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A STUDY OF THE PATENT SYSTEM IN INDIA IN THE LIGHT OF THE PATENT COOPERATION TREATY

"The patent system adds the fuel of interest to the fire of genius."

- Abraham Lincoln

One may contemplate the invention of the patent system in the world. As per "British Intellectual Property" Expert Robin Jacob, the patenting concept goes back to 600 B.C., which states about patenting of a document for "some kind of newfangled loaf" of bread.¹ Furthermore, John of Utynam has been the first person to be awarded English Patent is, a Flemish glassmaker, in 1449.² Subsequently, the Venetian Senate's first patent law articulated the concept of "intellectual property" and the advancing importance of inventor's rights in 1471. With time, patent law was established in the world, leading to the development of a treaty. Therefore, through this paper, I would shed light on the "Patent Cooperation Treaty" and the Patent System in India; and how the two correlate with each other.

PATENT COOPERATION TREATY

The Treaty of Patent Cooperation, widely known as PCT, is an international treaty administered by the "World Intellectual Property Organization (WIPO)".

¹ Six significant moments in patent history, REUTERS, November 4, 2014, <https://www.reuters.com/article/us-moments-patent-idUSKBN0IN1Y120141104> (last visited Jul 30, 2021).

² Ibid.

Under this system, even a single “international” patent can be filed for patent protection in contracting states “international” patent application; the significant advantage under this system is to avoid filling multiple applications in different countries. As of 2020, the PCT system includes 153 contracting states.³

The formation of the Patent Cooperation Treaty traces to the 1883 era; The “Paris Convention for the Protection of Industrial Property” (1883) was the first international agreement catering for the need for intellectual property to be protected internationally. It covered Patents, trademarks, industrial designs, utility models, service marks, trade names, geographical indications, and the abolition of unfair competition.⁴ Likewise, the “Berne Convention for the Protection of Literary and Artistic Works”⁵ was adopted in 1886, which cater to the “protection of works and their author's rights”⁶. In 1893, Paris and Berne convention were integrated, resulting in the “United International Bureaux for the Protection of Intellectual Property”⁷, also known as BIRPI, based in Berne, Switzerland. BIRPI was the predecessor of the “World Intellectual Property Organization” (WIPO), which superseded it, 87 years later, in 1970⁸.

Later, On 29th September 1966, the Executive Committee of the Paris Intellectual Property Protection Union passed a recommendation requiring the director of BIRPI to work out a resolution to eliminate the duplicity in works and, thereof, resultant reduced costs for the applicants. Based on the recommendation, the first draft treaty was published in 1967, which acted as the base for discussion of the first Expert Committee at Geneva in October 1967⁹. Following this meeting, numerous consultations with the BIRPI in early 1968 to work on international search, internal application, and the international preliminary examinations. These issues were incorporated in the Second Draft Treaty, published on 15th July 1968, based on the second Committee of Experts meeting, attended by all members of the Paris Union and representatives of “41 states, seven intergovernmental and non-governmental organisations”.¹⁰ In 1969, specific meetings were held to consider the Revised Draft Treaty; since deliberations

³ *What is PCT?*, , <https://www.vpi.int/index.php/en/pct/what-is> (last visited Jul 31, 2021).

⁴ *Summary of the Paris Convention for the Protection of Industrial Property (1883)*, , https://www.wipo.int/treaties/en/ip/paris/summary_paris.html (last visited Jul 17, 2021).

⁵ *Berne Convention for the Protection of Literary and Artistic Works*, , <https://www.wipo.int/treaties/en/ip/berne/index.html> (last visited Jul 17, 2021).

⁶ *Ibid.*

⁷ *WIPO — A Brief History*, <https://www.wipo.int/about-wipo/en/history.html> (last visited Jul 18, 2021).

⁸ *Ibid.*

⁹ *washington_p739_to_764.pdf*, ,

https://www.wipo.int/export/sites/www/pct/en/texts/pdf/washington_p739_to_764.pdf (last visited Jul 17, 2021).

