

## MANUAL OF PATENT OFFICE PRACTICE AND PROCEDURE

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### THE OFFICE OF CONTROLLER GENERAL OF PATENTS, DESIGNS & TRADEMARKS

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#### **PREFACE**

The Patents Act, 1970 was amended in 1999, 2002 and finally in 2005 to provide for product patents in chemicals, pharmaceuticals, food and agro-chemicals and bring in other necessary amendments in line with Trade Related Aspects of Intellectual Property Rights (TRIPS). Patents Rules have been commensurately amended initially as Patent Rules, 2003, which were further amended in 2005, 2006, 2012, 2013, 2014, 2016 and 2017. India became signatory to PCT in 1998. Consequently, patent filing in India including National Phase applications under PCT has increased exponentially. Indian Patent Office is a major PCT applications filing country and also functions as ISA/IPEA under PCT.

Indian Patent Office has been modernized in terms of automation, IT enablement and electronic processing of patent applications during last decade. The objective of modernization project was to increase the functional efficiency and streamline the procedures in tune with the international best practices.

Considerable changes have been effected in patenting procedures from time to time in accordance with the provisions of the amended Act and Rules and also to bring in automation, electronic work-flow, comprehensive e-filing, simplified and transparent procedures and efficient public service delivery of IP services.

The office has been regularly publishing the Manual of Patent Office Practice and Procedure to codify patent procedures for streamlining the functioning, provide benefit to stakeholders and also to provide guidance for prosecution of patent applications at Patent Office.

In view of recent amendments of Patent Rules, reengineering of patent procedures and automation in almost all activities in Patent Office, there has been demand to revise and update the present Manual.

Accordingly, the present version of Manual of Patent Office Practice and Procedure, hereinafter referred to as "Manual", has been prepared, which is yet another step to fulfill our commitments towards more efficiency and transparency in the functioning of Patent Office.

This Manual may be considered as a practical guide for effective prosecution of patent applications in India. However, it does not constitute rule making and, hence, does not have the force and effect of law.

The Manual will be revised from time to time based on interpretations by Courts of Law, statutory amendments and valuable inputs from the stakeholders.

(O.P. Gupta)

Controller General of Patents, Designs and Trademarks

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#### **Chapter-1: Introduction**

- 1. This manual has been compiled with an intention to codify the practices and procedures being followed by the Indian Patent Office and is intended to serve as a procedural guide for practitioners and other users of the Indian Patent System.
- 2. Indian Patent Office functions from four locations viz. Delhi, Mumbai, Kolkata and Chennai with defined areas of territorial jurisdiction. Introduction of office automation and electronic processing of patent applications has resulted in substantial uniformity and transparency in functioning. Complete file wrapper in respect of published patent applications including information related to publication, examination reports, status of application, amendments, grant, opposition, renewal and decisions of controllers as well as legal status of patents in the form of electronic Patent Register has been made available to the public. This manual is expected to bring in further transparency and uniform practices in the patent office.
- 3. Processing of patent applications is a multi-stage process, involving filing of an application, electronic data processing, screening and classification, publication, examination, hearing if required, pre-grant opposition and grant/refusal. Examiner and Controller of Patents on one side and Applicant/Agent and general public on the other are involved in the patenting process. This Manual explains rights, functions and responsibilities of all stakeholders so as to ensure smooth functioning of the patent system.
- 4. This manual is intended to spell out patent office practices and procedure and bridge any information gap that may currently exist in this regard. It is not intended to be an interpretation of the Indian Patent Law.
- 5. The procedure for filing Patent application and its processing up to grant/refusal, maintenance etc. is explained in the following chapters except infringement proceedings. Certain matters like exceptions to the rights of patentee, Government use, compulsory licensing etc. have also been included.
- 6. Some of the key definitions have been explained in Chapter-2.
- 7. Chapters 3 to 8 deal with the procedure for filing of patent applications including

- ordinary and PCT national phase applications, convention and PCT international applications, patent of addition, divisional application and Indian ISA/IPEA.
- 8. Chapters 9 to 11 relate to examination, grant, pre-grant and post grant oppositions.
- 9. Chapters 12 to 14 cover the post-grant procedures such as maintenance of patent, appeal, revocation, compulsory licensing and use of patents for the purpose of Government.
- 10. Chapters 15 to 21 relate to patent agents, offences and penalties, general powers of Controller, general services, scientific advisors and miscellaneous provisions.
- 11. Time lines prescribed under the Act and Rules have been specifically dealt with separately in Chapter 22.
- 12. The Officers functioning under the Act have been vested with statutory powers. They also have some discretionary powers under the Act, which are to be exercised judiciously. As regards the patentability of any subject matter under consideration by an Officer empowered under the Act, he shall not be guided solely by the contents of this manual but shall take judicious decisions based on the Act, Rules and judicial decisions on the matter. However, all officers of Patent Office shall follow the procedure set forth in the Manual.

#### **Chapter 02: Key definitions**

General	
For better appreciation of this Manual, the user may	
require to have clear understanding of certain terms	
which are defined in the Act and Rules. Some of the	
important definitions are as under.	
Definitions	
"Controller" means the Controller General of Patents,	Section
Designs and Trade Marks referred to in Section 73 (1).	2(1)(b),
The Controller General of Patents, Designs and	2(2)(a), and
Trademarks is appointed by the Government of India	73;
under Section 3 of the Trademarks Act, 1999. The person	Section 3 of
so appointed will be the Controller of Patents for the	Trademarks
purposes of Patents Act, 1970.	Act, 1999
The Central Government may appoint examiners and	
other officers with designations as deemed fit, who shall	
discharge, under the superintendence and directions of	
the Controller General of Patents, Designs and	
Trademarks, such functions of the Controller under this	
Act, as he may authorize in writing from time to time, by general or special order.	
pursuance of Section 73 (3).	
The Controller General has authorized Assistant	
Controllers, Deputy Controllers, Joint Controllers and	
Senior Joint Controllers to discharge most of the functions	
under the Act.	
The Controller General has the power to withdraw any	
matter pending before an officer, by an order in writing	
	For better appreciation of this Manual, the user may require to have clear understanding of certain terms which are defined in the Act and Rules. Some of the important definitions are as under.  Definitions  "Controller" means the Controller General of Patents, Designs and Trade Marks referred to in Section 73 (1).  The Controller General of Patents, Designs and Trademarks is appointed by the Government of India under Section 3 of the Trademarks Act, 1999. The person so appointed will be the Controller of Patents for the purposes of Patents Act, 1970.  The Central Government may appoint examiners and other officers with designations as deemed fit, who shall discharge, under the superintendence and directions of the Controller General of Patents, Designs and Trademarks, such functions of the Controller under this Act, as he may authorize in writing from time to time, by general or special order.  Controller shall be construed as including a reference to any officer discharging such functions of the Controller in pursuance of Section 73 (3).  The Controller General has authorized Assistant Controllers, Deputy Controllers, Joint Controllers and Senior Joint Controllers to discharge most of the functions under the Act.  The Controller General has the power to withdraw any

	and for reasons to be recorded therein, and deal with	
	such matter himself, either de novo or from the stage it	
	was so withdrawn or transfer the same to another officer	
	who may, subject to special directions in the order of	
	such transfer, proceed with the matter either de novo or	
	from the stage it was so transferred.	
02.02.02	"Government undertaking" means any industrial	Section
	undertaking carried on –	2(1) (h),
	a. by a department of the Government, or	Section
	b. by a corporation established by a Central,	617 of the
	Provincial or State Act, which is owned or	Companies
	controlled by the Government, or	Act, 1956
	c. by a Government company as defined in section 617 of the Companies Act, 1956 (1 of	1100) 1700
	1956), or	
	d. by an institution wholly or substantially	
	financed by the Government.	
02.02.03	"Invention" means a new product or process involving	Section
	an inventive step and capable of industrial application.	2(1)(j)
02.02.03A	"New invention" means any invention or technology	Section
	which has not been anticipated by publication in any	2(1)(l)
	document or used in the country or elsewhere in the	
	world before the date of filing of patent application with	
	complete specification, i.e. the subject matter has not	
	fallen in public domain or that it does not form part of	
	the state of the art.	
02.02.04	"Inventive step" means a feature of an invention	Section
	that involves technical advance as compared to the	2(1)(ja)
	existing knowledge or having economic significance or	
	both and that makes the invention not obvious to a	
	person skilled in the art.	
02.02.05	"Capable of industrial application", in relation to	Section
	an invention, means that the invention is capable of	2(1)(ac)
	being made or used in an industry.	

02.02.06	"Legal representative" means a person who in	Section
	law represents the estate of a deceased person.	2(1)(k)
02.02.07	"Assignee" includes an assignee of the assignee and	Section
	the legal representative of a deceased assignee and	2(1)(ab)
	references to the assignee of any person include	
	references to the assignee of the legal representative or	
	assignee of that person.	
02.02.08	"Patentee" means the person for the time being entered	Section
	on the register as the grantee or proprietor of the patent.	2(1)(p)
02.02.09	"Patent office" means the patent office referred to	Section
	in section 74.	2(1)(r),
	Unlike many other Countries, for the purpose of	2 (2) (b), 74
	facilitating the registration of patents, Indian Patent	
	Office functions from four locations viz. Kolkata, Delhi,	
	Chennai and Mumbai.	
02.02.10	"Appropriate office" means the appropriate office of	Rule 2(b), 4
	the patent office as specified in rule 4.	
02.02.11	"Person" includes the Government.	Section
02.02.12	"Person interested" includes a person engaged in, or	2(1) (s) Section
02.02.12	in promoting, research in the same field as that to	2(1)(t)
	which the invention relates. (In the matter of 'Indian	2(1)(0)
	network for people living with HIV/AIDS' v/s 'Union of	
	India the Madras high court widehed the ambit of i	
	India' the Madras high court widened the ambit of "person interested" by including person/persons who	
	"person interested" by including person/persons who	
02.02.13	"person interested" by including person/persons who has a concern for public interest in the area of public	Section
02.02.13	"person interested" by including person/persons who has a concern for public interest in the area of public health and nutrition.	Section 2(1)(u)
02.02.13	"person interested" by including person/persons who has a concern for public interest in the area of public health and nutrition.  "Prescribed" means prescribed by rules made under	
	"person interested" by including person/persons who has a concern for public interest in the area of public health and nutrition.  "Prescribed" means prescribed by rules made under this Act.	2(1)(u)
	"person interested" by including person/persons who has a concern for public interest in the area of public health and nutrition.  "Prescribed" means prescribed by rules made under this Act.  "Opposition Board" means an Opposition Board	2(1)(u) Section 25
02.02.14	"person interested" by including person/persons who has a concern for public interest in the area of public health and nutrition.  "Prescribed" means prescribed by rules made under this Act.  "Opposition Board" means an Opposition Board constituted under sub - section (3) of section 25.	2(1)(u) Section 25 (3), 2(1) (la)

	first Importer of an invention into India, or a person	2(1)(y)
	to whom an invention is first communicated from	
	outside India.	
02.02.16	"small entity" means, -	Rule 2(fa),
	(i) in case of an enterprise engaged in the manufacture or	Section 7 (1)
	production of goods, an enterprise where the investment	(b) of MSME
	in plant and machinery does not exceed the limit specified	Development
	for a medium enterprise under clause (a) of sub-section	Act, 2006
	(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 ( I ) of	
	Section 7 of the Micro, Small and Medium Enterprises	
	Development Act, 2006.	
	Explanation 1 : For the purpose of this clause,	
	"enterprise" means an industrial undertaking or a	
	business concern or any other establishment, by whatever	
	name called, engaged in the manufacture or production of	
	goods, in any manner, pertaining to any industry specified	
	in the First Schedule to the Industries (Development and	
	Regulation) Act, 1951 (65 of 1951) or engaged in	
	providing or rendering of any service or services in such	
	an industry.	
	Explanation 2: 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.	
	Explanation 3: The reference rates of foreign currency of	
	the Reserve Bank of India shall prevail.	
	F	

02.02.17	"Startup" means	Rule 2(fb)
	(a) an entity in India recognised as a startup by the	
	competent authority under Startup India initiative.	
	(b) In case of a foreign entity, an entity fulfilling the	
	criteria for turnover and period of incorporation/	
	registration as per Startup India Initiative and submitting	
	declaration to that effect.	
	<b>Explanation</b> : In calculating the turnover, reference rates	
	of foreign currency of Reserve Bank of India shall prevail.	
02.02.18	"International Application" means an application for	Section
	patent made with accordance with the Patent Co-	2(1)(ia)
	operation Treaty .	

#### **Chapter 03: Filing of Patent Application**

#### 03.01 Applicant

Section 6,

An application for a Patent for an invention may be made by any of the following persons either alone or jointly with any other 134, 135;

Form-1

person:

True and first inventor

True and first inventor's assignee

Legal representative of deceased true and first inventor or

his/her assignee

The term "person" as defined in the Patents Act includes Government. The term "person" as defined in the General Clauses Act, 1897 includes any company or association or body of individuals, whether incorporated or not. In the case of a limited partnership, the application may be in the names of all personally responsible partners.

True and first inventor does not include either the first importer of an invention into India or a person to whom an invention is first communicated from outside India.

The applicant is required to disclose the name, address and nationality of the true and first inventor(s).

Assignee can be a natural person or a legal person such as a registered company, small entity, startup, a research organization, an educational institute or Government.

Assignee includes assignee of an assignee also. Wherever, the inventor(s) is/are not the applicant, a proof of right to apply, by way of an endorsement in the Application form (Form 1) or an assignment deed, shall be submitted.

Natural person means any individual or a group of individuals.

Other than natural person includes a registered company, small

entity, startup, research organization, educational institute or Government. Legal representative means a person who in law represents the estate of a deceased person. In such a case, the Legal Representative is required to file appropriate legal instruments as Proof of Right. 03.01.01 Procedure to be followed in case of death of applicant, or in Section 20 case the legal entity ceases to exist-substitution or addition of applicant. Form-6 a. If the applicant dies before the grant of patent, a request may be made by a person who would, by virtue of an assignment or agreement made in writing, or by operation of law, be entitled to interest in the patent. If one or more of the joint applicant(s) die(s) before the grant of the patent, the survivor(s) may, with the consent of the legal representative of the deceased, request for proceeding the application in the name of survivor(s). b. This procedure is also applicable to a legal entity which has ceased to exist before the grant of patent as well as to joint applicants where one of the applicants has died. In all these cases, when a request is made in Form-6, the Controller may allow such substitution. However, in case of joint applicants, the substitution can only be made with the consent of all the other joint applicants. c. When there is a dispute between joint applicants regarding such substitution, the Controller, after giving opportunity of being heard to all the applicants, may give such directions as he thinks fit for enabling the application to proceed. Accordingly, the Controller may direct that the application shall proceed in the name of one or more of the parties. Such directions may also relate to the manner in

which the application should proceed.

Further, the Controller shall not issue any such direction unless:

- i. the invention is identified in the agreement or assignment by reference to the number of application for the patent or,
- ii. there is an assignment/ agreement produced before the Controller by the person to whom it was made indicating that the assignment or agreement relates to the invention in respect of which the application is made or,
- iii. the rights of the claimant in respect of the invention have been finally established by decision of a court or,
- iv. the Controller takes a decision after hearing the disputed parties as per the proceedings under sub-section (5) of section 20.

#### 03.02 **Jurisdiction**

Unlike many other Countries, Indian Patent Office functions from four locations *viz.* Kolkata, Delhi, Chennai and Mumbai for carrying out all procedures relating to patents,

An application for patent shall be filed with the Patent Office having appropriate jurisdiction. Territorial jurisdiction of patent office in respect of a patent application is decided based on any of the following:

- i. Place of residence, domicile or business of the applicant (first mentioned applicant in case of joint applicants) or,
- ii. Place from where an invention actually originated or,
- iii. Address for service in India given by the applicant, when the Applicant has no place of business or domicile in India (Foreign applicants).

Also, the further application referred to in section 16 of the Act, shall be filed at the appropriate office of the first mentioned application only.

Section 16,

74.

Rule 4, 5.

#### Territorial jurisdictions are as under:

Patent Office	Territorial Jurisdiction
Mumbai	The States of Gujarat, Maharashtra, Madhya
	Pradesh, Goa, Chhattisgarh, the Union
	Territories of Daman & Diu and Dadra &
	Nagar Haveli
Delhi	The States of Haryana, Himachal Pradesh,
	Jammu and Kashmir, Punjab, Rajasthan,
	Uttar Pradesh, Uttarakhand, National Capital
	Territory of Delhi and the Union Territory of
	Chandigarh.
Chennai	The States of Andhra Pradesh, Karnataka,
	Kerala, Tamil Nadu, Telangana and the
	Union Territories of Pondicherry and
	Lakshadweep.
Kolkata	Rest of India (States of Bihar, Jharkhand,
	Orissa, West Bengal, Sikkim, Assam,
	Meghalaya, Manipur, Tripura, Nagaland,
	Arunachal Pradesh and Union Territory of
	Andaman and Nicobar Islands)

An appropriate office where a patent application is filed shall not be ordinarily changed.

However, the Controller may allocate an application for patent to any of the four Patent Offices, if required.

The appropriate office for filing a divisional patent application is the office where the main application is filed.

A applicant is required to give an address for service in India including a postal address in India and an email address.

However, a patent agent shall also be required to furnish a mobile number registered in India and an email address. Such address for service shall be considered for all proceedings under the Act and Rules.

	Appropriate office in relation to International Applications	
	under Patent Co-operation Treaty and National Phase	
	Applications:	
	(1) The receiving office, designated office and elected office for	
	the purpose of International Applications filed under the	
	Treaty shall be the appropriate office in accordance with	
	Rule 4.	
	(2) An International Application under the PCT shall be filed at	
	and processed by the appropriate office in accordance	
	with the provisions of Chapter III of the Patents Rules, the	
	Treaty and the Regulations established under the PCT.	
03.03	Types of Patent Applications	Section 7,
	1. Ordinary Application, i.e., an application which has been	16, 54, 135
	filed directly in the Indian Patent Office without claiming	
	priority.	
	2. Convention Application.	
	3. PCT National Phase Application.	
	4. Divisional Application, i.e, a further application divided	
	out of the first mentioned Patent Application.	
	5. Patent of Addition, i.e. an application for patent in respect	
	of any improvement in or modification of the invention for	
	which patent application has already been filed or Patent	
	has been granted .	
03.04	Filing of patent application	
	Every application for a patent shall be for one invention only and	Section 7,
	shall be filed in Form-1 along with Provisional/Complete	First
	Specification, accompanied with the prescribed fee as given in	Schedule
	First Schedule, at an appropriate office. However, a provisional	
	specification cannot be filed in case of Convention Application	
	or application filed under PCT designating India	
	(For further description of Provisional / Complete Specifications	

refer Chapter 5).

Normal fee shall be applicable for applications containing up to thirty pages in specification and up to 10 claims. If the specification exceeds thirty pages or claims are more than ten in number, additional fee as given in First Schedule is payable.

It may be noted that 10 % additional fee shall be payable when the application for patent and other documents are filed through physical mode, namely, in hard copy format.

#### **E-Filing of Patent Application:**

IPO has developed comprehensive e-filing system for patents, wherein, in addition to online filing of new applications, subsequent filing of all the documents has also been integrated.

New and enhanced features of Comprehensive E –filing services include:

- Web- based filing system
- Dual way login (Digital Signature as well as Password based)
   and password regeneration
- Provision for filing of all entries as per First Schedule of the Patents Rules, 2003
- Proper validations with Patent Office database
- Facility to upgrade / update digital signatures

(https://ipindiaonline.gov.in/epatentfiling/goForLogin/doLogin)

#### 03.04.01

#### **Documents required for filing Patent Application**

#### A patent application should contain:

- 1. Application for grant of patent in Form-1.
- 2. A proof of right from the inventor(s) by way of endorsement in the appropriate column of Form-1 or as an assignment duly authenticated. It shall be filed within 6 months from the date of filing of the application in India.
- 3. Provisional / Complete specification in Form-2.
- 4. Statement and undertaking under Section 8 (1) in Form-3:
  An applicant must file Form 3 either along with the application or within 6 months from the date of application.
- 5. Declaration as to inventorship shall be filed in Form-5 along with the complete specification filed after provisional specification. However, the Controller may allow Form-5 to be filed within one month from the date of filing of complete specification, if a request is made to the Controller in Form- 4.
- 6. If an applicant is MSME/ Startup, Form 28, accompanied with appropriate evidence of being MSME/ Startup, shall be submitted in accordance with rule Rule 2(fa)/ 2(fb), respectively.
- 7. **Form of Authorisation:** The authorisation of an agent shall be filed in Form 26 or in the form of a power of attorney within a period of three months from the date of filing of such application or document, failing which no action shall be taken on such application or documents for further processing till such deficiency is removed.

In case a general power of attorney has already been filed in another application, a self-attested copy of the same shall be filed along with Form 26 by the authorized Patent Agent.

#### 8. Priority document is required in the following cases:

a. Convention Application (under Paris Convention).

Section 7.
Rule 2(fa)/
2(fb),
Rule 8, 10,
12, 13, 135.
Form-1, 2, 3,
5, 26, 28.
Section 6 of
Biological
Diversity
Act, 2002.

Rule 17.1

Regulations

of PCT

 PCT National Phase Application wherein requirements of Rule 17.1 (a or b) of regulations made under the PCT have not been fulfilled.

The priority document should be filed along with the PCT National phase application before the expiry of 31 months from the date of priority.

- 9. Every application shall bear the signature of the applicant or authorized person/patent agent along with name and date in the appropriate space provided in the forms.
- 10. The Specification shall be signed by the applicant or his authorized person / patent agent with date on the last page of the claims contained in the Specification. Drawing sheets should bear the signature of an applicant or his authorized patent agent in the right hand bottom corner.
- 11. If the application pertains to a biological material obtained from India, the applicant is required to submit the permission from the National Biodiversity Authority any time before the grant of the patent.
- 12. The application shall disclose in the Specification the source of geographical origin of any biological material, when used in the invention .

#### 03.04.02 | Comprehensive E-filing:

Rule 6

E-filing Portal of Patent Office, available in the official website of Controller General of Patents, Designs & Trade Marks (www.ipindia.nic.in), provides a comprehensive platform for online submission of patent applications and subsequent forms in a secure and authenticated electronic way.

Authentication of the filing is done via a digital signature which the applicant or his agent must procure as Digital Signature Certificate (DSC) of class II or III from authorized vendors. (List is given on website).

Online payment of fees is effected through a payment gateway with all the prevalent major modes of payment, like Net banking, Credit Cards, Debit Cards or ATM Cards.

The portal provides flexibility to applicants or their authorized agents to work from their premises on 24x7 basis, even on holidays.

#### Steps of e-filing:

- 1. Visit -<u>www.ipindia.gov.in</u> and proceed to E-Gateways
- 2. Register for New User and creation of "userid"
- 3. Install Digital Signature Certificate (DSC) and configure the system as per the DSC manual
- 4. Login to the e-filing module
- 5. Select New Application filing or any particular Form which is to be filed
- 6. Draft the new application or any subsequent forms
- 7. Upload the PDF version of required documents
- 8. Save the draft
- 9. Go to the drafted forms
- 10. Enter the mobile number, if SMS alert are required
- 11. Select the drafted form and proceed for signing of drafted form
- 12. After the forms are digitally signed, it is ready for making the payment though the available Payment Gateways
- 13. Select the digitally signed form and proceed for payment
- 14. Select the payment gateway (NTRP Bharatkosh payment gateway)
- 15. Select the bank and payment mode to make the payment of fee
- 16. After payment acknowledgement receipt would be generated.

Submitted forms would then proceed to the respective section of the Patent Office for processing and official actions.

- 1. Any Application, notice or other document authorised or required to be filed, left, made or given at the Patent office, or to the Controller or to any other person under the Act or the rules, may be tendered by hand or sent by a letter addressed to the Controller at the Appropriate Office or to that person through post or registered post or speed post or by electronic transmission duly authenticated.
- 2. 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.

- 3. If it is sent by post or registered post or speed post or by electronic transmission duly authenticated, it shall be deemed to have been filed, left, made or given at the time when the mail containing the same would have been delivered in the ordinary course of post or registered post or speed post or by electronic transmission duly authenticated, as the case may be. In proving such sending, it shall be sufficient to show that the mail was properly addressed and transmitted.
- 4. In case of a postal delay, the Controller follows the provisions of the above paragraph with regard to the date of receipt of the document.
- 5. Any written communication addressed to a patentee at his postal address or email address, as it appears on the register of patents or at his address for service given under rule 5, or

to any applicant or opponent in any proceedings under the Act or the rules, at the postal address or email address appearing on the Application or notice of opposition, or given for service, shall be deemed to be properly addressed.

- 6. All notices and all written communications addressed to a patentee, or to any applicant or opponent in any proceedings under the Act or the rules, and all documents forwarded to the patentee or to the said applicant or opponent, shall, except when they are sent by special messenger, be sent by registered post or speed post or by electronic transmission duly authenticated.
- 7. The date of notice or written communication addressed to a patentee or to any applicant or opponent in any proceedings under the Act and the rules shall be the date of dispatch of the said notice or written communication, by registered post or speed post or fax or electronic transmission duly authenticated, as the case may be, unless otherwise specified under the Act or the rules.
- 8. In case of delay in receipt of a document or communication sent by the Patent office to a party to any proceedings under the Act or the rules, the delay in transmitting or resubmitting a document to the Patent office or doing any act by the party may be condoned by the Controller if a petition for such condonation of delay is made by the party to the Controller immediately after the receipt of the document or communication along with the statement regarding the circumstances of the fact and evidence in support of the statement:

Provided that the delay condoned by the Controller shall not exceed the period between the date on which the party was supposed to have received the document or communication by ordinary course of mail or electronic transmission duly authenticated and the actual date of receipt of the same.

The condonation of such delay can also be made for reasons of war, revolution, civil disorder, strike, natural calamity, a general unavailability of electronic communication services or other similar reasons occurred in the locality where the applicant/agent resides or has place of business. The delay can be allowed when the applicant/agent files a petition for condonation of such delay to the Controller provided the situation was of such severity that it disrupted the normal communication in that area and that the petition is filed within maximum one month from the date of cessation of the such situation.

#### 03.04.04 Receiving documents in Office:

- 1. The application and any other documents with or without accompanying fees is received at the Patent Office at separate counters known as Fee Counter (FC) and Non-Fee Counter (NFC), respectively.
- 2. The fee bearing documents are sent to the fee counter and the non-fee bearing documents are sent to the non-fee counter.
- 3. The staff at the fee counter makes relevant entries in the module. stamps the documents so received, generates the Cash Book Receipts (CBRs) and enters the CBR number, date, amount of fee received, application number, patent number or other relevant entries.
- 4. The staff at the non-fee counter makes relevant entry in the document receipt module and stamps the documents
- 5. The documents from both the counters are sent on an hourly basis to the Electronic Data Processing (EDP) Section for digitization.
- 6. Documents requiring no digitization are sent to the

	concerned section on daily basis.	
03.04.05	Language and Paper size etc.	Rule 9
	All documents and copies of the documents, except affidavits and drawings, filed with patent office, shall be -	
	1. Filed in typewritten or printed in Hindi or English (unless otherwise directed or allowed by the Controller) in large and legible characters not less than 0.28 centimetre high with deep indelible ink with lines widely spaced not less than one and half spaced, only upon one side of the paper;	
	2. Filed on such paper which is flexible, strong, white, smooth, non-shiny, and durable of size A4 of approximately 29.7 centimetre by 21 centimetre with a margin of at least 4 centimetre on the top and left hand part and 3 centimetre on the bottom and right hand part thereof;	
	3. Filed with numbers in consecutive Arabic numerals in the centre of the bottom of the sheet; and	
	4. Filed with the numbering to every fifth line of each page of the description and each page of the claims at right half of the left margin.	
	5. Additional copies of all documents shall be filed at the appropriate office as may be required by the Controller.	
	6. Names and addresses of applicant and other persons shall be given in full, together with their nationality and such other particulars, if any, as are necessary for their identification.	
	Signature	
	Any signature which is not legible or which is written in a script other than Hindi or English shall be accompanied by a transcription of the name either in Hindi or in English in block letters.	
03.04.06	Sequence listing	Rule 9
	If the application for patent discloses sequence listing of	

nucleotides or amino acid sequences, the sequence listing of nucleotides or amino acid sequences shall be filed in computer readable text format along with the application, and no print form of the sequence listing of nucleotides or amino acid sequences is required to be given.

A nucleotide sequence shall be listed with a maximum of 60 bases per line, with a space between each group of 10 bases. The bases of a nucleotide sequence (including introns) shall be listed in groups of 10 bases, except in the coding parts of the sequence. Leftover bases, fewer than 10 in number at the end of noncoding parts of a sequence, should be grouped together and separated from adjacent groups by a space. The bases of the coding parts of a nucleotide sequence shall be listed as triplets (codons).

Any sequence listing in electronic form shall be contained within one electronic file encoded using IBM39 Code Page 437, IBM Code Page 93240 or a compatible code page to represent the sequence listing with no other codes included.

Any sequence listing in the electronic document format as specified shall preferably be created by dedicated software such as PatentIn.

(Reference: WIPO STANDARD ST.25 STANDARD FOR THE PRESENTATION OF NUCLEOTIDE AND AMINO ACID SEQUENCE LISTINGS IN PATENT APPLICATIONS

#### **URL**:

https://www.wipo.int/export/sites/www/standards/en/pdf/03-25-01.pdf)

#### 03.04.07 Fee:

 Fee payable under the Act in case of offline filing may either be paid in cash 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. 142, Rule 7, First Schedule

Section

- 2. If the draft or banker's cheque is sent by post, the fee shall be deemed to have been paid on the date on which the draft or banker's cheque has actually reached the Controller.
- 3. Ten percent additional fee shall be payable when the application for patent and other documents are filed through physical mode, namely, in hard copy format.
- 4. In case of online filing, payment of fees is effected through a payment gateway with all the prevalent major modes of payment like Net banking, Credit Cards, Debit Cards or ATM Cards.
- 5. When a small entity/start up is an applicant, every subsequent document for which a fee has been specified, shall be accompanied by duly authenticated copy the evidence of small entity/start up. .
- 6. In case an application processed by a natural person is fully or partially transferred to a person other than a natural person, the difference, if any, in the scale of fee(s) between the fee(s) charged from a natural person and the fee(s) chargeable from the person other than a natural person in the same matter for all previous proceedings shall be paid by the new applicant with the request for transfer in Form 6 along with Form 30.
- 7. When an application processed by a small entity is fully or partly transferred to a person other than a natural person (except a small entity), the difference, if any, in the scale of fee(s) between the fee(s) charged from a small entity and the fee(s) chargeable from the person other than a natural person (except a small entity) in the same matter for all previous proceedings shall be paid by the new applicant with the request for transfer in Form 6 along with Form 30
- 8. When an application is filed 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 for all previous proceedings along with the request for transfer in Form 6 along with Form 30.:

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

- 9. Where a fee is payable in respect of a document, the entire fee shall accompany the document.
- 10. Where a fee is payable in respect of the doing of an act by the Controller, the Controller shall not do that act until the fee has been paid.
- 11. Fee once paid in respect of any proceedings shall not be ordinarily refunded whether the proceedings have taken place or not. However, on the request by the applicant/agent in Form 30 and if the Controller is satisfied that during the online filing process, the fee was paid more than once for the same proceeding, the excess fee shall be refunded.
- 12. Prescribed fee for various proceedings under the Act is given in First Schedule.

