

Role of Indian Patent Office as ISA & IPEA under the PCT

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Which ISA(s) is (are) competent (Rule 35)

- The competent ISA(s) is (are) specified by the RO
- If more than one is specified by the RO, the applicant has the choice:
 - in making that choice, the applicant must take into account the language(s) accepted by the ISA (a translation of the international application for the purposes of international search may be required in certain cases (Rule 12.3))
- If the international application is filed with RO/IB, the competent ISAs will be those which would have been competent if the international application had been filed with (any of) the national or regional Office(s) which, on the basis of applicant's nationality or residence, could be a competent RO
- Choice of ISA to be indicated in the request (Box No. VII)

ISA/IPEA for Indian Applicant

- **India**
- Australia
- Austria
- China
- Sweden
- United States of America
- European Patent Office

Language for examination – English

ISA/IN AND IPEA/IN

- ❖ Indian Patent office starts functioning as ISA & IPEA under the PCT on 15th October, 2013
- ❖ More than 550 examiners trained in ISA & IPEA
- ❖ More than 200 examiners working in ISA/IPEA from different field of science and engineering
- ❖ More than 6000 search copies received and examined by ISA/IN since October, 2013

The International Searching Authority

- Checks unity of invention (Rules 13 and 40), Checks title (Rule 37); checks abstract (Rule 38) Searches claimed invention (Article 15(3), Rule 33.3)
- Authorizes rectification of obvious mistakes if the mistake is:
 - in any part of the international application other than the request, (Rule 91.1(b)(ii)) or
 - in any paper submitted to that Authority (Rule 91.1(b)(iv))
- Establishes international search report (ISR) (Rules 42 and 43) and/or
- declaration that no international search report will be established (Article 17(2))
- Establishes written opinion of the ISA (Rule 43*bis*):
- non-binding first opinion on novelty, inventive step

International Search Report (ISR) (Rules 42 and 43)

❖ Contains:

- IPC (International Patent Classification) symbols
- indications of the technical areas searched
- indications relating to any finding of lack of unity
- a list of the relevant prior art documents
- indications relating to any finding that a meaningful search could not be carried out in respect of certain (but not all) claims

❖ Time limit to establish ISR and written opinion of the ISA:

- 3 months from the date of receipt of the search copy by the ISA (usually within approximately 16 months from the priority date if priority is claimed); or
- 9 months from the priority date, whichever time limit expires later

Written opinion of the ISA (Rule 43*bis*)

Initial preliminary non-binding opinion on:

- novelty (not anticipated)
- inventive step (not obvious)
- industrial applicability
- A written opinion will be established for all international applications at the same time as the ISR
- The written opinion is sent to applicant and the International Bureau together with the ISR
- The written opinion is NOT published together with the application
- No formal procedure for applicants to respond to written opinion of the ISA
- Possibility to submit informal comments to the International Bureau which will communicate such comments to DOs together with the IPRP (Chapter I) if and when it is sent

Who is entitled to make a demand? (Article 31(2)(a) and Rule 54.2)

- The applicant, or if there are two or more applicants, at least one of them,
- who is a resident or national of a PCT Contracting State bound by Chapter II, and
- whose international application has been filed with a receiving Office of or acting for a Contracting State bound by Chapter II (currently all States)

Where to file the demand? (Rule 59) (1)

- Directly with the competent IPEA
- The competent IPEA(s):
 - is (are) specified by the RO
 - if more than one is specified by the RO, applicant has the choice
- In making his choice, the applicant must take into account:
 - the language(s) accepted by the IPEA
 - that some IPEA(s) accept only international applications which have been searched by certain ISAs (that is the case, for example, of IPEA/EP)

At what time should a demand be filed? (Rule 54**bis**. 1(a)) (1)

■ At any time prior to the expiration of whichever of the following

periods expires later:

3 months from the date of transmittal of the ISR and WO of the ISA

22 months from the priority date

■ In respect of designated Offices for which the 20-month time limit under Article 22(1) continues to apply, prior to the expiration of 19 months from the priority date, in order to delay national phase from 20 to 30 months from the priority date

■ International preliminary examination will not start before the expiration of the time limit under Rule 54**bis**. 1(a) unless applicants expressly request earlier start

The international preliminary report on patentability (Chapter II) (1)

- Must be established by the IPEA within:
- 28 months from the priority date
- 6 months from the time provided under Rule 69.1 for the start of the international preliminary examination
- 6 months from date of receipt by IPEA of translation under Rule 55.2,
- whichever expires last (Rule 69.2)

WHY OPTING ISA/IPEA INDIA?

