

FINAL REPORT
ON
THE PATENTS AND DESIGNS ACT, 200-----

INTRODUCTION

PATENTS

In England grants of monopoly rights to exploit an invention by the inventor date back to the Elizabethan (Queen Elizabeth I) period. It was the right of the sovereign to make such grants by issuing Letters Patent. The introduction of any new manufacture was rewarded by grant of a monopoly right over the manufacture to the inventor for a certain period of time. This device was adopted for encouraging introduction of new arts and thereby to promote welfare of the state as a whole. Certain abuses of the general power of granting monopolies emerged in England and in order to check these abuses and limit monopolies already granted and to define in what circumstances monopolies may be granted by the sovereign, the Statute of Monopolies was passed in 1623. This Statute was the basis on which all subsequent laws in England and her colonies including the Indian Sub-continent were passed.

In England, the patent office was established in 1853. Subsequent legislations on patent are the Patents, Designs and Trade Marks Act, 1883, Patents and Designs Act, 1907, Patents Act, 1949, Patents Act, 1977 and Copyright, Designs and Patents Act, 1988.

In the Indian Sub-continent, the Patents and Designs Act was enacted in 1911 mainly on the basis of the principles laid down in the Statute of Monopolies, Patents, Design and Trade Marks Act, 1883 and Patents and Designs Act, 1907. The Patents and Designs Act, 1911, is the law in force in Bangladesh on patents and designs.

The laws relating to patents and designs have, therefore, been consolidated in a single enactment in Bangladesh, namely, the Patents and Designs Act, 1911. The same establishment, namely, the patent office set up under section 55 of the Act and the Controller of Patents and Designs and his staff appointed under the same section of the Act by the Government administer all matters relating to both patents and designs. The Act is divided into three parts. In part I laws relating to patents, in part II laws relating to designs and in part III general provisions have been included. In some countries, two separate acts prevail for patents and designs respectively. In India, a separate Patents Act was enacted in 1970 and the provisions relating to designs continue to be governed by the provisions of the Patents and Designs Act, 1911, and

for this purpose suitable amendments by way of omission, addition, substitution etc. were made in the Patents and Designs Act, 1911, by the Patents Act, 1970 (Act 39 of 1970). In Bangladesh, we have been implementing the provisions relating to both patents and designs under a single enactment and through a single establishment since 1911. In Bangladesh, inventions are not many and as such, a single establishment can conveniently deal with both patents and designs. The World Intellectual Property Organization (WIPO) also recommends that the patent office may also look after matters relating to designs (see WIPO General Information, page 15). In that case, it will be convenient to keep the provisions relating to both patents and designs in one enactment as in the present Act. If the provisions relating to patents and the provisions relating to designs are made in a single enactment, the administering authority who will, as we have proposed above, enforce the provisions relating to both patents and designs, will feel convenient if he finds the provisions relating to both the matters in a single Act rather than in separate Acts.

Since enactment of the Patents and Designs Act, 1911, the concepts of patents and designs have undergone enormous development through decisions of courts around the world. In addition, a large number of international conventions have been adopted recommending enactment of uniform laws on intellectual property including patents and designs. Some of these conventions are: International Convention for the Protection of Industrial Property, Convention on the grant of European Patents (adopted in Munich, 5 October, 1973), Convention for the European Patent for the Common Market (adopted in Luxembourg, 15 December, 1975), Patent Co-operation Treaty (adopted in Washington, 19 June, 1970), Paris Convention for the Protection of Industrial Property, 1967, known as the Paris Convention, and the Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994, known as the TRIPS Agreement. The present Act is required to be updated in order to give effect in this country to certain international treaties on patents and designs, particularly to those to which Bangladesh is a State-Party. As such, we propose to substitute the present Act by proposing a new enactment instead of suggesting amendments to the present Act.

In the proposed enactment, we propose to address the following issues in relation to patents:-

(1) Interpretation of various terms, (2) Requirements for claiming patents - Invention, Improvement, Novelty; (3) Grant of Patent, Right of Patentee, Old Patents, New Patents; Application, Prior Publication, Prior User; (4) Assignment of Patent and Licence; (5) Compulsory Licence, Licence of Right; (6) Revocation of Patents; (7) Specification, Rectification, etc., (8) Infringement and Miscellaneous.

DESIGNS

Ever since the production of useful articles, design or rather industrial design as a form of human endeavour and as a part of industrial manufacture engaged the attention of human society. From the dawn of civilization through the middle ages until the recent times man has been taking care to provide ornamentation to his products. The manufacturer of an article – who himself was its designer in early times – always took care to see that his product was, in addition to being efficient, attractive to the eyes of the consumer. The elements which make the product attractive to the eyes are called design. The design of an article also makes it attractive in the market. As such, good design is encouraged and if good design is to be encouraged, the maker of design ought to be protected from those who would take advantage of the fruit of his labour. As such, the necessity for a law for protecting the interests of the makers of new and original designs in the same way as protecting the interests of new and useful inventions.

In the proposed Act, we propose to follow the same guide-lines as stated above in respect of law relating to patents. In case of designs we will address ourselves to the following aspects:- (1) Definition; (2) Registration of designs; (3) Cancellation of registration; (4) Infringement of registration and (5) Miscellaneous.

The proposed Act may be divided into two parts, part I containing the law relating to patents, part II containing the law relating to designs and part III relating to general matters. Each part may contain several chapters containing the sections.

The first chapter may be devoted to preliminary matters such as, the “short title, extent and commencement” and “definition and interpretation” of various terms used in the Act.

The short title, extent commencement extend and applicability of the Act may run as follows:-

CHAPTER I

PRELIMINARY

“1. **Short title, extent and commencement.-**

(1) This Act may be called the Patents and Designs Act, 2001.

(2) It extends to the whole of Bangladesh.

(3) It shall come into force on such date as the government may, by notification in the official gazette, appoint.”

“2. In this Act, unless the context otherwise requires.-

(1) “Attorney General” means the Attorney General for Bangladesh.

(2) “assignee” includes the legal representative of a deceased assignee, and references to the assignee of any person include references to the assignee of the legal representative or assignee of the person;

(3) “article” means (as respects designs) any article of manufacture and any substance, artificial or natural or partly artificial and partly natural;

(4) “Controller” means the Controller of Patents and Designs appointed under this Act;

(5) “convention application” means an application for a patent by virtue of section 146 of this Act;

(6) “convention country” means a country which is a member of World Trade Organisation;

(7) “copyright” means the exclusive right to apply a design to any article in any class in which the design is registered;

(8) “design” means only the features of shape, configuration, pattern or ornament applied to any article by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in section 478, or property mark as defined in section 479 of the Penal Code, 1860;

(9) “District Court” has the meaning assigned to that expression by the Code of Civil Procedure, 1908;

(10) “environment” includes water, air and land and the interrelationship which exists among and between water, air and land and human beings, other living creatures, plants, microorganism and property;

(11) “environmental pollutant” means any solid, liquid or gaseous substance present in such concentration as may be, or tend to be, injurious to environment;

(12) “environmental pollution” means the presence in the environment of any environmental pollutant;

(13) “exclusive licence” means a licence from a patentee which confers on the licensee and persons authorised by him, to the exclusion of all other persons (including the patentee), any right in respect of the patented invention, and ‘exclusive licensee’ shall be construed accordingly;

(14) “food” means any article of nourishment and includes any substance intended for the use of babies, invalids or convalescents as an article of food or drink;

(15) “government undertaking” means any industrial undertaking carried on-

- (a) by a department of the Government, or
- (b) by a corporation established by the Government and is owned or controlled by the Government, and includes the Bangladesh Council of Scientific and Industrial Research and any other institution which is financed wholly or for the major part by the said Council.

(16) “invention” means any new, sufficiently inventive and useful-

- (a) art, process, method or manner of manufacture,
- (b) machine, apparatus or other article,
- (c) substance produced by manufacture.

and includes any new, sufficiently inventive and useful improvement of any of them, and an alleged invention.

(17) “legal representative” means a person who in law represents the estate of a deceased person;

(18) “manufacture” includes any art, process or manner of producing, preparing or making, a plant, machine, apparatus or any other article and an article prepared or produced by manufacture;

(19) “medicines or drug” includes-

- (a) all medicines for internal or external use of human beings or animals,
- (b) all substances intended to be used for or in the diagnosis, treatment, mitigation or prevention of diseases in human beings or animals,
- (c) all substances intended to be used for or in the maintenance of public health, or the prevention or control of any epidemic disease among human beings or animals,
- (d) insecticides, germicides, fungicides, weedicides and all other substances intended to be used for the protection or preservation of plants,

- (e) all chemical substances which are ordinarily used as intermediates in the preparation or manufacture of any of the medicines or substances above referred to;

(20) “patents” means a patent granted under this Act and includes for the purposes of sections 52, 57, 58, 59, 60, 62, 63, 64, 65, 66, 70, 72, 73, 75, 76, 77, 85, 111, 146, 158, 159 and 160 and Chapters XVIII, XIX and XXII of this Act, a patent granted under the Patents and Designs Act, 1911.

(21) “patent agent” means a person for the time being registered under this Act as a patent agent;

(22) “patented article” means an article in respect of which a patent is in force;

(23) “patented invention” means an invention for which a patent is granted;

(24) “patented process” means a process in respect of which a patent is in force;

(25) “patented product” means a product which is a patented invention or, in relation to a patented process, a product obtained directly by means of the process or to which the process has been applied;

(26) “patentee” means the person for the time being entered on the register as the grantor or proprietor of the patent;

(27) “patent of addition” means a patent granted in accordance with section 62 of this Act;

(28) “person” includes the Government;

(29) “person interested” includes a person engaged in, or in promoting research in the same field as that to which the invention relates;

(30) “prescribed” means prescribed by rules made under this Act;

(31) “prescribed manner” includes the payment of the prescribed fee;

(32) “priority date” has the same meaning assigned to it by section 12 of this Act;

(33) “proprietor of a new and original design”-

(a) where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is executed; and

(b) where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means,

in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(c) in any other case, means the author of the design;

and where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person; and

(34) “register” means the register of patent kept under section 74 of this Act.

PART I

CHAPTER II

PATENTABILITY OF INVENTIONS

3. Patentable inventions. (1) A patent may be granted only for an invention which satisfies the following conditions, that is to say-

- (a) the invention is new;
- (b) it involves an inventive step;
- (c) it is capable of industrial application; and
- (d) the grant of a patent for it is not excluded by section 4 of this Act.

(2) An invention may be a product or a process.

4. Exclusion from patentability.- The following are not inventions for the purposes of this Act, that is to say, anything which is -

- (a) an invention which is frivolous on the ground that it claims as an invention anything obviously contrary to well-established natural laws;
- (b) an invention the use of which would be contrary to law or morality;
- (c) an invention the use of which would be injurious to public health or environment;
- (d) an invention which is a substance capable of being used as food or medicine;
- (e) a discovery, scientific theory or mathematical method;
- (f) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;
- (g) a scheme, rule or method for doing business, playing games, performing a mental act or program for a computer;

- (h) an invention the publication or exploitation of which would be generally expected to encourage offensive, immoral or anti-social behaviour;
- (i) any variety of animal or plant or any essentially biological process for the production of animals or plants, not being a micro-biological process or the product of such a process;
- (j) any method for the medicinal, surgical, curative or prophylactic or other treatment of human beings or any method of a similar treatment of animals or plants, and diagnostic methods practised on the human body, animal body or plant: Provided that this clause shall not apply to any products used in any such methods;
- (k) a method of agriculture or horticulture;
- (l) the mere discovery of any new property or new use of a known process, machine, or apparatus unless such known process results in a new product or employs at least one new reactant;
- (m) a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;
- (n) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;
- (o) a method or process of testing applicable during the process of manufacture for rendering the machine, apparatus or other equipment more efficient or for the improvement or restoration of the existing machine, apparatus or other equipment or for the improvement or control of manufacture;
- (p) an invention relating to atomic energy falling under Article 16 of the Bangladesh Atomic Energy Commission Order, 1973 (President's Order No. 15 of 1973).

Provided that claims for the invention of methods or processes of manufacture of substances prepared or produced by chemical processes (including alloys, optical glass, semi-conductors and intermetallic compounds), substances intended for use or capable of being used, as food or as medicine or as drug or any method for the medicinal, surgical, curative or prophylactic or other treatment of plants shall be patentable.

Provided further that an application for patent may be made under section 8 in respect of such substances but it shall remain pending for further action until bar is lifted under TRIPS Agreement.

5. **Novelty.**- (1) An invention shall be taken to be new if it does not form part of prior art.

(2) Prior art in the case of an invention shall be taken to comprise-

- (a) all matter, whether a product, a process, information about either, or anything else, made available to the public anywhere in the world, by written or oral description, by use or in any other way, at any time prior to the filing or, as the case may be, the priority date, of the application for patent claiming the invention;
- (b) the contents of a domestic application for patent having an earlier filing or, as the case may be, priority date than the application for patent referred to in clause (a) of this sub-section, to the extent that such contents are included in the patent granted on the basis of the said domestic application for patent.

(3) For the purposes of clause (a) of sub-section (2) of this section the disclosure of matter constituting an invention shall be disregarded in the case of a patent or an application for a patent if occurring within six months preceding the date of filing the application for the patent and either-

- (a) the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by any person-
 - (i) from the inventor or from any person to whom the matter was made available in confidence by the inventor or who obtained it from the inventor because he or the inventor believed that he was entitled to obtain it; or
 - (ii) from any other person to whom the matter was made available in confidence by any person mentioned in sub-clause (i) of this clause or in this sub-clause or who obtained it from any person so mentioned because he or the person from whom he obtained it believed that he was entitled to obtain it;
- (b) the disclosure was made in breach of confidence by any person who obtained the matter in confidence from the inventor or from any other person to whom it was made available, or who obtained it, from the inventor; or
- (c) the disclosure was due to, or made in consequence of the inventor displaying the invention at an international exhibition and the applicant states, on filing the application, that the invention has been so displayed and also, within the prescribed period, files written evidence in support of the statement complying with any prescribed conditions.

(4) In this section, references to the inventor include references to any proprietor of the invention for the time being.

(5) In the case of an invention consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body, the fact that the substance or composition forms part of the prior art shall not prevent the invention from being taken to be new if the use of the substance or composition in any such method does not form part of the prior art.

6. Inventive step.- An invention shall be taken to involve an inventive step if, having regard to the prior art relevant to the application for patent claiming the invention, it is not obvious to a person skilled in the art.

7. Industrial application.- (1) Subject to sub-section (2) of this section, an invention shall be taken to be of industrial application if it can be made or used in any kind of industry, handicraft, agriculture and fishery.

(2) An invention of a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body shall not be taken to be capable of industrial application.

(3) Sub-section (2) of this section shall not prevent a product consisting of a substance or composition being treated as capable of industrial application merely because it is invented for use in any such method.

CHAPTER III

APPLICATIONS FOR PATENTS

8. Persons entitled to make application.- (1) An application for a patent for an invention may be made by any of the following persons, that is to say:-

- (a) by any person claiming to be the true and first inventor of the invention;
- (b) by any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such application;
- (c) by the legal representative of any deceased person who, immediately before his death, was entitled to make such an application.

(2) An application under sub-section (1) of this section may be made by any of the persons referred to therein whether he is a citizen of Bangladesh or not, either alone or jointly with any other person

9. Form of application.- (1) Every application for a patent shall be for one invention only and shall be made in the prescribed form and filed in the patent office in the prescribed manner.

(2) If the application is made by virtue of an assignment of the right to apply for a patent for the invention, there shall be furnished with the application or within such period as may be prescribed after filing of the application a declaration, signed by the person claiming to be true and first inventor or his legal representative, stating that he assents to the making of the application.

(3) Every application under this section shall state that the applicant is in possession of the invention and shall name the person claiming to be the true and first inventor; and where the person so claiming is not the applicant or one of the applicants, the application shall contain a declaration that the applicant believes the person so named to be the true and first inventor.

10. Provisional and complete specifications.- (1) Every application for a patent (not being a convention application) shall be accompanied by either a provisional specification or a complete specification.

(2) Where an application for a patent (not being a convention application) is accompanied by a provisional specification, a complete specification shall be filed within twelve months from the date of filing of the application and if the complete specification is not so filed the application shall be deemed to be abandoned:

Provided that the complete specification may be filed at any time after twelve months but within fifteen months from the date of filing the application if a request to that effect is made to the Controller and the prescribed fee is paid on or before the date on which the complete specification is filed.

(3) Where two or more applications accompanied by provisional specifications have been filed in the name of the same applicant or applicants in respect of inventions which are cognate or of which one is a modification of another, a single complete specification may, subject to the provisions of this section and section 11 of this Act be filed in pursuance of those applications, or, if more than one complete specification has been filed, may, with the leave of the Controller, be proceeded with in respect of those applications.

(4) Where an application for a patent (not being a convention application) is accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant so requests at any time before the acceptance of the specification, direct that it shall be treated for the purposes of this Act as a provisional application, and proceed with the application accordingly.

(5) Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under sub-section (4) of this section as a provisional specification, the Controller may, if the applicant so requests at any time before the acceptance of the complete specification, cancel the provisional specification and post-date the application to the date filing of the complete specification.

11. Contents of specification.- (1) Every specification, whether provisional or complete, shall describe the invention, and shall begin with a title indicating the subject to which the invention relates.

(2) Subject to any rules made under this Act, drawings may, and shall, if the Controller so requires, be supplied for the purposes of any specification, whether provisional or complete; and any drawings so supplied shall, unless the Controller otherwise directs, be deemed to form part of the specification, and references in this Act to a specification shall be construed accordingly.

(3) If, in any particular case, the Controller considers that an application for a patent should be further supplemented by a model or sample of anything illustrating the invention or alleged to constitute an invention, such model or sample as he may require shall be furnished before the acceptance of the application, but such model or sample shall not be deemed to form part of the application.

(4) Every complete specification-

- (a) shall fully and particularly describe the invention and the method by which it is to be performed;
- (b) shall disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and
- (c) shall end with a claim or claims defining the scope of the invention claimed.

(5) The claim or claims of a complete specification must relate to a single invention, must be clear and succinct, and must be fairly based on the matter disclosed in the specification and must, in the case of an invention such as is referred to in the proviso to clause (r) of section 4 of this Act, relate to a single method or process of manufacture.

(6) A declaration as to the inventorship of the invention shall, in such cases as may be prescribed, be furnished in prescribed form with the complete specification or within such period as may be prescribed after the filing of that specification.

(7) Subject to the foregoing provisions of this section, a complete specification filed after a provisional specification may include claims in respect of developments of, or additions to, the invention which was described in the provisional specification, being developments or additions in respect of which the applicant would be entitled under the provisions of section 8 of this Act to make a separate application for a patent.

(8) Where a complete specification claims a new substance, the claim shall be construed as not extending to that substance when found in nature.

12. Priority dates of claims of a complete specification.- (1) Every claim of a complete specification shall have effect from the date prescribed by this section in relation to that claim and such date shall be known as the priority date.

(2) A claim in a complete specification of a patent shall not be invalidated by reason only of the publication or use of the invention, so far as claimed in that claim, on or after the priority date of such claim, or by the grant of another patent upon a specification claiming the same invention in a claim of the same or later priority date.

(3) Where the complete specification is filed in pursuance of a single application accompanied by a provisional specification or by a specification which is treated as a provisional application by virtue of a direction under sub-section (4) of section 10 of this Act, and the claim is fairly based on the matter disclosed in that specification, the priority date of that claim shall be the date of filing of the application.

(4) Where the complete specification is filed or proceeded with in pursuance of two or more applications accompanied by such specifications as are mentioned in sub-section (3) of this section, and the claim is fairly based on the matter disclosed in one of those specifications, the priority date of that claim shall be the date of the filing of the application accompanied by that specification.

(5) Where the complete specification is filed or proceeded with in pursuance of two or more applications accompanied by such specifications as are mentioned in sub-section (3) of this section, and the claim is fairly based on the matter disclosed partly in one and partly in another of those specifications, the priority date of that claim shall be the date of the filing of the application accompanied by the specification of the later date.

(6) Where the complete specification has been filed in pursuance of a further application made by virtue of sub-section (1) of section 18 of this Act and the claim is fairly based on the matter disclosed in any of the earlier specifications, provisional or complete, as the case may be, the priority date of that claim shall be the date of filing of that specification in which the matter was first disclosed.

(7) Where, under the foregoing provisions of this section, any claim of a complete specification would, but for the provisions of this sub-section, have two or more priority dates, the priority date of that claim shall be the earlier or earliest of those dates.

(8) In any case to which sub-sections (3), (4), (5), (6) and (7) of this section do not apply, the priority date of a claim shall, subject to section 148 of this Act be the date of filing of the complete specification.

(9) The reference to the date of the filing of the application or of the complete specification in this section shall, in cases where there has been a post-dating under section 10 or section 19 of this Act or, as the case may be, an ante-dating under section 18 of this Act, be a reference to the date as so post-dated or ante-dated.

The next section of this chapter may contain provisions regarding foreign applications and run as follows:-

13. Information and undertaking regarding foreign applications.- (1) Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside the territory of Bangladesh in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file along with his application-

- (a) a statement setting out the name of the country where the application is being prosecuted, the serial number and date of filing of the application and such other particulars as may be prescribed; and
- (b) an undertaking that, up to the date of the acceptance of his complete specification filed in Bangladesh, he would keep the Controller informed in writing, from time to time, of the details of the nature referred to in clause (a) of this sub-section, in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside Bangladesh subsequently to the filing of the statement referred to in the aforesaid clause, within the prescribed time.

