

PATENT

Patent is a grant supplied for an invention by the Government to the inventor in exchange for full disclosure of the invention. A patent is an exclusive right granted by law to applicants / assignees to make use of and exploit their inventions for a limited period of time (generally 20 years from filing). The patent holder has the legal right to exclude others from commercially exploiting his invention for the duration of this period. In return for exclusive rights, the applicant is obliged to disclose the invention to the public in a manner that enables others, skilled in the art, to replicate the invention. The patent system is designed to balance the interests of applicants / assignees (exclusive rights) and the interests of society (disclosure of invention).

BENEFITS:

1. The inventor is secure from competition and can exploit the invention for his gain.
2. For the public the invention becomes public knowledge. The technology is freely available after expiry of patent and cheaper and better products become available.

What is meant by patentable invention?

Under Patent Law 'invention' means a new product or process involving an inventive step and capable of industrial application.

Any invention concerning with composition, construction or manufacture of a substance, of an article or of an apparatus or an industrial type of process can be patented

A new product or process, involving an inventive step and capable of being made or used in an industry. It means the invention to be patentable should be technical in nature and should meet the following criteria –

- **Novelty:** The matter disclosed in the specification is not published in India or elsewhere before the date of filing of the patent application in India.
- **Inventive Step:** The invention is not obvious to a person skilled in the art in the light of the prior publication/knowledge/ document.

- **Industrially applicable:** Invention should possess utility, so that it can be made or used in an industry.

What is not patentable?

The following are Non-Patentable inventions within the meaning of Section 3 of Patents Act, 1970 -

- Inventions contrary to well established natural laws
- Frivolous inventions
- Commercial exploitation or primary use of inventions,
 - which is contrary to public order or morality
 - which causes serious prejudice to health or human, animal, plant life or to the environments
- Mere Discovery of a Scientific Principle
- Formulation of an Abstract Theory
- Discovery of any living thing
- Discovery of non-living substance occurring in nature
- Mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus, unless such known process results in a new product or employs at least one new reactant.
- Substance obtained by mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance
- Mere arrangement or re-arrangement or duplication of known devices, each functioning independently of one another in a known way
- Method of Agriculture or Horticulture
- Any process for medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings *or* a similar treatment of animals to render them free of disease *or* to increase their economic value or that of their products.
- Plants & animals in whole or any part thereof other than micro-organisms, but including seeds, varieties and species and essentially biological process for production or propagation of plants & animals

- Mathematical method
- Business method
- Algorithms
- Computer programme *per se*
- A literary, dramatic, musical or artistic work or any other aesthetic creation including cinematographic work and television productions.
- Presentation of information
- Topography of integrated circuits.
- Inventions which are Traditional Knowledge or an aggregation or duplication of known properties of traditionally known component or components.

Patent System in India

The Patent System in India is governed by the Patents Act, 1970 as amended by the Patents (Amendment) Act, 2005 and the Patents Rules, 2003, as amended by the Patents (Amendment) Rules 2006 effective from 05-05-2006.

Patent system in India is administered under the superintendence of the **Controller General of Patents, Designs, Trademarks and Geographical Indications**. The Office of the Controller General functions under the Department of Industrial Policy and Promotion, Ministry of Commerce and Industry.

There are **four patent offices in India** -

- ✓ Kolkata (Head Office)
- ✓ Delhi
- ✓ Mumbai
- ✓ Chennai

The **Patent Information System (PIS) at Nagpur** has been functioning as patent information base for the users.

The PIS maintains a comprehensive collection of patent specification and patent related literature, on a world-wide basis and provides technological information contained in patent or patent related literature through search services and patent copy supply services to various users of R&D establishments, Government offices, private industries, business, inventors and other users within India.

Jurisdiction of Patent offices in India

An applicant or first mentioned applicant in case of joint applicants can file application for patent at the appropriate Patent Office under whose jurisdiction he normally resides or has his domicile or has a place of business or the place from where the invention actually originated.

