

“Intellectual property”

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I have an innovation How do I protect it in the market ???



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INTELLECTUAL PROPERTY

Intellectual Property refers to creation that arises from the human intellect i.e. inventions in all fields of human endeavor, scientific discoveries, industrial designs for article, literary & artistic work, symbols etc. used in commerce.

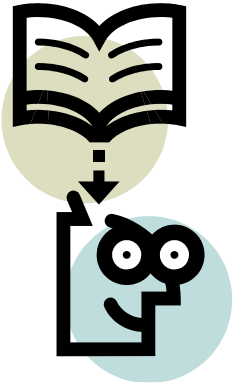
Nature/ characteristics of Intellectual Property:

- Creation of human mind (Intellect)
- Intangible property (Intangible property, also known as incorporeal property, is a type of property that cannot be touched or seen. It is a right that is created by the human mind and can be transferred to another person or entity. Examples of intangible property include patents, trademarks, copyrights, and trade secrets.)
- Exclusive rights given by statutes
- Time-bound and Territorial/Jurisdictional



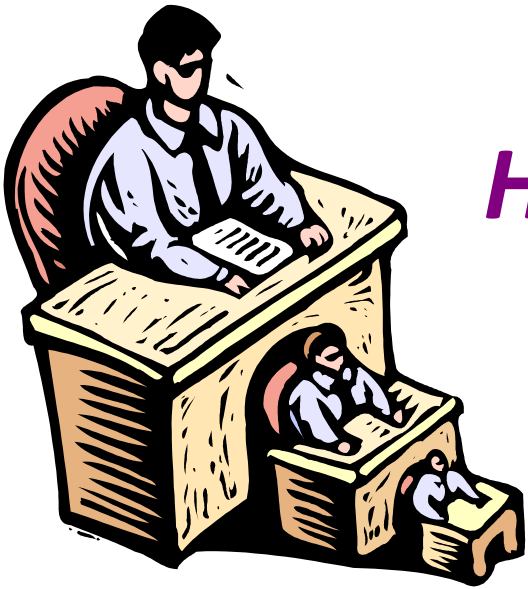
or
al

What is Intellectual Property Right (IPR)?



Intellectual Property Right

- not to be confused with IP
- it is a right vested in the asset, not the asset itself. (This means a person or other entity can have a vested interest in a tangible or intangible asset if there are no conditions to its ownership. The time during which a person or entity is required to wait before exercising ownership of the asset is known as the vesting period)
- e.g.
 - an idea / invention is IP, a patent registration is an IPR
 - a customer / price list is IP, a right of confidentiality is an IPR
 - a secret production method is IP, a right to a trade secret is an IPR
 - a particular way of representation is IP, copyright or a design registration is an IPR
 - a brand / trade name is IP, a trade mark registration is an IPR



How Intellectual Property Law Works

- Affirmative Rights, NOT Protection
- Allows owner to file a lawsuit against a transgressor (a person who breaks a law or moral rule: The system seems to be designed to punish the **transgressor** rather than help his victim)
- Does not stop a transgressor



Intellectual Property Rights

“INDUSTRIAL PROPERTIES”

PATENTS

INDUSTRIAL DESIGNS

TRADEMARKS

TRADE SECRETS

PLANT VARIETIES

INTEGRATED

CIRCUITS

GEOGRAPHICAL

INDICATORS

“COPYRIGHT”

LITERARY

NOVEL

POEM

PLAYS

FILMS

MUSICAL

ARTISTIC

DRAWINGS

PHOTOGRAHS

PERFORMING ARTS

SCULPTURES

SOFTWARE

Intellectual property

INDUSTRIAL PROPERTY

+

COPY RIGHT

PATENTS

DESIGNS

TRADEMARKS

Geographical Indications

**Patents
& Designs**

Patent Information

PATENT OFFICE

PLS

GOVERNMENT OF INDIA

Copyright office

GIR Trade Marks Registrar

Trade Marks

Copy Right

Geographical Indications

INDUSTRIAL PROPERTY

Patents	Designs	Trade-Marks	Geographical Indications
Inventions relating to constructional features	any modification in shape, pattern, configuration	Word Name Logo	Indications of source origin or geography
e.g. Safety Valve, Mechanism of a PRESSURE COOKER	e.g. shape of a handle or body portion of a pressure cooker	e.g. for same Pressure Cooker “PRESTIGE” “HAWKINS” “MAHARAJA”	Darjeeling tea Kanchipuram sarees Kolhapur chappals

Intellectual Property Rights



PATENT

Design

**TRADE
MARKS**

The RingG-PEN™

Flair, Reynolds, Cello, luxury etc.

