

HANDBOOK ON PATENT FILING PROCEDURES



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STEP 1: FILING OF PATENT APPLICATION

Patent Documents can be filed either through online or at the patent office in respective **jurisdiction**: Kolkata, Delhi, Mumbai, and Chennai.

Physical Filing [at the counter of a jurisdictional patent office]

1. Covering indicating the list of documents;
2. Application for Grant of Patent in **Form 1** in duplicate [section 7, 54 & 135 and Rule 20(1)];
3. Provisional/Complete specification in **Form 2** in duplicate [Section 10; Rule 13]; comprising
 - Description
 - Claims
 - Drawing (if any)
 - Abstract
4. Statement and Undertaking in **Form 3** in duplicate [Section 8; Rule 12];
5. Power of Attorney in **Form 26** (in case a patent agent is assigned) (in original)(Rule 3.3 (a)(ii));
6. Declaration of Inventorship in **Form 5** in duplicate (only where applicant and inventor[s] are different);(Rule 4.17);
7. **Form 28** (in case the applicant is a small entity) (Rule 2 (fa) & 7);
8. Certified true copy of the Priority document (in case priority is claimed); and
9. Requisite Statutory fees (cheque / DD).

Statutory Fees [Physical Filing]:

Particular	Natural Person (INR)	Small Entity (INR)	Large Entity (INR)
For filing patent application	1, 760	4, 400	8, 800
For each sheet of specification in addition to 30	176	440	880
For each claim in addition to 10 claims	352	880	1, 760

Online Filing [By using E-Filing Portal of the Patent Office]

Pre-requisite

1. Login ID & Password;
2. Digital Signature [Class III issued from (n) Code Solutions or Safe Script or e-Mudhra]; and
3. Valid Debit/Credit/Net Banking facility for transaction.

E-Filing Procedure

1. Form 1 is generated through portal with field specific information to be fed by filer;
2. Provisional/Complete specification in **Form 2** (in pdf format); comprising

- Description
Claims
Abstract
3. Drawings (in pdf format);
 4. Figure of Abstract (in jpg format);
 5. Statement and Undertaking in **Form 3** (in pdf format);
 6. Power of Attorney in **Form 26** (in case a patent agent is assigned) (in pdf format), original needs to be submitted before Indian Patent Office);
 7. Declaration of Inventorship in **Form 5** (in pdf format);
 8. **Form 28** (in case the applicant is a small entity);
 9. Letter/documentary proof to prove the small entity status (if any);
 10. Certified true copy of the Priority document (in case priority is claimed) in original, to be submitted within 6 months of filing the Application;
 11. Priority Details; and
 12. Requisite Statutory fees (through payment gateway).

Statutory Fees:

Particular	Natural Person (INR)	Small Entity (INR)	Large Entity (INR)
For filing patent application	1, 600	4, 000	8, 000
For each sheet of specification in addition to 30	160	400	800
For each claim in addition to 10 claims	320	800	1, 600

Regional Patent office's Jurisdiction

Office	Territorial Jurisdiction
Patent Office Branch, Mumbai	The States of Maharashtra, Gujarat, Madhya Pradesh and Goa, Daman & Diu & Dadar & Nagar Haveli
Patent Office Branch, Chennai	The States of Andhra Pradesh, Kerala Tamil Nadu, Mysore and Pondicherry, Laccadive, Minicoy and Aminidivi Islands
Patent Office Branch, New Delhi	States of Haryana, Himachal Pradesh, Jammu & Kashmir, Punjab, Rajasthan and Uttar Pradesh, Chandigarh and Delhi
Patent Office (Head), Kolkata	West Bengal and other rest part of India.

STEP 2: PUBLICATION

[Rule 24] A patent application will be published automatically in the official journal after expiry of 18 months from date of filing or date of priority of the application containing title, abstract, application no. and name of applicant[s] and inventor[s].

Request for early publication: [Rule 22A] To expedite the process of grant of patent a request for publication under Section 11(A)(2) can be made in **Form 9** any time after filing of the application. Upon such request the application will be published in one month from the date of such request.

