

FILING PROCEDURE

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WHY THE PATENT APPLICATIONS ARE EXAMINED?

- PATENT GRANT IS NOT A REGISTRATION
- PATENT GRANT IS SUBJECTED TO CERTAIN CRITERIA
- WHAT ARE THE TYPES OF EXAMINATIONS?
 - ❑ FORMAL EXAMINATION
 - ❑ TECHNICAL EXAMINATION

Technical Examination mainly revolves around Novelty, Inventive Step, Industrial applicability & Statutory Exclusions

THE NEW NUMBERING SYSTEM

- The numbering system of Patent Applications and Request for Examination filed in the Indian Patent office is being streamlined and standardized with a view to attain uniformity in accessibility and processing of patent applications by all Patent Offices in India. Accordingly a new format of numbering has been implemented with effect 1st January 2016
- The new numbering system for patent applications shall have 12 characters fixed length numeric standard patent application format applicable to all the patent offices in India and shall include identifiers of year of filing, jurisdiction, type of application and application number.
- Similarly the numbering system of Request for Examination shall also be unified and standardized.
- Application numbers / Request numbers that have already been allotted shall continue to be maintained and recognized till they are fully converted into the new numbering pattern.

NEW NUMBERING FORMAT FOR Patent Applications in India

- Format: **YYYYJTNNNNNN**
 - “YYYY” denotes four digit fixed length “Year of filing”
 - “J” denotes fixed length single digit “Jurisdiction” in numerals, wherein 1 for Delhi; 2 for Mumbai; 3 for Kolkata; and 4 for Chennai [it is based on postal index codes]
 - “T” denotes fixed length single digit “Type of Application” in numerals
 - 1 for Ordinary
 - 2 for Ordinary-Divisional
 - 3 for Ordinary-Patent of Addition
 - 4 for Convention Application
 - 5 for Convention-Divisional
 - 6 for Convention- Patent of Addition
 - 7 for PCT National Phase Application
 - 8 for PCT National Phase-Divisional
 - 9 for PCT National Phase-Patent of Addition
- “NNNNNN” denotes 6 digits fixed length common continuous running serial number applicable for all Patent Offices in India

NEW NUMBERING FORMAT FOR Patent Applications in India

- Example 1 : First Ordinary application filed in Delhi then the number will be:
- YYYY J T NNNNNN
- 2016 1 1 000001
- Example 2 : If the second application is a Convention application and filed in Mumbai then the number would be;
- 2016 2 4 000002
- The “NNNNNN” series of applications shall be unique and sequentially incremented for all the four patent offices in the order of their filing. Date of application shall accompany the patent application number in the format YYYY/MM/DD [YEAR/MONTH/DATE]

NEW NUMBERING FORMAT FOR Request for Examination in India

- **For Request for Examination u/r 20B(4)(1)(i)**
- **Format: RYYYYJNNNNNN under rule 24B(1)(i) (Normal)**
- **“R” denotes Request for examination u/r 24(B)(1)(i)**
- **“YYYY” denotes four digit fixed length “Year of filing”**
- **“J” denotes fixed length single digit “Jurisdiction” in numerals, wherein 1 for Delhi; 2 for Mumbai; 3 for Kolkata; and 4 for Chennai [it is based on postal index codes]**
- **For Request for Examination u/r 20(4)(ii)(Express)**
- **FORMAT: XYYYYJNNNNNN**
- **“X” denotes Request for Examination u/r 20(4)(ii)**
- **“YYYY” denotes four digit fixed length “Year of filing”**
- **“J” denotes fixed length single digit “Jurisdiction” in numerals, wherein 1 for Delhi; 2 for Mumbai; 3 for Kolkata; and 4 for Chennai [it is based on postal index codes]**

“NNNNNN” denotes 6 digits fixed length common continuous running serial number applicable for all Patent Offices in India

Both the serial numbers u/r 24(B)(1)(i) and u/r 20(4)(ii) shall be common and shall be accompanied by the date of request for examination in YYYY/MM/DD format.

