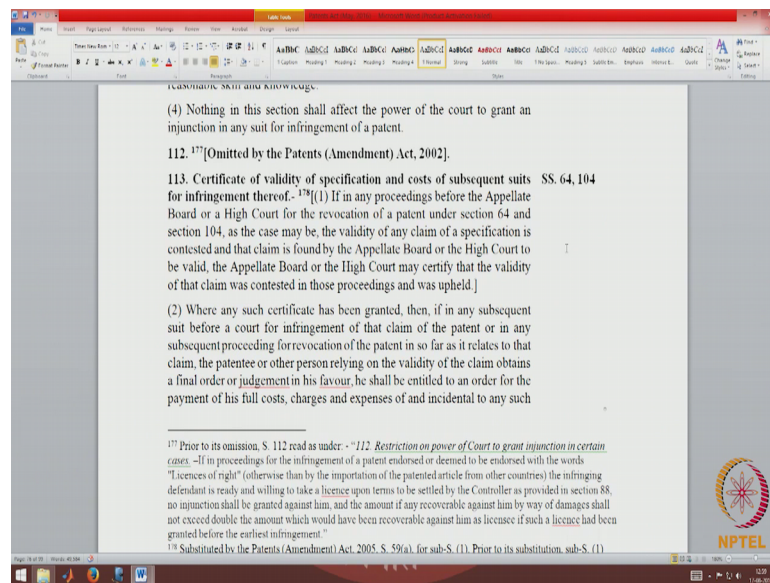


Patent Law for Engineers and Scientists
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Lecture – 74
Patent Enforcement, International Arrangements & Other Miscellaneous
Provisions
Certificate of Validity

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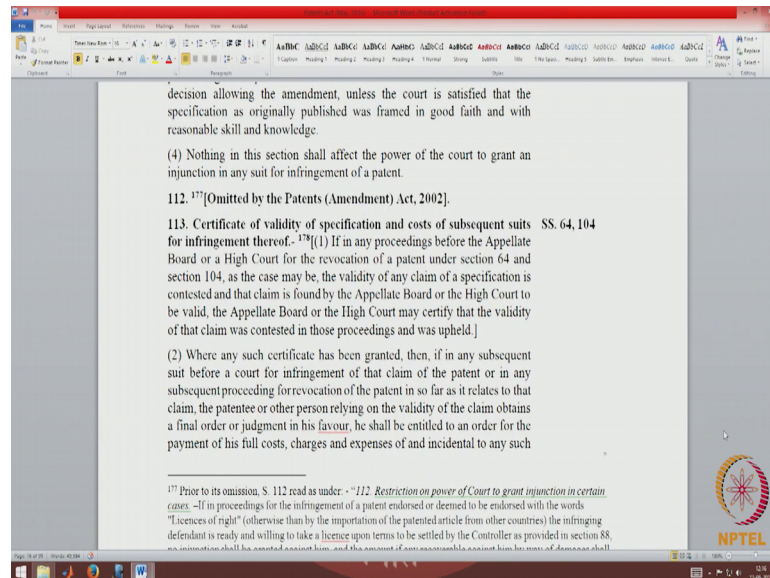


In an infringement suit, if a patentee become successful, he is succeeds in an infringement suit then he can obtain what is called a certificate of validity and once a person gets a certificate of validity; that can be used against future infringers. So, a patentee succeeds and an infringement suit asks the court to give a certificate of validity or the applied board to give a certificate of validity. Once the board or the high court issues a certificate of validity and if there is another infringer who is infringing he can inform the next infringer or the second infringer to say that there is been an earlier preceding and my patent has been appealed and I have a certificate of validity stop from doing things.

If the second infringes still continues the upon filing an infringement suit, the person the patentee will be entitled for cost from the second infringer because he has already put the second infringer on notice and he has already told the second infringer that he has been through an earlier infringement proceedings, the court has appealed his patent and issued

a certificate of validity. So, the effect of a certificate of validity is that it becomes easy for the patentee to claim costs against the future infringer.

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Section 113 deals with the certificate of validity, we are already mentioned that the certificate of validity a certificate that the patentee can obtain after there has been a proceeding under section 104; there is been a proceeding and the patent was challenged. There was a revocation challenge on the patent which in other words means the validity of the patent was challenged and the validity of the patent was up held.

