

Law Relating to patents

- 1) Patent is a statutory right given to a person for his invention for a limited period of time by the Govt. In exchange of full disclosure of his invention.
- 2) An invention is patentable if -
 - a) It is novel.
 - b) It has inventive steps / It is not obvious.
 - c) It should be capable of industrial application.
 - d) It does not fall under sec 3 or 4 in the patent Act.
- 3) Following inventions are not patentable because they fall under sec 3 of Act:
 - a) Invention which is frivolous or against natural law.
 - b) The use of which is contrary to morality or public order.
 - c) It is a mere discovery of a scientific principle or just an abstract theory.
 - d) It is a discovery of a new form of known substance which does not enhance the efficacy or a new use of a known substance.
 - e) It is a new substance obtained by just a mixture of known substance.
 - f) Any process of the medical, surgical treatment.
 - g) A method of Agriculture & horticulture.
 - h) Plants and animals in whole.
 - i) Computer programme.
 - j) Literary, dramatic, musical or artistic work.
 - k) Any other playing game.

Section 4 prohibits the grant of patent in respect of an invention relating to atomic energy.

1) In case of ^{Novartis} Abi vs. Union of India the issue was with regards to the application of Sec 3(d) wherein the court held that merely increasing the bioavailability of any substance with increasing the therapeutic accuracy would not allow the same to be patented.

2) The act has setup second tier of qualifying standards where in the applicant has to prove the enhancement of therapeutic accuracy in order to get patent.

patents

A patent is a rights granted for any new work which is not anticipated by prior publication in any patent or non patent literature.

So, the invention is considered new if it has not been disclosed in prior art where prior art means everything that has published before the public before the date of filing of complete specification.

Advantages

- a) The patentee has complete right to restrict outsiders from using the patent.
- b) The patentee can file a suit for encroachment of patent and ask for remedies like injunction and compensation.
- c) Patentee can commercially exploit his creation as per his choice.
- d) A patentee has the exclusive right to make any changes or alteration of an invention.

In Raj Prakash vs Mangat Ram Choudhary
- The court held that inventive step means to discover something not found by anybody previously, which means that the creator was the first to embrace it.

- Who is entitled to make an application for patent
- a) The inventor
 - b) The assignee of the person claiming to be the first inventor.
 - c) Legal representative of any deceased person

Form of Application and provisional complete specification -

- a) A single application can be made for one invention only and in case the application is by virtue of assignment then the proof of right to make application has been to be furnished.
- b) Every application needs to be first filed with the patent office in India and if the applicant wants it can also make an app. under PCT designating India
- c) Every such application needs to be accompanied ~~with~~ with a complete or provisional specification.
- d) Further if a provisional application has been filed then the same has to be substituted by complete specification within 12 months of application failing which the application is deemed to be abandoned.
- e) If a complete specification is filed but the

applicant yet wants to add some more specification than he may apply to the controller to make the application as provisional ~~within~~ 1

g) The applicant may also request the controller to post date of application.

- a) General procedure
- b) Filing of patent application
- c) Publication after 18 months
- d) Grant opposition/Representation by any person
- e) Request for examination
- f) Examination grant or refusal
- g) Publication of grant of patent
- h) Post grant opposition to grant patent
- i) Decision by controller.

Content of Specification

1) Every application must be supported by a complete or provisional ^{specification} following are the content of a complete specification:

- a) Fully and particularly describe the invention, its use and the method by which it is to be performed.
- b) Disclose the best method of performing the invention known to the applicant.
- c) End with a claim or claims set against the invention.
- d) Abstract on the technical information on the invention.

2) If the applicant mentions any biological material which cannot be described and is not available

lable to the public than the application shall be completed by depositing the material with an international depository authority.

3) The following conditions must be satisfied:

a) The deposit of material shall be made not later than the date of application.

b) All the characteristics of the material should be properly identified or indicated.

c) The details of the depository where the material is deposited shall be mentioned in the application.

d) The access to material shall be available after the publication of the application.

e) The applicant should also disclose the source of the geographical origin of the biological material.

publication of application

1) Every application for patent shall be published after the expiry of 18 months from the date of app. or priority date w-e-earlier

2) However, An applicant may make a request to the Controller to publish the application even before the expiry of period.

3) The Controller shall publish the application as soon as possible.

4) Upon the publication of application that the depository instrument shall also make the biological material available to the public.

5) The patent office can also be available the

6) From the date of publication of application till the grant of patent the applicant shall have like privileges as that of a patent holder. However He shall not have the right to file a case of infringement until the patent is granted.

7) Every application needs to be published except:

- a) Application in which secrecy direction is imposed.
- b) the application has been abandoned.
- c) Application which has been withdrawn 3 months prior to 18 months.

Request for examination

1) No application shall be examined unless the applicant makes a request for application.

2) If no application is made, the application is treated as abandoned.

Examination of application

1) Whether request for examination have been made to the controller then the controller shall forward the same to the examiner to report about the same.

