

- (b) whether there is any lawful ground of objection to the grant of the patent under this enactment, in pursuance of the application,
- (c) the result of investigations made under Section 12,
- (d) whether the priority date of each claim as indicated by the applicant is the priority date of that claim as determined by this Act, and
- (e) any other matter which may be prescribed."

Clause 12—Search for anticipation by previous publication and by prior claim

378. I have already set out in paragraphs 111 to 115 ante my views as to what should constitute anticipation by publication. I have there explained that the U.K. system, which has been followed in India under Section 9 of the Patents and Designs Act, 1911, of anticipatory publications being confined to publication in India and which is continued in the Bill is not in the interests of the country and that national economy would be better served if the continental or the American system, whereunder publication of the invention before the priority date in any part of the world constitutes anticipation, were adopted.

379. It may be noticed that though the marginal note to Clause 12 refers to a search for anticipation by previous publication etc., the body of the clause does not use the expression "anticipation". This may be remedied.

380. A provision on the lines of Section 11(2) of the U.K. Act, 1949 is useful and may be added. Section 44 of the Patents Law of 1957 of Czechoslovakia contains a provision for a Commission of Experts as the advisory organ of the President of the Patent Office, with assignments to be fixed by the latter. A similar provision for a panel of experts to advise the Controller, if he desires at any time to consult them on questions involving novelty or subject matter might be usefully adopted here. The references should be made confidentially and if the report of the expert is adverse to the applicant, the Controller might be directed not to act upon the report without making the report available for the applicant and giving him an opportunity to be heard.

The Clause may be redrafted thus:

"12. Search for anticipation by previous publication and by prior claim.—(1) The Examiner to whom an application for a patent is referred under section 11 shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification—

- (a) has been anticipated by publication before the date of filing of the applicant's complete specification in any specification filed in pursuance of an application for a patent made in India and dated on or after 1-1-1912;
- (b) is claimed in any claim or any other complete specification published on or after the date of filing of the applicant's complete specification, being a specification filed in pursuance of an application for a patent made

in India and dated before or claiming the priority date earlier than that date.

- (2) The Examiner shall, in addition, make such investigation as the Controller may direct for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been anticipated by publication in India or elsewhere in any other document before the date of filing of the applicant's complete specification.
- (3) Where a complete specification is amended under the provisions of this Act before it has been accepted, the amended specification shall be examined and investigated in like manner as the original specification.
- (4) The investigations made under this Section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Central Government or any officer thereof by reason of, or in connection with, any such investigation or any proceeding consequent thereon."

Clause 13—Consideration by the Controller of the report by the Examiner

381. The practice in Australia is to forward to the applicant the report of the Examiner on the complete specification, and section 53(1) of the Australian Act provides for the computation of the time for acceptance from the date on which the report was sent to the applicant. In the U.K. as well as under the Indian Patents and Designs Act, 1911, the practice that prevails is for the applicant being informed merely of the objections of the Controller, the report of the Examiner as such not being forwarded to the applicant. The present practice may continue.

382. The next question is as regards the procedure to be followed by the Controller in disposing of the application in the light of the examiner's report. No doubt Clause 73 makes provision for the Controller affording an opportunity to an applicant before any discretionary power vested in him is exercised adversely to the applicant. But in order to avoid any argument that Clause 73 might not be attracted to cases where the statute directs the Controller to pass orders rejecting an application, it would be preferable to put matters beyond controversy.

383. I would accordingly suggest that the clause might be redrafted thus:—

"13. Consideration by the Controller of the report by the Examiner.—Where in respect of an application for a patent the Controller has received the report of the Examiner, he shall if the same were adverse to the applicant or required any amendment of the application or of the specification to ensure compliance with the provisions of this Act or the rules made thereunder, notify the applicant of the objections to his application, and require the latter to show cause why the objections should not be upheld. The Controller shall after hearing the applicant, if the latter so desires, dispose of the application in accordance with the provisions hereinafter appearing."

Clauses 14 and 15.—Order of refusal or amendment of application in certain cases

384. These clauses which deal with substantially the same matter broadly correspond to Sections 10(1) and 6(2) respectively of the U.K. Patents Act, 1949. It would be convenient to combine the provisions of these two clauses.

385. There is no provision corresponding to section 10(2) of the U.K. Act, 1949 dealing with cases where the primary or the intended use of an invention is lawful, but there is the possibility of the invention being put to a use which is either contrary to law or to morality. In such cases, the U.K. Act vests the Controller with a discretion to accept the application, provided the applicant disclaims the unlawful use of the invention. Cases where advantage has been taken of this provision have been few but notwithstanding this, there is no doubt that this is a useful provision and might be added.

386. The following redraft seeks to implement this recommendation:—

"14. Refusal of application in certain cases.—(1) Where the Controller is satisfied that the application or any specification filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may either

- (a) refuse to proceed with the application; or
- (b) require the application, specification or drawings to be amended to his satisfaction before he proceeds with the application.

(2) If it appears to the Controller that

- (a) the application claiming to be a convention application was filed in contravention of the provisions of Chapter XVII, or
- (b) the invention claimed in the specification is

- (i) not an invention within section 2(h), or
- (ii) not patentable under section 3,

he shall refuse the application.

(3) If it appears to the Controller that any invention in respect of which an application for a patent is made might be used in any manner contrary to law, he may refuse the application, unless the specification is amended by the insertion of such disclaimer in respect of that use of the invention or such other reference to the illegality thereof as the Controller thinks fit.

Clause 16—Other orders of the Controller

387. Clause 16(1) deals with the division of an application. This provision is necessitated by the rule that an application for a patent should be confined to and each patent would cover only a single invention. Where the complete specification filed in respect of an application and the claims based thereon, relate to more than one invention the Controller is bound to raise an objection requiring the applicant to amend his complete specification by confining it to

a single invention. But even apart from such objection raised by the Controller, the applicant for a patent might himself realise the defect in his application and seek to amend his complete specification to conform to the Act. In either of these cases the applicant would naturally be desirous of covering his invention which is disclosed in the specification already filed but which is excluded from the earlier complete specification, by filing a further application and obtain a patent therefor. It is to this situation that Clause 16(1) is directed.

388. The language of the draft clause, however, which appears in part to be based upon the provisions of Section 6(5) of the U.K. Patents Act, 1949, is defective in more respects than one.

First, the sub-clause by implication appears to suggest that if an earlier complete specification filed in pursuance of a single application disclosed more than one invention, the Controller had the option either to proceed with the application or to call on the applicant to require the applicant to restrict his claims to one invention. This of course is not what was intended. The phraseology of the sub-section should be altered to make it clear that the Controller has no such option once he finds that the claims of a complete specification relate to more than one invention.

Secondly, it is not clear whether the specification to accompany the further application might be a provisional or should be a complete specification, though I believe the intention was to permit only a complete specification. The Australian Act [Section 51(2)] in terms requires that the fresh application should be accompanied by a complete specification. I would recommend this being made clear.

Lastly, the sub-clause provides for the ante-dating of the fresh application to the date of the original application or such later date as the Controller may fix, in which event the further application is to be deemed to have been made on the date which it bears in accordance with such directions.

389. The provision empowering the Controller to ante-date the further application and the specification filed with it, to an earlier date reproduces in effect the provisions contained in Section 6(5) of the U.K. Act. In regard to this, however, I would suggest a change, which, while being logical and consistent with the principle of differentiation between the priority date and the date of the patent, produces a just result.

390. The ante-dating of an application and specification has significance for two purposes:

(1) for fixing the priority date for determining anticipation. The basic principle underlying this is that subject to any provision as to post-dating the priority date should be the date on which the invention was first disclosed. In my redraft of Clause 10(5) I have made provision for the priority date in respect of the further application filed after division, being determined with reference to this principle.

(2) for fixing the date of the patent which under the Bill is the date of the filing of the complete specification [vide

... (1), if the further application is treated as having been filed on the date it was actually filed, there would be difficulty in reconciling it with the statutory requirement as to the maximum time which might lapse between the filing of a provisional and a complete specification. Under Clause 8 of the Bill, this maximum interval was 12 months and I have suggested this being increased to 15 months. In the normal course of events, the defect which necessitated the division of an application would be noticed only when the complete specification is examined and by this date in very many cases the 15 month-period would have lapsed. There is therefore necessity to make a provision for ante-dating the date of the filing of the complete specification to avoid this result. I however consider that it would be just and also logical to ante-date the further application and the complete specification filed therewith to the date of the filing of the earlier complete specification as the further specification became necessary merely on account of extra matter contained in the specification. In this situation it would be necessary to ensure that the specification filed with the further application does not contain any matter not already disclosed in the earlier complete specification contained. If the applicant desires to include fresh matter not already in the complete specification already filed, he must file a fresh application which would have other priority and filing dates.

391. Including these points the clause should with clarity specify that:—

- (1) A further application may be made for an invention disclosed either in a provisional or a complete specification already filed [vide sections 6(5) of the U.K. and 51 of the Australian Acts].
- (2) Such an application may be filed by an applicant who, either apprehends that his application might be held defective on the ground that more than one invention has been claimed in a complete specification, or in order to remedy a defect of this nature pointed out by the Controller (*ibid*).
- (3) The fresh application to be filed before the acceptance of the complete specification [Section 51(1) of the Australian Act].
- (4) The fresh application to be accompanied by a complete specification [51(2) of the Australian Act].
- (5) The Controller to be empowered to require amendments to be made in the complete specification first filed as well as in the complete specification filed with the fresh application to ensure that the same matter is not included in both the complete specifications [U.K. Rule 13(2)].
- (6) The deletion of the later part of clause 16(1) which empowers the Controller to ante-date the fresh complete specification.

392. Sub-clause (2).—This sub-clause, as also the sub-clause that follows, confer power upon the Controller to post-date an application. Sub-clause (2) deals with a case where the post-dating is in consequence of a request made by the applicant. Provision on these lines was first introduced in the U.K. in 1932 by an amendment introduced by the Patents Act of that year. A slight change in the language of this provision was made by the U.K. Act of 1949 by the introduction of the opening words "At any time after an application has been filed". Before the introduction of these words, it was held in *Seligman's Application for a Patent* (36 R.P.C. 267) that where an application had not been accepted within 18 months from the date of the filing and had therefore become void [Clause 18(2) of the Bill] no application for post-dating could be entertained. The insertion of the words italicized above is stated in Terrell on the Law of Patents as overruling this decision in these terms:

"Under the present Act it seems plain, by reason of the use of the words 'at any time' that where an application is post-dated it is treated for all purposes as having been made on the later date".

