

# Analysis of Patent Filing Procedure in India

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Patent filing procedure in India is very simple and sober; there are different ways of filing patent applications in India such as Indian Patent Application, Conventional Application, and National Phase Application wherein we will discuss one by one with the illustrative manner in order to get the better understanding.

**Key words:** Patent Cooperation Treaty (PCT), national phase application, conventional application.

## Introduction:

The concept of Intellectual Property in India is an old British-ruled Indian tradition. Though, since the evolution of Trade Related Aspects of Intellectual Property Rights (TRIPS) agreement in 1995, India has taken pro-active measures to come par with the world Intellectual Property standards. India has met the TRIPS minimum standards in 2005. Since then we are observing growth in the number of patents and innovations taking place in India. It is a pseudo-6 year old start of Patents for this growing and developing nation, although more pro-active measures, policies and support systems are yet to be seen.

The Indian patent law is enshrined in the Patents Act, 1970. The Act seeks to provide legal protection for inventions and the rights granted under the Act are operative in the whole of India. The object of the patent law is to provide a statutory right to the owner of the patent for a certain period of time and disclose invention to use it and practice that invention and make it work thus encourage scientific research and new technology, stimulate new inventions of commercial utility and pass inventions into public domain after expiry of the fixed period of the monopoly.

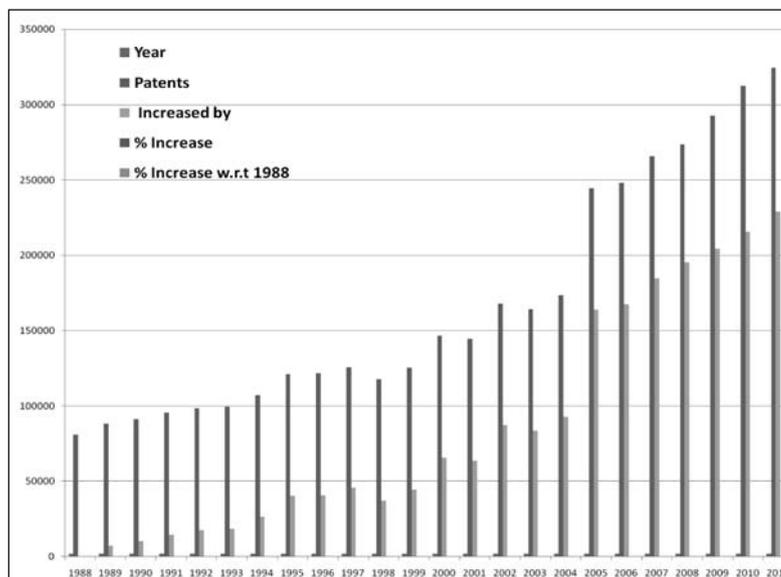
In India, efforts are made for the protection of human intellect through patent filings. For this purpose India has become a part of the global patent regime. IPO is creating awareness among the R&D community regarding patents and their global benefits. From 18<sup>th</sup> July 2007, e-filing facility for patent applications has been initiated to ease the filing of patents. India has joined various treaties like Paris Convention and Patent Cooperation Treaty (PCT). India also plays an important role in WTO and WIPO.

Every country has its own patent office and its own patent laws for the protection of innovative ideas. Rights given by the patents are monopoly rights which prevent others from making, using or selling the creator's invention for a specified period of time. Patents are issued for inventions which are solutions to specific problems in the field of technology. Invention may be related to a product or a process. In order to get a patent for an invention, the invention has to be patentable (Novel, non obvious, inventive step, utility, etc.) and application must be filed in the patent office. Patent document is published as an application and later granted by the patent office as a patent. Patents are granted for the inventions related to process, products, apparatus and industrial applications.

The analysis of statistical data published by CAS, a division of ACS, covering articles, patents and books support the growing trend in filing patents

in chemical sciences all over the world. This data analysis from 1997 to 2007 indicates that the periodical literature abstracted in CA has increased by 39.39 per cent, whereas the patent literature has increased by 111.01 percent. The data published by Thomson Reuters in World IP Today analyses overall global scenario in patent filing, and it reports that there is a 21 per cent increase in patent filing since 2002; with Japan, US and China being the leading countries. The academic innovations during this period have increased to 25 per cent in China and Russia. WIPO too reports the steady growth in patent filing and ranks Japan as the top patent filing country with 17.5 per cent growth, followed by Germany, Korea, France, China, UK, Netherlands, Canada, and Australia. Dunn indicated that patents are treated as an important source of information and also contributes to the growth of S and T along with other sources of information. In chemical sciences, patent literature plays a significant role as it discloses current research ideas for the first time in the form of patent applications to the patent office.

