

ROADMAP FOR PATENT CREATION

STATUTORY DIFFERENCES BETWEEN INDIA, EUROPE AND USA

LECTURE 29

A very warm welcome in the fourth module of week 6 of the Course, roadmap for patent creation, titled “Statutory Differences between India, Europe and USA” A Brief about the Patent Systems in Different Countries USA

- The first patent statute was enacted with the object entitled “An act to promote the Progress of Useful Arts ”.
- There were 7 sections and the patent term was fourteen years(14 yrs).
- The patentable subject matter considered was , ‘any manufacture, engine, machine or device, or any improvement there in not before known or used’ which was later amended to include:
 - After US became a signatory to The Paris Convention it enacted Sherman Act of 1890 and the Evarts Act of 1891.
- The Sherman Anti-Trust Act was the first Federal act was approved on July 2, 1890, This law outlawed monopolistic business practices.
- The Sherman Antitrust Act of 1890 was the first measure passed by the U.S. Congress to prohibit trusts
- In 1952 the new structure of patent act took shape.
- At present the Title 35 of United States Code (USC) governs all cases related to patents.

EU: United Kingdom

- In UK two different systems co-exist together. One at the Regional Level and the other at the National Level.
 1. The EPC system works at the Regional Level, and covers 38 European States including United Kingdom.
 2. It is an inter-governmental organization that was set up in October 1977 on the basis of European Patent Convention (EPC) which was signed in Munich in 1973.
 - a. The EPC has two bodies, The European Patent Office-executive and the European Patent Organization-administrative.
 - b. It provides a Uniform Filing Procedure to an inventor seeking patent protection in up to 38 European Countries.

2. UK also has a national legislation for grant of patent, which is the UK Patents Act 1977.

India

- In India, the patent law dates back to nearly 150 years.
- Earlier India followed the British Patent Act, which was applied with subsequent amendments.
- The different acts for protection of invention were as follows:
 - Act VI of 1856: Based on British Patent Law, 1852 [later repealed]
 - Protection of Inventions Act, 1883 [amended]
 - The Inventions and Designs Act, 1888 [repealed]
 - The Indian Patent and Designs Act, 1911.
- After Independence, it introduced a bill in the Parliament in the year 1965 which got passed as, 'Indian Patent Act, 1970'. This act was later amended in 1999.
- In 1995, India became a signatory to the Trade Related Aspects of Intellectual Property Rights [TRIPS]. It became obligatory for India (developing country) to include the provisions of TRIPS into its statute
- India Patent Act, 1970 is amended in 2002 and 2005 subsequently to fulfill its TRIPS obligations.

Statutory Differences

. First-to-file versus first-to-invent

- US used to follow the system of *first-to-invent* over *first-to-file*.
- However in March 2013 the Leahy-Smith America Invents Act, changed to *first-to-file* system.[35 USC s.102]

2. Grace Period for Disclosure of Application

- In US [35 USC s.102], one-year grace period has been given to the inventor.
- If the invention has been made 'publicly available' (by selling the invention, giving lecture about it or showing it to an investor) before the filing of the application, then the inventor has a time-period of one year to file the application and obtain a patent.
- The inventor can freely publish his invention without losing his patent rights.
- With the Leahy-Smith America Invents Act 2011, the grace period is limited to publications by the inventor himself or by someone who has obtained information directly from the inventor. Any disclosure from a third party would destroy the novelty of invention.

- In Europe [Article 54 of EPC] and in India [sec 2(l), sec. 20,30 &31 of Patent Act 1970], a grace period is not given.

If the invention has been made 'publicly available' (by selling the invention, giving lecture about it or showing it to an investor) before the filing of the application, the application would be rejected

3. Types of Patents

- In EU and India there are two types of patents:

Product Patent and Process Patent.

- Whereas in US there are three types of patents:

Utility Patent, Design Patent and Plant Patent.

Utility Patent: granted to anyone who invents any new or useful process, machine, article of manufacture or composition of matter, or any new and useful improvement thereof;

Design patent: granted to anyone who invents a new, original, and ornamental design for an article of manufacture. It only protects the appearance but not the functional or structural features. Protection is for 14 years only.

Plant Patent: granted to anyone who invents or discovers and reproduces any distinct any new variety of plant including cultivated sports, mutants, hybrids and newly found seedlings other than a tuber-propagated plant or a plant found in an uncultivated state.

4. Test of Obviousness: Different Approaches

the statutory requirement for Obviousness/inventive step is same in all jurisdictions that is IN, EU and USA

signatory to TRIPS.

However the difference lies in the method of interpretation that has developed through Court precedents in different jurisdictions.

In India the test for non-obviousness/inventive step

[sec. 2 j(a) Patent Act 1970] is interpreted by the Supreme Court in '*Biswanath Prasad Radhey Shyam v. Hindustan Metal Industries*'. According to the test, *what has to be determined is whether at the time the invention was made, any other person skilled in the same field would have come up with the same invention, had he faced the same problem.* – If the objective answer to this question is a YES, then the invention is Obvious.

