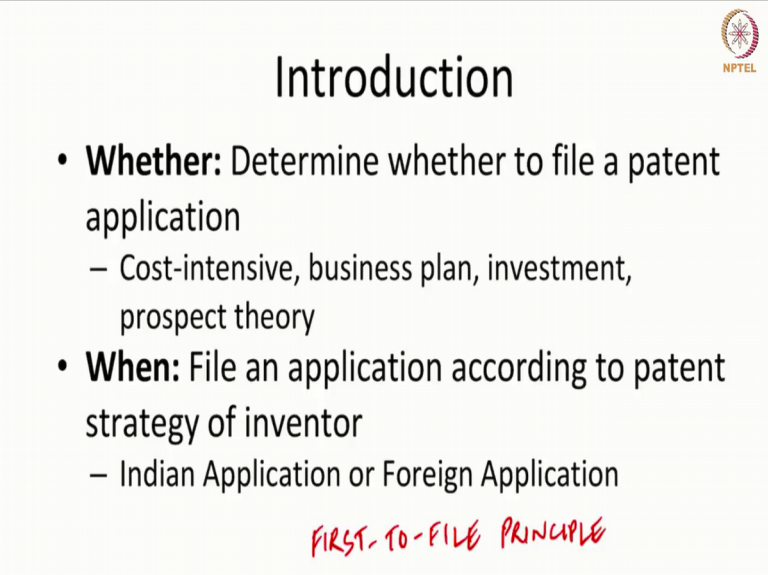
Intellectual Property
Prof. Feroz Ali
Department of Humanities and Social Sciences
Indian Institute of Technology, Madras

Lecture - 23
When and How To File a Patent

(Refer Slide Time: 00:14)



If you want to go forward, then you would look at when to file the patent application. Now, the patent application, the timing of filing the patent application is critical. Because, all countries like India now follow the first to file principle. The United States till recently had the first to invent principle; in the sense, that a person who invents first gets the patent, even if he is late in filing a patent before the patent office.

Now, globally we have one standard which is the first to file principle. In the sense that, regardless of who invented a patent or who came up with the invention, regardless of who came up with the invention for the first time, it is the person who approaches the patent office first by filing an application who will get the patent.

So, what the law has set? It has set a raise to the patent office. It does not matter whether you invent first. So, what matters is the person who filed the patent application first. Now, there is quite lot of history as why we settled on this type of determining who came first. Because, inventor ship disputes are tricky, it is very hard to establish. We will have to get in to lab records, we will have to get back to how people kept logs on the works

they did this, quite a lot of effort that goes in to determining who had actually invented it. And there are cases where 2 people or 2 teams of people may come up and say that we invented the invention around the same time.

So, it becomes very hard to determine who actually was the first inventor because, the patent is again where who there can be only one winner. If there is an invention; even if 10 teams work on the same invention, they can be only one winner, the person who completes it first. And the way in which the patent system determines who completes the invention first is by ensuring who approaches the patent office first. So, this is called the first to file principle.

The first to file principle tells us that, regardless of who invents the invention first, it is the person who first files the patent application in the patent office who will get the grant in his or her name. Now, this also explains the way in which patents are now dealt with there is an urgency to file a patent, because now the world moves on the first to file principle. So, you cannot be happy or rest assured thinking that who are the first inventor and you can prove it in the court of law ; those are now gone. The only way you can prove that you are the true and first inventor that is a place which the patent act uses is to show you approach the patent office first.

So, the urgency that we normally find in filing patents largely is tied to this principle, the first to file principle. Secondly, the urgency in filing patterns is also contributed by the fact that if you do not file, somebody else will file and claim priority. Now, priority simply means who approach the patent office first by filing a document.

So, priority is important for us to understand whether your patent merits to understand whether your invention merits patent the day on which you file an application for a patent. If there is a prior invention disclosed in the prior of, then you do not claim the priority. Because, somebody else is proceeded you to it and also filed an invention or as claimed it. So, if somebody else has already claimed the invention, then you will not get it.

So, priority is important when you follow a first to file principle because you have people approaching the patent office and filing applications all the time. Now, if there is a dispute with regard to who filed an invention or who claims a invention and we will

have to look at the principle of priority. Priorities simply says the point at which you name a full disclosure of your invention.

Now, there are inventions which can be disclosed and parts assumed that there is the invention with 3 critical components you make. A disclosure of the component number 1 in say, in March of a particular year, compound number component number 2 is disclosed in April of the same year and component number 3 is disclosed in May of the same year. So, March, April, May, you make 3 disclosures.

Only when you disclose the component number 3 in May, did you make a full disclosure of your invention. Till such time, it was just a partial disclosure. So, the law will treat the point at which you make the full disclosure which was in May. As the date of your priority, we have quite lot of principles that govern how priority is done, but, you need to bare this in mind. Priority is tied with the disclosure. The day 1 you make a disclosure of your invention, your priority will start.

So, first we have the reason why people rush to the patent of this to file patents is because, we follow a first to file principle which is tied to priority to the danger of those filing a patent and stopping you. So, this is a estimate reason why people file patents because, they do not want to be stopped from involving or engaging in activities that they pursue. Because, somebody else proceeded them in filing a patent and if they get a patent granted, then they will be able to stop the activities.

