

Origin of patent

Term patent has its origin in the term “letters Patent” 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

Indian Patents and Designs Act was enacted in 1911

- Patents bill 1953 was submitted by a Patents enquiry committee based on the United Kingdom Patents act 1949. Bill however lapsed
- Patents bill has been passed by both houses of parliament in 1970
- With amendments in 1974, 1999, 2002, 2005.

Meaning of the term Patent

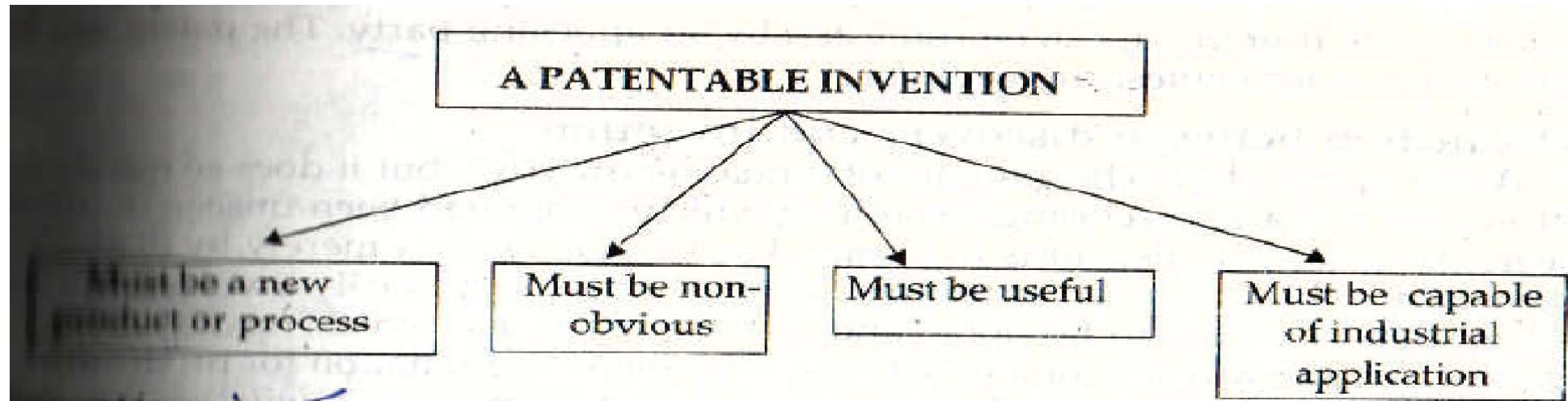
- It grants some privilege ,property or authority made by govt or sovereign of the country to one or more individuals.
- The instrument by which such grant is made is know as patent.
- Term patent got a statutory meaning in India when the patent act 1970 was enacted.
- Patent under the act is granted 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 person to whom a patent is granted is called patentee
- Patent agent means a person for the time being registered under the patents act as a patent agent

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 right over invention is an intellectual property rights
- Owner of the property can deal with it like any other movable property i.e. the patentee can sell the whole or part of his property (patent). He can grant licence to others to use the patented property, or assign the property to any other(s). Such a sale, licence or assignment of patent property is for valuable consideration

Principles underlying the patent law in India

- It must be novel
- It must involve on inventive step
- It must be caplble of industrial application
- Must not fall within any categories of subject matter specific excluded or made subject to expection



Exceptions

- (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

Exceptions

- 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.

Principles underlying the patent law in India

- Invention must be new useful and non-obvious
- Newness
- Usefulness
- Exceptions
- Non-obviousness
- Invention must be disclosed fully
- Distinction between discovery and invention
- Use and acquisition of patented invention by the central government

Procedure for obtaining Patent

- Submission of applications
- Publication and examination of applications
- Opposition to grant of patent to the applicant
- Grant and sealing of patent.

SUBMISSION OF APPLICATIONS

Sections 6 to 11 of the Act list the conditions which are to be satisfied by 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 specifications to be filed with the application describing the invention, method of performing, claims of invention and the provision for technical information, alongwith the provisions 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 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.

