

Intellectual Property Rights

A Manual

2007



**A MANUAL
ON
INTELLECTUAL PROPERTY RIGHTS
(IPR)**



Entrepreneurship Development and IPR Unit

BIRLA INSTITUTE OF TECHNOLOGY & SCIENCE, Pilani

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Preface

This manual provides guidelines relating to the procedure of filing patents applications in India. The manual takes care of amendments that have been brought out in the Patents Act from time to time including new provisions of the law viz. The Patents Act, 1970 as amended by the Patents (Amendment) Act of 1999, the Patents Amendment Act 2002, and further, by the Patents (Amendment) Ordinance 2004 Act 2005. The main purpose is to create awareness amongst the faculty members and researchers about patents system in India and to provide user friendly guidelines for obtaining and maintaining patents under the existing Patents law. It is expected that this manual will be of significant help to people involved in innovation and invention activities towards protecting their intellectual property rights arising as an outcome of their efforts.

This is only a preliminary step towards creating awareness about Intellectual Property Rights (IPR). Suggestions for improving the quality of the manual are welcome.

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INTELLECTUAL PROPERTY RIGHTS

1.1 Introduction

For nearly last two hundred years, neo-classical economics had recognized only two factors of production: labour and capital. But now this is changing. Information and knowledge are replacing capital and energy as the primary wealth-creating assets, just as the latter two replaced land and labour 200 years ago. In addition, technological developments in the 20th century have transformed the majority of wealth-creating work from physically-based to "knowledge-based." Technology and knowledge are now the key factors of production. With increased mobility of information and the global work force, knowledge and expertise can be transported instantantly around the world, and any advantage gained by one company can be eliminated by competitive improvements overnight. The only comparative advantage a company will enjoy will be its process of innovation--combining market and technology know-how with the creative talents of knowledge workers to solve a constant stream of competitive problems--and its ability to derive value from information. The major challenge before organizations in the coming years would be to create a culture for IPRs regime, so that creative work and innovations get duly protected. More and more organizations may have to provide at their cost the services of IP Management Consulting Firm for drafting/prosecution of the intellectual Property (IP) application(s) and also provide adequate funds for making payments for accessing the relevant IP databases for this purpose. Thus, to make Economics of Knowledge as the greatest strength of Indian economy, there would be need for creating an ecosystem for promotion of particularly knowledge driven entrepreneurship with major emphasis on creating an environment and a system to provide due protection to the intellectual properties. This can be achieved by creating a stringent IPR regime.

Intellectual Property Rights (IPR), very broadly, are rights granted to creators and owners of works that are results of human intellectual creativity. These works can be in the industrial, scientific, literary and artistic domains, which can be in the form of an invention, a manuscript, a suite of software, or a business name.

The importance of intellectual property in India is well established at all levels- statutory, administrative and judicial. India ratified the agreement establishing the World Trade Organisation (WTO). This Agreement, inter-alia, contains an Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) which came into force from 1st January 1995. It lays down minimum standards for protection and enforcement of intellectual property rights in member countries which are required to promote effective and adequate protection of intellectual property rights with a view to reducing distortions of and impediments to international trade. The obligations under the TRIPS Agreement relate to provision of minimum standard of protection within the member countries legal systems and practices.

The Agreement provides for norms and standards in respect of following areas of intellectual property:

- Patents
- Copyrights and related rights
- Trade Marks
- Geographical Indications
- Industrial Designs
- Layout Designs of Integrated Circuits
- Protection of Undisclosed Information (Trade Secrets)
- Plant varieties

IPR is a general term covering patents, copyright, trademark, industrial designs, geographical indications, protection of layout design of integrated circuits and protection of undisclosed information (trade secrets).

1.2 Legislations Covering IPRS in INDIA

1.2.1 Patents: The Patents Act, 1970.

The act was last amended in March 1999.

1.2.2 Design: The Designs Act, 1911. A new Designs Act 2000 has been enacted superseding the earlier Designs Act 1911.

1.2.3 Trade Mark: The Trade and Merchandise Marks Act, 1958. A new Trademarks Act, 1999 has been enacted superseding the earlier Trade and Merchandise Marks Act, 1958. (Enforcement pending)

1.2.4 Copyright: The Copyright Act, 1957 as amended in 1983, 1984 and 1992, 1994, 1999 and the Copyright Rules, 1958.

1.2.5 Layout Design of Integrated Circuits: The Semiconductor Integrated Circuit Layout Design Act 2000. (Enforcement pending) Protection of Undisclosed Information: No exclusive legislation exists but the matter would be generally covered under the Contract Act, 1872

1.2.6 Geographical Indications: The Geographical Indication of Goods (Registration and Protection) Act 1999. (Enforcement pending).

PATENTS

The Patents Act, 1970 is a landmark in the industrial development of India. The basic philosophy of the Act is that patents are granted to encourage inventions and to ensure that these inventions are worked on a commercial scale without undue delay.

The word “Invention” has been defined under the Patents Act 1970 as amended from time to time; as

*“An **invention** means a new product or process involving an inventive step and capable of industrial application” (S. 2(1) (j))*

“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 .

A patent is an exclusive right granted by a country to the owner of an invention to make, use, manufacture and market the invention, provided the invention satisfies certain conditions stipulated in the law. Exclusivity of right implies that no one else can make, use, manufacture or market the invention without the consent of the patent holder. This right is available only for a limited period of time. However, the use or exploitation of a patent may be affected by other laws of the country which has awarded the patent.

These laws may relate to health, safety, food, security etc. Further, existing patents in a similar area may also come in the way. A patent in the law is a property right and hence, can be gifted, inherited, assigned, sold or licensed. As the right is conferred by the State, it can be revoked by the State under very special circumstances even if the patent has been sold or licensed or manufactured or marketed in the meantime. The patent right is territorial in nature and inventors/their assignees will have to file separate patent applications in countries of their interest, along with necessary fees, for obtaining patents in those countries.

By virtue of the grant of a patent, patentee gets the exclusive rights in his favour that prevent the third parties (not having his consent) from making, using, offering for sale, selling or importing the patented product or process within the territory of grant.

The basic obligation in the area of patents is that, invention in all branches of technology whether products or processes shall be patentable if they meet the three tests of: being new, involving an inventive step, and being capable of industrial application. In addition to the general security exemption which applies to the entire TRIPS Agreement, specific exclusions are permissible from the scope of patentability of inventions, the prevention of whose commercial exploitation is necessary to protect public order or morality, human, animal, plant life or health; or to avoid serious prejudice to the environment. Further, members may also exclude from patentability diagnostic, therapeutic and surgical methods of treatment of humans, animals and plants other than micro-organisms and essentially biological processes for the production of plants and animals.

The TRIPS Agreement provides for a minimum term of protection of 20 years counted from the date of filing. India has already implemented its obligations under Articles 70.8 and 70.9 of TRIPS Agreement.

A comprehensive review of the Patents Act, 1970 was also made and a bill to amend the Patents Act, 1970 was introduced in Parliament on 20th December, 1999 and notified on 25-6-2002 to make the Patents Law TRIPS compatible. India amended its Patents Act again in 2002 to meet the second set of obligations (Term of Patent etc.), which had to take effect from 1-1-2000. This amendment, which provides for 20 years term for the patent, reversal of burden of proof etc., came into force on 20th May, 2003. The Third Amendment of the Patents Act 1970, by way of the Patents (Amendment) Ordinance 2004 came into force on 1st January, 2005 incorporating the provisions for granting product patent in all fields of Technology including chemicals, food, drugs and

agrochemicals and this Ordinance has been replaced by the Patents (Amendment) Act 2005 which has been in force now with effect from 1-1-2005.

2.1 Conditions to be satisfied by An Invention to be Patentable

An invention must satisfy the following three conditions of:

- (i) Novelty
- (ii) Inventiveness (Non-obviousness)
- (iii) Usefulness

(i) 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'.

(ii) Inventiveness (Non-obviousness):

A patent application involves an inventive step if the proposed invention is not obvious to a person skilled in the art i.e., skilled in the subject matter of the patent application. The prior art should not point towards the invention implying that the practitioner of the subject matter could not have thought about the invention prior to filing of the patent application. Inventiveness cannot be decided on the material contained in unpublished patents. The complexity or the simplicity of an inventive step does not have any bearing on the grant of a patent. In other

words a very simple invention can qualify for a patent. If there is an inventive step between the proposed patent and the prior art at that point of time, then an invention has taken place.

(iii) Usefulness:

An invention must possess utility for the grant of patent. No valid patent can be granted for an invention devoid of utility.

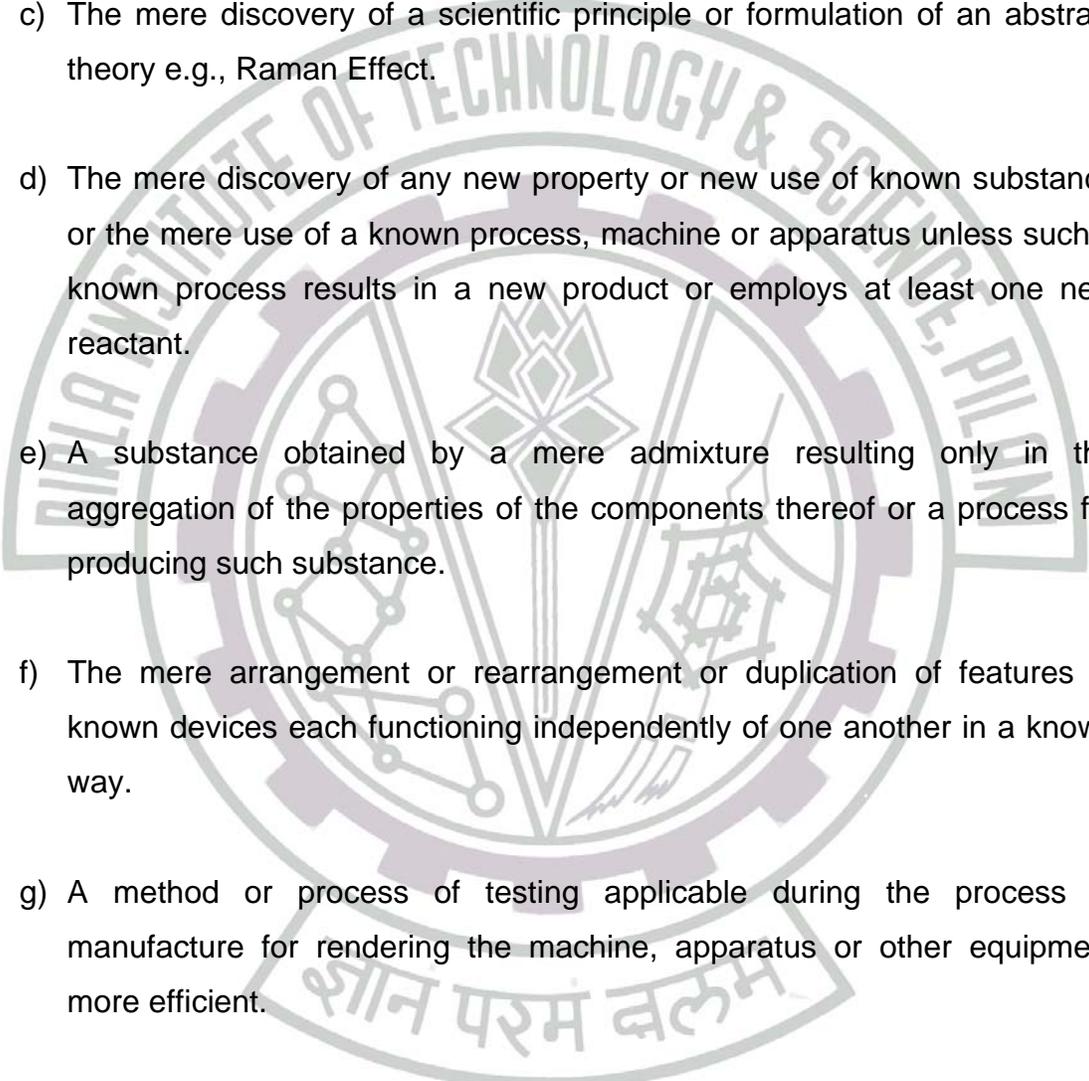
2.2 Patentable Inventions under the Patents Act, 1970

- a) Art, process, method or manner of manufacture.
- b) Machine, apparatus or other article, Substances produced by manufacture, which include any new and useful improvements of any of them and an alleged invention.
- c) However, inventions claiming substance intended for use, or capable of being used, as food or as medicine or drug or relating to substances prepared or produced by chemical processes (including alloys, optical glass, semiconductors and inter-metallic compounds) are not patentable.

2.3 Types of Inventions which are not Patentable in India

An invention may satisfy the conditions of novelty, inventiveness and usefulness but it may not qualify for a patent under the following situations:

- a) An invention which is frivolous or which claims anything obviously contrary to well established natural laws e.g. different types of perpetual motion machines.

- 
- b) An invention the primary or intended use of which would be contrary to law or morality or injurious to public health e.g. a process for the preparation of a beverage which involves use of a carcinogenic substance, although the beverage may have higher nourishment value.
- c) The mere discovery of a scientific principle or formulation of an abstract theory e.g., Raman Effect.
- d) The mere discovery of any new property or new use of known substance or the mere use of a known process, machine or apparatus unless such a known process results in a new product or employs at least one new reactant.
- 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.
- f) The mere arrangement or rearrangement or duplication of features of known devices each functioning independently of one another in a known way.
- g) A method or process of testing applicable during the process of manufacture for rendering the machine, apparatus or other equipment more efficient.
- h) A method of agriculture or horticulture.
- i) Any process for medical, surgical, curative, prophylactic or other treatment of human beings, or any process for a similar treatment of animals or plants.

- j) Inventions relating to atomic energy.

2.4 Term of a Patent in the Indian System

- (a) Five years from the date of sealing of the patent or seven years from the date of the patent (i. e. the date of filing the complete specification), whichever period is shorter, for an invention claiming the method or process of manufacture of a substance, where the substance is intended or capable of being used as a drug, medicine or food.
- (b) Twenty years from the date of patent in respect of any other patentable invention.