¹⁰ *Ibid.*

of the 1968 Expert committee, the same was published by the BIRPI, which led to the formation of the document studied at the Washington Diplomatic Conference. Later, BIRPI invited members of the Paris Union and various government organisations and non-governmental organisations to the Preparatory Study Group on the Draft Patent Treaty Regulations held in Geneva. Two new documents were published, thus, incorporating the same in the Treaty.¹¹

In Washington, the “Washington Diplomatic Conference” on Patent Cooperation From 25th May- 19th June 1970, Treaty was held, wherein the remarkable effort put in by the committees of experts and BIRPI paid off. On the last day of the conference, the Treaty was signed and entered into force with effect from 24th January 1978 with initially 18 contracting states, and as of 2020, it consists of 153 contracting states¹². Patent Cooperation Treaty is one of its kind, which is a multilateral treaty drafted over almost four years comprising of 69 articles and 95 rules directed by “World Intellectual Property Organization (WIPO)”¹³.

AIM

The PCT aims to expedite the fulfilment of the broader objectives of the patent systems:

- Promoting the support for advancement pertaining to science and technology
- Safeguard the applicant’s interest reinforced with legal parameters for their inventions
- To streamline and provide more economical protection of inventions
- To advance and accelerate public access to technical information
- To support and advance the economic growth of emergent nations

Furthermore, the aim of drafting the said Treaty was to achieve two general goals;

¹¹ *Ibid.*

¹² *The PCT now has 153 Contracting States, , https://www.wipo.int/pct/en/pct_contracting_states.html (last visited Jul 17, 2021).*

¹³ *George R. Clark, The Patent Cooperation Treaty Past, Present, and Future, 1971 U. ILL. L.F. 458 (1971).*

First is “the field of procedures for obtaining legal protection for inventions”; the second is “the field of dissemination of technical information and the organisation of technical assistance, particularly for developing countries”¹⁴.

In the “field of Procedures”, the Treaty includes two significant objectives:

“To Save Efforts- Time, Work, Money both for the applicant and the national offices”¹⁵ which is stated in the preamble to the Treaty as “Desiring to simplify and render more economical the obtaining of protection for inventions where protection is sought in several countries,”¹⁶

The other is to increase the likelihood of granting strong patents- here; strong patents refer to the granted invention patents which can withstand challenges in court by satisfying all the conditions for patentability. The above stated is derived from the preamble to the Treaty also, “Desiring to perfect the legal protection of inventions,”¹⁷

In the “field of Dissemination of Technical Information and Assistance”;

The Treaty's preamble aims, “Desiring to facilitate and accelerate access by the public to the technical information contained in documents describing new inventions”.¹⁸ Moreover, rapid access to technical information and assistance is mainly required by developing countries wherein the same can be concluded efficiently.

PROCEDURE

The Patent Cooperation Treaty procedure primarily has two phases- International Phase and National or Regional Phase;

- International Phase

It includes three features, two of which are mandatory for every contracting state that becomes part of the Treaty. The two features- *International Application* and *International Search* together are referred to as “Phase I”. The third feature includes

¹⁴ George R. Clark, *The Patent Cooperation Treaty Past, Present and Future*, 1971 U. ILL. L.F. 458 (1971).

¹⁵ Saving efforts for National Offices consists of international search reports and possibly international preliminary examination reports, which greatly reduces the examination work.

¹⁶ Patent Cooperation Treaty (PCT), *supra* note 14.

¹⁷ *Ibid.*

¹⁸ *Ibid.*

International Preliminary Examination, which is not mandatory and thus, is known as “Phase II”.¹⁹

Steps comprising the First Phase

International Application

The applicant files an international application and submits the same to the patent office (the Receiving Office²⁰). Furthermore, the nationality or the resident status of the applicant of the contracting state is mandatory while filing the international application.

The office then verifies if the international application meets the minimum requirements to obtain an international filing date. Under the procedure, the copy of the international application is sent to the International Bureau for record and the International Searching Authority from the receiving office, respectively.²¹

International Search Procedure & Publication

The International Searching Authority thoroughly analyses the International applications for relevant prior art and generates a report known as “International Search Report” (ISR)²², which includes simple citations of documents deemed suitable to the examination effect;

The applicant can make an informed decision for applying for national protection since it involves hefty fees and other expenses, including translation costs; mandatory to pay for entering the national phase in each country. The applicant may also opt for a supplementary international search in addition to the compulsory international search. The same is said to be an additional report which provides insight to the applicant about the growth prospects of the prior art.

The international bureau publishes the international application directed by receiving office, which usually happens after the expiry of 540 days from the priority date.²³ However, there are

¹⁹ *washington_p739_to_764.pdf*, *supra* note 9.

