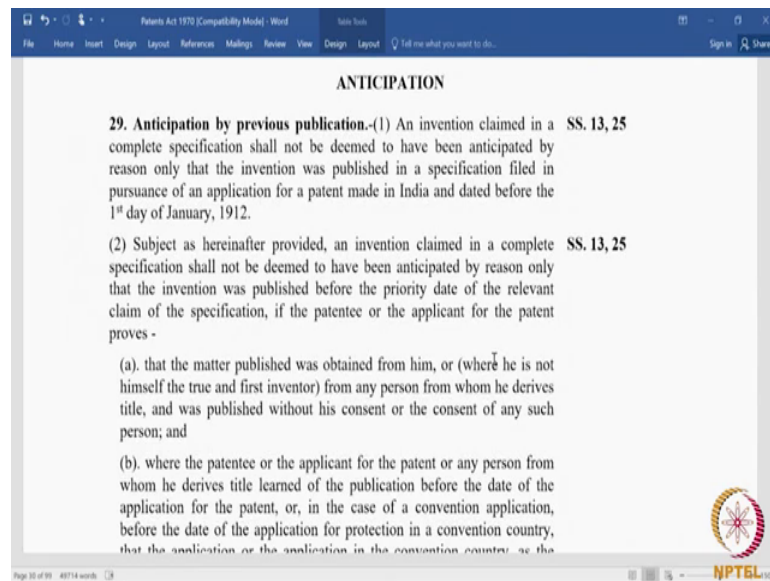


**Patent Law for Engineers and Scientists**  
**Prof. Feroz Ali**  
**Department of Management**  
**Indian Institute of Technology, Madras**

**Lecture – 10**  
**Patentability of Inventions**  
**Anticipation**

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Chapter 6 of the Patents Act deals with anticipation. Chapter 6 starts with section 29 and it goes all the way till section 34, so 29 to 34 deals with anticipation. 29 to 34 deals with instances which are excluded from anticipation and we understand anticipation as a situation where an invention is covered by the prior art, an invention as claimed in the complete specification has been already disclosed or covered in the prior art. Now in the prior art it could be by prior publication, it could be by prior claiming, it could be by prior knowledge, it could be by prior use, it could also will be by prior disclosure in a local community what we call by anticipation by traditional knowledge.

So, anticipation has different categories largely they fall into four categories; anticipation by prior publication before the date of priority of the matter claimed was disclosed; so that is what we call anticipation by publication. The second category is anticipation by prior claiming; a claim in a specification anticipated the invention though they claim

would have been published later on. Now this will cover instances where one application which is still in the dormant phase in the 18 month unpublished phase; anticipates another application which comes later on. So, there we look at prior claiming because in patent law there is this 18 month unpublished period and they could be anticipation of one invention that can happen during that period. So, prior claiming covers instances relating to anticipation by an unpublished application, so that is the second part.

The first is anticipation by prior publication, the second type of anticipation is anticipation by prior claiming. In claiming we are trying to map one claim with an earlier claim of an patent application. The third category is anticipation by public use or public knowledge, you can say it prior use or prior knowledge; there you can use these words interchangeably. So, this is a type of anticipation here it need not be a case of comparing documents; in the first two cases trial publication and prior claiming anticipation is can be proved by comparing documents, but when it involves prior use and prior knowledge or public use and public knowledge in India; then it can be done by taking or letting in evidence.

So, it need not be a mapping of documents which is a normal way in which anticipation is proved; that is the third category anticipation by public use or public knowledge, the words used in section 25; 1 and 2 are a publicly known or publicly used in India. The fourth category is anticipation by traditional knowledge, the knowledge that was with a local or a traditional community anticipated the invention; these are the four categories of anticipation mentioned under the Act.

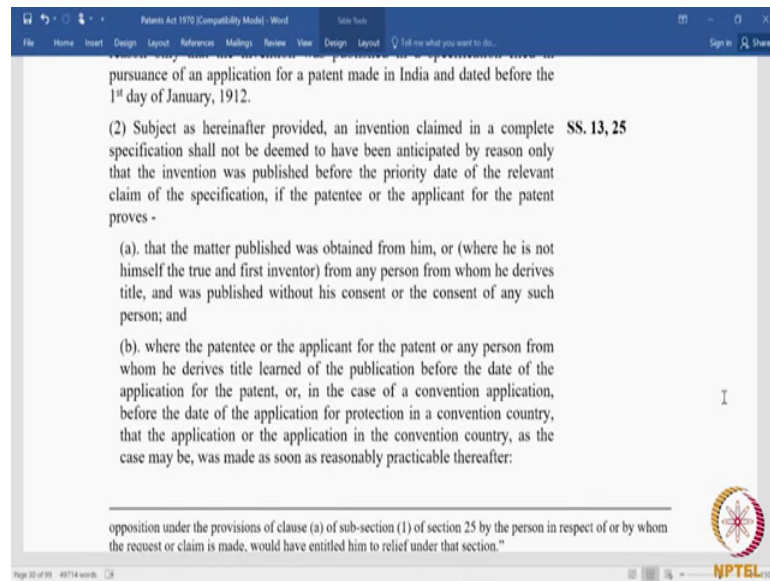
29 talks about anticipation by previous publication the first category and it tells us about instances where certain cases will not be treated as anticipation 29; 1 and invention claim in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published in a specification filed in pursuance of an application made in India; dated before the 1st day of January, 1912. So, we had already mentioned the date 1st January, 1912 is significant because that is the day the 1911, Act came into being. The 1911, Act was the Act that preceded the 1970, Act; the 1911, Act was called the Indian patents and designs act 1911 and the 1911, Act came into effect on 1st January 1912.

