PEOPLE)

**A
BILL**

to amend and consolidate the law relating to patents.

BE it enacted by Parliament as follows:—

CHAPTER I

PRELIMINARY

1. Short title, extent and commencement.—(1) This Act may be called the Patents Act, 1958. 5

(2) It extends to the whole of India except the State of Jammu and Kashmir.

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

2. Definitions.—In this Act, unless the context otherwise requires,— 10

(a) 'Advocate-General' means an Advocate-General appointed under the Constitution;

(b) 'assignee' includes 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; 15

(c) 'Controller' means the Controller of Patents and Designs appointed under section 5;

(d) 'district court' has the meaning assigned to that expression by the Code of Civil Procedure, 1908 (Act V of 1908); 20

(e) '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; 25

(f) 'High Court' means,—

(i) in relation to a Part A State or a Part B State, the High Court for that State;

5 (ii) in relation to the States of Ajmer and Vindhya Pradesh, the High Court at Allahabad;

(iii) in relation to the State of Bhopal, the High Court at Nagpur;

(iv) in relation to the States of Bilaspur, Delhi and Himachal Pradesh, the High Court of Punjab;

10 (v) in relation to the State of Coorg, the High Court of Mysore;

(vi) in relation to the State of Kutch, the High Court at Bombay;

15 (vii) in relation to the States of Manipur and Tripura, the High Court of Assam;

(viii) in relation to the Andaman and Nicobar Islands, the High Court at Calcutta;

(g) 'India' means the territory of India excluding the State of Jammu and Kashmir;

20 (h) 'invention' means,—

(i) any new and useful manufacture;

(ii) any new and useful composition of matter;

(iii) any new and useful improvement of any such manufacture or composition of matter;

25 which is capable of being used or applied in trade or industry and which is not previously known or used in India;

Explanation I.—An invention shall not be deemed to be new unless it involves an inventive step.

30 *Explanation II.*—An invention shall not be deemed to be useful unless it achieves the object which is claimed for it and makes a definite contribution to the existing stock of technical knowledge in India on the subject-matter of the invention;

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

35 (j) 'manufacture', includes—

(i) any art or process—

(a) for producing, preparing or making an article by subjecting a material to manual, mechanical, chemical, electrical or any other like operation, or

40 (b) for producing any new material or for preserving or modifying the properties of any known material;

(ii) any method or process of testing applicable to the improvement or control of manufacture;

45 (iii) any machine or apparatus used for any of the purposes specified in item (a) or item (b) of sub-clause (i); and

- (iv) any article or material produced, prepared or made by manufacture;
- (k) 'patent' means a patent granted under this Act;
- (l) 'patented article' means an article in respect of which a patent has been granted; 5
- (m) 'patentee' means the person for the time being entered on the register of patents kept under this Act as the grantee or proprietor of the patent;
- (n) 'patent agent' means a person carrying on in India the business of acting as agent for other persons for the purpose of applying for or obtaining patents in India or elsewhere; 10
- (o) 'patent of addition' means a patent granted in accordance with section 31;
- (p) 'Patent Office' means the Patent Office established under section 4 and includes any branch thereof; 15
- (q) 'prescribed' means prescribed by rules made under this Act;
- (r) 'priority date' has the meaning assigned to it by section 10;
- (s) 'true and first inventor' includes a person who first imports an invention into India, or to whom an invention is first communicated from outside India. 20

3. What is not patentable.—The following shall not be patentable under this Act:—

- (a) an invention the use of which would be contrary to law or morality;
- (b) the mere discovery of new properties of a known substance; 25
- (c) a mere duplication of known devices or juxtaposition of known devices which function independently of one another;
- (d) a substance prepared or produced by a chemical process or intended for food or medicine other than a substance prepared or produced by any method or process of manufacture particularly described in the complete specification of the invention or by its obvious chemical equivalent. 30
- Explanation.*—In relation to a substance intended for food or medicine, a mere admixture resulting only in the aggregation of the known properties of the ingredients of that substance shall not be deemed to be a method or process of manufacture. 35

CHAPTER II

PATENT OFFICE AND ESTABLISHMENT

4. Patent Office and its branches.—(1) There shall be established for the purposes of this Act an office to be called the Patent Office and such number of branch offices as the Central Government may deem fit. 40

(2) The Patent Office shall be under the immediate control of the Controller who shall act under the superintendence and direction of the Central Government.

(3) There shall be a seal for the Patent Office. 45

5. Controller and other officers.—(1) The Central Government may appoint a person to be the Controller of Patents and Designs and as many Deputy and Assistant Controllers as may be necessary.

(2) The Deputy and Assistant Controllers shall be under the superintendence and direction of the Controller and shall discharge such functions of the Controller under this Act as the Controller may from time to time authorise them to discharge; and any reference in this Act to the
 5 Controller shall include a reference to a Deputy Controller or an Assistant Controller when so discharging any such functions.

(3) The Central Government may appoint for the purposes of the Patent Office such number of Examiners, Assistant Examiners and other officers as it may deem fit for the purpose of carrying out the provisions of this Act.

CHAPTER III

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APPLICATIONS FOR GRANT OF PATENTS

6. Persons entitled to apply for a patent.—(1) An application for a patent for an invention may be made by any of the following persons, that is to say,—

15 (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;

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

and may be made by that person or legal representative either alone or jointly with any other person.

7. Form of application.—(1) Every application for a patent shall be
 25 made in the prescribed form and shall be filed at the Patent Office in the prescribed manner.

(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
 30 of the application either—

(a) a declaration signed by the person claiming to be the true and first inventor or his legal representative, stating that he assents to the making of the application; or

35 (b) the original deed of assignment executed by the true and first inventor or his legal representative.

(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
 40 first inventor.

(4) Every such application shall be accompanied by—

(a) a provisional or a complete specification; and

(b) the prescribed fee.

8. Provisional and complete specifications.—(1) Where an application for a patent is accompanied by a provisional specification, a complete specification shall be filed within nine 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: 5

Provided that the complete specification may be filed at any time after nine months but within twelve months from the date aforesaid, if a request to that effect is made to the Controller and the prescribed fee is paid on or before the date on which the complete specification is filed.

(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. 10 15

(3) Where an application for a patent is accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant so requests at any time before the acceptance 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. 20

(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 the acceptance of the application, cancel the provisional specification and post-date the application to the date of filing of the complete specification. 25

9. Contents of specification.—(1) Every specification, whether complete or provisional, shall describe the invention and shall begin with a title sufficiently indicating the subject-matter to which the invention relates. 30

(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. 35

(3) Every complete specification—

(a) shall particularly describe the invention and the method by which it is to be performed; 40

(b) shall 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) shall end with a claim or claims defining the scope of the invention claimed. 45

(3) The claim or claims of a complete specification shall relate to a single invention, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification.

(5) 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.

- 5 (6) 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
10 to make a separate application for a patent.

10. Priority date of claims of complete specification.—(1) Every claim of a complete specification shall have effect from the date specified in this section in relation to that claim (in this Act referred to as the 'priority date'); and a patent shall not be invalidated by reason only of the publi-
15 cation or use of the invention, so far as claimed in any claim of the complete specification, on or after the priority date of that claim, or by the grant of another patent upon a specification claiming the same invention in a claim of the same or later priority date.

(2) Where the complete specification is filed in pursuance of a single
20 application accompanied by a provisional specification or by a specification which is treated by virtue of a direction under sub-section (3) of section 8 as a provisional specification, and the claim is fairly based on the matter disclosed in that specification, the priority date of that claim shall be the date of filing of the application.

(3) Where the complete specification is filed or proceeded with in
25 pursuance of two or more applications accompanied by such specifications as are mentioned in sub-section (2), and the claim is fairly based on the matter disclosed in one of those specifications, the priority date of that claim shall be the date of filing of the application accompanied by that
30 specification.

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

(5) In any case to which sub-sections (2) to (4) do not apply, the
35 priority date of a claim shall, subject to the provisions of section 83, be the date of filing of the complete specification.

11. Examination of application.—When the complete specification has been filed in respect of an application for a patent, the application
40 and the specification or specifications relating thereto shall be referred by the Controller to an Examiner for making a report to him in respect of the following matters, namely:—

- (a) whether the subject-matter of the specification or specifica-
tions is an invention within the meaning of clause (h) of section 2;
45 (b) whether the application and the specification or specifications relating thereto are in accordance with the requirements of this Act and of any rules made thereunder;
(c) the result of investigations made under section 12; and
(d) any other matter which may be prescribed.

**12. Search for anticipation by previous publication and by prior
50 claim.**—(1) The examiner to whom an application for a patent is referred under section 11, shall make investigation for the purpose of ascer-

taining whether the invention, so far as claimed in any claim of the complete specification—

(a) has been published 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 within fifty years before that date; or 5

(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 that date. 10

(2) The Examiner may, in addition, make such investigation as the Controller may direct for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been published in India before the date of filing of the applicant's complete specification in any other document. 15

(3) The investigations made under this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Central Government or any officer by reason of, or in connection with, any such investigation or any proceeding consequent thereon 20

13. Controller to take into consideration the report of Examiner.—When, in respect of any application for a patent, the Controller has received the report of the Examiner under section 11, he shall, after considering the report, dispose of the application in accordance with the provisions hereinafter appearing. 25

14. Refusal of application in certain cases.—Where the Controller is satisfied that the subject-matter of the specifications relating to an application is not an 'invention' within the meaning of clause (h) of section 2 or is not patentable under section 3, he shall refuse the application. 30

15. Order of refusal or amendment of application in certain cases.—Where the Controller is satisfied that the application and the specifications relating thereto do not comply with the requirements of this Act or of any rules made thereunder, the Controller may, subject to the other provisions of this Act, refuse to proceed with the application or require that the application or the specification be amended to his satisfaction before he proceeds with the application. 35

16. Other orders on application.—(1) Where a specification relates to more than one invention, the application shall, if the Controller or the applicant so requires, be restricted to one invention and the other inventions may be made the subject-matter of fresh applications; and any such fresh application shall be proceeded with as a substantive application, but the Controller may direct that any such fresh application made before the acceptance of the original application shall bear the date of the original application or such later date as he may fix, and the fresh application shall be deemed, for the purposes of this Act, to have been made on the date which it bears in accordance with such direction. 40 45

(2) At any time after an application has been filed under this Act and before acceptance of the application, the Controller may, at the request of the applicant and upon payment of the prescribed fee, direct that the 50

application shall be post-dated to such date as may be specified in the request, and proceed with the application accordingly:

5 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.

10 (3) Where an application or specification filed under this Act is amended before acceptance of the application, the Controller may direct that the application or specification shall be post-dated to the date on which it is amended, or if it has been returned to the applicant, to the date on which it is refiled.

15 (4) Where it appears to the Controller that the invention so far as claimed in any claim of the complete specification has been published in the manner referred to in sub-section (1) or sub-section (2) of section 12, he may refuse to accept the application unless the applicant either—

(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 in India; or

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

25 (5) 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 12, 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 either—

(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

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

(6) If it appears to the Controller as a result of an investigation under section 12 or otherwise—

35 (c) 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 12; and

(b) that such other complete specification was published on or after the priority date of the applicant's claim;

40 then, unless it has been 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 (5) shall apply in the same manner as they apply to a specification published on or after the date of filing of the applicant's complete specification.

45 (7) The power of the Controller under sub-sections (5) and (6) to direct the insertion of a reference to another specification may be exercised either before or after a patent has been granted for an invention claimed in that other specification, but any direction given before the grant of such a patent shall be of no effect unless and until such a patent is granted.

17. Substitution of applicants.—(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 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 claimant and the applicant or the other joint applicant or applicants, according as the case may require. 5 10

(2) No such direction as aforesaid shall be given by virtue of any assignment or agreement made by one of two 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 any invention unless either— 15

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

(b) there is produced to the Controller an acknowledgment by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made; or 20

(c) the rights of the claimant in respect of the invention have been finally established under the provisions of this Act.