# O3.05 Processing of Application O3.05.01 Initial processing 1. On receipt of an application, the Office accords a date and serial number to it. Requests for examination are accorded separate serial numbers.

2. Applications and other documents filed in physical form are

- digitized, verified, screened, classified and uploaded to the internal server of the Office.
- 3. Patent applications and other documents are arranged in a e-wrapper.
- 4. The Application is screened for:
  - a. International Patent Classification
  - b. Technical field of invention for allocation to an examiner in the respective field
  - c. Relevance to defence or atomic energy.
  - **d.** Correct/complete abstract. If found not proper, the abstract will be amended suitably, so as to provide better information to third parties. However, care is taken that such amendment does not result in a change in the nature of invention.

#### 03.05.02 Numbering System for Applications

- FORMAT: YYYY J T NNNNNN , Where,
- "YYYY" is Four digit fixed length "Year of filing"
   (in YYYY/MM/DD)
- "J" is fixed length single digit "Jurisdiction" in numerals (1 for Delhi, 2 for Mumbai, 3 for Kolkata, 4 for Chennai)
- "T" is fixed length single digit "Type of Application" in numerals:
  - (1 for Ordinary; 2 for Ordinary-Divisional; 3 for Ordinary-Patent of Addition; 4 for Convention; 5 for Convention-Divisional; 6 for Convention-Patent of Addition; 7 for PCT NP; 8 for PCT NP-Divisional and 9 for PCT NP-Patent of Addition)
- "NNNNN" is 6 digits fixed length common continuous running serial number of applications applicable for all

Г		
	Patent Offices in India	
	Thus, 1 <sup>st</sup> application (Ordinary) filed in Delhi in 2019 will	
	be numbered as 201911000001.	
	If 2 <sup>nd</sup> application in 2019 is "Convention" application from	
	Mumbai it would be numbered as 201924000002.	
00.0 = 00		
03.05.03	i. Numbering Format for Request for Examination	
	Format: RYYYYJNNNNNN	
	Where, "R denotes Request for examination u/r 24B(1) (i)	
	"YYYY" denotes four digit fixed length "Year of filing"	
	"J" denotes Jurisdiction for Patent Application against	
	which Request of Examination has been filed	
	• "NNNNN" denotes 6 digits fixed length common	
	continuous running serial number applicable for all Patent	
	Offices in India.	
	ii. Numbering Format for Request for Expedited Examination	
	Format: EYYYYJNNNNNN	
	Where, "E denotes Request for expedited examination	
	under rule 24 (C)	
03.05.04	Scrutiny of application	
	1. The Office checks whether the Application has been filed in	
	appropriate jurisdiction (see <b>03.02</b> ). If the jurisdiction is not	
	appropriate, the application shall not be taken on record and	
	the applicant is informed accordingly.	
	2. The Office checks for Proof of Right to file the application (See	
	03.04). If the proof of right is not filed along with the	
	application, it shall be filed within a period of six months from	
	the date of filing of the application. Otherwise, the applicant	
	shall file the same along with a petition under Rule 137/138.	
	3. The Office checks whether the application and other	
	documents have been filed in the prescribed format i.e.	

prescribed forms, request, petitions, assignment deeds, translation etc.

- 4. Further, the Office checks whether:
  - a. the documents are prepared on a proper sized paper, typed in appropriate font with proper spacing,
  - b. the documents are duly signed
  - c. abstract, drawings (if any) have been filed in proper format.
  - d. meaningful claim(s) are present in a complete specification,
  - e. whether, Authoristion of an Agent in Form 26 or in the form of a power of attorney is filed within a period of three months from the date of filing of such application or document.
  - f whether, Form-5 has been filed, if required.
  - g. whether the invention has been assigned to another person and Form 6 has been duly filed along with the deed of assignment. If the right is assigned from an individual to a legal entity, the legal entity is invited to pay the balance fees.

#### 03.05.05 Secrecy Directions and consequences thereof

- Section 35, 36, 37, 38
- 1. If in the opinion of the Controller an invention pertains to a subject matter relevant for the purpose of defence, as notified by the Central Government, or, the Controller, issues secrecy directions prohibiting the publication of the application to the applicant and refers the matter to the Central Government for their consideration as to whether the application is prejudicial to the defence of India.
- 2. The Central Government, after considering the merits of the secrecy direction, may give notice to the Controller as to whether the secrecy direction needs to be continued or not.
- 3. The Central Government reviews the matter at an interval of

six months. The applicant may request for a reconsideration of the secrecy direction and, if the same is found reasonable by the Controller, he may request the Central Government for a review. 4. If the Central Government is of the opinion that an invention in respect of which the Controller has not imposed a secrecy direction and is relevant for defence purposes, it may at any time before the grant of the patent notify the Controller that effect. Thereupon, the Controller invokes the provisions of Section 35(1). 5. So long as any directions under Section 35 are in force, the Controller shall not take a decision on grant/refusal of the application. 03.05.06 **Inventions relating to Atomic Energy** Section 4 of the Patents 1. No Patent is granted in respect of an invention relating to Act, 1970; atomic energy falling within sub-section (1) of Section 20 of the Atomic Energy Act, 1962. 2. According to Section 20(1) of Atomic Energy Act, atomic Section energy means energy released from atomic nuclei as a result 2 of the of any process including the fission and fusion processes. Atomic Under this Act, "prescribed substances" means any substance Energy including any mineral which the Central Government Act, may, by notification, prescribe, being a substance which in its 1962. opinion is or may be used for the production or use of atomic S.0.61(E) energy or research. The updated list of "prescribed substances" under Atomic Energy Act 1962, published vide notification dated 28th April, 2016, may be accessed at http://dae.nic.in/writereaddata/Prescribed-eng.pdf 3. Upon screening, if an Application is found to be falling within the purview of the Atomic Energy Act, the Controller refers

the Application to the Central Government. 4. The Central Government upon consideration may issue a direction to the Controller, which is final. 5. The opinion of the Central Government is not open to an appeal. 03.06 Withdrawal of patent application Section 11A(3)(c), The applicant may, at any time after filing the application but 11B(4), Rule before the grant of a patent, withdraw the application by making a 7(4A) and request in writing. A request for withdrawing the application 26, Form 29, under sub-section (4) of section 11B shall be made in Form 29. First However, if the applicant makes a request for withdrawal Schedule within 15 months from the date of filing or priority of the application, whichever is earlier, the application will not be published. Withdrawal and Refund of Fees: If request for withdrawal of an application is filed in respect of which a request for examination has been filed but FER has not been issued. 90% of the fee paid for request examination/expedited examination can be refunded prescribed in the First Schedule, on a request made by the applicant in Form 29.

#### Chapter - 4: Publication of Application

#### **04.01** | Publication of Patent Application

- a) An application for Patent is not open to public before the expiry of 18 months from the date of filing or date of priority, whichever is earlier.
- Section 11A, Rule 24
- b) At the end of 18 months period from the date of filing or from the date of priority whichever is earlier, the Application is published in the Official Journal except in the cases, where:
  - i. Secrecy direction u/s 35 is in force.
  - ii. Application is abandoned u/s 9(1) (i.e., complete Specification not filed within twelve months from the date of filing of Provisional Specification).
  - iii. Application is withdrawn three months prior to the publication period, i.e., before the end of 15th month from the date of filing or priority, whichever is earlier.
    - This will apply for PCT National Phase Applications as well, if such application has been filed in India before the expiry of 15 months from the date of priority.
- c) The Patent Office publishes the application in the official e-Journal, ordinarily within one month from the date of expiry of 18 months from the date of filing or priority, whichever is earlier.
- d) Where a secrecy direction has been given, the application will be published only when the secrecy direction is revoked, subject to the expiry of the 18- month period from the date of filing or priority.
- e) Publication of application under sub-sections (2) and (5) of section 11A shall be identified by the letter 'A' along with the number of application.

04.02	Early Publication	Section11A(2),
	a) A request for early publication may be made in Form-9 with	Rule 24A
	the prescribed fee.	Form-9,
	b) The request for early publication will be considered if the	First Schedule
	patent application does not pertain to subject matter relevant	
	for defence purpose.	
	The application is published within one month from the date	
	of such request.	
04.03	Particulars of Publication	Section 11A
04.03	Fai ticulais of Fublication	Section 11A
	The Patent Office Journal is published on every Friday with the	
	following particulars:	
	i. Application number	
	ii. Date of filing	
	iii. Title of invention	
	iv. Publication date	
	v. International Patent Classification	
	vi. Name and address of the applicant	
	vii. Name of the inventor(s)	
	viii. Priority details like priority document number, number,	
	date, country etc.	
	ix. Reference to Patent of Addition /Divisional Application	
	along with filing date of the parent Application.	
	x. Abstract	
	xi. No. of claims	
	xii. Drawings (if any)	
04.04	Effects of Publication	Section
	a) Upon publication, the Patent Office makes the	11A(6), Rule
	specification (complete as well as provisional, if any), abstract,	27, 55(1A).
	drawings and any other documents filed in respect of the	
	application available to the public on its website and copies	
	of the same can also be made available on payment of the	

- prescribed fee as given in the First Schedule, if such a request is filed.
- b) After publication of the application for Patent, the depository institution will make the biological material, mentioned in the specification, available to the public.
- c) On and from the date of publication of the application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for the invention had been granted on the date of publication of the application:
  - Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been granted:
- d) No patent shall be granted before the expiry of six months from the date of publication of the application.

**Chapter - 5: Provisional and Complete Specification** 

05.01	Specification	
	The Specification is a techno-legal document containing full	Section 9,
	scientific details of the invention and claims to the patent rights.	10, 57, 59.
	The Specification, thus, forms a crucial part of the Patent	Rule 13, 14,
	Application.	24A,
	The Specification may be filed either as a Provisional or complete Specification.	Form-1, 2
	Provisional or Complete Specification shall be submitted in	
	Form-2 along with the Application Form-1 and other documents,	
	in duplicate, accompanied with the prescribed fee as given in the First Schedule.	
	The first page of the Form 2 shall contain:	
	a) Title of the invention;	
	b) Name, address and nationality of each of the applicants for the Patent; and	
	c) Preamble to the description.	
	Title of the invention shall disclose the specific features of the invention normally in not more than fifteen words.	
	The applicant shall submit drawings, wherever required. The Controller may also require the applicant to submit drawings, if necessary at the examination stage. Such drawings shall form a part of the Specification and suitable references thereto shall be made in the Specification. The Controller may require the applicant to submit, any time before the grant, models or samples related to the invention for better illustration of the invention. However, such models or samples shall not form part of the Specification.	
	Filing amendments in the specification:	
	1) When amendments are made to a provisional or complete	

specification or any drawing accompanying it, the pages incorporating such amendments shall be retyped and submitted to form a continuous document.

- 2) A marked copy clearly identifying the amendments carried out and a statement clearly indicating the portion (page number and line number) of the specification or drawing being amended along with the reason shall also be filed.
- 3) Amendments shall not be made by slips pasted on, or as footnotes or by writing in the margin of any of the said documents.
- 4) When a retyped page or pages incorporating amendments are submitted, the corresponding earlier page shall be deemed to have been superseded and cancelled by the applicant.

# 05.02 Provisional Specification

- Section 9, 11A(3)(b), 17
- a) When the applicant finds that his invention has reached a stage wherein it can be disclosed, but has not attained the final stage, he may prepare a disclosure of the invention in the form of a written description and submit it to Patent Office as Provisional Specification.
- b) A Provisional Specification secures a priority date for the application over any other application which is likely to be filed in respect of the same invention being developed concurrently.
- c) An application filed with provisional specification is deemed to be abandoned if no complete specification is filed within twelve months from the date of filing of the provisional specification [S. 9 (1)].
- d) If in the opinion of the Controller, two provisional specifications filed by an applicant are cognate or if one is a modification of the other, he may allow the applicant to file

one complete specification covering both the provisional applications. Such a complete specification shall have to be filed within twelve months from the date of filing of the first provisional application. In such cases, date of filing of application is the date of filing of the earliest provisional specification and shall bear the number of that application. [S 9 (2)]

- e) An applicant may, within twelve months from the filing of a complete specification (not being a convention application or a PCT National Phase Application), convert the same into a provisional specification. Consequently, the applicant has to file a complete specification within twelve months from the date of first filing. [ ( S. 9 (3) ]
- f) After filing complete Specification, he may cancel the provisional specification (i.e. the one filed directly u/s 9 (1) or the one converted from a complete specification ( u/s 9 (3) ), and request for post-dating of application to the Date of filing of the complete specification.

# **05.02.02** | Contents of Provisional Specification:

A Provisional Specification is not a rough draft or a skeleton of the complete specification. A complete specification, which follows later, does not replace the Provisional Specification. Both are permanent and separate documents.

- a) A Provisional Specification shall essentially contain the title and description of the invention and shall start with a preamble: "The following Specification describes the invention".
  - Claims should not be included in the Provisional Specification as the purpose of filing a Provisional Specification is to claim a priority date.
- b) The description starts from the second page starting with the field of invention and containing the background of

	<ul><li>the invention, object of the invention and statement of the invention.</li><li>c) It is advisable to include in the Provisional Specification as much information as the applicant has at the time of filing.</li><li>d) It may be noted that a Provisional Specification cannot be filed in case of a Divisional, Convention or a PCT National</li></ul>	
	Phase Application. In such cases, filing a Complete Specification is a mandatory requirement.	
05.03	Complete Specification	Section 10
	The Complete Specification is a techno-legal document which fully and particularly describes the invention and discloses the best method of performing the invention.  As the Complete Specification is an important document in the patent proceedings, it is advised that it should be drafted with utmost care without any ambiguity.  It is mandatory on the part of an applicant to disclose fully and	
	particularly various features constituting the invention. The disclosure of the invention in a complete specification must be such that a person skilled in the art should be able to perform the invention.	
	Important elements of the Complete Specification are discussed below.	
05.03.01	Contents of Complete Specification	Section
	Every complete specification shall:  a) fully and particularly describe the invention and its operation or use and the method by which it is performed;	10(4)
	b) disclose the best method of performing the invention which is known to the applicant for which he is entitled	

	to claim protection;	
	c) end with a claim or set of claims defining the scope of the	
	invention for which the protection is claimed;	
	d) make reference to deposit of the biological material in the	
	international depository authority, if applicable; and	
	e) be accompanied by an abstract.	
	f) Irrelevant or other matter, not necessary in the opinion of	
	the Controller for elucidation of the invention, shall be	
	excluded from the title, description, claims and drawings.	
05.03.02	National phase applications	Section
	In case of national phase applications, the title, description,	10(4A),
	drawings, abstract and claims filed with the international	Rule 20(1)
	application are taken as a complete specification. An application	
	corresponding to an International application filed under PCT	
	may be made in Form-1.	
	However, the applicant, while filing such application	
	corresponding to an international application designating India,	
	may delete a claim, in accordance with the provisions contained	
	in rule 14.	
	(For further details of the PCT National Phase Applications,	
	please see Chapter 7)	
05.03.03	Title	Rule
	The title should be sufficiently indicative of the subject matter of	13(7)(a)
	the invention and shall disclose the specific features of the	
	invention. It need not be the same as the preamble of the main	
	claim. It shall be brief, free from fancy expressions or ambiguity	
	and as precise and definite as possible, but it need not go	
	into the details of the invention itself. Title should not	
05 00 04	ordinarily exceed fifteen words.	
05.03.04	Field of the Invention and use of Invention	
	The description should preferably begin with a general	

	statement of the invention so as to indicate briefly the subject	
	matter to which the invention relates, e.g. "This invention relates	
	to". Thereafter, the advantages of the invention may	
	be mentioned to bring out clearly the areas of application and	
	preferable use of the invention. The applicant may substantiate	
	industrial applicability of the invention in this part.	
05.03.05	Prior Art and problem to be solved	
	This part should indicate the status of technology in the field of	
	invention with reference to developments in the field including	
	patents and pending patent applications in the specific art.	
	When the invention relates to improvement over the existing	
	product or process, a short statement of the closest prior art	
	known to the applicant in that respect shall also be given.	
	However, the description should fully and particularly describe	
	the invention, by clearly distinguishing it from such a closest	
	prior art, known to the applicant.	
05.03.06	Objects of the Invention	
	The purpose of this part is to clearly bring out the necessity of	
	the invention. It shall clearly mention the technical problems	
	associated with the existing technology and the solution for that,	
	bringing out the differences between the claimed invention and	
	the prior art. The solution sought by the invention should be	
	clearly brought out as object(s) of inventions with statements	
	like	
	"The principal object of this invention is",	
	"Another object of this invention is",	
	"A further object of this invention is" etc.	
05.03.07	Summary of the Invention	
	1	
	The description should include a summary of invention before	
	The description should include a summary of invention before giving the details of the invention and the method of performing	

novel features of the invention for which protection is desired. This part is intended to declare different aspects of the invention.

# **05.03.08** | **Detailed Description of the Invention**

- a) Description of an invention is required to be furnished in sufficient detail so as to give a complete picture of the invention and follows the Summary of invention. The nature of improvements or modifications effected with respect to the prior art should be clearly and sufficiently described. It may include examples/drawings or both for clearly describing and ascertaining the nature of invention. Examples must be included in the description, especially in the case of chemical related inventions.
- b) The details of invention described should be sufficient for a person skilled in the art to perform the invention without further experimentation.
- c) Reference to the drawings should be specific and preferably in the following form: This invention is illustrated with the help of the accompanying drawings......
- d) The Specification in respect of Patent of Addition should contain at the beginning of the description, a definite statement indicating an improvement in or modification of the original invention and the serial number of the Application for Patent in respect of the original invention. The Specifications should also contain a short statement of the invention as disclosed in the earlier Specification.
- e) Terms in other languages, if any, used in the description should be accompanied by their English equivalents. The use of vague words, slang and colloquialisms is objectionable and shall be avoided.
- f) In case a biological material described in the specification is not available to the public and cannot be described

adequately as per the provisions of the Act, such material shall be deposited, in order to make the application complete, with the International Depository Authority under the Budapest Treaty, on or before the date of filing. The International Depository Authority in India are:

Microbial Type Culture Collection and Gene Bank (MTCC)
 Chandigarh.

For further information on Microbial Type Culture Collection and Gene Bank (MTCC) please visit - <a href="https://mtccindia.res.in/">https://mtccindia.res.in/</a>

• National Centre for Cell Science, Pune (NCCS)

For further information on NCCS please visit - <a href="http://www.nccs.res.in/">http://www.nccs.res.in/</a>

- g) Reference to such biological material shall be made in the Specification within three months from the date of filing, giving all the available characteristics of the material required for it to be correctly identified or indicated including the name, address of the depository institution and the date and number of the deposit of the material at the institution.
- h) If there is any request for early publication, then the said reference shall be given on or before the date of filing of such request.
- Further, the source and geographical origin of the biological material specified in the Specification shall also be disclosed.
- j) Access to the material in the depository institution is available only after the date of application of patent in India.
- k) In the case of Biotechnology related inventions, reference to the relevant sequence ID (SEQ ID), if any, shall be mentioned in the description/claims of the specification.

05.03.09	Drawings	Rule 15
	a) Drawings or sketches, which require a special illustration of the invention, shall not appear in the description itself. Such drawings shall be on separate sheet(s).	
	b) Drawings shall be prepared neatly and clearly on durable paper sheet.	
	c) Drawings shall be on standard A4 size sheets with a clear margin of at least 4 cm on the top and left hand and 3 cm at the bottom and right hand of every sheet.	
	d) Drawings shall be on a scale sufficiently large to show the inventions clearly and dimensions shall not be marked on the drawings.	
	e) Drawings shall be sequentially or systematically numbered and shall bear—	
	i. in the left hand top corner, the name of the applicant;	
	<ul><li>ii. in the right hand top corner, the number of the sheets of drawings, and the consecutive number of each sheet; and</li></ul>	
	iii. In the right hand bottom corner, the signature of the applicant or his agent.	
	f) No descriptive matter shall appear on the drawings except in the flow diagrams.	
05.03.10	Abstract	Rule 13(7)
	a) Every complete specification shall be accompanied by an	
	abstract to provide technical information on the invention.	
	The abstract shall commence with the title of the invention.	
	b) The abstract shall be so drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical field.	

c) The abstract shall contain a concise summary of the matter contained in the specification. 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. Wherever necessary, the abstract shall contain the chemical formula which characterizes the invention. d) The abstract may not contain more than one hundred and fifty words. e) If the specification contains any drawing, the applicant shall indicate reference numerals of drawings in the abstract, which may accompany the abstract when published. Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by the reference sign used in that drawing. f) The Controller may amend the abstract for providing better information to third parties. 05.03.11 **Best Method** Section 10 The Act specifically requires that the complete specification must describe the best method of performing the invention known to the applicant, including the one, which he may have acquired during the period of provisional protection prior to the date of filing the complete specification. 05.03.12 Section Claims 10(4)(c)Claims define the contours of rights, if and when a patent is granted for an invention. Hence, claims are the most critical part of a Patent Application. In a complete specification the description is followed by claims. Since, claims define the scope of legal protection, they should be drafted carefully to cover all the aspects of the protection being sought; at the same time

	adequately distinguishing the prior art from the claimed	
	invention.	
05.03.13	Unity of invention and clarity of claims	Section
	a) Claim(s) of a Complete Specification shall relate to a single	10(5)
	invention, or to a group of inventions linked so as to form a	
	single inventive concept.	
	b) Claims shall be clear and succinct and fairly based on the	
	matter disclosed in the specification.	
05.03.14	Significance of Claims	
	a) A claim is a statement of technical facts expressed in legal	
	terms defining the scope of the invention sought to be	
	protected. No exclusivity is obtained for any matter	
	described in the Complete Specification unless it is claimed	
	in the claims. What is not claimed in the claims stands	
	disclaimed and is open to public use, even if the matter is	
	disclosed in the description.	
	b) Claims define the boundaries of legal protection sought by	
	the patentee and form a protective fence around the	
	invention which is defined by the words and phrases in the	
	claims.	
	c) Claims shall define clearly the scope of the invention with	
	conciseness, precision and accuracy, so that others may	
	know the exact boundary into which they should not	
	trespass.	
	d) Each claim is evaluated on its own merit and, therefore, if	
	one of the claims is objected, it does not mean that the rest of	
	the claims are invalid. It is therefore important to make	
	claims on all aspects of the invention to ensure that the	
	applicant gets the widest possible protection.	
05.03.15	Scope of claims	
	a) Claims must not be too broad to embrace more than what	

- the applicant has in fact invented. A Claim which is too broad may encroach upon the subject matter which is in public domain or belongs to others.
- b) However, a claim may not be too narrow also because such a Claim would not be sufficiently effective against potential infringement. An infringer would go scot-free, if the claims were too narrow and hence, the full benefit of the invention may not accrue to the inventor.
- c) Having many claims, where each claim has a different scope, allows the applicant to have a legal title to different aspects of the invention. A good drafting may begin with broad claims and develops towards claims that are narrower in scope.
- d) Terms of the claim which confuse the scope of the invention, or claim that are not specific (e.g. any novel matter) should be avoided.

#### 05.03.16 | Structure of Claims

- a) The description of invention in the complete specification is to be followed by a 'statement of Claims' preceded by the prescribed preamble, 'I / We Claim' as the case may be.
- b) Claims should start from a fresh page, after detailed description of the invention and should be serially numbered.
- c) Each claim should be in a single sentence and should be clearly worded.
- d) A claim should not be verbose.
- e) There is no restriction as to the number of claims that can be incorporated in the specification. Applicant has to pay additional fee, if total number of claims are more than ten.
- f) Each claim should be fairly based on matter disclosed in the specification. This means that all the characteristics of the

- invention that form part of the Claims must be fully explained in the description.
- g) A claim should be clear in the sense that it should not cause the reader to speculate. For example, if words like 'thin', 'strong', 'a major part', 'such as', 'when required' or 'any' are used, the reader may make a subjective judgment unless such expression follows some definite value.
- h) A claim must be specific and not vague, ambiguous or hypothetical in nature. Each claim should be complete so that it covers the inventive feature and enough elements around it to put the invention in the proper context.
- i) In Addition, any term which is used in the claim, must be either found in the description or fairly inferred from the description.
- j) Trade Marks should not be used in Patent Applications where a generic term can be used instead, since a Trademark is an indication of the origin rather than the composition or content of goods, However, Trade Marks are only permitted in claims where it can be shown that their use is unavoidable and does not introduce ambiguity. Where Marks that are registered are mentioned, they should be acknowledged as such. If a Trade Mark is not registered, its owner should be indicated.
- k) A Claim usually consists of three parts:
  - Preamble,
  - Transitional phrase; and
  - Body.
- An introductory phrase identifies the category of invention and sometimes the purpose (for example, a machine for waxing paper, and a composition for fertilizing soil).
- m) The transition phrase may be words and phrases such as:
  - comprising of

- including
- consisting of
- consisting essentially of
- n) If the invention is an improvement on a product or a process existing in the prior art, the invention should be distinguished very clearly by characterizing the claim with respect to the prior art. In such cases, the claim will have two parts separated by the word 'characterized by' or 'wherein'.
- o) The first claim is always an independent claim also known as 'Principal Claim'. It should clearly define the essential novel features of the most preferred embodiment of the process/product that constitutes the invention. The claim may be properly characterized with respect to the 'prior art', defining all the technical features essential to the invention or inventive concept. The claim should bring out sufficient details of interrelationship, operation or utility to establish that the invention achieves the intended objectives.
- p) There may be more than one independent claim in a single application if the claims fall under a single inventive concept. While there is no restriction as to the number of claims, including independent claims, it is advisable to limit the number of claims, as well as the number of independent claims in a single application so that the claims are all of cognate character and are linked so as to form a single inventive concept. Inclusion of multiple independent claims directed at non- cognate aspects of the claimed invention is not desirable. If claims relate to a plurality of distinct inventions, it may be objected on ground of lack of unity of invention.
- q) Further independent claims are justified where the single inventive concept covers more than one category e.g. process, product, complementary versions within one category e.g. plug and socket, transmitter and receiver,

which work only together.

r) A dependent claim derives antecedence from an independent claim and reads into it the features of the independent claim and may contain additional non-essential features and even the minute aspects and optional features.

# For example:

- A wrapper as claimed in Claim 1, wherein a narrow area of the tear tape, spaced from each edge of the tear-tape, is united to a narrow area of the wrapper defined on each side by a line of perforations which are covered by the outer portions of the tear-tape, the perforations facilitating tearing of the wrapper to remove the portion bounded to the tear-tape.
- A gramophone record according to Claim 1, wherein the percentage of filler employed in the record is from 1 to 70 per cent.
- A tool according to Claim 1, wherein the means for guiding the tool and facilitating the removal of the waste metal and the means for preventing the distortion of the spindle comprise two separate plates slidable and removable mounted on the spindle.
- s. A claim which is unsearchable due to number of alternatives embraced or the choice of characterizing parameters should be avoided.
- t. Dependent claims that are not fully limited by the terms of the preceding independent claim, e.g. dependent claims which omit, modify or substitute a feature of an independent claim should be avoided.
- s) The practice of including an omnibus claim does not have any legal basis under the Patents Act. In fact, such a claim cannot be allowed as per Section 10(4)(c) of the Act. As such

	omnibus claims are unclear, vague and unsearchable, and	
	hence, it is desirable to avoid omnibus claims in a patent	
	application.	
05.04	Priority of a claim	Section
	Each claim of a complete specification shall have a priority date.	2(1)(w), 11
	If the complete specification is filed along with the application,	
	the date of filing of the application is the date of the priority of	
	the claim(s) of the specification if the claim(s) are fairly based	
	on the matter disclosed in the specification.	
05.04.01	Priority dates- General	Section 9, 11
	a) When a Complete Specification is filed pursuant to a Provisional Specification, the priority date thereof shall be the date of filing of the provisional application.	
	b) When a complete specification is filed based on two or more provisional specifications which are cognate, the priority dates for claims arising from each of the provisional specifications will be the date of the respective provisional specification.	
	c) When a complete specification is converted into a provisional specification and a fresh complete specification is filed thereafter, the priority date of claims shall be the date of disclosure of the relevant specification in which the claimed subject matter was first disclosed.	
	d) When a complete specification is filed after the provisional specification, the Controller may on the request of the applicant made any time before the grant, cancel the provisional specification and post-date the provisional specification to the date of complete specification.	
	e) If the Claim is fairly based on the matter disclosed partly in one and partly in another such previous application accompanying provisional specification, the priority date of	

	the claim shall be the date of the later filed Specification.	
	f) Where a complete specification based on a previously filed	
	application in India has been filed within twelve months	
	from the date of that application and the claim is fairly based	
	on the matter disclosed in the previously filed application,	
	the priority date of that claim shall be the date of the	
	previously filed application in which the matter was first	
	disclosed.	
	g) A claim in a complete specification of a patent shall not be	
	invalidated by the reason only of:	
	i. the publication or use of the invention so far as claimed	
	in that claim on or after the priority date of such claim;	
	or	
	ii. The grant of another patent which claims the invention,	
	so far as claimed in the first mentioned claim, in a claim	
	of the same or a later priority date.	
05.04.02	Divisional application	Section
	In case of a Divisional Application, priority date of the claim(s) is	11(4)
	the date of filing of the first mentioned application.	
05.04.03	Convention application	Section
	The priority date of the claim(s) of a convention application is	11(6), 135
	the date of filing of the basic application filed in the	
	convention country.	
05.04.04	Effect of Priority Date of a Claim	Section
	The novelty of a claim is dependent on its date of priority.	11(8)
	Nothing published on or after the date of priority of a claim can	
	be cited to destroy the novelty of that invention.	

