



MANUAL OF PATENT OFFICE PRACTICE AND PROCEDURE

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PREFACE

The Patents Act, 1970 was amended in 1999, 2002 and finally in 2005 to provide for product patents in chemicals, pharmaceuticals, food and agro-chemicals and bring in other necessary amendments in line with Trade Related Aspects of Intellectual Property Rights (TRIPS). Patents Rules have been commensurately amended, initially as Patent Rules, 2003, which were further amended in 2005, 2006, 2012, 2013, 2014, 2016, 2017 and 2019. India became signatory to Patent Cooperation Treaty (PCT) in 1998. Consequently, patent filing in India, including National Phase applications under PCT, has increased exponentially. Indian Patent Office is a major PCT filing country and also functions as ISA/IPEA under PCT.

Indian Patent Office has been modernized in terms of automation, IT enablement and electronic processing of patent applications during last decade. The objective of modernization project was to increase the functional efficiency and streamline the procedures in tune with international best practices.

Considerable changes have been effected in patenting procedures from time to time in accordance with the provisions of the amended Act and Rules and also to bring in automation, electronic work-flow, comprehensive e-filing, simplified and transparent procedures and efficient public service delivery of IP services.

The office has been regularly publishing the Manual of Patent Office Practice and Procedure to codify patent procedures for streamlining the functioning, provide benefit to stakeholders and also to provide guidance for prosecution of patent applications at Patent Office.

In view of the recent amendments of Patent Rules, reengineering of patent procedures and automation in almost all activities in Patent Office, there has been demand to revise and update the present Manual.

Accordingly, the present version of Manual of Patent Office Practice and Procedure, hereinafter referred to as “Manual”, has been prepared which is yet another step to fulfill our commitments towards more efficiency and transparency in the functioning of Patent Office.

This Manual may be considered as a practical guide for effective prosecution of patent applications in India. However, it does not constitute rule making and, hence, does not have the force and effect of law.

The Manual will be revised from time to time based on interpretations by courts of law, statutory amendments and valuable inputs from the stakeholders.

(Om Prakash Gupta)

Controller General of Patents, Designs and Trademarks

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Chapter-1: Introduction

1. This manual has been compiled with an intention to codify the practices and procedures being followed by the Indian Patent Office and the same is intended to serve as a procedural guide for practitioners and other users of the Indian Patent System.
2. Indian Patent Office functions from four locations viz. Delhi, Mumbai, Kolkata and Chennai with defined areas of territorial jurisdiction. Introduction of office automation and electronic processing of patent applications has resulted in uniformity and transparency in functioning of the office. A complete file wrapper in respect of published patent applications including, information related to publication, examination reports, status of application, amendments, grant, opposition, renewal and decisions of controllers as well as legal status of patents in the form of electronic Patent Register, has been made available to the public. This manual is expected to bring in further transparency and uniformity in patent office practices. .
3. Processing of patent applications is a multi-stage process, involving filing of an application, electronic data processing, screening and classification, publication, examination, hearing if required, pre-grant opposition and grant/refusal.
4. This manual is intended to spell out patent office practices and procedure and bridge any information gap that may be currently existing in this regard. It is not intended to be the interpretation of the Indian Patents Act and Rules made thereunder.
5. The procedure for filing patent application and its processing up to grant/refusal, maintenance etc. is explained in the following chapters except infringement proceedings. Certain matters like exceptions to the rights of patentee, Government use, compulsory licensing, etc. have also been included.
6. Some of the key definitions have been explained in Chapter-2.
7. Chapters 3 to 8 relate to the procedure for filing of patent applications including ordinary and PCT national phase applications, convention and PCT international applications, patent of addition, divisional application and functioning of Indian Patent Office as ISA/IPEA.
8. Chapters 9 to11 relate to examination, grant, pre-grant and post-grant oppositions.
9. Chapters 12 to 14 relate to the post-grant procedures such as maintenance of patent, appeal, revocation, compulsory licensing and use of patents for the purpose of Government.
10. Chapters 15 to 21 relate to Patent Agents, offences and penalties, general powers of Controller, general services, scientific advisors and miscellaneous provisions.
11. Time lines prescribed under the Act and Rules have been dealt with separately in Chapter 22.
12. The officers, appointed under section 73 (2) of the Act having delegated statutory powers, have

some discretionary powers under the Act, which are to be exercised cautiously and judiciously. They shall not be guided solely by the contents of this manual, but shall take judicious decisions based on the Act, Rules and judicial decisions available in the matter. However, all officers of Patent Office shall uniformly follow the procedures set forth in the Manual.

13. Common Procedures and Practices:

- a) **Affidavit and Evidence:** Subject to anything contrary to the directions issued by the Controller, evidence shall be given by way of an affidavit in all proceedings before the Controller, as may be required under the Act or Rules. As per Section 77(1)(c) of the Act and Rule 126 of the Patents Rules, the Controller has the power to receive evidence on affidavits which shall be duly sworn in. Nevertheless, a self-declaration signed before the Controller, who is legally empowered to receive the evidence, may also be considered as admissible evidence in any proceeding before the Controller under the Patents Act, if the Controller so allows.
- b) Consequent upon adopting the e-filing system, where certain documents are required to be filed in original, only one copy of such documents shall be submitted to the appropriate Patent Office.
- c) The latest document filed by the applicant shall be considered as final and the corresponding earlier document shall be deemed to have been superseded and cancelled by the applicant.
- d) Power of Attorney in Form-26 shall be stamped appropriately under the Indian Stamps Act.

Chapter 02: Key definitions

02.01	General	
	For better appreciation of the Manual, the user may require to have clear understanding of certain terms which are defined in the Act and Rules. Some of the important definitions are as under:	
02.02	Definitions	
02.02.01	"appropriate office" means the appropriate office of the Patent Office as specified in rule 4.	Rule 2(b), 4
02.02.02	"assignee" includes an assignee of the assignee and the legal representative of a deceased assignee and references to the assignee of any person include references to the assignee of the legal representative or assignee of that person.	Section 2(1)(ab)
02.02.03	"capable of industrial application", in relation to an invention, means that the invention is capable of being made or used in an industry	Section 2(1)(ac)
02.02.04	<p>"Controller" means the Controller General of Patents, Designs and Trade Marks referred to in Section 73 (1).</p> <p>The Controller General of Patents, Designs and Trademarks is appointed by the Government of India under Section 3 of the Trademarks Act, 1999. The person so appointed will be the Controller of Patents for the purposes of the Patents Act, 1970.</p> <p>The Central Government may appoint examiners and other officers with designations as deemed fit. The officers so appointed shall discharge, under the superintendence and directions of the Controller General of Patents, Designs and Trademarks, such functions of the Controller under this Act, as he may authorize in writing from time to time, by general or special order.</p> <p>Any reference to the Controller shall be construed as including a reference to any officer discharging such functions of the Controller in pursuance of Section 73.</p> <p>The Controller General has authorized Assistant Controllers, Deputy Controllers, Joint Controllers and Senior Joint Controllers to discharge certain functions of the Controller, under the Act.</p>	Section 2(1)(b), 2(2)(a), and 73; Section 3 of Trademarks Act, 1999

	The Controller General has the power to withdraw any matter pending before an officer, by an order in writing and for reasons to be recorded therein, and deal with such matter himself, either <i>de novo</i> or from the stage it was so withdrawn or transfer the same to another officer who may, subject to special directions in the order of such transfer, proceed with the matter either <i>de novo</i> or from the stage it was so transferred.	
02.02.05	"Government undertaking" means any industrial undertaking carried on – a. By a department of the Government, or b. by a corporation established by a Central, Provincial or State Act, which is owned or controlled by the Government, or c. by a Government company as defined in section 617 of the Companies Act, 1956 (1 of 1956), or d. by an institution wholly or substantially financed by the Government.	Section 2(1)(h), Section 617 of the Companies Act, 1956
02.02.06	"international application" means an application for patent made in accordance with the Patent Co-operation Treaty .	Section 2(1)(ia)
02.02.07	"invention" means a new product or process involving an inventive step and capable of industrial application.	Section 2(1)(j)
02.02.08	"inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art.	Section 2(1)(ja)
02.02.09	"legal representative" means a person who in law represents the estate of a deceased person.	Section 2(1)(k)
02.02.10	"Opposition Board" means an Opposition Board constituted under sub - section (3) of section 25.	Section 25(3), (1)(la)
02.02.11	"patentee" means the person for the time being entered on the register as the grantee or proprietor of the patent.	Section 2(1)(p)
02.02.12	"patent office" means the patent office referred to in section 74 Unlike many other Countries, Indian Patent Office functions from four locations viz. Kolkata, Delhi, Chennai and Mumbai for the purpose of facilitating processing of patent applications.	Section 2(1)(r), 2(2)(b), 74
02.02.13	"person" includes the Government.	Section 2(1)(s)

02.02.14	"person interested" includes a person engaged in, or in promoting, research in the same field as that to which the invention relates.	Section 2(1) (t)
02.02.15	"prescribed" means prescribed by rules made under this Act.	Section 2(1) (u)
02.02.16	"prescribed manner" includes the payment of the prescribed fee.	Section 2(1) (v)
02.02.17	<p>"small entity" means, -</p> <p>(i) in case of an enterprise engaged in the manufacture or production of goods, an enterprise where the investment in plant and machinery does not exceed the limit specified for a medium enterprise under clause (a) of sub-section (1) of section 7 of the Micro, Small and Medium Enterprises Development Act, 2006 (27 of 2006); and</p> <p>(ii) in case of an enterprise engaged in providing or rendering of services, an enterprise where the investment in equipment is not more than the limit specified for medium enterprises under clause (b) of sub-section (I) of Section 7 of the Micro, Small and Medium Enterprises Development Act, 2006.</p> <p>Explanation 1 : For the purpose of this clause, "enterprise" means an industrial undertaking or a business concern or any other establishment, by whatever name called, engaged in the manufacture or production of goods, in any manner, pertaining to any industry specified in the First Schedule to the Industries (Development and Regulation) Act, 1951 (65 of 1951) or engaged in providing or rendering of any service or services in such an industry.</p> <p>Explanation 2: In calculating the investment in plant and machinery, the cost of pollution control, research and development, industrial safety devices and such other things as may be specified by notification under the Micro, Small and Medium Enterprises Development Act, 2006 (27 of 2006), shall be excluded.</p> <p>Explanation 3: The reference rates of foreign currency of the Reserve Bank of India shall prevail.</p> <p>In case of foreign entity, the applicant shall furnish the declaration to the effect that the quantum of investment in plants and machinery/equipment is within the limit prescribed under the Micro, Small and Medium Enterprises Development Act, 2006 (27 of 2006 of India).</p>	<p>Rule 2(fa), Section 7 (1) (b) of MSME Development Act, 2006</p>

02.0218	<p>"Startup" means-</p> <p>(a) an entity in India recognised as a startup by the competent authority under Startup India initiative.</p> <p>(b) In case of a foreign entity, an entity fulfilling the criteria for turnover and period of incorporation/ registration as per Startup India Initiative and submitting declaration to that effect.</p> <p>Explanation: In calculating the turnover, reference rates of foreign currency of Reserve Bank of India shall prevail.</p>	Rule 2(fb)
02.02.19	<p>"true and first inventor" does not include either the first importer of an invention into India, or a person to whom an invention is first communicated from outside India.</p>	Section 2(1)(y)

Chapter 03: Filing of Patent Application

03.01	<p>Applicant</p> <ul style="list-style-type: none"> • An application for a patent for an invention may be made by any of the following persons either alone or jointly with any other person: <ul style="list-style-type: none"> - True and first inventor - True and first inventor's assignee - Legal representative of any deceased true and first inventor or his/her assignee • The term "person" as defined in the Patents Act includes Government. • True and first inventor does not include either the first importer of an invention into India or a person to whom an invention is first communicated from outside India. • An applicant is required to disclose the name, address and nationality of the true and first inventor(s). • "Assignee" can be a natural person or legal person such as, a registered company, small entity, startup, research organization, an educational institute or the Government. • Assignee includes assignee of an assignee also. • Where the inventor(s) is/are not the applicant(s), a proof of right to apply for a patent shall be submitted by way of endorsement in the appropriate paragraph of Form-1 or as an assignment from inventor(s) in favour of applicant(s), duly authenticated, irrespective of whether the application is a Convention or National Phase application. It shall be filed within 6 months from the date of filing of the application in India. • "Natural person" means any individual or a group of individuals. • "Other than natural person" includes a registered company, small entity, startup, research organization, educational institute or Government. • "Legal representative" means a person who in law represents the estate of a deceased person. In such a case, the Legal Representative is required to file appropriate legal instruments as proof of right. 	<p>Section 6, 7(2) 54, 134, 135; Rule 10 Form-1</p>
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03.01.01	<p>Procedure to be followed for substitution of applicants etc.</p> <p>(1)(a) If the Controller is satisfied with the claim that, by virtue of any assignment or agreement in writing made by the applicant or one of the applicants for the patent or by operation of law, the claimant would, if the patent were then granted, be entitled thereto or to the interest of the applicant therein, or to an undivided share of the patent or of that interest, the Controller may direct that the application shall proceed in the name of the claimant or in the names of the claimants and the applicant or the other joint applicant or applicants accordingly, as the case may require.</p> <p>Such a claim shall be made in Form 6 in the prescribed manner at any time before a grant of patent.</p> <p>(b) No such direction as aforesaid shall be given by virtue of any assignment or agreement made by one of two or more joint applicants for a patent except with the consent of the other joint applicant or applicants.</p> <p>(c) The original assignment or agreement or an official copy or notarized copy thereof shall also be produced for the Controller's inspection and the Controller may call for such other proof of title or written consent, as he may require.</p> <p>(d) Further, the Controller shall not issue any such direction unless:</p> <ol style="list-style-type: none"> i. the invention is identified in the agreement or assignment by reference to the number of application for the patent, or ii. there is an assignment/ agreement produced before the Controller by the person to whom it was made, indicating that the assignment or agreement relates to the invention in respect of which the application is made, or iii. the rights of the claimant in respect of the invention have been finally established by decision of a court, or iv. the Controller takes a decision after hearing the disputed parties as per the proceedings under section 20 (5) of the rules. <p>(2) Where one of two or more joint applicants for a patent dies at any</p>	Section 20, 34-36, Form-6
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	<p>time before the grant of patent, the Controller may, upon a request in that behalf made by the survivor or survivors, and with the consent of the legal representative of the deceased, direct that the application shall proceed in the name of the survivor or survivors alone.</p> <p>Such request shall be made in Form 6 and shall be accompanied by proof of death of the joint applicant and a certified copy of the probate of the will of the deceased or letters of administration in respect of his estate or any other document to prove that the person who gives the consent is the legal representative of the deceased applicant.</p> <p>(3) If any dispute arises between joint applicants for a patent as to whether or in what manner the application should be proceeded with, the Controller may, upon application made to him in the prescribed manner by any of the parties, and after giving an opportunity to be heard to all parties concerned, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be proceeded with, or for both those purposes, as the case may require.</p> <p>Such application shall be made in Form 6 in duplicate and shall be accompanied by a statement setting out fully the facts upon which the applicant relies and the directions which he seeks. A copy of the application and statement shall be sent by the Controller to every other joint applicant.</p>	
<p>03.02</p>	<p>Jurisdiction</p> <p>Unlike many other Countries, Indian Patent Office functions from four locations viz. Kolkata, Delhi, Chennai and Mumbai for carrying out all procedures relating to patents.</p> <p>An application for patent shall be filed with the Patent Office having appropriate jurisdiction. A territorial jurisdiction of patent office in respect of a patent application is decided based on any of the following:</p> <ol style="list-style-type: none"> i. Place of residence, domicile or business of the applicant (first mentioned applicant in case of joint applicants) or, 	<p>Section 16, 74. Rule 4, 5.</p>

- ii. Place from where an invention actually originated or,
- iii. Address for service in India given by the applicant, when the Applicant has no place of business or domicile in India (Foreign applicants).
- iv. Also, the further application referred to in section 16 of the Act shall be filed at the appropriate office of the first mentioned application only.

Territorial jurisdictions are as under:

Patent Office	Territorial Jurisdiction
Mumbai	The States of Gujarat, Maharashtra, Madhya Pradesh, Goa, Chhattisgarh, the Union Territories of Daman & Diu and Dadra & Nagar Haveli
Delhi	The States of Haryana, Himachal Pradesh, , Punjab, Rajasthan, Uttar Pradesh, Uttarakhand, National Capital Territory of Delhi and the Union Territories of Chandigarh, Jammu and Kashmir, and Ladakh.
Chennai	The States of Andhra Pradesh, Karnataka, Kerala, Tamil Nadu, Telangana and the Union Territories of Pondicherry and Lakshadweep.
Kolkata	Rest of India (States of Bihar, Jharkhand, Orissa, West Bengal, Sikkim, Assam, Meghalaya, Manipur, Tripura, Nagaland, Arunachal Pradesh and Union Territory of Andaman and Nicobar Islands)

An appropriate office where a patent application is filed shall not be ordinarily changed.

However, the Controller may allocate an application for patent to any of the four Patent Offices, if required.

All applicants and patent agents are required to give an address for service including postal address in India, an email address and a mobile number registered in India.

Such address for service shall be considered for all proceedings under the Patents Act and Rules.

03.03	<p>Types of Patent Applications</p> <ol style="list-style-type: none"> 1. Ordinary Application i.e., an application which has been filed directly in the Indian Patent Office without claiming priority of any foreign application. 2. Convention Application claiming the priority of a country which is a member to Paris Convention 3. PCT National Phase Application. 4. Divisional Application, i.e, a further application divided out of the first- mentioned patent application. 5. Patent of Addition i.e. an application for patent in respect of any improvement in or modification of the invention for which the patent application has already been filed or patent has been granted. 	Section 7, 16, 54,135
03.04	<p>Filing of patent application</p> <p>Every application for a patent shall be for one invention only and shall be filed in Form-1 at an appropriate office along with provisional/complete specification (in Form 2), accompanied with the prescribed fee as given in the First Schedule.</p> <p>However, a provisional specification cannot be filed in case of Convention Application or PCT National Phase application filed in India.</p> <p>(For further description of Provisional /Complete Specifications refer Chapter 5).</p> <p>Normal fee shall be applicable for applications containing up to 30 pages and up to 10 claims. If the application exceeds 30 pages or claims are more than 10 in number, additional fee, as given in the First Schedule, is payable.</p> <p>It may be noted that 10% additional fee shall be payable when the application for patent and other documents are filed through physical mode, namely, in hard-copy format.</p> <p>E-Filing of Patent Application:</p> <p>IPO has developed THE comprehensive e-filing system for patents, wherein, in addition to online filing of new applications, subsequent</p>	Section 7, First Schedule

	<p>filing of all the documents has also been integrated.</p> <p>New and enhanced features of Comprehensive E-filing services include:</p> <ul style="list-style-type: none"> • Web-based filing system • Dual way login (Digital Signature as well as Password based) and password regeneration • Provision for filing of all entries as per First Schedule of the Patents Rules, 2003 • Proper validations with Patent Office database • Facility to upgrade/update digital signatures <p>(https://ipindiaonline.gov.in/epatentfiling/goForLogin/doLogin)</p>	
03.04.01	<p>Documents required for filing patent application</p> <p>A patent application should contain the following:</p> <ol style="list-style-type: none"> 1. Application for grant of patent in Form-1. 2. A proof of right is required from the inventor(s) by way of endorsement in the appropriate paragraph of Form-1 or as an assignment from inventor(s) in favour of applicant(s), duly authenticated, irrespective of whether the application is a Convention or National Phase application. Accordingly, it shall be filed within 6 months from the date of filing of the application in India. 3. Provisional/complete specification in Form-2. 4. Statement and undertaking under Section 8 (1) in Form-3 : An applicant must file information and undertaking regarding foreign applications in Form 3, either along with the application or within 6 months from the date of application. The applicant is also required to keep the controller informed regarding every application relating to same or substantially same invention, if any filed in any country outside India subsequently, within six months from the date of filing of such application. 5. Declaration as to inventorship shall be filed in Form-5 along with the complete specification where the complete specification is filed after provisional specification, and also, where the application is either a convention application or national phase application filed in India under PCT. 	<p>Section 7. Rule 2(fa)/ 2(fb), Rule 7(1), 8, 10, 12, 13, 135. Form-1, 2, 3, 5, 26, 28. Section 6 of Biological Diversity Act, 2002.</p>

However, the Controller may allow Form-5 to be filed within one month from the date of filing of complete specification, if a request is made to the Controller in Form-4.

