

Patent

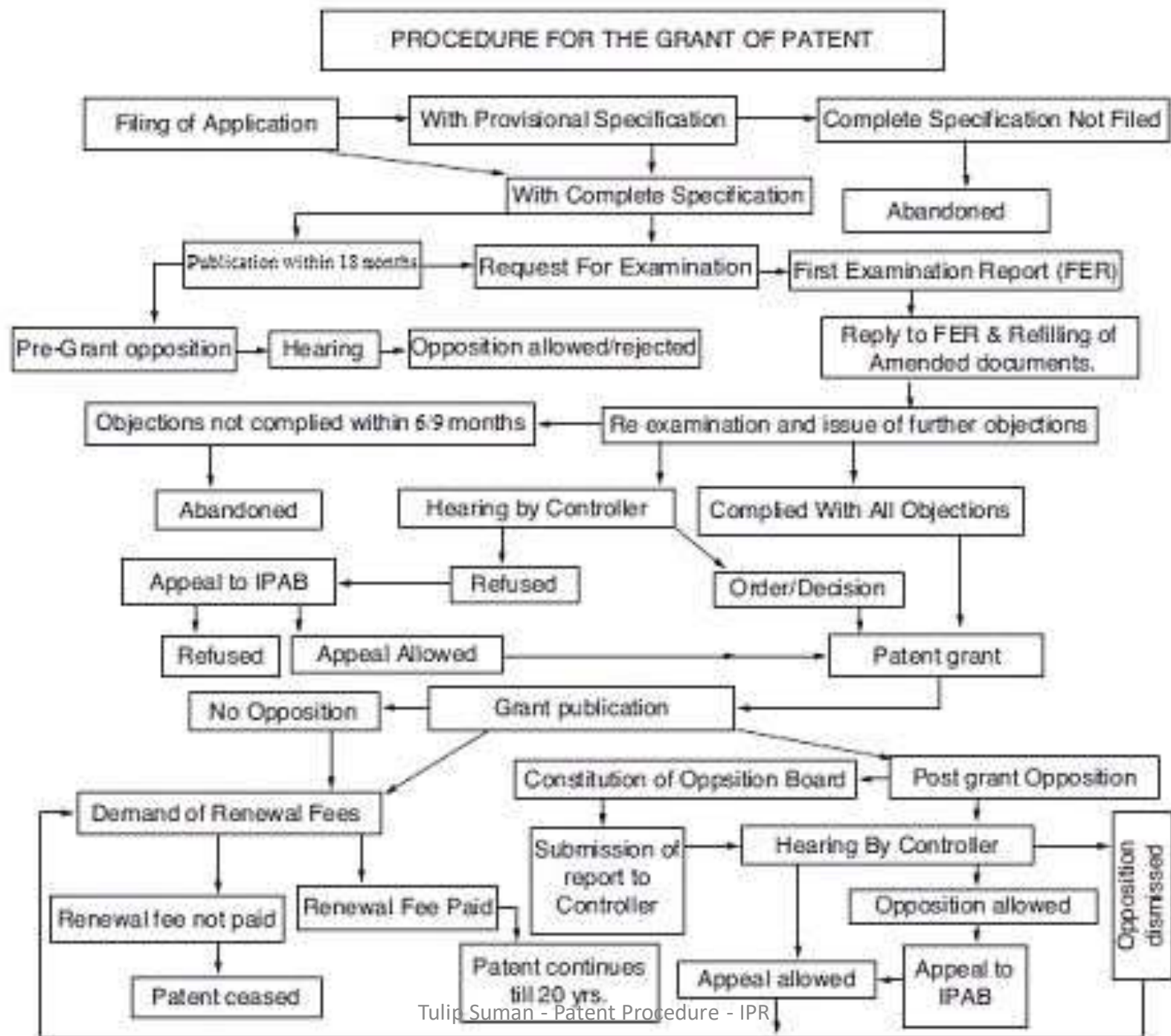
Procedure

Tulip Suman

LL.M.(IPR) NLUJ

Procedure

- Filing the application
 - a request for examination is required to be made for examination of the application in the Indian Patent Office
 - **within 48 months** from the date of priority of the application or from the date of filing of the application
- **First examination report** is issued
 - the applicant is given an opportunity to meet the objections raised in the report
 - The applicant has to comply with the requirements within **6 months from the issuance of the first examination report**
 - which may be extended for further 3 months on the request of the applicant
- If the requirements of the first examination report are not complied with within the prescribed period of 9 months
 - then the application is treated to have been abandoned by the applicant
- After the removal of objections and compliance of requirements, the patent is granted and notified in the **Patent Office Journal**



