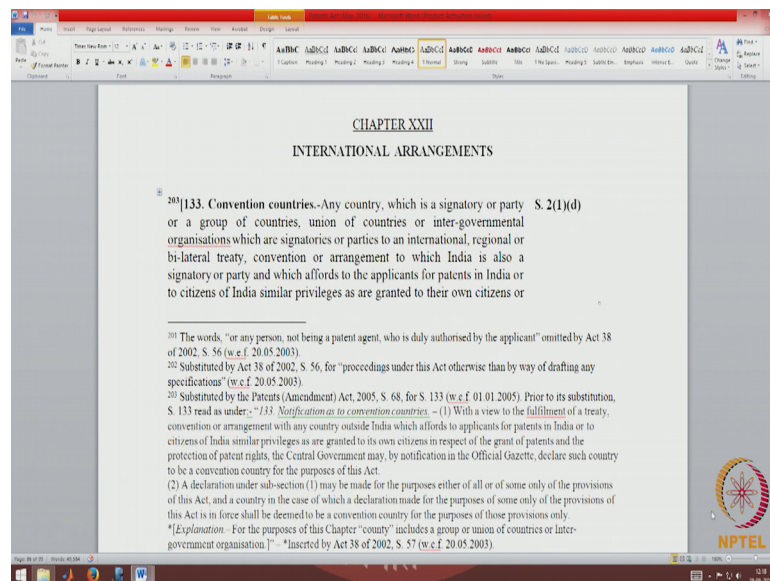


**Patent Law for Engineers and Scientists**  
**Prof. Feroz Ali**  
**Department of Management**  
**Indian Institute of Technology, Madras**

**Lecture – 76**  
**Patent Enforcement, International Arrangements & Other Miscellaneous Provisions**  
**International Arrangements**

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Chapter 22 deals with international arrangements. International arrangements refer to the process by which you can file multiple patented applications in multiple jurisdictions. Now this is a broad arrangement between various countries that is why we call it an international arrangement and there are two types of arrangements we will see that soon

There are two types of arrangements wherein you could file an application in one country, regard that as a priority document or that filing based on which you are made the filing as a priority date, and follow it up with filing in other country. Has it not been for an international arrangement like this, assume that there was no such international arrangement between countries then the only way you can file patent will be to have different teams ready at different patent office around the world, and to file the patent on the same day in such a way that one filing does not amount to disclosure of the novelty in another office.

So, the only way you could preserve the priority and the novelty of an invention, is by filing multiple applications by having teams to do that in different countries. So, the international arrangement actually helps us because it dispenses the need to be physically present with the team in different countries, to make the application at the same time. Now the difference priority is important to know who has the claim over an invention.

Now, assume that you have an invention and you have place 3 teams in 3 different countries to file an application, and you do that on a particular day. On the same day in a fourth country which you have not done which is not covered, there is another person who files in application for a similar invention very close to yours. Now that could lead to problems because that person can claim that he had no knowledge of your application, and he file it in a same day in a different country.

Now, the international arrangement in a way helps us to resolve those issues because if you file in international application or a basic application as the act calls it, then based on the basic application you could follow up many applications in different countries and they will all take the priority from there international application or the date of the basic application. Now that can broadly be done in two ways, one is to make a convention application and the other is to make up PCT patent cooperation treaty.

Now, you will remember in form 1 when we talk you through form 1 there was a column in forma one which dealt with types of application. You could file in a ordinary application that is an application focused on India an Indian application, you could file a convention application and the third type was an PCT national face application. The three types of applications you can file in India are ordinary convention and a PCT national face.

Now, conventional a PCT national face are covered in this chapter. Now the details of a PCT you may not find it here because PCT is a separate treaty in itself to the patent cooperation treaty which is administered by the WIPO world intellectual property organisation. So, they have dedicated websites, they have dedicated regulations. So, the details you have to refer to those regulations to understand how the PCT process works.

But the act covers what you need to know about international arrangements, and this will be important from the perspective of taking examinations what will be asked is what is

been covered in the act and rules. Rules are elaborate, but because i just need to bring your attention to the rules, we had a amendment done to the rules in 2013 and 2013 is an important year because that is the year India became an international search authority and India also became a international preliminary examination authority.

