



**Directorate of Distance Education
NALSAR University of Law, Hyderabad**

Reading Material

Post-Graduate Diploma in Patents Law

1.3 Patent Law and Practice In India

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CHAPTER I

History and evolution of Patent Law

Patent right is granted to an idea which should lead to a useful product or process. Idea without culminating into a useful product or process is not patentable. Patent is a territorial grant as it is granted by Government, hence enforceable only in that particular country. Present Patents Act i.e Patents Act, 1970 is very balanced Act in terms of catering the needs of patent system users. Patentee gets a right to stop others from manufacturing, selling and using the invention. The science progresses as the knowledge is made open to public and hence further developments can be made. Society gets benefitted in continuous up gradation of technology. Misuses of the system, if any, are taken care by the Government and may go the extent of revocation of patent, if necessity arises so.

Patents Law is very old Law in India and as of this year it is 164 years old. Looking at the History and its evolution will be a fascinating journey.

1856

The first legislation in India relating to patents was the Act VI of 1856. The objective of this legislation was to encourage inventions of new and useful manufactures and to induce inventors to disclose secret of their inventions. The Act was subsequently repealed by Act IX of 1857 since it had been enacted without the approval of the British Crown.

1859

Fresh legislation for granting 'exclusive privileges' was introduced in 1859 as Act XV of 1859. This legislation contained certain modifications of the earlier legislation, namely, grant of exclusive privileges to useful inventions only and extension of priority period from 6 months to 12 months. This Act excluded importers from the definition of inventor. This Act was based on the United Kingdom Act of 1852 with certain departures which include allowing assignees to make application in India and also taking prior public use or publication in India or United Kingdom for the purpose of ascertaining novelty.

1872

The Patterns & Designs Protection Act.

In 1872, the Act of 1859 was consolidated to provide protection relating to designs. It was renamed as "The Patterns and Designs Protection Act" under Act XIII of 1872. The Act of 1872 was further amended in 1883 (XVI of 1883) to introduce a provision to protect novelty of the invention, which prior to making

application for their protection were disclosed in the Exhibition of India. A grace period of 6 months was provided for filing such applications after the date of the opening of such Exhibition.

1883

The Protection of Inventions Act.

This Act remained in force for about 30 years without any change but in the year 1883, certain modifications in the patent law were made in United Kingdom and it was considered that those modifications should also be incorporated in the Indian law. In 1888, an Act was introduced to consolidate and amend the law relating to invention and designs in conformity with the amendments made in the U.K. law.

1888

Consolidated as the Inventions & Designs Act.

1911

The Indian Patents & Designs Act.

The Indian Patents and Designs Act, 1911, (Act II of 1911) replaced all the previous Acts. This Act brought patent administration under the management of Controller of Patents for the first time. This Act was further amended in 1920 to enter into reciprocal arrangements with UK and other countries for securing priority. In 1930, further amendments were made to incorporate, inter-alia, provisions relating to grant of secret patents, patent of addition, use of invention by Government, powers of the Controller to rectify register of patent and increase of term of the patent from 14 years to 16 years. In 1945, an amendment was made to provide for filing of provisional specification and submission of complete specification within nine months.

After Independence, it was felt that the Indian Patents & Designs Act, 1911 was not fulfilling its objective. It was found desirable to enact comprehensive patent law owing to substantial changes in political and economic conditions in the country. Accordingly, the Government of India constituted a committee under the Chairmanship of Justice (Dr.) Bakshi Tek Chand, a retired Judge of Lahore High Court, in 1949 to review the patent law in India in order to ensure that the patent system is conducive to the national interest. The terms of reference included —

To survey and report on the working of the patent system in India;

To examine the existing patent legislation in India and to make recommendations for improving it, particularly with reference to the provisions concerned with the prevention of abuse of patent rights;

To consider whether any special restrictions should be imposed on patent regarding food and medicine;

To suggest steps for ensuring effective publicity to the patent system and to patent literature, particularly as regards patents obtained by Indian inventors;

To consider the necessity and feasibility of setting up a National Patents Trust;

To consider the desirability or otherwise of regulating the profession of patent agents

To examine the working of the Patent Office and the services rendered by it to the public and make suitable recommendations for improvement; and

To report generally on any improvement that the Committee thinks fit to recommend for enabling the Indian Patent System to be more conducive to national interest by encouraging invention and the commercial development and use of inventions.

The committee submitted its interim report on 4th August, 1949 with recommendations for prevention of misuse or abuse of patent right in India and suggested amendments to sections 22, 23 & 23A of the Patents & Designs Act, 1911 on the lines of the United Kingdom Acts 1919 and 1949. The committee also observed that the Patents Act should contain clear indication to ensure that food and medicine and surgical and curative devices are made available to the public at the cheapest price commensurate with giving reasonable compensation to the patentee.

Based on the above recommendation of the Committee, the 1911 Act was amended in 1950 (Act XXXII of 1950) in relation to working of inventions and compulsory licence/revocation. Other provisions were related to endorsement of the patent with the words 'licence of right' on an application by the Government so that the Controller could grant licences. In 1952 (Act LXX of 1952) an amendment was made to provide compulsory licence in relation to patents in respect of food and medicines, insecticide, germicide or fungicide and a process for producing substance or any invention relating to surgical or curative devices. The compulsory licence was also available on notification by the Central Government. Based on the recommendations of the Committee, a bill was introduced in the Parliament in 1953 (Bill No.59 of 1953). However, the Government did not press for the consideration of the bill and it was allowed to lapse.

In 1957, the Government of India appointed Justice N. Rajagopala Ayyangar Committee to examine the question of revision of the Patent Law and advise government accordingly. The report of the Committee, which comprised of two parts, was submitted in September, 1959. The first part dealt with general aspects of the Patent Law and the second part gave detailed note on the several clauses of the lapsed bills 1953. The first part also dealt with evils of the patent system and solution with recommendations in regards to

the law. The committee recommended retention of the Patent System, despite its shortcomings. This report recommended major changes in the law which formed the basis of the introduction of the Patents Bill, 1965. This bill was introduced in the Lok Sabha on 21st September, 1965, which however lapsed. In 1967, again an amended bill was introduced which was referred to a Joint Parliamentary Committee and on the final recommendation of the Committee, the Patents Act, 1970 was passed. This Act repealed and replaced the 1911 Act so far as the patents law was concerned. However, the 1911 Act continued to be applicable to designs. Most of the provisions of the 1970 Act were brought into force on 20 th April 1972 with publication of the Patent Rules, 1972.

This Act remained in force for about 24 years without any change till December 1994. An ordinance effecting certain changes in the Act was issued on 31 st December 1994, which ceased to operate after six months. Subsequently, another ordinance was issued in 1999. This ordinance was subsequently replaced by t he Patents (Amendment) Act, 1999 that was brought into force retrospectively from 1 st January, 1995. The amended Act provided for filing of applications for product patents in the areas of drugs, pharmaceuticals and agro chemicals though such patents were not allowed. However, such applications were to be examined only after 31-12-2004. Meanwhile, the applicants could be allowed Exclusive Marketing Rights (EMR) to sell or distribute these products in India, subject to fulfilment of certain conditions.

The second amendment to the 1970 Act was made through the Patents (Amendment) Act, 2002 (Act 38 Of 2002). This Act came into force on 20 th May 2003 with the introduction of the new Patent Rules, 2003 by replacing the earlier Patents Rules, 1972

The third amendment to the Patents Act 1970 was introduced through the Patents (Amendment) Ordinance, 2004 w.e.f. 1 st January, 2005. This Ordinance was later replaced by the Patents (Amendment) Act 2005 (Act 15 Of 2005) on 4 th April, 2005 which was brought into force from 1-1-2005.

1999

On march 26, 1999 Patents (Amendment) Act, (1999) came into force from 01-01-1995.

2002

The Patents (Amendment) Act 2002 came into force from 20th may 2003

2005

The Patents (Amendment) Act 2005 effective from 1st january 2005

Patents Rules

Under the provisions of section 159 of the Patents Act, 1970 the Central Government is empowered to make rules for implementing the Act and regulating patent administration. Accordingly, the Patents Rules, 1972 were notified and brought into force w.e.f. 20.4.1972. These Rules were amended from time to time till 20 May 2003 when new Patents Rules, 2003 were brought into force by replacing the 1972 rules. These rules were further amended by the Patents (Amendment) Rules, 2005 and the Patents (Amendment) Rules, 2006. The last amendments are made effective from 5th May 2006.

CHAPTER II

Patent Eligibility and Patentability Requirements

Patent is granted by the Central Government and is territorial in nature. In other words when a country grants a patent right to the applicant the right can be enjoyed in that country only. Assuming that a particular subject matter of a patent application is substantially same and applied in different countries by different applicants and not filed in any other country other than the place of filing then that particular invention has several owners and they are not infringing one another as they did not opt to file in foreign countries either under Paris Convention or under the Patent Co-operation Treaty [PCT Route]. To obtain a patent grant in any country the four criteria, [viz., NOVELTY, INVENTIVE STEP, INDUSTRIAL APPLICABILITY & SHALL NOT FALL UNDER STATUTORY EXCLUSIONAS] must be fulfilled. Let us discuss the above four criteria with respect to the procedure adopted by the Indian Patent Office.

1. NOVELTY

Novelty in general meaning is NEWNESS. Then what do we mean by the word “NEW”? Is there any parameter by which the Newness can be understood? Or when we can call information as NEW? Obviously one can conclude that the information that has come into the public domain from a particular date loses the Newness. This thought concludes that the parameter to assess the novelty is time or date of disclosure of the information to the public. The next question comes into mind is that to which public the said information is disclosed. Under the Patents Law the first disclosure is to a National Patent Office. Disclosure of the information other than to National Patent Office leads to loss of Novelty which ultimately leads to non-grant of patent right. Therefore the date of disclosure of the patentable subject matter through a patent application as filed before Indian Patent Office [or to any National Patent granting authority] is the cutoff date for assessing the NOVELTY of the filed information. This is the reason why many countries do not allow the substantial changes to the subject matter which goes beyond the scope of the disclosed information on the first filing because the additional substantial changes which may be proposed during prosecution may alter the entire scope of the invention and obviously has different date of first disclosure which goes against the basic principles of patent granting system.

As discussed earlier patent grant is a territorial grant. Hence if any applicant desires to obtain a patent right in different countries for substantially same invention then the applicant or assignee or assignee to assignee has to file in the desired countries. In this scenario, the applicant may file on different dates in different countries. Assuming that the applicant files an application [complete specification but not

provisional specification] in India, on 2nd January 2019 and opts for EARLY PUBLICATION on the same day, which according to the procedure adopted by Indian Patent Office gets the application published within one month, say for example, gets published on 2nd February 2019 [In reality the publication is done on every Friday of a week, hence the actual date of publication may vary accordingly] then it is to be concluded that the Novelty of that particular invention has been lost with respect to further filings in foreign countries of the applicant's choice. To avoid this problem a group of countries sat in Paris and resolution was passed by the member countries that if the applicant of a country chooses a foreign country to obtain a patent right for the substantially same invention the said applicant has to file the patent application within a non-extendable time limit of 12 months. This time line is calculated from date to date. Say, for example, if the applicant of India files a patent application in India on 2nd January 2019 then the said applicant has dead line to file the patent application on or before 2nd January of 2020 but not later. When we travel from east to west or vice versa of our mother earth there is a time gap or lag. This variation does not affect the above condition as the applicant is advised to stick to the local date. Depending on the direction of the travel applicant may either lose or gain some time of few hours which is ignored by sticking to the specified date. This agreement among the nations or member countries is known as PARIS CONVENTION and the application filed in this route is known as CONVENTION APPLICATION. Under the Paris Convention the Novelty assessment is done with respect to the first date of disclosure. Once again assuming that an Indian applicant files his application on 2nd January 2019 then the applicant's first disclosure date to Indian Patent Office is 2nd January 2019 which in other words is known as PRIORITY DATE or DATE OF PRIORITY and the Patent filing date is also 2nd January 2019. Hence the 2nd January 2019 is both the Date of Filing and Date of Priority as far as India is concerned for that applicant. If the said applicant files his Indian application, say for example in USA on 2nd January 2020 under Paris Convention then the applicant's Priority date is 2nd January 2019 but the applicant's date of filing in USA is 2nd January 2020. Please observe that there are two different dates in USA for the same application. Under the Paris Convention it is agreed by USPTO that they make the Novelty assessment of the filed invention with respect to the Priority Date, that is, 2nd January 2019. The Patent Term of 20 years is always calculated from the DATE OF FILING but not from the Priority Date. In this case the 20 year term of the applicant, when patent is granted, ends by 2nd January 2039 in India and patent expires or enters into public domain in USA on or after 2nd January 2040.

Care must be taken that when the applicant desires to enter any number of countries that are members to Paris convention must do so before the expiry date of 12 month non-extendable period calculated from the first priority date.

There is a provision in Indian Patent System that an applicant can file a PROVISIONAL PATENT SPECIFICATION [OR APPLICATION] before disclosing the full invention. A COMPLETE

SPECIFICATION shall be filed within non-extendable time limit of 12 months from the date of filing of the Provisional Specification. Needless to stress that the Complete Specification has more detailed information in comparison with the matter disclosed in Provisional Specification. In other words there are disclosures of information in pieces at different times which the applicant may desire to claim as a patent right. Hence the claims of one patent application can have different priority dates.

On similar lines let us study a case wherein a foreign national files a Complete Specification [equivalent to a non-provisional application before USPTO] in a country of choice and desires to enter in other countries with modification of the initially filed specification, probably to suit the needs of that particular country. Since the modifications are new and disclosed only on the date of filing in such country the said modifications have different date of priority. Like-wise the applicant may propose a series of amendments while entering the different countries. In such case the final entered application may have different claims with different priority dates. The Novelty assessment of the claims needs to be done with respect to different dates against the claims that were disclosed at different times. Even in this scenario the dead line of non-extendable time limit of 12 months will expire from the first priority date. This is also the reason why the Indian Patent Office charges multiple priority fees whenever multiple priorities are claimed since the examination of such applications is considered to be examining different applications.

Some of the patent users opined that patent prosecution global wise is costlier and the strict compliance of 12 months to file a convention application in a foreign country or in a group of countries of choice, puts a burden on the applicant to make a quick decision, which; most of the times go adverse to the applicant as the applicant is unable to make a wise decision on commercial exploitation of the filed invention within the given short period of 12 months from the date of filing the first application.

Therefore to facilitate the patent filing a system called INTERNATIONAL PHASE OF THE PATENT FILING WAS EVOLVED under Patent Co-operation Treaty [PCT]. This is otherwise known as International Filing System comprises two phases; Chapter I and Chapter II. All the member countries under Paris Convention are the default members of PCT. An applicant without filing a National Application can directly file an International Application subject to the approval of the concerned governments under their governing rules. Or an applicant can file a National Application initially and according to the Paris Convention can subsequently file an International Application within a non-extendable time limit of 12 months. In other words if an applicant files a National Application, for example, say, on 2nd January 2019, if desired, may file an International Application but on or before 2nd January 2020 but not on any later date. If an International Application is filed then Chapter I is mandatory whereas Chapter II is voluntary or optional. Under Chapter I on or before the expiry of 16 month from the date of priority, inclusive date of filing provisional specification, an International Search Report is prepared and sent directly to the applicant for perusal and necessary action, if required to be taken from

the applicant side. International Search Report makes the Novelty assessment, Inventive Step or Non-obviousness assessment and Industrial Applicability or Utility by claim wise. International Search Report does not make any comment on STATUTORY EXCLUSIONS [Patent ineligible subject matters] because each country has its' own laws governing the patent system but still complying with TRIPS Agreement. Applicant is allowed to propose amendments, if any, only to the Claims portion and no amendments are allowed with respect to description or drawings or both. Applicant may file comments on the International Search Report totally disagreeing with the report. In such case no further examination is done by the International Search Authority. If the applicant desires to obtain International Opinion on the arguments put forward on the receipt of International Search Report with or without the proposal of amendments to claims and to the description as well, may opt for Chapter II. If opted for Chapter II the applicant needs to file a DEMAND before the expiry of 20 month or 22 months from the date of priority. Before the expiry of 28 month from the date of priority the applicant receives the International Preliminary Examination Report, commenting on the Novelty, presence or absence of Inventive Step and Industrial applicability or Utility by claim wise.

Therefore the PCT System allows the applicant to get an International Opinion on the invention disclosed for the first THREE CRITERIA out of FOUR CRITERIA required to be fulfilled in order to obtain a patent right for the full disclosure. Since a single application is filed under PCT; which is deemed filed application in all the member countries, and the same application is prosecuted in all the countries, after entering the National Phase; the International Report(s) on patentability certainly plays a major role in prosecution of the application which must be worth for the costs to be incurred. Though the International Search Report [under Chapter I] or International Preliminary Examination report [under Chapter II] is not binding on any member country the direction received from the International authorities propels the applicant in right strategy in prosecution of the application during the National Phase / Entry.

After understanding the link between Novelty assessment and Date of Priority the next question is whether India follows the ABSOLUTE NOVELTY TEST or RELATIVE NOVELTY TEST for assessing the Novelty of an invention disclosure. Absolute Novelty may be understood as that the invention disclosure under any circumstances is not in public domain prior to the date of priority. Relative Novelty may be understood as that the invention is not new on the date of priority but Novelty is understood to be present on the date of priority under special circumstances. These proviso clauses are described exhaustively under Section 13 of the Indian Patents Act.

Novelty is presumed to be absent of a subject matter of an invention if there is a publication of such subject matter was done in India before the date of priority but on or after the 1st day of January, 1912. This cutoff date as given is for the reason that the principles of the Indian Patents Act were introduced for

the entire length and breadth of the nation. Before that there were bits of kingdoms within Indian Territory which were having their own laws of privilege of inventions and restricting to their boundaries.

On comparing two patent applications filed in India, that disclosing substantially same subject matter of the invention, the applicant who claimed first will be the Patent Owner if granted. The second applicant though independently developed the alleged substantially same invention is denied with the patent right. Indirectly the Patent Office follows the rule of ‘first come first served’ basis. The second applicant is denied the patent right on ‘FIRST CLAIMED’ which according to the Indian Patent Law is the anticipation of the invention. To make the point clearer let us assume a case where the Applicant A has filed an application on 2nd January 2018 and according to the provisions of the Section 11A of the Patents Act the said application is published just after the expiry of 18 months from the priority date. In the present case the application of the Applicant A is published on or after 2nd July 2019. Assuming that now the [second] Applicant B has filed a patent application before the Indian Patent Office on or before 1st July 2019 will be denied with the patent right for the reason that there is a prior claiming. On observation one can conclude that the Applicant B has the priority date before the date of publication of the Applicant A. Under general rule since the publication of the applicant a has happened after the priority date of the Applicant B the Novelty is retained for Applicant B. but because of prior claiming the Novelty of the Applicant B is stated to be anticipated. It is to be remembered that such PRIOR CLAIMING COMPARISION is done only when both the applications in question are before the Indian Patent Office. If both the Applicants A and B happens to file in different countries and not prosecuted their patent applications in a country of the subsequent applicant; both may be granted with a patent right in their respective countries if the subject matter of the disclosure is patent eligible according to the respective laws of those countries.

Chapter VI of the Indian Patents Act further provides clarity on which occasions the subject matter of the filed patent application is not considered as ‘ANTICIPATED’ and the Novelty is retained.

ANTICIPATION BY PRIOR PUBLICATION

- (a) Novelty of an invention as filed is not lost on showing evidence that a specification comprises the said subject matter was published in India before the 1st day of January 1912.
- (b) Novelty of an invention as filed is not lost on showing that the invention has been published before the priority date provided that such publication was done by another person without obtaining permission from the applicant who is assignee or assignee to assignee. Novelty will be lost if the applicant does not file patent application within 12 months from the date of such publication. Therefore care must be taken that to file patent application within non-extendable time limit of 12 months from the date of such publication. This entire clause will be ineffective if

it is proved that the subject matter of the alleged invention has been worked in India before the date of priority. Working of the alleged invention in India excludes the working of the said invention for trial purposes, and if done by a person other than the applicant or patentee then the other person shall obtain the consent of the applicant or patentee that includes assignee or assignee to assignee.

- (c) Novelty of an invention as filed is not lost when a complete specification is filed in pursuance of an application filed either by the true and first inventor(s) or any person who derives title from the true and first inventor(s), when another person files a patent application in contravention of the rights of the true and first inventor(s) or any person who derives title from the true and first inventor(s) and the said another person proves that the invention has been worked in India after the date of filing the application in India by him. Further the argument by the said another person that no consent was obtained from the first and true inventor(s) or from the person who derives the title from the true and first inventor(s) since the another person has worked or published the alleged invention only after his date of filing the application; is not considered as Novelty destroying argument with respect to the application made by the true and first inventor(s) or by any person who derives the title from the true and first inventor(s).

ANTICIPATION BY PREVIOUS COMMUNICATION TO GOVERNMENT

For the purpose of investigation or for the purpose of understanding the merits of the invention as a consequence of communication in writing to government or to any authorized person of the government is not considered as an anticipation of the invention. Hence Novelty of the invention is retained.

ANTICIPATION BY PUBLIC DISPLAY

- (a) Displaying and using the invention in an Industrial or Other Exhibition that is notified by the Central Government either by the applicant or assignee or assignee to assignee [from the true and first inventor(s) to latest assignee] or by any other person with the consent of the applicant or assignee or assignee to assignee does not destroy the Novelty of the invention provided that the patent application is filed within non-extendable time limit of 12 months from the date of Exhibition.
- (b) Any publication of the alleged invention as a consequence of exhibiting the invention or use of the invention in such Central Government notified exhibitions does not kill the Novelty of the invention provided that the patent application is filed within non-extendable time limit of 12 months from the date of such publication.

- (c) Any use of the invention after the date of display and as a consequence of exhibition by any person either with or without the consent of the first and true inventor(s) or assignee or assignee to assignee [or applicant or patentee] does not kill the Novelty of the invention provided that the patent application is filed within non-extendable time limit of 12 months from the date of such use.
- (d) Reading and publishing the invention before the learned society and any transactions in such society with the consent of the applicant or patentee does not kill the Novelty of the invention provided that the patent application is filed within non-extendable time limit of 12 months from the date of such reading and transaction of the said learned society.

ANTICIPATION BY PUBLIC WORKING

Novelty of the disclosure of the invention is not considered as lost when;

- (a) Applicant or patentee or any person who derives title either directly or indirectly from the applicant or patentee or by a person who obtains the consent from the applicant or patentee or by any other person who is authorized by him works the invention in public for the purpose of reasonable trial only; or
- (b) If the nature of the invention is such that the invention has ought to be worked in public,

provided that the patent application is filed within non-extendable time limit of 12 months from the date of such prior public working.

ANTICIPATION BY USE AND PUBLICATION AFTER PROVISIONAL SPECIFICATION

- (a) If any alleged invention is shown as either published, worked or used or displayed between the dates of filing the provisional and complete specification does not kill the Novelty of the invention provided that the patent application is filed within non-extendable time limit of 12 months from the date of filing the provisional specification. Here it may be noted that unless the complete specification is filed the provisional specification is not published by the patent office. When the complete specification is not filed then the provisional specification is deemed as withdrawn. The applicant may file a fresh application if the subject matter is not brought into public domain by any means before the date of filing the fresh application.
- (b) In the case of convention application(s) and PCT National entry application(s) if the alleged invention is shown as either published, worked or used or displayed between the date of priority and the date of National entry does not kill the Novelty of the invention provided that the patent application(s) is/are filed within the prescribed non-extendable time limits of 12 months from the date of priority under Paris Convention or 31 months from the date of priority under PCT System.

2. INVENTIVE STEP or NON-OBVIOUSNESS

The second criteria for obtaining a patent right is that the alleged invention shall possess inventiveness. How the inventive step will be assessed for the given invention is the question before us now. Before that one needs to understand what inventive step is. What is the difference between Novelty and Inventive step?

Novelty as discussed earlier is NEW and the parameter to weigh the newness is the priority date. Inventiveness is the contribution made by the human intelligence to the new or novel thoughts. Inventive-step otherwise is explained that whatever the contribution of human intelligence to the new or novel thought shall not be an obvious to a person skilled in that particular field of technology to which the alleged invention is related to. In other words the alleged invention shall be non-obvious to the person skilled in the art.

In most of the cases a patent specification describes an existing technical problem and a technical solution that never existed before the priority date. The proposed technical solution is subject to Novelty and Inventive step assessment. Generally it is a little bit tricky to assess an invention whether it is obvious or not after knowing the technical solution to the given technical problem.

In the assessment of Novelty of a claim; each element of that claim shall be present in a claim of comparison. Or each element of the claim shall be present in any given description and the claim is made of a group of scattered elements of the description wherein the connectivity of these elements is provided in the description. But in most of the cases claim is compared with another claim for the presence or absence of all the elements of a given claim for assessing the Novelty.

As discussed above the Inventiveness is the contribution of human intelligence. The said contribution may be an outcome of gathering the ideas from various sources including from different technical fields and combining them to make a solution to solve the given problem. In this instance it is viewed that the human mind has not contributed towards framing the solution except in bringing the available pieces of information into a single fold. Hence the offered solution in a patent specification is considered as lacking in inventive step.

To be more clear a hypothetical explanation is provided as hereunder. Imagine that there are 10 sets wherein each set comprises of a problem and a solution to solve the said problem. Now out of 10 sets there are 10 problems and 10 solutions which are in public domain. Now, let us assume that a 11th problem arises and the solution is to be searched for. Here the 11th problem is Novel as it never existed before. Let us say that a person skilled in that particular field solves this 11th novel problem with one of the existing 10 solutions. Then we have a 11th set which has a novel problem and a non-

novel solution. Therefore the 11th set is NOVEL in nature but fails in passing the Inventive step test because the solution is a known solution. Further, let us say that the 11th Novel Problem could not be solved by any one of the 10 existing solutions but could be solved by a selected combination of the 10 existing solutions. Now, here the 11th set comprises a novel problem and a novel solution. Arriving at a combination for the novel 11th problem in such manner is expected to be obvious to a person skilled in that particular field of technology as it is related to a trial and error method used in evolving the combination solution deduced from the existing 10 solutions. Here we have a 11th set that comprises a novel problem and a novel solution but still fails to satisfy the requirements of Inventive step. The next approach is that when the proposed 11th solution is neither selected from any one of the existing 10 solutions nor any combination that may be worked out by a person skilled in the art by using the existing 10 solutions is considered to involve the human mind in real terms in creating a solution for solving the 11th novel problem and therefore possess the inventive step.

The Indian Patents Act defines the Inventive Step in the Section 2(1)(ja), which is reproduced as hereunder.

“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.

According to the above definition the alleged invention to pass the inventive step test shall make the invention not only as non-obvious but also shall involve technical advancement or economic significance or both.

To pass the inventive step test; the claim shall be of one of the combinations:

- (a) Non-obvious and having Technical advancement, or
- (b) Non-obvious and having Economic significance, or
- (c) Non-obvious, having Technical advancement and having Economic significance

The phrases “Technical advancement” and “Economic significance” are not defined in the Patents Act, hence notions available in public may be considered for applying the meaning of the said phrases. The implied meanings of these phrases may differ from one technical field to another.

Process patents generally relay on “Economic significance” in addition to Non-obviousness for prosecuting the inventive step.

3. INDUSTRIAL APPLICABILITY

Section 2(ac) of the Indian Patents Act defines the industrial applicability, which is reproduced here.

“Capable of industrial application” in relation to an invention, means that the invention is capable of being made or used in an industry.

If the patent is related to a product, then the product is reproducibly manufactured in bulk wherein each product shall have all the essential features of the invention. If the invention is related to a process then such patented process shall be made adoptable in an existing industry with or without modifications to the existing infrastructure or a new industry with adoptable infrastructure may be commissioned.

4. STATUTORY EXCLUSIONS

The criteria explains that though the alleged inventions passes all the above three tests still patent will not be granted because the subject matter as covered under the Sections 3 and 4 of the Indian Patents Act is stated to be patent ineligible.

SECTION 3

- (a) an invention which is frivolous or which claims anything obviously contrary to well established laws
- (b) an invention, the primary or intended use or commercial exploitation of which would be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment
- (c) The mere discovery of a scientific principle or the formulation of or discovery of any living thing or non-living substance occurring in nature
- (d) The mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or the new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

EXPLANATION:

For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy.

