

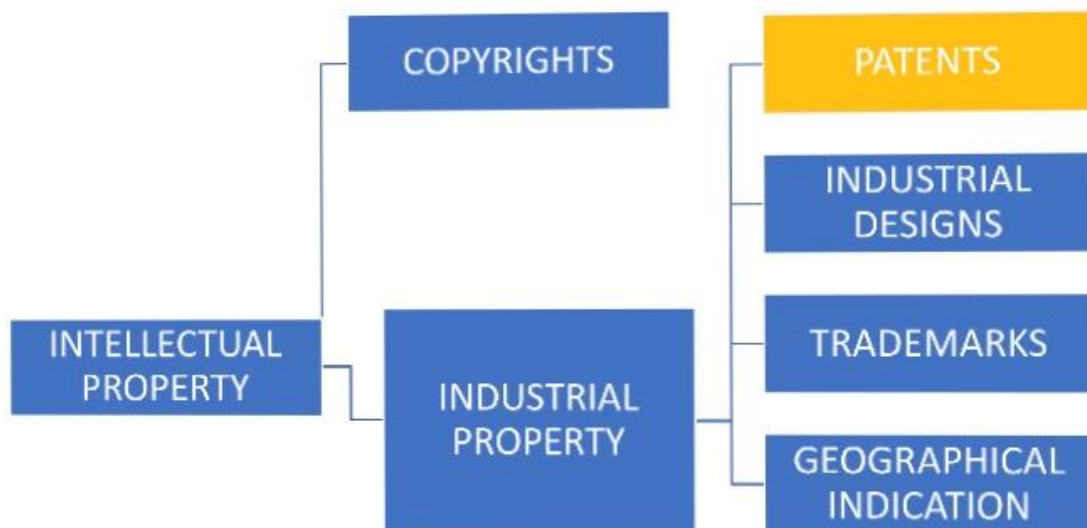
LET'S TALK ABOUT PATENT ACT, 1970

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INTRODUCTION



A patent is an exclusive right granted for an *INVENTION*.

Section 2(1) (j) of the Indian Patent Act, 1970 defines “invention” as:

1. New product or process
2. Involving an inventive step
3. & capable of Industrial application

THREE TESTS OF PATENTABILITY

- *Novelty*

The novelty test requires the invention to be innovative and new. The invention will be compared to prior art, or everything created in the past. This test is fairly easy to pass as well. Only if there is a product in the past that is identical to the invention will it receive rejection for a patent. Many times, products with simple changes will pass this test, but they face challenges in the final test.

In the case of *Lallubhai Chakubhai Jariwala v. Chimanlal Chunilal and Co.*ⁱⁱ, the Court pronounced that even though the two most essential components of a patent are novelty and utility, the innovation's uniqueness is the actual test of the patent.

- *Utility*

The utility test decides how useful the new product is in the real world. The inventor explains how the invention is applicable and will be used. In most cases, the inventor does not have to prove the invention works. The exception to that is in the medical field, which requires laboratory or clinical test results to prove the effectiveness. The term "utility" is used in a special sense and not in an abstract sense. Thus, mere usefulness would not be sufficient to support a patent.ⁱⁱⁱ

An invention must have commercial use or manifestation. Furthermore, even though an alleged invention may not be a final product, the same will be patentable only if it has some commercial viability. Thus, it is not the product that is the focus of attention but the actual physical substance created which has the potential of a commercial manifestation.^{iv}

- *Inventiveness*

The inventiveness test is the toughest test of the three to pass. In order to pass, the invention will be compared to prior art and the differences found must not be obvious to a person with skill in the relevant field. If an ordinary worker could have discovered the same invention it is considered obvious and will be rejected of a patent.

The Patents Act defines inventive step as “a feature of an invention that involves a technical advancement 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.”^v

Once the invention has passed these three tests it is approved for a patent and the inventor’s intellectual property is protected! Of course, there are laws and regulations when filing for a patent.

