

# ROADMAP FOR PATENT CREATION

## INTERACTION WITH IP ATTORNEY-INITIAL DRAFTING, FER REPLY, AND HEARING

### LECTURE 35

A very warm welcome in the fifth module of week 7 of the Course, roadmap for patent creation, titled "Interaction with IP attorney-Initial drafting, FER reply, and hearing" The most important step is selecting a competent patent attorney In first live interactive session, that is on March 1, 2019 there were two queries referring to this topic the first query was how to identify a trustworthy patent attorney and the second query was what is the difference between patent agent and patent attorney...So here briefly I will clarify these both doubts Patent agent or patent attorney ..now onwards in this module I will use the word patent expert.

So patent expert he /she is the one who will determine whether your invention is patentable; he/she will help you to obtain appropriate patent protection for your invention; and, he/she will help you to create path for commercialization which may be in any mode as licensing, entrepreneurship, collaboration... For patentability we have dedicated modules in week 2 For patent filing and process we have dedicated modules in week 5 and week 6 we have dedicated module on commercialization in week 8.So you have good idea about the subject..your patent filing process is starting with generation then protection and then commercialization After getting this basic idea about patent expert and patent cycle...

The first question is where one can get the information about the patent expert Whether any resources available? Yes there are resources.... So let us check this Generally , the starting point will be your friends who are working in IP area or law area Then you will try to get the information from your friends who have filed patent Then very common source will be Internet browsing So These are the general starting point for obtaining information about patent experts...Then bar associations can provide information. However the good resource will be the Indian Patent Office On the website of Indian patent office any one can visit and get the details about the registered patent agents Now patent office have one more additional service as patent facilitators...this information also you can get from the patent office site Thus you will get the details about patent experts Now you have received information about patent experts then next how to choose who is best for the particular project...This is because patent process is domain specific...no single person can file patent in all the subject areas...With practice patent expert can file patent in varied domain still there will be a few areas which he/she will not be comfortable...

So when you will interact with patent expert he /she will clearly mention that he /she can work in these areas of technology Because pharma chemistry require expertise in chemical structures and related knowledge Computer engineering related patents will require different expertise Microbiology and biotechnology will require again a different expertise

So we can say broadly life sciences, chemical sciences...computer science and so on Many times because of many years practice and experience, patent expert can work in areas other than his/her specialisation...But that must be judged properly... So in short your subject of invention and expertise should match...that is first important factor while considering patent expert service...Now next Educational background of patent expert...It is important to know the technical and scientific educational background, as well as legal education and patent experience, of a patent expert, both in terms of years of experience and the nature of that experience. IP is interdisciplinary subject we say that it will be good if patent expert have ..law and... technical and management background.... Patent agent examination science and engineering background

- ➔ patent drafting and prosecution part.....
- ➔ Searching
- ➔ Litigation
- ➔ Patent commercialization

Thus your Project under consideration will define the need Next important point is sequence of events for filing the patent application.For example, is the attorney recommending a patentability search followed by, based upon the results, the preparation and filing of a patent application? Search report is very important....Patent drafting...defining the scope...the capability to seek corresponding international protection? established relationships with competent non-Indian patent experts quality representation for a reasonable fee? Commercialization-license agreements? So you will check the subject expertise as per the project under consideration Then educational background Then sequence of events and possible expertise available Then next important thing is financial matter Fees

- attorney's fees
- hourly rate for attorney's fees, V/S
- fixed-fee arrangements
- disbursements Time

It is also desirable to ask for estimates of time periods involved in various stages of the work, and also better to understand when input or assistance from inventor is required, and the nature of such assistance. Then next it is better to understand associate network...this is especially required if inventor is planning for foreign filing So it should be better to know

-Associates - portions of the job, with or without supervision, at a lesser rate, thereby saving the potential client money? So after getting this much idea about how to identify right patent expert ...again a few things that matter are likethe comfort level of the inventor with the particular patent expertand the extent to which the inventor is able to assist and desires to

participate actively so both parties must be involved actively in the process after getting this much information Now let us check a few important points related to filing the application in legal point of view... the first important factor is Decision of Inventorship and assignee are the important factors. a few questions can be clarified in the discussion :

- Who is or are the inventors, i.e. who has participated in the invention?
- Availability of inventor in various stages for clarification of doubts related to technology. Identity of the Applicant Three types A natural person or a group of natural persons may be designated as the applicant(s). Alternatively, a legal person may be designated as the applicant. For example, the applicant may be a limited liability company (LLC) or a corporation. Policy of the organization generally defines inventorship and assignee
- documents which may prove the eligibility of the applicant then legal formalities like form 26..can be prepared to confirm the engagement). Also Please share full name and place of residence of every inventor. Additionally, share the phone numbers or email addresses of the inventors. This will be required later for filing the forms but more than that it will be required by patent expert .if any doubts about the invention or if some clarifications are required Patent expert can interact with inventor Then next important part is

3. Features of the Invention The technical features and experimental data provided will be crucial information for the patent expert for drafting a high quality patent application.

