APPENDICES
THE PATENTS ACT, 1970
(Act No. 39 of 1970)
[19th September, 1970]

CHAPTER I: PRELIMINARY

1. Short title, extent and commencement.—
(1) This Act may be called The Patents Act, 1970.
(2) It extends to the whole of India.
(3) It shall come into force on such date[1] as the Central Government may, by notification in the Official Gazette, appoint:
Provided that 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. Definitions and interpretation.—
(1) In this Act, unless the context otherwise requires,—
(a) “Appellate Board” means the Appellate Board referred to in section 116;
(b) “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;
(c) “Controller” means the Controller General of Patents, Designs and Trade Marks referred to in section 73;
(d) “convention application” means an application for a patent made by virtue of section 135;
(e) “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 organization referred to as a convention country in section 133;]
(f) “district court” has the meaning assigned to that expression by the Code of Civil Procedure, (5 of 1908).
(g) “exclusive licence” means a licence from a patentee which confers on the licensee, or on the licensee and persons authorised by him, to the exclusion of all other persons (including the patentee), any right in respect of the patented invention, and exclusive licensee shall be construed accordingly:
(h) “Government undertaking” means any industrial undertaking carried on—
(i) by a department of the Government, or
(ii) by a corporation established by a Central, Provincial or State Act, which is owned or controlled by the Government, or
(iii) by a Government company as defined in section 617 of the Companies Act, 1956 (1 of 1956); or, 15[omitted];
(iv) by an institution wholly or substantially financed by the Government;]
(i) "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;

8[(ia) "international application" means an application for patent made in accordance with the Patent Co-operation Treaty;]

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

(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;

(k) "legal representative" means a person who in law represents the estate of a deceased person;

18][(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, that is, the subject matter has not fallen in public domain or that it does not form part of the state of the art;

(ia) "Opposition Board" means an Opposition Board constituted under sub-section (4) of section 25;

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

(n) "patent agent" means a person for the time being registered under this Act as a patent agent;

(o) "patented article" and "patented process" means respectively an article or process in respect of which a patent is in force;

8[(oa) "Patent Co-operation Treaty" means the Patent Co-operation Treaty done at Washington on the 19th day of June, 1970 as amended and modified from time to time;]

(p) "patentee" means the person for the time being entered on the register as the grantee or proprietor of the patent;

(q) "patent of addition" means a patent granted in accordance with section 54;

(r) "patent office" means the patent office referred to in section 74;

(s) "person" includes the Government;

(t) "person interested" includes a person engaged in, or in promoting, research in the same field as that to which the invention relates;

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

(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.

(v) "prescribed manner" includes the payment of the prescribed fee;

(w) "priority date" has the meaning assigned to it by section 11;

(x) "register" means the register of patents referred to in section 67;

(y) "true and first inventor" does not include either the first importer of an invention into India, or a person to whom an invention is first communicated from outside India.

(2) In this Act, unless the context otherwise requires, any reference—
(a) to the Controller shall be construed as including a reference to any officer discharging the functions of the Controller in pursuance of section 73;
(b) to the patent office shall be construed as including a reference to any branch office of the patent office.

CHAPTER II: INVENTIONS NOT PATENTABLE

3. What are not inventions.—
The following are not inventions within the meaning of this Act.—
(a) an invention which is frivolous or which claims anything obviously contrary to well established natural laws;
(b) an invention the primary or intended use or commercial exploitation of which could be contrary public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment;
(c) the mere discovery of a scientific principle or the formulation of an abstract theory;
(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, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy;

(e) a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;
(f) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;
(g) a method of agriculture or horticulture;
(h) any process for the medicinal, surgical, curative, prophylactic diagnostic, the therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products;
(i) 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 program 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.
4. Inventions relating to atomic energy not patentable.—
No patent shall be granted in respect of an invention relating to atomic energy falling within sub-section (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962).

5. §[ Omitted]

CHAPTER III: APPLICATIONS FOR PATENTS

6. Persons entitled to apply for patents.—
(1) Subject to the provisions contained in section 134, an application for a patent for an invention may be made by any of the following persons, that is to say,—
(a) by any person claiming to be the true and first inventor of the invention;
(b) by any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application;
(c) by the legal representative of any deceased person who immediately before his death was entitled to make such an application.
(2) An application under sub-section (1) may be made by any of the persons referred to therein either alone or jointly with any other person.