6. **If an applicant is MSME/Startup, Form 28** accompanied with appropriate evidence in accordance with rule Rule 2 (fa)/ 2(fb) respectively shall be submitted.

In the case of **“small entity or startup”**, every document for which fee has been specified, shall be accompanied by Form-28.

7. **Form of Authorisation:**

Authorisation of an agent shall be filed in Form 26 or in the form of a power of attorney within a period of three months from the date of filing of such application or document, failing which no action shall be taken on such application or documents for further processing till such deficiency is removed.

In case a general power of attorney has already been filed in another application, a self-attested copy of the same shall be filed by the authorized Patent Agent.

8. **Priority document** is required in the following cases:

- Convention Application (under Paris Convention).
- PCT National Phase Application wherein requirements of Rule 17.1 (a or b) of regulations made under the PCT have not been fulfilled.

A priority document shall be filed along with PCT National phase application before the expiry of 31 months from the date of priority.

9. Every application shall bear the **signature of the applicant or authorized person/patent agent** along with name and date in the appropriate space provided in the forms.

The specification shall be signed by the applicant or his authorized patent agent with date on the last page of the claims contained in the Specification. Drawing sheets should bear the signature of an applicant or his authorized patent agent in the right hand bottom corner.

	<p>Where the documents have been digitally signed by the Applicant/Patent Agent, there will be no requirement of physical signature of the agent or applicant.</p> <p>10. If the invention as disclosed in the patent specification uses the biological material obtained from India, the applicant is required to submit the permission from the National Biodiversity Authority any time before the grant of the patent. (Please refer to Section-6 of the Biological Diversity Act, 2002).</p> <p>11. The application shall disclose in the specification the source and geographical origin of the biological material, if any used in the invention.</p>	
03.04.02	<p>Comprehensive E-filing:</p> <p>E-filing Portal of the Patent Office, available in the official website of Controller General of Patents, Designs & Trade Marks (www.ipindia.nic.in), provides comprehensive platform for online submission of patent application and subsequent forms in a secure and authenticated electronic way.</p> <p>Authentication of filing is done via a digital signature which the applicant or his agent must procure as Digital Signature Certificate (DSC) of class II or III from authorized vendors.</p> <p>Online payment of fees can be made through a payment gateway with all the prevalent major modes of payment like Net banking, Credit Cards, Debit Cards and Unified Payments Interface (UPI).</p> <p>The e-filing portal provides flexibility to applicants or their authorized agents to work from their premises on 24x7 basis, even on holidays.</p> <p>Steps of e-filing:</p> <ol style="list-style-type: none"> 1. Visit www.ipindia.gov.in and proceed to E-Gateways 2. Register for New User and creation of “user-id” 3. Install Digital Signature Certificate (DSC) and configure the system as per the DSC manual 4. Login to the e-filing module 5. Select New Application Filing or any particular Form which is to be filed 	Rule 6

	<ol style="list-style-type: none"> 6. Draft the Form(s) for new application or any other subsequent form (s) 7. Upload the PDF version of required documents 8. Save the draft 9. Go to the drafted forms 10. Enter the mobile number, if SMS alert are required 11. Select the drafted form and proceed for signing of drafted form 12. After the forms are digitally signed, it is ready for making the payment though the available Payment Gateways 13. Select the digitally signed form and proceed for payment 14. Select the payment gateway (NTRP-Bharatkosh payment gateway) 15. Select the bank and payment mode to make the payment of fee 16. After making payment, the acknowledgement receipt would be generated. <p>Submitted Forms would then proceed to the respective section of the Patent Office for processing and official actions.</p> <p>(For more and updated information on the steps for e-filing, you may also refer to the Comprehensive E- Filing Portal).</p>	
<p>03.04.03</p>	<p>Leaving and Serving Documents at Patent Office</p> <ol style="list-style-type: none"> 1. Any Application, notice or other document authorised or required to be filed, left, made or given at the patent office, or to the Controller or to any other person under the Act or the rules, may be tendered by hand or sent by a letter addressed to the Controller at the Appropriate Office or to that person through post or registered post or speed post or by electronic transmission duly authenticated. 2. If any such document is sent by post or registered post or speed post or by electronic transmission duly authenticated, it shall be deemed to have been filed, left, made or given at the time when the mail containing the same would have been delivered in the ordinary course of post or registered post or speed post or by electronic transmission duly authenticated, as the case may be. In proving such sending, it shall be sufficient to show that the mail was properly addressed and transmitted. 3. A patent agent shall file, leave, make or give all documents only 	<p>Rule 6, 6(1-A)</p>

	<p>by electronic transmission duly authenticated;</p> <ol style="list-style-type: none">4. Any document, if asked to be submitted in original, shall be submitted within a period of fifteen days, failing which such documents shall be deemed not to have been filed.5. Any written communication addressed to a patentee at his postal address or email address, as it appears on the register of patents or at his address for service given under rule 5, or to any applicant or opponent in any proceedings under the Act or the rules, at the postal address or email address, preferably on first email address appearing on the Application or notice of opposition, or given for service, shall be deemed to be properly addressed.6. All notices and all written communications addressed to a patentee, or to any applicant or opponent in any proceedings under the Act or the rules, and all documents forwarded to the patentee or to the said applicant or opponent, shall, except when they are sent by special messenger, be sent by registered post or speed post or by electronic transmission duly authenticated.7. The date of notice or written communication addressed to a patentee or to any applicant or opponent in any proceedings under the Act and the rules shall be the date of dispatch of the said notice or written communication, by registered post or speed post or fax or electronic transmission duly authenticated, as the case may be, unless otherwise specified under the Act or the rules.8.(i) In case of delay in receipt of a document or communication sent by the Patent office to a party to any proceedings under the Act or the rules, the delay in transmitting or resubmitting a document to the Patent office or doing any act by the party may be condoned by the Controller if a petition for such condonation of delay is made by the party to the Controller immediately after the receipt of the document or communication along with the statement regarding the circumstances of the fact and evidence	
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	<p>in support of the statement.</p> <p>Whenever an applicant is unable to submit the documents in time due to failure of server/Bharat Kosh/IT infrastructure on part of the Office, the applicant/patent agent is required to take screen shot of the problem and submit the same to the Office along with a statement regarding the circumstances of the facts as evidence in support as per Rule 6(5), whereupon such delay may be condoned after due verification by the Office.</p> <p>Such delay condoned by the Controller shall not exceed the period between the date on which the party was supposed to have received the document or communication by ordinary course of mail or electronic transmission duly authenticated and the actual date of receipt of the same.</p> <p>(ii). The condonation of such delay can also be made for reasons of war, revolution, civil disorder, strike, natural calamity, a general unavailability of electronic communication services or other similar reasons occurred in the locality where the applicant/agent resides or has place of business. The delay can be allowed when the applicant/agent files a petition for condonation of such delay to the Controller provided the situation was of such severity that it disrupted the normal communication in that area and that the petition is filed within maximum one month from the date of cessation of the such situation.</p> <p>Such delay condoned by the Controller shall not exceed the period for which national emergency was in force, or six months from the expiry of the prescribed period, whichever is earlier.</p> <p>(iii) A petition(s) as referred to above can be filed in Form 30, as no specific Form is provided for petition under rule 6 (5) and 6 (6).</p>	
<p>03.04.04</p>	<p>Receiving Documents in office:</p> <ol style="list-style-type: none"> 1. The application and any other documents with or without accompanying fees is received at the Patent Office at separate counters i.e., Fee Counter and Non-Fee Counter , respectively. 2. The fee bearing documents are sent to the fee counter and the 	

	<p>non-fee bearing documents are sent to the non-fee counter.</p> <ol style="list-style-type: none"> 3. The application and any other documents with or without accompanying fees is received at the Patent Office at separate counters i.e., Fee Counter and Non-Fee Counter , respectively. 4. The fee bearing documents are sent to the fee counter and the non-fee bearing documents are sent to the non-fee counter. 5. The staff at the fee counter makes relevant entries in the module, stamps the documents so received, generates the Cash Book Receipts (CBRs) and enters the CBR number, date, amount of fee received, application number, patent number or other relevant entries. 6. The staff at the non-fee counter makes relevant entry in the document receipt module and stamps the documents 7. The documents from both the counters are sent to Electronic Data Processing (EDP) Section for digitization 	
<p>03.04.05</p>	<p>Language and Paper-size etc.</p> <p>All documents and copies of the documents, except affidavits and drawings, filed with patent office, shall be:</p> <ol style="list-style-type: none"> 1. typewritten or printed in Hindi or English (unless otherwise directed or allowed by the Controller) in large and legible characters not less than 0.28 centimetre high with deep indelible ink with lines widely spaced not less than one and half spaced, only upon one side of the paper; 2. on such paper which is flexible, strong, white, smooth, non-shiny, and durable of size A4 of approximately 29.7 centimetre by 21centimetre with a margin of at least 4 centimetre on the top and left hand part and 3 centimetre on the bottom and right hand part thereof; 3. numbered in consecutive Arabic numerals in the centre of the bottom of the sheet; and 4. containing numbering to every fifth line of each page of the description and claims at right half of the left margin. 5. additional copies of all documents shall be filed at the appropriate 	<p>Rule 9</p>

	<p>office as may be required by the Controller.</p> <p>6. names and addresses of applicant and other persons shall be given in full, together with their nationality and such other particulars, if any, necessary for their identification.</p> <p>Signature</p> <p>Any signature which is not legible or which is written in a script other than Hindi or English shall be accompanied by a transcription of the name, either in Hindi or in English, in block letters.</p>	
03.04.06	<p>Sequence listing</p> <p>If the application for patent discloses sequence listing of nucleotides or amino acid sequences, such sequence listing shall be filed in the computer readable text format along with the application and no print form of the sequence listing of nucleotides or amino acid sequences will be required to be given.</p> <p>A nucleotide sequence shall be listed with a maximum of 60 bases per line, with a space between each group of 10 bases. The bases of a nucleotide sequence (including introns) shall be listed in groups of 10 bases, except in the coding parts of the sequence. Leftover bases, fewer than 10 in number at the end of non-coding parts of a sequence, should be grouped together and separated from adjacent groups by a space. The bases of the coding parts of a nucleotide sequence shall be listed as triplets (codons).</p> <p>Any sequence listing in electronic form shall be contained within one electronic file encoded using IBM 39 Code Page 437, IBM Code Page 93240 or a compatible code page to represent the sequence listing with no other codes included.</p> <p>Any sequence listing in the electronic document format as specified shall preferably be created by dedicated software such as PatentIn.</p> <p>(REFERENCE: WIPO STANDARD ST.25 FOR THE PRESENTATION OF NUCLEOTIDE AND AMINO ACID.</p> <p><u>URL: https://www.wipo.int/export/sites/www/standards/en/pdf/03-25-01.pdf</u>)</p>	Rule 9
03.04.07	<p>Fee:</p> <p>1. Fee payable under the Act in case of offline filing may either be</p>	Section

	<p>paid in cash or may be sent by bank draft or banker's cheque payable to the Controller of Patents and drawn on a scheduled bank at the place where the appropriate office is situated. Fee can also be paid through BHIM app in Controller of Patents Account.</p> <ol style="list-style-type: none"> 2. If the draft or banker's cheque is sent by post, the fee shall be deemed to have been paid on the date on which the draft or banker's cheque has actually reached the Controller. 3. Ten percent additional fee shall be payable when the application for patent and other documents are filed through physical mode, namely, in hard copy format. 4. In case of online filing, payment of fees can be made through a payment gateway with all the prevalent major modes of payment like Net banking, Credit Cards, Debit Cards or ATM Cards. 5. When a small entity/start up is an applicant, every subsequent document for which a fee has been specified, shall be accompanied by Form 28 with duly authenticated copy of the evidence of small entity/start up. 6. In case an application processed by a natural person is fully or partially transferred to a person other than a natural person, the difference, if any, in the scale of fee(s) between the fee(s) charged from a natural person and the fee(s) chargeable from the person other than a natural person in the same matter for all previous proceedings shall be paid by the new applicant with the request for transfer in Form 6 along with Form 30. 7. When an application processed by a small entity is fully or partly transferred to a person other than a natural person (except a small entity), the difference, if any, in the scale of fee(s) between the fee(s) charged from a small entity and the fee(s) chargeable from the person other than a natural person (except a small entity) in the same matter for all previous proceedings shall be paid by the new applicant with the request for transfer in Form 6 along with Form 30. 8. When an application is filed by a startup is fully or partly 	<p>142, Rule 7, First Schedule</p>
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	<p>transferred to any person other than a natural person or a startup, the difference, if any, in the scale of fees between the fees charged from a startup and such person to whom the application is transferred, shall be paid by the new applicant for all previous proceedings along with the request for transfer in Form 6 along with Form 30.</p> <p>Explanation- Where the startup ceases to be a startup after having filed an application for patent due to lapse of more than seven/ten years from the date of its incorporation or registration as applicable or the turnover subsequently crosses the financial threshold limit as defined, no such difference in the scale of fees shall be payable.</p> <p>9. Where a fee is payable in respect of a document, the entire fee shall accompany the document.</p> <p>10. Where a fee is payable in respect of the doing of an act by the Controller, the Controller shall not do that act until the fee has been paid.</p> <p>11. Fee once paid in respect of any proceedings shall not be ordinarily refunded whether the proceedings have taken place or not. However, on the request by the applicant/agent in Form 30 and if the Controller is satisfied that during the online filing process, the fee was paid more than once for the same proceeding, the excess fee shall be refunded.</p> <p>12. Prescribed fee for various proceedings under the Act is given in the First Schedule.</p>	
03.05	Processing of Application	
03.05.01	<p>Initial processing:</p> <p>1. On receipt of an application, the Office accords a date and serial number to it. Requests for examination are accorded separate serial numbers.</p> <p>2. Applications and other documents filed in physical form are digitized, verified, screened, classified and uploaded to the internal server of the Office.</p> <p>3. Patent applications and other documents are arranged in e-wrapper.</p>	

	<p>4. The Application is screened for:</p> <ol style="list-style-type: none"> a. International Patent Classification b. Technical field of invention for allocation to an examiner in the respective field c. Relevance to defence or atomic energy. d. Correctness and completeness of abstract. <p>If the abstract is found as not appropriate , the same will be amended suitably by the office , so as to provide better information to third parties. However, care is taken that such amendment does not result in a change in the nature of invention.</p>	
03.05.02	<p>i. Numbering System for Applications</p> <ul style="list-style-type: none"> • FORMAT: YYYY J T NNNNNN , Where, • "YYYY" is Four digit fixed length "Year of filing" (in YYYY/MM/DD) • "J" is fixed length single digit "Jurisdiction" in numerals (1 for Delhi, 2 for Mumbai, 3 for Kolkata, 4 for Chennai) • "T" is fixed length single digit "Type of Application"in numerals: (1 for Ordinary; 2 for Ordinary-Divisional;3 for Ordinary-Patent of Addition; 4 for Convention; 5 for Convention-Divisional; 6 for Convention-Patent of Addition; 7 for PCT NP; 8 for PCT NP-Divisional and 9 for PCT NP-Patent of Addition) • "NNNNNN" is 6 digits fixed length common continuous running serial number of applications applicable for all Patent Offices in India • Thus, 1st application (Ordinary) filed in Delhi in 2019 will be numbered as 201911000001. If 2nd application in 2019 is "Convention" application from Mumbai it would be numbered as 201924000002. 	

03.05.03	<p>ii. Numbering Format for Request for Examination</p> <ul style="list-style-type: none"> • Format: RYYYYJNNNNNNN, Where, • "R" denotes Request for examination u/r 24B(1)(i) "YYYY" denotes four digit fixed length "Year of filing" • "J" denotes Jurisdiction for Patent Application against which Request of Examination has been filed • "NNNNNN" denotes 6 digits fixed length common continuous running serial number applicable for all Patent Offices in India. <p>iii. Numbering Format for Request for Expedited Examination</p> <ul style="list-style-type: none"> • Format: EYYYYJNNNNNNN Where, "E denotes Request for Expedited Examination under rule 24 (C). 	
03.05.04	<p>Scrutiny of Application</p> <ol style="list-style-type: none"> 1. The Office checks whether the Application has been filed in Appropriate Jurisdiction (see 03.02). The address for service shall mandatorily include e-mail address and PIN code. If the address for service is not complete, the application shall be returned and the applicant will be informed accordingly. 2. The Office checks for Proof of Right to file the application (See 03.04). If proof of right is not filed along with the application, the same shall be filed within a period of six months from the date of filing of the application. Otherwise, the applicant shall file the same along with a petition under Rule 137/138. The Office checks whether the application and other documents have been filed in the prescribed format i.e. prescribed forms, request, petitions, assignment deeds, translation etc. 3. Further, the Office checks whether: <ol style="list-style-type: none"> a. the documents have been prepared on a proper sized paper and typed in appropriate font with proper spacing, b. the documents are duly signed c. abstract, drawings (if any) have been filed in proper format d. meaningful claim(s) are present in a complete specification, 	

	<p>e. whether authorisation of an Agent in Form 26 or in the form of a power of attorney is filed within a period of three months from the date of filing of such application or document.</p> <p>f. whether Form-5 has been filed, if required.</p> <p>g. whether the invention has been assigned to another person, and if yes, whether Form 6 has been duly filed along with the deed of assignment. If the right is assigned from an individual to a legal entity, the legal entity is invited to pay the balance fees.</p>	
<p>03.05.05</p>	<p>Secrecy Directions and consequences thereof-</p> <ol style="list-style-type: none"> 1. If in the opinion of the Controller, an invention pertains to a subject matter relevant for the purpose of defence, as notified by the Central Government, or otherwise the invention appears to the Controller to be so relevant, he will issue directions prohibiting the publication of the application and will notify the applicant. 2. Where the Controller gives any such direction, he shall refer the matter to the Central Government for consideration as to whether the publication of the application would be prejudicial to the defence of India. 3. If the Central Government, after considering the merits of the secrecy direction, is of the opinion that the publication of the invention would not so prejudice, will give notice to the Controller to that effect, who shall thereupon revoke the directions and notify the applicant accordingly. 4. The Central Government reviews the continuation of secrecy directions in the following circumstances: <ol style="list-style-type: none"> i) periodically at an interval of six months, or ii) on a request made by the applicant. If the applicant requests for reconsideration of the secrecy direction already imposed, and, if the same is found reasonable by the Controller, he shall request the Central Government for review. <p>If on such reconsideration, it appears to the Central Government that the publication of the invention would no</p> 	<p>Section 35, 36, 37, 38 Rule 72</p>

longer be prejudicial to the defence of India, it shall forthwith give notice to the Controller to revoke the direction and the Controllers shall thereupon revoke the directions previously given by him.

