

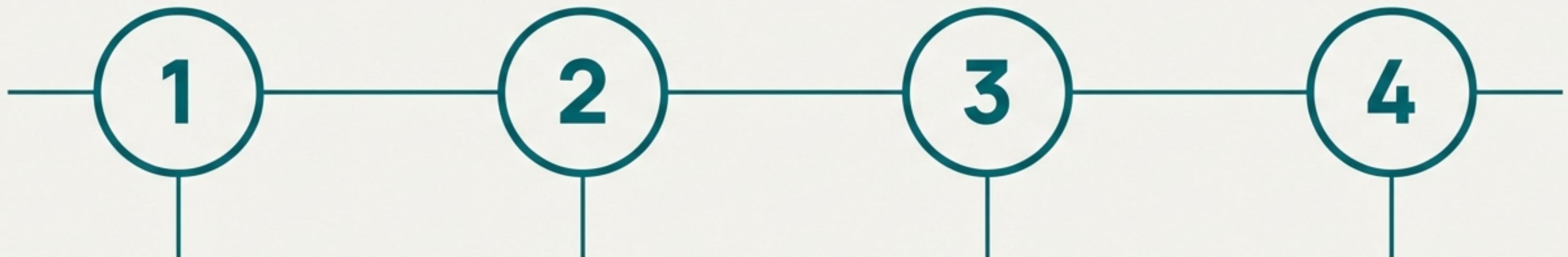


The Inventor's Journey: A Guide to The Patents Act, 1970

Understanding the Framework for Protecting Innovation in India

Based on The Patents Act, 1970 (as amended up to 11-03-2015)

From Idea to Asset: The Four Stages of the Patent Journey



PART 1: THE FOUNDATION

Defining the criteria for patentability. What qualifies as an 'invention' and what is statutorily excluded?

PART 2: THE APPLICATION

The procedural first steps: preparing and filing your claim to secure a priority date.

PART 3: THE SCRUTINY

The interactive phase: publication, examination by the Patent Office, and handling objections or opposition.

PART 4: THE GRANT & BEYOND

The destination: understanding the rights conferred by a patent, its term, and the responsibilities of a patentee.

The Three Pillars of an Invention

An invention is a “new product or process involving an inventive step and capable of industrial application.” – Section 2(1)(j)



1. New Invention (Novelty)

Must not have been anticipated by publication in any document or used in the country or elsewhere in the world before the filing date. It has not fallen into the public domain or become part of the ‘state of the art’. (Sec 2(1)(l))



2. Inventive Step (Non-Obviousness)

A feature that involves a technical advance compared to existing knowledge, or has economic significance, or both. It is not obvious to a person skilled in the art. (Sec 2(1)(ja))



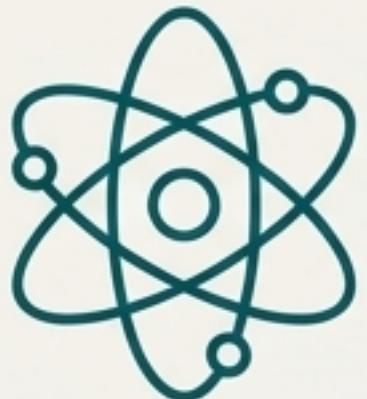
3. Capable of Industrial Application

The invention must be capable of being made or used in an industry. (Sec 2(1)(ac))

Who is the ‘True and First Inventor’?

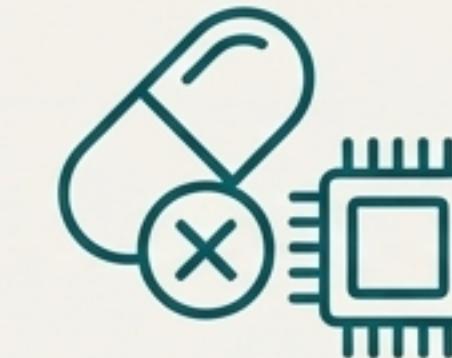
Per Section 2(1)(y), this term does not include the first importer of an invention into India, or a person to whom an invention is first communicated from outside India. It refers to the actual creator.

Navigating the Exclusions: What Lies Outside Patent Protection



Fundamental Principles & Discoveries

- Frivolous inventions or those contrary to natural laws (Sec 3(a)).
- The mere discovery of a scientific principle, abstract theory, or any living/non-living substance occurring in nature (Sec 3(c)).



Specific Exclusions in Science & Technology

- Mere discovery of a new form of a known substance unless it enhances known efficacy (Sec 3(d)).
- Methods of agriculture or horticulture (Sec 3(h)).
- Any process for medicinal, surgical, curative, or diagnostic treatment of humans or animals (Sec 3(i)).
- Computer programs *per se* or algorithms (Sec 3(k)).
- Inventions relating to atomic energy (Sec 4).