(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 personal representative of the deceased, direct that the application shall proceed in the name of the survivor or survivors alone. 25

(5) If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the Controller may, upon application made to him in the prescribed manner by any of the parties, and after giving to all parties concerned an opportunity to be heard, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be proceeded with, or for both those purposes, according as the case may require. 30 35

18. Acceptance of application.—(1) Where in respect of an application for a patent no order is passed by the Controller under section 14 or section 15 or section 16, or where an order is passed by the Controller under section 15 or section 16 which is complied with by the applicant, the Controller may, subject to the provisions of sub-section (2), accept the application. 40

(2) Unless an application for a patent is accepted within eighteen months from the date of the application, the application shall (except where an appeal has been lodged) be deemed to have been refused: 45

Provided that where, before, or within three months after, the expiration of the said period of eighteen months a request is made to the Controller for an extension of time, the application shall, on payment of the prescribed fee, be continued for any period so requested not exceeding in all three months from the expiration of the said period of eighteen months. 50

19. **Advertisement of acceptance of application.**—On the acceptance of an application, the Controller shall give notice thereof to the applicant and shall advertise the acceptance in the Official Gazette; and the application and the specification with the drawings (if any) shall be open to public inspection.

20. **Effect of acceptance of application.**—After the acceptance of an application and until the date of sealing a patent in respect thereof or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of advertisement of acceptance of the application :

Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been sealed.

21. **Objections to sealing of patent.**—(1) At any time within four months from the date of advertisement of the acceptance of an application in the Official Gazette, any person interested may, on payment of the prescribed fee, file before the Controller objections in writing to the sealing of the patent on the application, such objections being restricted to the matters specified in clauses (a) to (d) of section 11.

(2) Where any objections have been filed under sub-section (1), the Controller shall, after hearing the applicant and, if necessary, the person filing the objections and after making such further enquiry, if any, as he may deem fit, may—

(a) dismiss the objections; or

(b) direct the applicant to amend the complete specification to the satisfaction of the Controller and within such time as may be specified in the direction; or

(c) direct that the reference to any other specification shall be inserted by way of notice to the public in the applicant's complete specification.

(3) Where the applicant refuses or fails to carry out any directions of the Controller under clause (b) or clause (c) of sub-section (2), the Controller may refuse to seal the patent.

22. **Mention of inventor as such in patent.**—(1) If the Controller is satisfied, upon a request or claim made in accordance with the provisions of this section,—

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

(b) that the application for the patent is a direct consequence of his being the inventor;

the Controller shall, subject to the provisions of this section, cause him to be mentioned as inventor in any patent granted in pursuance of the application, in the complete specification, and in the register of patents:

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

(2) For the purposes of this section, the actual deviser of an invention or a part of an invention shall be deemed to be the inventor, notwithstanding that any other person is for any of the other purposes of this Act treated as the true and first inventor; and no person shall be deemed to be the inventor of an invention or a part of an invention by reason only that it was imported by him into India or that it was communicated to him from outside India. 5

(3) 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. 10

(4) 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 (3)] desires to be mentioned as aforesaid, he may make a claim in the prescribed manner in that behalf. 15

(5) A request under the foregoing provisions of this section shall be made not later than two months after the date of advertisement of acceptance of the application or within such further period (not exceeding one month) as the Controller may, on an application made to him in that behalf before the expiration of the said period of two months and subject to the payment of the prescribed fee, allow. 20

(6) Where a claim is made under sub-section (4), 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 (3) or sub-section (4), 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 the said sub-section (4), any person to whom notice of the claim has been given as aforesaid. 25

(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. 30 35

23. Provision for secrecy of certain inventions.—(1) Where, either before or after the commencement of this Act, an application for a patent has been made in respect of an invention, and 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, he may give directions for prohibiting or restricting the publication of information with respect to the invention, or the communication of such information to any person or class of persons specified in the directions; and while such directions are in force, the application may, subject to the directions, proceed up to the stage of the acceptance of the application, but the acceptance shall not be advertised nor the specification published, and no patent shall be granted in pursuance of the application. 40 45

(2) Where the Controller gives any such directions as aforesaid, he shall give notice of the application and of the directions to the Central Government, and thereupon the following provisions shall have effect, that is to say,—

5 (a) 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 unless a notice under paragraph (c) of this sub-section has been previously given by the Central Government, to
10 the Controller, shall reconsider that question before the expiration of nine months from the date of filing of the application for the patent and at least once in every subsequent year;

(b) for the purpose aforesaid, the Central Government may, at
15 any time after the application has been accepted or, with the consent of the applicant, at any time before the application has been accepted, inspect the application and any documents furnished to the Controller in connection therewith;

(c) if upon consideration of the invention at any time it appears
20 to the Central Government that the publication of the invention would not, or would no longer, be prejudicial to the defence of India, the Central Government, shall give notice to the Controller to that effect;

(d) on receipt of any such notice the Controller shall revoke
25 the directions and may, subject to such conditions, if any, as he thinks fit, 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.

(3) Where an application for a patent for an invention in respect of which directions have been given under this section or under section 12 of the Atomic Energy Act, 1948 (XXIX of 1948), is accepted during the continuance in force of the directions, then—

30 (a) if any use of the invention is made during the continuance in force of the directions by or on behalf of or to the order of the Government, the provisions of sections 53, 54 and 55 shall apply in relation to that use as if the patent had been granted for the invention; and

35 (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 compensation as appears 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.

40 (4) Where a patent is granted in pursuance of an application in respect of which directions have been given under this section or under section 12 of the Atomic Energy Act, 1948 (XXIX of 1948), no renewal fees shall be payable in respect of any period during which those directions are in force.

45 (5) No person resident in India shall, except under the authority of a written permit 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—

50 (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 directions have been given under sub-section (1) of this section or under section 12 of the Atomic Energy Act, 1948 (XXIX of 1948), in relation to the application in India, or all such directions have been revoked:

Provided that this sub-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. 5

CHAPTER IV

GRANT AND SEALING OF PATENT

24. Grant and sealing of patent.—(1) Where an application in respect of a patent is accepted, and no objections have been filed under section 21 or where such objections have been filed but have been dismissed, or where the applicant has carried out the directions of the Controller under clause (b) or clause (c) of sub-section (2) of section 21, a patent shall on the prescribed request and on payment of the prescribed fee, be granted subject to such conditions (if any) as the Central Government thinks expedient. to the applicant, or in the case of a joint application to the applicants jointly, and the Controller shall cause the patent to be sealed with the seal of the Patent Office. 10 15

(2) A patent shall be sealed as soon as may be but not after the expiration of a period of twenty-four months from the date of the application: 20

Provided that—

(a) where the Controller has allowed an extension of time within which an application may be accepted, a further extension of four months after the said period of twenty-four months shall be allowed for the sealing of the patent; 25

(b) where the sealing is delayed by an appeal against the direction, decision or order of the Controller under section 14, section 15, section 16 or section 17 or by any proceeding taken for obtaining such direction, decision or order, the patent may be sealed at such time as the Controller may direct; 30

(c) where the patent is granted to the legal representative of an applicant who has died before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within twelve months after the date of his death or at such later time as the Controller may think fit; 35

(d) where for any reason a patent cannot be sealed within the period allowed by any of the foregoing provisions of this section, that period may, on payment of the prescribed fee and on compliance with the prescribed conditions, be extended to the extent applied for but not exceeding three months. 40

25. Date of patent.—(1) Except as otherwise expressly provided in this Act, every patent shall be dated and sealed as of the date of filing of the complete specification:

Provided that no proceedings shall be taken in respect of an infringement committed before the date of advertisement of acceptance of the application. 45

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

26. Form 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; but the specification may contain more than one claim:

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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.

(3) Subject to the provisions of Chapter XI, a patent shall have the same effect against Government as it has against any person.

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27. Rights of patentee.—A patent sealed with the seal of the Patent Office shall, subject to the other provisions of this Act, confer on the patentee—

(a) in the case of a patented article, the exclusive right to make use or sell such article in India and of authorising others so to do;

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(b) in the case of a patent relating to a process, the exclusive privilege of using and exercising such process in India and of using or selling articles in India made by such process and of authorising others so to do

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28. Patent obtained in fraud of true and first inventor.—Where a patent has been revoked by a High Court or the Controller on the ground that it has been obtained in fraud of the true and first inventor, the Controller may, on the application of the true and first inventor or his legal representative or assignee made in accordance with the provisions of this Act, grant to him a patent for the whole or any part of the invention, and

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the patent so granted shall bear the same date as the patent so revoked:

Provided that no suit shall be brought for any infringement of the patent so granted committed before the actual date on which such patent was granted.

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29. Term of patent.—(1) The term limited in every patent for the duration thereof shall, save as otherwise expressly provided by this Act, be sixteen years from its date.

(2) A patent shall, notwithstanding anything contained therein or in this Act, cease if the patentee fails to pay the prescribed fees within the prescribed times:

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Provided that the period prescribed for the payment of any fees shall be extended to such period not being more than three months longer than the prescribed period as may be specified in a request made to the Controller, if the request is made and the prescribed fees and the prescribed additional fees are paid.

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30. Extension of term of patent.—(1) A patentee may make an application to the Controller that his patent may be extended for a further term.

(2) Every application made under sub-section (1)—

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(a) shall be filed at the Patent Office at least six months before the time limited for expiration of the patent;

(b) shall be accompanied by the prescribed fee; and

(c) shall be advertised by the patentee within the prescribed time and in the prescribed manner.

(3) Any interested person may within such time as may be prescribed and on payment of the prescribed fee, give notice in the prescribed manner to the Controller of opposition to the application. 5

(4) The patentee and any person who has given notice of opposition under sub-section (3) shall be made parties to the proceedings before the Controller.

(5) The Controller having regard to— 10

(a) the nature and merits of the invention in relation to the public;

(b) the profits made on the patent; and

(c) such other circumstances as may be relevant;

and after hearing the parties may grant or refuse the application. 15

(6) If upon application made by a patentee in accordance with this section the Controller is satisfied that the patentee has not been adequately remunerated by the patent, the Controller may by order extend the term of the patent, subject to such restrictions, conditions and provisions, if any, as may be specified in the order, for such period not exceeding five years, or in an exceptional case, ten years as may be so specified; and any such order may be made notwithstanding that the term of the patent has previously expired. 20

31. Patents of addition.—(1) Subject to the provisions of this section, where an application is made for a patent in respect of any improvement or modification of an invention (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 a patent for the improvement or modification as a patent of addition. 25 30

(2) Subject to the provisions of 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. 35

(3) A patent shall not be granted as a patent of addition unless the date of filing of the complete specification was the same as or later than the date of filing of the complete specification in respect of the main invention. 40

(4) A patent of addition shall not be sealed before the sealing of the patent for the main invention; and if the period within which, but for the provisions of this sub-section, a request for the sealing of a patent could be made under section 24 expires before the period within which a request for the sealing of the patent for the main invention may be so made, the 45

request for the sealing of the patent of addition may be made at any time within the last mentioned period.

- (5) 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—

- (a) if the term of the patent for the main invention is extended under section 30, the term of the patent of addition may also be extended accordingly ;

- (b) if the patent for the main invention is revoked under this Act, the Court or the Controller, as the case may be, may order that the patent of addition shall become an independent patent for the remainder of the term of the patent for the main invention and thereupon the patent shall continue in force as an independent patent accordingly.

- (6) No renewal fees shall be payable in respect of a patent of addition, but, if any such patent becomes an independent patent under sub-section (5), the same fees shall thereafter be payable upon the same dates as if the patent had been originally granted as an independent patent.

(7) 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.

CHAPTER V

35 RESTORATION OF LAPSED PATENTS AND PATENT APPLICATIONS

- 32. Restoration of lapsed patents.—**(1) Where a patent has ceased to have effect by reason of failure to pay any prescribed fee within the prescribed period or within that period as extended under section 30, and the Controller is satisfied upon application made within the prescribed period from the date on which the patent has ceased to have effect that the failure was unintentional and that no undue delay has occurred in the making or prosecution of the application, he shall, by order, restore the patent and any patent of addition specified in the application which has ceased to have effect on the cesser of that patent.

- (2) An application under this section may be made by the person who was the patentee or by his legal representative; and where the patent was held by two or more persons jointly, the application may, with the leave of the Controller, be made by one or more of them without joining the others.

