

PATENT FILING PROCEDURE

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PATENTS & DESIGNS

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OVERALL VIEW

- Filing an application for Patent
- Date of priority is the date of filing
- Filing a request for examination
- No examination without receiving a request for examination
- Date of filing the request for examination of an application is the basis for the prosecution

PROVISIONAL SPECIFICATION

- FILED WHEN INVENTION IS NOT COMPLETE
- FILED TO OBTAIN A PRIORITY DATE
- NOT SURE TO WHAT EXTENT THE CLAIMS SHOULD BE AS INVENTION IS NOT COMPLETE. HENCE GENERALLY NO CLAIM PORTION
- CLAIMS IN PROVISIONAL IS POSSIBLE WHEN THE APPLICANT REQUESTS TO CONVERT THE COMPLETE SPECIFICATION INTO A PROVISIONAL SPECIFICATION
- FILING MULTIPLE PROVISIONAL SPECIFICATIONS FOR THE SAME INVENTION IS POSSIBLE [PLEASE DO NOT GET CONFUSED WITH PATENT OF ADDITION]

COMPLETE SPECIFICATION

- CAN BE FILED WITHOUT FILING COMPLETE SPECIFICATION [WHEN THE APPLICANT FEELS THAT INVENTION IS COMPLETE]
- IF FILED AFTER PROVISIONAL SHALL DO SO WITHIN NON-EXTENDABLE TIME PERIOD OF 12 MONTHS
- IF NOT FILED WITHIN 12 MONTH STATURORY PERIOD THE APPLICATION IS DEEMED TO BE ABANDONED UNDER SECTION 9(1) OF THE PATENTS ACT.
- COGNATION OF MULTIPLE PROVISIONAL SPECIFICATIONS IS ALLOWABLE, IF SO THE COMPLETE SPECIFICATION SHALL BE FILED WITHIN NON-EXTENDABLE TIME PERIOD OF 12 MONTHS CALCULATED FROM THE EARLIEST PRIORITY
- IF FILED AFTER PROVISIONAL THE SCOPE OF THE INVENTION SHALL NOT GO BEYOND THE SCOPE OF THE INVENTION AS DISCLOSED IN PROVISIONAL SPECIFICATION(S)
- THE COMPLETE SPECIFICATION SHALL BE IN CONFORMITY WITH SECTION 10 OF THE PATENTS ACT

TYPES OF APPLICATIONS

- 1) ORDINARY APPLICATIONS
- 2) DIVISIONAL APPLICATIONS
- 3) PATENT OF ADDITION
- 4) CONVENTION APPLICATION
- 5) PCT NATIONAL PHASE

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- Recent Amendments
under the Indian Patent
Acts and Rules
EFFECTIV FROM 28th
FEBRUARY 2014

PATENTS(AMENDMENT) RULES 2014

FIRST AMENDMENT

●WHO ARE THE APPLICANTS?

- No change in the perception of “Person” of Section 6 of the Act. In other words an inventor, an Assignee or a Legal Representative either alone or jointly with any other person can file the patent application.
- Provided that either alone or in combination with a person of a foreign country is not allowed to file patent wherein there is no reciprocity agreement.
- Definition of “person” is provided in Section 2(1)(s) is.....“Person includes Government”
- Rule 7 describes the differential fee structure for “Natural Person” & “Other than Natural Person” and the fee to be paid was in 1:4 ratio.
- With the latest amendment “Small Entity” was included under the definition of “Person” and incorporated in Rule 2 as (da) and defined under (fa) of the said rule, consequently now there is THREE DIFFERENTIAL FEE STRUCTURES, with THREE DIFFERENT TYPES OF APPLICANTS.
 - NATURAL PERSON
 - SMALL ENTITY
 - OTHER THAN THE ABOVE

PATENTS(AMENDMENT) RULES 2014

FIRST AMENDMENT

• DEFINITION OF SMALL ENTITY

- '(fa) "small entity" means,-
 - (i) in case of an enterprise engaged in the manufacture or production of goods, an enterprise where the investment in plant and machinery **does not exceed the limit specified for a medium enterprise** under clause (a) of sub-section (1) of section 7 of the Micro, Small and Medium Enterprises Development Act, 2006 (27 of 2006); and
 - (ii) in case of an enterprise engaged in providing or rendering of services, an enterprise where the investment in equipment is **not more than the limit specified for medium enterprises** under clause (b) of sub-section (1) of section 7 of the Micro, Small and Medium Enterprises Development Act, 2006.

