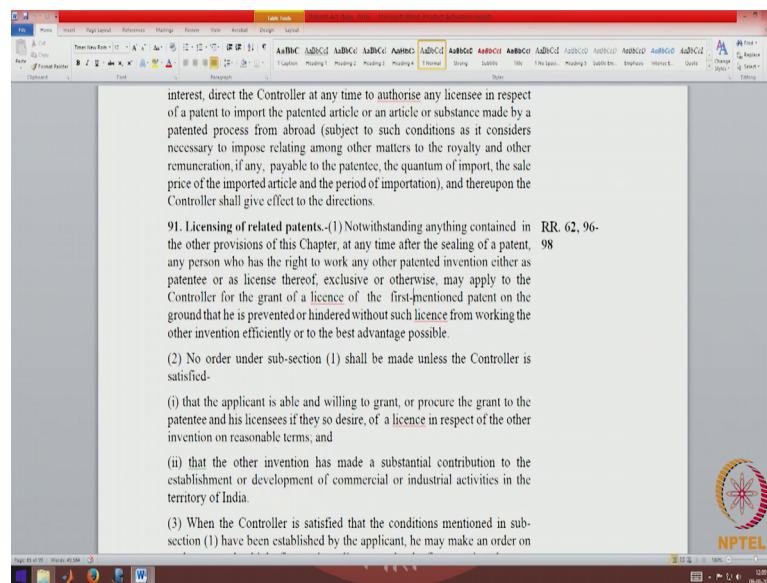


Patent Law for Engineers and Scientists
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Lecture – 65
Compulsory Licensing
Licensing of Related Patents

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Section 91; section 91 deals with licensing of related patterns, this is the second type of compulsory licenses, we had already mentioned that compulsory licences under the patterns act four into four categories. Category number one which is the general category pertains to section 84; the second category is section 91. It is a different type the grounds are different, the operation is different and even the way in which you get a licence the reasons for which you get a licence are also different. Apart from 84 and 91 we have 9 and 92 a. So, these 4 categories comprises the 4 different types of compulsory licenses that can be granted under the act so.

Now, let us look at section 91; before looking at section 91 you need to bear in mind the procedure and the grounds for the grant of a normal compulsory licence what we call the default compulsory license under section 84. We need to bear in mind the grounds on which it can be granted, the procedure that needs to be followed, how long the licence can be kept and the powers of the controller in granting these licences, that is section 84

till section 90 we had already covered them. So, you need to bear the details from section 84 to section 90 in mind so that you understand 91 better, because 91 presents an entirely different picture of four of the use of compulsory licenses

Now, 91 specifically pertain to related patents. Related patents in the sense that you have a patent and in the same field of technology there is a related patent which does not belong to you related in the sense of the technology is so close to your technology or for instance you cannot work your patent efficiently without infringing the other patent or without use of the other patent so, but the only difficulty is that the other patent belongs to another patentee.

So, in such cases you could approach the patent controller, seeking a licence of a related patent. Now the criterion here is that your technology and the technology covered by the related patent another patent is technology should be related to one another, it cannot be chalk and cheese it has to be related it there has to be some connection between these two patterns. In that case if you are not able to work your pattern without seeking a licence from the other person, and the other person is not willing to grant a licence for you to you, then you can approach the controller for a compulsory licence.

So, the ground rather the only ground on which you can seek a patent is that you cannot work your invention effectively, because of another patent and the patentee of the other patent is not granting you a licence and these two technologies or the inventions covered in these two patents are related to each other. Now you will see how different this is from the compulsory licences that are granted under section 84. 84 had certain grounds reasonable requirements not met, affordable price not met not a not work locally, this does not pertain to any such ground the only requirement here is that you cannot work your invention without the use of another person's patent and that patent is not being available made available to you on a licence.

Now, let us look at the details of this section and just how the ground is are different the way in which this operates are also this provision operates is also different. We had seen in 84 that the patent should have been granted and it has to be three years since the patent does grant being granted and only then you can make an application for a licence compulsory licence under 84. 94 does not have a similar requirement and in fact, you could say that 91 does not have a similar requirement.

In fact, you can look at the procedure in 91 it appears to be a fast track procedure; because here is a situation where a patent is available or the patentee is not able to work his invention effectively, not because of any difficulty from (Refer Time: 04:49) because there is another patent and he is not able to get a licence to that pattern. So, this is more like enabling technologies to be worked more efficiently, you might have heard about technology holdup or patent hold up when patterns can be used to hold up, others from working around or working in a particular technology.

So, 91 solves the issue of patent hold up; if you are working in a related technology and if you find that there is another patent that is hindering your working, then you could seek a license.

Now, let us look at the details of this section 91 1. Not with sending anything contained in other provisions of this chapter which includes section 84 and a default section compulsively license under that section, at any time after the sealing of a patent we had already mentioned our ceiling is a remnant of the past which the last amendment did not take care of you should read that as at any time after the grant of a patent. Sealing used to be a step before the grant of a patent now it is no longer relevant, and the last amendment to the patent act actually removed all evidences of sealing except in this chapter the chapter pertaining to compulsory license.

