



Ministry of Commerce and Industry
Department for Promotion of Industry and Internal Trade
Office of the Controller General of Patents, Designs & Trade Marks (O/o CGPDTM)

BOUDDHIK AAGMAN

An Induction Journey at IP Office

Demystifying Legal Terminologies

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Essential Legal Terminology for Patent Office Officials

Why to Learn?

- **Techno-Legal Expertise:** The role of an examiner combines technical knowledge with legal understanding to evaluate patent applications effectively.
- **Transition in Focus:** Examiners move beyond technical analysis to apply legal principles, ensuring compliance with patent laws and regulations.



Understanding Patent Law - Legal terminologies are essential for interpreting provisions of the Patents Act, 1970.

Accurate Examination- Helps ensure compliance with legal standards of patentability (novelty, inventive step, industrial applicability).

Drafting Reports - Enables precise drafting of examination reports, objections, and decisions.

Avoiding Ambiguities- Clear understanding reduces the risk of misinterpretation of legal provisions.

International Collaboration-Facilitates communication in global patent systems like WIPO and PCT.

Efficient Dispute- Handling Aids in resolving challenges during the patent grant process.

Ensuring Fairness-Helps apply laws uniformly, ensuring transparency and fairness in patent examination.



- The **Act** and **Rules** are foundational elements of the **legal framework for establishing, regulating and enforcing laws** in any domain, including those pertaining to intellectual property.

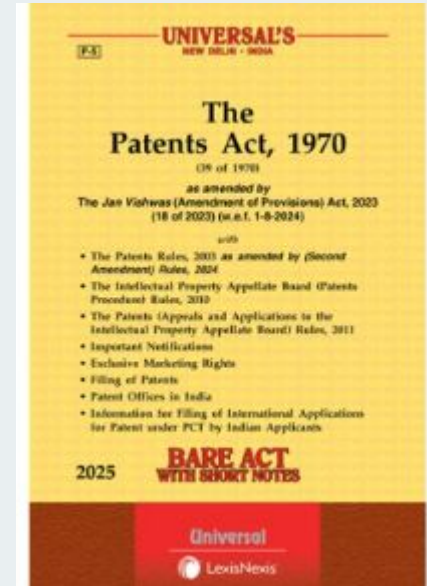
- **ACT:**

Primary Legal Foundation: The Act defines the fundamental principles, rights, and responsibilities related to patents and designs in India, serving as the cornerstone of the legal framework.

Legislative Origin: Drafted by the relevant ministry with legal experts, the Act is introduced as a Bill in Parliament, debated, and approved by both houses and the President.

Strict Compliance: The Act's provisions must be strictly followed without deviation, ensuring uniform application of patent and design laws.

Constitutional Alignment: Every Act must comply with the Constitution of India, maintaining consistency with the nation's supreme legal authority.



Example Section 6-

Section 6. Persons entitled to apply for patents

(1) Subject to the provisions contained in section 134, an application for a patent for an invention may be made by any of the following persons, that is to say,—

(a) by any person claiming to be the true and first inventor of the invention;

(b) by any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application;

(c) by the legal representative of any deceased person who immediately before his death was entitled to make such an application.

(2) An application under sub-section (1) may be made by any of the persons referred to therein either alone or jointly with any other person.

The Patents Act contains 163 ‘Sections’ and these Sections are grouped under 23 Chapters.



Rules-

Procedural Framework: Rules provide the detailed procedures for implementing the provisions of the Act in practice.

Consistency with the Act: Rules must align with the parent Act and are considered subordinate legislation to facilitate its effective implementation.

Role of the Central Government: The Central Government drafts, finalizes, and enforces the Rules to ensure they adhere to the legislative intent of the Act.

Public Consultation: Draft Rules are published in the Official Gazette for stakeholder feedback, which is considered before finalization.

Legally Enforceable: Once finalized and approved, the Rules are notified in the Official Gazette, giving them legal enforceability.



THE PATENTS RULES, 2003



For example -

Rule 10. Period within which proof of the right under section 7(2) to make the application shall be furnished

Where, in an application for a patent made by virtue of an assignment of the right to apply for the patent for the invention, if the proof of the right to make the application is not furnished with the application, the applicant shall within a period of six months after the filing of such application furnish such proof.

