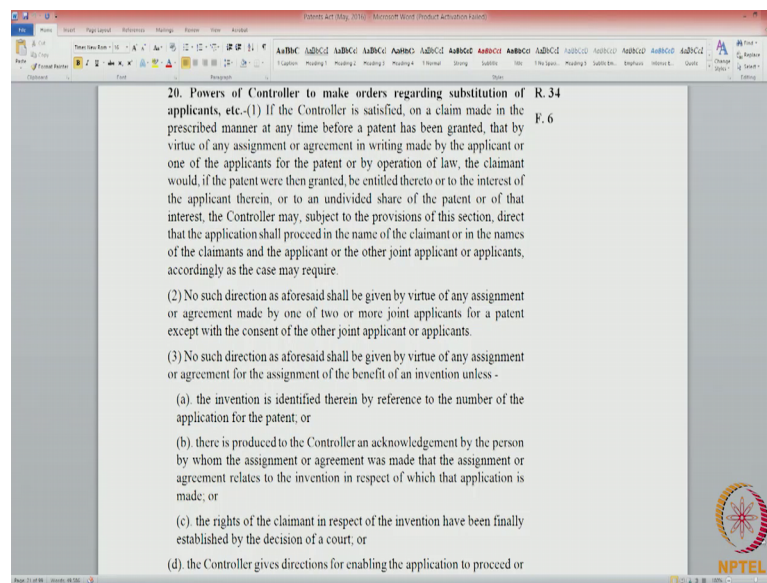


**Patent Law for Engineers and Scientists**  
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**Lecture - 37**  
**Patent Prosecution: Powers of Controller**  
**Orders Regarding Substitution of Applicants**

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Section 20: power of controller to make orders regarding substitution of applicants' etcetera. When an application is filed the applicant on whose behalf the application is made is mentioned in the application itself. Now assume that after period of time the applicant wants to assign the invention to another person even before grant, it still in the application fees he wants to assign it or it is a part of a company he wants to sell the company or he wants to sell the invention alone like it is a research organization somebody has shown interest in the invention. So, they have an agreement to sell the invention to that person.

In all these cases they could be a transfer of title, a transfer of ownership from the applicant to another person, either through a sale of a company, either through an assignment or through the sale of the invention of the technologies itself. In all these cases there has to be a substitution of the name of the applicant. Now after the grant if there is an assignment, there are provisions under the act where a patentee can be

substituted. We are not talking about a patentee substitution, you are talking about an applicant whose name is there in the application, how do we substitute a new applicant's name because for certain reasons the applicant has changed the person who was the applicant is no longer the applicant and somebody else has come in his or her place the controller has certain powers.

Now, let us look at that; 21 if the controller is satisfied on a claim made in the prescribed manner at any time before a patent has been granted. So, 20 point to be noted, section 20 the powers of the controller under section 20 are before the grant of the patent. So, how do you change the name of a patentee? Section 20 does not apply because the patentee we call him a patentee when the patent is granted we do not call him an applicant. We refer to the person as an applicant up until the time of the grant after the grant is called a patentee or the patent holder.

So, to substitute the name of a patentee this is not the provision. So, you need to bear that in mind because this provision applies before the patent has been granted, that by virtue of an assignment or agreement in writing. Now these are the things that you need to note before the patent has been granted by virtue of any assignment or agreement in writing made by the applicant or one of the applicants of the patent or by operation of law.

There are three things there could be an assignment, assignment is where you give your right to another person, there could be an agreement, the agreement can be a takeover agreement if it is a company, it can be a share purchase agreement, if it is a company I purchase the majority shares and I become the owner of 100 percent shares, it could be any agreement which is critical for this transaction or by operation of law. By operation of law say the company is acquired by another company operation of law, or the company becomes bankrupt the company does not have money and all the assets of the company are sold the patents alone are purchased by another party. So, that is operation of law.

The patents are purchased by when the company gets into bankruptcy proceedings, patents being the asset of the company are purchased separately. So, that is something we called operation of law. The claimant would if the patent was to be granted be entitled there to or to the interest of the applicant there in or an undivided share. Now the claimant is the person who wants to come in as the new applicant. So, claimant would be if the patent is granted this is in the future if the patent is granted, would be entitled there

too he will be entitled to becoming the applicant or to the interest of the applicant or undivided share of the patent, or of that interest the controller may subject to the provisions of the section direct the application to proceed in the.

