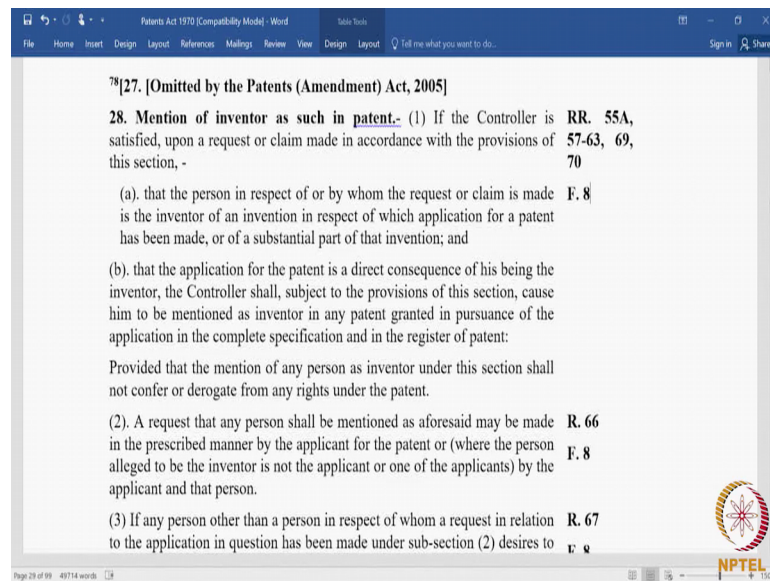


Patent Law for Engineers and Scientists
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Lecture - 44
Patent Prosecution: Opposition
Mention of Inventor

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Section 28: mention of inventor as such in patent. There are instances where the true and first inventor is not attributed the fact that he is the inventor of the invention. There are vary circumstances where the attribution of a person as the inventor of an invention may not happen, in such cases there is a procedure by which that can be corrected. Section 28 1 states that if the controller is satisfied upon a request or claim made in accordance with the provisions of this section. So, there is a claim or request made to the controller.

A: that the person in respect of or by whom the request or claim is made is the inventor of an invention in respect of which the application for a patent has been made, or a substantial part of that invention. So, the claim or the request could be to state that an inventor is the inventor of an invention as a whole, or he is the inventor of a substantial part of an invention; and b that the application for the patent is a direct consequence of his being the inventor and the application that was filed was filed because he invented the invention. The controller shall subject to the provisions of the section cause him to be

mentioned as inventor in any patent granted in pursuance of the application, in the complete specification and in the register of patent.

So, if a person is an inventor and his name is not mentioned in the column of an inventor and you know inform one you have to mention who the inventor is, if there are multiple inventors all the inventors name have to be mentioned them status of an inventor is different from the status of an applicant there are cases where the inventor can be the applicant, but these two work two different entities. The inventor is a person who comes up with the invention for the first time that is why he is called a true and first inventor, where as an applicant is the person who owns the invention and who is entitled to apply for a grant of a patent. In a case where the inventor is also the applicant then the inventors name will appear in the invention column of form 1, his name will also appear in the applicant column or assign a column in form 1.

Now, you will see that form 1 clause 4 gives the place where you have to enter the names of the inventors that is mandatory; you cannot file a form 1 without having the inventors name in it, and clause three a you have to mention the applicants. So, these are two different entities the person who is an applicant need not be and inventor there are cases where the inventor assigns his invention to the applicant, and the applicant can file the application and perceive the application.

The inventor necessarily has to have a connection with the creation of the invention, that is a requirement under law that an invention should have some connection to the invention to the creation of the invention, that is why you find in 28 1 a there is a mention of in the person being an inventor of the invention or of a substantial part of that invention, which means the creation of the invention was a group end of here there were others to joint inventors and together they came up with the invention.

Now, 28 does not deal with ownership disputes, you need to be very clear on that 28 does not deal with ownership dispute because the status of an inventor is not considered as the status of their owner. The inventor is a person who comes up with the invention unless the inventor is shown as an applicant only then he becomes the owner. So, there are cases where the inventor whose name is mentioned maybe an employ of an organization or a company, he may be a scientist working in a laboratory or a research organization, in all those cases the invention has to bear the name of the inventor. The inventor names has to

be mentioned there is no other way then mentioning the inventors name. But the applicant could be the person to whom the inventor has assigned the invention it could be the research organization, it could be the lab, it could be the corporation of the company for which the inventor had worked. The applicant this regarded as the owner of the invention and the inventor is regarded as the creator of the invention, these two are two different statuses under the patents act.

