Patent Documentation, Examination and Infringement

Lesson 6

KEY CONCEPTS

■ Record Books ■ Specifications ■ Patent Filing ■ Prior Use ■ Inventorship ■ Patent Abstract ■ Claims ■ Sufficient Disclosure ■ Examination ■ Patent Cooperation Treaty ■ Publication ■ Examination & Re-examination ■ Doctrine of Equivalence ■ Doctrine of Exhaustion ■ Patent Misuse ■ Infringement

Learning Objectives

To understand:

- The legal framework provided for law regulating documentation, and examination of Patent.
- The process relating to Registration, Documentation and Examination of Patents.
- Protection of registered patent in India.
- The legal machinery in case of Patent Infringement.
- Legal frame work pertaining to Patents.

Lesson Outline

INTRODUCTION

Innovation is a worldwide phenomenon, occurring in all parts of the globe and constantly improving our well-being and quality of life. Over the last decade, as shown in WIPO's Global Innovation Index (GII), innovation expenditures worldwide have been growing faster than GDP. In high-income countries, private sector funding drove much of this growth in innovation expenditure, while in middle- and low-income countries, the contribution of public funds in research and development expenditure, could be as high as 75 percent.

It is human nature to seek technical solutions whenever we encounter problems, whether in relation to daily life needs or a quest to explore outer space. Therefore, the growing number on filings of patent applications is an indicator of human inventiveness in very diverse technological fields. The patent system offers inventors recognition for their creativity and the possibility of material reward for their inventions. At the same time, the obligatory publication of patents and patent applications facilitates the spread of new technical knowledge and the acceleration of innovation activities in society as a whole.

In reality, however, the potential benefits offered by the patent system have not been fully enjoyed by innovators in all parts of the world. While there may be many reasons for this, the opportunity to obtain the special skill set needed to draft a patent application that fully captures the potential of a new invention is a challenge in many countries.

Innovators need well-drafted patent applications if they want to secure the best possible protection for their inventions and reduce the risk of rejection of applications. For third parties, well-drafted patents are just as important: they are not only a valuable source of new knowledge, they show the clear demarcation of the scope of the patent protection, helping to avoid the inadvertent infringement of patent rights or to support a challenge to the validity of a patent. For patent offices, receiving applications that are well drafted enables more efficient handling of patent prosecution.

Also, the completeness of the disclosure and the strength of the claims are crucial criteria for the award of the patent. The Act provides a variety of filtering methods that enable an innovation to be patented and preserved for the specified period of time. One such filtering mechanism is the Examiner's review of a patent application and the Controller's subsequent processing.

In order to identify the relevant prior arts for determining uniqueness and inventiveness of an alleged invention throughout the process of examination as per provisions of the Act and Regulations, the Patent Office thoroughly searches several databases for the invention as detailed in the specification.

Notwithstanding the fact that there are available checks and balances in the form of oppositions, revocations, or counter-revocations in infringement lawsuits, the examination system serves as the principal gatekeeper of the patent system.

The common misconception is that obtaining a patent guarantees total protection from infringement. Yet when a patent is in danger, its owners must take more extensive action to safeguard their rights. Patent litigation refers to legal actions taken to defend patents from infringement; the outcomes may include monetary penalties or an injunction prohibiting further infringement.

PATENT DOCUMENTATION

Lab Notebooks/Log Books/Record Books

Laboratory Notebooks are the birthplace of inventions. Laboratory notebooks (also called a journal, inventor's notebook or log book) is used by inventors, scientists and engineers to record their invention process, experimental tests, ideas and results and observations. It is not a legal document but is valuable, if properly organized and maintained, since it can help establish dates of conception and reduction to practice. An interference proceeding, also known as a priority contest is an inter-party proceeding to determine the priority issues of multiple patent applications. The information can improve the outcome of a patent or a patent contestation.

A patent grants its owner(s) the right to sue those who manufacture and market products or services that infringe on the claims declared in the patent. Typically, governments award patents on either a first to file or first to

invent basis. Therefore, it is important to keep and maintain records that help establish who is first to invent a particular invention. Under U.S. law, a patent is granted to the first to conceive the idea for the invention, not the first to apply for the patent. So a laboratory notebook is essential evidence of the date of conception.

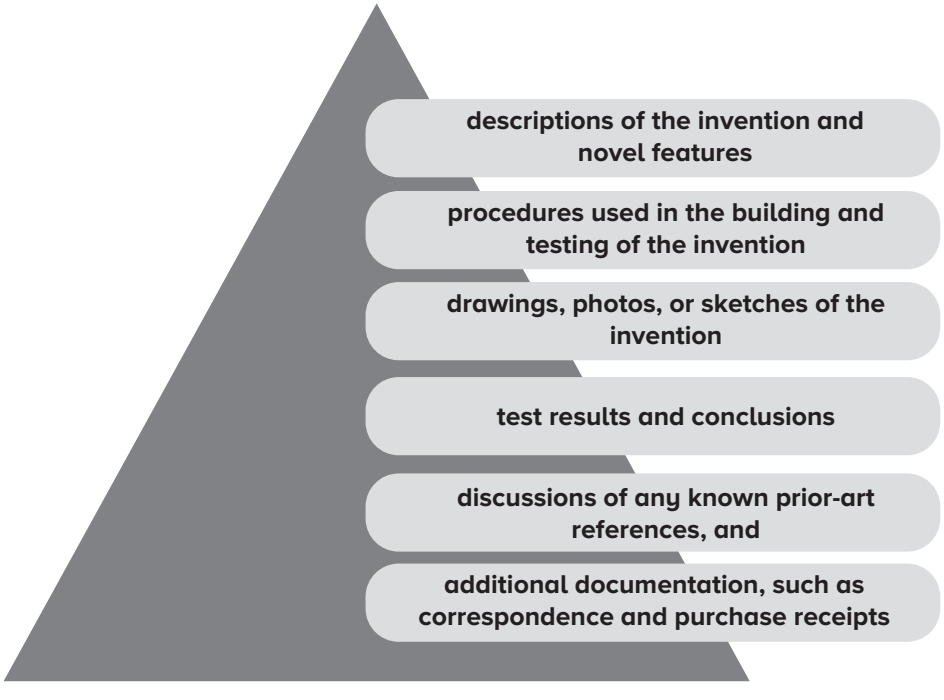
Laboratory notebook is a systematic device for recording all information related to an invention in such a way that it can be used as a key component to develop a case during a patent contestation or patent-related lawsuit.

In most countries, we have a "first to file" system, which means that the right to the grant of a patent lies with the first person to file the patent application for protection of that invention, regardless of the date on which the invention was actually made.

In the US, there is a "first to invent" system. Under this system, priority of invention is awarded to the person who can establish that they made the invention first according to a relatively complex priority of invention calculation. Essentially, in this system, the act of invention is considered to comprise two steps: the "conception" of the invention and the "reduction to practice" of the invention. The conception of the invention has been described as the formation in the mind of the inventor of a definite and permanent idea or concept of invention as it is to be applied in practice. The reduction to practice of the invention can consist of either actual reduction to practice of the invention, which involves building, performing or testing the invention and checking that it works for its intended use, or constructive reduction to practice, which is the filing of a patent application.

In the US, the question of who is the first to invent can arise during interference proceedings at the US Patent and Trademarks Office (USPTO). During interference proceedings a person can defeat another person's claim to an invention by establishing, through evidence, an earlier date of conception together with diligence in reducing the invention to practice. Laboratory notebooks usually form part of the evidence, which can help establish the date of conception and diligence.

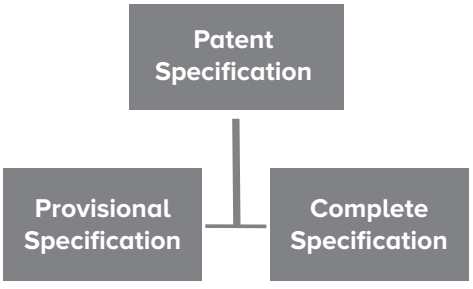
The lab notebook usually includes:



METHODS OF INVENTION DISCLOSURE

As already discussed, an invention is patentable if it meets three pre-requisites of patentability, namely novelty, inventive step, and capable of industrial applicability. While filing the application for a patent for any invention, inventors/applicants need to disclose the technical information pertinent to these three pre- requisites in a patent specification. The disclosure must be sufficient to enable an average skilled person to perform the invention.

There are two types of patent documents usually known as patent specification, namely -



Provisional and Complete Specifications and Contents

Section 9 and 10 of the Act of 1970, provides for Provisional and complete specifications and Contents of specifications. It states that-

1) Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) is accompanied by a provisional specification, a complete specification shall be filed within twelve months from the date of filing of the application, and if the complete specification is not so filed, the application shall be deemed to be abandoned.

2) Where two or more applications in the name of the same applicant are accompanied by provisional specifications in respect of inventions which are cognate or of which one is a modification of another and the Controller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may allow one complete specification to be filed in respect of all such provisional specifications:

   Provided that the period of time specified under sub-section (1) shall be reckoned from the date of filing of the earliest provisional specification.

3) Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) is accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant so requests at any time within twelve months from the date of filing of the application, direct that such specification shall be treated, for the purposes of this Act, as a provisional specification and proceed with the application accordingly.

4) Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under sub-section (3) as a provisional specification, the Controller may, if the applicant so requests at any time before grant of patent, cancel the provisional specification and post-date the application to the date of filing of the complete specification.

Content of Specification

Section 10 states that every specification, whether provisional or complete, shall describe the invention and shall begin with a title sufficiently indicating the subject-matter to which the invention relates.

Subject to any rules that may be made in this behalf under this Act, drawings may, and shall, if the Controller so requires, be supplied for the purposes of any specification, whether complete or provisional; and any drawings so supplied shall, unless the Controller otherwise directs, be deemed to form part of the specification, and references in this Act to a specification shall be construed accordingly.

If, in any particular case, the Controller considers that an application should be further supplemented by a model or sample of anything illustrating the invention or alleged to constitute an invention, such model or

sample as he may require shall be furnished before the application is found in order for grant of a patent, but such model or sample shall not be deemed to form part of the specification.

A declaration as to the inventorship of the invention shall, in such cases as may be prescribed, be furnished in the prescribed form with the complete specification or within such period as may be prescribed after the filing of that specification.

Subject to the foregoing provisions of this section, a complete specification filed after a provisional specification may include claims in respect of developments of, or additions to, the invention which was described in the provisional specification, being developments or additions in respect of which the applicant would be entitled under the provisions of section 6 to make a separate application for a patent.

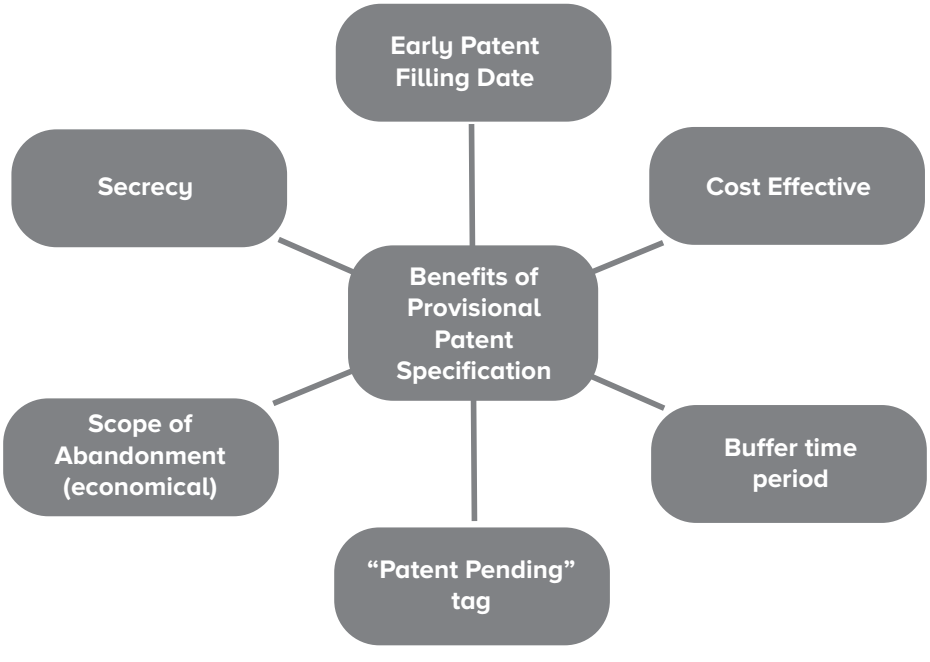
PROVISIONAL SPECIFICATION

A provisional specification is usually filed to establish priority of the invention in case the disclosed invention is only at a conceptual stage and a delay is expected in submitting full and specific description of the invention. Although, a patent application accompanied with provisional specification does not confer any legal patent rights to the applicants, it is, however, a very important document to establish the earliest ownership of an invention. The provisional specification is a permanent and independent scientific cum legal document and no amendment is allowed in this. No patent is granted on the basis of a provisional specification. It has to be followed by a complete specification for obtaining a patent for the said invention. Complete specification must be submitted within 12 months of filing the provisional specification. This period can be extended by 3 months. It is not necessary to file an application with provisional specification before the complete specification. An application with complete specification can be filed right at the first instance.

A provisional patent specification is a preliminary application before filing a usual patent. It explains the invention in a broad manner but not completely. It is the document which may be filed before a Complete Specification in the Office of the Controller of Patents pertaining to a prospective patent.

It gets the word “provisional” in its name from being incomplete and a predecessor of a complete specification which comes later. Also, although it is not mandatory, it is highly recommended as it has a lot of benefits for the inventor.

Why Should an Inventor File a Provisional Patent Specification?



1. **Early Patent Filing Date**

   On filing of the Provisional Patent Specification the inventor is entitled to an earlier filing date. This is key as it secures the priority date for the applicant. The benefits of this are numerous-

   - The fact that similar inventions which are filed after the filing date of the provisional cannot become prior art for the applicants invention.
   - If any dispute regarding the ownership of the invention arises, the Patent Office will accept the provisional patent's earlier filing date as the date of filing.

2. **Cost Effective**

   The upfront cost of a Provisional Patent Specification is much lower than that of a complete patent application which saves thousands of rupees for the inventor in terms of professional fees.

   Also, as it is technically more lucid (does not contain claims, prior art search and exhaustive and detailed drawings) as compared to the Complete Specification it costs less money and resources to prepare. Provisional Patent Specification can also be prepared by the in inventor himself.

3. **Buffer time period**

   When an invention is new, you will not know what to claim protection for. There is a pendency period of twelve months between the provisional patent specification and complete patent specification. This may be used for-

   - Researching on the invention regarding its value in the market and commercial viability.
   - Improving its features and making it technically more sophisticated.
   - further development of claims based on industry research.

4. **"Patent Pending" tag**

   Once the Provisional Patent Specification has been filed the inventor can legally use the tag "Patent Pending" or "Patent Applied" for his or her invention. This tag aids in obtaining funds as the credibility of the invention increases while the business model is being set up in the background. It can be used as a selling proposition

5. **Scope of Abandonment (economical)**

   If the Applicant goes for a provisional specification and then realises that it is not commercially viable or chooses not to get a patent, he might abandon it. But if in the same scenario if he had gone for a complete specification he would have already spent a lot of money on it and the abandonment would have been expensive.

6. **Secrecy**

   As there no publication of the patent application, the priority date is reserved by maintaining the secrecy.

Essentials of Application under Provisional Patent Specification

An Applicant should remember the following things-

1. It is not a rough draft of the Complete Patent Specification. Whereas it defines the scope of the invention and it is the Provisional Patent Specification on which the following Complete Specification and finally the grant of Patent will be based upon.

   All the elements of the invention which are born during the 12 months between the Provisional Patent Specification and Complete Patent Specification filing will not get the earlier priority date. Any addition/ development to the invention after filing **provisional patent specification** which is outside the scope which is set by provisional application will not have the advantage of priority date of provisional application.

2. The inventor/applicant should keep in mind that this is not the 'final' or 'conclusive' step towards securing a patent. It is the initial step in the procedure towards patent registration.

3. It has to be kept in mind that if the time period of twelve months within which the applicant has to file Complete Patent Specification is not adhered to then the patent application will be deemed to be 'abandoned'.
4. Although the confidentiality is maintained after the Provisional Patent Application, complete and adequate disclosures should be made in the Provisional Patent Application as incomplete applications will be disadvantageous for the applicant in the future and his scope of securing a patent may considerably reduce.
5. A rough set of claims should be designed even though they need not be a part of the Provisional Patent Application. This should be done in order to conceptualize the invention and understand the implications of the invention completely.

COMPLETE SPECIFICATION

Section 10(4) states that every complete specification shall--

a) fully and particularly describe the invention and its operation or use and the method by which it is to be performed;

b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and

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

d) be accompanied by an abstract to provide technical information on the invention: Provided that--

(i) the Controller may amend the abstract for providing better information to third parties; and

(ii) 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), and if such material is not available to the public, the application shall be completed by depositing 3[the material to an international depository authority under the Budapest Treaty] and by fulfilling the following conditions, namely:--

A. 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;

B. 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;

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

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

Section 10(4A) provides that in case of an international application designating India, the title, description, drawings, abstract and claims filed with the application shall be taken as the complete specification for the purposes of this Act.

Section 10(5) the claim or claims of a complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification.

Priority Dates of Claims of a Complete Specification

There shall be a priority date for each claim of a complete specification. Where a complete specification is filed in pursuance of a single application accompanied by--

a) a provisional specification; or

b) a specification which is treated by virtue of a direction under sub-section (3) of section 9 as a provisional specification, and the claim is fairly based on the matter disclosed in the specification referred to in

clause (a) or clause (b), the priority date of that claim shall be the date of the filing of the relevant specification.

and the claim is fairly based on the matter disclosed in the specification referred to in clause (a) or clause (b), the priority date of that claim shall be the date of the filing of the relevant specification.

Where the complete specification is filed or proceeded with in pursuance of two or more applications accompanied by such specifications as are mentioned in sub-section (2) and the claim is fairly based on the matter disclosed—

a) in one of those specifications, the priority date of that claim shall be the date of the filing of the application accompanied by that specification;

b) partly in one and partly in another, the priority date of that claim shall be the date of the filing of the application accompanied by the specification of the later date.

Where a complete specification based on a previously filed application in India has been filed within twelve months from the date of that application and the claim is fairly based on the matter disclosed in the previously filed application, the priority date of that claim shall be the date of the previously filed application in which the matter was first disclosed.

Where the complete specification has been filed in pursuance of a further application made by virtue of sub-section (1) of section 16 and the claim is fairly based on the matter disclosed in any of the earlier specifications, provisional or complete, as the case may be, the priority date of that claim shall be the date of the filing of that specification in which the matter was first disclosed.

Where, under the foregoing provisions of this section, any claim of a complete specification would, but for the provisions of this sub-section, have two or more priority dates, the priority date of that claim shall be the earlier or earliest of those dates.

In any case to which sub-sections (2), (3), (3A), (4) and (5) do not apply, the priority date of a claim shall, subject to the provisions of section 137, be the date of filing of the complete specification.

The reference to the date of the filing of the application or of the complete specification in this section shall, in cases where there has been a post-dating under section 9 or section 17 or, as the case may be, ante-dating under section 16, be a reference to the date as so post-dated or ante-dated.

A claim in a complete specification of a patent shall not be invalid by reason only of--

a) the publication or use of the invention so far as claimed in that claim on or after the priority date of such claim; or

b) the grant of another patent which claims the invention, so far as claimed in the first mentioned claim, in a claim of the same or a later priority date.

Submission of complete specification is necessary to obtain a patent. The contents of a complete specification would include the following:

(1) Title of the invention.

(2) Field to which the invention belongs.

(3) Background of the invention including prior art giving drawbacks of the known inventions & practices.

(4) Complete description of the invention along with experimental results.

(5) Drawings etc. essential for understanding the invention.

(6) Claims, which are statements, related to the invention on which legal proprietorship is being sought. Therefore the claims have to be drafted very carefully.

In order to obtain a patent, an applicant must fully and particularly describe the invention therein claimed in a complete specification. The disclosure of the invention in a complete specification must be such that a person

skilled in the art may be able to perform the invention. This is possible only when an applicant discloses the invention fully and particularly including the best method of performing the invention. The Specification is a techno-legal document containing full scientific details of the invention and claims to the patent rights. The Specification, thus, forms a crucial part of the Patent Application. It is mandatory on the part of an applicant to disclose fully and particularly various features constituting the invention.

A patent applicant may, if he so desires, file one or more further applications under section 16, including in respect of an invention disclosed in the provisional or complete specification or a further application filed under section 16.

The relevance or say importance of the specification can be seen in the landmark judgement of the Supreme Court in the case of *Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries*, From the below discussed case, we'll understand that how important is the specification in terms of an invention. When the meaning of a term in a claim is not clear, the description will be relied upon to understand the term in context of what is described in the specification. A complete specification in whole is important for an invention. Essential components of a complete specification are description, claims, drawings, abstract and sequence listings, if any. All these essentials combine to form a complete specification. The goal behind the full disclosure of the invention in the specification part is that a person skilled in the art may be able to perform the invention or more preferably an ordinary person can able to understand the invention upto maximum extent.

CASE STUDY

Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries, AIR 1982 SC1444

Facts:

M/s. Hindustan Metal Industries, respondent herein, (hereinafter called the Plaintiff) is a registered partnership firm carrying on the business of manufacturing brass and German silver utensils at Mirzapur. M/s. Biswanath Prasad Radhey Shyam, appellant herein, (hereinafter called the defendant) is a concern carrying on the business of manufacturing dishes and utensils in Mirzapur. The plaintiff instituted a suit for injunction and damages.

The old method of manufacturing utensils, particularly shallow dishes, was to turn scrap and polish them on some sort of headstock without a tailstock, the utensils either being fixed to the headstock by thermoplastic cement or held in the jaws of a chuck fixed to the head-stock. This system was, however, fraught with risk to the workers inasmuch as the utensils used to fly off from the headstock. Consequently with a view to introduce improvement, convenience speed, safety and better finish, Purshottam Dass, one of the partners of the Plaintiff-firm, invented a device and method for the manufacture of utensils, in 1951. The plaintiff after filing the necessary specifications and claims in the Patent Office, got the alleged invention patented under the Indian Patent and Designs Act, 1911 (hereinafter called the Act), at No. 46368-51 on May 6, 1953 with effect from December 13, 1951 as assignee of the said patent. By virtue of this patent, the plaintiff acquired the sole and exclusive right of using this method and means for the manufacture of utensils. In September 1952, the plaintiff learnt that the defendant was using and employing the device and method of manufacturing of dishes under the former's patent. The plaintiff served a notice upon the defendant asking him to desist from infringing the plaintiff's patent, but the defendant continued to infringe the patent.

Issue:

On the preceding facts, the plaintiff prayed for a permanent injunction restraining the defendant from adopting, imitating, employing or in any manner infringing the device of the plaintiff's patent. The plaintiff further prayed for a mandatory injunction requiring the defendant to destroy the articles used for the infringement of his patent. The plaintiff further claimed a decree for Rs. 3,000/- as damages.

Contentions:

The defendant resisted the suit on various grounds, out of those which are material for the decision of these appeals are: that the defendant's firm is an old concern carrying on the manufacture of metal wares since long; that the method covered by the plaintiff's patent, namely, that of a lathe (headstock, adapter and tailstock) has been known and openly and commonly in use in the commercial world all over the country for several decades before the plaintiff's patent; that the alleged invention of the plaintiff was not on the date of the patent, a manner of new

manufacture or improvement, nor did it involve any inventive step or ingenuity having regard to what was known or used prior to the date of the patent; and that the patent has no utility and therefore it was liable to be revoked.

