

Patent

Module 4

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- Patent:
 - Introduction,
 - inventions not patentable;
 - Patent filing in India;
 - Conventional patent filing & PCT;
 - patent Infringement and Enforcement

History of Patents

<https://ipindia.gov.in/history-of-indian-patent-system.htm>

Ministry of Commerce & Industry
Dept. Of Industrial Policy & Promotion

Controller General of Patents, Designs & Trade Marks

Patent & Design
Office

Kolkata

Delhi

Mumbai

Chennai

Trade Marks
Registry

Mumbai

Kolkata

Delhi

Chennai

Ahmadabad

Geographical
Indications
Registry

Chennai

Patent
Information
System

RGNIIPM

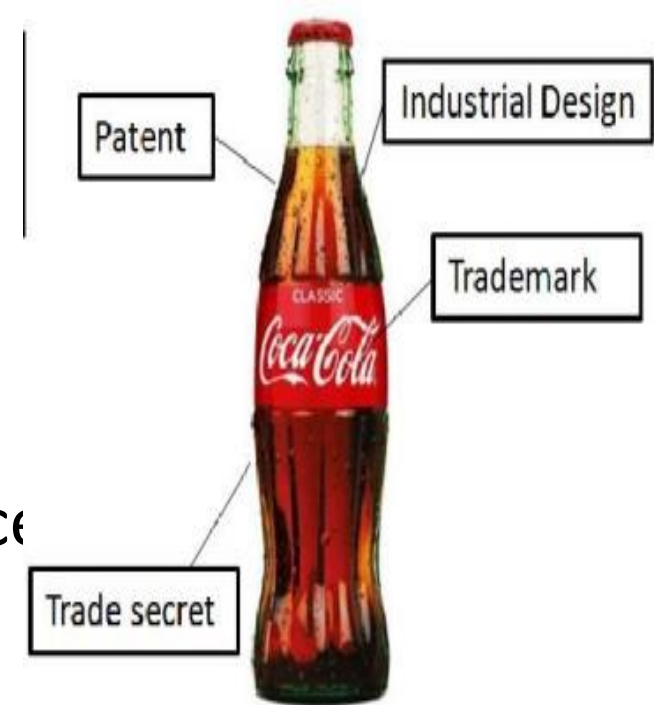
NAGPUR

Law and Regulations

- Patents Act, 1970
 - Amended in
 - 1999
 - 2002
 - 2005
- Patents Rules, 2003
 - Amended in
 - 2005
 - 2006

Patents:

- Inventions (Products, Processes, Materials, Compositions)
- Technical Solution to a Technical problem



Patent 20 Yrs *Every year (mandatory) The Patents Act,1970 Amended in 2005

Patents will cease and be transferred to public domain if Patents are not renewed within 6 month of expiry of concerned year by paying renewal fee.

- **The logo Coca-Cola is an example for TRADE MARK.**
 - **Shape of the bottle – an INDUSTRIAL DESIGN.**
 - **PATENT** may have been obtained in respect of bottling equipment.
 - **COPYRIGHT** – in respect of the text, database or artistic work appearing on its website.
- i.e., A single product can be protected by more than one IPR.**



Scope of Patentability Under The Patents Act

What is an Invention?

Sec.2(1)(J)

“Invention” means

- **A new product or**
- **A new process**

involving

- **an inventive step and**
- **capable of industrial application**

“NEW” means

Invention must not be

- Published in India or elsewhere
- In prior public knowledge or prior public use within India
- Claimed before in any specification in India

Patentable subject matter

Invention must

- ◆ relate to a **Process** or **Product** or both
- ◆ be new (**Novel**)
- ◆ involves an **inventive step**
- ◆ be capable of **industrial application**
- ◆ not fall under **Sections 3 and 4**

Important Glossary

Prior Art

- the **complete information publicly available** related to matter for which protection is sought in a patent application.
- Also known as state of the art.
- See also *PCT International search*.

Priority

- under the terms of the Paris Convention of 1883 and its later amendments, **an applicant may make a subsequent filing for the same invention in another jurisdiction** within 12 months of a first filing, quoting the priority of the first filing.

IS EVERGREENING OF PATENTS ALLOWED IN INDIA?

