

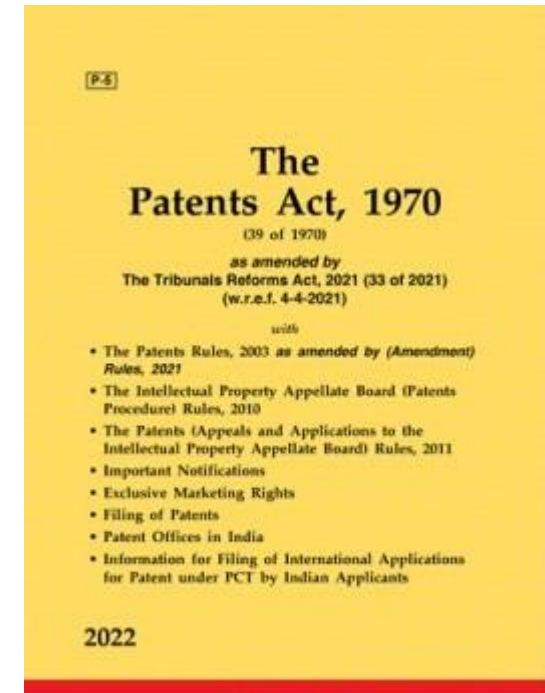
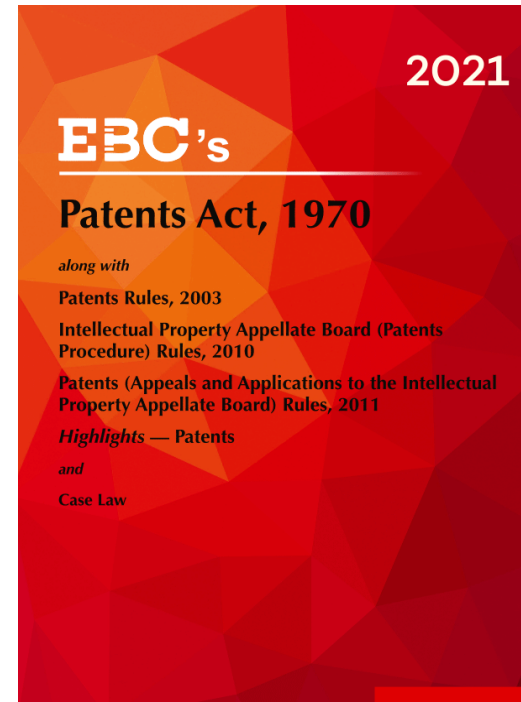
SOURCES AND THEORIES OF IP LAW

SOURABH BHARTI

NALSAR

- **Legislation** – Law passed by legislative body is called an Act
 - Patents Act 1970
 - Copyright Act 1957
 - Trademarks Act 1999
 - Designs Act 2000
- Where do you find them?
- On Patent Office Website <https://ipindia.gov.in/resources.htm#acts>

- In the market, published by various publishers



- **Rules** – legislative in nature but enacted by executive
 - THE PATENTS RULES, 2003
- Section 7 (2) of the Act
- Form of application: (2) Where the application is made by virtue of an assignment of the right to apply for a patent for the invention, there shall be furnished with the application, or within such period **as may be prescribed** after the filing of the application, proof of the right to make the application.
- Rule 10 of the Patent Rules:
- **Period within which proof of the right under section 7(2) to make the application shall be furnished** Where, in an application for a patent made by virtue of an assignment of the right to apply for the patent for the invention, if the proof of the right to make the application is not furnished with the application, the applicant shall **within a period of six months** after the filing of such application furnish such proof.