[Terrell on Law of Patents: 9th Edition Page 39].

I do not agree with this comment and in this I am supported by the decision of the Divisional Court in *A. H. Freeman and others* (1953 R.P.C. 263), which has been affirmed by the Court of Appeal in 1959 R.P.C. 25. It is not however proper to leave the matter in this state of ambiguity and I would resolve it on the lines of the U.K. decision.

393. Sub-clause (3).—This sub-clause has to be drafted so as to conform to the draft of Clause 14(1).

394. Sub-clause (4).—This corresponds to Section 7(3) of the U.K. Act. I would suggest two changes in the sub-clause. The first is in regard to the reference to sub-section (1) of Section 12: this should be to sub-section 1(a), the matter referred to in sub-clause (b) being that dealt with by Clause 16(5). The second is that sub-clause 4(a) in making a reference to the country of publication of the documents, uses the words "in India". In view of the change I have recommended in the rule as regards what shall constitute an anticipatory publication by documents, it is necessary that the words "in India" should be deleted. I would further suggest the substitution of the words "acceptance of the complete specification" for "acceptance of the application". I have discussed this last matter in the notes to Clause 18.

395. Sub-clauses 5 and 6.—These correspond to sections 8(2) and 8(3) of the U.K. Act, 1949 and make provision for references being entered in the specifications. There is one other ground, besides those provided for in Sections 8(2) and 8(3) of the U.K. Act [corresponding to Clauses 16(5) and 16(6)] upon which a specific reference may be inserted by the Controller. That is the subject matter of Section 9 of the U.K. Act. This Section 9 is based on the recommendation of the Swan Committee who in paragraph 180 of their Final Report said:

"We also consider that provisions should be made in the Acts to the effect that where, in the Comptroller's opinion, the

invention claimed cannot be performed without risk of infringement of some claim of an earlier patent which is in force and *prima facie* valid, he may, unless the applicant himself agrees to insert a specific reference to such earlier patent, insert a reference to it after the claims by way of notice to the public".

395. Broadly stated this recommendation was in effect to put into precise and statutory form the previously existing practice of the Patents Office. Luxmoore, J., referred to the practice in this regard in *Daniel Adamson & Company's* application (50 R.P.C. 171 at p. 174):

"A specific reference is inserted in order to warn the public and to call attention to a relationship existing between the invention described and claimed in the specification in which such reference appears and the invention described and claimed in the Letters Patent the subject of such specific reference."

There were also other cases in which according to the practice of the Patent Office specific reference used to be made but it is unnecessary to go into the details of that practice. I understand that the practice in India is on the same lines as in the U.K. Under the existing practice though the Controller normally requires an applicant to insert a reference and declines to proceed with the application in proper cases unless the reference were inserted, he is not under any statutory obligation to do so. It was this option or discretionary power of the Controller that was made obligatory and statutory under Section 9 of the U.K. Patents Act. The omission of a provision on the lines of Section 9 does not therefore make much difference because the existing practice will continue. But on the other hand, the codification of the law and a statutory definition of the conditions in which a reference should be inserted would put the matter beyond doubt. For these reasons I consider that it would be useful to have a provision on the lines of Section 9 of the U.K. Patents Act, 1949 to be inserted as one of the sub-clauses of Clause 16.

397. Sub-clause (7).—This sub-clause reproduces the provision contained in Section 8(4) of the U.K. Patents Act. The power of the Controller to insert a reference after the grant of the patent is in the U.K. put in to cover cases of belated opposition under Section 33 of the U.K. Act. As the Bill does not make any provision for such belated opposition, references to the power of the Controller subsequent to the grant of a patent must be omitted.

398. A redraft on the following lines will carry out the above suggestions:—

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

- (b) (i) The further application under the last preceding sub-section shall be accompanied by a complete specification, and the application and the complete specification shall be deemed to be filed on the date of filing of the complete specification in pursuance of the first mentioned application.
- (ii) The complete specification filed with the further application shall not include any matter not in substance disclosed in the complete specification filed in pursuance of the first mentioned application.
- (iii) The Controller may require such amendment of the complete specification filed in pursuance of either the original or the further application as may be necessary to ensure that neither of the said complete specifications includes a claim for matter claimed in the other.
- (c) The further application shall, subject to the determination of the priority date under Section 10(5) of this Act, be proceeded with as a substantive application.
- (2) Subject to the provisions of Section 8 at any time after an application has been filed under this Act and before acceptance of the complete specification, the Controller may, at the request of the applicant made in the prescribed manner, direct that the application shall be post-dated to such date as may be specified in the request, and proceed with the application accordingly:
- Provided however that no application shall be post-dated under this sub-section to a date later than six months from the date on which it was actually made or would, but for the provisions of this sub-section, be deemed to have been made.
- (3) Where an application or specification (including drawings) is amended in pursuance of the directions of the Controller under Section 14(1) the application or specification shall, if the Controller so directs, be deemed to have been made on the date on which the requirement is complied with or where the application or specification is returned to the applicant, the date on which it is re-filed after complying with the requirement.
- (4) Where it appears to the Controller that the invention so far as claimed in any claim of the complete specification has been anticipated in the manner referred to in sub-section 1(a) or sub-section (2) of Section 12 he may refuse to accept the complete specification unless the applicant either
- (a) shows to the satisfaction of the Controller that the priority date of the claim of his complete specification is not later than the date on which the relevant document was published; or
- (b) amends his complete specification to the satisfaction of the Controller.
- (5) If it appears to the Controller that the invention is claimed in a claim of any other complete specification referred

to in clause (b) of sub-section (1) of Section 12, he may, subject to the provisions hereinafter contained, direct that a reference to that other specification shall be inserted by way of notice to the public in the applicant's complete specification unless within such time as may be prescribed either:

- (a) the applicant shows to the satisfaction of the Controller that the priority date of his claim is not later than the priority date of the claim of the said other specification; or
 - (b) the complete specification is amended to the satisfaction of the Controller.
- (6) If it appears to the Controller as a result of an investigation under Section 12 or otherwise—
- (a) that the invention so far as claimed in any claim of the applicant's complete specification has been claimed in any other complete specification referred to in clause (a) of sub-section (1) of Section 12; and
 - (b) that such other complete specification was published on or after the priority date of the applicant's claim; then, unless it has been shown to the satisfaction of the Controller that the priority date of the applicant's claim is not later than the priority date of the claim of that specification, the provisions of sub-section (5) shall apply in the same manner as they apply to a specification published on or after the date of filing of the applicant's complete specification.
- (7) Any order of the Controller under sub-section (5) or (6) of this section directing the insertion of a reference to another complete specification shall be of no effect unless and until the other patent is granted.
- (8) (i) If, in consequence of the investigations required by the foregoing provisions of this Act or of proceedings under Section 21 of this Act, it appears to the Controller that an invention in respect of which application for a patent has been made cannot be performed without substantial risk of infringement of a claim of any other patent, he may direct that a reference to that other patent shall be inserted in the applicant's complete specification by way of notice to the public unless within such time as may be prescribed either—
- (a) the applicant shows to the satisfaction of the Controller that there are reasonable grounds for contesting the validity of the said claim of the other patent; or
 - (b) the complete specification is amended to the satisfaction of the Controller.
- (ii) Where, after a reference to another patent has been inserted in a complete specification in pursuance of a direction under the foregoing sub-section—
- (a) that other patent is revoked or otherwise ceases to be in force; or

- (b) the specification of that other patent is amended by the deletion of the relevant claim; or
- (c) it is found, in proceedings before the court or the Controller, that the relevant claim of that other patent is invalid or is not infringed by any working of the applicant's invention, the Controller may, on the application of the applicant, delete the reference to that other patent."

Clause 17—Substitution of applications etc.

399. This clause reproduces Section 17 of the U.K. Act, the present provision in relation to this matter being contained in Section 10(1A) of the Indian Patents and Designs Act, 1911.

The marginal note may be amended to read "Substitution of applicants etc." as in the U.K.

400. Sub-clause (1).—Sub-clause (3) indicates that the assignment or agreement dealt with in sub-clause (1) is in writing. This might be made explicit by the addition of the words "in writing" after the word "agreement" in line 3.

401. Sub-clause (2).—This sub-clause refers to an assignment or agreement made by one of two joint applicants for a patent. In the context it is obvious that what is meant is "by one of two or more joint applicants". The words "or more" occur in the corresponding U.K. Section 17(2) and they might be inserted in sub-clause (2).

402. Sub-clause (3).—Paragraph (c) of sub-clause (3) departs from the U.K. provision—Section 17(3) (c)—by omitting reference to the right being established in a court. I do not consider the omission justified. Further the reference to "the rights of the claimant in respect of the invention" being "finally established under the provisions of this Act" is an inaccurate description of the scope and function of the Controller under sub-clause (5) to which it obviously refers. Under sub-clause (5) the Controller does not determine the rights of the claimant to the invention, but is only concerned to give directions "for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be proceeded with". In view of this, the provisions of sub-clause (3) (c) may be redrafted thus:

- "(c) the rights of the claimant in respect of the invention have been finally established by the decision of a court; or
- (d) the Controller gives directions for enabling the application to proceed or for regulating the manner in which it should be proceeded with under the provisions of sub-section (5) of this section."

403. Sub-clause (4).—The U.K. expression "personal representative" has to be replaced by the words "legal representative" its Indian equivalent in line 27.

Clause 18—Acceptance of complete Specification

404. This clause corresponds broadly to Sections 12 and 13(1) of the U.K. Patents Act, 1949 though the language employed is not identical. I would suggest that this clause might be broken up into two parts as in the U.K., the first dealing with the time within which an applicant should put his application and specification in order,

...including the prescription of the time within which he should do so. The logicity of such an arrangement is too obvious to require argument in support.

405. There are two other matters to which I would draw attention: (1) The Bill speaks of "the acceptance of the application" whereas the U.K. Patents Act refers to "the acceptance of the complete specification". I would prefer the U.K. form because the main subject matter under examination is the specification and it is when that is in order that an acceptance takes place. (2) Section 13(1) of the U.K. Act carries in addition a proviso which is designed to prevent premature publications of specifications so as not to prejudice applications made abroad. A provision on these lines would benefit Indian inventors who make the basic application in this country. The provision is designed to obviate the difficulties arising from the fact that in certain countries, the publication of a specification in any other country constitutes an anticipation so as to deprive an invention of novelty for the purpose of making application for patents. I would suggest the adoption of a similar provision in the Bill.