(2) The Controller may also require the applicant to furnish, as far as may be available to the applicant, details relating to the objections, if any, taken to any such application as is referred to in sub-section (1) of this section on the ground that the invention is lacking in novelty or patentability, the amendments effected in the specification, the claims allowed in respect thereof, and such other particulars as he may require.

CHAPTER-IV

EXAMINATION OF APPLICATIONS

14. Examination of application.- (1) When the complete specification has been filed in respect of an application for a patent, the application and the specification or specifications relating thereto shall be referred by the Controller to an examiner for making a report to him in respect of the following matters, namely:-

(a) whether the application and the specification or specifications relating thereto are in accordance with the requirements of this Act and of any rules made thereunder;

- (a) whether there is any lawful ground of objection to the grant of the patent under this Act. in pursuance of the application;
- (b) the result of investigations made under section 15 of this Act; and
- (c) any other matter which may be prescribed.

(2) The examiner to whom the application and the specification or specifications relating thereto are referred under subsection (1) of this section shall ordinarily make the report to the Controller within a period of eighteen months from the date of such reference.

15. Search for anticipation by previous publication and by prior claim.- (1) The examiner to whom an application for a patent is referred under section 14 of this Act shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification-

- (a) has been anticipated by publication before the date of filing of the applicant's complete specification in any specification filed in pursuance of an application for a patent made in Bangladesh and dated on or after the 1st day of January, 1912;
- (b) is claimed in any claim of any other complete specification published on or after the date of filing of the applicant's complete specification, being a specification filed in pursuance of an application for a patent made in Bangladesh and dated before or claiming the priority date earlier than that date.

(2) The examiner shall, in addition, make such investigation as the Controller may direct for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been anticipated by publication in

Bangladesh or elsewhere outside Bangladesh in any document other than those mentioned in sub section (1) of this section before the date of filing of the applicant's complete specification.

(3) Where a complete specification is amended under the provisions of this Act before it has been accepted, the amended specification shall be examined and investigated in like manner as the original specification.

(4) The examination and investigation required under section 14 of this Act and this section shall not be deemed in any way to warrant the validity of any patent, and no liability shall be incurred by the Government or any officer of the Government by reason of, or in connection with, any such examination or investigation or any report or other proceedings consequent thereon.

16. Consideration of report of examiner by Controller.- Where, in respect of an application for a patent, the report of the examiner received by the Controller is adverse to the applicant or requires any amendment of the application or of the specification to ensure compliance with the provisions of this Act, or of the rules made thereunder, the Controller, before proceeding to dispose of the application in accordance with the provisions hereinafter appearing, shall communicate the gist of the objections to the applicant and shall, if so required by the applicant within the prescribed time, give the applicant an opportunity of being heard.

17. Power of Controller to refuse or require amended applications in certain cases.- (1) Where the Controller is satisfied that the application or any specification filed in pursuance thereof does not comply with the requirements of this Act, or any rules made thereunder, the Controller may either-

- (a) refuse to proceed with the application; or
- (b) require the application or any such specification or drawings to be amended to his satisfaction before he proceeds with the application.

(2) If it appears to the Controller that the invention claimed in the specification is not an invention within the meaning of, or is not patentable under, this Act, he shall refuse the application.

(3) If it appears to the Controller that any invention, in respect of which an application for a patent is made, might be used in any manner contrary to law, he may refuse the application, unless the specification is amended by the insertion of such disclaimer in respect of that use of the invention, or such other reference to the illegality thereof, as the Controller thinks fit.

18. Power of Controller to make orders respecting division of application.- (1) A person who has made an application for a patent under this Act, may, at any time

before the acceptance of the complete specification, if he so desires, or with a view to remedy the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first mentioned application.

(2) The further application under sub section (1) shall be accompanied by a complete specification, but such complete specification shall not include any matter not in substance disclosed in the complete specification filed in pursuance of the first mentioned application.

(3) The Controller may require such amendment of the complete specification filed in pursuance of either the original or the further application as may be necessary to ensure that neither of the said complete specifications includes a claim for any matter claimed in the other.

Explanation.- For the purposes of this Act, the further application and the complete specification accompanying it shall be deemed to have been filed on the date on which the complete specification in pursuance of the first mentioned application had been filed, and the further application shall, subject to the determination of the priority date under sub-section (6) of section 12 of this Act, be proceeded with as a substantive application.

19. Power of Controller to make orders respecting dating of application.- (1) Subject to the provisions of section 10 of this Act, at any time after the filing of an application and before acceptance of the complete specification under this Act, the Controller may, at the request of the applicant made in the prescribed manner, direct that the application shall be post-dated to such date as may be specified in the request, and proceed with the application accordingly:

Provided that no application shall be post-dated under this sub-section to a date later than six months from the date on which it was actually made or would, but for this sub-section, be deemed to have been made.

(2) Where an application or specification including drawings is required to be amended under clause (b) of sub-section (1) of section 17 of this Act, the application or specification shall, if the Controller so directs, be deemed to have been made on the date on which the requirement is complied with or where the application or specification is returned to the applicant, on the date on which it is re-filed after complying with the requirement.

20. Powers of Controller in cases of anticipation.- (1) Where it appears to the Controller that the invention so far claimed in any claim with the complete specification has been anticipated in the manner referred to in clause (a) of sub-

section (1) or sub-section (2) of section 15 of this Act, he may refuse to accept the complete specification unless the applicant-

- (a) shows to the satisfaction of the Controller that the priority date of the claim of his complete specification is not later than the date on which the relevant document was published; or
- (b) amends his complete specification to the satisfaction of the Controller.

(2) If it appears to the Controller that the invention is claimed in a claim of any other complete specification referred to in clause (b) of sub-section (1) of section 15 of this Act, he may, subject to the provisions hereinafter contained, direct that a reference to that other specification shall be inserted by way of notice to the public in the applicant's complete specification unless within such time as may be prescribed,-

- (a) the applicant shows to the satisfaction of the Controller that the priority date of his claim is not later than the priority date of the claim of the said other specification; or
- (b) the complete specification is amended to the satisfaction of the Controller.

(3) If it appears to the Controller, as a result of an investigation under section 15 or otherwise,-

- (a) that the invention so far as claimed in any claim of the applicant's complete specification has been claimed in any other complete specification referred to in clause (a) of sub-section (1) of section 15 of this Act, and
- (b) that such other complete specification was published on or after the priority date of the applicant's claim,

then, unless it is shown to the satisfaction of the Controller that the priority date of the applicant's claim is not later than the priority date of the claim of the specification, the provisions of sub-section (2) of this section shall apply thereto in the same manner as they apply to a specification published on or after the date of filing of the applicant's complete specification.

(4) Any order of the Controller under sub-section (2) or sub-section (3) of this section directing insertion of a reference to another complete specification shall be of no effect unless and until the other patent is granted.

21. Powers of Controller in case of potential infringement.- (1) If, in consequence of investigations required by the foregoing provisions of this Act, or of proceedings under section 34 of this Act, it appears to the Controller that an invention in respect of which an application for a patent has been made cannot be performed

without substantial risk of infringement of a claim of any other patent, he may direct that a reference to that other patent shall be inserted in the applicant's complete specification by way of notice to the public, unless within such time as may be prescribed-

- (a) the applicant shows to the satisfaction of the Controller that there are reasonable grounds for contesting the validity of the said claim of the other patent; or
- (b) the complete specification is amended to the satisfaction of the Controller.

(2) Where, after a reference to another patent has been inserted in a complete specification in pursuance of a direction under sub-section (1) of this section-

- (a) that other patent is revoked or otherwise ceases to be in force; or
- (b) the specification of that other patent is amended by the deletion of the relevant claim; or
- (c) it is found, in proceedings before the court or the Controller that the relevant claim of that other patent is invalid or is not infringed by any working of the applicant's invention,

the Controller may, on the application of the applicant, delete the reference to that other patent.

22. Powers of Controller to make orders regarding substitution of applicants, etc.- (1) If the Controller is satisfied, on a claim made in the prescribed manner at any time before a patent has been granted, that by virtue of any assignment or agreement in writing made by the applicant or one of the applicants for the patent or by operation of law, the claimant would, if the patent were then granted, be entitled thereto or to the interest of the applicant therein, or to an undivided share of the patent or of that interest, the Controller may, subject to the provisions of this section, direct that the application shall proceed in the name of the claimant or the names of the claimants and the applicant or the other joint applicant or applicants, as the case may require.

(2) No such direction as aforesaid shall be given by virtue of any assignment or agreement made by one of two or more joint applicants for a patent except with the consent of the other joint applicant or applicants.

(3) No such direction as aforesaid shall be given by virtue of any assignment or agreement for the assignment of the benefit of an invention unless-

- (a) the invention is identified therein by reference to the number of the application for the patent; or

- (b) there is produced to the Controller an acknowledgement by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made; or
- (c) the rights of the claimant in respect of the invention have been finally established by the decision of a court; or
- (d) the Controller gives directions for enabling the application to proceed or for regulating the manner in which it should be proceeded with under sub section (5) of this section.

(4) Where one of two or more joint applicants for a patent dies at any time before the patent has been granted, the Controller may, upon a request in that behalf made by the survivor or survivors, and with the consent of the legal representative of the deceased, direct that the application shall proceed in the name of the survivor or survivors alone.

(5) If any dispute arises between the joint applicants for a patent whether or in what manner the application should be proceeded with, the Controller may, upon application made to him in the prescribed manner by any of the parties, and after giving to all parties concerned an opportunity to be heard, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be proceeded with, or for both of those purposes, as the case may require.

23. Time for putting application in order for acceptance.- (1) An application for a patent shall be deemed to have been abandoned unless within fifteen months from the date on which the first statement of objections to the application or complete specification is forwarded by the Controller to the applicant or within such longer period as may be allowed under the following provisions of this section the applicant has complied with all the requirements imposed on him by or under this Act, whether in connection with the complete specification or otherwise in relation to his application.

Explanation.- Where the application or any specification or, in the case of a convention application, any document filed as part of the application has been returned to the applicant by the Controller in the course of the proceedings, the applicant shall not be deemed to have complied with such requirements unless and until he has re-filed it.

(2) The period of fifteen months specified in subsection (1) of this section shall, on request made by the applicant in the prescribed manner and before the expiration of the period so specified, be extended for a further period so requested (hereafter in this section referred to as the extended period) so that the total period for

complying with the requirements of the Controller does not exceed eighteen months from the date on which the objections referred to in sub-section (1) of this section are forwarded to the applicant.

(3) If at the expiration of the period of fifteen months specified in sub-section (1) of this section or the extended period.

- (a) an appeal to the High Court Division is pending in respect of the application for the patent for the main invention; or
- (b) in the case of an application for a patent of addition, an appeal to the High Court Division is pending in respect of either that application or the application for the main invention,

the time within which the requirements of the Controller shall be complied with shall, on an application made by the applicant before the expiration of the said period of fifteen months or the extended period, as the case may be, be extended until such date as the High Court Division may determine.

(4) If the time within which the appeal mentioned in sub-section (3) of this section may be instituted has not expired, the Controller may extend the period of fifteen months, or as the case may be, the extended period, until the expiration of such further period as he may determine:

Provided that if an appeal has been filed during the said further period, and the High Court Division has granted any extension of time for complying with the requirements of the Controller, then, the requirements may be complied with within the time granted by the High Court Division.

24. Acceptance of complete specification.- Subject to the provisions of section 23 of this Act, the complete specification filed in pursuance of an application for a patent may be accepted by the Controller at any time after the applicant has complied with the requirements mentioned in sub-section (1) of that section, and, if not so accepted within the period allowed under that section for compliance with those requirements, shall be accepted as soon as may be thereafter:

Provided that the applicant may make an application to the Controller in the prescribed manner requesting him to postpone acceptance until such date not being later than eighteen months from the date on which the objections referred to in sub-section (1) of section 23 of this Act are forwarded to the applicant as may be specified in the application, and, if such application is made, the Controller may postpone acceptance accordingly.

25. Advertisement of acceptance of complete specification.- On the acceptance of a complete specification, the Controller shall give notice thereof to the applicant and shall advertise in the Official Gazette the fact that the specification has been

accepted, and thereupon the application and the specification with the drawings (if any) filed in pursuance thereof shall be open to public inspection.

26. Effect of acceptance of complete specification.- On and from the date of advertisement of the acceptance of a complete specification in the Official Gazette and until the date of sealing of a patent in respect thereof, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of advertisement of acceptance of the complete specification:

Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been sealed.

CHAPTER V

OPPOSITION TO GRANT OF PATENT

27. Opposition to grant of patent.- (1) At any time within four months from the date of advertisement of the acceptance of a complete specification under this Act, or written such further period not exceeding one month in the aggregate as the Controller may allow on application being made to him in the prescribed manner before expiry of the four months aforesaid, any person interested may give notice to the Controller of opposition to the grant of the patent on any of the following grounds, namely:-

- (a) that the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;
- (b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim –
 - (i) in any specification filed in pursuance of an application for a patent in Bangladesh on or after in 1st day of January, 1912; or
 - (ii) in Bangladesh or elsewhere outside Bangladesh, in any other document:

Provided that the ground specified in sub-clause (ii) of this clause shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 31 of this Act.

- (c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in Bangladesh, being a claim of which the priority date is earlier than that of the applicant's claim;

- (d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in Bangladesh before the priority date of that claim.

Explanation.- For the purposes of this clause, an invention relating to a process for which a patent is claimed shall be deemed to have been publicly known or publicly used in Bangladesh before the priority date of the claim if a product made by that process had already been imported into Bangladesh before that date except where such importation has been for the purpose of reasonable trial or experiment only;

- (e) that the invention so far as claimed in any claim of the complete specification is obvious and does not involve any inventive step, having regard to the matter published as mentioned in clause (b) of this sub-section or having regard to what was used in Bangladesh before the priority date of the applicant's claim;
- (f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;
- (g) that the subject of any claim of the complete specification is not patentable under this Act;
- (h) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;
- (i) that the applicant has failed to disclose to the Controller the information required by section 13 of this Act or has furnished information which in any material particular was false to his knowledge;
- (j) that in the case of a convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title;

but on no other ground.

(2) Where any such notice of opposition as is referred to in sub-section (1) of this section is given, the Controller shall within two months after expiry of the period mentioned in sub-section (1) of this section, hear the applicant and the opponent, if desirous of being heard, and decide on the case.

(3) The grant of a patent shall not be refused on the ground stated in clause (c) of sub-section (1) of this section if no patent has been granted in pursuance of the application mentioned in that clause.

(4) For the purposes of any inquiry under clause (d) or clause (e) of sub-section (1) of this section, no account shall be taken of any secret use.

28. Controller may treat application as application of opponent in cases of “obtaining”.- (1) Where, in any opposition proceeding under this Act-

- (a) the Controller finds that the invention, so far as claimed in any claim of the complete specification, was obtained from the opponent in the manner set out in clause (a) of sub-section (1) of section 27 of this Act and refuses the application on that ground, he may, on request by such opponent made in the prescribed manner, direct that the application shall proceed in the name of the opponent as if the application and the specification had been filed by the opponent on the date on which they were actually filed;
- (b) the Controller finds that a part of an invention described in the complete specification was so obtained from the opponent and passes an order requiring that the specification be amended by the exclusion of that part of the invention, the opponent may, subject to the provision of sub-section (2) of this section, file an application in accordance with the provision of this Act accompanied by a complete specification for the grant of a patent for the invention so excluded from the applicant's specification, and the Controller may treat such application and specification as having been filed, for the purposes of this Act relating to the priority dates of claims of the complete specification, on the date on which the corresponding document was or was deemed to have been filed by the earlier applicant, but for all other purposes the application of the opponent shall be proceeded with as an application for a patent under this Act.

(2) Where an opponent has, before the date of the order of the Controller requiring the amendment of a complete specification referred to in clause (b) of sub-section (1) of this section, filed an application for a patent for an invention which includes the whole or a part of the invention held to have been obtained from him and such application is pending, the Controller may treat such application and specification in so far as they relate to the invention held to have been obtained from him, as having been filed, for the purposes of this Act relating to the priority dates of claims of the complete specification, on the date on which the corresponding document was or was deemed to have been filed by the earlier applicant, but for all other purposes the application of the opponent shall be proceeded with as an application for a patent under this Act.

29. Refusal of patent without opposition.- If at any time after the acceptance of the complete specification filed in pursuance of an application for a patent and before

the grant of a patent thereon it comes to the notice of the Controller, otherwise than in consequence of proceedings in opposition to the grant under section 27 of this Act, that the invention, so far as claimed in any claim of the complete specification, has been published before the priority date of the claim-

- (a) in any specification filed in pursuance of an application for a patent made in Bangladesh and dated on or after the 1st day of January, 1912;
- (b) in any other document in Bangladesh or elsewhere outside Bangladesh,

the Controller may refuse to grant the patent unless, within such time as may be prescribed, the complete specification is amended to his satisfaction:

Provided that the Controller shall not refuse to grant the patent on the ground specified in clause (b) of this section if such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 31 of this Act.

30. Mention of inventor as such in patent.- (1) If the Controller is satisfied, upon a request or claim made in accordance with the provisions of this section,-

- (a) that the person in respect of whom or by whom the request or claim is made is the inventor of an invention in respect of which application for a patent has been made, or of a substantial part of that invention; and
- (b) that the application for the patent is a direct consequence of his being the inventor;

the Controller shall, subject to the provisions of this section, cause him to be mentioned as inventor in any patent granted in pursuance of the application, in the complete specification, and in the register of patents:

Provided that the mention of any person as inventor under this section shall not confer or derogate from any rights under the patent.

(2) For the purposes of this section the actual deviser of an invention or a part of an invention shall be deemed to be the inventor, notwithstanding that any other person is for any of the other purposes of this Act treated as the true and first inventor; and no person shall be deemed to be the inventor of an invention or a part of an invention by reason only that it was imported by him into Bangladesh.

(3) A request that any person shall be mentioned as inventor under sub-section (1) of this section may be made in the prescribed manner by the applicant for the patent or (where the person alleged to be the inventor is not the applicant or one of the applicants) by the applicant and that person.

(4) If any person other than a person in respect of whom a request in relation to the application in question has been made under the last foregoing sub-section desires to be mentioned as aforesaid, he may make a claim in the prescribed manner in that behalf.

(5) A request or claim under the foregoing provisions of this section must be made not later than two months after the date of advertisement of the acceptance of the complete specification, or within such further period (not exceeding one month) as the Controller may, on an application made to him in that behalf before the expiration of the said period of two months and subject to payment of the prescribed fee, allow.

(6) No request or claim under the foregoing provisions of this section shall be entertained if it appears to the Controller that the request or claim is based upon facts which, if proved in the case of an opposition under the provisions of clause (a) of sub-section (1) of section 34 of this Act by the person in respect of or by whom the request or claim is made, would have entitled him to relief under that section.

(7) Subject to the provisions of sub-section (6) of this section, where a claim is made under sub-section (4) of this section, the Controller shall give notice of the claim to every applicant for the patent (not being the claimant) and to any other person whom the Controller may consider interested; and before deciding upon any request or claim made under sub-section (3) or sub-section (4) of this section, the Controller shall, if required, hear the person in respect of or by whom the request or claim is made, and, in the case of a claim under sub-section (4) of this section, any person to whom notice of the claim has been given as aforesaid.

(8) Where any person has been mentioned as inventor in pursuance of this section, any other person who alleges that he ought not to have been so mentioned may at any time apply to the Controller for a certificate to that effect, and the Controller may, after hearing, if required, any person whom he may consider to be interested, issue such a certificate, and if he does so, he shall rectify the specification and the register accordingly.

CHAPTER VI

ANTICIPATION

31. Anticipation by previous publication.- (1) An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the invention was published in a specification filed in pursuance of an application for a patent made in Bangladesh before the 1st day of January, 1912

(2) Subject as hereinafter provided, an invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that the

invention was published before the priority date of the relevant claim of the specification, if the patentee or the applicant for the patent proves-

- (a) that the matter published was obtained from him, or (where he is not himself the true and first inventor) from any person from whom he derives title, and was published without his consent or the consent of any such person; and
- (b) where the patentee or the applicant for the patent or any person from whom he derives title learned of the publication before the date of the application for the patent, or, in the case of a convention application, before the date of the application for protection in a convention country, that the application or the application in the convention country, as the case may be, was made as soon as reasonably practicable thereafter:

Provided that this sub-section shall not apply if the invention was before the priority date of the claim commercially worked in Bangladesh, otherwise than for the purpose of reasonable trial, either by the patentee or the applicant for the patent or any person from whom he derives title or by any other person with the consent of the patentee or the applicant for the patent or any person from whom he derives title.

(3) Where a complete specification is filed in pursuance of an application for a patent made by a person being the true and first inventor or deriving title from him, an invention claimed in that specification shall not be deemed to have been anticipated by reason only of any other application for a patent in respect of the same invention made in contravention of the rights of that person, or by reason only that after the date of filing of that other application the invention was used or published, without the consent of that person, by the applicant in respect of that other application, or by any other person in consequence of any disclosure of any invention by that applicant.

32. Anticipation by previous communication to Government.- An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of the communication of the invention to the Government or to any person, authorised by the Government to investigate the invention or its merits, or of anything done, in consequence of such a communication, for the purpose of the investigation.

