Patents In India – FAQs

Disclaimer: The answers given below to the probable questions are for the purpose of guiding public which can not be quoted in any legal proceedings and will have no legal purpose. The users are advised to refer the provisions of the Patents Act 1970 as amended and the Patents Rules 2003 as amended including the latest fee schedules.

**Q: What is a Patent?**

A: A 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 purposes without his consent.

**Q: Does Indian Patent give protection worldwide?**

A: Patent protection is territorial right and therefore it is effective only within the territory of India. However, filing an application in India enables the applicant to file a corresponding application for same invention in convention countries, within or before expiry of twelve months from the filing date in India. Therefore, separate patents should be obtained in each country where the applicant requires protection of his invention in those countries. There is no patent valid worldwide.

**Q: Is it possible to file international application under Patent Cooperation Treaty (PCT) in India?**

A: 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 Office (RO) for International application. The addresses of these offices are available on the website of CGPDTM i.e. www.ipindia.nic.in.

**Q: What can be patented?**

A: 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 section 3 and 4 of the Act.

**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: How can I apply for a patent?**

A: A patent application can be filed 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 filed 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.

**Q: Is there provision for filing patent application electronically by online system?**

A: From 20th July, 2007 the Indian Patent Office has put in place an online filing system for patent application. More information for filing online application is available on the website of Patent Office i.e. www.ipindia.nic.in. This facility is also available for filing trademarks application.

**Q: What are the criteria of patentability?**

A: An invention to become patentable subject matter must meet the following criteria -

• It should be novel.

• It should have inventive step or it must be non-obvious

• It should be capable of Industrial application.

• It should not fall within the provisions of section 3 and 4 of the Patents Act 1970.

**Q: Should application for patent be filed before or after, publication of the details of the invention?**

A: The application for patent should be filed before the publication of the invention and till then it should not be disclosed or published. Disclosure of invention by publication before filing 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 filing application even after publication.

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

A: Generally, a patent application for the invention which has been either published or publicly displayed cannot be filed. However 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 a exhibition organised by the Government or disclosure before any learned society or published by applicant. The details conditions are provided under Chapter VI of the Act (Section 29-34).

**Q: How a Patent Specification is prepared?**

A: A patent specification can be prepared by the applicant himself or his registered and authorized agent. The patent specification generally comprises of the title of the invention indicating its technical field, prior art, draw backs in the prior art, the solution provided by the inventor to obviate the drawbacks of 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 at least one claim or statement of claims defining the scope of the invention for which protection is sought for.

**Q: What is a provisional specification?**

A: 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

**Q: Is it necessary to file a provisional application?**

A: Generally, an application filed with provisional specification is known as provisional application which is useful in establishing a priority date for 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 specification.

**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: When an application for patent is published?**

A: Every application for patent is published after 18 months from the date of its filing or priority date whichever is earlier. However, following applications are not published.

• Application in which secrecy direction is imposed

• Application which has been abandoned u/s 9(1) and

• Application which has been withdrawn 3 months prior to 18 months

**Q: Is there any provision in the law for early publication?**

A: Yes, the applicant can make a request for early publication in Form 9 along with the prescribed fee. After receiving such request the Patent Office publishes such application within a period of one month provided the invention contained thereon does not relate to atomic energy or defence purpose.

**Q: Is patent application once filed is examined automatically?**

A: The patent application is not examined automatically after its filing. The examination is done only after receipt of the request of examination either from the applicant or from third party.

**Q: When the request for examination can be filed?**

A: 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 upto 2006.

**Q: Is there any provision for early examination?**

A: There is no provision for filing a request for early examination. The applications are examined in the order in which requests for examination are filed. However, an express request for examination before expiry of 31 months can be made in respect of the applications filed under Patent Cooperation Treaty known as National Phase applications by payment of the prescribed fee.

**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 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 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 within the prescribed time?**

A: If the applicant is not able to comply with or meet the requirement within 12 months, or does not submit the documents which were sent to him for compliance within the said period, the application is deemed to have been abandoned.