²⁰ *As stated in Articles 2(xv), “Receiving office is the national Office, intergovernmental or international organization with which the international application is filed and which checks and processes it according to the PCT and its Regulations”.*

²¹ *washington_p739_to_764.pdf*, *supra* note 9.

²² *Jay Erstling & Isabelle Boutillon, The Patent Cooperation Treaty: At the Center of the International Patent System*, 32 *WM. MITCHELL L. REV.* 1583 (2006).

²³ *washington_p739_to_764.pdf*, *supra* note 9.

two exceptions to it; a) on the applicant's request, it may be preponed, b) it may not take place later or not at all if the specified contracting states do not require international publication. It also stated that any third party could file observations within 28 months from the date of publication of the international application.²⁴

Steps comprising the Second Phase

International Preliminary Examination Procedure

“International Preliminary Examination Authority” (IPEA) undertakes the procedure of preliminary examination; "the objective of the international preliminary examination is to formulate a preliminary and nonbinding report directed to the questions whether the claimed invention is novel, involves an inventive step (is non-obvious), and is industrially applicable".²⁵ After which, a single opportunity is provided to the applicant for any changes to be made concerning the claims or, the description hereafter, the examination report is established. However, the report is not published and remains one of the confidential documents.²⁶

- National Phase

In the national phase, the applicant decides to proceed ahead, and if so happens, the applications are submitted to the respective office of the countries where they want protection. Selection of nations is the most crucial step of the applicant; after selecting the same, the applicant applies and pays the required fees. It is WIPO that communicates with the national offices on behalf of the applicant for the required documents. Moreover, an applicant must take the necessary steps enabling him to enter the national phase before 30 months from the priority date, except the European Patent Office and Indian Patent Office, which have a time limit of 31 months.²⁷

ADVANTAGES

- In General

²⁴ *Third Party Observations*, , https://www.wipo.int/pct/en/faqs/third_party_observations.html (last visited Jul 28, 2021).

²⁵ *George R. Clark, The Patent Cooperation Treaty Past, Present and Future, 1971 U. ILL. L.F. 458 (1971).*

²⁶ *washington_p739_to_764.pdf, supra note 9.*

²⁷ *Jay Erstling & Isabelle Boutillon, The Patent Cooperation Treaty: At the Center of the International Patent System, 32 WM. MITCHELL L. REV. 1583 (2006).*

The PCT system provides a better way for inventors and industries to obtain patent protection internationally. Filing one international application for security for an invention can simultaneously seek protection in 153 countries signatories to the PCT. In contrast, the traditional patent system required a separate application filed in each country requesting patent protection, leading to cumbersome tasks and additional costs of patent office fees, translation fees, legal fees, etc.

- For the Inventor/Applicant

An essential advantage of PCT application is that it provides ample time for the costs of national phase applications. Thus, it provides applicants with time to explore the growth possibilities of their invention in various countries before finalising the application of the national phase.

Another advantage is to evaluate the prospects of obtaining the granted patents and their scope in different countries with the help of ISR and preliminary examination. The PCT application route is initially costly but turns out to be cost-effective in the overall process.

PATENT SYSTEM IN INDIA

Indian Patent System can be followed back to 1856, the time of British India. India's first patent-related legislation is known as "Act VI of 1856", founded on British law of 1852, with specific alterations.²⁸ The legislation was notified to encourage the manufacturers to new inventions and share their secrets.

The law, as mentioned earlier, is flawed because it was promulgated without the approval of the British Crown and was annulled by "Act IX of 1857". A new piece of legislation was introduced in 1859 with necessary changes to grant "exclusive privileges", such as "Act XV of 1859". The new legislation with specific reforms was notified for the exclusive benefits of making and selling through inventions in India and authorised within 14 years. The reforms included permitting uses to practical inventions, and it also had an extension of priority periods from 180 days to 360 days.²⁹

²⁸History of Indian Patent System | About Us | Intellectual Property India | Government of India, , <https://ipindia.gov.in/history-of-indian-patent-system.htm> (last visited Jul 26, 2021).

²⁹ Ibid.

