

**Rksassociate – Advocates & Legal
Consultants**

eBook

PATENT & TRADE MARK GUIDE

IN INDIA



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Patents

In India the Patent Office under the Department of Industrial Policy and Promotion, Ministry of Commerce and Industry performs the statutory duties in connection with the grant of patent and registration of Industrial Design. In India the patent law is governed by The Patents Act, 1970 and The Patents Rule 2003 and amendments thereof. India is the member of the following international organization and treaties:

1. WIPO Convention, since May 1975.
2. Paris Convention (Industrial Property), since December 1998.
3. Berne Convention (Literary and Artistic Works), since April 1928.
4. PCT (Patents), since December 1998.
5. Geneva Convention (Unauthorized Duplication of Phonograms), since February 1975.
6. Budapest Treaty (Deposit of Micro-organisms), from December 2001.
7. Nairobi Treaty (Olympic Symbol), since October 1983.
8. WTO: Member and Signatory to TRIPS Agreement, since January 1995.
9. UCC since October 1957.
10. SAARC since December 1985.

1. TYPES OF PATENT APPLICATIONS

A. Ordinary Patent Application

It is a simple application for patent without any priority claim and not being convention or National Phase Application. It should be accompanied by a provisional or complete specification at the time of filing.

B. Convention Application

An applicant who files an application (“basic application”) for patent in a convention country can make convention application in India within 12 months from the date of basic application.

C. National Phase Application under PCT

PCT stands for the Patent Co-operation Treaty. It is a sister treaty of the Paris Convention administered by the World Intellectual Property Organization (WIPO). The PCT system facilitates filing of patent applications under a single umbrella and provides for simplified procedure for the search and examination of such applications. This allows a resident or national of a PCT member state to obtain the effect of patent filings in any or all of the PCT countries and to defer the bulk of filing costs usually due on filing. India became a PCT Contracting state on December 7, 1998.

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Since December 7, 1998, it is possible to designate India in PCT applications and to elect India in the demand for preliminary examination.

If India is a designated country in the PCT application and is also elected in the demand for preliminary examination filed within 19 months of the priority date, then the deadline for entry into the National Phase in India is 31 months from the Priority Date. If the applicant does not so elect India in the demand for preliminary examination, then the deadline for entry into the National Phase in India is 21 months from the Priority Date. Therefore, all applicants who have designated India in their PCT application filed on or after December 7, 1998, will be able to file PCT National Phase applications in India.

2. PATENTABLE INVENTIONS

The basic criteria for an invention to be patentable are the following:

- (1) An invention must be novel
- (2) Has an inventive step and
- (3) Is capable of industrial application

Also:

- A criterion for the process patent is elaborated to chemical process: Biochemical, Biotechnological and Microbiological processes.
- Scientists involved since long time in research and development in the field of genetics for creation of human clone baby holding genetically altered cell, are allowed to acquire the patent right on their worthy enormous effort.
- A method or process of testing during the process of manufacture is patentable.
- Process defined for the diagnostic and therapeutic treatment in case of plants is patentable.

3. NON-PATENTABLE INVENTIONS

There are some products and processes, which are not patentable in India. They are classified into two categories in the patent act

- a) Those, which are not inventions b) Invention relating to atomic Energy

Various types of non-patentable inventions

1. An invention which is frivolous or which claims anything obvious contrary to well established natural laws.
2. An invention the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment.
3. 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.
4. 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.
5. 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.
6. The mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way.
7. A method of agriculture or horticulture.
8. Any process for the medicinal, surgical, curative, prophylactic diagnostic therapeutic or other treatment of human being 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.

9. 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.

10.A literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions.

11.A mere scheme or rule or method of performing mental act or method of playing game.

12.A presentation of information.

