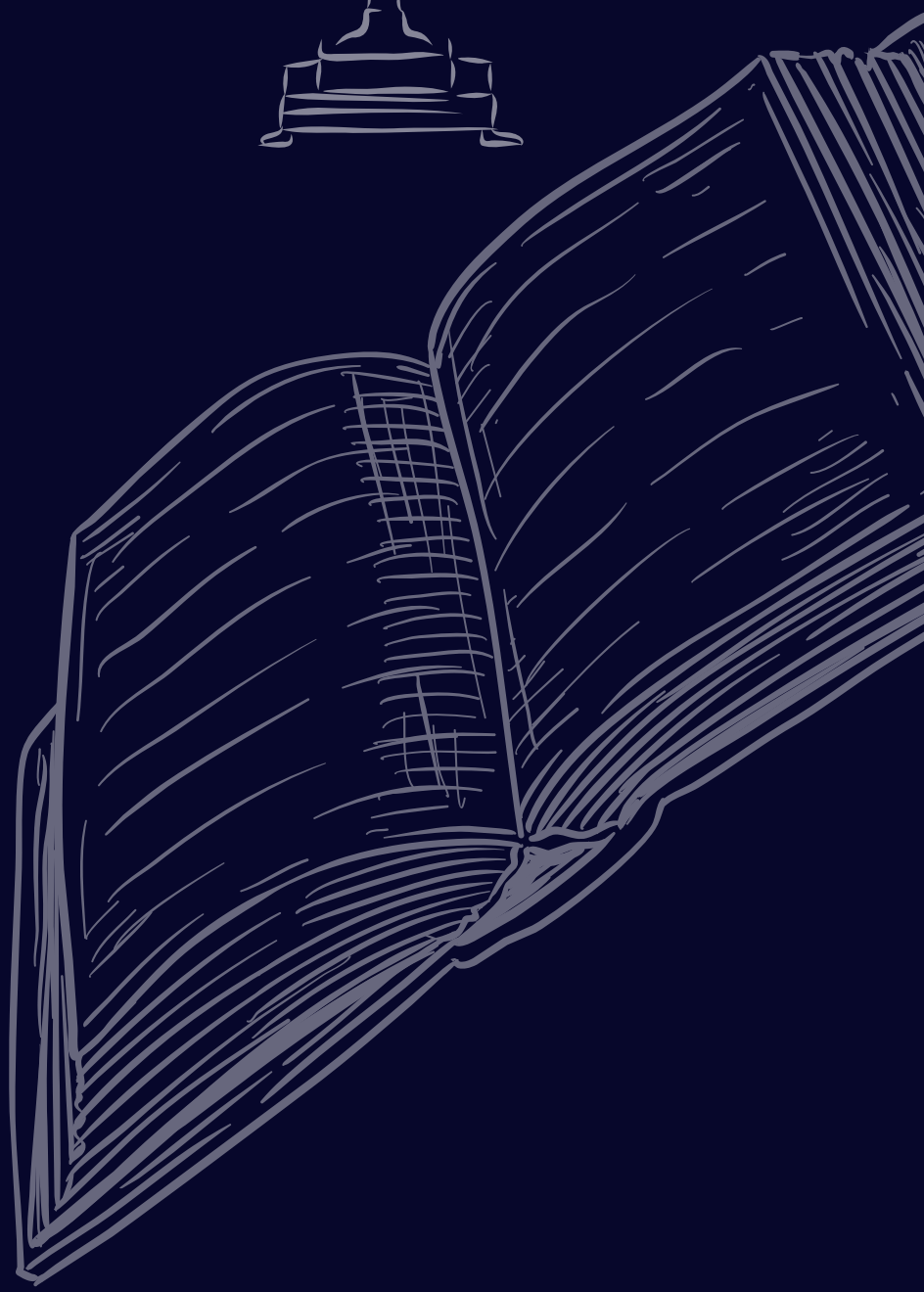
EDITION ONE

RASPREP

Module 2

THE PATENTS ACT, 1970 (No. 39 of 1970)

Part II



Section-wise Analysis of the Indian Patents Act, 1970 (Sections 54-115)

PREFACE

The Patents Act, 1970 (No. 39 of 1970), along with its subsequent amendments, governs the law relating to the grant, protection, and enforcement of patents in India.

This book provides a comprehensive explanation of the various sections of the Act. It is intended to assist students, legal practitioners, patent professionals, researchers and innovators in understanding the statutory provisions, their scope and practical applications.

Each section is explained in detail, supported by illustrative examples and interpretations where necessary. Special attention is given to patentability criteria, rights conferred by patents, procedures for filing, opposition and remedies for infringement.

By focusing on Sections 54 to 115, this book provides a concise yet comprehensive understanding of the key provisions of the Indian Patents Act, making it accessible and practically useful for both academic and professional purposes.

REFERENCE

The explanations and commentary in this book are based on the Indian Patents Act, 1970 (No. 39 of 1970), including all subsequent amendments. Sections cited in this book are reproduced from the Indian Patents Act, 1970, while the explanations and commentary are original, provided for clarity and understanding.

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About Us

At RAS Intellect, we specialize in patents, trademarks, copyrights, and everything that protects your brainchild. From solo inventors to growing startups and global enterprises, we empower creators to secure, protect, and profit from their innovation. Our team of skilled professionals is dedicated to guiding organizations through the complexities of IP processes, ensuring that valuable assets are effectively protected and leveraged for maximum benefit. We operate across multiple verticals to cater to the unique challenges faced by organizations in promoting innovation while ensuring effective protection and management of intellectual assets. We also offer end-to-end support for research paper writing and publication, enabling impactful dissemination of innovative ideas in reputed journals.

Vision

Our vision is to become a leading innovation and intellectual property enabler across India by empowering startups, universities, researchers, and enterprises with technology-driven IP, research, and commercialization solutions that transform ideas into impactful innovations.

Mission

To empower innovators and creators by protecting and maximizing the value of their intellectual property through strategic, tailored solutions, while advancing research excellence by enabling high-quality publications in globally recognized and reputed journals.

Charting the Course to Success

Our services are focused on strengthening measurable research, innovation, IPR, publication, and documentation outcomes for NIRF, NAAC and IIC.

1. IPR and Patent Filing Support

- Patentability assessment of faculty/student research
- Prior art searching and patent landscape reports
- Provisional and complete patent specification drafting
- Patent filing
- Early publication request support
- Request for examination filing support
- FER response drafting and prosecution assistance
- Patent grant tracking and reporting
- Design registration filing
- Copyright filing for software, manuals, literary works, lab content and academic material
- Trademark support for university innovation cells, incubation centres and institutional brands

2.NIRF Research Parameter Support

- Annual NIRF research data audit
- Patent published/granted tracking
- Research publication tracking
- Scopus publication mapping
- Citation and H-index monitoring
- Faculty-wise research output mapping
- Department-wise research performance reports

3. NAAC Criterion III Support

- Criterion III gap analysis
- Research policy drafting
- IPR policy drafting or revision
- Innovation and startup policy drafting
- Seed money policy documentation
- Research promotion mechanism documentation
- Faculty research incentive policy support
- Patent and publication evidence compilation
- MoU and collaboration evidence structuring
- Extension activity documentation
- Innovation ecosystem documentation

4. IIC and Innovation Cell Support

- IIC annual activity calendar planning
- Innovation and IP awareness sessions
- Patent search workshops
- Idea-to-IP mentoring
- Student innovation screening
- Hackathon planning and execution
- Prototype documentation support
- Startup mentoring sessions
- Entrepreneurship and commercialization workshops.

5. Research Paper and Publication Support

- Research topic selection support
- Literature review guidance
- Research paper structuring
- Journal selection guidance
- Scopus-indexed journal identification
- Plagiarism and AI-similarity reduction guidance
- Manuscript formatting as per journal guidelines
- Citation and referencing support
- Response to reviewer comments

6. Faculty Development and Student Training Programs

- Patent drafting workshop
- Patent search workshop
- Research methodology workshop
- Scopus publication workshop
- Copyright and design registration workshop
- Innovation-to-commercialization workshop
- Technology transfer and licensing session
- Startup and entrepreneurship bootcamp
- Patent Agent career awareness session
- IP for faculty research advancement
- IP for Ph.D. scholars and research supervisors

7. University IP Cell Setup and Management

- IP Cell formation support
- IP Cell SOP drafting
- Invention disclosure form preparation
- Patent review committee formation support
- IP ownership and revenue-sharing policy
- Faculty/student disclosure workflow
- Patent filing calendar
- IP awareness schedule
- Department-wise IP coordinators' training

8. Incubation and Commercialization Support

- Technology readiness assessment
- Commercial potential assessment
- Startup idea screening
- IP-based startup mentoring
- Licensing strategy
- Technology transfer documentation
- MoU drafting support
- Pitch deck preparation
- Innovation portfolio preparation

RASPREP University Training Programs

RAS Intellect offers structured IP training and internship programs for universities through 1-week, 6-week, and 6-month formats. These programs cover IP fundamentals, patent searching, patent drafting, legal understanding, innovation awareness, and career readiness in the intellectual property domain. The modules can be delivered in virtual, hybrid, or offline mode and may also be customized as credit-based, vocational, or skill-development programs for students and faculty. This initiative supports universities in strengthening innovation culture, student employability, academic enrichment, and evidence-based contribution towards NAAC, NIRF and IIC-related research and innovation parameters.

How this supports Universities

- NAAC Criterion III: research, innovation, extension, skill development, and institutional innovation ecosystem.
- IIC activities: IP awareness, innovation training, patent search workshops, idea-to-IP mentoring, and entrepreneurship-linked activities.
- NIRF support areas: research culture, professional practice, IPR awareness, patent filing pipeline, and student/faculty innovation outcomes.
- Employability and academic enrichment: by creating technically trained students for IP, patent drafting, research analysis, and innovation-based career roles.

Recent Milestones

Recognitions and Contributions from 2024–2025

- **National IP Outreach Mission – Viksit Bharat**

Dr. Ruchi represented RAS Intellect Solutions as a panelist in the "IPR for Women in Business" session organized by PHDCCI, contributing to the national dialogue on IP for inclusive innovation.

- **National IP Yatra 2025 – ASSOCHAM & MSME Ministry**

As co-panelist at this MSME Ministry-supported event, Dr. Ruchi addressed "Maximizing IP Value for Startups & MSMEs," underscoring the firm's expertise in IP commercialization.

- **National Intellectual Property Awards 2024 – Ministry of Commerce & CGPDTM**

Dr. Ruchi was invited to the prestigious IP Awards held at Bharat Mandapam, New Delhi, recognizing RAS Intellect's national contribution to IP literacy and strategy.

- **Leadership & Innovation Milestone – TiECON 2025**

Honoured by the Governor of Punjab, Dr. Ruchi received an award at TiECON 2025 for excellence in research and innovation leadership.

Building IP Foundations for Viksit Bharat

A visionary collaboration with Punjab School Education Board (PSEB)

In alignment with the national vision of **Viksit Bharat@2047**, RAS Intellect is collaborating with the **Punjab School Education Board (PSEB)** to introduce Intellectual Property (IP) education in schools across Punjab.

This initiative aims to embed IP awareness and foundational knowledge within the school curriculum — empowering students and educators to understand, create, and protect innovation from an early age. By nurturing IP consciousness at the grassroots level, we are shaping a generation of future-ready innovators equipped to lead India toward self-reliance and global competitiveness.

Meet the Founder

Visionary leadership driving India's IP revolution

Dr. Ruchi Singla

Director & CEO, RAS Intellect Solutions Pvt. Ltd

- Over 20 years of experience in academic research, intellectual property strategy, and innovation leadership
- Recognized among the **Top 50 Mentors in India** for contributions to national mentoring initiatives
- Serves as a **Regional Mentor of Change** under the **Atal Innovation Mission**, NITI Aayog
- Successfully guided **over 2,300 patent filings** across diverse fields, including AI, drones, and cybersecurity
- Established **three Centres of Excellence** during her academic leadership, fostering innovation ecosystems
- Licensed Indian Patent Agent (No. 5887) and Certified Canadian Patent Administrator by **the Intellectual Property Institute of Canada**
- Secured **over ₹15 crores** in funding for research, innovation, and startup incubation projects
- Empaneled as an **IP Facilitator under the Startup India Scheme (SIIP)** to support early-stage ventures
- Regular speaker and co-panelist at national forums including **TiECON, ASSOCHAM, and PHDCCI**
- Former **Director of Research & Innovation at CGC Landran** and **Director at ACIC RISE Association,** supported by NITI Aayog

At the intersection of policy, education, and intellectual property, Dr. Ruchi Singla is building a more innovation-ready India.

Chapter 9
PATENTS OF ADDITION

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Patents of Addition

(1) Subject to the provisions contained in this section, where an application is made for a patent in respect of any improvement in or modification of an invention described or disclosed in the complete specification filed therefor (in this Act referred to as the "main invention") and the applicant also applies or has applied for a patent for that invention or is the patentee in respect thereof, the Controller may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.

(2) Subject to the provisions contained in this section, where an invention, being an improvement in or modification of another invention, is the subject of an independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention, the Controller may, if the patentee so requests, by order, revoke the patent for the improvement or modification and grant to the patentee a patent of addition in respect thereof, bearing the same date as the date of the patent so revoked.

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

(4) A patent of addition shall not be granted before grant of the patent for the main invention.

Explanation:

This section deals with the patent of addition. The Controller may, if the applicant or patentee so requests, grant patents for any improvement in or modification of the main invention, an invention earlier described or disclosed in the complete specification, as a patent of addition.

If the invention of the patent of addition is already patented as an independent patent and the patentee also owns that independent patent along with the patent of main invention, then upon request, the Controller may, by order, revoke that independent patent and grant a patent of addition in respect thereof, bearing the same date as the date of the patent so revoked.

The patent of addition will not be granted unless its date of filing is the same as or later than that of the patent of main invention; it will not be granted before the grant of the patent of main invention.

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Term of patents of addition

(1) A patent of addition shall be granted for a term equal to that of the patent for the main invention, or so much thereof as has not expired, and shall remain in force during that term or until the previous cesser of the patent for the main invention and no longer:

Provided that if the patent for the main invention is revoked under this Act, the court, or, as the case may be, the Controller, on request made to him by the patentee in the prescribed manner, may order that the patent of addition shall become an independent patent for the remainder of the term for the patent for the main invention and thereupon the patent shall continue in force as an independent patent accordingly.

