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Provisional Application for Patent and their Legal Impact

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ABSTRACT

Provisional applications for patents play a crucial role in the intellectual property landscape, offering inventors a streamlined pathway to secure priority and protection while refining their inventions. This paper explores the legal framework and practical implications of provisional patent applications, focusing on their purpose, requirements, and strategic advantages. By providing a temporary placeholder for inventions, provisional applications establish an early filing date, enabling inventors to further develop their ideas without forfeiting potential patent rights. This study examines the criteria for filing provisional applications, their impact on subsequent non-provisional filings, and the legal protections afforded during the provisional period. Moreover, it delves into the nuances of disclosure requirements and the strategic considerations for maximizing the benefits of provisional applications in safeguarding intellectual property. Through case studies and comparative analysis, this paper elucidates how provisional applications shape innovation strategies, mitigate risks, and enhance the overall patenting process within the framework of intellectual property law.

I. INTRODUCTION

A provisional patent application in India is an initial step in the patent filing process that allows inventors to secure a priority date for their invention while giving them time to refine their invention or gather additional data before filing a complete specification. Under the Indian Patent Act of 1970, the concept of a provisional application was introduced to provide a cost-effective and simplified method for inventors to establish an early filing date, which is crucial in the patenting process given the "first to file" principle. A provisional patent application is a preliminary application that does not require a full description of the invention. It serves as a placeholder that allows the inventor to claim the priority date from the filing of the provisional application. This date is critical because it establishes the inventor's rights against subsequent applications for the same invention by others. The primary purpose of a provisional patent application is to provide inventors with an opportunity to secure their invention's priority while

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deferring some of the costs and formalities associated with filing a complete specification.

II. LEGAL FRAMEWORK UNDER THE INDIAN PATENT ACT, 1970: PROVISIONAL PATENT APPLICATIONS

The Indian Patent Act, 1970, provides a comprehensive legal framework for the protection of inventions through the patenting process, including the filing of provisional patent applications. Provisional applications serve as a preliminary step that allows inventors to secure an early filing date while deferring the detailed requirements of a complete specification.

- Relevant Sections and Provisions

Section 9: Provisional and Complete Specifications

Section 9 of the Indian Patent Act, 1970, is the primary provision governing provisional patent applications. It allows an applicant to file a provisional specification to establish a priority date and then follow it up with a complete specification within 12 months. The section outlines that the complete specification must be filed within 12 months from the date of filing the provisional application, failing which the application is deemed to be abandoned.

- Key Requirements for Filing a Provisional Patent Application

Description of the Invention: The provisional application must include a description of the invention, providing enough detail to demonstrate the nature and purpose of the invention. Unlike a complete specification, the provisional specification does not require detailed claims.

Forms and Fees: The application must be submitted using the prescribed forms along with the requisite filing fees. Fees may vary depending on the type of applicant (individual, small entity, or large entity).

Priority Date: The date of filing the provisional application is considered the priority date. This priority date is crucial as it determines the precedence of the invention over others that may be filed subsequently.

Conversion to Complete Specification: The applicant must file a complete specification within 12 months from the filing date of the provisional application. The complete specification must include a full description of the invention, claims defining the scope of the invention, drawings (if necessary), and an abstract.

- Procedural Steps

Preparation of Documents: Draft a provisional specification that includes the title, description of the invention, and any necessary drawings. Prepare the necessary forms (Form 1 for

application and Form 2 for provisional specification) and calculate the applicable fees.

Filing the Application: Submit the provisional application along with the forms and fees to the Indian Patent Office. Upon submission, the Patent Office provides an acknowledgment with the filing date, which is the priority date.

Follow-up with Complete Specification: Draft and file the complete specification within 12 months of the provisional application filing date. The complete specification must fulfill all requirements, including detailed claims and a comprehensive description.

- Rights and Legal Implications

Securing Priority Date: The priority date established by the provisional application provides a legal basis for the invention's novelty, protecting it from being preempted by subsequent applications.

Temporary Protection: While the provisional application itself does not grant enforceable rights, it serves as a critical step in securing future patent rights. Upon filing the complete specification, the application can proceed to examination and eventual grant of a patent, which confers exclusive rights to the inventor.

Abandonment and Consequences: If the complete specification is not filed within the 12-month period, the provisional application is deemed abandoned. Abandonment means the inventor loses the priority date and must restart the process if they wish to pursue patent protection.

- Strategic Considerations

Cost-Effective Entry: Provisional applications are less costly and procedurally simpler than complete specifications, providing an affordable option for initial patent filing.

Time for Refinement: The 12-month period allows inventors to refine their inventions and gather additional data before committing to the detailed requirements of a complete specification.

Market Assessment: Inventors can use the provisional application period to assess the commercial viability of their invention and seek funding or partnerships.

Filing Process and Requirements

1. Provisional Patent Application:

- Purpose: Establish an early filing date and allow the inventor to secure a priority date while refining the invention and preparing the complete specification.

- Validity: The provisional application is valid for 12 months from the date of filing, within which a complete specification must be filed.

