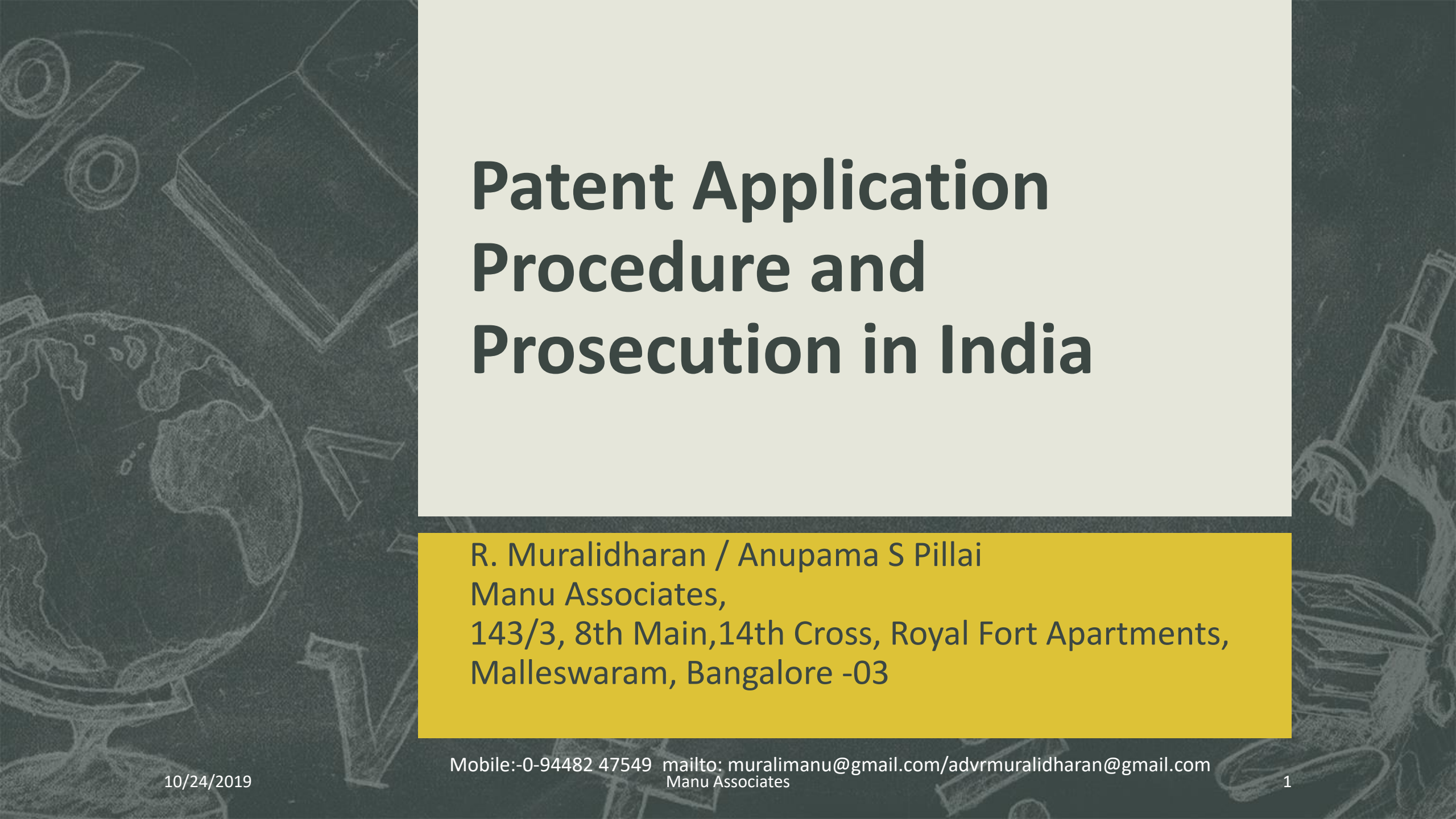




Patent Application Procedure and Prosecution in India

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Patent Office

- Indian Patent Offices are located at Delhi, Kolkata, Mumbai and Chennai with its head quarters in Kolkata.
- Seat of the Controller General Patents Designs Trademark is at Mumbai.
- The office of the Patent Information System and National Institute for Intellectual Property Management is at Nagpur.
- O.P. Gupta is the current CG and took charge on 16 November 2015