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.

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 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.

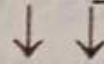
Section 7(4) provides that every such application (not being a convention application or an application filed under the Patent Co-operation Treaty designating India) shall be accompanied by a provisional or a complete specification. It also provides that where an application is made by a foreign national 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

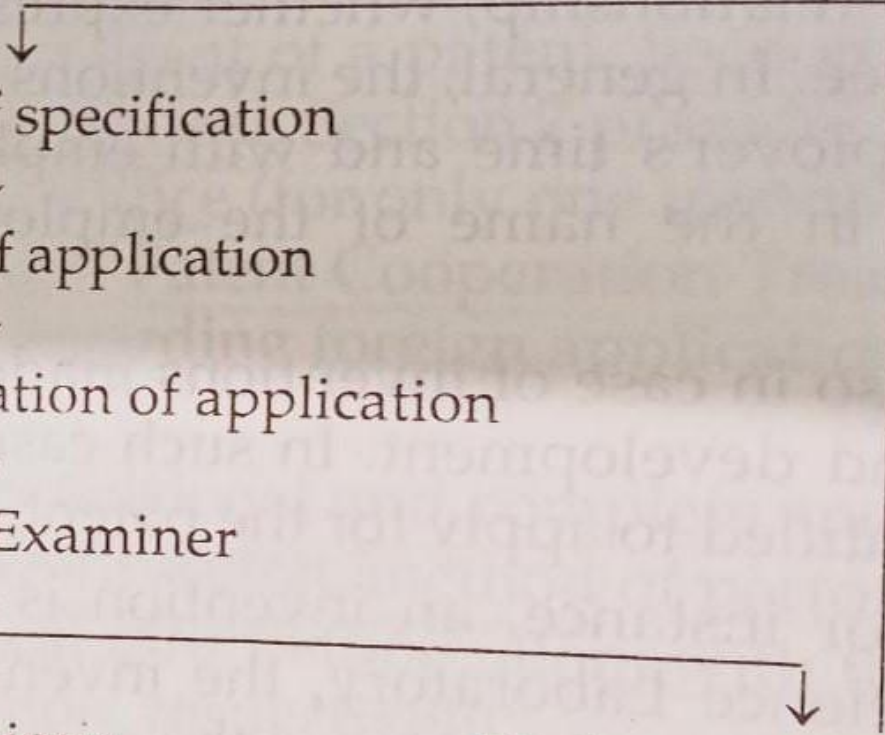
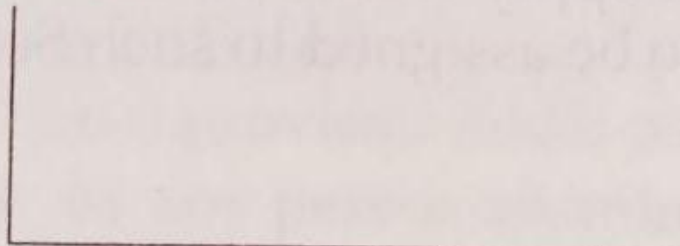
↓
Objections

↓
Division of application

↓
Amendment of objections



Patent is granted



Section 8 Special provisions for foreign applicants

- Provides for

that an applicant for a patent prosecuting singularly or jointly with any other person, an application for patent in any country outside India in respect to the same invention or substantially same in respect to same, along with application or within prescribed time as allowed by controller

- 1 make a statement setting out details of such a application
- 2 make a undertaking to keep controller informed in writing from time to time, of particulars as required, in respect to other application
- Any time after filing of application till time of grant or refusal of patent the controller requires to furnish details regards processing of application in a country outside India using form 3 as per patent rules 2003

Applicant to file provisional and complete specifications Section 9

- Provides for application of patent is accompanied by provisional specs
- A complete specs need to be submitted within 12 months of filing patent application
- If not the application will be deemed to be abandoned
- Were application is accompanied by complete specs as directed by controller may be treated as provisional for 12 months and proceed with it further
- Both provisional or complete specs must be in Form 2 of the Patent rule 2003

