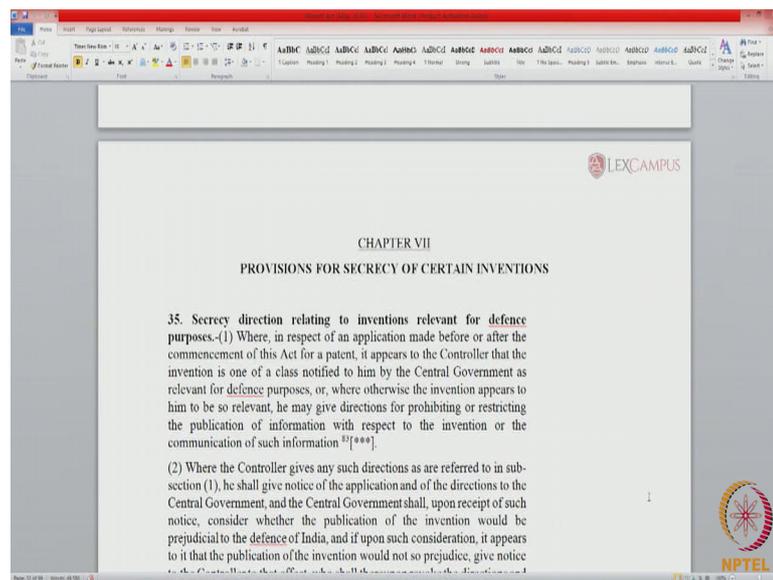


Patent Law for Engineers and Scientists
Prof. Feroz Ali
Department of Management
Indian Institute of Technology, Madras

Lecture - 46
Patent Prosecution: Practice at the Patent Office
Secrecy Provisions

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Section 35: secrecy direction relating to inventions relevant for defence purposes. The patents act provides for certain provisions of secrecy. And when we say secrecy we specifically refer to the ability of an invention as disclosed in a complete specification to be kept as a secret. In the context of patent law when we see kept as a secret, we always understand that as it is opposite or we understand that by comparing with it is opposite. Patent specifications are designed to be published and they would eventually at some point in time they will be published and will be available to the public.

Now in many case laws on proving lack of inventive step or obviousness, what matters with regard to the prior art was whether it was made available to the public. Publication of an application or a granted patent makes the invention available to the public. The public can do many things with it can refer to it can work upon it as long as it does not infringe upon the rights granted under section 48.

The public at large is allowed to look at the invention. A secrecy provision when there is a secrecy direction issued under the act. The invention will not be published, it will not be granted, rather it will be kept in a secret mode; in the sense that it will be kept away from public scrutiny. Many countries have secrecy provisions and they are all tuned towards national security and for defence purposes.

If a country feels that certain inventions if they are published or if they are put into the public domain by publishing the application or by granting the patent, then they could be in issue that could affect the security and the defence of the country. So, many countries have similar provisions. So, section 35 allows the controller if he is of the opinion that the invention is relevant for defence purposes, then he may give directions prohibiting or restricting the publication of information about the invention.

So, we already mentioned complete specifications are designed to be published. If you do not publish a complete specification, if you do not take a request for publication they automatically get published after 18 months. So, there is no way you can keep up complete specification a secret, because their design is to be published and the fact that once they are published the matter disclosed in the complete specification would fall for public access. The central government and the controller are empowered to keep certain inventions as secrets.

Now let us look at section 35. Section 35 states that where in respect of an application made before or after the commencement of this act for a patent it appears to the controller. So, what matters is the opinion of the controller. So, so we will get into details as when the controller forms this opinion 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. So, we understand that the controller forms an opinion which is based on a notification by the central government.

So, the central government will make a notification on certain technologies or certain inventions being relevant for defence purposes. Or whether otherwise the invention appears to be relevant to him to be so relevant. So, one if he if it is one of the notified classes yes or even otherwise if it is not in the notified classes, but the controller forms an opinion that this could be meant for defence purposes. For instance if you look at night vision, night vision is something which was initially which came as an invention that

could be used in military purposes or toady there are various other accruements which have in cooperated night vision.

So, when the first time night vision would have been patented they may not be a clear implication on what could be the reach or what could be the impact of a such technology on defence. So, the controller can either go by the notification issued by the central government or the controller can form has own opinion. So, what is the controller do if he is forms are opinion? He may give directions for prohibiting or restricting the publication of a information with the respect to the invention or the communication of such information.

Now this is what the controller can do. Controller can prohibit the publication of information with respect to the invention. So, he can prohibit the initial publication. So, the controller from this we understand that the controller has to form his opinion on the invention before it gets published. So, assume a case were an application is filed. Along with the application form 9 is filed. So, when form 9 is filed along with form 1 and 2 the application should get published immediately, because form 9 is a request for publication.

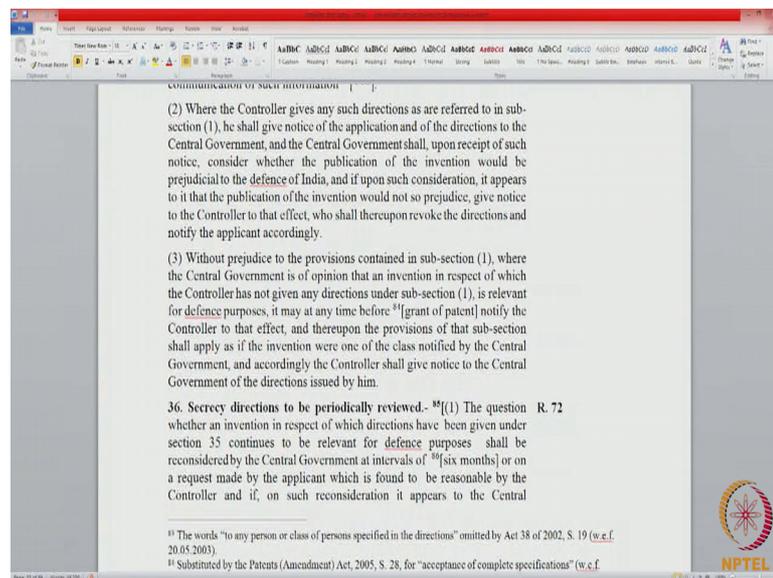
So, assume a person files form 1 and 2 along with form 9 then the application will not wait for the 18 month period it may get published immediately. Where does the controller form his opinion? Because this provision says the controller should form has opinion and the normally the controller will get to see an application after the application comes before him and he allots the application to an examiner. This is normally after the publication after the 18 month period.