- (e) A substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance.
- (f) The mere arrangement or rearrangement or duplication of known devices each functioning independently of one another in a known way
- (g) Section 3(g) was deleted which was read
A method or process of testing applicable during the process of manufacture for rendering the machine, apparatus or other equipment more efficient or for the improvement or restoration of existing machine, apparatus or other equipment or for the improvement or control of manufacture.
- (h) A method of agriculture or horticulture.
- (i) Any process for the medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products.
- (j) Plants and animals in whole or any part thereof other than microorganisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals.
- (k) A mathematical or business method or a computer program per se or algorithms
- (l) A literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions
- (m) A mere scheme or rule or method of performing mental act or method playing game.
- (n) A presentation of information
- (o) Topography of Integrated circuits
- (p) An invention which, in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components.

SECTION 4

No patent shall be granted in respect of an invention relating to atomic energy falling within subsection (1) of Section 20 of the Atomic Energy Act, 1962 (33 of 1962).

CHAPTER III

Patent Procedure

1. FILING

In order to obtain a patent right a true and first inventor or a group of inventors have to apply for a patent by filing a specification along with the specified forms accompanying with the prescribed fees in a prescribed manner. Patent Manual as published by the Indian Patent Office in their website www.ipindia.nic.in is more useful for the patent filers in India.

It is not mandatory that a true and first inventor or a group of inventors only need to apply. The assignee of a true and first inventor or a group of inventors or an assignee or an assignee to assignee or a combination thereof can also apply for a patent by filing a proof of right to make the application in the prescribed manner. Assignment can be made either before filing a patent or after obtaining the grant. In other words assignment of a patent right is possible at any time during the life term of a patent, that is 20 years from the date of filing.

India has FOUR PATENT OFFICES representing the four directions, viz., East, North, South and West parts of India. Mumbai Patent Office has a jurisdiction of western part of India. Chennai Patent Office has a jurisdiction of southern part of India. Delhi Patent Office has a jurisdiction of northern part of India. Kolkata Patent Office has a jurisdiction of eastern part of India. Hence the applicant has to apply for a patent right in such office where his / her jurisdiction fits in.

The address of the applicant decides the jurisdiction. In case of multiple applicants the address of the first applicant decides the jurisdiction. The address of the applicant may refer to a residence or domicile or place of business or the place from where the invention actually originated. If the applicant is a foreign national or a foreign entity then the local address for correspondence decides the jurisdiction for filing a patent application.

If any applicant desires to file a PCT International Application has to follow the jurisdiction requirement but the International Search Report will be issued from the Delhi Patent Office, being the International Search Authority.

Every applicant has to provide an address for correspondence, email address and telephone numbers including mobile number. The relevant information will be sent to the given email and an SMS is delivered to the given mobile number during prosecution of the patent application. The address for correspondence can be the address of the applicant or the address of an agent, if engaged or an address of

an authorized person of a company. Since the patent prosecution generally takes a longer period spanning from one year to two years to three years, if the applicant desires to update the address for correspondence including change in email or mobile numbers may do so by filing Form-13 in the prescribed manner. It shall be noted that the Indian Patent Office is corresponding only electronically, in other words through email and mobile communication. No hard copies are sent by post. Hence maintaining the proper address for correspondence from time to time is mandatory.

SECRECY DIRECTIONS

If it appears to the Controller that the invention is one of a class notified to him by the Central Government as relevant for defense purpose Or

Where otherwise the invention appears to the Controller to be so relevant

Controller may give directions for prohibiting or restricting the publication of information with respect to the invention or communication of such information.

When the invention is thought to be prejudice to defense of India

Controller so notifies to the Central Govt.,

Central Govt., examines and notify the decision to the Controller

If the Notice refers that the invention is not prejudicial to defense of India, the Controller thereupon revoke the directions of secrecy and informs the applicant accordingly.

Even without receiving the information from the Controller, if the Central Govt., feels that an invention which is found to be prejudice defense of India, at any time before the grant of patent, may notify the Controller.

Accordingly the Controller shall give notice to the Central Govt., of the directions issued by him.

Periodical review of secrecy directions:

Done by the Central Govt., at intervals of six months or the applicant may request for reconsideration or if the Central Govt., opines that the invention no longer is prejudicial to defense of India, or if the invention is filed by a foreign applicant and it is found that the invention is published outside India,

Notifies the Controller to revoke the directions and the Controller thereupon revokes the directions previously given by him.

Consequences of secrecy directions

- (a) Prosecution shall proceed up to the stage of grant
- (b) Controller shall neither refuse nor grant the patent
- (c) Invention shall not be published
- (d) No appeal shall lie from any order of the Controller passed in respect of the directions issued under secrecy clause

Use of the invention under secrecy [when found to be in order for grant]

During the continuance in force of the directions, the use of the invention is made by or on behalf of, or to the order of the Government, it is referred as use of the invention after the grant of patent by the Government and therefore the Government shall pay the royalty to the patentee.

The patentee shall be paid not more than adequate remuneration in the circumstances of each case, taking into account the economic value of the use of the patent.

Residents not to apply for patents outside India without prior permission

- (a) No Indian resident is allowed to file a patent application outside India [in a foreign country] without obtaining prior permission from the Controller.
- (b) Any person interested to file in a foreign country shall file Form – 25 in the prescribed manner.
- (c) Any person interested to file in a foreign country may do so after 6 weeks from the date of filing in India and no prior permission is required in such case.
- (d) No permission is accorded for the applications which have clamped with secrecy clause. Permission will be granted only on the revocation of secrecy clause.
- (e) This requirement is not applicable to a person who resides outside India and applied for a patent outside India.

It may be noted here that this requirement applies to INDIAN RESIDENTS. Indian resident includes a foreigner who resides in India. Similarly, an Indian who resides outside India applies for a patent in such country where he resides this requirement will not apply.

Liability for contravention of Section 35 [secrecy clause imposition] and Section 39 [foreign filing permission]

- (a) On contravention of the Sections 35 and 39 the application for patent under the Act shall be deemed to have been abandoned before the grant and if granted is liable to be revoked under the provisions of Section 64 of the Indian Patents Act.

- (b) If any person fails to comply with any direction given under Section 35 or makes or causes to be made an application for the grant of a patent in contravention of Section 39, shall be punishable with imprisonment for a term which may extend to two years, or with fine or with both.

Filing of Patent Application / Specification

Filing of an application for patent in India can be broadly classified based on the nature of the applicant or type of application and mode of filing.

NATURE OF APPLICANT(S)

- a) Any individual or group of individuals together can apply for patent.
- b) Any legal entity or a group of Legal entities together can file a patent application.
- c) Any individual or a group of individuals and a Legal entity or a group of Legal entities can apply for a patent.
- d) Any individual or a group of individuals can be inventor(s) or assignee(s)
- e) Any Legal entity or a group of Legal entities are either are first assignee(s) or assignee(s) to assignee(s)
- f) Any START UP COMPANY, if becomes the applicant and subject to certain conditions will be treated at par with INDIVIDUAL APPLICANT for enjoying the benefits provided for an individual applicant with respect to the scheduled fees. Individual and Start Ups enjoys the lowest fee.
- g) SMALL ENTITY engaged either in MANUFACTURING or SERVICE sectors, if are the sole applicants for a patent enjoys a fee reduction in contrast with the applicant(s) who are not individuals, and are not Start Ups.
- h) Highest patent fee is applicable only to such applicants who are neither individuals, nor start ups, nor small entities.
- i) Any combination of applicants attracts the higher fees wherein at least one of the applicants is/are bracketed under such fee schedule.. For example, if the applicants are a Small entity and an Individual then fee shall be paid according the Small entity status fee.
- j) If there is a change in the nature of the applicants between the date of filing and the date of grant, the difference of fees as applicable shall be paid from the date of filing.
- k) Applicant can be of any National or of any Resident.

RELATED DEFINITIONS

START UP

The Patents Rule 2(fb) provides the definition of a start up. The following is the excerpt of the said Rule.

(fb) (i) "Startup" means

(a) an entity in India recognised as a startup by the competent authority under Startup India initiative.

(b) In case of a foreign entity, an entity fulfilling the criteria for turnover and period of incorporation/ registration as per Startup India Initiative and submitting declaration to that effect.

Explanation: In calculating the turnover, reference rates of foreign currency of Reserve Bank of India shall prevail.

(c) words and expressions used, but not defined in these rules, shall have the meanings respectively assigned to them in the Act.

As per the guidelines issued by MINISTRY OF COMMERCE AND INDUSTRY (Department of Industrial Policy and Promotion) NOTIFICATION New Delhi, dated the 11th April, 2018; a start up company has been defined in India is as follows.

(a) An entity shall be considered as a Startup:

i. Upto a period of seven years from the date of incorporation/registration, if it is incorporated as a private limited company (as defined in the Companies Act, 2013) or registered as a partnership firm (registered under section 59 of the Partnership Act, 1932) or a limited liability partnership (under the Limited Liability Partnership Act, 2008) in India. In the case of Startups in the biotechnology sector, the period shall be upto ten years from the date of its incorporation/ registration.

ii. Turnover of the entity for any of the financial years since incorporation/ registration has not exceeded Rs. 25 crore

iii. Entity is working towards innovation, development or improvement of products or processes or services, or if it is a scalable business model with a high potential of employment generation or wealth creation.

Provided that an entity formed by splitting up or reconstruction of an existing business shall not be considered a 'Startup'.

Explanation: An entity shall cease to be a Startup on completion of seven years from the date of its incorporation/ registration or if its turnover for any previous year exceeds Rupees 25 crore. In respect of

Startups in the biotechnology sector, an entity shall cease to be a Startup on completion of ten years from the date of its incorporation/ registration or if its turnover for any previous year exceeds Rs. 25 crore.

SMALL ENTITY

The Patents Rule 2(fa) provides the definition of a start up. The following is the excerpt of the said Rule.

(fa) "small entity" means, -

- (i) in case of an enterprise engaged in the manufacture or production of goods, an enterprise where the investment in plant and machinery does not exceed the limit specified for a medium enterprise under clause (a) of sub-section (1) of section 7 of the Micro, Small and Medium Enterprises Development Act, 2006 (27 of 2006); and
- (ii) in case of an enterprise engaged in providing or rendering of services, an enterprise where the investment in equipment is not more than the limit specified for medium enterprises under clause (b) of sub-section (1) of Section 7 of the Micro, Small and Medium Enterprises Development Act, 2006.

Explanation 1. - For the purpose of this clause, "enterprise" means an industrial undertaking or a business concern or any other establishment, by whatever name called, engaged in the manufacture or production of goods, in any manner, pertaining to any industry specified in the First Schedule to the Industries (Development and Regulation) Act, 1951 (65 of 1951) or engaged in providing or rendering of any service or services in such an industry.

Explanation 2. - In calculating the investment in plant and machinery, the cost of pollution control, research and development, industrial safety devices and such other things as may be specified by notification under the Micro, Small and Medium Enterprises Development Act, 2006 (27 of 2006); shall be excluded.

Excerpts from MSME Act [source <https://msme.gov.in/know-about-msme>]

What are Micro, Small & Medium Enterprises ?

Definitions of Micro, Small & Medium Enterprises In accordance with the provision of Micro, Small & Medium Enterprises Development (MSMED) Act, 2006 the Micro, Small and Medium Enterprises (MSME) are classified in two Classes:

1. **Manufacturing Enterprises**-he enterprises engaged in the manufacture or production of goods pertaining to any industry specified in the first schedule to the industries (Development and regulation) Act, 1951) or employing plant and machinery in the process of value addition to the final product having a distinct name or character or use. The Manufacturing Enterprise are **defined in terms of investment in Plant & Machinery**.

2. **Service Enterprises**:-The enterprises engaged in providing or rendering of services and are **defined in terms of investment in equipment..**

The limit for investment in plant and machinery / equipment for manufacturing / service enterprises, as notified,[vide S.O. 1642\(E\) dtd.29-09-2006](#) are as under

Manufacturing Sector		
Enterprises	Investment in plant & machinery	
Micro Enterprises	Does not exceed twenty five lakh rupees	
Small Enterprises	More than twenty five lakh rupees but does not exceed five crore rupees	
Medium Enterprises	More than five crore rupees but does not exceed ten crore rupees	
Service Sector		
Enterprises	Investment in equipments	
Micro Enterprises	Does not exceed ten lakh rupees:	
Small Enterprises	More than ten lakh rupees but does not exceed two crore rupees	
Medium Enterprises	More than two crore rupees but does not exceed five crore rupees	

TYPE OF APPLICATIONS

Form-1 is the specified form of the application wherein the details of the type of application is asked for. The type of application is mentioned by a “digit” in the 12 digit application number. Though there is no specific sequence on the mention of type of applications for the convenience sake the following order is followed.

a) CONVENTION APPLICATION

This is the application filed by a foreign applicant within non-extendable time limit of 12 months from the earliest priority date. [Under Paris Convention].

b) PCT NATIONAL PHASE APPLICATION

This is the application which is a National Entry application filed by any applicant including Indian National and Resident within a non-extendable time limit of 31 months from the earliest priority date.

c) ORDINARY APPLICATION

This is the application which is neither Convention application nor a PCT National Phase Application. In other words this is the first application of the world, filed by an applicant, who is of either Indian or of Foreign origin. Indian filing date is also the First Priority Date of the application / applicant.

d) DIVISIONAL APPLICATION

Under the provisions of the Section 46(2) of the Indian Patents Act “A patent shall be granted for ONE invention only”. Section 16 of the Indian Patents Act provides guidelines on dealing with such application that comprise more than one invention. The applicant can suo motto make a request the Controller to allow him/her to file another application comprising the different invention that was disclosed in the first filed or parent application. Or, the applicant may file another application on the direction of the Controller to divide the application. Such applications are referred as Divisional Applications. Date of divisional application is ante-dated to the parent application and therefore the life term of 20 years is calculated from the filing date of the first mentioned application.

Divisional Application(s) can arise from Convention Application or from PCT National Phase Application or from Ordinary application.

If the first mentioned application comprises “n” number of multiple inventions then theoretically there is a possibility of (n-1) divisional applications barring the first mentioned application.

Divisional applications are prosecuted like a regular application and if granted renewal fee shall be paid to maintain the patent.

e) PATENT OF ADDITION

Chapter IX and Sections 54 to 56 deal with the applications related to any modification proposed to a filed or granted patent.

Section 54 (1) of the Indian Patents Act reads thus;

- (1) Subject to the provisions contained in this section, where an application is made for a patent in respect of any improvement in or modification of an invention described or disclosed in the complete specification filed therefor (in this Act referred to as the "main invention") and the applicant also applies or has applied for a patent for that invention or is the patentee in respect thereof, the Controller may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.

MODE OF FILING

Applicant can file the patent applications either by filing hard copies or by using Indian patent e-filing system. If the applicant chooses to file through hard copy filing route then the applicant needs to file 10% extra fee then the prescribed e-filing fee.

SCHEDULED FEE

The First Schedule of the Indian Patents Rules provides a list of forms and associated fee to be paid. A differential fee structure on the nature of the applicant is also provided in the said first schedule. A base fee has been fixed to small entities and then the fee for others is calculated accordingly. Say, for example, for a small entity the prescribed fee for a particular action, is “X”, then the individual applicant needs to pay only 40% of X and an applicant who does not qualify as an individual or a start up company or does not qualify as small entity has to file “2X” [TWICE OF X] as the prescribed fee. If the applicant does not choose the e-filing route then there will be an addition of 10% to the above prescribed fee.

Fee concessions, if any, shall be claimed by filing necessary documents at the time of filing only. It is not acceptable to file the documents first and the proving documents later to claim fee concession, if applicable. If the applicant is small entity then a certificate from MSME is mandatory. If the applicant is a Startup, then a registration certificate from the Department for Promotion of Industry and Internal Trade [DPIIT] earlier known as Department of Industrial Policy & Promotion (DIPP) shall be attached.

REQUIRED FORMS AT THE TIME OF FILING FOR A PATENT BEFORE INDIAN PATENT OFFICE

- a) Form-1
- b) Form-2
- c) Form-3, if applicable
- d) Form-5, if applicable

- e) Form-9, if desired by the applicant
- f) Form-18 – advised to file along with the Complete Specification

FORM-1

This Form can be used by any kind of applicant for any type of application. This Form can be filed either by the applicant or by any authorized Patent Attorney. There are provisions to fill the specified columns wherein the applicant is advised to provide the names of the applicant(s), the names of the inventor(s) addresses and their Nationalities, address for correspondence. Address for correspondence shall contain the working email id, phone numbers including mobile number(s), fax number(s), if any. Providing mobile number is mandatory as the sms's of different activities during prosecution are being sent as an alert to the applicant to respond, if desired, before the stipulated time limits. Providing email id is also mandatory as the Indian Patent Office has dispensed with hard copy correspondence. It may be noted that even the Patent Certificate, when granted, will be sent to the email on record which can be printed by the applicant. Therefore, the applicant(s) are cautioned to keep the mobile number and email ids in active mode. If there is any change is sought then the applicant(s) need to file Form-13 along with the prescribed fee to get the change recorded.

If the applicant(s) is/are assignees then it is mandatory to fill the requisite column by the inventors [12th Paragraph of Form-1 that is DECLARATIONS] and sign the Form-1. In case, if it is not possible to obtain the signatures of the inventor(s) [even when the signature of one of the inventors is not possible] then a PROOF OF RIGHT to make an application can be filed by the applicants in the form of ASSIGNMENT either along with the application or within 6 months from the date of filing, failing which the applicant(s) need to file a petition to condone the delay in filing under the provisions of the Patents Rule 138.

Section 135(1) deals with the provision of filing the convention application(s) that includes PCT National Phase applications. The said section reads thus;

There is no restriction on the number of applicants and number of inventors.

(1) Without prejudice to the provisions contained in section 6, where a person has made an application for a patent in respect of an invention in a convention country (hereinafter referred to as the "basic application"), and that person or the legal representative or assignee of that person makes an application under this Act for a patent within twelve months after the date on which the basic application was made, the priority date of a claim of the complete specification, being a claim based on matter disclosed in the basic application, is the date of making of the basic application.

Explanation.—Where applications have been made for similar protection in respect of an invention in two or more convention countries, the period of twelve months referred to in this sub-section shall be reckoned from the date on which the earlier or earliest of the said applications was made.

It may be noted here that in the absence of worldwide assignment, the applicant of a convention country shall file Proof of Right to make the application in India though the invention was assigned to the applicants in that convention country.

FORM -2

Form-2 is the SPECIFICATION of the alleged invention. The first page is specified which to be numbered as FIRST PAGE of the filed specification. The details of the invention that shall meet the requirements of the provisions of the Section 10 of the Indian Patents Act shall start from second page onwards. There is no limitation on the number of pages. If the pages go beyond 30 pages then there is a fee to be paid per page starting from 31st page onwards. [Please refer the First Schedule of the Patents Rules].

There are two kinds of specifications.

- a) Provisional Specification, and
- b) Complete Specification.

It may be noted that filing Provisional Specification is not mandatory.

PROVISIONAL SPECIFICATION

Filing a Provisional Specification is not possible for Convention application, PCT National Application, Divisional application.

Though there is no direction in the Indian Patents Act that the Patent is granted to that applicant who files the application first. The indication in this indirect direction of first come first served basis can be found on the principle that the applicant whose priority is earliest is granted with patent right and of another applicant whose priority is later than the first applicant of the substantially same invention is denied under anticipation of the invention under prior claiming.

Section 13(1)(b) guides the examiner to prepare a report on anticipation of invention through prior claiming.

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 has been anticipated wherein the claim in question is claimed 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.

Therefore, in order to grab the Priority Date, some of the applicants prefer to file a Provisional Specification to stay ahead of the competitors. Patents Law takes care on not misusing this provision by restricting the applicants of the Provisional Specification to file the corresponding Complete specification within non-extendable time limit of 12 months.

Section 9(1) of the Patents Act reads thus;

- (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.

When the Provisional specification is filed, the applicants can file multiple provisional specifications having improvements or modifications of the first filed provisional specification. In such case on the leave of the Controller the applicant can merge all the provisional filed and can file a single complete specification.

Section 9(2) of the Patents Act reads thus;

- (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.

Because of this situation there is always a possibility that there are disclosures of different modifications or improvements have different dates. If such modifications and or improvements are claimed at the time of filing the Complete Specification then there is always a possibility of claims of a particular specification have claims having different priority dates. This is the reason why the examination reports of any country; including International Search Report and or International Preliminary Examination Report makes claim wise assessment on Novelty, Inventive Step etcetra.

If the applicant desires to convert a filed complete specification into a provisional specification can do so by filing a request. There is no specific Form and also there is no Fees to be paid to make such request.

Section 9(3) of the Patents Act reads thus;

- (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.

If the applicant desires to cancel the filed Provisional Specification after filing the Complete Specification and desires to Post-date the application may do so by filing a request. There is no specific Form and there is no Fee to be paid for making such request. By cancellation of the Provisional Specification the Priority Date shifts from the date of filing the Provisional specification to that date of filing the Complete Specification. In other words, the Novelty assessment date shifts from the date of provisional to that of complete, hence the applicant shall be cautious in making such request.

Section 9(4) of the Patents Act reads thus;

- (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.

Further Section 17(1) stipulates that the post-dating can be allowed by a maximum period of 6 months.

Section 17(1)

- (1) Subject to the provisions of section 9, at any time after the filing of an application and before the grant of the patent under this Act, the Controller may, at the request of the applicant made in the prescribed manner, direct that the application shall be post-dated to such date as may be specified in the request, and proceed with the application accordingly:

Provided that no application shall be post-dated under this sub-section to a date later than six months from the date on which it was actually made or would, but for the provisions of this sub-section, be deemed to have been made.

Ordinarily a Provisional Specification does not contain CLAIMS as the invention is incomplete. But there is a possibility of a provisional specification comprising claims when the applicant makes a request for the conversion of the Complete into Provisional.

COMPLETE SPECIFICATION

- a) If provisional is filed then the Complete Specification shall be filed within non-extendable time limit of 12 months from the date of filing the Provisional Specification.
- b) If multiple Provisional Specifications are filed for the given invention by the applicant, then applicant is allowed to cognate all the provisional specifications and can file a single complete specification and 12 month period is reckoned from the earliest priority date.
- c) [Section 135(2)] Where applications for protection have been made in one or more convention countries in respect of two or more inventions which are cognate or of which one is a modification of another, a single convention application may, subject to the provisions contained in section 10, be made in respect of those inventions at any time within twelve months from the date of the earliest of the said applications for protection:
MULTIPLE PRIORITY FEE IS TO BE PAID: Provided that the fee payable on the making of any such application shall be the same as if separate applications have been made in respect of each of the said inventions, and the requirements of clause (b) of sub-section (1) of section 136 shall, in the case of any such application, apply separately to the applications for protection in respect of each of the said inventions.
- d) Complete Specification can be filed without filing the Provisional Specification.

SECTION 10 OF THE INDIAN PATENTS ACT

(1) 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.

(2) 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.

(3) 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.

(4) 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 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 of patent in India or if a 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.

(4A) 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.

(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.

(6) 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.

(7) 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.

FORM-3

If the applicant for a patent is Indian Citizen and Indian Resident then he/she cannot apply for a patent right outside India unless;

- a) First file an Indian application and wait for six weeks and if no intimation is received from Patent Office with respect to secrecy directions; or
- b) Apply for permission to file abroad [without filing in India] by filing Form – 25 along with the prescribed fee [wherein the permission or denial will be intimated within 3 weeks to the applicant]

Once the application is filed before the Indian Patent Office then it is mandatory for the applicant to provide the details of foreign filing particulars, if any, within 6 months from the date of such country. For example, after filing in India in the month of January 2018 and if the applicant files substantially same invention in other countries, for example, in US, UK, Europe, Japan on 2nd February, 3rd March, 4th April and 5th May of 2018 respectively; then within 6 months that is on or before 2nd August 2018 in the case of US filing, within 6 months, that is on or before 3rd September 2018 in the case of UK filing, within 6 months, that is on or before 4th October 2018 in the case of Europe filing, and within 6 months, that is, on or before 5th November 2018 in the case of Japan filing, shall file the details of such filings before the Indian Patent Office. For any reason, if the applicant could not file Form-3 within this stipulated period of 6 months then provisions of the Patents Rule 138 shall apply.

If the applicant is of foreign origin, then there may be a possibility of that applicant to file the application in different countries before filing in India, then in such case the applicant need to file Form-3 on the date of Indian filing failing which he may do so within 6 months from the date of filing in India. If the said

foreign applicant files the application for patent in foreign country(ies) after filing in India, still the applicant needs to file Form-3 in the prescribed manner.

If the applicant is Indian National and or Indian Resident and there is no foreign filing then filing Form-3 is not required.

Suppression of information with respect to foreign filing particulars and updating the information with respect to foreign applications is one of the grounds of opposition. If proved in post-grant opposition, the patent will be revoked. Hence the applicant shall be careful in updating the information with respect to foreign filings.

Section 8(1) of the Indian Patents Act

(1) Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file along with his application or subsequently within the prescribed period as the Controller may allow—

(a) a statement setting out detailed particulars of such application; and

(b) an undertaking that, up to the date of grant of patent in India, he would keep the Controller informed in writing, from time to time, of detailed particulars as required under clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequently to the filing of the statement referred to in the aforesaid clause, within the prescribed time.

FORM – 5

Form-5 is required to be filed only under 3 circumstances; they are

- a) At the time of filing the Complete Specification after filing the Provisional Specification
- b) At the time of filing Convention Application
- c) At the time of filing PCT National Phase application.

This is because there is a possibility of improvements of the invention of the basic application and the said improvements could have been contributed by other persons [further inventors] who may not be the inventors of the basic application. Even if there are no further inventors filing Form-5 in the above circumstances is mandatory.

Form-5 shall be filed along with the Complete Specification. No fee is required to be paid. No free time period is allowed. For any reason if the applicant could not file Form-5 along with the Complete Specification, he may file Form-5 within one month from the date of filing by filing Form-4 along with the prescribed fee. Further time extension of 1 month may be allowed by the Controller under the provisions of the Patents Rule 138.

Filing Form-5 is not required when the Complete Specification is filed without filing the Provisional Specification by any Indian national or resident as his/her's first patent application in the world.

FORM – 9

Form-9 is related to request for an early publication.

Patent, if granted, lasts for **20 YEARS FROM THE DATE OF FILING**. Once the application is filed before the Patent Office, then the details of the Patent application is made public through Patent Gazette Publication as soon as the expiry of 18 months from the earliest priority date. Publication is done only when there is a filing of Complete Specification. Abandoned Provisional specifications are not published. The PROVISIONAL RIGHT OF THE APPLICANT STARTS ONLY FROM THE DATE OF PUBLICATION but not from the date of filing. Between the date of publication and the date of patent grant, the applicant is not allowed to file any suit for infringement before any court. The applicant may do so after obtaining the grant and may claim damages from the date of publication. Therefore, in reality the patent right is enjoyable only for 18 and half years from the date of filing.

As discussed earlier the patent right is granted to the first come first served basis. Hence the interests of all the applicants are to be considered before taking the application for prosecution. An applicant is allowed to file a provisional specification and then a complete specification within 12 months from the date of filing the provisional specification. Under the Convention route an applicant is allowed to file an application in a country of his choice within non-extendable time limit of 12 months from the earliest priority date. Instead of choosing a particular country the applicant may choose to file an International application under PCT route. All the member countries under Paris Convention are bound by these rules. Assuming that an applicant files an application in his home country and files an International application on the last day of the non-extendable time limit of 12 months, then International Search Authority is given 4 months' time to prepare and send the International Search Report directly to the address for correspondence as provided by the applicant. Then the applicant is given 2 months' time to react and if desired may propose the amendments only to the claims but not descriptive portion of the specification. Or the applicant may lodge his/her protest in writing. All these information will be published at the expiry of this transaction period, which is $12+4+2=18$ months by International Bureau [IB] in their portal which is freely available for the public. Even if a direct International Application is filed wherein the

International filing date is the earliest priority date the International Search Report will be issued before the expiry of 16 months and publication will be done only at the expiry of 18 months from the said priority date. Therefore the publication of any patent application at the expiry of 18 month period from the earliest priority date is universal and followed by each and every member country under Paris Convention and India is not an exception.

The above arguments or explanation may not be palatable to an applicant who is interested to file and obtain patent right only in India and not interested in International markets. For such type of applicants losing the patent right for 18 months from the date of filing is considered to be a big loss. To cater the interests of such applicants the Indian Patent Office has introduced a system of EARLY PUBLICATION, that is before the expiry of 18 month period from the earliest priority date provided the applicant files Form-9 along with the requisite fee requesting for early publication. Ordinarily, the Indian Patent Office publishes at the earliest time after receiving Form-9 from the applicants. Ordinarily the entire activity will not take more than one month time from the date of receipt of Form-9.

Form-9 cannot be filed along with Provisional Specification.