So, the controller will direct, the application to proceed in the name of the claimant or the names of the claimant and the applicant or the other joint applicants accordingly as the case may require. There are three instances where so, we understand in the section, we try to understand who the claimant is there is a claimant here, claimant is not the present applicant.

Claimant we understand as a person, who has received something from the applicant which entitles him to become an applicant. So, the claimant is used as the future applicant or the new applicant let us call the new. Now this provision also contains instances where only an interest is given, the entire invention is not sold the entire invention is not given. So, there are three applicants they all together want to bring in the fourth applicant, do you understand there are already three people because there can be you can make joint applications, there are only the three applicants say there are three scientist had file the patent in their own name. A fourth person was also help them, but his name did not come in the application.

Now, they if I they make an agreement with the fourth person to say that we recognize you are right you had made a contribution, and they say that we will include you as a inventor or based on that agreement it is an agreement in writing, the fourth person can who can be regarded as a claimant will not get the entire invention you will only get in undivided share that is one fourth of the invention, if that is the arrangement. So, this provision applies for instances where a person gets the full patent full interest in it, and also cases in which he may be a joint applicant. So, that is why it says a claimant who by three things, by agreement, by assignment, or by operation of law. Operation of law I said there is a bankruptcy proceeding something a legal proceeding based on which the claimant came to acquire an interest.

So, there is a claimant or claimants it could be one or more people, and the claimant by virtue of three things an agreement assignment or operation of law was entitled to the application itself, he came he was entitled to the application itself or to an interest or to an undivided share. So, three things he was entitled to the patent, the application the

patent does not the application or to an interest or two an undivided share of the patent or that interest. In such cases the controller shall direct the application to proceed in the name of the claimants, claimant or claimant or in case there are existing applicants who also continue with in then in their names jointly.

So, I hope you understand this scheme, there is a claimant the claimant comes gets an interest in the application based on three things there is an agreement between the existing applicants or there is an assignment or by operation of law he gets an interest. And what kind of interest is that he has an he is entitled to the application or to an interest in which is not the full right, but a part of it or he is entitled to in undivided share or an interest in that undivided share.

So, when he is entitled to the invention itself or to a share in the invention, then the controller can shall proceed as if the claimant has become an applicant. The controller shall proceed with the claimant now shown as the applicant. So, the word claimant is used here so that we do not get confused with the old applicant and the new applicant. 22 no such direction as a force it shall be given by virtue of an assignment or agreement any assignment or agreement, made by two or more joint applicants for a patent except with the consent of other joint applicants. Now what did we see in 21?

In 21 we saw a claimant making a claim that he should be treated as an applicant we saw that in 21. 22 states if there are joint applicants then the consent of all the applicant is required before including somebody as a claimant. If the controller needs to give a direction this provision requires the claimant to make an application to the controller under form 6, and the controller will have to give a direction. So, the direction is what is being sort under this provision. 22 says that the controller will not give the direction till the consent of all the joint applicant are received let me give an example. there are 3 applicants to a particular application.

Now, a b and c; a and b have an agreement with d, and they want to bring d into the list of applicants. So, d becomes the claimant, these agreement is only with a and b, but not with c, but c is an existing applicant there are three applicants a b and c, a and b have an agreement with d, based on that agreement they want to bring d as a claimant he become they want to bring them as a new applicant. As per 22 the controller will not do it he will not receive a direction till they get the consent of c. So, provision is very simple in case

you need to bring if you are a joint applicant with others you cannot bring a new applicant without everyone consenting. So, that is what it says except with the consent of other joint applicants.

So, all the joint applicants a b and c will have to consent, if all of them do not consent the controller will not pass a direction it is just to protect the interest of the existing applicants. 23 no such direction as aforesaid shall be given by virtue of any assignment or agreement, for the assignment of a benefit of an invention. So, this is with regard to assignment of a benefit of an invention unless a the invention is identified there in by reference to a number identified by reference to the number of the application, there will be there is produced to the controller and acknowledgement by the person by whom the assignment or agreement was made acknowledgement by the person, who made the assignment or agreement that the assignment or agreement release to an invention in respect of which the application is made, that it relates to the invention.

