



Intellectual Property Rights

Awareness Training

November 2019
V1.0

Intellectual Property Rights

Contents

1. Introduction	4
2. The Concept of Intellectual Property.....	4
3. Evolution of Intellectual Property System in India	5
3.1 Patents Act, 1970	6
3.2 Trade Mark Act, 1999.....	6
3.3 The Designs Act, 2000	6
3.4 The Geographical Indications of Goods (Registration and Protection) Act, 1999	6
3.5 Copyright Act, 1957.....	7
3.6 The Semi Conductor Integrated Circuits Layout Design Act, 2000	7
4. Patent Cooperation Treaty (PCT)	7
5. Berne Convention for the Protection of Literary and Artistic Works	8
6. Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement.....	8
7. National Intellectual Property Rights (IPR) Policy.....	9
8. PATENTS.....	10
8.1 Patentability Criteria	10
8.2 Application for Patent.....	13
8.3 Form of Application	13
8.4 Specification.....	14
8.4.1 Provisional Specification	14
8.4.2 Complete Specification	15
8.5 Types of Patent Applications	15
8.6 Where to apply?.....	15
8.7 Procedure for Filing of a Patent Application.....	16
8.8 Contents of Patent Application.....	16
8.9 e-filing	17
8.10 Processing of Application.....	17
8.11 Publication of Application.....	18
8.12 Request for Examination.....	19
8.13 Search for Anticipation by Previous Publication and by Prior Claim	19
8.14 Opposition to the Patent	19
8.14.1 Pre Grant opposition.....	19

Intellectual Property Rights

8.14.2 Post Grant opposition	20
8.15 Grant of Patents.....	21
8.16 Term of Patent	21
8.17 Working of Patent.....	22
8.18 Ceasing a patent.....	22
8.19 Restoration of Lapsed Patents	22
8.20 Surrender of Patents.....	22
8.21 Revocation of patents	23
8.22 Assignments of Patents.....	23
8.23 Penalties under Patent Act	23
8.24 Compulsory Licensing	24
8.25 Transfer of Technology	24
9. International Applications.....	25
10. Patent Offices in India.....	26
11. Trademarks	26
12. Industrial Designs.....	27
13. Copyrights	27
14. Semiconductor IC Layout Design	28
15. References:	28
16. Online Training:.....	29

Intellectual Property Rights

1. Introduction

Over the past two decades, intellectual property rights have grown to a stature from where it plays a major role in the development of global economy. In the 1990s, many countries unilaterally strengthened their laws and regulations in this area. At the multilateral level, the successful conclusion of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) in the World Trade Organization enhanced the protection and enforcement of IPRs to the level of solemn international commitment.

The domain of intellectual property is vast. Copyrights, Patents, Trademarks and Designs are known to have received recognition for a long time. This study material provides an in-depth understanding to the trainees about the various forms of the intellectual property.

Intellectual property (IP) refers to the creations of the human mind like inventions, literary and artistic works, and symbols, names, images and designs used in commerce.

Intellectual property is divided into two categories:

Industrial property, which includes inventions (patents), trademarks, industrial designs, and geographic indications of source; and **copyright**, which includes literary and artistic works such as novels, poems and plays, films, musical works, artistic works such as drawings, paintings, photographs and sculptures, and architectural designs.

Rights related to copyright include those of performing artists in their performances, producers of phonograms in their recordings, and those of broadcasters in their radio and television programs.

Intellectual property rights protect the interests of creators by giving them property rights over their creations.

2. The Concept of Intellectual Property

The concept of intellectual property is not new as Renaissance northern Italy is thought to be the cradle of the Intellectual Property system.

The International Intellectual Property system also started to take shape with the setting up of the *Paris Convention for the Protection of Industrial Property in 1883* and the *Berne Convention for the Protection of Literary and Artistic Works in 1886*.

The Convention establishing the World Intellectual Property Organization (1967) gives the following list of the subject matter protected by intellectual property rights:

- literary, artistic and scientific works;
- performances of performing artists, phonograms, and broadcasts;
- inventions in all fields of human endeavor;
- scientific discoveries;
- industrial designs;
- trademarks, service marks, and commercial names and designations;
- protection against unfair competition; and

Intellectual Property Rights

- “all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields.”

With the establishment of the world trade Organization (WTO), the importance and role of the intellectual property protection has been crystallized in the *Trade-Related Intellectual Property Systems (TRIPS) Agreement*. It was negotiated at the *General Agreement on Tariffs and Trade (GATT) treaty in 1994*.

The TRIPS Agreement encompasses, in principle, all forms of intellectual property and aims at harmonizing and strengthening standards of protection and providing for effective enforcement at both national and international levels.

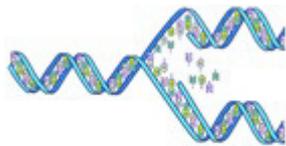
The *TRIPS Agreement, which came into effect on 1 January 1995*, is to date the most comprehensive multilateral agreement on intellectual property. The areas of intellectual property that it covers are:

- Copyright and related rights (i.e. the rights of performers, producers of sound recordings and broadcasting organisations);
- Trademarks including service marks;
- Geographical indications including appellations of origin;
- Industrial designs;
- Patents including protection of new varieties of plants;
- The lay-out designs (topographies) of integrated circuits;
- The undisclosed information including trade secrets and test data.

Few Examples of Intellectual Properties include:



Coca-Cola®



DNA replication



Apple® iPod®



Instant camera



Harry Potter

3. Evolution of Intellectual Property System in India

In India Patent Act was introduced in the year 1856 which remained in force for over 50 years, which was subsequently modified and amended and was called "*The Indian Patents and Designs Act, 1911*". After Independence a comprehensive bill on patent rights was enacted in the year 1970 and was called "*The Patents Act, 1970*".

With the establishment of WTO and India being signatory to the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), several new legislations were passed for the protection of intellectual property rights to meet the international obligations. These included: Trade Marks, called the **Trade Mark Act, 1999**; Designs Act, 1911 was replaced by the **Designs Act, 2000**; the Copyright Act, 1957 amended a number of times, the latest is called **Copyright (Amendment) Act, 2012**; and the latest amendments made to the

Intellectual Property Rights

Patents Act, 1970 in 2005. Besides, new legislations on geographical indications and plant varieties were also enacted. These are called **Geographical Indications of Goods (Registration and Protection) Act, 1999**, and **Protection of Plant Varieties and Farmers' Rights Act, 2001** respectively.

