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Pre/Post Grant Issues in Patenting 3

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''शिक्षा मानव को बन्धनों से मुक्त करती है और आज के युग में तो यह लोकतंत्र की भावना का आधार भी है। जन्म तथा अन्य कारणों से उत्पन्न जाति एवं वर्गगत विषमताओं को दूर करते हुए मनुष्य को इन सबसे ऊपर उठाती है।''

-इन्दिरा गांधी

" Education is a liberating force, and in our age it is also a democratising force, cutting across the barriers of caste and class, smoothing out inequalities imposed by birth and other circumstances"

- Indira Gandhi

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Block

3

PRE/POST GRANT ISSUES IN PATENTING

UNIT 9
Infringement of Patent 5

UNIT 10
Filing Opposition-Pre/Post Grant Issues 18

UNIT 11
Grounds of Defence 34

UNIT 12
Intellectual Property Appellate Board 49

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BLOCK 3 PRE/POST GRANT ISSUES IN PATENTING

In the previous block, you have studied patent filing and commercialization. The Block is dedicated to the pre/post grant issues in patenting. This block comprises of four units.

Unit 9 deals with infringement of patents which include acts which constitute infringement of the patent rights. It further deals with exceptions of infringement, types of infringement and the remedies available in case of infringement. It also deals pre and post grant issues of filing.

Unit 10 discusses issues necessary for filing opposition, which includes pre grant opposition and post grant opposition.

Unit 11 deals elaborately with the defenses available under the provisions of Patent Act 1970 against any suit for infringement. It includes the revolution grounds, Gillette defense and the remedies available to the exponent.

Unit 12 deals elaborately with the Intellectual Property Appellate Board and its salient features.

UNIT 9 INFRINGEMENT OF PATENT

Structure

9.1 Introduction

9.2 Objectives

9.3 Infringement: Its Meaning

9.4 Exceptions to Infringement

9.5 Types of Infringement

- 9.5.1 Deliberate Infringement
- 9.5.2 Deliberate with Minor Modifications
- 9.5.3 Indirect Infringement
- 9.5.4 Contributory Infringement
- 9.5.5 Accidental Infringement
- 9.5.6 Innocent Infringement

9.6 Determination of Infringement

- 9.6.1 Doctrine of Colorable Variations
- 9.6.2 Doctrine of Pith and Marrow
- 9.6.3 Doctrine of Equivalents

9.7 Burden of Proof

9.8 Jurisdiction of Suit for Infringement

9.9 Time for Filing the Suit

- 9.9.1 Who can File the Suit
- 9.9.2 Who can be Sued

9.10 Summary

9.11 Terminal Questions

9.12 Answers and Hints

9.13 References and Suggested Readings

9.1 INTRODUCTION

It may be recalled that the grant of patent confers upon the patentee certain exclusive rights. By virtue of these rights he can recover the cost incurred in the research and in securing these rights and therefore can make profits either by licensing the patented invention to third party on the payment of royalty or manufacturing and selling the patented products in the markets. If somebody exploits these rights without authorization, this leads to violation of these rights and such violation is known as infringement. The term "infringement" in general sense connotes the encroachment upon the legal rights granted under the statute. When boundaries of the real estate property are invaded by an unauthorized person, the act of invasion is known as trespassing. Similarly when the legal boundary of patent rights, which are defined by the claims of the invention, are trespassed or invaded by the unauthorized person without any authorization of the patentee, is

called "infringement" of patent. However, unlike the trespass, the infringement is a statutory wrong. The Patents, Act, 1970, although does not define the term" infringement", it has been defined under the provisions of section 60 of U.K. Patents Act, 1977 and Article 271 of US Code 35(US Patent law).According to US Law, "whoever, without authority, makes, uses or sells any patented invention, within the United States during the term of patent therefore, infringes the patent". Similarly, section 60 of the U.K. Patent Act, 1977 defines the infringement, according to which, a person infringes a patent for an invention, while patent is in force if, does any act as enumerated therein within the United Kingdom in relation to the patented invention without the consent of the proprietor of the patent subject to certain provisions of the law. So the question is what amounts to an infringement under the provision of the Patents, Act 1970?

9.2 OBJECTIVES

After reading this unit, you should be able to:

- describe what infringement means;
- explain the exceptions to infringement;
- discuss the different types of infringement;
- determine the different issues of infringement;
- be well acquainted with the fact where the jurisdiction would be in case of a suit of infringement; and
- describe who could file a suit and the time for filing a suit.

9.3 INFRINGEMENT: ITS MEANING

As mentioned above, as there is no definition of the term "infringement" in the Patents, Act 1970, it can be ascertained from the scope of the exclusive rights granted and by the act of third party who has invaded the patents rights conferred upon the patentee by the patent law. Under the Indian law, the rights of the patentee are provided under section 48, which provides, that patent granted, shall confer upon the patent, the exclusive rights to prevent third parties who do not have his consent, from the act of making, using, offering for sale, selling, or importing for those purposes that products in India in case where the subject matter of the patent is a product. In case, the subject matter of patent is process, the exclusive right to prevent third parties, who do not have his consent the act of using that process and the act of using, offering for sale, selling or importing for those purposes the product obtained from that process in India. However these rights are not absolute rights and therefore they are subject to certain conditions and act of infringement will be considered in the background of these conditions. Nevertheless, in general, any violation of these rights by third party without the consent of the patentee is known as infringement of patent. In **Bristol-Mayers Company application [1975 RPC,127 at page 153]**, it was held that the rights of a patentee are infringed by anyone who makes or supplies that substance commercially for use by others even though he does not know that it is that substance he is making or supplying. In essence, what the law of patents is about is stopping people from using patented things without authorization. Similarly, it was also held **[Steers vs. Roger]** that, the truth is that letters patent

do not give the patentee any right to use patent but confers the right to excludes others from exploiting of or using the particular invention. Therefore in case of infringement it is not important on the part of plaintiff to prove that he has suffered commercial loss but to prove that his exclusive rights conferred upon by patent have been infringed by the respondent. The importation of patented drug in bulk and exporting thereof after tableting, was held infringement as patentee also has right to import under patent monopoly.(Smith Kline vs. D.D.S.A. Pharmaceuticals [1978]FSR109). Similarly in **Becham Group vs. Bristol Laboratories** , a claim to a semi-synthetic penicillin was held infringed by importation and sale of a chemical substance which did not have the claimed formula but which would have nevertheless be converted in the human blood stream into the claimed substance.

9.4 EXCEPTIONS TO INFRINGEMENT

It may be noted again that the patent rights are not absolute rights as they are subject to certain conditions. Therefore, there are certain acts which are not considered an infringement under the provisions of the Act, although the patented invention has been used without any authorization from patentee. The following acts are exempted from being considered as infringements under various provisions of the Act.

a) Importation or manufacturing of any apparatus or machine or other articles in respect of which the patent is granted or any article made by using a patented process, by the government or by a person on behalf of the government for the purpose of its own use [Sec.47].

b) Use of any patented process by or on behalf of the government for the purpose of its own use [Sec.47].

c) Use of any patented product or machine or article and any patented process for the manufacturing of said product, by any person for the purpose merely of experiments or research including the imparting of instructions to pupils in the educational institutions, [Sec.47].

d) Importation of patented medicine or drug by the government for the purpose of its own use or the purpose of distribution in any dispensary, hospital or any other medical institution maintained by or on behalf of the government or any dispensary , hospital or medical institutions notified by the central government having regard to public service rendered by them[Sec.47].

e) The use of the patented invention on board a vessel or aircraft of foreign country which comes temporarily or accidentally to India including the territorial waters in transit, will not infringe the rights of the patentee. However such exemption will not apply to the national of those countries which do not confer corresponding rights to person ordinarily resident in India [Sec.49].

f) The use of patent invention between the date on which patent ceased to have effect due to failure to pay the renewal fee or otherwise and the date of publication of application for restoration of patent[Sec.62 (2)].

g) The use of patent invention before the actual date on which patent was granted to true and first inventor where such patent was obtained by another person, wrongfully or in fraud of him [Sec.52 (3)].

h) Importation of patented products by any person from any person authorized under the law to produce and sell or distribute the patent products [Sec.107 A (a)].

i) Manufacturing, selling, using or importation of the patented invention solely for uses reasonably related to the development and submission of the information required under any law for time being in force in India that regulates the manufacturing, selling or importing any product [Sec.107 A (b).

j) Use of the patented invention by the Government or by any person authorized by the Government for its own use in public interest under the Act [Sec. 100-102].

k) When an enterprise has made significant investment and is manufacturing and marketing the pharmaceutical product which was patented by patentee after 1st January 2005 but the application for patent was filed on or after1st January 1995 in India[Sec.11A(7).

l) When patentee has exhausted is right [term is over or patented product sold].

9.5 TYPES OF INFRINGEMENT

There are several types of infringements which can take place. Some of them are given below.

9.5.1 Deliberate Infringement

Where third party or defendant has intentional disregard for patent rights held by patentee and has made no attempt to avoid the infringement. In other words the defendant did not make any effort to take any prior permission from the right holder for making the patented product or using the patented process. This is also known as **direct or willful** infringement. In such case, there is generally a straight copying of the patented invention. Under such situation good faith or ignorance is no defence.

9.5.2 Deliberate with Minor Modification to Hide

Where the third party has made some minor modifications over the patented invention in order to hide the direct infringement, although such modifications do not have any significance importance over the patented invention. This kind of infringements takes place frequently when either the patented product is out in the market for sale or the patented invention is published and then the third party try to modify the patented product in order to escape the infringement suit. This kind of infringement is most commonly occurring and has become the contention of litigation.

9.5.3 Indirect Infringement

Where a third party or defendant is actively encouraging another to make, use or sell the patented invention. Therefore, in such situation such a third party so inducing the person is liable for the indirect infringement.

9.5.4 Contributory Infringement

Where a third party or defendants are holding the patent rights for one of parts of the machine whereas patent rights for entire machine are held by another

person. Under such situation selling the entire machine by assembling the patented parts, would lead to contributory infringement. This kind of infringement mostly takes place in the spare parts of motor vehicles. However the manufacture of or sale of parts of a combination patent is not an infringement although such parts made for the purpose of making such combination provided such parts are not themselves of subject matter of patent.

9.5.5 Accidental Infringement

This is the situation where different people or research and development department working together at same time to solve some typical problem without knowing each other's work. In such situation one may arrive on the solution earlier than others and get his invention patented. Therefore patent holder might feel that his invention has been copied and infringed by others, although they have arrived on the similar solutions independently, probably by different route. This may be called as accidental infringement.

9.5.6 Innocent Infringement

In this case the third party or defendant infringes the patented invention either without the knowledge of existence of any valid patent for such invention or he has no sufficient means to know that there exist a valid patent for such invention. This kind of infringement may occur until the patent is granted but not published after the grant. Normally all the national offices are publishing details of the invention after the grant of patent. However, sometimes the patent holders, while selling the patented invention, do not mention the patent number on the products. This leads to insufficient notice to the public in general and third party in particular. This provides the cover to the defendant to take shelters as innocent infringer as most national legislations provide such kind of provisions. However, ignorance of existence of valid patent for a particular invention has no excuse if there are means to know about the existence of such patents.

Self Assessment Question **(Spend 2 minutes)**

1) What do you mean by direct or willful infringement?

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9.6 DETERMINATION OF INFRINGEMENT

The determination of infringement issues of any valid patented invention requires at least four questions to be decided, namely (1) what is the extent of monopoly right conferred by the patent. This has to be ascertained by a proper construction of the patent specification; (2) whether the alleged acts amount to making, using, exercising, selling or distributing or importing a product in case of product patent; or using or exercising a process in case of a process patent, (3) whether, what the alleged infringer is doing amounts to an infringement of the patent rights and whether such infringed act are done in the country where the patent is granted (India).

In order to ascertain the scope of the claims of the invention in the patent specification for which protection is sought for, the following guidelines were observed by Hon'ble High Court of Delhi in ***Raj Prakash v. Mangat Ram Choudhary***[AIR 1978 Del1, at p 9],while following the principles laid down in ***Farbwerke Hoechst Akt, etc v. Unichem Laboratories*** **[AIR1969 Bom255].**They are, namely (1) the main function of the court is to construe the claims which are alleged to have been infringed without reference to the body of the specifications; (2) the specifications to be referred only if there is any ambiguity or difficulty in the construction of the claims;(3) where the claim is wide enough to cover all methods for achieving particular results , the question is not as to the method actually followed by the plaintiff but is whether the method followed by the defendant is covered by the claim in plaintiff's patent;(4) the claim in the specification of patent need only be as clear as subject admits (5) the patentee need not so simplify his claim as to make it easy or convenient for infringer to evade it;(6) the patentee's duty is not to prevent all possible arguments as to whether there is an infringement or not in a particular case but to enable the court to formulate questions of facts to be answered;(7) the complete specifications must describe at least one embodiment of the invention in each of the claims (8) the description must be sufficient to enable those in the industry concerned to carry the invention into the effect without making further experimentation and (9) the description must be fair and unambiguous so that it must not be unnecessarily too difficult to follow.

It may be further noted that while considering the scope of the claims, not only the above guidelines are important but also it may be ascertained as to what are the essential integers of the claim , and then non essential features may be omitted or replaced by the equivalent integers so as to consider the infringing article. Then the essential features of the patented invention must be compared with the defendant's product or article. If the defendant's product or article or process falls within the scope of plaintiff's patented product or process, wherein all essential features have been found to have been covered or found, then there is an act of infringement.

While considering the infringement of patent, the courts generally follow the following principle while construing the scope of the claims as claimed in the specification.

i) Doctrine of colorable variations,

ii) Doctrine of pith and marrow, and

iii) Doctrine of equivalents.

9.6.1 Doctrine of Colorable Variations

This principle is applicable in those cases where the defendant has incorporated or adopted all the essential features of the patented invention of the plaintiff, while making the machine, article or product or the process and has made small variations or modifications in the non-essential features or added some features to differentiate from the patented invention, which have no substantial effect in fact, rather gives a color to suggest that he is not infringing the patented invention. These kinds of changes do not involve any inventive ingenuity.

9.6.2 Doctrine of Pith and Marrow

This principle is old and has more or less no application in the modern system of drafting and construction of the scope of claims where there are multiple claims. While applying the doctrine of pith and marrow, it has to be seen as to whether the infringing apparatus or article is substantially the same as the apparatus or article said to have been infringed. If the infringing article substantially has same essential features or integers as of patented article, then, the infringement has occurred and alleged infringer has infringed the right in pith and marrow as crux of the invention is in the essential integers and not in the nonessential integers which by me omitted or replaced by the equivalents. However, the courts are not bound to detect the absolute similarities between the infringing goods and infringed goods. The omission of or substitution for an unessential features, will not suffice to avoid the infringement. In one of the cases, where patent was for an expandable watch strip, which was made up of two sleeves connected by U shaped connecting bow. The defendant, while making the strap replaced the U shaped with C shaped bow. The court, while applying the doctrine of pith and marrow, held that the U shaped bows were essential integers the patented strip C shaped bows were essential integers in the defendant case. Since, the essential integers are different and hence there is no infringement of patented invention.

9.6.3 Doctrine of Equivalents

This doctrine is applicable when there are obvious equivalents for unessential integers which involve no inventive ingenuity in replacing or in omitting nonessential features with such equivalents. However, it is not applicable to the cases where there are some omissions or substitution for essential integers. In such case, one can not be held responsible for infringement.

In ***Marconi v. British Radio Telegraph***, was a case where the defendants substituted an electrical equivalent for what was held to inessential integer in the patented radiotelegraphy system and were held to have infringed the patent. ***In Unwin v. Heath***, it was observed that though the use of a chemical or mechanical substitute which is a known equivalent to the things pointed out by the specification and claimed as an invention, amounted to an infringement of the patent, yet, if the equivalents were not known to be so at the time of patent and specification, the use of it, would be no infringement. In this case there was ample evidence that to melt together oxide of manganese and carbonaceous matter with steel and iron would serve as an equivalent for the melting together of carburet of manganese with steel or iron in producing the desired results. But there was no evidence that at the time of the patent and specification, this was known to a person of ordinary skill in the chemistry **[Patent law by P. Narayanan, p 533]**.

Self Assessment Question **(Spend 3 minutes)**

2) When is doctorate of colorable variation applicable?

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9.7 BURDEN OF PROOF

In case of infringement suits, the plaintiff has the onus of establishing the fact that defendant has infringed his patent, while alleging the infringement. This is a general law of evidence. However in case of infringement relating to a patent for a process for obtaining a product, under the certain circumstances, the onus will be shifted to defendant to prove that he has used a different process to produce such a product which would have been otherwise produced by the patented process and he has not infringed the rights of the patentee or the plaintiff. This provision has already been incorporated in the Patents Act, under section 104A, which is given below.

104A(1)- In any suit for infringement of a patent, where the subject matter of patent is a process for obtaining a product, the court may direct the defendant to prove that the process used by him to obtain the product, identical to the product of the patented process, is different from the patented process if,-

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

(b) there is a substantial likelihood that the identical product is made by the process, and the patentee or a person deriving title or interest in the patent from him, has been unable through reasonable efforts to determine the process actually used, provided that the patentee or a person deriving title or interest in the patent from him first proves that the product is identical to the product directly obtained by the patented process.

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

Accordingly, as per the above mentioned provisions, a new product would be deemed to have been produced only by the patented process, in the absence of any contrary evidence. As a general principle of the law, burden of proving the infringement is on the plaintiff but the burden of proving particular facts such as a process of producing the same product which is in question, is on the defendant since such facts are within his knowledge. However the defendant is not under any obligation under the above law to disclose to court any precise method of manufacturing or manufacturing secrets or his commercial secrets in order to discharge his burden of proof.

Example: In ***British Thomson-Houston v. Charlesworth Peebles*** [1902, 19 RPC169], (reference quoted in the Patent law by P.Narayanan), evidence showed that the filaments contained in the infringing lamps could not have been manufactured by any other process than that of plaintiff. It was held that plaintiff had established a prima facie case of infringement, but that would not have been sufficient to entitle to a decree had the lamp been manufactured in United Kingdom. Since the lamps in question were manufactured abroad, this prima facie evidence was sufficient to throw the onus on the defendant of proving that they were not manufactured by the process disclosed in the plaintiff's patent. The burden of proof also shifts to defendant in case the defendant is claiming himself an innocent infringer on the date of infringement.

9.8 JURISDICTION OF SUIT FOR INFRINGEMENT

In the action for infringement a proper jurisdiction is very important. If the suit is filed in a wrong jurisdiction, the defendant may raise the question of its maintainability and may be declared void for the want of jurisdiction. According to the provisions of Section 104, a suit for infringement of patent or for declaration of non-infringement under Section 105 can not be filed in a court inferior to district court. Therefore, the infringement suit can either be filed in the district court or the High Court depending upon the pecuniary value of the suit. In case, the suit is filed in the District Court by the plaintiff and defendant files a counter-claim for revocation in replying the grounds in the written statement, in such situation, the suit along with the counter-claim shall be transferred to the High Court for the final decision in the matter and the Power of the District to try the suit ceases to have any jurisdiction. However, in case the suit is filed in District Court and defendant has raised the question of invalidity of patent as defence but filed a separate petition for revocation of patent in an another court, for instance in the Intellectual Property Appellate Board (IPAB), in this situation, the infringement suit filed in District Court is maintainable and such court can try the suit for its final disposal and therefore not affected by the proviso to Section 104 as the question of infringement and revocation are two different issues. Similarly when suit for the patent infringement is filed in the High Court as District Court is lacking the original jurisdiction due to the pecuniary value of the suit and defendant has not filed any counter-claim for the revocation of patent while filing the reply to suit but had filed a petition in the Intellectual Property Appellate Board (IPAB) before, then also petition filed in IPAB for revocation will not stand transferred automatically unless and until so ordered by the High Court. In sum, it is pointed out that unless and until, the defendant files a counter-claim in the suit for infringement filed in the District Court, the suit shall not be transferred automatically to High Court in accordance with the proviso to section 104 as infringement and revocation are two different issues. However, the Hon'ble High Court of Gujarat deciding a case under the Patents and Designs Act, 1911, held that where any of the grounds justifying the revocation of the patent are pleaded in the written reply filed by the defendant without any specific prayer for revocation or the counter-claim for revocation, then District Court has no jurisdiction to try. After, this judgment of the High Court, the CPC was amended wherein r-6B of Order VIII provides a clear provision for making counter-claim in the written statement.