Or c the right of a claimant in respect of the invention have been finally, established by decision of a court this is where by operation of law. You saw that operation of the law the rights of a claimant has been established by a decision of the court or d the controller gives direction for enabling the application to proceed for regulating the manner in which it should be proceeded under subsection 5.

Controller gives direction sub section 5 under sub section 5. We will see what sub section 5 is, but in this in 23 we say the it puts the requirements for the controller to pass a direction, before passing a direction saying that somebody is the claimant, there are certain requirements. The first requirement no such direction as aforesaid shall be given by virtue of an assignment on agreement for the assignment of a benefit. So, whether there is an assignment of a benefit in an invention, as assignment is where you want to give a part of the right to another person. Then the controller will insist that the invention is referenced by the application number, because we are still in the application stage.

So, the assignment that agreement should referred to the application number. So, if the parties come with an agreement without the application number, mentioned in the agreement the controller will not act by it. So, there can be a question what are the requirements of the document that has to be filed along with form 6. You can give multiple choices it should contain the patent number, it should contain the application

number, it should have a cross reference to all the names of the party, you can come up with many answers; the correct answer will be it should have a cross reference to the application number. So, you could create questions on that, but understand this is yet another case of cross reference.

So, you could make a chart on all the cross references under the patents act. So, where ever you can do a control f on the act and find all the references, and you can make a chart with the provisions; type of reference, reference to which part or reference to what the section of the relevant rule, and the just of it. So, that it becomes easier to memorize. So, this pertains to the first requirement is that there has to be a reference to the application number when or there is an acknowledgement by the person who made the assignment that the assignment release to the invention in respect of its application has made the person who makes the assignment, should say that this assignment is pertaining to this application is not mention the number is not mentioned, but he says this is with regard to an application, it is clearly identified by the person who makes the acknowledgement, it is clearly identified that they are talking about a particular invention.

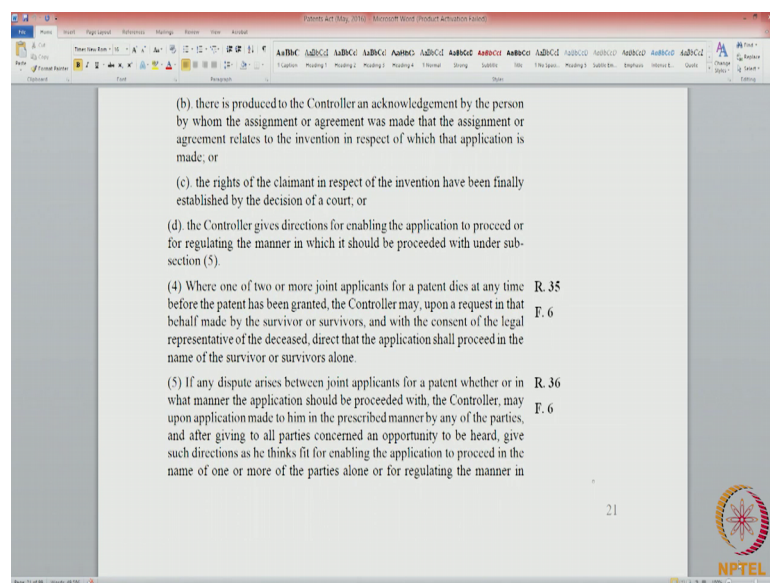
So, the person who makes the assignment acknowledges the invention. So, there is no doubt. So, what is the objective here? In the first case a person who reach the agreement should know what the invention is. In the second case we say that the person who makes the assignment should acknowledge, that this is the invention that is being transferred or that is being that is for which there are seeking a direction or there is a decision of a court. Say there was dispute with regard to inventors or dispute with regard to an agreement joint developed agreement. Two institutes come up with an agreement memorandum of understanding and later on they have an agreement to develop and invention two institutes. So, researchers from both the institutes do work and file an application. A third institute now comes and says I was also involved in the project, I should also be shown as an applicant. Institute the first two institutes say that no you are not involved and that becomes a dispute.

