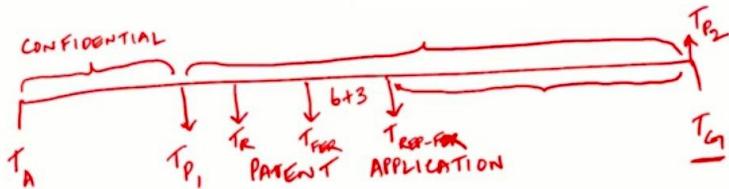




Patent Prosecution

Patent Prosecution



Transcript



Search in video

2:36 be after publication, they can be a request for examination, there is a time for request

2:48 for examination. Then after the time for request for examination, they can be time for filing

2:57 the FER - the first examination report. Within 6 plus 3 months you can get an extension of

3:05 up to 3 months, there has to be a time for reply to the FER. Now, reply to FER.

3:13 Now, after this there will be a period during which the Patent Office will look into it.

3:21 And this can continue the Patent Office actions requiring certain things to be set right,

3:27 and then the patent eventually results in a grant. Now, let us look at the stages the

3:34 application goes through in the process of a prosecution.

3:41 Now, first as we said there is an application, the patent application is published. Now,

3:50 it is not published normally for a period of 18 months; from the date filing till 18

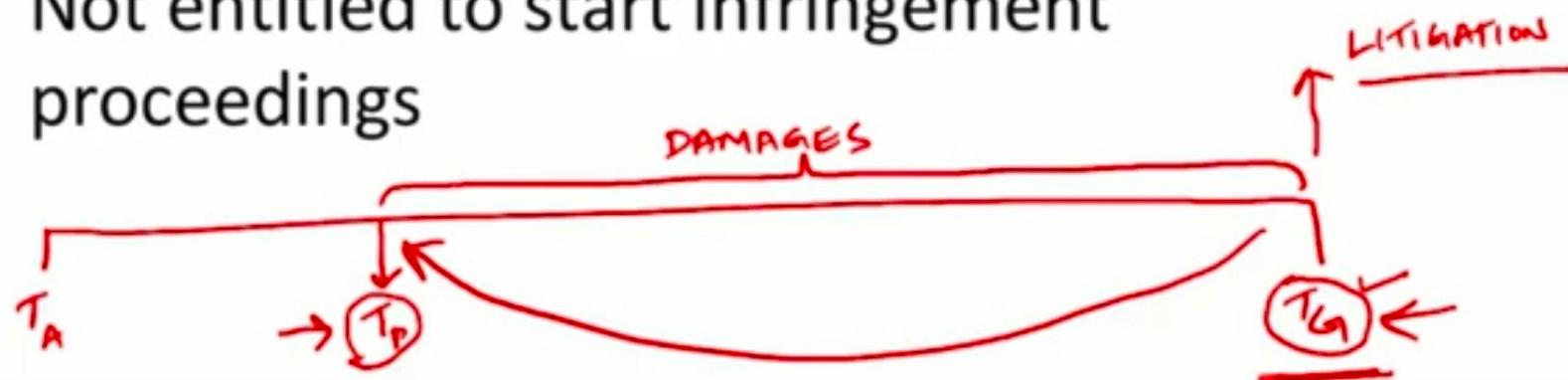
3:57 months the application is not published. this

Publication of Application

- Open to public after 18 months from date of application
- **Form 9:** Request for publication for early publication
- No publication:
 - Secrecy direction imposed
 - Patent abandoned
 - Withdrawn 3 months prior to 18 month period

Publication of Application: Rights of Applicant

- Like rights from date of publication as if patent granted
- Not entitled to start infringement proceedings



Publication of Application: Rights of Applicant



- Like rights from date of publication as if patent granted
- Not entitled to start infringement proceedings
- Reasonable royalty

Request for Examination

- **Form 18:** Request after publication of application
- Within 48 months from date of application
- If no request made-application deemed to be withdrawn

Examination of Application

- Application referred to an examiner: First Examination Report (**FER**)
 - Within 1 month from publication or after request for examination
- FER contents
 - Application and specification as per Act and Rules
 - Lawful grounds of objections
 - Result of investigation

Examination of Application

- Submission of report by Examiner: 1-3 months
 - Submitted to Controller
 - Confidential
- Examination of application
 - Adjudicatory process
 - SS.12 & 13: Code of examination for examiners

What is FER?