FORMAL EXAMINATION

- To be understood and to be done in following terms
- Procedural aspects & Time limitation and allowances
- Legal requirements

Before proceeding further let us understand on the classification of nature of applicants and mode of filing the application for patent.

Nature of applicants

☐ INDIVIDUALS & START UP COMPANIES

For a startup company:

1. Validity is 5 years from the date of registration and can be retrospective, and
2. Any financial year TURNOVER shall not exceed 25 crore, and
3. Shall involve in innovative work.
4. Shall be certified by start up committee in India or any other equivalent if the applicant is a foreigner

☐ SMALL ENTITIES

1. If manufacture unit the total expenses on infrastructure shall not exceed 10 crore
2. If service sector unit is the applicant then the total expenses on equipment shall not exceed 5 crore
3. Shall be supported by submitting a certificate under MSME Act.

☐ OTHER THAN THE ABOVE TWO

☐ NO RESTRICTION ON NATIONALITY OR RESIDENCE

Mode of Filing

- Fees has to be paid wherever is prescribed in total and shall accompany with the document.
- Fees can be paid either online or in the form of DDs or Banker Cheque or by cash
- Whenever hard copies are filed or filing is not done through e-filing system then fee is 10% in excess of the fee that is payable through online
- Patent agents shall use e-filing system only
- No courier service is allowed. Encouraged to use the services of Indian Post. Facsimile or email services are not allowed.

BUT.....

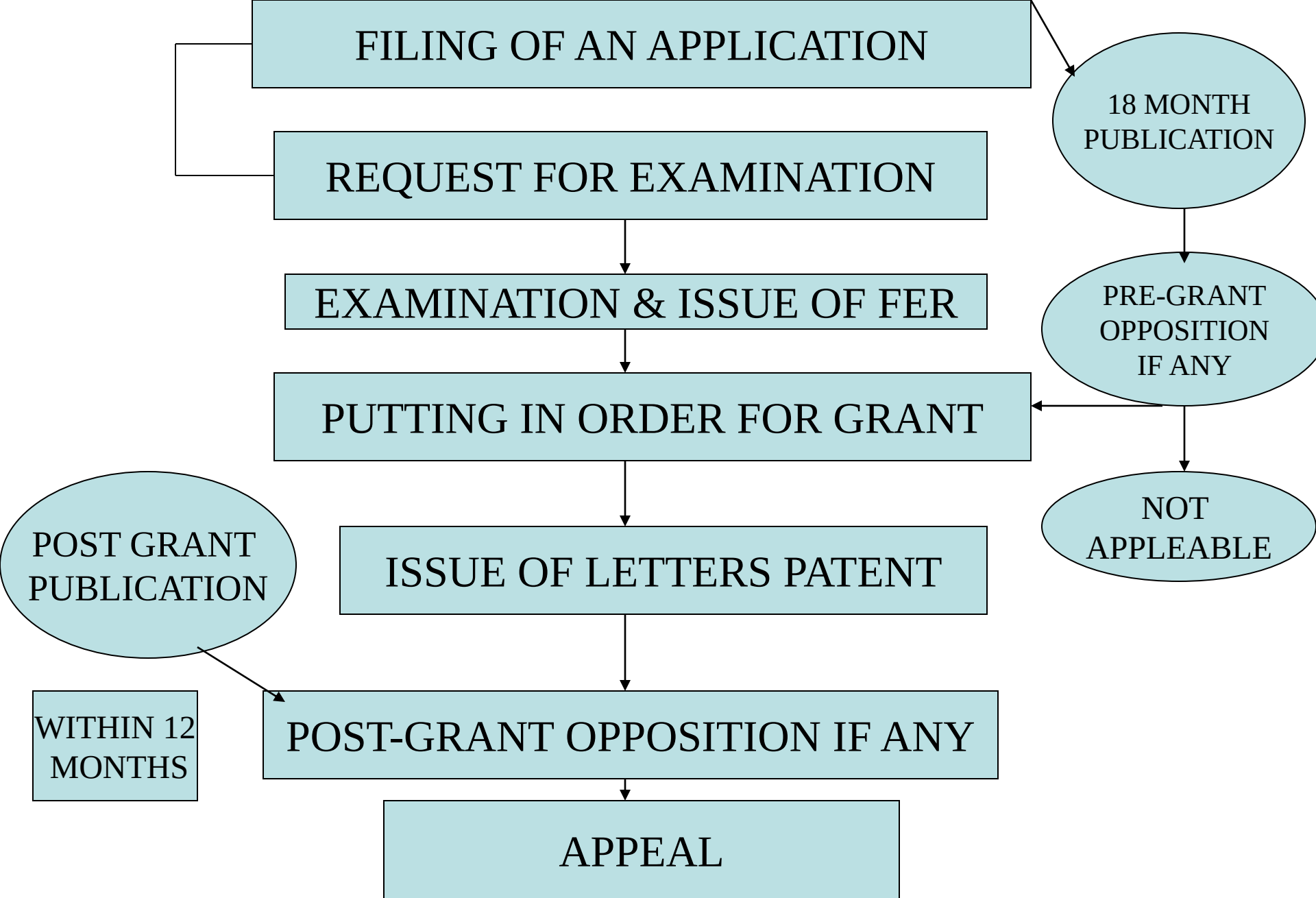
Whenever patent agents are filing on behalf of the inventors/applicants the following documents, **in original**, shall be filed in hard copies within 15 days from the date of uploading the same.

