

Introduction on Intellectual Property to Engineers and Technologists
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Lecture - 12
Patent Prosecution (Contd.)

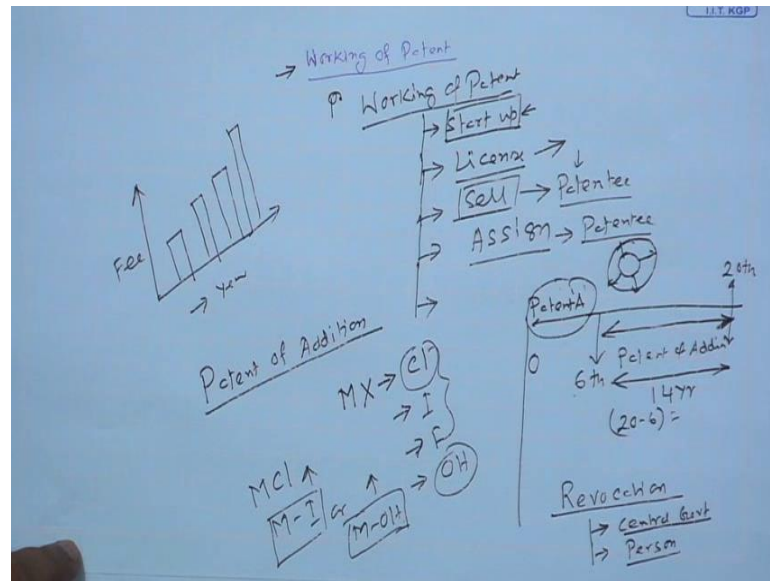
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I have discussed about the 3 grant prosecution. So, just like say what will be the steps involved to get the patent in the form of a certificate. So, your task is not complete, after getting the certificate. So, then also we have to think about just like say, different steps are involved just like say you have to give a statement of working of your patents. You have to be provided just like say, if it here you have to provide a statement of working of your invention because the patent is for to the government has provided or state have provided the a patent right to you based on working of your working just like you will they have considering that you will work with your invention where let us if in India patent.

So, further there is in the government restoration taking a check whether you are working of your patents or not. So, every years you have to renewal patents and also give a working statement of your patents. So, working of patents you know working of patents working of patents of patents.

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So, what do you mean by working in patent now working of patents means let us say you have got a patents. So, now, you have not yet sorry you have file the you have file the patent applications, but such likes you have now, started to form is start up now just like a working of patent working of patent you have one. Now crate a start up now sorry you try to get is to how can you work with a startup, get license and a sell, assign say the start up sell assign. So, these are the different routs by virtue of which you can work about your invention or you may refer that whom you are giving the license or whom you have sell your patent whom, you assign the patents assign the patents or you start up is formed then just like say start up is a formed then start up how your using.

So, every years you have to give a working statement of your patent if, you are not working of your invention non-working lead to the may be revocation of your patent. So, what are the things you have to follow you have to work of your work with the patent. So, working involved just like a work with you just like a work does not means a commercial means even you also research over, but this only for a commercial purpose I would referred that is industrial applicability. So, you create a start up create a start of company then a company like, this way then you may give license to another company because invention will fit somebody's product portfolio they will take the license licensing the licensee will work you are the licensor you also working of your patents. If you sell now you have been the already sell the rights means now the patent who will the

patentee whom you have sell you will be the patentee. So, this will reflected you assign, will be the patentee now he will give the statement of working of the invention.

So, now the rights the name the owners will be the buyer owner will be the assignee of the invention, but license simply the permission by virtue of some legal instrument you are giving permissive somebody to use the invention, licensee, in this case license will not give the licensee will not give the statement of working. The licensor means the person who is the patent holder will give the working of the invention start up means if the inventor himself created the start up or applicant created the start up you will give the obvious will owners ownership lying with him then you will give them a statement of working. So, you got an idea the statement of working component working of patent in India means not in India, so the production or working in India.

So, some cases you may refer that production is Bangladesh and here you are simply selling that may also treated as a working of the invention in India also. So, working of the patents you have to provide then you have to review your patents just like your file patent applications fees you have paid your file a request for examination fees also by virtue of that you got the patent, may be let us a fourth year then after fourth year every year till twentieth year, you have to pay the renewal fees of your patents the renewal fee is also if you consider renewal fee like this. So, first year renewal fee is like this fee let us say this is fee this type is a year wise renewal fee then second year will increase third year like this way renewal fee till twentieth years will increase on that way.