- iii) In case the application filed by a foreign applicant is found to be relevant for defence purposes by the Central Government but published outside India, it shall give notice to the Controller to revoke the directions previously given by him.

The result of every re-consideration under sub-section 36 (1), shall be communicated to the applicant within 15 days of the receipt of the notice by the Controller.

5. If the Central Government is of the opinion that an invention in respect of which the Controller has not imposed a secrecy direction and is relevant for defence purposes, it may at any time before the grant of the patent notify the Controller to that effect. Thereupon, the Controller invokes the provisions of Section 35(1) and notify the Central Government accordingly.
6. So long as any directions under Section 35 are in force, the Controller shall not take a decision on grant/refusal of the application. However, the application may, subject to the directions, proceed up to the stage of "in order for grant", but the application and the specification found to be in order for grant of the patent shall not be published, and no patent shall be granted in pursuance of that application. Further, no appeal shall lie from any order of the Controller passed in respect thereof.
7. Where an application is found to be in order for grant of the patent during the continuance in force of the directions, then-
- (a) if, any use of the invention is made by or on behalf of, or to the order of the Government, the provisions of sections 100, 101 and 103 shall apply in relation to that use, as if the patent had been granted for the invention; and,
- (b) if it appears to the Central Government that the applicant for the patent has suffered hardship by reason of the

	<p>continuance in force of the directions, the Central Government may make to him such payment (if any) by way of solatium as appears to the Central Government to be reasonable having regard to the novelty and utility of the invention and the purpose for which it is designed, and to any other relevant circumstances.</p> <p>(c) Where a patent is granted in pursuance of an application in respect of which directions have been given under section 35, no renewal fee shall be payable in respect of any period during which those directions were in force.</p>	
03.05.06	<p>Inventions relating to Atomic Energy</p> <p>No Patent is granted in respect of an invention relating to atomic energy falling within sub-section (1) of Section 20 of the Atomic Energy Act, 1962.</p> <p>According to Section 20(1) of Atomic Energy Act, atomic energy means energy released from atomic nuclei as a result of any process including the fission and fusion processes. Under this Act, "prescribed substances" means any substance including any mineral which the Central Government may, by notification, prescribe, being a substance which in its opinion is or may be used for the production or use of atomic energy or research.</p> <p>The updated list of "prescribed substances" under Atomic Energy Act 1962, published vide notification dated 28th April, 2016, may be accessed at http://dae.nic.in/writereaddata/Prescribed-eng.pdf</p> <p>Upon screening, if an Application is found to be falling within the purview of the Atomic Energy Act, the Controller refers the Application to the Central Government.</p> <p>The Central Government upon consideration may issue a direction to the Controller, which is final. The same shall be informed to the applicant.</p> <p>The opinion of the Central Government is not open to an appeal.</p>	<p>Section 4 of the Patents Act, 1970;</p> <p>Section 2 of the Atomic Energy Act, 1962.</p> <p>S.O.61(E)</p>
03.06	<p>Withdrawal of patent application</p> <p>The applicant may, at any time after filing the application but before the grant of a patent, withdraw the application by making a request in</p>	<p>Section 11 A (3)(c),</p>

	<p>writing. A request for withdrawing the application under sub-section (4) of section 11B shall be made in Form 29.</p> <p>However, if the applicant makes a request for withdrawal within 15 months from the date of filing or priority of the application, whichever is earlier, the application will not be published.</p> <p>Withdrawal and Refund of Fees :</p> <p>If request for withdrawal of an application is filed in respect of which a request for examination has been filed but FER has not been issued, 90% of the fee paid for request for examination/expedited examination can be refunded as prescribed in the First Schedule, on a request made by the applicant in Form 29.</p>	<p>11B(4), Rule 7(4A) and 26, Form 29, First Schedule</p>
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Chapter – 4 : Publication of Application

04.01	<p>Publication of Patent Application</p> <p>a) An application for Patent is not open to public before the expiry of 18 months from the date of filing or date of priority, whichever is earlier.</p> <p>b) At the end of the period as mentioned in para (a) above, the Application is published in the Official Journal <u>except</u> in the cases, where:</p> <ol style="list-style-type: none"> i. Secrecy direction u/s 35 is in force. ii. Application is abandoned u/s 9 (1) (i.e., complete Specification not filed within twelve months from the date of filing of Provisional Specification). iii. Application is withdrawn three months prior to the due date of publication, i.e., before the end of 15th month from the date of filing or priority, whichever is earlier. <p>c) The Patent Office publishes applications in the official e-Journal, ordinarily within one month from the date of expiry of the period as specified in para (a) above.</p> <p>d) Where a secrecy direction has been given, then the application will be published after the expiry of the period as mentioned in para (a) above or when the secrecy direction has ceased to operate, whichever is later.</p> <p>e) Publication of application under sub-sections (2) and (5) of section 11A shall be identified by the letter 'A' along with the number of application.</p>	<p>Section 11A, Rule 24</p>
04.02	<p>Early Publication</p> <p>a) A request for early publication may be made in Form-9 with the prescribed fee.</p> <p>b) Such a request will be considered only if the Complete specification has been filed in the instant case.</p> <p>c) Further, a patent application shall not be considered for early publication if an invention pertains to subject matter relevant for</p>	<p>Section 11-A(2), Rule 24-A, Form-9, First Schedule</p>

	<p>defence purpose.</p> <p>d) The application is published within one month from the date of such request.</p>	
04.03	<p>Particulars of Publication</p> <p>The Patent Office Journal is published on every Friday with the following particulars in respect of application:</p> <ol style="list-style-type: none"> i. Application number ii. Country iii. Date of filing iv. Publication date v. Title of invention vi. International Patent Classification vii. Priority details like priority document number, priority date, Priority country, International Application No. and Filing date, etc. viii. Name and address of the applicant ix. Name of the inventor(s) x. Reference in respect of Patent of Addition shall be the application number and filing date of the main application. xi. Reference in respect of Divisional Application shall be the application number and filing date of the of the first mentioned application. xii. Abstract xiii. No. of pages xiv. No. of claims 	Section 11A
04.04	<p>Effects of Publication</p> <p>a) Upon publication, the Patent Office makes the specification (complete as well as provisional, if any), abstract, drawings and any other documents filed in respect of the application available to the public on its website and copies of the same can also be made available on payment of the prescribed fee as given in the First Schedule of Patents Rules 2003 (as amended), if such a request is filed.</p>	Section 11A(6), Rule 27, 55 (1A).

	<p>b) After publication of the application for Patent, the depository institution shall make the biological material, mentioned in the specification, available to the public.</p> <p>c) 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 had been granted on the date of publication of the application:</p> <p>Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been granted:</p> <p>d) No patent shall be granted before the expiry of six months from the date of publication of the application.</p>	
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Chapter - 5: Provisional and Complete Specification

05.01	Specification	
	<p>The Specification is a techno-legal document containing scientific and technical disclosure and claims for the invention which is the basis of rights of a patent. The Specification, thus, forms a crucial part of the patent application.</p> <p>A specification may be filed either as a provisional or complete specification.</p> <p>Provisional or Complete Specification shall be submitted in Form-2 along with the Application Form-1 and other documents accompanied with the prescribed fee as given in the First Schedule.</p> <p>The first page of Form - 2 shall contain:</p> <ol style="list-style-type: none"> a) Title of the invention; b) Name, address and nationality of each of the applicants for patent; and c) Preamble to the description: <ol style="list-style-type: none"> i) If the provisional specification is filed, the Preamble shall be as under: <p style="text-align: center;"><i>“The following Specification describes the invention”.</i></p> ii) If the complete specification is filed, the Preamble shall be as under: <p style="text-align: center;"><i>“The following specification particularly describes the invention and the manner in which it is to be performed.”</i></p> <p>Title of the invention shall disclose the specific features of the invention normally in not more than fifteen words.</p> <p>The applicant shall submit drawings, wherever required. Further, the Controller may also require the applicant to submit drawings, if necessary at the examination stage. Such drawings shall form a part of the Specification and suitable references thereto shall be made in the Specification. The Controller may require the applicant to submit, any time before the grant, models or samples related to the invention for better illustration of the invention. However, such models or samples shall not form part of the Specification.</p>	<p>Section 9, 10, 57, 59. Rule 13, 14, 24A, Form-1, 2</p>

	<p>Filing amendments to the specification:</p> <ol style="list-style-type: none"> 1) When amendments are made to a provisional or complete specification or any drawing accompanying it, the pages incorporating such amendments shall be retyped and submitted to form a continuous document. 2) A marked copy clearly identifying the amendments carried out and a statement clearly indicating the portion (page number and line number) of the specification or drawing being amended along with the reason shall also be filed. 3) Amendments shall not be made by slips pasted on, or as footnotes or by writing in the margin of any of the said documents. 4) When a retyped page or pages incorporating amendments are submitted, the corresponding earlier page(s) shall be deemed to have been superseded and cancelled by the applicant. 	
<p>05.02</p>	<p>Provisional Specification</p> <ol style="list-style-type: none"> a) When the applicant finds that his invention has reached a stage where it can be disclosed but has not attained the final stage, he may prepare a disclosure of the invention in the form of a written description and submit it to Patent Office as a Provisional Specification. b) A Provisional Specification secures a priority date for the application. c) An application filed with provisional specification is deemed to be abandoned if no complete specification is filed within twelve months from the date of filing of the provisional specification [S. 9 (1)]. d) If in the opinion of the Controller, two or more provisional specifications filed by an applicant are cognate, or if one is a modification of the other, he may allow the applicant to file one complete specification in respect of all such provisional specifications. Such a complete specification shall have to be filed within twelve months from the date of filing of the first provisional application. In such cases, date of filing of the 	<p>Section 9, 11A (3) (b), 17</p>

	<p>application is the date of filing of the earliest provisional specification and shall bear the number of that application [S9 (2)].</p> <p>e) An applicant, within twelve months from the filing of a complete specification (not being a convention application or PCT National Phase Application), may request the Controller to convert the complete specification so filed to a provisional specification. Consequently, the applicant has to file a complete specification within twelve months from the date of first filing. [(S. 9 (3)]</p> <p>f) After filing a complete Specification, the applicant may request the Controller at any time before grant of patent to cancel the provisional specification (i.e. the one filed directly u/s 9 (1) or the one converted from a complete specification (u/s 9 (3)), the Controller may cancel the provisional specification and post-date the application to the date of filing of the complete specification.</p>	
<p>05.02.02</p>	<p>Contents of Provisional Specification:</p> <p>Provisional specification is a techno-legal document which describes the invention and it is followed by a complete specification.</p> <p>a) A provisional specification shall essentially contain the title and description of the invention.</p> <p>It is advisable not to include claims in the provisional specification as the purpose of filing a provisional specification is to claim a priority date and it is only meant for describing the invention.</p> <p>b) The description starts from the second page with the field of invention, background of the invention, object of the invention and statement of the invention.</p> <p>c) It is advisable to include as much information as the applicant has in a provisional specification, at the time of filing.</p> <p>d) It may be noted that a provisional specification cannot be filed in case of a Divisional, Convention or PCT National Phase Application.</p>	<p>Section 10</p>

<p>05.03</p>	<p>Complete Specification</p> <p>Complete Specification is a techno-legal document which fully and particularly describes the invention and discloses the best method of performing the invention.</p> <p>As a complete specification is an important document in the patent proceedings, it is advised that it should be drafted with utmost care without any ambiguity.</p> <p>It is mandatory on the part of applicant to disclose fully and particularly various features constituting the invention. Disclosure of invention in a complete specification must be such that a person of average skill and average knowledge in India should be able to perform the invention based on what is disclosed in the specification.</p>	<p>Section 10</p>
<p>05.03.01</p>	<p>Contents of Complete Specification</p> <p>Every complete specification shall:</p> <ol style="list-style-type: none"> a) fully and particularly describe the invention and its operation or use and the method by which it is performed; b) disclose the best method of performing the invention which is known to the applicant for which he is entitled to claim protection; c) end with a claim or set of claims defining the scope of the invention for which the protection is claimed; d) make reference to deposit of the biological material in the international depository authority, if applicable; e) disclose the source and geographical origin of biological material specified in the Specification; f) be accompanied by an abstract; and g) not include irrelevant or other matter, not necessary for elucidation of the invention, from the title, description, claims and drawings. h) in case of a specification for Divisional Application, shall contain specific reference to the number of original application from which the divisional application is made. i) in case of a specification for Patent of Addition, shall contain a specific reference to the number of main patent or application 	<p>Section 10(4)</p>

	<p>for patent, as the case may be, and a definite statement that invention comprises an improvement in or a modification of the invention claimed in the specification of the main patent granted or applied for.</p>	
05.03.02	<p>National phase applications</p> <p>In case of national phase applications, the title, description, drawings, abstract and claims filed with the international application are taken as a complete specification. An application corresponding to an International application filed under PCT may be made in Form-1.</p> <p>However, the applicant, while filing such application corresponding to an international application designating India, may delete a claim, in accordance with the provisions contained in rule 14.</p> <p>(For further details of the PCT National Phase Applications, please see Chapter 7)</p>	<p>Section 10(4A), Rule 20(1)</p>
05.03.03	<p>Title of invention</p> <p>The title should be sufficiently indicative of the subject matter of the invention and shall disclose the specific features of the invention. It need not be the same as the preamble of the main claim. It shall be brief, free from fancy expressions or ambiguity and as precise and definite as possible, but it need not go into the details of the invention itself. Title should not ordinarily exceed fifteen words.</p>	<p>Rule 13(7)(a)</p>
05.03.04	<p>Field of invention and use of invention</p> <p>The description should preferably begin with a general statement of the invention so as to indicate briefly the subject matter to which the invention relates, e.g. “This invention relates to”. Thereafter, the advantages of the invention may be mentioned to bring out clearly the areas of application and preferable use of the invention. The applicant may substantiate industrial applicability of the invention in this part.</p>	
05.03.05	<p>Prior art and Problem to be solved</p> <p>This part should generally indicate the status of technology in the field of invention with reference to developments in the field including patents and pending patent applications in the specific art. When the invention relates to improvement over the existing product or process,</p>	

	<p>a short statement of the closest prior art known to the applicant in that respect shall also be given. However, the description should fully and particularly describe the invention by clearly distinguishing it from such closest prior art, known to the applicant.</p>	
05.03.06	<p>Objects of invention</p> <p>The purpose of this part is to clearly bring out the objectives to be achieved by the invention. It shall clearly mention the technical problems associated with the existing technology and the solution for that, bringing out the differences between the claimed invention and the prior art. The solution sought by the invention should be clearly brought out as object(s) of inventions with statements like ,</p> <p>“The principal object of this invention is.....”,</p> <p>“Another object of this invention is”,</p> <p>“A further object of this invention is” etc.</p>	
05.03.07	<p>Summary of invention</p> <p>The description should include a summary of invention before giving details of the invention and the method of performing it. The statement should clearly set forth the distinguishing features of the invention for which protection is desired. This part is intended to declare different aspects of the invention.</p>	
05.03.08	<p>Brief Description of Drawings, if any</p> <p>Drawing(s), if form(s) a part of the specification, shall be enlisted properly.</p>	
05.03.09	<p>Detailed Description of invention</p> <p>a) Description of an invention is required to be furnished in sufficient detail so as to give a complete picture of the invention and follows the Summary of invention. The nature of improvements or modifications effected with respect to the prior art should be clearly and sufficiently described. It may include examples/drawings or both for clearly describing and ascertaining the nature of invention. Examples must be included in the description, especially in the case of chemical related inventions.</p> <p>b) Disclosure of invention in a complete specification must be such that a person of average skill and average knowledge in India</p>	

should be able to perform the invention based on what is disclosed in the specification.

- c) Reference to the drawings should be specific and preferably in the following form: *“This invention is illustrated with the help of the accompanying drawings.....”*
- d) The Specification in respect of Patent of Addition should contain at the beginning of the description, a definite statement indicating an improvement in or modification of the original invention and the serial number of the Application for Patent in respect of the original invention. The Specifications should also contain a short statement of the invention as disclosed in the earlier Specification.
- e) Terms in other languages, if any, used in the description should be accompanied by their English equivalents. The use of vague words, slang and colloquialisms is objectionable and shall be avoided.
- f) In case a biological material described in the specification is not available to the public and cannot be described adequately as per the provisions of the Act, such material shall be deposited with the International Depository Authority under the Budapest Treaty, on or before the date of filing.
- g) The International Depository Authority in India are :
- **Microbial Type Culture Collection and Gene Bank (MTCC) Chandigarh.**
For further information on Microbial Type Culture Collection and Gene Bank (MTCC) please visit- <https://mtccindia.res.in/>
 - **Microbial Culture Collection (MCC), Pune**
For further information on NCCS please visit- <http://www.nccs.res.in/g>
- g) Reference to such biological material shall be made in the Specification within three months from the date of filing, giving all the available characteristics of the material required for it to be correctly identified or indicated including the name, address of the depository institution and the date and number of the deposit of the material at the institution.

