

Patent Office - Prosecution Procedures

By

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Asst. Controller of Patents & Designs

Patent Office, Mumbai

Govt. of India

Patent Administration in India

The Head Office is in Kolkata

Four branches:

Kolkata

Mumbai

Delhi

Chennai

Patent Administration in India

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

Patent Administration in India

Territorial Jurisdiction Patent Office Branch,

Mumbai: The States of Maharashtra, Gujrat Madhya Pradesh and Goa,
Daman & Diu & Dadar & Nagar Haveli

Chennai: The States of Andhra Pradesh, Kerala Tamil Nadu, Mysore and
Pondicherry, Laccadive, Minicoy and Aminidivi Islands.

New Delhi: States of Haryana, Himachal Pradesh, Jammu & Kashmir,
Punjab, Rajasthan and Uttar Pradesh, Chandigarh and Delhi.

Kolkata: The rest of India.e from the act

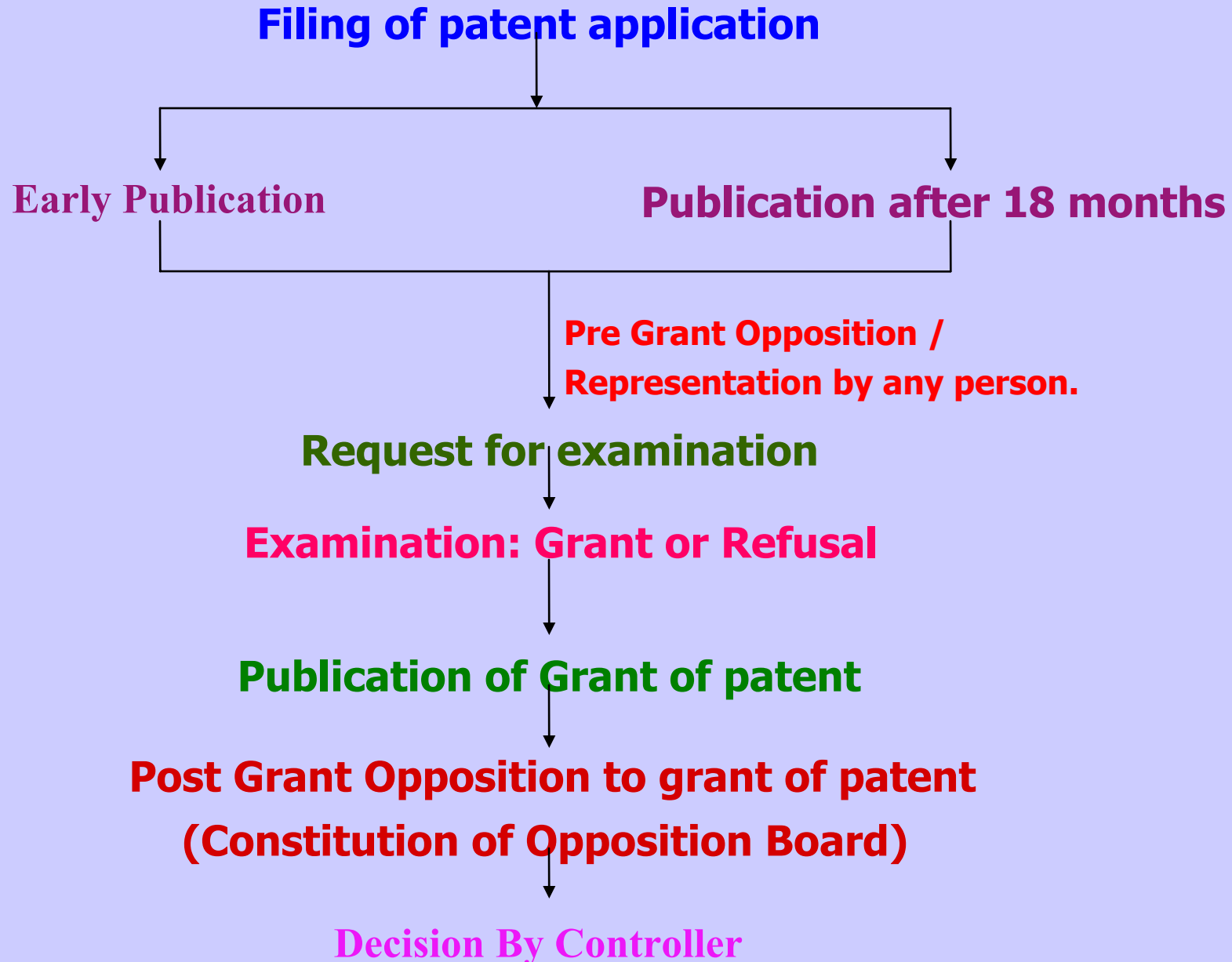
Who can file Patent Application in India

[Section 6 and 134]

