

PATENT PROCUREMENT IN INDIA

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Introduction: This paper has been created under the leadership of Mr. Edward Blocker, Chair of the Intellectual Property Owners Association (“IPO”) Asian Practice Committee, to provide background to IPO members on the subject of obtaining patents in India. It should not be construed as providing legal advice or as representing the views of IPO.

The Indian Patent Law of 1970 and the Amendment of 2005 are available on-line at the Indian Patent Office Website at: <http://patentoffice.nic.in/ipr/patent/patents.htm> and <http://patentoffice.nic.in/>, respectively.

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1. Introduction to Patent Laws in India

The Patents Act, 1970

The provisions of the Patent Act, 1970¹ (hereinafter referred to as the “1970 Act”) govern the procurement and grant of patents in India (Non-substantive procedural issues relating to the procurement & granting of patents are governed by the Patent Rules and not the 1970 Act). Section 159 of the Act, requires the Central Government to frame rules² to administer and carry out the intent of the Act. The Act was kept in abeyance till the formulation of rules. The rules came into force on April 20, 1972.³ Thus, the 1970 Act (except for certain sections) came into force on April 20, 1972 . The remaining sections of the Act came into force on April 1, 1978.⁴ Since its enactment, the Act has been amended on five occasions by:

- The Repealing and Amending Act, 1974 (Act 56 of 1974)
- The Delegated Legislation Provisions (Amendment) Act, 1985 (Act 4 of 1985)
- The Patents (Amendment) Act, 1999 (17 of 1999)
- The Patents (Amendment) Act, 2002 (38 of 2002)
- The Patents (Amendment) Act, 2005 (15 of 2005)

¹ Act No. 38 of 1970. The 1970 Act came on the Statute book on 19th September 1970 was after being passed by both Houses of Parliament and receiving the assent of the President. The 1970 Act has undergone three major amendments by: The Patents (Amendment) Act, 1999, Act No. 17 of 1999; The Patents (Amendment) Act, 2002, Act No. 38 of 2002; The Patents (Amendment) Act, 2005, Act No. 15 of 2005. [The 1970 Act, as amended till date has been referred to hereinafter as the “Patents Act, 1970.”]

² § 159 of the Patents Act, 1970 (*id*) states: “Power of Central Government to make rules- (1) The Central Government may, by notification in the Official Gazette, make rules for carrying out the purposes of this Act.”

³ The Patents Rules, 1972, published in S. O. 301 (E) dated 20th April 1972 in Gazette of India Pt. II, Section 3 (ii)

⁴ §§12(2), 13(2), 28, 86 and 125 to 132 of the 1970 Act came into force on April 1, 1978 *vide* S. O. 799, dated 10th March, 1978 published in Gazette of India, Pt. II, § 3 (ii), p 764.

The first two amending Acts listed above reflect the changes driven within India, while the later three amending Acts made substantive changes to the Indian patent laws in order to meet India's obligations under TRIPS.⁵

At present, the Patents Act, 1970 is a collection of Twenty-three Chapters each dealing with various principles/aspects involved in the grant of patents in India.⁶

Pre-Independence Legislative History

The Indian Patent laws have their roots in the English Patent system. The English Patent system originated from the Royal prerogative power to grant monopolies. In India, however, the patent system is a statutory creation. The question whether to grant patents in India was of interest to the Government as early as 1832. A bill was put forth which empowered the Governor-General of India to grant patent rights.⁷ The original goal of the bill was to extend the protection of patents granted in England, to India, but this did not take effect due to the legal uncertainties⁸ associated with extending such rights to India. The first codified statute awarding protection to inventions in India was passed in 1856 (Act VI of 1856), and used the term 'exclusive privileges' instead of the term 'patent.'⁹ This Act was modified and re-enacted as Act No. VI of 1856, and was founded on the English Patent Act No. XI of 1852. An 'Exclusive Privilege' was awarded by the

⁵ The Agreement on Trade Related Aspects of Intellectual Property Rights (15 April 1994) LT/UR/A-1C/IP/1. [Hereinafter TRIPS]. The text of TRIPS is available at http://www.wto.org/english/docs_e/legal_e/27-trips.pdf (last visited 20 May 2007). India signed the TRIPS w.e.f. 1994 and entered the World Trade Organization w.e.f. 1995.

⁶ Chapter I- Preliminary including definitions and interpretation, Chapter II- Inventions Not Patentable, Chapter III- Applications for Patents, Chapter IV- Publication And Examination of Applications, Chapter V- Opposition Proceedings To Grant of Patents, Chapter VI- Anticipation, Chapter VII- Provisions For Secrecy Of Certain Inventions, Chapter VIII- Grant Of Patents And Rights Conferred Thereby, Chapter IX- Patents of Addition, Chapter X- Amendments of Applications And Specifications, Chapter XI- Restoration of Lapsed Patents, Chapter XII- Surrender And Revocation Of Patents, Chapter XIII- Register Of Patents Chapter XIV- Patent Office And Its Establishment, Chapter XV- Powers Of Controller Generally, Chapter XVI- Working Of Patents, Compulsory Licences And Revocation, Chapter XVII- Use Of Inventions For Purposes Of Government And Acquisition Of Inventions By Central Government ,Chapter XVIII- Suits, Concerning Infringement Of Patents, Chapter XIX- Appeals To the Appellate Board, Chapter XX- Penalties, Chapter XXI- Patent Agents, Chapter XXII- International Arrangements , Chapter XXIII- Miscellaneous

⁷ See D N CHOWDHARY, EVOLUTION OF PATENT LAWS: DEVELOPING COUNTRIES' PERSPECTIVE, 13-14 (Central Law House, Delhi, 2006) [Hereinafter, "Chowdhary"]

⁸ See Chowdhary (*id.*)

⁹ See P. NARAYANAN, PATENT LAW, 6 (4th ed., Eastern Law House, Calcutta 2006) [Hereinafter, "Narayanan"]

Act for a period of 14 years from the date of filing the specification. Act IX of 1857 repealed Act VI of 1856, as the legality of Act VI was challenged.¹⁰ Act IX of 1857 was further refined in the year 1859. The Acts of 1857 and 1859 afforded protection only to inventions. Later, in order to grant protection to patterns and designs, the Patterns & Designs Protection Act, 1872 was passed.¹¹ Over time, certain modifications were made in the English Statute that led to the introduction of the Inventions and Designs Act, 1883 in India. These Acts were further consolidated by the Inventions and Designs Act, 1888.¹² In 1911, new legislation was enacted granting 'patents' in India. The Act, the Indian Patents & Designs Act, 1911¹³ (hereinafter, the "1911 Act"), consolidated and replaced the existing statutes and was the first to introduce a patent management system under the Controller of Patents. The 1911 Act underwent three further amendments in 1920, 1930 and 1945.

Post-Independence Developments

The development of the Indian patent system post independence can be attributed to the recommendations of committees appointed by the Government of India. A Patent Enquiry Committee under the Chairmanship of Dr. Bakshi Tek Chand in 1949 recommended changes to the Indian patent laws to make them more conducive to national interest. Based on the Committee's Report, the Patent Bill, 1953 was introduced but it ultimately lapsed.¹⁴ In 1957, a second Patent Enquiry Committee was formed under the Chairmanship of Rajagopala Ayyangar.¹⁵ The Committee submitted a Report in the 1959 and on the basis of the Report, the Patents Bill 1965 was introduced. However, the 1965 Bill also lapsed and an amended version of the Bill was reintroduced

¹⁰ Act VI of 1856 was repealed in 1857 "as it was introduced without the prior sanction of the Queen. Patent Office." As stated in the Draft Manual of Patent Practice and Procedure, (Patent Office, India, 2005). Text available at: <http://www.patentoffice.nic.in/ipr/patent/manual-2052005.pdf> (last visited May 21, 2007). [Hereinafter, the "Draft MOPP"]

¹¹ *Supra* note 9

¹² *id.*

¹³ Act II of 1911. [Hereinafter, the "1911 Act"]

¹⁴ See Draft MOPP (*supra* note 10) at 7

¹⁵ N. RAJAGOPALA AYYANGAR, REPORT ON THE REVISION OF THE PATENTS LAW, Government of India (1959). [Hereinafter, the *Ayyangar Report*]

in 1967, which was subsequently enacted as the 1970 Act.¹⁶ The development of patent law in India owes much to the Report of Rajagopala Ayyangar, as majority of recommendations of the Committee found their way into the Act.

Post-TRIPS amendments

India's accession to World Trade Organization ("WTO") in 1995 marked an important phase in the development of India's patent laws. Prior to India's accession to the WTO, the 1970 Act, had been undisturbed for a period of 29 years. Beginning in 1999, a series of amendments were enacted in order to bring the 1970 Act into compliance with TRIPS. The first amendment came in 1999, with retrospective effect from January 1, 1995, to provide interim protection to inventions relating to pharmaceutical products by accepting mail box applications which would retain the priority of such inventions until the "mail box" opened in 2005 with the official introduction of product patents.¹⁷ The amendment also provided for the grant of exclusive marketing rights for such products.¹⁸ The Act was again amended in 2002 to incorporate the second set of TRIPS obligations *i.e.* extension of term of patents to 20 years, reversal of burden of proof, etc.¹⁹ and in 2005 for granting product patents in all fields of

¹⁶ See Introduction of 1970 Act (*supra* note 1)

¹⁷ See TRIPS (*supra* note 7) Art. 70.8 which states: "Where a Member does not make available as of the date of entry into force of the WTO Agreement patent protection for pharmaceutical and agricultural chemical products commensurate with the obligations under Article 27, that member shall: (a) not withstanding the provisions of Part VI, provide as from the date of entry into force of the WTO Agreement a means by which applications for patents for such inventions can be filed; (b) apply to these applications, as of date of the application of this Agreement, the criteria for patentability as laid down in this Agreement as if those criteria are being applied on the date of filing in that Member or, where priority is available and claimed, the priority date of the application; and (c) provide patent protection in accordance with this Agreement as from the grant of the patent and for remainder of the patent term, counted from the filing date in accordance with Article 33 of this Agreement, for those applications that meet the criteria for protection referred to in sub paragraph (b)."

¹⁸ See *id.* Article 70.9: "Where a product is subject of a patent application in a Member in accordance with paragraph 8 (a), exclusive marketing rights shall be granted, notwithstanding the provisions of Part VI, above for a period of five years after obtaining market approval in That Member or until a product patent is granted or rejected in that Member, whichever period is shorter, provided that subsequent to the entry into force of the WTO agreement, a patent application has been filed and a patent granted for that product in another Member and marketing approval obtained in such other Member."

¹⁹ See *id.* Article 65: "Transitional Arrangements: 65.1 Subject to the provisions of paragraph 2, 3 and 4, no Member shall be obliged to apply the provisions of this Agreement before the expiry of a general period of one year following the date of entry into force of the WTO Agreement." *Id.* Article 65.2:- "A developing

technology including chemicals, food, drugs and agrochemicals, etc.²⁰ Two of the three post-TRIPS amendments to the 1970 Act were introduced in the form of Presidential Ordinances.

The Patent Rules, 2003

Each post-TRIPS amendments to the Act called for a wide range of corresponding changes in the rules to implement the changes in substantive law. The changes in the Patents (Amendment) Act, 2002 required substantial changes in the procedural laws which lead to the repeal of the Patent Rules, 1972. The Patents Rules, 2003 were enacted on May 2, 2003²¹ after being published²² and circulated for over six months in order to receive public comments.²³ The Rules were further amended by the Patents (Amendment) Rules, 2005²⁴ and the Patents (Amendment) Rules, 2006.²⁵

The purpose of these amendments to the Rules was to introduce flexibility and reduce processing time for patent applications and to simplify and rationalize the procedures for granting of patents.²⁶ Broadly, the Rules are divided in fifteen chapters

country Member is entitled to delay for a further period of four years from the date of application, as defined in paragraph 1, of the provisions of this Agreement other than Articles 3, 4 and 5.”

²⁰ See *id.* Article 65.4: “To the extent that a developing country Member is obliged by this Agreement to extend product patent protection to areas of technology not so protectable in its territory on the general date of application of this Agreement for that Member, as defined in paragraph 2, it may delay the application of the provisions on product patents of Section 5 of Part II to such areas of technology for an additional period of five years.”

²¹ Vide S. O. 493(E) dated 2nd May 2003, published in the Gazette of India, (Extraordinary), Pt. II, Section 3 (ii) [Hereinafter, the Patent Rules, 2003].

²² Draft Rules were published in exercise of the powers conferred by § 159 of the Patents Act, 1970 *vide* notification of the Government of India in the Ministry of Commerce and Industry (Department of Industrial Policy and Promotion) No. S. O. 1018(E) dated 20th September 2002 in Pt. II, Section 3 (ii) (Extraordinary) for inviting objections and suggestions from persons affected thereby before expiry of a period of thirty days from the date on which copies of the Gazette containing the Notification were made available to the public.

²³ The copies of the Gazette containing the draft Rules were made available to public on 3rd October 2002.

