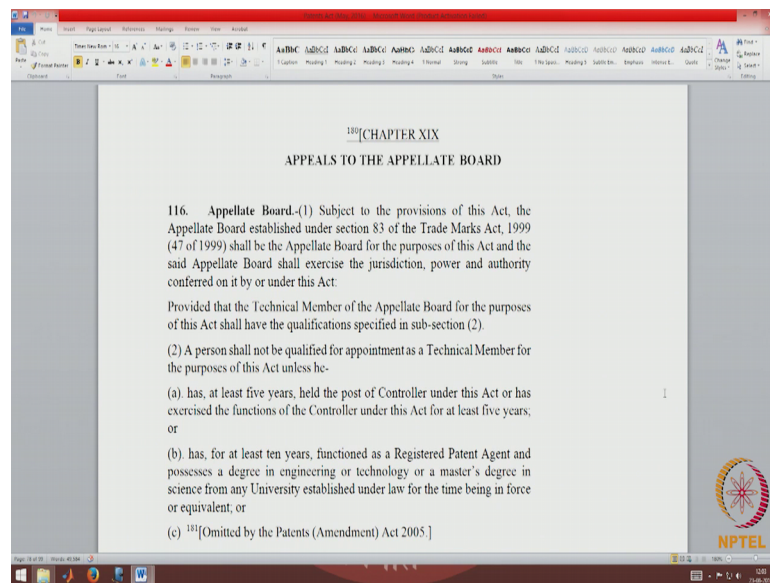


Patent Law for Engineers and Scientists
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Lecture – 69
Patent Enforcement, International Arrangements & Other Miscellaneous Provisions
Intellectual Property Appellate Board

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Appeals to the appellate board; the patent system envisages a system where individuals or even corporate entities can file patent applications and get them granted at the patent office. Now this is a simple system which exists in many jurisdictions around the world; the fact that a person can approach the government or office that is run by a government to get a patent granted to that person's invention. So, we understand from that that patent rights are rights granted by the state or by the government, but sometimes if a person is aggrieved in his interaction with the government, say he approaches an government office to get some registration done and there is a deficiency in the service or he is not happy with the result that comes out of it then there is normally a recourse available to that person to agitate the matter further.

So, in the legal system, we have a system of appeals the system of appeals provides for an appeal is available to an appellate body to correct an error or a mistake that is being content done by the inferior body the decision making body in the patent system appeals

from the patent office lie to the appellate board the appellate board is known as the intellectual property appellate board IPAB and the appellate board was constituted as a common appellate board for trademarks and for patents. So, it was the trademarks act nineteen ninety nine that actually created the appellate board.

The patents act when it was amended, incorporated the appellate board provision recently. Now the question may arise then what was the arrangement before the appellate board came into a force. The arrangement was every matter which could be taken up an appeal over a decision of the patent office would lie as an appeal to the high court to the respective high court. So, the appellate board was created under the trademarks act, but the appellate board for the purposes of discharging; the functions under the patents act was notified only many years later on and this had to be done because when the act took away the powers of the high court and vested in the appellate board the appellate board also needed the personal who could handle that. So, if you look at the appellate board there is a technical member who has a background and patent who sits along with the judicial member the judicial member is also called the chairman.

So, together the bench discharges functions of largely looking at appeals from the patent office, the appellate board can also look into appeals from the central government. We know that in certain cases, the central government is vested with certain powers under the patents act, the appellate board though it is called the appellate board, it also has original jurisdiction. Now the appellate jurisdiction is where there is an existing order passed by an inferior court or by an inferior body which can be taken up in appeal. Now the scope of an appeal is limited you cannot agitate a ground that has not been agitated before the inferior court or organization.

So, in that sense appeal is more like a higher organization or a higher judicial body looking into the decision that is already made by an inferior body. So, appeal is something that there is the mandate is already set, the case is already been decided by inferior body and the superior body looks into the reasoning and the conclusion that the inferior body has come up with and to see whether it stands certain checks, the original jurisdiction refers to the ability of a party to approach with a list by list we mean with an issue to a body for the first time meaning which the matter has not been agitated before in an inferior body or in any other body, but the matter is first introduced for the first time before the decision making body.

So, the appellate board not only has the power to look at appeals from the patent office, it also has original jurisdiction by which, we mean the power to consider matters directly even in the absence of an appeal or even in the absence of an impugned order. An impugned order is an order which is been challenged and it presumes that that order was passed by an inferior body inferior decision making body. So, the appellate board though it is called the appellate board, it also has powers other than deciding appeals. Those powers we refer to them as original jurisdiction of the appellate board. Now the original jurisdiction of the appellate board as we will see in the provisions pertain to 2 broad categories, one it has the power to look at revocation. So, you can file a petition for revocation not an appeal you can file a petition for revocation directly before the appellate board and that can be the first instance your agitating that issue under section 64.