2.5 Essential Patent Documents to be submitted

There are two types of patent documents usually known as patent specification, namely

- (i) Provisional Specification and
- (ii) Complete Specification

A provisional specification is usually filed to establish priority of the invention in case the disclosed invention is at a conceptual stage and a delay is expected in submitting full and specific description of the invention. Although, a patent application accompanied with provisional specification does not confer any legal patent rights to the applicants, it is, however, a very important document to establish the earliest ownership of an invention. The provisional specification is a permanent and independent scientific cum legal document and no amendment is allowed in this. No patent is granted on the basis of a provisional specification. It

has to be followed by a complete specification for obtaining a patent for the said invention. Complete specification must be submitted within 12 months of filing the provisional specification. This period can be extended by 3 months. It is not necessary to file an application with provisional specification before the complete specification. An application with complete specification can be filed right at the first instance.

(ii) Complete Specification:

Submission of complete specification is necessary to obtain a patent. The contents of a complete specification would include the following

Title of the invention

- ❖ Field to which invention belongs.
- ❖ Background of the invention including prior art giving drawbacks of the known inventions practices.
- ❖ Complete description of the invention along with experimental results.
- ❖ Drawings etc. essential for understanding the invention.
- ❖ Claims, which are statements, related to the invention on which legal proprietorship is being sought. Therefore the claims have to be drafted very carefully.

Note: Some sample forms for filling of Patent application are given in Annexure-1.

2.6 Criteria for Naming Inventors in an Application for Patent

The naming of inventors is normally decided on the basis of the following criteria:

- a) All persons who contribute towards development of patentable features of an invention should be named as inventor(s).

- b) All persons, who have made intellectual contribution in achieving the final results of the research work leading to a patent, should be named as inventor(s).
- c) A person who has not contributed intellectually in the development of an invention is not entitled to be included as an inventor.
- d) A person who provides ideas needed to produce the 'germs of the invention' need not himself / herself carry out the experiments, construct the apparatus with his/her own hands or make the drawings himself/herself. The person may take the help of others. Such persons who have helped in conducting the experiments, constructing apparatus or making the drawings or models without providing any intellectual inputs are not entitled to be named as inventors.

Quite often difficulties are experienced in deciding the names of inventors. To avoid such a situation, it is essential that all scientists engaged in research should keep factual, clear and accurate record of daily work done by them in the form of a diary. The pages in the diary should be consecutively numbered and the entries made should be signed both by the scientists and the concerned leader.

2.7 Where to apply?

Application for the patent has to be filed in the respective patent office as mentioned below. The territorial jurisdiction is decided based on whether any of the following occurrences falls within the territory:

- a) Place of residence, domicile or business of the applicant (first mentioned applicant in the case of joint applicants)
- b) Place from where the invention actually originated.
- c) Address for service in India given by the applicant when he has no place of business or domicile in India.

A foreign applicant should give an address for service in India and the jurisdiction will be decided upon that. An applicant (Indian or foreigner) also can give his Patent Agent's address as address for serving documents, if he/she so wishes.

Table: 2.1 Various Patent Offices in India

Patent Office	Territorial Jurisdiction
Mumbai	States of Gujarat, Maharashtra, Madhya Pradesh, Goa, Chattishgarh; Union territories of Daman and Diu, and Dadra and Nagar Haveli
Delhi	State of Haryana, Himachal Pradesh, Jammu & Kashmir, Punjab, Rajasthan, Utter Pradesh, Uttarnchal, National Capital Territory of Delhi and Union Territory of Chandigarh
Chennai	States of Andhra Pradesh, Kerala, Karnataka, Tamil Nadu; and Union Territories of Pondicerry and Lakshdweep
Kolkata (Head Office)	Rest of India

2.8 How to apply ?

Steps Involved in Obtaining a Patent

- To file an application for patent accompanied with either a provisional specification or a complete specification
- To file complete specifications , if provisional application was submitted earlier
- Examination of the application by patent office
- Acceptance of applications and publication in the gazette of accepted applications
- Responding and satisfactorily overcoming the opposition/objections , if any, to the grant of patent
- Sealing of patent

Application for patent (Form 1) in duplicate should be accompanied by the documents as indicated below. The fee (Rs.1000/- for natural citizen of India or Rs.4000 /- for other than a citizen) can be paid within one month. Other details of the fee payable for different purposes are given in the Appendix -3. The details about various applicable forms for filing patents are given in the Appendix – 4.

- a) Application for Grant of Patent (Form 1)
- b) Provisional or Complete Specification (Form 2) and drawings (if any) in duplicate
- c) Statement and undertaking regarding foreign filing details in respect of the same invention (Form 3)
- d) Declaration as to Inventorship (Form 5) (In the case of a Convention Application and PCT National Phase Application and filing Complete after Provisional)
- e) Priority document (if it is a Convention Application)
- f) Power of Attorney (Form 26) (if the application is made through a patent agent)
- g) Proof of Right if the application is made by the assignee (Proof of right to apply can be produced either in the body of the application (Endorsement in Form1) or by way of a separate assignment deed.

2.9 Why 'Provisional' Specification ?

When the applicant finds that his invention has reached a presentable form, then he may prepare a disclosure of the invention in the form of a written description and submit it to the patent office. This disclosure is called a Provisional Specification. Application for *Provisional Specification* has to include the nature of the invention. This gives a priority to the applicant over any other person who

is likely to file an application for patent in respect of the same invention being developed concurrently in some other part of the world.

Immediately on receiving the provisional specification the patent office accords a filing date for the application and gives a period up to twelve months for filing the Complete Specification during which the applicant can fully develop his invention.

2.10 Complete Specification

Complete Specification is a techno-legal document that fully and particularly describes the invention and the best method of performing it. It should start with a preamble “The following specification particularly describes the nature of this invention and the manner in which it is to perform.” It should contain the following in not more than 30 pages beyond which each page is chargeable as given in the first schedule.

- **A Title**

The title should give a fair indication of the art or industry to which the invention relates. It should be brief and as precise and definite as possible. The following are not allowable in the title: — a) The inventor’s name b) The word ‘Patent’ c) Words in other languages d) The abbreviation “etc.” e) Fancy words, e.g., “Wash Well Soap”, “Universal Rest Easy Patent Chair”.

- **Field of the invention.**

The description should preferably begin with a short general statement of the invention so as to show its *scope*, and to indicate briefly the subject matter to which the invention relates, e.g. “This invention relates to”

- **State of the Art in the Field**

This part should indicate the status of the technology in the field of invention with reference to experiments going on in the field, patents and pending patent applications in the specific art with emphasis on the '**prior art**' relevant to the invention. When the invention relates to an improvement on an existing apparatus or process a short statement of **closest prior art** may also be given.

- **Object of the invention (Problem & Solution)**

The purpose is to clearly bring out the necessity of the invention. It shall clearly specify the technical problems associated with the existing technology and the proposed solution, highlighting the obvious difference between the claimed invention and the prior art. The solution sought by the invention should be clearly brought out with statements like "It has already been proposed
. " followed by the objects which the invention has in view e.g. "The principal object of this invention is", "Another object of this invention is", "A further object of this invention is" etc.

- **Statement of invention**

The description should include a statement of invention before giving the details of the invention and the method of performing it. The statement should clearly set forth the distinguishing *novel features* of the invention for which protection is desired. This part is intended to declare the different aspects of the invention *verbatim* with the claims and complements to the omnibus claim in situations of infringement proceedings.- It usually starts like "Accordingly the invention provides an apparatus consisting of ----- which is characterized in that -----". Other aspects and processes if any also can be stated e.g. "There is also provided a method for performing -----" etc.

- **Detailed description of the invention with reference to the drawings.**

The details of the invention described should be sufficient for an average person skilled in the art to perform the invention by developing the necessary technical **know how** by himself. It can include examples/drawings or both for clearly describing and ascertaining the nature of the invention. Sufficient number of examples can be appended to the description especially in the case of chemical inventions. The following terms are somewhat vague, and their use should be avoided from the description as far as possible: — “Special”, “design”, “suitable”, “etc”. “Whereby”, “if desired”, “and/or”, “customary methods”, “known methods”. Terms in other languages, if any, used in the description should be accompanied by their English equivalents. The use of vague slang words and colloquialisms is objectionable and should be avoided.

- **Scope and/or Ambit of the Invention**

This part of the specification should bring out the areas of application of the invention and the preferable use of the invention. The applicant can substantiate the industrial applicability of the invention in this part and call for the protection against duplication of the invention in the related fields by specifying the scope and ambit. *The advantages of the invention also can be described in this part of the specification.*

- **Claims**

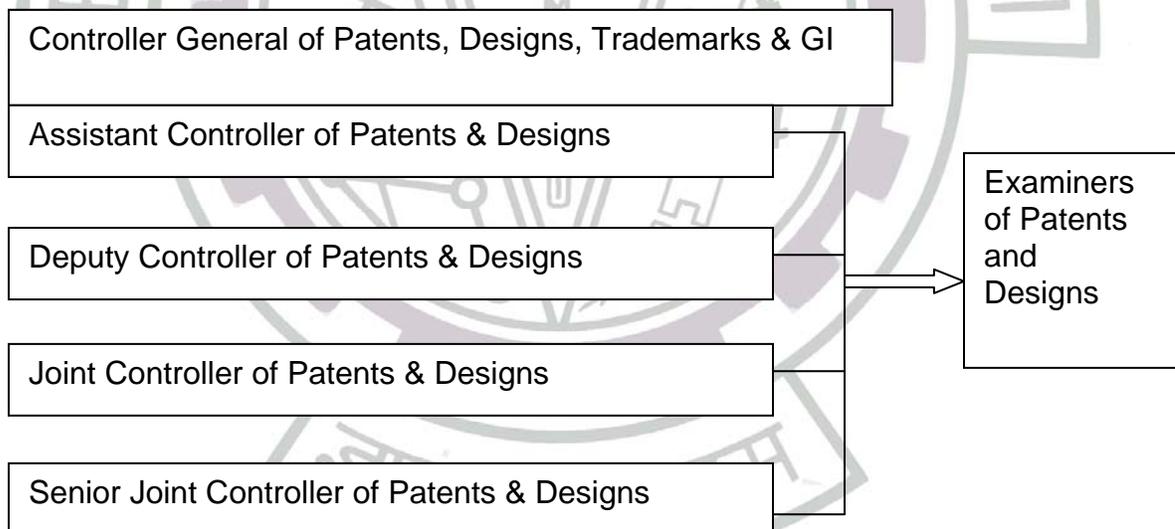
The description in the Complete Specification need to clearly and succinctly state the “Claims” preceded by the prescribed preamble, “I claim” or “We claim”, as the case may be. It shall preferably start from the next page after the full description of the invention with the claims serially numbered. The purpose of the

statement of Claims is to highlight with conciseness, precision and accuracy as to how much of what is described in the specification has been sought to be protected, implying thereby that what is not claimed is open to public use. *The claim or claims of a complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept.*

Statement of the form given immediately below is *not* to be regarded as claims, in as much as they do not define the invention: —

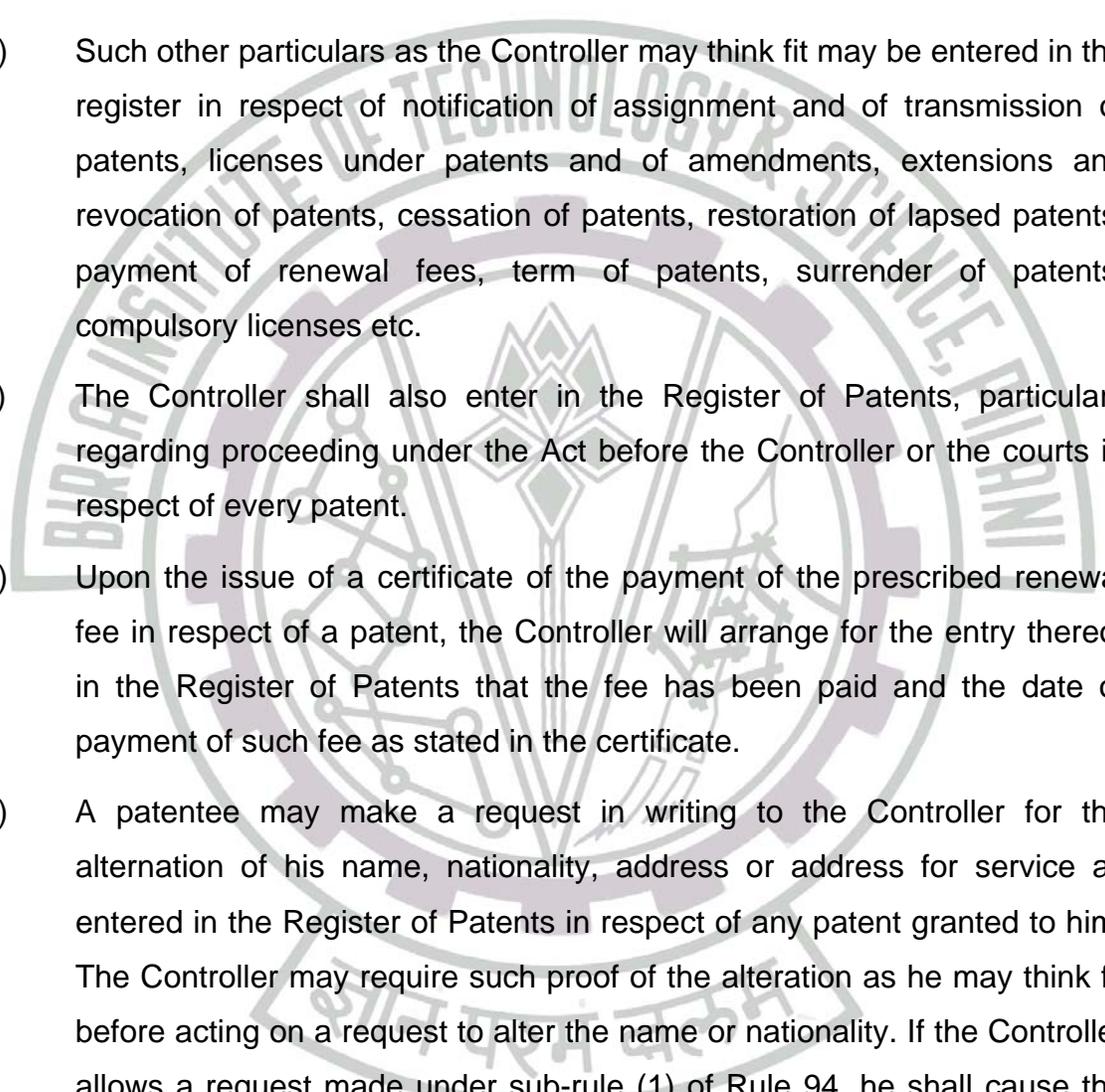
- a) I claim to be the inventor of this appliance.
- b) I claim a patent and that no one else shall use my invention without leave.
- c) I claim that the machine described above is quite new and has never been seen or used before.