Another important point relating to jurisdiction is that such suits for patent infringement in the District Court must be filed at a place where the cause of action has arisen in accordance of the provisions of CPC. A cause of action arises from the date of infringement. However, in case the infringing goods of the defendants are distributed by their agents carrying on the business within the territorial jurisdiction of a particular court (district), then, that court has jurisdiction to entertain a suit for infringement.

It may also be noted that there are still some conflicting opinions about the power of the City Civil Court to try the infringement suits. In one of the cases decided under the Trademarks Act, the Hon'ble High Court of Andhra Pradesh held that the City Civil Court oh Hyderabad was a District Court [***Western India Match v. Haji Abbas Hussain AIR 1962 AP 127***], whereas, Hon'ble High Court of Madras held that the City Civil Court was not a District Court or a court superior

to District Court [*Neiveli Ceramics v. Hindustan Sanitary ware (1976) IPLR 66, P-72*].

9.9 TIME FOR FILING THE SUIT

According to the provisions provided in proviso to Sub-section (7) of section 11A of the Patents Act, 1970,, the applicant for patent is not entitled to file any suit for infringement of patent unless a patent has been granted, in spite of the fact that the application for patent for has been published under the provisions of Section 11A (1) and (2) after expiry of the statutory period of maintaining the secrecy. However , from the date of publication of the application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for the invention had been granted on the date of publication of the application. Therefore, the applicant can not institute any proceeding or suit for infringement of patent before the patent is granted, but he is entitled to claim damages from the date of publication of patent application.

It may however, be noted that according to the provisions of Section 45(3) of the Act, a suit or any proceeding for infringement can not be commenced or prosecuted in respect of infringement committed before the publication of the application.

The of limitation to file a suit for infringement is provided under Section 40 of the Indian Limitation Act, which is 3 years from the date of when the infringement has occurred. A cause of action for the suit of infringement arises when the infringing act has taken place. Accordingly, the limitation period for filing the infringement suit begins from the date of infringing act and not from the grant of patent. Therefore the grant of patent is not a condition precedent in order to the arising the cause of action but for filing the suit for infringement.

9.9.1 Who Can File the Suit

Since the exclusive rights for patent to prohibit third party from doing any act as mentioned in Section 48 are conferred upon the patentee, it is quite obvious that the patentee is the person who can institute the suit for the infringement of patent. The patentee is the person, in accordance with the provisions of the Section 2(1) (p), who has been entered in the resister of patent for the time being as the grantee or the proprietor of the patent.

However, in case of joint owners or co-owners, the co-owners are also entitled to file the suit since they are entitled for equal undivided share in the patent. Therefore the suit must be filed by both of them and in case the suit is filed by one of them, I think, other must join the proceeding as a plaintiff, failing which as defendant. In case the co-owner joined as defendant, he must not be liable for any damage or cost on the basis of analogy in case of exclusive licence holder or compulsory licence holder as provided under Section 109 and Section 110 respectively when patentee joined as defendant in case the patent infringement suit is filed either by licence e or the holder of compulsory licence.

Further, a suit for infringement can also be filed by the holder of exclusive licence as he shall also have like rights as the patentee from the date when the exclusive licence is granted. This is applicable only when the infringement has taken place after the grant of exclusive licence .

Similarly a licensee who has been granted a compulsory licence under section 84 can also bring a suit for the patent infringement after the date of grant of such licence but only when the patentee refuses or neglects to take action for instituting the suit for the infringement within two months after being so called upon to do so. This is however subject to the terms and conditions stipulated in the licence agreement. As stated above, in case the patent infringement suits are filed by exclusive licence holder and compulsory licence holder and patentee has not joined them as plaintiff in such cases, the patentee is not liable for any cost and damages when he has been made as defendant. This is a statutory exemption to him.

Further, an assignee can also institute a suit for the infringement, provided the deed of assignment between the patentee and assignee is executed in writing as provided under section 68 and the rights and interest of the assignee are registered in the patent registered. Therefore, the assignee becomes entitle to file the said suit only after his name and interest is registered in the patent register. However the assignee is not at all entitled to file the suit for the infringement occurred before the execution of the assignment deed and registration of his interest in the register of patent.

Self Assessment Question **(Spend 4 minutes)**

3) Who all are eligible to bring a suit for infringement of the patent?

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9.9.2 Who Can be Sued

A suit for patent infringement can be filed against any person who is either manufacturing, using, offering for sale, selling, or importing the patented product in India without the consent of the patentee including those persons who are using the patented process or offering for sale, selling or importing the product obtained from that patented process in India without the consent of the patentee of the patented process except those who are statutory exempted under the Patents Act, 1970.Those who are exempted have already bee discussed under exemption. Therefore, manufacturers, sellers, or importers can be sued for the patent infringement. However, there are certain conditions where it is difficult o ascertain the actual infringer. The some of situations are discussed below.

i) **Infringement by Agent or servant**: An infringement action against an agent or servant can be initiated individually but that would not absolve the responsibility of the person who has appointed them for that purpose. However, action against mere workmen who innocently help in an infringement, and are not really guilty person, would not be taken. Therefore, it would largely depend on concerted action of these agents and servants and also on the intention of the defendant as to what purpose the agent or servants are appointed for. If they are appointed for continuation of the infringing act, they are responsibly equally and individually as well.

ii) **Directors of the company**: In case the evidences establish the relationship of the principal and servant between the directors and the company in, or expressly authorized the company for committing the infringing acts, the directors are responsible for the infringement **[*British Thomson-Houston v. Sterling Accessories (1924)41 RPC, 311*]**. However, mere instructions by the director to certain acts, which are infringing acts, are not sufficient unless it was established that, such facts of infringing acts were within the knowledge of such direction while giving the instruction. Further, in cases where, the company is doing business of its own independently without the express instructions of the directors, in such a situation, the directors are not responsible.

iii) **Joint tortfeasors:** When an infringing act is committed by two persons in concert with each other or such act is committed by the agent in the course of employment of his principal or by the servant in the employment of his master, such persons would clearly be called the joint tortfeasors and liable for the infringement.

iv) **Making and selling parts of the combination:** When a person is making or selling the individual parts or elements of the patented article or machine for combination, there would not be an act of infringement, even though such manufacturer or vendor knew that such parts or elements would eventually be combined to constitute such article or machine. However, in case such parts and elements are made and sold as collection so that they could easily be put together, it would amount to an infringement. But in case such a collection is exported where the assembling of patented articles or machines is done in other country, it would possible not amount to an infringing act.

v) **Repairing work:** if the act of defendant, while doing the repairs is such that he is using the patented process substantially or producing the article new article in the guise of repairing the old article which has been made under the patent, in such situation, he would be liable for the infringement **[*Dunlop Pneumatic Tyre Co. Ltd. v. Holborn Tyre Co. Ltd* [18RPC, 222].**

9.10 SUMMARY

- The Right of the patentee are provided under Sec. 48. Under this section, it is mentioned that the patent granted shall confer upon the patent the exclusive rights to prevent third parties who do not have his correct, from the act of making, using, offering for sale, selling or reporting for there purposes that products in India in case where the subject matter of patent is a product. Only moluation of the rights of patentee by third party valuets is infurgent.
- Patient rights are not assolute rights.
- There are general types of influent which include: a) doubleside infurgent; b) delegate will miror modification to hide c) indirect infergement d) Cortubutory influrgent e) accidental infurgement f) innocent infrigement.
- While considering the infurgent of patent, the court follows the following principles:
  - a) doctrine of coloursafe variations
  - b) doctorine of pith and narrow
  - c) doctine of equivatents

9.11 TERMINAL QUESTIONS

1) What are the different types of infringement? Explain.

2) What are the questions that determine the various infringement issues of any valid patent? Elaborate with cases.

9.12 ANSWERS AND HINTS

Self Assessment Questions

1) When the defendant does not make any effort to take any prior permission from the right holder for making the patented product for using the patented process it is known as direct or willful infringement.

2) Doctrine of colorable variations is applicable in those cases where the defendant has incorporated all the essential features of the patented invention of the plantiff, while making the machine article or product or the process and has made variations or modifications in the non essential features or added some features to differentiate from the patented invention, which have no substantial effect in fact and thus gives a color to suggest that he is not infringing the patented invention.

3) The person who are entitled to bring a suit for infringement of the patent are

   a) the patentee himself

   b) in case of joint owner or co-owner (both of them)

   c) a licensee who has been granted a compulsory licence under section 84

   d) an assignee

Terminal Questions

1) Refer to Section 9.5

2) Refer to Section 9.6

9.13 REFERENCES AND SUGGESTED READINGS

1) Patent law by P.Narayanan. Fourth Edition,2006 published by Eastern Law House.

2) Terrell on the Law of Patent, Sweet & Maxwell, Limited, London. U.K.

3) Intellectual Property by W.R. Cornish, Sweet & Maxwell, Limited, London. U.K.

4) The Patents Act,1970 as amended up to 2005 and the Patents Rules 2003 as amended up to 2006.

UNIT 10 FILING OPPOSITION-PRE/POST GRANT ISSUES

Structure

10.1 Introduction

10.2 Objectives

10.3 Pre-Grant Opposition

- 10.3.1 Representation
- 10.3.2 Persons Who Can File Representation
- 10.3.3 Time Limit
- 10.3.4 Grounds of Opposition

10.4 Procedure for Pre-Grant Opposition

10.5 Post Grant Opposition

10.6 Procedure for Post-Grant Opposition

10.7 Summary

10.8 Terminal Questions

10.9 Answers and Hints

10.10 References and Suggested Readings

10.1 INTRODUCTION

The opposition to the grant of patent to any invention is equally important as the securing the grant of patent. In fact the opposition related provisions ensure that no frivolous inventions are protected under the law as well as no public rights are encroached upon by the so called applicants. Therefore such a procedure in any patent law provides the balance between the rights of the public at one hand and the rights of the applicants (or inventors) at other hand. Patents Act 1970 prior to the amendment in 2005 enshrined the opposition provisions under Section 25 prior to the grant of patent on the publication of the acceptance of the application within four months of such publication, which was extendable for another one month. However such procedure was available only to an interested person who could file such opposition on proving that he was really a person interested in the law and his interest would be affected on the grant of such patent but not available to any person. Further, if such a person somehow missed the opportunity at that time, no remedy was available except to file an application for revocation in the High Court which was very expensive and time consuming. Therefore the Patents (Amendment) Act, 2005 introduced two tier opposition systems in the Patents Act, 1970 which can be filed in the patent office itself before the controller. This is known as pre-grant opposition by way of representation under Section 25(1) and the other one is known as post-grant opposition under Section 25(2) of the Act within one year from the grant of patent.

10.2 OBJECTIVES

After reading this unit, you should be able to:

- explain the necessary constituents involved for filing a pre grant opposition;
- describe the procedure for pre grant opposition;
- discuss post grant opposition and its necessary constituents; and
- explain the procedure for post grant opposition.

10.3 PRE-GRANT OPPOSITION

10.3.1 Representation

It is to be noted that in order to file any pre-grant opposition to the grant of patent to any invention, the person is required to make a representation before the controller. The said representation must contain statement of facts and at least one of the grounds as contained in Section 25(1) and evidences supporting the grounds relied upon.

10.3.2 Persons Who Can File Representation

The representation for opposition can be filed under the provisions of Section 25(1) of the Act by **any person** unlike the provisions existed before 2005 amendments, where only interested person could file such an opposition. Further, filing of such representation does not require any fee to be paid to the patent office.

10.3.3 Time Limit

Under the provisions of Section 11A of the Act, every application for patent is published in patent office journal after expiry of statutory period of 18 months from the date of its filing or date of priority, whichever is earlier except certain applications such as those in which secrecy directions are imposed under Section 35, or those abandoned under Section 9(1) or those which have been withdrawn prior to publication. Accordingly, on publication of any application under the Act, the representation for opposition can be filed within a period of six months from the date of such publication but before the grant of patent.

10.3.4 Grounds of Opposition

It may be noted that the grounds for filing the representation for opposition are contained in clause (a) to clause (k) of Section 25(1) of the Patents Act, 1970. However, it is cautioned that no other ground is available for filing pre-grant opposition as well as post grant opposition. These grounds are discussed below in details.

i) Wrongful obtaining: If the applicant for patent or a person through whom he claims the invention, has wrongfully obtained the invention or any part of the invention. The ground of wrongful obtaining need to be established clearly beyond any doubt by the person alleging such ground and if there is any suspicion in the circumstances, wrongful obtaining can not be proved. Wrongful obtaining includes

fraudulent or deceitful or unlawful manner. Therefore the opponent has to prove that the invention was obtained from him or his assignee by the applicant for patent or his assignee in wrongful or unlawful manner.

Remedy in case of wrongful obtaining:-In the cases where the wrongful obtaining has been proved by the opponent, the controller under the provisions of section 26 of the Patents Act 1970, may refuse the application to proceed further or on the request made in the prescribed manner by the opponent may order to proceed the application in the name of the opponent from the date when the application was actually filed.

However in case where the controller finds that only a part of the invention as described in the complete specification was wrongfully obtained, he may ask the applicant to amend the specification in order to exclude such part of the invention from the specification and allow the opponent to file a fresh application for the part of the invention so excluded and treat such application to have been filed on the date when the earlier application was filed by the applicant so as to allow the priority date of the claims for the purpose of novelty.

In case where the opponent has already filed the application for patent for an invention which includes the whole or the part of the invention, before the order of the controller requiring the applicant to amend the complete specification to exclude the part of the invention which was wrongfully obtained, the controller may treat such application of the opponent, deemed to have been filed on the date when the earlier application was filed by the applicant in order to provide the priority of the claims of the complete specification so as to protect the novelty of the invention so claimed by the opponent.

ii) Prior publication: If the invention so claimed has been published before the priority date of the claims in any specification filed in pursuance of the application filed in India on or after 1st January 1912 or any other document in India or elsewhere. Therefore as far as prior publication of the invention in any document other that Indian patent specification is concerned, global novelty criteria is followed.

Accordingly the requirement of prior publication is that (a) the publication of the invention must have taken place prior to the priority date of the claims of the application so opposed (b) such publication must have taken place in the Indian patent specification filed in respect of the application filed on or after 1st January 1912 or any document in India or any where in the world and(c) the subject matter of claims must have been disclosed in such publication.

While considering the ground of prior publication for successful opposition, it must be ensured that the information disclosed in the prior published document must be equal to that disclosed in the specification of application so opposed for the purpose of practical utility but not similar. In a classic decision by House of Lords in ***Hills v. Evans*** [42RPC,543at page 555],it was held that, the antecedent statement must in order to invalidate the subsequent patent, be such that a person of ordinary knowledge of the subject would at once perceive and understand and be able practically to apply the discovery without the necessity of making further experiment and the information given in the prior publication must for the purpose of practical utility be equal to that given by subsequent patent. These ruling or guidelines are followed by the patent office and courts in India as well. Therefore, the person skilled in the art by following the instructions given in the prior published document should be available to achieve same results as achieved by the alleged

invention disclosed in the application so opposed without carrying out further experimentations.

Another requirement to prove anticipation by the prior publication is that the information must be disclosed in one document and not in several documents. In other words, mosaic of information contained in each separate document would not suffice and legitimate to construe the anticipation.

Example of anticipation by Prior publication: **1. Indian Patent No. 183455 [Stoplik Services India Pvt. Ltd v. Panacea Biotech Ltd]** This patent specification was claiming a process for preparation of injectable Nimesulide composition. Opposition was filed by the opponents on the ground of prior publication, including other grounds as well on the basis of Sri Lankan Patent which also described the process for the preparation of same Nimesulide composition. The alleged invention was considered anticipated as cited document disclosed the invention or disclosed the information in such a way that made it part of the state of the art. The claim lacked in novelty if information about anything falling within its scope has already been disclosed in the prior art. For instance, even if, for example a claim specifies alternative, or defines the invention by reference of range of values, then the invention is not new if one of these alternatives, or a single example falling within this range, is already known. Therefore a specific example sometimes is sufficient to destroy the novelty of a claim when the same is defined generically. The grant of patent was refused on the above ground.

Self Assessment Question **(Spend 3 minutes)**

1) Explain prior pubication with examples.

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2. Indian Patent No.- 173953 [Godrej Soaps v. Hindustan Lever Ltd] : This patent was claiming the invention related to "process for making a soap composition containing glycerol". Opposition was filed on the ground of prior publication on the basis of prior published document describing very broad range of the ingredients. It was held by the controller after considering all the documents on the records that the ingredients recited in the principal claim have a very specific and narrow range of proportions, which were not taught by cited documents. Cited document did not teach as to how to obtain the right balance of salt & glycerol in order to avoid a soap which was too hard or too soft. Further, the cited documents also did not mention of balancing the quantities of glycerol or salt against the quantities of total fatty matter. In view these reasons opposition did not succeed as opponents failed to establish the ground.

Exception: However, there is an exception to this provision of prior publication under Section 29(2) and (3) of the Act. According to these provisions, the publication of the invention before the priority date of the claims, shall not be deemed to be considered anticipation, if the applicant proves that the matter was obtained from him or from the person from whom he derives the title and it was

published without his consent but the application for patent has been made within reasonably practicable time.

If the invention has been used or worked for the purpose of reasonable trial, or used secretly such use or working would not amount to anticipation. However, If the invention has been commercially worked in India otherwise than for the reasonable trial purpose, by the applicant for patent or any person from whom he derives the title or any person with the consent of the applicant for patent, such exception is not applicable.

The similar exceptions to anticipation are also available to the applicant if the invention has been published in consequence of display or use of the invention at the industrial or other exhibitions organized by the Government by the notification in the official Gazette, with the consent of the true and first inventor or a person deriving the title from him or the description of the invention in a paper has been read by the true and first inventor before the learned society or published with his consent in the transactions of a such society, provided an application has been filed by such true and first inventor other person deriving such title through him within a period of twelve months from the date of opening of such exhibition or the reading or publication of the paper as the case may be.

iii) Prior claiming: If the invention so far as claimed is claimed in any of the claims of the complete specification of the application filed in India prior to filing date or priority date of the application so opposed but published on or after the priority date of the applicant's application.

Accordingly the requirement of prior claiming is that (a) the invention so claimed in the applicant's application so opposed has been claimed in the specification of the other prior application (b) the complete specification of the earlier application must have been published on or after the filing of the application so opposed and (c) the earlier application must have been filed in India prior to the filing date or the priority date of the application so opposed.

Further, while proving the prior claiming it must be shown that the claimed invention of the application so opposed must have been claimed and not merely comprehended in the claims of cited Indian patent specification. If the claims of the invention have been claimed in the foreign applications filed in USA or other foreign countries, the ground will not sustain and liable to be rejected.

In case of prior claiming, there may be three situations to arise. Firstly, where the claims of earlier application are narrow and therefore falling wholly within the scope of later application, secondly where the claims of earlier application and claims of later application are overlapping with each other but not coterminous and thirdly where the claims of earlier application are broader and covering the claims of later application within their scope.

The issues relating first two situations can be sorted out by making suitable amendments in the later application so as to exclude the subject matter of claims of the earlier application and the subject matter of the claims so overlapped. However in the case of third situation where the claims of earlier application are embracing and claiming the subject matter of later application, it will be considered an anticipation unless and until, the applicant for later application proves that he has selected an area from the subject matter of claims of earlier application which gives a distinct advantage or surprising or unexpected results beyond or different from that disclosed in the earlier application. In such situation the applicant for

later application must frame his claims in the complete specification in such a way that, it proves either some real advantages to be gained or some disadvantages to be avoided while selecting the parameters from the prior disclosed and claimed invention. Such kind of selections for a particular invention is known as selection patent. Sometimes in order to overcome the objection relating to prior claiming the applicant of later application is allowed by the controller on his satisfaction to amend the specification by inserting the reference of earlier application.

iv) Prior public knowledge or public use: If the invention so claimed in the complete specification was publicly known or publicly used in India before the priority date or the date of filing of the application whichever was earlier. In case of invention relating a process for which a patent has already been granted is deemed to have been publicly known or publicly used in India before the priority date of the claims, if a product made by that process has already been imported into India before that date except where such importation was for the purpose of reasonable trial or experimentation only.