2. Preparing Provisional Patent Application

Components of a Provisional Patent Application:

- Form 1: Application for the grant of a patent.
- Form 2: Provisional specification (including title, description, and drawings, if necessary).
- Form 5: Declaration as to inventorship.
- Form 26: Power of authority (if filed through a patent agent).
- Form 3: Statement and undertaking under Section 8 (disclosure of foreign applications, if any).
- Priority Document: If claiming priority from an earlier application (if applicable).

3. Steps to Prepare:

- Title of Invention: Provide a clear and concise title.
- Provisional Specification: This should include:
 - Title: The title of the invention.
 - Description: A brief description of the invention and its field.
 - Drawings: If applicable, include drawings or sketches to illustrate the invention.

4. Filing the Application

- Documents Preparation: Ensure all the required forms (Form 1, Form 2, Form 5, Form 26, and Form 3) are correctly filled out.
- Fee Payment: Pay the prescribed filing fee. Fees vary based on the type of applicant (individual, startup, small entity, or others).

5. Submission:

- Online Filing: Via the Indian Patent Office's e-filing system.
- Physical Filing: Submission at the appropriate patent office branch (Kolkata, Mumbai, Delhi, or Chennai).

6. Online Submission:

- Register: Create an account on the Indian Patent Office's e-filing portal.
 - Login: Access your account and select the option to file a provisional application.
 - Upload Documents: Follow the prompts to upload the prepared documents (Forms 1, 2, 5, 26, and 3).
7. Fees: Complete the payment process online.
- Acknowledgment: After submission, you will receive an acknowledgment receipt and an application number.
8. Post-Filing
- One-Year Deadline: You must file the complete specification within 12 months of the provisional application filing date.
 - Patent Pending: You can mark your product as "Patent Pending" during this period.
 - Develop and Refine: Use the 12 months to further develop the invention and gather necessary data for the complete specification.
9. Additional Tips
- Thorough Description: Ensure that the provisional specification is detailed enough to describe the invention properly.
 - Professional Help: Consider consulting with a patent attorney or agent to ensure your application is well-prepared and comprehensive.
 - Keep Records: Maintain detailed records of the invention development process, including laboratory notebooks, sketches, and prototypes.

III. STRATEGIC ADVANTAGES OF PROVISIONAL PATENT APPLICATION IN INDIA

1. Low Upfront Cost:

Filing a provisional patent application is significantly cheaper than filing a full patent application. This cost-effectiveness allows inventors to secure a priority date without a substantial financial commitment initially.

2. Ability to Use "Patent Pending":

Upon filing a provisional patent application, you gain the legal right to label your invention as "Patent Pending." This designation, while not a full patent, indicates that you have initiated the patent process, providing a measure of protection and credibility when marketing or disclosing your product prototypes.

3. Time to Let Your Invention Evolve:

Filing a full patent application at an early stage might prevent you from fully developing your invention. A provisional patent secures your priority date, giving you up to 12 months to refine your invention. This period allows you to enhance your invention's potential while maintaining the original filing date for priority purposes, as long as the scope remains consistent.

4. Opportunity to Test Commercial Potential:

With a provisional application filed, you can explore the commercial viability of your invention without rushing into a full patent application. This time can be used to:

- Gauge the interest of businesses in licensing your invention once it's patented.
- Assess the commercial value and feasibility of your invention.
- Further develop your invention to maximize its potential.
- Conduct thorough market research to confirm its marketability.

This 12-month window allows for extensive evaluation and strategic planning without compromising confidentiality or protection.

5. Option to Abandon Without Major Financial Loss:

If you discover that your invention is not commercially viable or does not attract interest from potential buyers or licensees, you can choose to abandon the provisional patent application. This decision can save you significant amounts of money that would otherwise be spent on pursuing a full patent application, which might not be justifiable if the invention proves unworthy of further investment.

6. Potential for Patent Granting by Following Procedure:

A provisional patent can eventually lead to a granted patent if you file a complete patent application within 12 months from the provisional filing date and adhere to the entire patent process. Most countries recognize the provisional application's filing date as the priority date, which is crucial for determining the novelty and prior art status of your invention. This earlier priority date can be advantageous in the patent examination process.

How a Provisional Application Can Save Costs in Obtaining a Patent in India

In the typical life cycle of a patent owner, the most preferred way to get a return on investment (ROI) from patents is by licensing them to other businesses. Success in licensing your patent (also known as patent commercialization) depends on how effectively you communicate with decision-makers and highlight the advantages and potential profits of licensing rights to your

patented invention.

However, you don't always need to go through the full patent procedure to determine if there is interest in licensing your patented invention. Instead of filing a complete patent application, you can opt to file a provisional patent application. Once filed, you secure the priority date or filing date for the patent.

With the "Patent Pending" status from the provisional application, you can proceed with almost 90 to 95% of your intended activities without fear of your invention being stolen or losing its novelty. This includes:

- Reaching out to interested businesses to assess its commercial value and identify potential licensing partners.
- Starting to commercially sell your invention.
- Contacting investors, bankers, forming partnerships, establishing supply chains, and engaging with manufacturers.
- Selling the provisional patent application to interested businesses.

The only thing you need to wait for is the grant of the patent if you want to stop others from copying your invention or to file a suit against infringement of your patented invention. This is the only aspect that requires waiting until the patent is granted.