2.11 Hierarchy of Officers in Patents Office



2.12 Register of Patents

Register of patents and particulars to be entered therein (S. 67)

- 
- a) Upon the grant of a patent, the Controller will arrange to enter in the Register of Patents, the name, address and nationality of the grantee as the patentee thereof, the title of the invention (including the categories specified in section 5 to which the invention relates), the date of the patent and the date of granting thereof together with address of service of the Patent.
- b) Such other particulars as the Controller may think fit may be entered in the register in respect of notification of assignment and of transmission of patents, licenses under patents and of amendments, extensions and revocation of patents, cessation of patents, restoration of lapsed patents, payment of renewal fees, term of patents, surrender of patents, compulsory licenses etc.
- c) The Controller shall also enter in the Register of Patents, particulars regarding proceeding under the Act before the Controller or the courts in respect of every patent.
- d) Upon the issue of a certificate of the payment of the prescribed renewal fee in respect of a patent, the Controller will arrange for the entry thereof in the Register of Patents that the fee has been paid and the date of payment of such fee as stated in the certificate.
- e) A patentee may make a request in writing to the Controller for the alternation of his name, nationality, address or address for service as entered in the Register of Patents in respect of any patent granted to him. The Controller may require such proof of the alteration as he may think fit before acting on a request to alter the name or nationality. If the Controller allows a request made under sub-rule (1) of Rule 94, he shall cause the entries in the register to be altered accordingly.

If a patentee makes a request in writing for entering an additional address for service in India and the Controller is satisfied that the request should be allowed,

subject to the condition that no more than two addresses for service shall be entered in the register at any one time.

Register of patent can be used as evidence in the court of law. There is no need of producing the original register in the court .The duly certified copies of the entries in respect of patent in the register can serve the purpose.

Some examples of patents granted are given in Appendix -5.

2.13 Working of Patents and compulsory Licensing

➤ Working of Invention

Patents are granted for the purpose of exploitation, which will enhance industrial development and therefore should be worked in its fullest extent within the territory of India. S.83 of Patents Act provides that *“Patents are granted to encourage inventions and to secure that the inventions are worked in India on a commercial scale and to the fullest extent reasonably practicable without undue delay and they are not granted merely to enable patentees to enjoy a monopoly for the importation of the patented article.”*

The patentee and every licensee should furnish the details of working of the invention at every six months and whenever required by the Controller (S. 146)

➤ Revocation of patent for non-working (S. 85):

An application to the Controller for an order revoking the patent under section 85(1) may be made after the expiry of 2 years from the date of order granting the first compulsory license. The application shall be in Form 19 with the prescribed fee. Except in the case of an application made by the Central Govt., the application shall set out the nature of the applicant's interest and the terms and conditions of the license the applicant is willing to accept.

➤ **Compulsory Licenses (S. 84):**

The provisions for compulsory licenses are made to prevent the abuse of patent as a monopoly and to make way for commercial exploitation of the invention by an interested person. Any interested person can make an application for grant of compulsory license for a patent after three years from the date of grant of that patent on any of the following grounds –

- a) The reasonable requirements of the public with respect to the patented invention have not been satisfied.
- b) The patented invention is not available to the public at a reasonably affordable price.
- c) The patented invention is not worked in the territory of India. The request for grant of a compulsory license can also be made by a licensee of the patent. Application for compulsory license should be made in Form 17 with the prescribed fee of Rs.1500 for natural person and Rs.6000/- for other than natural person with a statement setting out the nature of the applicant's interest and the facts upon which the application is based.

➤ **Government Use of the Inventions**

- Anytime after filing or grant of a patent, Government or any person authorized by it can use the patented invention for the purpose of Government.
- If an invention is used before the priority date of the relevant claim of complete specification by the Government or any person authorized by it for the purpose of Government, then no royalty or remuneration need to be paid to the patentee.
- If an invention is to be used at any time after the grant of Complete Specification by Government or any person authorized by it for the purpose of Government, then that use should be made only on terms agreed upon between the Government or any person duly authorized

and the patentee or in default of agreement be decided by High Court under section 103.

- Government can authorize any person in respect of an invention either before or after the grant whether or not the patentee authorizes that person.
- Where Government authorizes any person for using an invention for Govt. purposes then unless it is contrary to the Public interest the Central Government shall inform the patentee, from time to time, the extent of use of the invention for the purpose of Government. In case of use by the undertaking, Government may call for such information from the undertaking.
- The right to use the invention for the purpose of Government includes the right to sell the goods and the purchaser has the power to deal with the goods as if the Government or the person authorized were the patentee of the invention.
- In case of an exclusive licensee as per section 101 (3) or an assignor, Central Government should also inform the exclusive licensee or assignor, as the case may be, regarding the extent of use of invention for the purpose of Government.
- In respect of an invention used by the Government for the purpose of Government, any agreement, license of assignment etc. between the patentee or applicant and any person other than the Government shall have no effect if the agreement restricts the use for the purpose of Government or instructs any payment in respect of any use for the purpose of Government.
- In relation to any use of the invention made for the purpose of Government by the patentee to the order of Central Government any sum payable by virtue of section 100 (3) shall be divided between the

patentee and the assignor in such proportion as may be agreed upon or in default be decided by high Court under section 103.

- In case there is an exclusive licensee authorized under his license to use the Invention for the purpose of Government the patentee shall share any payment and such licensee in such proportion as agreed upon or, in default, is decided by High Court under section 103.
- If necessary Central Government can acquire an invention from the applicant or patentee for a public purpose, by publishing a notification to that effect in the Official Gazette
- Notice of acquisition shall be given to the applicant or patentee, as the case may be, and other persons appearing in the register as having interest in that patent.
- Compensation should be given by the Central Government to the concerned person as agreed upon between them or in default be determined by High Court under Section 103. Any dispute arising out of use of an invention by the Central Government for the purpose of Government may be referred to the High Court by either party to the dispute in such manner as may be prescribed by rules of High Court under Section 103. Government may ask for revocation of patent or raise an issue regarding the validity of the patent. In case the Government thinks disclosure of any document regarding the invention will be prejudicial to the public interest, then the Government can disclose confidentially to the advocate of other party in any proceeding at any time at the High Court.

2.14 Revocation of Patents

I. A Patent may be revoked by High Court on any of the grounds stated hereafter, at any time during the life of the patent.

- i) On the petition by any person interested or
- ii) On the petition by the Central Government by the Appellate Board
- iii) On a counter claim by the defendant in a suit of infringement.

In a suit for infringement under Sec. 104 the defendant's counter-claim for revocation of a patent, the High Court may revoke a patent without any separate petition for revocation.

II. Grounds for Revocation

The following are the grounds of opposition

- a) Invention claimed is the subject of prior grant
- b) Patentee not entitled to the patent
- c) Patent was wrongfully obtained by a person other than the person entitled:
- d) Subject of a claim is not an invention
- e) Invention is "lacking in novelty with regard to prior knowledge or prior use
- f) Invention is obvious or does not involve inventive step having regard to prior knowledge or prior use

- g) Invention is not useful.
- h) Invention is not sufficiently described.
- i) Claim not clearly defined and not fairly based.
- j) Patent was obtained by false suggestion or representation.
- k) Subject of claims not a patentable invention.
- l) Claimed invention was secretly used before the priority date.
- m) Failure to disclose information regarding Foreign Application.
- n) Non-compliance of secrecy direction.
- o) Leave to Amendment of specification obtained by fraud.
- p) Specification Wrongly Mentioning or Not Disclosing Geographical Origin.
- q) Inventions is Anticipated by traditional knowledge

2.15 Term of Patent

The term of patent is 20 years from the date of the application in respect of all the patents including those which have not expired on 20/05/03, when Patents (Amendment) Act 2002 came into force provided that the renewal fee is paid every year on due date or extended period (maximum six months). To keep the patent in force renewal fee should be paid at the expiration of the second year from the date of patent or of any succeeding year before the expiration of the second or succeeding year (Rule 80 (1)). The annual fee payable in respect of two or more years may be paid in advance. The fee to be paid is listed under entry no. 18 of the First Schedule whereas renewal fee, which has become due after the grant of patent, shall be governed by the provisions of Sec. 53. The renewal fee, which has become due at the time of grant of patent, will be governed by Section 142(4). It says that when the patent is granted later than two years from the date of filing of complete specification, the fee that has become due in the meantime might be paid within three months from the date of recording of the patent in the Register or within the extended period not later than nine months from the date of recording. (S. 142(4)). In the cases where the renewal fee, which have become due at the time of grant and which have become due after the grant are very close, these may be paid together along with required extension under Section 53.

2.16 Patent of Addition

When an applicant feels that he has come across an invention which is a slight modification on the invention for which he has already applied for / has patent the applicant can go for Patent of Addition since the invention does not involve a substantial inventive step. It is also possible to convert an independent patent to a patent of addition at a later date if the subject matter was an improvement in or modification to the main invention for which he holds a patent.

However patent will not be granted as Patent of Addition unless the date of filing complete specification was the same or later than the date of filing of the complete specification in respect of the main invention (S. 54(1), S. 54 (2) & S. 54(3)).

It should be noted that a Patent of Addition will not be granted before the granting of the patent for the main invention. In an application for a Patent of Addition, the determination as to whether the invention proposed is or is not an improvement or modification of the applicant's previous invention, has to be done by the proper comparison between the novel contributions which each specification has made to the art and not between the sum of the characteristics claimed in the respective main invention and proposed Patent of Addition. In other words mere presence of a number of elements common to both inventions is not sufficient to make one invention an improvement of or addition to the other.

Note: Patenting process and stages of prosecution of IPR application in India are given in Appendix-1 & 2. Some examples of patent(case Studies) are given in Appendix-5.

COPYRIGHT

Copyright is one of the key branches of IP law which protects the expression of ideas. For a work to gain copyright, it has to be original and should be expressed in a material form. Copyright is thus effective upon the creation of the work. It arises automatically and in the UK one does not have to register the copyright in the work before it is protected.

3.1 Entitlement to Copyright

A work will qualify for copyright protection if:

- It is of a type protected by copyright under the Act.
- It is recorded in some form – e.g. in writing, by a sound recording, on a computer disk, or in a printed form.

- The work meets the requisite degree of originality. A work is original if adequate skill, labour and judgment are spent on creating it.

3.2 Works Protected by Copyright

The types of copyright works are broadly categorised into:

- Original literary, dramatic, artistic or musical works,
- Sound recordings, films or broadcasts and
- The typographical arrangement of published editions.

Literary work also includes:

- A table or compilation other than a database,
- A computer program,
- Preparatory design material for a computer program and
- A database.

Dramatic work includes a work of dance or mime. Musical work means any work consisting of music but excludes the words and music of songs.

3.3 Rights granted by Copyright

Copyright grants certain rights that are exclusive to its owner. Based on these rights, the copyright owner

- Can copy the work
- Issue copies of the work to the public
- Rent or lend the work to the public
- Perform, show or play the work in public
- Communicate the work to the public – this includes broadcasting of a work and also electronic transmission and make an adaptation of the work or do any of the above in relation to an adaptation

Copyright can subsist separately and collectively in the building blocks of any particular work. For example, the elements that constitute a website may include the web page, title, sound effects, images or pictures on the page and the address or domain name. Apart from a copyright on the web site, each of these building blocks grants separate rights to their owners.

3.4 Copyright Ownership - Who owns what in a Copyright Work?

Copyright ownership can arise automatically or by means of transfer of ownership through an assignment, assignation or license.

3.5 Copyright Owner

The first owner of copyright in a work is the person who created the work. Joint ownership may arise where more than one author is involved in creating a work.

3.6 Copyright Ownership in Computer Generated Works

In the case of computer generated works, the creator is the person by whom the arrangement necessary for the creation of the work is undertaken.

3.7 Copyright Ownership in an Employer-Employee Relationship

Copyright of works created during the course of employment will be owned by the employer unless an agreement to the contrary is in place. Additionally, copyright ownership is also dependent on the question of whether the work in question was produced during the course of employment.

3.8 Ownership of Copyright by Staff

Copyright ownership of works created by Further Education (FE) and Higher Education (HE) staff is principally dependent on the question whether the creation of the work was within the scope of his/her job specification. The rule applies irrespective of the question whether the staff had used the employer's resources to produce the work and whether the work in question was produced during the office hours of the staff. This issue has great significance within FE and HE. Many academics in the institutes produce content in the form of articles and other publications during office hours whilst using the equipment of the institution. In some cases, their primary job specification may only relate to their teaching or lecturing function. Here, the reality is that FE and HE institutes have by convention, expressly or impliedly, waived their copyright in materials produced out-with the remit of the academics job specification. The rationale of this may be is that allowing the academic to retain copyright in the work he or she is encouraged to produce more material thus raising the profile of the institution. It can also be observed that one of the common deliverables currently included in the job specification of most academic staff is to raise the research profile of FE or HE institutes through publications in journals. It is also worth pointing out that academics often give their copyright to academic journals and their institutions pay for subscriptions to the journals that may contain articles, which in law is the first owner.