Section 7 (1)(a) of the Micro, Small and Medium Enterprises Development Act, 2006

- 7. Classification of enterprises.-
- (1) Notwithstanding anything contained in section 11B of the Industries (Development and Regulation) Act, 1951 , the Central Government may, for the purposes of this Act, by notification and having regard to the provisions of sub- sections (4) and (5), classify any class or classes of enterprises, whether proprietorship, Hindu undivided family, association of persons, co- operative society, partnership firm, company or undertaking, by whatever name called,
- (a) in the case of the enterprises engaged in the manufacture or production of goods pertaining to any industry specified in the First Schedule to the Industries (Development and Regulation) Act, 1951 , as
 - (i) **a micro enterprise**, where the investment in plant and machinery **does not exceed twenty- five lakh rupees**;
 - (ii) **a small enterprise**, where the investment in plant and machinery is **more than twenty- five lakh rupees but does not exceed five crore rupees**; or
 - (iii) **a medium enterprise**, where the investment in plant and machinery is more than five crore rupees **but does not exceed ten crore rupees**;

Section 7 (1)(b) of the Micro, Small and Medium Enterprises Development Act, 2006

- (b) in the case of the enterprises engaged in providing or rendering of services, as
- (i) a **micro enterprise**, where the investment in equipment **does not exceed ten lakh rupees**;
- (ii) a **small enterprise**, where the investment in equipment is **more than ten lakh rupees but does not exceed two crore rupees**; or
- (iii) a **medium enterprise**, where the investment in equipment is more than two crore rupees **but does not exceed five crore rupees**. Explanation 1. For the removal of doubts, it is hereby clarified that in calculating the investment in plant and machinery, the cost of pollution control, research and development, industrial safety devices and such other items as may be specified, by notification, shall be excluded. Explanation 2. It is clarified that the provisions of section 29B of the Industries (Development and Regulation) Act, 1951 , shall be applicable to the enterprises specified in sub- clauses (i) and (ii) of clause (a) of sub- section (1) of this section.
- In calculating the investment in plant and machinery, **the cost** of pollution control, research and development, industrial safety devices and such other things as may be specified by notification under the Micro, Small and Medium Enterprises Development Act, 2006 (27 of 2006), **shall be excluded**.

SMALL ENTITY...CONCLUSIONS

- Small Entity is one the following enterprises;

1) Micro Enterprise

2) Small Enterprise &

3) Medium Enterprise

- The maximum limitation for the enterprises engaged in the manufacture or production of goods does not exceed TEN CRORE rupees. [as on date]

- The maximum limitation for the enterprises engaged in providing or rendering of services does not exceed FIVE CRORE rupees. [as on date]

- Note: For foreign applicants the reference rates of foreign currency of the Reserve Bank of India shall prevail.

SMALL ENTITY...CONCLUSIONS

- An enterprise with 10 or 5 crore investment is eligible to claim as small entity.
- To claim small entity status Form-28 is required to be filed.
- The evidence for this claim for an Indian enterprise is the Evidence of registration under the Micro, Small and Medium Enterprises Act, 2006 (27 of 2006).
- The evidence for this claim by a Foreign enterprise is any relevant document issued by that Government.

PATENTS(AMENDMENT) RULES 2014

SECOND AMENDMENT

● RECENT FEE STRUCTURE

- ❖ If the prescribed fee for small entity is Rs. “X”, the prescribed fee for other than the person is “2X”; e.g. if the fee for small entity is Rs. 4000 /- then the fee for legal entity is Rs. 8000/-
- ❖ The fee for the natural person is 60% less by the fee payable by small entity. In other words only 40% of the small entity fee needs to be filed by a natural person. E.g. if the fee payable by the small entity is Rs. 4000/- then the fee to be paid by the natural person will be $4000 \times 40 / 100 = \text{Rs. } 1600/-$
- ❖ The fee structure is initially prepared for e filing pattern. If the applicant does not / could not use the e filing facility then the applicant needs to file 10% additional cost to the e filing fee.
- ❖ In case of provisional specification the additional fee beyond 30 pages only need to be filed along with basic fee and priority fee, if applicable.
- ❖ In case of complete specification either directly or filed after provisional the additional fee beyond 30 pages and additional fee for extra claims need to be filed along with basic fee and priority fee, if applicable.