FORM-18 / FORM 18-A

The Indian Patent Office requires a separate application requesting the Patent Office to take up the application for examination. This requirement is in addition to the filing Form-1. Request for examination has to be filed within 48 months from the earliest priority date by filing Form-18 along with the prescribed fees. PCT National Phase is not examined until the 31 month period from the earliest priority date is expired. If any applicant desires to get his/her PCT National Phase application to be examined before the expiry of the said 31 month period may file a request by filing Form-18A along with the prescribed fee. Form 18A can be filed by an applicant of ordinary application when he/she is either files an PCT International application and chooses India as the International Search Authority or the applicant is a Start Up.

As on today it is advisable to file the request for examination [form-18] along with the Complete Specification as the order of examining the patent applications based on the sequential order or chronological order of the request numbers but not on the application numbers.

For example, assuming that an applicant files Form-1, say in the month of 5th May 2014 and files a request for examination on 5th May 2018 wherein the second applicant files Forms 1 and 18 on 6th May 2014 then the application of the second applicant is prosecuted first and the prosecution of the first applicant will start only after 5th May 2018. Hence it is always advisable to file Form-18 along with the Complete Specification.

Irrespective of 48 month deadline, for the patent applications wherein secrecy is clamped or directed by the Controller to divide the application then the applicant can file Form – 18 within 6 months from the date of revocation of secrecy or from the date of filing the divisional application.

The relevant Sections and Rules are reproduced as here under.

SECTION 11-B OF THE PATENTS ACT

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 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) the 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.

RULE 24B OF THE INDIAN PATENTS RULES

Examination of application

(1)(i) A request for examination under section 11B shall be made in Form 18 within forty-eight months from the date of priority of the application or from the date of filing of the application, whichever is earlier;

(ii) The period within which the request for examination under sub-section (3) of section 11B to be made shall be forty-eight months from the date of priority if applicable, or forty-eight months from the date of filing of the application;

(iii) The request for examination under sub-section (4) of section 11B shall be made within forty-eight months from the date of priority or from the date of filing of the application, or within six months from the date of revocation of the secrecy direction, whichever is later;

(iv) The request for examination of application as filed according to the 'Explanation' under sub-section (3) of section 16 shall be made within forty-eight months from the date of filing of the application or from the date of priority of the first mentioned application or within six months from the date of filing of the further application, whichever is later;

(v) The period for making request for examination under section 11B of the applications filed before the 1st day of January, 2005 shall be the period specified under the section 11B before the commencement of the Patents (Amendment) Act, 2005 or the period specified under these rules, whichever expires later.

RULE 24 (C) OF THE INDIAN PATENTS RULES

Expedited examination of applications

(1) An applicant may file a request for expedited examination in Form 18A along with the fee as specified in the first schedule **ONLY BY ELECTRONIC TRANSMISSION [No hard copy filing is allowed]** duly authenticated within the period prescribed in rule 24B on any of the following grounds, namely:

(a) that 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.

(2) A request for examination filed under rule 24B may be converted to a request for expedited examination under sub-rule (1) of rule 24C by paying the relevant fees and submitting requisite documents as required under sub-rule (1).

(3) 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.

(4) 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 intimation to the applicant, and shall be deemed to have been filed on the date on which the request for expedited examination was filed.

2. Examination

After meeting all the filing requirements the application is published at the expiry of 18 months to make it open to public. Once the request for examination is filed the applications are arranged in chronological order and taken up for examination in that order only.

EXAMINATION PROCEDURE IN BRIEF

The Examination proceedings in the Indian Patent Office, in brief, are as follows.

- a) The patent application is allotted to the Examiner by the Controller. At present the allotment is done through an internal module, the software assesses the load on each examiner and the application is allotted to that examiner whose load is relatively low. Applications are divided into group wise and are allotted to that particular examiner who is expert in the relevant field. Therefore, it is to be understood that a Patent application of a particular jurisdiction may be allotted to the examiner who is working in another jurisdiction. There is an automatic pairing of the examiner and Controller. Hence Controller may be of different jurisdiction.
- b) Examiner is requested to making a report to him in respect of the following matters, namely:—
- (i) 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;
 - (ii) whether there is any lawful ground of objection to the grant of the patent under this Act in pursuance of the application;
 - (iii) the result of investigations made under section 13; and
 - (iv) any other matter which may be prescribed.
 - (v) The examiner to whom the application and the specification and other documents relating thereto are referred shall ordinarily make the report to the Controller within one month but not exceeding three months from the date of reference.
- c) The Controller reviews the report of the examiner and gist of the objections, if any, will be communicated to the applicant. The period within which the Controller shall dispose of the report of the examiner shall ordinarily be one month from the date of the receipt of such report by the Controller. The dispatch of reports is done through email and an alert is sent in the form of sms to the given mobile number. No hard copies are sent. Provided that where the request for examination was filed by a person interested, only an intimation of such examination will be sent to such person interested.
- d) When the applicant desires to file a reply to the examination report then the time for putting an application in order for grant shall be six months from the date on which the first statement of objections is issued to the applicant to comply with the requirements.
- e) The stipulated 6 month time for putting an application in order for grant can be further extended for a period of three months on a request in Form 4 for extension of time along with prescribed fee, made to the Controller before expiry of the period of 6 months. The associated fee with Form-4 is monthly fee and the applicant is granted with only one extension of time, if requested. Therefore, the applicant shall be cautious enough in selecting the time period within the extendable time limit of 3 months. Further requests, if made, will be summarily rejected and if no reply is made then the application is treated to be abandoned by the applicant. Applicant cannot

- re-file the patent application because novelty of the invention is lost owing to the section 11A publication.
- f) Reply to the first statement of objections and subsequent reply, if any, shall be processed in the order in which such reply is received. Ordinarily there will be no second examination report issuance; instead a hearing is fixed through video conferencing. If the applicant does not have a facility of video conferencing the Patent Office of the applicant's jurisdiction will arrange such facility on making a request by the applicant.
 - g) If the reply to examination reports satisfies the requirements of the Patents Act the applicant will be granted with a patent right at the earliest, provided that the Controller shall not grant a patent right to the applicant unless until the expiry of 6 month period from the date of Section 11B publication, that is publication at the expiry of 18 months from the date of filing the application including the provisional filing.[earliest priority date].
 - h) If Form-9 is not filed, then statutorily the grant of patent to an application takes 24 months from the date of filing. 18 months publication and 6 months stay from the date of publication put together is 24 months. Examination starts only after publication provided a request for examination is received before the publication date. If the request for examination is filed later to the date of publication, accordingly the examination proceedings are delayed.
 - i) After the grant of patent the details are once again published in the Patent Office Journal.

PCT NATIONAL PHASE APPLICATION:

- a) International filing date is the date of filing in India. 20 years patent term is calculated from the International filing date.
- b) The Patent Office shall not commence processing of an application filed corresponding to international application designating India before the expiration of the time limit of 31 months from the earliest priority date.
- c) The Patent Office may, on the express request filed in Form 18A along with the fee specified in First Schedule, process or examine the application at any time before thirty one months.
- d) If the International Application is in other than English language then the applicant has to file the English translated documents before the expiry of 31 month period from the earliest priority date.
- e) The PCT National Phase Applications shall be examined under the provisions of the Indian Patents Act.

SECTION 14 HEARING:

The applicant, if interested can make a request for a hearing before submitting any response to the adverse examination report issued by the Controller. But such request, on the lines of the Section 80 shall be filed

at least 10 days before the date of hearing. If such request is made the Controller ordinarily gives an opportunity for hearing.

SECTION 15 HEARING

“Where the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may refuse the application or may require the application, specification or the other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application and refuse the application on failure to do so.”

Section 15 can be read with Section 80.

SECTION 80

“Without prejudice to any provision contained in this Act requiring the Controller to hear any party to the proceedings thereunder or to give any such party an opportunity to be heard, the Controller shall give to any applicant for a patent, or for amendment of a specification (if within the prescribed time the applicant so requires) an opportunity to be heard before exercising adversely to the applicant any discretion vested in the Controller by or under this Act.

Provided that the party desiring a hearing makes the request for such hearing to the Controller at least ten days in advance of the expiry of the time-limit specified in respect of the proceeding.”

In other words, the Controller before refusing the application can offer an opportunity of personally being heard to the applicant under Natural Justice as per the provisions of the Section 15 of the Patents Act. It may be noted that unlike in Section 14 the hearing date is not linked with the last date for putting up the application in order. In other words the controller may fix a date of hearing even after the last date. In such circumstances there will be only one opportunity is given to the applicant.

RULE 129A: REQUEST FOR ADJOURNMENT OF HEARING DATE

An applicant for patent or a party to a proceeding may make a request for adjournment of the hearing with reasonable cause along with the prescribed fee prescribed in First Schedule, at least three days before the date of hearing and the Controller, if he thinks fit to do so, and upon such terms as he may direct, may adjourn the hearing and intimate the parties accordingly: Provided that no party shall be given more than two adjournments and each adjournment shall not be for more than thirty days.

NUMBERING SYSTEM OF APPLICATIONS AND REQUEST FOR EXAMINATION APPLICATIONS

Indian Patent Office follows a unique system in numbering the application for patent [Form-1] and the applications for requesting for the examination [Form – 18 / 18A]

The numbering system of Patent Applications and Request for Examination filed in the Indian Patent office is being streamlined and standardized with a view to attain uniformity in accessibility and processing of patent applications by all Patent Offices in India. Accordingly a new format of numbering has been implemented with effect 1st January 2016

The new numbering system for patent applications shall have 12 characters fixed length numeric standard patent application format applicable to all the patent offices in India and shall include identifiers of year of filing, jurisdiction, type of application and application number.

Similarly the numbering system of Request for Examination shall also be unified and standardized

For Patent Applications – Form – 1; the numbering system is as follows.

Format: YYYYJTNNNNNN

“YYYY”denotes four digit fixed length “Year of filing”

“J” denotes fixed length single digit “Jurisdiction” in numerals, wherein 1 for Delhi; 2 for Mumbai; 3 for Kolkata; and 4 for Chennai [it is based on postal index codes]

“T” denotes fixed length single digit “Type of Application” in numerals

1 for Ordinary

2 for Ordinary-Divisional

3 for Ordinary-Patent of Addition

4 for Convention Application

5 for Convention-Divisional

6 for Convention- Patent of Addition

7 for PCT National Phase Application

8 for PCT National Phase-Divisional

9 for PCT National Phase-Patent of Addition

“NNNNNN” denotes 6 digits fixed length common continuous running serial number applicable for all Patent Offices in India.

Example 1 : First Ordinary application filed in Delhi in the year 2019, then the number will be:

YYYY J T NNNNNN

2019 1 1 000001

Example 2 : If the second application is a Convention application and filed in Mumbai in 2019, then the number would be;

2019 2 4 000002

NEW NUMBERING FORMAT FOR Request for Examination in India

For Request for Examination u/r 20B(4)(1)(i)(Normal)

Format: RYYYYJNNNNNN under rule 24B(1)(i) (Normal)

“R” denotes Request for examination u/r 24(B)(1)(i)

“YYYY” denotes four digit fixed length “Year of filing”

“J” denotes fixed length single digit “Jurisdiction” in numerals, wherein 1 for Delhi; 2 for Mumbai; 3 for Kolkata; and 4 for Chennai [it is based on postal index codes]

For Request for Examination u/r 20(4)(ii)(Express)

FORMAT: XYYYYJNNNNNN

“X” denotes Request for Examination u/r 20(4)(ii)

“YYYY” denotes four digit fixed length “Year of filing”

“J” denotes fixed length single digit “Jurisdiction” in numerals, wherein 1 for Delhi; 2 for Mumbai; 3 for Kolkata; and 4 for Chennai [it is based on postal index codes]

“NNNNNN” denotes 6 digits fixed length common continuous running serial number applicable for all Patent Offices in India

Both the serial numbers u/r 24(B)(1)(i) and u/r 20(4)(ii) shall be common and shall be accompanied by the date of request for examination in YYYY/MM/DD format.

PROSECUTION OF PATENT APPLICATION

Once the complete specification is filed then the activities of publication and filing the request for examination are independent and not connected with each other. But the application is taken up for prosecution or for examination only when these activities are completed.

The Patents Rule 24B 2(i) is reproduced as here under;

(2) (i) Where the request for examination has been filed under sub-rule (1) and application has been published under section 11A, the Controller shall refer the application, specification and other documents related thereto to the examiner and such reference shall be made in the order in which the request is filed:

Provided that in case of a further application filed under section 16, the order of reference of such further application shall be the same as that of the first mentioned application:

Provided further that in case the first mentioned application has already been referred for examination, the further application shall have to be accompanied by a request for examination, and such further application shall be published within one month and be referred to the examiner within one month from the date of such publication.

When a request for examination is filed by a person interested other than the applicant, the Examination Report is sent to the applicant only, and intimation is given to the person interested.

The following paragraphs are the reproduction from the Patent Manual prepared by the Indian Patent Office under the caption “Examination”.

The patent application is referred to an Examiner by the Controller for conducting the formal as well as substantive examination as per the subject matter of the invention vis-à-vis the area of specialization of the Examiner. At present, the Patent Office has four examination groups based on the broad area of specialization viz.:

- a. Chemistry and allied subjects.
- b. Biotechnology, Microbiology and allied subjects.
- c. Electrical, Electronics & related subject
- d. Mechanical and other subjects.

The reference to the Examiner is made ordinarily within one month from the date of publication or one month from the date of request for examination, whichever is later, and is made in order in which the request is filed.

When an application is referred by the Controller, the Examiner makes a report on the patentability as well as other matters ordinarily within one month but not exceeding three months from the date of such reference.

The examiner conducts a search in the Indian Patent Database, starting from 1.1.1912, and all the patent databases of other countries such as: EPO database, WIPO database, USPTO database, JPO DATABASE, TKDL (Traditional Knowledge Digital Library) and other paid databases. In addition to the above, PCT Minimum required patent and non-patent literature is searched. The search is conducted to find out any publication which may anticipate the claimed subject matter. Another objective of the search is to ascertain whether an invention as claimed in any claims of the complete specification has been claimed in any claim of any other complete specification, filed in India, which has been published on or after the date of filing of the applicant's complete specification.

The search is conducted with respect to the date of filing of complete specification.

The examiner records in his noting, the following items:

- a. International classification.
- b. Search strategy adopted.
- c. Key word(s) used.
- d. Databases consulted for both Patent and non-Patent literature.
- e. List of search queries.
- f. Prior art findings and analysis regarding the patentability.
- g. Limitation on search if any, such as non-clarity of claims or multiplicity of inventions or any other reason due to which a reasonable search cannot be conducted.

Novelty

- a) An invention is considered as new if it is not anticipated by prior publication, prior use or prior public knowledge. An invention is new (novel) if it has not been disclosed in the prior art, where the prior art means everything that has been published, presented or otherwise disclosed to the public before the date of filing of complete specification.

- 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: 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; also the Examiner may consider such 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. The prior art should disclose the invention either in explicit or implicit manner. Mosaicing of prior art documents is not followed in the determination of novelty. A generic disclosure in the prior art may not necessarily take away the novelty of a specific disclosure. For instance, a metal spring may not take away the novelty of a copper spring. A specific disclosure in the prior art takes away the novelty of a generic disclosure. For instance, a copper spring takes away the novelty of a metal spring. 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.

INVENTIVE STEP

General principle

Inventive step is a feature of an invention that involves a technical advancement 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. An invention is patentable only if it involves one or more inventive step. In relation to the determination of patentability, an Examiner first conducts an enquiry as to the novelty of the claimed invention and then proceeds to conduct an enquiry on whether the claimed invention involves one or more inventive step.

Determination of inventive step

- a) For determination of inventive step, all or any of the prior art(s) revealed during the search process to perform an enquiry as to whether such prior art(s) disclose(s) the claimed invention, are relied upon.

b) Publications existing on the date of filing of complete specification would be considered as a prior art.

c) However, Indian Applications filed before but on or after the date of filing of complete specification of the instant application are considered as a prior claiming.

d) Invention as a whole shall be considered. In other words, it is not sufficient to draw the conclusion that a claimed invention is obvious merely because individual parts of the claim taken separately are known or might be found to be obvious.

e) If an invention lies merely in verifying the previous predictions, without substantially adding anything for technical advancement or economic significance in the art, the inventive step is lacking.

f) For the purpose of establishing obviousness of the invention, citing a mosaic of prior arts is permissible, provided such prior art is enabling.

g) If the invention is predictable based on the available prior art, merely requiring workshop improvement by a person skilled in the art, the inventive step is lacking.

INDUSTRIAL APPLICABILITY

1. In order for an invention to be patentable, an invention must be capable of industrial application. Industrial Application in relation to patentability means that the invention is capable of being made or used in an industry.

2. The Examiner shall assess if the claimed invention is capable of use in any industry or made using an industrial process. Typically, the specification explains the industrial applicability of the disclosed invention in a self-evident manner. Usually industrial applicability is self-evident. If it is not, a mere suggestion that the matter would be industrially applicable is not sufficient. A specific utility should be indicated in the specification supported by the disclosure. For example, indicating that a compound may be useful in treating unspecified disorders, or that the compound has—useful biological properties, would not be sufficient to define a specific utility for the compound. The specific usefulness has to be indicated.

STATUTORY EXCLUSIONS OR INVENTIONS THAT ARE NOT PATENTABLE

Sections 3 and 4 of the Indian Patents Act define inventions that are not patentable.

Under the Patents Act, 1970, the following are not inventions and hence are not considered to be patentable. However, examples given are mere illustrations and may not be conclusive on the subject. Objective decisions may be taken on case to case basis.

(a) an invention which is frivolous or which claims anything obviously contrary to well established laws. Some examples of a frivolous nature and contrary to natural laws are:-

- ☐ A machine purporting to produce perpetual motion.
- ☐ A machine alleged to be giving output without any input.
- ☐ A machine allegedly giving 100% efficiency

(b) an invention, the primary or intended use or commercial exploitation of which would be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment,

Some examples are;

- (i). Any device, apparatus or machine or method for committing theft/burglary.
 - (ii). Any machine or method for counterfeiting of currency notes.
 - (iii) Any device or method for gambling.
 - (iv) An invention the use of which can cause serious prejudice to human beings, plants and animals.
 - (v) Inventions, the intended use or commercial exploitation of which is found to be injurious to public, animal or plant life or health, such as, a method of adulteration of food.
 - (vi). An invention, the primary or intended use of which is likely to violate the well accepted and settled social, cultural, legal norms of morality, e.g. a method for cloning of humans.
 - (vii) An invention, the primary or proposed use of which would disturb the public order e.g. a device for house-breaking.
 - (viii) However, if the primary or intended purpose or commercial exploitation of a claimed invention is not causing serious prejudice to human, animal or plant life or health or to the environment, such subject matter may be considered to be an invention and may be patentable. For instance, a pesticide.
- (c) The mere discovery of a scientific principle or the formulation of or discovery of any living thing or non-living substance occurring in nature.
- i) A claim for discovery of scientific principle is not to be an invention, but such a principle when used with a process of manufacture resulting in a substance or an article may be considered to be an invention.

ii) A scientific theory is a statement about the natural world. These theories themselves are not considered to be inventions, no matter how radical or revolutionary an insight they may provide, since they do not result in a product or process. However, if the theory leads to practical application in the process of manufacture of an article or substance, it may well be patentable. A claim for formulation of abstract theory is not considered to be an invention. For example, the fact that a known material or article is found to have a hitherto unknown property is a discovery and not an invention. But if the discovery leads to the conclusion that the material can be used for making a particular article or in a particular process, then the article or process could be considered to be an invention.

iii) Finding out that a particular known material is able to withstand mechanical shock is a discovery and therefore not patentable, but a claim to a railway sleeper made of the material would not fall foul of exclusion, and would be allowable if it passed the tests for novelty and inventive step. Similarly, finding a new substance or micro-organism occurring freely in nature is a discovery and not an invention.

- (d) The mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or the new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

EXPLANATION:

For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy.

According to this provision, the following are not inventions and hence not patentable:

- (i) mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance;
- (ii) the mere discovery of any new property of a known substance;
- (iii) the mere discovery of new use for a known substance;
- (iv) the mere use of a known process unless such known process results in a new product or employs at least one new reactant;
- (v) the mere use of a known machine or apparatus.

The explanation to Section 3(d) further clarifies that the salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance may be considered to be the same substance. It however

states that such salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of such known substance may be considered as patentable only if they differ significantly in properties with regard to efficacy.

The Examiner on a case to case basis applies the test as to what constitutes such salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives to differ significantly in properties with regard to efficacy from the known substance. The complete specification may bring out clearly and categorically in the description, as to how the subject matter differs significantly in properties with regard to efficacy from the known substance thereof, at the time of filing of the application or subsequently by way of an amendment of specification under section 59.

In a recent case in relation to a pharmaceutical substance, the Madras High Court held that efficacy means therapeutic efficacy. It was held that:—going by the meaning for the word “efficacy” and “therapeutic”... what the patent applicant is expected to show is, how effective the new discovery made would be in healing a disease having a good effect on the body? In other words, the patent applicant is definitely aware as to what is the “therapeutic effect” of the drug for which he had already got a patent and what is the difference between the therapeutic effect of the patented drug and the drug in respect of which patent is asked for.”“Due to the advanced technology in all fields of science, it is possible to show by giving necessary comparative details based on such science that the discovery of a new form of a known substance had resulted in the enhancement of the known efficacy of the original substance and the derivatives so derived will not be the same substance, since the properties of the derivatives differ significantly with regard to efficacy.” (Novartis AG Vs. Union of India, W.P. No. 24760/06).

- (e) A substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance.

An admixture resulting in synergistic properties is not considered as mere admixture, e.g., a soap, detergent, lubricant and polymer composition etc, and hence may be considered to be patentable.

A mere aggregation of features must be distinguished from a combination invention. The existence of a combination invention requires that the relationship between the features or groups of features be one of functional reciprocity or that they show a combinative effect beyond the sum of their individual effects. The features should be functionally linked together which is the actual characteristic of a combination invention.

In general all the substances which are produced by mere admixing, or a process of producing such substances should satisfy the requirement of synergistic effect in order to be patentable.

Synergistic effect should be clearly brought out in the description by way of comparison at the time of filing of the Application itself. The subsequent submissions regarding synergism can be accepted in a reply to the office action as a further support of synergy. However, such submitted data may be incorporated in the Specification, subject to the provisions of Section 59

- (f) The mere arrangement or rearrangement or duplication of known devices each functioning independently of one another in a known way.

In order to be patentable, an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy the test of invention or an 'inventive step'. To be patentable, the improvement or the combination must produce a new result, or a new article or a better or cheaper article than before. A combination of old known integers may be so combined that by their working inter-relation, they produce a new process or an improved result. Mere collocation of more than one integers or things, not involving the exercise of any inventive faculty, does not qualify for the grant of a patent. (Biswanath Prasad Radhey Shyam Vs. Hindustan Metal Industries (1979) 2 SCC, 511).

A new and useful application of an old principle may be good subject-matter. An improvement on something known may also afford subject-matter; so also a different combination of matters already known. A patentable combination is one in which the component elements are so combined as to produce a new result or arrive at an old result in a better or more expeditious or more economical manner. If the result produced by the combination is either a new article or a better or cheaper article than before, the combination may afford subject-matter of a patent. (Lallubhai Chakubhai Vs. Chimanlal and Co. (AIR 1936 Bom 99.)

An invention claiming a mere juxtaposition of known devices in which each device functions independently is not considered patentable. Merely placing side-by-side old integers so that each performs its own function independently of the others is not a patentable combination.

[As for example: a flour mill provided with sieving means].

However, where the old integers when placed together have some working interrelation, producing a new or improved result, then there could be a patentable subject matter in the working interrelation brought about by the collection of the integers.

When two or more features of an apparatus or device are known, and they are juxtaposed without any interdependence on their functioning, they should be held to have been already known. (Rampratap v. Bhabha Atomic Research Center, 1976 IPLR 28 P. 35), e.g., an umbrella with fan (388/Bom/73), bucket fitted with torch, clock and transistor in a single cabinet. These are not patentable, since they are nothing but mere arrangement and rearrangement of items without

having any working interrelationship between them and are devices capable of functioning independently of each other.

As for instance, in the case of an application for a patent in respect of an apparatus for producing metallic bellows, the hydraulic machine and the roll forming machine disclosed therein were functioning as separate machines independently of each other and as such had no novel feature. Hence, there is no invention when a claim is made on known types of hydraulic forming and roll forming machines functioning independently of each other.

A new combination may be the subject matter of a patent although every part of the combination, per se, is old, for here the new article is not the parts themselves but the assembling and working of the parts, together. The merit of a new combination very much depends upon the result produced. Where a slight alteration turns that which was practically useless into what is useful and important, it is fit subject matter for a patent. (Lallubhai Chakkubhai v. Shamaldas Sankalchand Shah, AIR 1934 Bom 407).

(g) Section 3(g) was deleted which was read

A method or process of testing applicable during the process of manufacture for rendering the machine, apparatus or other equipment more efficient or for the improvement or restoration of existing machine, apparatus or other equipment or for the improvement or control of manufacture.

(h) A method of agriculture or horticulture.

Examples of subject matters excluded from patentability under this provision are:

- (i) A method of producing a plant, even if it involved a modification of the conditions under which natural phenomena would pursue their inevitable course (for instance a greenhouse).
- (ii) A method of producing improved soil from the soil with nematodes by treating the soil with a preparation containing specified phosphorathioates.
- (iii) A method of producing mushrooms.
- (iv) A method for cultivation of algae
- (i) Any process for the medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products.

This provision excludes from patentability, the following:

- (i) Medicinal methods: As for example a process of administering medicines orally, or through injectables, or topically or through a dermal patch.
- (ii) Surgical methods: As for example a stitch-free incision for cataract removal.
- (iii) Curative methods: As for example a method of cleaning plaque from teeth.
- (iv) Prophylactic methods: As for example a method of vaccination.

(v) Diagnostic methods: Diagnosis is the identification of the nature of a medical illness, usually by investigating its history and symptoms and by applying tests. Determination of the general physical state of an individual (e.g. a fitness test) is considered to be diagnostic.

(vi) Therapeutic methods: The term “therapy” includes prevention as well as treatment or cure of disease. Therefore, the process relating to therapy may be considered as a method of treatment and as such not patentable.

(vii) Any method of treatment of animal to render them free of disease or to increase their economic value or that of their products. As for example, a method of treating sheep for increasing wool yield or a method of artificially inducing the body mass of poultry.

(viii) Further examples of subject matters excluded under this provision are: any operation on the body, which requires the skill and knowledge of a surgeon and includes treatments such as cosmetic treatment, the termination of pregnancy, castration, sterilization, artificial insemination, embryo transplants, treatments for experimental and research purposes and the removal of organs, skin or bone marrow from a living donor, any therapy or diagnosis practiced on the human or animal body and further includes methods of abortion, induction of labour, control of estrus or menstrual regulation.

(ix) Application of substances to the body for purely cosmetic purposes is not therapy.

(x) Patent may however be obtained for surgical, therapeutic or diagnostic instrument or apparatus. Also the manufacture of prostheses or artificial limbs and taking measurements thereof on the human body are patentable.

- (j) Plants and animals in whole or any part thereof other than microorganisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals.

The subject matters excluded under this provision are:

(a) plants in whole or in part

(b) animals in whole or in part

(c) seeds

(d) varieties and species of plants and animals

(e) essentially biological process(es) for production or propagation of plants and animals. Microorganisms, other than the ones discovered from the nature, may be patentable. For instance, genetically modified microorganisms may be patentable subject to other requirements of Patentability.

A new process of preparation of a vaccine under specific scientific conditions, the vaccine useful for protecting poultry against contagious bursitis infection was held to be patentable by the Court

on the ratio that the statute does not make a manner of manufacture as un-patentable even if the end products contains a living organism. (Dimminaco – A.G. Vs. Controller of Patents & Designs and Others). Plant varieties are provided protection in India under the provisions of the Protection of Plant Varieties and Farmers' Rights Act, 2002.