So, the Indian patent office has been receiving application since 1912; this is under the system that was established by the British. So, an invention shall claimed in a specification shall not be deemed to have been anticipated by reason only that the invention was published in a specification file in pursuance of an application for a patent made in India and dated before 1st Jan, 1912. Before first Jan, 1912 we did not have a formal patent system, but still we had certain executive privileges granted by the British government.

So, and there is similar to a patent you could make an application and the British government would grant a patent. So, if there were any disclosures made in an application; made in India and dated before 1912, then that would not amount to anticipation because we are excluding documents before 1912 for the simple fact that the patent office was not functioning at that point. So, this is a redundant provision because today there is no protection offered, we did not even compare cases where documents were published or look into documents that were published before 1912; 29; 2.

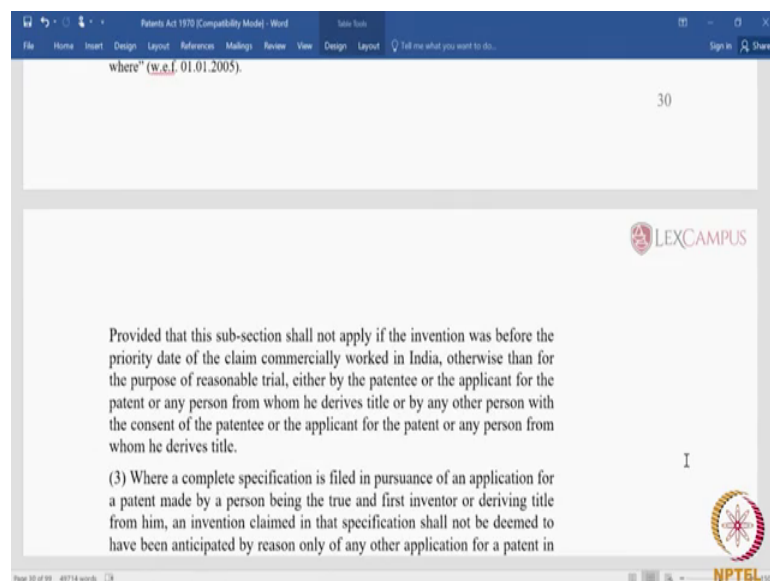
Subject as hereinafter provided, an invention claimed in a complete specification shall not be deemed to have been anticipated; again an exception to anticipation by reason only that the invention was published before the priority date of the relevant claim, if the patentee of the applicant for the patent proves; that the matter published was obtained from him or where he is not the true and first inventor; from any person whom he derives title, and was published without consent or the consent of any such person.

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B, where the patentee or the applicant for the patent or any person from whom he derives title of the publication before the date of the application or in case of a convention application, before the date of the application for protection in a convention country, that the application or the application in the convention country, as a case may be, was made as soon as reasonably practicable thereafter.

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Provided that the sub-section shall not apply if the invention was before the priority date of the claim commercially worked in India, otherwise than for purposes of reasonable trial, either by the patentee or by a person who derives title with the consent of the patentee or the applicant for the patent or any person from whom he derives title.

Now, in short this means that disclosures made before the priority date, an invention that is disclosed before the priority date which was done without the consent of the patentee or the applicant will not amount to anticipation. For instance, there are a group of scientist who worked for an organisation and the scientist have; are bound by a non disclosure agreement within that organisation by which all of them are not supposed to disclose the invention without the consent of the organisation.

Now if one of the scientist disclosures or publishes the matter without the consent of the organisation, then that matter which was published cannot be used as anticipation because it was done without the consent of the owner. The owner try to keep it safe, there was an agreement binding the people to whom it was disclosed, the person who was under in agreement breached that agreement and put it in the public domain or disclose it.

So, any disclosure that happens before the date of priority for which the patentee or the applicant had not given consent; will not amount to anticipation. So, this is a way in which the interest of the applicant is protected. Now consent is one part of this scheme, the disclosure to the public, the publication before the priority date should have happened without the consent of the patentee or the applicant. So, he has to prove that the matter was published was obtained from him or from another person whose with whom he had an arrangement and was published without the consent. So, first he has to prove that the disclosure happened without his consent.