**Chapter- 6: Divisional Application and Patent of Addition** 

06.01	Divisional Application	
06.01.01	General	Section 16(1)
	An applicant may, at any time before the grant of a patent, if he	
	so desires, or with a view to remedy the objection raised by the	
	Controller on the ground that claims of a complete specification	
	relate to more than one invention, may divide the application	
	and file further application(s) in respect of invention disclosed	
	in the provisional or complete specification already filed.	
	Examination of a divisional application is always done	
	vis-à-vis the first mentioned application. If two or more	
	divisional applications are filed based on a first mentioned	
	application, examination of the second or subsequent divisional	
	application(s) shall be done vis-à-vis the first mentioned	
	application, and other divisional application(s), examined	
	earlier, if any, to avoid double patenting. The whole patent	
	family, in such cases, is available to the Examiner on the official	
	database.	
	The date of filing of a divisional application shall be the same as	
	that of the first mentioned application, from which it has been	
	divided.	
	The term of patent for a divisional application shall be twenty	
	years from the date of filing of the first mentioned application	
	or international filing date in case the application was divided	
	out of National phase application under PCT.	
	No divisional application can be filed, the claims of which is/are	
	identical to claims of the parent application (first mentioned	
	application).	
06.01.02	Contents	Section
	A Divisional Application(s) shall be accompanied by a Complete	16(2), 16(3)
	Specification and shall not include any matter not in substance	

	disclosed in the first mentioned application. The first	
	mentioned application and the Divisional Application(s) may	
	be amended upon requirement/ direction of Controller to	
	ensure that neither of the complete specifications includes a	
	claim for any matter claimed in the other.	
06.01.03	Priority	Section 16,
	The divisional application is treated as a substantive	Explanation
	application and accorded the date of filing of the first	Section 11(4)
	mentioned application along with a separate application	
	number.	
	The claims of divisional application shall have the same priority	
	date as that of the first mentioned application. A divisional	
	application shall be examined vis-à-vis the first mentioned	
	application so as to avoid claim overlap resulting in double	
	patenting.	
	A divisional application is treated as a substantive application	
	in the sense that:	
	a) separate fee(s) is required to be paid;	
	b) separate request for examination requires to be made;	
	c) it can be prosecuted separately;	
	d) it results in an independent patent.	
06.01.04	Appropriate office	Rule 4
	The divisional application shall be filed at the appropriate	
	office of the first mentioned application only.	
	[Rule 24B(2) for reference to Examination]	
06.01.05	Reference	
	The Complete Specification accompanying the Divisional	Rule 13(2)
	Application shall contain a specific reference to the	
	original application from which the divisional application is	
	made.	
06.01.06	Fee	Section 16
	For all purposes under the Patents Act, the Divisional	

	Application is treated as a substantive application and, hence,	
	all fees applicable to a patent application, shall be payable.	
06.02	Patent Of Addition	
06.02.01	General	Section 54,
	a) When an applicant comes up with an improvement in or modification of the invention described or disclosed in the main application for which he has already applied for or has obtained a patent, the applicant may make an application for patent of addition.	55
	b) An application for a Patent of Addition shall be filed on the same or subsequent date of filing of the application for main Patent.	
	c) A Patent of Addition shall be granted only after the grant of the main patent.	
	d) When a patentee holds two patents, it is possible to convert one of the independent patents to a patent of addition of the other, if the subject matter was an improvement in or modification to the other patented invention.	
	e) There is no need to pay separate renewal fee for the Patent of addition during the term of the main patent.	
	<ul> <li>f) A patent of addition expires along with the main patent. However, if the main patent is revoked, the patent of addition may be converted into an independent patent, if so requested by the patentee and the renewal fee for the remaining term of the patent need to be paid accordingly.</li> <li>g) Date of filing shall be the date on which the application for</li> </ul>	
	patent of addition has been filed.	
06.02.02	Novelty and inventive step	Section 56
	An application for Patent of Addition cannot be challenged on the ground of lack of inventive step with respect to the	

	disclosure in the main application or patent. But the disclosure in main application or patent may be cited for novelty against the application for patent of addition.  In the matter of <b>Ravi Kamal Bali v/s Kala Tech</b> and others the <b>Bombay High Court on 12</b> th <b>February, 2008</b> dismissed the defendant's arguments that Patent of addition can only be	
	granted if it has an inventive step over the main application.	
06.02.03	Reference	Dula 12(2)
00.02.03	Reference	Rule 13(3)
00.02.03	The complete specification of application for patent of addition	Rule 13(3)
00.02.03	The complete specification of application for patent of addition shall include specific reference to the number of main patent or	Kule 13(3)
00.02.03	The complete specification of application for patent of addition shall include specific reference to the number of main patent or the application for main patent, as the case may be, and a	Kule 13(3)
00.02.03	The complete specification of application for patent of addition shall include specific reference to the number of main patent or the application for main patent, as the case may be, and a definite statement that the invention comprises an	Kule 13(3)
00.02.03	The complete specification of application for patent of addition shall include specific reference to the number of main patent or the application for main patent, as the case may be, and a	Kule 13(3)

# Chapter -7: Convention Application, International Application and National Phase Application

	Paris Convention and WTO Agreement  1. Paris Convention of 1883 provides reciprocity in filing with	Section 133
	<ul> <li>the right of priority. India became member of the Paris Convention in 1998.</li> <li>2. India became a member of WTO Agreement in 1995 and member of Patent Co-operation Treaty in 1998.</li> <li>3. India is a member of Budapest Treaty (2001) on the International recognition of the deposit of micro-organism for the purpose of patent procedure (1977) and provides a</li> </ul>	
	mechanism for depositing biological material in the internationally recognized depository authorities for the purposes of supplementing the description of a Specification.	
07.01.02	Any country which is a signatory or party, or a group of countries, union of countries or inter-governmental organizations which are signatories or parties to an international, regional or bi-lateral treaty, convention or arrangement to which India is also a signatory or party, and which affords to the applicants for patents in India or to citizens of India similar privileges as are granted to their own citizens or citizens to their member countries in respect of the grant of patents and protection of patent rights, shall be a convention country or convention countries for the purposes of this Act.  At present, India is a member of WTO and a member country in the Paris Convention and a contracting state to the PCT. Any	Section 2(1)(d), 133, 134

	organizations, which are members/contracting states to the	
	above convention/ treaty/ agreement, are convention	
	countries for the purposes of the Act.	
07.01.03	Convention Application	Section
	a) Where a person has made an application for Patent in	135
	respect of an invention in a Convention country (basic	
	application), and that person or the legal representative or	
	assignee of that person makes an application under this Act	
	for a patent within twelve months after the date on which	
	the basic application was made, the priority date of a	
	claim of the complete specification, being a claim based on	
	matter disclosed in the basic application, is the date of	
	making of the basic application.	
	b) Where applications have been made for similar protection in	
	respect of an invention in two or more convention countries,	
	the period of twelve months referred to in this sub-section	
	shall be reckoned from the date on which the earlier or	
	earliest of the said applications was made.	
	c) Where applications for protection have been made in one	
	or more convention countries in respect of two or more	
	inventions which are cognate or of which one is a	
	modification of another, a single convention application may	
	be made in respect of those inventions at any time within	
	twelve months from the date of the earliest of the said	
	applications for protection. However, the fee payable in	
	respect of such application shall be the same as if separate	
	applications have been made in respect of each of the said	
	inventions.	
07.01.04	Documents to be submitted	Section
	Every convention application shall:	136, 138.
	a) be accompanied by a complete specification;	Rule 121

	b) an abstract;	
	c) specify the date on which and the convention country in which, the application for protection, or as the case may be, the first of such applications was made; and	
	d) state that no application for protection in respect of the invention had been made in a convention country before that date by the applicant or by any person from whom he derives title.	
	e) include claims in respect of developments or, additions to, the invention in respect of which the application for protection was made in a Convention country.	
	f) If the Controller requires, a certified copy of the priority document has to be filed within 3 months from the date of communication by the Controller, of such requirement. If the priority document is in a language other than English, a verified English translation shall be submitted.	
07.01.05	Multiple priorities	_
07.01.03	Multiple priorities	Section
07.01.03	a) When two or more applications for patents constituting one invention have been made in one or more convention countries, one application may be made within twelve months from the date on which the earlier or earliest of those applications was made.	Section 135(2), 137
07.01.03	a) When two or more applications for patents constituting one invention have been made in one or more convention countries, one application may be made within twelve months from the date on which the earlier or earliest of	
07.01.06	<ul> <li>a) When two or more applications for patents constituting one invention have been made in one or more convention countries, one application may be made within twelve months from the date on which the earlier or earliest of those applications was made.</li> <li>b) The priority date of a claim is the date on which the matter</li> </ul>	
	<ul> <li>a) When two or more applications for patents constituting one invention have been made in one or more convention countries, one application may be made within twelve months from the date on which the earlier or earliest of those applications was made.</li> <li>b) The priority date of a claim is the date on which the matter was first disclosed in a patent application.</li> </ul>	135(2), 137

	c) A Convention Application shall not be post-dated under sub-			
	section (1) of section 17 to a date later than the date on			
	which the application could have been made under the			
	provisions of this Act.			
07.02	International Application under PCT			
07.02.01	PCT International application by Indian applicant	Section 39,		
	An Indian applicant can file a PCT International application	118, Rule 4		
	in the following manner:			
	i. If the international application is filed before 6 weeks			
	from the date of the priority in India, the foreign filling			
	permission under section 39 has to be procured from			
	the appropriate patent office.			
	ii. If the international application is filed directly at RO/IB			
	or RO/IN, foreign filling permission under section 39			
	has to be procured from the appropriate patent office.			
	If the applicant fails to procure the foreign filling permission			
	under section 39, the application will not be considered as			
	international application.			
	If any person fails to comply with any direction given under			
	section 35 or makes or causes to be made an application for the			
	grant of a patent in contravention of section 39, he shall be			
	punishable with imprisonment for a' term which may extend to			
	two years, or with fine, or with both.			
07.02.02	Indian Patent Office as Receiving Office and requirements:	Section		
	1. Online filing:	2(1)(ia),		
	An International patent application can be filed in Indian			
	Patent Office as a Receiving Office, in request form (PCT/RO/	7(1A), 39		
	101), through the e-PCT module of WIPO (https://pct.wipo.int)			
	along with application body, declaration, POA (In case of	PCT/RO/10		
	agents), MSME Certificate in case of small entity OR DIPP	1		
	certificate in case of startup for claiming fee reduction in			

transmittal and priority fees.

# 2. Offline filing:

- a) An International patent application can be filed in Indian Patent Office as a Receiving Office, in request form (PCT / RO / 101), which can be downloaded from the WIPO website, and has to be submitted in triplicates along with application body, declaration, POA (Incase of agents), MSME Certificate in case of small entity OR DIPP certificate in case of start up for claiming fee reduction in transmittal and priority fees. Foreign filing permission should be submitted as per requirement.
- a) 90% Fee reduction, in case of International filing fees, for natural persons can be availed only if the nationality and residence of the applicant is India.
- b) In case the search authority is ISA/US, the applicant has to submit the following documents.
- Micro entity certificate in form 15A of USPTO for claiming micro entity fee reduction.
- Small entity assertion/declaration for claiming small entity fee reduction.
- ➤ In USA, Universities are automatically considered as small entity and hence applicant can avail search fee reduction by mentioning the same in RO/101.

## **International Bureau as Receiving Office**

An international patent application can be directly filed in IB along with the prescribed fee, in request form (PCT / RO / 101), in duplicate. Permission u/s 39 is required for filing directly in IB. Such an application may also be filed electronically.

07.02.03	Functions of Indian Patent Office as Receiving Office	Section 35,	
	Receiving office (RO) -Receives the International		
	Application (IA) and does the following verifications:		
	✓ Formality Check :Nationality/Residence	16 of PCT.	
	✓ At least one of the applicants must have the right to file	PCT	
	with the RO	Receiving	
	✓ The application must be in a language accepted by the	Office	
	RO (English/Hindi)	Guidelines	
	✓ If formality criteria not satisfied, IA is referred to IB for		
	further processing.		
	✓ Accords or refuses international filing date(Article		
	11(1))		
	Checks the technical elements of International application.		
	The application must contain at least:		
	✓ An indication that it is intended as an international		
	application		
	✓ A request which has the effect of making all possible		
	designations (Article 4 and Rules 3 and 4.9)		
	✓ The name of the applicant (Rule 4.5)		
	✓ A description (Rule 5)		
	✓ A claim (Rule 6)		
	Decides on requests for incorporation by reference of		
	missing elements or parts (Rules 20.5 to 20.7)		
	Checks whether translation of international application is  required (Dyles 12.2 and 12.4).		
	required (Rules 12.3 and 12.4)		
	Checks if the required fees (RO/IB /ISA) are timely paid		
	(Rule14,15, 16bis)		
	Checks priority claim(s) (Rules 4.10 and 26bis)		
	Decides on requests for restoration of the priority right		
	(Rule 26bis.3)		

- Specifies the International Searching Authority
- Specifies the International Preliminary Examining
  Authority
- Checks for national security clearance/FFL (as per section 39 of Patent Act 1970)
- Forwards the record copy to IB and the search copy to ISA, including any required translation (Article 12 and Rules 22.1 and 23.1)
- Forwards and receives correspondence from applicants and the international authorities
- Establishes priority documents of PCT applications filed with it (Rule 21.2)
- COMPETENT INTERNATIONAL SEARCHING AUTHORITIES (ISAs) (Article 16, Rule 35)
  - ✓ INDIAN PATENT OFFICE (IN)
  - ✓ AUSTRIAN PATENT OFFICE (AT)
  - ✓ AUSTRALIAN PATENT OFFICE(AU)
  - ✓ EUROPEAN PATENT OFFICE (EP)
  - ✓ CHINESE INTELLECTUAL PROPERTY OFFICE (CN)
  - ✓ UNITED STATES PATENT & TRADEMARK OFFICE(US)
  - ✓ SWEDISH PATENT OFFICE (SE)

Updated Information is available on WIPO Website (www.wipo.int)

- Fees payable to the receiving Office (RO)
  - transmittal fee
  - > international filing fee (for IB)
  - > search fee (for ISA)
  - > supplement per sheet in excess of 30 (for IB)
  - fee for priority document (Now can be paid through WIPO DAS)

	late payment fee			
	late furnishing fee (to			
	application)			
	> fee for copies of documents			
	(Fees indicated in italics are to be paid only as per			
	instructions from RO			
	• Intimation of Fee payment :RO /102			
	After request is filed	, the Fees	to be paid towards	
	International filing, search , priority and transmittal			
	fees are calculated by RO.			
	Demand letter (PCT/RO/102) issued			
	Demand letter (PCT/RO/102) with the INR			
	equivalent towards calculation of IB fee and a mode of			
	payment letter is dispatched to applicant			
	(hardcopy/email) oi	n the same	e day by RO.	
07.02.04	PCT Fee (may vary from time to time)			Rule 16bis
	1. All PCT fees are subject to change periodically. For			of
	latest fees, please refe			
	www.wipo.int.			Regulat
	International Filing Fee		USD 1,366 **	ions
	Search Fees			under
	(AT)		USD 2,202***	the
	(AU) USD 1,631			PCT
	(CN) USD 309			
	(EP) USD 2095***			
	(SE)		USD 2095***	
			USD 2095*** USD 2080	
	(SE)			
	(SE)		USD 2080	

(IN) INR USD 153 10000 USD 38* INR 2500*	
INR	
2500*	
<ul> <li>The applicant can make payment towards IB fee and (except ISA/IN) fees directly through NEFT /RTGS submit the UTR /Ref no: via email to RO/IN</li> <li>RO prepares debit instructions to the bank and transmits</li> </ul>	and s the
payment subsequently to IB and ISA and also intimate	the
same through e mail to all International authorities.	
07.02.05 International Search	Article 15,
International Searching Authority designated by applicant in International Application. The Internation	onal 17, 18, 19 on of
<ol> <li>If the International Application did not claim priority of previously filed Indian Patent Application, International search report is normally made available within nine months from the International filing date priority is claimed, that report is made available usually the 16th month from the priority date. Even where prioris claimed, the International search report is norm made available before publication of the International Application. This allows time for the applicant to withdow the Application before publication, if desired.</li> <li>On receipt of the International Search Report applicant may amend the Claims (under Article 19) in light of the International Search Report with effect in</li> </ol>	the PCT.  able e. If y by ority hally onal raw  the ight

two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority, or 16 months from the priority date, whichever time limit expires later. However, any amendment made under Article 19 which is received by the International Bureau after the expiration of the applicable time limit is considered to have been received by the Bureau on the last day of the time limit if it reaches before the technical preparations for international publication have been completed. 4. Such amendments save costs for preparation of different sets of amendments and for local Agents filing such amendments before Designated Offices. 5. Indian Patent Office has been recognized as an International Searching Authority (ISA) and an International Preliminary Examining Authority (IPEA) at the meeting of the General Assemblies of WIPO held in September – October, 2007. 6. The Indian Patent Office started functioning as an Searching (ISA) International Authority International Preliminary Examining Authority (IPEA) from October 2013. 07.02.06 Withdrawals in International Application Withdrawal of Application Article 8(1), 1. The applicant may withdraw the international application at any time prior to the expiration of 30 months from the priority date. 20(1), 2. Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the 21(2)(a), International Bureau, to the Receiving Office or, where Article 39(1) applies, to the International Preliminary

Examining Authority.

3. No international publication of the international application shall be effected if the notice of withdrawal sent by the applicant or transmitted by the Receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for international publication have been completed.

23(2),

39(1),

40(2) of PCT.

Rule

4.15(b),

45bis.8,

53.8(b),

90*bis*,

90.2(b)

of Regulat ions under

the PCT.

# Withdrawal of Designations

- 1. The applicant may withdraw the designation of any designated State at any time prior to the expiration of 30 months from the priority date. Withdrawal of the designation of a State which has been elected shall entail withdrawal of the corresponding election under Rule 90bis.4.
- 2. Where a State has been designated for the purpose of obtaining both, a national patent and a regional patent, withdrawal of the designation of that State shall be taken to mean withdrawal of only the designation for the purpose of obtaining a national patent, except where otherwise indicated.
- 3. Withdrawal of the designations of all designated States shall be treated as withdrawal of the international application under Rule 90bis.1.
- 4. Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the Receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.
- 5. No international publication of the designation shall be effected if the notice of withdrawal sent by the applicant or transmitted by the Receiving Office or the International Preliminary Examining Authority reaches the International

Bureau before the technical preparations for international publication have been completed.

## **Withdrawal of Priority Claims**

- 1. The applicant may withdraw a priority claim, made in the international application under Article 8(1), at any time prior to the expiration of 30 months from the priority date.
- 2. Where the international application contains more than one priority claim, the applicant may exercise the right provided for in paragraph (a) of PCT Rule 90bis3 in respect of one or more of the priority claims.
- 3. Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the Receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.
- 4. Where the withdrawal of a priority claim causes a change in the priority date, any time limit which is computed from the original priority date and which has not already expired shall, subject to paragraph (e) of PCT Rule 90*bis*3, be computed from the priority date resulting from that change.
- 5. In the case of the time limit referred to in Article 21(2)(a), the International Bureau may nevertheless proceed with the international publication on the basis of the said time limit as computed from the original priority date if the notice of withdrawal sent by the applicant or transmitted by the Receiving Office or the International Preliminary Examining Authority reaches the International Bureau after the completion of the technical preparations for international publication.

## Withdrawal of Supplementary Search Request

1. The applicant may withdraw a supplementary search

- request at any time prior to the date of transmittal to the applicant and to the International Bureau, under Rule 45bis.8(a), of the Supplementary International Search Report or the declaration that no such report will be established.
- 2. Withdrawal shall be effective on receipt, within the time limit under paragraph (a) of PCT Rule 90*bis*.3*bis*, of a notice addressed by the applicant, at his option, to the Authority specified for supplementary search or to the International Bureau, provided that, where the notice does not reach the Authority specified for supplementary search in sufficient time to prevent the transmittal of the report or declaration referred to in paragraph (a) of PCT Rule 90*bis*.3*bis*, the communication of that report or declaration under Article 20(1), as applicable by virtue of Rule 45bis.8(b), shall nevertheless be effected.

#### Withdrawal of the Demand, or of Elections

- 1. The applicant may withdraw the demand or any or all elections at any time prior to the expiration of 30 months from the priority date.
- 2. Withdrawal shall be effective upon receipt of a notice addressed by the applicant to the International Bureau.
- 3. If the notice of withdrawal is submitted by the applicant to the International Preliminary Examining Authority, that Authority shall mark the date of receipt on the notice and transmit it promptly to the International Bureau. The notice shall be considered to have been submitted to the International Bureau on the date marked.

# **Signature**

1. Any notice of withdrawal referred to in Rules 90*bis*.1 to 90bis.4 shall, subject to paragraph (b) of PCT Rule 90bis.5, be signed by the applicant or, if there are two or more

- applicants, by all of them. An applicant who is considered to be the common representative under Rule 90.2(b) shall, subject to paragraph (b), will not be entitled to sign such a notice on behalf of the other applicants.
- 2. Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 need not be signed by that applicant (the applicant concerned) if it is signed by at least one applicant and
  - i. a statement is furnished explaining, to the satisfaction of the Receiving Office, the International Bureau, the Authority carrying out the supplementary international search or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned, or
  - ii. in the case of a notice of withdrawal referred to in Rule 90*bis*.1(b), 90*bis*.2(d), 90*bis*.3(c) or 90*bis*.3*bis*(b), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or
  - iii. in the case of a notice of withdrawal referred to in Rule 90*bis*.4(b), the applicant concerned did not sign the demand but the requirements of Rule 53.8(b) were complied with.

### **Effect of Withdrawal**

1. Withdrawal under Rule 90bis of the international application, any designation, any priority claim, the demand or any election shall have no effect in any designated or elected Office where the processing or examination of the international application has already started under

Article 2	23(2) or Article 40(2).	
2. Where Rule internat 3. Where a	the international application is withdrawn under 90bis.1, the international processing of the tional application shall be discontinued.  a supplementary search request is withdrawn under 0bis.3bis, the supplementary international search by	
4. Where Rule 90	the demand or all elections are withdrawn under obis.4, the processing of the international application International Preliminary Examining Authority shall ontinued.	
07.02.07 Internation	nal Preliminary Examination	
ways. It to the I usual cr for the Agents of 2. Helps the	tional Preliminary Examination is useful in many is optional for the applicant and provides, in addition international Search Report, a second opinion on the riteria of patentability before expenses are incurred national phase (for translation, fees and foreign etc.).  The applicant to adapt the International Application in time with the results of the International Search	Article 33, 34, 35, 17(2)
the App non-bin Internation For an I Internation Preliminary	eport is negative, the applicant may decide to abandon olication. However, the opinions from ISA & IPEA are adding on the member countries.  In al Preliminary Examining Authorities  Indian Applicant, the following are competent	

- 2. Australian Patent Office (AU)
- 3. European Patent Office (EP) (Only if ISA was AT, EP or SE)
- 4. China Intellectual Property Office (CN)
- 5. United States Patent & Trademark Office (US)
- 6. Swedish Patent Office (SE)
- 7. Indian Patent Office (IN)

Updated Information is available on WIPO Website (www.wipo.int)

# **Demand for International Preliminary Examination**

- 1. The demand for international preliminary examination shall be made separately from the international application.
- 2. The demand for international preliminary examination may be made to the Indian Patent Office, International Bureau or to any of the six competent International Preliminary Examining Authorities mentioned above.
- 3. The demand shall contain the prescribed particulars and shall be in the prescribed language and form. The demand shall be subject to the payment of the prescribed fees within the prescribed time limit.
- 4. The demand for International Preliminary Examination has to be made:
  - a. Within 22 months from the date of priority, or
  - b. Within 3 months from the date of transmittal of International Search Report and written opinion to the applicant or the declaration under Article 17(2), whichever is later.

The fees to be paid by the applicant is given in the PCT Newsletter which is available on the WIPO website, www.wipo.int.

07.03	PCT National Phase Application	
07.03.01	General	Article 22,
07.03.01	<ol> <li>The national phase follows the international phase. It is necessary for an applicant to file a national phase application in each designated country, where protection is sought, within the time prescribed under PCT, i.e., within 30 months from the priority date. However, this time limit may be increased through National Laws by each member Country. Indian Patent Law provides a time limit of 31 months from the priority date. Some countries allow extension of such time limit on payment of additional fee.</li> <li>For making a national phase application before a Designated Office, the applicant shall:         <ol> <li>a. pay the prescribed national fee; and</li> <li>b. file a duly verified translation of the basic application, if necessary.</li> </ol> </li> <li>International filing date is the deemed date of filing in India if the applicant enters the national phase in India by filing a National Phase Application within thirty one months from the date of priority.</li> <li>The international filing allows the preservation of priority from the date of filing of first application in the convention</li> </ol>	23 of PCT Rule 20 of The Patent Rules, 2003
07.03.02	country.  Basic Requirements to enter National Phase in India	Rulo 11
07.03.02	<ol> <li>The applicant has to file the National Phase Application within 31 months from the priority date or International Application date, whichever is earlier. The application with respect to the National Phase Application may be made in Form -1.</li> <li>The jurisdiction of filing is the same as that of the ordinary Application. Address for service in India shall be filed.</li> </ol>	Rule 14, 20, 21

- 3. Where the International Application has not been filed or published in one of the official languages (Hindi or English), a translation of the application, description, claims (if amended, both as originally filed and amended together with any statement), drawings, if any, and abstract should be submitted along with the Application.
- 4. For the National Phase Application, the title, description, drawings, abstract and claims as filed with the International Application under PCT shall be taken as the Complete Specification. However, If the applicant has amended the Complete Specification under Chapter-I and/or Chapter-II of the PCT, such amended specification shall be taken as the Complete Specification for the purpose of filing in India
- 5. The applicant may make a request to the Controller for amendment of the complete specification which was filed with the National Phase Application, as a separate request in Form-13, along with the application. The fee payable in respect of a National Phase Application is calculated as per the number of pages and claims as they stand in the PCT Application on the date of filing in India.
- 6. If the applicant makes an amendment for an International Application before ISA and/or IPEA, it shall, if the applicant so desires, be taken as an amendment before the Patent Office, prior to entry in national phase.
- 7. However, at the time of filing the national Phase application corresponding to International application designating India, the applicant may delete a claim in accordance with the provisions contained in Rule 14,
- 8. In case of a change in applicant, if the change has occurred after the international filing date and has not been

reflected in a notification from the International Bureau (Form PCT/IB/306), the change may be effected by filing Form 6 and/or Form 13, as the case may be.9. If PCT/IB/304 is available on the website of WIPO, the Patent Office shall not require the applicant to submit the priority document. If not available on the website of WIPO, the Office may request for the same from the applicant . If the applicant filed a priority document through WIPO-DAS in such case, the applicant shall provide the code for accessing the priority document.

- 10. However, if the applicant has not complied with the requirements of rule 17.1 paragraph [a or b] of the regulations made under the PCT, he shall submit the priority document to the office before the expiry of thirty one months from the date of priority.
- 11. Where the applicant does not comply with the requirements of (10) above, the Controller shall invite the applicant to file the priority document or the translation thereof within three months from the date of such invitation. If the applicant fails to do so, the claim of the applicant for the priority shall be disregarded for the purposes of the Act.
- 12. All other formalities that are required for filing and processing an ordinary patent application shall apply to a National Phase Application.13. Processing of a national phase Application will not commence before the expiry of 31 months from the date of priority. However, the applicant may file an express request for processing before 31 months, in Form 18 under Rule 20 (4)(ii).
- 14. If the applicant for national phase application is willing for expedited examination under Rule 24 C (1) before the expiry of 31 months from the date of priority, he may do so

after filing express request under Rule 20 (4)(ii).15.

International Application filed under the PCT designating
India is considered as a Convention Application under
Section 135 for which the filing date is the date of
International Application.

# Chapter - 8: Indian International Searching Authority and Indian International Preliminary Examination Authority

# 08.01 India as ISA/IPEA The Patent Cooperation Treaty, the international patent filing system, administered by the World Intellectual Property Organization (WIPO) provides the applicants from member countries, a facility for filing single international application for grant of patent in 152 countries of the world. It also has the additional benefits of obtaining International Search Report International Preliminary Examination Report (IPER) before entering the national phase in each individual country. The ISR and IPER are established according to high internationally regulated standards, by one of the Patent Offices of the world that are highly experienced in examining patent applications and that have been specially appointed by WIPO to carry out international search and examination. The Indian Patent Office was recognized as an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) under the PCT and, accordingly, started functioning from 15th October 2013 as ISA and IPEA. As per requirement for ISA/IPEA IPO has access to the

started functioning from 15th October 2013 as ISA and IPEA. As per requirement for ISA/IPEA IPO has access to the comprehensive collection of patent and non-patent literature to fulfill PCT minimum documentation requirement, integrated Search platform IPATS to enable one click search through the vast collection of information and professionally qualified and skilled Examiners. IPO) has also established a Quality Management System to monitor the ISA/IPEA . Fully electronic processing system ensures speedy disposal and dissemination of information on real time basis.

## 08.02 | Applicants in ISA/IPEA

The applicants of PCT International Applications who are

	nationals/residents of India and Iran can select the Indian	
	Patent Office as ISA/IPEA. The type of Indian applicants	
	choosing IPO as ISA/IPEA include individual inventors, Start	
	ups, premier research institutions, universities, Indian multi-	
	national conglomerates, Indian units of foreign multi-national	
	firms and foreign firms with Indian inventors or Indian	
	companies as co-applicants.	
08.03	Indian International Searching Authority	Rule 19A
	1) The Patent Office, Delhi performs the functions of the Indian International Searching Authority under the treaty in accordance with an agreement between the Indian Patent Office and the International Bureau.	
	2) The fees payable to the Searching Authority includes the fees as specified in the Fifth Schedule, in addition to the fees specified in the regulations made under the Treaty.	
	3) The Searching Authority establishes international search report in respect of international applications, or, as the case may be, declares in accordance with sub-rule (3) of rule 19B that meaningful search cannot be established, in cases where India has been indicated as a competent International Searching Authority.	
08.04	International search report	Rule 19B
	1) The Searching Authority, on receipt of the search copy, notifies the International Bureau and the applicant about receipt of search copy with identification mark 'ISA/IN' along with international application number and its serial number and date of receipt of the search copy.	
	2) Notwithstanding anything contained in the proviso to item (i) of sub-rule (2) of rule 24B, the Searching Authority shall, upon receipt of the search copy, refer the international application, in the order in which the search copy was	

received, to an examiner or any other officer appointed under sub-section (2) of Section 73 of the Act for preparing an international search report, in accordance with the provisions contained in the Treaty and the regulations under the Treaty, ordinarily within a period of one month but not exceeding two months from the date of such reference.