- In USA the provision for non-obviousness [35 USC 103] was interpreted by the US Supreme Court in The court gave the following guidelines:- '*Graham v. John Deree*'.

- 1] Determine the scope and content of prior art

- 2] Analyze the difference between prior art and the invention

- 3] Determine the level of ordinary skill in the pertinent art

- 4] Ascertain secondary considerations of non-obviousness (like long felt but unmet need of the device or the failure of the others to solve the problem that the said invention does, etc.)

- In EU the Board of Appeals at the EPO have interpreted the meaning of 'non-obviousness/inventive step' [Art. 56 of EPC] through the test of problem-solution approach:-

- 1] Choose the closest prior art

- 2] Determine the technical problem- Determine the technical problem that invention addresses. Also determine the technical differences between the closest prior art and the invention in question.

- 3] Examine the solution- whether the solution is obvious to the person skilled in the art.

5. Best mode requirement

- In US [35 USC 112] the patent law requires the inventor to disclose the best way to practice the invention in the patent application. Failure to do so would invalidate the patent application.

- Under the Leahy-Smith America Invents Act 2013, now it is formally required by the applicant to disclose the best mode, but without invalidating the patent application.

- In India [sec. 10 (4)(b) of Patent Act 1970], requires an applicant to disclose the best method of performing the invention which is known to the applicant. The applicant is also required to disclose all the best mode of performing the invention if there are more than one, in the specification.

- In EU there is no such requirement. Only one way to perform the invention must be included into the application [Art. 83 EPC]. It does not mandate any mention of best way to perform the invention.

5. Non-patentable Inventions

6. In EU [Art. 52(2) & 53 of EPC] and India [Sec. 3 & 4 of Patent Act 1970], the statute describes what is not an invention and, thus, cannot be patented.

7. The two countries follow an exclusionary approach: as to what is mentioned under the statutory list cannot be patented while that which is not mentioned under the list is only entitled for patent protection.

8. In US [35 USC s. 101], the statute describes what is an invention and can be patented. Unlike the EU and Indian approach, it does not expressly exclude anything.

9. US follows an inclusionary approach: as to what is mentioned in the statutory list can be patented and not otherwise.

7. Rights conferred by a Granted patent

- An Indian and US patent is a property right that is enforceable in the whole territory of India or USA, respectively.

- It allows the patent holder to prevent anyone from making, using or selling the patented invention in the respective countries.

- An EU patent on the other hand is granted under European Patent Convention (EPC), which is a Regional Treaty. The grant of patent under EPC, confers upon the owner the option to choose the countries in which he/she wants protection from the list of 38 countries.

The patent holder then has the same rights and obligations as mentioned in the national patent laws in those EPC countries where the inventor wants to secure his patent

8. Publication of Patent Application

- In US until Sept. 2000, the Patents were published only after they were granted. After the amendment in 2000, now the Patent applications are published 18 months after their filing date, unless they are withdrawn. [35 USC s. 122(b)]

- In EU [Art. 93] and India [Sec. 11, Rule 24] all patent applications are published 18 months after their filing date, unless they are withdrawn.

- The only difference now is that a non-publication request can be made in US while it cannot be made in EU and India.

9. Challenging the Validity of Patent after grant

- In EU, within 9 months, [Art. 99 EPC] and in India, within 1 year, [sec. 25 of Patent Act 1970] after the grant of patent, anyone can file an opposition, with the Patent Officer, stating evidences and reasons as to why patent should not be granted.

- The officer then conducts a hearing where both sides are allowed to argue and defend their case. This is known as "opposition proceedings".

- In US there is a “re-examination proceeding” that is different from the “opposition proceedings”.
- A “re-examination proceeding” [35 USC s. 305] can be initiated by anybody during the life of the patent, with the USPTO examiner by presenting reasons and evidences.
- The USPTO examiner then discusses the same with the patent holder. The party challenging it is not a part of this proceeding.
- The USPTO examiner acts as an arbiter & examines the patent on the grounds of novelty, obviousness and utility and judges the standards against the prior art in the field.

10. Patent Term Adjustment

- The Patent term in India [sec. 53(2)] and EU [Art. 63 of EPC] is 20 years from the date of filing of the application.
- In US the patent term for Utility and Plant Patent is 20 years; where as for Design Patent is 15 years. [35 USC s. 154 A]. USC also contains provisions for patent term extension which is absent in India and EU.
- Utility Patent and Plant Patents are eligible for Patent Term Adjustment.

The three grounds for extension are:

1. Failure of USPTO to take certain actions within the time specified under the Act.
2. Failure of USPTO to issue patent within 3 years from the date of filing of the application.
3. Compensation for delays due to interference proceedings or secrecy orders or successful appellate reviews.

10. Language

US and Indian Patent Office works only with English Language.

Whereas the European Patent Office’s (EPO) official languages include German, English and French. An applicant is allowed to file a patent application in any of the three official languages and file it with the EPO.

Video

With this we come to the end of this session. In the next session , “Identification of inventor and applicant and their rights”, we will learn about the who is the owner of patent and rights of both inventor and applicant See you in the next session

thank you!