406. Under sub-clause (2) the maximum period within which an application for a patent could be accepted is 12 months from the making of the application. In the U.K. Patents Act of 1949, however, the starting point for the computation of this maximum time is from the date of the filing of the complete specification.

407. The U.K. Patents and Designs Act of 1907 as originally enacted did not fix any period of time within which alone an application should be accepted. In order however to secure that the requisitions of the Controller shall be expeditiously complied with and to prevent undue delay by the applicants the Patents and Designs Amendment Act, 1932 enacted Section 8-A which fixed a maximum period of eighteen months from the date of the application, for its acceptance. The starting point was however, altered in 1939 to run from the date of the filing of the complete specification and this has been continued by the Patents Act of 1949. [It may be mentioned in passing that Section 12(1) of the U.K. Patents Act, 1949 has been the subject of further amendments under which the maximum period allowable now stands enlarged to four years vide, the U.K. Patents Act of 1957 (section 1).

408. To make the date of filing of an application for a patent, the starting point for computing the maximum period allowable for the acceptance of a complete specification does not seem to have much reason behind it, while on the other hand, there is more logic in making it commence from the filing of the complete specification. It is the complete specification which is examined by the Patent Office and the interval provided by the clause is for the purpose of allowing for--

- (a) the time required for the examination of the application and the specification by the Patent Office and;
- (b) the time required by the applicant to comply with the requirements of the office.

Besides, to compute the time from the filing of an application operates to the prejudice of applicants who file provisional specifications along

with their applications and as I have already pointed out, most of them are Indian applicants. The provision in the Bill must therefore, be altered.

409. The mode of computation adopted in the U.K., however, suffers from the defect that the time taken by the Patent Office for examination, for which the Act could not and does not prescribe any maximum period, is included in the total period of time within which the acceptance of the specification ought to take place. In other words, any delay caused by the office in completing the examination is in effect attributed to the applicant and he is prejudicially affected if the examination takes more time than might be usual. This anomaly is avoided in Australia, by prescribing that the time within which the complete specification could be accepted should start from the date on which the report of the Examiner is sent to the applicant. Section 53(1) of the Australian Patents Act enacts:

"The time within which an application and a complete specification may be accepted is fifteen months from the date on which the first report of the Examiner on the complete specification was sent to the applicant."

The provision in Canada (Section 32) is similar and the applicant being given "six months after any Examiner appointed has taken action thereon, of which notice has been given to the applicant". I consider this method of fixing the time, making it start from the date on which the first statement of objections by the Controller is sent to the applicant to be just and not open to the objection that an applicant ought not to suffer for the delay caused in the examination by the Patent Office.

410. The next question is the fixation of the precise time limit within which an applicant should be obliged to comply with the requisitions of the office and bring the application and the specification in order. From the quotations which I have made in the previous paragraph, it would be seen that this period is fifteen months in Australia and six months in Canada. I am of opinion that taking into account the conditions in India a period of twelve months might be adopted with a provision for the extension of that period by the Controller by further three months. This would mean that specifications ought to be put in order within a maximum period of fifteen months from the date when the objections of the Controller are communicated to the applicant.

411. Section 32 of the Canadian Act specifies two alternative time limits for an applicant putting his specification in order. One to which I have already adverted provides for six months from the date when the report of the Examiner is communicated to the applicant and the other an absolute period of twelve months from the date of the filing of the complete specification (the system of provisional specification does not obtain in Canada), the applicant having the benefit of the longer of the two periods. Having regard to the fact that I have suggested the raising of the period from six to practically 15 months I do not think it necessary to recommend the adoption of any similar provision here.

412. There is one matter to which it is necessary to advert, on the language of Clause 18(2). This sub-clause uses the expression "deemed to have been refused" in referring to an application which

has been allowed to lapse. This does not appear to be quite accurate. These words were obviously taken from Section 5(4), of the existing Indian Patents and Designs Act, 1911. In the case now under discussion the Controller exercises no violation and passes no order as a result of which the application comes to an end but it is rather the case of a failure to act on the part of the applicant himself. I would prefer the use of the words "be deemed to have been abandoned" as connoting with precision the real situation.

413. Clause 18(2) is further defective in that it does not contain any positive provision setting out the rules applicable in cases where an appeal is filed against the Controller's orders, though cases where appeals are filed are excluded from the operation of the rule as to the limit of time within which an application could be accepted. On the clause as it stands it would appear that if an appeal were filed there would be no limit of time within which a complete specification should be put in order. In the U.K. Patents Act the positive provision is contained in Section 12(3) and it is necessary to incorporate this in Clause 18.

414. The following redraft of clause 18 as Clauses 18 and 18-A, implements these recommendations:—

"18. **Time for acceptance of complete specification.**—(1) An application for a patent shall be deemed to have been abandoned unless within 12 months from the date of the forwarding of the first statement of objections to the application or complete specification by the Controller to the applicant or within such longer period as may be allowed by the following provisions of this section, the applicant has complied with all the requirements imposed on him by or under this Act. Where the application or any specification has been returned to the applicant by the Controller in the course of examination proceedings the applicant shall not be deemed to have complied with such requirements unless and until he has refiled it.

(2) The period allowed by sub-section (1) of this section shall be extended by the Controller to such period not exceeding 15 months from the date of the forwarding of the statement of objections referred to in the foregoing sub-section (1), on application made in the prescribed manner by the applicant before the expiration of the period so specified.

(3) If at the expiration of the period allowed under the foregoing provisions of this section, an appeal to the High Court is pending in respect of the application (or, in the case of an application for a patent of addition, either in respect of that application or in respect of the application for the patent for the main invention) or the prescribed time within which such an appeal could be filed in the High Court (apart from any extension of time granted by the court for filing the appeal) has not expired, then—

(a) where such appeal is pending, or is brought within the aforesaid time of twelve or fifteen months as the case may be or before the expiration of any extension of that time granted by the High court (in the case

of a first extension) on an application made within that time or (in the case of a subsequent extension) on an application made before the expiration of the last previous extension, the said period of twelve or fifteen months as the case may be for complying with the requirements of the Controller shall be extended until such date as the High Court may determine;

(b) where no such appeal is pending or is so brought, the said period of twelve or fifteen months as the case may be for complying with the requirements of the Controller shall continue until the end of the time aforesaid or if any extension of that time is granted by the High Court as aforesaid, until the expiration of the extension or last extension so granted."

"18A. **Acceptance of the complete specification.**—Subject to the provisions of the last foregoing section, the complete specification filed in pursuance of an application for a patent may be accepted by the Controller at any time after the applicant has complied with the requirements mentioned in sub-section (1) of that section and if not so accepted within the period allowed under that section for compliance with those requirements shall be "accepted as soon as may be thereafter:

Provided that the applicant may make an application to the Controller in the prescribed manner requesting him to postpone acceptance until such date not being later than 15 months from the date of the forwarding of the statement of objections referred to in sub-section (2) of the foregoing section as may be specified in the application and if such application is made the Controller may postpone acceptance accordingly."

Clause 19—Advertisement of acceptance of a complete specification

415. This clause reproduces the terms of Section 9 of the U.K. Act of 1907 which was adopted in Section 6 of the Indian Patents and Designs Act of 1911. The corresponding section of the U.K. Act of 1949 [Section 13(4)] made a variation in that the advertisement is to specify the date on which the application and the specification would be open to public inspection, whereas under the clause only the acceptance is notified and thereupon the specification becomes automatically open to public inspection. The change from the provisions of section 9 of the U.K. Act of 1907 was made as a result of the recommendations of the Swan Committee. In para. 184 of their Final Report they said:

"This section provides that, on the acceptance of the complete specification, the Comptroller shall advertise the acceptance, and that the application and specification shall thereupon be open to public inspection. It has been pointed out to us that this practice has some inconvenience. There is often delay in obtaining such inspection, owing to the fact that the documents in question have been sent to the printer for the printing of the specification. It was also pointed out that in some foreign countries a patent is invalidated if the invention has been

foreign application. After full consideration of the matter and consultation with the officials of the Patent Office, we have come to the conclusion that it is desirable to print a date on the specification as the date when the printed copy of the specification is available for purchase, and to treat this date as the first date when the specification may be inspected and can be deemed to be published, and as the date from which the rights of the patentee for recovering damages for infringement accrue, and as the date from which the period for giving notice of opposition to the grant is reckoned. We are informed that under normal conditions the date when the printed copy of the specification would be available is from two to three weeks after the date of acceptance."

416. The provision in Australia is slightly different from that in the U.K. Under section 43(1), of the Australian Patents Act, 1952, on the expiration of six months after the lodging of the complete specification, a notification is to be published that the specification is open to public inspection. This throwing open of the specification to public inspection is unrelated to its acceptance and the latter is separately advertised under Section 52(2). In Australia, therefore, a complete specification might become open to public inspection even before the acceptance of the application by the Controller.

417. The following history of the provisions in Australia might be found useful in considering the proposal made by the Patents Enquiry Committee in para 143 recommending the publication of complete specifications immediately they were filed. Before 1946 the Australian Patent Act followed the U.K. model of specifications becoming open to public inspection only after the acceptance of the application. Section 38A of the Act introduced in that year directed publication of specifications immediately after their lodgment. This however was in force but for a short time, and was replaced by the present provisions as a result of the recommendations of the Dean Committee. In paragraph 53 of their report they said:

"By an amendment of the existing Act made in 1946, Section 38A was inserted providing for the publication of a complete specification after its lodgment. Having regard to the existing state of the examination work in the Patent Office, we accept the principle that a complete specification should not have to await acceptance before it becomes open to public inspection. There are, however, disadvantages in too early publication and we have accordingly provided in Clause 43 that publication shall not take place until six months after lodgment of the complete specification."

418. The Patents Enquiry Committee suggested in para 143 that the provision as to publication of complete specification in India might be modelled on Section 38-A, of the Australian Amendment introduced in 1946. The Bill does not accept this recommendation—and, in my opinion, this rejection is correct. I am not convinced of any advantage in the publication of a complete specification

before acceptance, but, though I entirely agree that in order to ensure that inventions are not kept secret for too long, examination of the specification should be speeded up and such of them as are accepted should be laid open to public inspection at as early a date as possible, on principle I am against the publication of a specification which is not accepted.

419. As between the provisions in the Bill and that in the U.K. Act, I would prefer the latter and would recommend that the clause be redrafted on the lines of Section 13(2) of the U.K. Act.