IV. LEGAL PROVISIONS AND REMEDIES PROVIDED TO THE PERSON FILING FOR PATENT APPLICATION

Sections Dealing with Rights of a Patentee:

Section 6: Defines who can apply to become a patentee. Eligible applicants include the true and first inventor, their assignee, legal representative upon death, or a joint inventor.

Section 8: Allows foreign applicants to apply for patent rights in India. Applicants must keep the controller updated on the status of the patent application in India and any related applications filed abroad.

Section 43: Grants a patent if the application meets all requirements and is not refused by the controller. The term "expeditiously" is used but is not clearly defined in terms of time frame.

Section 44: Permits the continuation of a patent even if the patentee (person or corporate body) dies or ceases to exist, at the controller's discretion.

Section 46: States that the Patents Act of 1970 applies throughout India, including areas with special circumstances like Jammu and Kashmir.

Section 48: Details the rights of a patentee against third-party use of their patented product or process. This includes preventing unauthorized making, using, selling, or importing the patented invention.

Section 49: Discusses infringement of patent rights, particularly in cases where foreign vessels, aircraft, or vehicles temporarily enter Indian territory. Infringement does not occur if the use of the patent was necessary on board. Reciprocity in foreign countries is required to avoid infringement claims.

Section 50: Deals with co-ownership of patents. Co-owners have equal and undivided shares unless otherwise contracted. Co-owners can individually exploit the patent for profit but cannot grant licenses or ownership interests to third parties without consent from all co-owners.

Section 53: Establishes a 20-year term for a patent, promoting further development and innovation within that period.

Section 54: Allows a patentee to file for a "patent of addition" for improvements or modifications to an existing patent. The same applicant must file both the main and additional patents, and the filing dates must be the same or later for the additional patent.

Section 60: Provides a remedy for restoring a lapsed patent, typically due to non-payment of fees or failure to meet conditions, once the deficiencies are corrected.

Section 62: Ensure full rights are reinstated to the patentee upon restoration of the patent.

Section 63: Allows the patentee to surrender the patent. The controller oversees the surrender process, publishing and notifying other applicants or third parties interested in the patent.

Sections Related to Inventions That Cannot Be Patented:

Section 3: Lists inventions that cannot be patented in India. This includes certain categories like frivolous or immoral inventions, discoveries of scientific principles, methods of agriculture, and others.

Section 4: Prohibits the patenting of inventions related to atomic energy.

The Patents (Amendment) Act of 2005 expanded the scope of patentable inventions, including methods or processes of manufacture, which were previously excluded. The amendments also aimed to clarify and add flexibility in interpreting what constitutes a patentable invention, thereby fostering a more innovation-friendly environment in India.

Infringement of Patents:

- 1- Direct infringement: It is the most common and obvious form of patent infringement. It occurs when a third party, without the permission of the patent holder, uses, reproduces, imports, sells, or offers to sell a patented invention. This can happen either intentionally or unintentionally during the patent term. For example, Samsung using Apple's patented phone manufacturing process without permission constitutes direct infringement. The key requirement is performing a substantially similar function as the patented product without a legal license from the owner.
- 2- Literal infringement: It is a type of direct infringement where every element of the patented invention is exactly copied. In the case of *Polaroid Corp. vs. Eastman Kodak Co (1986)*³, Polaroid claimed Kodak violated its patents related to instant photography. The court ruled in favor of Polaroid, determining Kodak had infringed upon Polaroid's patents, resulting in a substantial damages award and an order for Kodak to stop producing and selling its instant photography system.
- 3- Non-literal infringement: It is also known as the Doctrine of Equivalence, occurs when an invention is similar to the patented invention, performing the same function in the same way to produce the same result, despite differences in name, shape, or form. In *Ravi Kamal Bali vs. Kala Tech. & Ors (2008)*⁴, the court ruled in favor of the plaintiff, applying the Doctrine of Equivalence, because the defendant's product performed the same function and was made from the same material as the plaintiff's patented tamper lock, with only slight differences in construction.
- 4- Indirect infringement: It involves third parties supporting, contributing to, or promoting direct infringement, either accidentally or knowingly. Induced infringement involves willfully aiding the infringing process, such as by assisting in manufacturing the product, assembling the patented product without a license, providing production instructions, printing instructions of patented items, or licensing plans or processes.
- 5- Contributory infringement: It is a type of indirect infringement where the infringer sells or supplies parts specifically designed to manufacture the patented product, even if they do not directly participate in the manufacturing process.
- 6- Willful infringement: It occurs when someone knowingly disregards the patent, and the burden of proof lies on the patent holder. The infringer can defend themselves by demonstrating a good faith belief that they would not be liable, which must be

³ <https://lawbhoomi.com/infringement-of-patents-and-remedies-for-infringement-of-patents/#Jurisdiction>

⁴ <https://lawbhoomi.com/infringement-of-patents-and-remedies-for-infringement-of-patents/#Jurisdiction>

reasonable. If willful infringement is proven, the court can impose significant penalties, including up to three to four times the actual damages, as well as court costs and lawyer's fees.

