in Chemistry, Physics and Engineering and other branches of technology from time to time and tend to eliminate the tendency in some of the existing officers getting fossilised. The post of Deputy Controller may carry the same status and scale of pay, namely, Rs. 800-1300, as that of the Deputy Registrar of Trade Marks.

256. (v) **Joint Controller.**—The Joint Controller of Patents and Designs will be in charge of the day-to-day administration of the office. The status and scale of pay for this post may be the same as that of the Joint Registrar of Trade Marks, namely, Rs. 1,300—1,800. The post of Joint Controller should be treated as a selection post and may be filled up on the recommendation of the U.P.S.C. preferably by direct recruitment or by promotion by selection from among the Deputy Controllers, who have worked for at least five years as Deputy Controller.

257. **Library.**—It is of the utmost importance that the technical library of the Patent Office should be maitained up-to-date and all important books on different branches of technology should be obtained and made available to the Examiners and the public. The maintenance of the Patent Office Library in every industrially advanced country constitutes a very important part of the public service rendered by the Patent Office and their example might be followed in India. In the U.K., for instance, the Patent Office Library is one of the principal scientific and technical reference libraries in that country and contains the patent specifications of all countries, abridgements of specifications and the latest technical books and periodicals in every branch of technology.

258. **Abstracting Section.**—This will be a convenient point at which I might formulate a suggestion which in my opinion would greatly enhance the utility of the Patent Office, by rendering it a potent instrument for the diffusion of scientific and technological knowledge, greatly minimise duplication of work among those engaged in research, and thus accelerate the rate of invention.

259. India is in a position to obtain free on an exchange basis—the published patent specifications from several countries. For instance at the recent Commonwealth Conference at Canberra in November 1955 the following resolution was passed:—

> "This Conference recommends to Commonwealth countries the mutual exchange without charge, of their patent publications, namely, specifications, journals, gazettes, annual reports, laws and regulations and like publications".

260. This resolution has not been ratified, but as this was unanimously passed, there can be no difficulty if a move were made, to make the resolution effective. Again, the American, Russian, West German, and other Patent Offices have offered their specifications on an exchange basis, but lack of space to house these has been the reason for our not availing ourselves of the facilities offered. I consider it a matter of regret that an opportunity for acquiring such a valuable collection of technological information, and making it available to the public should have been neglected—merely for the reason that there is lack of storage facilities.

261. I would recommend that in the first instance at least the specifications in the English language be obtained for the use of the

Patent Office. Now that branches of the Patent Office are going to be established, those specifications may be stored in such office where the problem of space is not so acute as in the Office at Calcutta, and be put to the use to which I shall advert.

262. The disclosure contained in patent specifications are the results of scientific investigations at the highest level, and the specifications therefore represent a vast accumulation of technical knowledge. Though the number of applications for patents filed in India are comparatively few, about 3,000 a year, the number of such applications in the U.K., is over 30,000 a year and in the U.S.A. nearly 1,00,000. Several of the inventions for which patents are granted in the U.K. and in the U.S.A. represent the record of great scientific and technological achievement.

263. The tempo of a country's advance in industrial and technological development is intimately related to the rate of invention evolved in the country. Though occasionally invention is the result of a 'flash of genius', most of the inventions are the end product of patient, organised and sustained research by high level scientists and technicians. Even in countries more industrially and technically advanced than India, complaints are frequently made of the scarcity of scientific and technical personnel of real class gifted with the necessary qualities for research. In India this problem is necessarily more acute, though the opening of more institutions for post-graduate training and of the several national laboratories might help to lessen the gap between the number needed and that available. One must hasten to add that there is never any question of a surfeit of this type of talent, because by its fruitful activity it would itself create conditions stepping up the demand.

264. The point, however, I was endeavouring to make was, that it was essential that the talent on hand available for useful research work should be utilised in the most economical manner, so as to maximise the results of its labours.

265. One of the principal factors that operate to the uneconomical utilisation of research manpower is duplication of effort. Competent observers have expressed the view that the phenomenal advance of Russian scientists in the recent past has been in large measure due to the elimination of duplication of effort. Says Gunther in his recent work "Inside Russia",—

> "One scientific field in which the Russians are particularly strong is abstracting. Their service in this regard is admitted to be incomparably the best in the world, even by people who hate to admit it. Years ago in the United States Students of chemistry were obliged to learn German, in order to read scientific papers and keep up with German chemical literature, which was without peer. Similarly today a great many students in the free world, particularly of physics, biology and mechanics wish that they knew Russian, even if they are not obliged to learn it. Russian abstracting is so copious and skilful that a point has been reached where American scientists have found out about new developments in their fields by fellow

sian abstracting service was set up in 1953, after Stalin. The aim is to make *everything* of any interest or value on a scientific or medical subject published in the world available in Russian within a few months of its first appearance—abstracted, translated, and published. This goes far beyond anything ever attempted by any other Government or private institution in the world".

266. Duplication may assume several forms and of these I will refer to two main types. The first is where, several research workers are engaged independently in solving an identical or an allied problem and when the results achieved or solution reached by one worker or a group of workers is not immediately made available to the others engaged on the work. The methods of eliminating duplication of this type are obviously beyond the scope of this enquiry and so I will say no more about it. There is another type of duplication, in the minimising, if not avoiding of which the Patent Office can lend a helping hand. The duplication I am referring to is that involved in research in this country being carried on without those engaged in it being kept immediately informed of the advances made in other countries of inventions for which patents have been granted there.

267. One of the branches of the Patent Office might be entrusted with the task of examining the patent specifications received from U.S.A., U.K., Australia and Canada. I am mentioning these countries primarily because the specifications would be in English and would not need the services of translators. The patent specifications dealing with those branches of science or technology that might be of use in the country might be collected, abstracted and classified, the classification being based upon the industry in which it might be utilised and the branch of science to which it is related. The abstracts may then be arranged, printed or typed and duplicated separately for each class and be made available for sale to the public. Government research institutions and technological institutions and colleges run by Government may be supplied free with abstracts of patent specifications in the particular class in which they are engaged or interested. If on examination of the abstract, any person desires to have the entire text of the specification, this may be copied and supplied on payment of a fee.

268. I realise that the above proposal would involve the employment of additional staff. I assume that of the specifications examined about 15% of them would be of sufficient interest or importance to justify abstracting. Taking into account, the total number of specifications which would be received by the Indian Patent Office, I consider that a staff consisting of two officers of the grade of Examiners, and one Assistant Controller to guide them and coordinate their activities would be found sufficient. In addition, each of the Examiners would need the services of a sufficient number of scientific assistants of the grade of Senior Scientific Assistant in the National Laboratories—besides clerical staff for typing etc. I am not unmindful of the fact that the amount realised by the sale of the abstracts would hardly meet even a small portion of the cost. But as the object of the provision is to raise the level of scientific and technical education among research workers and those engaged in industry, the return from the scheme should be looked for only in the attainment of technical advance and increased tempo of research.

269. There is one other matter to which I desire to refer. There is a possibility that some of the inventions covered by the specifications received from foreign countries are the subject of patents granted or of applications for patents which are pending in India. In such a case, the circulation of the foreign specification for the same invention might conceivably lead to the unauthorised use and infringement of the inventions patented in India. This possibility is avoided by the Patent Office excluding from the abstracts the specifications for which patents have been applied for and are pending or have been granted in India. This may not be difficult as I am recommending that every applicant for a patent should disclose in his application the details of the corresponding applications if any made abroad by him for the same or substantially the same invention (*vide* clause 7A). In addition, I would suggest that Government might add a note of warning in these publications that before any step is taken towards the commercial working of the invention published, the concerned parties might assure themselves that there is no patent pending or granted in India.

270. I consider that if the results achieved by scientists and research workers in other parts of the world were brought to the notice of scientific students and workers in India, it would besides greatly widening their horizon of knowledge, avoid duplication of effort and would induce them to concentrate on attempts to improve the technique already disclosed in those specifications.

271. **Staff requirements of the Abstracting Section.**—As already stated the new section for preparing abstracts of foreign specifications may be placed under an Assistant Controller with two Examiners. There should be a sufficient number of well qualified Senior Scientific Assistants, First or Second class M.Sc. (or B.E., First Class or Second Class) with a scale of pay and status corresponding to the posts of Senior Scientific Assistants in National Laboratories under the C.S.I.R. They may appear for the Departmental Examination on Patents Law and Practice prescribed for the Examiner, provided they had served atleast for five years as Senior Scientific Assistants and if they pass the Departmental examination they might be considered by the U.P.S.C. for promotion to the posts of Examiners Class I (gazetted) as in the case of Examiners Class II (gazetted). On an average about 100 to 125 patent specifications may be abstracted every month by a Senior Scientific Assistant and on the basis that about 15,000 specifications may have to be abstracted every year, 10 to 15 Senior Scientific Assistants will be required.

272. **Office Accommodation.**—I should like to draw the attention of Government to the fact that the present office accommodation of the Patent Office is totally inadequate and to the urgent necessity for providing enough space for the library and to house the foreign specifications. I would suggest that, as in other industrially advanced countries, the combined Patents and Trade Marks Office should be housed in a separate building having sufficient accommodation for the office staff and for the library.

Patent office a public utility department and to be maintained from general revenue

273. I have not evaluated the financial implications of the recommendations made by me in regard to the strength of the staff and their emoluments nor have I evaluated the implications of the increases I am recommending, as to the fees to be charged. But I would draw attention to three factors which might be taken into account in this connection: (1) I understand that the Patent Office is at present not only self supporting but leaves a surplus of the order of about Rs. 3 lakhs per year and the changes in the scale of fees I have suggested might bring in more revenue; (2) the effective operation of the patent system itself is dependent on the efficiency and adequacy of the Patent Office; (3) The maintenance of a Patent Office should be considered a service rendered to the public, and this is how it is looked upon in the U.K. & U.S.A. and other advanced countries and therefore if an increase in the cost should result in an increase in the efficiency of the service, the cost is always worthwhile.