In 1872, the Act of 1859 was incorporated to furnish design-related protections. Therefore, the “Act XIII of 1872” was changed to “The Patterns and Designs Protection Act”. The Act of 1872 was revised and renamed the “Act XVI of 1883”.³⁰ The Protection of Inventions Act of 1883 was introduced to protect the novelty of inventions, which was disclosed at the Exhibition of India before submitting the protection application. The grace period for applying the opening date of the exhibition was six months. The Act was in practice for almost 30 years but required change due to the revision in Patent law of the United Kingdom, and the Act was also amended to be in parity with the new patent law. The Government introduced the Inventions and Design Act in 1888 to bring incompatibility between two geographical locations and be at par with the amendments approved for the designs and inventions compatible with U.K. laws.³¹

The Govt. of India superseded all prevailing laws vide “The Indian Patents & Designs Act’1911”, and it was, first time, put under the jurisdiction of the Controller of patents. There were amendments in the Act, which were made in 1920 and 1930 to achieve reciprocal agreements with the U.K. & other nations for securing priority & the granting of secret patents, patents of addition, government use of inventions, the authority to correct the patent registration and increase in the validity from 14 years to 16 years. A time gap within nine months for submitting provisional specifications and final specifications was further relaxed vide amendment in 1945.³²

After the Independence of India, it was speculated to review the patent system of India as the “Indian Patents & Design Act, 1911” was not accomplishing its objective. Thus, a committee headed by Justice (Dr). Bakshi Tek Chand³³ was constituted to analyse India's patent system and patent law to be beneficial in the national interest with specific terms of reference.³⁴ Certain

³⁰ *Ibid.*

³¹ *History of Indian Patent System | About Us | Intellectual Property India | Government of India, supra note 28.*

³² *Ibid.*

³³ *A retired judge of Lahore High Court.*

³⁴ “The terms of reference included:

- *To survey and report on the working of the patent system in India;*
- *To examine the existing patent legislation in India and to make recommendations for improving it, particularly with reference to the provisions concerned with the prevention of abuse of patent rights;*
- *To consider whether any special restrictions should be imposed on patent regarding food and medicine;*
- *To suggest steps for ensuring effective publicity to the patent system and to patent literature, particularly as regards patents obtained by Indian inventors;*
- *To consider the necessity and feasibility of setting up a National Patents Trust;*
- *To consider the desirability or otherwise of regulating the profession of patent agents*
- *To examine the working of the Patent Office and the services rendered by it to the public and make suitable recommendations for improvement; and*

recommendations proposed by the committee was to avoid misapplication of patent rights in India and advised amendments to “section 22, 23, & 23A of the Patents & Designs Act, 1911 corresponding to U.K. Acts of 1919 and 1949”³⁵.

There had been continuous improvements/amendments to the 1911 Act³⁶ while considering the public interest at large, mainly in health care equipment and compensation of the R & D costs to the patent holder for even balance. Another amendment in 1952³⁷ was done for the mandatory license of food and medicines, insecticide, germicide or fungicide and inventions related to surgical or curative devices.³⁸ In 1953,³⁹ a bill was placed in the parliament, but the Govt did not consider the same.

Later, in 1957, the Indian Government formed another committee headed by Justice N. Rajagopala Ayyangar Committee⁴⁰ to examine the revision of patent law. The committee recommended the following:

- The exact degree and scope of patentability to be allowed for the invention of chemical products
- Provision of patentability of inventions related to food and medicines;

In the House of People, on 21st September 1965; The Patent Law of 1965 was introduced, which eventually relapsed. Later, the Patents Act of 1970 was passed based on recommendations made with respect to the amendment bill proposed in 1967. This Act rescinded the 1911 Act; however, the same is still applicable to designs. With the promulgation of the patent rules in 1972, on 20th April 1972, the 1970 Act was enforced to a more considerable extent.⁴¹

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- *To report generally on any improvement that the Committee thinks fit to recommend for enabling the Indian Patent System to be more conducive to national interest by encouraging invention and the commercial development and use of inventions”.*

³⁵ *History of Indian Patent System | About Us | Intellectual Property India | Government of India, supra note 28.*

³⁶ *Patent and Design Amendment Act (Act XXXII of 1950)*

³⁷ *Patent and Design Amendment Act (Act LXX of 1952)*

³⁸ *History of Indian Patent System | About Us | Intellectual Property India | Government of India, supra note 28.*

