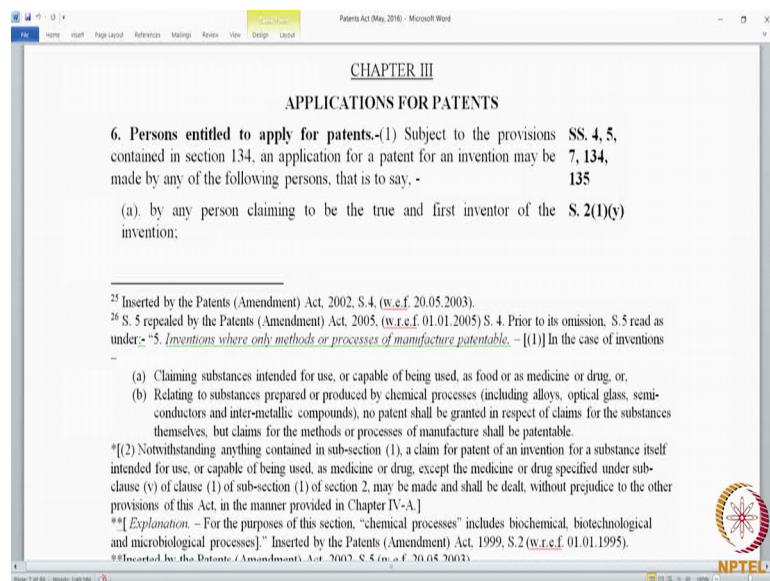


Patent Law for Engineers and Scientists
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Lecture - 20
Patent Prosecution: Patent Applications
Who Can Apply for a Patent?

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“Applications for patents” Section 6 of the patents act describes the categories of persons who can apply for a patent; section 6 one reads subject to the provisions contained in section 134 an application for a patent for an invention maybe made by any of the following persons. Now section 134 deals with international applications, we will be covering that in detail at the appropriate point. International arrangements 134 specifically deal with notification as to countries not providing for reciprocity. So, subject to that provision the following categories of persons can make an application.

Now, if you see on your screen we have given cross references to section 4, 57, 134, 135, and section 2 1 y, these are the relevant cross references. So, you can check them to see how this provision is related to the other provisions of the; at and the rules the first category of person who can apply for a patent is a person claiming to be the first true and first inventor of the invention.

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Who can apply for patents?

- True and first inventor of the invention
 - S.2(1)(y): “true and first inventor” does not include either the first importer of an invention into India, or a person to whom an invention is first communicated from outside India
 - Person who makes the invention for first time
 - Natural Person; Assignee



Now the true and first inventor is defined in section 2(1)(y), the true and first inventor is defined as the person that does not include either the first importer of an invention into India or a person to whom an invention is first communicated from outside India.

What the definition does rather than explaining who are true and first inventor is, it just says the 2 categories of persons who will not come under this definition. If you import an invention into India then if you are the first importer, you will not be regarded as the true and first inventor. Section 48 refers to importation as one of the rights protected by a patent. A patent when it is granted also gives the right to import and invention. So, this very specifically says true and first inventor is a person who has to do something with the creation of the invention not merely importing it.

So, mere importation of the invention into India will not make you the true and first inventor. Similarly a person to whom an invention is communicated is first communicated from outside India. Now in the earlier occasion the product came into India in this category the invention was communicated and you will know the invention can be communicated in various ways there are communications get can destroy the novelty of an invention, there are secret communications or protected communications confidential communications. So, when an invention is first communicated to a person in India from outside India even that will not qualify for a true and first inventor.

So, that brings us to the question who is the true and first inventor. True and first inventor is the person who conceives and develops the invention. We could also say that he is the person who puts into practice the invention for the first time if you recall the history of patent law, true and first inventor is a phrase that developed in the United Kingdom and we have cases to say which describes how this concept evolved. An analogy in understanding the true and first inventor will be the author of a copyrighted work the author of a copyrighted work is given a special status in copyright law. He or she is a person who makes the original work for the first time.

