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Secrecy directions and Restoration of Patents

CS Meenakshi Jayaraman



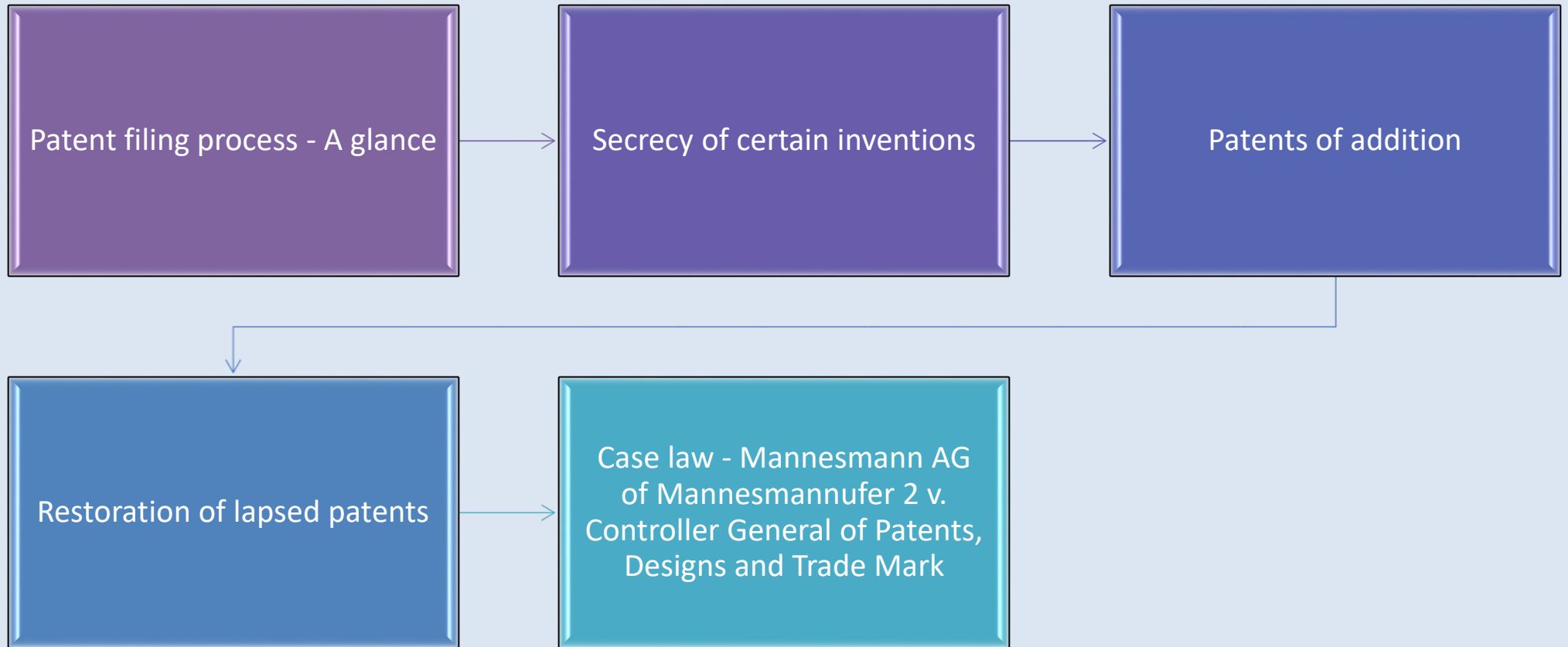


Research Credits



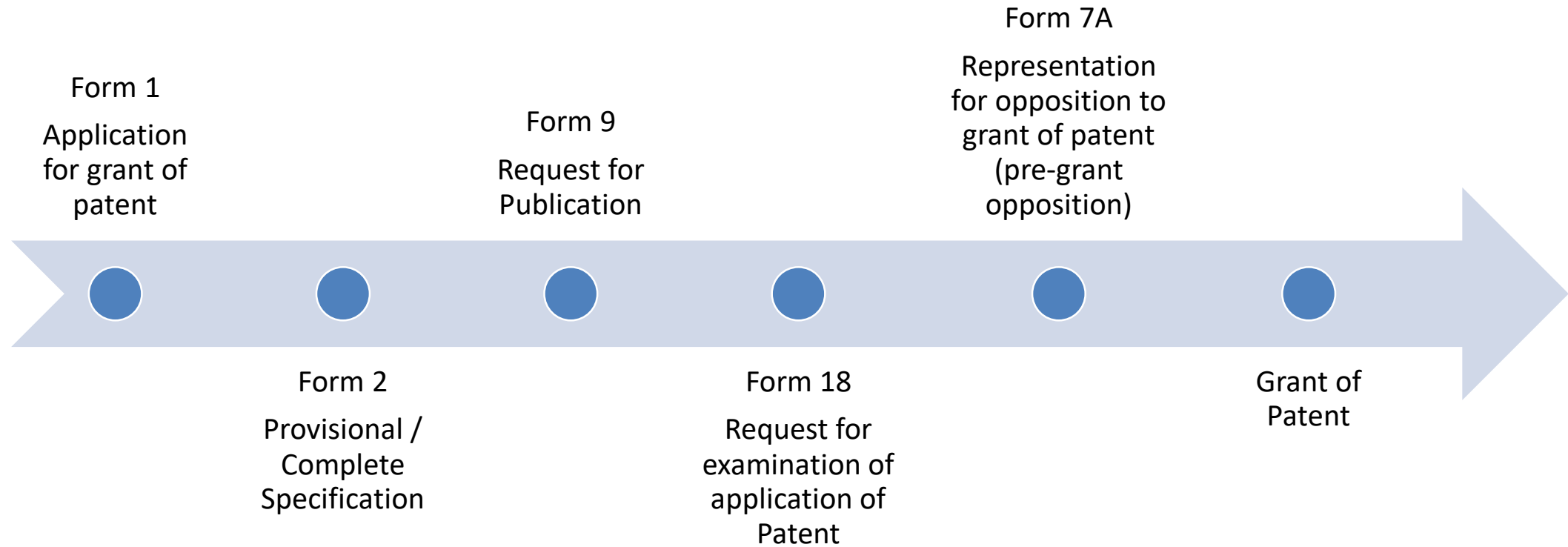
Iswariya BS
Hari Saanthosi. R

Presentation Schema



Patent filing process