- (k) A mathematical or business method or a computer program per se or algorithms.
- (i). Under this provision, mathematical methods, business methods, computer programmes per se and algorithms are not considered as patentable subject matter.
 - (ii). Mathematical methods are considered to be acts of mental skill. A method of calculation, formulation of equations, finding square roots, cube roots and all other methods directly involving mathematical methods are therefore not patentable. With the development in computer technology, mathematical methods are used for writing algorithms and computer programs for different applications and the claimed invention is sometimes camouflaged as one relating to the technological development rather than the mathematical method itself. These methods, claimed in any form, are considered to be not patentable.
 - (iii) —Business Methods claimed in any form are not patentable subject matter. The term Business Methods involves whole gamut of activities in a commercial or industrial enterprise relating to transaction of goods or services. With the development of technology, business activities have grown tremendously through e-commerce and related B2B and B2C business transactions. The claims are at times drafted not directly as business methods but apparently with some technical features such as internet, networks, satellites, telecommunications etc. This exclusion applies to all business methods and, therefore, if in substance the claims relate to business methods, even with the help of technology, they are not considered to be a patentable subject matter.
 - (iv) Algorithms in all forms including but not limited to, a set of rules or procedures or any sequence of steps or any method expressed by way of a finite list of defined instructions, whether for solving a problem or otherwise, and whether employing a logical, arithmetical or computational method, recursive or otherwise, are excluded from patentability.
 - (v) Patent applications, with computer programme as a subject matter, are first examined with respect to (b), (c) and (d) above. If the subject matter of an application does not fall under these categories, then, the subject matter is examined with a view to decide whether it is a computer programme per se.
 - (vi) If the claimed subject matter in a patent application is only a computer programme, it is considered as a computer programme per se and hence not patentable. Claims directed at computer programme products are computer programmes per se stored in a computer readable medium and as such are not allowable. Even if the claims, inter alia, contain a subject matter

which is not a computer programme, it is examined whether such subject matter is sufficiently disclosed in the specification and forms an essential part of the invention.

(vii) If the subject matter of a patent application is not found excluded under the foregoing provisions, it shall be examined with respect to other criteria of patentability

- (l) A literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions

Writings, music, works of fine arts, paintings, sculptures, computer programmes, electronic databases, books, pamphlets, lectures, addresses, sermons, dramatic-musical works, choreographic works, cinematographic works, drawings, architecture, engravings, lithography, photographic works, applied art, illustrations, maps, plans, sketches, three-dimensional works relating to geography, topography, translations, adaptations, arrangements of music, multimedia productions, etc. are not patentable. Such works fall within the domain of the Copyright Act, 1957.

- (m) A mere scheme or rule or method of performing mental act or method playing game.

A mere scheme or rule or method of performing mental act or method of playing game, are excluded from patentability, because they are considered as outcome of mere mental process. For example,

(i). Method of playing chess.

(ii) Method of teaching.

(iii) Method of learning

- (n) A presentation of information.

Any manner, means or method of expressing information whether visual, audible or tangible by words, codes, signals, symbols, diagrams or any other mode of representation is not patentable. For example, a speech instruction means in the form of printed text where horizontal underlining indicated stress and vertical separating lines divided the works into rhythmic groups is not patentable. For instance, railway time table, 100years calendar etc.

In the matter of application No. 94/Cal/2002, the Controller held that the Patent system was meant for protecting only one kind of creativity i.e. technological creativity and since the claimed invention relates to business method and method of presenting information, it is not allowed.

- (o) Topography of Integrated circuits.

Since protection of Layout Designs of Integrated Circuits is governed separately under the Semiconductor Integrated Circuit Lay-out Designs Act, 2000, three-dimensional configuration of the electronic circuits used in microchips and semiconductor chips is not patentable.

- (p) An invention which, in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components.

Traditional Knowledge, being knowledge already existing, is not patentable. An example is the antiseptic properties of turmeric for wound healing. Another example is the pesticidal and insecticidal properties of neem.

The Examiner conducts an investigation by using the Traditional Knowledge Digital Library (TKDL) and other resources to decide as to whether the claimed subject matter falls within the purview of this provision.

SECTION 4

No patent shall be granted in respect of an invention relating to atomic energy falling within sub-section (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962).

Special provision as to inventions under the provisions of Section 20 of the Atomic Energy Act 1962;

As from the commencement of this Act, no patents shall be granted for inventions which in the opinion of the Central Government are useful for or relate to the production, control, use or disposal of atomic energy or the prospecting, mining, extraction, production, physical and chemical treatment, fabrication, enrichment, canning or use of any prescribed substance or radioactive substance or the ensuring of safety in atomic energy operations.

Please refer to

https://upload.indiacode.nic.in/showfile?actid=AC_CEN_38_63_00001_196233_1517807321654&type=notification&filename=Notification%20on%20List%20of%20Prescribed%20substances,%20Prescribed%20Equipment%20and%20Technology.pdf for the list of prescribed substance or radioactive substance.

The prohibition under sub-section (1) shall also apply to any invention of the nature specified in that sub-section in respect of which an application for the grant of a patent has been made to the Controller of Patents and Designs appointed under the Indian Patents and Designs Act, 1911, before the commencement of this Act and is pending with him at such commencement.

The Central Government shall have the power to inspect at any time any pending patent application and specification before its acceptance and if it considers that the invention relates to atomic energy, to issue directions to the Controller of Patents and Designs to refuse the application on that ground.

Any person, who has made an invention which he has reason to believe relates to atomic energy, shall communicate to the Central Government the nature and description of the invention.

Any person desiring to apply for a patent abroad for an invention relating to or which he has reason to believe relates to atomic energy shall obtain prior permission from the Central Government before making the application abroad or communicating the invention to any person abroad, unless three months have elapsed since his request for permission was made to the Central Government and no reply was received by him.

The Controller of Patents and Designs shall have the power to refer any application to the Central Government for direction as to whether the invention is one relating to atomic energy and the direction given by the Central Government shall be final.

Any invention in the field of atomic energy conceived whether in establishments controlled by the Central Government or under any contract, sub-contract, arrangement or other relationship with the Central Government shall be deemed to have been made or conceived by the Central Government, irrespective of whether such contract, sub-contract, arrangement or other relationship involves financial participation of or assistance from the Central Government.

Notwithstanding anything contained in the Indian Patents and Designs Act, 1911, the decision of the Central Government on points connected with or arising out of this section shall be final.

3. PUBLICATIONS

PUBLICATION OF INFORMATION UNDER VARIOUS SECTIONS & RULES

Section 11A

- (i) Every application for a patent shall, on the expiry of the period of 18 months, is 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 18 month period.
- (ii) The applicant may request for early publication by filing Form-9 along with the requisite fee. The publication will be done as early as possible after allowing such request.
- (iii) 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 of 18 months or when the secrecy direction has ceased to operate, whichever is later.

- (iv) 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.
- (v) 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.
- (vi) 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:

SUMMARY OF 11A

Date of filing is the date of filing either provisional or complete specification

First publication in the patent journal is as soon as at the expiry of 18 months from the date of filing

The period of 18 month can be shortened by filing Form– 9. Ordinarily published within ONE month from the expiry period

No Publication when secrecy is clamped or abandoned under S 9(1) or application is withdrawn within 15 months from the date of filing.

Effect of 18 month publication are

- (a) The patent specification opens to public
- (b) the depository institution shall make the biological material mentioned in the specification available to the public
- (c) open invitation to file pre-grant opposition by way of representation by any person within 6 months from the date of publication or before the date of grant whichever is later.
- (d) Loss of Novelty, therefore the applicant cannot re-file the application, if abandoned by the applicant either not filing the request for examination or not filing a reply to the examination report.

RULE 24 OF THE INDIAN PATENTS RULES

The period for which an application for patent shall not ordinarily be open to public under sub-section (1) of section 11A shall be eighteen months from the date of filing of application or the date of priority of the application, whichever is earlier

Provided that the period within which the Controller shall publish the application in the journal shall ordinarily be one month from the date of expiry of said period, or one month from the date of request for publication under rule 24A.

RULE 24A OF THE INDIAN PATENTS RULES

A request for publication under sub-section (2) of section 11 A shall be made in Form 9.

RULE 25 OF THE INDIAN PATENTS RULES

Identification of published applications

Publication of application under sub-sections (2) and (5) of section 11A shall be identified by the letter 'A' along with the number of application.

POST GRANT PUBLICATION

SECTION 43(2): “On the grant of patent, the Controller shall publish the fact that the patent has been granted and thereupon the application, specification and other documents related thereto shall be open for public inspection.”

Effect of Post-grant publication:

The fact of grant of patent will be published in the patent journal as soon as patent is granted

The applicant / patentee is entitled to institute any proceedings for infringement with retrospective effect from the 18 month publication

Post-grant opposition can be filed within 12 months from the date of publication of grant of patent.

PART OF SECTION 36: REVOCATION OF SECRECY DIRECTION ON A PUBLICATION OUTSIDE INDIA

In case of an application filed by a foreign applicant it is found that the invention is published outside India it shall forthwith give notice to the Controller to revoke the direction and the Controllers shall thereupon revoke the directions previously given by him.

SECTION 57 (3): PROPOSED AMENDMENTS TO A PATENT APPLICATION OR TO A PATENT

(3) Any application for leave to amend an application for a patent or a complete specification or a document related thereto under this section made after the grant of patent and the nature of the proposed amendment may be published.

RULE 83 OF THE INDIAN PATENTS RULES

The amendments allowed after a patent has been granted, shall be published.

PART OF SECTION 61: PUBLICATION FOR RESTORATION OF LAPSED PATENTS

If, after hearing the applicant in cases where the applicant so desires or the Controller thinks fit, the Controller is prima facie satisfied that the failure to pay the renewal fee was unintentional and that there has been no undue delay in the making of the application, he **shall publish** the application in the prescribed manner; and within the prescribed period any person interested may give notice to the Controller of opposition thereto on either or both of the following grounds, that is to say,—

- (a) that the failure to pay the renewal fee was not unintentional; or
- (b) that there has been undue delay in the making of the application.

RULE 86 OF THE INDIAN PATENTS RULES - PAYMENT OF UNPAID RENEWAL FEES

(1) Where the Controller decides in favour of the applicant, the applicant shall pay the unpaid renewal fees and the additional fee specified in the First Schedule, within a month from the date of the order of the Controller allowing the application for restoration.

(2) The Controller shall publish his decision.

PART OF SECTION 63: PUBLICATION FOR OFFER TO SURRENDER OF PATENTS

Where such an offer is made, the Controller shall publish the offer in the prescribed manner, and also notify every person other than the patentee whose name appears in the register as having an interest in the patent.

RULE 87 OF THE INDIAN PATENTS RULES – SURRENDER OF PATENTS

(1) The Controller **shall publish the notice of an offer** given under section 63.

(2) Any person interested may, within three months from the date of publication of the notice, give notice of opposition to the Controller in Form 14 in duplicate.

(3) The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 63 as they apply to the hearing in opposition proceeding.

(4) If the Controller accepts the patentee's offer to surrender the patent, he may direct the patentee to return the patent, and on receipt of such patent, the Controller shall by order revoke it **and publish the revocation of the patent.**

SECTION 78(4): PUBLICATION REGARDING CORRECTION OF ANY ERROR IN PATENT

(4) Where a request is made under this section for the correction of any error in a patent or application for a patent or any document filed in pursuance of such an application, and it appears to the Controller that **the correction would materially alter the meaning or scope of the document** to which the request relates and ought not to be made without notice to persons affected thereby, he shall require notice of the nature of **the proposed correction to be published** in the prescribed manner.

SECTION 102(1): ACQUISITION OF INVENTION AND PATENTS BY THE CENTRAL GOVERNMENT.

(1) The Central Government may, if satisfied that it is necessary that an invention which is the subject of an application for a patent or a **patent should be acquired from the applicant or the patentee for a public purpose, publish a notification to that effect in the Official Gazette**, and thereupon the invention or patent and all rights in respect of the invention or patent shall, by force of this section, stand transferred to and be vested in the Central Government.

NO OPPOSITION IS ALLOWED.

SECTION 146: POWER OF CONTROLLER TO CALL FOR INFORMATION FROM PATENTEES

PUBLICATION OF FORM-27 DETAILS

(1) The Controller may, at any time during the continuance of the patent, by notice in writing, require a patentee or a licensee, exclusive or otherwise, to furnish to him within two months from the date of such notice or within such further time as the Controller may allow, such information or such periodical statements as to the extent to which the patented invention has been commercially worked in India as may be specified in the notice.

(2) Without prejudice to the provisions of sub-section (1), every patentee and every licensee (whether exclusive or otherwise) shall furnish in such manner and form and at such intervals (not being less than

six months) as may be prescribed statements as to the extent to which the patented invention has been worked on a commercial scale in India.

(3) The Controller may publish the information received by him under sub-section (1) or sub-section (2) in such manner as may be prescribed.

RULE 131: FORM AND MANNER IN WHICH STATEMENTS REQUIRED UNDER SECTION 146(2) TO BE FURNISHED

(1) The statements shall be furnished by every patentee and every licensee under sub-section (2) of section 146 in Form 27 which shall be duly verified by the patentee or the licensee or his authorised agent.

(2) The statements referred to in sub-rule (1) shall be furnished in respect of every calendar year within three months of the end of each year.

(3) The Controller **may publish the information received by him** under sub-section (1) or sub-section (2) of section 146.

NO CONSEQUENTIAL ACTION AFTER PUBLICATION. The data is useful on knowing the facts about working of patents in India.

RULE 99: MANNER OF PUBLICATION OF THE REVOCATION ORDER

The Controller **shall publish** the order made by him **under sub-section (3) of section 85 revoking a patent.**

SECTION 85: REVOCATION OF PATENTS BY THE CONTROLLER FOR NON-WORKING

(3) The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied or that patented invention has not been worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price, may make an order revoking the patent.

RULE 117: RESTORATION OF NAME OF PERSONS REMOVED FROM THE REGISTER OF PATENT AGENTS – PUBLICATION IN OFFICIAL WEB SITE ONLY

(1) An application for the restoration of the name of any person removed from the register of patent agents under sub-section (2) of section 130 shall be made in Form 23 within two months from the date of such removal.

(2) If the name of a person is restored to the register of patent agents, his name shall be continued therein for a period of one year from the date on which his last annual fee became due.

(3) The restoration of a name to the register of patent agents shall be communicated to the patent agent and also **published on the official website.**

RULE 120: PUBLICATION OF NAMES OF PATENT AGENTS, REGISTERED UNDER THE ACT

The names and addresses of persons registered as patent agents shall from time to time **be published.**

4. Opposition

The word “OPPOSITION” as far as the patents are concerned is referred to cancellation or revocation of a granted patent. In the Indian Patents Act there are provisions to oppose other than the patent application either in the pre-grant and post-grant. Pre-grant, Post-grant and revocation proceedings are mainly known and discussed. The other provisions are; for example, (a) opposing the allowed amendments to a specification at post grant stage, (b) opposing the restoration of lapsed patents, (c) opposing the offer of surrendering a patent and the like. All types of oppositions are discussed here.

Opposition to a patent application can be filed before the grant of patent which is known as Pre-grant Opposition. Opposition also can be filed within non-extendable time limit of 12 months from the date of publication of grant under the provisions of the Section 43(2) which is known as Post-grant Opposition. After the expiry of 12 month period from the date of publication of grant, if any person desires to invalidate a patent may file for Revocation of Patent before IPAB or as a counter in an infringement suit in any Court. Section 26 deals exclusively with the first ground of Post-grant opposition wherein the applicant has been proved to have wrongfully obtained the invention from the original inventor or any authorized person of the said inventor.

Opposition whether it is Pre-grant or Post-grant or Revocation of Patent can be filed only on the specified grounds as provided in the Indian Patents Act. Both Pre-grant and Post-grant opposition have substantially similar common grounds whereas the grounds for Revocation of Patent are slightly different and elaborate in contrast to the grounds for Pre and Post grant opposition.

SECTION 25(1): GROUNDS FOR PRE- GRANT OPPOSITION

(1) Where an application for a patent has been published **but a patent has not been granted**, any person may, in writing, represent by way of opposition to the Controller against the grant of patent on the ground—

(a) that the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim—

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document:

Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 29;

(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant's claim;

(d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

Explanation.—For the purposes of this clause, an invention relating to a process for which a patent is claimed shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only;

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the applicant's claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(h) that the applicant has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge;

(i) that in the case of a convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title;

(j) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;

(k) that the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere,

but on no other ground,

and the Controller shall, if requested by such person for being heard, hear him and dispose of such representation in such manner and within such period as may be prescribed.

RULE 55: OPPOSITION PROCEEDINGS UNDER PRE-GRANT OPPOSITION

(1) Representation for opposition under sub-section (1) of section 25 shall be filed in Form 7(A) at the appropriate office with a copy to the applicant, and shall include a statement and evidence, if any, in support of the representation and a request for hearing, if so desired.

(1A) Notwithstanding anything contained in sub-rule (1), no patent shall be granted before the expiry of a period of six months from the date of publication of the application under section 11 A.

(2) The Controller shall consider such representation only when a request for examination of the application has been filed.

(3) On consideration of the representation if the Controller is of the opinion that application for patent shall be refused or the complete specification requires amendment, he shall give a notice to the applicant to that effect.

(4) On receiving the notice under sub-rule (3), the applicant shall, if he so desires, file his statement and evidence, if any, in support of his application within three months from the date of the notice, with a copy to the opponent.

(5) On consideration of the statement and evidence filed by the applicant, the representation including the statement and evidence filed by the opponent, submissions made by the parties, and after hearing the

parties, if so requested, the Controller may either reject the representation or require the complete specification and other documents to be amended to his satisfaction before the patent is granted or refuse to grant a patent on the application, by passing a speaking order to simultaneously decide on the application and the representation ordinarily within one month from the completion of above proceedings.

SECTION 25(2): GROUNDS FOR POST- GRANT OPPOSITION

At any time after the grant of patent but before the expiry of a period of one year from the date of publication of grant of a patent, any person interested may give notice of opposition to the Controller in the prescribed manner on any of the following grounds, namely:—

(a) that the patentee or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim—

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document: Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 29;

(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the claim of the patentee and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the claim of the patentee;

(d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

Explanation.—For the purposes of this clause, an invention relating to a process for which a patent is granted shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only;

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(h) that the patentee has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge;

(i) that in the case of a patent granted on a convention application, the application for patent was not made within twelve months from the date of the first application for protection for the invention made in a convention country or in India by the patentee or a person from whom he derives title;

(j) that the complete specification does not disclose or wrongly mentions the source and geographical origin of biological material used for the invention;

(k) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere,

but on no other ground.

RULES 55A TO 63 OF THE INDIAN PATENTS RULES: PROCEDURE FOR POST-GRANT OPPOSITION

RULE 55A: FILING OF NOTICE OF OPPOSITION

The notice of opposition to be given under sub-section (2) of section 25 shall be made in Form 7 and sent to the Controller in duplicate at the appropriate office.

RULE 56: CONSTITUTION OF OPPOSITION BOARD AND ITS PROCEEDING

(1) On receipt of notice of opposition under rule 55A, the Controller shall, by order, constitute an Opposition Board consisting of three members and nominate one of the members as the Chairman of the Board.

(2) An examiner appointed under sub-section (2) of section 73 shall be eligible to be a member of the Opposition Board.

(3) The examiner, who has dealt with the application for patent during the proceeding for grant of patent, thereon shall not be eligible as member of Opposition Board as specified in sub-rule (2) for that application.

(4) The Opposition Board shall conduct the examination of the notice of opposition along with documents filed under rules 57 to 60 referred to under sub-section (3) of section 25, submit a report with reasons on each ground taken in the notice of opposition with its joint recommendation within three months from the date on which the documents were forwarded to them.

RULE 57: FILING OF WRITTEN STATEMENT OF OPPOSITION AND EVIDENCE

The opponent shall send a written statement in duplicate setting out the nature of the opponent's interest, the facts upon which he bases his case and relief which he seeks and evidence, if any, along with notice of opposition and shall deliver to the patentee a copy of the statement and the evidence, if any.

RULE 58: FILING OF REPLY STATEMENT AND EVIDENCE

(1) If the patentee desires to contest the opposition, he shall leave at the appropriate office a reply statement setting out fully the grounds upon which the opposition is contested and evidence, if any, in support of his case within a period of two months from the date of receipt of the copy of the written statement and Opponent's evidence, if any by him under rule 57 and deliver to the opponent a copy thereof.

(2) If the patentee does not desire to contest or leave his reply and evidence within the period as specified in sub-rule (1), the patent shall be deemed to have been revoked.

RULE 59: FILING OF REPLY EVIDENCE BY OPPONENT

The opponent may, within one month from the date of delivery to him of a copy of the patentee's reply statement and evidence under rule 58, leave at the appropriate office evidence in reply strictly confined to matters in the patentee's evidence and shall deliver to the patentee a copy of such evidence.

RULE 60: FURTHER EVIDENCE TO BE LEFT WITH THE LEAVE OF THE CONTROLLER

No further evidence shall be delivered by either party except with the leave or directions of the Controller: Provided that such leave or direction is prayed before the Controller has fixed the hearing under rule 62.

RULE 61: COPIES OF DOCUMENTS TO BE SUPPLIED

(1) Copies of all documents referred to in the notice of opposition or in any statement or evidence filed in connection with the opposition and authenticated to the satisfaction of the Controller, shall be simultaneously furnished in duplicate unless the Controller otherwise directs.

(2) Where a specification or other document in a language other than English is referred to in the notice, statement or evidence, an attested translation thereof, in duplicate, in English shall be furnished along with such notice, statement or evidence, as the case may be.

RULE 62: HEARING

(1) On the completion of the presentation of evidence, if any, and on receiving the recommendation of Opposition Board or at such other time as the Controller may think fit, he shall fix a date and time for the hearing of the opposition and shall give the parties not less than ten days' notice of such hearing and may require members of Opposition Board to be present in the hearing.

(2) If either party to the proceeding desires to be heard, he shall inform the Controller by a notice along with the fee as specified in the First Schedule.

(3) The Controller may refuse to hear any party who has not given notice under sub-rule (2).

(4) If either party intends to rely on any publication at the hearing not already mentioned in the notice, statement or evidence, he shall give to the other party and to the Controller not less than five days' notice of his intention, together with details of such publication.

(5) After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing, and after taking into consideration the recommendation of Opposition Board, the Controller shall decide the opposition and notify his decision to the parties giving reasons therefor.

RULE 63: DETERMINATION OF COSTS

If the patentee notifies the Controller that he desires to withdraw the patent after notice of opposition is given, the Controller, depending on the merits of the case, may decide whether costs should be awarded to the opponent.

OPPOSITION IN CASE OF OBTAINING

Section 26 deals with both Pre-grant and Post-grant opposition in deciding the case with respect to the first ground of the specified objections as specified both in Sections 25(1) and 25(2) of the Indian Patents Act. The said ground of opposition is “WRONGFUL OBTAINMENT OF INVENTION”.

The wrongful obtained information can be full information of a patent or a part of it. Therefore the Patents Act provides an opportunity to the applicant or patentee to amend the specification by deleting the portion of wrongly obtained information upon a proof that indeed the said information is wrongfully obtained from a person other than the applicant or patentee. Assuming that the said other person [second applicant] from whom the information was wrongfully obtained files a patent application either before

initiating the opposition proceedings or during the opposition proceedings but filed after the filing of the applicant or patentee [first applicant] who has wrongfully obtained the full or part of the information then the claims of the second applicant will have the date of priority of the first applicant for Novelty assessment and the remaining patentability criteria and examination prosecution is done in usual manner.

SECTION 26: IN CASES OF “OBTAINING” Controller may treat the patent as the patent of Opponent.

(1) Where in any opposition proceeding under this Act the Controller finds that—

(a) the invention, so far as claimed in any claim of the complete specification, was obtained from the opponent in the manner set out in clause (a) of sub-section (2) of section 25 and revokes the patent on that ground, he may, on request by such opponent made in the prescribed manner, direct that the patent shall stand amended in the name of the opponent;

(b) a part of an invention described in the complete specification was so obtained from the opponent, he may pass an order requiring that the specification be amended by the exclusion of that part of the invention.

(2) Where an opponent has, before the date of the order of the Controller requiring the amendment of a complete specification referred to in clause (b) of sub-section (1), filed an application for a patent for an invention which included the whole or a part of the invention held to have been obtained from him and such application is pending, the Controller may treat such application and specification in so far as they relate to the invention held to have been obtained from him, as having been filed, for the purposes of this Act relating to the priority dates of claims of the complete specification, on the date on which the corresponding document was or was deemed to have been filed by the patentee in the earlier application but for all other purposes the application of the opponent shall be proceeded with as an application for a patent under this Act.

RULE 63A: REQUEST MADE UNDER SECTION 26(1)

Request under section 26(1) shall be made on Form 12 within three months from the date of the order of the Controller and shall be accompanied by a statement setting out the facts upon which the petitioner relies and relief he claims.

OPPOSITION PROCEEDINGS OTHER THAN PRE-GRANT, POST-GRANT AND REVOCATION

(a) OPPOSITION PROCEEDINGS UNDER SECTION 78: **Power of Controller to correct clerical errors etc.**

(1) Without prejudice to the provisions contained in sections 57 and 59 as regards amendment of applications for patents or complete specifications or other documents related thereto and subject to the provisions of section 44, the Controller may, in accordance with the provisions of this section, correct any clerical error in any patent or in any specification or other document filed in pursuance of such application or in any application for a patent or any clerical error in any matter which is entered in the register.

(2) A correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.

(3) Where the Controller proposes to make any such correction as aforesaid otherwise than in pursuance of a request made under this section, he shall give notice of the proposal to the patentee or the applicant for the patent, as the case may be, and to any other person who appears to him to be concerned, and shall give them an opportunity to be heard before making the correction.

(4) Where a request is made under this section for the correction of any error in a patent or application for a patent or any document filed in pursuance of such an application, and it appears to the Controller that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons affected thereby, he shall require notice of the nature of the proposed correction to be published in the prescribed manner.

(5) Within the prescribed time after any such publication as aforesaid any person interested may give notice to the Controller of opposition to the request, and, where such notice of opposition is given, the Controller shall give notice thereof to the person by whom the request was made, and shall give to him and to the opponent an opportunity to be heard before he decides the case.

PROCEDURAL ASPECTS UNDER OPPOSITION AGAINST THE PROPOSED AMENDMENT OF CLERICAL ERRORS UNDER SECTION 78

RULE 124: MANNER AND TIME OF OPPOSITION TO THE MAKING OF CORRECTIONS

(1) Any person interested may, at any time, **within three months from the date of the advertisement of the request for correction** give notice of opposition to the Controller in **Form 14** in duplicate.

(2) Such notice of opposition shall be accompanied by a statement in duplicate setting out the nature of the opponent's interest, the facts on which he relies and the relief which he seeks.

(3) A copy of the notice and of the statement shall be sent by the Controller to the person making the request.

(4) The procedure specified in rules 58 to 63 relating to the filing of reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 78 as they apply in the hearing of the opposition proceeding.

(b) SECTION 61: PROCEDURE FOR DISPOSAL OF APPLICATIONS FOR RESTORATION OF LAPSED PATENTS

(1) If, after hearing the applicant in cases where the applicant so desires or the Controller thinks fit, the Controller is prima facie satisfied that the failure to pay the renewal fee was unintentional and that there has been no undue delay in the making of the application, he shall publish the application in the prescribed manner; and within the prescribed period any person interested may give notice to the Controller of opposition thereto on either or both of the following grounds, that is to say,—

(a) that the failure to pay the renewal fee was not unintentional; or

(b) that there has been undue delay in the making of the application.

(2) If notice of opposition is given within the period aforesaid, the Controller shall notify the applicant, and shall give to him and to the opponent an opportunity to be heard before he decides the case.

(3) If no notice of opposition is given within the period aforesaid or if in the case of opposition, the decision of the Controller is in favour of the applicant, the Controller shall, upon payment of any unpaid renewal fee and such additional fee as may be prescribed, restore the patent and any patent of addition specified in the application which has ceased to have effect on the cesser of that patent.

(4) The Controller may, if he thinks fit as a condition of restoring the patent, require that an entry shall be made in the register of any document or matter which, under the provisions of this Act, has to be entered in the register but which has not been so entered.

RULE 85: OPPOSITION TO RESTORATION UNDER SECTION 61

(1) At any time, within **two months from the date of publication** of the application under sub-rule (3) of rule 84, any person interested may give notice of opposition thereto in **Form 14**.

(2) A copy of the notice of opposition shall be sent by the Controller to the applicant.

(3) The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 60 as they apply to the hearing in the opposition proceeding.

(c) OPPOSITION TO POST-GRANT AMENDMENTS

SUB SECTIONS 3 TO 5 OF SECTION 57

(3) Any application for leave to amend an application for a patent or a complete specification or a document related thereto under this section made after the grant of patent and the nature of the proposed amendment may be published.

(4) Where an application is published under sub-section (3), any person interested may, within the prescribed period after the publication thereof, give notice to the Controller of opposition thereto; and where such a notice is given within the period aforesaid, the Controller shall notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case.

(5) An amendment under this section of a complete specification may be, or include, an amendment of the priority date of a claim.

RULE 81: AMENDMENT OF APPLICATION, SPECIFICATION OR ANY DOCUMENT RELATING THERETO

(1) An application under section 57 for the amendment of an application for a patent or a complete specification or any document related thereto shall be made in Form 13.

