

PATENT AGENT and Nature of Examination

BY

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WHO IS PATENT AGENT Sec.125

- **Link between the Controller and Inventor**
- **Person who facilitates work at the patent office relating to grant of patents**
- **Technically a person registered in the register of Patent Agents maintained by the Controller under section 125 of The Patents Act 1970 (Act)**
- **Authorized to do certain acts in exclusion of others and to practice before the Controller on behalf of other**

QUALIFICATIONS FOR PATENT AGENT

Section 126 of the Act gives qualifications for registration as Patent Agent

- Citizen of India
- Completed 21 years of age
- Degree in Science, engineering or technology from recognized university
- Other qualification as prescribed by the Government
- Should have passed the qualifying examination conducted by the Patent Office **or**
- Should have worked as examiner or discharged functions of Controller for not less than ten years
- Has paid such fee as prescribed

RIGHTS AND FUNCTIONS OF PATENT AGENT

(Sec 127 & 128)

Rights subject to other provisions of the Act

- To practice before the Controller
- Prepare all documents and transact all business
- Discharge such other functions in connection with any proceeding before the Controller under the Act
- Signing of all the applications and communications to the Controller on behalf of persons on authorization

RESTRICTION ON PRACTICE AS PATENT AGENT

(Sec 129)

- No person either alone or with partnership of other person shall practice as Patent Agent
- Describe or hold himself out as a Patent Agent unless registered
- Company or other body corporate cannot practise or describe itself as a Patent Agent
- Practice as Patent Agent means:
 - Applying for obtaining patents in India or elsewhere
 - Preparing specifications and other documents for the purpose of this Act or in any other country
 - Rights subject to other provisions of the Act
 - Giving advice other than scientific or technical nature as to the validity of patents or their infringement

POWERS OF CONTROLLER IN RESPECT OF PATENT AGENT

(Sections 130 TO 132)

- Removal of name from the register of Patent Agents
 - Erroneous entry
 - Conviction for misconduct in professional capacity
- Restoration of name after sufficient cause
- Controller may refuse to deal with or recognize
 - If name is removed and not registered
 - Conviction under section 123 (Practice as Patent Agent by a non registered person)
 - Employees of Patent Agents
 - Persons not residing or having place of business in India

QUALIFYING EXAMINATION FOR REGISTRATION AS PATENT AGENTS

(Rule 110)

- Written examination
 - Two papers each of 3.0 hrs. duration carrying 100 marks each
 - Paper (1) relates to The Patent Act and Rules
 - Paper (2) relates to Drafting and interpretation of patent specification and other documents.
- Viva Voce (100 marks)
- Qualifying marks: At least 50% in each of the above and aggregate of 60%

QUALIFYING EXAMINATION FOR REGISTRATION AS PATENT AGENTS

(Rule 110)

- Paper 1 Total 100 Marks
 - Divided into four parts A1, A2, B1, B2
- Part A (30 Marks)
 - Each question carry two marks
 - Candidate to answer all the questions in this section
 - To chose the right answer by indicate choice in the answer sheet
 - If more than one correct options, both the answers should be given
 - Illustration:
 - Question 1= C
 - Question 1= B and C

SAMPLE QUESTIONS

Paper 1 Part A1

● Question 1

1. A granted patent gives the patentee the right to claim damages:
 - a. From the priority date of the patent
 - b. From the date of grant of the patent
 - c. From the date of filing of the complete specification
 - d. From the date the patent applicant has survived an opposition proceeding
 - e. From the date of publication of the patent application in the official journal

2. A patent can be revoked
 - a. Anytime after its grant
 - b. Only after 1 year from the date of grant
 - c. Only after 3 years from the date of grant
 - d. Only after obtaining permission from the Controller of Patents
 - e. All of the above

3. India is a member of the
 - a. Paris Convention
 - b. Patent Cooperation Treaty (PCT)
 - c. Strasbourg Agreement
 - d. Substantive Patent Law Treaty
 - e. All of the above

SAMPLE QUESTIONS

Paper 1 Part A2

- **10 Questions, all to attempt, 10 marks :True or false**
Illustration Question (1)= true

1. A pre grant opposition decision in favour of the patent applicant can be appealed to the IPAB.
2. A genetically modified plant is patentable.
3. A “true and first inventor” includes a person who qualifies as the first importer of an invention into India.
4. In a successful post grant opposition, the Controller may ask the patentee to amend the patent specification.
5. The Controller himself can revoke a patent for its non-working, after the expiration of two years from the date of the order granting the first compulsory license in relation to such patent.
6. The Request for examination can be made only by an applicant

SAMPLE QUESTIONS

Paper 1 Part B (1)

- Short answers, total 10 questions, five to answer, 4 marks each total 20 marks.