Trade-Related Aspects of Intellectual Property Rights (TRIPS) in the World Trade Organization **Compliance**

- Agreement enhanced the protection and enforcement of IPRs to the level of solemn international commitment.
- India is a signatory of TRIPs Agreement in the Uruguay Round agreement of 1995 and hence, the government has initiated action to bring in the requisite changes.
- In the last few years, India has enacted fully TRIPs-compliant Trademarks Act, Copyright Act, Designs Registration Act, Geographical Indications Act and Protection of Layouts for Integrated Circuits Act.

Basic Facts about WIPO



WIPO's Mission: World Intellectual Property Organization
To promote the protection of IP rights
worldwide and extend the benefits
of the international IP system to all
member States

Status: An int'l intergovernmental organization

Member States: 183

Staff: 915 from 94 countries

Treaties Administered: 24

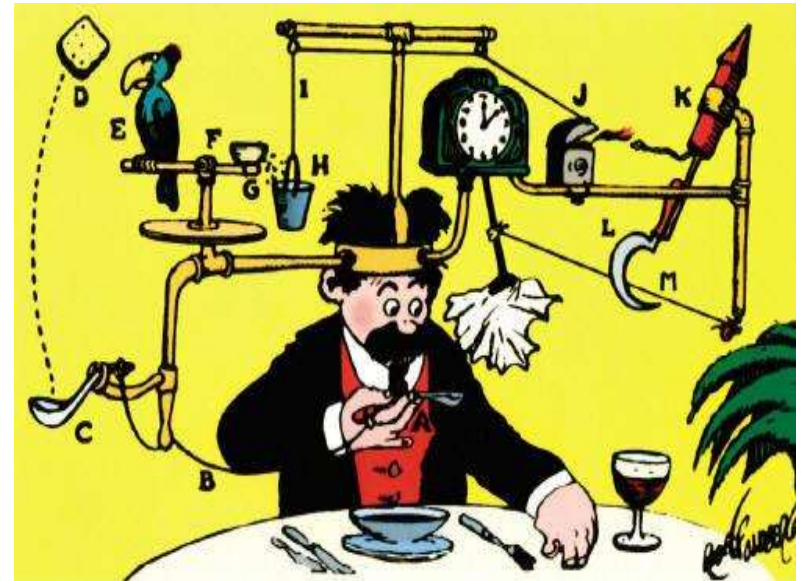
Decisions by: GA, CC, WIPO Conference (General
American)

Guiding Principles: Transparency, Accountability,
Consensus

History of Patent Law:

YEAR	ACTS
1856	THE ACT VI OF 1856 ON PROTECTION OF INVENTIONS BASED ON THE BRITISH PATENT LAW OF 1852. CERTAIN EXCLUSIVE PRIVILEGES GRANTED TO INVENTORS OF NEW MANUFACTURERS FOR A PERIOD OF 14 YEARS.
1859	THE ACT MODIFIED AS ACT XV; PATENT MONOPOLIES CALLED EXCLUSIVE PRIVILEGES (MAKING. SELLING AND USING INVENTIONS IN INDIA AND AUTHORIZING OTHERS TO DO SO FOR 14 YEARS FROM DATE OF FILING SPECIFICATION).
1872	THE PATENTS & DESIGNS PROTECTION ACT.
1883	THE PROTECTION OF INVENTIONS ACT.
1888	CONSOLIDATED AS THE INVENTIONS & DESIGNS ACT.
1911	THE INDIAN PATENTS & DESIGNS ACT.
1972	THE PATENTS ACT (ACT 39 OF 1970) CAME INTO FORCE ON 20 TH APRIL 1972.
1999	ON MARCH 26, 1999 PATENTS (AMENDMENT) ACT, (1999) CAME INTO FORCE FROM 01-01-1995.
2002	THE PATENTS (AMENDMENT) ACT 2002 CAME INTO FORCE FROM 20TH MAY 2003
2005	THE PATENTS (AMENDMENT) ACT 2005 EFFECTIVE FROM 1st JANUARY 2005

File Patents- *Protect Inventions*



Generate Ideas.....