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

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(4) If after hearing the applicant (where the applicant so requires or the Controller thinks fit) the Controller is satisfied that a *prima facie* case has been made out for an order under this section, he shall advertise the application in the prescribed manner; and within the prescribed period any person may give notice to the Controller of opposition thereto on either or both of the following grounds, that is to say:—

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

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

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

(6) If no notice of opposition is given within the period aforesaid or if in the case of opposition the decision of the Controller is in favour of the applicant, the Controller shall upon payment of any unpaid prescribed fee and such additional fee as may be prescribed, make an order in accordance with the application.

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(7) An order under this section for the restoration of the patent—

(a) may be made subject to such conditions as the Controller thinks fit including in particular a condition requiring the registration in the Register of Patents of any matter in respect of which the provisions of this Act as to the entries in that Register have not been complied with; and

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(b) shall contain such provisions as may be prescribed for the protection of persons who may have begun to avail themselves of the patented invention between the date when the patent ceased to have effect and the date of the advertisement of the application under this section;

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and if any condition of an order under this section is not complied with by the patentee, the Controller may, after giving to the patentee or his legal representative an opportunity to be heard, revoke the order and give such directions consequential on the revocation as he thinks fit.

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33. Restoration of lapsed applications for patents.—(1) Where a patent has not been sealed by reason only that the prescribed request was not made within the time allowed for that purpose by or under sub-section (2) of section 24, then, if the Controller is satisfied upon application made within the prescribed period after the expiration of that time by the applicant for the patent that the failure to make the request was unintentional, he may order the patent to be sealed notwithstanding that the prescribed request was not made as aforesaid.

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(2) An application under this section shall contain a statement (to be verified in such manner as may be prescribed) fully setting out the circumstances which led to the failure to make the prescribed request and the Controller may require from the applicant such further evidence as he thinks necessary.

(3) If after hearing the applicant (where the applicant so requires or the Controller thinks fit) the Controller is satisfied that a *prima facie* case has been made out for an order under this section, he shall advertise the application in the prescribed manner; and within the prescribed period any person may give notice to the Controller of opposition thereto on the ground that the failure to make the prescribed request was not unintentional.

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

(5) If no notice of opposition is given within the period aforesaid or in the case of opposition the decision of the Controller is in favour of the applicant, the Controller shall upon payment of the prescribed fee in respect of the making of the request for sealing and of such additional fee as may be prescribed, make an order in accordance with the application.

(6) An order under this section shall contain such provisions as may be prescribed for the protection of persons who may have begun to avail themselves of the invention between the date when the time allowed by or under sub-section (2) of section 24 for the making of the prescribed request expired and the date of the advertisement of the application under this section.

CHAPTER VI

AMENDMENT OF APPLICATION OR SPECIFICATION

34. **Amendment of application or specification by Controller.**—(1) An applicant or a patentee may at any time, by request in writing lodged at the Patent Office and accompanied by the prescribed fee, seek leave to amend his application, or specification, including drawings, if any, by way of disclaimer, correction or explanation, stating the nature of, and the reasons for, the proposed amendment.

(2) If the application for a patent has not been accepted, the Controller shall determine whether and subject to what conditions (if any) the amendment shall be allowed.

(3) In any other case the request and the nature of the proposed amendment shall be advertised in the prescribed manner and at any time within three months from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

(4) Where such a notice is given, the Controller shall give notice of the opposition to the person making the request, and shall hear and decide the case.

(5) Where no notice of opposition is given, or the person so giving notice of opposition does not appear, the Controller shall determine whether and subject to what conditions, if any, the amendment may be allowed.

(6) No amendment shall be allowed that would make the application or specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the application or specification as it stood before amendment.

(7) Leave to amend shall be conclusive as to the right of the party allowed to make the amendment, except in case of fraud; and the amendment shall be advertised in the prescribed manner, and shall in all courts and for all purposes be deemed to form part of the application or specification.

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(8) No application or specification shall be amended under this section when and so long as any suit for infringement or a proceeding for the revocation of the patent is pending before a court.

35. Amendment of specification by the court.—In any suit for infringement of a patent or proceeding before a court for the revocation of a patent, the court may by order allow the patentee to amend his specification by way of disclaimer, correction or explanation in such manner, and subject to such terms as to costs, advertisement or otherwise, as the court may think fit:

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Provided that no amendment shall be so allowed as to make the specification as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment:

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Provided further that notice of the application shall be given to the Controller, and the Controller shall have the right to appear and be heard.

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CHAPTER VII

SURRENDER AND REVOCATION OF PATENTS

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

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(2) Where such an offer is made, the Controller shall advertise the offer in the prescribed manner; and within the prescribed period after such advertisement any person interested may give notice to the Controller of opposition to the surrender.

(3) Where any such notice of opposition is duly given, the Controller shall notify the patentee.

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

37. Revocation of Patents.—(1) Revocation of a patent in whole or in part may be obtained on a petition to a High Court or the Controller or on a counter-claim in a suit for infringement before a High Court, on all or any of the grounds specified in clause (a) of sub-section (2).

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(2) A petition for the revocation of a patent may be presented—

(a) at any time after the sealing of the patent to a High Court on any of the following grounds—

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(i) that the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in India;

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(ii) that the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor;

5 (iii) that the patent was obtained in contravention of the rights of the petitioner or any person under or through whom he claims;

(iv) that the subject-matter of the complete specification is not an 'invention' within the meaning of clause (h) of section 2;

(v) that the invention is not patentable under section 3;

10 (vi) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed or does not disclose the best method of performing it which was known to the applicant for a patent and for which he was entitled to claim protection;

15 (vii) that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;

(viii) that the patent was obtained on a false suggestion or representation;

20 (ix) that the primary or intended use or exercise of the invention is contrary to law;

(x) that the patentee has contravened, or has not complied with, the conditions, if any, contained in the patent;

25 (xi) that prior to the date of the patent, the patentee or other person (not being the Government or any person authorised in that behalf by the Government) secretly worked the invention on a commercial scale (and not merely by way of reasonable trial or experiment) in India and thereby made direct or indirect profits in excess of such amount as the court or the Controller may in
30 consideration of all the circumstances of the case deem reasonable;

(b) within one year from the date of sealing of the patent to the Controller on any of the grounds specified in clause (a).

35 (3) A notice of any petition for revocation of a patent under this section shall be served on all persons appearing from the register to be proprietors of that patent or to have shares or interests therein and it shall not be necessary to serve a notice on any other person.

40 (4) Without prejudice to the provisions of sub-section (2), a patent may be revoked on the petition of the Government if a High Court or the Controller, as the case may be, is satisfied that the patentee has without reasonable cause failed to comply with the request of the Government to make, use or exercise the patented invention for the purposes of the Union or of the State, as the case may be, upon reasonable terms:

Provided that when a suit for infringement or a proceeding for the revocation of a patent is pending in any court, a petition to the Controller under this section shall not be made except with the leave of the Court:

Provided further that this section shall have effect in relation to the ground of revocation specified in sub-clause (ii) of clause (a) of sub-section (2) subject to the provisions of section 81. 5

38. Procedure for petition of revocation to High Court.—(1) A petition for revocation of a patent to a High Court may be presented—

(a) by the Attorney General for India or by the Advocate General of a State or any person authorised by either of them; or 10

(b) by any person alleging—

(i) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims; or

(ii) that he, or any person under or through whom he claims, was the true and first inventor of any invention included in the claim of the patentee; or 15

(iii) that he, or any person under or through whom he claims an interest in any trade, business or manufacture, had publicly manufactured, used or sold, within India before the date of the patent, anything claimed by the patentee as his invention. 20

(2) The High Court may, notwithstanding anything contained in the Code of Civil Procedure, 1908 (Act V of 1908), require any person, other than the Attorney General, the Advocate General or any person authorised by either of them, applying for the revocation of a patent to give security for the payment of all costs incurred or likely to be incurred by any person appearing to oppose the petition. 25

(3) The High Court may, if it thinks fit, direct an issue for the trial before itself or any district court subordinate to it, of any question arising upon a petition to itself under section 37, and the issue shall be tried accordingly. 30

(4) If the issue is directed to such district court, the finding of that court shall not be subject to appeal, but the evidence taken upon the trial shall be recorded and a copy thereof, certified by the Judge of the court, shall be transmitted, together with any remarks which he may think fit to make thereupon, to the High Court directing the issue, and the High Court may thereupon act upon the finding of the district court or dispose of the petition upon the evidence recorded, or direct a new trial, as the justice of the case may require. 35

39. Procedure for petition of revocation to Controller.—(1) Where a petition is made to the Controller under section 37, the Controller shall give to all persons to whom a notice is issued under sub-section (3) of that section and the petitioner an opportunity to be heard before deciding the case. 40

(2) If on a petition under section 37, the Controller is satisfied that any of the grounds specified in clause (a) of sub-section (2) of that section are established, he may by order direct that the patent shall be revoked either unconditionally or unless within such time as may be specified in the order the complete specification is amended to his satisfaction. 45

CHAPTER VIII

COMPULSORY LICENCES.

40. Application for licence.—(1) At any time after the expiration of three years from the date of the sealing of a patent, any person interested **5** may apply to the Controller upon any one or more of the grounds specified in sub-section (2) for a licence under the patent.

(2) The grounds upon which an application under sub-section (1) may be made are as follows, that is to say:—

10 (a) that the patented invention being capable of being commercially worked in India, has not been commercially worked therein or is not being so worked to the fullest extent that is reasonably practicable;

15 (b) that a demand for the patented article in India is not being met to an adequate extent or on reasonable terms, or is being met to a substantial extent by importation of the patented article from other countries;

(c) that the commercial working of the invention in India is being prevented or hindered by the importation of the patented article from other countries;

20 (d) that by reason of the refusal of the patentee to grant a licence or licences on reasonable terms—

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

25 (ii) 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;

30 (e) that by reason of conditions imposed by the patentee upon the grant of licences under the patent, or upon the purchase, hire or use of the patented article or process, the manufacture, use or sale of materials not protected by the patent or the establishment or development of commercial or industrial activities in India is unfairly prejudiced.

35 (3) An application under this section may be made by any person notwithstanding that he is already the holder of a licence under the patent; and no person shall be estopped from alleging any of the matters specified in sub-section (2) by reason of any admission made by him, whether in such a licence or otherwise, or by reason of his having accepted such a licence.

40 (4) In this section the expression 'patented article' includes any article made by a patented process.

41. Relief in respect of an application under section 40.—(1) Where an application is made under section 40, the Controller may make an order granting any of the following reliefs, that is to say, the Controller may—

45 (a) grant a licence to the applicant upon such terms as the Controller thinks fit; and may also, where the circumstances so require, direct that all other existing licences in respect of the patent shall either be amended or revoked, or that the patentee shall forfeit any right which may have as a patentee, to make, use, exercise or vend **50** the invention or to grant licences under the patent;

(b) revoke any existing licence held by the applicant and grant a new licence upon such terms as the Controller thinks fit, or amend any licence held by the applicant in such manner as the Controller may think fit;

(c) grant a licence under the patent to such customers of the applicant and on such terms as the Controller thinks fit, if the Controller is satisfied that the manufacture, use or sale of materials not protected by the patent is unfairly prejudiced by reason of conditions imposed by the patentee upon the grant of licences under the patent or upon the purchase, hire or use of the patented article or process: 5
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Provided that where the application is made on the ground that the patented invention is not being commercially worked in India or is not being worked to the fullest extent that is reasonably practicable and it appears to the Controller that the time which has elapsed since the granting of the patent has for any reason been insufficient to enable it to be so worked, he may, by order, adjourn the application for such period as will, in his opinion, give sufficient time for the invention to be so worked. 15

(2) Except in cases where the terms of a licence have been settled by mutual agreement and such terms otherwise provide, any person to whom a licence has been granted under sub-section (1) shall be entitled to call upon the patentee to take proceedings to prevent any infringement of the patent and if the patentee refuses or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as though he were the patentee, making the patentee a defendant but a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. 20
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42. Endorsement of patent on application by Government.—(1) At any time after the expiration of three years from the date of the sealing of a patent, the Central Government may apply to the Controller upon any one or more of the grounds specified in sub-section (2) of section 40 for the endorsement of the patent with the words 'Licences of Right'. 30

(2) An application under this section may also be made on the ground that by the refusal of the patentee to grant a licence or licences on reasonable terms the establishment or development of commercial or industrial activities in India is unfairly prejudiced or the development of an industry, the control of which by the Union is declared by Parliament by law to be expedient in the public interest, is being prevented or hindered. 35

(3) Where a patent of addition is in force, any application under sub-section (1) either for the endorsement of the original patent or the patent of addition shall be deemed to be an application for the endorsement of both the patents and where any such application is granted or refused, it shall be deemed to have been granted or refused in respect of both the patents. 40
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(4) All endorsements of patents made under this section shall be entered in the Register of Patents maintained under section 67.