By Foreigners

- India is a signatory to
 - the **Paris Convention for the Protection of Industrial Property, 1883**
 - the **Patent Cooperation Treaty (PCT), 1970**
- a foreign entity can adopt any of these two treaties
 - for filing of application for grant of patent in India
- Where an application for grant of patent in respect of an invention in a Convention Country has been filed
 - similar application can also be filed in India
 - for grant of patent by such applicant or the legal representative or assignee of such person
 - **within 12 months from the date on which the basic application was made in the Convention Country**, ie, the home country
- The priority date in such a case is considered as the date of making of the basic application

Pre Grant Opposition

- A representation for pre-grant opposition can be filed by *any person*
 - under s 11A of the Patents Act, 1970
 - within six months from the date of publication of the application, as amended (the "Patents Act") or before the grant of patent
- The grounds on which the representation can be filed are provided
 - under section 25(1) of the Patents Act
 - There is no fee for filing representation for pre-grant opposition
 - Representation for pre-grant opposition can be filed even though no request for examination has been filed
- However, the representation will be considered only when a request for examination is received within the prescribed period.

Post Grant Opposition

- *Any interested person*
- can file post-grant opposition
- within **twelve months from the date of publication** of the grant of patent in the official journal of the patent office

Ground

- Some of the grounds for filing pre-and post-grant opposition are as under:
- (a) Patent wrongfully obtained;
- (b) Prior publication;
- (c) The invention was publicly known or publicly used in India before the priority date of that claim;
- (d) The invention is obvious and does not involve any inventive step;
- (e) That the subject of any claim is not an invention within the meaning of this Act, or is not patentable under this Act;

- (f) Insufficient disclosure of the invention or the method by which it is to be performed;
- (g) That in the case of a patent granted on convention application, the application for patent was not made within twelve months from the date of the first application for protection for the invention made in a convention country or in India;
- (h) That the complete specification does not disclose or wrongly mentions the source and geographical origin of biological material used for the invention; and
- (i) That the invention was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.

Term

- The term of every patent in India
 - **20 years** from the date of filing the patent application
 - irrespective of whether it is filed with provisional or complete specification
- If applications are filed under the Patent Cooperative Treaty (PCT)
 - the term of **20 years begins from the international filing date**

Payment of Renewal Fee

Restoration of Patent

- patentee has to **renew the patent every year**
 - by paying the renewal fee
 - can be paid every year or in lump sum
- Request for restoration of patent can be filed
 - within eighteen months from the date of cessation of patent
 - along with the prescribed fee
 - After the receipt of the request, the matter is notified in the official journal for further processing of the request

Patent of Biological Material

- If the invention uses a biological material which is new
 - it is essential to deposit the same in the **International Depository Authority (IDA)**
 - prior to the filing of the application in India
 - in order to supplement the description
- If such biological materials are **already known**
 - it is not essential to deposit the same
- The IDA in India located at **Chandigarh**
- **Institute of Microbial Technology (IMTECH)**

Rights Granted by A Patent

- If the grant of the patent is for a product
 - then the patentee has a right to prevent others from
 - making, using, offering for sale, selling or importing the patented product in India
- If the patent is for a process
 - then the patentee has the right to prevent others from
 - using the process, using the product directly obtained by the process, offering for sale, selling or importing the product in India directly obtained by the process.
- Before filing an application for grant of patent in India, it is important to note

"What is not Patentable in India?"

- Any invention which is
 - Frivolous
 - Obvious
 - contrary to well established natural laws,
 - contrary to law
 - Morality
 - injurious to public health
 - a mere discovery of a scientific principle
 - the formulation of an abstract theory
 - a mere discovery of any new property or new use for a known substance or process, machine or apparatus
 - 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
 - a mere arrangement or rearrangement or duplication of known devices,
 - a method of agriculture or horticulture and
 - inventions relating to atomic energy,
- are not patentable in India.

Maintainability of Secrecy by the Indian Patent Office (IPO)

- All patent applications are kept secret
 - up to **eighteen months from the date of filing**
 - or priority date, whichever is earlier,
 - thereafter they are published in the Official Journal of the Patent Office published every week
- After such publication of the patent application
- public can **inspect the documents** and
- may take the photocopy thereof on the payment of the prescribed fee

Infringement of Patent

- Patent infringement proceedings can only be initiated **after grant of patent** in India
- but may include a claim retrospectively from the date of publication of the application for grant of the patent
- Infringement of a patent consists of
 - the unauthorised making, importing, using, offering for sale or selling any patented invention within the India
- Patents Act, 1970
 - only a civil action can be initiated in a Court of Law
- **Defence:**
 - a suit for infringement can be defended on various grounds
 - including the grounds on which a patent cannot be granted in India and
 - based on such defence, revocation of Patent can also be claimed

Licensing and Assignment of Patent

- What is Permissible?
 - An assignment in a patent or
 - a share in a patent or a mortgage
 - license or the creation of any other interest in a patent
- assignment **is valid only when it is in writing**
 - agreement is reduced to the form of a document
 - embodying all the terms and conditions governing the rights and obligations of the parties to the agreement
- The application for registration is required to be made by the transferee in the prescribed form