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ADJUDICATING AUTHORITIES UNDER THE PATENT ACT**ABSTRACT**

A patent is an exclusive right given for an invention, which is a product or method that offers a new way of doing something or a new technological solution to a problem. Technical information regarding the innovation must be given to the public in a patent application in order to get a patent.

In modern parlance, a patent is a privilege awarded to an inventor for the invention of any fresh, valuable, non-obvious technique, the machine, object of manufacture, or substance composition. The name "patent" derives from the Latin verb "patere," which means "to lay open," i.e. to make available for public view.

The Controller of Patents is the primary person in charge of overseeing India's patent system. The Controller is the ultimate supervisor of the four Patent Offices located in Chennai, Delhi, Mumbai, and Kolkata. Because the Controller also serves as the Registrar of Trademarks with the Trade Office's Head Office in Mumbai, the Controller also serves as a patent attorney from his office in Mumbai. The patent's official headquarters are in Kolkata (Calcutta). Patents awarded under the Patents Act, as well as other officials of the Patent Office, are directed or regulated by the Controller. However, An appeal can be taken to IPAB against the decision of the Controller or the Central Government of India in cases relating to the denial of an application for failing to comply with the Act's provisions.

INTRODUCTION

On April 20, 1972, the Patents Act 1970¹ and the Patents Rules 1972² went into effect, replacing the Indian Patents and Designs Act 1911³. The suggestions of the Ayyangar Committee Report, chaired by Justice N. Rajagopala Ayyangar, were substantially included in the Patents Act. One of the proposals was to allow only process patents for discoveries involving pharmaceuticals, medicines, food, and chemicals.

Later, India became a signatory to a number of international treaties with the goal of improving its patent law and integrating it into the contemporary world. Becoming a member of the **TRIPS**⁴ was a key step toward reaching this goal.

On the 7th of December 1998, India signed the Paris Convention and the Patent Cooperation Treaty, and on the 17th of December 2001, it signed the Budapest Treaty.

Current position of India

The Patents Act, 1970, as modified by the Patents (Amendment) Act, 2005⁵ (hereafter referred to as the Act) and the Patents Rules, 2006 control the current Indian patent law situation (hereinafter referred to as the Rules)

The Patent Office's headquarters are in Kolkata, with branch offices in Delhi, Mumbai, and Chennai. The Controller General of Patents, Designs, Trademarks, and Geographical Indications oversees India's patent system. Each office is responsible for accepting patent applications in its local territory and is authorised to handle all aspects of the Patent Act.

The jurisdiction in which the patent application is filed is determined by:

1. Indian applicant(s): determined by the applicant's residence, place of business, or the location of the invention's genesis.

¹ Available at: https://ipindia.gov.in/writereaddata/Portal/IPOAct/1_31_1_patent-act-1970-11march2015.pdf , Ref on: Date- 10/08/2021 Time- 2:55 PM

² Available at: <https://www.wipo.int/edocs/lexdocs/laws/en/in/in029en.pdf> Ref on: Date- 10/08/2021 Time- 2:57 PM

³ Available at: the Indian Patents and Designs Act 1911 Ref on: Date- 10/08/2021 Time- 2:55 PM

⁴ Available at: https://www.wto.org/english/tratop_e/trips_e/trips_e.htm Ref on: Date- 10/08/2021 Time- 3:15 PM

⁵ Available at: https://ipindia.gov.in/writereaddata/Portal/IPOAct/1_69_1_patent_2005.pdf Ref on: Date- 10/08/2021 Time- 3:55 PM

2. Indian applicant(s): determined by the applicant's residence, place of business, or the location of the invention's genesis. The address for service in India determines the foreign applicant(s).

What can be patented?

Sections 3⁶ and 4⁷ of the Indian Patents Act, 1970, clearly stated the limitations on what can be patented in India. In order to get a patent in India, several requirements must be met. They are as follows:

The subject of the patent:

The most crucial factor to examine is whether or not the invention relates to a patentable subject matter. The non-patentable subject matter is included in Sections 3 and 4 of the Patents Act. Unless the invention falls under one of the provisions of Sections 3 or 4, it is a patentable topic.