Secondly, which is covered in b, he has to follow it up with an application as soon as possible. So, he came to know about the publication; he did not want the material covered in the disclosure to come into the public domain, but it had come. So, he should quickly file an application in the case, it is an Indian application you should file one or where an application covers a convention country he should make the application as soon

as reasonably practicable; so, this is the second condition.

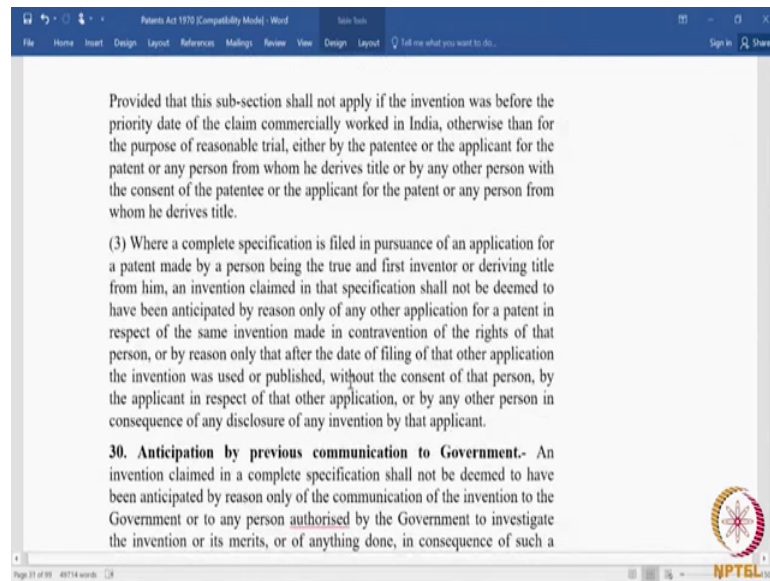
First condition is he says that the disclosure was made without my consent, but soon after he found that about the publication; the disclosure he should move and make an application because this is logical because the only way you can get the benefit of an earlier disclosure is that the moment you found that you are entitled to a grace period, you would operate within that grace period.

Now, this is not similar to antedating because the person will not get an earlier priority, but this is what we call a grace period and here the grace period is not mentioned the grace period is you should make the application as soon as reasonably practicable thereafter. So, you wanted to keep your invention a secret, but somebody disclosed it without your consent; soon after you knew about it maybe you come to know about the publication after few days, weeks or months.

Soon after you came to know about it, you made an application as soon as reasonably practicable. So, the requirement if somebody asks you; what is the grace period under section 29; 2? The grace period can be 12 months from the date of disclosure, 6 months from the date of disclosure as soon as reasonably practicable from the date of disclosure or from the date of publication or another choice or none of the above. Then the correct answer, in a case involving 29; will be the grace period is as soon as reasonably practicable.

You will see in the other cases, the grace period is specifically mentioned as 12 months, but in this case a 12 month may not be meaningful because a person may come to know about the publication after 24 months quite possible. So, in this case what is important is to look at when the publication came to prove that the publication happens without the consent and as soon as knowing the publication, as soon as you get to know that the publication happen; file an application as soon as reasonably practicable. So, 29; 2 deals with the grace period for the only difference is the grace period in 29; 2 is not specified.

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It further continues to say that provided the sub-section shall not apply, if the invention was before the priority date commercially worked in India. Now, if the disclosure or publication or the fact that it came into the public domain by commercially working it in India, then you will not be entitled to claim this anticipation by prior publication, you will not be given that benefit; if it was commercially worked in India because then commercially working in India, you cannot say that the disclosure happened without my consent and at the same time you commercially release the product without a patent application.

So, that is like you are contradicting yourself you say that my rights are being violated, the disclosure; the publication was made without my consent; what is the object of making that? To say that I wanted to preserve the secrecy of my invention, but it was revealed by a third patent without my consent. At the same time you have yourself commercially work the invention, which means a third patent will get to know because we know that public use is covered as a ground for anticipation. So, you were commercially using it, working it then you cannot take this plea that the disclosure happened without my consent because you have any way put it in the public domain.

Unless the commercial working was for reasonable trial, you could work something

commercially, but for reasonable trial. For instance, we are not getting into a discussion on whether this is patentable, but I am just giving you an instance. Say there is a fintech technology for transferring money; from one party to another. This can only be tested by commercial working in the public domain because you want transactions, you want to involve a bank, you want involve people having an app or something.

So, this will definitely come if you want to test it; the reasonable trial will involve third parties and it will involve a much open network of people. So, you can say that yes I commercially worked it, but that was for reasonable trial, you could still claim that exception. But this provision covers commercial working other than for reasonable trial, you really wanted to earn money and you were not doing a beta test; either by the patentee or the applicant from whom we entitle our consent.

