

INVENTOR GUIDANCE NOTES

(While papers published by the IP Group provide simple and accurate guidelines for inventors/ scientists)



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SCOPE: This Inventor Guidance Notes compiles some important legal terminologies, definitions & timelines of Intellectual Property Rights.	DATE: 28th June 2013
TABLE OF CONTENTS: A. Important definitions related to IPR B. Important Timelines in Patent prosecution C. Glossary D. List of Abbreviations E. References	REVIEWERS: Nitin S Tewari V. Premnath

Note: All definitions as per Indian context & regulations.

A. Important Definitions related to IPR:

Patent

- **Legal Definition** Patent is a grant or right to exclude others from making, using or selling one's invention and includes right to license others to make, use or sell it. (Ref. 1)
- **Explanation** A patent is an exclusive right granted for a certain period by a country to the owner of an invention to stop others from making, selling, importing or offering to sale his patented invention. The third party cannot make, use, import, manufacture, or market the invention without the consent of the patent holder. A patent in the law is a property right & hence can be gifted, inherited, assigned, sold or licensed. There is nothing like a global patent or a world patent. The patent right is territorial in nature & the inventors/their assignees have to prosecute the patent application in countries of their interest for obtaining patents in those countries. (Ref. 2)

Copyright

- **Legal Definition** Copyright means the exclusive right, to do or authorise the doing of any of the following acts in respect of a work or any substantial part thereof, namely:-
 - (a) in the case of a literary, dramatic or musical work, not being a computer programme, -
 - (i) to reproduce the work in any material form including the storing of it in any medium by electronic means;
 - (ii) to issue copies of the work to the public not being copies already in circulation;
 - (iii) to perform the work in public, or communicate it to the public;
 - (iv) to make any cinematograph film or sound recording in respect of the work;
 - (v) to make any translation of the work;
 - (vi) to make any adaptation of the work;
 - (vii) to do, in relation to a translation or an adaptation of the work, any of the acts specified in relation to the work in sub-clauses (i) to (vi);
 - (b) in the case of a computer programme,-
 - (i) to do any of the acts specified in clause (a);
 - (ii) to sell or give on commercial rental or offer for sale or for commercial rental any copy of the computer programme: Provided that such commercial rental does not apply in respect of computer programmes where the programme itself is not the essential object of the rental.”
 - (c) in the case of an artistic work,-
 - (i) to reproduce the work in any material form including depiction in three dimensions of a two dimensional work or in two dimensions of a three dimensional work;
 - (ii) to communicate the work to the public;
 - (iii) to issue copies of the work to the public not being copies already in circulation;
 - (iv) to include the work in any cinematograph film;
 - (v) to make any adaptation of the work;
 - (vi) to do in relation to an adaptation of the work any of the acts specified in relation to the work in sub-clauses (i) to (iv);
 - (d) In the case of cinematograph film, -

- (i) to make a copy of the film, including a photograph of any image forming part thereof;
- (ii) to sell or give on hire, or offer for sale or hire, any copy of the film, regardless of whether such copy has been sold or given on hire on earlier occasions;
- (iii) to communicate the film to the public;
- (e) In the case of sound recording, -
 - (i) to make any other sound recording embodying it;
 - (ii) to sell or give on hire, or offer for sale or hire, any copy of the sound recording regardless of whether such copy has been sold or given on hire on earlier occasions;
 - (iii) to communicate the sound recording to the public. (Ref. 3)

Designs:

- **Legal Definition** Design refers to the features of shape, configuration, pattern, ornamentation or composition of lines or colours applied to any article, whether in two or three dimensional (or both) forms. This may be applied by any industrial **process** or means (manual, mechanical or chemical) separately or by a combined process, which in the finished article appeals to and judged solely by the eye. Design does not include any mode or principle of construction or anything which is mere mechanical device. It also does not include any trade mark or any artistic work. (Ref. 4)

Trademark:

- **Explanation** A trademark is a distinctive sign capable of distinguishing the “goods” or “services” produced or provided by one enterprise from those of other enterprises.
- Any distinctive words, letters, numerals, drawings, pictures, shapes, colours, sounds, smells, logos, labels or combinations used to distinguish goods or services may be considered a trademark. (Ref. 5)

Invention:

- **Legal Definition** Invention means a new product or process involving an inventive step and capable of industrial application (section 2j of Patent Act, 1970) (Ref. 1)
- **Explanation** Invention may include any new art, process, method of manufacture, machine, apparatus, system, composition or a substance manufactured by a new process. (Ref.2)