NOVARTIS CASE ^{vi}

(Ever Greening of Patents)

In this case the company was trying to patent a new medicine which was a slightly altered (not better) version of an already patented medicine.

This was rejected by the Supreme Court as an action to prevent ever greening of patent.

Ever greening of patents not allowed u/s 3(d) of the act which states:

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 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. -For the purposes of this clause, 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.^{vii}

INDIA gives both, mostly process patent is given to food & pharmaceutical industries.

HISTORY

The Venetian Patent Statute, 1474

The Venetian Patent Statute was a law created in Venice in 1474. It gave inventors the right to exclusively make and use their inventions for a period of ten years. This was the first known patent law and included procedures for securing and enforcing the right to exclude others from using the invention.^{viii}

The Indian Patents and Designs Act, 1911

This Act brought patent administration under the management of Controller of Patents for the first time.^{ix}

Patents Act, 1970

This Act repealed and replaced the 1911 Act so far as the patents law was concerned. However, the 1911 Act continued to be applicable to designs.^x

Patent Rules, 1972

Most of the provisions of the 1970 Act were brought into force on 20th April 1972 with publication of the Patent Rules, 1972.^{xi}

India joined WTO & TRIPS in the year 1975

Patent (Amendment) Act, 2005^{xii}

Reasons

- FastTrack mechanism
- Protection of biodiversity and knowledge
- Public health emergency
- Revocation of patent in public interest & also on security considerations.

PROCEDURE FOR GRANT OF PATENT

Filing of application for patent can be *provisional* or *complete*.

Filing a provisional patent application is not the same as an official patent application. The provisional patent application marks your invention as "patent pending." This gives you time to get everything to finish the non-provisional application, which is the binding patent form.

The applicant then further gets 12 months of filing complete application from the date of filing provisional application.

PRIORITY DATE (term of **20 YEARS**) also begins from this date.

- Request for EXAM of application by the Indian Patent Office
- Patent Office examines and issues FIRST EXAM REPORT
- Applicant get 12 months to comply objections raised in FIRST EXAM REPORT otherwise application is considered as abandoned.
- Applicant get 12 months from FIRST FILING date to file in foreign countries.
- Can file individually – PARIS CONVENTION
- Can file in 153 countries - The Patent Cooperation Treaty (PCT)

Application is always individual but PCT will allocate time and uniformity.

If someone is filing a patent and i have objection then i can opt for:

- Pre- Grant Opposition

When an application for a patent has been filed, it is published after 18 months from the filing date. Any person can file a pre grant-opposition before the grant of the patent, but after a period of **6 months** from the date of publication of the application; section 25(1).

- Post – Grant Opposition

After a patent has been granted, (12 months) within one year of the publication of the grant of the patent, any person interested can file post grant-opposition against the grant of the patent. Post Grant opposition can be filed on the grounds mentioned in section 25(2).

In the official journal of the patent office, both opposition are after publication of application.

GROUNDINGS OF OPPOSITION

- The patentee or the applicant wrongfully obtained the invention from the opponent or a person from whom the opponent derives title.
- The invention was published before the priority date, subject to the limitations on anticipation under section 29 Patents Act, 1970.
- The invention was previously claimed in an Indian application having an earlier priority date.
- The invention was publicly known or publicly previously used in India and if an invention relates to a process then it shall be deemed to publicly known or publicly used in India when a product made by that process had already been imported into India before the priority date;
- The invention lacks any inventive step over any prior publication or over any prior use in India.
- The subject matter of the invention is not patentable under the Patent Act 1970.
- The disclosure of the invention or the method by which it is to be performed is not sufficient and clear.
- The patentee has failed to disclose or has furnished false information regarding foreign applications.
- There is no disclosure or wrong mentioning of the source and geographical origin of the biological material used for the invention.
- The invention is anticipated by the tradition knowledge in India or elsewhere.

Filing Patent by Foreigners in India

India is a signatory to the Paris Convention for the Protection of Industrial Property, 1883 and the Patent Cooperation Treaty, 1970, so a foreign entity too can apply for a grant of patent in India.

