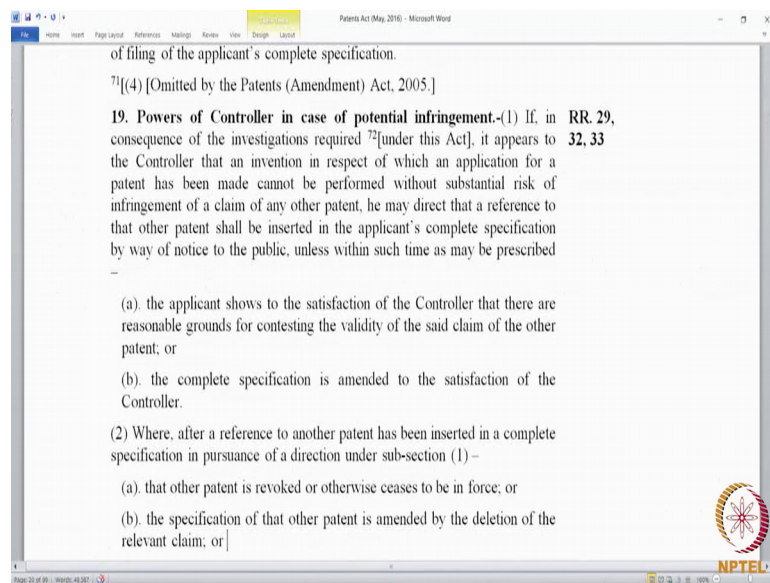


**Patent Law for Engineers and Scientists**  
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**Lecture - 36**  
**Patent Prosecution: Powers of Controller**  
**Potential Infringement**

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Section 19: powers of controller in case of potential infringement. Just as the controller has powers in case of anticipation the controller feels that the invention as filed by the applicant could be anticipated by some prior art, the controller can communicate these objections to the applicant. The applicant can either satisfy the controller saying that the priority is not affected by the prior art or he can carry out amendments. So, or they could also be reference in certain cases inserted by the controller.

Now, similarly the controller has certain powers when it comes to potential infringement. Now this is probably the only place in the act where the word infringement is mentioned from the viewpoint of the patent office. Because determining infringement is not the function of the patent office, whether a pattern is infringed or not is not the business of the controller, the controller is not the body or the authority that is given the power to determine infringement. So, you need to understand that we are only talking about potential infringement; this is not the infringement that happens after a patent

disgruntled. The normal disgruntled that happens after a patent is granted is with regard to the rights of a patentee under section 48, patentee has certain rights whether it is a process or a product which I mentioned in section 48.

If somebody violates those right and the rights are that others should not use you should not manufacture use half of our sale sell or import the invention if somebody does these 5 acts without the consent of the patentee we call that infringement. The acts mentioned in section 48 committed by a third party without the consent of the patentee if it with consent it is called license if it is done without the consent then we deem that to be infringement. The patent office is not the authority to determine infringement, because once a patent is granted if there is infringement the patentee will file an infringement suit under section 104 claiming reliefs under 108.

So, infringement is determined by the code, but the potential infringement mentioned here is with regard to the application that is spending before the controller the controller feels that if this application is granted it will infringe another patent which is already there. So, in such cases because the controller is not deciding infringement based on a granted patent he is not comparing the act of an infringer with a granted patent that is not they end over here.

Here he is looking at the claims in an application before him and determining if he grants this claim whether it infringe an earlier patent. So, in a normal infringement case the act of the infringer is compared to what is mentioned in the claim and act of an infringer is mapped to the claim of a granted patent here a claim is map with an earlier claim and the controller considers that to be a potential infringement, if this claim is granted and if somebody works this claim that would amount to an infringement.

So, try to understand infringement is not normally the task of the patent office, infringement normally happens after the grant. An infringement is always an action of a third party which comes within this scope of a granted claim this is infringement which happens before a court of law the patentee has to file a case for that or the exclusive licensee can file a case for that.