Court's Findings:

As pointed out in *Arnold vs. Bradbury (1871) 6 Ch. A. 706* the proper way to construe a specification is not to read the claims first and then see what the full description of the invention is, but first to read the description of the invention, in order that the mind may be prepared for what it is, that the invention is to be claimed, for the patentee cannot claim more than he desires to patent. In *Parkinson v. Simon (1894) 11 R.P.C. 483* Lord Esher M.R. enunciated that as far as possible the claims must be so construed as to give an effective meaning to each of them, but the specification and the claims must be looked at and construed together.

The findings of the learned trial Judge to the effect that the patent is not a manner of new manufacture or improvement, nor does it involve any inventive step having regard to what was known or used prior to the date of patent, should not have been lightly disturbed by the Appellate Bench. Moreover, the approach adopted by the trial Court was quite in conformity with the basic principles on the subject, noticed in an earlier part of this judgment. The patented machine is merely an application of an old invention, known for decades before 1951, for the traditional purpose of scraping and turning utensils, with a slight change in the mode of application, which is no more than a 'Workshop improvement', a normal development of an existing manner of manufacture not involving something novel which would be outside the probable capacity of a craftsman. The alleged discovery does not lie outside the Track of what was known before. It would have been obvious to any skilled worker in the field, in the state of knowledge existing at the date of patent, of what was publicly known or practised before about this process, that the claim in question viz., mere addition of a lever and bracket did not make the invention the subject of the claim concerned. There has been no substantial exercise of the inventive power or innovative faculty. Thus judged objectively, by the tests suggested by authorities, the patent in question lacked novelty and invention.

Held:

Court started that-

"For all the reasons aforesaid, we have no hesitation in holding that the learned Judges of the Appellate Bench were in error in reversing the findings of the trial Court on Issues 1 and 1-A. The learned trial Judge was right in holding that the patented machine was neither a manner of new manufacture or novel improvement, nor did it involve any inventive step, having regard to what was publicly known or used at the date of the patent. The grant of the patent in question was therefore, invalid and was liable to be revoked on the grounds mentioned in Clauses (d) and (e) of Section 26(1) of the Act."

Patent Abstract

According to Section 10(4) (d) of The Indian Patent Act, every complete specification shall include an abstract to provide technical information on the invention. It shall be indicative of technical field, technical problem resolved, chemical formulae, and designs if any.

Rule 13(7) of Patent Rules 2003 provides for specification and contents of the abstract. They are as under-

a) Every complete specification shall be accompanied by an abstract to provide technical information on the invention. The abstract shall commence with the title of the invention.

b) The abstract shall be so drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical field, in particular by making it possible to assess whether there is a need to consult the specification itself.

c) The abstract shall contain a concise summary of the matter contained in the specification. The summary shall indicate clearly the technical field to which the invention belongs, technical problem to which the invention relates and the solution to the problem through the invention and principal use or uses of the invention. Where necessary, the abstract shall contain the chemical formula, which characterizes the invention.

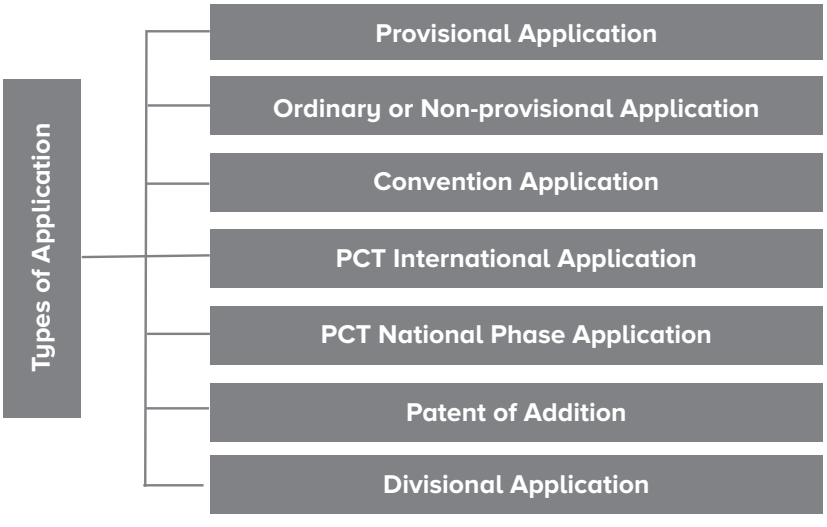
d) The abstract may not contain more than one hundred and fifty words.

e) If the specification contains any drawing, the applicant shall indicate on the abstract the figure, or exceptionally, the figures of the drawings which may accompany the abstract when published. Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by the reference sign used in that drawing.

f) The Controller may amend the abstract for providing better information to third parties.

TYPES OF PATENT APPLICATION

A patent application is a request for the issuance of a patent for the innovation that the applicant has claimed and detailed. An application for this purpose typically consists of a description of the invention, as well as any pertinent official documents and correspondence. There are various types of patent applications, and each one serves a certain function. They are-



1. **Provisional Application -** When an invention is still being tested and isn't finalised, a provisional application, often referred to as a temporary application, is submitted. Additionally, as the Indian Patent Office adheres to the "First to File" approach, a preliminary application is sent to the patent office in order to claim priority (known popularly as the First-Come-First-Served-Basis). Technically speaking, the earlier an invention is filed, the less chance there is of any related inventions being considered prior art by the inventor's application. To ensure that the innovation's priority rights are protected, an application for this reason must be meticulously written and include a concise description of the invention.
2. **Ordinary or Non-Provisional Application -** This kind of application is submitted when neither the applicant nor the application is being filed in accordance with any earlier convention application. It must be backed up with a thorough complete specification that accurately describes the innovation. It can be done via-
   i) *Direct Filing* - In which the Indian Patent Office receives the complete specification without a corresponding provisional specification.
   ii) *Subsequent Filing* - This method claims priority from the submitted provisional specification and involves filing a complete specification after the relevant provisional specification.
3. **Convention Application -** When claiming a priority date based on an application that was filed in any of the convention nations that is identical to or substantially similar to it, a convention application is filed. An applicant must submit an application to the Indian Patent Office within a year of the date on which a comparable application was first submitted in the convention country in order to qualify for a status of convention. Simply put, a convention application gives the applicant the right to assert priority in all convention countries.

4. **PCT International Application -** A PCT application is an international application. The application opens the door for a streamlined patent application process in numerous nations at once, even though it does not permit for the grant of an international patent. It is subject to the Patent Corporation Treaty and may be recognised in as many as 142 nations. By submitting this application, you can prevent copies of your innovation from being made in the specified nations. This application can be submitted at the following locations in India:
   - The Indian Patent Office (IPO), which serves as the receiving office.
   - The International Bureau of WIPO, either upon the receipt of a foreign filing permit from IPO or six and twelve months following the submission of an application in India.

   In contrast to other applications, it grants the application a 30-31-month window from the international filing date or the priority date to entry into other nations, giving the applicant more time to assess the viability of the invention.
5. **PCT National Phase Application -** An applicant must submit a national phase application in each country where protection is desired, according to accepted practise. Within 31 months of the priority date or the international filing date, whichever is earlier, the same must be filed. Each member country has the option of extending the time restriction through national laws. The title, description, abstract, and claims as submitted in the international application under PCT shall be regarded as the Full Specification with regard to the National Phase Application. In addition, the rules for submitting and processing a regular patent application are also used here.
6. **Patent of Addition -** If the applicant finds an innovation that is merely a modest modification of the invention for which the applicant has already applied for or been granted a patent, the applicant must file this application. A separate renewal fee shouldn't be paid during the primary patent's term because a patent of addition is only granted after the parent patent has been granted. Also, it must be granted for a period of time equal to the duration of the patent for the primary invention; as a result, it expires with the first patent. The application for a patent of addition was filed on the date of this document's filing. Only if the innovation doesn't require a significant creative step may it be filed.
7. **Divisional Application -** If a particular application makes claims for more than one invention, the applicant may decide to partition the application and submit two or more applications. These applications' priority dates are the same as those of the parent application.

Is it mandatory to obtain prior permission from the Patent Office to file application for patent outside India or abroad? Also, under what circumstances, it is necessary to obtain a prior permission from the Patent Office?

Ordinarily, under the following circumstances, it is not necessary to obtain prior permission from the Patent Office to file patent application abroad:

- ***Applicant is not Indian resident and invention is originated abroad about.***
- ***If the applicant is Indian resident and filed patent application has been in India before filing the application outside India and six weeks period is over from that date.***
- ***The invention does not belong to Atomic Energy or defence purpose.***

Residents of India require prior permission to apply for patents outside India under section 39 of the Patents Act, 1970 under following circumstances:

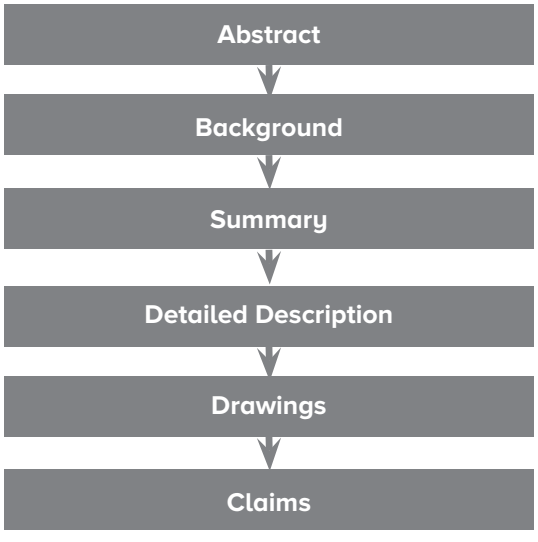
- ***The applicant or inventor is Indian resident,***
- ***Applicant does not wish to file patent application in India prior to filing outside India,***
- ***If the applicant is Indian resident, a patent application has been filed in India and six weeks period is not yet over from that date,***
- ***The invention relates to atomic energy or defence purpose.***

However if the invention is relevant for Defence or Atomic Energy purpose, no permission shall be granted without the consent of Central Government.

Patent Application and its Contents

A patent application memorializes the agreement between the inventor and the government office that results in the issuance of a patent. Accordingly, a patent application is in many ways like a contract. Writing a high-quality patent application is important because it sets out in a clear fashion the terms by which the patent owner and others will be bound. In this sense, drafting a patent application is different from writing a scientific paper. As the patent document contains technical subject matter, it will also bear some similarities to a scientific or technical paper, although it does not usually need to rise to the level of a blueprint for making invention protected by the patent. The issued patent will be reviewed over the years by public officials such as patent examiners and judges and business partners. Thus, the patent application should be drafted with these important audiences in mind.

The parts of the patent application typically include the Background, Summary, Detailed Description and Drawings, Claims and Abstract. In reading a patent application:



How can one register for online filing of patent application?

To register for filing of patent application, the user is required to obtain the Class II/III digital signature. After obtaining the digital signature, the user can register himself on the CGPDTM website by creating his user ID and password.

One can file patent applications through comprehensive online filing system at https://ipindiaonline.gov.in/epatentfiling/goForLogin/doLogin. More information for filing online application is available on the website of Patent Office i.e. www.ipindia.gov.in.

Contents of Patent Application

A patent application should contain:

1. Application for grant of patent in Form-1.
2. Applicant has to obtain a proof of right to file the application from the inventor. The Proof of Right is either an endorsement at the end of the Application Form-1 or a separate assignment.
3. Provisional / complete specification in Form-2.
4. Statement and undertaking under Section 8 in Form- 3, if applicable. An applicant must file Form 3 either along with the application or within three months from the date of issuance of first statement of objections under sub-rule (3) of rule 24B or sub-rule (8) of rule 24C

5. Declaration as to inventorship shall be filed in Form for Applications accompanying a Complete Specification or a Convention Application or a PCT Application designating India. However, the Controller may allow Form-5 to be filed within one month from the date of filing of application, if a request is made to the Controller in Form-4.
6. Power of authority in Form-26, if filed through a Patent Agent. In case a general power of authority has already been filed in another application, a self-attested copy of the same may be filed by the Agent. In case the original general power of authority has been filed in another jurisdiction, that fact may also be mentioned in the self-attested copy
7. Priority document is required in the following cases:

   (a) Convention Application (under Paris Convention).

   (b) PCT National Phase Application wherein requirements of Rule 17.1 (a or b) of regulations made under the PCT have not been fulfilled.

   The priority document may be filed along with the application or before the expiry of eighteen months from the date of priority, so as to enable publication of the application. In case of a request for early publication, the priority document shall be filed before/along with such request.
8. Every application shall bear the Signature of the applicant or authorized person / Patent Agent along with name and date in the appropriate space provided in the forms.
9. The Specification shall be signed by the agent/applicant with date on the last page of the Specification. The drawing sheets should bear the signature of an applicant or his agent in the right hand bottom corner.
10. If the Application pertains to a biological material obtained from India, the applicant is required to submit the permission from the National Biodiversity Authority any time before the grant of the patent. However, it would be sufficient if the permission from the National Biodiversity Authority is submitted before the grant of the patent.

    The Application form shall also indicate clearly the source of geographical origin of any biological material used in the Specification, wherever applicable. [Section 7. Rule 8, 12, 13, 135. Also Section 6 of the Biological Diversity Act, 2002 & Rule 17.1 of Regulations made under the PCT]

Writing of Patent Document

There is no specific format as to how to prepare a patent document. It is worth having the application professionally prepared. The patent professional assists the applicant by drafting the disclosure and claims, and preparing any necessary forms etc.

It is pertinent to mention that World Intellectual Property Organization (WIPO) has published a document titled WIPO Patent Drafting Manual. Under Part III of the said Manual, patent application preparation and filing has been discussed in detail. The same is briefly reproduced herein below for the information of the students.

After filing the application, you create a file for the provisional patent application, containing a copy of everything you sent to the patent office including all the forms and copies of any checks for fee payment. The file also includes the original mail deposit receipt from the post office that has the date of deposit. Thus, if the patent office does not provide your patent application with the proper date of receipt, you have everything you will need to provide the proper filing date to the patent office – a date that is absolutely crucial in preserving your client's rights to obtain patent protection. It is essential to note that one day late is too late.

Patent agents must strive to protect their client's patent rights and sometimes protecting the applicant's rights involves simply making sure that critical dates are observed. If the patent agent above had forgotten to ask about possible bar dates or had not pressed the engineer for precise information, the patent agent might have returned to his office and spent the next two weeks drafting a beautiful legal document for an invention that could no longer be patented.

Finally, the patent agent must try to understand early if the applicant wants to file in foreign countries. In countries that are Member States of the Paris Convention, applicants have one year to file their patent application abroad after the national filing date (or priority date). The filing of a PCT application also operates within the one-year time frame of the Paris Convention. The patent agent should docket the priority application's filing date, and check with the applicant well ahead of the anniversary date. Even when the applicant has initially indicated no interest in foreign filing he may change his mind in a year. Also, remember that the patent agent does not need to wait a full year before filing. The patent agent should also determine if the applicant is interested in obtaining protection in a non-Paris Convention country before filing the priority application. If the applicant is interested in a non-Paris Convention country, the patent agent needs to understand that country's specific priority rules. Non-Paris Convention countries can have very unique rules for inbound foreign applications. In some cases, the patent agent may even need to co-file the application in the non-Paris Convention country and in the inventor's home country at the same time in order to ensure patentability.

A patent agent will likely not be allowed directly to represent his client before foreign patent offices. Foreign associate attorneys will represent the client abroad. There are several models for interacting with foreign associate attorneys. In the "hands off" model the foreign associate sends official correspondence and provides information on local rules but takes little substantive action in the case. The patent agent who filed the original priority application makes all the major decisions. In the "hands on" model the foreign associate drafts proposed responses to office actions and forwards them to the patent agent for approval. The patent agent may use different models for different foreign associate attorneys, e.g. "hands on" in some countries, and "hands off" in others.

Article 2.1 of the TRIPS Agreement requires its signatories who are not Paris Convention signatories to honor certain provisions of the Paris Convention such as the one-year period for claiming priority. As noted elsewhere, the patent agent needs to verify the actual practice and procedural requirements being followed in countries of interest to his client.

The true and first inventor(s), his assignee, or their legal representative – can apply for patent with a provisional or a complete specification either themselves or through an agent by duly submitting the application form – at the appropriate office. In India, there are 4 offices, namely Delhi, Mumbai, Chennai & Kolkata and depending on the address of the applicant where he resides, has his domicile, or has a place of business or the place from where invention actually originated, the appropriate office is applicable.

In case of foreign applicants, who don't have domicile, place of business in India, place of business or address for service in India of the patent agent appointed by them is the determining factor for appropriate office. Specific state wise details can be accessed here: *http://ipindia.nic.in/ipr/patent/patjurid.htm.*

The date of first filing of a patent application is called the priority date. In the patent system of first to file, this date becomes important and if there are two patents/ patent applications with same/substantially similar subject matter, the earlier priority date patent application/patent survives the other. If filing has to be done in other countries, the priority of the initially filed application (parent application) can be taken and filed in respective countries/regions. The subsequent applications shall have the same priority date as the parent application and are referred to as family members of the initial application and each other. The application process is generally similar but the format of application may differ from country to country and the applicant ordinarily cannot file without professional assistance of a patent agent or attorney in that country/region.

1. Obtaining Invention Disclosures from Inventors

A patent agent's clients will likely have different levels of sophistication with respect to their abilities to handle patent documents. Some clients may have fairly sophisticated administrative units that can provide completed invention disclosure packages to patent agents who then conduct a follow-up review as necessary. At the opposite extreme are clients who have no IP infrastructure and require considerable guidance and assistance from the patent agent.

The patent drafter will need to gather technical information and ideas about the invention from its inventors, as well as insight into business considerations that may come from other sources, such as the applicant's managers or marketing executives. The technical information will mainly be provided in writing – that is, as

invention disclosures, sketches, technical drawings, laboratory reports, manuscripts of (unpublished) papers, prototypes, etc.

The patent agent will learn over time which approach offers the best results for different types of clients. In any event, the patent agent should always attempt to have at least one meeting either in person or by telephone with the inventor. Similarly, it is unlikely that the inventor will understand the legal/background information being sought about his invention in the absence of a meeting with the patent agent.

In an ideal situation, the inventor will provide the patent agent with an Invention Disclosure Form and supporting documents well before the face-to-face meeting between them. The patent agent will review the disclosure materials and note any places where he has questions or where he believes additional disclosure would be helpful. During the meeting between the patent agent and the inventor, the patent agent verifies that he has a complete understanding of the invention, establishes that there is no additional disclosure information that he should also receive (or that he receives the additional disclosure material), determines the most commercially-significant aspects of the invention and confirms that there are either no pending bar dates or verifies the precise bar dates.

The patent agent should review the invention disclosure well prior to meeting with the inventor. This will ensure that the patent agent will have had sufficient time to identify all the parts of the invention disclosure that raise questions – both technical parts (e.g. “how does A function with B”?) and legal parts (e.g. “Who else could be an inventor?”).

2. Identifying Patentable Inventions

In reviewing an invention disclosure and/or in speaking with an inventor the patent agent must keep focused on any/all patentable inventions described. Much of the text in an invention disclosure and/or discussions during the meeting with the inventor will probably not be about a purely patentable novelty but will include other non- patentable technical details. The patent agent should not be surprised to discover that quite often inventors do not know what they have invented, at least in “patentability” terms, as they often think in other terms such as “discoveries.” Thus, the patent agent will often be the one who articulates what constitutes a patentable invention.

3. Understanding the Invention

The patent agent should never become the inventor but should strive to have the clearest grasp of the invention needed to obtain a patent with the broadest claims allowed by law. This means the patent agent must understand the invention well enough to draft claims describing the invention with the fewest possible limitations. In other words, the patent agent must understand the invention well enough to know what elements do not need to be recited in the broadest possible claim for the invention.

Understanding the invention also means that the patent agent understands it well enough to prepare a specification for a patent application that discloses all possibly patentable aspects of the invention and enough additional information so that a lay person skilled in the pertinent technical field can understand and make the object invented. Understanding the invention also means that the patent agent can receive a prior art description such as one used as the basis for a claim rejection by a patent office and be able to explain the differences between the invention and the prior art and/or amend the pending claims to highlight these differences in a manner that minimizes the reduction in the scope of claim coverage.

The patent agent may discover that the inventor does not know the answer to all his questions. The inventor may be able to speculate about alternatives and in some instances may even have the time to conduct some additional research. The patent agent must make sure, however, that the specification discloses a working embodiment of the invention. Thus, if the inventor is uncertain about the answer to any of the patent agent’s questions, the patent agent must use his best professional judgment as to how to deal with the uncertainty.

There may be gaps in the technical disclosure that the patent agent can fill but he should always confirm with the inventor that the substitute for any missing material is correct and within the spirit of the invention. The patent agent may assist the inventor in considering possible alternative embodiments for the invention. Often inventors create their inventions for a very specific purpose and have not really considered whether they could be applied to other areas.

Illustration

The patent agent understands that the invention involves pipes A, B and C. The inventor disclosed that the common edge formed by the combination of pipes A and B was burned before pipe C was attached. The patent drafter may want to ask the inventor whether the surface could be prepared in any way other than burning. If so, then the invention may be broader than only burning the surface material. The patent drafter may, for example, want to ask whether the surfaces can be burned before attaching pipe A to pipe B or whether they must be combined first.

4. Inventorship

A patent application as filed is required to include the name(s) of the inventor(s). Before filing the patent application, the patent agent should ask their client who is/are the inventor(s) and then confirm whether the inventor(s) indicated by the client qualify for inventorship or not. The patent agent should keep in mind that the would-be inventor(s) indicated by the client may not always be entitled as true inventor(s).

Does meaning of inventorship remain same throughout different jurisdiction?

Although the definition of inventorship differs across jurisdictions, the general test is that person's creativity should have led in some way to the features of the claimed invention that distinguish it from the prior art.

For example, in the United States, a person who contributed to the conception of the invention is entitled to be an inventor, while someone else who merely acted under the direction of that person is not. Similarly, in Japan, only a person who has substantially engaged in the creative process of the claimed invention is entitled to be an inventor.

Whereas, a supervisor who simply manages inventors, a person who simply follows instructions from a researcher to collect data or conduct experiments, or a person who merely provided funds and facilities to the inventor may not be so entitled.

Certificate of inventorship

The Controller may issue a certificate of inventorship to an inventor in respect of a patent in force, on a request made by the inventor in Form-8A along with fee specified in the First Schedule. The Controller may issue a duplicate certificate of inventorship to an inventor in respect of a patent in force on a request made by the inventor in Form-8A along with the fee specified in the First Schedule and such request shall contain a statement setting out the circumstances in which the original certificate of inventorship was lost, destroyed, damaged or cannot be produced.

TYPICAL PARTS OF THE PATENT APPLICATION

Once a patent agent understands the invention he can begin preparing the patent application. The parts of the application are generally:

- claims
- detailed description (or specification)
- drawings
- background
- abstract
- summary.

A patent agent will want to consider the patent application's title fairly early. This title should broadly describe the invention. However, titles are not generally examined. Occasionally a patent examiner will decide that a title

is not descriptive of the invention. It is best to avoid being overly narrow in the invention's title, although the title should sufficiently indicate the subject matter of the invention.

A patent application as filed should also include the names of the inventors. The inventors should be named after the title, e.g. on the cover page. The patent application itself should also include all priority information, such as the identification of related applications. In the US, for example, priority information should be provided as the first sentence in the application. The patent agent may have other forms to complete that also provide the inventor's name and priority information but there is more certainty when this information is also included as part of the application itself.

Always remember who the audience will be for the patent application. The key audiences include judges and patent examiners. Of course, the patent agent's client and the inventor are also audiences; the patent agent must make sure the inventor understands his own patent application. Other potential audiences include competitors, infringers and investors. Many investors will often scrutinize a technology company's patent portfolio carefully before making an investment.

1. Claims

The claims define the scope of exclusive patent protection in terms of the technical features of the invention. The claims are the legally operative part of a patent application and whether or not an invention meets the patentability requirements is determined on the basis of the claims. Claims must be clear and concise, as well as fully supported by the description.

