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## Frequently Asked Questions on Patents

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### **What information/documents are required for filing a patent application in India?**

The following:

- title of the invention;
- complete specification describing the invention with at least one 'claim' (for filing a non-provisional application);
- drawings (if necessary in order to understand the invention) and statement of claims;
- certified priority documents (if priority is claimed), in the original language, together with a verified English translation if the original is not in English;
- electronic copy of the sequences (protein, recombinant DNA, RNA, etc.), if applicable;
- an abstract of the invention;
- Power of Attorney (this may be filed at any time prior to the date of grant, preferably within a month, but should be filed within 90 days of the date of its execution); and
- Form for claiming reduced fee, if applicable. (There are three categories of applicants- Natural Person, Small Entity and Large Entity. Different slabs of official fees are applicable for each category of applicant. While no separate documentation is required for applicants of Natural Person and Large Entity categories, a Small Entity needs to furnish a separate form for claiming reduced fee.) In case of joint applicants, the highest fee category of the applicant among the joint applicants is considered for the purpose of fee calculation.

### **Is it possible to secure a patent for an invention that has been published or displayed in an exhibition?**

Patent applications should be filed prior to publication or display of the invention; failure to do so may be detrimental to novelty of the invention. However, in certain circumstances, there is a grace period of 12 months from the date of publication or display, during which applications can be filed. This is available where an invention has been either published in an exhibition organised by the Government or publicly displayed before any learned society; or where the publication has occurred without the consent of the applicant.

### **What conditions must be satisfied for an invention to be patentable?**

An invention must meet the criteria of novelty, inventiveness and industrial applicability to be eligible for the grant of patent. Further, the subject matter of the invention should not be exclusion as contained in the act.

### **What inventions are excluded from patentability under the Indian Patents Act?**

- Inventions that are not patentable include:
- Inventions contrary to well-established natural laws;

- mere discovery of a scientific principle or the formulation of an abstract theory
- mere discovery of a new form of a known substance which does not result in the enhancement of the known efficiency of that substance or the mere discovery of any new property new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employ at least one new reactant.
- method of agriculture or horticulture;
- method of treatment of human beings or treatment of animals, plants and animals in whole or any part thereof other than micro-organisms; and
- inventions relating to atomic energy.

### **Which filing system, 'first to file' or 'first to invent, does India follow?**

The Indian Patents Act makes provision for a 'first to file' system

### **Does the Indian patent system provide the option of filing a provisional specification? If yes, what is the significance of doing so?**

Yes. The main advantage of filing a provisional specification for an inventor/applicant is to secure an early priority date. The provisional specification can be followed, within 12 months, by a complete specification containing details of the invention and a statement of claim. Filing a provisional specification gives sufficient time to the inventor/applicant to assess and evaluate the market potential of the invention before filing the complete specification. However, it is not necessary to file a provisional specification; one can file a complete specification at the outset. Also, in case the provisional application as filed, included at least one claim, the applicant can request the patent office to treat the provisional application as the complete one and proceed accordingly.

### **What language is acceptable to the Patent office?**

The application must be filed in either English or Hindi. Translations of any priority documents in other languages are required to be submitted within 31 months; in practice, however, they are accepted later than that.

### **Can multiple applications be filed with one general Power of Attorney or must a separate Power of Attorney be submitted with each application?**

The applicant may submit either a general Power of Attorney or specific Powers of Attorney. The Indian patent office accepts both.

### **Is photocopy of a priority document acceptable, or is the original required? Also, what is the timeline for submitting priority documents if they are not submitted at the time of filing?**

The applicant is required to submit either a certified priority document in original or a copy of the Notification Concerning Submission or Transmittal of Priority Document (PCT/IB/304) within 31

months of the earliest priority date. Where the priority document is not in English, a duly verified English translation must also be submitted.

If the applicant fails to comply with the above, the claimed priority may be lost.

**Is it necessary to deposit biological material in the international depository authority and if yes, where in India can one deposit the same?**

If the invention describes or makes use of a new biological material, which can not be identified by a written description, it is essential to deposit the same in an International Depository Authority (IDA) as recognised under the Budapest treaty, in order to supplement the description.

In India, the following two institutes have acquired the status of an international depository authority:

The Institute of Microbial Technology (IMTECH) located at Chandigarh and the Microbial Culture Collection (MCC), National Centre for Cell Science (NCCS), University of Pune Campus, Ganeshkhind, Pune-411007, Maharashtra. The deposit should be made no later than the date of filing of the application.