But if an application comes along with form 9 which is a request for publication then the application will have to be published immediately, depending on the number of pending applications if there is a q then according to the q, but the normal's when a request for publication is taken it has to be published immediately. Now if a person takes an application form 1 along with form 9 then does the controller exercises discretion under section 35 1. Because assuming that there are one and average close to 50000 patent applications filed in India every year, the controller may have to go through and make a preliminary opinion before there is a request for publication.

So, we understand that if a request for publication is filed then the controller will have to exercise some kind of a scrutiny, a quick scrutiny before it is published. Or if the 18 month period is available for it any time before the 18 month period because this call has to be taken by the controller before the publication. So, the act is really not very clear as to what time the controller will exercise this when will he form his opinion, but we can understand that it as to be done for the secrecy provision to be effective it has to be done before the publication.

Now let us see how it works 35 2. Where the controller gives such directions as are referred to in subsection 1, he shall give notice of the application and of the directions to the central government.

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And the central government shall upon receipt of 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 there upon revoke the directions and notified the applicant accordingly. Now this gives us one scenario, one scenario were the controller feels that something is relevant for the defence purposes. He has to give notice to the central government. The controller first passes the direction saying that they shall not be any publication of the information, he passes that direction. Which means the patent office will now not published that patent application they invention or details

pertaining to the invention will not be published. Once he issues their act this is sequence of events the controller looks in to the application his of the opinion either by considering the notification in issued by the central government the central government is expected to give a notification, listing of the things that are relevant for or technologies that are relevant for defense purposes. He may rely on the notification and same something is relevant for defence purposes or he may on his own opinion come to a conclusion something is relevant.

When the controller forms his opinion, he will first issue a direction saying that secrecy direction is issued under 35 1, information should not be published. Once he does that once he issues a secrecy direction the next step will be to communicate that by way of a notice to the central government, because the controller is not the person who can take a call on whether something is relevant for defence purposes or not. He can at best make his preliminary opinion, waste on his preliminary opinion he can issue a direction not to publish and that is an internal affair with in his office. He has to pass on, he has to give notice of the application and the direction that he has issued to the central government. The central government upon receipt of the notice shall consider whether publication of the invention will prejudice, will be prejudicial to the defence of India.

So, the call on whether something will be prejudicial to the defence of India has to be taken by the central government and not by the controller. They may be some confusion with regard to who takes the call on secrecy. The direction of secrecy is issued by the controller. The controller issues the secrecy direction, but the decision whether something is prejudicial to the defense of India that decision is taken by the central government. And what does as central government relay on? The central government relies on the application and the direction issued by the controller. Once the central government comes to the conclusion that publication of this particular invention will not be prejudicial to the defence of India then the central government shall give notice.

The first notice is given by the controller to the central government, now the central government shall give notice to the controller saying that this is not prejudicial. On receipt of the notice the controller shall revoke the direction which earlier issued and notify the applicant accordingly. When a secrecy direction is issued nothing happens on an application. The application will not be published. There are provisions where the prosecution can happened, but the application is not published. But once a secrecy

direction is revoked and that is revoked by the controller upon a notice issued by the central government.

So, there are 2 things they issuing of the direction secrecy direction and revocation of the secrecy direction is done by the controller. Issuing the secrecy direction and revoking the secrecy direction is done by the controller, but the decision once whether or technology or an invention will be prejudicial to the defence of India is the call that the central government has to take 35 3, without prejudice to the provisions contained in subsection 1 where is central government is of the opinion that the invention in respect of which the controller has not given any direction under subsection 1 is relevant for defence purposes it may at any time before grant of a patent notify the controller to that effect and there upon the provisions of sub section shall apply as if the invention were one of the class notified by the central government. And accordingly the controller shall give notice to the central government of the directions issued by him.

Now, what happens in cases where the controller does not pick up an; invention as being relevant for defence purposes, they could be many reasons were the controller does not pick it up. 1 by over side the controller and the patent office could have missed it, 2 the list of notifies things may not have this technology mentioned in it. So, they could be many reasons why the controller may things that something is not relevant for defense purposes.

So, in such cases if the central government founds an opinion that an invention is in respect of which the controller has not given any direction is relevant, at any time before the grant it can notify the controller to that effect saying that this is relevant. And there upon the provisions sub section shall apply as if the invention where one of the class notified by the central government. Now once the central government communicates to the controller that this technology though it is not notified is relevant for defence purposes, then it will be as if it was a class notified by the central government.

So, it the fact that the central government as communicated to the controller that a particular technology is relevant is enough it is as though it issued a notification saying that this is a class that is notified. And once that happens the controller shall give notice to the central government of the directions issued by him. Again the right to issue a secrecy direction is only with the controller. You can see that the central government will

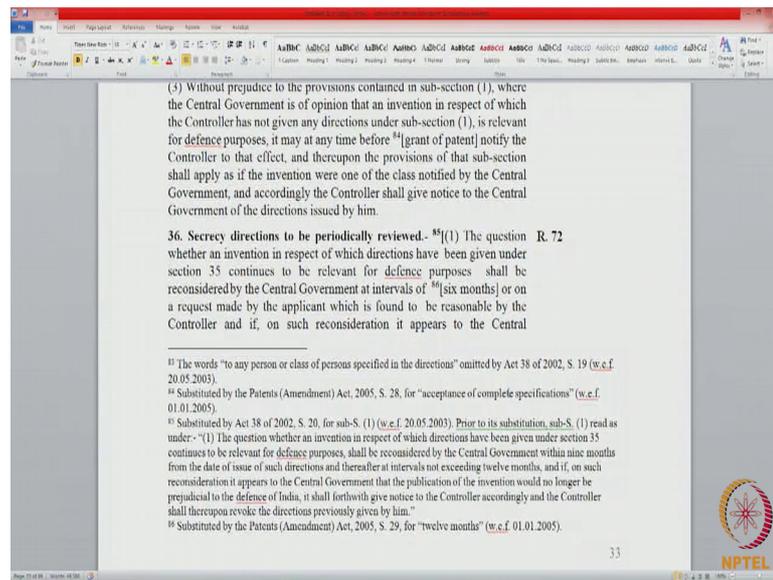
remind him that this technology is also relevant, but still the direction has to be issued by the controller.