- ✘ Competitive very less search and examination fee
- ✘ Opportunity to get expedited examination of applications under Patents Act (Rule 24C)
- ✘ Quality report
- ✘ Timely report issued

PCT YEARLY REVIEW 2019

- ❖ Of the top 10 ISAs, the office of India (+48.7%) recorded the most pronounced growth, whereas KIPO (-7%) and the office of Israel (-5.9%) experienced the sharpest decreases.
- ❖ India transmitted more than 99% of such ISRs within three months.
- ❖ Timeliness in transmitting international search reports to the International Bureau, measured from priority date by international searching authority, 2018 India - 99.5%
- ❖ Timeliness in transmitting international search reports to the International Bureau, measured from date of receipt of the search copy by international searching authority, 2018 India-99.1%

Quality Policy

Vision

Our policy is to achieve and maintain the best standards of quality in all our products and services.

Mission

We, at the Indian Patent Office, identify the following yardsticks determining the quality of our products and services-

Reliability of our search reports,

Consistency in our examination reports,

Timeliness in delivering services,

Correctness of data while providing patent information

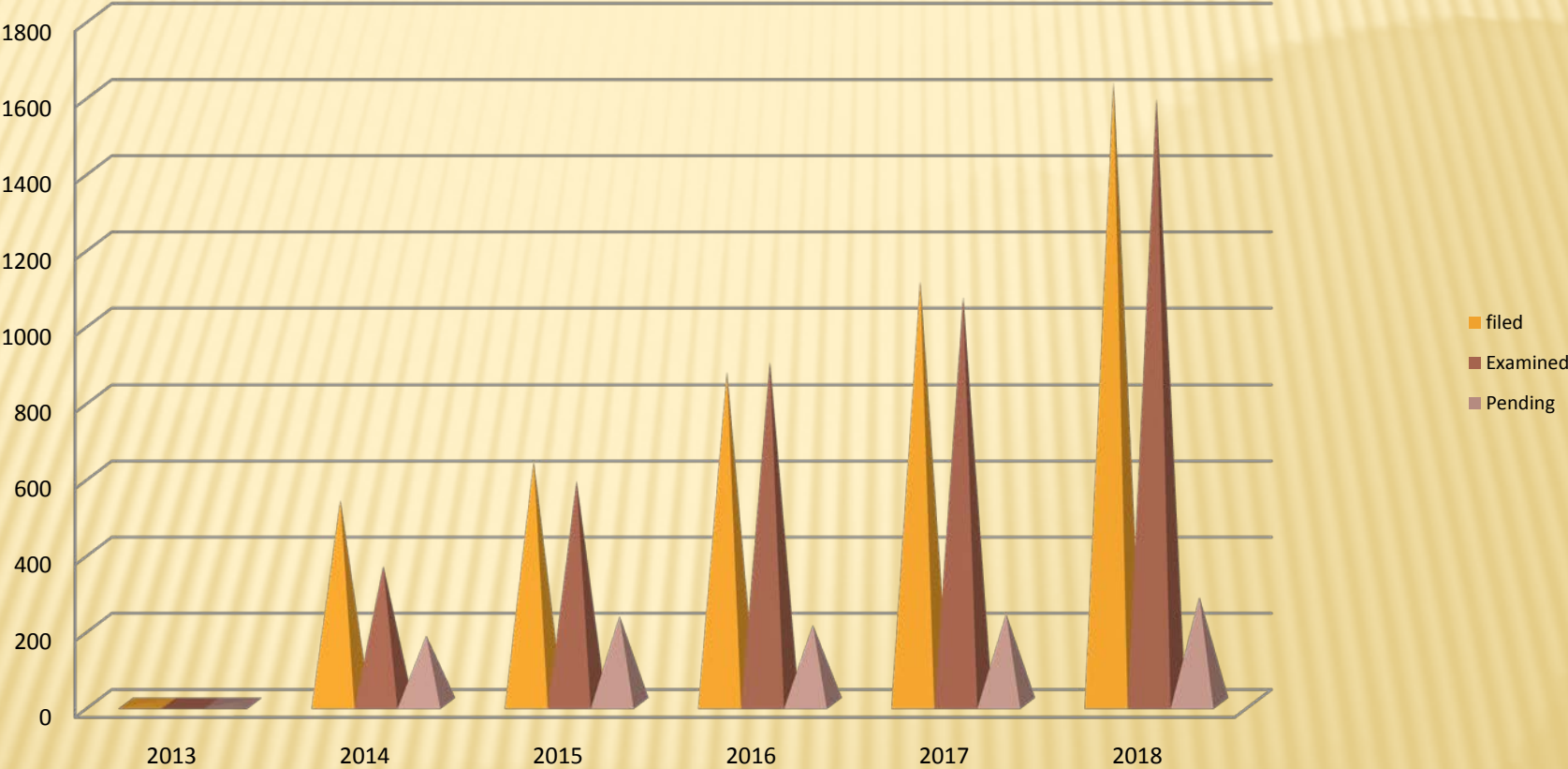
Real time dissemination of information

Stakeholder satisfaction encouraging feedbacks and being responsive and

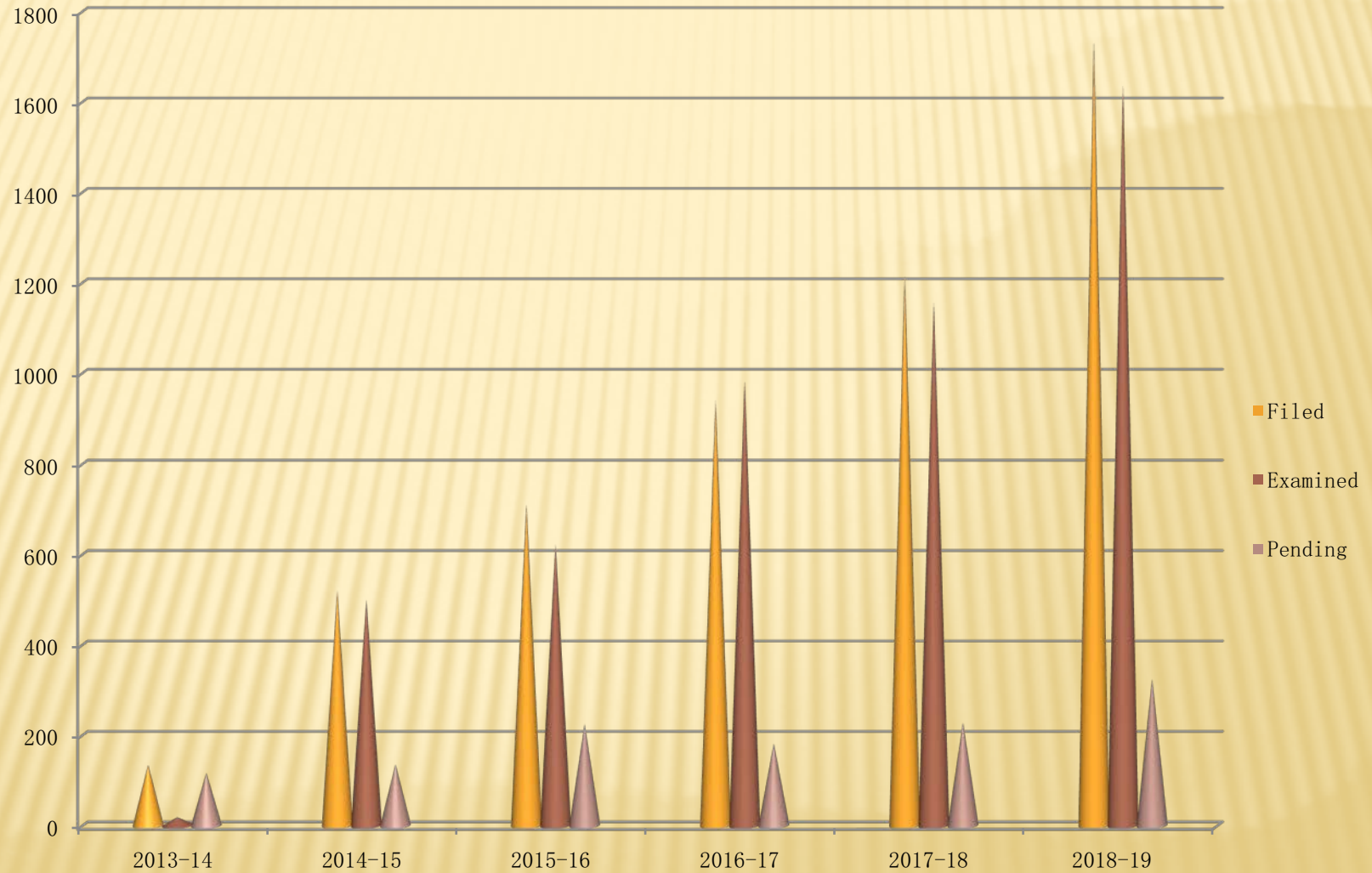
Kind of Fee or Charges	Amount (INR)
1 Search fee (<u>Rule 16.1(a)</u>)	10000 (2500) "
2 Additional fee (<u>Rule 40.2(a)</u>)	10000 (2500) "
3 Protest fee (<u>Rule 40.2(e)</u> and <u>68.3(e)</u>)	4000 (1000) "
4 Late furnishing fee (<u>Rule 13ter.1(c)</u> and <u>13ter.2</u>)	4000 (1000) "
5 Preliminary examination fee (<u>Rule 58.1(b)</u>):	
- where the international search report was issued by the Authority	10000 (2500) "
-in other cases	12000 (3000) "
6 Additional fee (<u>Rule 68.3(a)</u>):	
-where the international search report was issued by the Authority	10000 (2500) "
-in other cases	12000 (3000) "
7 Cost of copies (<u>Rules 44.3(b)</u> , <u>71.2(b)</u> and <u>94.2</u>), per page	10