Indian Patent Act and Evergreening: The fundamental tenet of our nation's patent law is that -

- a patent can only be issued for an invention that is both
 - novel and
 - useful.

Patenting incremental advances, sometimes known as “evergreening,” is prohibited by Section 3(d) of India's patent legislation

Section 3(d) of the Indian Patents Act of 1970 states that the following are non-patentable:

- Discovering a new form of a **known substance**
- Discovering a new property or use for a known substance
- Using a known process, machine, or apparatus unless it results in a new product or uses at least one new reactant

A recent example that was not a known substance

– S. 3(d) clarified of the Indian Patents Act, 1970.

Patent application no. 7096/CHENP/2015 - it claimed priority from the US application number 61/815,502 dated 24 April 2013.

The patent application claimed two polymorphic forms—A and B—of a compound RTA-408.

Compound RTA-408 was claimed and granted in the Indian Patent Application No. 8486/DELNP/2014.

The patent application 7096/CHENP/2015 was refused essentially on the grounds of being not patentable under Section 3(d) of the Indian Patents Act.

<https://corporate.cyrilamarchandblogs.com/2024/02/court-interprets-known-substance-in-respect-of-section-3d-of-the-patents-act/>

Another Example

- In recent judgement of the Delhi High Court in *Chugai Seiyaku Kabushiki Kaisha versus Controller of Patents and Design C.A.(COMM.IPD-PAT) 4/2021 dated April 6, 2022*, the Delhi High Court held that the method of producing a solid form (tablet) of pre-existing drug via direct compression method is not patentable.
- This case was directed to the Appeal filed by the *Chugai Seiyaku Kabushiki Kaisha*, the Appellant, challenging the order passed by the *Controller of Patents*, the Respondent, in the matter of the Appellant's patent application No.201617023236, wherein the Application has been rejected by the Respondent on grounds of lack of inventive step and Section 3(d) of the Patents Act.

the method should not be a mere use of a known method or should involve a new reactant or should result in a new product.

Alternatively, if the claimed method has a significant improvement over the existing prior arts, then the claimed method can escape from the imposition of Section 3(d) of the Indian Patents Act, 1970.

Priority date

A patent's priority date is the date on which the first application for a patent is filed, and it determines whether other patent applications or documents are considered prior art.

The priority date is important for several reasons, including:

- **Establishing who owns the patent** - If multiple people independently invent the same thing, the person who files the earliest application or claims the earliest priority date is the one who owns the patent.
- **Preventing competitors from patenting the same invention** - The priority date prevents later applicants from patenting the same invention.
- **Making the invention public** - The priority date allows the inventor to make the invention public without losing its novelty abroad.

Priority date refers to the earliest filing date in a family of patent applications

- If the earliest-filed patent application for a particular invention was a provisional application, then the filing date of the provisional is your priority date.
- If the first filing was a non-provisional application, then the priority date is the non-provisional filing date.
- If the earliest filed application was an international (PCT) or foreign-filed application, then the filing date of the non-US application is the priority date.

For example, **If:**

- Provisional application filed on Jan. 20, 2016 disclosing features A and B of an invention;
- Non-provisional filed on Jan. 20, 2017 claiming priority to the 1/20/16 provisional and adding new feature C (i.e., disclosing A, B & C); and
- Continuation-in-part (CIP) application filed on Aug. 20, 2017 adding new feature D (i.e., disclosing A, B, C & D).

Then, the priority date for each feature would be:

- Features A & B: 1/20/16 (filing date of provisional);
- Feature C: 1/20/17 (filing date of non-provisional); and
- Feature D: 8/20/17 (filing date of CIP).
- The priority date determines whether another patent filing or publicly available document qualifies as prior art against one's patent application.

