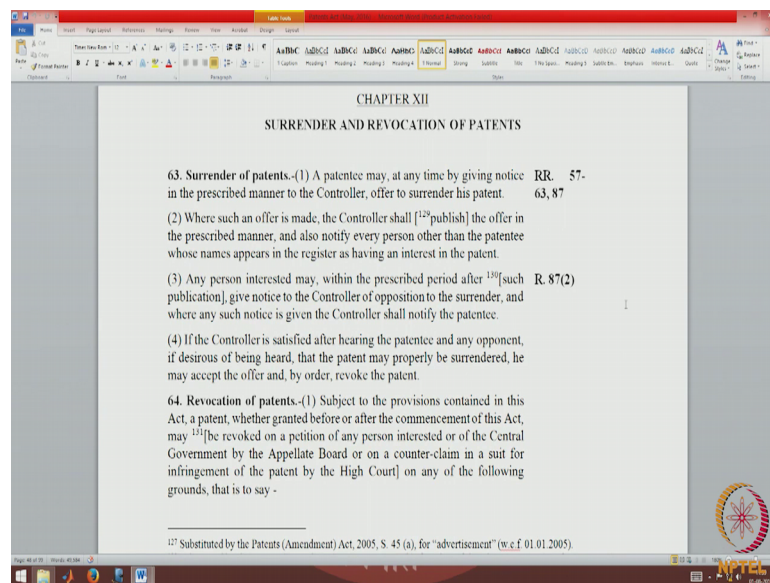


**Patent Law for Engineers and Scientists**  
**Prof. Feroz Ali**  
**Department of Management**  
**Indian Institute of Technology, Madras**

**Lecture - 53**  
**Patent Office and Patent Prosecution**  
**Surrender of Patents**

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Surrender of patents section 63 deals with the surrender of patents. A patent can be surrendered by the patentee before the patent office there is a procedure for surrendering a patent. The consequences surrendering would mean that the patent can no longer be enforced and it sees us to be a private right, which is enforceable against third parties.

So, once a patentee surrenders his patent the patent and all the materials covered by the patent that is the invention of the technology covered by the patent, falls into the public domain. So, surrender is a voluntary act by which the patentee gives up his right in a patent. Right in a patent can come to an end either at the expiry of the term of the patent the 20 of period or it can come to an end when it is not renewed the we are already seen for nonpayment of renewal fees or it can come to an end if there is an in validation proceeding. See an opposition preceding instituted by a third party or a revocation preceding instituted by a third party.

In all these cases the term of a patent can come to an end, surrender gives the option for a patentee to voluntarily give up the patent by a procedure that is established under the patents act and rules. Now let us look at section 63 surrender of patents one, a patentee may at any time give notice in the prescribed manner to the controller offer to surrender his patent.

So, it is by notice a patentee can offer to surrender his patent. Now once such an offer is made the controller shall publish the offer in a prescribed manner and notify every person whose name appears in the register. Now if there are multiple owners to the patent if there are more than one patentee in the register of patents, then if one person chooses to surrender the patent the controller has to give notice to the other parties. So, that the controller can take care of their interest there is also an opposition proceeding because surrender of a patent could involve rights of third parties it could affect the rights of others.

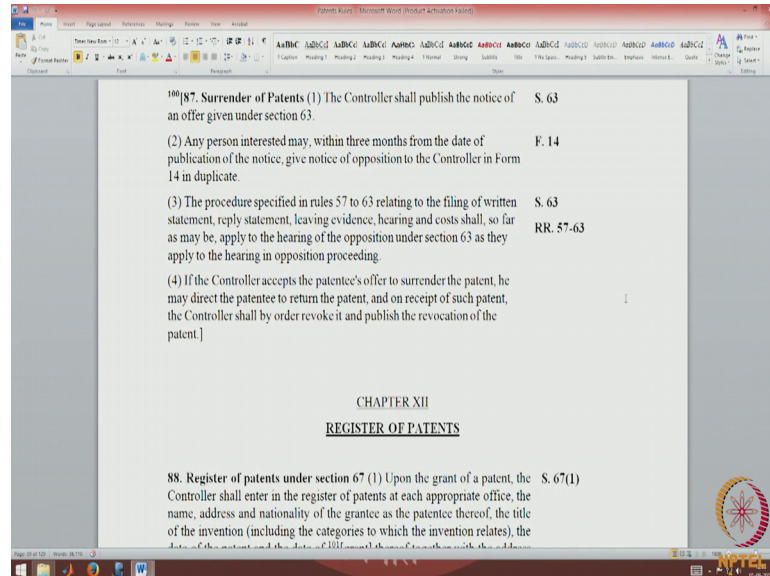
So, any person interested can give notice to the controller of opposition, and as we have already stated the procedure for conducting any opposition under the patents act involved in two parties, will be the same as the procedure for post grant opposition. Section 55 A onwards the same procedure will be followed for any opposition under the patents act involved in two parties. So, there is a provision for opposing the surrender of patents, and if the controller is satisfied after hearing the patentee and the opponent the patent may properly be surrendered he may accept the offer and by order revoke the patent.

Now, this is important to understand, surrender is an act from the patentee to give up his or her patent. So, it is an act it is a voluntary act done by the patentee in approaching the patent office giving notice, and giving the reasons as to why the patent has to be surrendered. Surrender in itself does not revoke a patent, it is important to understand that because section 63(4) tells us that the offer to surrender has to be accepted by the controller and by order the controller has to revoke the patent. So, there is a recent case law of the intellectual property appellate board, where the distinction between surrender and revocation was actually discussed by the intellectual property appellate board.

So, the appellate boards said that an offer to surrender in itself cannot be deemed as a revocation, and the consequences of revocation can be different from the consequences

of a surrender because a surrender is done under section 63 whereas, a revocation proceeding is under section 64 to which we will soon come to.

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Now the procedure of surrender as mentioned in rule 87. Now when an offer for surrender is done by the patentee the controller shall publish the notice of the offer, so that people who are interested may intervene by way of opposition. 2 talks about the opposition the opposition for a surrender of patent is done by under form 14. Form 14 is the form that is to be used when there is a opposition to the surrender of a patent and as we mention the rules from 57 to 63 with generally deal with a procedure of post grant opposition or opposition after the grant, the same rules will apply with regard to written state filing of written statement, reply statement, leaving evidence hearing cost, the same rules will apply in an opposition proceedings that is triggered by a surrender of patents.

Now, if the controller accepts the patentees offer to surrender the patent, he may direct the patentee to return the patent and on receipt of such patent the control may order revoke it, by order revoke it and publish the revocation of the patents. So, when the controller wants to accept the offer the controller will ask the patentee to formally return the patent.

Now returning the patent is nothing but returning the form of the patent which is the certificate in which the patent is issued from 3. So, this involves a return of the patent. So, it is just not surrender is not the symbolic there is some physical activity involved,

which is giving back the patent the patent certificate that was issued and on receipt of it the controller shall revoke it and published the revocation. So, the revocation in a surrender also needs to be published.

So, there are two publications when the surrender proceeding starts, the notice given by the patentee offering to surrender the patent has to be published that is the first publication, the publication of the notice to surrender and pursuant to that when the control comes with an order then the order itself has to be published saying that this patent has now been revoked.

Now, the object of a publication is to operate as notice to the public at last, that a particular patent has now falling in to the public domain.