Novelty:

Innovation is an essential factor in assessing an invention's patentability. A novelty or new invention is defined in Section 2(1) of the Patent Act⁸ as "no innovation or technique published in any document before the date of filing of a patent application, wherever in the nation or the globe." The whole specification, that is, the subject matter has not entered the public domain or is not state of the art."

Simply put, the uniqueness criterion stipulates that an invention should never have been released into the public domain. It must be the most recent, with no earlier artworks that are the same or comparable.

An innovative step: It is defined as "the characteristic of an invention that includes scientific development or is of economic importance or both, as contrasted to existing knowledge, and innovation not evident to a person versed in the art" under Section 2(ja) of the Patents Act. This means that the innovation should not be evident to someone knowledgeable in the same

⁶ Available at: <https://ipindia.gov.in/writereaddata/Portal/ev/sections/ps3.html> Ref on: Date- 10/08/2021 Time- 11:00PM

⁷ Available at: <https://ipindia.gov.in/writereaddata/Portal/ev/sections/ps4.html> Ref on: Date- 10/08/2021 Time- 11:15 PM

⁸ Available at: <https://indiankanoon.org/doc/1027057/> Ref on: Date- 10/08/2021 Time- 11:55 PM

field as the invention. It should not be creative or obvious to someone with experience in the same industry.

Capable of industrial application: Section 2 (ac) of the Patents Act ⁹defines industrial applicability as "the invention is capable of being produced or utilised in an industry." This indicates that the Invention cannot exist in the abstract. It must be applied in any industry, which implies it must have practical use in terms of the patent.

These are the legislative requirements for obtaining a patent for an invention. Furthermore, the publication of a competent patent is a crucial criterion for getting a patent. A competent patent disclosure implies that a patent draught specification sufficiently discloses the Invention such that a person knowledgeable in the same field as the Invention may carry out the Invention without excessive effort.

Patent Procedure

Step 1: Describe your innovations (ideas or concepts) in depth.

Gather all relevant facts regarding your invention, such as:

- Invention Field
- What is the Invention about?
- How does it function?
- The Advantages of Invention

If you worked on the invention and throughout the research and development phase, you should have some call lab records that are signed and dated by both you and the relevant authorities.

Step 2: Include a diagram, drawing, and sketch that explains the invention.

Drawings and drawings should be developed in such a way that the visual work may be described in conjunction with the innovation work. They are very essential in patent applications.

⁹ Available at: <https://indiankanoon.org/doc/65643/> Ref on: Date- 10/08/2021 Time- 11:55 PM

Step 3: Determine whether or not the invention is patentable.

Not all innovations are patentable; according to the Indian Patent Act, certain inventions have not been deemed patentable.

Step 4: Find a Patent

The next stage will be to determine if your invention fulfils all of the patent conditions outlined in the Indian Patent Act-

- The invention must be original.
- The invention must be obscure.
- Industrial applications are required for the invention.

Step 5: Submit a patent application.

If you are still in the early stages of developing your invention, you can file a provisional application. It has the following advantages:

- The deadline for filing.
- Full specifications must be submitted within 12 months.
- Less expensive.

When you file a provisional application, you secure the filing date, which is quite valuable in the patent industry. You have 12 months to finish the specification; after that, your patent application will be deleted.

You can file the entire specification with the patent application if you have finished the essential papers and your research work has progressed to the point where you can have prototypes and experimental findings to prove your innovative step.

Filing the provisional specification is an optional step; if you have a comprehensive understanding of your invention, you can go directly to the full specification.

Step 6: The application is published.

The application is published 18 months after the first filing if the entire specification is filed simultaneously with the patent application.

If you do not want to wait 18 months from the filing date to publish your patent application, you may submit an initial publishing request with the specified cost. Typically, the patent application is publicised as a one-month form request.

