

— FAQ'S

Doing Business in India

IPR (Patents)

1. How can one find out that an invention is already patented? (Under The Patents Act 1970)

The person concerned can perform a preliminary search on Patent Office website in the Indian Patent database of granted patent or Patent Office journal published every week. The public can conduct search free of charge on the website of Patent Office. The person concerned can also make a request for such information under section 153 of the Act. For further details please access following link.

2. Where could one find a copy of the Patent Office Journal without purchasing the publication? (Under The Patents Act 1970)

The Patent Office e-journal is freely available on patent office site, link.

3. What are the contents of the Patent Office Journal? (Under The Patents Act 1970)

The Patent Office Journal contains information relating to patent applications which are published, post grant publication, restoration of patent, notifications, indexes, list of non-working patents and notices issued by Patent Office relating to Patents, etc. For further details please access following link.

4. Where is the information relating to patent application notified? (Under The Patents Act 1970)

The information relating to the patent application is published in the Patent Office e-Journal issued every friday. This is available in electronic form on the website of the Patent Office. For further details please access following link.

5. What are then various stages involved in the grant of patent? (Under The Patents Act

1970)

After filing the applicant for the grant of patent, a request for examination is required to be made by the applicant or by third party and, thereafter, it is taken up for examination by the Patent Office. The first examination Report is issued to the applicant to give him an opportunity to correct the deficiencies in the application and meet the objections raised in the said report. The applicant must comply with the requirements within the prescribed time otherwise his application would be treated as deemed to have been abandoned. When all the requirements are met, the patent is granted and notified in the Patent Office Journal. However before the grant of patent and after the publication of application, any person can make a representation for pre-grant opposition. For further details please access following link.

6. What happens when applicant is not able to meet the requirement within the prescribed time for a patent? (Under The Patents Act 1970)

If the applicant is not able to meet the requirements of the patent office within 12 months and does not submit the documents which were sent to him for compliance within the said period, the application is deemed to have been abandoned. For further details please access following link.

7. What happens to a patent application once it is examined? (Under The Patents Act 1970)

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 twelve months from the date of FER. In case the application is found to be in order for grant, the patent is granted, provided there is no pre-grant opposition filed or pending. If a pre-grant opposition is pending, the further action is taken after disposing of the pre-grant opposition. A letters patent is then issued to the applicant. For further details please access following link.

8. Does patent office help in finding users for patent? (Under The Patents Act 1970)

The Patent Office has no role in the commercialization of patent. However, the information relating to patents is published in the e-journal of the Patent Office in the official website which is freely accessible to the public worldwide. This certainly helps the applicant to attract potential user or licensee. The Patent office also compiles a list of patents which have not been commercially worked in India. For further details please access following link.

9. What is the term of patent? (Under The Patents Act 1970)

Term of every patent in India is 20 years from the date of filing of patent application, irrespective of whether it is filed with provisional or complete specification. However, in case of applications filed under PCT, the term of 20 years begins from International filing date. For further details please access following link.

10. Is there any difference in the amount of fees to be paid by an individual or a legal entity for filing a patent application? (Under The Patents Act 1970)

Yes, the application filing fees for an individual person (natural person) is US\$ 25 and for small entity the fee is US\$ 62. For a legal entity, other than individual and small entity, the fee is US\$ 124, upto 10 claims and 30 pages. However in case the number of pages exceed beyond 30, the natural person has to pay US\$ 2.5 and small entity \$ 6 for each extra page, whereas a legal entity, other than individual and small entity, has to pay US\$ 12 per extra page. Similarly, if the number of claims exceed beyond 10, then natural person has to pay US\$ 5 and small entity US\$ 12, for each additional claim. A legal person other than small entity/natural person has to pay US\$ 25 for each additional claim. For further details please access following link.

11. Does the Patent Office help to select a patent attorney or agent to make patent search or to prepare and prosecute patent application? (Under The Patents Act 1970)

Yes, Patent Office is publishing the list of facilitators who are willing to play a role in filing patent applications for start-ups and act as a patent agent on their behalf. Their fees for this purpose have also been notified. The list of facilitators is available in IPO website www.ipindia.nic.in and has also been uploaded in the Start-up Hub in DPIIT website. For further details please access following link.

12. What are obligations of the patentee after grant of patent? (Under The Patents Act 1970)

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

13. Is there any provision in the law for early publications of patents? (Under The Patents Act 1970)

Yes, according to Indian Patent Act the patent application can be examined for early publications as per the Form-9 introduced by the Patent Office. For further details please access following link.