³⁹ *Patent Bill, 1953 (59 of 1953)*

⁴⁰ *Justice N. Rajagopala Ayyangar Committee on Revision of Patent Law available https://spicyip.com/wp-content/uploads/2013/10/ayyengar_committee_report.pdf.*

⁴¹ *History of Indian Patent System | About Us | Intellectual Property India | Government of India, supra note 28.*

Some features included in the Act are⁴²:

- Substances used for food, medicine and medicine, including chemical process products, will have no product patents.
- Regulations on confidentiality of inventions related to defence.
- Stringent restrictions for license agreements to avoid patent rights abuse.
- The need for no work provision; for compulsory licences and licensing rights and revocation of patents.
- Including appeals to the High Court on decisions of the Controller.

The Patents Act of 1970, which is still in effect with alterations, remained in effect for approximately 24 years till December 1994 without any changes. “The Patents Act of 1970” made significant amendments to the then existing “Patents and Designs Act of 1911”.

Eventually, many international agreements were formed to develop patent law in emerging nations. During this period, India felt it is need of the hour to join the international agreements with the sole objective to establish patent laws in India, resulting in India being a member of the “Trade Related Intellectual Property Rights System” (TRIPS).⁴³

Likewise, India became part of the “Paris Convention” and the “Patent Cooperation Treaty” on 7th December 1998.

According to Mueller,

“India’s participation in the debates over the inclusion of intellectual property within the GATT framework and its eventual entry into the World Trade Organization (WTO), along with its accession to the Paris Convention for the Protection of Industrial Property and the Patent Cooperation Treaty, have compelled significant strengthening of the nation’s patent laws. The implementation of those changes is ongoing, and their anticipated

⁴² *INTELLECTUAL PROPERTY INDIA*, 253,

http://ipindia.gov.in/writereaddata/Portal/IPOGuidelinesManuals/1_59_1_15-wo-ga-34-china.pdf.

⁴³ *Chapter 5.pdf*, , <http://14.139.58.147:8080/jspui/bitstream/123456789/50/9/chapter%205.pdf> (last visited Jul 5, 2021).

impact remains to be fully seen. Today India stands as a rising global power with a patent system still very much in flux”⁴⁴.

The need to add EMR was raised when India became a signatory to TRIPS and had to comply with the requirements on 1st January 1995; thus, Section 5 of the “Indian Patent Act of 1970” allows explicitly process patents for drugs medical-related inventions.⁴⁵ To fulfil the obligation to grant exclusive market rights, a decree was issued on 31st December 1994, which made specific changes to the Act, which ceased to be implemented after six months.

Subsequently, another decree was released in 1999. This decree was later substituted by the First Patents (Amendment) Act of 1999, which took effect retrospectively on 1st January 1995. The amended Act included “Chapter IV A”, which is based on granting EMR (Exclusive Marketing Rights) for patented drugs in other countries and filing an application in India.⁴⁶ Therefore, EMR has become an alternative to patent protection for food, medicines and drug-related inventions during the transition period.

The Patent (Amendment) Act 2000 was a second amendment to the 1970 Act, which entered into force on 20th May 2003, and introduced a new Patent Rule, 2003 that substituted the earlier Patent Rule, 1972. Certain amendments that were made are⁴⁷:

- Additional coding of non-patented inventions
- All technologies have a 20-year patent term
- Provide process patents with reversal of the burden of proof
- Need of compulsory licenses for public health
- Eliminate the provision of a license of right
- Introduce a deferred examination system

⁴⁴ Uday S. Racherla, *Historical Evolution of India’s Patent Regime and Its Impact on Innovation in the Indian Pharmaceutical Industry*, in *INNOVATION, ECONOMIC DEVELOPMENT, AND INTELLECTUAL PROPERTY IN INDIA AND CHINA: COMPARING SIX ECONOMIC SECTORS 271–298* (Kung-Chung Liu & Uday S. Racherla eds., 2019), https://doi.org/10.1007/978-981-13-8102-7_12 (last visited Jul 27, 2021).

⁴⁵ *History of Indian Patent System | About Us | Intellectual Property India | Government of India*, *supra* note 28.

⁴⁶ *Ibid.*

⁴⁷ *INTELLECTUAL PROPERTY INDIA*, *supra* note 42.