And Own Them.....IPR !

What are Patents?

- Exclusive rights given to a person in return for a full and complete disclosure of the invention for which the patent is claimed
- Available for both product and process
- Granted for 20 years from the date of filing
- Patent rights are “territorial rights”(the central right of jurisdiction, which is the right to create and enforce laws)



Patentability Criteria

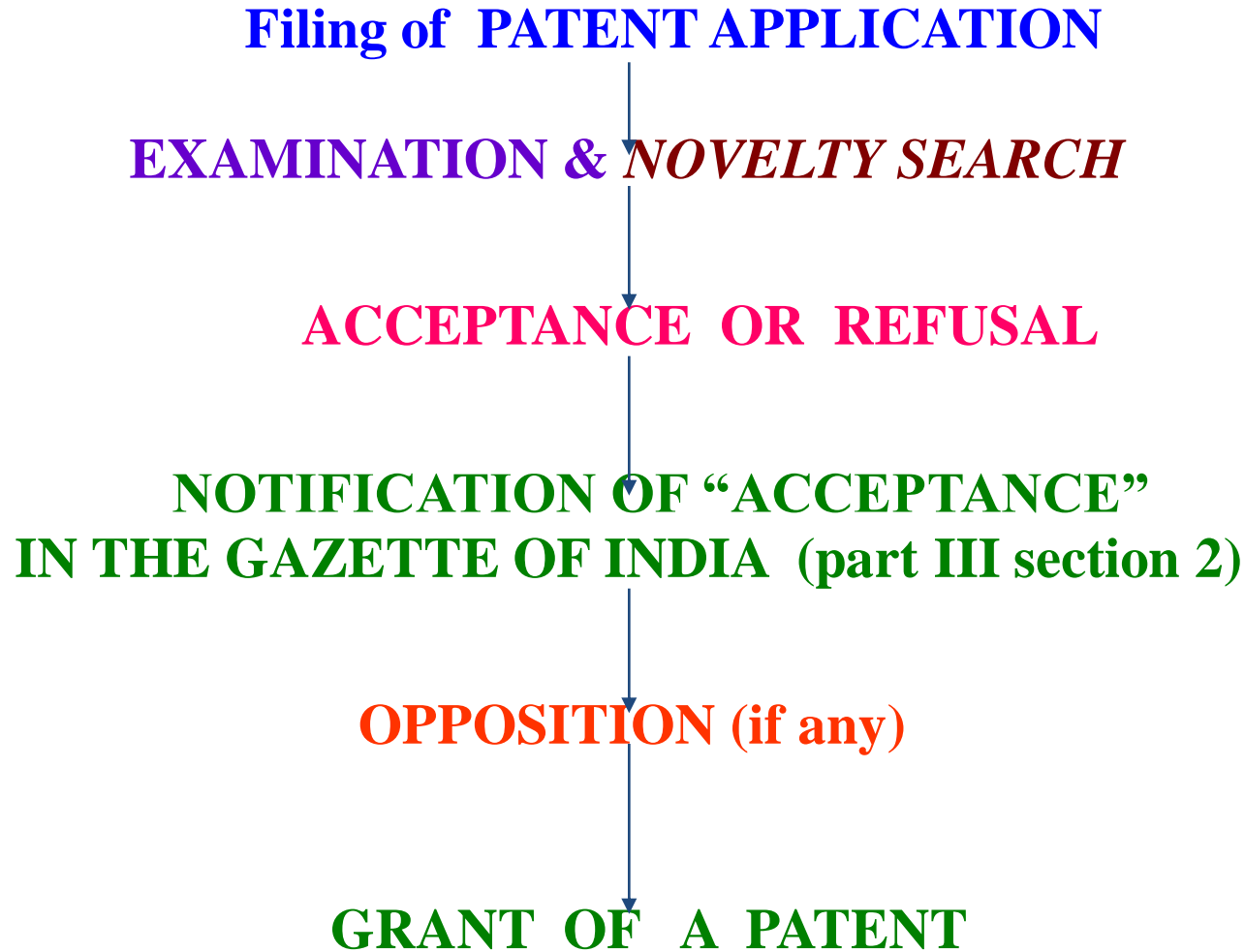
Novel

Non-Obvious/ Inventive Step

Industrial Application

Patentable subject matter

Patent Grant Procedure (In Brief)