3.9 Copyright Ownership in Collaborative Research

In the case of collaborative research partnership between FE and HE institutes and an outside partner copyright ownership can be held jointly. It is often the case that an agreement regulates this partnership and so ownership rights are distinguishable.

3.10 Copyright Ownership by Students

Relationship between students and FE and HE institutes are based on a special type of contract. These agreements are the various terms and conditions in the documentation (e.g. prospectus) that passes between them. In the absence of special terms and conditions in these documentations, copyright ownership in a work created by the student normally rests with the student. FE or HE institutes would therefore be better protected if it were to state in the prospectus or student handbooks that it may own copyright in certain works created (e.g. databases, software, and thesis publications) by the students. A feasible option so that both FE or HE institutes and its students reap mutual benefits from this collaboration would be to allow the student to retain ownership in his work and be compensated by means of a reward or income and the FE or HE institute to have the rights to use the work (e.g. to publish the work or to use it as a teaching material).

3.11 Duration of Copyright Protection

The duration of copyright is dependent on the type of work in question. Given below are examples of some works.

- **Literary, Dramatic, Musical and Artistic Works:** The life time of the author plus a period of 70 years from the end of the year in which the author dies.
- **Computer generated works:** 50 years from the date of creation of the work. A work is deemed to be computer generated where there is “no human author”.
- **Sound recordings:** 50 years from the end of year in which it was made or published.
- **Broadcasts**– 50 years from the end of the year of broadcast.
- **Typographical arrangement of published editions:** 25 years from the year of first publication.

3.12 Infringement of Copyright

Copyright is said to be infringed when one of the exclusive rights of an author is performed by a party without the consent or authorisation of the author. This infringement is called primary infringement. Providing accessories for infringing the exclusive rights or assisting in the making or distribution of infringing copies is also treated as an infringement and is referred to as secondary infringement.

3.13 Library Uses

The making of copies from books in libraries by its users (staff or students) is fair dealing only if it is made for research or private study for non-commercial purposes. This would require the user to sign a copyright declaration form.

3.14 How to file a Copyright Application?

- Classify Work
- Determine Ownership
- Identify Appropriate Form
- Complete Registration Form
- Comply with Deposit Requirements
- Payment of Fee

Note: List of forms for filling Industrial Designs are given in Annexure-2.

The details of Copy Right Office are:

B-2/W-3, Curzon Road Barracks

Kasturba Gandhi Marg

New Delhi-110001

Phone:91-113382549

91 -11 338 4687

TRADE MARKS

Trade marks have been defined as any sign, or any combination of signs capable of distinguishing the goods or services of one undertaking from those of other undertakings. Such distinguishing marks constitute protectable subject matter under the provisions of the TRIPS Agreement. The Agreement provides that initial registration and each renewal of registration shall be for a term of not less than 7 years and the registration shall be renewable indefinitely. Compulsory licensing of trade marks is not permitted.

Keeping in view the changes in trade and commercial practices, globalisation of trade, need for simplification and harmonisation of trade marks registration systems etc., a comprehensive review of the Trade and Merchandise Marks Act, 1958 was made and a Bill to repeal and replace the 1958 Act has been passed by Parliament and notified in the Gazette on 30.12.1999. This Act not only makes Trade Marks Law compatible with TRIPS Agreement but also harmonises it with international systems and practices. Work is underway to bring the law into force.

GEOGRAPHICAL INDICATIONS

The TRIPS Agreement contains a general obligation that parties shall provide the legal means for interested parties to prevent the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good. There is no obligation under the Agreement to protect geographical indications which are not protected in their country of origin or which have fallen into disuse in that country.

A new law for the protection of geographical indications, viz. the Geographical Indications of Goods (Registration and the Protection) Act, 1999 has also been

passed by the Parliament and notified on 30.12.1999 and the rules made there-under notified on 8-3-2002.

5.1 Documents required for filing Geographical Indications

An application for registration of a geographical indication is to be made in writing using a replica of the official application Form GI-1 for the registration of a Geographical Indication in Part A of the Register by an Indian applicant; Form GI-2 for a convention application; an application for goods falling in different classes by an Indian applicant in Form GI-3 and an application for registration of goods falling in different classes from a convention country in Form GI-4 along with prescribed fee, and should be addressed to the "Registrar of Geographical Indications".

5.2 Additional Requirements

Application in prescribed forms (submitted to The Registrar of Geographical Indications)

- How the indication serves to designate the goods as a Geographical Indication?
- The class of goods;
- The territory;
- The particulars of appearance;
- Particulars of producers;
- An affidavit of how the applicant claims to represent the interest;
- The standard bench mark or other characteristics of the geographical indication;
- The particulars of special characteristics;
- Textual description of the proposed boundary;
- The growth attributes in relation to the G.I. pertinent to the application;
- Certified copies of the map of the territory;
- Special human skill involved, if any;

- Number of producers; and
- Particulars of inspection structures, if any, to regulate the use of geographical indication.

INDUSTRIAL DESIGNS

Obligations envisaged to patent industrial designs that are independently created designs and are new or original. Individual governments have been given the option to exclude from protection, designs dictated by technical or functional considerations, as against aesthetic consideration which constitutes the coverage of industrial designs. The right accruing to the right holder is the right to prevent third parties not having his consent from making, selling or importing articles being or embodying a design, which is a copy or substantially a copy of the protected design when such acts are undertaken for commercial purposes. The duration of protection is to be not less than 10 years.

A new Designs Law repealing and replacing the Designs Act, 1911 has been passed by Parliament in the Budget Session, 2000. This Act has been come into force from 11.5.2001.

6.1. Documents Required

- A signed Power of Attorney in front of 2 witnesses;
- Sets of figures or photographs in color or black and white, preferably of various views of the complete article;
- A certified copy of the priority document showing the filing date, number and country, if priority is to be claimed.

6.2. Steps involved in Registration of Designs

- Finding out whether any registration already exists
- Preparing a representation of the design
- Identifying the class of design

- Providing a statement of novelty
- Including a disclaimer
- Claiming a priority date
- Determining the fee to be paid
- Ensuring all enclosures are attaché

LAYOUT DESIGN OF INTEGRATED CIRCUIT

Three dimensional disposition of the elements – at least one of which is active and of some or all of the interconnections of an integrated circuit, or such a three dimensional disposition prepared for an integrated circuit intended for manufacture.

A product in its final or intermediate form in which the elements, at least one of which is active, and some or all of the interconnections are integrally formed in or on a piece of material, and the purpose of this is to perform an electronic function.

PLANT VARIETY

A plant grouping within a single botanical taxon of the lowest known rank which, irrespective of whether the conditions for the grant of a Breeders Right are fully met, can be defined by the expression of the characteristics resulting from a given genotype or a combination of genotypes distinguished from any other plant grouping, by the expression of at least one of the said characteristics, and considered as units with regard to its suitability for being propagated without change.

8.1 Plant Breeder

The person, who breeds, discovers or develops a new plant variety.

8.2 New Plant Varieties and TRIPS Agreement

Like Patent, Copyright, Trademark and Industrial Design protection a special protection for new Plant varieties is available. This provision is lesser known by many people. The International Union for the Protection of New Plant Varieties (UPOV) and the TRIPS Agreement provide this protection. The Act of UPOV Convention in 1991 gave this important protection to the plant breeders. The UPOV office is situated in Geneva and it coordinates the Protection of New Plant species. There is a debate in many countries that the plants developed do not satisfy the non-obvious requirement in a patent application system as existing techniques are used and the new breed is obvious. Therefore, a unique “sui generis” system is utilized for the Protection of New Plant Varieties. The TRIPS provides a protection for 25 years in case of trees and vines while the protection for other plants is 20 years. The main aim of this article is to create awareness in the less known area of Protection of New Plant Varieties.

The Indian Parliament has finally passed the Plant Variety Protection and Farmers Rights Act, 2001. India has put in place a law to grant Plant Breeders Rights on new varieties of seeds, for the very first time. It has simultaneously provided a Farmers Right. This legislation was necessitated by the commitments that India made in the agreement on Trade Related Intellectual Property Rights (TRIPS) when it ratified the Uruguay GATT Round in 1994. Article 27. 3(b) of TRIPS which deals with the protection of new plant varieties offers three options. Protection will have to be granted by a patent, an effective sui generis system or by a combination of the two. The sui generis system refers to the grant of Plant Breeders Rights, of what kind is not defined, except to say that it should be "effective". India ultimately opted for the sui generis option but not without a determined struggle by civil society to stop seed patents.

INTERNATIONAL PATENTING

9.1 Need for International Patenting

An Indian patent provides the owners with exclusionary rights for the exploitation and for taking benefits of the patent for its term. Thus, an India's patent owner can preclude others from making, using or selling the claimed invention in India and its territories. But the Indian patent does not grant rights outside India, nor does it curtail “**infringing**” activities abroad. Protection of the invention outside India requires the applicant to file a written description of the invention, relevant drawings, support documents, and required fees with the patent office in the foreign jurisdiction where protection is sought. Filing can be done directly with a national patent office or under the **Patent Cooperation Treaty (PCT)**. If protection is sought only in Europe, one application can be filed before the European Patent Office (EPO).

9.2 Patent Cooperation Treaty ("PCT") (1970)

The Treaty makes it possible to seek patent protection for an invention related to industrial property simultaneously in each of a large number of countries by filing an "**international**" patent application. Such an application may be filed by anyone who is a national or resident of a Contracting State. It may generally be filed with the national patent office of the Contracting State of which the applicant is a national or resident or, at the applicant's option, with the International Bureau of WIPO in Geneva. If the applicant is a national or resident of a Contracting State which is party to the European Patent Convention, the Harare Protocol on Patents and Industrial Designs (Harare Protocol), the revised Bangui Agreement Relating to the Creation of an African Intellectual Property Organization or the Eurasian Patent Convention, the international application may also be filed with the European Patent Office (EPO), the African Regional Industrial Property

Organization (ARIPO), the African Intellectual Property Organization (OAPI) or the Eurasian Patent Office (EAPO), respectively.

The international application is then subjected to what is called an "**international search.**" That search is carried out by one of the major patent offices appointed by the PCT Assembly as an International Searching Authority (ISA). The said search results in an "**international search report,**" that is, a listing of the citations of such published documents that might affect the patentability of the invention claimed in the international application. At the same time, the ISA prepares a written opinion on patentability. The international search report and the written opinion are communicated by the ISA to the applicant who may decide to withdraw his application, in particular where the said report or opinion makes the granting of patents unlikely. If the international application is not withdrawn, it is, together with the international search report, published by the International Bureau.

9.3 General Information Concerning US Patents

A U.S. patent for an invention is the grant of a property right to the inventor(s), issued by the U.S. Patent and Trademark Office. The right conferred by the patent grant is, in the language of the statute and of the grant itself, "**the right to exclude others from making, using, offering for sale, or selling**" the invention in the United States or "**importing**" the invention into the United States. To get a U.S. patent, an application must be filed in the U.S. Patent and Trademark Office.

Generally, the term of a new patent is 20 years from the date on which the application for the patent was filed in the United States or, in special cases, from the date an earlier related application was filed, subject to the payment of maintenance fees. U.S. patent grants are effective only within the United States, U.S. territories, and U.S. possessions. Under certain circumstances, patent term extensions or adjustments may be available.

The Constitution of the United States gives Congress the power to enact laws relating to patents, in Article I, section 8, which reads “Congress shall have 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.” Under this power Congress has from time to time enacted various laws relating to patents. The first patent law was enacted in 1790. The patent laws underwent a general revision which was enacted July 19, 1952, and which came into effect January 1, 1953. It is codified in Title 35, United States Code. Additionally, on November 29, 1999, Congress enacted the American Inventors Protection Act of 1999 (AIPA), which further revised the patent laws. See Public Law 106-113, 113 Stat. 1501 (1999).

Most inventors employ the services of registered **patent attorneys or patent agents**. The law gives the USPTO the power to make rules and regulations governing conduct and the recognition of patent attorneys and agents to practice before the USPTO. Persons who are not recognized by the USPTO for this practice are not permitted by law to represent inventors before the USPTO.

Utility Patent

Utility patents may be granted to anyone who invents or discovers any new and useful process, machine, article of manufacture, or compositions of matters, or any new useful improvement thereof.

Design Patent

Design patents may be granted to anyone who invents a new, original, and ornamental design for an article of manufacture.

Plant Patent

Plant patents may be granted to anyone who invents or discovers and asexually reproduces any distinct.

Provisional Application for a Patent

Since June 8, 1995, the USPTO has offered inventors the option of filing a provisional application for patent which was designed to provide a lower cost first patent filing in the United States and to give U.S. applicants parity with foreign applicants. Claims and oath or declaration are NOT required for a provisional application. Provisional application provides the means to establish an early effective filing date in a patent application and permits the term “Patent Pending” to be applied in connection with the invention. Provisional applications may not be filed for design inventions.

The filing date of a provisional application is the date on which a written description of the invention, and drawings if necessary, are received in the USPTO. To be complete, a provisional application must also include the filing fee, and a cover sheet specifying that the application is a provisional application for patent. The applicant would then have up to 12 months to file a non-provisional application for patent as described above. The claimed subject matter in the later filed non-provisional application is entitled to the benefit of the filing date of the provisional application if it has support in the provisional application. If a provisional application is not filed in English, and a non-provisional application is filed claiming benefit to the provisional application, a translation of the provisional application will be required. See title 37, Code of Federal Regulations, Section 1.78(a)(5).

Provisional applications are NOT examined on their merits. A provisional application will become abandoned by the operation of law 12 months from its filing date. The 12-month pendency for a provisional application is not counted toward the 20-year term of a patent granted on a subsequently filed non-provisional application which claims benefit of the filing date of the provisional application.

