

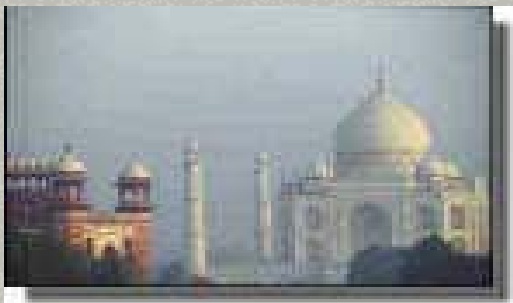
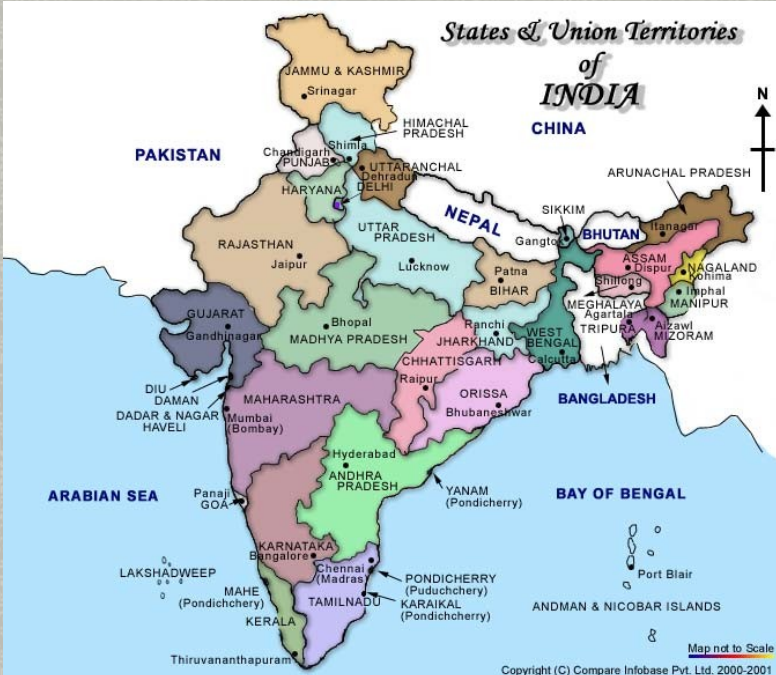
Progressive Changes in Indian IP Laws & Practice