V. REMEDIES AVAILABLE AGAINST PATENT INFRINGEMENT CASES

Section 108(1) of the Patents Act provides for the remedies to the plaintiff in case his patent rights have been infringed. In any suit for infringement, the court may grant reliefs such as injunction and at the option of plaintiff, either damages or an account of profits:

An injunction is a court order that requires the infringing party to stop making, using, selling, or importing the infringing product. It aims to preserve the value of the patent and prevent further harm to the patent holder. To obtain an injunction, the patent holder must prove that their patent is valid, and that the defendant has infringed upon it. There are three kinds of injunctions:

1. **Temporary/Interlocutory Injunction:** This type of injunction is limited to a specific period or until the case is finally decided on its merits. It aims to mitigate the risk of injustice to the plaintiff during the period before the court resolves the uncertainty. The purpose is to protect the plaintiff against injury from the violation of their rights, which could not be adequately compensated by damages. An interlocutory injunction is issued at the initial stages of the suit to prevent the defendant from gaining further profits from the alleged infringement. The patentee must prove the validity of the patent and the occurrence of infringement, demonstrating that this infringement has caused them irreparable harm.

2. **Permanent Injunction:** A permanent injunction is granted when the court finally decides the case on its merits. If the defendant is found guilty of infringing the patent, the interim injunction is converted into a permanent injunction. However, if the defendant is found innocent, the interim injunction is dissolved. This type of injunction remains in effect for the duration of the patent.

3. **Ex Parte Interim Injunction:** This is granted without notifying the defendant, typically in urgent situations. Trial courts may consider several guidelines before granting such an injunction:

- The plaintiff and defendant reside outside the state, and their identities and addresses are easily verified.
- The sales of the infringed products are not on a commercial scale.
- The interim injunction will lead to the closure of the defendant's business.

- Careful scrutiny of certificates and infringing marks is necessary in patent/trademark disputes.
- No ex parte interim injunction can be granted without evidence of infringement.

Damages or Account of Profits

The owner of a patent is entitled to either damages or an account of profits. They may obtain damages for losses caused by the defendant's infringing activities or an account of profits gained by the infringer, but not both. When drafting a claim, the plaintiff typically requests these remedies as alternatives. This remedy is granted in addition to an injunction.

Damages: Compensation for the losses suffered due to the infringement.

Account of Profits: The infringer must account for and surrender the profits made from the patented invention.

In the case of *Ravi Raj Gupta v. Acme Glass Mosaic Industries*⁵, the court held that the patent in question was not an invention as defined under Section 2(j) of the Patents Act, 1970. Therefore, the plaintiff was not entitled to an ad interim injunction. However, to protect the plaintiff's interests if they ultimately succeeded, the defendant was ordered to maintain a complete and accurate account of the manufacture and sale of the infringing goods.

Seizure or Forfeiture of Infringing Goods:

Apart from other reliefs, the court may order that the infringing goods and materials predominantly used in their creation be seized, forfeited, or destroyed. This action is taken without any compensation to the infringer, as deemed fit by the court under the circumstances of the case.

VI. CASE LAWS

BAJAJ Auto Limited Vs. TVS Motor Company Limited JT 2009 (12) SC 103⁶

Facts:

BAJAJ Auto Limited (Plaintiff) owned a patent for Digital Twin Spark Ignition (DTSi) technology, granted in 2005 after filing in 2002. In 2007, the Plaintiff sued TVS Motor Company (Defendant) in the Madras High Court for patent infringement and sought a permanent injunction under Section 108 of the Patents Act. Alongside, the Plaintiff requested a temporary injunction while the permanent injunction case was pending. Concurrently, the

⁵ <https://lawbhoomi.com/infringement-of-patents-and-remedies-for-infringement-of-patents/#Jurisdiction>

⁶ <https://www.ourlegalworld.com/bajaj-auto-ltd-vs-t-v-s-motor-company-ltd-jt-2009-12-sc-103/>

Defendant filed a suit under Section 106, asserting that their improvements and changes to the patented technology nullified the infringement claim. The Madras High Court initially granted a temporary injunction to the Plaintiff, restricting the Defendant from taking new orders for vehicles using the contested technology but allowing the execution of pending orders. This injunction was later vacated following a plea from the Defendant, prompting the Plaintiff to appeal to the Supreme Court of India (SC).

Appeal to the Supreme Court:

The Supreme Court did not assess the merits of the case but focused on the prolonged duration of the legal proceedings, which had taken about two years over a temporary injunction. The SC dismissed the appeal, emphasizing that intellectual property rights (IPR) infringement cases must be resolved swiftly, particularly regarding injunction decisions. The SC instructed the Madras High Court to hear the case daily and conclude it by November 30, 2009.

Final Judgment for the Patent Infringement:

The Madras High Court ultimately ruled in favor of the Plaintiff, affirming that BAJAJ Auto Limited held the patent for the DTSi technology and had been using it for five years. The court applied the Doctrine of Equivalence, stating that for determining novel features as "pith and marrow," a purposive construction is necessary. This ensures that any variant would fall outside the monopoly even if it did not materially affect the invention's operation.

Novartis vs. Cipla, 2015⁷

Facts

In 2015, Novartis (Plaintiff) sued Cipla (Defendant) for infringing patents related to Onbrez (Indacaterol), a drug for chronic obstructive pulmonary disease, and sought damages. Novartis held five patents in India covering the drug's product composition and process. In 2014, Cipla launched a generic version of Onbrez and petitioned to revoke Novartis' patents, arguing that the disease had reached an "epidemic" stage and Novartis' monopoly restricted drug access. Cipla requested the Central Government to revoke the patents under Section 92(3) and Section 66 of the Patents Act, claiming Novartis was not manufacturing the drug locally and only importing limited quantities through a licensee. Novartis then filed a patent infringement suit in the Delhi High Court.

