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## CONTENTS

• Publishers note to the Fourth Edition	v
• About the Author	vi
• Preface to the First Edition	vii
• Table of Cases	xI

## PART I—PATENTS

### CHAPTER 1 INTRODUCTION

<u>Origin of the term patent</u>	3
Statement of Objects and Reasons: The Patents Act, 1930	3
<u>Meaning of the term 'Patent'</u>	4
<u>Patent—A Form of property</u>	5
<u>What is the objective behind a Patent Law</u>	5
<u>Legislative provisions regulating Patents</u>	5
<u>Principles underlying the Patent Law in India</u>	5
Invention must be new, useful and non-obvious	5
Newness	6
Usefulness	6
Non-obviousness	6
Exceptions	6
Invention must be disclosed fully	7
Use and acquisition of patented invention by the Central Government	7
Some restricted use of a patented invention permissible under the law	8
Use by a person other than a patentee constitutes infringement of the patent	8
Reliefs in cases of infringement	8
Burden not on patentee in case of infringement	8
Prima facie proof of infringement	8
Special status of patents relating to medicines, food items and chemicals	9
Test of anticipation in patent cases	9
Balance of convenience and patent	10
Protection to unused patents	10
Guidelines for restrictive patentable sectors etc.	10

**CHAPTER 2****PROTECTABLE SUBJECT MATTER—PATENTABLE INVENTION**

Intangibles are not patentable	12
Inventions which are not patentable under the Act	13
Patent of addition	14
Term of patents of addition	15
Process patent	15

**CHAPTER 3****PROCEDURE FOR OBTAINING PATENT**

Submission of application	16
Persons entitled to apply for patents	16
First-to-apply system	17
Meaning of true and first inventor	17
Assignee of an inventor may apply	17
Inventions made by an employee	17
Form of application	18
Special provision for foreign applicants	19
The applicant to file provisional and complete specification	19
What is a specification?	20
Publication and examination of the application *	21
Communication to the applicant	22
Opposition Proceedings to Grant of Patent *	23
Grant of Patent *	23
Term of the Patent *	23
Joint inventors	23
Compulsory-Licence	23

**CHAPTER 4****PROVISIONAL AND COMPLETE SPECIFICATION**

Specification	25
Contents and form of specification	25
Nature of the patent specification	26
Kinds of Specification	26
Provisional specification	26
Need to file a Provisional Specification	26
Provisional Specification to be followed by Complete Specification	26
Complete specification	27
The contents of a Complete Specification	27
Priority date of a claim	27
The interpretation of specification and its importance	28
Claims	28
Whether a specification can be amended once it has been filed	29
Amendment before acceptance	29

Amendment after acceptance	30
Amendment before the grant of patent	30
Conditions for amendment	30
Disclaimer	30
Correction	30
Explanation	31
Who is to allow the amendment	31

### CHAPTER 5

#### **RIGHTS CONFERRED ON A PATENTEE**

✓ Patent rights are conditional	33
Rights of patentees	34
The right to exploit the patent	34
Right to licence	34
Right to assign	34
The right to surrender the patent	35
Right to sue for infringement	35
Exceptions and Limitations	35
Power of the Central Government to use invention for purposes of Government	35
Acquisition of invention and patent by the Central Government	36
Government use of invention without payment of royalty	36
Compulsory licences	37
Use of the invention for defence purposes	38
How the rights of a patentee are enforced ?	39
Duties of a patentee	39

### CHAPTER 6

#### **TRANSFER OF PATENT**

✓ Forms of transfer of Patent Rights	40
✓ Assignment	40
The difference between assignment and licence	40
Assignee	40
Kinds of assignment	41
Legal assignment	41
Equitable assignment	41
Mortgage	41
Conditions to create a valid assignment	41
Licence	42
The kinds of licence	42
(1) Voluntary Licence	42
(2) Statutory Licence	42
(3) Exclusive/limited licence	42
(4) Express/implied	43

## Introduction

### ORIGIN OF THE TERM PATENT

The term 'Patent' has its origin in the term "Letters Patent".

The expression "Letters Patent" meant open letters as distinguished from closed letters. These were instruments under the Great Seal of the King of England addressed by the Crown to all the subjects at large, in which the Crown conferred certain rights and privileges on one or more individuals in the kingdom.

In the later part of the nineteenth century new inventions in the field of art, process, method or manner of manufacture, machinery, apparatuses and other substances, produced by manufacturers were on the increase and the inventors became very much interested that the inventions done by them should not be infringed by any one else by copying them or by adopting the methods used by them. To save the interests of inventors, the then British rulers enacted the Indian Patents and Designs Act, 1911 (2 of 1911).

### STATEMENT OF OBJECTS AND REASONS: THE PATENTS ACT, 1970

The existing Indian Patents and Designs Act was enacted in 1911 and since then there have been substantial changes in the political and economic conditions of the country. The need for a comprehensive law so as to ensure more effectively that patent rights are not worked to the detriment of the consumer or to the prejudice of trade or the industrial development of the country was felt as early as 1948 and in that year the Government appointed the Patents Enquiry Committee to review the working of the patents law in India. The Committee submitted its final report in 1950. The Patents Bill, 1953, based largely on the United Kingdom Patents Act, 1949 and incorporating some of the recommendations of the Committee was introduced in the Lok Sabha on 7th December, 1953. The Bill, however, lapsed on the dissolution of the First Lok Sabha.

In 1957, the Government of India appointed Justice N. Rajagopala Ayyangar to examine afresh and review the patents Law in India and advised the Government on the changes necessary. The Judge submitted a comprehensive Report on Patents Law Revision in September, 1959. The Patents Bill, 1965, based mainly on the recommendations contained in his detailed report and incorporating a few more changes in the light of further examination made particularly with reference to patents for food, drugs and medicines, was

## Intellectual Property

introduced in the Lok Sabha on 21st September, 1965. The Bill was referred on 25th November, 1965 to a Joint Committee of Parliament. The Joint Committee, after a careful consideration of the matter, adopted a number of amendments to the Bill. The Report of the Joint Committee with the amended Bill, was presented to the Lok Sabha on 1st November, 1966. The Patents Bill, 1965, as reported by the Joint Committee was formally moved in the Lok Sabha on 5th December, 1966, but could not be proceeded with for want of time and eventually lapsed with the dissolution of the Third Lok Sabha on 3rd March, 1967.

A Bill containing comprehensive provisions to amend and consolidate the existing law and also containing amendments/recommendations by the Joint Committee referred to above was brought before the Parliament, subsequently.

### ACT 39 OF 1970

The Patents Bill having been passed by both the Houses of Parliament received the assent of the President on 19th September, 1970. It came on the Statute Book as THE PATENTS ACT, 1970 (39 of 1970).

### LIST OF AMENDING ACTS

1. The Repealing and Amending Act, 1974 (56 of 1974).
2. The Delegated Legislation Provisions (Amendment) Act, 1985 (4 of 1986).
3. The Patents (Amendment) Act, 1999 (17 of 1999).
4. The Patents (Amendment) Act, 2002 (38 of 2002).
5. The Patents (Amendment) Act, 2005 (15 of 2005).

### MEANING OF THE TERM 'PATENT'

It refers to a grant of some privilege, property or authority made by the Government or the Sovereign of the country to one or more individuals. The instrument by which such grant is made is known as 'Patent'.

The term 'Patent' acquired statutory meaning in India when the Patents Act, 1970 (hereinafter referred to as the Act) was enacted.