2) The Examiner shall examine make report in following manner:

- a) Whether the application & specification is as per the requirement of the Act.
- b) There is any lawful ground of objection or not.
- c) The result of investigation or any other matter.

3) The examiner now investigate to ascertain whether the invention claim has been anticipated before the date of filing of application or is claimed in any other complete specification published on or after the date of applicant's complete specification.

4) The report of the examiner is not considered by the controller and if there is any adverse objection then OOBH must be provided to the applicant.

5) Based on this the controller may accept or reject the application.

6) If the application is found to be incomplete and the controller refused to it than the patent is granted with the seal of the patent office and the date on which the patent is granted shall be entered in the register.

7) Term of patent

i) Every patent registered shall have a total term of 20 years but the same needs to be renewed after 3rd year from the date of filing of application. Thereafter the fees is paid every year.

ii) A patent lapses at the expiry of twenty years or year the non payment of renewal fees.

iii) If there has been a lapse because of non payment the same can be renewed by paying applying to the Controller within 18 months of lapse, provided the applicant needs to

prove that the lapse was unintentional and there has been no dealing in the making of application.

iv) The controller after hearing the application if he so desires can publish the same ~~should be published~~ for objection.

v) At this point the application can be opposed on the ground that:

a) The failure was unintentional

b) There has been an undue delay in the making of application.

vi) ~~the~~ In ~~the~~ ^{such} case the COBH has given both the parties and the patent is either restored or rejected.

Power of Controller to make orders respecting dating of Application and cases of Anticipation

1) The applicant may at any time before the grant of patent apply to the Controller to post date the application.

2) The Controller can order for same for a period not exceeding 6 months.

3) Where the Controller has ordered for amendment to an application or specification then the day on which the revised application is filed again is the date of the application.

4) If the Controller feels that the invention claimed is already anticipated then he may refuse the application unless the applicant proves to the Controller that the claim of complete specification

it is not later than the date on which the other document is published or he amends his complete specification to the satisfaction of controller.

Substitution of Applicant

- 1) Where before the grant of patent any person has got a right by virtue of assignment or operation of law then he may apply to the controller for substitution of the name of the applicant or addition with the current applicant of his name.
- 2) No such application shall be entertained if the assignment is made by one of the two or more joint applicants unless the consent of all the other applicant has been obtained.
- 3) Further no such direction shall be made unless the applicant shows :-
 - a) An acknowledgement by the person from whom the original assignment has been taken.
 - b) That the rights of the claimant have been finally established.
 - c) The applicant has to identify the invention by reference to the application number.
 - d)
- 4) Where one of the two or more joint applicant dies before the grant of patent then the controller may on request of the survivor and with the consent of the legal representative of the deceased direct application shall proceed in the name of the survivor alone.

5) Dispute if any between the joint applicants has to how the application has proceed shall be decided by the Controller.

Opposition to the patent

1) where an application of patent has been published but the patent is yet not granted then any person may in writing apply to the controller opposing the grant of patent on the following grounds:

a) That the applicant wrongfully obtained the invention.

b) That the invention claimed the complete specification has already been published before the priority date.

c) When the invention claimed in the complete specification is similar to another claim filed of which the priority date is earlier than of the applicants claimed.

d) That the invention is publically known or used in India ^{or}

e) That the invention so claimed in any complete specification ~~was already publically known~~ is obvious.

f) That the invention so far claimed in any complete specification is not an invention.

h) That the applicant does not sufficiently described the invention or its best method to use it

g) The applicant wrongfully mentioned the source of application.

2) Any person may oppose at any time ^{after} the grant of patent but before the expiry of one year from the date of publication of grant of patent.

on the following grounds:

- a) That the patentee wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims.
 - b) That the subject of any claim of the complete specification is not an invention.
 - c) That the complete specification does not sufficiently and clearly describe the invention.
 - d) That the complete specification doesn't disclose or wrongly mentions the source and geographical origin of biological material used for the invention.
 - e) The invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve ^{any inventive} ~~Comp~~ ^{Step} Constitution of opposition Board and its proceedings.
- 1) Where an opposition is given to the Controller then he may by order form of opposition board for examination of objection and referred the parties accordingly.
 - 2) The Board has only recommendatory powers and the controller may after giving VOBH to both the parties either maintain/amend / revoke the patent.

Resident not to apply for patents outside India without prior permission.

- 1) No person resident ~~shall~~ in India shall make grant of patent outside India unless the same has been approved by the Controller.
- 2) Also an application for the same invention has to be made in India not less than 6 weeks before the application outside India.
- 3) The controller will not approve if the invention

Date / /
is relevant for defence purpose.

Grant of patents

→ Where an application of patent is in order and same hasn't been refused by the controller and application is not found in contravention of the Act, then the patent shall be granted to the applicant or applicants expeditiously as possible.