ABOUT START UP ENTITIES

PATENT AMENDMENT RULES – 2016
MADE EFFECTIVE FROM 16-05-2016

CATEGORY OF APPLICANTS

- NATURAL / INDIVIDUAL PERSON; START UP COMPANY/COMPANIES
- SMALL ENTITY
- OTHER THAN THE ABOVE [e.g. MNCs]

No restriction either on Nationality or Residence

DEFINITIONS – NATURAL PERSON

- Natural person means any individual irrespective of nationality
- No limitation on numbers to apply
- Applicants and inventors may be same or different
- One or more of the inventors can be the applicant(s)
- Includes Assignee or Assignee to Assignee

DEFINITIONS – STARTUP ENTITY

RULE – 2(fa)

- Can be a PRIVATE LIMITE COMPANY (as defined in the Companies Act 2013), or
- Can be a REGISTERED PARTNERSHIP FIRM (registered under Section 59 of the Partnership Act - 1932), or
- Can be a LIMITED LIABILITY PARTNERSHIP (under the Limited Liabilities Partnership Act of 2002)

DEFINITIONS – STARTUP ENTITY

RULE – 2(fa)

An entity is considered to be working towards innovation, development, deployment OR commercialization of new products, processes OR services driven by technology or intellectual property if it aims to develop and commercialize a new product or service or process, OR a significantly improved existing product or service or process that will create or add value for customers or workflow.

DEFINITIONS – WHICH IS NOT A STARTUP ENTITY

RULE – 2(fa)

- Provided that any such entity formed by splitting up or reconstruction of a business already in existence shall not be considered as a startup.
- Provided further that the mere act of developing
 - a. products or services or processes which do not have potential for commercialisation, or
 - b. undifferentiated products or services or processes, or
 - c. products or services or processes with no or limited incremental value for customers or workflow,would not be covered under this definition.

If combined either with small entity or any other entity other than natural person and small entity, the applicants will lose the incentives.

CHANGES IN DEFINITION OF STARTUP

- Definition of startups as given in DPIIT's [April 2018](#) gazette notification, only considered entities up to a period of seven years from the date of incorporation as startups. Further, the entity's annual turnover was not to exceed INR 25 Cr in any of the financial years since incorporation.
- The Department for Promotion of Industry and Internal Trade (DPIIT) has released a gazette notification 19th February 2019, widening the definition of startups from the earlier definition under 'Startup India, Standup India' scheme. In the new definition, an entity will be considered a startup,
- Till up to 10 years from its incorporation date.
- If an entity's turnover for any of the financial years since its incorporation hasn't exceeded INR 100 Cr.

Certain queries on start-ups

- A start-up which has an exclusive agreement with a major MNC to produce a commercializable product sold under the brand name of that MNC can apply over the technical advancement?
- A start-up which has an invention before the end of the first financial year [to prove on turnover of 25 crore] how can prove that it is a start-up company to enjoy the benefits under the new rules.
- How to ascertain on the conditions imposed on the start-ups that the start-ups is using the patented technology or provide an assurance that the product or process which is being developed or developed has potential for obtaining a patent right?
- What is the definition of undifferentiated product(s) or Process(es)?
- How to assess the product(s) / Service(s)/process(es) has/have no or limited incremental value addition to the customers?
- What is the definition for limited incremental value?
- When guidelines are not clear the system will lead to catastrophe and there is a possibility of totally opposite interpretations by the Controllers.

LIMITATIONS OF A STARTUP ENTITY

RULE – 2(fa)

- Encouragement to obtain patent right in India for start ups through concessions and expediting the prosecution of the application is valid ONLY FOR 5 YEARS FROM THE DATE OF REGISTRATION and applicable retrospectively. In other words the applicant shall prove about the status on the date of filing.
- Once 5 year period is over or if its turnover for any previous year exceeds rupees twenty-five crore then the same entity is not considered as “STARTUP ENTITY”. Once eligible the status will not be revised on completion of 5 years during the prosecution of the application.
- Yearly **TURNOVER** [as defined in the Companies Act, 2013 (18 of 2013)] shall not exceed 25 crore [The reference rates of foreign currency of the Reserve Bank of India shall prevail] of any financial year of the 5 year period.