Court Decision

The Delhi High Court granted a temporary injunction in favor of Novartis, preventing Cipla

⁷ <https://indiankanoon.org/doc/68879740/>

from making or selling a generic version of Onbrez. The court determined that Novartis had a strong prima facie case, and that the validity of the patent was not seriously challenged. Additionally, Cipla's claims of drug shortages and inadequacy were not substantiated with proof. In 2017, Cipla's appeal against this decision was dismissed on similar grounds, focusing on the sufficiency of the drug's importation to meet Indian demand.

The Delhi Network of Positive People vs Union Of India & Ors on 7 May, 2015⁸

Facts:

The petitioner has filed a Public Interest Litigation (PIL) under Article 226 to protect the rights of people living with HIV/AIDS. The petition highlights that in the mid-1990s, a combination of three anti-retroviral (ARV) medicines was found to effectively treat HIV, but these medicines were patented and sold at high prices, making them inaccessible to many in developing countries. In 2001, Indian generic companies began producing these medicines at much lower costs, significantly reducing prices and increasing access to treatment. In response, pharmaceutical companies filed multiple patent applications for the same medicines to maintain high prices and restrict access. The petitioner has been opposing these patent applications to keep ARVs affordable.

The petition also addresses the issue of pharmaceutical companies filing divisional patent applications based on earlier ones to keep the applications pending and create uncertainty over patent status. Section 16(1) of the Patents Act allows for divisional applications if the original application covers more than one invention, but Section 10(5) requires that a patent application should only cover a single invention or inventive concept. The petitioner argues that companies misuse Section 16 to keep their applications alive after the parent applications face objections, resulting in abandonment of the parent application while keeping the divisional application active. This forces the petitioner to file multiple pre-grant oppositions, leading to a burden on the Patent Office and wasted resources. Despite representations and rule amendments, the issue persists, and the petitioner seeks to stop the misuse of divisional patent applications to ensure ARV medicines remain affordable and accessible.

Issues:

1-whether the court can legislate or direct legislative action under Article 226 of the Constitution of India?

2-Whether the court can issue directives to statutory authorities under the Patents Act to act

⁸ <https://indiankanoon.org/doc/101191201/>

contrary to the procedures laid down by the Act and its rules?

Judgment:

The petitioner has filed a rejoinder reiterating its case, and the senior counsel for the petitioner has been heard. However, the court emphasized that it cannot legislate or direct the legislature to enact laws, as this power lies solely with the Central Government under Section 159 of the Patents Act. While Section 158 allows High Courts to make rules, this is limited to the conduct and procedure of proceedings before the court and does not extend to the Patent Office.

The Supreme Court in *V.K. Naswa Vs. Home Secretary, Union of India* (2012) 2 SCC 542, reiterated that courts cannot legislate or direct the executive to enact laws. Courts cannot supervise or direct the rule-making powers of the executive. This principle was followed in *Mool Chand Kucheria Vs. Union of India* and *P.N. Kohli Vs. Union of India*. Similarly, statutory authorities under the Patents Act cannot be directed to act contrary to the Act and its rules, as held in *Intellectual Property Attorneys Association Vs. Union of India*.

Moreover, the petition lacks specific instances of abuse of Section 16, as the patent applicants involved were not made parties to the petition. The court cannot address issues in a vacuum without a cause of action, as highlighted in *Federation of Indian Mineral Industries Vs. Union of India*. While PILs have relaxed this rule to some extent, the court cannot deal with statutory provisions or rules without a concrete cause of action. Therefore, the court cannot grant the petitioner's requests.

Boehringer Ingelheim International ... vs The Controller Of Patents & Anr. on 12 July, 2022⁹

Facts:

The background of this case involves a patent application filed by the Applicant in 2008 under the National Phase PCT Application for 'Use of DPP IV Inhibitors'. The application originally contained 18 claims, including Claims 15 and 15A. After receiving a First Examination Report in March 2014, the Applicant made amendments in October 2014, focusing on Claims 14, 15, and 15A. These amendments were aimed at addressing objections related to novelty and inventive step.

In August 2017, a hearing was conducted to discuss these amendments. However, before a final decision was made in January 2018, the Applicant attempted to file a divisional application in September 2017, based on the claims that were later rejected in the parent

⁹ <https://indiankanoon.org/doc/164938320/>

application. The Controller of Patents rejected both the amendments and the parent application in January 2018 under Section 15 of the Patents Act, determining that the amended claims exceeded the scope of the original claims.

Following this rejection, a divisional application related to these claims was also under consideration. In March 2022, after issuing a First Examination Report and considering a pre-grant opposition, the Controller refused the divisional application. The Controller's decision was based on the fact that the claims in the divisional application were identical to those previously examined and rejected in the parent application. This decision highlighted concerns about the repetition of claims and the failure to meet the requirements under Sections 57 and 59 of the Patents Act.