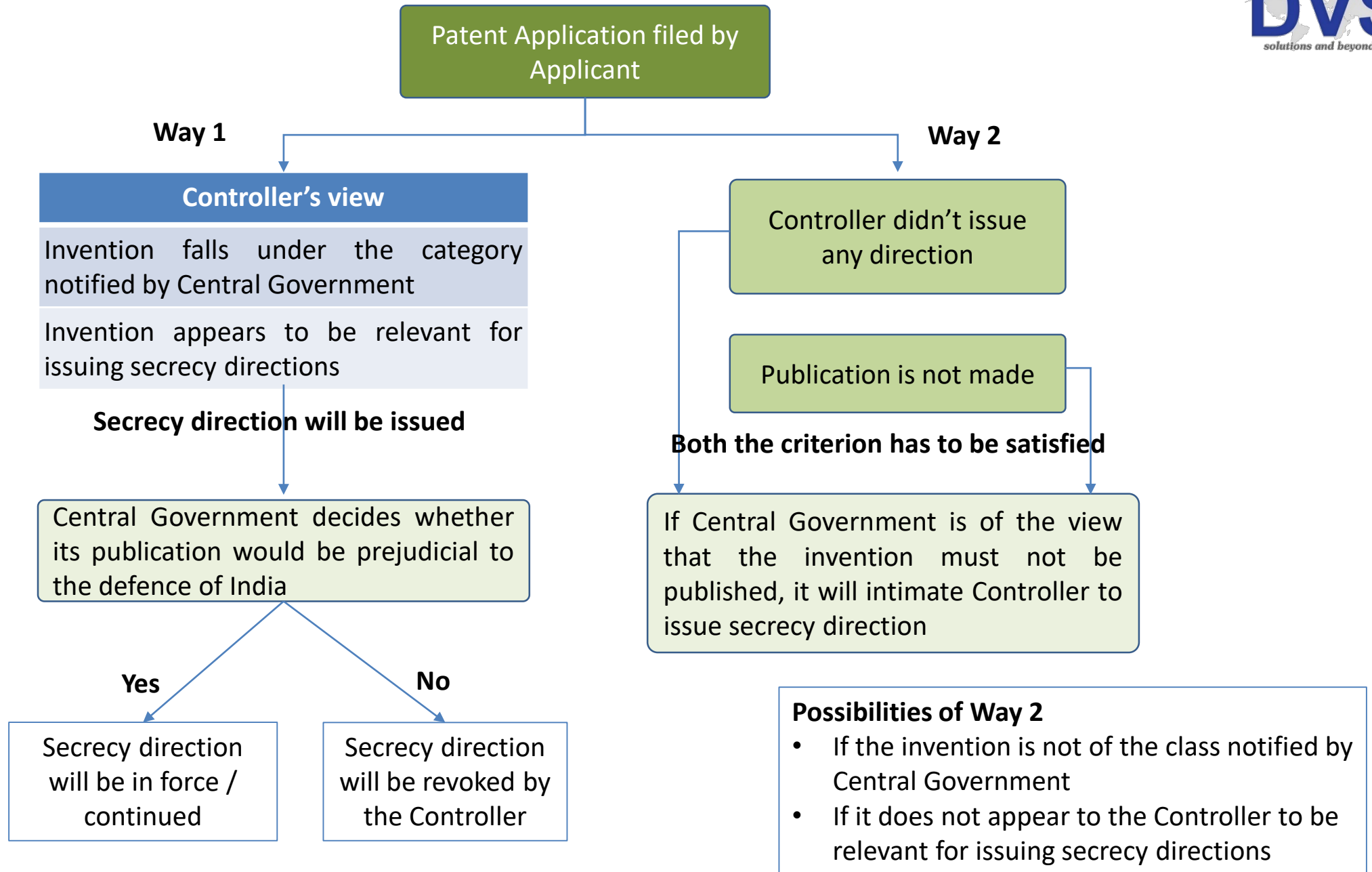
Patent filing process - A glance



Patent filings can be made either in e-mode in IP India official website or through physical mode by submitting in the respective Patent office
Fee for physical mode is 10% higher than e-mode (First Schedule)

