



Unit –II

Patents and Procedure For Obtaining Patent

Principles Underlying The Patent Law In India

- Inventions must be **new, useful and non-obvious**

1. Novelty or inventiveness:

- The element of novel invention is dependent upon the state of prior art, i.e. the existing knowledge and similar inventions already known in the particular field.
- E.g. The recent grant of patent in USA to Turmeric products was challenged on this ground, the Indian council of scientific and industrial research (CSIR) challenged the grant of patent on Turmeric by the US patent office on the ground that 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 time immemorial.
- The CSIR was successful in getting the grant of patent

Principles Underlying The Patent Law In India

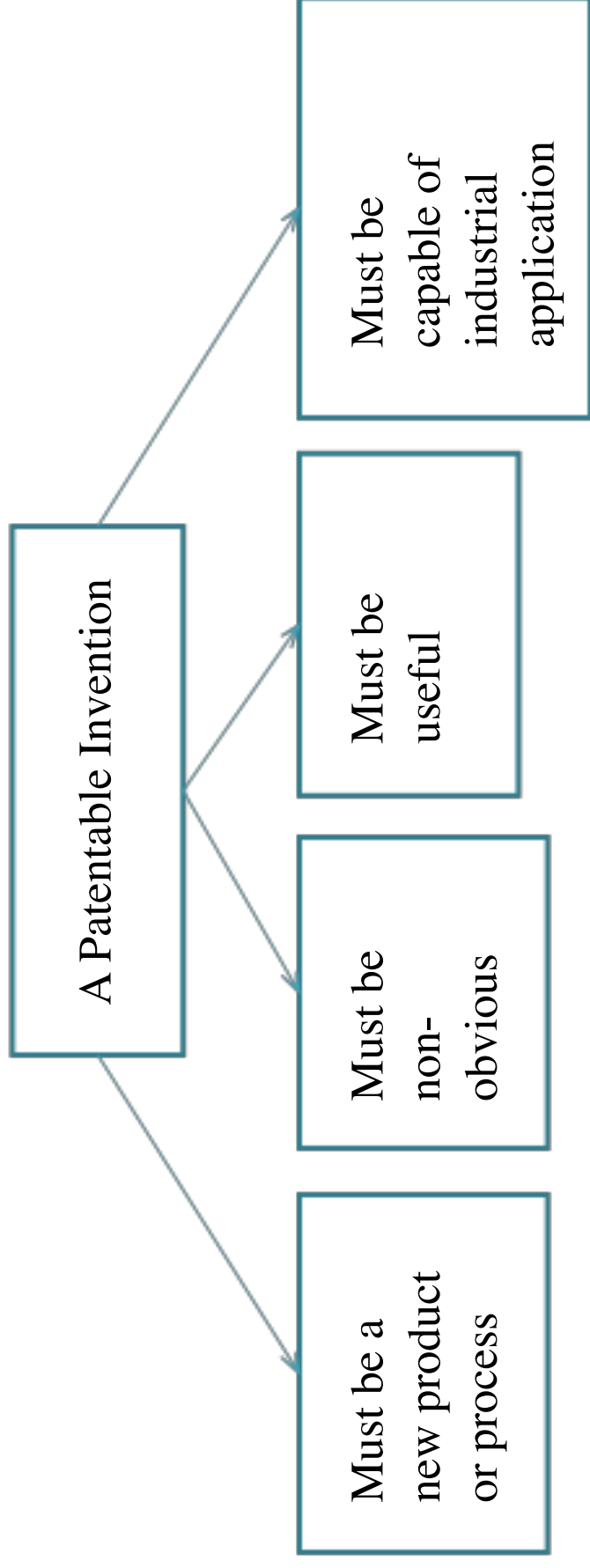
2. Usefulness or utility:

- 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 mankind cannot be patented.
- In some countries, not so useful inventions are protected as utility models.
- But that concept is not statutorily recognized in India.
- For example, the following claims do not represent a specific utility/use:
 - A class of chemical compounds may be stated to be “pharmaceutically active” without any explanation of the type of activity
 - An isolated DNA sequence where the only stated utility is that it may be used as a “molecular marker” or “gene probe”

Principles Underlying The Patent Law In India

3. **Non-obviousness:**

- The invention must be non-obviousness to a person reasonably skilled in the art to which the invention relates.
- Example: 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.



Principles Underlying The Patent Law In India

- Inventions must be disclosed fully



The full disclosure of the patented invention is mandatory.



If an inventor fails to disclose the invention fully, the patent will not be granted.

- Use and acquisition of patented invention by the Central Government



The Act recognizes that the Central Government may use any invention even without the payment of royalty to the inventor.