The reason for this is an invention which is covered by a patent. When it is filed before the patent office it is the controller who has a control over how the information is kept a secret or how it is to be published. This is not something which is the central government does have many powers, central government even has the power to revoke central government has the power to make rules and you can say that the controller is the authority under the central government. But the central government in itself cannot pass this direction because the act uses the controller to pass the direction.

So, even when the when the central government informs the controller just particular technology is relevant for defence purposes, it has the effect of a notification as it is as though the central government has notified this particular class also. And based on notification the controller will have to issue special secrecy directions. So, that is again it has to be done by the controller.

So, the controller issues secrecy directions once the government informs the controller that something is relevant for defence purposes, though it may not have been in the class notified, there is we understand that there is a class of inventions and technologies notified by the central government this particular technology was not there in it, but still when the central government communicates to the controller the controller shall issue notice of the directions.

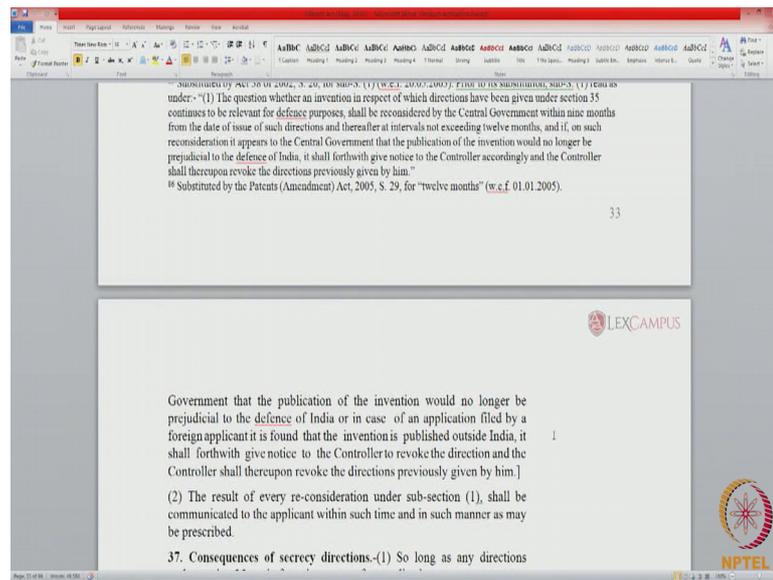
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So, he will have to issue directions and inform the central government. Now what happens to the secrecy directions which have been issued by the controller? 36, secrecy directions to be periodically reviewed; the question whether the invention and respect of which directions have been given under section 35, continues to be relevant for defence purposes shall be reconsidered by the government at intervals of 6 months or on a request made by the applicant which is found to be reasonable by the controller.

And if on such consideration it appears to the central government that the publication of the invention would no longer be prejudicial to the defence of India or in the case of an application filed by a foreign applicant it is found the invention is published outside India

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It shall forthwith give notice to the controller to revoke the direction. And the controller thereupon revoke the direction previously issued given by him and 2 the result of every reconsideration under subsection 1 shall be communicated to the applicant within such time in such manner as may be prescribed.

We will have to look into the rules for that. So, what happens when a secrecy direction is issued by the controller? The controller issue the secrecy direction, and we have already seen that though the controller issues the secrecy direction, he only controls the transmission of information. He only protects the publication of information. He does not take a call on whether a particular technology is relevant for defence purposes because that is beyond the purview of the functions of the controller. So, we know that it is the central government which would take a call on whether a particular technology is relevant for defence purposes.

Now once the central government takes the call, section 36 allows the central government to reconsider it is decision every 6 months. Because in 6 months So many things could have happened the technology could have come into the market. Or this technology could have been published in a journal or some information about it could have come out from a third party, need not be through the applicant. So, if the information is already out then the there is no wisdom in keeping or maintaining the secrecy direction. In such cases the central government will ask the controller to revoke.

Central government does not revoke it central government will now say that this technology for which we passed the secrecy direction is now available for everyone it is no longer a secret.

So, revoke the secrecy direction. So, the only way you can request or the central government or the controller can revoke a secrecy direction is the invention sees us to be a secret. So, if you are asked what are the conditions under which a secrecy direction issued by the controller can be revoked. The fundamental condition is that what was earlier kept a secret is now no longer a secret. It is not a secret in India or it was disclosed outside they could be a number of reasons you need not have disclose to the world third party could have disclosed. And it is now on the public domain the fact of the invention is in the power of public domain is in to revoke a secrecy direction.

Now So, this the central government will have to review every 6 months because they will be new discloses coming new technologies new products coming the central government will have to look re considerate every 6 months to see whether the secrecy directions that have been issued are valid. Alternatively the applicant can make a request. Now when the applicant makes a request to the controller and the controller finds that request to be reasonable and if on the consideration the central government re considers it, and feels that it need not be kept a secret then it will asked the controller to revoke the direction.

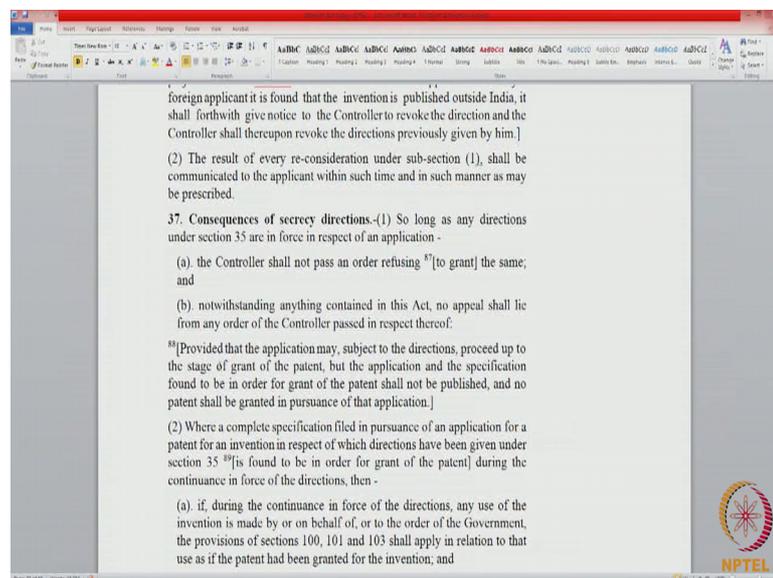
So, either the central government can do on it is own every 6 months or the applicant can asked the controller to re considerate. There are 2 ways to revoke a secrecy direction. Now if the central government comes to a conclusion that the invention would no longer be prejudicial to the defence of India could be that the technology has changed or something else has happened which is much more relevant, the central government can say that revoke the secrecy direction.