- 3) If the Searching Authority considers that, in accordance with rule 19(3) -
  - the international application relates to a subject matter which the Searching Authority is not required to search and, accordingly, decides not to search; or the description, claims or drawings fail to comply with the requirements prescribed under the regulation under the Treaty to such an extent that a meaningful search could not be carried out,
  - then the Authority declares and notifies the applicant and the International Bureau that no international search report has been established.
- 4) In a case where any situation referred to in clause (a) or clause (b) of rule 19 (3) is found to exist in connection with certain claims only, the Searching Authority indicates this fact in the International Search Report in respect of such claims, and for other claims, it establishes the International Search Report.
- 5) If the Searching Authority considers that the international application does not comply with the requirement of unity of invention, in accordance with the provisions contained in Rule 13 of the regulations under the Treaty, then it sends a notice specifying the reasons for which the international application is not considered as complying with the requirement of unity of invention. Subsequently, the applicant is invited to:

- a) pay the additional fees specified in the Fifth Schedule, indicating the amount of fees to be paid, within a period of one month from the date of such invitation; and
- b) pay, where applicable, the protest fee specified in the Fifth Schedule, indicating the amount of fee to be paid, within a period of one month from the date of such invitation.
- 6) The Searching Authority establishes the International Search Report on those parts of the international application which relate to the invention first mentioned in the claims ("main invention") and subject to payment of additional fee within the period specified in sub-rule (5), on those parts of the international application which relate to inventions in respect of which such additional fees were paid.
- 7) Any applicant may pay the additional fees under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fees is excessive.
- 8) The examination of the protest referred to in sub-rule (7) is carried out by a Review Committee constituted by the Controller.
- 9) The Review Committee constituted under sub-rule (8) examines the extent to which the protest is justified and, accordingly, orders for the total or partial reimbursement of the additional fee to the applicant.
- 10) Where the applicant has not paid the fees for the protest in accordance with clause (b) of sub-rule (5), the protest is considered not to have been made and the same is declared by the Searching Authority.
- 11) The protest fee is refunded to the applicant where the

	Review Committee referred to in sub-rule (8) finds that the	
	protest was entirely justified.	
	12)Where the international application contains the disclosure	
	of one or more nucleotide or amino acid sequences and the	
	sequences are not furnished in computer-readable text	
	format, the Searching Authority sends a notice to the	
	applicant to submit the sequence listing in computer-	
	readable text format and pay the late furnishing fee specified	
	in the Fifth Schedule, within a period of one month from the	
	date of such notice and if the applicant fails to comply with	
	the notice, the Searching Authority searches the	
	international application to the extent that a meaningful	
	search can be carried out without the sequence listing.	
08.05	Time limit for establishing international search report	Rule 19C
	The Searching Authority establishes the International Search	
	Report and written opinion or, as the case may be, the	
	declaration referred to in sub-rule (3) of rule 19B within a	
	period of three months from the date of receipt of the search	
	copy by the Searching Authority, or within a period of nine	
	months from the date of priority, whichever expires later.	
08.06	Transmittal of International Search Report and written	Rule 19D
	opinion	
	The Searching Authority transmits one copy of the International	
	Search Report or of the declaration referred to in Article	
	17(2)(a) of the Treaty, and one copy of the written opinion	
	established under Rule 43bis.1 of the regulations under the	
	Treaty, to the International Bureau and one copy to the	
	applicant, on the same day.	
08.07	Confidential treatment	Rule 19E
	All matters pertaining to international applications are kept	
	confidential in accordance with the treaty and the regulations	
	under the Treaty.	

<ol> <li>The Patent Office, Delhi branch performs the functions of the International Preliminary Examining Authority under the Treaty in accordance with an agreement between the Indian Patent Office and the International Bureau.</li> <li>The Examining Authority establishes-         <ul> <li>the International Preliminary Examination Report in respect of all international applications electing India as an International Preliminary Examining Authority;</li> <li>the International Preliminary Examination Report in</li> </ul> </li> </ol>
Treaty in accordance with an agreement between the Indian Patent Office and the International Bureau.  2) The Examining Authority establishes- a) the International Preliminary Examination Report in respect of all international applications electing India as an International Preliminary Examining Authority;
Patent Office and the International Bureau.  2) The Examining Authority establishes- a) the International Preliminary Examination Report in respect of all international applications electing India as an International Preliminary Examining Authority;
2) The Examining Authority establishes-  a) the International Preliminary Examination Report in respect of all international applications electing India as an International Preliminary Examining Authority;
a) the International Preliminary Examination Report in respect of all international applications electing India as an International Preliminary Examining Authority;
respect of all international applications electing India as an International Preliminary Examining Authority;
as an International Preliminary Examining Authority;
b) the International Preliminary Examination Report in
respect of the demands filed by the nationals or
residents of other countries in accordance with an
agreement between Indian Patent Office and the
International Bureau, upon being notified by the
International Bureau;
c) the International Preliminary Examination in respect of
demands made by the nationals or residents of other
countries not party to the Treaty or not bound by
Chapter II of the Treaty, if the Assembly has so
approved.
08.09 Period for making a demand Rule 190
1) The demand for international preliminary examination is
made within the period specified in the Treaty or
regulations under the Treaty.
2) In case the demand is made after the expiry of the period
specified in sub-rule (1), it is considered to have not been
made and no International Preliminary Examination Report
is prepared.
08.10   Fees payable to Examining Authority   Rule 191
The fees payable to the Examining Authority includes the fees
specified in the Fifth Schedule, in addition to the fees specified
in the regulations under the Treaty.

08.11	Manner of making a demand	Rule 19I
	A demand shall be made in accordance with the provisions	
	contained in the rules, the Treaty and the regulations under the	
	Treaty.	
08.12	Processing of demands for international preliminary	Rule 19J
	examination	
	1) The Examining Authority, on receipt of the demand for international preliminary examination, if the Examining	
	Authority is competent to conduct an international	
	preliminary examination, assigns the identification mark	
	'IPEA/IN' and notifies the Applicant and the International	
	Bureau.	
	2) In case where the Examining Authority is not competent to	
	conduct the international preliminary examination of the	
	international application, it transmits the demand promptly	
	to the International Bureau.	
08.13	International Preliminary Examination Report	Rule 19K
	1) Notwithstanding anything contained in the proviso to item	
	(i) of sub-rule (2) of rule 24B, the Examining Authority	
	refers the international application, in accordance with the	
	provisions contained in the Treaty and the regulations under	
	the Treaty, in the order in which the demand was received in	
	the Examining Authority to an examiner or any other officer	
	appointed under sub-section (2) of section 73 of the Act for	
	preparing an International Preliminary Examination Report	
	ordinarily within a period of three months but not exceeding	
	four months from the date of such reference.	
	2) Claims relating to inventions in respect of which no	
	International Search Report has been established shall not	
	be the subject of international preliminary examination.	
	3) If the Examining Authority considers that-	

- a) the international application relates to a subject matter on which the Examining Authority is not required to carry out an international preliminary examination, and, decides not to carry out such examination; or
- b) that the description, the claims, or the drawings, are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the questions of novelty, inventive step (non-obviousness), or industrial applicability,

then, the Examining Authority does not go into these questions and informs the applicant of this opinion and the reasons therefor.

- 4) In a case where any situation referred to in clause (a) or clause (b) of sub-rule (3) is found to exist in connection with certain claims only, the Examining Authority indicates this fact in the International Preliminary Examination Report in respect of such claims, and for other claims, it establishes the International Preliminary Examination Report.
- 5) Where the Examining Authority finds that the international application does not comply with the requirement of unity of invention, in accordance with the provisions contained in Rule 13 of the regulations under the Treaty and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees. it issues a notice to the applicant:
  - a) specifying at least one possibility of restriction which.
     in the opinion of the Examining Authority. would be
     in compliance with the applicable requirement;
  - specifying the reasons for which the international application is not considered as complying with the requirement of unity of invention;

- c) inviting the applicant to comply with the invitation within one month from the date of such notice;
- d) indicating the amount of the required additional fees to be paid in case the applicant so chooses; and
- e) inviting the applicant to pay, the protest fee within one month from the date of such notice, and indicate the amount to be paid, as specified in the Fifth Schedule.
- 6) Any applicant may pay the additional fees under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fees is excessive.
- 7) The examination of the protest is carried out by a Review Committee constituted by the Controller.
- 8) The Review Committee constituted examines the extent to which the protest is justified and accordingly orders for the total or partial reimbursement to the applicant of the additional fee.
- 9) The protest fee is refunded to the applicant where the Review Committee referred to in sub-rule (6) finds that the protest was entirely justified.

# 08.14 Period for establishing international preliminary examination report and its transmission

Rule 19L

The period for establishing the International Preliminary Examination Report shall be:

- a) twenty eight months from the priority date; or
- b) six months from the period specified under Rule 69.1 of the regulations under the Treaty for the start of the international preliminary examination; or

	c) six months from the date of receipt by the Examining Authority of the translation furnished under Rule 55.2 of the regulations under the Treaty, whichever expires last.	
08.15	Transmittal of International Preliminary Examination	Rule 19M
	Report	
	The Examining Authority transmits one copy of International	
	Preliminary Examination Report and its annexures, if any, to the	
	International Bureau, and one copy to the applicant, on the	
	same day.	
08.16	Conditions for and extent of refund	Rule 19N
	The fee paid by the applicant may be refunded, waived or	
	reduced to the extent and in accordance with the conditions	
	specified in the Treaty or the regulations under the Treaty and	
	the agreement entered between the Indian Patent Office and the	
	International Bureau.	

## Chapter- 9: Examination & Grant

## 09.01 **Request for Examination** Section 11B, 35. An Application for a Patent shall not be examined unless the applicant or any other person interested makes a Rule 24B, request for examination. The request is to be filed in Form 24C. 18 or Form 18A (as the case may be) along with the fee as prescribed in First Schedule. 2) A request for examination has to be made within fortyeight months from the date of priority of the application or from the date of filing of the application, whichever is earlier. If no such request for examination is filed within the prescribed time limit, the application shall be treated as withdrawn by the applicant. 3) In a case where secrecy direction has been issued under Section 35, the request for examination may be made within six months from the date of revocation of the secrecy direction, or within forty-eight months from the date of filing or priority, whichever is later. 4) The Office will not examine an application unless it is published and a request for examination is filed. 5) When a request for examination is filed by a person interested other than the applicant, the Examination Report is sent to the applicant only, and intimation is given to the person interested. In the matter of Nippon Steel Corporation vs. Union of India (UOI) W.P. **(C)** 801 Of 2011 (08.02.2011): Manu/De/07/12/2011, the Delhi High Court held that once application is deemed to have been withdrawn by applicant in terms of Section 11B(4) of Act, Controller of Patents cannot entertain application for amending any portion of such application - It is not possible to accept submission of petitioner

that Controller of Patents is bound to allow amendment at any time, even after deemed withdrawal of such application. The Court also noted that the Petitioner missed the deadline for filing Request for examination accordingly.

In the matter of **Sphaera Pharma, Pte. Ltd And Anr. vs Union Of India And Anr. on 16 February, 2018** the Delhi High Court held that any request for extension of time prescribed has to be made before the expiry of such time as prescribed in the Rules. Therefore, even if the express language of Rule 138 of the Rules is ignored, the benefit of Rule 138 would not be available to the petitioner (who requested for extension of time under Rule 138 to file are request for examination in Form 18), as no such application for extension of time was made prior to expiry of the prescribed time.

#### 09.01.02 Expedited examination of applications

- Rule 24B, 24C, First Schedule
- 1) An applicant may file a request for expedited examination in Form 18A, along with the fee, only by electronic transmission, duly authenticated, within 48 months from the date of filing or Priority date, whichever earlier on any of the following grounds:
  - a) India has been chosen 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.
- 2) 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 prescribed.
- 3) If the application is not published or a request for early publication is not filed, the Applicant shall file Form 9 with

prescribed fee along with Form 18A.

- 4) If the request for expedited examination does not comply with the requirements of this rule, such a request shall be processed as normal request for examination, 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.
- 5) 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.
- by a startup, as defined in Rule 2 (fb), under this rule shall not be questioned merely on the ground that the startup ceased to be a startup after having filed an application for patent. 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.
- 6) 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.
- 7) 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.
- 8) 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.

- 9) 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.
- 10) 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).
- 11) 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.
- 12) Notwithstanding anything contained 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.

### 09.02 Reference for Examination

Once a request for examination is received, and the application is published under section 11A, the application is taken up for Examination in the chronological order of filing of request for examination.

11A, 12. Rule 24B(2)(i)

Section

2) Accordingly, the Controller shall refer the application, specification and other documents related thereto to the examiner and such reference shall be made in the order in which the request is filed.

Provided that in case of a further application filed under

section 16, the order of reference of such further application shall be the same as that of the first mentioned application.

Provided further that in case the first mentioned application has already been referred for examination, the further application shall have to be accompanied by a request for examination, and such further application shall be published within one month and be referred to the examiner within one month from the date of such publication.

3) A first statement of objections, along with any documents as may be required, shall be issued by the Controller to the applicant or his authorised agent within one month from the date of disposal of the report of examiner by the Controller:

Provided that where the request for examination was filed by a person interested, only an intimation of such examination may be sent to such person interested.

- 4) The patent application is referred to an Examiner by the Controller for conducting the formal as well as substantive examination as per the subject matter of the invention visà-vis the area of specialization of the Examiner. At present, the Patent Office has four examination groups based on the broad area of specialization viz.:
  - a) Chemistry and allied subjects.
  - b) Biotechnology, Microbiology and allied subjects.
  - c) Electrical, Electronics & related subject
  - d) Mechanical and other subjects.

The reference to the Examiner is made ordinarily within one month from the date of publication or one month from the date of request for examination, whichever is later, and is made in order in which the request is filed.

	5) When an application is referred by the Controller, the	
	Examiner makes a report on the patentability as well as	
	other matters ordinarily within one month but not	
	exceeding three months from the date of such reference.	
09.03	Examination of application	
09.03.01	Search for anticipation by previous publication and prior	Section 13
	claiming	
	1) The examiner conducts a search in the Indian Patent Database, starting from 1.1.1912, and all the available databases including patent /non patent literature In	
	addition to the above, PCT Minimum documentation is searched. The search is conducted to find out any publication	
	which may anticipate the claimed subject matter. Another objective of the search is to ascertain whether an invention	
	as claimed in any of the claims of the complete specification	
	has been claimed in any claim of any other complete	
	specification, filed in India, which has been published on or	
	after the date of filing of the applicant's complete specification.	
	2) The search is conducted with respect to the date of filing of complete specification.	
	3) The examiner ascertains the following:	
	a) International Patent classification.	
	b) Search strategy.	
	c) Keyword(s) used.	
	d) Databases consulted for both Patent and non Patent literature.	
	e) Prior art findings and analysis regarding the patentability.	
	f) Limitation on search if any, such as non clarity of claims	
	or multiplicity of inventions or any other reason due	
	to which a reasonable search cannot be conducted.	

#### 09.03.02

#### **Novelty**

Section

- 2(1)(j), 13, 29, 30, 31, 32, 33, 34
- 1) An invention is considered as new if it is not anticipated by prior publication in patent and non-patent literature, prior use or prior public knowledge.
  - An invention is new (novel) if it has not been disclosed in the prior art, where the prior art means everything that has been published, presented or otherwise disclosed to the public before the date of filing of complete specification.
- 2) For the purpose of determining novelty, an application for patent filed at the Indian Patent Office before the date of filing of complete specification of a later filed application, but published after the same, is considered for the purposes of prior claiming.
- 3) While ascertaining novelty, the Examiner takes into consideration, inter alia, the following documents:
  - which have been published before the date of filing of the application in any of the specifications filed in pursuance of application for patent in India on or after 1st January, 1912.
  - such Indian Patent Applications which have been filed before the date of filing of complete specification and published on or after the date of filing of the complete specification, but claims the same subject matter.
  - The Examiner may also consider such documents which have been published before in a transaction of a learned society or exhibited before in an authorized manner as designated by the Government within one year from the date of such filing.
- 4) A prior art is considered as anticipating novelty if all the features of the invention under examination are present in the cited prior art document.

	<ul><li>5) The prior art should disclose the invention either in explicit or implicit manner. Mosaicing of prior art documents is not allowed in the rejection of novelty.</li><li>6) A generic disclosure in the prior art may not necessarily take away the novelty of a specific disclosure. For instance,</li></ul>	
	<ul><li>a metal spring may not take away the novelty of a copper spring.</li><li>7) A specific disclosure in the prior art takes away the novelty of a generic disclosure. For instance, a copper spring takes away the novelty of a metal spring.</li></ul>	
	8) In a case where a prior art is cited as an anticipation in the Examination Report, the onus of proving that the same is deemed not to be an anticipation by reason of Section 29-34, is on the applicant.	
09.03.03	Inventive step	
09.03.03.01	Inventive step is a feature of an invention that involves technical advance compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art  Whiledetermining patentability of the invention, an Examiner first conducts investigation as to whether the novelty of the claimed invention is established and then proceeds to conduct examination on whether the claimed invention involves the inventive step.	Section 2(1)(j), 2(1)(ja)
09.03.03.02	<ol> <li>Determination of inventive step</li> <li>For determination of inventive step, the prior art as a whole, revealed during the search process, is relied upon to assess if such prior art(s) disclose(s) the claimed invention.</li> <li>Invention as a whole shall be considered. In other words, it is not sufficient to draw the conclusion that a claimed</li> </ol>	

invention is obvious merely because individual parts of the claims taken separately are known or might be found to be obvious.

- 3) If an invention lies merely in verifying the previous predictions, without substantially adding anything for technical advancement or economic significance in the art, the inventive step is lacking.
- 4) For the purpose of establishing obviousness of the invention, citing a mosaic of prior arts is permissible.
- 5) If the invention is predictable based on the available prior art, merely requiring workshop improvement by a person skilled in the art, the inventive step is lacking.

Hon'ble Supreme Court of India on inventive step: In **Biswanath** Prasad Radhey Shyam vs Hindustan Metal Industries Ltd it was held that "The expression "does not involve any inventive step" used in Section 26(1) (a) of the Act and its equivalent word "obvious", have acquired special significance in the terminology of Patent Law. The 'obviousness' has to be strictly and objectively judged. For this determination several forms of the question have been suggested. The one suggested by Salmond L. J. in Rado v. John Tye & Son Ltd. is apposite. It is: "Whether the alleged discovery lies so much out of the Track of what was known before as not naturally to suggest itself to a person thinking on the subject, it must not be the obvious or natural suggestion of what was previously known." "Another test of whether a document is a publication which would negative existence of novelty or an "inventive step" is suggested, as under:"Had the document been placed in the hands of a competent craftsman (or engineer as distinguished from a mere artisan), endowed with the common general knowledge at the 'priority date', who was faced with the problem solved by the patentee but without knowledge of the patented invention,

would he have said, "this gives me what I want?" (Encyclopaedia Britannica; ibid). To put it in another form: "Was it for practical purposes obvious to a skilled worker, in the field concerned, in the state of knowledge existing at the date of the patent to be found in the literature then available to him, that he would or should make the invention the subject of the claim concerned?"

In the **F.Hoffman la Roche v Cipla** case the Hon"ble Delhi High Court had observed that the obviousness test is what is laid down in **Biswanath Prasad Radhey Shyam vs Hindustan Metal Industries Ltd (AIR 1982 SC 1444)** and that "Such observations made in the foreign judgments are not the guiding factors in the true sense of the term as to what qualities that person skilled in the art should possess. The reading of the said qualities would mean qualifying the said statement and the test laid down by the Supreme Court."

Hon"ble High Court further added "From the bare reading of the afore quoted observations of Supreme Court, it is manifest that the Hon'ble Supreme Court has laid down the test for the purposes of ascertaining as to what constitutes an inventive step which is to be seen from the standpoint of technological advancement as well as obviousness to a person who is skilled in the art. It is to be emphasized that what is required to be seen is that the invention should not be obvious to the person skilled in art. These are exactly the wordings of New Patents Act, 2005 u/s Section 2(ja) as seen above. Therefore, the same cannot be read to mean that there has to exist other qualities in the said person like unimaginary nature of the person or any other kind of person having distinct qualities....... Normal and grammatical meaning of the said person who is skilled in art would presuppose that the said person would have the knowledge and the skill in the said field of art and will not be unknown to a particular field of art and it is from that angle one has to see that if the said document which is prior patent if placed in the hands

of the said person skilled in art whether he will be able to work upon the same in the workshop and achieve the desired result leading to patent which is under challenge. If the answer comes in affirmative, then certainly the said invention under challenge is anticipated by the prior art or in other words, obvious to the person skilled in art as a mere workshop result and otherwise it is not. The said view propounded by Hon'ble Supreme Court in Biswanath Prasad (supra) holds the field till date and has been followed from time to time by this Court till recently without any variance..... Therefore, it is proper and legally warranted to apply the same very test for testing the patent; be it any kind of patent. It would be improper to import any further doctrinal approach by making the test modified or qualified what has been laid down by the Hon'ble Supreme Court in of Biswanath Prasad (supra)."

The "obviousness" must be strictly and objectively judged. While determining inventive step, it is important to look at the invention as a whole. It must be ensured that inventive step must be a feature which is not an excluded subject itself. Otherwise, the patentee by citing economic significance or technical advance in relation to any of the excluded subjects can insist upon grant of patent thereto. Therefore, this technical advance comparison should be done with the subject matter of invention and it should be found it is not related to any of the excluded subjects.

Accordingly, the following points need to be objectively judged to ascertain whether, looking at the invention as a whole, the invention does have inventive step or not:

- 1) Identify the "person skilled in the art", i.e competent craftsman or engineer as distinguished from a mere artisan;
- 2) Identify the relevant common general knowledge of that person at the priority date;

	<ul> <li>3) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;</li> <li>4) Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;</li> <li>5) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of inventive ingenuity?</li> </ul>	
09.03.04	Industrial Applicability	Section
09.03.04	1) In order for an invention to be patentable, an invention must be capable of industrial application. Industrial Application in relation to patentability means that the invention is capable of being made or used in an industry.	2(1)(ac)
	2) The Examiner shall assess if the claimed invention is capable of use in any industry or made using an industrial process. Typically, the specification explains the industrial applicability of the disclosed invention in a self-evident manner. Usually industrial applicability is self-evident. If it is not, a mere suggestion that the matter would be industrially applicable is not sufficient. A specific utility should be indicated in the specification supported by the disclosure. For example, indicating that a compound may be useful in treating unspecified disorders, or that the compound has useful biological   properties, would not be sufficient to define a specific utility for the compound. The specific usefulness has to be indicated.	
09.03.05	Inventions not patentable  Under the Patents Act, 1970, the following are not inventions and hence are not considered to be patentable. However, examples given are mere illustrations and may not be conclusive	Section 3
		00

	on the subject. Objective decisions may be taken on case to case basis.	
09.03.05.01	An invention which is frivolous or which claims anything	Section
	obviously contrary to well established laws is not an	3(a)
	invention.	
	Some examples of a frivolous nature and contrary to natural	
	laws are:-	
	A machine purporting to produce perpetual motion.	
	A machine alleged to be giving output without any input.	
	A machine allegedly giving 100% efficiency.	
09.03.05.02	An invention, the primary or intended use or commercial	Section
	exploitation of which would be contrary to public order or	3(b)
	morality or which causes serious prejudice to human, animal	
	or plant life or health or to the environment is not an	
	invention.	
	Some examples are:	
	a) Any device, apparatus or machine or method for committing theft/burglary.	
	b) Any machine or method for counterfeiting of currency notes.	
	c) Any device or method for gambling.	
	d) An invention the use of which can cause serious prejudice to human beings, plants and animals.	
	e) Inventions, the intended use or commercial exploitation of which is found to be injurious to public, animal or plant life or health, such as, a method of adulteration of food.	
	f) An invention, the primary or intended use of which is likely to violate the well accepted and settled social,	

cultural, legal norms of morality, e.g. a method for cloning of humans.

- g) An invention, the primary or proposed use of which would disturb the public orders e.g. a device for house-breaking.
- h) However, if the primary or intended purpose or commercial exploitation of a claimed invention is not causing serious prejudice to human, animal or plant life or health or to the environment, such subject matter may be considered to be an invention and may be patentable. For instance, a pesticide.

#### 09.03.05.03

## The mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or nonliving substance occurring in nature is not an invention.

Section 3(c)

- a) A claim for discovery of scientific principle is not considered to be an invention, but a process of manufacture, based on the use of such principle, resulting in a substance or an article may be considered to be an invention.
- b) A scientific theory is a statement about the natural world. These theories themselves are not considered to be inventions, no matter how radical or revolutionary an insight they may provide, since they do not result in a product or process. However, any practical application of such theory in the process of manufacture of an article or substance, may well be patentable.
- c) The fact that a known material or article is found to have a hitherto unknown property is a discovery and not an invention. But if such discovery leads to the conclusion that the material can be used for making a particular article or in a particular process, then the article or process could be considered to be an invention.

For example, the property of a particular known material to be able to withstand mechanical shock is a discovery and therefore not patentable, but a claim to a railway sleeper made of such material would not fall foul of this exclusion, and would be allowable if it passed the tests for novelty and inventive step.

d) Similarly, finding of a new substance or micro-organism occurring freely in nature is a discovery and not an invention.

#### 09.03.05.04

The mere discovery of a new form of a known substance which does not result in the 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 is not an invention.

Section 3(d)

"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 regard to efficacy".

According to this provision, the following are not inventions and hence not patentable:

- a) mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance;
- b) the mere discovery of any new property of a known substance;
- c) the mere discovery of new use for a known substance;
  - d) the mere discovery of 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 to Section** 3(d) further clarifies that salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance may be considered as may be considered to be the same substance and can be patentable only if they differ significantly in Properties with regard to efficacy.

An Examiner investigates on case to case basis as to what constitutes the difference in properties with regard to efficacy from the known substance.

The complete specification shall bring out clearly and categorically in the description, as to how the subject matter differs significantly in properties with regard to efficacy from the known substance. at the time of filing of the application or subsequently by way of an amendment of specification under section 59.

Section 3(d) stipulates that an incremental invention, based upon an already known substance, having established medicinal activity shall be deemed to be treated as a same substance, and shall fall foul of patentability, if the invention in question fails to demonstrate significantly improved therapeutic efficacy with respect to the known substance.

After analysing the legislative history of Section 3(d), the Hon'ble Supreme Court in the matter of **Novartis AG Vs. Union of India, W.P.No. 24760/06,** commented, "We have, therefore, no doubt that the amendment/addition made in section 3(d) is meant especially to deal with chemical substances, and more particularly pharmaceutical products. The amended portion of section 3(d) clearly sets up a second tier of qualifying standards for chemical substances/pharmaceutical products in order to

leave the door open for true and genuine inventions but, at the same time, to check any attempt at repetitive patenting or extension of the patent term on spurious grounds (para...).

It was further held by the Apex Court -

" in the case of medicines, efficacy means "therapeutic efficacy" and physico-chemical properties of substances do not meet the requirement of "therapeutic efficacy".

It was also held that patent applicants must prove the increase in therapeutic efficacy and just increased bioavailability alone may not necessarily lead to an enhancement of therapeutic efficacy, and in any given case enhanced efficacy must be specifically claimed and established by research data.

#### 09.03.05.05

# A substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance is not an invention.

An admixture resulting in synergistic properties is not considered as mere admixture. Hence,, substances like soap, detergent, lubricants, may be considered as patentable.

A mere aggregation of features must be distinguished from a combination invention. The existence of a combination invention requires that the relationship between the features or groups of features be one of functional reciprocity or that they show a combinative effect beyond the sum of their individual effects. The features should be functionally linked together which is the actual characteristic of a combination invention.

In general, all the substances which are produced by mixing components or a process of producing such substances should satisfy the requirement of synergistic effect in order to be patentable. Synergistic effect should be clearly brought out in the description by way of comparison at the time of filing of the Application itself. The subsequent submissions regarding synergism can be accepted in a reply to the office action as a

## Section

3(e)

further support of synergy. However, such submitted data may be incorporated in the Specification, subject to the provisions of Section 59. 09.03.05.06 The mere arrangement or re-arrangement or duplication of Section known devices each functioning independently of one another 3(f) in a known way is not an invention. In order to be patentable, an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy the test of invention or an 'inventive step'. To be patentable, the improvement or the combination must produce a new result, or a new article or a better or cheaper article than before. A combination of old known integers may be so combined that by their working interrelation, they produce a new process or an improved result. Mere collocation of more than one integers or things, not involving the exercise of any inventive faculty, does not qualify for the grant of a patent. (Biswanath Prasad Radhey Shyam Vs. Hindustan Metal Industries (1979) 2 SCC, 511). A new and useful application of an old principle may be good subject-matter. An improvement on something known may also afford subject-matter; so also a different combination of matters already known. A patentable combination is one in which the component elements are so combined as to produce a new result or arrive at an old result in a better or more expeditious or more economical manner. If the result produced by the combination is either a new article or a better or cheaper article than before, the combination may afford subject-matter of a patent. (Lallubhai Chakubhai Vs. Chimanlal and Co. (AIR 1936 Bom 99.) An invention claiming a mere juxtaposition of known devices in which each device functions independently is not considered patentable. Merely placing side-by-side old integers so that each

performs its own function independently of the others is not a patentable combination.

[As for example: a flour mill provided with sieving means]. However, where the old integers when placed together have some working interrelation, producing a new or improved result, then there could be a patentable subject matter in the working interrelation brought about by the collection of the integers.

When two or more features of an apparatus or device are known, and they are juxtaposed without any inter-dependence on their functioning, they should be held to have been already known. (Rampratap v. Bhabha Atomic Research Center, 1976 IPLR 28 P. 35), e.g., an umbrella with fan (388/Bom/73), bucket fitted with torch, clock and transistor in a single cabinet. These are not patentable, since they are nothing but mere arrangement and rearrangement of items without having any working interrelationship between them and are devices capable of functioning independently of each other.