33. Anticipation by public display, etc.- An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of-

- (a) the display of the invention with the consent of the true and first inventor or a person deriving title from him at an industrial or other exhibition to which the provisions of this section have been extended by the Government by notification in the Official Gazette, or the use

thereof with his consent for the purpose of such an exhibition, in the place where it is held; or

- (b) the publication of any description of the invention in consequence of the display or use of the invention at any such exhibition as aforesaid; or
- (c) the use of the invention after it has been displayed or used at any such exhibition as aforesaid and during the period of the exhibition, by any person without the consent of the true and first inventor or a person deriving title from him; or
- (d) the description of the invention in a paper read by the true and first inventor before a learned society or published with his consent in the transactions of such a society,

if the application for the patent is made by the true and first inventor or a person deriving title from him not later than six months after the opening of the exhibition or the reading or publication of the paper, as the case may be.

34. Anticipation by public working.- An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only that at any time within one year before the priority date of the relevant claim of the specification, the invention was publicly worked in Bangladesh-

- (a) by the patentee or applicant for the patent or any person from whom he derives title; or
- (b) by any other person with the consent of the patentee or applicant for the patent or any person from whom he derives title,

if the working was effected for the purpose of reasonable trial only and if it was reasonably necessary, having regard to the nature of the invention, that the working for that purpose should be effected in public.

35. Anticipation by use and publication after provisional specification.- (1) Where a complete specification is filed or proceeded with in pursuance of an application which was accompanied by a provisional specification or where a complete specification filed with an application is treated by virtue of a direction under sub-section (4) of section 10 of this Act as a provisional specification, then, notwithstanding anything contained in this Act, the Controller shall not refuse to grant the patent and the patent shall not be revoked or invalidated by reason only that any matter described in the provisional specification or in the specification treated as aforesaid as a provisional specification was used in Bangladesh or published in Bangladesh or elsewhere outside Bangladesh at any time after the date of the filing of that specification.

(2) Where a complete specification is filed in pursuance of a convention application, then, notwithstanding anything contained in this Act, the Controller shall not refuse to grant the patent, and the patent shall not be revoked or invalidated, by reason only that any matter disclosed in any application for protection in any convention country upon which the convention application is founded was used in Bangladesh or published in Bangladesh or elsewhere at any time after the date of that application for protection.

36. No anticipation if circumstances are only as described in sections 31, 32, 33 and 34 of this Act.- Notwithstanding anything contained in this Act, the Controller shall not refuse to accept a complete specification for a patent or to grant a patent and a patent shall not be revoked or invalidated by reason only of any circumstances which, by virtue of section 31 or section 32 or section 33 or section 34 of this Act, do not constitute an anticipation of the invention claimed in the specification.

CHAPTER VII

PROVISIONS FOR SECRECY OF CERTAIN INVENTIONS

37. Secrecy directions relating to inventions for defence purposes.- (1) Where, in respect of an application made before or after the commencement of this Act for a patent, it appears to the Controller that the invention is one of a class notified to him by the Government as relevant for defence purposes, or where otherwise the invention appears to him to be so relevant, he may give directions for prohibiting or restricting the publication of information with respect to the invention or the communication of such information to any person or class of persons specified in the directions.

(2) Where the Controller gives any such directions as are referred to in the foregoing sub-section, he shall give notice of the application and of the directions to the Government, and the Government shall, upon receipt of such notice, consider whether the publication of the invention would be prejudicial to the defence of Bangladesh, and if upon such consideration, it appears to it that the publication of the invention would not be prejudicial to the defence of Bangladesh, give notice to the Controller to that effect, who shall thereupon revoke the directions and notify the applicant accordingly.

(3) Without prejudice to the provisions of sub-section (1) of this section, where the Government is of opinion that an invention in respect of which the Controller has not given any directions under sub-section (1) of this section, is relevant for defence purposes, it may at any time before acceptance of the complete specification notify the Controller to that effect, and thereupon the provisions of sub-section (1) of this section shall apply as if the invention were one of the class notified

by the Government, and accordingly the Controller shall give notice to the Government of the directions issued by him.

38. Secrecy directions to be periodically reviewed.- (1) The question whether an invention in respect of which directions have been given under section 37 of this Act, continues to be relevant for defence purposes, shall be re-considered by the Government within nine months from the date of issue of such directions and thereafter at intervals not exceeding twelve months, and if, on such re-consideration it appears to the Government that the publication of the invention would no longer be prejudicial to the defence of Bangladesh, it shall forthwith give notice to the Controller accordingly, and, the Controller shall thereupon revoke the directions previously given by him.

(2) The result of every re-consideration under sub-section (1) of this section shall be communicated to the applicant within such time and in such manner as may be prescribed.

39. Consequences of secrecy directions.- (1) So long as any directions under section 37 of this Act are in force in respect of an application, the Controller shall not pass an order refusing to accept the application.

(2) Notwithstanding anything contained elsewhere in this Act, no appeal shall lie from any order of the Controller passed in respect of such application:

Provided that the application may, subject to the directions of the Controller, proceed up to the stage of the acceptance of the complete specification, but the acceptance shall not be advertised nor the specification published, and no patent shall be granted in pursuance of the application.

(3) Where a complete specification filed in pursuance of an application for a patent for an invention in respect of which directions have been given under section 37 of this Act is accepted during the continuance in force of the directions, then-

- (a) if, during the continuance in force of the directions, any use of the invention is made by, or on behalf of, or to the order of the Government the provisions of sections 101, 102 and 104 of this Act shall apply in relation to that use as if the patent had been granted for the invention; and
- (b) if it appears to the Government that the applicant for the patent has suffered hardship by reason of the continuance in force of the directions, the Government may make to him such payment (if any) by way of solatium as appears to the Government to be reasonable having regard to the novelty and utility of the invention and the purpose for which it is designated and to any other relevant circumstances.

- (c) Where a patent is granted in pursuance of an application in respect of which directions have been given under section 37 of this Act, no renewal fee shall be payable in respect of any period during which those directions were in force.

40. Revocation of secrecy directions and extension of time.- When any direction given under section 37 of this Act is revoked by the Controller, then, notwithstanding any provision of this Act specifying the time within which any step should be taken or any act done in connection with an application for the patent, the Controller may, subject to such conditions, if any, as he thinks fit to impose, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application, whether or not that time has previously expired.

41. Liability for contravention of section 37.- Without prejudice to the provisions contained in Chapter XXIII, if in respect of an application for a patent any person contravenes any direction as to the secrecy given by the Controller under section 44 of this Act, the application for patent under this Act shall be deemed to have been abandoned and the patent granted, if any, shall be liable to be revoked under section 71 of this Act.

42. Finality of orders of Controller and Government.- All orders of the Controller giving directions as to secrecy as well as orders of the Government under this Chapter shall be final and shall not be called in question in any court on any ground whatsoever.

43. Savings respecting disclosure to Government.- Nothing in this Act shall be held to prevent the disclosure by the Controller of information concerning an application for a patent or a specification filed in pursuance thereof to the Government for the purpose of the application or specification being examined for considering whether an order under this Chapter should be made or whether an order so made should be revoked.

CHAPTER VIII

GRANT, SEALING, EFFECT AND TERM OF PATENTS

44. Grant and sealing of patent.- (1) Where a complete specification in pursuance of an application for a patent has been accepted and either-

- (a) the application has not been opposed under section 27 of this Act and the time for filing the opposition has expired; or
- (b) the application has been opposed and the opposition has been finally decided in favour of the applicant; or

- (c) the application has not been refused by the Controller in exercise of any power vested in him under this Act,

the patent shall, on request being made by the applicant in the prescribed form and within the time mentioned in sub-sections (2) and (3) of this section, be granted to the applicant or, in case of a joint application, to the applicants jointly, and the Controller shall cause the patent to be sealed with the seal of the patent office and the date on which the patent is sealed shall be entered in the register.

(2) Subject to the provisions of sub-section (1) of this section and the provisions of this Act with respect to patents of addition, a request under this section for the sealing of a patent shall be made not later than the expiration of a period of six months from the date of the advertisement of the acceptance of the complete specification:

Provided that –

- (a) where at the expiration of the said period of six months any proceeding in relation to the application for the patent is pending before the Controller or the High Court Division, the request may be made within two months after the final determination of such proceeding; and
- (b) where the applicant or one of the applicants where there are more applicants than one, has died before the expiration of the time within which under the provisions of this sub-section the request could otherwise be made, the said request may be made at any time within twelve months after the date of the death or at such later time as the Controller may allow.

(3) The period within which under sub-section (2) of this section a request for sealing of a patent may be made, may, from time to time, be extended by the Controller to such longer period as may be specified in an application made to him in that behalf, if the application is made and the prescribed fee paid within that longer period:

Provided that the first mentioned period shall not be extended under this sub-section for more than three months in the aggregate.

Explanation.- For the purposes of this section, a proceeding shall be deemed to be pending so long as the time for any appeal therein (apart from any future extension of that time) has not expired, and a proceeding shall be deemed to be finally determined when the time for any appeal therein (apart from any such extension) has expired without the appeal being brought.

45. Amendment of patent granted to deceased applicant.- Where, at any time after a patent has been sealed in pursuance of any application under this Act, the

Controller is satisfied that the person to whom the patent was granted had died, or in the case of a body corporate, had ceased to exist, before the patent was sealed, the Controller may amend the patent by substituting for the name of that person the name of the person to whom the patent ought to have been granted, and the patent shall have effect, and shall be deemed always to have had effect, accordingly.

46. Date of patent.- (1) Subject to the other provisions contained in this Act, every patent shall be dated with the date of filing of the complete specification:

Provided that no suit or other proceeding shall be taken or prosecuted in respect of an infringement committed before the date of advertisement of the acceptance of the complete specification.

(2) The date of every patent shall be entered in the register of patents.

47. Form, extent and effect of patent.- (1) Every patent shall be in such form as may be prescribed.

(2) A patent shall be granted for one invention only; but it shall not be competent for any person in an action, suit or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

(3) Every patent shall have effect throughout Bangladesh.

In every country, patents are granted subject to certain conditions in the public interests such as, certain apparatus may be made by the Government or imported by the Government in spite of grant of patent for such apparatus, use of any process by the Government merely for its own use in spite of grant of a patent for the said process, etc. The proposed provision may be as follows:-

48. Grant of patents to be subject to certain conditions.- The grant of a patent under this Act shall be subject to the condition that-

- (a) any machine, apparatus or other article in respect of which the patent is granted or any article made by using a process in respect of which the patent is granted, may be imported or made by or on behalf of the Government for the sole purpose merely of its own use ;
- (b) any process in respect of which the patent is granted may be used by or on behalf of the Government for the sole purpose merely of its own use.
- (c) any machine, apparatus or other article in respect of which the patent is granted or any article made by the use of the process in respect of which the patent is granted, may be made or used, and any process in respect of which the patent is granted may be used, by any person for

the sole purpose merely of experiment or research including the imparting of instruction to pupils; and

- (d) in the case of a patent in respect of any medicine or drug, the medicine or drug may be imported by the Government for the sole purpose merely of its own use or for distribution in any dispensary, hospital or medical institution maintained by or on behalf of the Government or any other dispensary, hospital or other medical institution which the Government may, having regard to the public service that such dispensary, hospital or medical institution renders, specify in this behalf by notification in the Official Gazette.

49. Rights of patentees.- (1) Subject to the other provisions contained in this Act, a patent granted before the commencement of this Act, shall confer on the patentee the exclusive right by himself, his agent or licensees to make, use, exercise, sell or distribute the invention in Bangladesh.

(2) Subject to the other provisions contained in this Act and the conditions specified in section 55 of this Act, a patent granted after the commencement of this Act shall confer upon the patentee-

- (a) where the patent is for an article or substance, the exclusive right by himself, his agents or licensees to make, use, exercise, sell or distribute such article or substance in Bangladesh; and
- (b) where a patent is for a method or process of manufacturing an article or substance, the exclusive right by himself, his agents or licensees to use or exercise the method or process in Bangladesh.

50. Patent rights not infringed when used on foreign vessels etc., temporarily or accidentally in Bangladesh.- (1) Where a vessel or aircraft registered in a foreign country or a land vehicle owned by a person ordinarily resident in such a country comes into Bangladesh (including the territorial waters of Bangladesh) temporarily or accidentally only, the rights conferred by a patent for an invention shall not be deemed to be infringed by the use of the invention-

- (a) in the body of the vessel or in the machinery, tackle, apparatus or other accessories thereof, so far as the invention is used on board the vessel and for its actual needs only; or
- (b) in the construction or working of the aircraft or land vehicle or of the accessories thereof,

as the case may be.

(2) This section shall not be applicable to vessels, aircraft or land vehicles owned by persons ordinarily resident in a foreign country if the laws of such foreign country do not provide corresponding rights with respect to the use of inventions in vessels, aircraft or land vehicles owned by persons ordinarily resident in Bangladesh while in the ports or within the territorial waters of that foreign country or otherwise within the jurisdiction of its courts.

51. Rights of co-owners of patents.- (1) Where a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent.

(2) Subject to the provisions contained in this section and section 59 of this Act, where two or more persons are registered as grantees or proprietors of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to make, use, exercise and sell the patented invention for his own benefit without accounting to the other person or persons.

(3) Subject to the provisions contained in this section and in section 59 of this Act and to any agreement for the time being in force, where two or more persons are registered as grantees or proprietors of a patent, then, a licence under the patent shall not be granted and a share in the patent shall not be assigned by one of such persons except with the consent of the other person or persons.

(4) Where a patented article is sold by one of two or more persons registered as grantees or proprietors of a patent, the purchaser and any person claiming through him shall be entitled to deal with the article in the same manner as if the article had been sold by a sole patentee.

(5) Subject to the provisions contained in this section, the rules of law applicable to the ownership and devolution of movable property generally shall apply in relation to patents; and nothing in sub-section (1) or sub-section (2) of this section shall affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or their rights or obligations as such.

(6) Nothing in this section shall affect the rights of the assignees of a partial interest in a patent created before the commencement of this Act.

52. Power of Controller to give directions to co-owners.- (1) Where two or more persons are registered as grantees or proprietors of a patent, the Controller may, upon application made in the prescribed manner by any of

those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licences under the patent, or the exercise of any right under section 58 of this Act in relation thereto, as he thinks fit.

(2) If any person registered as grantee or proprietor of a patent fails to execute any instrument or to do any other thing required for carrying out of any direction given under this section within fourteen days after being requested in writing so to do by any of the other persons so registered, the Controller may, upon application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default.

(3) Before giving any directions in pursuance of an application under this section, the Controller shall give an opportunity, in the case of an application under sub-section (1) of this section, to the other person or persons registered as grantees or proprietors of the patent, and, in the case of an application under sub-section (2) of this section, to the person in default.

(4) No directions shall be given under this section so as to affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or of their rights or obligations as such, or which is inconsistent with the terms of any agreement between persons registered as grantees or proprietors of the patent.

53. Grant of patent to true and first inventor where it has been obtained by another in fraud of him.- (1) Where a patent has been revoked on the ground that the patent was obtained wrongfully and in contravention of the rights of the petitioner or any person under or through whom he claims, or where in a petition for revocation, the court, instead of revoking the patent, directs the complete specification to be amended by the exclusion of a claim or claims in consequence of a finding that the invention covered by such claim or claims had been obtained from the petitioner, the court may, by order passed in the same proceeding, permit the grant to the petitioner of the whole or such part of the invention which the court finds has been wrongfully obtained by the patentee, in lieu of the patent so revoked or is excluded by amendment.

(2) Where any such order is passed, the Controller shall, on request by the petitioner made in the prescribed manner, grant to him-

- (i) in cases where the court permits the whole of the patent to be granted, a new patent bearing the same date and number as the patent revoked;
- (ii) in cases where the court permits a part only of the patent to be granted, a new patent for such part bearing the same date as the patent revoked and numbered in such manner as may be prescribed:

Provided that the Controller may, as a condition of such grant, require the petitioner to file a new and complete specification to the satisfaction of the Controller describing and claiming that part of the invention for which the patent is to be granted.

(3) No suit shall be filed for infringement of a patent granted under this section committed before the actual date on which such patent was granted.

54. Term of patent.- (1) Subject to the provisions of this Act, the term of every patent granted under this Act shall be twenty years from the date of filing of application for patent in compliance with chapter III of the Act.

(2) Notwithstanding anything in this Act or in the patent, a patent shall cease to have effect on the expiry of the period prescribed for the payment of any renewal fee if it is not paid within that period.

(3) If during the period of six months immediately following the expiry of the prescribed period the renewal fee and any prescribed additional fee are paid, the patent shall notwithstanding sub-section (2) of this section, be treated for the purposes of this Act as is it had never expired, and accordingly-

- (a) anything done under or in relation to it during that further period shall be valid;
- (b) an act which would constitute an infringement of it if it had expired shall constitute an infringement;
- (c) an act which would constitute the use of the patented invention for the purposes mentioned in section 55 of this Act if the patent had not expired shall constitute that use.

(4) Rules shall provide requiring the Controller to notify the registered proprietor of a patent that a renewal fee has not been received from him in the Patent Office before the end of the prescribed period.

CHAPTER IX

PATENTS OF ADDITION

55. Patents of addition.- (1) Subject to the provisions of this section, where an application is made for a patent in respect of any improvement in or modification of an invention (in this Act referred to as “ the main invention) and the applicant also applies or has applied for a patent of that invention or is the patentee in respect thereof, the Controller may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.

(2) Subject to the provisions of this section, where an invention, being an improvement in or modification of another invention, is the subject of an independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention, the Controller may, if the patentee so requests, by order revoke the patent for the improvement or modification and grant to the patentee a patent of addition in respect thereof, bearing the same date as the date of the patent so revoked.

(3) A patent shall not be granted as a patent of addition unless the date of filing of the complete specification was the same as or later than the date of filing of the complete specification in respect of the main invention.

(4) A patent of addition shall not be sealed before the sealing of the patent for the main invention; and if the period within which, but for the provisions of this sub-section, a request for the sealing of a patent of addition could be made under section 51 of this Act expires before the period within which a request for the sealing of the patent for the main invention may be so made, the request for the sealing of the patent of addition may be made at any time within the last mentioned period.

56. Term of patents of addition.- (1) A patent of addition shall be granted for a term equal to that of the patent for the main invention, or so much thereof as is unexpired, and shall remain in force during that term or until the previous cesser of the patent for the main invention and no longer:

Provided that if the patent for the main invention is revoked under this Act, the court, or, as the case may be, the Controller, on request made to him by the patentee in the prescribed manner, may order that the patent of addition shall become an independent patent for the remainder of the term of the patent for the main invention, and thereupon the patent shall continue in force as an independent patent accordingly.

(2) No renewal fees shall be payable in respect of a patent of addition, but, if any such patent becomes an independent patent under sub-section (1) of this section, the same fees shall thereafter be payable, upon the same dates, as if the patent had been originally granted as an independent patent.

57. Validity of patents of addition.- (1) The grant of a patent of addition shall not be refused, and a patent granted as a patent of addition shall not be revoked or invalidated, on the ground only that the invention claimed in the complete specification does not involve any inventive step having regard to any publication or use of-

- (a) the main invention described in the complete specification relating thereto; or
- (b) any improvement in, or modification of, the main invention described in the complete specification of a patent of addition to the patent for the main invention or of an application for such a patent of addition,

and the validity of a patent of addition shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

(2) For the removal of doubts it is hereby declared that in determining the novelty of the invention claimed in the complete specification filed in pursuance of an application for a patent of addition regard shall be had also to the complete specification in which the main invention is described.

CHAPTER X

AMENDMENT OF APPLICATIONS AND SPECIFICATIONS

58. Amendment of application and specification before Controller.- (1) Subject to the provisions of section 60 of this Act, the Controller may, upon application made under this section in the prescribed manner by an applicant for a patent or by a patentee, allow the application for the patent or the complete specification to be amended subject to such conditions, if any, as the Controller thinks fit:

Provided that the Controller shall not pass any order allowing or refusing an application to amend an application for a patent or a specification under this section while any suit before a court for the infringement of the patent or any proceeding before the High Court Division for the revocation of

the patent is pending, whether the suit or proceeding commenced before or after the filing of the application to amend.

(2) Every application for leave to amend an application for a patent or a specification under this section shall state the nature of the proposed amendments, and shall give full particulars of the reasons for which the application is made.

(3) Every application for leave to amend an application for a patent or a specification under this section made after the acceptance of the complete specification and the nature of the proposed amendment shall be advertised in the prescribed manner.

(4) Where an application is advertised under sub-section (3) of this section, any person interested may, within the prescribed period after the advertisement thereof, give notice to the Controller of opposition thereto; and where such a notice is given with the period aforesaid, the Controller shall notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case.

(5) An amendment under this section of a complete specification may be, or include, an amendment of the priority date of a claim.

(6) The provisions of this section shall be without prejudice to the right of an applicant for a patent to amend his specification to comply with the directions of the Controller issued before the acceptance of the complete specification or in the course of proceedings in opposition to the grant of a patent.

59. Amendment of specification before High Court Division.- In any application before the High Court Division for the revocation of a patent, the High Court Division may, subject to the provisions contained in section 60 of this Act, allow the patentee to amend his complete specification in such manner and subject to such terms as to costs, advertisement or otherwise, as the High Court Division may think fit, and if in any proceedings for revocation the High Court Division decides that the patent is invalid, it may allow the specification amended under this section instead of revoking the patent.

(2) Where an application for an order under this section is made to the High Court Division, the applicant shall give notice of the application to the

Controller, and the Controller shall be entitled to appear and be heard, and shall appear if so directed by the High Court Division.

(3) Copies of the orders of the High Court Division allowing the patentee to amend the specification shall be transmitted by the High Court Division to the Controller who shall, on receipt thereof, cause an entry thereof and reference thereto to be made in the register.