Patent under the Act is granted by the Controller to the inventor for a period of 20 years. It is the exclusive right to make use, exercise and vend his invention. The Patents (Amendment) Act, 2005 defines patent under section 2(m) as: "Patent" means a patent for any invention granted under this Act. The Patents Rules, 2003 provides for the application for patents. The Patents (Amendment) Rules, 2006 provides for new Form of Patent.

The Act conveys to the inventor substantive rights and secures to him the valuable monetary right which he can enforce for his own advantage either by using it himself or by conveying the privileges to others. He receives something tangible; something which has present existing value which protects him from some competition and is the source of gain and profit.

After the expiry of the period for which exclusive right is granted to the inventor, the invention can be put to use by any person other than the one to whom a patent had been granted.

The person to whom a patent is granted is called patentee.

### Introduction

### PATENT—A FORM OF PROPERTY

An invention is the creation of intellect applied to capital and labour, to produce something new and useful. Such creation becomes the exclusive property of the inventor on grant of patent. The patentee's exclusive proprietary right over the invention is an intellectual property right. The owner of the "patent", i.e., patentee is entitled to deal with his such property in the same manner as owner of any other movable property deals with his property.

This means that the patentee can sell the whole or part of his property (patent). He can also grant licence to other(s) to use the patented property. He can also assign such property to any other(s). Such sale, licence or assignment of patented property naturally has to be for valuable consideration, acceptable mutually.

### WHAT IS THE OBJECTIVE BEHIND A PATENT LAW?

The Patent Law recognises the exclusive right of a patentee to gain commercial advantage out of his invention. This is to encourage the inventors to invest their creative faculties, knowing that their inventions would be protected by law and no one else would be able to copy their inventions for certain period during which the respective inventor would have exclusive rights.

In the case of *Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries*, (1979) 2 SCC 511, it has been held by the Supreme Court that, "the object of patent law is to encourage scientific research, new technology and industrial progress. Grant of exclusive privilege to own, use or sell the method or the product patented for a limited period, stimulates new inventions of commercial utility. The price of the grant of the monopoly is the disclosure of the invention at the Patent Office, which after expiry of the fixed period of the monopoly, passes into the public domain".

### LEGISLATIVE PROVISIONS REGULATING PATENTS

The Indian Patents Act, 1970 and the Patent Rules, 2003 regulate the grant, the operative period, the revocation and infringement, etc., of the patents. The Patents Act was amended in 2005 and the Patents Rules were amended in 2005 and 2006 for the purpose of contemporary adjustment in Patent Laws.

### PRINCIPLES UNDERLYING THE PATENT LAW IN INDIA

Principles upon which Indian Patent Law is based are enumerated below:

#### *Invention must be new, useful and non-obvious*

To be patentable, the invention must be new product or process; useful and capable of industrial application. Another feature of an invention to be granted patent is that it should involve technical advance as compared to the existing knowledge or have economic significance or both. The invention must be non-obvious to a person possessed of average skill in the art. What is obvious to a person skilled in the art cannot be patented. For instance, an invention in carpentry may be non-obvious to a layman but it may be obvious to a carpenter of average skill. Such obvious invention would not be patentable.

**Newness**

The element of novelty (newness) in an invention is dependent upon the state of prior art, i.e., the existing knowledge and similar inventions already known in the particular field. There would be no novelty if there has been prior publication and prior use of same or an identical invention. For instance, the recent grant of patent in the U.S.A. to turmeric products was attacked on this ground. The Indian Council of Scientific and Industrial Research (CSIR) challenged the grant of patent on turmeric by the U.S. Patent Office on the plea that the patent could not be granted since there was no novelty in the invention. Also that what was patented was already published in Indian texts and use of turmeric preparations has been made in our country since times immemorial. The CSIR was successful in getting the grant of patent to an American company revoked. This instance highlights the importance of the element of novelty for an invention to qualify for grant of patent.

For the purpose of patent, the invention must be a new one. It means that the invention must involve any innovation or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification. That is to say, the subject-matter must not have fallen in public domain or that it does not form part of the state of the art.

**Usefulness**

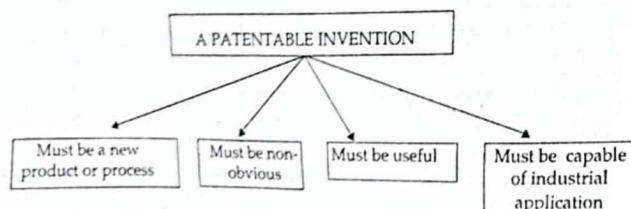
The invention besides being new and non-obvious, must also be useful. An invention which is new and also non-obvious but which cannot be put to any beneficial use of the mankind, cannot be patented.

However, not so useful inventions are protected in some countries as 'utility models'. But that concept is not statutorily recognized in India.

**Non-obviousness**

The invention must be non-obvious to a person skilled in the art to which the invention relates.

To depict diagrammatically:

**Exceptions**

Some inventions, in spite of being new, non-obvious and useful cannot be patented under the Act. Such non-patentable inventions would be:

- (a) Those inventions which are injurious to public health or violate public morality or public interest or which causes serious prejudice to human, animal or plant life or health, or to the environment.

- (b) New method of agriculture or horticulture is non-patentable invention in order to have a more widespread benefit of such invention, rather than concentrating the commercial gain of such invention in the hands of the inventor alone.
- (c) A process of treatment of human beings, animals or plants. Imagine the consequences of such an invented process of treatment being patented. A patient residing in Shimla, needing treatment invented and patented by a Bombay doctor, would have to go to that doctor in Bombay who invented the process of treatment, say of muscular spasms! Such a patent over a process of treatment, if granted, would run counter to public purpose which every legislative and executive act has to serve.
- (d) The mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance, or the 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.
- (e) Any process for the medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products.
- (f) Any invention which in effect is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component.
- (g) Inventions relating to atomic energy.

**Invention must be disclosed fully**

While the Act grants the exclusive right to the inventor to exploit his invention for commercial gain for a specific period of time, it also imposes on him the duty of fully disclosing the invention in the complete specification so as to facilitate anyone from the public working the invention, once the period of protection expires.

The full disclosure of the patented invention is mandatory. If an inventor fails to disclose the invention fully, the patent will not be granted. The validity of such patent, even if granted, can be contested by an opposing party. The patent can be revoked on such contest succeeding.

**Use and acquisition of patented invention by the Central Government**

The grant of a patent confers the exclusive right of use on the patentee for commercial gain but the Act recognises that the Central Government may use any invention even without the payment of royalty to the inventor. For instance, the Central Government may use an invention being a medicine or drug for the purpose of distribution in any dispensary, hospital or other medical institution maintained by or on behalf of the Government. The Central Government can acquire the patents from the patentee or any other person having interest in the patent, by paying the compensation.

The idea is that the invention can be put to use for general public benefit by the Government in certain circumstances, when the patentee would have to forgo his commercial gain in the general public interest.

#### Some restricted use of a patented invention permissible under the law

The essence of a patent is conferring of the exclusive right on the patentee. Yet some restricted use of a patented invention by a person other than the patentee is permissible under the law. For instance, use of a patented invention is permissible for research or experimental purposes or for imparting knowledge or instructions to pupils.

For instance, teacher in an engineering college can depict, explain and show the functioning of patented invention to his pupils without violating any provisions of law.

#### Use by a person other than a patentee constitutes infringement of the patent

The Act expressly provides that use by a person other than the patentee, patentee's assignee or licensee would be an infringement of the patent and as such illegal, leaving apart its use by Government for public purpose and the permissible use for research experiments or imparting knowledge to students.