13.Topography of integrated circuits

The following are certain examples of non-patentable inventions

- Discovery of any natural living thing or non-living thing.
- Invention based on any new Diagnostic and Therapeutic treatment of any causative disease to human beings and animals.
- Use or commercial exploitation of any invention, which could be harmful to human, animal or plant life or to the environment.
- Plants and animals, including varieties, seeds and species thereof and Biological process for the production or propagation of plants and animals.
- New mathematical or Business trend method, computer programs, any artistic work, art of presentation, new method of playing game, topography of integrated circuits.
- Replication of any traditional knowledge.

4. PERSONS ENTITLED TO APPLY FOR PATENT IN INDIA

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

- a) True and first Inventor
- b) His/her assignee
- c) Legal representative of deceased inventor or assignee.

5. CHECK-LIST AND INFORMATION REQUIRED FOR FILING PATENT

1. Name, Nationality and Address of the applicant
2. Name, Nationality and Address of the inventor
3. Title, Description, Drawings, Claims & Abstract of the Invention
4. Priority application number, date and other details
5. PCT application details (in case of national phase)
6. FORM 1-Application for patent to be filed in duplicate
7. FORM 2-Description, Drawings, Claims and abstracts in duplicate
8. FORM 3-Statement and undertaking regarding foreign filing details in respect of the same invention
9. FORM 5-Declaration as to Inventor-ship

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10. Priority document (if applicable)

11. FORM 26-Power of Attorney (can be filed later, before hearing) The format of the POA can be downloaded from our website www.indiajuris.com by clicking on PRACTICE tab.

12. Proof of right if the application is made by the assignee or by way of separate assignment deed. (proof of right may be submitted within three months of application)

13. International Search Report

6. TERM OF PATENT

The term of patent in India is twenty years from the date of filing or Date of Priority as the case may be. The first annuity (Renewal fees) is payable at the expiration of the second year from the date of the patent or of any succeeding year and the same shall be remitted to the patent office before the expiration of the second or the succeeding year. The period for payment of renewal fee may be extended not more than six months if the applicant makes the request for extension in the prescribed form and fee.

A patent shall cease to have effect on the expiration of the period prescribed for the payment of renewal fees. On cessation of the patent right due to non-payment of annuity or on expiry of the term of patent the subject matter covered by the said patent shall not be entitled to any protection.

7. EXAMINATION PROCEDURE

After the expiry of eighteen months from the date of priority or filing of patent application whichever is earlier, the application shall be published in the official Gazette. The applicant may also apply for early publication under form 9. Any person can file opposition against the grant of patent once the application is published. The controller will consider said opposition only when the applicant has filed Request for Examination (RFE).