- **Judicial Precedents**

- **Supreme Court**

- Novartis v Union of India, AIR 2013 SC 1311, [2013] 13 S.C.R. 148
- *Section 3 (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....*
- In applying 3(d) of the Act, the Court decided to interpret "efficacy" as "therapeutic efficacy" because the subject matter of the patent is a compound of medicinal value. Court acknowledged that physical efficacy of imatinib mesylate in beta crystalline form was enhanced in comparison to other forms and that the beta crystalline form of imatinib mesylate had 30 per cent increased bioavailability as compared to imatinib in free base form; however, as no material had been offered to indicate that the beta crystalline form of imatinib mesylate would produce an enhanced or superior efficacy (therapeutic) on molecular basis than what could be achieved with imatinib free base in vivo animal model, the court opined that the beta crystalline form of imatinib mesylate, did not qualify the test of Section 3(d)

- **High Courts**

- **Foreign Judgements**

- *Diamond v Chakraborty* (1980, US Supreme Court)

- Everything made by man under the sun is patentable.

- Section 101 of US Patent Act - Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
- India – Section 3 – Long list of excluded subject matter
- (j) plants and animals in whole or any part thereof other than micro organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals

- **Manual**

- **MANUAL OF PATENT OFFICE PRACTICE AND PROCEDURE Version 3.0**

- Preface - The office has been regularly publishing the Manual of Patent Office Practice and Procedure to codify patent procedures for streamlining the functioning, provide benefit to stakeholders and also to provide guidance for prosecution of patent applications at Patent Office. In view of the recent amendments of Patent Rules, reengineering of patent procedures and automation in almost all activities in Patent Office, there has been demand to revise and update the present Manual. Accordingly, the present version of Manual of Patent Office Practice and Procedure, hereinafter referred to as —Manual||, has been prepared which is yet another step to fulfil our commitments towards more efficiency and transparency in the functioning of Patent Office. This Manual may be considered as a practical guide for effective prosecution of patent applications in India. However, it does not constitute rule making and, hence, does not have the force and effect of law. The Manual will be revised from time to time based on interpretations by courts of law, statutory amendments and valuable inputs from the stakeholders.

- <https://ipindia.gov.in/writereaddata/Portal/Images/pdf/Manual for Patent Office Practice and Procedure .pdf>

- Treaties

- Paris Convention
- Berne Convention
- TRIPS Agreement
- Budapest Treaty
- PCT

Understanding IP and Its Theories

- What is IP?
- IP deals with ideas or utilization of ideas
- Ideas are a resource
- The question of control – who, when and how much?
- IP regime gives answers

Reasons for theoretical understanding...

- IP implicates liberty
 - Palmer writes: *Liberty and intellectual property seem to be at odds, for while property in tangible objects limits actions only with respect to particular goods, property in ideal objects restricts an entire range of actions unlimited by place or time, involving legitimately owned property ... by all but those privileged to receive monopoly grants from the state*
- Ideas stimulate further ideas
 - Newton had famously said, "if I have seen that far, it was only because I was standing on the shoulders of the giants".
- Subject matter is non rivalrous
 - *That ideas should freely spread from one to another over the globe, for the moral and mutual instruction of man, and improvement of his condition, seems to have been peculiarly and benevolently designed by nature, when she made them, like fire, expansible over all space, without lessening their density in any point, and like the air in which we breathe, move, and have our physical being, incapable of confinement or exclusive appropriation. **Inventions then cannot, in nature, be a subject of property.**"* Thomas Jefferson

Theoretical Perspectives

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graph TD; A[Theoretical Perspectives] --> B[Creator Centric]; A --> C[Public/User Centric]
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Creator
Centric

Public/User
Centric

- TRIPS and futility of theoretical debate??
- Lockean Natural Rights Theory
 - Labour Justifies private acquisition
 - Provisos – No Harm, No waste
- Nozick's clarification
 - Harm meaning changing someone position to his detriment
 - Patent law should provide for independent creation
 - Time period of protection

- Utilitarian Theory
- Jeremy Bentham – Greatest good of greatest number of people
- Do we need IP for that?
- US Constitution Art 1 Section 8
 - Grants US Congress the power, "*To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.*"
- Posner's explanation
 - Cost of Expression and Cost of production

Comparative Claims

Utilitarians insist

- Utilitarianism is the only possible way to justify Intellectual Property
- Moral claims to Intellectual Property are irrational and hence unreasonable

Lokeans insist

- Utilitarianism suffers from data uncertainty
- Machlup Fritz famous statement
- We cannot ignore moral universals
- We can accommodate efficiency related concerns within the theory.