- Which are the technical features the inventors consider to be essential vis-à-vis the known state of the art?
- Is the invention predominantly an product (or device) or an process (or use)?
- Which advantages or effects are achieved by the invention?
- which disadvantages of the prior art have been overcome
- Has the invention been implemented? Is a working prototype available? what is the status of the development of a prototype?
- Are further experiments being carried out or has the development of the inventive product been finished?
- Has the invention been submitted by the inventor as a manuscript for publication
- Has the invention been disclosed in the context of lectures or presentations?.
- Has the invention been publicly disclosed or did any third party have access to the invention or the prototype?
- Are there any prior patent applications, designating the same inventors as the inventors of the present invention?

- publicly available prior art documents known before realizing the invention..
- Does the invention have any connections to existing products or processes of the applicant?
- If so, what modifications have led to the successful realization of the invention?
- What alternative sources of information of the applicant are available (websites, presentations)?
- Has the invention been stimulated by publications of third parties?
- Which publications have been considered before completing the invention?
- Search report
- Have the most relevant prior art documents been identified by a novelty search? A first overview of the most important documents can be obtained using search tools of various patent offices. Which databases have been used, by whom and to which extent? Which search strategy was applied?
- Should a supplementary research be carried out by the patent attorney before the patent application is drafted? A supplementary search will often be useful when the invention is in a technical field, which the applicant has just entered and wherein the prior art is not yet fully known to the applicant or the inventors.

7. Commercialization and Market Analysis Generally, a patent or utility model application will secure a monopoly to the applicant, which should cover the specific product or process to be marketed. The claims of the patent application should be drafted in a way to make sure that the protection of the specific product or process is maximized. Typically, patent application will only be filed in countries wherein the the product or process will be marketed.

- What are the characteristics of the final product or process to be marketed? In which countries will the product or process be offered for sale? Which customers will be addressed?
- Will the invention be marketed by the applicant or will a patent be licensed out by the applicant?
- Who are the main competitors in the market? What are the competitors' products? Is there a high likeliness that any competitors will copy the protected product / the protected process?

Ultimately, the decision as to which features are to be protected and in which countries protection is sought will depend on the economic needs of the applicant. However, a patent attorney may provide in the inventor interview information on the expected costs in the process of obtaining the patent as well as advice on the general enforceability of claims in the

respective countries. This information should be taken into account in the process of decision making.

8. Special Case: Inventions in Biotechnology If the invention resides in the fields of biotechnology, for example relates to genetic engineering, microbiology, protein or enzyme technology, the following further questions should be addressed in the inventor interview.

- Did the inventors use constructs or organisms which are not publicly accessible in the invention? If so, have the constructs or organisms been deposited in a microorganism bank or will the constructs or organisms be deposited in future?
- Does the invention include new gene sequences? Has a BLAST analysis been carried out? Are the gene sequences available in electronic form? Note the genebank database accession numbers.
- Which gene sequences are state of the art or may be found in nature?
- What are the most relevant domains of the gene or of the polypeptide sequence? For instance, the regions encoding the antigen binding site of an antibody encoding gene sequence or the regulatory regions of a DNA sequence may be relevant.

9. Special Case: Inventions in Chemistry If the invention resides in the fields of chemistry, for example relates to a chemical substance, a medical agent or a chemical process, the following further questions should be addressed in the inventor interview.

- Is the method of synthesis of the compounds generally known?
- Can the formulas of the inventive compounds be reduced to a lead structure or a chemical substance class, with all or a significant number of its members providing the technical effects of the invention? Which are the substituents or residues usable with the lead structure or chemical substance class?
- Which substances have been synthesized in particular by the inventors?

### **Types of Specifications**

- 1) Provisional specification; and
- 2) Complete specification.

### **Contents of a Specification**

A specification should be drafted and submitted in Form 2 to the Indian Patent Office. As mentioned in the previous section, a provisional specification as opposed to the complete specification will not have a claim section. The sections are as follows

- 1) Title;
- 2) Preamble of the invention;
  
- 3) Technical field;
- 4) Background;
- 5) Objects;
- 6) Brief description of the drawings;
- 7) Detailed description;
- 8) Claims (for complete specification); and
- 9) Abstract.

