

Intellectual Property Rights (IPR) and Obtaining A Patent: Indian Scenario

Jayanth Shantharam Kesave¹, Nimish Gupta² and R S Bedi²

ABSTRACT

Aim: The aim of this article is to give an overall understanding about Intellectual properties rights and to gain knowledge regarding current patent system in India

Summary: Research and research associated business is taking a good shape in India from the last few years. Clinicians and research personnel are becoming increasingly in need to have a comprehensive understanding of guidelines and frameworks of intellectual property rights in their own country and also about the conditions and systems prevailing at an international level to be competitive and to remain relevant in an increasing globalised economy. Intellectual property rights are legal rights of institutions and individual researchers who involve in invention and innovation. There are various IPR tools to obtain legal rights over the properties created by the research team. Patent system is one such important tool, which aims to give the innovators their legal share in their research products. Prevailing patent system in India allows the local researcher in registering their innovative

product in India and also helps to get a foothold in the international market.

Keywords: IPR, legal rights, patent system

INTRODUCTION

Intellectual property rights are an individual/institutions legal rights. In the changing and globalised economic situation, it is important to have a good understanding of legal implications and rights of researchers and institutions. It is equally important to understand the existing trends. This article gives an overview of IPR tools available in general and patent system in India in particular.

Intellectual property rights (IPR)

Intellectual Property Rights are legal rights, the properties per say result from intellectual activity in industrial, scientific, literary and artistic fields.¹ These rights safeguard creators and other producers of intellectual goods and services by granting them certain time-limited rights to control their use. Protected IP rights like other property can be a matter of trade, which can be owned, sold or bought. These are intangible and non exhausted consumption.^{1,2}

Intellectual Property Rights are statutory rights once granted allows the creator/s or owner/s of the intellectual property to exclude others from exploiting the same commercially for a given period of time. It allows the creator/s, owner/s to have the benefits from their work when these are exploited commercially. IPR are granted to an inventor or creator, designer in lieu of the discloser of his/her knowledge.

An *invention* is a new product or process involving an inventive step and capable of industrial application. An *innovation* is the successful exploitation of new ideas in the form of a useful machinery or process, by any person, using own intellect is called as innovation.³ Every innovation may not be patentable invention but every invention is an innovation.

TYPES/TOOLS OF IPRs:

- a. Patents.



Dr Jayanth Shantharam Kesave has done his graduation (BDS) from VS Dental College and KIMS Hospital Bangalore, Karnataka in year 1993. He has done his MDS (Oral & Maxillofacial Surgery) from AB Shetty Memorial Institute of Dental Science, Mangalore, Karnataka, India in 2000. He completed his Diploma (MOSRCS) in Oral Surgery from Royal College of Surgeons Edinburgh, UK in the year 2002. Currently he is a medical student at AIMU, St Lucia, West Indies and also working for ministry of health, Govt of St Lucia involving in facial deformity corrective surgery whilst a med student.

¹Medical student AIMU, St Lucia, West Indies, ²Department of Oral & Maxillofacial Surgery, Saraswati Dental College & Hospital, Lucknow (UP), India.

Address for Correspondence:

Dr. Nimish Gupta, Department of Oral & Maxillofacial Surgery, Saraswati Dental College & Hospital, Lucknow (UP), India.
Contact No: +91 8601989139, e-mail: jayanth.kesave@gmail.com.
Date of Submission: 10-02-2012
Reviews Completed: 10-04-2012
Date of Acceptance: 15-04-2012

- b. Trademarks.
- c. Copyrights and related rights.
- d. Geographical Indications.
- e. Industrial Designs.
- f. Trade Secrets.
- g. Layout Design for Integrated Circuits.
- h. Protection of New Plant Variety.

Governing Laws in India for IPR are:

1. Patent Act 1970
2. Trade Marks Act (1958 original) 1999
3. The Copyright Act 1957
4. The design Act 2000
5. Geographical Indication of Goods (Registration and Protection) Act 1999
6. Plant Variety and Farmers Right Protection Act 2001

Scope of IPRs

In order to be suitable for IPR registration, an invention must be novel and inventive. An invention is considered to be novel if it has not been disclosed to the public at the time that the IPR application was made. As long as the date of the application precedes any disclosure of details of the invention to the public, the invention can be validly registered as one of the various IPR tools available in the country.⁴ If however, details of the invention have been disclosed to the public before applying for the IPR rights, then the invention is no longer considered to be novel in an IPR sense and it will not be possible to protect it validly through the available IPR system.