Statutory Fees:

Particular	Natural person (INR)	Small Entity (INR)	Large Entity (INR)
Physical Filing	2, 750	6, 875	13, 750
E-Filing	2, 500	6, 250	12, 500

STEP 3: OPPOSITION (IF ANY)

1. Pre grant Opposition

[Section 25(1)] Upon publication but before the grant of patent, any person, based on different grounds may file a pre grant opposition, in writing, represent by way of opposition to the Controller against the grant of patent. However the opposition will be taken by the patent office only after the filing of Request for Examination.

Time limit:

May be filed within 3 months from the date of publication of the application [sec 25(1); rule 55(1)] OR Before the grant of patent, whichever is later.

Fee:

NO FEE

Form and Content [Rule 55(1)]:

Form 7A along with the representation comprise of following particulars:

1. Statement regarding opposition;
2. Evidence regarding opposition; (if any)
3. Request for hearing (Optional).

Procedure:

1. The Controller will consider such Representation only when a request for examination has been filed.
2. The Controller shall forward the Representation to the applicant.
3. On the basis of notice of filing the Representation, the applicant shall file his Statement and Evidence (if any) in support of his application within three months from the date of the notice.
4. Either party may request the Controller to give them a chance to be heard.

After considering the representation of the opponent and the response of the applicant and their supporting evidences (if any) and after hearing both the parties (if hearing is requested), the Controller shall proceed further simultaneously either rejecting the representation and granting the patent or accepting the representation and refusing the grant of patent. Ordinarily within one month from the completion of the above proceedings. [Rule 55(6)]

Appeal:

An applicant can go for an appeal against the decision of the Controller. Such an appeal can be filed before the Intellectual Property Appellate Board (IPAB).

2. Post grant Opposition

[Section 25(2)] Upon grant of patent any interested person, based on different grounds may file a post grant opposition in **Form 7** to the Controller against the grant of patent.

Time limit:

[Section 25(2)] Within one year after the grant of a patent.

Form and Content:

1. Notice of opposition shall be in **Form 7** (in duplicate) [Rule 55A];
2. Written Statement setting out nature of the interest (in duplicate) [Rule 57];
3. Evidence regarding opposition;
4. Statutory fees;
5. Request for hearing (Optional).

Statutory Fees:

Particular	Natural person (INR)	Small Entity (INR)	Large Entity (INR)
Physical Filing	2, 640	6, 600	13, 200
E-Filing	2, 400	6, 000	12, 000

Procedure:

1. On receipt of notice of opposition, the Controller shall, by order, constitute an Opposition Board consisting of three members and nominate one of the members as the Chairman of the Board;
2. A copy of Statement and Evidence together with Notice of Opposition shall be delivered to the applicant;
3. If the applicant desires to contest the opposition, he shall leave a Reply Statement setting out fully the grounds upon which the opposition is contested and evidence within a period of two months from the date of receipt of the copy of statement and opponent's evidence.
4. The opponent may within three months from the date of receipt of a copy of applicant's reply; leave Evidence in Reply strictly confined to matters in the applicant's reply and shall deliver to the applicant a copy of such evidence.
5. The Opposition Board shall conduct the examination of the notice of opposition along with documents filed above and submit a Report with reasons on each ground taken in the notice of opposition with its joint recommendation within three months from the date on which the document were forwarded to them.

Hearing: [Rule 62]

1. Controller may fix a date and time for the hearing of the opposition according to this rule and inform the parties and also member of opposition Board.
2. Upon the receipt of the notice of hearing either party to the proceeding is desirous to be heard, he shall inform the Controller by a notice along with the prescribed fee;
3. [Rule 63] If the applicant notifies the Controller that he does not desire to proceed with the application after notice of opposition is given, the Controller, depending upon the merits of the case, may decide whether costs should be awarded to the opponent.

After hearing a 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 and notifies his decision to the parties giving reasons thereof.

Appeal

An applicant can go for an appeal against the decision of the Controller. Such an appeal can be filed before the Intellectual Property Appellate Board (IPAB).

STEP 4: REQUEST FOR EXAMINATION

No Request, No Grant

In **Form 18** [sec 11B; rules 20(4)(ii) and 24B(1)(i)] (in duplicate when filed in physical copy) within period of 48 months from date of filing or priority, whichever is earlier.

