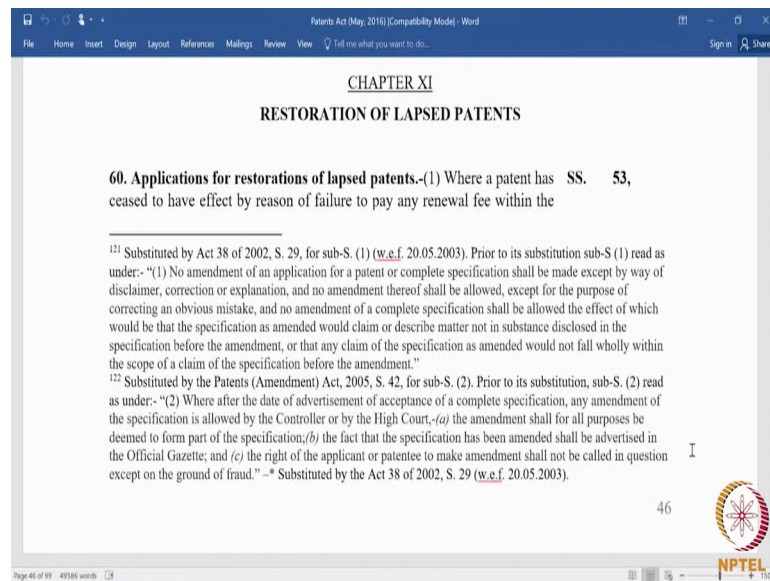


Patent Law for Engineers and Scientists
Prof. Feroz Ali
Department of Management
Indian Institute of Technology, Madras

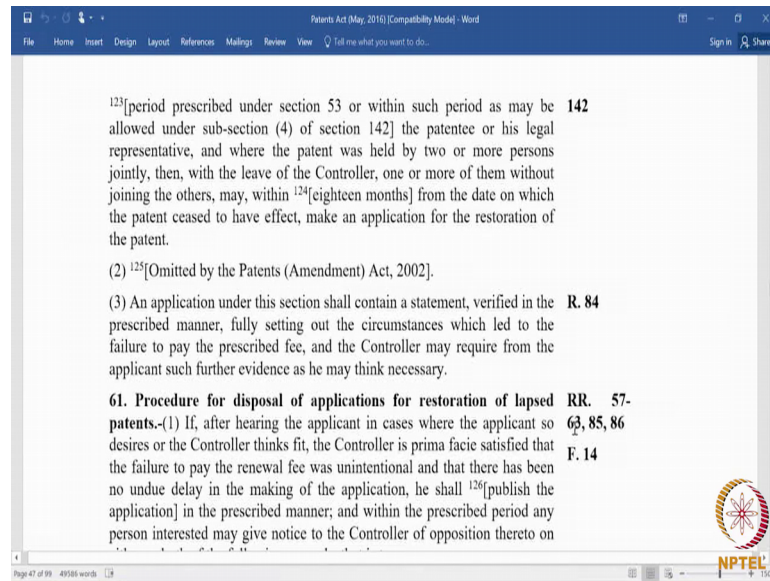
Lecture - 52
Patent Prosecution: Practice at the Patent Office
Restoration of Lapsed Patents

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Restoration of lapse patents, there will be instances where a pattern may become lapsed for nonpayment of fee now patents can cease to have affect by reason of failure to pay the renewal fee on time. There is a procedure to revive or to restore those patents which have a lapsed or which have ceased. Section 60: deals with the provisions under which you can restore a lapsed pattern.

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Where a patents have cease to have effect by reason of a failure to pay the renewal fee within the period prescribed the patent or his legal representative and where the pattern to sell by two or more people with the leave of the controller one or more of them without joining with others may within 18 months from the date of the patents cease to have effect make an application for restoration. So, the restoration application has to be made 18 months from the date on which the patent ceased.

Now the application should contain a statement verified in the prescribed manner fully setting of the circumstances which led to the failure to pray the prescribed fee and we require the applicant for such evidence the controller can ask for further evidence. Now there is a procedure which is mentioned in section 61.

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(3) An application under this section shall contain a statement, verified in the prescribed manner, fully setting out the circumstances which led to the failure to pay the prescribed fee, and the Controller may require from the applicant such further evidence as he may think necessary. R. 84

61. Procedure for disposal of applications for restoration of lapsed patents.-(1) If, after hearing the applicant in cases where the applicant so desires or the Controller thinks fit, the Controller is prima facie satisfied that the failure to pay the renewal fee was unintentional and that there has been no undue delay in the making of the application, he shall [publish the application] in the prescribed manner; and within the prescribed period any person interested may give notice to the Controller of opposition thereto on either or both of the following grounds, that is to say, - F. 14

(a) that the failure to pay the renewal fee was not unintentional; or

(b) that there has been undue delay in the making of the application.