#### Reliefs in cases of infringement

The Act lays down the reliefs which the patentee is entitled to claim when his patent has been infringed. The Act prescribes that the civil remedy lies in institution of a suit in a court of competent jurisdiction. The prescription of relief in suits for infringement is based on the principle 'where there is a wrong there is remedy'. The plaintiff on satisfying the court about infringement of his patent would be entitled to the following reliefs:—

- (1) Interlocutory injunction.
- (2) Damages.
- (3) Account of profits.

#### Burden not on patentee in case of infringement

Where the subject-matter of patent is a process for obtaining a product, the defendant is to prove that the process used by him to obtain the product, identical to the product of the patented process, is different from the patented process if:

- (i) the subject-matter of the patent is a process for obtaining a new product;
- or
- (ii) there is a substantially likelihood that the identical product is made by the process, and the patentee or a person deriving title or interest in the patent from him, has been unable through reasonable efforts to determine the process actually used.

#### Prima facie proof of infringement

The plaintiff must first establish such facts as will satisfy the court that there are strong *prima facie* reasons for acting on the supposition that the patent is valid.

The most cogent evidence for this purpose is either that there has been a previous trial in which the patent has been held to be valid, or that the patentee has worked and enjoyed the patent for many years without disputes or may be that as between the parties, the plaintiff is relieved from the onus of establishing validity; as where the defendant has admitted it or is so placed in his relationship to the plaintiff as to be estopped from denying it.

#### Special status of patents relating to medicines, food items and chemicals

The Act accords special status to patents relating to medicines, food items and chemicals.

No product patent can be granted relating to any process of medicinal, surgical, curative prophylactic, diagnostic, therapeutic or other treatment of human being, food items and chemicals. Only the process of manufacturing such products can be patented. In case of grant of patents for certain substances which are not food items or drugs as such, but are capable of being used as food and drugs, the same are deemed to be endorsed with 'licences of rights'. The significance is that a patent endorsed with the words 'licences of rights' does not retain the exclusive right of the patentee. Any other person can apply for a right to use the invention after the expiry of three years from the date of sealing of the patent. The Controller would grant patent to that person to manufacture such substance. In such cases, the inventor's (patentee's) right of exclusive use is limited only to three years. This again is for use of the invention in certain circumstances for general public good.

#### Test of anticipation in patent cases

The dictionary meaning of the word "anticipation" is act of anticipating, previous notion, etc. Any information as to alleged invention given by any prior publication must be for the purpose of practical utility equal to that given by the subsequent patent. The latter invention must be described in the earlier publication that is held to anticipate it, in order to sustain the defence of anticipation. Where the question is solely one of prior publication, it is not enough to prove that an apparatus described in an early specification could have been used to produce this or that result. It must also be shown that the specifications contain clear and the unmistakable directions to use it. It must be shown that the public have been so presented with the invention that it is out of the power of any subsequent person to claim the invention as his own.

Moreover, the antecedent statement, must, in order to invalidate the subsequent patent, be such that a person of ordinary knowledge of the subject would at one perceive and understand and be able to practically apply the discovery without the necessity of making further experiments and must, for the purposes of practical utility, be equal to that given by the subsequent patent.

So the publication relied upon by the opponent for such ground must satisfy the following requirements:

- (i) It must have been affected before the priority date of the claim which is subject of attack by the opponent.

- (ii) Such publication may include any specification filed in pursuance of an application for a patent made in India or any other document published anywhere.
- (iii) The claim attacked must be contained in any of the said publication.

#### **Balance of convenience and patent**

The balance of convenience has also an important role to play. Stultification of a person's investment, loss of employment, public interest in the product (such as life saving drug), product quality coupled with price, or the party being smaller in size, may go against other party. The cases of bridgehead, i.e., only a short period to go before expiry of a person's or party's patent, parties being of equal size, etc. may go in favour of another person. The case of snow-ball, i.e., more future infringements may not tilt the balance in favour of a party.

#### **Protection to unused patents**

Justice Douglas has stated in respect of prefection to unused patents thus: "It is common practice to make an invention and to secure a patent to block off a competitor's progress. By studying his ware and developing an improvement upon it, a concern may, "fence in" a rival, by a series of such moves it may pin the trade enemy within a technology which rapidly becomes obsolete. As often as not, such manoeuvres retard, rather than promote, the progress of useful arts. Invariably their effect is to enlarge and to prolong personal privilege within the public domain."

Justice Douglas has also stated in a dissenting judgment that one patent is used merely to protect another. The use of a new patent is suppressed so as to preclude experimentation which might result in further invention by competitors.

In this respect it can be said that in case of an invention or discovery which unlocks the doors of science and reveals the secrets of a dreaded disease, it is possible that a patentee could be permitted to suppress that invention by the terms of a letters patent and withhold from humanity, the benefit of the cure.

#### **Guidelines for restrictive patentable sectors etc.**

The Government of India has formulated the draft guidelines for the newly amended Patent Act, 2005. As per the guidelines, non-inventions, inventions relating to atomic energy, or those contrary to public order or causing serious prejudice to human beings, animals, health or environment will not be patentable.

These draft guidelines have been put for public comments. They envisage that any process for medical, surgical, curative, diagnostic and therapeutic treatment of human beings or animals is not patentable under the Patents Act. The patents however can be obtained for surgical, therapeutic or diagnostic instruments.

The draft guidelines relate to the practice and procedure to be followed in examination of patents application in India. They also aim at making industries, research and development organizations, individual researchers and inventors familiar with the patents system in India. They provide for a user-friendly system for obtaining as well as maintaining patents under the existing legal system.

While clones and new variety of plants are not patentable, the process or method of preparing genetically modified organisms are patentable subject-matter.

The Draft guidelines also include procedure for examining inventions in the software sector. As per the guidelines, claims relating to software programme products, which are nothing but computer programmes *per se* simply expressed on a computer readable storage medium, are not patentable. However, an invention involving hardware along with software or a computer programme in order to perform the function of a hardware may be considered patentable, for instance, embedded systems.

Further, mere discovery of a scientific principle or formulation of an abstract theory or discovery of any living thing or non-living substance will also not be eligible for a patent. Similarly, literary, dramatic, musical or artistic works or any other aesthetic creation, including cinematographic works and television products, are not patentable, according to the guidelines.

When a patent is granted to two or more persons, each will be entitled to an equal undivided share in the patent unless an agreement to contrary is in force. All can enjoy their rights for their own benefits without accounting for the others but the licence cannot be given to any other person, or its assignment cannot be done without the consent of others.

Similarly, when a patented article is sold by one of two or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming the article through him shall be entitled to deal with the article in the same manner as if the article had been sold by a sole patentee.

Further, the Controller of Patents can, at any point of time, revoke a patent if the criteria like novelty are not fulfilled. The violation of conditions or false information given in the disclosure forms can also lead revoking of patents.

## 2 Protectable Subject Matter— Patentable Invention



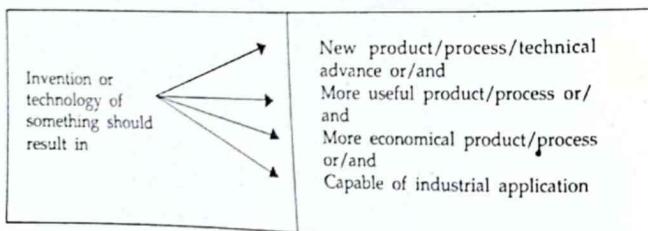
The protectable subject-matter of a patent is an invention.

