FAQ Patents

What is industrial property?

A. Industrial property includes:

(a) Patents (b) Utility models (c) Industrial designs (d) Trademarks, service marks and trade names (e) Indication of source or appellations of origin (this is same as the geographical indications adopted in TRIPS);

Q. What is a patent?

A. 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 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 similar area may also come in the way. A patent in law is a property right and hence, can be gifted, inherited, assigned, sold or licensed. It is a right conferred by the State; it can be revoked by the State under very special circumstances. 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.

Q. What are the conditions to be satisfied by an invention to be patentable?

A. invention is defined as “invention means a new product or process involving an inventive step and capable of industrial application” (Section 2(1) (j)).

An invention must satisfy the following four conditions of:

(i) Novelty (ii) Inventiveness (Non-obviousness) (iii) Usefulness (iv) Industrial Applicability

Novelty: An invention will be considered novel if it does not form a part of the global state of the art. Information appearing in magazines, technical journals, books, newspapers etc. constitute the state of the art. Oral description of the invention in a seminar/conference can also spoil novelty. Novelty is assessed in a global context. An invention will cease to be novel if it has been disclosed in the public through any type of publications anywhere in the world before filing a patent application in respect of the invention. Prior use of the invention in the country of interest before the filing date can also destroy the novelty. Novelty is determined through extensive literature and patent searches. It should be realized that patent search is essential and critical for ascertaining novelty as most of the information reported in patent documents does not get published anywhere else.

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. A mere 'scintilla' of invention is sufficient to found a valid patent.

This coupled with the requirement of section 2(ja) *"inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art;*

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

Industrial Applicability: For Industrial Applicability criterion the invention should be used for a particular field not in general. The invention should be such that it is used in any industry not necessarily applicable across the board.

Q. Which are the non-patentable inventions under the Indian Patent Law?

A. Sections 3 & 4 of the Patents Act, 1970 enlist the non-patentable inventions.

Section 3 reads as follows:

The following are not inventions within the meaning of this Act,

(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 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 substance occurring in nature] (But the dividing line between invention and discovery is very thin a lot of it will depend on the projection of the invention);

(d) the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant;(Explanation Derivatives of a same substance such as salts, esters, ethers, polymorphs, metabolites, new form particle size and other derivatives of a known substance will be considered as the same substance unless they defer significantly in properties with regards to efficacy)

(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; (A synergistic admixture is patentable. If the admixture discloses a beneficial new properties not disclosed by the individual ingredients, the same is patentable)

(f) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;

(g) a method of agriculture or horticulture ;(Crop protection chemical and new devices used in agricultural of horticultural operations are patentable)

(h) 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;

(i) 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;(New plant varieties can be protected under a different law)

(j) a mathematical or business method or a computer program per se or algorithms ;(But if the software is responsible for causing an improved technical effect or improves the efficacy of the existing device, then the technical or the improved device can be patented)

(k) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;(The same can be protected under laws of Copyright)

(l) a mere scheme or rule or method of performing mental act or method of playing game;

(m) a presentation of information;

(n) topography of integrated circuits; (This can be protected under a different law)

(o) an invention which, in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components.](But an improvement to the traditional knowledge complying with the requirement of novelty, utility and non-obviousness can be a subject matter of Patent)

And Section 4:

No patent shall be granted in respect of an invention relating to atomic energy falling within sub-section (1) of Section 20 of the Atomic Energy Act, 1962 (33 of 1962)

Q. Can a published or disclosed invention be patented?

A. Novelty is crucial for Patent protection. Usually, the novelty is lost by:

(a) prior publication;

(b) prior public use;

(c) prior claiming (if it has been claimed in an earlier specification.)
Publication of an invention in any form by the inventor before filing of a patent application would disqualify the invention to be patentable. Hence, inventors should not disclose their inventions before filing the patent application. The invention should be considered for publication after a patent application has been filed. Thus, it can be seen that there is no contradiction between publishing an inventive work and filing of patent application in respect of the invention.
However Section 31 and 32 provide that if the disclosure is before a scientific body or an exhibition notified by the Union Government, then, within twelve months from such publication or display, a patent application can be made.
A non-commercial experimental use does not defeat novelty. But, it is always better to apply for a patent first and publish or exhibit the product after patent application. If such publication or display had occurred prior to the application, contact a patent attorney immediately to know whether an application can be made notwithstanding the disclosure.