420. I understand that at present on the average there is a time lag of about 14 months between an advertisement of the acceptance of a specification and the publication of the printed complete specification which is said to be due to the delay in having the printing done in the Government Press [vide Appendix A—Table (10)]. This delay causes hardship to the public. This should be reduced and in no case should it exceed four weeks. To achieve this expedition, the Patent Office might either have a printing press of its own, or be equipped with equipment for rapid duplication like Multigraph etc. so as to enable it to make sufficient copies of specifications for being sold to persons seeking them for the purpose of filing opposition or at least be permitted to utilize a private printing press.

421. In this connection, I might suggest that the present scale of fees payable for application for patents may be modified by reducing by Rs. 10 the fee for the filing of a complete specification and by requiring the payment of Rs. 5 per page of the specification including drawings, subject to a maximum of Rs. 100 for the costs of publishing them and which might be made payable within 30 days of the applicant being notified of the acceptance with power in the Controller to extend this period, say, by another month. If the applicant failed to pay the fee within the time fixed or extended for cause, the acceptance might be revoked and the application refused. This would be more equitable than the present system, under which all applicants for patents pay the same sum whatever be the cost the Government incurs in the matter of having their specifications printed and published. My suggestion, if accepted, might be implemented by appropriate rules.

422. If this clause follows, as I suggested, the phraseology of Section 13(2) of the U.K. Act, 1949, there would have to be a provision on the lines of Section 13(3), of the U.K. Act in order to correlate the expressions used in Clause 19 with those in Clause 20. I would therefore suggest that Clause 19 might have a second paragraph carrying the words of Section 13(3) of the U.K. Act.

423. The following redraft would carry out these suggestions:

"19. Advertisement of acceptance of a complete specification.—

(1) On the acceptance of a complete specification the Controller shall give notice to the applicant, and shall advertise in the Gazette the fact that the specification has been accepted and the date on which the application and specification or specifications filed in pursuance thereof will be open to public inspection.

(2) Any reference in this Act to the date of publication of a complete specification shall be construed as a reference to the date advertised as aforesaid."

424. This clause corresponds in general to section 13(4), of the U.K. Act differing however in two minor matters.

425. The first is that the clause refers to the date of the acceptance of the application as compared to the date "of the publication of the complete specification" referred to in the U.K. Act. I would prefer the U.K. form as being more logical since it is the publication which discloses the invention to the public and not the acceptance of the application and complete specification, which is the matter relevant in this context. I may add that this is also in accordance with the provision in Australia (Section 57).

426. Next the clause includes the words "or the expiration of the time for sealing" which do not occur in the U.K. Act, 1949. These words have had a hoary ancestry in England having come right down at least from the Patents Act of 1883 (Section 15) and continued to be in the U.K. enactments until the Act of 1949. The precise effect, however, of these words is not apparent; nor is it clear whether the relevant date mentioned is the later or the earlier of the two dates—the date of sealing or the expiration of the time. As the proviso requires that the patent shall be sealed before any rights could be enforced, the significance of the words is rather obscure and I presume they were deleted for this reason. There are no reported decisions on the provision. It may be mentioned that these words do not appear in the corresponding section in Australia. I would therefore suggest the deletion of these words. The following redraft would carry out these suggestions.

"20. Effect of acceptance of complete specification.—After the date of the publication of the complete specification and until the date of sealing a patent in respect thereof, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the publication of the complete specification:

Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been sealed."

Clause 21—Opposition to grant of patent

427. I have already discussed the desirability of retaining opposition proceedings as it obtains in the Indian Patents and Designs Act, 1911 and have suggested that clause 21 might be redrafted on the lines of Section 14 of the U.K. Act. The accompanying draft seeks to give effect particularly to the alterations I have recommended in relation to what should constitute anticipation by publication in documents, and the provision in Clause 7-A requiring information from applicants regarding the fate of their foreign applications for the same invention for which a patent is sought here.

21. Opposition to grant of Patent.—(1) At any time within three months from the date of the publication of a complete specification under this Act, (or within such further period not exceeding one month in the aggregate as the Controller on application made to him in the prescribed manner allows) any person interested may give notice to

the Controller of opposition to the grant of the patent on any of the following grounds:—

- (a) That the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person of whom he is the legal representative;
- (b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date claimed
 - (i) in any specification filed in pursuance of an application for a patent made in India after 1-1-1912, or
 - (ii) in India or elsewhere, in any other document, not being a document of the class described in sub-sections (2) or (3) of Section 43 of this Act.
- (c) that the invention, so far as claimed in any claim of the complete specification is published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant's claim¹;
- (d) that the invention so far as claimed in any claim of the complete specification was used in India before the priority date of that claim;
- (e) that the invention so far as claimed in any claim of the complete specification is obvious and so does not involve any inventive step, having regard to the matter published as mentioned in paragraph (b) of this sub-section; or having regard to what was used in India before the priority date of the applicant's claim;
- (f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act or is not patentable under Section 3.
- (g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;
- (h) that the applicant failed to disclose to the Controller the information required by Section 7A or furnished information which in any material particular was false to his knowledge.

but on no other ground.

- (2) Where any such notice is given, the Controller shall give notice of the opposition to the applicant and shall give to the applicant and the opponent an opportunity to be heard before he decides on the case.
- (3) The grant of a patent shall not be refused on the grounds stated in paragraph (c) of sub-section (1) of this section

¹For the orders which the Controller might pass in opposition proceedings when a prior claiming is proved see per Lloyd Jacob J. in 1959 RPC 103.

if no patent has been granted in pursuance of the application mentioned in that paragraph; and for the purpose of enquiry under clauses (d) and (e) of the said subsection (1), no account shall be taken of any secret use."

Clause 21-A—Refusal of patent without opposition

428. The U.K. Act contains a provision—Section 15—under which anticipatory publications might be brought to the notice of the Comptroller without the informant filing a formal and regular opposition to the grant of the patent, a provision which appears to me would be extremely useful. In the first place, it is confined to one specific ground upon which an application could be rejected—a ground which is capable of immediate verification and acceptance if the facts stated were correct. The provision would only mean that the informant assists the Patent Office to effect a more complete examination by bringing to its notice matters which might have been missed. Secondly, the informant might either be a person not having a *locus standi* to file opposition for the reason that he is not technically "a person interested" or one who is not in a position to undertake the expense of filing a regular opposition but might have in his possession information regarding anticipatory publications, which would make the examination more complicated and this would certainly be in the public interest.

429. I have drafted a clause which would carry out this suggestion.

"21-A. Refusal of patents without opposition.—If at any time after the acceptance of the complete specification filed in pursuance of an application for a patent and before the grant of a patent thereon it comes to the notice of the Comptroller, otherwise than in consequence of proceedings in opposition to the grant under the last foregoing section, that the invention, so far as claimed in any claim of the complete specification, has been published before the priority date of the claim;

- (a) in any specification filed in pursuance of an application for a patent made in India and dated after 1-1-1912;
- (b) in any other document [not being a document of any class described in Section 48 (2) or (3) of this Act], the Comptroller may refuse to grant the patent unless, within such time as may be prescribed, the complete specification is amended to his satisfaction."

Clause 22—Mention of inventor as such in patent

430. This clause substantially reproduces Section 16 of the U.K. Patents Act, 1949 except that it omits sub-section (6) of the latter enactment. There is no provision corresponding to Clause 22 in Australia but the New Zealand Act has a provision (section 23) in the same terms as Section 16 of the U.K. Act.

431. The provision owes its origin to the terms of Art. IV (ter) of the International Convention as amended at London in 1934. The Article runs:—

"The inventor shall have the right to be mentioned as such in the patent".

The U.K. Patents Act of 1907 was amended in 1938 by the introduction of a new Section 11A carrying this provision into that Act. The present provision in the United Kingdom Act of 1949 substantially reproduces Section 11A of the Act of 1907.

432. Though India is not a party to the International Convention and there is therefore no legal necessity for such a provision, the justification for it rests on the moral ground upon which the Article of the International Convention itself is based. The principle is that whether or not the actual deviser has proprietary right to the invention (he would not have, for instance, in those cases where he is an employee and the invention has been made in the course of his employment), he has a moral right to be named as the inventor. Such a mention besides affording him mental satisfaction gives him a prestige and increases his economic worth, advantages to which he is legitimately entitled though by contract he might have parted with proprietary interest in the particular patent granted.

433. Sub-clause (2).—In view of my recommendation to eliminate "communicatees" and "importers" of invention from the category of "first and true inventors", sub-clause (2) is unnecessary and may be deleted.

434. Sub-clause (5).—This sub-clause makes a slight departure from the corresponding U.K. provision contained in Section 16(5). The latter prescribes a time-limit both for a request as well as for claim. It is not very clear why the time-limit for the claim was omitted in sub-clause (5). This might be rectified by the inclusion in it of the words "or claim" after the words "A request".

435. In view of the change which I have suggested to Clauses 18 and 19, the provision contained in sub-clause (5) here might be brought into line with the provisions in the U.K. enactment, wherein the starting point for the computation of the time limit of two months runs from the date of the publication of the complete specification and not the date of advertisement of the acceptance of the application. The sub-clause might read:—

"(5) A request or claim under the foregoing provisions of this section shall be made not later than two months after the date of publication of the complete specification or within such further period (not exceeding one month) as the Comptroller may, on an application made to him in that behalf before the expiration of the said period of two months and subject to the payment of the prescribed fee, allow."

Suggested new sub-clause 5A.—Sub-section (6) of the U.K. Act runs in these terms:

"No request or claim under the foregoing provisions of this section shall be entertained if it appears to the Comptroller that the request or claim is based upon facts which, if proved in the case of an opposition under the provisions of paragraph (a) of sub-section (1) of section fourteen of this Act by the person in respect of or by whom the request or claim is made, would have entitled him to relief under that section."

436. The reason why the Bill does not carry this provision might possibly be on account of the omission of the procedure for opposition. In view, however, of my recommendation to introduce opposition proceedings, a provision on the lines of sub-clause (6) of Section 16 of the U.K. Act, 1949 would have to be included in Clause 22.

437. Section 18(6) of the U.K. Act is based on sound principle. Where a claimant alleges and proves that the invention had been obtained from him, the fact would uproot the title of the applicant and would therefore be a ground for refusing the application. For this reason, the sub-section provides that the proper remedy for a person coming forward with such an allegation should be to invalidate the grant of the patent and not merely obtain mention of his name as an inventor. The provision is in public interest and I would suggest its adoption. As regards the language of the sub-clause there is one point that deserves mention. Sub-section (6) of the U.K. Act refers both to a request as well as a claim. The provision is quite in order so far as "claims" are concerned. It is, however, not clear how "a request" could be based on an allegation of "obtaining". A request is made when an applicant or all the applicants together with the actual deviser, if he is not the applicant, present an application to the Controller. In such cases as the alleged actual deviser is a consenting party, no allegation of "obtaining" is possible. I therefore consider that the reference to "request" might be omitted from the new sub-clause. If effect were given to these suggestions, a new sub-clause 5A might be added reading:

"(5A). No claim under the foregoing provisions of this section shall be entertained if it appears to the Controller that the claim is based upon facts which, if proved in the case of an opposition under the provisions of Section 21 of this Act by the person in respect of or by whom the claim is made, would have entitled him to relief under that section."