**Q: Is there provision for extension beyond time limit of 12 months?**

A: There is no provision for extension of time beyond the period of 12 months.

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

A: If applicant has not complied with the requirements within the prescribed time, and no request for hearing has been made by the applicant, the controller may not provide the opportunity of being heard. However the Controller shall provide an opportunity of being heard to the applicant before refusing his application if a request for such hearing has been made by the applicant at least 10 days in advance before expiry of the statutory period.

**Q: What are the various stages involved in the grant of patent?**

A: After filing the application 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. Usually, the First Examination Report is issued and the applicant is given an opportunity to correct the deficiencies in order to 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.

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

A: A representation for pre-grant opposition can be filed within six months from the date of publication of the application u/s 11A or before the grant of patent. The grounds on which the representation can be filed are provided u/s 25(1) of the Patents Act 1970.

**Q: Is there any fee for filing such representation for pre-grant opposition?**

A: There is no fee for filing representation for pre-grant opposition? This can be filed by any person.

**Q: What are the grounds for filing representation for pre-grant opposition?**

A: The grounds for filing post-grant opposition are contained in section 25(1) of the Patents Act 1970.

**Q: Is it possible to file pre-grant opposition even though there is no request for examination filed?**

A: Yes, it is possible to file representation for pre-grant opposition even though there is no request for examination has been filed. However, the representation will be considered only when a request for examination is received within the prescribed period.

**Q: What is the time limit for filing post-grant opposition in the patent office?**

A: The time for filing post-grant opposition is 12 months from the date of publication of the grant of patent in the official journal of the patent office.

**Q: Is there any fee for filing post-grant opposition?**

A: The post grant opposition has to be filed in the prescribed form 7 along with prescribed fees of Rs.1500 for natural person and Rs.6000 for person other than natural person. The post grant opposition has to be filed by the person interested and not by any other person.

**Q: What are the grounds for filing the post grant opposition?**

A: The grounds for filing post-grant opposition are contained in section 25(2) of the Patents Act 1970.

**Q: Is it necessary to go to the Indian Patent Office to transact any business relating to patent application?**

A: No, normally all the communications with the office are done through written correspondence. However, interviews relating to patent application can be had with examiners with prior appointment on any working day during prosecution stage.

**Q: Where the information relating to patent application is notified?**

A: The information relating to the patent application is published in the Patent office Journal issued on every Friday. This is also available in electronic form on the website of the Patent Office

**Q: What are the contents of the Patent office Journal?**

A: The Patent office Journal contains information relating to patent applications which are published u/s 11A, post grant publication, restoration of patent, notifications , indexes, list of non-working patents and notices Issued by the Patent Office relating to Patents, etc..

**Q: Can one subscribe a copy of the Patent office Journal?**

A: The Patent office Journal can be subscribed by making payment of Rs 400/- in cash or by DD/cheque in favour of the Controller of Patents. This is also available in CD form. However, the journal can be downloaded from the website free of charge.

**Q: Where could one find a copy of the Patent office Journal without purchasing the publication?**

A: The Patent office Journal is freely available on patent office site i.e. www.ipindia.nic.in.This is also available in the technical libraries maintained by the Patent Offices. The library facilities are available to the public free of charge from Monday to Friday on working days except holidays.

**Q: Can one use the words "Patent Pending" or "Patent Applied For"?**

A: These words are normally used by the patent applicant to their products after filing his application for patent so that the public is made aware that a patent application has been filed in respect of that invention. Use of these words where no application has been made is prohibited under the Patent law. However, use of such words by the patent applicant does not prohibit the third party to plead as innocent unless the patent number is indicated.

**Q: How useful is the marking of a product with "patent pending" or "patent applied for" before the grant?**

A: Marking of a product with the words “patent pending” or “Patent applied for” after filing of the application for patent serve as a notice to the public that an application for patent is pending with the Patent Office but there is no legal significance of these words. The infringement action can be initiated only after the patent is granted.