The majority of patent agents prepare several draft patent claims as their first step in writing a patent application. The claims are the legally-operative part of a patent application; everything revolves around the claims. If the claims are prepared before drafting the specification the patent agent will know which terms need to be described in the specification.

One of the first things to do is to prepare the claims for the invention. In fact, the patent agent may even want to sketch out the claims in the disclosure meeting with the inventor. This will often provide confirmation to the patent agent that he has understood the invention. The patent agent may wish to use some sort of "picture claim" in the initial meeting with the inventor since inventors are often unfamiliar with patent claim language. For this reason, the patent agent should avoid using highly abstract language to describe the invention in the disclosure meeting with the inventor.

Due to the critical importance of claims, the patent agent should carefully revisit them after drafting the specification. This is because after writing the specification, the patent agent will likely come to an even better understanding of the invention. For example, he will now be in a better position to spot extraneous limitations in the claims that could prevent obtaining the broadest possible claim coverage. Similarly, after preparing the specification the patent agent may now see that the claims do not describe the invention as accurately as they could.

Once the claims are completed the patent agent needs to check the drawings and specification to verify that the claim terms have been appropriately described and disclosed.

A patent claim is indisputably the most important part of a patent specification. It defines the boundary of the patent. To break it down, a patent claim defines exactly what is claimed by the invention and therefore what is sought to be protected. It clearly lays down what the patent does and does not cover. Simply put, the extent of protection conferred by a patent is defined by the patent claims. A claim is usually expressed as a statement of technical facts expressed in legal terms, defining the scope of the invention sought to be protected.

Why is a patent claim so important?

The preceding paragraph would have made the immense importance of a patent claim evident. A patent claim is that part of the specification, which after the patent is granted, tells third parties what they can and cannot do insofar as the invention is concerned. The exclusive right conferred by the grant of a patent is defined by a patent claim. Any mistake in drafting patent claims could result in an utterly useless patent. Only the patent claims define the scope of protection granted by a patent. The rest of the patent specification only helps explain the invention in detail. Claims define the contours of legal rights when the patent is granted. Section 10 (4) (c) of the Patents Act, 1970 states that every complete specification must end with a patent claim or patent claims that defines the scope of the invention for which protection is claimed.

How to draft a patent claim?

There is no straightjacket formula for drafting a patent claim. Drafting patent claims depends on each invention. It depends on what protection the Applicant seeks to claim on that invention. Depending on the protection sought by the applicant the claim may be constructed in a broad or narrow manner in reference to existing prior art. However, care must be taken to ensure that the patent claims are neither too broad (it cannot include what the applicant has not invented) nor too narrow (where the applicant may lose out on a necessary protection). Given the difficult nature of drafting patent claims, it is clear that drafting expertise is required to draft proper patent claims. It is always better to engage professional services to draft a patent specification.

What are the types of patent claims?

Essentially, claims are of two types: Independent claims and Dependent claims.

1. **Independent claims:**

   They are 'standalone' claims that do not bear reference to any other claim. It contains a preamble and all the elements necessary to define the invention. The first claim is usually an independent claim that sets the tone for the protection claimed by the invention. Independent claims are usually broader as compared to the dependent claims so as to prevent potential infringers from circumventing the independent claim in any which way.

   Independent Claims may be of three types:

   - A claim for a thing
   - A claim for a method of making a thing
   - A claim for a method of using a thing.

2. **Dependent Claims:**

   Dependent claims always bear reference to an earlier claim or independent claim and limit their scope. Dependent claims are therefore relatively narrow as they limit the scope of an earlier claim. Further, dependent claims refine the scope of protection sought for an invention. Additionally, it may contain additional non-essential features and even the minute aspects and optional features that are not described in the independent claim.

CASE LAWS

In ***Patent Application No. 7795/DELNP/2007, order dated May 9, 2019*** it was stated that reason for patent rejection was the lack of clarity and conciseness. It was decided that the claims were unclear since different meanings of the invention were provided in separate claims. Determining the invention's breadth was challenging due to the numerous distinct claims. Moreover, the preamble of the claims made no mention of the function or object of the claimed device. Several statements list various methods that are unclear in terms of their structural characteristics. Regarding the assertions, there was no support in the description. The claims were ambiguous because certain structural elements were missing.

Press Metal Corporation Limited V. Noshir Sorabji Pochkhanawalla (1982 PTC 259 (Bom)),

It was held that – "It is the duty of a patentee to state clearly and distinctly the nature and limits of what he claims. If the language used by the patentee is obscure and ambiguous, no patent can be granted, and it is immaterial whether the obscurity in the language is due to design or carelessness or want of skill. It is undoubtedly true that the language used in describing an invention would depend upon the class of person versed in the art and who intend to act upon the specifications. In the present case, the invention is described in an obscure and ambiguous language, and on this ground, the patent is liable to be refused".

2. Detailed Description or Specification

The detailed description section, sometimes known as the "preferred embodiment of invention" section or the "disclosed embodiment of the invention" section breathes life into the claims and provides a sufficient explanation of the invention for an ordinary person skilled in the art to make and understand the invention.

In some jurisdictions the term "specification" is also used to refer to the description in addition to the summary and background sections of the application; suffice to say that "detailed description" and "specification" are generally the same for purposes of patent drafting.

The detailed description section must be closely tied to the drawings. This section cannot be substantively amended once the application has been filed. Consequently, the patent agent must make sure that the detailed description section provides an appropriate degree of technical disclosure on the day that the application is filed as he won't have a second chance to alter this part of the application. The patent agent cannot amend his application to include new technical disclosure during prosecution.

Thus, a patent agent should take care that the patent application

(1) reflects the disclosure material provided by the inventors;

(2) provides sufficient information to enable an ordinary artisan to reproduce the invention; and

(3) provides sufficient depth so that the claims can be narrowed during patent prosecution to avoid close prior art.

The description discloses the invention sufficiently clearly and completely to the extent that a person skilled in the art will be able to carry out the claimed invention. To improve the readability of the description, it usually contains several sections. While the format of the description is not the same across jurisdictions, in general, the follow elements appear on the description.

1. The title of the invention, as appearing in the request, concisely identifies and broadly describes the invention for which patent protection is sought.
2. The technical field to which the invention relates may then be specified.
3. The background art in the field of the invention will be set out next, which can be useful for the understanding of the invention.
4. This is followed by a summary of the invention, which outlines its full scope and how it has solved the problem of the background art.
5. The description then briefly explains the drawings.
6. Finally, the description discloses greater detail of the claimed invention by way of examples (embodiments), making reference to the drawings. These examples often play an important role in meeting the support requirement and the enablement requirement

The patent agent must use his best judgment to balance his concerns about being under-inclusive in the specification section against including too much unclaimed subject matter in the application. In many patent systems, unclaimed subject matter in a patent application is considered to have been "dedicated to the public" by the inventor. Subject matter that is dedicated to the public is not patentable.

Similarly, if the patent application's disclosure includes an unclaimed invention, the patent agent may wish to prepare claims for this invention. If necessary, the patent agent can include the claims for any previously unclaimed invention in either a divisional or continuation application as appropriate. The patent agent will want to make sure that his client has approved the filing of any divisional or continuation applications. As a general rule, the patent agent should consult his client on every substantive matter pertaining to the client's pending patent application.

In drafting the detailed description section, the patent agent will generally want to err on the side of inclusion for the reasons described above. The patent agent will also want to consider the "best mode" requirement that arises in jurisdictions such as the US and India. The patent application must disclose the best mode of carrying out the invention known to the inventors.

In drafting the specification, the patent agent should avoid using phrases such as "the invention is..." The patent agent should instead use phrases like "in an embodiment of the invention." This will ensure that patent claims receive the

broadest interpretation possible. Without limiting words to the contrary, the detailed description section is generally presumed to disclose "an embodiment" of the invention rather than the invention itself. However, if the patent agent forecloses this broader reading, the scope of the claimed invention may be similarly narrowed.

Enablement Requirement

The "Enablement" requirement means that a patent application must teach ordinary persons skilled in the art how to make and use the invention. Enablement is usually viewed as of the filing date of the patent application. A patent application that is not enabled as of its filing date cannot become enabled by later technical innovations.

The patent agent must be very careful in his use of language in a patent application. The patent agent's language choices will be important not only during patent prosecution but especially if/when the patent is litigated. The patent agent should be particularly careful in his use of words containing absolutes of any sort. Thus, the patent agent will want to make sure that if a patent application uses words like "must" and "always," these words very precisely and accurately express the situation at hand.

The patent agent must always research and review the law and relevant rules pertaining to the country where he is seeking patent protection for his client. Many patent laws and rules are available online. For example, the WIPO website provides information about the Patent Cooperation Treaty and practical information relating to the filing of PCT applications; the EPO website provides information about filing and prosecuting applicants and the US Patent and Trademark Office website provides information about US patent laws and filing applications in the US.

EPO and USPTO enablement requirements-

According to Article 29(1) of the TRIPS agreement, the signatory nations of the agreement must include a requirement for patent applicants to provide disclosure so that an expert in the field can use the innovation. According to Article 29(1), nations may also decide to include a legal provision requiring the disclosure of the best mode.

For instance, just the enabling condition must be met according to the European Patent Convention (Article 83). The enablement condition as well as the best mode requirement must be satisfied before the patent is granted in both the United States of America (35 U.S.C. 112) and India [Section 10(4) of the Act].

3. Drawings

The drawings provide visual support in describing the invention and often facilitate better understanding of the claimed invention. They may include figures, tables, flow charts and diagrams. A representative drawing is usually positioned on the front page of a published patent document.

The patent agent must prepare good visual supporting materials that describe the invention. In fact, many patent agents would argue that the drawings are the most important part of the patent application after the claims. Some patent laws require that every claimed element be shown in a drawing. Where possible, the drawings should explain the invention in sufficient detail that reading the detailed description section merely confirms in words the information provided in the drawings. This will not be possible with all inventions. In preparing the drawings the patent agent should think of the story he wants to tell and how he wants to tell it. The patent agent should also think about the level of detail necessary to provide an enabling disclosure.

The elements shown in a patent's drawings are typically accompanied by a short description in words and a reference number such as "clock 102." The reader will expect to see "clock 102" in the accompanying text of the detailed description section. The patent agent should use a consistent numbering scheme for the reference numbers.

The patent laws require that a patent applicant to furnish at least one patent drawing (sometimes referred to as a patent illustration) of the invention whenever the invention is capable of illustration by way of a drawing. Said another way, whenever a drawing would assist in the understanding of an invention one need at least one patent drawing. The easiest best way to create a better, strong application is to include many patent drawings.

4. Background

The use of background sections varies among the world's patent regimes. In some patent systems the background section serves to disclose to the public the closest prior art applied against the patent application during examination.

This is the situation in most European systems. In some countries such as the US, the prior art submitted by the patent applicant, as well as the prior art found by the examiner, is printed on the cover of the patent itself.

The background section is typically considered prior art disclosed by the inventor. Consequently, if the applicant's own inventive disclosure ends up in the background section, the patent examiner may cite this section in the rejection of the applicant's claims. Some patent offices take a fairly hard line about inventive disclosures in background sections, which is one of the reasons why patent agents should draft them carefully.

A good background section should be fairly short and merely set the stage for the technical disclosure to be provided in the detailed description section. The background section could describe the prior art at a very high level. The background section may conclude with a short, crisp statement about the shortcomings of the prior art but this must be written in a manner that does not disclose the solution to be described later in the application.

5. Abstract

The abstract is a summary (a digest) of the invention limited to a certain number of words. It typically includes key features recited in the claims and is primarily an aid for those conducting patent searches and readers of patent documents, delivering an overview of the invention.

The patent abstract should describe the invention very clearly in the fewest possible words. The patent agent could use a version of the first paragraph of the summary of the invention section as the abstract.

6. Summary

As noted earlier, not all jurisdictions require a summary of the invention section. However, such sections are customarily prepared in many jurisdictions even when not strictly required by national law. The patent agent may find himself reviewing summary sections drafted by foreign patent agents working on his client's foreign counterpart patent applications. Consequently, the patent agent should understand the precise requirements and customary practice regarding a summary of the invention sections in the jurisdictions of interest to his clients.

Some patent agents prepare the summary of the invention section by taking each of the independent claims in the patent application and turning them into paragraphs. This approach also has an advantage that the precise words used in the claims will be guaranteed to be in the specification. Many patent agents simply draft the summary of the invention section in a manner that highlights the important aspects of the invention using words drawn from the application's claims.

The summary of the invention section should be one of the last parts of the patent application that the patent agent writes. In preparing the summary of the invention sections, avoid providing some sort of "big picture" summary that goes beyond the claims in any manner.

FILING OF PATENT DOCUMENTS

As per Rule 9 of the Patent Rules, 2003, all documents and copies of the documents, except affidavits and drawings, filed with patent office, shall –

- be typewritten or printed in Hindi or English (unless otherwise directed or allowed by the Controller) in large and legible characters not less than 0.28 centimetre high with deep indelible ink with lines widely spaced not less than one and half spaced only upon one side of the paper;
- be on such paper which is flexible, strong, white, smooth, non-shiny, and durable of size A4 of approximately 29.7 centimetre by 21 centimetre with a margin of at least 4 centimetre on the top and left hand part, and 3 centimetre on the bottom and right hand part thereof;
- be numbered in consecutive Arabic numerals in the centre of the bottom of the sheet; and

- contain the numbering to every fifth line of each page of the description and each page of the claims at right half of the left margin.

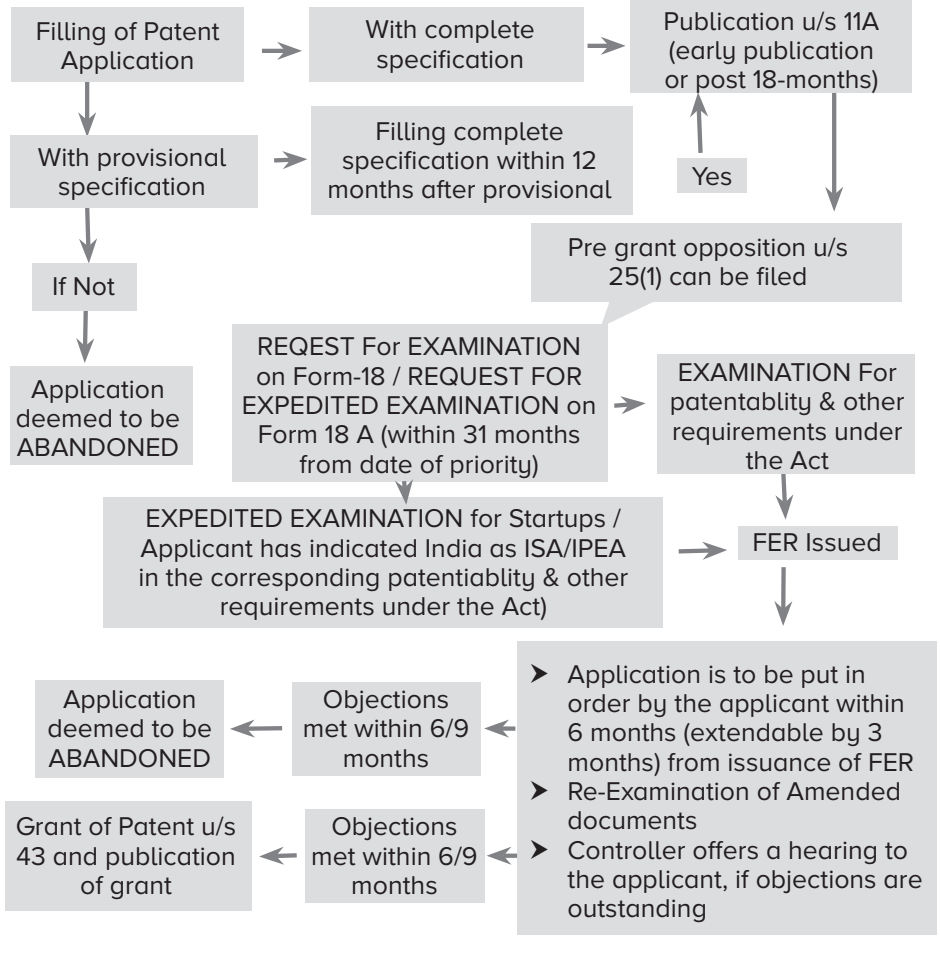
Any signature which is not legible or which is written in a script other than English or Hindi shall be accompanied by a transcription of the name either in Hindi or English in capital letters.

In case, the application for patent discloses sequence listing of nucleotides or amino acid sequences, the sequence listing of nucleotides or amino acid sequences shall be filed in computer readable text format along with the application, and no print form of the sequence listing of nucleotides or amino acid sequences is required to be given.

Additional copies of all documents shall be filed at the appropriate office as may be required by the Controller. Names and addresses of applicant and other persons shall be given in full together with their nationality and such other particulars, if any, as are necessary for their identification.

PATENT WORKFLOW

Patent Flow Chart



Source - https://ipindia.gov.in/writereaddata/Portal/News/237_1_Patent_FlowChart_09June2016.pdf

TIMELINE OF PATENT PROSECUTION

The submission of a patent application with the Indian Patent Office is the first step in every patent prosecution. After filing, the office checks the paperwork to ensure that all requirements have been met. In order to determine if the invention satisfies the three fundamental criteria for patentability—novelty, inventiveness, and industrial applicability—a technical analysis of the application is next conducted. The application is carefully examined during this examination stage by the examiner who is an expert in the relevant technical field. If the examiner has any concerns about the application's formal requirements or patentability, he or she will include those concerns in an examination report and send it to the applicants or their agents for a timely response.

Following are some of the important time lines during the prosecution of a patent application.

Filing of Complete Specofication following provisional specofication (Form 2)	Within 12 months of filing of provisional specification
Statement and undertaking regarding foreign applications (Form 3)	3 months from the date of issuance of first statement of objections under sub-rule (3) of rule 24B or sub rule (8) of rule 24C
Request for Examination (Form 18)	thirty-one months from the date of filing of filing or priority, whichever is earlier
Declaration of Inventorship (Form5)	With the complete specification or within one month from the date of filing of complete specification
Time for replying to the first examination report (FER)	6 months from the date of issuance of the FER, ectendable upto 3 months, total 9 months
Pre-grant Opposition (Form 7A)	after publication of the application and any time before the grant of patent
Post-grant Opposition (Form 7)	One year from the date of publication of grant of patent
Reference to deposit of biological material	Within 6 months from the date of filing of application
Furnishing information relating to woeking of patent (Form 27)	Working statement shall be furnished once in respect of every period of three financial year, starting from the financial year commencing immediately after the financial year in which the patent was granted, and shall be furnished within six months from the expiry of each such period. Provided that the Controller may condone the delay or extend the time in filing of such statement for a period up to three months upon a request made in Form 4.

Does the Patent Office keep information of the invention secret?

Yes. All the patent applications are kept secret upto 18 months from the date of filing or priority date whichever is earlier and thereafter they are published in the Official Journal of the Patent Office which is published every week and also available on the IPO website. After its publication, public can inspect the documents and also may take the photocopy thereof on payment of the fee as prescribed.

PUBLICATION AND EXAMINATION OF PATENT APPLICATION

Usually a patent application is published in the Official Patent Office Journal after the lapse of 18 months from the date of filing of the application or the priority claimed date, whichever is earlier. This publication includes

all pertinent details related to the application. It includes the title, abstract, application number and name and address of the applicant. After this publication a patent application becomes open for public scrutiny.

When is an application for patent published?

Every application for patent is published after expiry of 18 months from the date of its filing or priority date whichever is earlier. However, following applications are not published.

A. Application in which secrecy direction is imposed.

B. Application which has been abandoned u/s 9(1) and i.e when a provisional application has been filed and the complete application has not been filed with 12 months from the filing of the provisional application.

C. Application which has been withdrawn 3 months prior to 18 months.

According to Section 11A of Patents Act, 1970 no application for patent shall ordinarily be opened to the public for such period as may be prescribed.

The applicant may, in the prescribed manner, request the Controller to publish his application at any time before the expiry of the period prescribed under sub-section (1) and subject to the provisions of sub-section (3), the Controller shall publish such application as soon as possible.

Every application for a patent shall, on the expiry of the period specified under sub-section (1), be published, except in cases where the application—

(a) in which secrecy direction is imposed under section 35; or

(b) has been abandoned under sub-section (1) of section 9; or

(c) has been withdrawn three months prior to the period specified under sub-section (1).

In case a secrecy direction has been given in respect of an application under section 35, then, it shall be published after the expiry of the period prescribed under sub-section (1) or when the secrecy direction has ceased to operate, whichever is later.

The publication of every application under this section shall include the particulars of the date of application, number of application, name and address of the applicant identifying the application and an abstract.

Upon publication of an application for a patent under this section—

(a) the depository institution shall make the biological material mentioned in the specification available to the public;

(b) the patent office may, on payment of such fee as may be prescribed, make the specification and drawings, if any, of such application available to the public.

On and from the date of publication of the application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for the invention had been granted on the date of publication of the application:

Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been granted:

Provided further that the rights of a patentee in respect of applications made under sub-section (2) of section 5 before the 1st day of January, 2005 shall accrue from the date of grant of the patent:

Provided also that after a patent is granted in respect of applications made under sub-section (2) of section 5, the patent-holder shall only be entitled to receive reasonable royalty from such enterprises which have made significant investment and were producing and marketing the concerned product prior to the 1st day of January, 2005 and which continue to manufacture the product covered by the patent on the date of grant of the patent and no infringement proceedings shall be instituted against such enterprises.

Is there any provision in the Patents Act for early publication? Can any invention be patented after publication or display in the public exhibition?

Yes, the applicant can make a request for early publication in Form 9 along with the prescribed fee. After receiving such request the Patent Office publishes such application within a period of one. Generally, an invention which has been either published or publicly displayed cannot be patented as such publication or public display leads to lack of novelty. However, under certain circumstances, the Patents

Act provides a grace period of 12 months for filing of patent application from the date of its publication in a journal or its public display in an exhibition organised by the Government or disclosure before any learned society or published by applicant. The detailed conditions are provided under Chapter VI of the Act (Section 29-34).

WHO CAN FILE THE REQUEST FOR EXAMINATION IN INDIA AND HOW?

In India a request for patent examination (RFE) may be filed by:

the patent applicant of the patent application or

by any other interested person

Filling out Form 18 will initiate the request for examination. The interested party (third party) must provide the necessary proof of his involvement in the specific patent application.

Form-18 has to be filed, specifying the details of the patent applicant or other interested party, application number, title, date of filing and publication date together with the specified fees.

It is crucial to adhere to the patent office deadlines. Otherwise it is advisable to file the request for inspection, when filing patent application.

Before the expiration of the allotted 31 months, it is advisable to submit an express request for patent examination for any national phase application or PCT international application entering India.

REQUEST FOR EXAMINATION

Is patent application once filed examined automatically?

A patent application is not examined automatically after its filing. The examination is done only after receipt of the request of examination in Form 18 either from the applicant or from third party or Form 18A for expedited examination (under conditions as prescribed in the Rules).

Section 11B states that, no application for a patent shall be examined unless the applicant or any other interested person makes a request in the prescribed manner for such examination within the prescribed period.

In case of an application in respect of a claim for a patent filed under sub-section (2) of section 5 before the 1st day of January, 2005 a request for its examination shall be made in the prescribed manner and within the prescribed period by the applicant or any other interested person.

In case the applicant or any other interested person does not make a request for examination of the application for a patent within the period as specified under sub-section (1) or sub-section (3), the application shall be treated as withdrawn by the applicant:

Provided that—

(i) he applicant may, at any time after filing the application but before the grant of a patent, withdraw the application by making a request in the prescribed manner; and

(ii) in a case where secrecy direction has been issued under section 35, the request for examination may be made within the prescribed period from the date of revocation of the secrecy direction.