Section 2(1)(j) of Patents Act, 1970 defines an invention as a new product or process involving an inventive step and capable of industrial application. Section 2(1)(ja) defines an 'inventive step' as a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art. The Patent Rules, 2003, rule 2(c) defines "article" as including any substance or material, and any plant, machinery or apparatus whether affixed to land or not.

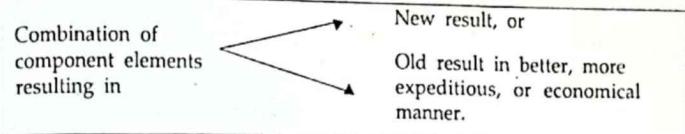
Section 2(l) which was added by the Patents (Amendment) Act, 2005, defines "new invention" as any invention or technology which has not been anticipated by publication in any document or need in the country or elsewhere in the world before the date of filing of patent application with complete specification i.e., the subject-matter has not fallen in public domain or that it does not form part of the state of the art.

### Intangibles are not patentable

The question whether there is an invention is a question of fact in each case. What is protected is the result of an invention: the resultant product, so to say. An improvement on something known is a subject-matter of a patent, provided it results in a new product or process or a more useful or a more economical product or process.



A patentable combination is the one in which the component elements are so combined as to produce a new result or to arrive at an old result in a better or more expeditious or more economical manner.



If the result produced is either a new article or a better or a cheaper article than before, the combination will be entitled to a patent.

For example, the known component of Aspirin, namely, Acetyl Salicylic Acid is found to be produced by a method which produces ten times the quantum of Aspirin from the same input. Such method of manufacture yields the old result, i.e., Aspirin, but does it in a more economical manner. Such method would be entitled to patent protection.

The mere combination of two or more elements without exercising any inventive faculty and without involving an inventive step cannot be a subject-matter of patent.

An 'alleged invention' means something which is alleged to be a manner of new manufacture even though it may not be so. However, such an invention of a manner of new manufacture has to have the elements of novelty, utility and non-obviousness to qualify it for grant of patent.

Improvement of a manner of manufacture means any useful modification of an already known manner of manufacture of an article or substance, whether such a previously existing manner of manufacture is patented or not.

Thus, to be patentable an invention has to be new product or process involving an inventive step and capable of industrial application. An invention also includes an inventive step.

An invention of the above kind must not be unpatentable within the Act. In other words, it should not be an invention prohibited from being patented under the Act.

### INVENTIONS WHICH ARE NOT PATENTABLE UNDER THE ACT

Sections 3 and 4 of the Indian Patents Act, 1970 lists the following as not being inventions within the meaning of the Act and therefore, being unpatentable:

- (1) An invention which is frivolous or which claims anything obviously contrary to the well established natural laws.
- (2) An invention, the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health, or to environment.
- (3) The mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature.

- (4) The mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the 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 atleast one new reactant.
- (5) 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.
- (6) The mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way.
- (7) A method of agriculture or horticulture.
- (8) Any process for the medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products.
- (9) Plants and 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 and animals.
- (10) A mathematical or business method or a computer programme *per se* or algorithms.
- (11) Literary, dramatic, musical or artistic work or any other aesthetic creation including cinematographic works and television productions.
- (12) A mere scheme or rule or method of performing mental act or method of playing game.
- (13) A presentation of information.
- (14) Topography of integrated circuits.
- (15) An invention which, in effect, is a traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component.
- (16) An invention relating to atomic energy.

#### PATENT OF ADDITION

If a person who has applied for patent or a person who has already obtained a patent makes an application to the Controller in respect of any improvement in or modification of an invention described or disclosed in the complete specification of the invention, the Controller may grant patent for such improvement or modification. Such patent for improvement or modification is termed as Patent of Addition.

Where an invention, being an improvement in or modification of another invention, is the subject of an independent patent and the patentee in respect of that patent of improvement or modification is also the patentee in respect of the patent for the main invention, the Controller may, on request of such patentee, revoke the patent for improvement or modification and grant to the patentee a patent of addition bearing the same date as that of the patent so revoked.

However, a patent shall not be granted as a patent of addition unless the date of filing of the application was the same as or later than the date of filing of the application in respect of main invention. The Patents (Amendment) Act, 2005 has added a new provision that a patent of addition shall not be granted before grant of the patent for the main invention.)

#### TERM OF PATENTS OF ADDITION

A patent of addition shall be granted for a term equal to that of patent for the main invention or for so much of the term for the patent of main invention as has not expired. However, if the patent for the main invention is revoked, the Court or the Controller, on request made by the patentee may order that the patent of addition shall become an independent patent for the remainder of the term for the patent of the main invention. No renewal fees shall be payable in respect of patent of addition, but if any patent becomes an independent patent, the same fees shall thereafter be payable, as if the patent had been originally granted as an independent patent.)

#### PROCESS PATENT

A patent can be granted to a new and useful:

- (1) Product, or
- (2) Process

The definition of the term 'invention' includes an inventive step which is capable of industrial application. An invention that involves technical advance as compared to the existing knowledge or having economic significance or both that makes the invention not obvious to a person skilled in the art is also included in this definition.

In fact, the Act recognises only the process patents in foods and drugs, and not product patents in them. There has been a clash between India and the other signatories of the World Trade Organisation (WTO) in this regard. The other members of WTO want India to grant product patents also in the above categories of goods. India being a signatory to the WTO agreement cannot escape the requirement of amending the Act to grant patents for products in these categories.



### Procedure for obtaining Patent

3

✓ Procedure for obtaining a patent consists of the following steps:-

- (a) Submission of application.
- (b) Examination of application.
- (c) Advertisement of acceptance of complete specification.
- (d) Opposition to grant of patent to the applicant.
- (e) Hearing of the parties.
- (f) Grant and sealing of patent.

#### SUBMISSION OF APPLICATION

Sections 6 to 11 of the Act list the conditions which are to be satisfied by the applicant while submitting application for grant of a patent. Section 6 of the Act stipulates the persons entitled to apply for a patent. Section 7 provides the Form for the patent application to be filed in Patent Office (for only one invention) and also provides for international application under Patent Cooperation Treaty. Section 8 lays down information and undertaking regarding foreign applications which are required to be furnished under the Act.

Sections 9 and 10 list the contents of provisional and complete specification to be filed with the application describing the invention, method of performing, claim of invention and the provision for technical information, alongwith the provision for the international application for invention, respectively.

#### Persons entitled to apply for patents

Section 6 provides that a patent application can be made:

- (a) by any person claiming to be the true and first inventor of the invention,
- (b) by any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application,
- (c) by the legal representative of any deceased person, who immediately before his death was entitled to make such an application.

An application can be made by any person either alone or jointly with any other person.

The Patent Rules, 2003 specifies the procedure for application for patents. Rule 10 provides the period of proof and Rule 11 specifies the order of recording applications.

The Patents (Amendment) Rules, 2006 provides for new Form of Patent.

16

#### *Procedure for Obtaining Patent*

17

#### **First-to-apply system**

The statute is based on the first-to-apply system, sort of first come first served principle. That is, a person who applies first gets the patent. In case an inventor is first to invent but applies for a patent later—any time after another inventor has made an application, he will not be entitled to get the patent.

#### **Meaning of true and first inventor**

A person who is the first one to convert the ideas and scientific principles into a working invention, is the first and true inventor. A person who merely communicates an idea to another cannot claim to be the true and first inventor and so is not entitled to apply for a patent.