Explanation.--For the purposes of this rule, the six months period in case of an application corresponding to an international application in which India is designated shall be reckoned from the actual date on which the corresponding application is filed in India.

Section 7(2) - Where the application is made by virtue of an assignment of the right to apply for a patent for the invention, there shall be furnished with the application, or **within such period as may be prescribed** after the filing of the application, proof of the right to make the application.

The Patents Rules contain 139 Rules grouped under 16 chapters.



Treaty and Convention

- Treaty and Convention are terms commonly used in **international law to describe formal agreements between nations.**
 - **A treaty is a formal, legally binding agreement** between two or more sovereign states (countries) or international organizations. It can be bilateral (between two countries) or multilateral (involving multiple countries). Treaties are legally enforceable under international law.
 - **A convention** is a type of **multilateral treaty** that is often initiated by an international organization to address a specific issue of global concern. Conventions tend to set an international standard and guidelines. Once ratified, conventions become binding on the participating countries.
- Examples - **Paris Convention and Patent Cooperation Treaty (PCT).**



Manual

- **A manual** is a detailed guide providing **instructions, guidelines, and information** about specific processes, systems, or regulations.
- In IP law, manuals are created by authorities to help stakeholders **understand and comply with laws**, rules, and procedures.
- Manuals aim to clarify specific subjects, offering **step-by-step instructions** to codify procedures and streamline operations.
- They provide guidance for **IP prosecution, benefiting stakeholders** like applicants, examiners, and legal practitioners.
- Examples of IP manuals include the **Manual of Patent Office Practice** and Procedure, Manual of Designs Practice and Procedure, and Manual of Geographical Indications Practice and Procedure.



MANUAL OF
PATENT LAW



Guidelines

- Guidelines **clarify legal and procedural requirements**, minimizing discrepancies in legal implementation.
- They ensure procedural consistency, **efficiency, uniformity**, and transparency in legal processes.
- Guidelines promote uniformity, transparency, and consistency, reducing errors and disputes.
- They **simplify complex procedures** by providing step-by-step instructions for stakeholders.
- By aligning the understanding of authorities and stakeholders, guidelines reduce errors in compiling legal requirements.
- Proper implementation of guidelines helps minimize disputes and litigation, fostering smoother processes.



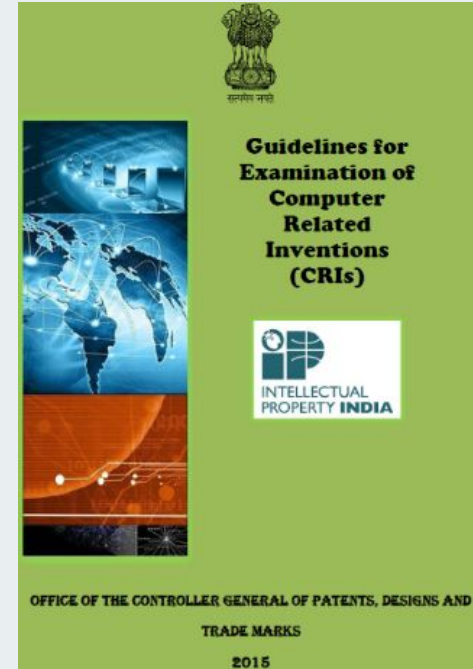
Guidelines

Guidelines are periodically updated to incorporate changes in law, technological advancements, global best practices, and judicial interpretations.

Regular updates to guidelines ensure they remain relevant, efficient, and effective, fostering clarity, improving stakeholders' ease, and adapting to evolving contexts

Examples - Guidelines for Computer Related Invention(CRI), Traditional Knowledge and Biological Material etc.

IN CS & ECE field, CRI are Important- Provide clear criteria for patenting software, algorithms, and computer-implemented inventions, ensuring that such inventions are assessed consistently and fairly.



Legal terms frequently used in Patent Prosecution

What is an Examiner of Patents & Designs?