²⁴ Vide S. O. 1418(E) dated 28th December 2004, published in the Gazette of India, Pt. II, Section 3 (ii) (Extraordinary) w.e.f. January 1, 2005

²⁵ Vide S. O. 657 (E) dated 5th May, 2006, published in the Gazette of India, Pt. II, Section 3 (ii) (Extraordinary) w.e.f May 5, 2006.

²⁶ See Draft MOPP, (*supra* note 10), at 8

and four schedules. The chapters provide for detailed procedures that lead to the granting of patents²⁷, and the schedules provide the prescribed fees and forms.²⁸

2. Patent Administration in India

The Office of the Controller General of Patents & Designs administers the Patent Act, 1970 and the Rules made there under. Any reference to the “Central Government” in the Act or the Rules refers to the Government of India, typically represented by the Secretary, the Department of Commerce & Industry. The Office of the Controller General of Patents & Designs is also responsible for the administration of Trademarks and Geographical Indications. The Ministry of Industrial Policy & Promotion, through the Joint Secretary, has administrative and supervisory control over the office of the Controller General of Patents, Designs, Trade Marks and Geographical Indications.²⁹ For the purposes of the Patents Act, 1970 and the Rules, the Controller General acts as the Controller of Patents.³⁰ Further, the Act also provides for an Appellate Board to entertain and admit appeals arising out of the orders of the Controller of Patents and to exercise jurisdiction with respect to proceedings to revoke a patent other than through a counter-claim in a suit for infringement. An Intellectual Property Appellate Board (IPAB) was established under section 83 of the Trade Marks Act, 1999³¹ to act as the Appellate Board for the purposes of the Patents Act, 1970.

²⁷ Chapter I Preliminary, Chapter II Applications For Patents, Chapter III International Applications Under Patent Cooperation Treaty (PCT), Chapter IV Publication And Examination Of Applications, Chapter V *omitted by the Patents (Amendments) Rules, 2005*, Chapter VI Opposition Proceedings To Grant Of Patents, Chapter VII Secrecy Directions, Chapter VIII Grant Of Patents, Chapter IX Amendment Of Application, Specification Or Any Document Relating Thereto, Chapter X Restoration Of Patents, Chapter XI Surrender Of Patents, Chapter XII Register Of Patents, Chapter XIII Compulsory License And Revocation of Patent, Chapter XIV Scientific Advisers, Chapter XV Patent Agents, Chapter XVI Miscellaneous

²⁸ See Patent Rules, 2003 (*supra* note 21) The First Schedule-Fees, The Second Schedule-Forms, The Third Schedule-Form of Patent, The Fourth Schedule - Costs to be awarded in various proceedings before the Controller under the Act.

²⁹ Appointed by the Central Government under § 4 of the Trade Marks Act, 1999, Act No. 47 of 2000.

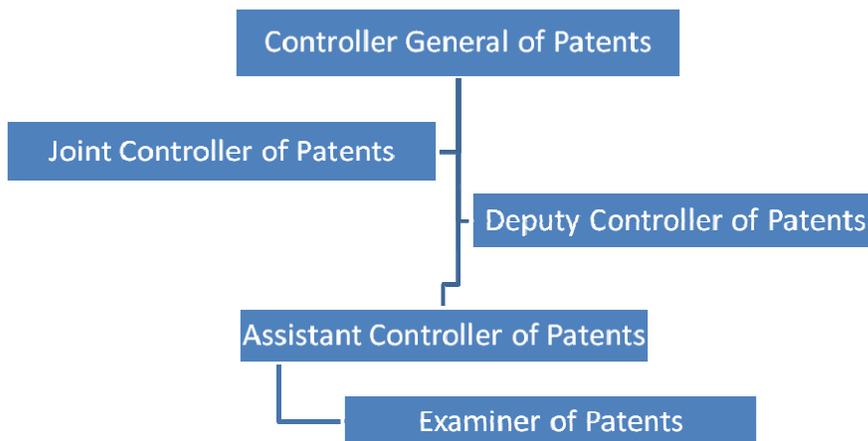
³⁰ See the Patents Act, 1970 (*supra* note 1) § 73(1)

³¹ The Patents Act, 1970 (*id.*) § 116 (1)

2.1 The Office of Controller of Patents

The Controller of Patents is the principal officer responsible for administering the patent system in India. The Controller is the overall supervisor of the four Patent Offices in Chennai, Delhi, Mumbai and Kolkata.³² Since the Controller also acts as the Registrar of Trademarks with the Head Office of Trade Marks in Mumbai the Controller of Patents functions from his office in Mumbai. Officially, the Head Office of Patents is in Kolkata (Calcutta)³³ The Examiners of Patents appointed under the Patents Act and other officers of the Patent Office³⁴ discharge their functions under the direction of the Controller.³⁵ The hierarchy of the officers at the Patent Office is illustrated below:

2.1.1 Hierarchy of Officers in Patent Office



³² The Patents Act, 1970 (*supra* note 1) § 74 (2) states:- “The Central Government may, by notification in the Official Gazette, specify the name of the Patent Office.”

³³ The Patents Act, 1970 (*id.*) § 74 (3) states:- “The head office of the patent office shall be at such place as the Central Government may specify, and for the purpose of facilitating the registration of patents there may be established, at such other places, as the central Government may think fit, branch offices of the patent offices.”

³⁴ The Patents Act, 1970 (*supra* note 1) § 73 (2)-For the purposes of this Act, the Central Government may appoint as many examiners and other officers and with such designations as it thinks fit.

³⁵ The Patents Act, 1970 (*id.*) § 73 (3) subject to the provisions of this Act, the officers appointed under sub-section (2) shall discharge under the superintendence and directions of the Controller such functions of the Controller under this Act as he may, from time to time by general or special order in writing, authorize them to discharge.

2.1.2 Powers of the Controller:

The Controller's powers, rights and duties include the following:

- (a) to receive, acknowledge, accept, publish and examine a patent application, claim, description and specification, etc.³⁶
- (b) to make search and investigate for anticipation by previous publication and by prior claim³⁷
- (c) to consider the report of the examiners,³⁸
- (d) to refuse application or require amended application, in certain cases³⁹
- (e) to make orders respecting division of application⁴⁰
- (f) to make orders respecting dating of applications⁴¹
- (g) to make orders regarding substitution of applicants⁴²
- (h) to receive, hear and dispose of representation by way of opposition against the grant of patent⁴³
- (i) to receive notice of opposition before the expiry of a period of one year from the date of publication of grant of a patent⁴⁴
- (j) to constitute the Opposition Board to examine the notice of opposition and to submit recommendation to the Controller⁴⁵
- (k) to consider the recommendation of the Opposition Board, hear the opponent and to make orders to maintain, amend or revoke the patent⁴⁶

³⁶The Patents Act, 1970 (*id.*) §§. 7, 8, 9, 10, 11A, 11B & 12

³⁷ The Patents Act, 1970 (*id.*) § 13

³⁸ See Patents Act, 1970 (*id.*) §. 14

³⁹ See Patents Act, 1970 (*id.*) § 15

⁴⁰See Patents Act, 1970 (*id.*) § 16

⁴¹ See Patents Act, 1970 (*id.*) § 17

⁴² See Patents Act, 1970 (*id.*) § 20

⁴³ See Patents Act, 1970 (*id.*) § 25 (1)

⁴⁴ See Patents Act, 1970 (*id.*) § 25 (2)

⁴⁵ See Patents Act, 1970 (*id.*) § 25 (3) (b)

⁴⁶ See Patents Act, 1970 (*id.*) § 25 (4)

- (l) to order mention of inventors as such in patent⁴⁷ provided the request or claim for such mention is made before the grant of patent⁴⁸
- (m) to issue secrecy directions for prohibiting or restricting the publication of information with respect to the invention relevant for defense purposes as notified by the Central Government⁴⁹
- (n) to revoke secrecy directions on being notified by the Central Government⁵⁰
- (o) to issue written permit to a person resident in India to make an application outside India for the grant of a patent for an invention⁵¹
- (p) to grant patent⁵²
- (q) upon grant, to publish the fact that the patent has been granted and the application, specification and other documents related thereto are open for public inspection⁵³
- (r) to issue directions to the co-owners of a patent with regard to the sale or lease of the patent or any interest therein⁵⁴
- (s) to grant patent for improvement or modification as a patent of addition⁵⁵
- (t) to allow or refuse an application to amend an application for patent or specification or any documents related thereto⁵⁶
- (u) to allow restoration of lapsed patent⁵⁷
- (v) to receive, hear opposition in respect of application for surrender of patent and to order for revocation⁵⁸
- (w) to carry out the directions of the Central Government in respect of grant of a patent for an invention relating to atomic energy⁵⁹

⁴⁷ See Patents Act, 1970 (*id.*) § 28 (1)

⁴⁸ See Patents Act, 1970 (*id.*) § 28 (4)

⁴⁹ See Patents Act, 1970 (*id.*) § 35 (1)

⁵⁰ See Patents Act, 1970 (*id.*) § 36

⁵¹ See Patents Act, 1970 (*id.*) § 39

⁵² See Patents Act, 1970 (*id.*) § 43 (1)

⁵³ See Patents Act, 1970 (*id.*) § 43 (2)

⁵⁴ See Patents Act, 1970 (*id.*) § 51

⁵⁵ See Patents Act, 1970 (*id.*) § 54

⁵⁶ See Patents Act, 1970 (*id.*) § 57

⁵⁷ See Patents Act, 1970 (*id.*) § 61

⁵⁸ See Patents Act, 1970 (*id.*) § 63

⁵⁹ See Patents Act, 1970 (*id.*) § 65

- (x) to keep, control and manage the Register of Patents under the superintendence and directions of the Central Government⁶⁰
- (y) to register assignments, transmission, mortgage, license or any other instruments creating an interest in a patent⁶¹
- (z) in any proceedings before him, to enjoy the rights and privileges of a civil court⁶²
- (aa) to correct clerical errors, etc. in any patent or in any specification for a patent or any clerical error in any manner which is entered in the register⁶³
- (bb) to receive evidence by way of affidavit or to take oral evidence and to allow any party to be cross examined on the contents of his affidavit⁶⁴
- (cc) to grant compulsory licenses in respect of patented invention that has not worked in India or is not available to the public at a reasonably affordable price⁶⁵
- (dd) to revoke the patent for non-working⁶⁶
- (ee) to grant license for related patents⁶⁷
- (ff) to grant compulsory license on the declaration of the Central Government of the circumstances of national emergency or of extreme urgency⁶⁸
- (gg) to grant compulsory licenses for export of patented pharmaceutical products in certain exceptional circumstances⁶⁹
- (hh) to appear and be heard in any proceedings before the Appellate Board in which the relief sought includes alteration or rectification of the register of patents or in which any question relating to the practice of

⁶⁰ See Patents Act, 1970 (*id.*) § 67

⁶¹ See Patents Act, 1970 (*id.*) § 69

⁶² See Patents Act, 1970 (*id.*) § 77

⁶³ See Patents Act, 1970 (*id.*) § 78

⁶⁴ See Patents Act, 1970 (*id.*) § 79

⁶⁵ See Patents Act, 1970 (*id.*) § 84

⁶⁶ See Patents Act, 1970 (*id.*) § 85

⁶⁷ See Patents Act, 1970 (*id.*) § 91

⁶⁸ See Patents Act, 1970 (*id.*) § 92

⁶⁹ See Patents Act, 1970 (*id.*) § 92A

patent office is raised or in any appeal to the Appellate Board from an order of the Controller⁷⁰

- (ii) to maintain the register of patent agents⁷¹
- (jj) to remove the name of any from the register of patent agents⁷²
- (kk) to refuse to deal with certain agents⁷³
- (ll) to call for information from patentees as to the extent to which the patented invention has been commercially worked in India and/or other information related thereto⁷⁴

2.2 Intellectual Property Appellate Board

The Intellectual Property Appellate Board (IPAB) was established on September 15, 2003 by the Central Government under the provisions of section 83 of the Trade Marks Act, 1999⁷⁵. The Patents Act, 1970 (as amended in 2002) provided for designation of IPAB as the Appellate Board for the purposes of the Patents Act, 1970.⁷⁶ The Ministry of Commerce and Industry, Government of India recently announced the appointment of a Technical Member on the IPAB effective as of April 2, 2007. The IPAB is headquartered in Chennai and also conducts hearings on rotation in Chennai, Delhi, Mumbai, Kolkata and Ahmedabad.