The growth in filing patents is prominent among scientific disciplines like biotechnology, environmental sciences, chemical sciences, pharmaceutical and drug sciences. These types of industries are mainly concerned with consumer products. The growth in chemical and pharmaceutical sciences is more as compared to other industries as it has a prominent place in human life. The industrial growth and patent filing growth is continuous



The above chart gives the statistical data recorded by CAS, regarding chemical patent publications, abstracted in CS, reported during the period 1988 to 2011.

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in this area as new innovative products, preparations, properties or uses are brought to the notice via patents. In all branches of sciences, almost all countries are filing patents but considering the output in the form of patent filing, few countries like USA, UK, Germany, Japan, China, France and Korea are leading. It is noticed that major industries file more than 500-600 patents in a year. For e.g. Bayer Germany, DuPont USA, etc. It is found that the growth of patents in all subject areas is prominent and also gaining importance day by day due to IPR policies. Patents are found in every area of applied science and technology, and inventions range from simple mechanisms to complex chemical compounds. Research is an inventive process wherein new developments are constantly being reported and users need to get the information about new practices through the literature published by the researcher. Patent literature plays an important role in disseminating the nascent ideas to users and hence it is a unique source of delivering scientific information.

### Description:

The following are the steps involved in the patent filing procedure:

Filing of Patent Application with Indian patent offices

1. Covering indicating the list of documents;
2. Application for Grant of Patent in Form 1 [section 7, 54 & 135 and Rule 20(1)] in duplicate;
3. Complete specification in Form 2 in duplicate [Section 10; Rule 13]; comprising:
  - Description
  - Claims
  - Drawing (if any)
  - Abstract
4. Statement and Undertaking in Form 3 in duplicate [Section 8; Rule 12];
5. Power of Attorney in Form 26 (in original) (Rule 3.3 (a) (ii));
6. Declaration of Inventorship in Form 5 in duplicate (only in case of an Indian Application); (Rule 4.17);
7. Certified true copy of the Priority document (in case priority is claimed);
8. Requisite Statutory fees (cheque / DD).

### Statutory Fees:

Particular	Natural person (INR)	Other than natural person (INR)
For filing patent application	1000	4000
For each sheet of specification in addition to 30	100	400
For each claim in addition to 10 claims	200	800

Documents can be filed online or in the patent office having jurisdiction: Kolkata (head office), Delhi, Mumbai, Chennai, Regional Patent office's Jurisdiction Office, Territorial Jurisdiction Patent Office Branch

#### Mumbai

The States of Maharashtra, Gujarat, Madhya Pradesh and Goa, Daman & Diu & Dadra & Nagar Haveli Patent Office Branch.

#### Chennai

The States of Andhra Pradesh, Kerala Tamil Nadu, Mysore and Pondicherry, Laccadive, Minicoy and Amindivi Islands.

#### New Delhi

States of Haryana, Himachal Pradesh, Jammu & Kashmir, Punjab, Rajasthan and Uttar Pradesh, Chandigarh and Delhi.

#### Patent Office (Head), Kolkata

West Bengal and the remaining part of India.

### Publication:

[Rule 24] A patent application will be published automatically in the official journal after expiry of 18 months from date of filing or date of priority of the application containing title, abstract, application no. and name of applicant[s] and inventor[s].

Request for early publication: [Rule 22A] To expedite the process of grant of patent a request for publication under Section 11(A)(2) can be made in Form 9 any time after filing of the application. Upon such a request the application will be published in one month from the date of request.

### Statutory Fees:

Particular	Natural person (INR)	Other than natural person (INR)
Request for Early Publication	2500	10,000

### Opposition (if any):

#### Pre-grant Opposition:

[Section 25(1)] Upon publication, but before the grant of patent, any person, based on different grounds may file a pre-grant opposition, in writing, represented by way of opposition to the Controller against the grant of patent. However the opposition will be taken by the patent office only after the filing of Request for Examination.

#### Time limit:

May be filed within 3 months from the date of publication of the application [sec 25(1); rule 55(1)] OR Before the grant of patent, whichever is later.