60. Supplementary provisions as to amendment of application or specification.- (1) After the acceptance of a complete specification, no amendment of an application for a patent or a complete specification shall be effected except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of correcting an obvious mistake, and no amendment of a complete specification shall be allowed the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed in the specification before the amendment, or that any claim of specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

(2) Where, after the date of advertisement of acceptance of a complete specification, any amendment of the specification is allowed or approved by the Controller or the High Court Division,

- (a) the right of the applicant or the patentee to make the amendment shall not be called in question except on the ground of fraud; and
- (b) the amendment shall for all purposes and in all courts be deemed to form part of the specification.

(3) In construing the specification as amended, reference may be made to the specification as originally accepted.

(4) Where, after the date of advertisement of acceptance of a complete specification, any amendment of the specification is allowed or approved as aforesaid, the fact that the specification has been amended shall be advertised in the Official Gazette.

CHAPTER XI

RESTORATION OF LAPSED PATENTS

61. Application for restoration of lapsed patents and procedure for its disposal.- (1) Where a patent has ceased to have effect by reason of failure to pay any renewal fee within the prescribed period or within the period as

provided in sub-section (3) of section 54 of this Act, the patentee or his legal representative, and where the patent was held by two or more persons jointly, then, with the leave of the Controller, one or more of them without joining the others, may, within one year from the date on which the patent ceased to have effect, make an application for the restoration of the patent.

(2) The provisions of sub-section (1) of this section shall also apply to patents granted before the commencement of this Act, subject to the modification that for the reference to the prescribed period or to sub-section (3) of section 54 of this Act, there shall be substituted a reference to the period prescribed therefor under the Patents and Designs Act, 1911 (Act II of 1911) or to sub-section (2) of section 14 of that Act.

(3) An application under this section shall contain a statement, verified in the prescribed manner, fully setting out the circumstances which led to the failure to pay the prescribed fee, and the Controller may require from the applicant such further evidence as he may think necessary.

(4) If, after the hearing the applicant in cases where the applicant so requires or the Controller thinks fit, the Controller is prima facie satisfied that the failure to pay the renewal fee was unintentional and that there has been no undue delay in the making of the application, he shall advertise the application in the prescribed manner; and within the prescribed period any person interested may give notice to the Controller of opposition thereto on either or both of the following grounds, that is to say,-

- (a) that the failure to pay the renewal fee was not unintentional; or
- (b) that there has been undue delay in the making of the application.

(5) If notice of opposition is given within the period aforesaid, the Controller shall notify the applicant and shall give to him and to the opponent an opportunity to be heard before he decides the case.

(6) If no notice of opposition is given within the period aforesaid, or, if in the case of opposition, the decision of the Controller is in favour of the applicant, the Controller shall, upon payment of any unpaid renewal fee and such additional fee as may be prescribed, restore the patent and any patent of addition specified in the application which has ceased to have effect on the cesser of that patent.

(7) An order for restoration of a patent under this section may be subject to the condition that an entry shall be made in the register of any document or

matter, which, under the provisions of this Act, has to be entered in the register but which has not been so entered.

62. Effect of order for restoration patent.- (1) The effect of an order for the restoration of a patent is as follows.

(2) Anything done under or in relation to the patent during the period between expiry and restoration shall be treated as valid.

(3) Anything done during the period between expiry and restoration which would have constituted an infringement if the patent had not expired shall be treated as an infringement-

(a) if done at a time when it was possible for the patent to be renewed under sub-section (3) of section 61 of this Act; or

(b) if it was a continuation or repetition of an earlier infringing act.

(4) If after it was no longer possible for the patent to be so renewed, and before advertisement of the notice of the application for restoration, a person-

(a) began in good faith to do an act which would have constituted an infringement of the patent if it had not expired, or

(b) made in good faith effective and serious preparations to do such an act;

he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the restoration of the patent; but this right does not extend to granting a licence to another person to do the act.

(5) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by sub-section (4) of this section may-

(a) authorise the doing of that act by any partners of his for the time being in that business; and

(b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(6) Where a product is disposed of to another in exercise of the rights conferred by sub-sections (4) or (5) of this section, that other and any person

claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.

(7) The above provisions apply in relation to the use of a patent for the services of the Government as they apply in relation to infringement of the patent.

CHAPTER XII

SURRENDER OF PATENTS

63. Surrender of patents.- (1) A patentee may, at any time by giving notice to the Controller in the prescribed manner, offer to surrender his patent.

(2) Where such offer is made, the Controller shall advertise the offer in the prescribed manner, and also notify every person other than the patentee whose name appears in the register as having an interest in the patent.

(3) Any person interested may, within the prescribed period after such advertisement, give notice to the Controller of his opposition to the surrender of a patent under this section, and if he does so the Controller shall notify the patentee and determine the question.

(4) If the Controller is satisfied after hearing the patentee and any opponent who desires to be heard, that the patent may properly be surrendered, he may accept the offer of surrender and, as from the date when notice of his acceptance is advertised in the Official Gazette, the patent shall cease to have effect, but no action for infringement shall lie in respect of any act done before that date and no right to compensation shall accrue for any use of the patented invention before that date for the services of the Government.

(5) The acceptance of the offer of surrender shall be advertised by the Controller in the Official Gazette within sixty days from the date of acceptance.

CHAPTER XIII

REVOCATION OF PATENTS

64. Revocation of Patents.- (1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act, may, on the petition of any person interested or on a counter-claim in a suit for infringement of the patent, be revoked by the High Court Division on any of the following grounds, that is to say, -

- (a) that the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in Bangladesh;
- (b) that the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor :

Provided that a patent granted under the Patents and Designs Act, 1911 (Act II of 1911) shall not be revoked on the ground that the applicant was the communicatee or the importer of the invention in Bangladesh and therefore not entitled to make an application for the grant of a patent under this Act;

- (c) that the patent was obtained in contravention of the rights of the petitioner or any person under or through whom he claims;
- (d) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;
- (e) that the invention, so far as claimed in any claim of the complete specification, is not new, having regard to what was known or used in Bangladesh before the priority date of the claim or to what was published in Bangladesh or elsewhere in any of the documents referred to in section 15 of this Act:

Provided that in relation to patents granted under the Patents and Designs Act, 1911 (Act II of 1911), this clause shall have effect as if the words “or elsewhere” had been omitted;

- (f) that the invention, so far as claimed in any claim of the complete specification, is obvious or does not involve any inventive step, having regard to what was known or used in Bangladesh or what was published in Bangladesh or elsewhere before the priority date of the claim:

Provided that in relation to patents granted under the Patents and Designs Act, 1911 (Act II of 1911), this clause shall have effect as if the words “or elsewhere” had been omitted.

- (g) that the invention, so far as claimed in any claim of the complete specification, is not useful;
- (h) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are

not by themselves sufficient to enable a person in Bangladesh possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection;

- (i) that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;
- (j) that the patent was obtained on a false suggestion or representation;
- (k) that the primary or intended use or exercise of the invention is contrary to law;
- (l) that the subject of any claim of the complete specification is not patentable under this Act;
- (m) that the invention, so far as claimed in any claim of the complete specification, was secretly used in Bangladesh, otherwise than as mentioned in sub-section (3) of this section, before the priority date of that claim.
- (n) that the applicant for the patent has failed to disclose to the Controller the information required by section 13 of this Act or has furnished information which in any material particular was false to his knowledge.
- (o) that the applicant contravened any direction for secrecy passed under section 44 of this Act; and
- (p) that leave to amend the complete specification under section 65 or section 66 of this Act was obtained by fraud.

(2) For the purposes of clause (e) and (f) of sub-section (1) of this section-

- (a) no account shall be taken of secret use or of any use for the purpose of reasonable trial or experiment only; and
- (b) where the patent is for a process or for a product as made by a process described or claimed, the importation into Bangladesh of the product made abroad by that process shall constitute knowledge or use in Bangladesh of the invention on the date of the importation, except where such importation has been for the purpose of reasonable trial or experiment only.

(3) For the purpose of clause (m) of sub-section (1) of this section, no account shall be taken of any use of the invention-

- (a) for the purpose of reasonable trial or experiment only; or
- (b) by the Government or any person authorised by the Government or by a Government undertaking, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention directly or indirectly to the Government or person authorised as aforesaid or to the Government undertaking; or
- (c) by any other person, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention, and without the consent or acquiescence of the applicant or of any person from whom he derives title.

(4) Notice of any petition for revocation of a patent under this section shall be served on all persons appearing from the register to be the proprietors of that patent or to have shares or interests therein and it shall not be necessary to serve a notice on any other person.

65. Revocation of patent or amendment of complete specification on direction from the Government in cases relating to atomic energy.- (1) Where, at any time after acceptance of a complete specification, the Government is satisfied that an application for a patent or a patent is for an invention relating to atomic energy for which no patent can be granted under any law for the time being in force, it may direct the Controller to refuse to proceed further with the application or to revoke the patent, as the case may be, and thereupon the Controller, after giving notice to the applicant or, as the case may be, to the patentee and every other person whose name has been entered in the register as having an interest in the patent, and after giving them an opportunity of being heard, may refuse to proceed further with the application or may revoke the patent.

(2) In any proceedings under sub-section (1) of this section, the Controller may allow the applicant for the patent or the patentee to amend the complete specification in such manner as he considers necessary instead of refusing to proceed with the application for revoking the patent

66. Revocation of patent in public interest.- Where the Government is of opinion that a patent or the mode of exercising it is mischievous to the State or generally prejudicial to the public, it may, after giving the patentee an opportunity to be heard, make a declaration to that effect in the Official Gazette and thereupon the patent shall be deemed to be revoked. The above provision will require further consideration after circulation of the working paper.

CHAPTER XIV

REGISTER OF PATENTS

67. Register of patents.- (1) There shall be kept at the patent office a register of patents, wherein shall be entered-

- (a) the names and addresses of grantees of patents;
- (b) notifications of assignments and of transmissions of patents, of licences under patents, and of amendments; extensions, and revocations of patents; and
- (c) particulars of such other matters affecting the validity or proprietorship of patents as may be prescribed.

(2) No notice of any trust, whether express, implied or constructive, shall be entered in the register, and the Controller shall not be affected by any such notice.

(3) Subject to the superintendence and direction of the Government, the register shall be kept under the control and management of the Controller.

(4) The register of patents existing at the commencement of this Act shall be incorporated in, and form part of, the register under this Act.

68. Assignments etc., not to be valid unless in writing and registered.- An assignment of a patent or of a share in a patent, a mortgage, licence or the creation of any other interest in a patent shall not be valid unless the same were in writing and the agreement between the parties concerned is reduced to the form of a document embodying all the terms and conditions governing their rights and obligations and the application for registration of such document is filed in the prescribed manner with the Controller within six months from the date of commencement of this Act or the execution of the document, whichever is later or within such further period not exceeding six months in the aggregate as the Controller on application made in the prescribed manner allows:

Provided that the document shall, when registered, have effect from the date of its execution.

69. Registration of assignments, transmissions, etc.- (1) Where any person becomes entitled by assignment, transmission or operation of law to a patent or to a share in a patent or becomes entitled as a mortgagee, licensee or otherwise to any other interest in a patent, he shall apply in writing in the prescribed manner to the Controller for the registration of his title, or, as the case may be, of notice of his interest in the register.

(2) Without prejudice to the provisions of sub-section (1) of this section, an application for the registration of the title of any person becoming entitled by assignment to a patent or a share in a patent, or becoming entitled by virtue of a mortgage, licence or other instrument to any other interest in a patent, may be made in the prescribed manner by the assignor, mortgagor, licensor or any other party to the instrument, as the case may be.

(3) Where an application is made under this section for the registration of the title of any person, the Controller shall, upon proof of title to his satisfaction-

- (a) where that person is entitled to a patent or a share in a patent, register him in the register as proprietor or co-proprietor of the patent, and enter in the register particulars of the instrument or event by which he derives title; or
- (b) where the person is entitled to any other interest in the patent, enter in the register notice of his interest, with particulars of the instrument, if any, creating it:

Provided that if there is any dispute between the parties whether the assignment, mortgage, licence, transmission, operation of law or any other such transaction has validly vested in such person a title to the patent or any share or interest therein, the Controller may refuse to take any action under clause (a) or, as the case may be, under clause (b) of this sub-section, until the rights of the parties have been determined by a competent court.

(4) There shall be supplied to the Controller in the prescribed manner for being filed in the patent office copies of all agreements, licences and other documents affecting the title to any patent or any licence thereunder authenticated in the prescribed manner and also such other documents as may be prescribed relevant to the subject-matter:

Provided that in the case of a licence granted under a patent, the Controller shall, if so requested by the patentee or licensee, take steps for securing that the terms of the licence are not disclosed to any person except under the order of a court.

(5) Except for the purposes of an application under sub-section (1) of this section or of an application to rectify the register, a document in respect of which no entry has been made in the register under sub-section (3) of this section shall not be admitted by the Controller or by any court as evidence of the title of any person to a patent or to a share or interest therein unless the Controller or the court, for reasons to be recorded in writing, otherwise directs.

70. Power of registered proprietor or grantee to deal with patent.- Subject to the provisions contained in this Act relating to co-ownership of patents and also

subject to any rights vested in any other person of which notice is entered in the register, the person or persons registered as proprietor or grantee of a patent shall have power to assign, grant licences under, or otherwise deal with, the patent and to give effectual receipts for any consideration for any such assignment, licence or dealing:

Provided that any equities in respect of the patent may be enforced in like manner as in respect of any other moveable property.

71. Rectification of register by High Court Division.- (1) The High Court Division may, on the application of any person aggrieved, order the register to be rectified by the making, variation or deletion of any entry therein.

(2) In any proceedings under this section the High Court Division may decide any question that may be necessary or expedient to decide in connection with the rectification of the register.

(3) Notice of any application to the High Court Division under this section shall be given in the Controller who shall be entitled to appear and be heard on the application, and shall appear if so directed by the High Court Division.

(4) Any order of the High Court Division under this section rectifying the register shall direct that notice of the rectification shall be served upon the Controller in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

72. Register to be open for inspection.- (1) Subject to the provisions contained in this Act and any rules made thereunder, the register shall at all convenient times be open to inspection by the public.

(2) Certified copy, sealed with the seal of the Patent Office, of any entry in the register or certified extract from the register shall be supplied to any person requiring them on payment of the prescribed fee.

73. Entry in the register to be evidence.- (1) The register shall be prima facie evidence of any matters required or authorised by or under this Act to be entered therein.

(2) A certificate purporting to be signed by the Controller and certifying that any entry which he is authorised by this Act or by rules made under this Act to make has or has not been made, or that any other thing which he is so authorised to do has or has not been done, shall be prima facie evidence of the matters so certified.

(3) Each of the following, that is to say-

(a) a copy of an entry in the register or an extract from the register which is supplied under sub-section (2) of section 72 of this Act;

- (b) a copy of any document kept in the Patent Office or an extract from any such document, any specification of a patent or any application for patent which has been published,

which purports to be a certified copy or a certified extract shall be admitted in evidence without further proof and without production of the original.

(4) In section 79 of this Act and in this section “certified copy” and “certified extract” mean a copy and extract certified by the Controller, or by an officer authorised by him to certify, to be true copy of the original and sealed with the seal of the Patent Office.

CHAPTER XV

PATENT OFFICE

74. Patent Office.- (1) For the purposes of this Act, there shall be an office which shall be known as the Patent Office.

(2) The Patent Office provided by the Government under the Patents and Designs Act, 1911, (Act II of 1911) shall be the Patent Office under this Act.

(3) The head office of the Patent Office shall be at such place as the Government may specify, and for the purpose of facilitating the registration of patents there may be established, at such other place or places as the Government may think fit, branch offices of the Patent Office.

(4) There shall be a seal of the Patent Office.

75. Controller and other officers.- (1) For the purposes of this Act, the Government shall appoint a Controller of Patents and Designs.

(2) For the purposes of this Act, the Government may appoint as many examiners and other officers with such designations as it may think fit.

(3) Subject to the provisions of this Act, the officers appointed under sub-section (2) shall discharge under the superintendence and directions of the Controller such functions and powers of the Controller under this Act as he may, from time to time by general or special order in writing, authorise them to discharge.

(4) Without prejudice to the generality of the provisions of sub-section (3) of this section, the Controller may, by order in writing and for reasons to be recorded therein, withdraw any matter pending before an officer appointed under sub-section (2) of this section and deal with such matter himself either de novo or from the stage it was so withdrawn or transfer the same to another officer appointed under sub-section (2) of this section who may, subject to special directions in the order of

transfer, proceed with the matter either de novo or from the stage it was so transferred.

76. Restriction on employees of Patent Office as to right or interest in patents and as regards furnishing of information, etc.- (1) No officer or employee of the Patent Office shall, during the period for which he holds his office, acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by that office.

(2) An officer or employee of the Patent Office shall not, except when required or authorised by of this Act or under a direction in writing of the Government or the Controller or by order of a court,-

- (a) furnish information on a matter which is being, or has been, dealt with under this Act, or under the Patents and Designs Act, 1911 (Act II of 1911); or
- (b) prepare or assist in the preparation of a document required or permitted by or under this Act or under the Patents and Designs Act, 1911 (Act II of 1911), to be lodged in the Patent Office; or
- (c) conduct a search in the records of the Patent Office.

CHAPTER XVI

GENERAL POWERS OF CONTROLLER

77. Controller to have certain powers of a civil court.- Subject to any rules made in this behalf, the Controller in any proceedings before him under this Act shall have the powers of a civil court while trying a suit under the Code of Civil Procedure, 1908 (Act V of 1908) in respect of the following matters, namely:-

- (a) summoning and enforcing the attendance of any person and examining him on oath;
- (b) requiring the discovery and production of any document;
- (c) receiving evidence on affidavits;
- (d) issuing commissions for the examination of witnesses or documents;
- (e) awarding costs;
- (f) reviewing his own decision on application made within the prescribed time and in the prescribed manner;
- (g) setting aside an order passed exparte on application made within the prescribed time and in the prescribed manner;

(h) any other matter which may be prescribed.

78. Power of Controller to correct clerical errors, etc.- (1) Without prejudice to the provisions contained in section 58 and 60 of this Act as regards amendment of applications for patents or complete specifications and subject to the provisions of section 45 of this Act, the Controller may, in accordance with the provisions of this section, correct any clerical error in any patent or in any specification or other document filed in pursuance of such application or in any application for a patent or any clerical error in any matter which is entered in the register.

(2) A correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request .

(3) Where the controller proposes to make such correction as aforesaid otherwise than in pursuance of a request made under this section, he shall give notice of the proposal to the patentee or the applicant for the patent, as the case may be, and to any person who appears to him to be concerned, and shall give them an opportunity to be heard before making the correction.

(4) Where a request is made under this section for the correction of any error in a patent or an application for a patent or any document filed in pursuance of a such an application, and it appears to the Controller that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons affected thereby, he shall require notice of the nature of the proposed correction to be advertised in the prescribed manner.

(5) Within the prescribed time and after such advertisement as aforesaid any person interested may give notice to the Controller of opposition to the request, and where such notice of opposition is given, the Controller shall give notice thereof to the person by whom the request was made, and shall give to him and to the opponent an opportunity to be heard before he decides the case.

79. Evidence how to be taken and powers of Controller in respect thereof.- Subject to any rules made in this behalf, in any proceeding under this Act before the Controller, evidence shall be given by affidavit, in the absence of any direction by the Controller to the contrary, but in any case in which the Controller thinks it right so to do, he may take oral evidence 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.

80. Exercise of discretionary power of Controller.- Without prejudice to any provision contained in this Act requiring the Controller to hear any party to the proceedings thereunder or to give any such party an opportunity to be heard, the Controller shall give to any applicant for a patent, or for amendment of a specification (if within the prescribed time the applicant so requires), an opportunity to be heard

before exercising adversely to the applicant any discretion vested in the Controller by or under this Act.

81. Disposal by Controller of applications for extension of time.- Where, under the provisions of this Act or the rules made thereunder, the Controller may extend the time for doing any act, nothing in this Act shall be deemed to require him to give notice to or hear the parties interested in opposing the extension, nor shall any appeal lie from any order of the Controller granting such extension.

CHAPTER XVII

WORKING OF PATENTS, COMPULSORY LICENCES, LICENCES OF RIGHT AND REVOCATION OF PATENT

82. Patentee's application for entry in register that licences are available as of right.- (1) At any time after the grant of a patent its proprietor may apply to the Controller for an entry to be made in the register to the effect that licences under the patent are to be available as of right.

(2) Where such an application is made, the Controller shall give notice of the application to any person registered as having a right in or under the patent and, if satisfied that the proprietor of the patent is not precluded by contract from granting licences under the patent, shall make that entry.

(3) Where an entry is made under sub-section (2) of this section in respect of a patent-

- (a) any person shall, at any time after the entry is made, be entitled as of right to a licence under the patent on such terms as may be settled by agreement or, in default of agreement, by the Controller on the application of the proprietor of the patent or the person requiring the licence;
- (b) the Controller may, on the application of the holder of any licence granted under the patent before the entry was made, order the licence to be exchanged for a licence of right on terms so settled;
- (c) if in proceedings for infringement of the patent the defendant undertakes to take a licence on such terms, no injunction shall be granted or prosecution shall be proceeded with against him and the amount (if any) recoverable against him by way of damages shall not exceed double the amount which would have been payable by him as licensee if such a licence on those terms had been granted before the earliest infringement;
- (d) the renewal fee payable in respect of the patent after the date of the entry shall be half the fee which would be payable if the entry had not been made.