The other case is that, if the application filed by a foreign applicant is found it is found that the invention is published outside India. Then again the controller shall be asked to revoke the direction. Now if there is in defence related technology filed by a foreign applicant in India. Most likely the foreign applicant would have filed applications in his home country. Now if those applications get published assume that those country did not

grant a secrecy direction, then there is no point in keeping a secrecy direction on the Indian application, because it is already published same application.

So, the corresponding foreign application got published so, there is no point. If a publication happens, and if the secret is no longer a secret that is the ground for revoking the direction; so you revoke a secrecy direction if a secret does not remain a secret or if the central government is of the opinion that the technology or the invention covered is no longer relevant or no longer prejudicial to the defence of India. So, these are the 2 conditions. Now once the central government re considers it shall be the decision shall be communicated to the applicant.

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Now let us look at the consequences of the secrecy direction. What happens when a secrecy direction has issued? Now when a secrecy direction is issued by the controller, the controller shall not pass an order refusing to grant the same. He cannot refuse the application while an order is pending. So, as long as there is a secrecy direction in force the application cannot be refused and no appeal shall lie from any order of the controller passed in respect thereof.

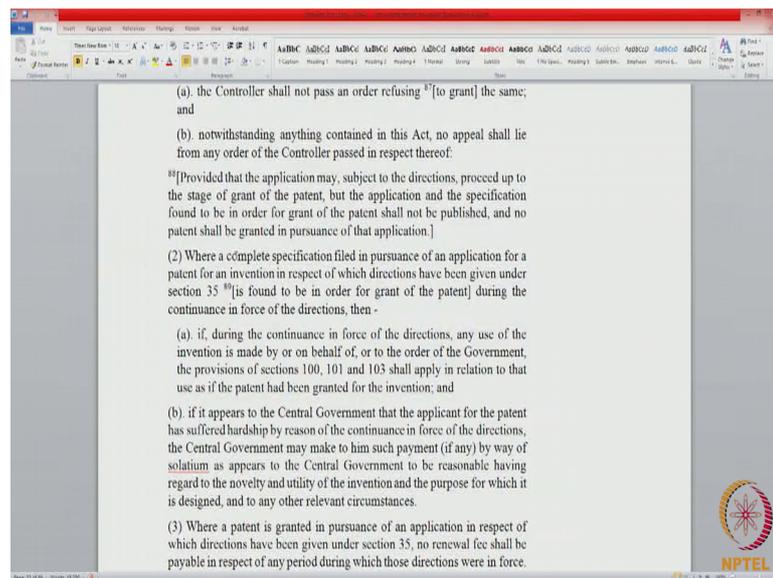
Now, if the controller passes an secrecy direction, then there cannot be an appeal in respect of such a direction as long as the secrecy direction is in force. Now we are already mentioned the provisions of appeal are contained in section 117 a of the patents act; instances where an appeal lies to the intellectual property appellate board. So 35, 36,

37 which we have been seen, an order issued by the controller cannot be appealed; they are not grounds on which an appeal can be filed before the intellectual property appellate board. So, the subsection continues provided that the application may subject to directions proceed up to the stage of a grant of a patent, but the application and specification found to be in order for grant of the patent shall not be published and no patent shall be granted in pursuance of that application.

So, even if there is a secrecy direction the patent office can continue the process of prosecution, and it can make it ready up until the grant of a patent, but it cannot grant the patent. So, everything else short of grant can happen everything else short of reject can also happen. So, this secrecy provision affects the outside world. The prosecution of the patent is not stopped by a secrecy provision.

So, if there is an FER issued the applicant can respond to the FER, if there are further objections issued by the patent office the applicant can do that respond to them if the patent office insists on amendment the applicant can amend the patent, they can do any number of things, but for either grant of the patent or reject of the patent, these 2 things cannot happen. The patent office cannot grant or reject short of that they can do everything else. So, and we are talking about internal procedures within the patent office.

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37 2 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 section 35 is found to

be in order for a grant during the continuation in force of the directions then if during the continuation in force of the directions any use of the invention is made by or on behalf or to the order of the government under sections 100, 101 and 103 shall apply in relation to that use as if the patent had been granted for that invention.

And if it appears to the central government that the applicant for the patent has suffered hardship by reason of the continuation of in force of the directions, the central government may make to him such payment if any by way of a solatium as appears to the central government 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. Now this sub section tells us if a secrecy direction is given under section 35 and the patent is found to be in order for a grant.

So, it is got over all the all the objections in prosecution and it is found to be in order for a grant, if during the continuation of the secrecy direction there is use of the invention by the government. And we know that the government can use or even acquire the invention, like how the government can acquired private property reliant acquisition act allows the government to acquire private property, that government can also acquire intellectual property or use intellectual property and the provisions from section 100, 101 and 103 pertained to that.

Now, if the government uses the invention then it will be as though it used it under section 100, 101 and 103 as if the patent has been granted. Now when we come to section 101, 100, 101, 103 the government if it uses a patent after the grant then the government can give some compensation in leave of the use. There are provisions for that or if the government acquires the patent then the government can give some compensation. Now 100, 101, 103 all pertain to applications that have already been materialize into a grant. Section 100 on words applies to cases where there is already a grant and government wants to use that invention, then the government uses that invention it gives royalty or some kind of compensation.