Issues:

1. Whether the divisional application, filed after the rejection of amendments in the parent application, legitimately encompasses claims that were previously considered and refused. Does the Patents Act, 1970, allow for such divisional applications when the claims are similar to those already examined and rejected?
2. Whether the Amended Claims Meet the Criteria of Novelty and Inventive Step? Does the Controller's determination that these claims lack novelty and inventive step, based on cited prior art documents, adhere to the legal standards under Sections 2(1)(j) and 2(1)(ja) of the Patents Act, 1970?

Judgment:

The appeal contested the rejection of a divisional application stemming from a parent application focused solely on the use of DPP IV inhibitors, without any claims pertaining to their formulation as medicaments. Despite attempts to amend and include product claims, these were deemed beyond the original scope and not permissible under Section 16 of the patent law, which requires a clear demonstration of multiple inventions within the parent application's claims. The court emphasized that for a divisional application to be valid, there must be a "plurality of inventions" disclosed in the parent's claims, which was absent in this case. Consequently, the refusal upheld the principle that what is not explicitly claimed in the parent application cannot be pursued through a divisional application, ensuring adherence to the foundational rule in patent law that claims dictate the scope of protection.

In summary, the divisional application was denied because the parent application exclusively outlined the use of DPP IV inhibitors, lacking any claims related to their composition as medicaments. Efforts to introduce new product claims through amendments were rejected for

exceeding the original scope. The court's decision underscored that a divisional application can only be justified when the parent application encompasses multiple inventions within its defined claims, which was not satisfied here. This ruling reinforces the fundamental principle that inventions must be explicitly claimed to be protected, preventing the expansion of patent rights beyond what was originally disclosed and claimed.

VII. TRANSITION OF CONVERTING PROVISIONAL APPLICATION INTO COMPLETE SPECIFICATION

Section 9 of the Patent Act

Provisional and Complete Specifications

Provisional and complete specifications are fundamental concepts in patent law. This system, which is well-recognized internationally, helps establish the priority of a patent application. Section 9 of the Indian Patent Act, 1970, outlines various scenarios for filing a complete specification following the submission of a provisional specification.

Section 9(1): Filing Timelines

- If you file a provisional patent application, you must submit a complete specification within 12 months.
- If you don't file the complete specification in time, your application will be considered abandoned.

Section 9(2): Combining Provisional Applications

- If you have multiple related provisional applications, the Controller can let you file a single complete specification for all of them.
- The 12-month deadline for filing the complete specification is based on the date of your earliest provisional application.

Section 9(3): Converting Complete to Provisional

- You can convert a complete specification to a provisional one if you request this within 12 months of the initial filing.
- Once converted, you still need to file a complete specification within 12 months from the original filing date.

Section 9(4): Postdating Provisional Applications

- If you have both a provisional and a complete specification, you can ask to cancel the

provisional one and change the filing date to the date of the complete specification.

- This extends the patent term but risks encountering new prior art published in the interim.

Eligibility and Requirements for Provisional Patents:

Determining eligibility for a provisional patent is crucial in the patent process. Not all inventions qualify for this initial protection. Key factors include:

- Novelty: The invention must be new and not previously disclosed to the public.
- Inventiveness: The invention must involve an inventive step and not be obvious to experts in the field.
- Utility: The invention must have practical use and provide a tangible benefit.
- Scope of Patent Laws: The invention must fall within patentable subject matter, such as products, processes, machines, or compositions of matter.
- Detailed Specification: The provisional specification must provide enough detail for someone skilled in the field to replicate the invention.
- Proper Inventorship: The application must correctly list all inventors who contributed to the invention.
- Timely Filing: The application must be filed within one year of any public disclosure of the invention.

Documents Required for Provisional Patent Application:

Essential documents and components for filing a provisional patent include:

Forms Required:

- Form 1: Application form.
- Form 2: Provisional specification form.
- Form 5: Declaration by the inventor.
- Form 26: Power of attorney for the patent attorney/agent.
- Form 3: For foreign applicants only.
- Government filing fee.

Contents of the Provisional Specification:

- Title of the Invention: A concise title.
- Area or Field of Invention: Description of the technological field.

- Background & Prior Art: Explanation of existing technologies and how the invention differs.
- Economic Advantages: Commercial value and benefits.
- Statement of Invention: Key innovative features.
- Summary of Invention: Overview of key aspects.
- Brief Description of Drawings (Optional).
- Detailed Description with Drawings/Examples (Optional).
- Claims: Included with the complete specification.
- Abstract: Brief overview of the technical field, problems addressed, and solutions offered.

VIII. IMPACT ON INNOVATION AND BUSINESS STRATEGY IN INDIA

In India, the provisional patent application significantly impacts innovation by encouraging early-stage creativity and development. The lower cost and simplified process of filing a provisional patent make it accessible to startups and individual inventors, who might otherwise be deterred by the complexities and expenses associated with full patent applications. This accessibility leads to increased filings, fostering a culture where innovators feel empowered to protect their ideas early on. The 12-month period allowed for filing a complete specification enables inventors to refine and enhance their inventions, promoting continuous improvement and potentially leading to breakthrough innovations. By securing an early filing date, provisional patents provide a crucial advantage in fast-moving industries, ensuring that innovators can protect their ideas against competitors.

