



Legal and Administerial Overreach by IPO while Considering Proof of Right Requirement

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India being a dualist country has to domesticate treaty obligations to enforce the same at domestic level by enacting statutes, which in turn must be construed in the light of the parent treaty. This paper introspects the complexity in identifying the applicable rule concerning the Proof of Right requirement for Indian National Phase Applications under Patent Cooperation Treaty (PCT) Rule 4.17. It goes on to highlight the incongruity between the PCT regulations and the domestic law as interpreted and applied by the Indian Patent Office (IPO). A comparative study of legal positions in other countries are also included for a better understanding of approaches by foreign patent offices towards implementing PCT obligations concerning Proof of Right. In essence, this paper sheds light on how the IPO's demand for proof of right contradicts with several provisions of the PCT Regulations, the recent PCT Applicant's Guide for the national phase and concludes by mooted some suggestions to resolve the issue.

Keywords: PCT Rule 4.17, Proof of Right, Declaration by Inventors, Indian National Phase Application, Patent Office Manual, WIPO CASE

Negation of the Purpose of PCT

A Declaration by inventors under Rule 4.17 Patent Cooperation Treaty (PCT) and Form-1 of The Patents Act, 1970, declares that the applicant is an assignee of the true and first inventor, and the inventor testifies with his signature that he has assigned his right to apply for patent, to the applicant. Even after providing the Declaration as per PCT Rule 4.17(ii), during the examination of the corresponding Indian national phase application, when such Declaration is available online in the WIPO CASE and made freely accessible to Indian Patent Office, the Office still insists on submission of proof of right either by way of filling the Declaration by Inventors in column 12(i) of Form-1 or by furnishing an Assignment Deed.¹

The Declaration by inventors in Form 1 requires the inventor's signature if he/she is a single inventor. In the case of multiple inventors, signatures of all the inventors need to be provided in the column for the Declaration. It is to be understood that finding all the inventors who may be residing in different parts of the world at the relevant time and obtaining their signatures in the prescribed format within the stipulated time period, is an extremely cumbersome and time-consuming process and practically infeasible

in most cases. However, the applicants are being compelled to undergo this procedure again at the national phase stage in India, despite the furnishing of a common assignment and a Declaration under Rule 4.17(ii) of PCT at the time of international filing. Thus, the very purpose behind the Patent Cooperation Treaty's adoption, which is to streamline and simplify procedures/formalities for applicants at the national patent office, is being undermined by the Indian Patent Office when it insists on the applicants to unnecessarily repeat the application formalities. By doing so, some of the benefits of procedural simplification of the Treaty are being taken away from the Applicants.

PCT and Procedures of Patent Filing, Examination, Search and Grant

Patent Cooperation Treaty: Procedural Aspects

India deposited its instrument of accession to the Patent Cooperation Treaty (PCT) on 7 September 1998. The PCT provides for the filing of a single international application in one language, having an effect in each of the countries that are party to the PCT, which the applicant designates in his application for patent protection.²

The patent filing procedure usually begins with the filing of first patent application in the national or

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regional patent office (local application). Based on the contents specified in the local application, a PCT international application is usually filed within 12 months thereafter with the Receiving Office (RO) of national/regional patent office or directly with the RO of WIPO if national laws permit it. Following this, the chosen patent office known as the International Searching Authority (ISA) performs search and provides an International Search Report (ISR) and Written Opinion within 16 months from the priority date of the application. This search report provides citations of patent documents and technical references relevant for determining the patentability of the invention. The International Bureau of WIPO publishes the application at this stage (after 18 months from the priority date), which serves to provide technical disclosure of the invention. Sometimes the applicant may request a supplementary international search to expand the linguistic and technical scope of the search. To further evaluate the chances of obtaining a grant of the patent, the applicant may file a demand for International Preliminary Examination with a national or regional patent office that has been appointed as an International Preliminary Examining Authority (IPEA)³ under the PCT, which is done within 22 months from the priority date. The International Preliminary Report on Patentability (IPRP) provided by IPEA is generally non-binding opinion and is only provided to applicants who have filed a Demand for it. The end of the international phase is marked by the entry into the national phase patent procedure. Once in the national phase, the patent application is subject to the patent laws, regulations, and practices of each country.⁴

The Request

The request part of the PCT application typically contains details, information, and a petition for processing the application as per PCT terms. The filling of a PCT application electronically would generate a request form automatically.⁵ To facilitate the processing of the PCT application during the national phase, there is an option to include certain declarations in the request form which allows the applicant to comply at the time of filing the PCT application with specific national law requirement.⁶ Sections 211 to 212⁷ of the 'Administrative Instructions under the PCT' provide for standardized wordings of declarations under PCT Rule 4.17. While filing the Declaration, an applicant has to take into

consideration the facts of the case, the chronology of events, and apply standardized wordings.

