

ROADMAP FOR PATENT CREATION

POST PATENT FILING MANDATORY REQUIREMENTS-STATUTORY AND GENERAL

LECTURE 37

A very warm welcome in the second module of week 8 of the Course, roadmap for patent creation, titled "Post patent filing mandatory requirements-statutory and general" There are two important mandatory requirements Let us check which are these requirements The first one is

Statement and Undertaking Under Section 8 Form 3 Let us check Form 3.....This is the declaration which ..so it is declaration as I/We hereby declare that I/We have not made any application for the same/substantially the same invention outside India Or
(ii) that I/We who have made this application Number.....datedalone/jointly with, made for the same/ substantially same invention, application(s) for patent in the other countries, the particulars of which are given below:

- (i) Name of the country
- (ii) Date of application
- (iii) Application No.
- (iv) Status of the application
- (v) Date of publication
- (vi) Date of grant

so here

Section 8(1)(b)4 read with Rule 12(2) of the Patents Rules5 ..it says that the applicant(s) is expected to furnish information of 'every other application,' if any, filed elsewhere subsequent to the filing within six months of filing such new application. So this is mandatory to inform patent office about any new filing So this is first mandatory requirement..now let us check second mandatory requirement....this is about working of patent so it is

Statement Regarding the Working of the Patented Invention on Commercial Scale in India Section 146 Form 27

What information you are providing...

1. Whether the patented invention has been worked or not worked?
 - if not worked, the reasons for not working and the steps being taken for the working of the invention.
 - if worked, the quantum and value (in rupees) of the patented product?
 1. Manufactured in India;
 2. Imported from other countries along with the details of each country;
2. The licenses and sub-licenses granted during the year;
3. Whether the public requirement has been met, at a reasonable price either partly, adequately or to the fullest extent?

Let us check one interesting case related to it....By referring to Form 27, The Patent Office found that Bayer did not import the drug at all in 2008 and only started importing it in small quantities in 2009 and 2010. Seeing that Bayer was not making the drug accessible to more people, Natco applied for a compulsory license under Section 84 of the Patents Act, 1970 which was then granted by the controller and upheld later by the Bombay High Court So these are the two mandatory requirements..Before checking general information ...a few important things I wish to put forward form 5 inventor addition Form 6 applicant change Form 13 amendment of patent Now the general requirements Probably everyone follow these general requirements however...sometimes due to unawarenss about the procedures applicant may miss completion of certain procedures So which are these

Request for examination

PCT/conventional

FER reply

Hearing

opposition

Commercialization

Let us watch one interesting video here...Video With this we come to the end of this session on most important topic, patent commercialization See you in the next session

thank you!