So, the exception is you can claim the grace period or you can say that something is not anticipated under 29; 2, provided you prove that the publication happened without your consent and you quickly followed up within patent application, there is no time line given; it is as soon as reasonably practicable. Now, you will not be entitled to 29; 2, if you commercially work the invention because you are contradicting your own stand that somebody else released my invention, when I myself have commercially worked it.

So, commercial working is an act that can kill the novelty of an invention. So, commercial working as per the act tells us that can kill the novelty of an invention, commercial working can anticipate an invention; is it clear? The only exception is if the commercial working was for the purpose of reasonable trial.

29; 3 states that where a complete specification is file in pursuance of an application for a patent made by a person being the true and first inventor or deriving title from him, an invention claimed in that specification shall not be deemed to have been anticipated by reason only of any other application for a patent in respect of the same invention made in contravention of the rights of that person, or by reason only that after the date of filing of the other application the invention was used or published, without the consent of that person, by the applicant in respect of the other application, and by any other person in consequence of any disclosure of any invention by that applicant.



Now, again the long provision but we understand this as where a complete specification is filed in pursuance of an application, made by a person who is entitled to make that application that is a true or first inventor or an assignee or legal representative; shall not be deemed to have been anticipated. So, an application that is filled shall not be anticipating by using only that any other application for a patent in respect of the same invention was made, in contravention of the rights of that person.

29; 3 can be illustrated by an example, assume that application b is filed by a true and first inventor or an assignee or a legal representative, a person who can be entitled to be an applicant under the Act. Application b is filed by a person who is entitled to file that application, an application b covers an invention there has been an earlier application; application a; which covers the same invention but it is not filed by the applicant, somebody else filed it. But the applicant is able to show that application a was filed in contravention of his rights.

His rights were violated and it was filed, some employee took the idea from the office went and filed it; one instance. We had a joint venture saying that we will jointly file it, but the joint venture partner separately went and filed it. So, in contravention of my right an earlier application was filed, I filed application b covering the invention but in contravention of my right, I did not know someone filed an earlier application prior in time that will not amount to anticipation; that is what the section says because the reason being in 9; 2, it was consent here it is contravention of right; contravention of right I did not give consent, I did not ask my joint venture partner to go and file it separately, I never gave my employee a right to take my invention and go and file in application. So, in contravention of the rights of the person or by reason only that after the date of filing of the other application, the invention was used or published without the consent by the applicant in respect of the other application or by any other person in consequence of the invention and disclosure.

So, there are two parts here; first that an earlier application was filed without or violating my rights that is one or by reason; that after the date of filing of the earlier application that is application a, the invention was used or published without the consent of that person; that is the second scenario. So, assume that there is a 10 month gap between

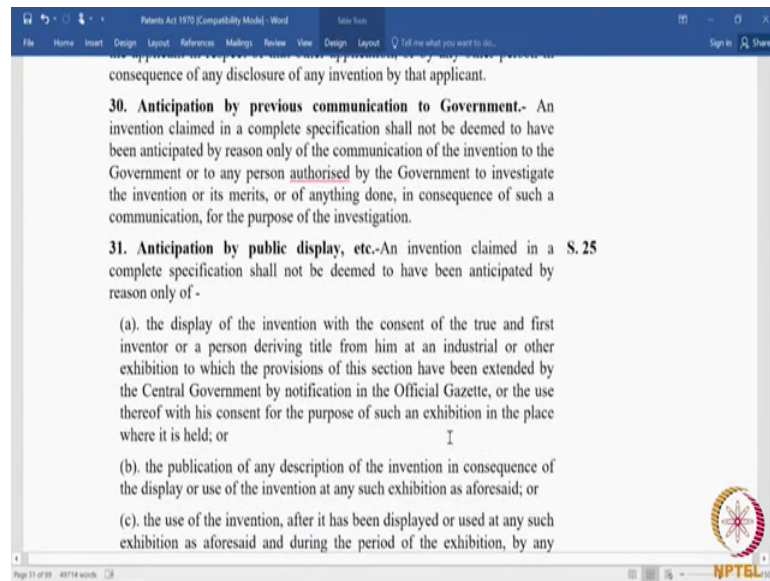
application a and application b. Application b is filed in October and application b is filed by the true and first inventor or the person whose actually entitled to it, let us call him the genuine applicant.

Application b is filed by the genuine applicant application a is filed in January itself, but not by a genuine applicant. So, the first scenario says that if application a is filed in contravention of the rights of an applicant b; who files application b, then the earlier filing will not anticipate the later filing; simple reason it was done in contravention of the rights. The second situation is application a is filed in January, sometime in March or in April; the invention is either used or the application is published without the consent of the person.

So, here is a case that applicant b's application was filed in October, applicant a who countermines the right of applicant b; application a is filed in January, but in March and April there has been a use or a publication. So, for all practical purposes application a's priority is preserved because the publication came in March or in April; after the publication, after the application a was failed, but that will now become prior art or that will now anticipate application b which is filed in October. So, b as long as applicant b can show that was not without my consent, he will get over it; you understand? That publication or use of the invention was without my consent.