Secrecy of certain inventions

Ways to issue secrecy directions



Points to be noted for issue of Secrecy directions

Neither the Act nor the Rules provide time limit for issuing secrecy direction

Such direction has to be issued before publication / receipt of application for publication from the applicant

Form 1 + Form 2 at the time of application

Time to issue secrecy directions (in general) – 18 months from the date of application / priority date

Form 1 + Form 2 at the time of application

Form 9 (request for publication)

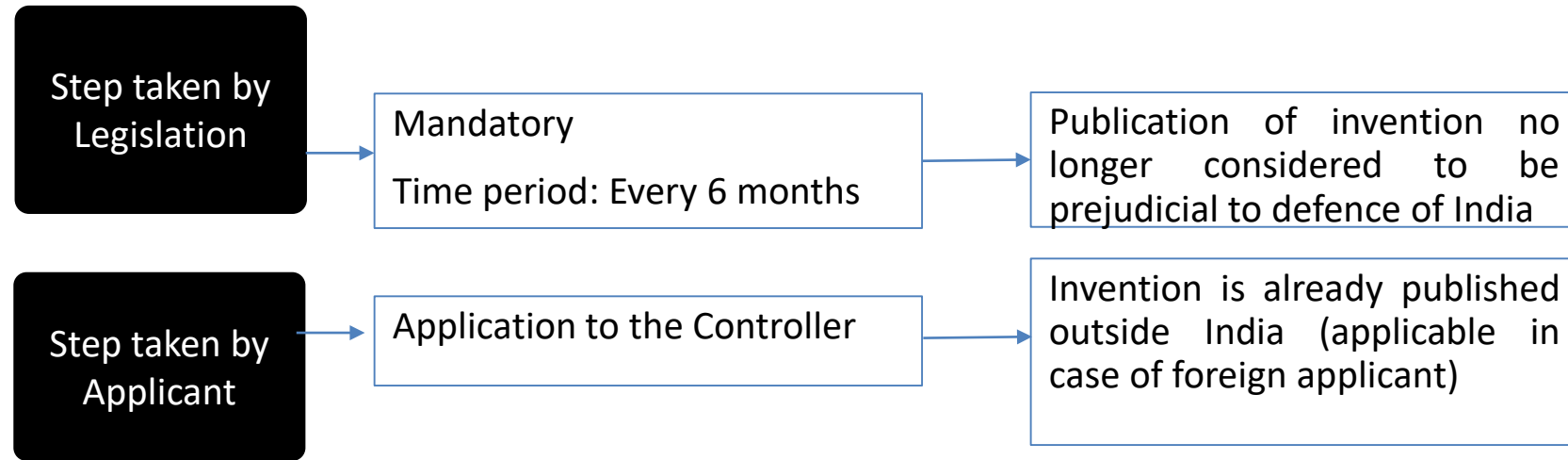
Time to issue secrecy direction: Time between the application stage and request for publication stage

Form 1 + Form 2 + Form 9 at the time of application

Time to issue secrecy directions: **No provision in the Act**

Power to issue and revoke the secrecy direction lies only with the Controller though the Central Government decides whether the invention is prejudicial to the defence of India or not