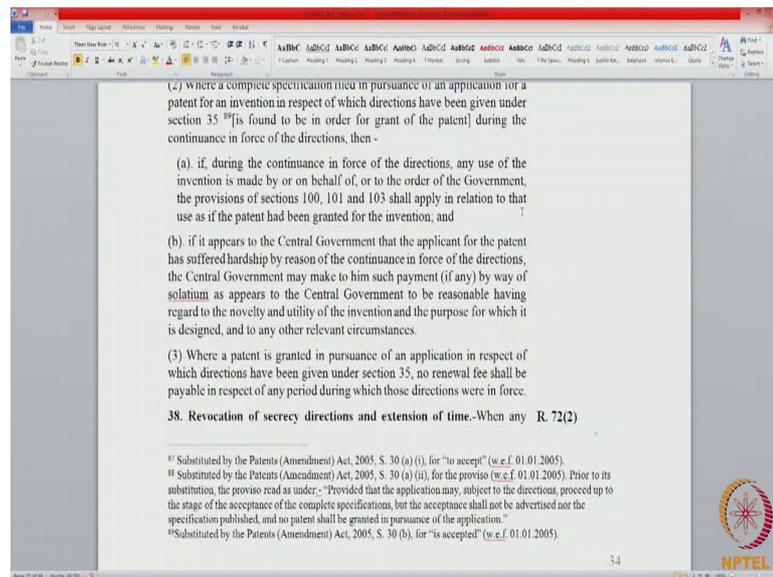
Now, in this case when a secrecy direction is issued we had already seen that there cannot be a grant, because pending secrecy direction the patent cannot be granted. So, when there is a secrecy direction and the patent cannot be granted, but the government

wants to use it or the government uses that invention, then it will be as if the provisions of 100 applying which means it will be treated as though this patent has been granted.

So, this is deeming provision you can see the word as if the patent has been granted, which means the patentee or which means the applicant will have the rights of a patentee even before the grant. So, this is a deeming provision which allows the applicant to have certain rights of a patentee even before the grant. The reason being the grant the only issue that hinders the grant is the secrecy direction, not been a secrecy direction it would have been granted. And because the government is using it the government will now regard this as a proceeding under 101 and 103, they could be a question.

What are the instances in which the government can deal with an application deal with an invention in the application state and grant compensation to the applicant for government use then a patent has not been granted? When a patent has been granted section 100 onwards will apply, but when a patent was not been granted if there is a secrecy direction then section 37 will apply. Now 2 b tells us that if it appears to the central government that the applicant has suffered hardship by reason of continuation of the directions the central government may pay him a solatium considering the novelty and utility of the invention and for the purpose for which it first design and for other relevant circumstances. So, if the person suffers hardship, the applicant suffers hardship due to the continuation of the direction, the central government can give some compensations solatium

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So, some payment can be made 3, where a patent is granted in pursuance of an application in respect of which directions have been issued under section 35, no renewal fee shall be payable in respect of any period during which those directions were in force.

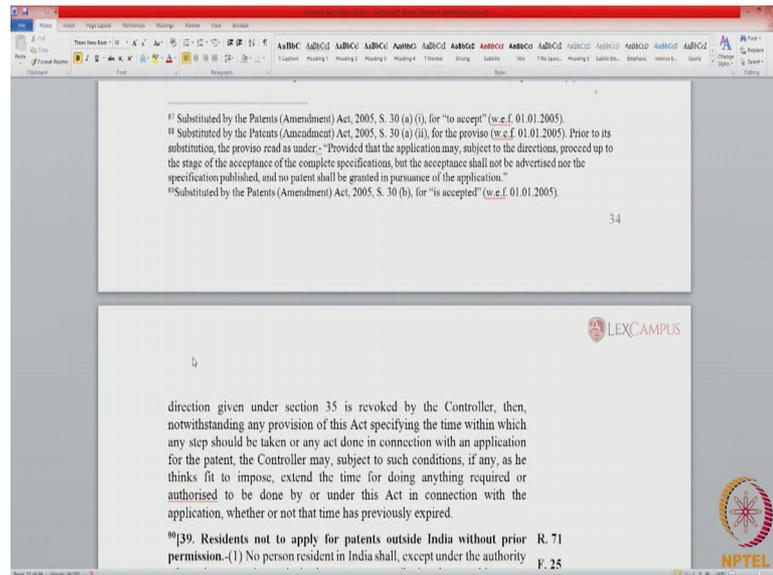
So, they could be a question that what are the instances in which an applicant or a patentee whose patent has been granted is not bound to pay renewal fee during the life of a patent. The renewal fee is collected after the grant because is the patent office is going to reject the patent term starts from the date of filing the application. The 20 year period starts from the date of filing the application, but when the on the date you file the application you are not going to start paying the renewal fee, the renewal fee is something that your expected to pay only if your application materializes to a grant.

And the renewal fees always collected getting the by asking the applicant to pay the backlog. So, if you get a grant in the fifth year you will be asked to pay the renewal fee for from first year onwards, correct? Because it is always like that the renewal fee cannot be paid as the time of application because you do not whether you will get a grant or not.

So, innovatively in all the cases the renewal fee is back dated or you paid for upon grant you paid for all the years, you have been those years the application was still in the in the state in which it was not a formal grant, but still your term covers the time you spent in the application state.

So, if you spent 5 years in the applications state in the patent office still you will have to pay the fees for all those 5 years after the grant. The only condition where you need not pay those fees is if there was the secrecy direction. If there was a secrecy direction you need not pay the renewal fees as long as the secrecy direction continued; 38, revocation of secrecy direction and extension of time.

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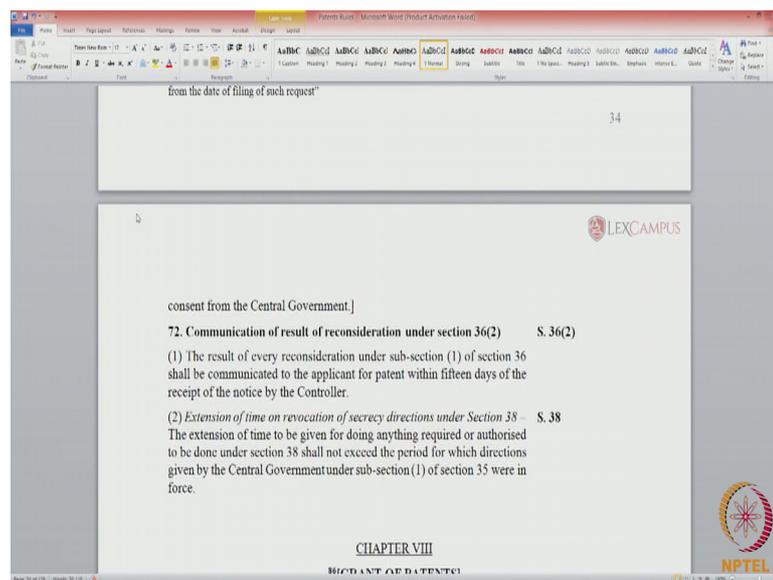
When any direction given under section 35 is revoked by the controller then notwithstanding any provision of this act specifying the time within which any step should be taken or any act done in connection with the application for the patent, the controller may subject to such conditions if any as he thinks fit to impose extend the time for doing anything required or authorized to be done by or under this act in connection with the application whether or not that time has previously expired.