3.1 Patents Act, 1970

After India became a signatory to the TRIPS agreement forming part of the Agreement establishing the World Trade Organization (WTO) for the purpose of reduction of distortions and impediments to international trade and promotion of effective and adequate protection of intellectual property rights, the Patents Act, 1970 has been amended in the year 1995, 1999, 2002 and 2005 to meet its obligations under the TRIPS agreement. Thus, the Patent Amendment Act, 2005 is now fully in force and operative.

3.2 Trade Mark Act, 1999

The law of trademarks is also now modernized under the Trademarks Act of 1999. A trademark is a special symbol for distinguishing the goods offered for sale or otherwise put on the market by one trader from those of another.

The important salient features of the Act *inter-alia* include:

- It broadens the definition of infringement of a registered trademark to include action against the unauthorized use of a confusingly similar mark.
- An action for infringement will also be available against the unauthorised use of a mark in relation to dissimilar goods, if such mark is similar to a registered and the interest of the owner is likely to be affected adversely. The remedy for infringement of a trademark is also strengthened under the new law by authorising the police with the power to seize infringing articles without a warrant.

3.3 The Designs Act, 2000

The Designs Act of 1911 has been replaced by the *Designs Act, 2000*. In view of considerable progress made in the field of science and technology, a need was felt to provide more efficient legal system for the protection of industrial designs and to encourage design activity to promote the design element in an article of production.

Industrial Design law deals with the aesthetics or the original design of an industrial product. An industrial product usually contains elements of both art and craft, that is to say artistic as well as functional elements. The design law excludes from its purview the functioning features of an article and grants protection only to those which have an aesthetic appeal.

3.4 The Geographical Indications of Goods (Registration and Protection) Act, 1999

Under the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), there is no obligation for other countries to extend reciprocal protection unless a geographical indication is protected in the country of its origin. To cover up such situations it became

Intellectual Property Rights

necessary to have a comprehensive legislation for registration and for providing adequate protection to geographical indications and accordingly the Parliament has passed a legislation, namely, the ***Geographical indication of Goods (Registration and Protection) Act, 1999***. The legislation is administered through the Geographical Indication Registry under the overall charge of the Controller General of Patents, Designs and Trade Marks.

3.5 Copyright Act, 1957

Copyright in India is governed by ***Copyright Act, 1957***. As per this Act, copyright grants author's lifetime coverage plus 60 years after death. Copyright and related rights on cultural goods, products and services, arise from individual or collective creativity. ***All original intellectual creations expressed in a reproducible form will be connected as "works eligible for copyright protections"***. Copyright laws distinguish between different classes of works such as literary, artistic, musical works and sound recordings and cinematograph films.

Copyright protection also includes novel rights which involve the right to claim authorship of a work, and the right to oppose changes to it that could harm the creator's reputation. The creator or the owner of the copyright in a work, can enforce his right administratively and in the courts by inspection of premises for evidence of production or possession of illegally made "pirated" goods related to protected works. The owner may obtain court orders to stop such activities, as well as seek damages for loss of financial rewards and recognition.

A vital field which gets copyright protection is the computer industry. The Copyright Act, 1957, was amended in 1984 and computer programming was included with the definition of "literary work." The new definition of "computer programme" introduced in 1994, means a set of instructions expressed in works, codes or in any other form, including a machine readable medium, capable of causing a computer to perform a particular task or achieve a particular result.

3.6 The Semi Conductor Integrated Circuits Layout Design Act, 2000

The practice of providing protection through the methods of Copyright, Patents did not appropriately accommodate the requirements of Intellectual Property Rights protection for the Layout-Designs of Integrated Circuits. This was because of the fact that ***in the context of Layout Designs, the concept of "originality" is of utmost significance, whether it is a "novelty or not"***. While the Patent Law requires that the idea should be original as well as novel, the copyright law is too general to accommodate the original ideas of scientific creation of Layout-Designs of Integrated Circuits.

In view of the above, the necessity for providing protection for Layout-Designs of Integrated Circuits was felt to reward and encourage an adequate level of investment of human, financial and technological resources.

4. Patent Cooperation Treaty (PCT)

The Patent Cooperation Treaty makes it possible to seek patent protection for an invention simultaneously in each of a large number of countries by filing an international patent application. The application may be filed by anyone who is a national or resident of a

Intellectual Property Rights

contracting State, 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.

The advantages of PCT filing for the applicant, the patent offices and the general public are given below:

- (1) The applicant has up to 18 months more than in a procedure outside the PCT to reflect on the desirability of seeking protection in foreign countries,
- (2) to appoint local patent agents in each foreign country,
- (3) to prepare the necessary translations and to pay the national fees. The PCT filing assures the applicant that if his international application is in the form prescribed by the PCT, it cannot be rejected on formal grounds by any designated Office during the national phase of the processing of the application. On the basis of the international search report, the applicant can evaluate with reasonable probability the chances of his invention being patented.

5. Berne Convention for the Protection of Literary and Artistic Works

The three basic principles of the Convention are the following:

1. Works originating in one of the contracting States must be given the same protection in each of the other contracting States as the latter grants to the works of its own nationals.
2. Such protection must not be conditional upon compliance with any formality.
3. Such protection is independent of the existence of protection in the country of origin of the work. If, however, a contracting State provides for a longer term than the minimum prescribed by the Convention and the work ceases to be protected in the country of origin, protection may be denied once protection in the country of origin ceases.

6. Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement

With the establishment of the world trade Organization (WTO), the importance and role of the intellectual property protection has been crystallized in the Trade-Related Intellectual Property Systems (TRIPS) Agreement.

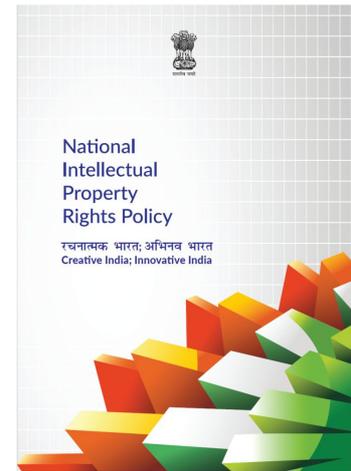
The TRIPS Agreement encompasses, in principle, all forms of intellectual property and aims at harmonizing and strengthening standards of protection and providing for effective enforcement at both national and international levels.