⁷⁰ See Patents Act, 1970 (*id.*) § 117E

⁷¹ See Patents Act, 1970 (*id.*) § 125

⁷² See Patents Act, 1970 (*id.*) §130

⁷³ See Patents Act, 1970 (*id.*) §131

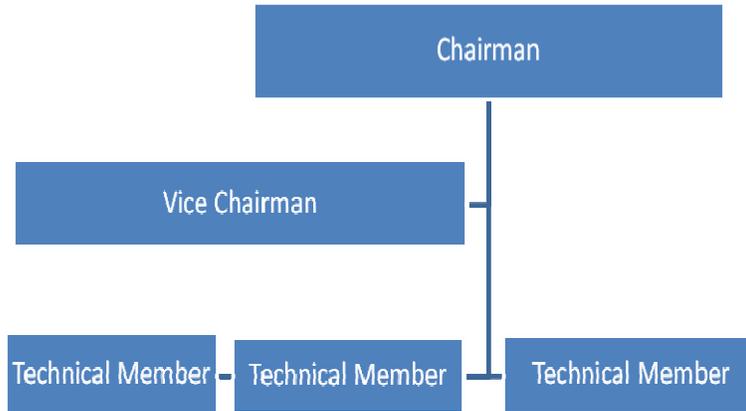
⁷⁴ See Patents Act, 1970 (*id.*) §146

⁷⁵ *Vide* Ministry of Commerce and Industry Notification S. O. No. 1049(E) dated 15th September 2003, published in the Gazette of India (Extraordinary), Pt. II, § 3(ii)

⁷⁶ The Patents Act, 1970 (*supra* note 1) § 116

2.2.1 Composition of the Appellate Board

The composition and hierarchy of the Appellate Board is illustrated below:



2.2.2 Powers and Jurisdiction of the Appellate Board:

As of April 2, 2007, the Appellate Board is empowered to receive, hear and dispose of all appeals from any order or decision of the Controller and all cases pertaining to the revocation of a patent, other than through a counter-claim in a suit for infringement. The Appellate Board may proceed with the matter either *de novo* or from the stage at which it was transferred on appeal.⁷⁷ The jurisdiction to hear patent infringement cases continues with the High Courts.

3. Patentability

Indian patent law does not affirmatively recite those inventions for which patents may be granted. The Act instead provides a list of subject matter excluded from patentability and a scheme for granting patents if the invention claimed in a patent application does not contravene its provisions. A patent shall be granted if an invention meets the requirements of the Act which include the basic test of patentability – whether the invention is new, non-obvious and capable of industrial application. The term

⁷⁷ The Patents Act, 1970 (*id.*)

‘invention’ has been interpreted to mean finding out something which has not been found out by other people.⁷⁸ It is not necessary that the invention be complicated but the essential aspect is that the inventor should be the first person to adopt it.⁷⁹ These earlier interpretations term ‘invention’ may not be as dependable today given recent interpretations of such terms as ‘inventive step’, and ‘new invention.’

3.1 Statutory Provisions

Interpretation in the Act of such terms as ‘invention,’ ‘inventive step’ and ‘new invention’ are critical to the determination of patentability. Therefore, it is helpful to trace how the term ‘invention’ has been defined under the Indian patent laws. The original definition of ‘invention’ per Section 2 (j) of the Patents Act of 1970 is as follows:

invention" means any new and useful-

- (i) *art, process, method or manner of manufacture;*
- (ii) *machine, apparatus or other article;*
- (iii) *substance produced by manufacture,*
and includes any new and useful improvement of any of them, and an
alleged invention;

Under this definition of “invention,” the Indian Patent Office attached great significance to the requirement that the invention be an article of “manufacture” and denied a number of patents. The Office based its rejection either on the ground that the claimed invention was not an article of “manufacture” at all or that there was no “vendible commodity.”⁸⁰

The definition of ‘invention’ was modified by the Patents (Amendment) Act, 2002. The modification of the definition was made to align it with the definition of

⁷⁸ *Pope Appliance Corpn. v. Spanish River Pulp and Paper Mills Ltd.*, AIR 1929 PC 38

⁷⁹ *Raj Prakash v. Mangat Ram* AIR 1978 Del. 1

⁸⁰ The above rationale was used by the Indian Patent Office in *Dimminaco AG v. Controller of Patents and Designs*(*infra* note 140) for refusing an application.

Article 27 of the TRIPS. Thus, ‘invention’ is currently defined as ‘*a new product or process involving one or more inventive step and capable of industrial application*’. Further, following the footnote of Article 27⁸¹ explaining the meanings of the expressions ‘inventive step’⁸² and ‘industrial application’⁸³ two new definitions were also introduced.

It is pertinent to note that the 2005 amendment retained the existing definition of “invention” but further introduced a new definition for a “new invention”⁸⁴. The interpretation of “new invention” is not yet clear because “new invention” is not reiterated in the Act. However, this definition is significant in determining when an invention is anticipated by prior public knowledge, publication or public working any where in the world. The phrase ‘fallen in public domain’ attaches considerable evidentiary obligations on the part of an applicant to prove novelty.

3.1.1 Exceptions before 2005

As described earlier, Chapter II of the Patent Act specifically delineates inventions for which a patent may not be granted. The Patents Act, 1970 as originally enacted, introduced section 3 which enumerated unpatentable subject mater. The original text of Section 3 is reproduced below:

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

- (i) an invention which is frivolous or which claims anything obvious contrary to well established natural laws;*

⁸¹ The foot note of TRIPS (*supra* note 5) says “For the purpose of this Article, the terms ‘inventive step’ and ‘capable of industrial application’ may be deemed by a Member to be synonymous with the terms ‘non- obvious’ and ‘useful’ respectively.”

⁸² § 2(1)(ja) of Patents Act, 1970 (*supra* note 1) states: “‘inventive step’ means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art.”

⁸³ § 2(1)(ac) of the Patents Act, 1970 (*id.*) “capable of industrial application”, in relation to an invention, means that the invention is capable of being made or used in an industry

⁸⁴ § 2 (l) of Patents Act, 1970 (*id.*) defines new invention as follows: new invention means any invention or technology which has not been anticipated by publication in any document or used in the country or else where in the world before the date of filing of patent application with complete specification, *i.e* the subject matter has not fallen in public domain or that it does not form part of the state of art;”

- (ii) *an invention the primary or intended use of which would be contrary to law or morality or injurious to public health;*
- (iii) *the mere discovery of a scientific principle or the formulation of an abstract theory;*
- (iv) *the mere discovery of any new property of new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant;*
- (v) *a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;*
- (vi) *the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;*
- (vii) *a method or process of testing applicable during the process of manufacture for rendering the machine, apparatus or other equipment more efficient or for the improvement or restoration of the existing machine, apparatus or other equipment or for the improvement or control of manufacture;*
- (viii) *a method of agriculture or horticulture;*
- (ix) *any process for the medicinal, surgical, curative, prophylactic or other treatment of human beings or any process for a similar treatment of animals or plants to render them free of disease or to increase their economic value or that of their products.*

With respect to medicines, the Patents Act, 1970 introduced an independent section 5, which stated:

Inventions where only methods or processes of manufacture patentable

(1) In the case of inventions-

- (i) claiming substances intended for use, or capable of being used, as food or as medicine⁸⁵ or drug, or*

⁸⁵ § 2(k) Patents Act, 1970 (*id.*) defined “medicine or drug” as:
(k) medicine or drug" includes-

(ii) relating to substances prepared or produced by chemical processes (including alloys, optical glass, semi-conductors and inter-metallic compounds),

no patent shall be granted in respect of claims for the substances themselves, but claims for the methods or processes of manufacture shall be patentable.

In order to comply with the requirements for mail box applications, the Act 17 of 1999 inserted the following clause under section 5:

[(2) Notwithstanding anything contained in sub-section (1), a claim for patent of an invention for a substance itself intended for use, or capable of being used, as medicine or drug, except the medicine or drug specified under sub-clause (v) of clause (1) of sub-section (1) of section 2, may be made and shall be dealt, without prejudice to the other provisions of this Act, in the manner provided in Chapter IVA.]

An explanation was added by the Act 38 of 2002 which brought biochemical, biotechnological and microbiological process within the ambit of the section.⁸⁶

Act 38 of 2002 brought further changes in the Chapter. The following are the changes that were brought out by modifications of the sections:

1. Sub section (b) underwent substitution as

“An invention the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human animal or plant life or health or to the environment.”⁸⁷

-
- (i) all medicines for internal or external use of human beings or animals,
 - (ii) all substances intended to be used for or in the diagnosis, treatment, mitigation or prevention of diseases in human beings or animals,
 - (iii) all substances intended to be used or in the maintenance of public health, or the prevention or control of any epidemic disease among human beings or animals,
 - (iv) insecticides, germicides, fungicides, weedicides and all other substances intended to be used for the protection or preservation of plants,

all chemical substances which are ordinarily used as intermediates in the preparation or manufacture of any of the medicines or substances above referred to;

⁸⁶ § 5 Patents Act, 1970 (*id.*) provided as an explanation that: “Explanation: For the purpose of this section, “chemical process” includes biochemical biotechnological and microbiological process.”

⁸⁷ This provision paraphrases TRIPs (*supra* note 5) Art 27(2).

2. Sub-section (c) was amended and now reads the mere discovery of a scientific principle or the formulation of an abstract theory *or discovery of any living thing or non living substances occurring in nature*⁸⁸
3. Subsection (g) was omitted and sub section (i) was amended to add the words “diagnostic and therapeutic” after the words medicinal, surgical, curative, prophylactic and delete words “or plants”.

The following are the additions made to the section 3:

1. *(j) plants and animals in whole or any part thereof other than microorganisms but including seeds, varieties and species and essentially biological processes for the production or propagation of plants and animals;*
2. *(k) a mathematical or business method or a computer program per se or algorithms;*
3. *(l) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;*
4. *(m) a mere scheme or rule or method of performing mental act or method of playing game*
5. *(n) a presentation of information;*
6. *(o) topography of integrated circuits;*
7. *(p) an invention which is effect, is traditional knowledge or which is an aggregation or duplication of known properties if traditionally known component or components.*

3.1.2 Exceptions after 2005 Amendment

Act No. 15 of 2005 brought out only one change in section 3 which has emerged as an important change to the Act.⁸⁹

⁸⁸ Please note that all additions have been *italicized*.

At present, non-patentable subject matter includes the following:

1. inventions contrary to natural law⁹⁰
2. inventions contrary to public order or morality⁹¹
3. the discovery of a scientific principle, abstract theory, discovery of a natural thing or discovery of a natural organism⁹²
4. (a) a new form of a known substance which lacks enhanced efficacy, (b) a new use of a known substance, or (c) the use of a known process, machine, or apparatus without a new product or a new reactant⁹³
5. a mere admixture of ingredients⁹⁴
6. a mere arrangement of known devices⁹⁵
7. agriculture or horticulture methods⁹⁶
8. diagnosis and treatment methods for humans or animals⁹⁷
9. non-micro-organism plants or animals⁹⁸
10. mathematical, algorithmic, or business methods or computer programs *per se*,⁹⁹
11. artistic works¹⁰⁰
12. mental acts or method of playing games¹⁰¹
13. presentations of information¹⁰²
14. integrated circuit topography¹⁰³
15. traditional knowledge or aggregations thereof¹⁰⁴, and
16. relating to atomic energy¹⁰⁵

⁸⁹ The Patents (Amendment) Act 2005 modified §3 (d). For the text of the section and associated discussion, see *infra* note 135 and text thereto.

⁹⁰ See Patents Act, 1970 (*supra* note 1) §3 (a)

⁹¹ See Patents Act, 1970 (*id.*) §3 (b)

⁹² See Patents Act, 1970 (*id.*) §3 (c)

⁹³ See Patents Act, 1970 (*id.*) § 3 (d)

⁹⁴ See Patents Act, 1970 (*id.*) §3 (e)

⁹⁵ See Patents Act, 1970 (*id.*) Sec 3 (f)

⁹⁶ See Patents Act, 1970 (*id.*) § 3 (h)

⁹⁷ See Patents Act, 1970 (*id.*) § 3 (i)

⁹⁸ See Patents Act, 1970 (*id.*) § 3(j)

⁹⁹ See Patents Act, 1970 (*id.*) §3 (k)

¹⁰⁰ See Patents Act, 1970 (*id.*) §3 (l)

¹⁰¹ See Patents Act, 1970 (*id.*) § 3(m)

¹⁰² See Patents Act, 1970 (*id.*) §3 (n)

¹⁰³ See Patents Act, 1970 (*id.*) §3 (o)

¹⁰⁴ See Patents Act, 1970 (*id.*) §3 (p)

¹⁰⁵ See Patents Act, 1970 (*id.*) §4

The long list of statutory exclusions originally provided in Section 3 of the Patents Act, 1970 continues to exist even after the TRIPS mandated amendments.

3.2 Novelty

The definition of ‘new invention’¹⁰⁶ according to the Amendment Act of 2005 describes any invention or technology as novel which has not been anticipated anywhere in the world. This definition endorses absolute novelty as the criteria for patentability. This requirement for absolute novelty is limited by section 25¹⁰⁷ and section 64¹⁰⁸ of the Act which provide that an opposition or revocation can be sustained only if the ‘invention is publicly known or publicly used in India..