So, renewal you have to every year's you have to give a working statement you have to renew your patents or renewal you have to renew your patents. So, now, there is also another procedure if you thought about that I forgot to any other patent fall let us say second year, but there is a procedure when means act I suggested given some window period within a with the period. Let us it when second years renewal fee suppose to the paid in a December, but you have not for you have not paid because, let us a you are not getting proper licensee, you are not sure about that say sheet investment capital investment, so you are not working with invention on these cases.

So, you have not may be also intentional you have not renewed the paid the renewal fee, but till some away after that you got some investment, you got some licensee, you got some capitals. So, that case you want to restore your right, so there is a procedure called

restoration you have to restore your rights getting that my intention I am not say intentionally not paid my intention say, I am not like that say I am was unintentionally. So, intentionally I have not miss the renewal fees unintentionally that I which non-intentionally I have not some of paid the renewal fees now. But I have now I want to restore my rights with reference to those patents. So, then you can go for a restoration you can go for you can restore your rights it is ok.

So, restoration is one of the part restorations. So, restoration is the another part you can restores the your rights restoration you can restore your right by within that time frame then it will be restored if you do not restored within the time frame then your patent will be abandoned.

So, what do you mean by amendment then with that? You do not any right on that patents, so that will be abandoned so you may consider that may lead to the abandon means no rights then it will be consider as a patent it will be consider as public goods. So, the steps involved in working of patent in renewal restoration then another part is important here that amendment.

Now during the words after the getting the patent, any amendment with reference to the name of the applicant or amendment with reference specification without changing the scope or content of scope of scope of the invention that is you cannot enlarge your rights whatever light have been provided based on the date of filing or compete specification that you cannot further enlarged. So, within the same scope you may go for amendment or your amendment with the reference to the name of the applicant, in the name of patentee that as possible in the patent act if you read the section 57 of the patent acts, they have given the scope o limit of the amendment with reference to the patent.

Now it is a patent of earlier it was an application, now you got the certificate means patent whatever the amendment is permitted in respect of the patent while the respect of the patent including the patent applicant patent fees name and also content of the specification that scope is limited and discuss in section 57 generally your amendment should not. So, generally means not like that amendment should not again further give additional right to you. So, the amendment, you can do amendment by the before after grants before grants also can be possible after grant amendment you are stating about. So, amendment using the section 57 amendment with reference to apply and say patentee

will amendment is reference to the specification content without changing the scope of your rights.

So, these are the amendment is also possible and go for amendment then another important parameter here patent of additions; patent of addition is another important parameters what do you mean by that I will try to explain that component patent of addition.

So, patent of additions, so let us see you have an invention what I will let us consider your invention let with reference to a chemical that chemical is a used for let us say again. Let us say consider biochemical that chemical have a potential for let us say for of some energy. So, now, the that your invention is the chemical with reference to generation of some energy by subsequently have a made modification and improvement with reference to that chemical may be, let say the chemical that chemical you have used m x and x is reference to let say a light c l that I we have not thought about iodine or florin or some other and also let say instead of allogine, you are thinking about other radical also. So, x part initially limited to chlorine and even you are not claimed the all allied group.

So, now you are thinking about improvement is reference to the m means MCL instead of MCL your considering MI or MOH. So, you are improving because MOH you are getting that improve property over MCL m I having improved property over MCL. So, then you are giving some improvement or modification you are doing some improvement or modifications.

So, that improvement and modification is definitely new that improvement or modification is definitely new. So, that improvement and modification you want to protect, but you may ask me whether improvement and modification I can protect by means of amendment no by improvement and modification is not within the scope of your earlier invention. So, the improvement and modification can come off by virtue patent of addition keeping it do not have the knowledge about the patent of addition do not use that part specifically although these are there are there with reference to the patent of additions, but improvement and modification can be protected by means of patent of additions.

So, if you ask me what are the criteria with the patent of addition again required to meet the criteria of patentability I will say no, but patent of addition should be improvement and modification should be new, but does not required to fulfill the criteria of inventive steps say just like MCL others person also can thought about MI, but you are the person, you are trying to make a modification on improvement, but let see you may ask me if somebody can come up with m I with reference to the chemical and file in independent patent application; you can file a suit against the person on the grounds of inventive steps.

