

Question Q228

National Group: India
Title: **Prior User Rights**
Contributor: Hari Subramaniam
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I. **Analysis of current law and case law**

1. Yes. In fact, the Indian law goes far beyond the rights of the prior user. Under the Indian law prior public use or knowledge in India before the priority date of the application actually renders the patent application or any patent invalid. Thus, if a prior public use of an invention had taken place before the priority date of the Indian patent, the Indian Patent may be invalidated on this ground alone.
2. Once there is a prior user, the invention is deemed to have passed into the public domain. Therefore, a prior user is more likely to invalidate the patent than negotiate with the patentee. At the most, the prior user may agree not to press for invalidation if the patentee agrees to not to file a suit for infringement.
3. Any person in India has a right to use a technology which is in the public domain. Therefore, in a suit for infringement, the Court will consider the following-
 - i) whether the accused product or process is covered by any valid claim of the Patent.
 - ii) whether the prior use disclosed sufficient information to destroy the novelty or render obvious any claim of the patent. If the prior use provided sufficient information to anticipate or render obvious the invention covered by the patent the patent may be invalidated. In fact prior use is a ground for refusal of application in a pre-grant opposition, cancellation of patent in a post-grant opposition before the Patent Office, revocation of the patent before the Intellectual Property Appellate Board and revocation of the patent before the High Court in a counter claim in infringement proceedings. In order to succeed in such invalidation, the prior use must be actual commercial use, *i.e.*, it must have been reduced to practice.
4. Prior use in India before the priority date will destroy the novelty of the invention. If the prior use commenced after the priority date but before the filing date in India, it will not affect the novelty.

5. No, the prior use must have taken place in India. A mere prior use outside India without publication in a document will not affect the novelty of the invention in India.
6. Yes. If the prior user had obtained the invention from the inventor and had published and used it without the consent of the inventor then such prior use will not affect the novelty provided the inventor is able to establish that either the prior user stole the invention from him or that the prior user was under a specific obligation not to use the invention.
7. Yes.
8. The question of prior use within India is relevant purely for the purposes of assessing the novelty of the invention. The prior user will have a clear right to continue to use whatever he or any member of public had used in India before the priority date of the application. By the same token, the novelty of the invention will be destroyed to the extent the prior use anticipated the invention. If any residual novelty of the invention is still left on which the patentee can claim a valid patent then the patentee will have a right to prevent any person including the prior user from using any embodiment that survives as a novel and non obvious invention in any of its valid claims.
9. No, a single instance of a prior use in public is sufficient to destroy the novelty of the invention.
10. A prior user does not have a private right. On the contrary, it has the effect of destroying the monopoly right of the inventor or the patentee. Thus, once the patentee or the applicant for patent loses the right, not only the prior user but the entire public has the right to use the invention.
11. There are no exceptions. Please also refer to the answer to question 10.
12. No
13. As stated previously, prior use of an invention in India before the priority date of patent or the patent application destroys the novelty. Once any third party, not only the prior user, establishes that that prior use of the invention has taken place in India, it is sufficient to destroy the novelty of the invention. Therefore, there is no further requirement placed either on the prior user or any public once prior use by any person has taken place in India.

II. Policy considerations and proposals for improvements to your current system-

14. In my opinion, yes. If publication in any document anywhere in the world in any language can destroy the novelty of the invention, there is no reason why a prior public use should not. The very concept of the patent system is that the patentee should not be entitled to any monopoly in respect of any subject matter which was in the public domain prior to the priority date of an application or a patent.
15. Prior user has an extremely valuable right in favour of the public in a pre-grant, post-grant or cancellation proceedings.
16. No.

III Proposals for harmonization

17. Yes
18. It need not be commercial but it must be public. Under Section 32 of the Patents Act, "public use up to one year before the priority date of the application will not affect the novelty provided-
 - a) the prior use was effected by the patentee or its representative; *and*
 - b) the prior use was only for the purpose of reasonable trial and experimentation; *and*
 - c) the nature of the invention was such that the trial or experimentation had to be conducted in public." This appears to be a very good standard to follow.
19. The critical date is one day before the priority date.
20. Once the invention has passed into public domain before the priority date by prior use by a third party, it cannot be recalled. This will be subject to our answer to question 6.
21. Prior use should be domestic. It will be very difficult to prove prior use in a foreign country.
22. Yes.
23. No. In fact, the invention should be invalidated to the extent prior use has taken place.
24. There should be no such thing as a prior user right. It should be a simple question of private monopoly right of a patentee *versus* public right. The public should have a right to use anything in the public domain before the priority date of the patent.
25. No.
26. The law should be formalised to the extent that prior public use should destroy the novelty. There is no reason to treat prior public use differently from prior publication.