WHERE TO FILE (jurisdiction)

- If THE APPLICANT/FIRST MENTIONED APPLICANT-RESIDES/HAS DOMICILE/HAS PLACE OF BUSINESS/HAS ORIGIN OF INVENTION/HAS SERVICE ADDRESS(in case of foreign applicant) IN

STATES

JURISDICTION

- | | |
|-----------------|---------------------|
| • NORTHERN | PATENT OFFICE DELHI |
| • SOUTHERN | PAT. OFFICE CHENNAI |
| • WESTERN | PAT. OFFICE MUMBAI |
| • REST OF INDIA | PAT. OFF. KOLKATTA |

How to Apply ?

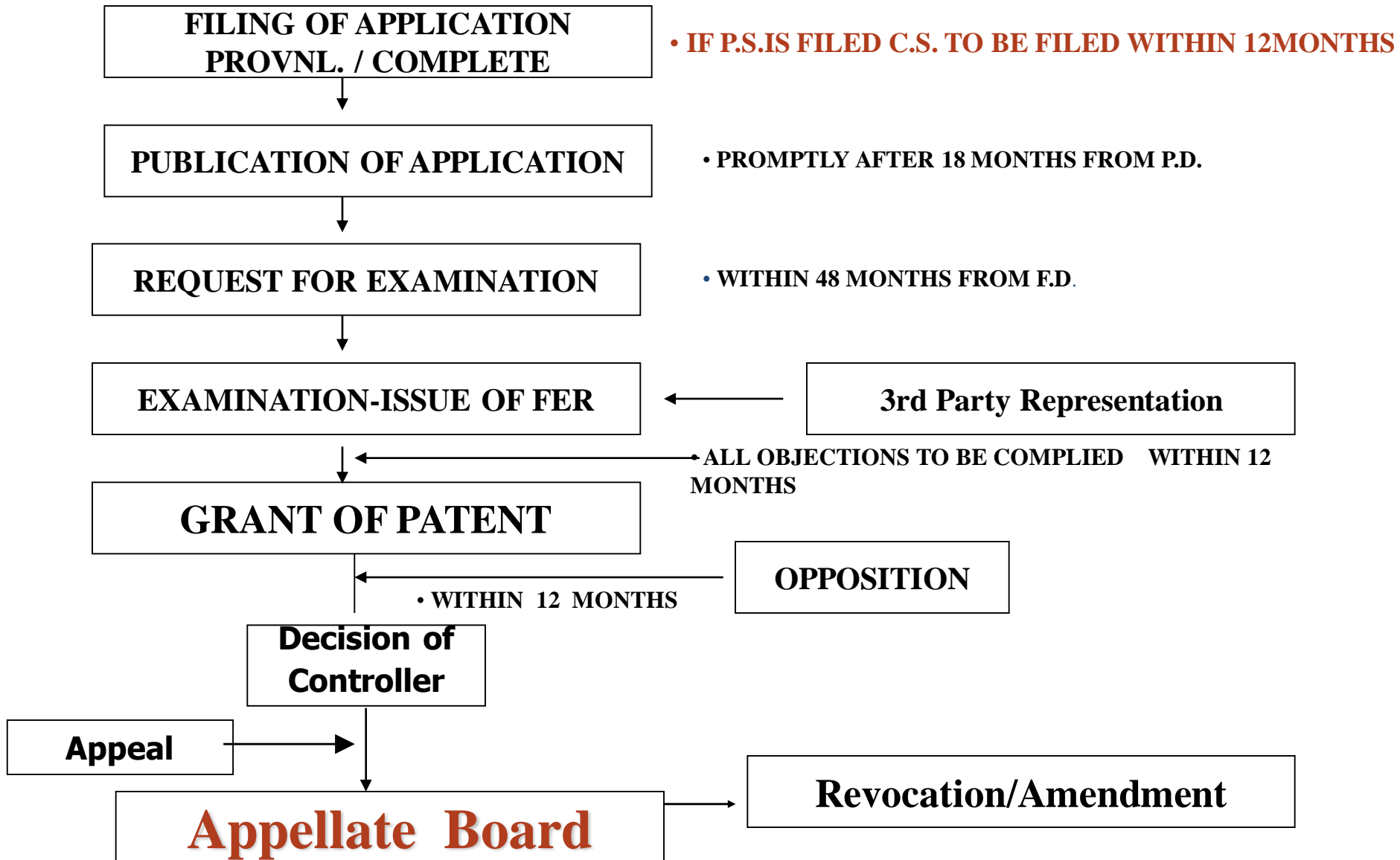
- APPLICATION ON FORM –1 with covering letter in the name of controller
- SPECIFICATION PROVISIONAL/COMPLETE ON FORM –2
- ABSTRACT OF INVENTION
- STATEMENT AND UNDERTAKING OF FOREIGN FILING PARTICULARS ON FORM -3- if any
- PROOF OF RIGHT—if applicable
- DECLARATION OF INVENTORSHIP ON FORM- 5

