

2017

FREQUENTLY ASKED QUESTIONS- PATENTS

Disclaimer:-The replies given to the probable questions are for the purpose of guiding public and cannot be quoted in any legal proceedings. They will have no legal purpose. The users are advised to refer to the provisions of the Patents Act 1970 as amended and the Patents Rules 2003 as amended including the latest fee schedules, available at www.ipindia.nic.in



GENERAL INFORMATION:

1. What is a Patent?

A Patent is a statutory right for an invention granted for a limited period of time to the patentee by the Government, in exchange of full disclosure of his invention for excluding others, from making, using, selling, importing the patented product or process for producing that product for those purposes without his consent.

2. What is the term of a patent in the Indian system?

The term of every patent granted is 20 years from the date of filing of application. However, for application filed under national phase under Patent Cooperation Treaty(PCT), the term of patent will be 20 years from the international filing date accorded under PCT.

3. Which Act governs the patent system in India?

The patent system in India is governed by the Patents Act, 1970 (No.39 of 1970) as amended by the Patents (Amendment) Act, 2005 and the Patents Rules, 2003. The Patent Rules are regularly amended in consonance with the changing environment, most recent being in 2016.

4. Does Indian Patent give protection worldwide?

No. Patent protection is a territorial right and therefore it is effective only within the territory of India. There is no concept of global patent.

However, filing an application in India enables the applicant to file a corresponding application for same invention in convention countries or under PCT, within or before expiry of twelve months from the filing date in India. Patents should be obtained in each country where the applicant requires protection of his invention.

5. What can be patented?

An invention relating either to a product or process that is new, involving inventive step and capable of industrial application can be patented. However, it must not fall into the categories of inventions that are non-patentable under sections 3 and 4 of the Act.

6. What is the criteria of patentability?

An invention is patentable subject matter if it meets the following criteria -

- i) It should be novel.
- ii) It should have inventive step or it must be non-obvious
- iii) It should be capable of Industrial application.
- iv) It should not attract the provisions of section 3 and 4 of the Patents Act 1970.

7. What types of inventions are not patentable in India?

An invention may satisfy the condition of novelty, inventiveness and usefulness but it may not qualify for a patent under the following situations:

- i. an invention which is frivolous or which claims anything obviously contrary to well established natural laws;
- ii. an invention the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment;
- iii. the mere discovery of scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature;
- iv. the mere discovery of a new form of a known substance which does not result in enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known

process, machine or apparatus unless such known process results in a new product or employs at least one new reactant;

Explanation: *For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regards to efficacy.*

- v. a substance obtained by mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;
- vi. the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;
- viii. a method of agriculture or horticulture;
- ix. any process for medicinal, surgical, curative, prophylactic (diagnostic, therapeutic) or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products;
- x. plants and animals in whole or any part thereof other than microorganisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;
- xi. a mathematical or business method or a computer program *per se* or algorithms;
- xii. a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;
- xiii. a mere scheme or rule or method of performing mental act or method of playing game;
- xiv. a presentation of information;
- xv. topography of integrated circuits;
- xvi. an invention which, in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components;
- xvii. inventions relating to atomic energy;

8. When should an application for a patent be filed?

An application for a patent can be filed at the earliest possible date and should not be delayed. An application filed with provisional specification, disclosing the essence of the nature of the invention helps to register the priority of the invention. Delay in filing an application may entail some risks such as (i) some other inventor might file a patent application on the said invention and (ii) there may be either an inadvertent publication of the invention by the inventor himself/herself or by others independently of him/her.

9. Can any invention be patented after publication or display in the public exhibition?

Generally, an invention which has been either published or publicly displayed cannot be patented as such publication or public display leads to lack of novelty. However, under certain circumstances, the Patents Act provides a **grace period of 12 months** for filing of patent application from the date of its publication in a journal or its public display in an exhibition organised by the Government or disclosure before any learned society or published by applicant. The detailed conditions are provided under Chapter VI of the Act (Section 29-34).

10. Does the Patent Office keep information of the invention secret?

Yes. All the patent applications are kept secret upto 18 months from the date of filing or priority date whichever is earlier and thereafter they are published in the Official Journal of the Patent Office which is published every week and also available on the IPO website. After its publication, public can inspect the documents and also may take the photocopy thereof on payment of the fee as prescribed.

11. Is it necessary to visit the Indian Patent Office to transact any business relating to patent application?

It is not necessary to visit the patent office to file the application as online filing facility is provided. Only in case the application is required to be filed offline, the same can be filed physically at the counter of the Office. Moreover, all the communications with the office are

made through emails. However, hearing proceedings relating to patent application can be attended with prior appointment on any working day during prosecution stage.

12. Where can one find the information relating to published/ granted patent application?

The information relating to the patent application is published in the Patent office Journal issued on every Friday. This is also available in electronic form on the website of the Patent Office, www.ipindia.nic.in.

13. What are the contents of the Patent office Journal?

The Patent office Journal contains information relating to patent applications which are published u/s 11A, post grant publication, restoration of patent, notifications , list of non-working patents and public notices issued by the Patent Office.

14. Can one subscribe a copy of the Patent office Journal?

There is no need to subscribe the Patent Office journal as same is published online and is available free of cost on patent office site i.e. www.ipindia.nic.in.

FILING RELATED INFORMATION:**15. Who can apply for a patent?**

A patent application can be filed either by true and first inventor or his assignee, either alone or jointly with any other person. However, legal representative of any deceased person can also make an application for patent.

16. How can I apply for a patent?

A patent application can be filed with Indian Patent Office either with provisional specification or with complete specification along with fee as prescribed in schedule I. In case the application is filed with provisional specification, then one has to file complete specification within 12 months from the date of filing of the provisional application. There is no further extension of time to file complete specification after expiry of said period.