The courts in India have observed that whether the alleged invention involves novelty and inventive step is a mixed question of law and fact that depends on the circumstances of the case.¹⁰⁹ In *Neiveli Ceramics & Refractories Ltd. v. Hindustan Sanitaryware & Industries Ltd.*¹¹⁰, it was held that even the disclosure to one person of the features claimed an invention earlier than the so called invention date would be enough to defeat a claim of novelty.¹¹¹

3.3 Inventive step/Non Obviousness

The text of the Act by the 2005 amendment defines “inventive step” as a feature of an invention that involves a “technical advance” as compared to existing knowledge; or as having “economic significance” or “both” that makes the invention not obvious to a person skilled in the art.¹¹² According to the draft Manual on Patent Practice and

¹⁰⁶ See *supra* note 84.

¹⁰⁷ See § 25 (2)(b) Patents Act, 1970 (*supra* note 1) (Grounds for opposition of a patent after grant).

¹⁰⁸ See §64 Patents Act, 1970 (*id.*) (Grounds for Revocation of Patents)

¹⁰⁹ *Polar Industries v. Jay Engineering* (1991) IPLR 150 (Cal.)

¹¹⁰ PTC (Suppl.) (2) 341 (Mad) (Decided on August,20 1974)

¹¹¹ See *id* at 355

¹¹² See § 2 (ja) Patents Act, 1970 (*supra* note 1)

Procedure (hereinafter, the “MOPP”)¹¹³, the Patent Office considers the following factors to determine inventive step:

1. scope and content of the prior art;
2. assessing the technical result and the economic value achieved by the invention;
3. differences between the relevant prior art and the claimed invention;
4. defining the technical problem to be solved as the object on the invention to achieve the result; and
5. final determination of non obviousness etc.

The Patents (Amendment) Act, 2005 attaches great significance to “economic value” factor as it alone could satisfy the test of inventive step. The standard for “economic significance” seems more relevant for assessing the industrial applicability than being a qualification for “inventive step.” Even though the Act does not define state of art or prior art, they have been included in the Act.¹¹⁴ The test for judging inventive step depends on the question whether a non - inventive mind have thought of the alleged invention. If the answer is negative, then the invention is considered non-obvious.¹¹⁵ The courts have at times held that the inventive step or obviousness has to be judged from the point of view of a person skilled in the art.¹¹⁶ A person skilled in the art should be presumed to be an ordinary practitioner aware about what is common knowledge in the relevant art at the relevant time.¹¹⁷ How far such knowledge anticipates the new invention is a question of fact depending on the facts and circumstances of the case.¹¹⁸ The invention is to be considered as a whole for assessing the inventive step and a conclusion cannot be drawn merely because an individual element of the claim taken separately is known or might be found to be obvious.¹¹⁹ In order to deprive an invention of patentability on the ground of anticipation by prior publication, it must be shown that

¹¹³ Draft MOPP (*supra* note 10)

¹¹⁴ See Patents Act, 1970 (*id.*) § 13 read with § 29 to § 34

¹¹⁵ Draft MOPP (*supra* note 10) at 12

¹¹⁶ *Kishore Mahadeo Pole, G.M. Walchnad Nagar Industries Ltd v. Thermax Pvt. Ltd* 1988 PTC 213

¹¹⁷ See “Chowdhary” *supra* note 7

¹¹⁸ *Lallubhai Chakubhai Jariwala v. Chimanlal Chunilal and Co.* AIR 1936 Bom. 99

¹¹⁹ See *id.* at 13

the invention claimed was published in any documents prior to the date of the application.¹²⁰

The amended definition of ‘inventive step’ combines the inventive step inquiry with a test ‘economic significance’ and raises a set of practical issues when prosecuting a patent application in India. Examiners are unclear how to apply the amended definition. The amended definition suggests that first the Examiner must determine if claimed invention passes the test of economic significance, and then proceed to ascertain if it is not obvious to a person skilled in the art. But, Examiners continue to raise claim rejections based on the core inventive step inquiry.

3.4 Industrial Applicability/Utility

The following conditions must be satisfied for the invention to be considered industrially applicable. The invention:

1. Can be made
2. Can be used at least in one field of activity
3. Can be reproduced with the same characteristics as many times as necessary.¹²¹

To be patentable, an invention must be useful, but mere usefulness is not sufficient to support the patentability of a patent application.¹²² Utility is not determined by the element of commercial or pecuniary success and has to be determined with reference to the state of things at the filing date of the patent application.

3.5 Patentable Subject Matter

India is a country that remains extremely cautious about the subject matter for which it grants patents, as well as the scope afforded to patents. This “caution” has a long history and is still very strong in the minds of the general public.¹²³

¹²⁰ *Bomay Agarwal Co., Alola v. Ramchand Diwanchand*, AIR 1953 Nag.154

¹²¹ Draft MOPP (*supra* note 10) at 13

¹²² *Indian Vacuum Brake Co. Ltd. v. E.S. Luard* AIR 1926 Cal. 152

¹²³ According to one author, the general mistrust towards a strong patent system, particularly the mind-set of the patent office in India can be traced back to the *Ayyangar Committee Report* (see *supra* note 17), which formed the basis of the Patents Act, 1970 (see *supra* note 1). Shamnad M. Basheer, "'Policy Style'

In order to understand the patentability of various subject matter in India, a review of the history of patent protection in India is helpful. The 1911 Act did not spell out any provision that categorically dealt with patentable subject matter. However, the Tek Chand Committee concluded from studying the definition of “invention”¹²⁴ and the provisions for refusing patent applications,¹²⁵ that in order to be patentable, subject matter was required to relate to a “manner of manufacture,” i.e., “it must be a process or apparatus, or a product of manufacture, but it must suggest an act to be done or an operation to be performed by subjecting materials to manual, mechanical, chemical, electrical or the like operation.”¹²⁶ Interestingly, results achieved by the working of an invention were not considered to constitute any manner of manufacture.¹²⁷

In relation to patentable subject matter, the Tek Chand Committee Report in its recommendations stated that “The Indian Patents and Designs Act does not clearly indicate the field of inventions to which patent protection is available, and to the extent that it does, it is inadequate to meet the present needs of the country.”¹²⁸ Although the

Reasoning at the Indian Patent Office,” *Intellectual Property Quarterly*, 309-323, Vol. 3, 2005. Available at SSRN: <http://ssrn.com/abstract=829464> (Last visited May 21, 2007) [Hereinafter, “Basheer: Policy Style”]. Today, even though almost half a century has passed since the Ayyangar Report was submitted, the impression that patents are all bad for the Indian economy and against public interest, forms the basis of most public debates relating to patents in India. This was also evident from the recent reaction of the public after the release of the Report of the Technical Expert Group on Patent Law Issues (December 2006) (Hereinafter, the “*Mashelkar Committee Report*”). During the debates leading to the Patents (Amendments) Act, 2005, it was decided that a expert group would be set up to look into the issue of whether it would be TRIPs compliant to exclude micro-organisms from being patentable and whether the patentability of pharmaceutical substances could be limited to “new chemical entities (NCE)” or “new medical entities (NME).” Accordingly, a *Technical Expert Group (TEG) on Patent Law Issues* was set up by the Government of India, Ministry of Commerce & Industry, Department of Industrial Policy & Promotion *vide* O. M. No. 12/14/2005-IPR-III dated April 5, 2005. The report of the TEG was eventually withdrawn due to public controversy. A copy of the report is available at: http://www.patentoffice.nic.in/ipr/patent/mashelkar_committee_report.doc (last visited May 21, 2007).

¹²⁴ § 2(8) of the 1911 Act

¹²⁵ § 2(10) of the 1911 Act

¹²⁶ See THE REPORT OF THE PATENTS ENQUIRY COMMITTEE, 37 (1948-50) [Hereinafter, the “Tek Chand Committee Report”]

¹²⁷ Further, the committee also concluded that the 1911 Act required inventions to be new, involve an inventive step, have utility, and not be contrary to law or morality in order to be patentable. In relation to the patentability of (a) agriculture, horticulture and biological process and products; (b) discoveries capable of industrial application, but which are not concerned with making any vendible products; and (c) A chemical compound per se without reference to the process of its manufacture, the committee found that the 1911 Act contained no guidance. See Tek Chand Committee Report (*id.*) at 38.

¹²⁸ See Tek Chand Committee Report (*id.*) at 60

Committee did not suggest any definition for “patentable invention”, it looked into the provisions relating to patentable inventions in a number of countries and recommended, inter alia, that at the time of the revision of the Act, the following considerations be kept in mind:

- (1) Invention should be given a wider meaning, so as to “include inventions capable of application for industrial uses, even if they are concerned with processes only and do not result in the manufacture of any article.”¹²⁹
- (2) “Substances prepared or produced by chemical processes or intended for food or medicine should not be patentable except when made by the invented process or their obvious equivalents.
- (3) Inventions of which the primary or intended use would be contrary to law or morality should not be patentable.”¹³⁰

The recommendations of the Tek Chand Committee resulted in the amendment of sections 22, 23 and 23A to 23G of the Indian Patents and Designs Act, 1911. However, the major change in Indian patent law and policy was a result of the Ayyangar Committee. The Committee broadened its scope of investigation and went beyond the Tek Chand committee in investigating the effect that patent law as it was in 1950 had on the Indian economy.¹³¹

The Ayyangar Committee, upon analyzing the data collected by the Tek Chand Committee, found that the ratio of patents held by foreigners versus those held by Indian

¹²⁹ Compare to Thomas Brandt Application? Vendible commodity requirement?

¹³⁰ See Tek Chand Committee Report (*supra* note 126). The other recommendations made by the committee related to the determining the scope of novelty, inventive step and utility, the patent office, abuse of patent rights, compulsory searches, opposition proceedings etc. See Tek Chand Committee Report (*id.*) at 65-85.

¹³¹ Ayyangar Report (*supra* note 15) at 11, 23: The Ayyangar committee was of the view that (1) in order to maintain the rate of invention, the country in question must be “technologically advanced.” In order to ensure this, there must be (a) a considerable degree of diffusion of scientific and technological education and a high number of people reaching high proficiency by such education; (b) a massive industrial production which could absorb the products of the education; (c) a sufficient amount of speculative capital must be forthcoming for being risked into investment in new ventures and for profitable utilization in such industries. (2) The committee also stated that the patents must be worked in the country granting the patent in order to ensure that the country gains the full benefit of the patent system.

nationals was a dismal 9:1 (i.e., 90% of Indian patents were held by foreigners).¹³² Inspired by the historical and contemporary practices of other countries at the time, the Ayyangar committee recommended (in relation to subject matter) that the patent system in India be improved by “defining with precision inventions which should be patentable and by rendering unpatentable certain inventions, the grant of patents to which, will retard research or industrial progress or be detrimental to national health or well being.”¹³³

Going well beyond the Tek Chand Committee’s recommendations, the Ayyangar Committee recommended specific clauses to be considered for inclusion into the new Indian patent law. The recommendations of the Ayyangar Committee were accepted almost in their entirety¹³⁴ and resulted in the 1970 Act. No public outcry nor substantial issues relating to patentability arose under the 1970 Act until after India signed the TRIPs Agreement.

3.5.1 Patentability Issues

3.5.1.1 Pharmaceutical Substance

The deletion of section 5 and the new revised section 3 (d) has made the issue of patentability of pharmaceutical products the focal point of international interest in Indian patent laws. A look at the Parliamentary debates suggests that section 3(d) was introduced with the aim of discouraging what is popularly termed as “evergreening of patents.” For this reason, it may be safe to presume that the expected standard of ‘efficacy’ under section 3(d) will be very high.¹³⁵

¹³² The report stated that this was the case despite India having attained independence and the opening of several institutions for higher learning and advanced research. See Ayyangar Report (*id.*) at 12, 26.

¹³³ See Ayyangar Report (*id.*) at 19, 45

¹³⁴ With a few minor additions/deletions. For example, the clause excluding “a method or process of testing applicable during the process of manufacture for rendering the machine, apparatus or other equipment more efficient or for the improvement or restoration of the existing machine, apparatus or other equipment or for the improvement or control of manufacture” under section 3 was not originally recommended by the Ayyangar Committee.

¹³⁵ Sri Kamal Nath, Minister of Commerce and Industry, while answering the concerns voiced by other members of the Lok Sabha (Lower House) in relation to the ‘evergreening’ of patents, quoted section 3(d)

The constitutionality of the amendments to Section 3(d) is currently under judicial scrutiny. Novartis AG had filed a Writ Petition in the Chennai High Court challenging an Order of the Controller of Patents rejecting a patent application for an invention of a cancer drug *β-Crystalline form of imatinib mesylate*. The applicant has alleged before the Chennai High Court that Section 3(d)¹³⁶ of the Patents Act, 1970 (as amended) is unconstitutional. The rationale is that it falls short of India's obligations as a TRIPS signatory. A larger question is whether international treaty obligations could be read automatically into the national laws pursuant to the scheme of the Indian Constitution.¹³⁷ While part of the appeal has been transferred to the IPAB (the part challenging the Controller's Order as to patentability under section 3(d)), the High Court has reserved for orders the question on the constitutional validity of the amended Section 3(d).

