Unit 4: Patent-Part 1
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Historical Perspective

1856
The Act VI of 1856 on protection of inventions based on the British Patent Law of 1852. Certain exclusive privileges granted to inventors of new manufacturers for a period of 14 years.

1859
The Act modified as act XV Patent monopolies called exclusive privileges (making, selling and using inventions in India and authorizing others to do so for 14 years from date of filing specification).

1872
The Patterns & Designs Protection Act.

1883
The Protection of Inventions Act.

1888
Consolidated as the Inventions & Designs Act.

1911
The Indian Patents & Designs Act.

1999
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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.

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.
What is Patent?
A patent is an exclusive right granted by the Government to the inventor to exclude others to use, make and sell an invention is a specific period of time.
The word “patent” is referred from a Latin term “patere” which means “to lay open,” i.e. to make available for public inspection. There are three basic tests for any invention to be patentable:
- Firstly, the invention must be novel, meaning thereby that the Invention must not be in existence.
- Secondly, the Invention must be non-obvious, i.e. the Invention must be a significant improvement to the previous one; mere change in technology will not give the right of the patent to the inventor.
- Thirdly, the invention must be useful in a bonafide manner, meaning thereby that the Invention must not be solely used in any illegal work and is useful to the world in a bonafide manner.

What is the object of Grant of Patent?
The subject of Patent Law is to encourage scientific research, new technology and industrial progress. Grant of exclusive privilege to own, use or sell the method or the product patented for limited period, stimulates new inventions of commercial utility. The price of the grant of monopoly is the disclosure of the invention at the Patent Office, which after the expiry of the fixed period of the monopoly passes into the public domain.

Rights in a Patent (this you give when it is explained in less marks, otherwise follow the next heading of Rights and obligations of the patentee)
Patent registrations confers on the rightful owner a right capable of protection under the Act i.e. the right to exclude others from using the invention for a limited period of time. The monopoly over patented right can be exercised by the owner for a period of 20 years after which it is open to exploitation by others.
Patent confers the right to manufacture, use, offer for sale, sell or import the invention for the prescribed period.

Time Period for which Patent is granted
Initially, the Act provided for a shorter term of protection for medicine or drug substances. However, vide the Amendment Act of 2005 uniform period of 20 years was provided for all the Patents. Thus, once the prescribed period of 20 years is over, then any person can exploit the patented invention. Here it would be relevant to mention that similar to a trademark even the term of a patent begins from the date of application of patent.
What are the requirements for Grant of Patent?
The application for Patent shall be made at the Indian Patent Office.
Any person i.e. Indian or a Foreigner, individual, company or the Government can file a Patent Application.
The person applying for Patent shall be the true and first inventor of the invention proposed to be patented.
The patent application can also be made jointly.
The patent application shall primarily disclose the best method of performing the invention known to the applicant
for which he is entitled to claim protection.
The applicant shall also define the scope of invention.
The invention desired to be patented shall be new, should involve an inventive step and must be capable of
industrial application.
A patent application can be made for a single invention only.
An international application made under the PCT (Patent Co-operation Treaty) designating India shall be deemed as
an application made under the Patents Act with the priority date accruing from the date of the international filing
date accorded under the PCT.

What can be patented?
There are certain criteria which have to be fulfilled to obtain a patent in India. They are:

1-Patent subject:
The most important consideration is to determine whether the Invention relates to a patent subject matter. Sections
3 and 4 of the Patents Act list non-patentable subject matter. Unless the Invention comes under any provision of
Section 3 or 4, it means that it consists of a subject for a patent.

2-Novelty:
Innovation is an important criterion in determining the patent potential of an invention. A novelty or new Invention
is defined as “no invention or technology published in any document before the date of filing of a patent
application, anywhere in the country or the world”. The complete specification, that is, the subject matter has not
fallen into the public domain or is not part of state of the art”. Simply, the novelty requirement basically states that
an invention that should never have been published in the public domain. It must be the newest which have no
same or similar prior arts.
3- Inventive steps:
An inventive step is defined as “the characteristic of an invention that involves technological advancement or is of economic importance or both, as compared to existing knowledge, and invention not obvious to a person skilled in the art.” This means that the invention should not be obvious to a person skilled in the same field where the invention is concerned. It should not be inventive and obvious for a person skilled in the same field.