- Publication of the application is made mandatory after 18 months from the date of application
- Provisions on “process patents” of microorganism
- Formation of the board of appeal
- Provisions of “parallel imports.”
- The need to save biodiversity and traditional knowledge

“The Patents (Amendment) Act, 2005” was notified on 4th April 2005 and enforced on 1st January 2005. This patent amendment supersedes the regulations mentioned above. Through this revision, the Indian Patent Law has fully complied with the TRIPS requirement.

Certain features that were incorporated in the Act:⁴⁸

- Extend “product patents” to all technological fields
- Eliminate regulations related to exclusive marketing rights (EMR).
- Provision for grant of a compulsory license for the export of medicines to countries in dire need.
- Modify regulations related to opposition procedures to simplify the “pre-grant and post-grant opposition” in the Patent Office.
- Strengthen regulations related to public security to prevent dual-use technologies from obtaining foreign patents
- Improve regulations related to time limits for better processing of patent applications.

Chronological Sequence of Development of Patent Law in India⁴⁹

1856	The Act VI of 1856 on the protection of inventions based on the British Patent Law of 1852.
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⁴⁸ *Ibid.*

⁴⁹ *History of Indian Patent System | About Us | Intellectual Property India | Government of India, supra note 28.*

1859	The Act was modified as Act XV; Exclusive Privileges were included.
1872	The Patents & Designs Protection Act under Act XIII of 1872.
1883	The Protection of Inventions Act, 1883.
1888	Inventions & Designs Act, 1888.
1911	The Indian Patents & Designs Act, 1911.
1972	The Patents Act, 1970, came into force on 20th April 1972.
1999	The Patents (Amendment) Act (1999) came into force from 01-01-1995
2002	The Patents (Amendment) Act, 2002 came into force on 20th May 2003
2005	The Patents (Amendment) Act, 2005 effective from 1st January 2005

INDIAN PATENT OFFICE

“Lincoln said that the Patent Office adds the flame of interest to the light of creativity. And that is why we need to improve the effectiveness of our Patent Office”. - Jay Inslee

Indian Patent Office has its head office (H.O.) in Kolkata and branch offices located at Delhi, Mumbai & Chennai, with individual territorial jurisdictions dealing in all sections of the Patent Act. The Trademark Registry at Mumbai is headed by Mr Rajendra Ratnoo⁵⁰, the Controller General of Patents, Design & Trademark (CGPDTM). The trademark branch is in Ahmedabad also along with other branch offices of the Indian Patent Office. Department for Promotion of Industry and Internal Trade administers Indian Patent Law including Patents, Designs and Trademarks⁵¹ wherein Controller General governs the Indian Patent Office.

⁵⁰ *Rajendra Ratnoo (IAS) gets additional charge as Controller General of Patents, Designs & Trade Marks, , <https://psuwatch.com/rajendra-ratnoo-ias-gets-additional-charge-as-controller-general-of-patents-designs-trade-marks> (last visited Jul 27, 2021).*

⁵¹ *INTELLECTUAL PROPERTY INDIA, supra note 37.*

The Offices of the “Patent Information System” (PIS) and “National Institute of Intellectual Property Management” (NIIPM) are at Nagpur. “Patent Information System” was established in 1980 with the primary objective:⁵²

- To secure and store an inclusive collection of patent specifications and patent-related documents worldwide, to meet the need of information technology about research, users and institutions.
- It is providing technical information in patents by search services.

Functions

The PIS meets the needs of users based on patent documents and computer systems and is used to retrieve and disseminate patent information.

Patent Information Services

The PIS provides patent information services, such as searching and supplying patent copies, and requires payment of applicable fees, including mailing fees which can be made based on the “proforma invoice”.⁵³

Patent Search Services

To avail of search services, one has to send the search request. The services that can be availed are:⁵⁴

- State of Art Search
- Bibliographic Search
- English Equivalent Patent Search
- Equivalent Family Patent Search
- Assisted Search

⁵² *Patent Information System | Intellectual Property India, , <http://ipindia.gov.in/patent-information-system.htm> (last visited Jul 27, 2021).*

⁵³ *Patent Information System | Intellectual Property India, , <http://ipindia.gov.in/patent-information-system.htm> (last visited Jul 27, 2021).*