Section 10 lists the content of complete specs

- Should be appropriately named as per subject matter of the invention
- Full and particular description of the application description of its operation or use and method by which its is performed
- Disclosure of Best method of performing the invention as known to the inventor for which he can claim protection
- Claim defining scope of invention for which protection is claimed
- Specs must consist of abstract of technical information of the invention

Section 10 lists the content of complete specs

- In case of international application descriptions, title, abstract, drawings, and claim in application is considered as complete specs
- Claims of complete specs related to single invention or multiple inventions forming a concept, must be clear
- Declaration of inventor ship of the invention must furnished within prescribed period after filing the specs
- Complete specs filed after filing provisional specs may contain developments and advancement of the invention as provided by section 6 can file a separate application for patent

Section 10[2] provides

- That controller may require drawings of the invention to be furnished as a part of specs
- Claim is a feature of the invention for the inventor has exclusive right for which the inventor claims protection
- function of Claim is to define describe the scope of the invention and claim for protection
- Specs need not specify the advantages of the invention or the performance in detail with specs of the manufacturer, which is put
Before a workman who is manufacturing it

Publication and examination

- Chapter IV of the Patents act 1970 as amended by Patents act 2005 talks about Publication and examination of applications
- Section 11A provides that no application of patent is available for the public view for 18 months from the date of filing the application or date of the priority of the application which ever is earlier.
- The controller will publish the application as soon as possible
- Every application is published after the aforesaid period except in case of application
 1. filed under section 35 where secrecy direction is imposed
 2. Abandoned under section 9(1)
 3. Has been withdrawn 3 months prior before the prescribed period

Publications must include

- Particulars of date of applications
- Number of the application
- Particulars of the applicant
- An abstract
- There after on publication the patent office may make the drawings, specifications, available to 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.

POWERS OF THE CONTROLLER OF PATENTS

Under section 14 of the Act provides that where, in respect of an application for a patent, the report of the examiner received by the Controller is adverse to the applicant or requires any amendment of the application, the specification or the drawings or documents to ensure compliance with the provisions of the Act or of the rules made thereunder, the controller shall communicate the gist of objections to the applicant and give him an opportunity of hearing.

According to section 16, a person who has made an application for a patent under the Act may, at any time before the grant of the patent, if he so desires, with a view to remedy the objection raised by the controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed. The further application shall be accompanied by a complete specification, but such specification shall not contain any matter not in substance disclosed in the complete specification of the first mentioned application. The Controller may require the amendment of the complete specification, to ensure that neither of the complete specifications includes a claim for any matter claimed in the other.

Section 17 provides that subject to the provisions of the Act, the Controller may, at any time before the grant of the patent, if he so desires, with a view to remedy the objection raised by the controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed. The further application shall be accompanied by a complete specification, but such specification shall not contain any matter not in substance disclosed in the complete specification of the first mentioned application. The Controller may require the amendment of the complete specification, to ensure that neither of the complete specifications includes a claim for any matter claimed in the other.

Section 17 provides that subject to the provisions of section 9, at any time after the filing of an application and before the grant of the patent under the Act, the Controller may, at the request of the applicant direct that the application be post-dated to such date as may be specified in the request and proceed to examine the application accordingly. However, no application is to be post-dated to a date more than six months from the date on which it was actually made or would be deemed to have been made.

Under section 18 where it appears that an applicant has made a claim for any matter claimed in the other

Under section 18, where it appears to the Controller that the invention has been anticipated as referred to under sections 13(2)(1) (a) or 13(2) he may refuse to accept the complete specification unless the applicant—

- (a) shows that the priority date of the claim of his specification is not later than the date on which the relevant document was published; or
- (b) amends his complete specification of the Controller.