14. Is patent application once filed examined automatically? (Under The Patents Act 1970)

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

15. When can the request for examination can be filed for patents? (Under The Patents Act 1970)

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

16. Is there any provision for early examination of patents? (Under The Patents Act 1970)

There is a provision for filing a request for early examination. The Patent Office has introduced Form 18A for expedited examination for the applicants who meet certain eligibility criteria. Please refer to Indian Patent office website for details. For further details please access following link.

17. Does the Patent Office keep information of the invention secret? (Under The Patents Act 1970)

Yes, all patent applications are kept secret up to 18 months from the date of filing or priority date whichever is earlier and, thereafter, they are published in the Official e-journal of the Patent Office which is published every week 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. For further details please access following link.

18. Is it possible to file international application under Patent Cooperation Treaty (PCT) in India? (Under The Patents Act 1970)

It is possible to file an international application known as PCT application in India in the Patent Offices located at Kolkata, Chennai, Mumbai, and Delhi. All these offices act as Receiving Offices (RO) for International application. The address of these offices are available on the website of CGPDTM on the link.

19. What can be patented? (Under The Patents Act 1970)

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

20. Who can apply for a patent? (Under The Patents Act 1970)

A patent application can be either filled 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. For further details please access following link.

21. How can I apply for a patent? (Under The Patents Act 1970)

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

22. Is there provision for filing patent application electronically by online system? (Under The Patents Act 1970)

From 20 July 2007, the Indian Patent Office has put in place an online filing system for patent

application. More information for filling online application is available on the website of Patent Office i.e. www.ipindia.nic.in. As per Patents (Amendment) Rules 2014, there is a fee concession for e-filing, as 10% higher fee is charged if the application is filed in hard copy format. For further details please access following link.

23. What are the criteria of patentability? (Under The Patents Act 1970)

An invention can become patentable subject matter must meet the following criteria:- 1) It should be novel. 2) It should have inventive step or it must be non-obvious. 3) It should be capable of industrial application. 4) It should not fall within any of the provisions of sections 3 and 4 of the Patents Act 1970. For further details please access following link.

24. Should application for patent be filled before or after, publication of the detail of the invention for patents? (Under The Patents Act 1970)

The application for patent should be filled before the publication of the invention and till then it should not be disclosed or published. Disclosure of invention by publication before filling of the patent application may be detrimental to novelty of the invention as it may no longer be considered novel due to such publication. However, under certain conditions, there is grace period of 12 months for filling application even after publication. For further details please access following link.

25. Can any invention be patented after publication or display in the public exhibition? (Under The Patents Act 1970)

Generally, a patent application for the invention which has been either published or publicly displayed cannot be filed. However, the Patent Act provides a grace period of 12 months for filling of patent application from the date of its publication in a journal or its public display in an exhibition organized by the Government or disclosure before any learned society or published by applicant. The detail of conditions are provided under Chapter VI of the Act. For details on the Act, refer to link.

26. How a patent specification is prepared? (Under The Patents Act 1970)

A patent specification can be prepared by the applicant himself or his registered and authorized agent. The patent specification generally comprise of the title of the invention indicating its technical field, prior art, draw backs in the prior art, a concise but sufficient description of the invention and its

usefulness, drawings (if any) and details of best method of its working. The complete specification must contain atleast one claim or statement of claims defining the scope of the invention for which protection is sought. For further details please access following link.

27. What is provisional specification of patents? (Under The Patents Act 1970)

Indian Patent Law follows first to file system. Provisional specification describes the nature of the invention to have the priority date of filing of the application in which the inventive idea has been disclosed. It must be followed by a complete specification describing the details of the invention along with a statement of claims within 12 months after filing of the provisional application. If the complete specification is not filed within the prescribed period, the application is treated as deemed to have been abandoned. For further details please access following link.

28. Does Indian Patent given protection worldwide? (Under The Patents Act 1970)

Patent protection is territorial right and therefore it is effective only within the territory of India. However, filling an application in India enables the applicant to file a corresponding application for same invention in conventional countries, within or before expiry of twelve months from filling data in India. Therefore, separate patent should be obtained in each country where the applicant requires protection of his invention in those countries. There is no patent valid worldwide. For further details please access following link.

29. What is a Patent? (Under The Patents Act 1970)

Patent is a statutory right for an invention granted for a limited period of time to the patentee by the government, in exchange of full disclosure of his invention for excluding others, from making, using, selling, importing the patented product or process for producing that product for those purpose without his consent. For further details please access following link.

30. Is it necessary to file a provisional application? (Under The Patents Act 1970)

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

details please access following link.

