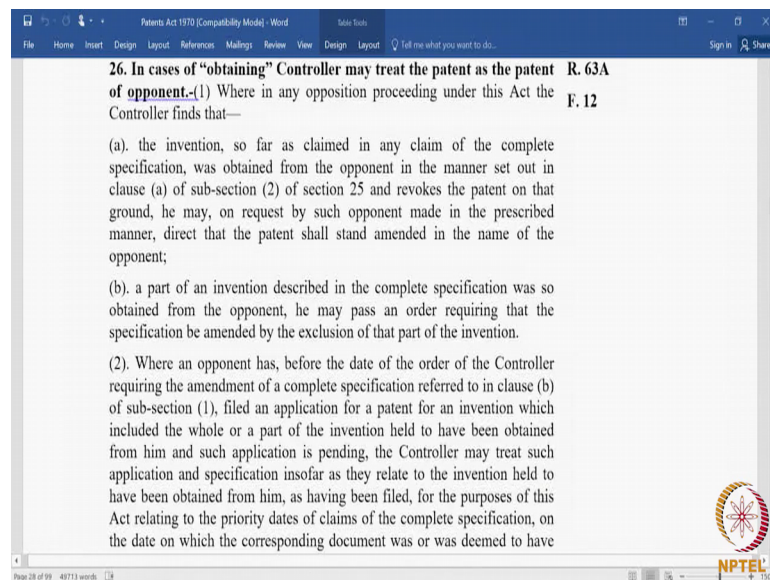


**Patent Law for Engineers and Scientists**  
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**Lecture - 43**  
**Patent Prosecution: Opposition**  
**Obtained Invention**

Section 26.

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Section 26 deals with instances of obtaining. Now we saw that in section 25 2 a when an invention is wrong fully obtain it can be a ground for opposition. Section 26 deals with instances covered under section 25 2 a, section 25 2 a covers instances were a patentee or a person under or through whom he claims wrong fully obtain that invention or any part thereof or which means it need not we entire invention it could be certain things covered in certain claims from him or from a person under through whom he claims.

So, the opponent if he has a case that the patentee wrong fully obtaining the invention from the opponent, he can file a ground for opposition under section 25 2 a; now were such an opposition is field and the controller comes to a conclusion this is 26 1 a that the invention that has been claim was obtain from the opponent in a manners set out and clause a of subsection 2 of 25 that is 25 2 a and revokes the patent. So, wrong full obtainment as I said is not a substantive ground, it is not based on the merit of the patent

the fact that the patentee did something wrong, he claimed in invention that did not belong to him the controller can revoke.

So, it is not based on the substantive merit it is based on the conduct of the patentee, the fact that he filed an application which he was not entitled to his a ground for revocation so the controller as the power to revoke. Now he may on the request of sub opponent made in the prescribed manner direct that the patent shall stand amended in the name of the opponent. Now this is a slightly different relief normally an opponent files an opposition to destroy the patent, to revoke the patent. Now if the opponents cases that he took the invention from me, then the opponent may be interested in getting that invention back.

So, this is a provision were a granted patent can be transfer from one person to another; this is probly the only provision in the patents act. So, if the question is ask under which proceedings of the patents act can the controller transfer a patent granted patent from one person to another they answer is 26. This is actually transfer of patent because your name is going to be substituted as the patentee or you could even wore the question as under which provision of the patents act can a person substitute his name as the patentee give the choices 26 will be the; even 25 2 may not be correct because 25 2 the relief is only revocation, you saw in 25 4 three things can be done, maintain amend revoke.

Transfer substitution of name is not a power under 25 4. So, the correct answer will be 26. So, an opponent who claims that they invention was taken from him has the power to substitute his name or request the patent office to substitute his name and the controller if he satisfied he can direct the patent to be amended in the name of the opponent . So, again this is a case were the patentees conduct was bad he actually took something which should not belong to him the opponent filed a revocation, but then the opponent said that do not revoke the patent I want I am the original one let it come back to be then the controller will amended.