The onus to prove the prior public use or prior public knowledge lies with the opponent. This provision is primarily meant for protecting the interest of the prior user in India of the invention so claimed. Therefore a person who is already manufacturing a thing or manufactured previously and put it use can not be stopped from doing so, what he has done before.

In order to prove prior use, the proof must be very clear and corroborated by the evidence. The prior use need not be habitual or repetitive, only single use is sufficient to prove the prior use. However where a prior use is not intentional but only fortuitous or accidental, then the ground of prior use must fail. If a gift of the sample of the invention before the priority date enables the recipient of the sample to ascertain the invention in the manner which he is free in equity and law to use as he pleased, then the ground of prior public use stands established and patent can be invalidated.

In case of prior public knowledge, the mere publication of the invention is not sufficient, and on the other hand a thing may be publicly known without being published in the document. What is important is the communication of the invention even to a single member of the public. However the publication of the invention in the patent specification is sufficient to constitute the prior public knowledge as the patent specifications are open to public inspection after their publication.

Exceptions:-It is noteworthy that, under the Patents Act 1970,there are certain exceptions to the ground of prior public use or prior public knowledge. Firstly if the invention has been used for the purpose of reasonable trials prior to the priority date of the claims by the applicant for patent or any person from whom he derives the title or patentee or by any person with the consent of such persons under the provisions of Section 29(2),secondly, if the invention has been communicated to the Government or to the person so authorized by the Government to investigate the invention or its merits or anything done in consequence of such communication for the purpose of the investigation (Section-30),thirdly, use of the invention after its display in the exhibition or during exhibition by any person without the consent of the true or first inventor or a person deriving the title from him provided the application for patent is filed within 12 months by such true and first inventor or a person deriving the title from him(31),fourthly, working of the invention in public for reasonable trial any time within one year from the priority date of the claims of the specification by applicant or patentee or by a person

from whom he derives the title or by any other person with the consent of the applicant or patentee or any other person from whom he derives the title the true or first inventor or a person deriving the title from him, having regard to the nature of the invention (Section-32)fifthly, if the invention has been used in India after filing of the provisional specification or the complete specification filed with application has been treated as provisional specification under Section 9(3) of the Act (Section-33) and sixthly, if the invention has been used secretly no account will be taken into consideration as to prior use. However, whether a particular prior use is secret use or not will depend upon the circumstances of the case.

v) **The obviousness or lack of inventive step:** If the invention so claimed is obvious and clearly does not involve any inventive step having regard to the matter published prior to priority of the claims of the complete specification or what has been used publicly in India. Therefore the consideration of obviousness or lack of inventive step requires the prior publication of the invention in (a) Indian patent specification filed in respect of the application filed in India on or after 1st January 1912(b) any document in India or anywhere in the world including foreign patent specifications, books, journals, etc(c) prior public use in India.

To consider as to whether an alleged invention is obvious or not, proper analysis of the information disclosed in the prior published documents or prior used as prior art must be made in order to ascertain the differences between the two and if there are differences, further objective analysis must be made as to whether such differences are so obvious to the person skilled in art who can perceive such changes. If on such objective analysis, the answer is affirmative, then invention is said be lacking inventive step and obvious to a person skilled in the art. However, if it was found that an inventive ingenuity was necessary to make such changes, then invention did not lack the inventive step and not obvious to a person skilled in the art.

Examples-

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

2) In another case which was decided by the patent office was related to a hardening composition comprising (i)an unsaturated polyester resin (ii) hardening accelerator containing cobalt metal soap and (iii) methyl ethyl ketone peroxide as hardener the two patent documents were submitted by the opponent wherein document one was disclosing a hardening composition

comprising(i) unsaturated polyester resin,(ii) hardening accelerator containing three component cobalt metal soap, calcium metal soap & copper metal soap and(iii) tertiary butyl per-benzoate as a hardener. The document two was disclosing the method of hardening of unsaturated polyester resin using peroxides such as methyl ethyl ketone peroxide, tertiary butyl per benzoate which can function as a hardener .The controller held the invention obvious in view of the disclosure in the two cited documents as it was obvious to a person skilled in the art to use tertiary butyl per-benzoate as hardener in the hardening composition.

Sometimes the obviousness is decided by considering the facts (a) as to whether the alleged invention is solving a long standing and important problem existing in the prior art (b) as to how significant and long had that problem existed(c) as to what were prior efforts made to solve the problem and (d) as to whether the problem has been solved effectively.

The issue of obviousness is generally and must be decided on the basis of evidence submitted by the expert in the relevant field of technology or a person skilled in **relevant** art or field of technology by considering his technical qualifications and experience. Further, the issue as to whether the alleged invention does not involve the inventive step must be proved clearly beyond any doubt and if there is a doubt about the obviousness, such doubt should be resolved in the favour of the applicant.

vi) Invention not an invention or patentable invention: If the invention so claimed in the specification is not an invention within the meaning of the term "invention" as defined under the provisions of Section 2(1)(j) or not patentable under the provisions of Section 3 or provisions of Section 4 of the Act.

Accordingly, the alleged invention, in order to be patentable must be a new process or the product involving an inventive step and capable an industrial application. The invention is said to be novel or new, when it is not anticipated by the prior publication, prior claiming and prior public knowledge or prior public use as prescribed under the Act. Similarly the invention is said to involve the inventive step if it involves technical advancement as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art. The invention is capable of industrial application if it can be used or made in an industry.

Further, the invention in order to be patentable must not fall within non patentable inventions as enumerated in the provisions of section 3. It may be noted that the inventions relating following subject matter have been excluded from patentability under the law.

- Frivolous & obviously contrary to natural law
- Contrary to law, morality or injurious to public health
- Use or commercial exploitation is contrary to public order or morality or cause serious prejudice to human, animal or plant life or health or to the environment
- Mere discovery of scientific principle or formulation of abstract theory
- Discovery of living or non living substances occurring in nature

- Mere discovery of new form of known substance which does not result in the enhancement of the known efficacy of that substance or mere discovery of new property or new use of known substance / process/machine/apparatus.
    - *Explanation-For the purpose of this clause, salt, esters, polymorphs, metabolites, pure forms, isomers, complexes etc, shall be considered to be the same unless they differ significantly in properties with regard to efficacy*
- Mere admixtures resulting in the aggregation of properties of the ingradients
- Mere arrangement and rearrangement of known devices. working independently
- Method of agriculture or horticulture
- Process for any medicinal, surgical, curative, prophylactic, diagnostic or therapeutic treatment of human being or animal.
- Plant & animals or their parts including seeds, varieties and species and essentially biological process for the production or propagation of plants and animals
- A mathematical or business method or a computer programme per se or algorithms
- Literary, dramatic. musical or artistic/cinematography works and television productions or any other aesthetic creation.
- Scheme or rule or method of performing mental act or method of playing game
- Presentation of information
- Topography of integrated circuit
- Traditional knowledge or aggregation or duplication of known properties of traditionally known components

Apart from the above, the invention should also not fall within the category of atomic energy related inventions which are falling within the provisions of Section 20(1) of the Atomic Energy Act, 1962.However, the burden of proof lies upon the opponent who is relying upon the ground that the alleged invention is neither an invention nor patentable invention within the Act.

vii) Insufficient disclosure: If the complete specification does not sufficiently and clearly describe the invention or the method by which it is to performed. It may be noted that sufficiency of disclosure of the invention is examined at four stages under the law and out of which three stages in the patent office by the controller. The first at and during examination stage, secondly at pre-grant opposition stage and thirdly at post-grant opposition stage. Fourth and last stage is during revocation proceeding by the Intellectual appellate Board or by the High Court under certain circumstances. In case of the inventions relating to biotechnological field particularly to biological material or microorganisms, the description is supplemented by deposition of microorganisms in the International Depository Authorities (IDAs).

In fact, the consideration to the grant of patent to the inventor is the sufficient disclosure of the invention by him in the specification so that on the expiry of the term of patent, the information becomes the public property which can be utilized without any payment of royalty to the right holder. This can be achieved only when the information in the patent specification is sufficient and enables a person having ordinary skill to achieve the same results as intended to be achieved by the claims.

The proper test of sufficiency of the disclosure is that a person of ordinary skill in the relevant field on pursuing the instructions contained in the claims and the description must be able to obtain the same results as promised by the claims or be able to perform the invention to achieve at least one embodiment of the invention without doing further undue experimentation. If the promised results can be achieved without performing or doing any further and undue experiments, the invention is said to have disclosed sufficiently failing which, the ground would prevail.

It is important to note that while preparing the complete specification, the utmost good faith is expected of the applicant. The willful or intentional introduction of ambiguity for misleading the public would be sufficient to avoid the grant of patent. Therefore the subject matter of the invention to be disclosed in the patent specification must be concise, clear, succinct and unambiguous. Further, the claims and description should not be speculative in nature.

Self Assessment Question **(Spend 3 minutes)**

2) Explain the proper test of sufficiency of disclosure?

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viii) Failure to disclose the information of foreign application u/s 8: If the applicant has failed to disclose to the controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge. It may be noted that under the provisions of section 8, the applicant is required to file a statement containing the details of the corresponding application for same or substantially same invention being prosecuted outside India by the applicant or by the person from whom he derives the title or by the person deriving the title from him. This should be filed at the time of filing the application or within the time limit as allowed by the controller. The applicant is also required to file the undertaking to keep the controller informed in writing regarding corresponding applications for same or substantially same invention filed outside India subsequent to the application filed in India. The controller may also require the applicant to furnish the details of prosecution relating corresponding application being prosecuted in a country outside India. Therefore failure on the part of the applicant to disclose such information within the prescribed time or wrongful or false disclosure of such disclosure would entail the denial of patent in pre-grant opposition and revocation of patent in post grant opposition.

ix) Failure to file convention application within 12 months: If the application was not made, in the case of a conventional application, within the period of 12 months from the date of first application for protection for the invention made in a convention country by the applicant or a person from whom he derives the title, the application may be refused to proceed further by the controller.

The filing of the convention application after expiry of 12 months is in violation of provisions of section under the provisions of Sections 135 and 136. Further,the provisions of Section136(3) also does not permit the post dating of convention application to any later date within which the convention application could have been made. This is mainly for the reasons that applicant can neither the post date the convention application for a period equal to the delayed period, unless the earlier application in the convention country is postdated, nor can he afford to convert the said convention application to non-convention application due to loss of priority which may result into loss of novelty. However, if the applicant can get the earlier application in convention country postdated, in such situation the period of 12 months will be counted from the postdated date. Similarly in case where the applicant can afford to convert the convention application to non-convention application, the issue of 12 months period would become irrelevant. In this situation the application will not be liable to be refused. It may also be noted that in case of post-grant opposition where the patent has already granted in respect of convention application which was not filed within 12 months, the applicant can neither get the convention application postdated in the convention country nor can he get the application converted into non-convention application and therefore under such situation the patent granted will have to be revoked.

In case of late receipt of the convention application by the patent office through post after the expiry of the 12 months can be condoned due to postal delay. However if such application has been delivered in person by the applicant or his representative, the delay beyond 12 months can not be condoned as delivery does not fall within the ambit of postal service as mistake is one of the substance not of procedure(Fujisawa's application[1978]FSR(CA)).

x) Failure to disclose or wrongful disclosure of the source or geographical origin of the biological material: In case the complete specification does not disclose or wrongly disclose the source or geographical origin of biological material used for the invention. This ground for opposition was introduced by the Patents (Amendment) Act, 2002 mainly to ensure to protect bio-piracy and misappropriation of the biological resources. and also disclosure of the source or geographical origin of the biological material in the complete specification would encourage the sharing of the benefits out of the patent by the country whose biological resource are used by the applicant. In the absence of disclosure or wrongful disclosure it would be very difficult to find out as to which country's biological material or resource has been used by the applicant and this would lead to sever confusion to determine the source as well as benefit sharing. Such kinds of provisions are also helpful to determine as to whether the applicant has taken prior permission from the competent authority to file the application for patent for the inventions utilizing the biological resources of the country. Failure to meet the above requirement would entail the refusal of the application to proceed further in the pre-grant opposition and revocation of patent in post grant opposition.

xi) Anticipation of the invention by traditional knowledge: If the invention so far as claimed in any claim of the complete specification is anticipated having

regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere. This ground for opposition was introduced by the Patents (Amendment) Act, 2002 mainly to protect the Traditional Knowledge (TK) including the properties of medicinal plants, herbal products using momordica charantia, turmeric, neem, tulsi, etc, available in India or any part of the world existing orally or otherwise. It may be noted that all other grounds in the opposition need written documentary evidences whereas under the provisions of this sub-section, an oral knowledge can be recognized in the evidence.

10.4 PROCEDURE FOR PRE-GRANT OPPOSITION

The procedure for the pre-grant opposition is prescribed under rule 55 of the Patents Rules 2003. Accordingly, in order to file representation for opposition, any person may submit such representation along with the documents as mentioned above with the time as prescribed. On receipt of the representation, a notice to the applicant along with a copy of the representation will be sent only after ensuring that a request for the examination has been received. In case, the request for examination has not been received by the controller within the prescribed time, the application will be treated to have been withdrawn and such representation will not be considered at all. In case the person making the representation for opposition feel that his representation must be considered by the controller even the request for examination has not made by the applicant in order not to considered the application for patent withdrawn, he must file himself the request for examination as third party within the prescribed period so as to enable the controller to refuse the application.

On receiving the notice, the applicant should file his statement along with evidence within three months from the date of notice in support of his application, in case he is so interested. If permitted further by the controller by leave granted, the opponent may also file the reply statement within the time allowed by the controller. The controller may then provide an opportunity to be heard to both parties if so requested. Even if the request for hearing is not made by either party, the controller has power to offer such hearing for the purpose of natural justice.

In case the controller feels after considering the statements, evidences and submission during hearing by the applicant that complete specification requires amendment to be carried out to his satisfaction, he can allow the applicant to do so and allow the patent application for grant otherwise the application will be refused. In case the controller is of the opinion that the one of the grounds has been successfully established, the application would be rejected by him and in case none of the grounds has been established, the representation would be rejected and patent would be granted thereon.

FLOW DIAGRAM OF THE PRE-GRANT OPPOSTION PROCEDURE:

IF ALLOWED BY CONTROLLER

PUBLICATIONN OF APPLICATION U/S11A

FILING OF REPRESENTATION

FOR OPPOSITION TO GRANT

WITHIN 6 MONTHS FROM THE PUBLICATION BUT BEFORE GRANT BY ANY PERSON

REFUSAL OF OPPOSTION AND PROCEED FOR GRANT

CONSIDERATION BY CONTROLLER

NOTICE TO APPLICANT

APPLICANT'S REPLY AND EVIDENCE WITHIN **3** MONTHS

OPPONENT'S REPLY WITHIN PERMITTED TIME LIMIT

HEARING

DECISION OF CONTROLLER WITHIN **1M**

REFUSAL OF APPLICATION

AMENDMENTS AND ALLOWED THE APPLICATION FOR GRANT

[please check in original - flow chart]

10.5 POST-GRANT OPPOSITION

a) **Notice of Opposition:** In order to file post-grant opposition to any patent granted to any invention; the opponent is required to file a notice of opposition to the controller in the manner prescribed in the Patent Rules, that is in Form-7 along with prescribed fee of Rs.1500 in case of natural person and Rs.6000 in case of legal entity. It must be filed in duplicate. The said notice must be filed with written statement indicating the interest of the opponent, the facts upon which he relies containing at least one of the grounds as contained in Section 25(2), the relief which he seeks and evidences supporting the grounds. On the receipt of the notice by the patent office, it will be notified to the patentee (Section 25(3)(a)).

b) **Who can file the notice:** The notice for the post grant opposition can be filed under the provisions of Section 25(2) of the Act by **an interested person** unlike the provisions of Section 25(1), where any person could file such an opposition. The person interested has been defined in Section 2(1)(t) to include a person engaged in, or in promoting research in the same field as that to which the invention relates. This definition is not exhaustive but inclusive. Therefore one has to prove his locus standi as to what kind of interest the opponent has in the same field of technology to which the invention relates. This could be a research interest, manufacturing interest, trading interest, etc. In fact there is no express limitation upon the nature of the interest to be shown. It is the responsibility of the controller or the court to determine on the basis of facts whether the opponent as shown himself to be a person interested **[Globe Industries Corporation's Patent(1977)RPC 563,page 575].** However the interest must be bona fide, real and substantial not frivolous or vexatious or mala fide.

c) **Time Limit:** The notice of opposition can be filed at any time after the publication of the grant of patent in the official journal of the patent office but before the expiry of a period of 12 months from such publication.

d) **Grounds of opposition:** It may be noted that the grounds for filing of the post grant opposition are contained in clause (a) to clause (k) of section 25(2), which are same as for the pre-grant opposition but no other ground. These grounds have already discussed above in details discussed in respect of pre-grant opposition.

e) **Opposition Board:** Once the notice of opposition is received, a board will be constituted to be known as Opposition Board for scrutinizing and examining the notice of opposition, evidences and other document sent by the opponent along with said notice. The said opposition board consists of three members and one of them is a chairman. The members of the board are generally are the examiners. However the examiner who has examined the case during the prosecution of the application for the grant of patent is not entitled to become the member in order to maintain the independence of the board without any bias or prejudice. After considering all the documents, the opposition board gives its joint recommendation within three months in a report with reasons in respect of each ground to the controller for final decision.

10.6 PROCEDURE FOR POST-GRANT OPPOSITION

As stated above, on the receipt of notice of opposition, a board is constituted to examine the issues relating to the opposition and patentee is informed about the notice of opposition so entered and a copy of the notice along with written statement and evidences if any is sent to the patentee for his reply. In case the patentee is interested in contesting the opposition, he has to file his reply statement and evidence if any within a period of two months from the date of receipt of the copy of the notice and written statement in the patent office replying all the grounds of opposition mentioned by the opponent and evidences supporting his reply. He is also required to send the copy of the reply statement to the opponent.

The opponent within a period of one month from the date of delivery of reply from the applicant is required to file his reply at the patent office to the reply submitted by him. The reply of the opponent should be strictly confined to the reply submitted by the applicant and sent a copy of the reply to the applicant. Thereafter neither party is entitled to file any evidence unless with a permission from the controller.

On completion of the presentation of the document and receipt of the recommendation of the opposition board the controller will fix a hearing for hearing the parties and give at least 10 days notice to both parties to attend the hearing if they are so interested, In case any or both parties are interested to be present in the hearing they must send their notice of interest to attend hearing in advance along with fee so prescribed. After hearing both parties and taking into account the recommendation of the Opposition Board, the controller will decide the opposition by giving the reasons in his decision.

The controller, while issuing his order, shall either maintain or ask the patentee to amend or revoke the patent as the case may be. In case the patent specification is amended by the patentee after receiving the order of the, controller, then in such situations, the patent will stand amended accordingly.

FLOW DIAGRAM OF THE POST-GRANT OPPOSTION PROCEDURE:

IF ALLOWEDBY CONTROLLER

WITHIN 12 MONTHS FROM THE PUBLICATION OF THE GRANT OF PATENT IN OFFICIAL JOURNAL

PUBLICATIONN OF GRANT OF PATENT U/S 43(2)

FILING OF NOTICE OF OPPOSITION TO PATENT BY OPPONENT ALONG WITH WRITTEN STATEMENT AND EVIDENCE

CONSTITUTION OF OPPOSTION BOARD

NOTICE TO APPLICANT

OPPONENT'S REPLY WITHIN ONE MONTH

APPLICANT'S REPLY AND EVIDENCE WITHIN **2** MONTHS

EXAMINATION OF DOCUMENTS BY THE OPPOSITION BOARD AND ITS RECOMMENDATIONS

FURTHER EVIDENCE BY EITHER PARTY WITH LEAVE

HEARING NOTICE

OPPONENT

APPLICANT

HEARING

DECISION OF CONTROLLER

AMENDMENTS AND MAITAINING THE PATENT AS AMENDED

REVOCATION OF PATENT

REFUSAL OF OPPOSTION AND MAITAINING THE PATENT

[please check in original - flow chart]

10.7 SUMMARY

For filing any pre-grant opposition to the grant of patent to any invention, the person should make a representation before the controller.