Now, look at the investment analogy; if you are the head of an RND department which has to invest quite lot of money in a production line. Now, you have to ensure that the line in which you are investing money remains a clear line for years to come. It cannot be that to invest money at a particular assembly line for producing something and find that down the line, there is somebody who has patent of that and they have filed a case to stop you. So, one of the things that you ensure is to clear the way for your products to come out in the future.

So, in that sense, patent is an assessment because, though you file the patent, the benefits that the patents happened at the point later in time. So, to coming back to the when principle, now when your file is largely determined by the loss of the place that you operate and it is also call an inventor has to take. Normally, if the inventor has not come up with the full formed invention, there is a prospect, there is a prominence, but the

inventor has not really, but the inventor has not really thrashed out the detail office invention. The law allows such an inventor to file what we call a provisional application.

A provisional application can be filed. What we call a provisional specification can be filed and later on, within a period of 1 year, when the details of the invention, when the inventor has more details about the invention, say he has done more experiments or he has done more work and improved it. Then, he can follow it with what we call a complete specification.

So, the time of filing can be determined by the rate at which progressing in your work. Sometimes, it could be bright development or promising development that you notice in your lab and you may have to quickly work to ensure that you reach a point where you can make a disclosure. Again, the provisional has to have a disclosure which can cover the entire invention that you have come up with.

Because, if the provision only makes a partial disclosure and later on, after a year, when you have to file the complete, you make the remainder of the disclosure. There will always be a doubt as to when your invention was fully disclosed because of the partial invention of the disclosure.

So, one advice or a rule to follow is that, when you are confident that the entire disclosure can be captured in writing. That is, the time to go for a provisional. You will have still a 1 year to come up with claims to clear out certain aspects of your invention and to explain the invention in detail. So, the call of when to file is something that based on the preparedness of the inventor to what extent the inventor has done work and whether they can make a full disclosure.

Now, apart from this, the inventor also has to describe whether to file an Indian application or foreign application. Now, in India, the inventor resides in a India. Then, the default option is to file an Indian application even if the inventor plans to take the invention to foreign countries.

So, there is a mechanism by which, it is there are 2 mechanisms. In fact, by which after filing an Indian application, you can follow it up within a period; usually, 12 months by filing; what we call a convention application. This is an international treaty. All the Paris convention if we have covered in our earlier lectures. So, the Paris convention allows

you to follow up an Indian application with the foreign application in any of the countries which are signatory to the Paris convention.

So, this is 1 route. If you do not want to take the Paris convention route or rather if you want to enter multiple countries not just one country, then you would follow the PCT route which is the which stands for patent cooperation treaty. Now, patent cooperation treaty is a mechanism by which you can file an application in India and follow it up with PCT application, because India has an office that receives PCT application and then enter different jurisdiction based on your need with an 13 months from the date of filing the application or your priority. So, you have a 13-month period to enter different countries.

So, the when call when to file an explanation will depend on when it has to be an Indian application alone or whether the inventor plans to file application around the world what we call foreign application and whether being a resident. There is also an option of being a resident in India and filing a application in a foreign country or this option can be exercised by getting what is called a foreign filing license.

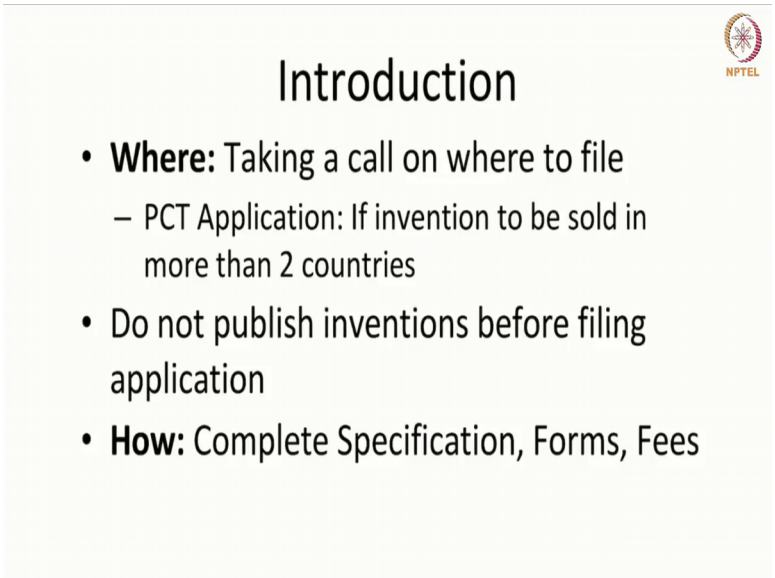
So, this is something which inventors need to bare load. This is something which inventors need to take of many a times. If you are collaborating with a foreign partner and you have a joint venture agreement into or a memorandum of understanding to collaborate and even to file patents joint league.