(2) No renewal fees shall be payable in respect of a patent of addition, but, if any such patent becomes an independent patent under sub-section (1), the same fees shall thereafter be payable, upon the same dates, as if the patent had been originally granted as an independent patent.

Explanation:

This section deals with the term and fee structure for the patents of addition. The term of the patent of addition is equal to that of the patent of the main invention or the remaining term of the patent of main invention if that has been partially expired.

If the patent of the main invention is revoked, the court/the Controller, on patentee's request in the prescribed manner, may order that the patent of addition, for the remainder of the term of the patent of the main invention, shall continue in force as an independent patent.

For a patent of addition, no renewal fees should be paid, unless it becomes an independent patent as discussed, where the same standard renewal fees shall thereafter be payable, upon the same dates, as if it had been originally granted as an independent patent.

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Validity of patents of addition

(1) The grant of a patent of addition shall not be refused, and a patent granted as a patent of addition shall not be revoked or invalidated, on the ground only that the invention claimed in the complete specification does not involve any inventive step having regard to any publication or use of —

(a) the main invention described in the complete specification relating thereto; or

(b) any improvement in or modification of the main invention described in the complete specification of a patent of addition to the patent for the main invention or of an application for such a patent of addition, and the validity of a patent of addition shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

(2) For the removal of doubts, it is hereby declared that in determining the novelty of the invention claimed in the complete specification filed in pursuance of an application for a patent of addition regard shall be had also to the complete specification in which the main invention is described.

Explanation:

This section deals with the validity of the patents of addition. This section clarifies the fact that the grant of a patent of addition shall not be refused and a granted patent of addition shall not be revoked or invalidated, on the ground that the complete specification of the patent of addition lacks inventive step, because of (i) publication or use of the main invention, or (ii) the invention should be filed as an independent patent. For instance, a patent of addition doesn't need to demonstrate inventive step separately, over the main invention.

The novelty of the invention of the patent of addition should be assessed taking into consideration that of the main invention. This section ensures the incremental innovations or technical refinements to an existing invention is protectable without meeting the patentability criteria fully.

Chapter 10
AMENDMENT OF APPLICATIONS AND SPECIFICATIONS

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Amendment of application and specification before Controller

(1) Subject to the provisions of section 59, the Controller may, upon application made under this section in the prescribed manner by an applicant for a patent or by a patentee, allow the application for the patent or the complete specification or any document relating thereto to be amended subject to such conditions, if any, as the Controller thinks fit:

Provided that the Controller shall not pass any order allowing or refusing an application to amend an application for a patent or a specification or any document relating thereto under this section while any suit before a court for the infringement of the patent or any proceeding before the High Court for the revocation of the patent is pending, whether the suit or proceeding commenced before or after the filing of the application to amend.

(2) Every application for leave to amend an application for a patent or a complete specification or any document relating thereto under this section shall state the nature of the proposed amendment, and shall give full particulars of the reasons for which the application is made.

(3) Any application for leave to amend an application for a patent or a complete specification or a document related thereto under this section made after the grant of patent and the nature of the proposed amendment may be published.

(4) Where an application is published under sub-section (3), any person interested may, within the prescribed period after the publication thereof, give notice to the Controller of opposition thereto; and where such a notice is given within the period aforesaid, the Controller shall notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case.

(5) An amendment under this section of a complete specification may be, or include, an amendment of the priority date of a claim.

(6) The provisions of this section shall be without prejudice to the right of an applicant for a patent to amend his specification or any other document related thereto to comply with the directions of the Controller issued before the grant of a patent.

Explanation:

This section guides on about the amendment of an application, complete specification or any related documents before the Controller. The Controller can give permission for amendment of a patent application, a complete specification or any related documents, upon receiving a formal request in the prescribed manner by the patentee/the applicant, at the Controller's discretion, provided it includes all the details about the nature of the proposed amendment and the reason behind the proposed amendment.

However, any amendment will not be allowed/refused during the time the patent application if battling a court case for any infringement or a revocation proceeding is pending.

For a granted patent, any requested amendment should be followed by the publication of the desired amendments, upon getting approved by the controller, which will allow interested parties to oppose the published amendments, within a prescribed period.

Both the applicant and the opponent get an opportunity to be heard by the controller. Here an amendment may be, or include also, an amendment or change to the priority date of a claim. Additionally, this section gives an applicant the right to make any amendments before the grant of the corresponding patent application, as directed by the Controller.

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Amendment of specification before Appellate Board or High Court

(1) In any proceeding before the High Court for the revocation of a patent, the High Court, may, subject to the provisions contained in section 59, allow the patentee to amend his complete specification in such manner and subject to such terms as to costs, advertisement or otherwise, as the High Court may think fit, and if in any proceedings for revocation the High Court decides that the patent is invalid, it may allow the specification to be amended under this section instead of revoking the patent.

(2) Where an application for an order under this section is made to the High Court, the applicant shall give notice of the application to the Controller, and the Controller shall be entitled to appear and be heard, and shall appear if so, directed by the High Court.

(3) Copies of all orders of the High Court allowing the patentee to amend the specification shall be transmitted by the High Court to the Controller who shall, on receipt thereof, cause an entry thereof and reference thereto to be made in the register.

Explanation:

This section deals with the amendment of patent specification during proceedings involving revocation of a patent before the Appellate Board or the High Court. This section allows the patentee to amend his complete specification, instead of revoking the patent, if the High Court or the Appellate Board finds the patent invalid subject to the conditions given in Section 59. Such amendments permitted by the High Court or the Appellate Board may be decided on terms related to costs, advertisement or other procedural aspects, as the High Court or the Appellate Board may think fit. The applicant should give notice of such kind of amendment related application to the Controller and the Controller must appear and be heard, in the proceedings, directed by the High Court. Upon approval of the amendment, the High Court or the Appellate Board must send to the Controller, copies of all orders of the High Court allowing the patentee to amend his complete specification, who shall, upon receipt of such kinds of documents, then make the necessary entries in the register of patents.

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Supplementary provisions as to amendment of application or specification

(1) No amendment of an application for a patent or a complete specification or any document relating thereto shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of incorporation of actual fact, and no amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

(2) Where after the date of grant of patent any amendment of the specification or any other documents related thereto is allowed by the Controller or by the High Court, as the case may be, —

(a) the amendment shall for all purposes be deemed to form part of the specification along with other documents related thereto;

(b) the fact that the specification or any other documents related thereto has been amended shall be published as expeditiously as possible; and

(c) the right of the applicant or patentee to make amendment shall not be called in question except on the ground of fraud.

(3) In construing the specification as amended, reference may be made to the specification as originally accepted.

Explanation:

This section restricts amendments of a patent application or a complete specification or any related document, to only those made by way of disclaimer, correction or explanation, ensuring no addition of new subject matter or broadening of the scope of the original claims, incorporating only the actual fact. Any amendment must stay within the boundaries of originally disclosed matter in the patent specification, preserving the integrity of the patent system and preventing misuse through post-filing modifications. For any amendment related to a granted patent, the Controller or the High Court will allow for the amendment if it is found that the amendment is a part of the specification along with other related documents and the amendment shall be published as expeditiously as possible. The applicant's or the patentee's right to make the amendment is not questionable except for fraud cases. Moreover, a reference related to the amendment should be made to the originally accepted specification.

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Chapter 11
RESTORATION OF LAPSED PATENTS

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Applications for restoration of lapsed patents

(1) Where a patent has ceased to have effect by reason of failure to pay any renewal fee within the period prescribed under section 53 or within such period as may be allowed under sub-section (4) of section 142, the patentee or his legal representative, and where the patent was held by two or more persons jointly, then, with the leave of the Controller, one or more of them without joining the others, may, within eighteen months from the date on which the patent ceased to have effect, make an application for the restoration of the patent.

(2) [Omitted]

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

Explanation:

This section is about the restoration of the lapsed patents. If a patent ceases to have effect due to failure of renewal fee payment within the prescribed period, the patentee or his legal representative, or one or more of persons without joining the others in case of the patent held by two or more persons jointly, may make an application for the patent restoration within eighteen months from the date the patent lapsed. The applicant must submit a verified statement, along with the application, fully explaining the circumstances which led to the failure to pay the prescribed renewal fee. The controller may request the applicant for additional evidence, if necessary, to prove the non-payment of the renewal fee by the applicant was unintentional.

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Procedure for disposal of applications for restoration of lapsed patents

(1) If, after hearing the applicant in cases where the applicant so desires or the Controller thinks fit, the Controller is prima facie satisfied that the failure to pay the renewal fee was unintentional and that there has been no undue delay in the making of the application, he shall publish the application in the prescribed manner; and within the prescribed period any person interested may give notice to the Controller of opposition thereto on either or both of the following grounds, that is to say,—

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

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

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

(3) If no notice of opposition is given within the period aforesaid or if in the case of opposition, the decision of the Controller is in favour of the applicant, the Controller shall, upon payment of any unpaid renewal fee and such additional fee as may be prescribed, restore the patent and any patent of addition specified in the application which has ceased to have effect on the cesser of that patent.
(4) The Controller may, if he thinks fit as a condition of restoring the patent, require that an entry shall be made in the register of any document or matter which, under the provisions of this Act, has to be entered in the register but which has not been so entered.

Explanation:
This section provide an overview of the procedure for restoration of lapsed patents. According to this section, after hearing, if the Controller is satisfied that the renewal fee payment was unintentional and there was no undue delay in making the restoration application, he shall publish the restoration application in the prescribed manner and within the prescribed period so that any person interested may send opposition notice regarding the patent restoration on grounds that either the renewal fee payment failure was not unintentional or there was an undue delay in the patent restoration application submission or both. If any person interested sends notice of opposition to the Controller within the aforesaid period, the Controller should notify the applicant and give an opportunity to be heard to both the applicant and the opponent, before he takes any decision on the restoration case. If no notice of opposition is received within the aforesaid period or if the Controller takes the decision in favour of the applicant in the case of any opposition, the Controller, on payment of any unpaid renewal fee and any prescribed additional fee, shall restore the patent and any patent of addition, specified in the patent restoration application. If required, the Controller may also make updates to the register of patents as a condition for restoration.

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Rights of patentees of lapsed patents which have been restored

(1) Where a patent is restored, the rights of the patentee shall be subject to such provisions as may be prescribed and to such other provisions as the Controller thinks fit to impose for the protection or compensation of persons who may have begun to avail themselves of, or have taken definite steps by contract or otherwise to avail themselves of, the patented invention between the date when the patent ceased to have effect and the date of the publication of the application for restoration of the patent under this Chapter.
(2) No suit or other proceeding shall be commenced or prosecuted in respect of an infringement of a patent committed between the date on which the patent ceased to have effect and the date of publication of the application for restoration of the patent.

Explanation:
This section gives the essence of the rights of patentees of lapsed patents which have been restored. Upon restoration, a patentee's right, subject to conditions prescribed by law and any additional provisions imposed by the Controller, will be restored. Additionally, no legal suit or other proceeding for an infringement of a patent committed between the date on which the patent is lapsed and the date of the patent restoration application publication can be initiated or prosecuted according to this section.

Chapter 12
SURRENDER AND REVOCATION OF PATENTS

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Surrender of patents

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

(2) Where such an offer is made, the Controller shall publish the offer in the prescribed manner, and also notify every person other than the patentee whose name appears in the register as having an interest in the patent.

(3) Any person interested may, within the prescribed period after such publication give notice to the Controller of opposition to the surrender, and where any such notice is given the Controller shall notify the patentee.

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

Explanation:

This section deals with the surrender of patents. According to the section, a patentee may, at any time by giving notice to the Controller, in the prescribed manner, offer to voluntarily surrender his patent. Upon receiving such an offer, the Controller must publish a notice about the offer in the prescribed manner to notify every person listed in the register of patents other than the patentee, having an interest in that patent. Upon publication of such notice in the official Gazette, any person interested may, within a prescribed period, give notice to the Controller of opposition to the surrender and upon receiving any such notice, the Controller should notify the patentee about that notice within a prescribed period and conduct a hearing, if requested. Upon considering all related submission and communication, and hearing the patentee and any opponent, if the Controller is satisfied that the patent may properly be surrendered, he may accept the offer, and by order revoke the patent.

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Revocation of Power patents

(1) Subject to the provisions contained in this Act, a patent whether granted before or after the commencement of this Act, may, be revoked on a petition of any person interested or of the Central Government or on a counter-claim in a suit for infringement of the patent by the High Court on any of the following grounds, that is to say —

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

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

(c) that the patent was obtained wrongfully in contravention of the rights of the petitioner or any person under or through whom he claims;
(d) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;
(e) that the invention so far as claimed in any claim of the complete specification is not new, having regard to what was publicly known or publicly used in India before the priority date of the claim or to what was published in India or elsewhere in any of the documents referred to in section 13:
(f) that the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step, having regard to what was publicly known or publicly used in India or what was published in India or elsewhere before the priority date of the claim:
(g) that the invention, so far as claimed in any claim of the complete specification, is not useful;
(h) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim, protection;
(i) that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;
(j) that the patent was obtained on a false suggestion or representation;
(k) that the subject of any claim of the complete specification is not patentable under this Act;
(l) that the invention so far as claimed in any claim of the complete specification was secretly used in India, otherwise than as mentioned in sub-section (3), before the priority date of the claim;
(m) that the applicant for the patent has failed to disclose to the Controller the information required by section 8 or has furnished information which in any material particular was false to his knowledge;
(n) that the applicant contravened any direction for secrecy passed under section 35 or made or caused to be made an application for the grant of a patent outside India in contravention of section 39;
(o) that leave to amend the complete specification under section 57 or section 58 was obtained by fraud;
(p) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;
(q) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.
(2) For the purposes of clauses (e) and (f) of sub-section (1), —
(a) no account shall be taken of personal document or secret trial or secret use; and
(b) where the patent is for a process or for a product as made by a process described or claimed the importation into India of the product made abroad by that process shall constitute knowledge or use in India of the invention on the date of the importation, except where such importation has been for the purpose of reasonable trial or experiment only.

