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INTELLECTUAL PROPERTY AND TECHNOLOGY LAW UPDATES

S&A IP-Tech

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INVENTORSHIP AND PROOF OF RIGHT

TUSHAR KOHLI

[1]Section 7 of the Indian Patent Act prescribes that whenever the application is made by the virtue of an assignment of the right to apply for a patent for a particular invention, the applicant is required to furnish either with the application or within six months of the date of the filing of Indian application, a proof of right to make the application. The said requirement is mandatory under [2]Rule 10 and a proof of right must be submitted along with the application for patent. However in case it is not furnished, the applicant can furnish such proof of right within a period of six months after the application is filed. The time period for filing proof of right can be extended under the provision of [3]Rule 138 by a maximum period of one month, considering the fact that request for extension is filed within the six month period of the application filed.

In order to establish the proof of right, Form 1 can be used wherein the inventor/s is/are required to sign a declaration in original through which the inventor(s) declare that the applicant is its/their assignee or legal representative. In case there are more than one inventors for a particular invention and the inventors are located around the world, the Indian Patent Office also accepts individually signed documents from each of the inventors.

In a case where the inventors are no longer part of the organization, filing of a certified copy of the employment contract may be sufficient to satisfy the requirement of proof of right provided that the employment contract states in clear terms that the invention was conceptualize and made by the inventors/employees during the time they were part of the organization and the invention was the property of the employer/ applicant. In a situation where one of the inventors is deceased, a form signed by the deceased's legal heir is acceptable to fulfil the proof of right requirement.

A peculiar situation that may arise is where there is no employment contract, and the inventor is no longer associated with the employer. In such cases, the applicant can provide a sworn affidavit stating that the inventor was a part of the organization during the invention and the invention was property of the employer.

Another option would be to submit a copy of certified or notarized USPTO or EPO global assignment if corresponding USA or EP application has been filed. Certified copy or "notarized copy of Assignment" filed in US or EP - wherein "certified copy of assignment" would mean a USPTO or EPO certified copy of the Assignment filed at said patent offices in any of the applications; and "a notarized copy of Assignment" would mean a copy duly notarized by a Notary Public to be true and complete copy of the original Assignment document.

1 https://ipindia.gov.in/writereaddata/Portal/ev/sections/ps7.html

2 https://ipindia.gov.in/writereaddata/Portal/ev/rules/pr10.html

3 https://ipindia.gov.in/writereaddata/Portal/ev/rules/pr138.html

A final resort if all the above-mentioned options are not feasible would be to provide a secondary evidence. It can be provided by way of an affidavit from the legal representative of the applicant and co-inventors, if any, along with requisite documents to be signed by the inventors. The signed documents can then be filed at the Indian Patent Office to establish that the applicant is the true owner of the invention.

One of the primary things to remember is that filing of the documents and evidences must be done within the prescribed period of six months of the filing of the application in India. If not filed within the prescribed period, the Controller has the power to refuse the patent application under [4]section 15 of the Indian Patent Act.

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4 https://ipindia.gov.in/writereaddata/Portal/ev/sections/ps15.html

THE BOLAR PROVISION IN INDIA: AN EXCEPTION TO PATENT MONOPOLY

SHILPI KUMARI

A patent is a monopoly right given exclusively to an inventor for a limited period of time in return of his/her disclosure of an invention that is a new, nonobvious, and useful product and/or process. It is an exclusive monopoly right, which most modern business owners leverage to optimize the commercialization of their intellectual inventions. Indian patent law enables a patentee to exclude others from making, using, selling, licensing for sale or importing their patented invention without their consent. The patentee is entitled to seek relief in case of an infringement, which includes an injunction, damages or an account of profits. However, certain acts of making, using, selling or importing a patented invention by a third party, even without the consent of the patentee, are not considered to be an act of infringement. This exemption is covered under section 107(A) of the Patent Law which is referred to as the 'Bolar provision' or 'Bolar exemption'.