Although, the Regulations governing the acceptance of declarations by designated offices, was entered on 1 March 2001, it was initially subject to notifications of incompatibility with the national laws of few States. They later withdrew this status of incompatibility. Thus, no designated offices are generally entitled to require a national-type declaration on the subject matters covered by the declarations referred to in PCT Rule 4.17 or require further information other than what is contained in the standardized wording of the Declaration. The exception to this rule is whereby, if the designated Office doubts the veracity of a PCT Declaration or the indications in the Declaration, it is entitled, under PCT Rule 51*bis*.2⁸ to request further proof or evidence on the subject matter in question. This would be on a case to case basis, and there cannot be a general requirement by the Office.

The intention of PCT Rule 4.17 and Rule 51*bis*.2 is to minimize the requests of the designated Office on further proof or evidence regarding the declarations. Further, Article 27 of PCT also limits the requirements that can be set by a National Office upon entry in the National Phase. Article 27(1) of the PCT clearly states that no national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in the Treaty and the Regulations. However, certain national requirements, including demand for proof of right documents under PCT Rule 4.17(ii), are allowed under Article 27(2) read with Rule 51*bis*.1. Nonetheless, such documents demandable by National Offices under Article 27(2) read with Rule 51*bis*.1 are subject to the condition stipulated under Rule 51*bis*.2. Hence, in effect, no further proof for the declaration filed under PCT Rule 4.17(ii), shall be demanded by the national offices unless it reasonably suspects the veracity of such Declaration. In adopting the Regulations regarding the submission of declarations to the International Bureau (IB)⁹ during the international phase, the member States agreed that if an applicant submits a declaration that complies with the standardized wording contained in the Administrative Instructions under the PCT within the applicable time limit, such declarations should generally be accepted at face value. Therefore, to the extent the national law

of a designated Office contains requirements different from those of the PCT, the provisions of the PCT must prevail, and it is the responsibility of the State concerned to ensure that this is the case.

If the wording of a declaration does not conform to that standardized wording, the applicant by Form PCT/IB/370¹⁰ has the opportunity to correct the Declaration within the time limit under PCT Rule 26ter. According to PCT Rule 26ter,¹¹ where the receiving Office or the International Bureau (IB) finds that any declaration is not worded as required, it may invite the applicant to correct the Declaration within a time limit of 16 months from the priority date. If the Declaration is not subsequently corrected so as to conform to the standardized wording, it will not lead to any loss of rights, and the IB will, nevertheless, publish the Declaration. It will then be up to each of the designated offices concerned to determine whether it can accept the Declaration or not, and the designated office(s) would be entitled to require the applicant to furnish a new declaration or further evidence in the national phase.

National Phase Application

The Patents Act,¹² deals with the provisions of international arrangements under Chapter XXII.¹³ Section 138¹⁴ of the Patents Act provides for PCT application in the national phase. According to Section 6,¹⁵ a person claiming to be the true and first inventor of the invention, assignee of the person claiming to be the true and first inventor and the legal representative of any deceased person who immediately before his death was entitled to make such an application can file patent applications in India. In cases where the assignee files the application, the assignee is required to submit a 'Proof of Right', as per Section 7(2)¹⁶ of the Patents Act, 1970. According to the Patent Office Manual, the documents that are considered 'Proof of Right' include:

- a) Declarations by inventors under column 12(i) of Form-1 of the Application for Grant of Patent¹⁷ that requires the signature of the inventor(s) stating that the patent applicant is their assignee or legal representative.
- b) A legal assignment deed between an inventor(s) and the assignee. In this case, either an original deed or notarized copy may be submitted as the proof of right.
- c) Declarations given as a part of PCT Rule submitted 4.17(ii) to the Receiving Office.

In the event of any change in the applicant(s) and/or inventor(s) of the PCT application before filing the national phase application in India, the said change has to be notified by the International Bureau in Form PCT/IB/306. In the absence of such notification by the IB, the national phase application needs to be filed in India as per the information available with the IB, and subsequently, an application to record the assignment of rights from present assignee to the new assignee needs to be filed by the present assignee.