So, these things could happen in businesses or competitors could do this; they will file an application and quickly disclose it and later on try to use that as prior to kill the novelty of their competitor's invention. So, in such cases the latter applicant; in this case the applicant b will have to show that the earlier application was made in contravention and the publication was made without his consent. Again, we understand these instances as some form of a wrongful obtainment; this actually covers an instance of invention being wrongfully obtained, somebody filing an application and disclosing a contravening the rights of a genuine applicant.

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Now, we saw we are already mentioned there are four types of anticipation; we saw anticipation by prior publication; what are the exceptions to it? Now, 30 deals with anticipation by previous communication to government; now certain communications are protected, an invention claimed in a complete specification shall not be deemed to have been anticipated which means shall not be considered as anticipation by reason only of communication of that invention to a government or any person authorised by the government to investigate the invention or its merit or anything done in consequence of such a communication for the purpose of the investigation.

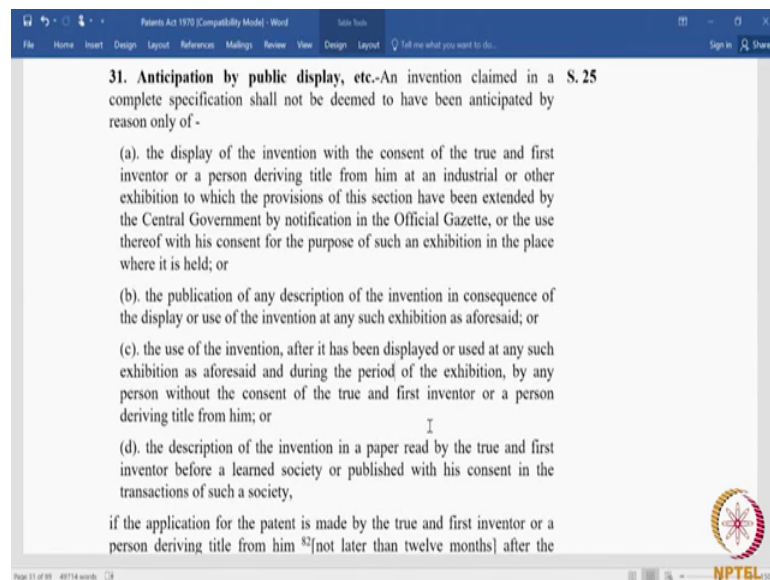
So, any communication to the government to investigate the invention or its merits, will not amount to anticipation. So, you communicate your invention say to a department of the government, they want to know whether the invention has merit so that they can use it and licence it from you; that will not amount the anticipation. Later on, if you file an application that communication cannot be used as a ground for anticipation because if that could be used as a ground for anticipation, nobody will communicate anything to the government.

So, there are many technologies that have been developed by entrepreneurs in India, companies in India and even foreign companies operating in India; they would want the

government to buy a technology which they are developing and they may disclose this to the government much ahead in time. If the government start using that communication of the technology for the purpose of anticipation, people will start dealing with the government. So, this is a protection for the government to look at inventions, at a much earlier stage because of the same government that grants the patent; so, you have to protect communications to the government because I cannot be communicating a particular thing to the government and the government saying that because you communicated to me; now it is in the public domain.

So, this is a protection for communications made to the government. So, any communication made to the government and there is no grace period per se here there is no; it does not say that you should quickly follow it up or anything it is a standing position. If you make a communication to the government later on, you could file an application, communicates to the government provided it is in the right channel will not be used to anticipate your invention; so very simple provision.

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Now, 31 deals with anticipation by public display etcetera; now 29 was anticipation by publication and we have already mentioned anticipation by publication and claiming is proved by comparing documents. Public display is what we call prior knowledge or

public knowledge or public use in India; we say the third category is anticipation by public knowledge or public use in India.

This third category has certain exceptions, if you display certain things or if you use certain things or if people come to know about certain things; still you will be protected by a grace period, here the grace period is mentioned, now we will see what are those protected categories and invention claimed in a complete specification shall not be deemed to be anticipated by reason only of display of the invention with the consent of the true and first inventor or the person deriving title at an industrial or other exhibition.

So, display of the invention at an industrial or other exhibition to which the provisions of the sections had been extended by the central government by notifications. So, the central government by notification in the official gazette has to say that; section 31 applies to this industrial fair or this exhibition, there has to be a notification or use thereof with his consent for the purpose of such an exhibition in the place where it is held.

So, that display has to happen with the consent of the inventor or with the consent of the applicant, let us put it that way; it should happen with the consent of a person who is entitled to apply. Now this covers industrial or other exhibition to which the provisions of that the government extends, central government by notification in official gazette extends the provisions of the section or the use thereof with his consent for the purpose of such an exhibition in the place where it is held.