Examiner of Patents & Designs - An Examiner of Patents is a professional employed by the Government in a patent office whose primary role is to **evaluate** patent **applications** to determine whether they meet the legal requirements for patentability.

Patent- A patent is a type of intellectual property that gives its owner the legal right to exclude others from making, using, or selling an invention for a limited time period. It is a legal and enforceable right extended by the law of the country.

Application - Application means application for grant of patent for an invention (describes in complete specification in a proper format having claims) filed at Indian Patent office.

Abstract- The section of a patent that provides a brief summary of the invention described in a patent.

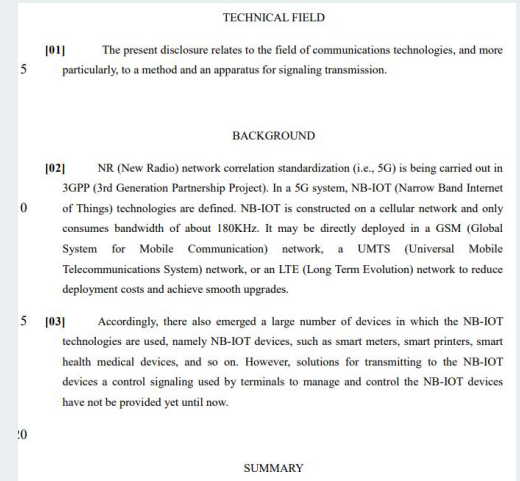


Complete Specification- A document that fully describes an invention, including its technical and scientific details. It provides a comprehensive description of the **invention** and the manner in which it can be performed, enabling a person skilled in the relevant field to replicate the invention.

Claims - Part of patent application which defines the matter for which protection is sought. It is a statement in a patent application that defines the scope of the invention's protection. Claim defines the metes and bounds of the protection of a particular invention.

Examination - It is an act of questioning or inspecting something. It is the process by which a patent Examiner reviews a patent application for compliance with the requirements laid down in the patent laws of that country.

Invention - An invention is a new product or process that solves a technical or functional problem. It should be 'new', involve an 'inventive step' and 'capable of industrial application'.



Prior Art - Prior art is information that's publicly available before a patent application is filed. Existing knowledge, publications, or inventions relevant to determining the patentability criteria of a patent application.

Anticipation - Anticipation in patent law refers to when an invention has been disclosed or used before the patent application is filed, making it ineligible for a patent. This means the knowledge is already in the public domain before the filing of the application.

Search- It refers to the process of reviewing and analyzing patent databases/papers to identify existing patents or published patent applications/papers relevant to a particular invention, technology, or innovation.

Novelty - Something new or unusual. It is a requirement for patentability; the invention must be new and not disclosed in prior art.

Inventive step - Inventive step means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art.



Industrial Applicability - Industrial applicability is a requirement for patenting an invention, meaning that the invention can be used or made in any industry.

Controller of Patents - In charge of overseeing the administration and management of patents, generating reports, refusing or granting of patents.

First Examination Report (FER) - First Examination Report (FER) is a document issued by the patent office which contains the summary of objections resulting from the initial examination of patent application by the Patent Office.

Hearing Notice - A **hearing notice** having objection is an official communication issued by a patent office or intellectual property office to inform a party (such as a patent applicant, patent holder, or opposing party) about a scheduled hearing.

Grant - The grant of a patent refers to the official issuance of a patent by the patent office, providing legal protection and **exclusive rights to the inventor**, after following the due process of examination and opposition (if any).

Refusal - An act of refusing or denying the grant of a patent by the Controller.

Abandonment - The meaning of Abandonment refers to the intentional or unintentional act of neglecting, dropping, discarding or eliminating. When a reply of the applicant to an office action is not done within the specified time limits, the application may be considered (depending on the jurisdiction), as abandoned or deemed abandoned.



Priority (date) - A "priority date" refers to the earliest filing date of a patent application for a specific invention.

Person skilled in the art (PSITA)- A person skilled in the art (PSITA) is a hypothetical person with required technical knowledge and skill in a given field. The inventive step of an invention is adjudged considering the knowledge of the PSITA as a yardstick.