7. Form of application.—
(1) Every application for a patent shall be for one invention only and shall be made in the prescribed form and filed in the patent office.

8. Information and undertaking regarding foreign applications.—
(1) Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file along with his application 1[or subsequently 2[within the prescribed period as the Controller may allow]]

2[(a) a statement setting out detailed particulars of such application; and;]
(b) an undertaking that, 10[up to the date of grant of patent in India], he would keep the
Controller informed in writing, from time to time, of 2[detailed particulars as required
under] clause (a) in respect of every other application relating to the same or substantially
the same invention, if any, filed in any country outside India subsequently to the filing of
the statement referred to in the aforesaid clause, within the prescribed time.
11[(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 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.]

9. Provisional and complete specifications.—
(1) 12[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];
Provided that the complete specification may be filed at any time after twelve months but
within fifteen months from the date aforesaid, if a request to that effect is made to the
Controller and the prescribed fee is paid on or before the date on which the complete
specification is filed.
(2) Where two or more applications in the name of the same applicant are accompanied
by provisional specifications in respect of inventions which are cognate or of which one
is a modification of another and the Controller is of opinion that the whole of such
inventions are such as to constitute a single invention and may properly be included in
one patent, he may allow one complete specification to be filed in respect of all such
provisional specifications.
13[Provided that the period of time specified under sub-section (1) shall be reckoned
from the date of filing of the earliest provisional specification]
(3) 14[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]
(4) Where a complete specification has been filed in pursuance of an application for a
patent accompanied by a provisional specification or by a specification treated by virtue
of a direction under sub-section (3) as a provisional specification, the Controller may, if
the applicant so requests at any time before 15[grant of patent], cancel the provisional
specification and post-date the application to the date of filing of the complete
specification.

10. Contents of specifications.—
(1) Every specification, whether provisional of complete, shall describe the invention and
shall begin with a title sufficiently indicating the subject-matter to which the invention
relates.
(2) Subject to any rules that may be made in this behalf under this Act, drawings may,
and shall, if the Controller so requires, be supplied for the purposes of any specification,
whether complete or provisional; and any drawings so supplied shall; unless the Controller otherwise directs, be deemed to form part of the specification, and references in this Act to a specification shall be construed accordingly.

(3) If, in any particular case, the Controller considers that an application should be further supplemented by a model or sample of anything illustrating the invention or alleged to constitute an invention, such model or sample as he may require shall be furnished before the application is found in order for grant of a patent, but such model or sample shall not be deemed to form part of the specification.

(4) Every complete specification shall—

(a) fully and particularly describe the invention and its operation or use and the method by which it is to be performed;

(b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and

(c) end with a claim or claims defining the scope of the invention for which protection is claimed.

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 international depository authority under the Budapest Treaty and by fulfilling the following conditions, 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;

(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.

(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.

(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.

(6) A declaration as to the inventorship of the invention shall, in such cases as may be prescribed, be furnished in the prescribed form with the complete specification or within such period as may be prescribed after the filing of that specification.