From a business strategy perspective, provisional patents offer several strategic benefits. They allow companies to test the commercial viability of their inventions while retaining some protection, which is crucial for attracting investors and forming strategic partnerships. This provisional period serves as a tangible asset that demonstrates ongoing innovation, aiding in securing funding and fostering business growth. Companies can leverage the early filing date to establish a competitive edge, positioning themselves as leaders in their respective fields. Additionally, by using provisional patents to build a comprehensive patent portfolio, businesses can deter competitors and enhance their market standing, ensuring long-term success and market dominance.

The flexibility provided by provisional patents is particularly beneficial for operational strategy. Businesses can use the provisional period for iterative development, responding to

market feedback and technical advancements before committing to a full patent application. This approach allows for better financial management, as companies can defer the higher costs associated with full patents and allocate resources to other critical areas such as product development and marketing. In terms of legal and regulatory compliance, aligning provisional patent filings with a broader intellectual property strategy ensures that businesses are well-prepared for future challenges, enhancing their ability to manage and protect their intellectual property rights effectively.

In the Indian context, provisional patents are especially significant for startups and small and medium enterprises (SMEs). Initiatives like the Startup India program provide support and benefits for patent filing, making provisional patents an attractive option for new and small businesses. This support helps build a robust domestic innovation ecosystem, reducing reliance on foreign technology and boosting local innovation. Additionally, provisional patents enable Indian companies to quickly adapt and innovate based on local market needs, enhancing their competitiveness against multinational corporations. Protecting early-stage innovations also increases the export potential of Indian technologies, opening new markets and opportunities for growth.

However, challenges remain, such as the need for greater awareness and education about the benefits and processes of filing provisional patents among Indian innovators and businesses. Access to legal expertise and support is crucial to navigate the complexities of patent laws and maximize the benefits of provisional patents. Overall, the impact of provisional patent applications on innovation and business strategy in India is profound, providing a foundation for growth, competitiveness, and sustained technological advancement.

IX. COMMON PITFALLS AND CHALLENGES

Filing a provisional patent application in India, while advantageous, comes with several common pitfalls that inventors and businesses must be aware of. One significant pitfall is the issue of insufficient disclosure. A provisional patent application must provide a complete and detailed description of the invention to support a subsequent non-provisional application. However, many applicants fall into the trap of providing vague or incomplete specifications, which can undermine the application's value and leave the invention inadequately protected. Another common mistake is failing to follow up with a complete application within the 12-month window. If the follow-up application is not filed in time, the provisional application lapses, and the priority date is lost, which can be detrimental in a competitive field.

Misunderstanding legal requirements is another frequent pitfall. Errors in the filing process,

such as using incorrect forms or missing deadlines, can invalidate the provisional application. Additionally, failing to comply with the specific requirements set by the Indian Patent Office, like those regarding drawings and claims, can create complications. Overestimating the protection offered by a provisional application is also a common mistake. A provisional application does not grant patent rights but merely establishes a priority date. Some inventors mistakenly believe they have legal protection against infringement at this stage, which is only achieved once a patent is granted.

Strategic planning is crucial when filing a provisional patent, but many inventors and businesses fall short in this area. Filing without thorough market research can result in protecting an invention that lacks commercial viability. Moreover, failing to align the patent strategy with the overall business strategy can lead to wasted resources and missed opportunities, affecting the innovation's success and market potential.

Navigating the patent system in India presents its own set of challenges. The process can be complex and bureaucratic, requiring detailed knowledge of procedures and regulations, which can be daunting for individual inventors and small businesses. Transitioning from a provisional to a non-provisional patent demands significant time and financial resources, adding to the challenge. Ensuring comprehensive coverage is another hurdle. Defining the invention's scope adequately in the provisional application is critical for effective patent protection. Accurate and legally sound technical descriptions are essential but can be difficult to achieve without expert assistance.

Access to legal and technical expertise is often limited for many inventors and small businesses, compromising the quality of the application. Hiring experienced professionals, such as patent attorneys, can be expensive, further adding to the financial burden. Maintaining confidentiality during the application process is also challenging. Although provisional applications are not published, the disclosure required for filing must be managed carefully to avoid compromising the invention's confidentiality before securing full protection. Additionally, the subsequent full application will be published, potentially exposing sensitive information.

Market and competitive dynamics present additional challenges. In rapidly evolving industries, the 12-month period provided by a provisional application might not be sufficient to fully develop and protect an invention before competitors introduce similar technologies. Coordinating the provisional application with foreign filings adds complexity due to varying international patent laws and timelines. Despite these challenges, with adequate preparation, understanding of legal requirements, strategic alignment, and access to professional expertise,

inventors and businesses can maximize the benefits of provisional patent applications and avoid common pitfalls.

X. COMPARATIVE ANALYSIS

Provisional patent applications (PPAs) offer a strategic advantage in securing an early priority date and deferring the complexities of a full patent application. Comparing the PPA systems of India with other countries, such as the United States, Australia, and the United Kingdom, reveals notable differences in process, costs, and strategic implications. In India, PPAs are relatively inexpensive and accessible, encouraging early-stage innovation, particularly among startups and small businesses. The Indian Patent Office allows a 12-month window to file a complete specification, similar to other jurisdictions, but the procedural requirements are less stringent, requiring a detailed description but no formal claims.