10.8 TERMINAL QUESTIONS

1) Explain pre-grant opposition?

2) Discuss post-grant opposition.

10.9 ANSWERS AND HINTS

Self Assessment Questions

1) Refer to Sub-section 10.3.4

2) Refer to Sub-section 10.3.4

Terminal Questions

1) Refer to Section 10.3

2) Refer to Section 10.6

10.10 REFERENCES AND SUGGESTED READINGS

1) Patent law by P.Narayanan. Fourth Edition, 2006 Published by Eastern Law House.

2) Patent for invention and the protection of Industrial Design by T.A.Blanco White

3) Terrell on the Law of Patent, Sweet & Maxwell, Limited, London. U.K.

4) Intellectual Property by W.R. Cornish, Sweet & Maxwell, Limited, London. U.K.

5) The Patents Act, 1970 as amended up to 2005 and the Patents Rules 2003 as amended up to 2006.

UNIT 11 GROUNDS OF DEFENCE

Structure

11.1 Introduction

11.2 Objectives

11.3 Defences

11.4 Revocation Grounds

11.5 Gillette Defence

11.6 Relief or Remedy

11.7 Declaration as to Non-Infringement

11.8 Summary

11.9 Terminal Questions

11.10 Answers and Hints

11.11 References and Suggested Readings

11.1 INTRODUCTION

It is now clear from the last Unit No.10, that the action for infringement by the patentee against a person who has been unauthorized doing the prohibited acts is a method to enforce his patent rights. However if the defendant is aggrieved by such action of the plaintiff or of the patentee due to the reasons that the claims of the plaintiff are not valid, he can file a counter-claim for revocation of patent and therefore challenge the validity of said patent. Further, since the patents are not absolute rights as they are subject to certain conditions under which a certain class of persons such as Government or any person authorized by the Government can use the patent. Such persons, if the patent has been used for that purpose, can also plead defence against infringement suit under those conditions.

While by filing the suit for infringement the plaintiff can also pray for certain reliefs in the plaint, before the court finally adjudicates or certain interim relief's prior to the final adjudication. It may be also noted that any interested person can also file a petition for revocation of patent in Intellectual Property Appellate Board (IPAB) while a suit for infringement is pending before the court and there is no such restriction in the patent law. It is entirely up to the defendant as to whether he would like to file a separate petition for the revocation of patent or as a counter-claim for the revocation of patent.

However the advantage is that in case it is filed as a counter-claim, then in that situation the entire matter is transferred to High Court as in that situation all other court ceases to have jurisdiction. It was held by the court that a person interested must be a person who has a direct and tangible commercial interest which is injured or affected by the continuance of patent on the register ***(Ajay Industrial Corporation v. Shiro Kanao of Ibaraki City***, AIR 1983 Del 496.). It was also held that once challenge is made with regard to the patent claimed by the plaintiff and its revocation is sought for by the defendants by counter-claim, all further

things should be done only by the High Court as the District Court will lose jurisdiction to proceed with the matter any further. ***(Low Heat Driers (P) Ltd. v. Biju George* (2001 (21) PTC *775*) Kerala)**

11.2 OBJECTIVES

After reading this unit, you should be able to:

- explain the various defenses available under the provision of the patent act 1970 against any suit for infringement;
- discuss the various grounds for the revocation of patents;
- describe Gillette defense;
- illustrate the remedy available to the plaintiff in case of infringement of right by the defendant; and
- mention the declaration to non-infringement.

11.3 DEFENCES

The Defences available under the provisions of the Patents Act, 1970 against any suit for infringement are as follows:

a) Defences which are generally stipulated under Section 107 of the Act according to which, every ground on which a patent can be revoked under Section 64. These grounds will be discussed in details in the later paragraphs.

b) The, making, using, importation of any machine, apparatus or other article, or by using of any process or by the importation, use or distribution of any medicine or drug by the government or by any person authorized by the Government for its own use or the purpose of distribution in any dispensary or the hospital or any other medical institution maintained by or on behalf of the Government or in accordance with any condition specified in Section 47 are also not considered an infringement and therefore use of patented invention under these conditions can also be pleaded as defence

c) Recently in 2002, by the Patents (Amendments) Act 2002, however, the provisions of Section 107 have been amended by adding a new section 107A where two more conditions have been added in which, certain act will not amount to an infringement and therefore can be pleaded as defence in the infringement suits. The such acts includes manufacturing, selling, using or importation of the patented invention solely for the purpose of uses reasonably related to the development and submission of the information to competent authority such Drug Controller under Drugs and Cosmetic Act, to grant license for manufacturing and marketing a particular drug in India [Sec.107 A (a)] or importation of patented products by any person from any person who is duly authorized under the law to produce and sell or distribute [Sec.107 A (b)].

d) There are still some situations where defendant has done the prohibited acts without the consent of the patent holder or without procuring a valid licence from the patentee, where such acts would not amount to an infringement and therefore the defendant can validly plead as defence. Such situations include

the use of the patented invention on board a vessel or aircraft of foreign country which comes temporarily or accidentally to India including the territorial waters in transit subject to certain exception; the use of patent invention between the date on which patent ceased to have effect due to failure to pay the renewal fee or otherwise and the date of publication of application for restoration of patent [Sec.62 (2)], the use of patent invention before the actual date on which patent was granted to true and first inventor where such patent was obtained by another person, wrongfully or in fraud of him [Sec.52 (3)], use of the patented invention by the Government or by any person authorized by the Government for its own use in public interest under the Act [Sec. 100-102].

e) When an enterprise has made significant investment and is manufacturing and marketing the pharmaceutical product based on the patented pharmaceutical products which was patented by patentee on or after 1st January 2005 but the application for patent for said pharmaceutical product was filed on or after1st January 1995 in India in accordance with mailbox provisions under Section 5(2) of the Act. Therefore such manufacturing and marketing of patent pharmaceutical products by defendant will not amount to infringement and a valid ground can be pleaded successfully.Sec.11A (7).

f) There are also some situations when patentee has exhausted his right due to sale of the patented product or due to expiry of the term of patented product. Under such situations also a valid defence can be pleaded by the defendant.

g) There may be some situations where a plaint is filed by a person who is neither a registered patentee nor a registered license holder. Under such circumstances also a valid defence can be pleaded against the plaintiff successfully as the plaintiff being incapable of filing the infringement suit.

h) In some circumstances, a person being an innocent infringer can also be pleaded as a defence on the ground that on the date of infringement, he was not aware and also had reasonable grounds to believe that a patent for the infringed product existed in the name of the plaintiff or the plaintiff was a legal right holder by virtue of assignment or valid license. This defence can be pleaded only when the patented product is sold by the plaintiff by applying the words "patent" or "patented" or "patent pending" without expressly mentioning the patent number thereon. However, in such circumstances the defendant will be protected only against the grant of damages or an account of profit and further prohibited act has to be discontinued thereafter.

i) Where the plaintiff is barred by the principle of res-judicata or estopped from filing the suit for infringement under certain circumstances.

j) If at the time of the infringement there was in force a contract relating to the patent and containing a condition declared unlawful under the provisions of section 140 of the Act subject to the condition that if the plaintiff is not a party to the contract and proves to the satisfaction of the court that the restrictive condition was inserted in the contract without his knowledge and consent, express or implied (Section 140(3).

k) Gillette defence alleging that the infringement was not novel at the relevant time.

Although the some of the grounds as defence are self explanatory in nature, few will be discussed in details.

Self Assessment Question **(Spend 3 minutes)**

1) Can a valid defense be pleaded against the plaintiff when the plaint is filed by a person who is neither a registered patentee nor a registered license holders.

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11.4 REVOCATION GROUNDS

The grounds for revocation of patent which can be pleaded as defence in counter-claim by the defendant are elaborated and discussed below in details.

a) **The invention claimed is the subject of a valid claim in a patent already granted in India prior to the clamed invention - prior claiming:** The invention claimed in the patent sought to be revoked has already been claimed in the claims of a patent granted in India, having earlier priority date and that the said **earlier claims are valid**. It means the patent must have been granted on the application disclosing the same in invention filed before the application of the plaintiff and claims are held valid, meaning that the claims are not the subject of any post grant opposition proceedings or revocation or held valid after such proceedings. In case the patentee (plaintiff) does not accept the validity of the prior granted claims, he would be ordered by the court to give particulars of his objections.

b) **Patentee not entitled to the patent:** Section 6 of the Patents Act specifies the categories of persons who are entitled to apply for Patents in India where a true and first inventor, assignee or legal representative may apply for patent either alone or jointly. If a person is other than those mentioned therein subject to the Provision of Sec 2(1)(y) , in such situation the patent can be revoked. It is noteworthy that a true and first inventor does not include either the first importer of an invention into India or a person to whom an invention is first communicated from outside India. It may be further observed that assignee can be a natural person or other than natural person like registered company, research organization, educational institute or Government or person authorized by the Government such as Public Undertakings, etc. and assignee includes assignee of the assignee also (Section- 2(1)(ab)).However fraudulent conduct or deceit is not essential under this ground.

c) **Patent was wrongfully obtained by a person in contravention of provisions relating to the persons entitled:** When a patent has been obtained by any person wrongfully, other than the person who was entitled to apply, such entitled person may file a petition under this ground for

revocation. The petitioner however has to prove that he is a person entitled to apply for the patent. If the patent is revoked by the court on this ground; the Court can also direct the Controller to proceed the patent further in the name of the person who was really entitled rightfully. Under this ground of revocation fraudulent conduct or deceit can be alleged by the respondent by submitting the evidence that he was in fact in possession of invention and the plaintiff has obtained the invention from by fraud or deceitful manner.

d) **Subject of a claim is not an invention:** Under this ground, the respondent can raise the basic question of patentability where the patent granted does not satisfy the provision of Sec 2(1)(j) meaning thereby that the alleged invention either related to a process or product does not fulfill the criteria of novelty, inventive step and industrial applicability or where the process is not a manner of manufacture resulting into some intangible effects or where the invention can not be used or made by the industrial process. Therefore the patent can be revoked under this ground. The onus to prove that the alleged invention is an invention within the provisions of the Act would then lie on the plaintiff.

e) **Invention is lacking in novelty with regard to prior knowledge or prior use in India or prior publication India or elsewhere:** This ground for revocation is based on lack of novelty in view of prior public knowledge and prior public use in India. It may be noted that novelty of an invention is an essential prerequisite for grant of any patent. Therefore in order to establish sufficient evidence in the form of documents have to be produced by the defendant mentioning the date of publication and name of the document where such invention was published. In case of prior public use sufficient evidence with regard to names, places and time of prior public use in India. In addition to this, the defendant has to establish that such prior public use was for commercial purpose and not for experimental purpose and also not a secret use. If the patent is for the process, there is no need to give details of the process including drawings and a mere description is sufficient to identify the prior user.

In case, the prior use of the apparatus or machine is in existence, in such case the defendant would not be required to give the details with regard to description and drawings of such apparatus or machine and mere information with regard to identification of user either by procurement of the apparatus or machine or by inspection would be sufficient. A similar position would be adopted in case of the infringement related to ingredients or compositions.

It may be noted that in case of prior public knowledge, any matter may form a part of common public knowledge even if it is not published or not available in a form of a book. On the contrary, mere publication of any matter is not sufficient to establish public knowledge. A thing may be made publicly known either orally or through documents, provided that the publication is such that the concerned person is free to share the information with others. The other criteria relating determination of prior public knowledge or use and publication have been discussed in Module 9 relating to opposition.

In case of ***Monsanto Company v. Coramandal Indag Products (P) Ltd.***, (1986) (1 SCC 642: AIR 1986 712), it was held that to satisfy the requirement of being publicly known it is not necessary that it should be widely used to the knowledge of the consumer public. It is sufficient if it is

known to the persons who are engaged in the pursuit of the knowledge of the patented product or process either as men of science or men of commerce or consumers. It may however be noted that while considering the issue of novelty in revocation proceedings on the basis of some documents or use no account shall be taken of personal document or secret trial or secret use of the invention and in case where the patent is for a process or for a product as made by a process described or claimed, the importation into India of the product made abroad by that process shall constitute knowledge or use in India of the invention on the date of the importation, except where such importation has been for the purpose of reasonable trial or experiment only.

f) **Invention is obvious or does not involve inventive step having regard to prior public knowledge or prior use in India or prior publication India or elsewhere:** This ground of revocation of a patent is alleged by the defendant on the facts that the invention claimed in any claim is obvious or has no inventive step as compared to prior public knowledge or prior use in India including the prior publication. The prior public knowledge can be considered on the basis of two factors namely (i) the information contained in the published document which has been used by some groups or even individual and (ii) common general knowledge. The common general knowledge means the information is common knowledge in the art to the person who is duly qualified and engaged in the art to which the invention relates. In case of ***Monsanto Company v. Coramandal India Products (P) Ltd.***, (1986 AIR 712), it was held that to satisfy the requirement of being publicly known it is not necessary that it should be widely used to the knowledge of the consumer public. It is sufficient if it is known to the persons who are engaged in the pursuit of the knowledge of the patented product or process either as men of science or men of commerce or consumers. Therefore the proof of common knowledge is decided on the basis of evidences submitted by such person in the art. Accordingly the issue of obviousness is decided on the basis of the information available in the prior art or state of art and prior common knowledge based on the evidences submitted by the person skilled in the art or person practically engaged in that art.

Generally, if what is claimed in a patent lies within the development of an existing trade i.e. this development could be carried out by any skilled person in that trade without any substantial inventive step then subject matter is considered to be obvious. Therefore the way in which the invention has been arrived at is considered to be more relevant in judging whether or not the invention is obvious. If a subject matter appears to be obvious then it does not involve any "inventive step" and if any subject matter involves "inventive step", obviously it is not "obvious". **[Ref: AIR 1945 orders 6 at 9.9].** The other criteria for determination of obviousness or lack of inventive step have been discussed in Module 9 relating to opposition.

It may however be noted that while considering the issue of obviousness or lack of inventive step in revocation proceedings on the basis of some documents or use no account shall be taken of personal document or secret trial or secret use of the invention and in case where the patent is for a process or for a product as made by a process described or claimed, the importation into India of the product made abroad by that

process shall constitute knowledge or use in India of the invention on the date of the importation, except where such importation has been for the purpose of reasonable trial or experiment only.

g) **Invention is not useful:** This ground of revocation is applicable when a patent has been obtained for an invention, which is not useful. 'Not useful' means that the invention either does not work to achieve the intended results as mentioned in the specification or does not work at all.

h) **The complete specification does not sufficiently and fairly describe the invention and does not disclose the best method by which it is to be performed:** This ground for revocation is applicable when the complete specification does not sufficiently and fairly describe the invention to be understood by the person ordinarily skilled in the art, and the method by which the alleged invention is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection. Therefore, the complete specification must describe at least an embodiment of the invention as claimed in each of the claims. Therefore, while alleging this ground, the difficulties faced in performing the invention in accordance with the description must be pointed out. In case the intended results are not achieved, no further evidences are required.

Further, the description of the invention in the complete specification must be sufficient to enable concerned person in the relevant field of technology to put the invention in effect without doing further experimentations and the description must be fair and must not be unnecessarily so difficult to be understood. However, in order to determine the sufficiency of description, the matter should be judged individually on merit of the disclosure made in specification. It may be noted that a patent is granted in lieu of the disclosure of the invention to the public so that on expiry of the term of protection, it can be exploited by the public without facing any difficulty. Here, it is pertinent to mention that it is obligatory for an applicant to describe the invention sufficiently and fairly in the specification **(AIR 1969 Bom 255 at pp. 266).**

i) **The scope of claims is not clearly and sufficiently defined and not fairly based on the matter disclosed in the specification;** Under this provision, there are two aspects of the ground for revocation i.e. (i) that the scope of any claim is not sufficiently and clearly defined and (ii) the claim is not fairly based on the matter disclosed in the specification. Generally for revocation of patent the respondent raises the issue of an ambiguity in the claims. Once issue is raised by the defendant, it becomes imperative on the plaintiff to satisfy the court that the claims are unambiguous and clear to understand and to follow so that the intended results can be achieved by following the instruction in the claims. In ***Natural Colour Kinematograph Co. Ltd v. Bioschemes*** **(32 RPC 256, p. 268),** it was observed that, while preparing the specification, the applicant must take utmost care in observing good faith and intentional introduction of an ambiguity for the purpose of misleading the public would be sufficient to avoid patent.

j) **Patent was obtained by false suggestion or representation:** The Patent may be revoked on the ground that it was obtained on false suggestion or representation. As there is no limitation to their nature, such false suggestion or representation may relate to the disclosure made in the specification where intended results are not achievable by following the directions contained therein or to any fact or statement required to be made in connection with the grant during the prosecution of the application in the patent office. However, the defendant is required to give the details or particulars of false suggestion or the nature of misrepresentation made by the patent applicant (plaintiff).

k) **Subject matter of claims is not a patentable invention:** This ground for revocation would appear to be applicable particularly to those inventions which are prohibited to be patentable under the provisions of section 3 and 4 of the Act. The details have been given in the module-9 relating to opposition of patent.

l) **Claimed invention was secretly used before the priority date in India:** The ground of prior secrete use of the invention in India for revocation of patent will invalidate the patent except where the invention has been used either for the purpose of reasonable trial or experiment only or by the Government or by any person authorized by the Government or by a Government undertaking, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention directly or indirectly to the Government or person authorized as aforesaid or to the Government undertaking or by any other person, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention, and without the consent or acquiescence of the applicant or of any person from whom he derives title. It was held by the court that if the secret use is for trial or experimental purposes, the patent will be valid ***(AIR 1945 OUDH 6ACP.9).*** However the plaintiff is required to give the particulars about no-secret use of the invention before the priority date.

m) **Failure to disclose information regarding Foreign Application:** Section 8 provides for disclosure of information regarding foreign application. If the applicant for the patent has failed to disclose to the Controller the information required in respect of such corresponding foreign applications for substantially same invention or details of the processing of the corresponding foreign application or has furnished information which in any material particular was false to his knowledge, the patent may be revoked on this ground.

n) **Non-compliance of secrecy direction and filing outside India without prior permission:** Section 35 provides for imposition of secrecy direction by the Central Government in the case where the invention has been considered relevant for defence purpose and accordingly Controller may give prohibit or restrict the publication of information or communication of the information. If an applicant has contravened any such direction, the patent granted shall be revoked under this ground.

If an applicant has made or caused to be made an application for the grant of a patent outside India in contravention of provisions of Section 39, the patent granted for the same application shall be revoked under this ground.

o) **Leave to Amendment of specification obtained by fraud:** The Controller is empowered to allow amendment of the application, complete specification

on application made by the applicant for patent or patentee under Section 57 subject to the condition that such amendments are within the purview of the provision of Section 59. The High Court /IPAB has also been empowered to order for amendment of complete specification under revocation proceeding under Section 58. If the permission to amend the specification was obtained by fraud, it is a ground for revocation. However the defendant has to prove that a fraud was committed while obtaining the permission for amendment.

p) **Specification wrongly mentioning or not disclosing geographical origin source of biological material:** Under this ground a patent may be revoked if the applicant had wrongly mentioned or failed to disclose in the complete specification the source or geographical origin of biological material used for the invention. This ground for revocation was introduced by the Patents (Amendment) Act, 2002 mainly to ensure to protect bio-piracy and misappropriation of the biological resources. And also disclosure of the source or geographical origin of the biological material in the complete specification would encourage the sharing of the benefits out of the patent by the country whose biological resource are used by the applicant. In the absence of disclosure or wrongful disclosure it would be very difficult to find out as to which country's biological material or resource has been used by the applicant and this would lead to sever confusion to determine the source as well as benefit sharing. Such kinds of provisions are also helpful to determine as to whether the applicant has taken prior permission from the competent authority to file the application for patent for the inventions utilizing the biological resources of the country.

q) **Inventions is Anticipated by traditional knowledge:** This ground for revocation is applicable if any invention claimed in the specification is anticipated by the knowledge available orally or otherwise within any local or any indigenous community in India or elsewhere. This ground was introduced by the Patents (Amendment) Act, 2002 mainly to protect the Traditional Knowledge (TK) including the properties of medicinal plants, herbal products using some medicinal plants such as Momordica charantia, turmeric, neem, tulsi, etc, available in India or any part of the world existing orally or otherwise. It may be noted that all other grounds need written documentary evidences whereas under this provision, an oral knowledge can be sufficient and can be recognized in the evidence.