STARTUP ENTITY

RULE – 3(B)

In case an application processed by a startup is fully or partly transferred to any person other than a natural person or a startup, the difference, if any, in the scale of fees between the fees charged from a startup and such person to whom the application is transferred, shall be paid by the new applicant along with the request for transfer:

Explanation.- Where the startup ceases to be a startup after having filed an application for patent due to lapse of more than five years from the date of its incorporation or registration or the turnover subsequently crosses the financial threshold limit as defined, no such difference in the scale of fees shall be payable.

STARTUP ENTITY – EXPEDITED EXAMINATION RULE – 24(C)(1)

- Expedited examination is exclusive for National Phase Applications & Startup Entity Applications.
- For Startup Entity it is applicable retrospectively but the difference of fee shall be paid at the time of making a request.
- Relevant form is 18A along with the fee as specified in the first schedule only by electronic transmission duly authenticated within the period prescribed in rule 24B

STARTUP ENTITY – EXPEDITED EXAMINATION

RULE – 24(C)(2 TO 4)

- A request for examination filed under rule 24B may be converted to a request for expedited examination under sub-rule (1) of rule 24C by paying the relevant fees and submitting requisite documents as required under sub-rule (1).
- Except where the application has already been published under sub-section (2) of section 11A or a request for publication under rule 24A has already been filed, a request for expedited examination shall be accompanied by a request for publication under rule 24A.
- Where the request for expedited examination does not comply with the requirements of this rule, such a request shall be processed in accordance with the provisions contained in rule 24B, with an intimation to the applicant, and shall be deemed to have been filed on the date on which the request for expedited examination was filed.

STARTUP ENTITY – EXPEDITED EXAMINATION

RULE – 24(C)(5-6)

- The Controller shall refer the request for expedited examination along with the application and specification and other documents to the examiner, in respect of the applications where the request for expedited examination has been received, in the order of filing of such requests.
- Provided that a request for expedited examination under this rule filed by a startup shall not be questioned merely on the ground that the startup ceased to be a startup after having filed an application for patent due to the lapse of more than five years from the date of its incorporation or registration, or the turnover subsequently crossed the financial threshold limit, as defined.
- The period within which the examiner shall make the report under sub-section (2) of section 12, shall ordinarily be one month but not exceeding two months from the date of reference of the application to him by the Controller.

STARTUP ENTITY – EXPEDITED EXAMINATION RULE – 24(C)(7-8)-DUTY OF THE CONTROLLER

- The period within which the Controller shall dispose of the report of the examiner shall be one month from the date of receipt of such report by the Controller.
- A first statement of objections along with any document, if required, shall be issued by the Controller to the applicant or his authorised agent within fifteen days from the date of disposal of the report of examiner by the Controller.

STARTUP ENTITY – EXPEDITED EXAMINATION

RULE – 24(C)(9 TO 11)-PROSECUTION

PROCEDURE

- Reply to the first statement of objections and subsequent reply, if any, in respect of an application where the request for expedited examination was filed, shall be processed in the order in which such reply for such application is received.
- The time for putting an application in order for grant under section 21 shall be six months from the date on which the first statement of objections is issued to the applicant.
- The time for putting an application in order for grant under section 21, as prescribed in sub-rule (10) may be further extended for a period of three months on a request for extension made in Form 4 along with the prescribed fee, made to the Controller before the expiry of the period specified under sub-rule (10).

STARTUP ENTITY – EXPEDITED EXAMINATION
RULE – 24(C)(12) –DISPOSAL BY CONTROLLER

- The Controller shall dispose of the application within a period of **THREE MONTHS** from the **date of receipt of the last reply** to the first statement of objections **or** within a period of **three months** from the last date to put the application in order for grant under section 21 of the Act, whichever is earlier:
- Provided that this time limit shall not be applicable in case of pre-grant opposition.

STARTUP ENTITY – EXPEDITED EXAMINATION SPECIAL RULE – 24(C)(13)

Notwithstanding anything contained in this rule, the Controller may limit the number of requests for expedited examination to be received during the year by way of a notice to be published in the official journal.