(2) If notice of opposition is given within the period aforesaid, the Controller shall notify the applicant, and shall give to him and to the opponent an opportunity to be heard before he decides the case. R. 85

(3) If no notice of opposition is given within the period aforesaid or if in the case of opposition, the decision of the Controller is in favour of the applicant, the Controller shall, upon payment of any unpaid renewal fee and

Now, if the controller is satisfied prima facie satisfied that the failure to pay the renewal fee was unintentional and there has been no undue delay in making the application he shall publish the application in the prescribed manner and within the prescribed any person interested may give notice to opposition again. If a patent gets lapped or it ceases for nonpayment of fee then the controller will have to publish that and allow oppositions if somebody opposes it then there will be an opposition procedure based on that.

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61. Procedure for disposal of applications for restoration of lapsed patents.-(1) If, after hearing the applicant in cases where the applicant so desires or the Controller thinks fit, the Controller is prima facie satisfied that the failure to pay the renewal fee was unintentional and that there has been no undue delay in the making of the application, he shall [publish the application] in the prescribed manner; and within the prescribed period any person interested may give notice to the Controller of opposition thereto on either or both of the following grounds, that is to say, - F. 14

(a) that the failure to pay the renewal fee was not unintentional; or

(b) that there has been undue delay in the making of the application.

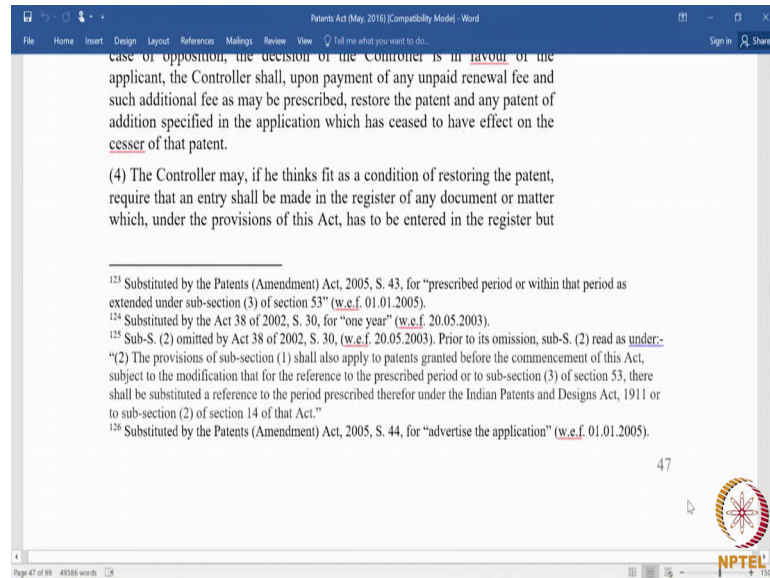
(2) If notice of opposition is given within the period aforesaid, the Controller shall notify the applicant, and shall give to him and to the opponent an opportunity to be heard before he decides the case. R. 85

(3) If no notice of opposition is given within the period aforesaid or if in the case of opposition, the decision of the Controller is in favour of the applicant, the Controller shall, upon payment of any unpaid renewal fee and such additional fee as may be prescribed, restore the patent and any patent of addition specified in the application which has ceased to have effect on the cesser of that patent.

(4) The Controller may, if he thinks fit as a condition of restoring the patent, require that an entry shall be made in the register of any document or matter

Now, the grounds on which a person any interested person can oppose are very limited - one the opponent can say that the failure to pay the renewal fee was not intentional it was deliberate and there has been an undue delay in making the application.

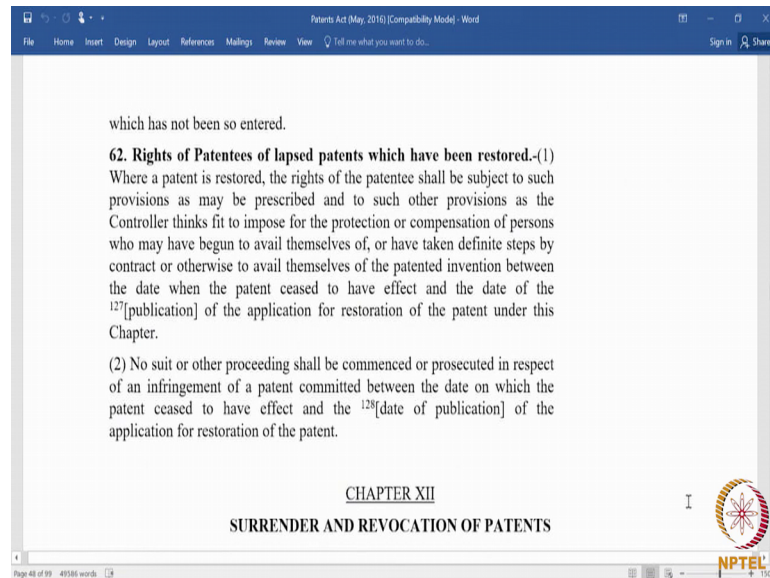
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So, these are the grounds on which the opposition can be made the controller shall notify the applicant shall give him and the opponent an opportunity to be heard before deciding the case. If no notice of opposition is given within the period the decision is in favour of the applicant, the controller shall upon payment of the unpaid renewal fee. So, you need to pay the unpaid renewal fee and such additional fee as may be prescribed restores the patent 4.

