An Act further to amend the Patents Act, 1970

Be it enacted by Parliament in the Fiftieth Year of the Republic of India as follows:-

1. (i) This Act may be called the Patents (Amendment) Act, 1999.
   (ii) It shall be deemed to have come into force on the 1st day of January, 1995.

2. Section 5 of the Patents Act, 1970 (hereinafter referred to as the principal Act) shall be renumbered as sub-section (1) thereof and after sub-section (1) as so renumbered, the following sub-section shall be inserted, namely:

   "(2) Notwithstanding anything contained in sub-section (1), a claim for patent of an invention for a substance itself intended for use, or capable of being used, as medicine or drug, except the medicine or drug specified under sub-clause (v) of clause (1) of sub-section (1) of section 2, may be made and shall be dealt, without prejudice to the other provisions of this Act, in the manner provided in Chapter IV-A."

3. After Chapter IV of the principal Act, the following Chapter shall be inserted, namely:

`CHAPTER IV-A

Exclusive Marketing Rights`

24A. (1) Notwithstanding anything contained in sub-section (1) of section 12, the Controller shall not, under that sub-section, refer an application in respect of a claim for a patent covered under sub-section (2) of section 5 to an examiner for making a report till the 31st day of December, 2004 and shall, where an application for grant of exclusive right to sell or distribute the article or substance in India has been made in the prescribed form and manner and on payment of prescribed fee, refer the application for patent, to an examiner for making a report to him as to whether the invention is not an invention within the meaning of this Act in terms of section 3 or the invention is an invention for which no patent can be granted in terms of section 4.

(2) Where the Controller, on receipt of a report under sub-section (1) and after such other investigation as he may deem necessary, is satisfied that the invention is not an invention within the meaning of this Act in terms of section 3 or the invention is an invention for which no patent can be granted in terms of section 4, he shall reject the application for exclusive right to sell or distribute the article or substance.

(3) In a case where an application for exclusive right to sell or distribute an article or a substance is not rejected by the Controller on receipt of a report under sub-section (1) and after such other investigation, if any, made by him, he may proceed to grant exclusive right to sell or distribute the article or substance in the manner provided in section 24B.

Explanation – It is hereby clarified that for the purposes of this section, the exclusive right to sell or distribute any article or substance under this section shall not include an article or substance based on the system of Indian medicine as defined in clause (e) of sub-section (1) of section 2 of the Indian Medicine Central Council Act, 1970 and where such article or substance is already in the public domain.
24B. (1) Where a claim for patent covered under sub-section (2) of section 5 has been made and the applicant has,—

(a) where an invention has been made whether in India or in a country other than India and before filing such a claim, filed an application for the same invention claiming identical article or substance in a convention country on or after the 1st day of January, 1995 and the patent and the approval to sell or distribute the article or substance on the basis of appropriate tests conducted on or after the 1st day of January, 1995, in that country has been granted on or after the date of making a claim for patent covered under sub-section (2) of section 5; or

(b) where an invention has been made in India and before filing such a claim, made a claim for patent on or after the 1st day of January, 1995 for method or process of manufacture for that invention relating to identical article or substance and has been granted in India the patent therefore on or after the date of making a claim for patent covered under sub-section (2) of section 5.

and has received the approval to sell or distribute the article or substance from the authority specified in this behalf by the Central Government, then, he shall have the exclusive right by himself, his agents or licensees to sell or distribute in India the article or the substance on and from the date of approval granted by the Controller in this behalf till a period of five years or till the date of grant of patent or the date of rejection of application for the grant of patent, whichever is earlier.

(2) Where, the specifications of an invention relatable to an article or a substance covered under sub-section (2) of section 5 have been recorded in a document or the invention has been tried or used, or, the article or the substance has been sold, by a person, before a claim for a patent of that invention is made in India or in a convention country, then, the sale or distribution of the article or substance by such person, after the claim referred to above is made, shall not be deemed to be an infringement of exclusive right to sell or distribute under sub-section (1):

Provided that nothing in this sub-section shall apply in a case where a person makes or uses an article or a substance with a view to sell or distribute the same, the details of invention relatable thereto were given by a person who was holding an exclusive right to sell or distribute the article or substance.

24C. The provisions in relation to compulsory licenses in Chapter XVI shall, subject to the necessary modifications, apply in relation to an exclusive right to sell or distribute under section 24B as they apply to, and in relation to, a right under a patent to sell or distribute and for that purpose the following modifications shall be deemed to have been made to the provisions of that Chapter and all their grammatical variations and cognate expressions shall be construed accordingly, namely:—

(a) Throughout Chapter XVI,—

(i) working of the invention shall be deemed to be selling or distributing of the article or substance;

(ii) references to "patents" shall be deemed to be references to "right to sell or distribute",

(iii) references to "patented article" shall be deemed to be references to "an article for which exclusive right to sell or distribute has been granted";

(b) three years from the date of sealing of a patent in section 84 shall be deemed to be two years from the date of approval by the Controller for exclusive right to sell or distribute under section 24B;

(c) the time which has elapsed since the sealing of a patent under section 85 shall be deemed to be the time which has elapsed since the approval by the Controller for exclusive right to sell or distribute under section 24B;
(d) clauses (d) and (e) of section 90 shall be omitted.

24D. (1) Without prejudice to the provisions of any other law for the time being in force, where, at any time after an exclusive right to sell or distribute any article or substance has been granted under sub-section (1) of section 24B, the Central Government is satisfied that it is necessary or expedient in public interest to sell or distribute the article or substance by a person other than a person to whom exclusive right has been granted under sub-section (1) of section 24B, it may, by itself or through any person authorized in writing by it in this behalf, sell or distribute the article or substance.

(2) The Central Government may by notification in the Official Gazette and at any time after an exclusive right to sell or distribute an article or a substance has been granted, direct, in the public interest and for reasons to be stated, that the said article or substance shall be sold at a price determined by an authority specified by it in this behalf.

24E. All suits relating to infringement of a right under section 24B shall be dealt with in the same manner as they were suits concerning infringement of patents under Chapter XVIII.

24F. The examination and investigations required under this Chapter shall not be deemed in any way to warrant the validity of any grant of exclusive right to sell or distribute, and no liability shall be incurred by the Central Government or any officer thereof by reason of, or in connection with, any such examination or investigation or any report or other proceedings consequent thereon.

4. Section 39 of the principal Act shall be omitted.

5. In section 40 of the principal Act, the words and figures "or makes or causes to be made an application for the grant of a patent outside India in contravention of section 39" shall be omitted.

6. In section 64 of the principal Act, in sub-section (1), in clause (n), the words and figures "or made or caused to be made an application for the grant of a patent outside India in contravention of section 39" shall be omitted.

7. In section 118 of the principal Act, the words and figures "or makes or causes to be made an application for the grant of a patent in contravention of section 39" shall be omitted.

8. After section 157 of the principal Act, the following section shall be inserted, namely:

'157A. 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 a patent under this Act, which it considers prejudicial to the interest of security of India;

(b) take action including the revocation of any patent which it considers necessary in the interest of security of India:

Provided that the Central Government shall, before taking any action under this clause, issue a notification in the Official Gazette declaring its intention to take such action.

Explanation. – For the purposes of this section, the expression "security of India" means 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 or the purpose of supplying a military establishment; or

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

9. (1) The Patents (Amendment) Ordinance 1999, is hereby repealed.

(2) Notwithstanding such repeal, anything done or any action taken under the principal Act, as amended by the Patents (Amendment) Ordinance, 1994, which ceased to operate, or under the Patents (Amendment) Ordinance, 1999, shall be deemed to have been done or taken under the corresponding provisions of the principal Act, as amended by this Act.

(3) All applications made in respect of claims for patent of invention specified under sub-section (2) of section 5 of the principal Act, from the date of cesser of the Patents (Amendment) Ordinance, 1994 till the date on which this Act receives the assent of the President (both days inclusive) shall be deemed to have been validly made as if the provisions of the principal Act, as amended by this Act, had been in force at all material times.

Raghbir Singh,
Secretary to the Government of India
An Act further to amend the Patents Act, 1970.

BE it enacted by Parliament in the Fifty-third Year of the Republic of India as follows:-

1. SHORT TITLE AND COMMENCEMENT.--(1) This Act may be called the Patents (Amendment) Act, 2002.

(2) It shall come into force on such date as the Central Government may, by notification in the Official Gazette, appoint; and different dates may be appointed for different provisions of this Act and any reference in any such provision to the commencement of this Act shall be construed as a reference to the coming into force of that provision.

2. SUBSTITUTION OF CERTAIN WORDS FOR THE WORDS "HIGH COURT" AND "COURT".--In the Patents Act, 1970 (39 of 1970) (hereinafter referred to as the principal Act), for the words "High Court" wherever they occur in sections 21, 43 and 71 and the word "Court" occurring in sections 21 and 71, the words "Appellate Board" and "Board" shall respectively be substituted.

3. AMENDMENT OF SECTION 2.--In section 2 of the principal Act, in sub-section (1),-(a) for clause (a), the following clauses shall be substituted, namely:- '(a) "Appellate Board" means the Appellate Board referred to in section 116;

(ab) "assignee" includes an assignee of the assignee and the legal representative of a deceased assignee and references to the assignee of any person include references to the assignee of the legal representative or assignee of that person;

(ac) "capable of industrial application", in relation to an invention, means that the invention is capable of being made or used in an industry;

(b) for clause (d), the following clause shall be substituted, namely:-

'(d) "convention country" means a country or a country which is member of a group of countries or a union of countries or an Inter-governmental organisation notified as such under sub-section (1) of section 133;

(c) for clause (g), the following clause shall be substituted, namely:-

'(g) "food" means any article of nourishment for human consumption and also includes any substance intended for the use of infants, invalids or convalescents as an article of food or drink;
(d) in clause (i),-

(i) in sub-clause (i), for the words "Union territory of Delhi", the words "National Capital Territory of Delhi" shall be substituted;

(ii) for sub-clause (ii), the following sub-clause shall be substituted, namely:-

"(ii) in relation to the State of Arunachal Pradesh and the State of Mizoram, the Gauhati High Court (the High Court of Assam, Nagaland, Meghalaya, Manipur, Tripura, Mizoram and Arunachal Pradesh);"

(iii) in sub-clause (v), for the words "Union territory of Goa, Daman and Diu", the words "State of Goa, the Union territory of Daman and Diu" shall be substituted;

(e) after clause (i), the following clause shall be inserted, namely:-

'(ia) "international application" means an application for patent made in accordance with the Patent Cooperation Treaty;'

(f) for clause (j), the following clauses shall be substituted, namely:-

'(j) "invention" means a new product or process involving an inventive step and capable of industrial application;

(ja) "inventive step" means a feature that makes the invention not obvious to a person skilled in the art;'

(g) for clause (m), the following clause shall be substituted, namely:-

'(m) "patent" means a patent granted under this Act;'

(h) after clause (o), the following clause shall be inserted, namely:-

'(oa) "Patent Cooperation Treaty" means the Patent Cooperation Treaty done at Washington on the 19th day of June, 1970 as amended and modified from time to time;'

(i) for clause (u), the following clause shall be substituted, namely:-

'(u) "prescribed" means,-

(A) in relation to proceedings before a High Court, prescribed by rules made by the High Court;

(B) in relation to proceedings before the Appellate Board, prescribed by rules made by the Appellate Board; and

(C) in other cases, prescribed by rules made under this Act.'

Amendment of section 3.

4. Amendment of section 3.-In section 3 of the principal Act,-

(a) for clause (b), the following clause shall be substituted, namely:-
(b) an invention the primary or intended use or commercial exploitation of which would be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment;"

(b) in clause (c), after the words "an abstract theory", the words "or discovery of any living thing or non-living substance occurring in nature" shall be inserted;

(c) clause (g) shall be omitted;

(d) in clause (i),

(i) after the word "prophylactic", the words "diagnostic, therapeutic" shall be inserted;

(ii) the words "or plants" shall be omitted;

(e) after clause (i), the following clauses shall be inserted, namely:-

"(j) plants and animals in whole or any part thereof other than micro-organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;

(k) a mathematical or business method or a computer programme per se or algorithms;

(l) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;

(m) a mere scheme or rule or method of performing mental act or method of playing game;

(n) a presentation of information;

(o) topography of integrated circuits;

(p) an invention which, in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components.".

Amendment of section 5.

5. Amendment of section 5.-In section 5 of the principal Act, after sub-section (2), the following Explanation shall be inserted, namely:-

'Explanation.-For the purposes of this section, "chemical processes" includes biochemical, biotechnological and microbiological processes.'.