It is important to be aware of the danger of premature disclosure of details of an invention. Even after an application has been filed, details of the invention should only be disclosed as part of a planned program of commercial exploitation. Another requirement for a valid IPR application is inventiveness. This means that the invention must contain an inventive step. This can be the most difficult thing to show. An IPR examiner may decide that the invention is obvious i.e. that somebody knowledgeable in the subject area, when familiarised with all earlier IPR rights or other technology in the area, would have immediately been led to the same conclusion.^{3,5}

Disclosing an Invention and commercialisation

Details of an invention should not be disclosed to outsiders until such time as an IPR application has been filed. It is deemed better to complete the development of the invention and file the IPR application when it becomes necessary to

make disclosures as part of a planned program of commercial exploitation. If it is necessary to talk to technical specialists or others in order to obtain assistance during the development of the invention, this should be done on the basis of confidentiality. People should be informed that the information is strictly confidential and asked to sign a simple document undertaking not to disclose the information until given permission to do so.^{5,6}

Adopting a proper commercialization strategy involves considering all aspects at the same time, technical, commercial and legal. At the initial stages proper attention should be given to the technical aspects, but once the IPR application is filed, the commercialisation should proceed as quickly as possible within the limited time scale provided by the IPR system.

Once an application has been filed in India, applications in other countries must be made within twelve months if the best protection is to be obtained. An international IPR programme can be a very expensive business.³ Funding for international IPR programs from either private or public sources is unlikely to be obtained unless there are definite commercial plans for the invention which are well advanced. Setting up one's own manufacturing company or identifying potential licensees and reaching agreement with them can take time. A period of longer than twelve months is usually required to complete either of these activities.

Licensing Strategy

Where a product is unsuitable for export because of distance, cost or other factors, a licensing strategy can be used. The Indian company can use the patents to license the manufacturing/marketing rights for their invention to a foreign manufacturer. In return they receive a royalty, which increases their profits.³ Licensing for both the home and export markets to Indian and/or foreign companies are also the appropriate strategy for inventions made by non-manufacturing companies or by universities and colleges.

Academic Research, their Publication and IPR Application Strategies

People carrying out academic research are frequently under pressure to publish the results of their research for academic reasons. Researchers should, bear in mind the possibility of commercial results from their research. If a researcher sees a commercial application from his or her research, it would be wise to delay publication until a patent application has been filed.⁷

Applying for a Patent

The first step in applying for a patent is to file a preliminary application in one country. When the application is filed, the

date of application is recorded and this is called the “priority date”. The first application can be quite basic and does not have to include a set of claims. It is still an important document and specialist advice from a patent agent should be obtained in preparing it.³

Most countries are signatories to an international convention, which guarantees that the priority date of an invention filed in one country will be respected in other countries, provided an application is filed in the other countries within twelve months of the date of filing the first application. This is why the first document filed can be very important later.

The system of filing an application in one country initially can be of great benefit to inventors provided they have timed it correctly. It allows up to twelve months before foreign applications must be filed. During this time the inventor can assess the commercial prospects of the invention, carry out improvements on it, and arrange the necessary finance for international patenting and commercial exploitation through manufacture and sale. This period is also used to assess the market potential for the invention in various countries and to decide in which countries the expense of patenting is justified.

The Patent System

A patent is a contract between the inventor or applicant for the patent and the State, whereby the inventor or applicant gets a monopoly from the State for a certain period in return for disclosing full details of the invention. The patent system thus ensures that information on new inventions is made available for eventual public use so as to encourage technical and economic development and discourage secrecy

If an inventor or company has an invention, which they consider to be novel and inventive, they may apply for a patent. This may be granted only after a detailed examination by a patent office. Once the patent is granted the inventor or applicant has the sole right to make, use or sell the invention for a limited period. This period is usually twenty years.^{3, 8}

A patent owner has the right to decide who may or may not use the patented invention for the period in which the invention is protected. The patent owner may give permission to, or license, other parties to use the invention on mutually agreed terms. The owner may also sell the right to the invention to someone else, who will then become the new owner of the patent. Once a patent expires, the protection ends, and an invention enters the public domain, that is the owner no longer holds exclusive rights to the invention, which becomes available to commercial exploitation by others.

All patent owners are obliged, in return for patent protection, to publicly disclose information on their invention in order to enrich the total body of technical knowledge in the world. Such an ever-increasing body of public knowledge promotes

further creativity and innovation in others. In this way, patents provide not only protection for the owner but valuable information and inspiration for future generations of researchers and inventors.

Patent Protection Limits

Patents can only be applied to inventions. These usually have an industrial dimension. An invention is normally a new product, which involves a new principle of operation or an improvement to an old principle.

It may refer to a new or improved industrial process. Things, which do not involve manufacture, are not usually considered to be inventions. For example, a new scientific theory or a new surgical procedure would not be considered to be patentable for this reason.³

Patent Specifications

The patent system is complex, and great skill is required in reducing the principle of an invention to words, which will have legal effect. Patent agents have detailed knowledge of the complex procedures in the various foreign patent systems and work with other patent agents throughout the world to obtain patent protection for an invention in different countries.⁸

A patent specification is written in a certain format, which may not be immediately obvious to the casual reader. The specification usually contains a preamble, which describes the background to the invention. Then comes a statement of invention, which is a legal statement of the scope of the monopoly sought.

