

the three places  
omitted;  
word "revived"

to be denoted by an  
"British", where-

to be denoted by an  
"British", where-

in the said Act,—  
in figure "para-  
" paragraph 4 "

in figure "para-  
where they occur,  
" paragraph 5 " shall be-

" company " the  
substituted;

" in both places  
" the insurer "

# ACT No. XII OF 1939.

[PASSED BY THE INDIAN LEGISLATURE.]

(Received the assent of the Governor General on the 28th  
March, 1939.)

An Act further to amend the law relating to the  
protection of Inventions and Designs.

WHEREAS it is expedient further to amend the  
law relating to the protection of Inventions  
and Designs; It is hereby enacted as follows:—

1. This Act may be called the Indian Patents and Short title.  
Designs (Amendment) Act, 1939.

2. For clause (7) of section 2 of the Indian Patents Amendment  
of section 2,  
Act II of  
1911.  
and Designs Act, 1911 (hereinafter referred to as the  
said Act), the following clause shall be substituted,  
namely:—

(7) "High Court" means a High Court as  
defined in sub-section (1) of section 219 of  
the Government of India Act, 1935.'

26 Geo. v, ch.  
2.

3. In section 5 of the said Act,—

(a) in sub-section (1),—

(i) for the words "examine every application, and  
if he considers" the words "refer every  
application to an Examiner and if satisfied  
on the report of the Examiner" shall be  
substituted;

(ia) in clause (c), after the words "the title"  
the words "of the specification" shall be  
inserted;

(ii) in clause (e), after the words "not a" the  
words "manner of" shall be inserted;

(iii) for clause (f) the following clauses shall be  
substituted, namely:—

"(f) the specification relates to more than one  
invention, or

(g) in  
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Amendment  
of section 5.  
Act II of  
1911.

(g) in the case of an application claiming priority under section 78A, the specification describes and claims an invention substantially larger than or substantially different from the invention disclosed in the specification filed with the application made outside British India by virtue of which priority is claimed, or

(h) in the case of an application for a patent of addition under section 15A, the invention described and claimed in the specification is not an improvement or modification of that described and claimed in the original specification,";

(b) after sub-section (1) the following sub-section shall be inserted, namely:—

"(1A) If the Controller considers, at any time before the acceptance of an application, that the invention claimed therein has been wholly or in part claimed in a specification published on or after the date which the patent applied for would bear if granted, appertaining to an application for a patent which if granted will be of prior date to the patent applied for, he may require that the applicant's specification be amended by the insertion of a reference to such other specification, by way of notice to the public.";

(c) in sub-section (2), after the word "amendment" the words "or the insertion of a reference" shall be inserted; and

(d) in sub-section (4),—

(i) for the words "become void" the words "be deemed to have been refused" shall be substituted;

(ii) in the proviso the words "by any period not exceeding three months" shall be omitted; and for the words "or revived, as the case may be, during, but not beyond the period of extension so requested" the words "for any period so requested not exceeding in

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application claiming on 78A, the specification claims an invention than or substantially invention disclosed filed with the application British India by ity is claimed, or lication for a patent section 15A, the and claimed in the ot an improvement that described and inal specification,"; following sub-section y :—

iders, at any time an application, that therein has been ed in a specification the date which the ld bear if granted, ication for a patent of prior date to the ay require that the be amended by ence to such other notice to the pub-

word " amendment " on of a reference "

void " the words n refused " shall be

s " by any period onths " shall be rds " or revived, as but not beyond the uested " the words sted not exceeding in

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in all three months from the expiration of the said period of twelve months " shall be substituted.

4. In clause (b) of the proviso to sub-section (2) of section 10 of the said Act, after the word " patent ", where it occurs for the first time, the words " or by any proceedings taken for obtaining a direction of the Controller under the provisions of sub-section (1A) " shall be inserted.

Amendment of section 10, Act II of 1911.

5. In section 14 of the said Act,—

Amendment of section 14, Act II of 1911.

(a) in sub-section (1B), for the words " may determine " the words " may, on application made in this behalf, determine " shall be substituted :

(b) in the proviso to sub-section (2),—

(i) the words " by any period not exceeding three months " shall be omitted ; and

(ii) for the words " during, but not beyond, the period of extension applied for " the words " for any period so applied for not exceeding in all three months from the expiration of the time for payment " shall be substituted.

6. In section 15 of the said Act, for sub-sections (5) and (6) the following sub-sections shall be substituted, namely :—

Amendment of section 15, Act II of 1911.

(5) The Central Government or the High Court to which a petition is referred shall in considering the petition have regard to the nature and merits of the invention in relation to the public, to the profits made on the patent and to all the circumstances of the case.

(6) If it appears to the Central Government or to the High Court when the petition is referred to it, that the patent has not been sufficiently remunerative, the Central Government or the High Court, as the case may be, may by order extend the term of the patent for a further term not exceeding five or in exceptional cases ten years or may order the grant of a new patent for such term not exceeding ten years as may be specified in the order and subject to any restriction, conditions and provisions which

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the Central Government or the High Court, as the case may be, may think fit.”

