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Intellectual Property Rights (IPR) - A Technical Knowhow in India



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Abstract

Intellectual Property Rights (IPR) or Patents are the exclusive rights given to a person for an invention in any branch of technology whether products or processes which is patentable if they meet the Criteria of being NOVEL, involving an INVENTIVE STEP and being capable of INDUSTRIAL APPLICATION. The laws which govern the intellectual property in India are well established at all levels- statutory, administrative and judicial. India is in agreement with World Trade Organisation (WTO) and also member of various treaties like Paris convention, PCT, Budapest Treaty. India is also part of Trade Related Aspects of Intellectual Property Rights (TRIPS) which came into force from 1st January 1995 which governs with minimum standards for protection and enforcement of intellectual property rights in member countries sufficiently required to promote effective and adequate protection of intellectual property rights.

The IPR are segregated into 5 different types of following areas:-

1. Patents
2. Trade Marks
3. Copyrights
4. Geographical Indications
5. Industrial Designs

Intellectual Property Rights (IPR) are governed by The Patents Act 1970 and Patents Rules 1972, which came into force on 20th April 1972 which was earlier known as Indian Patents and Designs Act 1911. The Patents Act earlier associated with only process patents with regard to inventions related to drugs, medicines, food and chemicals. The emergence of Pharmaceutical companies to larger extent gave a new path to India which became signatory to many international agreements to strengthen the industry in regard to patent law in association with globalization. The first and the foremost step towards the goal achievement was becoming the member of the Trade Related Intellectual Property Rights (TRIPS) system.

Later India also became signatory of the Paris Convention to enter convention countries and the Patent Cooperation Treaty to file single application for many countries on 7th December 1998. Signing the Budapest Treaty on 17th December 2001 for deposit of biological material was also one of the significant steps to match the standards of international market.

Various amendments came into picture since 1999 Patent Act amendments such as Introduction of Section 5(2) that provided filing of applications for patent in the field of drugs, medicines and agrochemicals and Provision of Exclusive Marketing Rights (EMR), The amendment also brought omission of Section 39 from the Act, thereby enabling the Indian residents to file the applications for in an outside India simultaneously. A separate chapter was added in Patent rules to deal with International Applications under PCT.

The Patents (Amendment) Act, 2002 featured the substantial amendments such as Increase in Term of Patent under Section 53 of Indian Patent Act from 14 to 20 years. Publication of application after 18 months from the date of filing by bringing India at par with the rest of the world. Microorganisms became patentable, and Traditional knowledge was included in "what are not inventions" under section 3. Specific Definition of "invention" was made in regard to follow provisions of TRIPS the concept of inventive step, thereby enlarging the scope of invention. Introduction of Section 39 that includes prohibition of Indian residents to apply abroad without prior permission or first filing in India.

Section 116 introduced with formation of Appellate Board to appeal against certain cases refused by Controller. Exemption to Bolar provision for the benefit of agrochemical and pharmaceutical Industry introduced under section 107 A. The third amendment to the Patents Act, 1970 came into force as The Patent (Amendment) Act, 2005. Many remarkable amendments were observed: Deletion of Exclusive Marketing Rights (EMR). Advent of "product patent regime" in India.

What are Inventions?

The criteria for patentability of an invention are:

1. Novelty,
2. Inventive step and
3. Industrial applicability

Under Section 2(1)(j) of the Patent Act, 2005, the “invention” means a new product or as process involving an inventive step and capable of industrial application. Under the Act “New invention” is also defined under section 2(1)(ja) of the Patents Act “New invention” means any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification, i.e., the subject matter has not fallen in public domain or that it does not form part of the state of the art. So the Patent Act defines absolute novelty which is not anticipated and not in public Domain, i.e. the invention should have neither been used anywhere in the world nor published in any part of the world [1].

Types of Patent Applications

Provisional application

This is a temporary application filed with a Patent Office to claim a “Priority Date”(First Filing), It is filed at a stage when an invention is not complete in all aspects. This application is relatively inexpensive to prepare and file, helps enables the inventor to study market potential till he files complete application with filed within 12 months or else it will be treated as abandoned under section 9(1). This application may or may not contain claims.

Complete application

A patent application containing the complete specification and claims of the invention is called a complete application and this can be filed directly if the invention is complete in all aspects.

Convention application

When an applicant files the application for a patent, claiming a priority date based on the same or substantially similar application filed in one or more of the convention countries under section 133, it is called a convention application. The applicant should file the application in the Indian Patent Office first and within twelve months from the date of first filing can file similar application in the convention country [2].

Patent cooperation treaty (PCT)-international application

It is an international agreement for filing patent applications having effect in up to 154 countries. PCT enables an applicant to file in multiple countries by single PCT application the application is to be filed in English language within 12 months from the date of filing in India.

PCT-national phase application

An international application made according to the Patent Cooperation Treaty (PCT) being the first application, can enter the national phase in India within 31 months from the international filing date or priority date (whichever is earlier). This application filed before the Controller in the Indian Patent Office claiming the priority and international filing date is called PCT National Phase application. The filing date of the application shall be the international filing date accorded under the Patent Cooperation Treaty.