If your collaboration United States files a patent there and shows you as an inventor. And as a co applicant, then you may be violating a provision of the Indian act which requires the Indian resident, a person is resident in India to either file the applications fist in India or to seek permission to file for an applications. So, the permission to files foreign applications is a requirement under the Indian law, and it has to be specified especially in cases where you have joint venture partnerships with foreign entities.

Because, the foreign entities will proceed and file a patent in their country showing you as a co applicant without seeking the necessity application, without seeking the necessary permission from the Indian patent office and you can blame the patent of all this because, this is a requirement in Indian law. So, if you have to file an application either you buy yourself or through your foreign partner, ensure that if you are a resident in India and the invention was made in India or part of it was developed in India. Then, you need to get an permission before you file a foreign application.

You can always file an Indian application first and follow it up with the foreign application, then the formation is not required. But, if you are not going to file an application first in India, you have to ensure that the required permission is obtained from the Indian patent office even if the entire filing is done on your behalf by your foreign particles.

(Refer Slide Time: 14:58)



Now, where to file the application? Now, the where to file the application is not a problem is difficult to solve because, in most countries require a residency requirement have a most countries have a residency requirement.

If you are a resident of a country, then and if you have come up with a invention. The law will require you to file it in that country first and if you want to file it in as the country, as we just mentioned, you may have to go through a process of getting in approval from your local patent office. So, the call on where to file is kind of addressed by the Indian act which says that, if you are in a resident and if you have invented something, you have to file it in India. It is a default option. But, an option is given for you for whatever reason you want to file an application in a foreign country to seek permission.

If you want to file in a foreign country first now, they could be some inventions developed by inventors in the which may not have a market in India at all, say the United States will be the primary and probably the only market in such cases it does not make

any sense to file a application in India a prosecuted getting granted. If it allow by paying fees in such cases, you can get a foreign filing license from Indian patent office and based on the license, you can file an application in the foreign country.

We are already mentioned this, you can file if you are interested in protecting your invention in more than 1 country, say 2 or more countries, then you can file a convention application under the Paris convention or a PCT application having a patent cooperation treaty application which is managed by another international organization called the WIPO: WIPO which stands for intellectual property organization. Now, if you are making multiple filings across the globe, one thing you be ensured is that you do not publish the invention before filing the first application.

Once you file a first application, you preserve the priority that application you file first preserves the priority for you and based on that, you can disclose the invention in multiple application. Law allows you to disclose your invention after you have published your application. So, law allows you to disclose your invention after you have filed an application.

So, filing a patent application is important for you to preserve the priority. So, what happens if you first publish and then file patent applications? Now, your publication could be used by the patent office to state that your invention lacks novelty. Now, you may be wondering the publication is mine and the application is also mine, why should my own publication be used to kill the novelty of an invention. Because, I make the publication, then I file the application, the law is same here across the globe that a person who seeks patent should maintain secrecy about his inventions till the invention is filed in the form of a patent application.

Those secrecy has to be maintained by the applicant himself and if the applicants files or publishes the information before filing the patent, then it is assumed that the inventor has allowed the information with regard to the invention to come into the public domain. What is in the public domain can be used to kill the novelty of any patent application.

So, care has to be taken in not publishing the information about the invention before filing the patent application. Now, how do you file a patent application? Now, patent application has the series of forms. There are fees that a company, each of those forms you normally file a patent application by drafting a complete specification, a complete

specification, there are parts to a complete specification. It is a techno legal document in the sense that, it captures the technology and history of the technology and the development of the technology above the invention, but then is worded like a legal document.

Because, unlike a scientific journal article where you make claim or where you cut discovery and inform the world about a working of an working of technology or a product, unlike a review article in a scientific journal, a patent makes a claim. The patent specification ends with the claim. A claim is worded as I claim or we claim where the inventors claim something that they have invented as their own private property.

So, this part of making a claim with the objective of enforcing a legal right against third parties; when the patent is granted, is not there in a journal article published in a scientific model because, you do not publish an article with the objective of stopping others what you have done.

Whereas, patents are documents which are filed with the objective of stopping others who are not willing to pay your royalty or who do not enjoy your consent. Now, because these documents perform the function of stopping others, the documents have to clearly show; what are the boundaries of your property patent is an intellectual property. So, you need to demark the boundaries of your invention very clearly.

So, that you achieve 2 things; one is make it very clear that your property is not does not belong to the public domain, it is not a part of the public domain, because if it belong to the public domain, then you are not entitled to a patent in a first plane. 2, you make the boundaries. So, clear that others know where the limits are. So, that people do not infringe it and people respect your right. So, the way in which we achieve this is by drafting a claim.

Now, patent law is an art of capturing technology in words in such a way that it performs notice functions to the world at large with regard to what you have invented and telling the world at large that this is a private property. So, this is done through a document what we call the complete specification. And once the complete specification is ready it is filed using particular form and by payment of particular the appropriate fees. We are already mentioned if the complete specification is not ready or you need to make exclusion. But, a full disclosure of your invention, you can also file a provisional

specification the difference between a provisional specification and a complete specification is that the complete specification must have claims.

The last part of the document where you make a claim with regard to your invention, what we call the claims have to be there in a complete specification, in a provisional specification you can file even without having claims.