



Intellectual Property Appellate Board

Delhi Registry –Cum-Bench

G-62 to 67 & 196 to 204, August Kranti Bhawan, Bhikaji Cama Place,

New Delhi – 110 066

Tele No: 011-26180613/14 Email: delhiregistryipab@gmail.com Website: <http://www.ipab.gov.in>

OA/63/2020/PT/DEL

TUESDAY, THIS THE 27TH DAY OF OCTOBER, 2020

**HON'BLE SHRI JUSTICE MANMOHAN SINGH
HON'BLE DR. B.P. SINGH**

**CHAIRMAN
TECHNICAL MEMBER (PATENTS)**

1. DOW AGROSCIENCES LLC

9330 ZIONVILLE RD,
INDIANAPOLIS,
INDIANA 46268
UNITED STATES OF AMERICA

...APPLICANT/APELLANT

(Represented by: Mr Shukadev Khuraijam)

Versus

1. THE CONTROLLER OF PATENTS

THE PATENT OFFICE
BAUDHIK SAMPADA BHAWAN
PLOT NO. 32, SECTORE-14, DWARKA
NEW DELHI – 110 078

...RESPONDENT

(Represented by - None)

ORDER

Hon'ble Shri Justice Manmohan Singh, Chairman

Hon'ble Dr. B.P. Singh, Technical Member (Patents)

1. The present appeal has been preferred under Section 117A of the Indian Patents Act, 1970 against the order dated 31/01/2020, passed by Respondent, under 15 of the Act, refusing the Appellant's Indian patent application no. 8373/DELNP/2014 on the sole formal ground of alleged non-filing of proof of right document.

2. Facts of the case.

2.1 The appellant submitted that the proof of right requirement as mandated by Section 7(2) of the Patents Act, 1970 was duly complied with by furnishing of the PCT document - PCT Declaration under Rule 4.17(ii) supporting the 'Applicant's entitlement to apply for or be granted a patent', at the Indian Patent Office (IPO) at the time of national phase entry i.e. the date of filing of the national phase application in India which was 08/10/2014.

2.2 However, on 20/06/2018, the Respondent issued the First Examination Report raising *inter alia* the following formal objection with respect to the proof of right requirement:

Endorsement by/Assignment from inventor:

The proof of right in the form of endorsement or assignment from the inventors has not been filed yet according to the section 7(2) of The Patents Act, 1970 (as amended). The same should be filed in the prescribed manner with the required petition.

2.3 The Appellant filed the response to the FER on 28/09/2018, i.e. within the stipulated period of six months from the date of issuance of the FER, making the following submission regarding the proof of requirement raised in the FER:

"Endorsement by / Assignment from Inventor

It is submitted that WIPO cover page with 4.17(ii) declaration in lieu of proof of right has been filed in the subject application."

2.4 Despite this submission, the Respondent maintained the requirement with regard to submission of proof of right document in the hearing notice dated 31/10/2018 stating as under:

"Formal requirements-

2. The proof of right in the form of endorsement or assignment from the inventors has not been filed yet according to the section 7(2) of The Patents Act, 1970 (as amended). The same should be filed in the prescribed manner with required petition, if any.”

2.5 The learned counsel of the appellant submits that evidently, the Respondent merely reiterated the requirement in the hearing notice, and neither acknowledged the submission of PCT Declaration under Rule 4.17 (ii), nor provided any reasoning in the hearing notice for not taking the said document on record as a valid proof of right document.

2.6 During the oral hearing attended on 26/11/2018, the Appellant once again brought the attention of the Respondent to the submission of PCT Declaration under Rule 4.17 (ii) and the Respondent directed the Appellant to make the relevant submission in the written arguments in this regard for his consideration.

