

Indian Patent Law: An Overview

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Patent Law of a jurisdiction (the geographical territory of a State to which the legal system applies) is the law governing the grant of exclusive rights to make, use, sell, offer to sell or import a new and useful invention i.e., the rights allow the grantee to exclude all others from doing the aforementioned acts. These rights are granted by a State to the inventor or any person authorized by the inventor to own the invention. The Patent law also provides that the grantee shall practice the invention within the territory of the State and make it available to the public at a reasonable cost. This situation provides a kind of a monopoly to the grantee to practice the invention and to exclude all others to practice the same without authorization. A patent is a legal monopoly, which is granted for a limited time by a country to the owner of an invention. Merely holding a patent does not give the owner the right to use or exploit the patented invention. That right may still be affected by other laws such as health and safety regulations, food and drugs regulations or even by other patents. A patent, in the eyes of the law, is a property right that can be given away, inherited, sold, licensed and even abandoned. As it is conferred by the government, the government can in certain cases revoke the patent ,even after the grant of patent or even if it has been sold or licensed to another in the meantime. These rights are territorial since they are granted by a State subject to national laws, and therefore, may vary from one country to another

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and temporary, i.e., they are granted for a limited period of 20 years (which may extend to 21 years under certain cases).

Introduction

India patent Act, 1970 differentiates patentable and non-patentable inventions. It means distinction is made between invention and process of invention. Person should have been true inventor of the product in order to be eligible under Indian law. Person whom patent right has been granted is known as patentee. Patentee has monopoly right over creation, right to surrender, right to give patent to some other person. This right is given by a state in order to safeguard and protect his invention. Under Patent Act, right to prevent others from making any use, selling or distributing the invented patent without any permission from patentee. In case there is an infringement of the patentee's law then a suit may be filed for infringement.

The Indian Patent Law is administered by the Indian Intellectual Property Office, officially called as the Office of the Controller General of Patents, Designs and Trademarks (CGPDTM), which is a body of the Ministry of Commerce and Industry under the Department of Industrial Policy and Promotion. The patent law consists of the Indian Patents Act and the Indian Patents Rules and is supplemented by the Manual of Patent Practice and Procedures published by the IPO².

Patents Act, 1970 and TRIPS Agreement

India is a signatory to the TRIPS Agreement hence it modified its patents law in conformity with TRIPS Agreement. The use of Information and Communication

² A copy of each of these is available at <http://ipindia.nic.in/ipr/patent/patents.htm>

Technology (ICT) should be considered for an effective enforcement of the Intellectual Property Rights in India.

The existence of IPRs is very old. The basic aim of conferring an IPR upon the person owning the same is to give a social recognition to its holder. The problem of IPRs violations was not as much in ancient times as it is in the contemporary society. This has happened due to the advent of information technology (IT) and 'Conflicts of laws' in various countries. The need of harmonization of law concerning IPRs was felt at the international level. Thus, the TRIPS Agreement was formulated to bring basic level harmonisation in IPRs laws all over the world. The provisions of TRIPS Agreement are the most extensive and rigorous in nature. They protect all the forms of IPRs collectively. The protective umbrella of TRIPS covers the following IPRs:

- (1) Copyright and Related Rights,
- (2) Trademarks,
- (3) Geographical Indications,
- (4) Industrial Designs,
- (5) Patents,
- (6) Layout designs of Integrated Circuits, and
- (7) Protection of Undisclosed Information.

It must be noted that by virtue of Article 1(2) of the TRIPS Agreements, the Control of Anti-Competitive Practices in Contractual Licences has been excluded from the definition of 'intellectual property'. Thus, the TRIPS Agreement covers virtually the entire gamut of IPRs.

It is possible to patent programs for computers which when run on a computer produce a "technical effect or includes hardware". However, if a program does not produce a technical effect when run on a computer, it is unlikely to be patentable.

A technical effect is generally an improvement in technology and needs to be in an area of technology that is patentable. For instance, an improved program for translating between Japanese and English is not patentable because linguistics is a mental process, not a technical field. On the other hand, a program which speeds up image enhancement may be patentable because it produces a technical improvement in a technical area.