Step 7: Submit a Request for Examination

Only after obtaining a request for an RFE examination is the patent application examined. Following receipt of your request, the Controller assigns your patent application to a patent examiner, who evaluates the patent application in accordance with the following patent eligibility criteria:

- The subject of the patent
- Newness
- Inconsistency
- Inventory Procedures
- Utilization in industry
- By allowing

Following a check for the aforementioned requirements, the examiner issues the patent application's initial examination report. This is known as patent prosecution. Patent prosecution refers to anything that occurs in the course of a patent application prior to the issuance of a patent.

The examiner's initial examination report, which is also sent to the patent applicant, generally contains prior art (existing documents previous to the filing date) that is comparable to the claimed invention.

Step 8: Respond to the objections

The examination report will result in some kind of objections for the majority of patent applicants. The best course of action is to discuss the examination report with a patent specialist (patent agent) and respond to the objections raised in the examination report.

In inspection reports, an inventor has the chance to communicate his uniqueness above the previous art. Inventors and patent agents develop and transmit a test answer in order to demonstrate that their invention is patentable and fulfils all patent conditions.

Step 9: resolving any objections

The Controller and the patent applicant are linked to ensure that any objections expressed about the invention or application are resolved and that the inventor has a fair chance to show his argument and establish uniqueness and innovative steps over other existing arts

It is the first award for a patent application after receiving a patent application in order for a grant.

Step 10: Once all patent criteria have been satisfied, an application for a grant will be submitted. The award of a patent is announced in the Patent Journal, which is published on a regular basis.

Adjudicating authorities under Patent Act

The Controller of Patents is the primary person in charge of administering India's patent system. The Controller is the ultimate supervisor of India's four patent offices, which are located in Chennai, Delhi, Mumbai, and Kolkata.

The Controller's powers include the ability to receive, acknowledge, accept, publish, and examine a patent application, claim, description, and specification, to conduct searches and

investigate for anticipation by previous publication and prior claim, to consider the examiners' reports, to refuse application or require an amended application, and, in certain cases, to make division orders.

CONTROLLER'S GENERAL POWERS

Section 77 of the Patents Act of 1970¹⁰ enumerates the controller's general functions. While trying a civil matter, he shall have some powers of a Civil Court under the CPC, 1908. These include calling and compelling witnesses to appear; receiving testimony on affidavits; issuing commissions for the examination of witnesses and documents; awarding expenses; and so on. This includes the ability to review his own decisions on applications filed within the prescribed time and in the prescribed manner, as well as the ability to set aside an order passed ex parte on an application filed within the prescribed time and in a prescribed manner; subsection 2 also clarifies that orders issued by the Controller are enforceable as a Civil Court decree.

Section 78 of the Patent Act¹¹ provides for the correction of any clerical error in any patent, specification, or other document filed in support of such application, or any clerical error in any information put in the register. The ability to rectify clerical mistakes under Section 78(1) does not extend to making modifications suo moto, according to *Press Metal Corporation Limited v. Noshin Sorabji Pochkanwalla*¹². As a result, modifications must absolutely be made under Section 57 of the Act¹³.

In the case of *AIA Engineering Ltd. v. Controller of Patents*¹⁴, it was decided that no revision of an application may be made while pretending to exercise rights under Section 78 of the Act, since the procedure of Section 57 read with Section 59 of the Act must be followed in such situation. - There appears to be no power for the Controller to make any unilateral changes. - As a result, the contested order could not be upheld because of a patent mistake and inappropriate exercise of jurisdiction by the Assistant Controller, and it was likely to be overturned. While exercising rights under Section 78 of the Patents Act, which allows for the

¹⁰ Available at: <https://ipindia.gov.in/writereaddata/Portal/ev/sections/ps77.html> Ref on: Date- 10/08/2021 Time- 1:00 PM