17. Is there provision for filing patent application electronically by online system?

Yes, one can file patent applications through comprehensive online filing system at <https://ipindiaonline.gov.in/epatentfiling/goForLogin/doLogin>. More information for filing online application is available on the website of Patent Office i.e. www.ipindia.nic.in.

18. How can one register for online filing of patent application?

To register for filing of patent application, the user is required to obtain the Class III digital signature. After obtaining the digital signature, the user can register himself on the CGPDTM website by creating his user ID and password.

19. How to obtain digital signature?

The digital signatures can be obtained from the certifying authorities such as (n)Code solutions, TCS and SAFESCRIP T or eMudra

20. In which language can an application for patent be filed with the Indian Patent Office?

An application for patent can be filed either in Hindi or English.

21. Is there any jurisdiction for filing patent application in India?

Yes, India has four patent offices located at Kolkata, New Delhi, Mumbai and Chennai. Each office has a separate territorial jurisdiction. The appropriate office for all proceedings including filing of the application depends normally where the applicant/first mentioned applicant resides/has domicile/has place of business/has origin of invention. In case of foreign applicants, it depends on the address for service in India given by such applicant.

22. When can an applicant withdraw patent application in India?

In India, a patent application can be withdrawn in the following ways:

- a request for the withdrawal of the application can be filed within 15 months of the date of filing or date of priority, whichever is earlier and accordingly the application will not be published and be treated as **—withdrawn**.
- An applicant can withdraw the application before the issuance of the First Examination Report. However, on withdrawal of the application, applicant can claim a refund of up to 90% of examination fees.
- An applicant can withdraw the application any time after its filing but before the grant of patent by making a request. There is no fee for withdrawing the application. And also there is no refund of examination fee.

23. What are the types of applications?

The types of applications that can be filed are:

A) PROVISIONAL APPLICATION

Indian Patent Law follows first to file system. A provisional application is an application which can be filed if the invention is still under experimentation stage. Filing a provisional specification provides the **advantage to the inventor since it helps** in establishing a **—priority** date of the invention. Further, the inventor gets 12 months' time to fully develop the invention and ascertain its market potential and to file the complete specification.

B) ORDINARY APPLICATION

An application for patent filed in the Patent Office without claiming any priority either in a convention country or without any reference to any other earlier application under process in the office. Such type of application is known as an ordinary application.

C) CONVENTION APPLICATION

An application for patent filed in the Patent Office, claiming a priority date based on the same or substantially similar application filed in one or more of the convention countries is known as a convention application. In order to get convention status, an applicant should file the application in the Indian Patent Office within 12 months from the date of first filing of a similar application in the convention country.

D) PCT INTERNATIONAL APPLICATION

An Application filed in India as Receiving Office (RO) under Patent Cooperation Treaty is an international application which can be filed in more than 150 countries by a single application.

E) PCT NATIONAL PHASE APPLICATION

When an international application is made according to PCT designating India, an applicant can file the national phase application in India within 31 months from the international filing date or the priority date, whichever is earlier.

F) PATENT OF ADDITION

When an invention is a slight modification of the earlier invention for which he has already applied for or has obtained patent, the applicant can go for patent of addition if the modification in the invention is new. One of the benefits of filing patent of addition is that there is no need to pay separate renewal fee for the patent of addition during the term of the main patent and it expires along with the main patent.

G) DIVISIONAL APPLICATION

When an application claims more than one invention, the applicant on his own or to meet the official objection on the ground of plurality or distinct invention may divide the application and file two or more applications, as the case may be for each of the inventions. This type of application, divided out of the parent one, is known as a Divisional Application. The priority date for all the divisional applications will be same as that of the main (the Parent) Application (Ante-dating).

24. Is it necessary to file a provisional application?

Generally, when an invention is not complete an application can be filed with provisional specification which is known as provisional application. This is useful in establishing a priority date for your invention. Moreover, it also gives sufficient time to the applicant to assess and evaluate the market potential of his invention before filing complete specification. However, it is not necessary to file an application with provisional specification and one can file application directly with complete specification.

25. When is an application for patent published?

Every application for patent is published after expiry of 18 months from the date of its filing or priority date whichever is earlier. However, following applications are not published.

- A) Application in which secrecy direction is imposed
- B) Application which has been abandoned u/s 9(1) and i.e when a provisional application has been filed and the complete application has not been filed within 12 months from the filing of the provisional application
- C) Application which has been withdrawn 3 months prior to 18 months

26. Is there any provision in the Patents Act for early publication?

Yes, the applicant can make a request for early publication in **Form 9** along with the prescribed fee. After receiving such request the Patent Office publishes such application within a period of one month provided the invention contained thereon does not relate to Atomic energy or Defence purpose.

27. What are the facilities available for an applicant to pay the fees?

The applicant can pay the fee either at cash counter or online through a comprehensive payment gateway which includes net banking, payment by Debit/Credit card. More than 70 banks are part of this payment gateway.

28. What are the forms required to be filled for filing of a patent application in India?

Generally, in order to file an application, an applicant is required to file Form 1 which is a request for filing an application and Form 2 which is either a provisional or complete specification or drawings if any. In addition to these, an abstract of the invention is also required. If the application is filed through a registered patent agent, a power of authority in favour of the said agent in Form 26 is also required. However, depending upon various

circumstances, following forms may also be required. The application can be examined only after receipt of request for examination on Form 18. The important forms are listed below:



29. What time lines are to be adhered to while prosecuting a patent application in India?

Following are some of the important time lines to be observed by an applicant during the prosecution of a patent application.