Amendment of section 7.

6. Amendment of section 7.-In section 7 of the principal Act, after sub-section (1), the following sub-section shall be inserted, namely:-

"(1A) Every international application under the Patent Cooperation Treaty for a patent, as may be filed designating India, shall be deemed to be an application under this Act, if a corresponding application has also been filed before the Controller in India.".
Amendment of section 8.

7. Amendment of section 8.-

In section 8 of the principal Act,-

(a) in sub-section (1),-

(i) in the opening portion, after the words "he shall file along with his application", the words "or subsequently within such period as the Controller may, for good and sufficient reasons, allow" shall be inserted;

(ii) for clause (a), the following clause shall be substituted, namely:-

"(a) a statement setting out detailed particulars of such application; and";

(iii) in clause (b), for the words "details of the nature referred to in", the words "detailed particulars as required under" shall be substituted;

(b) for sub-section (2), the following sub-section shall be substituted, namely:-

"(2) At any time after an application for patent is filed in India and till the grant of patent or refusal to grant of patent is made thereon, the Controller may also require the applicant to furnish details, as may be prescribed, relating to the processing of the application in a country outside India, and in that event the applicant shall furnish information available to him to the Controller within thirty days from the date of receipt of the communication requiring such furnishing of information or within such further period as the Controller may, for good and sufficient reasons, allow.".

Amendment of section 10.

8. Amendment of section 10.-In section 10 of the principal Act,-

(a) in sub-section (4), after clause (c), the following clause shall be inserted, namely:-

"(d) be accompanied by an abstract to provide technical information on the invention:

Provided that-

(i) the Controller may amend the abstract for providing better information to third parties; and

(ii) if the applicant mentions a biological material in the specification which may not be described in such a way as to satisfy clauses (a) and (b), and if such material is not available to the public, the application shall be completed by depositing the material to an authorised depository institution as may be notified by the Central Government in the Official Gazette and by fulfilling the following conditions, namely:-

(A) the deposit of the material shall be made not later than the date of the patent application in India;

(B) all the available characteristics of the material required for it to be correctly identified or indicated are included in the specification including the name, address of the depository institution and the date and number of the deposit of the material at the institution;
(C) access to the material is available in the depository institution only after the date of the application for patent in India or if a priority is claimed after the date of the priority;

(D) disclose the source and geographical origin of the biological material in the specification, when used in an invention.

(b) after sub-section (4), the following sub-section shall be inserted, namely:

"(4A) In case of an international application designating India,-

(i) the title, description, drawings, abstract and claims filed with the application shall be taken as the complete specification for the purposes of this Act; and

(ii) the filing date of the application and its complete specification, processed by the patent office as designated office or elected office, shall be the international filing date accorded under the Patent Cooperation Treaty.";

(c) for sub-section (5), the following sub-section shall be substituted, namely:

"(5) The claim or claims of a complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification.".

Amendment of Chapter IV.

9. Amendment of Chapter IV.- In Chapter IV of the principal Act,-

(a) for the Chapter heading "EXAMINATION OF APPLICATIONS", the following Chapter heading shall be substituted, namely:

"PUBLICATION AND EXAMINATION OF APPLICATIONS";

(b) before section 12, the following sections shall be inserted, namely:

"11A. Publication of applications.(1) Applications for patents shall not be open to the public for a period of eighteen months from the date of filing or date of priority, whichever is earlier.

(2) Except when a secrecy direction is given under section 35, every application for a patent shall, on the expiry of the period as specified in sub-section (1), be published.

(3) The publication of every application for a patent shall be notified in the Official Gazette.

(4) In case a secrecy direction has been given in respect of an application under section 35, then, it shall be published after the expiry of the period of eighteen months or when the secrecy direction has ceased to operate, whichever is later.

(5) The publication of every application under this section shall include the particulars of the date of application, number of application, name and address of the applicant identifying the application and an abstract.

(6) Upon publication of an application for a patent under this section-
(a) the depository institution shall make the biological material mentioned in the specification available to the public;

(b) the patent office may, on payment of such fee as may be prescribed, make the specification and drawings, if any, of such application available to the public.

11B. Request for examination.-

(1) No application for a patent shall be required to be examined unless the applicant or any other interested person makes a request in the prescribed manner for such examination within forty-eight months from the date of filing of the application for patent.

(2) In case of an application filed before the commencement of the Patents (Amendment) Act, 2002, a request in the prescribed manner for examination shall be made by the applicant or any other interested person within a period of twelve months from the date of such commencement or within forty-eight months from the date of the application, whichever is later.

(3) In case of an application in respect of a claim for a patent covered under sub-section (2) of section 5, a request in the prescribed manner for examination shall be made by the applicant or any other interested person within a period of twelve months from the 31st day of December, 2004 or within forty-eight months from the date of the application, whichever is later.

(4) In case the applicant or any other interested person does not make a request for examination of the application for a patent within the period as specified under sub-section (1) or sub-section (2) or sub-section (3), the application shall be treated as withdrawn by the applicant:

Provided that-

(i) the applicant may, at any time after the filing of the application but before the grant of the patent, withdraw the application made by him; and

(ii) in a case where a secrecy direction has been issued under section 35, the request for examination may be made within forty-eight months from the date of revocation of the secrecy direction.

Amendment of section 12.

10. Amendment of section 12.-In section 12 of the principal Act,-

(a) in sub-section (1),-

(i) for the words "When the complete specification has been filed in respect of an application for a patent, the application and specification relating thereto", the words, brackets, figures and letter "When a request for examination has been made in respect of an application for a patent in the prescribed manner under sub-section (1) or sub-section (2) or sub-section (3) of section 11B, the application and specification and other documents relating thereto" shall be substituted;

(ii) in clause (a), for the words "specification relating thereto", the words "specification and other documents relating thereto" shall be substituted;

(b) in sub-section (2), for the words "specification relating thereto", the words "specification and other documents relating thereto" shall be substituted.
Amendment of section 13.

11. Amendment of section 13.-In section 13 of the principal Act, in sub-section (2), the words "as the Controller may direct" shall be omitted.

Substitution of new section for section 15.

12. Substitution of new section for section 15.-For section 15 of the principal Act, the following section shall be substituted, namely:-

"15. Power of Controller to refuse or require amended applications, etc., in certain cases.-Where the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may require the application, specification or other document, as the case may be, to be amended to his satisfaction before he proceeds with the application or refuse the application on failure to do so.".

Amendment of section 17.

13. Amendment of section 17.-In section 17 of the principal Act, for sub-section (2), the following sub-section shall be substituted, namely:-

"(2) Where an application or specification (including drawings) or any other document is required to be amended under section 15, the application or specification or other document shall, if the Controller so directs, be deemed to have been made on the date on which the requirement is complied with or where the application or specification or other document is returned to the applicant, on the date on which it is refilled after complying with the requirement.".

Amendment of section 21.

14. Amendment of section 21.-In section 21 of the principal Act,-

(a) in sub-section (1), for the portion beginning with the words "fifteen months" and ending with the words "of this section", the words "twelve months from the date on which the first statement of objections to the application or complete specification or other documents relating thereto is forwarded to the applicant by the Controller," shall be substituted;

(b) sub-section (2) shall be omitted;

(c) in sub-section (3),-

(i) for the words, brackets and figure "fifteen months specified in sub-section (1) or the extended period", the words "twelve months" shall be substituted;

(ii) for the words "fifteen months or the extended period, as the case may be", the words "twelve months" shall be substituted;

(d) in sub-section (4), for the words "fifteen months, or as the case may be, the extended period, until the expiration of", the words "twelve months to" shall be substituted.

Amendment of section 22.
15. Amendment of section 22.-In section 22 of the principal Act, in the proviso, for the words "eighteen months", the words "twelve months" shall be substituted.

Amendment of section 23.

16. Amendment of section 23.-In section 23 of the principal Act, for the words "filed in pursuance thereof", the words "as accepted by the Controller along with other documents filed by the applicant in pursuance thereof" shall be substituted.

Amendment of section 24C.

17. Amendment of section 24C.-In section 24C of the principal Act, -

(a) in clause (c), for the word and figures "section 85", the word and figures "section 84" shall be substituted;

(b) for clause (d), the following clause shall be substituted, namely:-

"(d) clause (e) of sub-section (7) of section 84 shall be omitted."

Amendment of section 25.

18. Amendment of section 25.-In section 25 of the principal Act, -

(a) in sub-section (1), after clause (i), the following clauses shall be inserted, namely:-

"(j) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;

(k) that the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere;"

(b) in sub-section (2), for the words "shall give", the words "may, if so desired, give" shall be substituted;

(c) in sub-section (3), after the words "shall be taken of any", the words "personal document or secret trial or" shall be inserted.

Amendment of section 35.

19. Amendment of section 35.-In section 35 of the principal Act, in sub-section (1), the words "to any person or class of persons specified in the directions" shall be omitted.

Amendment of section 36.

20. Amendment of section 36.-In section 36 of the principal Act, for sub-section (1), the following sub-section shall be substituted, namely:-

"(1) The question whether an invention in respect of which directions have been given under section 35 continues to be relevant for defence purposes shall be reconsidered by the Central Government at intervals of twelve months or on a request made by the applicant which is found to be reasonable by the Controller
and if, on such reconsideration it appears to the Central Government that the publication of the invention would no longer be prejudicial to the defence of India or in case of an application filed by a foreign applicant it is found that the invention is published outside India, it shall forthwith give notice to the Controller to revoke the direction and the Controller shall thereupon revoke the directions previously given by him.”.

Insertion of new section 39.

21. Insertion of new section 39.-After section 38 of the principal Act, the following section shall be inserted, namely:-

"39. Prohibition to apply, under certain circumstances, for patents relevant for defence purposes, etc.- (1) No person shall, except under the authority of a written permit granted by or on behalf of the Controller, make or cause to be made any application outside India for the grant of a patent for an invention relevant for defence purposes or related to atomic energy unless-

(a) an application for a patent for the same invention has been made in India, not less than six weeks before the application outside India; and

(b) either no direction has been given under sub-section (1) of section 35 in relation to the application in India, or all such directions have been revoked.

(2) The Controller shall not grant written permission to any person to make any application outside India without the prior consent of the Central Government.

(3) This section shall not apply in relation to an invention for which an application for protection has first been filed in a country outside India by a person resident outside India.”.

Amendment of section 40.

22. Amendment of section 40.-In section 40 of the principal Act, after the words and figures "under section 35", the words and figures "or makes or causes to be made an application for grant of a patent outside India in contravention of section 39" shall be inserted.

Amendment of section 43.

23. Amendment of section 43.-In section 43 of the principal Act, in sub-section (1), (a) in clause (c), the word "or" shall be inserted at the end;

(b) after clause (c), the following clause shall be inserted, namely:-

"(d) the application has not been found to be in contravention of any of the provisions of the Act,”.

Amendment of section 45.

24. Amendment of section 45.-In section 45 of the principal Act, for sub-section (1), the following sub-section shall be substituted, namely:-

"(1) Subject to the other provisions contained in this Act, every patent shall be dated as of the date on which the application for patent was filed.”.
Substitution of new section for section 48.

25. Substitution of new section for section 48.-For section 48 of the principal Act, the following section shall be substituted, namely:-

"48. Rights of patentees.-Subject to the other provisions contained in this Act and the conditions specified in section 47, a patent granted under this Act shall confer upon the patentee-

(a) where the subject matter of the patent is a product, the exclusive right to prevent third parties, who do not have his consent, from the act of making, using, offering for sale, selling or importing for those purposes that product in India;

b) where the subject matter of the patent is a process, the exclusive right to prevent third parties, who do not have his consent, from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes he product obtained directly by that process in India:

Provided that the product obtained is not a product in respect of which no patent shall be granted under this Act.".

Amendment of section 50.

26. Amendment of section 50.-In section 50 of the principal Act, in

sub-section (2), for the words "make, use, exercise and sell the patented invention", the words and figures "the rights conferred by section 48" shall be substituted.

Amendment of section 53.

27. Amendment of section 53.-In section 53 of the principal Act,-

(a) for sub-section (1), the following sub-section shall be substituted, namely:-

"(1) Subject to the provisions of this Act, the term of every patent granted, after the commencement of the Patents (Amendment) Act, 2002, and the term of every patent which has not expired and has not ceased to have effect, on the date of such commencement, under this Act, shall be twenty years from the date of filing of the application for the patent.;"

(b) after sub-section (3), the following sub-section shall be inserted, namely:-

"(4) Notwithstanding anything contained in any other law for the time being in force, on cessation of the patent right due to non-payment of renewal fee or on the expiry of the term of patent, the subject matter covered by the said patent shall not be entitled to any protection.".