The Central Government can make rules on patent related subject matters as specified in Section 159 of the Patent Act. Rule 10¹⁸ states the period within which proof of the right under Section 7(2) to make the application shall be furnished. According to the said rule, if the proof of the right to make the application is not furnished along with the application, the applicant shall within a period of six months after the filing of such application furnish such proof.

The General Principles of Law

Need for Harmonious Construction of PCT and the Patents Act, 1970

As a country that follows the Doctrine of Dualism with respect to International Law, the International Law's adoption into the Municipal Law is necessary to enforce and implement the international law in India's territory. *Jolly George Varghese v The Bank of Cochin*¹⁹ is a landmark case in which the Supreme Court of India laid down the law on the enforcement of the Conventions or Treaties ratified by India. The Supreme Court observed that the Indian Constitution follows the 'dualistic' Doctrine with respect to international law and consequently held that an International Treaty ratified by the Government of India would not, *ipso facto*, become part of the National Law in India, until the same is incorporated into the municipal law by passing a domestic legislation giving effect to the Treaty. The fact that our country follows dualist model has been reiterated by the Supreme Court time and again.²⁰

Therefore, an International Treaty can be enforced in India only so long as it is not in conflict with the Municipal Laws of the State.²¹ In the case of a conflict between an International Treaty and a non-ambiguous Domestic Statute, the Domestic Statute prevails. If the statutory law is ambiguous and subject to multiple interpretations, both the treaty law and the statutory law are harmoniously construed in order to

avoid the conflict. Thus, the Indian Courts view international conventions and treaties only as an external aid for construction of a national legislation.²²

However, in the given context, the role of PCT is not restricted to an 'external aid of interpretation' because the domestic law²³ has stated that in case of any conflict between the PCT/Regulations/Administrative instructions and the Patent Rules concerning International Applications, the former shall prevail. Therefore, when the question of which law prevails, arises, keeping PCT on one hand and the Patent Rules 2003 on the other hand, the Patent Rules must yield to the PCT by virtue of Rule 23.

The Patents Act, 1970 was amended in 2002 in compliance with PCT to implement the provisions of the Treaty in the national phase patent filing procedures in India. In the context of the 'Proof of Right' under Section 7(2) of the Act, the India Patent Office²⁴ as well as the Intellectual Property Appellate Board (IPAB) has recently adopted an interpretation quite contrary to the corresponding provisions in the PCT with regard to the National Phase applications under PCT. Where the PCT regulations provide that the National Patent Offices shall demand documents evidencing the assignment of the right to apply for patents only in circumstances where the veracity of the Declaration under Rule 4.17 is under suspicion, the Controller of Patents and the IPAB insists on mandatory submission of proof at the time of national filing stage, for 'all applications'. The order of IPAB in the *NTT DoCoMo* case is not applicable for PCT National Phase Applications and, therefore, distinguishable from the current issue (For more details, please refer to Para 8). Therefore, in accordance with the Doctrine of harmonious construction, Section 7(2) of the Patents Act 1970 has to be harmoniously construed with the relevant provisions²⁵ of the PCT and the spirit of the Treaty.

Executive Guidelines cannot override the Statute and the Rules

It is settled law that executive instructions cannot amend or supersede or make additions to the statutory rules or provisions of an Act.²⁶ Similarly, statutory rules cannot be in conflict with the provisions of the Act, and in the event of a conflict, the Act prevails over the rule. Any executive instruction or order inconsistent with the statutory rules is not enforceable and is liable to be struck down as having no force of law.²⁷

Rule 03.01 of the Patent Office Manual 2019 exceeds the dictates of Section 7(2) and Section

138(4) of the Patents Act. Section 7(2) of the Act speaks about the submission of the proof of right in broad general terms whereas the Manual 2019 has proceeded to interpret Section 7(2) in definite terms. To the extent the scope of the 'Proof of Right' has been narrowed down and confined by the Manual which is an executive document, it is not enforceable.

Further, Section 138(4) of the Patents Act clearly lays down that an international application filed under the PCT designating India shall have the effect of filing an application for patent under Section 7 of the Act. Section 7(2) provides for the proof of the right requirement. Therefore, by virtue of Section 138(4) of the Act, a properly filed in international application under PCT is deemed to have complied with the Proof of Right requirement under Section 7(2) and the separate furnishing of proof of right is not required at the time of making the National Application.