Filing Office

The appropriate filing patent office is determined based on the Applicant's region/location-

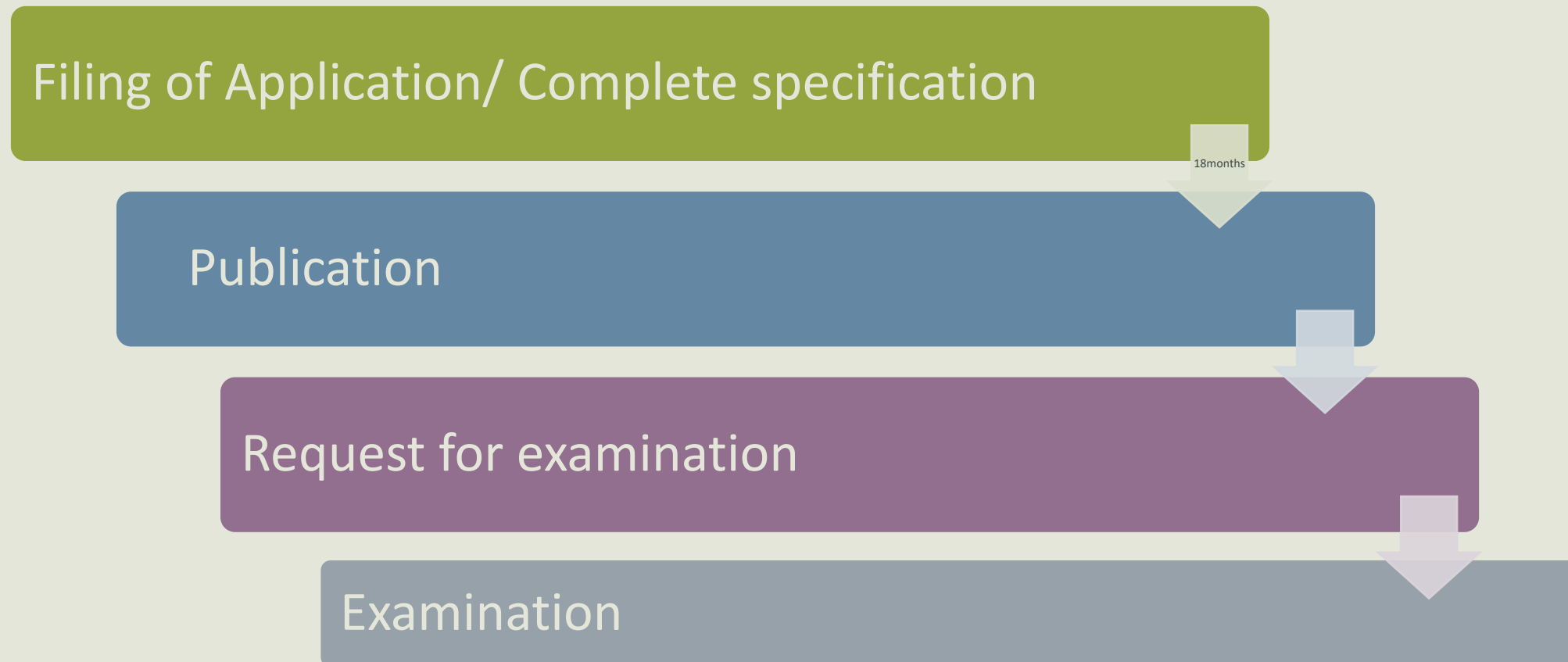
- where the applicant resides; or
- has a place of business, or
- the place from where the invention actually originated
- if the applicant has no place of business or domicile in India, the address for service given in the application.