So, the person who makes the invention for the first time is regarded as the true and first inventor. Just as you cannot have a copyrighted work without an author, similarly you cannot have a patented invention without a true and first inventor. So, inventor is the person who creates the invention and patent law does not recognize an invention which does not have an inventor. So, in the explanation to the definition of true and first inventor actually excluded by mentioning a person who imports for the first time and a person who communicates for the first time it actually excluded or it did not say anything about the person who actually created the invention.

So, you understand the true and first inventor as the person who created the invention for the first time and analogy as I mentioned is the author of a work or written work or a literary work which can be subject matter of a copyright the author may later on assign his right of publication to a publisher and the publisher may publish that book. So, even if there are publishers or even if there is a publisher behind a book, we would normally expect that book to be authored by a person legal entity. So, in this case when we find an invention we expect there to be a person or a group of real legal entities behind them, whom you refer to as a first true and first inventor.

It is possible for the true and first inventor to assign the invention to a third party, and the person to whom the invention gets assigned is called the assignee. So, it is possible for, but still even in the case of an assignment it is critical to have a true and first inventor.

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Who can apply for patents?

- True and first inventor of the invention
 - Form 1; Clause 4 and 12

4. INVENTOR(S) [Please tick (✓) at the appropriate category]			
Are all the inventor(s) same as the applicant(s) named above?		Yes ()	No ()
If "No", furnish the details of the inventor (s)			
Name in Full	Nationality	Country of Residence	Address of the Inventor

12. DECLARATIONS
(i) Declaration by the inventor(s) (In case the applicant is an assigner; the inventor(s) may sign herein or the applicant may upload the assignment or enclose the assignment with this application for patent or send the assignment by post/electronic transmission duly authenticated within the prescribed period) I/We, the above named inventor(s) is/are the true & first inventor(s) for this Invention and declare that the applicant(s) herein is/are my/our assignee or legal representative. (a) Date (b) Signature (s)



Now, the proof of the statement you can find in form one of the patent rules. So, if you look at form one you will find that form one which is the first form in the second schedule, second schedule deals with all the forms you will find in clause 4 of form 1 the inventors have to be mentioned. And in clause 12 which deals with declaration, the first declaration is the declaration by the inventors where the inventors would state or declare if there are multiple inventors we the above named inventors are the true and first inventors for this invention, and declare that the applicant herein our assignee all legal representative.

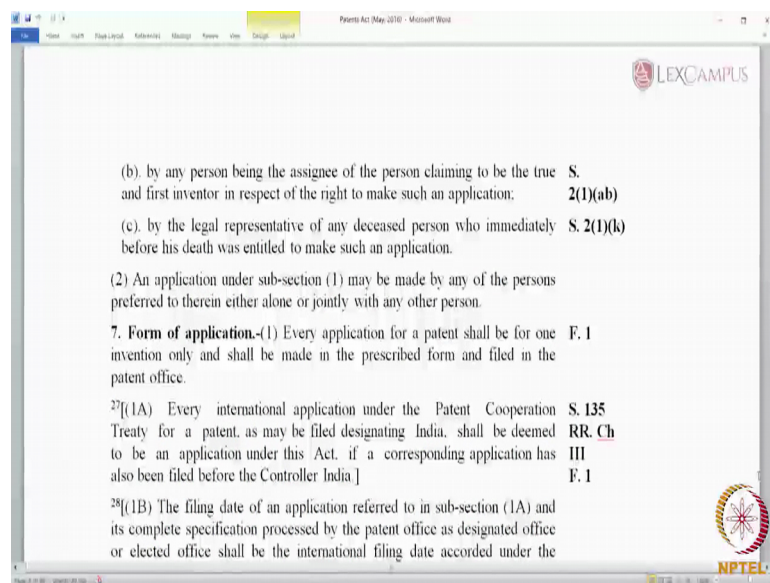
Now, this tells us that even if there is an assignment of the invention it is necessary for the inventor to make a declaration that they other true and first inventor. A declaration made by the true and first inventor may not have any bearing on determining who invented the invention for the first time, though the phrase refers to it as the true and first inventor, this phrase will not be critical in determining disputes with regard to inventor ship for the simple reason that India follows the first to file principal rather than the first to invent principle.