According to clause (2) of section 18, if it appears to the Controller that the invention is claimed in a claim of any other complete specification as referred to under section 13(1)(b), he may, direct that a reference to that other specification shall be inserted by way of notice to the public in the applicant's complete specification unless within such time as may be prescribed—

- (a) the applicant shows to the satisfaction of the Controller that the priority date of his claim is not later than the priority date of the claim of the other specification; or
- (b) the complete specification is amended to the satisfaction of the Controller.

OPPOSITION PROCEEDINGS

...to the satisfaction of the Controller

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.

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.

- (2) Prior publication in any Indian specification or prior publication in any other document in India or elsewhere.
- (3) The invention has been the subject-matter of a prior claim in an application which is prior in time than the applicant's claim.
- (4) The invention as claimed in the complete specification was publicly known or publicly used in India before the applicant's claim.
- (5) The invention as claimed by the applicant in his complete specification is obvious and does not involve any inventive step.

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- (6) The invention is not patentable or its patenting is prohibited under the Act.
- (7) The complete specification of the applicant does not sufficiently and clearly describe the invention or the method by which it is to be performed.
- (8) In case of foreign application, the failure to disclose information relating to such application filed in a foreign country.
- (9) In case of convention application, the application was not made within twelve months from the date of first application for protection of invention made in a convention country by the applicant or a person from whom he derives title.
- (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

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.

Grant of Patent

- When application is in order
- When application has not been refused by controller
- Application has not been found in contravention of the patents act

Date of patent

- Patent becomes effective from date of filing of complete specs
- Date is entered in a register
- No suit or proceedings shall commence in respect of infringement before the date of application

Extent and effect of patent of patent

Permitted use in respect of patent

- As per 1970 act patent granted is subject to certain conditions
- Patent for machine or apparatus manufactured with a process for which has been granted could be imported or made in behalf of government for the purpose of own use
- May be used on behalf of government for own use
- May be used for experimentation or research including instructions for students
- In case of medicine or drug for which patent is granted could be imported by government for own use or distribution in dispensary or hospital with regard to public service

Compulsory license

- Term of patent is for 20 years it can 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 for public interest.

Provisional and complete specs

Specification IS THE DESCRIPTION OF PATENT, it is part of patent application

- The description of the invention in the specification is in fact, the consideration in lieu of which exclusive right in the form of patent is granted

Content and form of specs

a) Title sufficiently indicative of the subject matter of the invention

Provisional or complete specs is filed in Form 2 as specified in patent act

b) description of invention and the method by which it is to be performed,

c) Specification must end with a claim or claims defining scope of invention for which protection is claimed

Claims must relate to single invention

d) Specification must be accompanied by abstract to provide technical information on the invention

e) In case of international application designating India title, description, abstract, drawings and claim are to be filled with application

f) Must be accompanied by declaration of inventorship of the invention

Nature of patent specs

- Must be not just description of invention must be technical and legal doc
- Specs is scrutinized by examiner in the controller 's office
- Description must satisfy the examiner that there is an invention
- Specs importance arises when any part alleges that the specs do not fully describe the invention and opposes the patent on that ground

Kind of specs

Provisional specs : is when the inventor is in the process of finalizing the invention

- Is not full and specific description
- It only has general describe of invention, its field of application and anticipated results

Need for provisional specs: used to **fix priority date of the patent**

As Indian patent is based on first to apply principle, this secures his claim to patent against similar claim by another inventor

Must be followed by complete specs within 12 months of date of filing provisional specs

Otherwise it is treated as abandoned

This ensures that the rights of other researcher in same area of research is not suspended

- **Complete specs** :

Complete specs content

- a) Title sufficiently indicative of the subject matter of the invention
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- b) description of invention and the method by which it is to be performed,
- c) Specification must end with a claim or claims defining scope of invention for which protection is claimed
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- d) Specification must be accompanied by abstract to provide technical information on the invention
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- f) Must be accompanied by declaration of inventorship of the invention

Priority date of claim

- Is date when the inventor files a patent application with provisional specs claiming the invention
- Novelty of the invention is tested with reference existing state of knowledge on such a priority date. If invention is novel and non obvious to a skilled person in the art appropriately aware of the developments .