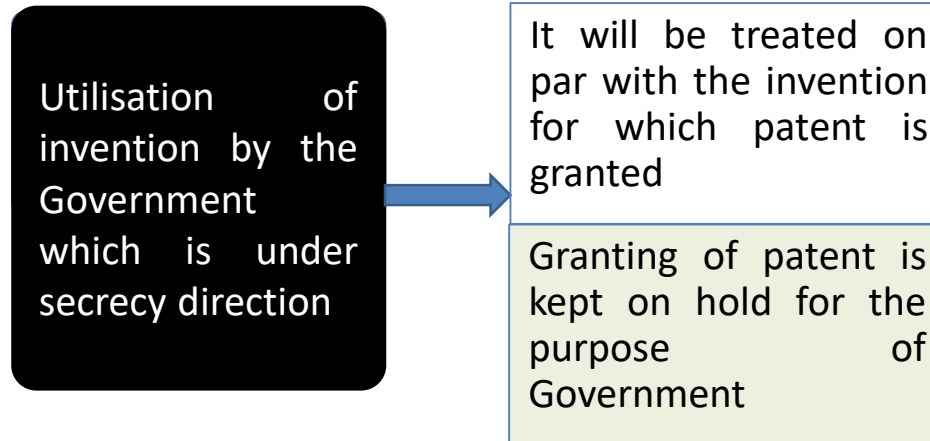
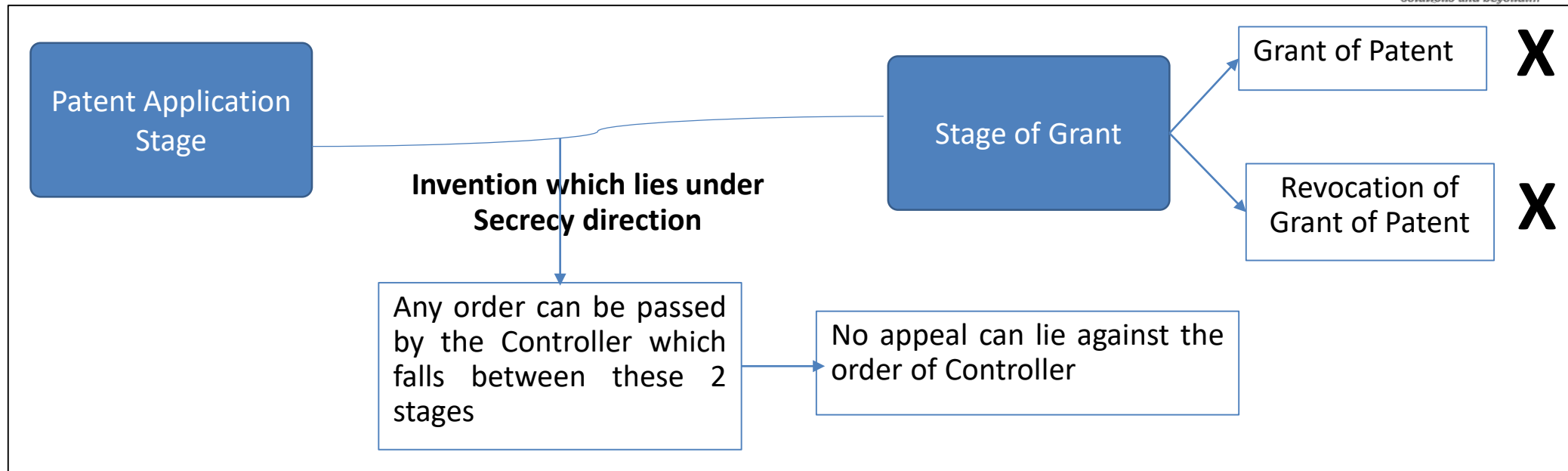
Removal of Secrecy Direction by CG



During the year 2018-2019, **98 applications were given secrecy directions** and the same were referred to Defence Research and Development Organisation. Out of which, 59 applications cleared for normal proceeding and 39 were pending with DRDO

Source: IP India Annual Report

Secrecy Directions – Pros & Cons



- ### Other advantages
- Compensation by way of Solatium will be paid, if the applicant suffers any hardships due to continuation in force of directions
 - No renewal fee in respect of the period during which direction were in force

Patent application outside India - Residents

Form-25

Application allowed with prior permission

If the resident has made an application in India not less than 6 weeks before making application outside India

And no secrecy order is issued and in force

If the resident wants to apply outside India, before applying in India?

Prior permission is required

Application not allowed

If the resident has made an application less than 6 weeks before making application outside India

Secrecy order is issued and in force

Point to be noted: In this case, the Controller is given a time period of 6 weeks to decide whether a secrecy direction be issued or not?

CG has to be consulted if the invention is relevant for **defence / atomic purpose**

The response to Form 25 has to be given within 21 days of application / response from CG

Will this provision be applicable if a person who is also a resident outside India, filed his first application outside India?
No, this provision will be relevant only if a person is resident and intends to make his first application

During the year 2018-2019, **5,852 applications** were filed in **Form 25** out of which, permission was granted for **5,713 applications**

Source: IP India Annual Report

Patents of addition

Patents of addition

Main Invention
The invention which has been filed by applicant / patentee in Form 1 + Form 2

Patent of Addition
Improvement / Modification to Main Invention

✓ Act allows such filing

Who can file?

