

Chapter 8

Grant of Patents and Rights Conferred Thereby

(Section 43-53)

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Highlights: Chapter 8

There shall not be any delay in grant of the patent by the controller and patent shall be granted to the applicant without delay if:

- The applicant has removed all the objections raised during examination of application or has amended the application to the satisfaction of the Controller.
- The applicant has put application in order for grant under Section 21 of the Act.
- There is no pre-grant representation within a period of **six months** from the date of publication and before the grant of patent
- When the pre-grant opposition has been disposed of in favor of the applicant.

The grant of the patent is published and for 1 year, the application remains open for any post-grant opposition. However, the grant of patent confers some rights to the patent holder depending upon the subject-matter of a patent whether it is for a process or a product. This Chapter also details the rights of co-owner and term of a patent along with the renewal fee required to keep a patent in force.

Important timelines

Section 43/Rule 74: Upon the grant of a patent under **Section 43**, a patent certificate is issued within **7 days** from the date of grant of patent.

Section 51//Rule 77: If any proprietor of the patent requested by the other proprietor to execute any instrument or to do anything which requires according to the **Section 51** and the proprietor fails to do the same within **14 days**.

Section 52/Rule 79: Requests made by the petitioner under **Section 52(2)** shall be made in the **Form-12** [*Request by the Petitioner under Section 52(2)*] within **3 months** from the date of the order of the Appellate board.

Section 53/Rule 80: The term of every granted patent or the patent that has not expired or not ceased to have effect after the commencement of the Patents (Amendment) Act, 2002 shall be **20 years** from the date of filing of application of the patent.

Rule 80, the period of payment of renewal fees is not extended more than **6 months**, only if the request for extension of time is made in **Form-4** [*Request for extension of time*] with the specified fee. The annual renewal fees are payable in respect of **2 years** or more years and can be paid in advance.

Section 43: Grant of patents **

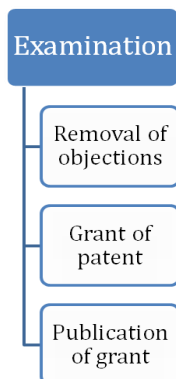
(1) Where an application for a patent has been found to be in order for grant of the patent and either
(a) the application hasn't been refused by the Controller by virtue of any power vested in him by this Act;
or

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

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

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

Interpretation (Section 43): After examination of the application, FER (First Examination Report) is sent to the applicant and the applicant shall comply with all discrepancies listed by the Controller in FER. After removing all objections/discrepancies, there shall not be any delay in grant of patent to the applicant.



(1) Where an application for a patent has been found to be in order for grant of the patent, the patent shall be granted as expeditiously as possible to the applicant (s) with the seal of the patent office. The date on which the patent is granted shall be entered in the register of patents if:

- a. Application has not been refused by the Controller; or
- b. Application has not been found to be in contravention of any of the provisions of this Act.

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

Rule 73: Omitted

Rule 74: Form of patent

(1) A patent shall be in the form as specified in the Third Schedule with such modifications as the circumstances of each case may require and shall bear the number accorded to the application under rule 37.

(2) The patent certificate shall ordinarily be issued within seven days from the date of grant of patent under section 43.

Interpretation (Rule 74): There is a proper format for the certificate of granted patent as mentioned in Third Schedule.

[THE THIRD SCHEDULE] (Refer rule 74) FORM OF PATENT	
GOVERNMENT OF INDIA	
Patent No. Application No. Date of filing Patentee..... Inventor(s) (Where applicable) It is hereby certified that a patent has been granted to the patentee for an invention entitled.....as disclosed in the above mentioned application for the term of 20 years from theday of.....20..... in accordance with the provisions of the Patent Act, 1970. <div style="display: flex; justify-content: space-between;"> Date of Grant..... Seal of the Office)..... Controller of Patents </div>	
<p>Note: - The fees for renewal of this patent, if it is to be maintained will fall due on.....day of20.... and on the same day in every year thereafter.]</p>	

(1) A patent shall be in the form as specified in the Third Schedule and shall bear the number accorded to the application (Rule-37, *Numbering of applications on the grant of patent*).