(3) For the purpose of clause (l) of sub-section (1), no account shall be taken of any use of the invention —

(a) for the purpose of reasonable trial or experiment only; or

(b) by the Government or by any person authorised by the Government or by a Government undertaking, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention directly or indirectly to the Government or person authorised as aforesaid or to the Government undertaking; or

(c) by any other person, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention, and without the consent or acquiescence of the applicant or of any person from whom he derives title.

(4) Without prejudice to the provisions contained in sub-section (1), a patent may be revoked by the High Court on the petition of the Central Government, if the High Court is satisfied that the patentee has without reasonable cause failed to comply with the request of the Central Government to make, use or exercise the patented invention for the purposes of Government within the meaning of section 99 upon reasonable terms.

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

Explanation:

This section provides comprehensive knowledge about the revocation of patents in India. It highlights multiple grounds for revocation, including lack of novelty, lack of inventiveness, lack of industrial applicability of the invention, wrongful procurement of patent by the patentee, incorporation of non-patentable subject matter, insufficient and not fully clear description of the invention in the complete specification, no incorporation of clearly defined claims made fairly based on the disclosure, secret use of the patent in India before the priority date, failure to disclose required information or source related to any biological material mentioned in the patent by the patentee, embodying a publicly known or used invention in the patent, obtaining of patent through either fraudulent amendments or false suggestion or misleading representations and failure to disclose the information asked by the Controller. It also covers the cases of prejudicial patent to public interest, obtaining of patent in contravention of any law, patent grant to a person, not entitled under this act and incorporation of a subject matter in the patent which is not an invention according to the definition given in the Indian Patents Act 1970. The section 64 allows any person interested or the Central Government or a counter-claim in a patent infringement suit to seek revocation before the Appellate Board or the High Court. The section ensures only valid, ethically obtained and fully disclosed patents to remain enforceable, maintaining the patent system integrity and protecting the public interest.

The section 64 also highlights the points which does not count for the reason of patent revocation, which includes secret use or private testing of the invention by someone, bringing a product into India from another country, use of the invention for testing only before filing the patent, sharing of the invention with the government or someone authorized by the government and use of the invention by someone without permission from the patentee.

The High Court can revoke a patent on the petition by the Central Government if the patentee refuses to let the government make, use or exercise the invention on fair terms, without a good reason. If the Central Government asks the High Court to revoke the patent, all persons present on the register of patents to be proprietors of that patent or have shares or interests in it must be informed, but no one else needs to be notified.

65

Revocation of patent or amendment of complete specification on directions from Government in cases relating to atomic energy

(1) Where at any time after grant of a patent, the Central Government is satisfied that a patent is for an invention relating to atomic energy for which no patent can be granted under sub-section (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962), it may direct the Controller to revoke the patent, and thereupon the Controller, after giving notice, to the patentee and every other person whose name has been entered in the register as having an interest in the patent, and after giving them an opportunity of being heard, may revoke the patent.

(2) In any proceedings under sub-section (1), the Controller may allow the patentee to amend the complete specification in such manner as he considers necessary instead of revoking the patent.

Explanation:

This section empowers the central government to direct the Controller for the revocation of a patent, at any time after the grant of an atomic energy related patent, after giving notice, to the patentee and every other person whose name has been entered in the register of patents as having an interest in that patent, and after giving them an opportunity of being heard. Moreover, the Controller, upon getting directions from the Central Government, may also allow the patentee to amend the complete specification of an invention related to atomic energy, in a way as he thinks necessary instead of revoking the patent.

66

Revocation of patent in public interest

Where the Central Government is of opinion that a patent or the mode in which it is exercised is mischievous to the State or generally prejudicial to the public, it may, after giving the patentee an opportunity to be heard, make a declaration to that effect in the Official Gazette and thereupon the patent shall be deemed to be revoked.

Explanation:

This section empowers the central government to revoke a patent if he thinks that the patent or the mode in which is being exercised is mischievous or generally prejudicial to the public. Before getting revoked, the patentee should be given an opportunity to be heard, upon which if the government still remains unsatisfied, it may issue a declaration in the Official Gazette, and the patent will be deemed revoked.

Chapter 13
REGISTER OF PATENTS

67

Register of patents and particulars to be entered therein

(1) There shall be kept at the patent office a register of patents, wherein shall be entered —

(a) the names and addresses of grantees of patents;

(b) notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, a revocation of patents; and

(c) particulars of such other matters affecting the validity or proprietorship of patents as may be prescribed.

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

(3) Subject to the superintendence and direction of the Central Government, the register shall be kept under the control and management of the Controller.

(4) Notwithstanding anything contained in sub-section (1), it shall be lawful for the Controller to keep the register of patents or any part thereof in computer floppies, diskettes or any other electronic form subject to such safeguards as may be prescribed.

(5) Notwithstanding anything contained in the Indian Evidence Act, 1872 (1 of 1872), a copy of, or extracts from, the register of patents, certified to be a true copy under the hand of the Controller or any officer duly authorised by the Controller in this behalf shall, in all legal proceedings, be admissible in evidence.

(6) In the event the register is kept wholly or partly in computer floppies, diskettes or any other electronic form, —

(a) reference in this Act to an entry in the register shall be deemed to include reference to a record of particulars kept in computer floppies, diskettes or any other electronic form and comprising the register or part of the register;

(b) references in this Act to particulars being registered or entered in the register shall be deemed to include references to the keeping of record of those particulars comprising the register or part of the register in computer floppies, diskettes or any other electronic form; and

(c) references in this Act to the rectification of the register are to be read as including references to the rectification of the record of particulars kept in computer floppies, diskettes or any other electronic form and comprising the register or part of the register.

Explanation:

This section explains what is the register of patents and what particulars should be entered in it. The Register of Patents should be kept at the Patents Office, India. The names and addresses of the patent holders, any notification related to assignments and transmissions of patents, patent licences, amendments, extensions, or revocation of patents should be entered in the Register of Patents. Any relevant information affecting the validity or proprietorship of patents should also be entered in the Register of Patents.

Any express, implied, or constructive notice of any trust should not be entered in the Register of Patents and the Controller should not be affected by any such notice of trust. The register should be kept under the control and management of the Controller, who operates under the superintendence and direction of the Central Government. The Controller may maintain the Register of Patents in electronic formats such as computer floppies, diskettes or any other electronic form, wholly or partially, provided proper safeguards are taken. In all legal proceedings, a true copy of, or extracts from the Register of Patents, certified by the Controller or any authorised officer by the Controller, can be submitted as evidence. Furthermore, any entries, registrations or rectifications in the register of patents are deemed to be included in the same electronic records as well.

68

Assignments, etc., not to be valid unless in writing and duly executed

An assignment of a patent or of a share in a patent, a mortgage, licence or the creation of any other interest in a patent shall not be valid unless the same were in writing and the agreement between the parties concerned is reduced to the form of a document embodying all the terms and conditions governing their rights and obligations and duly executed.

Explanation:
This section informs that assignment of a patent or a share in a patent, a mortgage, licence, or the creation of any other interest in a patent will only be considered as valid if the same is/are made in writing, having the agreement between the parties concerned, including all the terms and conditions governing their rights and obligations and duly executed.

69

Registration of assignments, transmissions, etc.

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

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

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

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

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

Provided that if there is any dispute between the parties whether the assignment, mortgage, licence, transmission, operation of law or any other such transaction has validly vested in such person a title to the patent or any share or interest therein, the Controller may refuse to take any action under clause (a) or, as the case may be, under clause (b), until the rights of the parties have been determined by a competent court.

(4) There shall be supplied to the Controller in the prescribed manner for being filed in the patent office copies of all agreements, licences and other documents affecting the title to any patent or any licence thereunder authenticated in the prescribed manner and also such other documents as may be prescribed relevant to the subject-matter:
Provided that in the case of a licence granted under a patent, the Controller shall, if so, requested by the patentee or licensee, take steps for securing that the terms of the licence are not disclosed to any person except under the order of a court.
(5) Except for the purposes of an application under sub-section (1) or of an application to rectify the register, a document in respect of which no entry has been made in the register under sub-section (3) shall not be admitted by the Controller or by any court as evidence of the title of any person to a patent or to a share or interest therein unless the Controller or the court, for reasons to be recorded in writing, otherwise directs.

Explanation:
This section is about registration of assignments, transmissions, etc. According to this section, if someone gets ownership or rights of a patent through lawful assignment, transferring, licensing, or inheritance of the patent's right, they should inform, in writing in a prescribed manner with the proper proof of change of the patents right, the Controller and the patent office so that any above-mentioned change in the proprietorship could be registered or recorded officially in the Register of Patents to keep the Register of Patents up-to-date. Once these changes are registered in the Register of Patents, having the documents able to show the proper legal ownership, as a proof, it can be used as legal proof in court or before the patent office for any legal battle. The changes, which are not recorded in the Register of Patents, cannot be used as legal proof in court or before the patent office for any legal battle. In case of any disagreement about the lawful ownership of a patent, the patent office can wait till the issue is solved in court and once the decision of the court comes, the updated ownership or rights of a patent should be registered.

70

Power of registered grantee or proprietor to deal with patent

Subject to the provisions contained in this Act relating to co-ownership of patents and subject also to any rights vested in any other person of which notice is entered in the register, the person or persons registered as grantee or proprietor of a patent shall have power to assign, grant licences under, or otherwise deal with, the patent and to give effectual receipts for any consideration for any such assignment, licence or dealing: Provided that any equities in respect of the patent may be enforced in like manner as in respect of any other movable property.

Explanation:
This section empowers the registered grantee or proprietor of a patent to assign, license or otherwise deal with the patent, including receiving payment or considering such kind of transactions, ensuring maximum and legally possible commercial exploitation of the patent by the patent holder, without having conflicting rights over it. Moreover, any patent related equity, such as financial interests or claims can be enforced in like manner as those in respect of any other movable property.

71

Rectification of register by High Court

(1) The High Court may, on the application of any person aggrieved —
(a) by the absence or omission from the register of any entry; or
(b) by any entry made in the register without sufficient cause; or
(c) by any entry wrongly remaining on the register; or
(d) by any error or defect in any entry in the register, make such order for the making, variation or deletion, of any entry therein as it may think fit.
(2) In any proceeding under this section the High Court may decide any question that may be necessary or expedient to decide in connection with the rectification of the register.
(3) Notice of any application to the High Court under this section shall be given in the prescribed manner to the Controller who shall be entitled to appear and be heard on the application, and shall appear if so, directed by the High Court.
(4) Any order of the High Court under this section rectifying the register shall direct that notice of the rectification shall be served upon the Controller in the prescribed manner who shall upon receipt of such notice rectifies the register accordingly.

Explanation:
This section empowers the High Court to rectify anything in the Register of Patents. This section allows any person aggrieved to apply to the High Court for correction or rectification of information present in the Register of Patents if he/she notices, either absence or omission of any entry from the Register of Patents, or presence of any entry in the Register of Patents without sufficient cause, or presence of any wrong entry on the Register of Patents, or presence of any error or defect in the Register of Patents making orders for the making, variation or deletion, of any entry therein. Upon receiving such request from the person aggrieved, the High Court may decide to put any necessary question to either complete or to expedite the rectification process. Moreover, any application notice related to rectification of the Register of Patents made to the High Court, shall be given in the prescribed manner to the Controller, who has a legal right to appear and be heard on the concerned rectification application, by the High Court. Furthermore, upon hearing both the Controller and the person aggrieved, the High Court may generate any order, regarding the rectification of the Register of Patents, the notice of which should be sent to the Controller in the prescribed manner. The Controller, upon receipt of such notice should rectify the Register of Patents accordingly.

72

Register to be open for inspection

(1) Subject to the provisions contained in this Act and any rules made thereunder, the register shall at all convenient times be open to inspection by the public; and certified copies, sealed with the seal of the patent office, of any entry in the register shall be given to any person requiring them on payment of the prescribed fee.
(2) The register shall be prima facie evidence of any matters required or authorised by or under this Act to be entered therein.
(3) If the record of particulars is kept in computer floppies or diskettes or in any other electronic form, sub-sections (1) and (2) shall be deemed to have been complied with if the public is given access to such computer floppies, diskettes or any other electronic form or printouts of such record of particulars for inspection.

Explanation:
This section is about the public accessibility of the register of patents for patent related information for promoting transparency and supporting legal and commercial due diligence in patent related matters. According to this section, the patent register, maintained by the patent office, should be open for public inspection at all convenient times. Upon a formal request with payment of the prescribed fee, any person is eligible to get the certified copies of any document related to a patent, present in the register of patents, sealed with the seal of the patent office. The register of patents serves as the prima facie evidence of all the matters recorded in it. Moreover, if the register of patents is maintained in any electronic forms, such as computer floppies or diskettes, or in any other electronic form, public access to the digital records or their printouts will be treated as sufficient to meet the public inspection requirement.

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Chapter 14
PATENT OFFICE AND ITS ESTABLISHMENT

73

Controller and other officers

(1) The Controller General of Patents, Designs and Trade Marks appointed under sub-section (1) of section 3 of the Trade Marks Act, 1999 (47 of 1999), shall be the Controller of Patents for the purposes of this Act.

(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.

(3) Subject to the provisions of this Act, the officers appointed under subsection (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, authorise them to discharge.

(4) Without prejudice to the generality of the provisions of sub-section (3), the Controller may, by order in writing and for reasons to be recorded therein withdraw any matter pending before an officer appointed under sub-section (2) and deal with such matter himself either de novo or from the stage it was so withdrawn or transfer the same to another officer appointed under sub-section (2) who may, subject to special directions in the order of transfer, proceed with the matter either de novo or from the stage it was so transferred.

Explanation:

Section 73 defines the leadership structure of the Indian Patent Office. It establishes a centralized system where one senior official – the Controller General of Patents, Designs, and Trade Marks – is appointed by the Central Government to head all major intellectual property offices in India. This includes oversight of patents, designs, trademarks, and geographical indications.

The Controller General also acts as the Controller of Patents under this Act and has the power to appoint and manage examiners and other officers. These officers can carry out specific duties if authorized through a written order.