If individual files a grant of patent in the country of the convention, a similar application can be filed in India for the same. The filing of the application in India should be done within twelve months from the date of filing in the convention country.^{xiii}

LIMITATIONS

As per Sections 3 and 4 of the Indian Patent Act, the following innovations are not Patentable in India^{xiv}:

1. An invention that is frivolous or trivial
2. An invention that claims anything obviously contrary to well established natural laws
3. The mere discovery of a scientific principle
4. Moreover, an invention whose primary goal or intended use is contrary to law or morality or is injurious to public health
5. The formulation of an abstract theory
6. Further, 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
7. 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
8. 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
9. Similarly, the mere arrangement or rearrangement or duplication of known devices, each functioning independently of one another in a known way.
10. A method of agriculture or horticulture

EXCEPTIONS

- Experimental or research use.
- Use of the patented invention on foreign vessels etc.
- For obtaining regulatory approval from authorities
- Exhaustion of patent rights & parallel imports
- Compulsory licensing and
- Use of acquisition of inventions by the government.

INFRINGEMENT

The Indian Patents Act, 1970 does not specifically define activities that constitute infringement of patents, however, **Section 48 of the Indian Patents Act, 1970**, confers exclusive rights upon the patentee to exclude third parties from making, importing, using, offering for sale or selling the patented invention, patented product or patented process. It can therefore be concluded that violation of aforementioned monopoly rights would constitute infringement of a patent.

- The colourable imitation of the invention
- Mechanical equivalents
- Carrying essential features of the invention
- Immaterial variation in the invention

Maj Retd Sukesh Behl & Anr vs Koninklijke Philips Electronics (2016)^{xv}

A counterclaim for revocation of the suit was filed by Sukesh Behl against Kononklijke under Section 64(1)(m) of the Indian Patents Act. In the original case, Koninklijke filed a suit against Sukesh Behl for the infringement of his patent rights demanding a permanent injunction against Koninklijke Philips.

The High Court of Delhi finally decided that Kononklijke had failed to comply with the requirements mentioned under Section 8 of the Indian Patents Act and hence would be made liable under Section 64(1)(m) of the Patents Act.

***Symed Labs v. Glenmark Pharmaceuticals*^{xvi}**

Symed labs filed a case against Glenmark Pharmaceuticals for infringement of two of its patents. The Court, in this case, held that there was prima facie evidence against Glenmark that they have misused Symed's patented products for manufacturing and selling in the market. It was due to this misuse that symed has suffered irreparable loss. The Court, as a result, ordered an interim injunction on the sale of the patented product by Glenmark. The Court also held that in this particular case, providing damages would not reverse the loss suffered by the plaintiff. Therefore, providing protection to the patented process was inevitable to safeguard Symed's patent rights.

JURISDICTION

- No court lower than District Court
- At cause of action or where the Defendant resides

Limitation Period

The limitation period as per the Limitation Act would commence once the cause of action has arisen, and the Petitioner cannot choose to approach the Court at any time during the life of the patent.^{xvii}

The limitation period for instituting suit for the patent infringement is **3 years** from the date of infringement and jurisdiction is the geographic area where the infringement has taken place.

Also, the burden of proof to establish that an infringement has occurred lies on the patentee.

***Bajaj Auto Limited vs TVS Motor Company Limited*^{xviii}**

This case was instituted in the year 2007 by Bajaj Auto Limited against T.V.S. Motor Company Ltd. in the Madras High Court. In this case, the court held that the cases related to copyright infringement, including the cases of patent infringement, took many years to get disposed of. The court ordered the other courts to expedite the disposal of the cases related to copyright

infringement. The parties often get caught up in getting an order for a temporary injunction. The court suggested that the proceedings related to such cases be carried out on a day-to-day basis and that decisions be announced within four months of the initiation of the proceedings