Series of Presentations in Japan in the year 2004



INDIA

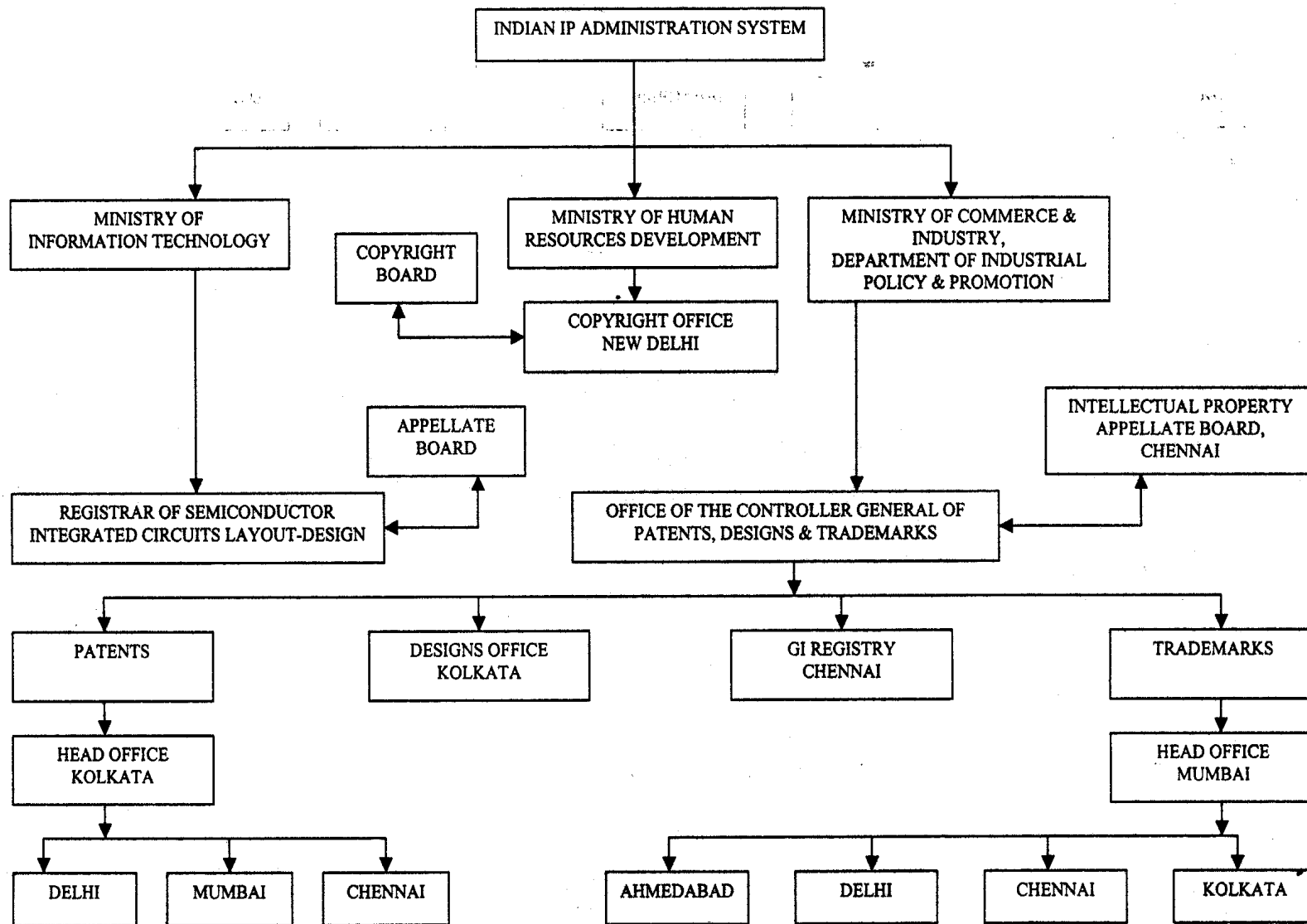




Indian IP Administration System

- **Intellectual Property is a union/federal subject.**







The Indian IP legislations are :-

The Patents Act, 1970