It can be observed that while new pharmaceutical drugs are patentable under both the US and Indian Patent Laws, Indian Patent Law is more restrictive in granting pharmaceutical patents.¹³⁸ This is despite legal and inventive step arguments made by an Applicant because pharmaceutical inventions will likely require evidence of significantly higher efficacy in order to be granted.

and said that "There is no question of evergreening". Shri Kharabela Swain, opposing the Bill opined that patents should be given for 'incremental use' as Indian scientists do not have the know-how or capital to come up with new chemical entities, but do have the know how to make improvements. Thus, patents ought to be given for incremental innovations. See Lok Sabha debate at <http://164.100.24.208/debate14/debtext.asp?sln=1745&ser=patents&smode=t> (last visited, May 21, 2007). As quoted in Basheer S and Kochupillai M "The Patents (Amendment) Act 2005: Its Implications in and outside India" 62 IIP 43 (2005).

¹³⁶ The Patents Act, 1970 (supra note 1) § 3 (d) states: "the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

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

¹³⁷ As per the judgment of the Supreme Court of India in *Vishaka v. State of Rajasthan* AIR 1997 SC 3011, India's obligations under an international treaty may be read into the Constitution provided there is no law to the contrary. In the present case, since there is a law in place, under the logic of *Vishaka*, the court cannot automatically read TRIPs obligations into the national laws or the Constitution.

¹³⁸ See Patents Act, 1970 (*Id.*).

3.5.1.2 Microorganisms

Until 2002, microorganisms were not patentable subject matter in India. By virtue of the Patents (Amendment) Act, 2002, microorganisms may now be awarded patents.¹³⁹ The positive approach of the Judiciary in this regard was reflected in *Dimminaco AG v. Controller of Patents and Designs*.¹⁴⁰ In this case, the Patent Office had refused an application claiming “a process for preparation of a vaccine which is capable of protecting poultry against infectious bursitis infections”¹⁴¹ stating that the term “manufacture” under the Patent Act did not include a process that had as its end product a “living substance.” The decision was challenged before the Kolkata High Court and the Court reversed the decision of the Indian Patent Office.¹⁴² The Patent Office was asked to reconsider the application in line with the decision of the High Court and the application was eventually accepted by the Patent Office.¹⁴³

3.5.1.3 Plants

In a recent decision, *Speaking Roses International Inc. v. Controller-General of Patents & Anr.*,¹⁴⁴ the petitioners applied for a patent for a method of ‘providing an image on the organic product’ (particularly flowers). The application was rejected under Section 3(j) of the Patents Act. On appeal, the decision refusing the patent was overturned on the grounds that *Sec. 3(j) prohibits the patenting of plants and animals or biological processes* and because the petitioner in the case was seeking a patent for providing images on flowers and not the flowers themselves, the same was patentable.

¹³⁹ See Patents Act, 1970 § 3 (j)

¹⁴⁰ App. No.135/Cal/98 (filed on January 28, 1998)

¹⁴¹ For a detailed and interesting discussion of this case, see Basheer: Policy Style (*supra* note 128).

¹⁴² (2002) I.P.L.R. July 255, Kolkata High Court

¹⁴³ See *id.*

¹⁴⁴ Misc. Petition No. 13/2006; decided 12th February 2007

3.5.1.4 Software

An attempt was made in the Patents (Amendment) Ordinance, 2004 to explain what types of computer software inventions are patentable. Sub-section 3(k) proposed in the Ordinance reads as follows:

“(k) a computer program per se other than its technical application to industry or a combination with hardware;

(ka) a mathematical method or a business method or algorithms”.

This section was however substituted by the Patents (Amendment) Act, 2005, which reverted to an earlier position, namely, that “a mathematical or business method or a computer programme per se or algorithms” are not inventions within the meaning of the Act. This leaves it to the discretion of the patent examiners to decide what is not a computer programme *per se*. Often they apply the test as used at the European Patent Office and equate the expression ‘*per se*’ with ‘as such’ as used in the European Patent Convention.¹⁴⁵ Business methods are not patentable under any circumstance and neither are gaming methods and presentations of information. However, the Draft Manual on Patent Procedure, in Appendix II, provides guidelines for patenting computer related inventions when claimed as a combination of hardware and software.¹⁴⁶ The computer software patenting guidelines appended to the Manual were based on the amendments to Section 3(k) & (ka) as contained in the Patents (Amendment) Ordinance, 2004. The Parliamentary Committee that reviewed the Ordinance did not agree to the proposed language and retained the original wordings. Therefore the guidelines are likely to undergo further changes.

3.5.1.5 Traditional Knowledge and Biodiversity

Sub-section 3(p) was inserted into the Patents Act, 1970 by the Patents (Amendment) Act, 2002 to protect the traditional knowledge and biodiversity of India. A

¹⁴⁵ Article 52 (2)(c) and (3) of the European Patent Convention

¹⁴⁶ See Draft MOPP (*supra* note 10) 156

number of corresponding amendments were made in other sections of the Patents Act. A proviso was added to section 10(4) whereby every patent specification is required to disclose the source and geographic origin of any biological material used in the invention. Further, section 25 provides that a patent may be opposed on the grounds that (1) the invention claimed does not disclose or wrongly mentions the source or the geographical origin of the biological material used for the ‘invention’; or (2) the invention has been anticipated by ‘knowledge’ – oral or otherwise – available within any local or indigenous community in India or elsewhere.

4. The Application

Filing an application is typically the first step towards procuring a patent in India. Indian practice follows the single inventive concept meaning that one application should be filed for each invention or inventive concept. A process and product for manufacturing that product is considered as one invention. However subsequent methods of using the product are treated as a separate invention.

The true and first inventor¹⁴⁷, his or her assignee¹⁴⁸ and/or legal representative¹⁴⁹ of any deceased person who immediately before his or her death was entitled to make such application can make the application for grant of patent for an invention in India.¹⁵⁰ In the U.S. only individuals are eligible for filing an application, whereas the Courts in India have confirmed that a firm can apply for a patent as an assignee.¹⁵¹

4.1 Ordinary Application

An application for patent without any claim for priority made under any convention and without reference to any other application is referred to as an ordinary

¹⁴⁷ See Patents Act, 1970 (*supra* note 1) § 2(1) (y) “true and first inventor” does not include either the first importer of an invention into India, or person to whom an invention is first communicated from outside India.

¹⁴⁸ See Patents Act, 1970 (*id.*) § 2(1) (ab) “assignee” includes an assignee of the assignee and the legal representative of the deceased assignee and reference to the assignee of any person include references to the assignee of the legal representative or assignee of that person.

¹⁴⁹ See Patents Act, 1970 (*id.*) § 2 (1) (k) “legal representative” means a person who in law represents the estate of a deceased person.

¹⁵⁰ See Patents Act, 1970 (*id.*) § 6

¹⁵¹ *Shinning Industries v. Shri Krishna Industries*, AIR 1975 All. 231

application. Every ordinary application is required to be filed in duplicate¹⁵² in Form –1¹⁵³ (Appendix I) with the concerned Patent Office.¹⁵⁴ The territorial jurisdiction of the Patent Office is based upon whether any of the following falls within the territory of that Patent Office:

- a. Place of residence, domicile or business of the applicant (or of the first mentioned applicant in case of joint applicants);
- b. Place from where the invention actually originated; or
- c. Address for service in India as given in the application when the applicant has no place of residence, domicile or business in India.¹⁵⁵

Every application is required to specify that the applicant is in possession of the invention and shall also state the name and address of the first and true inventor.¹⁵⁶ A patent application must be accompanied by the following documents.

- (a) Provisional or Complete Specification in Form 2 (Appendix II) and drawings if any¹⁵⁷;
- (b) Statement and Undertaking regarding foreign filing details in respect of the same or substantially same invention in Form 3¹⁵⁸ (Appendix III) ;
- (c) Declaration as to inventor ship in Form 5 (Appendix IV) (in case application is filed with the complete specification)¹⁵⁹;
- (d) Priority document (in case of convention application)¹⁶⁰;
- (e) Power of Attorney, if application is made through a patent agent¹⁶¹; and
- (f) Proof of right if the application is made by the assignee.¹⁶² Proof of right can be filed by way of separate assignment deed or by incorporating in the body of

¹⁵² See Draft MOPP (*supra* note 10)

¹⁵³ See the Patent Rules, 2003 (*supra* note 21).

¹⁵⁴ There are four patent offices, Mumbai, Delhi, Chennai and Kolkata, which is the Head Office.

¹⁵⁵ See Rule 5 of the Patent Rules, 2003 (*supra* note 21)

¹⁵⁶ See the Patents Act, 1970 (*supra* note 1) § 7 (3)

¹⁵⁷ See Rule 13 &15 of the Patent Rules, 2003 (*supra* note 21)

¹⁵⁸ See § 8(1) of the Patents Act, 1970 (*supra* note 1) and Rule 12 of the Patent Rules, 2003 (*id.*)

¹⁵⁹ See Rule 13(6) of the Patent Rules, 2003 (*id.*)

¹⁶⁰ See § 138 e Patents Act, 1970 (*supra* note 1).

¹⁶¹ See Rule 135(1) of the Patent Rules, 2003 (*supra* note 21)

the application by endorsement in Form 1. (See Appendix I) In case the legal representative makes application, “death certificate” of the deceased would be treated as the proof of right.

The fee for filing the application (Rs. 1000/- for natural person and Rs. 4000/- for other than natural person) can be paid within one month of filing¹⁶³ and the aforesaid proof of right can be filed within three months of the application. Further, the cost is also depended on the number of claims, priority dates and the number of pages of the complete specification.

4.2 International/PCT Application

An international application filed in accordance with the Patent Cooperation Treaty (PCT)¹⁶⁴ is known as a PCT International application. A PCT international application designating India, if filed with the Controller of Patents in India within 31 months from its international date of filing, is referred as a PCT National Phase application and is treated as if the application were filed under the Act.¹⁶⁵ The filing date of the national phase application shall be the international filing date accorded under the PCT. Every PCT national phase application shall be accompanied by a complete specification. The title, description, drawings, abstract and claims filed with the application are treated as the complete specification by the Patent Office.¹⁶⁶ The time limit prescribed for entering into the national phase is thirty-one months from the priority date,¹⁶⁷ but an application could be examined or processed at any time before this time limit if an express request to the Patent Office is made.¹⁶⁸ Usually, the Patent Office commences the processing and examination of the application only after the thirty-one month period has lapsed.¹⁶⁹ Unlike U.S. and certain other countries, national phase entry

¹⁶² See Draft MOPP (*supra* note 10)

¹⁶³ See Rule 7 (2) Patent Rules, 2003 (*supra* note 21)

¹⁶⁴ See § 2(1)(ia) Patents Act, 1970 (*supra* note 1).

¹⁶⁵ See § 7(1A) Patents Act, 1970 (*id.*)

¹⁶⁶ See § 10 (4A) of the Patents Act, 1970 (*id.*)

¹⁶⁷ See Rule 20 (4) (i) of the Patent Rules, 2003 (*supra* note 21).

¹⁶⁸ See Rule 20 (4) (ii) of the Patent Rules, 2003 (*id.*)

¹⁶⁹ See Rule 20 (2) of the Patent Rules, 2003 (*id.*)

cannot be postponed and the non-compliance of the requirements would cause the application to be treated as abandoned.¹⁷⁰

4.3 Convention Application

A convention country is any country which is a signatory or a party to an international or bi-lateral treaty or convention or arrangement to which India is a signatory or party whereby privileges granted to their citizens are likewise granted to Indian citizens.¹⁷¹ In order to claim convention status, an applicant should file the application in the Indian Patent Office within a period of twelve months from the date of filing a similar application in the convention country.¹⁷² The applicant will not be entitled to any benefit of provisions as no retrospective effect can be claimed for an application filed in a country before declaring it as a convention country.¹⁷³ The convention application should include:

- (a) A complete specification;
- (b) Specify the date and the convention country in which the application was made; and
- (c) State that no application for protection in respect of that invention has been made in a convention country before that date.¹⁷⁴

If two or more applications have been made with respect of inventions in more than one convention country, and the inventions are related to constitute one invention, one application may be made within a period of twelve months from the date on which the earlier or earliest of such applications was made.¹⁷⁵ If any of the documents filed are in a foreign language, the Controller may request the translation of the document verified by affidavit or otherwise to his satisfaction.¹⁷⁶

¹⁷⁰ See Rule 22 of the Patent Rules, 2003 (*id.*)

¹⁷¹ § 2 (d) read with § 133 Patents Act, 1970 (*supra* note 1)

¹⁷² § 135 Patents Act, 1970 (*supra* note 1)

¹⁷³ *Daniel AC Officine Meccaniche SPA v. Controller of Patents and Designs* 2000 PTC 219 (DB)

¹⁷⁴ The Patent Rules, 2003 (*supra* note 21) Rule 136

¹⁷⁵ § 137 (1) Patents Act, 1970 (*supra* note 1)

¹⁷⁶ See § 138 (2) Patents Act, 1970 (*id.*)

4.4 Application for Addition

A Patent of Addition enables the applicant to apply for an improvement or modifications made on the invention disclosed in the complete specification.¹⁷⁷ The improvement must be something more than a mere workshop improvement.¹⁷⁸ The term for a Patent of Addition shall not exceed the term of a regular patent,¹⁷⁹ and shall not be granted prior to the date of grant of a patent for the main invention.¹⁸⁰ A Patent of Addition cannot be questioned on the ground that the invention ought to have been the subject of an independent patent.¹⁸¹

The complete specification for a Patent of Addition shall include specific reference to the number of the main patent or the application number of the main patent as the case may be. The applicant for a Patent of Addition must also make a statement to the effect that the invention comprises an improvement in or a modification of the invention claimed in the specification of the main patent granted or applied for.