Potential infringement if an application with a particular claim if it way to be granted it would infringe an existing patent. So, the controller can see if an application is to be granted it would infringe an existing patent.

19 – 1, if in consequence of investigation required under this act it appears to the controller that an invention in respect of which an application for a patent has been made cannot be performed. So, we are talking about an application pending before the controller cannot be performed without substantial risk of infringement of a claim of any other patent which is a granted patent this is a second patent he may direct that a reference to the other patent shall be inserted in the applicant's complete specification by way of notice to the public same thing this is a reference and why is a reference done to inform the public that if you work this patent you will be infringing another patent.

So, it is only a reference in the specification saying that this is also covered by or this aspect of the invention is covered by another patent. The forms of reference are also there we have a form of reference as to how that reference has to be made in rule 31 the form is mentioned how to make a reference under 18 – 2, and in 33 you have rule 33 you have how to make a reference to another patent under 19 - 1. So, the form is mentioned in reference has been directed in pursuance of section 19 - 1 of the patents act to patent number so and so.

So, this will be inserted in the complete specification. So, rule 31 gives the reference under section 18 and rule 33 gives the form of reference under section 19 now coming back to 19 - 1. So, the yardstick for the controller is that if the invention pending before him if it cannot be performed if the invention contained in a claim cannot be performed without substantial risk of infringement of a claim of another patent. So, what is the controller doing here? The controller is looking at the claim and the way in which the invention is to be performed if the invention is performed based on the complete specification then there will be a substantial risk of infringement which means what is covered in this patent is also covered in another patent.

So, the risk is of a potential infringement and the remedy that the controller would do is to insert a reference. Now to get away or to avoid the reference the applicant can do two things again a and b, he can either show to the satisfaction of the controller that there are reasonable grounds for contesting the validity of the set claim of the other patent. Now in anticipation we saw that you can prove that your priority is earlier in time here you do not do that here you can demonstrate to the controller that that patent is granted, but there are grounds on which the validity can be objected in effect you are telling the controller that if somebody objects the validity of that patent they will get revoked.

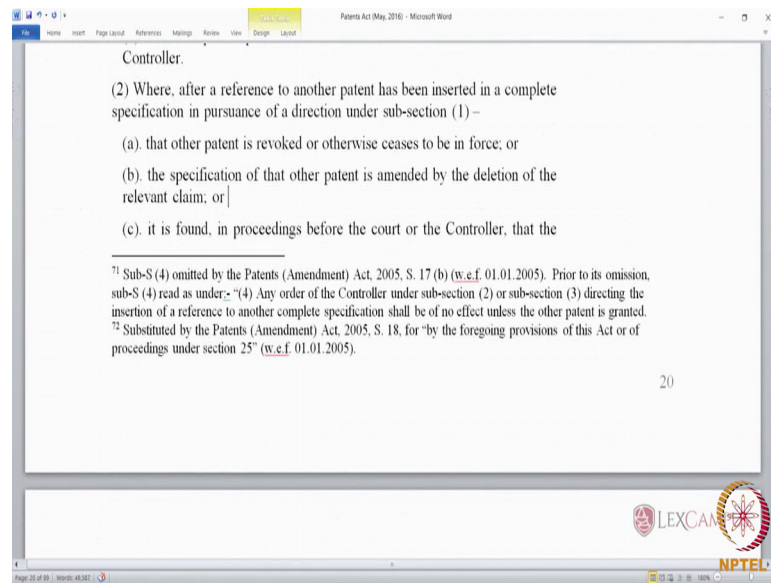
So, if it gets revoked there is a question of an infringement you understand. So, you are telling the controller even without filing a pre grant or a pose in this case there can only be a post grant because that is an already granted patent even without failing a post grant you are indicating to the controller that if somebody makes a challenge this patent will get revoked there is a reasonable ground for contesting the validity. So, do not worry about the reference because this looks like a patent that is invalid.