- (a) Rule 10: Proof of Right to make an application
- (b) Rule 135: Submission of PA or GPA
- (c) Rule 91: Deed of Assignment; Certificate regarding change in name of the claimant as applicant
- (d) Rule 13(6): Declaration of Inventorship
- (e) Rule 21: Priority Document – if not filed along with the specification 3 months notice is given to the applicant from the date of notice by the Controller. Applicable only for PCTNP applications. [3 month restriction in case of Section 138(1) is not applicable under this]

What will happen if the patent agent fails to do so? Left to the wisdom of Examiner and Controller pair. Probably we may ask for an irregularity petition under the Rule 137 of the Patents (Amendment) Rules 2016.

TYPES OF APPLICATIONS

- APPLICATIONS FILED ONLY IN INDIA
[ORDINARY APPLICATIONS]
- DIVISIONAL APPLICATIONS
- PATENT OF ADDITION APPLICATIONS
- CONVENTION APPLICATIONS
- PCT NATIONAL PHASE APPLICATIONS



FORM – 1

Procedural aspects & Time limitation and allowances

- ❖ Form-1 is the universal form for all the types of applications.
- ❖ Depending upon the type of the application the required details needs to be filled.
- ❖ No time limit for ordinary application.
- ❖ Divisional applications needs to be filed before grant/refusal of the parent application. Applications are antedated.
- ❖ Patent of addition can be filed at any time during the patent term. No antedating of the application.
- ❖ Convention application shall be filed within non-extendable time limit of 12 months from the date of priority
- ❖ PCT National Phase application shall be filed within non-extendable time limit of 31 months from the date of priority.

FORM – 1

Procedural aspects & Time limitation and allowances

- Form-1 can be filed either by inventor(s) or assignee(s).
- No limitation on number of applicants/inventors
- If applicant(s) is/are assignee then filing Proof of Right [POR] to file a patent application is mandatory.
- If any priorities are claimed then the basic fee payable shall be multiplied by the number of priorities
- In priority applications the certified copies of the priority document(s) shall be filed.

LEGAL REQUIREMENTS OF FORM-1

- POR can be filed in two ways. First one is that all the inventors will sign at paragraph 12 of Form-1 or by filing a separate Assignment
- POR shall be filed either along with the application or within 6 months which can be further extendable by filing a petition under section 7(2) of the Patents Act.
- Form – 1 can be amended by filing Form – 13; amendment includes the priority date.[Section 57(5)]

