



## Legal Provisions of Patenting In India

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### ABSTRACT

*Among all living creatures only man has effectively utilized his intellect in improving his standard of living right from Stone Age till today. Intellectual property is the property which has been created by exercise of intellectual faculty. India has a long world of protection of Intellectual property Rights through a system of well developed substantive laws and established legal and administrative practices. The importance of patent system for stimulating inventions, research and development of the country is well recognized in India. The progress and prosperity of a nation depends upon the level of scientific, industrial and technology development. Patent Act, 1970 is the main legislation on patent. The Act was amended by Amendment Act of 1999, 2002 and 2005 to incorporate the obligations of TRIPs.*

*The researcher in this paper has given an overview of the procedure for the grant of Patent. The paper also highlights some prominent features of the TRIPs Agreement which have now been incorporated into our domestic legislation. These features include scope of patentability, patent eligibility and patent prosecution.*

### KEYWORDS :

### Introduction

The system of granting patents in India is governed by the Patents Act, 1970 which contains elaborate invention provisions for the protection of invention as well as prevention of abuse or misuse of patent right. The main objective of the Indian Patent Act is to encourage inventions and secure the working of inventions in India on a commercial scale and to secure that patents are not granted merely to enable patentee to enjoy monopoly for the importation of patented article. After the Amendment of 2005 the Patent Act, 1970 clearly states as to what is patentable and what is non-patentable in India. The Act defines the term 'invention as "new product or process involving an inventive step, capable of industrial application."<sup>2</sup> It further says that invention should not be obvious to a person skilled in the state of art.<sup>3</sup> It also defines the term new 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 filling 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.<sup>4</sup> Thus, patents are granted to inventions that satisfy statutory requirements of novelty, inventive step and industrial application.

### Patent Eligibility

Patent eligibility means the subject matter that is open to patenting. In addition to the above mentioned statutory criteria, a patent will only be granted where the invention is patentable. Section 3 (a)<sup>5</sup> clearly states that "an invention which is frivolous or which claims anything obviously contrary to well established natural laws" is not an invention, hence not patentable, similarly an invention, the primary or intended use of which would be contrary to law or morality or injurious to public health, is not patentable under sanction 3 (b)<sup>6</sup>. Article 27(2) of TRIPs Agreement also contains the same ground. This exception is not limited to security reason but also extends to protection of human, animal or plant life or health and may also extend to protection of human, animal or plant life or health and may also be applied to the inventions that may lead to serious prejudice to the environment.

Section 3(e) of the Act provides that a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components or a process for producing such substance is not patentable. If the result obtained by invention is more than might be expected from a mere mixture, the invention is patentable. Life as it exists in the nature is not patentable but if any new form of life is created by human intervention, then it is patentable method of performing mental act and are not patentable, computer programmers are also not patentable.

If there is merely a new use of an old substance involving old integers without a working interrelationship producing a new or improved result or otherwise obvious on the face of specification it is excluded

from an invention. The Act provides, that, "mere arrangement or rearrangement or duplication of known devices each functioning independently of one another in a known way is not patentable."<sup>7</sup> The next clause includes method of agriculture or horticulture,<sup>8</sup> section 3(g) excludes any process for the medicinal, surgical, curative, prophylactic, diagnostic, and therapeutic or any other treatment of human beings or any process for a similar treatment of animals. Another important exclusion is a literary, dramatic, musical or artistic work or any other aesthetic creation including cinematographic works and television productions.<sup>9</sup> These things are subject matter of Copyright Act, 1957. Lastly, this section also deals with the concept of Traditional knowledge. Section 3(p) of the Act states that, an invention which is in effect, traditional knowledge or which is an aggregation or duplication of known projections of traditionally known components is not patentable. Thus patent eligibility sums up the concept of novelty i.e. only truly new inventors deserve patents.<sup>10</sup> Non obviousness is one of the essential requirements of patentability. The last requirement is the practical nature of patent law which requires that the invention should be something which can be used industrially or related to an industrial process. Thus any invention fulfilling the above essential elements of patentability and not falling within section 3 has to pass through a process of obtaining patent.

### Patent Prosecution

An application to obtain a patent is called patent prosecution. It consists of preparing and filling the patent application, filling response and amendments to the objection of patent examiner. Patent prosecution will result in either the issuance of a published patent or rejection or abandonment of application thus apart from the above requirements which are external in nature; a claimed invention should meet some internal requirements which are procedural in nature.