Office	Jurisdiction
Mumbai	The States of Maharashtra, Gujarat, Madhya Pradesh, Goa and Chhattisgarh and the Union Territories of Daman and Diu & Dadra and Nagar Haveli.
Chennai	The States of Andhra Pradesh, Karnataka, Kerala, Tamil Nadu and the Union Territories of Pondicherry and Lakshadweep
New Delhi	The States of Haryana, Himachal Pradesh, Jammu and Kashmir, Punjab, Rajasthan, Uttar Pradesh, Uttaranchal, Delhi and the Union Territory of Chandigarh.
Kolkatta	The rest of India

Filings – General procedure

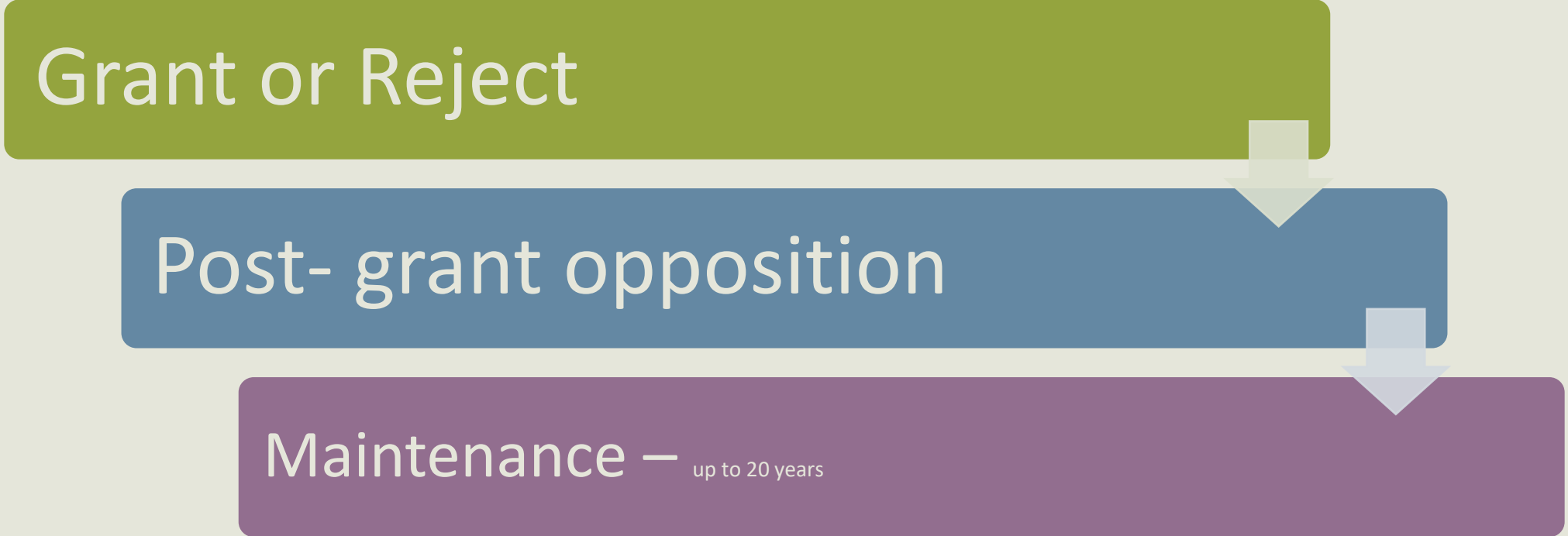
- Till the Patent Amendment Act 2016, (which came into effect on May 16, 2016) filings were in physical form. Each form along with the required document had to be sent to the appropriate Patent office through Courier/ Speed post.
- Patent Amendment Act 2016 has made e-filing mandatory for patent agents. Now the patent agent has to upload the required Forms with the Patent office through their registered account. The documents should be duly authenticated, including scanned copies of documents that are required to be submitted in original.
- The original documents that are required to be submitted in original, shall be submitted within a period of fifteen days, failing which such documents shall be deemed not to have been filed.