Criteria for Patentable inventions:

- **Novelty:**
 - Explanation** An invention will be considered new if it does not form a part of the state-of-the-art also referred to as ‘prior art’. The Patent Act requires that the invention should not have been anticipated or disclosed through any publication or used anywhere in the world before the filing of a patent application in respect of the invention. In other words, the subject matter of the invention should not fall within the public domain or form a part of the state of the art. (Ref.2)

- **Non-Obviousness/ Inventive step:**

Legal Definition "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. (Ref. 1)

- **Utility:**

Explanation An invention must be capable of industrial application; capable of being made or used in an industry (Ref.2)

Non- Patentable Inventions:

- An invention which is frivolous or which claims anything obviously contrary to well established natural laws;
- An invention the primary or intended use or commercial exploitation of which could be contrary public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment;
- The mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature;
- The mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

Explanation For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy;

- A substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;
- The mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;
- A method of agriculture or horticulture;
- Any process for the medicinal, surgical, curative, prophylactic diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products.
- Plants and animals in whole or any part thereof other than micro organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;
- A mathematical or business method or a computer programme *per se* or algorithms;
- A literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;
- A mere scheme or rule or method of performing mental act or method of playing game;
- A presentation of information;
- Topography of integrated circuits;
- An invention which in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components.
- Inventions relating to atomic energy not patentable. (Ref. 1 & 16)

Filing of Patent: An application for a patent may be filed at any of the branches of Indian patent office in the prescribed format accompanied by relevant forms, specification & prescribed government fees. (Ref.2)

Types of Patent Documents

- **Provisional specification:** A specification which does not contain claims is regarded as a provisional specification. A provisional specification is filed in cases where the invention is not complete or is at a preliminary stage at the time of filing the application & requires further development. A complete specification must be filed within 12 months from the date of filing a provisional specification. [s 9 (1)]
Thus provisional filing is a priority document which secures a priority date for the invention. As India follows a first to file system, securing an earlier priority for the invention is highly beneficial for the inventor & is facilitated by the provisional filing.
An inventor is free to publish or go public with his invention once a provisional specification is filed at the patent office. (Ref.2)
- **Complete specification:** The complete specification is a techno-legal document which fully & completely describes the invention & the best mode of carrying out the invention. The invention should be described in a clear & succinct manner in the complete specification so that a person who is ordinarily skilled in the art should be able to work the invention without making any extra efforts. Claims are an important part of the complete specification, which describe the boundaries of the protection sought. A complete specification must be filed within 12 months from the date of filing a provisional specification. [s 9 (1)] (Ref.1, 2)

Types of Patent Applications (Ref.2)

- **Ordinary application:** It refers to an application, which is filed in the Indian patent office without claiming priority of any other application. It may be accompanied by a provisional or complete specification.
- **Conventional Application:** It is an application filed in the Indian patent Office claiming the priority of the same application filed in the convention country. The convention application must be accompanied with a complete specification & must be filed within 12 months from the date of filing the application in the convention country.
- **PCT/International Application:** The international patent application which is filed through patent cooperation treaty is also referred to as PCT application. If an application has been filed in the convention country, then the PCT application must be filed within 12 months from the date of filing the similar application in the convention country.
- **Divisional Application:** In accordance with s 10(5), the claims of a complete specification must relate to a single invention or to a group of inventions which are linked to each other by a single inventive concept. Subject to the provisions of s 16, if an application for patent contains more than one invention which are not linked to each other by a single inventive step, then an applicant may upon the controllers order file a further application in respect of a non-related invention disclosed in provisional or complete specification. The application so divided claiming non-related inventions is called as divisional patent application.

- **Patent of Addition:** A patent of addition may be filed in respect of any improvement in or modification of an invention described or disclosed in the complete specification of parent patent application. It has to be filed by the same inventors as named on the parent application. (based on ref.1)

Publication of patent application

Every application for patent is published after 18 months from the date of its filing or priority date whichever is earlier. However, following applications are not published.