*Example:* A physics teacher explains a principle in his class. One of his students makes a working invention producing a new result by putting into use the principle taught by his teacher. The student is the true and first inventor and the one entitled to apply for a patent and not the teacher.

#### **Assignee of an inventor may apply**

The right to apply for a patent may be assigned by the true and first inventor on another. On such an assignment, the assignee is entitled to apply for a patent.

#### **Inventions made by an employee**

Where an employee makes an invention during his employment, he would be entitled to apply for a patent.

The person entitled to apply in such a situation would be determined by the contractual relationship, whether express or implied, between the employer and the employee. In general, the inventions made by an employee even though made during employer's time and with employer's materials and expense, would be patentable in the name of the employee unless a specific contract provides otherwise.

It is not so in case of inventions made by employees specifically employed for research and development. In such cases the inventions belong to the employer and he is entitled to apply for the patent.

When, for instance, an invention is made by a Scientist in the Government Forensic Science Laboratory, the invention would belong to the Department of Science of the Government and the person entitled to apply would be the Secretary of the Department. However, the right to apply has to be assigned to such Secretary by inventor-employee Scientist.

#### **Form of application**

Section 7(1) provides that only one application can be made for one invention and it has to be made in the prescribed form (available in the Patent Office) and filed in the Patent Office.

Every specification, whether provisional or complete, shall be made in Form 2 prescribed under the Patents Rules, 2003.

Section 7(1A) provides for application for international patent under Patent Cooperation Treaty.

Section 7(1B) provides that the filing date of an application referred to in subsection (1A) and its complete specification, processed by the patent office as

18 designated office or elected office, shall be the international filing date accorded under the Patent Co-operation Treaty.

Section 7(2) provides that where an application is made by virtue of an assignment of the right to apply for a patent for the invention, there shall be furnished with the application or within such period as may be prescribed after the filing of the application, the proof of the right to make the application, i.e., some document showing that assignment by the true and first inventor has actually been made in favour of the applicant.

Section 7(3) lays down that every application shall state that the applicant is in possession of the invention and shall name the person claiming to be the true and first inventor and where the person so claiming to be true and first inventor is not the applicant (for instance an employee) the application shall contain a declaration that the applicant (for instance, an employer assignee) believes the person so named to be the true and first inventor.

Section 7(4) provides that every such application (not being a convention application or an application filed under the Patent Co-operation Treaty designating India) shall be accompanied by a provisional or a complete specification. It also provides that where an application is made by a foreign national of a convention country, i.e., a country offering the reciprocal right to an Indian citizen to apply for a patent in that country, the patent application is to be accompanied with the complete specification and not provisional specification.

#### Procedure for Registration of Patent

File application in the patent office



Provisional/Complete specification should be filed



Acceptance of specification



Publication of application



Request for examination of application



Report of Examiner



Approval      Objections      Division of application

Amendment of objections

Patent is granted

#### SPECIAL PROVISION FOR FOREIGN APPLICANTS

Section 8 provides that where an applicant for a patent is prosecuting, either alone or jointly with any other person, an application for a patent in any country outside India in respect of same or substantially the same invention, he shall file alongwith the application or subsequently within the prescribed time [as the Controller may allow]:

- (1) a statement setting out detailed particulars of such application,
- (2) an undertaking, that upto the grant of patent in India, he would keep the Controller informed in writing from time to time, of detailed particulars as required, in respect of every other application relating to same or substantially the same invention.

However, at any time after an application for patent is filed in India, till the grant or refusal to grant of the patent, the Controller may also require to furnish details relating to the processing of the application in a country outside India. The statement and undertaking required to be filed shall be made in Form 3 as specified in the Patents Rules, 2003.

#### THE APPLICANT TO FILE PROVISIONAL AND COMPLETE SPECIFICATION

Section 9 provides that where an application for a patent (not being a convention application or an application filed under the Patent Co-operation Treaty designating India) is accompanied by a provisional specification, a complete specification shall be filed, within twelve months from the date of filing of an application, and if it is not so filed, then the application shall be deemed to have been abandoned. However, where an application for a patent (not being a convention application or an application filed under Patent Cooperation Treaty designating India) is accompanied by a specification purporting to be a complete specification, and if the applicant requests within twelve months from date of filing of the application, the Controller may direct that such specification shall be treated as provisional specification and proceed with it accordingly. Every specification, whether provisional or complete, shall be made in Form 2 as specified in the Patents Rules, 2003.

#### What is a specification?

A patent specification is a technical document describing the invention. A specification may be provisional which gives the initial description of an invention when the application is filed. A complete specification gives full and sufficient detail of an invention in such a manner that a person skilled in the art can use the invention when he reads such a description. The purpose of filing a specification is to make available the invention to the public on the expiry of the term of the patent.)

Section 10 of the Act lists the contents of the complete specification as follows:—

NAMED

- (1) The invention shall be titled sufficiently indicating the subject-matter to which the invention relates. DESCRIPTION, USE & METHOD
- (2) The full and particular description of the invention and its operation or use and the method by which it is to be performed.)
- (3) The disclosure of the best method of performing the invention which is known to the applicant and for which he is entitled to claim the protection. BEST METHOD FOR WHICH
- (4) The claims defining the scope of the invention for which the protection is claimed.

- 20 **ABSTRACT**
- (5) The specification shall be accompanied by an abstract to provide technical information on the invention.
  - (6) In case of an international application designating India the title, description, drawings, abstract and claims filed with the application shall be taken as a complete specification. **INTERNATIONAL APP.**
  - (7) The claim(s) of a complete specification shall relate to a single invention, or to a group of inventions linked so as to form single inventive concept, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification. **CLAIMS RELATE**
  - (8) The declaration as to the inventorship of the invention, shall be furnished within the period prescribed after filing of the specification. **INVENTORSHIP**
  - (9) The complete specification filed after a provisional specification may include claims in respect of developments of, or addition to the invention which was described in the provisional specification, being developments or additions in respect of which the applicant would be entitled under the provisions of section 6 to make a separate application for a patent.

*Anticipation*  
Section 10(2) provides that a Controller may require drawings to be supplied, which shall form part of the specification.

A claim is a feature of the invention over which the applicants claims an exclusive right. It defines monopoly. The function of a claim is to define and limit with precision what it is, which is claimed to have been invented and therefore, entitled for the patent protection.

It is not necessary for a specification to explain all the advantages of an invention. It is also not necessary to describe the manner of performance of the invention with that length of detail with which the specification of the manufacturer of something is usually put before the workman, who is engaged to manufacture it; *Amp. Inc. v. Utilix Pty. Ltd.*, (1973) RPC 175.

#### PUBLICATION AND EXAMINATION OF THE APPLICATION

The Patents Act, 1970, as amended by Patents (Amendment) Act, 2005, provides that the application for patent shall ordinarily be open to the public for such period as may be prescribed. However, the applicant may request the Controller to publish his application before the expiry of the period prescribed and subject to certain exceptions, the Controller shall publish such application as soon as possible.

Every application for a patent shall, on expiry of the period prescribed, be published except in few cases:

- (a) where the application is one in which secrecy direction is imposed under section 35. **SECRECY DIRECTION**
- (b) where the application has been abandoned under section 9.
- (c) where the application has been withdrawn three months prior to the period specified.

However, in case of a secrecy direction having been given, it shall be published after the expiry of the period specified or when the secrecy direction has ceased to operate, whichever is later.

