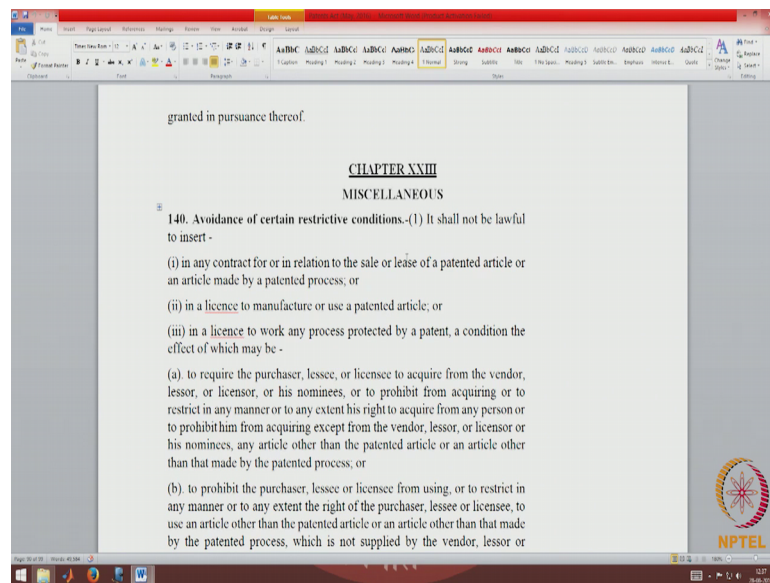


Patent Law for Engineers and Scientists
Prof. Feroz Ali
Department of Management
Indian Institute of Technology, Madras

Lecture - 77
Patent Enforcement, International Arrangements & Other Miscellaneous Provisions
Miscellaneous

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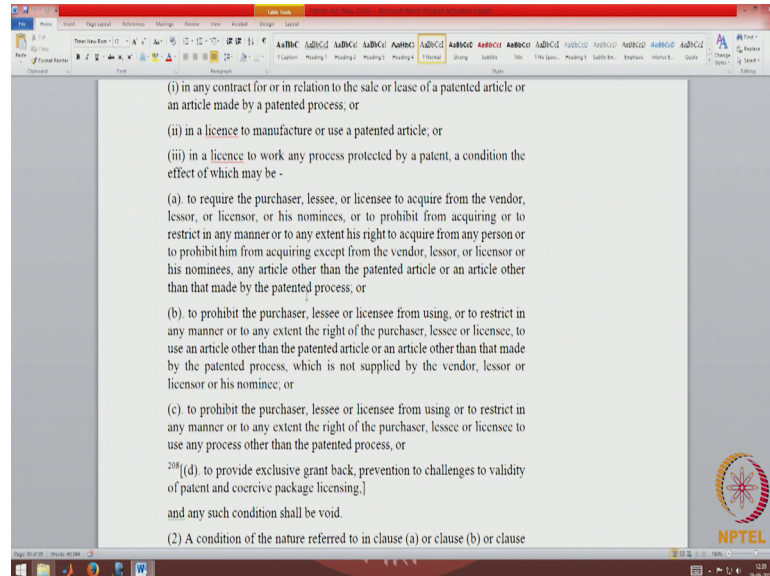
The patents act has certain miscellaneous provisions miscellaneous provisions are provisions that do not fit into any of the earlier chapters. So, they had to be collected in a separate chapter. So, you will find sap chapter 23 which deals miscellaneous provisions.

There are there are a wide variety of things that are collected under the chapter, we will quickly take you through the gist of these provision so that you know what these provisions are. But they do not require a separate treatment in the sense that they are not part of the prosecution process, they are not things that normally happened during the prosecution process. Even if they are they are of a supplemental nature that is the reason they figure in a separate chapter under the heading miscellaneous.

Now, section 140 deals with avoidance of certain restrictive conditions. Now when you enter into a contract pertaining to a patent, you cannot have certain restrictive conditions

and some of the especially in a licence not so much in l s sale or lease because sale can be a conclusive sale of your rights, but we see this occur in cases of patent licensing.

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Now, what are those some of the instances are mentioned here, you cannot provide a provision for exclusive grand back in d here, prevention of validity to challenges to validity of a patent cohesive package licensing, if you have any such term in your agreement of licensing on sale or lease of your patents, and such conditions shall be void. Restrictive conditions are conditions which when a person is dealing with patents and a person is licensing most of the time it appears in cases of licensing, as licensing is patent he cannot have certain restrictive conditions. For innocence a patentee cannot tell the licensee not to challenge the validity of his patent.

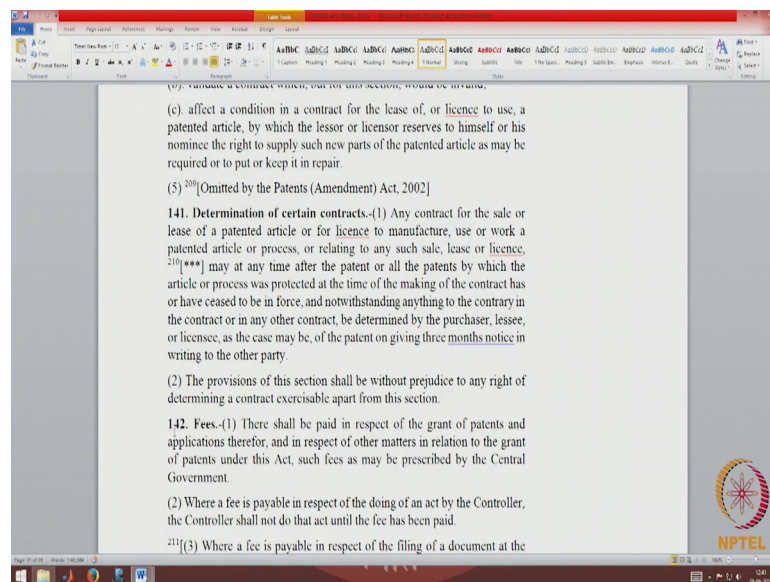
So, validity challenges filing post grant opposition challenges filing revocations petitions these are right statutory rights that are given to any licensee. Just because a person is in a licence arrangement, you cannot force him to give up these rights. So, prevention two challenges to a validity of a patent, even if there is a class to that affect the courts if they are called to look up on it they will treat that condition as a void condition. It will be null and void it will not be given effect 2.

