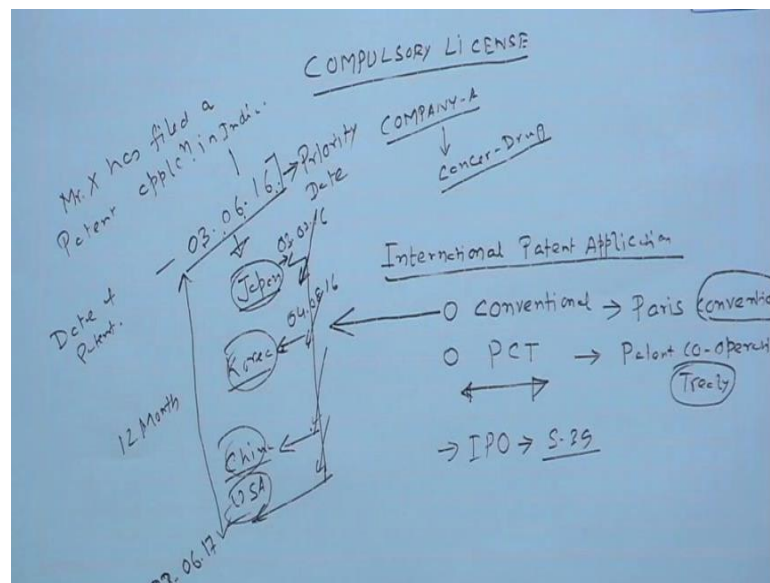


Introduction on Intellectual Property to Engineers and Technologists
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Lecture - 13
International Patent Filing

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So, we you now learnt about Indian part, so how to get the patent in India, what are the work flow with reference to the patent applications in India? Just like said what will be your work flow with reference to the patent in India?

So now, I referred already to you the patent right is (Refer Time: 00:55) right. What is the meaning of that, that your Indian patent is only valid in India? So, the virtue o that; so now you want establish your business in China, but you have a patent in India. So you always have to be in fear of fear of two ways. What are the two way? You may came up with a situation that you are infringing somebody's patent in China and another situation let us say you will pay this thing is in say in the consideration in the form of a public good in China.

So, if it is a public good in China so other competitor also can produce the same product in China. So you have to face the consequences of competition in China, somehow will

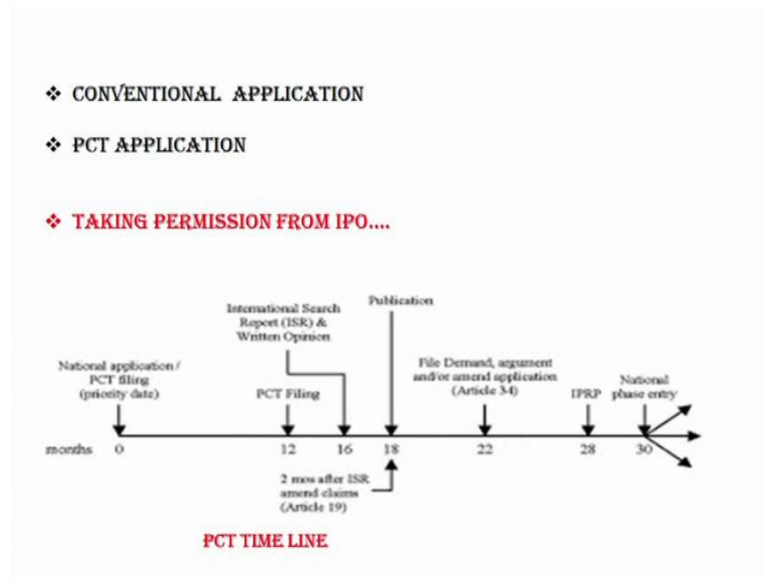
not able to use your powers sometimes you called Dominant power. So sometime you patent give ultimately give a dominant power, in a particular market; although, you should not use your dominant power, but you will get a dominant power in the market if you have a patents.

So, understood that you have got the patent in India, you want to ultimately establish a business in China, then what threat you have. First means you will not having dominant power in China, you have to face competition in China and another state that you may fear of that somebody have a patent may be in China, with reference to the same or similar type of invention then you are falling in trap of that patent, so then you are infringed in China. Although, we had patent holder in India but you are infringed in China, definitely you will not want that, so considering that you already told that.

So, we have procedure or just like say for getting if it in other countries also. Just like say Paris convention you have heard about, you heard about the gat, you have heard about the trips. The trade related aspect of intellectual property rights just like you heard about WTO; World Trade Organization.

So it is a say WTO is they can administer and enforced trade related aspects. So similarly the trips suggested a general frame work of IP law. The country who are the member of the trips, they will have to follow the minimum standards with reference to the IP law, just take I referred patent ability criteria. Now almost uniform what the member of trips all the 3 criteria is there, so they have to minimum at least a mere follow gives some bench mark, if you are the member of that is a minimum bench mark they can go beyond that but they should not go below that. So, minimum bench mark has been described that by the trips and the country has to follow that minimum bench mark.