Introduction to Bolar Exemption

Bolar provision' or 'Bolar exemption' can act as a safeguard against patent infringement, which is significant in the segment of pharmaceutical drugs. The provision allows the purpose of research as a defense, according to which, the use of a patented invention in research to generate clinic trial data for regulatory approval is not considered an act of infringement. Before the expiry of the patent term, pharmaceutical patentees have the IP monopolistic rights over patented drug(s) to refrain competitors from launching generic versions of the drug in the market.

Bolar exemption was introduced to provide an environment wherein generics could compete, but also simultaneously not to give monopoly to any single generic company or manufacturer. Though Indian research exemption explicitly says that — patent is used solely for purposes reasonably related to development and submission of information, but it does not charges or imposes the regulatory authority in the case of disclosure of information.

Bolar Exemption in India

The bolar exemption as provided in Section 107(A) has not seen much fervency in the Indian market as compared to other countries. Still with the Bayer v. UOI the litigation in this section has started and has gained some pace. Since the judgment in this case was mostly based on the sale and export, it missed out on some really important issues connected with bolar exemption. Indian research exemption is quite vast and is not restricted unlike that of U.S., but with such liberal provision comes many hurdles and obstacles. Indian bolar exemption will have a clearer stance if these few points are inculcated in Indian jurisprudence of bolar exemption:

- Indian bolar provision has made it very clearly that bolar exemption is provided for any product. In India, the provision applies for pharmaceutical products as well as products like motor vehicles, aircrafts etc.

- If India wants a similar situation like that of Canada, then there needs to be an amendment in the Patents Act.

- Also, Indian Bolar exemption has not made it clear that who can use, construct, sell, and import the patented invention solely for purpose of development and submission. It remains to be seen whether India will take the German stance on the issue, i.e. including suppliers of patented invention apart from the generic company engaged in submission of information or taking the stance like that of Poland or Mexico, which refused to take suppliers/third parties within bolar exemption.

Conclusion

The decision pronounced by the Delhi High Court regarding the Bayer Vs. UOI case has expanded the reach of the bolar exemption by giving liberal interpretation to the word i.e. sale, and same is expected from the judiciary with regards to the above two points, i.e. striking a balance between public interest and patentees' rights. The judgment comes as a relief to innovation-based companies as the pre-conditions and obligations placed on generic companies deter them from exporting drugs covered by patents under the pretext of Section 107(A) and curb the spill-over effect in the foreign market.

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BEST STRATEGIES FOR PERFORMING PATENT SEARCHES IN INDIA

HEENA LAMBA

Those related to the fraternity of Intellectual Property Rights have witnessed many changes in the Indian Patent Office (IPO) system in the past decade. Clearly, it has become acclimatized with the changing technologies and has done a good work in making documents available for each application. This change has been quite evident in case of Patents and Trademarks, however a lot needs to be done for making the system transparent in terms of Designs. For Trademarks, confidentiality of important documents is being well maintained by the IPO.

Patent Searches: Patent searches in India are officially performed using the Indian Patent Advanced Search System (inPASS) which was introduced in the year 2015. It allows full-text search of all Indian Patents and Patent applications using Boolean operators (AND, OR and/or NOT). The fields in which the search can be performed in the database inPASS include title, abstract, complete specification, application number, applicant name, patent number, inventor name, IPC class, date of priority, priority country, date of filing and/or date of grant. Even though such an extensive searching system has been put in place by IPO, its reliability is still questionable owing to following reasons:

- Digitization of the abstract and complete specification by the IPO is erroneous at times.
- Digitization of non-English characters is erroneous most of the times.

In view of the above, technical searches like chemical compounds and formulae based searching is not possible using inPASS, which limits the usage of this extensive search system to basic search functions using specific search terms only with/without use of Boolean operators.

Patent searching software like Questel Orbit, PatSeer, Dennemeyer Octimine, AcclaimIP from Anaqua, DartsIP and many more also provide databases of Indian Patents and Patent Applications for more reliable and advanced searching. However, it would be pertinent to mention here that if such databases are compiled using inPASS information then reliability of that database also becomes questionable. Also, a common problem that is observed in using such software is that it is difficult to trace the applications having first and/or only filing in India. Since such applications do not have any Patent family nor do they take priority from any foreign application, such applications cannot be mapped using WIPO or USPTO or EPO database which is usually the source of information in such databases. On the contrary, if the patent applications have corresponding filing outside India then probability of coverage of such patent is usually high.