	<p>h) If there is any request for early publication, then the said reference shall be given on or before the date of filing of such request.</p> <p>i) Further, the source and geographical origin of the biological material specified in the Specification shall also be disclosed.</p> <p>j) Access to the material in the depository institution is available only after the date of application for patent in India.</p> <p>k) In the case of Biotechnology related inventions, reference to the relevant sequence ID (SEQ ID), if any, shall be mentioned in the description/claims of the specification.</p>	
05.03.10	<p>Drawings</p> <p>a) Drawings or sketches, which require a special illustration of the invention, shall not appear in the description itself. Such drawings shall be on separate sheet(s).</p> <p>b) Drawings shall be prepared neatly and clearly on durable paper sheet.</p> <p>c) Drawings shall be on standard A4 size sheets with a clear margin of at least 4 cm on the top and left hand and 3 cm at the bottom and right hand of every sheet.</p> <p>d) Drawings shall be on a scale sufficiently large to show the inventions clearly and dimensions shall not be marked on the drawings.</p> <p>e) Drawings shall be sequentially or systematically numbered and shall bear -</p> <ol style="list-style-type: none"> i. in the left hand top corner, the name of the applicant; ii. in the right hand top corner, the number of the sheets of drawings, and the consecutive number of each sheet; and iii. In the right hand bottom corner, the signature of the applicant or his agent. <p>f) No descriptive matter shall appear on the drawings except in the flow diagrams.</p>	Rule 15
05.03.11	<p>Abstract</p> <p>a) Every complete specification shall be accompanied by an abstract to provide technical information on the invention. The abstract shall commence with the title of the invention.</p>	Rule 13 (7)

	<p>b) The abstract shall be so drafted that it constitutes an efficient instrument for the purpose of searching in the particular technical field.</p> <p>c) The abstract shall contain a concise summary of the matter contained in the specification. The summary shall indicate clearly the technical field to which the invention belongs, technical problem to which the invention relates and the solution to the problem through the invention and principal use or uses of the invention. Wherever necessary, the abstract shall contain the chemical formula which characterizes the invention.</p> <p>d) The abstract may not contain more than 150 words.</p> <p>e) If the specification contains any drawing, the applicant shall indicate reference numerals of drawings in the abstract, which may accompany the abstract when published. Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by the reference sign used in that drawing.</p> <p>f) The Controller may amend the abstract for providing better information to third parties.</p>	
05.03.12	<p>Best Method</p> <p>The Act specifically requires that the complete specification must describe the best method of performing the invention known to the applicant, including the one, which he may have acquired during the period of provisional protection prior to the date of filing the complete specification.</p>	Section 10
05.03.13	<p>Claims</p> <p>Claims define the contours of rights, if and when a patent is granted for an invention. Hence, claims are the most critical part of a patent application. In a complete specification the description is followed by claims. Since, claims of the invention define the scope of legal protection, it should be drafted carefully to cover all the aspects of the invention for which protection being sought; at the same time adequately distinguishing the prior art from the claimed invention.</p>	Section 10(4)(c)
05.03.14	<p>Unity of invention and Clarity of claims</p> <p>a) Claim(s) of a Complete Specification shall relate to a single</p>	Section 10(5)

	<p>invention, or to a group of inventions linked so as to form a single inventive concept.</p> <p>b) Claims shall be clear and succinct and fairly based on the matter disclosed in the specification.</p>	
05.03.15	<p>Significance of Claims</p> <p>a) A claim is a statement of technical facts expressed in legal terms defining the scope of the invention to be protected. No exclusivity is obtained for any matter described in the Complete Specification unless it is claimed in the claims. What is not claimed in the claims(including amended claims) stands disclaimed and is open to public use, even if the matter is disclosed in the description.</p> <p>b) Claims define the boundaries of legal protection sought by the patentee and form a protective fence around the invention which is defined by the words and phrases in the claims.</p> <p>c) Claims shall define clearly the scope of the invention with conciseness, precision and accuracy, so that others may know the exact boundary into which they should not trespass.</p> <p>d) Each claim is evaluated on its own merit and, therefore, if one of the claims is objected, it does not mean that the rest of the claims are invalid. It is therefore important to make claims on all aspects of the invention to ensure that the applicant gets the widest possible protection.</p>	
05.03.16	<p>Scope of Claims</p> <p>a) Claims must not be too broad to embrace more than what the applicant has in fact invented. A Claim which is too broad may encroach upon the subject matter which is in public domain or belongs to others.</p> <p>b) However, a claim may not be too narrow also because such a claim would not be sufficiently effective against potential infringement. An infringer would go scot-free, if the claims were too narrow and hence, the full benefit of the invention may not accrue to the inventor.</p> <p>c) Having many claims, where each claim has a different scope,</p>	

	<p>allows the applicant to have a legal title to different aspects of the invention.</p> <p>d) Terms of the claim which confuse the scope of the invention, or claim that are not specific (e.g. any novel matter) should be avoided.</p>	
<p>05.03.17</p>	<p>Structure of Claims</p> <p>a) The description of invention in the complete specification is to be followed by a ‘statement of Claims’ preceded by the preamble, ‘I / We Claim’ as the case may be.</p> <p>b) Claims should start from a fresh page, after detailed description of the invention and should be serially numbered.</p> <p>c) Each claim should be in a single sentence.</p> <p>d) Each claim should be clear and succinct.</p> <p>e) A claim should not be verbose.</p> <p>f) The claims should relate to a single invention, or to a group of inventions linked to a single inventive concept.</p> <p>g) There is no restriction as to the number of claims that can be incorporated in the specification. Applicant has to pay additional fee for each claim, if total number of claims is more than ten.</p> <p>h) Each claim should be fairly based on matter disclosed in the specification.</p> <p>i) The claims must be fully supported by the description.</p> <p>j) A claim should be clear in the sense that it should not cause any speculation with respect to scope of the claimed invention. For example, words like ‘thin’, ‘strong’, ‘a major part’, ‘such as’, ‘when required’ or ‘any’ are used in the claims, the same may lead to a subjective interpretation. Where ever use of such terms are unavoidable and are considered as clear and definitive to a person skilled in the art, the same may be allowable.</p> <p>k) A claim must be specific and not vague, ambiguous or hypothetical in nature. Each claim should be complete so that it covers the inventive feature and enough elements around it to put the invention in the proper context.</p> <p>l) Any term which is used in the claim, must be either found in the description or fairly inferred from the description.</p>	

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| | <p>m) Trade Marks should not be used in Patent Applications where a generic term can be used instead, since a Trademark is an indication of the origin rather than the composition or content of goods, However, Trade Marks are only permitted in claims where it can be shown that their use is unavoidable and does not introduce ambiguity.</p> <p>n) A claim usually consists of three parts:</p> <ul style="list-style-type: none"> - Preamble, - Transitional phrase; and - Body. <p>o) An introductory phrase(Preamble) identifies the category of invention and sometimes the purpose (for example, a machine for waxing paper, and a composition for fertilizing soil).</p> <p>p) The transition phrase may be words and phrases such as:</p> <ul style="list-style-type: none"> - comprising - including - consisting of - consisting essentially of <p>q) If the invention is an improvement on a product or a process existing in the prior art, the invention should be characterized by the feature(s) comprising such improvement over the prior art. In such cases, the claim will have two parts separated by the word ‘characterized by’ or ‘wherein’.</p> <p>r) The first claim is always an independent claim also known as ‘Principal Claim’. It should clearly define the essential features of the embodiment(s) of the process/product that constitutes the invention. The claim should be properly characterized with respect to the ‘prior art’, defining all the technical features essential to the invention or inventive concept. The claim should bring out sufficient details of interrelationship and/or operation to establish that the invention achieves the intended objectives.</p> <p>s) There may be more than one independent claim in a single application if the claims fall under a single inventive concept. While there is no restriction as to the number of claims, including independent claims, it is advisable to limit the number of claims, as well as the number of independent claims in a single</p> | |
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	<p>application so that the claims are falling under a single inventive concept.</p> <p>A dependent claim derives antecedence from an independent claim and reads into it the features of the independent claim and may contain optional features.</p> <p>t) A claim shall not comprise number of alternatives and/or variable parameters/ features which make it unsearchable.</p> <p>u) Dependent claims that are not fully limited by the terms of the preceding independent claim, e.g. dependent claims which omit, modify or substitute a feature of an independent claim should be avoided.</p> <p>v) The practice of including an omnibus claim does not have any legal basis under the Patents Act. In fact, such a claim cannot be allowed as per Section 10(4)(c) of the Act, being non-definitive with respect to scope of invention for which the protection is claimed.</p>	
<p>05.04</p>	<p>Priority of Claim</p> <p>Each claim of a complete specification shall have a priority date. When a complete specification is filed along with the application, the date of filing of the application is the date of the priority of the claim(s) of the specification if the claim(s) are fairly based on the matter disclosed in the specification.</p>	<p>Section 2(1)(w), 11</p>
<p>05.04.01</p>	<p>Priority Dates- General</p> <p>a) When a complete specification is filed pursuant to a Provisional Specification, the priority date thereof shall be the date of filing of the provisional application.</p> <p>b) When a complete specification is filed based on two or more provisional specifications which are cognate, the priority dates for claims arising from each of the provisional specifications will be the date of the respective provisional specification.</p> <p>c) When a complete specification is converted into provisional specification and a fresh complete specification is filed thereafter, the priority date of claims shall be the date of disclosure of the relevant specification in which the claimed subject matter was first disclosed.</p>	<p>Section 9, 11</p>

	<p>d) When a complete specification is filed after the provisional specification, the Controller may on the request of the applicant made any time before the grant, cancel the provisional specification and post-date the provisional specification to the date of complete specification.</p> <p>e) If the claim is fairly based on the matter disclosed partly in one and partly in another such previous application accompanying provisional specification, the priority date of the claim shall be the date of the later filed Specification.</p> <p>f) Where a complete specification based on a previously filed application in India has been filed within twelve months from the date of that application and the claim is fairly based on the matter disclosed in the previously filed application, the priority date of that claim shall be the date of the previously filed application in which the matter was first disclosed.</p> <p>g) A claim in a complete specification of a patent shall not be invalidated by the reason only if:</p> <ol style="list-style-type: none"> i. the publication or use of the invention so far as claimed in that claim on or after the priority date of such claim; or ii. the grant of another patent which claims the invention, so far as claimed in the first mentioned claim, in a claim of the same or a later priority date. 	
05.04.02	<p>Divisional application</p> <p>In case of a Divisional Application, priority date of the claim(s) is the date of filing of the first mentioned application.</p>	Section 11(4)
05.04.03	<p>Convention application</p> <p>The priority date of the claim(s) of a convention application is the date of filing of the basic application filed in the convention country.</p>	Section 11(6), 135
05.04.04	<p>Effect of Priority Date of Claim</p> <p>The novelty of a claim is dependent on its date of priority. Nothing published on or after the date of priority of a claim can be cited to destroy the novelty of that invention.</p>	Section 11(8)

Chapter- 6: Divisional Application and Patent of Addition

06.01	Divisional Application	
06.01.01	<p>General</p> <p>i. An applicant may, at any time before the grant of a patent, if he so desires, or with a view to remedy the objection raised by the Controller on the ground that claims of a complete specification relate to more than one invention, may file further application(s) in respect of invention disclosed in the provisional or complete specification already filed in respect of the first-mentioned application.</p> <p>ii.(a) If the Power of Attorney, filed with the first mentioned application, expressly authorizes patent agent to act on his/her behalf in connection with such application, including any divisional application(s) arising out therefrom, a copy of the power of attorney is not required to be filed again in case of divisional application so filed. In absence of such express authorization in the Power of Attorney filed with the first mentioned application, a fresh Power of Attorney is required to be filed in case of divisional application.</p> <p>(b) If the applicant has submitted the proof of right in the prescribed manner with the first mentioned application, the same is not required to be filed again in case of divisional application.</p> <p>iii. Examination of a divisional application is always done vis-à-vis the first mentioned application. If two or more divisional applications are filed based on a first mentioned application, examination of the second or subsequent divisional application(s) shall be done vis-à-vis the first mentioned application, and other divisional application(s), examined earlier, if any, to avoid double patenting.</p> <p>iv. The date of filing of a divisional application shall be the same as that of the first mentioned application, from which it has been divided.</p> <p>v. The term of patent for a divisional application shall be twenty years from the date of filing of the first mentioned application or international filing date in case the application was divided out of</p>	Section 16 (1)

	<p>National phase application under PCT.</p> <p>vi. Claims of divisional application(s) shall be based on the claims of first mentioned (or earlier application for that matter) from which instant application is divided out and no addition of claims, which do not fall within the scope of said claims, is allowable.</p>	
06.01.02	<p>Contents</p> <p>Divisional Application(s) shall be accompanied by a complete specification and shall not include any matter not in substance disclosed in the first mentioned application. The first mentioned application and the divisional application(s) may be amended upon requirement/direction of Controller to ensure that neither of the complete specifications includes a claim for any matter claimed in the other.</p>	Section 16(2), 16(3)
06.01.03	<p>Priority</p> <ul style="list-style-type: none"> • The divisional application is treated as a substantive application and accorded the date of filing of the first mentioned application along with a separate application number. • The claims of divisional application shall have the same priority date as that indicated in the first mentioned application. • A divisional application shall be examined vis-à-vis the first mentioned application so as to avoid claim overlap resulting in double patenting. • A divisional application is treated as a substantive application in the sense that: <ul style="list-style-type: none"> a) separate fee(s) is required to be paid; b) separate request for examination requires to be made; c) it can be prosecuted separately; d) it results in an independent patent. 	Section 16, Explanation Section 11(4)
06.01.04	<p>Appropriate Office</p> <p>The divisional application shall be filed at the appropriate office of the first mentioned application only.</p>	Rule 4 (5)
06.01.05	<p>Reference</p> <p>The Complete Specification accompanying the divisional application shall contain a specific reference to the original application from which the divisional application is made.</p>	Rule 13(2)

<p>06.01.06</p>	<p>Fee</p> <p>For all purposes under the Patents Act, the divisional application is treated as a substantive application and, hence, all fees applicable to a patent application, shall be payable.</p>	<p>Section 16</p>
<p>06.02</p>	<p>Patent of Addition</p>	
<p>06.02.01</p>	<p>General</p> <p>a) When an applicant comes up with an improvement in or modification of the invention described or disclosed in the main application for which he has already applied for or has obtained a patent, the applicant may make an application for patent of addition.</p> <p>b) An application for a Patent of Addition shall be filed on the same or subsequent date of filing of the application for main Patent.</p> <p>c) A Patent of Addition shall be granted only after the grant of the main patent.</p> <p>d) When a patentee holds two patents, it is possible to convert one of the independent patents to a patent of addition of the other, if the subject matter was an improvement in or modification to the other patented invention.</p> <p>e) There is no need to pay separate renewal fee for the Patent of addition during the term of the main patent.</p> <p>f) A patent of addition expires along with the main patent. However, if the main patent is revoked, the patent of addition may be converted into an independent patent, if so requested by the patentee and the renewal fee for the remaining term of the patent need to be paid accordingly.</p> <p>g) Date of filing shall be the date on which the application for patent of addition has been filed.</p>	<p>Section 54, 55</p>
<p>06.02.02</p>	<p>Novelty and Inventive step</p> <p>An application for Patent of Addition cannot be challenged on the ground of lack of inventive step with respect to the disclosure in the main application or patent. But the disclosure in main application or patent may be cited for novelty against the application for patent of addition.</p>	<p>Section 56</p>

	In the matter of Ravi Kamal Bali v/s Kala Tech and others the Bombay High Court on 12th February, 2008 dismissed the defendant's arguments that Patent of addition can only be granted if it has an inventive step over the main application.	
06.02.03	<p>Reference</p> <p>The complete specification of application for patent of addition shall include specific reference to the number of main patent or the application for main patent, as the case may be, and a definite statement that the invention comprises an improvement in, or a modification of the invention claimed in the specification of the main patent, granted or applied for.</p>	Rule 13(3)

Chapter -7: Convention Application, International Application and National Phase Application

07.01	Convention Application	
07.01.01	<p>Paris Convention and WTO Agreement</p> <p>Paris Convention of 1883 provides reciprocity in filing with the right of priority. India became member of the Paris Convention in 1998. India became a member of WTO Agreement in 1995 and member of Patent Co-operation Treaty in 1998.</p> <p>India became a member of the Budapest Treaty on the International recognition of the deposit of micro-organism for the purpose of patent procedure in 2001. It provides a mechanism for depositing biological material in the internationally recognized depository authorities for the purpose of supplementing the description in the specification.</p>	Section 133
07.01.02	<p>Convention Country</p> <p>Any country which is a signatory or party or a group of countries, union of countries or inter-governmental organizations which are signatories or parties to an international, regional or bi-lateral treaty, convention or arrangement to which India is also a signatory or party, and, which affords to the applicants for patents in India or to citizens of India similar privileges as are granted to their own citizens or citizens to their member countries in respect of the grant of patents and protection of patent rights, shall be a convention country or convention countries for the purposes of this Act.</p> <p>At present, India is a member of WTO and a member country to the Paris Convention and a contracting state to the PCT. Any country, union of countries or inter-governmental organizations, which are members/contracting states to the above convention/treaty/agreement, are convention countries for the purposes of the Act.</p>	Section 2(1)(d), 133, 134
07.01.03	<p>Convention Application</p> <p>a) Where a person has made an application for a patent in respect of an invention in a Convention country (basic application), and that person or the legal representative or assignee of that person makes</p>	Section 135

	<p>an application under this Act for a patent within twelve months after the date on which the basic application was made, the priority date of a claim of the complete specification, being a claim based on matter disclosed in the basic application, is the date of making of the basic application.</p> <p>b) Where applications have been made for similar protection in respect of an invention in two or more convention countries, the period of twelve months referred to in this sub-section shall be reckoned from the date on which the earlier or earliest of the said applications was made.</p> <p>c) Where applications for protection have been made in one or more convention countries in respect of two or more inventions which are cognate or of which one is a modification of another, a single convention application may be made in respect of those inventions at any time within twelve months from the date of the earliest of the said applications for protection. However, the fee payable in respect of such application shall be the same as if separate applications have been made in respect of each of the said inventions.</p>	
<p>07.01.04</p>	<p>Documents to be submitted</p> <p>1) Every convention application shall:</p> <ul style="list-style-type: none"> i. be accompanied by a complete specification; ii. specify the date on which the first of such applications was made and the convention country in which such application for protection is sought and iii. state that no application for protection in respect of the invention had been made in a convention country before that date by the applicant or by any person from whom he derives title. <p>2) a complete specification filed with a convention application may include claims in respect of developments of, or additions to, the invention in respect of which the application for protection was made in a convention country, being developments or additions in respect of which the applicant would be entitled under the provisions of section 6 to make a separate application for a patent.</p>	<p>Section 136, 138. Rule 121</p>