11.5 GILLETTE DEFENCE

This kind of defence was creation of British jurisprudence where the defendant can allege that the alleged infringement was not novel at the date of plaintiff's letter patent. Accordingly, if the defendant can prove that the prohibited act is merely what was previously disclosed in a publication which can be relied upon against the validity of patent without any substantial or patentable variation having been made; it would be a good defence. In ***Gillette Safety Razor Co. v. Anglo-American Trading Co. Ltd*** **(30 RPC 465 P 480),** Lord Moulten stated that the defence that " the alleged infringement was not novel at the date of plaintiff's Letter Patent" was a good defence in law. In such cases the patent to be revoked would be so wide to cover those non-patentable insignificant variations which would try to differentiate the patent from what was already known. In such cases the defendant must succeed either on the validity or non-infringement. The Gillette

defence was also applied by the Indian High Courts in Various cases. It was held by Bombay High Court in ***Hindustan Lever vs. Godrej Soaps Limited*** **(1999 PTC(17) P-756** that a Gillette defence can be considered in the case where the invention is prima facie not patentable under the provisions of section 3 of the Act.

Other Defences as stated above are of self explanatory in nature and there need to require any explanation further in this regard.

Self Assessment Question **(Spend 3 minutes)**

2) Define Gillette defence.

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11.6 RELIEF OR REMEDY

Although, the patent law provides certain defence for the respondent, while he is being prosecuted for the infringement of the patent rights, at the same time it also provides certain reliefs or remedies to the plaintiff in case he has successfully proved the infringement of his right by the defendant. According to the provisions of section108 (1) of the Act, in the infringement proceedings, the court may grant an injunction with certain terms and conditions or at the option of the plaintiff, either damage or an account of profit in lieu of damage.

However, under certain circumstances of the case, the court may also order to seize, forfeit or destroy the infringed goods or the materials or implements used in the creation of such goods without payment of any compensation (section-108(2)).

a) **Injunctions:** Generally in any suit for the infringement of patent right, the court grants an injunction to restrain the respondent from doing that prohibited act as a punitive relief. Therefore granting of injunction is an interim kind of relief to the plaintiff before the suit is finally is disposed by the court awarding the damage or an account of profit. The grant of any injunction is not an automatic but is discretion of the court for which exceptional circumstances are to be shown.

Further any injunction granted by the court is for a limited period of time but no case would exceed beyond the term of patent. Secondly it can be terminated at any time by the court depending upon the circumstances of the case. There may be two types of injunctions which could be generally granted by the court, namely (1) temporary or interlocutory injunction and (2) permanent injunction. The courts sometimes grant ex-parte injunctions also depending upon the circumstances of each case.

It may however be noted that due to delay in the proceedings and final disposal of the suits for infringements, the plaintiffs now a days are mainly interested in getting the injunction as they serve their purpose to stop the

defendant from doing the infringement acts. The terms and conditions or circumstances under which these injunctions may be granted are discussed below in detail.

1) **Temporary or interlocutory injunction:** While filing the suit for the infringement, generally all plaintiffs make a plea for the interim or temporary or interlocutory injunction to restrain the defendants to commit further any act of infringement until the suit is finally adjudicated by the court. Under the provisions of Civil Procedure Code, the courts have at their discretion, power to grant these kinds of injunctions. It was held in ***NRDC v. DCM Ltd*** **(AIR 1980 Delhi 132)** that for the grant of temporary injunction, principles applicable to the infringement of patent actions are that (i) there is a prima facie case, that the patent is valid and infringed,(ii) that the balance of convenience is in favour of grant of injunction and (iii) that the plaintiff will suffer irreparable loss.

Similarly it was observed in ***Hindustan Lever v. Godrej Soaps Limited*** **(1999 PTC(17) P-766** that in order to get temporary injunction the plaintiff needs to prove following things before the court, namely (i) the plaintiff has a prima facie case to prove by evidence that patent is availed patent,(ii) the plaintiff has prima facie evidence to prove that there has been an infringement by the defendant and(iii) the plaintiff has balance of convenience in his favour. It was further observed that as a rule, if the patent is a new one and defendant has challenged it, the court may refuse to grant any interim or temporary injunction. However, if the patent is sufficiently old and has been worked, the court would presume the patent to be valid one for the purpose of a temporary injunction and grant such injunction. In case the patent is more than 6 years old and there has been actual user, it would be safe for the court to proceed upon the presumption that patent is a valid one to grant temporary injunction. In ***NIKY TASHA India Pvt Limited v. M/s. Faridabad Gas Gadgets Pvt Limited*** **(AIR 1985 Delhi 136),** it was held that the interlocutory injunctions will not normally be granted where damage will provide an adequate remedy should the claim succeed. Further, the court will not grant the interlocutory injunction unless satisfied that there is a real probability of plaintiff succeeding on the trial of the case. Where the design is of a recent date, no injunction should be granted. More so, when there is a serious question as to the validity of the design to be tried in the suit and an application for cancellation has been made.

It has been pointed out in "Law and Practice of Injunction' by Kerr(6th Edition 1981) that, if one clear instance of infringement or strong prima facie case of infringement is made out and the plaintiff has not been guilty of latches, the court will generally grant an interlocutory injunction in the following case(i) when the validity of patent has already been established in a previous action (ii)when the patent is of old standing and the enjoyment under it has been uninterrupted (iii) when the validity of patent is not in issue; notwithstanding that that the defendant offers to keep an account. Conversely, in, general, if the patent is new and its validity has not been established and endeavored to be shown that it ought not to have been granted, the Court will not interfere.

The court however has power to grant injunctions immediately in case of partially valid patent cases as the partially valid patents can be good prima facie evidence on the validity of patent. The provisions of **Section 114** of the

Patents Act, 1970 also provide similar support for the grant of injunction in case where some of the claims in the specification are partially valid and other claims are invalid. Therefore the issue of grant of injunction is a mixed question of law and facts based on the evidence.

2) **Permanent injunction:** The principles of permanent injunctions are similar to that applicable for temporary or interlocutory injunctions. However the permanent injunctions are granted after full hearing of the case where the court is fully satisfied with the fact that the patent being infringed is fully valid and there has been infringement by the defendant and its further continuance is detrimental to the interest of the plaintiff due to which has suffered irreparable loss. Permanent injunctions are sometimes treated as permanent remedy in the patent infringement suits.

3) **Ex-parte injunction:** The courts while granting either the temporary or interlocutory injunctions, grant these injunctions as ex-parte. The ex-parte injunctions are granted normally in case where certificate of validly of patent was granted by the court previously in other proceedings and there was a prima facie case of infringement which has been established beyond any doubt. In ***PDC Limited & others v. Khandelwal & Others*** **2007 (35) PTC 436 (Mad),** it was held by the court that ex-parte injunction can be granted only after an effective scrutiny of both oral as well as documentary evidence. The following guidelines were formulated by the court for considering the grant of ex-parte injunctions, namely,

   i) Whether the plaintiff and the primary defendant are residing outside the state and their identity, address etc. are easily known;

   ii) Whether sales of the offending products are not on a commercial scale;

   iii) If the grant of interim injunction is going to result in the closure of operation/ business of the defendant; if the ex-parte injunction has a nation wide operation and is not just confined within the state;

   iv) Whether the dispute involves patent issues the trial court should carefully pursue the certificate of validity of patent;

   v) Whether an ex-parte injunction should not be granted in cases where no evidence of proof of infringement has been filed by the plaintiff and;

   vi) In patent case, the trial court has to carefully note the distinction between product patent and the process patent. If the plaintiff alleges a violation of process patent, then the ex-parte injunction should not be granted unless the plaintiff has adduced the evidence of an independent scientist/ other technical expert who has tested the plaintiff's and defendant's product and arrived at an independent finding as to the identity of the processes used. In process patent cases, the opportunity must be given to the defendants to explain how their process does not constitute the infringement within the meaning of Section 104-A of the patent act.

Therefore for the grant of ex-parte injunction the court must be satisfied about the above mentioned conditions by the plaintiff in case he is requesting for the same.

b) **Damages:** Apart from an injunction, the successful plaintiff at his option is also entitled either for damages or an account of profit under Section 108

of the Act. However the amount of damages for which he is entitle would depend on the loss sustained by the plaintiff or patentee due to infringing act of the defendant. However in case the plaintiff elect to an account of profit, then it would be immaterial as to how much of his patented invention was appropriated by the defendant and how much profit the defendant earned out of his total business. Therefore the profit, for which the plaintiff would be entitled, would be limited to the profit earned by the appropriation of the infringed goods.

As mentioned above, it may be remembered that under the provisions of **Section 114** of the Patents Act, 1970 where some of the claims in the specification are partially valid and other claims are invalid the court can only grant an injunction depending upon the circumstances but where the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the court has discretionary power to grant relief in respect of any valid claim which is infringed as cost and as to the date from which damage or an account of profit should be reckoned by considering the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there.

However in certain case the plaintiff is not entitled to claim damages but court has power to grant an injunction on his satisfaction of the circumstances and conditions of the situation..

i) **Innocent infringement:** The damage or an account of profit shall not be granted against the defendant who proves that at the date of infringement he was not aware and had no reasonable grounds for believing that the patent existed **[Section-111(1)]**

ii) The court may also refuse to grant any damage or an account of profit in respect of infringement committed after a failure to pay the renewal fee within the prescribed period and before any extension of that period **[Section-111(2)]**

iii) The court shall also not grant any damage or an account of profit in respect of use of invention before the publication of decision allowing the amendment of specification under Section 57 by way of correction, disclaimer or explanation unless the court is satisfied that the specification as originally published was framed in good faith and with reasonable skill and knowledge. **[Section-111(3)]**

iv) Where the validity of patent has been certified by the court and certificate of validity of claims has been issued by the Appellate board or High Court in other proceedings, the plaintiff would be entitled for the for the payment of full cost ,charges and expenses of and incidental to such suits or proceedings but where the party disputing the validity of claims satisfied the court that he was not aware of the grant of the certificate when he raised the dispute and withdrew forthwith such defence when he became aware of such a certificate in such situation the payment of full cost, charges and other expenses will not be ordered by the court **[Section-113(2)].**

11.7 DECLARATION AS TO NO-INFRINGEMENT

The court has discretion power to make declaration as to non-infringement of the use of the patented process or the product by him where a person making a suit for such declaration against the patentee proves that he has applied in writing to the patentee or exclusive licencee for a written acknowledgements and has furnished him with full particulars in writing of the process or article in question and that the patentee or licencee has refused or neglected to give such an acknowledgment **[Section-105(1)].** However the validity of the claims of the specification shall not be questioned while making a suit for such declaration. Moreover, the making or refusal of such declaration by the court would not be deemed to imply that the patent is valid or invalid **[Section-105(3)].** The suit for such declaration can be filed only after publication of grant of patent. **[Section-105(4)].**

Relief in case of groundless threats: In case where any person threatens any other person by circulars or advertisement or by communications oral or in writing addressed to that or any other person with proceedings of infringement of patent, the aggrieved person may bring a suit against him for the reliefs namely (1) a declaration to the effect that the threats are unjustified;(2) an injunction against the continuance of the threats and(3) such damage, if any, as he has sustained **[Section-106(1)].** In such case the court has power to grant all or any relief as prayed for in the suit unless the defendant proves that the acts in respect of which proceedings were threatened constitute or would constitute, if done an infringement of patent rights **[Section-106(2)].**However mere notification of existence of patent would not amount to a threat of infringement proceedings.

11.8 SUMMARY

- There are various defenses available under the provision of the Patent Act, 1970 against any suit for infringement.
- The grounds for revocation of patent can be pleaded as defense in counterclaim by the defender.
- Gillette defense is a creation of British Jurisprudence where the defendant can allege that the infringement was not novel at the date of plaintiff letter patent.
- There are number of relief or remedies available to the respondent, while he is being prosecuted for the infringement of the patent rights.

11.9 TERMINAL QUESTIONS

1) Mention the various revocation grounds which can be pleaded as defence by the defendant.
2) Discuss the relief or remedies available to the respondent.

11.10 ANSWERS AND HINTS

Self Assessment Questions

1) yes
2) This kind of defence was the creation of British jurisprudence where the defendant can allege that the alleged infringement was not novel at the date of plaintiff's letter of patent.

Terminal Questions

1) Refer to Section 11.4

2) Refer to Section 11.6

11.11 REFERENCES AND SUGGESTED READINGS

1) Patent law by P.Narayanan. Fourth Edition, 2006 published by Eastern Law House.

2) Terrell on the Law of Patent, Sweet & Maxwell, Limited, London. U.K.

3) Intellectual Property by W.R. Cornish, Sweet & Maxwell, Limited, London. U.K.

4) The Patents Act,1970 as amended up to 2005 and the Patents Rules 2003 as amended up to 2006.

UNIT 12 INTELLECTUAL PROPERTY APPELLATE BOARD (IPAB)

Structure

12.1 Introduction

12.2 Objectives

12.3 Position in India

12.4 Amendments in the Patents Act

12.5 Objective of IPAB

12.6 Location of IPAB and its Benches

12.7 Salient features of the IPAB

12.8 Qualifications of the Chairman and Vice-Chairman

12.9 Qualifications of the Technical Member Patents

12.10 Transfer of Cases

12.11 Operationalisation of IPAB for Patents

12.12 Filing of Appeal in IPAB – Patents

12.13 Filing of Appeal in IPAB – Trademarks

12.14 Guidelines by IPAB

12.15 IPAB Under Trademarks Act

12.16 Summary

12.1 INTRODUCTION

In this unit we will study the remedies available to the applicant for patent against the adverse decision of the Controller. What third party remedy is possible against the wrongly granted patents? Which authority is competent and has the jurisdiction to process appeals arising from the decisions of the Controller under various provisions of the Patents Act? Where the application for revocation and rectification register of patents can be filed?

Intellectual property is a specialized subject needing special expertise to deal with. Appellate Tribunal for Intellectual property is a recognized system in many countries of the world. With experienced hands in the field of patent law as Technical Member in Appellate Tribunal has raised the quality of decision making process in patent law matters. Similarly the applications for revocation of patent and rectification register dealt earlier by the courts are now be heard more expeditiously by Appellate Tribunals.

12.2 OBJECTIVES

After reading this unit, you should be able to:

- describe the establishment of Intellectual Property Appellate Board;
- explain the various amendments in the Patents act;
- discuss the salient features of IPAB; and
- describe the objective of IPAB.

12.3 POSITION IN INDIA

Until April 2007, appeals from the Controller's order and petitions for revocation of patent were being filed before the High Courts of Delhi, Chennai, Kolkata, and Mumbai. There were many conflicting decisions of courts creating legal and administrative difficulties as regards the patent law in India, Due to heavy burden on the courts some cases were not taken up in time and term of patent gets over. In order to mitigate these difficulties it was decided to establish a specialized Intellectual Property Appellate Board (IPAB) to adjudicate the matters pertaining to patent law.

Establishment of Intellectual Property Appellate Board (IPAB).

The Intellectual Property Appellate Board (IPAB) was set up at Chennai under Section 83 of the Trademarks Act 1999.It was made operational for trademarks law from 20th September 2002. It has now been made operational for the purposes of the Patents Act, 1970 from 3rd April 2007. Earlier this Board was operational to hear against the decisions of the Registrar under the Trademarks Act and the Geographical Indications Act only.

12.4 AMENDMENTS IN THE PATENTS ACT

The Patents Act 1970 (39 of 70) was amended by the Patents (Amendment) Act, 2002 (38 of 2002) and the Patents (Amendment) Act, 2005 (15 of 2005) to make provisions for establishment of appellate board for patents matters. Under Section 116 of the said Act, Appellate Board established under section 83 of the Trade Marks Act, 1999, was enjoined to be the Appellate Board for the purposes of the Patents Act. However, it provided that the qualification of the Technical Member for the patents shall be those specified in 116 (2). Section 117 (B) further lays down that the provisions of sub-Section 2 to 6 of Section 84, Section 87, Section 92, Section 95 and Section 96 of the Trademarks Act, 1999 shall apply to the Appellate Board in discharge of its duties/functions under the Patents Act as they applied to it in the discharge of its functions under Trade Marks Act, 1999.Thus IPAB established under the Trade marks Act also function as Appellate authority for patents when the IPAB bench comprises of one Judicial Member and one Technical Member patent.

12.5 OBJECTIVE OF IPAB

Main objective for the establishment of the Intellectual Property Appellate Board is to provide for an expeditious adjudication of appeals against the Controllers order by judicial and technical experts promptly which at present being are heard

according to Judicial procedure followed by Courts . With the constitution of the Appellate Board a team of full time specialists in IP including judicial and technical experts, would contribute to and formulate rulings on par with international standards. This would not only reduce the burden on the High Courts who are already over-burdened with work, but would also result in quicker disposal of appeals thereby providing faster relief to the litigants in terms of cutting down delays and expenses. This will enable association of experts in appellate decisions and provide for expeditious disposal of appeals. This was specially done to deal with the expected increase in the volume of appeals in the future and in order to have speedy, timely and less expensive disposal of appeals, etc. This would elevate the status adjudication in patent matters by

- Establishment of a techno-legal mechanism for quick disposal of appeal cases,
- Evolvement of sound precedents and practices,
- Ensuring that appeal from the Controller's decision is dealt with by judicial and technical experts promptly, and
- Avoiding conflicting decisions which have been given by various High Courts in the past.

12.6 LOCATION OF IPAB AND ITS BENCHES

The IPAB is located in Chennai and the Benches of the IPAB also sit in Ahmedabad, Delhi, Mumbai and Kolkata in addition to Chennai in respect of trademarks matters.. This board is headed by Chairman. Its other members are Vice-chairman and Two Technical Member (Trademarks) and One Technical Member (Patent). Separate benches are constituted for hearing Patent and trademarks cases. Chairman of the IPAB notify the composition of bench for patents and trademarks and allot cases to these benches from time to time for disposal.

12.7 SALIENT FEATURES OF THE IPAB

a) *Exclusive Appellate Jurisdiction*

The IPAB has been conferred exclusive jurisdiction to hear appeals from the decisions, orders or directions of the Controller of Patents or Central Government in respect of matters specified in Section 117A of the Patents Act.

b) *Original Application (OA) Jurisdiction*

The IPAB has been conferred an original jurisdiction to receive application for revocation of patent under Section 64 and Rectification of register of patents under Section 71. Procedure for making such application is prescribed under Section 117D (1).

c) *Non Applicability of Civil Procedure Code*

The Code of Civil Procedure is not applicable to the proceedings before the IPAB. Earlier when the appeals were heard by the High Courts, procedural compliance used to consume much time which invariably resulted in delayed disposal of the appeals. But now simplified rules and freedom from CPC would ensure faster disposal of matters before the IPAB.

d) *Power of IPAB to make rules*

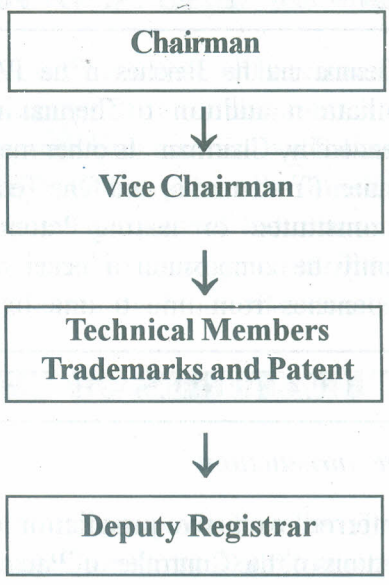
IPAB has been vested with the powers to make its own rules under section 117H in respect of conduct and procedure in relation to all proceedings before it under the Patents Act. No such rules have been notified by IPAB for the purposes of the patents Act so far. While there is no provision of appeal against the order of the Appellate Board, an appeal by way of Writ may be filed before the High Court.

e) *Time allowed for Appeals*

An appeal against an impugned decisions, orders or directions of the Controller or Central Government should be preferred before the IPAB within a period of three months from the date of such order. However, IPAB may allow further time in accordance with the rules made by it, provided the Appellate Board is satisfied that there exists sufficient cause for extending the time for doing any act prescribed under the rules. No Rules for prosecution of appeals under the patent Act has been framed by IPAB so far. However High Court rule are being followed at present by IPAB.

f) *Structure of IPAB*

The Appellate Board consists of a Chairman, Vice-Chairman as Judicial and Technical Members.



g) *Composition of an IPAB Bench for patents*

Section 117B of the patent act states that provisions of Sub Section (2) to (6) Section.84, Section. 87, Section.92. Section.95 and Section.96 of Trademarks Act, 1999 (47 of 1999) apply to the patent act *mutatis mutandis* to IPAB or Its Benches under the Patents Act. 1970. Therefore, as per provisions of Sub Section (2) of Section 84 of the Trademarks Act, 1999 (47 of 1999) an IPAB Bench shall consist of one Judicial Member and one Technical Member. Every Bench of the IPAB for patents comprises a Judicial Member and a Technical Member. Technical member for patent shall have the qualification prescribed under Section 116 (2) where bench is constituted to deal with patens matters.