As for instance, in the case of an application for a patent in respect of an apparatus for producing metallic bellows, the hydraulic machine and the roll forming machine disclosed therein were functioning as separate machines independently of each other and as such had no novel feature. Hence, there is no invention when a claim is made on known types of hydraulic forming and roll forming machines functioning independently of each other.

A new combination may be the subject matter of a patent although every part of the combination, per se, is old, for here the new article is not the parts themselves but the assembling and working of the parts, together. The merit of a new combination very much depends upon the result produced. Where a slight alteration turns that which was practically

	useless into what is useful and important, it is fit subject matter	
	for a patent.( <b>Lallubhai Chakkubhai v. Shamaldas</b>	
	Sankalchand Shah, AIR 1934 Bom 407).	
09.03.05.07	A method of agriculture or horticulture is not an invention.	Section
	Examples of subject matters excluded from patentability under	3(h)
	this provision are:	
	a) A method of producing a plant, even if it involved a	
	modification of the conditions under which natural	
	phenomena would pursue their inevitable course (for	
	instance a green house).	
	b) A method of producing improved soil from the soil with	
	nematodes by treating the soil with a preparation	
	containing specified phosphorathioates.	
	c) A method of producing mushrooms.	
	d) A method for cultivation of algae.	
	e) A method for removal of weeds.	
09.03.05.08	Any process for the medicinal, surgical, curative,	Section
	prophylactic, diagnostic, therapeutic or other treatment of	3(i)
	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 is not an invention.	
	This provision excludes from patentability, the following:	
	a) Medicinal methods: for example a process of	
	administering medicines orally, or through injectables, or	
	topically or through a dermal patch.	
	b) Surgical methods: for example a stitch-free incision for	
	cataract removal.	
	c) Curative methods: for example a method of cleaning	
	plaque from teeth.	
	d) Prophylactic methods: for example a method of	

vaccination.

- e) Diagnostic methods: Diagnosis is the identification of the nature of a medical illness, usually by investigating its history and symptoms and by applying tests. Determination of the general physical state of an individual (e.g. a fitness test) is considered to be diagnostic.
- f) Therapeutic methods: The term 'therapy' includes prevention as well as treatment or cure of disease. Therefore, the process relating to therapy may be considered as a method of treatment and as such not patentable.
- g) Any method of treatment of animal to render them free of disease or to increase their economic value or that of their products. As for example, a method of treating sheep for increasing wool yield or a method of artificially inducing the body mass of poultry.
- h) Further examples of subject matter excluded under this provision are: any operation on the body, which requires the skill and knowledge of a surgeon and includes treatments such as cosmetic treatment, the termination of pregnancy, castration, sterilization, artificial insemination, embryo transplants, treatments for experimental and research purposes and the removal of organs, skin or bone marrow from a living donor, any therapy or diagnosis practiced on the human or animal body and further includes methods of abortion, induction of labour, control of estrus or menstrual regulation.
- i) Application of substances to the body for purely cosmetic purposes is not therapy.
- j) Patent may however be obtained for surgical, therapeutic or diagnostic instrument or apparatus.

	k) Also the manufacture of prostheses or artificial limbs and	
	taking measurements thereof on the human body are	
	patentable.	
09.03.05.09	Plants and animals in whole or any part thereof other than	Section
	micro-organisms but including seeds, varieties and species	3(j)
	and essentially biological processes for production or	- 0)
	propagation of plants and animals are not inventions.	
	The subject matters excluded under this provision are:	
	a) plants in whole or in part	
	b) animals in whole or in part	
	c) seeds	
	d) varieties and species of plants and animals	
	e) essentially biological process(es) for production or	
	propagation of plants and animals.	
	Microorganisms, other than the ones discovered from the	
	nature, may be patentable. For instance, genetically modified	
	microorganisms may be patentable subject to other	
	requirements of Patentability.	
	Plant varieties are provided protection in India under the	
	provisions of the 'Protection of Plant Varieties and Farmers'	
	Rights Act, 2002'.	
09.03.05.10	A mathematical or business method or a computer	Section
	programme per se or algorithms are not inventions and	3(k)
	hence not patentable.	
	Under this provision, mathematical methods, business methods,	
	computer programmes per se and algorithms are not considered	
	as patentable subject matter.	
	1) Claims directed as "Mathematical Method": Mathematical	
	methods are a particular example of the principle that purely	
	abstract or intellectual methods are not patentable.	
	Mathematical methods like method of calculation,	

formulation of equations, finding square roots, cube roots and all other similar acts of mental skill are therefore, not patentable. Similarly mere manipulations of abstract idea or solving purely mathematical problem/equations without specifying a practical application also attract the exclusion under this category.

However, mere presence of a mathematical formula in a claim, to clearly specify the scope of protection being sought in an invention, may not necessarily render it to be a "mathematical method" claim. Also, such exclusions may not apply to inventions that include mathematical formulae and resulting in systems for encoding, reducing noise in communications/ electrical/electronic systems or encrypting/ decrypting electronic communications.

2) Claims directed as "Business Method": The term "Business Methods" involves whole gamut of activities in a commercial or industrial enterprise relating to transaction of goods or services. The claims drafted not directly as "business methods" but apparently with some unspecified means are held non-patentable. However, if the claimed subject matter specifies an apparatus and/or a technical process for carrying out the invention even partly, the claims shall be examined as a whole. When a claim is "business methods" in substance, it is not to be considered a patentable subject matter. However, mere presence of the words such as "enterprise", "business", "business rules", "supply-chain", "order", "sales", "transactions", "commerce", "payment" etc. in the claims may not lead to conclusion of an invention being just a "Business Method", but if the subject matter is essentially about carrying out business/ trade/ financial activity/ transaction and/or a method of buying/selling goods through web (e.g. providing web service functionality), the same should be treated as business method and shall not be patentable.

- 3) Claims directed as "Algorithm": Algorithms in all forms including but not limited to, a set of rules or procedures or any sequence of steps or any method expressed by way of a finite list of defined instructions, whether for solving a problem or otherwise, and whether employing a logical, arithmetical or computational method, recursive or otherwise, are excluded from patentability.
- 4) Claims directed as "Computer Programme per se": Claims which are directed towards computer programs per se are excluded from patentability, like,
  - a) Claims directed at computer programmes/ set of instructions/ Routines and/or Sub-routines.
  - b) Claims directed at "computer programme products" /
     "Storage Medium having instructions" / "Database" /
     "Computer Memory with instruction" stored in a
     computer readable medium.

The legislative intent to attach suffix per se to computer programme is evident by the following view expressed by the Joint Parliamentary Committee while introducing Patents (Amendments) Act, 2002: "In the new proposed clause (k) the words "per se" have been inserted. This change has been proposed because sometimes the computer programme may include certain other things, ancillary thereto or developed thereon. The intention here is not to reject them for grant of patent if they are inventions. However, the computer programmes as such are not intended to be granted patent. This amendment has been proposed to clarify the purpose."

09.03.05.11

A literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions is not an invention.

Section

3(l)

	Writings, music, works of fine arts, paintings, sculptures, omputer programmes, electronic databases, pamphlets, lectures,	
	, , drawings, architecture, engravings, lithography, photographic	
	works, applied art, illustrations, maps, plans, sketches,	
	topography, translations, adaptations, etc. are not patentable.	
	Such works fall within the domain of the Copyright Act, 1957.	
09.03.05.12	A mere scheme or rule or method of performing mental act or	Section
	method of playing game is not an invention.	3(m)
	A mere scheme or rule or method of performing mental act or	
	method of playing game, are excluded from patentability,	
	because they are considered as outcome of mere mental process.	
	For example,	
	a) Method of playing chess.	
	b) Method of teaching.	
	c) Method of learning.	
09.03.05.13	A presentation of information is not an invention.	Section
	Any manner, means or method of expressing information	3(n)
	whether visual, audible or tangible by words, codes, signals,	
	symbols, diagrams or any other mode of representation is not	
	patentable. For example, a speech instruction means in the form	
	of printed text where horizontal underlining indicated stress and	
	vertical separating lines divided the works into rhythmic groups	
	is not patentable. For instance, railway time table, 100 years	
	calendar etc.	
09.03.05.14	Topography of integrated circuits is not an invention.	Section
	Since protection of Layout Designs of Integrated Circuits is	3(o)
	governed separately under the Semiconductor Integrated Circuit	
	Lay-out Designs Act, 2000, three-dimensional configuration of	
	the electronic circuits used in microchips and semiconductor	
	chips is not patentable.	
09.03.05.15	An invention which in effect, is traditional knowledge or	Section
	which is an aggregation or duplication of known properties	

	of traditionally known component or components is not an	3(p)
	invention.	
	Traditional Knowledge, being knowledge already existing, is not	
	patentable. An example is the antiseptic properties of turmeric	
	for wound healing. Another example is the pesticidal and insecticidal properties of neem.	
	The Examiner conducts an investigation by using the Traditional	
	Knowledge Digital Library (TKDL) and other resources to decide	
	as to whether the claimed subject matter falls within the purview of this provision.	
	Information and undertaking regarding foreign	
	applications	Section 8,
09.03.06	One of the criteria for the grant of a patent application and	Rule 12
	continuation of a patent is to provide information and	
	undertaking regarding foreign applications in Form 3, in	
	accordance with Section 8 of the Patents Act, 1970 and Rule	
	12 of the Patents (Amendment) Rule, 2003.	
	• No fee has been prescribed in the Act or Rules if submission is in accordance to the timelines as prescribed in rule 12.	
	Similar provision, which is in accordance with TRIPS	
	Agreement, is available in the laws of other countries like	
	USA,China,EPO, Mexico, Phillipines etc.	
	• Provisions in Section 8 : Filing of Information	
	regarding foreign applications :	
	(1) The applicant shall file along with his application or	
	within six months from the date of filing the	
	application-	
	(a) a statement setting out the name of the country	
	where the application is being prosecuted, the	
	serial number and date of filing of the application	
	and such other particulars as may be prescribed;	

and

(b) an undertaking that, up to the date of grant in India, he would keep the Controller informed in writing, from time to time, of details of the nature referred to in clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequently to the filing of the statement referred to in the aforesaid clause, within the period of 6 months.

The period of six months in case of an application corresponding to an international application in which India is designated shall be reckoned from the actual date on which the corresponding application is filed in India.

- (2) The Controller may also require the applicant to furnish, as far as may be available to the applicant, details relating to the objections, if any, taken to any such application as is referred to in sub-section (1) on the ground that the invention is lacking in novelty or patentability, the amendments effected in the specifications, the claims allowed in respect thereof and such other particulars as he may require, within six months from the date of such filing..
- If Form 3 is filed after the period specified it may be considered by the Office in accordance with the powers of the Controller generally provided in rule 137 /138.
- Recent arrangement with WIPO regarding access to Patent Information

#### A. WIPO DIGITAL ACCESS SERVICE

The WIPO Digital Access Service (DAS) is an electronic

priority documents system allowing and similar documents to be securely exchanged between participating intellectual property (IP) offices. This initiative makes the procedure simpler for the applicant, in that, instead of the tedious task of requesting documents from one country and then supplying them to his/her own country office, the DAS system allows for electronic exchange of documents directly between the offices. The documents are uploaded on a secure platform, by a participating office upon request by the applicant, and can then be accessed by a different participating office as required. This step further strengthens the data accessibility of priority documents in the Indian Patent Office.

On 12th March 2018, a public notice has been issued to the stakeholders informing the availability of the WIPO Digital Access Service under WIPO-India Cooperation Agreement.

# B. WIPO CENTRALIZED ACCESS TO SEARCH AND EXAMINATION (WIPO CASE):

The WIPO CASE system enables patent offices to securely share search and examination documentation related to patent applications in order to facilitate work sharing programs. Offices can share their dossier information either directly through the WIPO CASE system or through the IP5 One Portal Dossier linkage system.

The rationale of joining WIPO CASE is based on the fact that the same patent applications are filed in multiple offices, patent examiners can increase the efficiency and quality of their work by sharing their examination results.

The Indian Patent Office started its operations as an Accessing Office under WIPO CASE from June 1, 2015 and

commenced its operations as a Providing Office in February 2018. Thus, it has now access to search and examination reports of the corresponding applications filed in major patent offices.

#### • Legal jurisprudence:

Indian Courts while deciding the petitions on non-compliance of section 8 requirement by the patentee/applicant have analyzed the matter. The gist of rulings by the Courts is as under:

- ➤ the provision for revocation of patent under section 64(1) (m) on the ground of non-compliance of Section 8 should not be exercised solely and automatically just because it exists in the Act, as there lies a discretion in the Court not to revoke the patent on the peculiar facts and circumstances of the present case. The said discretion exists by use of the word, "may" under Section 64 of the Act.
- ➤ It is also necessary to consider the question whether there was deliberate or willful suppression and whether the undisclosed information was "material" to the grant of the patent. The Court can decide the fate of revocation petition only after considering such issues at trial on the basis of evidence submitted.

[REFERENCES: (1) HOFFMAN-LA ROCHE LTD. Vs. CIPLA ( CS (OS) No.89/2008 and C.C. 52/2008 , 07.09.2012, ( II) Koninklijke Philips Electronics vs. Maj. (retd.) Sukesh Behl & anr (CS (OS) No. 2206 of 2012, 6 -11-2013, (iii) Maj. (retd.) Sukesh behl & anr. Vs. Koninklijke philips electronics (FAO (OS) No.16 of 2014 (Division bench order)-Appeal to the CS (OS) No. 2206 of 2012 (Single judge order) ,07.11.2014 and (iv) Fresenius Kabi oncology Limited V. Glaxo GROUP LIMITED &ANR (IPAB-ORA 17 of 2012/PT/KOL &

M.P.Nos .4 of 2013, 9 of 2013, 10 of 2013 & 49 of 2013; 27.07.2013)]

• Guiding Principles to Patent Examiners and Controllers regarding requirement Under Section 8:

With the successful implementation of the WIPO CASE and WIPO Digital Access Service (DAS), and the legal jurisprudence evolved with respect to Section 8; the requirement of section 8 mandates shall be fulfilled by the Patent Office as under:

- 1. The examiner/Controller shall mandatorily check whether the applicant has filed a statement to the effect that the stipulated documents are available in WIPO CASE and DAS, from where the Office can access the documents. If such a statement has not been filed, then the applicant is required to provide all relevant documents, without fail.
- 2. The examiner/Controller shall check and ascertain whether the priority documents and similar documents pertaining to the application being processed in the Indian Patent Office are available in the WIPO Digital Access Service (DAS). If such documents are available, further information with regards to priority may not be sought for, from the applicant.
- 3. The examiner/Controller shall utilise all the facilities available in WIPO CASE regarding processing of corresponding patent applications in other countries, including access to Search and Examination reports, and other information available with Patent Offices that are part of WIPO CASE (currently Australia, Brunei Darussalam, Canada, Chile, European Patent Office (EPO), India, Israel, Japan, New Zealand, Republic of Korea, Singapore, International Bureau of WIPO, United Kingdom, United States of America).
- 4. Notwithstanding any of the steps mentioned above, the

	Controller may seek details as stipulated under Section	
	8(2) of the Patents Act, 1970 relating to the processing of	
	the application in a country outside India, including but not	
	limited to, Search and/or examination reports, Claims of	
	application allowed/ disallowed, Amendments made, if any,	
	etc. n other Patent offices.	
09.03.07	Sufficiency of Disclosure	Section 10
	Sufficiency of disclosure is yet another aspect, which is checked	
	by the Examiner while examining a patent application. The	
	Examiner will look for whether:	
	b) the specification is properly titled.	
	c) the subject matter is fully and particularly described in	
	the specification.	
	d) the claims define the scope of the invention properly.	
	e) the Specification describes the best method of performing	
	the invention or not.	
	f) the source and geographical origin, in case of inventions	
	related to biological materials, has been disclosed.	
	g) approval obtained from Biodiversity Authority, wherever	
	applicable.	
	h) accession number and other details of the depository are	
	given, if applicable	
09.03.08	Unity of Invention	Section
	1) The Claims of a Specification shall relate to a single inventive	10(5)
	concept. In case, an application comprises a plurality of	
	inventive concepts the examiner refers to the same in his	
	report. The application may be divided in order to meet the	
	objection of plurality of distinct inventions.	
	2) The determination whether a group of inventions is so	
	linked as to form a single inventive concept shall be made	
	without regard to whether the inventions are claimed in	

separate claims or as alternatives within a single claim.

- 3) Unity of invention between process and apparatus or means requires that the apparatus or means have been specifically designed for carrying out the process, or at least a step of the process.
- 4) Independent claims of different categories may relate to a single inventive concept. For example:
- a) Claims for a product and process specially adapted for manufacture of the product.
- b) Claims for a process and apparatus or means specifically designed for carrying out the process.
- c) A mould for casting an article, a method of making that mould, a process of casting the article by using the said mould will constitute a single invention.
- d) A locking system containing plug and socket wherein separate independent claims for a plug and socket may constitute a single inventive concept.
- e) A broadcasting system comprising transmitter and receiver.
- f) If an invention relates to a new type of spray bottle, claims may be directed to the spray bottle itself (a product) and a method of making the spray bottle (a process).
- g) In case of a genetically modified Gene Sequence/Amino Acid Sequence claims may be directed to a Gene sequence/Amino Acid sequence, a method of expressing the sequence, an antibody against that protein/sequence, a kit containing such antibody/ sequence.
- h) In case of a drug or pharmaceutical product, claims may be directed to a drug or pharmaceutical product, a process of making the product, a composition containing the drug.

09.03.09

**Report of Examiner** 

Section 3,

1) The examiner makes a report after carrying out detailed examination with respect to the following matters:	4, 12, 13
a) whether the application and the specification and other documents relating thereto are in accordance with the requirements of the Act and rules made thereunder;	
b) whether there is any lawful ground of objection to the grant of patent under the Act;	
c) the result of investigations under Section 13.	
2) The examiner prepares the report after conducting a prior art search to ascertain the novelty, and examining as to whether the invention disclosed in the specification is inventive and industrially applicable.	
The Examiner also examines whether the invention belongs to one of the categories of non-patentable inventions coming under Section 3 and 4, and whether the application is in conformity with all the provisions of the Act.	
Consideration of Report by Controller and issuance of First	Section 3,
statement of objection/ First Examination Report (FER)	4, 14, 15,
<ol> <li>The Controller considers the report of the examiner ordinarily within one month from the date of the receipt of such report and a gist of objections, if any, is sent to the applicant in the form of a report - First Examination Report (FER) - along with the application and specification, if required. If there is no objection to the grant of patent and no pre-grant opposition under Section 25(1) is pending, the patent is granted at the earliest.</li> <li>The FER is sent to the applicant, even when the request for examination has been filed by a person interested. An intimation regarding the issue of FER is given to such person interested.</li> <li>First Examination Report (FER) may contain office</li> </ol>	18, 21
	examination with respect to the following matters:  a) whether the application and the specification and other documents relating thereto are in accordance with the requirements of the Act and rules made thereunder;  b) whether there is any lawful ground of objection to the grant of patent under the Act;  c) the result of investigations under Section 13.  2) The examiner prepares the report after conducting a prior art search to ascertain the novelty, and examining as to whether the invention disclosed in the specification is inventive and industrially applicable.  The Examiner also examines whether the invention belongs to one of the categories of non-patentable inventions coming under Section 3 and 4, and whether the application is in conformity with all the provisions of the Act.  Consideration of Report by Controller and issuance of First statement of objection/ First Examination Report (FER)  1) The Controller considers the report of the examiner ordinarily within one month from the date of the receipt of such report and a gist of objections, if any, is sent to the applicant in the form of a report - First Examination Report (FER) - along with the application and specification, if required. If there is no objection to the grant of patent and no pre-grant opposition under Section 25(1) is pending, the patent is granted at the earliest.  2) The FER is sent to the applicant, even when the request for examination has been filed by a person interested. An intimation regarding the issue of FER is given to such person interested.

objections relating to:

- a) Lack of novelty, inventive step and industrial applicability.
- b) Subject matter relating to a category, which falls within the purview of Sections 3 and 4.
- c) Non-fulfilment of any other requirement under the Act & Rules.
- 4) The applicant is required to comply with all the requirements imposed upon him by the Act as communicated through FER or subsequent communication, at the earliest. However, if applicant fails to respond to the FER, within six months from the date of issuance of FER or within an extended period of 3 months the application is deemed to have been abandoned under Section 21(1). A communication to that effect is sent to the applicant for information. The period of 6 months is extendable only once for a maximum period of three months, if requested in Form 4 within the prescribed period of 6 months, along with fees.
- 5) If the response / amendment filed by the applicant do not satisfy the requirements laid down by the Act, the Controller offers an opportunity of hearing and decides the case on merits.
- 6. The hearing may also be held through video-conferencing or audio-visual communication devices. Such hearing shall be deemed to have taken place at the appropriate office.

Explanation.— For the purposes of this rule, the expression communication device shall have the same meaning as assigned to it in clause (ha) of sub-section (1) of section 2 of the Information Technology Act, 2000 (21 of 2000).

In all cases of hearing, written submissions and the relevant documents, if any, shall be filed within fifteen days from the

date of hearing. 7. When the applicant re-files the documents within stipulated time, the application has to be examined in a fresh manner by the examiner. Upon examination, if it is found that the requirements of the Act have been met, the Patent is granted. 8. If the applicant contests any of the objections communicated to him by the Controller or he re-files his specification or other documents, along with his observations as to whether or not the specification is to be amended, an opportunity of being heard is given. 9. After hearing the applicant, the Controller may specify or permit such amendment as he thinks fit and grant the patent. The Controller may refuse to grant the patent if requirements of the Act and Rules are not complied with. 10. No patent is refused without giving an opportunity of being heard under Section 14. A decision by the Controller under Section 15 for refusal of patent shall be a speaking order. 11. Such an order of Controller under Section 15 is appealable before the Intellectual Property Appellate Board. 09.05 **Post-dating of Application** Section 1) The application for patent may be post-dated to a date not 9(4), 15, later than six months from the date of application on a 17 request made by the applicant at any time before the grant of patent along with the prescribed fee. Where such request is made before the examination of a) application, the same may be allowed and the examination shall be conducted with reference to the date so post-dated. b) Where such request is made after the issuance of First Examination Report, the same may be allowed subject to fresh examination with reference to the date so post-

dated.

- 2) If the application or specification (or drawings if any) or any document is required to be amended under section 15 to comply with the requirements of the Act or the Rules, the Controller may direct that the application or specification or other documents related thereto be deemed to have been made on the date on which the requirements are complied with or the date on which it is re-filed after complying with the requirements. In case this provision is invoked, the application shall be examined afresh with reference to the date as directed by the Controller (Section 17(2)).
- 3) Following may be instances in which Section 17(2) may be invoked by the Controller:
  - a) A missing part is brought-in through an amendment, for the purpose of meeting the office objections during Section 15 proceedings, by the applicant.
  - b) A new drawing is brought-in through an amendment for the purpose of explaining the amended specification, and without such amended drawing the amended specification cannot be explained.

# 4) Regarding Date of filing for Post- dating of application, the following should be kept in mind:

- i) Applicant can file an application with Provisional Specification and then file Complete Specification within the stipulated period of 12 months. In this case, his date of filing with provisional application will be the date of application.
- ii) Applicant can file an application with Complete Specification and request to convert it into Provisional Specification within 12 months of original filing date (Section 9 (3)) and file Complete Specification within 12 months from the first filing date, then the date of filing will still be the date of first filing.

- (iii) After filing complete Specification, the applicant may cancel the provisional specification (i.e. the one filed directly under Section 9 (1) or the one converted from a complete specification under Section 9 (3) ) and can post-date the application to the date of filing of the complete specification (Section 9 (3)). In this case, the date of application will be the date on which such Complete Specification is filed.
- (iv) **Section 17 (1)**: Subject to the provisions of section 9, at any time after the filing of an application and before the grant of the patent, the Controller may, at the request of the applicant made in the prescribed manner, direct that the application shall be post-dated to maximum period of six months from the date of filing the application.

Therefore, the said period of six months as provided in section 17 (1), shall be counted from the Date of application as stated above in (i), (ii) or (iii), as the case may be.

#### 09.06 | Pre-Grant Opposition

- 1) Any person may file an opposition by way of representation to the Controller in Form 7A against the grant of Patent, at the appropriate office, at any time after publication of patent application u/s 11A, but before the grant of Patent on any of the grounds mentioned in Section 25(1) with a copy to the applicant. The date of grant of Patent is the date on which the Controller orders the grant of patent in the file. Simultaneously, the patent number is generated and the fact of granting the patent is available on the official website.
- 2) If any pre-grant opposition is received after the grant of the patent, the Controller shall return the pre- grant opposition to the opponent and shall intimate such opponent about the fact of grant of the patent. If the opponent is a person

Section

11A,

25(1). Rule 55. interested, he may file a formal post grant opposition.

- 3) A Patent is not granted before the expiry of six months from the date of publication under Section 11A. Therefore, a person may file the pre-grant opposition within the assured period of six months from the date of Publication, to make sure that the pre-grant opposition is filed before the grant of patent.
- 4) The representation shall include a statement and evidence, if any, in support of such representation and a request for hearing, if so desired.
- 5) The Controller shall consider the representation only after a Request for Examination for that Application has been filed.
- 6) The Pre-Grant Opposition, if available on record, is considered by the Controller along with the report of the Examiner.
- 7) On consideration of the opposition, if the Controller is of the opinion that the opposition is devoid of any merit, an opportunity of hearing shall be granted to the opponent. After hearing the opponent, if the Controller is still of the opinion that the opposition shall be refused, a speaking order shall be issued rejecting the pre-grant opposition, ordinarily within one month.
- 8) However, if the Controller is of the opinion that pre- grant opposition has merit and the application shall be refused or amended, a notice is given to the applicant along with a copy of the representation. The applicant shall, if he so desires, give reply to that representation along with his statement and evidence, if any, in support of his application within three months from the date of the notice.
- 9) The Controller shall consider the statement and evidence filed by the applicant and may either refuse the grant of patent or ask for amendment of the complete specification to

his satisfaction before the grant of patent.

10) On consideration of the statement and evidence filed by the applicant, the representation including the statement and evidence filed by the opponent, submissions made by the parties, and after hearing the parties, if so requested, the Controller may either reject the representation or require the complete specification and other documents to be amended to his satisfaction before the patent is granted or refuse to grant a patent on the application, by passing a speaking order to simultaneously decide on the application and the representation ordinarily within one month from the completion of above proceedings. If the application for patent is to be refused on consideration of the pre-grant opposition u/s 25(1), a speaking order of refusal shall be issued under Section 15.

In the matter of **Neon Laboratories Pvt. Ltd. vs. Troikaa Pharma Limited and Ors. (Writ Petition No. 211 of 2010),**the Bombay High Court held that "When the law consciously confers a right on a person that right must be protected in the way it has been granted." "Section 25(1) and Rule 55 of Patent Amendment Act and Patent Rules contemplate that if the original claim/application for grant of patent is amended and the amendments are opposed, then, a personal hearing to the objector on the amended claims is required to be given if specifically requested"

In the matter of **Snehlata C. Gupte vs. Union of India (UOI) and Ors,** the Delhi High Court held the pre grant representation proceedings on the same pedestal as per court hearing despite the fact that patent being techno-legal in nature and involving complexities.

"For the purposes of Section 43(1) of the Patent Act, patent is 'granted' on the date on which the Controller passes a final order to that effect on the file."

09.07	Grant of Patent	
09.07.01	Compliance of conditions under the Act	Section 18,
	<ol> <li>The Patent is granted as expeditiously as possible when</li> <li>the application has not been refused by the Controller by virtue of any power vested in him by this Act, or</li> <li>the application has not been found to be in contravention of any of the provisions of the Act, or</li> </ol>	43. Rule 28, 28A, 29, 30, 31.
	<ul> <li>For instance,</li> <li>a) All objections raised by the examiner have been met and documents returned with the FER have been resubmitted after complying with the requirements, within 6 months from the date of the FER or within the extended period.</li> <li>b) In cases where the FER contains reference to a prior art which was published before the date of filing of complete specification but after the date of priority of the application, the applicant will have to prove that the priority date of the claim of his complete specification is earlier than the date on which the relevant document was published. The priority date of such claim is the date on which the matter was first disclosed in the relevant specification. In the alternative, the applicant may amend his complete specification to overcome the objection in respect of such document. In the absence of above mentioned proof or amendment, the application is liable to be refused, after following the procedure elaborated in Rule 28, 28-A.</li> <li>c) In cases where the FER contains reference to a prior art which was published after the date of filing of his</li> </ul>	
	complete specification but claiming an earlier priority date, the applicant will have to prove that the priority date of the claim of his complete specification is earlier than the date on which such document was published.	

The priority date of such claim is the date on which the matter was first disclosed in the relevant specification. In the alternative, the applicant may amend his complete specification to overcome the objection in respect of such document. In the absence of above mentioned proof or amendment, a reference to the other specification shall be inserted by way of notice to the public in the applicant's specification, after following the procedure elaborated in Rule 29-31.

d) When there is no pre-grant representation pending before the grant of Patent or when the Pre-Grant Opposition has been disposed of in favor of the applicant, the date of grant of patent is the date on which the patent is granted by the Controller in the file. The patent number is simultaneously generated. As the Patent Office has moved to complete electronic processing, the fact of grant of Patent by the Controller and the Patent Number is reflected on the official website on real time basis.

### 09.07.02 | Consequences of grant

- Section 43, Form-27
- 1) On the grant of patent, every patent is allotted a serial number by the electronic system. A Certificate of Patent is generated in the prescribed format and an entry in the eregister is made simultaneously. In the present electronic system, the date of recordal of Patent in the Register of Patents is the same as the date of grant of Patent by the Controller.
- 2) The complete specification as granted is made available to public through official website.
- 3) The application, specification and other related documents are open for public inspection on payment of prescribed fee.
- 4) The fact that the patent has been granted is published in the official journal of the Patent Office.