Cohesive packaging licensing is where the patentee has certain patent products, he also has certain non patented products which are not covered by a patent he would want the licensee to take the patented and the non patented products whether as a package. So, a

package licensing is where lies patents there are patented as well as non patented product. So, if there is a force full if there is an agreement event to take non patented products or technology or inventions then that condition will be void.

The reason being what is non-patented is not protected, and a person can is free to use it if the person gets it through a legitimate channel. So, unless it is confidential information or treat secret, but if it is something the technology is non-patented, understanding is that anybody else should be free to use it. So, when a patentee combined patented and non patented products in one agreement and forces the licensee to take it, that condition of clubbing or what is used by the at cohesive package licensing will be void.

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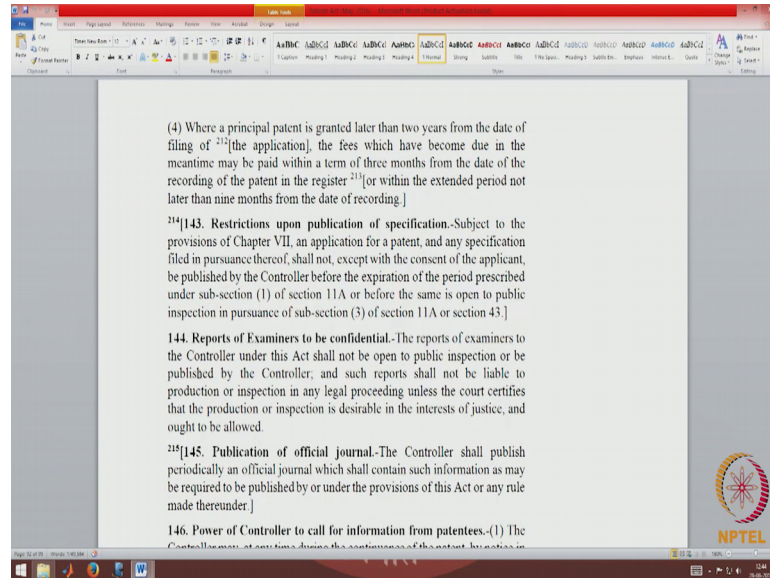


Now, 141 deals with a provision where certain contracts like a contract for sale or lease of a patented article or licence to manufacture use or work of a patented article or relating to any such a sale lease or licence, may at any time after the patent or all the patents by which the article of processes protected as a time of making of the contact, has or have cease to be in force and not withstanding anything to the contrary in the contract be determined by the purchaser a licensee extra of the patent on giving three months notice in writing to the other party.

Now, this implies that if you undertake a licence of a patent, when the patent expires you can issue notice giving 3 months' notice, to the other party the patentee and terminate the contract because the contract service based on the patent. So, if the patent has expired

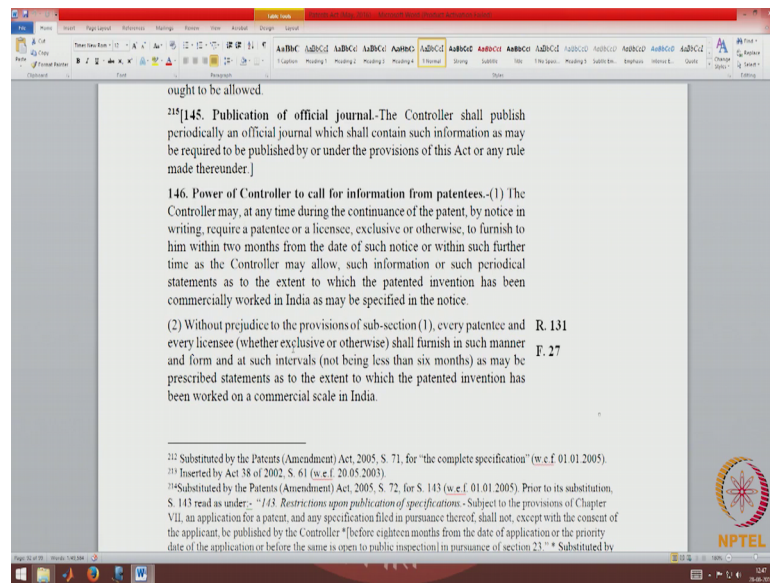
then there is no need to honour that contract. It is open for licensee to give notice of three months giving three months notice in writing, and to terminate the contract.