PROSECUTION STEPS



PROSECUTION STEPS

Grant or Reject



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graph TD; A[Grant or Reject] --> B[Post-grant opposition]; B --> C[Maintenance — up to 20 years];
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The diagram illustrates the prosecution steps as a vertical flowchart. It consists of three rectangular boxes stacked vertically, connected by downward-pointing arrows. The first box is olive green and contains the text 'Grant or Reject'. A light green arrow points from its bottom center to the top center of the second box. The second box is blue and contains the text 'Post-grant opposition'. A light blue arrow points from its bottom center to the top center of the third box. The third box is purple and contains the text 'Maintenance — up to 20 years'.

Post-grant opposition

Maintenance — up to 20 years

Who can file a Patent Application?

- An application for a patent for an invention may be made by any of the following persons, either alone or jointly with any other person :
 1. by any person claiming to be the true and first inventor of the invention;
 2. by any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application;
 3. by the legal representative of any deceased person who immediately before his death was entitled to make such an application.
- Patent Act recognise four types of Applicants :- natural persons, small entity , other than small entity and Startups (Start up were recognised and included by the Patent Amendment Act 2016).

Relevant Forms in Filing a Patent Application.

- Form 1. - Application for grant of patent . Proof of Right to Apply (Paragraph 9 of
- Form 2 – Provisional or complete Specification
- Form 3 - Statement of Foreign Filing
- Form 5 - Declaration as to Inventor ship
- Form 9 - Request for Early Publication
- Form 18 - Request for Examination
- Form 26 - Power of Attorney, if Required
- Certified Copy of Convention Application, if required (in case of foreign filings)
- Abstract of Invention
- Drawing(s), if any.

Forms - Fee in Filing a Patent Application. Form - 1

Particulars		Online		Physical		
	Natural person(s) and/ or Start-up.	Small entity, alone or with natural person(s) and/ or Start-up	Others, alone or With natural person(s) and/ or Start-up and/ or Small Entity	Natural person(s) and/ or Start-up.	Small entity, alone or with natural person(s) and/ or Start-up	Others, alone or With natural person(s) and/ or Start-up and/ or Small Entity
On application for a patent under sections 7, 54 or 135 and rule 20(1) accompanied by provisional or complete Specification-	1600 Multiple of 1600 in case of every multiple priority.	4000 Multiple of 4000 in case of every multiple priority.	8000 Multiple of 8000 in case of every multiple priority.	1750 Multiple of 1750 in case of every multiple priority.	4400 Multiple of 4400 in case of every multiple priority	8800 Multiple of 8800 in case of every multiple priority.
I) for each sheet of specification in addition to 30, excluding sequence listing of nucleotides and/ or amino acid sequences under sub-rule (3) of rule (9);	(i) 160	400	800	(i) 180	(i) 440	i) 880
(ii) for each claim in addition to 10;	(ii) 320	800	1600	(ii) 350	(ii) 880	(ii) 1750
(iii) for each page of sequence listing of nucleotides and/ or amino acid sequences under sub-rule (3) of rule (9).	(iii) 160 subject to a maximum of 24000	400 subject to a maximum of 60000	iii) 800 subject to a maximum of 120000	Not allowed	Not allowed	Not allowed