- A) Application in which secrecy direction is imposed
- B) Application which has been abandoned u/s 9(1) and
- C) Application which has been withdrawn 3 months prior to 18 months (based on ref.1)

Early Publication: The patent act provides for an early publication of the filed specification when applied for it in the prescribed form & upon payment of the prescribed fees. Request for early publication can be filed any time after filing the complete specification. (Based on ref.1)

Patent Examination: The patent office examines the novelty, inventive step & industrial applicability of the invention when a request for examination is made in the prescribed form within 48 months from the date of priority or date of first filing. The examiner compiles his comments on the patentability of the application in a report known as the First Examination Report (FER). He shares this report with the applicant. The applicant must provide his reply to the examiners comments within 12 months from the date of receipt of the report. On going through the comments, if satisfied the examiner may grant a patent to the applicant. If not satisfied with the applicants reply to the queries raised by the examiner, the patent application is refused a grant of patent. (Based on ref.1)

Grant of a Patent: The examiner on receipt of the applicants reply to his queries, if satisfied that the concerned patent application is novel, has inventive step & industrial applicability, may grant a patent to the applicant. (Based on ref.1)

Term of a patent: The term of a patent is 20 years from the date of first filing. (Based on ref.1)

Rights of a Patentee: A patent granted under this Act shall confer upon the patentee—

(a) where the subject matter of the patent is a product, the exclusive right to prevent third parties, who do not have his consent, from the act of **making, using, offering for sale, selling or importing for those purposes that product in India;**

(b) where the subject matter of the patent is a process, the exclusive right to prevent third parties, who do not have his consent, from the act of using that **process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India** (Ref. 1)

B. Important Timelines in Patent Prosecution

No.	Proceedings	Timelines
1.	Provisional specification/ Direct Complete specification	Priority filing – 0 month. All the time lines are usually counted from this date.
2.	Complete specification filed in pursuance of provisional specification	Within 12 months from the date of filing provisional specification
3.	Proof of right to make an application by virtue of assignment of right	At the time of filing an application or within 6 months from the date of such filing
4.	Conversion of complete specification into provisional specification	Within 12 month from the date of filing an application
5.	Publication of an application (automatic publication)	18 months from the date of priority filing
6.	Request for early publication	Any time after filing an application
7.	Withdrawal of an application before publication	3 months prior to the expiry of 18 months from the date of application
8.	Request for Examination	Within 48 months from the date of priority or date of first filing.
9.	Information & undertaking regarding foreign filing	At the time of filing an application or within 6 months from the date of such filing
10.	Pre-grant opposition	Any time after publication of an application & before the grant of the patent
11.	Post-grant opposition	Within 1 year from the date of publication for the grant of patent
12.	Application for the grant of compulsory license	Anytime after 3 years from the date of grant of patent
13.	Application for restoration of lapsed patent due to non-payment of renewal fees	Within 18 months from the date on which the patent lapsed
14.	Surrender of patent	Anytime after grant of the patent
15.	Post dating of an application	Anytime after filing & before the grant of a patent
16.	Information regarding the extent to which the invention has been worked on commercial scale in India	Shall be furnished in respect of each calendar year before the expiry of 3 months of the end of each year & within 2 months from the date of communication of controller.
17.	Declaration as to inventorship	Along with the application or before the expiry of 1 month from the date of priority filing

C. Glossary:

A

Abandonment: An inventor may decide to abandon a patent application that is pending in the patent office by not responding to communications from the patent office or by notifying the patent office that he or she officially wishes to abandon the application. Once an application is abandoned, patent office will no longer consider the application for patentability. (Adapted from Ref.7)

Abstract: The abstract is a required part of a patent application. The abstract should be designed to allow a reader to determine quickly the subject matter of the patent application. (Ref. 7)

Allowance: Allowance is the term used by some patent offices to indicate that a patent application is in a condition to become a granted patent. (Ref. 7)

Amendment: Any change to a patent application that is pending in the patent office may be changed by an amendment. Amendments are usually made in response to a communication from the patent office, but an inventor can submit a preliminary amendment before he or she receives any communication from the patent office. Amendments cannot add information that was not part of the original patent application, but portions of the application may be deleted or rewritten. Obvious errors in the application may also be corrected. Amendments may also be made to a granted patent, following which it will be published along with the amendment to facilitate opposition to the amendments if any. (Ref. 7)

Anticipation: A reference that contains all of the elements of a claim is considered to anticipate the claim. (Ref. 7)

Application: A written document seeking patent protection and filed with the Indian Patent Office or a patent office outside of the India. The application must include a disclosure of the invention that would, without undue experimentation, enable a person of ordinary skill in the art to make and use the invention; at least one claim (in case of complete specifications); drawings (if drawings are necessary to understand the invention); and disclosure of what the inventor views as the best mode for practicing the invention. The claims of the application define the invention and the scope of the coverage sought. The written description and enabling disclosure are typically found in the specification portion of the application. The specification is the narrative portion of the application, along with the drawings, if present. The specification includes the description of the preferred embodiments or best mode of practicing the invention. It may include a summary of the invention; a description of the background of the invention, including prior art or the problem dealt with by the invention; and a description of the drawings. The specification may also include an abstract of the disclosure. (Adapted from Ref. 8)