Thus, no provision of the Patents Act, 1970 directs an Applicant who is making a national phase application under PCT, to furnish a Declaration from Inventors in Form-1 or submit an assignment deed. Furthermore, the Patents Act gives enough leeway to the applicant in producing any document that evidences the assignment of the right to apply, from the inventor to the applicant. However, the Patent Office Manual, an executive document undertakes to confine the scope of this proof of right under Section 7(2) by directing that it should be submitted either by way of an endorsement in the Form-1 (Declaration from Inventors in Column 12(i)) or an Assignment Deed. The Declaration by inventors filed in accordance with Rule 4.17 PCT is sufficient proof of right for the national phase examination, and the same can be accessed by the Indian Patent Office from the respective WIPO CASE available online. However, in Chapter 03.01 the Manual categorically states that where the inventor(s) is/are not the applicant(s), a proof of right to apply for a patent shall be submitted by way of endorsement in the appropriate paragraph of Form-1 or as an assignment from the inventor(s) in favour of applicant(s), duly authenticated, irrespective of whether the application is a Convention or National Phase Application.

Ayyangar Committee Report

In 1957, the Government of India appointed a Committee presided over by Justice N. Rajagopala Ayyangar to submit a report advising the government on the matter of revision of the Patent Laws in India. Based on the recommendations of the Ayyangar

Committee, the Patents Act, 1970 was enacted which repealed and replaced that part of the Patents & Designs Act, 1911 concerning the Patents Law.

Addressing the issue of proof of assignment, the Report says that the consent of the true and first inventor obtained in the form of an affidavit/declaration is sufficient proof for the applicant's title to the invention. As per the said Report, the statute is not to mandate submission of particular evidence as proof of the applicant's right to apply for the patent; however, the Patent Rules may incorporate provisions for the same. To quote Late Justice N. Rajagopala Ayyangar from his Report,

'The applicant would no doubt have to establish his title to make the application and for this purpose it is sufficient to require him to file an affidavit setting out how he traces his title to the invention. The rules might make provision for the particular evidence which he must produce to prove his case.'

The Report goes on to suggest that where the application is made by virtue of an assignment of the right to apply for a patent, there shall be furnished (a) an affidavit signed by the true and first inventor or his legal representative stating that he assents to the making of the application and (b) an affidavit signed by the applicant setting out the facts relied on to support the application.²⁸ Thus, in accordance with the recommendations of the Committee, the concerned provision in the Act shall only ask for the above-mentioned affidavits/declarations as proof. The Report does not mention that the consent of the inventor has to be obtained by way of mandatory Declaration in any particular format like Form-1 or Assignment Deed.

Application of Patent Office Manual

On the question of placing reliance on the Patent Office Manual, two schools of thought can be considered as existing. One is with respect to the significant role being played by the Manual in bridging the gap in the application of the general provisions of the Patents Act and the Patent Rules in specific applications like the National Phase Applications under PCT and the Convention. The second school of thought speaks about the irrelevance and non-binding effect of the Manual.

First School of Thought

The Patents Act being a general statute encompassing all aspects of the Patent law, it is impossible for the Act to provide special provisions

detailing all the incorporated provisions of the ratified international conventions and treaties. Therefore, to solve this issue of ambiguity concerning the implementation of general sections of the statute in specific applications, the Manual acts as a set of guidelines for the Patent Examiners, Controller as well as the Applicants. It codifies the practices of the Indian Patent Office, incorporating the changes brought about through Amendment Acts, new Rules, and Judgments. The Manual is also revised from time to time based on interpretations by a Court of Law, statutory amendments and valuable inputs from the stakeholders. In this context, the Manual assumes a major role and are heavily relied upon by the Patent Office and Applicants as a document that facilitates smooth application.

Second School of Thought

The other school of thought adopts a contrary view regarding the relevance and applicability of the Manual. As per this proposition, Manuals are irrelevant, holding no sanctity before the law and are non-binding on the Courts, Patent Office, and Applicants. In the below paragraphs, the reasons substantiating the second school of thought are pointed out in detail.

Legality of the Patent Office Manual

The Manual is only an executive document that does not have an authority of law. The rules laid down in the Manual are not binding on the Patent Office and therefore non-enforceable. It is only a codification of the patent procedures to provide internal guidance for the prosecution of patent applications at the Patent Office. The preface of the Manual says:

'This Manual may be considered a practical guide for the effective prosecution of patent applications in India. However, it does not constitute rulemaking and, hence, does not have the force and effect of law. The Manual will be revised from time to time based on interpretations by courts of law, statutory amendments, and valuable inputs from the stakeholders.'