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142 deals with fees section 143 deals with restriction upon publication of specification this provision states that there is a normal 18 month period, for which during which an application is kept un published unless the applicant request for a publication. This provision states that the application shall not be published by the controller before the expiration of the 18 month period or before the same is open to the public inspection in respect of the conditions mentioned in 11 A3 and which is the three conditions where there is a secrecy direction passed or the patent application which is a professional is abandoned or it is withdrawn or the patent itself is granted under 43. So, these are the conditions in which the patent can be published.

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144 states that the report of the examiners to be confidential, now these reports are different from the report what is referred to as the first examination report or the first statement of objection. This is a report that moves from the examiner to the controller. So, this should not be confused with the first examination report or the first statement of objection. So, this report shall be confidential unless it is required to be produced by the order of a quote.

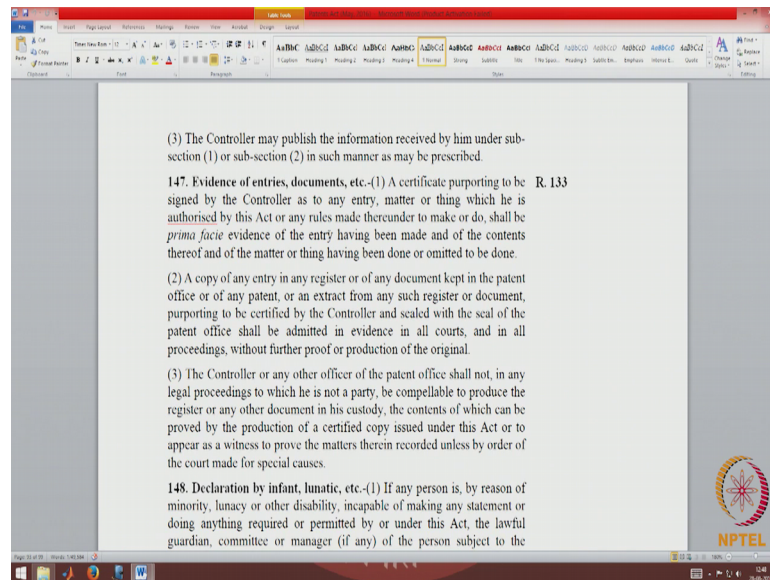
The patent office has a journal 145 refers to the publication of the official journal and it is published every week, the applications that are published are notified in it the grand's are also notified, and if there is any amendment to a patent amendments are also published. So, this is the official journal and it is available at the patent office website a soft copies available.

Now, 146 deals with power of the controller to call information from patentees, the controller has the power there is a provision where the patentee has to file working statements using form 27. Working statement requires the patentee to disclose to the patent office whether the invention is being worked or if it is not being worked the reasons why the patent does not being worked. Now these are a statements timely statement which has to be filed before the patent office use in form 27.

Now, if a person feels to file or regardless of whether a person has been feeling this or not, the patent office can on its own ask for this information. So, 146 deals with the

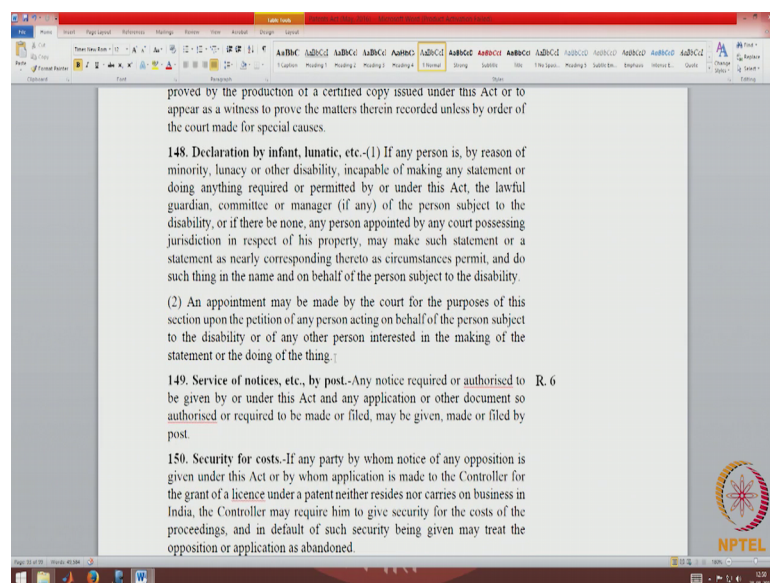
responsibility of the patentee to file at regular intervals information pertaining to the working of patents, it also covers the power of the controller to call for these information whenever the controller deems fit.

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147 deals with evidences of entries document etcetera and we had seen that the patent office keeps a register, and a copy of the register will be regarded as evidence of an entry in the register.

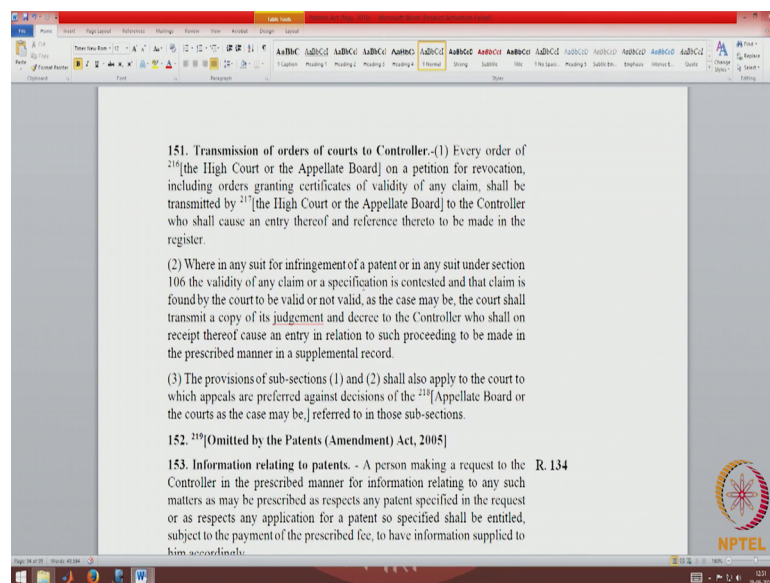
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Now, 148 deals with declaration by infant lunatic etcetera. Now in law and infant or a lunatic or a person of unsound mind cannot enter into a contract. There is a legal disability and that is factored here if any person is by reason of minority lunacy on disability, incapable of making any statement or doing anything required or emitted by or under this act, the lawful guardian commit or manager can do it on his behalf. These provisions exist in different laws. So, that is been incorporated in the patents act too.