Q. What is the distinction between patented inventions and know how?
A. Law does not require that the information disclosed in the patent specification be sufficient for commercial exploitation of the invention. Thus, patent usually may not disclose sufficient information for commercialization. Know how on the other hand, covers all information necessary to commercialize the invention e.g. setting up a production plant. Such information would include, for example, details of the production methods, the design drawings etc. It is this knowhow which is traded while transferring technology. Know how is always kept as a trade secret and not shared with public. Know how is not protected through patents as most of it is non-patentable matter and one does not take patent on the remaining parts to avoid public disclosure. A know how developed around an existing patent and commercialized subsequently may be an infringement of the patent unless the patentee has agreed to commercialization on mutually agreed terms.

Q. When should an application for a patent be filed?
A. Filing of an application for a patent should be completed at the earliest possible date and should not be delayed. An application filed with provisional specification, disclosing the essence of the nature of the invention helps to register the priority by the applicant. Delay in filing an application may entail some risks like (i) other inventors might forestall the first inventor by applying for a patent for the said invention (ii) there may be either an inadvertent publication of the invention by the inventor himself/herself or by others independently of him/her.

Q. Can an applicant file an application in foreign language in India?
A. An application can be filed in India either in English or Hindi.

Q. What is the application procedure?
A. the application procedure is stated in the Patent Rules wherein in the First Schedule therein lays down the fees, cursory reading will reflect the form number, its nature and the applicable fees, second schedule reflects the list of Forms and the specimen forms. The main forms being:

- Form 1 An application for patent has to be made in Form 1 (duplicate) and shall be accompanied by prescribed fee
- Form 2 (provisional or complete specification) and
- Form 3 (a declaration and undertaking regarding the foreign patent filings of the same invention).

Q. What is Form 1? Should this Form necessarily contain the signatures of the Inventors and the Applicant? If an employee invents a new technology who should be the Applicant for Patent?

If an invention originates in the course of Contract of Employment (in the absence of a contract to the contrary) the technology vests with the employer and he should be shown to be Applicant for Patent.
Form 1 need not have the signature of Inventors for the initial filing. If the initial filing is made without the signature of the inventors, subsequently, From 1 duly signed by the inventor must be logged with the Patent Office within six months of the Application.
If the Applicant is a Company, Form 1 must be signed by the Company Secretary or a Director or any Authorized Signatory who has been specifically authorized to represent the Company by means of a Resolution passed by the Board of Directors of the Company.

Q. What is Form 2 or Specification, What is the difference between Complete and Provisional Specification?
Specification is the most important document in the entire Patenting procedure. We strongly recommend that you consult an Attorney before finalizing the specification. There are two types of specification provisional and complete.
Provisional Specification is logged to achieve earliest priority date. When the inventive concept is in its formative stages, and a lot of final details of the invention have to be worked out in future, it is better to log a provisional specification. On the other hand, if everything about the invention is known and the invention can be commercialized or marketed the next day, it is better to log the complete specification straight away.
If a provisional specification is followed by a Complete Specification, the Applicant will also have to log the declaration of inventor ship as in Form 5.
If a Complete Specification is not logged within 12 months of logging the Provisional Specification, the Patent Application will be deemed to have been abandoned.

Q. Who will read my Patent Specification?
A good specification is Legal, Technical and Commercial Document. To begin with, the Specification would be read by the "Examiner" in Patent Office who would normally be a person skilled in the art or the field of the invention.

(However, during the later stages the Specification would be read by
(a) the Controller of Patents
(b) Investment Banker
(c) Lending Banker
(d) A Judge
Hence, it must be comprehensible even for those who are not so skilled in the area of invention.)

Q. What should be the contents of the Specification?
Adopt the following format while preparing the Specification.
(a) Title of the invention.
(b) Area of the Invention.
(c) Background of the invention.
(d) Summary of the invention
(e) Explanation about the drawings. Law does not compel you to submit drawings. But remember a good drawing can save you from pages of written description.
(f) Detailed description of the invention.
(g) Claims. This is the most important part in a Patent Specification. Please always consult an Attorney before drafting the claim.
(h) Abstract.