The National Working Group on Patent Law in its comments²⁹ on the Draft Manual of Patent, Practice, and Procedures 2008, dated 16th April 2008 wrote to the then Controller General of Patents, Designs, and Trade Marks saying it fully agrees with the views expressed by Justice V. R. Krishna Iyer, Former Judge, Supreme Court, in his comments on the same addressed to the Prime Minister of India, about the 'irrelevance' of the Manual issued by the Patent Office.

Irrelevance of the Manual for the Interpretation of the Patents Act and Rules

The Manual holds no legal value before any authority of law, for the following reasons, as quoted by Justice Krishna Iyer:¹

- a) The Patent Office practice has to be within the framework of statute of law, and all questions concerning the examination of the patent application and the procedure governing the grant of patents are solely within the purview of and regulated by the provisions contained in the Patents Act and Rules. As previously discussed, the Manual reduces the scope of Proof of Right under Section 7(2) by confining it to the Declaration by Inventors under Form-1 and the Assignment Deed, whereas the Patents Act intends to give the same a broader interpretation by leaving the term 'Proof of Right' undefined.
- b) The powers of the Controller are set out in Section 73(3) and (4) and Sections 77 to 81 of the Act, and those specifically referred to in respect of certain proceedings under the Act. Neither the Controller nor the Central Government has any authority or sanction of law to publish a Manual of this nature.
- c) Through the disclaimer of non-enforceability, set out in the preface of the Manual, the Patent Office recognizes the absence of any legality for the document and disowns any authoritative nature to the contents of the document.

However, for practical purposes and in contradiction to the point (c), the Manual and the procedures set out therein are enforced by the Patent Office. The duty of interpretation of the law is within the domain of Courts and not of a public body. The Patent Office, through these Manuals, seems to undertake the function of interpretation of the Patent Law in India, despite the disclaimer about its legal enforceability. Thus the Manual might provide a fertile ground for litigation and controversy in the interpretation of the provisions of the Patents Act and Patent Rules.

Suggestions for the Manner of Implementation of the Patent Office Manual

Taking into consideration the pros and cons of views of both the proponents, it is essential to adopt a middle ground to resolve the matter at hand with respect to the 'Proof of Right' requirement. To the extent the rules of the Manual are inconsistent with the spirit of the PCT, it negates the purpose behind

India becoming a party to the Treaty and contradicts any provision of the Patents Act, 1970 it should be disregarded, and the PCT, its Regulations and Administrative Instructions should prevail. In the given case, the inconsistency lies in Rule 03.01 under Chapter 3 of the Manual of Patent Office Practice and Procedure 2019, which is the most updated Manual.

This rule is clearly inconsistent with Section 138(4) of the Patents Act, PCT Rule 4.17 read with Rule 51*bis*.1(a)(ii) and 51*bis*.2(ii), and the clarifications provided by the Patent Office in the PCT Applicant's Guide - National Phase, 2020 and the PCT Applicant's Guide - International Phase, 2020. Therefore, the inconsistent provision needs to be revised or amended in accordance with the stipulations of the PCT and the PCT Applicant's Guides.

Case Analysis***NTT DoCoMo v The Controller of Patents and Designs***

In 2013, the IPAB delivered a landmark order clarifying the ambiguity concerning the proof of right requirement under Section 7(2) of the Indian Patents Act, 1970 for Convention Applications. The applicant *NTT DoCoMo*, Japanese Company submitted a Convention application for grant of the patent before the Indian Patent Office.

It had declared in Form-1 and Form-5 that they were the assignees of the true and first inventor, but they did not obtain the signatures of the inventor(s) in the column for Declaration by inventors in Form-1. The Controller rejected the application citing several objections among which the most pertinent issue was the failure of the applicant to furnish the proof of right. *NTT DoCoMo* argued that for Convention applications, it is sufficient to substantiate the right of the applicant to apply, and there is no requirement to establish the proof of right. As far as Section 7(2) is concerned, the authority is to consider only the right of the applicant to apply and not in respect of proof of such right. The decision of IPAB:

- a) Section 7(2) makes it clear that if the patent application is made by virtue of an assignment of the right to apply, the appellant shall produce the proof of the right to make the application within the prescribed period.
- b) As per Section 139 all the provisions of the Patents Act, 1970 shall apply in relation to a convention application as they apply in relation to an ordinary application.

