

## PATENT PROSECUTION IN INDIA

### I. SUBJECT MATTER OF A PATENT APPLICATION

A patent application can be filed for an invention, i.e., a product or a process which is new, involves an inventive step and is capable of industrial application. These three primary factors of novelty, inventiveness and industrial applicability lay the foundation for the success or failure of any patent application seeking grant of patent rights before an Indian Patent Office. An invention would be considered novel if its subject matter has not fallen into public domain through any publication or use. Further, the condition of having an inventive step would be met if the invention involves a technical advancement which is not obvious to a person skilled in the field to which the invention belongs. And the invention would be considered industrially applicable if it possesses utility for an economic use and is capable of being made or used in an industry.

### II. WHO IS ENTITLED TO APPLY

A patent application can be filed, either alone or jointly with any another person(s), by the first inventor of the invention or by his assignee or legal representative (in case of a deceased person who was entitled to make the application immediately before his death). However, it may be noted that nationals of a country, which does not accord patent protection rights to Indian citizens, will not be entitled to apply for patent rights in India.

### III. APPROPRIATE OFFICE FOR FILING AN APPLICATION

A foreign applicant, who has no place of business or domicile in India, can file a patent application at any of the Patent Offices in India provided he mentions the address for service of the place which falls within the territorial limits of the office where he intends to file his patent application. On the other hand, the appropriate Patent Office for an Indian applicant is governed by territorial limits and therefore would be decided according to either the place where he (or the first mentioned applicant in case of joint applicants) normally resides or has domicile or has a place of business or the place from where the invention actually originated.

### IV. REQUISITE DOCUMENTS FOR A PATENT APPLICATION

The following documents, along with the applicable statutory fee, are required to be submitted while making an application for the grant of a patent.

1. Application for grant of patent, in duplicate, in Form 1 under The Patent Rules, 2003 (**Patent Rules**).
2. Provisional or complete specification, in duplicate, in Form 2 under the Patent Rules. If a provisional specification is filed initially, it must be followed by the complete specification within 12 months of the date of filing of the provisional specification. The provisional or complete specification includes the description of the working of the invention, the claims, drawings (if any) and the abstract of the invention.

3. Information disclosing details of any foreign applications in respect of the invention, in duplicate, in Form 3 under the Patent Rules.
4. In case priority is claimed, a certified copy of the priority documents.
5. Declaration of inventorship, in duplicate, in Form 5 under the Patent Rules.
6. Power of attorney.

**V. PUBLICATION OF A PATENT APPLICATION**

A patent application is published in the Official Patent Office Journal after the expiry of 18 months from the date of filing of the application or the date of priority claimed, whichever is earlier. The publication mentions all relevant particulars relating to the application including the title, abstract, application number and name and address of the applicant. It is only after this publication that a patent application becomes open for public inspection. Should the applicant want an early publication before the expiry of 18 months, he can do so by filing a request for early publication in Form 9 under the Patent Rules and paying the associated statutory fee. A request for early publication can be filed at any time after filing of the patent application. Ordinarily, a patent application is published within 1 month from the date of the request for early publication.

**VI. REQUEST FOR EXAMINATION OF A PATENT APPLICATION**

A patent application is examined only upon a request made by the applicant. This request for examination has to be made within 48 months from the date of filing of the application or the date of priority claimed, whichever is earlier. The application will be treated as abandoned if no request of examination is filed within the prescribed period of 48 months.

**VII. EXAMINATION**

After receiving a request for examination from the applicant, the Patent Office examines the patent application and issues a First Examination Report (**FER**) stating the objections/requirements with respect to novelty and/ or inventiveness and/or industrial application. The FER is ordinarily issued within a period of 6 to 18 months from the date of request for examination or the date of publication, whichever is later.

**VIII. RESPONSE TO THE FER**

In order to make good the objections raised by the Patent Office in the FER, a response should be filed by the applicant within a period of 12 months from the date of the FER. If a response to the FER is not filed within this prescribed period of 12 months, the application will be deemed to have been abandoned.

**IX. GRANT OF PATENT, TERM & RENEWAL FEE**

If the response to the FER by the applicant, in the opinion of the Patent Office, satisfies and overcomes all the objections raised in the FER, the applicant would be granted a valid patent by the Indian Patent Office. Typically, the response to the FER would be followed by hearing(s) at the

Patent Office wherein the applicant is required to substantiate its written response through oral arguments. This whole process of filing of the response to the FER, the hearing(s) at the Patent Office and the grant of patent is usually completed within 12 months from the date of issuance of the FER. A patent is valid for 20 years from the date of filing of the patent application. However to maintain its validity and to keep the patent in force, a renewal fee has to be paid by the applicant every year. The applicant has the option of paying the annual renewal fee for 2 or more years in advance.

#### X. **OPPOSITIONS**

Oppositions to a patent application or the grant of a patent can be filed by third parties. A pre-grant opposition, i.e. an opposition before the grant of a patent, can be filed by any person in writing at any time after the publication of the impugned patent application in the Official Patent Office Journal but before the grant of the patent. However, it may be noted that such pre-grant opposition will be taken up by the Patent Office only after the applicant files for a request for examination. An opposition can also be filed after the grant of a patent, however, such post-grant opposition can only be filed by an interested third party which is affected by the grant of the impugned patent. Also, such post-grant opposition has to be filed within 12 months from the date of publication of the grant of patent in the Official Patent Office Journal. The grounds of opposition may include prior art, lack of novelty, invalidity, wrongful obtainment, false representation, lack of inventive step etc.

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*The contents of this document are intended for information purposes only and are not in the nature of a legal opinion or advice. They may not encompass all possible regulations and circumstances applicable to the subject matter and readers are encouraged to seek legal counsel prior to acting upon any of the information provided herein.*

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