Analogy would be that of an author and a publisher under the copyrights act. Now we understand that very clearly a person who authors the book need not be the publisher; where as a publisher in most cases is in body corporate which may act through its employees and offices. So, the publisher owns the publication because the publisher takes the right from the author, the publisher gets to distribute and commercialize the publication. Where as the author is the creator of the work the author creates the work and it is the publisher who handles everything else, dissemination, publication commercialization of the written or artistic work.

Similarly, this status of an inventor is to create because the of the fact that he had created the invention, the law will always attribute him as the inventor through that is a right which nobody can take away from the inventor. Just as if you wrote a book you will always be attributed as such author, you may not make any money out of it, you may have assign the copyright to somebody else, but still you have a right to be mentioned as the author as long as the book axis. So, in patent law the inventor has a right to be mentioned as the inventor as long as the patent exists. So, the correction that the controller will do is he would mention that person as an inventor in the application for the complete specification that is one place where he will make the correction and in the register of patents.

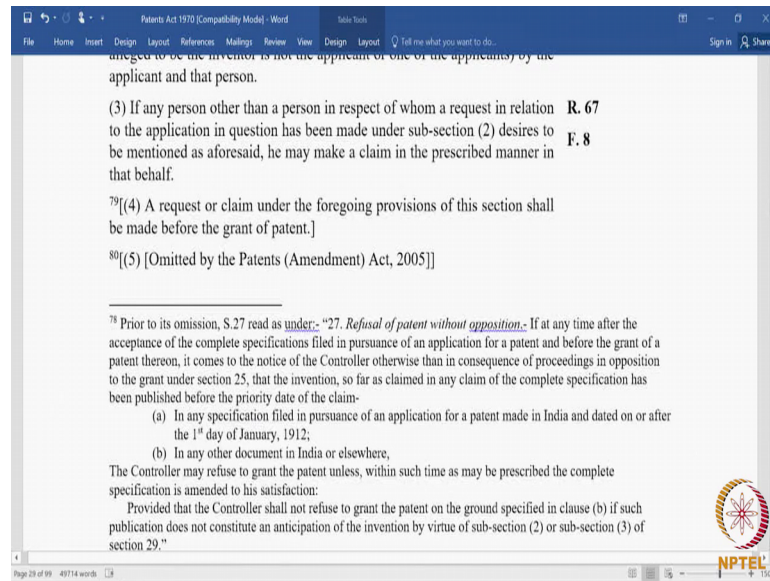
So, the controller will correct the record in two places, in the complete specification that is form 1 and form 2 and also in the register of patents. And as I mentioned before this does not affect the rights of owners, the mere mention of an inventors name does not affect the right of the owners because applicants are the owners of the patent. Provided that the mention of any person has invented under section shall not confer or derogate from any rights under the patent this is what I just mentioned that it will not confer or derogate from any rights under the patent. When we say any rights under the patent we are talking about the rights as a owner. The owners right does not get affected by

mentioning a person has an inventor, right of co owners as discussed in section fifty of the patent side. So, this in this provision we are not even talking about the rights of the co owners, we are only on the point of a person who invented the invention was not mentioned as the inventor he can request to the controller to have his name mentioned as the inventor.

28 2 a request that any person shall be mentioned as a foresaid may be made in the prescribed manner the form for that is form 8 you can see the cross reference there by the applicant for the patent or with a person alleged to be the inventor is not the applicant or one of the applicants by the applicant and that person. So, the person who can file form 8 is either the applicant himself and if the applicant is also the inventor then it is a clear case, there is a probably a clerical error where the invention was not mentioned then the applicant can request this change to be made or where the person alleged to be the inventor is not the applicant now this is where I mentioned the fact that the you are in inventor you are right is that of a creator where as the applicant is the owner.

So, you could create something and assign it to somebody else as we will most likely happen in large organizations where the employees create the invention and because of their employment contract the all the invention they come up with will now west with the employer. So, in cases where the person alleges to be the inventor is not the applicant or own of the applicant then by the applicant and that person. So, this is what is mentioned in the act 3.