Contd....

- CERTIFIED COPIES OF PRIORITY DOCUMENTS- if applicable
- POWER OF ATTORNEY-if applicable
- MAY BE LEFT/SENT TO THE APPROPRIATE OFFICE IN HINDI/ENGLISH
- MAY BE FILED IN ELECTRONIC FORM WITH ONE COPY ON WHITE PAPER
- IF APPLICATION DISCLOSES SEQUENCE LISTING OF NUCLEOTIDES AND/OR AMINO ACIDS, IT SHOULD BE FILED IN ELECTRONIC FORM

Stages from filing to grant of a patent

STAGES - FILING TO GRANT OF PATENT



Obtaining a patent

- File an application for patent
 - With one of the patent offices based on territorial jurisdiction of the place of office or residence of the applicant /agent
 - Pay the required fee
- Information concerning application form and details of fee available at www.ipindia.nic.in
- Guidelines for applicants also available on this website

Formality Check

- An Examiner checks the formal requirements before accepting the application and the fee – this is done immediately
- Issue of application number and the cash receipt – this is done the same day
- In case of receipt of application by post, cash receipt, application number is sent by post within 2-3 days

PROVISIONAL SPECIFICATION

- SECURES PRIORITY DATE
- MAY BE FILED AS SOON AS PATENTABLE IDEA COMES IN MIND
- DISCLOSES ESSENTIAL FEATURES OF INVENTION
- PATENT IS GRANTED ON COMPLETE SPECIFICATION ONLY
- TIMELIMIT TO FILE C.S.: 12 MONTHS FROM P.S.
- PAGES EXCEEDING 30 INCLUDING DRAWING SHEETS ARE CHARGEABLE @ 100/400 PER PAGE

Content of Complete Specification

- Fully and particularly describe the invention and the method of its performing
- Should end with claims defining the scope of the invention
- Claims should be clear and fairly based on the description
- Should relate to A single invention or to A group of inventions linked so as to form A single inventive concept
- An abstract* to provide technical information
- In case of biological material, the application is completed by depositing the material to an authorised depository institution and by fulfilling certain conditions*

Abstract should contain:

- *TITLE:SHALL DISCLOSE THE SPECIFIC FEATURE OF INVENTION-50-150 WORDS*
 - *CONCISE SUMMERY OF THE SPECIFICATION CONTAINING:*
 - ❖ *TECHNICAL FIELD OF THE INVENTION*
 - ❖ *TECHNICAL PROBLEM TO WHICH INVENTION RELATES*
 - ❖ *SOLUTION TO THE PROBLEM THROUGH THE INVENTION*
 - ❖ *PRINCIPAL USE OR USES OF THE PROBLEM*
 - ❖ *FIGURES OF THE DRAWINGS WHICH MAY ACCOMPANY IT FOR PUBLICATION*
 - ❖ *CHEMICAL FORMULA: if necessary*
 - ❖ *REFERENCE NUMERALS WITH EACH FEATURE OF THE INVENTION*
- MAY NOT CONTAIN MORE THAN 150 WORDS*

Publication

- Application is kept secret for a period of 18 months from the date of filing
- In 19th month, the application is published in the official journal – this journal is made available on the website weekly
- Applicant has an option to get his application published before 18 months also
- In that case, application is published within one month of the request

Request for Examination

- Application is examined on request
- Request for examination can be made either by the applicant or by a third party
- A period of 48 months, from the date of filing, is available for making request for examination

Examination

- Application is sent to an Examiner within 1 month from the date of request for examination
- Examiner undertakes examination w.r.t.
 - whether the claimed invention is not prohibited for grant of patent
 - whether the invention meets the criteria of patentability