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#### Procedure for Obtaining Patent

21

The publication of every application shall include:

- (a) particulars of the date of application,
- (b) number of application,
- (c) name and address of the applicant,
- (d) an abstract.

Thereafter, upon publication of an application for a patent, the patent office may make the specifications and drawings (if any) of such application available to the public.

The Patents (Amendment) Act, 2005 provides that on and from the date of application of patent and until the date of grant of patent, the applicant shall have the like privileges and rights as if a patent for invention had been granted on the date of publication of the application. The applicant shall not be entitled to institute any proceedings for infringement until the patent has been granted. However, rights of a patentee in respect of applications made under section 5(2) before January 1, 2005, shall accrue from the date of grant of the patent. The patent holder, in such a case, shall be entitled to receive reasonable royalty from such enterprises which have made significant investment and were producing and marketing the concerned product prior to January 1, 2005, and which continue to manufacture the product covered by the patent, on the date of grant of patent and no infringement proceedings shall be instituted against such enterprises.

When a request for examination has been made in respect of an application for a patent under section 11B, the application and specifications and other documents related shall be referred at the earliest by the Controller to the examiner for making a report in respect of the following matters:

- (1) whether the application and the specifications and other documents related thereto, are in accordance with the requirements of the Act and the rules made thereunder, **IN ACCORDANCE WITH PATENT ACT & LAW**
- (2) whether there is any lawful ground of objection to the grant of patent,
- (3) the result of investigation made under section 13,
- (4) any other matter, which may be prescribed.

The Examiner makes a search in the applications, specifications and other documents of prior applications and specifications of patent already granted, to see whether the same invention has already been published or claimed or is subject-matter of existing or expired patents. The examination of application shall be made in accordance with Form 18 of Patents Rules, 2003.

#### COMMUNICATION TO THE APPLICANT

If, on examination, any objections are raised by the Patent Examiner concerned, the Patent Office will communicate to the applicant the objections so raised. The objections generally relate to the drafting of the specification and claims, anticipation of any of the claims in any prior publication of any specification or claims or documents, or prior publication of the invention in some book or journal.

The applicant is to make the amendment sought. If such amendments are not made within fifteen months from the date on which the first statement of objections to the application or complete specification is forwarded by the Controller to the applicant, the application is deemed to have been abandoned. Such period of making amendments can be extended to a maximum of 18 months

22 on a request for extension being made by the applicant. If the objections are not satisfactorily rectified, the Controller, after giving an opportunity of hearing to the applicant, may refuse the acceptance of the application.

#### **OPPOSITION PROCEEDINGS TO GRANT OF PATENT**

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 patent on the grounds:

- (1) The applicant had wrongfully obtained the complete invention or a part thereof from a person under or through whom he claims.
- (2) Such an opposition can be envisaged in a case where there have been two inventors engaged in arriving at an invention. In case one of them files an application himself or through his assignee, the other inventor or his legal representative, in case he is dead, can oppose the application on the ground of wrongfully obtaining of a part of invention when the other inventor had invented a major portion of the invention and his invention having been stolen and proclaimed by the former as being his own.
- (3) Prior publication in any Indian specification or prior publication in any other document in India or elsewhere.
- (4) The invention has been the subject-matter of a prior claim in an application which is prior in time than the applicant's claim.
- (5) The invention as claimed in the complete specification was publicly known or publicly used in India before the applicant's claim.
- (6) The invention as claimed by the applicant in his complete specification is obvious and does not involve any inventive step.
- (7) The invention is not patentable or its patenting is prohibited under the Act.
- (8) The complete specification of the applicant does not sufficiently and clearly describe the invention or the method by which it is to be performed.
- (9) In case of foreign application, the failure to disclose information relating to such application filed in a foreign country.
- (10) In case the complete specification does not disclose or wrongly mentions the source or geographical origin or biological material used for the invention.
- (11) In case the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.

The Controller shall, if requested by such person for being heard, hear him and dispose of such representation in such manner and within such period as may be prescribed.

However, at any time after the grant of patent but before the expiry of one year from the date of publication of grant of patent, any person interested may give notice of opposition to the Controller, on any of the similar grounds mentioned aforesaid.

Where any such notice of opposition is duly given, the Controller shall notify the patentee and shall constitute a Board, refer such notice of opposition along

with the documents for examination and submission of its recommendations to the Controller. The Opposition Board, after giving the patentee and opponent, an opportunity of being heard, shall submit its recommendations to the Controller, and the Controller shall order either to maintain, or to amend, or to revoke the patent, though while passing an order, the Controller shall not take into account any personal document or secret trial or secret use.

Chapter VI of the Patents Rules, 2003 deals with the Opposition proceedings. Rule 55 states that opposition by representation against the grant of patent be duly filed in Form 7 and sent to the Controller in duplicate. Rule 57 lays down rule regarding the filing of written statement of opposition and evidence.

#### **GRANT OF PATENT**

When the application for a patent has been found in order for grant of the patent and:

- (1) the application has not been refused by the Controller by virtue of any power vested in him,
- (2) the application has not been found to be in contravention of any of the provisions of the Act,

then the patent shall be granted as expeditiously as possible with the seal of the patent office, and the date on which the patent is granted shall be entered in the register. On the grant of the patent, the Controller shall publish the fact that the patent has been granted and it shall be open for the public inspection. A patent shall be granted for one invention only.

The decision of the Controller, if it is against the applicant, can be appealed against in the Appellate Board.

#### **TERM OF THE PATENT**

Section 53 of the Act lays down that the term of patent after the commencement of the Patents (Amendment) Act, 2002 or the term of every patent which has not expired and has not ceased to have effect, on the date of commencement of the said Act, shall be twenty years from the date of filling of the application for the patent.

Similarly, the term of patent in case of international applications filed under the Patent Co-operation Treaty designating India, shall be twenty years from the international filing date accorded under the Patent Co-operation Treaty.

#### **JOINT INVENTORS**

The inventor is the person who thinks of the invention, not somebody who merely builds something described by another party. If an idea arises as a result of a discussion among several people, all those who contributed to the resulting invention are joint inventors. Where the application for patent is made by two or more joint applicants, an application for substitution of one of the joint applicants will not be allowed, except with the consent of the other joint applicants. This is in consonance with the principle that a co-owner of a patent cannot assign his rights without the consent of the other co-owners. On the death of a joint applicant before the patent is granted, the Controller may, on a request made by the survivors and with the consent of the legal representative of the deceased, direct the application to proceed in the name of the survivors alone.

#### **COMPULSORY LICENCE**

The term of patent can, however, be cut short by the grant of 'compulsory licence' or 'licence of right' to any person to work the invention when the patentee fails to work the invention in public interest.