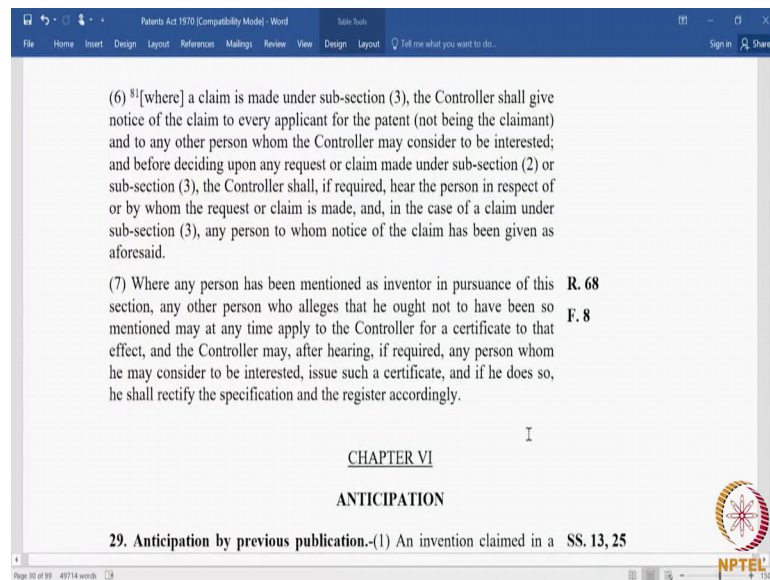
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If any person other than a person in respect of whom a request in relation to application in question has been made under sub section 2, desires to be mentioned as aforesaid he may make a claim in the prescribed manner in that behalf.

Now, we saw instances where an applicant can make the request or an applicant along with the inventor can make a request, but three covers instances where any person other than a person in respect of whom a request in relation is made under subsection 2 desire. So, any other person could also make it and that the rule 67 deals with the details that will be covered are you would still be using form 8 to do that. 4 a request or claim under the foregoing provisions of the section shall be made before the grant of patent. So, form 8 should be filed before the grant of a patent. So, you could have a question when do you file form 8. A request or claim under the foregoing provisions of this section shall be made before the grant of a patent.

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Then 5 was omitted, then you have 6 where a claim is made under subsection three that is by a third party the controller shall give notice of the claim to every applicant not being the claimant and to any other person whom the controller may consider to be interested and before deciding upon any request or claim made under subsection 2 or subsection 3 the controller shall if required here the person in respect of power by whom the request or claim is made and in the case of a claim under subsection three any person to whom notice of the claim has been given as a force it.

So, there are two types of proceedings here proceeding under subsection 2, where an applicant files form 8 or an applicant along with the inventor files form 8. Now you could they could be a question what are the categories of people who can file form 8 applicant along with the aggrieved inventor now the normal inventor along with the inventor whose name is missing; and a third party who is neither the applicant nor the aggrieved inventor all the choices are right.

Now, in both the cases the controller will give notice and here the person the section only says that the controller shall give notice of the claim to every person involved. So, who he will call the applicant he will call the inventor he will call any other person who may be interested they may be other people whom the controller may feel they maybe other joint inventors the controller can call any person and here that person. So, so there is a six deals with hearing 7, where any person has been mentioned in as inventor in

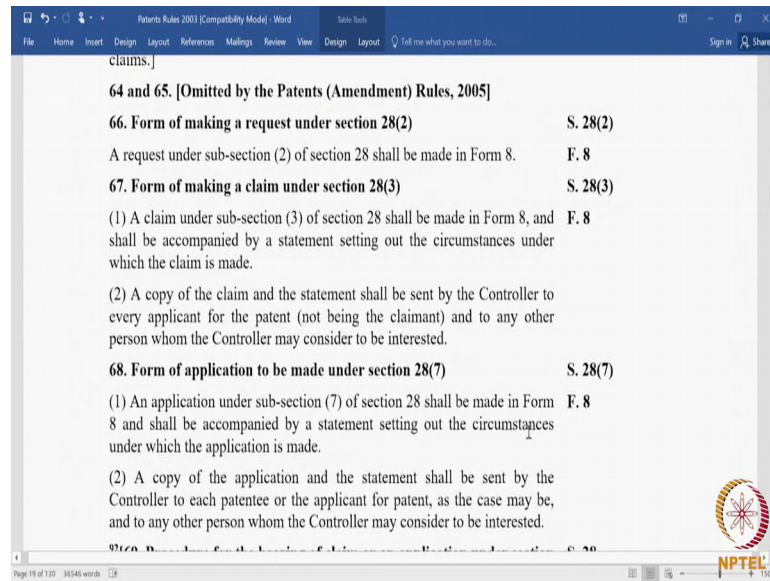
pursuance of this section, any other person alleges that he ought to have or not to have been so mentioned may at anytime apply to the controller for a certificate to that effect and the controller may after hearing if required any person who may considered to be interested issue such a certificate, and if he does so, he shall rectify the specification and register accordingly.