**Title:**

The complete specification should begin with the title of the invention. The title should fairly capture specific features of the invention. It should not be more than fifteen (15) words. Further, Inventor's name, the word "patent", words in other languages, the abbreviation "etc" and fancy words may not be used in the title. The title should embrace all variants (apparatus) of the invention. For example, a title may be "A system and a method for \_\_\_\_", "An apparatus and a method for\_\_\_\_" and so on. e.g. Brush Vs. Cleaning Article ; Pen Vs. Writing Instrument

**Preamble of the invention**

The preamble for a provisional specification should state "The following specification describes the invention". Further, the preamble of a complete specification should state "The following specification particularly describes the invention and the manner in which it is to be performed." The preamble along with the title of the invention, name, address and nationality of the applicant(s) should appear in the first page of Form 2.

**Technical Field**

The "Technical field" section in the specification will mention as to what field the invention belongs to and particularly states as to the subject matter of the invention. For example, the Technical Field may state "The invention generally relates to dispensing machines and more particularly to a machine which dispenses coffee".

**Background**

The objective of this section is to distinguish the invention at hand from that of what is already being practiced in the industry. The aforementioned objective will be achieved by

briefly discussing the teachings of the prior art and drawbacks or disadvantages, if any, of such teachings. This section sets the stage for describing, at a later stage, the invention at hand clearly and in more detail.

For example, if the invention relates to a coffee dispensing machine in which a crusher is included, as a novel and inventive concept, to grind the coffee seeds, the disadvantages or drawbacks of existing coffee dispensing machine (assuming that the concept of grinding the coffee seeds in the dispensing machine itself is not present in the existing coffee dispensing machine) may be briefly discussed.

### **Objects**

The objective of this section is to bring about the necessity of the invention.

This section is aimed at bringing about the objectives, advantages or solutions achieved by employing the invention at hand. It may include statements such as “The principle object of an embodiment of this invention is.....; Another object of the embodiment of this invention is.....; yet another object of the embodiment if this invention is... and so on.

### **Brief description of the drawings**

This section will refer to all the figures in “Drawing” part of the specification. In this section, a brief discussion is presented as to the embodiments depicted by each of the figures. For example, it may be stated that “Figure 1 is a perspective view of a coffee dispensing machine having a crusher according to an embodiment of the invention; and Figure 2 depicts crusher of figure 1 connected to a collecting chamber and so on.

### **Detailed description of the invention**

The objective of this section is to provide sufficient details of the invention. The making and using of the invention and the objectives, advantages or solutions achieved by employing the invention (as discussed in “Objects of the invention ”section of the specification) should be explained in depth. Further, the details of the invention should be explained with respect to the drawings. The details provided in this section are considered sufficient if a person having ordinary skill in the art is able to practice the invention without undue experimentation. This section may also include examples to facilitate better understanding of the invention. Further, this section should provide or disclose the best method of performing the invention, which is known to the applicant.

### **Claims**

Claims are the sum and substance of the patent specification. The patent rights are granted to the claimed subject matter. The subject matter which is in the description but not claimed will

be considered disclaimed and hence is donated to the public. Each claim is a separate invention and hence all the claims are not held invalid for one claim being invalid.

A claim is a sentence and hence should start with a capital letter and end with a full stop. The claims section of the specification should start on a separate page after the “Detailed

description of the invention” section. The preamble to claims section should be, “I claim”, “We Claim” or “What is claimed is” and should follow with the claim listings. Almost always, the first independent claim is drafted broadly to cover the important aspects of the invention. Further details of the invention may be covered in dependent claims which will have narrow coverage. Different set of claims may be drafted to vary the scope of protection sought.

A claim has to be structured in three parts viz, Introductory phrase, body and a link that joins the introductory phrase and the body. First Examination Report Hearings The Indian Patent Office typically offers a hearing to the applicant after the response to the FER has been filed, to address any pending objections. It is therefore advisable to file the response to the FER at the earliest so as to leave sufficient time for such a hearing. Once all objections have been addressed, the application is placed in order for grant. *Section 80. Exercise of discretionary powers by Controller.—*

*The Controller shall give to any applicant for a patent, or for amendment of a specification (if within the prescribed time the applicant so requires) an opportunity to be heard before exercising adversely to the applicant any discretion vested in the Controller by or under this Act.*

**Provided that the party desiring a hearing makes the request for such hearing to the Controller at least ten days in advance of the expiry of the time-limit specified in respect of the proceeding.**

Written Submission-Hearings Granted Video With this we come to the end of this session. See you in the next session.

thank you!