(7) Subject to the foregoing provisions of this section, a complete specification filed after a provisional specification may include claims in respect of developments of, or additions
to, the invention which was described in the provisional specification, being
developments or additions in respect of which the applicant would be entitled under the
provisions of section 6 to make a separate application for a patent.
11. Priority dates of claims of a complete specification.—
(1) There shall be a priority date for each claim of a complete specification.
(2) Where a complete specification is filed in pursuance of a single application
accompanied by—
(a) a provisional specification; or
(b) a specification which is treated by virtue of a direction under sub-section (3) of
section 9 as a provisional specification,
and the claim is fairly based on the matter disclosed in the specification referred to in
clause (a) or clause (b), the priority date of that claim shall be the date of filing of the
relevant specification.
(3) Where the complete specification is filed or proceeded with in pursuance of two or
more applications accompanied by such specifications as are mentioned in sub-section
(2) and the claim is fairly based on the matter disclosed—
(a) in one of those specifications, the priority date of that claim shall be the date of the
filing of the application accompanied by that specification;
(b) partly in one and partly in another, the priority date of that claim shall be the date of
the filing of the application accompanied by the specification of the later date,
20[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.
(4) Where the complete specification has been filed in pursuance of a further application
made by virtue of sub-section (1) of section 16 and the claim is fairly based on the matter
disclosed in any of the earlier specifications, provisional or complete, as the case may be,
the priority date of that claim shall be the date of the filing of that specification in which
the matter was first disclosed.
(5) Where, under the foregoing provisions of this section, any claim of a complete
specification would, but for the provisions of this sub-section, have two or more priority
dates, the priority date of that claim shall be the earliest of those dates.
(6) In any case to which sub-sections (2), (3), 20[3A], (4) and (5) do not apply, the
priority date of a claim shall, subject to the provisions of section 137, be the date of filing
of the complete specification.
(7) The reference to the date of the filing of the application or of the complete
specification in this section shall, in cases where there has been a post-dating under
section 9 or section 17 or, as the case may be, an ante-dating under section 16, be a
reference to the date as so post-dated or ante-dated.
(8) A claim in a complete specification of a patent shall not be invalid by reason only of—
(a) the publication or use of the invention so far as claimed in that claim on or after the
priority date of such claim; or
(b) the grant of another patent which claims the invention, so far as claimed in the first
mentioned claim, in a claim of the same or a later priority date.
CHAPTER IV: EXAMINATION AND PUBLICATION OF APPLICATIONS

16[11A. Publication of applications.—

(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).

(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 prescribed under sub-section (1) 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.

(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 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.]

11B. Request for examination.—

(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.

(2) [Omitted]
22[(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.]

(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) 23[Omitted] or sub-section (3), the application shall be treated as withdrawn by the applicant:

24[Provided that—
	(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. Examination of application.—

1) When a request for examination has been made in respect of an application for a patent in the prescribed manner 25[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 1) to an examiner for making a report to him in respect of the following matters, namely:
	(a) whether the application and the 3[specification and other documents relating thereto] are in accordance with the requirements of this Act and of any rules made there under;
	(b) whether there is any lawful ground of objection to the grant of the patent under this Act in pursuance of the application;
	(c) the result of investigations made under section 13, and
	(d) any other matter which may be prescribed.

2) The examiner to whom the application and the 3[specification and other documents relating thereto] are referred under sub-section (1) shall ordinarily make the report to the Controller 26[within such period as may be prescribed].

13. Search for anticipation by previous publication and by prior claim.—

1) The examiner to whom an application for a patent is referred under section 12 shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification—
	(a) has been anticipated by publication before the date of filing of the applicant's complete specification in any specification filed in pursuance of an application for a patent made in India and dated on or after the 1st day of January, 1912;
	(b) is claimed in any claim of any other complete specification published on or after the date of filing of the applicant's complete specification being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.

2) The examiner shall, in addition, make such investigation 4[***] for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been anticipated by publication in India or elsewhere in any document other than those mentioned in sub-section (1) before the date of filing of the applicant's complete specification.

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(3) Where a complete specification is amended under the provisions of this Act before the grant of a patent, the amended specification shall be examined and investigated in like manner as the original specification.

(4) The examination and investigations required under section 12 and this section shall not be deemed in any way to warrant the validity of any patent, 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.

28(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.

29(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.”).

16. Power of Controller to make orders respecting division of application.—
(1) A person who has made an application for a patent under this Act may, at any time before the grant of the patent, if he so desires, or with a view to remedy the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first mentioned application.

(2) The further application under sub-section (1) shall be accompanied by a complete specification, but such complete specification shall not include any matter not in substance disclosed in the complete specification filed in pursuance of the first mentioned application.

(3) The Controller may require such amendment of the complete specification filed in pursuance of either the original or the further application as may be necessary to ensure that neither of the said complete specifications includes a claim for any matter claimed in the other.