Now, issue of certificate is there are very few instances where the controller can issue the certificate. Now this is one case where the controller can issue a certificate the certificate is this subsection 7 comes into play after a proceeding under subsection 2 or subsection 3 has happened. Does a proceeding that has happened the controller as corrected and added a name of an inventor as an inventor that proceeding has already happened under 2 or under 3 a person's name has been added.

Now another person feels that this person is not the inventor, his name has been wrongly added then he can approach the controller at any time for a certificate saying that this person's name was wrongly added, and they will be a hearing and the controller will call all the necessary parties and then issue the certificate saying that we understand the certificate as a written document, specifying that the person's name was wrongly added and now it has been removed and if we issues that certificate then he will have to correct the specification and the register; because these where the two places he mentioned then inventor, we have rectification before the intellectual property appellate board, this is a rectification process before the controller.

So, they could be a question, how do you rectify a person whose name has been mentioned as the inventor under section 28, but you are aggrieved or you feel that that needs to be corrected what is the procedure to be followed. The procedure to be followed is under 28 7 you approach the controller for a certificate.

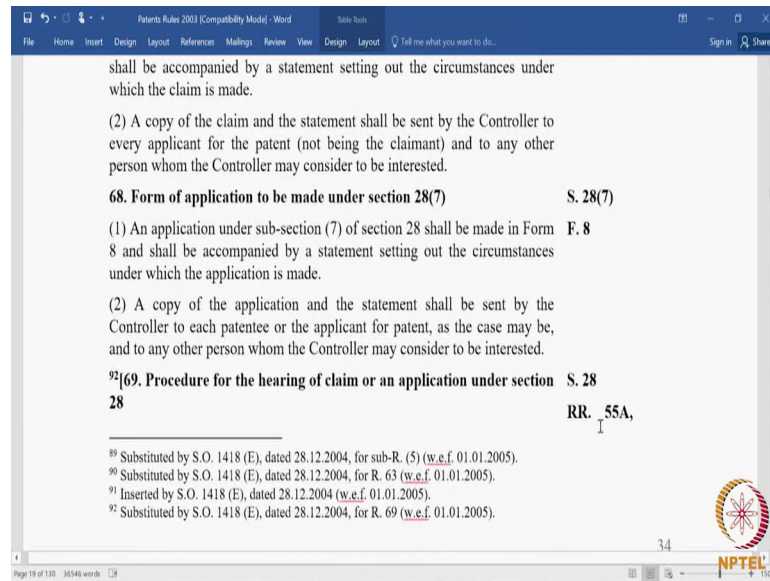
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Now let us look at the corresponding rules, rule 66. The form under which 28 2 proceedings is initiated is Form 8. The same form is used for initiating proceedings under 28 3. So, you need to understand in 28 there are different proceedings 28 2 is where the applicant alone or applicant jointly with the inventor can apply, in 28 3 any other person who is neither the applicant nor the inventor the aggrieved inventor can apply. So, in both cases you use Form 8. Rule 67 1 tells us that a claim under 28 3 shall be made in Form 8 and shall be accompanied by a statement setting out the circumstances under which the claim is made because the statement and claim is not required under a 28 2 proceeding because they are connected parties, you are either an applicant or the alleged inventor.

So, you are connected to the proceeding. In 28 3 it is a third party you was making it that is why we require a statement. So, the difference between rule 66 and 67 is that because 67 involves a third party a statement setting out the circumstances is required. 67 2 a copy of the claim and the statement shall be sent by the controller to every applicant for the patent not being the claimant, and to any other person whom the controller may consider to be interested. So, once in 23 proceeding he shall sell copy to all the parties interested including the every applicant if and any party who may be interested.

