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PATENT LAW (LIP 901)
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Meaning of 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. A patent is also available for improvement in their previous Invention. The word “patent” is referred from a Latin term “patere” which means “to lay open,” i.e. to make available for public inspection.

The Patents under the Act are granted by the Controller to the Inventor(s) for a period of 20 years. It is an exclusive right to make use, exercise and bend his invention.

There are three basic tests for any invention to be patentable:

1. The invention must be novel, meaning thereby that the Invention must not be in existence.
2. 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.
3. 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.

PRODUCT / PROCESS PATENTS

Section 5 of the Patents Act, 1970 provided for grant of Process Patents only in certain categories of inventions. It may be noted here that under the Patents Act, 1970, in all other areas, Product and Process Patents could be issued and have been issued.

The TRIPs Agreement under Article 27.1 stipulates that Patents shall be available for any invention, whether Products or Processes, in all fields of technology except for the exclusion stipulated under Article 27.2 and 27.3.

Pursuant to the TRIPs agreement, the Patents Act, 1970 was amended in the year 2002. Section 5 of the Patents Act, 1970 (as it stood after the 2002 amendments) provided that, in the case of inventions being claimed relating to food, medicine, drugs or chemical substances, only Patents relating to the methods or processes of manufacture of such substances could be obtained.

PATENTABLE SUBJECT MATTER AND PATENTABILITY CRITERIA

A Patent is granted for an invention which may be related to any process or product. An invention is different from a discovery. A discovery is something that already existed but has now been discovered.

Not all inventions are Patentable

An invention must fulfill certain requirements in order to be qualified as Patentable. These requirements are known as 'conditions of Patentability'. The term 'invention' under the Patents Act, 1970 has been defined as 'a new product or process involving an inventive step and capable of industrial application.' (Section 2(1)(j)).

The term 'New invention' is defined as any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of Patent application with complete specification, i.e., the subject matter has not fallen in public domain or that it does not form part of the state of the art [Section 2(1)(1)] where, 'capable of industrial application', in relation to an invention, means that the invention is capable of being made or used in an industry [Section 2(1)(ac)].

Raj Prakash v. Mangat Ram Choudhary, AIR 1978

it was held that an invention, as is well known, is to find out something or discover something not found or discovered by anyone before. It is not necessary that the invention should be anything complicated. The essential thing is that the inventor was first to adopt it. The principle, therefore, is that every simple invention that is claimed, so long as it is something which is novel or new, it would be an invention and the claims and specifications have to be read in that light.

DURATION OF PATENTS

The legal rights accrued by securing a Patent for an invention can be exercised for a limited period, which is specified in the Patent legislation of the country concerned. This period is called as the 'Term of the Patent'. Currently, in all member countries of WTO, including India, the term is twenty years from the date of filing the application. It should be noted that this term is not automatically renewed and depends on the payment of the prescribed annual fee within the stipulated time. If this fee (maintenance fee) is not paid, the Patent will lapse and become the public property. Subsequently, a fresh application for Patent for the said invention cannot be filed, as the novelty of the invention has been lost. Therefore, one has to be very careful to keep the Patent alive by paying the prescribed renewal fee within the time prescribed.

ELEMENTS OF PATENTABILITY

The conditions of Patentability are:

- Novelty
- Inventive step (non-obviousness)
- Industrial applicability (utility)

Novelty

A novel invention is one which has not been disclosed in the prior art where 'prior art' means everything that has been published, presented or otherwise disclosed to the public on the date of Patent (The 'Prior Art' includes documents in foreign languages disclosed in any format in any country of the world). For an invention to be judged as novel, the disclosed information should not be available in the 'Prior Art'.

This means that there should not be any prior disclosure of any information contained in the application for Patent (anywhere in the public domain, either written or in any other form, or in any language) before the date on which the application is first filed i.e. the 'priority date'.

Ganendro Nath Banerji v. Dhanpal Das Gupta, AIR 1945

it was held that no general rule can be laid down as to what does or does not constitute an invention. The general criterion seems to be whether that which is claimed lies within the limits of development of some existing trade, in the sense that it is such a development as an ordinary person skilled in that trade could, if he wishes so to do, naturally, make without any inventive step. But novelty need only be established in the process of manufacturing, not in the article produced. Novel combination of two known ideas may be sufficient to establish novelty of subject matter in this respect.

Ram Narain Kher v. M/s Ambassador Industries, AIR 1976

Delhi High Court held that at the time the Patent is granted to a party it is essential that the party claiming Patent should specify what particular features of his device distinguish it from those which had gone before and show the nature of the improvement which is said to constitute the invention. A person claiming a Patent has not only to allege the improvement in art in the form but also that the improvement effected a new and very useful addition to the existing state of knowledge. The novelty or the invention has to be succinctly stated in the claim.

Inventive Step (Non-obviousness)

'Inventive step' is a feature of an invention that involves technical advancement as compared to existing knowledge or having economic significance or both, making the invention non-obvious to a person skilled in that art. Here definition of 'inventive step' has been enlarged to include economic significance of the invention apart from already existing criteria for determining the inventive step.

An invention shall not be considered as involving an inventive step, if, having regard to the state of the art, it is obvious to a person skilled in the art. The term 'obvious' means that something which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, *i.e.*, *something* which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art.

Industrial Applicability

An invention is capable of industrial application if it satisfies following three conditions, cumulatively:

- **can be made;**
- **can be used in at least one field of activity;**
- **can be reproduced with the same characteristics as many times as necessary.**

An invention to be Patentable must be useful. If the subject matter is devoid of utility it does not satisfy the requirement of invention. For the purpose of utility, the element of commercial or pecuniary success has no relation to the question of utility in Patent law.

Non- Patentable Subject Matter

Under section 3 of 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 is not an invention.

(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 is not an invention.

(c) The mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature is 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 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 is not an invention.

(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 is not an invention.

(f) The mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way is not an invention.

(h) A method of agriculture or horticulture is not an invention.

(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 is not an invention.

(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 are not inventions.

(k) A mathematical or business method or a computer programme per se or algorithms are not inventions and hence not patentable.

(l) A literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions is not an invention.

(m) A mere scheme or rule or method of performing mental act or method of playing game is not an invention.

(n) A presentation of information is not an invention.

(o) Topography of integrated circuits is not an invention.

(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 is not an invention.

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

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

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Thank You.