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**PATENT AMENDMENT ORDINANCE**

- The Patents (Amendments) Act, 2005
- Definitions
- Scope
- Patentability criterion
- Inventions not patentable
- PCT Applications
  - Intn'l & National
- Publication
- Request for Examination
- Opposition
- Appeals
- Patent (Amendment) Rules, 2005
- New Time lines
- No extensions
- Heavy penalties
- Inflated fees
- No discretion with Controller
- All burden on applicants
- Enforcements

**New Law  
SALIENT POINTS**

- No more mailbox applications
- Pharmaceuticals, chemicals & food *per se* patentable
- List of Unpatentable inventions enlarged
- Rights in patents from the date of publication
- Pre-grant representations
- Post grant Opposition introduced
- Divisionals may be filed up to grant of patents on parent application
- Less time for filing request for Examination

**Patentability criterion**

- Nearly TRIPS compliant
- “Invention” means NEW product or process having inventive step and capable of industrial application.
- “Manufacture of tangible product” no longer a criterion
- Should fall outside Sections 3 & 4

**Definition of Invention**

- “New Invention” means any invention or technology that has not been anticipated...*i.e.*, the subject matter has not fallen in public domain or that it does not form part of the state of art
- The new law confuses between “*prior art*” and “*state of art*”

**Definition of Invention**

- “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.
- What exactly is “economic significance”

### Inventions NOT Patentable (Ss. 3 & 4)

- Frivolous or contrary to natural laws (perpetual motion machine, making crazy sounds)
- Contrary to public order or morality (Sex apparatus)
- Mere discovery of scientific principle or theory (E = MC<sup>2</sup>; {[a+b]<sup>2</sup> = a<sup>2</sup> + 2ab + b<sup>2</sup>})
- Mere discovery of new property
- Mere new use for a known substance

### Inventions NOT Patentable (Ss. 3 & 4)

- Mere admixture (H<sup>2</sup> + O<sup>2</sup>) as opposed to synergistic compositions (Gun powder)
- Mere arrangement or rearrangement of known devices
- Method of agriculture or horticulture
- Process for the medicinal, surgical, curative, prophylactic, diagnostic or therapeutic treatment of humans and animals)

### Inventions NOT Patentable (Ss. 3 & 4)

- Plants or animals in whole or any part thereof
- Seeds, plant varieties, essentially biological processes for production or propagation of plants or animals
- Computer programme per se other than its technical application to industry or a combination with hardware
- Mathematical or business method
- Literary, dramatic work etc.

### Inventions NOT Patentable (Ss. 3 & 4)

- Mere scheme, rule, performing mental act or method of playing game
- A presentation of information
- Topography of integrated circuits
- Traditional knowledge
- Atomic energy related

### Drugs, Chemicals and food products

- Unpatentable till 31-12-2004
- Patentable w.e.f 01.01.2005
- Saving clause for drugs and medicines
- *What happens to applications for chemicals which are not drugs, filed prior to 01.01.05 but examined after 01.01.2005?*

### Pharmaceutical products

- **Effective 1 January 1995, mailbox applications for pharmaceutical products.**
- **Mailbox applications enabled the applicant to secure earliest priority date.**
- **Not to be examined before 1 January 2005**
- **In the interim period pipeline protection available**

### Interim Pipeline Protection

- Subject to satisfaction of certain conditions...Exclusive marketing rights (EMR).
- Exclusivity is **ONLY** for marketing & not for manufacture
- Valid for Five years or grant or refusal of a patent whichever happens earlier.
- Few EMRs have been granted..all of them before the court.

### EMRs

- **United Phosphorous..several interim injunctions in force**
- **Novartis...Divergent views..should the prior user be protected.**
- **Who is a prior user? What happens to the patentees priority date?**
- **Public health vs patentees rights.**

### Protecting common man

- Pricing control mechanism
- Pre and post grant oppositions
- Revocation of patents
- Compulsory licenses.

### Effect on common man

- No effect on existing drugs
- New drugs may be a bit expensive
- But encourage Indian companies to innovate and thereby contributes to industrial growth.

### Courts Involved

- **Appellate Tribunal**
- **District Courts**
- **High Court**
- **Supreme Court**

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### Courts Involved

- **Appellate Tribunal**
- **.....TM Appeals from the Registrar's Orders**
- **.....Patent Appeals from the Controller's Orders (yet to be established)**

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## Courts

- **District Courts....Lowest Court having jurisdiction to try suits for infringement**
- **No jurisdiction for trying revocation proceedings**

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## Courts

- **High Courts....Original and Appellate**
- **All High Courts do not have Original jurisdiction. (*Sometimes leads to Forum Shopping*)**
- **Absence of specialised Courts could lead to *forum shopping*.**

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## IP Courts

- **No specialized IP Courts**
- **Most Courts have high degree of experience and expertise in dealing with Trade Mark and copyright matters.**
- **Some of world class rulings are from India**
- **Not many litigation in Patents**

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## Advantages of IP Courts

- **Specialized judges having expertise in law and science.**
- **With each case the experience will grow**
- **IP cases, where time is critical, will not be allowed to be prolonged.**
- **At present IP cases are won or lost in interim stage.**

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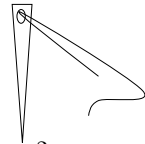
## Disadvantages

- **Same judges in all cases.**
- **Chances of evolution of law reduced.**

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## Claim: Definition is crucial

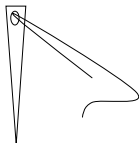
- **A sewing instrument comprising of a hard element having a proximal end, which is blunt, a distal end which is sharp and **an eye close to the proximal end****



.....How about sewing machines?

**Claim: Definition is crucial**

- A sewing instrument comprising of a hard element having a proximal end, which is blunt, a distal end which is sharp and **an eye on**



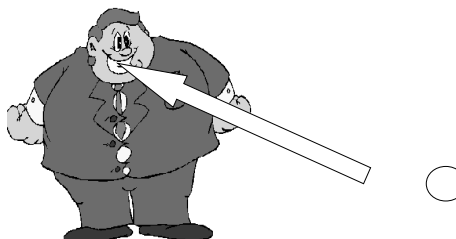
**Terfenidine case**

- Merrel Dow:
- Original Patent for terfenadine - **a wonder drug** ....*due to expire.*

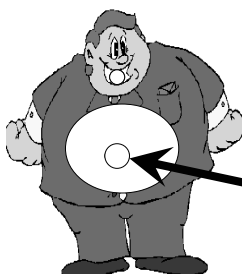
**PERPETUATION**

- The competitors are waiting for the terfenidine patent to expire
- ***In the meantime.....***

**Terfenadine**



**Terfenadine**



**ACID METABOLITE**

**Terfenadine**

- .....and obtain for a patent for the **acid metabolite**
- ... and sue competitors selling terfenidine on the ground that when patientseat the medicine, it is converted into a metabolite in their stomach, thereby infringing the second patent.

### The GLAXO case-Patent or a Design



Bottom view of known inhaler



BOTTOM VIEW OF GLAXO'S INHALER

### DOMAIN NAMES

- Yahoo.com vs. Yahooindia.com
- Rediff.com vs Radiff.com
- Defendants restrained

### DOMAIN NAMES

- WHEN DOMAIN NAME IS A GENERIC WORD?

- www.mutualfundindia.com

- ~~www.mutualfundsindia.com~~

NO INJUNCTION GRANTED