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Now, we saw the this certificate 28 7 talks about a certificate its one of the few provisions, where you can rectify a error the controller has power to make clerical errors he has power to correct mistakes and clerical errors controller generally has a power, but process of rectification like filing a petition and getting something rectified, this is one of the provisions where you can rectify, and by rectification we mean something else is on record and you want to correct that.

So, this certificate operates like a rectification procedure, and if you compare the language of this provision 28 7 with the language in section 71 which is rectification of the register, this proceeding will also result in the rectification of the register because eventually the controller will have to rectify the specification and the register. Now you will see that the appellate board can be approached by an aggrieved person in the absent or omission from the register of an entry, we buy any entry made into the register without sufficient cause, by any entry wrongly remaining in the register or by any error or defect in the entry in the register.

So, the register can be corrected and we are talking about all these instances after the grant and 28 use are 28 has to be done before the grant. So, the question if somebody ask that a person is wrongly mentioned as he inventor, but the patent is granted what are his options. You see that a person is wrongly mentioned as the inventor and a patent has

been granted what are his option file 28 2, because he knows the applicant the applicant is willing to help or if the applicant is not willing to well he files 28 3 as a third party.

Then section 71 proceeding before the I p p all those choices. So, now, you know that 28 is where it comes into play before the grant, after the grant naturally the question comes what if something happens and how do your 71 is the answer. So, in 68 again for the certificate no 68 pertains to 28 7 which is to rectify an error which has already been carried out, and the person who request is asking for a he is asking for a certificate. So, he does the same thing he files form 8 and because he is a third party there is a statement.

So, understand that statement is required when you have already not a party to the proceeding, you are a third party a statement is required. Applicant no statement applicant along with the aggrieved inventor no statement required. So, statement is required because you are a third party entering into the proceeding, now they could be another question in how many proceedings under the patents act can third parties intervene before the grant of a patent.

Piezo under 25 1 third parties can intervene any person, this 28 7 and 28 3 or 2 instances where a person interested a third party can intervene in to the prosecution, that is more important because normally we understand a prosecution as an as a proceeding between the controller others a patent office and the applicant. Third parties are normally not allowed a third parties may be allowed in some cases and this is yet another case 28 3 and 28 7 all instances where third parties may be alone. So, the choices could be 28 3, 28 7, 25 1 and so on.

68 2 tells us that a copy of the application and the statement shall be sent by the controller to each patentee or applicant for patent as the case may be and to any other person whom the controller make considered to be interested. From the language of 68 2 you can understand that it is a small detail in 68. 68 2 tells us that a copy of this application and the statement shall be sent by the controller to each patentee or the applicant for patent as the case may be, which means 28 7 can be instituted even after the grant of a patent.

Because the otherwise the status of a patentee will not be mentioned here and in fact, the provision that we saw in 28 4. 28 4 covers 28 2 and 28 3, because 28 4 says a request or claim under the foregoing provisions that is 28 2 and 28 4 of the section shall be made

before the grant of a patent. 28 2 and 28 3 alone pertain to before the grant of a patent 28 7 proceeding can be anytime, the certificate can be anytime because rule tells us that a notice can be issued even to the patentee which mean the patent has been granted at that stage. So, so that needs to be checked that 28 7 is not a proceeding before grant, 28 2 and 28 3 are proceedings before grant because 28 4 tells us that the request under the foregoing provisions that is 1 2 8 3 of the section shall be made before the grant of a patent ok.

So, when we are talking about 28 7 proceeding for a certificate, it can be either before or after the grant. Even the language of 28 7 tells us may at anytime apply to the controller for a certificate anytime there is no time stipulation that it should be before the grant. So, even this provision ride along with the rule which says patentees can be notified as the case may be tells us that the certificate or the rectification can be done even after the grant. It can be done even after the grant before the controller then you have a second option if you want to rectify the register alone and you can go to the I p a b the I p a b may not rectify the specification.

So, that is a difference that we define here, here the controller may ask the specification to be rectified and the register to be rectified where as we saw in 71 it is a procedure for rectifying the register. Rule 69 procedure for hearing of claim or in application under section 28.