Based on our experience of using a few searching software, we can say that we have not come across any database which has full coverage of Indian Patents and Patent Applications. The same is also evident from the fact that the relevant searches

obtained on searching in inPASS are always higher than in any professional software.

IPC/CPC classification: The International Patent Classification (IPC) provides for a hierarchical system of language independent symbols for the classification of patents and utility models according to the different areas of technology to which they pertain[5]. IPC is used in more than 100 countries for classifying patent documents. As such it is a very powerful tool for searching patent related databases. You can carry out a search (or you can modify your term based search) using IPC symbols in almost all patent related databases especially US and JP. The Cooperative Patent Classification (CPC) is an extension of the IPC and is jointly managed by the EPO and the US Patent and Trademark Office. It is divided into nine sections, A-H and Y, which in turn are sub-divided into classes, sub-classes, groups and sub-groups. Using the CPC, you can carry out a high precision search in the EP and US Patent documentation in their Patent databases and also in the Japanese documentation using specific search terms[6].

In Indian Patent Office database inPASS, we have observed that at IPO classification of the subject matter of ordinary and international applications (PCT National Phase and Conventional) are done in two different formats first being continuous number format (i.e. C07C0231120000, C07C0209100000, C07C0253300000, C07C0221000000, C07H0015040000) and second being more recognizable format (A61K 31/047, A61K 9/48, A61P 15/00). In view of the said dissimilarity in classification formats search results obtained are not very reliable and therefore narrowing search results using IPC/CPC classification is not successful while searching for relevant patents in India[7].

Another issue observed while searching relevant Patents in Indian database inPASS is that Form 13 for intermediary amendments are not published and therefore it is difficult to capture such amendments via search portals. Our readers must be aware that Form 13 is filed at IPO for making amendments in the complete specification and/or claims in any Patent application that may or may not be accepted by the Controller at the time of grant. Such amendments may become necessary to be monitored by the competitors to know whether the technical knowledge of interest is now available in the public domain or not. Patent searching in India does not publish or digitize such amendments and therefore such information may not be readily available in searchable form. Additional search in relevant patent applications is required to be conducted to have this further information.

Keeping in mind the above drawbacks, we can conclude that even though there are many advanced patent databases available to search for relevant patent information in India but still to get the most precise results, additional efforts need to be made in the IPO searching database in PASS.

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5 International Patent Classification (IPC). Available at https://www.wipo.int/classifications/ipc/en/

6 International Patent Classification (IPC). Available at https://www.wipo.int/classifications/ipc/en/faq/

7 Indian Patent Office official Journals. Available at https://ipindia.gov.in/journal-patents.htm

COVID-19 VACCINE AT THE COST OF IP RIGHTS.

VIJAYLAXMI RATHORE

Where the rest of the world is awaiting a shot of vaccine to safeguard themselves against ongoing Covid-19 pandemic, developing countries like South Africa and India, on November 02, 2020, petitioned to the World Trade Organization (WTO) with proposed waiver to certain provisions of the TRIPS Agreement for the prevention, containment, and treatment of Covid-19 drugs, vaccines and diagnostic technologies. Further, the co-member countries like Kenya, Mozambique, Pakistan and Eswatini have extended their support and joined this petition.

The W.T.O., which oversees trade rules among its 164 member nations, is currently reviewing the series of questions cited in proposal whether such a broad waiver request is appropriate or not. The WTO at its Council for Trade-Related Aspects of Intellectual Property Rights (TRIPS) meeting considers that IP rights are one part of a broad discussion informing the availability and accessibility of treatments for COVID-19. Indeed, as the Doha Declaration on the TRIPS Agreement also called 'TRIPS flexibilities' has emphasized the context of access to medicines and medical technology through compulsory licenses or government use as a wider national and international effort to address public health problems.