12.8 QUALIFICATIONS OF THE CHAIRMAN AND VICE-CHAIRMAN

A person can qualify for appointment as the Chairman if he is, or has been, a judge of a High Court; or has, for at least two years, held the office of a Vice-Chairman. For appointment as the Vice-Chairman, a person should have, for at least two years, held the office of a Judicial Member or a Technical Member; or been a member of the Indian Legal Service and held a post in Grade I of that Service or any higher post for at least five years. A person shall be qualified for appointment as a Judicial Member if he has been a member of the Indian Legal Service and has held the post in Grade I of that Service for at least three years; or has, for at least ten years, held a civil judicial office.

12.9 QUALIFICATIONS OF THE TECHNICAL MEMBER PATENTS

The Patents Act provides the particulars of the qualifications for appointment as a technical member of the IPAB. According to Section 116(2) for appointment as a Technical Member, a person should have, for at least five years, held the post of Controller under the Patents Act, 1970 or has exercised functions of Controller under the Patents Act, 1970 or for at least ten years, functioned as a registered patent agent and possesses a degree in engineering or technology or a masters degree in science or equivalent.

12.10 TRANSFER OF CASES

The Chairman has the power to transfer cases from one Bench to another either on an application by a party to the hearing or on its own. This discretionary power will ensure fixing the place of hearing taking into consideration the convenience of the parties.

Appeals from IPAB

Orders passed by the IPAB are subject to appeal before the High Court. It is to be noted that the IPAB has no statutory power to try infringement proceedings. These proceedings are solely under the jurisdiction Courts.

IPAB provisions in the Patents Act

With a view to streamline and give focused approach in the IPR administration, existing Intellectual Property Rights Appellate Board established under Section 83 of the Trademarks Act, 1999 was marked to be utilized for the purposes of the patent Act also. This was done by making suitable amendments in the Patents Act, 1970 in the year 2002 and 2005

The Patents Act, 1970 was amended by Patent (Amendment) Act, 2002 (38 of 2002) when exiting provision in Chapter XIX relating appeals to the high court was replace by the new chapter with heading "Appeals to the Appellate Board". This chapter contained provisions relating to constitution, functions, powers of the Appellate Board, qualifications of Technical Member, staff for the Appellate Board, appeals jurisdiction, procedure of Appellate Board, bar of jurisdiction of other forum in matters within the jurisdiction of the Appellate Board, procedure for

rectification before Appellate Board, appearance of Controller before the Appellate board, cost of Controller and transfer of proceedings pending before High Court.

The Patents (Amendment) Act, 2005,(15 of 2005) further extended the jurisdiction of IPAB to include petition for revocation of patent and rectification of register of patents. These amendments were not operationalised when other amendments were brought into force in 2003 as the process for appointment of the Technical member was expected to take time.

12.11 OPERATIONALISATION OF IPAB FOR PATENTS

The provisions of the Patent (Amendment) Act, 2002 and the Patents (Amendment) Act, 2005, relating to the Intellectual Property Appellate Board have now been brought into force from 3rd April 2007 through a notification in the gazette. This marks the beginning of operationalisation IPAB for the purposes of the Patents Act. A notification in the gazette has been published on 3rd April 2007 to transfer all the appeals against the decision of the Controller pending before the various High Courts to the IPAB.

The decisions, orders or directions of the Controller of patents in the proceedings relating to the following sections are appealable before the IPAB

Sec 15 - Refusal or amendment of the application

S.16 - Order for division of application

S.17 - Order for post dating of application

S.18 - refusal of application on the ground of anticipation

S.19 - direction to insert reference in case of potential infringement

S.20 - ordrr for substitution of applicants

Sec25 (4) - order to maintain or amend or revoke a patent in post grant opposition

S.28 - order to mention of inventor as such in patent

S.51 - Direction to co-owners

S.54 - order in respect of patent of addition

S.57 - order for amendment of application/specification/or any other document

S.60 & S.61 - order in respect of restoration of lapsed patents

S.63 - order in respect of surrender of patents

S.69 (3) - refusal to register assignment

S.78 - decision to correct clerical errors

S, 84 (1) to (5) decision on application for compulsory licence

S.85 - order for revocation of patent for non-working

S.88 - order for granting compulsory licence to licensee

S.91 - order for granting compulsory licence on related patents

S.94 - order for termination of compulsory licence

Similarly the orders or directions of the Central Government in the matters relating to the following sections are appealable before the IPAB.

S.66 - direction for revocation of patent in public interest

S.92 - order for availably of compulsory licence on patents notified

12.12 FILING OF APPEAL IN IPAB – PATENTS

The IPAB rules specify the documents required for filling an appeal in IPAB. These documents includes

1) Memo of parties with address
2) Appeal under Section 117A drawn on form 2 or form 3 or form 4 as applicable (in triplicate) with evidence in the form of affidavit with prescribe fee (with sufficient number of copies as there are respondents)
3) Certified copy of the order against with appeal is filed
4) Copy of the supporting documents such as FER, response, written submission, citations etc.
5) Copy of patent specification as filed including amended versions.
6) Power of attorney
7) Vakalatnama
8) If condonation of delay is sought application on form 5 with affidavit of the appellant with prescribe fee

12.13 FILING OF APPEAL IN IPAB - TRADEMARKS

The IPAB rules specify the documents required for filling an appeal in IPAB. These documents includes

1) Memo of parties with address
2) Appeal under Section117A drawn on form (in triplicate) with evidence in the form of affidavit with prescribe fee (with sufficient number of copies as there are respondents /registered users/authorized users)
3) Certified copy of the order against with appeal is filed
4) Copy of the supporting documents
5) Power of attorney
6) Vakalatnama
7) If condonation of delay is sought application on form 3 with affidavit of the appellant with prescribe fee

12.14 GUIDELINES BY IPAB

Following Guidelines are issued by Intellectual Property Appellate Board to facilitate the process of proceedings before the board.

1) Pleadings shall be brief and not argumentative. The legal provisions and the extracts from decisions shall not form part of the pleadings. They should not be repetitive.

2) Pleadings must be verified by the party and not the counsel.

3) Repetition of pleadings shall be avoided while filing Miscellaneous Petitions

4) It shall be typed on foolscap green sheet on both sides having 5cm margin on either side.

5) All the documents filed into the Registry shall be of the same size.

6) No change of Vakalat shall be accepted without the consent from the earlier counsel.

7) The counsel shall ensure that the paper book containing pleadings shall be numbered before serving on the other side so that the paper book filed in the Registry and the paper book with the counsel on both sides are identically paginated.

8) The address for service in India of the respondent must be given, if the respondent resides/carries on business outside India.

9) The members of the Bar shall be ready to argue the appeal after service of notice and the date of hearing is fixed.

10) The Applicant shall number his evidence as Exhibit A1, A2 etc. The respondent shall number his documents as Exhibit R1, R2 etc. If any additional evidence is filed along with any miscellaneous petition, that evidence will be numbered continuously with reference to the documents originally filed. E.g. if the evidence filed originally was from Ex. A1 to A20, then the additional evidence will start from Ex. A21. The same method will be followed by the respondent.

11) Extension of time for filing counter statement/reply shall not be sought on vague reasons. The two months' period provided by law is sufficient, and unless there is a compelling reason no further extension must be sought for and extension beyond actual period of two months will be granted on payment of costs and filing the counter statement/reply on the stipulated date.

(***Source:*** IPAB website)

12.15 IPAB UNDER TRADEMARKS ACT

Section 83 of the Trademarks Act, 1999 provides for establishment of an Appellate Board to be known as the 'Intellectual Property Appellate Board' to exercise the jurisdiction, powers and authority conferred on it by or under the Act. The provisions relating to IPAB are contained in Sections 83 to 100 of this Act. The IPAB has been established by the Central Government with effect from 15th September, 2003 vide Government of India Gazette Notification No. S.O.1049 (E) dated 15th September, 2003 with its office at Chennai. The IPAB

has been vested with the powers to make its own rules under section 92 in respect of conduct and procedure in relation to all proceedings before it under this Act In exercise of such powers conferred upon it a notification was issued on December 5, 2003, which laid down the Rules relating to the proceedings for the purposes of Trade Marks Act before the IPAB. The following rules were made by the IPAB to regulate its procedure for trade marks matters.

12.16 SUMMARY

- Intellectual Property Appellate Board (IPAB) was set up at Chennai under Section 83 of the Trademarks Act, 1999.
- The main objective of the establishment of the IPAB is to provide an expeditions adjudication of appeals against the controllers order by judicial and technical experts promptly which at present being are heard according to judicial procedure followed by Courts.
- The salient features of the IPAB include.
  a) Exclusive Appellate Jurisdiction
  b) Original application (OA) jurisdiction.
  c) Non applicability of Civil Procedure Code
  d) Power of IPAB to make rules
  e) Time allowed for appeals
  f) Structure of IPAB
  g) Composition of an IPAB bench for patents.
- There are number of guidelines by IPAB issued by Intellectual Property Appellate Board to facilitate the proceedings before the Board.
- Section 83 of the Trademarks Act, 1999 for the establishment of an Appellate Board to be known as the "Intellectual Property Appellate Board" to exercise the jurisdiction, powers and authority conferred on it by or under the Act.

12.17 TERMINAL QUESTIONS

1) Explain the objectives of IPAB.
2) Describe the salient features of IPAB.
3) Write a note on the operationalisation of IPAB for Patents.

12.18 ANSWERS AND HINTS

Terminal Questions

1) Refer to Section 12.5
2) Refer to Section 12.7
3) Refer to Section 12.11

1. Intellectual Property Appellate Board (Procedure) Rules, 2003

NOTIFICATION
NEW DELHI , THE 5th DECEMBER, 2003

GSR 929(E).- The following rules made by the Intellectual Property Appellate Board to regulate its procedure, in exercise of powers conferred upon it by section 92 of the Trade Marks Act, 1999 (47 of 1999), are hereby published for general information:

MINISTRY OF COMMERCE AND INDUSTRY
DEPARTMENT OF INDUSTRIAL POLICY AND PROMOTION
INTELLECTUAL PROPERTY APPELLATE BOARD

INTELLECTUAL PROPERTY APPELLATE BOARD (PROCEDURE) RULES, 2003

In exercise of the powers conferred by section 92 of the Trade Marks Act, 1999 (47 of 1999), the Appellate Board hereby makes the following rules, namely :-

1) **Short title and commencement:-**

1) These rules may be called The Intellectual Property Appellate Board (Procedure) Rules, 2003.

2) They shall come into force on the date of their publication in the Official Gazette.

2) **Definitions:-**

In these rules, unless the context otherwise requires-

a) **"Act"** means the Trade Marks Act, 1999 (47 of 1999);

b) **"address for service"** means the address furnished by an applicant or appellant or respondent or his authorised agent or his legal practitioner at which service of summons, notices or other processes may be effected;

c) **"agent"** means a person duly authorised by an applicant or appellant or respondent to present application, appeal, counter statement, reply, rejoinder, evidence or any other document on his behalf before the Appellate Board and shall include an agent referred to in section 145;

d) **"appeal"** means an appeal under section 91 of the Trade Marks Act,1999 and includes Original Appeal (O.A.) and Transferred Appeal (T.A.);

e) **"appellant"** means a person making an appeal to the Appellate Board under section 91;

f) **"application"** means an application for removal of registered trade mark from the register under section 47 or rectifying the register under section 57 or section 125;

g) **"Deputy Registrar"** means the Deputy Registrar of the Appellate Board and includes any officer to whom the powers and functions of the Deputy Registrar may be delegated;

h) **"fee"** means the fee prescribed under the Second Schedule of these rules;

i) **"form"** means a form specified under the First Schedule to these rules;

j) **"legal practitioner"** shall have the same meaning as is assigned to it in the Advocates Act, 1961 (25 of 1961);

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

l) **"pleadings"** includes applications or appeals, counter statements, rejoinders, replies and evidences supplementing them and other documents permitted to be filed before the Appellate Board ;

m) **"Registry"** means the Registry of the Appellate Board;

n) **"section"** means a section of the Act;

o) **"transferred application or appeal"** means an application or an appeal or other proceedings which has been transferred to the Appellate Board under section 100;

p) words and expressions used and not defined in these rules but defined in the Act shall have the meanings respectively assigned to them in the Act.

3) **Form of procedure of application or appeal:-**

1) An application shall be filed in the Form 1 annexed to the Trade Marks (Applications and appeals to the Intellectual Property Appellate Board) Rules, 2003 by an aggrieved person in the Registry of the Appellate Board;

2) An appeal from any order or decision of the Registrar of Trade Marks shall be filed in the Forms 2,3 or 4 of the Trade Marks (Applications and appeals to the Intellectual Property Appellate Board) Rules, 2003;

3) An application or appeal sent by post shall be deemed to have been presented before the Registry on the day it was received in the Registry.

4) **Payment of fee:-**

The prescribed fees shall be paid through bank draft payable at Chennai drawn in favour of the Deputy Registrar, Intellectual Property Appellate Board.

5) **Language of the Appellate Board:-**

1) The proceedings of the Appellate Board shall be conducted in English or Hindi.

2) All decisions or orders of the Appellate Board shall be either in English or Hindi.

6) **Application or appeal to be in writing:-**

1) Every application, appeal, counter statement, rejoinder, reply or other document filed before the Appellate Board shall by typed or printed neatly.

2) The application or appeal under sub-rule (1) shall be presented in three sets in a paper-book form along with an empty file size envelope bearing full address of the respondent and, in case the respondents are more than one, then, sufficient number of extra paper-books together with empty file size envelopes bearing full addresses of each respondent shall be furnished by the applicant or appellant.

7) **Presentation and scrutiny of application or appeal:-**

1) The Deputy Registrar shall endorse on every application or appeal the date on which it is presented.

2) If, on scrutiny, the application or appeal is in order, it shall be duly registered and given a serial number.

3) If an application or appeal is found to be defective and the defect noticed is formal in nature, the Deputy Registrar may allow the applicant or appellant to rectify the same in his presence and if the said defect is not formal in nature, the Deputy Registrar may allow the applicant or appellant fifteen days time to rectify the defect as he may deem fit. If the application or appeal has been sent by post and found to be defective, the Deputy Registrar may communicate the defects to the applicant or appellant and allow the applicant or appellant fifteen days time from the date of receipt of the communication from the Deputy Registrar to rectify the defects.

4) If the applicant or appellant fails to rectify the defects within the time allowed in sub-rule (3), the application or appeal shall be deemed to have been abandoned.

8) **Documents to accompany application or appeal:-**

1) Every application shall be in triplicate in paper-book form and all evidences shall be in the form of affidavits, if any.

2) Every appeal shall be in triplicate in paper-book form and shall be accompanied by the copies of the order, at least one of which shall be a certified copy against which the appeal is filed, along with evidences in the form of affidavits.

3) Where a party is represented by authorized representative, a copy of the authorization to act as the authorized representative shall be appended to the application or appeal.

9) **Notices of application or appeal to the respondent:-**

A copy of the application or appeal in paper-book form shall be served by the Deputy Registrar on the respondent as soon as the same is registered in the Registry.

10) **Filing of counter statement to the application or appeal and other documents by the respondent:-**

1) After receipt of the application or appeal filed in the prescribed Form 1, 2, or 3 of the Trade Marks (Applications and appeals to the Intellectual Property Appellate Board) Rules, 2003, the respondent may file three complete sets of counter statement in the prescribed Form 1 under these rules containing the reply to the application or appeal along with documents including evidences in the form of affidavits, if any, in paper-book form before the Registry within two months of the service of the notice on him of the filing of the application or appeal. A copy of the counter statement shall be served to the applicant or appellant by the respondent directly under intimation to the Registry.

2) After receipt of the appeal filed in the prescribed Form 4 of the Trade Marks (Applications and appeals to the Intellectual Property Appellate Board) Rules, 2003, the respondent may file three complete sets of counter statement in the prescribed Form 2 under these rules containing the reply to the appeal in paper-book form before the Registry within two months of the service of the notice on him of the filing of appeal. A copy of the counter statement shall be served to the appellant by the respondent directly under intimation to the Registry. The case would then proceed for hearing.

11) **Filing of reply by the applicant or appellant:-**

After receipt of counter statement, the applicant or appellant, may file his reply within two months of the service of the counter statement along with evidence in the form of affidavits, if any, in triplicate in the Registry. A copy of the reply shall be served on the respondent directly under intimation to the Registry.

12) **Exhibits:-**

Where there are exhibits to affidavits, a copy each of such exhibits shall be sent to the other party. The originals shall be left in the Appellate Board for inspection of the other party. These shall be produced at the hearing unless the Appellate Board otherwise directs.

13) **Translation of documents:-**

Where a document in a language other than Hindi or English is referred to in any proceedings, an attested translation thereof in Hindi or English shall be furnished in triplicate to the Appellate Board and a copy thereof shall be served upon the other party or parties directly under intimation to the Registry.

14) **Extension of time:-**

1) If the Appellate Board is satisfied, on an application made to it in the prescribed Form 3 under these rules, that there is sufficient cause for extending the time for doing any act prescribed under these rules (not being a time expressly provided for in the Trade Marks Act, 1999), whether the time so specified has expired or not, it may subject to such conditions as it may think fit to impose, extend the time and inform the parties accordingly.

2) Nothing in sub-rule (1) shall be deemed to require the Appellate Board to hear the parties before disposing off an application for extension of time and no appeal shall lie from any order of the Appellate Board under this rule.

15) **Intervention by third parties:-**

Any person other than the registered proprietor of a trade mark alleging interest in a registered trade mark in respect of which an appeal has been filed under section 91 against the order or decision of the Registrar for the removal of a trade mark or to cancel or vary the registration and to rectify the Register may apply in the prescribed Form 4 under these rules for leave to intervene, stating the nature of his interest and the Deputy Registrar may refuse or grant such leave after hearing, if so required, the parties concerned upon such terms and conditions as he deems fit.

16) **Date of hearing to be notified:-**

The Appellate Board shall notify the parties the date and place of hearing of the application or appeal in such manner as the Chairman may by general or special order direct.

17) **Hearing of application or appeal:-**

1) On the day fixed or on any other day to which the hearing may be adjourned, the parties shall be heard by a Bench of the Appellate Board.

2) In case where the applicant or appellant does not appear at the hearing, the case will be treated as abandoned.

18) **Adjournment of hearing:-**

A party to the hearing may make an application in triplicate for adjournment of the hearing in Form 5 under these rules with the prescribed fee fifteen days before the date of hearing alongwith the concurrence for the adjournment from the other party. The Appellate Board may consider the application and pass such orders as it deems fit.

19) **Award of costs by the Appellate Board:-**

The Appellate Board may award such costs as it deems fit to the parties having regard to all the circumstances of the case.

20) **Order to be signed and dated:-**

(1) Every order of the Appellate Board shall be signed and dated by the Members of the Bench.

(2) The order shall be pronounced in the sitting of the Bench.

21) **Communication of orders:-**

A certified copy of every order passed by the Bench shall be communicated to the parties to the proceedings.

22) **Publication of the orders:-**

The orders of the Bench as are deemed fit for publication in any authoritative report or the press may be released for such publication on such terms and conditions as the Chairman may lay down.

23) **Review petitions:-**

1) A petition in triplicate for review of an order of the Appellate Board may be made to the Registry in the prescribed Form 6 under these rules within two months from the date on which the order is communicated accompanied by a statement setting forth the grounds on which the review is sought. Where the order in question concerns more than one respondent, sufficient extra copies of such petition and statement shall be filed.