Business, Information & Creativity

- Mathematical or business methods (Sec 3(k)).
- Literary, dramatic, musical, or artistic works (Sec 3(l)).
- A mere scheme, rule, or method of performing a mental act or playing a game (Sec 3(m)).
- The presentation of information (Sec 3(n)).



Public Policy & Traditional Knowledge

- Inventions contrary to public order or morality, or which cause serious prejudice to human, animal, plant life, or the environment (Sec 3(b)).
- An invention which is, in effect, traditional knowledge (Sec 3(p)).

Filing the Application: Securing Your Priority



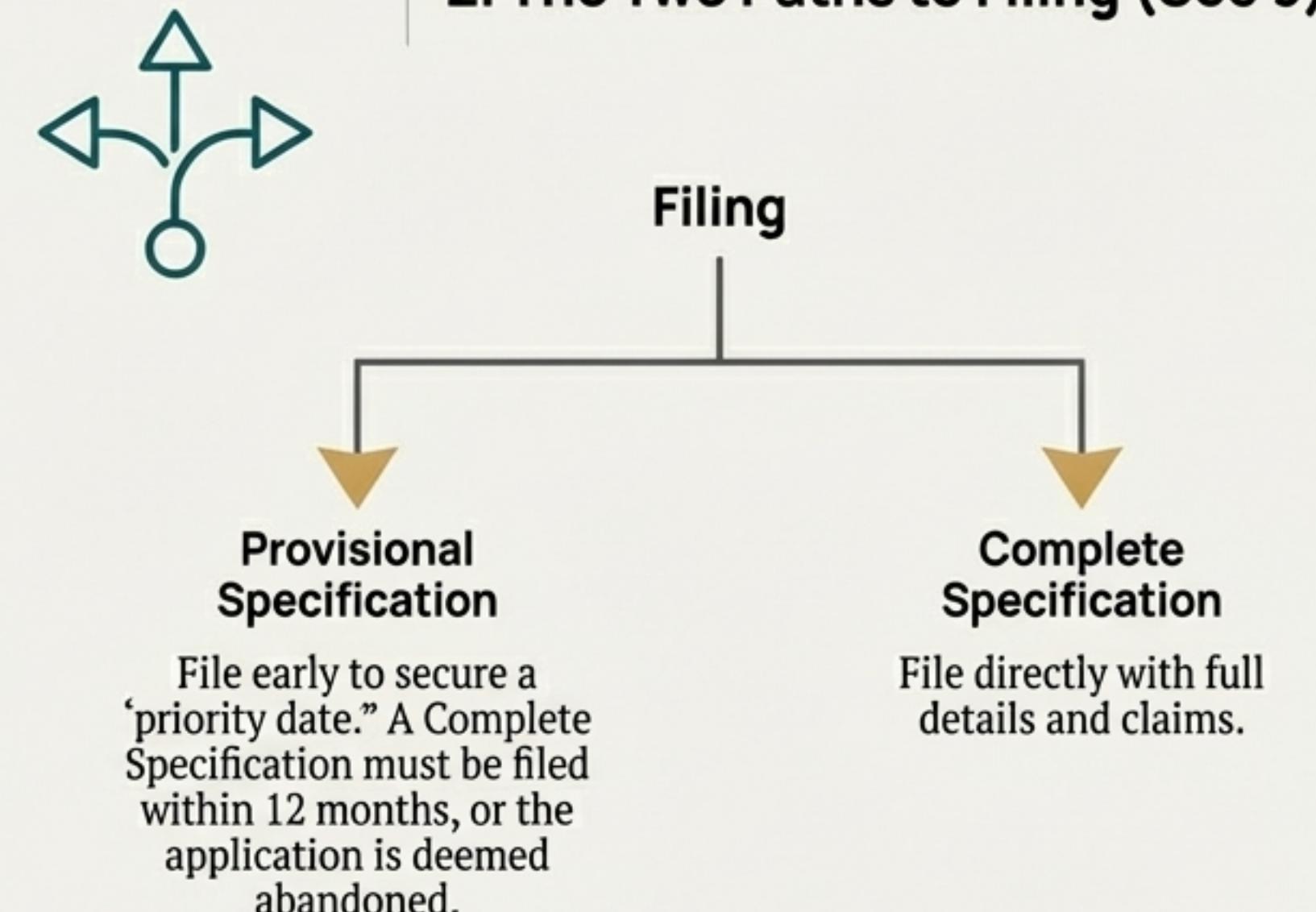
1. Who Can Apply? (Sec 6)

- The 'true and first inventor.'
- An assignee of the inventor.
- A legal representative of a deceased inventor.
- Can be filed alone or jointly.