A surcharge is required for filing the basic filing fee or the cover sheet on a date later than the filing of the provisional application.

Filing, Search, and Examination Fees

Patent applications are subject to the payment of a basic fee and additional fees that include search fees, examination fees, and issue fees. These fees are due at the time of filing the application. Consult the USPTO Web site at <http://www.uspto.gov> for the current fees. Additional filing fees are due if there are more than 3 independent claims, more than 20 total claims, or if the total number of sheets of paper in the specification and claims is over 100. If the application contains multiple dependent claims, additional fees are required.

If the owner of the invention is a small entity, (an independent inventor, a small business concern or a non-profit organization), most fees are reduced by half if small entity status is claimed. If small entity status is desired and appropriate, applicants should file a written assertion of small entity status in addition to paying the small entity filing fee. The written assertion may be a simple statement on a transmittal letter such as "Applicant claims small entity status." Applicants claiming small entity status should make an investigation as to whether small entity status is appropriate before claiming such status.

Specification (Description and Claims)

The following order of arrangement should be observed in framing the application:

- (a) Application transmittal form.
- (b) Fee transmittal form.
- (c) Application Data Sheet.
- (d) Specification.
- (e) Drawings.
- (f) Executed Oath or declaration.

The specification should have the following sections, in order:

- (1) Title of the Invention.

- (2) Cross Reference to related applications (if any). (Related applications may be listed on an application data sheet, either instead of or together with being listed in the specification.)
- (3) Statement of federally sponsored research/development (if any).
- (4) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on a compact disc and an incorporation by reference of the material on the compact disc. The total number of compact disc including duplicates and the files on each compact disc shall be specified.
- (5) Background of the Invention.
- (6) Brief Summary of the Invention.
- (7) Brief description of the several views of the drawing (if any).
- (8) Detailed Description of the Invention.
- (9) A claim or claims.
- (10) Abstract of the disclosure.
- (11) Sequence listing (if any).

The specification must include a written description of the invention and of the manner and process of making and using it, and is required to be full, clear, concise, and exact terms as to enable any person skilled in the technological area to which the invention pertains, or with which it is most nearly connected, to make and use the same.

The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter, or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor for carrying out the invention must be set forth.

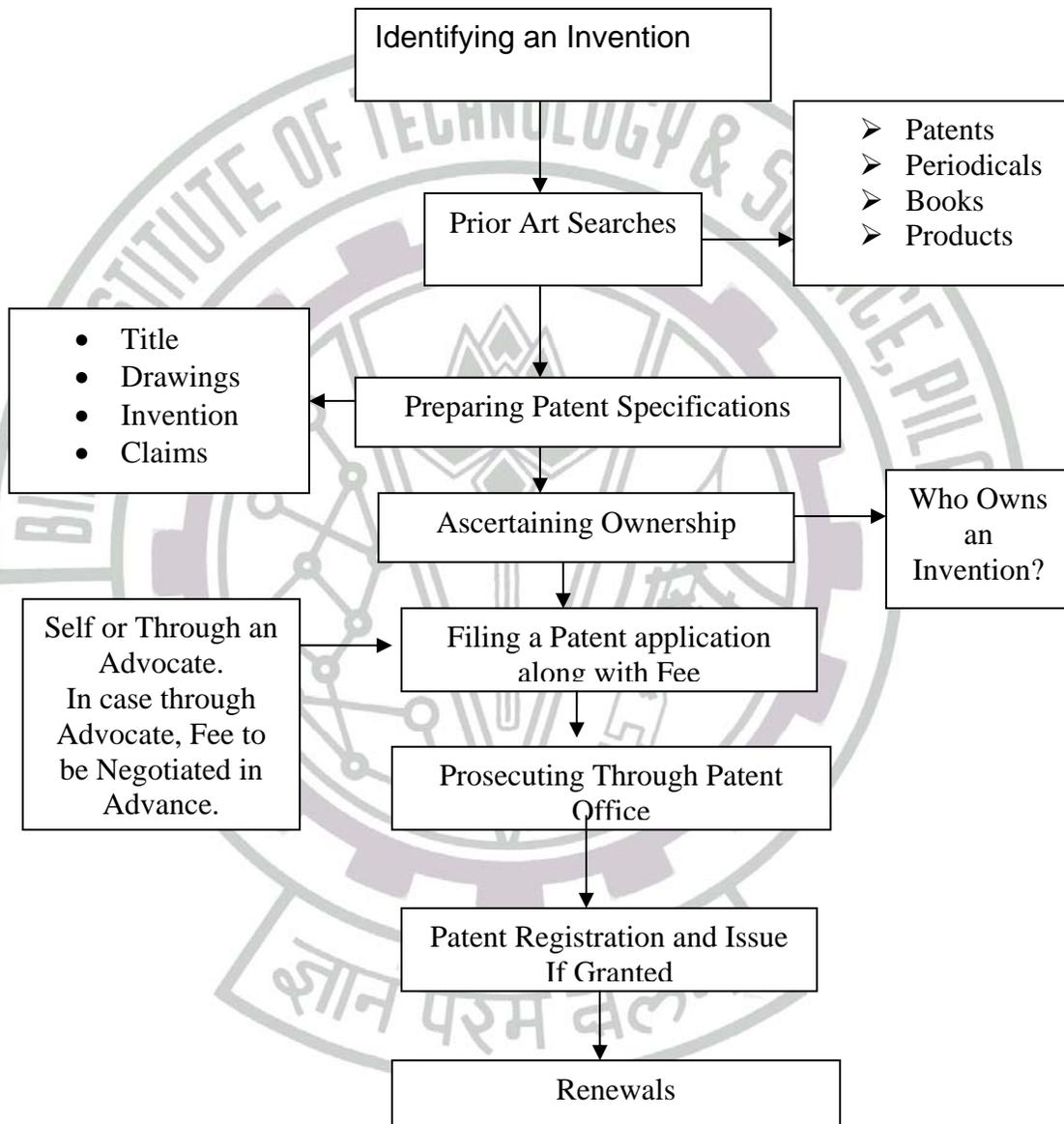
To sum up, this manual gives the need and importance of protecting intellectual property in present context of globalization. It attempts to create a greater awareness to know about various aspects of Intellectual Property Rights pertaining to Patents, Design, Trade mark, copyright, layout design of integrated circuits, trade secrets and geographical indications. The purpose is to direct research and scientific efforts that can result in benefits to the society and in particular to the innovator(s) by taking required steps at appropriate time to protect against any infringements. It also gives insight into procedures for filing IPR's in India. It provides a guideline to follow the steps meticulously to avoid any infringement.

To protect the innovative and creative work of an individual, it is mandatory to create a culture of IPR regime so as to derive full benefit from the investments made in research and developments.

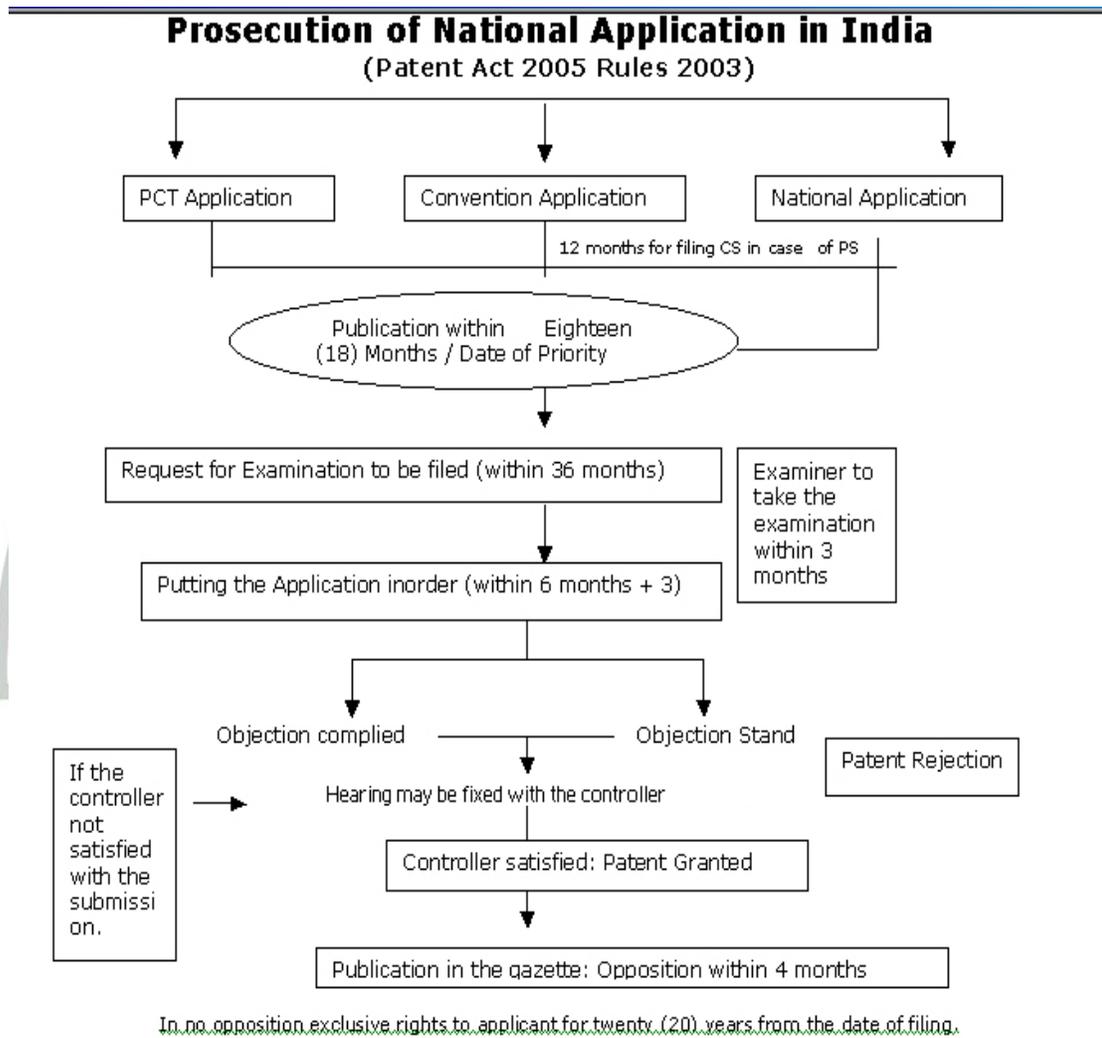
Note:

1. **Details of Intellectual Property Rights: Instruments, Subject Matter, Fields of Application and Related WIPO and Other International Agreements are given in Annexure-3.**
2. **List of web sites for more details on IPR are given in Annexure-4.**
3. **List of web sites to find out details of Patents are given in Annexure-5.**
4. **Some important definitions related to IPR are given in Annexure-6.**

THE PATENTING PROCESS



STAGES OF PROSECUTION OF IPR APPLICATION IN INDIA



Source: www.sristi.org/mdpipr2005/ppt/anilq/patent%20filling%20clubbed%20-final.ppt

Appendix -3

FEE PAYABLE FOR PATENT APPLICATION IN INDIA

		Form		natural person(s) either alone or jointly with natural person(s)
1.	2.	3.	4	5.
			Rupees	Rupees
1.	On application for a patent under sections 7, 54 or 135 and rule 20 (1) accompanied by provisional / complete specification -	1	1000 Multiple of 1000 in case of every multiple priority.	4,000 Multiple of 4,000 in case of every multiple priority
(i)	for each sheet of specification in addition to 30;		(i) 100	(i) 400
(ii)	for each claim in addition to 10.		(ii) 200	(ii) 800
2.	On filing complete specification after provisional upto 30 pages having upto 10 claims. -	2	No fee	No fee
(i)	for each sheet in addition to 30;		(i) 100	(i) 400
(ii)	for each claim in addition to 10.		(ii) 200	(ii) 800
3.	On filing a statement and undertaking under section 8.	3	No fee	No fee
4. (i)	On request for extension of time under sections 53(2) and 142(4), rules 13(6), 80(1A) and 130.	4	300 per month	1200 per month
4(ii)	On request for extension of time under section 21(1) and rule 24B(4)(ii).	4	(a) 1000 for first month (b) 2000 for second month (c) 3000 for third month	(a) 4000 for first month (b) 8000 for second month (c) 12000 for third month
5.	On filing a declaration as to inventorship under rule 13(6).	5	No fee	No fee
6.	On application for postdating.	-	500	2,000

7.	On application for deletion of reference under section 19(2).	-	500	2,000
8. (i)	On claim under section 20(1);	6	500	2,000
(ii)	On request for direction under section 20(4) or 20(5).	6	500	2,000
9.	On notice of opposition to grant of patent under section 25(3).	7	1,500	6,000
10.	On giving notice that hearing before Controller will be attended under rule 62(2).	-	1,500	6,000
11.	On application under sections 28(2), 28(3) or 28(7).	8	500	2,000
12.	Request for publication under section 11A(2) and rule 23B.	9	2,500	10,000
13.	On application under section 44 for amendment of patent.	10	1,500	6,000
14.	On application for directions under sections 51(1) or 51(2).	11	1,500	6,000
15.	On request for grant of a patent under section 26(1) and 52(2).	12	1,500	6,000
16.	On request for converting a patent of addition to an independent patent under section 55(1).	-	1,500	6,000
17.	For renewal of a patent under section 53: -			
(i)	before the expiration of the 2nd year from the date of patent in respect of 3rd year;	-	500	2,000
(ii)	before the expiration of the 3rd year in respect of the 4th year;	-	500	2,000
(iii)	before the expiration of the 4th year in respect of the 5th year;	-	500	2,000
(iv)	before the expiration of the 5th year in respect of the 6th year;	-	500	2,000
(v)	before the expiration of the 6th year in respect of the 7th year;	-	1,500	6,000
(vi)	before the expiration of the 7th year in respect of the 8th year;	-	1,500	6,000
(vii)	before the expiration of the 8th year in respect of the 9th year;	-	1,500	6,000
(viii)	before the expiration of the 9th year in respect of the 10th year;	-	1,500	6,000
(ix)	before the expiration of the 10th year in respect of the 11th year;	-	3,000	12,000
(x)	before the expiration of the 11 th year in respect of the 12th year;	-	3,000	12,000
(xi)	before the expiration of the 12th year in respect of the 13th year;	-	3,000	12,000

