



PROCEEDINGS BEFORE INDIAN PATENT OFFICE

Author: Kalyan Chakravarthy Kankanala, CKO, Brain League IP Services Pvt. Ltd.

Overview

A patent application can be filed at any of the four patent offices in India (Kolkata, Delhi, Mumbai or Chennai). The patent application passes through the following stages:

- A. Filing
- B. Publication
- C. Examination
- D. Opposition
- E. Grant

A. Filing

1. Applicant : An application for a patent can be filed by the true and first inventor. It can also be filed by the assignee or legal representative of the inventor. If an application is filed by the assignee, proof of assignment has to be submitted along with the application. The applicant can be national of any country.

2. Form of Application: Every application shall be accompanied by a provisional or complete specification. Provisional applications are generally filed at a stage where some experimentation is required to perfect the invention.

Filing of a provisional specification allows the applicant to get an early application date.

A Provisional Specification shall contain:

- a. Title,
- b. Written Description,
- c. Drawings, if necessary and
- d. Sample or model if required.

The complete specification shall contain:

- a. Title,
- b. Abstract,
- c. Written Description,
- d. Drawings (where necessary),
- e. Sample or Model (if required by the examiner),
- f. Enablement and BestMode,
- g. Claims and
- h. Deposit (Microorganisms)

- a. Title

Title is generally a word or a phrase indicating the content of the invention.

- b. Abstract

It is a short paragraph describing the invention in a precise manner.

c. Written Description

This is an important part of the specification. It contains the complete and elaborate description of the invention.

Written Description generally starts with a background of the invention. The written description explains the invention clearly and comprehensively, with the help of examples, drawings and models, where and when required.

d. Drawings

The written description might be supplemented with drawings, where and when required. The drawings should be clearly labeled.

e. Samples or Models

On initiative of the inventor or when required by the patent examiner samples or models might be submitted to the patent office. Such samples or models will provide a better understanding of the invention.

f. Enablement and Best Mode

The applicant has to enable his invention in order to allow a person with ordinary skill in the art to make and work the invention. He should not only enable, the applicant should also describe the best mode of carrying out the invention.

g. Claims

Claims define the metes and bounds of the invention. They are the most important elements in a specification.

h. Deposit

If an invention involves microorganisms, which cannot be described by writing, a sample of the microorganism has to be deposited at an internationally recognized depository. There is an internationally recognized depository at Chandigarh

A provisional specification cannot be filed if an application has been filed in a foreign country (Convention country) before the Indian filing and if the application is a PCT application. A complete specification has to be filed within twelve months (extendable to fifteen months) of filing the provisional specification. Each specification should contain only one invention. If there is more than one invention in a specification, separate applications have to be filed for each invention.

3. Priority Date

Priority date is the date of first filing allotted by the patent office to an application. If a provisional application is followed by a complete application, the priority date shall be date of filing of the provisional application. If an Indian application is filed after a foreign or PCT application, the priority date shall be the date of filing of the foreign or PCT application. If an application is divided into two applications, the priority date shall be date of filing of the parent application.

Priority date is the date of reference used by the patent office to determine the newness of the invention. If the claimed invention is part of public knowledge before the priority date, it will not be eligible for a patent. Under US Law, priority date is pushed back to the date of conception for determining novelty and Non-obviousness.

4. Place of Filing

A Patent application can be filed at any of the four patent offices in India. Patent Offices are located at Kolkata, New Delhi, Chennai and Mumbai.

5. Documents to be submitted at the time of filing.

The following documents have to be submitted at the time of filing a patent application:

- a. Form 1 - Application for the grant of patent.
- b. Form 2 - Provisional or Complete Specification.
- c. Form 3 - Statement and undertaking by the applicant.
- d. Form 5 - Declaration as to inventorship.
- e. Form 26 - Authorization of patent agent or any other person.

Priority document details have to be filed for a Convention application.

B. PUBLICATION

A patent application will be published on expiry of eighteen months after the priority date. It can be published earlier, if such a request is made by the applicant. The application will not be published if directions are given for secrecy, until the term of those directions expire. It will also not be published if the application is withdrawn three months before publication date.

On publication, specification including drawings and deposits shall be open for public inspection. The rights of the patentee start from the date of publication but they cannot be enforced until after patent grant.

C. EXAMINATION

1. Request for Examination

The process of examination starts with a request for examination. The request has to be made within 36 months from the date of priority or filing. However, if secrecy directions have been given for the application, the request can be made six months after the directions are revoked or thirty six months from the date of priority or filing, if that date is later.

2. Examination

On receiving the request, the controller shall direct the patent application to the Examiner for examination. To start with, the examiner makes a formal examination by verifying the propriety and correctness of all documents filed with the application. Later, he verifies the patentability of the application. The patentability analysis includes all patentability requirements.

After confirming that the application falls within the scope of patentable subject matter, the examiner conducts a prior art search to check if there is prior art, which anticipates the invention claimed. Prior art search for anticipation includes search for anticipation by publication, filing of complete specification, etc. He then verifies the existence of inventive step, Industrial application, and Enablement and Best mode.

The examiner will give the examination report within 1 month from the date of reference by controller and that term shall not exceed three months. If the examination report is adverse, the controller sends a notice to the applicant and gives him an opportunity to correct and if necessary an opportunity of hearing. The Controller might ask the applicant to amend the application in order to proceed further. If the applicant does not make such changes, the application might be rejected.

The Controller has the power to divide the application, post date the application, substitute applicants and reject the application. An order of division will be given if the application contains more than one invention and if it is required to file separate applications for each invention.

The application might be post dated to a period of six months if requested by the applicant. Substitution of inventors is generally done if the inventor has been wrongfully mentioned or if a joint inventor has not been mentioned in the application.

The controller has the power to reject the application, if the applicant does not comply with his requirements.

D. OPPOSITION

1. Pre-grant Opposition

Any person can file an opposition for grant of patent after the application has been published. Opposition may be filed on any of the following grounds:

- a. Non compliance of patentability requirements.
- b. Nondisclosure or Wrongful disclosure of genetic resources or traditional knowledge.

2. Post-grant Opposition

Any person can file an opposition within a period of twelve months after the grant of a patent. It can be filed based on the following grounds:

- a. Wrongful obtainment of the invention by the inventor.
- b. Publication of the claimed invention before the priority date.
- c. Sale or Import of the invention before the priority date.
- d. Public use or display of the invention.

- e. The invention doesn't satisfy the patentability requirements.
- f. Disclosure of false information to patent office.
- g. Application for the invention is not filed within twelve months from the date of convention application.
- h. Nondisclosure or wrongful disclosure of the biological source.
- i. Invention is anticipated by traditional knowledge.

3. Process of Opposition

On receiving a notice of opposition, the controller notifies the patentee. He then constitutes an Opposition board to deal with the opposition. The Opposition board decides the issues after giving reasonable opportunity of hearing to both the parties. The Opposition board might invalidate the patent, require amendments or maintain the status quo. If amendments are required, they have to be made within the prescribed period in order to maintain the patent.

E. GRANT

If the application satisfies all the requirements of the patent act, the application is said to be in order for grant. An application in order for grant shall be granted expeditiously. A granted patent shall be published in the official gazette and shall be open for public inspection. Every granted patent shall be given the filing date. The patent will be valid throughout India. A granted patent gives the patent holder the exclusive right to make, use, sell, offer for sale and import the product or use the process. However, the government can make use of the patent for its own purposes or for distributing an invention relating to medicine to hospitals and dispensaries. Furthermore, any person can make use of the patent for experiment or education.