Patent Agent - A patent agent is a licensed professional who helps inventors and companies with patent applications.

Sufficiency of Disclosure -Sufficiency of disclosure or enablement is a patent law requirement that a patent application disclose a claimed invention in sufficient detail so that the person skilled in the art could carry out that claimed invention.

Subsequent Examination Report- A further examination report issued by IPO after the FER. The provision of SER is time dependent. Beyond a prescribed time period, hearing notice is issued.

Appropriate Office - Any office of the department in which functions are carried out related to the particular task. The appropriate office for a patent application in India depends on the applicant's residency, domicile, or place of business, or the location of the invention's origin



Amendment: Amendment means alteration, modification, or correction. The modification of a portion of an application, specification, claims or abstract etc. The nature and type of amendments allowed are defined in the Patents Act.

Convention application: Convention patent applications filed in India are applications which take priority from an earlier patent application filed in a convention country.

Declaration: A declaration is a written statement assertion, or announcement made by an individual or entity often under oath or penalty of perjury

Disclaimer: Generally, Disclaimer is a statement denying responsibility. In patent application, through disclaimer, the owner relinquishes certain legal rights to the patent.

Disclosure: Description of the invention in a patent application or a patent. Disclosure is often used interchangeably with Specification in referring to a patent or patent application.

Divisional Application: A further patent application filed after an original patent application because the initial application is related to more than one distinct invention. The divisional application may be filed in order to meet an objection of the Patent Office on 'unity of invention' or suo-moto by the applicant.



International patent application- International patent application is a request to file an application of an invention in multiple countries at a same time. A patent application filed under the Patent Cooperation Treaty (PCT), enabling applicants to seek protection in multiple countries. There is no concept of 'international patent' or 'global patent'. An international application only facilitates the filing procedures in multiple countries and reduce burden on the applicant.

Convention application- Conventional patent applications filed in India are application which takes priority from an earlier patent application filed in a convention country.

Patent Cooperation Treaty (PCT) - The Patent Cooperation Treaty (PCT) is an international treaty that allows inventors to seek patent protection for their inventions in multiple countries by filing a single application.

Trade Related Intellectual Property Rights (TRIPS)- It is an agreement of World Trade organization (WTO). It came into effect on 1 January 1995, is to date the most comprehensive multilateral agreement on intellectual property. It is an international legal framework established to set minimum standards for the protection and enforcement of intellectual property (IP) rights among member countries of the World Trade Organization (WTO). The objective of TRIPS was to harmonize IP laws globally to facilitate trade and reduce distortions caused by varying national IP systems.

WIPO-WIPO stands for World Intellectual Property Organization, which is a United Nations agency that administers international intellectual property.

International Search Report (ISR)- After filing an international application, the international searching authority publishes ISR. It is a key document that identifies certain prior arts which may be prejudicial to the novelty and/or inventive step of the given invention. The ISR helps the applicant and patent offices assess the patentability of the invention. The opinion of the ISA in ISR are non-binding.



Designs -

Design means the **shape, configuration, pattern or colours** applied to a product for aesthetic appearance. It is a form of intellectual property defined as 'Design' means **only the features of shape**, configuration, pattern or ornament or composition of lines or colour or combination thereof applied to any article whether two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye, but does not include any mode or principle or construction or anything which is in substance a mere mechanical device, and **does not include any trade mark**, as define in clause (v) of sub-section of Section 2 of the Trade and Merchandise Marks Act, 1958, property mark or artistic works as defined under Section 2(c) of the Copyright Act, 1957.



Further Some Terms Frequently Used-

Natural Justice: Natural justice is legal philosophy that ensures fairness, equity, transparency and justice that guide judicial and administrative decision-making processes. It encompasses a set of principles aimed at preventing arbitrary or biased decisions and ensuring that individuals are treated justly.

NBA: National Biodiversity Authority. Registration/permission from NBA is required if biological material used in an invention in a patent application is from India.

Notarized: Notarized means a notary public certifies the authenticity of a document. This adds a layer of protection against fraud.

Opposition: A formal challenge to a patent application or granted patent, often filed by a third party.