So, you demonstrate to the controller. So, no reference will be inserted or you amend the specification to get over the objection. So, two things that the applicant can do if the controller feels there is substantial risk of infringement of another patent and wants to add a reference in the form reference you saw that in rule 33 they will mention the number of the patent. If you do not want a reference of an somebody else is patent in your patent then what you will do is you will demonstrate or satisfy the controller saying that there are issues of validity on that patent. So, do not at that reference it is a matter of time that that will be challenge or you can amend the specification.

Now, tell me one instance where an applicant will not be worried about an earlier reference, the applicant the controller says that there is a potential or a substantial risk of infringement I am going to add this reference and the applicant says no problem go ahead and add the reference. Can you think of one instance where the applicant can say I am not going to show you the validity of the earlier patent can be contested not I may going to amend this specification, if you want to carry a reference carry that reference.

This will happen when both the applications are held by the same person. If the earlier application that was granted belongs to the same company the company will not have a problem with the reference because they are both belonging to same entity.

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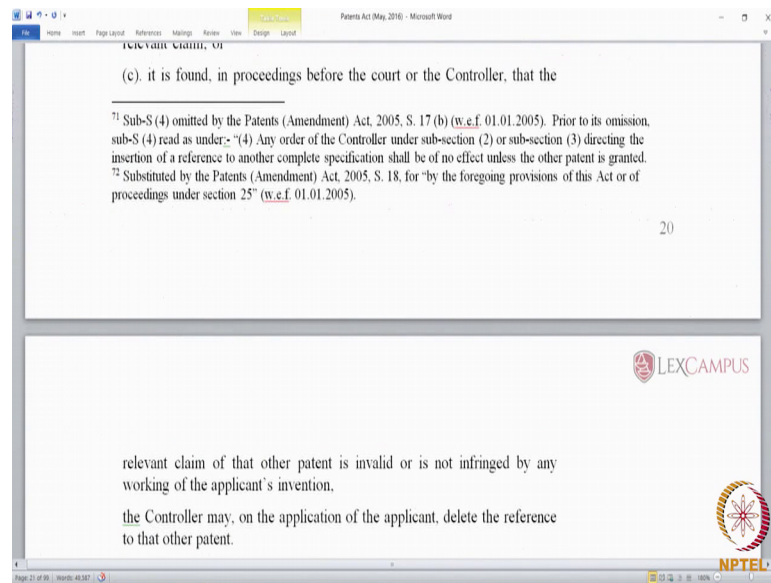


19 - 2 were after reference to another parent has been inserted in a complete specification and pursuance of the direction under sub section 1 a the other patent is revoked or otherwise ceases to be in force.

Now, in 19 - 1 the applicant will only tell the controller that there is a possibility that it can be revoked, but here in 19 - 2 it was actually revoked or it cease to be in force either the renewal fee was not paid or it reached to his expiry time and got expired or b the specification of that other patent is amended by a deletion of the relevant claim the relevant claim I told you in 19 the controller does a claim to claim mapping what this claimed in this invention is also claimed in another invention. So, if you work this invention if you put this invention to practice it will infringe the earlier pattern.

Now that claim was dropped that specification was amended and this relevant claim which was the cause for the infringement was deleted. 2 c says that if in a proceeding before the court or the controller and we understand this court to include also appellate board that the relevant claim of the other patent is invalid or is not infringe by the working of the applicants invention.

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Now, not infringe by the working of an applicant's invention is a suit for infringement was filed and the court held that that the applicants invention which means we can understand that in that case the applicant was made the difference, the court held that what the applicant was doing what is covered by his patent has does not infringe.