When a secrecy direction is issued there are certain things an applicant cannot do. The applicant cannot take a request for expedited examination, even if is an title to it he cannot do that because if there is a requirement that the application has to be published that requirement is not going to be satisfied now. The applicant may not be able to contest a pre grant opposition. Because that will involved giving notice to third parties third parties will get to know if any amendment is carried during the pre ground opposition. So, there are certain things and because of the secrecy direction the applicant may not be able to do certain acts.

So, when a secrecy direction is revoked by the controller the controller may extend the time for doing anything required or authorized to be done under the act. This provision allows the controller to extend the time for doing something because there was the secrecy direction in force. Secrecy direction can tie down an applicant's ability to prosecute the application. And we know that in patent law there are various time lines which an applicant has to confirm. But once a secrecy direction is revoked the controller can extend the time for doing so those things it could be anything.

So, the controller has the power to extend the time, beyond the secrecy direction and we had already seen it in rule 24 b the 48 month period for taking a request for examination within which time we have to take the request for examination, will consider if there is a secrecy direction pending then it will be 6 months from the expiry of the secrecy direction.

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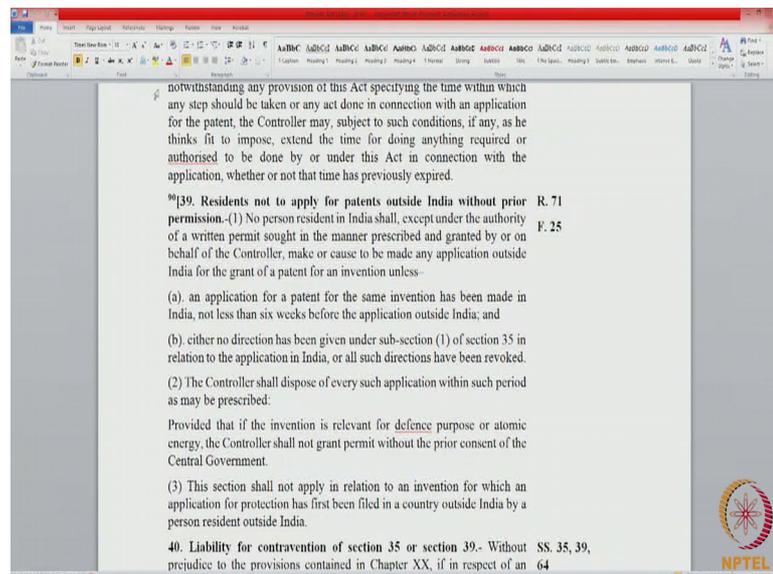
So, wherever a secrecy direction is there, once it expires the controller can give for the time for doing things. Now let us quickly have a look at rule 72. Rule 72, communication of result of reconsideration under section 36 2; we had seen that under 36 2 the central government shall reconsider the secrecy directions issued by the controller, in intervals of 6 months or if the applicant approaches the controller as an when the applicant approaches. Now 72 1 states that the result of every reconsideration under subsection 1 of 36 shall be communicated to the applicant for patent within 15 days of the receipt of

the notice by the controller. So, if the controller receives notice from central government after reconsideration it shall may communicated to the applicant within 15 days.

2 states that extension of time on revocation secrecy directions under section 38. Now this actually covers section 38. Now 72 mentions 36 2, 72 2 refers to section 38 which is revocation of secrecy direction and extension of time. The extension of time to be given for doing anything required or authorized to be done under section 38 shall not exceed the period for which the directions given by the central government under section 35 1 were in force. Now if the secrecy directions were in force for say 12 months. Now the extension of time for doing anything under the act under section 38 shall not exceed 12 months.

So, this only gives the applicant a time equivalent to the time where he could not do anything. The secrecy direction was for 12 months he was not able to do things for 12 months he will be given an extension of another 12 months to do whatever you wants to. If the secrecy direction was only for 6 months then the extension of time should also be only for 6 months. So, this provision just says that the extension of time will not exceed the period of for which the directions where issued and were in force.

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Now, let us look at section 39. Section 39 is slightly deferent in it is operation because all these file 36, 37, 35, 36, 37, 38 were specific cases were there was an invention an

application for which was filed before the patent office and the controller felt that this could be relevant for defence purposes and you should a secrecy direction.

Once the direction is issued the central government will have to look at it either uphold the secrecy direction or asked to be revoked. And the central government also has the power to intimate the controller separately whether the controller looks at the class of notified inventions and technologies whether he does that or not the controller the central government has the power to initiate things on it is own. 39 pertains to application for patents outside India. 39 residence not to apply for patents outside India without prior permission. Authority 9 only affects people, who are resident in India 39, one states no person resident in India shall except under authority of a written permit sought in the manner prescribed and granted by or on behalf of the controller. Make or cause to be made an application outside India for the grant of a patent for an invention.

So, a person whose resident in India cannot make an application outside India for the invention that was made in India without a written permission of the controller unless, a the application for a patent of the same invention has been made in India not less than 6 weeks before the application outside India. So, you need not seek permission you need not seek the permit. If you had made the application first in India, then there is no need for seeking permission, if an application was made not less than 6 weeks before the application outside India. So, 6 week before the foreign application was made that is the application outside India an application was made in India which means you file first in India. If a resident files first in India there was no need for him to take permission under section 39.

And either no direction has been given under subsection 1 of 35 in relation to the application India or all such directions have been revoked. Now this brings and interesting aspect into how the patent office works. Now, one we say that if a person whose resident in India has to file an application for a patent he has to file it in India first. If you wants to filed first outside India he needs to take a permission.

So, in an ideal case he will file the application in India after 6 weeks he will file it in any foreign country where he wants. But if an application is not filed in India then he will have to take permission. Now the permission is not required if no direction is passed under section 35 1 or if a direction was passed and it was revoked. To simplify this, let us

first look at the instances where a person resident in India need not take permission. Let us look at the then we look at the instances where He needs to take permission.