- First statement of objections
- Issued by the controller [R. 24B(3)]
- Pursuant to examination under SS. 12 & 13
 - Examination of Application [S. 12] ✓
 - Search for Anticipation [S. 13] ✓



Replying to FER

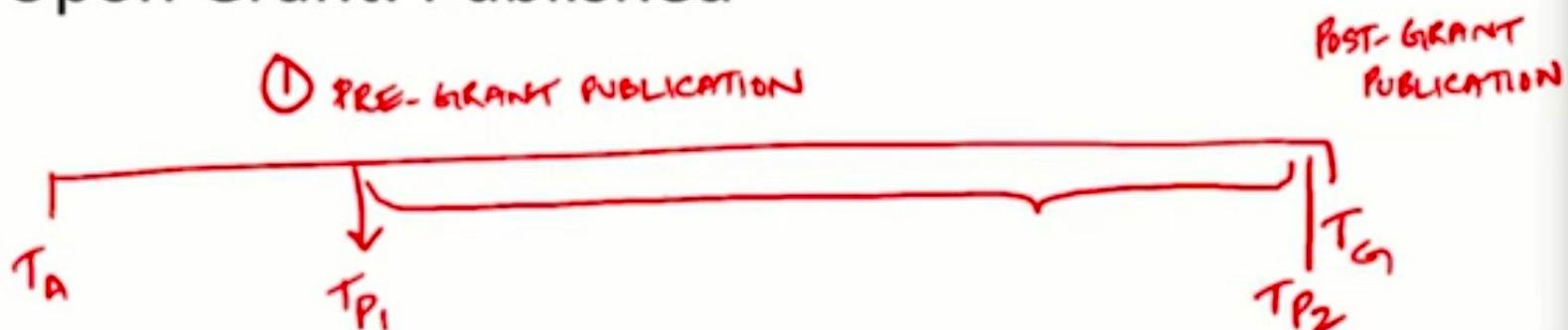
- 6 months + 3 months
- Address all objections
- Failure to reply to objections – rejection of patent

Rights on Grant

- Grant of patent confers exclusive rights on the patentee – *S. 48*
- Right to prevent third parties from making, using², offering for sale³, selling⁴ or importing, for those purposes, that product in India

Grant of Patents: When? [S.43]

- Patent shall be granted expeditiously
 - Found to be in order for grant
 - Application not been refused by Controller; or
 - Application not in contravention of the Act
- Upon Grant: Published



Grant of Patents: When? [S.43]

- Patent shall be granted expeditiously
 - Found to be in order for grant
 - Application not been refused by Controller; or
 - Application not in contravention of the Act
- Upon Grant: Published
- Application, specification and other documents open for public inspection



Amendment of Patent Granted [S.44]

- Person died or body corporate ceased to exist
- Controller may amend the patent
- Substitute to the name of the person to whom the patent ought to have been granted

Conditions of Grant [S.47]

- ✓ Government use
- ✓ Experiment and research
- ✓ Import of medicine or drug

{

Rights [S.48]

- Rights conferred by grant: Infringement
- Exclusive right to prevent third parties
 - making, using, offering for sale, selling or importing (product or process)



Transcript



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- 2:59 So, a process patent will allow other processes to also exist if the processes are non infringing,
- 3:07 if the processes do not intrude into the right that has been granted, whereas a product patent
- 3:14 is a more comprehensive protection.
- 3:17 Let us again come to the example of a liquid solution.
- 3:21 Say there is a product patent over the liquid solution which says the liquid solution itself
- 3:28 is claimed.
- 3:29 When the liquid solution itself is claimed, any process of making it say by using steps
- 3:36 a, b and c, or say by using steps d and e, or any other combination, we will also be
- 3:43 covered because now the product itself is covered.
- 3:47 Now, this distinction is critical for us because India did not offer product protection for
- 3:57 pharmaceutical products before 2005, because we did not offer patent protection for pharmaceutical