2.7 The Appellant in his written arguments dated 06/12/2018, submitted the following arguments with regard to proof of right:

“With respect to the Controller’s requirement for filing proof of right in the subject application, the Applicant presents the submissions below and reproduce PCT Rules 4.17 (ii) and Rule 51 bis. 2(ii) relevant in this respect:

Rule 51 bis.2 Certain Circumstances in Which Documents or Evidence May Not Be Required

The designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:

(ii) relating to the applicant’s entitlement, as at the international filing date, to apply for and be granted a patent

(Rule 51bis.1(a)(ii)), if a declaration as to that matter, in accordance with Rule 4.17(ii), is contained in the request or is submitted directly to the designated Office;

*4.17 Declarations Relating to National Requirements
Referred to in Rule 51bis.1(a) (i) to (v)*

The request may, for the purposes of the national law applicable in one or more designated States, contain one or more of the following declarations, worded as prescribed by the Administrative Instructions:

(ii) a declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent,

In further support of the above, the Applicant also enclosed a copy of the PCT Applicant's Guide National Phase (National Chapter – INDIA), which clearly states that the proof of right requirement can be met, if the corresponding declaration is made at the PCT stage.

In the subject application, the applicant has filed a declaration under Rule 4.17(ii) of PCT regulation (Declaration made as applicant's entitlement, as at the international filing date, to apply for and be granted a patent) with PCT Request Form at the time of filing the PCT application PCT/US2013/032270.

As the PCT guidelines, Rule 51bis 2(ii) envisage that a designated office shall not require any document/evidence for applicant's entitlement to apply for Patent, if declaration under Rule 4.17 (ii) is complied with PCT request, unless, it may reasonably doubt the veracity of the declaration, it is humbly submitted that the said declaration should be sufficient and no further evidence/document may be required of the applicant in this context.

2.8 *In view of the aforesaid, the Applicant have met all the requirements of the PCT guidelines evidenced by filing declaration in the PCT request, hence, the applicant is not required to submit proof of right document to file the application in India. Copy of WIPO cover page with rule 4.17(ii) declaration and PCT Request Form is enclosed evidencing the declaration of filing of the said declaration.*

It is also most respectfully brought to the learned Controller's attention that in numerous cases before Indian Patent Office, declaration under Rule 4.17(ii) with the declaration in PCT request or Form PCT/IB/371 has been considered and found sufficient as proof of right and cases proceeded to grant accordingly."

2.9 It's submission of the learned counsel of the appellant that the Respondent, while correctly withdrawing the objections pertaining to technical and other formal issues, surprisingly, vide Impugned Order dated 31/01/2020, (after a gap of more than a year from the hearing) refused the subject application on the sole ground of non-filing of proof of right document.

3. Aggrieved by this impugned order that the appellant has preferred this appeal.

4. Analysis

4.1 In order to assess the need for filing the document, establishing the proof of right, a look at Section 6 of the Patents Act, 1970 is imperative:

“Section 6¹

Persons entitled to apply for patents

(1) Subject to the provisions contained in section 134, an application for a patent for an invention may be made by any of the following persons, that is to say,—

(a) by any person claiming to be the true and first inventor of the invention;

(b) by any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application;

(c) by the legal representative of any deceased person who immediately before his death was entitled to make such an application.

(2) An application under sub-section (1) may be made by any of the persons referred to therein either alone or jointly with any other person.

4.2 As is evident that the provisions of section 6, is subject to the provisions of section 134:

“Section 134²

Notification as to countries not providing for reciprocity

Where any country specified by the Central Government in this behalf by notification in the Official Gazette does not accord to citizens of India the same rights in respect of the grant of patents and the protection of patent rights as it accords to its own nationals, **no national of such country**

¹ Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps6.html>

² Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps134.html>

shall be entitled, either solely or jointly with any other person,—

- a. to apply for the grant of a patent or be registered as the proprietor of a patent;*
- b. to be registered as the assignee of the proprietor of a patent; or*
- c. to apply for a licence or hold any licence under a patent granted under this Act.[Emphasis added]*

4.3 Therefore, it is evident that the clause “*Subject to the provisions contained in section 134*” mentioned in section 6, just carves out an exception that no nationals of any country, specified by the Government of India in its official Gazette, will not be entitled to file patents in India, if it do not accord to citizens of India the same rights in respect of the grant of patents and the protection of patent rights as it accords to its own nationals. In all other cases, the entitlement of filing a patent application is governed by the provisions of section 6, irrespective of type of applications and nationality of the applicants.