So, that refers to the original power of the appellate board; another original power of the appellate board and original power also means that this power is exclusively vested with the appellate board because there is a power, there is a provision which confers exclusivity on or bar and jurisdiction of the other bodies on the appellate board and this is normally been done because when tribunals takeover functions which were previously discharge by the high courts or by the lower courts, there you will normally find provision where it bars or it prohibits approaching those courts or any other court for relief because now you have a specialized organization discharging this function we do not want a multiple litigation or what is commonly called forum shopping people approaching different forums for getting the same relief.

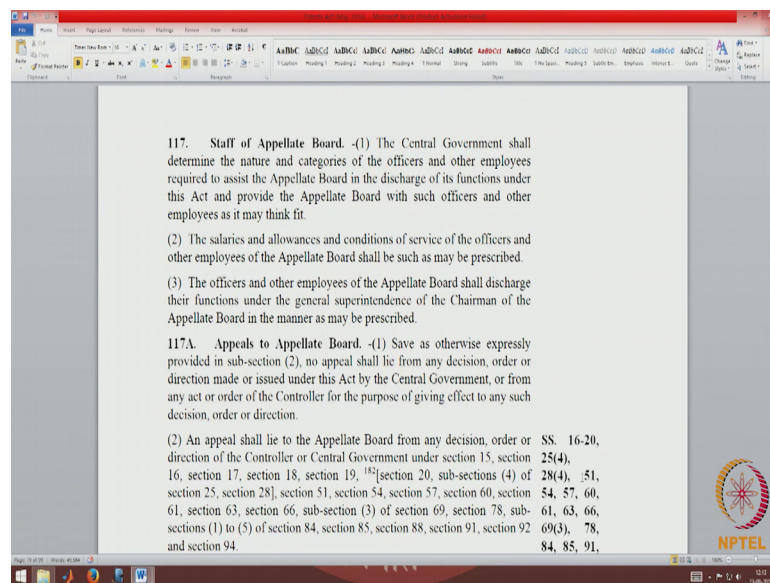
So, you have various bar baring provisions and the appellate board also has a baring provision where you cannot approach any other court for relief except the appellate board. So, the 2 broad original jurisdiction involves the power to receive a petition for revocation and a power to rectify the register rectification proceedings. So, under 64, section 64 and under section 71, the appellate board has power to look into matters even in the absence of an appeal. So, that is what we call an original jurisdiction.

Now, the appellate board 116 tells us that the appellate board is the same board that was established under the trademarks act 1999, but the only difference being that the technical member of the appellate board shall have qualifications pertaining to patent law a in trademark law, the person need not have qualifications pertaining to patent law. So,

that person too tells us that shall not be qualified the person shall not be qualified for appointment as a technical member for the purposes of this act.

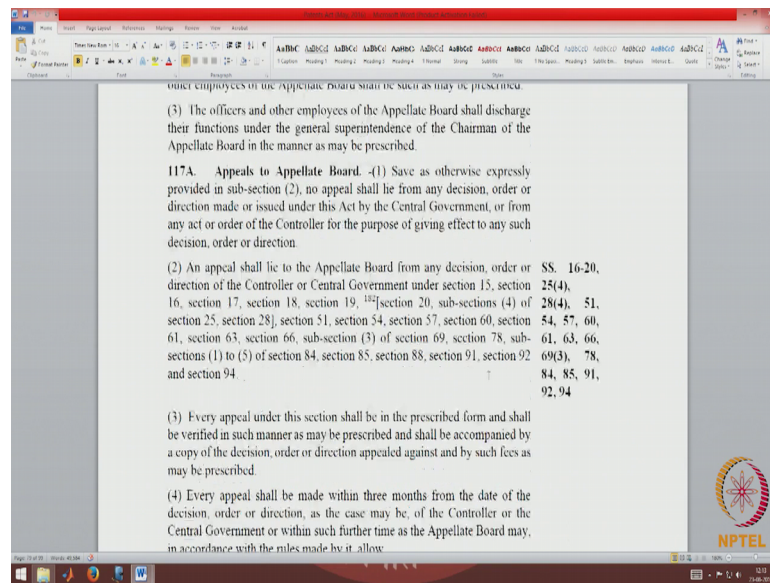
Unless he has 5 years; at least 5 years experience in the post of the controller or at least 10 years functioned as a registered patent agent possessing a degree in technology, Master's degrees in science. Now this is the requirement for a technical member. So, the board appellate board comprises of when it sits discharging the patent function, it comprises of the chairman who is an judicial member and the judicial member could be in many cases, we have seen a retired judges of the judiciary higher judiciary becoming the judicial member or the chairman and the technical member technical member should have some patent related background either as a controller or as a patent registered patent agent.