(2) If the application for amendment under sub-rule (1) relates to an application for a patent which has not been granted, the Controller shall determine whether and subject to what conditions, if any, the amendment shall be allowed.

(3) (a) If the application for amendment under sub-rule (1) is **made after grant of patent** and the nature of the proposed amendment is substantive, the application **shall be published**.

(b) Any person interested in opposing the application for amendment **shall give a notice of opposition in Form 14 within three months from the date of publication** of the application.

(c) The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 57 as they apply to the hearing of an opposition proceeding. Surrender of Patents

(d) OPPOSITION PROCEEDINGS IN SURRENDER OF PATENTS

SECTION 63: SURRENDER OF PATENTS

(1) A patentee may, at any time by giving notice in the prescribed manner to the Controller, offer to surrender his patent.

(2) Where such an offer is made, the Controller shall publish the offer in the prescribed manner, and also notify every person other than the patentee whose name appears in the register as having an interest in the patent.

(3) Any person interested may, within the prescribed period after such publication, give notice to the Controller of opposition to the surrender, and where any such notice is given the Controller shall notify the patentee.

(4) If the Controller is satisfied after hearing the patentee and any opponent, if desirous of being heard, that the patent may properly be surrendered, he may accept the offer and, by order, revoke the patent.

RULE 87: SURRENDER OF PATENTS

(1) The Controller shall publish the notice of an offer given under section 63.

(2) Any person interested may, **within three months from the date of publication of the notice, give notice of opposition to the Controller in Form 14** in duplicate.

(3) The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 63 as they apply to the hearing in opposition proceeding.

(4) If the Controller accepts the patentee's offer to surrender the patent, he may direct the patentee to return the patent, and on receipt of such patent, the Controller shall by order revoke it and publish the revocation of the patent.

NO OPPOSITION BUT ON DIRECTION BY CENTRAL GOVERNMENT; POSSIBILITY OF REVOCATION OF PATENT RIGHT

There are no opposition proceedings but still the patent can be revoked under the provisions of Sections 65 and 66 of the Indian Patents Act.

SECTION 65: REVOCATION OF PATENT OR AMENDMENT OF COMPLETE SPECIFICATION ON DIRECTIONS FROM GOVERNMENT IN CASES RELATING TO ATOMIC ENERGY

(1) Where at any time after grant of a patent, the Central Government is satisfied that a patent is for an invention relating to atomic energy for which no patent can be granted under sub-section (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962), it may direct the Controller to revoke the patent, and thereupon the Controller, after giving notice, to the patentee and every other person whose name has been entered in the register as having an interest in the patent, and after giving them an opportunity of being heard, may revoke the patent.

(2) In any proceedings under sub-section (1), the Controller may allow the patentee to amend the complete specification in such manner as he considers necessary instead of revoking the patent.

SECTION 66: REVOCATION OF PATENT IN PUBLIC INTEREST

Where the Central Government is of opinion that a patent or the mode in which it is exercised is mischievous to the State or generally prejudicial to the public, it may, after giving the patentee an opportunity to be heard, make a declaration to that effect in the Official Gazette and thereupon the patent shall be deemed to be revoked.

5. Grant of Patent Right to the Applicant

There are two kinds of patents. The first one is PRODUCT PATENT and second one is PROCESS PATENT. Product patent is more powerful than process patent for the reason that when a product is protected through a patent right, the product per se is protected by whatever process is followed to manufacture the said patented product. The processes of manufacturing the said patented product may include a known process or any unprotected process. In the Process Patent the “Product” is not protected and hence the preparation of that product by any process other than the patented process does not amount to infringement.

Patent right is a negative right. In other words the Indian Patents Act provides a right to the grantee to stop others from manufacturing and marketing a patented product which includes the right of importing the said patented product. If it is related to a process then the grantee has a right to stop others from manufacturing, most likely a known product, from using the patented process.

Patent is granted to ONE INVENTION ONLY, otherwise; or if the application is found to have multiple unconnected inventions, in other words the multiple inventions are not connected through a single inventive concept shall be divided and filed separately.

The main invention, if found eligible for grant, shall be granted first and then, if any patent of addition is filed, and if found eligible can be granted later to the date of grant of the main invention. The patent term of the patent of addition is equal to that of main invention and not beyond than that.

The major differences between Divisional application and Patent of Addition are;

- (a) Divisional application shall be filed before the date of grant of the first application whereas Patent of addition can be filed at any time during the patent term.
- (b) Divisional application is examined for all the patentability criteria whereas “INVENTIVE STEP” is not questioned in Patent of Addition.

- (c) Renewal fee or annuity fee shall be paid for a Divisional application whereas Renewal fee or annuity fee need not be paid for Patent of addition unless a Patent of addition is converted into an Independent Patent.

GRANT OF PATENT TO MORE THAN ONE APPLICANT

If there is more than one applicant for the patent then the right is equally divided among the grantees unless there is a different agreement with respect each grantee's share in a patent that is to be registered with the Patent Office. Further the grant of patent right is subject to applicability of the General Principles as envisaged under Section 83 of the Patents Act.

GRANT OF PATENT TO DECEASED APPLICANT

If the applicant or patentee does not exist for whatever the reason, for example by death of a person or by a company which ceased to exist and **has not made any deed of transfer of patent right** then the grant is made to such person who approaches the Controller in the prescribed manner.

GRANT OF PATENT TO A SUBSTITUTED APPLICANT

After filing for a patent the applicant may assign the invention to another person. Person includes a legal entity. In such case the new claimant has to file a request in the prescribed manner to substitute the name of the applicant before the grant of patent right.

TERM OF THE PATENT

For every patent there is a date of filing. Patent term is for 20 years and is calculated from the date of filing the patent application. If the provisional specification is filed first and followed by filing the complete specification then the date of filing is the date of filing the provisional specification. If the Complete specification is filed without filing any Provisional specification then the date of filing is the date of filing the complete specification.

If any Convention Application is filed wherein the provision of filing a provisional specification is not allowed then the date of entry into India is the date of filing the application and the patent term of 20 years is calculated from the actual date of filing in India. Priority date is not considered for patent term calculation. For PCT National Phase applications the International Filing Date is the deemed date of filing in India, irrespective of the actual date of entering the National Phase in India, and therefore the patent term of 20 years is calculated from the International filing date.

Under any circumstances the Patent Term is not extended.

DIFFERENCES AMONG THE APPLICANT, PATENTEE AND GRANTEE

Applicant means a person who applies for a patent. Applicant can be an inventor(s) or Assignee(s) or Assignee to Assignees. Patentee is the person to whom the patent is granted. Ordinarily, the two words “PATENTEE” and “GRANTEE” can be interchangeably used. Patentee may be Inventor(s) himself/herself/themselves, or may be Assignee(s) themselves or Assignee to Assignee themselves. In Post-grant the Patentee may further assign the granted patented right to another assignee. The said another assignee is not the Patentee at the time of grant. The said another assignee under the provisions of the Section 69 shall register the assignment deed with the Patent Office to claim his/her/ theirs interest in the said patent. After registering so, the registered assignee is generally referred as Grantee.

Relevant Sections are reproduced herewith for quick reference.

SECTION 2(1)(j): DEFINITIONS AND INTERPRETATIONS

- (j) "invention" means a **new product or process** involving an inventive step and capable of industrial application;

SECTION 2(1)(m): DEFINITIONS AND INTERPRETATIONS

- (m) "patent" means a patent **for any invention** granted under this Act;

A known process is patentable unless any reactant or one of the reactants OR any product or one of the products is NOVEL

SECTION 3: WHAT ARE NOT INVENTIONS?

PART OF SECTION 3(d): The mere use of a known process, machine or apparatus **unless such known process results in a new product or employs at least one new reactant is not patentable.**

Section 82: Definition of "patented articles" and "patentee"

In this Chapter, unless the context otherwise requires,—

- (a) "patented article" includes any article made by a patented process; and
(b) "patentee" includes an exclusive licensee.

SECTION 43(1): GRANT OF PATENTS

- (1) Where an application for a patent has been found to be in order for grant of the patent and either—

(a) the application has not been refused by the Controller by virtue of any power vested in him by this Act; or

(b) the application has not been found to be in contravention of any of the provisions of this Act,

the patent shall be granted as expeditiously as possible to the applicant or, in the case of a joint application, to the applicants jointly, with the seal of the patent office and the date on which the patent is granted shall be entered in the register.

SECTION 46: FORM, EXTENT AND EFFECT OF PATENT

(1) Every patent shall be in the prescribed form and shall have effect throughout India.

(2) A patent shall be granted for one invention only:

Provided that it shall not be competent for any person in a suit or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

PART OF SECTION 54: PATENTS OF ADDITION

(3) A patent shall not be granted as a patent of addition unless the date of filing of the application was the same as or later than the date of filing of the application in respect of the main invention.

(4) A patent of addition shall not be granted before grant of the patent for the main invention.

SECTION 55: TERM OF PATENTS OF ADDITION

(1) A patent of addition shall be granted for a term equal to that of the patent for the main invention, or so much thereof as has not expired, and shall remain in force during that term or until the previous cesser of the patent for the main invention and no longer:

Provided that if the patent for the main invention is revoked under this Act, the court, or, as the case may be, the Controller, on request made to him by the patentee in the prescribed manner, may order that the patent of addition shall become an independent patent for the remainder of the term for the patent for the main invention and thereupon the patent shall continue in force as an independent patent accordingly.

(2) No renewal fees shall be payable in respect of a patent of addition, but, if any such patent becomes an independent patent under sub-section (1) the same fees shall thereafter be payable, upon the same dates, as if the patent had been originally granted as an independent patent.

SECTION 83: GENERAL PRINCIPLES APPLICABLE TO WORKING OF PATENTED INVENTIONS

Without prejudice to the other provisions contained in this Act, in exercising the powers conferred by this Chapter, regard shall be had to the following general considerations, namely;—

- (a) that patents are granted to encourage inventions and to secure that the inventions are worked in India on a commercial scale and to the fullest extent that is reasonably practicable without undue delay;
- (b) that they are not granted merely to enable patentees to enjoy a monopoly for the importation of the patented article;
- (c) that the protection and enforcement of patent rights contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations;
- (d) that patents granted do not impede protection of public health and nutrition and should act as instrument to promote public interest specially in sectors of vital importance for socio-economic and technological development of India;
- (e) that patents granted do not in any way prohibit Central Government in taking measures to protect public health;
- (f) that the patent right is not abused by the patentee or person deriving title or interest on patent from the patentee, and the patentee or a person deriving title or interest on patent from the patentee does not resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology; and
- (g) that patents are granted to make the benefit of the patented invention available at reasonably affordable prices to the public.

SECTION 47: GRANT OF PATENTS TO BE SUBJECT TO CERTAIN CONDITIONS

The grant of a patent under this Act shall be subject to the condition that—

- (1) any machine, apparatus or other article in respect of which the patent is granted or any article made by using a process in respect of which the patent is granted, may be imported or made by or on behalf of the Government for the purpose merely of its own use;
- (2) any process in respect of which the patent is granted may be used by or on behalf of the Government for the purpose merely of its own use;

(3) any machine, apparatus or other article in respect of which the patent is granted or any article made by the use of the process in respect of which the patent is granted, may be made or used, and any process in respect of which the patent is granted may be used, by any person, for the purpose merely of experiment or research including the imparting of instructions to pupils; and

(4) in the case of a patent in respect of any medicine or drug, the medicine or drug may be imported by the Government for the purpose merely of its own use or for distribution in any dispensary, hospital or other medical institution maintained by or on behalf of the Government or any other dispensary, hospital or other medical institution which the Central Government may, having regard to the public service that such dispensary, hospital or medical institution renders, specify in this behalf by notification in the Official Gazette.

SECTION 68: ASSIGNMENTS, ETC., NOT TO BE VALID UNLESS IN WRITING AND DULY EXECUTED

An assignment of a patent or of a share in a patent, a mortgage, licence or the creation of any other interest in a patent shall not be valid unless the same were in writing and the agreement between the parties concerned is reduced to the form of a document embodying all the terms and conditions governing their rights and obligations and duly executed.

SECTION 69: REGISTRATION OF ASSIGNMENTS, TRANSMISSIONS, ETC

(1) Where any person becomes entitled by assignment, transmission or operation of law to a patent or to a share in a patent or becomes entitled as a mortgagee, licensee or otherwise to any other interest in a patent, he shall apply in writing in the prescribed manner to the Controller for the registration of his title or, as the case may be, of notice of his interest in the register.

(2) Without prejudice to the provisions of sub-section (1), an application for the registration of the title of any person becoming entitled by assignment to a patent or a share in a patent or becoming entitled by virtue of a mortgage, licence or other instrument to any other interest in a patent may be made in the prescribed manner by the assignor, mortgagor, licensor or other party to that instrument, as the case may be.

(3) Where an application is made under this section for the registration of the title of any person the Controller shall, upon proof to title of his satisfaction,-

(a) where that person is entitled to a patent or a share in a patent, register him in the register as proprietor or co-proprietor of the patent, and enter in the register particulars of the instrument or even by which he derives title; or

(b) where that person is entitled to any other interest in the patent, enter in the register notice of his interest, with particulars of the instrument, if any, creating it:

Provided that if there is any dispute between the parties whether the assignment, mortgage, licence, transmission, operation of law or any other such transaction has validly vested in such person a title to the patent or any share or interest therein, the Controller may refuse to take any action under clause (a) or, as the case may be, under clause (b), until the rights of the parties have been determined by a competent court.

(4) There shall be supplied to the Controller in the prescribed manner for being filed in the patent office copies of all agreements, licences and other documents affecting the title to any patent or any licence thereunder authenticated in the prescribed manner and also such other documents as may be prescribed relevant to the subject-matter:

Provided that in the case of a licence granted under a patent, the Controller shall, if so requested by the patentee or licensee, take steps for securing that the terms of the licence are not disclosed to any person except under the order of a court.

(5) Except for the purposes of an application under sub-section (1) or of an application to rectify the register, a **document in respect of which no entry has been made in the register under sub-section (3) shall not be admitted by the Controller or by any court as evidence of the title of any person to a patent or to a share or interest therein** unless the Controller or the court, for reasons to be recorded in writing, otherwise directs.

SECTION 44: AMENDMENT OF PATENT GRANTED TO DECEASED APPLICANT

Where, at any time after a patent has been granted in pursuance of an application under this Act, the Controller is satisfied that the person to whom the patent was granted had died, or, in the case of a body corporate, had ceased to exist, before the patent was granted, the Controller may amend the patent by substituting for the name of that person the name of the person to whom the patent ought to have been granted, and the patent shall have effect, and shall be deemed always to have had effect, accordingly.

Section 44: Amendment of patent granted to deceased applicant

Where, at any time after a patent has been granted in pursuance of an application under this Act, the Controller is satisfied that the person to whom the patent was granted had died, or, in the case of a body corporate, had ceased to exist, before the patent was granted, the Controller may amend the patent by substituting for the name of that person the name of the person to whom the patent ought to have been granted, and the patent shall have effect, and shall be deemed always to have had effect, accordingly.

Rule 75: Amendment of patent under section 44

An application under section 44 for the amendment of a patent shall be made in **Form 10** along with substantiating evidence and be accompanied by the patent.

SECTION 20: POWERS OF CONTROLLER TO MAKE ORDERS REGARDING SUBSTITUTION OF APPLICANTS, ETC.

(1) If the Controller is satisfied, on a claim made in the prescribed manner at any time before a patent has been granted, that by virtue of any assignment or agreement in writing made by the applicant or one of the applicants for the patent or by operation of law, the claimant would, if the patent were then granted, be entitled thereto or to the interest of the applicant therein, or to an undivided share of the patent or of that interest, the Controller may, subject to the provisions of this section, direct that the application shall proceed in the name of the claimant or in the names of the claimants and the applicant or the other joint applicant or applicants, accordingly as the case may require.

(2) No such direction as aforesaid shall be given by virtue of any assignment or agreement made by one of two or more joint applicants for a patent except with the consent of the other joint applicant or applicants.

(3) No such direction as aforesaid shall be given by virtue of any assignment or agreement for the assignment of the benefit of an invention unless—

(a) the invention is identified therein by reference to the number of the application for the patent; or

(b) there is produced to the Controller an acknowledgement by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made; or

(c) the rights of the claimant in respect of the invention have been finally established by the decision of a court; or

(d) the Controller gives directions for enabling the application to proceed or for regulating the manner in which it should be proceeded with under sub-section (5).

(4) Where one of two or more joint applicants for a patent dies at any time before the patent has been granted, the Controller may, upon a request in that behalf made by the survivor or survivors, and with the consent of the legal representative of the deceased, direct that the application shall proceed in the name of the survivor or survivors alone.

(5) If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the Controller may, upon application made to him in the prescribed manner by any of the parties, and after giving to all parties concerned an opportunity to be heard, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be proceeded with, or for both those purposes, as the case may require.

Rule 34: Manner in which a claim under section 20(1) shall be made

(1) A claim under sub-section (1) of section 20 shall be made in Form 6.

(2) The original assignment or agreement or an official copy or notarized copy thereof shall also be produced for the Controller's inspection and the Controller may call for such other proof of title or written consent as he may require.

Rule 35: Manner in which a request may be made under section 20(4)

(1) A request under sub-section (4) of section 20 shall be made in Form 6.

(2) The request shall be accompanied by proof of death of the joint applicant and a certified copy of the probate of the will of the deceased or letters of administration in respect of his estate or any other document to prove that the person who gives the consent is the legal representative of the deceased applicant.

Rule 36: Manner of application under section 20(5)

(1) An application under sub-section (5) of section 20 shall be made in Form 6 in duplicate and shall be accompanied by a statement setting out fully the facts upon which the applicant relies and the directions which he seeks.

(2) A copy of the application and statement shall be sent by the Controller to every other joint applicant.

SECTION 45: DATE OF PATENT

(1) Subject to the other provisions contained in this Act, every patent shall be dated as of the date on which the application for patent was filed.

(2) The date of every patent shall be entered in the register.

(3) Notwithstanding anything contained in this section, no suit or other proceeding shall be commenced or prosecuted in respect of an infringement committed before the date of publication of the application.

SECTION 53: TERM OF PATENT

(1) Subject to the provisions of this Act, the term of every patent granted, after the commencement of the Patents (Amendment) Act, 2002, and the term of every patent which has not expired and has not ceased to have effect, on the date of such commencement, under this Act, shall be twenty years from the date of filing of the application for the patent.

Explanation.—For the purposes of this sub-section, the term of patent in case of International applications filed under the Patent Cooperation Treaty designating India, shall be twenty years from the international filing date accorded under the Patent Cooperation Treaty.

(2) A patent shall cease to have effect notwithstanding anything therein or in this Act on the expiration of the period prescribed for the payment of any renewal fee, if that fee is not paid within the prescribed period or within such extended period as may be prescribed.

(3) [Omitted]

(4) Notwithstanding anything contained in any other law for the time being in force, on cessation of the patent right due to non-payment of renewal fee or on expiry of the term of patent, the subject matter covered by the said patent shall not be entitled to any protection.

6. Revocation of Patent

When a person desires to challenge a patent but unaware of the patent grant and subsequent publication thereupon or could not gather proper and just evidence to challenge a patent may opt for revocation of a patent at any time during the life term of a patent. Therefore, the sword of opposition always hangs over the head of a patentee throughout the life term of the patent. If patent is not strong enough then always there is a threat to it hence Patents Law is good enough to take care the needs of the public of this property of right against any misuse through public support.

The revocation petition cannot be filed before the Patent Office. It can be filed by any interested person either before IPAB or before any High Court on a counter-claim in a suit for infringement.

The grounds for opposition under revocation proceedings are also specified in the Patents Act and revocation petition shall be based only on such specified grounds. The grounds for revocation go beyond the grounds specified for Pre and Post-grant oppositions’.

If the Central Government considers that the patent right ought not to have been granted because the subject matter of the patent falls within the Section 4 of the Patents Act may direct the Controller to revoke the patent. The Controller provides an opportunity for being heard to the patentee. If the Central

Government opines that the patent right is mischievously exercised and generally prejudicial to the public of India may revoke the patent by giving an opportunity to the patent to be heard.

SECTION 64: GROUNDS FOR REVOCATION

(1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act, may, be revoked on a petition of any person interested or of the Central Government by the Appellate Board or on a counter-claim in a suit for infringement of the patent by the High Court on any of the following grounds, that is to say—

(a) that the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in India;

(b) that the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor;

(c) that the patent was obtained wrongfully in contravention of the rights of the petitioner or any person under or through whom he claims;

(d) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;

(e) that the invention so far as claimed in any claim of the complete specification is not new, having regard to what was publicly known or publicly used in India before the priority date of the claim or to what was published in India or elsewhere in any of the documents referred to in section 13;

(f) that the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step, having regard to what was publicly known or publicly used in India or what was published in India or elsewhere before the priority date of the claim;

(g) that the invention, so far as claimed in any claim of the complete specification, is not useful;

(h) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient 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, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection;

(i) that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;

- (j) that the patent was obtained on a false suggestion or representation;
- (k) that the subject of any claim of the complete specification is not patentable under this Act;
- (l) that the invention so far as claimed in any claim of the complete specification was secretly used in India, otherwise than as mentioned in sub-section (3), before the priority date of the claim;
- (m) that the applicant for the patent has failed to disclose to the Controller the information required by section 8 or has furnished information which in any material particular was false to his knowledge;
- (n) that the applicant contravened any direction for secrecy passed under section 35 or made or caused to be made an application for the grant of a patent outside India in contravention of section 39;
- (o) that leave to amend the complete specification under section 57 or section 58 was obtained by fraud.
- (p) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;
- (q) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.

(2) For the purposes of clauses (e) and (f) of sub-section (1)—

- (a) no account shall be taken of personal document or secret trial or secret use; and
- (b) where the patent is for a process or for a product as made by a process described or claimed, the importation into India of the product made abroad by that process shall constitute knowledge or use in India of the invention on the date of the importation, except where such importation has been for the purpose of reasonable trial or experiment only.

(3) For the purpose of clause (1) of sub-section (1), no account shall be taken of any use of the invention—

- (a) for the purpose of reasonable trial or experiment only; or
- (b) by the Government or by any person authorised by the Government or by a Government undertaking, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention directly or indirectly to the Government or person authorised as aforesaid or to the Government undertaking; or

(c) by any other person, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention, and without the consent or acquiescence of the applicant or of any person from whom he derives title.

(4) Without prejudice to the provisions contained in sub-section (1) a patent may be revoked by the High Court on the petition of the Central Government, if the High Court is satisfied that the patentee has without reasonable cause failed to comply with the request of the Central Government to make, use or exercise the patented invention for the purposes of Government within the meaning of section 99 upon reasonable terms.

(5) A notice of any petition for revocation of a patent under this section shall be served on all persons appearing from the register to be proprietors of that patent or to have shares or interests therein and it shall not be necessary to serve a notice on any other person.

Section 65

Revocation of patent or amendment of complete specification on directions from Government in cases relating to atomic energy

(1) Where at any time after grant of a patent, the Central Government is satisfied that a patent is for an invention relating to atomic energy for which no patent can be granted under sub-section (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962), it may direct the Controller to revoke the patent, and thereupon the Controller, after giving notice, to the patentee and every other person whose name has been entered in the register as having an interest in the patent, and after giving them an opportunity of being heard, may revoke the patent.

(2) In any proceedings under sub-section (1), the Controller may allow the patentee to amend the complete specification in such manner as he considers necessary instead of revoking the patent.

Section 66

Revocation of patent in public interest

Where the Central Government is of opinion that a patent or the mode in which it is exercised is mischievous to the State or generally prejudicial to the public, it may, after giving the patentee an opportunity to be heard, make a declaration to that effect in the Official Gazette and thereupon the patent shall be deemed to be revoked.

Section 85:

Revocation of patents by the Controller for non-working

(1) Where, in respect of a patent, a compulsory licence has been granted, the Central Government or any person interested may, **after the expiration of two years from the date of the order granting the first compulsory licence**, apply to the Controller for an order revoking the patent on the ground that the patented invention has not been worked in the territory of India or that reasonable requirements of the public with respect to the patented invention has not been satisfied or that the patented invention is not available to the public at a reasonably affordable price.

(2) Every application under sub-section (1) shall contain such particulars as may be prescribed, the facts upon which the application is based, and, in the case of an application other than by the Central Government, shall also set out the nature of the applicant's interest.

(3) The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied or that patented invention has not been worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price, may make an order revoking the patent.

(4) Every application under sub-section (1) **shall ordinarily be decided within one year** of its being presented to the Controller.

Section 87:

Procedure for dealing with applications under sections 84 and 85

(1) Where the Controller is satisfied, upon consideration of an application under section 84, Or section 85, that a prima facie case has been made out for the making of an order, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which the application is made, and shall publish the application in the official journal.

(2) The patentee or any other person desiring to oppose the application may, within such time as may be prescribed or within such further time as the Controller may on application (made either before or after the expiration of the prescribed time) allow, give to the Controller notice of opposition.

(3) Any such notice of opposition shall contain a statement setting out the grounds on which the application is opposed.

(4) Where any such notice of opposition is duly given, the Controller shall notify the applicant, and shall give to the applicant and the opponent an opportunity to be heard before deciding the case.

Rule 98

Notice of opposition under section 87(2)

(1) A notice of opposition under sub-section (2) of section 87 shall be given in **Form 14** and shall be sent to the Controller **within two months from the date of the publication** of the application under sub-section (1) of the said section.

(2) The notice of opposition referred to in sub-rule (1) shall include the terms and conditions of the licence, if any, the opponent is prepared to grant to the applicant and shall be accompanied by evidence in support of the opposition.

(3) The opponent shall serve a copy of his notice of opposition and evidence on the applicant and notify the Controller when such service has been effected.

(4) No further statement or evidence shall be delivered by either party except with the leave of or on requisition by the Controller.

(5) The Controller shall forthwith fix a date and time for the hearing of the case and shall give the parties not less than ten days' notice of such hearing.

(6) The procedure specified in sub-rules (2) to (5) of rule 62, shall, so far as may be, apply to the procedure for hearing under this rule as they apply to the hearing in opposition proceedings.

Section 52: Grant of patent to true and first inventor where it has been obtained by another in fraud of him.

(1) Where the patent has been revoked under section 64 on the ground that the patent was obtained wrongfully and in contravention of the rights of the petitioner or any person under or through whom he claims, or, where in a petition for revocation, the Appellate Board or court, instead of revoking the patent, directs the complete specification to be amended by the exclusion of a claim or claims in consequence of a finding that the invention covered by such claim or claims had been obtained from the petitioner, the Appellate Board or court may, by order passed in the same proceeding, permit the grant to the petitioner of the whole or such part of the invention which the Appellate Board or court finds has been wrongfully obtained by the patentee, in lieu of the patent so revoked or is excluded by amendment.

(2) Where any such order is passed, the Controller shall, on request by the petitioner made in the prescribed manner grant to him—

(i) in cases where the Appellate Board or court permits the whole of the patent to be granted, a new patent bearing the same date and number as the patent revoked;

(ii) in cases where the Appellate Board or court permits a part only of the patent to be granted, a new patent for such part bearing the same date as the patent revoked and numbered in such manner as may be prescribed:

Provided that the Controller may, as a condition of such grant, require the petitioner to file a new and complete specification to the satisfaction of the Controller describing and claiming that part of the invention for which the patent is to be granted.

(3) No suit shall be brought for any infringement of a patent granted under this section committed before the actual date on which such patent was granted.

RULE 79: REQUEST UNDER SECTION 52(2)

(1) A request under sub-section (2) of section 52 shall be made in Form 12 within three months from the date of the order of the Appellate Board or court referred to in sub-section (1) of the said section and shall be accompanied by a statement setting out the facts upon which the petitioner relies and the relief he claims and a certified copy of the order of the Appellate Board or court.

(2) Where the Appellate Board or court has ordered the grant of patent to the applicant only for a part of the invention, the new patent granted shall be accorded a number in the same series of numbers accorded to the complete specifications accepted on the same day as the patent is granted.

NOTE: Section 26 and Rule 63A are also to deal a case for obtaining the invention fraudulently but the proceedings comes under Opposition before the Patent Office. Section 52 and Rule 79 refers to the same action during revocation proceedings before IPAB or High Court. Directions as provided in the Sections 26 and 52 are similar in nature.

CHAPTER IV

Rights of Patentee and Compulsory Licensing

RIGHTS OF PATENTEE

Section 48: Rights of patentees

Subject to the other provisions contained in this Act and the conditions specified in section 47, a patent granted under this Act shall confer upon the patentee—

(a) where the subject matter of the patent is a product, the exclusive right to prevent third parties, who do not have his consent, from the act of making, using, offering for sale, selling or importing for those purposes that product in India;

(b) where the subject matter of the patent is a process, the exclusive right to prevent third parties, who do not have his consent, from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India:

CO-OWNERS OF A PATENT

When the patent is owned by more than one person then all the registered names of the persons will have equal share or interest in the patent. Like in fixed assets, hereto, one of the owners of a patent can assign or give licence or mortgage his share of patent to any third person.

