

# Week 3 NPTEL (IP)

## Patent Rights

- Patent Prosecution
  - File patent application
  - Scrutinize application
  - Patent Grant
- Patent Enforcement
  - Prevent infringement
  - Courts



## Fundamentals of Patents

- Exclusive monopoly right conferred by the Government
- Exclusive right to make, sell, use, offer for sale, import
- Territorial right



Patent serve different purposes.

Now, the object of a patent or the grant of a patent could be to identify area and technology and to do further work.

So, filing a patent gives the patent owner the right to work in a particular sphere to the exclusion of others.

So, whatever products that can come out of that technological area can now be carved as a right by the patent holder. Patents are also seen as instruments that can incentivize innovation by offering a limited monopoly for the inventor.

As we mentioned, we derived this regime through certain international conventions like the Paris convention, the trips agreement which stands for trade related aspects of intellectual property rights which is a part of the WTO, the world trade organization and also we have some arrangements between countries to facilitate patent filing internationally like the Patent Cooperation Treaty, the PCT.

As we mentioned before, the patents act in India came as a British import.

The Britishers when they were ruling the country, they had brought in the patents act of 1911 which was largely the British act itself, but soon after independence, it was felt that because patents are tied closely to the development of a nation, it was felt that India required its own patent law.

- **Emergence of Patents in India**
  - Early patent statutes; the 1911 Act
  - Tek Chand and Ayyangar Committees
  - Patents Act, 1970
    - Patent Amendment Acts, 1999; 2002; 2005
    - Patent Rules, 2003; amended in 2005, 2006, 2013, 2014 and 2016

1970 act which is the present act that we have come as an exercise that was

suggested by taking all the measures the committees had suggested.

So, the 1970 act for the first time, it removed product protection for medicines.

Earlier the 1911 act had offered product protection for product patents what we called product patents for pharmaceutical and drugs, pharmaceuticals and drugs.

Now, this was removed by the 1970 act, the 1970 act also made some substantial changes in the term of the patent the term of a patent was 14 years and the term of a patent for a food medicine or drug was a shorter period.

It would vary between five to seven years and they were also host of provisions on compulsory licensing which was introduced by the 1970 act.

The 1970 act was also after India became member of the world trade organization in 1995, the act came to be amended three times, in 1999, in 2002 and in 2005

o, with the amendment of the patents

act in 2005, we now offer product and process patents irrespective of the technology.

Earlier there was a distinction that product patents need not be granted for drugs and pharmaceuticals, now that is gone.

So, the two kinds of patents broadly that can be granted under the Indian patents act are either for a product or for a process

## What Constitutes a Patent Specification

Patent specification = **Description + Claims**

Description

- Title
- Background
- Summary of Invention
- Detailed description of invention
- Abstract

# To Whom is the Patent Addressed to

- “Patent specifications are curious documents in that they are written by a group of experts (**patent agents**), embody the rights of a group of creative people (**inventors**), are addressed to a hypothetical group of skilled persons (**persons skilled in the art**), and may, if the case so demands, be interpreted and constructed by a legally trained group of persons (**examiners and judges**).”

— The Law of Patents, LexisNexis, 2007

- Person skilled in the art—hypothetical construct
- Section 10(1) “..shall describe the invention..”



the universal codes are used in different specifications by different patent offices but the code the numbers tend to remain the same. Now, and this is what is known as bibliographical detail.

Bibliographical detail will give you the details about what are the bibliographical details about the patent; the inventors name, application number, the date on which it was filed, the classification, the title, patent office in which it is filed, you will also see a barcode which is for administrative purposes, the US office has also given a barcode .

Now, you find the abstract also the abstract as we had just seen in form 2 comes after the signature and date in the Indian form 2, it comes after, but here it is presented in a different way.

The abstract is presented up front . Now, the abstract describes a combination bit with correction markup providing a user with a writing utensil and a correction method in a single device and it further describes what the abstract is.