3. Core Application Requirements

- **One Invention per Application:** Every application shall be for one invention only (Sec 7(1)).
- **Declaration of Inventorship:** The application must name the true and first inventor (Sec 7(3)).
- **Disclosure of Foreign Filings (Critical Compliance):** Applicants must file a statement with details of any applications for the same invention prosecuted outside India and undertake to keep the Controller updated (Sec 8).



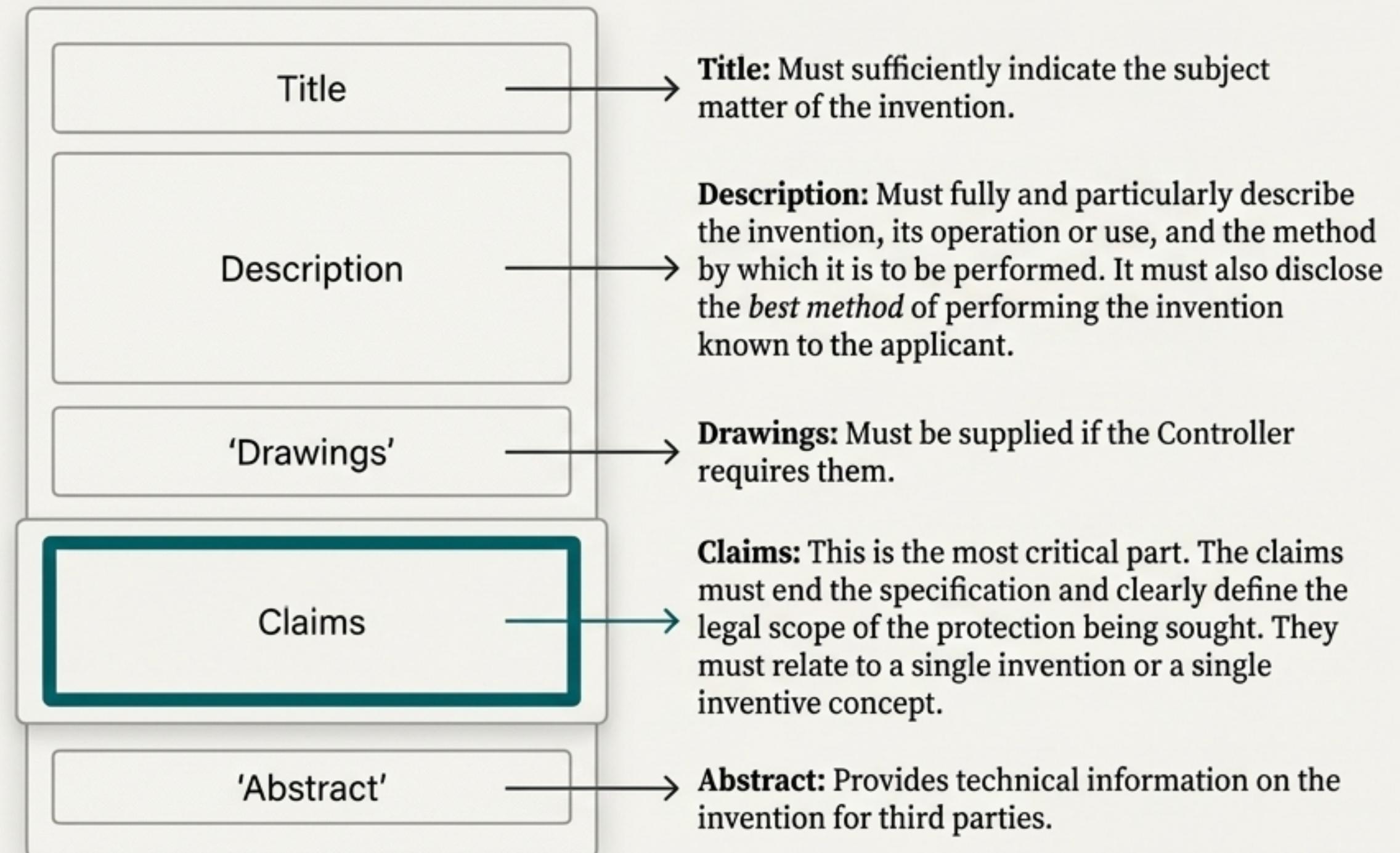
The Blueprint of Your Invention: Anatomy of a Complete Specification

Based on Section 10 of The Patents Act, 1970



Special Proviso: Biological Material

If the invention uses biological material that cannot be fully described and is not publicly available, it must be deposited in an International Depository Authority under the Budapest Treaty. The specification must include the depository's name, address, and the deposit deposit date and number. (Proviso to Sec 10(4)(d))



The Gauntlet: From Filing to First Scrutiny



1. Publication (Sec 11A)

- The application is ordinarily published after 18 months from the filing date.
- From this date, the applicant gains "like privileges and rights as if a patent...had been granted."
- **Important Caveat:** The applicant cannot institute any infringement proceedings until the patent is actually granted.

