

# **INTELLECTUAL PROPERTY PORTFOLIO MANAGEMENT**

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Welcome friends. So, in our earlier sessions We discussed about basics of intellectual property portfolio management. We also discussed about the development of the concept of IP as a tool not only at India level but at the global level also. We discussed that how from 1474 the idea of intellectual property protection started which

into the system of creation of WIPO and we discussed that how in India also over a period of time different types of patent laws their amendments happened and now going into the final details of our intellectual property management system let us first start with patent system. because patent is considered to be the most important type of intellectual property. So, let us see what are the different types of patent filing strategies. And for that purpose, first we need to understand what is a patent filing. Now, who will file the patent?

Inventor files the patent. Whenever inventor feels that I have done something innovative, I have done something which is non-existent, it is new, then I will go for filing the patent. Now, there are three very important conditions which need to be satisfied and inventor needs to check those conditions. What is one condition is novelty. that whether my research for what I am going to have patent, this is novel, new.

Second is whether it is naturally obvious thing or non-obvious thing. If it is obvious, if there is a thermos, I increase the thickness of that thermos. It will be better providing the protection. It will be a poor conductor of heat. You can keep your water warm for longer duration.

Because of the increased thickness, heat transfer rate will go down. So, it is obvious. So, if I do something of this sort, it will not be a case for patent. Case for patent is when it is non-obvious. something which is not going to happen on its own.

I have done something inventive in that case. So, many of us know non obvious as there has to be some inventive step in this. Without inventive step you are not eligible to get patent and third is it will be of benefit it will be of commercially useful. So, there has to be a scope of industry application.

Something which is only theoretical which cannot be applied by the industry will not be possible to get a patent and these three conditions are universal. global conditions or you can say these are decided by WIPO and accordingly each country will develop its patent act based on these three conditions. Something which is novel, something where some element of inventive step is present and at the same time it has application oriented invention. If it is not application oriented invention patent will not be possible. So, to get the patent for the invention first and foremost thing you need to check before going for filing the application in the patent office you need to check whether these three conditions are fulfilled or not.

For example, in various organizations we have the internal system. where we create internal committees. For example, you are working in a higher education institute, you are working in some HEI, you are a researcher and you feel that my research has potential of patent. It should be protected under the system of patent of India. So you will approach your administrator.

You will go to your admin office. For example I can call this admin office as let us say IPR office. So you will go to your IPR office. Sir I have done this research and please help me to get a protection for my research. Now, IPR office before filing your application to the patent office because IPR office will not grant the patent.

IPR office will forward your application to the patent office of India. Before that IPR office will do a due diligence and due diligence at the IPR office will be done on these three aspects novelty. inventive step and industrial application. If your internal office, IPR office, administrative office if this office is satisfied on these three aspects then only they will process your application to the next level. However, if you are independent

If you are independent, you are not working with any HEI, you are not working in any organization, you are an independent person. In that case, you are an independent researcher. You will directly go to Indian Patent Office. You may go and IPO will also check these three things. Since cost is involved in the process of protection so before incurring that cost the local IPR office or internal IPR office they will do due diligence okay it is

worthy enough to spend money on this particular invention or not for the protection purpose.

Because we all may be emotionally charged that okay I have done this invention It is a very new thing and it should be protected under the system of payday. But when you go to databases, there are good number of databases which are available and when you check with those databases then you realize that okay there are similar kind of inventions done by the experts, scientists before me and then you realize that it is not so novel. It has so many elements which were already done by the previous researchers. So, I have to do something additional, incremental to get the patent protection.

So, this is the first important thing in this patent filing that you need to check novelty, inventive step and industrial application. Now, the strategy here is how I am checking the novelty. There may be some free databases and there are paid databases. So, one important thing is accessibility of these databases. As an independent researcher, I can only use free databases, it may not be possible for

to subscribe these costly paid databases. But in the organization, if I am a researcher in HEI, if I am an employee in some organization, we can have a policy of paid databases also. So, if I want to make my organization IPCV organization, I can go for more and more paid databases, so that my researchers can have more confidence about their research. So, this is about the first step in this process of filing the IP.

Then, obviously, if I am in India, I have to go to Indian patent office. We call it as IPO. Like in Japan, it is known as JPO. In US, it is known as USPTO. So, different countries they have name of their own patent offices.

So, in India it is Indian patent office. So, you have to file your application in Indian patent office. And as we just know that there are Indian patent law. So, under that Indian patent law you will file your application in IPO. is a very important milestone in many ways and because of COVID now in Indian patent office though you can file offline and online but 99.9 percent applications these days are filed online only.

