

FREQUENTLY ASKED QUESTIONS: PATENT

Q: What are the criteria of patentability?

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

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

Q: What types of inventions are not patentable in India?

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

- 1) an invention which is frivolous or which claims anything obviously contrary to well established natural laws;
- 2) an invention the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human , animal or plant life or health or to the environment;
- 3) the mere discovery of scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature;
- 4) the mere discovery of a new form of a known substance which does not result in enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant;

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

- 5) a substance obtained by mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;
- 6) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;
- 7) a method of agriculture or horticulture;

- 8) any process for medicinal, surgical, curative, prophylactic (diagnostic, therapeutic) or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products;
- 9) plants and animals in whole or any part thereof other than microorganisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;
- 10) a mathematical or business method or a computer program per se or algorithms;
- 11) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;
- 12) a mere scheme or rule or method of performing mental act or method of playing game;
- 13) a presentation of information;
- 14) topography of integrated circuits;
- 15) an invention which, in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components;
- 16) inventions relating to atomic energy;

Q: When should an application for a patent be filed?

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

Q: Can any invention be patented after publication or display in the public exhibition?

A: Generally, an invention which has been either published or publicly displayed cannot be patented as such publication or public display leads to lack of novelty. However, under certain circumstances, the Patents Act provides a grace period of 12 months for filing of patent application from the date of its publication in a journal or its public display in an exhibition organised by the Government or disclosure before any learned society or published

by applicant. The detailed conditions are provided under Chapter VI of the Act (Section 29-34).

Q: Does the Patent Office keep information of the invention secret?

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

Q: Who can apply for a patent?

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

Q: When should the complete specification be filed?

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

Q: Is there any jurisdiction for filing patent application in India?

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

Q: What are the types of applications?

A: The types of applications that can be filed are:

1) PROVISIONAL APPLICATION - Indian Patent Law follows first to file system.

A provisional application is an application which can be filed if the invention is still

under experimentation stage. Filing a provisional specification provides the advantage to the inventor since it helps in establishing a —priority date of the invention. Further, the inventor gets 12 months' time to fully develop the invention and ascertain its market potential and to file the complete specification.

- 2) ORDINARY APPLICATION - An application for patent filed in the Patent Office without claiming any priority either in a convention country or without any reference to any other earlier application under process in the office. Such type of application is known an ordinary application.
- 3) CONVENTION APPLICATION-An application for patent filed in the Patent Office, claiming a priority date based on the same or substantially similar application filed in one or more of the convention countries is known as a convention application. In order to get convention status, an applicant should file the application in the Indian Patent Office within 12 months from the date of first filing of a similar application in the convention country.
- 4) PCT INTERNATIONAL APPLICATION - An Application filed in India as Receiving Office (RO) under Patent Cooperation Treaty is an international application which can be filed in more than 150 countries by a single application.
- 5) PCT NATIONAL PHASE APPLICATION - When an international application is made according to PCT designating India, an applicant can file the national phase application in India within 31 months from the international filing date or the priority date, whichever is earlier.
- 6) PATENT OF ADDITION - When an invention is a slight modification of the earlier invention for which he has already applied for or has obtained patent, the applicant can go for patent of addition if the modification in the invention is new. One of the benefits of filing patent of addition is that there no need to pay separate renewal fee for the patent of addition during the term of the main patent and it expires along with the main patent.
- 7) DIVISIONAL APPLICATION - When an application claims more than one invention, the applicant on his own or to meet the official objection on the ground of plurality or distinct invention may divide the application and file two or more applications, as the case may be for each of the inventions. This type of application, divided out of the parent one, is known a Divisional Application. The priority date for

all the divisional applications will be same as that of the main (the Parent) Application (Ante-dating).

Q: What are the forms required to be filled for filing a patent application in India?

A: Generally, in order to file an application, an applicant is required to file Form 1 which is a request for filing an application and Form 2 which is either a provisional or complete specification with drawings, if any. In addition to these, an abstract of the invention is also required. If the application is filed through a registered patent agent, a power of authority in favour of the said agent in Form 26 is also required. However, depending upon various circumstances, some other forms/documents (Form 3, 5, proof of right, priority document etc.) may also be required. The application can be examined only after receipt of request for examination on Form 18/18A which needs to be filed within thirty-one months from the date of priority of the application or from the date of filing of the application, whichever is earlier.

Q: What happens to a patent application once it is examined?

A: After examination, the Patent office issues an examination report to the applicant which is generally known as First Examination Report (FER). Thereafter the applicant is required to comply with the requirements within a period of 6 months from the date of FER which can be extended by 3 months with a request in Form 4 for extension of time along with prescribed fee. In case, the application is found to be in order for grant, the patent is granted, provided there no pre-grant opposition is filed or pending. A letter patent is issued to the applicant. However, in case a pre-grant opposition is pending, the further action is taken after disposition of the pre-grant opposition.

Q: What happens when applicant is not able to meet the requirement of FER within the prescribed time?

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

Q: Does an applicant get an opportunity of being heard before his application is refused?

A: If the applicant's reply to FER is not satisfactory, the Controller shall provide an opportunity of being heard to the applicant before refusing or granting the application.

Q: What is time limit for filing the representation for pre-grant opposition?

A: A representation for pre-grant opposition under section 25(1) of Patents Act, 1970 can be filed on Form 7A before the grant of patent.

Q: What is the time limit for filing notice of opposition (post-grant opposition) in the patent office?

A: The post-grant opposition under section 25(2) of Patents Act, 1970 can be filed on Form 7 within 12 months from the date of publication of the grant of patent in the official journal of the patent office.

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

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

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

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

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

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

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

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

- (a) The applicant or inventor is Indian resident,

- (b) Applicant does not wish to file patent application in India prior to filing outside India.
- (c) If the applicant is Indian resident, a patent application has been filed in India and six weeks period is not yet over from that date
- (d) The invention relates to atomic energy or defence purpose. However if the invention is relevant for Defence or Atomic Energy purpose, no permission shall be granted without the consent of Central Government.

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

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

Q: Are there any official fee reduction available for MSME's, Start-ups, and Universities/Educational Institutes with respect to patent filing?

A: Yes, MSME's, Start-ups, and Universities/Educational Institutes may avail reduced fee structure as applicable for natural person by filing Form 28 along with the relevant evidence.

Q: What is the relevant date from the infringement perspective?

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

Q: What are the rights of a patentee once the patent is granted?

A: A patentee enjoys the exclusive right to make and use the patented invention. The patentee also has the right to assign the patent, grant licences, or otherwise deal with the patent, for

any consideration. These rights, created by statute, are circumscribed by various conditions and limitations as prescribed under the Patents Act.1970.

Q: What are the rights of a patentee once the patent is granted?

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