Q. Is there any limit on number of pages or claims in the Specification?
Even though there is no limit to the number of pages in the specifications, it is better to be precise. The official fee as per First Schedule of the patent rules will depend upon number of pages and the claims. (Information concerning application form and details of fee available at www.ipindia.nic.in)

Q. Is there an automatic right to Publication and Examination once a Complete Specification is lodged?

There is an automatic right to Publication. The application gets published after 18 months from the date of filing of application or the date of priority of the application, whichever is earlier.

The Applicant has to specifically request for Examination after the publication of the Specification in the Patent Office Gazette, by paying prescribed fee. If the Examination is not requested within 48 months of the Priority Date, the Application will be deemed to have been abandoned.

Q. Can this examination be expedited? When does the publication take place?

Normally publication of the application is done after 18 months from the date of filing of application or from the date of priority of the application, whichever is earlier. An applicant can request for examination only after publication.

Request for expedited publication can be made in Form 9 by paying the prescribed fee.

Thereafter, request for examination has to be made in Form 18 with a prescribed fee.

The Express Request for Examination for National phase applications is possible on further payment of official fee.

Q. What should we do after the issuance of First Examination Report?

Usually, the First Examination Report will comprise many objections from the Patent Office. All the requirements of the Report would have to be complied within 1 Year from the date of the issuance of the First Examination Report.

In between, the Patent Office may issue further Official Actions if warranted by circumstances.

If the requirements of the Examination Report are not complied within 1 year, then the application is deemed to be abandoned.

Q. Is it possible to amend the Patent Specification once filed?

The Patents Act, 1970 considers 2 types of amendments. After the receipt of the First Examination Report, amendments may be made to comply with the requirements of the Report. These are involuntary amendments made at the instance of the Patent Office and the same can be done free of cost.

In addition, voluntary amendments are also possible by filing Form 13 on payment of the prescribed fee. Voluntary amendments can be made either before or after the grant of the Patent.

However, amendments cannot be made for the purpose of increase in the scope of the claims or for incorporating additional disclosure.

Minor amendments for changing the name, address of the applicant and address for service can be effected on payment of fee mentioned in the Indian Patent Act.

Q. What happens if the requirement of the First Examination Report (FER) is not complied within the stipulated time? Will the applicant have a right of hearing and appeal?

If the requirements of the FER are not completed within the stipulated time, the application is deemed to have been abandoned. In case of abandonment, the Controller does not pass any speaking order but merely informs the applicant that the application has been abandoned. In such a case, the applicant does not have any right of appeal, but the aggrieved applicant can either file a Review Petition under Rule 130 of the Patent Rules before the Controller of the Patent or file a Writ petition under Art.226 of the Constitution.

Under the Patents Act, there is no automatic right of hearing before the rejection of the Patent application. If an applicant is very keen to have an oral hearing, he must specifically request for hearing. If the Controller rejects the application, even after hearing, the applicant can file an appeal within 90 days to the Intellectual Property Appellate Tribunal (IPAT) within 90 days of the order of rejection. As on date, the jurisdiction to hear patent appeal has not yet been

conferred on IPAT and hence, the High Court's within whose jurisdiction the Patent Office is located are empowered to entertain Miscellaneous Appeal.

Q. What is the term of patent in India and when does the renewal fee become payable?
A patent is valid for 20 years from the date of filing of the application. In case of International applications filed under Patent Cooperation Treaty designating India, the term of the patent is 20 years from the international filing date.

Q. If two or more persons work together to make an invention, to whom will the patent be granted?
If each had a share in the ideas forming the invention as defined in the claims - even if only as to one claim, they are joint inventors and a patent will be issued to them jointly on the basis of a proper patent application.

Q. What is considered as the date of patent?
The date of patent is the date of filing the application for patent (whether provisional or complete). The term of the patent is counted from this date.

Q. How does one keep a patent in force for the full patent term?
A patent has to be maintained by paying the maintenance fees every year. If the maintenance fee is not paid, the patent will cease to remain in force and the invention becomes open to public. Anyone can then utilize the patent without the danger of infringing the patent.