Appellate Board: Intellectual Property Appellate Board (IPAB) has been constituted by a Gazette notification of the Central Government in the Ministry of Commerce and Industry on 15th September 2003 to hear appeals against the decisions of the Registrar under the Trade Marks Act, 1999 and the Geographical Indications of Goods (Registration and Protection) Act, 1999. IPAB has its headquarters at Chennai and shall have sittings at Chennai, Mumbai, Delhi, Kolkata and Ahmadabad. In terms of the Notifications No.12/15/2006-IPR-III) dated 2/4/2007 issued by the Ministry of Commerce & Industry, the provisions of the Patent Amendment Act, 2002 and the Patents Amendment Act, 2005, relating to the Intellectual Property Appellate Board

have been brought into force. Thus, all the Appeals pending before the various High Courts will stand transferred to the IPAB. Likewise, fresh Rectification Applications under the Patents Act, 1970, will have to be filed before the IPAB. (Ref. 14)

Assignee: An assignee is the owner of a patent application or granted patent to whom the rights of a patent have been assigned. (Ref. 7)

Assignment: The transfer of ownership of patents or patent application is typically referred to as an assignment. (Ref. 7)

Assignor: Someone who is transferring their ownership of a patent application or granted patent is considered to be an assignor. (Ref. 7)

B

Best Mode: Patent Law requires that a patent application include the best mode in the description of the invention. The best mode is the best way that the inventor considers at the time of filing the patent application for making and using the claimed invention. (Ref. 7)

Budapest Treaty: Budapest treaty on International Recognition of deposit of Micro-organisms for the purposes of patent procedure. The authorized depository institution in India located at Chandigarh is the Microbial type Culture Collection & Gene bank (MTCC). When a patent application relates to a micro-organism, it is mandatory for the applicant to deposit a culture of the concerned microbe at the depository. (Based on Ref. 1 & 2)

C

Capable of Industrial Application: Means that an invention must be capable of being made or used in an Industry. This is an essential criterion for patentability. (Based on Ref. 1)

Citation: All the relevant prior arts found during the examination of a patent application, by an examiner, which may hamper the prospects of grant of a patent are called citations. These may include patent as well as non-patent literature. (Adapted from Ref. 15)

Claim: A claim in a patent application is the legally binding portion of the patent application. It describes the boundaries of the invention for which the protection is sought. Claims are the legal parts of a patent document. Typically an apparatus/ product claim consists of a series of elements related to one another that describe the invention. A method/process claim consists of a series of steps that describe the novel method. (Ref. 7)

Compulsory License: At any time after the expiration of three years from the date of the grant of a patent, any person interested may make an application to the Controller for grant of compulsory licence on patent on any of the following grounds, namely:—

- (a) that the reasonable requirements of the public with respect to the patented invention have not been satisfied, or
- (b) that the patented invention is not available to the public at a reasonably affordable price, or

(c) that the patented invention is not worked in the territory of India. (Ref. 1)

Controller: Controller means Controller General of Patents, Designs & Trademarks. He is the signing authority for the grant of a patent. (Ref. 2)

Convention Country: Any country, which is a signatory or party or a group of countries, union of countries or intergovernmental organisations which are signatories or parties to an international, regional or bi-lateral treaty, convention or arrangement to which India is also a signatory or party and which affords to the applicants for patents in India or to citizens of India similar privileges as are granted to their own citizens or citizens to their member countries in respect of the grant of patents and protection of patent rights shall be a convention country or convention countries for the purposes of this Act. (Ref. 2)

D

Declaration as to Inventor-ship: An inventor or group of inventors are required to sign and submit a declaration as part of the patent application. The declaration or oath should state that the inventor believes that he is an inventor, that he is familiar with the contents of the patent application. (Ref. 2)

Design Patent: A design patent is a patent that protects the appearance of something not the combinations of elements or how they are interrelated which is considered a utility patent. (Ref. 7)

Description: A full & detailed explanation of the invention & how it works, filed at the office to initiate a patent application. The description must give away the best mode of performance of the invention & may be accompanied by one or more drawings. (Ref. 2)