	<p>3) be accompanied by an abstract</p> <p>4) a certified copy of the priority document, if the Controller requires the same, may be filed within 3 months from the date of communication by the Controller of such requirement.</p> <p>5) accompanied by a verified English translation of such document, if the priority document is in a language other than English.</p>	
07.01.05	<p>Multiple priorities</p> <p>a) When two or more applications for patents constituting one invention have been made in one or more convention countries, one application may be made within twelve months from the date on which the earlier or earliest of those applications was made in respect of the inventions disclosed in the specifications which accompanied the basic applications.</p> <p>b) The priority date of a claim of the complete specification, being a claim based on matters disclosed in one or more of the basic applications, is the date on which that matter was first so disclosed.</p> <p>c) For the purposes of this Act, a matter shall be deemed to have been disclosed in a basic application for protection in a convention country if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgement of a prior art) in that application, or any documents submitted by the applicant for protection in support of and at the same time as that application but no account shall be taken of any disclosure effected by any such document unless a copy of the documents is filed at the patent office with the convention application or within such period as may be prescribed after the filing of that application.</p>	Section 135(2), 137
07.01.06	<p>Other conditions</p> <p>a) The term of patent of a convention application shall be twenty years from the date of filing of the Application in India.</p> <p>b) A Convention Application can be divided, and the divided Application shall have the same priority date.</p> <p>c) A Convention Application shall not be post-dated under sub-section (1) of section 17 to a date later than the date on which the</p>	Section 136, 139

	application could have been made under the provisions of this Act.	
07.02	International Application under PCT	
07.02.01	<p>PCT International application by Indian applicant</p> <p>An Indian applicant can file a PCT International application in the following manner:</p> <ol style="list-style-type: none"> i. If the international application is filed before 6 weeks from the date of the priority in India, the foreign filing permission under section 39 has to be obtained from the appropriate patent office. ii. If the international application is filed directly at RO/IB or RO/IN (i.e. without a priority claim), foreign filing permission under section 39 has to be obtained from the appropriate patent office. <p>If the applicant fails to obtain the foreign filing permission under section 39, the application will not be considered as international application by RO/IN.</p> <p>If any person fails to comply with any direction given under section 35 or makes or causes to be made an application for the grant of a patent in contravention of section 39, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.</p>	Section 39, 118, Rule 4
07.02.02	<p>Indian Patent Office as Receiving Office and requirements:</p> <p>(a) (i) Online filing:</p> <p>An International patent application can be filed in Indian Patent Office as a Receiving Office, in request form (PCT/RO/101), through the e-PCT module of WIPO (https://pct.wipo.int) along with application body, declaration, PoA (In case of agents), MSME Certificate in case of small entity or certificate of recognition as Startup issued by DPIIT for claiming fee reduction in transmittal and priority document fees.</p> <p>(ii) Offline filing:</p> <p>An International patent application can be filed in Indian Patent Office as a Receiving Office, in request form (PCT/RO/101), which can be downloaded from the WIPO website, and has to be submitted in triplicates along with application body, declaration, PoA (in case of agents), MSME Certificate in case of small entity or certificate of recognition as Startup issued by DPIIT for</p>	Section 2(1) (ia), 7(1A), 39 PCT/RO/101

	<p>claiming fee reduction in transmittal and priority document fees.</p> <p>In case of both online and offline filing, a foreign filing permission under section 39 shall be submitted, if required.</p> <p>(b) If the applicant is a natural person, who is national and resident of India, is entitled to a reduction of 90% of international filing fee. If there is more than one applicant, each must satisfy the above mentioned criteria.</p> <p>(c) In case ISA/US is selected as Search Authority is, the applicant has to submit the following documents:</p> <ul style="list-style-type: none"> • Certificate of Micro Entity status in Form PTO/SB/15A of USPTO for claiming micro-entity fee reduction. • Small Entity assertion/declaration for claiming small entity fee reduction. <p>International Bureau as Receiving Office</p> <p>An international patent application can be directly filed with IB along with the prescribed fee, in request form (PCT/RO/ 101), in duplicate. Permission u/s 39 is required for filing directly in IB. Such application can also be filed electronically via e-PCT route.</p>	
07.02.03	<p>Functions of Indian Patent Office as Receiving Office:</p> <ul style="list-style-type: none"> • Receiving Office (RO) receives International Application (IA) and does the following verifications: <ul style="list-style-type: none"> ✓ Formality Check :Nationality/Residence ✓ At least one of the applicants must have the right to file with the RO ✓ The application must be in a language accepted by the RO (English/Hindi) ✓ If formality criteria are not satisfied, then IA may be referred to IB for further processing. ✓ Accords or refuses the international filing date (Article 11(1)) • Checks the technical elements of International application. The application must contain at least: <ul style="list-style-type: none"> ✓ An indication that it is intended as an international application ✓ A request which has the effect of making all possible designations (Article 4 and Rules 3 and 4.9) 	Section 35, Article 3, 4,11, 14, 16 of PCT. PCT- Receiving Office Guidelines

	<ul style="list-style-type: none"> ✓ The name of the applicant (Rule 4.5) ✓ A description (Rule 5) ✓ A claim (Rule 6) • Decides on requests for incorporation by reference of missing elements or parts (Rules 20.5 to 20.7) • Checks whether translation of international application is required (Rules 12.3 and 12.4) • Checks if the required fees (RO/IB /ISA) are timely paid (Rule14,15, 16bis) • Checks priority claim(s) (Rules 4.10 and 26bis) • Decides on requests for restoration of the priority right (Rule 26bis.3) • Specifies the <i>International Searching Authority</i> • Specifies <i>the International Preliminary Examining Authority</i> • Checks for national security clearance/FFL (as per section 39 of Patent Act 1970) • Forwards the record copy to IB and the search copy to ISA, including any required translation (Article 12, Rules 22.1 and 23.1) • Forwards and receives correspondence from applicants and the international authorities • Prepares the priority documents of PCT applications filed with it. • COMPETENT INTERNATIONAL SEARCHING AUTHORITIES (ISAs) (Article 16, Rule 35) <ul style="list-style-type: none"> ✓ Indian Patent Office (IN) ✓ Austrian Patent Office (AT) ✓ Australian Patent Office (AU) ✓ European Patent Office (EP) ✓ The State Intellectual Property Office of The People's Republic of China (CN) ✓ United States Patent & Trademark Office (US) ✓ Swedish Patent And Registration Office (SE) <p style="text-align: center;">Updated information is available on WIPO website (www.wipo.int)</p>	
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	<ul style="list-style-type: none"> • Fees payable to the receiving Office (RO) <ul style="list-style-type: none"> ➤ transmittal fee (No fee , if applied through e-PCT) ➤ international filing fee (for IB) ➤ search fee (for ISA) ➤ supplement to the international filing fee for each sheet in excess of 30 (for IB) ➤ <i>fee for priority document</i> (No fee to be paid if applied through WIPO DAS) ➤ <i>late payment fee</i> ➤ <i>late furnishing fee (translation of international application)</i> ➤ <i>fee for copies of documents</i> <p><i>(Fees indicated in italics are to be paid only as per instructions from RO).</i></p> <p>Intimation to the applicant concerning payment of the prescribed fee is sent in Form PCT/RO/102.</p> 																														
07.02.04	<p>PCT Fee (may vary from time to time)</p> <p>All PCT fees are subject to change periodically. For latest fees, please refer the latest PCT newsletter at URL www.wipo.int.</p> <table border="1" data-bbox="386 1227 1264 1863"> <tr> <td colspan="2">International Filing Fee</td> <td>USD 1,352</td> </tr> <tr> <td colspan="2">Search Fees</td> <td></td> </tr> <tr> <td colspan="2">(AT)</td> <td>USD 2,053</td> </tr> <tr> <td colspan="2">(AU)</td> <td>USD 1,589</td> </tr> <tr> <td colspan="2">(CN)</td> <td>USD 306</td> </tr> <tr> <td colspan="2">(EP)</td> <td>USD 2053</td> </tr> <tr> <td colspan="2">(SE)</td> <td>USD 2095</td> </tr> <tr> <td colspan="2">(US)</td> <td>USD 2080 For small entity USD 1,040 For micro entity: USD 520</td> </tr> <tr> <td rowspan="2">(IN)</td> <td>INR 10000 (other than natural person)</td> <td>USD 144</td> </tr> <tr> <td>INR 2500 (for natural person)</td> <td>USD 36</td> </tr> </table> <ul style="list-style-type: none"> • The applicant can make the payment towards International filing fee and ISA fee (except ISA/IN) directly through NEFT /RTGS and submit the UTR/Ref no via email to RO/IN • RO prepares debit instructions to the bank and transmits the 	International Filing Fee		USD 1,352	Search Fees			(AT)		USD 2,053	(AU)		USD 1,589	(CN)		USD 306	(EP)		USD 2053	(SE)		USD 2095	(US)		USD 2080 For small entity USD 1,040 For micro entity: USD 520	(IN)	INR 10000 (other than natural person)	USD 144	INR 2500 (for natural person)	USD 36	Rule 16bis of Regulations under the PCT
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(IN)	INR 10000 (other than natural person)	USD 144																													
	INR 2500 (for natural person)	USD 36																													

	<p>payment subsequently to IB and ISA and also intimate the same through e mail to the concerned International authority.</p>	
07.02.05	<p>International Search</p> <ol style="list-style-type: none"> 1. International search report is established by the International Searching Authority chosen by the applicant in international application. The International Searching Authority provides a written opinion on patentability along with international search report. 2. If the international application did not claim priority of a previously filed Indian patent application, the international search report is normally made available within nine months from the international filing date. If priority is claimed, that report is made available usually by the 16th month from the priority date. Even where priority is claimed, the international search report is normally made available before publication of the international application. This allows time for the applicant to withdraw the application before publication, if desired. 3. On receipt of the international search report the applicant may amend the claims (under Article 19) in light of the international search report with effect in all designated States. The time limit referred to in Article 19 is two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority or 16 months from the priority date, whichever time limit expires later. However, any amendment made under Article 19 which is received by the International Bureau after the expiration of the applicable time limit is considered to have been received by the Bureau on the last day of the time limit if it reaches before the technical preparations for international publication have been completed. 4. Such amendments save costs for preparation of different sets of amendments and for local Agents filing such amendments before Designated Offices. 5. Indian Patent Office has been recognized as an International Searching Authority (ISA) and an International Preliminary 	<p>Article 15, 16, 17, 18, 19 of PCT.</p>

	<p>Examining Authority (IPEA) at the meeting of the General Assemblies of WIPO held in September – October, 2007.</p> <p>6. The Indian Patent Office started functioning as an International Searching Authority (ISA) and an International Preliminary Examining Authority (IPEA) from October, 2013.</p>	
07.02.06	Withdrawals of International Application	
	<p>Withdrawal of Application</p> <ol style="list-style-type: none"> 1. The applicant may withdraw the international application at any time prior to the expiration of 30 months from the priority date. 2. Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the Receiving Office or, where Article 39(1) applies to the International Preliminary Examining Authority. 3. No international publication of the international application shall be effected if the notice of withdrawal sent by the applicant or transmitted by the Receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for international publication have been completed. <p>Withdrawal of Designations</p> <ol style="list-style-type: none"> 1. The applicant may withdraw the designation of any designated State at any time prior to the expiration of 30 months from the priority date. Withdrawal of the designation of a State which has been elected shall entail withdrawal of the corresponding election under Rule 90bis.4. 2. Where a State has been designated for the purpose of obtaining both, a national patent and a regional patent, withdrawal of the designation of that State shall be taken to mean withdrawal of only the designation for the purpose of obtaining a national patent, except where otherwise indicated. 3. Withdrawal of designations of all designated States shall be treated as withdrawal of the international application under Rule 90bis.1. 4. Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the Receiving Office or, where Article 39(1) applies, to the 	<p>Article 8(1), 20 (1), 21(2) (a), 23 (2), 39(1), 40 (2) of PCT. Rule 4.15 (b), 45bis.8, 53.8 (b), 90bis, 90.2(b) of Regulations under the PCT.</p>

International Preliminary Examining Authority.

5. No international publication of the designation shall be effected if the notice of withdrawal sent by the applicant or transmitted by the Receiving Office or the International Preliminary Examining Authority reaches the International Bureau before the technical preparations for international publication have been completed.

Withdrawal of Priority Claims

1. The applicant may withdraw a priority claim, made in the international application under Article 8(1), at any time prior to the expiration of 30 months from the priority date.
2. Where the international application contains more than one priority claim, the applicant may exercise the right provided for in paragraph (a) of PCT Rule 90bis3 in respect of one or more or all of the priority claims.
3. Withdrawal shall be effective on receipt of a notice addressed by the applicant, at his option, to the International Bureau, to the Receiving Office or, where Article 39(1) applies, to the International Preliminary Examining Authority.
4. Where the withdrawal of a priority claim causes a change in the priority date, any time limit which is computed from the original priority date and which has not already expired shall, subject to paragraph (e) of PCT Rule 90bis3, be computed from the priority date resulting from that change.
5. In the case of the time limit referred to in Article 21(2)(a), the International Bureau may nevertheless proceed with the international publication on the basis of the said time limit as computed from the original priority date if the notice of withdrawal sent by the applicant or transmitted by the Receiving Office or the International Preliminary Examining Authority reaches the International Bureau after the completion of the technical preparations for international publication.

Withdrawal of Supplementary Search Request

1. The applicant may withdraw a supplementary search request at any time prior to the date of transmittal to the applicant and to the

International Bureau, under Rule 45bis.8(a), of the supplementary international search report or the declaration that no such report will be established.

2. Withdrawal shall be effective on receipt, within the time limit under paragraph (a) of PCT Rule 90bis.3bis, of a notice addressed by the applicant, at his option, to the Authority specified for supplementary search or to the International Bureau, provided that, where the notice does not reach the Authority specified for supplementary search in sufficient time to prevent the transmittal of the report or declaration referred to in paragraph (a) of PCT Rule 90bis.3bis, the communication of that report or declaration under Article 20(1), as applicable by virtue of Rule 45bis.8(b), shall nevertheless be effected.

Withdrawal of Demand or of Elections

1. The applicant may withdraw the demand or any or all elections at any time prior to the expiration of 30 months from the priority date.
2. Withdrawal shall be effective upon receipt of a notice addressed by the applicant to the International Bureau.
3. If the notice of withdrawal is submitted by the applicant to the International Preliminary Examining Authority, that Authority shall mark the date of receipt on the notice and transmit it promptly to the International Bureau. The notice shall be considered to have been submitted to the International Bureau on the date marked.

Signature

1. Any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 shall be signed by the applicant or, if there are two or more applicants, by all of them. An applicant who is considered to be the common representative under Rule 90.2(b) shall, not be entitled to sign such a notice on behalf of the other applicants.

Effect of Withdrawal

1. Withdrawal under Rule 90bis of the international application, any designation, any priority claim, the demand or any election shall

	<p>have no effect in any designated or elected Office where the processing or examination of the international application has already started under Article 23(2) or Article 40(2).</p> <ol style="list-style-type: none"> 2. Where the international application is withdrawn under Rule 90bis.1, the international processing of the international application shall be discontinued. 3. Where a supplementary search request is withdrawn under Rule 90bis.3bis, the supplementary international search by the Authority concerned shall be discontinued. 4. Where the demand or all elections are withdrawn under Rule 90bis.4, the processing of the international application by the International Preliminary Examining Authority shall be discontinued. 	
07.02.07	International Preliminary Examination	
	<p>Significance</p> <ol style="list-style-type: none"> 1. International Preliminary Examination is optional for the applicant and provides, in addition to the International Search Report, a second opinion on the usual criteria of patentability before expenses are incurred for the national phase (for translation, fees for Agents/Attorneys etc.). 2. Helps the applicant to adapt the international application in accordance with the results of the international search report; 3. If the report is negative, the applicant may decide to abandon the application. However, the opinions from ISA & IPEA are non-binding on the member countries. <p>International Preliminary Examining Authorities</p> <p>For an Indian applicant, the following are competent International Preliminary Examining Authorities (IPEAs):</p> <ol style="list-style-type: none"> 1. Austrian Patent Office (AT) 2. Australian Patent Office (AU) 3. European Patent Office (EP) (Only if ISA was AT, EP or SE) 4. The State Intellectual Property Office of the People's Republic of China (CN) 5. United States Patent & Trademark Office (US) 	<p>Article 33, 34, 35, 17(2)</p>

	<p>6. Swedish Patent and Registration Office (SE) 7. Indian Patent Office (IN)</p> <p style="text-align: center;">Updated information is available on WIPO Website (www.wipo.int)</p> <p>Demand for International Preliminary Examination</p> <ol style="list-style-type: none"> 1. The demand for international preliminary examination shall be made separately from the international application. 2. The demand for international preliminary examination may be made to the Indian Patent Office, Delhi, International Bureau or to any of the six competent International Preliminary Examining Authorities mentioned above. 3. The demand shall contain the prescribed particulars and shall be in the prescribed language and form. The demand shall be subject to payment of the prescribed fees within the prescribed time limit. 4. The demand for International Preliminary Examination has to be made: <ol style="list-style-type: none"> a. Within 22 months from the date of priority, or b. Within 3 months from the date of transmittal of International Search Report and written opinion to the applicant or the declaration under Article 17(2), whichever is later. <p style="margin-left: 40px;">The fees to be paid by the applicant are given in the PCT Newsletter which is available on the WIPO website, www.wipo.int.</p> 	
07.03	PCT National Phase Application	
07.03.01	<p>General</p> <ol style="list-style-type: none"> 1. The national phase follows the international phase. It is necessary for an applicant to file a national phase application in each designated country, where protection is sought, within the time prescribed under PCT, i.e., within 30/31 months from the priority date, as the case may be. However, this time limit may be increased through national laws by each member country. 2. Indian Patent Law provides a time limit of 31 months from the priority date. Some countries allow extension of such time limit on payment of additional fee. <p>For making a national phase application before the Designated</p>	<p>Article 22, 23 of PCT, Rule 20 of The Patent Rules, 2003</p>

	<p>Office, the applicant shall:</p> <ol style="list-style-type: none"> a. pay the prescribed national fee; and b. file a duly verified translation of basic application, if necessary. <p>3. International filing date is the deemed date of filing in India if the applicant enters the national phase in India by filing a national phase application within thirty one months from the date of priority.</p> <p>4. The international filing allows the preservation of priority from the date of filing of first application in the convention country.</p>	
07.03.02	<p>Basic Requirements to enter National Phase in India</p> <ol style="list-style-type: none"> 1. The applicant has to file national phase application within 31 months from the priority date or international filing date of application, whichever is earlier. The application with respect to the national phase application may be made in Form -1. 2. The appropriate office for filing of national phase application shall be decided as per address for service in India, which shall be furnished by the applicant in Form 1. 3. Where the international application has not been filed or published in one of the official languages (Hindi or English), a translation of the application, description, claims (if amended, both as originally filed and amended together with any statement), drawings, if any, and abstract should be submitted along with the application. 4. For the national phase application, the title, description, drawings, abstract and claims as filed with the international application under PCT shall be taken as the complete specification. However, if the applicant has amended the complete specification under Chapter-I and/or Chapter-II of the PCT, such amended specification shall be taken as the complete specification for the purpose of filing in India. <p>In case of difference between the translation of title as translated by the PCT and that provided in the verified English translation, the latter shall be taken on record.</p>	Rule 14, 20, 21

5. The applicant may make a request to the Controller for amendment of the complete specification which was filed with the national phase application, as a separate request in Form-13, along with the application. The fee payable in respect of a national phase application is calculated as per the number of pages and claims as they stand in the PCT international application on the date of filing in India.
6. If the applicant makes an amendment in an international application before ISA and/or IPEA, it shall, if the applicant so desires, be taken as an amendment before the Patent Office, prior to entry in national phase.
7. However, at the time of filing the national phase application corresponding to international application designating India, the applicant may delete a claim as provided in rule 20 (1), in accordance with the provisions contained in Rule 14, without filing an application for amendment.

It is clarified that only deletion of claims is allowable and no other amendment, such as addition, revision or modification of claims, is allowable.

However, this option as to deletion of claims is not applicable for the applications filed prior to amendments of the Patents Rules 2003 implemented w.e.f. 16-05-2016.