PCT NATIONAL PHASE APPLICATIONS

- If corresponding application has been filed then the International application is the deemed application in India. [Section 7(1A)]
- In other words the description, claims, drawings & abstract of the International application ONLY need to be examined.
- The amendments before the International phase are treated as amendments made and allowable during the National Phase.
- Chapter 1 of International Phase is mandatory for all the PCT International Applications.
- At the expiry of 16 month from the date of priority, if applicable, or from the date of filing the International Application ISR will be issued directly to the applicant.
- If applicant is desirous to amend then he is allowed to make amendments ONLY TO CLAIMS. The proposed amendments, if any shall be submitted to International Bureau [IB] before the expiry of 18 month from the date of priority, if applicable, or from the date of filing the International application

PCT NATIONAL PHASE APPLICATIONS

- Chapter 2 of International Phase is not mandatory wherein if the applicant desires to get his amended application / unamended application is further examined by an International authority he may do so by filing a demand within the expiry of 19 or 22 month from the date of priority, as applicable, or from the date of filing the International application.
- Under the Chapter 2 the applicant is free to amend the description as well.
- Amendments made, if any during Chapter 2 is allowable during the National Phase.
- The fee during the national fee payable to Indian application shall be calculated based on the latest International Application. During the entry into National Phase no amendments can be proposed by the applicant. But after filing and paying the necessary fees Form – 13 can be filed.
- On the provisions of the latest Patents Amendment Rules 2016 [effective from 16th May 2016] the applicant CAN DELETE the claims, and no other amendments are allowed at the entry stage of National Phase. [subrule 1 of Rule 20]

FORM – 2

Procedural aspects & Time limitation and allowances

- Form – 2 is the bunch of papers known as specification wherein the first page is prescribed by the Patents Act.
- Specification is of two types; provisional and complete
- If provisional is filed then the complete shall be filed within non-extendable time limit of 12 months from the date of filing the provisional
- Multiple provisional applications are allowable to be filed for an invention. In such case 12 month period is reckoned from the earliest filing of provisional application

LEGAL REQUIREMENTS OF FORM - 2

- Form – 2 is the specification that includes descriptive pages of the invention, claims, abstract and drawings, if applicable.
- Basic fee is up to 30 pages inclusive of all the above and 10 claims.
- Every page beyond 30 pages and every claim beyond 10 claims is chargeable.
- Preamble of Form – 2 is the requirement imposed under the provisions of the Section 10 of the Patents Act.

FORM – 3

Procedural aspects & Time limitation and allowances

- Not a mandatory form
- Shall be filed when a corresponding application is filed outside India
- Free time available under the provisions of Rule 12 is 6 months from the date of such filing
- Is applicable for each country hence time limit is to be reckoned from the date of filing in such country
- There is a possibility of entering in foreign countries before filing in India. In such occasions 6 month period is calculated from the date of filing in India

FORM – 3

Procedural aspects & Time limitation and allowances

- Section 8 provisions are to be followed.
- Section 8(1) provisions are to be followed by the applicant.
 - i. Section 8(1)(a) teaches about filing the foreign filing particulars **at the time of filing in India**.
 - ii. Section 8(1)(b) teaches about filing the foreign filing particulars **after filing in India**.
- Section 8(2) provisions are imposed on the applicant by the Controller inquiring on the novelty and inventive step assessment made by a foreign country. The applicant has to reply within the prescribed period of 6 months from the date of communication. Time period is extendable by filing a petition under Rule 138.

FORM – 3 LEGAL IMPLICATIONS

- Time limitations under Sections 8(1) & 8(2) are extendable by filing a relevant petition.
- Non-information or wrong information on form-3 can be a legal ground for opposition and the applicant may lose the patent grant on this ground alone. Sections 25(1)(h); 25(2)(h) & 64(1)(m).

WHERE EXTENTION OF TIME IS ALLOWED & IMPOSITIONS

EXTENTION OF TIME IS POSSIBLE BY TWO WAYS.

- i. By filing Form-4
- ii. By filing a petition under Rule 138

Act provides a stipulated period to do an action and the Act also defines on how much time is extendable.

Form – 4 can be filed during the extendable period.

Petition u/r 138 has to be filed before the expiry of the stipulated period.