Inventive step

A feature of an invention

- involves technical advances as compared to the existing knowledge or
- has economic significance or both and
- makes the invention not obvious to a person skilled in the art

Industrial application means

- Invention is capable of
 - being made or
 - used
- in any kind of industry

Section 3 exclusions

Section 3(a)

- **Frivolous inventions**
- **Inventions contrary to well-established natural laws**

Examples

- Machine that gives more than 100% performance
- Perpetual machine

Section 3 exclusions

Section 3(b)

Commercial exploitation or primary use of inventions, which is

- **Contrary to**
 - public order or
 - Morality

Examples

- Gambling machine,
- Device for house-breaking ,

Section 3 exclusions

Section 3(b)

Commercial exploitation or primary use of inventions , which

➤ **Causes serious Prejudice to**

- health or
- human, animal, plant life or
- to the environment

Examples

- Biological warfare material or device,
- weapons of mass destruction
- Terminator gene technology,
- Embryonic stem cell

https://www.wipo.int/pct/en/texts/nat_sec.html - you can find information on restrictions for each country to file international patents - PCT

Checks and Balances

Section 3(b)

Excludes patents on

- GMOs – exploitation of which could be contrary public order or morality or prejudicial to human, animal, or plant life or health or the environment

Effect: Only genetically modified micro-organisms (GMOs) that do not fall under section 3 (b) are patentable.

Section 3 exclusions

Section 3 (c)

- Mere Discovery of a Scientific Principle or
- formulation of an Abstract Theory or
- discovery of any living thing or
- discovery of non–living substance occurring in nature

Examples

- Newton's Laws
- Superconducting Phenomenon as such
- Property of certain material to withstand mechanical shock
- Discovery of micro-organism
- Discovery of natural gas or a mineral

Checks and Balances

Section 3(c)

Excludes patents on

- Naturally occurring Micro-organisms

Effect

Genetically modified microorganisms (GMOs) are however, patentable.

Section 3 exclusions

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

Section 3 exclusions

Section 3 (d) Explanation

For the purposes of this clause,

- salts, esters, ethers, polymorphs,
- metabolites, pure form, particle size,
- isomers, mixture of isomers,
- complexes, combinations and other derivatives of known substances

shall be considered to be the same substance, unless they differ significantly in properties about **efficacy**.

Examples

- Crystalline forms of known substance

Checks and Balances

Section 3 (d) Explanation

Effect

Salts, esters, ethers, polymorphs, metabolite, pure forms, particle size, isomers, complexes, combinations and derivatives of a known substance with **enhanced efficacy** are patentable

Section 3 exclusions

Section 3 (d)

- Mere discovery of any new property or new use for a known substance or 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.*

Examples

- New use of Aspirin for heart ailments,
- Mere new uses of Neem

Section 3 exclusions

Section 3(e)

Substance obtained by mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance

Examples

- Combiflam [Paracetamol (Antipyretic) + Brufen (analgesic)]
- Solution of sugar and color additives in water to form a soft drink

However,

A mixture resulting into synergistic properties of mixture of ingredients however, may be patentable - Soap, Detergents, lubricants etc

Checks and Balances

Section 3 (e)

Effect

- Substance obtained by mere admixture resulting only in the aggregation of the properties of the components thereof or
- a process for producing such substance

are not patentable

However

Synergistic formulations are patentable

Section 3 exclusions

Section 3 (f)

Mere arrangement or re-arrangement or duplication of known devices, each functioning independently of one another in a known way

Examples

- A Bucket fitted with torch,
- An Umbrella with fan
- A Clock and radio in a single cabinet
- A flour-mill provided with sieving

Section 3 exclusions

Section 3(h)

Method of Agriculture or Horticulture

Examples

- Cultivation of algae ,
- Producing new form of a known plant,
- Preparation of an improved soil

However,

Agricultural Equipments are patentable

Section 3 exclusions

Section 3(i)

Any process for medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings *or* a similar treatment of animals to render them free of disease *or* to increase their economic value *or* that of their products

Examples

- Removal of cancer tumor
- Removal of dental plaque and carries
- Surgical processes
- Processes relating to therapy
- Method of vaccination,
- Blood transfusion

However,

- Treatment performed on tissues or fluids permanently removed from the body
 - Surgical, therapeutic or diagnostic Apparatus or instruments
- are patentable**

Section 3 exclusions

Section 3(j)

Plants & animals in **whole or any part thereof** other than micro-organisms, but including seeds, varieties and species and essentially biological process for production or propagation of plants & animals

Section 3 exclusions

Section 3(j)

- **Plants & animals in whole**
- **Parts of plants & animals**
- **Seeds**
- **Varieties & species**
- **Essentially biological processes for propagation or production of the animals & plants**

Checks and Balances

Section 3(j)

Excludes patents on

- Plants and animals in whole or any parts thereof, including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals

Examples

- Clones and new varieties of plants
- A process for production of plants or animals if it consists entirely of natural phenomena such as crossing or selection
- Essentially biological Process

Section 3 exclusions

Section 3(k)

- * mathematical method or
- * business method or
- * algorithms or
- * computer programme *per se*

Examples

- *Computer program by itself or as a record on a carrier*

However

- New calculating machine
- combination of hardware and software

is patentable

Section 3 exclusions

Section 3(I)

A literary, dramatic, musical or artistic work or any other aesthetic creation including cinematographic work and television productions

These subject-matters fall under the copyright protection

Section 3 exclusions

Section 3(m)

A mere scheme or rule or method of performing mental act or method of playing game

Examples

- Scheme for learning a language
- Method for solving a crossword puzzle,
- Method of learning a language
- Method of teaching /learning

However,

- Novel apparatus for playing game or carrying out a scheme *is patentable*

Section 3 exclusions

Section 3 (n)

Presentation of information

Examples

- Any manner or method of expressing information whether by
 - *spoken words*
 - *Visual display*
 - *symbols*
 - *diagrams*
- Information recorded on a carrier

Section 3 exclusions

Section 3 (o)

Topography of integrated circuits.

Examples

Mask works - circuits layout

Section 3 exclusions

Section 3 (p)

Inventions which are

Traditional Knowledge or an aggregation or duplication of known properties of traditionally known component or components

Examples

Traditional Knowledge already in public domain

- Wound healing property of Haldi

However,

Any value-addition using Traditional Knowledge leading to a new process or product, which is novel with inventive step and industrial applicability,

■ Extraction of Azadirachtin from Neem

can be *patented*

Non Patentable inventions

Section 4

Inventions falling within Section 20(1) of the Atomic Energy Act, 1962 are not patentable

Effect

Inventions relating to compounds of Uranium, Beryllium, Thorium, Plutonium, Radium, Graphite, Lithium and more as notified by Central Govt. from time to time.

Stages from filing to grant of a patent

Obtaining a patent

- File an application for patent
 - With one of the patent offices based on territorial jurisdiction of the place of office or residence of the applicant /agent
 - Pay the required fee
- Information concerning application form and details of fee available at www.ipindia.nic.in
- Guidelines for applicants also available on this website

Formality Check

- An Examiner checks the formal requirements before accepting the application and the fee – this is done immediately
- Issue of application number and the cash receipt – this is done the same day
- In case of receipt of application by post, cash receipt, application number is sent by post within 2-3 days

Publication

- Application is kept secret for a period of 18 months from the date of filing
- In 19th month, the application is published in the official journal – this journal is made available on the website weekly
- Applicant has an option to get his application published before 18 months also
- In that case, application is published within one month of the request

Request for Examination

- Application is examined on request
- Request for examination can be made either by the applicant or by a third party
- A period of 48 months, from the date of filing, is available for making request for examination

Examination

- Application is sent to an Examiner within 1 month from the date of request for examination
- Examiner undertakes examination w.r.t.
 - whether the claimed invention is not prohibited for grant of patent
 - whether the invention meets the criteria of patentability

Issue of FER

- A period of 1 to 3 months is available to Examiner to submit the report to the Controller
- 1 month's time available to Controller to vet the Examiner's report
- First Examination Report (FER) containing gist of the objections is issued within 6 months from the date of filing of request

Response from the Applicant

- 12 months' time, from the date of issue of FER, is available to the applicant to meet the objections
- If objections are met, grant of patent is approved by the Controller – within a period of 1 month

Pre-grant Opposition

- After publication, an opposition can be filed within a period of 6 months
- Opportunity of hearing the opponent is also available

Examination of Pre-grant Opposition

- Opposition (documents) is sent to the applicant
- A period of 3 months is allowed for receipt of response