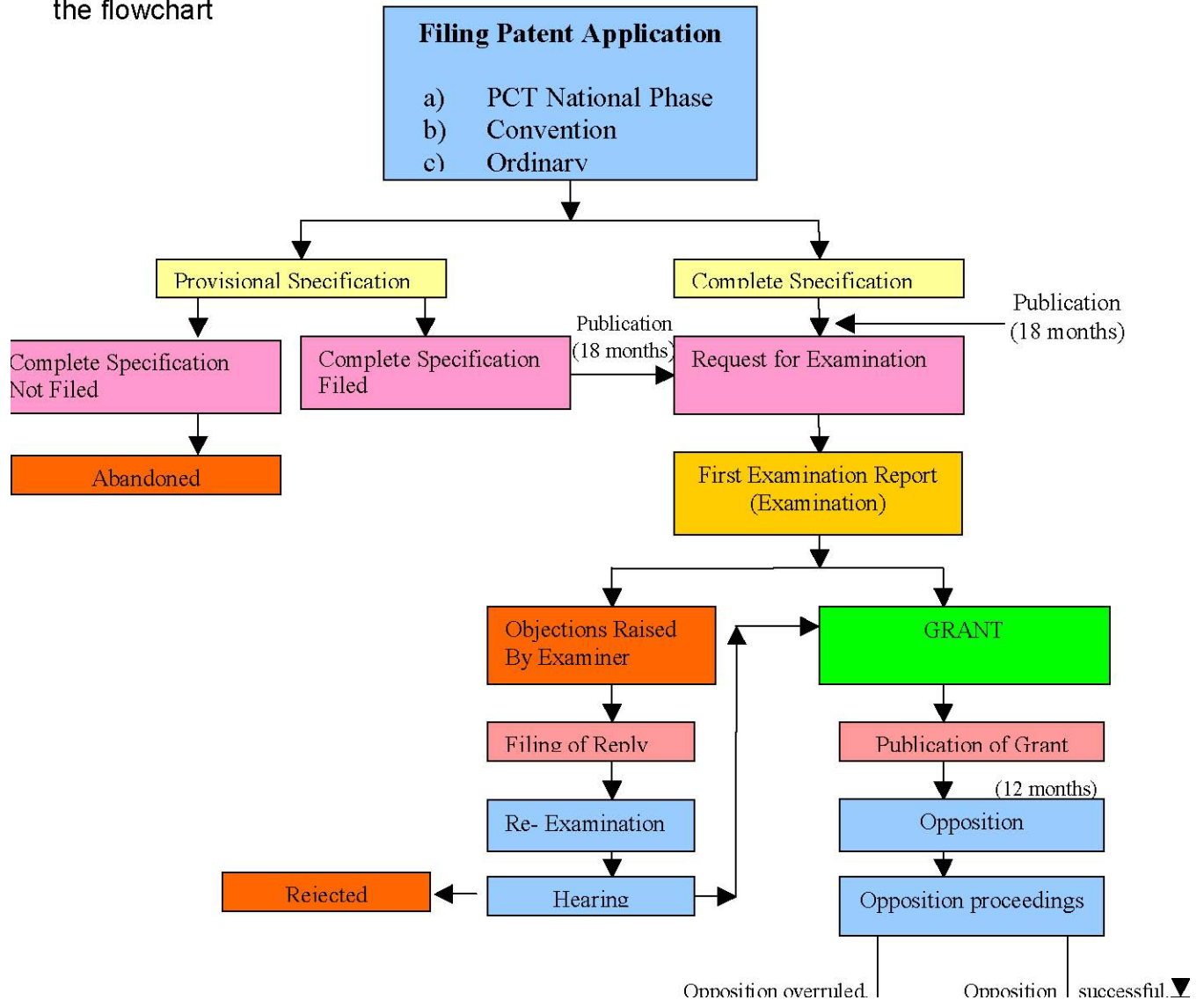
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Request for Examination (RFE) shall be made after publication as mentioned above but within 48 months from the date of priority, or the date of filing whichever is earlier, failing which application shall be deemed as abandoned.

On examination the Examiner will issue First Examination Report (FER). If the Examiner raises objections, the applicant must comply with all the requirements within 12 months from the date on which the statement of objections is issued.

Once all the requirements are complied with, the patent office will intimate the grant of patent to the applicant. Such granted patent shall be published in Patent Office Journal and shall remain open for opposition for a period of 12 months from the date of publication in journal. The procedure is further clarified by way of

the flowchart



8. INDIAN ONLINE PATENT SEARCHABLE DATABASE

Indian Patent Office has come up with online searchable patent database. This step is very effective and important towards timely disposal of Patent Applications. Applicants can now search the database free of cost. Please visit this website for patent search <http://pk2id.delhi.nic.in/>

Some Important points to note about patents

- Form No. 1, 3 and 5 shall be filed within 6 months after the date of filing of application.
- National Phase Application can be filed within 31 months from the priority date.

- Period of publication of application is 18 months from the date of filing of application or the date of priority, whichever is earlier.
- Request for Examination shall be filed within 48 months from the date of filing of application or the date of priority, whichever is earlier.

Trade Marks

The trade mark laws in India are governed by Trade Marks Act, 1999 which is in conformity with the TRIPS Agreement to which India is a signatory. Other sources which affects trade marks law are International Multilateral Convention, National Bilateral Treaty, Regional Treaty, Decision of the Courts, Office practice and rulings, Decision of Intellectual Property Appellate Board.