Clause 23—Provision for secrecy for certain inventions etc.

438. I have discussed the broad outlines of the scheme for the preservation of secrecy in regard to applications for patents for inventions relevant for defence in paras 218-236 ante.

439. It will therefore be sufficient if I confine myself to the details of the drafting changes which are needed. First in relation to sub-clause (1), its last portion enables the Controller to proceed with an application in regard to which a secrecy direction has been passed up to the stage of acceptance. From this, it would follow that the orders of the Controller passed in regard to the application or the specification filed in pursuance thereof, would all be subject to rights of appeal. It would, however, defeat the very purpose of the secrecy directions if the hearing of these appeals should take place in open court, in which event the invention which it is designed to keep secret by reason of the directions passed under Clause 23(1) would become disclosed to the public. This result could be obviated by one of two courses:

- (1) an elaborate provision for hearing appeals in the several stages in camera;
- (2) by eliminating appeals so long as secrecy directions are in force.

I consider the latter preferable primarily on administrative grounds. To guard against prejudice to applicants, the Controller might be deprived of the power to refuse an application so long as the directions are in force. In the appended redraft I have sought to make provision on these lines.

440. While on this topic I might advert to the fact that sub-clause (3) of the Bill makes provision for the inventor agitating the adequacy of the compensation granted to him by Government in court. In such a proceeding there is a possibility of the invention becoming disclosed to the public. This may be remedied by appropriate provisions in Clause 55 and I have expanded sub-clause (4) of clause 55 to meet this need.

441 Sub-clause 3(b).—I suggest the substitution of the word "solatium" for "compensation" used in sub-clause 3 (b) of the Bill. This would emphasise the aspect that the payment is not exigible as a matter of legal right.

442. In view of the recommendation I have made regarding the grant of patents to inventions in the field of Atomic Energy I suggest the omission of all reference to the Atomic Energy Act in this clause (sub-clauses 3, 4 and 5).

443. Sub-clause (5).—This sub-clause reproduces the provision of Section 18 (5) of the U. K. Act which was itself based upon the relevant war time regulation on the topic. If the suggestion I have made empowering the Central Government on its initiative to direct the Controller to pass secrecy directions were accepted it would be necessary to effect a change in the text of sub-clause (5) of Clause 23 making it incumbent on the Controller to obtain the consent of the Government before authorising an applicant for a patent in India to make an application abroad. In the absence of such provision, normally when the Controller decides in respect of an application that it is not necessary to pass any secrecy direction in relation to it, he would give permission to the applicant to file an application for a patent abroad. In view, however, of the Government having a right to examine applications in regard to which the Controller has not thought it necessary to pass orders under Section 23 (1) it is necessary to clothe the Government with control over the applicant filing applications for patents outside India.

444. I consider the period of 6 weeks provided by sub-clause 5 (a) inadequate for the Government to make up their mind whether it is necessary to issue orders to the Controller and would recommend its being made 8 weeks.

445. The U. S. A. Patents Act which contains a similar provision as to secrecy directions as in Clause 23 (1) enacts that any contravention of the directions by the applicant shall be visited not only with punishment as a criminal offence as is done by Clause 84 of the Bill but also with other disabilities on the applicant by way of his losing the right to proceed with the application for patent. I consider such a provision proper because it is somewhat odd that a patent should be granted or remain in force for an invention in regard to which the applicant has been guilty of a criminal offence.

446. The following redraft gives effect to the above suggestions:—

- "23. Provision for secrecy for certain inventions etc.—(1). Where either before or after the commencement of this Act, an application for a patent has been made in respect of an invention and it appears to the Controller that the invention is one of a class notified to him by the Central Government as relevant for defence purposes or where otherwise the invention appears to him to be so relevant, he may give directions for prohibiting or restricting the publication of information with respect to the invention, or the communication of such information to any person or class of persons specified in the directions.
- (2) Where the Controller gives any such directions as are specified in sub-section (1), he shall give notice of the application and of the directions to the Central Government and the Central Government shall, upon receipt of such notice, consider whether the publication of the invention would be prejudicial to the defence of India, and if upon such consideration, it appears to it that the publication of the invention would not so prejudice give notice to the Controller to that effect, who shall thereupon revoke the directions and notify the applicant accordingly.
- (3) If the Central Government considers that any application for a patent in regard to which the Controller has not given the directions set out in sub-section (1) of this section, is relevant for the purpose of defence, it may at any time before the acceptance of the complete specification, notify the Controller to that effect and upon receipt of such notice, the Controller shall give to the applicant the directions set out in sub-section (1) of this section and intimate the same to the Central Government.
- (4) The Central Government shall reconsider the question whether the publication of the invention continues to be prejudicial to the defence of India within nine months from the date of the filing of the application for the patent, and once at least during every subsequent year and if on such reconsideration it appears to it that the publication of the invention would no longer be prejudicial to the defence of India it shall forthwith give notice to the Controller who shall thereupon revoke the previous direction.
- (5) So long as any directions under sub-section (1) are in force in respect of an application—
- (a) the Controller shall not pass an order refusing to accept the same, and
- (b) notwithstanding anything in Chapter XVIII, no appeal shall lie from any order of the Controller passed in respect thereof:

Provided that the application may, subject to the directions, proceed upto the stage of the acceptance of the complete specification, but the acceptance shall not be advertised nor the specification published, and no patent shall be granted in pursuance of the application.

(6) When any direction under sub-section (1) is revoked by the Controller, he may, (notwithstanding any provision of this Act, specifying the time within which any step should be taken or any act done in connection with an application for the patent), as he thinks fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application whether or not that time has previously expired.

- (7) Nothing in this Act shall be held to prevent the disclosure by the Controller of information concerning an application for a patent or a specification filed in pursuance thereof to the Central Government or any department thereof, for the purpose of the application or specification being examined for considering whether an order under this section should be made, varied or revoked.
- (8) Where a complete specification filed in pursuance of an application for a patent for an invention in respect of which directions have been given under this section is accepted during the continuance in force of the directions, then
- (a) if any use of the invention is made during the continuance in force of the directions by or on behalf of or to the order of the Government, the provisions of sections 53, 54 and 55 shall apply in relation to that use as if the patent had been granted for the invention; and
- (b) if it appears to the Central Government that the applicant for the patent has suffered hardship by reason of the continuance in force of the directions, the Central Government may make to him such payment (if any) by way of solatium as appears to be reasonable having regard to the novelty and utility of the invention and the purpose for which it is designed, and to any other relevant circumstances.
- (9) Where a patent is granted in pursuance of an application in respect of which directions have been given under this section, no renewal fee shall be payable in respect of any period during which those directions were in force.
- (10) No person resident in India shall, except under the authority of a written permit granted by or on behalf of the Controller, make or cause to be made any application outside India for the grant of a patent for an invention unless—
- (a) an application for a patent for the same invention has been made in India, not less than eight weeks before the application outside India, and
- (b) either no directions have been given under sub-section (1) of this section in relation to the application in India, or all such directions have been revoked:

Provided that

- (1) the Controller shall not grant written permission to make any application outside India without the prior consent of the Central Government;

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

(11) Without prejudice to the provisions of Chapter XIX, if in respect of an application for a patent any person contravenes any direction as to secrecy given by the Controller under this section or makes or causes to be made an application for the grant of a patent outside India in contravention of sub-section (10) the application for patent under this Act shall be deemed to have been abandoned and the patent if any granted shall be liable to be revoked under section 37.

(12) All orders of the Controller giving directions as to secrecy as well as all orders of the Central Government under this section shall be final and shall not be called in question in any court on any ground whatsoever."

Clause 24—Grant and sealing of patent

447. Sub-clause (1).—In dealing with clause 21 I have suggested that in place of the provision for objections contained in the present clause there should be a provision for a regular opposition on grounds which I have discussed in dealing with the earlier clause. If the recommendation be accepted the language of Clause 24 (1) would have to be modified.

448. Besides I am unable to comprehend the significance of the words "subject to such conditions if any as the Central Government thinks expedient" which occur in this sub-clause. No doubt these words are found in Section 10 of the Indian Patents and Designs Act, 1911 but I am not able to figure out precisely the sort of condition subject to which a patent may be granted. I am not aware of this power having been utilised during the nearly half a century of its existence so as to afford any guidance regarding the nature of the power. There is no similar provision in the Patents Acts of U.K., Australia or other countries. I suggest the omission of these words in the sub-clause.

449. Sub-clause (2).—Following Section 10 (2) of the Indian Patents and Designs Act, 1911 this sub-clause enacts an overall maximum period computed from the date of the application, within which a patent shall be sealed, the period prescribed by the sub-clause viz., 24 months being the same as that in the existing Act.

450. There is no similar maximum period prescribed by the U.K. Patents Act. On the other hand, it would be found that under that Act even in cases where there is no opposition to the grant of a patent and there were no appeals from the order of the Controller during the examination stage, nearly 35 months might elapse between the filing of an application and the sealing of a patent as might be seen from the following table:—

	Months	Months	
1. Where a provisional specification is filed with application.			
Time for filing complete specification .	12	+	3
			Permissible extension [vide S. 3 (2) of the U. K. Act of 1949].

	Months	Months	
2. After complete specification is filed.			
Time for complying with requisitions of the Controller and secure acceptance.	12	+	3
			Permissible extension [vide S. 12 (1) of the U.K. Act 1949*].
3. After acceptance			
Time usually taken before publication of complete specification.	1	month	(vide Swan Committee Report Para. 184).
4. From time of publication of complete specification request for sealing could be made within	4	months	[S. 19 (2)].

*The period of 12 months has been extended to four years by the Patents Act, 1957. The above computation of 35 months has been made without adverting to this amendment.

451. The period of 24 months allowed by Clause 24 (2) is unduly short. Further it is even inconsistent with the other provisions contained in the Bill because the period of 24 months might conceivably elapse in some cases before the time within which "notice of objections" could be filed under the present Clause 21.