(2) The patent certificate shall ordinarily be issued within 7 days from the date of grant of patent (Section 43, *Grant of patents*).

Rule 74A: Inspection of documents related to grant of patent

After the date of publication of a grant of a patent, the application together with the complete specification and provisional specification, if any, the drawing if any, abstract and other documents related thereto may be inspected at the appropriate office by making a written request to the Controller and on payment of fee and may obtain copies on payment of fee specified in the First Schedule.

Interpretation (Rule 74A): After the date of publication of a grant of a patent, the application together with the complete specification and provisional specification [if any], the drawing [if any], abstract and other documents may be inspected at the appropriate office by making a written request to the Controller on payment of fee as specified in the First Schedule [**320 INR for natural person/start up/small entity/educational institute and 1600 INR for others for e-filing and ten per cent additional in case of**

filing by physical mode. For supplying photocopies of the documents per page, the fee is 10 INR per page.].

Section 44: Amendment of patent granted to deceased applicant

Where, at any time after a patent has been granted in pursuance of an application under this Act, the Controller is satisfied that the person to whom the patent was granted had died, or, in the case of a body corporate, had ceased to exist, before the patent was granted, the Controller may amend the patent by substituting for the name of that person the name of the person to whom the patent ought to have been granted, and the patent shall have effect, and shall be deemed always to have had effect, accordingly.

Interpretation (Section 44): Section-44 relates to the substitution of applicant name in case of death of the applicant. If at any time after a patent has been granted, the Controller is satisfied that:

- The person to whom the patent was granted had died; or
- In the case of a body corporate [for example a company] had ceased to exist, before the patent was granted.

The Controller may amend the patent and substitute for the name of that person with the name of the person to whom the patent ought to have been granted, the patent in such as case shall have effect and shall be deemed always to have had effect, accordingly.

Rule 75: Amendment of patent under section 44

An application under section 44 for the amendment of a patent shall be made in Form 10 along with substantiating evidence and be accompanied by the patent.

Interpretation (Rule 75): An application under Section-44 for the amendment of a patent granted to a deceased applicant shall be made in **Form-10** [*Application for amendment of patent*] along with substantiating evidence. In case the person has died, his death certificate shall be submitted along with Form-10. Similarly, if the company ceases to exist, the documents proving closure of the company shall be submitted as evidence.

Fee: 2400 INR for natural person/start-up/small entity/educational institute and 12000 INR for others for e-filing and ten per cent additional in case of filing by physical mode.

Section 45: Date of patent ***

(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.

(2) The date of every patent shall be entered in the register.

(3) Notwithstanding anything contained in this section, no suit or other proceeding shall be commenced or prosecuted in respect of an infringement committed before the date of publication of the application.

Interpretation (Section 45): Every patent shall have date of filing as this date is important to calculate life of a patent [20 years from date of filing] as well as renewal fee.

- (1) Every patent shall be dated as of the date on which the application for patent was filed.
- (2) The date of every patent shall be entered in the register of patents.
- (3) No suit or other proceeding shall be commenced or prosecuted in respect of an infringement committed before the date of publication of grant of the application. The reason being that patent becomes part of prior art only after publication.

Section 46: Form, extent and effect of patent

(1) Every patent shall be in the prescribed form and shall have effect throughout India

(2) A patent shall be granted for one invention only:

Provided that it shall not be competent for any person in a suit or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention

Interpretation (Section 46): One patent shall claim only one invention. If it has more than one invention, the Controller may ask the applicant to divide it into more than one invention and file divisional application under Section-16. In any lawsuit or other proceeding, no one can raise objections that the patent has been granted for more than one invention.

(1) Every patent shall be in the prescribed form and shall have effect throughout India.