Amendment of section 57.

28. Amendment of section 57.-In section 57 of the principal Act,-

(a) in sub-section (1), after the word "specification" at both the places where it occurs, the words "or any document relating thereto" shall be inserted;

(b) in sub-section (2), for the words "or a specification", the words"or a complete specification or any document relating thereto" shall be substituted;
(c) for sub-section (3), the following sub-section shall be substituted, namely:-

"(3) Any application for leave to amend an application for a patent or a complete specification or a document relating thereto under this section made after the acceptance of the complete specification and the nature of the proposed amendment may be advertised in the Official Gazette if the amendment, in the opinion of the Controller, is substantive.;"

(d) in sub-section (6),-

(i) after the words "amend his specification", the words "or any document relating thereto" shall be inserted;

(ii) after the words "acceptance of the complete specification", the words "along with other documents filed by the applicant" shall be inserted.

Amendment of section 59.

29. Amendment of section 59.-In section 59 of the principal Act,-

(i) for sub-section (1), the following sub-section shall be substituted, namely:-

"(1) No amendment of an application for a patent or a complete specification or any document relating thereto shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of incorporation of actual fact, and no amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.;"

(ii) in sub-section (2),-

(a) for the words "complete specification, any amendment of the specification", the words "complete specification along with other documents relating thereto, any amendment of the specification or any other document relating thereto" shall be substituted

(b) in clause (a), for the word "specification", the words "specification along with other documents relating thereto" shall be substituted;

(c) in clause (b), for the word "specification", the words "specification or any other document relating thereto" shall be substituted.

Amendment of section 60.

30. Amendment of section 60.-In section 60 of the principal Act,-

(a) in sub-section (1), for the words "one year", the words "eighteen months" shall be substituted;

(b) sub-section (2) shall be omitted.

Amendment of section 64.

31. Amendment of section 64.-In section 64 of the principal Act,
(a) in sub-section (1),-

(i) the proviso to clause (b) shall be omitted;

(ii) the proviso to clause (e) shall be omitted;

(ii) the proviso to clause (f) shall be omitted;

(iv) in clause (n), after the words and figures "under section 35", the words and figures "or made or caused to be made an application for the grant of a patent outside India in contravention of section 39" shall be inserted;

(v) after clause (o), the following clauses shall be inserted, namely:-

"(p) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;

(q) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.";

(b) in sub-section (2), in clause (a), for the words "secret use", the words "personal document or secret trial or secret use" shall be substituted.

Amendment of section 67.

32. Amendment of section 67.-In section 67 of the principal Act, for

sub-section (4), the following sub-sections shall be substituted, namely:-

"(4) Notwithstanding anything contained in sub-section (1), it shall be lawful for the Controller to keep the register of patents or any part thereof in computer floppies, diskettes or any other electronic form subject to such safeguards as may be prescribed.

(5) Notwithstanding anything contained in the Indian Evidence Act, 1872 (1 of 1872), a copy of, or extracts from, the register of patents, certified to be a true copy under the hand of the Controller or any officer duly authorised by the Controller in this behalf shall, in all legal proceedings, be admissible in evidence.

(6) In the event the register is kept wholly or partly in computer floppies, diskettes or any other electronic form,-

(a) reference in this Act to an entry in the register shall be deemed to include reference to a record of particulars kept in computer floppies, diskettes or any other electronic form and comprising the register or part of the register;

(b) references in this Act to particulars being registered or entered in the register shall be deemed to include references to the keeping of record of those particulars comprising the register or part of the register in computer floppies, diskettes or a y other electronic form; and

(c) references in this Act to the rectification of the register are to be read as including references to the rectification of the record of particulars kept in computer floppies, diskettes or any other electronic form and comprising the register or part of the register.".
Amendment of section 68.

33. Amendment of section 68.—In section 68 of the principal Act, for the words "the Controller within six months from the commencement of this Act or the execution of the document, whichever is later or within such further period", the words "the Controller within six months from the execution of the document or within such further period" shall be substituted.

Amendment of section 72.

34. Amendment of section 72.—In section 72 of the principal Act,

after sub-section (2), the following sub-section shall be inserted, namely:

"(3) If the record of particulars is kept in computer floppies or diskettes or in any other electronic form, sub-sections (1) and (2) shall be deemed to have been complied with if the public is given access to such computer floppies, diskettes or any other electronic form or printouts of such record of particulars for inspection."

Amendment of section 73.

35. Amendment of section 73.—In section 73 of the principal Act, in sub-section (1), for the words and figures "section 4 of the Trade and Merchandise Marks Act, 1958 (43 of 1958)" the words and figures "section 3 of the Trade Marks Act, 1999 (47 of 199)" shall be substituted.

Amendment of section 76.

36. Amendment of section 76.—In section 76 of the principal Act, (a) for the words "Central Government", the words "Central Government or Appellate Board" shall be substituted; (b) in clauses (a) and (b), the words and figures "or under the Indian Patents and Designs Act, 1911 (2 of 1911)" shall respectively be omitted.

Amendment of section 78.

37. Amendment of section 78.—In section 78 of the principal Act, in

sub-section (1), after the words "complete specifications", the words "or other documents relating thereto" shall be inserted.

Amendment of section 80.

38. Amendment of section 80.—In section 80 of the principal Act, the following proviso shall be inserted at the end, namely:— "Provided that the party desiring a hearing makes the request for such hearing to the Controller at least ten days in advance of the expiry of the time-limit specified in respect of the proceeding."

Substitution of new Chapter for Chapter XVI.

39. Substitution of new Chapter for Chapter XVI.—For Chapter XVI of the principal Act, the following Chapter shall be substituted, namely:

'CHAPTER XVI WORKING OF PATENTS, COMPULSORY LICENCES AND REVOCATION
82. Definitions of "patented articles" and "patentee".-In this Chapter, unless the context otherwise requires,-

(a) "patented article" includes any article made by a patented process; and

(b) "patentee" includes an exclusive licensee.

83. General principles applicable to working of patented inventions.-Without prejudice to the other provisions contained in this Act, in exercising the powers conferred by this Chapter, regard shall be had to the following general considerations, namely:

(a) that patents are granted to encourage inventions and to secure that the inventions are worked in India on a commercial scale and to the fullest extent that is reasonably practicable without undue delay;

(b) that they are not granted merely to enable patentees to enjoy a monopoly for the importation of the patented article;

(c) that the protection and enforcement of patent rights contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations;

(d) that patents granted do not impede protection of public health and nutrition and should act as instrument to promote public interest specially in sectors of vital importance for socio-economic and technological development of India;

(e) that patents granted do not in any way prohibit Central Government in taking measures to protect public health;

(f) that the patent right is not abused by the patentee or person deriving title or interest on patent from the patentee, and the patentee or a person deriving title or interest on patent from the patentee does not resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology; and

(g) that patents are granted to make the benefit of the patented invention available at reasonably affordable prices to the public.

84. Compulsory licences.- (1) At any time after the expiration of three years from the date of the sealing of a patent, any person interested may make an application to the Controller for grant of compulsory licence on patent on any of the following grounds, namely:-

(a) that the reasonable requirements of the public with respect to the patented invention have not been satisfied, or

(b) that the patented invention is not available to the public at a reasonably affordable price, or

(c) that the patented invention is not worked in the territory of India.

(2) An application under this section may be made by any person notwithstanding that he is already the holder of a licence under the patent and no person shall be estopped from alleging that the reasonable requirements of the public with respect to the patented invention are not satisfied or that the patented invention is not worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price by reason of any admission made by him, whether in such a licence or otherwise or by reason of his having accepted such a licence.
(3) Every application under sub-section (1) shall contain a statement setting out the nature of the applicant's interest together with such particulars as may be prescribed and the facts upon which the application is based.

(4) The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied or that the patented invention is not worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price, may grant a licence upon such terms as he may deem fit.

(5) Where the Controller directs the patentee to grant a licence he may, as incidental thereto, exercise the powers set out in section 88.

(6) In considering the application filed under this section, the Controller shall take into account,- (i) the nature of the invention, the time which has elapsed since the sealing of the patent and the measures already taken by the patentee or any licensee to make full use of the invention;

(ii) the ability of the applicant to work the invention to the public advantage;

(iii) the capacity of the applicant to undertake the risk in providing capital and working the invention, if the application were granted;

(iv) as to whether the applicant has made efforts to obtain a licence from the patentee on reasonable terms and conditions and such efforts have not been successful within a reasonable period as the Controller may deem fit:

Provided that this clause shall not be applicable in case of national emergency or other circumstances of extreme urgency or in case of public non-commercial use or on establishment of a ground of anti-competitive practices adopted by the patentee,

but shall not be required to take into account matters subsequent to the making of the application.

(7) For the purposes of this Chapter, the reasonable requirements of the public shall be deemed not to have been satisfied-

(a) if, by reason of the refusal of the patentee to grant a licence or licences on reasonable terms,-

(i) an existing trade or industry or the development thereof or the establishment of any new trade or industry in India or the trade or industry of any person or class of persons trading or manufacturing in India is prejudiced; or

(ii) the demand for the patented article has not been met to an adequate extent or on reasonable terms; or

(iii) a market for export of the patented article manufactured in India is not being supplied or developed; or

(iv) the establishment or development of commercial activities in India is prejudiced; or

(b) if, by reason of conditions imposed by the patentee upon the grant of licences under the patent or upon the purchase, hire or use of the patented article or process, the manufacture, use or sale of materials not protected by the patent, or the establishment or development of any trade or industry in India, is prejudiced; or

(c) if the patentee imposes a condition upon the grant of licences under the patent to provide exclusive grant back, prevention to challenges to the validity of patent or coercive package licensing, or
(d) if the patented invention is not being worked in the territory of India on a commercial scale to an adequate extent or is not being so worked to the fullest extent that is reasonably practicable, or

(e) if the working of the patented invention in the territory of India on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by-

(i) the patentee or persons claiming under him; or

(ii) persons directly or indirectly purchasing from him; or

(iii) other persons against whom the patentee is not taking or has not taken proceedings for infringement.

85. Revocation of patents by the Controller for non-working.—(1) Where, in respect of a patent, a compulsory licence has been granted, the Central Government or any person interested may, after the expiration of two years from the date of the order granting the first compulsory licence, apply to the Controller for an order revoking the patent on the ground that the patented invention has not been worked in the territory of India or that reasonable requirements of the public with respect to the patented invention has not been satisfied or that the patented invention is not available to the public at a reasonably affordable price.

(2) Every application under sub-section (1) shall contain such particulars as may be prescribed, the facts upon which the application is based, and, in the case of an application other than by the Central Government, shall also set out the nature of the applicant's interest.

(3) The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied or that patented invention has not been worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price, may make an order revoking the patent.

(4) Every application under sub-section (1) shall ordinarily be decided within one year of its being presented to the Controller.

86. Power of Controller to adjourn applications for compulsory licences, etc., in certain cases.—(1) Where an application under section 84 or section 85, as the case may be, is made on the grounds that the patented invention has not been worked in the territory of India or on the ground mentioned in clause (d) of sub-section (7) of section 84 and the Controller is satisfied that the time which has elapsed since the sealing of the patent has for any reason been insufficient to enable the invention to be worked on a commercial scale to an adequate extent or to enable the invention to be so worked to the fullest extent that is reasonably practicable, he may, by order, adjourn the further hearing of the application for such period not exceeding twelve month in the aggregate as appears to him to be sufficient for the invention to be so worked:

Provided that in any case where the patentee establishes that the reason why a patented invention could not be worked as aforesaid before the date of the application was due to any State or Central Act or any rule or regulation made thereunder or any order of the Government imposed otherwise than by way of a condition for the working of the invention in the territory of India or for the disposal of the patented articles or of the articles made by the process or by the use of the patented plant, machinery, or apparatus, then, the period of adjournment ordered under this sub-section shall be reckoned from the date on which the period during which the working of the invention was prevented by such Act, rule or regulation or order of Government as computed from the date of the application, expires.
(2) No adjournment under sub-section (1) shall be ordered unless the Controller is satisfied that the patentee has taken with promptitude adequate or reasonable steps to start the working of the invention in the territory of India on a commercial scale and to an adequate extent.