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The procedure specified in rules 55A and 57 to 63 relating to the filing of notice of opposition, written statement, reply statement, leaving evidence, hearing and cost shall, so far as may be, apply to the hearing of a claim or an application under section 28 as they apply to the opposition proceedings subject to the modification that reference to patentee shall be construed as the person making the claim, or an application, as the case may be.] **57-63**

70. Mention of inventor **S. 28(1)**

Any mention of the inventor under sub-section (1) of section 28 shall be made in the relevant documents in the following form, namely: -

“The inventor of this invention/substantial part of this invention within the meaning of section 28 of the Patents Act, 1970, is _____ of _____”

CHAPTER VII
SECRECY DIRECTIONS

NPTEL

The procedure specified in rule 55 a and 57 to 63 relating to filing of notice of opposition written statement reply statement, leaving evidence hearing and cost shall so far as may be applied to the hearing of a claim or an application under section 28 as a apply to opposition proceedings subject to modification, that reference to patentee shall be construed as the person making the claim or an application as the case may be. Now there is a general rule that we need to keep bear in mind, rule 55 A onwards or rule 55A and rules 57 to 63 generally talk about the procedure in a post grant opposition, a post grant opposition as an opposition filed under section 25 2. So, post grant opposition is the ideal example of an contentious proceeding before the patent office it is an ideal example.

Because there are two parties both the parties are formally enter into the proceeding they file their evidences the controller hears them and gives a decision this also no opposition board in those proceedings, but here both the parties have a remedy in appeal and both the parties are heard by the controller. So, because post-grant opposition is an ideal template for conducting proceedings where two parties are involved before the controller. The rules applicable for post grant proceedings are applicable even another proceeding where two parties may be involved. So, the same rules like rules as in how to start the proceeding by filing a form filing the statement by the opponent, then the patentee files is reply then the opponent gets a chance to file a reply to the reply, then they will be a hearing then they will be evidence, the evidence will be closed if you want to file evidence beyond that then there is a procedure for that you have to seek special permission then they will be a hearing and they can be an order on cause also.

So, all the sequence that we saw an post grant opposition will apply not only for rule 69 that is a proceeding under 28, but it will also apply for various other proceedings like surrender for instance compulsory licensing. So, understand that wherever there are two parties one party being the patentee and the third party, any proceeding involving a patentee and a third party or an applicant and a third party, the procedure to be followed will be the procedure for post grant opposition.

But the procedure has not how do you add use evidence who files first what is the time frame for filing the reply what is the time frame for giving the reply to the reply, and fixing the hearing, notice of hearing end of evidence at work beyond that how do you adduce evidence all these formal procedures can be extrapolated can be changed or

modified to apply for every proceedings. So, if its 28 proceeding you do not call that person in opponent you call the claimant and still the claimant will file a statement, the applicant whoever wants to opposite will file their counter and the climate will get another chance to make a statement based on certain issues, and they will be a hearing, they will be evident settle be given, there will be a hearing notice, they will be an order, and there will be there can be a state of finding on costs.

So, this provision says that if you are conducting a proceeding under 28, those procedures will apply who will start first, who will reply, what is the time line notice of hearing all those 10 days notice so, that is what this means. You just saw that feeling of notice of opposition written statement reply statement leaving evidence hearing cost all these things will be governed by those rules, but with small changes because there is no notice of opposition here, here it is a form 8.

So, in that case it is form 7 that is forwarded along with the statement, here form 8 is forwarded along with the statement. So, those changes now normally there is an hearing in a post grant opposition the post grant opponent and the patentee are alone notice sent only for those two entities. In 28 7 notice could be sent to even interested people we saw that.

So, we are only talking about hearing and notice of hearing, but to whom it is sent will be decided by the kind of proceeding, because in 28 notice can be sent to applicants notice can be sent to inventors, notice can also be sent to interested whom the controller feels is interested we saw that whereas, in post grant notice can only be sent to two parties the post grant opponent and the patentee there is no third party. So, so these modification that word it is says subject to modification that reference to patentee shall be construed as a person making the claim or application as the case may be.

So, those subject to modifications these provisions will apply, and rule 70 tells us the form in which the mention has to be made. Any mention of an inventor under 28 1 shall be made in the relevant documents that is complete specification and the register in the following form the inventor of this invention sub slash substantial part of this invention within the meaning of section 28 is dash of dash. Now this is the way in which mention of invention has to be carried out.