149 deals with service of notices etcetera by post, 150 deals with security for cost in some cases the controller curry insist on security for costs, if the person is not residing in India versus or carries on business in India if the person is not in India or does not carry business in India, then the con controller can insist on security of costs. Now one fifty one deals with how the orders passed by the high court and the appellate board, can be transmitted to the controller.

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And 153 broadly deals with information relating to patents, the corresponding rule is rule 134 where the a person can approach the patent office for information relating to patents; there is a procedure to do that and all the information that is meant to be public agree so, that after the publication of a patent application, there are you can get copies of the complete specification and other documents. So, those documents can be obtained or information pertaining to those documents can be obtained from the patent office by payment offer required fee.

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152. ²¹⁹[Omitted by the Patents (Amendment) Act, 2005]

153. Information relating to patents. - A person making a request to the Controller in the prescribed manner for information relating to any such matters as may be prescribed as respects any patent specified in the request or as respects any application for a patent so specified shall be entitled, subject to the payment of the prescribed fee, to have information supplied to him accordingly. R. 134

154. Loss or destruction of patents. - If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Controller, the Controller may at any time, on application made in the prescribed manner and on payment of the prescribed fee, cause a duplicate thereof to be sealed and delivered to the applicant. R. 132

155. Reports of Controller to be placed before Parliament.-The Central Government shall cause to be placed before both Houses of Parliament once a year a report respecting the execution of this Act by or under the Controller.

156. Patent to bind Government.-Subject to the other provisions contained in this Act, a patent shall have to all intents the like effect as against Government as it has against any person.

²¹⁶ Substituted by the Patents (Amendment) Act, 2005, S. 74 (a), for "the High Court" (w.e.f. 01.01.2005).
²¹⁷ Substituted by the Patents (Amendment) Act, 2005, S. 74 (a), for "the High Court" (w.e.f. 01.01.2005).
²¹⁸ Substituted by the Patents (Amendment) Act, 2005, S. 74 (b), for "Courts" (w.e.f. 01.01.2005).
²¹⁹ Prior to its omission, S. 152 read as under: -"152. Transmission of copies of specifications, etc., and inspection

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154 deals with loss or destruction of patents if patent by loss or destruction we talk about the patent certificate. You could ask for a duplicate it is provided for now report both of the controller to be placed before parliament 155 deals with that. 156 says that the patent binds the government. So, the government grants patent, but it is also binding on the government and 157 deals with the right off the government to sell or used forfeited articles; patents the articles that are forfeited which could be patented can be sold by the government.

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157. Right of Government to sell or use forfeited articles.-Nothing in this Act shall affect the power of the Government or of any person deriving title directly or indirectly from the Government to sell or use any articles forfeited under any law for the time being in force.

²²⁰[157A. Protection of security of India.-Notwithstanding anything contained in this Act, the Central Government shall-

(a) not disclose any information relating to any patentable invention or any application relating to the grant of patent under this Act, which it considers prejudicial to the interest of the security of India,

(b) take any action including the revocation of any patent which it considers necessary in the interest of the security of India by issue of a notification in the Official Gazette to that effect.

Explanation.-For the purposes of this section, the expression "security of India" includes any action necessary for the security of India which-

(i) relates to fissionable materials or the materials from which they are derived, or

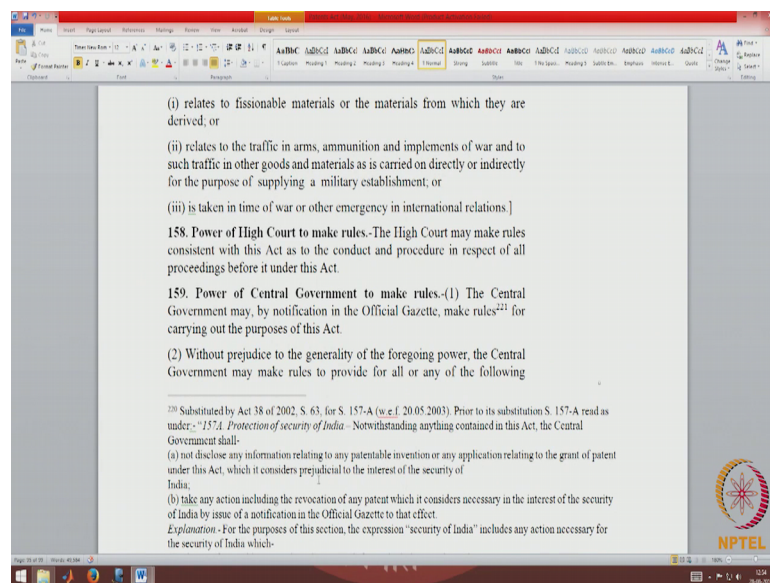
(ii) relates to the traffic in arms, ammunition and implements of war and to such traffic in other goods and materials as is carried on directly or indirectly for the purpose of supplying a military establishment, or

(iii) is taken in time of war or other emergency in international relations.]