So, there is no need to go to the physically to the patent office or sending the hard copies of your application you can do. your entire filing online itself. Now, here comes one more important question that is can I file my application on my own? So, answer is yes, answer is yes that you can file your application on your own. However, it is also advisable to take help of experts for filing your application because

you are a researcher and filing patent application is a techno legal kind of a work. So, for techno legal kind of a work it is better to take help of those persons those experts who have knowledge of legal side also. So, when you are writing a research paper it is purely a science communication, but when you are writing a patent application it is not purely a science communication. its science with legal knowledge that type of communication. So, therefore, it is recommended to take help of experts who can help you in filing your application and these days large number of people are available who can help you at very minimal cost.

There is a perception there is a myth that these people the IP attorneys they take huge charges for filing the applications and many of us may be having this kind of deterrent in our mind that it is a very expensive activity and many of us may not be able to see clear benefit also of IP protection. So, in that case obviously, this becomes a major resistance for filing the patent etcetera. So, here I want to say that these days there are significant reduction in the charges of attorneys also and many of the services have become so standardized that you can take the help of attorneys without much worry of cost.

Now, as we already know and again to re-emphasize that patent protection and innovation is very for your business success. Because though there are different types of benefits, but when I talk of business success because the whole idea of this particular course that how your IP portfolio helps you in your business success. Here you will see that it will create barriers for others to enter into your business. it is going to give you the protection without entry of competitors.

I think that is the biggest reason organizations want to go for this IP protection because I have the invention and once I have the rights with me others will not be able to use this technology and they will not be able to enter into that space where I want to do business. So, all these things whatever I have written on this slide I will like to summarize that it is the best entry barrier for my competitors. If I do not have patents, if I do not have IP protection anyone can come into that space and my exclusive right will not be there.

So, it protects my invention, it provides important market advantage because your competitors will not be there. You may charge initially higher prices, so it allows you financial gains. Over a period of time it is also true that technology is protected for 20 years. But technology changes very fast also. These days we all know how fast technology is changing, how fast product life is also changing.

And as a result of that faster change in technology, faster change in product, you have very short period to take benefit of your research. And therefore, people keep higher prices when their products are protected by patents or IP system. And that is way they are able to regain or they are able to get compensated for the R&D expenses they have done in finding new ways of doing things. Global market monopoly that is only possible when you are able to protect your inventions in multiple markets. So, once you have IP in India then obviously you will like to go for

USA, Europe, Japan and many other countries and wherever you are able to protect your IP you will get a kind of monopoly in those markets. And those organizations having more and more IP it is directly contributing to their goodwill, their branding. So, we know that organizations are branded on the basis of their IP creation in this knowledge economy era. So, now coming back to this patent filing strategy and it is a strategic decision as we know and since it is a territorial right. So, one very important strategic decision is in how many countries I should protect

That is important strategic decision because I have to file if I am in India I have to file in Indian patent office, but since filing in India will not give me the protection in other countries. So, therefore, in how many different countries in which other country I should file my patent while you can simply answer. Sir, we should file in all possible countries. Why to leave even single country? But dear friends, the issue is that it involves cost.

It is an expense for you. Wherever you go, you need to pay some fee for protection in that country. So, therefore, it becomes a strategic decision whether that country is offering you sufficient market or not. If sufficient market is not there, why should I protect my product in that area? But then somebody else may say, sir there is a scope of infringing your rights from that territory.

Therefore, you should protect in that particular area also. Even if it is not a possible market, but they may infringe your IP, they may start manufacturing there and may send to some other country. So, Considering all these aspects identifying the countries where you want to file. So, one important issue which we need to discuss in detail that host country plus additional countries.

So, what is the list of that additional country that we need to be very carefully select because it all depends upon your business interest and that business interest you are able to understand when you do a good market research. When you know about that particular market that particular country that what will be the future of these products in those

nations accordingly you will decide. your strategy to go into multiple countries. Generally, I see in academia we have this perspective now that most of us need to follow Indian system. So, therefore, we do patents in India, Indian patent office and then we have this aspiration to go to US patent office USPTO.

whether we have a market in US or not despite that it is all aspirational thing. So, when I say aspirational we are diluting the strategic aspect of patent filing. We need to think more rationally not emotionally about selection of countries. So, nowadays there is another interesting trend which is coming up that many of us in India are going for Australian patents that has again become a very emotional issue because the procedural things are much easier in case of Australia and to take advantage of those procedural things we are going to Australian patent office without understanding the strategic advantage of going to Australian patent office.

