**1.** Is it necessary to file a provisional application? Can a provisional application be examined and proceed to grant?

When an invention is not complete an application can be filed with a provisional specification which is known as provisional application. This is useful in establishing a priority date for the invention. Moreover, it also 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. An application filed with a provisional specification cannot be examined. In order to be examined, a complete specification has to be filed.

**2.** What are the types of patent applications?

The types of applications that can be filed are:

A) PROVISIONAL APPLICATION: Indian Patent Law follows first to file system. A provisional application is an application which can be filed if the invention is still under experimentation stage. Filing a provisional specification provides the advantage to the inventor since it helps in establishing a ―priority date of the invention. Further, the inventor gets 12 months’ time to fully develop the invention and ascertain its market potential and to file the complete specification.

B) ORDINARY APPLICATION: An application for patent filed in the Patent Office without claiming any priority either in a convention country or without any reference to any other earlier application under process in the office. Such type of application is known an ordinary application.

C) CONVENTION APPLICATION: An application for patent filed in the Patent Office, claiming a priority date based on the same or substantially similar application filed in one or more of the convention countries is known as a convention application. In order to get convention status, an applicant should file the application in the Indian Patent Office within 12 months from the date of first filing of a similar application in the convention country.

D) PCT INTERNATIONAL APPLICATION: An Application filed in India as Receiving Office (RO) under Patent Cooperation Treaty is an international application which can be filed in more than 150 countries by a single application.

E) PCT NATIONAL PHASE APPLICATION: When an international application is made according to PCT designating India, an applicant can file the national phase application in India within 31 months from the international filing date or the priority date, whichever is earlier.

F) DIVISIONAL APPLICATION: When an application claims more than one invention, the applicant on his own or to meet the official objection on the ground of plurality or distinct invention may divide the application and file two or more applications, as the case may be for each of the inventions. This type of application, divided out of the parent one, is known a Divisional Application. The priority date for all the divisional applications will be same as that of the main or the Parent Application.

G) PATENT OF ADDITION: When an invention is a slight modification of the earlier invention for which he has already applied for or has obtained patent, the applicant can go for patent of addition if the modification in the invention is new. One of the benefits of filing patent of addition is that there no need to pay separate renewal fee for the patent of addition during the term of the main patent and it expires along with the main patent.

**3.** Is a patent application once filed examined automatically?

A patent application is not examined automatically after its filing. The examination is done only after receipt of the request of examination in Form 18 either from the applicant or from third party or Form 18A for expedited examination. 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.

What happens to a patent application once it is examined? What happens when applicant is not able to meet the requirements within the prescribed time?

Once a patent application is examined, 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 6 months from the date of FER which can be extended by 3 months. In case, the application is not found to be in order for grant, the Patent Office usually gives the Applicant an opportunity of a hearing to settle the objections. However if the application is found to be in order for grant, the patent is granted, provided 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. If the applicant does not file a reply within 6 months or does not take an extension of 3 months, the application is deemed to have been abandoned. There is no provision for extension of time beyond the period of 9 months.

**4.** Is it possible to file oppositions against the patent application? If so, what are the types and tilmelines?

There are two stages in which an opposition can be filed against a

patent/patent application. There are provisions in the Patents Act for a

pre grant opposition and a post grant opposition. A pre grant opposition

can be lodged by any person whereas a post grant opposition can only be

lodged by an interested person and no other person. The grounds remain

the same for a pre grant opposition and a post grant opposition. A pre

grant opposition can be filed once the application is published and upto

the date of grant.

A post-grant opposition can be filed within one year of the publication of the grant of a patent. A patent application is published by the Indian Patent Office ordinarily after 18 months of the priority date after which a pre grant opposition may be lodged but prior to the date of grant of the patent. The opposition proceedings take place at the Patent Office under Rule 55 to 61 of the Patents Rules, followed by a hearing under Rule 62, before disposal of the opposition.

**5.** What are obligations of the patentee after the grant of patent? Is it possible to restore a patent once it has ceased?

After the grant of patent, every patentee has to maintain the patent by paying renewal fee every year. For first two years, there is no renewal fee to be paid. The renewal fee is payable from 3rd year onwards. In case the renewal fee is not paid the patent will cease. The patentee has the choice to pay the renewal fees every year or he can pay in lump sum as well. There are provisions in the Patents Act for restoration of a patent after its cessation. 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. Therefore,

1. Annuities are payable only upon grant of a Patent.
2. Accumulated annuities are to be paid under Rule 80(1) within 3 months and six months extension under Rule 80(1A) is possible upon payment of requisite fees.
3. Subsequent annuities are to be paid under Rule 80(2). Subsequent annuities are payable every year.
4. Restoration is possible under Rule 84 within 18 months from the date of cessation, which request for restoration may be opposed by any interested person under Rule 85.
5. Full term of Patent is 20 years.

**6.** Does the patentee have any other obligation besides paying the renewal fees?

Yes, according to Section 146(2) of the Act, the Patent office is to be kept informed regarding the working of patents every year, by the Patentee and/or every Licensee through filing of Form 27. Such a statement is to be filed within 6 months from the end of each financial year. Non-working statement do not invalidate a Patent. It is mandatory to file a statement of working even if a Patent is not worked. Non- working of a patent might lead to compulsory licensing under Section 84 of the Act.

**7.** Is it mandatory to obtain prior permission from the Patent Office to file application for patent outside India or abroad? Under what circumstances, it is necessary to obtain a prior permission from the Patent Office?