**PATENT OFFICES IN INDIA**  
**INTELLECTUAL PROPERTY OFFICES**

Shri S.Chandrasekran,  
Controller General of Patents,  
Designs & Trade Marks  
Bhoudhik Sampada Bhavan,  
Near Antop Hill Head Post Office,  
S.M. Road, Antop Hill, Mumbai-400037,  
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Website: www.ipindia.nic.in

Address with Phone Nos and email	Contact Person	Jurisdiction
The Patent Office, Intellectual Property Office Building, G.S.T. Road, Guindy, Chennai-600032, Phone: 044-22322804-25, Fax: 044-22322878, Email: chennai-patent@nic.in	H.C. Bakshi, Sr. Joint Controller of Patents & Designs	The States of Andhra Pradesh, Karnataka, Kerala, Tamil Nadu and Pondicherry and the Union Territories of Laccadive, Minicoy and Aminidivi Islands.
The Patent Office, Intellectual Property Office Building, Plot No. 32, Sector 14, Dwarka, New Delhi-110075, Phone: 011-28081922-25, Fax: 011-28081920-40, Email: delhi-patent@nic.in	P.K. Patni, Deputy Controller of Patents & Designs	The States of Haryana, Himachal Pradesh, Jammu and Kashmir, Punjab, Rajasthan, Uttar Pradesh and Delhi and the Union Territory of Chandigarh.
The Patent Office, Office of the Trade Marks Registry, Bhoudhik Sampada Bhavan, Near Antop Hill Head Post Office, S.M. Road, Antop Hill, Mumbai-400037, Phone: 022-24130387, Fax: 022-24130388, Email: mumbai-patent@nic.in	M.A. Haafeez, Assistant Controller of Patents & Designs	The States of Gujarat, Maharashtra, Madhya Pradesh and Goa and the Union Territories of Daman and Diu and Dadra and Nagar Haveli.
The Patent Office, Intellectual Property Office Building, CP-2 Sector V, Salt Lake City, Kolkata-700091, Phone: 23671945, 1946, 1987, Fax: 033-2367-1988, Email: kolkata-patent@nic.in	N.R. Seth, Deputy Controller of Patents & Designs	Rest of India

**Provisional and Complete Specification**

**SPECIFICATION**

To explain an invention, a description of the same is essential. An invention needs to be explained to enable the general public to use the invention on the expiry of the protected period. The description of the patent is called 'specification'. The specification is an essential part of a patent application. The description of the invention in the specification is in fact, the consideration in lieu of which an exclusive right in the form of patent is granted.

**Contents and form of specification**

- (a) The specification begins with the title sufficiently indicating the subject-matter of the invention.  
For instance title: MECHANISED RESPIRATOR.  
(See the format of a specification attached). Every specification, whether provisional or complete, shall be made in Form 2 as specified in the Patents Rules, 2003.
- (b) The full description of the invention and the method by which it is to be performed must be given. It should describe the best method of performance known to the applicant. (See the format of a specification attached).
- (c) The specification must end with a claim or claims defining the scope of the invention for which protection is claimed. The claims should relate to one invention only and not be stated in a general manner. The claims must be clear and be fairly based on the invention disclosed.
- (d) The specification must be accompanied by an abstract to provide technical information on the invention.
- (e) In case of an international application designating India, the title, description, drawings, abstract and claims are to be filed with the application.
- (f) A declaration as to the inventorship of the invention should also be given.
- (g) A complete specification may include claims in respect of developments of, or additions to, the invention which was described in a provisional specification, being developments or additions in which the applicant would be entitled to make a separate application for a patent.

**Nature of the patent specification**

A patent specification is not merely a description of the invention but it is also a technical and legal document. The importance of the claims in a specification is realised when the technical interpretation of the specification is considered by the Examiner in the Controller's Office. The description should satisfy the Examiner concerned that there indeed is an invention. The importance of specification arises when any party alleges that the specification of the applicant does not fully and sufficiently describe the invention and opposes the application on such ground. The specification has then to successfully meet the ground of opposition which it can do only if it gives sufficient description of the invention.

**KINDS OF SPECIFICATION**

Depending upon the sufficiency of description, a specification may be either:

- (1) Provisional specification, or
- (2) Complete specification.

**Provisional specification**

While an inventor is in the process of finalising his invention, he may file a specification known as 'Provisional Specification' which is not a full and specific description. It contains only a general description of the invention, its field of application and anticipated results. The Provisional Specification need not contain the claim(s).

**Need to file a Provisional Specification**

A provisional specification is filed to fix the priority date of the patent. Since the Indian patent law is based on the 'first-to-apply' principle, the inventor who first files provisional specification with claim(s) secures his invention against a similar claim for a patent being applied later by another inventor. The priority date of a claim is the date on which a specification containing the claim is filed. Normally, the priority date is the date of filing the provisional specification provided the claims are based on the matter disclosed in the provisional specification.

**Provisional Specification to be followed by Complete Specification**

According to the provisions of section 9 of the Act, where an application for patent, not being a convention application or an application filed under the Patent Co-operation Treaty designating India, is accompanied by a provisional specification, a complete specification shall be filed within twelve months from date of filing of the application and if the complete specification is not filed, the application shall be deemed to be abandoned.

This provision ensures that the rights of any other inventor in the same field of research are not kept in suspended animation by denying them the right to seek a patent for the same invention in case the prior applicant of the patent fails to develop his invention to a working stage during the permissible period. The Controller is not to wait indefinitely for such an applicant to file his complete specification. When a complete specification does not follow a provisional specification within the maximum period of fifteen months, the patent application is deemed to have been abandoned.

During the period between the filing of the provisional specification and complete specification, the inventor may conduct further research on the subject-matter of his invention and improve the method of carrying out the invention or introduce further developments or additions to the invention which he can incorporate in the complete specification and the claims.

When a complete specification and the claims mentioned therein are fairly based on the matter disclosed in the provisional specification, the applicant gets the liberty to publish or use his invention after the date of filing the application without endangering the value of the patent when granted in course of time.

**Complete specification**

The Complete Specification is the full description of the invention containing all the claims over which the applicant seeks monopoly right. The object of a complete specification is to define clearly and with precision the monopoly claimed so that others may know the exact boundaries of the monopoly right of the applicant.

**The contents of a Complete Specification are:**

- (1) Title sufficiently indicating the subject-matter to which the invention relates (See attached specification).
- (2) A full and particular description of the invention and its operation or use and the method by which it is to be performed.
- (3) A disclosure of the best method of performing invention which is known to the applicant and for which he seeks to claim protection.
- (4) The claim(s) defining the scope of the invention. The claim(s) must relate to one invention only. The claim(s) must be clear and precise.
- (5) The specification must be accompanied by an abstract to provide technical information on the invention.
- (6) In case of an international application designating India, the title, description, drawings, abstract and claims to be filed with the application.
- (7) A declaration as to the inventorship of the invention.
- (8) A complete specification filed after a provisional specification may include claims in respect of developments of, or additions to, the invention which was described in the provisional specification, being developments or additions in respect of which the applicant would be entitled, to make a separate application for patent.

**PRIORITY DATE OF A CLAIM**

The priority date is important in determining whether the invention is indeed new keeping in view the present state of knowledge in the given field. The priority date is the date on which the patentee claims his invention. Since a provisional specification is generally filed much before the filing of complete specification, the priority date is the date of filing of the provisional specification provided the claims contained therein are fairly based on the description of the invention as given in the provisional specification. The novelty of an invention is

tested with reference to the existing state of knowledge on such priority date. If the applicant's invention is novel and non-obvious to a person skilled in the art appropriately aware of the recent developments on such date, the invention qualifies the test of novelty and non-obviousness.

### THE INTERPRETATION OF SPECIFICATION AND ITS IMPORTANCE

The specification is the essence of the invention. It builds the boundaries around the monopoly right of the applicant. Anything falling outside the limits of such boundary cannot be claimed by the applicant. Any right within the limits of the specification cannot be denied. Therefore, the drafting of the specification is of utmost importance in creating the exclusive right and maintaining such right.

The claims must include all possible equivalent variations of the invention to guard against infringement.