#### Fee:

#### No Fee

#### Form and Content [Rule 55(1)]:

There is no prescribed form for pre grant opposition however the representation shall be in writing and shall comprise of following particulars:

1. Statement regarding opposition;
2. Evidence regarding opposition; (if any)
3. Request for hearing (Optional).

#### Procedure:

- a. The Controller will consider such Representation only when a request for examination has been filed.
- b. The Controller shall forward the Representation to the applicant.
- c. On the basis of notice of filing the Representation, the applicant shall file his Statement and Evidence (if any) in support of his application within three months from the date of the notice.
- d. Either party may request the Controller to give them a chance to be heard.

After considering the representation of the opponent and the response of the applicant and their supporting evidences (if any) and after hearing both the parties (if hearing is requested), the

Controller shall proceed further simultaneously either rejecting the representation and granting the patent or accepting the representation and refusing the grant of patent ordinarily within one month from the completion of the above proceedings [Rule 55(6)].

### Appeal:

An applicant can go for an appeal against the decision of the Controller. Such an appeal can be filed before the Intellectual Property Appellate Board (IPAB), Chennai.

### Post grant Opposition:

[Section 25(2)] Upon grant of patent, any interested person, based on different grounds may file a post grant opposition in Form 7 to the Controller against the grant of patent.

### Time limit:

[Section 25(2)] Within one year after the grant of a patent.

### Form and Content:

- Notice of opposition shall be in Form 7 (in duplicate) [Rule 55A];
- Written Statement setting out nature of the interest (in duplicate) [Rule 57];
- Evidence regarding opposition;
- Statutory fees;
- Request for hearing (Optional).

### Statutory Fees:

Particular	Natural person (INR)	Other than natural person (INR)
Notice of Opposition	1500	6,000

### Procedure:

- On receipt of notice of opposition, the Controller shall, by order, constitute an Opposition Board consisting of three members and nominate one of the members as the Chairman of the Board;
- A copy of the Statement and Evidence together with the Notice of Opposition shall be delivered to the applicant;
- If the applicant desires to contest the opposition, he shall leave a Reply Statement setting out fully the grounds upon which the opposition is contested and the evidence within a period of two months from the date of receipt of the copy of statement and opponent's evidence.
- The opponent may, within three month from the date of delivery to him of a copy of applicant's reply, leave Evidence in Reply strictly confined to matters in the applicant's reply and shall deliver to the applicant a copy of such evidence.
- The Opposition Board shall conduct the examination of the notice of opposition along with documents filed above and submit a Report with reasons on each ground taken in the notice of opposition with its joint recommendation within three months from the date on which the documents were forwarded to them.

### Hearing: [Rule 62]

- Controller may fix a date and time for the hearing of the opposition according to this rule and inform to the parties and also member of the Opposition Board.

- Upon the receipt of the notice of hearing, the party to the proceedings that is desirous to be heard shall inform the Controller by a notice along with the prescribed fee;
- [Rule 63] If the applicant notifies the Controller that he does not desire to proceed with the application after notice of opposition is given, The Controller, depending upon the merits of the case, may decide whether costs should be awarded to the opponent. After hearing a party or parties desirous of being heard or if neither party desires to be heard then without a hearing and after taking into consideration the recommendation of opposition board, the Controller shall decide the opposition and notifies his decision to the parties giving reasons therefore.

### Appeal:

An applicant can go for an appeal against the decision of the Controller. Such an appeal can be filed before the Intellectual Property Appellate Board (IPAB), Chennai.

### Statutory Fees:

Particular	Natural person (INR)	Other than natural person (INR)
Hearing before Controller	1500	6,000

### Request for Examination:

No Request, No Grant

In Form 18[sec 11B; rules 20(4) (ii) and 24B (1) (i)] in duplicate within period of 48 months from date of filing or priority.

### Statutory Fees:

Particular	Natural person (INR)	Other than natural person (INR)
Request for Examination	2500	10,000

### First Examination Report:

[Section 12; 24B (3)] After proper examination of patent application on the criteria of novelty, inventiveness and industrial application, the Patent Examiner will issue a First Examination Report (FER) and will send along with the application and specification to the applicant or authorized agent.

### Amendment of objections by the applicant:

The issued FER gives an opportunity to the applicant to file a response and overcome the objections raised by the Examiner.

Time limit: [Rule 24B(4)(iii)] Within 12 months from the date on which the First Examination Report has been issued to the applicant.

In case of the unjustified response, the Controller has power to refuse the grant of patent or amended claim[s] or make order for the Division of Application [Section 15, 16].