It is further clarified that if deletion of claim(s) results in consequent changes in dependency of remaining of claims, the same shall be allowable and no separate request for amendment is required.
8. If a change in the name of applicant/ change of applicant has occurred after the international filing date and has not been reflected in the notification from the International Bureau (Form PCT/IB/306), such change may be effected by filing Form 13/Form 6, as the case may be.
9. If PCT/IB/304 is available on the website of WIPO, the Patent Office shall not require the applicant to submit the priority document. If not available on the website of WIPO, the Office

	<p>may request for the same from the applicant. If the applicant filed a priority document through WIPO-DAS in such case, the applicant shall provide the code for accessing the priority document.</p> <p>10. However, if the applicant has not complied with the requirements of rule 17.1 paragraph(a) or paragraph (b)of the regulations made under the PCT, he shall submit the priority document to the office before the expiry of thirty one months from the date of priority.</p> <p>11. Where the applicant does not comply with the requirements of (10) above, the Controller shall invite the applicant to file the priority document or the translation thereof within three months from the date of such invitation. If the applicant fails to do so, the claim of the applicant for the priority shall be disregarded for the purposes of the Act.</p> <p>12. All other formalities that are required for filing and processing an ordinary patent application shall apply to a national phase application.</p> <p>13. Processing of a national phase application will not commence before the expiry of 31 months from the date of priority. However, the applicant may file an express request for examination before 31months in Form 18 under Rule 20 (4)(ii).</p> <p>14. If the applicant for national phase application is willing for expedited examination under Rule 24 C (1) before the expiry of 31 months from the date of priority, he shall file Form 18-A with requisite fees for expedited examination along with express request in Form 18 under Rule 20 (4)(ii) with fees.</p> <p>15. International application filed under PCT designating India is considered as a convention application under Section 135 for which the filing date is the date of international application.</p>	
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Chapter - 8: Indian International Searching Authority and Indian International Preliminary Examination Authority

08.01	<p>India as ISA/IPEA</p> <p>The Patent Cooperation Treaty, administered by the World Intellectual Property Organization (WIPO), provides the applicant from a member country, the facility for filing a single international application for grant of patent in all the PCT member countries. It also has the additional benefits of obtaining International Search Report (ISR), and International Preliminary Examination Report (IPER) before entering the national phase in each individual country. The ISR and IPER are established according to high internationally regulated standards, by one of the Patent Offices of the world that are highly experienced in examining patent applications and that have been specially appointed by WIPO to carry out international search and examination.</p> <p>The Indian Patent Office (IPO) was recognized as an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) under the PCT and started functioning as ISA and IPEA from 15th October 2013. As per requirement for ISA/IPEA, IPO has access to the comprehensive collection of patent and non-patent literature in order to fulfill PCT minimum documentation requirement, integrated search platform IPATS to enable one click search through the vast collection of information and professionally qualified and skilled Examiners. IPO has also established a Quality Management System to monitor the ISA/IPEA reports. Fully electronic processing system ensures speedy disposal and dissemination of information on real time basis.</p>	
08.02	<p>Applicants in ISA/IPEA</p> <p>Applicants for PCT international applications who are nationals/ residents of India and Iran can select Indian Patent Office as ISA/ IPEA. Indian applicants choosing IPO as ISA/ IPEA include individual inventors, startups, research institutions, universities, Indian multi-national conglomerates, Indian units of foreign multi-national firms and foreign firms with Indian inventors or Indian companies as co-applicants.</p>	

<p>08.03</p>	<p>Indian International Searching Authority</p> <ol style="list-style-type: none"> 1. Patent Office, Delhi performs the functions of Indian International Searching Authority under the Treaty in accordance with the agreement between Indian Patent Office and International Bureau. 2. The fees payable to the Searching Authority includes fees as specified in the Fifth Schedule, in addition to the fees specified in the regulations made under the Treaty. 3. The Searching Authority establishes international search report in respect of international applications or, as the case may be, declares, in accordance with sub-rule (3) of rule 19B that meaningful search cannot be established, in cases where India has been indicated as a competent International Searching Authority. 	<p>Rule 19-A</p>
<p>08.04</p>	<p>International Search Report</p> <ol style="list-style-type: none"> 1. The Searching Authority, on receipt of the search copy, notifies International Bureau and the applicant about receipt of search copy, with identification mark 'ISA/IN' along with international application number and its serial number and date of receipt of the search copy. 2. Notwithstanding anything contained in the proviso to item (i) of sub-rule (2) of rule 24B, the Searching Authority shall, upon receipt of the search copy, refer the international application, in the order in which the search copy was received, to an examiner or any other officer appointed under sub-section (2) of Section 73 of the Act for preparing an international search report, in accordance with the provisions contained in the Treaty and the regulations under the Treaty, ordinarily within a period of one month, but not exceeding two months from the date of such reference. 3. If the Searching Authority considers that, in accordance with rule 19-B(3) , the international application relates to a subject matter which the Searching Authority is not required to search and, accordingly, decides not to search; or the description, claims or drawings fail to comply with the requirements prescribed under the regulation under the Treaty to such an extent that a meaningful search could not be carried out, then the Authority declares and 	<p>Rule 19-B</p>

notifies the applicant and International Bureau that no international search report shall be established.

4. In a case where any situation referred to in clause (a) or clause (b) of rule 19-B(3) is found to exist in connection with certain claims only, the Searching Authority indicates this fact in the International Search Report in respect of such claims, and for other claims, it establishes the International Search Report.
5. If the Searching Authority considers that the international application does not comply with the requirement of unity of invention in accordance with the provisions contained in Rule 13 of the regulations under the Treaty, then it sends a notice specifying the reasons because of which the international application is not considered as complying with the requirement of unity of invention.

Subsequently, the applicant is invited to:

- a. pay the additional fees as specified in the Fifth Schedule indicating the amount of fees to be paid, within a period of one month from the date of such invitation; and,
 - b. pay, where applicable, the protest fee specified in the Fifth Schedule indicating the amount of fee to be paid, within a period of one month from the date of such invitation.
6. The Searching Authority establishes International Search Report on those parts of the international application which relate to the invention first mentioned in the claims (main invention) and, subject to payment of additional fee within the period specified in sub-rule (5), on those parts of the international application which relate to inventions in respect of which such additional fees were paid.
 7. Any applicant may pay the additional fees under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fees is excessive.
 8. The examination of the protest referred to in sub-rule (7) is carried out by a Review Committee constituted by the Controller.

	<p>9. The Review Committee constituted under sub-rule (8) examines the extent to which the protest is justified and, accordingly, orders for the total or partial reimbursement of the additional fee to the applicant.</p> <p>10. Where the applicant has not paid fees for the protest in accordance with clause (b) of sub-rule (5), the protest is considered not to have been made and the same is declared by the Searching Authority.</p> <p>11. Where the international application contains the disclosure of one or more nucleotide or amino acid sequences and the sequences are not furnished in computer-readable text format, the Searching Authority sends a notice to the applicant to submit the sequence listing in computer-readable text format and pay the late furnishing fee as specified in the Fifth Schedule, within a period of one month from the date of such notice and, if the applicant fails to comply with the notice, the Searching Authority searches the international application to the extent that a meaningful search can be carried out without the sequence listing.</p>	
08.05	<p>Time limit for establishing international search report</p> <p>The Searching Authority establishes the International Search Report and written opinion or, as the case may be, the declaration referred to in sub-rule (3) of rule 19B within a period of three months from the date of receipt of the search copy by the Searching Authority, or within a period of nine months from the date of priority, whichever expires later.</p>	Rule 19-C
08.06	<p>Transmittal of International Search Report and written opinion</p> <p>The Searching Authority transmits one copy of the International Search Report or of the declaration referred to in Article 17(2)(a) of the Treaty, and one copy of the written opinion established under Rule 43bis.1 of the regulations under the Treaty, to the International Bureau and one copy to the applicant, on the same day.</p>	Rule 19-D
08.07	<p>Confidential treatment</p> <p>All matters pertaining to international applications are kept confidential in accordance with the treaty and the regulations under the Treaty.</p>	Rule 19-E
08.08	<p>Indian International Preliminary Examining Authority</p> <p>1) The Patent Office, Delhi branch performs the functions of the International Preliminary Examining Authority under the Treaty in</p>	Rule 19-F

	<p>accordance with an agreement between the Indian Patent Office and the International Bureau.</p> <p>2) The Examining Authority establishes-</p> <p>a) the International Preliminary Examination Report in respect of all international applications electing India as an International Preliminary Examining Authority;</p> <p>b) the International Preliminary Examination Report in respect of the demands filed by the nationals or residents of other countries in accordance with an agreement between Indian Patent Office and the International Bureau, upon being notified by the International Bureau;</p> <p>c) the International Preliminary Examination in respect of demands made by the nationals or residents of other countries not party to the Treaty or not bound by Chapter II of the Treaty, if the Assembly has so approved.</p>	
08.09	<p>Period for making Demand</p> <p>1. Demand for international preliminary examination is made within the period specified in the Treaty or regulations under the Treaty.</p> <p>2. In case the demand is made after the expiry of the period specified in sub-rule (1), it is considered to have not been made and no International Preliminary Examination Report shall be prepared.</p>	Rule 19-G
08.10	<p>Fees payable to Examining Authority</p> <p>The fees payable to the Examining Authority includes the fees specified in the Fifth Schedule, in addition to the fees specified in the regulations under the Treaty.</p>	Rule 19-H
08.11	<p>Manner of making a demand</p> <p>A demand shall be made in accordance with the provisions contained in the rules, the Treaty and the regulations under the Treaty.</p>	Rule 19-I
08.12	<p>Processing of demands for international preliminary examination</p> <p>The Examining Authority, on receipt of the demand for international preliminary examination, if the Examining Authority is competent to conduct an international preliminary examination, assigns the identification mark 'IPEA/IN' and notifies the Applicant and the International Bureau.</p>	Rule 19-J

	In case where the Examining Authority is not competent to conduct the international preliminary examination of the international application, it transmits the demand promptly to the International Bureau.	
08.13	<p>International Preliminary Examination Report</p> <ol style="list-style-type: none"> 1. Notwithstanding anything contained in the proviso to item (i) of sub-rule (2) of rule 24B, the Examining Authority refers the international application, in accordance with the provisions contained in the Treaty and the regulations under the Treaty, in the order in which the demand was received in the Examining Authority to an examiner or any other officer appointed under sub-section (2) of section 73 of the Act for preparing an International Preliminary Examination Report ordinarily within a period of three months but not exceeding four months from the date of such reference. 2. Claims relating to inventions in respect of which no International Search Report has been established shall not be the subject of international preliminary examination. 3. If the Examining Authority considers that- <ol style="list-style-type: none"> a. the international application relates to a subject matter on which the Examining Authority is not required to carry out an international preliminary examination, and, decides not to carry out such examination; or b. that the description, claims, or drawings, are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the questions of novelty, inventive step (non-obviousness), or industrial applicability, c. then the Examining Authority does not go into these questions and informs the applicant of this opinion and the reasons therefor. 4. In a case where any situation referred to in clause (a) or clause (b) of sub-rule (3) is found to exist in connection with certain claims only, the Examining Authority indicates this fact in the International Preliminary Examination Report in respect of such claims, and for other claims, it establishes the International Preliminary Examination Report. 	Rule 19-K

	<p>5. Where the Examining Authority finds that the international application does not comply with the requirement of unity of invention, in accordance with the provisions contained in Rule 13 of the regulations under the Treaty and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees, it issues a notice to the applicant:</p> <ol style="list-style-type: none"> a. specifying at least one possibility of restriction which, in the opinion of the Examining Authority, would be in compliance with the applicable requirement; b. specifying the reasons for which the international application is not considered as complying with the requirement of unity of invention; c. inviting the applicant to comply with the invitation within one month from the date of such notice; d. indicating the amount of the required additional fees to be paid in case the applicant so chooses; and e. inviting the applicant to pay, the protest fee within one month from the date of such notice, and indicate the amount to be paid, as specified in the Fifth Schedule. <p>6. Any applicant may pay the additional fees under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fees is excessive.</p> <p>7. The examination of the protest is carried out by a Review Committee constituted by the Controller.</p> <p>8. The Review Committee constituted examines the extent to which the protest is justified and accordingly orders for the total or partial reimbursement to the applicant of the additional fee.</p> <p>9. The protest fee is refunded to the applicant where the Review Committee referred to in sub-rule (6) finds that the protest was entirely justified.</p>	
<p>08.14</p>	<p>Period for establishing International Preliminary Examination Report and its transmission</p> <p>The period for establishing the International Preliminary Examination</p>	<p>Rule 19L</p>

	<p>Report shall be:</p> <ol style="list-style-type: none"> a. twenty eight months from the priority date; or b. six months from the period specified under Rule 69.1 of the regulations under the Treaty for the start of the international preliminary examination; or c. six months from the date of receipt by the Examining Authority of the translation furnished under Rule 55.2 of the regulations under the Treaty, whichever expires last. 	
08.15	<p>Transmittal of International Preliminary Examination Report</p> <p>The Examining Authority transmits one copy of International Preliminary Examination Report and its annexures, if any, to the International Bureau, and one copy to the applicant, on the same day.</p>	Rule 19M
08.16	<p>Conditions for and extent of refund</p> <p>The fee paid by the applicant may be refunded, waived or reduced to the extent and in accordance with the conditions specified in the Treaty or the regulations under the Treaty and the agreement entered between the Indian Patent Office and the International Bureau.</p>	Rule 19N

Chapter- 9: Examination & Grant

09.01	<p>Request for Examination</p> <ol style="list-style-type: none"> 1. An Application for a Patent shall not be examined unless the applicant or any other person interested makes a request for examination. The request is to be filed in Form 18 or Form 18A (as the case may be) along with the fee as prescribed in First Schedule. 2. A request for examination has to be made within forty- eight months from the date of priority of the application or from the date of filing of the application, whichever is earlier. If no such request for examination is filed within the prescribed time limit, the application shall be treated as withdrawn by the applicant. In a case where secrecy direction has been issued under Section 35, the request for examination may be made within six months from the date of revocation of the secrecy direction, or within forty-eight months from the date of filing or priority, whichever is later.4. The request for examination of application as filed according to the 'Explanation' under sub-section (3) of section 16 (Divisional application) shall be made within forty-eight months from the date of filing of the application or from the date of priority of the first mentioned application or within six months from the date of filing of the further application, whichever is later. 3. The Patent Office shall not commence processing of an application filed corresponding to international application designating India before the expiration of the thirty one months from the priority date. However, the Patent Office may, on the express request filed in Form 18 along with the fee specified in First Schedule, process or examine the application at any time before thirty one months. 4. The Office will not examine an application unless it is published and a request for examination is filed. 5. When a request for examination is filed by a person interested other than the applicant, the Examination Report is sent to the applicant only, and intimation is given to the person interested. <p>In the matter of Nippon Steel Corporation vs. Union of India (UOI)-W.P. (C) 801 Of 2011 (08.02.2011): Manu/De/07/12/ 2011,</p>	<p>Section 11B, 35. Rule 20(2), 20(4)(ii), 24B, 24C.</p>
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	<p>the Delhi High Court held that once application is deemed to have been withdrawn by applicant in terms of Section 11B(4) of Act, the Controller of Patents cannot entertain application for amending any portion of such application. It is not possible to accept submission of petitioner that Controller of Patents is bound to allow amendment at any time, even after deemed withdrawal of such application. The Court also noted that the Petitioner missed the deadline for filing Request for examination accordingly.</p> <p>In the matter of Sphaera Pharma, Pte. Ltd And Anr. vs Union Of India And Anr. on 16 February, 2018 the Delhi High Court held that any request for extension of time prescribed has to be made before the expiry of such time as prescribed in the Rules. Therefore, even if the express language of Rule 138 of the Rules is ignored, the benefit of Rule 138 would not be available to the petitioner (who requested for extension of time under Rule 138 to file a request for examination in Form 18), as no such application for extension of time was made prior to expiry of the prescribed time.</p>	
09.01.01	<p>Expedited examination of applications</p> <p>1. An applicant may file a request for expedited examination in Form 18A, along with the fee, only by electronic transmission, duly authenticated, within 48 months from the date of filing or Priority date, whichever earlier on any of the following grounds:</p> <ul style="list-style-type: none"> (a) India has been chosen as the competent International Searching Authority or elected as an International Preliminary Examining Authority in the corresponding international application; or (b) that the applicant is a startup; or (c) that the applicant is a small entity; or (d) that if the applicant is a natural person or in the case of joint applicants, all the applicants are natural persons, then the applicant or at least one of the applicants is a female; or (e) that the applicant is a department of the Government; or (f) that the applicant is an institution established by a Central, Provincial or State Act, which is owned or controlled by 	Rule 24B, 24C

	<p>the Government; or</p> <p>(g) that the applicant is a Government company as defined in clause (45) of section 2 of the Companies Act, 2013 (18 of 2013); or</p> <p>(h) that the applicant is an institution wholly or substantially financed by the Government;</p> <p>Explanation:- For the purpose of this clause, the term ‘substantially financed’ shall have the same meaning as in the Explanation to sub-section (1) of section 14 of the Comptroller and Auditor General’s (Duties, Powers and Conditions of Service) Act, 1971(56 of 1971); or</p> <p>(i) that the application pertains to a sector which is notified by the Central Government on the basis of a request from the head of a department of the Central Government.:</p> <p>Provided that public comments are invited before any such notification; or</p> <p>(j) that the applicant is eligible under an arrangement for processing a patent application pursuant to an agreement between Indian Patent Office and a foreign Patent Office.</p> <p>Explanation:- The patentability of patent applications filed under clause (j) above will be in accordance with the relevant provisions of the Act.”.</p> <p>2. A request for examination filed under rule 24B may be converted to a request for expedited examination under sub-rule (1) of rule 24C by paying the relevant fees and submitting requisite documents as prescribed.</p> <p>3. If the application is not published or a request for early publication is not filed, the Applicant shall file Form 9 with prescribed fee along with Form 18A.</p> <p>4. If the request for expedited examination does not comply with the requirements of this rule, such a request shall be processed as normal request for examination , with an intimation to the applicant, and shall be deemed to have been filed on the date on which the request for expedited examination was filed.</p> <p>5. The Controller shall refer the request for expedited examination</p>	
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along with the application and specification and other documents to the examiner, in respect of the applications where the request for expedited examination has been received, in the order of filing of such requests.