Filing of Complete Specification following provisional specification (Form 2)	•Within 12 months of filing the provisional specification
Statement and undertaking regarding foreign applications (Form 3)	•Within 6 months from the date of filing of application
Request for examination (Form 18)	•Forty eight months from the date of filing or priority, whichever is earlier
Declaration of Inventorship (Form 5)	•With the complete specification or within one month from the date of filing of the complete specification
Time for replying to the First Examination report (FER)	•6 months from the date of issuance of the FER, extendable upto 3 months. Total 9 months.
Pre-grant opposition (Form 7A)	•After publication of the application and any time before the grant of patent
Post-grant opposition (Form 7)	•One year from the date of publication of grant of patent
Reference to deposit of biological material	•Within 3 months from the date of filing of application
Furnishing information relating to working of patent (Form 27)	•Working statements regarding the working of patented inventions in a calendar year is required to be submitted for every granted patent within 3 months from the end of every calendar year i.e. 31st March of every year. Therefore for submission of working statements for calendar year 2017 due date is 31st March 2018.

30. Is patent application once filed examined automatically?

A patent application is not examined automatically after its filing. The examination is done only after receipt of the request of examination in **Form 18** either from the applicant or from third party or Form 18A for expedited examination (under conditions as prescribed in the Rules).

31. When can the request for examination be filed?

The request for examination can be filed within a period of 48 months from the date of priority or date of filing of the application whichever is earlier. For more details kindly refer to rule 24B of the Patents Rules 2003 as amended.

32. Is there any provision for expedited examination?

Yes, as per Rule 24C of the Patent Rules as amended in 2016, a request for expedited examination can be filed with the prescribed fees in Form 18A along with the fee as specified in the first schedule only by electronic transmission duly authenticated within the period prescribed in rule 24B on any of the following grounds, namely:

(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 startup.

33. What happens to a patent application once it is examined?

After examination, the Patent office issues an examination report to the applicant which is generally known as First Examination Report (FER). Thereafter the applicant is required to comply with the requirements within a period of 6 months from the date of FER which can be extended by 3 months. In case, the application is found to be in order for grant, the patent is granted, provided there no pre-grant opposition is filed or pending. A letter patent is issued to the applicant. However, in case a pre-grant opposition is pending, the further action is taken after disposition of the pre-grant opposition.

34. What happens when applicant is not able to meet the requirement within the prescribed time?

If the applicant does not file a reply within **6 months or does not take an extension of 3 months**, the application is deemed to have been abandoned.

35. Is there provision for extension beyond time limit of 9 months?

No, there is no provision for extension of time beyond the said period.

36. Does an applicant get an opportunity of being heard before his application is refused?

If applicant has not complied with the requirements within the prescribed time, the Controller shall provide an opportunity of being heard to the applicant before refusing his application if a request for such hearing has been made by the applicant at least 10 days in advance before expiry of the statutory period.

37. What is time limit for filing the representation for pre-grant opposition?

A representation for pre-grant opposition under section 25(1) of Patents Act, 1970 can be filed, on Form 7A within six months from the date of publication of the application u/s 11A or before the grant of patent.

38. Is there any fee for filing such representation for pre-grant opposition?

No, there is no fee for filing representation for pre-grant opposition? This can be filed by any person.

39. What are the grounds for filing representation for pre-grant opposition?

The grounds for filing pre-grant opposition are contained in section 25(1) of the Patents Act 1970.

40. Is it possible to file pre-grant opposition even though there is no request for examination filed?

Yes, it is possible to file representation for pre-grant opposition even though there is no request for examination has been filed. However, the representation will be considered only when a request for examination is received within the prescribed period.

41. What is the time limit for filing post-grant opposition in the patent office?

The time for filing post-grant opposition is 12 months from the date of publication of the grant of patent in the official journal of the patent office.

42. Is there any fee for filing post-grant opposition?

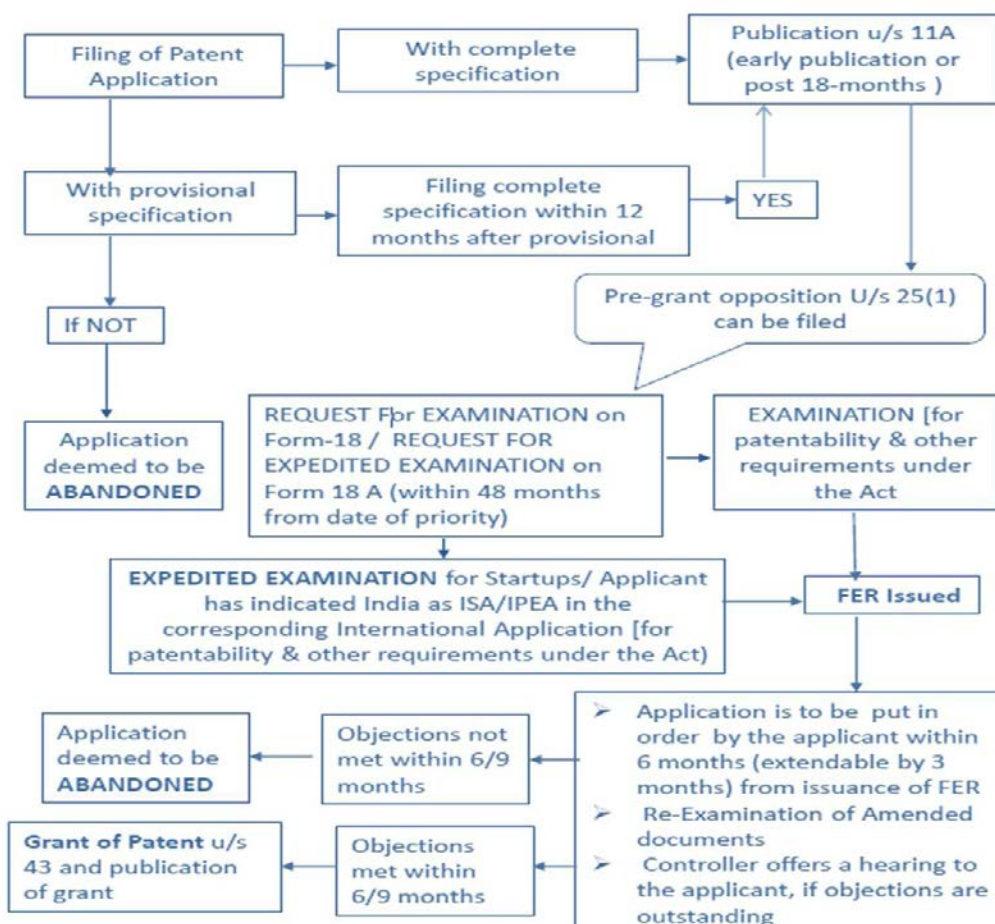
Yes, the post grant opposition has to be filed in the prescribed Form 7 along with prescribed fees as mentioned in First Schedule in Patents Rules 2003.. The post grant opposition has to be filed by the person interested and not by any other person.