(5) For the removal of doubts it is hereby declared that nothing in this section shall affect the right of the Central Government or any State

Government to make an application for the grant of a licence in respect of any industrial undertaking or trading activity owned or carried on by such Government.

43. Provision as to patents endorsed 'Licences of Right'.—(1) Where the Controller has made an endorsement upon a patent 'Licences of Right'—

(a) any person shall at any time after such endorsement be entitled as of right to a licence under the patent upon such terms as in default of agreement may be settled by the Controller on the application either of the patentee or of the person applying for a licence;

(b) the Controller may, on the application of a person holding a licence granted under the patent before the endorsement, order the licence to be revoked and grant a new licence by virtue of the endorsement upon terms to be settled in the aforesaid manner;

(c) if in proceedings for the infringement of the patent (otherwise than by importation of the patented article from other countries) the infringing defendant is ready and willing to take a licence upon terms to be settled by the Controller, no injunction against him shall be awarded, and the amount recoverable against him by way of damages, if any, shall not exceed double the amount which would have been recoverable against him as licensee if the licence had been dated prior to the earliest infringement;

(d) the renewal fees payable in respect of a patent so endorsed shall, as from the date of the endorsement, be one moiety only of the fees which would otherwise have been payable.

(2) The provisions of sub-section (2) of section 41 shall apply to any licence granted under sub-section (1) as they apply to a licence granted under the said section.

44. Exercise of powers on application under section 40 or section 42.—(1) The powers of the Controller upon an application under section 40 or section 42 shall be exercised with a view to securing the following general purposes, that is to say,—

(a) that inventions which can be worked on a commercial scale in India and which should in the public interest be so worked shall be worked therein without undue delay and to the fullest extent that is reasonably practicable;

(b) that the inventor or other person beneficially entitled to a patent shall receive reasonable remuneration having regard to the nature of the invention;

(c) that the interests of any person for the time being working or developing an invention in India under the protection of a patent shall not be unfairly prejudiced.

(2) Subject to the provisions of sub-section (1), the Controller shall in determining whether to make an order in pursuance of any such application or not, take account of the following matters, that is to say,—

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

(b) the ability of any person to whom a licence is to be granted under the order to work the invention to the public advantage; and

(c) the risks to be undertaken by that person in providing capital and working the invention if the application is granted;

but shall not take account of matters subsequent to the making of the application. 5

45. Inventions relating to food, medicines, insecticides, etc.—(1) Without prejudice to the foregoing provisions of this Act, where a patent is in force in respect of—

(a) a substance capable of being used as food, medicine, insecticide, germicide or fungicide or in the production of food, medicine, insecticide, germicide or fungicide, or 10

(b) a process for producing such a substance as aforesaid, or

(c) any invention capable of being used as or as part of a surgical or curative device, 15

the Controller shall, on application made to him by any person interested, order the grant to the applicant of a licence under the patent on such terms as he thinks fit, unless it appears to him that there are good reasons for refusing the application.

(2) In settling the terms of licences under this section, the Controller shall endeavour to secure that food, medicines, insecticide, germicide or fungicide and surgical and curative devices shall be available to the public at the lowest prices consistent with the patentees' deriving a reasonable advantage from their patent rights. 20

(3) A licence granted under this section shall entitle the licensee to make, use, exercise and vend the invention as food, medicine, insecticide, germicide or fungicide or for the purposes of the production of food, medicine, insecticide, germicide, or fungicide or as or as part of surgical or curative device, but for no other purposes. 25

(4) Where a patent other than a patent referred to in sub-section (1) is in force in respect of a substance or process for producing a substance and the Central Government is satisfied that it is expedient or necessary in the public interest that a licence under such a patent should be granted, the Central Government may, by notification in the Official Gazette, direct that the provisions of sub-section (1), sub-section (2) and sub-section (3) respecting the grant of licences shall apply to such a patent, and on the issue of such a notification, the said provisions shall apply to the patent as they apply to a patent referred to in sub-section (1). 30 35

46. Procedure on application under section 40 or section 42 or section 45.—(1) Every application under section 40 or section 42 or section 45 shall specify the nature of the order sought by the applicant and shall contain a statement setting out the nature of the applicant's interest, if any, and the facts upon which the application is based. 40

(2) Where the Controller is satisfied, upon consideration of any such application, that a *prima facie* case has been made out for the making of an order, he shall direct the applicant to serve copies of the application upon the patentee and any other persons appearing from the Register of Patents to be interested in the patent in respect of which the application is made and shall advertise the application. 45

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

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

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

47. Supplementary provisions with respect to orders under this Chapter.—

15 (1) Any order made by the Controller under this Chapter for the grant of a licence shall, without prejudice to any other mode of enforcement have effect as if it were a deed, executed by the patentee and all other necessary parties, granting a licence in accordance with the order.

(2) Notwithstanding anything contained in this Act, no order shall be made in pursuance of an application under section 40 or section 42 which would be at variance with any treaty, convention, arrangement or engagement applying to India and any other country.

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CHAPTER IX

ANTICIPATIONS

25 **48. Previous use and publication.—**(1) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of the public use or knowledge of the invention if such knowledge has been obtained surreptitiously or in fraud of the true and first inventor or his legal representative or assignee or has been communicated to the public in fraud of such inventor or his legal representative or assignee or in breach of confidence:

30 Provided that such inventor or his legal representative or assignee has not acquiesced in the public use of his invention and that he applies for a patent within six months after the commencement of such use.

(2) An invention claimed in a complete specification shall not be deemed to have been anticipated—

35 (a) by the secret use of the invention except where such secret use has been on a commercial scale by, or on behalf of, the applicant for the patent or any person deriving title from him, or

(b) by reason only that the invention was published in India—

40 (i) in a specification filed in pursuance of an application for a patent made in India and dated more than fifty years before the date of filing of the complete specification; or

(ii) in a specification describing the invention for the purposes of an application for protection in any country outside India made more than fifty years before the date of filing of the complete specification; or

45 (iii) in any abridgement of, or extract from, any such specification published under the authority of the Controller or of the Government of any country outside India.

(2) Notwithstanding anything in this Act, the Controller shall not refuse to accept the complete specification or to grant a patent, and the patent shall not be revoked or invalidated, by reason only of any circumstances which by virtue of this section do not constitute an anticipation for the invention claimed in the specification.

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49. Previous communication, display or working.—(1) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of the communication of the invention to the Government or to any person authorised by the Government to investigate the invention or its merits or of anything done, in consequence of such a communication for the purpose of the investigation.

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

(a) the display of the invention with the consent of the true and first inventor 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 purposes of such an exhibition in the place where it is held; or

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

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

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(d) the description of the invention in a paper read by the true and first inventor before a learned society or published with his consent in the transactions of such a society;

if the application for the patent is made by the true and first inventor or a person deriving title from him not later than six months after the opening of the exhibition or the reading or publication of the paper, as the case may be.

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(3) 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—

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

(b) by any other person with the consent of the patentee or applicant for the patent or any person from whom he derives title;

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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.

(4) Notwithstanding anything in this Act, the Controller shall not refuse to accept an application for a patent or to grant a patent, and a patent shall not be revoked or invalidated, by reason only of the circumstances which, by virtue of this section, do not constitute an anticipation of the invention claimed in the specification.

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CHAPTER X

JOINT PATENTERS

50. **Co-ownership of patents.**—(1) Where after the commencement of this Act 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 of this section and 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 make, use, exercise and vend the patented invention for his own benefit without accounting to the other person or persons.

(3) Subject to the provisions of this section and section 51, and to any agreement for the time being in force, a licence under a patent shall not be granted, and a share in a patent shall not be assigned, except with the consent of all persons, other than the licensor or assignor, who are registered as grantee or proprietor of the patent.

(4) Where an 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 of this section, the rules of law applicable to the ownership and devolution of movable property generally, shall apply in relation to patents as they apply in relation to other choses in action; and nothing in sub-section (1) or sub-section (2) shall affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person, or their rights or obligations as such.

51. **Power of Controller to give directions.**—(1) Where two or more persons are registered as grantee or proprietor of a patent, the Controller may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application with respect to the sale or lease of the patent or any interest therein, the grant of licences 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 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 directions 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 their rights or obligations as such.

CHAPTER XI

USE OF PATENTED INVENTIONS BY GOVERNMENT IN CERTAIN CASES

52. Definitions.—In this Chapter, unless the context otherwise requires,—

(a) 'purposes of the Government' means purposes of the Union or of a State, as the case may be; 5

(b) 'Government' means—

(i) in relation to the purposes of the Union, the Central Government; and

(ii) in relation to the purposes of a State, the State Government. 10

53. Use of inventions for Government purposes.—(1) Notwithstanding anything in this Act, the Government and any person authorised in writing by it may make, use and exercise any patented invention for the purposes of the Government in accordance with the provisions of this Chapter. 15

(2) If and so far as the invention has, before the priority date of relevant claim of the complete specification, been duly recorded by or tried by or on behalf of the Government otherwise than in consequence of the communication thereof directly or indirectly by the applicant or the patentee or any person from whom he derives title, any use of the invention by virtue of this section may be made free of any royalty or other payment to the patentee. 20

(3) If and so far as the invention has not been so recorded or tried as aforesaid, any use of the invention made by virtue of this section at any time after the acceptance of the application in respect of the patent, or in consequence of any such communication as aforesaid, shall be made upon such terms as may be agreed upon, either before or after the use, between the Government and the applicant or the patentee, as the case may be, or as may in default of agreement be determined by the High Court on a reference under section 55. 25 30

(4) The authority of the Government in respect of an invention may be given under this section either before or after the patent is granted and either before or after the acts in respect of which the authority is given are done, and may be given to any person whether or not he is authorised directly or indirectly by the applicant or the patentee to make, use, exercise or vend the invention. 35

(5) Where any use of an invention is made by or with the authority of the Government under this section, then unless it appears to the Government that it would be contrary to the public interest so to do, the Government shall notify the applicant or the patentee as soon as practicable after the use is begun and furnish him with such information as to the extent of the use as he may, from time to time, require. 40

(6) The right to use an invention conferred upon the Government under this section, or any provision for which this section is substituted shall include the power to sell any article made in pursuance of such right which is no longer required for the purposes of the Government. 45

(7) The purchaser of any articles sold in exercise of the powers conferred by this section and any person claiming through him shall have power to deal with them in the same manner as if the patent were held on behalf of the Government. 50

54. Rights of third parties in respect of Government use.—(1) In relation to any use of a patented invention or an invention in respect of which an application for a patent is pending, made for the purposes of the Government—

5 (a) by the Government or any person authorised by the Government under section 53, or

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

10 the provisions of any licence, assignment or agreement made whether before or after the commencement of this Act, between the patentee or applicant for the patent, or any person who derives title from him or from whom he derives title, and any person other than the Government shall be of no effect so far as those provisions restrict or regulate the use of the invention, or any model, document or information relating thereto, or
15 provide for the making of payments in respect of any such use, or calculated by reference thereto; and the reproduction or publication of any model or document in connection with the said use shall not be deemed to be an infringement of any copyright subsisting in the model or document.

20 (2) Where an exclusive licence granted otherwise than for royalties or other benefits determined by reference to the use of the invention is in force under the patent, then—

(a) in relation to any use of the invention which, but for the provisions of this section and section 53, would constitute an infringement of the rights of the licensee, sub-section (3) of section 53 shall have effect as if for the reference to the patentee there were substituted a reference to the licensee; and
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(b) in relation to any use of the invention by the licensee by virtue of an authority given under section 53, that section shall have effect as if the said sub-section (3) were omitted.