**Q: Does patent office help in finding users for patent?**

A: The Patent Office has no role in the commercialization of patent. However, the information relating to patent is published in the Patent Office journal and also published on the Patent Office website which is 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 are not commercially worked in India.

**Q: How can one find out that an invention is already patented?**

A: The person concerned can perform a preliminary search on Patent Office website in the Indian patent data base of granted patent or Patent Office journal published every week or by making search in the documents kept in the Patent Office Search and Reference Room, which contains Indian patents arranged according to international patent classification system as well in serial number. It is open to the general public from Monday to Friday, except Gazetted holidays. The public can also 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

**Q: What is the term of patent?**

A: 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.

**Q: Is there any difference in the amount of fees to be paid by an individual or a legal entity for filing a patent application?**

A: Yes, the application filing fees for an individual person(natural person) is Rs.1, 000/- and for a legal entity other than individual is Rs.4, 000/- upto 10 claims and 30 pages. However, in case, the number of pages exceed beyond 30, then natural person has to pay Rs.100/- each extra page and person other than natural person has to pay Rs.400/- per page. Similarly if the number of claims exceed beyond 10, then natural person has to pay Rs.200/- for each additional claim and person other than natural person has to pay Rs.800/- for each additional claim.

**Q: What are obligations of the patentee after the grant of patent?**

A: After the 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 the patent will be ceased.

**Q: Can the patentee pay renewal fee at a time or has to pay every year?**

A: The patentee has choice to pay the renewal fees every year or he can pay in lump sum as well.

**Q: When a patent can be restored after its cessation?**

A: A request for restoration of patent can be filed within 18 months from the date of cessation of patent along with the prescribed fee. After receipt of the request the matter is notified in the official journal for further processing of the request.

**Q: Is it necessary to engage a registered patent agent for filing an application for patent?**

A: No, it is not necessary under the patent law to engage a registered patent agent for filing an application for patent. The applicant is free to file an application by himself or through the patent agent. However, an applicant who is not a resident of India is required to file either through the registered patent agent or must give an address for service in India

**Q: Does the Patent Office help to select a patent attorney or agent to make patent search or to prepare and prosecute patent application?**

A: No, Patent Office does not make any recommendations regarding selection of a patent agent. However, the applicant is free to appoint any patent agent from a list of patent agents maintained by the office. This list can also be viewed at Patent Office website.

**Q: Does the patent office ascertain fees charged by the patent agents for their services?**

A: No. This is a matter between the applicant and the patent agent. The Patent Office has no role in ascertaining or assisting the fee charged by a patent agent.

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

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

• Applicant is not Indian resident and invention is originated abroad about.

• If the applicant is Indian resident, a patent application has been filed in India and six weeks period is over from that date.

• The invention does not belong to Atomic Energy or defence purpose.

In other circumstances, the prior permission is required. For further details kindly refer to section 39 of the Patents Act, 1970.

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

A: The person is required to take prior permission from the Patent Office under following circumstances.

• The applicant is Indian resident and invention is originated in India,

• Applicant does not wish to file patent application in India prior to filing abroad.

• 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

• The invention relates to atomic energy or defence purpose.

**Q: Is it essential to deposit biological material in the international depository authority?**

A: If the invention uses a biological material which is new, it is essential to deposit the same in the International Depository Authority (IDA) prior to the filing of the application in India in order to supplement the description. The description in the specification should contain the name and address of the International Depository Authority and, date and number of deposition of Biological material. If such biological material is already known, in such case it is not essential to deposit the same. For more details log on to www.ipindia.nic.in

**Q: Is there any International Depository Authority in India!**

A: Yes, there is an International Depository Authority in India located at Chandigarh which is known as Institute of Microbial Technology (IMTECH). The more details about this depository authority can be had on its website [imtech.res.in.](http://imtech.res.in/)

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