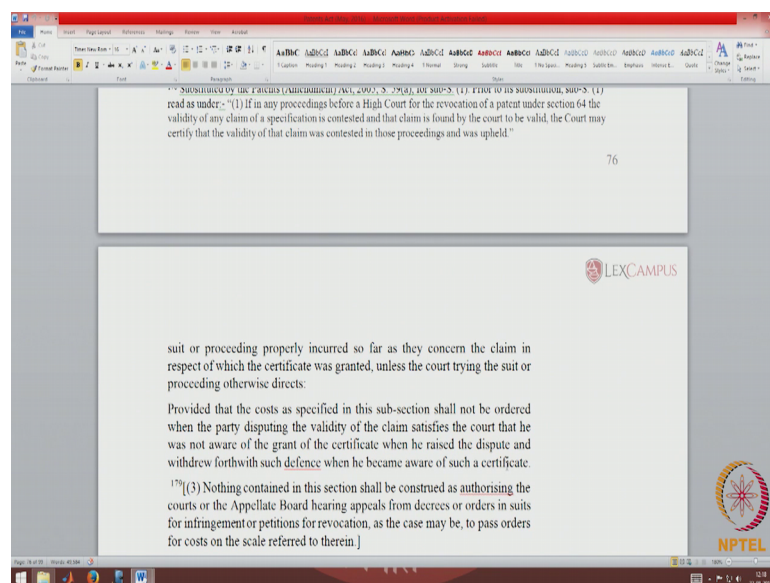
The claim was found to be valid either by the appellate board or by the high court, the appellate board or the high court may certify that the validity of a claim was contested and in those proceedings it was upheld. So, this means it is a certificate that is issued after a challenge for is made after a challenges made on the validity of a patent largely we refer to these proceedings as revocation proceedings. Revocation proceedings may happen either before in intellectual property appellate board or before the height court. So, wherever revocation grounds have been raised against the patent and the patentees successfully defense them and the patent does not get revoked as a consequence of that the patentee is entitled to get a certificate of validity saying that the claim was contested and it was appealed.

So, this is the certificate of validity is pertaining to claims that were contested claims that were claims against which there was an ground for revocation and the claims eventually

survived in the ground for revocation. So, which we referred to as claims that were appealed to be valid now we are already mentioned the purpose of a certificate of validity is if there are any future proceedings where the validity is going to be contested arguably by another defendant another party then the party can put that person on notice to say that there is already been the proceeding and this patent has been upheld.

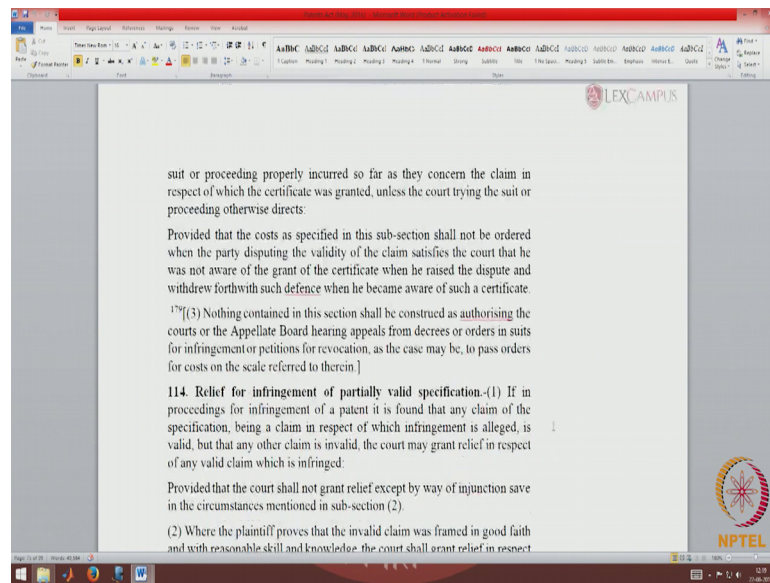
So, if you pursue with this invalidity challenge that the patentee will be entitled for an order of payment of its full costs subsection 2 refers to full costs.