XII. FORUM FOR LEGAL PROCEEDINGS

Proceedings before the High Court classified

274. The principal proceedings in relation to which it is necessary to define with certainty the Court to which resort should be had, fall under three heads: (1) The court to which appeals against the orders of the Controller should lie and (2) the Court to which original proceedings by way of revocation of patents should lie. (3) The Court which would have competance to determine the matters relating to compensation for Government use of patented inventions under Clause 55 of the Bill.

Appeals from the Controller's decisions

275. The general scheme of the Patents and Designs Act, 1911 is to vest appellate powers over the orders of the Controller in most cases in the Central Government and to constitute the High Court as the forum for entertaining petitions for revocation. There are however a few exceptions to this rule. Thus in the case of orders of the Controller relating to the grant or refusal of compulsory licences under section 22 etc. the appeal will lie to the High Court of Calcutta (*vide* section 23F). Again, original applications for the extension of a term of a patent have to be made to the Central Government, (*vide* section 15) but the Central Government is vested with power to refer these applications in appropriate cases to a High Court [section 15(3)].

276. The orders of the Controller which are now subject to appeal to the Central Government are all matters of judicial determination and it is but appropriate that appeals in these matters should lie to the Courts and not to an executive authority like the Central Government. This can be said of every order of the Controller now subject to appeal without exception [*vide* sections 5(2), 9(3), 10(1A), 16(5) and 17(6)]. In this respect the change made by the Bill is welcome and the assignment of the appellate jurisdiction to the High Court is in line with the provisions in that

regard in other countries like the U.K., the U.S.A., Canada, Australia and New Zealand

Present uncertainty as to High Courts having jurisdiction

277. It has however to be mentioned that the Bill is defective in that it does not take account of the fact that there are a plurality of High Courts in India and specify the particular High Court which would have competence to entertain these appeals. And this problem raised by the existence of a plurality of High Courts is not confined to appeals against the orders of Controller.

278. Section 26 of the Indian Patents and Designs Act, 1911 enacts:

> "26. (1) Revocation of a patent in whole or in part may be obtained on petition to or on a counter claim in a suit for infringement before a High Court."

The High Court is defined in section 2(7) of the Act so as to include all the High Courts in India. It would therefore be apparent that the Act does not particularise any one High Court as having jurisdiction in the matter in relation to any particular patent and that it leaves it open to every High Court in India to entertain these proceedings. The result of this state of affairs can best be summarised by quoting a passage from the judgment of Lort-Williams, J., in In re Hiralal Banjara (I.L.R. 1937-2 Calcutta 230).

> "The position created by the present Act seems to be very inconvenient and likely to raise difficulties such as the one with which I have to deal, because a number of High Courts of equal jurisdiction have jurisdiction to deal with the same patent, that is to say, any patent issued under the provisions of the Indian Patents and Designs Act. The result is that unless some further provision is made by the Legislature it is very likely that there will be conflicting decisions with regard to the same patent by different High Courts."

I would only add that if there has been so far only one reported case in which this sort of difficulty has cropped up it is wholly due to the paucity of litigation in regard to patents in India.

279. It is therefore very essential that the law should specify with certainty the High Court which would have jurisdiction (a) to entertain appeals against the orders of the Controller, (b) to entertain petitions for revocation of patents, (c) to entertain proceedings under Clause 55 of the Bill, the other proceedings in relation to patents being merely subsidiary or ancillary. If these three matters are determined with precision, the others would adjust themselves and present no difficulty.

Parallel provisions in the Trade and Merchandise Marks Act, 1958.

280. In my report on the revision of the law relating to Trade Marks I made three recommendations which are relevant to the present context.

1. The coordination of the activities of the Patent and Trade Marks offices by having a single official designated "Controller-General of Patents, Designs and Trade Marks" to be in overall control of both these forms of Industrial Property Law.

2. The division of the country into zones and the establishment of branch offices of the Trade Marks Office to serve the needs of these areas and determine the marks which shall be registered or shall be deemed to be registered in each of such offices.

3. Linking up the High Courts having territorial jurisdiction over the places where the offices of the Registry are located with all proceedings in relation to marks which are on the register of that particular office in regard to which applications have to be made to a particular office of the Registry.

281. These recommendations have been accepted by Government and have been implemented by the Trade and Merchandise Marks Act, 1958. Any solution therefore of the problem in relation to Patents has to take account of the above facts and should be consistent with the provisions of the other enactment.

Territorial jurisdiction of the offices of the Patent Office and of the High Courts

282. Bearing these in mind I would recommend the following:—

(1) There should be a combined Trade Marks and Patent Office in Bombay, Calcutta, Delhi and Madras where the Trade Marks Offices are now located and the territorial jurisdiction of each of these offices should be the same for the purposes of both these enactments. At each of these offices there would be an officer to deal with Trade Marks and another to deal with patents.

(2) The patents now in force might continue to be on the Calcutta Register for the purpose of all legal proceedings with however an option to the patentee to elect to have his patent transferred to any other zonal office the option however to be exercised within one year or such further period as may be extended by the Controller, from the coming into force of the Act.

(3) Applications for patents by persons residing in or carrying on business in a place in any of these zones would have to be made only to the office in that zone.

Following the analogy of the Trade and Merchandise Marks Act, 1958, in the case of persons who neither reside nor carry on business in India, the address for service set out in the application should determine the zonal office of the Patent Office in which the application would have to be filed. If there is opposition to the grant of a patent, the notice of opposition should be filed in the same office in which the application for patent has been filed, whatever might be the place of business or of residence of the opponent. In order to ensure that the examination of the applications is efficient and to secure uniformity, this should take place at the head office of the Patent Office. The orders passed should however be communicated to the applicant through the zonal office so as to avoid inconvenience to the applicant. If hearings have to take place they should normally be at the zonal office where the application has been filed unless the Controller considers the hearing at some other place more convenient for any special reason. Orders issued in relation to any application should be issued or deemed to be issued only from the zonal office so as to serve as the foundation for the jurisdiction of the High Court to hear appeals from such orders.

(4) The High Court competent to hear appeals from the orders of the Controller would be that High Court which has territorial jurisdiction over the zonal office in which the application for patent has been made or in the case of orders of the Controller in respect of patents already granted in that office in which the patent is registered.

(5) Similarly original petitions for the revocation of patents should be entertainable only by that High Court which has territorial jurisdiction over the place where the zonal office in which the patent is registered is situated.

(6) The proceedings under Clause 55 should be exclusively within the competence of the High Court having territorial jurisdiction over the patent, as defined above. This is necessary because there is provision in that Clause for petitions for revocation being heard as a defence to the claim for compensation.

283. I have dealt with the above matter in Part II of the Report and have suggested the insertion of a new chapter 1A containing the necessary provisions.

Procedure where validity of claims is attacked in infringement suits.

284. The proceedings in relation to patents yet to be considered are: (1) Suits for infringement (clause 58 of the Bill). (2) Suits for a declaration as to non-infringement (clause 57). (3) Suits complaining of groundless threats of infringement proceedings (clause 66).

285. Section 29 of the Indian Patents & Designs Act, 1911, enables a patentee to institute a suit in a District Court having jurisdiction to try the suit against any person who has infringed his right with a proviso that where the defendant counter-claims for revocation the suit along with the counter-claim should stand transferred to the High Court for decision. Clause 58 of the Bill reproduces in substance the above provisions in section 29 of the Act.

286. Section 29 (2) of the Indian Patents and Designs Act, 1911 in common with the law that prevails in several other countries of the world, the U.S.A., the U.K. and the Commonwealth countries, France and Belgium, to mention only a few, enables the defendant to plead the invalidity of the patent as a defence to a suit for infringement. That sub-section runs:

> "(2) Every ground on which a patent may be revoked under section 26 shall be available by way of defence to a suit for infringement."

and this provision has been repeated in clause 58 (4) of the Bill. I agree that this provision is necessary and in the notes on clauses I have suggested its retention in the clause relating to revocation.

287. The existence of this defence raises questions as to the manner in which possible differences between different Courts as to the validity or invalidity of the claims of a patent should be resolved. To make my meaning clear I would add this. A patent might be infringed by more persons than one and if these infringers reside in or carry on business or commit the act of infringement in different areas of the country, the several suits for infringement would have to be filed in District Courts in different States. The defence regarding the invalidity of the patent might be raised in more than one

Court and these Courts might decide differently the point about the validiy of the patent. In the United Kingdom this problem of conflicting decisions does not arise because all suits for infringement have to be filed in the High Court.

288. In the case of Trade Marks where conflicts of decisions of this type also arise, I recommended the procedure of having the suits for infringement in which the validity of the registration of the mark was raised, stayed and requiring the person raising the point of invalidity of the registration to move the competent High Court for the rectification of the Register. I do not think it is necessary to adopt such a procedure in the case of suits for infringement of patents. The number of such suits would be so few that such a complicated procedure is not called for.

289. In its place I would recommend the following. A suit for infringement may be filed in any court not inferior to a District Court which has territorial jurisdiction under the Civil Procedure Code to entertain it. All defences including those based on the invalidity of the patent would be gone into by that Court and by the appellate Courts if appeals were filed. But any finding by the Court that the patent or any claim therein was invalid would not have any effect on the patent as such and would not lead to the revocation of the patent. In other words, the decision in the suit would be merely one inter-partes operating between them by way of *res judicata* and not one in technical phraseology "in rem" affecting the patent itself.

Revocation proceedings only before High Court having jurisdiction

290. If any person interested were desirous of obtaining an adjudication which would, if successful, have an effect on the patent itself and beyond the immediate parties to that proceeding, he should file a petition for revocation of the patent, and the forum for this proceeding would be exclusively the High Court having territorial jurisdiction over the office where the patent is registered. If the petition succeeds, and the patent is held invalid, then subject to the result of any appeal preferred against such a decision, the patent would be revoked and an entry to that effect would be made in the Register of Patents. It is needless to add that where the Court dismisses the petition for revocation, there would be no legal bar against other persons interested in initiating fresh proceedings for revocation, though, save in exceptional circumstances, the chances of such a petition succeeding, particularly since the later proceeding also would be in the same High Court, would be very remote.