Amendment  
of section 26,  
Act II of  
1911.

7. For sub-section (I) of section 26 of the said Act the following sub-section shall be substituted namely :—

“(I) Revocation of a patent in whole or in part may be obtained on petition to or on a counter claim in a suit for infringement before a High Court on all or any of the following grounds, namely :—

- (a) that the invention has been the subject of a valid prior grant of a patent in British India;
- (b) that the true and first inventor or his legal representative or assign was not the applicant or one of the applicants for the patent ;
- (c) that the patent was obtained in fraud of the rights of the person applying for the revocation or of any person under or through whom he claims ;
- (d) that the invention was not, at the date of the patent, a manner of new manufacture or improvement ;
- (e) that the invention does not involve any inventive step, having regard to what was known or used prior to the date of the patent ;
- (f) that the invention is of no utility ;
- (g) that the specification does not sufficiently and fairly describe and ascertain the nature of the invention and the manner in which the invention is to be performed ;
- (h) that the specification does not sufficiently and clearly ascertain the scope of the invention claimed ;
- (i) that the patent was obtained on a false suggestion or representation ;
- (j) that the primary or intended use or exercise of the invention is contrary to law ;
- (k) that the patentee has contravened, or has not complied with, the conditions contained in the patent ;

(l) that

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or the High Court,  
think fit."

of the said Act  
be substituted

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(l) that the specification does not disclose the best method of performance of the invention known to the applicant for the patent at the time when the specification was left at the Patent Office ;

(m) that prior to the date of the patent, the patentee or other persons (not being authorities administering any department of the service of His Majesty, or the agents or contractors of, or any other persons authorised in that behalf by, the Central Government) secretly worked the invention on a commercial scale (and not merely by way of reasonable trial or experiment) in British India, and thereby made direct or indirect profits in excess of such amount as the Court may in consideration of all the circumstances of the case deem reasonable :

Provided that this sub-section shall have effect in relation to the ground of revocation specified—

(i) in clause (b), subject to the provisions of section 78A, or

(ii) in clause (d), subject to the provisions of sub-section (1) of section 13, sub-section (2) of section 21, section 38 and section 40."

8. (a) To sub-section (1) of section 29 of the said Act, the following proviso shall be added, namely:— Amendment of section 29, Act II of 1911.

" Provided that where a counter claim for revocation of the patent is made by the defendant, the suit, along with the counter claim, shall be transferred to the High Court for decision".

(b) In sub-section (2) of section 29 of the said Act for the words "this Act" the word and figure " section 26 " shall be substituted.

9. For section 38 of the said Act the following section shall be substituted, namely:—

" 38. The public use or knowledge of an invention in British India before the date of the application for a patent thereon shall not invalidate the patent granted thereon if the knowledge has been obtained surreptitiously

Substitution of new section for section 38, Act II of 1911.

Public use or knowledge of invention.

or

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or in fraud of the true and first inventor or his legal representative or assign or has been communicated to the public in fraud of such inventor or his legal representative or assign or in breach of confidence :

Provided that such inventor or his legal representative or assign has not acquiesced in the public use of his invention, and that he applies for a patent within six months after the commencement of such use. ”

10. For section 40 of the said Act the following section shall be substituted, namely :—

Substitution of new section for section 40, Act II of 1911.  
Provisions as to exhibitions and readings before learned societies.

“ 40. The exhibition of an invention at an industrial or other exhibition to which the provisions of this section have been extended by the Central Government by notification in the official Gazette, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention or the publication of any description thereof, during or after the period of the holding of the exhibition, by any person elsewhere without the privity or consent of the inventor or the reading of a paper by an inventor before a learned society, or the publication of that paper in the society's transactions shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention, or the validity of any patent granted on the application :

Provided that—

- (a) the exhibitor exhibiting the invention or the inventor reading the paper or authorising the publication thereof, as the case may be, gives to the Controller previous notice in the prescribed form ; and
- (b) the application for a patent is made before or within six months from the date of first exhibiting the invention or of the reading of the

the paper, as the case may be, or when it has not been so read, of the said publication."

11. In sub-sections (2) and (3) of section 47 of the said Act, the words "within the prescribed time" shall be omitted. Amendment of section 47, Act II of 1911.

12. For section 52 of the said Act the following section shall be substituted, namely:— Substitution of new section for section 52, Act II of 1911.

"52. The exhibition of a design, or of any article to which a design is applied, at an industrial or other exhibition to which the provisions of this section have been extended by the Central Government by notification in the official Gazette, or the publication of a description of the design, during the period of the holding of the exhibition, or the exhibition of the design or the article or the publication of a description of the design by any person elsewhere during or after the period of the holding of the exhibition, without the privity or consent of the proprietor, shall not prevent the design from being registered or invalidate the registration thereof: Provisions as to exhibitions.

