

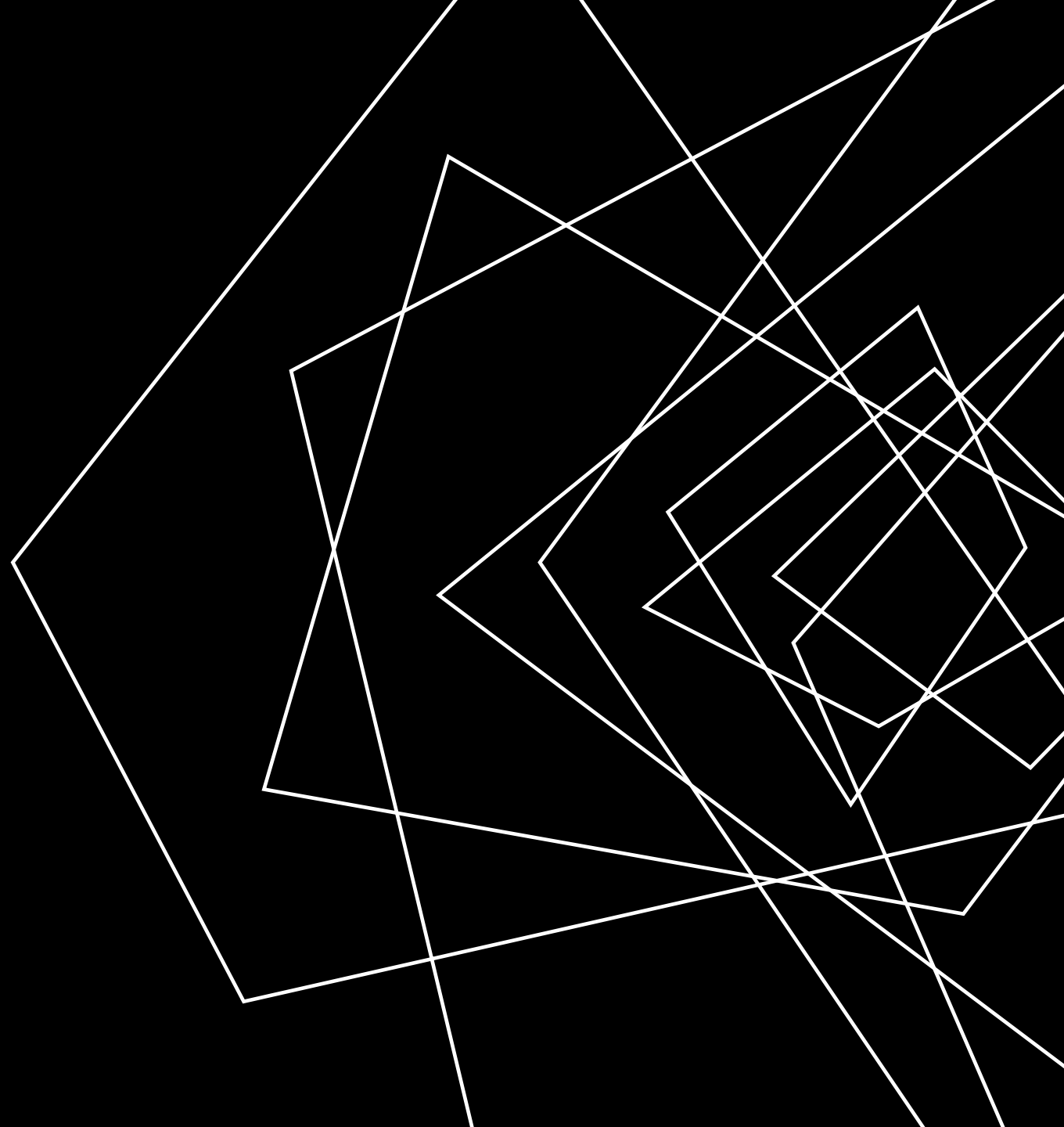
# PATENT PROSECUTION

Dr. (Ms) Sonali Correa

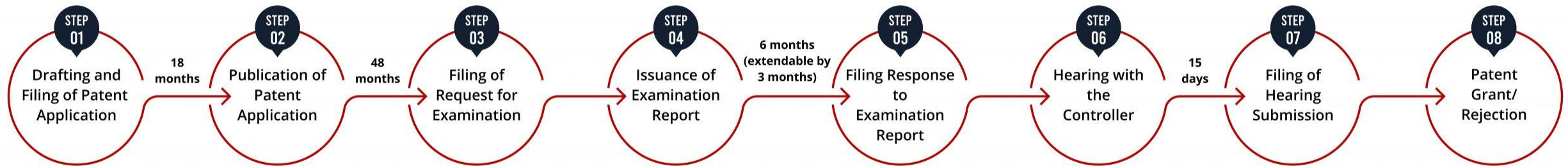
MSc., Ph.D.

## DEFINITION

Patent prosecution is a process where applicants and/or their representatives interact with the Patent Office to get a grant for their patent application.



# THE PATENT PROSECUTION SYSTEM IN INDIA



**\*Note:** Time periods are only mentioned against the steps which have specific timeframes.

**Total time:** Under the expedited examination process, patent applications are now being granted within a period of 8 months to 2 years instead of 3-6 years.

A series of black lines of varying thicknesses and orientations intersecting in the top-left corner of the page, creating a complex geometric pattern.

Every patent prosecution begins with the filing of a patent application before the Indian Patent Office

Post filing, the office verifies the documents to confirm the completeness of all the requirements.

The application is sent for a technical examination to check whether the invention meets the **three basic requirements of patentability**, i.e., novelty, inventiveness, and industrial applicability.

During this examination stage, the examiner having expertise in the particular technical domain judiciously examines the application.

In case the examiner has any objection(s) in terms of patentability or formal requirements in the application, he/she incorporates those objections in an examination report and sends it to the applicants or their representatives for submitting their response within the stipulated time.

