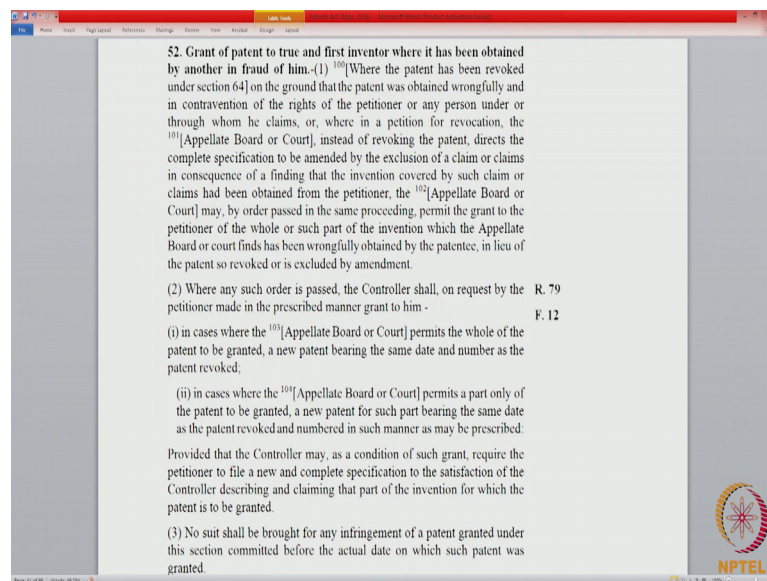


Patent Law for Engineers and Scientists
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Lecture - 50
Patent Prosecution: Practice at the Patent Office
Patent obtained by Fraud of True and First Inventor

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Section 52: grant of patent to true and first inventor where it has been obtained by another in fraud of him you will recollect there was a provision which we had seen under section 26 where in cases of wrongful obtaining or where the invention is wrongfully obtained from a person the controller had the power to substitute the right owner as the owner of the patent, and that person who file the post grant opposition seeking the revocation of a patent under the ground that the invention was wrongfully obtained can now become the patentee by substitution of his name in the register of patents. So, that was a case where an applicant who files for a patent and got the patent granted, but he was not entitled to it.

The person who was the genuine owner of the patent could first file an opposition under section 25 2 get the patent revoked and then ask the controller to substitute him as the owner of the patent that was in the context of opposition proceedings section 52 is in the context of revocation after a patent is granted within one year there could be a post grant

opposition file for revoking a patent the consequence of post run opposition this revocation, because we had seen that in section 25 2 pursuant to oppose grant opposition the controller can revoke the patent. So, the consequence of a revocation proceedings under section 64 and post grant opposition proceedings under 25 2.

One of the consequences could be revocation of the patent because we are talking about a patent that has been granted. Now let us look at 52. So, the difference between section 26 and section 52 is that in 26 the revocation happens by opposition after the grant or post grant opposition in 52 the revocation happens under section 64. Now let us see how this proceed 52 1 where a patent has been revoked under section 64 on a ground that the patents was wrongfully obtained and in contravention of the rights of the petitioner or any person under or through whom he claims.

Or where in a petition for revocation the appellate board or court instead of revoking the patent directs the complete specification to be amended to the exclusion of the claim or claims in consequence of the finding that the invention covered by such claim or claims has been obtained from the petitioner. The appellate board or court may by order passed in the same proceeding permit the grand to the petitioner of the whole or such part of the invention which appellate board or could find has been wrongly obtained by the patentee in lieu of the patent. So, revoke or excluded by amendment.

So, this provision is the same as 26. In 26th we saw that if the whole patent is wrongfully obtained then the whole patent could be granted in the name of the opponent. In this case again if the whole patent is granted instead of revoking the patent the appellate board or the court can substitute the petitioner that is the person from whom the patent was wrongfully obtained as the owner of the patent.

Now, in cases where it is not the whole patent that is wrongfully obtained, but only a claim then the appellate board or the court can ask for the exclusion of those claims by amendment and grant those claims to the petitioner what has been excluded by amendment. So, there are 2 cases here the first cases where the entire invention is wrongfully obtained then the entire invention can be instead of revoking the invention the appellate board or the court and when we see court here it means the court were a claim for revocation is made and we will see that a claim for revocation of a patent or invalidation of a patent can be made in an infringement suit as a counter claim.