Wait



2. Request for Examination (Sec 11B) - A CRITICAL STEP

- An application is **NOT** examined automatically.
- The applicant or any other interested person **must** make a formal request for examination within a prescribed period.
- **Consequence of Inaction:** If no request is made, the application "shall be treated as withdrawn by the applicant."

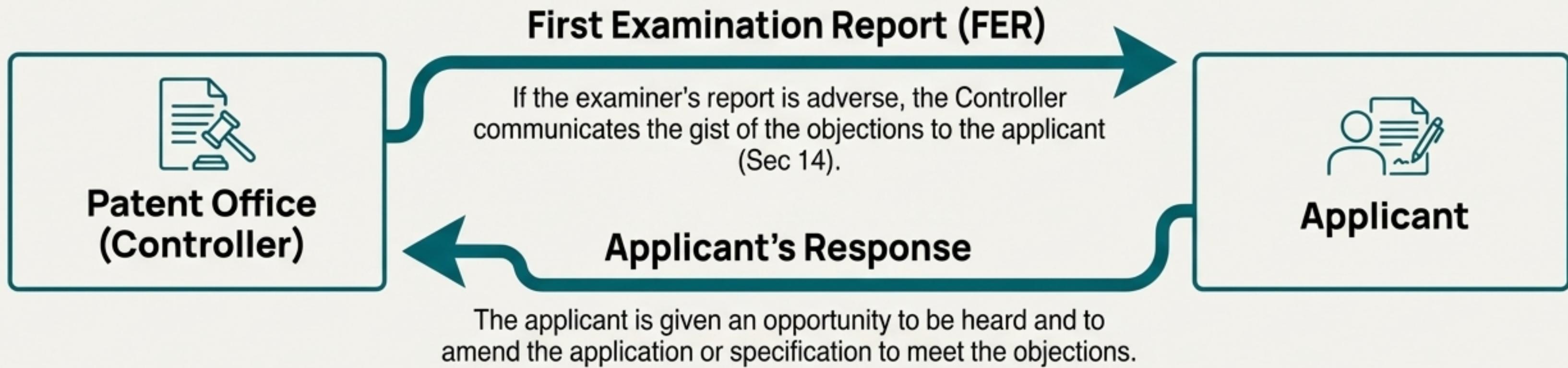
Applicant Initiates



3. The Examiner's Report (Sec 12 & 13)

- Once requested, the Controller refers the application to an examiner.
- The examiner conducts a search for "anticipation" (prior art) and reports on whether the application complies with the Act and if there are any lawful grounds for objection.

The Dialogue: Responding to the Patent Office



Controller's Powers (Sec 15)

The Controller can refuse the application or require amendments if it does not comply with the Act.

The Deadline is Absolute (Sec 21)

The applicant must comply with all requirements within a prescribed period from the date the first statement of objections is forwarded.

Consequence of Non-Compliance: If all requirements are not met within this period, the application "shall be deemed to have been abandoned."

Challenging the Claim: The Two Windows for Opposition

1. Pre-Grant Opposition (Sec 25(1))



When

After publication but *before* the patent is granted.



Who

"Any person" can file a representation.



Grounds

Wrongful obtaining, lack of novelty, obviousness (no inventive step), not an invention, insufficient disclosure, failure to disclose foreign filing information (Sec 8 violation), etc.



Process

The Controller hears the person and disposes of the representation.

2. Post-Grant Opposition (Sec 25(2))



When

Within one year *after* the date of publication of grant.



Who

"Any person interested."



Grounds

The same comprehensive grounds as pre-grant opposition.



Process

The Controller constitutes an 'Opposition Board' to examine the notice and submit recommendations. After hearing both parties, the Controller will order to maintain, amend, or revoke the patent.

The Destination: Your Rights and Responsibilities as a Patentee

The Grant (Sec 43)

If the application is in order and has survived scrutiny and opposition, the patent is granted, sealed, and entered into the register.



Term of Patent (Sec 53)

20 years

From the date of filing the application. For international applications under PCT, it is 20 years from the international filing date.