87. Procedure for dealing with applications under sections 84 and 85.—(1) Where the Controller is satisfied, upon consideration of an application under section 84, or section 85, that a prima facie case has been made out for the making of an order, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which the application is made, and shall advertise the application in the Official Gazette.

(2) The patentee or any other person desiring to oppose the application may, within such time as may be prescribed or within such further time as the Controller may on application (made either before or after the expiration of the prescribed time) allow, give to the Controller notice of opposition.

(3) Any such notice of opposition shall contain a statement setting out the grounds on which the application is opposed.

(4) Where any such notice of opposition is duly given, the Controller shall notify the applicant, and shall give to the applicant and the opponent an opportunity to be heard before deciding the case.

88. Powers of Controller in granting compulsory licences.—(1) Where the Controller is satisfied on an application made under section 84 that the manufacture, use or sale of materials not protected by the patent is prejudiced by reason of conditions imposed by the patentee upon the grant of licences under the patent, or upon the purchase, hire or use of the patented article or process, he may, subject to the provisions of that section, order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant.

(2) Where an application under section 84 is made by a person being the holder of a licence under the patent, the Controller may, if he makes an order for the grant of a licence to the applicant, order the existing licence to be cancelled, or may, if he thinks fit, instead of making an order for the grant of a licence to the applicant, order the existing licence to be amended.

(3) Where two or more patents are held by the same patentee and an applicant for a compulsory licence establishes that the reasonable requirements of the public have not been satisfied with respect to some only of the said patents, then, if the Controller is satisfied that the applicant cannot efficiently or satisfactorily work the licence granted to him under those patents without infringing the other patents held by the patentee and if those patents involve important technical advancement of considerable economic significance in relation to the other patents, he may, by order, direct the grant of a licence in respect of the other patents also to enable the licensee to work the patent or patents in regard to which a licence is granted under section 84.

(4) Where the terms and conditions of a licence have been settled by the Controller, the licensee may, at any time after he has worked the invention on a commercial scale for a period of not less than twelve months, make an application to the Controller or the revision of the terms and conditions on the ground that the terms and conditions settled have proved to be more onerous than originally expected and that in consequence thereof the licensee is unable to work the invention except at a loss:

Provided that no such application shall be entertained a second time.

89. General purposes for granting compulsory licences.—The powers of the Controller upon an application made under section 84 shall be exercised with a view to securing the following general purposes, that is to say,—
(a) that patented inventions are worked on a commercial scale in the territory of India without undue delay and to the fullest extent that is reasonably practicable;

(b) that the interests of any person for the time being working or developing an invention in the territory of India under the protection of a patent are not unfairly prejudiced.

90. Terms and conditions of compulsory licences.—(1) In settling the terms and conditions of a licence under section 84, the Controller shall endeavour to secure—

(i) that the royalty and other remuneration, if any, reserved to the patentee or other person beneficially entitled to the patent, is reasonable, having regard to the nature of the invention, the expenditure incurred by the patentee in making the invention or in developing it and obtaining a patent and keeping it in force and other relevant factors;

(ii) that the patented invention is worked to the fullest extent by the person to whom the licence is granted and with reasonable profit to him;

(iii) that the patented articles are made available to the public at reasonably affordable prices;

(iv) that the licence granted is a non-exclusive licence;

(v) that the right of the licensee is non-assignable;

(vi) that the licence is for the balance term of the patent unless a shorter term is consistent with public interest;

(vii) that the licence is granted with a predominant purpose of supplying in Indian market and in the case of semi-conductor technology, the licence granted is to work the invention for public non-commercial use and in the case, the licence granted to remedy a practice determined after judicial or administrative process to be anti-competitive, licensee shall be permitted to export the patented product.

(2) No licence granted by the Controller shall authorise the licensee to import the patented article or an article or substance made by a patented process from abroad where such importation would, but for such authorisation, constitute an infringement of the rights of the patentee.

(3) Notwithstanding anything contained in sub-section (2), the Central Government may, if in its opinion it is necessary so to do, in the public interest, direct the Controller at any time to authorise any licensee in respect of a patent to import the patented article or an article or substance made by a patented process from abroad (subject to such conditions as it considers necessary to impose relating among other matters to the royalty and other remuneration, if any, payable to the patentee, the quantum of import, the sale price of the imported article and the period of importation), and thereupon the Controller shall give effect to the directions.

91. Licensing of related patents.—(1) Notwithstanding anything contained in the other provisions of this Chapter, at any time after the sealing of a patent, any person who has the right to work any other patented invention either as patentee or as licensee thereof, exclusive or otherwise, may apply to the Controller for the grant of a licence of the first-mentioned patent on the ground that he is prevented or hindered without such licence from working the other invention efficiently or to the best advantage possible.

(2) No order under sub-section (1) shall be made unless the Controller is satisfied—

(i) that the applicant is able and willing to grant, or procure the grant to the patentee and his licensees if they so desire, of a licence in respect of the other invention on reasonable terms; and
(ii) that the other invention has made a substantial contribution to the establishment or development of commercial or industrial activities in the territory of India.

(3) When the Controller is satisfied that the conditions mentioned in sub-section (1) have been established by the applicant, he may make an order on such terms as he thinks fit granting a licence under the first-mentioned patent and a similar order under the other patent if so requested by the proprietor of the first-mentioned patent or his licensee:

Provided that the licence granted by the Controller shall be non-assignable except with the assignment of the respective patents.

(4) The provisions of sections 87, 88, 89 and 90 shall apply to licences granted under this section as they apply to licences granted under section 84.

92. Special provision for compulsory licences on notifications by Central Government.—(1) If the Central Government is satisfied, in respect of any patent in force in circumstances of national emergency or in circumstances of extreme urgency or in case of public non-commercial use, that it is necessary that compulsory licences should be granted at any time after the sealing thereof to work the invention, it may make a declaration to that effect, by notification in the Official Gazette, and thereupon the following provisions shall have effect, that is to say,—

(i) the Controller shall, on application made at any time after the notification by any person interested, grant to the applicant a licence under the patent on such terms and conditions as he thinks fit;

(ii) in settling the terms and conditions of a licence granted under this section, the Controller shall endeavour to secure that the articles manufactured under the patent shall be available to the public at the lowest prices consistent with the patentee deriving a reasonable advantage from their patent rights.

(2) The provisions of sections 83, 87, 88, 89 and 90 shall apply in relation to the grant of licences under this section as they apply in relation to the grant of licences under section 84.

(3) Notwithstanding anything contained in sub-section (2), where the Controller is satisfied on consideration of the application referred to in clause (i) of sub-section (1) that it is necessary in—

(i) a circumstance of national emergency; or

(ii) a circumstance of extreme urgency; or

(iii) a case of public non-commercial use,

which may arise or is required, as the case may be, including public health crises, relating to Acquired Immune Deficiency Syndrome, human immunodeficiency virus, tuberculosis, malaria or other epidemics, he shall not apply any procedure specified in section 87 in relation to that application for grant of licence under this section:

Provided that the Controller shall, as soon as may be practicable, inform the patentee of the patent relating to the application for such non-application of section 87.
93. Order for licence to operate as a deed between parties concerned.-Any order for the grant of a licence under this Chapter shall operate as if it were a deed granting a licence executed by the patentee and all other necessary parties embodying the terms and conditions, if any, settled by the Controller.

94. Termination of compulsory licence.- (1) On an application made by the patentee or any other person deriving title or interest in the patent, a compulsory licence granted under section 84 may be terminated by the Controller, if and when the circumstances that gave rise to the grant thereof no longer exist and such circumstances are unlikely to recur:

Provided that the holder of the compulsory licence shall have the right to object to such termination.

(2) While considering an application under sub-section (1), the Controller shall take into account that the interest of the person who had previously been granted the licence is not unduly prejudiced.”.

Amendment of section 99.

40. Amendment of section 99.-In section 99 of the principal Act,

sub-section (2) shall be omitted.

Amendment of section 100.

41. Amendment of section 100.-In section 100 of the principal Act,-

(a) in sub-section (3), for the proviso, the following proviso shall be substituted, namely:-

"Provided that in case of any such use of any patent, the patentee shall be paid not more than adequate remuneration in the circumstances of each case, taking into account the economic value of the use of the patent."

(b) in sub-section (5), for the words "unless it appears to the Government that it would be contrary to the public interest so to do", the words "except in case of national emergency or other circumstances of extreme urgency or for non-commercial use" shall be substituted;

(c) in sub-section (6), for the words "right to sell the goods", the words "right to sell, on non-commercial basis, the goods" shall be substituted.

Amendment of section 101.

42. Amendment of section 101.-In section 101 of the principal Act,-

(a) in sub-section (1),-

(i) the words ", whether before or after the commencement of this Act," shall be omitted;

(ii) the brackets and words "(including payments by way of minimum royalty)" shall be omitted;

(b) in sub-section (2), the brackets and words "(including payments by way of minimum royalty)" shall be omitted;

(c) in sub-section (3), in clause (b), the words "including payments by way of minimum royalty" shall be omitted.
Insertion of new section 104A.

43. Insertion of new section 104A.-After section 104 of the principal Act, the following section shall be inserted, namely:-

"104A. Burden of proof in case of suits concerning infringement.-(1) In any suit for infringement of a patent, where the subject matter of patent is a process for obtaining a product, the court may direct the defendant to prove that the process used by him to obtain the product, identical to the product of the patented process, is different from the patented process if,-

(a) the subject matter of the patent is a process for obtaining a new product; or

(b) there is a substantial likelihood that the identical product is made by the process, and the patentee or a person deriving title or interest in the patent from him, has been unable through reasonable efforts to determine the process actually used:

Provided that the patentee or a person deriving title or interest in the patent from him, first proves that the product is identical to the product directly obtained by the patented process.

(2) In considering whether a party has discharged the burden imposed upon him by sub-section (1), the court shall not require him to disclose any manufacturing or commercial secrets, if it appears to the court that it would be unreasonable to do so."

Insertion of new section 107A.

44. Insertion of new section 107A.-After section 107 of the principal Act, the following section shall be inserted, namely:-

"107 A. Certain acts not to be considered as infringement.-For the purposes of this Act,-

(a) any act of making, constructing, using or selling a patented invention solely for uses reasonably relating to the development and submission of information required under any law for the time being in force, in India, or in a country other than India that regulates the manufacture, construction, use or sale of any product;

(b) importation of patented products by any person from a person who is duly authorised by the patentee to sell or distribute the product,

shall not be considered as an infringement of patent rights."

Amendment of section 108.

45. Amendment of section 108.-Section 108 of the principal Act shall be numbered as sub-section (1) thereof, and after sub-section (1) as so numbered, the following sub-section shall be inserted, namely:-

"(2) The court may also order that the goods which are found to be infringing and materials and implements, the predominant use of which is in the creation of infringing goods shall be seized, forfeited or destroyed, as the court deems fit under the circumstances of the case without payment of any compensation."

Omission of section 112.
46. Omission of section 112.-Section 112 of the principal Act shall be omitted.

Substitution of new Chapter for Chapter XIX.

47. Substitution of new Chapter for Chapter XIX.-For Chapter XIX of the principal Act, the following Chapter shall be substituted, namely:-

"CHAPTER XIX APPEALS TO THE APPELLATE BOARD

116. Appellate Board.—(1) Subject to the provisions of this Act, the Appellate Board established under section 83 of the Trade Marks Act, 1999 (47 of 1999) shall be the Appellate Board for the purposes of this Act and the said Appellate Board shall exercise the jurisdiction, power and authority conferred on it by or under this Act:

Provided that the Technical Member of the Appellate Board for the purposes of this Act shall have the qualifications specified in sub-section (2).

(2) A person shall not be qualified for appointment as a Technical Member for the purposes of this Act unless he-

(a) has, at least five years, held the post of Controller under this Act or has exercised the functions of the Controller under this Act for at least five years; or

(b) has, for at least ten years, functioned as a Registered Patent Agent and possesses a degree in engineering or technology or a masters degree in science from any University established under law for the time being in force or equivalent; or

(c) has, for at least ten years, been an advocate of a proven specialised experience in practising law relating to patents and designs.

117. Staff of Appellate Board.—(1) The Central Government shall determine the nature and categories of the officers and other employees required to assist the Appellate Board in the discharge of its functions under this Act and provide the Appellate Board with such officers and other employees as it may think fit.

(2) The salaries and allowances and conditions of service of the officers and other employees of the Appellate Board shall be such as may be prescribed.

(3) The officers and other employees of the Appellate Board shall discharge their functions under the general superintendence of the Chairman of the Appellate Board in the manner as may be prescribed.