The TRIPS Agreement, which came into effect on 1 January 1995, is to date the most comprehensive multilateral agreement on intellectual property. The areas of intellectual property that it covers are:

- (i) Copyright and related rights (i.e. the rights of performers, producers of sound recordings and broadcasting organisations);
- (ii) Trademarks including service marks;
- (iii) Geographical indications including appellations of origin;

Intellectual Property Rights

- (iv) Industrial designs;
- (v) Patents including protection of new varieties of plants;
- (vi) The lay-out designs (topographies) of integrated circuits;
- (vii) The undisclosed information including trade secrets and test data.



7. National Intellectual Property Rights (IPR)

Policy

The National Intellectual Property Rights (IPR) Policy, approved by the Union Cabinet, is a giant leap by the Government of India to spur creativity and stimulate innovation. The document lays the roadmap for the future of IPRs in India.

The Department of Industrial Policy and Promotion (DIPP) is entrusted with matters concerning the specialised UN agency on IPRs, the World Intellectual Property Organisation (WIPO), including coordination with other concerned Ministries or Departments.

The *Controller General of Patents, Designs and Trade Marks (CGPDTM)* under the *Department of Industrial Policy and Promotion, Ministry of Commerce and Industry* is entrusted with the responsibility of administering the laws relating to Patents, Designs, Trade Marks and Geographical Indications within the territory of India.

VISION STATEMENT

An India where creativity and innovation are stimulated by Intellectual Property for the benefit of all; an India where intellectual property promotes advancement in science and technology, arts and culture, traditional knowledge and biodiversity resources; an India where knowledge is the main driver of development, and knowledge owned is transformed into knowledge shared.

MISSION STATEMENT

Stimulate a dynamic, vibrant and balanced intellectual property rights system in India to:

- foster creativity and innovation and thereby, promote entrepreneurship and enhance socio-economic and cultural development, and
- focus on enhancing access to healthcare, food security and environmental protection, among other sectors of vital social, economic and technological importance.

Objectives

The Policy lays down seven objectives which are elaborated with steps to be undertaken by the identified nodal Ministry/Department. The implementing or Nodal Ministry/Department shall coordinate with all other concerned stakeholders, including other Ministries/Departments, towards attaining the objectives.

1) **IPR Awareness: Outreach and Promotion** – To create public awareness about the economic, social and cultural benefits of IPRs among all sections of society.

“Creative India; Innovative India: रचनात्मक भारत; अभिनव भारत”

- 2) **Generation of IPRs** - To stimulate the generation of IPRs
- 3) **Legal and Legislative Framework** - To have strong and effective IPR laws, which balance the interests of rights owners with larger public interest.
- 4) **Administration and Management** - To modernize and strengthen service oriented IPR administration
- 5) **Commercialization of IPR** - Get value for IPRs through commercialization
- 6) **Enforcement and Adjudication** - To strengthen the enforcement and adjudicatory mechanisms for combating IPR infringements
- 7) **Human Capital Development** - To strengthen and expand human resources, institutions and capacities for teaching, training, research and skill building in IPRs

8. PATENTS

Generally speaking, patent is a monopoly grant and it enables the inventor to control the output and within the limits set by demand, the price of the patented products. Underlying economic and commercial justification for the patent system is that it acts as a stimulus to investment in the Industrial innovation.

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.

A patent is an official document given to an inventor by the government allowing him to exclude anyone else from commercially exploiting his invention for a limited period which is 20 years at present.

8.1 Patentability Criteria

The conditions of patentability are:

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

Novelty

A novel invention is one, which has not been disclosed, in the prior art where *prior art means everything that has been published, presented or otherwise disclosed to the public on the date of patent*. 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

Intellectual Property Rights

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'.

(a) An invention shall not be considered to be novel if it has been anticipated by publication before the date of the filing of the application in any of the specification filed in pursuance of application for patent in India on or after the 1st day of January 1912.

(b) An invention shall not be considered to be novel if it has been anticipated by publication made before the date of filing of the application in any of the documents in any country.

(c) An invention shall not be considered to be novel if it has been claimed in any claim of any other complete specification filed in India which is filed before the application but published after said application.

(d) An invention shall not be considered to be novel if it has been anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.

Inventive Step (Non-obviousness)

Inventive step is a feature of an invention that involves technical advance as compared to existing knowledge or having economic significance or both, making the invention non obvious to a person skilled in art.

For this purpose a “person skilled in the art” should be presumed to be an ordinary practitioner aware of what was general common knowledge in the relevant art at the relevant date. In some cases the person skilled in the art may be thought of as a group or team of persons rather than as a single person

Industrial Applicability

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

- can be made;
 - can be used in at least one field of activity;
 - can be reproduced with the same characteristics as many times as necessary.
- 1) An invention to be patentable must be useful. If the subject matter is devoid of utility it does not satisfy the requirement of invention.
 - 2) For the purpose of utility, the element of commercial or pecuniary success has no relation to the question of utility in patent law.
 - 3) The usefulness of an alleged invention depends not on whether by following the directions in the complete specification all the results not necessary for commercial success can be obtained, but on whether by such directions the effects that the application/patentee professed to produce could be obtained.
 - 4) The meaning of usefulness is therefore useful for the purpose indicated by the applicant or patentee whether a non-commercial utility is involved.

Intellectual Property Rights

- 5) The usefulness of the invention is to be judged, by the reference to the state of things at the date of filing of the patent application, if the invention was then useful, the fact that subsequent improvements have replaced the patented invention render it obsolete and commercially of no value, does not invalidate the patent.
- 6) Speculation or imaginary industrial uses are not considered to satisfy the industrial application requirement.

