

OPPOSITION

TYPES OF OPPOSITION

- PRE-GRANT
OPPOSITION [SEC 25(1)]
- POST-GRANT
OPPOSITION [SEC. 25 (2)]
- REVOCATION [SECS 64 TO 66]

GROUND FOR OPPOSITION UNDER SECTIONS 25(1) & 25 (2)

- That the applicant for the patent [that the patentee] or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;
- That the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim --
 - (i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912, or;
 - (ii) in India or elsewhere, in any other document;provided that the ground specified in sub clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub section (2) or sub section (3)
of Section 29

ANTICIPATION – SEC.29

Anticipation by previous publication

- Shall not be deemed to have been anticipated by reason only that ----
 - The invention was published and dated before the 1st day of January, 1912;
 - The invention was published before the priority date of the relevant claim, provided if it is proved that;
 - That the matter published was obtained from him without his consent, and
 - That the application was filed as soon as reasonably practicable thereafter [shall not apply if the claim was commercially worked in India]

GROUND FOR OPPOSITION

- That the invention so far as claimed in any claim of the complete specification is claimed in any claim of a complete specification published on or after the priority date of the applicant's claim[claim of the patentee] 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[patentee's] claim;

GROUND FOR OPPOSITION

- That the invention so far as claimed in any claim of the complete specification Was publicly known or publicly used in India before the priority date of that claim
- EXPLANATION

For the purpose of this clause, an invention relating to a process which a patent is claimed[granted] shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only;

ANTICIPATION BY PUBLIC DISPLAY ETC., SEC 31

- the above An invention claimed in a complete specification shall not be deemed to have anticipated by reason only of;
 - ✓ Displayed or used or published with or without the consent of the applicant at an Industrial or other Exhibition, notified by the Central Govt., in an Official Gazette or
 - ✓ The description of the invention in a paper read by the first and true inventor before a learned society or published with his consent in the transactions of such a society
 - ✓ Condition:- should have been applied for a patent within 12 months of actions.

ANTICIPATION BY PUBLIC WORKING – SEC 32

- An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that at any time within ONE YEAR before the priority date of the relevant claim of the specification, the invention was publicly worked in India -----
- ❖ By the patentee or applicant for the patent or any person from whom he derives title; or,
- ❖ By any other person with the consent of the patentee or applicant for patent or from any person from whom he derives title;
- ❖ If the working was effected for the purpose of reasonable trial only and if it was reasonably necessary, having regard to the nature of the invention, that the working for that purpose should be effected in public.

ANTICIPATION BY USE AND PUBLICATION AFTER PROVISIONAL SPECIFICATION – SEC 33

- Filing the complete specification after filing the provisional specification or
- Converting the complete specification into the provisional specification – Sec 9(3)
- The invention as claimed is not treated as anticipated when the said invention was used in India, or published in India or elsewhere at any time after filing the provisional but before filing the complete specification
- In the case of convention application the use or publication of said invention in India before filing in India but after the priority date[protection date] is not treated as anticipated

GROUND FOR OPPOSITION

- That the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the applicant's [patentee's] claim;

GROUND FOR OPPOSITION

- That the subject of any claim of the complete specification is not an invention within meaning of this Act, or is not patentable under this Act;
- That the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

GROUND FOR OPPOSITION

- That the applicant has failed to disclose to the Controller the information required by Section 8 or has furnished the information which in any material particular was false to his knowledge;
- That in case of convention application, the application was not made within 12 months from the date of the first application for protection for the invention made in a convention country[or In India] by the applicant[patentee] or a person from whom he derives title;

GROUND FOR OPPOSITION

- That the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;
- That the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere;
- But on no other ground.

PRE-GRANT OPPOSITION

BY WAY OF REPRESENTATION

PRE-GRANT OPPOSITION

SEC. 25(1) & RULE 55 (1 TO 6)

- ❖ If interested shall be filed only after publication under Sec 11 (A), that is 18 month publication, but before the date of grant
- ❖ Only by way of Representation
- ❖ Any person can file opposition
- ❖ No fee and no prescribed form
- ❖ Hearing may be requested for

PRE-GRANT OPPOSITION

RULE 55 (1 TO 6)

- 55 (1) : shall be filed at appropriate office
shall include a statement and
evidence, if any, and
a request for hearing, if so desired
- 55 (1-A): No patent shall be granted before
the expiry of 6 months period from the date
of publication under Sec 11(A).