(2) A patent shall be granted for one invention only. It shall not be competent for any person in a suit or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

Section 47: Grant of patents to be subject to certain conditions **

The grant of a patent under this Act shall be subject to the condition that;

(1) any machine, apparatus or other article in respect of which the patent is granted or any article made by using a process in respect of which the patent is granted, may be imported or made by or on behalf of the Government for the purpose merely of its own use;

(2) any process in respect of which the patent is granted may be used by or on behalf of the Government for the purpose merely of its own use;

(3) any machine, apparatus or other article in respect of which the patent is granted or any article made by the use of the process in respect of which the patent is granted, may be made or used, and any process in respect of which the patent is granted may be used, by any person, for the purpose merely of experiment or research including the imparting of instructions to pupils; and

(4) In the case of a patent in respect of any medicine or drug, the medicine or drug may be imported by the Government for the purpose merely of its own use or for distribution in any dispensary, hospital or other medical institution maintained by or on behalf of the Government or any other dispensary, hospital or other medical institution which the Central Government may, having regard to the public service that such dispensary, hospital or medical institution renders, specify in this behalf by notification in the Official Gazette.

Interpretation (Section 47): The grant of a patent is not absolute but there are certain exceptions. The patented invention can be used by Government for its own use, or for experimental or research purpose [including the imparting of instructions to the students] or in Government hospital, dispensary or medical institution.

(1) Any machine, apparatus or other article as a product for which the patent is granted or any article made by a patented process may be imported or made by or on behalf of the Government for the purpose merely of its own use.

(2) Any process in respect of which the patent is granted may be used by or on behalf of the Government for the purpose merely of its own use.

(3) Any machine, apparatus or other article in respect of which the patent is granted or any article made by the use of the patented process may be made or used, and any process in respect of which

- the patent is granted may be used, by any person, for the purpose merely of experiment or research including the imparting of instructions to pupils and
- (4) In the case of a patent in respect of any medicine or drug, the medicine or drug may be imported by the Government for the purpose merely of its own use or for distribution in any dispensary, hospital or other medical institution maintained by or on behalf of the Government or any other dispensary, hospital or other medical institution which the Central Government may, having regard to the public service that such dispensary, hospital or medical institution renders, specify in this behalf by notification in the Official Gazette.

Section 48: Rights of patentees ***

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

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

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

Interpretation (Section 48): Section-2 explains that invention is a product or process having novelty, inventive step and industrial application, which means that a patent can be granted either for a product or for a process. As far as rights of patentee are concerned, patent granted under this Act shall confer upon the patentee following rights:

- (1) Where the subject matter of the patent is a product, the patentee has exclusive right to prevent third parties, who do not have his consent, from the act of:
 - a. Making;
 - b. Using;
 - c. Offering for sale;
 - d. Selling; or
 - e. Importing for those purposes that product in India.
- (2) Where the subject matter of the patent is a process, the patentee the exclusive right to prevent third parties, who do not have his consent, from the act of:
 - a. Using that process;
 - b. Offering for sale;
 - c. Selling; or
 - d. Importing for those purposes the product obtained directly by that process in India.

The Patent act doesn't define anywhere the meaning of "Infringement of patent rights", but violation of any of the above mentioned rights is called as infringement.

Interpretation of Section-48 indicates that the patent does not give any positive rights but a set of negative rights to the patentee over his invention. A patentee's freedom to use its own invention may be limited by legislation or regulations or by the existence of other patents. Patentee has no right to make, use, sell or import the product for which he has a patent but has exclusive right to prevent third parties from making, using, selling, offering for sale and importing the patented products if the patented invention relates to a product. Similarly, if the patent is for a process, patentee has exclusive right to prevent third parties to make, use, sell, offer for sale or import any product made using the patented process, meaning that the

patentee can only exclude competitors or third parties from using or exploiting the invention, even if the competitor subsequently develops the same invention independently.

Section 49: Patent rights not infringed when used on foreign vessels etc., temporarily or accidentally in India

(1) Where a vessel or aircraft registered in a foreign country or a land vehicle owned by a person ordinarily resident in such country comes into India (including the territorial waters thereof) temporarily or accidentally only, the rights conferred by a patent for an invention shall not be deemed to be infringed by the use of the invention:

(a) in the body of the vessel or in the machinery, tackle, apparatus or other accessories thereof, so far as the invention is used on board the vessel and for its actual needs only; or

(b) in the construction or working of the aircraft or land vehicle or of the accessories thereof, as the case may be.