PATENT AMENDMENT RULES 2019

EXPEDITED EXAMINATION

4. In the said rules, in rule 24 C, in sub-rule (1), for clause (b), the following shall be substituted, namely:-

“(b) that the applicant is a **startup**; or

(c) that the applicant is a small entity; or

(d) that if the applicant is a natural person or in the case of joint applicants, all the applicants are natural persons, then the applicant or **at least one of the applicants is a female**; or

(e) that the applicant is a department of the Government; or

(f) that the applicant is an institution established by a Central, Provincial or State Act, which is owned or controlled by the Government; or

(g) that the applicant is a Government company as defined in clause (45) of section 2 of the Companies Act, 2013 (18 of 2013); or

(h) **that the applicant is an institution wholly or substantially financed by the Government;**

EXPLANATIONS

1. Explanation:- For the purpose of this clause, the term 'substantially financed' shall have the same meaning as in the Explanation to sub-section (1) of section 14 of the Comptroller and Auditor General's (Duties, Powers and Conditions of Service) Act, 1971(56 of 1971); or (i) that the application pertains to a sector which is notified by the Central Government on the basis of a request from the head of a department of the Central Government.: Provided that public comments are invited before any such notification; or (j) that the applicant is eligible under an arrangement for processing a patent application pursuant to an agreement between Indian Patent Office and a foreign Patent Office.
2. Explanation:- The patentability of patent applications filed under clause (j) above will be in accordance with the relevant provisions of the Act."

PATENT AMENDMENT RULES – 2016

MADE EFFECTIVE FROM 16-05-2016

FILING PROCEDURE BY AUTHORIZED PATENT AGENTS

- Rule 6(1A)
- Notwithstanding anything contained in sub-rule (1), a patent agent shall file, leave, make or give ALL DOCUMENTS ONLY BY ELECTRONIC TRANSMISSION duly authenticated, including scanned copies of documents that are required to be submitted in original:
- Provided that 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.

EXPLANATION

The following documents shall be filed in physical form as well.

- (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 applicant
- (d) Rule 13(6): Declaration of Inventorship
- (e) Rule 21: Priority Document

PATENT AMENDMENT RULES – 2016

MADE EFFECTIVE FROM 16-05-2016

HOW OFFICE WILL COMMUNICATE?

Every person, concerned in any proceedings to which the Act or these rules relate and every patentee, shall furnish to the Controller an address for service, **including a postal address in India and an e-mail address**, and such address for service shall be treated for all purposes connected with such proceedings or patent as the address of the person concerned in the proceedings or of the patentee. Unless such an address for service is given, the Controller shall be under no obligation either to proceed or deal with any proceeding, or patent or to send any notice that may be required to be given under the Act or these rules and the Controller may take *suo motu* decision in the matter: Provided that a patent agent shall also be **required to furnish to the Controller a mobile number registered in India.**

PATENT AMENDMENT RULES – 2016

MADE EFFECTIVE FROM 16-05-2016

WHAT ABOUT FEE PAYMENT?

- Rule 7(1)(a): The fees payable under the Act or these rules may be paid at the appropriate office either in cash or through electronic means or may be sent by bank draft or banker's cheque payable to the Controller of Patents and drawn on a scheduled bank at the place where the appropriate office is situated and if the draft or banker's cheque is sent by post, the fees shall be deemed to have been paid on the date on which the draft or banker's cheque has actually reached the Controller.
- The above rule causes confusion because certain documents need to be filed physically within 15 days which may follow either by filing certain petitions or certain forms, say for example, form-4; form-13; form-6 etcetera and wherein fee required can be filed even by draft or banker's cheque and there is no compulsion on fee payment to be made only through electronic means. Of course, module may not allow to file any forms that are need to be accompanied by an stipulated fee for uploading the said documents. If fee is not made electronically then the date of filing the documents will automatically be post dated to the date of realization of draft or cheque. [caution to be noted here]. But in the office either the draft or cheque from the agents are not accepted.
- For every act where there is no specific purpose there is a Form-30 for which the fee which needs to be paid is "AS APPLICABLE". [THIS FORM DOES NOT REPLACE A PETITION]

MANDATORY FORMS

- FORM – 1 [REQUEST FOR GRANT OF PATENT RIGHT]
- FORM – 2 [SPECIFICATION]
- FORM – 18 [REQUEST FOR EXAMINATION]

OPTIONAL FORM

- FORM – 9 [REQUEST FOR EARLY PUBLICATION]
- PATENT WILL NOT BE GRANTED WITHIN 6 MONTHS FROM THE DATE OF PUBLICATION
- PUBLICATION DOES NOT DESTROY THE PRIORITY DATE
- PROVISIONAL RIGHT STARTS FROM THE DATE OF PUBLICATION BUT CAN NOT SUE AN INFRINGER IN THE COURT OF LAW TILL THE ACTUAL GRANT OF PATENT
- GUESS THEN WHAT IS EFFECTIVE TERM OF PATENT?