So, the third institute approaches the court of law, with lot of documents to show that it was also involved and assume that the third researcher or institution is successful in getting an order from the court of law, saying that yes you made a contribution to the invention with lab notes and evidences of their they are finally, able to prove that. Now

based on that court order you can make a direction. So, the court order will very clearly say what is the facts and circumstances of the case, what invention they are pertaining to it may also say that the other two people have filed an application, this is the application number its pending before just patent of all the details will be there. So, the controller has to insist on that court order, and I gave you the situation where there is a dispute with regard to who the applicants are and one party gets a favourable decision from the court, then here the controller will have to insist or will have to see that the rights of the claimant in respect of the invention has been finally, established by a decision of the court.

So, when you file form 6 you will file form 6 with the court order, that that could be a question form 6. The accompanying documents in form 6 can be agreement assignment decision of a court, all of the above or something like that d. The controller gives direction for enabling the application to proceed under subsection 5 or we are coming to it.

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24 where one of the two or more joint applicants for a patent dies at any time before the patent is granted, the controller may upon the request in that behalf made by the survivors or survivors and with the consent of the legal representative of the deceased, direct that the applications shall proceed in the name of the server or survivors alone. What happens if there are multiple applicants and one of the person dies? In this

provision if there are three applicants a b and c, and c dies before the grant of a patent, a and b who are called survivors here the surviving applicants with the consent of a legal representative of c, c is died. So, c is legal representative they get a consent they can ask for a direction to proceed in the name of a and b alone.

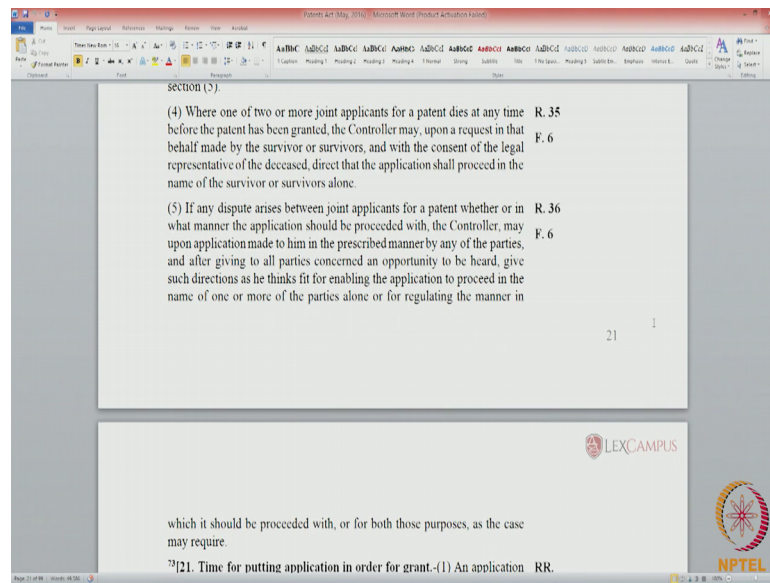
So, a and a b and c where the three applicants, c died in between before the application was granted, a and b can make a request to the controller for a direction to say that proceed in our own names do not worry about c, because c is now no more only condition is a and b will have to get the consent of the legal representatives. Whoever as survived, whoever are the successors in interest, whoever succeeds c its family members in most cases.

If it is a legal entity then whoever legally represents that person that is what we use the word legal representative of the deceased. You find the same language used in section 6 legal representative can be an applicant under this provision. So, assume a case where c are legal representatives do not give the consent. So, they come in as applicants because section 6 are allows them to do that. So, they will file a form 6, and they will say that we want to come in as the legal representative for the deceased applicant and their names will be substituted.

So, there could be questions on the course of action in the case of a death of a applicant. What could be the course of action in the case of a death of an applicant? In the case of death of an applicant the surviving applicants can proceed with the application in their names. Provided they get the consent provided they get the consent they can proceed in the in their names.



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25 if any dispute arises between joint applicants for a patent, whether or in what manner the application should proceed with. The controller may up on application made to him in a prescribed manner by any of the parties and after giving all the parties concerned an opportunity to be heard that is a hearing again, you find a hearing coming here give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be proceeded with or for both the purpose as the case may require.