So, now if you file if you come up what say if you come up with m I that you can go for patent of addition. So, because patent of addition means criteria of inventive step does not required to fulfill to get a patent of additions, patent of additions does not required to fulfill the criteria of inventive steps, it may be obvious to the person still in the earth, but you are adding a features with reference to your own patent. So, this is the patent of addition improvement modification you are protecting by means of patent of addition When you file a patent of addition, after getting a main patent; so then who can file patent of additions who can file patent of additions renovation will be filed by the applicant or patentee of the main patent applicant or patentee of the main patent, who will file the patent of addition; applicant or patentee of the main patent.

So, what happened to the inventors may on ultimately communicative to the applicant who applicant is the assignee or he may communicate with the patentee then, there will be because their agreement will suggest any improvement and modification again you have to assign that to the assignee or the patent or assignee who will me consider the applicant or subsequently the patentee that agreements should be clearly stated. So, understanding that patent inventors can also improve, but ultimately the improvement as to your modification has to be filed by the patentee or applicant of the patent.

So, now advantage of patent of addition; you are protecting the improvement or modification in the patent of additions then the time frame of the addition time frame over the patent of addition time frame this is the important part. So, let us say main patent say patent a main patent then say let us say it will protect up to 20th year. So, after getting the patent a means patent within 20 years time frame; you can file n number of patent of additions.

So, patent of addition has to be filed within 20 years by means within the life time of the main patent within the life time of the main patent you have to file the patent of additions. So, now advantage means, let us say your initial rights was that, now your rights is has increased may be the modification part is enlarged rights for you now enlarge rights, but then you are not getting additional time frame, you may consider this is the disadvantage you a main patents is file in 0, 1 patent also petition is file in 6th year.

So, the life of the patent of additions is only for 14 years means 20 minus 6 is 14 years. So, patent of additions will ultimately sometime you call; the life when it is when the main patents will die along with the main patent; patent (Refer Time: 17:37) will die, but one important feature is there let us, say some of main patent revoked. I will come or somehow main patent may revoked means let us main patent say and also another advantage of patent of addition you if you renew the main patent automatically patent of addition also will be renewed, but situation may emerged say patent of patent is somehow be main patent main patent be revoked because of some ground. So, revocation I will not expand here, so revoke then patent of addition will be independent patents.

But the life will be the life of the main patent advantage patent of addition will be independent patent when the main patent get revoked, but the life will not extend by virtue of that life will be life of your is, main patent life of the main patent. So, the improvement or modification can be protected by means of patent of additions improvement or modification will be protected by means of patent of additions got the thing; improvement or modification will be protected by means of patent of additions.

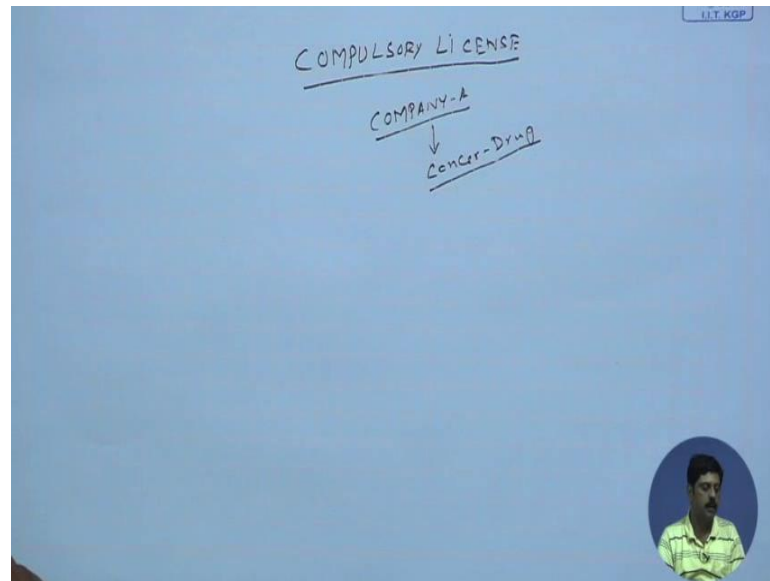
So, now these are you got the idea of patent of additions. So, now other part is the transaction that part I will discuss on later on transaction, whatever the way you can transact with reference to the patent then I has not the revocation. So, now, you have already got the trade of pre grant, post grant now again you have to be cautious about the revocations. So, now, the revocation can be done by the say patent office, government and also. So, revocation can be done who can a revoke revocation, revocation means, revocation of title you may consider means amendment of rights with reference to that patent. So, who can consider revoked central government will be referred it, central government or any person can also persons can also revoked your patents. So, central government let us say you are not working with reference to with the patents or

somehow you are increasing the price because of the monopoly rights you have on that patent you are increasing the price of the patented product.