Divisional Application: Patent law allows a patent owner to have only one invention per patent. In some cases that the patent examiner will determine that there are at least two different inventions claimed in a single patent application. In such a scenario, the examiner will require the patent owner to divide the application, one division will be elected to continue with the examination with the patent office and the other division may be withdraw to be filed as a new patent application, which is usually referred to as a divisional application. (Based on Ref. 1 & 7)

E

Enablement: Patent law requires that a patent application describe the claimed invention in such a way that anyone of ordinary skill in the technology that the invention is concern with will be able to make and use the claimed invention. (Ref. 7)

Examiner: The examiner is the employee of the patent office who reviews the patent application and judges the novelty of the claimed invention. (Ref. 7)

Exclusive License: A license from a patentee which confers on the licensee, or on the licensee & persons authorised by him, a right to exclude all persons (including the patentee) from using, selling, offering for sale, etc the patented invention. (Ref. 1)

Extension of Time: When the patent office communicates to the patent owner or his representative, the patent office usually mandates a time in which the owner or representative may respond without paying a late fee. If the owner or representative does not respond within the time period he or she must pay the late fee and request an extension of time. (Ref. 7)

F

File Wrapper: The file wrapper is the record of documentation kept by the United States patent office on a patent application or granted patent. (Ref. 7)

Filing Date: The filing date is the date on which the patent application was first filed at the patent office. (Ref. 7)

Filing Fee: The patent office requires a fee to process the patent application which is required at the time of filing. (Ref. 7)

First Examination Report: FER is the report provided by a patent examiner authorised by the Controller General of the Patent Office of India after examining a patent application. It mentions all objections to the grant of patent (if any) along with the citations hampering the grant of patent to an application. (Based on Ref 1 & 2)

First to File: In a first-to-file system, the right to the grant of a patent for a given invention lies with the first person to file a patent application for protection of that invention, regardless of the date of actual invention. (Based on Ref. 18)

First to Invent: Under this system, the date of filing a patent was not given preference if it could be proved by lab records etc that the invention was “first invented” by the claimant. Canada, the Philippines, and the United States were the only countries to use *first-to-invent* systems, but each switched to first-to-file in 1989, 1998, and 2013 respectively. (Based on Ref. 18)

G

Geographical Indication: Geographical Indications of Goods are defined as that aspect of industrial property which refers to the geographical indication referring to a country or to a place situated therein as being the country or place of origin of that product. Typically, such a name conveys an assurance of quality and distinctiveness which is essentially attributable to the fact of its origin in that defined geographical locality, region or country. (Ref. 6)

H

Hearing: The applicant can request for a hearing with the controller after receiving the First Examination report in order to convince the examiner by replying objectively to all the objections raised in the FER. (Ref. 2)

I

Infringement: Infringement is the term used for act of violating a patent owner's rights. (Ref. 7)

Intellectual Property: Patents, trademarks, copyrights, trade secrets and other intangible assets are considered to be intellectual property. (Ref. 7)

International Application: means an application for patent made in accordance with the Patent Cooperation Treaty. (Ref. 2)

Invention Disclosure: A patent agent or patent attorney will often ask the inventor to provide them with some kind of written description of their invention. This helps the attorney to better understand the invention and prepare a better patent application accordingly. (Ref. 7)

Inventive Step (Non-Obviousness): Means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both & that makes the invention not obvious to a person skilled in the art. (Ref. 1 & 2)

Inventor: In the patent world an inventor is someone who contributed to at least one of the claims in the patent application. (Ref. 7 & 17)

Issue: When a patent application becomes a patent, it is said to issue as a patent in many countries. In India a patent is said to be granted. (Adapted from Ref. 7)

J

K

L

Lapse: A granted patent is said to have lapsed due to non payment of renewal fees. A lapsed patent may be revived within a specific period from the date of lapse by payment of prescribed fees & making an application along with the reasons that led to the lapse. (Based on Ref. 1)

Legal Representative: Legal representative means a person who in law represents the estate of a deceased person. (Based on Ref. 1)

License: A patent owner can license a company to make their patented invention in exchange for sum of money and/or royalties. (Ref. 7)

M

Manual of Patent Examining Procedure (MPEP): The MPEP is the manual that the examiner at the patent office uses for reviewing patent applications. (Ref. 6)