**When is an application published? Can the publication of application be expedited in India?**

All applications, unless requested otherwise are published after eighteen months of filing. The applicant can make a request for early publication as well. The Patent Office publishes the application after receiving such request within a period of one month provided the invention contained thereon does not relate to atomic energy or defence purpose.

**Are the patent applications, once filed, examined automatically?**

No. Examination takes place only on receipt of a request for examination, made by either the applicant or a third party.

**Can one file Patent application online in India?**

While one may physically visit the applicable Patent office branch and file the application along with necessary documents, the Indian Patent Office has put in place an electronic filing system for submission of a patent application where an application can be filed online. The online filing system can also be used for performing other actions as indicated in the Patent Act.

**How can one apply for a patent outside India for an invention which was developed in India?**

For filing a patent application outside India for an invention developed in India, there is a requirement to seek permission from the Controller of Patents in India (Foreign Filing License). Alternatively, the application can be filed in India first and after six weeks the corresponding application can be filed in other countries.. Such requests for filing the applications outside India are entertained within 3-4 weeks by the patent office.

### **What is the timeline for filing a request for examination?**

A request for examination can be filed within 48 months from the date of priority or the date of filing the application, whichever is earlier. All patent applications are examined substantively and a first examination report stating any objection(s) will be communicated to the applicant or his agents. Applications or complete specifications may be amended in order to meet any objection(s).

### **Does the Indian patent system make provision for early examination?**

No; however, an express request for examination before the expiry of 31 months can be made in respect of applications filed under the Patent Cooperation Treaty (i.e. National Phase applications) on payment of the prescribed fee

### **Is India recognized as an International Searching Authority (ISA) and International Preliminary Examination Authority (IPEA)?**

Yes, the Indian Patent Office is recognised as an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) under the Patent Co-operation Treaty. India is perhaps the only English speaking country in the Asian region whose Patent Office has been so recognised and has started functioning from 15th October 2013. ISA and IPEAs provide search reports on novelty and examination reports on patentability of inventions. The Indian office has access to a comprehensive collection of patent and non-patent literature that covers the PCT minimum documentation. The office has developed an integrated Search platform, 'IPATS' to enable one click search through the vast collection of information.

### **What is the timeline for overcoming Patent Office objections, and is it possible to seek further extensions of time?**

All applications in India must be put in order for grant within one year of communication of objections from the patent office to the applicant. Hence, all objections must be dealt with within 12 months of the date of the first examination report, otherwise the application shall be deemed to be abandoned. The Indian Patents Act makes no provision for extensions of time.

### **Who can file a pre-grant opposition and what is the time limit?**

Any person may file a written opposition to grant of patent at any time after 18 months of the date of publication of the application, but before a patent is granted. It is possible to file a pre-grant opposition even though no request for examination has been filed. However, the opposition will be considered only when a request for examination has been received within the prescribed period.

### **Is there any fee and a particular format for filing a pre-grant opposition?**

While there is no fee to file a pre grant opposition, the opposition needs to be made on a specified form with a detailed statement of grounds on which the opposition is sought. Specific grounds on which a patent application can be opposed have been provided in the Act.

### **Is there a post-grant opposition process under the Indian Patents Act?**

A post-grant opposition can be filed within one year of the date of publication of grant. While a pre-grant opposition can be filed by 'any person', only an 'interested person' can file a post-grant opposition. A 'person interested' has been interpreted as a person who has a direct, present and tangible commercial interest or public interest which is injured or affected by the continuance of the patent on the register.

### **Is there any way to search whether an invention has already been patented in India?**

A preliminary search may be carried out on the Indian Patent Office website database, or in the Patent Office journal which is published every week. One can also make use of certain proprietary databases on Indian patents as well. A request for such information can also be made under section 153 of the Indian Patents Act.

### **What is the average time from filing until grant of a patent?**

In view of the present work load at the Patent Office, an application may take from three to five years to proceed to grant.

### **What are the rights of a patentee once the patent is granted?**

A patentee enjoys the exclusive right to make and use the patented invention. The patentee also has the right to assign the patent, grant licences, or otherwise deal with the patent, for any consideration. These rights, created by statute, are circumscribed by various conditions and limitations.