(4) An undertaking under sub-section 3 (c) of this section may be given at any time before final order in the proceedings, without any admission of liability.

(5) The licensee under a licence of right may (unless, in the case of a licence the terms of which are settled by agreement, the licence otherwise expressly provides) request the proprietor of the patent to take proceedings to prevent any infringement of

the patent; and if the proprietor refuses or neglects to do so within two months after being so requested, the licensee may institute proceedings for the infringement in his own name as if he were the proprietor, making the proprietor a defendant.

(6) A proprietor so added as defendant shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

83. Cancellation of entry made under section 82.- (1) At any time after an entry has been made under section 82 of this Act in respect of a patent, the proprietor of the patent may apply to the Controller for cancellation of the entry.

(2) Where such an application is made and the balance paid of all renewal fees which would have been payable if the entry had not been made, the Controller may cancel the entry, if satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application.

(3) Within the prescribed period after an entry has been made under section 89 of this Act in respect of a patent, any person who claims that the proprietor of the patent is, and was at the time of the entry, precluded by a contract in which the claimant is interested from granting licences under the patent may apply to the Controller for cancellation of the entry.

(4) Where the Controller is satisfied, on an application under sub-section (3) of this section, that the proprietor of the patent is and was so precluded, he shall cancel the entry; and the proprietor shall then be liable to pay, within a period specified by the Controller, a sum equal to the balance of all renewal fees which would have been payable if the entry had not been made, and the patent shall cease to have effect at the expiration of that period if that sum is not so paid.

(5) Where an entry is cancelled under this section, the rights and liabilities of the proprietor of the patent shall afterwards be the same as if the entry had not been made.

(6) Where an application has been made under this section, then-

- (a) in the case of an application under sub-section (1) of this section, any person, and
- (b) in case of an application under sub-section (3) of this section, the proprietor of the patent,

may within the prescribed period give notice to the Controller of opposition to the cancellation; and the Controller shall, in considering the application, determine whether the opposition is justified.

84. Compulsory licence and licence of right .- (1) At any time after the expiration of three years from the date of the sealing of a patent, any person may

apply to the Controller on one or more of the grounds specified in sub-section (2) of this section-

- (a) for a compulsory licence under the patent,
- (b) for an entry to be made in the register to the effect that licences under the patent are to be available as of right to be termed "licence of right", or
- (c) where the applicant is government department, for the grant to any person specified in the application of a licence under the patent.

(2) The grounds are:-

- (a) where the patented invention is capable of being commercially worked in Bangladesh, that it is not being so worked or is not being so worked to the fullest extent that is reasonably practicable and such lack of work is deemed abusive;
- (b) where the patented invention is a product, that a demand for the product in Bangladesh-
 - (i) is not being met on reasonable terms, or
 - (ii) is being met to a substantial extent by importation;
- (c) where the patented invention is capable of being commercially worked in Bangladesh, that it is being prevented or hindered from being so worked-
 - (i) where the invention is a product, by the importation of the product,
 - (ii) where the invention is a process, by the importation of a product obtained directly by means of the process or to which the process has been applied;
- (d) that by reason of the refusal of the proprietor of the patent to grant a licence or licences on reasonable terms-
 - (i) a market for the export of any patented product made in Bangladesh is not being supplied, or
 - (ii) the working or efficient working in Bangladesh of any other patented invention which makes a substantial contribution to the art is prevented or hindered, or
 - (iii) the establishment or development of commercial or industrial activities in Bangladesh is unfairly prejudiced;

- (e) that by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent, or the establishment or development of commercial or industrial activities in Bangladesh, is unfairly prejudiced;
- (f) that the reasonable requirements of the public with respect to the patented invention have not been satisfied;
- (g) that the patented invention is not available to the public at a reasonable price.

(3) Subject to the provisions of sub-sections (4) to (6) of this section, if the Controller is satisfied that any of those grounds are established, he may-

- (a) where the application is under sub-section 1 (a) of this section, order the grant of a licence to the applicant on such terms as he thinks fit;
- (b) where the application is under sub-section 1 (b) of this section, make such an entry as is there mentioned;
- (c) where the application is under sub-section 1 (c) of this section, order the grant of a licence to the person specified in the application on such terms as he thinks fit.

(4) Where the application is made on the ground that the patented invention is not being commercially worked in Bangladesh or is not being so worked to the fullest extent that is reasonably practicable, and it appears to the Controller that the time which has elapsed since the publication in the Official Gazette of a notice of the grant of the patent has for any reason been insufficient to enable the invention to be so worked, he may by order adjourn the application for such period not exceeding twelve months in the aggregate as appears to him to be sufficient for the invention to be so worked:

Provided that in any case where the patentee establishes that the reason why a patented invention could not be worked as aforesaid before the date of the application was due to any Act of Parliament or any rule or regulation made thereunder or any order of the Government imposed otherwise than by way of a condition for the working of the invention in Bangladesh or for the disposal of the patented articles or of the articles made by the process or by the use of the patented plant, machinery or apparatus, then, the period of adjournment ordered under this sub-section shall be reckoned from the date on which the period during which the working of the invention was prevented by such Act or rule or regulation or order of the Government as computed from the date of the application, expires.

(5) No entry shall be made in the register under this section on the ground mentioned in sub-section (2) (d) (i) of this section, and any licence granted under this section on that ground shall contain such provisions as appear to the Controller to be expedient for restricting the countries in which the product concerned may be disposed of or used by the licensee.

(6) No order or entry shall be made under this section in respect of a patent (the patent concerned) on the ground mentioned in sub-section (2) (d) (ii) of this section unless the Controller is satisfied that the proprietor of the patent for the other invention is able and willing to grant to the proprietor of the patent concerned and his licensees a licence under the patent for the other invention on reasonable terms.

(7) An application may be made under this section in respect of a patent notwithstanding that the applicant is already the holder of a licence under the patent; and no person shall be estopped or barred from alleging any of the matters specified in sub-section (2) of this section by reason of any admission made by him, whether in such a licence or otherwise, or by reason of his having accepted a licence.

(8) Where a patent of addition is in force, any application made under sub-section 1 (b) of this section for entry as "licence of right" either of the original patent or of the patent of addition shall be treated as an application for the entry of both patents, and where a patent of addition is granted in respect of a patent which is already entered under sub-section (3) (b) of this section as "licence of right", the patent of addition shall also be so entered.

(9) All licences granted and all entries made under this section shall be published in the Official Gazette in such manner as the Controller thinks fit.

85. Certain patents deemed to be entered as "licences of right."- (1)
Notwithstanding anything contained in this Act,-

- (a) every patent in force at the commencement of this Act in respect of inventions relating to-
 - (i) substances used or capable of being used as food or as medicine or drug;
 - (ii) the methods or processes for the manufacture or production of any such substance as is referred to in sub-clause (i);
 - (iii) the methods or processes for the manufacture or production of chemical substances (including alloys, optical glass, semi-conductors and inter-metallic compounds);

shall be deemed to be entered under sub-section (3) (b) of section 91 of this Act as "licences of right" from the commencement of this Act or from the expiration

of three years from the date of sealing of the patent under the Patents and Designs Act, 1911 (Act II of 1911), whichever is later, and

- (b) every patent granted after the commencement of this Act in respect of any such invention as is referred to in clause (r) of section 4 of this Act shall be deemed to be entered under sub-section (4) (b) of section 91 of this Act as “licence of right” from the date of expiration of three years from the date of sealing of the patent.

(2) In respect of every patent which is deemed to be entered under sub-section (4) (b) of section 84 of this Act as “licence of right, the provisions of section 86 of this Act shall apply.

86. Effect of entry of patent under sub-section (3) (b) of section 91 of this Act as “licence of right.”- (1) Where a patent has been entered under sub-section (3) (b) of section 84 of this Act as “licence of right”, any person who is interested in working the patented invention in Bangladesh may require the patentee to grant him a licence for the purpose on such terms as may be mutually agreed upon, notwithstanding that he is already the holder of a licence under the patent.

(2) If the parties are unable to agree on the terms of the licence, either of them may apply in the prescribed manner to the Controller to decide the terms thereof.

(3) The Controller shall, after giving notice to the parties and hearing them and after making such inquiry as he may deem fit, decide the terms on which the licence shall be granted by the patentee.

(4) The Controller may at any time before the terms of the licence are mutually agreed upon or decided by the Controller, on application made to him in this behalf by any person who has made any such requisition as is referred to in sub-section (1) of this section, permit him to work the patented invention on such terms as the Controller may, pending agreement between the parties or decision by the Controller, think fit to impose.

(5) The provisions of sub-sections (1), (2), (4) and (5) of section 89 and section 90 of this Act shall apply to licences granted under this section as they apply to licences granted under section 84 of this Act.

87. Revocation of patents for non-working.- (1) Where, in respect of a patent, a compulsory licence has been granted under sub-section 1 (a) of section 84 of this Act or an entry has been made under sub-section 1 (b) of section 84 of this Act as “licence of right” or a licence has been granted to any person on the application of a Government department under sub-section 1 (c) of section 84 of this Act, any person interested may, after the expiration of two years from the date of the order granting the first compulsory licence or an entry as “ licence of right” or a licence on the

application of a Government department, as the case may be, apply to the Controller for an order revoking the patent upon any of the grounds specified in sub-section (2) of section 84 of this Act.

(2) Every application under sub-section (1) of this section shall contain such particulars as may be prescribed and the facts upon which the application is based and shall also set out the nature of the applicant's interest.

(3) The Controller, if satisfied that any of grounds mentioned in sub-section (2) of section 84 of this Act are established, may make an order revoking the patent.

(4) Every application under sub-section (1) of this section shall ordinarily be decided within one year of its being presented to the Controller.

88. Procedure for dealing with an application under sections 84 and 87 of this Act.- (1) Where the Controller is satisfied, upon consideration of an application made under section 84 or section 87 of this Act, that a prima facie case has been made out for the making of an order, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which the application is made, and shall advertise the application in the Official Gazette.

(2) The patentee or any other person desiring to oppose the application may, within such time as may be prescribed or within such further time as the Controller may on application (made either before or after the expiration of the prescribed time) allow, give to the Controller notice of opposition.

(3) Any such notice of opposition shall contain a statement setting out the ground on which the applicant is opposed.

(4) Where any such notice of opposition is duly given, the Controller shall notify the applicant, and shall give to the applicant and the opponent an opportunity to be heard before deciding the matter.

89. Provisions about licences under section 84 of this Act.- (1) Where the Controller is satisfied, on an application made under section 84 of this Act in respect of a patent, that the manufacture, use or disposal of materials not protected by the patent is prejudiced by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or the use of the patented process, he may, subject to the provisions of that section, order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant.

(2) Where an application under section 84 of this Act is made in respect of a patent by a person who holds a licence under the patent, the Controller-

- (a) may, if he orders the grant of licence to the applicant, order the existing licence to be cancelled, or
- (b) may, instead of ordering the grant of a licence to the applicant, order the existing licence to be amended.

(3) Where on an application made under section 84 of this Act, the Controller orders the grant of a licence, he may, for reasons to be recorded in writing, direct that the licence shall operate-

- (a) to deprive the patentee of any right which he may have as patentee to make, use, exercise or vend the invention or to grant licences under the patent;
- (b) to revoke all existing licences in respect of the invention.

(4) Where two or more patents are held by the same patentee and an applicant for a compulsory licence establishes one or more of the grounds mentioned in sub-section (2) of section 84 of this Act with respect to some only of the patents, then, if the Controller is satisfied that the applicant cannot efficiently or satisfactorily work the licence granted to him under those patents without infringing the other patents held by the patentee, he may, by order, direct the grant of a licence in respect of the other patents also to enable the licensee to work the patent or patents in regard to which a licence is granted under section 84 of this Act.

(5) Where the terms and conditions of a licence have been settled by the Controller, the licensee may, at any time after he has worked the invention on a commercial scale for a period of not less than twelve months, make an application to the Controller for the revision of the terms and conditions on the ground that the terms and conditions settled have proved to be more onerous than originally expected and that in consequence thereof the licensee is unable to work the invention except at a loss:

Provided that no such application shall be entertained a second time.

(6) Sub-sections (5) and (6) of section 82 of this Act shall apply to a licence granted in pursuance of an order under section 84 of this Act and a licence granted by virtue of an entry under that section as it applies to a licence granted by virtue of an entry under section 82 of this Act.

90. General purposes of exercise of powers under section 84 of this Act.- (1) The powers of the Controller on an application under section 84 of this Act in respect of a patent shall be exercised with a view to securing the following general purposes:-

- (a) that the inventions which can be worked on a commercial scale in Bangladesh and should in the public interest be so worked shall be

worked there without undue delay and to the fullest extent that is reasonably practicable;

- (b) that the inventor or other person beneficially entitled to a patent shall receive reasonable remuneration having regard to the nature of the invention;
- (c) that the interests of any person for the time being working or developing an invention in Bangladesh under the protection of a patent shall not be unfairly prejudiced.

(2) Subject to sub-section (1) of this section, the Controller shall, in determining whether to make an order or entry in pursuance of such an application, take account of the following matters, that is to say-

- (a) the nature of the invention, the time which has elapsed since the publication in the Official Gazette of a notice of the grant of the patent and the measures already taken by the proprietor of the patent or any licensee to make full use of the invention;
- (b) the ability of any person to whom a licence would be granted under the order concerned to work the invention to the public advantage; and
- (c) the risks to be undertaken by that person in providing capital and working the invention if the application for an order is granted,

but shall not be required to take account of matters subsequent to the making of the application.

91. Licensing of related patents.- (1) Notwithstanding anything contained elsewhere of this Chapter, at any time after the sealing of a patent, any person who has the right to work any other patented invention either as patentee or as licensee thereof, exclusive or otherwise, may apply to the Controller for the grant of a licence of the first mentioned patent on the ground that he is prevented or hindered without such licence from working the other invention efficiently or to the best advantage possible.

(2) No order under sub-section (1) of this section shall be made unless the Controller is satisfied-

- (i) that the applicant is able and willing to grant, or procure the grant to the patentee and his licensees if they so desire, of a licence in respect of the other invention on reasonable terms; and
- (ii) that the other invention has made a substantial contribution to the establishment or development of commercial or industrial activities in Bangladesh.

(3) When the Controller is satisfied that the conditions mentioned in sub-section (1) of this section have been established by the applicant, he may make an order on such terms as he thinks fit for granting licence under the first mentioned patent and a similar order under the other patent if so requested by the proprietor of the first mentioned patent or his licensee.

(4) The provisions of sections 88 and 111 of this Act shall apply to licences granted under this section as they apply to licences granted under section 84 of this Act.

92. Order for licence to operate as a deed between parties concerned.- Any order for the grant of a licence under this Chapter shall operate as if it were a deed granting a licence executed by the patentee and all other necessary parties embodying the terms and conditions, if any, settled by the parties.

CHAPTER XVIII

USE OF INVENTIONS FOR PURPOSES OF GOVERNMENT AND ACQUISITION OF INVENTIONS BY GOVERNMENT.

93. Meaning of “use of invention for purposes of Government.- (1) For the purposes of this Chapter, an invention is said to be used for the purposes of Government if it is made, used, exercised or vended for the purposes of the Government or a Government undertaking.

(2) Without prejudice to the generality of the provisions of sub-section (1) of this section,

- (a) the importation, by or on behalf of the Government, of any invention being a machine, apparatus or other article covered by a patent granted before the commencement of this Act, for the purposes merely of its own use; and
- (b) the importation, by or on behalf of the Government, of any invention being a medicine or drug covered by a patent granted before the commencement of this Act-
 - (i) for the purpose merely of its own use; or
 - (ii) for the purpose of distribution in any dispensary, hospital or other medical institution maintained by or on behalf of the Government or in any other dispensary, hospital or other medical institution which the Government may, having regard to the public service which such other dispensary, hospital or medical institution render, specify in this behalf by notification in the Official Gazette,

shall also be deemed, for the purposes of this Chapter, to be use of such invention for the purposes of Government.

(3) Nothing contained in this Chapter shall apply in respect of any such importation, making or using of any machine, apparatus or other article or any such using of any process or of any such importation, using or distribution of any medicine or drug, as may be made by virtue of one or more conditions specified in section 48 of this Act.

94. Power of Government to use inventions for purposes of Government:- (1) Notwithstanding anything contained in this Act, at any time after an application for a patent has been filed at the patent office or a patent has been granted, the Government and any person authorised in writing by it, may use the invention for the purposes of Government in accordance with the following provisions of this Chapter.

(2) If and so far as the invention has, before the priority date of the relevant claim of the complete specification, been duly recorded in a document, or tested or tried, by or on behalf of the Government or a Government undertaking, otherwise than in consequence of the communication of the invention directly or indirectly by the patentee or any person from whom he derives title, any use of the invention by the Government or any person authorised in writing by it for the purpose of Government may be made free of any royalty or other remuneration to the patentee.

(3) If and so far as the invention has not been recorded or tried or tested as aforesaid, any use of the invention made by the Government or any person authorised by it under sub-section (1) of this section, at any time after the acceptance of the complete specification in respect of the patent or in consequence of any such communication as aforesaid, shall be made upon such terms as may be agreed upon, either before or after the use, between the Government or any person authorised under sub-section (1) of this section and the patentee, or, as may, in default of such agreement, be determined by the High Court Division on a reference under section 104 of this Act:

Provided that in the case of any such use of any patent in respect of any medicine or drug or article of food the royalty and other remuneration shall in no case exceed four per centum of the net ex-factory sale price in bulk of the patented article (exclusive of taxes levied under any law for the time being in force and any commissions payable) determined in such manner as may be prescribed.

(4) The authorisation by the Government in respect of an invention may be given under this section, either before or after the patent is granted and either before or after the acts in respect of which such authorisation is given or done, and may be given to any person, whether or not he is authorised directly or indirectly by the applicant or the patentee to make, use, exercise or vend the invention or import the machine, apparatus or other article or medicine or drug covered by such patent.

(5) Where an invention has been used by or with the authority of the Government under this section, then, unless it appears to the Government that it would be contrary to the public interest so to do, the Government shall notify the patentee as soon as practicable of the fact and furnish him with such information as to the extent of the use of the invention as he may, from time to time, reasonably require; and where the invention has been used for the purposes of a Government undertaking, the Government may call for such information as may be necessary for this purpose from such undertaking.

(6) The right to make, use, exercise and vend an invention for the purposes of the Government under sub-section (1) of this section shall include the right to sell the goods which have been made in exercise of that right, and a purchaser of goods so sold, and a person claiming through him, shall have the power to deal with the goods as if the Government or the person authorised under sub-section (1) of this section were the patentee of the invention.

(7) Where, in respect of a patent which has been the subject of an authorisation under this section, there is an exclusive licensee as is referred to in sub-section (3) of section 95 of this Act, or where such patent has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention (including payments by way of minimum royalty), the notice directed to be given under sub-section (5) of this section shall also be given to such exclusive licensee or assignor, as the case may be, and the reference to the patentee in sub-section (3) of this section shall be deemed to include a reference to such assignor or exclusive licensee.

95. Rights of third parties in respect of use of invention for purposes of Government.- (1) In relation to any use of a patented invention, or an invention in respect of which an application for a patent is pending, made for the purposes of Government-

- (a) by the Government or any person authorised by the Government under section 94 of this Act; or
- (b) by the patentee or applicant for the patent to the order of the Government,

the provisions of any licence, assignment or agreement granted or made, whether before or after the commencement of this Act, between the patentee or applicant for the patent or any person who derives title from him or from whom he derives title, and any person other than the Government shall be of no effect so far as those provisions-

- (i) restrict or regulate the use of the invention, or of any model, document or information relating thereto for the purposes of the Government, or
- (ii) provide for the making of payments in respect of any use of the invention or of the model, document or information relating thereto for the purposes of the Government, including payments by way of minimum royalty,

and the reproduction or publication of any model or document in connection with the said use for the purposes of the Government shall, notwithstanding anything in any other law for the time being in force, not be deemed to be an infringement of any copyright subsisting in the model or document.

(2) Where the patent, or the right to apply for or obtain the patent, has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention, including payments by way of minimum royalty, then-

- (a) in relation to any use of the invention made for the purposes of the Government by the patentee to the order of the Government, sub-section (3) of section 94 of this Act shall have effect as if that use were made by virtue of an authority given under that section; and
- (b) in relation to any use of the invention for the purposes of the Government by virtue of sub-section (3) of section 94 of this Act shall have effect as if the reference to the patentee included a reference to the assignor of the patent and any sum payable by virtue of that sub-section shall be divided between the patentee and the assignor in such proportion as may be agreed upon between them or as may in default of agreement be determined by the High Court Division on a reference under section 97 of this Act.

(3) Where, by virtue of sub-section (3) of section 94 of this Act, payments are required to be made by the Government or persons authorised under sub-section (1) of that section in respect of the use of an invention for the purposes of the Government and where in respect of such patent there is an exclusive licensee authorised under his licence to use the invention for the purposes of the Government, such sum shall be shared by the patentee and such licensee in such proportions, if any, as may be agreed upon between them or as may in default of agreement be determined by the High Court Division on a reference under section 97 of this Act to be just, having regard to any expenditure incurred by the licensee-

- (a) in developing the said invention; or
- (b) in making payments to the patentees other than royalties or other benefits determined by reference to the use of the invention including payments by way of minimum royalty in consideration of the licence.