Non Patentable Subject Matter

An invention may satisfy the condition of novelty, inventiveness and usefulness but it may not qualify for a patent. The following are not inventions within the meaning of **Section 3 of the Patents Act, 1970**:

- (a) an invention which is *frivolous* or which claims anything obviously contrary to well established natural laws;
- (b) an invention the primary or intended use or commercial exploitation of which could be *contrary to public order or morality* or which causes serious prejudice to human, animal or plant life or health or to the environment;
- (c) the mere *discovery of a scientific principle* or the formulation of an abstract theory or discovery of any living thing or non-living substances occurring in nature;
- (d) the mere *discovery of a new form of a known substance* which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any property or mere new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant;
- (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 re-arrangement or duplication of known devices* each functioning independently of one another in a known way;
- (g) omitted by Patents (Amendment) Act, 2002.
- (h) a *method of agriculture or horticulture*;
- (i) any *process for the medicinal, surgical, curative, prophylactic diagnostic, therapeutic or other treatment* of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products;
- (j) *plants and animals in whole* or any part thereof other than micro-organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;
- (k) a *computer programme* per se other than its technical application to industry or a combination with hardware;
- (l) a *literary, dramatic, musical or artistic work or any other aesthetic creation* whatsoever including cinematographic works and television productions;

Intellectual Property Rights

- (m) a *mere scheme or rule or method of performing mental act* or method of playing game;
- (n) a *presentation of information*;
- (o) *topography of integrated circuits*;
- (p) an invention which in effect, is *traditional knowledge* or which is an aggregation or duplication of known properties of traditionally known component or components.

Section 4 prohibits the grant of patent in respect of an *invention relating to atomic energy* falling within Subsection (1) of Section 20 of the Atomic Energy Act, 1962.

8.2 Application for Patent

Section 6 of the Act provides that an application for a patent for an invention may be made by any of the following persons either alone or jointly with another:

- (a) by any person claiming to be the *true and first inventor* of the invention;
- (b) by any person being the *assignee* of the person claiming to be the true and first inventor in respect of the right to make such an application;
- (c) by the *legal representative* of any deceased person who immediately before his death was entitled to make such an application.

As per Section 2(1)(y), “**true and first inventor**” does not include either the first importer of an invention into India or a person to whom an invention is first communicated from outside India. The applicant should disclose the name, address and nationality of the true and first applicant.

Assignee can be a natural person or other than natural person like registered company, research organization, educational institute or Government (S. 2(1)(s)). Assignee includes assignee of the assignee also (S. 2(1)(ab)). ‘**Proof of right**’ to apply such as assignment deed should be submitted by the assignee.

Legal representative means a person who in law represents the estate of a deceased person (S.2 (1) (k)). In such a case, they should file death certificate etc. as proof of right.

In case of a convention application, the legal representative or assignee of the applicant in the Convention Country can also file a Patent Application in India.

8.3 Form of Application

Section 7 dealing with form of application requires every application for a patent to be made for one invention only. *In respect of one single invention there must be one single patent.* A patent may be in respect of a substance or in respect of a process. But it is not possible to bifurcate a patent and state that it relates to the substance and the other to the process. In order to have a complete patent, the specifications and the claims must be clearly and distinctly mentioned.

Every international application under the Patent Cooperation Treaty (PCT) for a patent, as may be filed designating India shall be deemed to be an application under the Act, if a corresponding application has also been filed before Controller in India. *The filing date of such application and its complete specification processed by patent office as designated office or elected office shall be the international filing date accorded under the PCT.*

8.4 Specification

In order to obtain a patent, an applicant must fully and particularly describe the invention therein claimed in a complete specification. The disclosure of the invention in a complete specification must be such that a person skilled in the art may be able to perform the invention. The Specification is a techno-legal document containing full scientific details of the invention and claims to the patent rights. The Specification, thus, forms a crucial part of the Patent Application. It is mandatory on the part of an applicant to disclose fully and particularly various features constituting the invention. The Specification may be filed either as a *provisional* or as a *complete specification*. The Specification (provisional or complete) is to be submitted in **Form-2** along with the Application in **Form-1** and other documents, in duplicate, along with the prescribed fee as given in the First Schedule. The first page of the Form 2 shall contain:

- (a) Title of the invention;
- (b) Name, address and nationality of each of the applicants for the Patent; and
- (c) Preamble to the description.

The title of the invention shall sufficiently indicate the specific features of the invention. Every Specification whether provisional or complete shall describe the invention. The applicant shall submit drawings, wherever required. Such drawings shall form a part of the Specification and suitable references thereto shall be made in the Specification.

8.4.1 Provisional Specification

When the applicant finds that his invention has reached a stage wherein it can be disclosed on paper, but has not attained the final stage, he may prepare a disclosure of the invention in the form of a written description and submit it to Patent Office as a provisional specification which describes the invention.

A *provisional specification secures a priority date* for the application over any other application which is likely to be filed in respect of the same invention being developed concurrently.

Immediately on receiving the Provisional Specification the Patent Office accords a *filing date* and *application number* to the Application.

Section 9 stipulates that an application for a patent accompanying a provisional specification, a *complete specification shall be filed within twelve months from the date of filing* of the

application, and if the complete specification is not so filed, the application shall be deemed to be abandoned.

8.4.2 Complete Specification

The complete specification is a techno-legal document which fully and particularly describes the invention and discloses the best method of performing the invention.

As per Section 10, every complete specification is required to -

(a) *fully and particularly describe the invention* and its operation or use and the method by which it is to be performed;

(b) disclose the best *method of performing the invention* which is known to the applicant and for which he is entitled to claim protection; and

(c) end with a claim or *claims defining the scope of the invention* for which protection is claimed; and

(d) be accompanied by an *abstract* to provide technical information on the invention.

8.5 Types of Patent Applications

1. **Ordinary Application**, i.e., an Application which has been filed directly in the Indian Patent Office.

2. **Convention Application.**

3. **PCT Application.**

4. **Divisional Application**, which can result from division of a Patent Application.

5. **Patent of Addition**, which may be filed subsequent to the Filing of an Application for Patent, for an improvement or modification.

8.6 Where to apply?

As per Rule 4 of the Patents Rules, 2003 [as amended by Patents (Amendment) Rules, 2005], application for the patent has to be filed in the respective patent office as mentioned below where 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.