43. What are the grounds for filing the post grant opposition?

The grounds for filing post-grant opposition are contained in section 25(2) of the Patents Act 1970.

LIFE CYCLE OF A PATENT APPLICATION

1. Patent Flow Chart



OTHER INFORMATION:**44. What are the e-filing facilities available at www.ipindia.nic.in?**

The following are the e-filing facilities available for an applicant:

- Comprehensive e-filing facility for Patents and Designs,
- Comprehensive payment gate way including net banking, payment by Debit/Credit card
- Web based Simple Registration process and filing procedure
- Real time Validations with IPO Patent database
- Manage User Profile and Folders
- 10% fee reduction on online filing compared to offline filing to promote online filing.
- Request for expedited examination- only through e-filing

45. Does patent office help in finding users for patent?

The Patent Office has no role beyond grant of patent. Since patents are private rights the patent owner is responsible for commercializing the patent either himself or through licensee. However, the information relating to grant of patent is published in the Patent Office journal and also published on the Patent Office website which is accessible to the public worldwide. This certainly may help the applicant to attract potential user or licensee. The patent office also compiles and updates a list of patents which are lapsed/ceased in India.

46. Is Indian patent database searchable? How can one find out whether an invention is already patented?

The person concerned can perform a search free of cost on Indian Patent database consisting of published patent applications and granted patents. The said database is available on Patent Office website as **inPASS**<http://ipindiaservices.gov.in/publicsearch>. Further, the website (www.ipindia.nic.in) contains innovative tools under **DYNAMIC UTILITIES** which gives information about the patent applications at various stages of processing.

47. Is there any difference in the amount of fees to be paid by an individual or a legal entity for filing a patent application?

Yes, the Patent Rules provides for different fee for individuals/Startups, SME's and legal entity. Details can be seen in the First Schedule of the Patents Rules, 2003 as amended from time to time.

48. What are obligations of the patentee after the grant of patent?

After the grant of patent, every patentee has to maintain the patent by paying renewal fee every year as prescribed in the schedule I. For first two years, there is no renewal fee. The renewal fee is payable from 3rd year onwards. In case the renewal fee is not paid the patent will be ceased.

49. Can the patentee pay renewal fee at a time or has to pay every year?

The patentee has choice to pay the renewal fees every year or he can pay in lump sum as well.

50. When can a patent be restored after its cessation?

A request for restoration of patent can be filed within 18 months from the date of cessation of patent along with the prescribed fee. After receipt of the request the matter is notified in the official journal for further processing of the request.

51. What is meant by patent agent and what are the eligibility criteria of becoming a patent agent?

A Patent agent is a person registered with Indian Patent Office whose name is entered in the patent agent register after being declared qualified in the patent agent examination conducted by the patent office and who is entitled—

- (a) to practice before the Controller; and
- (b) to prepare all documents, transact all business and discharge such other functions as may be prescribed in connection with any proceeding before the Controller under this Act.

52. Eligibility conditions for registration as patent agents are below.-

A person shall be qualified to have his name entered in the register of patent agents if he fulfills the following conditions, namely—

- (a) he is a citizen of India;
- (b) he has completed the age of 21 years;
- (c) he has obtained a degree in science, engineering or technology from any university established under law for the time being in force in the territory of India or possesses such other equivalent qualifications as the Central Government may specify in this behalf,

and, in addition,—

- i) has passed the qualifying examination prescribed for the purpose; or
- ii) has, for a total period of not less than ten years, functioned either as an examiner or discharged the functions of the Controller under section 73 or both, but ceased to hold any such capacity.

53. Is it necessary to engage a registered patent agent for filing an application for patent?

It is not necessary under the patent law to engage a registered patent agent for filing an application for patent. The applicant is free to file an application by himself or through the patent agent. However, an applicant who is not a resident of India is required to file either through the registered patent agent or must give an address for service in India

54. Does the Patent Office help to select a patent attorney or agent to make patent search or to prepare and prosecute patent application?

No, Patent Office does not make any recommendations regarding selection of a patent agent. However, a list of patent agents is maintained by the office. This list can also be viewed at Patent Office website. The applicant is free to appoint any patent agent from the said list.

55. Does the patent office ascertain fees charged by the patent agents for their services?

No. This is a matter between the applicant and the patent agent. The Patent Office has no role in ascertaining the fee charged by a patent agent. However, for assisting startups to file

the patent applications, the Patent Office has enrolled the facilitators and prescribed a certain limit of fee reimbursement to be paid to the facilitators under the SIPP scheme. The details of the scheme can be seen on www.ipindia.nic.in.