96. Acquisition of inventions and patents by Government.- (1) The Government may, if satisfied that it is necessary that an invention which is the subject of an application for a patent or a patent should be acquired from the applicant or the patentee, as the case may be, for a public purpose, publish a notification to that effect in the Official Gazette, and thereupon the invention or patent and all rights in respect of the invention or patent shall stand transferred to and be vested in the Government.

(2) Notice of the acquisition under sub-section (1) of this section shall be given to the applicant for the patent, and, where a patent has been granted, to the patentee and other persons, if any, appearing in the register as having an interest in the patent.

(3) The Government shall pay to the applicant, or, as the case may be, the patentee or other persons appearing on the register as having an interest in the patent, such compensation as may be agreed upon between the Government and the applicant, or the patentee and other persons; or, as may, in default of agreement, be determined by the High Court Division on a reference under section 97 of this Act to be just having regard to the expenditure incurred in connection with the invention and, in case of a patent, the term thereof, the period during which and the manner in which it has already been worked including the profits made during such period by the patentee or by his licensee, whether exclusive or otherwise, and other relevant factors.

97. Reference to High Court Division of disputes as to use for purposes of Government.- (1) Any dispute as to the exercise by the Government or a person authorised by it of the power conferred by section 94 of this Act, or as to terms for the use of an invention for the purposes of the Government thereunder or as to the right of any person to receive any part of a payment made in pursuance of sub-section (3) of that section or as to the amount of compensation payable for the acquisition of an invention or a patent under section 96 of this Act, may be referred to the High Court Division by either party to the dispute in such manner as may be prescribed.

(2) In any proceedings under this section to which the Government is a party, the Government may,-

- (a) if the patentee is a party to the proceedings, file a petition by way of counter-claim for revocation of the patent on any ground upon which a patent may be revoked under section 64 of this Act, and

(b) whether a patentee is or is not a party to the proceedings, put in issue the validity of the patent without filing a petition for its revocation.

(3) If in such proceedings as aforesaid any question arises whether an invention has been recorded, tested or tried as is mentioned in section 94 of this Act, and the disclosure of any document regarding the invention, or of any evidence of the test or trial thereof, would in the opinion of the Government, be prejudicial to the public interest, the disclosure may be made confidentially to the advocate of the other party or to an independent expert mutually agreed upon.

(4) In determining under this section any dispute between the Government and any person as to terms for the use of an invention for the purposes of the Government, the High Court Division shall have regard to any benefit or compensation which that person or any person from whom he derives title, may have received, or may be entitled to receive, directly or indirectly in respect of the use of the invention in question for the purposes of the Government.

(5) In any proceedings under this section, the High Court Division may, at any time, order the whole proceedings or any question or issue of fact arising therein to be referred to an official referee, commissioner or an arbitrator on such terms as the High Court Division may direct; and references to the High Court Division in the foregoing provisions of this section shall be construed accordingly.

(6) Where the invention claimed in a patent was made by a person who at the time it was made was in the service of the Government or was an employee of a Government undertaking and the subject-matter of the invention is certified by the relevant Government or the principal officer of the Government undertaking to be connected with the work done in the course of the normal duties of the Government servant or employee of the Government undertaking, then notwithstanding anything contained in this section, any dispute of the nature referred to in sub-section (1) of this section relating to an invention shall be disposed of by the Government in conformity with the provisions of this section so far as may be applicable, but before doing so, the Government shall give an opportunity to the patentee and such other parties as it considers have an interest in the matter to be heard.

CHAPTER XIX

EMPLOYEES' INVENTIONS

98. Meaning of “employee” and “employer”.- For the purposes of this Chapter,-

(a) “employee” means a person who works or (where the employment has ceased) worked under a contract of employment or in employment under or for the purposes of the Government or a Government

undertaking including a person who serves or served in the army, navy or air force of the Republic; and

- (b) “employer”, in relation to an employee, means the person by whom the employee is or was employed.

99. Right to employees’ inventions.- (1) Notwithstanding anything contained in any other law for the time being in force, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Act and all other purposes if-

- (a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or
- (b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer’s undertaking.

(2) Any other invention made by an employee shall, as between him and his employer, be taken for the purposes of this Act to belong to the employee.

(3) Where, by virtue of this section an invention belongs, as between him and his employer, to an employee, nothing done-

- (a) by or on behalf of the employee or any person claiming under him for the purposes of pursuing an application for a patent, or
- (b) by any person for the purpose of performing or working the invention,

shall be taken to infringe any copyright or design right to which, as between him and his employer, his employer is entitled in any model or document relating to the invention.

100. Compensation of employees for certain inventions.- (1) Where it appears to the Controller on an application made by an employee within the prescribed period that the employee has made an invention belonging to the employer for which a patent has been granted, that the patent is, having regard among other things to the size and nature of the employer’s undertaking, of outstanding benefit to the employer and that by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer, the Controller may award him such compensation of an amount determined under section 101 of this Act.

(2) Where it appears to the Controller on an application made by an employee within the prescribed period that-

- (a) a patent has been granted for an invention made by and belonging to the employee;
- (b) his rights in the invention, or in any patent or application for a patent for the invention, have since the coming into force of this Act been assigned to the employer or an exclusive licence under the patent or application has since the coming into force of this Act been granted to the employer;
- (c) the benefit derived by the employee from the contract of assignment, assignation or grant or ancillary contract, hereinafter referred to as “the relevant contract,” is inadequate in relation to the benefit derived by the employer from the patent; and
- (d) by reason of those facts it is just that the employee should be awarded compensation to be paid by the employer in addition to the benefit derived from the relevant contract;

the Controller may award him such compensation of an amount determined under section 101 of this Act.

(3) Sub-section (2) of this section shall have effect notwithstanding anything in the relevant contract or any agreement applicable to the invention.

(4) References in this section to an invention belonging to an employer or employee are references to it so belonging as between the employer and the employee.

101. Amount of compensation.- (1) An award of compensation to an employee under sub-section (1) or sub-section (2) of section 100 of this Act in relation to a patent for an invention shall be such as will secure for the employee a fair share (having regard to all the circumstances) of the benefit which the employer has derived, or may reasonably be expected to derive, from the patent or from the assignment, assignation or grant to a person connected with the employer of the property or any right in the invention or the property in, or any right in or under, an application for that patent.

(2) For the purposes of sub-section (1) of this section the amount of any benefit derived or expected to be derived by an employer from the assignment, assignation or grant of-

- (a) the property in, or any right in or under, a patent for the invention or an application for such a patent; or

- (b) the property or any right in the invention;

to a person connected with him shall be taken to be the amount which could reasonably be expected to be so derived by the employer if that person had not been connected with him.

(3) Where the Government in its capacity as employer assigns or grants the property in, or any right in or under, an invention, patent or application for a patent to a body having among its functions that of developing or exploiting inventions resulting from public research and does so for no consideration or only a nominal consideration, any benefit derived from the invention, patent or application by that body shall be treated for the purposes of the foregoing provisions of this section as so derived by the Government.

(4) In determining the fair share of the benefit to be secured for an employee in respect of a patent for an invention which has always belonged to an employer, the Controller shall, among other things, take the following matters into account, that is to say-

- (a) the nature of the employee's duties, his remuneration and the other advantages he derives or has derived from his employment or has derived in relation to the invention under this Act;
- (b) the effort and skill which the employee has devoted to making the invention;
- (c) the effort and skill which any other person has devoted to making the invention jointly with the employee concerned, and the advice and other assistance contributed by any other employee who is not a joint inventor of the invention; and
- (d) the contribution made by the employer to the making, developing and working of the invention by the provision of advice, facilities and other assistance, by the provision of opportunities and by his managerial and commercial skill and activities.

(5) In determining the fair share of the benefit to be secured for an employee in respect of a patent for an invention which originally belonged to him, the Controller shall, among other things, take the following matters into account, that is to say-

- (a) any conditions in a licence or licences granted under this Act or otherwise in respect of the invention or the patent;
- (b) the extent to which the invention was made jointly by the employee with any other person; and

- (c) the contribution made by the employer to the making, developing and working of the invention as mentioned in clause (d) of sub-section (4) of this section.

(6) Any order for the payment of compensation under section 100 of this Act may be an order for the payment of a lump sum or for periodical payment, or both.

(7) The refusal of the Controller to make any such order on an application by an employee under section 100 of this Act shall not prevent a further application being made under that section by him or any successor in title of his.

(8) When the Controller has made any such order, he may on the application of either the employer or the employee vary or discharge it or suspend any provision of the order and revive any provision so suspended.

102. Enforceability of contracts relating to employees' inventions.- (1) This section applies to any contract relating to inventions made by an employee, being a contract entered into by him-

- (a) with the employer (alone or with another); or
- (b) with some other person at the request of the employer or in pursuance of the employee's contract of employment.

(2) Any term in a contract to which this section applies which diminishes the employee's rights in inventions of any description made by him after the coming into force of this Act and the date of the contract, or in or under patents for those inventions or applications for such patents, shall be unenforceable against him to the extent that it diminishes his rights in an invention of that description so made, or in or under a patent for such an invention or an application for any such patent.

(3) Sub-section (2) of this section shall not be construed as derogating from any duty of confidentiality owed to his employer by an employee by virtue of any law for the time being in force or otherwise.

(4) This section applies to any arrangement made with a Government employee by or on behalf of the Government as his employer as it applies to any contract made between an employee and an employer other than the Government, and for the purposes of this section "Government employee" means a person employed under or for the purposes of the Government or any officer or body exercising on behalf of the Government functions conferred by any enactment or a person serving in the army, navy or air forces of the Republic.

103. Supplementary provisions.- (1) Sections 98 to 102 of this Act shall not apply to an invention made before the coming into force of this Act.

(2) Sections 98 to 102 of this Act shall not apply to an invention made by an employee unless at the time he made the invention one of the following conditions was satisfied in his case, that is to say-

- (a) he was mainly employed in Bangladesh; or
- (b) he was not mainly employed anywhere or his place of employment could not be determined, but his employer had a place of business in Bangladesh to which the employee was attached, whether or not he was also attached elsewhere.

(3) In sections 98 to 102 of this Act and this section, except so far as the context otherwise requires, references to the making of an invention by an employee are references to his making it alone or jointly with any other person, but do not include references to his merely contributing advice or other assistance in the making of an invention by another employee.

(4) Any references in sections 98 to 102 of this Act to a patent and to a patent being granted are respectively references to a patent or other protection and to its being granted whether under this Act or the law in force in any other country or under any treaty or international convention.

(5) For the purposes of sections 100 and 101 of this Act the benefit derived or expected to be derived by an employer from a patent shall, where he dies before any award is made under section 100 of this Act in respect of the patent, include any benefit derived or expected to be derived from the patent by his personal representatives or by any person in whom it was vested by their assent.

(6) Where an employee dies before an award is made under section 100 of this Act in respect of a patented invention made by him, his personal representatives or their successors in interest may exercise his right to make or proceed with an application for compensation under sub-sections (1) or (2) of that section.

(7) In sections 100 and 101 of this Act and this section “benefit” means benefit in money or money’s worth.

CHAPTER XX

AVOIDANCE OF CERTAIN CONTRACTS

104. Avoidance of certain restrictive conditions.- (1) Subject to the provisions of this section, any condition or term of a contract for the supply of a patented product or of a licence to work a patented invention, or a contract relating to any such supply or licence, shall be void in so far as it purports-

- (a) in the case of a contract for supply, to require the person supplied to acquire from the supplier, or his nominee, or prohibit him from acquiring from any specified person, or from acquiring except from the supplier or his nominee, anything other than the patented product;
- (b) in the case of a licence to work a patented invention, to require the licensee to acquire from the licensor or his nominee or prohibit him from acquiring from any specified person, or from acquiring except from the licensor or his nominee, anything other than the product which is the patented invention or, if it is a process, other than any product obtained directly by means of the process or to which the process has been applied:
- (c) in either case, to prohibit the person supplied or licensee from using articles, whether patented products or not, which are not supplied by, or any patented process which does not belong to, the supplier or licensor, or his nominee, or to restrict the right of the person supplied or licensee to use any such articles or process.

(2) Sub-section (1) of this section applies to contracts and licences, whether made or granted before or after the coming into force of this Act.

(3) In proceedings against any person for infringement of a patent it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent and containing a condition or term declared void by this section:

Provided that this sub-section shall not apply if the plaintiff is not a party to the contract and proves to the satisfaction of the court that the restrictive condition was inserted in the contract without his knowledge and consent, express or implied.

(4) A condition or term of a contract or licence shall not be void by virtue of this section if-

- (a) at the time of the making of the contract or granting of the licence the supplier or licensor was willing to supply the product, or grant a licence to work the invention, as the case may be, to the person supplied or licensee, on reasonable terms specified in the contract or

licence and without any such condition or term as is mentioned in sub-section (1) of this section; and

- (b) the person supplied or licensee is entitled under the contract or licence to relieve himself of his liability to observe the condition or term on giving to the other party three months' notice in writing and subject to payment to that other party of such compensation being, in the case of a contract to supply, a lump sum or rent for the residue of the term of the contract and, in case of a licence, a royalty for the residue of the term of the licence, as may be determined by the Controller.

(5) If in any proceedings it is alleged that any condition or term of a contract or licence is void by virtue of this section it shall lie on the supplier or licensor to prove the matters set out in clause (a) of sub-section (4) of this section.

(6) A condition or term of a contract or licence shall not be void by virtue of this section by reason only that it prohibits any person from selling goods other than those supplied by a specific person or, in the case of a contract for the hiring of or licence to use a patented product, that it reserves to the hirer or licensor, or his nominee, the right to supply such new parts of the patented product as may be required to put or keep it in repair.

105. Determination of parts of certain contracts.- (1) Any contract for the supply of a patented product or licence to work a patented invention, or contract relating to any such supply or licence, may at any time after the patent or all the patents by which the product or invention was protected at the time of the making of the contract or granting of the licence has or have ceased to be in force, and notwithstanding anything to the contrary in the contract or licence or in any other contract, be determined, to the extent (and only to the extent) that the contract or licence relates to the product or invention, by either party on giving three months' notice in writing to the other party.

(2) In sub-section (1) of this section "patented product" and "patented invention" include respectively a product and an invention which is the subject of an application for a patent, and that sub-section shall apply in relation to a patent by which any such product or invention was protected and which was granted after the time of the making of the contract or granting of the licence in question, on an application which had been filed before that time, as it applies to a patent in force at that time.

(3) If, on an application under this sub-section made by either party to a contract or licence falling within sub-section (1) of this section, the Controller is satisfied that, in consequence of the patent or patents concerned ceasing to be in force, it would be unjust to require the applicant to continue to comply with all the terms and conditions of the contract or licence, it may make such order varying those orders or

conditions as, having regard to all the circumstances of the case, it thinks just as between the parties.

(4) The foregoing provisions of this section apply to contracts and licences whether made before or after the coming into force of this Act.

(5) The provisions of this section shall be without prejudice to any law for the time being in force relating to any right of determining a contract or licence exercisable apart from this section.

CHAPTER XXI

INFRINGEMENTS

106. Meaning of proceedings concerning infringement of patents, etc.- Subject to the provisions of this section, a person infringes a patent for an invention if, but only if, while the patent is in force, he does any of the following things in Bangladesh in relation to the invention without the consent of the patentee, that is to say,-

- (a) where the invention is a product, he makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise;
- (b) where the invention is a process, he uses the process or he offers it for use in Bangladesh when he knows, or it is obvious to a reasonable person in the circumstances, that its use there without the consent of the patentee would be an infringement of the patent.
- (c) where the invention is a process, he disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.

(2) Subject to the following provisions of this section, a person, other than the patentee, also infringes a patent for an invention if, while the patent is in force and without the consent of the patentee, he supplies or offers to supply in Bangladesh a person other than a licensee or other person entitled to work the invention with any of the means, relating to an essential element of the invention, for putting the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in Bangladesh.

(3) Sub-section (2) of this section shall not apply to the supply or offer of a staple commercial product unless the supply or the offer is made for the purpose of including the person supplied or, as the case may be, the person to whom the offer is made to do an act which constitutes an infringement of the patent by virtue of sub-section (1) of this section.

(4) An act which, apart from this sub-section, would constitute an infringement of a patent for an invention shall not do so if-

- (a) it is done privately and for purposes which are not commercial;
- (b) it is done for experimental purposes relating to the subject-matter of the invention;
- (c) it consists of the extemporaneous preparation in a pharmacy of a medicine for an individual in accordance with a prescription given by a registered medical or dental practitioner or consists of dealing with a medicine so prepared;
- (d) it consists of the use, exclusively for the needs of a relevant ship, of a product or process in the body of such a ship or in its machinery, tackle, apparatus or other accessories, in a case where the ship has temporarily or accidentally entered the internal or territorial waters of Bangladesh;
- (e) it consists of the use of a product or process in the body or operation of a relevant aircraft, hovercraft or vehicle which has temporarily or accidentally entered or is crossing Bangladesh, including the air space above it and its territorial waters, or the use of accessories for such a relevant aircraft, hovercraft or vehicle;
- (f) it consists of the use of an exempted aircraft which has lawfully entered or is lawfully crossing Bangladesh as aforesaid or of the importation into Bangladesh, or the use or storage there, of any part or accessory for such an aircraft.

(5) For the purposes of sub-section (2) of this section, a person who does an act in relation to an invention which is prevented only by virtue of clause (a), (b) or (c) of sub-section (4) of this section from constituting an infringement of a patent for the invention shall not be treated as a person entitled to work the invention, but-

- (a) the reference in that sub-section to a person entitled to work an invention includes a reference to a person so entitled by virtue section 94 of this Act, and
- (b) a person who by virtue of sub-section (4) or sub-section (5) of section 62 or section 116 of this Act is entitled to do an act in relation to an invention without it constituting such infringement shall, so far as concerns that act, be treated as a person entitled to work the invention.

(6) In this section-

“relevant ship” and “relevant aircraft, hovercraft or vehicle” mean respectively a ship and an aircraft, hovercraft or vehicle registered in, or belonging to, any country, other than Bangladesh, which is a party to the Convention for the Protection of Industrial Property signed at Paris on 20th March, 1883; and

“exempted aircraft” means an aircraft exempted from seizure in respect of patent claims under any law for the time being in force.

107. Jurisdiction of court for suits in respect of infringement of patents, etc.-

(1) Every suit for a declaration under section 108 of this Act or for any relief under section 109 of this Act or for infringement of a patent shall be instituted and tried in the Court of the District Judge within the local limits of whose jurisdiction, at the time of the institution of the suit, the person instituting the suit or, where there are more than one such person, any of them actually and voluntarily resides or carries on business or personally works for gain:

Provided that where in a suit 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 Division for decision.

(2) The District Judge may transfer any suit instituted under sub-section (1) of this section to any Court of Additional Judge within the local limits of his jurisdiction for hearing and disposal.

(3) The Court of Additional Judge to whom a suit is transferred under sub-section (2) of this section shall exercise in respect of that suit the same powers as are exercisable by the Court of the District Judge under this Act.

108. Power of court to make declaration as to non-infringement.- (1) Notwithstanding anything contained in any other law for the time being in force, any person may institute a suit for a declaration that the use by him of any process, or the making, use or sale of any article by him does not, or would not, constitute an infringement of a claim of a patent against the patentee or the holder of an exclusive licence under the patent, notwithstanding that no assertion to the contrary has been made by the patentee or the licensee, if it is shown-

- (a) that the plaintiff has applied in writing to the patentee or exclusive licensee for a written acknowledgment to the effect of the declaration claimed and has furnished him with full particulars in writing of the process or article in question; and
- (b) that the patentee or licensee has refused or neglected to give such an acknowledgement.

(2) The costs of all parties in a suit for a declaration brought by virtue of this section shall, unless for special reasons the court thinks fit to order otherwise, be paid by the plaintiff.

(3) The validity of a claim of the specification of a patent shall not be called in question in a suit for a declaration brought by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid or invalid.

(4) A suit for a declaration may be brought by virtue of this section at any time after the date of advertisement of acceptance of the complete specification of a patent, and references in this section to the patentee shall be construed accordingly.

109. Power of court to grant relief in cases of groundless threat of infringement proceedings.-

(1) Where any person (whether entitled to or interested in a patent or an application for a patent or not) threatens any other person by circulars or advertisements or by communications, oral or in writing addressed to that or any other person, with proceedings for infringement of a patent, any person aggrieved thereby may bring a suit against him praying for the following reliefs, that is to say-

- (a) a declaration to the effect that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) such damages, if any, as he has sustained thereby.

(2) Unless in such suit the defendant proves that the acts in respect of which the proceedings were threatened constitute or, if done, would constitute, an infringement of a patent or of rights arising from the publication of a complete specification in respect of a claim of the specification not shown by the plaintiff to be invalid, the court may grant to the plaintiff all or any of the reliefs prayed for.

Explanation.- A mere notification of the existence of a patent does not constitute a threat of proceeding within the meaning of this section.

110. Power of court in a suit for infringement.- (1) The proprietor of a patent may bring a suit in the court in respect of any act alleged to infringe the patent and, without prejudice to any other jurisdiction of the court, may claim in such suit-

- (a) for an injunction restraining the defendant from any apprehended act of infringement;
- (b) for an order for the defendant to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised;
- (c) for damages in respect of the infringement;
- (d) for an account of the profits derived by the defendant from the infringement;
- (e) for a declaration that the patent is valid and has been infringed by the defendant.

(2) The court shall not, in respect of the same infringement, both award the proprietor of a patent damages and order that he shall be given an account of the profits.