So, with the person's consent it is used with the person's can for the purpose of such an exhibition. So, it is used for the purpose of such an exhibition in the place where it is held, so this is also covered apart from notification. So, the first thing that is covered is display of the invention, in the latter part use of the invention. So, these two are two different things; display could be non functional display the invention is just displayed or there are charts or there are a posters, it is still a display.

So, display can amount to anticipation depends on the invention and the field of technology. So, display if you have to display your invention then you need a government notification to protect you, so if you are an inventor who wants to go and

display your invention; first thing you will see is whether it is a notified event, if it is not an notified event; you will not get the benefit of this provision.

Display is covered and use is also covered; display of the invention or use thereof for the purpose of such an exhibition in the place where it is held. We can understand this as your technology is being used for the purpose of the exhibition itself. The exhibition involves erection of certain tents and you have a technology where tents can be erected without any pillars or support structures.

Assume that it is used for the purpose of such an exhibition in the place where it is sell, then notification may not be required because the notification is for display; that is one way we can read it or b; the publication of any description of the invention in consequence of the display or use of the invention at any such exhibition as aforesaid. So, we saw display and use in a, in b; it is publication of any description of the invention in the consequence of the display or use.

So, we understand a as a physical display and physical use; b is a written, publication of a written description like what I mentioned as charts and posters. So, charts and posters will come in b, not in a; because in a it deals with the physical display and a physical use or b publication of any description of the invention in consequence of the display and their use. So, there is a display and a use and there are publications along with the display and the use; that is also covered or the use of the invention, after it has been displayed or used at any such exhibition as aforesaid and during the period of the exception by any person without the consent of the true or first inventor.

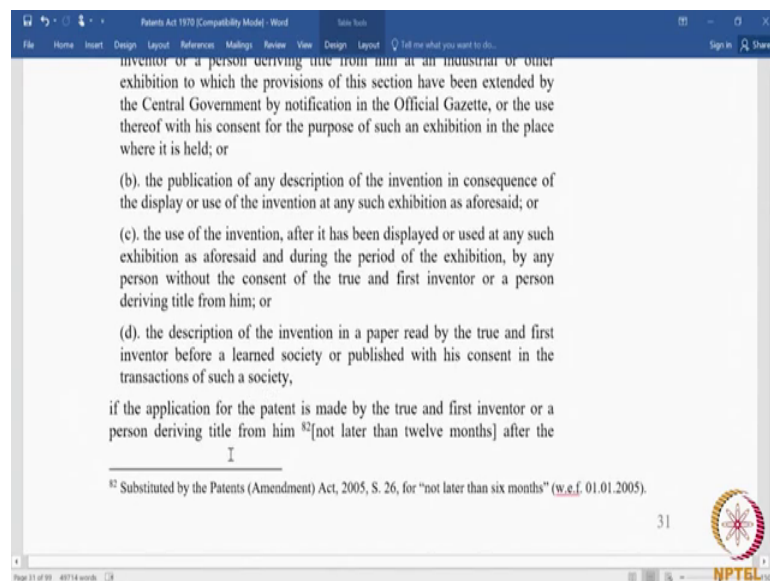
Now there has been a display or a use with the consent that is protected, somebody sees that in the exhibition and he uses the invention without the consent of the inventor. So, first there is already been a display by the authorised person, but someone sees it and uses the invention without the consent of the true and first invented or the person deriving title and then we will say the applicant, without the consent of the applicant; during the period of the exhibition.

Now this has to the third patent using the invention has to happen during the exhibition.

So, a covers display and use by the applicant with his consent, b covers all the publication material which goes with the display or use, c covers use of the invention by a third party without the consent, but within the exhibition. For instance, there is a gadget that is used, it is displayed and used by an applicant. He leaves the gadget and goes off; he is not there in his stall, so to say. Somebody else, now comes and uses the gadget and it is recorded on video and it passes on it gets disseminated. Now that use is without the consent of the applicant even that use is protected, so somebody uses without my consent, but I already used it somebody uses it in an exhibition without my consent is also covered.

Or d the description of an invention in a paper read by the true and first inventor before the learned society or published with his consent in the transactions of such a learned society. A paper; describing the invention read by the true and first inventor, so we are only talking about the inventor here; no assignee or applicant comes here. Inventor describes the invention in a paper which he represents before a learned society; learned society can have various meanings or published with his consent in the transactions of such a society. So, if there is a industrial body or a group of experts like IEEE; an IEEE has a conference. Then, if the inventor presents only presents a paper or he publishes a paper with in the IEEE journal.

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Then this has four instances a, b, c and d; a is display in use, b is publication of material along with the display in use, c is used by a third patent without the consent, d is either oral presentation or publication in the transactions of a learned society; what we call a journal run by a peer review society or industrial organisation. If these four things are there, if the application for the patent is made by the true or first inventor or the person deriving title; the applicant not later than 12 months after the opening of the exhibition or reading or publication of the paper as the case period then it will not amount to anticipation.