The Trade Marks Act, 1999

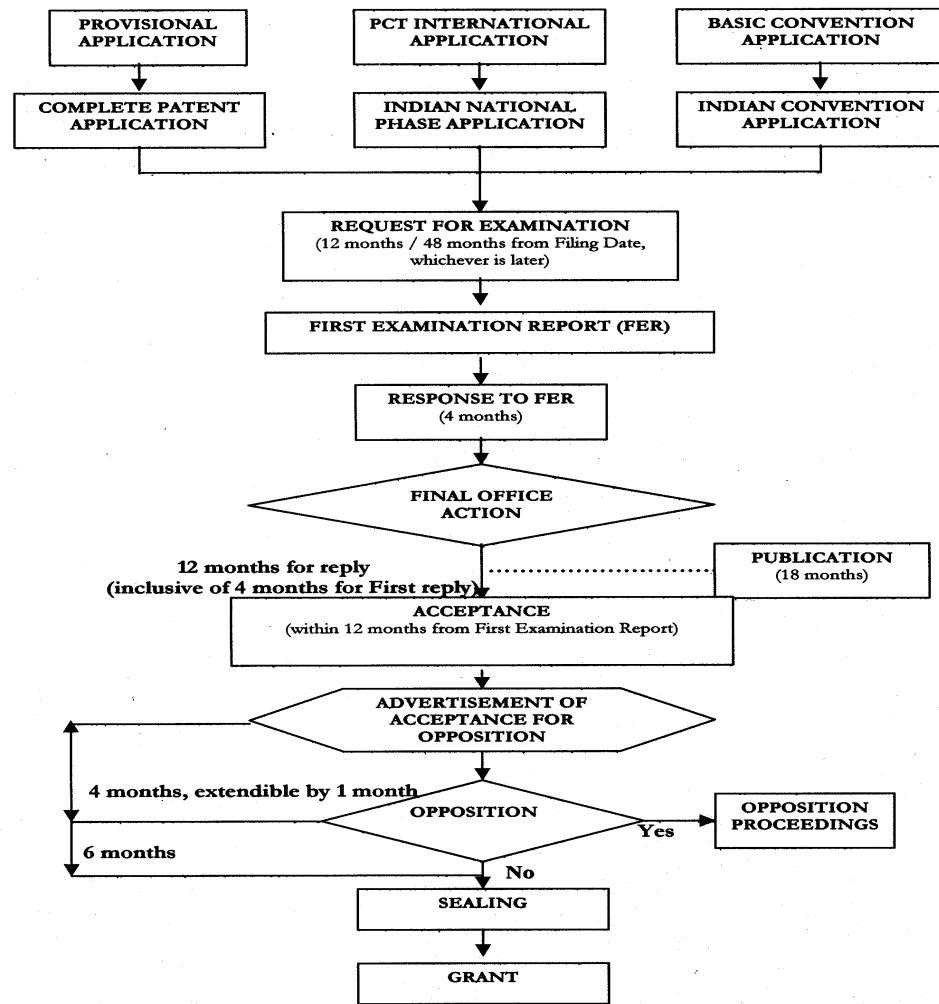
The Designs Act, 2000

The Copyright Act, 1957

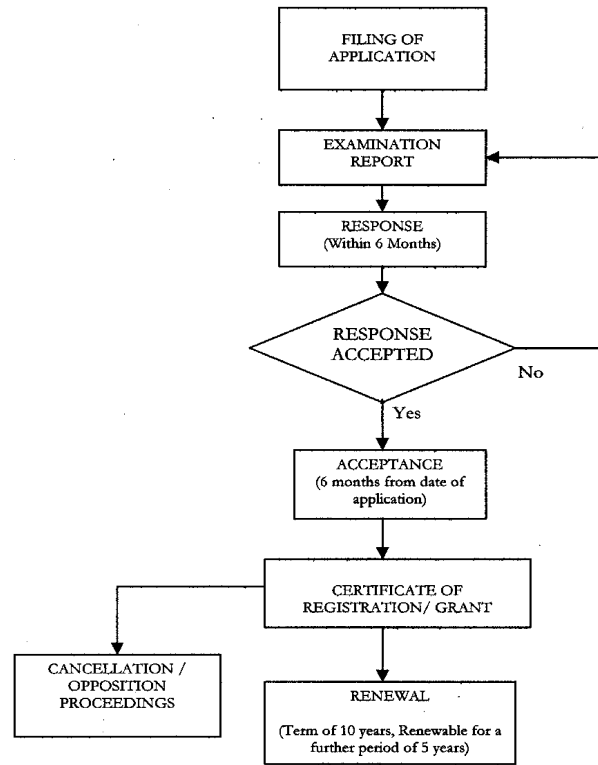
**The Geographical Indications of Goods
(Registration & Protection) Act, 1999**