In contrast, the United States also offers a PPA system that is highly utilized by both startups and large corporations. While filing costs are higher, the USPTO's robust e-filing system and strategic value in securing investor interest make it a popular choice. The US system places a significant emphasis on a thorough description to ensure the provisional filing supports a future non-provisional application. Similarly, Australia's PPA system is designed to be user-friendly, with relatively low costs and straightforward filing requirements, but like the US, it demands a comprehensive description of the invention.

The United Kingdom offers another perspective, where PPAs are not formally recognized. Instead, the UK Intellectual Property Office encourages filing a complete application with the possibility of making amendments later. This approach ensures early protection but requires more initial investment in preparing a comprehensive application. Across these countries, the strategic use of PPAs varies, with India and Australia providing more cost-effective and accessible options for early-stage inventors, while the US and UK systems, though more expensive, offer robust frameworks that are integral to broader, often international, patent strategies. Each system reflects its respective innovation landscape, balancing accessibility, cost, and strategic utility in fostering technological advancement.

Insights from international practices of provincial patent application and their relevance to India-

Insights from international practices of provisional patent applications (PPAs) highlight several key aspects that could enhance the Indian patent landscape. Countries like the United States and Australia emphasize the importance of a comprehensive description in the provisional filing, ensuring robust support for future non-provisional applications. This practice could be

beneficial for India by encouraging inventors to provide more detailed disclosures, thus strengthening the subsequent patent. The user-friendly and cost-effective nature of PPAs in these countries also promotes early-stage innovation and broader participation, which aligns with India's goals of fostering a vibrant startup ecosystem. Additionally, the strategic use of PPAs in attracting investment and securing early market positioning, as seen in the US, can be relevant for Indian startups seeking to demonstrate their commitment to intellectual property protection. Adopting best practices from these international examples can help India streamline its PPA process, making it more attractive and effective for domestic innovators while maintaining competitiveness in the global patent landscape.

XI. FUTURE DIRECTION OF PROVISIONAL PATENT APPLICATIONS IN INDIA

The future direction of provisional patent applications (PPAs) in India should prioritize making the process more accessible, efficient, and supportive of innovation. This involves enhancing the procedural framework to ensure that it caters effectively to the needs of startups, individual inventors, and small businesses. Emphasis should be placed on creating a more robust system that encourages detailed and comprehensive disclosures at the provisional stage, which in turn strengthens the quality of subsequent non-provisional applications. Additionally, fostering a culture of awareness about the strategic importance of PPAs in securing early protection and attracting investment is crucial. This can be achieved through targeted outreach and education programs that highlight the benefits and best practices of filing provisional patents.

Proposed Reforms for Provisional Patent Applications in India-

To achieve these future goals, several key reforms are necessary. Firstly, reducing the costs associated with filing provisional patents can lower the barrier to entry for many inventors and small enterprises, promoting a more inclusive innovation environment. Implementing incentives for detailed disclosures can ensure that provisional applications provide a solid foundation for future claims. Enhancing the digital infrastructure of the Indian Patent Office (IPO) is also critical; this includes developing a user-friendly online filing system that offers real-time tracking of application statuses, thus improving transparency and efficiency. Additionally, establishing partnerships with international patent offices to adopt best practices and harmonize procedures can provide Indian inventors with a more globally aligned patenting process. Training programs and workshops to educate inventors on the strategic use of PPAs and the importance of comprehensive documentation can further support the innovation ecosystem. These reforms collectively aim to make the provisional patent application process in India more effective, encouraging higher quality filings and stronger intellectual property

protection.

XII. CONCLUSION

In conclusion, provisional patent applications (PPAs) play a pivotal role in India's innovation ecosystem despite their associated challenges. While PPAs offer a cost-effective and accessible means for inventors to secure early filing dates and explore the commercial viability of their inventions, they also present common pitfalls. Insufficient disclosure, failure to follow up with complete applications within the 12-month window, and misunderstandings regarding legal requirements can undermine the effectiveness of PPAs. These pitfalls highlight the need for greater education and support mechanisms to help innovators navigate the complexities of patent filing.

Despite these challenges, the impact of PPAs on innovation in India is significant. They encourage early-stage creativity by reducing the financial burden of filing and providing a foundation for further development and refinement of inventions. PPAs also facilitate strategic planning for businesses, enabling them to attract investments, build patent portfolios, and establish competitive advantages in the market. Moreover, in a rapidly evolving global economy, PPAs allow Indian innovators to secure intellectual property rights swiftly, protecting their innovations against competitors and fostering a culture of entrepreneurship and technological advancement.

Looking ahead, addressing the common pitfalls associated with PPAs in India requires a multifaceted approach. This includes simplifying the filing process, enhancing accessibility through reduced costs, and improving the quality of disclosures through educational initiatives. Strengthening the digital infrastructure of the Indian Patent Office and aligning practices with international standards can further streamline the patenting process and enhance its effectiveness. By doing so, India can leverage PPAs more effectively to stimulate innovation, support economic growth, and position itself as a leader in global technological development. As these reforms take shape, they have the potential to unlock new opportunities for inventors, businesses, and the broader innovation ecosystem in India.