"Supplemental Record" for entries of decisions as to validity in infringement suits

291. I have referred to the fact that when a petition for revocation succeeds, appropriate entries would be made in the Register of Patents. It is now necessary to mention what should happen in cases where a Court pronounces against the validity of a patent in a suit for infringement. The decision of the trial court might be taken up in appeal to a High Court, or the suit itself might be tried in a High Court, and it is therefore proper that some record should be made of this finding for the information of other persons interested in the patented invention. I would recommend the opening of a "supplemental record" and entries being made in such record of the result of proceedings, which, though of importance in relation to the validity of a patent grant, do not legally affect the patent itself. The patent may be the subject of sale, or of licensing and it would be of the utmost importance to the prospective purchaser or licensee to be informed of what any court has pronounced regarding the validity or invalidity of the claims in a patent.

Revocation by way of counter-claim in infringement suit

292. The question that remains for consideration is as regards the provision in the Bill regarding counter-claims for revocation in a suit for infringement, which follows the provision to section 29 of the Indian Patents and Designs Act, 1911.

Clause 58(5) runs:

> "(5) A defendant in a suit for infringement of a patent may apply for revocation of the patent by way of counter-claim in the suit:
>
> Provided that where such a counter-claim is made, the suit along with the counter-claim shall be transferred to a High Court for decision."

293. As a patent has effect throughout India, an action for infringement of a patent might possibly be filed in any part of India where the infringement takes place or where the infringer resides or carries on business. From this, it would follow that the High Court to which, in the case of a counter-claim for revocation, the proceeding would stand transferred, if the provision of the Bill in Clause 58 were adopted, may or may not be the High Court which would be competent to entertain a petition for revocation under the scheme of zonal distribution of offices which I have formulated earlier. Of course, this might be got over by providing that the High Court to which the proceedings would stand transferred, should, in the event of a defendant in an infringement action counter-claiming by way of revocation, be the competent High Court as determined by other rules. But I consider this as a very inconvenient course to follow since this would mean that the entire suit for infringement as well as the claim for revocation would be tried in a High Court possibly very far removed from the place where the alleged infringement took place or where the alleged infringer resided or carried on business. It does not need argument to show that having regard to the distances in our country, this would be a very inconvenient state of affairs and would necessitate the issue of commissions for examination of witnesses, a rather unsatisfactory procedure.

294. For these reasons, I would suggest the deletion of this sub-clause. Where a defendant in a suit for infringement desires, in addition to raising a plea regarding the invalidity of the patent alleged to be infringed, to obtain the revocation of the patent, he should file an independent petition to the competent High Court for the latter relief. If the suit for infringement were pending in the same High Court then it may be expected that the two proceedings would be heard and disposed of together even without any specific statutory provision therefor. In other cases, a stay of the infringement suit pending the disposal of the petition for revocation, would be in the discretion of the Court trying that suit, and in regard to this matter also, there is no need for any provision in the Patents Act, the powers contained in the Civil Procedure Code being sufficient to obviate conflicts of decisions.

Provisions for forum regarding appeals and revocation similar to that in Australia

295. The scheme I have formulated of a single High Court being vested with an exclusive jurisdiction to entertain and dispose of (1) appeals from the Controller's orders, and (2) petitions for revocation, while other Courts have jurisdiction to hear and determine suits for infringement and decide defences based on the invalidity of the claims alleged to be infringed, is very similar to that which prevails under the Australian Patents Act, 1952 subject to two exceptions to which I shall advert later.

296. In Australia, as in India, there are a plurality of Courts which have jurisdiction to entertain suits for infringement. The Australian Patents Act, 1952 is a Commonwealth statute, the rights conferred on a patentee by a patent extending over the entire Commonwealth including all the States. The Courts of each of the States of the Commonwealth have jurisdiction to entertain suits for infringement, and the defendants in such suits are, as under Section 29(2) of the Indian Patents and Designs Act, 1911, entitled to raise by way of defence the invalidity of the claims of the patent alleged to be infringed (*vide* Section 105 of the Australian Act, 1952). The problem of avoiding conflicts in decisions regarding the validity of patent claims is nearly the same as in India—I say nearly, because the number of the State Courts are infinitesimally smaller than the number of District Courts in India in which such suits might be filed.

297. The solution adopted in Australia is this:

(1) Appeals from the orders of the Commissioner of Patents lie to the "Appeal Tribunal" and Section 146 of the Act of 1952 designates the High Court of Australia as the "Appeal Tribunal" for the purposes of the Act.

(2) In regard to petitions for revocation, Part XI of the Act constitutes the High Court of Australia as the exclusive forum for entertaining petitions for revocation of patents.

(3) In regard to actions for infringement, Section 113 of the Act enacts. "Jurisdiction is, by this section, conferred on the High Court to hear and determine an action or proceeding for the infringement of a patent, but this section does not deprive another court of jurisdiction which it possesses to hear and determine such an action or proceeding". The reference here is to the common law jurisdiction of the State court and the effect of the section is to continue the jurisdiction of the State Courts to entertain suits for infringement.

298. I referred to two matters in regard to which my proposals constituted a departure from the scheme of the Australian legislation. The first of them is in relation to the provision for a counter-claim in a suit for infringement. Section 116 of the Australian Patents Act, 1952 enacts that when a counter-claim for revocation is made in any suit for infringement pending in a State court, the entire proceedings are automatically transferred to the High Court of Australia for trial and disposal. It would be seen that this is similar to the provision in Section 29 of the Indian Patents and Designs Act, 1911 and Clause 58(5) of the Patents Bill but there is this difference that in Australia, there is only one High Court to which the proceeding would stand transferred while in India, there would be a multiplicity of such courts dependent upon the location of the District Court in which the suit for infringement was instituted. It is in view of this difference that I have suggested the elimination of the provision for a counter-claim—leaving proceedings for revocation to be initiated in the competent High Court by an independent petition.

299. The second matter on which my proposals constitute a variation from the law in Australia is the provision for a supplemental record for entering the findings of courts regarding the invalidity of claims in infringement action. I consider this an improvement which would serve the purposes, I have already mentioned.

Suits for declaration of non-infringement and to restrain groundless threats

300. There remain for consideration two other classes of suits in relation to patents, for which the enactment makes provision (1) suits for declaration as to non-infringement under clause 57 and (2) suits to restrain groundless threat of legal proceedings (Clause 66).

301. Under the Bill, both these kinds of suits are entertainable in any court not inferior to a District Court having territorial jurisdiction to try the suit and I agree that this is proper. The first type of suit poses no problem of conflict of decision as regards the validity of patents, since the validity of a patent cannot be raised in such a suit. In suits under Clause 66, the validity of a patent might be brought in issue and following the analogy of suits for infringement, I would suggest a similar rule. Any decision by the Court as regards validity would have effect only *inter-partes* and the result would be entered in the supplemental record.

302. I would only add that in Australia the State Courts have concurrent jurisdiction with the High Court of Australia, to entertain and decide suits to restrain groundless threats of legal proceedings [*vide* Section 121(4) of the Act of 1952].

303. In the notes on clauses, I have indicated in the relevant clauses the changes to be made to implement the above recommendations. I have, however, not drafted new clauses where these were necessary.

XIII. THE INTERNATIONAL CONVENTION

Patents Enquiry Committee's recommendation

304. The Patents Enquiry Committee recommended in para. 269 of their report the desirability of India joining the International Convention for the Protection of Industrial Property. The reason adduced by the Committee in favour of this suggestion may be set out in their own words:—

> "One of the objects of the Convention is to confer 'priorities' by virtue of which any person who first applies for a patent in any one of the member States on a particular date, would, if his application for a patent in any of the other member states is filed within one year thereafter, be entitled to claim that his patent in the said other States should be dated as of the date of the application made in the State of origin.
>
> Indian inventors who seek to obtain patents in foreign countries are at present handicapped for want of this 'priority'.

Certain other privileges extended to members of the Convention are also denied to Indian applicants for foreign patents. It has, therefore, been suggested that India should join the Convention.

As against this view, there is a feeling in some quarters that India will not gain much by joining the Convention as experience has shown that by joining other International Organisations, she has suffered rather than gained any advantage.

It is quite evident from the Articles of the Convention that Indian inventors, whose number is increasing, will gain substantial advantages, particularly with regard to obtaining 'priorities' for the patents taken out by them in foreign countries. It may be that, for some time to come, the number of Indian Inventors who would derive such advantages in respect of their foreign patents will not be as many as foreign inventors who would secure corresponding advantages in respect of Indian patents granted to them. Even so, we do not consider that this circumstance alone should be decisive as to whether India should join the International Convention."

Membership of the Convention against the interests of under-developed countries

305. Having considered the matter independently, I feel unable to endorse this suggestion. In this connection, I might usefully refer to an article in a recent issue of "La Propriete Industrielle" under the title "The International Protection of Industrial Property and the different stages of Economic Development of the States" where the writer expresses the opinion that the differences between economic and industrial conditions of the member nations of the International Union and those of the backward territories have become so great that the continued existence of the Convention, instead of aiding the development of the backward territories, will retard it. He adds that the changes to which the convention has given rise have tended to make it an instrument in the hands of the economically most powerful countries which formed a sort of closed group determined to defend its monopolies.

306. Though the Articles of the Convention leave a considerable latitude for the operation of municipal laws, they appear to me in so far as the Articles relate to patents for inventions, suited more to the industrially advanced than to the under-developed countries. In making this last observation, I have in mind the recommendations I made regarding the desirability of India joining the International Convention in my report on the Reform of Trade Marks Law (*vide* paras. 86 & 87). When I made that recommendation, my attention was confined to the position as regards the law relating to Trade Marks and to unfair trade competition and I did not have the opportunity to consider the question from the point of patents which I have now had.

307. Apart from any theoretical or ideological preference for or against the Convention, I would point out two matters which have a vital bearing on any decision on this matter. The first is that some of the recommendations which I have made and which I consider

essential to achieve the adequate working of inventions in the country are not in accordance with the Convention. For instance, I have recommended that patents which are not adequately worked within two years after they are compulsorily endorsed with the words "licences of right" might be revoked on application to the Controller. Again, I have recommended that patents for articles of food, medicine etc.; might be revoked on application to the Controller if within four years from the date of their grant, they are not worked within the country adequately to satisfy the demand for the products within the country. These two provisions might contravene Article 5A (3) of the Convention which runs:

> "(3) Revocation of the patent shall not be provided for except in cases where the granting of compulsory licences would not have been sufficient to prevent such abuses. No proceeding for the cancellation or revocation of a patent may be instituted before the expiration of two years from the granting of the first compulsory licence."