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Now the board can have its own stuff, the salaries and allowances shall be paid to the employees as it may be prescribed and the general superintendence is given to the chairman. The chairman has the power of general superintendence is also the administrative head and as well as the judicial head of the body.

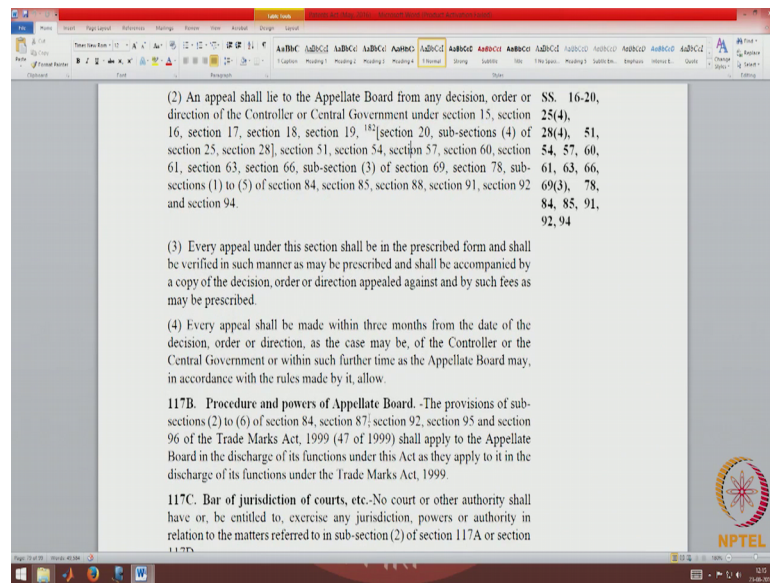
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Now, 117; a lists some of the appeals that can be filed before the appellate board. Now the appeals are with regard to particular matters and 117 A tells us that no appeal shall lie from any decision made under this act by the controller or by an order of the by the central government or by the order of the controller for the process of giving effect of any decision order or direction otherwise as expressly provided. So, what is they can be only an appeal on matters that are expressly provided. Now 117 A 2 gives you the list of matters on which there can be an appeal.

Now, you will see that the appeal can be from any decision order or direction or these are the 2-3 things that can be appealed against from the controller or a central government. So, from we considered them as inferior bodies in the sense that you can file an appeal against decision order or direction of the central government or a decision order or direction of the controller to the IPAB. So, in that sense when it comes to the exercise of judicial or decision making pass these bodies are inferior to the intellectual property appellate board and the sections are given and these are the sections on which they can be an appeal to the appellate board.

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Now the intellectual property appellate board has come up with rules prescribing the manner in which it can be filed. Now we have 2 sets of rules governing this and every appeal shall be made within 3 months from the date of the decision or order and that is the time limit given for filing the appeal.

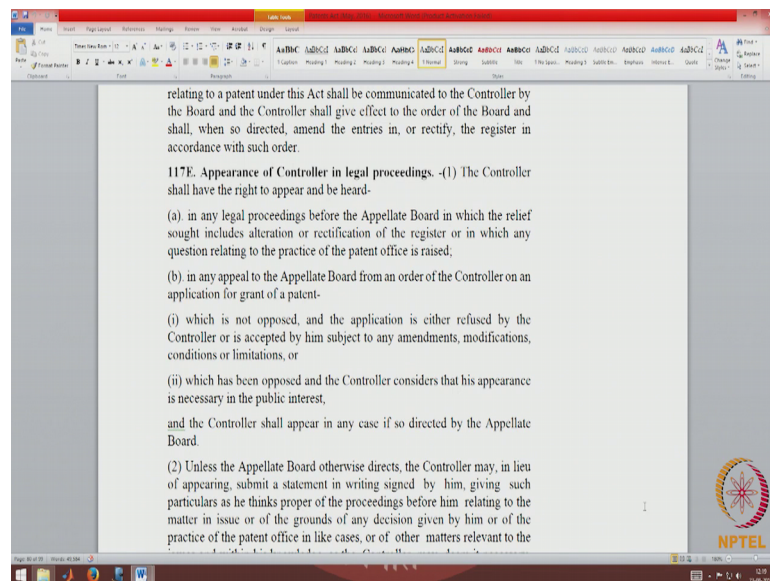
Now, earlier procedure and powers of the appellate board the provision of subsection 2; these are provisions of the trademarks act shall apply to the appellate board in discharge of its function. Now this is when the amendment came in 2005. Now after this, we have had 2 sets of rules; 2 sets of rules and we had already discussed in our initial lectures that these 2 sets of rules will form a part of the syllabus that is covered the intellectual property appellate board patent procedure rules 2010 and the patents appellate appeals an applications to the intellectual property appellate board rules 2011. So, we have the 2010 IPAB rules for short and the IPAB rules 2011; 2 sets of rules they are not very elaborate they run into short pages.