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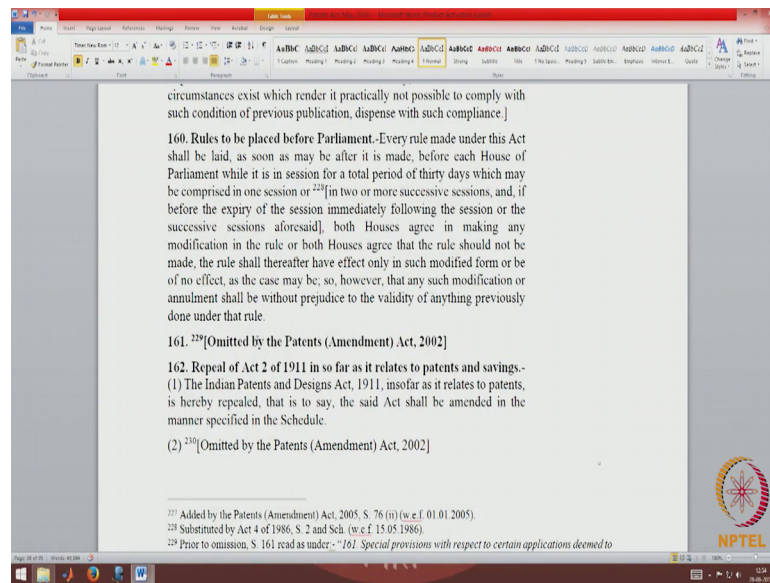
Now, on 157A deals with protection of security of India, what can be done if certain matters affect the security of India if it is disclosed in patent application, we already saw that there are provisions where secrecy direction can be issued. Now notwithstanding anything contained in this act, the central government shall not disclose any information relating to any patentable invention or application relating to the grant of a patent under this act, which is considered prejudicial to the interest of the security of India or take any action including revocation of patent, which it considered necessary in the interest of security of India by notification in the official gazette.

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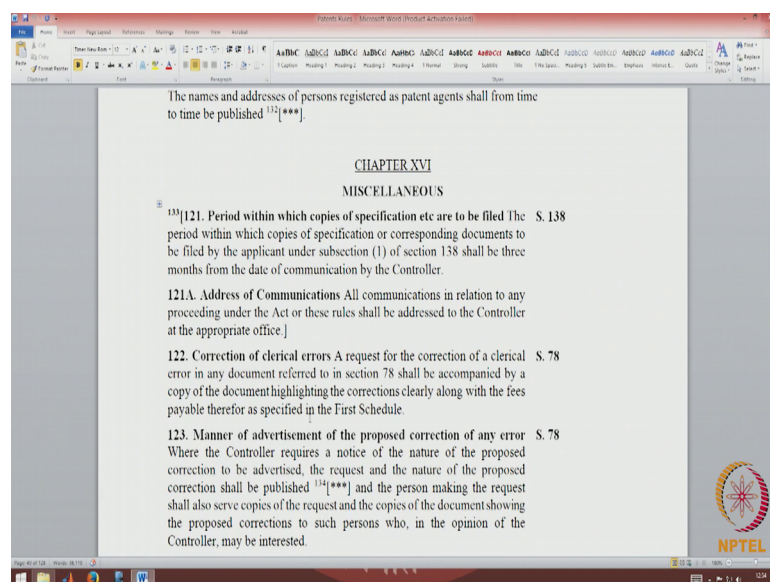
Now, what pertains to security of India will find that something that affects war an emergency in international relations, relates to traffic in arms ammunition fishnable material, all these things are broadly classified as atomic energy. As you as section 4 tells us will be regarded as things that are that pertain to the security of India. At the high court has the power to make rules and respective high court do make rules when it comes to patent proceedings and the central government also has power to make rules and which is what we had seen in the form of the patent rules 2003.

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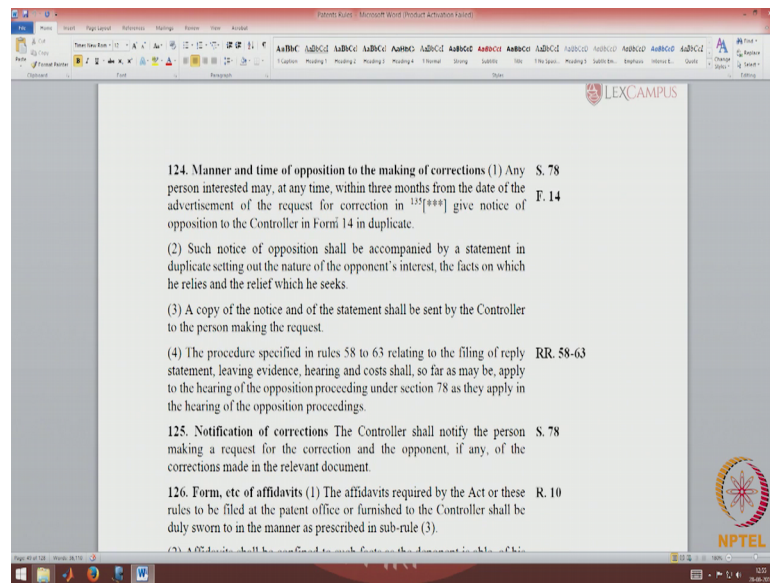
And the various matters under which department the central government can rule make rules are mentioned there in. The rules when they are made have to be placed before the parliament 160 deals with that, and 162 deals with the repeal of the earlier act here already mentioned the act of 1911 repeal was replaced by the 1970 act. So, in the 1978 act has a provision which expressly states that the earlier act is repealed.