Joining the Convention not recommended: Multi-lateral treaties for reciprocal arrangements preferred

308. The second matter I would like to refer is this. Under Section 78A of the Indian Patents and Designs Act, 1911 India can enter into conventions and arrangements only with the United Kingdom and its Dominions so that at present without any amendment of the law, we are unable to offer priority to applicants of other countries and naturally that is an impediment in the way of other countries offering priority rights to our nationals. In the redraft of this provision in the Patents Bill which I have accepted, convention arrangement might be entered into with any country and on the ratification of such arrangement, priority is conferred by the Act on the applicant of that convention country. The patent laws of almost every country in the world enable it to enter into treaty arrangements with other countries so as to confer on applicants from such country priority rights. Already some foreign countries have expressed their desire to enter into arrangements with India for the grant of priority rights in respect of patents on a reciprocal basis. In passing it may be observed that remembering that nearly 90 per cent. of the patents on the Indian register belong to foreigners, it is the other countries that would be keenly desirous of securing priority rights in India. If, therefore, the securing of priority rights for Indian inventors were the sole object to be gained by joining the convention, the same may be achieved by entering into treaty arrangements on reciprocal grant of priorities and this would not entail the need for altering our laws so as to secure conformity to the requirements of the Articles of the Convention.

309. For those reasons, I would recommend that for the present India need not join the International Convention.

XIV. PATENT AGENTS

No provisions for registration of Patent Agents under the present Indian Act.

310. The Indian Patents and Designs Act, 1911 does not contain any special provisions for controlling the profession of Patent Agents. It is open to any person to advertise himself as a Pate

Agent and to offer to draft patent specifications and undertake other work in connection with the obtaining of the patent even though such person has no technical qualification. There are no doubt a few Patent Agents who are persons of skill and quality. But as every person is at liberty to act as a Patent Agent, the consequence has been that grossly incompetent and even fraudulent persons have often acted as Patent Agents with great loss and injury to unwary inventors who employed them. I have heard of complaints with regard to the unscrupulous dealings by self-styled Patent Agents who have encouraged persons to apply for patents for worthless claims or who in drafting specifications of the claims had made serious mistakes. It is, therefore, desirable that as in other countries Patent Agents should be properly qualified to do their work, a work which involves great skill and responsibility and that such persons should have their names entered in a roll.

Herschell Committee's report (1888) in the U.K.

311. The situation in India described above appears to me to approximate to that which prevailed in the United Kingdom before provisions as regards Patent Agents were for the first time introduced into the Patents, Designs and Trade Marks Act, 1883 by an amendment effected by an Act of 1888. A Committee presided over by Lord Herschell, the Lord Chancellor, was constituted to enquire, *inter alia*, into the question of the proper statutory provision as regards Patent Agents, and it was as a result and in implementation of the recommendations of this Committee that the Act of 1888 was enacted. The Committee observed in their report:

> "Strong representations have been made to us in favour of the creation of a roll of patent agents. It is said that there are persons calling themselves patent agents who possess neither the requisite knowledge or integrity, and that occasionally inventors who are poor, and not highly educated, suffer seriously in consequence. Some witnesses urged that if a roll of duly qualified agents were created, the Patent Office should be permitted to deal only either with the inventor himself or with an agent on the roll. We cannot recommend such a regulation and we think it would be undesirable to put the right of communicating with the Patent Office in the hands of any body of men, or to create a monopoly in respect thereof. The matters upon which the office has to communicate with inventors are sometimes of a character quite untechnical, and it would be a hard measure to prevent an inventor in the provinces from transacting his business with the office in such cases through the agency of a friend residing in London. And we do not see our way to distinguish in an enactment between cases of this nature and those requiring technical knowledge, even if we thought it desirable to create a monopoly in favour of agents on the roll.
>
> We think, however, that it would be of public advantage to provide a means of securing a roll of patent agents consisting of duly qualified persons, the admission to which should be possible and easy for all persons so qualified. With this object we would suggest that steps should be taken with a view to fixing a standard of qualification for the title of patent agent. And it might perhaps be well to enact that any person should be subject to a penalty who without being on the roll assumed the title of patent agent either by advertisement or by description on his place of business or on any documents issued by him" (page vii of the Report).

Statutory provision for registration of Patent Agents recommended

312. The situation in India being the same I consider that the remedy and the form suggested by the Herschell Committee may with advantage be adopted and I accordingly recommend the same subject to a few modifications in detail to which I shall advert presently.

313. The right to use the appellation of Patent Agent and right to hold oneself out as a Patent Agent and practise the profession as such should be confined to those whose names appear on the Register of Patent Agents and the use of such name, the holding out or practising as such without being on the roll should be penalised.

History of the U.K. statutory provisions as to Patent Agents

314. In England the custody of the Patent Register and the conduct of the qualifying examination for eligibility to be registered in the Register were entrusted to the Institute of Patent Agents, which in 1891, became the Chartered Institute of Patent Agents. Under the U.K. Act 1907 the Comptroller was given power to refuse recognition not only to agents whose names had been struck off the roll for any professional misconduct but also to those persons who had not been duly registered. Under the 1919 Act, the practice of Patent Agency was closed to unregistered firms or companies, but a provision was made whereby any British subject who proved to the satisfaction of the Board of Trade that prior to 1st August 1919, he had been *bona fide* practising as Patent Agent either on his own account, or as a member of a firm, or as a Manager or Director of an incorporated company, could be entitled to be registered, if he made application for that purpose within a period fixed by the Board of Trade, unless the Board of Trade were satisfied that he had while so practising been guilty of misconduct.

Controller to be in charge of the Register of Patent Agents: Who may be registered as Patent Agents.

315. In India there is no recognised organisation or Institute of Patent Agents corresponding to the Chartered Institute of Patent Agents in the U.K. I would accordingly suggest that the custody of the proposed Register of Patent Agents and the conduct of the qualifying examination should be entrusted for the present to the Controller of Patents and Designs. The enactment may provide for the registration of the following classes of persons as Registered Patent Agents if they apply for registration to the Controller in the prescribed manner.

(1) Any Advocate, Solicitor or Attorney on the rolls of any High Court who holds a degree of a recognised University in Physical Science or Engineering or equivalent scientific or technical qualification to the satisfaction of the Controller.

(2) Any person who is a graduate in Science or Engineering of a recognised University or who possesses equivalent scientific or technical qualification to the satisfaction of the Controller and who has passed the qualifying examination prescribed for registering as a Patent Agent under the Rules. As regards the qualifying examination, the rules may prescribe the syllabus for this examination, which might be conducted by the Central Government. The candidate should be examined in Patent Law and practice in addition to technical subjects somewhat in line—but having regard to the conditions in India not of such high standard—with the qualifying examination conducted by the Chartered Institute of Patent Agents in London. Graduates in law, science or engineering might be permitted to sit for the qualifying examination. If the above system is followed, we will have a set of registered Patent Agents who as a body might be expected to be fairly competent for the purpose of drafting specifications and conducting proceedings under the Act before the Controller.

(3) Any person who has a degree in science or engineering of a recognised university or who possesses equivalent scientific and technical qualification to the satisfaction of the Controller and who had worked as Examiner of Patents at the Patent Office for a minimum period of five years provided that no officer of the Patent Office who has held a post involving duties as a hearing officer for more than twelve months shall be qualified to be registered or to practise as a patent agent, and

(4) Any person who has been describing himself and *bona fide* practising as a Patent Agent for at least 5 years before the 1st of January 1960*, provided that he satisfies the Controller that he had drafted and filed at the Indian Patent Office at least 30 complete specifications during the five years preceding the commencement of the Act and at least five complete specifications during every year in that period, and provided he made an application for registration as patent agent within a year from the date of coming into force of the new Act.

Aliens not to be registered as Patent Agents

316. The statute should provide in express terms that only a person who is the citizen of India shall be eligible for registration as a Patent Agent. It may be mentioned in this connection that in the U.K., Canada, Australia and most other countries, an alien is not allowed to practise as a Patent Agent—see Section 88(6) of the U.K. Patents Act, 1949 and Rule 10(3) of the U.K. Register of Patents Agents Rule, 1950. Such a provision is necessary particularly as Government might pass secrecy directions for security reasons in respect of some of the applications for patents and such applications should not be allowed to be handled by alien Patent Agents. In any event, competent technically and scientifically qualified Indian citizens are available for the work and they should be encouraged to take up this profession which is quite remunerative. As a few foreign nationals have already set up lucrative practice in this country, the rules may provide that those persons who have been practising continuously for five years before the 1st January 1960* in the manner stated earlier, may be exempted from the rule

*It is expected that this Report will be published by 1-1-1960 and hence this date.

as to nationality but this would be no ground to permit new aliens into this profession.

Registration of Companies and firms as Patent Agents

317. Section 88 of the U.K. Act, 1949 provides for incorporated companies being registered as Patent Agents subject to certain conditions. I do not consider a similar provision necessary or useful in this country. The right to be registered as a Patent Agent should be confined to individuals. A firm of registered Patent Agents may, however, be permitted to practise under a firm name, provided however, every one of the partners of the firm is registered as a Patent Agent in the prescribed manner; unless this requirement is complied with, the firm as such should not be allowed to practise as Patent Agents.

Rights of Registered Patent Agents: formation of closed profession not recommended.

318. I shall now deal with the rights of Patent Agents and the degree of monopoly, they should enjoy. In considering this matter, it is necessary to keep in mind the nature or types of professional work in connection with patent applications and patents generally. The work in relation to applications for patents and the further procedure relating thereto may be classified under three heads: (1) drafting of the patent specification and (2) other matters which involve acting and appearance before the Controller including appearance at hearings in respect of applications for patents, opposition proceedings, application for compulsory licences etc. and (3) proceedings before the Court.