Forms - Fee in Filing a Patent Application. Form - 2

Particulars	Online			Physical		
	Natural person(s) and/ or Start-up.	Small entity, alone or with natural person(s) and/ or Start-up	Others, alone or With natural person(s) and/ or Start-up and/ or Small Entity	Natural person(s) and/ or Start-up.	Small entity, alone or with natural person(s) and/ or Start-up	Others, alone or With natural person(s) and/ or Start-up and/ or Small Entity
On filing complete specification after provisional up to 30 pages having up to 10 claims –	No fee	No fee	No fee	No fee	No fee	No fee
(i) for each sheet of specification in addition to 30, excluding sequence listing of nucleotides and/ or amino acid sequences under sub-rule (3) of rule (9);	(i) 160	400	800	180	440	880
(ii) for each claim in addition to 10.	ii) 320	ii) 800	(ii) 1600	(ii) 350	ii) 880	ii) 1800
(iii) for each page of sequence listing of nucleotides and/ or amino acid sequences under sub-rule (3) of rule (9).	iii) 160 subject to a maximum of 24000	iii) 400 subject to a maximum of 60000	iii) 800 subject to a maximum of 120000	Not allowed	Not allowed	

Forms - Fee in Filing a Patent Application.

Forms	Particulars	Online			Physical		
		Natural person(s) and/ or Start-up.	Small entity, alone or with natural person(s) and/ or Start-up	Others, alone or With natural person(s) and/ or Start-up and/ or Small Entity	Natural person(s) and/ or Start-up.	Small entity, alone or with natural person(s) and/ or Start-up	Others, alone or With natural person(s) and/ or Start-up and/ or Small Entity
Forms 3	On filing a statement and undertaking under section 8.	No fee	No fee	No fee	No fee	No fee	No fee
Form 5	On filing a declaration as to inventor ship under sub-rule (6) of rule 13.	(i) 160	400	800	180	440	880
Form 9	Request for publication under section 11A(2) and rule 24A.	2500	6250	12500	2750	6900	13750
Form 18	On request for examination of application for patent—	4000	10000	20000	4400	11000	22000
	(i) under section 11B and rule 24(1);	5600	14000	28000	6150	15400	30800
	(ii) under rule 20(4)(ii).						
				Manu Associates			11