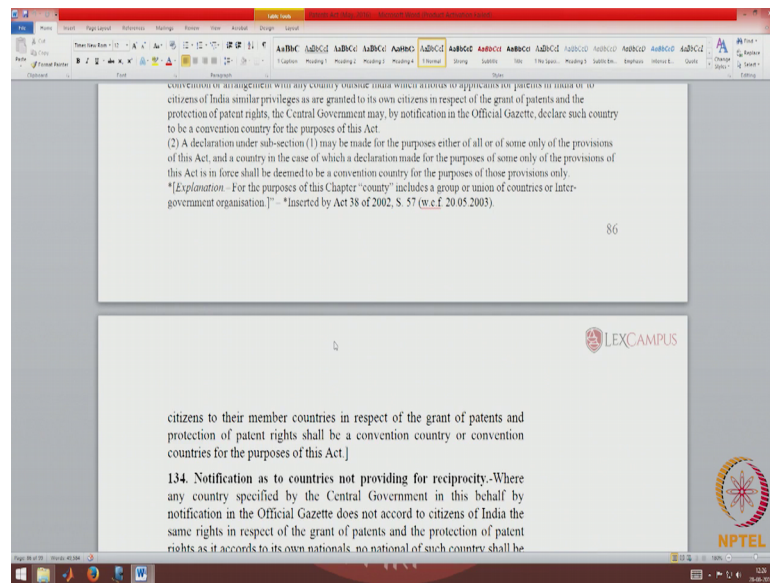
So, India. So, you could file an application in India and you could get Indian international search report, and then Indian international preliminary examination report. So, 2013 the amendment carried out in the patent rules that is from rule 19, the rule 19 which has rule 19 rule 19 a up until rule 19 n all these rules were introduced to bring in the details of that are provided under the patent cooperation treaty, by which India became an international search authority and an international preliminary examination authority.

And you will recollect that using India as an international search authority or international preliminary examination authority is one of the ways by which you can have an expedited examination. So, you will have to look into the details and rules 19 to understand and 19 followed by rule 20, 21, 22 and 23 to understand how the PCT process works, there are various institutions under the PCT, there are body, there are reports, there are timelines.

133 talks about convention countries; now when the patent act came into force this section was substituted in 2005, earlier there was a notification of convention countries and now you have convention countries defined in as it they are defined in section 2 1 d. Convention country means a country or a country which is a member of a group of country or union of countries or an Intel governmental organisations, referred to as a convention country in section 133.

So, section 133 refers to what a convention countries is. Any country which is a signatory or a party or a group of country union of countries or intergovernmental organisations, which are signatories of parties to an international regional bilateral treaty convention or arrangement to which India is also a signatory or a party. So, it could be anything, it could be a treaty a bilateral treaty, a convention, an arrangement or a regional arrangement on international arrangement the requirement is India should be a party to that.

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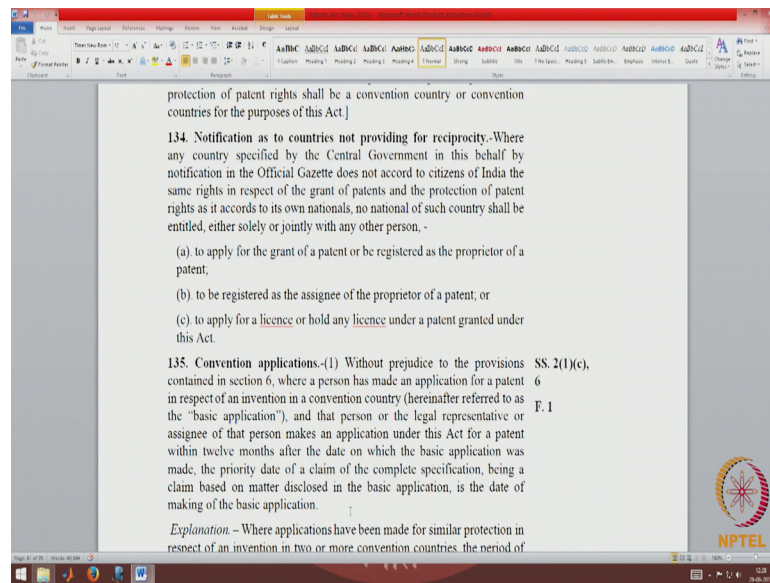


So, we understand a convention country as any arrangements to which India has is a party India is a signatory or a party, and which efforts to applicants for patents in India or to citizens of India similar privileges as a granted to their own citizens or citizens or their member countries in respect of grant of patents and protection of patent rights shall be a convention country.