Assignments

- Assignment, share, mortgage, license [S.68]
 - valid only when in writing
 - Reduced to form of document
 - Contains terms and conditions governing their
rights and obligations

Assignments

- Assignment, share, mortgage, license [S.68]
 - valid only when in writing
 - Reduced to form of document
 - Contains terms and conditions governing their
rights and obligations
- Assignment needs to be registered-Controller
[S.69, F.16]

Restrictive Conditions [S.140]

- Unlawful and void conditions in a contract/license
 - Sale or lease of a patented product/process
 - Manufacture or use a patented article
 - Work any process protected by patent

Restrictive Conditions [S.140]

- Unlawful and void conditions in a contract/license
 - Sale or lease of a patented product/process
 - Manufacture or use a patented article
 - Work any process protected by patent

1. TIE IN - NON-PATENTED PRODUCT

2. RESTRICTION OF USE - PRODUCT

3. RESTRICTION OF USE - PROCESS

4. EXCLUSIVE GRANT BACK, NO CHALLENGE, COERCIVE PACKAGE LICENSING

Restrictive Conditions [S.140]

- Unlawful and void conditions in a contract/license
 - Sale or lease of a patented product/process
 - Manufacture or use a patented article
 - Work any process protected by patent
- In an infringement suit, defence to prove there was a void contract in force

Restrictive Conditions [S.140]

- Valid Contracts
 - Exclusive licensee → SALE - FRANCHISEE
 - Exclusive supplier of new parts of patented article

Determination of Contracts [S.141]

- After a patent ceased to be in force, a contract or license relating to such patent shall be determined by the purchaser, lessee or licensee

Determination of Contracts [S.141]

- After a patent ceased to be in force, a contract or license relating to such patent shall be determined by the purchaser, lessee or licensee
- Give 3 months' notice to the other party

Introduction

- **Opposition:** Patent/Application challenged
- Importance of opposition proceedings
- Two kinds of oppositions
 - Opposition before grant [S.25(1)] - Pre-*gr*
 - Opposition after grant [S.25(2)]

Opposition Before Grant

- Nature of pre-grant opposition
 - Summary in nature
 - Not inter partes proceedings
- Status of opponent
 - Any person can make a representation
- Procedure of pre-grant opposition [R.55(1)]
 - Written representation [F. 7A]
 - Time bound procedure

Opposition After Grant

- Nature of post-grant opposition
 - Proceedings: Between patentee and opponent
- Status of opponent
 - Person interested [S.2(1)(t)]
'my person'
 - Technical competence in the same field
- Procedure of post-grant opposition
 - Notice of opposition [F.7]
 - Opposition Board [R.56]

Grounds of Opposition

- Invention wrongfully obtained
 - SS. 25(1)(a) & 25(2)(a)
 - Focus on identity of the invention
 - **Relief:** S. 26 Amend patent in the name of opponent



Transcript



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14:27 happen in different points in time the grounds remain the same.

14:33 The post grant opposition can be filed one year after the patent is granted.

14:39 So, there is a timeline for filing the post grant where as a pre-grant opposition can

14:45 be filed anytime after the patent is published, but before the grant of the patent.

14:54 There are 11 grounds and the grounds are meant to be exhaustive meaning which you cannot

14:59 add new grounds of opposition which are not covered in the 11 grounds.

15:04 For instance, a patent cannot be opposed for lack of unity, unity is a feature that each



Grounds of Opposition

- Same grounds for pre-grant and post-grant opposition
- **Difference:** Stage of introduction of grounds
- 11 grounds of opposition
- Exhaustive grounds
 - Can't be opposed on lack of unity

Grounds of Opposition

- Invention wrongfully obtained
 - SS. 25(1)(a) & 25(2)(a)
 - Focus on identity of the invention
 - **Relief:** S. 26 Amend patent in the name of
opponent

Grounds of Opposition

- Prior Publication
 - SS. 25(1)(b) & 25(2)(b)
 - Two Kinds
 - Published in India after 1 Jan, 1912 (patents)
 - Published in India or elsewhere, in any other document (non-patent)
 - Statutory exceptions
 - Matter published earlier published without consent of applicant
 - Invention claimed in complete specification