The controller may if he thinks fit as a condition for restoring the patent require that an entry shall be made in the register of any document or matter which under the provisions of the act shall be entered in the register which has not been so entered. So, the controller can as a condition for restoration make an entry in the register.

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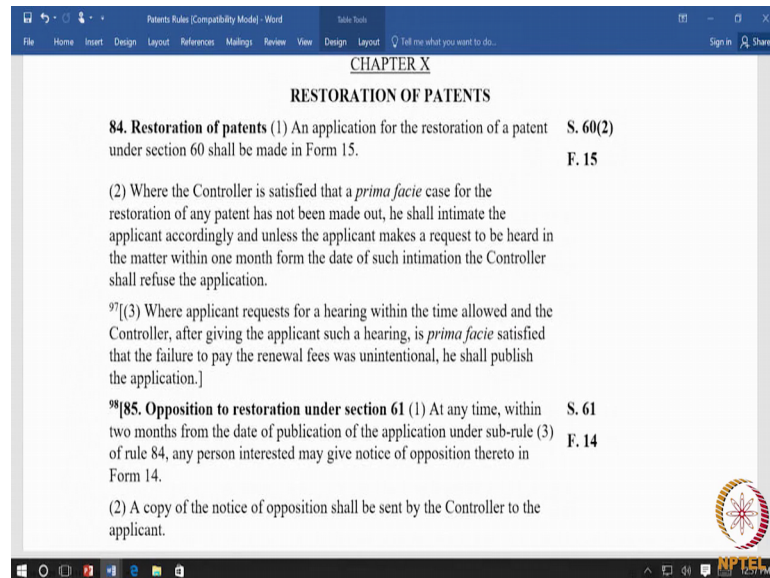


Now, what happens during the time the patent remains lapsed or the patent is ceased? Now when the patent is ceased for nonpayment of fees the patent cannot be enforced. Meaning which during the time in which renewal fee was not paid or the patent was in the condition of being lapsed you cannot enforce it, you cannot file a suit for infringement and you cannot claim damages with regard to infringement acts that could have happened during the period. When a patent is restored the rights of a patentee shall be subject to the provisions as may be prescribed as a controller thinks fit to impose the protection or compensation of persons who may have begin to avail themselves or have taken definite steps by contract or otherwise to avail themselves of a patent invention between the date when the patent ceased to have effect and the date of publication of the application for restoration.

So, the controller can impose protection on compensation of persons who started working because the persons who understood that the patent has lapsed when a patent lapses it falls into the public domain. So, for those persons who were taken some action definite steps by contract or otherwise to avail themselves of the patented invention the controller can take some measures, the controller thinks fit to impose for the protection of compensation of persons who could be affected by the fact that the patent is now restored.

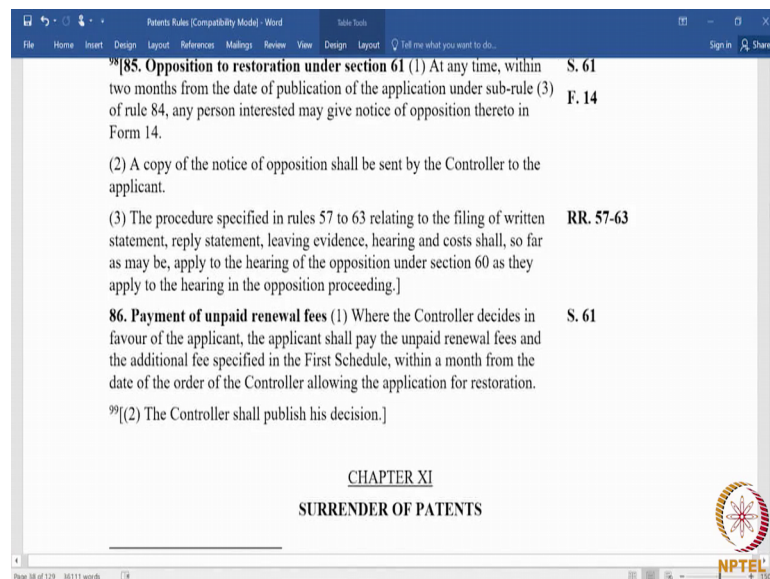
62, two states that no suit or proceeding shall be commenced or prosecuted in respect of infringement of a patent committed between the date on which the patent ceased to have effect and the date of publication. So, the date on which the patent ceased to have effect and the date on which the patent was the publication restoration of patent was published there cannot be any action for infringement or any preceding based on the lapsed pattern.

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Now, restoration of lapse patent, the rules of the corresponding rules are rules 84 restoration application for restoration is filled in form 15 and it has to be published.

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Now opposition, again a notice of opposition is given in form 14 within two month from the date of publication of the application, a copy of the notice of opposition shall be sent by the controller to the applicant and the provisions rules 57 to 63 the same as post grant opposition procedure shall apply.

Now payment of unpaid renewal fees, rule 86 where the controller decides and favor of the applicant applicants shall pay the unpaid renewal fees and the additional fees specified in first schedule within a month from the order of the controller the controller shall also publish his decision.