4- Capable of industrial application:
Industrial applicability is defined as “the invention is capable of being made or used in an industry”. This basically means that the Invention cannot exist in the abstract. It must be capable of being applied in any industry, which means that it must have practical utility in respect of patent.

These are statutory criteria for the patent of an invention. In addition, other important criteria for obtaining a patent is the disclosure of a competent patent. A competent patent disclosure means a patent draft specification must adequately disclose the Invention, so as to enable a person skilled in the same field related to carrying out the Invention with undue efforts.

Rights and obligations of the patentee

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Rights of Patente
Right to exploit patent: A patentee has the exclusive right to make use, exercise, sell or distribute the patented article or substance in India, or to use or exercise the method or process if the patent is for a person. This right can be exercised either by the patentee himself or by his agent or licensees. The patentee’s rights are exercisable only during the term of the patent.
Right to grant license: The patentee has the discretion to transfer rights or grant licenses or enter into some other arrangement for a consideration. A license or an assignment must be in writing and registered with the Controller of Patents, for it to be legitimate and valid. The document assigning a patent is not admitted as evidence of title of any person to a patent unless registered and this is applicable to assignee not to the assignor.
Right to Surrender: A patentee has the right to surrender his patent, but before accepting the offer of surrender, a notice of surrender is given to persons whose name is entered in the register as having an interest in the patent and their objections, if any, considered. The application for surrender is also published in the Official Gazette to enable interested persons to oppose.
Right to sue for infringement: The patentee has a right to institute proceedings for infringement of the patent in a District Court having jurisdiction to try the suit.
Obligations of patentee

Government use of patents: A patented invention may be used or even acquired by the Government, for its use only; it is to be understood that the Government may also restrict or prohibit the usage of the patent under specific circumstances. In case of a patent in respect of any medicine or drug, it may be imported by the Government for its own use or for distribution in any dispensary, hospital or other medical institution run by or on behalf of the Government. The aforesaid use can be made without the consent of the patentee or payment of any royalties. Apart from this, the Government may also sell the article manufactured by patented process on royalties or may also require a patent on paying suitable compensation.

Compulsory licenses: If the patent is not worked satisfactorily to meet the reasonable requirements of the public, at a reasonable price, the Controller may grant compulsory licenses to any applicant to work the patent. A compulsory license is a provision under the Indian Patent Act which grants power to the Government to mandate a generic drug maker to manufacture inexpensive medicine in public interest even as a patent in the product is valid. Compulsory licenses may also be obtained in respect of related patents where one patent cannot be worked without using the related patent.

Revocation of patent: A patent may be revoked in cases where there has been no work or unsatisfactory result to the demand of the public in respect of the patented invention.

Invention for defence purposes: Such patents may be subject to certain secrecy provisions, i.e. publication of the Invention may be restricted or prohibited by directions of Controller. Upon continuance of such order or prohibition of publication or communication of patented Invention, the application is debarred for using it, and the Central Government might use it on payment of royalties to the applicant.

Restored Patents: Once lapsed, a patent may be restored, provided that few limitations are imposed on the right of the patentee. When the infringement was made between the period of the date of infringement and the date of the advertisement of the application for reinstatement, the patent has no authority to take action for infringement.