Now, which means India should be the first requirement is India should be a signatory or a party to that arrangement or that agreement or that treaty and that arrangement or treaty or convention should offer reciprocity, meaning which the rights that are offered to Indian citizens India will offer to the citizens of that country, which means the country is respect each other's rights

So, on the basis of reciprocity India can be regarded as a convention country, if India is a signatory or a party to convention and the convention treats Indians like how it treats its own citizens. So, this is a test for a convention country. So, if India is in a party to an arrangement and the arrangement treats Indians and citizens or applicants for patents in India or citizens of India, like how it treats its own citizens then that is regarded as a convention country.

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Now, notification as to countries not providing for reciprocity. Now we said that in one thirty three the important principle was reciprocity; if countries do not provide for reciprocity, then there is a process by which any country specified by the central government in this behalf by notification if that country does not afford to citizens of India the same rights in respect of grant of patents and protection of patents that it occurred to its own national, no national of such country shall be entitled either solely or jointly to apply for a patent in India to be registered as an assignee or to hold a licence. So, if a country does not offer reciprocity, then 134 says that the national of that country will not be entitled to apply for a patent, register assignee or a proprietor of a patent or apply for a licence under a patent of this act.

Now, convention applications are mentioned in o135. Now in section 6 we saw that an application can be made by three people or three categories of persons. A True and first inventor assignee and a legal representative of a person who is entitled to apply these are the three categories.

Now, without prejudice to that, a person who has made an application in a convention country and that is the first application he makes in a convention country. There is a convention in which say we can take the Paris convention, where many countries are parties to it. So, a person makes an application for the first time in one country say he makes an application in the United Kingdom. That application will be call the basic

application the application that he first files will be called the basic application, and that person or legal representative of the assignee of the person makes an application under this act for a patent within 12 months after the date of the basic application was made.

Now, what is the requirement to make a convention application? An application has to be made in a convention country within 12 months of making that application, that application because it is the first application it will be called the basic application within 12 months of the basic application, an application had to be made in India. The priority date of the claim of the complete specification being a claim based on the matter disclosed in the basic application is the date of making the basic application. Which means the priority date is the date on which the first application was filed. It is the logical arrangement the first date on which the application was filed will be the date of the basic application, because that was the first application that was filed, but it could be filed in a different country.

So, this we saw in the case of provisional and complete specification; the complete specification could take in some instances it could take the priority from the provisional. What was the requirement? The matter should have been fairly based on the provisional if the claims are fairly based on the provisional, the claims can take the priority from the provisional. Now the claims based on matter disclosed is a language used here, you can see here claims based on matter disclosed in the basic applications this is nothing, but the concept of fair bases. Matter disclosed is it based the word fairly is missing, but it is understood that the same thing.

So, just how we had a basis for claims in the complete specification, if they had been fairly based on the disclosure made in the provisional you could claim the priority of the provisional. Similarly when you find an application in India and the claims or the claim is based on a matter that was disclosed in a basic application, which as we had mentioned in our example is an application filed in United Kingdom. So, you could claim the priority of the application in United Kingdom. The only requirement is you should file the Indian application within 12 months of filing the application in the United Kingdom, which is what the act refers to as the basic application.