111. Right of exclusive licensee to take proceedings against infringement.- (1) Subject to the provisions of this section, the holder of an exclusive licence under a patent shall have the same right as the patentee to institute a suit in respect of any infringement of the patent committed after the date of the licence; and references to patentee in the provisions of this Act relating to infringement shall be construed accordingly.

(2) In awarding damages or granting any other relief in any such suit, the court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such as a result of the infringement, or, as the case may be, the profits derived from the infringement so far as it constitutes an infringement of the rights of the exclusive licensee as such.

(3) In any suit instituted by the exclusive licensee under sub-section (1) of this section the patentee shall, unless he has joined as a plaintiff in the suit, be added as defendant:

Provided that a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

112. Right of licensee under section 84 (1) (a) of this Act.- Any person to whom a compulsory licence has been granted under clause (a) of sub-section (1) of section 84 of this Act shall be entitled to call upon the patentee to take proceedings to prevent any infringement of the patent, and, if the patentee refuses or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the

infringement in his own name as though he were the patentee, making the patentee a defendant:

Provided that a patentee so added shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

113. Restriction on recovery of damages for infringement.- (1) In a suit for infringement of a patent, damages shall not be awarded, and no order shall be made for an account of profits, against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the patent existed; and a person shall not be taken to have been so aware or to have had reasonable grounds for so supposing by reason only of the application to a product of the word “patent” or “patented”, or any word or words expressing or implying that a patent has been obtained for the product, unless the number of the patent accompanied the word or words in question.

(2) In any suit for infringement of a patent the court may, if it thinks fit, refuse to grant any damages or an account of profits in respect of any infringement committed during any further period specified in sub-section (3) of section 54 of this Act, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that sub-section.

(3) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, no damages or account of profits shall be granted in any proceeding for the infringement of the patent committed before the decision to allow the amendment unless the court is satisfied that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge.

114. Restriction on granting injunction in certain cases.- If in proceedings for infringement of a patent endorsed or deemed to be endorsed with the words, “licences of right” (otherwise than by the importation of the patented article from other countries) the infringing defendant is ready and willing to take a licence upon terms to be settled by the Controller under section 86 of this Act, no injunction shall be granted against him, and the amount, if any, recoverable against him by way of damages shall not exceed double the amount which would have been recoverable against him as licensee if such a licence had been granted before the earliest infringement.

115. Relief for infringement of partially valid patent.- (1) If the validity of a patent is put in issue in a proceeding for infringement of the patent and it is found that the patent is only partially valid, the court may, subject to sub-section (2) of this section, grant relief in respect of that part of the patent which is found to be valid and infringed.

(2) Where in any such proceeding it is found that the patent is only partially valid, the court shall not grant relief by way of damages, costs or expenses, except where the plaintiff proves that the specification for the patent was framed in good faith and with reasonable skill and knowledge, and in that event the court may grant relief in respect of that part of the patent which is valid and infringed, subject to the discretion of the court as to costs or expenses and as to the date from which damages should be reckoned.

(3) As a condition of relief under this section the court may direct that the specification of the patent shall be amended to its satisfaction upon an application made for that purpose under section 58 of this Act, and an application may be so made accordingly, whether or not all other issues in the proceeding have been determined.

116. Right to continue use begun before priority date.- (1) Where a patent is granted for an invention, a person who in Bangladesh before the priority date of the invention-

- (a) does in good faith an act which would constitute an infringement of the patent if it were in force, or
- (b) makes in good faith effective and serious preparations to do such an act,

has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the grant of the patent; but this right does not extend to granting a licence to another person to do the act.

(2) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by sub-section (1) of this section may-

- (a) authorise the doing of that act by any partners of his for the time being in that business, and
- (b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(3) Where a product is disposed of to another in exercise of the rights conferred by sub-section (1) or sub-section (2) of this Act, that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the registered patentee of the patent.

117. Certificate of contested validity of patent.- (1) If in any proceeding before the court or in any proceeding before the High Court Division for revocation of patent under section 64 of this Act, the validity of a patent to any extent is contested and that patent is found by the court or, as the case may be, by the High Court Division to be wholly or partially valid, the court or the High Court Division may certify that the validity of the patent was so contested and was upheld.

(2) Where a certificate is granted under sub-section (1) of this section, then, if in any subsequent suit before the court for infringement of the patent concerned or if in any subsequent proceeding before the High Court Division for revocation of the patent, a final order or judgment is made or given in favour of the party relying on the validity of the patent as found in the earlier proceeding, that party shall, unless the court or the High Court Division otherwise directs, be entitled to an order for the payment of his full costs, charges and expenses of, and incidental to, any such suit or proceeding properly incurred so far as they relate to the patent in respect of which the certificate was granted:

Provided that the costs as specified in this sub-section shall not be ordered when the party disputing the validity of the patent satisfies the court that he was not aware of the grant of the certificate when he raised the dispute and withdrew forthwith such defence when he became aware of such certificate.

(3) Nothing contained in this section shall be construed as authorising courts hearing appeals from decrees or orders in suits for infringement of patent or from petitions for revocation to pass orders for costs on the scale referred to therein.

118. Proceedings for infringement by co-owner.- (1) In applying section 106 of this Act to a patent in which there are two or more joint patentees the reference to the patentee shall be construed-

- (a) in relation to any act, as a reference to that patentee or those patentees who, by virtue of section 51 of this Act or any agreement referred to in that section, is or are entitled to that act without its amounting to an infringement; and
- (b) in relation to any consent, as a reference to that patentee or those patentees who, by virtue of section 58 of this Act or any agreement referred to in that section, is or are the proper person or persons to give consent.

(2) One of two or more joint patentees of a patent may without the concurrence of the others bring a proceeding in respect of an act alleged to infringe the patent, but shall not do so unless the others are made parties to the proceeding; but

any of the others made a defendant shall not be liable for any costs or expenses unless he enters appearance and takes part in the proceeding.

119. Scientific advisers.- (1) In any suit for infringement or in any proceeding before a court under this Act, the court may, at any time, and whether or not an application has been made by any party for that purpose, appoint an independent scientific adviser to assist the court or to inquire and report upon any such question of fact or of opinion (not involving a question of interpretation of law) as it may formulate for the purpose.

(2) The remuneration of the scientific adviser shall be fixed by the court and shall include the costs of making a report and a proper daily fee for any day on which the scientific adviser may be required to attend before the court, and such remuneration shall be paid by such parties in the proceeding as the court may direct.

CHAPTER XXII

APPEALS

120. Appeals.- (1) Save as otherwise expressly provided in this Act, an appeal shall lie to the High Court Division,-

- (a) from any decision, order, judgment or direction of the Court of District Judge or the Court of Additional Judge;
- (b) from any decision, order or direction of the Controller under any of the following provisions of this Act, that is to say-

section 17, section 18, section 19, section 20, section 21, section 22, section 27, section 29, section 30, section 52, section 55, section 58, section 61, section 63, sub-section (3) of section 69, section 78, section 82, section 83, section 84, section 85 and section 91 of this Act.

(2) No appeal shall lie from any decision, order or direction made or issued under the provisions of this Act by the Government or order of the Controller for the purposes of giving effect to any such decision, order or direction.

(3) Every appeal under sub-section (1) of this section shall be in writing and shall be made within three months from the date of the decision, order, judgment or direction of the court or, as the case may be, of the Controller, or within such further time as the High Court Division may in accordance with rules made by it allow.

121. Procedure for hearing appeals.- (1) Every appeal before the High Court Division under section 120 of this Act shall be in such form and shall contain such particulars as may be prescribed by rules made by the High Court Division.

(2) Every such appeal shall be heard by a Single Judge of the High Court Division:

Provided that the Chief Justice may, if he considers necessary, refer an appeal, at any stage of the proceeding, to a Bench of two or more Judges for hearing and disposal.

(3) Every such appeal shall be heard as expeditiously as possible and endeavour shall be made to decide the appeal within a period of twelve months from the date on which it is filed.

CHAPTER XXIII

PENALTIES

122. Contravention of secrecy provisions relating to certain inventions.- If any person fails to comply with any direction given under section 37 of this Act, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.

123. Falsification of entries in register, etc.- If any person makes, or causes to be made, a false entry in any register kept under this Act, or a writing purporting to be a copy of an entry in such a register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing knowing the writing or entry to be false, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.

124. Unauthorised claim of patent right.- If any person falsely represents that any article sold by him is patented in Bangladesh or is the subject of an application for a patent in Bangladesh, he shall be punishable with fine which may extend to five thousand taka.

Explanation: 1. – For the purposes of this section, a person shall be deemed to represent,-

- (a) that an article is patented in Bangladesh if there is stamped, engraved or impressed on, or otherwise applied to, the article the word “patent” or “patented” or some other word expressing or

implying that a patent for the article has been obtained in Bangladesh;

- (b) that an article is the subject of an application for a patent in Bangladesh, if there are stamped, engraved or impressed on, or otherwise applied to, the article the words “patent applied for”, “patent pending”, or some other words implying that an application for a patent for the article has been made in Bangladesh.

Explanation: 2.- The use of words “patent”, “patented”, “patent applied for”, “patent pending” or other words expressing or implying that an article is patented or that a patent has been applied for shall be deemed to refer to a patent in force in Bangladesh, or to a pending application for a patent in Bangladesh, as the case may be, unless there is an accompanying indication that the patent has been obtained or applied for in any country outside Bangladesh.

125. Wrongful use of words “patent office.”- If any person uses on his place of business or any document issued by him or otherwise the words “patent office” or any other words which would reasonably lead to the belief that his place of business is, or is officially connected with, the patent office, he shall be punishable with imprisonment for a term which may extend to one year, or with fine, or with both.

126. Refusal or failure to supply information.- (1) If any person refuses or fails to furnish-

- (a) to the Government any information which he is required to furnish under sub-section (5) of section 94;
- (b) to the Controller any information or statement which he is required to furnish by or under section 147 of this Act;

he shall be punishable with fine which may extend to two thousand taka.

(2) If any person, being required to furnish any such information as is referred to in sub-section (1) of this section, furnishes information or statement which is false, and which he either knows or has reason to believe to be false or does not believe to be true, he shall be punishable with imprisonment which may extend to six months, or with fine, or with both.

127. Practice by non-registered patent agents.- If any person contravenes the provisions of section 133 of this Act, he shall be punishable with fine which may extend to one thousand taka in case of first offence and five thousand taka in the case of a second or subsequent offence.

128. Offences by companies.- (1) If the person committing an offence under this Act is a company, the company as well as every person in charge of, and responsible to, the company for the conduct of its business at the time of the commission of the offence shall be deemed to be guilty of the offence and shall be liable to be proceeded against and punished accordingly:

Provided that nothing contained in this sub-section shall render any such person liable to any punishment if he proves that the offence was committed without his knowledge or that he exercised due diligence to prevent the commission of the offence.

(2) Notwithstanding anything contained in sub-section (1) of this section, where an offence under this Act has been committed by a company and it is proved that the offence has been committed with the consent or connivance of or that the commission of the offence is attributable to any neglect on the part of any director, manager, secretary or other officer of the company, such director, manager, secretary or other officer shall also be deemed to be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

Explanation :- For the purposes of this section-

- (a) “company” means any body corporate and includes a firm or other association of individuals; and
- (b) “director”, in relation to a firm, means a partner in the firm.

Sections 69 and 70 of the present Act make provisions for agency at the patent office. These existing provisions are insufficient and do not define the qualifications, rights, duties and liabilities, etc. of agents elaborately. We propose the provisions regarding agents as follows:-

CHAPTER XXIV

PATENT AGENTS

129. Register of patent agents.- The Controller shall maintain a register to be called the register of patent agents in which shall be entered the names and

addresses of all persons qualified to have their names so entered under section 130 of this Act.

130. Qualifications for registration as patent agents.- (1) A person shall be qualified to have his name entered in the register of patent agents if he fulfils the following conditions, namely:-

- (a) he is a citizen of Bangladesh;
- (b) he has completed the age of 21 years;
- (c) he is a graduate from a recognised university of Bangladesh or possesses equivalent qualifications from any other institution outside of Bangladesh;
- (d) he has passed the qualifying examination as may be prescribed by rules.

(2) Notwithstanding anything contained in sub-section (1) of this section, a person who has been practising as a patent agent on the date of coming into force of this Act and has filed not less than five complete specifications shall, on payment of the prescribed fee, be qualified to have his name entered in the register of patent agents.

131. Rights of patent agents.- Subject to the provisions contained in this Act and any rules made thereunder, every patent agent whose name is entered in the register of patent agents shall be entitled-

- (a) to practise before the Controller; and
- (b) to prepare all documents, transact all business and discharge such other functions as may be prescribed in connection with any proceeding before the Controller under this Act.

132. Subscription and verification of certain documents by patent agents.- (1) Subject to the provisions contained in sub-section (2) of this section and to any rules made under this Act, all applications and communications to the Controller under this Act may be signed by a patent agent authorised in writing in this behalf by the person concerned.

(2) The following documents, namely,-

- (i) applications for patents;
- (ii) applications for restoration of lapsed patents;

- (iii) applications for the sealing of patents after the time allowed for that purpose by or under sub-section (2), or sub-section (3) of section 51 of this Act has expired;
- (iv) applications for leave to amend;
- (v) applications for compulsory licences or for revocation; and
- (vi) notices of surrender of patents;

shall be signed and verified in the manner prescribed by the person making such applications or giving such notices:

Provided that if such person is absent from Bangladesh, they may be signed and verified on his behalf by a patent agent authorised by him in writing in that behalf.

133. Restrictions on practice as patent agents.- (1) No person, either alone or in partnership with any other person, shall practise, describe or hold himself out as a patent agent, or permit himself to be so described or held out, unless he is registered as a patent agent or, as the case may be, unless he and all his partners are so registered.

(2) No company or other body corporate shall practise, describe itself or hold itself out as patent agents or permit itself to be so described or held out.

Explanation.- For the purposes of this section, practice as a patent agent includes any of the following acts, namely:-

- (a) applying for or obtaining patents in Bangladesh or elsewhere;
- (b) preparing specifications or other documents for the purposes of this Act or of the patent law of any other country.
- (c) giving advice other than of a scientific or technical nature as to the validity of patents or their infringement.

134. Removal from the register of patent agents and restoration.- (1) The Government may remove the name of any person from the register of patent agents when it is satisfied, after giving that person a reasonable opportunity of being heard and after such further inquiry, if any, as it thinks fit to make-

- (i) that his name has been entered in the register of patent agents by error or on account of misrepresentation or suppression of material fact;

- (ii) that he has been convicted of any offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity which, in the opinion of the Government, renders him unfit to be kept in the register of patent agents.

(2) The Government may, on application and on sufficient cause being shown, restore to the register of patent agents the name of any person removed therefrom.

135. Power of Controller to refuse to deal with certain agents.- (1) Subject to any rules made in this behalf, the Controller may refuse to recognise as agent in respect of any business under this Act –

- (a) any individual whose name has been removed from, and not restored to, the register of patents;
- (b) any person who has been convicted of an offence under section 134 of this Act;
- (c) any person, not being registered as a patent agent, who, in the opinion of the Controller, is engaged wholly or mainly in acting as agent in applying for patents in Bangladesh or elsewhere in the name or for the benefit of the person by whom he is employed;
- (d) any company or firm, if any person whom the Controller could refuse to recognise as agent in respect of any business under this Act, is acting as a director or manager of the company or is a partner in the firm.

(2) The Controller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in Bangladesh.

136. Savings in respect of other persons authorised to act as agents.- Nothing in this Chapter shall be deemed to prohibit-

- (a) the applicant for a patent or any person, not being a patent agent, who is duly authorised by the applicant from drafting any specification or appearing or acting before the Controller; or
- (b) an advocate, not being a patent agent, from taking part in any proceedings under this Act otherwise than by way of drafting any specification.

CHAPTER XXV

INTERNATIONAL AGREEMENTS

137. Notification as to convention countries.- (1) With a view to fulfilment of a treaty, convention or arrangement and without prejudiced the principle of national treatment under the TRIPS Agreement all the members of the World Trade Organisation shall be treated as convention countries.

138. Convention applications.- (1) Without prejudice to the provisions contained in section 8 of this Act, where a person has made an application for a patent in respect of an invention in a convention country (hereinafter referred to as the “basic application”), and that person or the legal representative or the assignee of that person makes an application under this Act for a patent within twelve months after the date on which the basic application was made, the priority date of a claim of the complete specification, being a claim based on matter disclosed in the basic application, is the date of making of the basic application.

Explanation.- Where applications have been made for similar protection in respect of an invention in two or more convention countries, the period of twelve months referred to in this sub-section shall be reckoned from the date on which the earlier or earliest of the said applications was made.

(2) Where applications for protection have been made in one or more convention countries in respect of two or more inventions which are cognate or of which one is a modification of another, a single convention application may, subject to the provisions contained in section 11 of this Act, be made in respect of those inventions at any time within twelve months from the date of the earliest of the said applications for protection:

Provided that the fee payable on the making of any such application shall be the same as if separate applications have been made in respect of each of the said inventions, and the requirements of clause (b) of sub-section (1) of section 140 of this Act shall, in the case of any such application, apply separately to the applications for protection in respect of each of the said inventions.

139. Special provisions relating to convention applications.- (1) Every convention application shall-

- (a) be accompanied by a complete specification; and

- (b) specify the date on which and the convention country in which the application for protection, or as the case may be, the first of such applications was made; and
- (c) state that no application for protection in respect of the invention had been made in a convention country before that date by the applicant or by any person from whom he derives title.

(2) Subject to the provisions contained in section 11 of this Act, a complete specification filed with a convention application may include claims in respect of developments of, or additions to, the invention in respect of which the application for protection was made in a convention country, being developments or additions in respect of which the applicant would be entitled under the provisions of section 8 of this Act to make a separate application for a patent.

(3) A convention application shall not be post-dated under sub-section (1) of section 19 of this Act to a date later than the date on which under the provisions of this Act the application could have been made.

140. Multiple priorities.- (1) Where two or more applications for patents in respect of inventions have been made in one or more convention countries and those inventions are so related as to constitute one invention, one application may be made by any or all of the persons referred to in sub-section (1) of section 138 of this Act within twelve months from the date on which the earlier or the earliest of those applications was made, in respect of the inventions disclosed in the specifications which accompanied the basic applications.

(2) The priority date of a claim of the complete specification, being a claim based on matters disclosed in one or more of the basic applications, is the date on which that matter was first so disclosed.

(3) For the purposes of this Act, a matter shall be deemed to have been disclosed in a basic application for protection in a convention country if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgement of a prior act) in that application, or any documents submitted by the applicant for protection in support of and at the same time as that application, but no account shall be taken of any disclosure effected by any such document unless a copy of the document is filed at the patent office with the convention application or within such period as may be prescribed after the filing of that application.

141. Supplementary provisions as to convention applications.- (1) Where a convention application is made in accordance with the provisions of this Chapter, the applicant shall furnish, in addition to the complete specification, copies of the specifications or corresponding documents filed or deposited by the applicant in the patent office of the convention country in which the basic application was made, certified by the official chief or head of the patent office of the convention country, or otherwise verified to the satisfaction of the Controller, along with the application or within three months thereafter, or within such further period as the Controller may on good cause allow.

(2) If any such specification or other document is in a foreign language, a translation into either English or Bangla of the specification or document, verified by affidavit or otherwise to the satisfaction of the Controller, shall be annexed to the specification or document.

(3) For the purposes of this Act, the date on which an application was made in a convention country is such date as the Controller is satisfied, by certificate of the official chief or head of the patent office of the convention country or otherwise, is the date on which the application was made in that convention country.

142. Other provisions of Act to apply to convention applications.- Save as otherwise provided in this Chapter, all the provisions of this Act shall apply in relation to a convention application and a patent granted in pursuance thereof as they apply in relation to an ordinary application and a patent granted in pursuance thereof.

We propose to provide for miscellaneous matters, such as, fees, service of notices, costs, etc. in this Chapter which may run as follows:-

CHAPTER XXVI

MISCELLANEOUS

143. Fees.- (1) There shall be paid in respect of the grant of patents and applications therefor, and in respect of other matters in relation to the grant of patents under this Act, such fees as may be prescribed by the Government.

(2) Where a fee is payable in respect of the doing of an act by the Controller, the Controller shall not do that act until the fee has been paid.

(3) Where a fee is payable in respect of the filing of a document at the patent office, the document shall be deemed not to have been filed at that office until the fee has been paid.

(4) Where a principal patent is granted later than two years from the date of filing of the complete specification, the fees which have become due in the meantime may be paid within a period of three months from the date of the recording of the patent in the register.

144. Restrictions upon publication of specifications.- Subject to the provisions of Chapter VIII of this Act, an application for a patent, and any specification filed in pursuance thereof, shall not, except with consent of the applicant, be published by the Controller or be open to public inspection at any time before the date of advertisement of acceptance of the complete specification in pursuance of section 25 of this Act.

145. Reports of examiners to be confidential.- The reports of examiners to the Controller under this Act shall not be open to public inspection or be published by the Controller; and such reports shall not be liable to production or inspection in any legal proceeding unless the court certifies that the production or inspection is desirable in the interest of justice, and ought to be allowed.

146. Publication of patented invention.- The Controller shall issue periodically a publication of patented inventions containing such information as the Government may direct.

147. Power of Controller to call for information from patentees.- (1) The Controller may, at any time during the continuance of the patent, by notice in writing, require a patentee or a licensee, exclusive or otherwise, to furnish to him within two months from the date of such notice or within such further time as the Controller may allow, such information or such periodical statements as to the extent to which the patented invention has been commercially worked in Bangladesh as may be specified in the notice.