117A. Appeals to Appellate Board.—(1) Save as otherwise expressly provided in sub-section (2), no appeal shall lie from any decision, order or direction made or issued under this Act by the Central Government, or from any act or order of the Controller for the purpose of giving effect to any such decision, order or direction.

(2) An appeal shall lie to the Appellate Board from any decision, order or direction of the Controller or Central Government under section 15, section 16, section 17, section 18, section 19, section 20, section 25, section 27, section 28, section 51, section 54, section 57, section 60, section 61, section 63, section 66, subsection (3) of section 69, section 78, sub-sections (1) to (5) of section 84, section 85, section 88, section 91, section 92 and section 94.
(3) Every appeal under this section shall be in the prescribed form and shall be verified in such manner as may be prescribed and shall be accompanied by a copy of the decision, order or direction appealed against and by such fees as may be prescribed.

(4) Every appeal shall be made within three months from the date of the decision, order or direction, as the case may be, of the Controller or the Central Government or within such further time as the Appellate Board may, in accordance with the rules made by it, allow.

117B. Procedure and powers of Appellate Board.—The provisions of sub-sections (2) to (6) of section 84, section 87, section 92, section 95 and section 96 of the Trade Marks Act, 1999 (47 of 1999) shall apply to the Appellate Board in the discharge of its functions under this Act as they apply to it in the discharge of its functions under the Trade Marks Act, 1999.

117C. Bar of jurisdiction of courts, etc.—No court or other authority shall have or, be entitled to, exercise any jurisdiction, powers or authority in relation to the matters referred to in sub-section (2) of section 117A or section 117D.

117D. Procedure for application for rectification, etc., before Appellate Board.—(1) An application for rectification of the register made to the Appellate Board under section 71 shall be in such form as may be prescribed.

(2) A certified copy of every order or judgment of the Appellate Board relating to a patent under this Act shall be communicated to the Controller by the Board and the Controller shall give effect to the order of the Board and shall, when so directed, amend the entries in, or rectify, the register in accordance with such order.

117E. Appearance of Controller in legal proceedings.—(1) The Controller shall have the right to appear and be heard—

(a) in any legal proceedings before the Appellate Board in which the relief sought includes alteration or rectification of the register or in which any question relating to the practice of the patent office is raised;

(b) in any appeal to the Appellate Board from an order of the Controller on an application for grant of a patent—

(i) which is not opposed, and the application is either refused by the Controller or is accepted by him subject to any amendments, modifications, conditions or limitations, or

(ii) which has been opposed and the Controller considers that his appearance is necessary in the public interest,

and the Controller shall appear in any case if so directed by the Appellate Board.

(2) Unless the Appellate Board otherwise directs, the Controller may, in lieu of appearing, submit a statement in writing signed by him, giving such particulars as he thinks proper of the proceedings before him relating to the matter in issue or of the grounds of any decision given by him or of the practice of the patent office in like cases, or of other matters relevant to the issues and within his knowledge as the Controller may deem it necessary, and such statement shall be evidence in the proceeding.

117F. Costs of Controller in proceedings before Appellate Board.—In all proceedings under this Act before the Appellate Board, the costs of the Controller shall be in the discretion of the Board, but the Controller shall not be ordered to pay the costs of any of the parties.
117G. Transfer of pending proceedings to Appellate Board.-All cases of appeals against any order or decision of the Controller and all cases pertaining to 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 in the Official Gazette and the Appellate Board may proceed with the matter either de novo or from the stage it was so transferred.

117H. Power of Appellate Board to make rules.-The Appellate Board may make rules consistent with this Act as to the conduct and procedure in respect of all proceedings before it under this Act.

Amendment of section 118.

48. Amendment of section 118.-In section 118 of the principal Act, after the words and figures "under section 35", the words and figures "or makes or causes to be made an application for the grant" inserted.

Amendment of section 120. 49. Amendment of section 120.-In section 120 of the principal Act, for the words "five hundred rupees", the words "ten thousand rupees" shall be substituted.

Amendment of section 122.

50. Amendment of section 122.-In section 122 of the principal Act, in sub-section (1), for the words "one thousand rupees", the words "twenty thousand rupees" shall be substituted.

Amendment of section 123.

51. Amendment of section 123.-In section 123 of the principal Act,-

(a) for the words "five hundred rupees", the words "ten thousand rupees" shall be substituted;

(b) for the words "two thousand rupees", the words "forty thousand rupees" shall be substituted.

Substitution of new section for section 125.

52. Substitution of new section for section 125.-For section 125 of the principal Act, the following section shall be substituted, namely:-

"125. Register of patent agents.—(1) The Controller shall maintain a register to be called the register of patent agents in which shall be entered the names, addresses and other relevant particulars, as may be prescribed, of all persons qualified to have their names so entered under section 126.

(2) Notwithstanding anything contained in sub-section (1), it shall be lawful for the Controller to keep the register of patent agents in computer floppies, diskettes or any other electronic form subject to such safeguards as may be prescribed.”.

Amendment of section 126.

53. Amendment of section 126.-In section 126 of the principal Act,-

(a) in sub-section (1),-

(i) in clause (c),-
(A) for the words "degree from any University", the words "degree in science, engineering or technology from any University established under law for the time being in force" shall be substituted;

(B) in sub-clause (ii), the word "or" shall be inserted at the end;

(ii) after sub-clause (ii), the following sub-clause shall be inserted, namely:-

"(iii) has, for a total period of not less than ten years, functioned either as an examiner or discharged the functions of the Controller under section 73 or both, but ceased to hold any such capacity at the time of making the application for registration;"

(b) for sub-section (2), the following sub-section shall be substituted, namely:-

"(2) Notwithstanding anything contained in sub-section (1), a person who has been registered as a patent agent before the commencement of the Patents (Amendment) Act, 2002 shall be entitled to continue to be, or when required to be re-registered, as a patent agent, on payment of the fees as may be prescribed.".

Amendment of section 128.

54. Amendment of section 128.-In section 128 of the principal Act,-

(a) in sub-section (1), the words "Subject to the provisions contained in sub-section (2) and to any rules made under this Act," shall be omitted;

(b) sub-section (2) shall be omitted.

Amendment of section 130

55. Amendment of section 130.-In section 130 of the principal Act,-

(a) for the words "Central Government" wherever they occur, the word "Controller" shall be substituted;

(b) in sub-section (1), for the word "it" at both the places where it occurs, the word "he" shall be substituted.

Amendment of section 132.

56. Amendment of section 132.-In section 132 of the principal Act,-

(a) in clause (a), the words "or any person, not being a patent agent, who is duly authorised by the applicant" shall be omitted;

(b) in clause (b), for the words "proceedings under this Act, otherwise than by way of drafting any specification", the words "hearing before the Controller on behalf of a party who is taking part in any proceeding under this Act" shall be substituted .

Amendment of section 133.

57. Amendment of section 133.-In section 133 of the principal Act, the following Explanation shall be inserted at the end, namely:- 'Explanation:-For the purposes of this Chapter "country" includes a group or union of countries or Inter-governmental organisation.'.

Amendment of section 138.
58. Amendment of section 138.-In section 138 of the principal Act,-

(a) in sub-section (1), after the words "shall furnish,", the words "when required by the Controller," shall be inserted;

(b) in sub-section (2), for the words "annexed to the specification or document", the words "furnished when required by the Controller" shall be substituted;

(c) after sub-section (3), the following sub-sections shall be inserted, namely:-

"(4) An international application filed under the Patent Cooperation Treaty designating India shall have effect of filing an application for patent under section 7, section 54 and section 135, as the case may be, and the title, description, claim and abstract and drawings, if any, filed in the international application shall be taken as complete specification for the purposes of this Act.

(5) The filing date of an application for patent and its complete specification processed by the patent office as designated office shall be the international filing date accorded under the Patent Cooperation Treaty.

(6) Amendment, if any, proposed by the applicant for an international application designating India or designating and electing India before international searching authority or preliminary examination authority shall, if the applicant so desires, be taken as an amendment made before the patent office."

Amendment of section 140.

59. Amendment of section 140.-In section 140 of the principal Act,-

(a) in sub-section (1), in clause (iii), after sub-clause (c), the following sub-clause shall be inserted, namely:-

"(d) to provide exclusive grant back, prevention to challenges to validity of patent and coercive package licensing;";

(b) sub-section (5) shall be omitted.

Amendment of section 141.

60. Amendment of section 141.-In section 141 of the principal Act, in sub-section (1), the words, "whether made before or after the commencement of this Act," shall be omitted.

Amendment of section 142.

61. Amendment of section 142.-In section 142 of the principal Act,-

(a) for sub-section (3), the following sub-section shall be substituted, namely:-

"(3) Where a fee is payable in respect of the filing of a document at the patent office, the fee shall be paid along with the document or within the prescribed time and the document shall be deemed not to have been filed at the office if the fee has not been paid within such time;"

(b) in sub-section (4), the words "or within the extended period not later than nine months from the date of recording" shall be inserted at the end.
Amendment of section 143.

62. Amendment of section 143.-In section 143 of the principal Act, for the words "or be open to public inspection at any time before the date of advertisement of acceptance of the application", the words "before eighteen months from the date of application or the priority date of the application or before the same is open to public inspection" shall be substituted.

Substitution of new section for section 157A.

63. Substitution of new section for section 157A.—For section 157A of the principal Act, the following section shall be substituted, namely:—

'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.'.

Amendment of section 159.

64. Amendment of section 159.—In section 159 of the principal Act, in sub-section (2),—

(a) after clause (i), the following clauses shall be inserted, namely:—

"(ia) the details to be furnished by the applicant under sub-section (2) of section 8;

(ib) the manner of making the request for examination of an application for patent under sub-sections (1), (2) and (3) of section 11B;";

(b) in clause (iii), after the word "manner", the words "and time" shall be inserted;

(c) in clause (ix), after the word "patents", the words "and the safeguards to be observed in the maintenance of such register in computer floppies, diskettes or any other electronic form" shall be inserted;

(d) after clause (xii), the following clauses shall be inserted, namely:—

"(xia) the salaries and allowances and other conditions of service of the officers and other employees of the Appellate Board under sub-section (2), and the manner in which the officers and other employees of the Appellate Board shall discharge their functions under sub-section (3), of section 117;"
(xiib) the form of making an appeal, the manner of verification and the fees payable under sub-section (3) of section 117A;

(xiiic) the form in which, and the particulars to be included in, the application to the Appellate Board under sub-section (1) of section 117D;"

(e) in clause (xiv), after the word "maintained", the words, brackets and figures "under sub-section (1) of section 125 and the safeguards to be observed in the maintenance of such register of patent agents on computer floppies, diskettes or any other electronic form under sub-section (2) of that section" shall be inserted.

Omission of section 161.

65. Omission of section 161.-Section 161 of the principal Act shall be omitted.

Amendment of section 162.

66. Amendment of section 162.-In section 162 of the principal Act, sub-sections (2) and (3) shall be omitted. ---

- SUBHASH C. JAIN, Secy. to the Govt. of India.
THE PATENTS (AMENDMENT) ACT, 2005

No. 15 of 2005 [4th April, 2005]

An Act further to amend the Patents Act, 1970.

BE it enacted by Parliament in the Fifty-sixth Year of the Republic of India as follows:-

Short title and commencement.

1. Short title and commencement.—(1) This Act may be called the Patents (Amendment) Act, 2005.

(2) Sub-clause (ii) of clause (a), and clause (b), of section 37, sections 41, 42, 47, 59 to 63 (both inclusive) and 74 shall come into force on such date as the Central Government may, by notification in the Official Gazette, appoint; and the remaining provisions of this Act shall be deemed to have come into force on the 1st day of January, 2005.