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Just as we saw there are some miscellaneous provisions in the rules as well, and they are a bunch of different things and it will make sense when they are read in the context so.

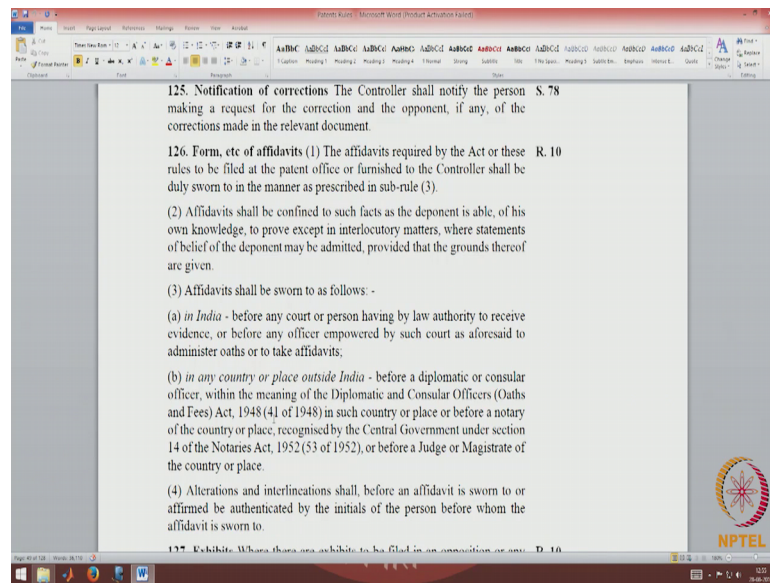
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So, you can see the cross references here, 121 deals with the period within which copies of the specification are to be filed the address to communication correction of clerical errors manner of advertisement of proposed correction, these are largely procedural matters.

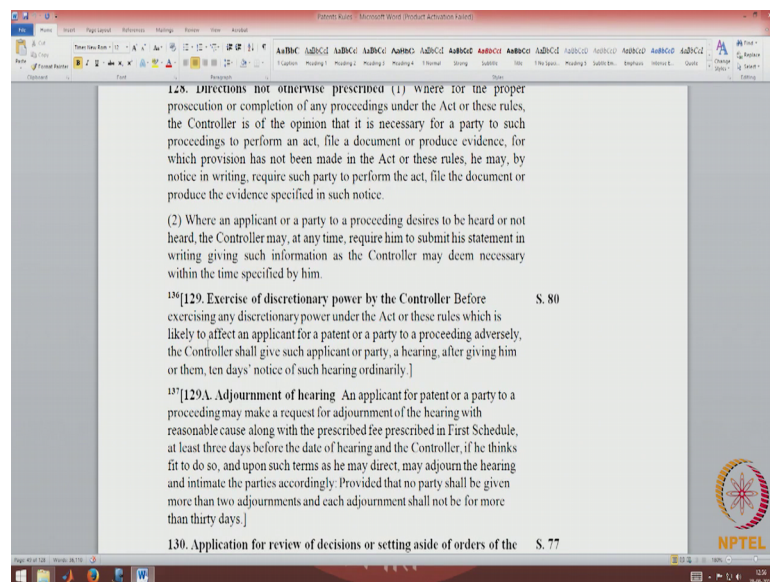
Manner and time of opposition of making of correction do if there is a correction that has to be done in that also can be a subject matter of opposition. Notification of corrections forms of affidavits affidavit if they are file in India, how it is to be done if they are filed in a country or shown in a country outside India.

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Then you are to go to the go as per the diplomatic and consular officer course and fees act it has to be complete it has they have to be apostil there is a process for doing that.

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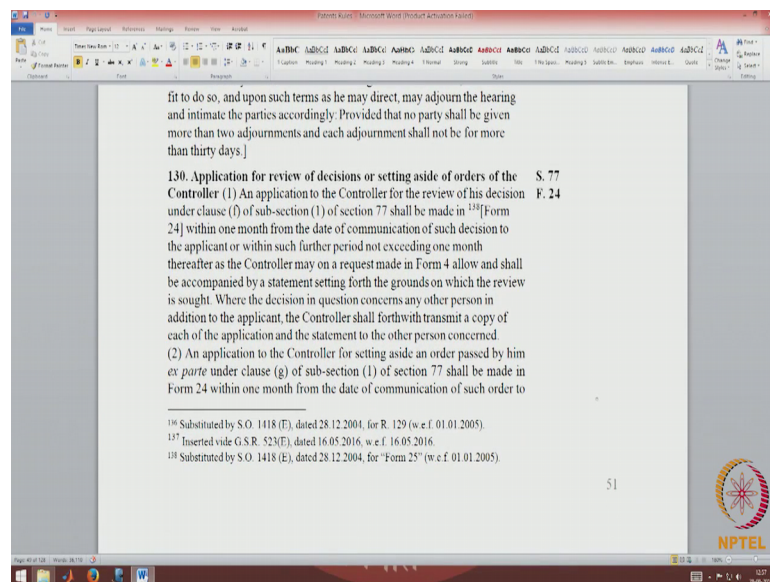


Now, exhibit 127 deals with exhibits and how to deal with them and 128 deals with directions where there is no provision provided for. 129 deals with the discretionary power of the controller where were the controller exercises his discretionary power which could be which could prejudice the party, the controller has to offer hearing. So,

this is a provision which mandates hearing of a party whos writes could be affected when the controller exercises with discussion.