Crucially, the Controller retains ultimate control, with the power to withdraw any matter from an officer and deal with it personally or reassign it to another officer, specifying whether the case should be handled from the beginning (de novo) or continued from the point of transfer. This ensures accountability (i.e. officers know their decisions can be reviewed or reassigned); consistency (i.e. the Controller can correct errors or ensure uniform interpretation of the law); and efficiency (i.e. the Controller can intervene in complex or sensitive matters when needed). It also acts as a safeguard, allowing the Controller to correct errors and maintain uniform standards across the system.

74

Patent office and its branches

(1) For the purposes of this Act, there shall be an office which shall be known as the patent office.

(2) The Central Government may, by notification in the Official Gazette, specify the name of the Patent Office.

(3) 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 office.

(4) There shall be a seal of the patent office.

Explanation:

Section 74 provides for the establishment of the Patent Office in India to administer the patent system. The Central Government is responsible for officially naming the office via a notification and for specifying the location of its head office, which is currently in Kolkata, along with any branch offices deemed necessary to facilitate patent registration, such as those in Mumbai, Chennai, and New Delhi. The section also mandates that the Patent Office shall have an official seal to authenticate its documents. The territorial jurisdiction of patent offices for applicants is as follows;

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

Territorial Jurisdiction of Patent Offices

75

Restriction on employees of patent office as to right or interest in patents

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

Explanation:
Section 75 establishes a clear ethical boundary for all officers and employees of the patent office, prohibiting them from acquiring any rights or interests in patents issued by the office during their tenure. The restriction applies both directly and indirectly, that is, they cannot obtain such rights themselves or through intermediaries, ensuring that their official duties remain free from personal gain or conflict of interest. This safeguard is designed to prevent self-dealing or insider advantage, thereby maintaining a fair, impartial and transparent patent process. However, this section makes an exception for rights acquired through inheritance or bequest, meaning that if a patent is passed down to them by a relative through succession or a will, they are permitted to hold that interest.

76

Officers and employees not to furnish information, etc.

An officer or employee in the patent office shall not, except when required or authorised by this Act or under a direction in writing of the [Central Government*..] or the Controller or by order of a court-

(a) furnish information on a matter which is being, or has been, dealt with under this Act ; or

(b) prepare or assist in the preparation of a document required or permitted by or under this Act , to be lodged in the patent office; or

(c) conduct a search in the records of the patent office.

** The words "or Appellate Board" omitted by Act 33 of 2021, s. 13 (w.e.f. 4-4-2021).*

Explanation:
Section 76 serves as confidentiality safeguard that prohibits officers and employees of the Patent Office from disclosing information related to patent matters or performing specific actions like preparation or assistance in preparing patent documents and the conduct of record searches within the Patent Office unless expressly authorized. Such authorization must come from the Act itself, the Central Government, the Controller or a court order. The phrase Appellate Board was deleted from the Act in 2021 and with effect from 4-4-2021 its jurisdiction transferred to the High Courts, any such authorization now falls under the purview of the relevant High Court. This section ensures the integrity, confidentiality and impartiality of the patent administration process.

Chapter 15
POWERS OF CONTROLLER GENERALLY

77

Controller to have certain powers of a civil court

(1) Subject to any rules made in this behalf, the Controller in any proceedings before him under this Act shall have the powers of a civil court while trying a suit under the Code of Civil Procedure, 1908 (5 of 1908), in respect of the following matters, namely:

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

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

(c) receiving evidence on affidavits;

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

(e) awarding costs;

(f) reviewing his own decision on application made within the prescribed time and in the prescribed manner;

(g) setting aside an order passed ex- parte on application made within the prescribed time and in the prescribed manner;

(h) any other matter which may be prescribed.

(2) Any order for costs awarded by the Controller in exercise of the powers conferred upon him under sub-section (1) shall be executable as a decree of a civil court.

Explanation:

Section 77 of the Patents Act, 1970, grants the Controller of Patents the powers of a civil court for proceedings conducted under the Act. This delegation of authority ensures that patent matters are handled with the same procedural rigor and fairness as regular civil litigation. The Controller can summon individuals to appear and examine them under oath, thereby securing the presence of parties or witnesses necessary for justice. To maintain transparency and prevent concealment of information, the Controller may require the disclosure and production of relevant documents. Evidence may also be accepted in the form of sworn affidavits which streamlines the process by avoiding the need for every witness to appear in person. Where direct examination is not possible, the Controller may issue commissions for the examination of witnesses or documents through an appointed commissioner. In addition, the Controller has the authority to award costs, usually directing the unsuccessful party to bear the expenses of the successful one. The Controller may also review his own decision upon application made within the prescribed time and manner, allowing correction of errors and preventing injustice. The Controlled can set aside an order passed in the absence of a party if sufficient cause for non-appearance is demonstrated. In addition, the Act empowers the Controller to exercise any other powers that may be prescribed through the rules, thus ensuring flexibility to meet procedural requirements.

Subsection (2) pertaining to execution of a cost order gives legal weight to the Controller's orders concerning costs which means that if a party fails to pay the awarded costs, the successful party can directly enforce the order through a civil court without having to file a new suit.

78

Power of Controller to correct clerical errors etc.

(1) Without prejudice to the provisions contained in sections 57 and 59 as regards amendment of applications for patents or complete specifications or other documents related thereto and subject to the provisions of section 44, the Controller may, in accordance with the provisions of this section, correct any clerical error in any patent or in any specification or other document filed in pursuance of such application or in any application for a patent or any clerical error in any matter which is entered in the register.

(2) A correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.

(3) Where the Controller proposes to make any such correction as aforesaid otherwise than in pursuance of a request made under this section, he shall give notice of the proposal to the patentee or the applicant for the patent, as the case may be, and to any other person who appears to him to be concerned, and shall give them an opportunity to be heard before making the correction.

(4) Where a request is made under this section for the correction of any error in a patent or application for a patent or any document filed in pursuance of such an application, and it appears to the Controller that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons affected thereby, he shall require notice of the nature of the proposed correction to be published in the prescribed manner.

(5) Within the prescribed time after any such publication as aforesaid any person interested may give notice to the Controller of opposition to the request, and, where such notice of opposition is given, the Controller shall give notice thereof to the person by whom the request was made, and shall give to him and to the opponent an opportunity to be heard before he decides the case.

Explanation:

According to this section, the Controller of Patents has power to rectify typos or clerical errors in patent related documents, registers, applications, or specifications. In this section the reference to Sections 57 (i.e. related to amendments to patent applications or specifications), 59 (i.e. post-grant amendments to the specification or claims), and 44 (I.e. related to amendments in cases of patent assignment or transfer) is given to ensure that this section is limited only to clerical/typographical corrections only and it prevents misuse of this section for making substantive amendments that must follow the stricter process. This provision plays an important role in upholding the integrity of patent records by allowing corrections that do not affect the substantive content of the application. However, it cannot be used to change the actual invention or to extend any legal deadlines.

Such correction may be carried out either upon a written request by any interested person accompanied with the prescribed fee or by the Controller on his own (i.e. suo motu). If correction is made suo motu, the Controller must give notice to applicant/patentee and concerned persons, and give them an opportunity to be heard. If correction affects meaning/scope, Controller must publish notice of proposed correction. After publication, interested persons may oppose within prescribed time and both parties get a hearing before final decision.

For Example: ***Original Claim (with error):*** A method for isolating protein using a buffer comprising sodium chloride in a concentration of 0.5 M.
Actual Intended Claim*: (****proposed correction****)* : "…sodium chloride in a concentration of 5 M."
Impact of correction**:** It will change the scope of invention: Correcting "0.5 M" to "5 M" changes the chemical conditions significantly. This could:

- Alter the scope of protection;
- Affect novelty or inventive step;
- Mislead competitors or examiners

Hence, in such cases, the Controller may require public notice under Section 78(4).

79

Evidence how to be given and powers of Controller in respect thereof

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

Explanation:

This Section explains how evidence is to be presented in proceedings before the Controller. By default, evidence must be submitted in the form of an affidavit, unless the Controller directs otherwise. However, if the Controller believes it is appropriate, he may allow oral evidence instead of or in addition to the affidavit. He also has the power to permit cross-examination of any person who has submitted an affidavit.

For example: An applicant misses the deadline to respond to the First Examination Report (FER) and submits a request for extension under Rule 138. Along with the request, they file an affidavit stating that the delay was due to a medical emergency: for example, hospitalization due to typhoid.

The Controller reviews the affidavit but feels the explanation needs further verification. To assess the genuineness of the claim, the Controller may call the applicant to give oral evidence during a hearing for instance, to explain the timeline of illness and recovery. The Controller may allow cross-examination by the opposing party (if any), especially if the extension affects their interests. This oral evidence helps the Controller decide whether the delay was truly unavoidable and whether the extension should be granted.

80

Exercise of discretionary powers by Controller

Without prejudice to any provision contained in this Act requiring the Controller to hear any party to the proceedings thereunder or to give any such party an opportunity to be heard, the Controller shall give to any applicant for a patent, or for amendment of a specification (if within the prescribed time the applicant so requires) an opportunity to be heard before exercising adversely to the applicant any discretion vested in the Controller by or under this Act. Provided that the party desiring a hearing makes the request for such hearing to the Controller at least ten days in advance of the expiry of the time-limit specified in respect of the proceeding.

Explanation:
If the Controller is about to make a decision that could go against the applicant (such as refusing a patent or rejecting an amendment request), the applicant has a right to be heard, but only if they ask for it in prescribed time. Specifically, the applicant must submit a request for a hearing at least ten days before the deadline for that proceeding. This ensures that the Controller doesn't make an adverse decision without giving the applicant a fair chance to explain their side. This section reinforces the principle of fairness and procedural opportunity in patent matters.

81

Disposal by Controller of applications for extension of time

Where under the provisions of this Act or the rules made thereunder the Controller may extend the time for doing any act, nothing in this Act shall be deemed to require him to give notice to or hear the party interested in opposing the extension, nor shall any appeal lie from any order of the Controller granting such extension.

Explanation:
According to this section, the Controller has the power to extend the time for doing any act under the Act or its rules such as replying to an examination report or filing a document; he can grant that extension without giving notice to anyone who might oppose it. Also, no appeal can be filed against the Controller's decision to grant such an extension. This means the Controller's decision is final.
Example: Suppose an applicant receives a First Examination Report (FER) and is required to respond within six months. Due to unexpected delays in gathering technical data, the applicant files a request for extension of time under Rule 138. The Controller reviews the request and decides to grant the extension by one month.
Even if a third party (e.g., a potential opponent) believes the extension is unfair or strategically harmful, they cannot oppose the Controller's decision. Also, no appeal can be filed against the Controller's order granting the extension.

Chapter 16

WORKING OF PATENTS, COMPULSORY LICENCES AND REVOCATION

82

Definition of "patented articles" and "patentee"

In this Chapter, unless the context otherwise requires,

1. "patented article" includes any article made by a patented process; and
2. "patentee" includes an exclusive licensee.

Explanation:

Section 82 gives special definitions of 'patented article' and 'patentee' that are broader than those given in Section 2 of the Act. Here, a "patented article" includes not just a patented product but also any item made using a patented process. Similarly, a "patentee" includes both the person registered as the patent owner and any exclusive licensee. These definitions apply only within this chapter, which deals with compulsory licensing and related matters.

For example: A company, XYZ Lab., holds a process patent for synthesizing a novel insulin analog using recombinant DNA technology. The patented process involves a unique fermentation and purification method. The company grants exclusive rights to ABC Pvt. Ltd.

Now under Section 82:

"Patented Article": The insulin analog produced using XYZ Lab's patented process is considered a "patented article", even though the patent is on the process, not the product itself.

"Patentee": XYZ Lab grants exclusive rights to distribute and market the insulin analog in India to ABC Pvt. Ltd.

Under Section 82(b), ABC Pvt. Ltd. is treated as the "patentee" for the purposes of Chapter XVI (e.g., if a compulsory license is sought, ABC Pvt. Ltd. can respond as the patentee).

83

General principles applicable to working of patented inventions

Without prejudice to the other provisions contained in this Act, in exercising the powers conferred by this Chapter, regard shall be had to the following general considerations, namely;

(a) that patents are granted to encourage inventions and to secure that the inventions are worked in India on a commercial scale and to the fullest extent that is reasonably practicable without undue delay;

(b) that they are not granted merely to enable patentees to enjoy a monopoly for the importation of the patented article;

(c) that the protection and enforcement of patent rights contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations;

(d) that patents granted do not impede protection of public health and nutrition and should act as instrument to promote public interest specially in sectors of vital importance for socio-economic and technological development of India;
(e) that patents granted do not in any way prohibit Central Government in taking measures to protect public health;
(f) that the patent right is not abused by the patentee or person deriving title or interest on patent from the patentee, and the patentee or a person deriving title or interest on patent from the patentee does not resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology; and
(g) that patents are granted to make the benefit of the patented invention available at reasonably affordable prices to the public.

Explanation:
This section functions as a guiding principle for the exercise of powers conferred under Chapter XVI, including the grant of compulsory licences. The emphasis is on safeguarding public interest, fostering innovation and ensuring the responsible use of patent rights. The clauses of this section embody the fundamental principles of safeguarding public interest and ensuring the fair and responsible exercise of patent rights.

- **Encouraging Local Use:** Patents should result in the commercial working of inventions in India, rather than being held merely on paper or delayed indefinitely.
- **No Monopoly on Imports:** Patent rights must not be exercised solely for importing products or for preventing others from manufacturing them within India.
- **Promoting Innovation & Technology transfer:** Patents should facilitate the dissemination of technology, benefiting both innovators and society at large, and contributing to economic and social welfare.
- **Supporting Public Health & Nutrition:** Patent protection must not obstruct access to essential goods. Patents should advance public interest, particularly in vital sectors such as healthcare, agriculture, and biotechnology.
- **Government's Right to Act:** The Central Government retains authority to adopt measures necessary to safeguard public health and ensure that patent rights do not override broader social objectives.
- **Preventing Abuse of Rights:** Patentee and licensee must not misuse patent rights to unfairly restrict trade, hinder technology transfer, or engage in practices detrimental to competition.
- **Balanced Patent System:** The patent framework is intended to strike a balance between private rights and public obligations, ensuring that the system fosters innovation while also serving the larger public good.