4.5 Divisional Application

A divisional application is an application divided out of parent application. A divisional application is preferred when the applicant claims more than one invention and the law does not permit multiple patents in one invention. Applicants, at their own request, before the grant of patent, divide the application and file two or more applications as desired for the invention. The main objective of the divisional application is to meet the official objections raised by the Controller on the question of an application disclosing more than one invention.¹⁸² It is not clear as to whether the applicant may file a divisional from another divisional while maintaining the priority claim to the original

¹⁷⁷ See § 54 (1) Patents Act, 1970 (*id.*)

¹⁷⁸ *Biswanath Prasad Radhey Shyam v. Hindusthan Metal Industries*, AIR 1982 SC 144

¹⁷⁹ § 55 Patent Act, 1970 (*supra* note 1)

¹⁸⁰ See § 54 (4) Patents Act, 1970 (*id.*)

¹⁸¹ See § 56 (1) Patents Act, 1970 (*id.*)

¹⁸² See § 16 Patents Act, 1970 (*id.*)

application. The complete specification for a divisional application should not include any matter not disclosed in the complete specification of the first application.

4.6 Specification

A Specification is should accompany an application for patent.¹⁸³ A patent specification is a technical and legal document susceptible to interpretation by court of law.¹⁸⁴ The main function of a specification is to convey to the public what the patentee considers to be invention.¹⁸⁵ The specification shall be filed in Form 2¹⁸⁶ and the Act facilitates the filing of provisional specification and awards a time span of twelve months to file complete specification.¹⁸⁷ (See Appendix II for Form 2)

4.6.1 Provisional Specification

The main objective of filing a provision specification is to obtain priority over any other person who is likely to apply for the same invention developed concurrently in any other part of the world.¹⁸⁸ A provisional specification shall contain a description of the invention along with a title and is not replaced by the complete specification but is regarded as an independent document.¹⁸⁹ A complete specification, not being a convention or PCT application, can be converted into a provisional application within twelve months from the date of filing of the application by the Controller upon request of the applicant.¹⁹⁰

¹⁸³ See Draft MOPP (*supra* note 10)

¹⁸⁴ See Narayanan (*supra* note 9) at 74

¹⁸⁵ ELIZABETH VERKEY, LAW OF PATENTS 242 (5th ed., Eastern Book Company, 2005)

¹⁸⁶ The Patent Rules, 2003 (*supra* note 21).

¹⁸⁷ § 9 Patents Act, 1970 (*supra* note 1)

¹⁸⁸ See Draft MOPP (*supra* note 10) at 28

¹⁸⁹ See Draft MOPP (*id.*) at 32

¹⁹⁰ § 9 (3) Patents Act, 1970 (*supra* note 1)

4.6.2 Complete Specification

The main objective of complete specification is that it should enable a person skilled in the art to make the invention. The Manual on Patent Procedures, 2005 specifies that a complete specification should contain:

1. Title
2. Field of Invention
3. State of art in the field
4. Object of invention
5. Statement of Invention
6. Detailed description of the invention with reference to the drawings
7. Scope and ambit of the invention
8. Claims, and
9. Abstract¹⁹¹

The specification must sufficiently and fairly describe the invention in a manner that allows one of skill in the art to practice the invention. A specification that fails to do so may render the patent invalid and may provide grounds for revoking the patent¹⁹² The applicant has a duty to state things clearly and the language used in describing an invention depends upon the class of persons skilled in the art who may act upon and reply upon the specification.¹⁹³

The original filed specification must be complete because the statute prohibits amending the specification if it would lead to extension of the claims.¹⁹⁴ If an amendment to the specification is made and admitted, then it is construed as part of the full specification.¹⁹⁵

¹⁹¹ See Draft MOPP (*supra* note 10) at 33-36

¹⁹² The Patents Act, 1970 (*supra* note 1) § 64 (1) (h) Patents Act, 1970 (*supra* note 1)

¹⁹³ *Press Metal Corp.Ltd v. Noshir Sarabji*, AIR 1983 Bom. 144

¹⁹⁴ § 59 (1) Patents Act, 1970 (*supra* note 1)

¹⁹⁵ § 59 (2) (a) Patents Act, 1970 (*id.*)

4.7 Claims

If the objective of the specification is to convey to the public what the invention is, the primary purpose of the claims is to state the extent of monopoly that the patentee is seeking. A claim is a statement of technical facts expressed in legal terms by defining the scope of the invention sought to be protected.¹⁹⁶ The specification is usually followed by claims which should be succinct and clear and must relate to one invention.¹⁹⁷ What is not claimed in the claims will be regarded as being disclaimed.¹⁹⁸ Though there are no statutory limitations with regard to the number of claims, the claims in excess of ten are subject to additional fees.¹⁹⁹ The principal claim or the first claim essentially defines the novel features of the invention where as the optional features may be claimed through subsidiary claims. The subsidiary claims may include independent or dependent claims and each claim is evaluated on its own merit.²⁰⁰

4.8 Disclosure Requirements

4.8.1 Duty to Disclose

A patent applicant in India has the duty to disclose information regarding corresponding applications filed in other countries. At the time of filing a patent application in India, the applicant must file a Form 3 (Appendix III) under Section 8 of the Patents Act, 1970 dealing with the duty of the applicant to disclose the information.

The Applicant has the following obligations under Section 8:

- (1) File Form 3 with information regarding corresponding applications at the time of filing the Indian application or within 6 months from the date of filing the application in India. This applies to PCT National Phase Applications as well;

¹⁹⁶ See Narayanan (*Supra* note 9 at 82)

¹⁹⁷ § 10 (5) Patents Act, 1970 (*supra* note 1)

¹⁹⁸ See Draft MOPP (*supra* note 12) at 38

¹⁹⁹ See FIRST SCHEDULE of the Patent Rules, 2003 (*supra* note 21).

²⁰⁰ See Draft MOPP (*supra* note 10) at 38

- (2) Undertake to keep the Controller of Patents informed of every other application filed outside India subsequent to the filing of the Indian application; and
- (3) At any time during the prosecution of the application in India, if the Controller of Patents (read Examiner) requires, furnish details regarding the prosecution of corresponding applications in other countries.

The second and the third obligations are the trickiest and most difficult to comply with. In the event an applicant fails to comply with these obligations, it can be a ground for opposition under Section 25 (h) of the Patents Act, 1970.

Often Examiners ask applicants to submit the search and examination reports of corresponding foreign applications. This can become an onerous task if the applicant has filed patent applications in numerous countries.

4.8.2 Foreign Filing License

A foreign filing license must be obtained from the Patent Controller if an Indian resident makes or even causes to make a foreign patent application without filing a corresponding Indian patent application 6 weeks prior to filing the foreign application²⁰¹. This provision does not apply to a patent application filed outside India by a person not resident in India.

The implication of the provisions on foreign filing licenses, which as per the Indian patents law is referred to as a 'written permit', is that when a first filing of a patent application is effected outside India by an assignee company resident in India or with inventors resident in India, a foreign filing license must be obtained. The expressions 'resident in India' and 'makes or causes to be made' make this provision extend to applications naming inventors resident in India. In practically terms, the Patent Office will make a determination of this based on the nationality of the inventors as well as the permanent residential address of the inventor as shown in the patent application. An

²⁰¹ § 39 Patents Act, 1970 (*supra* note 1)

assignee will be considered as resident in India if the applicant company has a registered office in India or a place of business.

The Controller issues a 'written permit' within 3 months from the date of filing Form 25. (Appendix V). However, in the past the Patent Office has issued the permit as soon as within 48 hours of making a request.

The liabilities and penalties for not complying with the foreign filing license include:

- (a) Refusing to grant a patent in India for the same invention (the invention in respect of which a foreign application was made without a foreign filing license or without filing a corresponding application 6 weeks prior to the filing of the foreign application)²⁰²;
- (b) Fine²⁰³ \;and/or
- (c) Imprisonment up to 2 years²⁰⁴.

5. Prosecution of the Application

5.1 Filing of the Application

An application is usually filed at the appropriate Patent Office based on residence or principal place of business or from the place where the invention originated.²⁰⁵ The applicant however can withdraw the application at any time after filing application but before the grant of a patent.²⁰⁶

²⁰² § 40 Patents Act, 1970 (*id.*)

²⁰³ § 118 Patent Act, 1970 (*id.*)

²⁰⁴ See Patents Act, 1970 (*id.*)

²⁰⁵ The Patent Rules, 2003 (*supra* note 21), Rule 4

²⁰⁶ § 11A Patents Act, 1970. (*supra* note 1)

5.2 Publication

Upon receiving the application, the Patent Office accords the application an application number and applications corresponding to international applications designating India shall constitute a different series.²⁰⁷ All applications which have not been abandoned or withdrawn are published in the Patent Official Journal within 18 months from the date of filing or priority date, whichever is earlier.²⁰⁸ The applicant is permitted to request early publication from the Controller using Form 9 (Appendix VI).²⁰⁹ The public shall have access to the details of the application only from the date of publication. If the patent is for a biological material, the depository institution will make the biological material available to public.²¹⁰

The application shall not be published if a secrecy direction²¹¹ is given or if the application has been abandoned. The publication shall include the details such as the date of application, the application number, the name and address of the inventor and the abstract of the invention.²¹² Once the application is published, the applicant will be entitled to like privileges as that of the patentee from the date of publication except for the ability to institute an infringement proceedings.²¹³

5.3 Request for Examination

The application shall be taken up for examination only when a request for the examination has been filed using Form 18.²¹⁴ (Appendix VII). The request can be made by either the applicant or by any other interested person.²¹⁵ A request for examination (RFE) can be filed by either the applicant or by interested person within a period of 48 months from the date of priority or date of filing, whichever is earlier.²¹⁶

²⁰⁷ The Patent Rules, 2003 (*supra* note 21) Rule 11

²⁰⁸ The Patent Rules, 2003 (*supra* note 21) Rule 24

²⁰⁹ § 11A (2) Patents Act, 1970 (*supra* note 1)

²¹⁰ § 11A (6) (a) Patents Act, 1970 (*id.*)

²¹¹ § 35 Patents Act, 1970 (*id.*)

²¹² § 11 A (5) Patents Act, 1970 (*id.*)

²¹³ § 11A (7) Patents Act, 1970 (*id.*)

²¹⁴ See the Patent Rules, 2003 (*supra* note 21).

²¹⁵ § 11 B (1) Patent Act, 1970 (*id.*)

²¹⁶ § 11 A (2) of the Patents Act, 1970 (*supra* note 1) read with Rule 24 B (1) (i) of Patent Rules, 2003

The application is deemed to have been withdrawn on the non-submission of request for examination within the prescribed period.²¹⁷ Usually, a RFE is filed along with the application for patent so as to accelerate the examination process. If the application was bound by any secrecy direction, the applicant can make a request for examination within 48 months from the date of application or from the date of priority or within six months from the date of revocation of the secrecy direction, whichever is earlier.²¹⁸

5.4 Pre-grant Opposition/Representation

The Ayyangar Committee²¹⁹ recommended the inclusion of both pre grant and post grant oppositions, but the Patents Act, 1970 when enacted contained only pre-grant (post-acceptance) opposition.²²⁰ The Patents Act, 1970 changed the *locus standi* of an opponent and mandated that the opponent must be an ‘interested person’²²¹ as against the 1911 Act that enabled ‘any person’ to file a notice of opposition to grant of patent. It is the Controller of Patents or the Court that ascertains whether an opponent is ‘an interested person’.²²² An opposition or representation shall be filed at appropriate office with a statement and evidence along with a request for hearing.²²³ The representation can be filed after the publication of the application under section 11A of the Act²²⁴ until the grant of patent. The opposition or representation shall be considered only along with the request of examination.²²⁵ Section 25 of the Act, elaborates on the grounds to oppose a patent application²²⁶.

²¹⁷ § 11B (4) Patents Act, 1970 (*supra* note 1)

²¹⁸ The Patent Rules, 2003 (*supra* note 21) Rule 24 B(iii)

²¹⁹ *Supra* note 15

²²⁰ §25 Patents Act, 1970 (*supra* note 1)

²²¹ § 2(1)(t).Patents Act, 1970 (*id.*)

²²² *Satyappan Natesan v. Andre Vioza* (1980) 4 IPLR 138

²²³ The Patent Rules, 2003 (*supra* note 21) Rule 55 (1)

²²⁴ § 11A of Patents Act, 1970 (*supra* note 1) provides for publication of application. As per the section, the application can be published at the request of applicant to Controller. However, every application is published at the expiry of 18 months.