(2) This section shall not extend to vessels, aircrafts or land vehicles owned by persons ordinarily resident in a foreign country the laws of which do not confer corresponding rights with respect to the use of inventions in vessels, aircraft or land vehicles owned by persons ordinarily resident in India while in the ports or within the territorial waters of that foreign country or otherwise within the jurisdiction of its courts

Interpretation (Section 49): Where a vessel or aircraft registered in a foreign country or a land vehicle owned by a person ordinarily resident in such country comes into India (including the territorial waters thereof) temporarily or accidentally only, the rights conferred by a patent for an invention shall not be deemed to be infringed by the use of the invention:

i) in the body of the vessel or in the machinery, tackle, apparatus or other accessories thereof, so far as the invention is used on board the vessel and for its actual needs only; or

ii) in the construction or working of the aircraft or land vehicle or of the accessories thereof, as the case may be.

These provisions shall not extend to vessels, aircraft or land vehicles owned by persons ordinarily resident in a foreign country the law of which do not confer corresponding rights with respect to the use of inventions in vessels, aircraft or land vehicles owned by persons ordinarily resident in India while in the ports or within the territorial waters of that foreign country or otherwise within the jurisdiction of its courts.

Illustration

An aircraft registered in US, halts in India for 2 days and in the aircraft, there is a component which is patented by an Indian Company. Since the aircraft is only temporarily halted in India, use of such patented component shall not deem to be infringement of patent right because the aircraft has come to India or temporarily.

Section 50: Rights of co-owners of patents **

(1) Where a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent.

(2) Subject to the provisions contained in this section and in section 51, where two or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to rights conferred by section 48 for his own benefit without accounting to the other person or persons.

(3) Subject to the provisions contained in this section and in section 51 and to any agreement for the time being in force, where two or more persons are registered as grantee or proprietor of a patent, then, a license under the patent shall not be granted and share in the patent shall not be assigned by one of such persons except with the consent of the other person or persons.

(4) Where a patented article is sold by one of two or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming through him shall be entitled to deal with the article in the same manner as if the article had been sold by a sole patentee.

(5) Subject to the provisions contained in this section, the rules of law applicable to the ownership and devolution of movable property generally shall apply in relation to patents; and nothing contained in subsection (1) or subsection (2) shall affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or their rights or obligations as such.

(6) Nothing in this section shall affect the rights of the assignees of a partial interest in a patent created before the commencement of this Act.

Interpretation (Section 50): When a patent is granted to two or more persons, each of those persons will be entitled to an equal undivided share in the patent, unless an agreement to the contrary is in force. All of them can enjoy their rights for his own benefit without accounting to the other person (s), but license or assignment of their share to any other person should not be made without the consent of others.

- (1) Co-owners have equal & undivided share in the patent unless there is an agreement to the contrary. If co-owners want different percentage of share to be allocated, they should execute a separate agreement stating the percentage of share for each co-owner. In absence of such agreement, the co-owners shall have equal share in patent.
- (2) Each of the co-owners shall be entitled to rights as mentioned Section-48 [*Right of patentee*] for his own benefit without accounting to the other co-owner (s) unless an agreement to the contrary is in force.
- (3) A license under the patent shall not be granted and share in the patent shall not be assigned by one of such persons without consent of the other co-owner (s).
- (4) If a patented article is sold by one of the co-owners, the purchaser and any person claiming through him shall be entitled to deal with the article in the same manner as if the article had been sold by a sole patentee.
- (5) For the purpose of property right, patent right is treated as movable property¹. Rules of law applicable to the ownership and devolution of movable property generally shall apply in relation to patents.
- (6) Nothing in this section shall affect the rights of the assignees of a partial interest in a patent created before the commencement of this Act.

Section 51: Power of Controller to give directions to co-owners

(1) Where two or more persons are registered as grantee or proprietor of a patent, the Controller may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licenses under the patent, or the exercise of any right under section 50 in relation thereto, as he thinks fit.