The Indian Patents Act, 1970 provides patent protection in India. The same is in accordance with the provisions of the TRIPS Agreement. The recent conferment of 'product patent' along with the 'process patent' is an example of such compatibility. The protection to plant varieties has been excluded from the realm of patent law and a separate Act has been made for that purpose. Further, the provisions of 'international patent application' and 'compulsory licenses' are also in conformity with TRIPS Agreement and Doha Declaration respectively. Thus, the interest of the public at large has also been taken care of by the Indian Patents Act, 1970 and there is no need of being panicked from product patent of medicines. However, there is no need of a 'further protection' to pharmaceuticals in the form of 'Data Exclusivity' as the protection under the Patents Act, 1970 is not only sufficient but also in conformity with the TRIPS Agreement. The protection in the form of 'Data Exclusivity' is a 'TRIPS plus' provision to which Indian does not owe any obligation.

Salient features of Indian Patent law

The Patent law of India has the following salient features that decide whether a patent will be granted or not:

(a) The Object: The object of patent law is to encourage scientific research, new technology and industrial progress. The price of the grant of the 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.

(b) Inventive step: The fundamental principle of Patent law is that a patent is granted only for an invention which must have novelty and utility. It is essential for the validity of a patent that it must be the inventor's own discovery as opposed to mere verification of what was, already known before the date of the patent.

(c) Useful: The previous Act, i.e. Act of 1911, does not specify the requirement of being, useful, in the definition of invention, but courts have always taken the view that a patentable invention, apart from being a new manufacture, must also be useful.

(d) Improvement: 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. It must produce a new result, or a new article or a better or cheaper article than before. The new subject matter must involve "invention" over what is old. 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.

(e) The guiding tests: To decide whether an alleged invention involves novelty and an inventive step, certain broad criteria can be indicated. Firstly if the "manner of manufacture" patented, was publicly known, used or practised in the country before or at the date of the patent, it will negative novelty or 'subject matter'. Prior public knowledge of the alleged invention can be by word of mouth or by publication through books or other media. Secondly, the alleged discovery must not be the obvious or natural suggestion of what was previously known.

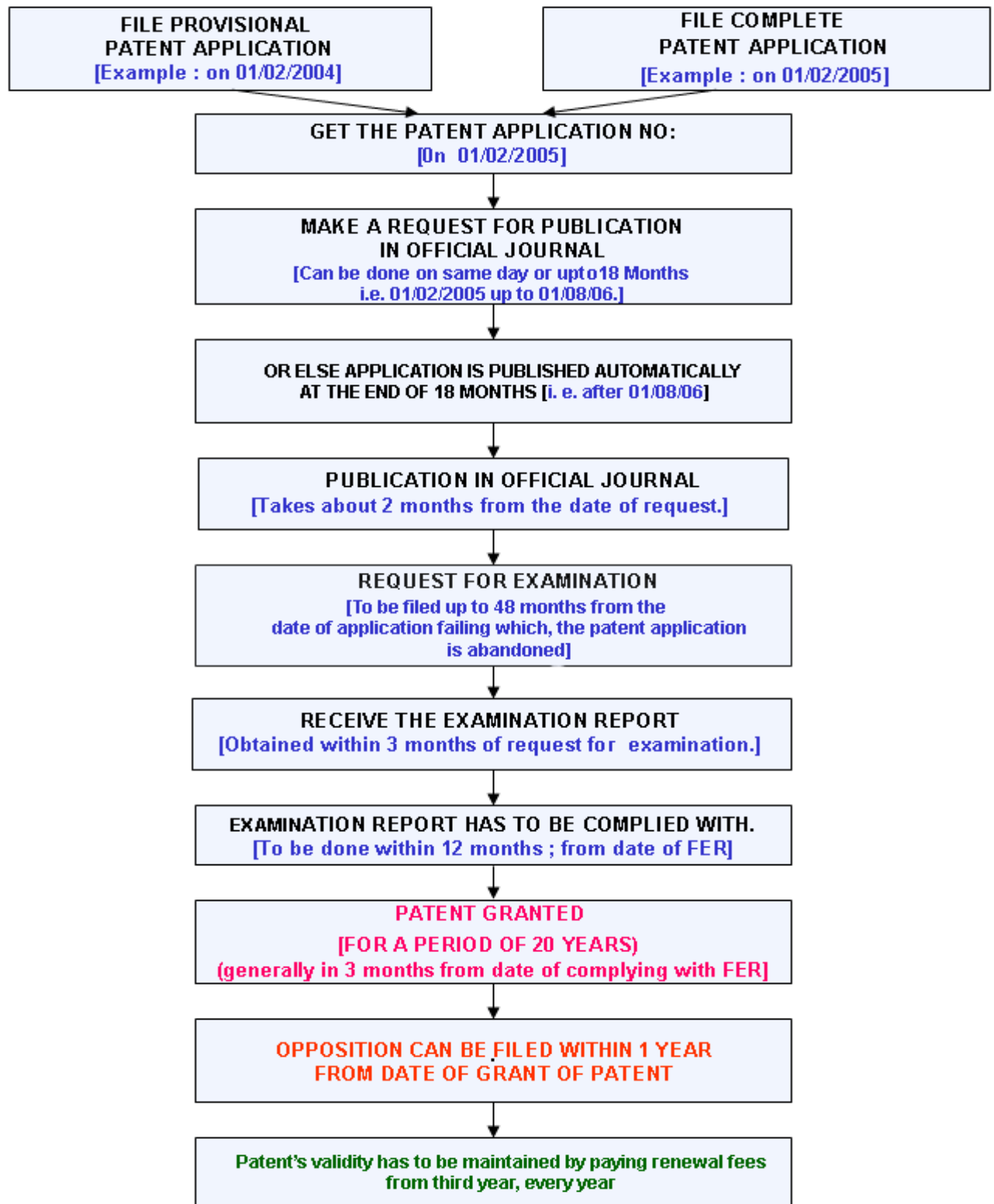
In short the invention must involve an inventive step and the same must be capable of industrial application. It must be supplemented by the concept of non-obviousness.