Applicant ✓
Patentee ✓

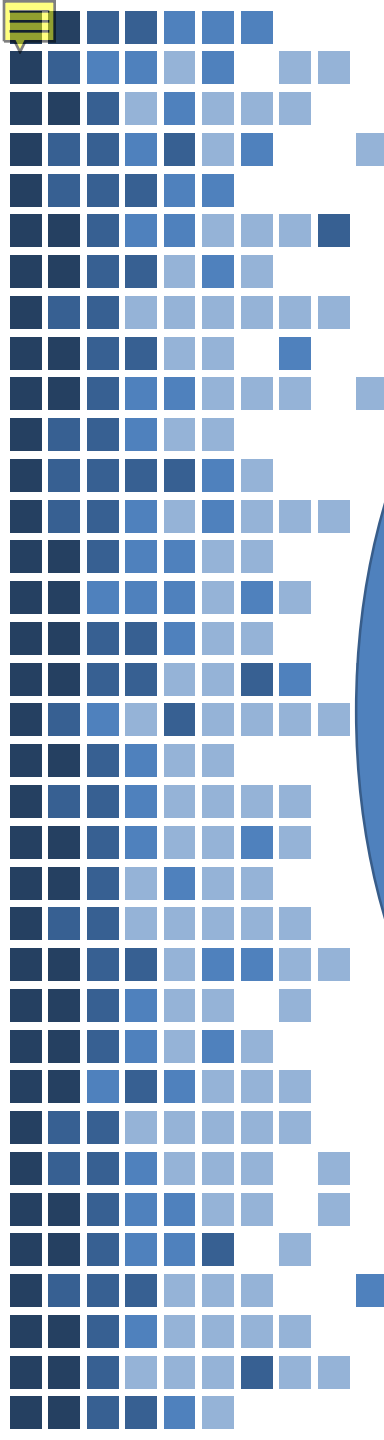
When can be filed?

→ Along with main invention
→ After filing main invention ✓
→ Before applying for main invention

When can the grant be given?

Only after / along with patent of main invention

X - not possible



Term of patents of addition

Particulars	Main Invention	Patent of Addition
Date of Grant	31/03/2020	31/03/2025
Validity	31/03/2040	31/03/2045

Though the patent of addition is valid for 20 years (equal to valid period of main invention) the tenor is restricted till the validity of main invention i.e. **31/03/2040**

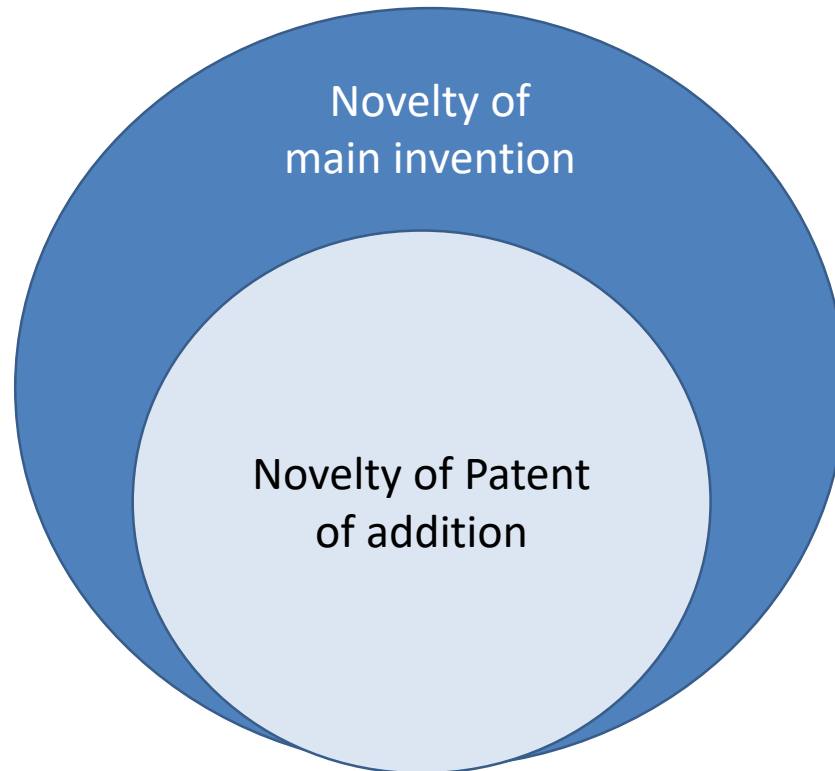
No renewal fees

This can be extended if the patent of addition is classified as an Independent Patent

In such case, renewal fees shall be paid from the date of classifying it as an Independent Patent i.e. from 01/04/2040

Novelty of Patent

Novelty of patent of addition shall not be seen separately from the novelty of main invention



Novelty of patent of addition has to be seen along with the novelty of main invention for deciding the grant of patent of addition

Restoration of lapsed patents

Restoration of lapsed patents

Application for restoration of Patents – **Form 15**

Restoration of lapsed (ceased) patents

Patents will cease to be in force when the renewal fees is not paid on time / extended time

Instance 1

- Principal Patent granted within 2 years
- Subsequent year renewal fee payment (irrespective of year of grant)
- Renewal fees has to be paid in advance for the every respective year
- Or Form 4 has to be filed to the Controller for extension of 6 months

Instance 2

- Principal patent granted later than 2 years from the date of filing of application
- Renewal fees has to be paid within 3 months
- Or Form 4 has to be filed to the Controller for extension of 9 months

Application for restoration of Patents has to be made **within 18 months** from the date of lapse of patent by the patentee / his legal representative / by 2 or more persons, if jointly held

During the year 2018-2019, **141 applications for restoration were filed**, out of which 84 patents were restored

Source: IP India Annual Report

Procedure for restoration of lapsed patents

Points to be considered for restoration of lapsed patents:

- Failure to pay renewal fees was unintentional
- No undue delay in making an application