¹¹ Available at: <https://ipindia.gov.in/writereaddata/Portal/ev/sections/ps78.html> Ref on: Date- 12/08/2021 Time- 1:10 PM

¹² Available at: *AIR 1983 Bom 144* Ref on: Date- 13/08/2021 Time- 4:00 PM

¹³ Available at: <https://ipindia.gov.in/writereaddata/Portal/ev/sections/ps57.html> Ref on: Date- 13/08/2021 Time- 4:00 PM

¹⁴ Available at: *2007(34)PTC457(Del)* Ref on: Date- 13/08/2021 Time- 4:10 PM

repair of clerical mistakes, modification is not permitted. Instead, the method set forth in Sections 57 and 59 of the Act must be followed.

CONTROLLER'S DISCRETIONARY POWERS

- The controller's discretionary power under Section 3 (d)¹⁵-

In *Novartis Ag v. Union of India*, the court found that Section 3(d) did not violate Article 14 of the Indian Constitution, was not ambiguous or arbitrary and did not provide the Patent Controller unrestricted power. Novartis' claims that Section 3(d), which prohibits patents for novel applications of existing chemicals unless the patentee can demonstrate "improvement of the known efficacy" or "differing considerably in characteristics with regard to efficacy," were vague and confusing were dismissed by the court. The court noted that discretionary power did not always imply discriminatory behaviour. The Patent Controller's discretionary power under Section 3(d) in determining whether a known substance has increased effectiveness did not result in an unreasonable exercise of discretionary power or prejudice against Novartis.

- The controller's discretionary power under Rules 137 and 138

Section 80¹⁶ deals with the Controller's discretionary powers and how they should be utilised. It especially relates to patent applications and patent modifications. The controller must provide the parties with a chance to be heard.

Section 81 offers the controller the ability to prolong time. And there will be no appeal from the Controller's order granting the extension.

- The Controller's Authority under Section 8 (2)¹⁷

Section 8 (2) empowers the Controller to request any information about the application's 'processing' in a nation other than India at any time before the patent is granted. The controller has discretionary power under section 8 (2) of the Act and rule (12) of the Rules, therefore an applicant must ensure that the information is presented to the controller's satisfaction

¹⁵ Available at: <https://indiankanoon.org/doc/1845556/> Ref on: Date- 13/08/2021 Time- 4:20 PM

¹⁶ Available at: <https://ipindia.gov.in/writereaddata/Portal/ev/sections/ps80.html> Ref on: Date- 13/08/2021 Time- 4:20 PM

¹⁷ Available at: <https://ipindia.gov.in/writereaddata/Portal/ev/sections/ps8.html> Ref on: Date- 13/08/2021 Time- 4:30 PM

- The Controller's authority under Section 17¹⁸

The Controller has the authority to postdate an application that is bound by Section 9(1), which states that a complete specification must be completed within 12 months of the applicant's filing date.

- Other Powers The Controller of Patents has the following powers:
 1. The ability to correct a typographical error made during the prosecution.
 2. Power to issue compulsory licences, to postpone compulsory licence applications, and to dismiss any stay actions.
 3. The ability to obtain information from patentees.
 4. The ability to revoke patents that have been relinquished.
 5. The controller has the authority to issue orders to patent co-owners.

Conclusion

Patents can provide great value and increased returns to individuals and companies on the investment made in developing new technology. Patenting should be done with an intelligent strategy that aligns business interests to implement the technology with a wide range of options in the search for how, where and when to patent. As an example, with a focus on international considerations and regulations in specific countries, it is possible for a company to achieve significant savings and improve the rights gained using patents.

The Controller of Patents has broad discretionary powers to assess such things as fair affordability, appropriate pricing, and reasonable royalty rates. These powers are not arbitrary, and the controller's overall powers are similar to those of a Civil Court under the Civil Procedure Code of 1908.

¹⁸ Available at: <https://ipindia.gov.in/writereaddata/Portal/ev/sections/ps17.html> Ref on: Date- 15/08/2021 Time- 10:30 PM