Section/ Rule	Purpose	Free time available	Maximum extension time allowable	When to file	Fees
S53(2) & R80(1-A)	Renewal fee	NIL	6 months	During Extendable period	Rs 480/- Or Rs1200/- or Rs. 2400/- per month provided the filing is done electronically, otherwise 10% extra fee is to be added.
S142(4)	Renewal fee immediately after the grant	3 months from the date of recordal	6 months	During Extendable period	-do-
R13(6)	Filing of Form- 5	NIL	1 Month plus	During first month	-do-
R130	To file review petition	ONE month	ONE month	During Extendable period	-do-

PETITION U/R 138

- Some time limitations cannot be extended.
- Such times have been shown as “save as otherwise provided” in Rule 138(1)
- Petition shall be filed according to the provisions of the Rule 138(2) before the end of the stipulated period, in other words not allowable if requested beyond the stipulated period
- Maximum one month extension is possible.
- Further extensions if required is left to the wisdom of the examiner and controller pair.

Where time extensions are not allowed?

Time prescribed in

clause (i) of sub-rule (4) of rule 20: entering national phase within 31 months from the date of priority

sub-rule (6) of rule 20: translations and amendments, if any, also shall be filed within 31 months from the date of priority

rule 21: when priority document has not been filed during the International phase then the applicant shall file the priority document within 31 months from the date of priority or within 3 months from the date of invitation by this office.

sub-rules (1), (5) and (6) of rule 24B:

- i. Form-18 within 48 months from the date of priority, if applicable or from date of filing;
- ii. Form-18 within 48 months from the date of priority or within 6 months from the date of revocation of secrecy [subsection 4 of section 11B], whichever is later;
- iii. Form-18 within 48 months from the earliest priority/date of filing/ within 6 months from the date of filing the divisional application whichever is later [subsection 3 of section 16]
- iv. Time for putting an application in order is 6 months from the date of issue of FER;
- v. Extendable time of 3 months for putting an application in order is 6 months from the date of issue of FER;

Where time extensions are not allowed?

sub-rules (10) and (11) of rule 24C: In expedited examination wherein Form – 18 A is filed

- i. Time for putting an application in order is 6 months from the date of issue of FER;
- ii. Extendable time of 3 months for putting an application in order is 6 months from the date of issue of FER;

sub-rule (4) of rule 55: 3 month time period for the applicant to file reply statement and evidence, if any, under Pre-grant opposition;

sub-rule (1A) of rule 80: Extendable period of 6 months for paying the renewal fee, and

sub-rules (1) and (2) of rule 130: Extension of time of one month for filing a review petition by filing Form - 24

FORM – 5 PROCEDURE & TIME LIMITATIONS

A form to add additional inventors

Mandatory form in the following circumstances

- Filing complete after provisional specification
- Filing a convention application
- Filing an PCT National Phase Application

TIME ALLOWANCE

NIL

Extension is possible for first one month by filing Form-4 & further extension is possible by filing a relevant petition.

HOW ABOUT DELETION OF INVENTORS?

No provision in the Patents Act.

Why so?

Because inventors are the first owners? How the ownership can be knocked out when the applicant declares in Form – 1 that so called named inventors are the true and first inventors.

To overcome the above problem there is a legal solution.

Applicant needs to file Form-13 & file a petition u/r 137 along with an affidavit intimating that one or more names of the inventors is/are erroneously entered and the said affidavit shall be signed by the actual inventors and the inventors whose name(s) is/are to be deleted.

FORM- 6 PROCEDURAL ASPECTS

IT IS THE FORM TO CHANGE THE NAME OF THE APPLICANT AND PROCEED ON CLAIMANT'S NAME BEFORE THE GRANT/REFUSAL OF PATENT

The circumstances under which Form-6 is filed;

- i. Any assignment or agreement made by the applicant in writing or by any one of the applicants [of course with the consent of other applicants]
- ii. By operation of law

FORM- 6 PROCEDURAL ASPECTS

The assignment shall contain the following details.