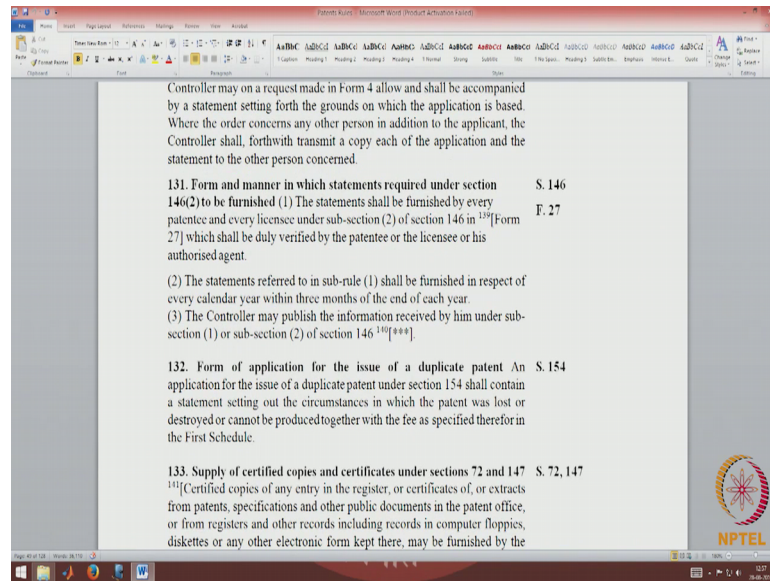
So, if it is a normal thing which where the controller does not have a discussion for instance. The controller receive the report of the examiner the confidential report the controller has to issue a first examination report of a statement of objection. There is no discretion there he has to do it whereas, a controller after hearing up post grant opposition has a discretion either to reject the patent or call for an amendment or to uphold the patent. So, in whatever he does he would be exercising is discretion. So, when he exercise is your discretion if it affects a party.

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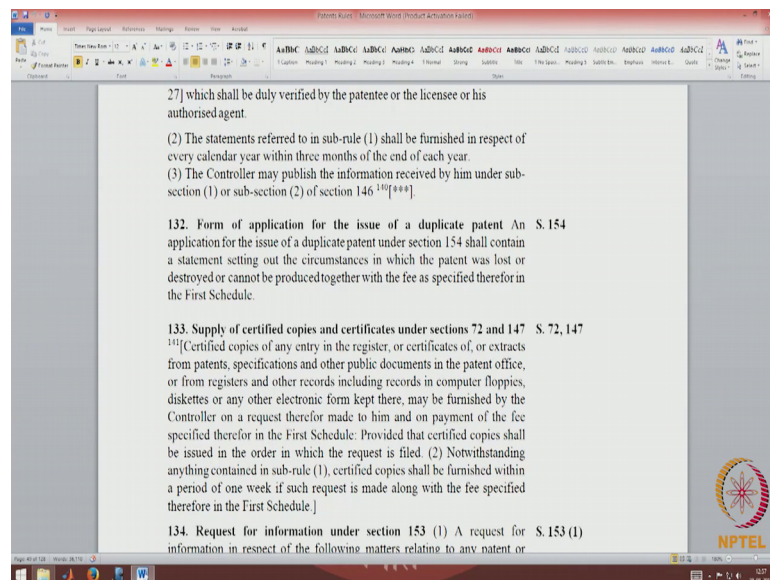
The party is entitled to a hearing hearings can be adjourned there is a provision for adjourning hearings and there are some requirements of notice and the controller can review his own order. So, one thirty deals of review of decisions and setting aside orders of the controller.

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Now, we had seen that form 27 requires working statements to be filed, and section 146 give the power the controller to ask for some information with regard to working of patents. 131 deals with the procedural aspects.

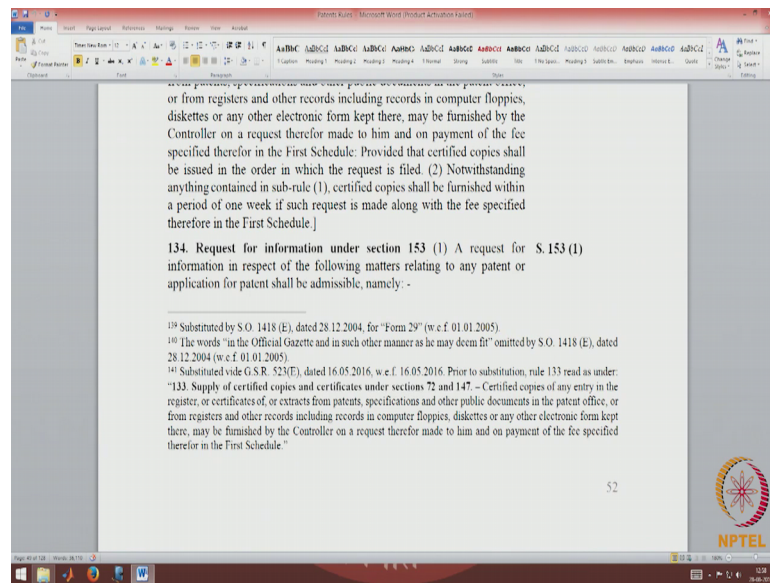
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Now, 132 deals with the forms to be used while getting a duplicate patent if your patent is destroyed.