Where to File?

The jurisdiction for filing the patent application depends upon

- i. Indian applicant(s): determined according to place of residence, place of business of the applicant or where the invention actually originated.
- ii. Foreign applicant(s): determined by the address for service in India.

How to Apply for Patents

An application for a patent for an invention can be made by any of the following persons either alone or jointly with another:

- i. True and First inventor
- ii. Assignee of True and First inventor
- iii. Legal representative of deceased inventor or assignee

Foreign Filing License: No person resident in India shall, except under the authority of the written permit can file any application outside India for the grant of a patent unless:

- i. An application for a patent for the same invention has been made in India not less than 6 weeks before the application is filed outside India, and
- ii. Either no secrecy direction has been given under Section 35(1) in relation to the application in India or all such directions have been revoked.

A request for foreign filing license may be filed on prescribed form with detailed description of the invention and the drawings, if any, and the prescribed fee.

What are Not Inventions?

Section 3 and Section 4 of the Act, deals with non patentable inventions

Section 3

A. Inventions which are frivolous or contrary to well established natural laws.

B. Inventions whose primary or intended use or commercial exploitation could be contrary to public order or morality (such as something against accepted norms of

a culture in a society), 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. However isolation of living thing or non-living substances is patentable as it involves human technical intervention.

D. 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 mere discovery of any new property, or new use of a known substance, or mere use of known process, machine, or apparatus unless such known process results in a new product or employs at least one new reactant.

E. Explanation to Section 3 (d): "Salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations, and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy. (Famous Gleevac Case: Novartis v. Union of India & Others which specified the Efficacy in Terms of Therapeutic Efficacy).

F. Substances obtained by mere admixture such as physical admixture are not patentable under the Act.

G. The mere arrangement or rearrangement or duplication of known devices each functioning independently of one another in a known way.

H. Methods of agriculture or horticulture.

I. Processes for medical, surgical, curative, prophylactic, diagnostic, therapeutic, or other treatment of human beings or animals or plants that would render them free of disease or to increase their economic value.

J. Plants and animals in whole or any part thereof other than microorganisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals.

K. Computer program per se, a mathematical method or a business method or algorithms.

L. Literary, dramatic, musical or artistic work or any other aesthetic creations including cinematographic works and television productions are not patentable as they are covered under the copyrights, design and entertainment laws.

M. Scheme/rule/method of performing a mental act or method of playing a game.

N. Presentation of information.

O. Topography of integrated circuits.

P. An invention falling within the scope of traditional knowledge such as the use of herbal medicines.

Section 4

Inventions relating to atomic energy are not patentable under section 4. Such applications are referred to the Department of Atomic Energy. The decision of the Department of Atomic Energy is final and no appeal lies to the decisions of the Department of Atomic Energy [3].

Publication

Every application is ordinarily published after the expiry of 18 months period from the date of filing of the application or the date of priority of the application whichever is earlier. An early publication can be requested by the applicant through a request in prescribed form and fee.

Few Exemptions to Early Publication Are

A. Secrecy directions are imposed under Section 35 of the Act.

B. Application has been abandoned under Section 9(1) of the Act.

The applicant has withdrawn his application three months prior to the expiry of said prescribed period of 18 months.

Implications of publication

On and from the date of the publication of the application for patent and until the date of grant of patent in respect of such patent, the applicant will have like privileges and rights as if the patent for the invention have been granted on date of publication of application except for filing suit for infringement

Request for examination

The request for substantive examination by applicant or any other interested person has to be filed on prescribed form, with the prescribed fee, after the publication of patent application, but within 48 months from the priority date of the application or from the date of filing the application whichever is earlier. The applications only be examined if Request for examination (RFE) filed under section 11 B. After this receipt of request for examination the First Examination Report (FER) generated. The first examination report is issued ordinarily within 6 months from the date of the request for the examination or 6 months from the date of publication whichever is later. Time for putting the application in order for grant under section 21 is six months with extension of 3 months as per latest 2016 amendments. Therefore, it is necessary to comply with all the requirements and objections raised by the patent office within stipulated time. Once all the requirements are met with and the examiner is satisfied with the arguments and amendments of the applicant, the application proceeds for grant. The grant is notified in the Patent Journal, published weekly by the Indian patent office [4].

Oppositions Proceedings

The Indian Patent system provides for two opposition proceedings, one before the grant of the patent and one after the grant of the patent to justify the rights of person interested in subject matter related to invention.

The grounds for Pre and Post Grant Opposition are the same namely:

- a. Wrongful obtaining of Invention,
- b. Prior publication,
- c. Prior claiming,
- d. Prior public knowledge and use,
- e. obviousness,
- f. Not an invention,
- g. Insufficiency of disclosure,
- h. Failure to file the information regarding foreign filing under Section 8
- i. Convention application not made within 12 months,
- j. Not disclosing or wrongly mentioning the source and geographical origin of biological material in the complete specification,
- k. Complete specification was anticipated having regard to the knowledge, oral or otherwise available within any local or indigenous community in India or elsewhere (traditional knowledge).