5) On the grant of patent, the patentee is required to pay the accumulated fee within 3 months from the date of recordal of Patent in the Register of Patents, which is now the same as the date of grant of Patent. The said period is extendable by six months provided the request is made before the expiry of extendable period. 6) A post-grant opposition under section 25(2) can be filed by any person interested within 12 months from the date of publication of grant. 7) Every patentee and licensee has to furnish a statement regarding the working of the patented invention on commercial scale in India at regular intervals (not less than six months) in the prescribed format. 09.07.03 **Date of Patent** Section 45 1) The date of Patent is the date of filing of the Application. However, in case of a PCT National Phase application, the date of filing is the international filing date. 2) Notwithstanding anything contained in this section, no suit or other proceeding shall be commenced or prosecuted in respect of an infringement committed before the date of grant of patent.. 09.07.04 Section 47 Conditions subject to which Patent is granted 1) any machine, apparatus or other article in respect of which the patent is granted or any article made by using a process in respect of which the patent is granted, may be imported or made by or on behalf of the government for the purpose merely of its own use; 2) any process in respect of which the patent is granted may be used by or on behalf of the government for the purpose merely of its own use; 3) any machine, apparatus or other article in respect of which

	the patent is granted or any article made by the use of the	
	process in respect of which the patent is granted, may be	
	made or used, and any process in respect of which the patent	
	is granted may be used, by any person, for the purpose	
	merely of experiment or research including the imparting of	
	instructions to pupils; and	
	4) in the case of a patent in respect of any medicine or drug, the	
	medicine or drug may be imported by the government for	
	the purpose merely of its own use or for distribution in any	
	dispensary, hospital or other medical institution maintained	
	by or on behalf of the government or any other dispensary,	
	hospital or medical institution which the Central Government	
	may, having regard to the public service that such	
	dispensary, hospital or medical institution renders, specify in	
	this behalf by notification in the Official Gazette.	
09.07.05	Rights of Patentee	Section 48
	1) In case of a patented product, the patentee shall have the	
	exclusive right to prevent third parties, from the act of	
	making, using, offering for sale, selling or importing for those	
	purposes that product in India.	
	2) In case of a patented process, the patentee shall have the	
	exclusive right to prevent third parties, from the act of using	
	that process, and from the act of using, offering for sale,	
	selling or importing for those purposes the product obtained	
	directly by that process in India.	
09.07.06	Rights of co-owners	Section 50,
	1) Where a patent is granted to two or more persons, each of	51
	those persons shall, unless an agreement to the contrary is in	
	force, be entitled to an equal undivided share in the patent.	
	2) Subject to the provisions contained in this section and in	
	Section 51, where two or more persons are registered as	
	grantee or proprietor of a patent, then, unless an agreement	
	to the contrary is in force, each of those persons shall be	
		120

- entitled, by himself or his agents, to the rights conferred by Section 48 for his own benefit without accounting to the other person or persons.
- 3) Subject to the provisions contained in this section and in section 51 and to any agreement for the time being in force, where two or more persons are registered as grantee or proprietor of a patent, then, a licence under the patent shall not be granted and a share in the patent shall not be assigned by one of such persons except with the consent of the other person or persons.
- 4) Where a patented article is sold by one of two or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming through him shall be entitled to deal with the article in the same manner as if the article had been sold by a sole patentee.
- 5) Subject to the provisions contained in this section, the rules of law applicable to the ownership and devolution of movable property generally shall apply in relation to patents, and nothing contained in sub-section (1) or sub-section (2) shall affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or their rights or obligations as such.
- 6) Nothing in this section shall affect the rights of the assignees of a partial interest in a patent created before the commencement of this Act.

#### 09.07.07 | Term of Patent

Section 53

The term of Patent is 20 years from the date of filing of application in respect of all the patents, including those for which the term had not expired on 20th May, 2003, when Patent (Amendment) Act 2002 came into force, provided that the renewal fee is paid every year before the due date or within the extended period (maximum six months).

## **Chapter - 10: Opposition Proceedings**

# **10.01** Post-grant opposition

- 1) Any person interested can file a Notice of Opposition against the grant of Patent in the prescribed format, in duplicate, any time after the grant but within twelve months from the date of publication of grant of patent at the appropriate Office.
- Section 2(1)(t), 25(2). Rule 55A, 60, 126, 127. Form 7.
- 2) The opponent shall state the nature of his interest in the matter.
- 3) The post-grant opposition can be filed on the grounds as mentioned in Section 25(2), but no other grounds.
- 4) After receipt of Notice of Opposition, the Controller shall notify the patentee about the fact of receipt of such notice, without any delay.
- 5) A copy of the statement and evidence, if any, shall be delivered to the patentee by the opponent.
- 6) If the patentee desires to contest the opposition, he shall file a reply statement setting out fully the grounds upon which the opposition is contested, and evidence if any, in support of his case within a period of two months from the date of receipt of the copy of opponent's written statement and evidence, if any, and deliver a copy to the opponent.
- 7) If the patentee does not desire to contest or does not file his reply and evidence within two months, the patent shall be deemed to have been abandoned and the Controller shall issue the order of revocation of Patent and the fact of revocation is entered in the register of patents.
- 8) After receipt of reply from the patentee, the opponent may file his evidence in reply within one month from the date of delivery to him of a copy of the patentee's reply

statement and evidence. Evidence in reply of the opponent shall be strictly confined to the matters in the patentee's evidence. The opponent shall deliver a copy of his reply statement and evidence to the patentee. No further evidence shall be delivered by either party, 9) except with the leave or direction of Controller. 10) With respect to further evidence filing, either party shall do so before the Controller's notification on the fixation of the date of hearing. 11) Where a specification or other document in a language other than English is referred to in the notice, statement or evidence, an attested translation thereof in duplicate in English should be furnished along with such notice, statement or evidence, as the case may be. 12) Evidence shall be filed on affidavits as required under Rule 126. 13) Exhibits shall be filed as required under Rule 127. 10.02 **Constitution of Opposition Board** Rule 56, 57, 58, 59, 1) After receipt of Notice of Opposition, an Opposition Board 60 is constituted by the Controller, by order, to examine such notice including all the documents filed under rule 57-60 in connection with opposition by the opponent as well as patentee. The Board shall submit the report with reasons on each 2) ground taken in the Notice of Opposition after examining all statements, documents and evidence submitted by the parties, as a joint recommendation within three months from the date on which all such documents were forwarded to them. 3) The Opposition Board consists of three members with one of them as Chairman. The examiner may be a member of the Board. But, the examiner who has dealt with the application for patent

		during the prosecution proceedings for grant of patent	
		thereon shall not be included as a member of the Board.	
10.03	Hearing		Rule 62
	1)	On the completion of the presentation of evidence, if any,	
		and after receiving the recommendation of Opposition	
		Board the Controller shall fix, a date and time for the	
		hearing of the opposition and inform the parties, at	
		least ten days in advance.	
	2)	On receipt of the notice of hearing, if either party desires	
		to be heard, he shall inform the Controller by a notice	
		along with the prescribed fee.	
	3)	The Controller may require the members of Opposition	
		Board to be present in the hearing	
	4)	The Controller may refuse to hear any party which has not	
		given such notice and fee.	
	5)	If either party intends to rely on any Publication at the	
		hearing not already mentioned in the notice of opposition,	
		statement or evidence, he shall give to the other party and	
		to the Controller a notice of his intention to do so,	
		together with details of such publication. Such notice shall	
		be given at least five days before the date of hearing.	
	6)	After hearing the 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, i.e., he may revoke the	
		patent, or order amendments in the Patent or refuse the	
		opposition and issue a speaking order.	
	7)	If amendment of specification or any other document is	
		ordered by the Controller, the patentee shall submit such	
		amended documents to the office within a reasonable	
		time, as directed by the Controller.	

## **Chapter 11: Post-grant procedures**

#### 11.01 Maintenance of Patent - renewal

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. Section 53, 142 (4). Rule 80. Form-4.

Further, renewal of a patent can be done beyond the due date in the extended period of six months from that date by filing Form-4 along with the prescribed fee.

This period of six months is not further extendable.

- 1) Where a patent is granted later than two years from the date of filing of the application, the fees which have become due in the meantime may be paid within a period of three months from the date of the recording of the patent in the register. The date of recording of patent in the register of patents is communicated to the applicant through an email mentioned in file records.
- 2) If a patent is granted before the expiry of two years from the date of filing of application, the first renewal fee becomes due in respect of the third year. However, the same shall be paid before the expiry of second year. First Renewal fee for a patent becomes due in respect of the third year counted from the date of filing of application for patent. However, the renewal fee for third year has to be paid before the expiry of second year. For clarification, the renewal fee may be paid before the expiration of the fourth year from the date of Patent for the fifth year and so on.
- 3) While paying the renewal fee, the patentee shall quote correctly the patent number, date of patent and the year in respect of which the renewal fee is being paid. Any mistake

in the above said particulars may lead to a lapse of patent.

- 4) For the Patent of Addition no renewal fee is required to be paid.
- 5) Annual renewal fee may be paid for more than one year in advance.

#### 11.02 Restoration of Lapsed Patents

- 1) When a Patent has ceased to have effect due to non-payment of renewal fees within the prescribed time, the Patent may be restored by filing an application for restoration, in Form-15, within eighteen months from the date on which the patent ceased to have effect. Such an application can be made by the patentee / assignee, or his legal representative and in case of joint applicants, then, with the leave of the Controller, any one or more of them without joining the others.
- 2) The applicant has to state, the circumstances which led to the failure of payment of renewal fees. The application must include a statement fully setting out such circumstances that led to the failure to pay the renewal fee. This statement is to be supported by evidence and copies of relevant documents.
- 3) The evidence must support the patentee's claim that the failure to pay was unintentional and there has been no undue delay in applying for restoration.
- 4) The Controller may call for further evidence to justify that the failure to pay was unintentional and that there has been no undue delay for making the application.
- 5) If a patentee has failed to register a change of name before cessation he must first apply under Rule 94 for alteration in the register. If he changed his name after cessation he must prove his identity. In both cases he must draw and sign the application in his new name but in the latter case must add 'formerly known as' to his identification.

Section 60. Rule 84, 94. Form-15.

#### 11.02.01 | Procedure for disposal of application for restoration

- 1) When the Controller is prima facie satisfied after verification of evidence submitted in support of in Form 15 that the failure to pay renewal fee was unintentional and there had been no undue delay, the application for restoration will be published in the official journal under rule 84(3).
- Section 60, 61, 62. Rule 84, 85, 86. Form-14,
- 2) If the Controller is satisfied that a prima facie case for restoration has not been made, the Controller may issue a notice to the applicant to that effect. Within one month from the date of notice, if the applicant makes a request to be heard on the matter, a hearing shall be given and the restoration application may be disposed. If no request for hearing is received within one month from the date of notice by the Controller, the application for restoration is refused. In case of rejection of the application for restoration, a speaking order shall be issued.
- 3) Any person interested may give notice of opposition in Form 14, in the prescribed manner, to the application for restoration within two months of the date of Publication in the official journal on the grounds that the failure to pay the renewal fee was not unintentional or that there has been undue delay in the making of the application.
- 4) The notice of opposition shall include a statement setting out the nature of the opponent's interest, the grounds of opposition, and the facts relied upon. The notice of opposition shall be sent to the applicant expeditiously by the Controller.
- 5) The procedure specified in rules 57 to 63 for post grant opposition for filing of written statement, reply statement; reply evidence, hearing and cost shall apply in this case.
- 6) When no opposition is received within a period of two months from the date of publication of the application for

restoration, or opposition, if any, is disposed of in favour of the Patentee, the Controller shall issue an order allowing the application for restoration. The unpaid renewal fee and the additional fee, as mentioned in the first schedule, shall be paid within one month from the date of order of the Controller.

- 7) The fact that a patent has been restored shall be published in the official journal.
- 8) To protect the persons who have begun to use the applicant's invention between the date when the Patent ceased to have effect and the date of Publication of the Application for restoration, every order for restoration includes the provisions and other conditions, as the Controller may impose, for protection and compensation of the above-mentioned persons. No suit or other proceeding shall be commenced or prosecuted in respect of an infringement of a Patent committed between the date on which the Patent ceased to have effect and the date of the Publication of the Application for restoration of the patent.

### 11.03 Registration of assignments/Transfer of Right

- 1) An assignment of a patent or of a share in a patent, a mortgage, licence or the creation of any other interest in a patent shall be valid only if the same were in writing and the agreement between the parties concerned is reduced to the form of a document embodying all the terms and conditions governing their rights and obligations and has been duly executed.
- 2) Any person who becomes entitled by assignment, transmission or operation of law to a patent or to a share in patent or becomes entitled as a mortgagee, licensee or otherwise to any other interest in a patent, may apply in writing in Form-16 to the Controller, for the registration of

Section 68, 69. Rule 90, 91, 92. Form-16. his title or as the case may be of notice of his interest in the register. Such an application can also be made by the assignor, mortgagor, licensor or other party as the case may be. Provided that in the case of a licence granted under a patent, the Controller shall, if so requested by the patentee or licensee, take steps for securing that the terms of the licence are not disclosed to any person except under the order of a court.

- 3) Where such application is made for the registration of title or notice of interest of any person, the Controller, upon proof of title or interest to his satisfaction, shall enter in the register such particulars as are appropriate.
- 4) If there is any dispute between the parties the Controller may refuse to take any action to make an entry in the register, until the rights of the parties have been determined by a competent court.
- 5) Except for the purpose of making an application for registration of right, title or interest in the register of patents or for an application for rectification of the register of patents in the IPAB, a document in respect of which no entry has been made in the register shall not be admitted by the Controller or by any court as evidence of the title of any person to a patent or to a share or interest therein unless the Controller or the court, for reasons to be recorded in writing, otherwise directs.
- 6) If requested by the patentee / licensee, the terms of the license may be kept confidential and not disclosed to any person, except under the order of a Court.

#### 11.04 Surrender Of Patents

1) The patentee may at any time offer to surrender his patent through an application on plain paper. On receipt of such an offer the Controller publishes the offer in the Official

Section 63.
Rule 57,
58, 59, 60,
61, 62, 63.

Journal and also notifies every person (other than the Form-14. patentee) whose name appears in the register as having an interest in the patent. 2) An opposition against the offer to surrender the patent may be filed by any person interested in Form 14 (in duplicate) within 3 months from the date of publication of such offer in the Official Journal. The Controller shall inform the Patentee on receipt of such notice. 3) The procedure relating to filing of written statement, reply statement leaving evidence and hearing of the opposition is similar to that of the opposition to the grant of Patents as per Rules 57-63 [See Chapter 10- Post-grant opposition]. 4) In case, the Controller accepts the patentee's offer to surrender the patent, he may direct the patentee to return the patent and on the receipt of which, the Controller shall by order, revoke it and publish such revocation in the official iournal. 11.05 Section 83, **Working of Patents** 146. Rule 1) Patents are granted to encourage inventions and to secure 131(2) that the inventions are worked in India on a commercial Form-27 scale and to the fullest extent that is reasonably practicable without undue delay. 2) The Controller has the power to call for the information such as periodical statements as to the extent to which the patented invention has been commercially worked in India. as may be specified in the notice issued to that effect at any time during the continuance of the Patent 3) A patentee or a licensee shall furnish such information within two months from the date of such notice or within such further time as the Controller may allow. 4) The patentee and every licensee shall furnish a statement as

to the extent to which the patented invention has been worked on a commercial scale in India, in Form 27, in respect of every calendar year, within three months of the end of each year.

#### 11.06 Amendments after the grant of patents

- 1) After the grant of patent, the patentee may apply in Form-13 for an amendment of the application for patent, complete specification or any document relating thereto to be amended subject to such conditions, if any, and as the Controller thinks fit. Such a request may be filed in Form-13 with prescribed fee.
- 2) The request shall state the nature of the proposed amendment, highlighted in an annexed copy along with the reasons. The amendments are allowable only by way of disclaimer, correction or explanation. Such amendments shall be for the purpose of incorporation of actual fact only. Further, no amendment of a complete specification shall be allowed the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or the amended claim(s) do not fall wholly within the scope of claim(s) of the specification before the amendment.
- 3) An application for amendment may be published along with the nature of proposed amendment. However, if the nature of proposed amendment is substantive, the application for amendment shall be published. For instance, any application for amending the complete specification or the claims or the application for patent shall be published.
- 4) The amended pages have to be filed in duplicate by the applicant along with duly cancelled original pages.
- 5) Any person interested may file a notice of opposition in

Section 57, 59. Rule 57, 58, 59, 60, 61, 62, 63, 81, 82, 83. Form-13, 14. Form-14 within three months from the date of publication of the application for amendment. Where such a notice of opposition is filed, the Controller notifies the applicant for amendment.

- 6) After giving an opportunity to the applicant and opponent, if any, the Controller shall dispose off the case. The procedure specified in rules 57 to 63 for post grant opposition for filing of written statement, reply statement; reply evidence, hearing and costs shall apply in this case.
- 7) Amendments allowed after the grant of patent shall be published.
- 8) A leave to amend the complete specification obtained by fraud is a ground for revocation of patent under Section 64.
- 9) If any suit for infringement is pending before a Court or any proceeding for revocation of the Patent is pending before the High Court, the Controller shall not pass any order allowing or refusing the application for amendment.

# 11.07 Procedure to be followed, after the grant of patent, in case of death of an applicant

- 1) If the applicant had died before the grant of patent, but the patent was granted in his name, a person in whose name the patent ought to have been granted may make a request to the Controller for substitution. The Controller may amend the patent by substituting the name of the deceased applicant with the name of such claimant. Such a request has to be made in Form-10.
- 2) If the applicant dies after the patent has been granted, any person who becomes entitled to the patent or to a share in the patent, by operation of law, may make a request for registration of his title. Such a request shall be made in Form-16.

Section 44. Rule 75. Form-10, 16.

#### 11.08 Register of Patents

ts which 72. Rule 88, 93, 94.

Section 67,

- 1) Patent Office maintains Electronic Register of Patents which is under the control and management of the Controller of Patents and same is available in the office website.
- 2) 2. E- register of patents contains details about the patentee, notifications in respect of assignments, transmissions, patents, licences under patents, and amendments, extension and revocations of patents and is available to public. A copy of, or extracts from, the register of patents, certified to be a true copy under the hand of the Controller or any officer duly authorized by the Controller is admissible in evidence in all legal proceedings.
- 3) Upon grant of a patent, the entries of name, address and nationality of the patentee, title of the invention including the categories to which the invention relates, date of the patent, date of granting thereof and address for service of the patentee are entered in the E-Register of Patents through the module. The fact of payment of renewal fee shall is also entered in the E-register The Register of patents also contains particulars regarding proceedings under the Act, before the Controller or in the Courts in respect of every patent.
- 4) An application for alteration of name, nationality, address or address for service as entered in the register of patents may be made to the Controller in respect of any Patent. The Controller may require such proof of the alteration as he may think fit before acting on the request. If the Controller allows such a request, entries in the E- Register are altered accordingly.
- 5) If a patentee makes a request in writing along with the prescribed fees for entering an additional address for service in India and the Controller is satisfied that the

	request shall be allowed, the additional address shall be entered in the E- Register.	
	6) Entries in the register for each patent are available to the public on the official website.	
11.09	Rectification of register of patents	Section 71
	1) An application for rectification of register of patents may be made to the Intellectual Property Appellate Board (IPAB) by any person aggrieved:	
	a) by the absence or omission from the register of any entry; or	
	b) by any entry made in the register without sufficient cause; or	
	c) by any entry wrongly remaining on the register; or	
	d) by any error or defect in any entry in the register.	
	2) Notice of such application made before the IPAB is given to the Controller, who is entitled to be heard on the application. Further, if so ordered, the Controller shall appear before the IPAB.	
	3) If IPAB passes any order rectifying the register, a notice of rectification is served upon the Controller, who, upon such receipt, rectifies the register.	

# **Chapter-12: Appeals**

12.01	Appellate Board and Appeals	
12.01.01	Appellate Board	Section 116,
	a. An Appellate board, established under the Section 83 of the	
	Trade Marks Act, 1999, is the Appellate Board for the	117A(2)
	purposes of Patents Act, 1970. An appeal lies to the Appellate	
	Board from any decision, order or directions of the Controller	
	or Central Government passed under the provisions	
	mentioned in Section 117A(2) only and not against any other	
	decision or direction. The Board has been constituted for	
	speeding up legal proceedings.	
	b. The Appellate Board became operational on and from 2nd	
	April, 2007 vide S.O. 507(E) published in the Gazette of India,	
	Part II, Section 3, Sub-section (ii).	
12.01.02	Appeals	Section
	a. An appeal lies from the decision, order or direction made	
	or issued under the Patents Act by the Central Government or	117A(2), 81.
	any act or order of the Controller for the purpose of giving	
	effect to any such decision order or direction.	
	b. Further, an appeal shall lie from any decision, order or	
	direction of the Controller or Central Government under	
	Sections 15, 16,17, 18, 19, 20, 25(4), 28, 51, 54, 57, 60, 61, 63,	
	66, 69(3), 78,84(1) to (5), 85, 88, 91, 92 and 94 of the Patents	
	Act.	
	c. No appeal lies from an Order of the Controller	
	granting extension of time when such extension is provided in	
	any provision of the Act or of the rules.	
12.02	Appeal procedure	Section
	a. Every appeal from the decision of the Controller under	
	relevant sections as mentioned in Section 117A (2) shall be	

117E, 117F.

accompanied by the certified copy of the decision, order or direction appealed against. Such application shall be in the form and fee prescribed.

- b. Every appeal should be made within three months from the date of the decision, order or direction of the Controller or of the Central Government, as the case may be or within such further time as the Appellate Board may in accordance with the Rules made by it allow.
- c. The Controller shall have the right to appear and be heard-
  - in any legal proceedings before the Appellate Board in which the relief sought includes alteration or rectification of the register or in which any question relating to the practice of the patent office is raised;
  - ii. in any appeal to the Appellate Board from an order of the Controller on an application for grant of patent—
    - A. which is not opposed, and the application is either refused by the Controller or is accepted by him subject to any amendments, modifications, conditions or limitations, or
    - B. which has been opposed and the Controller considers that his appearance is necessary in the public interest.
- d. The Controller shall appear in any case, if so directed by the Appellate Board.
- e. The Controller may, in lieu of appearing, unless the Appellate Board otherwise directs, submit a statement in writing signed by him, giving such particulars as he thinks proper of the proceedings before him relating to the matter in issue or of the grounds of any decision given by him or of the

practice of the patent office in like cases, or of other matters
relevant to the issues and within his knowledge as the
Controller may deem it necessary, and such statement
shall be evidence in the proceedings.

**Chapter-13: Revocation of Patent** 

13.01	Revocation of Patent	
13.01.01	Revocation before High Court or Appellate Board	Section 64
	a. Any person interested or the Central Government may	
	make a petition on any of the grounds, specified for	
	revocation of Patent under Section 64 of the Patents	
	Act, before the Appellate Board. A Patent may also be	
	revoked by the High Court on a counter-claim in a suit	
	for infringement of patent.	
	b. Grounds for revocation before the Appellate Board as	
	well as the High Court are elaborated in Section 64.	
	c. Without prejudice to the provisions contained in (a)	
	above, a patent may be revoked by the High Court on	
	the petition of the Central Government, if the High	
	Court is satisfied that the patentee has without	
	reasonable cause failed to comply with the request of	
	the Central Government to make, use or exercise the	
	patented invention for the purposes of government	
	within the meaning of Section 99 upon reasonable	
	terms.	
13.01.02	Revocation by Controller on direction of Central	Section 65
	Government	
	a. Where at any time after grant of a patent, the Central	
	Government is satisfied that a patent is for an	
	invention relating to atomic energy for which no	
	patent can be granted under sub-section (1) of section 20	
	of the Atomic Energy Act, 1962 (33 of 1962), it may direct	
	the Controller to revoke the patent, and thereupon the	
	Controller, after giving notice, to the patentee and every	
	other person whose name has been entered in the register	
	as having an interest in the patent, and after giving them	
	an opportunity of being heard, may revoke the patent.	
	b. In such proceedings, the Controller may allow the	

	patentee to amend the complete specification in such	
	manner as he considers necessary instead of revoking the	
	patent.	
13.01.03	Revocation by Central Government	Section 66
	Where the Central Government is of opinion that a patent	
	or the mode in which it is exercised is mischievous to the	
	State or generally prejudicial to the public, it may, after	
	giving the patentee an opportunity to be heard, make a	
	declaration to that effect in the Official Gazette and	
	thereupon the patent shall be deemed to be revoked.	
13.01.04	Revocation by Controller for non-working	Section 85
	a. Where, in respect of a patent, a compulsory licence has	
	been granted, the Central Government or any person	
	interested may, apply to the Controller for an order	
	revoking the patent on the ground:	
	i. that the patented invention has not been	
	worked in the territory of India, or	
	ii. that reasonable requirements of the public with	
	respect to the patented invention have not been	
	satisfied, or	
	iii. that the patented invention is not available to the	
	public at a reasonably affordable price.	
	b. Such an application can be made only after the	
	expiration of two years from the date of the order	
	granting the first compulsory licence.	
	c. Such an application shall contain such particulars as	
	may be prescribed, the facts upon which the application is	
	based, and, in the case of an application other than the one	
	made by the Central Government, it shall also set out the	
	nature of the applicant's interest.	
	d. Such applications shall ordinarily be decided within	
	one year from the date of presentation to the	
	Controller.	

#### **Chapter 14: Compulsory Licensing**

#### 14.01 Working of patents - General principles

Section 83,

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- a. Patents are granted to encourage inventions and to secure that the inventions are worked in India on a commercial scale and to the fullest extent that is reasonably practicable without undue delay.
- b. Patents are not granted merely to enable patentees to enjoy a monopoly for the importation of the patented article.
- c. The protection and enforcement of Patent rights contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.
- d. Patents granted do not impede protection of public health and nutrition and should act as instrument to promote public interest especially in sectors of vital importance for socio-economic and technological development of India.
- e. Patents granted do not in any way prohibit Central Government in taking measures to protect public health.
- f. The Patent right shall not be abused by the patentee or person deriving title or interest on Patent from the patentee, and the patentee or a person deriving title or interest on Patent from the patentee does not resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology.

	<ul> <li>g. Patents are granted to make the benefit of the patented invention available at reasonably affordable prices to the public.</li> <li>h. Patented inventions are worked on a commercial scale in the territory of India without undue delay and to the fullest extent that is reasonably practicable;</li> <li>i. The interests of any person for the time being working or developing an invention in the territory of India under the protection of a patent are not unfairly prejudiced.</li> </ul>	
14.02	Compulsory License	
	An application for grant of a compulsory license may be	
	made under the following provisions:	
	a. Section 84.	
	b. Section 91.	
	c. Section 92.	
	d. Section 92A.	
14.02.01	Compulsory License under Section 84	Section 84
	a. Any person interested may make an application to the	Form-17
	Controller for grant of Compulsory License for a patent	
	after the expiry of three years from the —date of grant	
	of the patent on the following grounds:	
	<ul> <li>i. that the reasonable requirements of public with respect to the patented invention have not been satisfied, or</li> </ul>	
	ii. that the patented invention is not available to the public at reasonably affordable price, or	
	iii. that the patented invention is not worked in the territory of India.	
	Such an application may also be made by the licensee.	

- b. No person shall be stopped from alleging the grounds i-iii above by reason of any admission made by him in the licence or otherwise or by reason of his having accepted such a licence.
- c. In considering such an application, the Controller shall take into account
  - i. the nature of the invention, the time which has elapsed since the sealing of the patent and the measures already taken by the patentee or any licensee to make full use of the invention;
  - ii. the ability of the applicant to work the invention to the public advantage;
  - iii. the capacity of the applicant to undertake the risk in providing capital and working the invention, if the application were granted;
  - iv. as to whether the applicant has made efforts to obtain a licence from the patentee on reasonable terms and conditions and such efforts have not been successful within a reasonable period as the Controller may deem fit. Reasonable period shall be construed as a period not ordinarily exceeding a period of six months. However, these circumstances shall not be applicable in case of national emergency or other circumstances of extreme urgency or in case of public noncommercial use or on establishment of a ground of anti-competitive practices adopted by the patentee.

#### 14.02.01.01 Reasonable requirements of the public

Section 84(7)

The reasonable requirements of the public shall be deemed not to have been satisfied—

- I. if, by reason of the refusal of the patentee to grant a licence or licences on reasonable terms,
  - i. an existing trade or industry or the development thereof or the establishment of any new trade or industry in India or the trade or industry in India or the trade or industry of any person or class of persons trading or manufacturing in India is prejudiced; or
  - ii. the demand for the patented article has not been met to an adequate extent or on reasonable terms; or
  - iii. a market for export of the patented article manufactured in India is not being supplied or developed; or
  - iv. the establishment or development of commercial activities in India is prejudiced;or
- II. if, by reason of conditions imposed by the patentee upon the grant of licences under the patent or upon the purchase, hire or use of the patented article or process, the manufacture, use or sale of materials not protected by the patent, or the establishment or development of any trade or industry in India, is prejudiced; or
- III. if the patentee imposes a condition upon the grant of licences under the patent to provide exclusive grant back, prevention to challenges to the validity of patent or coercive package licensing; or
- IV. if the patented invention is not being worked in the territory of India on a commercial scale to an adequate extent or is not being so worked to the

	fullest extent that is reasonably practicable; or	
	V. if the working of the patented invention in the	
	territory of India on a commercial scale is being	
	prevented or hindered by the importation from	
	abroad of the patented article by—	
	i. the patentee or persons claiming under him; or	
	ii. persons directly or indirectly purchasing from	
	him; or	
	iii. other persons against whom the patentee is not	
	taking or has not taken proceedings for	
	infringement.	
14.02.01.02	Contents of application	Section 84
	Such an application shall contain a statement setting out	Form-17
	the nature of the applicant's interest, the facts upon	
	which the application is based and the terms and	
	conditions of the licence the applicant is willing to accept.	
14.02.01.03	Procedure	Section 86,
14.02.01.03		Section 86, 87,88, 89, 90.
14.02.01.03	a. Where the Controller is satisfied, upon consideration	87,88, 89, 90.
14.02.01.03	a. Where the Controller is satisfied, upon consideration of an application for compulsory licence, that a prima	·
14.02.01.03	a. Where the Controller is satisfied, upon consideration	87,88, 89, 90. Rule 62, 96,
14.02.01.03	a. Where the Controller is satisfied, upon consideration of an application for compulsory licence, that a prima facie case has been made out, he shall direct the	87,88, 89, 90. Rule 62, 96, 97,98, 99,
14.02.01.03	a. Where the Controller is satisfied, upon consideration of an application for compulsory licence, that a prima facie case has been made out, he shall direct the applicant to serve copies of the application upon the	87,88, 89, 90. Rule 62, 96, 97,98, 99, 100, 101.
14.02.01.03	a. Where the Controller is satisfied, upon consideration of an application for compulsory licence, that a prima facie case has been made out, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the	87,88, 89, 90. Rule 62, 96, 97,98, 99, 100, 101.
14.02.01.03	a. Where the Controller is satisfied, upon consideration of an application for compulsory licence, that a prima facie case has been made out, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which	87,88, 89, 90. Rule 62, 96, 97,98, 99, 100, 101.
14.02.01.03	a. Where the Controller is satisfied, upon consideration of an application for compulsory licence, that a prima facie case has been made out, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which the application is made, and shall publish the application in the official journal.	87,88, 89, 90. Rule 62, 96, 97,98, 99, 100, 101.
14.02.01.03	a. Where the Controller is satisfied, upon consideration of an application for compulsory licence, that a prima facie case has been made out, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which the application is made, and shall publish the application in the official journal.	87,88, 89, 90. Rule 62, 96, 97,98, 99, 100, 101.
14.02.01.03	a. Where the Controller is satisfied, upon consideration of an application for compulsory licence, that a prima facie case has been made out, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which the application is made, and shall publish the application in the official journal.  b. The patentee or any other person desiring to oppose	87,88, 89, 90. Rule 62, 96, 97,98, 99, 100, 101.
14.02.01.03	<ul> <li>a. Where the Controller is satisfied, upon consideration of an application for compulsory licence, that a prima facie case has been made out, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which the application is made, and shall publish the application in the official journal.</li> <li>b. The patentee or any other person desiring to oppose the application may, within two months from the date</li> </ul>	87,88, 89, 90. Rule 62, 96, 97,98, 99, 100, 101.
14.02.01.03	a. Where the Controller is satisfied, upon consideration of an application for compulsory licence, that a prima facie case has been made out, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which the application is made, and shall publish the application in the official journal.  b. The patentee or any other person desiring to oppose the application may, within two months from the date of publication of the application or within such further	87,88, 89, 90. Rule 62, 96, 97,98, 99, 100, 101.
14.02.01.03	<ul> <li>a. Where the Controller is satisfied, upon consideration of an application for compulsory licence, that a prima facie case has been made out, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register to be interested in the patent in respect of which the application is made, and shall publish the application in the official journal.</li> <li>b. The patentee or any other person desiring to oppose the application may, within two months from the date of publication of the application or within such further time as the Controller may on application (made either</li> </ul>	87,88, 89, 90. Rule 62, 96, 97,98, 99, 100, 101.

which the application is opposed and the terms and conditions of the licence, if any, the opponent is prepared to grant to the applicant and shall be accompanied by evidence in support of the opposition.