He need not take permission if he makes the application first in India. And after 6 weeks he files an application outside India, no permission require. And he files an application in India and there is no direction issued under 35 1, no secrecy direction issued or secrecy direction was issued and it was revoked. Now this tells us that there is a 6 week window period which you have to wait for filing a foreign application. If you file an application in India and if you want to file a foreign application you will have to wait for 6 weeks, and we can assume within that 6 weeks the controller will quickly look into the application and see whether it is relevant for defence purposes and he may issue in secrecy direction under section 35.

So, the 6 week window period is allowed for the controller to look into the application and see whether it is relevant for defence purposes, because within that 6 weeks if he passes the secrecy direction then you cannot file an application outside India. Because the condition for filing an application outside India as one you should file it in India first and wait for 6 weeks to file it outside India and no secrecy direction should be passed, if you have invented something in India and if you are a resident then in a normal case if you want to file an application outside India you will wait for 6 weeks and then file the application.

Now if you want to file first in a foreign country, then you will need to take the foreign filing license or the permit. The acts is written permit you have to seek a written permit from the controller, there is a form for it you can see the cross reference form 25 is the relevant form: 39 2 states that, the controller shall dispose of every such application within such period as may be prescribe.

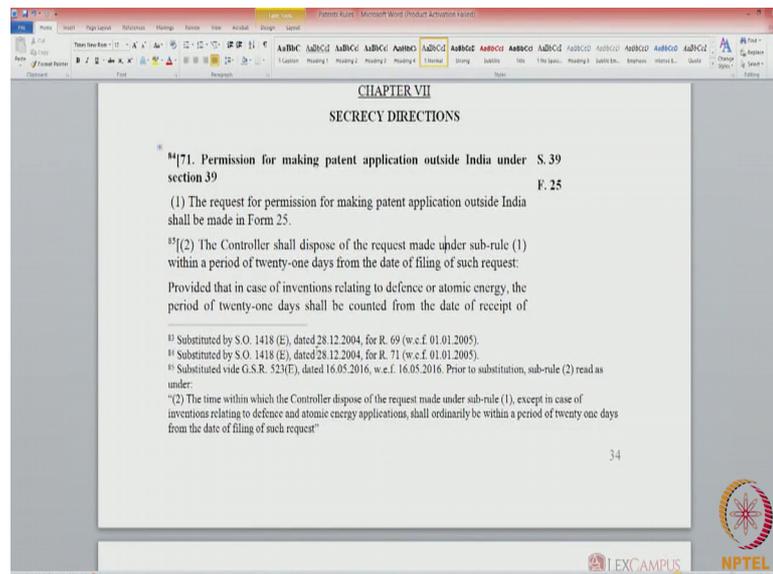
An application that is been made seeking a written permit shall be disposed of as prescribed provided that if the invention is relevant for defence purpose or atomic energy the controller shall not grant permit without the prior consent of the central government. So, apart from defence now we also have atomic energy coming in. But from section 4 we know that patent covering atomic energy under section 20 of the atomic energy act shall not be granted; 39 3 states that this section shall not apply in relation to an

invention for which an application for protection has been filed in a country outside India by a person resident outside India.

So, this will not apply for non residence. If a person is not a resident in India then he can file it without seeking the permission in the country where he wants to most likely the country where he is a resident. So, from this we understand that there are if a resident has to filed an application first in a foreign country he has to seek permission. But if he wants to file in India and then file in a foreign country the permission is not required he just needs to wait for 6 weeks and then file it provided there is no secrecy direction. If there is an application pending before him for under form 25 that is a foreign filing license seeking a written permit the controller shall see whether the invention is relevant for defence and atomic purposes.

So, normally if you see section 34 delete last few words normally if you look at section 35, 36, 37, 38 it only talks about defence purpose, but 39 introduces atomic energy. If you did not see the word atomic energy in the other section, but 39 introduces atomic energy. And a person who is resident outside India he is not born by this provision, he can directly file an application outside India.

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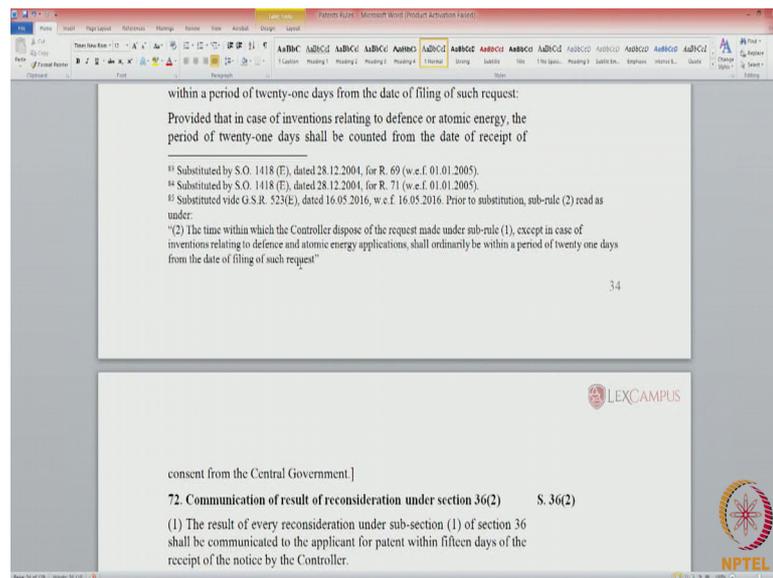


Now, 71 is the relevant rule for this section permission for making patent application outside India under section 39. 71 1 the request for permission shall be made in form 25.

2 the controller shall dispose of the request made under 71 1 within a period of 21 days from the date of filing of such request.