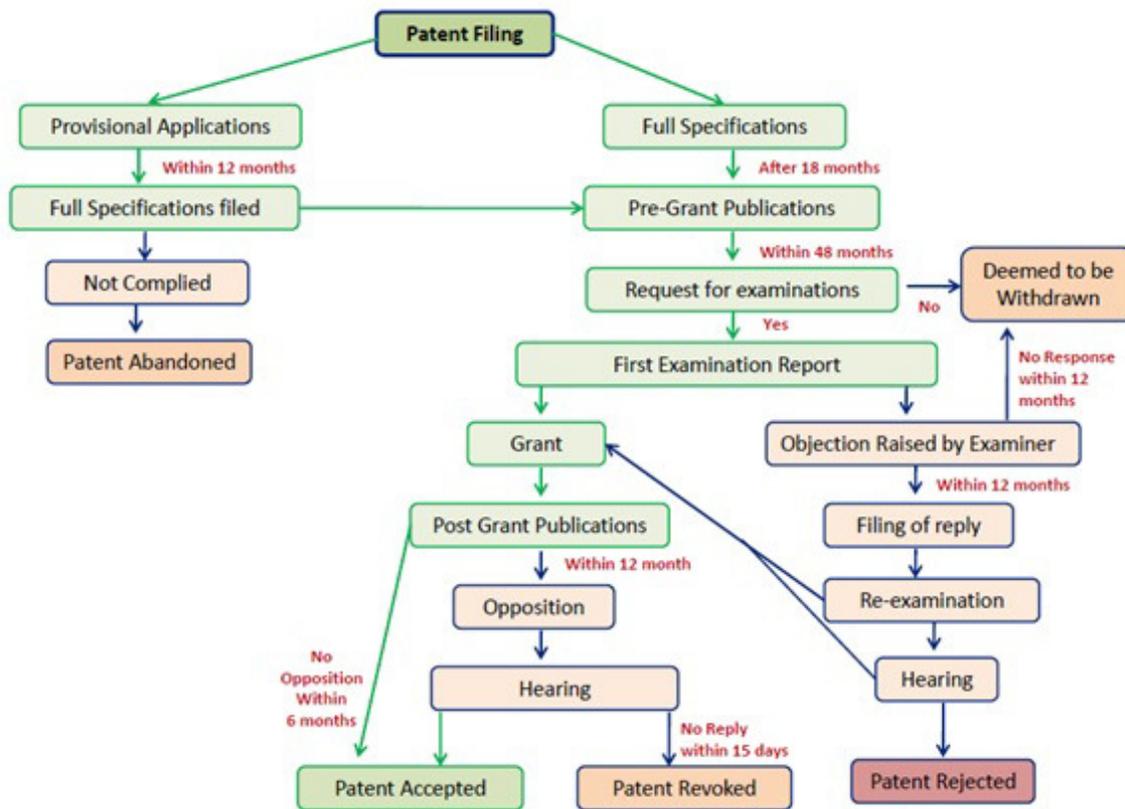
(c) Address for service in India given by the applicant when he has no place of business or domicile in India. (Rule 5)

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

8.7 Procedure for Filing of a Patent Application

A patent application shall be filed on Form-1 along with Provisional / Complete Specification, with the prescribed fee as given in First Schedule at an appropriate office.

However, a *provisional specification cannot be filed in case of a Convention Application (either directly or through PCT routes)*. Normal fee shall be applicable for applications containing upto thirty pages in specification and upto 10 claims. If the specification exceeds thirty pages or claims are more than ten in number, additional fee as given in First Schedule is payable. [Section 7, First Schedule].



8.8 Contents of Patent Application

A patent application should contain:

1. Application for grant of patent in **Form-1**.
2. Applicant has to obtain a proof of right to file the application from the inventor. The **Proof of Right** is either an endorsement at the end of the Application Form-1 or a separate assignment.
3. Provisional / complete specification in **Form-2**.
4. Statement and undertaking under Section 8 in **Form- 3**, if applicable. An applicant must file Form 3 either along with the application or within 6 months from the date of application.

Intellectual Property Rights

5. **Declaration as to inventor-ship** shall be filed in Form for Applications accompanying a Complete Specification or a Convention Application or a PCT Application designating India. However, the Controller may allow **Form-5** to be filed within one month from the date of filing of application, if a request is made to the Controller in Form-4.

6. **Power of authority** in **Form-26**, if filed through a Patent Agent. In case a general power of authority has already been filed in another application, a self attested copy of the same may be filed by the Agent. In case the original general power of authority has been filed in another jurisdiction, that fact may also be mentioned in the self attested copy.

7. **Priority document** is required in the following cases:

(a) Convention Application (under Paris Convention).

(b) PCT National Phase Application wherein requirements of Rule 17.1(a or b) of regulations made under the PCT have not been fulfilled.

8. Every application shall bear the Signature of the applicant or authorized person / Patent Agent along with name and date in the appropriate space provided in the forms.

9. The Specification shall be signed by the agent/applicant with date on the last page of the Specification. The drawing sheets should bear the signature of an applicant or his agent in the right hand bottom corner.

8.9 e-filing

1. The Patent Office provides the facility to file a Patent Application online from the native place of the agent of the applicant or applicant through e-filing.

2. For e-filing, applicant/agent must have a **digital signature**. For the first time, applicant/agent has to register as a new user and has to create login ID and password on the Patent office portal. (Rule 6). Details regarding procedure for e-filing are provided at <http://www.ipindia.nic.in>)

8.10 Processing of Application

Initial processing

1. On receipt of an application, the Office accords a date and serial number to it. PCT national phase Applications and non-PCT Applications are identified by separate serial numbers.

2. All applications and other documents are digitized, verified, screened, classified and uploaded to the internal server of the Office.

3. Patent applications and other documents are arranged in a file wrapper and the Bibliographic sheet is prepared and pasted on the file cover, so that the files move on for storing in the compactors.

4. The Application is screened for:

(a) International Patent Classification.

(b) Technical field of invention for allocation to an examiner in the respective field.

Intellectual Property Rights

(c) Relevance to defence or atomic energy.

5. Requests for examination are also accorded separate serial number.

Scrutiny of application

1. The Office checks whether the Application has been filed in appropriate jurisdiction. If the jurisdiction is not appropriate, the application shall not be taken on record and the applicant is informed accordingly.

2. The Office checks for proof of right to file the application. If the proof of right is not filed along with the application, it shall be filed within a period of six months from the date of filing of the application. Otherwise, the applicant shall file the same along with a petition under Rule 137/138.

3. The Office checks whether the application and other documents have been filed in the prescribed format i.e. prescribed forms, request, petitions, assignment deeds, translation etc.