Issue of FER

- A period of 1 to 3 months is available to Examiner to submit the report to the Controller
- 1 month's time available to Controller to vet the Examiner's report
- First Examination Report (FER) containing gist of the objections is issued within 6 months from the date of filing of request

Response from the Applicant

- 12 months' time, from the date of issue of FER, is available to the applicant to meet the objections
- If objections are met, grant of patent is approved by the Controller – within a period of 1 month

Pre-grant Opposition

- After publication, an opposition can be filed within a period of 6 months
- Opportunity of hearing the opponent is also available



Examination of Pre-grant Opposition

- Opposition (documents) is sent to the applicant
- A period of 3 months is allowed for receipt of response

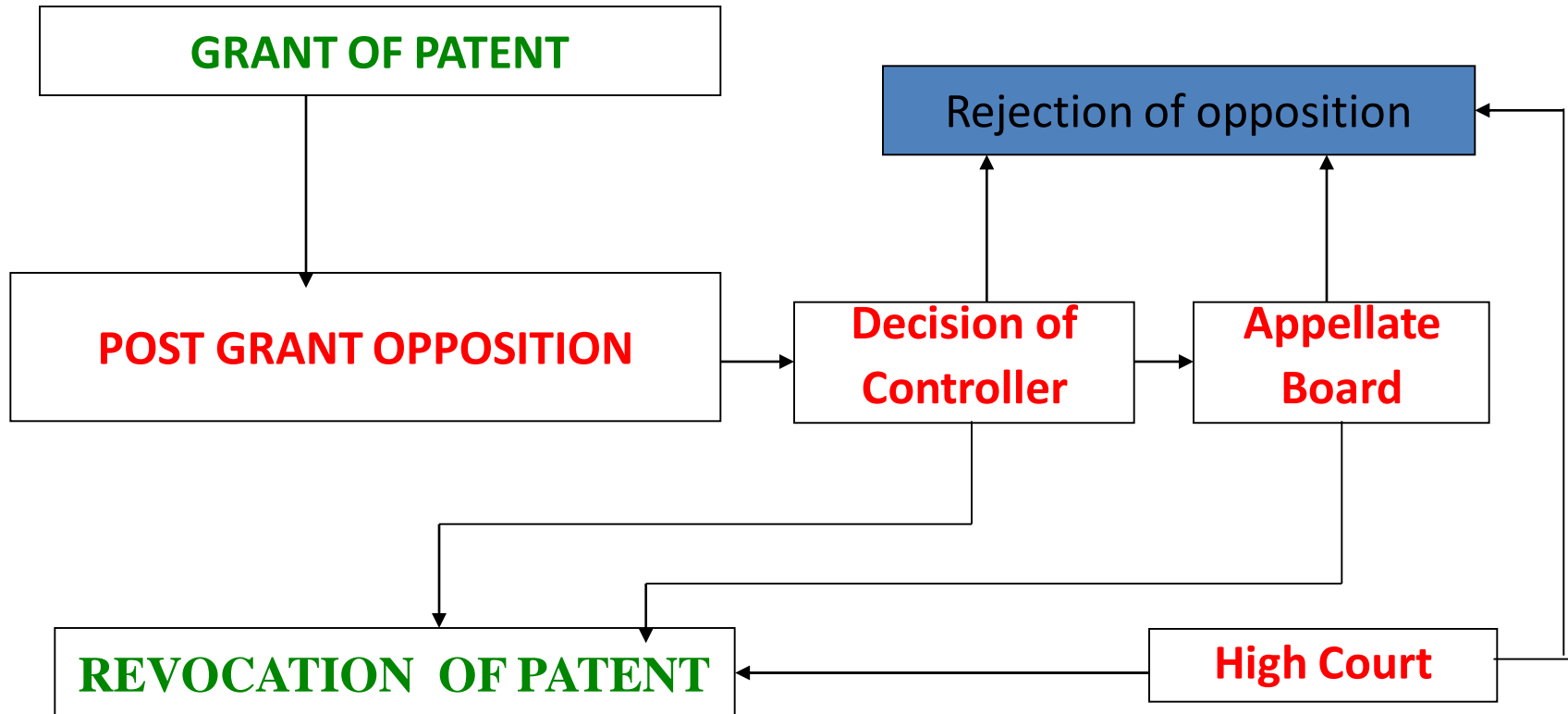
Consideration of Pre-grant Opposition

- After examining the opposition and the submissions made during the hearing, Controller may
 - Either reject the opposition and grant the patent
 - Or accept the opposition and modify/reject the patent application
- This is to be done within a period of 1 month from the date of completion of opposition proceedings

Grant of a Patent

- A certificate of patent is issued within 7 days
- Grant of patent is published in the official journal

A PROCEDURE FROM FILING TO GRANT OF PATENT (Cont.)