452. Under Section 19(2), the corresponding provision of the U.K. Patents Act, 1949, the time prescribed for requesting that the patent be sealed runs from the date of the publication of the complete specification. This is logical and is based on sound principle. Further the change that I have suggested to Clause 18 (2) as regards the time within which a complete specification should be put in order for the acceptance of the Controller precludes the possibility of prescribing an overall period commencing from the filing of the application. My suggestion there was that time should start from the date on which the statement of objections of the Controller was first sent to the applicant. In view of this the only logical starting point of time for the computation of the duration within which an applicant should, after acceptance of his application, make a request for the sealing should be from the date of the publication of the complete specification and in cases where there is opposition, after the determination of the opposition.

453. In regard to the exact period I would suggest that this might be six months from the date of the publication of the complete specification. In suggesting this period I have taken into account the fact that the maximum period prescribed for an opposition is four months and I have added two months more. I might point out that Section 66 of the Australian Act provides for a period of six months. This would avoid any possibility of a patent being sealed before the period of filing an opposition expires.

454. In regard to the provisos, proviso (a) is unnecessary in view of the substituted starting point of time being the date of the publication of the complete specification and not the date of the application.

Proviso (b).—If time starts from the date of publication of the specification, there need be no reference to appeals against the directions of the Controller under sections 14, 15 and 16 and proviso (b) may be confined to the orders of the Controller under Section 17.

Proviso (c) reproduces the provision of proviso (b) to Section 19 (2) of the U. K. Act which however may be framed on the same terms as in the U. K.

The U.K. Act has a proviso (a) to Section 19 (2) reading

"(a) where at the expiration of the said four months any proceeding in relation to the application for the patent is pending in any court or before the Comptroller or the Appeal Tribunal, the request may be made within the prescribed period after the final determination of that proceeding."

This has not been included among the provisions of the Bill. This proviso would be necessary as the terms of Clause 24 (1) will not suffice to cover the contingency since the provisions of sub-clause (2) provide a time limit within which the sealing should take place.

The present proviso (d) might conveniently be made into a separate sub-clause on the lines of Section 19 (3) of the U. K. Act the maximum period of extension being retained as under the Bill at three months.

455. Clause 24 omits section 19 (4) of the U. K. Act corresponding to Section 66 (5) of the Australian Act. This "hardship clause" was in the words of Blanco White "intended to counter a peculiarity now abolished of the U. S. law and appears to have no present application". The omission of this clause might, therefore, be maintained.

456. The clause might be redrafted on the following lines to give effect to my suggestions.—

"24. Grant and sealing of patent.—(1) Where a complete specification in pursuance of an application for a patent has been accepted and either—

(a) the application has not been opposed under Section 21 and the time for the filing of the opposition has expired; or

(b) the application has been opposed and the opposition has been finally decided in favour of the applicant, or

(c) the application has not been refused by the Controller, by virtue of any power vested in him by this Act,

the patent shall, on request by the applicant in the prescribed form, be granted to the applicant or in the case of a joint application to the applicants jointly, and the Controller shall cause the patent to be sealed with the seal of the Patent Office and the date on which the patent is sealed shall be entered in the Register of Patents.

(2) Subject to the provisions of sub-section (1) and of the provision of this Act with respect to patents of addition, a request under this section for the sealing of a patent shall be made not later than the expiration of a period of six months from the date of the publication of the complete specification:

Provided that—

(a) where at the expiration of the said six months any proceeding in relation to the application for the patent is pending before the Controller or the High Court,

the request may be made within the prescribed period after the final determination of that proceeding;

(b) where the applicant or one of the applicants has died before the expiration of the time within which under the provisions of this sub-section the request could otherwise be made, the said request may be made at any time within twelve months after the date of the death or at such later time as the Controller may allow.

(3) The period within which under the last foregoing sub-section a request for the sealing of a patent may be made may from time to time be extended by the Controller to such longer period as may be specified in an application made to him in that behalf, if the application is made and the prescribed fee paid within that longer period:

Provided that the first-mentioned period shall not be extended under this sub-section by more than three months or such shorter period as may be prescribed.

(4) For the purposes of this section a proceeding shall be deemed to be pending so long as the time for any appeal therein (apart from any future extension of that time) has not expired, and a proceeding shall be deemed to be finally determined when the time for any appeal therein (apart from any such extension) has expired without the appeal being brought."

Clause 24-A—Amendment of patent granted to deceased applicant

457. The provisions contained in proviso (b) to Clause 24(2) as renumbered are not sufficient to cover cases where after a request for sealing has been made, an applicant dies before the actual date of sealing, but the Controller in ignorance of his death, seals it in his name. Section 65(2) of the Australian Act makes provision for this contingency and similarly Section 20 of the U.K. Act. A provision on these lines might usefully be added as Clause 24-A and I would draft it on these lines.

"24A. Amendment of patent granted to deceased applicant.—

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

Clause 25—Date of the patent

458. Under Section 11 of the Indian Patents and Designs Act, 1911 the date of the patent is to be the date of the application. When this was originally enacted in 1911 it contained no provision for the filing of a provisional specification and every application had to be accompanied by a complete specification. This however was altered by the Amending Act 9 of 1945 by which a provision was made for

the filing along with an application, of a "provisional specification" as distinguished from a "complete specification" which latter might be filed within nine months after the filing of the provisional specification with a possible extension of one month at the discretion of the Controller. Notwithstanding this, the provision in Section 11 as regards the date of the patent was left untouched, evidently by inadvertence. The defects and disadvantages of such a system of computation were forcefully pointed out by the Swan Committee (paras 30 to 34 of their Final Report) and the U.K. Act of 1949 followed the Committee's recommendation. The provision in the Bill is on right lines and may be accepted.

459. Clause 25(1) is substantially derived from Section 22(1) of the U.K. Act except that in the latter there is no reference to the sealing. The U.K. Patents and Designs Act, 1907 Section 13 was in the same terms as Section 11 of the Indian Patents and Designs Act, 1911 including the words "and sealing" but these words were omitted from the U.K. enactment by the Amending Act of 1932.

460. The purpose of the provision as to "the date of the patent" is for calculating the duration of the patent and also the time from when the renewal fees would be payable. The date on which the patent is sealed is, however, immaterial for these purposes. It is however relevant only for the calculation of the period beyond which an application for compulsory licensing could ordinarily be filed. I have already in the redraft of Clause 24 provided for the Controller entering in the Register the date on which the patent is sealed. Having in view this provision and bearing in mind the need for not mixing up the date of the patent with the date of the sealing it is necessary that the reference to sealing should be omitted from Clause 25(1).

461. Section 22(1) of the U.K. Act, 1949 does not contain the exception with which sub-clause (1) opens, but Section 67 of the Australian Act which corresponds to Clause 25 uses the phraseology "Subject to this Act" which I prefer. It would be needed to cover cases of patents of addition.

462. The following redraft gives effect to the above suggestion:—

"25. Date of patent.—(1) Subject to this Act, every patent shall be dated with the date of filing of the complete specification:

Provided that no proceedings shall be taken in respect of an infringement committed before the date of the publication of the complete specification.

(2) The date of every patent shall be entered in the Register of Patents."

• Clause 26—Form, extent and effect of patent

463. Heading of the clause.—The marginal note to Section 21 of the U.K. Act corresponding to this clause reads "Extent, effect and form of patent" which is the same as in Section 12 of the Indian Patents and Designs Act, 1911 which the clause seeks to re-enact. Inasmuch as the patent is by sub-section (1) enacted to have effect throughout India, the word "extent" ought to appear in the marginal heading.

464. Sub-clause (1).—This corresponds to sub-sections (1) and (3) of Section 21 of the U.K. Act, 1949. Sub-section (1) of the U.K. Act contains a proviso for enabling assignments of patents to be made restricted to part only of the United Kingdom. This proviso does not find a place in the Indian Patents and Designs Act, 1911 and is omitted in Clause 26 of the Bill. No similar provision occurs either in the Australian or in the Canadian Acts. Having regard to the provision as to freedom of trade and commerce and intercourse within India enacted by Article 301 of the Constitution, the provision for assignment of a patent to have effect in part only of the territory in India might be very difficult to work and it has been correctly omitted in the Bill.

465. Sub-clause (2).—This reproduces the terms of Section 12(2) of the Indian Patents and Designs Act, 1911, which itself was based on Section 14(2) of the U.K. Patents and Designs Act, 1907. When this latter enactment was revised in 1949 the words "but the specification may contain more than one claim" were deleted [vide section 21(4) of the U.K. Patents Act, 1949]. The contents of a specification having already been fully defined, these words are out of place in this clause and may, therefore, be deleted from the sub-clause. The proviso to the sub-clause is in order and may be retained.

466. Sub-clause (3).—The Patents Enquiry Committee recommended in paragraph 165 of their Report that this provision should state that Government shall have the same rights and privileges as a private person. Sub-clause (3) is nearly in the same form as the present Section 21(1) of the Indian Patents and Designs Act, 1911. In its place, however, I would recommend the adoption of the form adopted in the Trade and Merchandise Marks Act, 1953, section 130 which runs:

"The provisions of this Act shall be binding on the Government."

It might be mentioned that the corresponding provision of the Australian Patents Act—Section 7—runs:

"This Act binds the Crown in right of the Commonwealth and of the several States."

If the form I have suggested were adopted there is no need to save the provisions of Chapter XI. As the expression "Government" is defined in the General Clauses Act to include both the Central and State Governments, it is not necessary to adopt the Australian form. The clause might run:—

"26. Form, extent and effect of patent.—(1) Every patent shall be in the prescribed form and shall have effect throughout India.

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

(3) The provisions of this Act shall be binding on the Government."

Clause 27—Rights of a patentee

467. This clause seeks to set out the rights of a patentee under a patent grant and appears to be based on the acceptance in part of the recommendations of the Patents Enquiry Committee. In their summary of recommendations (Chapter VIII, paragraph 9 at page 114) the Committee said:

"Rights of the patentee.—The Act should contain clear provision that—

- (a) in the case of a patented invention of any article, the patentee shall have the exclusive right to make, use and/or sell such article or to authorise others to do so.
- (b) in the case of a patented invention of a process, the patentee shall have the exclusive right to use such process and to use, and/or sell articles made by such process or to authorise others to do so, and
- (c) the exclusive right conferred by any patent shall be subject to rights already subsisting in respect of any other patent. (An "explanation" may be added stating that a new identical article shall, unless the contrary is proved, be presumed to have been made by identical process.)"

While Clause 27 adopts (a) and (b), it has omitted (c) and the Explanation suggested by the Committee.