Claims /categories of claims

- Main claim: should state what the invention is in the broadest term
- Subordinate claims: claims refer to additional features of the invention
- Omnious claim: relates to arrangement as described and as shown in the drawings

Whether a spec can be amended once it has been filed

- Amendment before acceptance ; controller seeks amendments
- Amendment after acceptance; application has been accepted by controller and published, a party may oppose any claim in the specs
- Amendment after the sealing of patent: before grant of patent an application for revocation of patent FILED by a person other than patentee High court instead of revocation may order amendment to specs to preserve the rights of patentee

Conditions for amendment

- Amendments to the patent after it is granted cannot be on his own, amend the specs at any stage after acceptance of specs

Amendments are made only under conditions imposed by the act as below

1. Disclaimer : is a statement by applicant denying a claim, such clause
Reduces the scope of monopoly by restricting the spread of the claim
2. Correction; is amended used to correcting specs mistake limited to typographical or minor mistakes made in writing specs. And not a correction that produce an effect of the invention altogether different
3. Explanation : that is braought in as clarifies or better explains some expression in the specs. But does not change its meaning.

Who is to allow the amendments

- Amendments has to have approval of the controller
- If specs is challenged in a revocation proceedings after grant of patent before high court, court id appropriate authority to allow the party to amend the specs or claims

Rights conferred on patentee

- To exploit the patent
- To licence patent to another
- Assign the patent to another
- Surrender the patent
- Sue for the infringement of the patent

Patent rights are conditional exceptions and limitations

- Govt use of patent
- Compulsory license and license rights Section 84 after 3years of grant of patent any person can apply to the controller for grant of compulsory license
- Use of invention for defense purposes
- revocation for non working of patents
- Limitations on restored patents

Enforcement of patentee rights

- A suit for infringement of a patent
- An action for specific performance of contract
- An action for recovery of royalties

Duties of a patentee

- Patentee is duty bound to ensure that the monopoly right created by patent is not used unfairly and does not act prejudicial to public interest
- Failure to discharge his duties would result in denial of patent rights by govt by granting compulsory license or license of rights on the patent
- Section 122 of act provides that refusal or failure to furnish any information to central govt or controller shall be punishable with fine which may extent to ten lakh rupees
- Overzealous patentee who threatens another by making unjustifiable threats of action for infringement is restrained from doing so. Court under section 106 may grant relief in case of groundless threats

Transfer of patent : forms of transfer of patent rights

- Assignment
- License
- Transmission of patent by operation of law

License

Kinds of license

- Voluntary license :is written authority granted by owner of patent to another person(s)empowering the latter to make , use sell the patented article in a manner and on terms and conditions provided in the license
- Statutory license : example is compulsory license and licenses of right
In statutory license controller and central govt play a important role
grant of such license their terms and conditions do not depend upon the will of parties as in case of voluntary license
- Exclusive /limited license : depends on the degree and extent of rights conferred on the licensee
- Express /implied license : an express license is one in which the permission to use the patent is given in express terms eg: I the patentee of ----- authorises X to ----- . Would constitute a clause in a express licence
- Implied license is not given in express terms

Rights conferred by license

- License that is valid and registered confers certain rights on the licensee to make, use or exercise the patented invention subject to valid conditions or limitations imposed on license
- can initiate proceedings against infringement OF RIGHTS accruing to him under the license if he is holding exclusive license

Transmission of patent by operation of law

- When a patentee dies his interest in the patent passes to the representative
- a patent can be acquired by govt under the act when reasonable requirements of public are not met
- Registration of assignment /license is essential

restrictive Conditions to be avoided in licensing

- Patentee is allowed to impose certain restraints on the licensees eg may be restrained from selling patented article in a particular territory
 - Or seek items manufactured by competitor
 - He cannot impose restrictions on the licensee which are against public interest
1. Acquire any article other than patented
 2. Acquire any article made by other than patented process then patented
 3. Use process other than patented
 4. preventing challenges to validity of patented process