Q. What are the criteria for naming inventors in an application for patent?
A. The naming of inventors is normally decided on the basis of the following criteria:
i. All persons who contribute towards development of patentable features of an invention should be named inventor(s).
ii. All persons, who have made intellectual contribution in achieving the final results of the research work leading to a patent, should be named inventor(s).
iii. A person who has not contributed intellectually in the development of an invention is not entitled to be included as an inventor.
iv. A person who provides ideas needed to produce the 'germs of the invention' need not himself / herself carry out the experiments, constructs the apparatus with his/her own hands or make the drawings himself/herself. The person may take the help or others. Such person 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 inventors.

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

Q. What are the essential patent documents to be generated and submitted by a potential patentee?
There are two types of patent documents usually known as patent specification, namely
(i) Provisional Specification and (ii) Complete Specification
- **Provisional Specification**
A provisional specification is usually filed to establish priority of the invention in case the disclosed invention is only 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 a 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.

- Complete Specification

Submission of complete specification is necessary to obtain a patent this is a techno-legal document The contents of a complete specification would include the following

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

Q. What is expected from patentee as an obligation to the state?

A. A patentee must disclose the invention in a patent document for anyone to practice it after the expiry of the patent or practice it with the consent of the patent holder during the life of the patent.

Q. What is the nature of information needed while consulting a patent attorney?

A. As an inventor one should share the complete invention with a patent attorney in the same manner as a patient confides in a doctor. A patent attorney may not be able to draft a good specification in the absence of details about the invention. Following points should be kept in mind while discussing with the attorney:

- Provide complete details of the invention including failures, if any, on the way to the invention.

- Do not feel bad if attorney asks you questions like where did you get the idea from or did you copy the idea from somewhere or are you keeping other inventors working with you on the inventor ship or have you published the invention or disclosed it in a seminar/conference or have you displayed the invention in an exhibition? A patent document is a techno-legal document; hence all precautions are to be taken right from the first step. Provides right answers and you may even show your laboratory note book/log book to the attorney. This will help the attorney / agent to explain the inventive step in a precise manner and draft a good specification and associated claims.
- Explain the central theme of the invention and novelty, inventiveness and utility of the invention.
- Share the entire prior art documents in your possession with the attorney.
- If you have developed an improved version of your competitor's product/process, admit it and be totally honest. This would help the attorney in drafting precise claims and avoid excessive claims, which might be struck down immediately or at a later date.
- A detailed description of the best way of putting the invention into practical use, results of your tests and trials, etc., including all failures and defects should be given to the attorney.
- Alternative ways of using the invention, and the substitutes or parts of it i.e., will one chemical compound do as well as any other in the process?
- It may be worth drafting the patent widely enough to cover less satisfactory alternatives as well so as to prevent rivals from marketing a less satisfactory competing product which because of its defects might bring the whole genre of product into disrepute or which may be cheap.

- Both after an initial search and during the course of the filing and grant of a patent application, it is important to respond quickly and accurately to queries which the patent attorney may have. Thus the client should keep the patent attorney informed of any new developments in the field of invention carried by the patentee or someone else.

Q. Is a patent granted in one country enforceable in other countries?
A. No. There is nothing like a global patent or a world patent. Patent rights are essentially territorial in nature and are protected only in a country (or countries) which has (have) granted these rights. In other words,-for obtaining patent rights in different countries one has to submit patent applications in all the countries of interest for grant of patents. This would entail payment of official fees and associated expenses, like the attorney fees, essential for obtaining patent rights in each country. However, there are some regional systems where by filing one application one could simultaneously obtain patents in the member countries of a regional system; European Patent Office is an example of a similar system.

Q. Does grant of a patent in one country affect its grant or refusal in another country?
A. Each country is free to grant or refuse a patent on the bases of scrutiny by its patent office. This means that granting a patent in one country of the Union does not force other countries to grant the patent for the same invention. Also, the refusal of the patent in one country does not mean that it will be terminated in all the countries.

Q. Is it possible to have global or world Patent?
A. No, patenting is a matter that falls within the domestic jurisdiction of a State. However, Article 27 of the WTO TRIPS agreement establishes 'international minimum standard in patent protection.' Paris Convention on protection of Industrial Property, 1883 confers on all the Applicants irrespective of Nationality, among other things (a) a right to national treatment; (b) right of priority.