2) The Registry shall forward the petition and statement to the respondents to the review petition.

3) The respondents may file counter statement in Form 1 under these rules within two months from the date of receipt of the review petition and shall forward a copy of the counter statement to the petitioner directly under intimation to the Registry.

4) The review petition shall be posted for hearing before a Bench by the Chairman.

24) **Continuation of proceedings after the death of a party, merger, assignment, acquisition or transmission:-**

On the death of a party or by merger, assignment, acquisition or transmission if a new party becomes entitled for continuation of the proceedings, the proceeding would be continued subject to filing a request with evidence in support therefor.

25) **Fee for inspection of records and obtaining copies thereof:-**

1) A fee of Rs.150/- for every hour or part there of shall be charged for inspecting the records of a pending application or appeal or decided case.

2) A fee of Rs.5/- shall be charged for providing xerox copies of each page of the record.

26) **Functions of the Deputy Registrar:-**

1) The Deputy Registrar shall discharge the functions under the general superintendence of the Chairman. He shall discharge such other functions as are assigned to him under these rules or by the Chairman by a separate order in writing.

2) He shall have the custody of the records of the Appellate Board.

3) The official seal of the Appellate Board shall be kept in the custody of the Deputy Registrar.

4) Subject to any general or special directions of the Chairman, the official seal of the Appellate Board shall not be affixed to any order, summons

or other process save under the authority in writing from the Deputy Registrar.

5) The official seal of the Appellate Board shall not be affixed to any certified copy issued by the Appellate Board save under the authority in writing of the Deputy Registrar.

27) **Additional functions and duties of the Deputy Registrar:-**

In addition to the functions and duties assigned under rule 26, the Deputy Registrar shall have the following functions and duties subject to any general or special orders of the Chairman, namely:–

i) to receive all applications, appeals, counter statements, replies and other documents;

ii) to decide all questions arising out of the scrutiny of the appeals and applications before they are registered;

iii) to require any application, appeal, counter statement, replies presented to the Appellate Board to be amended in accordance with the rules;

iv) subject to the directions of the Chairman, to fix date of hearing of the applications or appeals or other proceedings and issue notices therefor;

v) direct any formal amendment of records;

vi) to order supply of copies of documents to parties to proceedings;

vii) to grant leave to inspect the record of the Appellate Board;

viii) to requisition records from the custody of any court, Registrar of Trade Marks or other authority ;

ix) to decide questions relating to extension of time in respect of filing of counter statement, reply, rejoinder, etc.

28) **Dress regulations for the Chairman, Vice-Chairman, Technical Member of the Appellate Board and for the representatives of the parties :-**

i) The dress for the Chairman, Vice-Chairman and other Members shall be white pant with black coat and black tie or a buttoned-up black coat. If the officials are from the High Court Bench, then they shall be in their official robes.

ii) The dress for the professionals who appear before the Appellate Board shall be the professional dress, if any, and in case of other authorised representatives of the parties, it shall be the following :-

a) In the case of male, a black coat with a black tie or buttoned-up black coat over a white pant.

b) In the case of female, a black coat over white or any other sober coloured saree.

c) All other persons appearing before the Appellate Board shall be properly dressed.

29) **Seal and emblem:-**

The official seal and emblem of the Appellate Board shall be such as the Central Government may specify.

Manner of making Applications and Forms of Appeal

Section of the Trade Marks Act, 1999/ Rule of the Trade Marks Rules, 2002	On What Payable	Fees (Rs.)	Form
Section 47/57/125	On application under section 47, 57 or 125 for removal of a trademark from the register or rectification of the register.	5,000	Form 1
Section 91	On appeal from an order or decision of the Registrar of Trade Marks in respect of goods or services falling in one class.	5,000	Form 2
Section 91	On appeal from an order or decision of the Registrar of Trade Marks in respect of goods or services falling in two or more classes.	10,000	Form 3
Section 91 read with rule 162 of the Trade Marks Rules, 2002	On appeal from an order or decision of the Registrar of Trade Marks in regard to the registration or removal of a trade marks agent from the register of trade marks agents.	3,000	Form 4
Section 91	On application for condoning delay for filing appeal.	2,500	Form 5

Forms and Fees under IPAB Rules

Rule of the IPAB Rules, 2003	Purpose	Fees (Rs.)	Form
Rule 10 (1) / 23(3)	Filing of counter statement	2,000	Form 1
Rule 10(2)	Filing of counter statement	No Fee	Form 2
Rule 14	Application for extension of time	1,000 per month	Form 3
Rule 15	Application for leave to intervene in proceedings relating to rectification of the register or the removal of trade mark from the register of trade mark .	2,000	Form 4

Rule 18	Application for adjournment of hearing	1,000 per month	Form 5
Rule 23	Petition for review of the order of the Appellate Board	3,000	Form 6

Similarly following rules were made by the IPAB to regulate its procedure for patents matters. Notification No. G.S.R. 930(E) dated 29-11-2010 (Patents). This has been further modified by Notification No. G.S.R. 209(E) dated 11-03-2011 (Patents).

2. Intellectual Property Appellate Board (Patent Procedure) Rules, 2010.

Rules 2, 2010

MINISTRY OF COMMERCE AND INDUSTRY

(Department of Industrial Policy and Promotion)

NOTIFICATION

New Delhi, the 29th November, 2010

G.S.R. 930(E). - In exercise of the powers conferred by section 117 H of the Patents Act, 1970 (39 of 1970), the Appellate Board hereby makes the following rules, namely:-

1) Short title and commencement. - (1) These rules may be called the Intellectual Property Appellate Board (Patents Procedure) Rules, 2010. (2) They shall come into force on the date of their publication in the Official Gazette.

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

a) "Act" means the Patents Act, 1970 (39 of 1970);

b) "address for service" means the address furnished by an appellant or applicant or respondent or his authorised agent or his legal practitioner at which service of summons, notices or other processes may be effected;

c) "agent" means a person duly authorised by an appellant or applicant or respondent to present appeal, application, counter-statement, reply, rejoinder evidence or any other document on his behalf before the Appellate Board and shall include a patent agent referred to in section 125 of the Act;

d) "appeal" means an appeal under section 117 A and includes Original Appeal (O.A.) and, Transferred Appeal (T.A.) pursuant to section 117G;

e) "appellant" means a person making an appeal to the Appellate Board under section 117 A;

f) "application" means an application for rectification of register of patents under section 71 or a petition for revocation of patents under section 64;

g) "Deputy Registrar" means the Deputy Registrar of the Appellate Board and includes any officer to whom the powers and functions of the Deputy Registrar may be delegated;

h) "fee" means the fee prescribed under the Second Schedule to these rules;

i) "Form" means a form appended to these rules;

j) "legal practitioner" shall hove the same meaning as assigned to it in the Advocates Act, 1961 (25 of 1961);

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

l) "Miscellaneous Petition" means any petition' or request in writing made to the Appellate Board not being an application under section 64 or section 7] or an appeal under section 117 A'

m) "pleadings" includes appeals or applications, counter-statements, rejoinders and replies permitted to be filed before the Appellate Board;

n) "Registry" means the Registry of the Appellate Board;

o) "Schedule" means a Schedule to these rules;

p) "section" means a section of the Act,

q) "transferred appeal or application" means an appeal or on application or other proceedings which has been transferred to the Appellate Board under section 117G;

r) words and expressions used and not defined in these rules but defined in the Act or the Trade Marks Act, 1999 (47 of 1999) shall have the meanings respectively assigned to them in the Act or the Trade Marks Act. 1999.

3) Form of procedure of appeal or application. -

1) An appeal against a decision, order or direction of the Controller or Central Government, under section 117A shall be filed in the Form 1 annexed to the First Schedule to the Patents (Appeals and Applications to the Intellectual Property Appellate Board) Rules, 2010,

2) An application for rectification or revocation of patents shall be filed in the Form 2 annexed to the First Schedule to the Patents (Appeals and Applications to the Intellectual Property Appellate Board) Rules, 2010,

3) An appeal or application sent by post shall be deemed to have been presented before the Registry on the day it was received in the Registry.

4) Appeal or application to be in writing. –

1) Every appeal, application, counter-statement, rejoinder, reply or other document filed before the Appellate Board shall be typed or printed neatly on one side of the full scape sheet only.

2) The appeal or application under sub-rule (1) shall be presented in two sets in a paper-book form along with an empty file size envelope strong enough and sufficiently big to enable covering of the paper book bearing full address of the respondent and, in case the respondents are more than one, then sufficient number of extra paper-books together with empty file size envelopes as required bearing full addresses of each respondent shall be furnished by the appellant or applicant.

5) Documents to accompany appeal or application –

1) Every application shall be accompanied by evidence relied upon in support of the application in the form of affidavits with exhibits, if any, annexed thereto in paper-book form.

2) Every appeal filed shall be accompanied by the copies of the order at least one of which shall be a certified copy, against which the appeal is filed.

3) The documents intended to be attached to an affidavit shall be referred to as Exhibits and shall be marked in the same manner as exhibits admitted by the Appellate Board.

4) Every appeal or application, if filed by a person other than the appellant or applicant, then an affidavit stating the competency of the person shall be filed along with such appeal or application and the affidavit shall state the name and address and sufficiently describe the identity of the deponent and shall also state in what capacity he is so doing and whether he is authorised and if so by whom and by what instrument and a copy thereof shall be annexed to the affidavit.

5) Where a party is represented by and authorised representative, a copy of the authorisation to act as the authorised representative shall be appended to the appeal or application.

6) Fees.- The fees for filing counter-statement, petition for Intervention by third party, extension of time, adjournment of hearing and review petition before the Appellate Board shall be as provided in the Second Schedule, which shall be paid by way of bank draft drown in favour of the Deputy Registrar, Intellectual Property Appellate Board, payable at Chennai.

7) Authorisation. -

1) An appeal application or petition shall be presented by the parties or an advocate having a vakalat duly executed in his/her favour and duly accepted by him/her or by a patent agent having valid authorisation.

2) All communications directed to be made to a person in respect of any proceeding or matter may be addressed to such advocate or agent and service on the advocate or agent shall be deemed to be service upon the person so authorising him and all appearances before the Appellate Board may be made by or through such advocate or agent.

8) Verification of the appeal or application. - Every pleading shall be verified at the foot by the party or by one of the parties pleading or by some other person proved to the satisfaction of the Appellate Board to be authorized to verify the appeal or application and the person verifying shall specify that what he verifies is his own knowledge and what he verifies upon information received and believed to be true by reference to The numbered paragraphs of the pleading and shall be signed by the person making it and shall state the date on which it was signed and the place where it was signed.

9) Presentation and scrutiny of appeal or application. –

1) The Deputy Registrar shall endorse on every appeal or application the date with his signature on which it is presented.

2) If, on scrutiny, the appeal or application is found to be in order, it shall be duly registered and given a serial number and if any defect is noticed, the appeal or application shall not be registered until such defect is rectified.

3) If an appeal or application is found to be defective and the defect noticed is formal in nature, the Deputy Registrar may allow the appellant or applicant to rectify the same in his presence and if the said defect is not formal in nature, the Deputy Registrar may allow the appellant or applicant fifteen days time to rectify the defect as he may deem fit and if the appeal or application has been sent by post and found to be defective, the Deputy Registrar shall communicate the defects to the appellant or applicant and allow the appellant or applicant fifteen days time from the dote of receipt of the communication from the Deputy Registrar, to rectify the defects.

4) If the appellant or applicant fails to rectify the defects within the time allowed under sub-rule (3), the appeal or application shall be deemed to have been abandoned, unless the time is extended or the delay is condoned in rectifying the defect, in either case not exceeding 30 days as the case may be, by the Deputy Registrar.

10) Notices of appeal or application to the respondents. - A copy of the appeal or application in paper-book form shall be served by the Registry on the respondents as soon as the same is registered in the Registry.

11) Filing of counter-statement to the appeal or application and other documents by the respondent. - After receipt of the appeal or application filed in the prescribed Form 1 or Form 2, as the case may be, given in the First Schedule, the respondent may file two complete sets of counter-statement in the Form 1 of the First Schedule along with fees and documents including evidence in the form of affidavits, if any, in paper-book form before the Registry within two months from the date of service of the notice on him of the filing of the application or appeal and a copy of the counter-statement along with the documents shall be served to the applicant or appellant by the respondent directly under intimation to the Registry and the case shall then proceed for hearing.

12) Affidavit and Exhibits. -

1) The affidavits shall be, headed in the matter or matters to which they relate, drawn up in the first person, divided into paragraphs, consecutively numbered; and each paragraph shall, as far as practicable, be confined to one subject. Every affidavit shall state the description and the true place of abode of the person making the same, shall bear the name and address of the person filing it and shall state on whose behalf it is filed.

2) Where two or more persons join in an affidavit, each of them shall depose separately to such facts which are within his personal knowledge and those facts shall be stated in separate paragraphs.

3) Affidavits shall be taken -

a) in India, before any court or person having by law authority to receive evidence, or before any officer empowered by such court as aforesaid to administer oaths or to take affidavits;

b) in any country or place outside India, before a diplomatic or consular officer, within the meaning of the Diplomatic and Consular

Officers (Oaths and Fee) Act, 1948. or such country or place or before a notary public, or before a Judge or a Magistrate, of the country or place.

4) The person before whom an affidavit is taken shall state the date on which and the place where the same is taken and shall affix his seal. if any, or the seal of the court to which he is attached thereto and sign his name and designation at the end thereof.

5) Any affidavit purporting to hove been affixed, impressed or subscribed thereto or thereon the seal or signature of any person authorised by sub-rule (4) to take an affidavit, in testimony of the affidavit having been taken before him, may be admitted by the Deputy Registrar without proof of the genuineness of the seal or signature or of the official character of that person.

6) Alterations and interlineations shall, before an affidavit is sworn or affirmed, be authenticated by the initials of the person before whom the affidavit is taken.

7) Where there are exhibits to affidavits, a copy each of such exhibits shall bé sent to the other party or parties and the originals shall be produced whenever so required at the Registry for inspection by the other party and shall be produced at the time of hearing unless the Appellate Board otherwise directs.

13) Filing of reply by the appellant or applicant. - After receipt of counter statement, the appellant or applicant may file his reply within two months of the service of the counter-statement along with the evidence in the form of affidavits, if any, in duplicate in the Registry and a copy of the reply shall be served on the respondent directly under intimation to the Registry.

14) Filing of Additional documents in appeal. - No party shall, except with the leave of the Appellate Board had and obtained by request mode in writing in the form of a petition, copy whereof, shall serve upon the opposite parties, rely upon any document or file any such document in the appeal paper book which have not been previously filed before the Controller.

15) Translation of documents. - Where a document in a language other than Hindi or English is referred to in any proceeding an attested translated copy thereof in Hindi or English duly verified by the person, having the authority to do so, shall be furnished in duplicate to the Appellate Board and a copy thereof shall be served upon the other party or parties directly under intimation to the Registry.

16) Extension of time. - (1) If the Appellate Board is satisfied, on a petition along with the prescribed fee mode to it in Form 2 that there IS sufficient cause for extending the time for doing any act prescribed under these rules (not being a time expressly provided for in the Act) whether the time so specified has expired or not it may subject to such conditions as it may deem fit to impose, extend the time and inform the parties accordingly, (2) Nothing in sub-rule (1) shall be deemed to require the Appellate Board to hear the parties before disposing of the petition for extension of time.

17) Intervention by third parties. - Any person other than the patentee alleging interest in a granted patent in respect of which an appeal has been filed

under section 117 A against the order or decision of the Controller or in an application for the revocation of the patent or to rectify the Register may apply in the prescribed Form 3 given in the First Schedule along with prescribed fees for leave to implead/intervene, stating the nature of his interest and the Appellate Board may refuse or grant such leave after hearing, if so required, the parties concerned upon such terms and conditions as it deems fit.

18) Date of hearing to be notified. - The Registry shall notify the parties the date, time and place of hearing of the appeal or application in such manner as the Chairman may by general or special order direct.

19) Hearing of appeal or application. - (1) On the day fixed or on any other day to which the hearing may be adjourned, the parties shall be heard by a Bench of the Appellate Board.

(2) In case where the appellant, applicant or petitioner does not appear at the hearing, the appeal or application or the petition may be treated as abandoned unless he seeks an adjournment under rule 20.

20) Adjournment of hearing. - A party to the hearing may make a petition in duplicate for adjournment of the hearing in Form 4 with the prescribed fee fifteen days before the date of hearing after serving a copy of the petition for the adjournment upon the other party and the Appellate Board may consider the petition and pass such order as it deems fit.

21) Award of costs by the Appellate Board. - The Appellate Board may award such costs as it deems fit to the parties having regard to all the circumstances of the case.

22) Language of the Appellate Board. -

1) The proceedings of the Appellate Board shall be conducted in English or Hindi.

2) All decisions or orders of the Appellate Board shall be either in English or Hindi.

23) Order to be signed and dated. -

1) Every order of the Appellate Board shall be signed and dated by the Members of the Bench.

2) The order shall be pronounced in the sitting of the Bench.

24) Communication of orders. - A certified copy of every order passed by the Bench shall be communicated to the appellant and respondents or their authorised agent or their legal practitioners.

25) Publication of the orders. - The orders of the Bench as are deemed fit for publication in any authoritative report or the press may be released for such publication on such terms and conditions as the Chairman may decide.

26) Review Petitions.-

1) A petition in duplicate for review limited to procedural or clerical errors of an order of the Appellate Board may be mode to the Registry in the prescribed Form 5 given in the First Schedule along with the

prescribed fee within two months from the date on which the order is communicated accompanied by a statement setting forth the grounds on which the review is sought and where the order in question concerns more than one respondent, sufficient extra copies of such petition and statement shall be filed.

2) The Registry shall forward the petition and statement to the respondents to the review petition.

3) The respondents may file counter-statement in the prescribed Form 4 given in the First Schedule within two months from the date of receipt of the review petition and shall forward a copy of the counter-statement to the petitioner directly under intimation to the Registry.

4) The review petition shall be posted for hearing before a Bench by the Registry.

27) Rectification of Orders. - Notwithstanding anything contained in rule 26, the Appellate Board or the members constituting the Bench that passed any judgment: order or direction may at any time either suo motu or upon request in writing made by any party to the proceedings rectify or correct any clerical error in any such judgment, order or direction.

28) Continuation of proceedings after the death of a party, merger, assignment, acquisition or transmission. - On the death of a party by devolution on the legal representative of the deceased or by amalgamation, merger, assignment, acquisition, transmission, or by operation of law if a new patty becomes entitled for continuation of the proceedings, the proceeding shall be continued subject to filing a request in writing along with evidence in support thereof,

29) Fee for inspection of records and obtaining copies thereof. -

1) A fee for every hour or part thereof shall be charged for inspecting tile records of a pending appeal or application or decided case, as given in the Second Schedule.

2) A fee shall be charged for providing xerox copy of each page of the record as prescribed in the Second Schedule.

30) Functions of the Deputy Registrar. -

1) The Deputy Registrar shall discharge the functions under the general superintendence of the Chairman and shall discharge such other functions as are assigned to him under these rules or by the Chairman by a separate order in writing.

2) The Deputy Registrar shall be the custodian of the records of the Appellate Board.

3) The official seal of the Appellate Board shall be kept in the custody of the Deputy Registrar.

4) Subject to any general or special directions of the Chairman, the official seal of the Appellate Board shall not be affixed to any order, summons or other process save under the authority in writing from the Deputy Registrar.

5) The official seal of the Appellate Board shall not be affixed to any certified copy issued by the Appellate Board save under the authority in writing of the Deputy Registrar.

31) Additional functions and duties of the Deputy Registrar. - In addition to the functions and duties assigned under rule 30, the Deputy Registrar shall have the following functions and duties subject to any general or special orders of the Chairman, namely:-

i) to receive all appeals, applications, counter-statements, replies and other documents;

ii) to decide all questions arising out of the scrutiny of the appeals and applications before they are registered;

iii) to require any appeal, application, counter-statement, replies presented to the Appellate Board to be amended in accordance with the rules;

iv) subject to the directions of the Chairman, to fix date of hearing of the appeals or applications or other proceedings and issue notices therefore;

v) direct any formal amendment of records;

vi) to order supply of copies of documents to parties to the proceedings;

vii) to grant leave to inspect the records of the Appellate Board;

viii) to requisition records from the custody of any court Controller of Patents or other authority;

ix) to decide questions relating to extension of time in respect of filing of counter-statement, reply, rejoinder, etc.