Statutory Fees:

Particular	Natural person (INR)	Small Entity (INR)	Large Entity (INR)
Physical Filing	4, 400	11, 000	22, 000
E-Filing	4, 000	10, 000	20, 000

Express Request:

The Express Request can only be made for National Phase Applications under rule 20(4)(ii)

Statutory Fees:

Particular	Natural person (INR)	Small Entity (INR)	Large Entity (INR)
Physical Filing	6, 160	15, 400	30, 800
E-Filing	5, 600	14, 000	28, 000

STEP 5: FIRST EXAMINATION REPORT

[Section 12; 24B(3)] After proper examination of patent application on the criteria of novelty, inventiveness and industrial application, the Patent Examiner will issue a First Examination Report (FER) and will send along with the application and specification to the applicant or authorized agent.

STEP 6: AMENDMENT OF OBJECTIONS BY THE APPLICANT

The issued FER give an opportunity to the applicant to file a response and overcome the objections raised by the Examiner.

Time limit: [Rule 24B(4)(iii)] Within 12 months from the date on which the First Examination Report has been issued to the applicant.

In case of the unjustified response, the Controller has power to refuse the grant of patent or amended claim[s] or make order for the Division of Application [Section 15, 16].

STEP 7: GRANT OF PATENT

The Controller will grant the application upon satisfactory response by the applicant to overcome all of the objections raised in the FER.

On the grant of a patent, the application will be accorded a number, called serial number in the series of numbers accorded to patents under the Indian Patents Act, 1970(39 of 1970).

STEP 8: RENEWAL FEES

1. 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.
2. While paying the renewal fee, the number and date of the patent concerned and the year in respect of which the fee is paid shall be quoted.
3. The annual renewal fees payable in respect of two or more years may be paid in advance.

Statutory Fees (online mode*):

Particular	Natural person (INR)	Small Entity (INR)	Large Entity (INR)
Before the expiration of 2 nd year from the date of patent in respect of 3 rd -6 th years [Each Year]	500	2,000	4, 000
Before the expiration of 6 th year from the date of patent in respect of 7 th - 10 th years [Each Year]	2, 400	6,000	12, 000
Before the expiration of 10 th year from the date of patent in respect of 11 th - 15 th years [Each Year]	4, 800	12,000	24, 000
Before the expiration of 15 th year from the date of patent in respect of 16 th - 20 th year	8,000	20,000	40, 000

* 10% surcharge applicable in case of Physical Filing.

The period for payment of renewal fees may be extended to a period but not more than six months if the request for extension in **Form 4** with fees.

Statutory Fees:

Particular	Natural person (INR)	Small Entity (INR)	Large Entity (INR)
Physical Filing [per month]	528	1, 320	2, 640
E-Filing [per month]	480	1, 200	2, 400