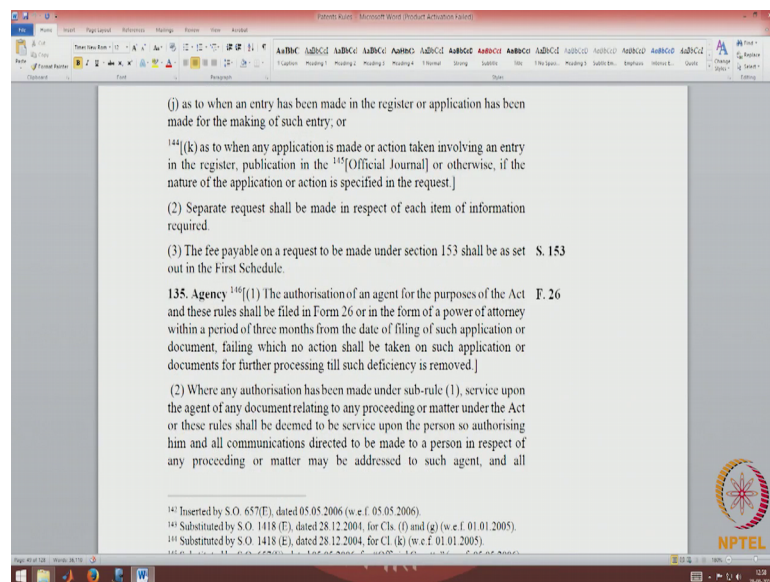
So, these are all supplemental provisions which are which person to certain aspects of patent prosecution supply of certified copies request for information.

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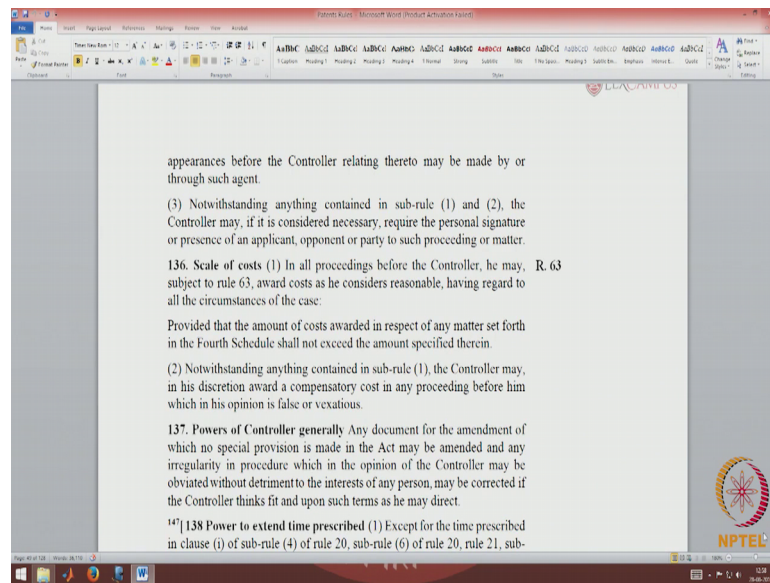
We saw that under section 153 you could make a request for certain information how that is to be made and the details are given here.

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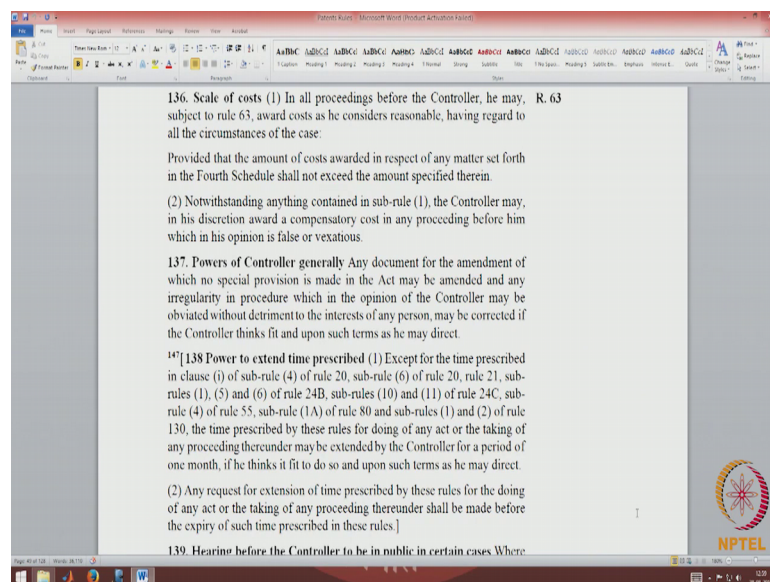
Now, the patent agent you can appoint a patent agent who acts as an agent of the patent applicant by filing form 26 way by the form you authorise a person to act as an agent.

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135 deals with that the controller has the power to avoid cause to the scale of cost or the amount of cost can be determined in accordance with rule 63, now the controller has the power to do that.

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Powers of the controller generally where there is no provision to amend a document, then the controller may in the interest of the parties involved correct the document. So, there is a power generally given to carry out changes in a document where there is no

specific provision, the controller has the power to extend time there are some limitations; 138 rule 138 deals with that.

Now, hearing before the controller is normally a public hearing unless the controller directs otherwise.