PART B (60 MARKS)

PART B1 (20 MARKS): Each Question Below Carries Four (4) Marks Each

Instructions:

This Part contains ten (10) questions. Please answer any ~~five (5)~~ questions from amongst them. Your answer must be brief and to the point. While answering the questions, you are expected to support your answer by giving reasons and citing the relevant sections and rules in the Indian Patents Act.

- ✓ Your client has filed a provisional patent application on January 1st 2006. She is unable to file her complete patent application by December 31st 2006. As a patent agent representing her, what options would you suggest?
2. Laila and Majnu, a happily married couple co-invent a tracking device. Using the very same tracking device, Majnu discovers that Laila was having an affair with their driver, Romeo. Thereafter Majnu divorces Laila and files a patent in his own name to cover the said tracking device. Upon learning of this, Laila approaches you to represent her. How would you advise her?
3. A patent has been granted to Lily on January 1st 2002. However she has failed to pay the renewal fees in 2006, which she realised in January 2007. She approaches you. What would your advice be?

SAMPLE QUESTIONS

Paper 1 Part B (2)

- Detailed answers, total 5 questions, four to answer, 10 marks each total 40 marks.

1. Your client, Mr Karimeen has developed a complex electro-mechanical device for fishing in lakes. His device is able to sense the movement of fishes and then adjust the angle of the bait to effectively attract the fishes. After filing the complete specification, Karimeen realises that the mechanism and the programmed chip in the device can be used for various other applications. How would you protect all features of Karimeen's inventions?

After a few years, Mr Nettoli, a renowned fisherman from Mangalore makes an improvement on the device. Since you are the best patent attorney in India, Nettoli also approaches you to protect his invention. You find that Nettoli's invention is novel but lacks an inventive step. What will be your approach in helping protect Nettoli's interests?

SAMPLE QUESTIONS

Paper (2) Part A

- Detailed answers with reasoning and provisions of the Act, total 4 questions, All four to answer, 10 marks each total 40 marks.

PART A (40 MARKS)

Instructions:

Each Question Below Carries 10 (Ten) Marks. Please answer all the questions. Your answer must be brief and to the point. While answering the questions, you are expected to support your answer by giving reasons and citing the relevant sections and rules in the Indian Patents Act.

1. A research team working with company CRO completed a very difficult R&D project. CRO has filed a provisional patent application on October 10, 2009 in its name. Since then, its researchers have worked further on the invention and are now in a position to file a complete specification. The complete specification is expected to have 61 pages and 113 claims. There are 3 new inventors, of which 2 are foreigners from another institution “CRY” whose names have to be included in the patent application. There is an understanding between “CRO” and “CRY” that the patent application will be filed jointly in the names of the two institutions.

Suggest a plan of action for the filing of the relevant patent application including the timelines, the essential forms to be filled, fees to be paid and associated formalities to be completed to ensure that the application is in order.

SAMPLE QUESTIONS

Paper (2) Part B

- **Drafting Specification two questions 30 marks each all to be answered, total 60 marks.**

the Indian Patents Act? If a license is finally taken, what are the various requirements under the Patents Act that Motu must comply with?

PART B (60 MARKS)

This part contains two questions of 30 (Thirty) Marks. Please answer both the questions.

Question 1.

After reading the below specification carefully, please:

- Draft at least 5 claims;
- ~~ii~~ Provide an appropriate title to the specification.
- ~~iii~~ Draft a suitable abstract

Field of the Invention

The present invention discloses a device capable of harvesting and planting of plantable materials, maintaining their integrity during harvesting and transplantation. Further the device has an optional holder and a protective case also capable of functioning as a handle.

SAMPLE QUESTIONS

Before 2010

- **Q.No.1. Answer any five of the following :-**
 - **a) Your client ABC Pharma, Chennai approaches you with a known molecule having slight modification therein by adding a methyl group in the benzene ring. They wish to obtain a Patent for this invention. Advise appropriately to your client about the available provisions in the Indian Patent Act.**
 - **b) Your client has filed an application for patent. They received first examination report from the Controller of Patents with the objection that “your said application contains the claims from 8 to 15 distinct from rest of the claims not falling under the single inventive concept”. Advise your client suitably about the provisions in the Patent Act in this regard.**

SAMPLE QUESTIONS

- **Q.No.2 Your client Maruti Pvt. Ltd., Gurgaon sent a request for examination through speed post in respect of an application filed by them. The said document was delivered in Patent office by Post office two days after the last date for the filing of the request for the examination. Patent office sent a communication to Maruti Pvt. Ltd., Gurgaon stating that the request for examination has been filed after the due date and therefore cannot be taken on record.**
- **Your client approaches you to take remedial action. Draft appropriate documents to justify the stand in favour of your client.**

Thank you