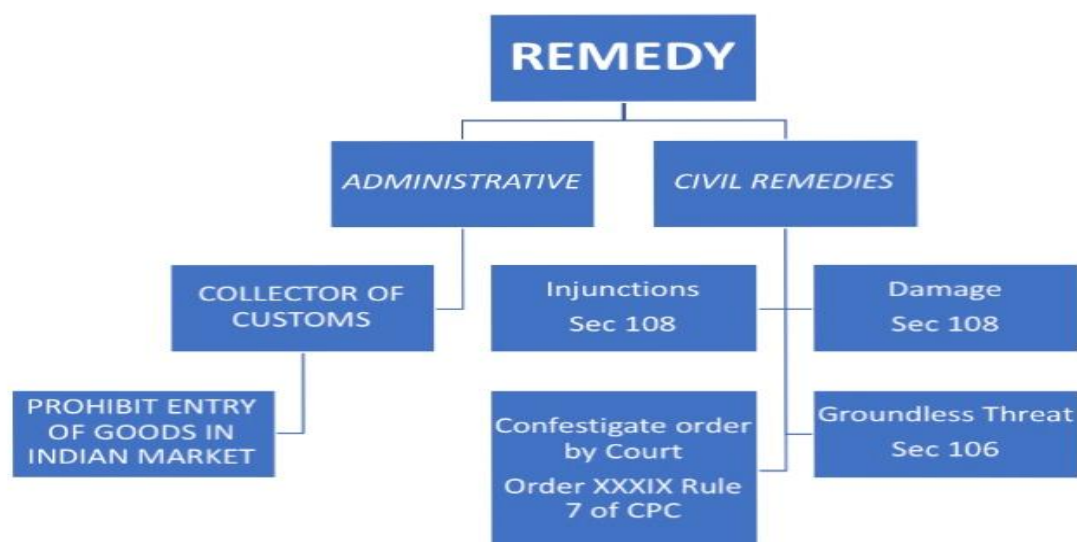
Who can file?

- Patentee
- Exclusive licensee if the license is registered
- A compulsory licensee
- Assignee

If someone wants to sue for infringement then it can institute only after the patent has been sealed. But the damages sustained in respect of an infringement committed during the period between the date of advertisement of acceptance of complete specification and the date of sealing may be claimed in the suit. ^{xix}

For the damages sustained due to the infringement committed during the period between date of publication and date of grant; a separate suit for damages can be instituted.

Lastly,



ENDNOTES

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- ⁱ The Patents Act, 1970, No. 39, Acts of Parliament, 1970 (India)
- ⁱⁱ AIR 1936 Bombay 99
- ⁱⁱⁱ Indian Vacuum Brake Co., Ltd. v. E.S. Luard AIR 1926 CAL 152
- ^{iv} Cipla Ltd. v. F. Hoffmann-La Roche Ltd. & Anr. [(2009) 40 PTC 125 (Del)]
- ^v Patents Act, 1970, Section 2(1) (ja)
- ^{vi} AIR 2013 SC 1311, (2013) 6 SCC 1
- ^{vii} Section 3(d) in The Patents Act, 1970
- ^{viii} <https://www.lsd.law/define/venetian-patent-statute>
- ^{ix} “History of Indian Patent System” on ipindia.gov.in
- ^x *ibid*
- ^{xi} *ibid*
- ^{xii} https://ipindia.gov.in/writereaddata/Portal/IPOAct/1_69_1_patent_2005.pdf
- ^{xiii} Regulations under the PCT (as in force from July 1, 2022) uploaded on <https://www.wipo.int/pct/en/texts/>
- ^{xiv} “What cannot be Patented in India?” uploaded by vakilsearch.com
- ^{xv} <https://indiankanoon.org/doc/104222721/>
- ^{xvi} 2015 SCC Online Del 6745
- ^{xvii} Bayer AG v. Controller of Patents, AIR 1982 Cal 30
- ^{xviii} (2009) 12 SCC 103
- ^{xix} <https://www.legalraasta.com/blog/patent-infringement-guide/>