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So there lies the international characteristic; international body and so considering that say Paris convention and trips. So, if I now ask you, how to will get a file patent application in other country. So, there that based on Paris convention then subsequently we have a patent cooperation treaty. Now patent law treaty different types of treaty all conventions these are the called, so soft tool or international tools. So, used for say for administering, enforcing, something beyond that countries jurisdiction. So with reference to the procedural aspect also, they make the system easier for applicants also. So definitely they have to create to a frame work. So, based on that these two routes you can presently available for an applicant of India and subsequently on (Refer Time: 05:49) basis.

So, somebody can file patent application in other country. So I referred there conventional application and PCT application I tried to explain these two things to you. So, conventional application generally is coming based on the Paris conventional, so Paris convention you understood convention treaty then convention treaty it is called Patent law; Patent cooperation treaty. So these are two soft tool or international tool it can be used with reference to the patent to get right beyond a particular territory with reference to a same invention may be.

So the conventional patent application, I will explain that. So, let us say Mr. X has filed a patent application in India. So now, he is thinking about extending or thinking about

creating his rights about the same invention in country like Japan, China, Korea, USA; so now he has already filed a patent of application. So, he got a date in India let us say today is 03.06.16; so his date of patent in India is 03.06.16.

So how he will get able to create the rights in our country; you may ask me you told that novelty inventive states are industrial activities criteria in other countries also. So now if he file patent application in Japan, how the patent application of Japan will be novel based because it is prior claimed in India patent applications. Although, the applicant or inventors are same, but already it is claimed in a prior patent application in India then, so then it will be a problem. So the WTO or Paris convention have come up with their some guidelines or procedure or rules you may consider to, somehow mitigate this problem. So, what they have, what say guidelines or tools or routes or rules, they have come up.

Let us say you have filed a patent application in India 03.06.16. So, now using the conventional route, you can file patent application in other country like Japan, Korea but you have to thought about; whether all are member of Paris convention or not in Korea, China, USA; you can file patent application in other this countries also Japan, China, Korea, USA. So, they have told that if you file; you have to file the patent application in all those country within 12 month. This 12 month form the 03.06.16 means you have to file the patent application by 02.06.17 in all those country, if you follow by conventional route.

So, in that case the filing in India will be considered the priority, will get priority date. This is will be considered priority date, with reference to the patent filing date in this country. So, if you file patent application claiming priority of your patent application in India then that will not destroy the novelty of the patent application in those country, like Japan, Korea, China or USA. So in that case that they told if you file patent application within 12 month from the date of filing the patent application in a country, who where you are, so where you have filed patent application first, in that case you will not destroy the novelty of your invention, but you have to file the patent application within 12 month from the date of first filing the patent application in that first patent application.

So, this is the conventional route means advantage you are getting 12 month time to file patent application in the country who are the member you want to protect and who are also member of that is convention, so this is the; we call it is Conventional Patent

Applications. So, when you will file the patent application in Japan you have to tell my priority date is 03.06.16. When you file a patent application in Korea you have to refer my priority date, such and such date and you have to give the; submit the priority documents is whatever the patent application you filed in India, that will be considered priority document in Japan, Korea, China.

You may refer that priority document, you may go to Korea with the two priority documents means 03.06.16 then based on the that priority document again you have filed in Japan in may be 03.07.16. So, you can list here with two priority document in 04.08.16. Like this way you may claim multiple priorities is also there is no problem (Refer Time: 12:35) of that, but the date of the fast priority document will be 03.06.16.

So, conventional route you can use to file the patent application in a member country; which are, who are the member of Paris convention, so this is a conventional route of filing patent application. Now disadvantage of that you have to go and file the patent application in the country, again you have to file a patent applications in Korea, Japan, China and USA and also within 12 month.

So, problem means individually again you have to file patent application then that international body now administered by WIPO then came of another treaty call patent cooperation treaty how that it make the system easier for the applicant. So, they have come up with a procedure called patent cooperation treaty and some application called PCT applications route or sometime called international patent applications route. Although there is no international patent, but this is making two routes that make an applicant who get extend his right in different jurisdiction with ease. Just I will try to explain the component or timeline with reference to the PCT application. Although little bit complicated by I will try to explain that thing.

So, just I say you may come to the international filing in different ways also just like say based on conventional, you can may mixed some cases that conventional application along with the PCT routes also or you may file a provisional application based on that you are coming to the complete specifications also. So, let us say you are filing a provisional application in Indian patent office in 0 months means today or you have filed a conventional application means another you have a say application then you want to claim priority of that.