84

Compulsory licences

1. At any time after the expiration of three years from the date of the grant of a patent, any person interested may make an application to the Controller for grant of compulsory licence on patent on any of the following grounds, namely:

- that the reasonable requirements of the public with respect to the patented invention have not been satisfied,or
- that the patented invention is not available to the public at a reasonably affordable price, or
- that the patented invention is not worked in the territory of India.

Explanation:
After the expiry of three years from the date of grant of a patent, any interested person, such as a company, researcher, or public institution, may apply to the Controller of Patents for the grant of a compulsory licence- a legal permission to use the patented invention without the patentee's consent. The following are the grounds for granting a compulsory licence. The applicant must establish at least one of these grounds;
(a) Unmet Public Needs: The patented invention is not widely accessible enough to satisfy the public's legitimate needs.
For instance, a patented medication that saves lives is only accessible to a small percentage of patients because of a restricted supply.
(b) Unaffordable Prices: The general population cannot afford the invention.
For example, a patented medical device costs significantly more than patients or hospitals can afford.
(c) Non-working in India: The invention is not being manufactured or used in India.
Example: A patented technology is only produced abroad and not locally commercialized or imported.

Compulsory licences

2. An application under this section may be made by any person notwithstanding that he is already the holder of a licence under the patent and no person shall be stopped from alleging that the reasonable requirements of the public with respect to the patented invention are not satisfied or that the patented invention is not worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price by reason of any admission made by him, whether in such a licence or otherwise or by reason of his having accepted such a licence.

Explanation:
Even if a person already holds a licence under the patent (i.e., has permission from the patentee to use the invention), they can still apply for a compulsory licence under Section 84. This subsection ensures that public interest takes priority over private arrangements. The applicant cannot be legally barred from claiming:
- Public requirements are not met
- The invention is not worked in India
- The price is not reasonably affordable

Even if the applicant previously admitted otherwise in the licence agreement or elsewhere, they can still raise these grounds.

Compulsory licences

3. Every application under sub-section (1) shall contain a statement setting out the nature of the applicant's interest together with such particulars as may be prescribed and the facts upon which the application is based.

Explanation:
When someone applies for a compulsory licence under Section 84(1), they must clearly explain why they are interested in the patent- such as being a manufacturer, distributor, or public health organization. The application must also include all required details as per the patent rules, like the patent number, applicant's information, and proof that the 3-year period has passed. Most importantly, the applicant must provide facts and evidence to support their claim showing that the public's needs aren't being met, the product is too expensive, or it's not being manufactured or used in India.

Compulsory licences

4. The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied or that the patented invention is not worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price, may grant a licence upon such terms as he may deem fit.

Explanation:
If the Controller of Patents is satisfied that the public's reasonable needs for the patented invention are not being met or that the invention is not being manufactured or used in India, or that it is not available at a reasonably affordable price, then the Controller has the authority to grant a compulsory licence. This licence allows another party to use the patented invention and the Controller can decide the terms and conditions for the licence such as royalty payments, scope of use etc. keeping the public interest in mind.

Compulsory licences

5. Where the Controller directs the patentee to grant a licence he may, as incidental thereto, exercise the powers set out in section 88.

Explanation:
If the Controller decides that a compulsory licence should be granted and directs the patentee to issue that licence to the applicant, the Controller can also use the powers given under Section 88 to support or manage the licensing process. These powers include setting specific terms and conditions for the licence such as the scope of use, duration, royalty payments, and other safeguards to ensure the licence serves the public interest and is fair to both parties.

Compulsory licences

6. In considering the application field under this section, the Controller shall take into account,
(i) the nature of the invention, the time which has elapsed since the sealing of the patent and the measures already taken by the patentee or any licensee to make full use of the invention;
(ii) the ability of the applicant to work the invention to the public advantage;
(iii) the capacity of the applicant to undertake the risk in providing capital and working the invention, if the application were granted;
(iv) as to whether the applicant has made efforts to obtain a licence from the patentee on reasonable terms and conditions and such efforts have not been successful within a reasonable period as the Controller may deem fit: Provided that this clause shall not be applicable in case of national emergency or other circumstances of extreme urgency or in case of public non-commercial use or on establishment of a ground of anticompetitive practices adopted by the patentee, but shall not be required to take into account matters subsequent to the making of the application. Explanation.—For the purposes of clause (iv), "reasonable period" shall be construed as a period not ordinarily exceeding a period of six months.

Explanation:
When the Controller reviews a compulsory licence application under Section 84, they must consider several factors. These include the type of invention, how long it's been since the patent was granted and what steps the patentee or licensee has taken to fully use the invention. The Controller also looks at whether the applicant is capable of using the invention in a way that benefits the public and whether they have the financial capacity and willingness to take on the risks involved.

Further, the applicant must show that they tried to get a voluntary licence from the patentee on reasonable terms, but were unsuccessful within a reasonable time usually not more than six months. However, this requirement is waived in cases of national emergency, extreme urgency, public non-commercial use, or if the patentee has engaged in anti-competitive practices. The Controller will not consider events that happen after the application for compulsory license is filed.

Compulsory licences

7. For the purposes of this Chapter, the reasonable requirements of the public shall be deemed not to have been satisfied-

(a) if, by reason of the refusal of the patentee to grant a licence or licences on reasonable terms,

1. an existing trade or industry or the development thereof or the establishment of any new trade or industry in India or the trade or industry of any person or class of persons trading or manufacturing in India is prejudiced; or
2. the demand for the patented article has not been met to an adequate extent or on reasonable terms; or
3. a market for export of the patented article manufactured in India is not being supplied or developed; or
4. the establishment or development of commercial activities in India is prejudiced; or

(b) if, by reason of conditions imposed by the patentee upon the grant of licences under the patent or upon the purchase, hire or use of the patented article or process, the manufacture, use or sale of materials not protected by the patent, or the establishment or development of any trade or industry in India, is prejudiced; or

(c) if the patentee imposes a condition upon the grant of licences under the patent to provide exclusive grant back, prevention to challenges to the validity of patent or coercive package licensing; or

(d) if the patented invention is not being worked in the territory of India on a commercial scale to an adequate extent or is not being so worked to the fullest extent that is reasonably practicable; or

1. if the working of the patented invention in the territory of India on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by
2. the patentee or persons claiming under him or
3. persons directly or indirectly purchasing from him; or
4. other persons against whom the patentee is not taking or has not taken proceedings for infringement.

Explanation:

For the purpose of granting a compulsory licence, the law recognizes that the reasonable requirements of the public may be considered unmet in various circumstances. These circumstances include situations where the patentee refuses to grant licences on reasonable terms, adversely affecting existing or potential industries in India, or fails to adequately meet the demand for the patented product. It also applies when patentee imposes restrictive conditions such as linking unrelated products to the licence, reserving exclusive rights, preventing lawful challenges to the patent or enforcing package deals. Furthermore, if the patented invention is not being commercially worked in India to a reasonable extent or if local utilization is impeded due to imports from abroad, particularly when patentee does not take steps to prevent such imports, the public's requirements are deemed unsatisfied. In these cases, the Controller is empowered to intervene to safeguard public interest and promote industrial development.

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Revocation of patents by the Controller for non-working

1. Where, in respect of a patent, a compulsory licence has been granted, the Central Government or any person interested may, after the expiration of two years from the date of the order granting the first compulsory licence, apply to the Controller for an order revoking the patent on the ground that the patented invention has not been worked in the territory of India or that reasonable requirements of the public with respect to the patented invention has not been satisfied or that the patented invention is not available to the public at a reasonably affordable price.
2. Every application under sub-section (1) shall contain such particulars as may be prescribed, the facts upon which the application is based, and, in the case of an application other than by the Central Government, shall also set out the nature of the applicant's interest.
3. The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied or that patented invention has not been worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price, may make an order revoking the patent.
4. Every application under sub-section (1) shall ordinarily be decided within one year of its being presented to the Controller.

Explanation:
This section empowers the Controller to revoke a patent on grounds of non-working but only after a compulsory licence has been granted and two years have passed since that order. The Central Government or any interested person may apply for revocation if the patented invention has not been commercially worked in India, does not meet the reasonable requirements of the public, or is not available at a reasonably affordable price. Any person interested in a patent, such as a competitor, consumer group, or licensee as well as the Central Government can apply for revocation. If the applicant is not the Central Government, they must clearly explain their interest in the matter. The application must include all prescribed particulars, provide facts supporting the request for revocation and in the case of non-government applicants, disclose their interest in the patent.

86

Power of Controller to adjourn applications for compulsory licences, etc., in certain cases

1. Where an application under section 84 or section 85, as the case may be, is made on the grounds that the patented invention has not been worked in the territory of India or on the ground mentioned in clause (d) of sub-section (7) of section 84 and the Controller is satisfied that the time which has elapsed since the sealing of the patent has for any reason been insufficient to enable the invention to be worked on a commercial scale to an adequate extent or to enable the invention to be so worked to the fullest extent that is reasonably practicable, he may, by order, adjourn the further hearing of the application for such period not exceeding twelve months in the aggregate as appears to him to be sufficient for the invention to be so worked:

Provided that in any case where the patentee establishes that the reason why a patented invention could not be worked as aforesaid before the date of the application was due to any State or Central Act or any rule or regulation made thereunder or any order of the Government imposed otherwise than by way of a condition for the working of the invention in the territory of India or for the disposal of the patented articles or of the articles made by the process or by the use of the patented plant, machinery, or apparatus, then, the period of adjournment ordered under this sub-section shall be reckoned from the date on which the period during which the working of the invention was prevented by such Act, rule or regulation or order of Government as computed from the date of the application, expires.

2. No adjournment under sub-section (1) shall be ordered unless the Controller is satisfied that the patentee has taken with promptitude adequate or reasonable steps to start the working of the invention in the territory of India on a commercial scale and to an adequate extent.

Explanation:
According to Section 86 the Controller has power to adjourn hearings on applications for compulsory licences (under Section 84) or revocation (under Section 85) if the patented invention has not yet been worked in India. If the Controller finds that the patent has only recently been granted and the patentee has not had sufficient time to begin commercial-scale use of the invention, the hearing of a compulsory license application may be postponed. Such postponement can be allowed for up to 12 months in total, giving the patentee a fair opportunity to start working the invention before the license is considered. Additionally, if the patentee proves that the delay in working was due to legal or governmental restrictions such as a State or Central Act, rule, regulation, or government order unrelated to working conditions the adjournment period will be calculated from the end of such restriction. The Controller will only grant adjournment if the patentee has already made genuine efforts to commercially use or sell the invention in India.

87

Procedure for dealing with applications under sections 84 and 85

1. Where the Controller is satisfied, upon consideration of an application under section 84, Or section 85, that a prima facie case has been made out for the making of an order, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which the application is made, and shall publish the application in the official journal.

Explanation:
As per subsection 1, If someone applies for a compulsory license (under Section 84) or revocation of patent (under Section 85) and the Controller thinks the application looks valid at first glance, then the Controller will ask the applicant to send copies of the application to the patent holder and anyone else listed in the patent register who might be affected. The Controller will also publish the application in the official patent journal so that others are informed.

Procedure for dealing with applications under sections 84 and 85

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

Explanation:
If the patent holder or any other person wants to oppose the application (for compulsory license or revocation), they can inform the Controller by giving a notice of opposition. This must be done within the time allowed by the rules, or within extra time if the Controller agrees whether the request for extra time is made before or after the original deadline.

Procedure for dealing with applications under sections 84 and 85

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

Explanation:
The notice of opposition must contain a written statement explaining why they are opposing it. This statement should clearly mention the reasons or grounds for the opposition such as legal, technical, or factual points that challenge the application. Without this explanation, the opposition won't be considered complete.

Procedure for dealing with applications under sections 84 and 85

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

Explanation:
According to this subsection, if notice of opposition is submitted properly, the Controller must inform the applicant about it. Then, before making any decision, the Controller must give both the applicant and the opponent a fair chance to present their side.

88

Powers of Controller in granting compulsory licences

1. Where the Controller is satisfied on an application made under section 84 that the manufacture, use or sale of materials not protected by the patent is prejudiced by reason of conditions imposed by the patentee upon the grant of licences under the patent, or upon the purchase, hire or use of the patented article or process, he may, subject to the provisions of that section, order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant.

Explanation:
If someone applies for a compulsory licence under Section 84 and the Controller finds that the patentee has set unfair or unreasonable conditions such as limiting how others can get a licence or use the patented product or process and these conditions affect the sale or use of non-patented items, the Controller can take action and may order that licences be granted not only to the applicant but also to the applicant's customers, if needed. This ensures that the patentee does not use the patent rights in a way that unfairly restricts trade or other products.

Powers of Controller in granting compulsory licences

2. Where an application under section 84 is made by a person being the holder of a licence under the patent, the Controller may, if he makes an order for the grant of a licence to the applicant, order the existing licence to be cancelled, or may, if he thinks fit, instead of making an order for the grant of a licence to the applicant, order the existing licence to be amended.

Explanation:
According to this section, if someone who already holds a license under a patent applies for a compulsory license under Section 84 and the Controller has two options when deciding the application. The Controller can either cancel the existing license and issue a new one or if he prefers, he can simply change (amend) the terms of the existing license instead of granting a fresh one. This gives the Controller flexibility to adjust licensing terms based on the situation.

Powers of Controller in granting compulsory licences

3. Where two or more patents are held by the same patentee and an applicant for a compulsory licence establishes that the reasonable requirements of the public have not been satisfied with respect to some only of the said patents, then, if the Controller is satisfied that the applicant cannot efficiently or satisfactorily work the licence granted to him under those patents without infringing the other patents held by the patentee and if those patents involve important technical advancement of considerable economic significance in relation to the other patents, he may, by order, direct the grant of a licence in respect of the other patents also to enable the licensee to work the patent or patents in regard to which a licence is granted under section 84.

Explanation:
If a person applies for a compulsory license under Section 84 for one or more patents held by the same patentee and proves that public needs are not being met for those patents, the Controller may look deeper. If the Controller finds that the applicant cannot properly use those patents without also using other related patents held by the same patentee and those other patents involve important technical improvements that are economically significant then the Controller can also grant a license for those related patents. This helps the applicant work the original patents effectively without legal risk of infringement.