- c) No documents filed by the applicant to prove whether it has got a worldwide assignment or at least the right to make the application in India from the inventor.
- d) The applicant is given an opportunity to produce the required documents of proof of right, failing which the order would be automatically restored, i.e., the application would be rejected.

Critical Analysis of the Order

The larger issue of the harmonious construction of the provisions of PCT, the Regulations and the Administrative Instructions thereunder with the corresponding Section 7(2) of the Patents Act 1970, in the context of national phase applications under PCT, has not been dealt with by the IPAB. Hence the scope of the IPAB order, in this case, is restricted to Convention Applications and ordinary applications under the Act and, therefore, not applicable to applications filed under PCT.

IPAB insists on the production of proof however, it has not indicated anything regarding the nature of the document to be submitted as the proof. Neither does the Patents Act specify, in particular, about the nature of the proof of right. Hence any document showing the willingness of the inventor, to grant the right to apply, to the applicant, is sufficient to fulfil the requirement under Section 7(2) of the Act and the direction of IPAB in the instant case.

The Decision in NTT DoCoMo Case Stands Distinguished

The instant case is concerning a Convention Application and the holding that proof of right requirement under Section 7(2) invariably applies to Convention Applications, is by virtue of Section 139 of the Act. As per Section 139 of the Act, all the provisions of the Act shall apply in relation to a convention application as they apply in relation to an ordinary application. However, with respect to national phase applications under the Patent Cooperation Treaty, a similar provision corresponding to Section 139 covering PCT applications does not exist. In other words, there is no provision in the Patents Act, which states that all the provisions of the Act are applicable to a PCT application as they apply to an ordinary application.

For the sake of arguments, Section 7 (1A) may be taken as a provision comparable with Section 139 in this regard. Section 7(1A) provides that every international application under PCT, designating India

shall be deemed to be an application under the Patents Act if a corresponding application has also been filed before the Controller in India. However, any inference to the effect that both ordinary applications and PCT National Phase Applications are subject to the same proof of right requirements under Section 7(2) is wrong by virtue of Section 138(4). Section 138(4) states that a PCT application shall have the effect of filing an application for a patent under Section 7 of the Act, meaning a national application corresponding to a PCT application is deemed to have satisfied the proof of right requirement under Section 7(2) of the Patents Act.

Hence the holding in the *NTT DoCoMo* case is distinguishable on both facts and applicable law, from the limited issue which was to be determined in that case which was whether 'Proof of Right requirement under Section 7(2) of the Indian Patents Act 1970 is applicable to Convention Applications'. While deciding this case, the IPAB was not adjudicating upon the legality and enforceability of PCT Rule 4.17 read with Rule 51bis.1 (a)(ii) and 51bis.2(ii) in India. That was not an issue for consideration before the IPAB and therefore any attempt to interpret this order in a manner negating PCT Rule 4.17 read with Rule 51bis.1(a)(ii) and Rule 51bis.2(ii) would be inconsistent with the international obligations of India under PCT.

Recent Clarifications in PCT Applicant's Guide

The National Phase Chapter of the *PCT Applicant's Guide* contains information on the "National Phase" of the PCT procedure, namely the procedure before the designated (or elected) Offices. It follows on from information on the "International Phase" of the PCT procedure. The draft of each Chapter dealing with an Office (national or regional) in its capacity as designated (and elected) Office has been approved by that Office.³⁰

PCT Applicant's Guide - National Phase³¹

Special Requirements of the Indian Patent Office includes an 'Instrument of assignment or transfer' where the applicant is not the Inventor and a 'Declaration of Inventorship by the Applicant'. The latest PCT Applicant's Guide for National Phase Application in India, issued on 26 March 2020 clarifies the ambiguity concerning the furnishing of the Assignment deed as proof of right. The Indian Patent Office in this Guide has clearly stated that the 'requirement of instrument of assignment or transfer where the applicant is not the inventor may be

satisfied if the corresponding declaration has been made in accordance with PCT Rule 4.17.’