Expedited Examination

Rule 24C provides for Express or Expedited Examination. The Patents Act, 1970 provides for examination of patent application only on filing of request for examination by the applicant or any other interested person (section 11 B). This request can be filed on Form-18 with prescribed fee at any time within 31 months from the date of priority or from the date of filing of the application, whichever is earlier. The patent application is referred to the examiner strictly in order of the requests filed. The examiner to whom the application is referred for examination has to submit his report to the Controller ordinarily within a period of one month from such reference but not exceeding three months from such reference [Rule 24B (2)].

Who can file for Expedited Examination?

Below given can file for express or expedited examination-

(a) India has been indicated as the competent International Searching Authority or elected as an International Preliminary Examining Authority in the corresponding international application; or

(b) that the applicant is a startup; or

(c) that the applicant is a small entity; or

(d) that if the applicant is a natural person or in the case of joint applicants, all the applicants are natural persons, then the applicant or at least one of the applicants is a female; or

(e) that the applicant is a department of the Government; or

(f) that the applicant is an institution established by a Central, Provincial or State Act, which is owned or controlled by the Government; or

(g) that the applicant is a Government company as defined in clause (45) of section 2 of the Companies Act, 2013; or

(h) that the applicant is an institution wholly or substantially financed by the Government;

(i) that the application pertains to a sector which is notified by the Central Government on the basis of a request from the head of a department of the Central Government;

(j) that the applicant is eligible under an arrangement for processing a patent application pursuant to an agreement between Indian Patent Office and a foreign Patent Office.

Except where the application has already been published under sub-section (2) of section 11A or a request for publication under rule 24A has already been filed, a request for expedited examination shall be accompanied by a request for publication under rule 24A.

Where the request for expedited examination does not comply with the requirements of this rule, such a request shall be processed in accordance with the provisions contained in rule 24B, with an intimation to the applicant, and shall be deemed to have been filed on the date on which the request for expedited examination was filed.

The Controller shall refer the request for expedited examination along with the application and specification and other documents to the examiner, in respect of the applications where the request for expedited examination has been received, in the order of filing of such requests.

Provided that a request for expedited examination under this rule filed by a startup shall not be questioned merely on the ground that the startup ceased to be a startup after having filed an application for patent due to

the lapse of more than five years from the date of its incorporation or registration, or the turnover subsequently crossed the financial threshold limit, as defined.

The period within which the examiner shall make the report under sub-section (2) of section 12, shall ordinarily be one month but not exceeding two months from the date of reference of the application to him by the Controller.

The period within which the Controller shall dispose of the report of the examiner shall be one month from the date of receipt of such report by the Controller.

A first statement of objections along with any document, if required, shall be issued by the Controller to the applicant or his authorised agent within fifteen days from the date of disposal of the report of examiner by the Controller.

Reply to the first statement of objections and subsequent reply, if any, in respect of an application where the request for expedited examination was filed, shall be processed in the order in which such reply for such application is received.

The time for putting an application in order for grant under section 21 shall be six months from the date on which the first statement of objections is issued to the applicant.

The time for putting an application in order for grant under section 21, as prescribed in sub-rule (10) may be further extended for a period of three months on a request for extension made in Form 4 along with the prescribed fee, made to the Controller before the expiry of the period specified herein.

The Controller shall dispose of the application within a period of three months from the date of receipt of the last reply to the first statement of objections or within a period of three months from the last date to put the application in order for grant under section 21 of the Act, whichever is earlier: Provided that this time limit shall not be applicable in case of pre-grant opposition. Notwithstanding anything contained this rule, the Controller may limit the number of requests for expedited examination to be received during the year by way of a notice to be published in the official journal.

Did you know?

In 2019, the Indian Patent Office (IPO) and the Japan Patent Office (JPO) commenced a Bilateral Patent Prosecution Highway (PPH) pilot program. Patent Prosecution Highways (PPH) are designed to expedite the patent application process. This is accomplished by a system of information exchange across offices, or occasionally even nations. In the form of a bilateral agreement with the Japanese Patent Office, India has a PPH pilot programme (JPO). The three-year trial term for this pilot initiative started in November 2019.

This program is designed to prove to be advantageous to both applicants and patent offices. According to this, an applicant can speed up the prosecution process in a second patent office by using favourable examination results from one patent office. By allowing patent offices to effectively reuse or depend on the examination performed by other patent offices, patent applications can be processed more quickly. It shortens the prosecution process' workload and timetable. The patent office where protection is sought retains the authority to grant or deny a patent.

What is start up criteria? What are the benefits provided by the Government of India to Start-up applicants for filing patent applications?

Start-up means an entity, incorporated or registered in India under the Start-up India: Stand-Up India" initiative of the Government of India.

Government of India provides the following benefits to Start Ups in filing patent application in India under Scheme for Facilitating Start-ups Intellectual Property Protection (SIPP):

- ***An entity qualifying as a start-up under Stand-Up India initiative of the Government of India can avail the facility of expedited examination.***

- ***The Government reimburses the expenditure to the facilitator who assists the start-up for filing and prosecuting the patent application to the extent of Rs.10,000/- Office of CGPDTM, INDIA.***

IMPORTANT ASPECTS OF EXAMINATION

Few important aspects are to be kept in mind while requesting an examination. They are-

Understanding the invention

The Complete Specification describing the invention is a techno-legal document. It should fully and particularly describe the invention and the method by which it is to be performed i.e. the description of the method or the instructions for the working of the invention as contained in the complete specification are by themselves sufficient, full and particular to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention.

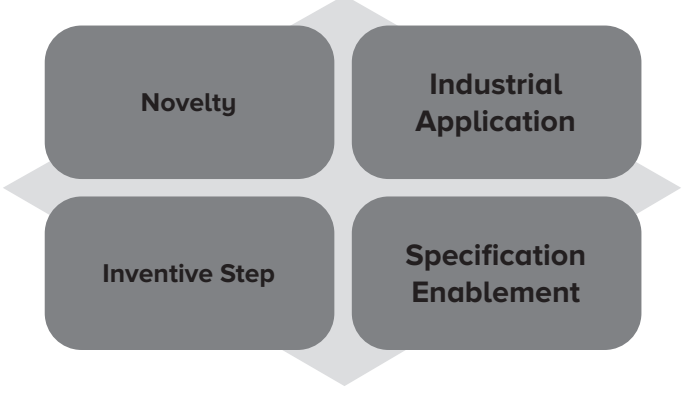
If the applicant mentions biological material in the invention and it is not possible to describe the same in the complete specification in the manner described in clauses (a) and (b) of section 10(4), and if such material is not available to public, the requirement of sufficiency of disclosure shall be completed by depositing such material in an International Depository Authority under the Budapest Treaty. The same shall be deposited not later than the date of filing, however, the reference number to the deposit shall be made in the specification within 3 months from the date of filing the application.

The complete specification shall contain the details of such deposition and the source and geographical origin of the biological material.

The technical advance, synergistic effect and efficacy of the claimed invention must be substantiated properly in the body of specification as well as by way of suitable examples.

Patentability Criterion

Below given are the patentability criteria on the basis on which patent examination is done. They are:-



Novelty

An invention is considered new (novel) if it has not been anticipated by publication in any document anywhere in the world, or prior claimed in an application for patent in India, or form part of the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere, or used; before the date of filing of patent application or date of priority, whichever is earlier, that is, the subject matter has not fallen in the public domain or that it does not form part of the state of the art.

Followings are the general principles relating assessment of Novelty:

a. An invention is considered as new if it is not anticipated by prior publication, prior use or prior public knowledge.

b. For the purpose of determining novelty, an application for Patent filed at the Indian Patent Office before the date of filing of complete specification of a later filed application but published after the same is considered for the purposes of prior claiming.

c. While ascertaining novelty, the Examiner takes into consideration, inter alia, the following documents:

- Documents which have been published before the date of filing of complete specification.
- Such Indian Patent Applications which have been filed before the date of filing of complete specification and published on or after the date of filing of the complete specification, but claims the same subject matter.
- Documents which have been published before in a transaction of a learned society or exhibited before in an authorized manner as designated by the Government within one year from the date of such filing.

d. A prior art will be considered as anticipatory if all the features of the invention under examination are present in the cited prior art.

e. The prior art should disclose the invention either in explicit or implicit manner.

f. Mosaicking of prior art documents is not followed in the determination of novelty.

g. A generic disclosure in the prior art may not necessarily take away the novelty of a specific disclosure.

h. A specific disclosure in the prior art takes away the novelty of a generic disclosure.

i. In a case where a prior art is cited as an anticipation in the Examination Report, which is not deemed to be an anticipation by reason on Section 29-34, the onus of proving is on the applicant.

CASE LAWS

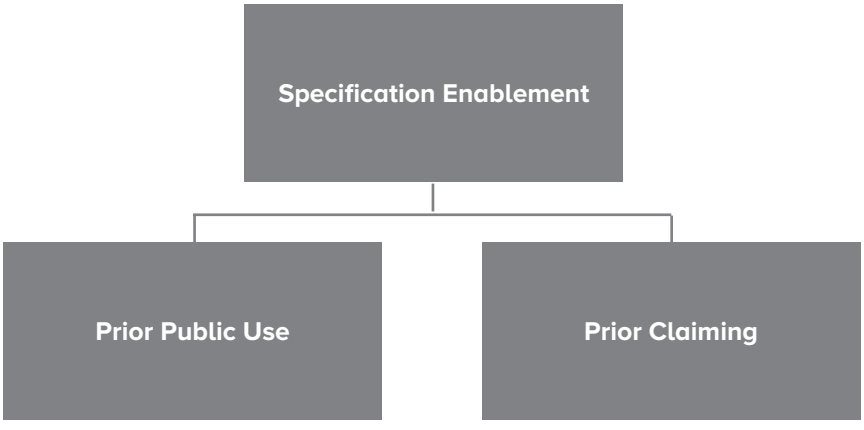
M/s. Crompton Greaves Ltd. Mumbai vs. M/s. Bharat Heavy Electricals Ltd. Hyderabad, on patent application No.221/BOM/96 (184657)

In this case, it was held by the Controller that the ground that the invention was publicly known or publicly used in India was not established by the opponent since the photo copies submitted by the opponent stated mainly the terms and conditions of a contract to supply 3900 KVA and 5400 KVA traction transformers. The photocopies of work order did not define any constructional features of the traction transformer. A mere statement by the opponent company that they are the first in the field of manufacturing alone can not stop the applicant company from obtaining a patent unless the opponents establish that they were manufacturing an identical product before the date of filing.

Monsanto company v. Coramandal Indag Products (P) Ltd. (1986) (1 SCC 642: AIR 1986 712: 1986 PTC 195 SC)

It was held that the invention was publicly known since its formula was published in the report of the International Rice Research Institute in the year 1968 and its common name But achlor was published in the same report in the year 1969

Novelty covers both Prior Public Use and Prior Claiming-



Prior Public Use

Prior public use of the invention before the date of filing of application destroys the novelty of the invention. However, there is an exception to this general rule. The Act provides that if an invention has been publicly worked in India within one year before the priority date by the patentee or applicant for the patent or by any third person from whom he derives the title or by the person who has obtained a consent to work the invention and such working of invention was only for the purpose of reasonable trial and it was necessary to effect such trial or working in public in view of the nature of the invention then such working of invention does not anticipate the invention (Section 32).

In case of a prior disclosure by the inventor, the Patents Act provides a one-year grace period for filing a patent application if the invention has been described in front of a learned society or published during the transactions of such learned society. The grace period is also available for conducting reasonable trials such as data generation for regulatory approval; it is not available where an invention is being sold or commercially worked in India. However, any use or publication of an invention after filing a provisional patent application in India will not be considered anticipation. Similarly, the grounds relating to public display [Sections 31(a), 31(b) and 31(c)], public working (Section 32) and traditional knowledge [Section 3(p)] are major considerations when determining novelty. An invention can also be anticipated by knowledge, either oral or in any other form existing in a local or indigenous community in India or elsewhere.

The general factors considered for anticipation assessment may be relevant in selection invention cases. In selection inventions, the selection of specific dimensions, ranges of values or parameters within (prior) larger areas based on new characteristics and unknown properties are considered to be invention. While the Indian Patent Office (IPO) does not expressly state that selection patents are unpatentable in India, a combined reading of Sections 3(d) and 2(1)(ja) appear to have a strict standard regarding patentability of selection invention.

What does it mean to "claim priority" of an earlier patent application?

Generally, patent applicants who wish to protect their invention in more than one country usually first file a national or regional patent application with their national or regional patent Office, and within 12 months from the filing date of that first application, they file their international application under the PCT. The effect of claiming the priority of an earlier patent application is that a patent shall not be invalidated by reasons of any acts accomplished in the interval, such as another filing, the publication or sale of the invention.

CASE LAWS

Farbewerke Hoechst Aktiengesellschaft Vormals Meister Lucius and Bruning a Corporation and Ors. vs. Unichem Laboratories and Ors. (11.07.1968 - BOMHC) AIR1969Bom255

The Court stated that to anticipate a patent, a prior publication or activity must contain the whole of the invention impugned; i.e., all the features by which the particular claim attacked is limited. In other words, the anticipation must be such as to describe, or be an infringement of the claim attacked.

Monsanto Co. v. Coromandel Indag Products (P) Ltd. 1986 A.I.R. 712

In this case, it was held that "to satisfy the requirement of being publicly known as used in clauses (e) and (f) of section 64(1), it is not necessary that it should widely be used to the knowledge of the consumer public. It is sufficient if it is known to the persons who are engaged in the pursuit of knowledge of the patented product or process either as men of science or men of commerce or consumers."

Public Claiming

Section 13 - Search for anticipation by previous publication and by prior claim-

(1) The examiner to whom an application for a patent is referred under section 12 shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification.

(2) In any claim of any other complete specification published on or after the date of filing of the applicant's complete specification, being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.

As per Rule 29, procedure in case of anticipation by prior claiming.—

When it is found that the invention so far as claimed in any claim of the complete specification, is claimed in any claim of any other specification falling within clause (b) of sub-section (1) of section 13, the applicant shall be so informed and shall be afforded an opportunity to amend his specification.

If the applicant's specification is otherwise in order for grant and an objection under clause (b) of sub-section (1) of section 13 is outstanding, the Controller may postpone the grant of patent and allow a period of two months for removing the objection.

In order to prove prior claiming of the invention, compliance with the following conditions is examined:

(i) That the application 'X' where the invention has been claimed in a claim prior to the application 'Y' claiming alleged invention, has been filed in India.

(ii) The application 'X' must have been filed or claiming a priority earlier to the priority date of application 'Y' in question.

(iii) The application 'X' should have been published on or after the date of application ('Y') in question.

CASE LAWS

Pfizer Products Inc. vs. The Controller of Patent and Designs (21.08.2020 - IPAB): (OA/2/2016/PT/MUM)

IPAB in this case stated that in order to have valid objection about anticipation by prior claiming, the following has to be established [section 13(1)(b)]:

a. That there is an invention for which an application for patent has been made in India (hereinafter referred to as 'the first application').

b. The second invention for which a patent has been granted is "claimed in any claim" of the complete specification of the first application.

c. The first application is published after the priority date of the claim of the patentee.

d. The claim of the first application has a priority date that is earlier than the claim of the patentee.

It was further stated that with regard to section 13(1)(b) of the impugned order is not sustainable that for the purpose of prior claiming, "the claims" of the Indian Prior art have to be mapped with the claims of the Indian applications/patents.

Centron Industrial Alliance Private Limited v. Harbans Lal Malhotra and Sons Private limited, [DPD, Vol.1, p 133], patent No. 123140

The Controller held that the later application (filed on 15th September, 1969) claiming a method of manufacturing superior quality blades of razors and like instruments which consists atomic or molecular deposition in vacuum of a thin film of particles of a corrosion resistant material on the cutting edge or edges of the blades of the said instruments and thereafter coating the said blade with polytetrafluoroethylene. The claimed method is anticipated by prior claiming in an earlier application (filed on 14th March, 1969)

claiming a method of manufacturing, superior quality blades of razors and like instruments defined, which included coating the blades with polytetrafluoroethylene, characterized in that the said method consisted of atomic or molecular deposition in vacuum of a thin film of particles of a corrosion resistant material on the cutting edge or edges of the blades of the said instruments before coating the said blades with said polytetrafluoroethylene.

Grace Period

Rule 29A states that an application to avail the period specified under section 31 shall be filed in Form 31, along with the fees specified in the First Schedule

Inventive Step

Inventive step is decided in accordance with the provisions of section 2(1)(ja) of the Indian Patents Act, 1970.

As per 2(1)(ja), "inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art.

The Intellectual Property Appellate Board on inventive step and exclusions:

"When the patentee explains that there is an inventive step which is a technical advance compared to the existing knowledge (state-of the-art) or that it has economic significance that would not give him the right to a patent as such. ''The inventive step' must be a feature which is not an excluded subject itself. Otherwise, the patentee by citing economic significance or technical advance in relation to any of the excluded subjects can insist upon grant of patent thereto. Therefore, this technical advance comparison should be done with the subject matter of invention and it should be found it is not related to any of the excluded subjects."

Accordingly the following points need to be objectively judged to ascertain whether the invention does have inventive step or not:

a. Identify the inventive concept of the claim in question;

b. Identify the "person skilled in the art", i.e. competent craftsman or engineer as distinguished from a mere artisan;

c. Identify the relevant common general knowledge of that person at the priority date;

d. Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed.

CASE LAWS

Ajay Industrial Corporation vs. Shiro Kamas of Iberaki City (AIR 1983 Del 496.)

In this case, it was stated that the specification and claims had all to be read together and reasonably and benevolently construed. In the absence of any technical or expert evidence either indicating that these

statements were wrong or that the article produced incorporated no new devices to get over these defects, it could not be held that the patent embodied no new discovery or invention. It was held that the appellant had not discharged the onus that lay on it to establish that the respondent's patent could not have been registered and, therefore, needed to be revoked.

Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries, AIR 1982 SC 1444

It was held that "The expression "does not involve any inventive step" used in Section 26(1)(a) of the Act and its equivalent word "obvious", have acquired special significance in the terminology of Patent Law. The 'obviousness' has to be strictly and objectively judged. For this determination several forms of the question have been suggested. The one suggested by Salmond *L. J. in Rado* v. *John Tye & Son Ltd.* is apposite. It is: "Whether the alleged discovery lies so much out of the Track of what was known before as not naturally to suggest itself to a person thinking on the subject, it must not be the obvious or natural suggestion of what was previously known."

It was also observed that "Another test of whether a document is a publication which would negative existence of novelty or an "inventive step" is suggested, as under: "Had the document been placed in the hands of a competent craftsman (or engineer as distinguished from a mere artisan), endowed with the common general knowledge at the 'priority date', who was faced with the problem solved by the patentee but without knowledge of the patented invention, would he have said, "this gives me what I want?".

Industrial Applicability

The third criteria of patentability are that the invention should be capable of industrial application. It is defined in Section 2 (1)(ac) of the Patents Act, 1970.

Section 2 (1) (ac) "Capable of Industrial application", in relation to an invention, means that the invention is capable of being made or used in an industry.

Essentials for an invention to be capable of industrial application

- If the subject matter is devoid of industrial application it does not satisfy the definition of "invention" for the purpose of the Act. Ordinarily, "Industry" is taken in its broad sense as including any useful and practical, as distinct from intellectual or aesthetic activity. It does not necessarily imply the use of a machine or the manufacture of a product and covers such thing as a process for dispersing fog or a process of converting energy from one form to another.
- Vague and speculative indication of possible objectives that might or might not be achievable by carrying out further research with the tool as described may not be sufficient for fulfilment of the requirement of industrial applicability. The purpose of granting a patent is not to reserve an unexplored field of research for an applicant.
- Methods of testing are generally regarded as capable of industrial application if the test is applicable to the improvement or control of a product, apparatus or process which itself is capable of industrial application. It is therefore advisable to indicate the purpose of the test if this is not otherwise apparent.

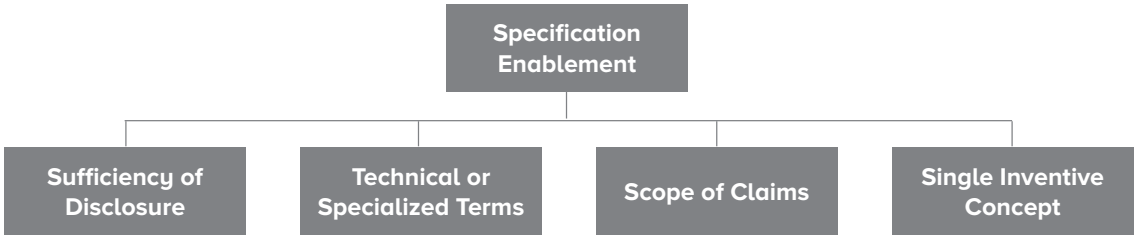
- Processes or articles alleged to operate in a manner which is clearly contrary to well-established physical laws, such as perpetual motion machines, are regarded as not having industrial application.
- An invention for a method of treatment of the human or animal body by surgery or therapy or of diagnosis practiced on the human or animal body is not taken to be capable of industrial application.
- Parts /pieces of the human or animal body to be used in transplants are objected as not being capable of industrial application.

Illustration

- An application relating to a scheme for exchanging all or part of a prison sentence for corporal punishment was held to lack industrial applicability and also to be a method for doing business.
- A method for effecting introductions with a view to making friends was held not to be industrially applicable, even though it could be carried out by a commercial enterprise. It was also found to be excluded as a method of doing business. In a patent for a photo-booth camera was held that the folded optical path as described and claimed could not give rise to the claimed narrowing of the depth of field. As a result, the hearing officer held that the invention could not work as described and claimed, and so lacked industrial applicability.

Specification Enablement

Specification enablement includes –



Sufficiency of Disclosure

In the patent system, the sufficiency of disclosure is a prerequisite. The method a patent specification is written may vary slightly depending on the jurisdiction, but all require that the disclosure be sufficient.

Also the applicant is required to disclose the source and geographical origin of such materials as used in the invention, subject to provisions of section 10(4). For details please refer to the guidelines on biotech and Traditional Knowledge.

The description should not contain passages which confuse the scope of the invention.

Where particular description or drawings do not exemplify the invention claimed, for example, where they are included by way of explaining the invention or for comparison or where they relate to prior art, the description should make this clear.

CASE LAWS

The Controller rejected ***Patent Application No. 201611017772 in an order dated June 12, 2019,*** citing "Sufficiency of Disclosure u/s 10(4)" as one of the reasons. The description stated that "in an exemplary implementation, the presentation of cultural similarity and/or environmental fitment can be determined based on a cultural evaluation of an individual's attributes, and comparison of such evaluation with cultural aspects of other users in a selected career," but certain details, such as how the cultural aspects of an individual were evaluated, what the cultural attributes are, etc., were not disclosed. In light of the aforementioned, the controller was of the opinion that complete specification did not satisfy Section 10(4) of the Act's requirements.

TATA Global Beverages Limited vs. Hindustan Unilever Limited and Ors. (18.10.2012 - IPAB) : Decided On: 18.10.2012 in TRA/1/2007/PT/MUM

In this case it was held that the sufficiency requirement is met if at least one way of working the invention is clearly indicated enabling the skilled person to carry out the invention. The applicant only submitted that in the absence of any control data of the colour of the starting material, the specification lack in establishment of any "improvement" related thereto. It is not necessary for the purpose of section 10(4) that the disclosure of a patent be adequate to enable the skilled person to carry out all conceivable ways of operating the invention. If the best method known to the patentee is disclosed it satisfies the requirement of sufficiency. Since the appellant has not contested the reproducibility of the example of the patent in question we find it sufficient for the purpose of section 10.

Farbewerke Hoechst Aktiengesellschaft Vormals Meister Lucius and Bruning a Corporation and Ors. vs. Unichem Laboratories and Ors. (11.07.1968 - BOMHC) AIR 1969 Bom 255,

In this case, the Court while discussing the sufficieny of disclosure stated the Halsbury's branches of insufficiency of description "(1) the complete specification must describe "an embodiment" of the invention claimed in each of the claims and that the description must be sufficient to enable those in the industry concerned to carry it into effect "without their making further inventions"; and (2) that the description must be fair i.e. it must not be unnecessarily difficult to follow.