(xii)	before the expiration of the 13th year in respect of the 14th year;	-	3,000	12,000
(xiii)	before the expiration of 14 th year in respect of 15 th year;	-	3,000	12,000
(xiv)	before the expiration of 15 th year in respect of 16 th year;	-	5,000	20,000
(xv)	before the expiration of 16 th year in respect of 17 th year;	-	5,000	20,000
(xvi)	before the expiration of 17 th year in respect of 18 th year;	-	5,000	20,000
(xvii)	before the expiration of 18 th year in respect of 19 th year;	-	5,000	20,000
(xviii)	before the expiration of 19 th year in respect of 20 th year.	-	5,000	20,000
18.	On application for amendment of application for patent /complete specification/other related documents under section 57 -	13		
	(i) before grant of patent;		500	2,000
	(ii) after grant of patent;		1,000	4,000
	(iii) where amendment is for changing name /address /nationality/address for service.		200	800
19.	On notice of opposition to an application under sections 57(4), 61(1) and 87(2) or to surrender a patent under section 63(3) or to a request under section 78(5).	14	1,500	6,000
20.	On application for restoration of a patent under section 60.	15	1,500	6,000
21.	Additional fee for restoration.	-	3,000	12,000
22.	On notice of offer to surrender a patent under section 63.	-	1,000	4,000
23.	Application for withdrawing the application under section 11B(4) and rule 26(1).	-	1,000	4,000
24.	On application for the entry in the register of patent of the name of a person entitled to a patent or as a share or as a mortgage or as licensee or as otherwise or for the entry in the register of patents of notification of a document under sections 69(1) or 69(2) and rule 90(1), or 90(2).	16	1,000 (In respect of each patent)	4,000 (In respect of each patent)
25.	On application for alteration of an entry in the register of patents or	-	200	800

	register of patent agent under rule 94(1) or rule 118(1).			
26.	On request for entry of an additional address for service in the Register of Patents under rule 94(3).	-	500	2,000
27.	On application for compulsory license under sections 84(1), 91(1), 92(1) and 92A.	17	1,500	6,000
28.	On request for examination of application for patent - (a) under section 11B and rule 24(1); (b) under rule 20(4)(ii).	18	2,500 3,500	10,000 14,000
29.	On application for revocation of a patent under section 85(1).	19	1,500	6,000
30.	On application for revision of terms and conditions of licence under section 88(4).	20	1,500	6,000
31.	On request for termination of compulsory licence under section 94.	21	1,500	6,000
32.	On application for registration as a patent agent under rule 109(1) or 112.	22	2,000	-
33.	On request for appearing in the qualifying examination under rule 109(3).	-	1,000	-
34.	For continuance of the name of a person in the register of patent agent -	-	-	-
(i)	For the 1st year to be paid along with registration;	-	500	-
(ii)	For every year excluding the 1st year to be paid on the 1st April in each year.	-	500	-
35.	On application for duplicate certificate of patent agent under rule 111A.	-	1,000	-
36.	On application for restoration of the name of a person in the register of patent agents under rule 117(1).	23	1,000 (Plus continuation fee under entry number 36)	-
37.	On a request for correction of clerical error under section 78(2).	-	500	2,000
38.	On application for review or setting aside the decisions/ order of the controller under sections 77(1)(f) or 77(1)(g).	24	1,000	4,000

39.	On application for permission for applying patent outside India under section 39 and rule 71(1).	25	1,000	4,000
40.	On application for duplicate Patent under section 154, and rule 132.	-	1,000	4,000
41.	On request for certified copies under section 72 or for certificate under section 147, and rule 133.	-	1,000	4,000
42.	For certifying office copies, printed each.	-	500	2,000
43.	On request for inspection of register under section 72, inspection under rule 27 or rule 74A.	-	200	800
44.	On request for information under sections 127, 132 and 153; and rule 135.	-	300	1,200
45.	On form of authorization of patent agent.	26	No fee	No fee
46.	On petition not otherwise provided for.	-	1,000	4,000
47.	For supplying of photocopies of the documents per page.	-	4	4
48.	Transmittal fee for International application.	-	2,000	8,000
49.	For preparation of certified copy of priority document and for transmission of the same to the International Bureau of World Intellectual Property Organization.	-	1,000	4,000
50.	On statement regarding working of a patented invention on a commercial scale in India under section 146(2) and rule 131(1).	27	No fee	No fee

Note: All the Forms/Applications/Requests/Notice/Petitions shall be filed in duplicate unless otherwise specified in the rules.

Important List of Forms for IPR

Form 1	<u>Application for grant of patent</u>
Form 2	<u>Provisional / Complete specification</u>
Form 3	<u>Statement and undertaking under section 8</u>
Form 4	<u>Request for extension of time</u>
Form 5	<u>Declaration as to Inventor ship</u>
Form 6	<u>Claim or request regarding any change in applicant for patent</u>
Form 7	<u>Notice of opposition</u>
Form 8	<u>Request or claim regarding mention of inventor as such in a patent</u>
Form 9	<u>Request for publication</u>
Form 10	<u>Application for amendment of patent</u>
Form 11	<u>Application for direction of the controller</u>
Form 12	<u>Request for grant patent under section 26(1) & 52(2)</u>
Form 13	<u>Application for amendment of the application for patent / complete specification</u>
Form 14	<u>Notice of opposition to amendment / restoration / surrender of patent / grant of compulsory license or revision of terms thereof or to correction of clerical errors</u>
Form 15	<u>Application for the restoration of patent</u>
Form 16	<u>Application for registration of title / interest in a patent or share in it or registration of any document purporting to affect proprietorship of the patent</u>
Form 17	<u>Application for compulsory licence</u>
Form 18	<u>Request / express request for examination of application of patent</u>
Form 19	<u>Application for revocation of a patent for non working</u>
Form 20	<u>Application for revision of terms and conditions of licence</u>
Form 21	<u>Request for termination of compulsory licence</u>
Form 22	<u>Application for registration of patent agent</u>
Form 23	<u>Application for the restoration of the name in the register of patent agents</u>
Form 24	<u>Application for review / setting aside controller's decision / order</u>
Form 25	<u>Request for permission for making patent application outside India</u>
Form 26	<u>Form for authorisation of a patent agent / or any person in a matter of proceeding under the act</u>
Form 27	<u>Statement regarding the working of the patented invention on commercial scale in India</u>
	<u>3rd Schedule : Form of patent</u>
	<u>4th Schedule :- Fee structure</u>



Some Examples of patents

MULTI COLOUR CHALK

Application 2205/CHE/2006 published 2006-12-15, filed 2006-11-29

The newly Invented MULTI COLOUR CHALKS are very new concept which writes both side in two different colour and it is very novel in look. Since these chalks are produced in a very simple tiny device with up graded mechanical process 3 to 4 time higher production are achieved in a low cost, without causing much hard ship to employees. These chalks are hygienic in nature as it emits less dust or no dust at all, these chalk does not soil hands hence it is user friendly. To all Educational Institutions, there is great potential and a wide scope in International Market for export which shall bring in Foreign exchange to our country. Further this new concept shall create large number of employment in our country.

Applicant

A. CHANDRASHEKAR
NO. 177/26, 1ST FLOOR, 4TH MAIN ROAD, INDUSTRIAL TOWN ,, RAJAJINAGAR,
BANGALORE-560 044., INDIA.

International Info

Classification: C09D 1/00

"Methods and kits for diagnosing tumorigenicity and determining resistance to the antineoplastic effects of antiestrogen therapy"

Application 78/CHENP/2004 published 2005-12-09, filed 2004-01-13

Methods and kits for diagnosing tumorigenicity and for determining whether a cancer patient is resistant to the pharmacological effects of antiestrogen therapy. Increased levels of the PCDGF (GP88) growth factor are indicative of tumorigenicity and resistance to the pharmacological effects of antiestrogen therapy. The methods and kits of the invention are useful for assessing the tumorigenicity of a biological sample from a patient and determining whether the patient is a candidate for antiestrogen, including tamoxifen, therapy.

Applicant

A & G PHARMACEUTICALS, INC
600 E. Lombard Street, Suite 509, Baltimore, MD 21202, a US company, USA

Inventor

International Info - Classification: A61B

Publication Number: PCT/US02/18549

A QUEOUS EMULSION FUELS FROM PETROLEUM RESIDUUMBASED FUEL OILS.

Application 316/MUMNP/2004 A PCT/US99/08492 published , filed 2004-05-26

An aqueous macroemulsion to be used in place of petroleum residuum-based fuel oils such as No. 4, No. 5, and No. 6 fuel oils, as well as the vacuum residuum from the fraction distillation of petroleum, is formed by emulsifying the fuel oil with water or an aqueous liquid, the fuel oil

forming the dispersed phase and the aqueous liquid forming the continuous phase. An emulsion stabilizer, and optionally various other additives, notably a lower alkyl alcohol, are included to stabilize the properties of the emulsion. The emulsion is prepared by heating the fuel oil, particularly No. 6 fuel oil, and the water to a temperature above about 60 DEG C, and combining the two heated liquids in an appropriate ratio and shearing the mixture to form the macroemulsion. The macroemulsion offers numerous advantages over the fuel oil itself including the fact that it can be pumped at ambient temperature rather than requiring heating, and that it is a clean-burning fuel with significantly lower emission of NOx and other pollutants and contaminants.

Applicant

A-55, INC.
5270NEIL ROAD,RENO, NEVADA 89502, U.S.A.

Inventor

GUNNERMAN RUDOLF.

International Info

Classification: C 10 L 1/32
Publication Number:

Source : Big Patents India <http://india.bigpatents.org/view/38165/3392fb93729>

BASMATI

CASE NUMBER: 493

CASE MNEMONIC: Basmati

CASE NAME: India-US Basmati Rice Dispute

Patent number 5663484

In late 1997, an American company RiceTec Inc, was granted a patent by the US patent office to call the aromatic rice grown outside India 'Basmati'. RiceTec Inc, had been trying to enter the international Basmati market with brands like 'Kasmati' and 'Texmati' described as Basmati-type rice with minimal success. However, with the Basmati patent rights, RiceTec will now be able to not only call its aromatic rice Basmati within the US, but also label it Basmati for its exports. This has grave repercussions for India and Pakistan because not only will India lose out on the 45,000 tonne US import market, which forms 10 percent of the total Basmati exports, but also its position in crucial markets like the European Union, the United Kingdom, Middle East and West Asia. In addition, the patent on Basmati is believed to be a violation of the fundamental fact that the long grain aromatic rice grown only in Punjab, Haryana, and Uttar Pradesh is called Basmati. According to sources from the Indian Newspaper, Economic Times, "Patenting Basmati in the US is like snatching away our history and culture."

Basmati rice means the "*queen of fragrance or the perfumed one.*" This type of rice has been grown in the foothills of the Himalayas for thousands of years. Its perfumy, nut-like flavor and

aroma can be attributed to the fact that the grain is aged to decrease its moisture content. Basmati, a long-grained rice with a fine texture is the costliest rice in the world and has been favored by emperors and praised by poets for hundreds of years. According to the Agricultural and Processed Food Products Export Development Authority (APEDA), India is the second largest producer of rice after China, and grows over a tenth of the world's wheat. In 1993, Basmati rice attracted the highest premium because it is a very-long grained rice, with an aroma of its own which enhances the flavors its mixed with.

RiceTec Inc, was issued the Patent number **5663484** on Basmati rice lines and grains on September 2, 1997.

In abstract, "the invention relates to novel rice lines and to plants and grains of these lines. The invention also relates to a novel means for determining the cooking and starch properties of rice grains and its use in identifying desirable rice lines. Specifically, one aspect of the invention relates to novel rice lines whose plants are semi-dwarf in stature, substantially photoperiod insensitive and high yielding, and produce rice grains having characteristics similar or superior to those of good quality Basmati rice. Another aspect of the invention relates to novel rice lines produced from novel rice lines. The invention provides a method for breeding these novel lines. A third aspect...relates to the finding that the starch index (SI) of a rice grain can predict the grain's cooking and starch properties, to a method based thereon for identifying grains that can be cooked to the firmness of traditional Basmati rice preparations, and to the use of this method in selecting desirable segregants in rice breeding programs."