Secrecy directions and consequences thereof

1. After the initial processing and scrutiny of the applications by the patent office, if in the opinion of the Controller an invention pertains to a subject matter relevant for the purpose of defence as notified by the Central Government, the Controller issues a secrecy direction prohibiting the publication of the application to the applicant and refers the matter to the Central Government for their consideration as to whether the application is prejudicial to the defence of India.

2. The Central Government, after considering the merits of the secrecy direction, may give notice to the Controller as to whether the secrecy direction needs to be continued or not.

3. The Central Government reviews the matter at an interval of six months. The applicant may request for a reconsideration of the secrecy direction and if the same is found reasonable by the Controller, he may request the Central Government for a review.

4. If the Central Government is of the opinion that an invention in respect of which the Controller has not imposed a secrecy direction and is relevant for defence purposes, it may at any time before the grant of the patent notify the Controller to that effect.

8.11 Publication of Application

Section 11A(1) provides that no application for patents shall ordinarily be open to public for such period as may be prescribed. Rule 24 dealing with procedure for publication of application provides that the period for which an application for patent shall not ordinarily be open to public under Section 11A(1) shall be *eighteen months from the date of filing* of application or the date of priority of the application, whichever is earlier. A request for publication under Section 11A (2) is required to be made in **Form 9**.

The publication of every application shall include the particulars of the date of application, number of application, name and address of the applicant identifying the application and an abstract.

8.12 Request for Examination

As per Section 11B an application for a Patent will not be examined unless the applicant or any other person interested makes a request for examination in the prescribed manner. The request is to be filed in **Form-18** with the fee as prescribed in First Schedule.

2. A request for examination has to be made *within forty eight months from the date of priority of the application or from the date of filing of the application, whichever is earlier*. If no such request for examination is filed within the prescribed time limit, the application shall be treated as withdrawn by the applicant.

3. In a case where secrecy direction has been issued under Section 35, the request for examination may be made *within six months from the date of revocation of the secrecy direction, or within forty-eight months from the date of filing or priority, which ever is later*.

4. The Office will not examine an application unless it is published and a request for examination is filed.

5. When a request for examination is filed by a person interested other than the applicant, the Examination Report is sent to the applicant only, and intimation is given to the person interested.

8.13 Search for Anticipation by Previous Publication and by Prior Claim

Section 13 dealing with search for anticipation by previous publication and by prior claim provides that the examiner to whom the application for a patent is referred shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification:

(a) has been anticipated by publication before the date of filing of the applicant's complete specification in any specification filed in pursuance of an application for a patent made in India and dated on or after the 1st day of January, 1912;

(b) is claimed in any claim of any other complete specification published on or after the date of filing of the applicant's complete specification, being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.

8.14 Opposition to the Patent

8.14.1 Pre Grant opposition

Section 25 of the Act deals with *opposition to grant of patent* and provides that where an application for a patent has been *published but a patent has not been granted*, any person may, in writing, represent by way of opposition to the Controller against the grant of patent on the following grounds and the Controller on request of such person shall hear him and dispose of the representation in the prescribed manner and specified time. The grounds of the opposition are:

Intellectual Property Rights

(a) that the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim -

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document :

(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant's claim;

(d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause or having regard to what was used in India before the priority date of the applicant's claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(h) that the applicant has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge;

(i) that in the case of convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title;

(j) that the complete specification does not disclose or wrongly mentions the source of geographical origin of biological material used for the invention;

(k) that the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.

8.14.2 Post Grant opposition

Section 25(2) entitles any interested person to give notice of opposition, to the Controller in the prescribed manner at any time after the grant of patent but before the expiry of a period of one year from the date of publication of grant of a patent, on any of the following grounds only :-

Intellectual Property Rights

- (a) that the patentee or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;
- (b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or in India or elsewhere, in any other document.
- (c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the claim of the patentee and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the claim of the patentee;
- (d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.
- (e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause
- (f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;
- (g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;
- (h) that the patentee has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge;
- (i) that in the case of a patent granted on convention application, the application for patent was not made within twelve months from the date of the first application for protection for the invention made in a convention country or in India by the patentee or a person from whom he derives title;
- (j) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.

8.15 Grant of Patents

Section 43 dealing with grant of patents provides that where an application for a patent has been found to be in order for grant of the patent and either the application has not been refused by the Controller by virtue of any power vested in him by the Act; or the application has not been found to be in contravention of any of the provisions of the Act, the patent shall be granted as expeditiously as possible to the applicant or, in the case of a joint application, to the applicants jointly, with the seal of the patent office and the date on which the patent is granted shall be entered in the register.

8.16 Term of Patent

Section 53 provides that the term of every patent granted after the commencement of the Patents (Amendment) Act, 2002 and the term of every patent which has not expired and has

Intellectual Property Rights

not ceased to have effect, on the date of such commencement, shall be *twenty years from the date of filing* of application for the patent. Explanation to Section 53(1) clarifies that the term of patent in case of international applications filed under the PCT designating India, shall be *twenty years from the international filing date accorded under the Patent Cooperation Treaty*.

8.17 Working of Patent

a. 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 that is reasonably practicable without undue delay.

b. The Controller has the power to call for the information such as periodical statements as to the extent to which the patented invention has been commercially worked in India, as may be specified in the notice issued to that effect at any time during the continuance of the Patent

c. A patentee or a licensee shall furnish such information within two months from the date of such notice or within such further time as the Controller may allow.

d. The patentee and every licensee shall furnish a statement as to the extent to which the patented invention has been worked on a commercial scale in India, in Form 27, in respect of every calendar year, within three months of the end of each year.

8.18 Ceasing a patent

A patent shall cease to have effect on the expiration of the period prescribed for the payment of any renewal fee, *if that fee is not paid within the prescribed period* or within such extended period as may be prescribed. Further on cessation of the patent right due to non-payment of renewal fee or on expiry of the term of patent, the subject matter covered by the said patent shall not be entitled to any protection.

8.19 Restoration of Lapsed Patents

Section 60 provides that where a patent has ceased to have effect by reason of failure to pay any renewal fee within the period prescribed under section 53 or within period as may be allowed under section 142(4), the patentee or his legal representative and where the patent was held by two or more persons jointly, then with the leave of the Controller one or more of them without joining the others, may *within eighteen months from the date on which the patent ceased to have effect*, make an application for the restoration of the patent.