Central Government can acquire the patents

Principles Underlying The Patent Law In India

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



Use of a patented invention is permissible for research or experimental purpose or for imparting knowledge.

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



Use by a person other than the patentee, patentee's assignee or licensee would be an infringement of the patent. ^{the persons patent would be illegal} It is illegal ^{entitled to these reliefs}



Reliefs in cases of infringement



Interlocutory injunction



Damages

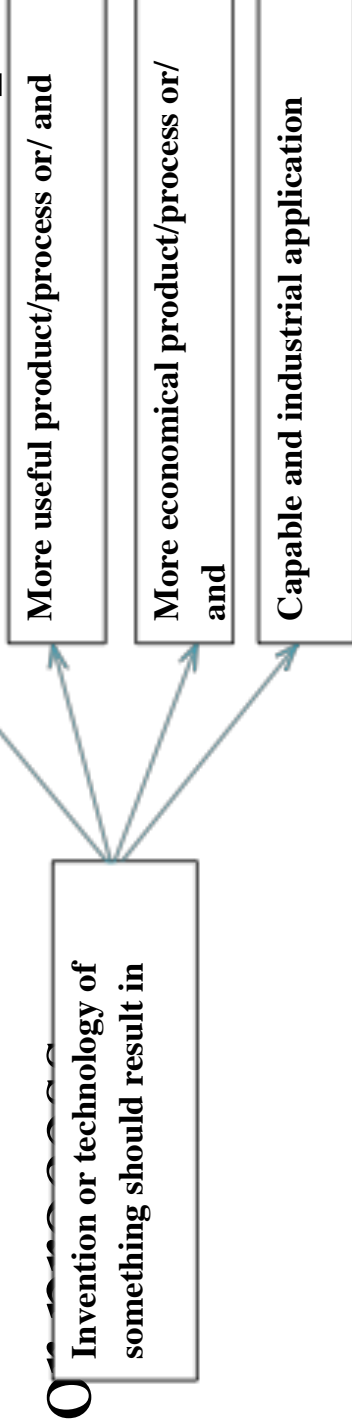
Principles Underlying The Patent Law In India

- Burden not on patentee in case of infringement
 - the subject matter of patent is a process for obtaining a product, the defendant is to prove that his product is different from the patented process if:
- The subject matter of the patent is a process for obtaining a new product
 - There is a substantially likelihood that the identical product is made by the process
- Prima facie proof of infringement
- Special status of patents relating to medicines, food items and chemicals

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 a 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 existing knowledge or having economic significance or both and that makes the

An improvement on something known is a **Patentable** invention if it is a new, non-obvious, and useful subject-matter of patent, provided it results in a new product or process or a more useful or a more economical product or process.



Intangibles Are Not Patentable

If result produced is either a new article or a cheaper article than before, the combination will be entitled to 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 same input. Such method of manufacturer yields the old result, i.e. aspirin, but does it in a more economical manner. Such method would be entitled to patent.
- An “alleged invention” means something which is alleged to be a manner of new manufacturer even though it may not be so.
- Improvement of a manner of a 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 above kind must not be patentable within the Act. In other words, it should not be an invention prohibited from being patented under

Inventions Which Are Not
Patentable Under the
Patent Act the one
contrary to established natural
laws is not patentable. A perpetual
motion machine or a machine that
gives more than 100% performance
cannot be patented according to this
clause. An invention whose
commercial exploitation is contrary to
public order and morality or which
causes serious prejudice to human,
animal, plant or the environment is not

Inventions Which Are Not

Patentable Under The for the

medicinal, surgical,
curative,

prophylactic

diagnostic,

therapeutic

or

Patent Of Addition

- If a person who has applied for a patent or a person who has already obtained a patent makes an application to controller in respect of any improvement in or modification of an invention described or disclosed in complete specification of invention, the controller may grant patent for such improvement or modification termed as Patent of Addition.
- However, a patent shall not be granted as a patent of addition unless the date of filing of application was same as or later than date of filing of the application in respect of main invention.
- The Patents (Amendment) Act, 2005 has added a new provision that patent of addition shall not be granted before grant of patent for main invention

Terms Of Patent Of Addition

- A patent of addition shall be granted for a term equal to that of a patent for the main invention or for so much of term of patent of main invention as has not expired.
- However, if the patent for 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 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 be thereafter 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:
 - Product
 - Process
- The Act recognizes only the process patents in foods and drugs, and not product patents in them.
- There as been a clash between India and the other signatories of the World Trade Organization (WTO) in this regard. The other members of WTO want India to

The Applicant to File Provisional Specification

- 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.