The specification and claims are addressed to those with a high degree of knowledge of the field of science to which they relate, particularly when they relate to chemistry and allied subjects. It is not necessary to describe processes on the Claims to a specification when they are part of the common knowledge available to those skilled in the science who can, after reading them, refer to the technical literature on the subject for the purpose of carrying them into effect. "An embodiment" of the invention is, therefore, in my opinion, sufficiently described in the plaintiffs patent and that description is not unnecessarily difficult to follow, it being sufficient to enable the invention to be carried into effect "without making further inventions".

Technical or Specialized Terms

Points to be kept in mind while using specialised terms-

- The description should be as clear and straightforward as possible, with the avoidance of unnecessary technical jargon.
- Foreign terms may be used only where there is no English equivalent.
- Terms already having an established meaning should not be used differently, if this is likely to cause confusion.
- The use of proper names or similar words to refer to materials or articles is undesirable in so far as such words merely denote origin, or where they may relate to a range of different products.
- The product should be sufficiently identified, without reliance on the word, to enable the invention to be carried out by the skilled person.
- A trade name or mark should not be used in a specification since it is an indication of origin rather than of composition or content and on that account cannot properly be used to describe an article.

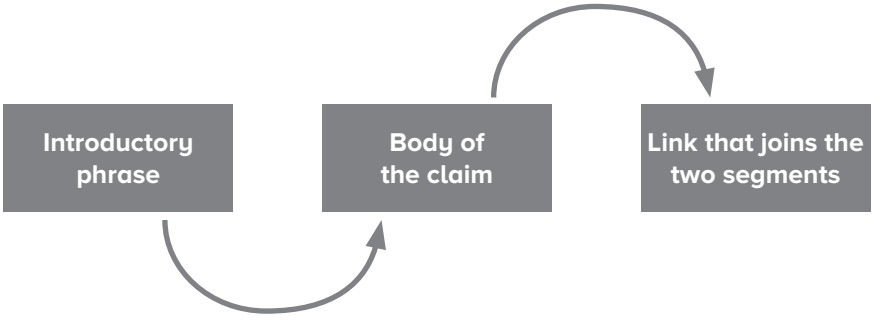
Scope of Claims

As the value of a patent depends largely upon the scope of the claims, special care is necessary to ensure that the claims are not allowed to include either more or less than what the applicant desires to protect by his patent and must be fairly based on the matter disclosed in the specification. Therefore, claims must not be too extensive so as to embrace more than what the applicant has disclosed in the complete specification. A claim, which is too wide, may encroach upon the subject matter, which may be in public domain or belong to others.

Passages which confuse the scope of the invention or claims that are unspecific (e.g. those claiming "Any novel matter...") is prejudicial to clarity of claims.

A claim shall be for the protection of either a product or process or apparatus or all of them, as the case may be, and shall be in one sentence according to the standard practice.

A claim usually consists of three parts:



1. Introductory phrase- The introductory phrase identifies the category of the invention and sometimes the purpose (For example, a machine for waxing paper, a composition for fertilizing soil).
2. Body of the claim- It is the specific legal description of the exact invention, which is sought to be protected.
3. The linking consists of words and phrases such as:
   - Which comprises
   - Including
   - Consisting of
   - consisting essentially of

Illustration

"A data input device" is the introductory phrase, "comprising" is the linking word, and the rest of the claim is the body. "A data input device comprising; an input surface adapted to be locally exposed to a pressure or pressure force, a sensor means disposed below the input surface for detecting the position of the pressure or pressure force on the input surface and for outputting an output signal representing said position and; an evaluating means for evaluating the output signal of the sensor means."

Single Inventive Concept

Section 10(5) mandates that the claim/ claims of the complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept.

In other words when there is a group of inventions in a specification they should be linked by a single concept which is inventive or there should be a technical relationship among the claimed inventions, which makes the inventive contribution over the prior art. To fulfil the requirement of unity of invention each claim of a complete specification should share a single common technical relationship which is inventive.

The determination whether a group of inventions is so linked as to form a single inventive concept is made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Lack of unity of invention may be directly evident "a priori," that is, before considering the claims in relation to any prior art, or may only become apparent "a posteriori," that is, after taking the prior art into consideration.

Illustration

Independent claims to A + X, A + Y, X + Y can be said to lack unity a priori as there is no subject matter common to all claims. In the case of independent claims to A + X and A + Y, unity of invention is present a priori as A is common to both claims.

However, if it can be established that A is known, there is lack of unity a posteriori, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.

EXAMINATION PROCESS IN INDIA

The Process of examination starts with filing a request for examination. Unlike publication, this is not an automatic process. Only after receiving the Request for Examination (RFE) the controller transfers the patent application to the patent examiner. The request for examination has to be made within 48 months from the date of priority or filing whichever is earlier.

ALLOCATION OF APPLICATION TO EXAMINER FOR EXAMINATION

Once the request for examination is received and the application has been published, the Controller shall refer the particular application to an examiner for conducting examination and search in accordance with section 12 and 13 of the Patents Act, 1970. Before such reference the controller has to take the following points into consideration. In order of filing of request: Reference of patent application shall be strictly in accordance with the sequential order of filing of the request for examination.

EXAMINATION OF PATENT APPLICATION: REGULATORY REGIME

The examination of patent application is conducted in accordance with the provisions of section 12 of the Patents Act, 1970. After the patent application is filed and subsequent to the filing of the request for examination as well as the publication of the same, the Controller shall refer the application and the specification and other documents related thereto to an examiner for making a report to him in accordance with the provisions of the Act and the rules made there under.

Section 12 states that when a request for examination has been made in respect of an application for a patent in the prescribed manner under sub-section (1) or sub- section (3) of section 11B, the application and specification and other documents related thereto shall be referred at the earliest by the Controller to an examiner for making a report to him in respect of the following matters, namely:—

a. whether the application and the specification and other documents relating thereto are in accordance with the requirements of this Act and of any rules made thereunder;

b. whether there is any lawful ground of objection to the grant of the patent under this Act in pursuance of the application;

c. the result of investigations made under section 13; and

d. any other matter which may be prescribed.

The examiner to whom the application and the specification and other documents relating thereto are referred under sub-section (1) shall ordinarily make the report to the Controller within such period as may be prescribed.

The search needs to be conducted in accordance with section 132 of the patents Act, 1970.However, it is evident that section 12(1) [(a) to (d)] mandate applicability of the entire Patent Act and the Rules made there under for the purpose of examination of the patent application. The examiner has to submit the report of such examination to the Controller on the matters specified under therein accordingly.

FIRST EXAMINATION REPORT UNDER THE PATENT ACT

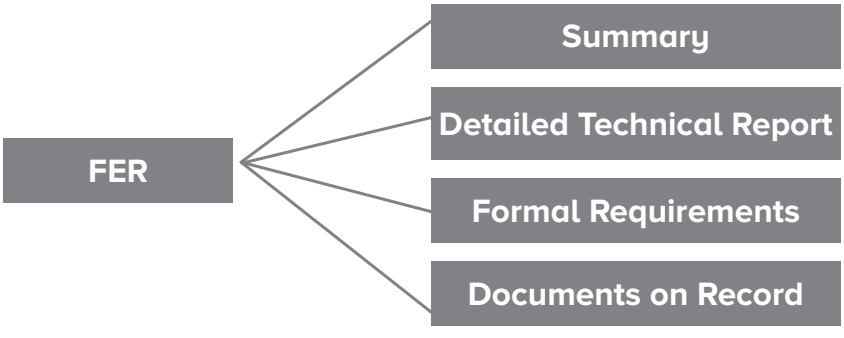
After reviewing the patent application, the Patent Office sends the patent applicant an examination report, commonly referred to as the First Examination Report (FER). This is delivered to the controller by the examiner. It frequently comprises prior art that is related to the innovation being claimed. In this context, prior art refers to earlier published works that are comparable to the claimed innovation. It is not required to be bought commercially. There is only proof that the alleged invention is already well-known.

Within a year of the FER's issuance, the applicant must respond to any objections and put the application in order for grant (First Examination Report).

The application is regarded to have been abandoned in this instance as well if the response to the examination report is not submitted within the allotted time period of 12 months.

If a third party does not submit or maintain a pre-grant objection after the patent application is determined to be in order for grant, the patent is issued.

The First Examination Report [FER] is divided into 4 parts, namely:



- **Summary -** This section of the report follows the basic details of the patent applications. There are some requirements of the Patent Act which the patent application is expected to mandatorily fulfill. So the status of the Patent application regarding whether or not it fulfills the requirements under the Act are mentioned in a summarized form.
- **Detailed Technical Report -** The detailed justifications for the objections listed in the summary (section above) are provided in the second portion of the Examination report. It is further separated into two sections:

  A list of the documents listed, followed by a description of the Act's requirements and specific observations.

  1. *List of Documents* – The patent and non-patent literature (prior arts) that are comparable to the current patent application (to be reviewed) are referenced in the list of documents cited section along with their priority and publication dates, respectively.
  2. *Detailed Observation*- The explanation and pertinent prior arts, such as D1, D2, and so on, are included with the reasons for objection to the patent application. The sections dealing with inventive step, non-patentability, adequate disclosure, and definitiveness challenges, the section along with corrective steps are mentioned herein.
- **Formal Requirements-** In this section, the detail related to the formal requirements is mentioned. This section lists the pending forms, official requirements and the correction required (if any) in the format of specification is mentioned.
- **Documents on Record-** This section mentions the list of documents along with their docket number and docket date on which the examination report is based along with the last date for filing the response to the FER.

RE-ISSUE AND RE-EXAMINATION

After the grant of patent, every patentee has to maintain the patent by paying renewal fee every year as prescribed in the schedule I.

For first two years, there is no renewal fee. The renewal fee is payable from 3rd year onwards. In case the renewal fee is not paid the patent will be ceased. To keep a patent in force renewal fees is payable at the expiration of second year from the date of the patent or of any succeeding year. In other words renewal fee has to be every year up to the completion of 20 years. Renewal fees can be paid beyond the due date within a period of 6 prescribed fees. If a patent is granted later than two years from the date of filing of the application, the fees which have become due in the meantime may be made within a period of 3 months from the date of recording the patent in the register. This time is also extendable by 6 months as described earlier.

The annual renewal fees payable in respect of two or more years may be paid in advance: Provided that where the renewal fees is paid in advance through electronic mode for a period of at least 4 years, a ten per cent reduction in fee shall be applicable for such renewal.

INTERNATIONAL FILING

Patent Cooperation Treaty

The PCT is an international treaty with more than 150 Contracting States which are bound with certain formal requirements set out in the Treaty and Regulations. The PCT makes it possible to seek patent protection for an invention simultaneously in a large number of countries by filing a single –international patent application instead of filing several separate national or regional patent applications however, granting of patents remains under the control of the national or regional patent offices after the corresponding – national phase application has been filed and the national phase application is assessed as per patent law of that jurisdiction.

As per Indian Patent Act 1970 as amended and the Patents Rules 2003 as amended by (amendment) rules 2016, any PCT international application may be filed designating India and it shall deemed to be an application if the corresponding national phase application has also been filed.

Advantages of the Patent Cooperation Treaty

The PCT System has many advantages for an applicant, for the patent Offices and for the general public:

1. You have up to 18 months more than if you had not used the PCT to reflect on the desirability of seeking protection in foreign countries, to appoint local patent agents in each foreign country, to prepare the necessary translations and to pay the national fees;
2. If your international application is in the form prescribed by the PCT, it cannot be rejected on formal grounds by any PCT Contracting State patent Office during the national phase of the processing of the application;
3. The international search report and written opinion contain important information about the potential patentability of your invention, providing a strong basis for you to make business decisions about how to proceed;
4. You have the possibility during the optional international preliminary examination to amend the international application, enter into dialogue with the examiner to fully argue your case and put the application in order before processing by the various national patent Offices;
5. The search and examination work of patent Offices in the national phase can be considerably reduced due to the international search report, the written opinion and, where applicable, the international preliminary report on patentability that accompany the international application;
6. You may be able to fast-track examination procedures in the national phase in Contracting States that have PCT-Patent Prosecution Highway (PCT-PPH) agreements or similar arrangements;

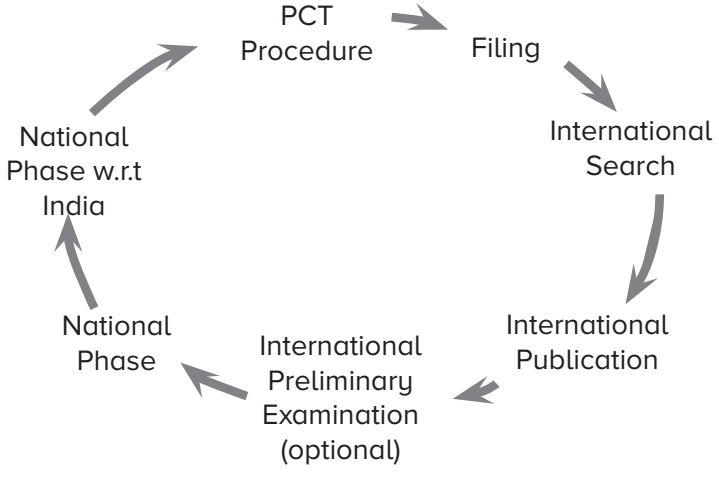
7. Since each international application is published together with an international search report, third parties are in a better position to evaluate the potential patentability of the claimed invention;

8. For an applicant, international publication online puts the world on notice of your invention. You may also highlight your interest in concluding licensing agreements on PATENTSCOPE, which can be an effective means of advertising and looking for potential licensees;

9. You also achieve other savings in document preparation, communication and translations because the work done during the international processing is generally not repeated before each Office (for example, you submit only one copy of the priority document instead of having to submit several copies); and

10. If your invention appears to be not patentable at the end of the international phase, you may abandon the PCT application and save the costs you would otherwise have incurred by directly seeking protection in foreign countries, appointing local patent agents in each foreign country, preparing the necessary translations and paying the national fees.

Procedure of obtaining Patent via PCT



The PCT procedure includes:

1. **Filing:** File an international application with a RO/IN national patent Office or directly with International Bureau (IB) of WIPO, complying with the PCT formality requirements and fees. In India PCT application are filed at appropriate patent offices decided on the basis of territorial limits (Rule 4, Indian Patent Act 1970 as amended and patent Rules 2003 as amended).

2. **International Search:** An International Searching Authority (ISA) identifies the published patent documents and technical literature (prior art) which may have an influence on whether your invention is patentable, and establishes a written opinion on your invention‘s potential patentability. Indian Patent office, Delhi Branch performs the function of ISA on receipt of prescribed fee specified in Fifth Schedule of patent act 1970 as amended and patent rules 2003 as amended.

3. **International Publication:** After expiration of 18 months from the earliest filing date (Priority Date), the content of your international application is disclosed to the world.

4. **International Preliminary Examination (optional):** One of the ISAs on request carries out an additional patentability analysis, usually on an amended version of your application. Indian Patent office, Delhi Branch performs the function of International Preliminary Examination (IPEA) on receipt

of prescribed fee specified in Fifth Schedule of patent act 1970 as amended and patent rules 2003 as amended.

5. **National Phase:** After the end of the international PCT procedure, usually at 30/31 months from the earliest filing date of your initial application, from which you claim priority, you start to pursue the grant of your patents directly before the national (or regional) patent Offices of the countries in which you want to obtain them.
6. **National Phase w.r.t India:** In India, 31 months is maximum time limit to enter national phase. To enter national phase an application corresponding to an international application is made in Form 1.

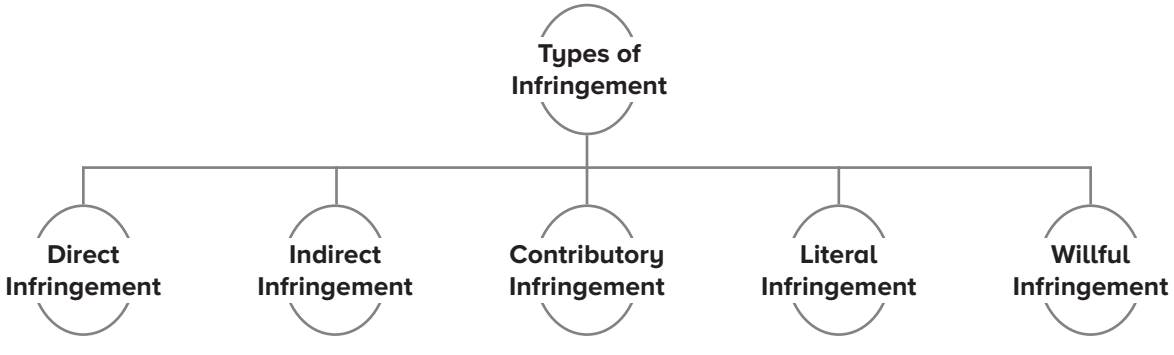
PATENT INFRINGEMENT

Patent infringement means the violation of the exclusive rights of the patent holder. As discussed earlier, patent rights are the exclusive rights granted by the Government to an inventor over his invention for a limited period of time. In other words, if any person exercises the exclusive rights of the patent holder without the patent owner's authorization then that person is liable for patent infringement. Sections 104-114 of the Patents Act, 1970 provide guidelines relating to patent infringement.Patent infringement occurs when another party makes, uses, or sells a patented item without the permission of the patent holder. The patent holder may choose to sue the infringing party to stop his or her activities, as well as to receive compensation for the unauthorized use. Since intellectual property is governed by statutory law, the patent holder must sue the unauthorized party in court of law.

Unlike the Design law, the Patents law does not specify as to what would constitute infringement of a patented product or process. However, the following acts when committed without the consent of the patentee shall amount to infringement:

Types of Patent Infringement

There are different ways a patent could be infringed. Some of the types of patent infringements includes:



(a) Direct Infringement

This occurs when a product covered by a patent is manufactured without permission. Direct patent infringement is the most obvious and the most common form of patent infringement. Basically, direct patent infringement occurs when a product that is substantially close to a patented product or invention is marketed, sold, or used commercially without permission from the owner of the patented product or invention.

CASE LAW

Larami Corp. vs. Amron (1993)

In this case, a patented water gun by Amron was violated by Larami Corporation. The allegedly infringing product was a toy named SUPER SOAKERS that, in contrast to the claimed idea, had a "elongated housing containing a chamber therein for a liquid," was detachable and removable. The court ruled that the SUPER SOAKERS manufactured by Larami did not violate Amron's patent, since it was different from the plaintiff's product.

(b) Indirect Infringement

An indirect infringer may induce infringement by encouraging or aiding another in infringing a patent. Indirect patent infringement suggests that there was some amount of deceit or accidental patent infringement in the incident.

Illustration

A holds a patent for a device and B manufactures a device which is substantially similar to A's device. B is supplied with a product from another person C to facilitate manufacturing of the B's device. If the device so manufactured by B infringes upon A's patent, then person C indirectly infringes A's patent. Further, if such a product is knowingly sold or supplied, it may lead to "contributory infringement".

(c) Contributory Infringement

The other party becomes vicariously liable for the actions of the infringer when there is an intended involvement or help by one party in an act of infringement.

It is a form of indirect infringement in which an individual or business is held accountable for an infringement even if they haven't actively taken part in the infringing actions. In light of this, it occurs when a party sells a good that they are aware is used in an infringing good. Typically, this product will not have any commercial value apart from the fact that it is used in the infringement.

When a seller offers a part or component that, while not infringing on its own, has a specific application as a component of another machine or composition that does infringe on a patent, that seller is deemed to have committed contributing infringement.

Illustration

Person X is selling a chair that has been patented. Given that the chair is protected by a patent, which stipulates that it must have legs among other things. Given that adding legs will be necessary to make the chair useable. Person X, who is selling the chair without legs may be in direct violation as contributory infringement. The Person X is nonetheless responsible as long as creating infringing chairs was the recipient's objective and the supplier knew it, even if the chairs are not converted into such goods (perhaps because the patentee steps in before that may happen).

(d) Literal Infringement

This exists if there is a direct correspondence between the words in the patent claims and the infringing device. Even if an invention does not literally infringe the patent, it may still infringe under the doctrine of equivalents.

A device that performs the substantially same task in substantially the same way to achieve substantially the same result infringes the patent under this doctrine. If the court finds Infringement, it must still determine whether the Infringement was willful.

(e) Willful Infringement

Willful Infringement involves intentional disregard for another's patent rights and encompasses both direct and intentional copying and continued Infringement after notice. Patent users and inventors should employ patent attorneys to ensure that the use of a patent is valid and non-infringing. Even if Infringement is later found, the attempt to secure a legal opinion is evidence that the Infringement was not willful.

If the court finds that the Infringement was willful, the infringer faces a substantial financial penalty; a willful infringer may end up paying triple the amount of actual damages suffered by the patent holder, as well as the plaintiff's attorneys' fees.

Illustration

A, knowing about B's patented invention of sound system devises his own version of sound system which is a replica of B's invention knowing well that his acts were in violation of the B's patent. It is said to be wilful infringement on part of A.

Exceptions of Infringement

The law however enumerates certain exceptions to Infringement:

1. **Scientific, Experimental and Research:** Any patented article or process can be used for the following purposes:
   - Experiment
   - Research
   - Instructing the pupils

   It is also permitted to make, construct, use, sell or import a patented invention solely for the uses reasonably related to the development and submission of information required under any law for the time being in force, in India, or in a country other than India, that regulates the manufacture, construction, use, sale or import of any product. All such acts, if within the bounds as created above, cannot be challenged as infringing the rights of the patentee.
2. **Doctrine of Exhaustion:** The first sale doctrine, often known as the doctrine of exhaustion, refers to the idea that a patent holder's rights are exhausted once their work is sold without restriction. This doctrine states that a patentee loses control over a particular product when it is first sold without restriction.

   A patent holder has officially used the rights to prevent others from making, using, selling, offering for commercialization in the region of patent issue, or bringing an innovation into the region of patent issue by making the first sale of the patent creation, and has thus reaped the benefits associated with a patent. This is the justification for the rights being exhausted upon the sale of the protected product. This has been discussed in detail further in the chapter.
3. **Foreign Vessels, Aircraft or Land Vehicles Exception:** The Paris Convention states that a patent's rights may not extend to the use of a protected innovation when a vessel is on board when it momentarily or unintentionally enters the water, provided that the invention is solely used to meet the needs of the vessel.

   When a foreign vessel, flying machine, or land vehicle momentarily or accidentally enters the country's territory, the patent rights are not violated when the protected creation is used only for the needs of such foreign vessels, flying machines, or land vehicles and their accessories.

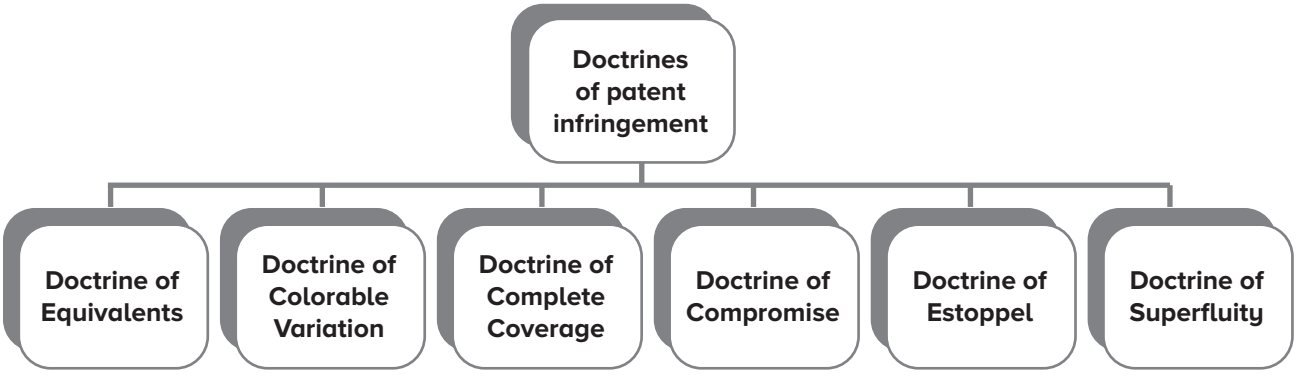
   Given that the ships, aircraft, or land vehicles do not remain in the local seas or the territory of the country indefinitely, the phrase "temporary" includes both unintentional and unintended entry as well as intentional and usual entry into a port. This unique situation benefits ongoing global transit and lowers tensions between governments over the treatment of ships carrying their flag.