Infringement of patents

- Patentee is having exclusive right to make, distribute, or sell the invention in India.
- Infringement would be when any of these rights has been violated
- Patentee can assign or license all or some of these rights

In case of product rights of patentee is infringed when some one makes or supplies that item commercially

In case of process or method use by any one other than patentee amounts to infringement

Infringement depends on

- Extent of monopoly rights granted to patentee as interpreted from the specs and claims contained in the application of the patentee. Any action that falls outside the scope of claims would not amount to infringement
- Whether he is infringing any monopoly rights of the patentee to make, distribute or sell the invention.

Construction of claims and infringement

- Construction of claims is important since the action of a defendant whether or not a infringement , would depend upon the scope of monopoly right conferred by the claims put up by the patentee.
- To constitute an infringement of a product, the infringing article must tacke each and everyessential integerof the claim.
- However even if some non essential features are deleted the infringement remains.
- If the patent has many features but the patentee has claimed a few the infinger can take ADVANTAGE OF THE situation.
- When particular combination is claimed as an esstential feature of the invention. Whena different combination is used to achieve similar result it would not amount to infringement

Patents held to be infringed

- Colorable imitation of an invention
- Immaterial variations in the invention
- Mechanical equivalents
- Taking essential features of the invention
- Infringement is to be decided based on facts of each case

Patents held to be not infringed

- Claim construed to be for a combination not infringed by the defendant
- Claim construed to be for particular combination not taken by the defendant
- Claim construed to be for particular combination not infringed by the defendants
- Claim for a particular combination held to be not infringed by the defendant
- Claim construed to be for a particular combination not infringed by defendants
- Patent held to be valid but not infringed –the doctrine of pith and marrow

Action for infringement

- Whenever the monopoly rights are violated of the patentee, it is secured by act through judicial intervention. The patentee has to institute a suit for infringement
- Following are the relief that could be awarded
 1. Interlocutory /interim injunction
 2. damages on account of profits
 3. Permanent injunction

Where a suit is to be initiated procedure to be followed

- Section 104 of the act provides that a suit for infringement shall not be admitted in any court inferior to District court having jurisdiction to try the suit
- When an action for infringement has been instituted in District court and the defendant makes a counter claim for revocation of patent. Then the case is transferred to the high court which has jurisdiction to try cases of revocation
- The burden of proof in case of suits is on the plaintiff to establish infringement

Procedure followed in the suit

- Procedure followed in conducting a suit for infringement is governed by provisions of code of civil procedure.

When can a suit be instituted

- A suit for infringement can be instituted only after the patent has been sealed. When the specs has been accepted and published i.e. during the period when opposition has been called and is being decided.
- the applicant cannot institute a suit of infringement, but damages sustained due to infringement committed during the period i.e. date of publishing of acceptance of complete specs and the date of grant may be claimed in another suit for damages but not suit for infringement
- In case of patent lapsed and subsequently restored, no suit or other proceedings can be brought for infringement in the interim period
- Patent obtained wrongfully by a person and later granted to the true inventor no suit for infringement can be instituted before grant to the true inventor

Period limitation for instituting a suit

- Instituting of suit should be within 3years of date of infringement
- A notice need not be sent to the defendant
- the court will give notice to the defendant

Who is entitled to sue

- The following persons are entitled to sue
 1. The patentee
 2. Exclusive licensee if the licence is registered
 3. A compulsory licensee when the patentee refuses or neglects to institute proceedings
 4. A licensee other than the above two licensee can bring an action for infringement depending upon the terms of the contract between licensor and licensee
 5. assignee
 6. Co-owners of a patent

The court may direct the defendant to prove that his product is different from the patented process section 104A was inserted for providing burden of proof on defendant

Objective behind patent law

- Patent law recognises the exclusive right of a patentee to gain commercial advantage out of his invention
- It encourages the inventors to invest their creative faculties, knowing their inventions would be protected by law and no one else would be able to copy their inventions for a certain period of time during which the inventor has exclusive rights
- Price for grant of monopoly is the disclosure of the invention at the patent office.
- After expiry of the fixed period of monopoly it passes into the public domain.
- Fundamental principle of patent law to grant a patent only for an invention which must be new and useful. Thrust is on novelty and utility. Must be more than workshop improvement.