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].
17. Power of Controller to make orders respecting dating of application.—
(1) Subject to the provisions of section 9, at any time after the filing of an application and 32[before the grant of the patent] under this Act, the Controller may, at the request of the applicant made in the prescribed manner, direct that the application shall be post-dated to such date as may be specified in the request, and proceed with the application accordingly: Provided that no application shall be post-dated under this sub-section to a date later than six months from the date on which it was actually made or would, but for the provisions of this sub-section, be deemed to have been made.

62[(2) Where an application or specification (including drawings) or any other document is required to be amended under section 13, 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 refiled after complying with the requirement.]

18. Powers of Controller in cases of anticipation.—
(1) Where it appears to the Controller that the invention so far as claimed in any claim of the complete specification has been anticipated in the manner referred to in clause (a) of sub-section (1) or sub-section (2) of section 13, he may refuse 33[the application] unless the applicant—
(a) shows to the satisfaction of the Controller that the priority date of the claim of his complete specification is not later than the date on which the relevant document was published; or
(b) amends his complete specification to the satisfaction of the Controller.

(2) If it appears to the Controller that the invention is claimed in a claim of any other complete specification referred to in clause (b) of sub-section (1) of section 13, he may, subject to the provisions hereinafter contained, direct that a reference to that other specification shall be inserted by way of notice to the public in the applicant's complete specification unless within such time as may be prescribed,—
(a) the applicant shows to the satisfaction of the Controller that the priority date of claim is not later than the priority date of the claim of the said other specification; or
(b) the complete specification is amended to the satisfaction of the Controller.

(3) If it appears to the Controller, as a result of an investigation under section 13 or otherwise,—
(a) that the invention so far as claimed in any claim of the applicant's complete specification has been claimed in any other complete specification referred to in clause (a) of sub-section (1) of section 13; and
(b) that such other complete specification was published on or after the priority date of the applicant's claim,
then, unless it is shown to the satisfaction of the Controller that the priority date of the applicant's claim is not later than the priority date of the claim of that specification, the provisions of sub-section (2) shall apply thereto in the same manner as they apply to a specification published on or after the date of filing of the applicant's complete specification.

(4) 34[Omitted]

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19. Powers of Controller in case of potential infringement.—
(1) If, in consequence of the investigations required under this Act, it appears to the Controller that an invention in respect of which an application for a patent has been made cannot be performed without substantial risk of infringement of a claim of any other patent, he may direct that a reference to that other patent shall be inserted in the applicant's complete specification by way of notice to the public, unless within such time as may be prescribed—
(a) the applicant shows to the satisfaction of the Controller that there are reasonable grounds for contesting the validity of the said claim of the other patent; or
(b) the complete specification is amended to the satisfaction of the Controller.
(2) Where, after a reference to another patent has been inserted in a complete specification in pursuance of a direction under sub-section (1)—
(a) that other patent is revoked or otherwise ceases to be in force; or
(b) the specification of that other patent is amended by the deletion of the relevant claim; or
(c) it is found, in proceedings before the court or the Controller, that the relevant claim of that other patent is invalid or is not infringed by any working of the applicant's invention, the Controller may, on the application of the applicant, delete the reference to that other patent.

20. Powers of Controller to make orders regarding substitution of applicants, etc.—
(1) If the Controller is satisfied, on a claim made in the prescribed manner at any time before a patent has been granted, that by virtue of any assignment or agreement in writing made by the applicant or one of the applicants for the patent or by operation of law, the claimant would, if the patent were then granted, be entitled thereto or to the interest of the applicant therein, or to an undivided share of the patent or of that interest, the Controller may, subject to the provisions of this section, direct that the application shall proceed in the name of the claimant or in the names of the claimants and the applicant or the other joint applicant or applicants, accordingly as the case may require.
(2) No such direction as aforesaid shall be given by virtue of any assignment or agreement made by one of two or more joint applicants for a patent except with the consent of the other joint applicant or applicants.
(3) No such direction as aforesaid shall be given by virtue of any assignment or agreement for the assignment of the benefit of an invention unless—
(a) the invention is identified therein by reference to the number of the application for the patent; or
(b) there is produced to the Controller an acknowledgement by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made; or
(c) the rights of the claimant in respect of the invention have been finally established by the decision of a court; or
(d) the Controller gives directions for enabling the application to proceed or for regulating the manner in which it should be proceeded with under subsection (5).
(4) Where one of two or more joint applicants for a patent dies at any time before the patent has been granted, the Controller may, upon a request in that behalf made by the survivor or survivors, and with the consent of the legal representative of the deceased, direct that the application shall proceed in the name of the survivor or survivors alone.
(5) If any dispute arises between joint applicant for a patent whether or in what manner the application should be proceeded with, the Controller may, upon application made to him in the prescribed manner by any of the parties, and after giving to all parties concerned an opportunity to be heard, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be proceeded with, or for both those purposes, as the case may require.