30 (3) Subject to the provisions of sub-section (2), where the patent, or the right to apply for or obtain the patent, has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention, then—

(a) in relation to any use of the invention by virtue of section 35 53, sub-section (3) of that section shall have effect as if the reference to the patentee included a reference to the assignor, and any sum payable by virtue of that sub-section shall be divided between the patentee and the assignor in such proportion as may be agreed upon between them or as may in default of agreement be determined by the High
40 Court on a reference made under section 55; and

(b) in relation to any use of the invention made for the purposes of the Government by the patentee to the order of the Government, sub-section (3) of section 53 shall have effect as if that use were made by virtue of an authority given under that section.

45 (4) Where, under sub-section (3) of section 53, payments are required to be made by the Government to a patentee in respect of any use of an invention, any person being the holder of an exclusive licence under patent [not being such a licence as is mentioned in sub-section (2) of this section] authorising him to make that use of the invention, shall be entitled

to recover from the patentee such part (if any) of those payments as may be agreed upon between that person and the patentee or the applicant, or as may in default of agreement be determined by the High Court under section 55 to be just having regard to any expenditure incurred by that person—

(a) in developing the said invention; or

(b) in making payments to the patentee, other than royalties or other payments determined by reference to the use of the invention, in consideration of the licence;

and if, at any time before the amount of any such payment has been agreed upon between the Government and the patentee or the applicant, that person gives notice in writing of his interest to the Government, any agreement as to the amount of that payment shall be of no effect unless it is made with his consent.

55. Reference of disputes as to Government use.—(1) Any dispute as to the exercise by the Government or a person authorised by it of the powers conferred by section 53, or as to terms for the use of an invention for the purposes of the Government thereunder, or as to the right of any person to receive any part of a payment made in pursuance of sub-section (3) of that section, may be referred to a High Court by either party to the dispute in such manner as may be prescribed by the rules of the High Court:

Provided that, if the inventor or the patentee is a Government servant, or the subject-matter of the invention is certified by the Government to be connected with work done in the course of the normal duties of a Government servant, any such dispute shall be settled by the Government after hearing the applicant or the patentee and any other person having an interest in the invention or patent.

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

(a) if the patentee is a party to the proceedings, apply for revocation of the patent upon any ground upon which a patent may be revoked under section 37; and

(b) in any case, put in issue the validity of the patent without applying for its revocation.

(3) If in such proceedings as aforesaid any question arises whether an invention has been recorded or tried as is mentioned in section 53, and the disclosure of any document recording the invention, or of any evidence of the trial thereof, would in the opinion of the Government be prejudicial to the public interest, the disclosure may be made confidentially to counsel of the other party or to an independent expert mutually agreed upon.

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

(5) In any proceedings under this section, the High Court may at any time order the whole proceedings or any question or issue of fact arising therein to be referred to an official referee, Commissioner or an arbitrator

on such terms as the High Court may direct; and references to the High Court in the foregoing provisions of this section shall be construed accordingly.

- 5 **56. Saving.**—Nothing in this Chapter shall affect the power of the Government or of any person deriving title directly or indirectly from the Government to sell or use any articles forfeited under any law for the time being in force relating to customs or excise.

CHAPTER XII

DECLARATORY SUITS AND SUITS FOR INFRINGEMENT OF PATENTS

- 10 **57. Power of Court to make declaration as to non-infringement.**—(1) Notwithstanding anything contained in section 42 of the Specific Relief Act, 1877 (I of 1877), any person who has reasonable cause to doubt whether the use of a process or the making or using or selling of any article would constitute an infringement of a claim of a patent, may
15 institute a declaratory suit in the district court having jurisdiction, if it is shown—

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

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

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

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

30 (4) A suit for a declaration may be brought by virtue of this section at any time after the date of advertisement of acceptance of the application for a patent and references in this section to the patentee shall be construed accordingly.

35 **58. Suit for infringement of patents.**—(1) A patentee may institute a suit in the district court having jurisdiction to try the suit against any person who, during the continuance of a patent acquired by him under this Act in respect of an invention, makes, sells or uses the invention without his licence, or counterfeits it, or imitates it.

40 (2) The holder of an exclusive licence shall have the like right as the patentee to institute a suit in respect of any infringement of the patent committed after the date of the licence, and in awarding damages or granting any other relief in any such suit the court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such
45 or, as the case may be, the profits earned by means of the infringement so far as it constitutes an infringement of the rights of the exclusive licensee as such.

(3) In any suit for infringement of patent by the holder of an exclusive licence under sub-section (2), the patentee shall, unless he has joined as a plaintiff in the suit, be added as a defendant:

Provided that a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. 5

(4) Every ground on which a patent may be revoked under section 37 shall be available by way of defence to a suit for infringement of a patent instituted under this section.

(5) A defendant in a suit for infringement of a patent may apply for revocation of the patent by way of counter-claim in the suit: 10

Provided that where such a counter-claim is made, the suit along with the counter-claim shall be transferred to a High Court for decision.

59. Restriction on recovery of damages for infringement.—(1) In a suit for the infringement of a patent damages shall not be awarded against the defendant who proves that at the date of infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent. 15

Explanation.—A person shall not be deemed to have been aware or to have had reasonable means of making himself aware as aforesaid by reason only of the application to an article of the word "patent", "patented" or any word or words expressing or implying that a patent has been obtained for the article, unless the number of the patent accompanied the word or words in question. 20

(2) In any proceeding for infringement of a patent the court may, if it thinks fit, refuse to award any damages in respect of any infringement committed after a failure to pay any renewal fee within the prescribed period and before any extension of that period. 25

(3) Where an amendment of a specification by way of disclaimer, correction or explanation has been allowed under this Act after the publication of the specification, no damages shall be awarded in any proceeding in respect of the use of the invention before the date of the decision allowing the amendment, unless the court is satisfied that the specification as originally published was framed in good faith and with reasonable skill and knowledge. 30 35

(4) Nothing in this section shall affect the power of the court to grant an injunction in any proceedings for infringement of a patent.

60. Order of inspection, etc., in suit.—In a suit for infringement of a patent, the court may, on the application of one party make such order for an injunction or inspection of accounts, and impose such terms and give such directions respecting the same and the proceedings thereon, as the court may deem fit. 40

61. Certificate of contested validity of specification.—(1) If in any suit for infringement of a patent the validity of any claim of a specification is contested, and that claim is found by the court to be valid, the court may certify that the validity of that claim was contested in that suit. 45

(2) Where any such certificate has been granted, if in any subsequent suit before the court for infringement of the patent or for revocation of the patent, a final order or judgment is made or given in favour of the party relying on the validity of the patent, that party shall, unless the court otherwise directs, be entitled to all costs, charges and expenses of, and incidental to, the said suit properly incurred:

Provided that this sub-section shall not apply to the costs of any appeal against a decree in any such suit.

62. Relief for infringement of partially valid specification.—(1) If in proceedings for infringement of a patent it is found that any claim of the specification being a claim in respect of which infringement is alleged, is valid, but that any other claim is invalid, the court may grant relief in respect of any valid claim which is infringed:

Provided that the court shall not grant relief by way of damages or costs except in the circumstances mentioned in sub-section (2).

(2) Where the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the court shall grant relief in respect of any valid claim which is infringed subject to the discretion of the court as to costs and as to the date from which damages should be reckoned.

(3) For the purpose of granting any relief under sub-section (1) or sub-section (2), the court may direct that the specification shall be amended to its satisfaction upon an application made for that purpose under section 35, and such an application may be made accordingly whether or not all other issues in the proceeding have been determined.

Explanation.—In exercising the discretion as to costs and as to the date from which the damages should be reckoned, the court may take into consideration the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there.

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CHAPTER XIII

MISCELLANEOUS PROVISIONS RELATING TO REVOCATION AND INFRINGEMENT OF PATENTS

63. Transmission of decrees and orders to the Controller.—A court making a decree in a suit for infringement of patent under section 58 or an order on a petition under section 37 shall send a copy of the decree or order, as the case may be, to the Controller, who shall cause an entry thereof and reference thereto to be made in the register of patents.

64. Power of High Court to stay proceedings, etc.—A High Court to which a petition has been presented under section 37 may stay proceedings on, or dismiss the petition if in its opinion the petition would be disposed of more justly or conveniently by another High Court.

65. Hearing with assessor.—(1) In a suit or proceeding for infringement or revocation of a patent, the court may, if it thinks fit, and shall on the request of all the parties to the proceedings, call in the aid of an assessor specially qualified, and try the case wholly or partially with his assistance.

(2) A court exercising appellate jurisdiction in respect of such suit or proceeding may, if it thinks fit, call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this section shall in every case be determined by the court and be paid by it as part of the expense of the execution of this Act.

66. Remedy for groundless threats of infringement proceedings.—(1)

Where any person (whether entitled to or interested in a patent or an application for a patent or not) by circulars, advertisements or otherwise threatens any other person with proceedings for infringement of a patent, any person aggrieved thereby may bring a suit against him in a district court having jurisdiction to try the suit for any such relief as is mentioned in sub-section (2).

(2) Unless in any action brought by virtue of this section the defendant proves that the acts in respect of which the proceedings were threatened constitute or, if done, would constitute, an infringement of a patent or of rights arising from the publication of a complete specification in respect of a claim of the specification not shown by the plaintiff to be invalid, the plaintiff shall be entitled to the following reliefs, that is to say:—

- (a) a declaration to the effect that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) such damages, if any, as the plaintiff has sustained thereby.

(3) For the removal of doubts it is hereby declared that a mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.

(4) Nothing in this section shall apply if a suit for infringement of a patent is commenced and prosecuted with due diligence.

CHAPTER XIV

REGISTER OF PATENTS, ETC.

67. Register of patents.—(1) There shall be kept at the Patent Office a register of patents wherein shall be entered—

- (a) the names and addresses of grantees of patents;
- (b) notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents; and
- (c) particulars of such other matters affecting the validity or proprietorship of patents as may be prescribed.

(2) Copies of all deeds, agreements, licences and other documents affecting the proprietorship in any patent or in any licence thereunder shall be supplied to the Controller in the prescribed manner for filing in the Patent Office.

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

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

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

5 (6) For the removal of doubts, it is hereby declared that the register of patents existing at the commencement of this Act shall be incorporated in, and form part of, the register of patents under this Act.

10 **68. Entry of assignments and transmissions in register.**—(1) Where any person becomes entitled by assignment, transmission or operation of law to a patent or to a share in a patent, or becomes entitled as a mortgagee, licensee or otherwise to any other interest in a patent, he shall apply in writing in the prescribed manner to the Controller for the registration of his title, or, as the case may be, of notice of his interest in the register of patents.

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

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

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

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

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

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

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

45 **69. Rectification of register.**—(1) The Controller may, on the application in the prescribed manner of any person aggrieved by the non-insertion in, or omission from, the register of patents of any entry, or of any entry made in such a register without sufficient cause, or of any entry wrongly remaining in such register, or by an error or defect in any entry in such register, make such order for making, expunging or varying such entry as he thinks fit and rectify the register accordingly.

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(2) In proceedings under this section the Controller may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register.

(3) The Controller may refer any application under this section to a High Court for decision, and the High Court shall dispose of any application so referred in such manner as it thinks fit.

(4) Any order made by a High Court rectifying the register shall direct that notice of the rectification be served on the Controller in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly.

(5) Nothing in this section shall be deemed to empower the Controller to rectify the register of Patents or to decide any question relating to a patent otherwise than for the purpose of correcting a mistake of fact, apparent from a reference either to the patent itself or to some order of a competent authority made under any other provision of this Act.

70. Evidence of entries, documents, etc.—(1) A certificate purporting to be under the hand of the Controller as to any entry, matter or thing which he is authorised by this Act, or any rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

(2) A copy of any entry in any register or of any document kept in the Patent Office or of any patent, or an extract from any such register or document purporting to be certified by the Controller and to be sealed with the seal of the Patent Office shall be admitted in evidence in all Courts in India, and in all proceedings, without further proof or production of the original:

Provided that a Court may, if it has reason to doubt the accuracy or authenticity of any such copy or extract tendered in evidence require the production of the original or such further proof as it considers necessary.

CHAPTER XV

POWERS OF CONTROLLER IN PROCEEDINGS UNDER THE ACT

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

(a) summoning and enforcing the attendance of any person and examining him on oath;

(b) requiring the discovery and production of any document;

(c) receiving evidence on affidavits;

(d) issuing commissions for the examination of witnesses or documents;

(e) awarding costs; and

(f) any other matter which may be prescribed.

