Patent Office Procedures
The page on Patents on website of the Intellectual Property Office, India can be accessed at http://ipindia.nic.in/ipr/patent/patents.htm

History of Indian Patent System

1856
THE ACT VI OF 1856 ON PROTECTION OF INVENTIONS BASED ON THE BRITISH PATENT LAW OF 1852. CERTAIN EXCLUSIVE PRIVILEGES GRANTED TO INVENTORS OF NEW MANUFACTURERS FOR A PERIOD OF 14 YEARS.

1859
THE ACT MODIFIED AS ACT XV. PATENT MONOPOLIES CALLED EXCLUSIVE PRIVILEGES (MAKING, SELLING AND USING INVENTIONS IN INDIA AND AUTHORIZING OTHERS TO DO SO FOR 14 YEARS FROM DATE OF FILING SPECIFICATION).

1872
The Patents and Designs Protection Act (Act XIII of 1872)

1883
THE PROTECTION OF INVENTIONS ACT.

1888
CONSOLIDATED AS THE INVENTIONS & DESIGNS ACT.

1911
THE INDIAN PATENTS & DESIGNS ACT.

1972

1999

2002
THE PATENTS (AMENDMENT) ACT 2002 CAME INTO FORCE FROM 20TH MAY 2003

2005
THE PATENTS (AMENDMENT) ACT 2005 EFFECTIVE FROM 1ST JANUARY 2005
Importance of patents

- Important source of scientific and technical literature
- A treasure-house of scientific inventions
- Avoids duplication
- Paves way for further discoveries
- Stop re-inventing the wheel
- Identifies emerging technologies, emerging areas
What does a patent do?

- Protects intellectual property for 20 years
  - no one else can manufacture the product
  - some one can pay you royalties
  - you can block competitors

- After 20 years, technology goes to public domain
What is patent

- It is a statutory right to the inventor or the applicant by the government for his invention which is either a new process or product.
- It is for the limited period of time.
- It is granted in lieu of sufficient disclosure to the patent offices.
- It is only territorial right.
- It is a negative right.
What is patent

However patent is not an absolute right

This is subject to certain conditions like-

- Government Use
- Importation or manufacturing by or on behalf of the government
- Experimental purpose
- Research purpose
- Teaching purpose
- Distribution of drug or medicine by government in dispensary, hospital or other medical institutions rendering public service or on behalf of the government
- Used for Foreign vessels, aircraft, land vehicles which have temporarily or accidentally come to India
What are Patent Rights

✓ To prevent third party without authorization-
✓ Making or manufacturing
✓ Using,
✓ Offering for sale
✓ Selling,
✓ Importing
✓ Distributing
✓ Licensing
Patentable subject matter

- Any article, apparatus or machinery or its component
- Any substance whether living or non living, product, pharmaceutical product
- Any composition of matter, pharmaceutical products
- Any process, manner or art of manufacturing other than essential biological process
Scope of Patentability Under The Patents Act
What is an Invention?

Sec.2(1)(j)

“Invention” means a new product or process involving an inventive step and capable of industrial application.
Basic criteria of patentability

The 3 basic criteria which any invention must meet in order to deserve a patent:

Novelty

Non-obviousness

Industrial application
Patentable subject matter

Invention must

- relates to a **Process** or **Product** or both
- be new **(Novel)**
- involves an **inventive step**
- be Capable of **industrial application**
- not fall under **Section 3 and 4**
“NEW” MEANS

Invention must not be

- Published in India or elsewhere
- In prior public knowledge or prior public use with in India
- Claimed before in any specification in India
Inventive step

A **feature of an invention** that involves technical advance as compared to the existing knowledge or have economic significance or both and makes the invention not obvious to a person skilled in the art.
Industrial application means

Invention is capable of being made or used in any kind of industry.
What is not Patentable

- Inventions falling within the scope of Sec. (3) of Patents Act, 1970.
- Inventions falling within the scope of Sec. (1) of Sub-sec. 20 of Atomic Energy Act, 1962-
  - For Example: Inventions relating to Compounds of -
    - Uranium, Beryllium, Thorium, Plutonium, Radium, Graphite, Lithium and more as notified by Central Govt. from time to time
3(a): frivolous or anything obviously contrary to well established natural laws

3(b): contrary public order or morality serious prejudice to human, animal or plant life or health or to the environment

3(c): the mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substances occurring in nature

3(d): the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance

3(e): a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substances;

3(f): the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way

3(h): a method of agriculture or horticulture
### Inventions Not Patentable - Sec 3

| **3(i):** | any process for the medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of animals to render them free of disease or to increase their economic value or that of their products. |
| **3(j):** | plants & animals in whole or any part thereof other than microorganisms but including seeds, varieties and species and essentially biological processes for the production or propagation of plants and animals; |
| **3(k):** | a mathematical or business method or a computer programme *per se* or algorithms |
| **3(l):** | a literary, dramatic, musical or artistic work or any other aesthetic creation |
| **3(m):** | mere scheme or rule or method of performing mental act or method of playing game |
| **3(o):** | topography of integrated circuits |
| **3(p):** | an invention which in effect is traditional knowledge or which is an aggregation or duplication of known properties or traditionally known component or components. |
Process of Patenting

• Be curious but do not disclose your invention
• Keep a bound notebook to prove when you got the idea
• Develop the idea and produce a model
• Write why your invention is needed, what the existing products are in the market, your new product, and what is unique about your product
Filing of the Application

Physical filing at the Patent Office

Electronic filing
(July 20, 2007)
Where to file patent application

- The appropriate office of the patent office shall be the head office of the patent office or the branch office as the case may be within whose territorial limits ...
  - Residence of applicant or Domicile; or
  - His the place of business; or
  - The place where the invention actually originated.