But they are largely procedural. So, you just need to be familiar about what those rules cover and they are largely important for the purposes of practice when you file an appeal or a petition before the appellate board. So, there are no substantive provisions and for that purpose they will not be any questions from those rules in this exam 117 C is the bar provision I said that when specialized organizations are created like tribunal then the tribunal or that authority will bar the jurisdiction it will prohibit parties from approaching

other courts the general courts, this is because one because of the specialized nature of the function that is discharged by the body and 2 earlier these powers could have been vested in the court and one of the reasons for creating the specialized organization would be to transfer the powers from the general courts to this tribunal.

So, which happen in the case of the intellectual property appellate board earlier the power was vested by the high court. So, when there is already been a transfer unless it is made very clear that you cannot go back then you could be in a situation where parties are using the old system and the new system. So, there is an express bar on the jurisdiction of courts no court or other authorities shall have or be entitled to exercise any jurisdiction power or authority in relation to matters conferred in subsection 2 of section 117 A or 117 D is the original size jurisdiction that we had said the power of the appellate board to look at rectification and revocation.

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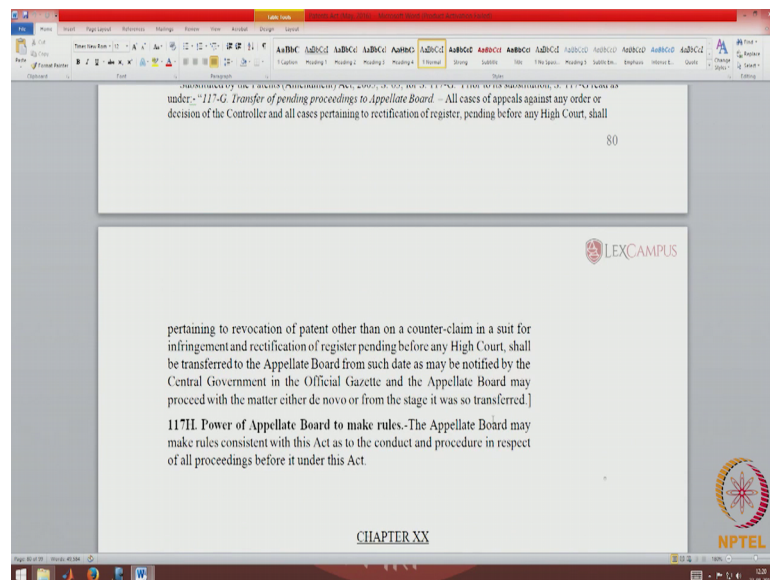
So, the original side or the power to receive matters directly without there being an need to considerate in appeal without being in the role of scrutinizing a lower court order, it is what we call an appeal exist in 2 cases before the IPAB 1 in the case of section 64 and the other in the case of section 71.

64 pertains to petition for revocation and 71 refers to an application for rectification of the register. Now 117 E provides some provisions where the controller can appear before the intellectual property appellate board and the details are given. So, there is a provision

where the controller can be asked to appear before the appellate board, either the controller can appear in person or he can delegate or he can may somebody else can appear on behalf of the controller the cost of the controller in proceedings can be its discretion of the board to a word cause.

Now, I would mention that before the appellate board was created the power that is now vested with the appellate board earlier existed in the high courts. So, when the appellate board was notified and created for the purposes of the patents act, all the matters that work pending in the high court where transferred to the appellate board. Now that came into effect by way of 117 G transfer of pending proceedings to appellate board all cases of appeals against any order or decision of the controller.

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And all cases pertaining to revocation of a petition other than a counterclaim in a suit for infringement and rectification of register pending before any high court shall be transferred to the appellate board from such date as may be notified by the central government.

So, we understand that there is a provision for transferring all the existing matters pertaining to revocation under 64, but it does not pertain to revocation that is raised as a counter claim that will remain in the high court because the high court will have to decide revocation and infringement in one go. So, those matters will not come, but a plane petition for revocation a petition for rectification and all the appeals against the

orders passed by the patent office shall now be transferred to the appellate board. So, we had quite a lot of cases that we are transferred and the appellate board had the power either to look at those matters fresh or from the stage on which it was transferred.

Now, that is what we refer to here as de novo de novo means from the beginning or from the stage it was so transferred. So, that was left to the discretion of the appellate board idea to start the matters are fresh or to take up the matter where they were left the power of the appellate board to make rules we have already mentioned there are 2 sets of rules now on patents rules made in 2010 and rules made in 2011.