**The Semiconductor Integrated Circuits
Lay Out-Design Act, 2000**

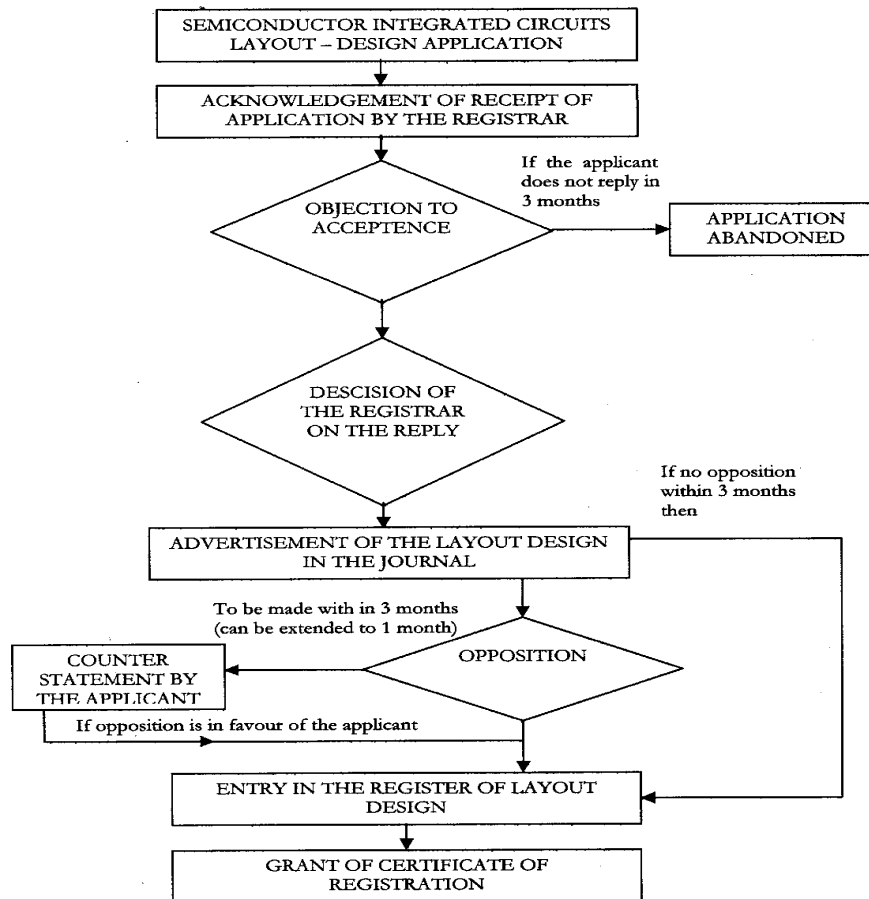
PATENT PROSECUTION PROCEDURE - INDIA



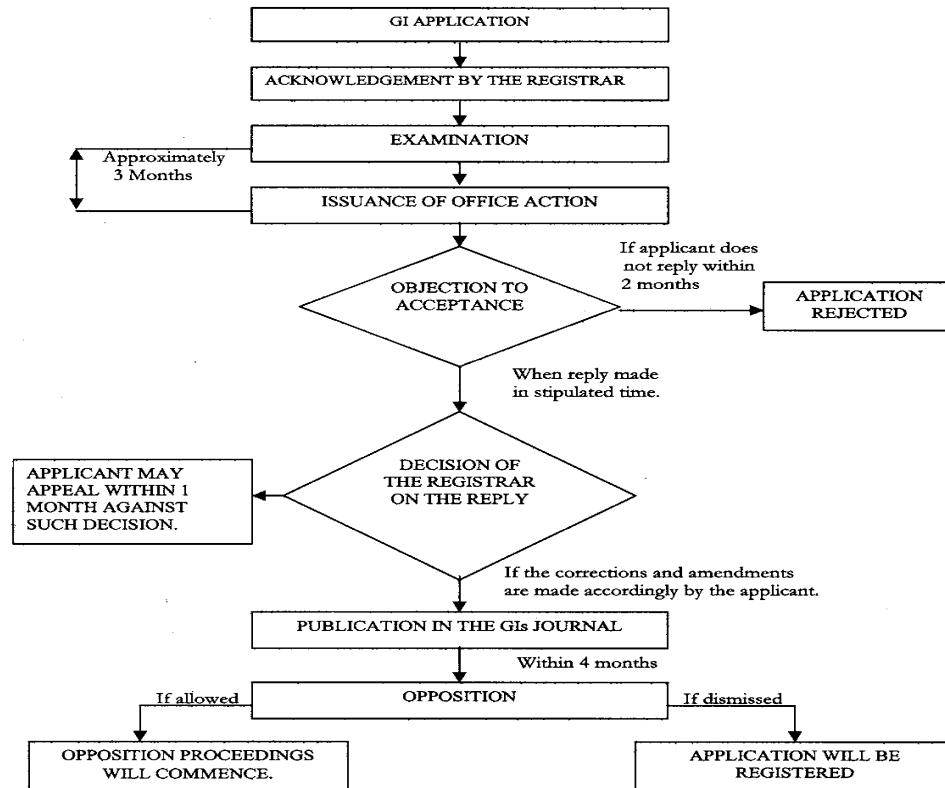
DESIGN PROSECUTION PROCEDURE - INDIA



**SEMICONDUCTOR INTEGRATED CIRCUITS LAYOUT- DESIGN
PROSECUTION PROCEDURE IN INDIA**



GEOGRAPHICAL INDICATIONS PROSECUTION PROCEDURE IN INDIA



Other IP Related Laws



**Biological Diversity Act,
2002**

**Protection of Plant
Varieties and Farmer's
Rights Bill (yet to become
an Act)**



Indian Patents Law – towards TRIPS Compliance

- India is a WTO Member and a TRIPS Signatory
- On January 1, 1995 when India joined WTO, Indian patent law was far behind the TRIPS norms
- No product patent protection was available for inventions respecting 'food', 'drug' and 'medicine'
- India failed to comply with the TRIPS obligations under Art. 70. to provide transitional protection in the form of EMRs, and receive Mail Box Applications
- India lost a dispute at the WTO – both at the level of DSB and the AB
- In 1999, India amended the Patents Act to provide for EMRs and Mail Box Applications
- A Second Amendment was also introduced in 1999, which came into force in May 2003. The second amendment brought the national law closer to the TRIPS
- A Third Amendment to make the national patent law fully TRIPS compliant is currently pending before the Indian Parliament



The highlights of the latest amendments in the patents law

- Product patent for all categories of inventions – including pharmaceuticals
- Term of patent increased to 20 years
- Microorganisms and microbiological processes patentable
- All EMRs will continue to be valid for the remaining term
- All EMR applications will be considered as Requests for Examination
- Compulsory Licensing provisions strengthened
- Grounds for invoking compulsory licensing include:
 - Public Interests
 - Government Security
 - Price of the product
 - Availability of the product
 - Local working
- Provision to give effect to Para. 8 of the Doha Declaration and Public Health



Patentability Criteria

Criteria for Patentability & Exclusions

Non-statutory subject matters:

- New Use of a Known Substance
- Substance obtained by mere admixture
- Method of agriculture, horticulture
- Methods of treatment; medicinal, surgical, curative, prophylactic, diagnostic, therapeutic, or other treatments of human beings and animals,