Patent Co-operation Treaty (PCT) facilitates filing of a single application that can be deemed as an application for all member states of PCT. National application in India has to be filed within 31 months of PCT Application. Grant of Patent in pursuant of the PCT National Phase Application is still left to the discretion of Local Patent Office.
The competent authorities for PCT filing from India are
1. The Patent Office, at Kolkata, New Delhi, Mumbai, and Chennai
2. International Bureau, Geneva, Switzerland.
International filings have to be made within 12 months of the filing of the Domestic Application.

Q. What is opposition under the Indian Patents Act 1970?
A. After the Patent Office has examined an application and found it in order for grant of a patent, it publishes the title of the invention, name of the inventor(s) and the applicant(s), abstract of the invention, drawings and claims in the Gazette of India, Part III Section 2, for interested parties to oppose the grant of the patent. An application for opposition may be filed at the concerned Patent Office branch within four months of the date of the issue of the concerned gazette. An extension of one month is possible; a request for extension has to be made within the first four months. Typed or photocopies of the specification together with photocopies of the drawings, if any, can be obtained from the Patent Office, Calcutta or the concerned branch office on payment of the prescribed fees. One would like to oppose if the idea of the accepted application infringes upon one's invention/existing patent, if the coverage of the proposed patent is very wide which may be detrimental to one's research or if the idea is not novel and so on.

Q. What is 'mail box' provision?
A. It s historical as of present. TRIPS required that countries, not providing product patents in respect of pharmaceuticals and chemical inventions had to put in a mechanism for accepting

product patent applications w.e.f. 1 January 1995. Such applications will only be examined for grant of patents, after suitable amendments in the national patent law have been made. This mechanism of accepting product patent applications is called the "mail box" mechanism. India has presently amended its Act mail box application concept is irrelevant as India has phased out Transitory clause as required under TRIPS and along with it EMR (exclusive marketing rights) Concept. Chapter IV A covering sections 24Ato 24F on EMR stands repealed

_____ Paris Convention _____

Q. Is India a signatory to the Paris Convention and the Patent Corporation Treaty?
A. Yes.

Q. What is the Paris Convention?
A. The Paris Convention is an international convention for promoting trade among the member countries, devised to facilitate protection of industrial property simultaneously in the member countries without any loss in the priority date. All the member countries provide national treatment to all the applications from the other member countries for protection of industrial property rights. The Convention was first signed in 1883. Since then, the Convention has been revised several times, in 1900 at Brussels, in 1911 at Washington, in 1925 at The Hague, in 1934 at London, in 1958 at Lisbon and in 1967 at Stockholm. The last amendment took place in 1979. India became a member of the Paris Convention on December 7, 1998. (Readers may note the use of the phrase 'Industrial Property' and not Intellectual Property).

Q. What are the principal features of the Paris Convention?
A. The principal features of the Paris Convention have been listed below:
- National treatment
- Right of priority
- Independence of patents
- Parallel importation
- Protection against false indications and unfair competition

Q. What is the meaning of national treatment under the Paris Convention?
This is a very important concept and is essential for successfully achieving the fundamental aim of the Paris Convention. The idea is to provide equal treatment to applications from member countries, in a given member country and not to differentiate between the nationals of your country and nationals of the other countries for the purpose of grant, and protection of industrial property in your country. Imagine that a national of country X applies for grant of a patent in India. According to the Paris Convention, the Indian Patent Office shall apply the same norms and rules, to the applicant from X, as applicable to an Indian applicant, for granting a patent. Similarly the applicant from X shall have the same protection after grant and identical legal remedies against any infringement shall be available to the applicant provided the conditions and formalities imposed upon Indians are complied with. No requirement as to domicile or establishment in the country where protection is claimed may be imposed.

Q. What do you understand by the right of priority and what is its significance?
A. The date from which patent right is deemed to start is usually the date of filing of complete specification. To obtain rights in other member countries, the application must be filed on the same day in other member countries if it is desired to have the rights started from the same day. However, there are practical difficulties in synchronizing the activities. For facilitating simultaneous protection in member countries, the Convention provides that within 12 months of national filing, if patent applications are filed in those member countries, the patents, if granted in member countries, will be effective from the date of national filing. This right is known as the right of priority. In other words you maintain the priority or the same date of filing in all the member countries and no one else in those countries can obtain the patent rights on a similar/identical invention from the same or a later date.