319. For work falling within the first category those engaged in the task should necessarily possess sufficient technical and scientific qualifications. For the second type of work, *viz.* appearance in proceedings before the Controller, though the possession of technical or scientific knowledge would be a great advantage, forensic ability is necessary, so that I do not see any harm in permitting, besides those who are permitted to do work of the first type, legal practitioners, *i.e.* those entitled to act or to plead before the High Courts. This class would include Advocates, Solicitors and Attorneys, on the roll of any High Court in India. Regarding proceedings before Courts, these would be before the High Courts having jurisdiction over the appropriate office of the Registry. These proceedings might be of three classes—(a) appeals against the orders of the Controller; (b) petitions for revocation under Clause 37; and (c) applications for determination of compensation under Clause 55.

Persons entitled to draft specifications

320. Taking up each of these types of work in that order, I would recommend that as regards the drafting of specifications, this should be a monopoly of Registered Patent Agents, subject only to one exception, *viz.* that the inventor might draft it himself or get it done by any person duly authorised by him. Taking into account the fact that there are just a few qualified Patent Agents in India, I would recommend that there should be no closed shop and that though the holding out by a person as a Patent Agent when he is not a Registered Patent Agent should be penalised, there should be no bar on an inventor seeking the assistance of a friend to draft his

specification. I might point out that in the corresponding provision of the Trade and Merchandise Marks Act, 1958, persons in the sole and regular employment of the applicant for registration are among those permitted to act and appear before the Registrar for their principals. In the case of inventions for which applications for patents are made by an individual, firm or corporation, it is possible that their technical staff might be much better acquainted with the technicalities involved in the invention and might be able to appreciate and put forward the salient points of the invention better than even a Patent Agent. The Act should not prohibit the inventor himself or an applicant for the patent from drafting his specification. There should be no objection, either, to allow an individual, firm or corporation to permit his or their technical expert, even though not a registered Patent Agent, to draft his or their specification and act on his or their behalf. There is no need in such cases to compel the individual, firm or corporation to resort to Patent Agents for filing their applications. But such technical experts who may be employed by an individual, firm or corporation to draft his or their specifications will not be allowed to practise or describe themselves or hold themselves out as Patent Agents in India or elsewhere unless registered in the prescribed manner.

Requirement as to scientific qualification for membership based on the Australian statute

321. In making the recommendation that a mere legal practitioner, Advocate, Solicitor or Attorney of any High Court should not be permitted to draft and file specifications as a part of his professional work, I am following the precedent in Australia, where such an exclusion of a legal practitioner as such occurs.

322. Section 137 of the Australian Patents Act, 1952 enacts:

> "137. Legal Practitioners not to prepare specifications etc.—A legal practitioner shall not prepare a specification or a document relating to an amendment of a specification other than a document relating to an amendment directed under section eightysix of this Act—
>
> (a) unless, within one year after the commencement of this Act, he has satisfied the Commissioner that, at any time before the first day of January, One thousand nine hundred and fiftytwo, he had practised as a patent attorney; or
>
> (b) unless he is acting under the instructions of a patent attorney or of a legal practitioner who has satisfied the Commissioner as provided by the last preceding paragraph.
>
> Penalty: One hundred pounds."

Appearance before Controller and the doing of other acts besides drafting specification.

323. Appearances before the Controller and the doing of any act in the Patent Office other than drafting specifications, may be open to all legal practitioners, i.e. Advocates, Solicitors, Attorneys on the rolls of any High Court, and of course to all registered Patent Agents.

Acting and appearance before courts

324. No specific provisions are necessary in the Act as regards the right to act and plead in respect of proceedings under the Patents Act before the High Court. The matter would be governed by the law regulating the right of legal practitioners before such courts. It is only necessary to add that a registered Patent Agent might not be entitled to act or appear in any Civil Court, merely by virtue of his name being on the roll of registered Patent Agents.

Removal from the register

325. The rules should provide for the suspension or removal of the names of the Patent Agents from the register of Patent Agents on the ground of professional misconduct. The Controller before whom the Patent Agent appears might be empowered to bring to the notice of the Central Government any misconduct on the part of the Agent and the Central Government might be vested with power to pass appropriate orders in case of proved misconduct after giving the Agent an opportunity to be heard.

I have up to now set out in broad outline my recommendations for the improvements of the Patent system and I shall proceed to discuss the several clauses of the Patents Bill of 1953 and the details of the changes I would recommend as regards these provisions.

PART II

NOTES ON CLAUSES

PART II

NOTES ON THE CLAUSES OF THE PATENTS BILL, 1953

Clause 2—Definitions.

326. I would suggest a few changes in the expressions defined in Clause 2 both by way of omission as well as addition.

(a) "Advocate-General"—I have suggested the omission of the reference to Advocate-General in Clause 38—the only clause where it occurs in the Bill—and if this recommendation is adopted, the definition might be deleted. Even otherwise, it appears to be unnecessary.

(c) Section 4(1) of the Trade and Merchandise Marks Act, 1958 enacts that "the Central Government may by notification in the Official Gazette appoint a person to be known as the Controller-General of Patents, Designs and Trade Marks, who shall be the Registrar for the purposes of this Act and the Controller of Patents and Designs for the purposes of the Indian Patents and Designs Act, 1911." The Government have already appointed an officer with the designation of the Controller-General of Patents, Designs and Trade Marks under Section 4(1). In view of this, there could not be a further appointment to the same office under Section 5 of the Patents Act. The proper method of co-ordinating the provisions of the Trade and Merchandise Marks Act, 1958 and those in this Act would be to define the expression "Controller" as follows:—

"Controller" means the "Controller-General of Patents, Designs and Trade Marks".

(d) and (e) may stand.

(ee) After clause (e) I would suggest the addition of a definition of the expression "Government undertaking" which I have used in my redraft of clauses 37, 41 and 53 to 55—This might run:—

"'Government undertaking' includes any industrial undertaking carried on by a Government department or by a Corporation owned or controlled by the Central or a State Government".

(f) In place of the definition of the words 'High Court' which appears in the Bill, I would suggest a definition on the same lines as is found in section 2 of the Trade and Merchandise Marks Act, 1958. The reasons for this definition would be apparent from the discussion relating to the need for a new chapter following clause 3 of the Bill.

(g) might be omitted since the Indian Patents and Designs Act, 1911 has already been extended to the State of Jammu and Kashmir.

(h) "Invention"—The definition of "invention" is contained in sub-clauses (h) and (j). I have already discussed the advisability of deleting the extended definition of "invention" suggested by the Patents Enquiry Committee so as to include "a method or process of testing applicable to the improvement or control of manufacture" (See paragraph 52 *ante*).

This apart, in place of the present definition, I would suggest one, which I consider, taken in conjunction with a redraft of Clause 3 of the Bill, more accurately represents the existing case law in the U.K. and in U.S.A. regarding the meaning of "invention". I would add that my draft is based upon the language used in the Canadian and U.S.A. Patents Acts and the decisions on this topic. The following definition might replace sub-clauses (h) and (j):—

"Invention" means, any new and useful art, process, method or manner of manufacture,

machine, apparatus or other article, or

substance produced by manufacture; and includes any new and useful improvement of any of them.

(ii) Legal Practitioner.—The expression "Legal Practitioner" is used in the chapter relating to Patent Agents. If not specifically defined for the purposes of this Act, the expression is apt to refer to all categories of legal practitioners including several classes of pleaders, as well as muktyars and revenue agents. Having regard to the nature of the qualifications requisite for a Patent Agent as well as the qualifications which a person who appears before the Controller in proceedings under this Act ought to possess, I consider it desirable to restrict the right to legal practitioners entitled to act or to plead in a High Court. The definition might run:—

"Legal Practitioner" does not include a person not entitled to act or plead in any High Court.

(j)—may be omitted.

(l)—In place of sub-clause (l) I would suggest the following:—

"'Patented article' and 'Patented process' mean respectively an article or process in respect of which a patent is in force".

(n) "Patent Agent"—In view of my recommendations that the Controller should maintain a register of Patent Agents, I would suggest the following definition to accord with this recommendation:—

"'Patent Agent' means a person for the time being registered in the prescribed manner as a Patent Agent".

(p) "Patent Office"—the reference here should be to section 5 and not to section 4 in view of the redraft I am recommending.

(pp) Sometimes a doubt has been expressed whether the expression "person" would include "Government" and the U.K. Act of 1949 proceeds on the assumption that it does. I would prefer controversy being avoided by the definition of the expression "person" to include Government. Of course, to qualify for being counted a "person interested"—where the Government is not specially named, it should have "interest" as other individuals.

Again the expression "person interested" is used in several clauses of the Bill (*vide* for example, Clause 21 as redrafted). In the U.K. the expression has received rather a limited construction as confined to those having a present trade or manufacturing interest. This might not be sufficient to include persons engaged in research. To put the matter beyond doubt, I would suggest the insertion of a definition reading—

(pp) "Person includes the Government, and 'Person interested' includes, a person engaged in research or a body or organisation engaged in promoting research, in the same field to which the invention relates".

(q) "Prescribed"—The definition in the Trade and Merchandise Marks Act, 1958 of the expression "prescribed" is more comprehensive and I would suggest the adoption of that form. This runs:—

"'Prescribed' means, in relation to proceedings before a High Court, prescribed by rules made by the High Court, and in other cases, prescribed by rules made under this Act".

In addition I would add a definition of the expression "prescribed manner". The expression "prescribed manner" is used in several clauses of the Bill in conjunction with the expression "accompanied by the prescribed fee". The definition of the expression "prescribed manner" so as to include the requirement of the payment of the prescribed fee, would obviate the need for reference to the "prescribed fee" in each clause. I would therefore suggest the following definition of the expression "prescribed manner":—

"(qq) 'prescribed manner' includes the payment of the prescribed fee".

In addition I would suggest

(1) the addition of the definition of the term "Register" as in the Trade and Merchandise Marks Act, 1958—

"(rr) 'Register' means the Register of Patents referred to in section 67",

and (2) a provision, in relation to the Controller, on the lines of section 2(2)(d) of the Trade and Merchandise Marks Act, 1958, which runs—

"In this Act, unless the context otherwise requires, any reference to the Registrar shall be construed as

including a reference to any officer when discharging the functions of the Registrar in pursuance of sub-section (2) of section 4".