- If the applicant has no business or domicile in India, the address for service in India is given by such applicant

<table>
<thead>
<tr>
<th>Office</th>
<th>Territorial Jurisdiction</th>
</tr>
</thead>
<tbody>
<tr>
<td>Patent Office Branch, Chennai</td>
<td>The States of Andhra Pradesh, Karnataka, Kerala, Tamil Nadu and the Union Territories of Pondicherry and Lakshadweep</td>
</tr>
<tr>
<td>Patent Office Branch Mumbai</td>
<td>The States of Maharashtra, Gujarat, Madhya Pradesh, Goa and Chhattisgarh and the Union Territories of Daman and Diu &amp; Dadra and Nagar Haveli.</td>
</tr>
<tr>
<td>Patent Office, HO Kolkata</td>
<td>The rest of India</td>
</tr>
</tbody>
</table>
How to file a patent application?

- Documents can be filed in the patent office
  - through online (e-filing) or
  - [www.ipindiaonline.gov.in/online](http://www.ipindiaonline.gov.in/online)
  - through post or
  - can be submitted by hand
GENERAL PROCEDURE FOR OBTAINING A PATENT

- Filing of patent application
- Publication after 18 months
- Pre Grant Opposition /Representation by any person.
- Request for examination
- Examination: Grant or Refusal
- Publication of Grant of patent
- Post Grant Opposition to grant of patent
- Decision By Controller
Part of a Patent-techno-legal document

- **Legal Information**
  - Name, address, contact details
  - inventor,
  - assignee,
  - Assignments
  - Details of foreign filing

- **Technical information** (Specification)

- **Form 1**
- **Form 2**
- **Form 3**
- **Form 18**
- **Form 9**
- **Form 26**

- **Background of the invention**
  - describes the need for the invention

- **Summary of the invention**
  - describes how the invention works
  - someone should be able to duplicate your work
  - the preferred embodiment
  - examples

- **Claims**
  - most important part
  - independent claims
  - dependent claims

- **Abstract**
Simple Graphical Representation of Patent Granting Procedure

- Patent Application
  - Publication
  - Pre Grant opposition
- Examination
- Application Grant
  - Publication of Grant
- Post Grant Opposition
Steps

• To get a patent grant, the first most step is to file a patent application.

❖ Who can file a patent application?
❖ Where to file a patent application?
❖ How to file a patent application?
Documents required for filing of a Patent Application

1. Covering letter- indicating the list of documents;
2. Application for Grant of Patent in Form 1 [section 7, 54 & 135 and Rule 20(1)] in duplicate;
3. Complete/Provisional specification in Form 2 in duplicate [Section 10; Rule 13]
4. Statement and Undertaking in Form 3 [Section 8; Rule 12];
5. Power of Attorney in Form 26 (in original) (Rule 3.3 (a) (ii)); (if filed through attorney)
6. Declaration of Inventor-ship in Form 5 (only in case of an Indian Application; (Rule 4.17);
7. Request for examination: F18
Who can file Patent Application

In India [Section 6 and 134]

• The application can be filed either alone or jointly:

- By any person claiming to be true and first inventor(s)
- By any person being the assignee of person claiming to be true and first inventor(s)
  (proof of assignment has to be submitted along with the application)
- By the legal representative of any deceased person or assignee
Essential ingredients of Complete Specification

- Title and Preamble
- Prior art
- Drawbacks in prior art
- Efforts or Solution to Drawbacks
- Summary Of the Invention
- Statement of invention
- Detail description of invention
- Detail description with reference to drawings
- Examples
- Claims
Main steps of Patenting Procedure

• Filing of application at the Patent Office
• Filing of request for examination
• Publication
• Examination
• Pre-grant Opposition
• Grant of Patent
• Post-grant Opposition
Patent Grant in India

1. Conceptualizing an invention
2. Filing of application
3. With complete specification
4. With provisional specification
5. Filing complete within 12 months after provisional

- YES
  - Pre-grant opposition U/s 25(1)
  - EXAMINATION [for patentability & other requirements]
  - F.E.R. Issued.

- IF NOT
  - Application ABANDONED

- REQUEST for EXAMINATION on Form-18 within 48 months from date of priority.
F.E.R. ISSUED

- Re-Examination of amended documents
- Controller offers a hearing to the applicant.
- Application is to be put in order within 12 months from issue of FER

Objections not met within 12 months

ABANDONED

Objections met within 12 months

Grant of Patent u/s 43 and publication of grant

Post grant opposition u/s 25(2)
THE FEE SCHEDULE

http://ipindia.nic.in/ipr/patent/patent_FormsFees/Fees.pdf
For any queries
www.ipindia.nic.in