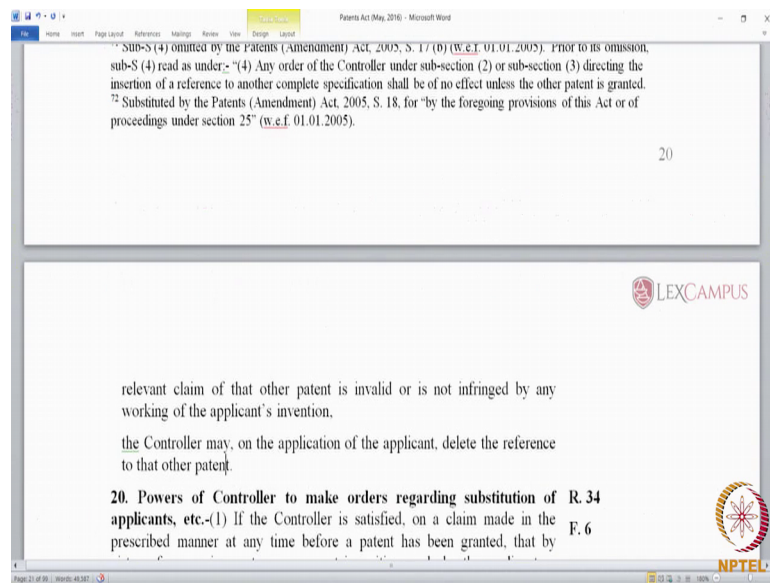
So, invalidity is different from not being infringed. In invalidity you are going to Christian the grant of the patent itself if you christen the grant of a patent you are going to say that this patent should not have been granted where as a declaration that you are not infringing merely states that what you are doing is outside the scope of the claim. So, this provision actually talks about two things that can come in infringe suit. Infringe suit is somebody files an infringe suit against to you for an action that you are doing if you can demonstrate to the court that your act is outside the scope of the claim then you are not infringing you can still continue the act. If you are not able to do that act then you would challenge his or her patent that is called an invalidity challenge where all the grounds in 64 revocation is actually an invalidity challenge.

So, the first response in an infringement suit would be I am not infringing this scope of my action is beyond the scope of what is claim. So, even if I am able to show that then I will get the court will say that pattern does not been infringe. So, that is a declaration the court will give. Over and about that I can even ask for a patent to be challenged the validity I can question the validity under all the ground mentioned in 64 I can challenge

the patent lack of novelty lack of inventive step lack of utility are all ground for challenge. So, if the patent gets revoked than there is no question of infringement you cannot infringe that patent that is revoked. So, both the factors are taken here patents that are revoked and patents that are granted valid, but not infringe.

Now, if you get a declaration from a court or by the controller, controller because they could be post grant opposition where validity is challenged then the controller may on application of the applicant delete the reference to that other patent.

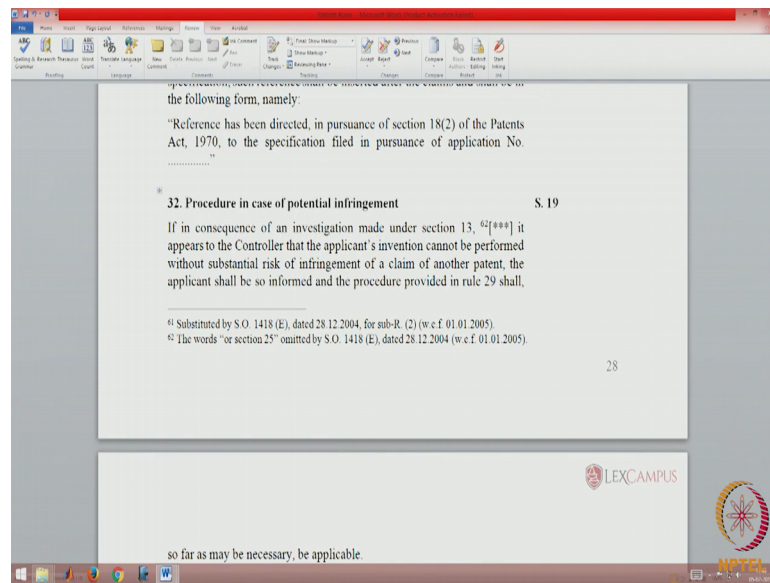
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So, two talks about cases where the reference is already inserted, but these three cases in these three instances the applicant can ask for the reference to be deleted, what are the three instances? The patent got revoked, so there is no question of infringement, the patent got amended that particular claim was deleted or the patent was found to be invalid in court or before the controller or the court held that the patent the what the applicant is doing is not infringement, scope of the applicants action and by presumption the scope of the applicants invention is beyond the scope of the is a declaration by the court.