56. Is it mandatory to obtain prior permission from the Patent Office to file application for patent outside India or abroad?

Ordinarily, under the following circumstances, it is not necessary to obtain prior permission from the Patent Office to file patent application abroad:

- (a) Applicant is not Indian resident and invention is originated abroad about.
- (b) If the applicant is Indian resident and filed patent application has been in India before filing the application outside India and six weeks period is over from that date.
- (c) The invention does not belong to Atomic Energy or defence purpose.

57. Under what circumstances, it is necessary to obtain a prior permission from the Patent Office?

Residents of India require prior permission to apply for patents outside India under section 39 of the Patents Act, 1970 under following circumstances.

- (a) The applicant or inventor is Indian resident,
- (b) Applicant does not wish to file patent application in India prior to filing outside India.
- (c) If the applicant is Indian resident, a patent application has been filed in India and six weeks period is not yet over from that date
- (d) The invention relates to atomic energy or defence purpose.

However if the invention is relevant for Defence or Atomic Energy purpose, no permission shall be granted without the consent of Central Government.

58. Is there any additional requirement for filing of patent applications in respect of microbiological inventions?

In addition to the various forms required to be filed at the time of filing the patent application, the applicant is also required to deposit the new strain of a microorganism if

used in the invention disclosed in the patent specification, in a recognized depository which assigns a registration number to the deposited microorganism, before filing for the patent application. This number needs to be quoted in the patent application.

59. Are there any specific instructions to inventors in respect of filing for patent applications where their invention lies in biological material?

The Patents Act, 1970 as well as the Biological Diversity Act, 2002 stipulates that the source and geographical origin of the biological material should be clearly disclosed in the patent specification. Further, according to the provision of Section 6 of the Biological Diversity Act, if the biological material used in the invention is from India, permission from the National Biological Authority has to be obtained by the applicant, and the same should be submitted to the Patent Office before the grant of patent.

60. Is it essential to deposit biological material in the international depository authority?

If the invention uses a biological material which is new, it is essential to deposit the same in the International Depository Authority (IDA) prior to the filing of the application in India in order to supplement the description. The description in the specification should contain the name and address of the International Depository Authority and, date and number of deposition of Biological material. If such biological material is already known, in such case it is not essential to deposit the same. For more details log on to www.ipindia.nic.in

61. Is there any International Depository Authority in India?

Yes, there is an International Depository Authority in India located at Chandigarh which is known as Institute of Microbial Technology (IMTECH). The more details regarding the said depository authority can be had on its website <http://imtech.res.in/>

62. Under what circumstances fees paid can be refunded?

As per the Amendments in Patents Act 2016, sub-rule (4) of rule 7 provides that if the Controller is satisfied that during the process of online payment, the fees was paid more than once for the same proceedings, the excess fees shall be refunded.

The newly inserted sub-rule 4A provides that in case of withdrawal of patent applications for which request for examination has been filed but first statement of objections have not been

issued, 90% of fees for non-expedited or expedited request for examination may be refunded to Applicant if he/she requests in newly inserted form 29 (which requires zero fees).

63. Have any new forms been introduced?

Forms 18A, 29 and 30 have been newly introduced in view of Patents Act, 1970 Amendment 2016.

64. What are the changes made to the submission of the Power of attorneys?

Now, the deadline for filing a power of attorney is 3 months from the date of filing of patent application and failing of which no action shall be taken on such applications or document till such deficiency is removed.

65. Are there any restrictions with respect to the hearing adjournments?

The Amended rules, 2016 provides for restriction on the number of hearing adjournments to two and each adjournment shall not be more than thirty days each. These adjournments have to be requested at least three days before the date of hearing.

66. Have there been any amendments with respect to national phase applications based on the international patent application:

The rule 20 has been amended to explain an application corresponding to an International application which clarifies that an application corresponding to an international application under PCT can include amendments made under Article 19 or article 34 of PCT, provided that the applicant while filing such application may delete a claim in accordance with Rule 14.

67. What are the instructions to patent agents regarding submission of all documents by electronic transmission?

Now Patent Agents are required to submit even those documents by electronic transmission that need to be submitted in original i.e. through scanned copies and then mandatorily submit the original documents within period of 15 days.

Following documents have to be submitted in original by patent agent after filing them electronically:

- i) The Authorization of Patent Agent or Power of Attorney
- ii) Proof of the right to make an application
- iii) Deed of assignment, certificate regarding change in name of the applicant, license agreement
- iv) Declaration of inventor-ship
- v) Priority document

68. Are there any schemes available for MSME's and Start-ups with respect to IPRs?

Yes, the Government of India has formulated schemes to spur the innovative capabilities of the innovators who are from MSME'S and Start-ups.

- i) **MSME's:** A 50% fee concession is provided for MSMEs vis-à-vis large entities on patent filing fees. The concession was provided by means of a
- ii) **A Scheme for facilitating Startups Intellectual Property Protection (SIPP)** has been launched for encouraging innovation and creativity of Startups.

For effective implementation of the scheme, facilitators have been empanelled by the Controller General of Patent, Trademark and Design (CGPDTM). Presently around 423 facilitators in Patent & Designs, 606 Facilitators in Trademarks have been empaneled under this scheme. Startups are provided a rebate of 80% on patent fees as compared to the fee paid by legal entity.

69. What is start up criteria?

Start-up means an entity, incorporated or registered in India under the **-Start-up India: Stand-Up India**" initiative of the Government of India.

70. What are the benefits provided by the Government of India to Start up applicants for filing patent applications?

Government of India provides the following benefits to Start Ups in filing patent application in India under **Scheme for Facilitating Start-ups Intellectual Property Protection (SIPP)**:

- An entity qualifying as a 'start up' under Stand-Up India initiative of the Government of India can avail the facility of **expedited examination**.