In the grant of patent shall be applicable to the following condition:

- a) Any Machine or article or process in respect of which patent is granted may be use by the govt. or made by them for the Government's own purpose.
- b) Any Machine apparatus as well as any process to which the patent is granted may be use by any person purely for any purpose of research as well as imparting instructions to the people.
- c) Further in the case of medicine or drugs the same may be manufactured or imported by the Govt. for the purpose of its own use or distribution in the Hospital maintained by the Govt. or any other hospital as notified by the Central Govt.

Terms of patent

- a) 20 years - from the date of filing for the application of patent.
- b) For international patent - 20 years from the date of filing under PCT.

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c) There after patent should be renewed every year till the life of 20 years, failing which the patent right shall be sealed.

Restoration of lapsed patent and its procedure -

1) The applicant may apply to the Controller for lapsed patent and the Controller is of the opinion that the failure to pay fees was unintentional and that there has been no delay in making of any application for restoration. Then he may publish the application for public objection where the objection may be on following two grounds that the intent failure of fee was intentional.

b) That there has been undue delay in making this application.

2) If any opposition is given then the Controller gives OOBH to both the parties -

3) At the end if no objection is raised or objection is raised is decided by the favour of applicant. Then the Controller may upon payment of renewal fees, renew the patent.

Note: The application for restoration within 18 months from where the patent was ceased.

Rights of patentees of lapsed patents which have been restored.

- 1) Where a patent is restored, similar rights are granted to patentee along with certain condition to protect those persons who may have begun to use the invention after the time it was ceased and the application of restoration.
- 2) No suit can be filed for infringement of patent for the term when it ceased and till its restoration.

Surrender and Revocation of patent.

1) A patentee may surrender his patent by giving notice to the Controller and Controller may publish and notify every other person who have interest of the patent.

2) Any person interested can oppose by sending a notice of to the Controller.

3) Then the Controller provides opportunity to both the parties and decide whether to revoke the patent or not.

Grounds for Revocation of patents.

- 1) Where a similar invention is claimed having early priority date.
- 2) Where the patent application was filed by a person not entitled under the Act.
- 3) Where the patent was wrongfully obtained.
- 4) When the subject matter of claim is not an invention.
- 5) Where the invention claimed is not new or obvious.

- 6/ Where the invention is not useful.
- 7/ Where the invention is to be performed by the method, it is not fairly described.
- 8/ Where the permission obtained is fraud.

Working of patented inventions - General principles -

- a/ patents are ~~in~~ granted to encourage inventions.
- b/ To ensure and secure that the inventions ~~have~~ are worked in India on a commercial scale.
- c/ It is just not given to the patentees who enjoy monopoly rights.
- d/ that the enforcement of patent right shall contribute towards social and economic welfare.
- e/ that the patent do not impede protection of public health.
- f/ that the patent granted cannot prohibit the central govt. for using the same for public health.
- g/ that the patented invention shall be available to the public at reasonably affordable price.

Compulsory licenses

- 1/ These are authorisation given to a party by the Controller to use or sell a particular product or process without the permission of patent owner.
- 2/ Any person interested for grant of compulsory license may at any time after the expiry of 3 years make application to the

Controller on the following ground -

- a) That the reasonable requirement of public has not been satisfied.
- b) That invention is not available to the public at reasonably affordable rate or price.
- c) That the invention is not worked in India.

3) If the Controller is satisfied that any of the above grounds are not being satisfied then he may grant compulsory license as he may deem fit.

4) When considering the application the Controller takes into consideration the following -

- a) nature of the invention.
- b) The ability of the applicant to work the invention towards the public advantages.
- c) The Capacity of the applicant.
- d) Whether any efforts to obtain a license have been by him which have not been successful.

5) Nothing from the above shall apply in case of following -

- a) National emergency.
- b) Extreme urgency.
- c) non-commercial use.
- d) Anti-Competitive practice adopted by the patentee.

Q When the reasonable requirement of public shall not have been satisfied ?

i) If by reason of refusal by the patentee to grant a license in existing trade or the demand for the patented article has been made or market for export its prejudicial affected.

ii) By the reason of conditions of patentee development of any industry is pre-judiciary affected.

iii) The patentee imposes coercive condition like exclusive grant back.

iv) That the patented invention is not being worked in India on a commercial scale.

Revocation of patents by the Controller for non-working -

i) Where a compulsory license has been granted then the CR or any interested party may after the expiry of 2 years from the date of compulsory license apply for to the Controller for revocation of patent on following grounds-

a) That the reasonable requirement of public has not been satisfied.

b) That invention is not available to the public at reasonably affordable rate or price.

c) That the invention is not worked in India.

ii) The Controller if satisfied may revoke

Date ___ / ___ / ___

the patent (He ^{is} put under an applicat obligation to decide upon the application within 1 year.

International arrangements -

- 1) International arrangements are in regards to all convention countries. Here, convention countries is that Country which is signatory to any international or bi-lateral treaty. In which India is also a signatory.
- 2) These countries provide similar privileges to patents register in India as they provide to their own citizen.
- 3) Where any convention Country does not provide same rights to any patent registered in India. Then no national of such Country will be treated for grant of patent or to be registered as assignee or to apply for license.