# PHASES OF PATENT PROSECUTION

# Phases of Patent Prosecution

Pre-grant  
prosecution

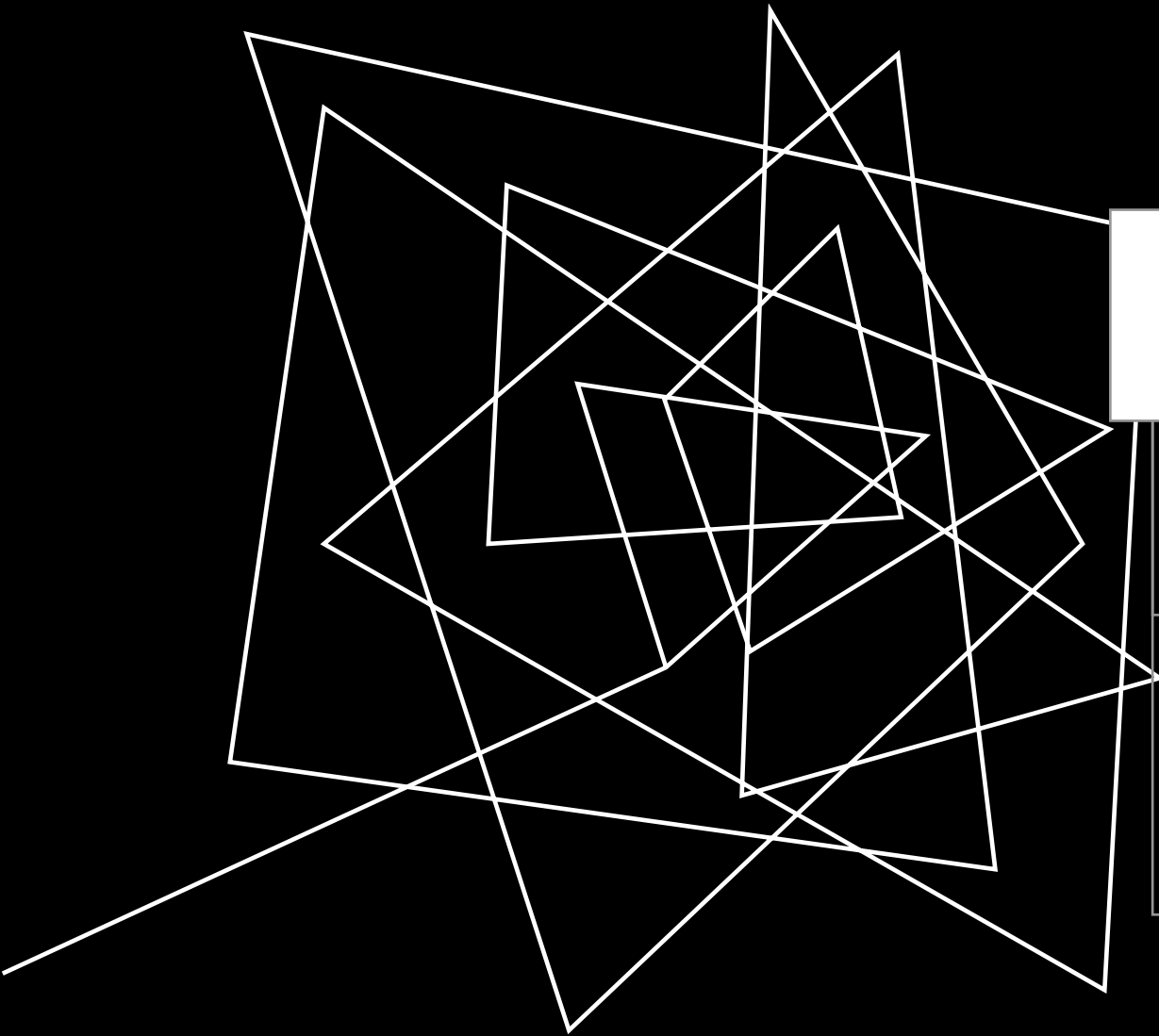
Post-grant  
Prosecution

involves the  
examination process  
conducted by the  
Patent Office

issuance of an  
examination report by  
the Office & drafting  
and filing a response

Takes place after the  
grant of a patent

include post-grant  
oppositions and post-  
grant amendments.



# PRE-GRANT PROSECUTION STAGES



## 1.Filing and Publication

A patent application must be filed with the Indian Patent Office to get a patent.

This application can be a provisional or a non-provisional/complete application.

In India, the Patent Office functions from four jurisdictions viz. Kolkata, Delhi, Chennai, and Mumbai.

- The application must be filed at the appropriate jurisdiction which is decided based on the following requirements:
  - *Applicant's place of residence, domicile, or place of business (first applicant in case of joint applicants) or,*
  - *The place from where an invention originated or,*
  - *In case of a foreign applicant, the address for service in India given by the applicant.*
- Non-provisional application is carefully drafted and filed with the Patent Office with all the necessary documents along with the prescribed fees, the Office assigns a unique patent application number and **filing date or priority date** to the application for reference and record purposes.
- First-filed applications are also known as a “priority application” and its date of filing is referred to as “priority date”
- after the expiry of 18 months from the filing date or priority date, the patent application gets published in the Official Gazette of India and comes into the public domain.



- To fast-track the overall process, a request for publication ([Form 9](#)) can be filed any time after filing the application with the Patent Office
- The application gets published within one month from the date of filing such a request.
- The applicant gets all the patent rights from the date of publication of a patent application
- These rights can only be claimed if the application is ultimately granted into a patent and only after the final grant.

## 2. Search and Examination

This is the most important step of the prosecution process that decides the fate of a patent application.