Provisional Specification

- A provisional specification is a patent document filed to establish priority of the invention in case the disclosed inventions is only at a conceptual stage and a delay is expected in submitting full and specific description of the invention.
- It is permanent and independent scientific cum legal document and no amendment is allowed in this.
- It is a document of record and it cannot be amended by adding new matter to it once

Provisional Specification

- Provisional Specification contains the following:
 - Title
 - Written description
 - Drawings, if necessary and
 - Claims(optional)
- A patent is never granted on the basis of a provisional specification.
- It has to be followed by a complete specification within 12 months from the date of its filing for obtaining a patent for the said invention.

Provisional Specification

- It is not necessary to file an applicant with provisional specification before the complete specification.
- An application with complete specification can be filled right at the first instance.
- If there aren't any significant changes the applicant can also file the same provisional specification as complete specification within 12 months.

Complete Specification

- The complete specification is a technological document which fully and particularly describes the invention and discloses the best method of performing the invention.
- As the complete specification is an extremely important document in the patent proceedings it is advised that it should be drafted with utmost care without any ambiguity

Complete Specification

- Important Elements of the Complete Specification:

➤ As per Section 10, every complete specification is required to –

- fully and particularly describe the invention and its operation or use and the method by which it is to be performed;
- disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and
- end with a claim or claims defining the scope of the invention for which protection is claimed; and
- be accompanied by an abstract to provide technical information on the invention.

Also, make reference to deposit of the biological material in the International Depository Authority, if applicable.

Complete Specification

- Controller may amend the abstract for providing better information to third parties.
- If the applicant mentions a biological material in the specification which may not be described in such a way as to satisfy clauses (a) and (b) above and if such material is not available to the public, the application shall be completed by depositing the material to an International Depository Authority under the Budapest Treaty.

- By fulfilling the following conditions, namely:

➤ the deposit of the material shall be made not later than the date of filing the patent application in India and a reference thereof shall be made in the specification within the prescribed period;

➤ all the available characteristics of the material required for it to be correctly identified or indicated are included in the specification including the name, address of the depository institution and the date and number of the deposit of the material at the institution;

➤ access to the material is available in the depository institution only after the date of the application for patent in India or if a priority is claimed after the date of the priority;

➤ disclose the source and geographical origin of the biological material in the specification, when used in an invention.

Types of Patent Applications

- 1. Ordinary Application, i.e., an Application which has been filed directly in the Indian Patent Office.
- 2. Convention Application.
- 3. PCT Application (International Patent).
- 4. Divisional Application, which can result from division of a Patent Application.
- 5. Patent of Addition, which may be filed subsequent to the Filing of an Application for Patent, for an improvement or modification.

Procedure For Obtaining Patent

- It consists of the following steps:
- Submission of application
- Examination of application
- Advertisement of acceptance of complete specification
- Opposition to grant of patent to the applicant
- Hearing of the parties
- Grant aid and sealing of patent.

Submission Of Application

- Section 6 to 11 of the act list the conditions, which are to be satisfied by the applicant while submitting application for a grant of a patent
- Section 7 provides the form for 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

Persons Entitled To Apply For Patents

- Section 6 provides that a patent application can be made:

➤ By any person claiming to be the first and true inventor of the invention,

➤ By any person being the assignee of the person claiming to be true and first inventor in respect of right to make such application,

➤ 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.

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 patent later—any time after another inventor has made an application, he will not be entitled to get the patent.

Meaning Of First And True Inventor

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

Assignee Of An Inventor May Apply

- The right to apply for 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 is entitled to apply for patent.
- The person entitled to apply in such situation would be determined by the contractual relationship, whether express or implied, between the employer and the employee.
- In general, the invention made by an employee even though made during employer's time and with employer's materials and equipment would be