Procedure of Patent

Step 1: Write about inventions (idea or concept) with each and every detail.
Collect all information about your Invention such as:
Field of Invention
What does the Invention describe
How does it work
Benefits of Invention
If you worked on the Invention and during the research and development phase, you should have some call lab records which are duly signed with the date by you and the concerned authority.
Step 2: It must involve a diagram, drawing and sketch explains the Invention. Drawings and drawings should be designed so that the visual work can be better explained with the invention work. They play an important role in patent applications.
Step 3: To check whether the Invention is patentable subject or not. Not all inventions can be patentable, as per the Indian Patent Act there are some inventions which have not been declared patentable (inventions are not patentable).
Step 4: Patent Discovery
The next step will be to find out if your Invention meets all patent criteria as per the Indian Patent Act:
The invention must be novel.
The Invention must be non-obvious.
The Invention must have industrial applications.
Step 5: File Patent Application
If you are at a very early stage in research and development for your Invention, then you can go for a provisional application. It offers the following benefits:
Filing date.
12 months time for filing full specification.
Lesser cost.
After filing a provisional application, you secure the filing date, which is very important in the patent world. You get 12 months to come up with the complete specification; your patent application will be removed at the end of 12 months.
When you have completed the required documents and your research work is at a level where you can have prototypes and experimental results to prove your inventive move; you can file the complete specification with the patent application.
Filing the provisional specification is an optional step if you are in the stage where you have complete knowledge about your Invention you can go straight to the full specification.
Step 6: Publication of the application
Upon filing the complete specification along with the application for the patent; the application is published 18 months after the first filing.
If you do not wish to wait until the expiration of 18 months from the filing date to publish your patent application, an initial publication request may be made with the prescribed fee. The patent application is usually published early as a one-month form request.
Step 7: Request for Examination
The patent application is scrutinized only after receiving a request for an RFE examination. After receiving this request, the Controller gives your patent application to a patent examiner who examines the patent application such as the various patent eligibility criteria:
- Patent subject
- Newness
- Lack of clarity
- Inventory steps
- Industrial application
- By enabling

The examiner makes the first examination report of the patent application upon a review for the above conditions. This is called patent prosecution. Everything that happens for a patent application before the grant of a patent is usually called patent prosecution.

The first examination report submitted to the Controller by the examiner usually includes prior art (existing documents prior to the filing date) that are similar to the claimed invention and is also reported to the patent applicant.

Step 8: Answer the objections
Most patent applicants will receive some type of objections based on the examination report. The best thing is to analyze the examination report with the patent professional (patent agent) and react to the objections in the examination report. This is an opportunity for an investor to communicate his novelty over the prior art in examination reports. Inventors and patent agents create and send a test response that tries to prove that their Invention is indeed patentable and meets all patent criteria.

Step 9: clearance of objections
The Controller and the patent applicant is connected for ensuring that all objections raised regarding the invention or application is resolved and the inventor has a fair chance to prove his point and establish novelty and inventive steps on other existing arts. Upon receiving a patent application in order for grant, it is the first grant for a patent applicant.

Step 10:
Once all patent requirements are met, the application will be placed for the grant. The grant of a patent is notified in the Patent Journal, which is published periodically.
Some major opposition grounds, common to both pre-grant and post-grant opposition, are mentioned below:
The Invention was published previously in India or elsewhere or was claimed previously in India.
The Invention is the formation of a part of the prior public knowledge or prior public use or traditional knowledge of any community.
The Invention is obvious and lacks an inventive step.
The Invention does not constitute an invention within the meaning of the Act, or the Invention is not patentable under the Act.
Failure to disclose information or furnishing false information relating to foreign by the applicant.

What are the Authorities concerning patent
The Controller of Patents is considered as the principal officer responsible for administering the patent system in India. The Controller is regarded as the overall supervisor of the four Patent Offices in Chennai, Delhi, Mumbai and Kolkata. Since the Controller also acts as the Registrar of Trademarks with the Head Office of the Trade Office in Mumbai, the Controller acts as a patent from his office in Mumbai. Officially, the patent has its head office in Kolkata (Calcutta). Patents granted under the Patents Act and other officers of the Patent Office discharge their functions under the direction or regulation of the Controller.

**Patent Infringement**

Patent infringement is a violation which involves the unauthorized use, production, sale, or offer of sale of the subject matter or Invention of another's patent. There are many different types of patents, such as utility patents, design patents, and plant patents. The basic idea behind patent infringement is that unauthorized parties are not allowed to use patents without the owner’s permission.