- The Government reimburses the expenditure to the facilitator who assists the startup for filing and prosecuting the patent application to the extent of Rs.10,000/-

71. What is the relevant date from the infringement perspective?

As per section 11A, the applicant shall have privileges as if patent was granted on the date of publication of application. Thus, in case of suit for infringement, the patent owner can claim damages from the date of publication of patent application or date of infringement whichever is earlier. However the suit for infringement can be filed only after a patent is granted.

72. What are the rights of a patentee once the patent is granted?

A patentee enjoys the exclusive right to make and use the patented invention. The patentee also has the right to assign the patent, grant licences, or otherwise deal with the patent, for any consideration. These rights, created by statute, are circumscribed by various conditions and limitations as prescribed under the Patents Act.1970.

73. Is it necessary to show working of a patent after grant?

Under the provisions of section 146, every patentee or a licensee, is required to furnish the information relating to working of patent, statement as to the extent to which the patented invention has been worked. This must be submitted on Form 27 by 31 March each year for the previous year ending 31 December.

INTERNATIONAL ARRANGEMENTS:

74. What is the Budapest Treaty?

This is an international treaty governing the deposition of microorganisms, cell lines etc in international approved authority approved by WIPO for the purpose of patent applications in any country that is a party to it. Because of the difficulties and, on occasion, of virtual impossibility of reproducing a microorganism from a description of it in a patent specification, it is essential to deposit a strain in a culture collection centre for testing and examination by others. There are many international depositories in many countries, which

are recognized under the Budapest Treaty. IMTECH, Chandigarh is a recognized depository in India.

75. What are the modes of filing a patent application in foreign countries?

Since there is no worldwide patent, the applicant has to file his patent application in respective countries separately to obtain protection on his invention. The following are the routes available to the applicant to file his International application in foreign country.

Paris Convention: The Paris Convention for the Protection of Industrial Property, established in 1883, provides for 12 months time to file the patent application in the member countries from the date of filing of the earliest application.

Patent Cooperation Treaty System: PCT is a system which allows an applicant to file in PCT contracting states within 30-31 months from priority date instead of 12 months. Not only does the PCT enable extended time period, it also simplifies filing procedure through a single application. The PCT system also provides for publication of application, International Search and International Preliminary Examination before entering the national phase .

76. What is the Patent Cooperation Treaty (PCT)?

The PCT is an international treaty with more than 150 Contracting States which are bound with certain formal requirements set out in the Treaty and Regulations. The PCT makes it possible to seek patent protection for an invention simultaneously in a large number of countries by filing a single –international patent application instead of filing several separate national or regional patent applications however, granting of patents remains under the control of the national or regional patent offices after the corresponding –national phase application has been filed and the national phase application is assessed as per patent law of that jurisdiction.

As per Indian Patent Act 1970 as amended and the Patents Rules 2003 as amended by (amendment) rules 2016, any PCT international application may be filed designating India and it shall be deemed to be an application if the corresponding national phase application has also been filed.

77. What is the procedure of PCT?

The PCT procedure includes:

- a. **Filing:** File an international application with a RO/IN national patent Office or directly with International Bureau (IB) of WIPO, complying with the PCT formality requirements and fees. In India PCT application are filed at appropriate patent offices decided on the basis of territorial limits (Rule 4, Indian Patent Act 1970 as amended and patent Rules 2003 as amended).
- b. **International Search:** An —International Searching Authority| (ISA) identifies the published patent documents and technical literature (—prior art|) which may have an influence on whether your invention is patentable, and establishes a written opinion on your invention’s potential patentability. Indian Patent office, Delhi Branch performs the function of ISA on receipt of prescribed fee specified in Fifth Schedule of patent act 1970 as amended and patent rules 2003 as amended.
- c. **International Publication:** After expiration of 18 months from the earliest filing date (Priority Date), the content of your international application is disclosed to the world.
- d. **International Preliminary Examination (optional):** one of the ISAs on request carries out an additional patentability analysis, usually on an amended version of your application. Indian Patent office, Delhi Branch performs the function of International Preliminary Examination (IPEA) on receipt of prescribed fee specified in Fifth Schedule of patent act 1970 as amended and patent rules 2003 as amended.
- e. **National Phase:** After the end of the international PCT procedure, usually at 30 months from the earliest filing date of your initial application, from which you claim priority, you start to pursue the grant of your patents directly before the national (or regional) patent Offices of the countries in which you want to obtain them.
- f. In India, 31 months is maximum time limit to enter national phase. To enter national phase an application corresponding to an international application is made in Form 1.

78. Who has the right to file an international patent application under the PCT?

PCT international patent application may be filed by a national or resident of a PCT Contracting State. If there are several applicants named in the international application, only one of them needs to comply with this requirement.

79. Can I file PCT applications electronically?

PCT applications can be filed electronically with RO/IN or RO/IB which accepts such filings (Indian Patent office does not accept full e-filing of PCT international application). WIPO web service (ePCT-filing) helps to prepare applications by automatically validating the entered data and drawing your attention to incorrectly or inconsistently completed parts. Applicants are also entitled to certain PCT fee reductions when filing electronically (<https://pct.wipo.int/>). WIPO's PCT-SAFE software offers PCT user to prepare international application in electronic form (<http://www.wipo.int/pct-safe/en/>).

80. In which language can a PCT application be filed?

PCT international application in India shall be filed with the appropriate office in triplicate either in English or Hindi. However, the request can be filed only in English.

81. What are the costs associated with the filing and processing of an international application under the PCT? What are the costs for entering the national phase?

PCT applicants generally pay three types of fees when they file their international applications:

- (a) An international filing fee
- (b) A search fee which can vary from ISA chosen, and
- (c) A small transmittal fee which varies depending on the receiving Office.

