



## Duty of disclosure during patent prosecution in India



Sneha Sharma, Manchikanti Padmavati\*

Indian Institute of Technology Kharagpur, Rajiv Gandhi School of IP Law, India

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### ABSTRACT

The Indian Patent Office has witnessed an increase in both volume and earnestness from applicants as a result of a duty to disclose that is mandated under Section 8, The Patents Act, 1970. There is a need to delink this with its original purpose. The present study aims at tracing the contours of the duty to disclose requirement in India and in the light of the recent cases, examine the extent to which Section 8 accomplishes the purpose. Elaboration of guidelines for Section 8 in the Manual for Patent Practice and Procedure and need for online linking of databases are suggested as measures for improvement.

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### 1. Introduction

Patent law has been described as a 'stressful if fertile union' between certain contradictory principles: self-interest and the common good; monopoly rights and liberty; the ownership of ideas and public disclosure of knowledge [1]. The utilitarian approach of patent law is to incentivize innovation and commercialize technology by granting monopoly to the inventor in exchange for disclosure to the public of all information relating to invention. Patent law thereby balances private rights and public interest. The requirement that a patent should include a specification containing description of the invention, allowing a person skilled in the art to practise, use or work the invention, is today a basic tenet of patent law. There has been an elaboration of this requirement which was at one time a new concept in the common law [2]. It was as early as 1778 when in *Liardet v Johnson*, Lord Mansfield asserted that written specification was a condition precedent to grant of a patent and thereafter it became a routine requirement [3]. The disclosure in the patent specification has since then been a *quid pro quo* with the state in return for the grant of a patent.

Disclosure of information related to invention with time led to the requirements of details of relevant prior art and those of corresponding applications in foreign countries. Such a requirement became also important with the introduction of the Patent Cooperation Treaty (PCT) route when simultaneous filing of patent

applications could be done in several countries. Further, based on the need to improve examination practice the trilateral office system with the USPTO, EPO and JPO was set up. This cooperation included sharing of search and examination documents between the offices. The disclosure requirement on one hand makes the examiner's job convenient in assessment of patentability and on the other hand helps to understand honest conduct of an applicant during patent prosecution. Such a duty upon each applicant affected the prosecution and grant of a patent.

#### 1.1. Duty to Disclose: Undertaking

Patents are issued keeping public interest in mind. There is a need for complete, clear and succinct disclosure of the invention and also additionally details relating to prosecution of corresponding applications; all of which is provided in good faith and equitably. To ensure both, the stage of patent examination becomes crucial where the Patent Office not only looks into the substantive aspects of an invention viz. subject matter, novelty, inventive step and utility, but also looks at the conduct of the patentee. It is certainly impracticable if not impossible to gauge applicants' conduct by the examiners without setting certain compliance standards. This is precisely why the concept of submission of an undertaking has attained such significance under patent prosecution with regard to duty to disclose. The undertaking to disclose relates essentially to corresponding foreign applications with subject matter of same or substantially similar nature. However, the standard of compliance varies from one jurisdiction to another.

\* Corresponding author.

E-mail address: [mpadma@rgsoipl.iitkgp.ernet.in](mailto:mpadma@rgsoipl.iitkgp.ernet.in) (M. Padmavati).

## 1.2. Duty to disclose: statutory mandate in India

India in particular has a unique standard of duty to disclose. It requires details such that information of “substantially similar” patents in foreign jurisdiction is available to the Indian Patent Office. The whole idea is that if the patent applied for in India has any corresponding foreign application (in any of the convention countries) then information/details have to be provided regarding each one of them from time to time to the patent office. The intention behind this requirement is to make available to the examiner, all the information that should be taken into consideration when judging patentability, as not all relevant information may be readily obtainable or identifiable from other sources. A patent applicant in India has the duty to disclose information at the time of filing a patent application in India, by submitting Form 3 (Appendix III) under Section 8 of the Patents Act, 1970 reproduced below:

Section 8 Information and undertaking regarding foreign applications:

(1) Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file along with his application or subsequently within the prescribed period as the Controller may allow—

(a) a statement setting out detailed particulars of such application; and

(b) an undertaking that, up to the date of grant of patent in India, he would keep the Controller informed in writing, from time to time, of detailed particulars as required under clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequently to the filing of the statement referred to in the aforesaid clause, within the prescribed time.

(2) At any time after an application for patent is filed in India and till the grant of a patent or refusal to grant of a patent made thereon, the Controller may also require the applicant to furnish details, as may be prescribed, relating to the processing of the application in a country outside India, and in that event the applicant shall furnish to the Controller information available to him within such period as may be prescribed.

Disclosure of the information under Section 8(1) requires disclosure of detailed particulars of all the corresponding foreign applications which is to be mandatorily provided by the applicant to the Controller within a period of six months from filing/availability. Since the phrase detailed particulars is not described, the heads of the details could be inferred from Form 3 as including names of countries, application numbers, filing dates, status, the date and number of publication and, if granted, the date of grant and number. An undertaking is necessary to keep the Controller of Patents informed of every other application filed outside India subsequent to the filing of the Indian application. Besides this the second type of information which is to be provided is only when requested by the Controller as laid down under Section 8(2) of the Act. This information includes information relating to objections, if any, in respect of novelty and patentability of the invention, search/examination reports issued, claim amendments, granted claims and other relevant information. The applicant is not required to furnish such details *suo moto*, however, he is free to submit said details on a periodic basis.

The status of an application from the date of application to the date of grant could be ‘Application pending grant of Patent’. During prosecution the status change could be identified as ‘First Examination report issued’ or ‘Non-final rejection’ etc. It is not clear whether the applicant is obliged to inform the Indian Patent Office that the patent application has been rejected in another country without the Controller having asked for it under Section 8(2). The literal interpretation of the statute therefore leaves a great deal for the Patent Office practice procedures to determine how these gaps have to be interpreted in practice. There are further issues as courts have varied in their interpretation. If courts infer an innocent omission as suppression of material information relating to the corresponding foreign applications it would seriously prejudice the grant of a patent and thereby impair validity of the granted patent. Failure to disclose information under section 8 is a ground for invalidation under sections 25(1)(h), 25(2)(h) and 64(1)(m) of the Indian Patents Act reproduced below:

Section 25

(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—

(h) 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;

Section 25

(2) 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:

(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;

Section 64

(1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act, may, be revoked on a petition of any person interested or of the Central Government 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 following grounds, that is to say—

(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;

It is therefore essential that an Applicant should not act merely for obtaining grant of a patent at all costs, but should diligently assist the Controller in reaching a correct decision by disclosing the information about prosecution of corresponding foreign applications. This would enable the Patent Office to grant a patent that has a greater presumption of validity. At this juncture it becomes important to identify the rationale for laying down such a compliance standard by the law makers, so that the meaningful application of this provision is ensured.

## 1.3. Legislative intent behind Section 8 of Indian Patents Act

Disclosure requirement in relation to patents differs from one jurisdiction to another and so does the stringency of its compliance.

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