So, let us say considering that also, so let us say you have claiming just like the provisional application in this considering the priority get the priority date. Now within 12 months you are filing a international patent application or PCT application or you may come directly you can also think thought about filing a PCT application here.

So, in this case say directly you can go 0 to 12 without priority you are coming to a PCT application or with priority you are entering into the PCT application. So in this case 0 to 12, another 12 months you are getting or you may directly file an international patent application in India patent office in the considering Indian patent office as a receiving office, so you are filing a PCT application directly in India.

So, you are filing a patent application directly in India in Indian patent office as an international patent application. So now what they will do say if Indian patent office receiving office, so they will transmit your applications to you have to what application fee you have to pay the application fee, transmittal fees. You have to pay here what fee international application fee; you have to pay transmittal fees. So, they will ultimately check formality as per PCT rules and they will transmit the things your application to the IB International Bureau.

So, International Bureau and I forget to mention here, you have to again pay another thing called search fee and you have to mention which search agency will ultimately you are using for to that agency will provide a search report. So, that I receiving office will transmit your application to the IB, IB will now send your application to that search agency for international search report and if you optionally asking for a say international preliminary examination report and you are mentioning an agency or same agency is doing for ISR also same agency is for IPEA no problem.

So, then IB also transmit your application to the search agency also IPEA, when within 16 month. So, within 16 month they will send your application to search agency and may be IPEA. When within 18 month from the date means this is 0th month, if 0th month is a date. So, from the priority date within 18 month, if it is 0 here from here 18 month it will be published. So, already I told Indian patent office there is a opposition also this is the all international patent obligation international publications this is what say entry that is not on the entry in an national phase, so your application still in the international phase. So, authority is IB International Bureau or you may consider WIPO is the authority

which refers to administering all those aspects of the patent application, so they will publish for international publication.

Then you some in this time you may receive the search report from that international authority, international search authorities. Based on that you may be allowed as specified in the PCT rules; PCT article 34, you may go for some source of amendment. That amendment for first parts also again may be icon will be published, but amendment is limited by the article 34. You not go search report is telling like this, I will completely change that let the amendment have been scope a limit of amendment already specified on that part, so it will be based on that. So, publications then may be allowed to amend till 22 months; some cases it is again published by the IB.

So, then now you have to enter into the national phases within 31 month. So, it is running in the international phase till 30 month after 30 or within 31 month you have to enter into the national phases. So now, in your international patent application you may state that I am selecting all 130 member of the PCT where I want to put it my rights. So, that you there is no problem that you may state that or you may state that in 10 country I want, so I want to I am electing 10 country then for my will not get my rights; get my patent to be protected, but the after say you get receiving the search about after receiving all sorts of thing, you have changed your mind you do not get any partner in that countries, where you are initially considering that I can may protect my invention, you do not get any partner.

So, now you are electing or selecting only may be selecting only electing you may consider electing also choosing only may be 10, 5 country. So now you have to mention which are the country where you want to put it your invention. So, within 31 month you may have to enough time to choose for where you may want to establish your business. So, wherever you establish your business, you have to protect your invention, protect your invention in that country in the form of patent to get a dominant position or for fear to escape the state of infringement in that country, so you are choosing that country.

So then it will enter that IB will ultimately communicate your patent application in that country, they will send the application in for that country. So, everything is administered, but you have to now pay the fees as applicable to that country. So now, paid fees

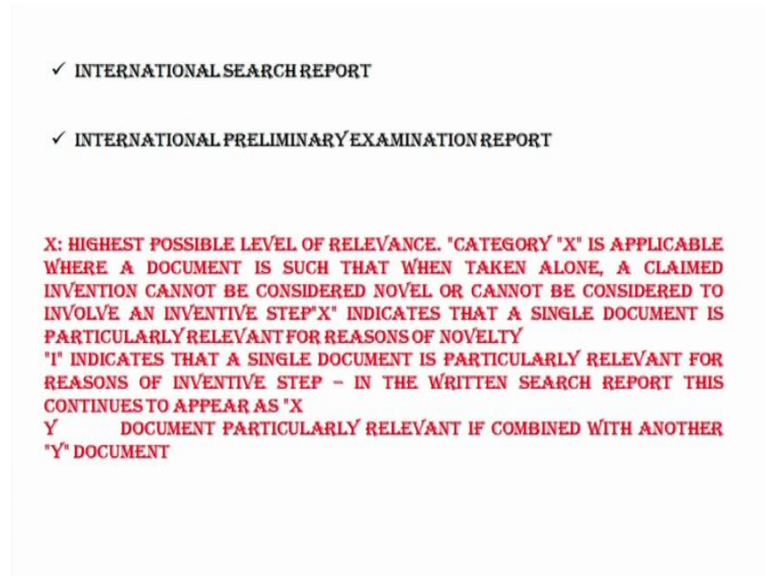
applicable in that country you have to pay. So, first you have to pay international fee then search fee, transmittal fee.