2. Amendment of section 2.—In section 2 of the Patents Act, 1970 (30 of 1970) (hereinafter referred to as the principal Act), in sub-section (1),—

(a) after clause (ab), the following clause shall be inserted, namely:-

"Budapest Treaty" means the Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the Purposes of Patent Procedure done at Budapest on 28th day of April, 1977, as amended and modified from time to time;"

(b) in clause (d), for the words, brackets and figures "notified as such under sub-section (1) of section 133", the words and figures "referred to as a convention country in section 133" shall be substituted;

(c) clause (g) shall be omitted;

(d) in clause (h),—

(i) in sub-clause (iii), after the words and figures "the Companies Act, 1956 (1 of 1956)", the word "; or" shall be inserted;

(ii) after sub-clause (iii), the following sub-clause shall be inserted, namely:-

"by an institution wholly or substantially financed by the Government;"

(iii) the words "and includes the Council of Scientific and Industrial Research and any other institution which is financed wholly or for the major part by the said Council;" shall be omitted;

(e) for clause (i), the following clause shall be substituted, namely:-

"High Court", in relation to a State or Union territory, means the High Court having territorial jurisdiction in that State or Union territory, as the case may be;"

(f) for clause (ja), the following clause shall be substituted, namely:-
(ja) "inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art;

(g) for clauses (l) and (m), the following clauses shall be substituted, namely:-

'(l) "new invention" means any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification, i.e. the subject matter has not fallen in public domain or that it does not form part of the state of the art;

'(la) "Opposition Board" means an Opposition Board constituted under sub-section (3) of section 25;

(m) "patent" means a patent for any invention granted under this Act;

(h) after clause (t), the following clause shall be inserted, namely:-

(ta) "pharmaceutical substance" means any new entity involving one or more inventive steps;

3. Amendment of section 3.-In section 3 of the principal Act, for clause (d), the following shall be substituted, namely:-

"(d) the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

Explanation.-For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy;".

4. Omission of section 5.-Section 5 of the principal Act shall be omitted.

5. Amendment of section 7.-In section 7 of the principal Act,-

(a) after sub-section (1A), the following sub-section shall be inserted, namely:-

"(1B) The filing date of an application referred to in sub-section (1A) and its complete specification processed by the patent office as designated office or elected office shall be the international filing date accorded under the Patent Cooperation Treaty.;"

(b) in sub-section (3), for the word "owner", the word "person" shall be substituted;

(c) for sub-section (4), the following sub-section shall be substituted, namely:-

"(4) Every such application (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) shall be accompanied by a provisional or a complete specification.".

6. Amendment of section 8.-In section 8 of the principal Act,-

(a) in sub-section (1),-
(i) for the words "within such period as the Controller may, for good and sufficient reasons, allow", the words "within the prescribed period as the Controller may allow" shall be substituted;

(ii) in clause (b), for the words "up to the date of the acceptance of his complete specification filed in India", the words "up to the date of grant of patent in India" shall be substituted;

(b) for sub-section (2), the following sub-section shall be substituted, namely:-

"(2) At any time after an application for patent is filed in India and till the grant of a patent or refusal to grant of a patent made thereon, the Controller may also require the applicant to furnish details, as may be prescribed, relating to the processing of the application in a country outside India, and in that event the applicant shall furnish to the Controller information available to him within such period as may be prescribed.".

7. Amendment of section 9.-In section 9 of the principal Act,-

(a) for sub-section (1), the following sub-section shall be substituted, namely:-

"(1) Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) is accompanied by a provisional specification, a complete specification shall be filed within twelve months from the date of filing of the application, and if the complete specification is not so filed, the application shall be deemed to be abandoned.";

(b) in sub-section (2), the following proviso shall be inserted at the end, namely:-

"Provided that the period of time specified under sub-section (1) shall be reckoned from the date of filing of the earliest provisional specification.";

(c) for sub-section (3), the following sub-section shall be substituted, namely:-

"(3) Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) is accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant so requests at any time within twelve months from the date of filing of the application, direct that such specification shall be treated, for the purposes of this Act, as a provisional specification and proceed with the application accordingly.";

(d) in sub-section (4), for the words "the acceptance of the complete specification", the words "grant of patent" shall be substituted.

8. Amendment of section 10.-In section 10 of the principal Act,-

(a) in sub-section (3), for the words "before the acceptance of the application", the words "before the application is found in order for grant of a patent" shall be substituted;

(b) in sub-section (4), in the proviso,-

(i) in clause (ii), for the words "the material to an authorised depository institution as may be notified by the Central Government in the Official Gazette", the words "the material to an international depository authority under the Budapest Treaty" shall be substituted;

(ii) for sub-clause (A), the following sub-clause shall be substituted, namely:-
"(A) the deposit of the material shall be made not later than the date of filing the patent application in India and a reference thereof shall be made in the specification within the prescribed period;"

(c) for sub-section (4A), the following sub-section shall be substituted, namely:-

"(4A) In case of an international application designating India, the title, description, drawings, abstract and claims filed with the application shall be taken as the complete specification for the purposes of this Act."

9. Amendment of section 11.-In section 11 of the principal Act,

(a) after sub-section (3), the following sub-section shall be inserted, namely:-

"(3A) Where a complete specification based on a previously filed application in India has been filed within twelve months from the date of that application and the claim is fairly based on the matter disclosed in the previously filed application, the priority date of that claim shall be the date of the previously filed application in which the matter was first disclosed.";

(b) in sub-section (6), after the brackets and figure "(3)," the brackets, figure and letter "(3A)," shall be inserted.

10. Amendment of section 11A.-In section 11A of the principal Act,-

(a) for sub-sections (1) to (3), the following sub-sections shall be substituted, namely:-

"(1) Save as otherwise provided, no application for patent shall ordinarily be open to the public for such period as may be prescribed.

(2) The applicant may, in the prescribed manner, request the Controller to publish his application at any time before the expiry of the period prescribed under sub-section (1) and subject to the provisions of sub-section (3), the Controller shall publish such application as soon as possible.

(3) Every application for a patent shall, on the expiry of the period specified under sub-section (1), be published, except in cases where the application-

(a) in which secrecy direction is imposed under section 35; or

(b) has been abandoned under sub-section (1) of section 9; or

(c) has been withdrawn three months prior to the period specified under sub-section (1)."

(b) in sub-section (4), for the words "of eighteen months", the words, brackets and figure "prescribed under sub-section (1)" shall be substituted;

(c) after sub-section (6), the following sub-section shall be inserted, namely:-

"(7) On and from the date of publication of the application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for the invention had been granted on the date of publication of the application:

Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been granted;
Provided further that the rights of a patentee in respect of applications made under sub-section (2) of section 5 before the 1st day of January, 2005 shall accrue from the date of grant of the patent:

Provided also that after a patent is granted in respect of applications made under sub-section (2) of section 5, the patent-holder shall only be entitled to receive reasonable royalty from such enterprises which have made significant investment and were producing and marketing the concerned product prior to the 1st day of January, 2005 and which continue to manufacture the product covered by the patent on the date of grant of the patent and no infringement proceedings shall be instituted against such enterprises.

11. Amendment of section 11B.-In section 11B of the principal Act,-

(a) for sub-section (1), the following sub-section shall be substituted, namely:-

"(1) No application for a patent shall be examined unless the applicant or any other interested person makes a request in the prescribed manner for such examination within the prescribed period.";

(b) sub-section (2) shall be omitted;

(c) for sub-section (3), the following sub-section shall be substituted, namely:-

"(3) In case of an application in respect of a claim for a patent filed under sub-section (2) of section 5 before the 1st day of January, 2005 a request for its examination shall be made in the prescribed manner and within the prescribed period by the applicant or any other interested person.";

(d) in sub-section (4),

(i) the words, brackets and figure "or sub-section (2)" shall be omitted;

(ii) for the proviso, the following proviso shall be substituted, namely:-

(i) the applicant may, at any time after filing the application but before the grant of a patent, withdraw the application by making a request in the prescribed manner; and

(ii) in a case where secrecy direction has been issued under section 35, the request for examination may be made within the prescribed period from the date of revocation of the secrecy direction.

12. Amendment of section 12.-In section 12 of the principal Act,-

(a) in sub-section (1), for the words, brackets, figures and letter "under sub-section (1) or sub-section (2) or sub-section (3) of section 11B, the application and specification and other documents shall be referred to by the Controller", the words, brackets, figures and letter "under sub-section (1) or sub-section (3) of section 11B, the application and specification and other documents related thereto shall be referred at the earliest by the Controller" shall be substituted;

(b) in sub-section (2), for the words "a period of eighteen months from the date of such reference", the words "such period as may be prescribed" shall be substituted.

13. Amendment of section 13.-In section 13 of the principal Act, in sub-section (3), for the words "it has been accepted", the words "the grant of a patent" shall be substituted.

14. Substitution of new sections for sections 14 and 15.—For sections 14 and 15 of the principal Act, the following sections shall be substituted, namely:-
14. Consideration of the report of examiner by Controller.—Where, in respect of an application for a patent, the report of the examiner received by the Controller is adverse to the applicant or requires any amendment of the application, the specification or other documents to ensure compliance with the provisions of this Act or of the rules made thereunder, the Controller, before proceeding to dispose of the application in accordance with the provisions hereinafter appearing, shall communicate as expeditiously as possible the gist of the objections to the applicant and shall, if so required by the applicant within the prescribed period, give him an opportunity of being heard.

15. Power of Controller to refuse or require amended applications, etc., in certain cases.—Where the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may refuse the application or may require the application, specification or the other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application and refuse the application on failure to do so.

15. Amendment of section 16.—In section 16 of the principal Act,—

(a) in sub-section (1), for the words "before the acceptance of the complete specification", the words "before the grant of the patent" shall be substituted;

(b) for the Explanation, the following Explanation shall be substituted, namely:

"Explanation.—For the purposes of this Act, the further application and the complete specification accompanying it shall be deemed to have been filed on the date on which the first mentioned application had been filed, and the further application shall be proceeded with as a substantive application and be examined when the request for examination is filed within the prescribed period."

16. Amendment of section 17.—In section 17 of the principal Act, in sub-section (1), for the words "before acceptance of the complete specification", the words "before the grant of the patent" shall be substituted.

17. Amendment of section 18.—In section 18 of the principal Act,—

(a) in sub-section (1), for the words "to accept the complete specification", the words "the application" shall be substituted;

(b) sub-section (4) shall be omitted.

18. Amendment of section 19.—In section 19 of the principal Act, in sub-section (1), for the words and figures "by the foregoing provisions of this Act or of proceedings under section 25", the words "under this Act" shall be substituted.

19. Substitution of new section for section 21.—For section 21 of the principal Act, the following section shall be substituted, namely:— "21. Time for putting application in order for grant.—(1) An application for a patent shall be deemed to have been abandoned unless, within such period as may be prescribed, the applicant has complied with all the requirements imposed on him by or under this Act, whether in connection with the complete specification or otherwise in relation to the application from the date on which the first statement of objections to the application or complete specification or other documents related thereto is forwarded to the applicant by the Controller.

Explanation.—Where the application for a patent or any specification or, in the case of a convention application or an application filed under the Patent Cooperation Treaty designating India any document filed as part of the application has been returned to the applicant by the Controller in the course of the proceedings, the applicant shall not be deemed to have complied with such requirements unless and until he
has re-filed it or the applicant proves to the satisfaction of the Controller that for the reasons beyond his control such document could not be re-filed.

(2) If at the expiration of the period as prescribed under sub-section (1),-

(a) an appeal to the High Court is pending in respect of the application for the patent for the main invention; or

(b) in the case of an application for a patent of addition, an appeal to the High Court is pending in respect of either that application or the application for the main invention, the time within which the requirements of the Controller shall be complied with shall, on an application made by the applicant before the expiration of the period as prescribed under sub-section (1), be extended until such date as the High Court may determine.

(3) If the time within which the appeal mentioned in sub-section (2) may be instituted has not expired, the Controller may extend the period as prescribed under sub-section (1), to such further period as he may determine:

Provided that if an appeal has been filed during the said further period, and the High Court has granted any extension of time for complying with the requirements of the Controller, then the requirements may be complied with within the time granted by the Court.”.

20. Omission of sections 22 to 24.-Sections 22 to 24 of the principal Act shall be omitted.

21. Omission of Chapter IVA.-Chapter IVA of the principal Act shall be omitted.

22. Substitution of new heading for heading of Chapter V.-In Chapter V of the principal Act, for the Chapter heading "OPPOSITION TO GRANT OF PATENT", the Chapter heading "OPPOSITION PROCEEDINGS TO GRANT OF PATENTS" shall be substituted.

23. Substitution of new sections for sections 25 and 26.-For sections 25 and 26 of the principal Act, the following sections shall be substituted, namely:-

"25. Opposition to the patent.- (1) Where an application for a patent has been published but a patent has not been granted, any person may, in writing, represent by way of opposition to the Controller against the grant of patent on the ground-

(a) that the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim-

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document:

Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 29;
(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant's claim;

(d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

Explanation.-For the purposes of this clause, an invention relating to a process for which a patent is claimed shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only;

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the applicant's claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(h) that the applicant has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge;

(i) that in the case of convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title;

(j) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;

(k) that the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere, but on no other ground and the Controller shall, if requested by such person for being heard, hear him and dispose of such representation in such manner and within such period as may be prescribed.