Provided that—

- (a) the exhibitor exhibiting the design or article, or publishing a description of the design, gives to the Controller previous notice in the prescribed form; and
- (b) the application for registration is made within six months from the date of first exhibiting the design or article or publishing a description of the design."

13. In sub-section (1) of section 53 of the said Act,— Amendment of section 53, Act II of 1911.  
(a) after clause (a) the following clause shall be inserted, namely:—

"(aa) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or";

(b) in

(b) in sub-clause (b), after the words "applied to any article" the words "in any class of goods in which the design is registered" shall be inserted.

Insertion of new section 59A in Act II of 1911.

14. After section 59 of the said Act the following section shall be inserted, namely:—

Information relating to patents.

"59A. A person making a request to the Controller in the prescribed manner as respects any patent specified in the request or as respects any application for a patent so specified, for information to be furnished to him by the Controller of any such matters as may be prescribed affecting that patent or application, shall be entitled, subject to the payment of the prescribed fee, to have information supplied to him accordingly."

Amendment of section 65, Act II of 1911.

15. In section 65 of the said Act, the word "and", in the first three places where it occurs, shall be omitted, and for the words "compelling the production of documents and awarding costs" the words "compelling the discovery and production of documents, issuing commissions for the examining of witnesses and awarding costs and such award shall be executable in any court having jurisdiction as if it were a decree of that court" shall be substituted.

Insertion of new section 70A in Act II of 1911.

16. After the heading "*Evidence, etc.*" and before section 71 of the said Act, the following section shall be inserted, namely:—

Evidence before the Controller.

"70A. Subject to any rules made under section 77, in any proceeding under this Act before the Controller, the evidence shall be given by affidavit, in the absence of directions by the Controller to the contrary; but in any case in which the Controller thinks it right so to do he may take evidence *viva voce* in lieu of or in addition to evidence by affidavit or may allow any party to be cross-examined on the contents of his affidavit."

Insertion of new section 71A in Act II of 1911.

17. After section 71 of the said Act the following section shall be inserted, namely:—

Evidence of documents in Patent Office.

"71A. Printed or written copies or extracts, purporting to be certified by the Controller and sealed



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e words " applied to  
" in any class of  
sign is registered "

Act the following  
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sealed with the seal of the Patent Office, of or  
from patents, specifications and other docu-  
ments in the Patent Office, and of or from  
registers and other books kept there, shall be  
admitted in evidence in all Courts in British  
India, and in all proceedings, without further  
proof or production of the originals:

Provided that a Court may, if it has reason to  
doubt the accuracy or authenticity of the copies  
tendered in evidence, require the production  
of the originals or such further proof as it  
considers necessary."

18. For section 72 of the said Act the following sec-  
tion shall be substituted, namely:—

Substitution of  
new section for  
section 72, Act  
II of 1911.

" 72. Copies of all such specifications, drawings  
and amendments left at the Patent Office,  
as become open to public inspection under the  
provisions of this Act, shall be transmitted,  
as soon as may be, after the printed copies  
thereof are available, to such authorities as  
the Central Government may appoint in this  
behalf, and shall be open to the inspection of  
any person at all reasonable times at places  
to be appointed by those authorities and  
approved by the Central Government."

Transmission  
of copies of  
specifications  
etc., and inspec-  
tion thereof.

19. In sub-section (1) of section 78A of the said  
Act,—

Amendment  
of section  
78A, Act II  
of 1911.

(a) for the words and figures " apply such of the  
provisions of section 91 of the Patents and  
Designs Act, 1907, as relate to inventions or  
designs, to British India," the words, letter  
and figures " declare British India to be a  
convention country within the meaning of sec-  
tion 91A of the Patents and Designs Act,  
1907," shall be substituted;

(b) for the words " shall be entitled to a patent for  
his invention or to registration of his design  
under this Act, in priority to other applicants;  
and the patent or registration shall have"  
the words " shall, either alone or jointly with  
any other person, be entitled to claim that the

patent

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patent that may be granted to him under this Act, for the said invention or the registration of the said design under this Act, shall be in priority to other applicants and shall have " shall be substituted.

Amendment  
of Schedule,  
Act II of  
1911.

20. In the Schedule to the said Act, for the words " Before the expiration of ", where they occur in the penultimate entry, the words " In respect of " shall be substituted.

Amendment  
of section 18,  
Act VIII of  
1878.

21. In section 18 of the Indian Sea Customs Act, 1878, after clause (f) the following clause shall be inserted, namely :—

" (ff) goods made or produced beyond the limits of British India and intended for sale, and having applied thereto, a design in which copyright exists under the Indian Patents and Designs Act, 1911, in respect of the class to which the goods belong or any fraudulent or obvious imitation of such design except when the application of such design has been made with the license or written consent of the registered proprietor of the design ;".