(2) If any person registered as grantee or proprietor of a patent fails to execute any instrument or to do any other thing required for the carrying out of any direction given under this section within fourteen days after being requested in writing so to do by any of the other persons so registered, the Controller may, upon

¹ Movable property is property that can be moved from one place to another. It includes personal items such as clothing and jewelry, household goods such as furniture and appliances etc.

application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default.

(3) Before giving any directions in pursuance of an application under this section, the Controller shall give an opportunity to be heard:

(a) in the case of an application under sub-section (1) to the other person or persons registered as grantee or proprietor of the patent;

(b) In the case of an application under sub-section (2), to the person in default.

(4) No direction shall be given under this section so as to affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or of their rights or obligations as such, or which is inconsistent with the terms of any agreement between persons registered as grantee or proprietor of the patent.

Interpretation (Section 51): Powers of the Controller to give directions to co-owner² in case of sale or lease or execution of instrument³ are as follows:

- (1) If a patent is co-owned, the Controller may give directions for the sale or lease of the patent or any interest therein or the exercise of any right under Section-50 to any of the co-owners. Such direction is given by the Controller only when application is made to him in the prescribed manner by any of the co-owners.
- (2) If any person registered as grantee or proprietor of a patent fails to execute any instrument⁴ or to do any other thing required for carrying out of any direction given under this section within **14 days** after being requested in writing so to do by any of the other persons so registered, the Controller may, upon application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default.

Illustration

Maya is registered as grantee of the patent and she fails to execute the instrument (license agreement) with 14 days after being requested by person who is co-owner of the patent. If co-owner makes application to the Controller, any other person can execute the instrument in the name and on behalf of Maya.

- (3) Before giving any directions under this section, the Controller shall give an opportunity to be heard:
 - a. In the case of an application under sub-section (1) to the other person or persons registered as grantee or proprietor of the patent;
 - b. In the case of an application under sub-section (2), to the person in default.
- (4) No direction shall be given under this section so as to affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or of their rights or obligations as such, or which is inconsistent with the terms of any agreement between persons registered as grantee or proprietor of the patent.

² Fee payable is 2400 INR for natural person/start up/small entity/educational institute and 12000 INR for others for e-filing and ten per cent additional in case of filing by physical mode.

³ A formal or legal written document; a document in writing, such as a deed, lease, bond, contract, or will. A writing that serves as evidence of an individual's right to collect money, such as a cheque.

⁴ A formal or legal written document; a document in writing, such as a deed, lease, bond, contract, or will.

Rule 76: Manner of applying for direction under section 51(1)

(1) An application for directions under sub-section (1) of section 51 shall be made in Form 11 and shall be accompanied by a statement setting out the facts upon which the applicant relies.

(2) A copy of the application and of the statement shall be sent by the Controller to every other person registered as grantee or proprietor of the patent.

Interpretation (Rule 76): (1) An application for directions under Section-51 (1) shall be made in Form-11⁵ [On application for directions under Section-51 (1) and 51 (2)] and shall be accompanied by a statement setting out the facts upon which the applicant relies.

(2) A copy of the application and of the statement shall be sent by the Controller to every other person registered as grantee or proprietor of the patent.

Rule 77: Manner of application under section 51(2)

(1) An application for directions under sub-section (2) of section 51 shall be made in Form 11 and shall be accompanied by a statement setting out the facts upon which the applicant relies.

(2) A copy of the application and statement shall be sent by the Controller to the person in default.

Interpretation (Rule 77): (1) An application for directions under sub-section Section-51 (2) shall be made in Form-11 [On application for directions under Section 51 (1) and 51 (2)] and shall be accompanied by a statement setting out the facts upon which the applicant relies.