Office	Territorial Jurisdiction
Patent Office Branch, Mumbai	The States of Maharashtra, Gujarat, Madhya Pradesh, Goa and Chhattisgarh and the Union Territories of Daman and Diu & Dadra and Nagar Haveli
Patent Office Branch, Chennai	The States of Andhra Pradesh, Karnataka, Kerala, Tamil Nadu and the Union Territories of Pondicherry and Lakshadweep.
Patent Office Branch, New Delhi	The States of Haryana, Himachal Pradesh, Jammu and Kashmir, Punjab, Rajasthan, Uttar Pradesh, Uttaranchal, Delhi and the Union Territory of Chandigarh.
Patent Office, Kolkata	The rest of India.

From 20th July, 2007 the Indian Patent Office has put in place an online filing system for patent application.

Types of Patent Applications

- 1) Ordinary Application
- 2) Application for Patent of Addition (granted for Improvement or Modification of the already patented invention, for an unexpired term of the main patent).
- 3) Divisional Application (in case of plurality of inventions disclosed in the main application).
- 4) Convention application, claiming priority date on the basis of filing in Convention Countries.
- 5) National Phase Application under PCT.

How is a patent obtained?

1. File an application for patent with one of the patent offices based on territorial jurisdiction of the place of office or residence of the applicant /agent
2. Pay the required fee
3. Information concerning application form and details of fee available at www.ipindia.nic.in. Guidelines for applicants also available on this website

The Patent Office then -

- Conducts searches to ascertain the prerequisites
- Publishes the application
- Conducts in-depth examination
- Raises objection to the application
- Grants the patent

General precautions for an applicant

- ✓ The **FIRST TO FILE SYSTEM** is employed, in which, among persons having filed the same invention, first one is granted a patent, therefore, a patent application should be filed promptly after conceiving the invention.
- ✓ The most common of these indiscretions is to publish their inventions in newspapers or scientific and technical journals, before applying for patents. Publication of an invention, even by the inventor himself, would (except under certain rare circumstances) constitute a bar for the subsequent patenting of it.
- ✓ The use of the invention in Public, or the commercial use of the invention, prior to the date of filing patent application would be a fatal objection to the grant of a patent for such invention, thereafter. There is, however, no objection to the secret working of the invention by way of reasonable trial or experiment, or to the disclosure of the invention to others, confidentially.
- ✓ Another mistake, which is frequently made by the inventors, is to wait until their inventions are fully developed for commercial working, before applying for patents. It

is, therefore, advisable to apply for a patent as soon as the inventor's idea of the nature of the invention has taken a definite shape.

- ✓ It is permissible to file an application for a patent accompanied by a "**Provisional Specification**" describing the invention. The application may, therefore, be made even before the full details of working of the invention are developed. The filing of an application for a patent disclosing the invention would secure priority date of the invention, and thereby, enable the inventor to work out the practical details of the invention and to file complete specification within 12 months from the date of filing of provisional specification.

PROCEDURE

1. Filing the application.

Application for patent can be filed at the appropriate Patent Office under whose jurisdiction applicant normally resides or has his domicile or has a place of business or the place from where the invention actually originated.

Documents required for filing a Patent application.

1. Application form in duplicate (**Form 1**).
2. Provisional or complete specification in duplicate. If the provisional specification is filed, it must be followed by the complete specification within 12 months. (**Form 2**).
3. Drawing in duplicate (if necessary).
4. Abstract of the invention in duplicate.
5. Information & undertaking listing the number, filing date & current status of each foreign patent application in duplicate (**Form 3**).
6. Priority document (if priority date is claimed) in convention application, when directed by the Controller.
7. Declaration of inventorship where provisional specification is followed by complete specification or in case of convention/PCT national phase application (**Form 5**).
8. Power of attorney (if filed through Patent Agent).
9. Fee (to be paid in cash/by cheque/by demand draft) (Schedule I).

10. (The cheque or demand draft should be payable to the "Controller of Patents" drawn on any schedule bank at a place where the appropriate office is situated).

E-filing of Patent applications

What is e-Filing?

From 20th July, 2007 the Indian Patent Office has put in place an online filing system for patent application.