21. Time for putting application in order for acceptance.—

36[(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.]

37[Omitted]
When used in this title unless the context otherwise indicates—

(a) The term “invention” means invention or discovery.
(b) The term “process” means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.
(c) The terms “United States” and “this country” mean the United States of America, its territories and possessions.
(d) The word “patentee” includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.
(e) The term “third-party requester” means a person requesting ex parte reexamination under section 302 or inter partes reexamination under section 311 who is not the patent owner.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
(c) he has abandoned the invention, or
(d) the invention was first patented or caused to be patented, or was the subject of an inventor’s certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor’s certificate filed more than twelve months before the filing of the application in the United States, or
(e) the invention was described in
   (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
   (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or
   (f) he did not himself invent the subject matter sought to be patented, or
   (g) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that

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before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or
(2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U.S.C. 103:
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
(b) (1) Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is novel under section 102 and nonobvious under subsection (a) of this section shall be considered nonobvious if—
(A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and
(B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.
(2) A patent issued on a process under paragraph (1)—
(A) shall also contain the claims to the composition of matter used in or made by that process, or
(B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding section 154.
(3) For purposes of paragraph (1), the term “biotechnological process” means—
(A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to—
(i) express an exogenous nucleotide sequence,
(ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or
(iii) express a specific physiological characteristic not naturally associated with said organism;
(B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and
(C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).
(c) (1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.
(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if—

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;
(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and
(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

35 U.S.C.104:

(a) In General.—

(1) Proceedings.— In proceedings in the Patent and Trademark Office, in the courts, and before any other competent authority, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country other than a NAFTA country or a WTO member country, except as provided in sections 119 and 365 of this title.

(2) Rights.— If an invention was made by a person, civil or military—

(A) while domiciled in the United States, and serving in any other country in connection with operations by or on behalf of the United States,
(B) while domiciled in a NAFTA country and serving in another country in connection with operations by or on behalf of that NAFTA country, or
(C) while domiciled in a WTO member country and serving in another country in connection with operations by or on behalf of that WTO member country, that person shall be entitled to the same rights of priority in the United States with respect to such invention as if such invention had been made in the United States, that NAFTA country, or that WTO member country, as the case may be.

(3) Use of information.— To the extent that any information in a NAFTA country or a WTO member country concerning knowledge, use, or other activity relevant to proving or disproving a date of invention has not been made available for use in a proceeding in the Patent and Trademark Office, a court, or any other competent authority to the same extent as such information could be made available in the United States, the Director, court, or such other authority shall draw appropriate inferences, or take other action permitted by statute, rule, or regulation, in favor of the party that requested the information in the proceeding.

(b) Definitions.— As used in this section—

(1) the term “NAFTA country” has the meaning given that term in section 2(4) of the North American Free Trade Agreement Implementation Act; and
(2) the term “WTO member country” has the meaning given that term in section 2(10) of the Uruguay Round Agreements Act.

35 U.S.C.105

(a) Any invention made, used or sold in outer space on a space object or component thereof under the jurisdiction or control of the United States shall be considered to be
made, used or sold within the United States for the purposes of this title, except with respect to any space object or component thereof that is specifically identified and otherwise provided for by an international agreement to which the United States is a party, or with respect to any space object or component thereof that is carried on the registry of a foreign state in accordance with the Convention on Registration of Objects Launched into Outer Space.

(b) Any invention made, used or sold in outer space on a space object or component thereof that is carried on the registry of a foreign state in accordance with the Convention on Registration of Objects Launched into Outer Space, shall be considered to be made, used or sold within the United States for the purposes of this title if specifically so agreed in an international agreement between the United States and the state of registry.