Grounds for making an application for restoration-

- (a) the failure to pay the renewal fee was not unintentional; or
- (b) there has been undue delay in the making of the application.

8.20 Surrender of Patents

Section 63 entitles the patentee to offer to surrender his patent, at any time by giving notice to the Controller. Where such an offer is made, the Controller shall publish the offer in the

Intellectual Property Rights

prescribed manner and also notify every person other than the patentee whose name appears in the register as having an interest in the patent.

Any person interested may, within the prescribed period after such publication, give notice of opposition to the Controller and where such notice is given the Controller shall notify the patentee. If the Controller is satisfied after hearing the patentee and any opponent, if desirous of being heard, that the patent may properly be surrendered, he may accept the offer and by order revoke the patent.

8.21 Revocation of patents

Any Interested person including the government can file a petition on any of the grounds specified for revocation of a patent under Section 64 of the Patents Act. Section 64 dealing with revocation of patents stipulates that a patent, whether granted before or after the commencement of this Act, may, be revoked on a petition of any person interested or of the Central Government by this Appellate Board or on a counterclaim in a suit for infringement of the patent by the High Court

8.22 Assignments of Patents

Assignment refers to the act of the patentee by which the patent rights are wholly or partially transferred to the assignee who acquires the right to prevent others from making, using or exercising or vending the invention. Section 70 of the Patents Act, 1970 gives the person/persons, persons registered as grantee or proprietor of a patent, power to assign, grant licences under, or otherwise deal with, the patent and to give effectual receipts for any consideration for any such assignment, licence or dealing.

The assignment can either be exclusive or non exclusive. The exclusivity can be further limited, for example exclusivity to a territory or market or line of products. Following are three main types of assignments in patents:

- 1) Legal Assignments
- 2) Equitable Assignments
- 3) Mortgages

8.23 Penalties under Patent Act

If any person fails to comply with any direction given under section 35 or makes or causes to be made an application for the grant of a patent in contravention of section 39, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.

If any person makes, a false entry in any register kept under the Patents Act or provides any writing or evidence as a result of which the entry in the register results into a false entry, knowing the entry or writing to be false, then he is punishable with imprisonment for a term that may extend to two years or with fine or with both.

Intellectual Property Rights

If any person falsely represents that any article sold by him is patented in India or is the subject of an Application for a Patent in India, he shall be punishable with fine that may extend to rupees one lakh.

If any person uses on his place of business or any document issued by him which would reasonably lead to the belief that either his place of business is the Patent Office or is officially connected with the Patent Office, he shall be punishable with imprisonment for a term that may extend to 6 months, or with fine, or with both.

If any person refuses or fails to furnish information as required under Sections 100(5) and 146, he shall be punishable with fine which may go up to rupees ten lakh (one million). Section 100(5) provides that any person including Government undertaking using a patented invention for the purpose of Government has to furnish any information on the use of invention as required by the Central Government and Section 146 provides that the patentee has to furnish a statement regarding the working of the patented invention in a commercial scale in India in Form 27. This has to be done annually within 3 months of the end of each calendar year for that calendar year. If he furnishes false information knowingly he shall be punishable with imprisonment that may extend to 6 months or with fine or with both.

Any person practicing as a Patent Agent without registering himself as such is liable to be punished with a fine of rupees one lakh for the first offence and rupees five lakh for subsequent offence.

When an offence is committed by a company, the company as well as every person in charge of, and responsible to the company for the conduct of its business at the time of the commission of the offence, shall be deemed to be guilty and shall be liable to be proceeded against and punished accordingly.

8.24 Compulsory Licensing

The provisions for compulsory licenses are made to prevent the abuse of patent as a monopoly and to make the way for commercial exploitation of the invention by an interested person. According to Section 84 any person interested 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) that the reasonable requirements of the public with respect to the patented invention have not been satisfied, or
- (b) that the patented invention is not available to the public at reasonably affordable price, or
- (c) that the patented invention is not worked in the territory of India.

8.25 Transfer of Technology

In a broader sense, technology is viewed as any systematic or practical knowledge, experience or skills used for – (i) manufacture of products or application of processes; (ii) commercial or management purposes in industry; and (iii) the achievement of any desired result, be it industry or social areas of life.

Intellectual Property Rights

It is universally recognized that an inflow of technology, whether appropriate or advanced, is necessary into a developing country for ensuring economic self-reliance to main the rate of progress of development. The concept of 'transfer of technology' is a complex phenomenon necessarily involving rights, obligations, privileges and commitments of the parties to the transaction.

The basic legal document is the Licence Agreement for transfer of technology. The other commonly used modes of technology transfer are technical assistance agreement, patents and patent agreement, know-how agreement, engineering services agreement, the trademark agreement and the franchise agreement.

License may be granted for IP that is necessary to further develop, reproduce, make, use, market, and sell products based on the technology to be transferred. The terms and conditions of a licensing agreement determine the success of the technology transfer. Therefore, while formulating the licensing agreement, the parties involved should define the technology to be transferred without any ambiguity. Certain factors to be considered while defining the technology in the licensing agreement include:

- type of the technology i.e. product, process, facility, software, formula, etc.;
- need for additional license for practicing the technology;
- industrial standards or specifications associated with the technology; and
- details required to practice the technology.

9. International Applications

An international application under the Treaty should be filed at and processed by the appropriate office in accordance with the provisions rules relating to international applications under Patent Cooperation Treaty (PCT) the regulations established under the PCT. The appropriate office shall on receipt of an international application, transmit one copy as record copy of such application to International Bureau of the World Intellectual Property Organisation and another copy as search copy to Competent International Searching Authority.