²²⁵ The Patent Rules, 2003 (*supra* note 21) Rule 55 (2)

²²⁶ Originally, § 25 of Patents Act, 1970 (*supra* note 1) contained nine grounds for opposition, namely, wrongful obtaining, anticipation, prior claiming, public knowledge, obviousness, non-patentability of subject matter, insufficiency of disclosure, non-disclosure of information regarding foreign applications and time barred convention application.

5.4.1 Wrongful Obtaining: A person can oppose a patent application or a patent if the applicant/patentee or the person under or through whom he claims, has wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims²²⁷. However, “obtained” does not necessarily mean fraud or misappropriation, rather the only rider attached with obtaining is ”wrongful.” Thus, if a person obtains the invention wrongfully, by whatsoever means, it will fall within the ambit of section 25(1)(a)²²⁸. In such a case, the Controller, may, on request made by the opponent in the prescribed manner, direct the application to proceed in the name of the opponent with the benefit of priority date attached to the application²²⁹.

5.4.2 Prior Publication: A prior publication will be considered only if the invention as claimed has been published before the priority date of the claim in any specification filed in pursuance of an application for a patent made in India on or after January 1, 1912 or in India or elsewhere, in any of other document²³⁰. However, the opposition under this ground will succeed only if the prior publication constitutes anticipation as envisaged under the Act itself²³¹.

5.4.3 Prior Claiming: Prior claiming occurs when invention claimed in any one claim of the complete specification has been published on or after the priority date of the applicant’s claim. However, mere comprehension of the subject matter of a claim in the cited specification will not be considered prior claiming. The opponent has to establish that the subject matter of a claim in the applicant’s specification forms the subject matter of a distinct claim in the cited specification²³².

5.4.4 Prior Public Knowledge or Public Use: If the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before

²²⁷ §25(1)(a) Patents Act, 1970 (*supra* note 1)

²²⁸ Patents Act, 1970 (*Id.*)

²²⁹ See § 26 Patents Act, 1970 (*id.*)

²³⁰ See §25(1)(b)(i) Patents Act, 1970 (*id.*)

²³¹ See §13 Patents Act, 1970 (*id.*)

²³² See § 25(1)(c) Patents Act, 1970 (*id.*)

the priority date of that claim, the invention can be opposed on the ground of prior public knowledge or public use²³³. An invention relating to a process shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if the product made by that claim has already been imported into India for commercialization. However, secret use shall not be considered as prior public knowledge or public use within the meaning of this section²³⁴.

5.4.5 Obviousness or Lack of Inventive Step: An application can also be opposed if the invention as claimed is *obvious and doesn't involve any inventive step* with reference to any document having the effect of anticipating the invention under sec. 25(1)(b)²³⁵. Inventive step has been further defined in sec. 2(1)(ja) of 1970 Act as a *feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art*. Another important provision of the law that has a direct bearing on this ground of opposition is Section 3(d) of the Act²³⁶. This Section is the most widely used to support patent oppositions in India.²³⁷ As an example, generic pharmaceutical companies rely on Section 3(d) r/w Section 2(1)(ja) to oppose pharmaceutical patent applications filed through the WTO Mail Box system²³⁸.

²³³ § 25(1)(d) Patents Act, 1970 (*id.*)

²³⁴ *Ganedro Nath Banerji v. Dhanpal Das Gupta*, AIR 1945 Oudh 6.

²³⁵ As per The Patents Act, 1970 (*supra* note 1) § 25(1)(b) (2005), a patent is deemed to be anticipated if published in

- (i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or
- (ii) in India or elsewhere, in any other document: Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 29.

²³⁶ Patents Act, 1970 (*id.*) § 3(d) states “the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.”

²³⁷ *Novartis AG and Anr v. Mehar Pharma and Anr*, 2005 (30) PTC 160(Bom).

²³⁸ The term “mailbox system” is used as shorthand for provisions to be put in place, which allow for the filing of patent applications for pharmaceutical and agricultural chemical products as required by Article 70.8 of TRIPS (*supra* note 5).

5.4.6 Claim not a Patentable Invention: If an invention falls under a statutory excluded category (non-statutory subject matter), it will not be considered as an invention patentable under the Patents Act, 1970 and hence can be opposed.

5.4.7 Invention not Sufficiently and Clearly Described: If the complete specification doesn't sufficiently and clearly describe the invention or the methods by which it is to be performed, it can be opposed. The 'sufficiency' of description refers to enabling the best mode requirement as per section 10 of the Patents Act, 1970. It is pertinent to note that India's patents law mandate a 'best mode' requirement.

5.4.8 Failure to Disclose Information Regarding Foreign Application: This ground²³⁹ has recently provided the most common basis for filing patent oppositions in India. Section 8 of the Patents Act, 1970 makes it obligatory on the part of the applicant for a patent to submit details of all corresponding patent applications to the Controller of Patents. Further, the applicant is also under an obligation to keep the Controller informed of the status of such corresponding applications until the grant of the Indian patent. Such information must be submitted within 6 months from the date of attending to a prosecution step with respect of an overseas application. In other words, an applicant for a patent in India must submit information relating to developments in corresponding applications that are pending in all other countries within 6 months from the date of such a development.

5.4.9 Conventional Application Time-Barred: In the case of a convention application, if the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title, the application can be opposed²⁴⁰.

5.4.10 Non-disclosure of Origin of Biological Material: A patent application can be opposed on the ground that the complete specification does not disclose or wrongly

²³⁹ § 25(1)(h) Patents Act, 1970 (*supra* note 1)

²⁴⁰ § 25(1)(i) Patents Act, 1970 (*id.*)

mentions the source or geographical origin of biological material used for the invention²⁴¹.

5.4.11 Prior Knowledge in Local or Indigenous Community: The provision concerning mandatory disclosure of the source of biological materials in an Indian patent application was only recently adopted²⁴². If the invention claimed in a patent application relates to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere, the patent application can be opposed²⁴³.

A pre grant opposition shall be opposed only on the basis of the grounds explicitly provided in the statute. This implies that no patent application or patent can be opposed on the ground of public interest or any other legal procedural infirmity.

5.5 Examination

After filing a request for examination, the application is taken up for examination and the Indian Patent Office follows a deferred examination system.²⁴⁴ The application will be examined to check whether it complies with the requirement of the Act and whether there are any lawful grounds for objection to the grant of patent. A search is then conducted for prior publications and prior claims.²⁴⁵ The Indian Patent Office usually proceeds with the examination of an application in the following order:

1. Understanding the invention;
2. Assessment of patentability of the subject matter;
3. Assessment of sufficiency of disclosure;
4. Check for unity of invention;
5. Appraisal of Industrial Applicability;
6. Classification of the invention;

²⁴¹ The Patents Act, 1970 (*id.*) § 25(1)(j) Patents Act, 1970 (*id.*)

²⁴² This ground of opposition was inserted by The Patents (Amendment) Act, 2005.

²⁴³ § 25(1)(k) Patents Act, 1970 (*supra* note 1)

²⁴⁴ See Draft MOPP (*supra* note 10) at 65

²⁴⁵ See § 12 Patents Act, 1970 (*supra* note 1)

7. Determination of the priority of each claim;
8. Novelty search;
9. Determination of the inventive step; and
10. Judgment and validity of the claim.²⁴⁶

5.5.1 Search and Investigation

The patent examiner is required to conduct a search for anticipation by previous publications²⁴⁷ and by prior claims.²⁴⁸ Chapter VI of the Patents Act, 1970, beginning with Section 29, lists the laws on anticipation/ and novelty and its exceptions. Novelty, according to the Indian practice, is judged according to an absolute novelty standard for both publications and public disclosures/use which includes “documents in foreign languages disclosed in any format in any country”²⁴⁹. In addition, India has a 12 month grace period for filing a patent application after a public display at an exhibition which is specifically approved by the government.²⁵⁰ As noted above, the exceptions to anticipation are similar to those in the U.S., except that there is no 12 month grace period for an inventor’s publication and/or public use. The patent examiner on completion of the search and investigation is required to report to the Controller. But the examination and investigation alone does not warrant the validity of the patent.²⁵¹

5.5.2 First Examination Report

Upon receiving a request for examination (RFE), the Controller shall task an examiner with preparing a First Examination Report (FER).²⁵² The examiner has to prepare the FER within about one month and not more than three months from the date of application/²⁵³ The Controller shall dispose of the examiner’s report ordinarily within a

²⁴⁶ See Draft MOPP (*supra* note 10) at 65

²⁴⁷ As per § 29 of the Patents Act, 1970 (*supra* note 1) it shall not amount to anticipation if the invention was published in a specification filed in pursuance for an application for patent prior to 1/1/1912.

²⁴⁸ § 13 The Patents Act, 1970 (*Id.*)

²⁴⁹ See *supra* note 10 Draft MPPP 2005, Chapter II, §2.2, p. 11.

²⁵⁰ See § 31 Patents Act, 1970, (*supra* note 1)

²⁵¹ See § 13 (4) Patents Act, 1970 (*Id.*)

²⁵² See § 2(1) Patents Act, 1970 (*Id.*)

²⁵³ See Patent Rules, 2003 (*supra* note 21) Rule 24 (2) (ii)

month from the date of receipt²⁵⁴. The FER, along with application and specification, shall be sent to the applicant within a period of six months from the date of request for examination or from the date of publication, whichever is later and an intimation of such examination is to be made to the ‘interested person’ if he or she had filed RFE²⁵⁵.

5.5.3 Putting Application in Order for Grant

If certain objections are stated in the report of the examiner, the applicant has a time span of twelve months to put the application in order for grant.²⁵⁶ The applicant has the option of either amending the application or complete specification as the case may be or by raising arguments. If the applicant is not able to comply within the time stipulated, the application is deemed to have been abandoned.²⁵⁷

5.6 Intimation for Grant

Once the application is put in order for grant, intimation to the effect that the application is found to be in order for grant subject to pre grant proceedings is sent to the patent applicant.

5.7 Grant

Upon meeting all of the requirements described above, the patent shall be granted as expeditiously as possible provided the Controller does not refuse the application by virtue of his or her inherent powers.²⁵⁸ The specification and other documents shall be open to the public for examination after the Controller has published the fact of grant. The patent shall be valid for a period of twenty years²⁵⁹ and the date of patent²⁶⁰ shall be

²⁵⁴ See Patent Rules, 2003 (*id.*) Rule 24 (2) (iii)

²⁵⁵ See Patent Rules, 2003 (*id.*) Rule 24(3)

²⁵⁶ See § 21 Patents Act, 1970 (*supra* note 1)

²⁵⁷ See Patents Act, 1970 (*id.*)

²⁵⁸ See § 43 (1) (a) Patents Act, 1970 (*id.*)

²⁵⁹ See §52 (1) Patents Act, 1970 (*id.*)

²⁶⁰ See § 45 Patents Act, 1970 (*id.*)

the date of application. A patent certificate is usually issued within seven days from the date of grant.²⁶¹

5.8 Publication of Grant

After the grant of patent, the Controller shall publish the fact that patent has been granted and the application, specification and other documents shall be open for public inspection.²⁶²

6. Post Grant Opposition

One of the substantive changes brought out by the Patents (Amendment) Act, 2005 is the Post Grant Opposition proceedings. With the introduction of Post Grant Opposition proceedings, India may be the only country which provides for both pre-grant opposition and post-grant opposition. The grounds for post-grant opposition are similar to those for pre-grant opposition.²⁶³ Only a person interested may give notice of opposition within one year from the date of publication of the grant.²⁶⁴ The notice of opposition shall be made in Form 7 (Appendix VIII) and shall be sent to the Controller in duplicate.²⁶⁵ A post-grant opposition has more procedural nuances than a pre-grant opposition. Some of the steps are explained below.

6.1 Notice of Opposition & Written Statement: A Notice of Opposition can be made at any time after the grant of a patent but within one year of the date of publication of grant of a patent²⁶⁶. It should be made in Form 7 and should be sent to the Controller of Patents in duplicate at the appropriate office. The Opponent is required to file a Written Statement and supporting evidence along with the Notice of Opposition²⁶⁷.

²⁶¹ See the Patent Rules, 2003 (*supra* note 21) Rule 74 (2)

²⁶² See § 43 (2) Patents Act, 1970 (*supra* note 1)

²⁶³ See § 25 (2) the Patents Act, 1970 (*Id.*) For more details see pre grant opposition

²⁶⁴ See Patents Act, 1970 (*id.*)

²⁶⁵ See Patent Rules, 2003 (*supra* note 21) Rule 55A

²⁶⁶ See § 25(2) (2005) Patents Act, 1970 (*supra* note 1)

²⁶⁷ See Patents Rules, 2003 (*supra* note 21) Rule 57 (2003).

