

Patents (Amendment) Act, 2005

Section 23 - Substitution of New Sections for Sections 25 and 26

For sections 25 and 26 of the principal Act, the following sections shall be substituted, namely:- "25. Opposition to the patent.-- (1) Where an application for a patent has been published but a patent has not been granted, any person may, in writing, represent by way of opposition to the Controller against the grant of patent on the ground of- (a) patentability including novelty, inventive step and industrial applicability, or (b) non-disclosure or wrongful mentioning in complete specification, source and geographical origin of biological material used in the invention and anticipation of invention by the knowledge, oral or otherwise available within any local or indigenous community in India or elsewhere, and the Controller shall consider and dispose of such representation in such manner and within such period as may be prescribed. (2) Notwithstanding anything contained in sub-section (1), the person making a representation referred to in that sub-section shall not become a party to any proceedings under this Act only for the reason that he has made such representation. (3) At any time after the grant of patent but before the expiry of a period of one year from the date of publication of grant of a patent, any person interested may give notice of opposition to the Controller in the prescribed manner on any of the following grounds, namely:- (a) 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; (b) 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; (c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the 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 claim of the patentee; (d) 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 purposes of this clause, an invention relating to a process for which a patent is 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; (e) 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 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 this Act; (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 patentee 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; (i) that in the case of a patent granted on convention application, the application for patent was not made within twelve months from the date of the first application for protection for the invention made in a convention country or in India by the patentee or a person from whom he derives title; (j) that the complete specification does not disclose or wrongly mentions the source and geographical origin of biological material used for the invention; (k) 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, but on no other ground. (4) (a) Where any such notice of opposition is duly given under sub-section (3), the Controller shall notify the patentee. (b) On receipt of such notice of opposition, the Controller shall, by order in writing, constitute a Board to be known as the Opposition Board consisting of such officers as he may determine and refer such notice of opposition along with the documents to the Board

for examination and submission of its recommendations to the Controller. (c) Every Opposition Board constituted under clause (b) shall conduct the examination in accordance with such procedure as may be prescribed. (5) On receipt of the recommendation of the Opposition Board and after giving the patentee and the opponent an opportunity of being heard, the Controller shall order either to maintain or to amend or to revoke the patent. (6) While passing an order under sub-section (5) in respect of the ground mentioned in clause (d) or clause (e) of sub-section (3), the Controller shall not take into account any personal document or secret trial or secret use. (7) In case the Controller issues an order under sub-section (5) that the patent shall be maintained subject to amendment of the specification or any other document, the patent shall stand amended accordingly. 26. In cases of "obtaining" Controller may treat the patent as the patent of opponent (1) Where in any opposition proceeding under this Act the Controller finds that- (a) the invention, so far as claimed in any claim of the complete specification, was obtained from the opponent in the manner set out in clause (a) of sub-section (3) of section 25 and revokes the patent on that ground, he may, on request by such opponent made in the prescribed manner, direct that the patent shall stand amended in the name of the opponent; (b) a part of an invention described in the complete specification was so obtained from the opponent, he may pass an order requiring that the specification be amended by the exclusion of that part of the invention. (2) Where an opponent has, before the date of the order of the Controller requiring the amendment of a complete specification referred to in clause (b) of sub-section (1), filed an application for a patent for an invention which included the whole or a 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 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 patentee in the earlier application but for all other purposes the application of the opponent shall be proceeded with as an application for a patent under this Act."