(2) At any time after the grant of patent but before the expiry of a period of one year from the date of publication of grant of a patent, any person interested may give notice of opposition to the Controller in the prescribed manner on any of the following grounds, namely:-

(a) that the patentee or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim-

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document:
Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 29;

c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the claim of the patentee and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the claim of the patentee;

d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

Explanation.-For the purposes of this clause, an invention relating to a process for which a patent is granted shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only;

e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the claim;

f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

h) that the patentee has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge;

i) that in the case of a patent granted on convention application, the application for patent was not made within twelve months from the date of the first application for protection for the invention made in a convention country or in India by the patentee or a person from whom he derives title;

j) that the complete specification does not disclose or wrongly mentions the source and geographical origin of biological material used for the invention;

k) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere,

but on no other ground.

3) (a) Where any such notice of opposition is duly given under sub-section (2), the Controller shall notify the patentee.

(b) On receipt of such notice of opposition, the Controller shall, by order in writing, constitute a Board to be known as the Opposition Board consisting of such officers as he may determine and refer such notice of opposition along with the documents to that Board for examination and submission of its recommendations to the Controller.

(c) Every Opposition Board constituted under clause (b) shall conduct the examination in accordance with such procedure as may be prescribed.
(4) On receipt of the recommendation of the Opposition Board and after giving the patentee and the opponent an opportunity of being heard, the Controller shall order either to maintain or to amend or to revoke the patent.

(5) While passing an order under sub-section (4) in respect of the ground mentioned in clause (d) or clause (e) of sub-section (2), the Controller shall not take into account any personal document or secret trial or secret use.

(6) In case the Controller issues an order under sub-section (4) that the patent shall be maintained subject to amendment of the specification or any other document, the patent shall stand amended accordingly.

26. In cases of "obtaining" Controller may treat the patent as the patent of opponent.-(1) Where in any opposition proceeding under this Act the Controller finds that-

(a) the invention, so far as claimed in any claim of the complete specification, was obtained from the opponent in the manner set out in clause (a) of sub-section (2) of section 25 and revokes the patent on that ground, he may, on request by such opponent made in the prescribed manner, direct that the patent shall stand amended in the name of the opponent;

(b) a part of an invention described in the complete specification was so obtained from the opponent, he may pass an order requiring that the specification be amended by the exclusion of that part of the invention.

(2) Where an opponent has, before the date of the order of the Controller requiring the amendment of a complete specification referred to in clause (b) of sub-section (1), filed an application for a patent for an invention which included the whole or a part of the invention held to have been obtained from him and such application is pending, the Controller may treat such application and specification in so far as they relate to the invention held to have been obtained from him, as having been filed, for the purposes of this Act relating to the priority dates of claims of the complete specification, on the date on which the corresponding document was or was deemed to have been filed by the patentee in the earlier application but for all other purposes the application of the opponent shall be proceeded with as an application for a patent under this Act."

24. Omission of section 27.-Section 27 of the principal Act shall be omitted.

25. Amendment of section 28.-In section 28 of the principal Act,-

(a) for sub-section (4), the following sub-section shall be substituted, namely:-

"(4) A request or claim under the foregoing provisions of this section shall be made before the grant of patent."

(b) sub-section (5) shall be omitted;

(c) in sub-section (6), for the words, brackets and figure "Subject to the provisions of sub-section (5), where", the word "Where" shall be substituted.

26. Amendment of section 31.-In section 31 of the principal Act, for the words "not later than six months", the words "not later than twelve months" shall be substituted.

27. Amendment of section 34.-In section 34 of the principal Act, the words "to accept complete specification for a patent or" shall be omitted.
28. Amendment of section 35.-In section 35 of the principal Act, in sub-section (3), for the words "acceptance of complete specification", the words "grant of patent" shall be substituted.

29. Amendment of section 36.-In section 36 of the principal Act, in sub-section (1), for the words "twelve months", the words "six months" shall be substituted.

30. Amendment of section 37.-In section 37 of the principal Act,-

(a) in sub-section (1),-

(i) in clause (a), for the words "to accept", the words "to grant" shall be substituted;

(ii) for the provison, the following proviso shall be substituted, namely:-

"Provided that the application may, subject to the directions, proceed up to the stage of grant of the patent, but the application and the specification found to be in order for grant of the patent shall not be published, and no patent shall be granted in pursuance of that application."

(b) in sub-section (2), for the words "is accepted", the words "is found to be in order for grant of the patent" shall be substituted.

31. Substitution of new section for section 39.-For section 39 of the principal Act, the following section shall be substituted, namely:-

"39. Residents not to apply for patents outside India without prior permission.—(1) No person resident in India shall, except under the authority of a written permit sought in the manner prescribed and granted by or on behalf of the Controller, make or cause to be made any application outside India for the grant of a patent for an invention unless-

(a) an application for a patent for the same invention has been made in India, not less than six weeks before the application outside India; and

(b) either no direction has been given under sub-section (1) of section 35 in relation to the application in India, or all such directions have been revoked.

(2) The Controller shall dispose of every such application within such period as may be prescribed:

Provided that if the invention is relevant for defence purpose or atomic energy, the Controller shall not grant permit without the prior consent of the Central Government.

(3) This section shall not apply in relation to an invention for which an application for protection has first been filed in a country outside India by a person resident outside India."

32. Substitution of heading of Chapter VIII.-In Chapter VIII of the principal Act, for the Chapter heading "GRANT AND SEALING OF PATENTS AND RIGHTS CONFERRED THEREBY", the Chapter heading "GRANT OF PATENTS AND RIGHTS CONFERRED THEREBY" shall be substituted.

33. Substitution of new section for section 43.-For section 43 of the principal Act, the following section shall be substituted, namely:-

"43. Grant of patents.—(1) Where an application for a patent has been found to be in order for grant of the patent and either-
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(a) the application has not been refused by the Controller by virtue of any power vested in him by this Act; or

(b) the application has not been found to be in contravention of any of the provisions of this Act,

the patent shall be granted as expeditiously as possible to the applicant or, in the case of a joint application, to the applicants jointly, with the seal of the patent office and the date on which the patent is granted shall be entered in the register.

(2) On the grant of patent, the Controller shall publish the fact that the patent has been granted and thereupon the application, specification and other documents related thereto shall be open for public inspection.

34. Amendment of section 44.-In section 44 of the principal Act, for the word "sealed", at both the places where it occurs, the word "granted" shall be substituted.

35. Amendment of section 45.-In section 45 of the principal Act, in sub-section (3), for the words "the date of advertisement of the acceptance of the complete specification", the words "the date of publication of the application" shall be substituted.

36. Amendment of section 48.-In section 48 of the principal Act, the proviso shall be omitted.

37. Amendment of section 52.-In section 52 of the principal Act,-

(a) in sub-section (1),-

(i) for the opening words "Where a patent has been revoked", the words and figures "Where the patent has been revoked under section 64" shall be substituted;

(ii) for the word "court", wherever it occurs, the words "Appellate Board or court" shall be substituted;

(b) in sub-section (2), for the word "court", occurring at both the places, the words "Appellate Board or court" shall be substituted.

38. Amendment of section 53.-In section 53 of the principal Act,-

(a) after sub-section (1), the following Explanation shall be inserted, namely:-

"Explanation.-For the purposes of this sub-section, the term of patent in case of International applications filed under the Patent Cooperation Treaty designating India, shall be twenty years from the international filing date accorded under the Patent Cooperation Treaty.";

(b) in sub-section (2), for the words "or within that period as extended under this section", the words "or within such extended period as may be prescribed" shall be substituted;

(c) sub-section (3) shall be omitted.

39. Amendment of section 54.-In section 54 of the principal Act,-

(a) in sub-section (3), for the words "complete specification", occurring at both the places, the word "application" shall be substituted;
(b) for sub-section (4), the following sub-section shall be substituted, namely:-

"(4) A patent of addition shall not be granted before grant of the patent for the main invention.".

40. Amendment of section 57.-In section 57 of the principal Act,-

(a) for sub-section (3), the following sub-section shall be substituted, namely:-

"(3) Any application for leave to amend an application for a patent or a complete specification or a document related thereto under this section made after the grant of patent and the nature of the proposed amendment may be published.";

(b) in sub-section (4),-

(i) for the word "advertised", the word "published" shall be substituted;

(ii) for the word "advertisement", the word "publication" shall be substituted;

(c) for sub-section (6), the following sub-section shall be substituted, namely:-

"(6) The provisions of this section shall be without prejudice to the right of an applicant for a patent to amend his specification or any other document related thereto to comply with the directions of the Controller issued before the grant of a patent.".

41. Substitution of new section for section 58.-For section 58 of the principal Act, the following section shall be substituted, namely:-

"58. Amendment of specification before Appellate Board or High Court.—(1) In any proceeding before the Appellate Board or the High Court for the revocation of a patent, the Appellate Board or the High Court, as the case may be, may, subject to the provisions contained in section 59, allow the patentee to amend his complete specification in such manner and subject to such terms as to costs, advertisement or otherwise, as the Appellate Board or the High Court may think fit, and if in any proceedings for revocation the Appellate Board or the High Court decides that the patent is invalid, it may allow the specification to be amended under this section instead of revoking the patent.

(2) Where an application for an order under this section is made to the Appellate Board or the High Court, the applicant shall give notice of the application to the Controller, and the Controller shall be entitled to appear and be heard, and shall appear if so directed by the Appellate Board or the High Court.

(3) Copies of all orders of the Appellate Board or the High Court allowing the patentee to amend the specification shall be transmitted by the Appellate Board or the High Court to the Controller who shall, on receipt thereof, cause an entry thereof and reference thereto to be made in the register.".

42. Amendment of section 59.-In section 59 of the principal Act, for sub-section (2), the following sub-section shall be substituted, namely:-

"(2) Where after the date of grant of patent any amendment of the specification or any other documents related thereto is allowed by the Controller or by the Appellate Board or the High Court, as the case may be,—

(a) the amendment shall for all purposes be deemed to form part of the specification along with other documents related thereto;
(b) the fact that the specification or any other documents related thereto has been amended shall be published as expeditiously as possible; and

(c) the right of the applicant or patentee to make amendment shall not be called in question except on the ground of fraud."

43. Amendment of section 60.-In section 60 of the principal Act, in sub-section (1), for the words, brackets and figures "prescribed period or within that period as extended under sub-section (3) of section 53", the words, figures and brackets "period prescribed under section 53 or within such period as may be allowed under sub-section (4) of section 142" shall be substituted.

44. Amendment of section 61.-In section 61 of the principal Act, in sub-section (1), for the words "advertise the application", the words "publish the application" shall be substituted.

45. Amendment of section 62.-In section 62 of the principal Act,-

(a) in sub-section (1), for the word "advertisement", the word "publication" shall be substituted;

(b) in sub-section (2), for the words "date of the advertisement", the words "date of publication" shall be substituted.

46. Amendment of section 63.-In section 63 of the principal Act,-

(a) in sub-section (2), for the word "advertise", the word "publish" shall be substituted;

(b) in sub-section (3), for the words "such advertisement", the words "such publication" shall be substituted.

47. Amendment of section 64.-In section 64 of the principal Act, in sub-section (1), for the words "on the petition of any person interested or of the Central Government or on a counter-claim in a suit for infringement of the patent, be revoked by the High Court", the words "be revoked on a petition of any person interested or of the Central Government by the Appellate Board or on a counter-claim in a suit for infringement of the patent by the High Court" shall be substituted.

48. Substitution of new section for section 65.-For section 65 of the principal Act, the following section shall be substituted, namely:-

"65. Revocation of patent or amendment of complete specification on directions from Government in cases relating to atomic energy.- (1) Where at any time after grant of a patent, the Central Government is satisfied that a patent is for an invention relating to atomic energy for which no patent can be granted under sub-section (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962), it may direct the Controller to revoke the patent, and thereupon the Controller, after giving notice, to the patentee and every other person whose name has been entered in the register as having an interest in the patent, and after giving them an opportunity of being heard, may revoke the patent.

(2) In any proceedings under sub-section (1), the Controller may allow the patentee to amend the complete specification in such manner as he considers necessary instead of revoking the patent."

49. Substitution of new section for section 68.-For section 68 of the principal Act, the following section shall be substituted, namely:-

"68. Assignments, etc., not to be valid unless in writing and duly executed.-An assignment of a patent or of a share in a patent, a mortgage, licence or the creation of any other interest in a patent shall not be valid
unless the same were in writing and the agreement between the parties concerned is reduced to the form of
a document embodying all the terms and conditions governing their rights and obligations and duly
executed.