Powers of Controller in granting compulsory licences

4. Where the terms and conditions of a licence have been settled by the Controller, the licensee may, at any time after he has worked the invention on a commercial scale for a period of not less than twelve months, make an application to the Controller for the revision of the terms and conditions on the ground that the terms and conditions settled have proved to be more onerous than originally expected and that in consequence thereof the licensee is unable to work the invention except at a loss: Provided that no such application shall be entertained a second time.

Explanation:
As per this subsection, if the Controller has already fixed the terms and conditions of a license and the licensee has used the invention commercially for at least 12 months, the licensee can apply to the Controller to revise those terms. This is allowed only if the licensee can show that the original terms turned out to be more burdensome than expected and because of that, they are unable to make a profit they are working the invention at a loss. However, this kind of application for revision can be made only once. The law does not allow a second request for revision later.

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General purposes for granting compulsory licences

The powers of the Controller upon an application made under section 84 shall be exercised with a view to securing the following general purposes, that is to say,

(a) that patented inventions are worked on a commercial scale in the territory of India without undue delay and to the fullest extent that is reasonably practicable;

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

Explanation:

This section reflects the guiding principles that the Controller consider while deciding an application for a compulsory licence under section 84. The Controller ensures that patented inventions are actually worked and commercially used in India without unnecessary delay and to the fullest extent reasonably possible, so that the public and industry benefit from them. At the same time, the Controller must see that the interests of other persons who are already working on or developing inventions in India under patent protection are not unfairly affected.

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Terms and conditions of compulsory licences

1. In settling the terms and conditions of a licence under section 84, the Controller shall endeavour to secure:

(i) that the royalty and other remuneration, if any, reserved to the patentee or other person beneficially entitled to the patent, is reasonable, having regard to the nature of the invention, the expenditure incurred by the patentee in making the invention or in developing it and obtaining a patent and keeping it in force and other relevant factors;

(ii) that the patented invention is worked to the fullest extent by the person to whom the licence is granted and with reasonable profit to him;

(iii) that the patented articles are made available to the public at reasonably affordable prices;

(iv) that the licence granted is a non-exclusive licence;

(v) that the right of the licensee is non-assignable;

(vi) that the licence is for the balance term of the patent unless a shorter term is consistent with public interest;

(vii) that the licence is granted with a predominant purpose of supply in the Indian market and that the licensee may also export the patented product if need be in accordance with the provisions of sub-clause (iii) of clause (a) of sub-section (7) of section 84;

(viii) that in the case of semi-conductor technology, the licence granted is to work the invention for public non-commercial use;

(ix) that in case the licence is granted to remedy a practice determined after judicial or administrative process to be anti-competitive, the licensee shall be permitted to export the patented product, if need be.

Explanation:

When the Controller fixes the terms of a compulsory licence, the aim is to keep a fair balance. The patentee should get a reasonable royalty, keeping in mind the nature of the invention and the costs they spent in developing and maintaining the patent. At the same time, the licensee must actually use the patent fully and be allowed to earn a fair profit.

The invention or product should reach the public at affordable prices and the licence should be non-exclusive so that more than one company can be allowed to work the patent if needed. The Controller ensures that a compulsory licence cannot be transferred to someone else by the licensee (non-assignable). The licence normally lasts for the remaining term of the patent, unless a shorter duration is better for the public interest. Its main purpose is to supply the Indian market, but the licensee may also export the product if it falls under the special conditions allowed in Section 84(7)(a)(iii), such as addressing public health needs. Further if the compulsory licence relates to semiconductor technology, it can only be used for public non-commercial purposes, such as government or research projects, and not for private profit-making. Further, if a compulsory licence is granted because the patentee was found, through a court or official process, to be involved in anti-competitive practices (like unfairly blocking competition or overpricing), then the licensee is allowed to export the patented product if necessary.

Terms and conditions of compulsory licences

2. No licence granted by the Controller shall authorise the licensee to import the patented article or an article or substance made by a patented process from abroad where such importation would, but for such authorisation, constitute an infringement of the rights of the patentee.

Explanation:

A compulsory licence gives the right to make and sell the patented product (or a product made using the patented process) in India, but it does not give the right to import it from outside India. If a licensee tries to import the patented product from outside India, that would still be counted as an infringement of the patentee's rights (unless the patentee has separately authorised it).

Terms and conditions of compulsory licences

3. Notwithstanding anything contained in sub-section (2), the Central Government may, if in its opinion it is necessary so to do, in the public interest, direct the Controller at any time to authorise any licensee in respect of a patent to import the patented article or an article or substance made by a patented process from abroad (subject to such conditions as it considers necessary to impose relating among other matters to the royalty and other remuneration, if any, payable to the patentee, the quantum of import, the sale price of the imported article and the period of importation), and thereupon the Controller shall give effect to the directions.

Explanation:

Even though normally (as per sub-section 2) a compulsory licence cannot be used to import patented products from abroad, the Central Government has the special power to allow it in public interest. The Central Government can step in anytime and direct the Controller to authorise a licensee to import a patented product (or product made by a patented process) from another country. This is allowed only if the Government thinks it is necessary in the public interest – for example, in cases of shortage, high local manufacturing costs, or urgent health needs. Further the Government can also fix conditions such as royalty to be paid to the patentee, quantity of imports allowed, price at which the imported product must be sold, the duration for which import is allowed. Once the Government issues this direction, the Controller is bound to comply.

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Licensing of related patents

1. Notwithstanding anything contained in the other provisions of this Chapter, at any time after the sealing of a patent, any person who has the right to work any other patented invention either as patentee or as licensee thereof, exclusive or otherwise, may apply to the Controller for the grant of a licence of the first mentioned patent on the ground that he is prevented or hindered without such licence from working the other invention efficiently or to the best advantage possible.

Explanation:
This subsection deals with dependent patents when one invention cannot be used efficiently without using another patented invention. If someone holds a patent (or a licence) for a second invention, but they need access to an earlier patented invention to make their invention work fully, they can ask the Controller for a licence of that earlier patent.This prevents one patent from blocking the working of another related invention.

Licensing of related patents

2. No order under sub-section (1) shall be made unless the Controller is satisfied

(i) that the applicant is able and willing to grant, or procure the grant to the patentee and his licensees if they so desire, of a licence in respect of the other invention on reasonable terms; and

(ii) that the other invention has made a substantial contribution to the establishment or development of commercial or industrial activities in the territory of India.

Explanation:
Before the Controller grants a licence under Section 91(1) for a dependent patent, two conditions must be satisfied. First, the applicant must be willing and able to give the patentee of the first patent (and their licensees, if they wish) a licence to use the applicant's invention on fair and reasonable terms. Second, the applicant's invention should make a meaningful contribution to the development of industry or commerce in India, ensuring that the licence benefits the country's technological or industrial growth.

Licensing of related patents

3. When the Controller is satisfied that the conditions mentioned in sub-section (1) have been established by the applicant, he may make an order on such terms as he thinks fit granting a licence under the first mentioned patent and a similar order under the other patent if so requested by the proprietor of the first mentioned patent or his licensee: Provided that the licence granted by the Controller shall be non-assignable except with the assignment of the respective patents.

Explanation:
Once the Controller is convinced that the applicant has fulfilled the conditions under Section 91(1) (i.e., they need the first patent to work their invention efficiently), the Controller can:

- **Grant a licence for the first patent:** The licence is given on terms Controller considers fair.
- **Grant a licence for the applicant's patent (the second patent):** If requested, the Controller can also make a corresponding licence under the applicant's patent for the first patentee or their licensee.

The licences cannot be transferred to anyone else unless the respective patents themselves are assigned, i.e. these licences are tied to the patents and cannot be separately transferred.

Licensing of related patents

4. The provisions of sections 87, 88, 89 and 90 shall apply to licences granted under this section as they apply to licences granted under section 84.

Explanation:
All the rules and principles that apply to licences granted under Section 84 also apply to licences granted under Section 91. Specifically, Sections 87, 88, 89, and 90 will govern these licences in the same way.

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Special provision for compulsory licences on notifications by Central Government

1. If the Central Government is satisfied, in respect of any patent in force in circumstances of national emergency or in circumstances of extreme urgency or in case of public non commercial use, that it is necessary that compulsory licenses should be granted at any time after the sealing thereof to work the invention, it may make a declaration to that effect, by notification in the Official Gazette, and thereupon the following provisions shall have effect, that is to say

(i) the Controller shall on application made at any time after the notification by any person interested, grant to the applicant a licence under the patent on such terms and conditions as he thinks fit;

(ii) in settling the terms and conditions of a licence granted under this section, the Controller shall endeavour to secure that the articles manufactured under the patent shall be available to the public at the lowest prices consistent with the patentees deriving a reasonable advantage from their patent rights.

Explanation:
Section 92 allows the Central Government to step in and permit compulsory licences at any time for a patent in certain special circumstances, even immediately after the patent is granted. These circumstances include:

- National emergency e.g., war, epidemic, natural disaster;
- Extreme urgency e.g., sudden shortage of life-saving medicines;
- Public non-commercial use e.g., government wants to use a patented invention for public projects, without commercial profit.

The Central Government can issue a notification in the Official Gazette declaring that compulsory licences may be granted for a specific patent.
After the notification, any interested person can apply to the Controller for a licence. The Controller grants the licence on terms and conditions deemed appropriate. While fixing the licence terms, the Controller ensures that the products are available to the public at the lowest prices, while still allowing the patentee to get a reasonable benefit from their patent.

Special provision for compulsory licences on notifications by Central Government

2. The provisions of sections 83, 87, 88, 89 and 90 shall apply in relation to the grant of licences under this section as they apply in relation to the grant of licences under section 84.

Explanation:
All the rules and safeguards that apply to compulsory licences u/s 84 also apply to licences granted u/s 92. Specifically, Sections 83, 87, 88, 89, and 90 govern these licences just as they do under Section 84.
Even though Section 92 deals with emergencies, extreme urgency, or public non-commercial use, the same principles of fairness, royalties, commercial working, and public interest apply.

Special provision for compulsory licences on notifications by Central Government

3. Notwithstanding anything contained in sub-section (2), where the Controller is satisfied on consideration of the application referred to in clause (i) of sub-section (1) that it is necessary in;

Explanation:
This subsection allows the Controller to override usual licence rules in urgent situations, ensuring quick public access to essential inventions.

Special provision for compulsory licences on notifications by Central Government

4. **(i)** a circumstance of national emergency; or
(ii) a circumstance of extreme urgency; or
(iii) a case of public non-commercial use, which may arise or is required, as the case may be, including public health crises, relating to Acquired Immuno Deficiency Syndrome, Human Immuno Deficiency Virus, tuberculosis, malaria or other epidemics, he shall not apply any procedure specified in section 87 in relation to that application for grant of licence under this section: Provided that the Controller shall, as soon as may be practicable, inform the patentee of the patent relating to the application for such non-application of section 87.

Explanation:
If the Controller is satisfied that a licence is needed because of national emergency, extreme urgency or public non-commercial use (for example, public health crises like AIDS, HIV, tuberculosis, malaria or other epidemics) then the Controller does not have to follow the normal procedures under Section 87 when granting the licence.
The Section 87 normally deals with the process for settling terms and conditions of a licence.
In urgent situations, following the usual procedure may delay access, so it can be skipped to ensure rapid availability. However, the Controller shall inform the patentee as soon as possible about the non-application of Section 87.

92A

Compulsory licence for export of patented pharmaceutical products in certain exceptional circumstances

1. Compulsory licence shall be available for manufacture and export of patented pharmaceutical products to any country having insufficient or no manufacturing capacity in the pharmaceutical sector for the concerned product to address public health problems, provided compulsory licence has been granted by such country or such country has, by notification or otherwise, allowed importation of the patented pharmaceutical products from India.

Explanation:
This subsection allows compulsory licences specifically for exporting pharmaceutical products from India to other countries that cannot produce the drugs themselves.
India cannot just export the patented drug on its own. The receiving country must agree and authorize the import:
• either through their own compulsory licence (officially allowing their own company or a foreign manufacturer to make or import the drug to address a public health need)
• or an official approval (allowed importation of the patented pharmaceutical product from India, either through a notification or official permission)

Compulsory licence for export of patented pharmaceutical products in certain exceptional circumstances

2. The Controller shall, on receipt of an application in the prescribed manner, grant a compulsory licence solely for manufacture and export of the concerned pharmaceutical product to such country under such terms and conditions as may be specified and published by him.

Explanation:
When an Indian manufacturer applies for a compulsory licence to produce a patented drug for export, the Controller grants the licence only for export. The Controller decides the terms and conditions, such as the amount that can be produced, royalty to the patentee, quality standards, duration and publishes these rules publicly. This ensures that the licence is legal, fair and transparent, while protecting the patentee's rights.

Special provision for compulsory licences on notifications by Central Government

3. The provisions of sub-sections (1) and (2) shall be without prejudice to the extent to which pharmaceutical products produced under a compulsory license can be exported under any other provision of this Act. Explanation For the purposes of this section, 'pharmaceutical products' means any patented product, or product manufactured through a patented process, of the pharmaceutical sector needed to address public health problems and shall be inclusive of ingredients necessary for their manufacture and diagnostic kits required for their use.

Explanation:
Even though Sections (1) and (2) set rules for granting compulsory licenses and exporting patented pharmaceutical products, these rules do not limit other ways of exporting such products allowed under the law. Here, 'pharmaceutical products' includes any patented medicine or product made using a patented process, the ingredients needed to make them and diagnostic kits required for their use, as long as they are needed to address public health problems.

93

Order for licence to operate as a deed between parties concerned.

Any order for the grant of a licence under this Chapter shall operate as if it were a deed granting a licence executed by the patentee and all other necessary parties embodying the terms and conditions, if any, settled by the Controller.

Explanation:
When the Controller grants a license by passing an official order under this Chapter, that order is treated just like a legal agreement (deed) signed by the patent holder and all other required parties. It includes all the terms and conditions decided by the Controller and has the same legal effect as if everyone had formally signed a license agreement themselves.

94

Termination of compulsory licence

(1) On an application made by the patentee or any other person deriving title or interest in the patent, a compulsory licence granted under section 84 may be terminated by the controller, if and when the circumstances that gave rise to the grant thereof no longer exist and such circumstances are unlikely to recur: Provided that the holder of the compulsory licence shall have the right to object to such termination.