Pre-grant opposition: A pre-grant opposition is filed before the grant of a patent by any person.

Post-grant opposition: A post-grant opposition is filed after the grant of a patent (within a specified time) by any person interested.

Petition: A petition is a formal written request or application submitted to a court, government, or other authority, seeking a specific legal remedy, action, or decision. It typically outlines the issue, the relief sought, and supporting facts or evidence.

Prima facie: In legal terms, "prima facie" is a Latin phrase meaning "at first glance" or "on its face".



Quiz

What does the term 'novelty' signify in patent law?

- Industrial applicability
- Newness of the invention
- Legal compliance
- Public disclosure

Newness of the invention



Quiz

What is the significance of the First Examination Report (FER)?

- It grants a patent
- It summarizes objections raised by the examiner
- It refuses a patent

It summarizes objections raised by the examiner



Quiz

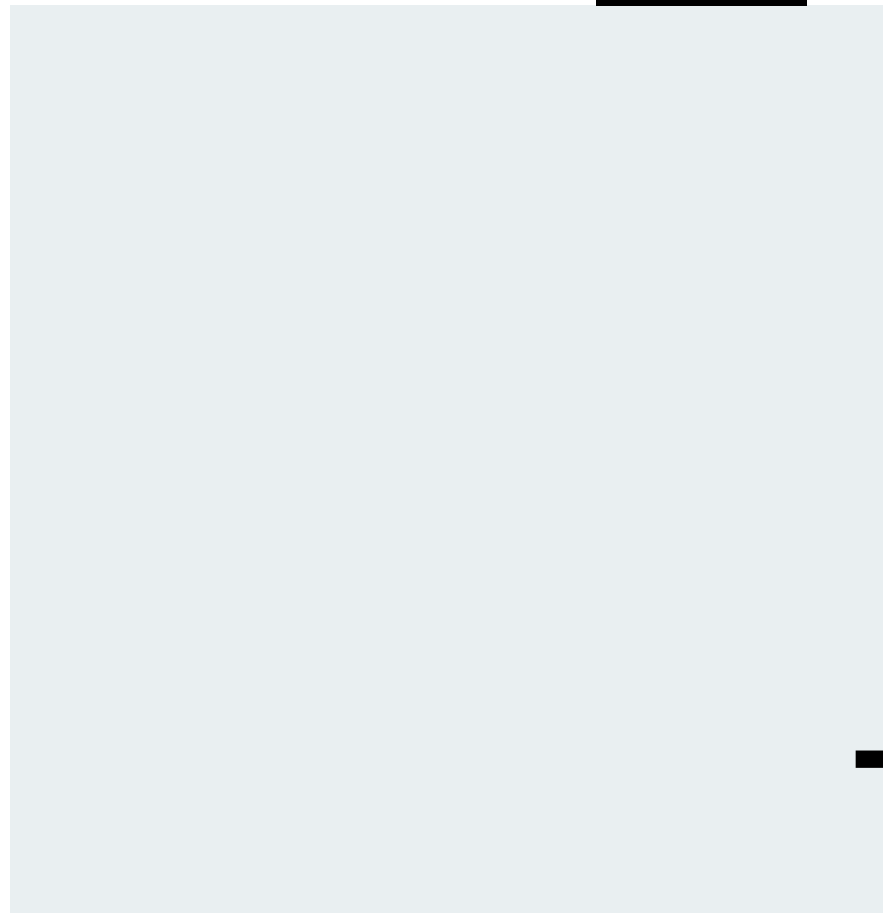
Which treaty allows for a single patent application across multiple countries?

- Paris Convention
- Budapest Treaty
- Patent Cooperation Treaty (PCT)
- TRIPS

Patent Cooperation Treaty (PCT).



Q&A.



Full list of Legal terms-

PDF should be Opened discloses all the terms.

Case law example - **Ferid Allani v. Union of India & Ors. (Delhi High Court, 2019)**

<https://thelegalquorum.com/ferid-allani-v-union-of-india-ors-delhi-high-court-2019/#:~:text=To%20sum%20up%2C%20the%20case,while%20also%20preserving%20essential%20protections.>