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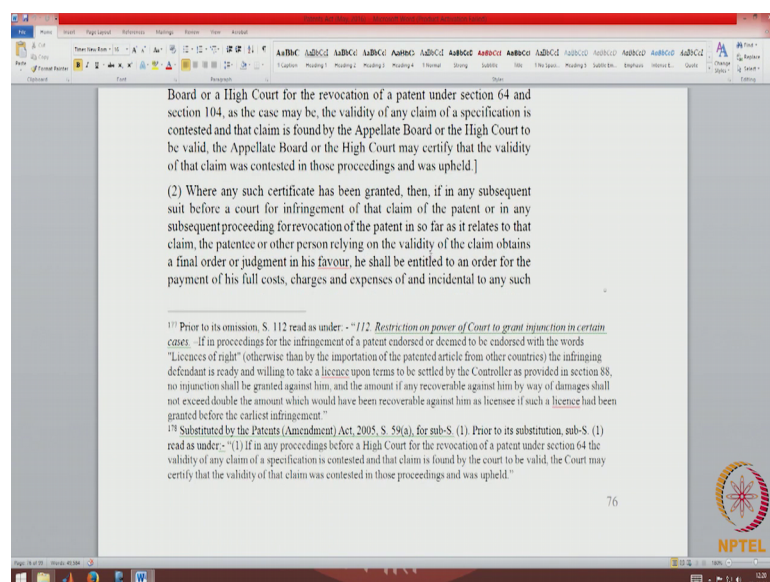
So, this certificate of valid validity allows the patentee to put a third party on notice who is interested in further challenging the patent and to claim full cost; the cost of proceedings; the cost that a patentee would incur in defending the validity challenge. So, this is a provision by which you can put the person on notice and eventually when the patentee succeeds he will be entitled to claim costs.

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Now there are some details in the section which you can figure out a sub section 3 says nothing contained in the section shall be construed as authorizing the courts or the appellate board hearing the appeal from decrease or orders in suits for infringement or petitions for revocation as the case may be to pass orders for cost on the scale refer to there in.

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Now, this; they can be an order on cause, but the order may not be an order for costs on the scales refer to there in. So, there is only an obligation for the court and the applet

board to award costs you will find it here where any search certificate has been granted, if in any subsequent suit before the court for infringement of that claim of a patent or in any subsequent proceeding for the revocation of a patent in so far as it relates to that claim. So, the certificate of validity is tied to the claim. So, if a claim is challenged and it survives or if it is appeal then for that claim, they can be a certificate of validity the patentee or any other person relying on the validity of claims obtains a final order of judgment in his favor he shall be entitled to an order for full payment of full costs. So, this is what the section provides for.

So, the certificate of validity; if a person gets a certificate of validity pertaining to a claim in say the first proceeding and there is another challenge and he succeeds in it any he gets a certificate of validity at the end of the proceeding when there is a further challenge to his patent, he is entitled to full costs. Once he is succeeds in the further challenge also the notice part comes in the proviso provided that the cost as specified in this sub section shall not be ordered when the party disputing the validity of the claim satisfies the code that he was not aware of the grant of a certificate when you raise the dispute and with through forth with such defense when it became aware of such a certificate. So, takes the responsibility of the patentee to put the third party who is disputing the validity of the claim on notice.

So, the responsibility of sharing or of bringing the certificate to the notice is on the patentee is the patentee does not discharge that responsibility, then it is a difference for the other party to say that I do not know there was a certificate of validity the moment I came to know about it I stopped or I withdrew the defense. So, that is a possibility or a potential defense that third party may have against the patentee. So, 3 we will come back to subsection 3 again. This provision does not authorize or cannot be construed as authorizing the courts to pass an order of cost based on this scales that I have been referred to there in there is an obligation to pass an order if the party has put their third party on notice of the patentee has put the third party on notice and has procured a certificate of validity in the earlier preceding.

So, the patentee is entitled to costs, but the scale of cost need not be what the patentee asks for. So, the patentee may have incurred legal expense and as you are aware legal expenses can change from council to council depending on whom you engage your legal expenses can vary. So, it is not obligatory on the courts or then appellate board to order

the costs on the scale refer to which means it need not order the costs that the patentee asks for the patentee is entitled to costs, but it need not be what the paternity asks for.