- Seeds, varieties and species;
- Essentially biological processes for production or propagation of plants or animals;
- Mathematical methods, business methods, algorithms and computer program perse;
- Literary, dramatic, artistic work or any other aesthetic creation;
- Methods of playing a mental act or method of playing games;
- A presentation of information;
- Topography of IC Chips;
- Invention which in effect is traditional knowledge.



Unity of Invention/Single Inventive Concept

The principle of “Unity of Invention” has been made flexible to cover all aspects of an invention under “a Single Inventive Concept” in a single application.

Multiple independent claims will be allowed.



Term of Patent

The term of Patent will be 20 years from the date of filing for all patents granted after commencement of the Act (including unexpired patents on the date of commencement of the Act).



Request for Examination

Request for Examination of applications is required within 48 months of filing date

Within 12 months from 31st December, 2004 or 48 months from the filing date whichever is later for “Black Box” pending applications

Within 12 months from the date of commencement of the Act (the Act came into force on May 20, 2003, hence this period is already over) or 48 months from filing date whichever is later for other pending applications

If a request for examination is not filed the application shall be deemed to be withdrawn



Publication

Under the new Act, an application for a patent will be open to the public for a period of 18 months from the priority date or the date of filing, whichever is earlier, unless a secrecy direction has been imposed on the subject matter of the invention.

Following the expiry of the 18-month period, every application for a patent will be published in the Official Gazette.



Highlights of the Procedural Amendments

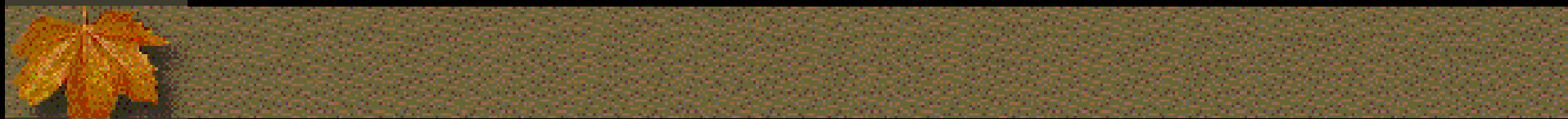
- Filing Fee has been reduced
- Forms have been amended – For PCT National Phase Applications Form 1A applies
- Request for Examination Mandatory (within 48 months from the date of filing)
- All Patent Applications will be published after 18 months from the date of priority
- The time limit to file reply to the first office action is reduced to 12 months from 15+3 months
- Time limit to restore a lapsed patent (lapsed due to non-payment of annuity) has been extended from 12 months to 18 months