Rice is an important aspect of life in the Southeast and other parts of Asia. For centuries, it has been the cornerstone of their food and culture. During this period, farming communities throughout the region developed, nurtured, and conserved over a hundred thousand distinct varieties of rice to suit different tastes and needs. It is for this reason that patenting of Basmati by RiceTec Inc. is perceived as not only intellectual property and cultural theft, but it also directly threatens farm communities in Southeast Asia. According to Dr Vandana Shiva, director of a Delhi-based research foundation which monitors issues involving patents and biopiracy, the main aim for obtaining the patent by RiceTec Inc. is to fool the consumers in believing there is no difference between spurious Basmati and real Basmati. Moreover, she claims the *"theft involved in the Basmati patent is, therefore, threefold: a theft of collective intellectual and biodiversity heritage on Indian farmers, a theft from Indian traders and exporters whose markets are being stolen by RiceTec Inc., and finally a deception of consumers since RiceTec is using a stolen name Basmati for rice which are derived from Indian rice but not grown in India, and hence are not the same quality."*

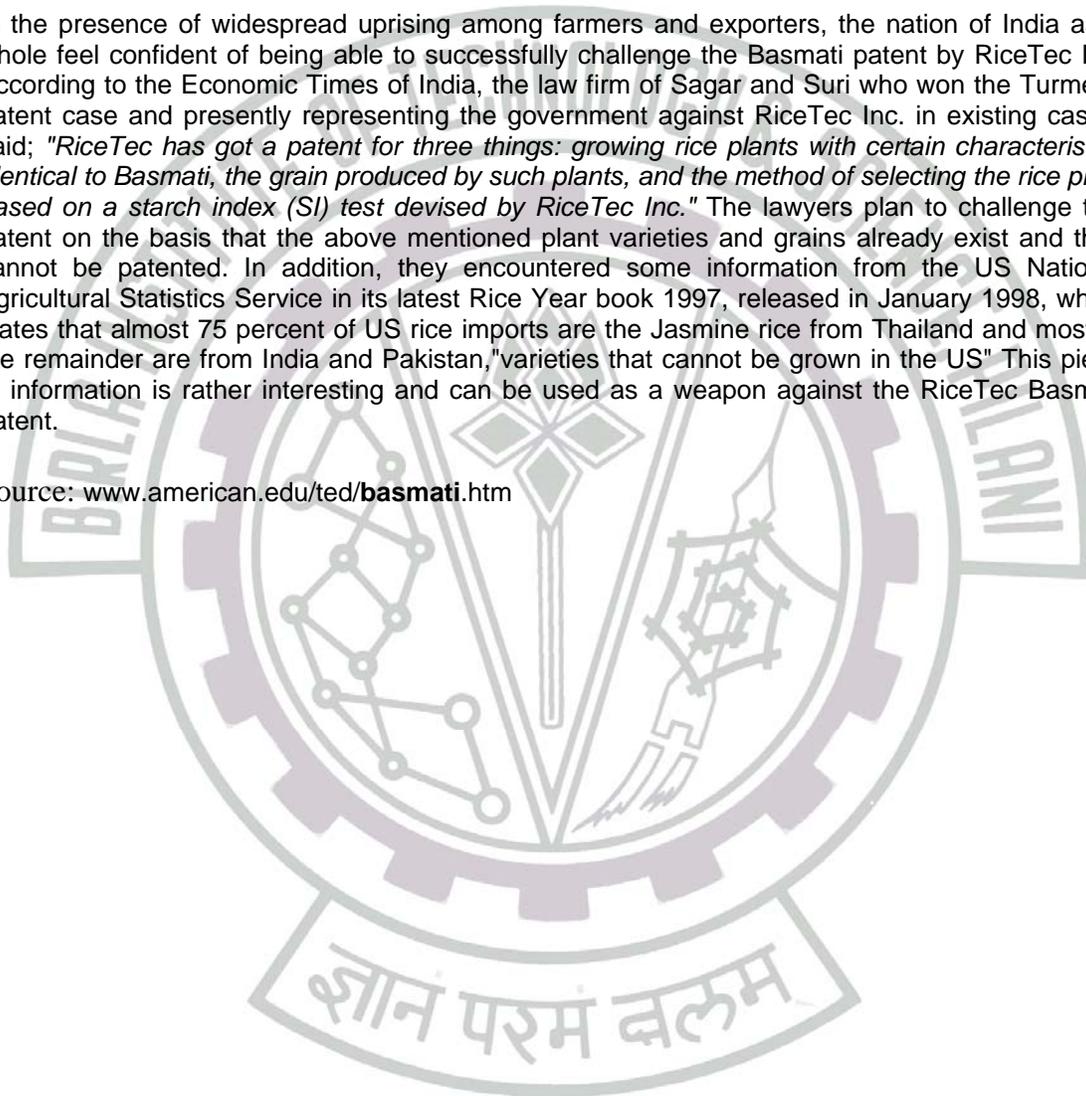
In fact, Basmati rice has been one of the fastest growing export items from India in recent years. In the year to March 1997, India exported more than half a million tonnes of Basmati to the Gulf, Saudi Arabia, Europe and the United States, a small part of its total rice exports, but high in value. More substantively, Indian farmers export \$250 million in Basmati every year and U.S. is a target market. RiceTec Inc. had attempted to sell its long-grain rice in Europe under such brand names as 'Texmati' and 'Kasmati' but not as Basmati. However, if the patent is not revoked, RiceTec Inc., can now sell its rice under the brand name Basmati which will definitely cut into India's and Pakistan's global market share, especially as the rice grown in the US could be sold cheaper than the Indian and Pakistani varieties.

In an official release, the government of India reacted immediately after learning of the Basmati patent issued to RiceTec Inc., stating that it would approach the US patent office and urge them to re-examine the patent to a United States firm to grow and sell rice under the Basmati brand name in order to protect India's interests, particularly those of growers and exporters. Furthermore, a high level inter-ministerial group comprising of *representatives of the ministries and departments of commerce, industry, external affairs, Council for scientific and industrial research (CSIR), Agriculture, Bio-technology, All India Rice Exporters Association (AIREA), APEDA, and Indian Council of Agricultural Research (ICAR)* were mobilized to begin an in-depth examination of the case. The contents and implications of the patent are currently being analyzed

in consultation with patent attorneys and agricultural scientists. The government of India is particularly concerned about the patenting of Basmati because of an earlier case where the US granted a patent to two Indian-born scientists on the use of Turmeric as a wound healing agent. This case worked in favor of India because the patent was subsequently revoked after scientists of (CSIR) successfully challenged the patenting on the ground that the healing properties of Turmeric had been 'common knowledge' in India for centuries. There is a clause in US patent laws that will accept any information already available in published or written form anywhere in the world as 'common knowledge'. As a result, India was able to furnish published evidence to support their case that the healing characteristics of Turmeric are not a new invention and as such cannot be patented.

In the presence of widespread uprising among farmers and exporters, the nation of India as a whole feel confident of being able to successfully challenge the Basmati patent by RiceTec Inc. According to the Economic Times of India, the law firm of Sagar and Suri who won the Turmeric patent case and presently representing the government against RiceTec Inc. in existing cases, said; *"RiceTec has got a patent for three things: growing rice plants with certain characteristics identical to Basmati, the grain produced by such plants, and the method of selecting the rice plant based on a starch index (SI) test devised by RiceTec Inc."* The lawyers plan to challenge this patent on the basis that the above mentioned plant varieties and grains already exist and thus cannot be patented. In addition, they encountered some information from the US National Agricultural Statistics Service in its latest Rice Year book 1997, released in January 1998, which states that almost 75 percent of US rice imports are the Jasmine rice from Thailand and most of the remainder are from India and Pakistan, "varieties that cannot be grown in the US" This piece of information is rather interesting and can be used as a weapon against the RiceTec Basmati patent.

Source: www.american.edu/ted/basmati.htm



ANNEXURES

Annexure-1: Details of Forms for filing of Patent Application

Details of Form 1

<p align="center">FORM 1</p> <p align="center">THE PATENTS ACT 1970</p> <p align="center">(39 OF 1970)</p> <p align="center">&</p> <p align="center">The Patents Rules, 2003</p> <p align="center">APPLICATION FOR GRANT OF</p> <p align="center">PATENT</p> <p align="center">(See section 7,54 & 135 and rule 20 (1))</p>		<p align="center">(FOR OFFICE USE ONLY)</p> <p>Application No.:</p> <p>Filing Date:</p> <p>Amount of Fee Paid:</p> <p>CBR No.:</p> <p>Signature:</p>
1. APPLICANT		
Name	Nationality	Address
XYZ	Indian	Birla Institute of Technology and Science, Pilani-333031 Rajasthan, India
2. INVENTOR (S)		
Name	Nationality	Address
Inventor's name	Indian	Permanent Address
	Indian	
3. TITLE OF THE INVENTION Title to be added		

4. ADDRESS FOR CORRESPONDENCE OF APPLICANT / AUTHORIZED PATENT AGENT IN INDIA		Telephone No. : Fax No. Mobile No. E-mail :		
5. PRIORITY PARTICULARS OF THE APPLICATION (S) FILED IN CONVENTION COUNTRY				
Country	Application Number	Filing Date	Name of the Applicant	Title of the Invention
N.A.				
6. PARTICULARS FOR FILING PATENT COOPERATION TREATY (PCT) NATIONAL PHASE				
International application number			N.A.	
9. DECLARATIONS :				
(i) Declaration by the Inventor (s)				
I/We, the above named inventor(s) am/are the true & first inventor(s) for this invention and declare that the applicant(s) herein is my/ our assignee.				
(a) Date				
(b) Signature (s) Signature				
(c) Name(s) Inventor's name				
(a) Date				
(b) Signature (s) Signature				
(c) Name(s) Inventor's name				
(ii) Declaration by the applicant (s) in the convention country				
I/We, the applicant(s) in the convention country declare that the applicant(s) herein is our assignee				
(a) Date				
(b) Signature (s) N.A.				
(c) Name(s) of the signatory				
(a) Date				

(b) Signature (s) **N.A.**

(c) Name(s) of the signatory)

(iii) Declaration by the applicant (s):

I/We, the applicant(s) hereby declare that:

- I/ We am/are in possession of the above – mentioned invention.
- The provisional/complete specification relating to the invention is filed with this application.
- The invention as disclosed in the specification uses the biological material from India and the necessary permission from the competent authority shall be submitted by me/us before the grant of patent to me/us.
- There is no lawful ground of objection to the grant of the Patent to me/us.
- I am/We are the assignees or legal representatives of true & first inventor(s).
- The application or each of the applications, particulars of which are given in Para – 5 was first application in convention country/countries in respect of my/our invention.
- I/We claim the priority from the above mentioned application(s) filed in convention country/countries and state that no application for protection in respect of the invention had been made in a convention country before that date by me/us or by any person from which I/we derive the title.
- My/our application in India is based on international application under Patent Cooperation Treaty (PCT) as mentioned in Para – 6.
- The application is derived out of my/our application particulars of which are given in Para – 7 and pray that this application may be treated as deemed to have been filed on _____ under sec. 16 of the Act.
- The said invention is an improvement on or modification of the invention particulars of which are given in Para – 8

10. Following are the attachments with the application:

- (a) Complete specification.
- (b) Complete specification (in conformation with the international application) / as amended before the International Preliminary Examination Authority (IPEA), as applicable (2 copies).
No. of pages 263 No. of claims 215
- (c) Drawings (in conformation with the international application) / as amended before the International Preliminary Examination Authority (IPEA), as applicable (2 copies). No. of sheets 11
- (d) Priority documents
- (e) Translation of priority document / specification/ International Search Report
- (f) Statement and undertaking on Form 3
- (g) Power of Authority
- (h) Declaration of inventorship on Form 5
- (i) Sequence listing in electronic form (floppy disc)
- (j) Fee Rs.in Cash/Cheque/Bank Draft bearing no.
Date on Bank.

I/We hereby declare that to the best of my/our knowledge, information and belief the facts and matters stated herein are correct and I/we request that a patent may be granted to me/us for the said invention.

Dated this day of

Signature :-

Name :

To,
The Controller of Patent
The Patent Office

Ordinary Application (S.7)

An application for patent made in the Patent Office without claiming any priority of application made in a convention country or without any reference to other application under process in the office is called an Ordinary Application.

Convention Application (S.135)

When an applicant comes to the patent office with an application claiming a priority date based on a similar application filed in one of the convention countries, it is called a Convention Application (By virtue of Paris Convention). To get a convention status an applicant should file the application in Indian Patents Office within twelve months from the date of first filing of a similar application in the

convention country. The priority document **(S.138 (1))** and its English translation (if required) **(S.138 (2))** also should be submitted by the applicant. A convention application should be accompanied by a complete specification. When two or more applications for patents constituting one invention have been made in one or more convention countries, one application may be made within twelve months from the date on which the earlier or earliest of those applications was made. **Multiple fees have to be remitted for multiple priorities** so that the other applications filed earlier in the convention countries will be deemed to have been published in India. Applicant of convention application shall furnish, when required by the Controller, copies of specification or documents **(priority documents)** certified by the official chief of the Patents Office of the convention country. If any such specification or document is in a foreign language, a translation into English of the specification or document shall be furnished.

PCT International Application PCT is an international filing system for patents in which the applicant gains an international filing date in all the designated countries conferring the late entry

(up to 31 months) to the national offices without affecting the priority date. This is a simple and economical procedure for those applicants seeking protection for the inventions in many countries. Indian Patent Office is a receiving office for

international applications by nationals or residents of India. *An international application shall be filed with the appropriate office in triplicate in respect of head office and quadruplicate in respect of branch offices, either in English or in Hindi language (Rule19(1)).*

PCT-National Phase Application (S.7 (1)(A))

An international application **(S.2 (1) (ia))** made according to Patent Cooperation Treaty **(S.2 (1) (oa))** designating India can enter national phase within 31 months from the international filing date. This application filed before the Controller in the Indian Patents Office claiming the priority and international filing date is called PCT National Phase Application. Applicant can enter national phase with a request made on white paper. But Form 1A is preferred by the Indian Patents office during National Phase Entry. The title, description, drawings, abstract and claims filed with the application shall be taken as the complete specification for the purposes of filing in India (S.10 (4A) (i)). The filing date of the application...shall be the international filing date accorded under the Patent Cooperation Treaty (S. 10(4A) It is not mandatory for the applicant to submit the documents while entering the national phase for filing the application in the designated or elected member countries, as it is obligatory on the part of WIPO to send those things to the designated offices. However for convenience and faster processing the applicant may submit the necessary documents. Office may ask for any other documents, which are necessary in addition to what was submitted along with the application.

Application for Patent of Addition (S.54)

When an applicant feels that he has an invention, which is a slight modification on the invention for which he has already applied for/has patent in India, the he can go for a Patent of Addition. The only benefit he gets is that there is no need to pay separate renewal fee for the Patent of Addition during the term of the main patent. Patent of Addition expires along with the main patent unless it is made independent, according to the provisions in **S.54**. The Complete Specification of that application shall include specific reference to the number of the main patent or the application for the main patent, as the case may be, and a definite

statement that the invention comprises an improvement on, or a modification of the invention claimed in the specification of the main patent granted or applied for.