4.4 Further section 7 (2) specifies the need for filing ‘proof of right’ in case the application is made by virtue of any assignment. It reads as follows:

“Section 7³

Form of application

“....(2) Where the application is made by virtue of an assignment of the right to apply for a patent for the invention, there shall be furnished with the application, or within such

³ Available at <http://ipindia.nic.in/writereaddata/Portal/ev/sections/ps7.html>

*period as may be prescribed after the filing of the application,
proof of the right to make the application.....”*

4.5 This filing of ‘proof of right’ is governed by Rule 10 of the Patents Rules 2003.

“Rule 10⁴

*Period within which proof of the right under section 7(2) to
make the application shall be furnished*

*Where, in an application for a patent made by virtue of an
assignment of the right to apply for the patent for the invention,
if the proof of the right to make the application is not furnished
with the application, the applicant shall within a period of six
months after the filing of such application furnish such proof.*

*Explanation.--For the purposes of this rule, the six months
period in case of an application corresponding to an
international application in which India is designated shall be
reckoned from the actual date on which the corresponding
application is filed in India.”*

4.6 The application Form-1 for patents prescribed under Rule 2003; under its column 12, mandates for certain declarations. Those relevant for filing ‘proof of right’ is shown as herein below:

(a) In case the applicant is an assignee:

- the inventor(s) may sign the marked portion of the application or
- the applicant may upload the assignment or
- enclose the assignment with this application for patent or
- send the assignment by post/electronic transmission duly authenticated within the prescribed period).

⁴ Available at <http://ipindia.nic.in/writereaddata/Portal/ev/rules/pr10.html>

(b) In case the applicant in India is different than the applicant in the convention country:

- the applicant in the convention country may sign the marked portion of the application or
- applicant in India may upload the assignment from the applicant in the convention country or enclose the said assignment with this application for patent or send the assignment by post/electronic transmission duly authenticated within the prescribed period)

4.7 Rule 20 of the Patents Rules, 2003, prescribes procedures to file an application corresponding to an international application filed under Patent Cooperation Treaty (PCT). Rule 23(1) of the Patents Rules, 2003 under its heading **“The requirements under this Chapter to be supplemental of the regulations, etc., under the Treaty”** states that *“(1) The provisions of this Chapter shall be supplemental to the PCT and the regulation and the administrative instructions made thereunder.”*

4.8 Let's have a look on the relevant provisions of requirement of documentary evidence to establish the eligibility to file a national phase patent application under PCT.

“Rule 51bis⁵

Certain National Requirements Allowed under Article 27

51bis.1 Certain National Requirements Allowed

(a) Subject to Rule 51bis.2, the national law applicable by the designated Office may, in accordance with Article 27, require the applicant to furnish, in particular:

⁵ Available at https://www.wipo.int/pct/en/texts/rules/r51bis.html#_51bis_2

..(ii) any document relating to the applicant's entitlement to apply for or be granted a patent,...

[Emphasis added]

4.9 Rule 51bis 1 again starts with a “subject to” clause and its carves out exception of Rule 51bis 2. Lets have a look on the provisions of Rule 51bis 2:

51bis.2 Certain Circumstances in Which Documents or Evidence May Not Be Required

The designated Office shall not, unless it may reasonably doubt the veracity of the indications or declaration concerned, require any document or evidence:

(i) relating to the identity of the inventor (Rule 51bis.1(a)(i)) (other than a document containing an oath or declaration of inventorship (Rule 51bis.1(a)(iv)), if indications concerning the inventor, in accordance with Rule 4.6, are contained in the request or if a declaration as to the identity of the inventor, in accordance with Rule 4.17(i), is contained in the request or is submitted directly to the designated Office;

(ii) relating to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rule 51bis.1(a)(ii)), if a declaration as to that matter, in accordance with Rule 4.17(ii), is contained in the request or is submitted directly to the designated Office;....”