Grounds of Opposition

- Prior Claiming
 - SS. 25(1)(c) & 25(2)(c)
 - Anticipation by application
 - Published in India with earlier priority date
 - **Recourse:** Controller may require amendment or insertion of a reference of earlier claim

Grounds of Opposition

- Prior knowledge or publicly used
 - SS. 25(1)(d) & 25(2)(d)
- Lack of Inventive step
 - SS. 25(1)(e) & 25(2)(e)
 - “Clearly” doesn’t involve any inventive step
- Subject of claim not an invention or not patentable
 - SS. 25(1)(f) & 25(2)(f)

Grounds of Opposition

- Insufficiency
 - SS. 25(1)(g) & 25(2)(g)
 - Sufficiently and clearly describe the invention
 - Method of performing
- Non-disclosure of information
 - SS. 25(1)(h) & 25(2)(h)
 - Failure to disclose information under S.8

Grounds of Opposition

- False claim to convention priority
 - SS. 25(1)(i) & 25(2)(i)
 - Two grounds
 - Time barred convention application
 - Basic application not a convention application
- Non disclosure of biological material
 - SS. 25(1)(i) & 25(2)(i)

Grounds of Opposition

- Anticipation by traditional knowledge
 - SS. 25(1)(k) & 25(2)(k)
 - Knowledge within local or indigenous community
 - Proved by oral or documentary evidence

Introduction

- Infringement not defined under the Act
- Intrusion, scope of invention for which protection claimed ↪
- Scope of monopoly rights: SS. 10(4)(c) & 48

Determining Infringement

- Within scope of invention as per claims?
- Violation of any right of the patentee?
- Who is liable for the act?
- Whether the act comes under any exception?

Act Violates Rights

- Infringement during term of patent
 - $T_A - T_{PA}$: Exempted Acts
- Rights of patentee protected
 - S.48 rights are protected
product —
process —
- Infringement of product and process

Jurisdiction [S.104]

- Courts having jurisdiction
 - District Court ✓ – COUNTER- CLAIM OF INVALIDITY
 - High Court ✓
 - Ordinary original civil jurisdiction –
 - Value of the relief claimed –
- Power to transfer
 - Counter claim of revocation is claimed

Parties

- Who can institute a suit?
 - Patentee ✓
 - Exclusive Licensees ✓
 - Co-owners ✓
- Who may be sued?
 - Any person infringing, or his agents
 - Joint tortfeasors (distributor, retailer)



Patents used on Foreign Vessel [S.49]

- The use of the invention shall not amount to infringement if used in—
 - Body of the vessel or on board
 - Construction or working of the vessel, aircraft or land vehicle
- Provision works on the principle of reciprocity



Bolar Exemption [S.107A(a)]

- Submission of sample to regulating authority
 - Without intention to market until patent expires, amounts to use of invention
 - All pharma research covered under S.107A(a)



Parallel Importation [S.107A(b)]

- International exhaustion of patent rights
 - Patented goods sold by patentee, he shall have no further control over it
 - Importation allowed
- No infringement

Appellate Board [S.116]

- Appellate board established under S.83 of Trade Marks Act, 1999
- Appeals, rectification, invalidity
- Bar of jurisdiction of courts

Introduction

- Suit for declaration of non infringement [S.105]
- Anticipatory action against patentee or licensee
 - Potential infringement action
- Risk assessment before venturing into commercial production

Declaration under S.105

- Parties to the suit
 - **By who:** Any person having an anticipation of infringement action
 - **Against whom:** Patentee or the holder of the exclusive licensee of the patent
- Jurisdiction: High Court or District Court
 - Acts under S.105 were done

Declaration under S.105

- Conditions to be met before filing suit
 - Seeking a written acknowledgment from patentee/licensee
 - Patentee/licensee refused to give acknowledgment
- Effect of Declaration
 - Plaintiff has not infringed patent