SECTION 51: POWER OF CONTROLLER TO GIVE DIRECTIONS TO CO-OWNERS

(1) Where two or more persons are registered as grantee or proprietor of a patent, the Controller may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licenses under the patent, or the exercise of any right under section 50 in relation thereto, as he thinks fit.

(2) If any person registered as grantee or proprietor of a patent fails to execute any instrument or to do any other thing required for the carrying out of any direction given under this section within fourteen days after being requested in writing so to do by any of the other persons so registered, the Controller may, upon application made to him in the prescribed manner by any such other person, give directions

empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default.

(3) Before giving any directions in pursuance of an application under this section, the Controller shall give an opportunity to be heard—

(a) in the case of an application under sub-section (1) to the other person or persons registered as grantee or proprietor of the patent;

(b) in the case of an application under sub-section (2), to the person in default.

(4) No direction shall be given under this section so as to affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or of their rights or obligations as such, or which is inconsistent with the terms of any agreement between persons registered as grantee or proprietor of the patent.

SECTION 70: POWER OF REGISTERED GRANTEE OR PROPRIETOR TO DEAL WITH PATENT

Subject to the provisions contained in this Act relating to co-ownership of patents and subject also to any rights vested in any other person of which notice is entered in the register, the person or persons registered as grantee or proprietor of a patent shall have power to assign, grant licences under, or otherwise deal with, the patent and to give effectual receipts for any consideration for any such assignment, licence or dealing:

Provided that any equities in respect of the patent may be enforced in like manner as in respect of any other movable property.

Section 50: Rights of co-owners of patents

(1) Where a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent.

(2) Subject to the provisions contained in this section and in section 51, where two or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each

of those persons shall be entitled, by himself or his agents, to rights conferred by section 48 for his own benefit without accounting to the other person or persons.

(3) Subject to the provisions contained in this section and in section 51 and to any agreement for the time being in force, where two or more persons are registered as grantee or proprietor of a patent, then, a licence under the patent shall not be granted and share in the patent shall not be assigned by one of such persons except with the consent of the other person or persons.

(4) Where a patented article is sold by one of two or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming through him shall be entitled to deal with the article in the same manner as if the article had been sold by a sole patentee.

(5) Subject to the provisions contained in this section, the rules of law applicable to the ownership and devolution of movable property generally shall apply in relation to patents; and nothing contained in sub-section (1) or sub-section (2) shall affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or their rights or obligations as such.

(6) Nothing in this section shall affect the rights of the assignees of a partial interest in a patent created before the commencement of this Act.

SECTION 49: PATENT RIGHTS NOT INFRINGED WHEN USED ON FOREIGN VESSELS ETC., TEMPORARILY OR ACCIDENTALLY IN INDIA

(1) Where a vessel or aircraft registered in a foreign country or a land vehicle owned by a person ordinarily resident in such country comes into India (including the territorial waters thereof) temporarily or accidentally only, the rights conferred by a patent for an invention shall not be deemed to be infringed by the use of the invention—

(a) in the body of the vessel or in the machinery, tackle, apparatus or other accessories thereof, so far as the invention is used on board the vessel and for its actual needs only; or

(b) in the construction or working of the aircraft or land vehicle or of the accessories thereof, as the case may be.

(2) This section shall not extend to vessels, aircrafts or land vehicles owned by persons ordinarily resident in a foreign country the laws of which do not confer corresponding rights with respect to the use of inventions in vessels, aircraft or land vehicles owned by persons ordinarily resident in India while in the ports or within the territorial waters of that foreign country or otherwise within the jurisdiction of its courts.

SECTION 62: RIGHTS OF PATENTEES OF LAPSED PATENTS WHICH HAVE BEEN RESTORED

(1) Where a patent is restored, the rights of the patentee shall be subject to such provisions as may be prescribed and to such other provisions as the Controller thinks fit to impose for the protection or compensation of persons who may have begun to avail themselves of, or have taken definite steps by contract or otherwise to avail themselves of, the patented invention between the date when the patent ceased to have effect and the date of publication of the application for restoration of the patent under this Chapter.

(2) No suit or other proceeding shall be commenced or prosecuted in respect of an infringement of a patent committed between the date on which the patent ceased to have effect and the date of the publication of the application for restoration of the patent.

COMPULSORY LICENSE

WHAT IS COMPULSORY LICENCE?

When the Patentee do not meet the requirements of the public for whatever the reason and do not licence the invention to any interested person then the interested person may approach the Controller for issuance of a license from the patent holder. If satisfied, the Controller may grant a license to the applicant. Hence it is called compulsory license. [CL]

WHEN TO FILE FOR CL?

At any time after EXPIRATION OF THREE YEARS FROM THE DATE OF THE GRANT of patent, an interested person can apply for the CL.

WHO CAN FILE FOR CL?

Any person interested in doing so. It does not restrict a licence holder and he also can apply.

WHO IS PERSON INTERESTED?

Person interested includes a person engaged in, or in promoting research in the same field as that to which the invention relates; wherein “person” includes Government.

WHAT ARE THE GROUNDS FOR FILING CL?

That the reasonable requirements of the public with respect to the patented invention have not been satisfied; OR

That the patented invention is not available to the public at a reasonably affordable price; OR

That the patented invention is not worked in the territory of India.

Note: working in India includes importation

WHICH FORM IS REQUIRED UNDER WHICH SECTIONS?

Form 17 needs to be filed under the sections 84(1); 91(1); 92(1) and 92A

What is the fee to be paid?

When it is e-filing then for natural person & Start Up; for small entity; and for others other than natural and small entity will be Rupees 2400; 6000; 12000 in the same order.

When it is physical filing then for natural person & Start Up; for small entity; and for others other than natural and small entity will be Rupees 2650; 6600; 13200 in the same order.

Application shall contain statement of interest and the facts upon which the application is based.

FACTS TO BE CONSIDERED BY THE CONTROLLER:

- The nature of the invention
- The time lapsed since the grant of patent
- Measures already taken by the patentee or any licensee to make full use of the invention
- The ability of the applicant to work the invention to the public advantage
- The capacity of the applicant to undertake the risk in providing capital and working the invention, if CL is granted
- Whether the applicant has made efforts to obtain a licence from the patentee on reasonable terms and conditions and such efforts have not been successful within a reasonable period as the Controller may deem fit. [not ordinarily exceeding a period of 6 months]

NOTE: Not applicable in case of National emergency or other circumstances of extreme urgency or in case of public non-commercial use or on establishment of a ground of anti-competitive practices adopted by the patentee.

GROUND ON WHICH REASONABLE REQUIREMENTS HAVE NOT BEEN SATISFIED

Refusal to grant licence or licences on reasonable terms;

i) an existing trade or industry or the development thereof or the establishment of any new trade or industry in India OR the trade or industry in India OR the trade or industry of any person or class of persons trading or manufacturing in India is prejudiced; OR

ii) The demand for the patented article has not been met to an adequate extent or on reasonable terms; OR

iii) A market for export of the patented article manufactured in India is not being supplied or developed; OR

iv) The establishment or development of commercial activities in India is prejudiced; OR

(b) if, by any reason of conditions imposed by the patentee upon the grant of licences under the patent or upon the purchase, hire or use of the patented article or process, the manufacture, use or sale of materials not protected by the patent, or the establishment or development of any trade or industry in India, is prejudiced; OR

(c) If the patentee imposes a condition upon the grant of licences under the patent to provide exclusive grant back, prevention to challenges to the validity of a patent or coercive package licencing; OR

(d) If the patented invention is not being worked in the territory of India on a commercial scale to an adequate extent or is not being so worked to the fullest extent that is reasonably practicable; OR

(e) If the working of the patented invention in the territory of India on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by;

(i) the patentee or the persons claiming under him; OR

(ii) persons directly or indirectly purchasing from him; OR

(iii) other persons against whom the patentee is not taking or has not taken proceedings for infringement.

REVOCATION OF PATENTS AFTER GRANTING COMPULSORY LICENCE –SECTION 85 [FOR NON-WORKING]

Any interested person can make an application before the Controller BUT AFTER THE LAPSE OF ONE YEAR FROM THE GRANT OF FIRST CL requesting the revocation of patent for non-working in India
Required Form to be filed is Form-19

When it is e-filing then for natural person & Start Up; for small entity; and for others other than natural and small entity will be Rupees 2400; 6000; 12000 in the same order.

When it is physical filing then for natural person & Start Up; for small entity; and for others other than natural and small entity will be Rupees 2650; 6600; 13200 in the same order.

Application shall contain statement of interest and the facts upon which the application is based.

Section 85

Revocation of patents by the Controller for non-working

(1) Where, in respect of a patent, a compulsory licence has been granted, the Central Government or any person interested may, after the expiration of two years from the date of the order granting the first compulsory licence, apply to the Controller for an order revoking the patent on the ground that the patented invention has not been worked in the territory of India or that reasonable requirements of the public with respect to the patented invention has not been satisfied or that the patented invention is not available to the public at a reasonably affordable price.

(2) Every application under sub-section (1) shall contain such particulars as may be prescribed, the facts upon which the application is based, and, in the case of an application other than by the Central Government, shall also set out the nature of the applicant's interest.

(3) The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied or that patented invention has not been worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price, may make an order revoking the patent.

(4) Every application under sub-section (1) shall ordinarily be decided within one year of its being presented to the Controller.

POWER OF CONTROLLER TO ADJOURN APPLICATIONS FOR CL IN CERTAIN CASES – SECTION 86

Controller if satisfied that the time period between the grant of patent and the date of filing the first application for CL is insufficient to enable the invention to be worked on a commercial scale to an adequate extent or to enable the invention to be so worked to the fullest extent that is reasonably practicable, he may, by order, adjourn the further hearing of the application for such period not exceeding 12 months in the aggregate as appears to him to be sufficient for the invention to be so worked, provided if the patentee proves that the delay is due to any State or Central Governments' impositions.

Then 12 month period shall be reckoned from the expiry of such imposition.

Section 86

Power of Controller to adjourn applications for compulsory licences, etc., in certain cases

(1) Where an application under section 84 or section 85, as the case may be, is made on the grounds that the patented invention has not been worked in the territory of India or on the ground mentioned in clause (d) of sub-section (7) of section 84 and the Controller is satisfied that the time which has elapsed since the sealing of the patent has for any reason been insufficient to enable the invention to be worked on a commercial scale to an adequate extent or to enable the invention to be so worked to the fullest extent that is reasonably practicable, he may, by order, adjourn the further hearing of the application for such period not exceeding twelve months in the aggregate as appears to him to be sufficient for the invention to be so worked:

Provided that in any case where the patentee establishes that the reason why a patented invention could not be worked as aforesaid before the date of the application was due to any State or Central Act or any rule or regulation made thereunder or any order of the Government imposed otherwise than by way of a condition for the working of the invention in the territory of India or for the disposal of the patented articles or of the articles made, by the process or by the use of the patented plant, machinery, or apparatus, then, the period of adjournment ordered under this sub-section shall be reckoned from the date on which the period during which the working of the invention was prevented by such Act, rule or regulation or order of Government as computed from the date of the application, expires.

(2) No adjournment under sub-section (1) shall be ordered unless the Controller is satisfied that the patentee has taken with promptitude adequate or reasonable steps to start the working of the invention in the territory of India on a commercial scale and to an adequate extent.

COMMON PROCEDURE TO DEAL WITH APPLICATIONS FILED UNDER SECTIONS 84 & 85

SECTION 87

Controller has to get prima facie satisfaction on the facts filed.

Controller shall direct the applicant to serve the copies of the application to the patentee or any other person appearing in the patent register to be interested in the patent

Controller shall publish the application in patent journal

A notice of opposition can be filed by any person interested by filing Form-14.

When it is e-filing then for natural person; for small entity; and for others other than natural and small entity will be Rupees 2400; 6000; 12000 in the same order.

When it is physical filing then for natural person; for small entity; and for others other than natural and small entity will be Rupees 2640; 6600; 13200 in the same order.

Controller shall provide an opportunity of being heard and decide the case on merits.

Section 87

Procedure for dealing with applications under sections 84 and 85

(1) Where the Controller is satisfied, upon consideration of an application under section 84, Or section 85, that a prima facie case has been made out for the making of an order, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which the application is made, and shall publish the application in the official journal.

(2) The patentee or any other person desiring to oppose the application may, within such time as may be prescribed or within such further time as the Controller may on application (made either before or after the expiration of the prescribed time) allow, give to the Controller notice of opposition.

(3) Any such notice of opposition shall contain a statement setting out the grounds on which the application is opposed.

(4) Where any such notice of opposition is duly given, the Controller shall notify the applicant, and shall give to the applicant and the opponent an opportunity to be heard before deciding the case.

POWERS OF CONTROLLER IN GRANTING CL – SECTION 88

CL may be granted to the customers of the applicant as he thinks fit and as well to the applicant.

If the applicant is a licence holder then the Controller may cancel earlier licence or may amend the earlier licence.

If the applicant seeks CL in some of the patents of a patentee who holds many patents and if the Controller thinks that unless CL is granted with respect to other patents for which CL has not been filed then the Controller may grant CL to all such patents without which the applicant cannot work the invention

CL licence holder may approach the Controller after the expiry of 12 months from the date of working of the invention seeking the revision of terms of conditions of the CL on the ground that the terms and conditions settled have proved to be more onerous than originally expected and that in consequence thereof the licensee is unable to work the invention except at a loss, provided that no such application shall be entertained a second time.

Section 88

Powers of Controller in granting compulsory licences

(1) Where the Controller is satisfied on an application made under section 84 that the manufacture, use or sale of materials not protected by the patent is prejudiced by reason of conditions imposed by the patentee upon the grant of licences under the patent, or upon the purchase, hire or use of the patented article or process, he may, subject to the provisions of that section, order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant.

(2) Where an application under section 84 is made by a person being the holder of a licence under the patent, the Controller may, if he makes an order for the grant of a licence to the applicant, order the existing licence to be cancelled, or may, if he thinks fit, instead of making an order for the grant of a licence to the applicant, order the existing licence to be amended.

(3) Where two or more patents are held by the same patentee and an applicant for a compulsory licence establishes that the reasonable requirements of the public have not been satisfied with respect to some only of the said patents, then, if the Controller is satisfied that the applicant cannot efficiently or satisfactorily work the licence granted to him under those patents without infringing the other patents held by the patentee and if those patents involve important technical advancement or considerable economic significance in relation to the other patents, he may, by order, direct the grant of a licence in respect of the other patents also to enable the licensee to work the patent or patents in regard to which a licence is granted under section 84.

(4) Where the terms and conditions of a licence have been settled by the Controller, the licensee may, at any time after he has worked the invention on a commercial scale for a period of not less than twelve months, make an application to the Controller for the revision of the terms and conditions on the ground that the terms and conditions settled have proved to be more onerous than originally expected and that in consequence thereof the licensee is unable to work the invention except at a loss:

Provided that no such application shall be entertained a second time.

GENEAL PURPOSES FOR GRANTING CL

SECTION 89

Powers of Controller shall be exercised with a view to securing the following general purposes:

That patented inventions are worked on a commercial scale in the territory of India without undue delay and to the fullest extent that is reasonably practicable;

That the interests of any person for the time being working or developing an invention in the territory of India under the protection of a patent are not unfairly prejudiced.

TERMS AND CONDITIONS OF CL SECTION 90

Royalty and any other remuneration to be paid to patentee will be decided by taking into consideration about the expenditure incurred by the patentee in;

- i) making & developing the invention
- ii) obtaining a patent
- iii) keeping the patent in force, and
- iv) other relevant factors.

Licensee should work the invention in full and shall be able to make some profit.

Patented article shall be made available at reasonably affordable prices.

CL is non-exclusive licence

CL right is non-assignable

CL as granted may be till the expiry of patent term or still shorter.

Licensee after meeting the local requirement is permitted to export.

In the case of semi conductor technology licensee is to work the invention for public non-commercial use.

Section 90

Terms and conditions of compulsory licences

(1) In settling the terms and conditions of a licence under section 84, the Controller shall endeavour to secure—

(i) that the royalty and other remuneration, if any, reserved to the patentee or other person beneficially entitled to the patent, is reasonable, having regard to the nature of the invention, the expenditure incurred by the patentee in making the invention or in developing it and obtaining a patent and keeping it in force and other relevant factors;

(ii) that the patented invention is worked to the fullest extent by the person to whom the licence is granted and with reasonable profit to him;

(iii) that the patented articles are made available to the public at reasonably affordable prices;

(iv) that the licence granted is a non-exclusive licence;

(v) that the right of the licensee is non-assignable;

(vi) that the licence is for the balance term of the patent unless a shorter term is consistent with public interest;

(vii) that the licence is granted with a predominant purpose of supply in the Indian market and that the licensee may also export the patented product, if need be in accordance with the provisions of sub-clause (iii) of clause (a) of sub-section (7) of section 84;

(viii) that in the case of semi-conductor technology, the licence granted is to work the invention for public non-commercial use;

(ix) that in case the licence is granted to remedy a practice determined after judicial or administrative process to be anti-competitive, the licensee shall be permitted to export the patented product, if need be.

(2) No licence granted by the Controller shall authorise the licensee to import the patented article or an article or substance made by a patented process from abroad where such importation would, but for such authorisation, constitute an infringement of the rights of the patentee.

(3) Notwithstanding anything contained in sub-section (2), the Central Government may, if in its opinion it is necessary so to do, in the public interest, direct the Controller at any time to authorise any licensee in respect of a patent to import the patented article or an article or substance made by a patented process from abroad (subject to such conditions as it considers necessary to impose relating among other matters to the royalty and other remuneration, if any, payable to the patentee, the quantum of import, the sale price of the imported article and the period of importation), and thereupon the Controller shall give effect to the directions.

Section 91

Licensing of related patents

(1) Notwithstanding anything contained in the other provisions of this Chapter, at any time after the sealing of a patent, any person who has the right to work any other patented invention either as patentee or as licensee thereof, exclusive or otherwise, may apply to the Controller for the grant of a licence of the first mentioned patent on the ground that he is prevented or hindered without such licence from working the other invention efficiently or to the best advantage possible.

(2) No order under sub-section (1) shall be made unless the Controller is satisfied—

(i) that the applicant is able and willing to grant, or procure the grant to the patentee and his licensees if they so desire, of a licence in respect of the other invention on reasonable terms; and

(ii) that the other invention has made a substantial contribution to the establishment or development of commercial or industrial activities in the territory of India.

(3) When the Controller is satisfied that the conditions mentioned in sub-section (1) have been established by the applicant, he may make an order on such terms as he thinks fit granting a licence under the first mentioned patent and a similar order under the other patent if so requested by the proprietor of the first mentioned patent or his licensee:

Provided that the licence granted by the Controller shall be non-assignable except with the assignment of the respective patents.

(4) The provisions of sections 87, 88, 89 and 90 shall apply to licences granted under this section as they apply to licences granted under section 84.

SPECIAL PROVISION FOR CL ON NOTIFICATIONS BY CENTRAL GOVERNMENT – SECTION 92

If the Government is satisfied in respect of any patent in force in circumstances of;

National emergency; or

In circumstances of extreme urgency; or

In case of public non-commercial use

that CL shall be granted at any time after the grant of patent may declare and notify in the Official Gazette with the effect of following provisions;

Controller shall grant CL to the applicant who filed for CL after notification on the terms and conditions he thinks fit.

Controller shall ensure that the articles of patent shall be available at the lowest prices consistent with the patentee deriving a reasonable advantage from their patent rights.

The provisions of sections 83,87,88,89 and 90 shall apply to this section.

In the cases of public health crises, relating to AIDS, HIV, TB, MALARIA or other epidemics, Controller shall not apply any procedure of Section 87 and will inform the patentee accordingly.

Section 92

Special provision for compulsory licences on notifications by Central Government

(1) If the Central Government is satisfied, in respect of any patent in force in circumstances of national emergency or in circumstances of extreme urgency or in case of public non-commercial use, that it is necessary that compulsory licenses should be granted at any time after the sealing thereof to work the invention, it may make a declaration to that effect, by notification in the Official Gazette, and thereupon the following provisions shall have effect, that is to say—

(i) the Controller shall on application made at any time after the notification by any person interested, grant to the applicant a licence under the patent on such terms and conditions as he thinks fit;

(ii) in settling the terms and conditions of a licence granted under this section, the Controller shall endeavour to secure that the articles manufactured under the patent shall be available to the public at the lowest prices consistent with the patentees deriving a reasonable advantage from their patent rights.

(2) The provisions of sections 83, 87, 88, 89 and 90 shall apply in relation to the grant of licences under this section as they apply in relation to the grant of licences under section 84.

(3) Notwithstanding anything contained in sub-section (2), where the Controller is satisfied on consideration of the application referred to in clause (i) of sub-section (1) that it is necessary in—

- (i) a circumstance of national emergency; or
- (ii) a circumstance of extreme urgency; or
- (iii) a case of public non-commercial use,

which may arise or is required, as the case may be, including public health crises, relating to Acquired Immuno Deficiency Syndrome, Human Immuno Deficiency Virus, tuberculosis, malaria or other epidemics, he shall not apply any procedure specified in section 87 in relation to that application for grant of licence under this section:

Provided that the Controller shall, as soon as may be practicable, inform the patentee of the patent relating to the application for such non-application of section 87.

CL FOR EXPORT OF PATENTED PHARMACEUTICAL PRODUCTS IN CERTAIN EXCEPTIONAL CIRCUMSTANCES – SECTION 92A

CL is available for MANUFACTURE & EXPORT of patented pharmaceutical products to any country; Having insufficient or no manufacturing capacity in the pharmaceutical sector for the concerned product to address public health problems provided compulsory licence has been granted by such country or such country by notification or otherwise, allowed importation of the patented pharmaceutical products from India.

Controller will grant CL for only such conditions and publish it.

Pharmaceutical products includes the ingredients needed to manufacture and diagnostic kits as well.

Section 92A

Compulsory licence for export of patented pharmaceutical products in certain exceptional circumstances

(1) Compulsory licence shall be available for manufacture and export of patented pharmaceutical products to any country having insufficient or no manufacturing capacity in the pharmaceutical sector for the concerned product to address public health problems, provided compulsory licence has been granted by such country or such country has, by notification or otherwise, allowed importation of the patented pharmaceutical products from India.

(2) The Controller shall, on receipt of an application in the prescribed manner, grant a compulsory licence solely for manufacture and export of the concerned pharmaceutical product to such country under such terms and conditions as may be specified and published by him.

(3) The provisions of sub-sections (1) and (2) shall be without prejudice to the extent to which pharmaceutical products produced under a compulsory license can be exported under any other provision of this Act.

Explanation.—For the purposes of this section, 'pharmaceutical products' means any patented product, or product manufactured through a patented process, of the pharmaceutical sector needed to address public health problems and shall be inclusive of ingredients necessary for their manufacture and diagnostic kits required for their use.

OTHER ISSUES UNDER CL – SECTION 93

Order of grant of licence including the terms and condition embodied therein shall act as a operation deed between parties.

Section 93

Order for licence to operate as a deed between parties concerned

Any order for the grant of a licence under this Chapter shall operate as if it were a deed granting a licence executed by the patentee and all other necessary parties embodying the terms and conditions, if any, settled by the Controller.

TERMINATION OF CL – SECTION 94

Application is made by the patentee or any other person deriving title or interest in the patent.

Can be terminated when the circumstances that lead for CL does not exist and such circumstances does not likely to recur.

CL holder can file an objection to termination.

While terminating the CL it shall be considered by the Controller that the interest of the CL holder is not unduly prejudiced.

Section 94

Termination of compulsory licence

(1) On an application made by the patentee or any other person deriving title or interest in the patent, a compulsory licence granted under section 84 may be terminated by the controller, if and when the circumstances that gave rise to the grant thereof no longer exist and such circumstances are unlikely to recur:

Provided that the holder of the compulsory licence shall have the right to object to such termination.

(2) While considering an application under section (1), the Controller shall take into account that the interest of the person who had previously been granted the licence is not unduly prejudiced.

CHAPTER V

Patent Drafting

IMPORTANCE OF PATENT DRAFTING

Drafting shall enable a person skilled in the art to perform the invention by a plain reading of the specification without really needing the help of the inventor(s) or the applicant(s)

To enjoy the monopoly as broadly as possible in the chosen field without infringing the existing patents

WHAT IS PATENT SPECIFICATION?

It is a techno-legal document that comprises 2 portions;

- a) description &
- b) claims

In general a provisional specification does not have claims portion unless a complete specification is converted into a provisional specification.

Complete Specification shall have both description and claims.

WHAT IS DESCRIPTION?

Description is an explanatory part of the alleged invention

Description comprises field of invention, problems of the prior art, technical solution to the said problems, best method of performing the invention, supporting disclosure by way of examples.

WHAT IS A CLAIM PORTION?

It is generally placed after the end of the description

No restriction on number of claims

Can be any number of independent and dependent claims

All the claims shall be connected through a single inventive concept

All the claims shall be related to a single invention only.

WHAT IS THE IMPORTANCE OF CLAIM(S)

Explains the technical boundary of the invention

Explains the extent of monopoly that can be exercised by the owner

Is the basis for understanding the infringement, if infringed and file a suit in a court of law accordingly.

DRAFT OF DESCRIPTION

Description generally has the following captions.

- (a) Field of invention
- (b) Prior art, if any
- (c) Problems of prior art, if any
- (d) Probable technical solution in brief
- (e) Objects of the invention
- (f) Brief description of the accompanying drawings, if any
- (g) Detailed description of the invention
- (h) Examples – actual work of invention

TECHNICAL FIELD OF INVENTION

The opening lines of description shall read as, “ the present invention relates to.....(preferably followed by the title of invention)

The next few lines or paragraphs shall be dedicated to the gradual transformation of the invention from broader perspective to finer perspective.

PRIOR ART

Is not mandatory

If known, better to provide prior art

If provided, helps in understanding the invention

Helps in keyword search

Helps in differentiating the invention from the prior art

If many documents are referred, it indicates the importance of the field which is under constant investigation.

PROBLEMS OF PRIOR ART

Most of the inventions are incremental in nature

Hence majority of the applications filed for patent has prior art

The present invention is the obvious result come out of the problems faced in the state of art.

OBJECTS OF THE INVENTION

No restrictions on mentioning various objects of the invention

The very first object of the invention generally gives the idea about what applicant has achieved

The following objects of the invention provides variable embodiments of the invention

The study of the objects of the invention provides a comprehensive understanding of the invention

TECHNICAL SOLUTION

A brief technical solution shall be followed by the problems identified in the prior art

The first object reflects what to achieve and brief solution describes how to achieve.

BRIEF DESCRIPTION OF THE ACCOMPANYING DRAWINGS, IF ANY

If it is necessary to describe the invention with the help of drawings or figures, please do so

Drawings shall be separated from the description

No descriptive matter shall be there on drawings

Same parts in the different drawings shall be marked either by same numerals or same alphabets which shall be descriptively elaborated only in the description

Probably the inference shall be given along with the nature of the drawing in the brief description

The drawing which vividly explains the invention may be stressed upon.

DETAILED DESCRIPTION

A detailed description may be detailed with the following captions.

The product

The process, or different processes if any and the best amongst

The apparatus

The different embodiments

Nomenclature

Definitions

EXAMPLES

Provides the actual work done by the inventor / applicant

At least one example from either end of the range claimed

Comparative examples to substantiate the alleged invention

If invention relates to a machine a performance comparison may be given

Efficacy studies, flow charts, comparative tables may be part of examples.

MANDATORY REQUIREMENTS

If the invention is related to biological material, then;

The geographical origin shall be mentioned

If biological material is from India, then permission from necessary authorities shall be filed before the date of grant

Deposition of biological material in an authorized depository before filing an application for patent

Mention of accession number and date of accession shall be given.

CLAIMS

When many independent claims are to be claimed please give importance to what was the first object to be achieved through this invention in the principal claim

One may draft independent plus claims dependent thereon as set or one may provide all the independent claims first and dependent claims dependent on various independent claims.

Section 2(1)(j) teaches that any new product or process involving an inventive step and capable of industrial application

Therefore use claims are not allowable

If invention relates to a composition then synergistic effect, if any, shall be clearly brought out in the claim

Claims shall not be repetitive in nature and shall be closely related

Subject matter of claims shall be fairly based on the matter disclosed in the description

If invention relates to a novel derivative, enhancement in known efficacy shall be brought out in the claim.