In case the applicant after a second look at the patent application finds that the patent contains more than one invention or on his own accord wishes to divide the application, he can claim the initial date of priority for subsequent patent applications. The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.
Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

Q. What is implied by importation in relation to working of a patent under the Convention?
A. Importation is considered as working of patent, provided the patented product is manufactured in a member country and is imported into another member country which has also granted a patent on the same invention to the same applicant. Imagine that a product X has been patented in two member countries A and B. The product X is then manufactured in country A and imported into the country B. This product X shall enjoy the same patent protection in the country B even though it has been manufactured in the country A. This would also be considered as if the patent has been worked in country B.

Q. Is there a provision for compulsory license in the Paris Convention?
A. Yes, each member country shall have the right to provide for the grant of compulsory licenses to prevent the abuses resulting from the exclusive rights conferred by the patent. Compulsory licenses for failure to work or insufficient working of the invention may not be requested before the period of time of non-working or insufficient working has elapsed. This time limit is four years from the date of filing of the patent application or three years from the date of the grant. Such licenses will be a non-exclusive and non-transferable one.

Q. Is there any relationship between the Paris Convention and the TRIPS Agreement?
A. It has been made mandatory for the member countries of the TRIPS Agreement to comply with the Article 1 to 12 and Article 19 of the Paris Convention.

Q. What are the other advantages of joining the Paris Convention?
A. There are a number of international conventions and treaties, which are open only to the members of the Paris Convention. Some of these are:

- Patent Cooperation Treaty (PCT)
- Budapest Treaty (for deposition of microorganisms)UPOV (for protection of new varieties of plants)
- Madrid Agreement (for repression of false or deceptive indications of source on goods)
- Madrid Protocol (concerning registration of marks)
- Hague Agreement (concerning deposits of industrial designs)

_____ Patent Corporation Treaty _____

Q. What is patent cooperation treaty (PCT)?
A. The patent cooperation treaty (PCT) is a multilateral treaty entered into force in 1978. Through PCT, an inventor of a member country (Contracting state of PCT can simultaneously obtain priority for his/her Invention in all/ any of the member countries, without having to file

a separate application in the countries of interest , by designating them in the PCT application .India joined the PCT on December 7, 1998.

Q. Who coordinates the activities of PCT?
A. All activities related to PCT are coordinated by the World Intellectual Property Organization (WIPO) situated in Geneva.
The competent authorities for PCT filing from India are
1. The Patent Office, at Kolkata, New Delhi, Mumbai, and Chennai
2. International Bureau, Geneva, Switzerland.

Q. What is the need for PCT?
A. In order to protect your invention in other countries, you are required to file an independent patent application in each country of interest; in some cases, within a stipulated time to obtain priority in these countries .This would entail a large investment, within a short time, to meet costs towards filing fees, translation, attorney charges etc. In addition you are making an assumption which, due to the short time available for making the decision on whether to file a patent application in a country or not, may not be well founded.
Inventors of Contracting States of PCT on the other hand can simultaneously obtain priority for their inventions without having to file separate application in the countries of interest; thus saving the initial investments towards filing fees, translation etc. In addition the system provides much longer time for filing patent application in member countries. The time available under Paris Convention for securing priority in other countries is 12 months from the date of initial filing. Under the PCT, the time available could be as much as minimum 20 and maximum 31 months. Further, an inventor is also benefited by the search report prepared under the PCT system to be sure that the claimed invention is novel. The inventor could also opt for preliminary examination before filing in other countries to be doubly sure about the patentability of the invention.

Q. How are patent applications under PCT handled?
A. The patent office or any other office designated by each contracting state becomes a receiving office for receiving patent applications. These applications are referred to International Searching Authorities (ISA) which usually the patent offices, appointed to carry out the patent search on a global basis. In case the receiving office is also an ISA, a separate referral is not required. There is also a provision to get a patent application examined by international preliminary Examining Authorities which, in most cases are ISA.
International Searching Authorities (ISA) being:
- Austrian Patent Office (AT)
- Australian Patent Office (AU)
- European Patent Office (EP)
- China Intellectual Property Office (CN)
- United States Patent & Trademark Office (US)
- Swedish Patent Office (SE)