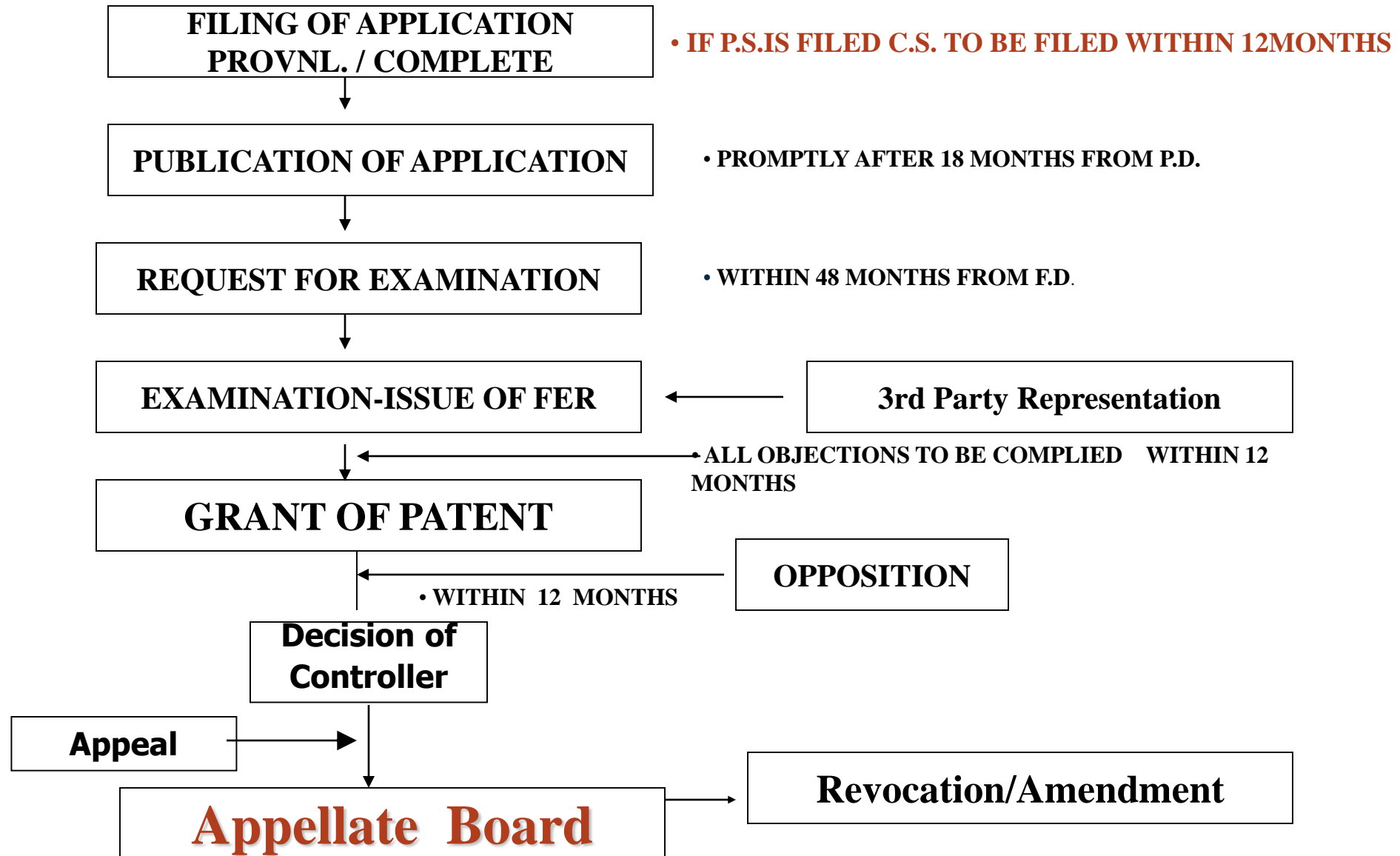
Consideration of Pre-grant Opposition

- After examining the opposition and the submissions made during the hearing, Controller may
 - Either reject the opposition and grant the patent
 - Or accept the opposition and modify/reject the patent application
- This is to be done within a period of 1 month from the date of completion of opposition proceedings

Grant of a Patent

- A certificate of patent is issued within 7 days
- Grant of patent is published in the official journal

STAGES - FILING TO GRANT OF PATENT



Renewal Fee

- To be paid within 3+6 months from date of recording in the register [sec 142 (4)]
- No fee for 1st and 2nd year
- Renewal fee, on yearly basis, is required to be paid for 3rd to 20th for keeping the patent in force
- Delay upto six months from due date permissible on payment of fee for extension of time
- Patent lapses if renewal fee is not paid within the prescribed period