Further, the co-sponsor countries like Australia, Canada, Chile and Mexico on November 27, 2020, have filed a communication titled "Questions on Intellectual-Property Challenges Experienced by Members in Relation to COVID-19". However, the co-sponsors reaffirm their support for the TRIPS Agreement, including the flexibilities on the TRIPS Agreement and Public Health. They also suggest the consideration of the proposed waiver and seek factual support to a series of questions which help them understand the possible significant IP barriers being confronted by WTO Members while addressing the pandemic. The communication also inquires as "what specific legal amendments or actions would the proponents seek to enact for the prevention, containment, and treatment of COVID-19 that are not – or may not be – consistent with the TRIPS Agreement and its flexibilities?"

While a number of countries are yet to respond to proposed waiver it's time to see whether the waiver will be receiving support or will be opposed by other WTO Members. Now to support the waiver, co-sponsor countries need to gather factual information that identify what challenges actually exist instead of being the very broad waiver proposal for all countries regardless of actual problems faced.

Vaccine development and competitive environment

The ongoing pandemic has boosted the research and development of vaccines and possible drug candidates and also the patenting process to protect the inventive process and innovative idea. According to the World Health Organization, there are more than 200 COVID-19 vaccine projects underway around the world. A quarter of those are in clinical trials, and several have already been approved for

emergency or limited use. In other words, this is or soon will be a competitive marketplace.

Whereas Pfizer/BioNTech has proved to be a winner for a short span, it seems to be quickly outpaced by other companies inclined to manufacture vaccines quickly and keep prices low in order to earn contracts. For example, the Pfizer/BioNTech vaccine has ultra-cold storage requirements that are expensive to comply with, while other companies like Moderna which are close to vaccine approvals have a well-established manufacturing, storage, and cold-chain facility. In order to rapidly meet global demand, there is a push for Pfizer and BioNTech to share their vaccine with the world, including a proposal by South Africa and India to have the World Trade Organization suspend patents covering their vaccine. But is this drastic measure actually necessary?

Is it fair to dilute patent rights?

It is unclear how waiver proposal for patent protections would guarantee a fair distribution of innovative medical products for COVID-19. But what is clear is that if successful, the effort would jeopardize future medical research and development.

But sadly, the pandemic is worsening day by day and requires urgent remedy to control it. So, before rejecting the proposal put forward by developing country, these developed countries should consider the fact that all IP agreements like Paris Convention, TRIPS, Doha declaration and most of the National/ domestic IP laws have provisions for diluting patents rights during pandemics and national emergencies.

Further, the increasing pressure from developing countries at the WTO should escalate the matters to government of developed countries to negotiate with their pharmaceutical companies for easy accessibility of low-cost drugs and vaccines worldwide.

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ROLE OF TRIPS AGREEMENT IN ECONOMIC DEVELOPMENT OF INDIA

PARUL SRIVASTAVA

TRIPS: Trade-Related Aspects of Intellectual Property Rights (TRIPS) is one of the most important agreements of WTO, an international agreement between all the member nations of the World Trade Organization (WTO). TRIPS came into force on January 01, 1995. It sets down the minimum standard for many forms of intellectual property regulations. Following areas of Intellectual Property are covered under the Agreement:

- Copyrights and Related rights
- Trademarks
- Geographical Indications
- Industrial Designs
- Patents (including protection of new variety of plants)
- Layout-designs of Integrated Circuits
- Undisclosed Information

Issues governed by the Agreement

TRIPS is the first agreement under WTO which requires member nations to establish relatively detailed norms within their respective legal frameworks, as well as to establish such measures of enforcement and such procedures which meet the minimum standards. The three important features of this agreement are:

Standards: TRIPS provides minimum standards for the protection of IPRs, where it describes the main elements of protection i.e., the subject matter which seeks protection, rights which are to be conferred and permissible exceptions to such rights, and also the minimum duration of protection.

Enforcement: Each member nation is required to enforce the agreement by providing domestic procedures and remedies with respect to protection of IPR. Further, the agreement lays down certain other provisions so that right holders can effectively enforce their rights.