AIM OF INVENTOR / APPLICANT

Shall claim as broadly as possible

Shall not infringe the other patents [owned by competitors]

Shall be able to enjoy the monopoly for a future period by not giving a chance to competitors, even if they improve upon the invention as disclosed herein but still falling within the scope

Fulfilling the requirements under section 10 but at the same time the secrecy of technical-know-how, trade secrets etc., are to be maintained

Enable the applicant to enjoy the monopoly as broadly as possible in the chosen field.

CHAPTER VI

Infringement and Defenses

If a Patentee desires to file a suit for infringement, the Patentee shall do so in a Court not lower than a District Court. If the defendant files a counter claim only on the merits of the case and do not make any prayer for revocation of the patent, the infringement proceedings shall be carried out in the District Court. If the defendant prays for revocation of a patent in his/her's counter claim then the suit along with the counter claim shall be transferred to High Court. It may be noted that the grounds of defense in both the cases may be the same.

Exclusive licensee is also eligible to file a suit for infringement. Being a licensee he/she too enjoys the like privileges of a Patentee with respect in filing a suit for infringement and claiming the damages. Patentee may or may not join with the plaintiff and unless patentee appears in person and takes part in proceedings is not eligible to claim any damages.

A licensee cannot file a suit for infringement before any Court without intimating the Patentee. If the Patentee ignores the plead made by the licensee to initiate proceedings to file a suit for infringement then after the expiry of 2 months from the date of communication and as if he/she is the patentee can file a suit for infringement. The plaintiff in such case shall make the Patentee as the defendant for his/her case. Unless the Patentee appears in person and take part in proceedings the Patentee is not eligible for claiming any damages.

When the suit for infringement for a process patent then the burden of proof lies with the defendant to show and prove that the process followed by him/her is different from the patented process.

A person, against whom, no infringement suit is filed, may approach the Court to institute a SUIT FOR DECLARATION that he/she is not infringing any patented product or process to seek relief from likelihood of filing a suit against him by the Patentee. Court may grant such relief if it is shown that the Plaintiff has approached the Patentee or exclusive licensee to acknowledge the declaration made by him and Patentee or exclusive licensee has refused to do or neglected the request. It may further be noted here validity of a claim cannot be questioned by Plaintiff in a suit for declaration.

The Applicant or Patentee [before grant and after grant] may issue groundless threats after either 18 month publication or publication of grant and in such circumstances; the aggrieved party may file a suit against the Applicant or Patentee. The Court may grant relief on the merits of the case. It may be noted here that a mere notification of the existence of a patent does not constitute as a threat.

The use of the patented product or process for further development and submission of information according to the law of land including a foreign government does not constitute as an infringement. Any commercial activity for this person is also considered as non-infringement.

Defenses against any suit for infringement are the specified grounds as provided under Section 64 for the revocation of patent. The same grounds can be used as a defense in a suit of infringement. Both prayers are different and held in different Courts. The revocation of patent proceedings are held by High Court whereas defense pleadings can be held by any Court but not inferior to a District Court.

In any suit for infringement, the order, if goes in favour of the Plaintiff, being either the Patentee or exclusive licensee, the Court may grant a relief giving the option to the Plaintiff either to claim damages or to claim on account of profits.

In a suit for infringement of 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 proceeding 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.

If in any proceedings before the Appellate Board or a High Court for the revocation of a patent under section 64 and section 104, as the case may be, the validity of any claim of a specification is contested and that claim is found by the Appellate Board or the High Court to be valid, the Appellate Board or the High Court may certify that the validity of that claim was contested in those proceedings and was upheld.

Where any such certificate has been granted, then, if in any subsequent suit before a court for infringement of that claim of the patent or in any subsequent proceeding for revocation of the patent in so

far as it relates to that claim, the patentee or other person relying on the validity of the claim obtains a final order or judgment in his favour, he shall be entitled to an order for the payment of his full costs, charges and expenses of and incidental to any such suit or proceeding properly incurred so far as they concern the claim in respect of which the certificate was granted, unless the court trying the suit or proceeding otherwise directs:

Provided that the costs as specific in this sub-section shall not be ordered when the party disputing the validity of the claim satisfies the court that he was not aware of the grant of the certificate when he raised the dispute and withdrew forthwith such defence when he became aware of such a certificate.

Nothing contained in this section shall be construed as authorising the courts or the Appellate Board hearing appeals from decrees or orders in suits for infringement or petitions for revocation, as the case may be, to pass orders for costs on the scale referred to therein.

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 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.

CHAPTER VII

Patent cooperation treaty [PCT]

The members of the Paris Convention are the members of the Patent Cooperation Treaty [PCT]. Under Paris Convention filing the Convention applications was facilitated. According to Paris Convention the applicant for a patent is entitled to a Priority Date which will be considered as date of disclosure to all the member countries even there is no actual filing in the member countries. In other words owing to the accordance of Priority Date and whenever the applicant enters into a National Phase in the countries of his choice among the member countries only each nation shall make the Novelty assessment with respect to the Priority Date but not on the Filing Date which is a later date to the Priority Date. The restriction is that the applicant shall decide about national phase entry within a non-extendable time limit of 12 months from the date of priority which is also the first filing date of that particular patent application.

There are drawbacks in the Convention Application filing system. They are;

- (a) The applicant shall decide to file in foreign countries, if interested within a non-extendable time limit of 12 months from the date of priority which is a risk taking step.
- (b) Applicant is not aware in which countries he/she may be awarded with Patent Right or not owing to the differential approach towards patentability criteria among the member countries.
- (c) Applicant in order to protect invention in many countries needs to shell out lot of money towards filing and patent attorney fee [local correspondence address is mandatory] etcetera in each of the member country.

Therefore, a new system was devised to eliminate the above said problems at international level and a Treaty was made and implemented which is known as PCT –Patent Cooperation Treaty. PCT system is an International Filing System but not an International Granting System. Under PCT an International Filing Date is accorded which will be the deemed date of filing in all the member countries. To become a member under PCT one needs to become a member under Paris Convention.

PCT system is a facilitating system for the applicant for a patent. An applicant can choose any country preferably, the home country as Receiving Office [RO] of his/her's International Patent Application. The applicant has to choose one of the countries among the list attached to that particular RO as his/her's preferred International Search Authority [ISA]. ISA after receiving the application from International Bureau [IB] a controlling authority under PCT shall make a report on Novelty, Inventive Step or Non-obviousness and Industrial Applicability, which is known International Search Report [ISR] and send the report directly to the applicant. If applicant desires to make any amendments, the applicant is allowed to amend only CLAIM PORTION but not description. Or if the applicant desires to file a protest can do so

without any amendment. Whether amendment to claims are made or not there will be no further examination done by ISA. This entire activity is known as Chapter I of the PCT and is mandatory.

Chapter II of the PCT is optional for the applicant for patent. Under Chapter II the applicant can make amendments to the entire specification including description and claims. But care shall be taken that the proposed amendments shall not go beyond the scope of the invention which was originally disclosed or as filed. If the applicant desires to obtain one more International Opinion or desires to obtain on the amended specification may opt for Chapter II by filing a Demand [application] before any chosen International Preliminary Examination Authority [IPEA]. IPEA prepares an International Preliminary Examination Report [IPER] which is forwarded to the applicant.

Whether the applicant opts for Chapter II or not the applicant gets a prescribed non-extendable time limit to enter national phase. The said prescribed non-extendable time limit varies from 20 months to 30 months from the date of priority. India provides 31 months for National Phase entry. Most of the member countries follow 30 month deadline. Therefore the activities under PCT system are strictly time bound. The various activities are;

- (a) ISR reaches the applicant within 16 months from the earliest date of priority
- (b) Applicant is given 2 months' time to file reply, if desired so
- (c) There is an International Publication of the application at just after the expiry of 18 months from the earliest priority date
- (d) If desired, the applicant needs to file a Demand before the expiry of 20 months from the earliest priority date.
- (e) IPER will be issued at the expiry of 28 months from the earliest priority date
- (f) Applicant may enter the National Phase within a period of 20/30/31 months from the earliest priority date.

Advantages of the PCT SYSTEM are:

- (a) One single application is sufficient to file and obtain a date of filing in all the member countries.
- (b) Applicant in advance is aware of the fate of the patentability criteria of the invention.
- (c) Applicant gets opportunities to amend the claims and specification in Chapters I and II respectively before entering the National Phase
- (d) A cost effective system as the International Filing System provides a way of knowing the probability on patentability criteria in advance and thus saving a lot of money when the applicant desires to enter in many countries.
- (e) Applicant gets more time [more than 12 months under Paris Convention] on assessing the commercial viability in different countries of the invention.

The PCT procedure consists of two main phases. It begins with the filing of an international application and ends (in the case of a favorable outcome for the applicant) with the grant of a number of national and/or regional patents: hence the terms “international phase” and “national phase.” (The expression “national phase” is used even if the Office before which it takes place is a regional Office). The expressions “international phase” and “national phase” are not actually used in the PCT, but they are convenient, short expressions which have become customary for usage.

The international phase, which is the subject of this part of the Guide, consists of five stages. The first three occur automatically for all international applications and the last two are optional. The first three steps consist of the filing of the international application by the applicant and its processing by the “receiving Office” the establishment of the international search report and written opinion by one of the “International Searching Authorities” and the publication of the international application together with the international search report by the International Bureau of WIPO (hereinafter referred to as “the International Bureau”). The fourth step includes the establishment of a supplementary international search which may be carried out by one or more of the International Searching Authorities (other than the one that carried out the main international search) resulting in the establishment of a supplementary international search report. Hereinafter, reference to the “(main) international search” alone does not include reference to the “supplementary international search”, and reference to “international search report” alone does not include reference to “supplementary international search report”, except where otherwise indicated. The third step includes communication of the published international application and the international search report and, where applicable, the supplementary international search report(s), as well as the international preliminary report on patentability (Chapter I of the PCT), by the International Bureau to the national (or regional) Offices which the applicant wishes to grant him a patent on the basis of his international application (the so-called “designated Offices”). The communication occurs upon request by the designated Office to the International Bureau.

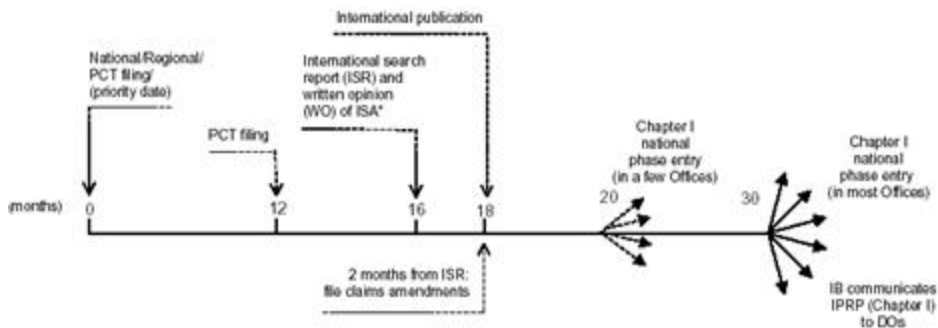
The optional fifth step involves what is known as international preliminary examination (under Chapter II of the PCT), and is concluded with the establishment of the international preliminary report on patentability (Chapter II of the PCT) by one of the “International Preliminary Examining Authorities” (see Annex E). The international preliminary report on patentability (Chapter II of the PCT) analyzes aspects of the general patentability of the invention. Together with the published international application, the international search report and any supplementary international search report, the international preliminary report on patentability (Chapter II of the PCT) is communicated to the national (or regional) Offices which the applicant wishes to grant him a patent on the basis of his international application (the so-called “elected Offices”). The communication occurs upon request by the elected Office to the

International Bureau. International preliminary examination is available subject to certain conditions and qualifications being met.

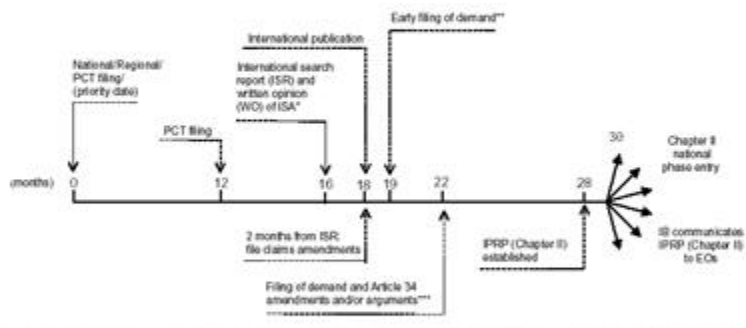
On completion of the international phase, further action is required before and in each of the national (or regional) Offices which the applicant wishes to grant him a patent on the basis of his international application. In particular, the applicant has to pay to those Offices the required national (or regional) fees, furnish them with any translations that are required and appoint a representative (patent agent) where required. There are time limits by which those steps must be taken if the application is to proceed in the national phase. If the steps are not taken within the applicable time limit, the effect of the international application may cease in any State where the time limit has not been met. The national (or regional) Offices then examine the application and grant or refuse the national (or regional) patent on the basis of their national laws. (In the PCT and in this Guide, any reference to “national law” is also a reference to a regional treaty such as the ARIPO Harare Protocol, the Eurasian Patent Convention, the European Patent Convention and the OAPI Agreement. These procedures before the national (or regional) Offices constitute what is usually referred to as the “national phase” of the PCT procedure and are considered in that part of this Guide.

It is up to the applicant to decide whether and when to enter the national phase before each national (or regional) Office. The international phase continues, for any particular State, until entry into the national phase before the national (or regional) Office concerned or until the expiration of the applicable time limit for entering the national phase before that Office. Since the national phase may be entered before different Offices at different times, the international application may simultaneously be in the international phase for some States and the national phase for others. Where national phase processing or examination has begun before a particular Office, any actions taken on the international application remaining in the international phase have no effect on the proceedings before that Office.

PCT TIMELINE - Chapter I only
(for international applications filed on or after 1 January 2004)



PCT TIMELINE - Chapter II
(for international applications filed on or after 1 January 2004)



Summary of the Patent Cooperation Treaty (PCT) (1970)

The Patent Cooperation Treaty (PCT) makes it possible to seek patent protection for an invention simultaneously in each of a large number of countries by filing an "international" patent application. Such

an application may be filed by anyone who is a national or resident of a PCT Contracting State. It may generally be filed with the national patent office of the Contracting State of which the applicant is a national or resident or, at the applicant's option, with the International Bureau of WIPO in Geneva.

If the applicant is a national or resident of a Contracting State party to the European Patent Convention, the Harare Protocol on Patents and Industrial Designs (Harare Protocol), the Bangui Agreement, or the Eurasian Patent Convention, the international application may also be filed with the European Patent Office (EPO), the African Regional Intellectual Property Organization (ARIPO), the African Intellectual Property Organization (OAPI) or the Eurasian Patent Office (EAPO), respectively.

The Treaty regulates in detail the formal requirements with which international applications must comply.

Filing a PCT application has the effect of automatically designating all Contracting States bound by the PCT on the international filing date. The effect of the international application is the same in each designated State as if a national patent application had been filed with the national patent office of that State.

The international application is subjected to an international search. That search is carried out by one of the competent International Searching Authorities (ISA) under the PCT [1] and results in an international search report, that is, a listing of the citations of published documents that might affect the patentability of the invention claimed in the international application. In addition, a preliminary and non-binding written opinion on whether the invention appears to meet patentability criteria in light of the search report results is also issued.

The international search report and written opinion are communicated to the applicant who, after evaluating their content, may decide to withdraw the application, in particular where the content of the report and opinion suggests that the granting of patents is unlikely, or the applicant may decide to amend the claims in the application.

If the international application is not withdrawn, it is published by the International Bureau, together with the international search report. At the same time, the written opinion is made available on PATENTSCOPE.

Before the expiration of 22 months from the priority date, the applicant has the option to request a Supplementary International Searching Authority (SISA) (an ISA willing to offer this service) to carry out an additional search of relevant documentation, specifically focusing on documents in the particular language in which that authority specializes. The goal of this additional search is to reduce the likelihood of further documents coming to light in the national phase that would make granting the patent unlikely.

An applicant that decides to continue with the international application with a view to seeking national (or regional) patents can, in relation to most Contracting States, wait until the end of the thirtieth month from the priority date to commence the national procedure before each designated office by furnishing a translation (where necessary) of the application into the official language of that office, paying to it the necessary fees and acquiring the services of local patent agents.

If the applicant wishes to make amendments to the application – for example, in order to address documents identified in the search report and conclusions made in the written opinion – and to have the potential patentability of the "as-amended" application reviewed – an optional international preliminary examination may be requested. The result of the preliminary examination is an international preliminary report on patentability (IPRP Chapter II) which is prepared by one of the competent International Preliminary Examining Authorities (IPEA) under the PCT [2] and which contains a preliminary and non-binding opinion on the patentability of the claimed invention. It provides the applicant with an even stronger basis on which to evaluate the chances of obtaining a patent and, if the report is favorable, a stronger basis on which to continue with the application before national and regional patent offices. If no international preliminary examination has been requested, the International Bureau establishes an international preliminary report on patentability (IPRP Chapter I) on the basis of the written opinion of the ISA and communicates this report to the designated offices.

The procedure under the PCT has numerous advantages for applicants, patent offices and the general public:

- (i) applicants have up to 18 months more than if they had not used the PCT to reflect on the desirability of seeking protection in foreign countries, appoint local patent agents in each foreign country, prepare the necessary translations and pay national fees;
- (ii) applicants can rest assured that, if their international application is in the form prescribed by the PCT, it cannot be rejected on formal grounds by any designated office during the national phase;
- (iii) on the basis of the international search report and the written opinion, applicants can evaluate with reasonable probability the chances of their invention being patented;
- (iv) applicants have the possibility, during the optional international preliminary examination, to amend the international application and thus put it in order before processing by the various patent offices;
- (v) the search and examination work of patent offices can be considerably reduced or eliminated thanks to the international search report, the written opinion and, where applicable, the international preliminary report on patentability which are communicated to designated offices together with the international application;

(vi) applicants are able to access fast-track examination procedures in the national phase in Contracting States that have PCT-Patent Prosecution Highway (PCT-PPH) agreements or similar arrangements;

(vii) since each international application is published with an international search report, third parties are in a better position to formulate a well-founded opinion about the potential patentability of the claimed invention; and

(viii) for applicants, international publication on PATENTSCOPE puts the world on notice of their applications, which can be an effective means of advertising and looking for potential licensees.

Ultimately, the PCT: brings the world within reach; streamlines the process of fulfilling diverse formality requirements; postpones the major costs associated with international patent protection; provides a strong basis for patenting decisions; and is used by the world's major corporations, research institutions and universities in seeking international patent protection.

The PCT created a Union which has an Assembly. Every State party to the PCT is a member of the Assembly. Among the most important tasks of the Assembly are the amendment of the Regulations issued under the Treaty, the adoption of the biennial program and budget of the Union and the fixing of certain fees connected with the use of the PCT system.

The Assembly of the PCT Union has established a special measure to benefit (1) an applicant who is a natural person and who is a national of and resides in a State that is listed as being a State whose per capita gross domestic product is below US\$ 25,000 (according to the most recent 10-year average per capita gross domestic product figures at constant 2005 US\$ values published by the United Nations), and whose nationals and residents who are natural persons have filed less than 10 international applications per year (per million population) or less than 50 international applications per year (in absolute numbers) according to the most recent five-year average yearly filing figures published by the International Bureau, and (2) applicants, whether natural persons or not, who are nationals of and reside in a State that is listed as being classified by the United Nations as a LDC. That benefit consists of a reduction of 90 per cent of certain fees under the Treaty.

Details concerning the PCT can be obtained by consulting the PCT website, the PCT Applicant's Guide, published by WIPO in English and French and the PCT Newsletter, published by WIPO in English.

The PCT was concluded in 1970, amended in 1979 and modified in 1984 and in 2001.

It is open to States party to the Paris Convention for the Protection of Industrial Property (1883). Instruments of ratification or accession must be deposited with the Director General of WIPO.

PATENT COOPERATION TREATY – ARTICLES – REGULATIONS

SOURCE OF ARTICLES: <https://www.wipo.int/pct/en/texts/articles/atoc.html>

Articles 10 to 14 provide the guidelines for the functioning of a Receiving Office.

Articles 15 to 30 provide the guidelines for Chapter I

Articles 31 to 42 provide guidelines for Chapter II

Articles 43 to 49 provide guidelines to Common Provisions.

Articles 50 to 52 provide guidelines to Technical Services

Articles 53 to 58 provide guidelines to Administrative services.

Article 59 is related to Disputes

Articles 60 to 61 provide guidelines on Revision of Amendments.

Articles 60 to 69 provide guidelines on Final Provisions

REGULATIONS UNDER THE PATENT COOPERATION TREATY

One may refer the following urls for the details: There are 96 rules in the Regulations which provides the procedural details under PCT system

<https://www.wipo.int/pct/en/texts/rules/rtoc1.html>

https://www.wipo.int/export/sites/www/pct/en/texts/pdf/pct_regs.pdf

INDIAN PATENT OFFICE ACTING – AS ISA & AS IPEA & FOR NATIONAL ENTRY UNDER PCT

Indian Patent Office is also the appropriate office to receive the International Patent Applications and can function as the Receiving Office [RO]. Indian Patent Office is also the International Searching authority [ISA] and the International Preliminary Examination Authority [IPEA]. Therefore, Indian Patent Office can issue ISR and IPER as well. The Indian applicants who choose India as ISA and or IPEA enjoy a special provision of expedited examination of their National Phase Applications.

Receiving Office can be any branch office of Indian Patent Office and jurisdiction as provisioned in Rule 4 of the Indian Patents Rules for place of filing is followed. But only Delhi branch office deals with IB and acts as ISA and IPEA.

Indian Patent Office [IPO] receives International applications either in English or Hindi language. All matters pertaining to international applications shall be kept confidential in accordance with the treaty and the regulations under the Treaty.

Applicants need to file International application in triplicate. HOME COPY is retained with RO. RECORD COPY will be transmitted to IB and the SEARCH COPY is transmitted to the competent ISA.

If India is declared as ISA by the applicant then India being Searching Authority shall establish the International Search Report and written **opinion within a period of three months from the date of receipt of the search copy by the Searching Authority, or within a period of nine months from the date of priority, whichever expires later.** One copy of the ISR will be sent to IB and one copy to the applicant on the same day.

India if elected as IPEA, then the period for establishing the International Preliminary Examination Report shall be:

1. twenty eight months from the priority date; or
2. six months from the period specified under Rule 69.1 of the regulations under the Treaty for the start of the international preliminary examination; or
3. six months from the date of receipt by the Examining Authority of the translation furnished under Rule 55.2 of the regulations under the Treaty, whichever expires last.

One copy of the IPEA will be sent to IB and one copy to the applicant on the same day.

CHAPTER VIII

Patent Search

Patent Search is one of the most important topics as it provides a basis for a group of activities.

- a) It provides an insight into the present trend in research and development.
- b) It provides the information about the strategic commercial activities of a competitor.
- c) It provides the information on what areas or requisite areas to be explored in research and development.
- d) It provides the information on the easiness or difficulties or failures in solving a technical problem which is the crux of a patent application. Therefore, it further provides an opportunity to proceed further on the left out core problems that needs the attention to solve them.
- e) It provides the information on commercially viable solution(s) of a given technical problem or a set of problems and the researches gets an opportunity to think and develop cheaper alternatives.
- f) It provides the information to patent seekers to invent and protect.
- g) It provides the information to Examiner-Controller pair [for Indian Patent Office] in any Patent Office to conclude and assess the presence or absence of Novelty and Inventive Step or Non-obviousness, thus enabling Patent Office to decide on the grant of a patent right to the applicant.

PATENT SEARCH FOR A PATENT APPLICATION

It is known in the patent circles that a complete specification broadly comprises description and claims. Patent protection is given to an invention through the claims as filed or as amended. Therefore claims of a patent specification are to be searched for patentability. Claims, generally covers the entire invention in Independent Claim(s) and claims dependent on the Independent claims. [Dependent Claims]. Each Independent claim is a complete or a precise version of an invention in its broadest form as far as possible. A Dependent Claim on any corresponding Independent Claim defines a narrower or a preferred version of a given invention. As discussed earlier there is a possibility of different claims of a patent application having different priority dates.

Instead of just reading the claims is not sufficient to understand an invention in detail. One needs to look into “Description” of an invention to understand on how the alleged invention is different from the prior art, what efforts are made by the applicant to overcome the known technical problem, how the alleged invention achieves the objects of the invention, what are the different embodiments and proof of working the alleged invention and other relevant factors, if any.

The complete specification may refer to a technical problem or a set of technical problems to be solved. The said complete specification may comprise a solution or a group of solutions to overcome the said technical problem(s). Accordingly the complete specifications can be broadly described based on the contents; that are;

- a) Complete specification that provides a single problem which is solved by a given single solution.
- b) Complete specification that provides a set of problems which is solved by a given single solution.
- c) Complete specification that provides a single problem which is solved by a given set of solutions.
- d) Complete specification that provides a set of problems which is solved by a given set of solutions.

To assess the patentability criteria, especially Novelty and Inventive or Non-obviousness it is imperative to select a key word or a set of key words both from “Technical Problem(s)” and “Technical solution(s)” as disclosed in the specification. There are several search engines are available to make searches wherein both free and paid databases are included. One needs to prepare a set of citations using key word(s) from the discussed Technical Problem(s) and similarly needs to prepare another set of citations using key word(s) from Technical Solution(s) as disclosed in the patent specification. Combine and compare both groups of citations, eliminate the duplicate(s), if any, read and compare the remaining citations with that of the patent specification in question. It may be noted that for Novelty assessment all the elements of a claim in question shall be available in a claim of comparison. One shall not combine a group of claims and decide that a claim in question has elements taken from different claims. This approach is not correct for Novelty assessment but correct approach for Inventive Step or Non-obviousness.

It may further be noted that since claims are tested for patentability criteria any subject matter that has been described but not claimed does not enjoy the patent protection. The unclaimed descriptive matter will become “Novelty destroying matter” if it is claimed by another applicant in another patent application at a later date.

Now, it should have been construed that selection of key word(s) plays a very important role in judging a patent application to be a patent eligible specification. Needless to say that wrong selection of key words makes the entire process a chaos and lead to a wrong result while granting a patent. Therefore, if the applicant provides some guidelines on the key words in the patent specification at the time of first filing; will be useful both for the patent granting authorities and the applicant themselves to safe guard against any possible error from the granting authority side.

TYPES OF PATENT SEARCHES AND OPINIONS

It is not commonly known by many inventors that there are different types of patent searches and opinions depending upon the reason for the search. Namely there are four varieties of patent searches: 1) Novelty (patentability); 2) Freedom to Operate (FTO); 3) Non-infringement; and 4) Validity.

1. Patentability Search or Novelty Search

A patentability search, otherwise known as novelty search, is conducted before filing a patent application to ensure whether the invention is new. This search is pretty important because nobody would like to lose all the hard earned money spent on drafting and filing the patent application just because the examiner found a similar concept as the invention as the criteria for rejecting a patent application.

By performing a novelty search for prior art, the inventor, patent lawyer, or a patent examiner can figure whether someone else already has had the same idea or not. If the search returns that someone has already worked on a similar idea, one can save money by not filing the application OR alter/improve the idea such that it meets the criteria of patentability.

Conducting a Novelty search helps (if not ensures) to know what are the chances that a patent may get granted. If a patentability search returns that the idea is novel and meets all the criteria for patentability, then one can file a patent and might be assured that it has a high chance of getting issued.

Given the high expenses of filing a patent and prosecuting a patent, it is always a better move to get a patentability search conducted prior to the filing of the patent application.

Benefits of a Patentability Search

It will help in drafting better claims.

There is always a chance that one might have missed information related to the technology which could improve the scope of a patent. Conducting a patentability search widens information horizons, thus making it possible to draft broader claims with an increased scope.

The strength of the patent is improved

The novelty search helps in identifying additional cases which might not have been covered by the inventor. If these uncovered cases are made part of the application it may reduce the chances of the competitor using these uncovered references against one's patent while challenging the validity of patent.

Helps understand the value of the invention

For businesses and large companies specifically, conducting a Novelty search helps determine the uniqueness and value of the patent, while helping them understand the potential for competitiveness the patent offers.

If the invention/patent is similar to a competitor's invention, the patent can be designed around to increase its monetization potential while offering the patent holder the freedom to operate. Hence the related strategy by the applicants is to increase the monetary value of a patent by filing continuations.

The Common Mistake to Avoid With Patentability Searches

Before filing an application, conducting a novelty search is never a mistake. The mistake actually happens when one carry out the move i.e., the search in a wrong way.