Now, the abstract we had seen has a particular function We saw that in rule 13, we had seen rule 13, 7 a and b what are the functions of the abstract? Now, abstract the world over perform similar function they describe the invention and it is a concise summary and they indicate the technical field to which the invention belongs,



(19) United States

(12) Patent Application Publication  
Abplanalp

(10) Pub. No.: US 2012/0093562 A1  
(43) Pub. Date: Apr. 19, 2012

(54) COMBINATION PEN WITH CORRECTION MARKER

(57) ABSTRACT

(76) Inventor: Sandra Abplanalp, Plainfield, IN  
(US)

A combination pen with correction marker providing a user with a writing utensil and a correction method in a single device. The combination pen with correction marker includes a tubular body, an ink cartridge housed within the tubular body, a pen tip connected to an end of the ink cartridge to dispenses an ink supply from within the ink cartridge, a twisting grip coupled with a plunger mechanism attached to an open end of said tubular body. The plunger mechanism moves the pen tip from an extended position and a retracted position when turning the twisting grip. The combination pen with correction marker further includes a correction reservoir fastened to an opposing end of the ink cartridge, which stores a supply of correction ink, and a sponge inserted within the correction reservoir wherein the sponge dispenses the supply of correction ink from the correction reservoir.

(21) Appl. No.: 12/905,042

(22) Filed: Oct. 14, 2010

Publication Classification

(51) Int. Cl.  
B05C 1/00  
(2006.01)

(52) U.S. Cl. .... 401/17; 401/23



# Patentability of Inventions



# What can be patented?

- Inventions [S. 2(1)(j)]
  - New product or process
  - Inventive step
  - Capable of industrial application
- Improvements as inventions



## Transcript



Search in video

5:58

These were all amendments that brought the act in compliance with the TRIPS agreement of the WTO. The TRIPS agreement being an international agreement, it brought a common standard on

6:08

various things; for instance that TRIPS agreement brought in and the TRIPS agreement was actually a product of close to 8 years of negotiations between the member countries.

6:17

It brought a common standard that the term of a patent shall be 20 years from the date

6:22

of application. India earlier had a 14 year period for inventions in general and a shorter period for patents

6:30

inventions pertaining to food, drug and medicine. Now this had to be changed. So, apart from this, the fact that the Indian patent regime did not grant product patents



## What can be patented?

- Inventions [S. 2(1)(j)]
  - New product or process
  - Inventive step
  - Capable of industrial application
- Improvements as inventions



## Patentability

- Statutory exceptions [SS. 3 & 4]
- Novelty/ New Invention
- Inventive step/ Non-Obvious
- Capable of Industrial Application/ Utility



## Inventions not Patentable

- SS 3&4 provides for exceptions to patentability, statutory exceptions
- S. 3 provides for an exhaustive list of items that cannot be classified as inventions

## What are not Patentable?

- Frivolous Inventions and Inventions Contrary to Natural Laws: Section 3(a)
  - Perpetual motion machine
- Inventions Contrary to Public Order or Morality: S. 3(b)
  - Case: Harvard Onco-mouse
  - Prejudice to life, health or environment

## What are not Patentable?

- Discovery not an Invention: S. 3(c)
  - Scientific principle;
  - Artificially synthesized substances—could be subject matter
- S. 3(d)
  - Mere discovery of new form of known substance—no enhanced efficacy



## What are not Patentable?

- S. 3(d)
  - Explanation: For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy.



## What are not Patentable?

- S. 3(d)
  - Mere discovery of any new property or new use for a known substance
  - Mere use of a known process, machine or apparatus unless—results in a new product or employs at least one new reactant

# What are not Patentable?

- Admixture: S 3(e)
  - Aggregation of properties of the component
  - Process of producing such substance
- Inventions Pertaining to Arrangement: S 3(f)
  - Workshop improvements
  - Combination of known integers
- Method of Testing: S. 3 (g)
  - Omitted

## What are not Patentable?

- Method of Agriculture or Horticulture: S. 3(h)
- Methods of Medical Treatment of Human and Animals: S. 3(i)
  - process for the medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings or animals



### Transcript



Search in video

26:49 So, the spark plug the number has to be referred.

26:56 So, that is claim 1, now claim 2 is a dependent claim as claimed in claim 1.

27:12 So, it refers it back to claim 1, claim 3 is again dependent, claim 4 is again dependent.

27:30 Claim 5 is again dependent because it says an improved internal combustion engine as claimed in any of the preceding claims.