FORM – 1

- Application for grant of patent
- Application for ordinary, convention, divisional, patent of addition and National application through PCT.
- Can be filed by an inventor or assignee or assignee to assignee
- Can be filed by any individual or legal entity, includes small entity.
- No restriction on the number of applicants
- A combination of individual & legal entity is allowed
- Jurisdiction is decided on the address of the first applicant
- Has a provision for endorsement / assignment

FORM-1 RELATED FEES

- When it is e-filing then for natural person; for small entity; and for others other than natural and small entity will be Rupees 1600; 4000; 8000 in the same order.
- When it is physical filing then for natural person; for small entity; and for others other than natural and small entity will be Rupees 1760; 4400; 8800 in the same order.
- If multiple priorities are claimed then the given fee shall be multiplied with number of priorities.

PROOF OF RIGHT

- Proof of right to make an application shall be furnished either along with form – 1 or within 6 months from the date of filing the application.
- Extension of time till the date of acceptance is possible by filing a petition under section 7 (2) and by remitting the prescribed fee.
- When it is e-filing then for natural person; for small entity; and for others other than natural and small entity will be Rupees 1600; 4000; 8000 in the same order.
- When it is physical filing then for natural person; for small entity; and for others other than natural and small entity will be Rupees 1760; 4400; 8800 in the same order.

FORM – 2

Form – 2

THE PATENTS ACT, 1970

(39 OF 1970)

AND

THE PATENTS RULES, 2003

PROVISIONAL / COMPLETE SPECIFICATION

(See Section 10; rule 13)

TITLE OF THE INVENTION

APPLICANT(S)

Name:

Nationality:

Address:

Preamble: The following specification

Describes the invention (for provisional)

Preamble: The following specification particularly

Describes the invention and the manner in

Which it is to be performed (for complete)

FORM – 2

- Fee for each sheet of specification in addition to 30 is Rs. 160/- ; Rs. 400/- ; Rs.800/- OR Rs. 176/-; Rs.440/- Rs. 880/- as applicable.
- Fee for each claim in addition to 10 is Rs.320/-; Rs. 800/- ; Rs 1600/- OR Rs. 352/-; Rs. 880/-; Rs 1760/- as applicable.
- Provisional filing is optional, if filed, the complete specification shall be filed within 12 months from the date of filing the provisional
- No extention of time is allowed
- No claims are allowed in the provisional specification
- **Cognation of different provisional specifications filed by the same applicant is allowed**

REQUEST FOR EXAMINATION

FORM -- 18

- Can be filed along with the complete specification
- Can be filed within 48 months from the date of filing the specification
- Can not be filed along with provisional specification
- Fee of Rs.4000/- ; Rs.10000/-; Rs.20000/- OR Rs.4400/- ; Rs. 11000/-; Rs.22000/- as applicable shall be paid.
[Section 11B & Rule 24(1)]
- For early examination of National Phase applications under PCT a fee of Rs. 5600/-; Rs. 14000/- Rs. 28000/- OR Rs. 6160/-; Rs. 15400/-; Rs.30800/- as applicable shall be paid [Rule 20(4)(ii)]
- No examination / prosecution without Form 18

SPECIAL MANDATORY FORMS

- **FORM – 3** [FOREIGN FILING PARTICULARS]
- **FORM – 5** [POSSIBILITY OF ADDITION OF INVENTORS & MANDATORY WHEN
 - a) COMPLETE FOLLOWED BY PROVISIONAL
 - b) CONVENTION APPLICATION
 - c) NATIONAL PHASE OF PCT APPLICATIONARE FILED]

FORM – 3

- Mandatory if the applicant has filed in foreign country(ies) either filing before or filing after the date of filing in India
- The details of foreign filing, filed before the date of filing shall be furnished either along with the application or within 6 months as allowed by the Controller
- The details of foreign filing, filed after the date of filing in India, shall be filed within 6 months from the date of filing in that foreign country
- Extention of time is allowable by filing a petition under rule 138
- Petition under rule 138 shall be filed before the expiry of 6 month period and maximum extention is allowed by ONLY ONE MONTH.
- The details includes the name of the country, the application number and the status of the application
- The details shall be provided till the date of grant
- Failure to do so becomes one of the grounds for the opposition