PRE-GRANT OPPOSITION

RULE 55 (1 TO 6)

- 55(2) : Controller shall consider such representation only when a request for examination has been filed
- 55(3) : Controller either refuse or feels that amendments are required shall notify the applicant.

PRE-GRANT OPPOSITION

RULE 55 (1 TO 6)

- 55(4) : If the applicant is desirous to contest he may file his statement and evidence, if any, within 3 months from the date of notice.
- 55(5) : Upon consideration of facts the Controller either refuse or require the application to be amended

PRE-GRANT OPPOSITION

RULE 55 (1 TO 6)

55 (6) :After considering the representation and submission made during the hearing if so requested, the Controller shall proceed further simultaneously either rejecting the representation and granting the patent or accepting the representation and refusing the grant of the patent on that application, ordinarily, within ONE MONTH from the completion of the above proceedings

POST-GRANT OPPOSITION

POST-GRANT OPPOSITION

- At any time after the grant of patent before the expiry of a period of ONE YEAR from the date of publication of grant of patent
- Only the PERSON INTERESTED can file
- Prescribed form is form-7; fee Rs 2400/- or Rs.6000/-or Rs. 12000/- as applicable

POST-GRANT OPPOSITION

RULES 55A TO 63

- 55-A : Filing of Notice of Opposition
Form – 7 in duplicate
- 56 : Constitution of Opposition Board
3 members [examiners], out of 3 one
is the Chairman of the Board
The examiner who examined the
application can not become the member

Board shall submit its joint recommendation within 3 months from the date on which the documents [rules 57 to 60] were forwarded.

POST-GRANT OPPOSITION

RULES 55A TO 63

- 57 : Opponent shall send a written statement and evidence, if any along with notice of opposition [Form 7] & shall deliver a copy to the patentee
- 58 : Patentee, if desired to contest, shall file a reply statement & evidence, if any, within 2 months from the date of receipt & deliver a copy to the opponent. If not responded, the patent is abandoned

POST-GRANT OPPOSITION

RULES 55A TO 63

- 59 : Opponent may file reply evidence strictly confined to matters in the Patentee's evidence within one month from the date of delivery & a copy shall be sent to the patentee
- 60 : No further evidence shall be delivered by either party except with the leave or directions of the Controller [such prayer is allowed only before the hearing date is fixed by the Controller]

POST-GRANT OPPOSITION RULES 55A TO 63

61 : All the copies shall be filed in
Duplicate.

If any document is in any language
other than English, a translation in
English shall be provided.

POST-GRANT OPPOSITION

RULES 55A TO 63

62 HEARING

- ☐ After the actions of the above rules the Controller fixes a date for hearing.
- ☐ Controller shall give not less than 10 days notice of such hearing
- ☐ Board members may or may not be present during the hearing
- ☐ If any party desirous to be present in the hearing, shall inform the Controller by a notice [no specified form] along with a fee of Rs. 1500/- or Rs.6000/- as applicable.

POST-GRANT OPPOSITION RULES 55A TO 63

- HEARING

If either party intends to rely on any publication at the hearing not already mentioned in the notice, statement or evidence, he shall give to the other party and to the Controller not less than 5 days' notice of his intention, together with details of such publication.

POST-GRANT OPPOSITION

RULES 55A TO 63

- HEARING

After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without hearing, and after taking into consideration the recommendation of Opposition Board, the Controller shall decide the opposition and notify his decision to the parties giving reasons therefor.

POST-GRANT OPPOSITION

RULES 55A TO 63

63 : DETERMINATION OF COSTS

If the patentee notifies the Controller that he desires to withdraw the patent after the notice of opposition is given, the Controller depending upon the merits of the case, may decide whether costs should be awarded to the opponent

“OBTAINING”

A SPECIAL CASE [SEC. 26(1)]

SECTION 25 (2)(a)

- Whole or part of the invention is obtained
- Revoke the patent on request by the opponent
- Patent shall stand amended in the name of the opponent
- Or Controller may ask the applicant to amend the specification by exclusion of that part of the invention

“OBTAINING”

A SPECIAL CASE [SEC. 26(2)]

- Before the date of the order of the Controller, imagine that
- The opponent has filed an application for patent disclosing the whole or part of the invention thus obtained by the applicant and the application is pending before the Patent Office;
- Irrespective of disclosure by the applicant, the opponent’s application shall be proceeded with as an application for the patent under the Act.