It is not necessary to obtain prior permission from the Patent Office to file patent application abroad if the Applicant is not an Indian resident and invention has originated abroad or if the applicant is an Indian resident and has filed a patent application in India and then filed the application outside India after a six weeks period is over from the Indian application date or the invention does not belong to Atomic Energy or defence purpose.

It is necessary for residents of India to obtain prior permission to apply for patents outside India under section 39 of the Patents Act, 1970 under following circumstances:

(a) The applicant or inventor is Indian resident,

(b) Applicant does not wish to file patent application in India prior to filing outside India.

(c) 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

(d) The invention relates to atomic energy or defence purpose. However if the invention is relevant for Defence or Atomic Energy purpose, no permission shall be granted without the consent of Central Government.

**8.** If the patent application relates to a microbiological invention, is there any additional requirement for filing the patent applications?

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. The description in the specification should contain the details of deposition, i.e., name and address of the International Depository Authority and, date and number of deposition of the biological material. If such biological material is already known, in such case it is not essential to deposit the same. For instance, if the patent application relates to a microbiological invention, then in addition to the written description to be filed at the time of filing the patent application, the applicant is also required to deposit the new strain of a microorganism if used in the invention disclosed in the patent specification, in a recognized depository which assigns a registration number to the deposited microorganism, before filing for the patent application. This number needs to be quoted in the patent application.

**9.** What are the modes of filing a patent application in foreign countries? What is the Patent Cooperation Treaty (PCT)?

As it is not possible to obtain a worldwide patent right, the applicant has to file his patent application in respective countries separately to obtain protection on his invention. The following are the routes available to the applicant to file his International application in foreign country:

Paris Convention: The Paris Convention for the Protection of Industrial Property, established in 1883, provides for 12 months time to file the patent application in the member countries from the date of filing of the earliest application.

Patent Cooperation Treaty System: PCT is a system which allows an applicant to file in PCT contracting states within 30/31 months from priority date instead of 12 months. Not only does the PCT enable extended time period, it also simplifies filing procedure through a single application. The PCT system also provides for publication of application, International Search and International Preliminary Examination before entering the national phase. The PCT is an international treaty with more than 150 Contracting States which are bound with certain formal requirements set out in the Treaty and Regulations. The PCT makes it possible to seek patent protection for an invention simultaneously in a large number of countries by filing a single ―international patent application instead of filing several separate national or regional patent applications however, granting of patents remains under the control of the national or regional patent offices after the corresponding ―national phase application has been filed and the national phase application is assessed as per patent law of that jurisdiction.

**10.** What is a Design under the Designs Act, 2000? What are the benefits of Design Registration?

A Design refers to the features of shape, configuration, pattern, ornamentation or composition of lines or colours applied to any article, whether in two or three dimensional (or both) forms. This may be applied by any industrial process or means (manual, mechanical or chemical) separately or by a combined process, which in the finished article appeals to and judged solely by the eye. Design does not include any mode or principle of construction or anything which is a mere mechanical device. It also does not include any trademark or any artistic work.

The registration of a design confers upon the registered proprietor the exclusive right to apply a design to the article in the class in which the design has been registered. A registered proprietor of the design is entitled for protection of his intellectual property. If his right is infringed by any person he can take steps against infringement. He can license or sell his design as legal property for a consideration or royalty. Registration initially confers this right for ten years from the date of registration. It is renewable for a further period of five years. If the fee for extension is not paid for the further period of registration within the period of initial registration, this right will cease. There is provision for the restoration of a lapsed design if the application for restoration is filed within one year from the date of cessation in the prescribed manner.

**11.** What are the essential requirements for registration of a design?

In order to be registrable, the design

* should be new or original,
* should not have been disclosed to the public anywhere by publication in tangible from or by use or in any other way prior to the filling date, or where applicable, the priority date of the application for registration.

· should be significantly distinguishable from known designs or combination of known designs.

· should not comprise or contain scandalous or obscene matter.

· should not be a mere mechanical contrivance.

· should be applied to an article and should appeal to the eye.

· should not be contrary to public order or morality.

· should not be prejudicial to the security of India.

**12.** Is it possible to seek cancellation of a registered design? Who can seek for cancellation and on what grounds?

It is possible to seek cancellation of a registered design. Any interested person can file a petition to the Controller seeking the cancellation of a registered design at any time after the registration of the design. An application for cancellation can be filed on the following grounds:

• that the design has been previously registered in India ; or

• that it has been published in India or in any other country prior to the date of registration; or

• that the design is not a new or original design; or

• that the design is not registrable under this Act; or

• It is not a design as defined under section 2(d).

**13.** What are the provisions relating to marking of an article and why is it necessary?

Before delivery on sale of any article with registered design, the registered proprietor shall mark such article with any of the following words:

i. REGISTERED;

ii. REGD.;

iii. RD, and

iv. the registration number

It is not necessary to mark the articles as required above in: i. textile goods in which the design is printed or woven, other than handkerchiefs; and ii. articles made of charcoal dust, which are brittle and which are not sold in single piece.

If the registered proprietor fails to mark an article, he shall not be entitled to recover any penalty or damages in respect of any infringement of his copyright in the design, unless he proves that he took all proper steps to ensure the marking of the article, or unless he proves that the infringement took place after the alleged infringer knew or had already received a notice of the existence of copyright in the design.