(5) In the definition, "true and first inventor" is defined as including the first importer of the invention and the first communicatee from abroad. I have already discussed (*vide* paragraphs 116—123 *ante*) the reasons why the definition should exclude these two categories of persons. If the expression "true and first inventor" were used for the first time in the Indian statutes the omission of the extended definition would be sufficient to achieve the purpose. In view, however, of the meaning which that expression has borne in the Indian Patents & Designs Act, 1911, I consider that it would be preferable to have a specific definition excluding these two categories of "inventors". The definition might then read:

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

Clause 3—What is not patentable

327. I would suggest a revision of the terms of clause 3 first, by an exhaustive enumeration of claims which are not patentable and secondly, by making a change in the matter contained in sub-clause (d) in relation to "sustances produced by chemical processes or intended for food or medicine".

328. I would redraft the clause as follows:—

"3. What is not patentable.—The following shall not be patentable under this Act and shall be deemed always not to have been patentable:—

(1) (a) An invention which is frivolous or claims anything obviously contrary to well established natural laws.

(b) An invention the use of which would be contrary to law or morality or injurious to public health.

(c) The mere discovery of a scientific principle or the formulation of an abstract theory.

(d) Methods of agriculture or horticulture.

(e) Processes for medicinal, surgical, curative, prophylactic and other treatment of man and processes for similar treatment of animals or plants to render them free of disease or to increase their economic value or that of their products.

(f) A claim to a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance.

(g) A mere discovery of any new property or new use for a known substance, or of the mere new use of a known process, machine or apparatus.

(h) A mere arrangement or rearrangement or duplication of known devices each working in an old or well-known way.

(2) No patent shall after the commencement of this Act be granted in respect of inventions claiming—(a) substances intended for or are capable of being used as food or beverage or as medicine (for men or animals) including sera, vaccines, antibiotics and biological preparations, insecticide, germicide or fungicide, and (b) substances produced by chemical processes including alloys but excluding glass.

(3) Notwithstanding anything in sub-section (2) inventions of chemical processes for the manufacture or production of the substances mentioned in that sub-section shall be patentable."

329. I have rearranged and redrafted the matter contained in paragraphs (a), (b) and (c) of the Bill. In addition I have included the several types of inventions or alleged inventions which are universally or almost universally not patentable. I consider that if a statute proceeds to define what is not patentable, it is much more satisfactory that it should be as exhaustive as possible in respect of that matter rather than that some portion of it should be left to be dealt with on the basis of the case law on the subject, particularly in view of the non-availability in India of reports of cases dealing with this branch of law. The form I have adopted would leave not much room for doubt or ambiguity and would make the administration of the Act easier.

330. Most of the categories of inventions set out in sub-clause (1) are almost universally not patentable and I would include in this class those in paragraphs (a), (b), (c), (g) and (h) of sub-clause (1).

331. Para (d).—Patents for inventions in the field of plant propagation by asexual methods [which would fall under para. (d)] are specifically permitted by the Patents Acts of the U.S.A. and of South Africa, but not in any other country. They have never been granted in India and the enactment of para (d) will remove any doubt that might exist as regards the patentability of such inventions.

332. As regards para (e) inventions of medicinal or surgical treatment of man are universally not patentable. Similarly curative processes for the treatment of plants or animals have been held not to be "a manner of new manufacture" and therefore not patentable in the U.K. (*vide* Rau's application, 52 RPC 362—production of lupin seeds of high oil content); in the matter of American Chemical Paint Coy's Application, 1958 RPC 47 (treatment of cotton plants). In the matter of an application by the Canterbury Agricultural College 1958 RPC 85 (treatment of sheep for increasing the wool yield). It appears therefore that this type of invention is unpatentable in India also under the Indian Patents and Designs Act, 1911 when the statute uses the same words "manner of new manufacture". To avoid doubt and clarify the law, I have included the inventions specified in paragraphs (d) and (e) in the first sub-clause—which has retrospective effect.

333. A provision on the lines of paragraph (f) is to be found in the patent laws of several countries. The substance of it was enacted in the U.K. in 1932 in the U.K. Patents and Designs Amendment Act of that year [*vide* proviso to Section 38A(1)]. There however it was confined to inventions relating to substances "*intended* for food or medicine" and the provision was continued in a slightly extended form by section 10(1)(c) of the U.K. Patents Act of 1949 under which it applied to substances "*capable of being used* as food or medicine". I have however removed the restriction in the scope of the prohibition to substances "capable of being used for food or medicine" because logically no differentiation can be maintained between them and other substances produced by admixture merely. The language of section 10(1)(c) of the U.K. Act of 1949 has been the subject of severe criticism by Blanco White (*vide* "Patents for Inventions" page 153) and I have tried to adopt a phraseology which might avoid these comments. The result of the unpatentability of process claims for effecting admixtures would in effect mean that only processes involving chemical reactions would be patentable taking the provisions of this paragraph in conjunction with sub-clause (3).

334. So far as sub-clause (2) is concerned I have in paragraphs 54 to 102 *ante* discussed the question involved in this recommendation in full and I have recommended that the adoption of a provision on the lines of section 38-A of the U.K. Act, 1907 to 1946 would not be in the interests of the country. I have there suggested that in regard to inventions relating to substances produced by chemical processes and also articles which are used as food or medicine etc., no patent should be granted for the product as such but the patent grant should be restricted to claims for the processes by which the product is produced. Sub-clause (2) of my draft gives effect to this recommendation. In passing I might make reference to two matters:

(1) In substance this provision is in line with the provision of the Swiss Patents Act of 1954 and I have already referred to the several other countries in which similar restrictions on patents are to be found.

(2) The second point is that I have included "alloys" as chemical products to which the restricted rule as to patentability should apply while excluding glass from that rule. I have already discussed the reasons for this provision and it is unnecessary to repeat them.

New Chapter-IA

335. A new chapter numbered "1A" might be inserted after clause 3 which may contain the necessary provisions for (1) the determination of the appropriate zonal office, and (2) the competent High Court.

336. The territorial jurisdiction of the zonal offices to entertain applications for the grant of patents would have to be defined. In the Trade and Merchandise Marks Act, 1958 and the rules, elaborate provisions have been made for the determination of the appropriate office of the Trade Marks Registry in regard to existing marks. I do not think that this elaboration is needed in the case of patents. In regard to existing patents, they might be all treated as having been registered in the office at Calcutta where they are now registered with an option, however, given to the patentees to have their patents transferred to any other office of the Patent office. This option might be permitted to be exercised within a reasonable time after the coming into force of this Act, say, within one year or within such extended period as the Controller may allow. Until the option is exercised, the appropriate office might be Calcutta but thereafter it would be the office chosen by the patentee for the time being.

337. Pending applications might be dealt with on the same basis as applications filed after the commencement of the Act. In the case of non-resident foreigners, the address for service in India set out in the applications might determine the appropriate office where the application for the patent could be entertained and proceeded with. In regard to applications from persons resident in India, their places of residence might determine the appropriate office of the Patent Office for the above purpose.

338. As in the Trade and Merchandise Marks Act, 1958 there will have to be a definition of 'High Court' so as to link up the appropriate office of the Patent Office with the particular High Court which would have jurisdiction in respect of patents registered or deemed to be registered in that office.

339. As has already been stated, the exclusive jurisdiction of the High Courts as defined would be confined to

(a) deciding appeals from the orders, decisions and directions of the Controller,

(b) entertaining petitions for the revocation of patents, or

(c) proceedings for the rectification of the register,

(d) determination of compensation etc. under clause 55.

Other legal proceedings concerning patents such as suits for infringement (Clause 58), for declaration of non-infringement (Clause 57) or to restrain groundless threats under Clause 66 might all be disposed of by courts not inferior to a District Court having territorial jurisdiction to entertain them under the provisions of the Code of Civil Procedure.

Clauses 4 and 5—Patent Office and its branches and Controller and other officers

340. In dealing with the definition of "Controller" in clause 2(c), I have pointed out the necessity for linking up the provisions of the Trade and Merchandise Marks Act with those of the Patents and Designs Act. As the law relating to patents and that relating to Designs would be covered by different pieces of legislation, it would be necessary to alter the last two lines of section 4(1) of the Trade and Merchandise Marks Act, 1958 to read—

"** and the Controller of Patents for the purposes of the Patents Act, 19 , and the Registrar of Designs for the purposes of the Designs Act, 19 ."

341. In view of the provisions already made in Section 4(1) of the Trade and Merchandise Marks Act for the vesting in the Central Government power to appoint a person as the Controller-General of Patents, Designs and Trade Marks, it is not necessary

to have the provision empowering the appointment of this officer duplicated in Clause 5. I would further suggest a rearrangement of the provisions in Clauses 4 and 5 of the Bill so as to secure uniformity with the corresponding sections of the Trade and Merchandise Marks Act, 1958. The following will achieve this purpose. The clauses might run thus:—

"4 **Controller and other officers.**—(1) The Controller-General of Patents, Designs and Trade Marks appointed under Section 4(1) of the Trade and Merchandise Marks Act, 1958 (Act 43 of 1958) shall, for the purposes of this Act, be the Controller of Patents.

(2) The Central Government may appoint so many examiners and other officers with such designations as it thinks fit for the purpose of discharging under the superintendence and direction of the Controller such functions of the Controller under this Act as it may from time to time authorise them to discharge."

"5. **Patent Office and its branches.**—(1) For the purpose of this Act there shall be established an office which shall be known as the Patent Office.

(2) The Head Office of the Patent Office shall be at such place as the Central Government may specify and for purposes of facilitating the registration of patents, there may be established at such other places as the Central Government may think fit, branch offices of the Patent Office.

(3) The Central Government may, by notification in the Official Gazette, define the territorial limits within which such Head Office or branch office of the Patent Office may exercise its functions.

(4) There shall be a seal of the Patent Office."

Clause 6—**Persons entitled to apply for a patent**

342. The language of the three sub-clauses is taken from section 1(1) (a) and (b) and section 1(3) of the U.K. Act of 1949. The U.K. section embodies the recommendation of the Swan Committee who suggested that an assignee might be rendered eligible to apply for a patent and prosecute a patent application. Clause 6 is comprehensive covering every case of assignment and devolution and might therefore stand.