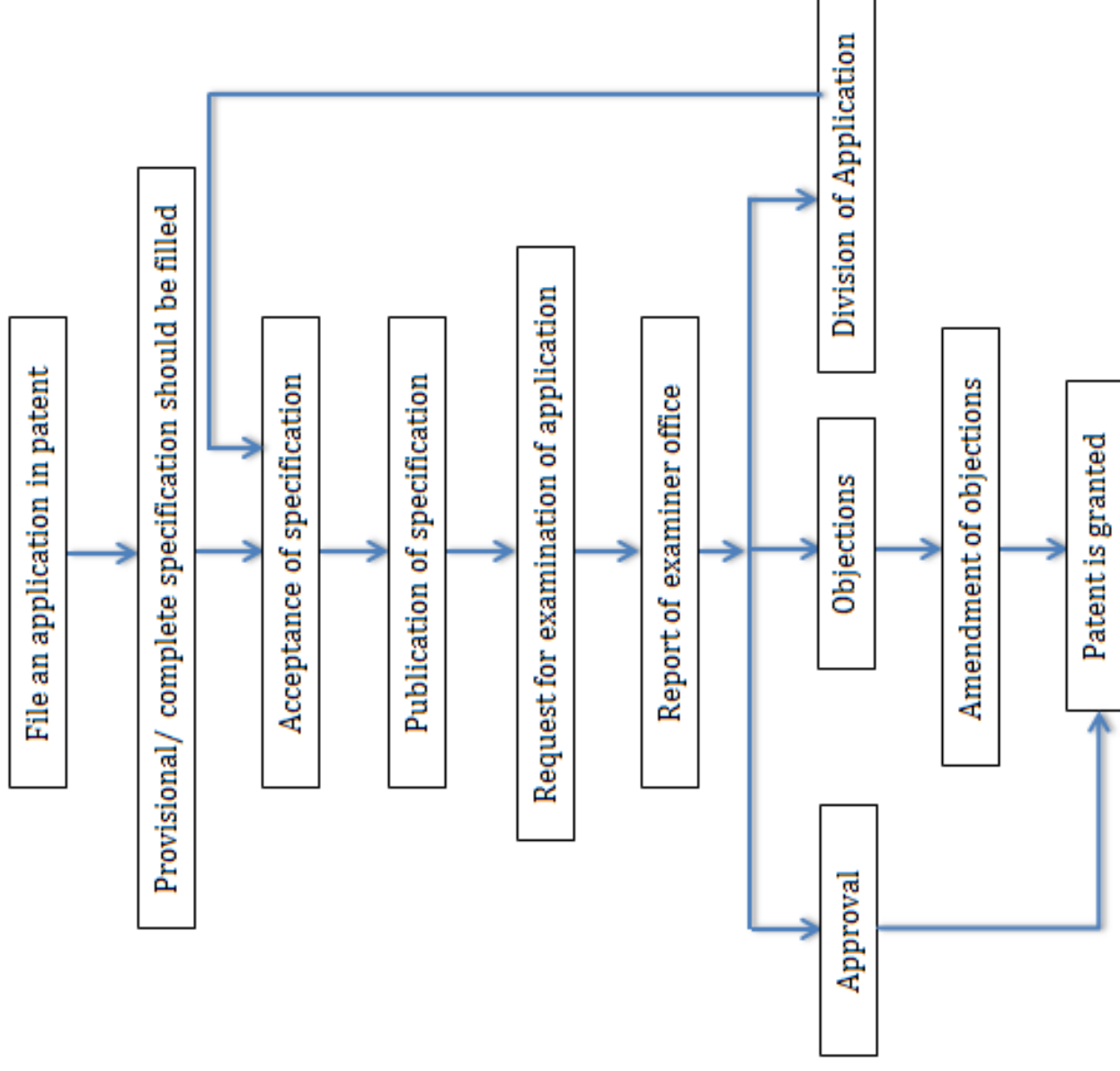
Form Of Application

- Section 7 (1) provides that only one application can be made for one invention and it has to be made in prescribed form (available in patent office) and file in patent office.
- Every specification, whether provisional or complete, shall be made in form 2 prescribed under the patents rule, 2003.
- Section 7 (1A) provides for application for international patent under PATENT COOPERATION TREATY.

- Section 7 (3) lays down that every application shall state that applicant is in possession of invention and shall name the person claiming to be true and first inventor and where the person so claiming to be the 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 true and first inventor.

- Section 7 (4) provides that every such application (not being a convention

Procedure For Registration Of Patent



Special Provision For Foreign

Applicants

- Section 8 provides that where an applicant for 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 along with the application or subsequently within the prescribed time [as the controller may allow]:



A statement setting out detailed particulars of such application,



An undertaking, that up to the grant 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 of patent is filed in India, till the grant or refusal to grant of patent, the controller may also require to furnish details relating to the processing of application in a country outside India. The statement and undertaking required to be filed shall be made in Form 3 as specified in Patents Rule, 2003.

Term of Patent

- In respect of a invention claiming process of manufacture of a substance intended to be used as food or medicine ---- 5 yrs from the date of sealing or 7 yrs from the date of patent whichever is shorter.
- In case of any other invention ---- 14 yrs from the date of patent.

Expiry of a Patent

- A patent can expire in the following ways:
 - The patent has lived its full term.
 - The patentee has failed to pay the renewal fee.
 - The validity of the patent has been successfully challenged by an opponent by filing an opposition either with the patent office or with the courts.
 - As soon as the patent expires, it pass to the general public domain and now anybody can use it without the permission of the original inventor