27:37 So, 1 to 5, it is again dependent; claim 6 is an independent claim, claim 7 is

28:03 an what we call an Omnibus claim.

28:14 It used to be a prop that Omnibus claims were granted before but now it is not granted the



## What are not Patentable?

- Method of Agriculture or Horticulture: S. 3(h)
- Methods of Medical Treatment of Human and Animals: S. 3(i)
  - process for the medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings or animals



# What are not Patentable?

- Plant and Animal Varieties: S. 3(j)
  - Micro-organism excluded
- Business Method, Computer Program: S.3(k)
  - Software patents; ‘per-se’ not patentable

# What are not Patentable?

- Literary, Dramatic, Musical or Artistic Work etc: Section 3(l)
  - Subject matter of copyright
- Scheme or Rule: Section 3(m)
- Presentation of Information: S. 3 (n)
  - Topography of Integrated Circuits: Section 3(o) Subject matter of copyright

# What are not Patentable?

- Traditional Knowledge: Section 3(p)
- Inventions Relating to Atomic Energy: S.4
  - If granted can be revoked under S. 65

# Novelty

- New Invention
  - [S. 2(1)(l)]
  - New invention or technology
  - Newness not defined under the Patents Act
- Anticipation
  - Publication, Use
  - Global Standard

# Anticipation

- Disclosure
- Publication
  - Discloses the invention to the world
  - Verifiable
- Use
  - To be shown by evidence

# Novelty

- New Invention
  - Subject Matter
  - Manner of Disclosure
    - Disclosure: Date of filing of patent application with complete specification
  - Anticipation

# Inventive Step

- Requirements of Inventive Step
  - Technical advance to existing knowledge
  - Economic significance
  - Both
- Not obvious to person skilled in the art



# Inventive Step

- Inventive Step v. Novelty
  - Novelty—comparison of technical features
  - Person skilled in the art
  - Inventive leap—step from the prior art to invention—non-obvious

# Inventive Step

- Determine person skilled in the art
  - Who is the invention addressed to?
  - Created for obviousness analysis
- Mosaiquing allowed for determining inventive step

# Inventive Step

- Determining inventive step
  - Problem and solution approach
    - Identify closest prior art
    - What was the technical problem?
    - Obvious to person skilled in the art

# Capable of Industrial Application

- S. 2(1)(ac): “Capable of industrial application”, in relation to an invention, means that the invention is capable of being made or used in an industry
- Invention is useful

# Person Skilled in the Art

- Notional person
- Standard by which inventiveness is ascertained
- Common general knowledge to his field



# Introduction

- **Whether:** Determine whether to file a patent application
  - Cost-intensive, business plan, investment, prospect theory

# Introduction

- **Whether:** Determine whether to file a patent application

- Cost-intensive, business plan, investment, prospect theory



## Transcript



Search in video

**24:30** Now, there are various automotive companies which have which file patents that are overlapping.

**24:36** Some technologies in cars, almost all the luxury car manufacturers will claim to have

**24:42** that piece of technology, but you will find that many a time these are overlapping technologies

**24:48** and you also find that these car manufacturers do not sue each other, they do not file cases

**24:53** against each other and why do they then file patents. For instance as a commercial by Mercedes

**25:00** Benz which shows that Mercedes Benz has 80000 patents.

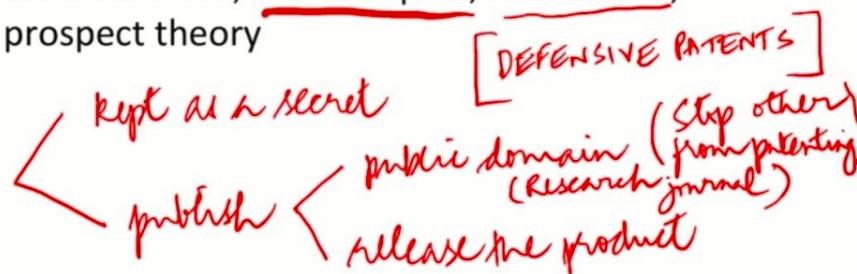
**25:08** The reason why these companies file patents



# Introduction

- **Whether:** Determine whether to file a patent application

- Cost-intensive, business plan, investment, prospect theory



## Transcript



Search in video

27:56 your journal article will now become a prior art for questioning that patent; that patent