This is followed by a detailed description of the invention, usually drawings or examples of how the invention is carried out. The final part of the specification includes a set of claims. These are not normally required in the preliminary application but are a vital part of the final document. A claim in this sense has nothing to do with the conventional use of the word, and does not relate to the advantages or performance of the invention.

A patent claim is where the patent agent sets out the scope or extent of the monopoly, which he claims on behalf of the inventor. In other words, one is claiming a territory of technology within which other people may not stray without infringing the patent. The scope of the patent is very important.

Examination and Prosecution

When patent specifications have been filed in the various countries the patent examiners in those countries examine them. These examiners carry out a search through previous

patent specifications and other literature in order to ascertain if the invention is novel. They also look at the question of inventiveness in relation to the “prior art”. As a result of the patent search, an examiner may feel that certain features of the invention have already been disclosed in previous specifications. Correspondence then ensues between the patent examiner and the patent agent until the examiner is satisfied that the claims for the patent are allowable. This can often mean an amendment or narrowing of the scope of the patent claims until the Patent Office in question is satisfied that it does not overlap the “territory of technology” claimed by previous inventors. This stage of the patenting procedure is called “prosecution” and can involve the inventor or applicant in considerable expense depending on the amount of work required to be done by the patent agent.^{3, 6, 8}

As part of the patent examination procedure, the specification filed by the applicant is published, usually eighteen months after the priority date. The Patent Office also publishes a list of previous patents, which were found to be of relevance in the patent search. Thus, even if an inventor has not disclosed the invention in any way up to this point, the patent system itself will make a disclosure and destroy its novelty at this time. *It is for this reason that inventions once disclosed cannot be the subject of subsequent patent applications either by the inventor or by anybody else.*

When the Patent Office has satisfied itself concerning the scope of the claims, which are to be granted, notice of allowance of the patent will be issued and the patent will be granted. In some instances interested parties may oppose the granting of the patent by lodging their grounds for opposition with the Patent Office. The patent applicant is expected provide further proof to claim novelty in their innovation to get letters of patent document issued in their favour.

Infringement

If an inventor makes a successful bid to win patent rights in one country, but a similar invention covered by a patent which is in force in another country, he or she may be sued in that country for infringement by the patentee. If infringement is proved, damages may be awarded to the owner of the patent.^{6,7}

E-filing a Patent Application in India

Salient features of e-filing a patent

1. The use of Digital Signatures on the documents

submitted in electronic form are maintained in order to ensure the security and authenticity of the documents filed.

2. A person who already has a specified Digital Signature Certificate (DSC) for any other application can use the same for e-filing of a patent application.
3. A class III Digital Signature Certificates (DSCs) may be obtained at
 - a. (n) Code Solutions
 - b. TCS -Tata consultancy services
 - c. Safe Script
4. An individual or a Patent Agent or a proprietor or an organisation can file its applications electronically. Without registering, no individual can file an application on-line.

CONCLUSION

The intellectual property rights empower researchers, academicians and entrepreneurs to safeguard their interests and to continue with the research activity whilst enabling them to realistically commercialise their inventions. The e-filing of patent in India greatly simplifies the patenting application.

REFERENCES

1. A manual on intellectual property rights. (Accessed web on 10th oct 2012 <http://www.bits-pilani.ac.in/Uploads/MicroModule/2011-12-12-7-46-19_276_Patent_ManualOct_25th_07.pdf>)
2. Draft Manual of Patent and procedure-the patent office India. Accessed web on 10th October 2012. http://ipindia.nic.in/ipr/patent/DraftPatent_Manual_2008.pdf
3. What is intellectual; property? (Accessed web on 10th October 2012 http://www.wipo.int/freepublications/en/intproperty/450/wipo_pub_450.pdf)
4. The patent system of India. (Accessed web on 10th October 2012 <http://www.gian.org/north/files/FAQ.pdf>)
5. Intellectual property rights-overveiw (Accessed web on 10th October 2012 <http://www.jisclegal.ac.uk/Portals/12/Documents/PDFs/IPROverview.pdf>)
6. Intellectual Property Rights: Theory & Indian Practice (Accessed web on 10th October 2012 ccsindia.org/policy/rule/articles/IPR_India.PD)
7. Introduction to Intellectual property. accessed web on 10th oct 2012 http://ipindia.nic.in/ipr/patent/patents_filing.pdf
8. Integrating *Intellectual Property Rights* and Development Policy. Accessed web on 10th October 2012 www.iprcommission.org/papers/pdfs/final_report/ciprfulfinal.pdf