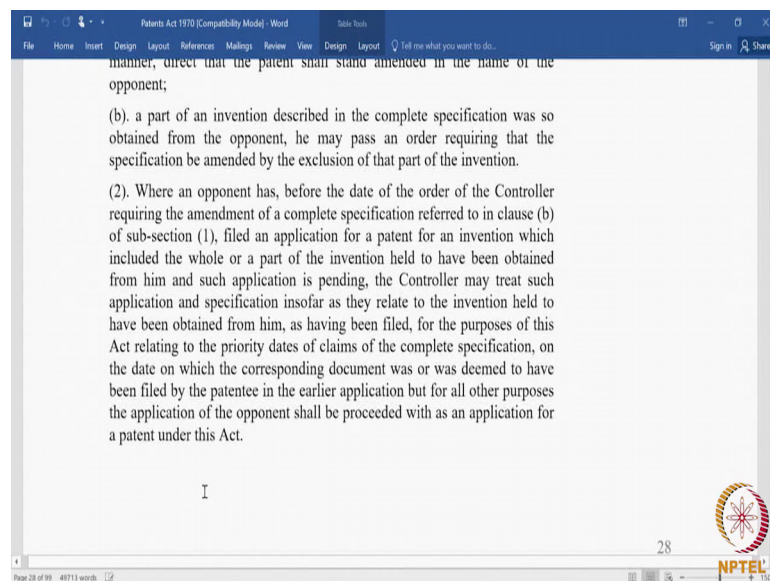
So, this applies only 25 2 a tell me why does not apply to 25 1 a? Because we said that the grounds are the same, it does not apply to 25 1 a because there is no name substitution that can happen before the grant. Why should the applicant name be substituted for all you know the it may never materialize into a grant. So, because it does a right is crystallized in the form of a grant, an a persons name is enter into the register

the issue of substitution of name comes in the issue of substitution of name does not come at the application state because there is no granted right there is nothing to be substitute once person name to an other. So, that is why the reference in section 26 is to 25 2 a and not to 25 1 a

So, this is yet another distinction between pre grant and post grant opposition. In post grant opposition and opponent can actually become the patentee in pre grant it is not possible. 1 b a part of the invention described in the complete specification was so obtained by the opponent he may pass an order requiring that the specification be amended to the exclusion of that part of the invention. As I said if the allegation of the invention being wrongfully obtain pertains to only one claim or few claims, then the controller will strike of those claims revoke those claims because those claims alone cannot be transfer will revoke those claims and allow the patent to country.

So, if the controller come to this conclusion after understanding the details of the case. If after hearing the parties the controller face that feels that not the entire invention is wrongfully obtained only a path which is in say claim 5 in 6 for instance, 5 and 6 alone covers were the opponent claims to be his. Now there is no provision for transferring 5 and 6 alone to another person. So, the controller will strike of 5 and 6 and grant the patent with the remaining claim because the remaining claims if it is prove that the remaining claims were not wrongfully obtained. So, that is what b tells us 2.

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Where an opponent has before the date of the order of the controller requiring the amendment of a complete specification or refer to in clause b of subsection 1, filed an application for a patent for an invention which included whole or part of invention held to have been obtain for him and such application is pending the controller may street such application in specification insofar as they relate to the invention held to have been obtained from him, as having been file for the purposes of this act relating to priority dates and claim of the specification on the date on with the corresponding document pause or was deemed to have been file by the patentee in the earlier application. But for all other purposes the application of the opponent shall be proceeded with as they application for a patent under this act. This is a lengthy provision you may have to read it in some detail, now this talks about a situation where the opponent has before the date of order of the controller requiring amendment of the complete specification under subsection 1 b. We said that if part of the invention is covered the controller will ask the patentee to amend, before he ask the patentee to amend if the opponent has filed an application. So, first we said that what if the opponent does not have an application if these claims are drop this claims are drop they fall into the public domain, but where the opponent has file an application for a patent, which included the whole or a part of an invention held to have been obtained.

So, we mention 5 and 6 were wrongfully obtained, but 5 and 6 appears in the application file by the opponent that is the case here. Now I told you an instance were 5 and 6 claim 5 and claim 6 were wrongfully obtained by the patentee. So, the controller under 1 b 26 one b can strike of 5 and 6. Now assume that before he strikes of 1 5 and 6 there is an application file by the opponent which has 5 and 6 (Refer Time: 08:55) for something similar to finds as been; obviously, because once I know that somebody I am going to make a claim from somebody that you have taken by invention only a part of my invention, I will defiantly file a corresponding application because I need to protected, otherwise it is just in the controller revokes it if falls into the public domain.

So, this is the part of strategy. So, you could have a question that if you are a post grant opponent and you feel or if you are a person who wants to raise an objection that part of your invention has been taken by another person and he has been granted a patent. Now what could be the safe guards that you take a b c d in one of the choices you can mention that you will file a patent for covering claims for what he has obtained and then filed an

opposition under 25 2 that will be the best answer. Because if you file an opposition under 25 2 without filing your own application then if the claims are struck of under 25 2 a you will not get it. Because your case is that only a part of the invention has taken are you able to understand only a part of your invention is taken if you do not have a parallel application then the controllers strikes off revokes it, he amends and he allows for the patent to continue without your part of the invention in how do you claim it.