PCT Applicant’s Guide - International Phase, updated on 1st July, 2020³²

Answering the question whether the designated Offices would require further evidence during the national phase, the given Applicants’ Guide provides that where the Declaration in question is one of those referred to in PCT Rule 4.17(i) to (iv), the designated Office may not require any document or evidence relating to the subject matter of such Declaration unless it may reasonably doubt the veracity of that Declaration.³³ All declarations filed under PCT Rule 4.17 will be part of the published international application. National Patent Offices can obtain the relevant Declarations from the published international application and will, therefore, not be communicated separately.³⁴

Legal Position in Other Jurisdictions

United States of America

The current US Patent law envisages situations where it is infeasible to obtain a Declaration of Inventorship as proof of assignment of the right to apply for a patent and provides for a viable alternative in favour of the applicant. Section 4(a) of the Leahy–Smith America Invents Act (AIA), 2011 amended the 35 USC 115 and 118 to change the requirements for the inventor’s oath or declaration.³⁵ There might arise situations where an inventor is unable to file the oath/declaration by reason of his/her death, legal incapacity, or cannot be found or reached after diligent effort, or he/she is under an obligation to assign the invention but has refused to make the oath/declaration.³⁶ In such circumstances, in lieu of the execution of an oath/ declaration by the inventor, the applicant for patent may provide a substitute statement.³⁷

The substitute statement must identify the individual with respect to whom the statement applies, set forth the circumstances for the permitted basis for filing the substitute statement in lieu of the oath or Declaration, and contain any additional information as required by the Director.³⁸ It must also contain an acknowledgment that any wilful false statement made in such statement is punishable under Section 1001 of Title 18 by fine or imprisonment of not more than five years, or both.

United Kingdom

The United Kingdom Patent Office³⁹ requires the applicant to submit their derivation of right. The Patent Office does not require submission of original assignment but its particulars (e.g., parties and date) should be included in Patents Form 7.⁴⁰ United Kingdom Patent Office may require the applicant to submit the name and address of the inventor if they have not been furnished in the "Request" part of the international application. As per the national laws, no representation by an agent is required, but an address for service in the European Economic Area or the Channel Islands is necessary.⁴¹ This means that once the declarations are filed as per Rule 4.17 of PCT completely, it satisfies the requirement of national law regarding the derivation of the right for granting of the patent.

China

The China National Intellectual Property Administration (CNIPA) presumes the applicant has the right to file the international application, and therefore no instrument of assignment is required if the international application is filed by an entity for an employee invention made by an inventor who is an employee of that entity. Thus CNIPA considers filing a declaration as per PCT Rule 4.17 in international applications would satisfy the requirement of proof of right. However, the national patent office may ask the applicant to resubmit it in the national phase if the name of the inventor has not been furnished in the "Request" part of the international application or if there is a change in applicant’s name and other similar circumstances.

Brazil

National Institute of Industrial Property which is the national patent office of Brazil requires the submission of the instrument of assignment where the name of the applicant has changed after the international filing date, and the change has not been reflected in a notification from the International Bureau (PCT/IB/306) as a part of 51bis Rule requirement of PCT. Thus, the patent office accepts the completed Declaration submitted in the international phase under Rule 4.17 for national law requirements.

Japan

The National Patent Office⁴² requires Proof of Right as a part of the patent application process. The

requirement of assignment is satisfied by filing a Declaration as per PCT Rule 4.17. But if the applicant is a legal entity, an indication of the name of an officer representing that entity (the indication of such a name is not required where a patent attorney represents the legal entity) is required to be submitted. The National Office may require an agent's appointment if the applicant is not resident in Japan as special requirement.⁴¹ The Proof of Right is required if the name or the residence of the applicant is changed during the international phase and the change has not been reflected in the international publication or in a Notification of the Recording of a Change (Form PCT/IB/306), a statement indicating the change (preferably, on a special request form). Where a change (addition and/or deletion) in the person of the inventor during the international phase has not been reflected in the international publication or in a Notification of the Recording of a Change (Form PCT/IB/306), the correct indications relating to the inventor [preferably, on a special transmittal form (Form 53)], a statement explaining the reasons for the change and a written oath of all inventors need to be furnished.⁴¹

Suggestions

The Manual can include an explicit provision similar to Rule 23 of the Patent Rules 2003 stating that in case of any conflict, the provisions of the Treaty and the Regulations and Administrative Instructions shall prevail over the rules and provisions of the Patents Act, in relation to the international applications under PCT. This could avoid confusion and, in case of conflicts, guide the Indian Patent Office and the Applicants to the correct law to be followed. Although the Doctrine of harmonious construction attempts to reduce the confusion by providing that the domestic law should be interpreted in line with international treaties to avoid conflicts (for more details refer to Para 5.1), an explicit provision in the Manual worded along the lines of Rule 23 could be an effective method to avoiding inconsistencies, rather than resorting to the intricate principles of interpretation of statutes.