4. **Private and Non-business Use Exception:** A patent does not grant private use rights or a monopoly over commercial activity. The government has the authority to grant a Compulsory License (CL) to an outsider in order to use the protected creation in order to limit the privileges of the patentee with the aim of preventing the mishandling/abuse of the rights by the property holder and to prevent any adverse effects of such activity on the general public. This is the case in cases where a patentee is neither using nor distributing the innovation for benefit. When the licensed invention is not promoted in India, is not widely available at reasonable prices, or is not produced in sufficient quantities, the concept of CL becomes crucial. Currently, it is believed that the CL arrangement is the best way to increase access to restricted medications.
5. **Prior-Use or Regulatory-Use Exemption:** This exemption, which is also known as the "Bolar Provision," is one of the statutory safeguards against the infringement of patent rights or patent infringement that allows generic drug manufacturers to successfully develop and submit the data necessary to obtain marketing authorization for patented products anywhere in the world without the consent of the patent holder. This clause enables general manufacturers or producers to sell and make their goods prior to the patent's expiration. In any case, the exemption does not consider the use of protected drugs to obtain a license to manufacture and market the generic drug prior to the expiration of the patent period.
6. **Exhaustion of Patent Rights:** When a licenced work or innovation is marketed without any restrictions, the benefits of the patent owner are said to have been exhausted, according to the doctrine of exhaustion. According to this doctrine, the patent owner's control over a protected product is diminished by the major unhindered sale of such product.

   The first sale of the patent creation allowed the patent owner to legitimately use the rights to prevent others from using, offering, making, or selling for commercial purposes in the Patent territory issued to bring innovation or invention into the area of Patent issue, and as a result, the patent owner has earned the benefits associated with a patent. This is the explanation for why the rights exhaust upon the sale of the protected product.
7. **Parallel Importation under certain conditions:** Patented article or article made by using the patented process can be imported by government for its own use. Also a patented process can be used by the government solely for its own use. Moreover the government can import any patented medicine or drug for the purposes of its own use or for distribution in any dispensary, hospital or other medical institution maintained by the government or any other dispensary, hospital or medical institution notified by the government. [Section 27 &47] This has been discussed in detail further in the chapter.

DOCTRINES OF PATENT INFRINGEMENT

There are five ways to justify a case of patent Infringement:



Sometimes the end user is not even aware that he or she is using a patented item unlawfully. Other times, there are too many people using the item to sue all of them. Rather than suing end users, it might be best to sue those who are knowingly trying to infringe on a patent.

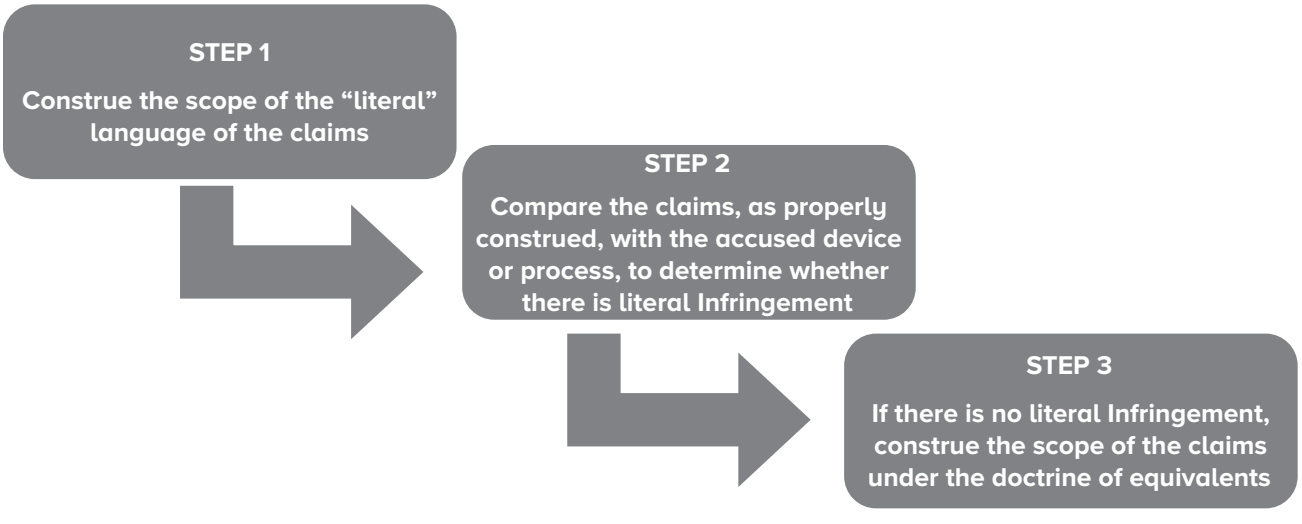
Doctrine of Equivalents

Patent Infringement generally falls into two categories: literal Infringement and Infringement under the doctrine of equivalents. The term "literal Infringement" means that every element recited in a claim has identical correspondence in the allegedly infringing device or process.

However, even if there is no literal Infringement, a claim may be infringed under the doctrine of equivalents if some other element of the accused device or process performs substantially the same function, in substantially the same way, to achieve substantially the same result. The doctrine of equivalents is a legal rule in most of the world's patent systems that allows a Court to hold a party liable for patent Infringement even though the infringing device or process does not fall within the literal scope of a patent claim, but nevertheless is equivalent to the claimed invention.

This "expansion" of claim coverage permitted by the doctrine of equivalents, however, is not unbounded. Instead, the scope of coverage which is afforded the patent owner is limited by (i) the doctrine of "prosecution history estoppel" and (ii) the prior art.

An Infringement analysis determines whether a claim in a patent literally "reads on" an accused infringer's device or process, or covers the allegedly infringing device under the doctrine of equivalents. The steps in the analysis are:



The doctrine of equivalents is an equitable doctrine which effectively expands the scope of the claims beyond their literal language to the true scope of the inventor's contribution to the art. However, there are limits on the scope of equivalents to which the patent owner is entitled.

Position of Doctrine of Equivalents in India

CASE LAW

Ravi Kamal Bali vs. Kala Tech and Ors. [2008] (38) PTC435 (Bom)

The idea of doctrine of equivalents was first introduced in India in this case. of The plaintiff filed a patent infringement lawsuit against Kala Tech, the defendant, seeking an interim injunction barring Kala Tech from producing, marketing, or distributing tamper-evident locks or seals as it would constitute a patent infringement. He contended that Kala Tech's accomplish the same task, in basically the same manner and delivers the same outcome so contributing to the infringement. Regardless of the fact that the interim injunction was not granted, the significance of the case resides in the fact that it was the first time the theory of equivalents was debated in India, despite the temporary injunction not being granted.

Doctrine of Colorable Variation

A colourable variation or immaterial variation amounting to infringement is where an infringer makes slight modification in the process or product but in fact takes in substance the essential features of the patentee's invention.

CASE LAW

Lektophone Corporation vs. The Rola Company, 282 U.S. 168 (1930)

A patent holder's patents were of sound-reproducing instruments for phonographs. According to the patent application, size and dimensions of the invention were the essence of the patent. The patent holder claimed that a radio loud speaker manufactured by the defendant (manufacturer) infringed the patents. The manufacturer's devise also had a central paper cone, but the cone was smaller than that of the patented devise and that constituted colorable alteration. The court held that because colorable alterations of the manufacturer's devise, it would not accomplish the object specified in the patent claims and hence did not infringe upon the patent holder's claims.

Doctrine of Complete Coverage

According to the doctrine of complete coverage, when a claim is interpreted, such interpretation must also be viewed in the context of assessing both literal and analogous infringement. The owner of a patent must demonstrate in court by the submission of proof that the claimed infringer has manufactured, sold, or used a methodology that is directly related to the original patented invention.

Doctrine of Compromise

Regarding the preservation of an invention's and utility model's patent rights, the doctrine of compromise is a fundamental premise. The limitation system, as represented by Germany, and the perimeter limitation system, as represented by England and the United States, are the two typical world practises in the technique of describing and assessing the claim of patent right protection.

Doctrine of Estoppel

Doctrine of estoppel is a notion that was developed in England and has since been incorporated into common law in practically all international courts. In a broad sense, the theory of estoppel principle states that no other interpretation is permitted beyond the date of publication of a technical statement.

Doctrine of Superfluity

A fundamental principle known as the doctrine of superfluity also goes by the name of the exclusion of superfluous technological elements. The doctrine omits the obvious additional technical features recorded in the patented independent claims when describing the patented claims and determining the patent right protection, and only considers the necessary and the most significant technical features when determining the patent right protection.

PATENT MISUSE

Under US Patent Law, when patent owners misuse their legal privileges, which generally occurs with utility patents, they interfere with legitimate trade and commerce. For those who are accused of patent infringement, it serves as their first line of defence. The aim of the alleged infringer when facing a lawsuit from a patent holder is to demonstrate that the patent holder is utilising its patent advantages to hinder competition. When a patent holder improperly tries to broaden the patent's purview in a way that has an anti-competitive effect, this is referred to as patent misuse.

A patentee cannot use a patent to get market benefits that go beyond the statutory patent right by violating the prohibition on patent misuse. The defence of patent misuse is not available to a presumed infringement merely because a patentee engages in some type of improper economic conduct, and patent misuse needs more than just aggressive litigation strategies or disagreement as to whether or not an accused product truly infringes.

CASE LAW

B. Braun Med., Inc. vs. Abbott Labs, 124 F.3d 1419, 1426 (Fed. Cir. 1997)

In this case, it was upheld that when the district court enters a declaratory judgment that the patent is unenforceable due to misuse, it could then exercise its discretion to hold a hearing to allow Abbott to state a substantive claim upon which it is entitled to recover damages. In this regard, contrary to the district court's opinion, monetary damages may not be awarded "under a declaratory judgment counterclaim based on patent misuse," because patent misuse simply renders the patent unenforceable. In other words, the defense of patent misuse may not be converted to an affirmative claim for damages simply by restyling it as a declaratory judgment counterclaim. The patent misuse doctrine is an extension of the equitable doctrine of unclean hands, whereby a court of equity will not lend its support to enforcement of a patent that has been misused.

DOCTRINE OF INEQUITABLE CONDUCT

In the United States, this principle is referred to as the duty of candour as mentioned in 37 CFR §1.56 (commonly referred to as Rule 56) and it requires the inventor and anyone else involved in the filing and prosecution of a patent application to disclose to the US Patent and Trademark Office (PTO) all information that they know to be relevant to the patent application in the form of an Information Disclosure Statement (IDS).

They rely on two major principles-

It is crucial to comprehend why these two components are accorded such a high priority. The applicant's arguments are heavily relied upon by the court when a patent application is filed. In this situation, the court is left with little choice but to accept the applicant's arguments as accurate, relevant, and sincere. The overall concept is that the patent applicant and the patent office should have a direct contact. In the *ex-parte* process of patent prosecution, the accuracy and completeness of the filings are not checked or verified by an opposing party. Misrepresentation, failure to disclose anything, and the submission of misleading information are examples of unequal conduct type behaviour.

As the Patent and Trademark Office (PTO) will heavily rely on the statements made by the patent applicant about the issues that will be dealt with in the patent prosecution process, it stipulates rules that the patent applicant discloses material facts of the patent application in good faith and with candour.

Indian Scenario

Section 8 of the Indian Patents Act, 1970 is very similar to the doctrine of inequitable conduct of United States, which requires applicants for Indian patents to submit "full descriptions" of international patent applications that are for the same or essentially the same invention as those being submitted for Indian patents. As long as

specific foreign applications are filed by the claimant, by any person who derives the title from him or by any person from whom the title is derived, such "detailed information" would have to be submitted.

This clause gives The Controller the authority to seek information that corresponds to overseas applications at any time while the Indian patent application is being prosecuted. In the event that international applications are submitted after the declaration and undertaking have been submitted, the applicant must provide the specifics of those applications within six months of the international application's submission.

SUITS CONCERNING INFRINGEMENT OF PATENTS

CHAPTER XVIII deals with suits concerning infringement of Patents

Jurisdiction

Section 104 of the Act provides for jurisdiction in case of infringement. It states no suit for a declaration under section 105 or for any relief under section 106 or for infringement of a patent shall be instituted in any court inferior to a district court having jurisdiction to try the suit:

Provided that where a counter-claim for revocation of the patent is made by the defendant, the suit, along with the counter-claim, shall be transferred to the High Court for decision.

Before dealing with jurisdiction, it may be pointed out that the courts in India receive (a) Patent Administrative Cases and (b) Patent Infringement Cases.

In patent administrative cases, the Indian Patent Office is the defendant. These types of cases include, dispute on grant of a patent, patent invalidation and upholding, and compulsory licensing. In patent Infringement cases, patentee or patent assignees pursue damages against willful Infringement conduct by the alleged infringer. These cases include, Infringement of patent, disputes relating to ownership of patent, disputes regarding patent rights or right for application, patent contractual disputes, contractual disputes of assignment of patent right, patent licensing, and dispute relating to the revocation of patents.

Like any other civil suit the jurisdiction shall be determined in accordance with the rules of Code of Civil Procedure. The appropriate forum would be:

(a) Principal place where the defendant carries on his business; or

(b) Place where the infringing articles are manufactured/ sold or infringing process is being applied or where the articles manufactured by the infringing process are being sold.

Period of Limitation: The period of limitation for instituting a suit for patent Infringement is three years from the date of Infringement.

Burden of proof in case of suits concerning infringement

The traditional rule of burden of proof is adhered to with respect to patented product and accordingly in case of alleged Infringement of a patented product the 'onus of proof' rests on the plaintiff. However, TRIPS-prompted amendment inserted by way of Section 104 (A) has 'reversed burden of proof' in case of Infringement of patented process. Section 104A states that in any suit for infringement of a patent, where the subject matter of patent is a process for obtaining a product, the court may direct the defendant to prove that the process used by him to obtain the product, identical to the product of the patented process, is different from the patented process if,—

a) the subject matter of the patent is a process for obtaining a new product; or

b) there is a substantial likelihood that the identical product is made by the process, and the patentee or a person deriving title or interest in the patent from him, has been unable through reasonable efforts to determine the process actually used:

Provided that the patentee or a person deriving title or interest in the patent from him, first proves that the product is identical to the product directly obtained by the patented process.

In considering whether a party has discharged the burden imposed upon him by sub-section (1), the court shall not require him to disclose any manufacturing or commercial secrets, if it appears to the court that it would be unreasonable to do so.

Power of court to make declaration as to non-infringement

Under section 105, notwithstanding anything contained in section 34 of the Specific Relief Act, 1963, any person may institute a suit for a declaration that the use by him of any process, or the making, use or sale of any article by him does not, or would not, constitute an infringement of a claim of a patent against the patentee or the holder of an exclusive licence under the patent, notwithstanding that no assertion to the contrary has been made by the patentee or the licensee, if it is shown-

a) that the plaintiff has applied in writing to the patentee or exclusive licensee for a written acknowledgment to the effect of the declaration claimed and has furnished him with full particulars in writing of the process or article in question; and

b) that the patentee or licensee has refused or neglected to give such an acknowledgment.

The costs of all parties in a suit for a declaration brought by virtue of this section shall, unless for special reasons the court thinks fit to order otherwise, be paid by the plaintiff.

The validity of a claim of the specification of a patent shall not be called in question in a suit for a declaration brought by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid or invalid.

A suit for a declaration may be brought by virtue of this section at any time after the publication of grant of a patent, and references in this section to the patentee shall be construed accordingly. The validity of a claim of the specification of a patent shall not be called in question in a suit for a declaration brought by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid or invalid.

A suit for a declaration may be brought by virtue of this section at any time after the publication of grant of a patent], and references in this section to the patentee shall be construed accordingly.

Power of court to grant relief in cases of groundless threats of infringement proceedings

Where any person (whether entitled to or interested in a patent or an application for a patent or not) threatens any other person by circulars or advertisements or by communications, oral or in writing addressed to that or any other person, with proceedings for infringement of a patent, any person aggrieved thereby may bring a suit against him praying for the following reliefs, that is to say—

(a) a declaration to the effect that the threats are unjustifiable;

(b) an injunction against the continuance of the threats; and

(c) such damages, if any, as he has sustained thereby.

Unless in such suit the defendant proves that the acts in respect of which the proceedings were threatened constitute or, if done, would constitute, an infringement of a patent or of rights arising from the publication of a complete specification in respect of a claim of the specification not shown by the plaintiff to be invalid, the court may grant to the plaintiff all or any of the reliefs prayed for.

Explanation.—A mere notification of the existence of a patent does not constitute a threat of proceeding within the meaning of this section.

Defences, etc., in suit for infringement

As per Section 107, in any suit for infringement of a patent, every ground on which it may be revoked under section 64 shall be available as a ground for defence.

In any suit for infringement of a patent by the making, using or importation of any machine, apparatus or other article or by the using of any process or by the importation, use or distribution of any medicine or drug, it shall be a ground for defence that such making, using, importation or distribution is in accordance with any one or more of the conditions specified in section 47.

WHAT DOES NOT CONSTITUTE INFRINGEMENT?

Certain acts not to be considered as infringement. They are-

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 for the time being in force, in India, or in a country other than India, that regulates the manufacture, construction, use, sale or import of any product;

2. importation of patented products by any person from a person who is duly authorised under the law to produce and sell or distribute the product, shall not be considered as an infringement of patent rights.

Section 107A in the act incorporates Bolar provision and provision for parallel imports.

What is Bolar Provision?

Bolar provision allows manufacturers to begin the research and development process in time to ensure that affordable equivalent generic medicines can be brought to market immediately upon the expiry of the product patent.

For private, non-commercial use, or to support research or experimentation, the bolar provision, or more precisely the bolar exemption, may be viewed as a particular kind of experimental use exception.

The Bolar Provision is a legal strategy for preventing patent infringement. An innovation is either used or sold by a third party for specific reasons for more study and development after it is created. Due to the implementation of the Bolar rule, generic drug manufacturers who want to grow their business in the market soon after the expiration of the innovator company's patents have the time and opportunity to perform research on the product while the patent is still in effect.

In India, the Bolar provision is comparatively broader than its US equivalent. While the US provision restricts the safe harbour available to generic manufacturers to making, using, offering for sale or selling the patented invention solely for uses that are reasonably related to the development and submission of information under US federal law in the United States only, its Indian counterpart does not specify such territorial limits. Thus, a sale, even if outside India, will fall within the sweep of Section 107A, if it is reasonably related to the development and submission of information required for regulatory approval under the law of the country in which the sale takes place.

CASE LAWS

Roche Products INC. v/s Bolar Pharmaceutical Co. before the Federal Circuit, USA, 1984

The concept was first originated in this case. For the experimental purpose of determining the bioequivalence of their product, with the goal of creating a generic version of the patent product, Bolar used a patented chemical of Roche. Due to a very evident corporate purpose, the Federal Circuit did not recognise this experimental usage. The Hatch Waxman Act, found in 35 U.S.C. 271(e)(1), reads that for utilization sensibly identified with the improvement

and accommodation of data under a Federal Law directing assembling, use, or clearance of medications or veterinary organic items, it would not be a demonstration of encroachment to make, use inside the USA or import into the USA a protected creation... this provision was later known as Bolar provision or Bolar Exception.

Bayer Corporation v. Union of India & Ors., and Bayer Intellectual Property GMBH & Anr v. Alembic Pharmaceutical Ltd., (2019)

In this case, the Court was of the opinion that the interpretation canvassed by Bayer is strained and artificial. Once it is held that patented inventions can be sold for the purpose of carrying on research which fulfils the regulatory requirements of India, there cannot be any bar or an interpretation narrowing the scope of such sale. What is important is the purpose of the sale, i.e. objective of carrying on experiment, research and developing information (in the form of reports, outcomes etc.). If the purpose of the sale is to ultimately exploit the patented invention and either work upon it or "work around" or work it through research so as to be prepared to apply for the patent for approval to market it once the patent tenure ends, there can be no impairment of the patentee's rights.

Section 107-A supports export as a legitimate component of the bolar exemption in accordance with the TRIPS agreement, international standards, and Article 47, 21 of the Indian Constitution. Exporting therefore falls under Section 107-A's "bolar exception" and is allowed for research and clinical trials.

What are Parallel Import Provisions?

Parallel import provisions are provided in section 107 A (b) of the Patents Act, which says that importation of patented products by any person authorized by the Patentee will not be considered as an Infringement. Therefore it is possible to import the patented products from the licensee of the patentee in any country without the permission of the Patentee. The purpose of Parallel import is to check the abuse of patent rights and meant to control the price of patented product.

Unauthorized purchases of non-falsified goods from another nation made by the owner of intellectual property are known as parallel imports. Parallel goods, sometimes known as "grey goods," are involved in international trade and intellectual property issues. The premise behind parallel imports is that all available intellectual property rights have been used. The depletion of intellectual property rights is one of the rights' limitations. The resale, renting, loan, and other contractual uses of IP-protected products on the domestic and international markets shall be governed by the owner when a commodity has been distributed with the consent of the IP owner.

Parallel imports take place when real goods are produced illegally, without the consent of the seller who owns the trademark, patent, or other intellectual property rights over such goods, with the intention of competing with the manufacturer's products which he initially sold internationally at a lower price. Parallel import is the practise of bringing legal goods produced with permission from the owner of the rights into another nation by an unlicensed manufacturer. The lawfulness of parallel imports in the country is decided by the exhaustion regimes adopted by the importing country. It relies greatly on Doctrine of Exhaustion, which varies from country to country.

Doctrine of Exhaustion

According to this doctrine, the owner of the items loses control over further sales once a legal contract has been signed. The owner's exclusive right to sell the intellectual property is "exhausted" after the first sale and cannot be used again in relation to the same domain. This argument claims that the copyright holder will not be able to profit by controlling the delivery and resale of such products after the first selling of the products and adequate payment of the copyright holder. There are still limitations imposed at a certain area on this hypothesis. Although the International Exhaustion Doctrine is specifically supported by Indian trademark and patent law, there is still debate about whether it applies to protected goods.

Global Scenario

Australia: Permits the parallel import of a limited number of goods, with the exception of books, automobiles, and music and programming CDs.

USA: It became legal by creating a reliable point of reference.

Hong Kong: Prior to the modification on July 6, 2007, parallel importation was legal or permitted in Hong Kong under the trademark and copyright laws.

Japan: The sale of reimported CDs is prohibited under the intellectual property rights laws of Japan, and audiovisual products that are marketed for export cannot be sold domestically.

Singapore: Products with copyrights and trademarks may be parallel imported there. Additionally, it facilitates the parallel import of patented goods.

New Zealand: It prohibits the parallel import of patented products.