N

National Biodiversity Authority: The National Biodiversity Authority (NBA) was established in 2003 to implement India's Biological Diversity Act (2002). The NBA is a Statutory, Autonomous Body and it performs facilitative, regulatory and advisory function for the Government of India on issues of conservation, sustainable use of biological resources and fair and equitable sharing of benefits arising out of the use of biological resources. The Biological Diversity Act (2002) mandates implementation of the Act through decentralized system with the NBA focusing on advising the Central Government on matters relating to the conservation of biodiversity, sustainable use of its components and equitable sharing of benefits arising out of the utilization of biological resources; and advising the State Governments in the selection of areas of biodiversity importance to be notified under Sub-Section (1) of Section 37 as heritage sites and measures for the management of such heritage sites. (Ref. 19)

New Invention: Means any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification i.e., the subject matter has not fallen in public domain or that it doesn't form a part of the state of the art. (Ref. 10)

Non-Obviousness: A patentable invention is required to be non-obviousness. This means that there are no references in combination or individually that teach all of the elements of the claimed invention. Non-obviousness also means that one of ordinary skill in the art would not feel that the claimed invention is obviousness. (Based on ref. 1)

O

Office Action: An office action is a communication from the US patent office requesting that an action be taken concerning the patent application. Typically the office action will request that the inventor overcome an objection (deals with a formatting error) or a rejection (deals with a statutory bar). The objection could request a change to the figures of the application or a spelling mistake; while on the other hand, the rejection may deal with claims that don't definitively define the invention or it may deal with a reference which discloses the claimed invention. (Ref. 7)

One of Ordinary Skill: One of ordinary skill in the art is someone who has ordinary skill in the technology that deals with the claimed invention. The MPEP discloses several characteristics which are used to determine who would be someone of ordinary skill in the art since it would change from field to field. During examination, an inventor has to determine if someone of ordinary skill in the art would consider the invention obvious. (Ref. 7)

Opposition of Patent: An opposition proceeding is an administrative process available under the patent and trademark law of many jurisdictions which allows third parties to formally dispute the validity of a pending patent application ("pre-grant opposition"), of a granted patent ("post-grant opposition") or of a trademark. (Ref. 11)

P

Paris Convention: The Paris Convention for the Protection of Industrial Property, signed in Paris, France, on 20 March 1883, was one of the first intellectual property treaties. It established a Union for the protection of industrial property. The Convention is still in force as of 2013. According to Articles 2 and 3 of this treaty, juristic and natural persons who are either national of or domiciled in a state party to the Convention shall, as regards the protection of industrial property, enjoy in all the other countries of the Union, the advantages that their respective laws grant to nationals. In other words, when an applicant files an application for a patent or a trademark in a foreign country member of the Union, the application receives the same treatment as if it came from a national of this foreign country. Furthermore, if the intellectual property right is granted (e.g. if the applicant becomes owners of a patent or of a registered trademark), the owner benefits from the same protection and the same legal remedy against any infringement as if the owner was a national owner of this right. (Ref. 13)

Patent: A patent is an exclusive right granted by a country to the owner of an invention to stop others from making, using, selling, importing or offering to sale his patented invention. The third party cannot make, use, import, manufacture or market the invention without the consent of the patent holder. This trade-off is designed to encourage innovation, while making society better off in the long run by exposing the public to new ideas. (Ref. 1)

Patentable: An invention that meets the requirements of patentability under relevant laws for being granted a patent is called as a patentable invention. Typically an invention needs to meet the following criteria: Novelty, Inventive step, Utility. Also it should not be of subject matter mentioned under non-patentable inventions under the act.

Patent Agent: A patent agent is a professional who is entitled to draft & file patent applications on behalf of an applicant whose name has been registered in the register of patent agents maintained by the patent office. (Based on Ref. 1)

Patent Cooperation Treaty (PCT): The PCT is a treaty that simplifies foreign patent filings in countries that are members of the World Trade Organization. A PCT filing allows an inventor to initially file a single patent application with a receiving office (usually the national patent office of that country) after which the patent application will receive an initial international examination before the inventor needs to decide which foreign countries he desires to file in. Once the application enters into a foreign country, the patent application will be reviewed again since all countries have different patent laws, but usually those national examinations rely heavily on the international examination. (Ref. 7)

Patent Examiner: A patent examiner is an employee at the patent office who is authorized to examine patent applications and legally determine the application's fate. (Ref. 7)

Patent Owner: Initially an inventor or group of inventors are the owners of the patent or patent application. All inventors have equal rights to the claimed invention regardless of the contribution of the claims, just as long as they made some contribution. Typically an inventor who works for a company is required under an employment contract to assign (or transfer ownership) of the patent or patent application to their employer. (Ref. 7)