So, revocation under section 64 can happen either before the appellate board or before a court which is deciding the infringement case. So, revocation can be taken as a defense for infringement. So, the 2 consequences if the patent is revoked by the appellate board or the court on the ground that it was wrongly obtained if the entire invention is said to have been wrongly obtained then the petitioner will now shown as the owner of the invention the appellate board or the court can permit the grant to the petitioner of the whole or such part of the invention which means if the whole invention is been wrongfully obtained the petitioner will become the owner of the whole invention he will be now make the owner.

If only a part of the invention was wrongfully obtained then the appellate board or the court will order amendment of that patent remove the claims that way wrongfully obtained and grant then to the petitioner 52 2 where such order pass the controller shall on request by the petitioner made in a prescribed manner Grantham one in cases where appellate board or court permit the whole of the patent to be granted in new patent where in the same date and number as the patent revoked 2 in cases where the appellate board or court permits only part of the patent to be granted a new patent for such part bearing the same date as the patent revoke a number in such manner as may be prescribed.

Now, for this to happen the petitioner has to make a request under form 12 to the controller. So, 52 1 talks about an order passed by the appellate board or the court the appellate board or the court in a proceeding where revocation was considered instead of revoking the patent grants the patent to the petitioner the entire patent to the petitioner or a part of a few claims to the petitioner now with that order the petitioner will have to approach the controller because the controller is a person who maintains the register of patents and the register of patent has to be corrected for the record to be set straight.

So, even if the appellate board or the court passes an order in favor of the petitioner the petitioner will still have to approach the controller to correct the record now that is done by form 12. Now the question arise form 12 is filed pursuant to a b c and d choices pursuant to a preceding under section 25 2 proceeding under section 64 the proceeding under section 25 1 none of the above. So, form 12 is always filed pursuant to a revocation under section 64.

So, you cannot file form 12 unless the patent has already been revoked and we are not talking about revocation by the controller, but we are talking about revocation by the appellate board or by the court. So, in cases where the whole patent is granted to the petitioner a new patent will be issued to the petitioner bearing the same date and number as a patent revoke the patent revoked the number will remain the same the date will remain the same, but the name will be of the petitioner the name will be substituted. So, this a new patent will be granted, but in the name of the petitioner.

Same number same date, but the petitioners name will be different this is where the entire patent is entire invention is obtained in cases where the appellate board or the court permits only part of the patent to be granted meaning which few claims which way wrongfully obtained to be granted a new patent for such part bearing the same date as the patent revoked and numbered in such manner as may be prescribed. So, in this case the date will be the same, but the number will be different the name of the patentee will also be different.

Now, you can see this as a or a similar analogy to what is happening in this provision will be instances where the patent office can divide an application under section 16 the patent office can divide an application separate the claims into 2 different applications grant them with different number they will have different numbers they will have the same date, but different number here because they were claims that were taken the controller will have to do a similar exercise of dividing the application, but in this case the owners will also be different.

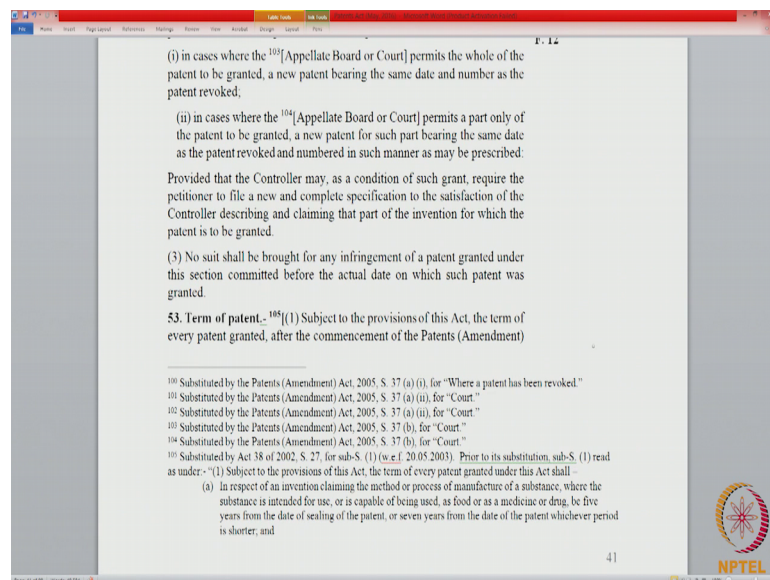
In a divisional application the owner will be the same because there was more than one invention the controller will have to separate it here again there is more than one invention in the sense that invention belonging to different people in section 16 there was more than one invention, because there we were talking about invention has been one invention the rule is one invention per application the applicant included 2 inventions in an application because there was more than one invention the controller divided it