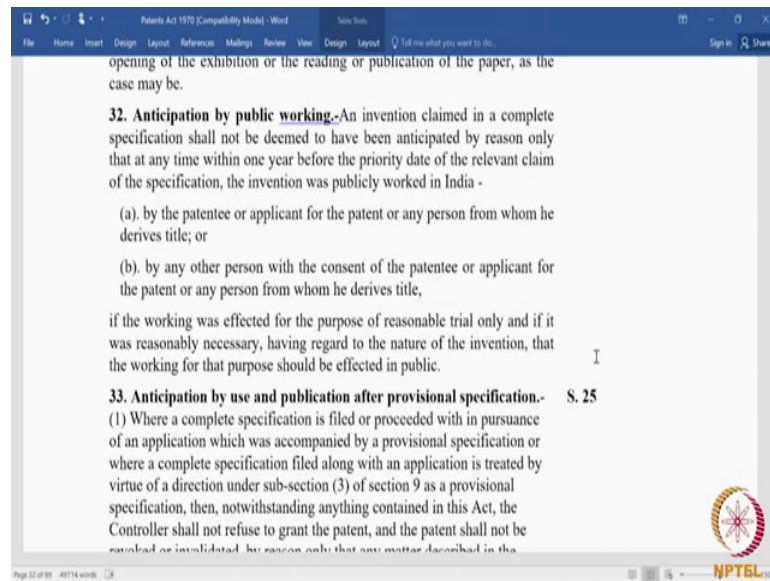
So, we have a grace period which is 12 months from the opening of the exhibition, reading where in clause d where he presents the paper or publication of the paper. If it is done within 12 months, there is no anticipation. So, which means under the Indian law; you could go for an IEEE conference, present your paper in the conference and within 12 months, you could file an application. Now some people have read this provision and said that the government has to notify because the government notification in official gazette, if you read the provisions; it applies only for an exhibition, it is not apply for transactions of a learned society.

In what you saw in a, the exhibition to which the provisions of the section have to be extended by central government by notification in an official gazette; does not apply it is not mentioned; it is only mentioned for exhibition, it is not mentioned for transactions of a learned society. So, journals are not covered by this, but still some people hold that it is better that the government notifies that all peer reviewed journals and all the journals in which people published scientific literature is covered under this provision or even if the patent office can issue a notification that will clarify it.

Because every time US has a grace period, India would also be having that grace period. I would say that India already has that grace period, but it has not been effectively worked; the law states that we have it.



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32; anticipation by public working, an invention claimed in a complete specification shall not be deemed to have been anticipated by reason only at anytime within 1 year before the priority date of the relevant claim, the invention was publicly worked in India by the patentee or the applicant or any person with the consent of the patent or the applicant; if the working was affected for the purpose of reasonable trial only and if it was reasonably necessary having reward to the nature of the invention, that the working for that purpose should be affected in public.

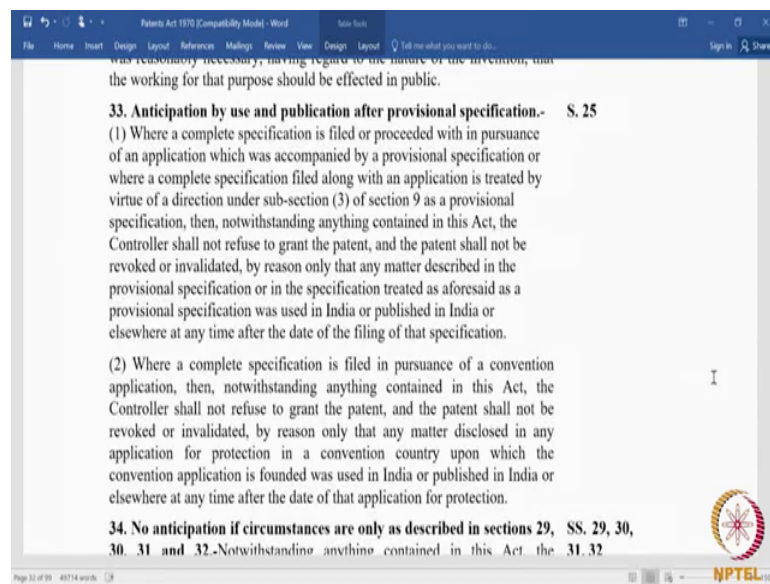
Many instances, now if there is a machine that can drill a tunnel underground; most likely it will be used by the public's work department or the metro or by the highways department; drilling huge holes underground is largely a requirement by these departments and it can only be done in public, there is no way you can drill or huge tunnel in a private property and it is not required also. So, drilling tunnel across mountains, across hills cutting and land and making deep tunnels; the machines that have been used can only be put even for reasonable trial, it can only be tested in a public space.

Similarly, some technology that makes drainages more efficient or water lines more efficient; this can only be tested in a large scale when it can be used in a public setup. So,

the requirement is; again beta testing on the internet, there is a judgement in the Yahoo's case; where they say that beta testing of a software will come under section 32, this is actually a sign saying that this will cover under public working, but public working when the provision was drafted, it is meant for mechanical invention, but it could be extended for other things also.