6. Provided that a request for expedited examination filed by a startup, as defined in Rule 2 (fb), under this rule shall not be questioned merely on the ground that the startup ceased to be a startup after having filed an application for patent.
7. The period within which the examiner shall make the report under sub-section (2) of section 12, shall ordinarily be one month but not exceeding two months from the date of reference of the application to him by the Controller.
8. The period within which the Controller shall dispose of the report of the examiner shall be one month from the date of receipt of such report by the Controller.
9. A first statement of objections along with any document, if required, shall be issued by the Controller to the applicant or his authorised agent within fifteen days from the date of disposal of the report of examiner by the Controller.
10. Reply to the first statement of objections and subsequent reply, if any, in respect of an application where the request for expedited examination was filed, shall be processed in the order in which such reply for such application is received.
11. The time for putting an application in order for grant under section 21 shall be six months from the date on which the first statement of objections is issued to the applicant.
12. The time for putting an application in order for grant under section 21, as prescribed in sub-rule (10) may be further extended for a period of three months on a request for extension made in Form 4 along with the prescribed fee, made to the Controller before the expiry of the period specified under sub-rule (10).
13. The Controller shall dispose of the application within a period of three months from the date of receipt of the last reply to the first

	<p>statement of objections or within a period of three months from the last date to put the application in order for grant under section 21 of the Act, whichever is earlier: Provided that this time limit shall not be applicable in case of pre-grant opposition.</p> <p>14. Notwithstanding anything contained this rule, the Controller may limit the number of requests for expedited examination to be received during the year by way of a notice to be published in the official journal.</p>	
<p>09.02</p>	<p>Reference for Examination</p> <ol style="list-style-type: none"> 1. Once a request for examination is received, and the application is published under section 11A, the application is taken up for Examination in the chronological order of filing of request for examination. 2. Accordingly, the Controller shall refer the application, specification and other documents related thereto to the examiner and such reference shall be made in the order in which the request is filed. 3. Provided that in case of a further application filed under section 16, the order of reference of such further application shall be the same as that of the first mentioned application. 4. Provided further that in case the first mentioned application has already been referred for examination, the further application shall have to be accompanied by a request for examination, and such further application shall be published within one month and be referred to the examiner within one month from the date of such publication. 5. The patent application is referred to an Examiner by the Controller for conducting the formal as well as substantive examination as per the subject matter of the invention vis-à-vis the area of specialization of the Examiner. At present, the Patent Office has four examination groups based on the broad area of specialization viz.: <ol style="list-style-type: none"> a. Chemistry and allied subjects. b. Biotechnology, Microbiology and allied subjects. c. Electrical, Electronics & related subject d. Mechanical and other subjects. 	<p>Section 11A, 12. Rule 24B(2)(i)</p>

	<p>6. The reference to the Examiner is made ordinarily within one month from the date of publication or one month from the date of request for examination, whichever is later, and is made in order in which the request is filed.</p> <p>7. When an application is referred by the Controller, the Examiner makes a report on the patentability as well as other matters ordinarily within one month but not exceeding three months from the date of such reference.</p> <p>8. The period within which the Controller shall dispose of the report of the Examiner shall ordinarily one month from the date of the receipt of the report by the Controller.</p> <p>9. A first statement of objections, along with any documents as may be required, shall be issued by the Controller to the applicant or his authorised agent within one month from the date of disposal of the report of examiner by the Controller:</p> <p>10. Provided that where the request for examination was filed by a person interested, only an intimation of such examination may be sent to such person interested.</p>	
09.03	Examination of application	
09.03.01	<p>Search for Anticipation by previous publication and Prior Claiming:</p> <p>1. The examiner conducts a search in the Indian Patent Database, starting from 1.1.1912, and all the available databases including patent/non patent literature. In addition to the above, PCT Minimum documentation is searched.</p> <p>2. The search is conducted to find out any publication which may anticipate the claimed subject matter.</p> <p>3. Another objective of the search is to ascertain whether an invention as claimed in any of the claims of the complete specification has been claimed in any claim of any other complete specification, filed in India, which has been published on or after the date of filing of the applicant's complete specification being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than</p>	Section 13

	<p>that date.</p> <ol style="list-style-type: none"> 4. The search is conducted with respect to the date of filing of complete specification. 5. The examiner ascertains the following: <ol style="list-style-type: none"> a) International Patent classification. b) Search strategy. c) Keyword(s) used. d) Databases consulted for both Patent and non-Patent literature. e) Prior art findings and analysis regarding the patentability. f) Limitation on search if any, such as non-clarity of claims or multiplicity of inventions or any other reason due to which a reasonable search cannot be conducted. 	
<p>09.03.02</p>	<p>Novelty</p> <ol style="list-style-type: none"> 1. An invention is considered as new(novel), if it is not anticipated by prior publication in patent and non-patent literature, i.e., an invention is novel if it has not been disclosed in the prior art, where the prior art means everything that has been published, presented or otherwise disclosed to the public before the date of filing/priority date of complete specification. 2. An invention is considered as novel, if it has not been anticipated by prior use or prior public knowledge in India . 3. For the purpose of determining novelty, an application for patent filed at the Indian Patent Office before the date of filing of complete specification of a later filed application, but published after the same, is considered for the purposes of prior claiming. 4. While ascertaining novelty, the Examiner takes into consideration, inter alia, the following documents: <ul style="list-style-type: none"> - which have been published before the date of filing of the application in any of the specifications filed in pursuance of application for patent in India on or after 1st January, 1912. - such Indian Patent Applications which have been filed before the date of filing of complete specification and published on or after the date of filing of the complete specification, but claims 	<p>Section 2(1)(j), 13, 29- 34</p>

	<p>the same subject matter.</p> <ol style="list-style-type: none"> 5. The examiner shall make such investigation for purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been anticipated by publication in India or elsewhere in any document other than those mentioned in section 13(1) before date of filing of the applicant's complete specification. 6. A prior art is considered as anticipating novelty if all the features of the invention under examination are present in the cited prior art document. 7. The prior art should disclose the invention either in explicit or implicit manner. Mosaicing of prior art documents is not allowed in determination of novelty. 8. A generic disclosure in the prior art may not necessarily take away the novelty of a specific disclosure. For instance, a metal spring may not take away the novelty of a copper spring. 9. A specific disclosure in the prior art takes away the novelty of a generic disclosure. For instance, a copper spring takes away the novelty of a metal spring. 10. In a case where a prior art is cited as an anticipation in the Examination Report, the onus of proving that the same is not to be an anticipation by reason of Section 29-34, lies on the applicant. 	
09.03.03	Inventive step	
09.03.03.01	<p>General principle</p> <p>Inventive step is a feature of an invention that involves technical advance compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art.</p> <p>While determining patentability of the invention, an Examiner first conducts investigation as to whether the novelty of the claimed invention is established and then proceeds to conduct examination on whether the claimed invention involves the inventive step.</p>	Section 2(1)(j), 2(1)(ja)

<p>09.03.03.02</p>	<p>Determination of Inventive Step</p> <ol style="list-style-type: none"> 1. For determination of inventive step, the prior art as a whole, revealed during the search process, is relied upon to assess if such prior art(s) disclose(s) the claimed invention. . 2. Invention as a whole shall be considered. In other words, it is not sufficient to draw the conclusion that a claimed invention is obvious merely because individual parts of the claims taken separately are known or might be found to be obvious. 3. If an invention lies merely in verifying the previous predictions, without substantially adding anything for technical advancement or economic significance in the art, the inventive step is lacking. 4. For the purpose of establishing obviousness of the invention to a person skilled in the art, mosaicing multiple documents of prior arts is permissible, if the cited prior art provides lead to the skilled person to combine the teachings thereunder, at the time of filing or priority date of patent application. 5. If the invention is predictable based on the available prior art, merely requiring workshop improvement by a person skilled in the art, the inventive step is lacking. <p>Hon’ble Supreme Court of India on inventive step: In Biswanath Prasad Radhey Shyam vs Hindustan Metal Industries Ltd it was held that “The expression <i>"does not involve any inventive step"</i> used in Section 26(1) (a) of the Act and its equivalent word <i>"obvious"</i>, have acquired special significance in the terminology of Patent Law. The 'obviousness' has to be strictly and objectively judged. For this determination several forms of the question have been suggested.</p> <p>The one suggested by Salmond L. J. in Rado v. John Tye & Son Ltd. is apposite. It is: "Whether the alleged discovery lies so much out of the Track of what was known before as not naturally to suggest itself to a person thinking on the subject, it must not be the obvious or natural suggestion of what was previously known." “Another test of whether a document is a publication which would negative existence of novelty or an "inventive step" is suggested, as under: “Had the document been placed in the hands of a</p>	
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competent craftsman (or engineer as distinguished from a mere artisan), endowed with the common general knowledge at the 'priority date', who was faced with the problem solved by the patentee but without knowledge of the patented invention, would he have said, "this gives me what I want?" (Encyclopedia Britannica; *ibid*). To put it in another form: "Was it for practical purposes obvious to a skilled worker, in the field concerned, in the state of knowledge existing at the date of the patent to be found in the literature then available to him, that he would or should make the invention the subject of the claim concerned?"

In the **F. Hoffman la Roche v Cipla** case the Hon'ble Delhi High Court had observed that the obviousness test is what is laid down in **Biswanath Prasad Radhey Shyam vs Hindustan Metal Industries Ltd (AIR 1982 SC 1444)** and that "Such observations made in the foreign judgments are not the guiding factors in the true sense of the term as to what qualities that person skilled in the art should possess. The reading of the said qualities would mean qualifying the said statement and the test laid down by the Supreme Court."

Hon'ble High Court further added "From the bare reading of the afore quoted observations of Supreme Court, it is manifest that the Hon'ble Supreme Court has laid down the test for the purposes of ascertaining as to what constitutes an inventive step which is to be seen from the standpoint of technological advancement as well as obviousness to a person who is skilled in the art. It is to be emphasized that what is required to be seen is that the invention should not be obvious to the person skilled in art. These are exactly the wordings of New Patents Act, 2005 u/s Section 2(ja) as seen above. Therefore, the same cannot be read to mean that there has to exist other qualities in the said person like unimaginary nature of the person or any other kind of person having distinct qualities..... Normal and grammatical meaning of the said person who is skilled in art would presuppose that the said person would have the knowledge and the skill in the said field of art and will not be unknown to a particular field of art and it is from that angle one has

to see that if the said document which is prior patent if placed in the hands of the said person skilled in art whether he will be able to work upon the same in the workshop and achieve the desired result leading to patent which is under challenge. If the answer comes in affirmative, then certainly the said invention under challenge is anticipated by the prior art or in other words, obvious to the person skilled in art as a mere workshop result and otherwise it is not. The said view propounded by Hon'ble Supreme Court in Biswanath Prasad (supra) holds the field till date and has been followed from time to time by this Court till recently without any variance..... Therefore, it is proper and legally warranted to apply the same very test for testing the patent; be it any kind of patent. It would be improper to import any further doctrinal approach by making the test modified or qualified what has been laid down by the Hon'ble Supreme Court **in of Biswanath Prasad (supra).**”

The “obviousness” must be strictly and objectively judged. While determining inventive step, it is important to look at the invention as a whole.

Accordingly, the following points need to be objectively judged to ascertain whether, looking at the invention as a whole, the invention does have inventive step or not:

- i. Identify the "person skilled in the art", i.e. competent craftsman or engineer as distinguished from a mere artisan;
- ii. Identify the relevant common general knowledge of that person at the priority date;
- iii. Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- iv. Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;
- v. Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of inventive ingenuity?

09.03.04	<p>Industrial Applicability</p> <ol style="list-style-type: none"> 1. In order for an invention to be patentable, an invention must be capable of industrial application. Industrial Application in relation to patentability means that the invention is capable of being made or used in an industry. 2. The Examiner shall assess if the claimed invention is capable of use in any industry or made using an industrial process. Typically, the specification explains the industrial applicability of the disclosed invention in a self-evident manner. If it is not, a mere suggestion that the matter would be industrially applicable is not sufficient. A specific utility should be indicated in the specification supported by the disclosure. For example, indicating that a compound may be useful in treating unspecified disorders, or that the compound has useful biological properties, would not be sufficient to define a specific utility for the compound. The specific usefulness has to be indicated. 	Section 2(1)(j), 2(1)(ac)
09.03.05	<p>Inventions not patentable</p> <p>Under the Patents Act, 1970, the following are not inventions and hence are not considered to be patentable. However, examples given are mere illustrations and may not be conclusive on the subject. Objective decisions may be taken on case to case basis.</p> <p>In addition to the illustrations in the instant Manual, the following subject-specific Guidelines have been issued and the same are hyperlinked as under:</p> <ol style="list-style-type: none"> 1) Revised Guidelines for Examination of Computer-related Inventions (CRIs) 2) Guidelines for Processing of Patent Applications relating to Traditional Knowledge and Biological Material 3) Guidelines for Examination of Biotechnology Applications for Patent 4) Guidelines for examination of patent applications in the field of Pharmaceuticals 	Section 3
09.03.05.01	<p><i>An invention which is frivolous or which claims anything obviously contrary to well established laws is not an invention.</i></p> <p>Some examples of a frivolous nature and contrary to natural laws are:</p>	Section 3(a)

	<ul style="list-style-type: none"> • A machine purporting to produce perpetual motion. • A machine alleged to be giving output without any input. • A machine allegedly giving 100% efficiency. 	
09.03.05.02	<p><i>An invention, the primary or intended use or commercial exploitation of which would be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment is not an invention.</i></p> <p>Some examples are:</p> <ol style="list-style-type: none"> a) Any device, apparatus or machine or method for committing theft/burglary. b) Any machine or method for counterfeiting of currency notes. c) Any device or method for gambling. d) An invention the use of which can cause serious prejudice to human beings, plants and animals. e) Inventions, the intended use or commercial exploitation of which is found to be injurious to public, animal or plant life or health, such as, a method of adulteration of food. f) An invention, the primary or intended use of which is likely to violate the well accepted and settled social, cultural, legal norms of morality, e.g. a method for cloning of humans. g) An invention, the primary or proposed use of which would disturb the public orders e.g. a device for house-breaking. h) However, if the primary or intended purpose or commercial exploitation of a claimed invention is not causing serious prejudice to human, animal or plant life or health or to the environment, such subject matter may be considered to be an invention and may be patentable, for instance, a pesticide. 	Section 3(b)
09.03.05.03	<p><i>The mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature is not an invention.</i></p> <p>A claim for discovery of scientific principle is not considered to be an invention, but a process of manufacture, based on the use of such principle, resulting in a substance or an article may be considered to be</p>	Section 3(c)

	<p>an invention.</p> <p>A scientific theory is a statement about the natural world. These theories themselves are not considered to be inventions, no matter how radical or revolutionary an insight they may provide, since they do not result in a product or process. However, any practical application of such theory in the process of manufacture of an article or substance, may well be patentable.</p> <p>The fact that a known material or article is found to have a hitherto unknown property is a discovery and not an invention. But if such discovery leads to the conclusion that the material can be used for making a particular article or in a particular process, then the article or process could be considered to be an invention.</p> <p>For example, the property of a particular known material to be able to withstand mechanical shock is a discovery and therefore not patentable, but a claim to a railway sleeper made of such material would not fall foul of this exclusion, and would be allowable if it passed the tests for novelty and inventive step.</p> <p>Similarly, finding of a new substance or micro-organism occurring freely in nature is a discovery and not an invention.</p>	
09.03.05.04	<p><i>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 or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant is not an invention.</i></p> <p><i>“Explanation:- For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy”.</i></p> <p>According to this provision, the following are not inventions and, hence, not patentable:</p>	Section 3(d)

- mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance;
- the mere discovery of any new property of a known substance;
- the mere discovery of new use for a known substance;
- the mere discovery of use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

Explanation to Section 3(d) further clarifies that salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance may be considered as may be considered to be the same substance and can be patentable only if they differ significantly in Properties with regard to efficacy.

An Examiner investigates on case to case basis as to what constitutes the difference in properties with regard to efficacy from the known substance.

The complete specification shall bring out clearly and categorically in the description, as to how the claimed subject matter differs significantly in properties with regard to efficacy from the known substance at the time of filing of the application or subsequently by way of an amendment of specification under section 59.

After analysing the legislative history of Section 3(d), the Hon'ble Supreme Court in the matter of **Novartis AG Vs. Union of India, W.P.No. 24760/06**, commented, "We have, therefore, no doubt that the amendment/addition made in section 3(d) is meant especially to deal with chemical substances, and more particularly pharmaceutical products. The amended portion of section 3(d) clearly sets up a second tier of qualifying standards for chemical substances/ pharmaceutical products in order to leave the door open for true and genuine inventions but, at the same time, to check any attempt at repetitive patenting or extension of the patent term on spurious grounds."

	<p>It was further held by the Apex Court –</p> <p>"in the case of medicines, efficacy means “therapeutic efficacy” and physico-chemical properties of substances do not meet the requirement of “therapeutic efficacy”.</p> <p>It was also held that patent applicants must prove the increase in therapeutic efficacy and just increased bioavailability alone may not necessarily lead to an enhancement of therapeutic efficacy, and in any given case, enhanced efficacy must be specifically claimed and established by research data.</p> <p>In this regard, in Para 187 of the Apex Court judgment, it is held that,</p> <p>".....the physico-chemical properties of beta crystalline form of Imatinib Mesylate, namely (i) more beneficial flow properties, (ii) better thermodynamic stability, and (iii) lower hygroscopicity, may be otherwise beneficial but these properties cannot even be taken into account for the purpose of the test of section 3(d) of the Act, since these properties have nothing to do with therapeutic efficacy.”</p>	
09.03.05.05	<p><i>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 substance is not an invention.</i></p> <p>An admixture resulting in synergistic properties is not considered as mere admixture. Hence, substances like soap, detergent, lubricants, may be considered as patentable.</p> <p>A mere aggregation of features must be distinguished from a combination invention. The existence of a combination invention requires that the relationship between the features or groups of features be one of functional reciprocity or that they show a combinative effect beyond the sum of their individual effects. The features should be functionally linked together which is the actual characteristic of a combination invention.</p> <p>In general, all the substances which are produced by mixing components or a process of producing such substances should satisfy the requirement of synergistic effect in order to be patentable. Synergistic effect should be clearly brought out in the description by</p>	Section 3(e)

	<p>way of comparison at the time of filing of the Application itself. The subsequent submissions regarding synergism can be accepted in a reply to the office action as a further support of synergy.</p>	
<p>09.03.05.06</p>	<p><i>The mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way is not an invention.</i></p> <p>In order to be patentable, an improvement on something known before or a combination of different matters already known, should be something more than a mere workshop improvement; and must independently satisfy the test of invention or an 'inventive step'. To be patentable, the improvement or the combination must produce a new result, or a new article or a better or cheaper article than before. A combination of old known integers may be so combined that by their working inter-relation, they produce a new process or an improved result. Mere collocation of more than one integers or things, not involving the exercise of any inventive faculty, does not qualify for the grant of a patent. (Biswanath Prasad Radhey Shyam Vs. Hindustan Metal Industries (1979) 2 SCC, 511).</p> <p>A new and useful application of an old principle may be good subject-matter. An improvement on something known may also afford subject-matter; so also a different combination of matters already known. A patentable combination is one in which the component elements are so combined as to produce a new result or arrive at an old result in a better or more expeditious or more economical manner. If the result produced by the combination is either a new article or a better or cheaper article than before, the combination may afford subject-matter of a patent. (Lallubhai Chakubhai Vs. Chimanlal and Co. (AIR 1936 Bom 99.)</p> <p>An invention claiming a mere juxtaposition of known devices in which each device functions independently is not considered patentable. Merely placing side-by-side old integers so that each performs its own function independently of the others is not a patentable combination. [As for example, a flour mill provided with sieving means].</p> <p>However, where the old integers when placed together have some</p>	<p>Section 3(f)</p>