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)
- ✓ By the legal representative of any deceased person who can immediately after his death is entitled to make such application

Patent Grant Procedure



Documents Required

- ✓ Application Form (Form 1)
- ✓ Proof of Right to Apply
(Paragraph 9 of Form 1)
- ✓ Provisional or complete
Specification (Form 2)
- ✓ Statement of Foreign Filing
(Form 3)
- ✓ Declaration as to Inventorship
(Form 5)
- ✓ Request for Early Publication
(Form 9)
- ✓ Request for Examination (Form
18)
- ✓ Power of Attorney, if Required
(Form 26)
- ✓ Certified Copy of Convention
Application, if required
- ✓ Abstract of Invention
- ✓ Drawing(s), if any

Provisional Specification

- ✓ It should describe the nature of invention & contain the description of essential features of the invention.
- ✓ No need to include claims & details of the manner in which it to be performed

Advantages of Provisional Specification

- o Priority for invention
- o No risk of losing priority
- o Liberty to develop
- o Disclose to interested person to obtain financial support
- o Virtually extend the term
- o Utilize for exploring commercial feasibility
- o Avoid incurring further expenses, if no commercial possibility

Contents of Complete Specification

- Title of the invention
- Field & background of the invention
- Use of the invention
- Prior art in the said field of invention & its drawback(s)
- Comparison between prior art & present invention
- Object (aim) of the present invention
- Summary of the present invention
- Brief description of drawings, if any
- Statement of the invention
- Detailed description of the invention w.r.t. drawings, if any
- Working examples for best method of the invention
- Claims for legal monopoly

Request for Early Publication (Form 9)

Applicant may in Form-9 request the controller to publish the application at any time before the expiry of 18 months and such application will be published within 1 month of such request (Sec. 11A).

Publication of Patent Application

[Under Section 11A]

- Every application for patent shall be published in Patent Office Official Journal on expiry of period of 18 months from the date of filing or date of priority, whichever is earlier & shall be open for public inspection (Rule 27)
- Except in the case, where the application –
 - (a) in which secrecy direction is imposed U/s. 35
 - (b) has been abandoned U/s. 9(1)
 - (c) has been withdrawn 3 months prior to 18 months

Importance of Publication

- *On and from the date of publication of the application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for the invention has been granted on the date of publication of the application.*
- *The applicant shall not be entitled to institute any proceedings for infringement until the patent has been granted*
- *Right of the patentee in the case of applications filed u/s 5(2) shall accrue from the date of grant of the patent*

Request for Examination

[Under Section 11 B]

- No application shall be examined unless the applicant or any other interested person makes a request for examination after publication (U/s. 11A) & within 48 months from the date of filing or date of priority, whichever is earlier.
- If, no request by the applicant or any other interested person within 48 months from the date of filing or date of priority, whichever is earlier, the application shall be treated as withdrawn by the applicant.

Request for Express Examination (Form 18)

The express request for examination of application filed through PCT route in national phase can be made in prescribed manner in Form 18 [Rule 20(4)(ii)].

Examination of Application

[Under Section 12 & 13]

- Every application after request for examination (U/s. 11B) shall be examined for -
 - (a) whether application is in accordance with the requirements of the Act or the rules made there under
 - (b) whether there is any lawful ground of objection to the grant of patent
 - (c) whether the novelty & inventive step is anticipated by prior claiming in India or publication anywhere in the world
 - (d) any other matter which may be prescribed under the Act

Grant or Refuse or Abandone

[Under Section 43, 15, & 21]

- If, within 12 months from the date FER -
- (a) all requirements met, patent will be granted immediately with seal of the Patent Office (Letters Patent) & grant publication U/s. 43(2);
- (b) requirement(s) not met, patent application will abandoned U/s. 21(1); or
- (c) requirement(s) met or not met even after hearing U/s. 15, patent will be granted or refused, as the case may be.
- Term of patent will be 20 years form the date of filing (sec. 53)

What rights a Patent confers on the patentee

If the patent is for a product :-

- the right to prevent others from
- making
 - using
 - offering for sale
 - selling
 - importing the patented product

What rights a Patent confers on the patentee

If the patent is for a process :-

- the right to prevent others from
 - using the process
 - offering for sale the product using the process
 - selling the product using the process
 - importing the product using the process

Post-Grant Opposition

[Under Section 25(2)]

- Any time after the grant or before expiry of 1 year from the date of publication of grant U/s. 43(2), any interested person may give notice of opposition on any of the grounds (a) to (k) of Section 25(2)
- Opposition board [constituted U/s. 25(3)(b)] after completion of proceeding & maturation of case for hearing will examine the matter & submit its report
- On receipt of report & after hearing the patentee & opponent, the patent will be either maintained or amended or revoked by order U/s. 25(4)

Other Activities

- *Residents not to apply for patents outside India without prior permission (Sec. 39, Form-25)*

Thank You