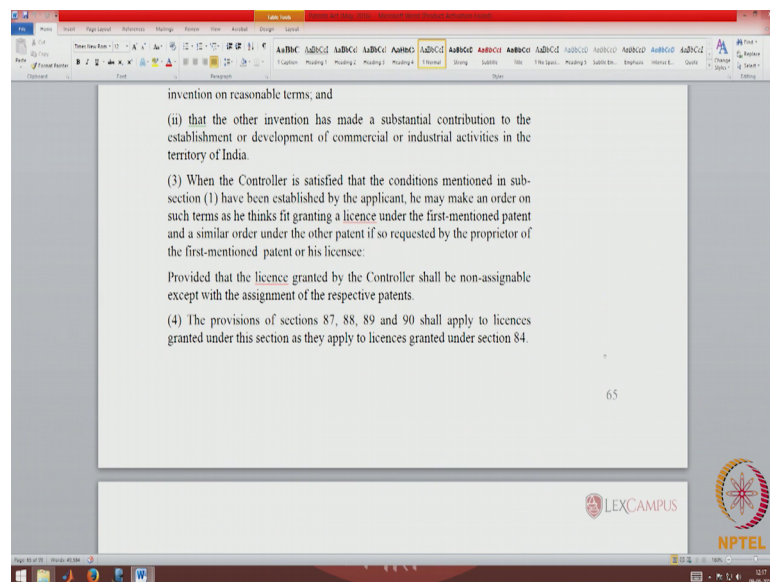
So, we read this at as at any time after the grant of a patent any person who has the right to work any other patented invention either as a patentee or a licensee thereof. So, the requirement under 91 is that you should be able to work up you should have some right to work a patented invention, either on your own as the patentee or as a license or as a licensee exclusive or otherwise. So, it converts both exclusive and on exclusive licenses, may apply to the controller for the grant of a license of the first mentioned patent on the ground that he is prevented or hindered without such a license from working the other invention effectively or to the best possible best advantage possible.

Now, the patentee is not able to work as invention effective without a license of the of another pattern, which belongs to another patentee. 2 no order under subsection one shall be made unless the controller is satisfied one the applicant is able and willing to grant or procure the grant to the patentee and his licensee. If they so desire of a license and respect of the other invention on reasonable terms, this is nothing, but cross licensing.

The applicant who seeks a license of another person's pattern should be willing to grant a license of his own pattern.

So, he should be willing to cross license his pattern and to that the other mean invention has made a substantial contribution to the establishment or development of commercial or industrial activities in the territory of India. So, the other pattern for which this license is sought has made some substantial contribution to the establishment or development of commercial or industrial activities in India. So, the other technology covered by a patent this important one and it has made some kind of a tech contribution for the commercial and industrial activities.

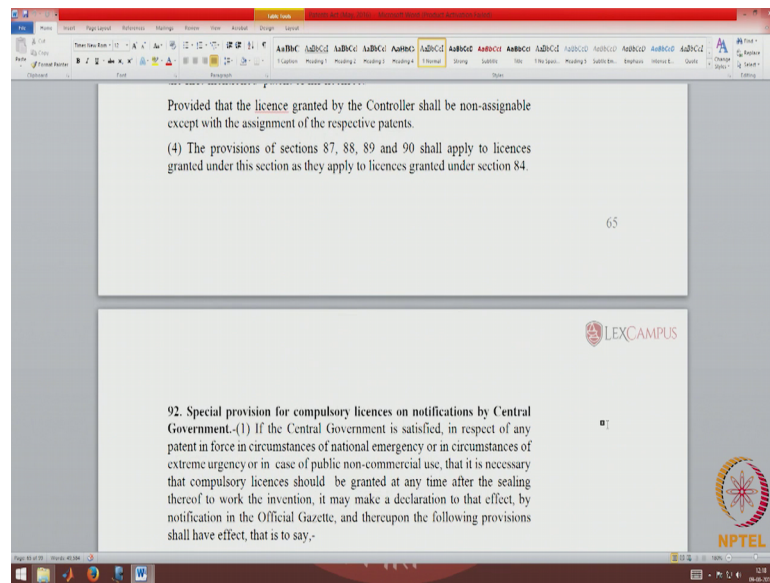
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Three when the controller is satisfied that the conditions mentioned in subsection 1 have been satisfied, by the applicant he may make an order on such terms as he thinks fit granting a license under the first mentioned pattern and a similar order under the other pattern is. So, requested by the proprietor of the first mention patent or his license provided that the license granted by the controller shall be non assignable except with the assignment of respective patterns.

Now, we also saw an assignable clause in section 84, but in this case it shall be non assignable except with the assignment of the respective patent.

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So, the assignment will be (Refer Time: 08:53) patents as well 4. The provisions of section 87 88 89 and ninety and shall apply to licences granted under this section as they apply to licences granted under section 84. Now we saw that there are general provisions under 87 which deals with the procedure to be followed in 84 and 85 and 88. 88 deals with powers of the controller in settling the terms of the licence and 89 deals with the general purposes of for granting licenses and 90 deals with the terms on which for instance we saw that one of the terms on which licence under 84 shall be granted is that the right of the license is non assignable. So, those terms will again apply in cases involving compulsory license under section 91.

Now, what is important here is the grounds in 84 will not apply for a compulsory licence under section 91. So, we saw that they were certain elaborate grounds and we also saw that the grounds were enumerated what reasonable requirement is, it enumerated under subsection 7 of section 84. So, all these details will not apply and the three year time limit will also not apply in case of 91. So, we can understand 91 as a fast track procedure in the sense that the three grounds under 84 need not be satisfied, the three year waiting period is also not there. So, in that sense its fast track and the only requirement is that the applicant needs to show that the patterns are related, and the applicant should be willing to grant a cross licence of his own patent, and the invention for which he is seeking a licence should have made some substantial contribution.