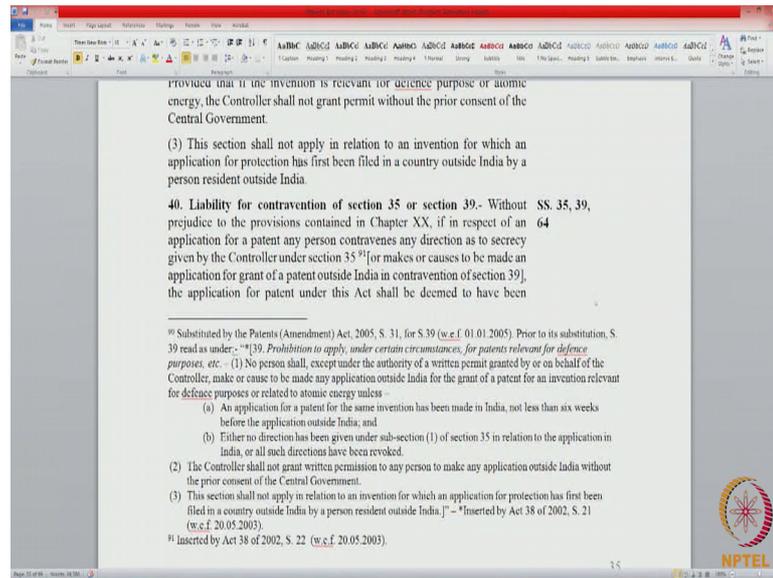
So, in roughly 3 weeks he has to dispose of the request, provided that in case of inventions relating to defence or atomic energy the period of 21 days shall be counted from the date of receipt of the consent from the central government.

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So, the central government as I already told you, if an invention pertains to defence purpose the decision is taking by the central government. The controller may pass a secrecy direction, but he is not deciding authority. Because he is not expected to know what is the current technology used in defence. So, the decision is taken by the central government. So, the period of 21 days if it pertains to atomic energy and defence will be started or will be counted from the date of receipt of the consent of the central government.

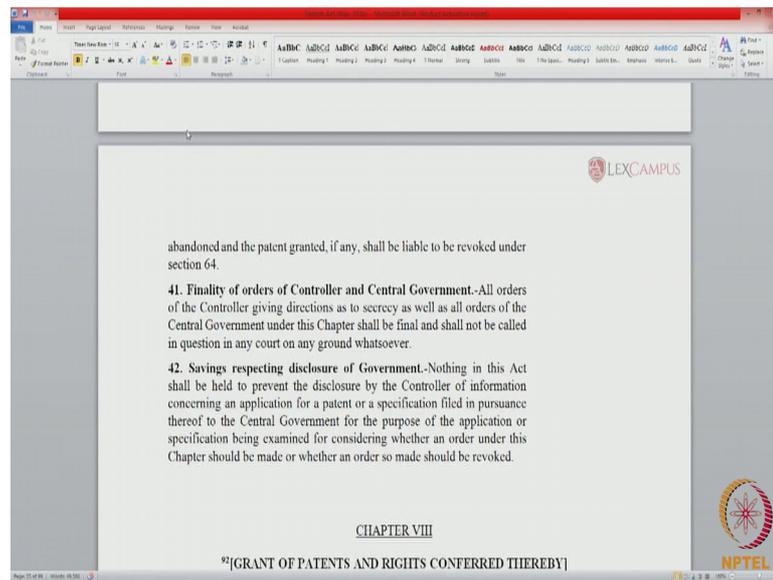
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So, when the central government indicates its consent, the 21 days will start from that day. Section 40 talks about certain liability provisions, there are certain consequences for contravening or for not complying with section 35 and or section 39.

Without prejudice to the provisions contained in chapter 20 if in respect of an application for a patent any person contravenes any direction as to secrecy given by the controller which means the controller gives a secrecy direction and the person does not comply with it under section 35 or makes or causes to be made an application for the grant of a patent outside India in contravention to section 39 which means being a resident without seeking permission he filed a foreign application first.

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So, that is a contravention of section 39 the application for a patent under this act shall be deemed to have been abandoned and the patent granted if any shall be liable to be revoked under section 64. So, if a patent is pending it will be deemed to have been abandoned yet another provision were the deemed to have been abandoned figures. So, this is yet another provisions were deemed to have been abandoned figures. So, or if a patent has been granted it is liable to be revoked, which means this becomes a ground for revocation. And you will find that the ground for revocation as in section 64 1 n. Section 64 1 n states that the applicant contravened any direction or secrecy passed under section 35 or made or cost to be made an application for the grant of a patent outside India and contravention of section 39 the same languages re produced in 64 1 n.

So, it is liable to be revoked means it can be a ground by which it can be revoked, but some person has to file an application or application for revocation or raise a counter claim before the high court, so it becomes a grant, whereas if there is contravention at the application stage then it will be deemed to have been abandoned. Section 40 1 finality of orders of controller and central government all orders of the controller giving directions as to secrecy as well as all orders of the central government under this chapter shall be final and shall not be called in to question in any court on any ground what isoever. We already saw that orders passed under secrecy provision cannot be appealed. We saw that before the IPV. Here they cannot be agitated or they cannot be call to question in any court.

So, on any ground what search? So, a secrecy direction because it pertains to national security to the defence of the country you cannot agitate as to why a secrecy direction was passed before the intellectual property appellate board which as an appeal. And you cannot even go to the normal courts by way of a red petition by of a review. You cannot go to the normal courts to say that this has judicial review at this provision effects me. So, there is a comprehensive bar in approaching the courts or in filing appeals 42, saving respecting disclosure of government.

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 for the purpose of the application or specification being examined for considering whether an order under this chapter would be made or whether an order so made should be revoked.

Now there is a provision under the act which states, that the central government will be bound by a grant of a patent. Section 150 6 tells us that patent to bind government, subject to other provision contain in this act the patent shall have all intense the like effect as against government as it has against any person. Now because the a patent binds the government and because it is the government which grants the patent, they could be an issue with regard to disclosing the controller disclosing certain aspects of the invention to the central government. How can you disclose this? Because the central government has the power to acquire an invention under section 100, 101 and 103, they are the power to use an acquire.

So, will this fall foul of some provision if the controller communicates information with regard to an invention to the central government. And the central government quickly issues a secrecy direction and the central government starts using it. So, this may look like an arbitrary provision that the controller informs the central government and central government issues a secrecy direction and starts using it because the act provides for all these things.

So but the saving provision says that nothing in this act shall be held to prevent a discloser. So, just because we have certain secrecy measures delete last sentence, Just because we have certain protection for the applicant it does not prevent the controller from making certain disclosures to the central government, because the defence of the

country is involved. Normally the controller does not make a disclosure to the central government, because the patent office keeps the prosecution as a matter between the applicant and the patent office. Normally it is not disclosed, third parties are not allowed.

But in this case alone there is a power to make a disclosure to the central government and that cannot violate any other part of the act. And this is being done for the central government to examine and consider whether an order issued has to be revoked or whether an order issued can be sustained.