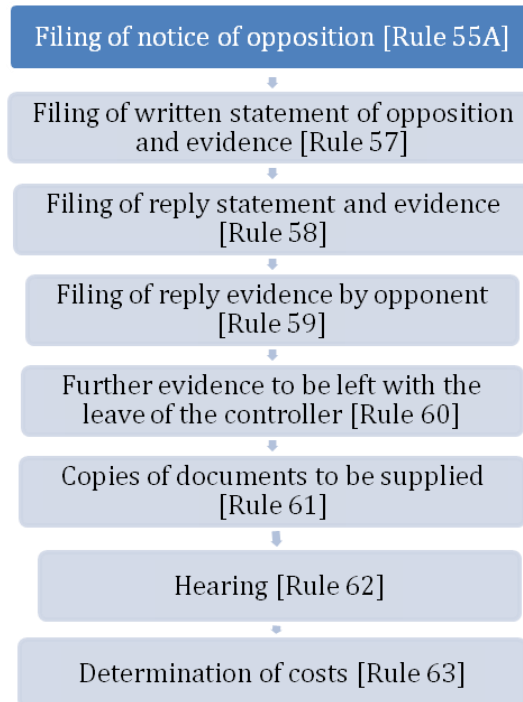
(2) A copy of the application and statement shall be sent by the Controller to the person in default.

Rule 78: Procedure for the hearing of proceedings under section 51

The procedure specified in rules 55A and 57 to 63 relating to the filing of notice of opposition, written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of an application under section 51 as they apply to the hearing of an opposition proceeding.

Interpretation (Rule 78): The procedure specified in Rules-55A and 57 to 63 relating to the filing of notice of opposition, written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of an application under Section-51 as they apply to the hearing of an opposition proceeding.

⁵ Fee payable is 2400 INR for natural person/start up/small entity/educational institute and 12000 INR for others for e-filing and ten per cent additional in case of filing by physical mode.



Section 52: Grant of patent to true and first inventor where it has been obtained by another in fraud of him

(1) Where a patent has been revoked under Section 64 on the ground that the patent was obtained wrongfully and in contravention of the rights of the petitioner or any person under or through whom he claims, or, where in a petition for revocation, the court, instead of revoking the patent, directs the complete specification to be amended by the exclusion of a claim or claims in consequence of a finding that the invention covered by such claim or claims had been obtained from the petitioner, the court may, by order passed in the same proceeding, permit the grant to the petitioner of the whole or such part of the invention which the court finds has been wrongfully obtained by the patentee, in lieu of the patent so revoked or is excluded by amendment.

(2) Where any such order is passed, the Controller shall, on request by the petitioner made in the prescribed manner grant to him-

(i) in cases where appellate board or the court permits the whole of the patent to be granted, a new patent bearing the same date and number as the patent revoked;

(ii) in cases where appellate board or the court permits a part only of the patent to be granted, a new patent for such part bearing the same date as the patent revoked and numbered in such manner as may be prescribed:

PROVIDED that the Controller may, as a condition of such grant, require the petitioner to file a new and complete specification to the satisfaction of the Controller describing and claiming that part of the invention for which the patent is to be granted.

(3) No suit shall be brought for any infringement of a patent granted under this section committed before the actual date on which such patent was granted.

Interpretation (Section 52): The Controller has the power to grant a patent to the “true and first inventor” with the same date and number of a patent which has been revoked under Section-64 on the ground that it had been obtained by the patentee in fraud.

- (1) If the patent was obtained wrongfully from the true and first inventor, the court shall direct order and permit grant of patent to the petitioner [true and first inventor] instead of revoking it. Court may also direct to amend application and grant to petitioner [true and first inventor] the portion of patent which is wrongfully obtained and belongs to true and first inventor.
- (2) Where any such order is passed, the Controller shall, on request by the petitioner manner grant to him⁶:
 - a. A new patent bearing the same date and number as the patent revoked, in cases where the appellate board or the court permits the whole of the patent to be granted.
 - b. A new patent for such part bearing the same date as the patent revoked and numbered in such manner as may be prescribed, in cases where appellate board or the court permits a part only of the patent to be granted.

The Controller may require the petitioner to file a new and complete specification and claiming that part of the invention for which the patent is to be granted.