If the Controller is satisfied under these 2 categories, he can publish the same for opposition

If the interested party is against these 2 categories, an opposition can be filed in Form 14

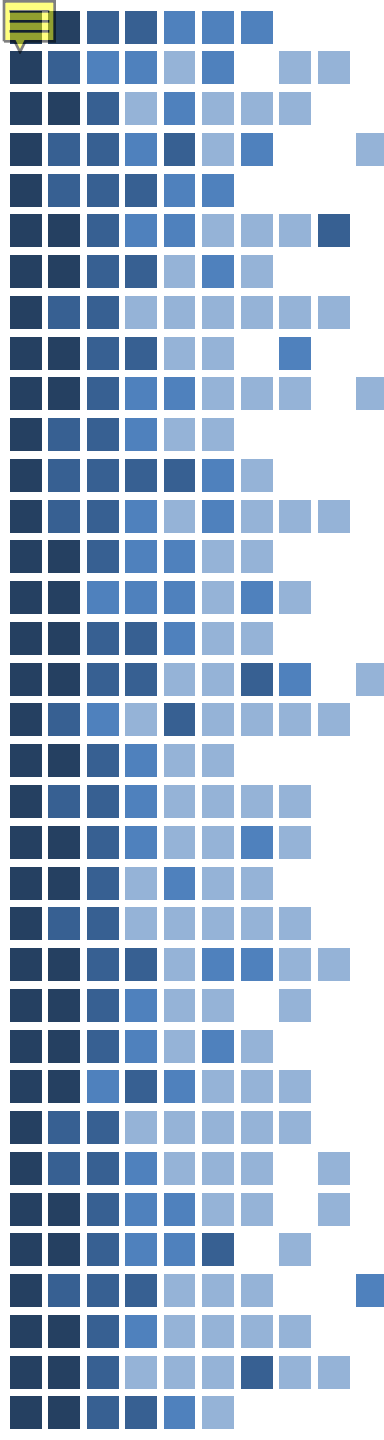
No Opposition

Decision in favour of Patentee

Decision in favour of Opponent

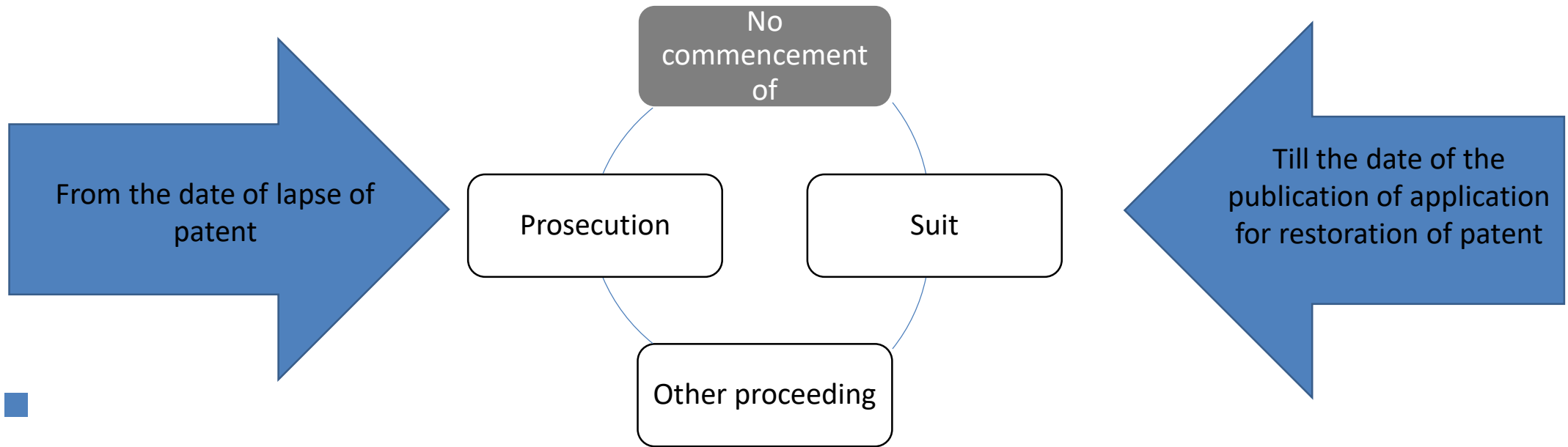
On receipt of renewal and additional fees (to be paid within 1 month from the date of order), patent will be restored