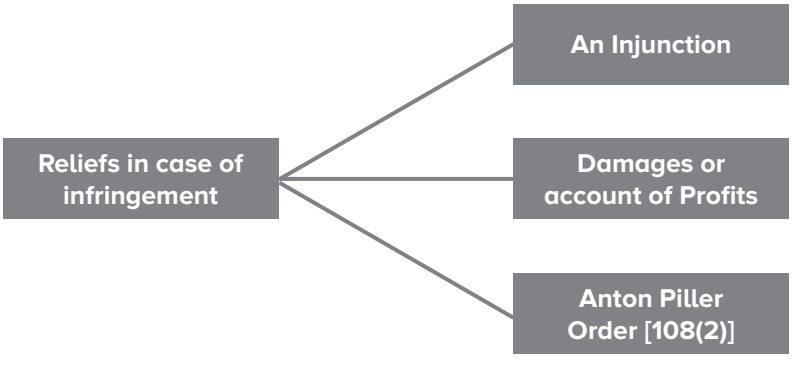
CASE LAW

Merch Sharp & Dohme Corp & Anr v. Sanjeev Gupta & Ors, 2019, CS(COMM) 823/2018

Court held that the argument that manufacture for the purposes of export is not covered by this provision is contrary to a plain textual reading of the provision. On a reasonable reading, "making", "using", "offering for sale", and "selling" of the patented product in India are each covered by Section 48(a) of the Act. The phrase «importing for those purposes» refers to import of the patented product for the enumerated purposes, e.g. using, offering for sale, or selling in India. The certificate of validity of the patent granted by this Court, coupled with several decrees and injunctions protecting the suit patent, lead to a conclusion that the questions of balance of convenience and irreparable injury must also be decided in favour of the plaintiffs.

RELIEFS IN SUITS FOR INFRINGEMENT

As stated earlier, the exclusive rights of a patent holder have been provided protection under the Patents Act, 1970 and in the event of any violation of these rights the patentee can file a suit in the appropriate court. No Infringement action may be started until a patent has been granted. As per Section 108 of the Patents Act, the reliefs which may be awarded in such a suit include–



The court may also order that the goods which are found to be infringing and materials and implement, the predominant use of which is in the creation of infringing goods shall be seized, forfeited or destroyed, as the court deems fit under the circumstances of the case without payment of any compensation.

As is evident the reliefs granted under Section 108 of the Patents Act are inclusive and not exhaustive.

Injunction

An injunction is a specific order of the Court forbidding the commission of a wrong threatened or the continuance of a wrongful course of action already begun, or in some cases (when it is called a 'mandatory injunction') commanding active restitution of the former state of things.

Injunctions are two types - (i) temporary and (ii) permanent.

- **Permanent injunction -** It restrains a party for ever from doing the specified act and the same can be granted only on merits at the conclusion of the trial after hearing both the parties to the suit. It is governed by Sections 38 to 42 of the Specific Relief Act, 1963.
- **Temporary or interim injunction -** It restrains a party temporarily from doing the specified act and can be granted until the disposal of suit. It is regulated by the provisions of Order 39 of the Code of Civil Procedure and it may be granted at any stage of the suit. Injunctions are preventive, prohibitive or restrictive i.e. when they prevent, prohibit or restraint someone from doing some thing or mandatory, i.e. when they compel, command or order some persons to do something.

In the case of patent Infringement, the plaintiff can obtain interlocutory order in the form of temporary injunction from the court by proving the existence of the following facts:

(a) A prima facie case of Infringement

(b) Balance of convenience is tilting in his/herfavour

(c) If injunction is not granted he/she shall suffer irreparable damage

CASE LAWS

F. Hoffmann-La Roche Ltd. and Anr. v. Cipla Limited, [2008 (37) PTC 71 (Del.)].

In this case, the plaintiffs filed a suit praying for permanent injunction restraining defendant from infringing its patent in respect of anti-cancer drug "Tarceva". The case acquired significance for the very reason that it was the first case in which the court considered the aspect of "pricing" of the drug in deciding on the interim injunction. The Court in this case laid down several crucial principles as follows:

(i) In patent Infringement actions, the courts should follow the approach indicated in American Cyanamid case, by applying all factors;

(ii) The courts should follow a rule of caution, and not always presume that patents are valid, especially if the defendant challenges it; and

(iii) The standard applicable for a defendant challenging the patent is whether it is a genuine one, as opposed to a vexatious defense. Only in the case of the former, the court will hold that the defendant has an arguable case.

The court was of the opinion that as between the two competing public interests, i.e. the public interest in granting an injunction to the patentee, as opposed to the public interest in access to a life saving drug for the people, the balance has to be tilted in favor of the latter. The court also opined that the patients in India can ill- afford high priced imported versions of the drug like "Tarceva".

Aggrieved by the decision of the single judge, Roche went in appeal. Dismissing the appeal, the Division Bench held that Roche failed to establish a prima facie case in its favor in view of the fact that a serious

challenge to the validity of the patent in suit was raised. It was also held that Roche failed to make a full disclosure of the facts.

The court imposed heavy costs quantified at `Rs.5 Lakhs to be paid by Roche to Cipla. The court however, restrained Cipla from exporting its drug to countries where Roche had a patent during the pendency of the case.

Novartis AG and Anr v. Mehar Pharma and Anr, 2005(30) PTC (Bom),

In this case, the court refused to grant temporary injunction on the ground that the validity of a recent patent was challenged. The power to grant temporary injunction is at the discretion of the court. The discretion is to be exercised reasonably, judiciously and on sound legal principles.

Mareva Injunction

It refers to injunctions that prohibits the Defendant from taking assets out of the country or from using them or disposing of them in a way that would make the Plaintiff's enforcement of the decree, if one were to be granted, a simple brutum fulmen (an ineffectual legal judgment).

In India, Mareva injunctions may be granted in accordance with Order 38 Rules 5 and 6 or Order 39 Rule 1 of the CPC. The requirements for obtaining a Mareva order, which is essentially an interlocutory injunction, are similar to those for obtaining any interim injunction: a *prima facie* case, the balance of convenience, and irreparable harm. The exact requirements have been spelled out in detail over time and include:

1. A cause of action must exist at the moment the order is to be granted, and the plaintiff must have a solid argument.
2. The Defendant must possess assets that are subject to the Court's authority.
3. The plaintiff must be granted the injunction if the balance of convenience favours her.
4. The Plaintiff must demonstrate that the Defendant lacks probity and that there is a genuine danger of wealth dissipation.
5. There hasn't been a delay in submitting the injunction application.

CASE LAWS

Mareva Compania Naviera SA and International Bulkcarriers SA, [1980] 1 All ER 213

Mareva Injunction was first issued in this case. In this case, the Defendants were prohibited from using their funds in Bank of London to pay the Plaintiff's claims, should they be able to establish them, according to an order that the Court of Appeal granted the Plaintiffs on an ex-parte motion.

Raman Tech. & Process Eng. Co. v. Solanki Traders Appeal (Civil) 6171 of 2001

The Supreme Court in this case defined the nature and boundaries of the injunction, emphasising that it should only be applied in limited circumstances and with strict adherence to the law in order to protect the Plaintiff's and Defendant's rights. It is not intended to be utilised by the Plaintiff as a means of turning his unsecured debt into a secured one, as a means of pressuring the Defendant into settling, or as a means of giving the Plaintiff priority over the Defendant's assets. Also, the defendant's ability to conduct business should not be impacted without adequate proof. Mareva injunctions are typically given earlier in the process, but even if they are, they are still considered interlocutory because they simply provide supplementary relief to the primary or substantive relief and are not final.

Damages and Accounts for Profits

Once the suit is decided in favour of the plaintiff, the court can either award damages or direct the defendant to render an account of profits. The two remedies are alternative and not concurrent in nature. Some express limitations have been imposed on the grant of this relief. The court shall not grant damages or account of profits in the following cases:

(a) Where the defendant proves that at the date of the Infringement he was not aware and had no reasonable grounds for believing that the patent existed.

(b) Where an amendment of a specification had been allowed after the publication of the specification, and the Infringement action is in respect of the specification before the date of publication unless the court is satisfied that original specification was made in good faith and with reasonable skill and knowledge.

This right to obtain provisional damages requires a patent holder to show the following:

(i) The infringing activities occurred after the patent application was published;

(ii) The patented claims are substantially identical to features of the process or the product infringing the patent; and

(iii) The infringer had actual notice of the published patent application.

CASE LAW

Biswanath Prasad Radhey Shyam vs. Hindustan Metal Industries. AIR SC 1978.

The Supreme Court of India has laid down the following guidelines to determine Infringement of a patent based on the above case. They are-

(i) Read the description and then the claims;

(ii) Find out what is the prior art;

(iii) What is the improvement over the prior art;

(iv) List the broad features of the improvement;

(v) Compare the said broad features with the defendant's process or apparatus;

(vi) If the defendant's process or apparatus is either identical or comes within the scope of the plaintiff's process or apparatus, there is an infringement.

Anton Piller Order

The Anton Piller order is frequently referred to as the legal plaintiffs' nuclear weapon. The reason for this is because this remedy is quite strong and provides an immediate, one-step solution to the issue of the plaintiff's IP infringement. They are a type of evidence preservation civil search warrant. In order to locate and preserve evidence that it fears might otherwise be lost, the offended party rushes to court and requests an examination and unannounced search of the alleged wrongdoer's property. By use of this *ex-parte* order, a Court Commissioner may be appointed to go to the defendant's property, search it, and confiscate any infringing products.

The order is made without consulting the alleged wrongdoer or the opposing party in order to preserve the element of surprise and guarantee the preservation of necessary evidence.

CASE LAWS

Anton Piller KG vs. Manufacturing Process, (1976) 1 All ER 779

In this case, first ever Anton Pillar Orders were issued. Court distinguished the remedy from regular search warrants by requiring serving of orders and the Defendant's consent and established the legal framework.

This type of order was recognised and given the term Anton Pillar Orders as a result of this case.

Essentials to be considered while considering issue of Anton Piller Order-

1. The Plaintiff must have a strong prima facie case;
2. The potential or actual damage must be of a serious nature;
3. The Defendants must be shown to have incriminating documents or items in their possession, and there must be clear evidence that they may destroy such evidence before further legal action is taken against them; and
4. The issuance of such an order must not harm the Defendant or his case.

The form of the order makes it plain that the court is not ordering or granting anything equivalent to a search warrant. The order is an order on the defendant in personam to permit inspection. It is therefore open to him to refuse to comply with such an order, but at his peril either of further proceedings for contempt of court - in which case, of course, the court will have the widest discretion as to how to deal with it, and if it turns out that the order was made improperly in the first place, the contempt will be dealt with accordingly - but more important, of course, the refusal to comply may be the most damning evidence against the defendant at the subsequent trial.

Bucyrus Europe Ltd. vs. Vulcan Industries Engineering Co Pvt Ltd., 2005 (30) PTC 279

In this case, Court held that such an order can be passed in the following situations :

(i) where the plaintiff has an extremely strong prima facie case,

(ii) where the actual or potential damage to the plaintiff is very serious, and

(iii) where it was clear that the defendant possessed vital evidence,

(iv) there was a real possibility that the defendant might destroy or dispose of such material so as to defeat the ends of justice, and

(v) the purpose of Anton Filler order is the preservation of evidence.

Before passing an Anton Filler order, some safeguards are also to be observed like asking the plaintiff to give an undertaking in damages in case the plaintiff is wrong and the defendant suffers damages as a result of the execution of the order. However, before the Court will grant an Anton Filler order, the plaintiff must be able to convince the Court that he has a strong case and that the order is indeed essential to the ends of justice.

John Doe Order or Ashok Kumar Order

A John Doe order is a kind of pre-infringement injunction intended to protect the author's IP rights in creative works like music and movies. The John Doe order is also known as the Rolling Anton Pillar, Anton Pillar, or Ashok Kumar order. The Court of Queen's Bench in the United Kingdom created the idea of a John Doe order as an extraordinary equitable remedy where an injunction order is issued against an unidentified defendant, enabling the plaintiff to search and seize the infringer's establishments with the intention of preserving evidence that might be disfigured.

In order to keep up with novel issues, the John Doe order concept has evolved throughout time. In India, intellectual property rights have been recognized as protecting the rights of people who invest in research and development, and the government has passed many laws to safeguard the rights of investors and researchers, including the Copyrights Act of 1957 and the Patent Act of 1970.

Indian Scenario (Ashok Kumar Orders)

When the defendants are primarily unidentified, the "John Doe order," also known as the "Ashok Kumar order" in India, is made. Actions are taken to restrain such unidentified persons. While the conventional practise was that such defendants' specifics should be known, Order 39 Rule 2 of the Civil Procedure Code, when read in conjunction with Section 151 of the CPC and covered by the Specific Relief Act of 1963, gives the Court the authority to make such an order.

The order invokes *quia timet* meaning 'because he fears' injunctions once it has been passed. As a result, quia timet is reiterated, and it is emphasized that one should never forget their rights, even when it is clear that they will be infringed. A *quia timet* remedy enables the person that has been wronged to defend its intellectual property rights before the actual violation occurs.

CASE LAW

Taj Television Ltd. and ors. vs. Rajan Mandal and ors. ([2003] F.S.R. 22),

The Hon'ble Delhi High Court issued the first-ever John Doe decision prohibiting the streaming of the FIFA World Cup by unlicensed cable providers. The first ex-parte interim order, known as John Doe's/Ashok Kumar's order, was issued, enabling the plaintiff to search and seize the tools and devices of unidentified defendants. This was the beginning of the practise of issuing orders against unidentified defendants. Also, a injunction order was issued against unidentified parties who might be in a position to violate the plaintiff's legitimate rights.

Conditions to pass John Doe Order

In India, courts issue John Doe orders in compliance with Order 39, Regulations 1 and 2 of the Civil Procedure Code, 1908 (CPC), as well as Section 151 of the CPC and the Specific Relief Act, 1963's provisions relating to permanent injunctions. The Court can only issue a John Doe order if certain conditions are satisfied.

The following are some of the conditions that have been mentioned in various legal rulings:

- A prima facie case must be established by the plaintiff(s).
- The plaintiff(s) must also show that if the John Doe order is not passed, he or she will suffer real or probable damage or irreparable losses.
- The plaintiff should win on the balance of convenience.

Norwich Pharmacal Order

These order maybe passed if a third party has unintentionally become involved in the matter at hand, the Norwich Pharmacal Order may be made against them to compel them to produce pertinent information and documents. Bringing such individuals to their attention increases the likelihood, if not the certainty, of the papers and information that must be released. These records assist the Court in reaching a decision when an Applicant files a lawsuit against others who are alleged to have participated in wrongdoing against the Applicant.

This order is only issued when it is thought to be in the interests of justice. The two most frequent uses of it are to determine who makes for the best defendant or to gather evidence to support a claim. Information may be obtained at any point during a court case, but it cannot be used to influence proceedings in another country.

Illustration

In a matter between A and B organizations Z may be able to provide information pertaining to it if Z is connected to a case involving A and B in any manner but is not actually a likely participant in the case. Then this order can be issued fir fishing of such information

CASE LAW

Norwich Pharmacal Co. vs. Customs and Excise Commissioners, 1974

First Norwich Pharmacal Order was issued in this case. In this case, the proprietor and exclusive licensee of a patent. Herein unidentified importers of the substance into the UK violated the exclusivity of patent.

The Norwich Pharmacal Co. filed a lawsuit against the Excise Commissioners to compel the production of information that would reveal the chemical's importer and, consequently, those who violated the patent.

According to the House of Lords, a judge could order an innocent third party to help the person who is experiencing harm by providing them with information about illegal behaviour if they have knowledge of it. Due to the legal precedent set by the case, disclosure orders against innocent third parties are now referred to as Norwich Pharmacal orders in the UK.

Right of Exclusive Licensee to take Proceedings against Infringement

Exclusive licensee is a legal person who has been granted a license or a permission to use patent to the exclusion of all others, including the patentee. Under the Act, the exclusive licensee shall have the like right as the patentee to institute a suit in respect of any Infringement of the patent.

In awarding damages or an account of profits or granting any other relief in any such suit, the court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee or, the profits earned by means of the Infringement so far as it constitutes an Infringement of the rights of the exclusive licensee as such.

In any suit for Infringement of a patent by an exclusive licensee, if the patentee does not join as plaintiff, he is added as a defendant, but a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. [Section 109]

Right of licensee under section 84 to take proceedings against infringement

According to Section 110, any person to whom a licence has been granted under section 84 shall be entitled to call upon the patentee to take proceedings to prevent any infringement of the patent, and, if the patentee refuses or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as though he were the patentee, making the patentee a defendant; but a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

Restriction on power of court to grant damages or account of profits for infringement

According to Section 111, in a suit for infringement of a patent, damages or an account of profits shall not be granted against the defendant who proves that at the date of the infringement he was not aware and had no reasonable grounds for believing that the patent existed.

Explanation.—A person shall not be deemed to have been aware or to have had reasonable grounds for believing that a patent exists by reason only of the application to an article of the word “patent”, “patented” or any word or words expressing or implying that a patent has been obtained for the article, unless the number of the patent accompanies the word or words in question.

In any suit for infringement of a patent the court may, if it thinks fit, refuse to grant any damages or an account of profits in respect of any infringement committed after a failure to pay any renewal fee within the prescribed period and before any extension of that period.

Where an amendment of a specification by way of disclaimer, correction or explanation has been allowed under this Act after the publication of the specification, no damages or account of profits shall be granted in any proceedings in respect of the use of the invention before the date of the decision allowing the amendment, unless the court is satisfied that the specification as originally published was framed in good faith and with reasonable skill and knowledge.

Nothing in this section shall affect the power of the court to grant an injunction in any suit for infringement of a patent.

Relief for infringement of partially valid specification

As per Section 114, if in proceedings for infringement of a patent it is found that any claim of the specification, being a claim in respect of which infringement is alleged, is valid, but that any other claim is invalid, the court may grant relief in respect of any valid claim which is infringed:

Provided that the court shall not grant relief except by way of injunction save in the circumstances mentioned in sub-section (2).

Where the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the court shall grant relief in respect of any valid claim which is infringed subject to the discretion of the court as to costs and as to the date from which damages or an account of profits should be reckoned, and in exercising such discretion the court may take into consideration the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there.

Scientific advisers

Section 115 states that in any suit for infringement or in any proceeding before a court under this Act, the court may at any time, and whether or not an application has been made by any party for that purpose, appoint an independent scientific adviser to assist the court or to inquire and report upon any such question of fact or of opinion (not involving a question of interpretation of law) as it may formulate for the purpose.

The remuneration of the scientific adviser shall be fixed by the court and shall include the costs of making a report and a proper daily fee for any day on which the scientific adviser may be required to attend before the court, and such remuneration shall be defrayed out of moneys provided by Parliament by law for the purpose.

POWER OF CONTROLLER IN CASE OF POTENTIAL INFRINGEMENT

Section 19 of the Patent Act, 1970 provides that -

(1) If, in consequence of the investigations required under this Act, it appears to the Controller that an invention in respect of which an application for a patent has been made cannot be performed without substantial risk of Infringement of a claim of any other patent, he may direct that a reference to that other patent shall be inserted in the applicant's complete specification by way of notice to the public, unless within such time as may be prescribed—

  (a) The applicant shows to the satisfaction of the Controller that there are reasonable grounds for contesting the validity of the said claim of the other patent; or

  (b) The complete specification is amended to the satisfaction of the Controller.

(2) Where, after a reference to another patent has been inserted in a complete specification in pursuance of a direction under sub-section (1)—

  (a) That other patent is revoked or otherwise ceases to be in force; or

  (b) The specification of that other patent is amended by the deletion of the relevant claim; or

  (c) It is found, in proceedings before the court or the Controller, that the relevant claim of that other patent is invalid or is not infringed by any working of the applicant's invention, the Controller may, on the application of the applicant, delete the reference to that other patent.

Review of Controllers' Decision (Procedure)

The statute provides for review of the Controller's decision under section 77 of the Patents Act 1970. The applicant need to file Form 24 within the time limits prescribed in Rule 130. The Controller shall act in accordance with the prescribed norms under Rule 130 and decide that matter on the merit of each case. The Controller, in any proceeding before him under the Patents Act, 1970, shall have the powers of a civil court while trying a civil suit under Code of Civil Procedure, 1908 (5 of 1908). The review under section 77 is dealt in the like manner.

Who may file the review Petition?

Any person considering himself aggrieved—

- by a decree or order from which an appeal is allowed, but from which no appeal has been preferred,
- by a decree or order from which no appeal is allowed.

Grounds for review:

- Discovery of new and important matter or evidence which, after the exercise of due diligence was not within petitioner's knowledge or could not be produced by him at the time when the decree was passed or order made,or
- on account of some mistake or error apparent on the face of the record, or
- for any other sufficient reason.

A party who is not appealing from a decree or order may apply for a review of judgment notwithstanding the pendency of an appeal by some other party except where the ground of such appeal is common to the applicant and the appellant, or when, being respondent, he can present to the Appellate Court, the case on which he applies for the review.

CASE LAWS

Biomoneta Research Pvt. Ltd. vs. Controller General of Patents Designs and Anr. C.A.(COMM. IPD-PAT) 297/2022 (dated 13.03.2023)

Facts-

An appeal was filed by Biomoneta Research Pvt. Ltd (appellants) against the impugned order wherein the application for grant of a patent titled 'Air Decontamination Assembly' bearing Application No. 201741016833, filed on 12th May, 2017 (hereinafter 'subject patent'), under Section 15 of the Patents Act, 1970 (hereinafter 'the Act') was refused on the ground that the claimed subject matter of the subject patent does not constitute an invention under Section 2(1)(j) of the Act.

The Appellant company claims to be a start-up recognized by the Biotechnology Industry Research Assistance Council (BIRAC) and supported by the Department of Biotechnology, Government of India and the Karnataka State Government for various innovative products and has gotten numerous award and recognition for their product.

The Appellant filed the request for examination vide RQ No. E20194003817 dated 7th February, 2019 under rule 24B of the Rules. Thereafter, the subject patent was examined under Section 12 and 13 of the Act. The First Examination Report ('FER') with the statement of objections was issued on 7th February, 2019. The primary objections raised by the FER were in relation to lack of inventive step under Section 2(1)(ja) of the Indian Patents Act, 1970 and insufficiency of disclosure and definitiveness in the claims.

Issue-

Patent Application was rejected on the grounds of lack of inventive step and definitiveness.

Judgement-

Court stated that the subject invention is not a mere addition to a well-known combination, but it has some new features and is an improvement in the method which has brought in greater efficiency. In such inventions, the EPO guideline which deal with combination vs juxtaposition or aggregation would be relevant. The invention claimed must normally be considered as a whole. When a claim consists of a 'combination of features', it is not correct to argue that the separate features of the combination taken by themselves are known or obvious and that 'therefore' the whole subject matter claimed is obvious. In other words, the interactions of the individual features must produce a synergistic effect.

Court held that "it is a settled position in law that secondary considerations by themselves may not qualify an invention to become patentable but when a set of old results are combined in a new and profitable manner, a patent can be granted. Lack of inventive step requires a person skilled in the art to be able to 'jump' from the existing prior art to the subject invention. There is nothing on record to establish that this 'jump' could have been achieved on the priority date, especially because even the controller arrives at the finding of lack of inventive step upon a combination of D1, D2 and D3. The differences between the prior arts & the subject invention lead to a finding of inventive step rather than its absence."

During the ongoing proceeding USPTO has granted Patent to the said invention numbered as US11565017B2 on 31st January, 2023, thereby strengthening the appellant's case that its innovation is not hit by the prior to art documents. Accordingly, the impugned order is set aside and the patent application is directed to proceed for grant."

Strix Ltd vs. Maharaja Appliances Limited, CS(COMM) 403/2018 and CC 54/2009, Delhi High Court dated 20.10.2023

Facts-

The Plaintiff - Strix Limited has filed the present suit in 2009, for permanent injunction restraining infringement of patent IN 192511/95, delivery up, rendition of accounts and damages. The Defendant - Maharaja Appliances Limited has filed a counter - claim challenging the validity of the Plaintiff's patent IN 192511/95 and seeking revocation of the Patent.

The Plaintiff incorporated in 1915, is engaged in the manufacture and sale of temperature control systems and cordless interfaces for kettles, jugs and a wide range of water boiling appliances. It claims to be a leading manufacturer of the same, selling to over 40 countries at the time of filing of the present suit. It is stated that the Plaintiff's temperature control systems are used over one billion times a day worldwide by over 20 per cent of the population across the globe. The claim of the Plaintiff is that these control systems are used with heating elements in various household appliances including kettles. The control systems help in switching off when the water boils in the kettles in order to protect the same from damage.