Twenty five deals with disputes between joint applicants. So, all the instances above where the joint applicants were not in dispute; a and b wanted to proceed after the death of c, c is representatives did not object they gave consent no problem. There is an agreement, all the parties have given consent no problem, there is an assignment all the parties have given are parties to the assignment there is no issue, but when one pass person refuses to give consent for bringing another applicant. So, which means there is a dispute between the joint applicants, and then what should be the request the control? Another here it is said if disputes arise between the joint applicants, whether or in what manner the application should proceed.

Now, the controller can take an call on whether the application should proceed or in what manner it should proceed, the controller may upon application made them in the prescribed manner by any of the parties and after giving them a hearing opportunity. So,

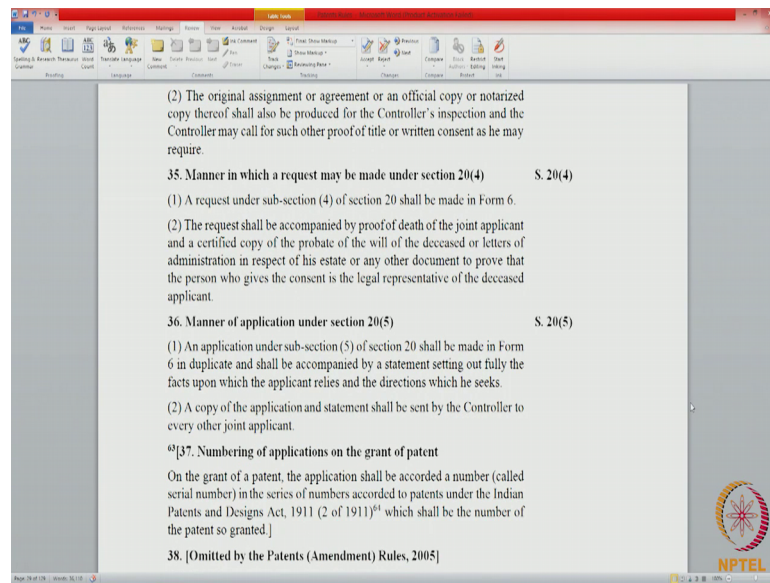
when there is a dispute any applicant can proceed to the controller under form 6, any applicant. So, the form 6 is not only for substituting names of applicants forms 6 can also be used to resolve a dispute between applicants, that is an important thing if you see form 6. Form 6 refers to all the sections on top 25 are mentioned there.

So, you will use form 6 and intimate the controller to say that there is a dispute between the joint applicants. So, the controller will hear the parties give them a hearing; controller can give such direction as he thinks fit now this is the important part. Now the controller can hear the parties and he can give such directions as he thinks fit. For enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be proceeded or for both.

So, you can either say that itself proceed in the name of certain parties or for regulating the manner in which it should be proceeded it with. Either the controller can say this application shall proceed in an if there are three applicants and one person is not cooperating, the controller can say it shall proceed in the name of a and b alone whatever for whatever reasons. Or it can say that it shall proceed in the name of a b and c, but they should not be they should not do anything to stall the process, they can say that it should proceed further because sometimes one applicant can stall the process it can say that I am not interested or he can go to the court and say that I filed a case till that is decided do not prosecute. So, many things can happen.

So, you can give a direction as to and whose name it should go or the manner in which it should proceed. So, both these things can be done by the controller, now let us look at the corresponding rules.

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Rule 34 manner in which a request may be made under section 24. Rule 35 1 says it shall be made in from 6, and 35 2 says that a request shall be accompanied by proof of the death of the joint applicant and a certified copy of the probate of the will of the deceased or letters of administration in respect of a state or any other document to prove that the person who gives consent, is the legal representative of the deceased applicants.

Now, there are quite lot of details in this, when you file form 6 under section 24 there is already a death, one of the applicants as died. So, you have to produce the death certificate that is what is called the proof of death. Proof of death is what we can get from the authorities call the death certificate. So, proof of death has to be accompanied that is one thing. The second thing is there has to be a statement of how the deceased person.