Persons who can be sued

1. person who infringes patent that violates the monopoly right of patentee
2. when two or more person jointly infringe. Both become co-defendant.
3. Agents or servants of a principal who is responsible for infringement
4. The consignee of a infringing article can be made a party to the proceedings in a infringement suit.

Onus of establishment infringement

Onus is on the plaintiff to establish infringement.

Following scenarios are considered infringement

1. Any act of making, constructing, using, selling or importing a patented invention solely for uses reasonably related to the development and submission of information required under any law in india or in country other than india
2. Importation of patented products by any person from a person who is duly authorized under the law to produce and sell or distribute the product

Defense set up by defendant

Defendant may set up one or more of following defences

1. That plaintiff is not entitled to sue for infringement
2. That there is no infringement or any threat or intention to infringement
3. that there was leave or license, express or implied, to use the invention
4. Estoppel or res judicata
5. The claims alleged to be infringed are invalid on grounds.
6. At the time of infringement there existed a contract relating to the patent containing a condition which is unlawful under the provision of section 140
7. Act complained of falls within the scope of infringement that is the defendant was unaware of the existence of the patent when the alleged act of the infringement occurred or was done after failure to pay renewal fee or was done before the date of amendment of specifications section 111
8. Counter-claim for revocation of the patent by the defendant

Estoppel or res judicata

- The principle of Estoppel means that an individual is barred from denying or alleging a certain fact or state of act because of that individual's previous conduct, allegation or denial. In simple terms, this means that an individual cannot turn around and deny his previous statement. Assignee of patent through registered assignment is alleged by patentee of infringement. The patentee is estopped from so alleging by his previous conduct
- Re judicata means that a matter already judicially acted or decided between the two parties, cannot be reopened or re-adjudicated for same cause of action

Expert evidence

- Is normally furnished before the court by the parties in a proceeding, due to the scientific and technical complexity involved in drafting of a patent specs
- Experts may be called to explain the practical working of the machinery and explain to the court whether the specs is really new or not
- Decision that prevails is that originating from the mind of the judge, keeping in mind facts and circumstances of the case

Relief 's injunction

- Injunction is an order of a court prohibiting someone from doing some specified act or commanding someone to undo some wrong or injury.
- Generally it is preventive and protective remedy aimed at preventing future wrongs. Injunctions are of two kinds;
- Temporary/ interlocutory injunctions-these are court orders which are in force for a specified time or until further orders of the court

a. Interlocutory injunction may be granted at any time during the proceeding of the suit.

Plaintiff may at the commencement of the suit or any time during the suit move the court for grant of an interim injunction to restrain the defendant from committing and continuing to the acts of infringement

Principles followed by court for granting interlocutory injunction re

1. Plaintiff must establish prima facie case in his favour
2. Must establish that the balance of convenience lies in his favour. When awarded will not offend the interest of the party who is alleged to have caused infringement

b. Final injunction

Factors considered for issuing interlocutory injunction

- Whether the patent is a new or old one
- Whether the term of the patent is to expire before the proceedings can be heard
- Whether the validity of patent has been challenged
- Whether it is possible to compensate the plaintiff by award of damages when he succeeds in the trial
- Whether the defendant can be compensated by the plaintiff's undertaking as to payment of damages

Final injunction

- Is granted at the termination of trial. The time for which the final injunction is in force is the remaining term of patent

Damages on account of profits

- A successful plaintiff in a suit for infringement is entitled to the relief of damages or account of profits. Both reliefs cannot be granted together.
- Certain cases where damages or profits cannot be granted
 1. When infringement was innocent, the defendant was not aware of the patent existed
 2. Infringement was committed after failure to pay renewal fee within the prescribed time and before any extension of the period.
 3. Where specs have been amended and the infringement was committed before the date of such amendment