Pre grant procedures

The pre grant representation may be filed by any person within six months of date of publication of the application or before the grant of the patent whichever is later. It may be noted that the Controller is empowered to grant the patent soon after six months from date of publication.

Post grant opposition procedure

The process of post grant opposition initiates with a notice of opposition filed by the opponent (who is an 'interested person') within 1 year from the date of publication of grant along with full written statement and evidence to the Controller.

Term of patent

The term of every patent granted under the Act is twenty years from the date of filing. The term of patent in case of International applications filed under the PCT, designating India, is twenty years from the international filing date accorded under the PCT. Patent remain in force with payment of renewal fee annually (Annuity). Patent Act also provides law for Restoration of patents under section 60 is possible if applied within 18 months from the date of lapse.

Intellectual Property Appellate Board (Ipab)

The Intellectual Property Appellate Board (IPAB) came into force with effect from April 2, 2007. Section 117A provides for appeals to the Appellate Board. IPAB is an administrative body that has the appellate jurisdiction over the decision of the Controller of Patents. However, IPAB has no statutory powers to trial infringement proceedings. As per section 117G of the IPA, all cases that are related to decisions or orders of the Controller which are pending in the High Court must be transferred to IPAB. The IPAB accept appeals against the decision of the Controller or Central Government of India in various matters such as, Any decisions related to refusal of amendment in application (u/s 15), Division of application (u/s 16), Dating of application (u/s 17), anticipation issues (u/s 18), cases of potential infringement (u/s 19), Substitution of applicants (u/s 20), amendment or revocation in opposition u/ 4 sub section of 25, Mention of inventor as such (u/s 28), Co-owners of the patent (u/s 51), Patent of Addition (u/s 54), any amendment of application or specification (u/s 57), Restoration of lapsed patents and disposal of related application, (u/s 60 and 61), Surrender of patents (u/s 63), revocation of patent in public interest (u/s 66), Registration of assignment (u/s 69), correction of clerical errors (u/s 78) Grant of compulsory license (u/s 84), Revocation of patent for non-working (u/s 85), Grant of compulsory license by controller (u/s 88), Licensing (u/s 91), special provisions of compulsory license (u/s 92) and Termination of compulsory license (u/s 94)

Patent rights

The Act provides the patentee exclusive for patent protection for inventions relating to both processes and products which prevent the third party to infringe the right related to use of patented article in any form it.

Registration of assignment

Under the Act, registration of assignment can be done in transferring the rights of patented invention as movable property. The license Agreement has to be registered under section 69 of the Patents Act at the appropriate Patent Office by filing prescribed form with the prescribed fee.

Commercial working of patents

Section 146(2) provides every patentee and licensee to furnish to the Controller periodical statement of the extent to which the patented invention has been worked on commercial basis in India in Form 27. Such statements are a mandatory requirement, Failure of which can lead to a penalty. It can also attract to provisions of grant of compulsory license under section 84. A statement of working would remain confidential till such time and if at all it is published by the Controller.

Compulsory License

The Compulsory License (CL) under Sections 84 to 94 of the Patents Act is an important benefit granted to a person whose

wants to use the technology of invention if the patentee in any case is using his rights unreasonably. A person may apply for a compulsory license three years after the grant of a patent on the following grounds:

1. the reasonable requirements of the public have not been satisfied, or
2. patented invention is not available at a reasonable affordable price or
3. the patented invention is not worked in India.

In exceptional circumstances Compulsory license may also be granted on notification by Central Government such as in context to public interest namely national emergency, extreme urgency example scarcity of petroleum products, earthquake etc, and public non-commercial use. The Controller will notify and grant licenses without any consideration as in other cases in respect of patents on such terms and conditions that the article is available to the public at lowest price.

Revocation of the Patent for Nonworking

In considering the application for the grant of compulsory license, the Controller shall take consideration of few points into account the nature of the invention; The time which has elapsed since the sealing of the patent; the measures already taken by the patentee or any licensee to make full use of the invention;

the ability of the applicant to work the invention to the public advantage; Capacity of the applicant to undertake the risk in providing the capital and working the invention; Whether the applicant has made efforts to obtain a license from a patentee

on reasonable terms and conditions and such efforts have not been successful within a reasonable period (6 months) as the Controller may deem fit. Where the Controller is satisfied the conditions in which the CL was granted has not met he may order to revoke the patent.

Patent Infringement

Last but not the least the rights of patentee are protected, and are liable to legal procedures if violation occurs by any third party. Patent infringement is the commission of a prohibited act with respect to a patented invention without permission from the patent holder. It occurs when someone violates the patent rights an inventor has in his invention by making, using or selling the invention without the patent owner's permission (or if the patent has been licensed), in a way not permitted by the license. In case of Infringement the patentee can claim damages such as Compensatory damages-a patent owner may recover lost profits or infringement Increased damages- up to three times the compensatory damages can be recovered in cases of willful or deliberate infringement Preliminary injunctions- Preliminary Injunction is desired at the outset of lawsuit. Permanent injunctions- A patent owner may stop the infringer from producing the products permanently.

References

1. The Patents Act 1970.
2. The Patents manual of IPO.
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4. <http://www.ipindia.nic.in/manuals.htm>



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