So, in these three cases if an reference has already been made you can ask for a deletion. The earlier part of 19 – 1, the 19 - 1 dealt with cases if the controller wants to make a reference how you can avoided. 19 - 2 mention if the controller makes a reference the circumstances in which you can request for a deletion.

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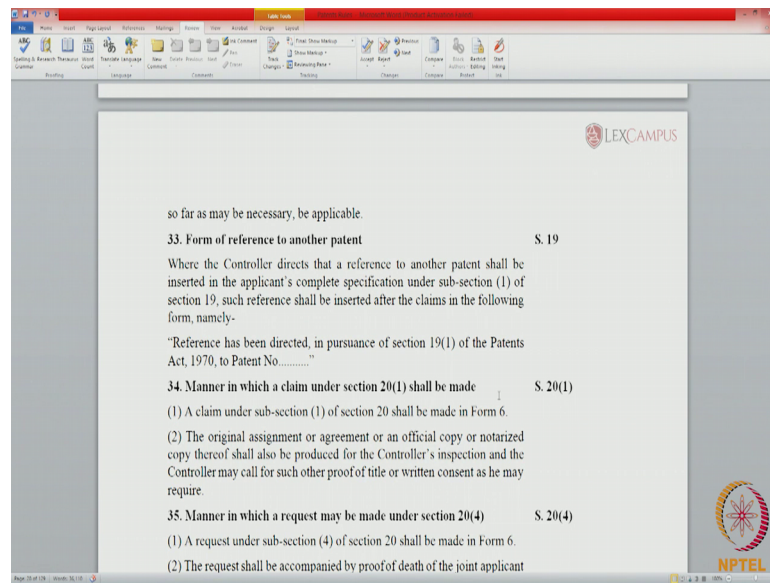
Rule 32 deals with the procedure in case of potential infringement. We had seen that in cases of potential infringement the controller has certain powers and this is the only provision under the patents act where the controller can do certain things with regard to infringement the controller is not the authority to determine infringement, infringement has to be determined by a court of law, a district court or any court above a district court can look into aspects of infringement. But the controller has been given as we had already seen some powers pertaining to potential infringement.

The procedure is prescribed in a rule 32 and the corresponding section is section 19 which we have mentioned that 32. If in consequence of an investigation made under section 13 it appears to the controller that the appellants invention cannot be performed with or without substantial risk of infringement to a claim of another patent the applicants also be informed and the procedure provided in rule 29 shall so far as may be necessary be applicable. So, this is quite straight forward. Just what we saw under section twenty nine the applicants shall be informed and the procedure in 29 will follow.

So, it is quite straight forward that applicants shall be informed and the procedure in rule 29 shall be applicable.



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Now, how is that form of reference to be made? Reference to another patent now reference to another specification we saw that will be done by referring to the specification number by which we mean that it could be an application number. So, rule 31 applies where the cross reference is to a pending application. Rule 33 applies when the cross reference is to a granted patent. So, if you are face to the question what does the difference between rule 31 and rule 33 we could have multiple answers the correct answer will be the choice will be ruled 31 deals with a cross reference to a pending application or an application, whereas rule 33 deals across a reference to a granted patent.

So, let us look at the form 33 rule 33 where a controller directs that a reference to another person shall be inserted in the applicants complete specification under 19 – 1, the reference shall be inserted after the claims in the following form. Again the place of insertion of a reference is after the claims. So, that is a point to note that all references are made after the inserted after the claims which is same we saw in 31 it is after the claims and in 33 is also it is after the claim the only difference is the references to a patent number in 33 whereas, in 31 it is reference to an application number. Referential has been directed in pursuance of 19 - 1 to patent number so and so.