Refer, Fifth Schedule of patent act 1970 as amended and patent rules 2003 as amended for fee structure for an international application designating India.

82. Are there any fee reductions available under the PCT?

PCT fee reductions are available to applicants who file electronically, based on the type of filing and the format of the application submitted.

In addition, to encourage the use of the PCT System by applicants from developing countries fee reductions of 90% for certain fees, including the international filing fee, are available to natural persons.

Some ISAs also provide for a reduction of the international search fee if the applicant or applicants are nationals or residents from certain countries (see Annex D of the *PCT Applicant's Guide* WIPO).

83. How long does the PCT process take?

- i. In most cases, up to an additional 18 months from the time you file your international patent application (or usually 30 months from the filing date of the initial patent application of which you claim priority) before starting of national phase procedures with individual patent Offices and to fulfill the national requirements.
- ii. This additional time can be useful for evaluating the chances of obtaining patents and exploiting invention commercially in the countries in which you plan to pursue patent protection, and for assessing both the technical value of your invention and the continued need for protection in those countries.
- iii. It is important to note, however, that you do not have to wait for the expiration of 30 months from the earliest filing date of your patent application (—priority date) before you enter the national phase – you can always request an early entry into the national phase.
- iv. Since, in the national phase, each patent Office is responsible for examining your application in accordance with national or regional patent laws, regulations and practices, the time required for the examination and grant of a patent varies across patent Offices.

84. What does it mean to “claim priority” of an earlier patent application?

Generally, patent applicants who wish to protect their invention in more than one country usually first file a national or regional patent application with their national or regional

patent Office, and within 12 months from the filing date of that first application, they file their international application under the PCT.

The effect of claiming the priority of an earlier patent application is that a patent shall not be invalidated by reasons of any acts accomplished in the interval, such as another filing, the publication or sale of the invention.

INTERNATIONAL SEARCH

85. Can an applicant opt for Indian Patent Office as ISA/IPEA for the international search of PCT application?

Yes, the Indian Patent Office was recognized as an International Searching Authority and International Preliminary Examining Authority under the PCT and started functioning from 15th October 2013. The advantages of search in Indian ISA are:

- i. Having access to a comprehensive collection of patent and non-patent literature that covers the PCT minimum documentation, our integrated Search platform IPATS enables one click search through the vast collection of information.
- ii. Professionally qualified and skilled Examiners are our assets.
- iii. IPO has established a Quality Management System covering technical and administrative tasks of the office. Fully electronic processing system ensures speedy disposal and dissemination of information on real time basis.
- iv. The fees for conducting a search under ISA/IPEA are the **lowest among** the other offices offering the same facilities.
- v. Further, if the applicant chooses the Indian ISA, he gets an additional advantage to enter the Expedited Examination System which ensures a grant of his application within 12 months (provided no pre-grant opposition is filed).

86. Which are the other offices which are appointed by the PCT to conduct searches?

The following have been appointed by the PCT Contracting States as International Searching Authorities (ISAs): the national Offices of Australia, Austria, Brazil, Canada, China, Chile, Egypt, Finland, India, Israel, Japan, the Republic of Korea, the Russian Federation, Spain, Sweden, Ukraine⁴ and the United States of America, and the following regional Offices, the European Patent Office and the Nordic Patent Institute. The

availability of a particular ISA to the nationals or residents of a country is determined by the receiving Office where the international application was filed. Some receiving Offices provide a choice of more than one competent ISA. If your receiving Office is one of those, you can choose any one of them, taking into account differing requirements relating to language, fees, etc.

87. What is a PCT international search?

A PCT international search is a high quality search of the relevant patent documents and other technical literature in those languages in which most patent applications are filed (Chinese, English, German and Japanese, and in certain cases, French, Korean, Russian and Spanish). The high quality of the search is assured by the standards prescribed in the PCT for the documentation to be consulted, and by the qualified staff and uniform search methods of the ISAs, which are all experienced patent Offices. The results are published in an international search report and a written opinion of the ISA on the potential patentability of your invention.

88. What is an international search report?

The international search report consists mainly of a listing of references to published patent documents and technical journal articles which might affect the patentability of the invention disclosed in the international application. The report contains indications for each of the documents listed as to their possible relevance to the critical patentability questions of novelty and inventive step (non-obviousness). Together with the search report, the ISA prepares a written opinion on patentability, which will give you a detailed analysis of the potential patentability of your invention. The international search report and the written opinion are sent to you by the ISA.

89. What is the value of the international search report?

The report enables you to evaluate your chances of obtaining patents in PCT Contracting States. An international search report which is favorable, that is, in which the documents (prior art) cited would appear not to prevent the grant of a patent, assists you in the further processing of your application in those countries in which you wish to obtain protection. If a

search report is unfavorable (for example, if it lists documents which challenge the novelty and/or inventive step of your invention), you have the opportunity to amend the claims in your international patent application (to better distinguish your invention from those documents), and have them published, or to withdraw the application before it is published.

90. Will an international search be carried out for all international applications?

- i) As a rule, an international search is carried out for all international applications. There are instances, however, where the ISA will not be able to carry out a search. For example, where the international application relates to subject matter which the ISA is not required to search or if the description, claims or drawings are not sufficiently clear for it to carry out a meaningful search. In such cases, the ISA will issue a declaration that no international search report will be issued.
- ii) There are also circumstances where the ISA will issue a partial search report. This can occur when, in the view of the ISA, the international application contains multiple inventions but the applicant has not paid additional search fees to cover the work required to search those additional invention(s).