(2) Any costs awarded by the Controller in exercise of the powers conferred upon him by clause (e) of sub-section (1) shall be executable in any court having jurisdiction as if it were a decree of that court.

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

73. **Exercise of discretionary power by Controller.**—Where any discretionary power is by or under this Act given to the Controller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of an application or of a specification without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard.

CHAPTER XVI

PATENT AGENTS

74. **Patent agents.**—Save as otherwise provided in this Chapter where by or under this Act any act other than the making of an affidavit is required to be done by any person, the act may subject to prescribed conditions or in special cases with the consent of the Central Government be done in lieu of that person himself, by a duly authorised agent, being a person registered in the prescribed manner as a patent agent.

75. **Subscription and verification of certain documents.**—The following documents, namely:—

- (i) applications for a patent,
- (ii) applications for extension of term of a patent,
- (iii) applications for the restoration of lapsed patents,
- (iv) applications for the sealing of a patent after the time allowed for that purpose by or under sub-section (2) of section 24 has expired,
- (v) applications for leave to amend,
- (vi) applications for compulsory licence or revocation,
- (vii) notices of surrender of patents, and
- (viii) applications for endorsement of patent with the words 'Licences of Right',

shall be signed and verified, in the manner prescribed by the person making such applications or giving such notices:

Provided that if such person is absent from India, they may be signed and verified on his behalf by a patent agent authorised by him in writing in that behalf.

76. **Restrictions on practice as patent agents.**—An individual shall not, either alone or in partnership with any other person, practise, describe himself or hold himself out as a patent agent, or permit himself to be so described or held out, unless he is registered as a patent agent in the register of patent agents or, as the case may be, unless he and all his partners are so registered and a company shall not practise, describe itself

or hold itself out or permit itself to be described or held out as aforesaid unless every director of the company and the manager (if he is not a director) or the managing agents, if any, of the company are registered as aforesaid.

77. Power of Controller to refuse to deal with certain agents.—(1) Subject to any rules made in this behalf, the Controller may refuse to recognise as agent in respect of any business under this Act— 5

(a) any individual whose name has been removed from, and not restored to, the register of patent agents, or who is for the time being suspended from acting as a patent agent; 10

(b) any person who has been convicted of an offence under section 90;

(c) any person who has been found by the Central Government (after being given an opportunity to be heard) to have been convicted of any offence or to have been guilty of any such misconduct as, in the case of an individual registered in the register of patent agents, would render him liable to have his name removed therefrom; 15

(d) any person, not being registered as a patent agent, who in the opinion of the Controller is engaged wholly or mainly in acting as agent in applying for patents in India or elsewhere in the name or for the benefit of a person by whom he is employed; 20

(e) any company or firm, if any person whom the Controller could refuse to recognise as agent in respect of any business under the Act is acting as a director or manager of the company or is a partner in the firm. 25

(2) The Controller shall refuse to recognise as agent in respect of any business under this Act, any person who neither resides nor has a place of business in India.

78. Saving.—Nothing in this Chapter shall be deemed to prohibit a legal practitioner from taking part in any proceeding under this Act. 30

CHAPTER XVII

INTERNATIONAL AGREEMENTS

79. Definitions.—In this Chapter, 'convention application' means an application for a patent made by virtue of section 81.

80. Notification as to the declaration of a convention country.—The Central Government may, with a view to the fulfilment of a treaty, convention or arrangement, by notification in the Official Gazette, declare that any country specified in the notification is a convention country for the purposes of this Act: 35

Provided that a declaration may be made as aforesaid for the purposes either of all or of some only of the provisions of this Act, and a country in the case of which a declaration made, for the purposes of some only of the provisions of this Act is in force shall be deemed to be a convention country for the purpose of those provisions only. 40

81. Convention application.—(1) Without prejudice to the provisions of section 6 an application for a patent for an invention in respect of which protection has been applied for in a convention country may be made by the 45

person by whom the application for protection was made or by his legal representative or assignee either alone or jointly with any other person:

5 Provided that no such application shall be made after the expiration of twelve months from the date of the application for protection in a convention country or where more than one such application for protection have been made, from the date of the first application.

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

15 Provided that the fee payable on the making of any such application shall be the same as if separate applications had been made in respect of each of the said inventions; and the requirements of clause (b) of subsection (1) of section 82 shall, in the case of any such application, apply separately to the applications for protection in respect of each of the said inventions.

82. Special provisions relating to convention application.—(1) A convention application shall—

20 (a) be accompanied by a complete specification; and

(b) specify the date on which and the convention country in which the application for protection or the first such application was made and shall state that no application for protection in respect of the invention had been made in a convention country before that date 25 by the applicant or any person from whom he derives title.

(2) A complete specification filed in pursuance of a convention application may include claims in respect of development of, or additions to, the invention in respect of which the application for protection was made in a convention country, being developments or additions in respect of which 30 the applicant would be entitled under the provisions of section 6 to make a separate application for a patent.

(3) If a convention application is not accepted within eighteen months from the date of the application for protection in a convention country or where more than one such application for protection have been made from the date of the first application, the specification shall with drawings (if 35 any) supplied therewith be open to public inspection at the expiration of such period.

83. Priority date of claims of complete specification in respect of convention application.—Where a claim in a complete specification filed in pursuance of a convention application is fairly based on the matter disclosed in the application for protection in a convention country or where 40 the convention application is founded upon more than one such application for protection, in one of those applications, the priority date of that claim shall be the date of the relevant application for protection.

84. Supplementary provisions as to convention applications.—(1) Where a person has applied for protection for an invention by an application which—

50 (a) in accordance with the terms of a treaty subsisting between any two or more convention countries, is equivalent to an application duly made in any one of those convention countries; or

(b) in accordance with the law of any convention country is equivalent to an application duly made in that convention country;

he shall be deemed for the purposes of this Act to have applied in that convention country.

(2) For the purposes of this Act, a matter shall be deemed to have been disclosed in an application for protection in a convention country if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgment of prior art) in that application or in documents submitted by the applicant for protection in support of and at the same time as that application; but no account shall be taken of any disclosure effected by any such document unless a copy of the document is filed at the Patent Office with the convention application or within such period as may be prescribed after the filing of that application.

85. Other provisions of this Act to apply to convention application.— Save as otherwise provided in this Chapter, all the provisions of this Act shall apply in relation to a convention application and a patent granted in pursuance thereof as they apply in relation to an ordinary application and a patent granted in pursuance thereof.

86. Special provisions as to vessels, aircraft and land Vehicles.—Where a vessel or aircraft registered in a convention 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.

CHAPTER XVIII

APPEALS

87. Appeals.—(1) An appeal shall lie to a High Court from any direction, decision or order of the Controller under any of the following provisions, that is to say,—

- (a) any order under section 14;
- (b) any order under section 15;
- (c) any direction, decision or order under section 16;
- (d) any direction under section 17;
- (e) any direction or decision under section 21;
- (f) any decision under section 22;
- (g) any order under section 30;
- (h) any decision or order under section 31;
- (i) any order under section 32;
- (j) any order under section 33;
- (k) any decision under sub-section (4) or sub-section (5) of section 34;
- (l) any order under sub-section (4) of section 36;

- (m) any order under sub-section (4) of section 37 ;
 (n) any order under sub-section (2) of section 39 ;
 (o) any order under sub-section (1) of section 41 ;
 5 (p) any order directing an endorsement of a patent with the words 'licences of Right' under section 42 ;
 (q) any decision or order under clause (a) or clause (b) of sub-section (1) of section 43 ;
 (r) any order under sub-section (1) of section 45 ;
 10 (s) any direction under sub-section (1) or sub-section (2) of section 51 ;
 (t) any order or decision under sub-section (1) or sub-section (2) of section 69.

(2) Every appeal under this section shall be in writing and shall be made within three months from the date of the direction, decision or order, as the case may be, of the Controller.

(3) In calculating the said period of three months the time, if any, occupied in granting a copy of the direction, decision or order appealed against shall be excluded.

20 **88. Procedure for hearing of appeals.**—(1) When an appeal has been preferred to a High Court under section 87, it shall be heard by a Bench of not less than two Judges.

(2) The Bench hearing the appeal may, if it thinks fit, and shall, on the request of the parties to the appeal, call in the aid of an assessor specially qualified for the purpose, and hear the appeal wholly or partially with his assistance.

(3) The remuneration, if any, to be paid to an assessor under this section shall in every case be determined by the High Court and he paid as part of the expenses of the execution of this Act.

30 (4) Save as otherwise provided in this section, the High Court may make rules consistent with this Act as to the procedure to be followed in respect of appeals made to it under section 87.

CHAPTER XIX

PENALTIES

89. Contravention of secrecy provisions relating to certain inventions.—

35 If any person fails to comply with any direction given under section 28 or makes or causes to be made an application for the grant of a patent in contravention of that section, he shall be punishable with imprisonment which may extend to two years, or with fine which may extend to one thousand rupees, or with both.

40 **90. Practice by non-registered patent agents.**—Any person who contravenes the provisions of section 76 shall be punishable with fine not exceeding two hundred rupees in the case of a first offence and five hundred rupees in the case of a second or subsequent offence.

45 **91. Falsification of entries in register.**—If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in such a register, or produces

or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be punishable with imprisonment which may extend to six months, or with fine which may extend to one thousand rupees, or with both.

92. Unauthorized claim of patent rights.—If any person falsely represents that any article sold by him is a patented article, he shall be punishable with imprisonment which may extend to six months, or with fine which may extend to one thousand rupees, or with both.

93. Wrongful use of words "Patent Office".—If any person uses on his place of business or on any document issued by him, or otherwise, the words "Patent Office" or any other words suggesting that his place of business is, or is officially connected with, the Patent Office, he shall be punishable with fine which may extend to one thousand rupees, and, in the case of a continuing offence, with a further fine of fifty rupees for each day on which the offence is continued after conviction therefor.

94. Refusal or failure to supply information.—Any person who refuses or fails to furnish to the Controller any information or statement which he is required to furnish under section 105 or furnishes such information or statement which is false or which he either knows or has reason to believe to be false or does not believe to be true, shall be punishable with imprisonment which may extend to six months, or with fine which may extend to one thousand rupees, or with both.

95. Contravention of provisions of section 98 by officers and employees of the Patent Office.—Any officer or employee of the Patent Office who contravenes the provisions of section 98 shall be punishable with imprisonment which may extend to six months, or with fine which may extend to two hundred rupees, or with both.

96. Offences by Companies.—(1) If the person committing an offence under this Act is a company, every person who, at the time the offence was committed, was in charge of, or was responsible to, the company, for the conduct of the business of the company, as well as the company shall be deemed to be guilty of the offence and shall be liable to be proceeded against and punished accordingly :

Provided that nothing contained in this sub-section shall render any such person liable to any punishment provided in this Act if he proves that the offence was committed without his knowledge or that he exercised due diligence to prevent the commission of such an offence.

(2) Notwithstanding anything contained in sub-section (1), where an offence under this Act has been committed by a company, and it is proved that the offence was committed with the consent or connivance of, or is attributable to any negligence on the part of any director, manager, secretary or other officer of the company, such director, manager, secretary or other officer shall also be deemed to be guilty of that offence and shall be liable to be proceeded with and punished accordingly.

Explanation.—For the purposes of this section—

(a) 'company' means any body corporate and includes a firm or other association of persons, and

(b) 'director' in relation to a firm means a partner in the firm.

CHAPTER XX

MISCELLANEOUS

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

98. Officers and employees not to furnish information, etc.—An officer or employee in the Patent Office shall not, except when required or authorised by this Act, or under a direction in writing of the Central Government or the Controller or by order of a court—

(a) furnish information on a matter which is being, or has been, dealt with under this Act or under the Indian Patents and Designs Act, 1911 (II of 1911); or

(b) prepare or assist in the preparation of a document required or permitted by or under this Act or under the Indian Patents and Designs Act 1911 (II of 1911), to be lodged in the Patent Office; or

(c) conduct a search in the records of the Patent Office.