28:01 will not be granted in the light of your disclosure.  
So, disclosing information by publication

28:08 is a great way to ensure that others do not get a patent and this is done as a defensive

28:15 method.  
Now, in case you are not inclined or your

28:19 situation does not allow you to publish the information through a research article, then

28:26 the other option is to release the product itself. Releasing the product again becomes

28:34 a part of the prior art, because when you release the product, the product becomes a

28:44 part of the prior art, because it is now



# Introduction

- **Whether:** Determine whether to file a patent application
  - Cost-intensive, business plan, investment, prospect theory
- **When:** File an application according to patent strategy of inventor
  - Indian Application or Foreign Application

# Introduction

- **Whether:** Determine whether to file a patent application
  - Cost-intensive, business plan, investment, prospect theory
- **When:** File an application according to patent strategy of inventor
  - Indian Application or Foreign Application

FIRST-TO-FILE PRINCIPLE



## Transcript



Search in video

8:16 Normally, if the inventor has not come up with the full formed invention, there is a

8:26 prospect, there is a promise, but the inventor has not really, but the inventor has not really

8:37 thrashed out the detail of his invention, the law allows such an inventor to file what

8:43 we call a provisional application.

8:46 A provisional application can be filed.

8:49 What we call a provisional specification can be filed and later on, within a period of

8:54 one year, when the details of the invention, when the inventor has more details about the

9:03 invention, say he has done more experiments or he has done more work and improved it.





# Introduction

- **Whether:** Determine whether to file a patent application
  - Cost-intensive, business plan, investment, prospect theory
- **When:** File an application according to patent strategy of inventor
  - Indian Application or Foreign Application

FIRST-TO-FILE PRINCIPLE



## Transcript



Search in video

covered

11:17 in our earlier lectures.

11:18 So, the Paris Convention allows you to follow up an Indian application with the foreign

11:24 application in any of the countries which are signatory to the Paris Convention.

11:29 So, this is one route.

11:31 If you do not want to take the Paris Convention route or rather if you want to enter multiple

11:36 countries not just one country, then you would follow the PCT route which is the which stands

11:42 for Patent Cooperation Treaty.



# Introduction

- **Where:** Taking a call on where to file
  - PCT Application: If invention to be sold in more than 2 countries
- Do not publish inventions before filing application
- **How:** Complete Specification, Forms, Fees

## Who can apply for patents?

- True and first inventor of the invention
  - Natural person
  - Other persons can be assignee or joint applicant



### Transcript



Search in video

**2:01** So, when an employee comes with an invention,  
the employees name figures as the inventor's

**2:07** name, whereas, the applicant will be the company  
itself; company or the organization to where

**2:15** the employee works.

**2:16** So, you can see two different possessions,  
which people employee with regard to  
patents. One,

**2:25** you are shown as a inventor, which could be  
the employee and there is a status of as the

**2:32** applicant itself who, the person who owns  
the patent, who files the patent, takes care

**2:38** of all the expenses for the patent to get  
granted, and who eventually renews the  
patent



# Who can apply for patents?

- True and first inventor of the invention
  - Natural person
  - Other persons can be assignee or joint applicant
- Assignee of true and first invention
  - Applicant is in possession of the invention
  - No lawful ground of objection to the grant of the patent to the applicant

## Who can apply for patents?

- Legal representative of any deceased person
  - Represents the estate of the deceased person
- Patent Agent - Authorisation
- Mention of Inventor
  - Person making application-possession of invention



### Transcript



Search in video

6:59 or you have Form 26, which you use to engage a patent agent.

7:04 So, the patent agent will be the point of contact between the inventor or the applicant

7:10 and the patent office.

7:12 Now, you also have a provision, where you need to mention the inventor, regardless of

7:19 who owns the invention.

7:21 So, this provision brings out the distinction between the capacity of an inventor and the

7:28 capacity of an applicant.

7:30 As an inventor, you have a right to be denoted; you have a right to be mentioned as an inventor.