Now, there was no fee till 30 month, now you have to when you are entering the national phase these, now that as if you are entering in a US PTO then US patent law will be applicable. Their procedure will be applicable here, so after that say international phase now you are entering into the national phase; now, national phase means national law; national law will be applicable with refers to you patent now. So, then US PTO you are going for EPO, you are going for JPO and their law their act, so Japan patent act, US patent act, European patent act; will be applicable to your invention now. So what advantage with this filing a single patent application, you will be able to enter into multiple countries, you are getting 31 months time to entering into a national pledge.

So, now if this is your international filing date, now you will get a national phase filing date for the country will be the; so two date international filing date and national filing date for that country. So, within 31 month you have to enter into the national phase, so you are getting 31 month time to enter a national phase. So it is easier single, say single patent application you are able to enter in a country in different countries. So, this is the advantage where as to conventional application because conventional application, you are have to independently file patent application in each conventional country, but here you are filing with the patent application by single patent international, patent application. You are able to enter into the multiple territory and to put it your patent right in the multiple territory, multiple territory by filing a multiple national phase applications.

So, and you are getting 31 month time to select, you are getting and compulsory search report by international search authority. You are getting an international, so you may getting say optional international, preliminary examination report from particular authorities; advantage for you by PTC applications. So, if I ask which is advantageous I will say PCT advantageous because cost and time cost effective time, effective place is there in the PCT application as compared to that conventional applications.

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So what were you learnt now PCT application and conventional application. Although another tools is available for you to file a patent application. Let us say you are not interested to file patent application in India. Let us say industrial policy in India you are Indian, Indian origin, Indian citizen. So, although the act suggested Indian citizen should file patent application in India first, but if you are not interested to file in India then say you also, you can file patent application in other country, but in that situation you have to take permission from IPO. You have to take permission from IPO following section 39 of Indian patent right.

So what way you can file patent application other country; you may file patent application in India, then go following the PCT route or conventional route claiming priority situation or you may have take from his and file you simply apply before the controller in Indian patent office for convention to file patent application in other country. If you are a citizen of in India, then you have to follow that section 39, otherwise it may lead to the criminal offense.

So, you have to first take permission from IPO if you ask that 35 apply for permission and they are not giving the permission, you can have to wait the reasonable time the file have been prescribed in the section, I think most of it is six weeks after filing applying for application for permission to file patent application to other country. If I am not permitting then you can, if you are not receive, not permitting, not like that if your say

not getting any response from them, you can go and proceed for filing patent application in other country.

So if I ask now, what are the routes are available for an Indian citizen to get patent rights in USA, Korea, Japan and China. Then without India I told (Refer Time: 26:42) without India, in that case first is I will take permission, then you can go and file independently in that country, but how will you get file independently in that country. In that case you have to first to get a priority from one country or otherwise you have to file the same day in all that country. The time will be decided as per IST international time frame because time is you know that there is problem in time frame. So, time will be considered as per the IST international standard time IST standard time. So, you have to follow that and you have to file patent application in other countries.

So, without that without that you will not get the rights in other countries. So, you then you can follow conventional route, file patent application in India, file conventional route you can get the patent right in other country or simply file a international patent application in the day 1 itself in India. They are also it is generally in India in other countries or you file a patent application in a form of provisional application; then a file in international patent application in India designating India.

So I forgot to mention designated then elected ask first is for international patent application is called designated country. Then when you enter the national phase then you will consider as elected country, designated and elected. So these are the routes you can follow for international getting patent for filing patent application beyond your jurisdiction means your own country. Similarly the US citizens also can follow the routes of conventional application and PCT application and file patent application in India. You know that till although situation have been changing, but most of the majority of the patent application in India by foreign applicant either by means of multinational companies and others. So, when filings are more now PCT applications have been increasing in India, so international filings peoples are using to file patent application in India.

So, now I have referred just (Refer Time: 28:54) referring the international search report. International search report gives a different they have been categorized to search your patent application using the prior art search databases and categorized the different

search document. They will get by x y like this, if some document they got it then by virtue of that all features of your invention is available in that document they have categorized that is x category of document. Then document particularly a combined with other document then y category of document. So, that international search report will provide you the documents or parallel documents which are directly relevant or highly relevant or relevant along with the other document to destroy the novelty and inventive steps or invention. So, international search report will give an idea with reference to your inventions strength which refers to novelty and inventive steps.

So, this is the class with refers to international filing of patent using conventional route or PCT routes. You got an idea about international search report; you got an idea about the say PCT application, national phase, international phase, relevant time frame. You should remember that for to people to take to avail this route of PCT applications. So, let us in it here will further continue discussion on that aspect.