### Patent Application in India

An application to obtain patent in India should be filed at the appropriate patent office based on principal place of business<sup>11</sup> of the applicant. The second schedule to the Patent Act deals with the form through which application is to be made along with fees specified in the first schedule. An application should be confined to one invention only. Every application should be accompanied by a provisional or a complete specification. If the applicant has applied for invention, he shall file a statement along with application that shall not be open to public for a period of eighteen months from the date of filing or date of priority whichever is earlier.<sup>12</sup> Every application shall be published after the expiry of the period unless there are secrecy directions on publication of the specifications and drawings are made available to the public.<sup>13</sup> A request for publication is made on Form 9. Application for a patent will be examined unless the applicant or any other interested person objects but within thirty six months from the date of priority or from date of filing.<sup>14</sup> When a request for examination has been made in respect of an application for a patent under section

11-B, the application and specification and other documents will be referred by the controller to an examiner for making a report on the following matters.<sup>15</sup>

Whether the application and specification and other documents are in accordance with the Act.

Whether there is any lawful ground of objection to the grant of the patent.

The result of investigation made under Sec. 5(B). Anticipation by previous publication and prior claims etc.

On such examination a report is prepared and sent to the applicant along with the application and specification. The applicant then has to submit his reply to the above report within six months. Apart from domestic route, there is also an international route to apply for international patent.

### Patent Application under International Treaties

#### Paris Convention

The Paris Convention is an International treaty that dictates as to how and when foreign patent application must be filled to obtain maximum international benefits. Under the convention, if an inventor has filed a patent application in his home country, he then has one year from that application filing date, called the priority date to file application for foreign country i.e. in all other convention countries.<sup>16</sup> If the counterpart patent application is based on the same invention within that convention year, the other countries will recognize that priority date when applying their laws to that application. The convention also requires that each convention country must apply its laws equally to all patent application it receives whether the applicants are citizens of that country or are from another convention country.<sup>17</sup>

#### Patent Co-operation Treaty (PCT)

Application for the protection of inventions in any of the contracting states may be filled as international application under the Patent Co-operation Treaty (PCT). It is a procedural treaty for the grant of the patent. The treaty is a multilateral treaty that was concluded in Washington in 1970 and entered into force in 1978. It is administered by the International Bureau of the World Intellectual Property Organization (WIPO). The treaty has simplified the procedure for obtaining international patents. The PCT procedure begins with the filing of international application and ends with the grant of a number of national patents.

The PCT offers as a first stage a chance to make a single international application leading to an international search conducted by any international searching authorities. The procedure starts with the filling of an international application by the applicant consisting of the title of invention, designation of at least one contracting state, name and state of the applicant, name of inventor, choice of type of protection, and abstract description, claim, drawings, signature and a declaration that application be processed according the PCT.<sup>18</sup>

The filling of application is followed by processing by 'receiving office' and an international search report by the International Search Authority. It is then published along with the report and communicated by International Bureau of WIPO to the applicant for obtaining protection. There is a prescribed format for international application. This form is accepted by all designated offices for patent application, so that there is no need to comply with a great variety of widely different formal requirement in different countries in which protection is sought. On completion of the international phase, the file moves to each designated office. The applicant has to pay the required national fees. Every step in national phase is time bound failing which the application may cease. The designated offices examine the application and on examination may grant or refuse the national patent on the basis of its national laws. An international application filed under PCT (Patent Cooperation Treaty) designating India shall be deemed to be an application under the Patent Act if corresponding application has been filled before the Controller in India.<sup>19</sup> The receiving office, designated office and elected office for international application shall be appropriate office as required under Patent Rules.<sup>20</sup> An international application has to be filed in triplicate.<sup>21</sup> The title, description, draw-

ings and claims shall be treated as specification. The international filing date is the date accorded under the treaty.<sup>22</sup>

### Persons entitled to apply for patent

An application for patenting an invention must be made by any of the following persons.<sup>23</sup>

Any person claiming to be the true and first inventor of the invention.

Any person being the assignee of the person claiming to be the true and first inventor in respect of the invention has the right to make application.

By the legal representative of deceased person who immediately before his death was entitled to make such an application.

The true and first inventor is a person who first made the invention and applied for the same invention and neither has used the same invention and neither has disclosed it to the world. The one who applies first for the patent will be considered the true and first inventor.<sup>24</sup> A financial partner, firm or corporation do not have the capacity to invent, hence are not considered as applicant. However, the right to apply for a patent is assignable. Sec. 6 (1) (b) enable an assignee of the true and first inventor to apply for patent. In case of death of the inventor the legal Representative are entitled to apply for the grant of patent. Thus the true and first inventor files the application for the grant of patent in the prescribed form and manner.

### Patent Specification

Every application for a patent not being a convention application or an application under PCT must be accompanied by a provisional or complete specification.<sup>25</sup> The Patent Act of all countries has a provision requiring the inventor to disclose how to make the claimed invention and also to give a written description of the invention in the specification. The contract between the inventor and the state requires that the inventor discloses and describes his invention sufficiently. The purpose of specification is to convey to the public the complete description of the invention along with the monopoly that he intends to obtain. Thus it is the consideration which constitutes the quid pro quo for the grant of patent monopoly.