468. The U.K. Patents Act, 1949 does not in the body of the enactment define the rights of a patentee but leaves it to be gathered from the terms of the Letters Patent. Section 21(3) of that enactment enables the patent to be in such form as may be prescribed. Rule 63 of the U.K. Patents Rules, 1949 directs it to be in the form set out in the third schedule. This however is not the mode adopted in Australia or in Canada or in the Indian Patents and Designs Act, 1911 (vide Section 69 of the Australian Act and Section 46 of the Canadian Patents Act and Section 12 of the Indian Patents and Designs Act, 1911). I think it would be of advantage to define as far as practicable the rights of a patentee in the Act itself so as to leave minimum scope for controversy on this matter.

469. It is universally the law that where the patent is in respect of an article or product *per se* the rights of a patentee extend to having an exclusive right to make, use, exercise or sell the invention which would include an exclusive right of importation of the product, and para (a) of the clause embodies this rule.

470. Where, however, the patent is not for an article but is solely for a process, the law in the U.K. is as set out in clause (b) *viz.*, that the protection would cover not merely the patented process but extend to the "article" made by the "use" of the process whether such "use" is within the country or abroad, so that importation or sale of an article made abroad by the patented process would be an infringement by the process patent.

471. The reason for the U.K. rule was stated in an early English decision *Wright v. Hitchcock* (1870, L.R. 5 Ex. 57 at p. 47) by Kelly C. B. thus:

"If the law were otherwise, then when a man has patented an invention, another might, by merely crossing the channel,

and manufacturing abroad and selling in London..... articles made by the patented process, wholly deprive the patentee of the benefit of his invention. It is therefore impossible to suppose that an exclusive right to vend is not given, and the defendants have therefore infringed the plaintiff's right...."

472. It has also been rested on the terms of the Letters Patent which contains a clause reinforcing the exclusive rights of the patentee by which "our subjects are strictly commanded.... that they do not... during the continuance of the said term either directly or indirectly make use of or put into practice the said invention or any part of the same...." see *Elmslie v. Bourcier* [1869 L.R. 9 Eq. 217; *Von Heyden v. Neustadt*. (1880) 14 Ch. D. 230].

473. A precisely similar view prevails in the U.K. as regards the analogous case of patents granted for machines which are used for the production of articles. Even where a claim is solely for a machine or apparatus, a product made by such machine or apparatus is treated as covered by the patent protection, so that not merely a manufacturer of the machine but also those who sell products made by the use of the machine whether within the country or abroad, are treated as infringing the patent. In this respect the law in the United Kingdom is in accordance with the law in France, Germany, Holland, the U.S.S.R. and other European countries as well as in Japan and in several of these countries the Patents Acts themselves contain specific provisions to that effect. I need only add that Australia and Canada follow the same rule as in the U.K.

474. The law in the United States is different and where the claim in a patent is for a process or for a machine, the sale of the product made by the use of the process or machine is not held to be an infringement, so that in effect an action for infringement of a process or a machine patent, would lie only against the manufacturer and not against those who sell goods obtained as a result of the manufacturer utilising the process or the machine. The rule was thus explained:

"A process patent is not infringed by selling the product, and the vendee of a product which has been made in infringement of a patented process cannot be held liable to the patentee, or in any extent to be an infringer"—(*American Gramophone Co. v. Gimbels Bros.* 234 Fed. at 368).

The broad proposition that the vendor of a product which has been made in infringement of a patented process is an infringer, or liable to any extent to the patentee, is untenable and does not require discussion. The patentee's remedy is against the manufacturer..... The patent... is one for a process, and not for a product. It describes a method of producing the Welsbach mantle..... to render it sufficiently hard and resistant to allow of transportation..... and any person is at liberty to vend or use the invention without accountability to the patentee, except he also be the manufacturer" (*Welsbach Light Co. v. Union Incandescent Light Co.* 101 Fed. at 131, 132). (Law of Chemical Patents by Thomas, Second Edition, p. 385).

These decisions arose out of patents for processes but similar rules govern the interpretation of the rights of parties where the claim in the patent is only for a machine.

475. It might at once be pointed out that the form of the patent grant in India under the Indian Patents and Designs Act, 1911 does not contain the injunction on 'the subjects' as in the U.K. Letters Patent "commanding them not to put into practice the invention *directly or indirectly*" or the provision as to the "whole profit or advantage" of the invention being assured to the inventor so that it would not be correct to assume that the Indian courts would, if a case arose in respect of an Indian Patent, apply with certainty the U.K. rule. It is hardly necessary to mention that no case has arisen for such decision being rendered.

476. The matter is thus *res integra* and there would therefore be no impediment in the shape of vested rights in the choice of a particular rule which would advance the national economy.

477. Undoubtedly the American rule is more logical in that the scope of the protection afforded by the law is co-extensive with the scope of the invention and the claim. The question, however, as to the rule of law to be adopted must ultimately depend not upon fine considerations of the theoretical justification for the particular view—for arguments could be found for any view—but upon what is really of benefit to the country bearing in mind the general pattern of industrial development.

478. The question as to the system of patent protection to be preferred, assumes added importance, in view of my recommendation that in a large field of invention—products obtained by chemical methods and articles of food and medicine—only process claims should be permitted. This taken in conjunction with the fact that a large majority of the patents in these lines are held by foreign nationals who are inclined to utilise the Indian Patents as a means for securing to them a monopoly of importation of the patented articles manufactured by them abroad, would appear to point to the desirability of the adoption of the American rule. It would be seen that under that rule, since a patent for a process confers merely an exclusive right to use the patented process, and not any exclusive right to sell the product made by the process, the importation of the product made abroad by the patented process and its sale would not constitute an infringement of the process patent. The result would be that as any one was free to import the article and sell it, the competition would lead to a reduction in price, and this would be particularly so in cases where the article is produced in countries where the invention patented in India does not enjoy patent protection. In the case of products which are essential to industrial production, for instance, some of the chemicals or essential drugs, this would be of considerable benefit to the country's industrial advance or to national health.

479. This advantage however has to be judged in the light of certain of the ill-effects of such a state of the law. The economic rationale behind the rule that sales within the country of articles manufactured abroad by a patented process constitutes an infringement is, as explained by Kelly C. B. in the passage already extracted, the need to protect one who started an industry within the

country from competitors abroad who had copied the patented process. Thus the American rule, while protecting the patentee against rival manufacturers within the country, leaves the indigenous industry without protection against manufacture abroad. In effect such a rule would handicap the starting of industries within the country, by removing the embargo which the U.K. patent rule imposes on importation of the patented article from abroad.

480. In the U.S.A., however, this ill-effect is avoided by administrative action—the use of the tariff, in cases where the product could be produced at a cheaper price in a foreign country. There would thus be some amount of illogicality between the adoption of the American rule and the provisions of the chapter on compulsory working—for in the latter the importation of a patented article without manufacturing it in this country is treated as an abuse which would justify the grant of a compulsory licence to work the invention.

481. In India also, if by administrative action, operating almost automatically, imports of the patented articles, the manufacture of which is commenced within the country, could be so regulated as to afford an assured market for home-produced goods, the adoption of the American rule would be beneficial. Such procedure would, while eliminating competition within the country by the protection against infringement afforded by the Patents Law, regulate competition from imported products as to confine it to the demand unsatisfied by local manufacture. This would impart a degree of flexibility achieving at the same time the grant of sufficient economic protection to Indian industry and the safeguarding of the interests of the consumer.

482. Much as I would have desired to recommend the American rule for adoption by this country I feel deterred from doing so for the reason that it is not easy to realise an administrative mechanism operating in the manner I have indicated. In these circumstances I recommend the adoption of the rule of law followed in the U.K. and other European countries as the one best suited to the needs of a country whose interests demand urgently the working of patented inventions within as short a time as possible and to the fullest extent reasonably practicable.

483. Next as to burden of proof in actions for infringement, where the patent infringed was for a product, as made by a process specifically described, the Committee desired in effect to introduce the same provision as was found in Section 38-A of the U.K. Patents Act, 1907. This proviso ran:—

"Provided that, in an action for infringement of a patent where the invention relates to the production of a new substance, any substance of the same chemical composition and constitution shall in the absence of proof to the contrary be deemed to have been produced by the patented process".

(This proviso to sub-section (1) was, with the first two words omitted, renumbered as sub-section (2) of Section 38A by the Amending Act of 1932). I do not see any reason to recommend the adoption of such a provision. From its text it would be obvious that it was closely bound up with the special form of claiming for chemical products

Amendment to Section 38-A(1) by the U.K. Patents and Designs Amendment Act of 1919, and since on my scheme there would be no absolute or limited product claims for chemical substances, there is no need for the enactment of this special rule as to onus. In regard to the patents now on the register, in which claims might have been drafted in the Section 38-A form, I would prefer to leave the law unchanged for the reason that as it is, it is fair.

484. Apart from any specific statutory provision, the position is that where the defendant has used or sold articles alleged to have been made by the patented process, the onus of proving that they were in fact made by that process would be on the plaintiff.

485. To quote Terrell—

"In *Cartsburn Sugar Refining Co. v. Sharp* (1 R.P.C. 181) the alleged infringement consisted in the sale in England of cube sugar manufactured in America by a machine made in accordance with the specification of the complainers' (i.e. the plaintiffs') patent. Lord Kinnear, in his judgment, said (1 R.P.C. 186): "No witness has been examined of sufficient skill as a mechanic to give a detailed description of the machine in question. All that is proved is that it does not correspond in all respects, though in some respects it does correspond, to the description in Hersey's patent. It is said that as the manufacture complained of had taken place in America, it was incumbent on the respondents, upon the principle which received effect in the case of *Neilson v. Betts* (L.R. 5 H.L.), to prove by negative evidence that it was not manufactured according to the specified process. I think no such onus lies upon the respondents in the present case, because there can be no question on the evidence that such articles as were sold by the respondents MAY HAVE BEEN produced by machinery which involved no infringement of the complainer's patent. That being so, it lay upon the complainers to prove their case, and as they took a commission to America for the purpose of proving it, there could have been no difficulty in their obtaining a sufficient description of the machine to which it is alleged they have traced the cubes of sugar sold by the respondents to enable them to establish the infringement, if infringement there was.

But where the articles were made abroad, and the plaintiffs in consequence could not be afforded full opportunity of inspecting the machinery by which they were made, it was held that it lay with the defendants to rebut a *prima facie* case made out by the plaintiffs. (19 R.P.C. 169).