E-filing is a service provided by the Intellectual Property Office, India in order to enable customers to apply for a patent on-line allowing from the User's browser for the User to:

- Complete an electronic application form
- Provide the associated attachments
- Complete the necessary payment details

Procedure for e-filing

1. Acquire Class 3 Digital Signatures either from (n) Code Solutions, Tata Consultancy Services(TCS) & Safe Script.
2. New users (Applicants, Agents or Attorneys), can complete online registration by providing Digital Signature details to get a User ID and Password for using the e-Filing System of Indian Patent Office (IPO).
3. Secure Login into the system with created User Id and the Password.
4. Download the Client Software for preparing Patent Application Offline with required documents and Digitally Sign it for uploading on IPO Server.
5. Fill Patent Application offline and generate an XML file using Client Software.
6. After creating application (XML) file offline, Digitally Sign the XML file (Max. file size permitted 5MB) for uploading on to the IPO Server.
7. Login into e-Patent portal (<http://ipindia.gov.in>) for uploading Application XML file on IPO Server.
8. Upload & Submit Digitally Signed XML file to IPO Server.
9. Process Application for EFT (Electronic Fund Transfer) using State Bank of India(SBI) & Axis Bank Payment Gateways.
10. Review Application Status on e-Patent Portal.
11. On successful EFT acknowledgement details would be displayed/ generated.
12. Print Acknowledgement. Click on "Print" to generate printout of acknowledgement

2. Publication:

3. All the applications for patent are published in the Patent Office Journal just after 18 months from the date of filing of the application or the date of priority whichever is earlier.

Exceptions:

- Applications prejudicial to the defence of India
- Applications abandoned due to non-filing of complete specification within 12 months after filing the provisional.
- Applications withdrawn within 15 months of filing the application.

The applications for patent are not open for public inspection before publication. After the date of publication, the application may be inspected at the appropriate office by making a written request to the Controller in the prescribed manner and on the payment of prescribed fee.

3.Request for examination

An application for patent will not be examined if no request is made by the applicant in Form-18 with prescribed fee, within a period of 48 months from the date of filing of the application. Where no request for examination of the application for patent has been filed within the prescribed period, the aforesaid application will be treated as withdrawn and, thereafter, application cannot be revived.

4.Examination

Application for patent, where request has been made by the applicant or by any other interested person, will be taken up for examination, according to the serial number of the requests received on Form 18. A First Examination Report (FER) stating the objections/requirements is communicated to the applicant, ordinarily within six (06) months from the date of request for examination or date of publication whichever is later. Application or complete specification should be amended in order to meet the objections/requirements within a period of 12 months from the date of First Examination Report (FER). No further extension of time is available in this regard. If all the objections are not complied with within the period of 12 months, the application shall be deemed to have been abandoned. When all the requirements are met the patent is granted, after 6 months from the date of publication, the letter patent is issued, entry is made in the register of patents and it is notified in the Patent Office, Journal.

5. Withdrawal of patent application

The application for patent can be withdrawn at least 3 (Three) months before the first publication which will be 18 (Eighteen) months from the date of filing or date of priority whichever is earlier. The application can also be withdrawn at any time before the grant of the patent. The application withdrawn after the date of publication cannot be filed again as it is already laid open for public inspection. However, application withdrawn before the publication can be filed again provided it is not opened to public otherwise.

6. Opposition proceedings to grant of patents

Where an application for a patent has been published but a patent has not been granted, any person may, in writing represent by way of opposition to the Controller against the grant of any Patent. The representation shall be filed at the appropriate office and **shall include a statement and evidence, if any, in support of the representation** and a request for hearing if so desired.

7. Grant of Patent

When all the requirements are met or in case of opposition under section 25(1), if the opposition is decided in favour of the applicant, the patent is granted, after 6 months from the date of publication under section 11 A, the letter patent is issued, entry is made in the register of patents and it is notified in the Patent Office, Journal.