- d. The opponent shall serve a copy of his notice of opposition and evidence on the applicant and notify the Controller when such service has been effected.
- e. No further statement or evidence shall be delivered by either party except with the leave of or on requisition by the Controller.
- f. The Controller shall forthwith fix a date and time for the hearing of the case and shall give the parties not less than ten days notice of such hearing.
- g. The procedure specified in sub-rules (2) to (5) of rule 62, shall, so far as may be, apply to the procedure for hearing under this rule as they apply to the hearing in opposition proceedings.
- h. If, upon consideration of the evidence, the Controller is satisfied that a prima facie case has not been made out, he shall notify the applicant accordingly, and unless the applicant requests to be heard in the matter, the Controller shall refuse the application. The applicant shall make such a request within one month from the date of such notification.
- i. If the applicant requests for a hearing within the time allowed, the Controller shall, after giving the applicant an opportunity of being heard, determine whether the application may be proceeded with or whether it shall be refused and issue a speaking order on the matter as expeditiously as possible.

#### 14.02.01.04 Terms and conditions

Section 90

In settling the terms and conditions of a licence, the Controller endeavours to secure -

- a. that the royalty and other remuneration, if any, reserved to the patentee or other person beneficially entitled to the patent, is reasonable, having regard to the nature of the invention, the expenditure incurred by the patentee in making the invention or in developing it and obtaining a patent and keeping it in force and other relevant factors;
- b. that the patented invention is worked to the fullest extent by the person to whom the licence is granted and with reasonable profit to him;
- c. that the patented articles are made available to the public at reasonably affordable prices;
- d. that the licence granted is a non-exclusive licence;
- e. that the right of the licensee is non-assignable;
- f. that the licence is for the balance term of the patent unless a shorter term is consistent with public interest;
- g. that the licence is granted with a predominant purpose of supply in the Indian market and that the licensee may also export the patented product, if need be in accordance with the provisions of sub-clause (iii) of clause (a) of sub-section (7) of section 84;
- h. that in the case of semi-conductor technology, the licence granted is to work the invention for public non-commercial use:
- i. that in case the licence is granted to remedy a practice determined after judicial or administrative process to be anti-competitive, the licensee shall be permitted to export the patented product, if need be.

The terms and conditions of a licence settled by the

	Controller, may be revised upon Application by the	
	licensee after he has worked the invention on a	
	commercial scale for at least twelve months, on the	
	ground that the terms and conditions settled have	
	proved to be more onerous than originally expected and	
	that in consequence thereof the licensee is unable to	
	work the invention except at a loss. However, no such	
	application shall be entertained a second time.	
14.02.01.05	Application by licencee	Section 88
	a. Where the Controller is satisfied on an application for	
	compulsory license that the manufacture, use or sale of	
	materials not protected by the patent is prejudiced by	
	reason of conditions imposed by the patentee upon the	
	grant of licences under the patent, or upon the purchase,	
	hire or use of the patented article or process, he may,	
	subject to the provisions of Section 84, order the grant of	
	licences under the patent to such customers of the	
	applicant as he thinks fit as well as to the applicant.	
	b. Where an application for compulsory license is made	
	by a person being the holder of a licence under the	
	patent, the Controller may, if he makes an order for the	
	grant of a licence to the applicant, order the existing	
	licence to be cancelled, or may, if the thinks fit, instead of	
	making an order for the grant of a licence to the	
	applicant, order the existing licence to be amended.	
14.02.01.06	Compulsory license in case of two or more patents	Section 88
	held by the same patentee	
	Where two or more patents are held by the same	
	patentee and an applicant for a compulsory licence	
	establishes that the reasonable requirements of the	
	public have not been satisfied with respect to some only	
	of the said patents, then, if the Controller is satisfied that	
<u> </u>		

the applicant cannot efficiently or satisfactorily work the licence granted to him under those patents without infringing the other patents held by the patentee and if those patents involve important technical advancement or considerable economic significance in relation to the other patents, he may, by order, direct the grant of a licence in respect of the other patents also to enable the licensee to work the patent or patents in regard to which a licence is granted under section 84.

#### 14.02.02 License for related patents

- Section 87, 88,89, 90, 91 Form-17
- a. At any time after the grant of a patent, any person who has the right to work any other patented invention, either as patentee or as licensee thereof, exclusive or otherwise, may apply to the Controller for the grant of a licence of the first mentioned patent on the ground that he is prevented or hindered without such licence from working the other invention efficiently or to the best advantage possible.
- b. No order under such an application shall be
   made unless the Controller is satisfied
  - i. that the applicant is able and willing to grant, or procure the grant to the patentee and his licensees if they so desire, of a licence in respect of the other invention on reasonable terms; and
  - ii. that the other invention has made a substantial contribution to the establishment or development of commercial or industrial activities in the territory of India.
- c. Controller, if satisfied, that the grounds alleged have been established by the applicant,

he may make an order on such terms as he thinks fit granting a licence under the first mentioned patent and a similar order under the other patent if so requested by the proprietor of the first mentioned patent or his licensee.

However, such a licence granted by the Controller shall be non- assignable except with the assignment of the respective patents.

d. The procedure as mentioned in Sections 87, 88,89 and 90 shall apply to licences a licence granted under this provision.

#### 14.02.03

## Compulsory licence on notification by Central Government

Section 83, 87,88, 89, 90, 92

a. If the Central Government is satisfied, in respect of any patent in force in circumstances of national emergency or in circumstances of extreme urgency or in case of public non-commercial use, that it is necessary that compulsory licenses should be granted at any time after the sealing thereof to work the invention, it may make a declaration to that effect, by notification in the Official Gazette, and thereupon the following provisions shall have effect, that is to say -

Form-17

- i. the Controller shall, on application made at any time after the notification by any person interested, grant to the applicant a licence under the patent on such terms and conditions as he thinks fit;
- ii. in settling the terms and conditions of a licence granted under this section, the Controller shall endeavour to secure that the articles manufactured under the patent shall be available to the public at the lowest prices consistent with the patentees deriving a reasonable advantage from their patent

rights.

- iii. The procedure as mentioned in Sections 83, 87, 88, 89 and 90 shall apply in relation to the grant of such licences as they apply in relation to the grant of licences under Sec. 84.
- iv. However, where the Controller is satisfied on consideration of the application that it is necessary in-
  - I. a circumstance of national emergency; or
  - II. a circumstance of extreme urgency; or
  - III. a case of public non-commercial use,

which may arise or is required, as the case may be, including public health crisis relating to Acquired Immuno Deficiency Syndrome, Human Immune Deficiency Virus, Tuberculosis, Malaria or other epidemics, the procedure as mentioned in Section 87 shall not apply. However, the Controller shall, as soon as may be practicable, inform the patentee of the patent relating to the application for such non-application of Section 87.

#### 14.02.04

# Compulsory licence for export of patented pharmaceutical products in certain exceptional circumstances

a. Compulsory licence shall be available for manufacture and export of patented pharmaceutical product to any country having insufficient or no manufacturing capacity in the pharmaceutical sector for the concerned product to address public health problems, provided compulsory licence has been granted by such country or such country has, by notification or otherwise, allowed importation of the patented pharmaceutical products from India.

Section 92A

Form-17

- b. The Controller shall, on receipt of an application in the prescribed manner, grant a compulsory licence solely for manufacture and export of the concerned pharmaceutical product to such country under such terms and conditions as may be specified and published by him.
- c. The provisions of (a) and (b) shall be without prejudice to the extent to which pharmaceutical products produced under a compulsory licence can be exported under any other provision of this Act.
- d. 'Pharmaceutical products' means any patented product, or product manufactured through a patented process, of the pharmaceutical sector needed to address public health problems and shall be inclusive of ingredients necessary for their manufacture and diagnostic kits required for their use.

#### 14.02.05 Terminatio

#### **Termination of Compulsory License**

Section 94

- a. Patentee or any other person deriving title or interest in the patent, may make an application for termination of compulsory licence granted under Section 84 on the ground that the circumstances that gave rise to the grant thereof no longer exist and such circumstances are unlikely to recur.
- b. The holder of the compulsory licence shall have the right to object to such termination.
- c. While considering such an application, the Controller shall take into account that the interest of the person, who had previously been granted the licence, is not unduly prejudiced.

## **Chapter 15: Use of patent for purposes of Government**

15.02	Use of patent for the purpose of Government	Section 99
	An invention is said to be used for the purpose of	
	Government if it is made, used, exercised or vended for the	
	purposes of Central Government, a State Government or a	
	Government undertaking.	
15.02	Power of Central Government to use inventions	Section 100
	a. Where an invention has, before the priority date of the	
	relevant claim of the complete specification, been duly	
	recorded in a document, or tested or tried, by or on behalf	
	of the government or a government undertaking, otherwise	
	than in consequence of the communication of the invention	
	directly or indirectly, by the patentee or by a person from	
	whom he derives title, any use of the invention by the	
	Central Government or any person authorized in writing by	
	it for the purposes of government may be made free of any	
	royalty or other remuneration to the patentee.	
	b. If and so far as the invention has not been so recorded or	
	tried or tested as aforesaid, any use of the invention made	
	by the Central Government of any person authorized by it as	
	above said, at any time after grant of the patent or in	
	consequence of any such communication as aforesaid,	
	shall be made upon terms as may be agreed upon either	
	before or after the use, between the Central Government or	
	any person authorised by Central Government and the	
	patentee, or, as may in default of agreement be determined	
	by the High Court on a reference under Section 103.	
	In case of any such use of any patent, the patentee shall be	
	paid not more than adequate remuneration in the	
	circumstances of each case, taking into account the	
	economic value of the use of the patent.	

- c. The authorisation by the Central Government in respect of an invention may be given either before or after the patent is granted and either before or after the acts in respect of which such authorisation is given or done, and may be given to any person, whether or not he is authorised directly or indirectly by the applicant or the patentee to make, use, exercise or vend the invention or import the machine, apparatus or other article or medicine or drug covered by such patent.
- d. Where an invention has been used by or with the authority of the Central Government for the purposes of government then except in case of national emergency or other circumstances of extreme urgency or for noncommercial use, the government shall notify the patentee as soon as practicable of the fact and furnish him with such information as to the extent of the use of the invention as he may, from time to time, reasonably require. Where the invention has been used for the purposes of a government undertaking, the Central Government may call for such information as may be necessary for this purpose from such undertaking.
- e. The right to make, use, exercise and vend an invention for the purposes of government shall include the right to sell on non- commercial basis, the goods which have been made in exercise of that right, and a purchaser of goods so sold, and a person claiming through him, shall have the power to deal with the goods as if the Central Government or the person authorised by the Central Government were the patentee of the invention.
- f. Where in respect of a patent which has been the subject of an authorisation, there is an exclusive licensee or where such patent has been assigned to the patentee in consideration of royalties or other benefits determined by

reference to the use of the invention (including payments by way of minimum royalty), the notice shall also be given to such exclusive licensee or assignor, as the case may be, and the reference to the patentee shall be deemed to include a reference to such assignor or exclusive licensee.

#### 15.03 Rights of third parties

Section 101

- a. In relation to any use of a patented invention, or an invention in respect of which an application for a patent is pending, made for the purposes of government
  - i. by the Central Government or any person authorised by the Central Government under section 100; or
  - ii. by the patentee or applicant for the patent to the order made by the Central Government,

the provisions of any licence, assignment or agreement granted or made, between the patentee or applicant for the patent (or any person who derives title from him or from whom he derives title) and any person other than the Central Government shall be of no effect so far as those provisions—

- i. restrict or regulate the use for the purposes of government of the invention, or of any model, document or information relating thereto, or
- ii. provide for the making of payments in respect of any use of the invention or of the model, document or information relating thereto for the purposes of government,

and the reproduction or publication of any model or document in connection with the said use for the purposes of government shall not been deemed to be an infringement of any copyright subsisting in the model or document.

- b. Where the patent, or the right to apply for or obtain the patent, has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention then, in relation to any use of the invention made for the purposes of government by the patentee to the order of the Central Government, subsection (3) of section 100 shall have effect as if that use were made by virtue of an authority given under that section, and any use of the invention for the purposes of government by virtue of sub-section (3) of that section shall have effect as if the reference to the patentee included a reference to the assignor of the patent, and any sum payable by virtue of that sub-section shall be divided between the patentee and the assignor in such proportion as may be agreed upon between them or as may in default of agreement be determined by the High Court on a reference under Section 103.
- c. Where by virtue of sub-section (3) of section 100, payments are required to be made by the Central Government or persons authorised under sub-section (1) of that section in respect of the use of an invention for the purposes of government, and where in respect of such patent there is an exclusive licensee authorised under his licence to use the invention for the purposes of government, such sum shall be shared by the patentee and such licensee in such proportions, if any, as may be agreed upon between them or as may in default of agreement be determined by the High Court on a reference under section 103 to be just, having regard to any expenditure incurred by the licensee
  - i. in developing the said invention; or
  - ii. in making payments to the patentees other than royalties or other benefits determined by reference

	to the use of the invention in consideration of the	
	licence.	
15.04	Acquisition of inventions	Section 102
	a. The Central Government may, if satisfied that it is	
	necessary that an invention which is the subject of an	
	application for a patent or a patent should be acquired from	
	the applicant or the patentee for a public purpose, publish a	
	notification to that effect in the Official Gazette, and	
	thereupon the invention or patent and all rights in respect	
	of the invention or patent shall, by force of this section,	
	stand transferred to and be vested in the Central	
	Government.	
	b. Notice of the acquisition shall be given to the applicant,	
	and, where a patent has been granted, to the patentee and	
	other persons, if any, appearing in the register as having an	
	interest in the patent.	
	c. The Central Government shall pay to the applicant, or as	
	the case may be, the patentee and other persons appearing	
	on the register as having an interest in the patent such	
	other compensation as may be agreed upon between the	
	Central Government and the applicant or the patentee	
	and other persons; or, as may, in default of agreement, be	
	determined by the High Court on a reference under section	
	103 to be just having regard to the expenditure incurred in	
	connection with the invention and, in the case of a patent,	
	the term thereof, the period during which and the manner	
	in which it has already been worked (including the profits	
	made during such period by the patentee or by his licensee	
	whether exclusive or otherwise) and other relevant factors.	
15.05	Reference of disputes to High Court	Section 103
	a. Any dispute as to the exercise by the Central	
	Government or a person authorised by it of the powers	

conferred by section 100, or as to terms for the use of an invention for the purposes of government thereunder or as to the right of any person to receive any part of a payment made in pursuance of sub-section (3) of that section or as to the amount of compensation payable for the acquisition of an invention or a patent under section 102, may be referred to the High Court by either party to the dispute in such manner as may be prescribed by the rules of the High Court.

- b. In any proceedings under this section to which the Central Government is a party, the Central Government may—
- i. if the patentee is a party to the proceedings, petition by way of counter-claim for revocation of the patent on any ground upon which a patent may be revoked under section 64; and
- ii. whether a patentee is or is not a party to the proceedings, put in issue the validity of the patent without petitioning for its revocation.
- c. If in such proceedings as aforesaid any question arises whether an invention has been recorded, tested or tried as is mentioned in section 100, and the disclosure of any document regarding the invention, or of any evidence of the test or trial thereof, would, in the opinion of the Central Government, be prejudicial to the public interest, the disclosure may be made confidentially to the advocate of the other party or to an independent expert mutually agreed upon.
- d. In determining under this section any dispute between the Central Government and any person as to terms for the use of an invention for the purposes of government, the High Court shall have regard to any benefit

or compensation which that person or any person from whom he derives title, may have received, or may be entitled to receive, directly or indirectly in respect of the use of the invention in question for the purposes of government.

- e. In any proceedings under this section, the High Court may at any time order the whole proceedings or any question or issue of fact arising therein to be referred to an official referee, commissioner or an arbitrator on such terms as the High Court may direct, and references to the High Court in the foregoing provisions of this section shall be construed accordingly.
- f. Where the invention claimed in a patent was made by a person who at time it was made was in the service of the Central Government or of a State Government or was an employee of a government undertaking and the subjectmatter of the invention is certified by the relevant government or the principal officer of the government undertaking to be connected with the work done in the course of the normal duties of the government servant or employee of the government undertaking, then. notwithstanding anything contained in this section, any dispute of the nature referred to in sub-section (1) relating to the invention shall be disposed of by the Central Government conformably to the provisions of this section so far as may be applicable, but before doing so the Central Government shall give an opportunity to the patentee and such other parties as it considers have an interest in the matter to be heard.

#### **Chapter 16: Patent Agents**

#### 16.01 Patent Agents

a. A patent application can be filed and prosecuted by an Applicant himself or through a registered Indian patent agent. The Register of Patent Agents containing the names and addresses of all the registered patent agents is available at: www.ipindia.nic.in

Section 126, 127

Rule 108.

109

- The Patents Act read with the Patents Rules prescribe the qualifications and the eligibility for becoming a patent agent. In order to get registered as a patent agent one has to pass an examination conducted by the Controller General of Patents annually. The notification concerning the published in the official website examination www.ipindia.nic.in and also in at least one prominent newspaper.
- c. In order to apply for registration as a patent agent, one has to be a citizen of India, above the age of 21, and should have a Bachelor's degree in Science or Engineering from a recognized Indian University or possesses such other equivalent qualifications as the Central Government may specify in this behalf.
- d. All matters relating to registration and subsequent procedures are dealt with in the Office of The Controller General of Patents, Designs and Trademarks, Mumbai.

Particulars to be contained in the register of patent agents

(1) The register of patent agents maintained under section 125 shall contain the name, nationality, address of the principal place of business, addresses of branch offices, if any, the qualifications, the date of registration of every registered patent agent and the details of their renewal of registration

and any other particulars so specified by the Controller.

- (2) Where the register of patent agents is in computer floppies, diskettes or any other electronic form, it shall be maintained and accessed only by the person who is duly authorised by the Controller and no entry or alteration of any entry or rectification of any entry in the said register shall be made by any person who is not so authorised by the Controller.
- (3) (i) Copies of register of patent agents shall be maintained in each of the branch offices;
- (ii) The register of patent agents shall also contain specimen signatures and photographs of the persons registered as patent agents.

Application for registration of patent agents

- (1) Every person who desires to be registered as a patent agent shall make an application in Form 22.
- (2) The applicant shall furnish such other information as may be required by the Controller.
- (3) A person desirous to appear in the qualifying examination under rule 110 shall make a request to the Controller along with the fee specified in the First Schedule after announcement of such examination and within the period as may be specified in the announcement.

#### 16.02 Disqualifications for registration as a patent agent

**Rule 114** 

- A person shall not be eligible to be registered as a patent agent, if he
  - a. has been adjudged by a competent court to be of unsound mind;
  - b. is an undischarged insolvent;
  - c. being a discharged insolvent, has not obtained from the court a certificate to the effect that his insolvency

	was caused by misfortune without any misconduct on	
	his part;	
	d. has been convicted by a competent court, whether	
	within or outside India of an offence to undergo a term	
	of imprisonment, unless the offence of which he has	
	been convicted has been pardoned or unless on an	
	application made by him, the Central Government has,	
	by order in this behalf, removed the disability;	
	e. being a legal practitioner has been guilty of professional	
	misconduct; or	
	f. being a chartered accountant, has been guilty of	
	negligence or misconduct.	
16.03	Rights of patent agents	Section 127
	A patent agent 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 proceedings before the Controller	
	under this Act.	
16.04	Subscription and verification of certain documents by a	Section 128
	Patent Agent	
	All applications and communications to the Controller under	
	this Act may be signed by a patent agent authorized in	
	writing in this behalf by the person concerned.	
16.05	Restrictions on Practice as Patent Agents	Section 129
	Only a person registered as a patent agent is authorized to	
	practice. In the case of a partnership, the firm may be	
	described or held out as Patent Agent, only if all of the	
	partners of the Firm are registered as patent agents. No	
	company or other body corporate shall practice, describe	
	itself or hold itself out as Patent Agents or permit itself to be	
1		

	so described or held out. Each person in the associate group	
	if any constituted should be a registered Agent and duly	
	authorized by the concerned person on behalf they act.	
16.06	Power of Controller to refuse to deal with certain agents	Section 131
	The Controller may refuse to recognize as agent in respect of	
	any business under this Act:	
	a. any individual whose name has been removed from, and	
	not restored to, the register;	
	b. any person who has been convicted of an offence under section 123;	
	c. any person, not being registered as a patent agent, who in	
	the opinion of the Controller is engaged wholly or mainly in	
	acting as agent in applying for patents in India or elsewhere	
	in the name or for the benefit of the person by whom he is employed;	
	d. any company or firm, if any person whom the Controller	
	could refuse to recognize as agent in respect of any business	
	under this Act, is acting as a director or manager of the	
	company or is a partner in the firm.	
	e. any person who neither resides nor has a place of	
	business in India.	
16.07	Power of Controller to remove the name of a Patent	Section 130.
	Agent	Rule 116.
	Removal of a name from the register of patent agents	
	(1) The Controller may delete from the register of patent	
	agents, the name of any patent agent-	
	(a) from whom a request has been received to that	
	effect; or	
	(b) when he is dead; or	
	(c) when the Controller has removed the name of a	
	person under sub-section (1) of section 130; or	

- (d) if he has defaulted in the payment of fees specified in rule 115, by more than three months after they are due; or
  - (e) if he ceases to be a citizen of India:

Provided that except under clause (a) and (b), before removing the name of any person from the register of patent agents under this rule, such person shall be given a reasonable opportunity of being heard.

- (2) The removal of the name of any person from the register of patent agents shall be published and shall be, where relevant forthwith communicated to the person concerned.
- a. The name of any person from the Register can be removed if the Controller is satisfied that: –
- i. his/her name has been entered in the Register by error on account of misrepresentation or suppression of material fact; or
- ii. he/she has been convicted of any offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity which in the opinion of the Controller renders him unfit to be kept in the register.
- b. The Controller shall take such decision after giving that person a reasonable opportunity of being heard and after any further inquiry, as he thinks fit to make.
- d. The decision of the removal of the name of any person from the Register of Patent Agents shall be published and will be communicated to the person concerned.

#### 16.08 Restoration of names of Patent Agents

**Rule 117** 

- a. Restoration of names of persons removed from the register of Patent Agents can be made by the Controller, on Application made in form 23 within two months from the date of such removal.
- b. The restoration of name to the register shall be published on official website and communicated to the person concerned.

Form-23

		1
	c. If the name of a person is entered in the register of	
	Patents Agents, his name shall be continued	
	therein for a period of one year from the date on	
	which his last annual fee became due.	
16.09	Alteration of names of Patent Agents	Section 125
	(1) A patent agent may apply for the alteration of his name,	
	address of the principal place of business and branch offices,	
	if any, or the qualifications entered in the register of patent	
	agents, e-mail address, telephone number, fax number or any	
	other particulars under sub-section (1) of section 125. On	
	receipt of such application and the fee specified therefor in	
	the First Schedule for such request for alteration of	
	particulars, the Controller shall cause the necessary	
	alterations to be made in the register of patent agents.	
	(2) Every alteration made in the register of patent agents	
	shall be published.	
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## **Chapter 17: Offences and Penalties**

17.01	Contravention of S.35 or 39	Section 118
	If any person fails to comply with any direction given under	
	section 35 or makes or causes to be made an application for	
	the grant of a patent in contravention of section 39, he shall	
	be punishable with imprisonment for a term which may	
	extend to two years, or with fine, or with both.	
17.02	Falsification of entries in register, etc.	Section 119
	If any person makes, a false entry in any register kept under	
	the Patents Act or provides any writing or evidence as a	
	result of which the entry in the register results into a false	
	entry, knowing the entry or writing to be false, then he is	
	punishable with imprisonment for a term that may extend to	
	two years or with fine or with both.	
17.03	Unauthorized Claim of Patent Rights	Section 120
	If any person falsely represents that any article sold by him is	
	patented in India or is the subject of an Application for a	
	Patent in India, he shall be punishable with fine that may	
	extend to rupees one lakh.	
17.04	Wrongful use of words, "Patent Office"	Section 121
	If any person uses on his place of business or any document	
	issued by him which would reasonably lead to the belief that	
	either his place of business is the Patent Office or is officially	
	connected with the Patent Office, he shall be punishable with	
	imprisonment for a term that may extend to 6 months, or	
	with fine, or with both.	
17.05	Refusal or failure to supply information	Section 122
	If any person refuses or fails to furnish information as	Form-27
	required under Sections 100(5) and 146, he shall be	
	punishable with fine which may go up to rupees ten lakh (one	
	million). Section 100(5) provides that any person including	
	Government undertaking using a patented invention for the	

	purpose of Government has to furnish any information on the	
	use of invention as required by the Central Government and	
	Section 146 provides that the patentee has to furnish a	
	statement regarding the working of the patented invention	
	in a commercial scale in India in Form 27. This has to be done	
	annually within 3 months of the end of each calendar year for	
	that calendar year. If he furnishes false information	
	knowingly he shall be punishable with imprisonment that	
	may extend to 6 months or with fine or with both.	
17.06	Practice by non-registered persons	Section 123
	Any person practicing as a Patent Agent without registering	
	himself as such is liable to be punished with a fine of rupees	
	one lakh for the first offence and rupees five lakh for	
	subsequent offence.	
17.07	Offences by Companies	Section 124
	a. When an offence is committed by a company, the company	
	as well as every person in charge of, and responsible to the	
	company for the conduct of its business at the time of the	
	commission of the offence, shall be deemed to be guilty and	
	shall be liable to be proceeded against and punished	
	accordingly.	
	However, if such person proves that the offence was	
	committed without his knowledge or that he exercised all	
	due diligence to prevent the commission of the office, he shall	
	not be liable.	
	b. Notwithstanding anything contained above, where an	
	offence under this Act has been committed by a company and	
	it is proved that the offence has been committed with the	
	consent, connivance or that the commission of the offence is	
	attributable to any neglect on the part of any director,	
	manager, secretary or other office of the company, such	
	director, manager, secretary or other officer shall also be	
	deemed to be guilty of that offence.	