This we do not call it a divisional because the divisional and the parent belongs to the same person here the divisional, but this is a kind of dividing the claims are taken off and granted a patent you cannot grant a patent it just a claims the descriptive part should also be there. So, that claim will get the benefit of the description from the other persons

patent and the patent will be granted having the same date. So, we had mentioned that in a divisional it is antenatal the divisional gets antedated here again when you see them word such part for bearing the same date as the patent revoked is again a case of anti date the new patent granted to the petitioner bearing those claims you cannot envisage a patent having only the claims.

So, it is understood that it will also have a descriptive part and the descriptive part has to be the same like how the descriptive part description in a divisional will be the same the only thing different in a divisional and the mother will be the claims similarly here the only thing different will be the claims.

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But unlike section 16 where the applicant was the same person for the mother and the divisional here the applicant will be 2 different persons provided that the controller may as a condition for grant require the petitioner to file a new and complete specification to the satisfaction of the controller describing and claiming that part of the invention for which the patent is to be granted now if the controller is going to grant only the claim in the name of the petitioner then the petitioner can have to file a new and complete specification to the satisfaction of the controller describing and claiming the part of the invention for which the patent is granted of the claims should be different, but the technology the claims should be different, but what is disclosed there will be an overlap between the earlier application and the application filed by the petitioner.

So, the controller shall require the petitioner to file a new and complete specification to the satisfaction of the controller describing and claiming that part of the invention. So, the new application which the petitioner will have to file will have a descriptive part and the claim the claim will be taken from the earlier part the descriptive part we can assume that there will be some kind of a overlap the destructive part cannot be taken from the earlier application because earlier application belongs to another person. So, here the descriptive part will be will have to be freshly generated by the petitioner.

Three no suit shall be brought for any infringement of a patent granted under the section completed before the actual date on which such patent was granted now the grant date will be different for an application that was filed originally and granted and the petition that was filed for revocation pursuing to that petition if the patent is granted in the name of the petitioner the grant date will be different let us look at sub section 2 2, what is highlighted. Now the appellate board or the court permits only part of the patent to be granted. So, if the petitioner is granted a part of the patent the petitioner cannot bring an infringement of the patent granted before the actual date of the grant which means normally you can only file a suit for infringement after the grant in this case there were 2 grants.

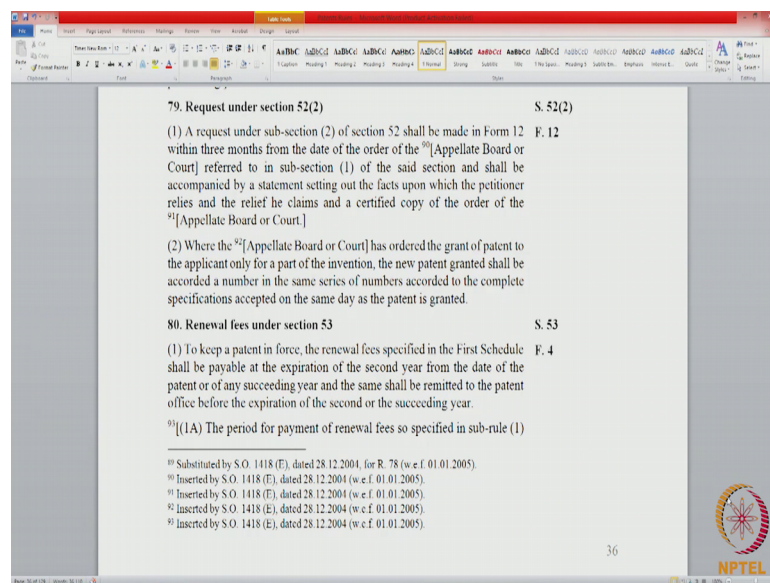
The first grant happen in the name of the person who wrong fully obtained the patent and then the petition filed a revocation and it got granted in his name. So, there are 2 grants 2 grants because first the patent as it was filed by the person who wrongfully obtained their invention the patent got granted then the petitioner filed a revocation saying that claim 2 and claim 5 should not have been given to him its it should belong to me, and the court cases case 2 and 5 belongs to you and he approaches the patent of its with form 12 asking the controller to grant claim 2 and 5 as a separate patent the controller will say you file a fresh complete specification description and claim.