⁵⁴ *Ibid.*

FILING OF PATENT APPLICATION IN INDIA

Anyone can file the patent application that claims to be the actual first inventor, his assignee, or his legal representative. Each applicant must provide a service address in India, where the Comptroller will send all correspondence. For foreign applicants who do not have their business place, the service address of the agent will be determined by the corresponding office. Therefore, the first patent right is granted to inventors or inventors who have the right to sell their inventions and transfer their rights to any other person or legal entity. There are different types of patent applications, which can be submitted according to the nature of the application.⁵⁵

Types of Patent Applications⁵⁶

- Ordinary Applications

An ordinary application can be filed in the patent office without claiming urgency for the same or reference to any other application in a convention country. Inventor himself can file as the applicant or by a person authorised to do it in his name; however, an applicant can be of Indian or foreign origin.⁵⁷

- Convention Applications

Convention application is the reverse of ordinary application. An applicant applies an urgent basis for the filing dates for the same or reference of any other application filed in at least one convention country. The applicant has to file the application in the Indian Patent Office within 12 months from filing a similar application in the Convention country.

- PCT International Applications

After filing a patent application through the international filing system (PCT), the applicant gets a filing date for all contracting states. The deferred application is granted to the national office for up to 31 months. Likewise, the Indian Patent Office receives an international application from citizens or residents of India with a translated application if required.⁵⁸

⁵⁵ Chapter 5.pdf, *supra* note 38.

⁵⁶ *INTELLECTUAL PROPERTY INDIA*, *supra* note 37.

⁵⁷ *Ibid.*

⁵⁸ *Ibid.*

- PCT National Phase Applications

Under PCT, the deferred application is granted to the national office within 31 months from the application's priority date in India. PCT national phase application is filed with Controller claiming urgency and the date of international filing. In India, applications on plain paper can be filed on plain paper, but Form 1 is preferred.⁵⁹

- Divisional Applications

Occasionally, applicants are required to submit a divisional application and select the claim to be administered in the main application when a filed patent application consists of two or more inventions. The Controller objects the same for lack of unity of the invention.⁶⁰

- Patent Of Addition Applications

Patent of Addition application is required when an applicant feels a modified version of the invention they applied for or has a patent. After that, an applicant can even change an independent patent into a patent of addition later, provided that the topic is modified to the primary invention.⁶¹

CORRELATION OF INDIAN PATENT SYSTEM AND THE PATENT COOPERATION TREATY

It is worth mentioning that industries and individuals from various contracting states apply for patent applications using the PCT. This is due to the PCT procedure that is effective, easy and has several benefits for applicants and the public. The Treaty, when it came into force in 1978, had only 18 contracting states, whereas now it has 153 contracting states⁶². Furthermore, PCT's primary objective is to support and advance the economic development of developing countries.

Initially, India consented to the "Paris Convention for Protection of Industrial Property" in December 1998 and later entered into "Patent Cooperation Treaty"⁶³. Being part of the Union is a historic event for Indian Patent System and provided the country with many opportunities.

⁵⁹ *INTELLECTUAL PROPERTY INDIA, supra note 37.*

⁶⁰ *Chapter 5.pdf, supra note 38.*

⁶¹ *INTELLECTUAL PROPERTY INDIA, supra note 42.*

⁶² *What is PCT? supra note 3.*

⁶³ *History of Indian Patent System | About Us | Intellectual Property India | Government of India, supra note 28.*

In the beginning, there was a sudden dip in the filing of an application when India joined PCT, from 8954 to 4824 drastically. However, next year it picked up, leading to the filing of 8503 patent applications.⁶⁴ According to WIPO, India ranks 8th in patents filed by resident scientists/innovators from the respective country.⁶⁵ Thus, it can be said that India has accepted the accession of PCT in India's patent system and has been taking full advantage of the efficient yet economical procedure for filing the application.

National Phase of filing Patent Application in India

According to the essential prerequisites for initiating the national phase in India, the applicant must submit the national phase application within 31 months from the priority date or the date of the international application, whichever comes first.⁶⁶ The application can be submitted on plain paper, but it is preferred to use Form 1. The national fee for INR is to be paid with the application as described in the First Schedule. According to the First Schedule, if there are multiple priorities, the fee will be delivered multiple times for each multiple priority. If the international application has not been submitted or published in one of the official languages (Hindi or English), translation is required.