Relief for Groundless Threats

- Suit for relief [S.106]
- **By who:** An aggrieved person
- **Against whom:** Any person
 - Entitled to a patent/application
 - Interested in a patent/application
 - Anyone whether interested or not

Relief for Groundless Threats

- Aggrieved person can claim following reliefs:
 - Declaration, threats are unjustifiable
 - Injunction against continuance of threats
 - Damages
- Defense for the defendants
 - Acts for proceedings threatened, shall constitute infringement
- Notice of existence of patent, not threatening

Kinds of Threats

- Threats during contractual relationship
- Legal notice by patentee
- Oral threat
- Written threat
- Threat of future infringements
- Threats in without prejudice communications

Types of CL

- Third Party Initiated CL
- Special CL
- CL of Related Patents
- CL for Export of Pharmaceuticals

Application for CL [S.84]

- Establish a prima facie case for S.84
- **Who can apply:** Any person interested after the expiration of 3 years from grant of patent
- **Conditions:**
 - Reasonable requirements of public not satisfied
 - Not available at reasonably affordable price
 - Not worked in India
- Other applications under SS. 91, 92 92A

Third Party Initiated [S.84]

- Procedure
 - Adjournment of applications, if time not enough to work the patent
 - Opposition of application
- Factors considered before grant [S.84(6)]
 - Nature of invention, steps taken to use invention
 - Ability to work invention for public advantage
 - Capacity of applicant to undertake risk
 - Failed in obtaining license

Incidental Orders: Controller

- Granting Licences to Customers of the Applicant
- Cancelling or Amending Existing Licences
- Granting Licences for Other Patents
- Revision of Terms and Conditions

Licensing of Related Patents [S.91]

- **Who:** Any person, right to work any other invention as a patentee or licensee
- **When:** Prevented without such licence from working the other invention efficiently
- **Conditions:**
 - Willing to grant/procure, license of other invention
 - Substantial contribution, industrial activities

Special Compulsory License [S.92]

- Compulsory licenses to work the invention
 - circumstances of national emergency
 - circumstances of extreme urgency
 - cases of public non-commercial use
- Includes public health crisis
- Notification by Central Govt.



Compulsory License for Export [S.92A]

- Manufacture and export of pharma products
- To a country having insufficient manufacturing capacity
 - Address public health problems
 - Such country allows importation from India

Termination [S.94]

- Termination of application made under S.84



Transcript



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can only be granted after 3 years of the patent

9:12

being granted and a compulsory license has been granted and it is been 2 years after

9:18

the grant of the compulsory license, nothing has been done the patent has not been worked.

9:26

So, the invention has not been worked reasonable requirements of the public not are, not being

9:32

satisfied and the invention is not available at an affordable.

Termination 5.94

9:37

Compulsory licenses granted can also be terminated an application that is been granted a compulsory



Revocation [S.85]

- Revocation in cases of not working
- **Who:** Person interested, Central Govt
- **When:** 2 years after date of grant of CL
- **Conditions:**
 - Invention not been worked
 - Reasonable requirements of public not satisfied
 - Not available at affordable price

Termination [S.94]

- Termination of application made under S.84
- Application made to the Controller by the patentee or interested person
- License holder has the right to object such termination
- Application to be made on F.21



Government Use and Acquisition

Use of Invention

- For the purposes of Government [S.99]
 - Central Govt, State Govt, Govt undertaking
- Meaning of use
 - Made, used, exercised or vended for the purposes of Govt.
 - Use of medicine and drugs under S.47

Use of Invention

- Payment of royalty to the patentee [S.100]
 - No royalty: tested on behalf of government before priority date
 - Royalty: if not tested on behalf of Govt, use after grant of patent
- Authorization by Govt
 - Before or after grant, to any person
 - Notify the patentee

Use of Invention

- Right of third parties [S.101]
 - Third party agreement shall not restrict the use of the invention by Govt
 - Provide for making of payments
- No copyright infringement on Govt use
- Compensation for Govt use

Acquisition of Invention

- Acquire invention for public purpose [S.102]
 - Publish a notification in Official Gazette
 - Notice to be given to person having interest
- Compensation to such person to be paid
 - In case of default, to be decided by HC