THE FEE SCHEDULE

On what payable	Form	Individual	Company
•Prov./Comp spec.	2	1000	4000
•PAGES EXCEEDING 30	-	100	400
•CLAIMS EXCEEDING 10	-	200	800
*Request for extension of time	4	1000/2000/3000	4000/8000/1200
REQUEST FOR EARLY PUBLICATION	9	2500	10000
•Request for Examination	18	2500	10000
•EXPRESS REQUEST FOR EXAMN.	18	3500	14000
*Change of Applicant	6	1500	2000
*Notice of Opposition	7	1000	6000
*Certified Copy\Certificate		1000	4000
*On a petition	--	1500	4000
*Restoration of lapsed patent	15	1500	6000
<u>RENEWAL FEES</u>			
3 rd to 6 th Year(per year)		500	2000
6 th to 10 th Year—do--		1500	6000
11 th to 15 th Year---do---		3000	12000
16 th to 20 th year----do---		5000	20000

IMPORTANT FEES IN DIFFERENT PROCEEDINGS

(Amount in Rupees)

	<u>Individual</u>	<u>Legal Entity</u>
➤ Application for Grant of Patent	1000	4000
➤ Request for Examination of Application	2500	10000
➤ Request for Publication	2500	10000
➤ Substitution of Applicant	500	2000
➤ Notice of Opposition	1500	6000
➤ Restoration of Lapsed Patent	1500	6000
➤ Renewal Fees (for 20 years)	48000	192000

PS. Professional help Patent Drafting costs around 30000



DUTIES OF PATENTEE

- **Maintenance of the patent**
 - ❖ **Pay renewal fees**
 - ❖ **Every year till the end of the term**
 - ❖ **Time limit: before end of the preceeding year (6 months extn. Available)**
- **Working of the patents:**
 - ❖ **Inventions are to be worked in India on commercial scale**
 - ❖ **Failing which compulsory licence may be issued**

Role of Patent Attorney

***Drafting of Specification**

- **Possible equivalent variations**
- **Broadest valid claim**
- **Avoid any pitfall**

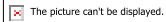
***Submission against Office Objections and related Proceedings**

***To face Opposition Proceedings**

***Execution of Licence Agreement, Deed of Assignment and other Legal Matters**



Enforcing Patent Rights

 The picture can't be displayed.

- It is up to the “Patentee” to enforce their patent against infringers by filing a case in federal court
- Patent holders have the legal right to exclude others from making, using, selling, or importing the invention

Patent Infringement

1. Demand the infringer stop & pay damages for past infringement
2. Offer a “Royalty”
3. Ignore the infringement or postpone action
4. File a patent infringement lawsuit in federal court

Litigation vs Licensing

If the objective is to stop a competitor from offering a product that infringes one's patent.

If the objective is to obtain royalty for the use of one's invention.

Should You Take Your Claim To Court?

To enforce a patent through litigation, you must determine the who, what, where, when, and how of events...

- Determine who infringed
- Create a claim chart detailing the product & service that has infringed
- Determine your location of suit
- File your claim as soon as you have proof
- Select a judge or jury

Rise of Patent Assertion Entities

Patent Assertion Entities (PAEs) are companies that buy and license patents in responsible business negotiations that provide legitimate benefits.



- **“Patent Trolls”** derive settlement revenue from defendants who are willing to settle instead of defending against a suit.
 - Acquire questionable patents & file suit against multiple defendants.
 - Rely on the threat of litigation expenses to extract settlements.

Alternatives To Litigation



- Litigations are costly, timely, & disruptive
- Alternative dispute resolutions (ADR) include Mediation & Arbitration

Mediation

An informal type of dispute resolution in which a third party (*mediator*) helps two parties come to an agreement.

Arbitration

A process in which the parties to a dispute present arguments and evidence to a dispute resolution practitioner (*arbitrator*) who makes a determination.

*Thank
You*

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