343. I need hardly add that in view of the altered definition of the expression, "true and first inventor" in Clause 2(8), a person who is the first importer or a communicatee of the invention in India, would not be entitled to apply as a "true and first inventor" under Clause 6(a).

Clause 7—Form of Application

344. Sub-Clause (1).—In view of the provisions relating to the territorial jurisdiction of the head office and branch offices of the Patent Office and to co-ordinate this with the provision as to the 'High Courts' it would be necessary to make appropriate changes in Clause 7(1).

345. Section 35 of the Australian Statute, corresponding to Clause 7, requires that every application shall be for one invention only. There is no doubt that this is also the intention of the Bill which is sought to be achieved by the provision in Clause 9(4) which prescribes the contents of a claim of a complete specification. I, however, consider it desirable to restate in Clause 7 itself that an application for a patent shall be for one invention only. If these changes are effected sub-clause (1) might run:—

"7. **Form of Application.**—(1) Every application for a patent shall be for one invention only. It shall be made in the prescribed form and shall be filed at the appropriate office of the Patent Office."

346. **Sub-clause (2).**—This corresponds in general to Section 2(2) of the U.K. Act of 1949 except that Clause 7(2)(b) enables the original deed of assignment to be filed as an alternate to the filing of the consent of "the true and first inventor". The object of requiring the consent of the true and first inventor is to safeguard his interests and ensure that no application is made in fraud of his rights. On the other hand the purpose of calling on the applicant to file the original deed under which he claims his right to apply is that evidence might be available to the Controller for deciding the right of the applicant to file the application. As the objects of these two requirements are different, there is incongruity in making them alternative conditions as has been done by this sub-clause.

347. Further, the filing of the original deed under which the assignee claims might not furnish all the information necessary to enable the Controller to accept the title of every assignee-applicant. In the first place, the definition of "assignee" is comprehensive to include the legal representative of a deceased person, and hence probate or letter of administration might be needed in some cases (*vide* Rule 10 of the U.K. Patent Rules, 1949). Secondly, the title of the applicant from the inventor might be traceable to more than one deed, and the sub-clause as drafted is defective in that it requires the applicant to file only the last deed under which his title vests.

348. The applicant would no doubt have to establish his title to make the application and for this purpose it is sufficient to require him to file an affidavit setting out how he traces his title to the invention. The rules might make provision for the particular evidence which he must produce to prove his case.

349. I would suggest that clause 7(2) might run:—

"Where the application is made by virtue of an assignment of the right to apply for a patent for the invention, there shall be furnished with the application or within such period as may be prescribed after the filing of the application—

(a) an affidavit by the person claiming to be the true and first inventor or his legal representative, stating that he assents to the making of the application; and

(b) an affidavit signed by the applicant setting out the facts relied on to support the application."

The statutory 'declaration' under the U.K. Act is analogous to an affidavit under Indian law (*vide* Rule 141 of U.K. Patent Rules,

1949), and hence I have substituted the word 'affidavit' for 'declaration' which occurs in the Bill.

The reference to the payment of the prescribed fee in Clause 7(4) (b) might be omitted in view of the definition of the expression "prescribed manner".

Clause 7A—Information and undertakings regarding foreign applications

350. In addition to the documents set out in Clause 7(2) it would be useful to require the applicant to furnish the following further information. The majority of the applicants for patents in India are foreign nationals and in several cases the application in India is for the same or substantially the same invention as that for which an application for patent has already been made by them in other countries. It would be of advantage therefore if the applicant is required to state whether he has made any application for a patent for the same or substantially the same invention as in India in any foreign country or countries, the objections, if any, raised by the Patent Offices of such countries on the ground of want of novelty or unpatentability or otherwise and the amendments directed to be made or actually made to the specification or claims in the foreign country or countries upto the date of acceptance of the application. This matter acquires added importance by reason of the change which I have suggested in the content of the publications which should constitute anticipation to deprive an invention of novelty. As publication abroad before the relevant date would also constitute anticipation, this information would be of great use for a proper examination of the application.

351. I would further suggest a provision for ensuring that the applicant keeps the Controller informed of any further foreign applications made and of the orders made on such applications after the date of the Indian application. Naturally this would have to be in the form of an undertaking to be filed by the applicant.

352. A provision of this sort is not at all unusual. Somewhat similar obligations are laid on applicants for patents in Canada by Rule 39 of the Canadian Patent Rules. Besides, at the recent Commonwealth Conference on Patents and Trade Marks at Canberra the following resolution was passed unanimously:—

> "This Conference recommends to those countries of the Commonwealth which undertake novelty search under statutory provision that they should provide in their legislation measures whereby applicants may be required to furnish the result of searches in other Patent Offices."

353. Clause 7-A might run:—

> "7-A.—Information and Undertakings regarding foreign applications.—Every applicant for a patent shall along with his application file—
>
> (1) (a) a statement setting out the name of the country, the serial number and date of filing of all applications for a patent for the same or substantially the same invention as disclosed by the provisional or complete specification as the case may be, filed under this Act, made in any country outside India, by either the applicant or to his knowledge by some person through whom he claims or by some person deriving title from him;
>
> (b) an undertaking that he would up to the date of the acceptance of his complete specification, filed in India, communicate to the Controller similar details of every foreign application and subsequent to those if any set out in the statement in the previous sub-clause within 6 weeks of his being apprised thereof;
>
> (2) (a) a statement setting out the details of all objections taken and orders passed on the ground of the invention lacking novelty or patentability and any amendments effected to the specifications and claims in such foreign countries in regard to the applications set out in (a) and (b) of sub-section (1);
>
> (b) an undertaking that he would up to the date of the acceptance of the complete specification, communicate to the Controller details of all objections taken, orders passed on the ground of the invention lacking novelty or patentability and the amendments effected to the specifications or claims and made subsequent to that statement specified in sub-section (1) within 6 weeks of his being apprised thereof."

354. In my draft of Clause 7-A. I have referred to the applications made abroad "by the applicant and by those from whom he claims and by those claiming under him". I am conscious that often enough applications are made not singly but by two or more individuals and that the Indian applicant might not be the sole but a joint applicant in the foreign country. I have not, however, thought it necessary to make specific provision for this contingency in the text of the clause, because I feel that an application abroad is none the less one by the applicant here, notwithstanding that it is by him jointly with another. In this view I am supported by the interpretation which was placed on a similar provision in regard to convention application in Switzer's Patent 1958 R.P.C. 415.

355. To secure compliance with this provision as to the disclosure of information regarding foreign applications for the same invention, I am adding to Clauses 21 and 37 words to include failure to communicate information in possession of an applicant, as constituting a ground of opposition and revocation respectively.

Clause 8—Provisional and Complete Specifications

356. Sub-Clause (1).—Under Section 4A(1) of the Patents and Designs Act of 1911, a complete specification has to be filed within nine months from the date of the application and the accompanying provisional specification, with a permissible extension by one month on request made by the applicant to the Controller for proper cause. The Patents Enquiry Committee, while recommending no change in the initial period of nine months prescribed under section 4A(1) of the present Act, suggested that the period of one month allowed for extension may be enhanced to three months. Clause 8(1) of the Bill adopts this recommendation.

357. Under the corresponding provisions of the U.K. Act of 1949 [Sections 3(2) to 3(5)] and under the Australian Patents Act, 1952—1955 [Section 41(1) and 41(2)] the time for filing a complete specification, where a provisional specification has accompanied the application, is twelve months with a permissible extension by another 3 months for proper cause, making the maximum interval between the filing of the provisional and complete specification 15 months.

358. Under the earlier U.K. Patents & Designs Act of 1907, the initial period was fixed at 9 months with a possible extension by another three months but as the total time of 12 months was found to be inconveniently short, it was extended to 12 and 15 months respectively by the Amendment Act of 1932. The Swan Committee suggested no alteration in the state of the law.

359. The question as to the precise limit of time to be permitted for the filing of a complete specification has to be determined by the balancing of two considerations: (1) It is not in the public interest to have too long a period of secrecy for an invention; (2) Inventors, however, do require a period of time for developing their inventions. The object of the system of provisional specification is to give time to the inventors to develop their inventions after the basic discovery has been made, so that they are in a position to specify in the complete specification the best mode of performing the invention. In this connection it is to be noted that a vast majority of applicants for patents in India are foreign nationals. Where the applications are from the Commonwealth countries with whom we have reciprocal arrangements for priority dates for patents, the majority of them are filed under the reciprocal arrangements which require that the application should be accompanied by a complete specification [*vide* section 78A(3), proviso (a) of the Indian Patents & Designs Act, 1911 and Clause 82(1)(a) of the Bill]. In the case of other foreign applicants also, a complete specification is more often filed with the application, as in several of their home countries, (e.g. America or Germany) there is no system of filing of provisional specifications and the Indian application is made subsequent to the filing of the application in the home country. The result is that the majority of the provisional specifications filed at the Indian Patent Office are from Indian applicants. During the period 1950—57 out of 20,222 applications for patents, (out of which 3,573 were by Indians), 2860 applications were accompanied by provisional specifications and of these 2091 originated in India and only 769 from abroad. In view of these facts, an extension of the period for filing the complete specification after the date of filing the provisional specifications would benefit mostly Indian nationals to get their complete specifications in proper order for being filed.

360. I accordingly recommend that Clause 8(1) may be amended so as to allow a period of 12 months with a possible extension by another 3 months on the lines of section 3 of the U.K. Act which has been followed in Australia and New Zealand.

361. **Sub-Clause (2).**—The corresponding provision in the U.K. Act, 1949 is section 3(3) which, however, does not specifically mention that the two or more applications accompanied by provisional specifications referred to in the clause should be in the name of the same applicant in order to attract the provisions of that

section though this is implicit from the other provisions of the U.K. Act with reference to anticipation etc. The language of the sub-clause which specifically provides for the applications being in the name of the same applicant puts the matter beyond doubt and might therefore be retained.

362. It should, however, be pointed out that the Australian Patents Act has in addition a provision for applications for inventions which are cognate being made by different applicants and for these several applicants being granted a patent jointly [*vide* Section 50(4)]. Under the British system, this type of joint grants would not be possible. I do not consider it necessary to adopt the additional Australian provision and would retain Clause 8(2) in its present form.