Illustration

Rohan is true and first inventor and Shyam obtains his invention by fraud and files a patent. After the patent has been granted to Shyam, Rohan [petitioner] files a revocation petition under Section 64 on the ground that Shyam obtained invention by fraud. Instead of revoking the patent granted to Shyam, the Controller may grant the same patent (or a part of it, which is obtained by fraud) to Rohan who is true and first inventor of the patent with same date and number.

- (3) No suit shall be brought for any infringement of a patent granted under this section committed before the actual date on which such patent was granted.

Rule 79: Request under Section 52 (2)

1. A request under subsection (2) of Section 52 shall be made in Form-12 within 3 months the date of order of the [Appellate Board or] Court referred to in sub-section (1) of the said section and shall be accompanied by a statement setting out the facts upon which the petitioner relies and relief he claims and a certified copy of the order of the [Appellate Board or the Court].
2. Where [Appellate Board or] Court has ordered the grant of patent to the applicant only for a part of the invention, the new patent granted shall be accorded a number in the same series of numbers accorded to the complete specifications accepted on the same day as patent is granted.

Interpretation (Rule 79): The true and first inventor can request the Controller to grant him a patent where he is true and first inventor and patentee has obtained invention from him by fraud and such patent is revoked [Section-52 (2), *Grant of patent to true and first inventor where it has been obtained by another in fraud of him*].

- (1) A request shall be made in **Form-12** [On request for grant of a patent under Section 26 (1) and 52 (2)] within 3 months the date of order of the Appellate Board or and shall be accompanied by a statement setting out the facts upon which the petitioner [true and first inventor] relies and relief he claims and a certified copy of the order of the [Appellate Board or the Court].

⁶ Fee payable is 2400 INR for natural person/start up/small entity/educational institute, and 12000 INR for others for e-filing and ten per cent additional in case of filing by physical mode.

- (2) Court has ordered the grant of patent to the applicant only for a part of the invention, the new patent granted shall be accorded a number in the same series of numbers accorded to the complete specifications accepted on the same day as patent is granted.

Section 53: Term of patent **

(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.

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

(2) A patent shall cease to have effect notwithstanding anything therein or in this Act on the expiration of the period prescribed for the payment of any renewal fee, if that fee is not paid within the prescribed period or within such extended period as may be prescribed.

(3) Omitted by Act 15 Of 2005

(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 expiry of the term of patent, the subject matter covered by the said patent shall not be entitled to any protection.

Interpretation (Section 53): The term of a patent is 20 years from the date of filing, after that patent fails to be in force and expires. The term of patent and renewal fee in general are governed by the provisions of Section-53, whereas the renewal fee, which has become due at the time of grant of patent, is governed by Section-142(4). When the patent is granted later than two years from the date of filing of the application, the fee that has become due in the meantime might be paid within **three months** from the date of recording of the patent in the Register or within the extended period not later than nine months from the date of recording. In the cases, where the renewal fee, which has become due at the time of grant and that which has become due after the grant are very close, they may be paid together along with required extension under Section-53⁷.

- (1) The term of every patent granted shall be 20 years from the date of filing of the application for the patent. The term of patent in case of international applications filed under the Patent Cooperation Treaty designating India, shall be twenty years from the international filing date accorded under the Patent Cooperation Treaty.

Illustration

If date of filing patent in India is 2nd June 2009, the patent shall expire on 2nd June 2029. However, if the applicant is a foreign national and files application for a patent in his national office on 2nd June 2009 followed by PCT application on 31st May 2010, in India, term of his patent will be calculated from his international date of filing i.e., 20 years from 31st May 2010.

- (2) A patent shall cease to have effect if the patentee does not pay renewal fee to maintain the patent in time.
- (3) Omitted by Act 15 Of 2005.

⁷ Fee payable for extension of time is 480 INR for natural person/start up/small entity/educational institute and 2400 INR for others per month for e-filing and ten per cent additional in case of filing by physical mode.

- (4) On cessation of the patent right due to non-payment of renewal fee or on expiry of the term of patent, the subject matter covered by the said patent shall not be entitled to any protection. It is supposed to be in public domain as prior art and patent fails to be in force. However, there is a provision to restore the patent provided the request for restoration has been made within prescribed time of 18 months from the date the patent ceases to have an effect.