In the various Saccharin cases (19 R.P.C. 169) the plaintiffs were the owners of patents which covered all known processes of making saccharin. They were able to produce evidence to the effect that although it was conceivable that saccharin might be made in some other way, no other processes were then known to the scientific world. The defendants, who imported saccharin, could not give any satisfactory account of the way in which the

imported substance was actually made. It was held that infringement had been established"—(Terrell on Patents, Ninth Edition, pages 159-160).

486. I consider the rule as to the burden of proof enunciated in the decisions referred to in the above extract, just and fair both to the patentee and the alleged infringer, and that there is no need for any legislative interference.

487. The other matter which the Committee desired to be included in the clause is in relation to saving the rights of prior patentees. Such a provision I have not been able to find in the Patent Laws of any country and in my opinion it is not necessary either. If any claim of a subsequently granted patent overlaps or is anticipated by an earlier patent grant it would be open to the prior patentee to take proceedings to have the later patent revoked in part or in whole, to the extent of the overlap. There is therefore no need for any specific saving in regard to the rights of prior patentees.

488. There is, however, one matter in connection with the right of patentees which requires to be clarified—the right of research workers to use the invention—whether it be an article or a process—for the purposes of carrying out experiments—in the course of research, as distinguished from use for a commercial purpose. Before proceeding further, I shall extract a passage from Blanco White's treatise on Patents to indicate the uncertainty of the law on this topic in the U.K.:

"... Mere experiment with a patented invention would appear not to amount to infringement; but it is the patent itself that must be the subject of experiment and not (for instance) the product of a patent process. And it would seem that a claim of right to exercise the invention may convert an experimental exercise into an actionable threat to infringe" (page 76).

I consider it desirable that the law should specifically exempt use of the patented articles or processes or the use of articles or products made by the use of the patented process or patented machine or apparatus for experimental purposes from being actionable as an infringement.

489. In *United Telephone Co. v. Sharples* (2 RPC 28) it was held that the use of an infringing article for the purpose of instructing pupils—pulling out the article to pieces and putting them together—was not a 'mere experimental user' and amounted to an infringement. It appears to me that such use is really experimental use and that the construction of the patentee's rights adopted in that decision as unduly hampering technical education. Even in the United Kingdom the *United Telephone Co. v. Sharples* decision is treated as a 'border line case' (See Blanco White on Patents for Inventions, page 71 note 45)—as an instance where it could have been held that the 'use' was not use as an article of the sort covered by the patent. The insertion of the words 'including the use of the patented article or process for the purpose of imparting instruction to pupils' in the clause would avoid this interpretation.

490. There is also need for a further saving in regard to the operation of other laws. For instance, it has been pointed out that

while the Patents Act purports to authorise a patentee to make, use or exercise his invention subject only to the provisions of the Indian Patents and Designs Act, 1911 the Industries (Development and Regulation) Act, 1951 imposes fetters upon the starting of an industry not excepting those for working a patented invention. Again, while the grant of a patent enables a patentee either to exercise the invention himself or to authorise others to do so, subject only to the provisions of the Indian Patents and Designs Act, 1911, the Foreign Exchange Regulation Act, 1947 imposes restrictions upon the transmission of funds by both the patentee as well as those authorised by them to work the inventions. There is no doubt that these two enactments the Industries (Development and Regulation) Act, 1951 and the Foreign Exchange Regulations Act, 1947 would override the rights conferred on a patentee by the Indian Patents and Designs Act, 1911. I have referred to these two enactments but this is not exhaustive (*vide*, for instance, the Drugs Act, 1940). The matter may be put beyond doubt by a specific provision subjecting the rights of a patentee to the provisions of other laws, laws other than the Indian Patents and Designs Act, 1911.

491. The form of the Letters Patent to be issued under the Act may be suitably amended to accord with the rights conferred on the patentee by the statute.

492. I would suggest the following redraft of Clause 27 for this purpose:—

- "27. Rights of a patentee.—(1) Subject to the provisions of this Act, a patent granted either before or after the commencement of this Act, shall confer upon the patentee:
- (a) where the patent is for an article or substance, the exclusive right by himself, his agents or licensees to make, use, exercise, sell or distribute such article or substance in India;
 - (b) where a patent is for a process of manufacturing an article or substance the exclusive right by himself, his agents or licensees to use or exercise the process in India and of using or selling in India articles or substances made by such process and of authorising others so to do.
- (2) Notwithstanding anything in this Act, the making or using of a patented machine or apparatus or other article, or the use of a patented process or the use of an article made by the use of the patented process, machine or apparatus for the purposes merely of experiment or research including the imparting of instruction to pupils and not by way of commercial use, shall not be deemed to constitute an infringement of the rights conferred on a patentee by this Act."
- (3) The rights conferred on the patentee by this section shall be exercisable only subject to the provisions of any other law in force.

Clause 28—Patent obtained in fraud of the true and first inventor

493. This clause is a reproduction of Section 13(2) of the Indian Patents and Designs Act, 1911. The provision in the Indian Patents

and Designs Act, 1911 was based upon Sections 17(2) and 15(2) to 15(4) of the U.K. Patents and Designs Act, 1907. The Australian Patents Act, 1952 contains provisions similar to Section 15(2) to 15(4) of the U.K. Act of 1907 [*vide* Section 60(3) and Section 107] with slight modifications to adapt them to the system of priority dates of claims which forms a feature of the Australian Patents Law, the only point of difference between them being that the Australian Act includes additional provisions applicable to cases where fraudulently obtained patents are revoked as a result of surrender.

494. When the U.K. Patents law was revised by the Swan Committee, they recommended the retention in substance of the provision in Section 15(2) to 15(4) with however slight verbal changes (*vide* paragraph 201 of their final Report). When the U.K. Patents Bill was introduced in the House of Lords, sub-sections (2) to (4) of Section 15 of the earlier enactment was dropped and in its place the provision in Section 53 of the Act was introduced. Section 53 of the U.K. Patents Act, 1949 effects considerable changes in the previous law. Whereas under Section 15 of the U.K. Patents Act, 1907 the applicant from whom the invention had been obtained is granted a patent in lieu of the patent so revoked (as under Clause 28 of the Bill), Section 53 of the U.K. Patents Act, 1949 provides merely for an earlier priority date being available to the applicant whose invention has been "obtained". This makes a difference because where a patent is granted in lieu of the revoked patent, there would be no opposition whereas in the procedure contemplated by Section 53 of the U.K. Act, the only advantage which the successful opponent or successful petitioner for revocation on the ground of "obtaining" would derive, is as regards the priority date for the purpose of determining anticipation or novelty of his application.

495. Section 53 of the U.K. Act, 1949 applies the same rule, *viz.*, conferring a priority date both to cases where a patent already granted is revoked on the ground of "obtaining" and where an opposition succeeds on that ground. I consider that a distinction should be drawn between these two types of cases and while the rule as to the assignment of an earlier priority date is apt and just, in cases where the matter remains at the stage of an application for a patent, the grant of a patent to the aggrieved inventor in lieu of the patent revoked is the proper relief that should be granted in cases of revocation of patents. If the former rule were applied to cases of revocation, the duration of the patent would for no fault of the public, be unduly enlarged and on this ground, I would favour the rule as found in Section 15(2) of the U.K. Act of 1907.

496. To give effect to this recommendation the clause might be split up into two, one dealing with cases of successful revocation on the ground of obtaining and the other with cases where an opposition succeeds on that ground.

497. In regard to the provision dealing with cases of revocation, there is a possibility of petitions by others besides the petitioner who complain of "obtaining" being filed and these several petitions being disposed of by a common order. Some or all of the claims relating to the grant of the invention held to have been "obtained" might possibly have been held invalid on other grounds. If the

right of the petitioner to obtain a patent in lieu of the whole or part of the patent revoked is made dependent on an order of the Court passed in the proceeding for revocation, all these contingencies would be effectively provided for.

498. In regard to the case of a successful opposition on ground of "obtaining", a provision on the lines of Section 53 of the U.K. Act, 1949 would be appropriate. The following draft would implement these suggestions:

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

(2) Where such order has been passed the following provisions shall have effect:—

The Controller shall on request by the petitioner made in the prescribed manner grant to him—

(1) In cases where the Court permits the whole of the patent to be granted, a new patent which will bear the same date and number in lieu of the patent revoked;

(2) in cases where the Court permits a part only of the patent to be granted, a new patent for such part and bearing the same date as the patent revoked; ;

Provided that the Controller shall as a condition of such grant require the petitioner to file a new complete specification to the satisfaction of the Controller describing and claiming that part of the invention for which the patent is being granted:

Provided further that the patent so granted to the petitioner shall be numbered as prescribed by the rules."

"28A. Priority date etc. in case of 'obtaining'.—(1) Where in any opposition proceeding under this Act—

(a) the Controller finds that the invention so far as claimed in any claim of the complete specification was obtained from the opponent in the manner set out in sub-section (1) (a), of Section 21 and refuses the application on that ground, he may, on request by such opponent made in the prescribed manner, direct that the application shall proceed in the name of the opponent as if the application and the specification

had been filed by the opponent on the dates on which they were actually filed;

(b) the Controller finds that a part of an invention described in the complete specification was so obtained from the opponent and has required that the specification be amended by the exclusion of that part of the invention, the opponent may, subject to the provisions of the succeeding sub-section, file an application in accordance with the provisions of this Act accompanied by a complete specification for the grant of a patent for the invention so excluded from the applicant's specification. The Controller may treat such application and specification as having been filed, for the purposes of the provisions of this Act relating to the priority dates of claims of the complete specification, on the date on which the corresponding document was or was deemed to have been filed by the earlier applicant but for all other purposes the application of the opponent shall be proceeded with as an application for a patent under this Act.

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

Clause 29—Term of Patent

499. This clause in terms reproduces the existing section 14(1) and (2) of the Indian Patents and Designs Act, 1911. Its provisions correspond to sub-sections (3) to (5) of Section 22 of the U.K. Patents Act, 1949 though expressed in somewhat different phraseology.

500. The proviso to sub-clause (2) reads as if the request, the prescribed fee and the prescribed additional fee referred to in it might be made, or paid even after the expiry of the extended period, which is certainly not the intention and this might be clarified by adopting the U.K. form which puts it beyond doubt.

501. I would suggest a slight drafting change in sub-clause (1) by substituting the words "Subject to the provisions of this Act" for the words "Save as otherwise expressly provided by this Act". The reason is that the words in the clause are intended to cover the case of the extension of the term of sixteen years for which provision is made under clause 30 of the Bill. In view of my recommendation