Form 1. - Application for grant of patent

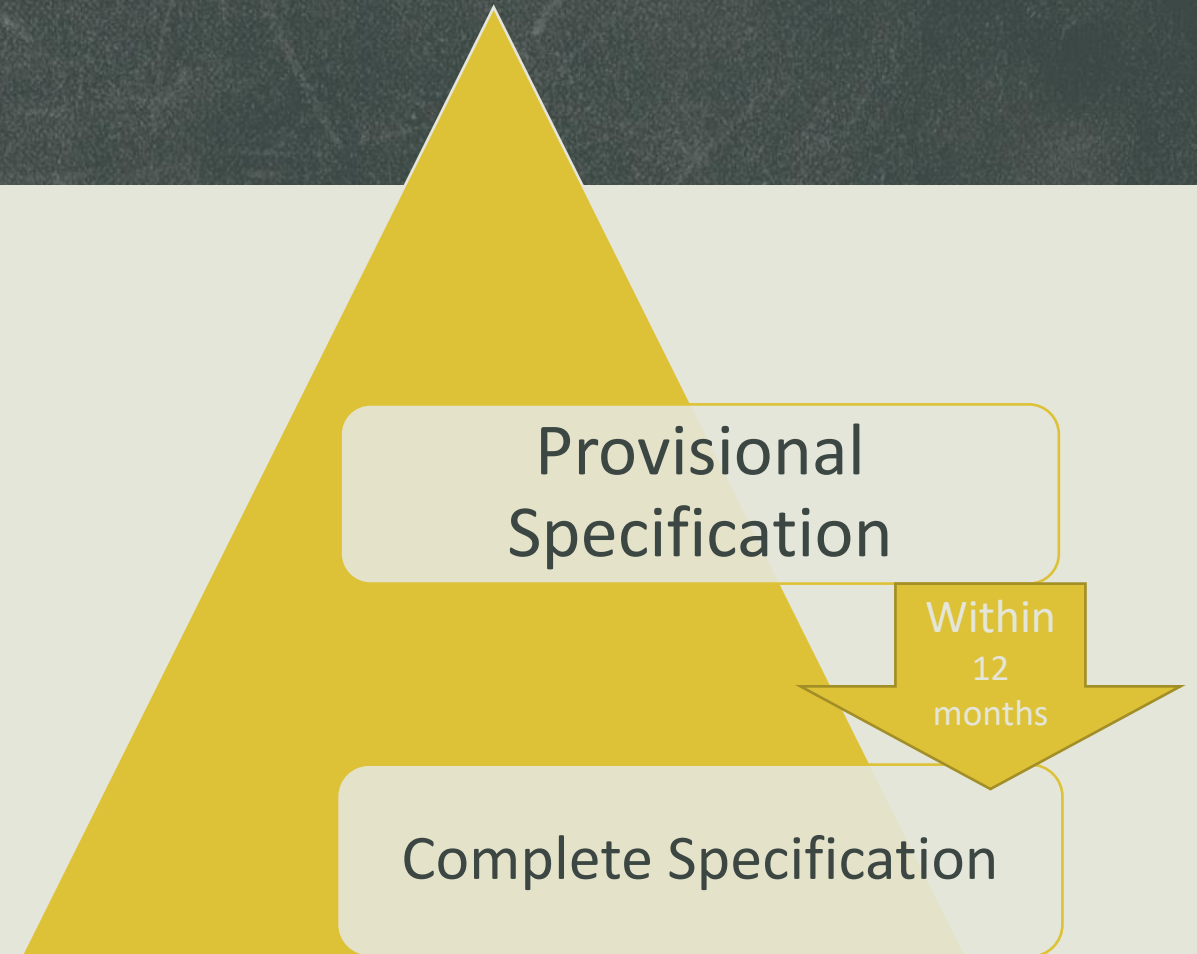
- The Applicant has to furnish following information
 - Applicant's name , Nationality and address.
 - Inventor/s' name , Nationality and address.
 - Address for correspondence.
 - Title of invention
 - Priority Particulars if the application is filed in a convention country.
 - Particulars (International application number and date as allotted by the receiving office) for filing PCT national phase application , if the applicant intends to file international application through PCT.
 - Particulars for Patent Addition, if this application intends to add-on an existing patent application.
 - Para 9 of Form 1 mandates a declaration by the inventors and the applicants as the authenticity of inventor-ship.

Form 2 – Provisional or complete Specification

- Specification describes the invention.
- Provisional Application describes the framework/nature of the invention. No specific format required.
- Complete Specification particularly describes the nature of the invention and the manner in which it is to be performed. The complete specification contains claims.
- Filing a provisional Application quickly gives a priority date.
- Priority date is usually the first filing date of a patent application.

Filing strategy

- 1.Title
- 2.Field of Invention
- 3.Background
- 4.Summary
- 5.List of Drawings
- 6.Detailed Description
- 7.Claims
- 8.Abstract



Forms of Patent filing

Provisional Specification	Complete Specification
Form 1, Form 2 (Provisional Specification) Form 3, Form 26	Form 1 Form 2 (Complete Specification) Form 3 Form 26 Form 5

Foreign Filing rule

- A person residing in India has to obtain permission from the Indian Patent Office before making a direct foreign filing.

Or

- File a provisional or complete specification in India, wait for six weeks, then can make foreign filing if no response is received from Indian Patent Office.

EXAMINATION

- The Applicant has to request for Examination **within 48 months** from the priority date.
- An Applicant can choose to either file a request for a normal examination or file a request for an expedited examination. **(Rule 24C)**
- In order to file for an expedited examination or to convert normal request for examination to expedited request for examination, the following criteria must be met:
 - a. that India has been indicated as the competent International Searching Authority or elected as an International Preliminary Examining Authority in the corresponding international application; or
 - b. that the applicant is a start-up.

Publications

- All applications are published as filed after expiry of 18 months from the date of filing.
- Indian Patent Office publishes only title and abstract of the application in the patent Office Journal. Request for early publication is also possible.
- USPTO, EPO and PCT publish full text of the application as filed.