Object of awarding damages

- To compensate for loss or injury suffered by the plaintiff due to the action of the defendant

Manner of assessment of damages factors

Amount of damages awarded is proportionate to the injury suffered by the plaintiff due to the action of the defendant

1. Patentee manufactures the product himself and does not grant license, the measure of damages will be profit which he would have earned
2. Where a patentee grants licenses for working the invention for payment of royalty, the measure of damages awarded would be the sum payable as royalty, had the infringer been the licensee of the patent
3. Assessment of damages would include the pecuniary equivalent of loss

Patent agents

- To practice as an agent under the act, person has to get his name registered as patent agent by making an application in form 22 as specified by patent rules 2003 at the Head office or the Patent Office

Qualifications of a patent **agent** : A person shall be a qualified agent, if he is a citizen of india, has completed 21 years of age, has a degree in science, engineering and technology from any university recognized by law in territory of india and in addition has passed qualifying exams for

The purpose or is an advocate or has a minimum of 10 years of experience as examiner or as controller.

Patent agent rights : patent agent is entitled to practice before the controller and prepare all documents, transact all business and discharge such functions as prescribed by the controller. Patent agent is authorized to sign all applications and communication to the controller on behalf of the concerned person, on being authorized to do so by that person in writing

Patent drafting

- What is Patent Drafting? **Filing for a patent includes a stringent process in which the inventor would have to provide a detailed description of their idea.** This description must explain why the idea is original and innovative – chronicling all the necessary facets of the invention that make it so. It is done to safeguard new inventions and ensure each one is unique.
- Patent drafting is the first step to protecting a great idea.

Patent Drafting: A step by step guide

- Once you have your team in place, you can move on to the next step, i.e., drafting the patent meticulously. Here's a step by step guide on patent drafting.

1. Check if your invention is patentableThe first step in the process of patent writing is to check if your invention is indeed patentable. This will require a detailed patentability search to help determine if you have any chance at getting the patent. Ideally, the search should be conducted for patented as well as non-patented references. Undertaking a detailed search of patentability also helps inventors deepen their understanding of the merits of their invention, and whether their chances of claiming the patent exist.

- Moreover, the references discovered before filing the patent can also help you fine-tune your invention and patent application, ensuring you do not file a patent for an already existing intellectual property. That said, this step is entirely optional. While it takes some extra effort in the beginning, it can prove to be a great time (and money) saver later.

2.Fill out the patent drafting applicationIf you've made it to the application stage, you need to fill and submit Form 1, also known as the Indian Patent Application Form, along with Form 2, i.e., the patent specification form. Based on which Indian state you are residing in, you'd either have to file a provisional or complete patent application.

- It is recommended that you opt for the provisional application if your invention is still in the development phase, thus blocking the filing date. You get 12 months to file the complete specification, which gives you a lot of time to test your invention and finalise it.

3.Fill the necessary forms to complete your patent applicationApart from Form 1 and Form 2 mentioned above, your patent application must be accompanied by several other forms. The forms you provide, depend on whether you're filing a patent in India as an Indian resident, applying for an international patent or whether you are a foreign applicant filing an application in India for grant of a patent in India. Here are the forms you must submit:

- **WIPO is the global forum for [intellectual property](#) (IP) services**, policy, information and cooperation. We are a self-funding agency of the [United Nations](#), with 193 member states

Indian Patent Office

- The Office of the Controller General of Patents, Designs and Trade Marks generally known as the Indian Patent Office, is an agency under the Department for Promotion of Industry and Internal Trade which administers the Indian law of Patents, Designs and Trademarks
- **[Headquarters location](#)**: [Mumbai](#)
- **[Founded](#)**: 1 January 1912
- five main administrative sections:^{[\[10\]](#)}
 - [Patent](#) Office
 - [Designs](#) Registry
 - [Trademarks](#) Registry
 - [Geographical indications](#) Registry

Database searching

Case studies