Getting the Deal Through: Patents

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Archana Shankar and Gitika Suri take an in-depth look at the protection of inventions and the options available with right owners for protecting their inventions. The discussion covers also the legal and procedural framework supporting the patent regime in India. Excerpts taken from the chapter published in Getting the Deal Through: Patents 2017.

Who can sue

An action for infringement of a patent may be instituted by the patentee him or herself. If the patent is licensing exclusively, the rights of the exclusive licensee to sue for infringement are equivalent to that of the patentee. The exclusive licensee must make the patentee a party to the proceedings either as a plaintiff or defendant. The Patents Act 1970 further provides scope to a licensee who has been granted a compulsory license to put the patentee on notice of the infringement and call upon him or her to take proceedings to prevent infringement. If the patentee neglects to do so within two months of being called upon to do so, such a licensee may institute proceedings as though he or she were the patent holder, making the patent holder a defendant in the proceeding.

Alternative dispute resolution

Alternative dispute resolution mechanisms have become an integral part of resolving disputes. The Delhi High Court, in particular, has an effective mediation and conciliation centre through which mediation mechanisms are explored. The court quite frequently refers matters for resolution through mediation, even though very few patent matters have been so referred. Courts also take into consideration arbitration agreements. However, arbitration is not available to assess invalidity, as the Patent Office does not recognise arbitral awards in this respect.

Who owns the patent

A company employee or an independent contractor's right to apply for an own a patent is governed by the terms of the agreement between employee and employer or contractor and contracting party. A patent may be owned by an individual, a group of individuals or a legal entity (eg, a company). A firm may also apply for a patent as an assignee (Shining Industries v Shri Krishna Industries, AIR 1975 ALL 231). A patent may be jointly filed and owned by two or more parties. An application may be filed by the inventor or assignee, or a legal representative of deceased persons who were entitled to make such an application, immediately before their death. A patent applicant may be a legal entity and need to necessarily be a natural person.

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