Patent Search: A patent search is a search typically performed before the filing of a patent application to determine patentability of the invention. Patent law does not require that a patent search be performed although the law does require that anyone involved in the preparation of the patent application submit to the patent office any information that they feel would affect the patentability of the claimed invention. (Ref. 7)

Pending: While a patent application that is waiting to be either examined by a patent examiner or to be issued in the patent office, it is considered to be pending. (Ref. 7)

Person Interested: includes a person engages in, or in promoting research in the same field as that to which the invention relates. (Ref. 2)

Prior Art: Prior art is the term to describe all of the knowledge and references pertaining to the technology of the claimed invention in the patent application. (Ref. 7)

Priority Date: A priority date is the earliest filing date that a patent application can claim. Some patent applications that are related to earlier filed patent applications by the same inventor can claim priority to the earlier applications. (Ref. 7)

Process Patent: A patent granted for a new process i.e for a process claim or a method claim is known as a process patent.

Product Patent: A patent granted for a product i.e claims for a composition, system, new substance, new machine/gadget etc is said to be product patent under the patent laws.

Prosecution: Prosecution refers to the interactions, abiding of formalities etc between an inventor and the patent office dealing with making a patent application ready for grant. (Ref. 7)

Provisional Application: A provisional patent application is an application that is filed with the patent office that is intended to expire automatically in one year from its filing date without an examination. The intent of a provisional patent application is to allow an inventor time to carry on more work on his invention before filing a complete specification 12 months down the line. (Adapted from Ref. 7)

Published Patent Application: Eighteen months after the filing date of a patent application, the patent office publishes the application. This does not give the inventor any more rights, but simply informs the public of what the inventor has filed. Typically at this point the patent application will still be pending in the patent office. An inventor can pay to have a patent application publish earlier, later or not at all depending on the needs of the inventor. (Ref. 7)

Q

R

Reduction to Practice: An invention is required to be reduced to practice before a patent can be applied for in United States. Actual reduction means that there is at least a prototype of the invention made. Constructive reduction means that all of the details to enable someone to make and use the invention have been thought through. The Indian patent office doesn't have any such requirement. (Based on Ref. 7)

Register of Patents: It is the register of patents kept at the Patent Office containing the names & addresses of grantees of patents, notifications of assignments & of transmission of patents, of licenses under the patents & of amendments, extensions, & revocation of patents; and particulars of such other matters affecting the validity or proprietorship of patents. (Based on Ref. 6)

Renewal Fees: Maintenance fees or renewal fees are fees that are paid to maintain a granted patent in force. Some patent laws require the payment of maintenance fees for pending patent applications. Not all patent laws require the payment of maintenance fees and different laws provide different regulations concerning not only the amount payable but also the regularity of the payments. In countries where maintenance fees are to be paid annually, they are sometimes called patent annuities (Based on Ref. 1)

Rejection/Refusal: When after the examination, & taking into consideration the applicant's comments on the first examination report, the examiner is satisfied that the patent cannot be granted, it is deemed to be a refusal or rejection to the grant of the patent to the applicant. (Based on Ref. 1)

Revocation: Revocation of patents can be made under Section 64 of the Indian Patents Act 1970. A patent may be revoked on a petition of any person interested or of the Central Government by the Appellate Board or on a counter claim in a suit for infringement of the patent by the High Court. (Ref. 12)

S

Specification: The specification, which is also called the disclosure, is a written description of an invention. The patent specification is drafted both to satisfy the written requirements for patentability, as well as to define the scope of the claims. A specification in other words is a general explanation of the invention and how to practice it along with Specific examples of how to practice the invention. (Ref. 9)

T

Trade Secret: A trade secret is a formula, practice, process, design, instrument, pattern, or compilation of information which is not generally known or reasonably ascertainable, by which a business can obtain an economic advantage over competitors or customers. (Ref. 6)

Trademark: A trademark is a distinctive sign capable of distinguishing the “goods” or “services” produced or provided by one enterprise from those of other enterprises. (Ref. 6)

True & First Inventor: Does not include either the first importer of an invention into India or a person to whom the invention is first communicated from outside India. (Ref. 1)

U

Unity of Invention: It is mandatory that each patent application must relate to only one invention i.e. must have a single inventive step. This is known as unity of invention.