Procedure in India

1. Legal Basis:

- The Patents Act 1970, as amended by The Patents (Amendment) Act 2005.
- The Patents Rules, 2003, as amended by The (Amendment) Rules 2006.

2. Procedure for filing a patent application:



3. Filing a Patent Application

Any person, even if he or she is a minor, may apply for a patent either alone or jointly with any other person. Such persons include the inventor, or his assignee or legal representative in the case of an ordinary application or, in the case of a priority application, the applicant in the convention country or his assignee or his legal representative. A corporate body cannot be named as an inventor. Foreigners and nationals not living in India need an address for service in India for this purpose. They may appoint a registered agent or representative whose address for service can be the address for service in India.

- **Place of filing:**

An application for a patent must be filed at the Patent Office branch within whose territorial jurisdiction the applicant resides or has his principal place of business or domicile. A foreign applicant must file at that Patent Office branch within whose jurisdiction his/her address for service is located.

- **Priority:**

Priority can be claimed from the earliest corresponding application in a convention country, provided that the Indian application is filed within twelve months of the priority date. Multiple and partial priorities are allowed.

- **Specification:**

A priority application must be filed with a complete specification in the first instance but a non-priority application may be filed with either a

provisional specification or a complete specification. Where a provisional specification is filed in the first instance, a complete specification must be filed within twelve months. Where two or more cognate provisional specifications have been filed, they may be combined and all their subject matter may be incorporated into a single complete specification to be filed within twelve months of the date of the earliest filed provisional specification.

- **Naming of inventor(s):**

As regards non-priority applications, the inventor(s) must be named in the application form. As regards priority applications, a declaration as to inventorship must be filed with the application or within a period of one month.

- **Information of corresponding applications in other countries:**

It is necessary at the time of filing a patent application in India, to inform the Controller of the details of all corresponding applications in other countries and to undertake to keep the Controller so informed up to the grant of the Indian application. Failure to do so could result in the refusal of the application in case it is opposed, or even revocation of a patent in proceedings before the High Court.

4. Patent Publication

Publication takes place 18 months from the date of the application. Urgent publication is possible on request on payment of fees. From the date of publication of the application for a patent and until the date of grant of the patent, the applicant will have the like privileges and rights as if a patent for the invention had been granted on the date of publication of the application.

- **Pre-Grant opposition of patent application:**

After publication but before the date of grant, anyone may file an opposition to the grant of a patent, by way of representation.