- a. Number of the application for patent, or
- b. An acknowledgment by a person by whom the assignment or agreement is made, or
- c. Rights of the claimant is decided by the Court, or
- d. Direction by the Controller on a dispute among the parties
- e. By any of the survivors after obtaining permission from the legal representative of the deceased

FORM – 6 LEGAL IMPACT

OWNERSHIP CHANGES FROM THE APPLICANT TO THE CLAIMANT

IF THE CHANGEOVER IS FROM NATURAL PERSON OR A START UP COMPANY TO SMALL ENTITY OR ANY PERSON OTHER THAN THOSE TWO THEN THE DIFFERENCE OF FEE SHALL BE FILED FROM THE FIRST ACTION.

SIMILARLY IF THE CHANGEOVER IS FROM SMALL ENTITY TO OTHER THAN NATURAL PERSON/START UP COMPANY THE DIFFERENCE OF FEE SHALL BE PAID FROM THE FIRST ACTION.

IF ACTION IS REVERSE THEN NO FEE WILL BE REFUNDED BY THIS OFFICE.

SECTION 28 & FORM - 8

- **What this section and form is about?**

To mention the name of the inventor(s) in LPD & in Patent Register

- **Who has to file?**

When applicant is not the inventor then both the applicant and the inventor shall file

- **When to file?**

Request shall be made before the grant of patent

- **What is the consequence?**

The name of the inventor(s) will be mentioned in LPD & in Patent Register

- **What are the legal implications ?**

Such mentioning shall not confer or derogate from any rights of the applicant.

REQUEST FOR EXAMINATION FORMS 18 & 18A

FORM - 18

Section 11B & Rule 24B(1):

Shall be filed within non-extendable time limit of 48 months from the date or priority, if applicable, otherwise from the date of filing. [4K, 10K, 20K...4400, 11K & 22K...FEES]

Under Rule 20(4)(ii): Express request to take up before the expiry of 31 month period from the date of priority [FEES: 5600, 14K 28K....6150, 15400, 30800]

FORM – 18A:

Fee has to be paid only by electronic transmission

Under Rule 24C: Expedited examination can be filed by an applicant who had opted India as ISA or IPEA or a start up [FEES 8000, 25000, 60000]

Form 18A also can be used for conversion from 24B to 24C [4000, 15000, 40000]

FORMS 18 & 18A LEGAL IMPLICATIONS

- If request for examination has been filed the application is deemed withdrawn by the applicant.
- There is a possibility of withdrawing the application before the publication and also after the publication.
- If withdrawn by the applicant before the 18 month publication under section 11A then Novelty is not lost and the applicant refile the application.
- If the application is withdrawn by the applicant after the publication then inventor himself loses the test for novelty owing to its publication and hence patent should not be granted
- Form -29 shall be filed for withdrawal request and no fee is to be paid.
- Refund to the applicant is possible [90% of the examination fee] provided that Form – 29 is filed before the issuance of first examination report

Amendments under section 57

FORM - 13

Section 57 shall be read with Section 59

Section 59 imposes that technical amendments are restricted to explanation, disclaimer and correction, in other words shall not go beyond the scope of the invention.

Amendments to any document including application and other forms and affidavits etcetera is possible.

Form – 13 is to be used for carrying out the amendments.

Differential fee structure exists between Pre-grant and Post-grant stages. In other words Form – 13 can be filed at any time of the patent term.

FORMAL AMENDMENTS

- Change of the name of the applicant. [do not get confused with change of the name of the applicant under sections 20 and 69]
- Change of the applicant's address
- Change of the inventors' address
- Change of the address for correspondence
- Amendment of any application or any other document
- Amendment includes priority date
- Any other relevant amendment

FORM - 30

- SUBRULE 2 OF Rule 8
- —(2) Where no Form is so specified for any purpose, the applicant may use Form 30 specified in the Second Schedule.
- Relevant section or Rule shall be mentioned & relevant fee needs to be paid, if any.
- For example the applicant needs to file the written submissions within 15 days from the date of hearing. If delayed Form-30 can be used.

HAPPY EXAMINING!

ANY QUESTIONS?
THANKS FOR YOUR ATTENTION