4.10 In order to further specify what is the declaration under Rule 4.17(ii), Lets have a look on the relevant portion of the PCT Applicants Guide –National Phase⁶

“CHAPTER 5: SPECIAL REQUIREMENTS TO BE COMPLIED WITH IN CONNECTION WITH THE NATIONAL PHASE

<i>Rules</i>	<i>Particulars</i>
<i>Rule 4.17 51bis.2</i>	5.005. What can be done in the international phase to simplify the processing of international applications in the national phase? <i>The applicant may include in Box No. VIII of the request form one or more of the following declarations under Rule 4.17:</i>
<i>Rule 4.17(ii) 51bis.1(a)(ii)</i>	<i>– Box No. VIII(ii): declaration as to the applicant’s entitlement, as at the international filing date, to apply for and be granted a patent;</i>

4.11 The applicant submitted that they filed such declaration and we have noted that the declaration filed by the appellant is available on the IPO Website with their written submission of hearing on 06/12/2018, though not in proper format. This declaration is also available on WIPO⁷ official website in similar manner.

5. We have further noted that Indian Patent Office under “Summary of requirements for entry into the national phase”⁸ has notified that the requirement of instrument of assignment or transfer, where the applicant is not the inventor is satisfied, if the corresponding declaration has been made in accordance with PCT Rule 4.17.

⁶ Available at <https://www.wipo.int/pct/en/guide/npindex.html>

⁷ Available at https://patentscope.wipo.int/search/en/detail.jsf?docId=WO2013148338&tab=PCTDOCUMENTS&_cid=P22-KGNRWK-98684-1

⁸ Available at <https://www.wipo.int/export/sites/www/pct/guide/en/gdvol2/annexes/in.pdf>

6. Now, let's consider the instant application. While refusing the case, the respondent has cited an earlier order of this Board in *NTT DoCoMo Inc. v Controller of Patents and Designs*⁹. The case under reference was based on different facts. The petitioner therein had contention that they have preferred a conventional application which is governed by section 135 of the Patents Act, 1970 and as per section 135, it is clear that section 6 is applicable only to ordinary application and not to conventional applications. The Board held that *"In view of the above said unambiguous provisions, we are of the considered view that it is incumbent on the applicant to substantiate or establish proof of right to make the application."*
7. Here, there is no denial on the part of the appellant about the requirement of 'proof of right', in case of PCT National phase applications. What they precisely argue that in case of availability of the declaration under Rule 4.17(ii) of the PCT; such requirements are considered to have been met. Therefore, the case referred to by the respondent to refuse the application is not analogous to the instant case. The appellant never claimed the fact that the requirement of filing 'proof of right' is not a mandatory condition under the Patents Law. What they submit is the legally accepted norms by which this requirement is supposed to have been obviated.
8. Further, we have noted that no indication is available to suggest that the respondent at any point of time had shown a reasonable doubt on the veracity of the indications or declaration concerned. There is no objection on its format either. In case of any doubt on veracity of the declaration, the respondent could have required any further document or evidence to substantiate the contention of the appellant, in accordance with Rule 51bis.2 of the Regulations under Patent Cooperation Treaty (PCT); but no such finding is available on records.

⁹ OA/39/2011/PT/CH

9. Therefore, we are of the firm opinion that the respondent did not take into account the comprehensive look on the legally accepted norms by which the requirements of filing 'proof of right' could be satisfied. He also couldn't apply the analogous case law and refused the application, citing a case law based on different facts. The refusal of the instant application, in spite of the valid arguments and submission by the appellant shows utter obstinateness on the part of the respondent.

10. We observe that the legal requirement of filing 'proof of right' is met by filing of the declaration under Rule 4.17 (ii) of the PCT Regulations by the appellant. There is no other ground or objection to the grant of patent which is mentioned in the refusal order.

11. Therefore, keeping in view the above facts, we set aside the impugned order dated 31/01/2020 of respondent and direct him to grant the patent in respect of the invention claimed in the instant application no. 8373/DELNP/2014 strictly within 2 weeks of the issuance of this order.

12. The appeal is allowed. No Cost.

- Sd/-

(Dr. B.P. Singh)
Technical Member (Patents)

-Sd/-

(Justice Manmohan Singh)
Chairman

Disclaimer: This order is being published for present information and should not be taken as a certified copy issued by the Board