### Grant of Patent:

The Controller will grant the application upon overcoming all the objections raised in the FER.

On the grant of a patent, the application will be accorded a number, called serial number in the series of numbers accorded to patents under the Indian Patents and Designs Act, 1911(2 of 1911).

## Renewal fees:

- To keep a patent in force, the renewal fees shall be payable at the expiration of the second year from the date of the patent or of any succeeding year and the same shall be remitted to the patent office before the expiration of the second or the succeeding year.
- While paying the renewal fee, the number and date of the patent concerned and the year in respect of which the fee is paid shall be quoted.
- The annual renewal fees payable in respect of two or more years may be paid in advance.

Statutory Fees:		
Particular	Natural person (INR)	Other than natural person (INR)
Before the expiration of 2nd year from the date of patent in respect of 3rd year	500	2000
Before the expiration of 6th year from the date of patent in respect of 7th year	1500	6000
Before the expiration of 10th year from the date of patent in respect of 11th year	3000	12000
Before the expiration of 15th year from the date of patent in respect of 16th year	5000	20000
The period for payment of renewal fees may be extended to a period but not more than six months if the request for extension in Form 4 with fees.		
Statutory Fees:		
Particular	Natural person (INR)	Other than natural person (INR)
Extension in Form 4	300 per month	1200 per month

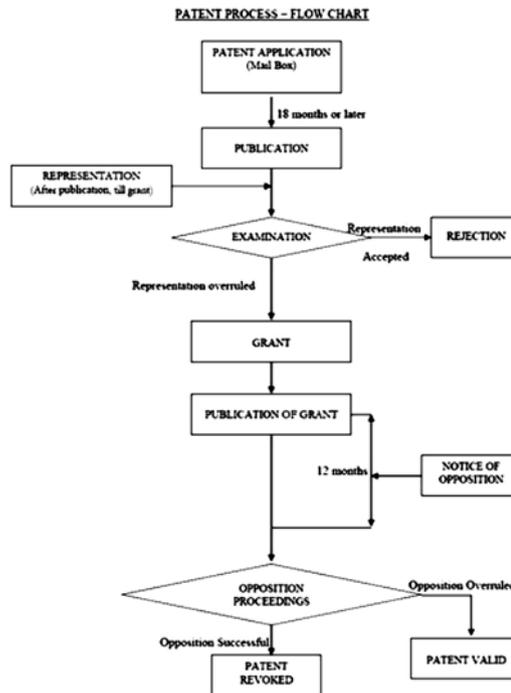
## Infringement Proceedings:

The patentee may file an action for patent infringement in either a District Court or a High Court. Whenever a defendant counter-claims for revocation of the patent, the suit along with the counterclaims is transferred to the High Court for decision. Because defendants invariably counterclaim for revocation, patent infringement suits are typically heard by the High Court only. According to patent laws in India, the High Court may allow the patentee to amend the application in order to preserve the validity of the patent. In such an event, the applicant must give notice to the Controller, who may be entitled to appear and be heard and shall appear if so directed by the High Court. If a patentee is successful in proving its case of patent infringement, and if the defendant does not comply with the judgment, a petition for contempt of court can be filed. Contempt of court is a criminal offense, while patent infringement is a civil offense. In the event of contempt of court, Indian law provides for imprisoning the authorized person(s) of the defendant. It is also possible to obtain a preliminary injunction, although the above-noted judicial backlog should be considered. The basis upon which a preliminary injunction is granted is whether the plaintiff shows a prima facie case and also whether the balance of "convenience" is in the plaintiff's favor.

However, an important consideration before enforcing a patent in India is to ensure that the patentee has worked the invention

directly or through its licenses in India. If a patentee has not worked the invention in India, then the defendant could seek a compulsory license under Section 84(1) (c), if the patent has been in force for more than three years. In addition, if a compulsory license is already in place and the patentee has still not worked the invention but yet asserts it, the defendant can seek a revocation of the patent under Section 85(1) of the Patents Act.

## Patent Prosecution flow chart:



## Conclusion:

It is of significant notice that IPO is developing its activities fast and is now compatible with the international patent searching authority. The trends from various statistical analyses reveal that there is a visible ascendancy in the process of patent filing both at the national and international levels. This clearly reflects the healthy growth of scientific innovations and inventions. This has been observed in the enhanced growth and development of scientific and technological institutions and also increased growth of research and development funds all over the globe.