

STATEMENT AS TO WORKING OF PATENTS

Recently the Controller General of Patents issued a public notice requiring all Patentees/ licensees to file statement as to working of their Patents in India latest by March 31, 2010. As per Rule 131 of the Patents Rules, as amended up to date, voluntarily the statement should be filed in respect of each calendar year within 3 months from the end of each calendar year. For example for a granted patent in India, for year 2009 the statement should be filed by March 31, 2010.

Also as per provisions of Section 146 of the Indian Patents Act, if such information has been demanded by the Controller the statement has to be filed within 2 months (or such further time as may be allowed by Controller) but there shall be intervals of at least 6 months between the two statements (Controller cannot demand information within 6 months of submission of last information). But presently the notice issued by the Controller is a public notice therefore instead of 2 months time he has requested compliance to provisions of Rule 131 of the Patent Rules.

This information may turn out to be relevant if someone later files a request for compulsory license in India and there this information can be used by the applicant. Till date no such publication of statement as to working of Patent in India is published as it is the discretion of the Controller whether he desires to publish such information or not.

No official fee is payable while submitting the information and the information has to be supplied only after the Patent has been granted and till the patent is in force in India. It is preretirement to mention herein that in case the information supplied is not supplied within time or refused, a penalty of up to Rs. 10 Lakhs (One million Indina Rupees or approx US \$ 25000) may be imposed and in case the information supplied is found to be false (intent necessary, especially malafide intent) there is also provision of imprisonment of up to 6 months or fine or both on the person deliberately providing the false/incorrect information.

In case, where the patented invention has not been used in India, a statement to that effect has to be filed and reasons for not working and steps taken for working of the invention has to be provided with. Where the patented invention has been worked in

India, the quantum and value of the patented product manufactured/used, place of manufacture (whether in India or imported) has to be provided. Further, in respect of the year to which the statement pertains the details of licence and sub-licence granted have to be provided. Also a statement has to be provided as whether the requirement of the public has been met adequately/ partly/ to the fullest extent.

Please note that statement has to be preferably supplied by the Applicant or its officials, therefore it is in your interest to execute the Form 27 and arrange filing of same in the Indian Patent office before March 31, 2010. But where same could not be so provided you may provide same to your Attorney in India on a letter head and he may submit same on your behalf.