**European Patent Convention Art.52-57**

**Art.52: Patentable Inventions:**

(1) European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step.

(2) The following in particular shall not be regarded as inventions within the meaning of paragraph 1:

(a) discoveries, scientific theories and mathematical methods;

(b) aesthetic creations;

(c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;

(d) presentations of information.

(3) The provisions of paragraph 2 shall exclude patentability of the subject-matter or activities referred to in that provision only to the extent to which a European patent application or European patent relates to such subject-matter or activities as such.

(4) Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be regarded as inventions which are susceptible of industrial application within the meaning of paragraph 1. This provision shall not apply to products, in particular substances or compositions, for use in any of these methods.

**Article 53: Exceptions to patentability:**

European patents shall not be granted in respect of:

(a) inventions the publication or exploitation of which would be contrary to "ordre public" or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in one or all of the Contracting States;

(b) plant or animal varieties or essentially biological processes for the production of plants or animals; this provision does not apply to microbiological processes or the products thereof.

**Article 54: Novelty**

(1) An invention shall be considered to be new if it does not form part of the state of the art.
(2) The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.

(3) Additionally, the content of European patent applications as filed, of which the dates of filing are prior to the date referred to in paragraph 2 and which were published under Article 93 on or after that date, shall be considered as comprised in the state of the art.

(4) Paragraph 3 shall be applied only in so far as a Contracting State designated in respect of the later application, was also designated in respect of the earlier application as published.

(5) The provisions of paragraphs 1 to 4 shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Article 52, paragraph 4, provided that its use for any method referred to in that paragraph is not comprised in the state of the art.

Article 55: Non-prejudicial disclosures

(1) For the application of Article 54 a disclosure of the invention shall not be taken into consideration if it occurred no earlier than six months preceding the filing of the European patent application and if it was due to, or in consequence of:
   (a) an evident abuse in relation to the applicant or his legal predecessor, or
   (b) the fact that the applicant or his legal predecessor has displayed the invention at an official, or officially recognised, international exhibition falling within the terms of the Convention on international exhibitions signed at Paris on 22 November 1928 and last revised on 30 November 1972.

(2) In the case of paragraph 1(b), paragraph 1 shall apply only if the applicant states, when filing the European patent application, that the invention has been so displayed and files a supporting certificate within the period and under the conditions laid down in the Implementing Regulations

Article 56: Inventive step:

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art. If the state of the art also includes documents within the meaning of Article 54, paragraph 3, these documents are not to be considered in deciding whether there has been an inventive step.

Article 57: Industrial application:

An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

TRADE RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS

Section 5: Arts.27 – 34

Article 27: Patenable Subject Matter

1. Subject to the provisions of paragraphs 2 and 3, patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application. Subject to paragraph 4 of Article 65, paragraph 8 of Article 70 and paragraph 3 of this Article, patents shall be available and patent rights enjoyable without discrimination as to the place of invention, the field of technology and whether products are imported or locally produced.
2. Members may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect ordre public or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by their law.

3. Members may also exclude from patentability:
   (a) diagnostic, therapeutic and surgical methods for the treatment of humans or animals;
   (b) plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes. However, Members shall provide for the protection of plant varieties either by patents or by an effective sui generis system or by any combination thereof. The provisions of this subparagraph shall be reviewed four years after the date of entry into force of the WTO Agreement.

Article 28: Rights Conferred
1. A patent shall confer on its owner the following exclusive rights:
   (a) where the subject matter of a patent is a product, to prevent third parties not having the owner’s consent from the acts of: making, using, offering for sale, selling, or importing for these purposes that product;
   (b) where the subject matter of a patent is a process, to prevent third parties not having the owner’s consent from the act of using the process, and from the acts of: using, offering for sale, selling, or importing for these purposes at least the product obtained directly by that process.

2. Patent owners shall also have the right to assign, or transfer by succession, the patent and to conclude licensing contracts.

Article 29: Conditions on Patent Applicants
1. Members shall require that an applicant for a patent shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art and may require the applicant to indicate the best mode for carrying out the invention known to the inventor at the filing date or, where priority is claimed, at the priority date of the application.