## **Chapter 18: General Powers of Controller**

18.01	Powers of a Civil Court	Section 77
18.01	Powers of a Civil Court  Subject to any rules made in this behalf, the Controller in any proceedings before him under this Act, have the powers of a Civil Court while trying a suit under the Code of Civil Procedure, 1908 (Act No. 5 of 1908) in respect of the following matters, namely: —  a. Summoning and enforcing the attendance of any person and examining him on oath;  b. Requiring the discovery and production of any document;  c. Receiving evidence on affidavits;	Section 77 Rule 136 Order XLVII of CPC, 1908.
	<ul> <li>d. Issuing commissions for the examination of witnesses of documents;</li> <li>e. Awarding costs;</li> <li>f. Reviewing his own decision on application made within the prescribed time and in the prescribed manner;</li> <li>g. Setting aside an order passed ex-parte on application made within the prescribed time and in the prescribed manner;</li> <li>h. Any other matter which may be prescribed.</li> </ul>	
18.02	<ul> <li>a. Any order for costs awarded by the Controller in exercise of the powers conferred upon him is executable as a decree of a civil court. In all proceedings before the Controller, costs may be awarded by the Controller, as he considers reasonable, having regard to all the circumstances of the case.</li> <li>b. However, the amount of costs awarded in respect of any matter set forth in the Fourth Schedule shall not exceed the amount specified therein.</li> <li>c. Notwithstanding anything contained in (a) above, the</li> </ul>	Section 77(1)(e) Rule 63, 136

	Controller may, in his discretion, award a compensatory cost	
	in any proceeding before him which in his opinion is false or	
	vexatious.	
18.03	Review	Section
	a. Any person considering himself aggrieved by any order or	77(1)(f).
	decree of the Controller from which an appeal is allowed but	Rule 130.
	no appeal has been preferred, or from which no appeal is	Form-4, 24.
	allowed, and who, from the discovery of new and important	Section 114
	matter or evidence which, after the exercise of due diligence	& Order
	was not within his knowledge or could not be produced by	XLVII of
	him at the time when the order or decree was passed or	CPC, 1908.
	order made, or on account of some mistake or error apparent	
	on the face of the record or for any other sufficient	
	reason, desires to obtain a review of the decree passed or	
	order made against him, may apply for a review of the order	
	or decree to the Controller.	
	b. An application to the Controller for the review of his	
	decision under clause (f) of sub-section (1) of section 77 shall	
	be made within one month from the date of communication	
	of such decision to the applicant or within such further	
	period not exceeding one month thereafter as the Controller	
	may on a request allow.	
	c. An application for review shall be accompanied by a	
	statement setting forth the grounds on which the review is	
	sought.	
	d. Where the decision in question concerns any other	
	person in addition to the applicant, the Controller shall	
	forthwith transmit a copy of each of the application and the statement to the other person concerned.	
	-	
	e. An application to the Controller for setting aside an order	
	passed by him ex-parte under clause (g) of sub-section (1) of	
	section 77 shall be made within one month from the date of	

	communication of such order to the applicant or within such	
	further period not exceeding one month as the Controller	
	may on a request allow and shall be accompanied by a	
	statement setting forth the grounds on which the application	
	is based. Where the order concerns any other person in	
	addition to the applicant, the Controller shall, forthwith	
	transmit a copy each of the application and the statement to	
	the other person concerned.	
18.04	Petition for Obviating an Irregularity	Rule 137.
	Any document for the amendment of which no special	Nippon
	provision is made in the Act may be amended and any	Steel
	irregularity in procedure, which in the opinion of the	Corporation
	Controller may be obviated without detriment to the	Vs. Union of
	interests of any person, may be corrected if the Controller	India
	thinks fit and upon such terms as he may direct.	
	While considering a petition under Rule 137, only such an	
	irregularity is allowed to be obviated which is without	
	detriment to the interests of any person. Further, only such	
	amendments for which there is no special provision in the	
	Act and which may be made without detriment to the	
	interests of any person are allowable. Generally, a failure to	
	Act within prescribed time shall not be considered as an	
	irregularity which can be obviated under this Rule, as the	
	Patents Act and Rules clearly mentions, wherever extensions	
	are allowed.	
18.05	Mention of Inventor in Patent	Section 28.
	If the controller is satisfied, upon a request or claim	Rule 57, 58,
	made in accordance with the provisions of this section —	59, 60,
	i) that the person in respect of or by whom the request or	61, 62, 63.
	claim is made is the inventor of an invention in respect of	Form 8.
	which application for a patent has been made, or of a	
<u> </u>		

substantial part of that invention; and

- ii) that the application for the patent is a direct consequence of his being the inventor, the Controller shall, subject to the provisions of this section, cause him to be mentioned as inventor in any patent granted in pursuance of the application in the complete specification and in the register of patents:
- a. Such a request or claim shall be accompanied by a statement setting out the circumstances under which the claim is made.
- b. However, the mention of any person as inventor under this section shall not confer or derogate from any rights under the patent.
- c. A request that any person shall be mentioned as aforesaid may be made in the prescribed manner by the applicant for the patent or (where the person alleged to be the inventor is not the applicant or one of the applicants) by the applicant and that person.
- d. If any person [other than a person in respect of whom a request in relation to the application in question has been made under sub- section (2)] desires to be mentioned as aforesaid, he may make a claim in the prescribed manner in that behalf.
- e. A request or claim under the foregoing provisions of this section shall be made before the grant of patent.
- f. Where such a claim is made, the Controller shall give notice of the claim to every applicant for the patent (not being the claimant) and to any other person whom the Controller may consider to be interested and before deciding upon any such request or claim, the Controller shall, if required, hear the person in respect of or by whom the request or claim is made, and also any person to whom notice of the claim has

been given as aforesaid.

- g. Where any person has been mentioned as inventor in pursuance of such an application, any other person who alleges that he ought not to have been so mentioned may at any time apply to the Controller for a certificate to that effect, and the Controller may, after hearing, if required, any person whom he may consider to be interested, issue such a certificate, and if he does so, he shall rectify the specification and the register accordingly.
- h. The procedure specified in rules 55A and 57 to 63 relating to the filing of notice of opposition, written statement, reply statement, leaving evidence, hearing and cost shall, so far as may be, apply to the hearing of such a claim or application as they apply to the opposition proceedings subject to the modification that reference to patentee shall be construed as the person making the claim, or an application, as the case may be.
- i. Any mention of the inventor under sub-section (1) of section 28 shall be made in the relevant documents in the following form namely:-
- -The inventor of this invention/substantial part of this invention within the meaning of section 28 of the Patents Act, 1970, is...of....

#### 18.06 Directions Not Otherwise Prescribed

a. Where for the proper prosecution or completion of any proceedings under the Act or these rules, the Controller is of the opinion that it is necessary for a party to such proceedings to perform an Act, file a document or produce evidence, for which provision has not been made in the Act or

these rules, he may, by notice in writing, require such party to perform the Act, file the document or produce the evidence

**Rule 128** 

	specified in such notice.	
	b. Where an applicant or a party to a proceeding desires to	
	be heard or not heard, the Controller may, at any time,	
	require him to submit his statement in writing giving such	
	information as the Controller may deem necessary within the	
	time specified by him.	
18.07	Exercise of Discretionary Power by the Controller	Section 80.
	a. Before acting adverse to any party, the Controller shall	Rule 129,
	give an opportunity of being heard to the party. The	129A.
	discretionary powers shall be exercised with due care and	
	caution and not in an arbitrary manner. Such reasons shall	
	be taken judiciously and the reasons shall be recorded in the	
	file. However, this will not apply to actions resulting from	
	provisions in the Act and Rules.	
	b. A party desiring a hearing shall make the request for such	
	hearing to the Controller at least ten days in advance of the	
	expiry of the time-limit specified in respect of the proceeding.	
	c. Before exercising any discretionary power under the Act	
	or these rules which is likely to affect an applicant for a	
	patent or a party to a proceeding adversely, the Controller	
	shall give such applicant or party, a hearing, after giving him	
	or them, ten days' notice of such hearing ordinarily.	
	d. An applicant for patent or a party to a proceeding may	
	make a request for adjournment of the hearing with	
	reasonable cause along with the prescribed fee prescribed in	
	First Schedule, at least three days before the date of hearing.	
	e. The Controller, if he thinks fit to do so, and upon such	
	terms as he may direct, may adjourn the hearing not more	
	than twice and intimate the parties accordingly. Each	
	adjournment shall not be for more than thirty days.	
18.08	Power of Controller to Correct Clerical Errors, etc.	Section 78.
	<u>L</u>	

Rule 122.

- a. Without prejudice to the provisions contained in sections 57 and 59 as regards amendment of applications for patents or complete specifications or other documents relating thereto and subject to the provisions of section 44, the Controller may, in accordance with the provisions of this section, correct any clerical error in any patent or in any specification or other document filed in pursuance of such application or in any application for a patent or any clerical error in any matter which is entered in the register.
- b. A correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.
- c. Where the Controller proposes to make any such correction as aforesaid otherwise than in pursuance of a request, he shall give notice of the proposal to the patentee or the applicant for the patent, as the case may be, and to any other person who appears to him to be concerned, and shall give them an opportunity to be heard before making the correction.
- d. Where a request is made for the correction of any error in a patent or application for a patent or any document filed in pursuance of such an application, and it appears to the Controller that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons affected thereby, he shall require notice of the nature of the proposed correction to be published in the official journal.
- e. Such a request for the correction of a clerical error in any document shall be accompanied by a copy of the document highlighting the corrections clearly along with the prescribed fees.

- f. Within the prescribed time after any such publication as aforesaid any person interested may give notice to the Controller of opposition to the request, and, where such notice of opposition is given, the Controller shall give notice thereof to the person by whom the request was made, and shall give to him and to the opponent an opportunity to be heard before he decides the case.
- g. The procedure specified in rules 58 to 63 relating to the filing of reply statement, leaving evidence, hearing and costs shall, so far as may be, will be applicable to the above proceedings.

#### 18.09 Ex-parte decision

Before proceeding ex-parte against any party, the Controller shall issue a notice to the concerned party clearly stating therein that if the party fails to attend the hearing so fixed, he shall be proceeded ex- parte. Such notice shall be sent by Registered Post with acknowledgment due.

## **Chapter 19: General Services**

19.01	General Services	
	<ul><li>a. Patent Office provides certain statutory and non-statutory services for the dissemination of information related to patent processing.</li><li>b. It may be noted that references to some of these</li></ul>	
	services have already been made in the relevant	
	Chapters.	
	c. These services are enumerated in the following paragraphs as per standards set by the Patent Office.	
19.02	Official Journal	Section 145
	a. Every Friday the Controller publishes the Official	
	Patent Journal electronically, which is made available on	
	the official website of the Patent Office.	
	b. The journal contains the following information:	
	<ul> <li>i. Section 11A publication, including early publication. ii. Withdrawal of Patent Applications.</li> </ul>	
	iii. Cessation of Patents.	
	iv. Restoration of lapsed Patents.	
	v. Post-Grant amendments.	
	vi. Amendment of Patent granted to a deceased applicant.	
	vii. Assignment after grant.	
	viii. Post-Grant Oppositions.	
	ix. Working of Patents.	
	x. Revocation of Patents.	
	xi. Compulsory Licences.	
	xii. Rectification of Register by the Appellate Board.	
	xiii. Details of Government use.	

	xiv. General matters.			
	xv. Surrender of patents.			
	c. Publications under the Designs Act form the last part of			
	the Journal published.			
19.03	Information relating to Patent Applications and	Section 153.		
	Patents	Rule 134.		
	a. At the request of a person (on plain paper), the	Rule 134.		
	Controller provides the following information regarding a			
	Patent or an Application for a Patent. Separate requests			
	shall be made in respect of each item:			
	i. as to when a Complete Specification			
	following a Provisional Specification has been			
	filed or an Application for Patent is deemed to be			
	abandoned;			
	ii. as to when the information under Section 8 has been			
	filed;			
	iii. as to when Publication of Application has been made			
	under Section 11 A;			
	iv. as to when an Application has been			
	withdrawn under Section 11B;			
	v. as to when a request for examination has been			
	made under Section 11B;			
	vi. as to when the examination report has been			
	issued under Section 12;			
	vii. as to when an Application for Patent has been			
	refused;			
	viii. as to when a Patent has been granted; ix. as to when a renewal fee has been paid;			
	x. as to when the term of a Patent has expired or			
	shall expire;			
	xi. as to when an entry has been made in the			
	Register or Application has been made for the			
	making of such entry; or xii. as to when any			
	<u> </u>			

Application is made or action taken involving an entry in the Register, publication in the Official Journal or otherwise, if the nature of the Application or action is specified in the request.

- b. The report of the Examiner to the Controller under Section 12 is not open to public unless directed by a Court of Law.
- c. Except (b) above, most of the information relating to patents is available on the official website. However, the information available on the official website of the Patent Office would not be sufficient for legal proceedings, for which a person may take recourse to (a) above.

#### 19.04 Inspection and supply of copies of documents

- a. After the publication of application, the application along with the complete specification, provisional specification, drawing, if any, and the abstract may be inspected at the appropriate Patent Office.
- b. After the grant of a patent, the application along with the complete specification, provisional specification, drawing, if any, and abstract and related thereto may be inspected at the concerned Patent Office.
- c. Request for inspection may be made in plain paper along with the prescribed fee.
- d. A person may obtain copies of any document open to public upon payment of the prescribed fee.
- e. Certified copy (as may be required for legal proceedings) of any document open to public may be obtained upon payment of prescribed fee.
- f. Register of Patents may be inspected during the

Section 72, 147, 154. Rule 27, 74A, 132, 133.

	working hours of the Patent Office by making a			
	written application along with the prescribed fee.			
	g. Certified copies of any entry in the Register is available			
	upon the payment of prescribed fee.			
	h. Certified copies of any entry in the register, or			
	certificates of, or extracts from patents, specifications			
	and other public documents in the patent office, or			
	from registers and other records including records in			
	computer floppies, diskettes or any other electronic form kept there, may be furnished by the Controller on			
	a request therefor made to him and on payment of the			
	fee specified therefor in the First Schedule: Provided			
	that certified copies shall be issued in the order in			
	which the request is filed.			
	i. Certified copies shall be furnished within a period of			
	one week if such request is made along with the fee			
	specified therefore in the First Schedule.			
19.05	Annual report of the Patent Office	Section 155		
	The Patent Office publishes an annual report comprising			
	statistical information pertaining to the activities of Patent			
	Office. Such report is placed before both the Houses of			
	Parliament, whereupon the report is made available on the			
	official website.			
19.06	Information available at the Website			
	The official website provides the following information:			
	a. Indian Patent Advanced Search System (inPASS)			
	provides information on:			
	i. Granted Patents:			
	i. Granted Patents;			
	<ul><li>i. Granted Patents;</li><li>ii. Published Patent Applications; E-Register</li><li>iii. Application/Documents Details</li></ul>			

vi. Patent Application status.

In addition, the following information is also available:

- News & Events/ Circulars by the Controller General
- Manuals/ Guidelines
- Act & Rules. e-version
- Controller's decisions d.
- e- Journals
- Dynamic utilities
- List of registered Patent Agents.
- Mobile App. A mobile App named "Intellectual Property India" has been developed and link is available on website for both android and iOS versions. Android version could also be downloaded from Google play store.
- A link for video conferencing on website.
- h. Feedback system

## **Chapter 20: Scientific Advisors**

20.01	Scientific Advisors	Section 115
	a. In any suit for infringement or in any proceeding before a	
	Court under this Act, the Court may at any time, suo- moto or	
	on an application made by a party, appoint an independent	
	Scientific Advisor to assist the Court or to inquire and report	
	upon any such questions of fact or of opinion (not involving a	
	question of interpretation of law) as it may formulate for the	
	purpose.	
	b. The remuneration of the Scientific Advisor shall be fixed	
	by the Court and shall include the cost of preparing/making a	
	report and appropriate fee for Scientific Advisor for any day	
	on which he/she may be required to attend the hearing of the	
	Court, and such remuneration shall be defrayed out of funds	
	provided by the Parliament under law for such purpose.	
20.02	Roll of Scientific Advisors	Rule 103,
	(1) The Controller shall maintain a roll of scientific	103A
	advisers for the purpose of section 115. The roll shall be	
	updated annually. The roll shall contain the names,	
	addresses, specimen signatures and photographs of scientific	
	advisers, their designations, information regarding their	
	educational qualifications, the disciplines of their	
	specialisation and their technical, practical and research	
	experience.	
	(2) A person shall be qualified to have his name entered in	
	the roll of scientific advisers, if he-	
	(i) holds a degree in science, engineering or technology or	
	equivalent;	
	(ii) has at least fifteen years' technical, practical or research	

experience; and

(iii) he holds or has held a responsible post in a scientific or technical department of the Central or State Government or in any organisation.

The Controller maintains a panel/list of scientific advisors for the purpose of Section 115. The panel/list is updated annually. The panel/list contains the names, addresses, specimen signatures and photographs of scientific advisors, their designations, information regarding their educational qualifications, the disciplines of their specialisation and their technical, practical and research experience. The panel/list is also accessible / made available on the official website of the Patent Office at url: www.ipindia.nic.in

(3). Disqualifications for inclusion in the roll of scientific advisers

A person shall not be eligible to be included in the roll of scientific advisors, if he

- (i)has been adjudged by a competent court to be of unsound mind;
- (ii) is an undischarged insolvent;
- (iii) being a discharged insolvent, has not obtained from the court a certificate to the effect that his insolvency was caused by misfortune without any misconduct on his part;
- (iv) has been convicted by a competent court, whether within or outside India of an offence to undergo a term of imprisonment, unless the offence of which he has been convicted has been pardoned or unless on an application made by him, the Central Government has, by order in this behalf, removed the disability; or
- (v) has been guilty of professional misconduct.

20.03	Qualifications and procedure for empanelment /	Rule 103,				
	enrollment	104,105,				
	a. Any person who-	106				
	i. holds a degree in science, engineering, technology or					
	equivalent;					
	ii. has at least fifteen years' practical or research experience; and					
	iii. holds or has held a responsible post in a scientific or technical department of the Central or State Government or in any other organization,					
	is qualified to have his/her name entered in the panel/list/roll of scientific advisors. However, where the Controller is of the opinion that it is necessary or expedient to do so, he may, by order, for reasons to be recorded in					
	writing, relax any of the qualifications specified above, with respect to any person, if such person is otherwise well qualified.					
	b. Any person interested may apply at any time to the Controller for inclusion of his/her name in the roll of scientific advisors by furnishing his/her bio-data.					
	c. The list/roll is updated and published annually.					
20.04	Removal from the roll/panel of Scientific Advisor	Rule 107				
	a. The Controller may remove the name of any person from the roll of scientific advisors, if—					
	i. such person makes a request for such removal; or					
	ii. the Controller is satisfied that his/her name has been entered in the roll by error or account of misrepresentation or suppression of any material fact; or					
	iii. such person has been convicted for an offence and sentenced to a term of imprisonment or has been guilty					

of misconduct in his professional capacity and the Controller is of the opinion that his/her name should be removed from the roll:

- b. Before removing the name of any person from the roll of scientific advisors under this rule, such person shall be given a reasonable opportunity of being heard.
- (c) such person has been convicted of an offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity and the Controller is of the opinion that his name should be removed from the roll; or
- (d) such person is dead: Provided that except in the cases falling under clause (a) and (d) above, before removing the name of any person from the roll of scientific advisers under this rule, such person shall be given a reasonable opportunity of being heard.

## **Chapter 21: Miscellaneous provisions**

21.01	Affidavits	Section 79.
	a. Notwithstanding anything to the contrary as and when directed by the Controller, in all proceedings before the Controller under this Act, evidence shall be given by way of an affidavit.	Rule 126.
	<ul> <li>b. In cases where the Controller deems it appropriate to do so, he may take oral evidence in lieu of, or in addition to, evidence by way of an affidavit, or may allow any party to be cross-examined on the contents stated in his/her affidavit.</li> <li>c. The affidavits required to be filed before the Controller of Patents under the Act or rules shall be duly sworn in the manner as prescribed under Clause (e) below.</li> <li>d. Affidavits shall be confined to such facts as the deponent is able, of his own knowledge, to prove except in interlocutory matters, where statements of belief of the deponent may be admitted, provided the grounds thereof are given.</li> </ul>	Diplomatic and Consular Officers (Oaths and Fees) Act, 1948.  Notifications u/s 14 of the Notaries Act,
	<ul> <li>e. Affidavits shall be sworn to as follows:</li> <li>i) In India - before any Court or person having by law authority to receive evidence, or before any officer empowered by such court as aforesaid to administer oaths or to take affidavits;</li> <li>ii) In any country or place outside India - before a diplomatic or consular officer, within the meaning of the Diplomatic and Consular Officers (Oaths and Fees) Act, 1948 (41 of1948); in such country or place or before a notary public of the country or place, recognised by the Central Government under section 14 of the Notaries Act, 1952 (53 of 1952);</li> </ul>	1952.

or before a Judge or Magistrate of the country or place.	
f. Alterations and interlineations shall, before an Affidavit is sworn to or affirmed to be authenticated by the initials of the person before whom the Affidavit is sworn to.	
Exhibits	Rule 127
Where there are exhibits to be filed in an opposition matter or any other proceeding, a copy or impression of each exhibit shall be supplied to the other party at his request and expense; if copies or impressions of the exhibits cannot conveniently be furnished, the originals shall be left with the Controller for inspection by the person interested by prior appointment. The exhibits in original, if not already left with Controller, shall be produced at the hearing.	
Officers and employees of Patent Office – Duties  An officer or employee of the Patent Office shall not, except when required or authorised by this Act or under a direction in writing of the Central Government or Appellate Board or the Controller or by order of a Court—  a. furnish information on a matter which is being, or has been, dealt with under this Act; or  b. prepare to assist in the preparation of a document required or permitted by or under this Act to be lodged in the Patent Office; or  c. conduct a search in the records of the Patent Office.	Section 76
Hearing to be in public  Where the hearing is held before the Controller in respect of	Rule 139
	f. Alterations and interlineations shall, before an Affidavit is sworn to or affirmed to be authenticated by the initials of the person before whom the Affidavit is sworn to.  Exhibits  Where there are exhibits to be filed in an opposition matter or any other proceeding, a copy or impression of each exhibit shall be supplied to the other party at his request and expense; if copies or impressions of the exhibits cannot conveniently be furnished, the originals shall be left with the Controller for inspection by the person interested by prior appointment. The exhibits in original, if not already left with Controller, shall be produced at the hearing.  Officers and employees of Patent Office – Duties  An officer or employee of the Patent Office shall not, except when required or authorised by this Act or under a direction in writing of the Central Government or Appellate Board or the Controller or by order of a Court—  a. furnish information on a matter which is being, or has been, dealt with under this Act; or  b. prepare to assist in the preparation of a document required or permitted by or under this Act to be lodged in the Patent Office; or  c. conduct a search in the records of the Patent Office.  Hearing to be in public

complete specification, the hearing of the dispute shall be in public unless the Controller, after consultation with the parties to the dispute who appear in person or are represented at the hearing, otherwise directs. 21.05 **Agency - Power of Attorney** Rule 135. a. Authorisation of an agent for the purposes of the Act and Form-26. the rules shall be made in Form 26 or in the form of a Power of Attorney within a period of 3 months from the date of filing of such application or document, failing which no action shall be taken on such application or documents for further processing, till such deficiency is removed. b. Where any such authorisation has been made, service upon the agent of any document relating to the proceeding or matter under the Act or the rules shall be deemed to be the service upon the person so authorising and all communications directed to be made to a person in respect of the proceeding or matter may be addressed to such agent, and all appearances before the Controller relating thereto may be made by or through such agent. c. If it is considered necessary, the office can require personal signature or presence of an applicant, the opponent or party to such proceeding or matter. d. As a matter of practice, an application may be accepted without a Power of Attorney, for the purpose of saving

priority. However, any subsequent papers can be filed only

after submitting the required Power of Authority. The Office

will not take any action if a Form-26 / authorisation

of agent is not present on the record.

## **Chapter 22: Time Limits**

22.01	Time limits	
	Time limits for various actions while prosecuting a	
	patent application and also for post grant procedures have been	
	either specifically provided in the Patents Act or prescribed	
	through the Patents Rules. These time limits are required to be	
	followed strictly by every person concerned. Failure to adhere to	
	the legally imposed time limits may turn out to be detrimental to	
	the interests of the applicants, patentees or any other person	
	interested.	
22.02	Petition for extension of time	Rule 138
22.02	retition for extension of time	Kule 130
	(1) Except for the time prescribed in clause (i) of sub-rule (4) of	
	rule 20, sub-rule (6) of rule 20, rule 21, sub-rules (1), (5) and (6)	
	of rule 24B, sub-rules (10) and (11) of rule 24C, sub-rule (4) of	
	rule 55, sub-rule (1A) of rule 80 and sub-rules (1) and (2) of rule	
	130, the time prescribed by these rules for doing of any act or	
	the taking of any proceeding thereunder may be extended by the	
	Controller for a period of one month, if he thinks it fit to do so	
	and upon such terms as he may direct.	
	(2) Any request for extension of time prescribed by these rules	
	for doing of any act or the taking of any proceeding thereunder	
	shall be made before the expiry of such time prescribed in these	
	rules.	

# ${\bf 22.03: Time\ limits\ prescribed\ by\ the\ Patents\ Act,\ 1970\ and\ Patents}$ ${\bf Rules,\ 2003}$

	Description	Time	Provision
1.	Proof of right to make an	Six months from the date of	Section 7(2)
	application	filling of application	Rule10
2.	Statement and undertaking	Six months from the date of	Section 8(1)
	regarding foreign	filing of application	Rule 12(1A)
	applications		
3.	Subsequent information	Six months from the date of	Section
	corresponding to foreign	filing of application outside	8(1)(a)
	filing	India	Rule 12(2)
4.	Information relating to	Six months from the date of	Section 8(2)
	objections in respect of	communication by Controller	Rule 12(3)
	novelty, patentability etc. in		
	foreign filing		
5.	Filing a complete	Twelve months from the date	Section 9(1)
	specification after filing	of filling of the Provisional	
	provisional specification	Specification	
6.	Declaration of Inventorship	With the complete	Rule 13(6)
	(Form 5)	specification or within one	
		month from the date of filing of	
		the complete specification	
7.	Reference to deposit of	Three months from the date	Section10
	biological material	of filing of application	(4)
			Rule 13(8)
8.	Convention application	Twelve months from the date	Section
		of filing of the basic	135(1)
- 0		application	0
9.	Convention application (in	Twelve months from the date	Section
	case of multiple priorities)	of filing of first filed basic	135(1)
10	Convention application	application  Twelve months from the date	Coation
10.	Convention application (cognate)		Section 135(2)
11.	, , ,	of earliest filed specification	, ,
11.	PCT national phase application	Thirty one months from the priority date	Rule 20(4)(i)
12.	Priority document (for	Three months from the date	Section
14.	convention application)	of communication from the	138(1)
	convention application;	Controller	Rule 121
13.	Publication of application	Ordinarily within one month	Rule 121
13.	i ubilication of application	from the expiry of eighteen	Kuic 24, 24A
		If one capity of eighteen	

	1		
		months from the date of filing or priority date, whichever is	
		earlier, or within one month	
		from the date of request for early	
		publication.	
14.	Withdrawal of application to	Fifteen months from date of	Sec
	prevent publication	filing or priority, whichever is	11A(3)(c)
		earlier	
	Request for withdrawal of	Any time before the grant of	Sec 11B(4),
	application	Patent	Rule 26
	Request for withdrawal and	In case withdrawal is requested	Rule 7(4A),
	refund of Fee	after filing the Request for	Rule 26
		examination but before issuance	
		of FER, then the fee is refunded as	
		prescribed in the First Schedule	
15.	Request for examination	Forty eight months from the	Section 11B
		date of filing or priority,	
		whichever is earlier	Rule 24B
16.	Request for examination,	Forty eight months from the	Rule
	where secrecy direction	date of filing or priority or	24B(1)(iii)
	imposed	within sixth months from the	
		date of revocation of secrecy	
		direction, whichever expires	
		later	
17.	Request for examination	Forty eight months from date	Rule
	(Divisional Application)	of filing or priority of first	24B(1)(iv)
		mentioned application, or	
		within six months from date of	
		filing of further application,	
		whichever expires later.	
18.	Time within which Examiner	Ordinarily within one month	Rule
	makes report to Controller	but not exceeding three months	24B(2)(ii)
		from the date of such reference	
19.	Controller disposes off the	Ordinarily within one month	Rule
	report of Examiner	from the date of receipt of	24B(2)(iii)
0.0	Di i Di i i i	report	D 1 045(0)
20.	First Examination Report	Within one month from the date	Rule 24B(3)
	(FER) sent by the Controller	of disposal of the report of	
0.4	to applicant	examiner by the Controller	0
21.	Time for complying with all	Six months from the date	Section
	requirements imposed by the	of issuance of the FER	21(1)
22	Act Fitters for	There are a the control of the	Rule 24B(5)
22	Extension Time for	Three months on a request in	Section

	complying with all	Form 4 if requested before expiry	21(1)
	requirements	of time prescribed under Rule	Rule 24B(6)
	requirements	24B(5)	Ruie 2 ID(0)
23.	Time, after publication,	Six months from the date of	Rule 55(1A)
23.	before	publication	Rule 33(1A)
	expiry of which no patent is	publication	
	granted		
24.	Pre-grant opposition	Any time before the grant of	Section
24.	l re-grant opposition	patent	25(1)
25.	Reply statement and	Three months from the date	Rule 55(4)
23.		of notice of the Controller	Kule 33(4)
	evidence (pre- grant	of notice of the Controller	
26.	opposition)	Oudinouily within one month	Dula FF(()
26.	Decision by Controller upon	Ordinarily within one month	Rule 55(6)
	pre- grant opposition	from completion of the	
27	Nation of Operation (see	proceedings	Cartina
27.	Notice of Opposition (post-	One year from the date of	Section
	grant	publication of grant of patent	25(2)
20	opposition)		D 1 50(4)
28.	Reply statement by patentee	Two months from receipt of	Rule 58(1)
20		opponent's written statement	2 1 70
29.	Reply evidence by opponent	One month from date of delivery	Rule 59
		of patentee's reply statement	D 1 = 664
30.	Opposition Board submits	Three months from the date on	Rule 56(4)
	report	which documents were forwarded	
		to the Board	
31.	Periodical review of secrecy	Every six months	Section
	directions		36(1)
32.	Controller disposes	Within a period of twenty-one	Section 39
	permission for filing abroad	days from the date of filing of	_
		such request	Rule 71
33.	Time after which no	Six weeks after filing the	Section
	permission is required for	application in India, where no	39(1)
	filing abroad	direction for secrecy in	
		present	
34.	Payment of first renewal	Three months from the date	Section
	fee, where patent has	of recordal in Register of	142(4)
	been granted after the	Patents	
	expiry of two years from		
	date of filing		
35.	Extension in time for	Extendable by maximum six	Section
	payment of renewal fee,	months	142(4)
	where patent has been		
	granted after expiry of two		

	years from date of filing		
36.	Time for payment of the	Before the expiry of the <b>nth</b>	Rule 80(1)
	renewal fee	year from date of patent in	
		respect of the (n+1) th year	
37.	Extension in time for	Maximum six months	Rule 80(1A)
	payment of renewal fee		
38.	Application for restoration of	Eighteen months from the	
	patent	date on which the Patent	
		ceased to have effect	Section 60
39.	Request for hearing by an	One month from date of	Rule 84(2)
	applicant for restoration,	intimation by the Controller	
	where prima facie case		
	has not been made out		
40.	Notice of Opposition against	Two months from the date of	Rule 85(1)
	restoration	publication of application for	
		restoration	
41.	Payment of the unpaid	One month from date of order	Rule 86(1)
	renewal fee and additional		
	fee when restoration		
	allowed		
42.	Notice of Opposition against	Three months from the date	Rule 87(2)
	an offer to surrender a	of publication of offer	
	patent		
43.	Notice of Opposition against	Three months from the date	Rule
	application for	of publication of such	81(3)(b)
	post-grant	application	
	amendment		
44.	Furnishing information	Three months from the end of	Section
	relating to working of patent	each calendar year	146(2),
	in respect of the calendar		Rule 131 (2)
	year		
45.	Furnishing information	Two months from the date of	Section
	relating to working of patent,	notice	146(1)
	upon notice of Controller		