

IPR: Patenting

Patent Law - Salient Features

Both product and process patent provided

Term of patent – 20 years

Examination on request

Both pre-grant and post-grant opposition

Fast track mechanism for disposal of appeals

Provision for protection of bio-diversity and traditional knowledge

Publication of applications after 18 months with facility for early publication

Scope of Patentability Under the Patents Act

What can be Patented? - **Invention**

New Product or Process (Novel)

Involving Inventive Steps (Non Obvious) – A feature that makes Invention not obvious to a person skilled in the art

Capable of Industrial Application - Invention should be capable of being made or used in an industry to result some tangible technical result

Sufficiently Disclosed in the Specification

What is an Invention?

“Invention” means a new product or process involving an inventive step and capable of 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**

Invention must NOT be (To Mean **NEWNESS**)

- 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 means

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

Stages from filing to grant of a patent

Obtaining a Patent: **File an application for patent**

Formality Check

Publication

Request for Examination

Examination

Issue of First Examination Report

Response from the Applicant

Pre-Grant Opposition

Examination of Pre-Grant Opposition

Consideration of Pre-Grant opposition

Grant of a Patent

Obtaining a Patent

File an application for patent

- With one of the patent offices based on territorial jurisdiction of the place of office or residence of the applicant /agent
- Pay the required fee

Information concerning application form and details of fee available at www.ipindia.nic.in (Guidelines for applicants also available on this website)

Formality Check

An Examiner checks the formal requirements before accepting the application and the fee – this is done immediately

Issue of application number and the cash receipt – this is done the same day (In case of receipt of application by post, cash receipt, application number is sent by post within 2-3 days)

Stages from filing to grant of a patent page 2/5

Publication

Application is kept secret for a period of 18 months from the date of filing
In 19th month, the application is published in the official journal – this journal is made available on the website weekly

Applicant has an option to get his application published before 18 months also
In that case, application is published within one month of the request

Request for Examination

Application is examined on request

Request for examination can be made either by the applicant or by a third party

A period of 48 months, from the date of filing, is available for making request for examination

Examination

Application is sent to an Examiner within 1 month from the date of request for examination

Examiner undertakes examination w.r.t.

- whether the claimed invention is not prohibited for grant of patent
- whether the invention meets the criteria of patentability

Issue of First Examination Report (FER)

A period of 1 to 3 months is available to Examiner to submit the report to the Controller

1 month's time available to Controller to vet the Examiner's report
First Examination Report (FER) containing gist of the objections is issued within 6 months from the date of filing of request

Stages from filing to grant of a patent page 4/5

Response from the Applicant

12 months' time, from the date of issue of FER, is available to the applicant to meet the objections

If objections are met, grant of patent is approved by the Controller – within a period of 1 month

Pre-grant Opposition

After publication, an opposition can be filed within a period of 6 months
Opportunity of hearing the opponent is also available

Examination of Pre-grant Opposition

Opposition (documents) is sent to the applicant

A period of 3 months is allowed for receipt of response

Consideration of Pre-grant Opposition

After examining the opposition and the submissions made during the hearing, Controller may

- Either reject the opposition and grant the patent
- Or accept the opposition and modify/reject the patent application

This is to be done within a period of 1 month from the date of completion of opposition proceedings

Grant of a Patent

A certificate of patent is issued within 7 days

Grant of patent is published in the official journal

Claims – A Statutory Requirement

Every complete specification must end with Claim(s)

Claim(s) must define the scope of invention for which protection is claimed

Elements of complete Specification

Title of the invention

Field and use of invention

Prior Art

Drawbacks of Prior Art

Comparison between Prior Art and Present Invention

Summary of the Present Invention

Statement of Invention

Detailed description of Invention- Drawings and Working Examples

Claims with Omnibus Claims - An omnibus claim is a claim which refers to the description and/or drawings as the subject matter of the claim

STAGES - FILING TO GRANT OF PATENT

**FILING OF APPLICATION
PROVN. / COMPLETE**

• **IF P.S. IS FILED C.S. TO BE FILED WITHIN 12 MONTHS**
(P.S.=Provisional Specification, C.S.=Complete Specification)

PUBLICATION OF APPLICATION

• **PROMPTLY AFTER 18 MONTHS FROM P.D**
(P.D.=Priority Date; This is the date of filing of the first application)

REQUEST FOR EXAMINATION

• **WITHIN 48 MONTHS FROM F.D.**
(F.D. = Filing Date)

**EXAMINATION-ISSUE OF FER
(FER= First Examination Report)**

3rd Party Representation

• **ALL OBJECTIONS TO BE COMPLIED WITHIN 12 MONTHS**

GRANT OF PATENT

OPPOSITION

• **WITHIN 12 MONTHS**

**Decision of
Controller**

Appeal

Appellate Board

Revocation/Amendment

