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इस भाग में भिन्न पृष्ठ संख्या दी जाती है जिससे कि यह अलग संकलन के रूप में रखा जा सके।
Separate paging is given to this Part in order that it may be filed as a separate compilation.

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MINISTRY OF LAW, JUSTICE AND COMPANY AFFAIRS
(Legislative Department)

New Delhi, the 25th June, 2002/Asadha 4, 1924 (Saka)

The following Act of Parliament received the assent of the President on the 25th June, 2002, and is hereby published for general information:—

THE PATENTS (AMENDMENT) ACT, 2002

(No. 38 OF 2002)

[25th June, 2002.]

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:—

Short title and commencement.

1. *(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.

Substitution of certain words for the words "High Court" and "Court".

2. In the Patents Act, 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. 39 of 1970.

Amendment of section 2.

3. 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. 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. 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. 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. 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. 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. 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:—

Publication of applications.

"11A. (*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.

Request for examination.

11B. (*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. 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. 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. For section 15 of the principal Act, the following section shall be substituted, namely:—

Power of Controller to refuse or require amended applications, etc., in certain cases.

"15. 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. 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 refiled after complying with the requirement.".

Amendment of section 21.

14. 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. 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. In section 23 of the prinicpal 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. 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. 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. 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. 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. After section 38 of the principal Act, the following section shall be inserted, namely:—

Prohibition to apply, under certain circumstances, for patents relevant for defence purposes, etc.

"39. *(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. 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. 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. 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. For section 48 of the principal Act, the following section shall be substituted, namely:—

Rights of patentees.

"48. 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 the 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. 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.

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

(*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.".

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

(*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.

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

(*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. 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. 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;

(*iii*) 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. 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, 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. 1 of 1872.

(*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 any 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. 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. 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. 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", the words and figures "section 3 of the Trade Marks Act, 1999" shall be substituted.

43 of 1958.
47 of 1999.

Amendment of section 76.

36. 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" shall respectively be omitted.

2 of 1911.

Amendment of section 78.

37. 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. 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. For Chapter XVI of the principal Act, the following Chapter shall be substituted, namely:—

'CHAPTER XVI

WORKING OF PATENTS, COMPULSORY LICENCES AND REVOCATION

Definitions of "patented articles" and "patentee".

82. 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.

General principles applicable to working of patented inventions.

83. 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.

Compulsory licences.

84. (*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.

Revocation of patents by the Controller for non-working.

85. (*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.

Power of Controller to adjourn applications for compulsory licences, etc., in certain cases.

86. (*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 months 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.

Procedure for dealing with applications under sections 84 and 85.

87. (*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.

Powers of Controller in granting compulsory licences.

88. (*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 for 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.

General purposes for granting compulsory licences.

89. 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.

Terms and conditions of compulsory licences.

90. (*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 susbtance 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.

Licensing of related patents.

91. (*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.

Special provision for compulsory licences on notifications by Central Government.

92. (*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 patentees 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.

Order for licence to operate as a deed between parties concerned.

93. 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.

Termination of compulsory licence.

94. (*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. In section 99 of the principal Act, sub-section (*2*) shall be omitted.

Amendment of section 100.

41. 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. 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. After section 104 of the principal Act, the following section shall be inserted, namely:—

Burden of proof in case of suits concerning infringement.

"104A. (*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. After section 107 of the principal Act, the following section shall be inserted, namely:—

Certain acts not to be considered as infringement.

"107A. 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. 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 implement, 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. Section 112 of the principal Act shall be omitted.

Substitution of new Chapter for Chapter XIX.

47. For Chapter XIX of the principal Act, the following Chapter shall be substituted, namely:—

"CHAPTER XIX

APPEALS TO THE APPELLATE BOARD

Appellate Board.

47 of 1999.

116. (*1*) Subject to the provisions of this Act, the Appellate Board established under section 83 of the Trade Marks Act, 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.

Staff of Appellate Board.

117. (*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.

Appeals to Appellate Board.

117A. (*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, sub-section (*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.

Procedure and powers of Appellate Board.

47 of 1999.

117B. 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 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.

Bar of jurisdiction of courts, etc.

117C. 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.

Procedure for application for rectification, etc., before Appellate Board.

117D. (*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.

Appearance of Controller in legal proceedings.

117E. (*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.

Costs of Controller in proceedings before Appellate Board.

117F. 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.

Transfer of pending proceedings to Appellate Board.

117G. 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.

Power of Appellate Board to make rules.

117H. 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. 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 of a patent in contravention of section 39" shall be inserted.

Amendment of section 120.

49. 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. 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. 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. For section 125 of the principal Act, the following section shall be substituted, namely:—

Register of patent agents.

"125. (*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. 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. 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. 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. 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. 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. 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. 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. 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. 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. 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. For section 157A of the principal Act, the following section shall be substituted, namely:—

Protection of security of India.

'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 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. 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:—

"(*xiia*) 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;

(*xiic*) 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. Section 161 of the principal Act shall be omitted.

Amendment of section 162.

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

SUBHASH C. JAIN,
Secy. to the Govt. of India.

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