I will grant it to you now that grant is going to happen in a different date it is different from the earlier grant which is now revoked. So, this grant you can only file a case for infringement after this grant date you cannot say that because a patent was already granted because that patent was revoke a revoked in the sense that the claims were removed and transfer to another patent.

Now, a person who has the second grant or in whose name who substituted or who has become the owner of claims 2 and 5 cannot make a suit for infringement based on the earlier grant he has to have he can only make a suit for infringement after the date on which his name appears as the patentee that is the fundamental rule you can only make a case for infringement the day you become the patentee. So, the petitioner soon after revocation was not the patentee he became the patentee only after filing form 12 and the patent office asking him to file a pet complete specification with the claims and that resulting in a grant.

So, in this case understand that there are 2 grants subsection three says that no suits shall be brought for any infringement of a patent granted under the section committed before the actual date on which such patent was granted. So, if there was an instrument before that date there cannot be an action on an infringement before the actual date of grant.

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Rules 79 request under section 52 2 in section 52 2 we had seen that request could be made to the controller on using form 12 and one of the prerequisites for using form 12 is that they should have been a revocation of a patent for under 64.

79 1 states that a request under 52 shall be made in form 12 within three months from the date of the order of the appellate board or court refer to in subsection 1. So, section 52 2 requires a proceeding under 52 1 and 52 1 is nothing, but a revocation action taken under 64 pursue into which the appellate board or the court comes to a conclusion that rather

than revoking the invention the invention can now be given in the name of the petitioner it can be granted in the name of the petitioner and shall be accompanied by a statement setting of the facts. So, that what are the things required the form 12 has to be made three months from the date of order it shall be accompanied by a statement setting of the facts upon which the petitioner realize and the relief he claims and a certified copy of the order of the appellate board of the court.

So, there is one timeline and three conditions the timeline is three months from the order of the appellate board of the court the three conditions are one there has to be a statement setting of the facts the petitioner will have to say what really claims saying that the patent should come should be granted in my name or saying that; so claims have to be granted in my name as a separate patent the third condition is a certified copy of the order of the applet board of the court has to be accompanied 79 2 where the appellate board as order the grant of a patent to the applicant only for a part of an invention the new patent granted shall be accorded a number in the same series of numbers accorded to the complete specification accepted on the same day as the patent is granted.

Now, when a part of an invention is granted there is there is no doubt as to what happens when the entire invention is given to the petitioner it will be re number and it will be given as a fresh patent, but when a part of a patent is granted 79 2 6 that the new patent shall be accorded a number in the same series of numbers according to the complete specification accepted on the same day as the patent is granted this refers to the grant of the patent in the earlier case, because in this situation there will be 2 existing patents one the patent belonging to the person who wrongfully obtained, but only a part of the invention was obtained the remaining part rightfully belongs to that person and then you have the other part which is now becomes a separate patent in itself.

So, when a part of a patent becomes a separate patent in itself then it shall be accorded number in the same series of numbers according to the complete specification accepted on the same day as the patent is granted, because the date remains same, because the date remains the same it should have number in the same series of numbers accorded to the complete specification. So, let us something which the patent office will look at.