- The Patent Office reviews all the formal documents, and the patent examiners conduct a worldwide patentability search based on the key features of the invention to check for any closest prior art that is relevant to the application in question.
- Based on these **prior arts**, the examiner decides whether the invention for which a patent application has been filed is **novel, inventive, and capable of industrial application**
- The examiner also looks for those inventions that are strictly excluded from patentability and are known as “non-patentable inventions”, examination stage takes 3-6 years.
- This process can be accelerated to reduce the time to 8 months to 2 years provided they file a request for expedited examination of their application

For filing the expedited examination request, the application needs to be already published. If it is not published, then a request for early publication must be filed. The eligibility criteria for filing the expedited examination request include:

- Applicant has chosen India as an International Searching Authority (ISA) or as an International Preliminary Examining Authority (IPEA) in a corresponding PCT application.
- Applicant is a Start-up.
- Applicant is a small-entity.
- Applicant is a female or in case of joint applicants where all the applicants are natural person, at least one of the applicants is female.
- Applicant is a department of the Government, or an institution owned or controlled or financed by the Government.
- Applicant is eligible under a bilateral agreement between IPO and a foreign patent office.
- Applicant is an eligible educational institution which is owned or controlled by the Government.

### **3. Issuance of Examination Report**

- Examiner finds that the invention lacks novelty or inventiveness in relation to any prior art, or it falls within the ambit of “non-patentable inventions”, then he/she enlists such objections in an examination report and sends it to the applicant or their representatives.
- The applicant must overcome every objection cited in the report within the prescribed time to proceed further with the process. If the applicant fails to submit his/her response within the time limit, then the application gets abandoned.

### **4. Response to Examination Report**

- An applicant may decide to modify or amend the specification, claims, or drawings; which **is in scope with the original application**
- After receiving the response, the examiner reviews all the arguments or amendments that the applicant has submitted and proceeds to the next step.

## **5. Subsequent Examination Reports or Hearing Before the Examiner**

- If the examiner is satisfied with the arguments or amendments, then he/she proceeds by issuing a patent certificate to the applicant.
- If the examiner is unsatisfied with the applicant's response to the examination report, then he/she can issue a second examination report or a hearing notice to resolve the matter.
- The applicant gets another opportunity to submit his/her response to the second examination report or appear for a hearing before the examiner and file a hearing submission within the prescribed time

## **6. Pre-Grant Opposition**

- The search and examination mainly take place between the examiner and the applicant.
- In some jurisdictions such as India, any third party called "the opponent" can oppose the grant of a patent based on certain grounds.
- This can be done immediately after the publication of the application but before the patent grant. Under [Section 25 \(1\)](#) of the Patents Act, a pre-grant opposition can be filed by "*any person*" without paying the official filing fees.

## **Section 25**

### **Opposition to Patents**

Where an application for a patent has been published but a patent has not been granted, any person may, in writing, represent by way of opposition to the Controller against the grant of patent on the ground—

(a) that the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim—

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document:

Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or subsection (3) of section 29;

(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant's claim;

(d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

*Explanation.*—For the purposes of this clause, an invention relating to a process for which a patent is claimed shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only;

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the applicant's claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(h) that the applicant has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge;

(i) that in the case of a convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title;

(j) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;

(k) that the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere, but on no other ground, and the Controller shall, if requested by such person for being heard, hear him and dispose of such representation in such manner and within such period as may be prescribed.

(3) (a) Where any such notice of opposition is duly given under sub-section (2), the Controller shall notify the patentee.

(b) On receipt of such notice of opposition, the Controller shall, by order in writing, constitute a Board to be known as the Opposition Board consisting of such officers as he may determine and refer such notice of opposition along with the documents to that Board for examination and submission of its recommendations to the Controller.

(c) Every Opposition Board constituted under clause (b) shall conduct the examination in accordance with such procedure as may be prescribed.

(4) On receipt of the recommendation of the Opposition Board and after giving the patentee and the opponent an opportunity of being heard, the Controller shall order either to maintain or to amend or to revoke the patent.

(5) While passing an order under sub-section (4) in respect of the ground mentioned in clause (d) or clause (e) of sub-section (2), the Controller shall not take into account any personal document or secret trial or secret use.