Q. What is the meaning of delayed processing of the application by the national phase or the regional phase?
A. A search report on the patent application filed with a receiving office is received by the applicant/inventor 16 months after the priority date which is nothing but the date of submitting the application in the receiving office. The International Bureau of the WIPO publishes the application and the search report 18 months after the priority date. The original application is then sent to the designated offices indicated in the application. Within two months of this i.e. by the 20th month, the applicant will have to formally apply to the patent offices of these countries for grant of patents by paying official fees and completing other formalities stipulated by these offices (some countries). In case translated copies of the application are required, the same has to be furnished by the applicant. In spite of submitting the request for grant of patents in designated countries in the 20th month after the priority

date, the priority in these countries is the same as the date of filing the original PCT application.
If applicant/inventor has requested for an examination report, the report is usually received by the applicant /inventor about 28 months after the priority date. Within two months of this, the applicant/inventor will have to formally apply for grant of patents in designated countries .The priority of the application is maintained in the designated countries.

Q. What is the benefit of the delayed processing?
A. (a) By the end of the 20th to 31st month the applicant is in a better position to assess the quality of the invention being protected as a detailed search report or an examination report or both would be available to help making an assessment.
(b) Applicants can re-evaluate their decision about filing applications in all the designated countries after a long gap of 20 to 31 months.
(c) If not satisfied, applicants may decide to drop a few countries from the list. This decision would also be influenced by the changing market conditions.
(d) Applicants can delay their investment in respect of the national phase or the regional phase applications by 20 to 31 months without sacrificing priority.

Q. Which is the appropriate office in India in relation to international applications?
A. An international application can be filed in any of the Branch Offices of the Patent Office located at New Delhi, Chennai, Mumbai and Kolkata (Head Office). Any of these Offices shall function as receiving office, designated office and elected office for the purpose of international applications filed under the Treaty.
An international application shall be filed in the Patent Office which would process the application in accordance with these rules and the provision under the PCT.

Q. Will an international application designating India be treated as an application for grant of patent under the 1970 Act?
A. Yes, an international application designating India shall be treated as an application for patent under the Act.

Q. What is the cost of filing a PCT application?
A. The schedule of fees is for filing with International Bureau directly:
is reflected in WIPO page for fees: http://www.wipo.int/pct/en/fees/index.html
Search fees are additionally payable
#All fees payable are reduced by 75% for applications filed by any applicant who resides in a PCT Contracting State where the per capita national income is below 3000 US dollars. If there are several applicants, each must satisfy the criterion. It may be noted that no concessions are available in the national phase or regional phase applications; respective fees in these phases will have to be paid by the applicant.

Q. Where do you pay the fees and in which currency?
A. All types of fees are payable at the receiving office and it is the responsibility of the receiving office to remit the search fees to the concerned office if the receiving office is not the search authority. Similarly, all other charges due to other agencies would be remitted by the receiving office. The fees are payable in the currency acceptable to the receiving office as an Indian you can pay all the fees in Indian rupees.

Q. What is the Budapest Treaty?
A. This is an international convention governing the recognition of deposits in officially approved culture collections for the purpose of patent applications in any country that is a party to it. Because of the difficulties and on occasion of virtual impossibility of reproducing a microorganism from a description of it in a patent specification, it is essential to deposit a strain in a culture collection centre for testing and examination by others. The Treaty was

signed in Budapest in 1973 and later on amended in 1980. India has become a member of this Treaty, with effect from December 17, 2001.

Q. Are there any differences in the filing of patent applications in respect of microbiological inventions and other inventions?
An inventor is required to deposit the strain of a microorganism in a recognized depository which assigns a registration number to the deposited microorganism. This number needs to be quoted in the patent application. Obviously a strain of microorganism is required to be deposited before filing a patent application. It may be observed that this mechanism obviates the need of describing a microorganism in the patent application. Further, samples of strains can be obtained from the depository for further working on the patent. There are many international depositories in many countries, which are recognized under the Budapest Treaty.