An Indian applicant can file a PCT International application in the following manner:

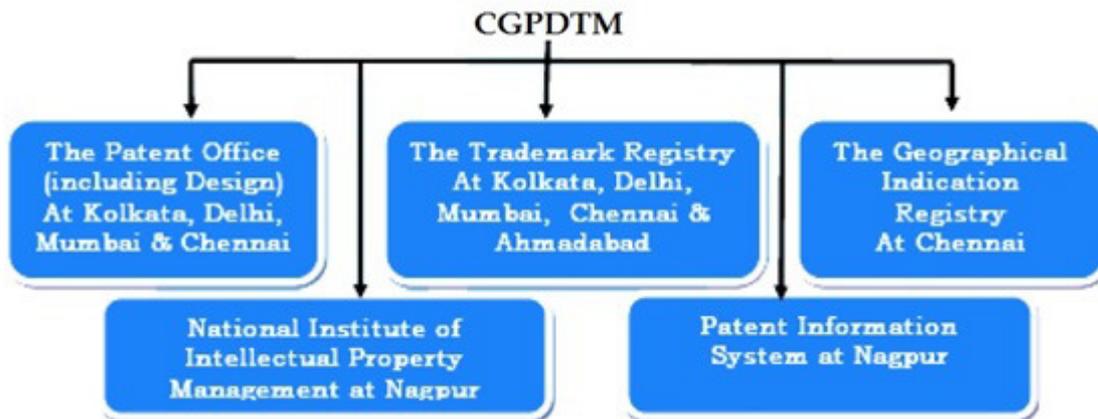
(a) Filing in the Indian Patent Office acting as Receiving Office. In such cases, it is advisable that the application be accompanied by permission for foreign filing granted under section 39 by the Controller. If such permission is sought along with the application, there is a probability that the permission may be deferred and the application may be referred to DRDO / Department of Atomic Energy for their directions.

(b) Filing directly in the International Bureau of WIPO after taking permission u/s 39 from the Indian Patent Office.

(c) After filing a patent application in India, anytime before the expiry of 12 months from the date of filing, file an international in IB of WIPO or in Indian Patent Office as Receiving Office. However, if the international filing is within 6 weeks from the date of filing in India, such filing shall be made after taking permission u/s 39 from the Indian Patent Office.

10. Patent Offices in India

The *Office of the Controller General of Patents, Designs & Trade Marks (CGPDTM)* comes under the *Department of Industrial Policy and Promotion, Ministry of Commerce and Industry*. Of late, the office of the Controller General has also been known as Intellectual Property Office (IPO). The Office of the Controller General of Patents, Designs & Trade Marks (CGPDTM) is located at Mumbai. The Patent information System (PIS) and National Institute of Intellectual Property Management (NIIPM) located at Nagpur also come under the superintendence of CGPDTM.



11. Trademarks

A trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises. Trademarks are protected by intellectual property rights. A word or a combination of words, letters, and numerals can perfectly constitute a trademark. But trademarks may also consist of drawings, symbols, three-dimensional features such as the shape and packaging of goods, non-visible signs such as sounds or fragrances, or color shades used as distinguishing features – the possibilities are almost limitless.



Significance of Trademarks includes:

- It identifies the goods / or services and its origin.
- It guarantees its unchanged quality
- It advertises the goods/services
- It creates an image for the goods/ services.

A person or entity (Corporate, society, etc) who claims to be the proprietor of the trade mark in relation to goods and /or services may apply for the registration of a Trade Mark. The initial registration of Trademark shall be for a period of 10 years and may be renewed from time to time for an unlimited period by payment of renewal fees.

12. Industrial Designs

'Design' means only the features of shape, configuration, pattern or ornament or composition of lines or colour or combination thereof applied to any article whether two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye, but does not include any mode or principle or construction or anything which is in substance a mere mechanical device, and does not include any trademark.

The "article" means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately.



Importance of Design

- Registration of a design confers upon the registered proprietor 'Copyright' in the design for the period of registration.
- Promotes more innovative and aesthetically attractive products.

13. Copyrights

Copyright is a right given by the law to creators of literary, dramatic, musical and artistic works and producers of cinematograph films and sound recordings. In fact, it is a bundle of rights including, inter alia, rights of reproduction, communication to the public, adaptation and translation of the work. There could be slight variations in the composition of the rights depending on the work.

Copyright ensures certain minimum safeguards of the rights of authors over their creations, thereby protecting and rewarding creativity. Creativity being the keystone of progress, no civilized society can afford to ignore the basic requirement of encouraging the same.

Intellectual Property Rights

Economic and social development of a society is dependent on creativity. The protection provided by copyright to the efforts of writers, artists, designers, dramatists, musicians, architects and producers of sound recordings, cinematograph films and computer software, creates an atmosphere conducive to creativity, which induces them to create more and motivates others to create.

A work means any of the following, namely, a literary, dramatic, musical or artistic work, a cinematograph film, or a sound recording. "Work of joint authorship" means a work produced by the collaboration of two or more authors in which the contribution of one author is not distinct from the contribution of the other author or authors.

Copyright subsists throughout India in the following classes of works:

- Original literary, dramatic, musical and artistic works;
- Cinematograph films; and
- Sound recordings.

14. Semiconductor IC Layout Design

The semiconductor integrated circuit is an integral part of every computer chip. The fifth generation computers are using Very Large Scale Integration (VLSI) where numerous transistors are accommodated on a single chip, cutting down the size of the chip and at the same time increasing its processing power significantly. This ultimately translates into smaller and more powerful computers. Hence, the development of the layout-design on a semiconductor integrated circuit as an intellectual property is quite significant.

"*Semiconductor Integrated circuits Layout- Design Act 2000*" is a supplement act to designs. It fulfills the obligations of TRIPS agreement regarding the protection of semiconductor integrated circuits layout- designs.

SICLD Act defines the following as:

- "**Semiconductor integrated circuit**" means a product having transistors or other circuitry elements, which are inseparably formed on a semiconductor material or an insulating material or inside the semiconductor material and designed to perform an electronic circuitry function.
- "**Layout-design**" means a layout of transistors and other circuitry elements and includes lead wires connecting such elements and expressed in any manner in a semiconductor integrated circuit.
- "**Commercial exploitation**" in relation to the SICLD means to sell, lease, offer or exhibit for sale or otherwise distribute such semiconductor integrated circuit for any commercial purpose.

15. References:

- <http://www.ipindia.nic.in/>
- <http://copyright.gov.in>

- <http://sicldr.gov.in>
- www.wipo.int
- www.google.co.in

16. Online Training:

<https://www.edx.org/course/intellectual-property-rights-a-management-perspect>

https://www.wipo.int/academy/en/courses/distance_learning/

<https://nptel.ac.in/course.html>