" *The amount in parentheses is applicable in case of filing by an individual.*

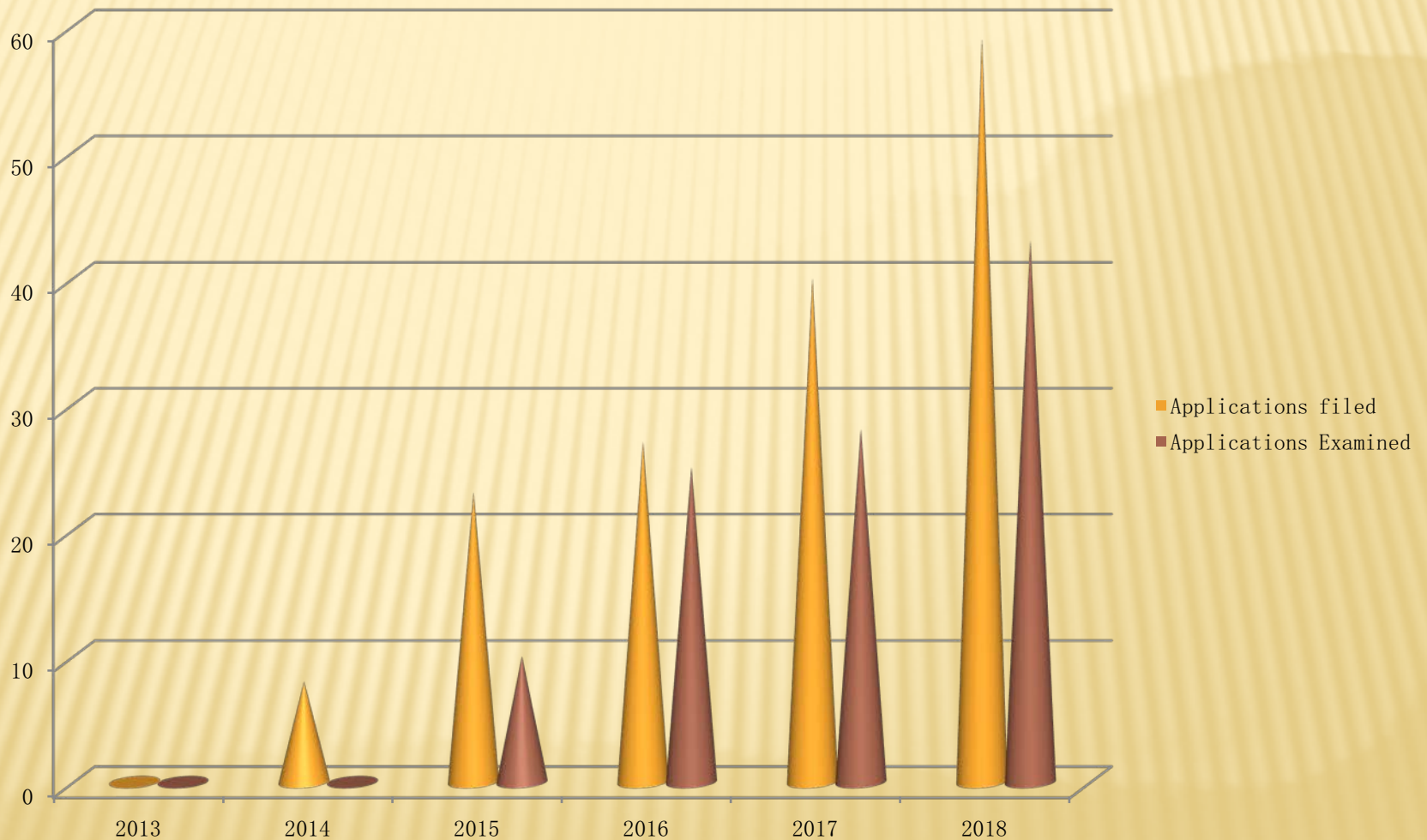
ISA applications filed, examined and pendency in Calendar years