DECLARATION OF INVENTORSHIP (Form – 5)

- Shall be filed along with the complete specification which is filed after provisional specification
- Shall be filed along with convention application [no possibility of filing provisional]
- Shall be filed along with National Phase application [under PCT] [no possibility of filing provisional specification]
- Only opportunity to add additional inventors

FORM AND OR PETITION FOR SEEKING EXTENTION OF TIME

- FORM – 4
 - a) CAN BE FILED DURING ALLOWABLE EXTENTION OF TIME
 - b) APPLICABLE ONLY TO SECTION 53(2) & 142(4) [RENEWAL FEE & RECORDAL FEE RESPECTIVELY] & RULES 13 (6) [FORM-5 FILING] & 130 [REVIEW PETITION]
 - c) MONTHLY FEE [480/1200/2400] NEED TO BE PAID. [10% extra for physical filing]
- PETITION UNDER RULE 138
 - a) SHALL BE FILED BEFORE THE STIPULATED PERIOD
 - b) MAXIMUM EXTENTION OF ONE MONTH PER RQUEST IS ALLOWED
 - c) FIXED FEE [1600/4000/8000] NEED TO BE PAID. [10% extra for physical filing]
 - d) MULTIPLE REQUESTS ARE ALLOWABLE

THE ABOVE FORM 4 & PETITION ARE NOT ALLOWABLE FOR NON EXTANDABLE TIME LIMITS SUCH AS FILING COMPLETE AFTER PROVISIONAL, CONVENTION APPLICATION, NATIONAL PHASE ENTRY, FORM -18 FILING, 12 MONTH PERIOD TO COMPLY WITH REQUIREMENTS OF FIRST EXAMINATION REPORT ETC.,

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 Extend able 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 petitio n	ONE month	ONE month	During Extend able period	-do-

DRAWINGS / FIGURES/ FLOW CHARTS

- No drawings or sketch, which would require a special illustration of the specification, shall appear in the specification itself
- At least one copy of the drawing shall be prepared neatly and clearly on a durable paper sheet
- Drawings shall be on a scale sufficiently large to show the inventions clearly and dimensions shall not be marked on the drawings

DRAWINGS / FIGURES/ FLOW CHARTS

- Drawings shall be sequentially or systematically numbered and shall bear—
 - (i) in the left hand top corner, the name of the applicant
 - (ii) in the right hand top corner, the number of the sheets of drawings, and the consecutive number of each sheet; and
 - (iii) in the right hand bottom corner, the signature of the applicant or his agent
- No descriptive matter shall appear on the drawings except in the flow diagrams.

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ABSTRACT

- To provide technical information on the invention
- Shall commence with the title of the invention and normally not more than 15 words
- The summary shall indicate clearly the technical field to which the invention belongs, technical problem to which the invention relates and the solution to the problem through the invention and principal use or uses of the invention and contain not more than 150 words
- If necessary, shall contain chemical formula, which characterizes the invention

ABSTRACT

- If the specification contains any drawing, the applicant shall indicate on the abstract the figure, or exceptionally, the figures of the drawings in the abstract
- The indicated drawings shall be published along with the abstract
- The abstract is the efficient instrument for the purposes of search in the particular technical field, in particular by making it possible to assess whether there is a need to consult the specification itself

PUBLICATIONS

- Date of filing is the date of filing either provisional or complete specification
- First publication in the patent journal is as soon as at the expiry of 18 months from the date of filing
- The period of 18 month can be shortened by filing Form– 9
- Ordinarily published within ONE month from the expiry period
- No Publication when secrecy is clamped or abandoned under S 9(1) or application is withdrawn within 15 months from the date of filing
- Effect of 18 month publication are
 - (a) The patent specification opens to public
 - (b) the depository institution shall make the biological material mentioned in the specification available to the public
 - (c) open invitation to file pre-grant opposition by way of representation by any person within 6 months from the date of publication or before the date of grant which ever is later.
 - (d) Loss of Novelty