The national law also has some other "special requirements", which can be met once the national prosecution begins. According to "DO / IN or EO / IN", the same required by the office is as follows;⁶⁷

- If, in the international application; the name, nationality and address of the inventor is not stated
- The clarification of assignee when an applicant is not the inventor.
- The document having the name change certificate occurred after the international filing date and was not registered in the International Bureau.
- Applicant's Inventorship Declaration

⁶⁴ *Ipindia.gov.in* (2021), https://ipindia.gov.in/writereaddata/Portal/Images/pdf/Use_of_the_PCT_-_National_prospective-_PCT_Roving_Seminar_Nov-Dec_2019.pdf (last visited Jul 29, 2021).

⁶⁵ Radheshyam Jadhav, *Half of India's patents come from three States*, @BUSINESSLINE, <https://www.thehindubusinessline.com/data-stories/data-focus/half-of-indias-patents-come-from-three-states/article33926092.ece> (last visited Jul 31, 2021).

⁶⁶ *INTELLECTUAL PROPERTY INDIA*, *supra* note 37.

⁶⁷ *Ibid.*

- Evidence of filing applications in other countries, if any
- Translation and copy of the international application to be verified

The patent application must be submitted to Indian Patent Office, depending on the company's location or the applicant. If there is no location given, then they can submit it in any of the four offices.

Each patent application will be published 18 months after the filing date⁶⁸. Therefore, an advance publication request and the prescribed fee can be filed. Once published, the application will be considered to be in the public domain.

A “First Examination Report” is formed by the examiner within three months after receiving it from the Controller who should forward it within 30 days to the examiner from the date of publication or RFE, whichever is later; provided the applicant submit the “request for examination” (RFE) within 48 hours for filing the application. The report is then forwarded to the inventor or the agent within six months from the date of publication or RFE, whichever is later. The applicant is given 12 months from the date FER is forwarded to comply with the requirements imposed in the report. Otherwise, the application will be considered abandoned.⁶⁹

After complying with the Controller's instructions/objections, the application, together with the full specification, will be published in the Patent Journal. The application can be objected to within four months or a longer specified period; if no one opposes through filing an objection or the objection is successfully overcome, the patent will be granted to the application.⁷⁰

Earlier in times, when the patent system was being developed in India, certain provisions for patents were not incorporated due to economic and political conditions that prevailed but has come a long way now; summing up the decision of India to be part of PCT was a new light of hope for Indian Patent System. During the adjusting period, there was a sudden hit on filing applications; however, later, the Treaty made patent filing applications in India efficient due to its primary objective to support economic development in developing countries. In addition, India could advance its technology constraints in correlation with the filing of applications making it a hassle-free procedure that an applicant or inventor undertakes. The main selling point of filing an application through PCT in the world, especially in India, is due to the time

⁶⁸ *History of Indian Patent System | About Us | Intellectual Property India | Government of India, supra note 28.*

⁶⁹ *Ibid.*

⁷⁰ *Chapter 5.pdf, supra note 43.*

period of up to 18 months that the applicant gets before payment of national fees, which gives one time to scrutinise the growth prospect of the patent in various countries whereas, before PCT, one had to pay a hefty amount of money for the filing of an application, translations fees and many other things. Furthermore, an increase in India's patent application will help the country's economic growth as industrial patents help the Government attract international investors to India; also, the I.P. index status of India shows that there is a positive relationship between I.P. Index and GDP.

CONCLUSION

Patent Cooperation Treaty is one of the comprehensive international treaties that deal with the patent system. Due to this Treaty, India made a remarkable change in its development of the patent system, as stated above. India is a developing country with strengths and weaknesses like many other countries, but the USP of this country is in its diversity of the population, making it unique. Likewise, PCT has a diverse system of operations that deals from linguistic aspect to legal; while coordinating with 153 contracting states regarding the patent application. Indian Patent System could have tremendous development, with support from PCT due to its primary objectives. The two systems are equally important; from India, PCT has many applications filed, leading to greater awareness about the same. Likewise, Indians are willing to file international applications is due to the effective yet economical procedure of PCT, which attracts inventors to file. Earlier, with the traditional patent procedure, the number of patent applications was less than today because the former was a cumbersome task with the high costs associated. In addition to it, every system does require timely alterations in its procedure to make it effective in every phase; if the same is not performed, then in times to come, the system becomes incompetent to deal with futuristic issues. In future, both PCT and Indian Patent System will flourish while developing solutions to the challenging problems placed ahead.