So, point which I am trying to say that many a times we are spending money for patent filing in multiple countries without understanding whether it is actually useful or not. Sometime, sometime it may not be needed at all to go to other countries. Your Indian patent is enough for giving you protection within the country. So, after understanding this first requirement that for

deciding where you should go you need to have proper forecasting data, market research data and then only you should go for filing of patent in other countries. But before you go for filing of patent in other countries you need to understand the process of filing the patent in India itself. First due diligence as we already discussed in the beginning of this session and then First filing patent office jurisdiction. In India we have a patent office in each part of our country.

Like there is a patent office in Delhi, Mumbai, Calcutta, Madras and these are covering the local geographical area. So, like I am from Uttarakhand. So, we have to go to Delhi office of patent. Then we have to write the entire application which is more like a techno legal kind of a document.

It is not purely science communication it is a techno plus legal document that we need to prepare. the additional documents forms etcetera which are required that also need to be there. Then these days as I am saying we go for online submission of application and as soon as you submit your application you get application number. So, now this is instant activity you click the submit and you get the application number and your benefits the important thing is all benefits of patent is starts from this application number date.

We are talking continuously that patents are applicable for 20 years exclusive right. The 20 year exclusive right is from the date of this application number. the day you file your application your all the protections start from that very day. So, it is very important to understand that we may be talking in detail in subsequent session, but here you are filing let us say you are filing in the month of March 2024. And then there will be some kind of examination of your application and other review happens you will respond to that review.

You are getting grant of your patent in March 2026. It is taking about two years time from filing to grant for example. We know that patent gives you exclusive right for 20 years that 20 year period starts from date of filing. So, 20 years will get completed in 2044. So, your rights will cease on March 2044.

not on March 2046. So, there is a myth there is a myth many of us believe that our 20 years period will start from grant date. Unfortunately that is not corrected your 20 year period starts from the date of filing and if you are not using your exclusive right during this period when it is between this time if you are not using your exclusive right during this period you are losing a lot of business opportunities. So, it is very important that we need to understand that our 20 year period is from the date of filing and do not wait please do not wait for grant to start your business activities.

Then some of you may ask then what is the significance of grant? the patent is not granted then what will happen? So, it is a obvious question that if all my benefits are starting just by filing then what is the significance of granting? So, the purpose of granting is that you can only take the prosecution benefits when it is granted. So, if somebody is trying to steal your technology

you can sue him in the court once your patent is granted. So, that is the benefit of granting because date of filing, date of filing is protecting your innovation. It gives you protection. The exclusive rights will become when you are granted with the patent. So, that is the difference between filing and granting.

Once you have submitted the application, you got this application number, your rights have started, protection has started of the novelty, then you need to follow the complete prosecution process. That means, your application will go through multiple stages and first it will be published in the patent journal. First it will be published in the patent journal after publication it will go for examination and after examination based on your response because there will be examination report you will respond to those examination

reports the grant will happen. Earlier the system was that from online filing to publication it used to take 18 months.

But now there is a possibility of expedited publication. This is second important strategic decision. Should we go for expedited publication or not? It has both pros and cons. If your application is published it comes into the public domain.

So, what is your invention? It will be known to public and public may start giving lot of objections on your application. When it is not published it is still a confidential document and at least for initial 18 months you can enjoy based on that confidentiality. So, I think it is also important strategic issue should I go for early publication, expedited publication or should I wait for normal 18 months?

This is one aspect and the second aspect is the cost also. If I am going for early publication, it requires some extra fee. So, when I decide that I need to pay more and then I will take the benefit of early publication, but it is opening like a Pandora box. If you are doing early publication, people will come to know and they may raise more objections on your application. And you may not be ready to face those challenges, those objections which may come from the public.

So, this is another important strategic decision. Should you go for early publication or not? Similarly, these days in Indian patent office, early examination is also possible. So, that also becomes important. decision should I apply for early examination or should I not apply for early examination.

So, if you are applying for early examination you have to pay more and disposal of your application happens faster. So, it since early grant has no business sense as such the business sense comes from the filing date. it has to be thought through because you are not going just for one application or two applications. When we are talking of portfolio management, it means that your organization handling let us say thousand patent application every year and therefore, this extra cost of publication, extra cost of examination need to be thought through very carefully and therefore, I am saying these becomes strategic decisions. If I am

individual researcher I am doing only one invention. So, for that case this portfolio management strategic issues may not come into the picture. These things are only coming into the picture when we are doing things in bulk. So, in this particular session we

discussed three important strategic dilemma. One is identifying countries where I should file my IP.

Should I go for early publication? Should I go for early examination? So, these three important strategic dilemma we discussed. And during the course, we will see that how are we going to solve these dilemma with the kind of information we are going to collect. So, with this, we come to end of this section.

Thank you very much.