Patent will not be restored, it will be treated available for public

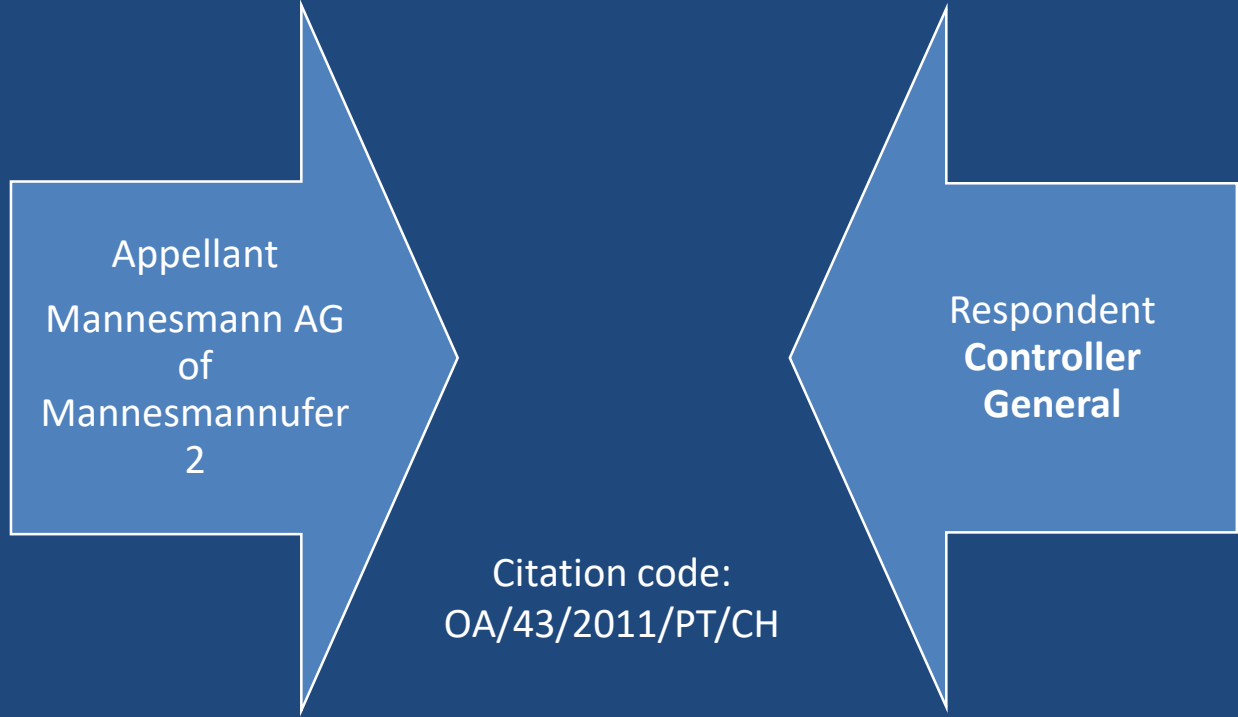


Rights of patentee is subject to the decision of Controller

- Once the patent is lapsed, it will be available to public i.e. no royalty has to be paid to the Patentee for using such Patent
- Thus, the general public will make use of the Patent once it is lapsed
- In order to protect and compensate them, Controller may issue directions to the Patentee to not commence any criminal proceedings against such general public
- Hence, the Act clearly states as follows:



Case law

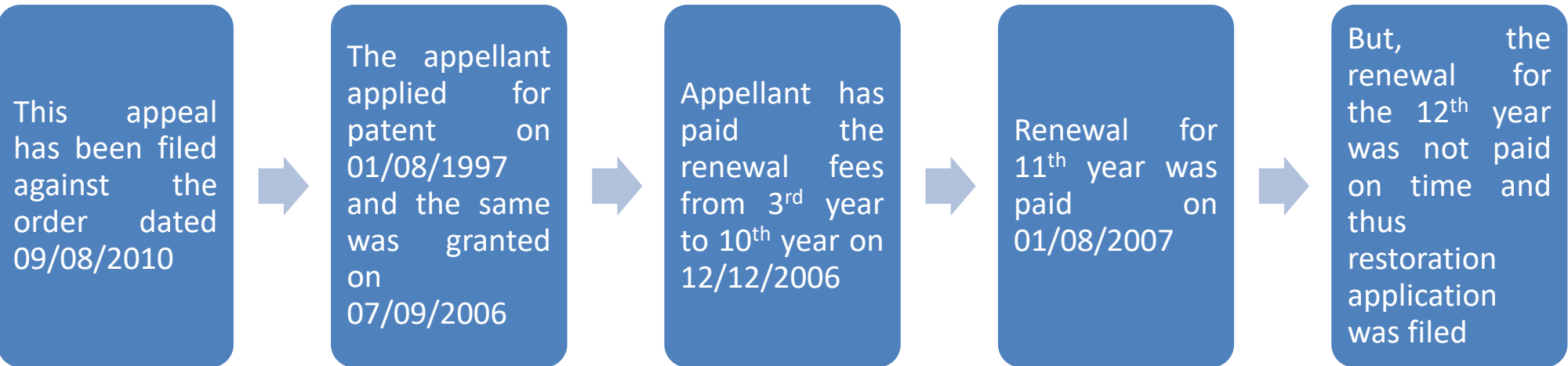


Appellant
Mannesmann AG
of
Mannesmannufer
2

Respondent
**Controller
General**

Citation code:
OA/43/2011/PT/CH

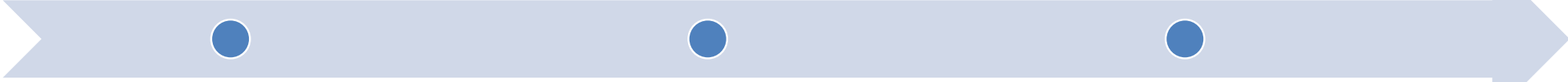
Facts of the Case



Controller held that:

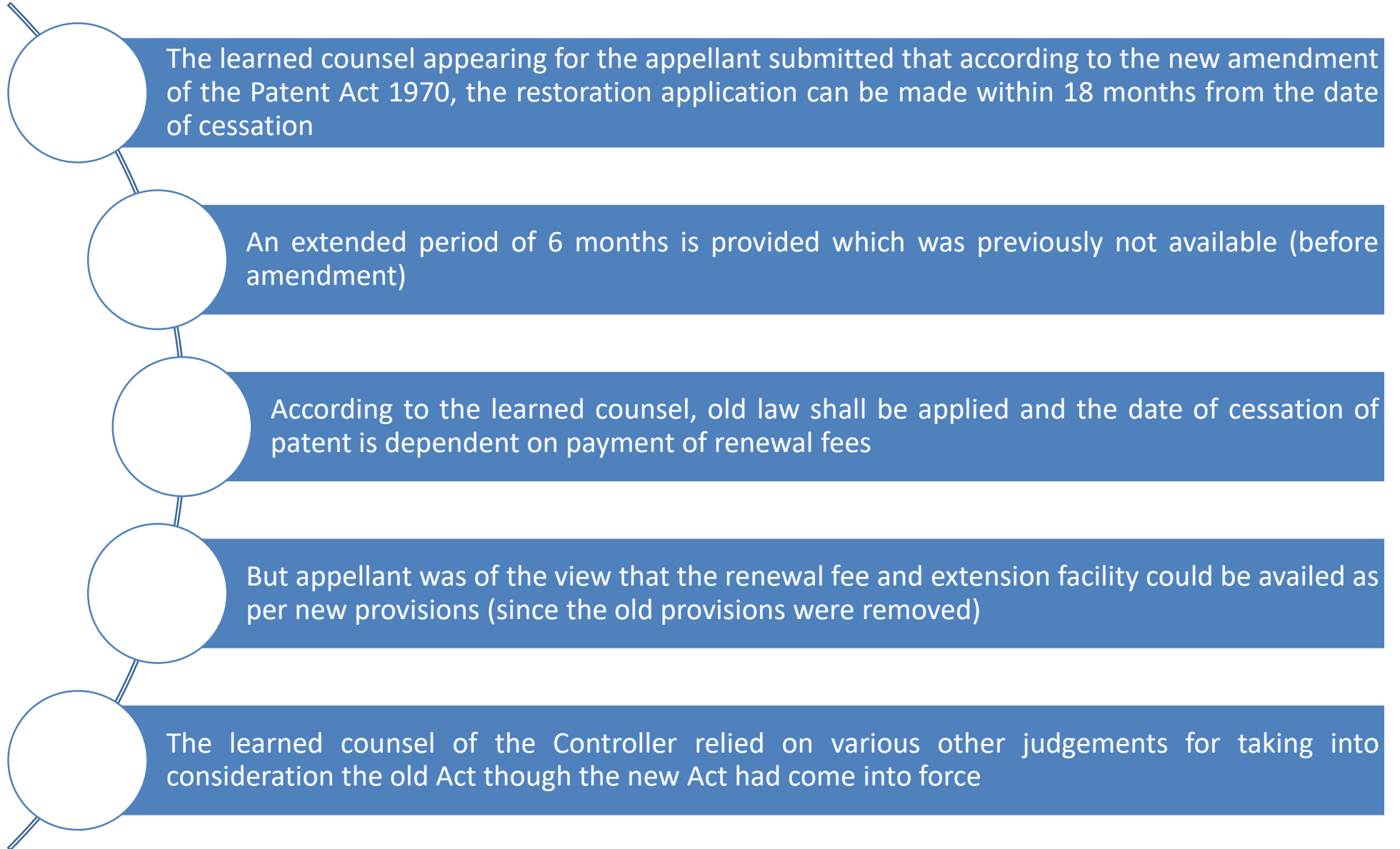
Patent ceased to have effect on 01/08/2008 and the application for patent restoration has to be made within 18 months

But, the restoration petition was filed on 13/04/2010



The period of 18 months ended on 01/02/2010

Discussion



Judgement

Intellectual Property Appellate Board's decision as on 13th September, 2012

The appellant has a chance of filing Form 4 for extension of payment of renewal fees for a period of 6 months and have his patent renewed, which ended on 01/02/2009

The appellant also had another chance of making an application to the controller within 18 months from the date of cessation of patent for restoration, which ended on 01/02/2010

The cessation of patent is fixed by the Act and does not float around according to the appellants wish

Thus the date of cessation of patent cannot be changed

The appeal stood dismissed



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