But, if you have to make the test and the test can only be affected in public; then this provision will apply. So, the requirement is it should be done with the consent of the patentee or the applicant and the working should be for; it should be done the working has to be in India and it should be done for reasonable trial alone and the nature of the invention was such that you could only do it in public say flying of an aircraft or a drone, it can only be done in public; so, things of that nature will be covered by this exception.

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33; anticipation by use and publication after provisional specification, now there are instances and most of the practitioners know that after you file the public provisional, there is no anticipation because the priority is preserved you could disclose the invention after filing a provisional. 33 says; where a complete specification is filed or proceeded with in pursuance of an application which was accompanied by a provisional or where a complete was filed along with an application is treated by virtue of section 9; 3 as a

professional this is what we call downgrading a complete into a provisional; the Act calls it the purported complete specification and specification purporting to be the complete specification.

So, 9; 3 talks about where you can file a complete and downgrade it to a provisional then notwithstanding anything contained in this Act; the controller shall not refuse to grant a patent and the patent shall not be revoked or invalidated by reason only that the matter described in that provisional or in the specification treated as aforesaid, as a professional specification that is a 9; 3 downgrading was used in India or published in India or elsewhere at any time after the date of filing of that specification.

So, you could file a specification in India; a provisional and the next day you could make disclose that invention in the United States or any part of the world because preserving the priority by filing a provisional allows you to disclose the invention after the provision is filed and that disclosure cannot be used as anticipation for your complete specification. So, if you preserve the priority filing a provisional and you make a disclosure; you disclose it to people in conference in the United States and after few months, if you file the complaint; this disclosure will not be used because you filed a provisional; so, provisional helps you to make; disclose the invention to the public.

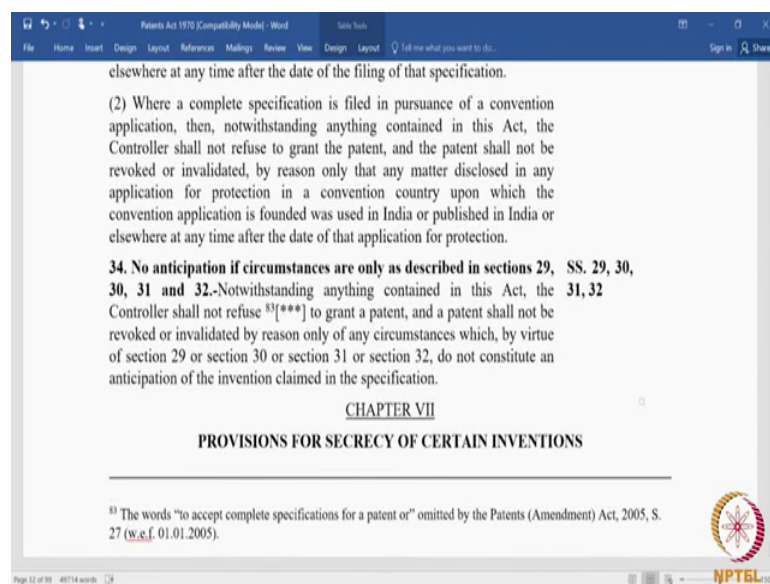
33; 2, where the complete specifications filed in pursuance of a convention application then notwithstanding anything contained in this Act. The Controller shall not refuse to grant a patent, and the patent shall not be revoked or invalidated. So, not only the controller not refuse, they cannot be any proceedings before the high court or the IPAB by reason only that the matter disclosed in any application for protection in a convention country upon which the convention application is founded; was used in India or published in India or elsewhere at any time after the date of the application for protection.

Now, just how you can file a provisional in India and disclose it in other parts of the world, will not affect your priority of the complete. Similarly, if you file a convention application in form country and then make the disclosure in India; that disclosure will not be used for anticipation because the convention priority preserves your priority in

India just a simple thing of how a convention application can preserve a priority and any disclosure, any use in India or publication in India or elsewhere at any time after the date of that application will not be used for the purpose of anticipation.

So, just how you could file a provisional in India and disclose it in any part of the world, when you file the complete; the disclosure you make after the professional will not be used for anticipation. Similarly, if you file a convention application first and then enter India say within 12 month period, any disclosures in the meantime after filing the convention application cannot be used as ground for anticipation. So, these are all foundational principles on which international patent law is based on.

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Section 34 says no anticipation and circumstances are only as described in section 29, 30, 31 and 32 notwithstanding anything contained in this Act, the controller shall not refuse to grant a patent and a patent shall not be revoked or invalidated by reason only of any circumstances by which by virtue of section 29 or 30, 31, 32; do not constitute an anticipation of an invention claimed in this specification, it just re-treats that; the instances covered in these provisions do not constitute anticipation of an invention, it is just it is a reiteration.