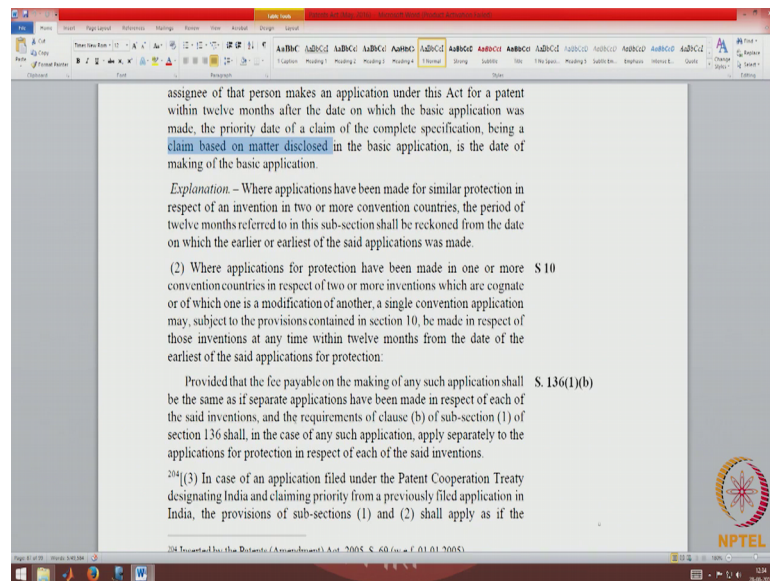
So, the concept of priority when it comes to a convention application is similar to the concept of how a complete specification takes its priority from a provisional

specification. But there are some differences because in this case both are complete the basic application is a complete file in united kingdom, and the Indian application file later on within 12 month is also a complete. So, this is complete taking priority from another complete and we had also seen in similar instances within the Indian patents act.

So, this arrangement allows the international arrangement by filing a convention application, allows you to take priority from another application file in another country. Provisional and complete pertain to applications filed within India within the Indian patent office, but here by this arrangement you are allowed to take priority from a different application filed in a different country.

And you have similar provisions like in respect of an invention two or more convention countries, the of 12 months shall be recant from the earliest application.

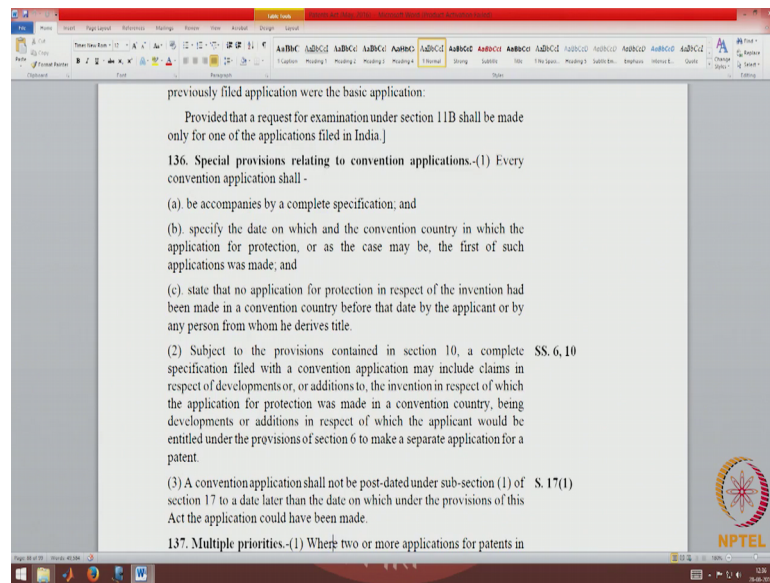
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just how we had if there are multiple provisional applications followed by a complete, then the date the 12 month period will accrue from the date of the first filing the from the date of the first provisional file. Sub section two talks about cognate applications which are related the priority will be from the earliest date.

Now, 3 you will find introduce PCT into the scheme; now this was an earlier provision.

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Now, in which only pertain to convention countries and three was inserted in 2005, because India became a party to the PCT at a later stage. So, this was incorporated as an amendment. In the case of an application filed under the patent cooperation treaty designating India and claiming priority from a previous file application in India, the provision of one and two shall apply access the previous filed application where a where the basic application provided that a request for examination under section 11B shall be made only for one of the applications filed in India.

Now this is a case where if an applications filed in India and you can file a PCT application based on the earlier filled application. The earlier filled application will do the job of a basic application. So, the PCT the arrangement is different from the convention application.