(6) In case the Controller issues an order under sub-section (4) that the patent shall be maintained subject to amendment of the specification or any other document, the patent shall stand amended accordingly.



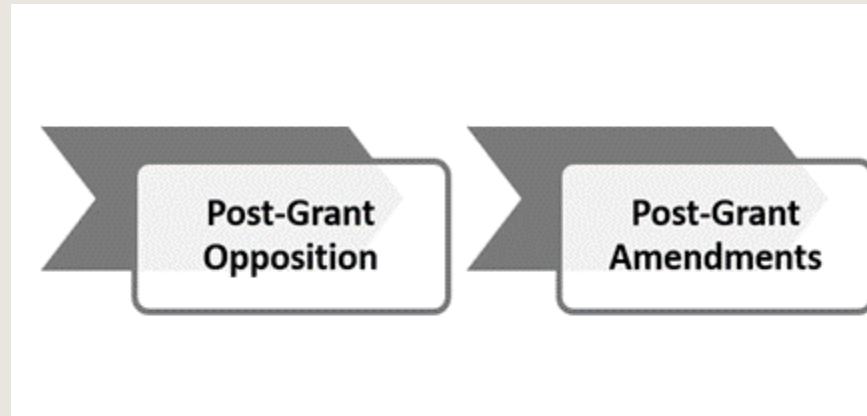
## **7. Decision of the Examiner**

The examiner once again reviews the documents submitted by the applicant and makes a final decision of whether to proceed with the grant or refusal. In case a pre-grant opposition has been filed against a patent application, then a hearing notice is issued to both the applicant and the opponent before passing the final order.

The applicant decides to opt for international protection via the Convention or Patent Cooperation Treaty (PCT) route. In such cases, the applicant must file a PCT or convention application within 12 months after filing the first application or the priority application and then prosecute his/her applications in different countries independently as each country has different patent laws.

Through the PCT or Convention route, an applicant can also file a patent application directly in foreign countries (without filing in India) but has to take a written permission or Foreign Filing Licence (FFL) from their local patent office. Since this process can be a tricky, taking assistance from patent experts or legal counsels can be extremely beneficial in increasing the likelihood of getting a patent.

# POST-GRANT PROSECUTION STAGES



## 1. Post-Grant Opposition

- In India, under Section 25 (2) of the Patents Act, a post-grant opposition can be filed after the grant of a patent but within one year from the date of publication of the grant of a patent based on any of the grounds described under the said section.
- Unlike pre-grant opposition, post-grant opposition can be filed by a “*person interested*” only and he/she must pay the prescribed official fees based on the entity status. Another difference between the two oppositions lies in the formation of an Opposition Board at the Patent Office to examine the documents filed by the opponent and the patentee, and in furnishing a recommendation in the post-grant opposition. Subsequently, the examiner issues a hearing notice to both the parties and decides whether the patent can be maintained, revoked, or amended.

(2) At any time **after the grant of patent but before the expiry of a period of one year from the date of publication of grant of a patent**, any person interested may give notice of opposition to the Controller in the prescribed manner on any of the following grounds, namely:—

(a) that the patentee or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim—

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document: Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 29;

(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the claim of the patentee and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the claim of the patentee;

d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

*Explanation.*—For the purposes of this clause, an invention relating to a process for which a patent is granted shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only;

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(h) that the patentee has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge;

(i) that in the case of a patent granted on a convention application, the application for patent was not made within twelve months from the date of the first application for protection for the invention made in a convention country or in India by the patentee or a person from whom he derives title;

(j) that the complete specification does not disclose or wrongly mentions the source and geographical origin of biological material used for the invention;

(k) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere, but on no other ground.

## 2. Post-Grant Amendments

[Section 57](#) and [Section 59](#) of the Patents Act provides the provision of both pre-grant and post-grant amendments. Section 59 states that the proposed amendments must meet the following requirements:

- Amendments should be by way of correction, disclaimer, or explanation.
- Amendments must be made for the incorporation of a fact.
- Amendments to the specification or claims should not go beyond the subject matter of originally filed specification or claims, respectively.