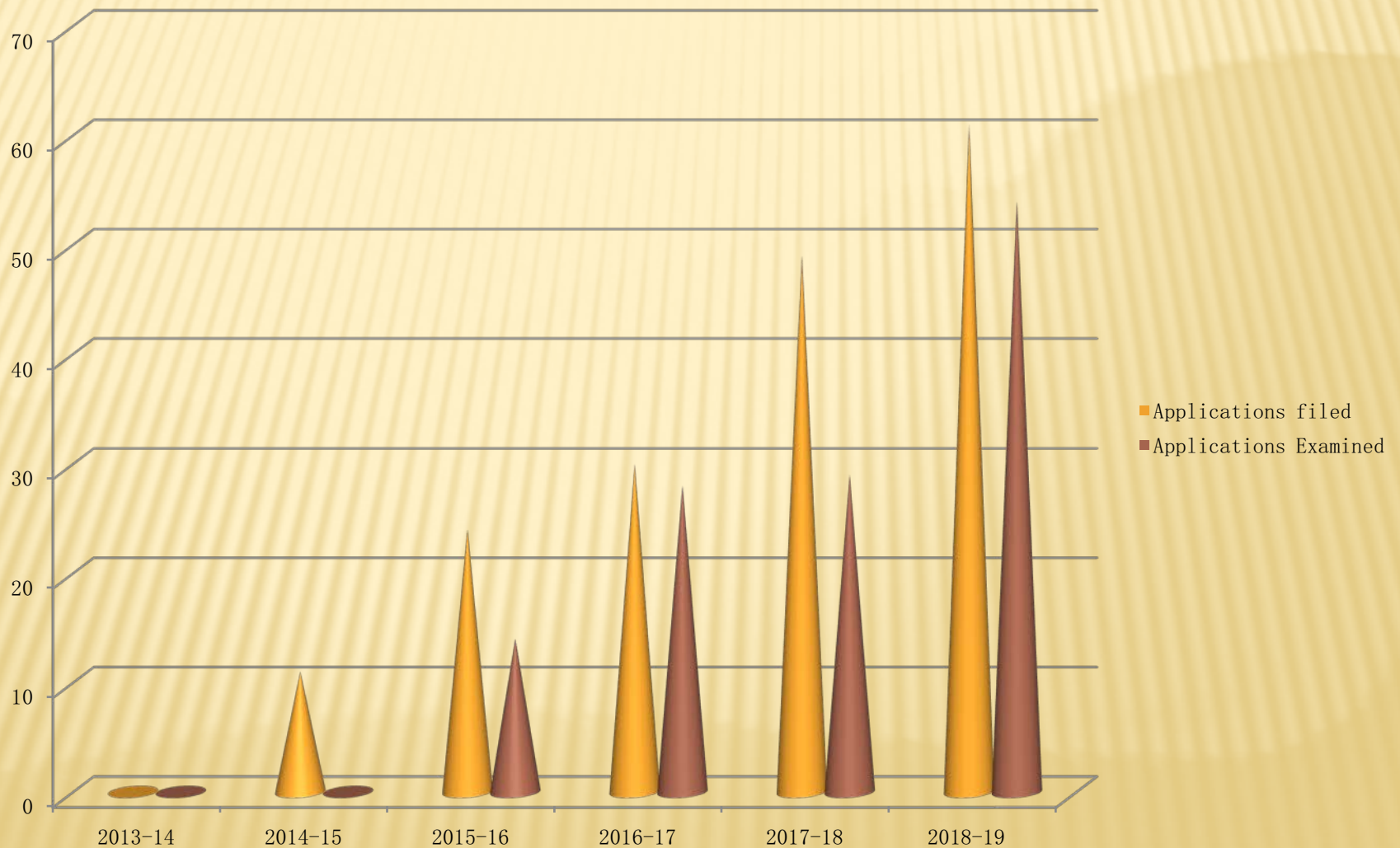
ISA APPLICATIONS FILING, EXAMINED AND PENDING



IPEA APPLICATIONS FILED, EXAMINED IN CALENDAR YEAR



IPEA APPLICATIONS FILED ,EXAMINED IN FINANCIAL YEAR





Thanks