91. What is the written opinion of the International Searching Authority?

For every international application, the ISA will establish, at the same time that it establishes the international search report, a preliminary and non-binding opinion on whether the invention appears to meet the patentability criteria in light of the search report results. The written opinion, which is sent to you together with the international search report, helps you understand and interpret the results of the search report with specific reference to the text of your international application, being of special help to you in evaluating your chances of obtaining a patent. The written opinion is made available to the public at the same time as the application.

INTERNATIONAL PUBLICATION

92. What does international publication under the PCT consist of?

WIPO publishes the international application shortly after the expiration of 18 months from the priority date (if it has not been withdrawn earlier), together with the international search report. PCT international applications are published online on PATENTSCOPE, a powerful, fully searchable database with flexible, multilingual interfaces and translation tools to assist users and the public in understanding the content of published applications.

93. Can third parties access documents contained in the file of the international application? If so, when?

Until international publication (18 months after the priority date), no third party is allowed access to your international application unless you as applicant request or authorize it. If you wish to withdraw your application (and you do so before international publication), international publication does not take place and, as a consequence, no access by third parties is permitted. However, when international publication occurs, certain documents in the international application file are made available on PATENTSCOPE together with the published international application, for example, the written opinion of the ISA and any informal comments on the written opinion.

INTERNATIONAL PRELIMINARY EXAMINATION

94. What is international preliminary examination?

International preliminary examination is a second evaluation of the potential patentability of the invention, using the same standards on which the written opinion of the ISA was based. If you wish to make amendments to your international application in order to overcome documents identified in the international search report and conclusions made in the written opinion of the ISA, international preliminary examination provides the only possibility to actively participate in the examination process and potentially influence the findings of the examiner before entering the national phase – you can submit amendments and arguments and are entitled to an interview with the examiner. At the end of the procedure, an international preliminary report on patentability (IPRP Chapter II) will be issued.

The International Preliminary Examining Authorities (IPEAs) which carry out the international preliminary examination are the ISAs mentioned above. For a given PCT

application, there may be one or more competent IPEAs; your receiving Office can supply details or you may consult the *PCT Applicant's Guide* and the *PCT Newsletter*.

95. What is the value of the international preliminary report on patentability (Chapter II)?

The IPRP (Chapter II) consists of an opinion on the compliance with the international patentability criteria of each of the claims which have been searched. It provides you with an even stronger basis to evaluate your chances of obtaining patents, in most cases on an amended application, and, if the report is favorable, a stronger basis to continue with your application before the national and regional patent Offices. The decision on the granting of a patent remains the responsibility of each of the national or regional Offices in which you enter the national phase; the IPRP (Chapter II) should be considered by the Offices but is not binding on them.

NATIONAL PHASE

96. How do I enter the national phase?

It is only after you have decided whether, and in respect of which States, you wish to proceed further with your international application that you must fulfill the requirements for entry into the national phase. These requirements include paying national fees and, in some cases, filing translations of the application. These steps must be taken, in relation to the majority of PCT Contracting States' patent Offices, before the end of the 30th month from the priority date. There may also be other requirements in connection with the entry into the national phase – for example, the appointment of local agents. More general information on national phase entry can be found in the *PCT Applicant's Guide, National Phase*, and specific information concerning fees and national requirements can be found in the national chapters for each PCT Contracting State in the same Guide.

97. What happens to my application in the national phase?

Once you have entered the national phase, the national or regional patent Offices concerned begin the process of determining whether they will grant you a patent. Any examination which these Offices may undertake should be made easier by the PCT international search

report and the written opinion and even more by an international preliminary examination report.

98. What are the advantages of the Patent Cooperation Treaty?

The PCT System has many advantages for an applicant, for the patent Offices and for the general public:

- (a) You have up to 18 months more than if you had not used the PCT to reflect on the desirability of seeking protection in foreign countries, to appoint local patent agents in each foreign country, to prepare the necessary translations and to pay the national fees;
- (b) If your international application is in the form prescribed by the PCT, it cannot be rejected on formal grounds by any PCT Contracting State patent Office during the national phase of the processing of the application;
- (c) The international search report and written opinion contain important information about the potential patentability of your invention, providing a strong basis for you to make business decisions about how to proceed;
- (d) You have the possibility during the optional international preliminary examination to amend the international application, enter into dialogue with the examiner to fully argue your case and put the application in order before processing by the various national patent Offices;
- (e) The search and examination work of patent Offices in the national phase can be considerably reduced due to the international search report, the written opinion and, where applicable, the international preliminary report on patentability that accompany the international application;
- (f) You may be able to fast-track examination procedures in the national phase in Contracting States that have PCT-Patent Prosecution Highway (PCT-PPH) agreements or similar arrangements;

- (g) Since each international application is published together with an international search report, third parties are in a better position to evaluate the potential patentability of the claimed invention;
- (h) For an applicant, international publication online puts the world on notice of your invention. You may also highlight your interest in concluding licensing agreements on PATENTSCOPE, which can be an effective means of advertising and looking for potential licensees;
- (i) You also achieve other savings in document preparation, communication and translations because the work done during the international processing is generally not repeated before each Office (for example, you submit only one copy of the priority document instead of having to submit several copies); and
- (j) if your invention appears to be not patentable at the end of the international phase, you may abandon the PCT application and save the costs you would otherwise have incurred by directly seeking protection in foreign countries, appointing local patent agents in each foreign country, preparing the necessary translations and paying the national fees.

99. What is ePCT?

ePCT is a WIPO online service that provides secure electronic access to the files of international applications filed under the PCT as maintained by the International Bureau. The applicants can file international applications using ePCT-Filing, with RO/IN as well as RO/IB.

100. What are the benefits of filing through ePCT?

- Applicants can avail a fee reduction as fixed by PCT division of WIPO from time to time.
- Less cumbersome, for both RO as well as for the applicant.
- Fast processing
- Record copy transmitted to the IB on the same day.