6.2 Constitution of Opposition Board: The Controller, on receipt of the Notice of Opposition constitutes an Opposition Board. The Opposition Board consists of three members; of them one shall be nominated as the Chairman. The Examiner who examined the patent application shall not be member of the Board. Typically, the Controller appoints a Deputy Controller of Patents or an Assistant Controller of Patents as the Chairman of the Opposition Board and 2 Senior Examiners as its members.²⁶⁸

6.3 Reply Statement and Evidence by Patentee: The Patentee, if he desires to contest the opposition, must submit with the Controller a Reply Statement and evidence in support of his case. This must be done within 2 months from the date of receipt of a copy of the Written Statement and the Opponent's evidence. A copy of the Reply Statement and evidence must be served on the Opponent.²⁶⁹

6.4 Filing of Reply Evidence by Opponent: Within one month of receipt of Reply Statement and evidence, the Opponent can file further Reply Evidence strictly confined to the evidence relied on by the Patentee²⁷⁰. The parties can file additional evidence, apart from those mentioned above after taking leave of the Controller. However, the Controller has discretion to grant or refuse the permission.

6.5 Hearing: The parties will get an opportunity to be heard by the Controller before a final decision is rendered. Generally, upon completion of the submission of evidence, the Controller notifies the parties of the date of hearing. The parties, if willing to be heard, have to inform the Controller by way of a notice along with the prescribed fee²⁷¹.

²⁶⁸ See Patents Rules, 2003 (*id.*) Rule 56

²⁶⁹ See Patents Rules, 2003 (*id.*) Rule 58

²⁷⁰ See Patents Rules, 2003 (*id.*) Rule 59

²⁷¹ See Patents Rules, 2003 (*id.*) Rule 62(2)

THE FOLLOWING TABLE HIGHLIGHTS THE PROCEDURAL DIFFERENCES BETWEEN PRE-GRANT AND POST-GRANT OPPOSITIONS.

SL.No.	Issue	Pre Grant Opposition	Post Grant Opposition
1.	<i>Locus Standi</i>	Any person	Only person interested
2.	Opposition Board	Not constituted	Constituted
3.	Notice	Notice of representation	Notice of opposition
4.	Examination of written statement and evidence	Done by controller	Done by Opposition Board
5.	Hearing	At the discretion of controller	At the discretion of parties
6.	Evidences	No reply evidence by opponent	Reply evidence by opponent
7.	Further evidence	No provision	With the leave of controller

In the near future, many provisions of the amended Indian patents law will come up for judicial scrutiny, including the provisions concerning opposition. Such scrutiny will bring greater clarity to the system.

7. Conclusion

Patent law in India has undergone significant changes in the last forty years. In 1970, new patent laws were introduced which brought about the first major legislative changes in post-independence India's patent laws. India was a founding member of the WTO and its accession to TRIPS required that further amendments be made to its patent laws. India's recent economic strides have also created an environment more conducive greater intellectual property protection.

FORM 1
THE PATENTS ACT 1970
(39 of 1970)
&
The Patents (Amendment) Rules, 2006
APPLICATION FOR GRANT OF PATENT
(See section 7, 54 & 135 and rule 20 (1)).

(FOR OFFICE USE ONLY)

Application No.
Filing Date:
Amount of Fee Paid:
CBR No:
Signature:

1. APPLICANT(S):

Name	Nationality	Address

2. INVENTOR(S):

Name	Nationality	Address

3. TITLE OF THE INVENTION:

**4. ADDRESS FOR CORRESPONDENCE OF
APPLICANT/AUTHORIZED PATENT AGENT IN INDIA**

Telephone No.
Fax:
Mobile No.:
Email:

5. PRIORITY PARTICULARS OF THE APPLICATION (S) FILED IN CONVENTION COUNTRY

Country	Application Number	Filing Date	Name of the Applicant	Title of the Invention

6. PARTICULARS FOR FILING PATENT COOPERATION TREATY (PCT) NATIONAL PHASE APPLICATION

International application number	International filing date as allotted by the receiving office

7. PARTICULARS FOR FILING DIVISIONAL APPLICATION

Original (first) application number	Date of filing of Original (first) application

8. PARTICULARS FOR FILING PATENT OF ADDITION

Main application/Patent Number.	Date of filing of main application

9. DECLARATIONS:

(i) Declaration by the inventors

I/We, the above named inventor(s) is/are the true & first inventor(s) for this invention and declare that the applicant(s) herein is/are my/our assignee or legal representative.

(a) Date _____

(b) Signature(s)

(c) Name(s)

(ii) Declaration by the applicant(s) in the convention country

(iii) DECLARATION by the applicant(s):

I/We , the applicant(s), hereby declare(s) that:

- (√) I am in possession of the above-mentioned invention.
- (√) The complete specification relating to the invention is filed with this application.
- (X) The invention as disclosed in the specification uses the biological material from India and the necessary permission from the competent authority shall be submitted by us before the grant of patent to me.
- (√) There is no lawful ground of objection to the grant of the patent to me.
- (√) I am the assignee of true & first inventors.
- (√) The application or each of the applications, particulars of which are given in Para-5 was the first application in convention country in respect of my invention.
- (√) I claim the priority from the above mentioned application filed in convention country and state that no application for protection in respect of the invention had been made in a convention country before that date by me or by any person from which I derive the title.
- (√) My application in India is based on international application under Patent Cooperation Treaty (PCT) as mentioned in Para-6.
- (X) The application is divided out of my application particulars of which are given in Para-7 and pray that this application may be treated as deemed to have been filed on _____ under Sec. 16 of the Act.
- (X) The said invention is an improvement in or modification of the invention particulars of which are given in Para-8.

10. FOLLOWING ARE THE ATTACHMENTS WITH THE APPLICATION:

- (a) Provisional specification/Complete specification.
- (b) Complete specification. (in conformation with the international application) / as amended before the International Preliminary Examination Authority(IPEA) , as applicable (two copies), No. Pages-.....No of Claims-.....

- (c) Drawings (in conformation with the international application)/as ammende before the International Preliminary Examination Authority(IPEA), as applicable (two copies), No. of Sheets -.....;
- (d) Priority Documents;
- (e) Translation of priority document/specification/international search report.
- (f) Statement and undertaking on form Form 3
- (g) Power of authority.
- (h) Declaration as to Inventorship on Form - 5;
- (i) Sequence listing in electronic form.
- (j)

Fee of Rs. /-in cash/cheque/bank draft bearing no.....

Dated.....on.....Bank

I/we hereby declare that to the best of my/our knowledge, information and belief the fact and matters stated herein are correct and I/we request that a patent may be granted to me/us for the said invention.

Dated this.....Day of, 20....

Signature:
Name:

To,
The Controller of Patents
The Patent Office
At.....

Note:

FORM 2
THE PATENTS ACT, 1970
(39 of 1970)
&
THE PATENTS RULES, 2003
PROVISIONAL/COMPLETE SPECIFICATION
(See section 10 and rule 13)

1. TITLE OF THE INVENTION

2. APPLICANT (S)

Name:

Nationality:

Address:

3. PREAMBLE TO THE DESCRIPTION

PROVISIONAL

The following specification describes the invention.

COMPLETE

The following specification particularly describes the invention and the manner in which it is to be performed.

4. DESCRIPTION (Description shall start from next page.)

5. CLAIMS (not applicable for provisional specification. Claims should start with the preamble----“I/we claim” on separate page)

6. DATE AND SIGNATURE (to be given at the end of last page of specification)

7. ABSTRACT OF THE INVENTION (to be given along with complete specification on separate page)

Dated this.....day of.....20....

4. To be signed by the applicant Signature. 4.....
or his authorized registered
patent agent.

5. Name of the natural person (.....).5
who has signed.

To

The Controller of Patents,
The Patent Office,
At.....

Note: Strike out whichever is not applicable.

FORM 5
THE PATENTS ACT, 1970
(39 OF 1970)
&
The Patents (Amendment) Rules, 2006
DECLARATION AS TO INVENTORSHIP
[See section 10(6) and rule 13(6)]

1. NAME OF APPLICANT (s)

hereby declare that the true and first inventor(s) of the invention disclosed in the complete specification filed in pursuance of my/our application numbered _____ dated April , 2007 is/are:

2. INVENTOR(S):

- (a) Name : .
(b) Nationality :
(c) Address :

Dated this Day of , 20.....

Name of Signatory

3. DECLARATION TO BE GIVEN WHEN THE APPLICATION IN INDIA IS FILED BY THE APPLICANT (S) IN THE CONVENTION COUNTRY:-

We the patent applicant(s) in the convention country hereby declare that our right to apply for a patent in India is by way of assignment from the true and first inventor(s).

Dated this day of.....20.....
Signature

Name of Signatory

4. STATEMENT (to be signed by the additional inventor(s) not mentioned in the application form)
I/We assent to the invention referred to in the above declaration, being included in the complete specification filed in pursuance of the stated application.

Dated this day of.....20.....

Signature of the additional inventor(s):
Name:

To,
The Controller of Patents
The Patent Office
At.....

Annexure V

FORM 25

THE PATENTS ACT, 1970
(39 OF 1970)
&
THE PATENTS (AMENDMENT) RULES, 2006
REQUEST FOR PERMISSION FOR MAKING PATENT
APPLICATION OUTSIDE INDIA
[Refer section 39 and rule 71(1)]

I..... in India is in possession of an invention for.....

I hereby attach the brief description of the invention.

I intend to file the Application in the Patent Office for the same invention.

I request that I may be granted permission to make European Application for the said invention. The reasons for making this application, are as follows:-

An application for the said invention has not been made in India and the Applicant intends to file an Application in the.....for the said invention.

The facts and matters stated above are true to the best of my knowledge, information and belief.

Dated this the Day of

Address

To
The Controller of Patents
The Patent Office

FORM 9
THE PATENTS ACT, 1970
(39 of 1970)
&
PATENT RULES, 2003
REQUEST FOR PUBLICATION
[See section 11A (2); rule 24 A)

1. Name, address and nationality of the applicant(s). I/We.....
.....
.....
.....
hereby request for early Publication of my/our Patent application No..... dated..... under section 11 A (2) of the Act.

Dated this.....day of.....20....
2. To be signed by the applicant or authorized registered patent agent. Signature.....
(.....).
3. Name of the natural person who has signed. To
The Controller of Patents,
The Patent Office,
At.....

Note.- For fee: *See* First Schedule.

<p>FORM 18 THE PATENT ACT, 1970 (39 of 1970) & THE PATENT [AMENDMENT] RULES, 2006 REQUEST/EXPRESS REQUEST FOR EXAMINATION OF APPLICATION FOR PATENT [See section 11B and rule 20(4)(ii), 24B(1)(i)]</p>	<p>(FOR OFFICE USE ONLY)</p> <p>RQ. No. Filing Date: Amount of Fee Paid: CBR No: Signature:</p>
<p>1. APPLICANT(S)/OTHER INTERESTED PERSON(S)</p> <p>(a) Name:</p> <p>(b) Nationality:</p> <p>(c) Address:</p> <p>[(d) date of publication of the application under section 11 A.....]</p>	
<p>2. STATEMENT IN CASE OF REQUEST FOR EXAMINATION MADE BY THE APPLICANT(S)</p> <p>I/We hereby request that my/our application for patent no. _____ filed on _____, 2006 for the invention titled “ _____ ” shall be examined under sections 12 and 13 of the Act.</p> <p style="text-align: center;">Or</p> <p>I/We hereby make an express request that my/our application for patent no _____ filed on _____ based on Patent Cooperation Treaty (PCT) application no _____ dated _____ made in our country _____ shall be examined under sections 12 and 13 of the Act, immediately without waiting for the expiry of 31 months as specified in rule 20 (4) (ii).</p>	
<p>3. STATEMENT IN CASE OF REQUEST FOR EXAMINATION MADE BY ANY OTHER INTERESTED PERSON</p> <p>I/We the interested person request for the examination of the application no _____ dated _____ filed by the applicant _____ titled _____ under sections 12 and 13 of the Act.</p> <p>As an evidence of my/our interest in the application for patent following documents are submitted.</p> <p>(a)..... </p>	
<p>4. ADDRESS FOR SERVICE</p>	
<p>Dated this ____ day of _____ 20____</p> <p>Signature</p> <p>Name of the signatory</p>	

To
The Controller of Patents,
The Patent Office,
At _____

FORM 7
THE PATENTS ACT, 1970
(39 OF 1970)
&
THE PATENT RULES, 2003
NOTICE OF OPPOSITION
[See section 25(2) and rule 55A]

- | | |
|--|--|
| 1. State names, addresses and nationality. | I/We,
.....
.....
Hereby give notice of opposition to patent No.....) granted on application No..... dated.....published on dated..... made by..... on the grounds. |
| 2. State the grounds taken one after another. |
..... |
| 3. Complete address including postal index number/code and state along with telephone and fax number | My/Our address for service in India is.....
.....
..... |
| 4. To be signed by the opponent or by his authorized registered patent agent. | Signature

(.....) |
| 5. Name of the neutral person who has signed | |

To
The Controller of Patents,
The Patent Office,
At.....

Note.- For fee: See First Schedule.