Examination Cont..

- ii. In case an application is not published, request for expedited examination must be accompanied by a request for publication.
- iii. The Controller shall dispose of the application within 3 months from the date of last reply to the examination report or within 3 months from the last date to put the application in order for grant.
- The timeline to file response to the First Examination Report is 6 months from the date of issuance of the First Examination Report. The timeline to file a response to First Examination Reports issued after May 16, 2016 remains 12 months from the date of issuance of the First Examination Report. (Rule 24B and Rule 24C)

Examination Cont...

Involves:

- (i) Ascertaining
 - (a) Novelty (by Prior Art Search)
 - (b) Utility
 - (c) Inventive Step
 - (d) Statutory Subject Matter
 - (e) Application Formalities
- (ii) Issue of First Examination Report

Cost for expedited examination

Entities	Normal Request for Examination Official Fees (INR)			Expedited Request for Examination Official Fees (INR)
		(i) under section 11B and rule 24(1);	ii) under rule 20(4)(ii).	
Natural Person/Startup	E –filing	4000	5600	4000
	Physical filings	4400	6150	Not allowed
Small entity	E –filing	10000	14000	15000
	Physical filings	11000	15400	Not allowed
Others	E-filing	20000	28000	40000
	Physical filings	22000	30800	Not allowed

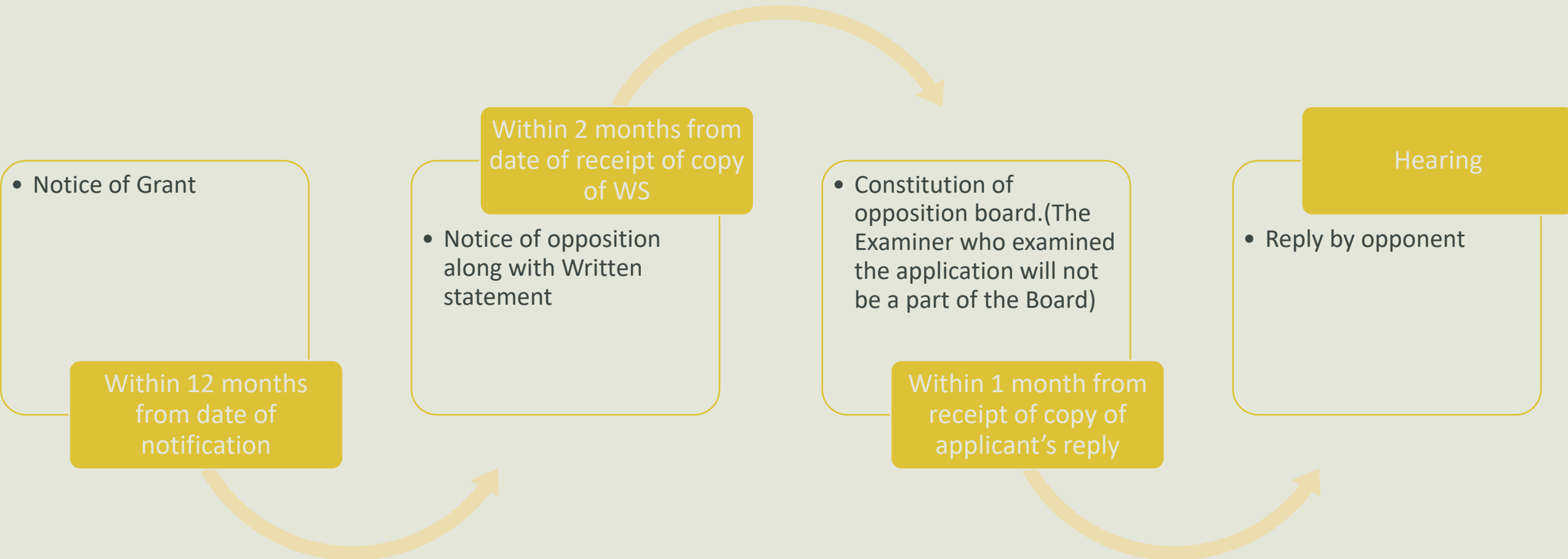
PRE-GRANT OPPOSITION - PROCEDURE



PRE-GRANT OPPOSITION-PROCEDURE

- Summary procedure
- Non appealable order
- No statutory provisions for hearing
- No scope for evidence