Such amendments may include the following details:

- Amendments in name, address, as well as the address for service.
- Amendments in the complete specification including description, claims, and priority date of a claim.

Additionally, [Section 78](#) empowers the examiner to correct any clerical error, which may either be requested by any person interested or even without such a request.

## **Section 57**

### **Amendment of application & specification or any document relating thereto before Controller**

(1) Subject to the provisions of section 59, the Controller may, upon application made under this section in the prescribed manner by an applicant for a patent or by a patentee, allow the application for the patent or the complete specification or any document relating thereto to be amended subject to such conditions, if any, as the Controller thinks fit:

Provided that the Controller shall not pass any order allowing or refusing an application to amend an application for a patent or a specification or any document relating thereto under this section while any suit before a court for the infringement of the patent or any proceeding before the High Court for the revocation of the patent is pending, whether the suit or proceeding commenced before or after the filing of the application to amend

(2) Every application for leave to amend an application for a patent or a complete specification or any document relating thereto under this section shall state the nature of the proposed amendment, and shall give full particulars of the reasons for which the application is made.

(3) Any application for leave to amend an application for a patent or a complete specification or a document related thereto under this section made after the grant of patent and the nature of the proposed amendment may be published.

(4) Where an application is published under sub-section (3), any person interested may, within the prescribed period after the publication thereof, give notice to the Controller of opposition thereto; and where such a notice is given within the period aforesaid, the Controller shall notify the person by whom the application under this section is made and shall give to that person and to the opponent an opportunity to be heard before he decides the case.

(5) An amendment under this section of a complete specification may be, or include, an amendment of the priority date of a claim.

(6) The provisions of this section shall be without prejudice to the right of an applicant for a patent to amend his specification or any other document related thereto to comply with the directions of the Controller issued before the grant of a patent.

## **Section 58**

### **Supplementary provisions as to amendment of application or specification**

(1) No amendment of an application for a patent or a complete specification or any document relating thereto shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of incorporation of actual fact, and no amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

(2) Where after the date of grant of patent any amendment of the specification or any other documents related thereto is allowed by the Controller or by the Appellate Board or the High Court, as the case may be,—

(a) the amendment shall for all purposes be deemed to form part of the specification along with other documents related thereto;

(b) the fact that the specification or any other documents related thereto has been amended shall be published as expeditiously as possible; and

(c) the right of the applicant or patentee to make amendment shall not be called in question except on the ground of fraud.

(3) In construing the specification as amended, reference may be made to the specification as originally accepted.



## **Section 78**

### **Power of Controller to correct clerical errors etc**

(1) Without prejudice to the provisions contained in sections 57 and 59 as regards amendment of applications for patents or complete specifications or other documents related thereto and subject to the provisions of section 44, the Controller may, in accordance with the provisions of this section, correct any clerical error in any patent or in any specification or other document filed in pursuance of such application or in any application for a patent or any clerical error in any matter which is entered in the register.

(2) A correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.

(3) Where the Controller proposes to make any such correction as aforesaid otherwise than in pursuance of a request made under this section, he shall give notice of the proposal to the patentee or the applicant for the patent, as the case may be, and to any other person who appears to him to be concerned, and shall give them an opportunity to be heard before making the correction.

(4) Where a request is made under this section for the correction of any error in a patent or application for a patent or any document filed in pursuance of such an application, and it appears to the Controller that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons affected thereby, he shall require notice of the nature of the proposed correction to be published in the prescribed manner.

(5) Within the prescribed time after any such publication as aforesaid any person interested may give notice to the Controller of opposition to the request, and, where such notice of opposition is given, the Controller shall give notice thereof to the person by whom the request was made, and shall give to him and to the opponent an opportunity to be heard before he decides the case.



## CONCLUSION

Patent prosecution decides the fate of a patent application. Thus, it is important to have a strong legal team by your side that assists you and represents your application at each step because even the slightest negligence may result in rejection or abandonment of the application.



THANK YOU