8. Term and Date of Patent

Term of every patent will be **20 years** from the date of filing of patent application, irrespective of whether it is filed with provisional or complete specification. **Date of patent is the date on which the application for patent is filed.** The term of patent in case of International applications filed under the Patent Cooperation Treaty designating India, will be 20 years from the International filing date accorded under the Patent Cooperation Treaty. A patent will have cease to effect on the expiration of the period prescribed for the payment of any renewal fee, if that fee is not paid within the prescribed period.

9. Renewal and restoration

To keep the patent in force, Renewal fee is to be paid every year. The first renewal fee is payable for the third year and must be paid before the expiration of the second year from the date of patent. If the patent has not been granted within two years the renewal fees may be accumulated and paid immediately after the patent is granted, or within three months of its record in Register of Patents or within extended period of 9 months, by paying extension fees of

six month on Form 4, from the date of record. If the renewal fee is not paid within the prescribed time, the patent will cease to have effect. However, provision to restore the patent is possible provided application is made within eighteen months from the date of cessation.

Rights of the Patentee (Sec. 48 of Patents Act, 1970)

- ✓ Where a patent covers a product, the grant of patent gives the patentee the exclusive right to prevent others from performing, without authorization, the act of making, using, offering for sale, selling or importing that product for the above purpose.
- ✓ Where a patent covers a process, the patentee has the exclusive right to exclude others from performing, without his authorization, the act of using that process, using and offering for sale, selling or importing for those purposes, the product obtained directly by that process in India.
- ✓ Where a patent is granted to two or more persons, each of those persons will be entitled to an equal undivided share in the patent unless there is an agreement to the contrary.

Restoration of lapsed patents

Where a patent has ceased to have effect due to failure to pay the renewal fee within the prescribed period, the patentee or his legal representative can within 18 months from the date on which the patent ceased to have effect make an application in Form 15 for restoration of the patent. If the Controller is satisfied that failure to pay the renewal fee was unintentional and that there has been no undue delay in the making of the application, then the patent will be restored.

Compulsory License

Compulsory Licensing (CL) allows governments to license third parties (that is, parties other than the patent holders) to produce and market a patented product or process without the consent of patent owners.

Any time after three years from date of sealing of a patent, application for compulsory license can be made, provided,

- a) Reasonable requirements of public have not been satisfied;
- b) Patented invention is not available to public at a reasonably affordable price or
- c) Patented invention is not worked in India.

The general purpose for granting compulsory licence is that –

- ✓ patented inventions are worked on a commercial scale in India without undue delay and to the fullest extent that is reasonably practicable
- ✓ the interests of any person for the time being working or developing an invention in India under the protection of a patent are not unfairly prejudiced.

Procedure to check if invention is already patented

The person concerned can perform a preliminary search on Patent Office website in the Indian patent data base of granted patent or Patent Office journal published every week or by making search in the documents kept in the Patent Office Search and Reference Room, which contains Indian patents arranged according to international patent classification system as well in serial number. It is open to the general public from Monday to Friday, except Gazetted holidays. The public can also conduct search free of charge on the website of Patent Office. The person concerned can also make a request for such information under section 153 of the Act.

Patent Agent

A Patent agent is a registered person with Indian Patent Office whose name is entered in the patent agent register after being declared qualified the patent agent examination conducted by the patent office and who is entitled—

- (a) To practice 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.

Infringement of Patents

Infringement of a patent consists of the unauthorized making, importing, using, offering for sale or selling any patented invention within the India.

Remedies against infringement of a patented invention

1. Interlocutory Injunction: A patent owner at the start of a trial can request for an interim injunction to restrain the defendant from committing the acts complained of until the hearing of the action or further orders. Permanent injunction is given based on the merits of the case at the end of the trial.

2. Relief of damages: An award of damages focuses on the losses sustained by the claimant. A patent owner is entitled to the relief of damages as compensation to the patentee and not punishment to the infringer.

3. Account of profits: Account of profits focuses on the profits made by the defendant, without reference to the damage suffered by the claimant at the hands of the defendant. The purpose of the account is to prevent the unjust enrichment of the defendant by the use of the claimant's invention. The patent owner may also opt for the account of profits where he has to prove use of invention and the amount of profit derived from such illegal use.