(2) Without prejudice to the provisions of sub-section (1) of this section, every patentee and every licensee (whether exclusive or otherwise) shall furnish in such manner and form and at such intervals (not being less than six months) as may be prescribed statement as to the extent to which the patented invention has been worked on a commercial scale in Bangladesh.

(3) The Controller may publish the information received by him under sub-section (1) or sub-section (2) of this section in such manner as may be prescribed.

148. Transmission of orders of courts to Controller.- (1) Every order of the High Court Division on a petition for revocation, including orders granting certificates of validity of any claim, shall be transmitted by the High Court Division to the Controller who shall cause an entry thereof and reference thereto to be made in the register.

(2) Where in any suit for infringement of a patent or in any suit under section 109 of this Act the validity of any claim or a specification is contested and that claim is found by the court to be valid or not valid, as the case may be, the court shall transmit a copy of its judgement and decree to the Controller who shall on receipt thereof cause an entry in relation to such proceeding to be made in the prescribed manner in a supplemental record.

(3) The provision of sub-sections (1) and (2) of this section shall also apply to the court to which appeals are preferred against decisions of the courts referred to in those sub-sections.

149. Transmission of copies of specifications, etc., and inspection thereof.- 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 Government may appoint in this behalf, and shall be open to the inspection of any person at all reasonable times at places to be specified by those authorities with the approval of the Government.

150. Information relating to patent.- A person making a request to the Controller in the prescribed manner for information relating to any such matters as may be prescribed as respects any patent specified in the request or as respects any application for a patent so specified shall be entitled, subject to the payment of the prescribed fee, to have information supplied to him accordingly.

151. Loss or destruction of patents.- If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Controller, the Controller may at any time, on application made in the prescribed manner and on the payment of the prescribed fee, cause a duplicate thereof to be sealed and delivered to the applicant.

152. Patent to bind Government.- Subject to the other provisions contained in this Act, a patent shall have to all intents the like effect as against the Government as it has against any person.

153. Right of Government to sell or use forfeited article.- Nothing in this Act shall affect the power of the Government or of any person deriving title directly or indirectly from the Government to sell or use any articles forfeited to the Government under any law for the time being in force.

PART II
DESIGNS
CHAPTER XXVII
REGISTRATION OF DESIGNS

154. Application for registration of designs.- (1) The Controller may, on the application of any person claiming to be the proprietor of any new or original design not previously published in Bangladesh, register the design under this part.

(2) The application under sub-section (1) of this section must be made in the prescribed form and must be left at the Patent Office in the prescribed manner and must be accompanied by the prescribed fee.

(3) The same design may be registered in more than one class, and, in case of doubt as to the class in which a design ought to be registered, the Controller shall decide the question.

(4) The Controller may, if for any reasons to be recorded in writing he thinks fit, refuse to register any design presented to him for registration.

(5) An appeal shall lie to the High Court Division from any order of refusal under sub-section (4) of this section.

(6) An application which, on account of any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within the prescribed time shall be deemed to be abandoned.

(7) A design when registered shall be registered as of the date of the application for registration.

155. Registration of designs in new classes.- Where a design has been registered in one or more classes of goods, the application of the proprietor of

the design to register it in some one or more other classes shall not be refused, nor shall the registration thereof be invalidated-

- (a) on the ground of the design not being a new or original design, by reason only that it was so previously registered; or
- (b) on the ground of the design having been previously published in Bangladesh, by reason only that it has been applied to goods of any class in which it was so previously registered:

Provided that such subsequent registration shall not extend the period of copyright in the design beyond that arising from previous registration.

156. Certificate of registration.- (1) The Controller shall grant a certificate of registration to the proprietor of the design when registered.

(2) The Controller may, in case of loss or destruction of the original certificate, or in any other case in which he deems it expedient, furnish one or more copies of the certificate on payment of the prescribed fees for such copies.

157. Register of Designs.- (1) There shall be kept at the Patent Office a book called the Register of Designs, wherein shall be entered the names and addresses of the proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may be prescribed.

(2) The Register of Designs existing on the date of commencement of this Act shall be incorporated with and form part of the Register of Designs under this Act.

(3) The Register of Designs shall be prima facie evidence of any matters by this Act directed or authorised to be entered therein.

CHAPTER XXVIII

COPYRIGHT IN REGISTERED DESIGNS

158. Copyright on registration.- (1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during twenty years from the date of registration of the design.

159. Requirements before delivery on sale.- (1) Before delivery on sale of any articles to which a registered design has been applied, the proprietor shall-

- (a) (if exact representations or specimens were not furnished on the application for registration), furnish to the Controller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the Controller may erase his name from the register, and thereupon the copyright in the design shall cease; and
- (b) cause each such article to be marked with the prescribed mark, or with the prescribed words or figures, denoting that the design is registered; and, if he fails to do so, the proprietor shall not be entitled to recover any penalty or damages in respect of any infringement of his copyright in the design unless he shows that he took all proper steps to ensure the marking of the article, or unless he shows that the infringement took place after the person guilty thereof knew or had received notice of the existence of the copyright in the design.

(2) Where a representation is made to the Government by or on behalf of any trade or industry that in the interests of the trade or industry it is expedient to dispense with or modify as regards any class or description of articles any of the requirements of this section as to marking, the Government may, if it thinks fit, by rules under this Act, dispense with or modify such requirements as regards any such class or description of articles to such extent and subject to such conditions as it thinks fit.

160. Effect of disclosure on copyright.- The disclosure of a design by the proprietor to any other person, in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person other than the proprietor of the design, and the acceptance of a first and confidential order for

goods bearing a new or original textile design intended for registration, shall not be deemed to be a publication of the design sufficient to invalidate the copyright thereof if registration thereof is obtained subsequently to the disclosure or acceptance.

161. Inspection of registered designs.- (1) During the existence of copyright in a design, or such shorter period as may be prescribed, the design shall not be open to inspection except by the proprietor or a person authorised by the Controller or by the Court, and furnishing such information as may enable the Controller to identify the design, and shall not be open to the inspection of any person except in the presence of the Controller, or of an officer acting under him, and on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof:

Provided that, where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.

(2) After the expiration of the copyright in a design, or such shorter period as aforesaid, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

(3) Different periods may be prescribed under this section for different classes of goods.

162. Information as to existence of copyright.- On the request of any person furnishing such information as may enable the Controller to identify the design, and on payment of the prescribed fee, the Controller shall inform such person whether the registration still exists in respect of the design, and, if so, in respect of what classes of goods, and shall state the date of registration, and the name and address of the registered proprietor.

163. Cancellation of registration.- (1) Any person interested may present a petition for the cancellation of the registration of a design-

(a) at any time after the registration of a design, to the High Court Division on any of the following grounds, namely:-

(i) that the design has been previously registered in Bangladesh; or

- (ii) that it has been published in Bangladesh prior to the date of registration; or
 - (iii) that the design is not a new or original design; or
- (b) within one year from the date of the registration, to the Controller on either of the grounds specified in sub-clauses (i) and (ii) of clause (a).

(2) An appeal shall lie from any order of the Controller under this section to the High Court Division.

(3) The Controller may, at any time, refer any petition filed under subsection (2) of this section to the High Court Division after recording the reasons for such reference, and the High Court Division shall decide any petition so referred.

164. Designs to bind Government.- (1) A registered design shall have to all intents the like effect as against the Government as it has against any person and the provisions of Chapter XVIII of Part I of this Act shall apply to registered designs as they apply to patents.

165. Provisions as to exhibition.- 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 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 the 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:

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.

In the next chapter, we propose to make provisions for legal proceedings for piracy of registered designs, etc. It should be noted that unlike the law of

copyright in artistic, literary or musical works, copyright does not subsist in design unless it is registered. In this chapter, we propose first to lay down what acts are prohibited during subsistence of copyright in a design and then we propose to lay down the penalties for commission of those acts. We, accordingly, propose the next chapter as follows:-

CHAPTER XXIX

LEGAL PROCEEDINGS

166. Piracy of registered design.- (1) During the existence of copyright in any design it shall not be lawful for any person-

- (a) for the purposes of sale, to apply or cause to be applied to any article in any class of goods in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or
- (b) 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 any obvious imitation thereof; or
- (c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of goods in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.

(2) If any person acts in contravention of this section, he shall be liable for every contravention-

- (a) to pay to the registered proprietor of the design a sum not exceeding five thousand taka recoverable as a debt, or
- (b) if the proprietor elects to bring a suit for recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly:

Provided that the total sum recoverable in respect of any one design under clause (a) of this sub-section shall not exceed ten thousand taka.

(3) When the court makes a decree in a suit under sub-section (2) of this section, it shall send a copy of the decree to the Controller, who shall cause an entry thereof to be made in the Register of Designs.

167. The provisions of Part I of this Act with regard to certificates of the validity of a patent, and to the remedy in case of groundless threats of legal proceedings by a patentee shall apply in the case of registered designs in like manner as they apply in the case of patents, with the substitution of references to the copyright in a design for references to a patent, and of references to the proprietor of a design for references to the patentee, and of references to the designs for references to the invention.

In the next chapter, we propose to deal with fees, provisions relating to registers, documents, etc., Controller's powers in respect of designs, evidence, agency, etc. under the heading "Miscellaneous". So, this chapter may be as follows-

CHAPTER XXX

FEES, REGISTERS, DOCUMENTS, ETC., POWERS

AND DUTIES OF CONTROLLER

168. Fees, etc.- (1) There shall be paid in respect of the registration of designs and applications therefor and in respect of other matters relating to designs under this Act such fees as may be prescribed by the Government.

(2) A proceeding in respect of which a fee is payable under this Part or rules made under this Act shall be of no effect unless the fee has been paid.

169. Notice of trust not be entered in registers.- There shall not be entered in any register kept under this Act, or be receivable by the Controller, any notice of any trust, expressed, implied or constructive.

170. Inspection of and extracts from registers.- Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act; and certified copies sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fees.

171. Privilege of reports of Controller.- Reports of or to the Controller made under this Part shall not in any case be published or be open to public inspection.

172. Prohibition of publication of drawings, designs, etc., where application for design abandoned, refused, etc.- Where an application for a design has been abandoned or refused, the application and any drawings, photographs, tracings, representations or specimens left in connection with the application shall not at any time be open to public inspection or be published by the Controller.

173. Power of Controller to correct clerical errors.- The Controller may, on request in writing accompanied by the prescribed fee, or of his own motion, correct any clerical error in the representation of a design or in the name or address of the proprietor of any design or in any other manner which is entered upon the Register of Designs.

174. Entry of assignments and transmissions in registers.- (1) Where a person becomes entitled by assignment, transmission or other operation of law to the copyright in a registered design, he may make an application to the Controller to register his title, and the Controller shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of such design, and shall cause an entry to be made in the prescribed manner in the Register of Designs of the assignment, transmission or other instrument affecting the title.

(2) Where any person becomes entitled as mortgagee, licensee or otherwise to any interest in a registered design, he may make an application to the Controller to register his title, and the Controller shall, on receipt of such application and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the Register of Designs, with particulars of the instruments, if any, creating such interest.

(3) The person registered as the proprietor of a design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licence as to, or otherwise deal with, the design and to give effectual licences as to, or otherwise deal with, the design and to give effectual receipts for any consideration for any such assignment, licence or dealing:

Provided that any equities in respect of the design may be enforced in like manner as in respect of any other movable property.

(4) Except in the case of an application made under section 175 of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of sub-sections (1) and (2) of this section shall not be admitted in evidence in any court in proof of the title to copyright in a design or to any interest therein, unless the court, for reasons to be recorded in writing, otherwise directs.

175. Rectification of register.- (1) The Controller may, on the application of any person aggrieved by the non-insertion in, or omission from, the Register of Designs of any entry, or by any entry made in such register without sufficient cause, or by any entry wrongly remaining on such register, or by an error or defect in any entry in such register, make such order for making, expunging or varying such entry as he thinks fit and rectify the register accordingly.

(2) The Controller may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of a register.

(3) An appeal shall lie to the High Court Division from any order of the Controller under this section.

(4) Any order of the High Court Division rectifying a register shall direct that notice of such rectification be served on the Controller in the prescribed manner and the Controller shall, upon receipt of such notice, rectify the register accordingly.

(5) Nothing in the section shall be deemed to empower the Controller to make any such order cancelling the registration of a design as is provided in section 163 of this Act.

176. Powers of Controller in proceedings under this Part.- **(1) Subject to any rules made in this behalf, the Controller in any proceedings before him under this Part shall have the powers of a civil court for the purpose of receiving evidence, administering oaths, enforcing the attendance of witnesses, compelling the discovery and production of documents issuing commissions for examination of witnesses and awarding costs.**

(2) Ανψη αωαρδ οφ χοστς μαδε βψ τηε Χοντρολλερ υνδερ τηισ Παρτ σηαλλ βε εξεχυταβλε ιν ανψη χιπιλ χουρτ ηαπιινγ φυρισδιχιτιον ασ ιφ ιτ ωερε α δεχρεε οφ τηατ χουρτ.

177. Exercise of discretionary power by Controller.- Where any discretionary power is by or under this Part given to the Controller, he shall not

exercise that power adversely to the applicant for registration of a design without giving the applicant an opportunity of being heard.

178. Power of Controller to take directions from Government.- The Controller may, in any case of doubt or difficulty arising in the administration or any of the provisions of this Part, apply to the Government for directions in the matter.

179. Refusal to register design in certain cases.- (1) The Controller may refuse to register a design if, in his opinion, the use of the design be contrary to law or morality or is obscene.

(2) An appeal shall lie to the High Court Division from an order of the Controller under sub-section (1) of this section.

180. Limitation for appeals.- (1) Where an appeal lies to the High Court Division from an order made by the Controller under this Part, such appeal shall be made within three months from the date of the order passed by the Controller.

(2) In calculating the period of three months under sub-section (1) of this section, the time required for granting a copy of the order appealed against shall be excluded.

181. Form of appeal.- (1) Every appeal under this Part shall be in writing and in such form as may be prescribed.

(2) Every appeal under this Part shall be accompanied by such fees as may be prescribed.

182. Evidence before Controller.- In any proceeding under this Part before the Controller, the evidence may be given by affidavit and in any case in which the Controller thinks it right so to do he may take 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.

183. Agency.- (1) All applications and communications to the Controller under this Part may be signed by, and all attendances upon the Controller may be made by or through a legal practitioner or by or through an agent authorised to the satisfaction of the Controller.

(2) The Controller may, if he sees fit, require-

- (a) any such agent to be resident in Bangladesh;
- (b) any person not residing in Bangladesh to employ an agent residing in Bangladesh;

- (c) the personal signature or presence of any applicant or other person.

184. Reciprocal arrangement with other countries.- (1) Where it is made to appear to the Government that the legislature of any country has made satisfactory provisions for the protection of designs registered in Bangladesh, the Government may, by notification in the Official Gazette, direct that the provisions of this section, with such variations or additions, if any, as may be set out in such notification, shall apply for the protection of designs in that country.

(2) Any person who has applied for protection for any design in a country mentioned in sub-section (1) of this section or his legal representative or assignee shall, either alone or jointly with any other person, be entitled to claim that the registration of the said design under this Act shall be in priority to other applicants and shall have the same date as the date of the application in that country:

Provided that-

- (a) the application is made within six months from the application for protection in the country mentioned in sub-section (1) of this section; and
- (b) nothing in this section shall entitle the proprietor of the design to recover damages for infringements happening prior to the actual date on which the design is registered in Bangladesh.

(3) The registration of a design shall not be invalidated by reason only of the exhibition or use of, or the publication of a description or representation of, the design in Bangladesh during the period specified in this section as that within which the application may be made.

(4) The application for the registration of a design under this section shall be made in the same manner as an ordinary application under this Part.

In the next part, we propose to suggest some provisions which shall be common to both patents and designs, such as evidence of entries, documents, declarable infant, lunatic etc., reports of the Controller, power of the Supreme Court to make rules, power of the Government to make rules, repeal, savings, etc. So, the following provisions may be as follows:-

PART III

GENERAL

185. Evidence of entries, documents, etc.- (1) A certificate purporting to be signed by the Controller as to any entry, matter or thing which he is authorised by this Act or any rules made thereunder to make or do, shall be prima facie evidence of the entry having been made and of the contents thereof and of the matter or thing having been done or omitted to be done.

(2) A copy of any entry in any register or of any document kept in the patent office or of any patent or design, or an extract from any such register or document, purporting to be certified by the Controller and sealed with the seal of the patent office shall be admitted in evidence in all courts, and in all proceedings, without further proof or production of the original.

(3) The Controller or any other officer of the patent office shall not, in any legal proceedings to which he is not a party, be compellable to produce the register or any other document in his custody, the contents of which can be proved by the production of a certified copy issued under this Act or to appear as a witness to prove the matters therein recorded unless by order of the court made for special causes.

186. Declaration by infant, lunatic, etc.- (1) If any person is, by reason of minority, lunacy or other disability incapable of making any statement or doing anything required or permitted by or under this Act, the lawful guardian, committee or manager (if any) of the person subject to the disability, or if there be none, any person appointed by any court possessing jurisdiction in respect of his property, may make such statement or a statement as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the statement or the doing of the thing.

187. Service of notices, etc., by post.- Any notice required or authorised to be given by or under this Act, and any application or other document so authorised or required to be made or filed, may be given, made or filed by post.

188. Security for costs.- If any party by whom notice of any opposition is given under this Act or by whom application is made to the Controller for the grant of a licence under a patent or a design neither resides nor carries on

business in Bangladesh, the Controller may require him to give security for the costs of the proceedings, and in default of such security being given may treat the opposition or application as abandoned.

189. Reports of Controller to be placed before Parliament.- The Government shall cause to be placed before Parliament once a year a report respecting the execution of this Act by or under the Controller.

190. Power of Supreme Court to make rules.- The Supreme Court may make rules consistent with this Act as to the conduct and procedure in respect of all proceedings before it under this Act.

191. Power of Government to make rules.- (1) The Government may, by notification in the Official Gazette, make rules for carrying out the purposes of this Act.

(2) Without prejudice to the generality of the foregoing power, the Government may make rules to provide for all or any of the following matters, namely:

- (i) the form and manner in which any application for a patent any specifications or drawing and any other application or document may be filed at the patent office;
- (ii) time within which any act or thing may be done under this Act, including the manner in which and the time within which any matter may be advertised under this Act;
- (iii) the fees which may be payable under this Act and the manner of payment of such fees;
- (iv) the matters in respect of which the examiner may make a report to the Controller;
- (v) the form of request for the sealing of a patent;
- (vi) the form and manner in which and the time within which any notice may be given under this Act;
- (vii) the provisions which may be inserted in an order for restoration of a patent for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had ceased;
- (viii) the establishment of branch offices of the patent office and the regulation generally of the business of the patent office, including its branch offices;

- (ix) the maintenance of the Register of Patents and the matters to be entered therein;
- (x) the time when and the manner in which the registers and any other document open to inspection may be inspected under this Act;
- (xi) the matters in respect of which the Controller shall have powers of a civil court;
- (xii) the qualifications of, and the preparation of a roll of, scientific advisers for the purpose of section 126 of this Act;
- (xiii) the manner in which any compensation for acquisition by the Government of an invention may be paid;
- (xiv) the manner in which the register of patent agents may be maintained;
- (xv) the conduct of qualifying examinations for patent agents and the matters connected with their practice and conduct, including the taking of disciplinary proceedings against patent agents for misconduct;
- (xvi) the regulation of the making, printing, publishing and selling of indexes to, and abridgments of, specifications and other documents in the patent office; and the inspection of indexes and abridgments and other documents;
- (xvii) the form and manner in which any application for a design may be made;
- (xviii) for regulating the practice of registration of designs under this Part;
- (xix) for classifying goods for the purposes of designs;
- (xx) for making or requiring duplicates of drawings and other documents;
- (xxi) for securing and regulating the publishing and selling of copies, at such prices and in such manner as the Government thinks fit, of drawings and other documents;
- (xxii) providing for the inspection of documents in the Patent Office and for the manner in which they may be published;

(xxiii) the maintenance of Register of Designs and the matters to be entered therein;

(xxiv) generally for regulating the business of the Patent Office relating to designs, the conduct of proceedings before the Controller under Part II, and all things by this Part placed under the direction or control of the Controller or of the Government; and

(xxv) any other matter which may be prescribed.

192. Repeals and savings.- (1) The Patents and Designs Act, 1911 (Act 2 of 1911) is hereby repealed.

(2) Notwithstanding the repeal of the Patents and Designs Act, 1911 (Act 2 of 1911)-

(a) the provisions of section 21A of that Act and of any rules made thereunder shall continue to apply in relation to any patent granted before the commencement of this Act in pursuance of that section, and

(b) the renewal fee in respect of a patent granted under that Act shall be as fixed thereunder.

(3) Save as otherwise provided in sub-section (2) of this section, the provisions of this Act shall apply to any application for a patent pending at the commencement of this Act and to any proceedings consequent thereon and to any patent granted in pursuance thereof.

(4) The General Clauses Act, 1897 (Act 10 of 1897) shall apply with respect to repeals notwithstanding the mention of particulars in this section.

(5) Notwithstanding anything contained in this Act, any suit or legal proceeding under the Patents and Designs Act, 1911 (Act 2 of 1911) pending in any court or authority at the commencement of this Act, may be continued and disposed of, as if this Act had not been passed.

Justice A.K.M. Sadeque
Member

Justice A.T.M. Afzal
Chairman