So, are reasonable lead of the public is you are not meeting, so on that ground when government may have the privileges to revoke your patent or you are not working with the patents; what working means say not working lead to the revocation or you are not providing the patented article require as required by the public. So, that lead to also revocation of the patent means you will your rights will be revoke, who can revoke; central government revoke and persons can also revoked on the grounds again just like say your invention is not novel, not inventive steps all that ground again may come up on the ground on in respect of revocation just you remember that, we have European patent of his we have revoke the right of the we have revoke the right of the that you may revoke the right of the revoke. The just like a own living property of the patent related to own living property of the all the we successfully revoked in European patent office because let us say own living property of all the was then all traditional knowledge considering this was a proud public knowledge in India, we have successfully able to be revoke the patent application in European; in Europe also will have to successfully revoke the patents.

So, third revocation again I coming the grounds of nobility inventive steps, again coming when the persons will use the use that tool for revocation central government use the tools of revocation or the need of the public on the grounds of non working and others. So, revocation is another threat for you just like a for a patentee, you may have to although very less number of incident in India, but you have to be you have to consider this situations also then another important parameter we may recording the compulsory license.

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So, compulsory license you may consider as mayor permissions, but compulsory license say means just like say consider a situation compulsory license. So, consider a situation a particular drug a may company a hold having patent; company a having patent with reference to a particular drug, let us drug with reference to the cancer drug. So now he has a patent, so now what he is doing he has do not have enough manufacturing capability and the drug he required that say we required a drug in the market and you know that economic suggested economy or price escalation may happen, if there is a demand supply gap and three case is the company a; intentionally is intentionally is trying to create a price escalation to ultimately use his monopoly power in the form of a patent.

So, then in that situation may company b may approach to the company a some cases b may deny it the company a because b want to enjoy the fruits of escalation because, you want to use this patent right as a monopolistic rights that is although anti competitive he want use that part. So, he may deny the license of any other company who having the manufacturing capability with reference to that cancer drugs also. In some situation even government may give, if somebody else to manufacture that based on license on the company a itself. So, the situation when compulsory licensing tool or instrument will be used by the government or you may consider the patent office when there is a say demand supply gap, national emergency, the monopolistic power the patentee have been

using his monopolistic power that lead to the price escalation they are led into the demand supply gap.

So to cover the monopolistic attitude of the patentee; so then government use the compulsory licensing tool. So, they use the compulsory licensing tool to cover the monopolistic power of the patentee what they will do. So, now in that situation this is how he denied the license company; a denied the license to company b then they can approach the government means patent office and then patent office will ultimately negotiate between the company a and the company b whom the company a has denied the license.

So, then they ultimately decide some amount of consideration by means of money. So, in this case 2 situation may arises, let us say company b approach the company a, but company b say also may be charged huge license amount, license fee in the means of power consideration in that grounds also company b can approach the government in the form or IP o that he as a denied he is charging a (Refer Time: 26:17) amount of money for license or if it if an denied the license. So, two situations he deny the license or another situation is charging amount in that situation also he can the approach the government for.

So, that government now arbitrate or negotiate between the company a; and company b and they will ultimately say you may consider say ultimately till or state the company a to give the license to company b and license b will decided by the government. So, who will decide the license fee, now government will decide the license fee? So, in this case the situation when company b; company is denying the license to company b or charging (Refer Time: 27:05) in other situation may arise is that company government need that medicine and some company another company has the manufacturing capability of that medicines. So, in those kinds of situation also the government can state till the company b to give license to that company who has the manufacturing capability of that medicine, so in that case government can also give negotiate, decide the license fee.

So, now compulsory license does not means calls a free license or so, compulsory license does means that a tool to curb the monopolistic attitude of the patentee, it is a tool used by the government to curb the monopolistic attitude of the patentee, it is a tool for the public benefit, so that monopolistic power of the patentee somehow be (Refer Time:

27:58) by using use of this tools in India will one component is they are with reference to the compulsory licensing the related incident.

So, now what are the post grant say prosecutions you have learnt now; working of patents or renewal then restoration then patent of addition; transaction part I will discuss subsequently, amendment, revocation, compulsory license. So, these are the different things you have learned about the post grant prosecutions. So, pre grant prosecution subsequently, we discussed about the post grant prosecutions means after grants also you have to learned know about all those things. So, let us say we have learnt how; what will be your work flow relevant patent in India for the 20 years period over the office has involved. So, I am stopping it here now will continue; discuss on subsequently.

Thank you.