While one can conduct the patent search on own, one may not get the same results that a patent lawyer or a professional patent searcher could get. Conducting an efficient search requires a lot of research on the subject matter and is more than just a google keyword search. It goes without mention that it is a time-consuming process.

But there is always a chance that prior art exists for the invention, which would go unnoticed during one's own search but could be found by the examiner who would reject the grant of a patent. Hence better be careful or may engage the expert.

Some people might even think that there is no requirement of novelty search, given the additional costs. By not even opting for this search, they might be committing a big mistake that they would have to pay later for. When a patent is involved in litigations, opponents often challenge the validity of the patent to escape from paying royalties. If prior art is found for the patent in question, which is a result of lack of novelty search, in the beginning, the patent holder would not only lose potential income but also his patent rights.

So while technically there might be no need to go for novelty search, it is often better to consider it as a favorable option as preparing a provisional patent application or a complete patent application consume a lot of time, effort, and money.

2. Freedom-To-Operate Search or Clearance Search

When someone comes up with a patentable invention they usually forget about patents which are held by other people. Acquiring a patent on one's invention merely does not gives the right to operate.

How do you sell/manufacture your product/invention without infringing on other people's patents? This is where freedom to operate search comes to help.

Freedom to operate refers to the ability to sell one's product or service without infringing on the patent rights of another party. When you are granted a patent, you are granted the right to prevent people from using your patented technology. Although everyone else is stopped from infringing on your patent, you must still perform freedom to operate analysis before you bring out your product in the market. If your invention uses any other kind of invention in a form of a process, machine, or composition of matter, then freedom to operate of your product in the market becomes questionable. You run the risk of infringing on someone else's IP, which comes with its own set of consequences.

For instance, a person who invented the concept of attaching an eraser tip to be placed on the end of a pencil could patent the invention. However, there may be many patents, owned by others, on erasers, glue or the process of attaching them, that may prevent your product to freely operate in the market. Your own patent does not make you safe.

Why Is Conducting FTO Search Important?

This process is quite important as it provides the applicant with a risk assessment of his product getting into a legal suit in the near future. It also allows him to check on risk assessment for patent infringement. Not only that, conducting an FTO Search helps him to get a clear idea about the licensing needs and even helps him to move product development in the right direction.

What To Do If There Exist Patents Which Limit Your Freedom To Operate?

If there is a limitation posed by a patent/(s) in your freedom to operate, then you can choose any of the following options:

Contact the patent holder for Sale/Licensing of Patent

Reach out to the patent holder and ask her/him if s/he could sell you the patent. If the patent holder does not want to sell, you can seek a license of that patent.

Go for cross-licensing

If your product is of value to the other patent holder, you can go for cross-licensing. In this case, both the parties can give each other the license of using their invention.

Design around the features in the product

Since after the freedom to operate search you know the risk associated with a particular feature in your product, you can design around the existing patents and introduce a new feature in your product that does not overlap on any existing patent. This strategy is used by many large companies to minimize their risk.

Why Is Freedom To Operate Complex?

Setting up Freedom to Operate is not an easy process. There are a great number of patents already in existence and moreover, thousands of it are granted every week. If you are launching the product in multiple countries then you have to assess your risk in each of those countries to get a freedom to operate opinion. You have to go through the claims of the relevant patents granted in these countries to understand if their claims can be interpreted in a way that they can overlap on the features of your product. This process requires focus and time.

3. Non-infringement Opinion

Similar to the FTO search, a non-infringement opinion determines if the inventor's proposed invention will infringe a particular patent. However, non-infringement opinions are directed to a specific patent or patents that have been previously identified. For example, a non-infringement opinion should be obtained when a new product, process, or technology is created but is known to be similar to an existing patented product/process/technology, particularly in the instance when there are known competitors with patents. The steps involved for a non-infringement opinion is similar to the FTO search except that no search is conducted because the patent at issue has already been identified. And just as with the FTO opinion, the independent claims of the relevant patents must be deconstructed and analyzed and compared element by element to the proposed invention.

A significant point about conducting FTO and non-infringement opinions in advance of any allegation of infringement or commencement of a lawsuit is that if the search and opinion (preferably written opinion) is performed by a reputable licensed patent attorney, it can serve an exculpatory purpose in the event that the inventor is actually sued for patent infringement. For example, if the inventor obtains a non-infringement opinion and later in time is sued for patent infringement based upon the same patent that was analyzed in the non-infringement opinion, the court will consider the opinion and may negate a finding of enhanced damages for willful infringement which can often be "treble damages" – tripling the actual damages amount. This has been particularly significant in light of the Supreme Court's 2016 holding in *Halo Electronics, Inc. v. Pulse Electronics, Inc., et al.* and *Stryker Corporation, et al. v. Zimmer, Inc., et al.* which lowered the burden to obtain treble damages in patent infringement cases. As such the importance to obtain such opinions cannot be overstated.

4. Validity Search

Validity Search or Invalidity Search or Strength Check Or Opposition Search

Patent Validity Search or Invalidity Search is a form of search that is conducted to identify references that can question the validity/enforceability of the claims of the patent that is issued by the patent office.

These searches may be referred differently based on the objective with which the search is being performed. Validity searches are often performed by patent holders or buyers before asserting, licensing, buying, or selling a patent to confirm the enforceability of the claims. These searches can help understand whether the patent in question can survive a validity attack, and thus help one take a better-informed and stronger negotiating stance.

Why Do You Need For A Patent Validity Or Invalidity Search?

Patent examiners normally have constrained time and resources to conduct their prior art searches. By some accounts, the Patent Examiner spends an average of about 12 hours per case to conduct a prior art. Given such limited resources, it's difficult for the Examiner to explore everything that is out there. This implies that if the patent is challenged it could put the validity of the patent at risk. In litigation, the defendant can use the result of a patent invalidity search to try and overthrow the patent in court or by filing a petition for IPR.

What Is The Scope Of A Patent Invalidity Search?

As the entire Patent Infringement lawsuit depends on either the validity of the patent or proving that the product is not infringing. If we talk about invalidity, the new documents uncovered via the search must be better than the prior art on record revealed earlier by the Patent Examiner. Thus, a patent invalidity search is an all-out spell on the patent.

What Are The Reasons For Conducting A Patent Invalidity Search?

The reasons for conducting a patent invalidity search are:

When a complaint of patent infringement is received from a patent owner.

When a cease and desist notice is received from the patent owner.

Prior to enforcing your own patents to regulate invalidity risks.

Prior to buying a patent to explore the strength of the patent

Oppose a recently issued patent of a competitor

What Are The Essentials To Be Provided For A Patent Invalidity Search?

The documents which are to be provided for a patent invalidity search are:

Patent number and the detailed claims which you need to overthrow (till the time the entire claim set is at issue).

The target priority date.

The prior art that is already known to you

Objective behind conducting a validity search

5. State of the Art Search

To gain an overall perspective of a particular patent field, a State of the Art patent search is conducted over all the broad list of patent searches. It provides a longtime market advantage, by helping make strategic decisions at the corporate level. The main concern is normally the novelty of a particular invention or the invalidity of an individual patent. On the other hand, a State of the Art search dives deep for a larger view.

What Is State Of The Art Search?

In a particular field, a State of the Art Patent Search is a comprehensive review of all the patent or non-patent literature. The main aim is to make a big picture of the state of play in a defined technology field. All the non-patent literature in a particular field can also be included in it. Another way of assessing the State of the Art and attaining a more visual indication of what is going on is Patent Landscape Search.

When Is State Of The Art Patent Search Required?

The State of the Art patent search is useful in two situations:

When one want to determine the research direction;

Upon entering a new field either through investment or acquisition; or

Just to check what is out there.

Entering a New Field:, A State of the Art Search should be carried out before entering a new field to get a clear picture of the latest developments and the areas of the field that have been pursued beforehand. It

can be a great aid to find out the competitiveness of a particular field and the likelihood of long-term profitability.

Finding out Research Direction: A State of the Art search can be helpful for organizations which are already active in a particular area to determine the most suitable future direction for their research by understanding the latest developments in the field or by rethinking what has been done in the past.

What to Search in a State Of The Art Patent Search?

A State of the Art Patent Search is done to capture all relevant references that relate to the technology of interest. Generally, if we have to compare, when you are going for this type of search, the technology of interest is a bit broader than what you would select when you are going for a patentability search. It should be wide enough to capture relevant ones but at the same time should not include unrelated documents.

PATENT SEARCH DATABASES

INPASS: Indian Patent Advanced Search System

InPASS, “Indian Patent Advanced Search System”, a new facility launched on 27th February, 2015, allows a full-text search to be conducted in all the Indian Patents and Patent Applications. This facility was not available earlier in iPAIRS, the Indian Patent Information Retrieval System. Numerous functionalities have been improved in this advanced search system. With this, the iPAIRS, the Indian Patent Information Retrieval System that was launched in 2010 has now officially been withdrawn.

<http://www.ipindia.nic.in/e-gateways.htm#public-search> or
<https://ipindiaservices.gov.in/publicsearch>: for Indian patents only

CSIR PATENT DATA BASE

About Patestate

Patestate is a full-text database of India and Foreign patents granted to CSIR during 1942-till date. The database summarizes the patented inventions and describes the claims made in each individual patent document. A search engine has been incorporated for finding, exploring, analyzing and tracking patents and related information.

Source: <http://www.patestate.com/patdb.jsp> : Patent database can be searched by Simple search or Boolean search. Alternatively, Patent database can be browsed by the category.

TRADITIONAL KNOWLEDGE DIGITAL LIBRARY –TKDL

Source: <http://www.tkdl.res.in/tkdl/langdefault/common/Home.asp?GL=Eng>

The Traditional Knowledge Digital Library (TKDL) is an Indian digital knowledge repository of the traditional knowledge, especially about medicinal plants and formulations used in Indian systems of medicine. Set up in 2001, as collaboration between the Council of Scientific and Industrial Research (CSIR) and the MINISTRY OF AYUSH the objective of the library is to protect the ancient and traditional knowledge of the country from exploitation through biopiracy and unethical patents, by documenting it electronically and classifying it as per international patent classification systems. Apart from that, the non-patent database serves to foster modern research based on traditional knowledge, as it simplifies access to this vast knowledge of remedies or practices.

As of 2010, it had transcribed 148 books on Ayurveda, Unani, Siddha and Yoga in public domain into 34 million pages of information, translated into five languages — English, German, French, Spanish and Japanese. Data on 80,000 formulations in Ayurveda, 1,000,000 in Unani and 12,000 in Siddha had already been put in the TKDL. Plus it has signed agreements with leading international patent offices such as European Patent Office (EPO), United Kingdom Trademark & Patent Office (UKPTO) and the United States Patent and Trademark Office to protect traditional knowledge from biopiracy, by giving patent examiners at international patent offices access to the TKDL database for patent search and examination.

Multi-national patent databases

Ambercite AI - Finds similar patents to 1 to 200 starting patents, using unique citation AI algorithms. Easily iterate to a relevant list of patents, some of which may be missed by conventional searching - then export or share with colleagues in an interactive form. Sample search based on Steve Jobs patent found [here](#).

Aureka - enterprise-wide IP research, analysis and management platform (Thomson Reuters)

CAPLUS - Most authoritative worldwide coverage of patent information in many scientific disciplines (Chemical Abstracts Service)

Delphion (Thomson Reuters)

DEPATISnet - provides free access to bibliographic data from an expanding number of issuing authorities (CH, EP, FR, GB, JP, US, WO) as well as full-text German patents and patent documents in PDF format. (German Patent and Trademark Office (DPMA))

Derwent World Patents Index - The most comprehensive and extensive database of value-added patent documents published in the world. (Thomson Reuters)

Designs in orbit.com - Global industrial designs search and watch service covering BX, CA, CH, CN, DE, ES, EU, FR, GB, JP, KR, RU, US, and WO. (Questel)

Dialog - An online information service with more than one billion unique records including in-depth repositories of scientific and technical data, patents, trademarks and other intellectual property data.

EAPATIS - Eurasian Patent Organisation web database with free access (with registration) to abstracts and bibliographic data to EAPO patents, and paid access to full specifications of patents from 30 issuing offices, including EAPO, all former Soviet Union nations, and Soviet Union patents and invention certificates back to 1924.

edital.com - Search trademarks, domains, and designs online and cover more than 250 registers. Elaborate statistics and insert your legal opinion directly online with the help of the wizard.

UNUMBIO - Unumbio is focused on IP and legal databases and content. Unumbio obtains, processes and delivers IP/legal data from almost any country in the world. Unumbio is associated with 100 IP firms covering over 185 jurisdictions. With their assistance and Unumbio's expertise, Unumbio is able to provide IP data from almost any official authorities overcoming all the logistical, political, cultural, technological and content management challenges. All the developed content is delivered in XML/PDF format and it is ready to be distributed, licensed, acquired or embedded in a wide range of ways. ONE OF THE MOST EXTENSIVE COLLECTIONS OF SCREENING SEARCHES DATABASES (TRADEMARKS, PATENTS, DESIGNS) AVAILABLE TO BE LICENSED TO THIRD PARTIES.

Espacenet - EPO Service to search and download patents.

European Patent Foundation - a continuously updated database of all patent applications filed in the European Union since 1978, in an easy to understand and search platform.

Google Patents - a public, worldwide, full-text translated patent search engine, with CPC-classified non-patent literature from Google Scholar and Google Books.

Google Patents Public Datasets - worldwide patent bibliographic data and US full text, provided by IFI CLAIMS Patent Services, updated quarterly. Add, connect and analyze additional public, paid and private raw data sources in Google BigQuery using SQL.

IFI CLAIMS Classic - Complete and reliable US patent data carefully curated with standardized and probable assignees, legal status, and over 50 years of rich chemical indexing and title enhancements.

IFI CLAIMS Global Patent Database - A comprehensive global patent database available through the CLAIMS Direct Web Service. The database combines information from multiple national and

international sources into a single normalized proprietary ST.36-based XML format. Legal status, US reassignments and referenced images are also included.

Innography - Correlated patent, litigation and business search and analysis.

INPADOC - Patent Family and Legal Status.

IP.com - The Intellectual Property Library is a free international database of over 10 million patent and patent-related publications.

IPEXL Patent Search - A free patent search service with a focus on Asian patent offices and multilingual support.

Linux Foundation Patent Commons - database of IT patents which the proprietors have pledged not to enforce if open-source conditions are met.

MAREC - MAREC is a subset of the Alexandria repository, a global storage facility for high quality scientific, technical and business information (Fairview Research). MAREC consists of 19 million patent documents in different languages, normalized to a highly specific XML format (IRF)

MARPAT on STN - Complex, but robust, database of chemical Markush structures from patents; used for comprehensive patent retrieval through structure searching (CAS)

MicroPatent - PatentWEB and TrademarkWEB (Thomson Reuters)

Nordiskapatent - free database allowing searching of patents from Denmark, Norway, Sweden and Finland. Only available in the local languages.

orbit.com - This advanced version of QPAT is the new IP platform for any specialist looking for immediate answers and best practices. Very user-friendly, Orbit.com combines the most comprehensive coverage and powerful interface. Search Questel's famous FamPat database and key content, and cover 60+ million documents grouped in 40+ million inventions with 18+ million images from 90+ patent authorities PLUS 20+ full texts integrating the legal status, all in native or machine-aided translated English. In addition to the express and regular search interfaces, search citations, legal status, and industrial designs, order worldwide file histories and patent copies, monitor patent and legal status, analyze graphs and stats, and manage your portfolio. ALL IN ONE. (Questel)

PatBase - A comprehensive full text searchable patent database covering over 30 million patent families (Minesoft)

Patent Fetcher - Free U.S. and Foreign patent publications in PDF form.

Patent Imaging Corporation's Patent Bank

Patent Inspiration - Weekly updated Patent search and analysis tool. The PatentInspiration database contains full text (claims & descriptions) of the main searched authorities (WO, EP, US, CA, ...). Patent images are for the moment available of more than 10 authorities (WO, EP, US, GB, ...).

Patent Integration - This service packages provides a standard patent searching of 16 million U.S., Europe, International publication and Japanese patents, a visualizing patents population on the basis of text-mining technology, and a creating rich patent chart.

Patent Lens - free database from the Australian Cambia organisation, offering full text and status searching of WO, EP, AU and US patents.

Patents.com - A comprehensive free patent search site

PATENTSCOPE® Search Service - Free full-text search and first publication worldwide of PCT international applications from 1978 to present as well as access to PCT file contents and national phase entry data for 40+ offices. National patent collections available for ARIPO, Argentina, Brazil, Cuba, Israel, Mexico, Morocco, Republic of Korea, Singapore, South Africa, Spain, and Vietnam including full-text search and document images for many collections. (World Intellectual Property Organization)

PATONline - The subscription database from the Technical University of Ilmenau may be accessed in either English or German and contains full-text documents (PDF/TIFF) from DE, EP, WO, US, JP, DD, FR, RU, SU, and GB. Documents from other countries can be requested online.

PatSeer - An online patent database with global patent coverage that includes 17+ full text collections, 100+ bibliographic collections, machine translations, PDFs, drawings, simple/extended families with legal status, corporate tree, semantic search tools and more. PatSeer's unique capabilities include Multi-dimensional (X vs. Y) analysis using great looking charts, custom fields, hierarchical categorization, Citation & Family Trees, Co-citation Analysis and a lot more.

PharmaValet- A database of approved US and Canadian drugs and their associated patent information. Extensive search capabilities by drug or patent. Features include: expiration, approval, and extension dates, Patent Family and Legal Status (containing SPC and Patent Term Extension info), synonyms and chemical structures, therapeutic class, integrated paragraph IV data, and more.

PROPIS - subscription database from P & TS of Switzerland, offering both patents and non-patent technical and scientific literature.

QPAT - Online service for IP specialists looking for the most comprehensive coverage, powerful search access, and strategic analysis possibilities. With FamPat and PlusPat databases, cover 60+ million documents grouped in 40+ million inventions with 18+ million images from 90+ patent authorities PLUS 20+ full texts integrating the legal status, all in native or machine-aided translated English. In addition to the express and regular search interfaces, search citations and legal status, order worldwide file histories and patent copies, monitor patent and legal status, analyze graphs and stats, and manage your portfolio. (Questel)

RAPID - A subscription multi-source solution to manage patent and non-patent monitoring results. Simple and intuitive interface, compatible with key information providers, collaborative workspace, gives access to all patent information (PDF, legal status, European register mosaic view).

Research Disclosure, operated by Questel, provides a cost effective way of creating defensive publications to stop others from patenting inventions. The concept is simple: by publishing details of an invention, you create citeable prior art stopping others from patenting the idea. The RD service is fast, effective and inexpensive; full paper and immediate online publication start at \$120. RD's 51 year archive of defensive publications is a well-recognized prior art search resource. Patent Examiners are required to search Research Disclosure by PCT mandate.

SurfIP (IP Office of Singapore) - International free patents, trademarks and designs search service with a bias towards Asia.

STN International - premier online database service providing science, technology, and patent information.

Thomson CompuMark - Trademark and Copyright (Thomson Reuters)

Thomson Innovation - a single, integrated solution that combines intellectual property, scientific literature, business data and news with analytic, collaboration and alerting tools. (Thomson Reuters)

TotalPatent One - 30 full-text and 100 bibliographic patent authorities, searchable in original language or English machine translation; 50+ million PDFs that are searchable, bookmarked, multi-page, and condensed; 40 million patent families; multiple search options including a true semantic search that works with your search expertise and gives you full transparency and control of the concepts it suggests; integrated and linked to a variety of related solutions including PatentOptimizer™, Chisum on Patents, BizInt Smart Charts for Patents, SciVerse Scopus™, and more. (LexisNexis)

WIPS - Subscription database from Korea offering patents from various major nations.

Single-authority patent databases or online official journals

In alphabetical order of country or international body.

An interactive map featuring national patent search systems can be found on Intellogist.

Albania Bulletin of Industrial Property - since 2004

Argentina - Patent database

Argentina - Searchable Patent Journal. Issues since 2004.

Armenia - Patent database

Auspat - Newest Australian patent search and status database to gradually replace older systems

AU Published Patent Data Searching - Previous official Australia database still required for some older documents.

Australia patent specification server - access to A, B, or C specifications by number only

Australian Official Journal of Patents - old law patent journal for applications before 5th July 2002

Supplement to Australian Official Journal of Patents - new law patent journal for applications after 5th July 2002.

Austria Publications Server - search by number or IPC

Austria status database - search by number only, more data may be available with paid subscription

Belgium - status database

EPATRAS (Belgium) - status and translations of EP patents valid in Belgium

Recueil des Brevets d'Invention (Belgium) - Belgian official journal (1997 - 2008)

Belize Intellectual Property Journal (2003 to date)

Brazil patent databases: select "Pesquisar Base de Patentes" for normal patent database, "Pesquisar Base de Patentes em Aniversario" to search patents expiring on a single day or within a date range.

Revistas da Propriedade Industrial (Brazil) - last 500 issues of official journal

Canadian Patent Database

EPOLINE - Online European Patent Register - online access to status and legal data of EPO documents from A publication on. Does not cover national phase status details for which it is necessary to check the relevant national authority status databases.

Republic of Ireland SPC database - search by number, date, product and applicant.

Italian Patent and Utility Models (FILDATA Web Site)

Italy SPC Bulletin - monthly announcements of application and grant.

Japanese Industrial Property Digital Library (IPDL) - includes Patent Abstracts of Japan, with searchable English-language titles and abstracts since 1976, and status and automatic full-text translation into English since 1990. Also includes the online Patent & Utility Model Gazette, from which it is possible to retrieve specifications of all Japanese patents and utility models since the beginning of the Japanese IP system, but by number only.

JP-NETe- All bibliographic and abstracts with full citation and legal status information of Japanese unexamined patents dating back to 1989 are available in English language with no time lag in publication date; see World Patent Information 31 (2009) 131-134 for more information.

Korean Intellectual Property Rights Information Service (KIPRIS) - A free patent information search service covering all Korean IP information (English abstracts of Korean patents since 1979 and machine translation of Korean patent & utility model publications since 1983) of the Korean Intellectual Property Office (KIPO) and patent information of EP, JPO, USPTO and WIPO. (Korean Institute of Patent Information (KIPI))

IP Philippines Patent Online Search System (PHILPAT) - contains Invention, Utility Model, and Design patents dating from 1948. Abstract information for patents under new law (1998) in about 50% of records.

New Zealand IP database (IPONZ) - searchable official database for NZ filed patents, designs, trade marks and plant variety rights, including status.

Slovakia SPC database - English language search form

Slovenia SPC database - English language search form

Swissreg - databases of all forms of IP in Switzerland, select from left of screen. "ESZ" = SPC.

UK Intellectual Property Office SPC search - Retrieve information on UK Supplementary Protection Certificates by patent or SPC number only.

PatentSurf.net (USA) - Surf U.S. patents by discovering natural relationships

USA Patent term extensions lists - US equivalent of SPC, official database

USPTO Databases - Main US official patent database site, with separate databases for granted patents and published applications. Also includes design patents (US equivalent of registered designs), plant patents, defensive publications, and statutory invention registrations.

Single Technology Databases - Biotechnology

BiologicPatentWatch.com - BiologicPatentWatch concentrates deep knowledge on biologic drugs from more than 60 biotechnology companies, including more than 2,800 active and expired US patents and 41,000 international patents spanning 91 countries and regional patent offices.

CAS Registry BLAST - A specialized platform using NCBI BLAST to search the biological sequence content of the CAS Registry database. CAS Registry includes sequences indexed both from the patent and non-patent literature content of CAPLUS. CAS Registry BLAST is accessible via STN Express. (STN)

DNA Data Bank of Japan - published nucleotide and/or amino acid sequences for genes. Includes patent information.

DNA Patent Database (USA) - free Georgetown University database of US DNA patents.

Entrez cross-database search - by the US National Center for Biotechnology Information. A resource for searching various free databases, including nucleic acid and protein sequences from patents.

European Bioinformatics Institute metasearch page - search various free databases on different types of biological information, including EP patent abstracts and nucleotide and protein sequences from patents.

Federal Bio-Technology Transfer Directory (searchable archive; not longer updated)

GENESEQ - A patent sequence database produced by Thomson Reuters, containing nucleic acid and amino acid sequences from patents since 1981 from 41 worldwide patent-issuing authorities, including WO, US, EP, JP, DE, IN and CN. Each record contains standardized terminology and bibliographic data, enhanced titles, English language abstracts, and manually-captured sequence information. (Thomson Reuters)

GenomeQuest/LifeQuest - A patent sequence database that contains over 610,000 documents and over 285 million nucleotide and protein sequences taken from global patent offices (EPO, USPTO, WIPO/PCT), publicly available bio-sequence databases and web resources (GenBank®, NIH, EMBL-Bank, DDBJ). GenomeQuest's Platinum and Gold+ offerings also include manually curated documents from major and developing authorities (US, EP, CN, BR, JP, KR, IN and many others) that contain sequences outside of the ST.25 listings. (GenomeQuest)

Patent Lens sequence search facility - A utility provided by CAMBIA, using NCBI BLAST to search sequences from US patent publications.

Patome - A patent sequence database containing sequence data in patents from WO, EP, US, JP, with annotation and analysis data.

PCTGEN (World Patent Application Biosequences database) - A patent sequence database comprising information on nucleic acid and protein sequences submitted to the World Intellectual Property Organization (WIPO) by patent applicants. The database is based upon data provided by the WIPO Published Sequence Listings web service. (FIZ Karlsruhe)

PSIPS (USA) - USPTO site to download sequences too long to include in full in patent specifications.

USGENE - A patent sequence database providing search access to all available peptide and nucleotide sequences from published applications and issued patents of the United States Patent and Trademark Office (USPTO). Sequence data are available in USGENE within 3 days of publication by the USPTO. The SequenceBase Corporation is the producer of the database.

WIPO Published Sequence Listings - nucleotide and protein sequence listings in WO applications

Single Technology Databases - Pharmaceutical

DrugPatentWatch.com - DrugPatentWatch concentrates deep knowledge on more than 6,400 small-molecule drugs and 2,300 generic ingredients from 1,700 branded and generic pharmaceutical companies and 700 suppliers, and more than 4,300 active and expired US patents and 74,000 international patents spanning 93 countries and regional patent offices.

Electronic Orange Book (USA) - American Food and Drug Administration free public database of approved drugs, often including key patent numbers and expiry dates.

FDA Suitability Petitions (USA) - lists of substances submitted for approval as generic drugs

Ark Patent Intelligence - site for the generic pharma industry has subscription patent databases concentrating on pharmaceutical patents, with particular stress on tracking patent and SPC expiry dates, and landscape patent searches - small molecules and biologics

Health Canada Patent Register - information on drug patents in Canada.

Medicine Information Central Patents (UK) - UK National Health Service database on drug patents in the UK. Registration required.

Orange Book Companion (USA) - subscription database on legal and regulatory information on drugs approved in the US, including details of related patents.

Single Technology Databases - Other than Life Sciences

DoE Patents (USA) - database of patents held by the US Department of Energy

Meta-search Tools

ipInsiders Patent & IP Search Toolbar - Free patent and other prior art search tool and collection of free online patent databases. Includes more than 100 patent and non-patent information search fields; intellectual property link directory to patent search engines and databases, supporting tools for patent information searching and analyzing, IP information providers, IP forums, groups and communities, tools for trademark, brand and domain name searchers; national patent, trademark and design databases, patent classification finders. In addition RSS feeds of WIPO, EPO and other IP news, IP Tweets.

Patent Pal - a free patent information toolbar providing search access to over 30 unique patent related search systems such as Google Patents, FreePatentsOnline, Esp@cenet, WIPO, Pat2Pdf, and the USPTO MPEP, links to foreign patent laws and virtually every major patent office in the world, and a convenient interface for receiving RSS feeds from popular patent related blogs. The PIUG wiki is included on the World menu and the Blog menu.

TechTransferWatch - Find licensable technologies from Academic labs, Foundations, and Government. Customizable alerts provide regular notifications of fresh technologies.

Freepatentsonline.com

A) Citation Search (on campus, or with UMD password)

Derwent Innovations Index (DII), 1963-present

LexisNexis Academic Patent Search

IEEE/IEE Electronic Library - IEL

ScienceDirect (Elsevier)

SciencDirect has a "References" field that can be proximity searched to find patent numbers, inventors, and title words

Science Citation Index Expanded (Web of Science)

B) JSTOR

JSTOR is best known for its humanities and social sciences coverage, but its full text proximity search sometimes can locate even some very old articles that cite older patents.

C) Databases- Onsite Only

Derwent Innovations Index (requires UMD username/password)

Search international patents back to 1963; many have hot links to later patents that cite them as prior art

D) PubEAST and PubWEST

Please call ahead: Librarian login required

Faster than the USPTO free web databases

Offers more features and search capabilities than the USPTO free web databases

Includes international patents