# Who can apply for patents?

- Legal representative of any deceased person
  - Represents the estate of the deceased person
- Patent Agent - Authorisation
- Mention of Inventor
  - Person making application-possession of invention

# Requirements of Application



1. Provisional or complete specification [F.2]
  - Provisional specification provides for priority
  - File complete specification within 12 months
2. Drawings
3. Foreign filing details of the said invention
  - Statement and undertaking: Form 3

# Requirements of Application

4. Priority document in case of convention application
  - Copies of specifications, documents
  - Or a request to retrieve the same from Digital Access Service
5. Declaration as to inventor ship
  - F.5, name, nationality, address of the inventor

## Requirements of Application

6. Power of attorney application made by patent agents
  - Form 26 or power of attorney
7. Fees
8. Proof of right if application made by assignee (Removed)

# Types of Applications



- Ordinary application: S.7
- Convention application: S.135



## Transcript



Search in video

- 0:59 In India, you can also file, a convention application.
- 1:02 A convention application is the second type of application and the provisions are given
- 1:06 under the Indian Patents Act.
- 1:08 The convention application is, because India is a party to the Paris convention, you can
- 1:14 file an application in a foreign country and then you can file a convention application
- 1:20 in India, seeking the priority from that foreign application, provided the foreign country
- 1:26 is also a signatory to the Paris convention.
- 1:28 So, this is in arrangement, where you can file an application in any country, which



# Types of Applications



- Ordinary application: S.7
- Convention application: S.135
- PCT international application under PCT



## Transcript



Search in video

**2:17** The third type of application you can file in India is the PCT international application

**2:22** under the Pattern Cooperation Treaty.

**2:24** Works very similar to the convention application because, India is now PCT has its PCT office

**2:33** set up in India.

**2:34** India can receive international PCT applications.

**2:37** The cost of filing ininternational PCT application is substantially different; when you compare

**2:42** it to the cost of filing a PCT application, say in the United States or in the European

**2:47** Union.



# Types of Applications

Pull up for precise seeking



- PCT national phase application under S.7(1A)



## Transcript



Search in video

2:50

You can also file a PCT in national phase

2:52

application in India.

2:54

Now, the PCT international application which you just saw, is an entry point in India,

3:01

where the PCT international application will now have the potential to go to various countries;

3:07

wherever you choose and you can choose different countries; the only thing that you will need

3:13

to do is, you will have to individually prosecute these applications in the respective countries.

3:18

So, the PCT international application gives you an entry point into different countries,

3:23

which are all signatories to the Patent



# Types of Applications



- PCT national phase application under S.7(1A)
- Application for patent of addition under S.54



## Transcript



Search in video

4:32

The fifth type of application is an application for a patent of addition.

4:37

You already have an invention, granted or filed in India, and now you have made some

4:42

improvements in modification to an existing invention.

4:45

You can cover the improvements and modification by the way of a patent of addition.

4:49

There is no need to file a fresh new application because, it is just a modification or an improvement

4:54

over an existing invention.

4:55

So, the patent of addition, allows you to cover improvements in modifications.



## Types of Applications

- PCT national phase application under S.7(1A)
- Application for patent of addition under S.54
- Divisional application under S.16

### Transcript



Search in video

you can file, and the sixth type is a divisional

5:28 application.

5:30 A divisional application is normally filed to divide an invention.

5:34 The law requires that every application should have only one invention.

5:38 So, you file an application with more than one invention, then you can voluntarily divide

5:43 it into the respective applications, covering each application covering an invention, or

5:51 you may be directed by the patent controller.

5:53 **The patent office may say that your application has more than one invention; this is called**

5:58 the unity of invention, that you can file only one application per invention.

6:03 The point, the patent office may point out that you have, your application has more than

6:08 one invention and ask you to divide it.

6:10 So, the process of dividing an application,

6:10 So, the process of dividing an application, wherein, you separate the invention, is done

6:16 by filing a divisional application.



## Transcript



0:01

To hold a patent that has changed the modern world, would define you as an innovator.

0:07

To hold more than one patent of this caliber, would define you as a true leader.

0:14

To hold over 80000, well that would make you the creators of the 2013 Mercedes Benz E class,

0:20

quite possibly the most advanced luxury sedan ever.

0:24

See authorized Mercedes Benz dealer for exceptional offers through Mercedes Benz financial services.