For instance when a feature of an invention is a movable coil with the help of a spring, the applicant must claim that any movable arrangement of a coil whether with a spring or any other equivalent mechanism, would be an equivalent variation of the invention. The aim of the applicant should be to obtain the broadest possible valid claims. The validity of a patent can be challenged if the claims are vague or too broad. The specification, therefore, has to be drafted by skilled professionals.

The claims constitute the most important part of the specification due to the fact that the validity of a patent is often attacked both in the opposition proceedings before the Controller and in infringement proceedings before courts on the ground of some error(s) in the claim.

### CLAIMS

The claims can be categorised as:

- Claim which is the main claim—It should state what the invention is in the broadest possible terms.
- Subordinate claim(s)—which claim(s) refer to the additional feature(s) of the invention.
- Omnibus claim—which relates to any arrangement substantially as described and as shown in the drawings.

The omnibus claim protects the applicant from infringement of his invention by creation of equivalent alternatives.

The claims should be drafted in such a manner that designing around the patent is not easily possible.

When question arises as to what forms part of claims and what not, the construction of the claims assumes importance.

The principles of the construction of specification:

- The complete specification must be read as a whole in the context of surrounding circumstances prevailing at the date of publication of the specification without regard to subsequent infringement or conduct of the patentee.

The pith and marrow of the claim, that is novelty and newness of the product or process, have to be considered.

- The claim itself marks out the legal limits of the monopoly granted by the patent. If an applicant fails to claim something, it is considered as being disclaimed. He cannot later claim that the features which he failed to mention were a part of his claim.
- The language of the claim must be clear and unambiguous so that the claim cannot be restricted, expanded or amended by a reference to some limitation in the language used in the claim or in any earlier part of the specification. For instance, an applicant cannot say that he meant something in a claim but forgot to draft it in a precise manner. However, for clarity, the rest of the specification can be referred to for deducing the real meaning of the technical terms and to resolve any ambiguities in the construction of the claim.
- The meaning of a specification is addressed to a person skilled in the art; whose level of knowledge extends to the state of art in the particular field at the time of the invention. What is new and non-obvious is determined with reference to the level of knowledge of such a person.
- The subjective opinion of the patentee or his witnesses regarding the invention are immaterial in arriving at the meaning of claims.
- The court of competent jurisdiction is the authority to interpret the specification. The court can call expert evidence to explain the meaning of technical or specific terms and phrases used in the specification.
- If the other party relies on documents other than the complete specification to plead invalidity of the patent, such a document would be inadmissible.
- The meaning of the claim is to be the same whether for the purpose of infringement or challenge to its validity.

### WHETHER A SPECIFICATION CAN BE AMENDED ONCE IT HAS BEEN FILED

A complete specification once filed is not absolute. It can be amended, subject to certain conditions, at the following three stages:

- Before acceptance.
- After acceptance.
- After the sealing of patent.

### Amendment before acceptance

The Patents Act, 1970, as amended by the Patents (Amendment) Act, 2005, provides under section 15 that where the Controller is satisfied that the application or any specification or any document filed in pursuance thereof, does not comply with the requirements of the Act or any rules made thereunder, the Controller may refuse the application or may require the amendment in the application, specification or other documents before he proceeds with the application and refuse the application on failure to do so. The amendment may

30 also be sought by the applicant himself. In such a case if the proposed amendment is not based on a matter fairly based on the specification filed earlier, it would be unacceptable. If such amendment does not add a new dimension to the matter covered in the original specification, the date of the applicant would remain the same. That is to say, that in spite of such amendment, the priority date of the specification would remain intact. However, if the amendment sought to be introduced by the applicant brings in matter which is new or which changes the character of the earlier matter in the specification, then the date of the specification would be changed to the date when such amendment is filed. Such an application for amendment will be advertised for anyone to oppose the proposed amendment.

#### **Amendment after acceptance**

When the application has been accepted by the Controller and published in the Official Gazette, a party may oppose any of the claims in the specifications. If the Controller finds merit in the Opposition, he may direct the applicant to amend the specification. However, the Controller shall not pass any order allowing or refusing an application to amend an application for patent or a specification, while any suit before a court for the infringement of a patent or any proceeding before the High Court for the revocation of the patent is pending.

#### **Amendment before the grant of patent**

Before the grant of patent, a person other than patentee, can apply for revocation of the patent before the High Court. The High Court in a given case instead of revoking the patent, may order amendment of the specification to preserve the rights of the patentee.

#### **CONDITIONS FOR AMENDMENT**

An applicant for a patent or a patentee to whom a patent has already been granted, cannot on his own, amend his specification at any stage, i.e., before or after acceptance of the specification. Granting such a liberty would result in repeated changes being incorporated in the specification all the while, thereby keeping the entire process in confusion.

The amendments can, however, be made only under certain conditions imposed by the Act, as below:

#### **Disclaimer**

The amendment must be by way of disclaimer. A disclaimer is a statement by the applicant denying a claim. Such a clause reduces the scope of monopoly by restricting the spread of the claim. For example, a wide claim covering two or more ways of construction can be reduced to a claim which covers only one of those ways of construction. A disclaimer would be read like this: "This invention claims-----but does not claim-----".

#### **Correction**

The amendment can also be for the purpose of correcting an obvious mistake in the specification. The correction which can be made in a specification is limited to any typographical or minor mistakes that have been made in the preparation

of the specification and not any correction so as to produce an effect of the invention being altogether different from what was presented earlier. A mistake may be apparent on the face of the specification in which case the Controller himself may require the applicant to make an amendment. The applicant himself can also seek correction of any such mistake. When the mistake is not apparent on the face of the specification, the applicant, in case he is the one who applies for amendment, has to furnish evidence to support that there indeed was a mistake in the specification.

For instance, where the correction in a specification amounts only to a mere change in the nomenclature, it may be allowed. But in case the amendment completely alters the identity of the compound in the specification, it cannot be allowed.

The correction is not easily allowed where the mistake in the document is clearly incorrect and inconsistent with the body of the specification. For example, an applicant realises after the filing of his specification that he missed out an essential claim, even though it was evident in the specification which if not protected, could enable anybody to design around the patent without being held liable for infringement. He can seek such amendment.

The amendment has to confine itself to the matters disclosed in the earlier specification. The proposed amendment cannot claim or describe matter not in substance disclosed in the earlier specification.

The scope of the specification must not be widened by an amendment. This means that he cannot make a claim for a monopoly right which was not included in the earlier specification.

#### **Explanation**

If something that is sought to be brought in by way of amendment which merely clarifies or better explains some expression in the specification but does not change its meaning or context may be allowed by the Controller or the High Court.

However, where after the date of grant of patent any amendment of the specification or any other document related is allowed by the Controller or by the Appellate Board or the High Court:

1. the amendment shall for all purposes be deemed to form part of the specification along with other documents.
2. the fact that the specification or any other document related thereto has been amended shall be published as expeditiously as possible.
3. the right of the applicant or patentee to make amendment shall not be called in question except on the ground of fraud.

#### **WHO IS TO ALLOW THE AMENDMENT**

An amendment if proposed to be made before the grant of the patent, has to have the approval of the Controller. If a specification is challenged in a revocation proceedings after the grant of the patent before the High Court, that Court would be the appropriate authority to allow the party to amend its specification or claims.

The amendments to the specification cannot be sought by the applicant or any person other than the applicant as a matter of right. The Controller, in case amendment is sought prior to the grant of the patent, and the High Court after such grant on revocation proceedings initiated before it, may grant the amendment in full or in part in exercise of their judicial discretion.

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