Explanation:
As per this section, if a compulsory licence was granted under Section 84, the patent holder or anyone with legal rights in the patent can apply to the Controller to end (terminate) that licence. The Controller may terminate it only if the original reasons for granting the licence no longer exist and are unlikely to happen again. However, the person who holds the compulsory licence has the right to object to this termination. This ensures fairness and gives both sides a chance to be heard.

Termination of compulsory licence

(2) While considering an application under section (1), the Controller shall take into account that the interest of the person who had previously been granted the licence is not unduly prejudiced.

Explanation:
When the Controller is deciding whether to cancel a compulsory licence (based on an application from the patentee or another interested party), he shall carefully consider the rights of the person who already holds the licence. The Controller shall take into account that the licensee's interests are not unfairly harmed by the termination.

95-98. [Omitted by the Patents (Amendment) Act, 2002]

Chapter 17

USE OF INVENTIONS FOR PURPOSES OF GOVERNMENT AND ACQUISITION OF INVENTIONS BY CENTRAL GOVERNMENT

99

Meaning of use of invention for purposes of Government

(1) For the purposes of this Chapter, an invention is said to be used for the purposes of Government if it is made, used, exercised or vended for the purposes of the Central Government, a State Government or a Government undertaking.

(2) [Omitted by the Patents (Amendment) Act, 2002]

(3) Nothing contained in this Chapter shall apply in respect of any such importation, making or using of any machine, apparatus or other article or of any such using of any process or of any such importation, using or distribution of any medicine or drug, as may be made by virtue of one or more of the conditions specified in section 47.

Explanation:

Section 99-103 helps us to understand that how the government can use the inventions for its own purposes and how it compensates you for the usage and acquisition of your invention. As per Section 99, the Government refers to Central Government, State Government or a Government Undertaking. The rules in this section do not apply to the import, creation or use of any equipment, process or the import, use or sharing of any medicine or drug that is allowed under the special conditions listed in Section 47 of this law.

100

Power of Central Government to use inventions for purposes of Government

(1) Notwithstanding anything contained in this Act, at any time after an application for a patent has been filed at the patent office or a patent has been granted, the Central Government and any person authorised in writing by it, may use the invention for the purposes of Government in accordance with the provisions of this Chapter.

(2) Where an invention has, before the priority date of the relevant claim of the complete specification, been duly recorded in a document, or tested or tried, by or on behalf of the Government or a Government undertaking, otherwise than in consequence of the communication of the invention directly or indirectly by the patentee or by a person from whom he derives title, any use of the invention by the Central Government or any person authorised in writing by it for the purposes of Government may be made free of any royalty or other remuneration to the patentee.

(3) If and so far as the invention has not been so recorded or tried or tested as aforesaid, any use of the invention made by the Central Government or any person authorised by it under sub-section (1), at any time after grant of the patent or in consequence of any such communication as aforesaid, shall be made upon terms as may be agreed upon either before or after the use, between the Central Government or any person authorised undersub-section (1) and the patentee, or, as may in default of agreement be determined by the High Court on a reference under section 103: Provided that in case of any such use of any patent, the patentee shall be paid not more than adequate remuneration in the circumstances of each case, taking into account the economic value of the use of the patent.

(4) The authorisation by the Central Government in respect of an invention may be given under this section, either before or after the patent is granted and either before or after the acts in respect of which such authorisation is given or done, and may be given to any person whether or not he is authorised directly or indirectly by the applicant or the patentee to make, use, exercise or vend the invention or import the machine, apparatus or other article or medicine or drug covered by such patent.

(5) Where an invention has been used by or with the authority of the Central Government for the purposes of Government under this section, then, except in case of national emergency or other circumstances of extreme urgency or for noncommercial use, the Government shall notify the patentee as soon as practicable of the fact and furnish him with such information as to the extent of the use of the invention as he may, from time to time, reasonably require; and where the invention has been used for the purposes of a Government undertaking, the Central Government may call for such information as may be necessary for this purpose from such undertaking.

(6) The right to make, use, exercise and vend an invention for the purposes of Government under sub-section (1) shall include the right to sell on noncommercial basis, the goods have been made in exercise of that right, and a purchaser of goods so sold, and a person claiming through him, shall have the power to deal with the goods as if the Central Government or the person authorised under sub-section (1) were the patentee of the invention.

(7) Where in respect of a patent which has been the subject of an authorisation under this section, there is an exclusive licensee as is referred to in sub-section (3) of section 101, or where such patent has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention (including payments by way of minimum royalty), the notice directed to be given under sub-section (5) shall also be given to such exclusive licensee or assignor, as the case may be, and the reference to the patentee in sub-section (3) shall be deemed to include a reference to such assignor or exclusive licensee.

Explanation:

As per Section 100.1, the invention can be used at an application phase or after a patent has been granted on an invention by the government or any person authorised in writing by the government.

As per Section 100.2, if the government or a government-run company has already documented, tested, or tried the invention before the claim's priority date without learning about it from the patent owner or their predecessor, the government can use it without paying the patent owner.

If the invention hasn't been recorded or tested as mentioned above, any government use after the patent is granted must be on agreed terms with the patent owner, or, if they can't agree, terms set by the High Court. However, the payment to the patent owner should be fair and consider the invention's economic value.

As per Section 100.4, the government can authorize the use of an invention before or after a patent is granted, and it can extend this authorization to anyone, regardless of whether the concerned is connected to the patent applicant or owner.

As per Section 100.5, the government is required to inform the patentee as soon as possible about the extent to which the invention is being used, except In case of national emergency, extreme urgency and non commercial use, the government can take little longer to inform the patentee.In case the invention is used by a Government undertaking, then the government may request government undertaking to provide such information from time to time.

As per Section 100.6, the government has right to sell patented goods on non-commercial basis. The buyers of such patented goods have no restrictions imposed on them, they are free to use the goods as if they have bought the goods from patentee itself.

In case the patent has been licensed or assigned to some other party. In such cases, the government provides such information to the licensee or the assignor about the usage of the Invention as per Section 100.7.

101

Rights of third parties in respect of use of invention for purposes of Government

(1) In relation to any use of a patented invention, or an invention in respect of which an application for a patent is pending, made for the purposes of Government :

(a) by the Central Government or any person authorised by the Central Government under section 100; or

(b) by the patentee or applicant for the patent to the order made by the Central Government, the provisions of any licence, assignment or agreement granted or made, between the patentee or applicant for the patent (or any person who derives title for him or from whom he derives title) and any person other then the Central Government shall be of no effect so far as those provisions—

(i) restrict or regulate the use for the purposes of Government of the invention, or of any model document or information relating thereto, or

(ii) provide for the making of payments in respect of any use of the invention or of the model, document or information relating thereto for the purposes of Government , and the reproduction or publication of any model or document in connection with the said use for the purposes of Government shall not be deemed to be an infringement of any copyright subsisting in the model or document.

(2) Where the patent, or the right to apply for or obtain the patent, has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention then, in relation to any use of the invention made for the purposes of Government by the patentee to the order of the Central Government, sub-section (3) of section 100 shall have effect as if that use were made by virtue of an authority given under that section; and use of the invention for the purposes of Government by virtue of sub-section (3) of that section shall have effect as if the reference to the patentee included a reference to the assignor of the patent, and any sum payable by virtue of that sub-section shall be divided between the patentee and the assignor in such proportion as may be agreed upon between them or as may in default of agreement be determined by the High Court on a reference under section 103.

(3) Where by virtue of sub-section (3) of section 100, payments are required to be made by the Central Government or persons authorised under sub-section (1) of that section in respect of the use of an invention for the purposes of Government and where in respect of such patent there is an exclusive licensee authorised under his licence to use the invention for the purposes of Government, such sum shall be shared by the patentee and such licensee in such

proportions, if any, as may be agreed upon between them or as may in default of agreement be determined by the High Court on a reference under section 103 to be just, having regard to any expenditure incurred by the licensee—

(a) in developing the said invention; or

(b) in making payments to the patentees other than royalties or other benefits determined by reference to the use of the invention in consideration of the licence.

Explanation:

This Section explains about what happens to the rights of third parties (in case the patentee has licenced/assigned his invention to the third party) when the government starts using the inventions.

Section 101.1 states that any clauses or provisions which are part of these licences/ assignments or agreements between the patentee and the third party will have no impact on the government. Any Clauses or provisions cannot restrict the usage of the invention by the government. No such clauses or provisions can force the government to make payments for the usage of the invention or the model document or the information related to the invention. Any reproduction of the information related to the invention by the government will not be considered as a copyright infringement.

As per Section 101.2, when a patentee has been assigned a right by an original assignor, the compensation coming out from the original usage can be or may be distributed among the assignor or/and the patentee as per their mutually agreed upon terms and conditions or the terms determined by the High Court.

As per Section 101.3, In case of an exclusive licensee, who has been ordered or requested by the government to use an invention will also be paid compensation by the government for the usage of the invention. The compensation is paid based on the expenses the licensee has incurred for the working of the invention or based on the royalty the exclusive licensee is paying to the patentee.

102

Acquisition of inventions and patents by the Central Government

(1) The Central Government may, if satisfied that it is necessary that an invention which is the subject of an application for a patent or a patent should be acquired from the applicant or the patentee for a public purpose, publish a notification to that effect in the Official Gazette, and thereupon the invention or patent and all rights in respect of the invention or patent shall, by force of this section, stand transferred to and be vested in the Central Government.

(2) Notice of the acquisition shall be given to the applicant, and, where a patent has been granted, to the patentee and other persons, if any, appearing in the register as having an interest in the patent.

(3) The Central Government shall pay to the applicant, or, as the case may be, the patentee and other persons appearing on the register as having an interest in the patent such compensation as may be agreed upon between the Central Government and the applicant, or the patentee and other persons; or, as may, in default of agreement, be determined by the High Court on a reference under section 103 to be just having regard to the expenditure incurred in connection with the invention and, in the case of a patent, the term thereof, the period during which and the manner in which it has already been worked (including the profits made during such period by the patentee or by his licensee whether exclusive or otherwise) and other relevant factors.

Explanation:
Section 102.1 states that the Indian Central Government may own the invention (any invention which is in the patent process or granted) if it believes that the invention is necessary for the public good and the same will be announced in the Official Gazette. As soon as they do that, the government automatically owns the invention or patent and all related rights.
As per Section 102.2, the government must inform the person who applied for the patent, the person who owns the patent (if one has been granted), and anyone else listed as having an interest in the patent.
The government has to pay the patent applicant or owner, and anyone else with an interest in the patent, a fair amount of money. This amount is either what the government and the parties agree on, or, if they can't agree, what the High Court decides is fair. The High Court will consider how much money was spent on developing the invention, the length of the patent, how long and in what way the patent has been used (including profits made during that time by the patent owner or their licensees), and other important factors.

103

Reference to High Court of disputes as to use for purposes of Government

(1) Any dispute as to the exercise by the Central Government or a person authorised by it of the powers conferred by section 100, or as to terms for the use of an invention for the purposes of Government thereunder or as to the right of any person to receive any part of a payment made in pursuance of sub-section (3) of that section or as to the amount of compensation payable for the acquisition of an invention or a patent under section 102, may be referred to the High Court by either party to the dispute in such manner as may be prescribed by the rules of the High Court.
(2) In any proceedings under this section to which the Central Government is a party, the Central Government may,— (a) if the patentee is a party to the proceedings, petition by way of counter-claim for revocation of the patent on any ground upon which a patent may be revoked under section 64; and (b) whether a patentee is or is not a party to the proceedings, put in issue the validity of the patent without petitioning for its revocation.
(3) If in such proceedings as aforesaid any question arises whether an invention has been recorded, tested or tried as is mentioned in section 100, and the disclosure of any document regarding the invention, or of any evidence of the test or trial thereof, would, in the opinion of the Central Government, be prejudicial to the public interest, the disclosure may be made confidentially to the advocate of the other party or to an independent expert mutually agreed upon.
(4) In determining under this section any dispute between the Central Government and any person as to terms for the use of an invention for the purposes of Government, the High Court shall have regard to any benefit or compensation which that person or any person from whom he derives title, may have received, or may be entitled to receive, directly or indirectly in respect of the use of the invention in question for the purposes of Government.
(5) In any proceedings under this section, the High Court may at any time order the whole proceedings or any question or issue of fact arising therein to be referred to an official referee, commissioner or an arbitrator on such terms as the High Court may direct, and references to the High Court in the foregoing provisions of this section shall be construed accordingly.

(6) Where the invention claimed in a patent was made by a person who at the time it was made was in the service of the Central Government or of a State Government or was an employee of a Government undertaking and the subject-matter of the invention is certified by the relevant Government or the principal officer of the Government undertaking to be connected with the work done in the course of the normal duties of the Government servant or employee of the Government undertaking, then, notwithstanding anything contained in this section, any dispute of the nature referred to in sub-section (1) relating to the invention shall be disposed of by the Central Government conformably to the provisions of this section so far as may be applicable, but before doing so the Central Government shall give an opportunity to the patentee and such other parties as it considers have an interest in the matter to be heard.

Explanation:

As per Section 103.1, the parties can approach High Court to resolve a dispute arising from the usage of the invention or the amount of compensation paid by the Central Government. The disputes can be related to the execution of the Invention by the Government (as per Section 100) or conflict in terms of use of an invention. There could be a dispute with regard to the rights of a person in receiving the compensation or the amount of the compensation that is to be paid by the government to the other party.

As per Section 103.2, the Central Government can file counter claim for the revocation of the patent (as per Section 64). If not that, the Central government may question the validity of few of the claims without moving forward for the revocation.

As per Section 103.3, the government will not pay any compensation for the invention in case the invention was known to the government before the priority date of the claims. To prove this, the government is required to provide the proof of evidence of the test or any trial conducted regarding the invention before the priority date of the claims. There could be a scenario where the government may not provide the evidence in the public. In such cases, the confidential disclosure with regard to the invention is done to the advocate or an expert.

When deciding on the terms for the government to use an invention, the High Court will consider any benefits or compensation the person or their predecessors have received or are entitled to receive, in connection with the government's use of the invention.