If the united states used to follow the first to invent principal till sometime back, but in 2013 they amended the law and now and united states used to be alone exception in that, now they universally follow what other countries do the way to determine inventor ship is to determine who at first file the invention. So, we follow the first file principle and.

So, the first inventor in the course of history this is not the case, they were instances as patent law developed where inventors would litigate or have a legal dispute with regard to who invented the invention for the first time.

So, but this is something that has been carried over from history. So, that is why you still have the phrase true and first inventor. So, we just now saw that how the phrase to when first inventor is defined in a manner in which it excludes 2 categories of people the person who first imports invention for the first time, and the person who first communicates the invention into India for the first time from outside India obviously. Now this is the first category of people who can make an application because the section 6 talks about who can make an application for a patent. So, the person who invents the invention who creates the invention for the first time can file an application for a patent. So, that is the first category.

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The second category is mentioned in 6 1 b by any person being the assignee of a person claiming to be the true and first inventor in respect of the right to make such an application.


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Who can apply for patents?

- Assignee of true and first invention
 - True and first inventor assigns the right in the invention
 - Form 1; Clause 12(iii)

(iii) Declaration by the applicant(s)
I/We the applicant(s) hereby declare(s) that:-

- I am/We are in possession of the above-mentioned invention.



So, the second category is a person being an assignee of the true and first inventor. So, the right to make an application comes from the true and first inventor, because this category says that if the true and first inventor assigns the right in an invention then the assignee can step in as the applicant. So, we understand that there are 2 categories of people to whom an invention can be related to. The first category as a true and first inventor who is the maker of the invention and the second category is the applicant who can apply. So, the person who makes the invention need not be the applicant in all the cases. In 6 1 a; the person who is the true and first inventor the inventor can actually be the applicant, but in most cases the applicant will be the assignee.

For instance if a person works for a institution a research institution. The scientist who works in the research institution will be regarded as a true and first inventor of the invention, but most likely the patent will be filed in the name of the research institution itself. So, the research institution will be the applicant and the scientist who came up with the invention will be shown as the true and first inventor. Now the right to make the application by the research institution will be through an assignment. So, the true and first inventor either through the employment contract or by through some special arrangement, will have to assign the right in the invention to the assignee that is the research institution for the research institution to make an application. So, the assignee is not the inventor, but the assignee gets the right from the true and first inventor so that is the second category.


Just as the true and first inventor is expected to make a declaration in form one similarly the assignee also needs to make a declaration in form one. Now the declarations are as I mentioned in clause 12 of form one, and you will find in the third part in clause 2 clause 12 declaration by the applicants; there you will find I am slash v or the assignee or legal representative of the true and first inventor. So, this statement needs to be made by the assignee for assignee can only get his or her right from the true and first inventor and the assignee has to say that there is an assignment.

The third category is mentioned in 6 1 c by a legal representative of any deceased person who immediately before his death was entitled to make such an application. Now we saw in a and b, there are only 2 kinds of categories of people who can make this application: one the inventor or the assignee of the inventor.

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Who can apply for patents?

- Legal representative of any deceased person
- Application can be made either alone or jointly



Now, the third categories says there could be a legal representative of a deceased person who immediately before his death was entitled to make that application, which largely means the legal representative of the true and first inventor or the legal representative of the assignee.

So, this is the clause that covers instances where someone was entitled to make an application, but could not do it because of their death. In such cases the legal representative whoever would inherit them or whoever would succeed them or whoever will have the rights of that person will be entitled to make an application. So, this covers

legal representatives of an inventor as well as legal representatives of an assignee; in the case the assignee is a body corporate like a company or an organization, then again legal representative will mean; obviously, the death of a body corporate does not (Refer Time: 14:00), but the person who was entitled to make the application if that person dies then any person who can step in as the legal representative of that person can make the application.

And section 6 2 states that any application an application made under subsection 1 may be made by any of the persons prefer to therein either alone or jointly with any other person. So, the true and first inventor can jointly make the application with the assignee if you are not assigned the entire invention to them, the true and first inventor could also jointly make an application with legal representative of a deceased assignee, if the diseased assignee is an individual. So, you could have an application made jointly by the people who mentioned in this category or they can make that application alone.