32) Dress code for the Chairman, Vice-Chairman, Technical Member of the Appellate Board and for the representatives of the parties. -

1) The address for the Chairman. Vice-Chairman and other Members shall be white or black pant with black coat and block tie or a buttoned-up black coot: Provided that if the officials are formerly from the High Court Bench, then they shall be in their official robes.

2) The professionals who appear before the Appellate Board shall be in their professional dress, if any, and in case of other authorised representatives of the parties, If shall be the following:-

a) in the case of mole, a black coat with a black tie or buttoned-up block coot over a white/black pant.

b) in the case of female, a black coat over white or any other sober coloured saree,

c) all other persons appearing before the Appellate Board shall be properly dressed.

THE FIRST SCHEDULE

(See rules 2 & 3)

FORMS FOR MAKING APPEALS AND APPLICATIONS

S.No.	Rules of the IPAB	Title	Form Number
1	2	3	4
1.	Rule 11	On filing counter-statement	Form 1
2.	Rule 16	On petition for extension of time	Form 2
3.	Rule 17	On petition for leave to intervene in proceedings	Form 3
4.	Rule 20	On petition for adjournment of hearing	Form 4
5.	Rule 20	On petition to review of the order of Appellate Board	Form 5

BEFORE THE INTELLECTUAL PROPERTY APPELLATE BOARD
THE FIRST SCHEDULE

FORM 1

(See rule 3 and 1)

(Form of Counter-Statement)

(To be filed in duplicate and accompanied by as many copies as there are registered users I authorized users under the registration)

In the matter of O.R.A./O.A. No.

A.B. (add description such as full name, nationality, address, registered office .....)

APPLICANT/APPELLANT

vs.

C.D. (add description such as full name, nationality, address, registered office and the residential or official address on which the service of notices is to be effected on the respondent or respondents. The details of each respondent are to be given in a chronological order).

RESPONDENT

I / we [l] ..... the respondent or the patentee of the patent No. ..... hereby give notice that the following are the grounds on which I/we rely for my lour application/patent:-

.....

.....

I/we admit the following allegations in the application/appeal:-

.....

.....

All communications relating to these proceedings may be sent to the following address in India:-

.....

.....

State the name and address of the registered proprietor or registered user of patent.

VERIFICATION

I, ...(name of the respondent I patentee age.....of .....nationality, resident of .....do hereby verify that the contents of paras.....to.....are true to my personal knowledge and paras.....to.....are believed to be true on legal advice and that I have not suppressed any material fact.

Dated this..... day of .....

Place:

Signature of the Respondent/

Patentee

Signature of Advocate/Agent

(FULL NAME OF THE SIGNATORY)

To,

The Deputy Registrar,
Intellectual Property Appellate Board,

Note : For fee see second schedule

BEFORE THE INTELLECTUAL PROPERTY APPELLATE BOARD

FORM 2

(See rule 16)

Application for extension of time

(To be filed in duplicate)

In the matter of O.R.A./O.A No. .....

A.B. (add description such as full name, nationality, address, registered office.....)

APPLICANT/APPELLANT

vs.

C.D. (add description such as full name, nationality, address, registered office and the residential or official address on which the service of notices is to be effected on the respondent or respondents. The details of each respondent are to be given in a chronological order).

RESPONDENT

In the matter of .....

I/we ..... being the ..... in the above matter hereby apply for an extension of time for.....on the following grounds.

.....

.....

All communications relating to these proceedings may be sent to the following address in India:-

.....

.....

Date:

Place:

Signature of Appellant/Applicant/
Respondent/Advocate/Agent
(FULL NAME OF THE SIGNATORY)

To

The Deputy Registrar.
Intellectual Property Appellate Board,

Note: For fee see second schedule

BEFORE THE INTELLECTUAL PROPERTY APPELLATE BOARD

FORM 3

(See rule 17)

Application for leave to intervene In proceedings relating to the rectification of the register or the removal of patent from the register of patents.

To be filed in duplicate together with a statement of case in duplicate)

.....

In the matter of O.R.A./O.A. No. .....

A.B. (add description such as full name, nationality, address, registered office

.....)

APPLICANT/APPELLANT

vs.

C.D. (add description such as full name, nationality, address, registered office and the residential or official address on which the service of notices is to be effected on the respondent or respondents. The details of each respondent are to be given in a chronological order).

RESPONDENT

In the matter of the Patent No. ..... granted in the name of

..... on.....

I/we ..... hereby apply for leave to intervene in the proceedings relating to the rectification or removal of the entry in the register in respect of the above mentioned patent.

My/our interest in the patent.....

.....

All communications relating to this application may be sent to the following address in India:

.....

.....

VERIFICATION

I, ...{name of the respondent/patentee age.....of..... nationality, resident of ..... do hereby verify that the contents of paras.....to.....are true to my personal knowledge and paras.....to..... are believed to be true on legal advice and that I have not suppressed any material fact.

Dated this..... day of .....

Place:

Signature of Advocate/Agent

Signature of the Applicant

(FULL NAME OF THE SIGNATORY)

To,

The Deputy Registrar.
Intellectual Property Appellate Board.

Note: For fee see second schedule

BEFORE THE INTELLECTUAL PROPERTY APPELLATE BOARD

FORM 4

(See rule 20)

Petition for adjournment of hearing

(To be filed in duplicate)

In the matter of O.R.A./O.A No. .....

A.B. (add description such as full name, nationality, address, registered office.....)

APPLICANT/APPELLANT

vs

C.D. (add description such as full name, nationality, address, registered office and the residential or official address on which the service of notices is to be effected on the respondent or respondents. The details of each respondent are to be given in a chronological order).

RESPONDENT

In the matter of .....I/We

..... being the .....in

the above matter hereby apply for adjournment of the hearing fixed for

..... for ..... month on the following grounds:-

.....

.....

.....

All communication relating to these proceedings may be sent to the following address in India:

.....

.....

Dated this..... of .....

Place :

Signature of Appellant/Applicant/
Respondent/Advocate/Agent
(FULL NAME OF THE SIGNATORY)

To,

The Deputy Registrar.
Intellectual Property Appellate Board,

Note: For fee see second schedule

BEFORE THE INTELLECTUL PROPERTY APPELLATE BOARD

FORM 5

(See rule 26)

Petition for review of the order of the Appellate Board

(To be filed in duplicate and accompanied by as many copies as there are registered users/authorized users under the registration)

In the matter of .....

A.B. (add description such as full name, nationality, address, registered office.....) represented by its Partner/Principal Officer/duly authorized Power of Attorney

PETITIONER

C.D. (add description such as full name, nationality, address, registered office and the residential or official address on which the service of notices is to be effected on the respondent or respondents. The details of each respondent are to be given in a chronological order).

RESPONDENT

In the matter of..... I/We ..... being the .....in the above matter hereby apply to the Appellate Board for the Review of their order dated the .... day of ..... 200 in the above matter.

The grounds for making this application are set forth in the accompanying statement.

VERIFICATION

I, ... (name of the respondent/patentee age.....of .....nationality, resident of .....do hereby verify that the contents of paras.....to.....are true to my personal knowledge and paras .....to.....are believed to be true on legal advice and that I have not suppressed any material fact.

Dated this.....day of .....

Place :

Signature of Advocate/Agent

Signature of the Applicant
(FULL NAME OF THE SIGNATORY)

To,

The Deputy Registrar.
Intellectual Property Appellate Board.

Note: For fee see second schedule

THE Second SCHEDULE

(See rules 6)

FEE

Entry No.	On what payable	Amount in Rupees		
		For Natural Person	For other than natural person either along or jointly with natural persons	Relevant Form
(1)	(2)	(3)	(4)	(5)
1.	On filing Counter-Statement	2000/-	4000/-	1
2.	On petition for extension of time	1000/- per month or part thereof	2000/- per month or part thereof	2
3.	On petition for leave to intervene	2000/-	4000/-	3
4.	On petition for adjournment of Hearing	1000/- per month	2000/- per month	4
5.	On petition to review of the order of the IPAB	3000/-	6000/-	5
6.	Fee for inspection of records of pending appeal or application of decided case.	150/- per hour or part thereof	300/- per hour or part thereof	-
7.	Fee for supplying photocopies of the documents	5/- per page	5/- per page	-
8.	Filing of a petition not other wise provided for	2000/-	4000/-	-

[F. No. 7(9)/2007-IPR.I.(IPAB)]
V. BHASKAR, Jt. Secy.

3. Patents (Appeals to the Intellectual Property Appellate Board) Rules, 2010

दूसरी अनुसूची

(नियम 4 देखिए)

फीस

प्रविष्टि सं.	किस पर संदेय	रकम रुपए में		सुसंगत प्ररूप
		वास्तविक व्यक्ति के लिए	वास्तविक व्यक्ति से भिन्न के लिए या तो अकेले या संयुक्त रूप से वास्तविक व्यक्ति के साथ	
(1)	(2)	(3)	(4)	(5)
1.	नियंत्रक के आदेश या विनिश्चयों से अपील करने के लिए आवेदन	5000	10000	1
2.	प्रतिसंहरण के लिए आवेदन	5000	10000	2
3.	परिशोधन के लिए आवेदन	5000	10000	2
4.	विलंब की माफी के लिए आवेदनं	2500 प्रति मास या उसका भाग	5000 प्रतिमास या उसका भाग	3

(फा.सं. 7(9)/2007–आईपीआर–1 (आईपीएवी))
वी. भास्कर, संयुक्त सचिव

MINISTRY OF COMMERCE AND INDUSTRY
(Department of Industrial Policy and Promotion)
NOTIFICATION

New Delhi, the 11th March, 2011

GS.R. 209(E), -- Whereas the draft or the Patents (Appeals and Applications to the Intellectual Property Appellate Board) Rules. 2010 were published as required by sub-section (3) of Section 159 of the Patents Act., 1970 in Gazette of India, Extraordinary, Part II, Section 3, Sub-section (i) dated 20th August, 2010,. *vide* notification of the Government of India in the Ministry of Commerce and Industry (Department of Industrial Policy and Promotion) number G.S.R. 690 (E), dated 18th August, 2010, inviting objections and suggestions from all persons likely to be affected thereby before the expiry of forty-five days from the date on which copies of the Gazette containing the notification were made available to the public;

And whereas the copies of the Gazette containing the notification were made available to the public on 27th August, 2010:

And whereas the objections and suggestions received from the public have been considered by the Central Government;

Now, therefore, in exercise of the powers conferred by Section 159 of the Patents Act, 1970 (39 of 1970), the Central Government hereby makes the following rules namely:

Rules

1. Short title and commencement - (1) These rules may be called the Patents (Appeals and Applications to the Intellectual Property Appellate Board) Rules, 2011.

(2) They shall come into force on the date of their final publication in the Official Gazette.

2. Appeals and applications - The manner of making appeals and applications and the forms of appeals and applications to the Appellate Board and the manner of verification thereof shall be as provided in the First Schedule.

3. Condonation of delay in filing appeal - Subject to the rules, if any, made in that behalf by Appellate Board any appeal under Section 117 A of the Patents Act, 1970 may be admitted after the prescribed period, if the Appellate Board is satisfied on a petition made to it in Form 3 that there is sufficient cause for not preferring the appeal with in the prescribed time.

4. Fees - The fees for filing appeal, application petition for condonation of delay before the Appellate Board shall be as provided in the Second Schedule which shall be paid by way of bank draft drawn in favour of the Deputy Registrar, Intellectual Property Appellate Board, payable at Chennai.

FIRST SCHEDULE

(See Rules 2 and 3)

FORMS

S. No.	Rules of the Patent (Appeals and Applications to the Intellectual Property Appellate Board) Rules, 2011	Title	Form Member
1	2	3	4
1.	Rule 2	An appeal under Section 117A from any decision order or direction of the Controller or Central Government.	Form 1
2.	Rule 2	Application under Section 64 for revocation of a patent or application for rectification of the register under Section 71 or both	Form 2
3.	Rule 3	Application for condoning the delay in filing appeal.	Form 3

BEFORE THE INTELLECTUAL PROPER'IT APPELLATE BOARD

FORM 1

(See rule 2)

Appeal under section 117 A of the Patents Act., 1970

(To be filled in duplicate)

In the matter of O.A. No. .....

A. B. (add description such as full name, nationality, address, registered office.....)

represented by its Partner Principal Officer power of attorney holder.

APPELLANT

Vs.

CD. (add description such as full name, nationality, address, registered office and the residential or official address on which the service of notices is to be effected on the respondent or respondents. The details of each respondent are to be given in a chronological order).

RESPONDENT

List of documents filed with the appeal:

S. No.	Details of Documents Relied upon	Page No.
1.		
2.		
3.		
4.		

Note: For fee see second schedule to these rules.

Signature of Advocate/Agent

Signature of Applicant

FOR USE IN THE BOARD OFFICE

Date of filing
or
Date of receipt by post
Registration No. Signature of Deputy Registrar

BEFORE THE INTELLECTUAL PROPERTY APPELLATE BOARD

In the matter of O.A. No. .....

A.B. (add description such as full name, nationality, address, registered office.....) represented by its Partner/Principal Officer/power of attorney holder.

APPELLANT

Vs.

C. D. (add description such as full name, nationality, address, registered offiec and the residential or official address on which the service of notices is to be effected on the respondent. The details of each respondent are to be given in a chronological order).

Respondent

DETAILS OF APPEAL:

1. **Particulars of the order against which the appeal is made:**

   (Particulars of the order giving the details like the number, date and authority which has passed the order against which the appeal is made.)

2. **Jurisdiction of the Board:**

   The appellant declares that this appeal is filed under section.....of the Patents Act, 1970 and that the subject matter of the order against which he wants redressal is within the jurisdlction of the Appellate Board,

3. **Limitation:**

   The date of the decision, order or direction appealed against is.....The said order was received by the Appellant on .....

   * The appellant further declares that the appeal is within the limitation period prescribed in Section 1 17A (4) of the Patents Act, 1970.

   * There is a delay of ..... days in filing this appeal. Accordingly, a petition for condonation of the said delay is filed along with this appeal.

4. **Facts of the case:**

   (Give here a concise statement of facts in a chronological order, each, paragraph containing as nearly as possible a separate issue or fact.)

5. **Grounds for relief with legal provisions:**

6. **Matters not previously filed or pending with any other court :**

   The appellant further declares that he had not previously filed any appeal, writ petition or suit before any court or all other authority regarding the matter in respect of which this appeal has been made.

   (In case the appellant had previously filed any such appeal, writ petition or suit, the stage at which it is pending, and if decided, the list of the decisions should be given with reference to the number of Annexure to be given in support thereof.)

7. **Reliefs sought:**

   In view of the facts mentioned above the appellant prays for the following relief (s):-

   (Specify the relief(s) sought explaining the grounds for such relief(s) and the legal provisions, if any relied upon).

8. **Particulars of Bank Draft.**

9. List of enclosures:

1.

2.

3.

4.

10. All communications relating to these proceedings may be sent to the following address in India :—

.....

.....

*Strike out that which is not applicable.

VERIFICATION

I .....(name of the appellant) age .....of ....nationality, resident of ..... do hereby verify that the contents of paras..... to..... are true to my personal knowledge and paras ..... to..... are..... believed to be true on legal advice and that I have not suppressed any material fact.

Dated, this .....day of.....

Place:

SIGNATURE OF THE ADVOCATE/AGENT SIGNATURE OF THE APPLICANT

On behalf of the applicant (Full name and designation of the signatory)

To

The Deputy Registrar

Intellectual Property Appellate Board

BEFORE THE INTELLECTUAL PROPERTY APPELLATE BOARD

FORM 2

(See rule 2)

Application for Revocation of Patent under Section 64 or Rectification of the Register of Patents under Section 71 of the Patents Act, 1970

(To be filed in duplicate along with the statement of case in duplicate stating the facts on which rectification is sought)

In the matter of O.R.A. No .....

A.B. (add description such as full name, nationality, address, registered office.....) represented by its Partner/Principal Officer/power of attorney holder.

APPLICANT

Vs.

C.D. (add description such as full name, nationality, address, registered office and the residential or official address on which the service of notices is to be effected on the respondent or respodents. The details of each respondent are to be given in a chronological order).

RESPONDENT

List of documents filed with the appeal:

S. No.	Details of Documents Relied upon	Page No.
1.		
2.		
3.		
4.		

Note: For fee see second schedule to these rules.

Signature of Advocate/Agent Signature of Applicant

FOR USE IN THE BOARD OFFICE

Date offiling
or
Date of receipt by post
Registration No.

Signature

for Deputy Registrar

BEFORE THE INTELLECTUAL PROPERTY APPELLATE BOARD

In the matter of O. R. A. No .....

A. B. (add description such as full name, nationality, address, registered office .....) represented by its Partner/Principal Officer/power of attorney holder,

APPLICANT

Vs.

C.D. (add description such as full name, nationality, address, registered office and the residential or official address on which the service of notices is to be effected on the respondent or respondents. The details of each respondent are to be given in a chronological order),

RESPONDENT

In the matter of a Patent No .....
granted in the name of ..... against Patent Application No. ..... on ..... by IPO.

I/We ..... hereby apply that the entry in the Register of Patents in respect of the above mentioned Patent may be revoked/ rectified in the followmg manner.

(1) .....

(2) .....

(3) .....

The grounds or facts on which my/our application for revocation/rectification is based is as follows :-

.....

.....

No action concerning the Patent in question is pending in any Court or before the Controller of Patents. All communications relating to this application may be sent to the following address in India :-

.....

.....

1. State full name, address and nationality. An address for service in Indian should be stated if the applicant has no place of business or of residence in India.

2. *Strike out that which is not applicable.

VERIFICATION

I ..... (Name of the applicant) being theApplicant/being the Principal Officer and having been authorised by the Applicant to file the present Application, age ....of..... nationality, resident of..... .....do hereby verify that the contents of paras ..... to ..... are true to my personal knowledge and paras .....to .....are believed to be true on legal advice and that I have not suppressed any material fact.

Dated this ..... Day of .....

Place.....

Signature of the Advocate/Agent Signature of the Applicant

On behalf of the Applicant (Full name and designation ofthe signatory)

To

The Deputy Registrar
Intellectual Property Appellate Board

BEFORE THE INTELLECTUAL PROPERTY APPELLATE BOARD

FORM 3

(See Rule 3)

In the matter of COD No. ..... in O.A. No. .....

Petition to condone the delay in filing appeal under Section 117 A of the Patents Act, 1970

(to be filled in duplicate together with statement of case in duplicate)

A.B. (add description such as full name, nationality, address. registered office).

APPLICANT

vs.

C.D. (add description such as full name nationality, address, registered office and the residential or official address on which the service of notices is to be effected on the respondent or respodents. The details of each respondent are to be given in a chronological order).

RESPONDENT

In the matter of decision order or direction of the Controller of parents in Patent application No .....

I/We here by apply for leave to condone tbe delay (specify the period of delay) ill filing the appeal.

The grounds for making this petition are set forth in the accompanying affidavit.

(To be enclosed on separate affidavit duly sworn/affirmed by the deponent)

All communications relating to this petition may be sent to the followiing address in India.

Signature of the Advocate/Agent

On behalf of the Applicant

Signature of the Applicant

(Full name and designation of the signatory)

To

The Deputy Registrar
Intellectual Property Appellate Board

Note: For fee see second schedule

SECOND SCHEDULE

(See rule 4)

FEES

Entry No.	On what payable	Amount in Rupees		Relevant Form
		For Natural Person	for other than natural person either along or jointly with natural persons	
1	2	3	4	5
1.	Application for appeal from order or decisions of Controller	5000/-	10000/-	1
2.	Application for revocation	5000/-	10000/-	2
3.	Application for rectification	5000/-	10000/-	2
4.	Application for condonation of delay	2500/- per month or part there of	5000/- per month or part there of	3

(F.No. 7(9)/2007-IPR 1 (IPAB)
V. BHASKAR, Jt. Secy.

MPDD/IGNOU/P.O.1K/March, 2017 (Reprint)

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