FORM 3
THE PATENT ACT, 1970
(39 OF 1970)
&
The Patents Rules, 2003
STATEMENT AND UNDERTAKING UNDER SECTION 8
(See section 8, rule 12)

We Birla Institute of Technology and Science, Pilani hereby declare

(i) that /we who have made this application No. Dated alone, made for the same/substantially same invention, application(s) for patent in the other countries, the particulars of which are given below :

Name of the country	Date of Application	Application No.	Status of the application	Date of publication	Date of grant
---------------------	---------------------	-----------------	---------------------------	---------------------	---------------

Not
Applicable

(iii) that the rights in the application(s) have been assigned to us and that we undertake that upto the date of grant of the patent, by the Controller, we would keep him informed in writing of the details regarding corresponding applications for patents filed outside India within three months from the date of filing of such application.

Dated this day of September

FOR BIRLA INSTITUTE OF TECHNOLOGY AND SCIENCE, PILANI

To,

The Controller of Patent

The Patent Office

Sec 8 Rule 12 Information and undertaking regarding foreign applications

Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file along with his application or within three months from the date of filing .(U/S 8(1),U/R 12(1A)). Application for Patent should also be accompanied by a statement and undertaking in Form 3. If there is no foreign filing, the applicant can give NIL statement. As per the amended Act the time period for filing Form 3 can be allowed by the Controller. It shall contain (a) Statement setting out detailed particulars of such application including the name of the country, application number and status of such application; and. (b) An undertaking that, up to the date of the grant of his complete specification filed in India, the applicant would keep the Controller informed in writing, from time to time, of the detailed particulars as required under clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequent to the filing of the statement referred to in the aforesaid clause, within three months of such filing (U/R12(1A)2),U/S 8(1)). At any time after an application for patent is filed in India and till the grant of patent or refusal to grant of patent is made thereon, the Controller may also require the applicant to furnish details as may be prescribed relating to the processing of the application in a country outside India, and in that event the applicant shall furnish information available to him to the Controller within three months from the date of receipt of the communication requiring such furnishing of information. In case of delay in furnishing the details beyond three months, the applicant can rectify the same by seeking extension of time in prevalent form along with a petition under rule 138.

FORM 2

**THE PATENTS ACT, 1970
(39 of 1970)**

**PROVISIONAL / COMPLETE SPECIFICATION
(See section 10 and rule 13)**

1. TITLE OF THE INVENTION	
2. APPLICANT(S) (a) NAME (b) NATIONALITY (c) ADDRESS	
3. PREAMBLE TO THE DESCRIPTION	
PROVISIONAL The following specification describes the invention	COMPLETE The following specification particularly describes the invention and the manner in which it is to be performed
4. DESCRIPTION (Description shall start from next page)	
5. CLAIMS (not applicable for provisional specification. Claims should start with the preamble – “I/We claim” on separate page)	
6. DATE AND SIGNATURE (to be given on the last page of specification)	
7. ABSTRACT OF THE INVENTION (to be given along with complete specification on a separate page)	
Note: *Repeat boxes in case of more than one entry *To be signed by the applicant(s) or the authorized registered patent agent *Name of the applicant should be given in full, family name in the beginning *Complete address of the applicant should be given, stating postal index no. / code, state and country *Strike out the columns which is/are not applicable	

FORM 5
THE PATENT ACT, 1970
(39 OF 1970)
&
The Patents Rules, 2003
DECLARATION AS TO INVENTORSHIP
[See section 10(6) and rule 13(6)]

1. NAME OF APPLICANT (S)

hereby declare that the true and first inventor(s) of the invention disclosed in the complete specification filed in pursuance of my / our application numbered **1075/MUM/2004** filed on 10 October 2004 are

2. INVENTOR (S)

- a. Name:
- b. Address:
- c. Indian National
- d.

- a. Name:
- b. Address:
- c. Indian National

Dated this day of

Signature :-

3. DECLARATION TO BE GIVEN WHEN THE APPLICATION IN INDIA IS FILED BY THE APPLICANT (S) IN THE CONVENTION COUNTRY:-

Dated this day of

Signature :-

FORM-19
THE PATENT ACT, 1970
(39 of 1970)

REQUEST FOR EXAMINATION OF APPLICATION FOR PATENT
[See section 11B; rule 24(1)]

1. We, a) **Birla Institute of Technology and Science, Pilani** b) having its administrative Office at Pilani 333031, State of Rajasthan, India and c) an autonomous educational institute established in India as “Deemed to be a University” by notification published in the Gazette of India dated the 27th June, 1964, the Ministry of Education, government of India, hereby request that our provisional/complete application for patent No ___/ filed on _____ for the invention “_____” shall be examined under sections 12 and 13 of the Act.

2. Our address for service in India is

Birla Institute of Technology & Science
PILANI – 333 031 (Rajasthan)

Dated _____ day of _____,

To

The Controller of Patents
The Patents Office,
Government of India,
Boudhik Sampada Bhavan,
Plot No. 32, Sector-14, Dwarka
New Delhi – 110075
Tel.: 28081920 - 25

Annexure-2: List of Forms for filing Industrial Designs

Form No.	Section or Rule	Title
<u>1</u>	Sections 5 and 44	Application for registration of design/Application under reciprocal arrangement.
<u>2</u>	Section 8(1)	Claim to proceed as an applicant or joint applicant.
<u>3</u>	Section 11(2)	Application for Extension of copyright.
<u>4</u>	Section 12(2)	Application for Restoration of lapsed design
<u>5</u>	Section 17(1)	Inspection of registered design
<u>6</u>	Section 18	Request for information when registration number is given.
<u>7</u>	Section 18	Request for information when registration number is not given.
<u>8</u>	Section 19	Petition to cancel registration of design.
<u>9</u>	Section 21	Notice of intended exhibition or publication of unregistered design.
<u>10.</u>	Section 30(3)	Application for registration of a document in the Register Design.
<u>11</u>	Section 30	Application for entry of name of proprietor or part proprietor in the Register
<u>12</u>	Section 30	Application for entry of mortgage or license in the Register.

<u>13.</u>	Section 30 and rule 37	Application for entry of notification of a document in the Register.
<u>14</u>	Section 29	Request for correction of clerical error.
<u>15</u>	Section 26 and rule 41	Request for certificate.
<u>16</u>	Section 17(2)	Application for certified copy of registered design.
<u>17</u>	Section 31	Application for rectification of Register.
<u>18</u>	rule 15	Application for extension of time for filing priority document.
<u>19</u>	rule 40	Notice of opposition.
<u>20</u>	rules 29 and 40	Notice of intention to attend hearing.
<u>21</u>	Section 43	Power of authority to agents.
<u>22</u>	rule 31	Request to alter name or address or address for service in Register
<u>23</u>	Section 10	Request for entries of two addresses in the Register

Annexure- 3

Intellectual Property Rights: Instruments, Subject Matter, Fields of Application and Related WIPO and Other International Agreements

Type of Intellectual Property Rights		Subject Matter	Main Fields of Application	Major International Agreement
Types of Instrument				
Industrial Property	Patents	New, non-obvious, industrially applicable inventions	Manufacturing	Paris Convention; Patent Cooperation Treaty; Budapest Treaty
	Utility models		Manufacturing	Paris Convention;
	Industrial Designs	Functional designs Ornamental designs	Clothing, motor cars, electronics and others	Hague Agreements; Paris Convention; Locarno Agreement
	Trademarks	Signs or symbols to distinguish the goods and services of one enterprise from those of others.	All industries	Paris Conventions; Madrid Agreement (international registration); Nice Agreement; Madrid Protocol (not yet in force); Trademark law Treaty (not yet in force)
	Geographical indications	Identification of the place of origin of goods indicative of the quality or other characteristics associated with the area	Agriculture and food industries, notably the sectors for wine and spirits.	Lisbon Agreement, Madrid Agreement (false indications)
Literary and artistic property	Copyrights: and neighboring rights.	Original works of authorships and related contributions from performers, producers of sound recordings, and broadcasting organizations.	Printing, entertainment (audio, video, motion pictures) software, broadcasting	Berne Convention; Rome Convention; Geneva Convention; Brussels Convention; Universal Copyright Convention

Sui generis protection	Breeders' rights	New, stable, homogeneous, distinctive varieties	Agriculture and food industry	Union for the Protection of New Varieties of Plants (UPOV)
	Integrated circuits	Original layout designs	Micro-electronics industry	Washington Treaty (not yet in force)
	Trade secrets	Secret business information	All industries	

Source; Carlos Braga, "Trade-Related Aspects of Intellectual Property Rights: The Uruguay Round Agreement and Its Economics Implications*" (World Bank Conferences paper, 26-27 January 1995).

Note: With the exception of UPOV, all treaties identified above are administered by WIPO. The Washington Treaty, not yet in force, has also been negotiated under WIPO auspices. The Rome Convention is administered jointly by WIPO, ILO and UNESCO. The Universal Copyright Convention is administered by UNESCO.



Annexure-4: List of Web Sites for more details on IPR

1. www.IPWatchdog.com
2. www.IPLawportal.com
3. www.wto.org
4. [www.esa.int/Specials/Intellectual Property Rights](http://www.esa.int/Specials/Intellectual_Property_Rights)
5. www.indianpatents.org.in
6. www.ipindia.nic.in
7. www.tifac.org.in
8. www.patentoffice.nic.in
9. www.uspto.gov
10. www.patent.gov.uk
11. www.sristi.org/mdpir2005/ppt/anilg/patent%20filling%20clubbed%20-final.ppt
12. Patent Cooperation Treaty (PCT) 1970 www.wipo.int/pct/
13. General Information concerning US Patents – <http://www.uspto.gov>

Annexure-5: List of Web Sites to find out details of Patents

Patent Sites in India

1. <http://www.nii.res.in/patentind.html>
2. <http://patinfo.nic.in/main.php>

Patent Site for Major Countries

1. <http://members.pcug.org.au/rossco/patentsearching.htm>
2. <http://www.ipmenu.com/patentresources.htm>

Annexure-6: Some Important Definitions Related to IPR

Utility Patent: A [patent](#) issued for inventions that perform useful functions. Most inventions fall into this category. A utility patent lasts for 20 years from the patent application's filing date.

Design Patent: A [patent](#) issued on a new design, used for purely aesthetic reasons, that does not affect the functioning of the underlying device. Design patents last for 14 years from the date the patent is issued. For example, the unique flaring fender designs appearing on new model trucks to make them look sportier are non-functional industrial designs that may qualify for design patents.

Plant Patent: A plant patent is a patent issued for newly invented strains of asexually reproducing plants. Tuber propagated plants or wild uncultivated plants may not be patented.

Absolute Novelty: An invention that possesses the quality of absolute novelty was not publicly known, was not sold or offered for sale (publicly or secretly) and was not made available to the public anywhere in any way prior to some critical date. Absolute novelty is not required for an invention to be patentable in the U.S., but if an invention does possess this quality, it definitely meets the novelty requirements of U.S. patent law. For this reason, Patent Partner uses the concept of absolute novelty as defined above to simplify the U.S. patentability evaluation. If an invention is not absolutely novel, then each actual novelty rule, all of which are more complex than the concept of absolute novelty, must be tested. For the purposes of this evaluation, the "critical date" in the U.S. is the earlier of the date of invention or the U.S. filing date.

Relative Novelty : In some countries, such as the [United States](#) and [Japan](#), a grace period exists for protecting an [inventor](#) or the [successor in title](#) from a publication of the invention before the [filing date](#). That is, if the inventor or the successor in title publishes the invention, an application can still be validly filed which will be considered novel despite the publication, provided that the filing is made during the grace period following the publication. The grace period is usually 6 or 12 months. This type of novelty bar is sometimes known as a **relative novelty** bar.

Local Novelty: Local novelty (as is currently the requirement in [New Zealand](#)) only regards publications, uses or sales that have taken place within that jurisdiction to be novelty destroying.

Provisional Application for Patent Filing : The provisional application must be made in the name(s) of all of the inventor(s). It can be filed up to 12 months following the date of first sale, offer for sale, public use, or publication of the

invention. (These pre-filing disclosures, although protected in the United States, may preclude patenting in foreign countries.)

Regular Patent application: Once a provisional application is filed, the inventor has one year to file a regular patent application claiming benefit of the provisional. If a regular patent application is not filed in this year, the provisional application will simply expire. The only purpose of the provisional application is to allow a regular application to "claim the benefit" of the provisional application. This means that the regular application will be treated in some circumstances as if it were filed on the filing date of the provisional application. Early filing dates may prove useful in helping to prove who the first inventor of an invention was. In addition, early filing dates can help avoid losing patent rights through loss of novelty. In addition to the early filing date, provisional applications are useful to extend the duration of a patent. The duration of a patent is twenty years from the filing date of the regular application. Since the filing date of the provisional application is not used to determine the expiration date, it is possible to extend the duration to twenty-one years from the first filing by filing a regular application one year after the provisional application.

Period of Copyright:

- a. If published within the life time of the author of a literary work the term is for the life time of the author plus 60 years.
- b. For cinematography films, records, photographs, posthumous publications, anonymous' publication, works of government and international agencies the term is 60 years from the beginning of the calendar year following the year in which the work was published.
- c. For broadcasting the term is 25 years from the beginning of the calendar year following the year, in which the broadcast was made.

Notice of Copyright: Use of the notice may be important because it informs the public that the work is protected by copyright, identifies the copyright owner, and shows the year of first publication. Furthermore, in the event that a work is infringed, if a proper notice of copyright appears on the published copy or copies to which a defendant in a copyright infringement suit had access, then no weight shall be given to such a defendant's interposition of a defense based on innocent infringement in mitigation of actual or statutory damages. Innocent infringement occurs when the infringer did not realize that the work was protected.

What can be protected as a trademark?

- names (such as company names, product names)
- domain names if they label a product or service
- images
- symbols
- logos

- slogans or phrases
- colors
- product design
- product packaging (known as trade dress)

How to Denote a Trademark? The appropriate trademark symbol (TM for product mark; SM for service mark; or ® to denote a registered trademark or service mark) should be used with the first or most prominent appearance of the Avocent Trademark in text, and need not be used again in the document so long as the reader clearly has notice from the first use.

