



Providing "Proof of Right" - An Unwelcome Additional Burden on Applicants in India

Section 7(2) of the Indian Patents Act requires that when an application is made “*by virtue of an assignment of the right to apply for a patent for the invention*”, then it is necessary to file “*proof of the right to make the application*”. The so-called “proof of right” is normally a “Form 1” signed by the applicant and the inventors. Alternatively, a certified/notarised copy of an assignment of rights in the invention in India from the inventors to the applicant can be filed in place of a “Form 1”.

Historically, the Indian Patent Office did not require “proof of right” to be filed if the applicant(s) for the priority application(s) and the applicant(s) for the subsequent convention filing were the same. This practice was based on an earlier opinion issued by the Controller General of Patents.

Given that most non-US priority applications are filed in the name of the applicant company and the subsequent convention application is also filed in the name of the same applicant company, it was not normally necessary to file “proof of right”. The main exception arose with applications claiming priority from one or more US patent applications filed in the name of the inventors, where the Indian Patent Office did require “proof of right” to be filed.

The Indian Intellectual Property Appellate Board (IPAB) has, however, recently overturned the earlier opinion issued by the Controller General of Patents. Thus, the IPAB indicated in *NTT DOCOMO Inc vs The Controller of Patents and Designs* that “proof of right” must be filed for all applications where the applicants are not the inventors.

It remains to be seen how quickly Indian Patent Office practice will change in view of the IPAB decision. Nevertheless, it is now likely to be necessary to file “proof of right” for the majority of Indian patent applications prior to grant. Thus, for pending Indian patent applications where “proof of right” has not yet been filed, applicants should expect that it will be necessary to file “proof of right” before the expiry of the acceptance deadline. For future Indian patent applications, “proof of right” should be filed within six months of entry into the Indian national phase, if possible, though it should also be possible alternatively to comply with the requirement once substantive examination commences.

If the Indian Patent Office does **not** ask for a “proof of right” on pending applications where such evidence has not previously been filed, the application could be granted without the need to

supply “proof of right” documentation. However, under those circumstances, third parties could potentially apply to the Indian Courts for revocation of the patent on the basis that “proof of right” was not filed during prosecution. Although it may be possible to defeat any such attacks by filing “proof of right” documentation during the revocation action, it may be more difficult to secure the necessary signatures at that late stage. We therefore recommend that if possible “proof of right” be filed on all pending Indian patent applications even in the absence of a Patent Office request for that material.

Accordingly, J A Kemp will review all pending Indian patent applications in our care to determine whether “proof of right” documentation needs to be filed. Your usual J A Kemp contact will be in touch if action is needed in this regard.

05 March 2014

For more information, please contact:

Toby Hopkin - thopkin@jakemp.com

Chris Milton - cmilton@jakemp.com

Ravi Srinivasan - rsrinivasan@jakemp.com