5. Patent Examination

- **Examination of application:**

Both formal and substantive examinations are made by the Indian Patent Office. Examination is by request.

- **Procedure:**

An applicant is required to meet all the objections and requirements of the Patent Office within a period of twelve months from the date of the first examination report (FER) issued by the Controller. No extension of time is permitted. If a patent application is not put in order in twelve months from the date of the FER, it lapses.

- **Amendment of application:**

An applicant may, of his own accord, apply to the Controller for amendment of his application or any document filed in respect thereof but such amendments must be filed by way of correction, explanation, or disclaimer. An applicant may also amend his application or specification at the instance of the examiner and file a separate divisional application(s) for the other invention(s) which will be accorded the date of filing of the complete specification of the original application or such later date as the Controller may fix. The divisional application must be filed prior to the grant of the parent application.

6. Grant of a Patent

The grant of an application is published in the Official Journal and is notified therein for post-Grant opposition. A patent can be revoked within one year after grant by post-Grant opposition proceedings before the Controller of Patents.

7. Post-grant Procedures

- **Revocation of a patent:**

It is possible for a patent to be revoked on the grounds of: prior publication anywhere in the world, public use or knowledge in India, lack of novelty with regard to the subject matter, obviousness, lack of inventiveness, ambiguity, insufficiency of description of the invention, fraud, false suggestion or representation that the person named as the inventor is not the true inventor, lack of utility, non-patentability of subject matter (E.g. food, drug or medicine per se, atomic energy, mere admixture, mere arrangement of known devices, process of testing, method of agriculture or horticulture, process of medicinal treatment), failure to furnish or falsity in information regarding corresponding applications in other countries supplied to the Controller or that the invention is contrary to law or morality.

- **Annuities:**

Except in the case of a patent of addition, for which no annuities are payable, annual renewal fees must be paid during the life of an Indian patent, the first of such fees falling due at the end of the second year of the life of a patent granted. Renewal fees due during the pendency of the application are payable within a period of three months from the date the patent is taken on record in the Register of Patents. Renewal fees for two or more years may be paid in advance if the patentee so desires. A maximum

extension of six months may be obtained on payment of the prescribed penalty fees. If the renewal fee in question is not paid within the extended period available, the patent will lapse.

- **Restoration:**

A lapsed patent may be restored if an application for restoration is made within 18 months of the date of lapsing of the patent, provided it can be shown that the lapsing of the patent was unintentional and that there was no undue delay in making the application for restoration.

- **Working of patents:**

Every patentee and every licensee is required to furnish within three months from the end of every calendar year, a statement as to the extent to which the invention has been worked in India on a commercial scale in the preceding year. Non-filing of this statement is a criminal offence.

- **Compulsory licenses:**

After three years from the date of grant of a patent, an interested party may apply to the Controller for the grant of a compulsory license alleging that the reasonable requirements of the public with respect to the invention have not been satisfied or that the invention is not available at a reasonable price. If the Controller is satisfied that a *prima facie* case for an applicant for compulsory license has been made, he shall serve a notice on the patentees who, if they so desire, may oppose the application for compulsory license.

- **Marking:**

Marking is not compulsory but advisable as otherwise damages may be difficult to recover in cases of infringement. The invention may be marked with the word “Patented” or “Patent” accompanied by the number and year of the patent.

- **Infringement:**

An infringement suit may be instituted by a patentee or his exclusive licensee. Every ground for revocation is available as a defense and revocation can be counter claimed in infringement proceedings. The Court may grant relief in respect of a valid claim or claims even though one or more other claims in the suit may be held to be invalid. Relief may include damages and costs as awarded by the court. A suit for injunction may be instituted and damages recovered in cases where there have been groundless threats. Any person may institute a suit for declaration as to non-infringement of a patent. The onus of proof of non-infringement lies with the defendant.

Conclusion

The Indian patents Act, 1970 is not only a complete Act but also in conformity with the TRIPS Agreement. It, however, needs enunciations in the form of judicial precedents as the same are lacking in case of patent law. It further must be analysed in the light of International developments in this field. The Indian Patent law must also be analysed in the light of both Public International law and the Private International Law as the same may create some problems in future.

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