The Exclusive Rights Conferred (Sec 48)



For a Product Patent

The exclusive right to prevent third parties from making, using, offering for sale, selling, or importing the product in India without consent.



For a Process Patent

The exclusive right to prevent third parties from using the process, and from using, offering for sale, selling, or importing the product *obtained directly* by that process in India without consent.

Subject to Conditions (Sec 47): These rights are not absolute and are subject to conditions, including use by the government for its own purpose and use by any person for experiment or research.

The Journey Continues: Maintaining and Managing Your Patent

Paying Renewal Fees (Sec 53(2))



A patent will cease to have effect if renewal fees are not paid within the prescribed period. This is an ongoing obligation.

Protecting Improvements with Patents of Addition (Sec 54)



If you make an improvement or modification to your main invention, you can apply for a “Patent of Addition.” Its term is linked to the main patent, and no separate renewal fees are payable.

Restoring a Lapsed Patent (Sec 60)



A patent that has ceased due to non-payment of renewal fees can be restored. An application can be made within 18 months from the date it ceased, provided the failure to pay was “unintentional.”

Amending a Specification (Sec 57 & 58)



A patentee can apply to amend the complete specification after grant, but this cannot broaden the scope of the claims or add matter not previously disclosed.

When a Patent is Extinguished: Surrender and Revocation

Voluntary Surrender (Sec 63)



A patentee may, at any time, offer to surrender their patent. The offer is published, and interested parties can oppose the surrender.

Revocation (Sec 64)



A patent can be revoked on a petition by “any person interested” or the Central Government, or as a counter-claim in an infringement suit.

Key Grounds for Revocation include:

Key Grounds for Revocation include:

- The invention is not new or lacks an inventive step.
- The subject is not a patentable invention under the Act.
- The specification does not sufficiently describe the invention.
- The patent was obtained on a false suggestion or representation.
- Failure to disclose information on foreign applications (Sec 8 violation).
- The applicant contravened secrecy directions (Sec 35) or foreign filing restrictions (Sec 39).

Revocation in Public Interest (Sec 66)

The Central Government can declare a patent revoked if it or the way it is exercised is “mischievous to the State or generally prejudicial to the public.”

The Balancing Act: Public Interest and Compulsory Licensing

Guiding Principles (Sec 83)

The Act emphasizes that patents are granted to secure that inventions are worked in India, not merely to enable monopolies on importation. They should make the invention's benefits available at 'reasonably affordable prices to the public.'



What is a Compulsory License?

It is a license granted by the Controller to a third party to work the patented invention without the patentee's consent.

Grounds for a Compulsory License (Sec 84)

At any time after 3 years from the date of grant, any person may apply if:



1. The reasonable requirements of the public for the patented invention have not been satisfied.



2. The patented invention is not available to the public at a reasonably affordable price.



3. The patented invention is not worked in the territory of India.

A Special Case: Inventions of National Importance

Secrecy Directions (Sec 35)



If the Controller deems an invention relevant for “defence purposes,” they may issue directions prohibiting or restricting its publication.

Foreign Filing Permit (Sec 39)



A person resident in India **cannot** file a patent application outside India for an invention **first**, without obtaining a written permit from the Controller.

Exception: No permit is needed if an application for the same invention was first filed in India at least six weeks prior, and no secrecy direction has been issued.

Serious Consequences of Contravention (Sec 40)



If an applicant violates the secrecy directions (Sec 35) or the foreign filing rule (Sec 39), the Indian patent application “shall be deemed to have been.

If a patent has already been granted, it “shall be liable to be revoked under section 64.”

Mastering the Inventor's Journey: Key Takeaways

1 A Strong Foundation is Non-Negotiable

Before starting, ensure your invention meets the three pillars of novelty, inventive step, and industrial application, and is not explicitly excluded by Sections 3 & 4.

2 The Process Demands Proactive Engagement

The journey is not passive. You must actively file the Request for Examination to initiate scrutiny and respond to all objections from the Controller within strict deadlines to avoid abandonment.

3 Rights are Powerful but Balanced

A 20-year patent grants strong exclusive rights, but these are counterbalanced by robust opposition proceedings for third-party challenges and public interest provisions like Compulsory Licensing.

4 Procedural Compliance is Critical

Meticulous adherence to procedural rules, such as disclosing foreign filings (Sec 8) and obtaining foreign filing permits (Sec 39), is essential. Failure can lead to abandonment or revocation.

The Indian Patents Act, 1970 provides a robust but demanding framework. Understanding this journey is the first step to successfully protecting and commercializing your innovation.