The Indian Patent Office Examiners may follow the updated PCT Applicant's Guide, National Phase⁴¹ issued in 2020 over the Order of IPAB in *NTT DoCoMo Case, for PCT National Phase Applications*. This is because the Applicant's Guide is a specific guideline addressing solely the procedure concerning

the PCT National Phase applications in India, whereas the *NTT DoCoMo Case* is a pre-dated order which is limited to Convention Applications and ordinary applications under the Patents Act, 1970.

The requirement of separate submission of proof of right by PCT applicants in India can be waived off without amending or revising the Section 7(2) of the Patents Act, by way of an Office Circular from the Controller General of Patents, Designs and Trade Marks. The Controller in 2018 had brought the application of Section 8(2) of the Patents Act 1970 in favour of the applicant by utilizing the facilities offered by the centralised WIPO CASE, without omitting or declaring the Section 8(2) of the Patents Act 1970 as redundant.

In 2018, the Controller General of Patents, Designs and Trade Marks issued an Office Circular⁴³ directing all Examiners and Controllers to utilize all the facilities in the WIPO CASE⁴⁴ regarding the processing of corresponding patent applications in foreign jurisdictions, including Search and Examination Reports made available in participating Patent Offices. It was also directed that such information already available in the WIPO CASE shall not be asked from the applicant during the examination of the National Phase Application. Thus through an Office Circular, the Controller waived off an important obligation of the applicant and resolved the issue of enforceability of a statutory provision that has become redundant in view of the ease at which the information is available in online databases. For this exact same reason stated in this circular, the requirement of separate submission of proof of right by PCT applicants in India as per the format provided in the Patent Office Manual 2019 can also be waived off without amending or revising the general Section 7(2) of the Patents Act, by way of a similar Office Circular of the Controller General.

Conclusion

This paper elucidates the dynamic interplay between international treaties and domestic law in the context of patent law. Textual interpretation of legislations, rules, and guidelines by turning a blind eye to the broader picture of India's treaty obligations undermines the very purpose behind the adoption of the Treaty or Convention. The paper provides an overview of the procedures of patent filing, examination, search, and grant under the Patent Cooperation Treaty and walks the reader through the

requirements of the National Phase Application under PCT. Discussed in particular are the interpretation of PCT Rule 4.17 read with Rule 51bis.1(a)(ii), Rule 51bis.2(ii), and Section 7(2) of the Patents Act, 1970 along with the implications of Rule 03.01 of the Patent Office Manual 2019. The Manual issued by the Indian Patent Office requires the ‘Proof of Right’ provided under Section 7(2) of the Patents Act 1970 to be filed mandatorily either by way of Form 1 or an Assignment Deed. The Indian Patent Office, through a narrow construction of the global concept of Proof of Right envisaged under PCT which is further incorporated in the same spirit in the domestic legislation, has overstepped the dictates of an Act passed by the Parliament of India. Consequently, in practice, India might appear to be in non-compliance with its obligations under PCT.

For the smooth functioning of an efficient legal system, a combined effort of the Executive, Legislature and Judiciary are essential. Thus the role of the judiciary is indispensable. So far the Intellectual Property Appellate Board seem to fail as a quasi-judicial body in laying down the right course of action for the Indian Patent Office, by not addressing the pressing issue of what constitutes Proof of Right for ‘International applications’⁴⁵ and ‘Convention applications’ under the Patents Act 1970. While adjudicating the *NTT DoCoMo* case, had the IPAB gone an extra mile in filling the legislative vacuum surrounding the constituents of Proof of Right, for national phase applications under PCT, by directing the Patent Office to strictly abide by the respective provisions of PCT Regulations, many ambiguities could have been brought to an end. With the support of general principles of law, basic rules of Interpretation of Statutes and the recent clarifications in the PCT Applicant’s Guide-National Phase, this paper identifies and comprehends the accurate legal position concerning the submission of proof of right for Indian National Phase Applications under PCT Rule 4.17.

Following the submission of this Paper, IPAB has delivered an order in *Dow Agrosciences LLC v The Controller of Patents*⁴⁶ adjudicating upon the same issue discussed in this Paper. The decision of the IPAB concurs with the analysis and findings of the authors.

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