Q. What is the system for protecting microbiological inventions and microorganisms?
A. The Indian Patent Act has no specific provision for patenting of microorganisms and microbiological processes. However, as a matter of practice microorganisms per se are not patentable in India. (However, a recent decision of the Kolkata High Court has held that microbiological processes are patentable in India). In order to meet the obligation under TRIPS, India is required to introduce a patenting of microorganisms. Draft laws in this regards have been formulated. It may, however, be noted that many countries allow both process and product patents in regard to microbiological inventions and microorganism per se. all such countries allow patenting of genetically modified microorganisms but a few also allow patenting of naturally occurring microorganisms if isolated from nature for the first time and if other conditions of patentability are satisfied.

Q. Does India have any law for protecting new plant varieties?
A. Yes, India has enacted the New Plant Variety and Farmers Rights
Protection Act in 2001 which, in addition to meeting the technical features of UPOV, provides rights to farmers to use the seeds from their own crops for planting the next crop. Further, there are provisions for benefit sharing with farmers and penalty for marketing spurious propagation material.

Q. Is there any system for protecting new plant variety?
A. New plant varieties cannot be protected in India at present. However, in many countries such plants can be protected through Breeders Rights, patent and UPOV Convention India is under an obligation to introduce a system for protecting new plant variety. The protection can be through patent or a sui generis system or a combination of these two systems.

Q. What is UPOV?
A. UPOV is an abbreviation of Union Pour la Protection des Obtentionsw Vegetable (Union for protection for new varieties of plant). It is an international convention which provides a common basis for the examination of plant varieties in different member States of UPOV for determining whether a plant variety merits protection under UPOV or not.

Q. What are the criteria for deciding protection of plant varieties?
A. There are 5 main criteria to arrive at a decision whether a plant variety is really new or not. These have remained unchanged between 1978 and 1991 Acts of the Convention. These criteria are:

1. Distinctness: The variety shall be deemed to be distinct if it is clearly Discountable from any other variety whose existence is a matter of common knowledge at the time of filing of the application .The object of this criterion is to ensure that the candidate variety can be identified amongst all other varieties whose existence is known, whether or not they are protected. An application for protection or for the entry of a variety in an official register in any country causes the variety to be recorded as a matter of common knowledge. In other

words, the application for the protection should be filed with UPOV before disclosing it to any other agency.

2. Uniformity: The variety shall be deemed to be uniform if, subject to the variation that may be accepted from the particular features of its propagation, it is sufficiently uniform in its relevant characteristics. .The objective of this criterion is to ensure that the individuals representing the variety which is a candidate of protection form a group which is identifiable on the basis of the description of its characteristics. In other words, the variation between individuals within a variety must be less than that within a species. In the absence of this condition it would become impossible to identify distinct varieties within species.

   The degree of uniformity is determined taking into account the mode of reproduction of the species and all the genetic structure of varieties. The same levels of uniformity cannot be required for a strictly self pollinating species or for a species which is vegetatively propagated. An acceptable level of uniformity would ensure that it can be used for agricultural production. In this regard the difference between the protection, given by UPOV and patent system can be noted.

3. Stability: The variety shall be deemed to be stable if its relevant characteristics remain unchanged after repeated propagation or, in the case of a particular cycle of propagation at the end of each such cycle. The idea is to ensure that the variety will be identical to the description established at the moment of granting protection after repeated propagation.

   Stability, as well as uniformity may be lost if the rights holder fails to maintain the variety true to the description established when the rights were granted.

4. Novelty: The variety shall be deemed to be new if, at the date of filing of the application for breeders' right, propagating or harvesting material of the variety has not been sold or otherwise disposed of to others, by or with the consent of the breeder for the purpose of exploitation of the variety. It is also understood that a variety to which people have had free access in the past cannot be protected because then the interest of those who have relied on the free access, will suffer.

   As it is some time necessary to see the response of the market to new varieties before deciding whether or not to apply for protection, grace period has been included. The period is one year prior to the date of application in the country where the application is filed and in countries other than that in which the application has been filed and six years in case of trees and vines and four years for all other species.

5. Appropriate denomination: The variety shall be designated by a denomination which will be its generic designation. The premise that the variety denomination must be its generic designation class for a requirement that 'denomination must enable the variety to be identified'. Users and consumers need to have some method of knowing that a sample is a sample of a particular identified plant variety; because it is often not possible to identify it from its appearance. This is facilitated by requiring that a specific denomination and only that denomination be used to identify a variety in trade.