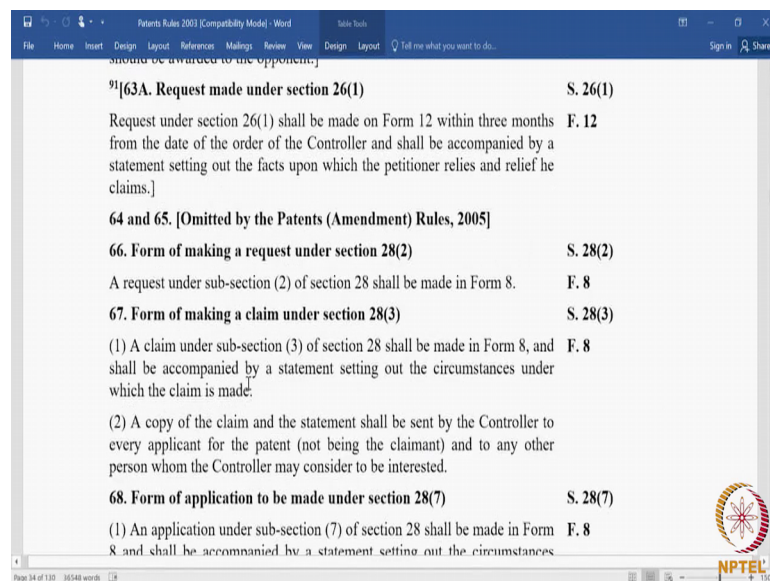
So, this safe guard is that you should file an application before you contest the post grant again this is the practice tip which you should advise an opponent any opponent who comes and says the part of a my invention is taken, that way simply to file you will get all the priority date because the opponent has precede all the priority for you, now let us see how this proceeds. The controller may treat such application and specification in so far as they relate to the invention held to have been obtained as having been filed for the purposes of this act relating to the priority days of the dates of the climes of the complete specification.

With simply means though you have file the application just before file in the opposition, you will get the priority date as on the day on which the patentee filed that particular claim you will get that priority. The controller may treat such application relating to the priority dates on the date on which the corresponding document was or deemed to have been filed by the patentee. So, you get the instants which we 5 and 6 claims are there which you allies the patentee has wrongfully obtained and you file an application for 5 and 6 claim at a later point in time, you get the benefit of the patentee is priority.

You see that they could be a question a very tricky question on antedating based on this provision you understand that because here the antedating happens into two different documents. If you raise this question I really will be interested in seeing how many people can answer that because you could say there is an earlier document which disclosed claims 5 and 6 which had a priority, there is a later application filed by a different person and because he raised a section 25 2 objection a stuck of the claims 5 and 6 as we have mentioned in the hypothetical sample and he accords the priority to the earlier date. So, actually his antedating the opponents application to the date of the patentees application.

So, you just read the provision again on the date on which the corresponding document was or was deemed to have been filed by the patentee in the earlier application, but for all other purposes the application of the opponent shall be proceeded with as an application for a patent under the act. So, for the priority purpose alone which means those to claims 5 and 6 though they were filed at a different point in time, gets the priority from an other document in this case not filed by the applicant at all.

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There is a corresponding rules 63 a request under section 26 1 shall be made in form 12, form 12 within three months from the date of the order of the controller and shall be accompanied by the statement setting on the facts upon which the petitioner relies and the relief he claims. Form 12 is for request for a grant of a patent under section 52 2. Rules 63 a tells us above the request to be made under section 26 1 request under section 26 1 has to be made under form 12 within three months from the date of the order of the controller, order of the controller under section 25 4 where he holds there is a ground for revocation of the patent and shall be accompanied by a statement setting of the facts upon which the petitioner relies and relief he claims saying that his entitle to the relief.

He has already filed an application for a patent and asking for the consequential relief. So, 26 1 proceedings are different from a proceeding in 25 2. The proceedings under 25 2 have to be completed by an order passed under section 25 4. Revoking the patent or part

of a patent or amending it, only then after the order in post grant opposition is out within 3 months you can file proceeding under section 26.

So, they are not joined proceedings. So, if the question is raised what is the time frame for filling a proceeding under section 26 1 or for filling form 12 form 12 can also be filed under section 52 2, but a form 12 is going to be filed under section 26 1 what is the time frame? You could have various choices form 12 has to be filed along with post grant opposition that is form 12 has to be filed along with form 7 a, form 12 has to be filed after the order of the controller under section 25 4, but within three months that could be the correct choice you could create different questions based on the details in this, but you will understand that three months from the date of the order refers to the three months from the date of the order passed and post grant opposition.