A trade mark (popularly known as brand name) in layman's language is a visual symbol which may be a word, signature, name, device, label, numerals or combination of colors used by one undertaking on goods or services or other articles of commerce to distinguish it from other similar goods or services originating from a different undertaking.

1. CLASSIFICATION SYSTEM

Various kinds of Goods and services, which are classified according to the International Classification of goods and services, are covered under trade mark. Currently schedule IV of the Trade Marks Act, 1999 provides a list of such goods and services falling in different classes.

2. REQUIREMENTS FOR FILING TRADE MARK APPLICATION

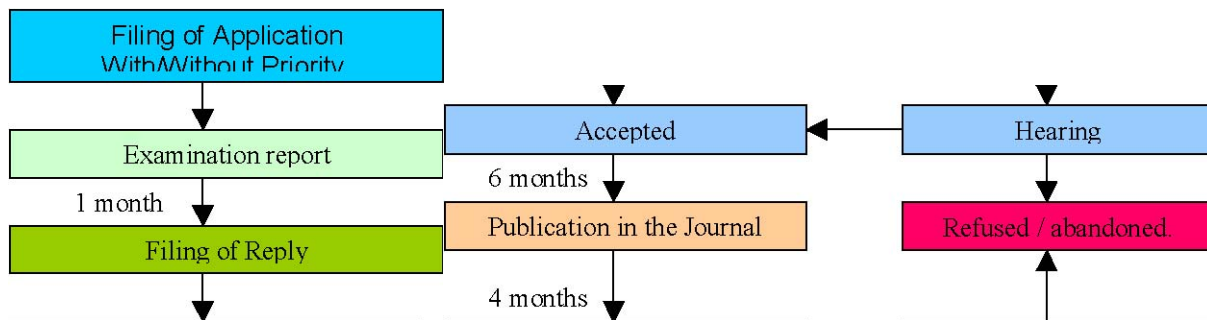
Any person claiming to be the proprietor of a trade mark used or proposed to be used can apply for trade mark registration. Following are the requirements for filing trade mark application.

- a. Name & Address of the Applicant Company / Person**
- b. Trademark / Logo (10 copies)
- c. Class(es)
- d. Description of goods / services
- e. Original priority documents, if priority is claimed. (can be filed within two months from the date of filing in India).
- f. Power of Attorney duly notarized (can be submitted later).

The format of the POA can be downloaded from our website www.indiajuris.com by clicking on PRACTICE tab.

3. REGISTRATION PROCEDURE

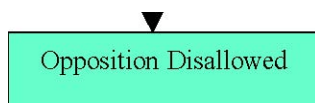
An undisputed registration process would take around twelve to fifteen months involving phases a) Filing of TM Application, b) Examination Report and reply thereof, c) Hearings, if required, d) Acceptance before Advertisement, e) Publication in TM Journal, and f) Issuance of Registration Certificate. The registration process is further clarified through the following flow chart.



Wait for opposition

2 months

Reply of notice/ hearing



After the trade mark is published in the TM Journal any person can file opposition within four months from the date of publication. After hearing both the parties the Registrar of Trade Mark shall decide accordingly and register or reject the trade mark.

4. TERM & RENEWAL OF TRADE MARK

The term of a trademark is ten years. It can be renewed further after every ten years. The application for renewal has to be made within six month from the date of expiry of the trade mark.

5. LICENSING AND ASSIGNMENT

Trade Mark can be assigned or licensed in respect of all or portion of the goods or services for which they are registered. Assignment or License Agreements of Trade Marks must be made in writing and recorded with the Registrar of Trade Marks for its validity and enforcement.

6. ENFORCEMENT

The remedies available to the owner of a trade mark for unauthorized use of his mark by third party are

a) an action for infringement in case of a registered trade mark, and b) an action for passing off in case of an unregistered trade mark.

The action for infringement is a statutory remedy and action for passing off is a common law remedy. In a suit for infringement or for passing off, the relief that the court may grant includes injunction, damages, account for profits and/or order for delivery of the infringing labels and marks for destruction.

For any further inquiry please contact:

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