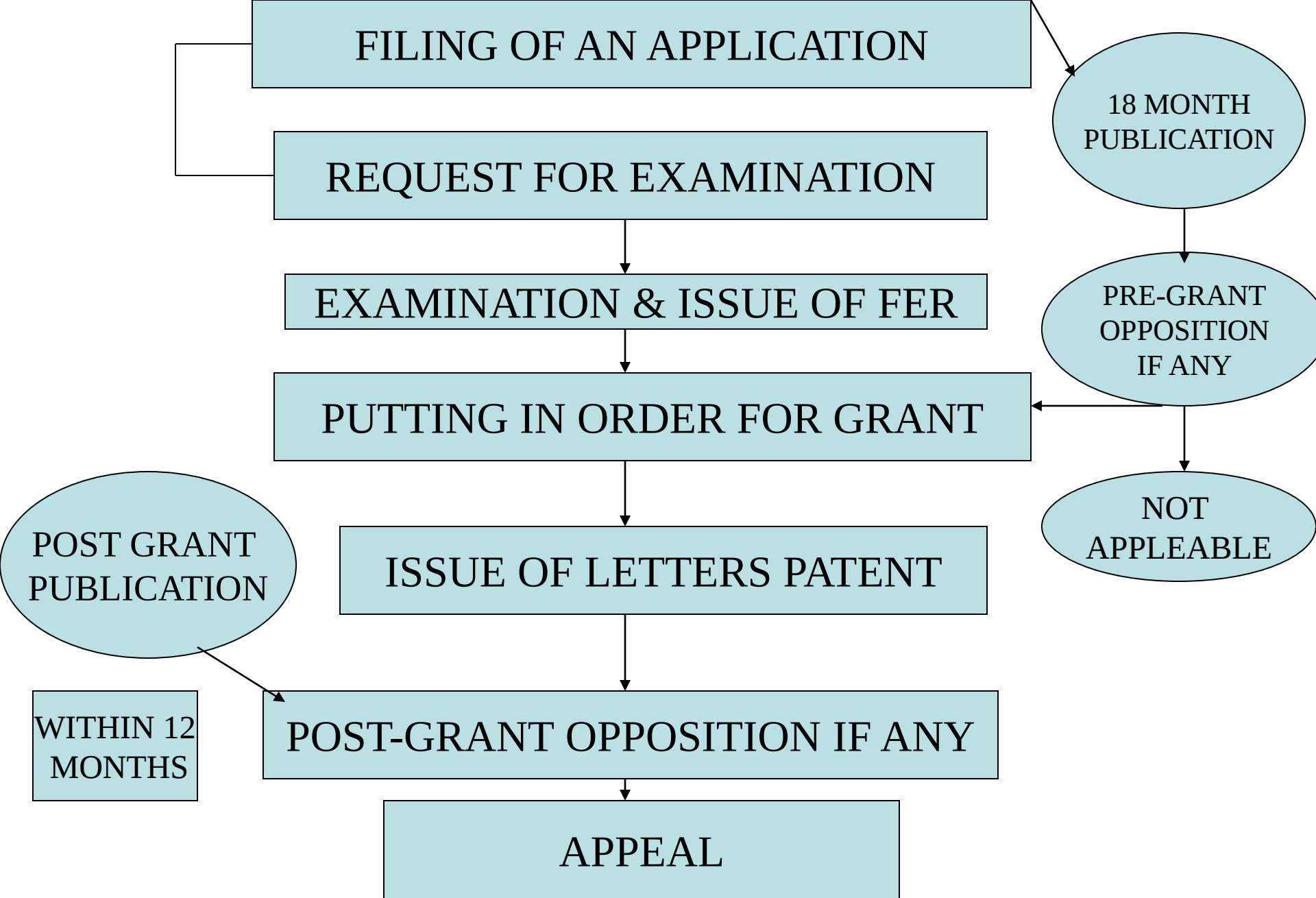
PUBLICATIONS

- The fact of grant of patent will be published in the patent journal as soon as patent is granted
- The applicant / patentee is entitled to institute any proceedings for infringement with retrospective effect from the 18 month publication
- Post-grant opposition can be filed within 12 months from the date of publication of grant of patent

TECHNICAL REQUIREMENTS

COMPLETE SPECIFICATION

- Contents of the specification
- The opening line should read as, "This invention relates to (Title of the Invention)"
- Technical field of invention.
- Prior art with short comings
- Problem with the existing art.
- Proposed technical solution.
- Brief description of the accompanying drawings, if any.
- Detailed description of the invention
- Examples
- Claims.



THANK you