POST GRANT OPPOSITION



Grounds for Opposition

- 1. Wrongfully obtaining of the invention or any part thereof by the applicant
- 2. Prior Publication
 - i. Indian Patents from 1.1.1912
 - ii. Any document in India or elsewhere
- 3. Prior Claiming
- 4. Prior public knowledge and prior public use in India
- 5. Obviousness and lacking in inventive step
- 6. Not an invention within the meaning of the Act, or not patentable under the Act

Grounds for Opposition

- 7. Insufficient Disclosure
- 8. Non disclosure or false disclosure of the information regarding foreign filing under section
- 9. Non filing of convention application within 12 months from first priority date
- 10. Non disclosure or wrongful disclosure of the source or geographical origin of biological material used for the invention.
- 11. Anticipation of the invention by the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.

Patent Amendment Rules 2016

- Amended Indian Patents Rules, 2003 came into force with effect from May 16,
- Notified by the Government of India in Gazette of India on October 26, 2015.
- Salient features:
 - CHANGE IN FILING PROCEDURE.
 - Online filing made mandatory .
 - An email id to be provided with Address for communication.
 - Any communication from the patent office to the address/ email id shall be deemed to be properly addressed

Patent Amendment Rules 2016

- **RECOGNIZED AND MADE SPECIAL PROVISIONS FOR STARTUPS.**

- Rule introduced the concept of Start up as an applicant.
- A entity is a start up it is
 - a Private Limited company (as defined in the Companies Act, 2013), or a registered partnership firm registered under section 59 of the Partnership Act, 1932 or a limited liability partnership under the Limited Liability Partnership Act, 2002.
 - Five years should have not lapsed since the date of registration or incorporation of the entity.
 - Turnover in any of the financial year should not be more than INR Twenty Five crores.
 - Entity should not have been formed by splitting up or reconstruction of a business already in existence

Patent Amendment Rules 2016

- Fees as same as that of natural persons .
- Fee has been waived for filing complete specifications after provisional up to 30 pages having up to 10 claims and for withdrawal of the application in terms of the Act and Rules.
- Fee for expedited examination of application is Rs.4000/- for a start up.

Expedited examination

- Form 18A – has been introduced to file a request for an expedited examination for Applicants who choose India as International Search Authority or an International Preliminary Examining Authority.
- As per Rule 24 (C) an applicant may file a request for expedite examination if:
 - he/she has indicated India as the competent International Searching Authority or elected India as an International Preliminary Examining Authority; or
 - applicant is a start-up

TIME PERIOD FOR FILING REPLY TO EXAMINATION REPORT . Rule 24B (6)

- The time period for filing reply to examination Report is reduced to 6 months from 12 months for Examination Report issued after May 18, 2016 .
- Time period for filing response to FER for cases where it has been issued before May 16, 2016 shall remain 12 months from the date on which the same was issued.

Patent Amendment Rules 2016

- **DELETION OF CLAIMS AT THE TIME OF NATIONAL PHASE ENTRY -** International applicants can now delete claims while entering national phase.
- **REFUND OF FEE-** In case of withdrawal of a patent application is made before the issuance of the first examination report , 90% of fees paid for request for examination / expedited examination shall be refunded.
- **AMENDMENTS IN OPPOSITION PROCEEDINGS-** The statement and evidences by the Applicant in its reply to the pre-grant opposition shall be issued to the opponent along with the Patent Office.