It is submitted that the STRIX U10 Series controls were first sold by the Plaintiff in 1996. The Plaintiff's controls are claimed to be used by various brands such as Philips, Tefal, Rowenta, Morphy Richards, Russell Hobbs, Braun, Kenwood, Bosch, Siemens etc.

The Plaintiff applied for a patent in India through the PCT route and was granted Patent No. 192511/95 in respect of 'Liquid heating Vessels' on 11th November, 2005 (hereinafter, 'Suit Patent') claiming priority from an U.K Application dated June 9, 1994. The Suit Patent is valid for a period of twenty years from the date of application, i.e. till 8th June, 2015.

The case of the Plaintiff is that the invention in the Suit Patent has been used by the Plaintiff since 2002. The principal claim of the Suit Patent is that of a liquid heating vessel comprising a liquid receiving container and an electrical heating element provided in thermal contact, with the base of the container.

In other words, the patented controls work based on sensing the temperature of the element, the element gets switched off once a certain temperature is reached.

Judgement-

It is submitted by the Plaintiff that the patented control has been sold by it to the Defendant itself in the years 2005-2006. The same is reflected by the documents and email correspondence between the parties, which have been placed on record. The Plaintiff claims to have then come across a kettle under the name 'Maharaja Whiteline Model No. EK 172' which had an identical temperature control system used in it.

Court stated that-

It is the settled position in law that in order to establish infringement all that is required is to compare the granted claims of the suit patent with the Defendant's product. The same has been held in Sotefin SA v. Indraprastha Cancer Society and Research Centre (2022:DHC:595), the relevant part of the same is as under:

For patent infringement analysis, comparison of elements of the suit patent's claims is to be done with the elements/ claims of the infringing product. On comparison, there can be a case of non-literal infringement, where each and every component of patent specification is not found in the infringing products. In other words, all the elements of a claim may not entirely correspond in the infringing product, as has been pointed by the experts, in the instant case. However, it does not inevitably mean that there can be no infringement. It is the pith and marrow of the invention claimed that is required to be looked into, and we do not have to get lost into the detailed specifications and do a meticulous verbal analysis which the parties have engaged into the Court.

The critical question is whether the elements not found in the Smart Dollies, are essential or not, so as to construe an infringement. For determining the question of infringement, it must be borne in mind that the non-essential or trifling variations or additions in the product would not be germane, so long as the substance of the invention is found to be copied. Pure literal construction is not be adopted, rather, doctrine of purposive construction should be applied. The court shall also apply Doctrine of Equivalence to examine if the substituted element in the infringing product does the same work, in substantially the same way, to accomplish substantially the same result."

It is the settled position in law that damages are of three kinds i.e., notional damages, compensatory damages, and punitive damages. In the judgement of *Hindustan Unilever Limited vs. Reckitt Benckiser India Limited MANU/DE/0353/2014*, on the aspect of award of punitive damages in civil cases, the ld. division bench of this Court has held as under:

"With due respect, this Court is unable to subscribe to that reasoning, which flies on the face of the circumstances spelt out in Rookes and later affirmed in Cassel. Both those judgments have received approval by the Supreme Court and are the law of the land. The reasoning of the House of Lords in those decisions is categorical about the circumstances under which punitive damages can be awarded. An added difficulty in holding that every violation of statute can result in punitive damages and proceeding to apply it in cases involving economic or commercial causes, such as intellectual property and not in other such matters, would be that even though statutes might provide penalties, prison sentences and fines (like under the Trademarks Act, the Copyrights Act, Designs Act, etc) and such provisions invariably cap the amount of fine, sentence or statutory compensation, civil courts can nevertheless proceed unhindered, on the assumption that such causes involve criminal propensity, and award "punitive" damages despite the plaintiffs inability to prove any general damage. Further, the reasoning that "one function of punitive damages is to relieve the pressure on an overloaded system of criminal justice by providing a civil alternative to criminal prosecution of minor crimes" is plainly wrong, because where the law provides that a crime is committed, it indicates the punishment. No statute authorizes the punishment of anyone for a libel-or infringement of trademark with a huge monetary fine-which goes not to the public exchequer, but to private coffers. Moreover, penalties and offences wherever prescribed require the prosecution to prove them without reasonable doubt. Therefore, to say that civil alternative to an overloaded criminal justice system is in public interest would be in fact to sanction violation of the law. This can also lead to undesirable results such as casual and unprincipled and eventually disproportionate awards. Consequently, this court declares that the reasoning and formulation of law enabling courts to determine punitive damages, based on the ruling in Lokesh Srivastava and Microsoft Corporation v. Yogesh Papat and Another, MANU/DE/0331/2005 : 2005 (30) PTC 245 (Del) is without authority. Those decisions are accordingly overruled. To award punitive damages, the courts should follow the categorization indicated in Rookes (supra) and further grant such damages only after being satisfied that the damages awarded for the wrongdoing is inadequate in the circumstances, having regard to the three categories in Rookes and also following the five principles in Cassel. The danger of not following this step by step reasoning would be ad hoc judge centric award of damages without discussion of the extent of harm or injury suffered by the plaintiff, on a mere whim that the defendant's action is so wrong that it has a "criminal" propensity or the case merely falls in one of the three categories mentioned in Rookes (to quote Cassel again-such event "does not of itself entitle the jury to award damages purely exemplary in character")."
Thus, the ld. Division Bench categorically holds that punitive damages cannot be awarded in such cases.

Indoco Remedies Ltd vs. Bristol Myers Squibb Holdings, CM APPL. 16257/2020 in FAO(OS) (COMM) 3/2020 & CM APPL. 602/2020

Facts:

Bristol Myers Squibb Holdings Ireland Unlimited Company (hereinafter referred to as "Bristol Myers"), alleging infringement, by the applicant, of Indian patent "IN 247381" (hereinafter referred to as "IN 381"), granted to Bristol Myers, in respect of "Lactam-Containing Compounds and Derivatives thereof, as Factor Xa Inhibitors". Bristol approached Delhi HC in 2019 requesting an ad-interim injunction against Indoco Remedies (Indoco) for infringing their patent and producing a generic form of the drug called "APIXABID".

The medicine had already been made (58,000) strips when Indoco applied to the court in 2020 for permission to distribute them on the grounds of "public interest," particularly during the COVID 19 pandemic.

Indoco said that the medication was substantially less expensive than Bristol Myers' medication while still being crucial for treating COVID 19.

According to Bristol Myers, Indoco only produced these strips in anticipation of the injunction, and the sale of them cannot be permitted because there has been obvious violation. They also argued that, given the "public interest," a mandatory licence would be the best course of action.

Held:

Court stated that -

"There is a shortage of Apixaban, and that the drug is needed for COVID-2019 treatment, that cannot empower us to allow clearing of products which infringe the patent of Bristol Myers and, thereby, allow violation of the injunction granted by the learned Single Judge vide her order dated 24th December, 2019, without returning a finding, in the first instance, that the order is prima facie, unsustainable on merits. Grant of interlocutory relief, it is well settled, requires cumulative satisfaction of three indicia of existence of a prima facie case, balance of convenience and irreparable loss to the person seeking interim injunction, were injunction not to be granted.

We are not satisfied that, even cumulatively, the material discloses any such overwhelming public interest, as would justify the grant of the reliefs prayed in the application. Not an iota of material, indicating shortage of "APIXABAN", qua the requirements of patients in need of the drug, or of the product of the Bristol Myers being prohibitively priced, or, for that matter, not being reasonably affordable, has been placed on record. It has been contended, emphatically, that the plea of shortage, forming one of the main planks of the reasoning of the applicant, is entirely artificial and unsupported by evidence, and we are persuaded to agree with the submission. It is also noteworthy in this regard that the applicant has not placed, on record, any notification, or other official release, by the Government, to indicate that there was a shortage of Apixaban in the market.

Even on the issue of maintainability, we are satisfied that the prayers in the application cannot be granted, we have, additionally, examined the plea of urgency and public interest, but find no merit, whatsoever, therein"

BAJAJ Auto Limited vs. TVS Motor Company Limited JT 2009 (12) SC 103

Facts:

Bajaj Auto Ltd. (Appellants) filed a lawsuit under the Indian Patents Act of 1970 against TVS Motors Pvt. Ltd. (Respondents) before the Madras High Court's single bench for the infringement of its patent no. 195904, which relates to twin spark plug engine technology in motor vehicles. In order to prevent the respondent from violating the monopoly rights granted by the Indian Patents Act, 1970, the appellant claimed that the respondent had been granted a perpetual injunction. In order to prevent the respondents from continuing to violate the appellants' patents while the lawsuit is pending, the appellants filed a request for an interim injunction against them. The introduction of TVS Flame was halted when the learned judge of a single bench issued an interim injunction prohibiting the respondents from continuing to infringe the appellant's patent. The respondents appealed the contested interim order to the Madras High Court divisional bench, which the divisional bench properly accepted. The Court of Justice Markandey Katju and Justice Ashok Kumar Ganguly of the Hon'ble Supreme Court of India received a Special Leave Petition (SLP) according to Article 136 of the Indian Constitution.

Issues:

- Whether the patent of Bajaj Ltdw as infringed by TVS.?
- Can patented technology that has undergone advancements be utilised without violating the original patent?

Held:

Court stated that -

"It is those novel features only that he claims to be essential that constitute the so-called "pith and marrow" of the claim. A patent specification should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge.

The question in each case is: whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular descriptive word or phrase understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it could have no material effect upon the way the invention worked.

As far as the application of the concept of pith and marrow of the claim, what is stated is that novel feature which is claimed to be essential would constitute the pith and marrow. The novel feature in the invention of the Respondent based on patent No.195904 dated 16.07.2002, varies in very many respects in the novel feature of the Appellant's product based on patent No.196636 dated 25.05.2000.

Such a distinction as between the patented claim and the infringed product is well protected under the provisions of the Patents Act, as has been set out in the various decisions we have no hesitation in holding that in the case on hand, even while holding that the claim of valid patent at the instance of the Respondent can be prima facie accepted, the alleged infringement as against the Appellant cannot be held to have been made out at the instance of the Respondent. Therefore, there is no case made out for grant of interim injunction."

Bayer Corporation vs. Union of India, 162 (2009) DLT 371

Facts:

The Indian Patent Office awarded a patent to Bayer Company (Plaintiff) in 2008 for its cancer medicine "Sorafenib Tosylate," which is used to treat liver and kidney cancer. The Drug Controller of India (Defendants) subsequently issued the first-ever Compulsory License to Natco Pharma in 2012 so that it may create a generic version of this medication. The medicine was being sold by the plaintiff for Rs. 2,80,000 each month for a course, and the defendant pledged to simply make it available for Rs. 8,800. Plaintiff filed a request for a stay of the licence with the Intellectual Property Appellate Board (IPAB), claiming that the licence granted by the DGCI was defective, illegitimate, and unsustainable. Plaintiff was upset that Natco had received a Compulsory License. The IPAB, however, denied the plaintiff's appeal, concluding that the license's reduced price points that made it more accessible to individuals meant that it had been granted in the public interest.The plaintiff then appealed the decision to the Bombay High Court (HC).

Issue:

Whether the DGCI's License was given in line with the Patent Act's rules?

Held:

Court stated that -

"Cipla rightly states that it will use its own brand name and label and therefore there is no question of manufacturing a drug under a name which belongs to another drug. Further, the terms "imitation" and "substitute" occurring in Section 17 B (b) DCA should be read in conjunction with the other words «in a manner likely to deceive». This envisages a situation where a generic manufacturer is passing off its drug as that of the patent holder by way of deception. Cipla states that it is not trying to pass off its drug as that of the appellant. It would be stretching the language of Section 17B (b) DCA to an impermissible limit to hold that all generic versions of patented drugs, for which marketing approval is sought from the DCGI in terms of the DCA, should be considered to be 'spurious' drugs.

Much emphasis was laid on Section 2 DCA to suggest that this provision requires the DCGI to account for the Patents Act since the provisions of the DCA are expressly stated to be «in addition to, and not in derogation of, any other law for the time being in force». This submission proceeds on a misconception that the DCGI is required to account for the provisions of the Patents Act. The reference to Section 156 of the Patents Act which states that «a patent shall have to all intents the like effect as against Government as it has against any person», does not mean that the DGCI has to enforce and protect the patent for the product, in respect of which marketing approval is sought, from being infringed. Section 156 only states that the government cannot also infringe a patent. It is a negative obligation on the government not to infringe. It creates no duty or positive obligation on the central government, or any department thereof, to protect a patent from infringement.

Therefore, by accepting Bayer's contention that every generic drug would be a spurious drug, this court would be subjecting manufacturers of generic versions of patented drugs to prosecution under the DCA although the Patents Act does not provide for such a consequence. This is yet another reason why the attempt at bringing in patent linkage on the basis of the existing provisions of the Patents Act and the DCA cannot be countenanced."

Novartis AG vs. Union of India (UOI) and Ors. (01.04.2013 - SC) : AIR 2013 SC 1311

Facts:

The pharmaceutical behemoth Novartis, applied for a patent on the anticancer medication Glivec in 1997 on the grounds that it had developed the beta crystalline salt form (imatinib mesylate) of the free base imatinib. Glivec is used to treat chronic myeloid leukaemia (CML) and gastrointestinal stromal tumours (GIST). It is a life-saving medication that is protected by patents in around 35 nations worldwide. Yet, India at the time did not give a patent to agrochemical and pharmaceutical items. According to the TRIPS agreement, the drug products in India become the subject of a patent in the year 2005. Following this, India updated its patent law and began issuing patents for pharmaceutical products.

The Madras Patent Office rejected Novartis's patent application in 2006 for the medicine Glivec on the grounds that the drug's pre-existing version, which was already patented outside of India, did not significantly improve upon its therapeutic performance. A known chemical may only be copyrighted if its new forms demonstrate "improved efficacy," according to Section 3(d) of the Indian Patents (Amendment) Act, 2005, which served as the foundation for the aforementioned decision. The Patent Office determined that the medicine Glivec could not be patented under Section 3(d) of the 2005 Act since it did not exhibit any improved efficacy.

Novartis submitted two writ petitions to the High Court of Madras under Article 226 of the Indian Constitution, one appealing the Madras Patent Office's decision to deny its request for a patent and the other contesting Section 3(d) of the Indian Patents Act as being in violation of TRIPS, vague, arbitrary, and Article 14 of the Constitution. The Madras High Court denied Novartis' Writ Petitions, ruling that it lacked the authority to assess whether a domestic statute violated an international treaty and, hence, could not evaluate whether Section 3(d) complied with TRIPS. Regarding Section 3(d), the Amending Act's goals were to prevent evergreening and give residents convenient access to life-saving medications. As a result, it cannot be regarded as ambiguous and arbitrary.

The Intellectual Property Appellate Board—an appellate authority for the patent controller—began the new phase of the legal dispute. IPAB refused to grant a patent to the medication Novartis because it was covered by Section 3(d) of the Act despite the beta-crystalline form of imatinib mesylate being regarded a new and innovative step. A Special Leave Petition to the Supreme Court, Novartis contested the aforementioned order.

Issue:

Whether the Appellant's product satisfies the tests and thus qualifies as "invention" within the meaning of Clauses (j) and (ja) of Section 2(1), can its patentability still be questioned and denied on the ground that Section 3(d) puts it out of the category of "invention"?

Held:

Court stated that -

"Section 2(1)(j) defines "invention" to mean, "a new product or …", but the new product in chemicals and especially pharmaceuticals may not necessarily mean something altogether new or completely unfamiliar or strange or not existing before. It may mean something "different from a recent previous" or "one regarded as better than what went before" or "in addition to another or others of the same kind"45. However, in case of chemicals and especially pharmaceuticals if the product for which patent protection is claimed is a new form of a known substance with known efficacy, then the subject product must pass, in addition to Clauses (j) and (ja) of Section 2(1), the test of enhanced efficacy as provided in Section 3(d) read with its explanation.

It is also seen above that even while the Appellant's application for grant of patent lay in the "mailbox" awaiting amendments in the law of patent in India, the Appellant was granted Exclusive Marketing Rights on November 10, 2003, following which Gleevec was marketed in India as well. On its package, the drug was described as "Imatinib Mesylate Tablets 100 mg" and it was further stated that "each film coated tablet contains: 100 mg Imatinib (as Mesylate)". On the package there is no reference at all to Imatinib Mesylate in beta crystalline form. What appears, therefore, is that what was sold as Gleevec was Imatinib Mesylate and not the subject product, the beta crystalline form of Imatinib Mesylate.

In view of the findings that the patent product, the beta crystalline form of Imatinib Mesylate, fails in both the tests of invention and patentability as provided under Clauses (j), (ja) of Section 2(1) and Section 3(d) respectively."

LESSON ROUND-UP

- Laboratory Notebooks is used by inventors, scientists and engineers to record their invention process, experimental tests, ideas and results and observations. It is not a legal document but is of great value, if properly organized and maintained, since it can help establish dates of conception and reduction to practice.
- Writing a high-quality patent application is important because it sets out in a clear fashion the terms by which the patent owner and others will be bound. In this sense, drafting a patent application is different from writing a scientific paper.
- The parts of the patent application typically include the Background, Summary, Detailed Description and Drawings, Claims and Abstract. The drafting of patent application must be made in full and strict compliance with the patent law of the concerned jurisdiction. It is worth having the application professionally prepared.
- Even though checks and balances in the form of pre- and post- grant oppositions, revocations or counter revocations in infringement suits are available, the examination system acts as a primary gate keeper of the patent system.
- This publication includes all pertinent details related to the application. It includes the title, abstract, application number and name and address of the applicant. After this publication a patent application becomes open for public scrutiny.
- The Patents Act, 1970 provides for examination of patent application only on filing of request for examination by the applicant or any other interested person [section 11B].
- Once the request for examination is received and the application has been published, the Controller shall refer the particular application to an examiner for conducting examination and search in accordance with section 12 and 13 of the Patents Act, 1970.
- The examination of patent application is conducted in accordance with the provisions of section 121 of the Patents Act, 1970.
- Section 10(5) mandates that the claim/ claims of the complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept.
- Prior public use of the invention before the date of filing of application destroys the novelty of the invention.

- After the grant of patent, every patentee has to maintain the patent by paying renewal fee every year as prescribed in the schedule I.
- The patentee has choice to pay the renewal fees every year or he can pay in lump sum as well. Further, a request for restoration of patent can be filed within 18 months from the date of cessation of patent along with the prescribed fee. After receipt of the request the matter is notified in the official journal for further processing of the request.
- Patent Infringement means the violation of the exclusive rights of the patent holder. Unlike the Design law, the Patents law does not specify as to what would constitute Infringement of a patented product or process. However, the following acts when committed without the consent of the patentee shall amount to Infringement.
- Like any other civil suit the jurisdiction shall be determined in accordance with the rules of Code of Civil Procedure. The period of limitation for instituting a suit for patent Infringement is there years from the date of Infringement.
- The traditional rule of burden of proof is adhered to with respect to patented product and accordingly in case of alleged Infringement of a patented product the 'onus of proof' rests on the plaintiff. However, TRIPS-prompted amendment inserted by way of Section 104 (A) has 'reversed burden of proof' in case of Infringement of patented process.
- Doctrine of Colourable Variation states that a colourable variation or immaterial variation amounting to Infringement is where an infringer makes slight modification in the process or product but in fact takes in substance the essential features of the patentee's invention.
- Doctrine of inequitable conduct is based on two major principles – good faith and candour.
- Bolar provision allows manufacturers to begin the research and development process in time to ensure that affordable equivalent generic medicines can be brought to market immediately upon the expiry of the product patent.
- According to the doctrine of Exhaustion, the owner of the items loses control over further sales once a legal contract has been signed. The owner's exclusive right to sell the intellectual property is "exhausted" after the first sale and cannot be used again in relation to the same domain.
- Mareva refers to injunctions that prohibits the Defendant from taking assets out of the country or from using them or disposing of them in a way that would make the Plaintiff's enforcement of the decree, ineffective.
- Norwich Pharmacal Order maybe passed against a third party that has unintentionally become involved in the matter at hand, to compel them to produce pertinent information and documents.
- Anton Piller Orders are a type of evidence preservation civil search warrant. By use of this ex-parte order, a Court Commissioner may be appointed to go to the defendant's property, search it, and confiscate any infringing products.

GLOSSARY

Laboratory notebook - It is a systematic device for recording all information related to an invention in such a way that it can be used as a key component to develop a case during a patent contestation or patent-related lawsuit.

Provisional specification - It is a preliminary application before filing a usual patent. It explains the invention in a broad manner but not completely. The provisional specification is a permanent and independent scientific cum legal document and no amendment is allowed in this.

Patent Abstract - Every complete specification shall include an abstract to provide technical information on the invention. It shall be indicative of technical field, technical problem resolved, chemical formulae, and designs if any.

PCT International Application - A PCT application is an international application. The application opens the door for a streamlined patent application process in numerous nations at once, even though it does not permit for the grant of an international patent. It is subject to the Patent Corporation Treaty and may be recognised in as many as 142 nations.

Patent of Addition - If the applicant finds an innovation that is merely a modest modification of the invention for which the applicant has already applied for or been granted a patent, the applicant must file this application. A separate renewal fee shouldn't be paid during the primary patent's term because a patent of addition is only granted after the parent patent has been granted.

Divisional Application - If a particular application makes claims for more than one invention, the applicant may decide to partition the application and submit two or more applications. These applications' priority dates are the same as those of the parent application.

Claims - The claims define the scope of exclusive patent protection in terms of the technical features of the invention. The claims are the legally operative part of a patent application and whether or not an invention meets the patentability requirements is determined on the basis of the claims. Claims must be clear and concise, as well as fully supported by the description.

Independent Claims - They are 'standalone' claims that do not bear reference to any other claim. It contains a preamble and all the elements necessary to define the invention. The first claim is usually an independent claim that sets the tone for the protection claimed by the invention.

Dependent claims - They always bear reference to an earlier claim or independent claim and limit their scope. Dependent claims are therefore relatively narrow as they limit the scope of an earlier claim. Further, dependent claims refine the scope of protection sought for an invention.

TEST YOURSELF

(These are meant for re-capitulation only. Answers to these questions are not to be submitted for evaluation.)

1. What is a Laboratory Notebook? How is it significant in patent litigation?
2. The disclosure of an invention must be sufficient to enable an average skilled person to perform the invention. Explain the statement.
3. The patent agent should never become the inventor but should strive to have the clearest grasp of the invention needed to obtain a patent with the broadest claims allowed by law. Discuss.
4. Briefly explain the typical parts of a patent application and types of patent application.
5. What is PCT? Explain the process of obtaining patent through PCT.
6. What is patent infringement? Explain it with the help of proper provisions under Patent Act, 1970 and case laws.
7. What are important aspects of examination?
8. What are the exception in case of alleged patent infringement?
9. Explain Doctrine of Equivalents with the help of examples and case laws.

10. Write a short note on the following-
    - First Examination Report (FER)
    - Claims
    - Anton Piller Order and Manerva Injunction
    - Patent Misuse
    - Doctrine of Exhaustion

LIST OF FURTHER READINGS

- Bare Act – Patent Act, 1970, rules and regulations made thereunder.
- WIPO Patent Drafting Manual Second edition.
- Manual of Patent Office Practice and Procedure -2019.
- Patent Office Procedures.

OTHER REFERENCES (Including Websites / Video Links)

- https://ipindia.gov.in/patents.htm
- https://ipindia.gov.in/writereaddata/Portal/Images/pdf/Manual_for_Patent_Office_Practice_and_Procedure_.pdf
- https://www.wipo.int/portal/en/index.html
- https://patentscope.wipo.int/search/en/search.jsf