When there is infringement of patent, the court generally compares the subject matter covered under the patent with the used subject matter by the “infringer”, infringement occurs when the infringer Uses patent material from in the exact form. Patent infringement is an act of any unauthorized manufacture, sale, or use of a patented invention. Patent infringement occurs directly or indirectly.

**Direct patent infringement:** The most common form of infringement is direct infringement, where the Invention that infringes patent claims is actually described, or the Invention performs substantially the same function.

**Indirect patent infringement:** Another form of patent infringement is indirect infringement, which is divided into two types:

1. **Infringement by inducement** is any activity by any third party that causes another person to infringe the patent directly. This may include selling parts that can only be used realistically for a patented invention, selling an invention with instructions to use in a certain method that infringes on a method patent or licenses an invention that is covered by the patent of another. The inducer must assist intentional infringement, but does not require intent to infringe on the patent.
2- Contributory infringement is the sale of components of material that are made for use in a patented invention and have no other commercial use. There is a significant overlap with indications, but contributor violations require a high level of delay. Violations of the seller must have direct infringement intent. To be an obligation for indirect violations, a direct violation must also be an indirect act.

Remedies for Patent Infringement
Patent infringement lawsuits can result in significantly higher losses than other types of lawsuits. Some laws, such as the Patent Act, allow plaintiffs to recover damages. Patent infringement is the illegal manufacture or usage of an invention or improvement of someone else’s invention or subject matter who owns a patent issued by the Government, without taking the owner’s consent either by consent, license or waiver. Several remedies are available to patent owners in the event of an infringement. Measures available in patent infringement litigation may include monetary relief, equal relief and costs, and attorneys’ fees.

Monetary Relief: Monetary relief in the form of compensatory damages is available to prevent patent infringement:
1-Indemnity compensation – A patent owner may have lost profits for infringement when they established the value of the patent.
2-Increased damage – Up to three times, compensation charges can be charged in cases of will or violation of will.
3-The time period for damages – The right to damages can be claimed only after the date when the patent was issued and only 6 years before the infringement claim is filed.

Equitable relief: Orders are issued by the court to prevent a person from doing anything or Act. Injections are available in two forms:
Preliminary injunction – Orders made in the initial stage of lawsuits or lawsuits that prevent parties from doing an act that is in dispute (such as making a patent product).
Permanent injunction – A final order of a court which permanently ceases certain activities or takes various other actions.
What role does WIPO play with regards to patents?
WIPO works to develop a balanced and effective international intellectual property (IP) system, a key part of which is dedicated to patents. WIPO’s member states collaborate in various areas, including on agreeing the treaties and conventions that underpin the international IP system and that make the global exchange of creativity and innovation possible. The IP services that WIPO offers, such as the facilitation of international patent protection under the PCT System, complement services available at the national and/or regional level. It’s important to remember that WIPO does not actually grant patents per se; the grant or refusal of a patent still rests with the relevant national or regional patent office.

Overview of the PCT system

Since we live in a global economy, there are many intellectual property laws that stretch across nations, which means the owners of a given item of intellectual property can be protected in places other than their home countries. The Patent Cooperation Treaty (PCT) is important for patent law because it allows patent-seekers to file an international application. The PCT is open to countries that were a party to the 1883 Paris Convention for the Protection of Industrial Property. The PCT concluded in 1970, then amended in 1979, and modified twice, in 1984 and 2001.

What Does the PCT Do?
The Patent Cooperation Treaty allows inventors to file international patent applications, which in turn gives their inventions patent protection simultaneously in several countries. An inventor may file this type of application if he or she is a national or resident of a Contracting State, meaning the country is party to the PCT. The application can be filed in the national patent office of the country of which the inventor is a resident or national (for example, a U.S. citizen or resident can file the application with the USPTO), or it can be filed with the International Bureau of WIPO in Geneva.