Rule 80: Renewal fees under section 53

(1) To keep a patent in force, the renewal fees specified in the First Schedule shall be payable at the expiration of the second year from the date of the patent or of any succeeding year and the same shall be remitted to the patent office before the expiration of the second or the succeeding year.

(1A) The period for payment of renewal fees so specified in sub-rule (1) may be extended to such period not being more than six months if the request for such extension of time is made in Form 4 with the fee specified in the First Schedule.

(2) While paying the renewal fee, the number and date of the patent concerned and the year in respect of which the fee is paid shall be quoted.

(3) The annual renewal fees payable in respect of two or more years may be paid in advance.

(4) The Controller shall, after making such enquiry as he may deem necessary, credit any renewal fee and issue a certificate that the fee has been paid.

Interpretation (Rule 80): Renewal fee is annual fee to be paid by the patentee in order to keep the patent in force. The patentee can pay fee for more than one year in one transaction.

- (1) To keep a patent in force, the renewal fees specified in the First Schedule shall be payable at the expiration of the second year from the date of the patent or of any succeeding year. The fee shall be remitted to the patent office before the expiration of the second or the succeeding year. The period for payment of renewal fees may be extended to such period not being more than 6 months if the request for such extension of time is made in Form-4 with the fee specified in the First Schedule.

Illustration

A patent was filed on 20th January 1998, published on 25th July 1999 and granted on 12th March 2002. In order to keep patent in force, following fee shall be paid throughout life of a patent i.e., 20 years from date of filing is as follows:

Renewal fee (Section 53, Rule 80) is payable at the expiration of the second year from the date of the patent. Here date of patent is 20-01-1998 and hence first payment of renewal fee is payable before 20th January 2000.

- The fee payable before the expiration of the 2nd year to expiration of 5th year in respect of the 6th year is 800 INR for natural person/start up/small entity/educational institute, and 4000 INR for others for e-filing and ten per cent additional in case of filing by physical mode every year.
- The fee payable before the expiration of the 6th year to expiration of 9th year in respect of the 10th year is 2400 INR for natural person/start up/small entity/educational institute and 12000 INR for others for e-filing and ten per cent additional in case of filing by physical mode every year.
- The fee payable before the expiration of the 10th year to expiration of 14th year in respect of the 15th year is 4800 INR for natural person/start up/small entity/educational institute and 24000 INR for others for e-filing and ten per cent additional in case of filing by physical mode every year.
- The fee payable before the expiration of the 15th year to expiration of the 19th year in respect of the 20th year is 8000 INR for natural person/start up/small entity/educational institute and 40000 INR for others for e-filing and ten per cent additional in case of filing by physical mode every year.

- (2) While paying the renewal fee, the number and date of the patent concerned and the year in respect of which the fee is paid shall be quoted.
- (3) The annual renewal fees payable in respect of two or more years may be paid in advance.
- (4) The Controller shall, after making such enquiry as he may deem necessary, credit any renewal fee and issue a receipt that the fee has been paid.

Self-Assessment Questions

Fill in the blanks:

1. Form-10 can be used for..... with fees offor legal entity.
2. Form-11 can be used for.....with fees of for legal entity.
3. Request for extension of time under Section-53 may be made on Form.....on payment offees.

Write short notes on:

1. Rights of patentee
2. Rights of co-owners of patent
3. Term of patent
4. Date of Patent
5. 'Grant of a patent' is subject to certain conditions. Discuss.

Answer the following:

1. Patent rights are absolute (True/False)
2. Three students approach you for getting patent on their novel machine and all three are applicants and inventors of the machine. Explain them the rights of the co-owners on the patent.
3. **Choose the correct option:**
A granted patent gives the patentee the right to claim damages:
 - i. From the priority date of the patent
 - ii. From the date of grant of the patent
 - iii. From the date of filling of the complete specification
 - iv. From the date the patent applicant has survived an opposition proceeding

From the date of publication of the patent application in the official journal⁷