### **What is the term of a patent? Once the patent is granted, do I need to renew it?**

The term of a patent in India is 20 years from the date of filing. However, for patents granted pursuant to applications filed under the PCT, the term of 20 years begins from the international filing date.

Yes, patents must be renewed. Maintenance/renewal fees are payable every year. The first renewal fee is payable at the end of the second year from the date of the patent. Renewal fees for any succeeding year must be paid before the end of that year. Renewal fees are not payable prior to grant; any annuities accrued prior to grant become payable only after grant. One may choose to pay for the entire term of the patent or part thereof in one go as well.

### **Is it necessary to show working of a patent after grant?**

Yes. Annual reports as to the extent of working, by patentees and licensees, are a statutory requirement and must be submitted by 31 March each year for the previous year ending 31 December.

### **Is there a grace period or extension of time available for paying annual fees in India?**

Yes. The time limit for the payment of annual fees to maintain the patent can be extended by up to a maximum of six months. This extension can be obtained on request, upon payment of a fee for each month of extension.

### **Can a patent be restored once it has lapsed?**

A patent, if lapsed due to the non-payment of renewal fees, may be revived by filing an application for restoration within eighteen months from the date the patent ceased to exist. The application to revive a lapsed patent should prove that the lapse was unintentional and that there was no undue delay in making the application for restoration.

### **Is there a way to oppose the restoration of a lapsed patent?**

Once an application for restoration has been made by the patentee, the controller, after having satisfied himself prima facie that the lapse was unintentional and there is no undue delay in making the request, published the application in the official journal. An interested person can oppose such restoration by proving that the delay was intentional or that there has been an undue delay in making of the application for restoration.

### **What are the ways to challenge a granted patent in India?**

Since January 2005, India has had a post-grant opposition system under which one (interested party) can oppose a granted patent within 12 months of the announcement of the decision to grant by the patent office.

Interested parties, or the government, can also file a petition for revocation of a patent at any time during the life of the patent. Such petitions are filed with the Intellectual Property Appellate Board (IPAB).

Further, in case of an infringement suit, the defendant in its defence can challenge the validity of the granted patent- which is decided by the concerned High Court- even if the original suit was filed in a lower court.

The courts have indicated that though there are several ways of challenging a granted patent, the opponent cannot initiate multiple parallel proceedings in different forums to invalidate a granted patent.

### **Is it an infringement in to deal with product obtained directly by means of a patented process without the authorisation from the patentee?**

Yes, in case of a patented process, where the patent claims a product obtained directly by the use of the patented process, manufacturing/selling such solutions without the authorisation of the patentee will amount to infringement.

### **Are there any differences if a claim for infringement is brought by an exclusive licensee rather than the patent proprietor?**

No. An exclusive licensee enjoys the same rights as those conferred to the patentee. The holder of an exclusive licence has the right to institute a suit in respect of any infringement of the patent committed after the date of the licence.

Further, while awarding damages or an account of profits or granting any other relief in any such suit the court takes into consideration any loss suffered or likely to be suffered by the exclusive licensee.

Also, in the suit for infringement of a patent by the holder of an exclusive licence, the patentee, unless he has joined as a plaintiff in the suit, is added as a defendant. However, the patentee so added as defendant is not liable for any costs unless he enters an appearance and takes part in the proceedings.

### **Where can the patentee file the suit for infringement?**

Once the patentee determines that the patent is being infringed, it can exercise the option of filing a suit for Patent infringement in a District Court or a High Court of the Jurisdiction where the infringer is situated or the cause of action i.e. patent infringement has arisen (generally an invoice establishing the selling of the infringing product is sufficient to invoke the jurisdiction of a particular court for trying the suit). High courts of New Delhi, Calcutta, Mumbai and Chennai also have the original jurisdiction to entertain patent infringement matters and hence, patent infringement suits can be directly instituted in these courts without approaching the district courts first.

While the suit for infringement of a patent can be instituted in any of the district courts, in cases where the defendant challenges the validity of the patent in its defence, such cases are transferred to the High Court.

Vatika Towers  
10th Floor Block-B  
Sector-54  
Gurgaon-122002  
National Capital Region (Haryana)  
India

Tel. +91 124 4655999  
Fax. +91 124 4045047  
Email [info@rnaip.com](mailto:info@rnaip.com)

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