In PCT you file one application and you file a PCT application, and then you can choose the different jurisdictions that you have to enter and you will be given a time period 30 months by which time you have to enter all the other jurisdictions. So, the convention application is one route to enter multiple jurisdictions, the PCT the patent cooperation treaty is another route.

136 deals with some special provisions on how to determine on postdating, what should be accompanied with the application, you cannot file international application based on a



provisional; you have to file your complete. So, these requirements are there and how do you deal with multiple priorities 137 deals with instances of multiple products.

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Act the application could have been made.

**137. Multiple priorities.**-(1) Where two or more applications for patents in respect of inventions have been made in one or more convention countries and those inventions are so related as to constitute one invention, one application may be made by any or all of the persons referred to in subsection (1) of section 135 within twelve months from the date on which the earlier or earliest of those applications was made, in respect of the inventions disclosed in the specifications which accompanied the basic application.

(2) The priority date of a claim of the complete specification, being a claim based on matters disclosed in one or more of the basic applications, is the date on which that matter was first so disclosed.

(3) For the purposes of this Act, a matter shall be deemed to have been disclosed in a basic application for protection in a convention country if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgement of a prior art) in that application, or any documents submitted by the applicant for protection in support of and at the same time as that application, but no account shall be taken of any disclosure effected by any such document unless a copy of the document is filed at the patent office with the convention application or within such period as may be prescribed after the filing of that application.

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We already seen the issue of multiple priorities, when we covered section 11 and also when we recovered section 9 on provisional and a complete based on the provisional similar rules apply here.

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**138. Supplementary provisions as to convention applications.**- <sup>285</sup>(1) R. 121

Where a convention application is made in accordance with the provisions of this Chapter, the applicant shall furnish, when required by the Controller, in addition to the complete specification, copies of the specifications or corresponding documents filed or deposited by the applicant in the patent office of the convention country as referred to in section 133 verified to the satisfaction of the Controller, within the prescribed period from the date of communication by the Controller.]

(2) If any such specification or other document is in a foreign language, a translation into English of the specification or document, verified by affidavit or otherwise to the satisfaction of the Controller, shall be <sup>286</sup>[furnished when required by the Controller.]

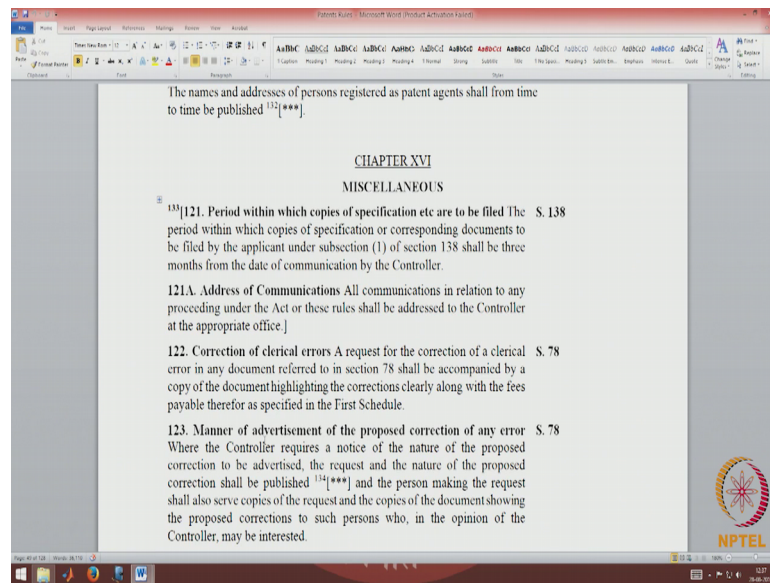
(3) For the purposes of this Act, the date on which an application was made in a convention country is such date as the Controller is satisfied, by certificate of the official chief or head of the patent office of the convention country or otherwise, in the date on which the application was made in that convention country.

<sup>287</sup>(4) An international application filed under the Patent Cooperation Treaty designating India shall have effect of filing an application for patent under



And there are some supplementary provisions on convention applications.

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I had already mentioned that the relevant rule for PCT applications, and convention applications will be rules 19 to 23.