99. Avoidance of certain restrictive conditions.—(1) Subject to the provisions of this section, any condition of a contract for the sale or lease of a patented article or of an article made by a patented process or for licence to use or work a patented article or process, or relating to any such sale, lease or licence, shall be void in so far as it purports—

(a) to require the purchaser, lessee or licensee to acquire from the vendor, lessor or licensor, or his nominees, or prohibit him from acquiring from any specified person or from acquiring except from the vendor, lessor or licensor, or his nominees, any articles other than the patented article or an article made by the patented process;

(b) to prohibit the purchaser, lessee or licensee from using articles (whether patented or not) which are not supplied by, or any patented process which does not belong to, the vendor, lessor or licensor, or his nominees or to restrict the right of the purchaser, lessee or licensee to use any such articles or process.

(2) In proceedings against any person for infringement of a patent, it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent made by or with the consent of the plaintiff and containing a condition void by virtue of this section.

(3) A condition of a contract shall not be void by virtue of this section, if—

(a) at the time of the making of the contract the vendor, lessor or licensor was willing to sell or lease the article or grant a licence to use or work the article or process as the case may be, to the purchaser, lessee or licensee on reasonable terms specified in the contract and without any such condition as is mentioned in sub-section (1) of this section; and

(b) the purchaser, lessee or licensee is entitled under the contract to relieve himself of his liability to observe the condition upon giving to the other party three months' notice in writing and subject to

payment to him of such compensation (being in the case of a purchase a lump sum, and in the case of a lease or licence a rent or royalty for the residue of the term of the contract) as may be determined by an arbitrator appointed by the Central Government.

(4) If in any proceeding it is alleged that any condition of a contract is void by virtue of this section, it shall lie on the vendor, lessor or licensor to prove the matters set out in clause (a) of sub-section (3). 5

(5) A condition of a contract shall not be void by virtue of this section by reason only that it prohibits any person from selling goods other than those supplied by a specified person, or, in the case of a contract for the lease of or licence to use a patented article, that it reserves to the lessor or licensor or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair. 10

100. 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, so however that the fees prescribed in respect of the instruments and matters mentioned in the First Schedule shall not exceed those therein specified. 15

(2) A proceeding in respect of which a fee is payable under this Act or the rules made thereunder shall be of no effect unless the fee has been paid. 20

101. Privilege of reports of Controller.—(1) Reports of or to the Controller made under this Act shall not in any case be published or be open to public inspection: 25

Provided that the Controller may on application made in the prescribed manner by any person disclose the result of any search made under section 12 in respect of any application for patent where the complete specification has been published.

102. Restriction upon publication of specification.—Subject to the provisions of sub-section (3) of section 82 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 or be open to public inspection at any time before the date of advertisement of acceptance of the application. 30 35

103. Publication of patented inventions.—The Controller shall issue periodically a publication of patented inventions containing such information as the Central Government may direct.

104. Powers of Controller to correct clerical errors.—The Controller may, on request in writing accompanied by the prescribed fee,— 40

(a) correct any clerical error in or in connection with an application for a patent or in any patent or any specification,

(b) correct any clerical error in the name or address of the proprietor of any patent or in any other matter which is entered upon the register of Patents. 45

105. Power of Controller to call for information from patentee.—The Controller may, at any time during the continuance of the patent by notice in writing require a patentee or an exclusive licensee to furnish to

him within two months from the date of such notice or within such further time as the Controller may allow, such information and such periodical statements as to the extent to which the patent has been commercially worked in India, as may be specified in the notice.

5 **106. Service of notices, etc., by post.**—Any notice required or authorised to be given by or under this Act, and any application or other document so authorised or required to be made or filed, may be given, made or filed by post.

10 **107. Declaration by infant, lunatic, etc.**—(1) If any person is, by reason of infancy or other disability, incapable of making any statement or doing anything required or permitted by or under this Act, the lawful guardian, committee or manager (if any) of the person subject to the disability, or if there be none, any person appointed by any court possessing jurisdiction in respect of his property, may make such statement or a statement as
15 nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making
20 of the statement or the doing of the thing.

108. Security for costs.—Where a person giving notice of any opposition under this Act or filing an appeal to a High Court from any direction, decision or order of the Controller under this Act, neither resides
25 nor carries on business in India, the Controller or the High Court, as the case may be, may require such person to give security for the payment of all costs incurred and likely to be incurred in the proceedings or appeal, as the case may be, and, in default of such security being given, may disallow the opposition or dismiss the appeal.

109. Transmission of copies of specification, etc., and inspection thereof.
30 —Copies of all such specifications, drawings and amendments left at the Patent Office, as become open to public inspection under the provisions of this Act, shall be transmitted, as soon as may be, after the printed copies thereof are available, to such authorities as the Central Government may appoint in this behalf, and shall be open to the inspection of any
35 person at all reasonable times at places to be appointed by those authorities and approved by the Central Government.

110. Information relating to patents.—A person making a request to the Controller in the prescribed manner as respects any patent specified in the request or as respects any application for a patent so specified, for
40 information to be furnished to him by the Controller of any such matters as may be prescribed affecting that patent or application, shall be entitled, subject to the payment of the prescribed fee, to have information supplied to him accordingly.

111. Loss or destruction of patent.—If a patent is lost or destroyed, or
45 its non-production is accounted for to the satisfaction of the Controller, the Controller may at any time, on payment of the prescribed fee, seal a duplicate thereof.

112. Models to be furnished to Indian Museum.—The trustees of the Indian Museum may at any time require a patentee to furnish them with
50 a model or sample of his invention on payment to the patentee of the cost

of the manufacture of the model or sample, the amount to be settled, in case of dispute, by the Central Government.

118. Power to make rules.—(1) The Central Government may, by notification in the Official Gazette, make rules for carrying out the purposes of this Act. 5

(2) Without prejudice to the generality of the foregoing power, the Central Government may make rules to provide for all or any of the following matters, namely:—

- (a) the establishment of branches of the Patent Office;
- (b) the form of applications for patents and of any specifications, drawings and other documents which may be filed at the Patent Office and for requiring copies to be furnished of any such documents; 10
- (c) the manner in which any application for a patent or any other documents may be filed at the Patent Office;
- (d) the time within which any act or thing may be done under this Act; 15
- (e) the fees which may be payable under this Act and the manner of payment of such fees;
- (f) the matters in respect of which the Examiner may make a report to the Controller; 20
- (g) the manner in which and the time within which any matter may be advertised under this Act;
- (h) the provisions which may be inserted in an order for restoration of a patent or lapsed application for a patent for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had ceased; 25
- (i) the form of a request for the sealing of a patent;
- (j) the form of the manner in which and the time within which any notice may be given under this Act;
- (k) the matters in respect of which the Controller shall have powers of a civil court; 30
- (l) the qualifications of patent agents and the keeping of a register of patent agents, the removal from the register of patent agents of the name of any person registered thereunder or the suspension of the right of any such person to act as a patent agent; 35
- (m) the conditions subject to which any act may be done by a patent agent on behalf of his principal;
- (n) the manner in which an application may be signed and verified under this Act;
- (o) the procedure to be followed in connection with any application or request to the Controller or in connection with any proceeding before the Controller and for authorising the rectification of irregularities of procedure; 40
- (p) the authorising of publication and sale of copies of specifications, drawings and other documents in the Patent Office, and of indexes or abridgement of such documents; 45

(g) the ensuring of secrecy with respect to patents to which section 23 applies;

5 (r) the regulation of business of the Patent Office and of all things by this Act placed under the direction or control of the Controller.

(3) The power to make rules under this section shall be subject to the condition of the rules being made after previous publication:

Provided that nothing in this sub-section shall apply in the case of rules made for the purpose specified in clause (g) of sub-section (2).

10

114. Special provisions relating to certain patents.—For the removal of doubts, it is hereby declared that—

15

(i) any patent granted before the relevant date in any of the merged territories or in any Indian State, or a Part B State or part thereof, under any law then in force in such merged territory, State or part shall have effect and shall be deemed always to have had effect in that merged territory, State or part only;

20

(ii) any patent granted before the 18th day of April, 1950 under the Indian Patents and Designs Act, 1911 (II of 1911), shall have effect and shall be deemed always to have had effect in those territories only to which the said Act applied at the date of the grant of the patent.

Explanation.—The expression 'relevant date' means—

(a) in relation to a merged territory, the 1st day of January, 1950; and

25

(b) in relation to an Indian State, or a Part B State or part thereof, the 18th day of April, 1950.

30

115. Repeal, saving and transitional provisions.—(1) The Indian Patents and Designs Act, 1911 (II of 1911), in so far as it relates to patents, is hereby repealed, and on the commencement of this Act the said Act shall be amended as indicated in the Second Schedule.

(2) Without prejudice to the provisions contained in the General Clauses Act, 1897 (X of 1897), with respect to repeals,—

35

(a) any notification, rule, order, requirement, certificate, notice, decision, direction, authorisation, consent, application, request or thing made, issued, given or done under the Indian Patents and Designs Act, 1911 (II of 1911) shall, if in force at the commencement of this Act, and in so far as it could have been made, issued, given or done under this Act, continue in force and have effect as if made, issued, given or done under the corresponding provisions of this Act;

40

(b) notwithstanding anything in sub-section (1) of section 8 of this Act, a complete specification shall not be filed in pursuance of an application which by virtue of section 4A of the Indian Patents and Designs Act, 1911 (II of 1911) was deemed to be abandoned at any time before the commencement of this Act;

45

(c) where two or more persons are registered as grantee or proprietor in respect of a patent which was granted or for which the application was made before the commencement of this Act, the right of each of those persons to assign the whole or part of the

interest in the patent shall not be restricted by reason only of the provisions of section 50 of this Act;

(d) a condition of any contract in force immediately before the commencement of this Act shall not be invalidated by reason only of the provisions of section 99 of this Act; 5

(e) the provisions of section 9 of the Indian Patents and Designs Act, 1911 (II of 1911) shall continue to apply in relation to any proceedings pending under that section at the commencement of this Act;

(f) the provisions of section 21A of the Indian Patents and Designs Act, 1911 (II of 1911) and of any rules made thereunder shall continue to apply in relation to any patent granted before the commencement of this Act in pursuance of that section; 10

(g) sub-section (1) of section 25 and sub-section (1) of section 29 of this Act shall not apply to any patent granted before the commencement of this Act; 15

(h) sub-section (1) of section 31 of this Act shall apply in relation to any application made before the commencement of this Act as it applies in relation to an application made after the commencement of this Act;

(i) sub-sections (2) and (3) of section 58 of this Act shall not apply in relation to any infringement of a patent committed before the commencement of this Act; 20

(j) in relation to a patent granted before the commencement of this Act the renewal fees shall be those specified in the Schedule to the Indian Patents and Designs Act, 1911 (II of 1911). 25

(3) Save as otherwise provided in sub-section (2), the provisions of this Act shall apply to any application for a patent pending at the commencement of this Act and to any proceedings consequent thereon and to any patent granted in pursuance thereof.