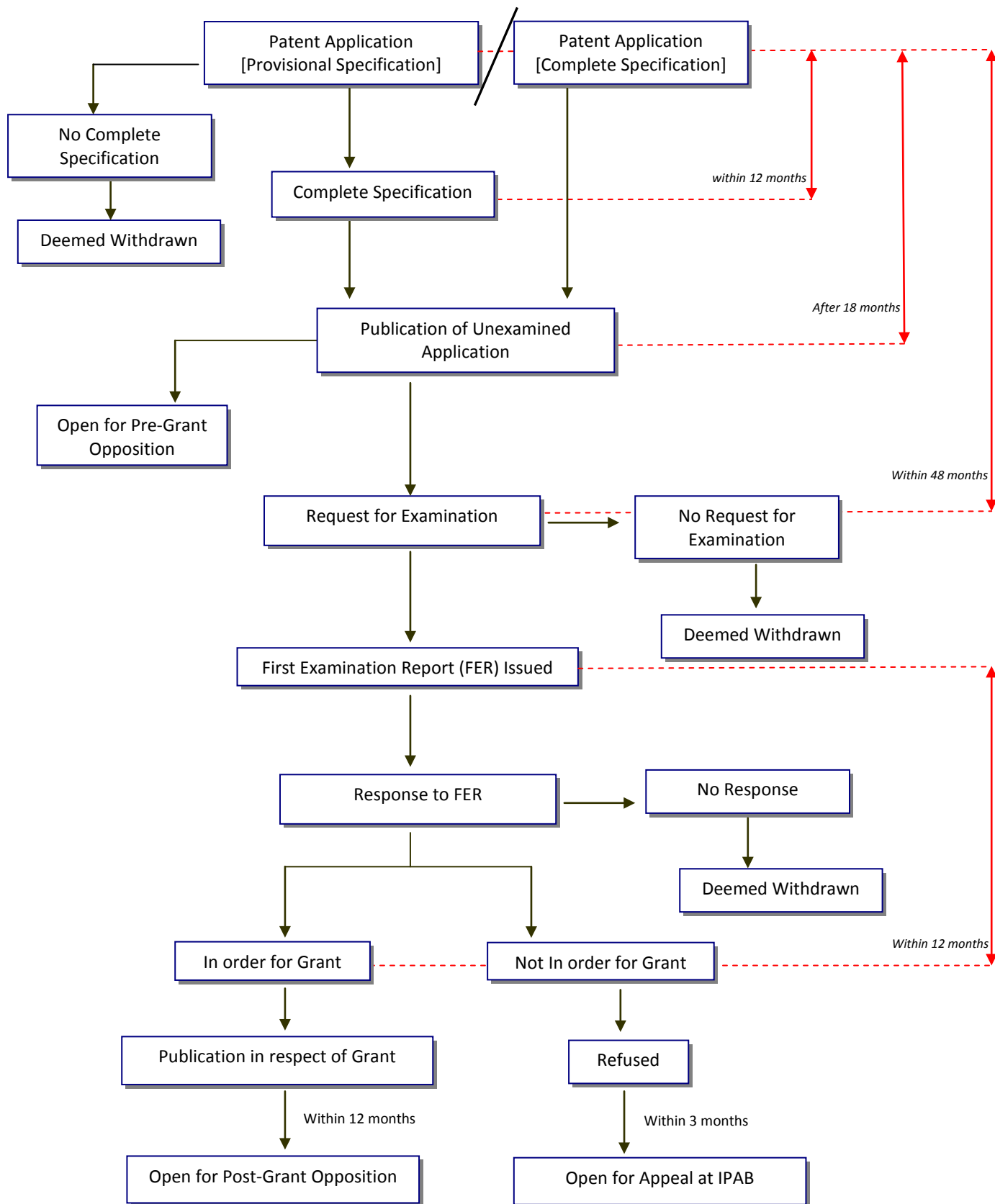
INFRINGEMENT PROCEEDINGS

The patentee may file an action for patent infringement in either a District Court or a High Court. Whenever a defendant counter-claims for revocation of the patent, the suit along with the counterclaims is transferred to the High Court for decision. Because defendants invariably counterclaim for revocation, patent infringement suits are typically heard by a High Court only. According to patent law in India, the High Court may allow the patentee to amend the application in order to preserve the validity of the patent. In such an event, the applicant must give notice to the Controller, who may be entitled to appear and be heard and shall appear if so directed by the High Court.

If a patentee is successful in proving its case of patent infringement, and if the defendant does not comply with the judgment, a petition for contempt of court can be filed. Contempt of court is a criminal offense, while patent infringement is a civil offense. In the event of a contempt of court, Indian law provides for imprisoning the authorized person(s) of the defendant. It is also possible to obtain a preliminary injunction, although the above-noted judicial backlog should be considered. The basis upon which a preliminary injunction is granted is whether the plaintiff shows a prima facie case and also whether the balance of "convenience" is in the plaintiff's favor.

However, an important consideration before enforcing a patent in India is to ensure that the patentee has worked the invention directly or through its licensees in India. If a patentee has not worked the invention in India, then the defendant could seek a compulsory license under Section 84(1)(c), if the patent has been in force for more than three years. In addition, if a compulsory license is already in place and the patentee has still not worked the invention but yet asserts it, the defendant can seek a revocation of the patent under Section 85(1) of the Patent Act.

PATENT PROSECUTION – FLOW CHART



PATENTWIRE CONSULTANTS PVT. LTD.

B-10, Ground Floor, Vishwakarma Colony

M.B. Road, New Delhi-110044, India

Mobile: +91 98113 67838 | Telephone: +91 11 26360036

Fax: +91 11 26360037

Email: desk@patentwire.co.in

www.patentwire.co.in