Dispute Settlement: All the disputes arising between members of WTO with respect to the obligations arising out of the TRIPS Agreement are subject to WTO's dispute settlement procedures.

Indian context

In a world where 80% of patents are held by developed countries, TRIPS provides a sort of socio-economic balance for third world countries in general and India in particular when it comes to the field of IPR.

In 2020, India enjoys a fairly young population with around 65% of her people below the age of 35. This rich human resources pool already gives her an upper hand in the service sector as well as makes her a melting pot of new ventures and innovations. Additionally, the recent push from the current government for "Make in India" is only going to

enable more entrepreneurial mindset among the general populace, which in turn might lead to increased numbers of domestic patents for inventions and processes. Being a member of TRIPS would enable her to make sure proper IP protection is in place for these new patents. It has been a long held belief that strong IP protection is one of the benchmarks for robust economic development and once India starts this journey of self-reliance and independence, she would need all the help she can get.

On the other hand if India continues to operate in its comfort bubble and not aim for solutions to make herself technologically, economically and demographically independent, she might have to continue paying the cost of rights to first world nations for technologies patented and protected by them. A 2001 World Bank report suggested that in the short term TRIPS effectively constitutes an annual $20 billion transfer of wealth from technology-importing developing countries to technology-exporting developed countries (cited in Dutfield & Suthersanen, 2004). Critics of TRIPS claim that it is a "hypocratic" arrangement created just to benefit select few big corporations in the first world that pushed for its adoption at a global scale.

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OLFACTORY MARKS

KHUSHBOO TOMAR

Trademark, in simple words means a mark which is represented graphically and which is capable of being distinguished from the goods and services of others. Section 2(1)(zb) of the Trademark Act, 1999, defines Trademark "*a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colors*".

The main objective of adopting trademark is to distinguish the goods and services of one with that of another. It also helps the trademark owner to protect the goodwill of the business. Trademark on goods or services give assurance to the general public that goods or services so marked are equal quality-wise. In addition to the above distinct characteristics, manufacturers give smell or odour to their products which distinguishes their products with that of other and such smell or odour are being registered as trademark. Smell marks are often referred to as olfactory marks. Even though in India there is no clear provision for smell trademark but still registration of smell trademark comes within the preview of the definition of the Trademark given u/s 2(1)(zb).

For the registration of Smell mark, the World Intellectual Property Organization (**WIPO**) has clearly mentioned that the applicant should be able to visually represent the product's odour or smell and he should show how the smell or odour of his product is distinct and different from the products of others in products from a similar category. To visually represent the smell, the applicant should write a description of the smell in such a manner that such smell can't be confused with the smell of any other product. In order to register the smell for a product, such product should have unique scent. For the smell to be registered, such smell should not be arising out of the original nature of such product.

The Trademark Act, 1999, clearly mentions that a trademark means a mark which is capable of being graphically represented and which can distinguish the goods and services of one with that of others u/s 2(1)(zb) of the Act. Section 2(1)(m) of the Act defines mark as "*Mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colors or any combination thereof*". From the definition of the mark we can clearly interpret that smell has not been included in the definition. Now the question is whether the non-traditional trademark will be included as mark u/s 2(1)(m) of the Act. We can say that the Trademark Act, 1999, is quite similar to International Trademark Treaties and Conventions. Even though the non- traditional marks are not clearly mentioned but such mark are neither specifically excluded from the Act.

Conclusion

We can't deny that smell is an important sense for humans in their day to day activities. The olfactory sense helps us in identifying and differentiating the products around us. Various new techniques and methods are used to market the goods and smell is

used in inducing the public to buy such products. Marketers are associating certain unique smell to their products which help the consumers in differentiating the goods with that of competitors. Keeping this in mind, smell marks have gained popularity and there has been an increase in registration of smell mark in India. Even though the registration of smell mark is difficult as it can't be graphically represented but still if the applicant is able to visually represent the product's odour or smell and show how the smell or odour is distinct and different from the products of others it can be registered. Applicant should give a written description how the smell can't be confused with the smell of any other product clearly. In India, we don't have many smell marks registered but in coming times this mark is going to established as a viable trademark.

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