(4) References in this Act to the Indian Patents and Designs Act, 1911 (II of 1911) are references to that Act as in force immediately before the commencement of this Act. 30

THE FIRST SCHEDULE

[See section 100]

35

Fees

	Rs.	
On application for a patent accompanied by provisional specification	20	
On filing complete specification after provisional specification	30	
On application for a patent accompanied by complete specification	50	
For sealing a patent	30	40
Before the expiration of the 4th year from the date of the patent	50	
Before the expiration of the 5th year from the date of the patent	50	
Before the expiration of the 6th year from the date of the patent	50	
Before the expiration of the 7th year from the date of the patent	50	

	Before the expiration of the 8th year from the date of the patent	100
	Before the expiration of the 9th year from the date of the patent	100
	Before the expiration of the 10th year from the date of the patent	125
	Before the expiration of the 11th year from the date of the patent	125
5	Before the expiration of the 12th year from the date of the patent	150
	Before the expiration of the 13th year from the date of the patent	150
	Before the expiration of the 14th year from the date of the patent	175
	Before the expiration of the 15th year from the date of the patent	175
	Provided that the fees for two or more years may be paid in advance	
10	On application to extend the term of a patent	50
	In respect of each year of the extended term of a patent granted under section 30.	200

THE SECOND SCHEDULE

[See section 115(1)]

- 15 *Amendments to the Indian Patents and Designs Act, 1911.*
1. In the long title and the preamble, the words 'Inventions and' and the words 'inventions and' shall, respectively, be omitted.
 2. In section 1, in sub-section (1), the words 'Indian Patents and' shall be omitted.
 - 20 3. In section 2,—
 - (a) clause (1) shall be omitted;
 - (b) in clause (2), the words and brackets '(as respects designs)' shall be omitted;
 - (c) in clause (3), for the words 'appointed under this Act' the words and figures 'appointed under the Patents Act 1958' shall be substituted;
 - 25 (d) clauses (6), (8), (10), (11) and (12) shall be omitted.
 4. Part I shall be omitted.
 5. In section 51B, for the words and figures 'The provisions of section 21', the words and figures 'The provisions of Chapter XI of the Patents Act, 1958', shall be substituted.
 - 30 6. In section 54, for the words 'The provisions of this Act', the words and figures 'The provisions of the Patents Act, 1958' shall be substituted.
 7. In section 57, in sub-section (1), the words 'the grant of patents and' and 'patents and' shall be omitted.
 - 35 8. Section 59A shall be omitted.
 9. In section 61, sub-section (1) shall be omitted.
 10. In section 62,—
 - (a) clause (a) shall be omitted;
 - (b) in clause (c), the words 'any patent or' and 'the register of patents or' shall be omitted.

11. In section 63,—

(a) in sub-section (1), the words 'to a patent or' and 'patent or', shall be omitted;

(b) in sub-section (2),—

(i) the words 'patent or' shall be omitted;

(ii) for the words 'patents or designs, as the case may be' the word 'designs' shall be substituted;

(c) in sub-section (3), the words 'patent or', wherever they occur, shall be omitted;

(d) in sub-section (4), the words 'patent or to' shall be omitted.

12. In section 64,—

(a) in sub-section (1)—

(i) the words 'patents or' shall be omitted;

(ii) the word 'either' wherever it occurs shall be omitted;

(b) in sub-section (5), clause (a) shall be omitted.

13. Section 66 shall be omitted.

14. In section 67, the words 'for a patent, or for amendment of an application or of a specification, or' shall be omitted.

15. In section 69, in sub-section (1), the words 'grant a patent for an invention or to' shall be omitted.

16. In section 71A, the words 'or from patents, specifications and other' shall be omitted.

17. Section 72 shall be omitted.

18. For section 74A, the following section shall be substituted, namely:—

"74A. *Security for costs.*—Where a person giving notice to the Court of appeal from any decision of the Controller under this Act, neither resides nor carries on business in India, the Court may require such person to give security for the payment of all costs incurred and likely to be incurred in the appeal and in default of such security being given may dismiss the appeal."

19. Section 75 shall be omitted.

20. In section 76,—

(a) in sub-section (1), the word 'other' shall be omitted;

(b) in clause (c) of sub-section (2), the word 'opponent' shall be omitted.

21. In section 77,—

(a) in sub-section (1),—

(i) in clause (c), the word 'specification,' shall be omitted;

(ii) clause (d) shall be omitted;

(iii) in clause (e), the words 'specifications and other' shall be omitted;

(iv) clause (ese) shall be omitted;

(b) sub-section (2A) shall be omitted.

5 22. In section 78A,—

(a) in sub-section (1),—

(i) the words 'invention or' and 'the patent that may be granted to him under this Act, for the said invention or' shall be omitted;

10 (ii) for the proviso, the following proviso shall be substituted, namely:—

“Provided that—

(a) the application is made within six months from the application for protection in the United Kingdom; and

15 (b) nothing in this section shall entitle the proprietor of the design to recover damages for infringement happening prior to the actual date on which the design is registered in India.”;

(b) in sub-section (2),—

20 (i) the words 'The patent granted for an invention or' shall be omitted;

(ii) clause (a) shall be omitted; and

(iii) in clause (b), the words 'in the case of a design' shall be omitted;

25 (c) in sub-section (3),—

(i) the words 'the grant of a patent or' shall be omitted; and

(ii) the proviso shall be omitted;

(d) in sub-section (4), the words 'inventions or' and 'patented or' wherever they occur shall be omitted.

30 23. In section 80, in the proviso, the words 'patent, permit or licence granted or' shall be omitted.

24. For the Schedule, the following Schedule shall be substituted, namely:—

“THE SCHEDULE

35 [See section 57]

Fees

On application for registration of a design ... Rs. 8/-.-”

STATEMENT OF OBJECTS AND REASONS.

The Indian Patents and Designs Act, 1911 was enacted at a time when India had not developed industrially. The experience of the working of this Act coupled with the progress of industrial development in the country indicated clearly the need for a more comprehensive legislation so as to ensure that patent rights are not abused to the detriment of the consumer or to the prejudice of the trade or of the industrial development of the country. A Committee known as the Patents Enquiry Committee was appointed by the Government of India in 1948 to review the working of the patent system and this Committee submitted an interim report which was confined mainly to the provisions relating to the monopoly rights conferred by patents. The Indian Patents and Designs (Amendment) Act, 1950 was enacted to give effect to the main recommendations in that report and since then some further *ad hoc* amendments have been carried out from time to time to incorporate changes which were considered to be of a very urgent nature. The final report of the Patents Enquiry Committee was submitted in 1950. The object of this Bill is to give effect to such of the recommendations of the final report of the Patents Enquiry Committee as have been accepted by Government. Opportunity has also been taken to make certain other improvements in the patent law.

The provisions of the Bill which make a change in the existing law are explained in the Notes on Clauses.

T. T. KRISHNAMACHARI.

NEW DELHI;

The 24th November, 1953.

Notes on Clauses

Clause 2.—The definitions of 'invention' and 'manufacture' have been amplified. The definitions of certain new terms which are used in the Bill have been added.

Clause 3.—This clause specifies what is not 'patentable' and is based upon judicial decisions on the subject.

Clause 8.—The proviso to sub-clause (1) extends the maximum period of ten months to twelve months during which a complete specification may be filed after the provisional specification.

Clause 10.—This clause lays down the criterion for determining the novelty or priority date of an invention and stipulates that the priority date of a claim in a complete specification should be determined on the basis of the disclosure contained in a complete or a foreign specification on which the particular claim in the complete specification may be based.

Clause 12.—The existing Act does not contain any specific provision requiring the Controller to make a compulsory search for ascertaining the novelty of an invention before its "acceptance". This clause makes it obligatory for compulsory searches to be made by the Patent Office in respect of all patent applications. Such a measure, it is considered, would enhance the commercial value attached to an Indian patent.

Clause 21.—This clause omits the provision in the existing Act (section 9) permitting opposition proceedings before the sealing of a patent. In its place a provision has been inserted under which it will be open to any person to file a statement of objections before the Controller of Patents and Designs within four months from the date of advertisement of the acceptance of the application in the Official Gazette. The objections would be considered by the Controller along with the Examiner's report before sealing the patent. Experience has shown that opposition proceedings in the past have proved frivolous and obstructive. They have also caused serious delays and substantial loss to the effective term of a patent.

Clause 22.—This clause makes it obligatory that the name of the first inventor shall be mentioned in the patent specification as also in the patent to be granted. The object of this clause is to recognise the right of the inventor to be associated with his invention.

Clause 23.—This clause replaces the provisions of section 21A of the existing Act which are somewhat rigid. The revised clause enables the Controller to enforce secrecy in respect of patent applications which may be relevant for defence purposes.

Clause 30.—At present petitions for extension of the term of a patent lie to the Central Government. Under this clause such petitions will have to be made to the Controller of Patents.

Clause 33.—This clause authorises the Controller of Patents to restore a lapsed application for a patent on which a patent could not be sealed within the prescribed time due to an unintentional delay or omission on the part of the applicant.

Clause 37.—The Controller is empowered to entertain applications for revocation of a patent which power at present vests in the High Courts only. An order of the Controller under this clause will, however, be subject to an appeal to the High Court.

Clause 50.—The expression 'joint tenants' which in this context is foreign to the Indian law is being omitted. The rules of law applicable in this country to the ownership and devolution of movable property are being applied to patents.

Clause 51.—This clause empowers the Controller of Patents to give directions to joint patentees with regard to the sale, lease or grant of licences on patents, particularly in the event of a dispute arising between them in regard to their mutual rights.

Clauses 52 to 56.—The provisions of these clauses replace the provisions of section 21 of the existing Act. Under section 21, the Central Government alone can use a patent for the purposes of the Union. This privilege is now being extended to the State Governments.

Clause 57.—This clause enables a person who has a reasonable cause to doubt whether the intended manufacture or use of an article would constitute an infringement of an existing patent to file a declaratory suit. Such a declaratory suit at the initial stage would protect persons who act *bona-fide* and would avoid unnecessary and prolonged litigation later which otherwise may become inevitable. A provision like this would also be beneficial to industrialists and would help in promoting the industrialisation of the country.

Clause 58.—This clause confers upon an 'exclusive licensee' the right to institute a suit for infringement of a patent which at present is enjoyed by a patentee only.

Clauses 74 to 78.—This is a new Chapter and provides for statutory control over the profession of patent agents. A patent agent will now be required to register himself under the Act and he will also have to pass a qualifying examination before he becomes eligible for such registration.

Clauses 79 to 86.—This Chapter deals with international agreements regarding reciprocal arrangements with foreign countries for the mutual protection of inventions. These clauses replace the provisions of the existing section 76A which outlines the present reciprocal arrangements existing between India, the United Kingdom, and other British Commonwealth countries.

Clause 87.—This clause provides for appeals. Under the existing Act appeals in a large majority of cases lie to the Central Government. Under the Bill, all appeals will lie to a High Court.

Clauses 89 to 96.—These clauses provide penalties in respect of certain offences. Under the existing Act, the only penalty provided is in respect of the wrongful use of the words 'Patent Office'.

Clause 97.—This is a new clause which disqualifies the employees of the Patent Office from acquiring any interest in a patent, except by inheritance or bequest.

Clause 98.—This is also a new clause which enjoins upon employees of the Patent Office to observe secrecy in respect of confidential information and documents to which they may have access in the discharge of their duties. A contravention of the provisions of this clause is made a penal offence.

Clause 99.—This clause is intended to remove the malpractices adopted in the trade regarding licences, contracts for sale, leases etc. in respect of patents and declares that all such instruments shall be void and unenforceable whenever they tend to impose restrictions with regard to purchase of articles other than patented articles.

Clause 101.—This clause is based on section 60 of the existing Act with the only difference that it permits the Controller of Patents to disclose, in his discretion, the result of investigations made in connection with the examination of patent specifications to the applicant. Such a provision, it is considered, would be beneficial to the inventors as it would enable them to know the extent of the prior art cited against their applications.

Clause 102.—This clause requires the Controller of Patents to treat all applications for patents confidential before their acceptance.

Clause 105.—This clause enables the Controller of Patents to call for periodical reports from patentees regarding the commercial working of their patents in India.

The First Schedule.—The existing fees are being slightly enhanced.

The Second Schedule.—This Schedule omits from the existing Act all provisions relating to patents and that Act will now contain provisions relating to designs only.

FINANCIAL MEMORANDUM

A Patent Office already exists at Calcutta to administer the Indian Patents and Designs Act, 1911, but it will need to be considerably strengthened in order to cope with the additional functions contemplated under the new Bill for amending the Law relating to Patents. For example the office will have to keep a close watch over the commercial exploitation of Patents and also to exercise control over the profession of Patent Agents. The Controller of Patents and Designs will also have considerably enlarged powers of trying suits relating to Patents.

2. Two new wings each under a Deputy Controller with Examiners and ministerial staff will have to be added to the Patent Office. The additional expenditure involved is estimated to be Rs. 1·10 lakhs per year but this will be more than balanced by the increased recovery of Rs. 1·50 lakhs per year from the enhanced rates of fees prescribed in the new Bill.

HOUSE OF THE PEOPLE

A
BILL

to amend and consolidate the law relating to Patents.

The President has, in pursuance of clause (3) of article 117 of the Constitution of India, recommended to the House of the People the consideration of the Bi

M. N. KAUL,
Secretary.

(*Shri T. T. Krishnamachari,*
Minister for Commerce and Industry)