Patent System Getting Streamlined

- The Indian Patent System is getting streamlined
- The Patent Offices have been fully automated
- 350 new Patent Examiners have joined
- A Training Institute has been set up in Nagpur at the Patent Information Bureau
- The backlog of pending patent application will be cleared soon
- An Intellectual Property Appellate Tribunal has been set up. The IP Appellate Tribunal will hear appeal from the decision of the Controller of Patents
- The Institute of Microbial Technology, Chandigarh has been designated as an International Depository Authority under the Budapest Treaty

Major Changes in the Indian Trade Marks Law



The Trade & Merchandise Marks Act, 1958 was repealed and the new law –

the Trade Marks Act, 1999 came into force on September 15, 2003

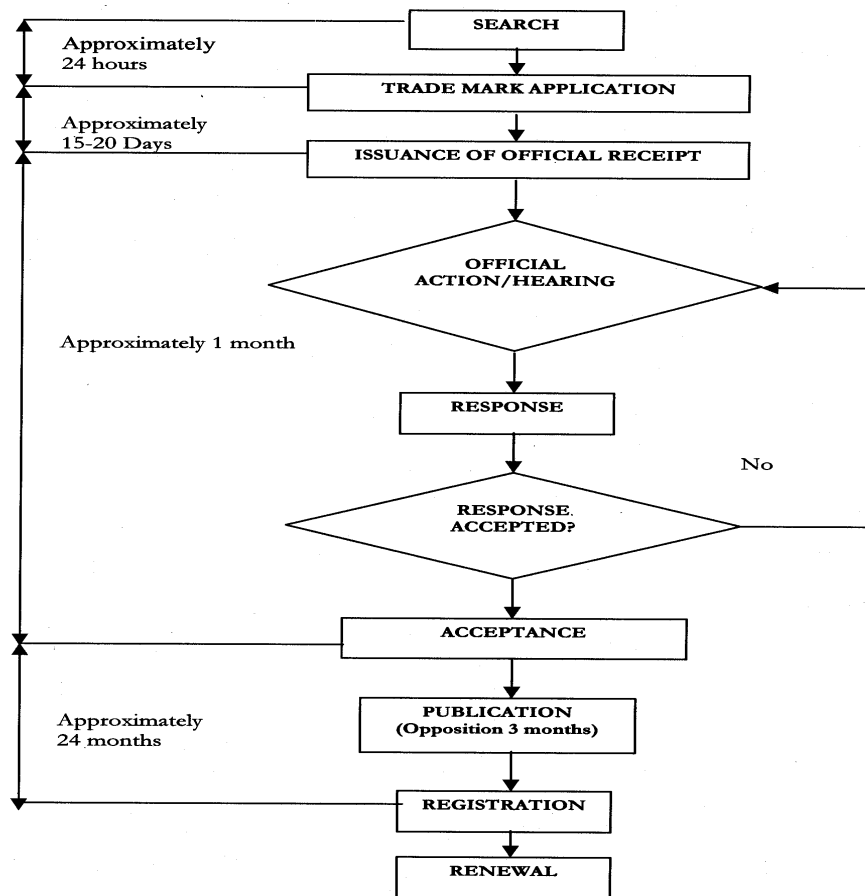
The new law brought in sweeping changes in the national trade marks law and practice

The Trade Mark Administration System



- Trade Marks Registry
Mumbai (Head Office)
- Trade Marks Registry, New
Delhi
- Trade Marks Registry,
Kolkata
- Trade Marks Registry,
Ahmedabad
- Trade Marks Registry,
Chennai

TRADE MARK PROSECUTION PROCEDURE - INDIA





Highlights of the Recent Amendments

- Service Marks Registrable
- Collective Marks Registrable
- Multi-Class Filing Permitted
- Shape of goods, Packaging, Combination of Colors Registrable
- Period of Registration extended to 10 years
- Assignment of Unregistered Trade Marks without Goodwill Possible
- Licensing of Unregistered Mark permitted
- Distinction between Part A and Part B of the Register abolished
- Intellectual Property Appellate Tribunal to be created



The Challenges Ahead.....

**Creating a predictable, efficient &
transparent Patent Administration
System**

**Developing a well-written Manual of
Patent Examination Procedure**

Developing a competent patent bar

**Constituting Patent Courts – or
benches having Judges capable of
understanding patent law**

**Creating Precedents that can
contribute to the growth of patent
law**



Thank You