2. Members may require an applicant for a patent to provide information concerning the applicant’s corresponding foreign applications and grants.

Article 30: Exceptions to Rights Conferred

Members may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.

Article 31: Other Use Without Authorization of the Right Holder

Where the law of a Member allows for other use of the subject matter of a patent without the authorization of the right holder, including use by the government or third parties authorized by the government, the following provisions shall be respected:
   (a) authorization of such use shall be considered on its individual merits;
   (b) such use may only be permitted if, prior to such use, the proposed user has made efforts to obtain authorization from the right holder on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of
time. This requirement may be waived by a Member in the case of a national emergency or other circumstances of extreme urgency or in cases of public non-commercial use. In situations of national emergency or other circumstances of extreme urgency, the right holder shall, nevertheless, be notified as soon as reasonably practicable. In the case of public non-commercial use, where the government or contractor, without making a patent search, knows or has demonstrable grounds to know that a valid patent is or will be used by or for the government, the right holder shall be informed promptly;

(c) the scope and duration of such use shall be limited to the purpose for which it was authorized, and in the case of semi-conductor technology shall only be for public non-commercial use or to remedy a practice determined after judicial or administrative process to be anti-competitive;

(d) such use shall be non-exclusive;

(e) such use shall be non-assignable, except with that part of the enterprise or goodwill which enjoys such use;

(f) any such use shall be authorized predominantly for the supply of the domestic market of the Member authorizing such use;

(g) authorization for such use shall be liable, subject to adequate protection of the legitimate interests of the persons so authorized, to be terminated if and when the circumstances which led to it cease to exist and are unlikely to recur. The competent authority shall have the authority to review, upon motivated request, the continued existence of these circumstances;

(h) the right holder shall be paid adequate remuneration in the circumstances of each case, taking into account the economic value of the authorization;

(i) the legal validity of any decision relating to the authorization of such use shall be subject to judicial review or other independent review by a distinct higher authority in that Member;

(j) any decision relating to the remuneration provided in respect of such use shall be subject to judicial review or other independent review by a distinct higher authority in that Member;

(k) Members are not obliged to apply the conditions set forth in subparagraphs (b) and (f) where such use is permitted to remedy a practice determined after judicial or administrative process to be anti-competitive. The need to correct anti-competitive practices may be taken into account in determining the amount of remuneration in such cases. Competent authorities shall have the authority to refuse termination of authorization if and when the conditions which led to such authorization are likely to recur;

(l) where such use is authorized to permit the exploitation of a patent ("the second patent") which cannot be exploited without infringing another patent ("the first patent"), the following additional conditions shall apply:

(i) the invention claimed in the second patent shall involve an important technical advance of considerable economic significance in relation to the invention claimed in the first patent;

(ii) the owner of the first patent shall be entitled to a cross-licence on reasonable terms to use the invention claimed in the second patent; and

(iii) the use authorized in respect of the first patent shall be non-assignable except with the assignment of the second patent.
Article 32: Revocation/Forfeiture

An opportunity for judicial review of any decision to revoke or forfeit a patent shall be available.

Article 33: Term of Protection

The term of protection available shall not end before the expiration of a period of twenty years counted from the filing date.

Article 34: Process Patents: Burden of Proof

1. For the purposes of civil proceedings in respect of the infringement of the rights of the owner referred to in paragraph 1(b) of Article 28, if the subject matter of a patent is a process for obtaining a product, the judicial authorities shall have the authority to order the defendant to prove that the process to obtain an identical product is different from the patented process. Therefore, Members shall provide, in at least one of the following circumstances, that any identical product when produced without the consent of the patent owner shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process:
   (a) if the product obtained by the patented process is new;
   (b) if there is a substantial likelihood that the identical product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used.

2. Any Member shall be free to provide that the burden of proof indicated in paragraph 1 shall be on the alleged infringer only if the condition referred to in subparagraph (a) is fulfilled or only if the condition referred to in subparagraph (b) is fulfilled.

3. In the adduction of proof to the contrary, the legitimate interests of defendants in protecting their manufacturing and business secrets shall be taken into account.