As per Section 103.5, the High Court may at any time order the whole proceedings or any question or issue of fact arising therein to be referred to an official referee, commissioner or an arbitrator.

Section 103.6 states that in case the invention claimed in a patent was made by an inventor who was a government employee (Central government, State Government or government undertaking) and the subject matter of the invention relates to the work that the inventor did while he was the employee of the government, then the Central Government has the power to dispose of the disputes on its own by providing an opportunity to be heard to the other party.

Chapter 18
SUITS CONCERNING INFRINGEMENT OF PATENTS

104

Jurisdiction

No suit for a declaration under section 105 or for any relief under section 106 or for infringement of a patent shall be instituted in any court inferior to a district court having jurisdiction to try the suit: Provided that where a counter-claim for revocation of the patent is made by the defendant, the suit, along with the counter-claim, shall be transferred to the High Court for decision.

Explanation:

A legal action to get an official statement about how a patent should be interpreted (Section 105), to ask for a specific remedy related to a patent (Section 106), or to claim that someone is using your patent without permission (patent infringement) cannot be initiated in any court that is lower than a district court.

However, if the counter-claim for revocation is made by the defendant, then the original lawsuit and their counter-claim will both be moved to the High Court, to be decided.

104A

Burden of proof in case of suits concerning infringement

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

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

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

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

Explanation:

In case of patent infringement, the burden of proof lies with the plaintiff (patentee, in this case). The plaintiff needs to match the feature of the product with the elements of the claim.

In case of a patented process, in which an identical product is manufactured, there could be a scenario where the plaintiff or the patentee is not able to identify the process used by the defendant, but the product is similar. In such cases, the burden of proof gets shifted on the defendant. Now, the defendant needs to prove that there is no infringement which is happening. The court will not require him to disclose any manufacturing or commercial secrets associated with the invention.

105

Power of court to make declaration as to non-infringement

(1) Notwithstanding anything contained in section 34 of the Specific Relief Act, 1963 (47 of 1963), any person may institute a suit for a declaration that the use by him of any process, or the making, use or sale of any article by him does not,or would not, constitute an infringement of a claim of a patent against the patentee or the holder of an exclusive licence under the patent, notwithstanding that no assertion to the contrary has been made by the patentee or the licensee,if it is shown

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

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

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

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

(4) A suit for a declaration may be brought by virtue of this section at any time after the publication of grant of a patent, and references in this section to the patentee shall be construed accordingly.

Explanation:

As per Section 105.1, a person(plaintiff) can approach a court with a request to issue a declaration that the activities as performed by a person do not constitute an infringement of a claim of a patent. There are some requirements which are required to be met before approaching the court. The person should have approached the patentee or the exclusive licensee to issue a declaration by providing all the necessary documents and all the relevant information of the work done by the person. In case the patentee or the exclusive licensee refuses or ignores the person's request to issue a declaration, then the person can approach a court to issue a declaration.

As per Section 105.2, the cost of all parties in a suit will be paid by the plaintiff (the person who is seeking a declaration).

Section 105.3 states that validity of claim will not be discussed and declaration will not imply validity or invalidity of any claim.

As per Section 105.4, declaration suit can be filed anytime after the grant of the patent.

106

Power of court to grant relief in cases of groundless threats of infringement proceedings

(1) Where any person (whether entitled to or interested in a patent or an application for patent or not) threatens any other person by circulars or advertisements or by communications, oral or in writing addressed to that or any other person, with proceedings for infringement of a patent, any person aggrieved thereby may bring a suit against him praying for the following reliefs, that is to say—

(a) a declaration to the effect that the threats are unjustifiable;

(b) an injunction against the continuance of the threats; and

(c) such damages, if any, as he has sustained thereby.

(2) Unless in such suit the defendant proves that the acts in respect of which the proceedings were threatened constitute or, if done, would constitute, an infringement of a patent or of rights arising from the publication of a complete specification in respect of a claim of the specification not shown by the plaintiff to be invalid the court may grant to the plaintiff all or any of the reliefs prayed for.

Explanation. —A mere notification of the existence of a patent does not constitute a threat of proceeding within the meaning of this section.

Explanation:

The patentee might be very aggressive in terms of the patent rights. The patentee will be issuing circulars, advertisements or communications to players in the market working on the same technology stating that their activities infringe the patent rights and continued use of the activities and continued use of such activities will force the patentee to initiate infringement proceedings against them. As a market player, the person receiving the communications from patentee will get threatened by such statement's issues by the patentee.

As per Section 106.1, the person can approach a court with a request to issue a declaration that such threats are unjustifiable. The person may also request a court to put an end to such threats by requesting the court to pass an injunction order to put an end to such threats. The person may also seek damages, if any.

As per Section 106.2, unless the patentee/defendant proves the infringement or plaintiff proves the claims invalid, then such a declaration will not be passed on by the court.

Mere notification of an existence of a patent will not be considered as a threat.

107

Defences, etc., in suits for infringement

(1) In any suit for infringement of a patent every ground on which it may be revoked under section 64 shall be available as a ground for defence.

(2) In any suit for infringement of a patent by the making, using or importation of any machine, apparatus of other article or by the using of any process or by the importation, use or distribution or any medicine or drug, it shall be a ground for defence that such making, using, importation or distribution is in accordance with any one or more of the conditions specified in section 47.

Explanation:

Consider a case where a patent infringement suit has been instituted by a patentee. The grounds of revocation (as per Section 64) can be used as a grounds of defence. Another alternate is that we demonstrate the difference between our product/process and the existing patent. If there are substantial differences, then there is no infringement.

107A

Certain acts not to be considered as infringement

For the purposes of this Act,—

(a) any act of making, constructing, using, selling or importing a patented invention solely for uses reasonably related to the development and submission of information required under any law for the time being in force, in India, or in a country other than India, that regulates the manufacture, construction, use, sale or import of any product;

(b) importation of patented products by any person from a person who is duly authorised under the law to produce and sell or distribute the product, shall not be considered as a infringement of patent rights.

Explanation:
If the usage of the patented invention is solely for the purpose of development and submission of information, then it is not an infringement.

108

Reliefs in suit for infringement

(1) The reliefs which a court may grant in any suit for infringement include an injunction (subject to such terms, if any, as the court thinks fit) and, at the option of the plaintiff, either damages or an account of profits.
(2) The court may also order that the goods which are found to be infringing and materials and implements, the predominant use of which is in the creation of infringing goods shall be seized, forfeited or destroyed, as the court deems fit under the circumstances of the case without payment of any compensation.

Explanation:
This section allows both preventive measures (injunctions) and compensatory/penal measures (damages, account of profits, destruction of infringing goods) to ensure that patent rights are effectively enforced.
As per Section 108.1, a court can issue an injunction restraining the infringer from continuing the act of infringement. This may be temporary (interim) or permanent. At the plaintiff's choice, a monetary compensation for the loss suffered by the patent holder. Instead of damages, the court may direct the infringer to hand over the profits earned through infringement.
As per Section 108.2, the court may also order infringing goods, as well as materials and implements used primarily for producing such goods, to be:

- Seized (taken into custody),
- Forfeited (ownership transferred/lost), or
- Destroyed, without requiring the plaintiff to compensate the defendant.

109

Right of exclusive licensee to take proceedings against infringement

(1) The holder of an exclusive licence shall have the like right as the patentee to institute a suit in respect of any infringement of the patent committed after the date of the licence, and in awarding damages or an account of profits or granting any other relief in any such suit the court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such or, as the case may be, the profits earned by means of the infringement so far as it constitutes an infringement of the rights of the exclusive licensee as such.
(2) In any suit for infringement of a patent by the holder of an exclusive licence under subsection (1), the patentee shall, unless he has joined as a plaintiff in the suit, be added as a defendant, but a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

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Right of licensee under section 84 to take proceedings against infringement

Any person to whom a licence has been granted under section 84 shall be entitled to call upon the patentee to take proceedings to prevent any infringement of the patent, and, if the patentee refuses or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as though he were the patentee, making the patentee a defendant; but a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

Explanation (Section 109 & Section 110):
A suit of infringement is filed within 3 years from the date of Infringement. Who all can file the suit of Infringement:

- Patentee
- Exclusive Licensee (under Section 109, the exclusive licensee enjoys like rights as that of a patentee. The Exclusive licensee is considered as a patentee when granting relief)
- Compulsory licensee (under Section 110, the Compulsory licensee can also file a suit of infringement, but the compulsory licensee has to inform the original patentee first to take action. In case the patentee refuses or ignores the request, then the compulsory licensee can initiate an action.)

If the Patentee does not join the case as a plaintiff as per the scenarios mentioned in Section 109 & Section 110, then the patentee gets added as a defendant (Section 109(2) & Section 110). The patentee is not liable for any cost in case he doesn't make any appearances or does not participate in the proceedings at all.

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Restriction on power of court to grant damages or account of profits for infringement

(1) In a suit for infringement of patent, damages or an account of profits shall not be granted against the defendant who proves that at the date of the infringement he was not aware and had no reasonable grounds for believing that the patent existed.

Explanation.—A person shall not be deemed to have been aware or to have had reasonable grounds for believing that a patent exists by reason only of the application to an article of the word "patent", "patented" or any word or words expressing or implying that a patent has been obtained for the article, unless the number of the patent accompanies the word or words in question.

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

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

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

Explanation:
A defendant won't be liable for damages or account of profits if they prove that, at the time of infringement, he did not knew about the existence of the patent, and the defendant had no reasonable grounds to believe the patent existed. Merely marking an article with "patent"/ "patented"/similar words does not count as knowledge, unless the patent number is also displayed.

If the patentee fails to pay the renewal fee and the patent lapses, then, for infringement occurring between lapse and later extension, the court may refuse to award damages/account of profits.

If the patent specification is amended (disclaimer, correction, explanation) after publication, then no damages/account of profits are awarded for infringements before the amendment decision unless the court is convinced that the original specification was made in good faith and with reasonable skill and knowledge. As per subsection 4, the Injunction is still Available, even if damages/account of profits are restricted under the above rules and the court still retains the power to grant an injunction against infringement.

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Restriction on power of court to grant injunction in certain cases
[Omitted by the Patents (Amendment) Act, 2002]

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Certificate of validity of specification and costs of subsequent suits for infringement thereof

(1) If in any proceedings before the Appellate Board or a High Court for the revocation of a patent under section 64 and section 104, as the case may be, the validity of any claim of a specification is contested and that claim is found by the Appellate Board or the High Court to be valid, the Appellate Board or the High Court may certify that the validity of that claim was contested in those proceedings and was upheld.

(2) Where any such certificate has been granted, then, if in any subsequent suit before a court for infringement of that claim of the patent or in any subsequent proceeding for revocation of the patent in so far as it relates to that claim, the patentee or other person relying on the validity of the claim obtains a final order or judgment in his favour, he shall be entitled to an order for the payment of his full costs, charges and expenses of and incidental to any such suit or proceeding properly incurred so far as they concern the claim in respect of which the certificate was granted, unless the court trying the suit or proceeding otherwise directs: Provided that the costs as specific in this sub-section shall not be ordered when the party disputing the validity of the claim satisfies the court that he was not aware of the grant of the certificate when he raised the dispute and withdrew forthwith such defence when he became aware of such a certificate.

(3) Nothing contained in this section shall be construed as authorising the courts or the Appellate Board hearing appeals from decrees or orders in suits for infringement or petitions for revocation, as the case may be, to pass orders for costs on the scale referred to therein.

Explanation:

If, in revocation proceedings under Section 64 (revocation) or Section 104 (counterclaim in infringement suit), a claim of a patent is contested and the High Court finds it valid, then the court/board may issue a certificate stating that the validity of the claim was contested and upheld. In any later suit for infringement or subsequent revocation proceeding relating to that same claim, If the patentee wins, he is entitled to full costs, charges, and expenses relating to that claim. The opposing party can avoid these costs if they show that they were not aware of the earlier certificate, and they withdrew the challenge immediately once they became aware of it.

This section does not authorize courts/boards in appeal proceedings to grant costs at the enhanced scale just because of such a certificate. The special cost rule applies only to later fresh proceedings (not appeals of the original case).

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Relief for infringement of partially valid specification

(1) If in proceedings for infringement of a patent it is found that any claim of the specification, being a claim in respect of which infringement is alleged, is valid, but that any other claim is invalid, the court may grant relief in respect of any valid claim which is infringed: Provided that the court shall not grant relief except by way of injunction save in the circumstances mentioned in sub-section (2).

(2) Where the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the court shall grant relief in respect of any valid claim which is infringed subject to the discretion of the court as to costs and as to the date from which damages or an account of profits should be reckoned, and in exercising such discretion the court may take into consideration the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there.

Explanation:
As per subsection 1, If, during a lawsuit for patent infringement, it is found that some parts of the patent (claims) are valid and others are not, the court may decide to provide remedies for the part of valid claim which is infringed. However, the court will generally only order the infringer to stop (an injunction) unless certain conditions in the next section are met.
As per Subsection 2, If the patent owner can show that the invalid parts of the patent were included honestly and with reasonable effort and knowledge, then the court can still provide remedies for the parts that were infringed. The court has the freedom to decide if the patent owner should pay the legal costs and from what date they should be compensated for the infringement (damages or profits). The court will also consider the parties conduct regarding the invalid parts of the patent when making these decisions.

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Scientific advisers

(1) In any suit for infringement or in any proceeding before a court under this Act, the court may at any time, and whether or not an application has been made by any party for that purpose, appoint an independent scientific adviser, to assist the court or to inquire and report upon any such question of fact or of opinion (not involving a question of interpretation of law) as it may formulate for the purpose.
(2) The remuneration of the scientific adviser shall be fixed by the court and shall include the costs of making a report and a proper daily fee for any day on which the scientific adviser may be required to attend before the court, and such remuneration shall be defrayed out of moneys provided by Parliament by law for the purpose.

Explanation:
Patent Suits are techno-legal in nature. While going over these patent suits, the courts on their own or on the request of parties assign a scientific advisor to assist the court in any enquiry or opinion that the court may need from the Scientific Advisor. The appointment of Scientific Advisors is done under Section 115. The remuneration of the Scientific adviser is decided by the court which includes all the expenses incurred related to th e making of a report.

Notes

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