Specification of invention whether provisional or complete must be fully described in the invention. It must begin with a title sufficiently interpreting the subject matter of the invention.<sup>26</sup> It also states the object of the invention, summarizing proposals for solving the same problem and setting out the nature of the invention. It may also contain drawings in its application depicting the invention. In *Electric and Musical Industrial Ltd. v. Lissen Ltd.*<sup>27</sup> it was stated that the preamble to the body and the claims on one hand and remainder of the body on the other, have different functions. The body, apart from the preamble, is there to instruct those skilled in the art concerned in carrying out the invention. The claims on the other hand define monopoly.

### Kinds of Specification

Depending of the sufficiency of description, a specification may be either;

Provisional specification, or (b) Complete specification

#### Provisional specification

An applicant may file a provisional specification which need not be full and complete and need not contain the claims. The object of provisional specification is to fix the priority date of the patent. The whole process of patent grant is lengthy involving considerable lapse of time between the date when the inventor first makes his application and the date when his invention is exposed to the public on grant of patent. There may also be more than one application for the same invention within a short span of time in both domestic and different countries. Thus to settle competing applications the inventor has to furnish provisional specification along with the application to set the priority date. Where the claim in the complete specification is fairly based on the matter disclosed in the provisional specification, the priority date of that claim is the date of filing of provisional specification.<sup>28</sup> During the period between filling of provisional and complete specification, the applicant may conduct further research in his

invention and may improve upon the method of carrying out the invention or introduce further development which he may incorporate in the complete specification. The applicant gets a maximum period of twelve months from the filling of provisional specification within which to fill the complete specification

### Complete Specification

The grant of a patent is based on complete specification filed by the application. A monopoly for the use of an invention is granted under the Act in consideration of the disclosure of the invention to the public. After the statutory period of protection any member of the public is entitled to make use of the invention. The object and purpose of a specification is that it should enable not anybody, but reasonably well informed artisan dealing with a subject matter with which he is familiar, to make the thing, so as to make it available for the public at the end of the protected period.<sup>29</sup> A complete specification is filed within twelve months after provisional specification.<sup>30</sup> It should contain besides the title, the following:<sup>31</sup>

Full and particular description of the invention and its operation or use and the methods by which it is to be performed.

To disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection.

A claim defining the scope of invention for which protection is sought. The claim should relate to one invention, whether it is for process or product. It should be clear, succinct and based on the matter disclosed in the specification.

It should be accompanied by an abstract to provide technical information on the invention.<sup>32</sup>

Where after the grant of patent, any amendment of specification or any other document is allowed it will be deemed to form part of the specification for all purposes.<sup>33</sup> Thus a final application along with complete specification is now free for being processed if it does not face any opposition.

### Grant of Patent

The next step of patent prosecution is grant and sealing of patent. Where the period for filing notice of opposition has expired and the opposition, if any, has been finally decided in favour of the application, the patent will be granted to the applicant on request made for the purpose and the patent will be sealed and entered in the register.<sup>34</sup> The Patent (Amendment) Act, 2005 states that a patent shall be granted as expeditiously as possible to the applicant and after grant the controller shall publish the fact of patent grant whereupon the application, specification and other documents shall be open for publication inspection.<sup>35</sup> A patent will be granted in the prescribed form and shall have effect throughout India.<sup>36</sup> The patent will be dated as of the date on which application for patent was filed.<sup>37</sup> The date of the patent will be entered on the register of patents.<sup>38</sup> A patent is granted subject to the following condition:<sup>39</sup>

That the machine, article or process is respect of which the patent is granted may be used by any person for the purpose of experiment or research.

That the medicine or drug that is covered by the patent may be imported by the government for the purpose of its own use or distribution in a dispensary having regard to public service.

In respect of every patent granted after the commencement of the Patents (Amendment) Act 2002 i.e. 20<sup>th</sup> May, 2005 the term of every patent which has not expired and has not ceased to have effect, shall be twenty years from the date of filling of the application for patent.<sup>40</sup> The term of patent is the same in the case of international application filed under Patent Cooperation Treaty.

### Conclusion

The Trade Related Aspects of Intellectual Property Rights (TRIPs) Agreement has brought about drastic changes to The Patent Act, 1970. The Amendments of 1999, 2002 and 2005 have made the Patent Act TRIPs compliant by making some drastic changes as to scope

of patentability, allowing product patent, exceptions to patentability etc. The procedure for the grant of patent has been simplified. The applicant can even file an application through PCT route i.e. file an international application, go for an international search and if not opposed to by any person interested, patent may be granted. Thus the new era is for innovation. The companies undertaking Research and Development will hold the key to the growth process of the country. The post TRIPs scenario will be interesting to witness specially pertaining to the scope of patentability and its impact on exports, public health issues and access to medicines.

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