363. Sub-Clauses 8(3) and 8(4) may remain as they are. They are substantially reproductions of Sections 3(4) and 3(5) of the U.K. Act.

Clause 9—Contents of Specification

364. **Sub-Clause (1).**—This is substantially taken from Section 4(1) of the U.K. Act, 1949 and might remain.

365. **Sub-Clause (2).**—Reproduces in substance Section 4(4) of the Indian Patents and Designs Act, 1911 but does not include Sub-Section (5) of that Section. That sub-section runs—

> "If in any particular case the Controller considers that an application should be further supplemented by a model or sample of anything illustrating the invention or alleged to constitute an invention, such model or sample as he may require shall be furnished before the acceptance of the application, but such model or sample shall not be deemed to form part of the specification".

366. A provision on these lines was first introduced in the U.K. Patents Act in 1907. The rationale of this requirement of sample was thus explained by the Comptroller in his Annual Report of the U.K. Patent Office for 1907—

> "With the object of checking applications for speculative patents for alleged inventions based only on chemical theories, and not submitted to the test of experiment, Section 2(5) has provided that where the invention in respect of which an application for a patent is made is a chemical invention, such typical samples and specimens as may be prescribed shall, if in any particular case the Comptroller considers it desirable, be furnished before the acceptance of the complete specification".

Frost in his Treatise on Patents (Fourth Edition, Vol. II, 1912, page 15) explains the object of conferring the power on the Comptroller to require samples thus—

> "The object of giving the Comptroller the above power is to prevent the granting of mere blocking patents. It is to enable the Comptroller, on behalf of the public, to be satisfied that the alleged invention will really produce the results stated. If a claim be allowed which is in terms sufficiently vague to apparently include the production of

a chemical body which, as a matter of fact, the applicant cannot produce by the alleged invention the patent may be used to harass a subsequent meritorious inventor, who, by a different invention, is able to produce such chemical body. When the Comptroller considers it desirable to call for samples and specimens and the applicant is unable to produce them, or satisfy the Comptroller that they can be produced, the Comptroller can, upon the report of the Examiner, either refuse the application or require amendment on the ground that the specification does not fairly describe the nature of the invention. This power may enable the Comptroller to prevent the dog-in-the-manger tactics which previously were, in some cases, practised by patentees whose claims were purposely drafted in language sufficiently vague to appear to claim chemical bodies which could not be produced by the alleged invention."

I consider this therefore a useful provision which deserves to be retained (*vide* also section 40 of the Canadian Patents Act).

367. Sub-Clause (3).—This deals with the contents of a complete specification and follows the provision contained in the corresponding section 4(3) of the U.K. Act which is substantially similar to Section 40(1) of the Australian enactment. The provision in Canada (Section 36), however, is more detailed and brings out the effect of the decisions on what a complete specification should contain. I consider that the form adopted in Canada might with advantage be adopted here with suitable changes. In place of this sub-clause I would suggest the following:

"9(3) (a): Every complete specification shall correctly and fully describe the invention and its operation or use, as contemplated by the inventor, including the best method of performing the invention which is known to the applicant so as to distinguish the invention from the prior art and shall set forth clearly the various steps in a process, or the method of constructing, making, compounding or using a machine, manufacture or composition of matter, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most closely connected to make, construct, compound or use it; in the case of a machine, it shall explain the principle thereof, and the best method in which the application of that principle is contemplated; in the case of a process the necessary sequence, if any, of the various steps shall be explained.

(b) The specification shall end with a claim or claims defining the scope of the invention and stating distinctly and in explicit terms the things, combinations or processes that the applicant regards as new and to which he claims to be entitled to protection."

368. Section 36(3) of the Canadian Act enables additional fee being charged where the number of claims contained in a complete specification exceed 20 following in this respect the provision in the Patents Law of the United States. I would recommend a similar provision for adoption. This would have the effect of eliminating unnecessary

claims and the cutting out of a multiplicity of claims which scarcely differ from one another, which is a common feature of the several of the foreign systems of drafting claims. There is, however, no necessity to insert any provision in the Act itself and it is sufficient if the Rules, which prescribe the fee for the filing of a complete specification, make a provision that where the claims of a complete specification exceed a reasonable number (say ten or fifteen) set out in the rules, a prescribed fee shall be paid on each 5 or 10 claims in excess of that figure.

Clause 10—Priority date of claims of complete specifications

369. The separation of the priority date for claims for the purpose of determining novelty from the date from which the patent should be effective was made in the U.K. in 1949 as a result of the recommendation of the Swan Committee (para 35 to 43 of their Final Report). The Patents Enquiry Committee recommended the adoption of this system in India and this is incorporated in Clause 10 of the Bill. I agree there is advantage in this system.

370. Coming to the details of the provision, it has to be noticed that the language of Clause 10 is substantially derived from the corresponding section 5 of the U.K. Act 1949. When this matter of priority dates was considered by the Dean Committee in Australia, they suggested one main change from the U.K. system. This point of difference is thus expressed in paragraph 59 of their Report:—

"Under the British Act and practice, claims are not allotted priority dates, unless and until the matter becomes an issue; but, on the whole, we consider that there are advantages in specifying priority dates in the specification and permitting them to be challenged in opposition, revocation and infringement proceedings."

Section 44 of the Australian Act which implements the above recommendation enacts:—

"44. (1) There shall be a priority date for each claim of a complete specification.

(2) A claim of a complete specification shall indicate the date which the applicant considers to be the priority date of that claim."

The requirement of this provision is carried out in Australia by the statutory rules framed under the Patents Act. Under Regulation 6 read with paragraph (11) of Part II of the 3rd Schedule, the priority date of each claim in the specification is required to be inserted by the applicant at the end of each claim. I consider the Australian provision to be an improvement over the British practice and I would recommend its adoption in India.

371. I would further suggest the addition of three new provisions which are not to be found either in Clause 10 of the Bill or in Section 5 of the U.K. Act, 1949.

372. The first one is based on Section 45(3) of the Australian Act and is applicable in cases where a further or a fresh application has been filed under Clause 16(1) of the Bill which deals with the division of applications, whose ratio I shall explain in my notes to that Clause

373. The other two are not found in specific terms either in the U.K. or in the Australian Acts. The first relates to the effect of post-dating of applications with reference to priorities. As to the effect of post-dating, Terrell says:—

> "The applicant gets more time for filing a complete specification for putting his application in order but at the risk of having his patent wholly or partially invalidated by some disclosure or application made meanwhile" (Terrell 'Law of Patents' page 39).

I have given effect to the principle behind this last observation in the redrafted sub-clause (8).

374. The other is a provision for determining the priority date where a complete specification is preceded by more than one provisional specification and a claim is based on matter fairly disclosed partly in one and partly in another of these provisional specifications. The Australian Act does not make provision for such a case, and in the absence of a specific provision, the priority date would be the date of the filing of the complete specification which is not proper.

375. The following redraft of Clause 10 would implement the above suggestion:—

"10. **Priority dates of claims of a complete specification.**—(1) There shall be a priority date for each claim of a complete specification.

(2) Each claim of a complete specification shall indicate the date which the applicant considers to be the priority date of that claim.

(3) Where a complete specification is filed in pursuance of a single application accompanied by—

(a) a provisional specification, or;

(b) by a specification which is treated by virtue of a direction under sub-section (3) of section 8 as a provisional specification;

and the claim is fairly based on the matter disclosed in the specification referred to in (a) or (b) above, the priority date of that claim shall be the date of the filing of the relevant specification.

(4) Where the complete specification is filed or proceeded with, in pursuance of two or more applications accompanied by such specifications as are mentioned in the preceding sub-section and the claim is fairly based on the matter disclosed

(a) in one of those specifications, the priority date of that claim shall be the date of filing of the application accompanied by that specification,

(b) partly in one and partly in another the priority date of that claim shall be the date of the filing of the application accompanied by the specification of the later date.

(5) Where the complete specification has been filed in pursuance of a further application made by virtue of Section 16(1) of this Act and the claim is fairly based on matter disclosed in any of the earlier specifications, provisional or complete, as the case may be, the priority date of that claim shall be the date of the filing of that specification in which the matter was first disclosed.

(6) Where, under the foregoing provisions of this section, any claim of a complete specification would, but for the provisions of this sub-section, have two or more priority dates, the priority date of that claim shall be the earlier or earliest of those dates.

(7) In any case to which sub-sections (3) to (6) do not apply, the priority date of a claim shall, subject to the provisions of section 83, be the date of filing of the complete specification.

(8) The reference to the date of the filing of the application or of the complete specification in this section shall in cases where there has been a post-dating under sub-sections (2) or (3) of Section 16 of this Act, be a reference to the date as so post-dated.

(9) A claim in a complete specification of a patent shall not be invalid by reason only of—

(a) the publication or use of the invention so far as claimed in that claim on or after the priority date of that claim; or

(b) the grant of another patent which claims the invention, so far as claimed in the first mentioned claim, in a claim of the same or a later priority date."

Clause 11—Examination of Application

376. This clause is certainly an improvement on the present section 5 of the Indian Patents and Designs Act, 1911 in that it specifies particularly the functions of the Examiner and the contents of his report. In substance, this clause follows the provision of the U.K. Act, 1949 [Section 6(1)]. There is, however, certain amount of redundancy in it, sub-clauses (a) and (b) somewhat overlapping, and besides, the clause fails to make provision for the consideration of objections based on Clause 3.

377. There is one other matter which logically follows from the amendment which I have suggested to Clause 10 of the Bill regarding the inclusion of provision on the lines of Section 44 of the Australian Patents Act, which requires every complete specification to specify a priority date for each of the claims. If this is accepted, there would have to be a provision for the examination of this matter on the lines of Section 47(2) of the Australian Act. The following redraft will implement the above suggestions:—

"11. **Examination of Application.**—(1) When the complete specification has been filed in respect of an application for a patent, the application and the specification or specifications relating thereto shall be referred by the Controller to an Examiner for making a report to him in respect of the following matters, namely—

(a) whether the application and the specification or specifications relating thereto are in accordance with the requirements of this Act or of any rules made thereunder,