Usefulness/Utility: The invention must be capable of industrial application i.e it can be made or used in an industry. (Ref. 1)

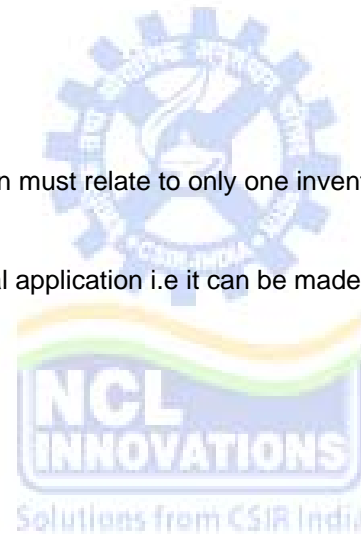
V

W

WIPO: The World Intellectual Property Organization (WIPO) is the United Nations agency dedicated to the use of intellectual property (patents, copyright, trademarks, designs, etc.) as a means of stimulating innovation and creativity. (Ref. 13)

Withdrawal of Application: When at any time after filing an application, the applicant feels that he does not wish to pursue the application further; he can abandon the application by formally writing to the controller expressing his wish to do the same or by simply not following the prosecution timelines.

Working of Patent: As per the Patent Act 1970, it is mandatory that an invention is practiced in India on a commercial scale and to the fullest extent that is reasonably practicable without undue delay. The Act requires every patentee and every licensee (whether exclusive or otherwise) to provide information on



the extent to which the 'patented invention' has been worked on a commercial scale in India (S. 146(2)). Failure to supply such information creates a presumption of non-working, and may assist the process of grant of compulsory licenses. (Based on Ref. 1)

X

Y

Z



D. List of Abbreviations:

No.	Abbreviation	Full form
1.	CGPDTM	Controller General of Patents, Design & Trademarks
2.	DO	Designated Office
3.	DOF	Date Of Filing
4.	EO	Elected Office
5.	EPO	European Patent Office
6.	FER	First Examination Report
7.	GATT	General Agreement on Tariff & Trade
8.	ISA	International Searching Authority
9.	IPEA	International Preliminary Examining Authority
10.	IB	International Bureau
11.	ISR	International Search Report
12.	IPRP	International Preliminary Report On Patentability
13.	IP	Intellectual Property
14.	IPR	Intellectual Property Right
15.	IPO	Indian Patent Office
16.	IPAB	Intellectual Property Appellate Board
17.	NBA	National Biodiversity Authority
18.	MOU	Memorandum Of Understanding
19.	MPPP	Manual of Patent Practice & Procedures
20.	NPE	National Phase Entry
21.	PCT	Patent Cooperation Treaty
22.	PA	Patent Agent & Patent Application
23.	POA	Patent Of Addition
24.	TRIPS	Trade Related Aspects of Intellectual Property Rights
25.	WIPO	World Intellectual Property Organization
26.	WTO	World Trade Organization
27.	WOSA	Written Opinion of Searching Authority
28.	USPTO	United States Patent & Trademark Office

E. References:

1. The Patent Act, 1970
2. Patent agent examination, Sheetal Chopra & Dr Akash Taneja, 2nd Edition, 2010
3. Indian Copyright Act, 1957
4. The Design Act, 2000
5. The Trademarks Act, 1999
6. <http://www.ipindia.nic.in/>
7. <http://www.inventorbasics.com/Patent%20Glossary.htm>
8. <http://www.tms.org/pubs/journals/jom/matters/matters-9609.html>
9. <http://www.patentlens.net/daisy/patentlens/2341.html>
10. <http://www.ipindia.nic.in/ipr/patent/manual/HTML%20AND%20PDF/Manual%20of%20Patent%20Office%20Practice%20and%20Procedure%20-%20html/Chapter%208.htm>
11. http://en.wikipedia.org/wiki/Opposition_proceeding
12. <http://www.itagbs.com/articles/revocation.html>
13. <http://www.wipo.int/about-wipo/en/>
14. <http://www.ipab.tn.nic.in/>
15. <http://www.intellogist.com/wiki/Citations>
16. <http://www.nclinnovations.org/pdfs/ign/IGN-08-exclusion-list.pdf>
17. <http://www.nclinnovations.org/pdfs/ign/IGN-05-Inventorship-v03-20111111.pdf>
18. http://en.wikipedia.org/wiki/First_to_file_and_first_to_invent
19. <http://www.nbaindia.org/>



Note: This IGN was finalized in the current form on 21st Aug 2013. This is intended as a working document. Readers are requested to provide comments/suggestions & point to any errors (if any) so as to help improve this document. Comments may be sent to sv.kanitkar@ncl.res.in