“OBTAINING” A SPECIAL CASE [RULE 63A]

- Request shall be made on Form – 12
- Fee of Rs.2400/- or Rs.6000/-or Rs 12000/- as applicable [10% extra for physical filing]
- Within 3 months from the date of order of the Controller [Section 26(1)]
- Shall be accompanied by a statement setting out the facts upon which the petitioner relies and relief he claims.

REVOCATION

SECTION 64 TO 66

WHO CAN FILE FOR REVOCATION?

- PETITION BY ANY PERSON INTERESTED,
OR
- BY THE CENTRAL GOVERNMENT, OR
- BY THE APPELLATE BOARD, OR
- ON A COUNTER CLAIM IN A SUIT FOR
INFRINGEMENT OF THE PATENT BY THE
HIGH COURT

ON ANY OF THE GROUNDS AS MENTIONED

GROUND FOR REVOCATION

- (a) that the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in India;
- (b) that the patent was granted on the application of a person not entitled under the provisions of this Act to apply there for

GROUND FOR REVOCATION

- © that the patent was obtained wrongfully in contravention of the rights of the petitioner or any person under or through whom he claims;
- (d) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;

GROUND FOR REVOCATION

- (e) that the invention so far as claimed in any claim of the complete specification is not new, having regard to what was publicly known or publicly used in India before the priority date of the claim or what was published in India or elsewhere in any of the documents referred to in Section 13;
- Sec 13 is for prior publication / prior claim

GROUND FOR REVOCATION

- (f) that the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step; having regard to what was publicly known or publicly used in India or what was published in India or elsewhere before the priority date of the claim;
- (g) that the invention, so far as claimed in any claim of the complete specification is not useful;

GROUND FOR REVOCATION

- (h) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in and average knowledge of the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing, it which was known to the applicant for the patent and for which he was entitled to claim protection

GROUNDNS FOR REVOCATION

- (i) that the scope of any claim of the complete specification, is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;
- (j) that the patent was obtained on a false suggestion or representation;
- (k) that the subject of any claim of the complete specification is not patentable under this Act

GROUND FOR REVOCATION

- (l) that the invention so far as claimed in any claim of the complete specification was secretly used in India, otherwise than as mentioned in sub section 3 of section 64, before the priority date of the claim;
- (m) that the applicant for the patent has failed to disclose to the Controller the information required by Section 8 or has furnished information which in any material particular was false to his knowledge;

GROUNDNS FOR REVOCATION

- (o) that leave to amend the complete specification under Section 57 or Section 58 was obtained by fraud;
- (p) that the complete specification does not disclose or wrongfully mentions the source or geographical origin of biological material used for the invention;
- (q) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere;

REVOCATION-SEC 64(4)

- A patent may be revoked by the High Court on the Petition of the Central Government, if the High Court is satisfied that the patentee has without reasonable cause failed to comply with the request of the Central Government to make, use or exercise the patented invention for the purposes of Government upon reasonable terms.[Refer Sec 99 & sec 47]

REVOCATION-SEC 64(5)

A notice of any petition for revocation of a patent under section 64 shall be served on all persons appearing from the register to be proprietors of that patent or to have shares or interests therein and it shall not be necessary to serve a notice on any other person

REVOCATION-SEC 65

- After the grant of a patent, if the Central Government feels that the invention is related to Atomic Energy, it may direct the Controller to revoke the patent.
- Before revoking an opportunity of being heard shall be given to the patentee.
- Controller may allow the patentee to amend the specification so as the revocation may be avoided.

REVOCATION-SEC 66

[in public interest]

- Where the Central Government is of the opinion that a patent or the mode in which it is exercised is mischievous to the State or generally prejudicial to the public; it may, after giving the patentee an opportunity of being heard, make a declaration to that effect in the Official Gazette and thereupon the patent shall be deemed to be revoked.

REVOCATION-SEC 85

[UNDER COMPULSORY LICENCE]

- Any person interested may apply for revocation after the expiry of TWO YEARS from the date of grant of first CL on the grounds;
- Patented invention has not been worked in the territory of India; or
- That the reasonable requirements of the public has not been satisfied; or
- The patented invention is not available to the public at a reasonably affordable price.
- Decided within ONE YEAR from the date of filing

**THANKS FOR YOUR
ATTENTION**