50. Amendment of section 74.-In section 74 of the principal Act, for sub-section (2), the following sub­
section shall be substituted, namely:-

"(2) The Central Government may, by notification in the Official Gazette, specify the name of the Patent
Office."

51. Amendment of section 78.-In section 78 of the principal Act,-

(a) in sub-section (4), for the word "advertised", the word "published" shall be substituted;

(b) in sub-section (5), for the words "such advertisement", the words "such publication" shall be
substituted.

52. Amendment of section 84.-In section 84 of the principal Act,-

(a) in sub-section (1), for the word "sealing", the word "grant" shall be substituted;

(b) in sub-section (6), the following Explanation shall be inserted at the end, namely,-

'Explanation.-For the purposes of clause (iv), "reasonable period" shall be construed as a period not
ordinarily exceeding a period of six months.'

53. Amendment of section 87.-In section 87 of the principal Act, in sub-section (1), for the words "shall
advertise the application in the Official Gazette", the words "shall publish the application in the official
journal" shall be substituted.

54. Amendment of section 90.-In section 90 of the principal Act, in sub-section (1), for clause (vii), the
following clauses shall be substituted, namely:-

"(vii) that the licence is granted with a predominant purpose of supply in the Indian market and that the
licensee may also export the patented product, if need be in accordance with the provisions of sub-clause
(iii) of clause (a) of sub-section (7) of section 84;

(viii) that in the case of semi-conductor technology, the licence granted is to work the invention for public
non-commercial use;

(ix) that in case the licence is granted to remedy a practice determined after judicial or administrative
process to be anti-competitive, the licensee shall be permitted to export the patented product, if need be."

55. Insertion of new section 92A.-After section 92 of the principal Act, the following section shall be
inserted, namely:-

'92A. Compulsory licence for export of patented pharmaceutical products in certain exceptional
circumstances.-(1) Compulsory licence shall be available for manufacture and export of patented
pharmaceutical products to any country having insufficient or no manufacturing capacity in the
pharmaceutical sector for the concerned product to address public health problems, provided compulsory
licence has been granted by such country or such country has, by notification or otherwise, allowed
importation of the patented pharmaceutical products from India.
(2) The Controller shall, on receipt of an application in the prescribed manner, grant a compulsory licence solely for manufacture and export of the concerned pharmaceutical product to such country under such terms and conditions as may be specified and published by him.

(3) The provisions of sub-sections (1) and (2) shall be without prejudice to the extent to which pharmaceutical products produced under a compulsory licence can be exported under any other provision of this Act.

Explanation.-For the purposes of this section, "pharmaceutical products" means any patented product, or product manufactured through a patented process, of the pharmaceutical sector needed to address public health problems and shall be inclusive of ingredients necessary for their manufacture and diagnostic kits required for their use.'.

56. Amendment of section 100.-In section 100 of the principal Act, in sub-section (3), for the words "the acceptance of the complete specification in respect of the patent", the words "grant of the patent" shall be substituted.

57. Amendment of section 105.-In section 105 of the principal Act, in sub-section (4), for the words "after the date of advertisement of acceptance of the complete specification of a patent", the words "after the publication of grant of a patent" shall be substituted.

58. Amendment of section 107A.-In section 107A of the principal Act,-

(a) in clause (a),-

(i) for the words "using or selling", the words "using, selling or importing" shall be substituted;

(ii) for the words "use or sale,", the words "use, sale or import" shall be substituted;

(b) in clause (b), for the words "who is duly authorised by the patentee to sell or distribute the product", the words "who is duly authorised under the law to produce and sell or distribute the product" shall be substituted.

59. Amendment of section 113.-In section 113 of the principal Act,-

(a) for sub-section (1), the following sub-section shall be substituted, namely:-

"(1) If in any proceedings before the Appellate Board or a High Court for the revocation of a patent under section 64 and section 104, as the case may be, the validity of any claim of a specification is contested and that claim is found by the Appellate Board or the High Court to be valid, the Appellate Board or the High Court may certify that the validity of that claim was contested in those proceedings and was upheld.";

(b) for sub-section (3), the following sub-section shall be substituted, namely:-

"(3) Nothing contained in this section shall be construed as authorising the courts or the Appellate Board hearing appeals from decrees or orders in suits for infringement or petitions for revocation, as the case may be, to pass orders for costs on the scale referred to therein.".

60. Amendment of section 116.-In section 116 of the principal Act [as substituted by section 47 of the Patents (Amendment) Act, 2002 (38 of 2002)], in sub-section (2), clause (c) shall be omitted.
61. Amendment of section 117A.-In section 117A of the principal Act [as inserted by section 47 of the Patents (Amendment) Act, 2002 (38 of 2002)], in sub-section (2), for the words and figures "section 20, section 25, section 27, section 28", the words, figures and brackets "section 20, sub-section (4) of section 25, section 28" shall be substituted.

62. Amendment of section 117D.-In section 117D of the principal Act [as inserted by section 47 of the Patents (Amendment) Act, 2002 (38 of 2002)], in sub-section (1), for the words, "for rectification of the register", the words and figures "for revocation of a patent before the Appellate Board under section 64 and an application for rectification of the register" shall be substituted.

63. Substitution of new section for section 117G.-For section 117G of the principal Act [as inserted by the Patents (Amendment) Act, 2002 (38 of 2002)], the following section shall be substituted, namely:-

"117G. Transfer of pending proceedings to Appellate Board.-All cases of appeals against any order or decision of the Controller and all cases pertaining to revocation of patent other than on a counter-claim 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 in the Official Gazette and the Appellate Board may proceed with the matter either de novo or from the stage it was so transferred."

64. Amendment of section 120.-In section 120 of the principal Act, for the words, "ten thousand rupees", the words "one lakh rupees" shall be substituted.

65. Amendment of section 122.-In section 122 of the principal Act, in sub-section (1), for the words "twenty thousand rupees", the words "ten lakh rupees" shall be substituted.

66. Amendment of section 123.-In section 123 of the principal Act, for the words "ten thousand rupees in the case of a first offence and forty thousand rupees", the words "one lakh rupees in the case of a first offence and five lakh rupees" shall be substituted.

67. Amendment of section 126.-In section 126 of the principal Act,-

(a) in sub-section (1), in clause (c), sub-clause (i) shall be omitted;

(b) in sub-section (2), for the words, brackets and figures "the Patents (Amendment) Act, 2002 (38 of 2002)", the words, brackets and figures "the Patents (Amendment) Act, 2005" shall be substituted.

68. Substitution of new section for section 133.-For section 133 of the principal Act, the following section shall be substituted, namely:-

"133. Convention countries.-Any country, which is a signatory or party or a group of countries, union of countries or inter-governmental organisations which are signatories or parties to an international, regional or bi-lateral treaty, convention or arrangement to which India is also a signatory or party and which affords to the applicants for patents in India or to citizens of India similar privileges as are granted to their own citizens or citizens to their member countries in respect of the grant of patents and protection of patent rights shall be a convention country or convention countries for the purposes of this Act.".

69. Amendment of section 135.-In section 135 of the principal Act, after sub-section (2), the following sub-section shall be inserted, namely:-

"(3) In case of an application filed under the Patent Cooperation Treaty designating India and claiming priority from a previously filed application in India, the provisions of sub-sections (1) and (2) shall apply as if the previously filed application were the basic application:
Provided that a request for examination under section 11B shall be made only for one of the applications filed in India.

70. Amendment of section 138.-In section 138 of the principal Act, for sub-section (1), the following sub-section shall be substituted, namely:-

"(1) Where a convention application is made in accordance with the provisions of this Chapter, the applicant shall furnish, when required by the Controller, in addition to the complete specification, copies of the specifications or corresponding documents filed or deposited by the applicant in the patent office of the convention country as referred to in section 133 verified to the satisfaction of the Controller, within the prescribed period from the date of communication by the Controller."

71. Amendment of section 142.-In section 142 of the principal Act, in sub-section (4), for the words "the complete specification", the words "the application" shall be substituted.

72. Substitution of new section for section 143.-For section 143 of the principal Act, the following section shall substituted, namely:- "143. Restrictions upon publication of specification.-Subject to the provisions of Chapter VII, an application for a patent, and any specification filed in pursuance thereof, shall not, except with the consent of the applicant, be published by the Controller before the expiration of the period prescribed under sub-section (1) of section 11A or before the same is open to public inspection in pursuance of sub-section (3) of section 11A or section 43.".

73. Substitution of new section for section 145.-For section 145 of the principal Act, the following section shall substituted, namely:- "145. Publication of official journal.-The Controller shall publish periodically an official journal which shall contain such information as may be required to be published by or under the provisions of this Act or any rule made thereunder.".

74. Amendment of section 151.-In section 151 of the principal Act,-

(a) in sub-section (1), for the words "the High Court", occurring at both the places, the words "the High Court or the Appellate Board" shall be substituted;

(b) in sub-section (3), for the word "courts", the words "Appellate Board or the courts, as the case may be," shall be substituted.

75. Omission of section 152.-Section 152 of the principal Act shall be omitted.

76. Amendment of section 159.-In section 159 of the principal Act,-

(i) in sub-section (2),

(a) for clauses (ia) and (ib), the following clauses shall be substituted, namely:-

"(ia) the period which the Controller may allow for filing of statement and undertaking for in respect of applications under sub-section (1), the period within which the details relating to processing of applications may be filed before the Controller and the details to be furnished by the applicant to the Controller under sub-section (2) of section 8;

(ib) the period within which a reference to the deposit of materials shall be made in the specification under sub-clause (A) of clause (ii) of the proviso to sub-section (4) of section 10;"
(ic) the period for which application for patent shall not be open to the public under sub-section (1) and the manner in which the applicant may make a request to the Controller to publish his application under sub-section (2) of section 11A;

(id) the manner of making the request for examination for an application for patent and the period within which such examination shall be made under sub-sections (1) and (3) of section 11B;

(ie) the manner in which an application for withdrawal of an application for grant of a patent shall be made and the period within which a request for examination from the date of revocation of secrecy directions shall be made under the proviso to sub-section (4) of section 11B.

(b) in clause (ii), for the word "advertised", the word "published" shall be substituted;

(c) for clause (v), the following clauses shall be substituted, namely:-

"(v) the manner in which and the period within which the Controller shall consider and dispose off a representation under sub-section (1) of section 25;

(va) the period within which the Controller is required to dispose off an application under section 39;"

(ii) in sub-section (3), the following proviso shall be added at the end, namely:- "Provided that the Central Government may, if it is satisfied that the circumstances exist which render it practically not possible to comply with such condition of previous publication, dispense with such compliance.

Omission of section 163.

77. Omission of section 163.-Section 163 of the principal Act shall be omitted.

Transitional provision.

78. Transitional provision.- (1) Notwithstanding the omission of Chapter IVA of the principal Act by section 21 of this Act, every application for the grant of exclusive marketing rights filed under that Chapter before the 1st day of January, 2005, in respect of a claim for a patent covered under sub-section (2) of section 5 of the principal Act, such application shall be deemed to be treated as a request for examination for grant of patent under sub-section (3) of section 11B of the principal Act, as amended by this Act.

(2) Every exclusive right to sell or distribute any article or substance in India granted before the 1st day of January, 2005 shall continue to be effective with the same terms and conditions on which it was granted.

(3) Without prejudice to any of the provisions of the principal Act, the applications in respect of which exclusive rights have been granted before the 1st day of January, 2005 shall be examined for the grant of patent immediately on the commencement of this Act.

(4) All suits relating to infringement of the exclusive right granted before 1st day of January, 2005 shall be dealt with in the same manner as if they were suits concerning infringement of patents under Chapter XVIII of the principal Act.

(5) The examination and investigation required as carried out for the grant of exclusive right shall not be deemed in any way to warrant the validity of any grant of exclusive right to sell or distribute, and no liability shall be incurred by the Central Government or any officer thereof by reason of, or in connection with, any such examination or investigation or any report or other proceedings consequent thereon.
79. % Repeal and saving.

79. Repeal and saving.—(1) The Patents (Amendment) Ordinance, 2004 (Ord. 7 of 2004) is hereby repealed.

(2) Notwithstanding such repeal, anything done or any action taken under the principal Act, as amended by the said Ordinance shall be deemed to have been done or taken under the corresponding provisions of the principal Act, as amended by this Act.

T.K. VISWANANATHAN
Secy, to the Govt. of India.