	<p>working interrelation, producing a new or improved result, then there could be a patentable subject matter in the working interrelation brought about by the collection of the integers.</p> <p>When two or more features of an apparatus or device are known, and they are juxtaposed without any inter- dependence on their functioning, they should be held to have been already known. (Rampratap v. Bhabha Atomic Research Center, 1976 IPLR 28 P. 35), e.g., an umbrella with fan (388/Bom/73), bucket fitted with torch, clock and transistor in a single cabinet. These are not patentable, since they are nothing but mere arrangement and rearrangement of items without having any working interrelationship between them and are devices capable of functioning independently of each other.</p> <p>As for instance, in the case of an application for a patent in respect of an apparatus for producing metallic bellows, the hydraulic machine and the roll forming machine disclosed therein were functioning as separate machines independently of each other and as such had no novel feature. Hence, there is no invention when a claim is made on known types of hydraulic forming and roll forming machines functioning independently of each other.</p> <p>A new combination may be the subject matter of a patent although every part of the combination, per se, is old, for here the new article is not the parts themselves but the assembling and working of the parts, together. The merit of a new combination very much depends upon the result produced. Where a slight alteration turns that which was practically useless into what is useful and important, it is fit subject matter for a patent. (Lallubhai Chakkubhai v. Shamaldas Sankalchand Shah, AIR 1934 Bom 407).</p>	
09.03.05.07	<p><i>A method of agriculture or horticulture is not an invention.</i></p> <p>Examples of subject matters excluded from patentability under this provision are:</p> <ol style="list-style-type: none"> a) A method of producing a plant, even if it involved modification of the conditions under which natural phenomena would pursue their inevitable course (for instance a green-house). b) A method of producing improved soil from the soil with nematodes by treating the soil with a preparation containing 	Section 3(h)

	<p>specified phosphorathioates.</p> <p>c) A method of producing mushrooms.</p> <p>d) A method for cultivation of algae.</p> <p>e) A method for removal of weeds.</p>	
09.03.05.08	<p><i>Any process for the medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products is not an invention.</i></p> <p>This provision excludes the following from patentability:</p> <p>a) Medicinal methods: for example a process of administering medicines orally, or through injectables, or topically or through a dermal patch.</p> <p>b) Surgical methods: for example a stitch-free incision for cataract removal.</p> <p>c) Curative methods: for example a method of cleaning plaque from teeth.</p> <p>d) Prophylactic methods: for example a method of vaccination.</p> <p>e) Diagnostic methods: Diagnosis is the identification of the nature of a medical illness, usually by investigating its history and symptoms and by applying tests. Determination of the general physical state of an individual (e.g. a fitness test) is considered to be diagnostic.</p> <p>f) Therapeutic methods: The term ‘therapy’ includes prevention as well as treatment or cure of disease. Therefore, the process relating to therapy may be considered as a method of treatment and as such not patentable.</p> <p>g) Any method of treatment of animal to render them free of disease or to increase their economic value or that of their products. As for example, a method of treating sheep for increasing wool yield or a method of artificially inducing the body mass of poultry.</p> <p>h) Further examples of subject matter excluded under this provision are: any operation on the body, which requires the skill and knowledge of a surgeon and includes treatments such as cosmetic</p>	Section 3(i)

	<p>treatment, the termination of pregnancy, castration, sterilization, artificial insemination, embryo transplants, treatments for experimental and research purposes and the removal of organs, skin or bone marrow from a living donor, any therapy or diagnosis practiced on the human or animal body and further includes methods of abortion, induction of labour, control of estrus or menstrual regulation.</p> <p>i) Application of substances to the body for purely cosmetic purposes is not therapy.</p> <p>j) Patent may however be obtained for surgical, therapeutic or diagnostic instrument or apparatus.</p> <p>k) Also the manufacture of prostheses or artificial limbs and taking measurements thereof on the human body are patentable.</p>	
09.03.05.09	<p><i>Plants and animals in whole or any part thereof other than micro-organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals are not inventions.</i></p> <p>The subject matters excluded under this provision are:</p> <p>a) plants in whole or in part</p> <p>b) animals in whole or in part</p> <p>c) seeds</p> <p>d) varieties and species of plants and animals</p> <p>e) essentially biological process(es) for production or propagation of plants and animals.</p> <p>Microorganisms, other than the ones discovered from the nature, may be patentable. For instance, genetically modified microorganisms may be patentable subject to other requirements of Patentability.</p> <p>Plant varieties are provided protection in India under the provisions of the ‘Protection of Plant Varieties and Farmers’ Rights Act, 2002’.</p>	Section 3(j)
09.03.05.10	<p><i>A mathematical or business method or a computer programme per se or algorithms are not inventions and hence not patentable.</i></p> <p>Under this provision, mathematical methods, business methods, computer programmes per se and algorithms are not considered as</p>	Section 3(k)

patentable subject matter.

For the purpose of this clause, refer the [Revised Guidelines for Examination of Computer-related Inventions \(CRIs\), 2017.](#)

However, a brief of the Guidelines is given as under:

- 1) **Claims directed as “Mathematical Method”:** Mathematical methods are a particular example of the principle that purely abstract or intellectual methods are not patentable. Mathematical methods like method of calculation, formulation of equations, finding square roots, cube roots and all other similar acts of mental skill are therefore, not patentable. Similarly mere manipulations of abstract idea or solving purely mathematical problem/equations without specifying a practical application also attract the exclusion under this category.

However, mere presence of a mathematical formula in a claim, to clearly specify the scope of protection being sought in an invention, may not necessarily render it to be a “mathematical method” claim. Also, such exclusions may not apply to inventions that include mathematical formulae and resulting in systems for encoding, reducing noise in communications/ electrical/electronic systems or encrypting/ decrypting electronic communications.

- 2) **Claims directed as “Business Method”:** The term “Business Methods” involves whole gamut of activities in a commercial or industrial enterprise relating to transaction of goods or services. The claims drafted not directly as “business methods” but apparently with some unspecified means are held non-patentable. However, if the claimed subject matter specifies an apparatus and/or a technical process for carrying out the invention even partly, the claims shall be examined as a whole. When a claim is “business methods” in substance, it is not to be considered a patentable subject matter. However, mere presence of the words such as “enterprise”, “business”, “business rules”, “supply-chain”, “order”, “sales”, “transactions”, “commerce”, “payment” etc. in the claims may not lead to conclusion of an invention being just a “Business Method”, but if the subject matter is essentially about

	<p>carrying out business/trade/financial activity/transaction and/or a method of buying/selling goods through web (e.g. providing web service functionality), the same should be treated as business method and shall not be patentable.</p> <p>3) Claims directed as “Algorithm”: Algorithms in all forms including but not limited to, a set of rules or procedures or any sequence of steps or any method expressed by way of a finite list of defined instructions, whether for solving a problem or otherwise, and whether employing a logical, arithmetical or computational method, recursive or otherwise, are excluded from patentability.</p> <p>4) Claims directed as “Computer Programme per se”: Claims which are directed towards computer programs per se are excluded from patentability, like,</p> <p>a) Claims directed at computer programmes/set of instructions/ Routines and/or Sub-routines.</p> <p>b) Claims directed at “computer programme products”/ “Storage Medium having instructions”/“Database”/ “Computer Memory with instruction” stored in a computer readable medium.</p> <p>The legislative intent to attach suffix per se to computer programme is evident by the following view expressed by the Joint Parliamentary Committee while introducing Patents (Amendments) Act, 2002: “In the new proposed clause (k) the words "per se" have been inserted. This change has been proposed because sometimes the computer programme may include certain other things, ancillary thereto or developed thereon. The intention here is not to reject them for grant of patent if they are inventions. However, the computer programmes as such are not intended to be granted patent. This amendment has been proposed to clarify the purpose.”</p>	
09.03.05.11	<p><i>A literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions is not an invention.</i></p> <p>Writings, music, works of fine arts, paintings, sculptures, computer programmes, electronic databases, pamphlets, lectures, drawings, architecture, engravings, lithography, photographic works, applied art,</p>	Section 3(l)

	illustrations, maps, plans, sketches, topography, translations, adaptations, etc. are not patentable. Such works fall within the domain of the Copyright Act, 1957.	
09.03.05.12	<p><i>A mere scheme or rule or method of performing mental act or method of playing game is not an invention.</i></p> <p>A mere scheme or rule or method of performing mental act or method of playing game, are excluded from patentability, because they are considered as outcome of mere mental process. For example,</p> <ol style="list-style-type: none"> a) Method of playing chess. b) Method of teaching. c) Method of learning. 	Section 3(m)
09.03.05.13	<p><i>A presentation of information is not an invention.</i></p> <p>Any manner, means or method of expressing information whether visual, audible or tangible by words, codes, signals, symbols, diagrams or any other mode of representation is not patentable. For example, a speech instruction means in the form of printed text where horizontal underlining indicated stress and vertical separating lines divided the works into rhythmic groups is not patentable. For instance, railway time table, 100 years calendar etc.</p>	Section 3(n)
09.03.05.14	<p><i>Topography of integrated circuits is not an invention.</i></p> <p>Since protection of Layout Designs of Integrated Circuits is governed separately under the Semiconductor Integrated Circuit Lay-out Designs Act, 2000, three-dimensional configuration of the electronic circuits used in microchips and semiconductor chips is not patentable.</p>	Section 3(o)
09.03.05.15	<p><i>An invention which in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components is not an invention.</i></p> <p>Traditional Knowledge, being knowledge already existing, is not patentable. An example is the antiseptic properties of turmeric for wound healing. Another example is the pesticidal and insecticidal properties of neem.</p> <p>The Examiner conducts investigation by using Traditional Knowledge</p>	Section 3(p)

	Digital Library (TKDL) and other resources to decide as to whether the claimed subject matter falls within the purview of this provision.	
09.03.06	<p>Information and undertaking regarding foreign applications</p> <ul style="list-style-type: none"> • One of the requirement for the grant of a patent application and continuation of a patent is to provide information and undertaking regarding foreign applications in Form 3, in accordance with Section 8 of the Patents Act, 1970 and Rule 12 of the Patents (Amendment) Rule, 2003. • No fee has been prescribed in the Act or Rules if submission is in accordance to the timelines as prescribed in rule 12. • Similar provision, which is in accordance with TRIPS Agreement, is available in the laws of other countries like USA, China, EPO, Mexico, Phillipines etc. <p>Provisions in Section 8: Filing of Information regarding foreign applications:</p> <p>(1) The applicant shall file along with his application or within six months from the date of filing the application-</p> <p>(a) a statement setting out the name of the country where the application is being prosecuted, the serial number and date of filing of the application and such other particulars as may be prescribed; and</p> <p>(b) an undertaking that, up to the date of grant in India, he would keep the Controller informed in writing, from time to time, of details of the nature referred to in clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequently to the filing of the statement referred to in the aforesaid clause, within the period of 6 months.</p> <ul style="list-style-type: none"> • The period of six months in case of an application corresponding to an international application in which India is designated shall be reckoned from the actual date on which the corresponding application is filed in India. • For corresponding foreign applications filed after the filing of the statement and undertaking in form 3, the 	Section 8, Rule 12

period of six months shall be reckoned from the date of filing of the said corresponding foreign application.

- (2) The Controller may also require the applicant to furnish, as far as may be available to the applicant, details relating to the objections, if any, taken to any such application as is referred to in sub-section (1) on the ground that the invention is lacking in novelty or patentability, the amendments effected in the specifications, the claims allowed in respect thereof and such other particulars as he may require, within six months from the date of such communication from the Controller.

Recent arrangement with WIPO regarding access to Patent Information

A. WIPO DIGITAL ACCESS SERVICE

The WIPO Digital Access Service (DAS) is an electronic system allowing priority documents and similar documents to be securely exchanged between participating intellectual property (IP) offices. This initiative makes the procedure simpler for the applicant, in that, instead of the tedious task of requesting documents from one country and then supplying them to his/her own country office, the DAS system allows for electronic exchange of documents directly between the offices. The documents are uploaded on a secure platform, by a participating office upon request by the applicant, and can then be accessed by a different participating office as required. This step further strengthens the data accessibility of priority documents in the Indian Patent Office.

On 12th March 2018, a public notice has been issued to the stakeholders informing the availability of the WIPO Digital Access Service under WIPO-India Cooperation Agreement.

B. WIPO CENTRALIZED ACCESS TO SEARCH ANDEXAMINATION (WIPO CASE)

The WIPO CASE system enables patent offices to securely share search and examination documentation related to patent applications in order to facilitate work sharing programs. Offices

can share their dossier information either directly through the WIPO CASE system or through the IP5 One Portal Dossier linkage system.

The rationale of joining WIPO CASE is based on the fact that the same patent applications are filed in multiple offices, patent examiners can increase the efficiency and quality of their work by sharing their examination results.

The Indian Patent Office started its operations as an Accessing Office under WIPO CASE from June 1, 2015 and commenced its operations as a Providing Office in February 2018. Thus, it has now access to search and examination reports of the corresponding applications filed in major patent offices.

- **Legal jurisprudence:**

Indian Courts while deciding the petitions on non-compliance of section 8 requirement by the patentee/applicant have analyzed the matter. The gist of rulings by the Courts is as under:

- the provision for revocation of patent under section 64(1) (m) on the ground of non-compliance of Section 8 should not be exercised solely and automatically just because it exists in the Act, as there lies a discretion in the Court not to revoke the patent on the peculiar facts and circumstances of the present case. The said discretion exists by use of the word, “may” under Section 64 of the Act.
- It is also necessary to consider the question whether there was deliberate or willful suppression and whether the undisclosed information was “material” to the grant of the patent. The Court can decide the fate of revocation petition only after considering such issues at trial on the basis of evidence submitted.

[REFERENCES: (1) HOFFMAN-LA ROCHE LTD. Vs. CIPLA (CS (OS) No.89/2008 and C.C. 52/2008, 07.09.2012, (ii) Koninklijke Philips Electronics vs. Maj. (retd.) Sukesh Behl & anr (CS (OS) No. 2206 of 2012, 6-11-2013, (iii) Maj. (retd.) Sukesh behl & anr. Vs. Koninklijke philips electronics (FAO (OS) No.16 of 2014 (Division bench order)-

Appeal to the CS (OS) No. 2206 of 2012 (Single judge order) ,07.11.2014 and (iv) **FRESENIUS KABI ONCOLOGY LIMITED V. GLAXO GROUP LIMITED &ANR** (IPAB-ORA 17 of 2012/PT/KOL & M.P. Nos. 4 of 2013, 9 of 2013, 10 of 2013 & 49 of 2013; 27.07.2013)]

• **Guiding Principles to Patent Examiners and Controllers regarding requirement Under Section 8:**

With the successful implementation of the WIPO CASE and WIPO Digital Access Service (DAS), and the legal jurisprudence evolved with respect to Section 8; the requirement of section 8 mandates shall be fulfilled by the Patent Office as under:

1. The examiner/Controller shall check whether the applicant has filed a statement to the effect that the stipulated documents are available in WIPO CASE and DAS, from where the Office can access the documents. If such a statement has not been filed, then the applicant is required to provide all relevant documents and/or information, without fail.
2. The examiner/Controller shall check and ascertain whether the priority documents and similar documents pertaining to the application being processed in the Indian Patent Office are available in the WIPO Digital Access Service (DAS). If such documents are available, further information with regards to priority may not be sought for, from the applicant.
3. The examiner/Controller shall utilise all the facilities available in WIPO CASE regarding processing of corresponding patent applications in other countries, including access to Search and Examination reports, and other information available with Patent Offices that are part of WIPO CASE (currently Australia, Brunei Darussalam, Canada, Chile, European Patent Office (EPO), India, Israel, Japan, New Zealand, Republic of Korea, Singapore, International Bureau of WIPO, United Kingdom, United States of America).
4. Notwithstanding any of the steps mentioned above, the Controller may seek details as stipulated under Section 8(2) of the Patents Act, 1970 relating to the processing of the application in a country

	<p>outside India, including but not limited to, Search and/or examination reports, Claims of application allowed/ disallowed, Amendments made, if any, etc. n other Patent offices.</p> <p>5. Wherever, the Controller accepts fulfillment of section 8 and 138 requirements through the documents available in WIPO Case and WIPO DAS, all such documents therefrom shall be uploaded in a file wrapper by the office.</p>	
09.03.07	<p>Sufficiency of Disclosure</p> <p>Sufficiency of disclosure is yet another aspect, which is checked by the Examiner while examining a patent application. The Examiner will look for whether:</p> <ol style="list-style-type: none"> a) the specification is properly titled. b) the subject matter is fully and particularly described in the specification. c) the claims define the scope of the invention properly. d) the Specification describes the best method of performing the invention or not. e) the source and geographical origin of the same has been disclosed in the specification if the invention is related to biological material and/or the biological material is used in the invention,. f) approval obtained from National Biodiversity Authority, (NBA) wherever applicable. g) if the applicant mentions a biological material in the specification which may not be described and if such material is not available to the public, the application shall be completed by depositing the material to international depository authority under the Budapest treaty. h) Accession Number and date of deposition of the material in the depository institution along with name and address of the depository authority shall be given, if applicable. 	Section 10
09.03.08	<p>Unity of Invention</p> <p>1) The Claims of a Specification shall relate to a single inventive concept. In case, an application comprises a plurality of inventive concepts the examiner refers to the same in his report. The</p>	Section 10(5)

application may be divided in order to meet the objection of plurality of distinct inventions.

- 2) The determination whether a group of inventions is so linked as to form a single inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.
- 3) Unity of invention between process and apparatus or means requires that the apparatus or means have been specifically designed for carrying out the process.
- 4) Independent claims of different categories may relate to a single inventive concept and may be allowed in one application, when they are linked to form a single inventive concept and are supported by the description.

For example:

- a) Claims for a product and process specially adapted for manufacture of the product.
- b) Claims for a process and apparatus or means specifically designed for carrying out the process.
- c) A mould for casting an article, a method of making that mould, a process of casting the article by using the said mould will constitute a single invention.
- d) A locking system containing plug and socket wherein separate independent claims for a plug and socket may constitute a single inventive concept.
- e) A broadcasting system comprising transmitter and receiver.
- f) If an invention relates to a new type of spray bottle, claims may be directed to the spray bottle itself (a product) and a method of making the spray bottle (a process).
- g) In case of a genetically modified Gene Sequence/Amino Acid Sequence claims may be directed to a Gene sequence/Amino Acid sequence, a method of expressing the sequence, an antibody against that protein/sequence, a kit containing

	<p>such antibody/ sequence.</p> <p>h) In case of a drug or pharmaceutical product, claims may be directed to a drug or pharmaceutical product, a process of making the product, a composition containing the drug.</p>	
09.03.09	<p>Report of Examiner</p> <p>1) The examiner makes a report after carrying out detailed examination with respect to the following matters:</p> <p>a) whether the application and the specification and other documents relating thereto are in accordance with the requirements of the Act and rules made thereunder;</p> <p>b) whether there is any lawful ground of objection to the grant of patent under the Act;</p> <p>c) the result of investigations under Section 13;</p> <p>d) any other matter which may be prescribed.</p> <p>2) The examiner prepares the report after conducting a prior art search to ascertain the novelty, and examining as to whether the invention disclosed in the specification is inventive and industrially applicable.</p> <p>The Examiner also examines whether the invention belongs to one of the categories of non-patentable inventions coming under Section 3 and 4, and whether the application is in conformity with all the provisions of the Act.</p>	Section 3, 4, 12, 13
09.04	<p>Consideration of Report by Controller and issuance of First statement of objection/ First Examination Report (FER)</p> <p>1) The Controller considers the report of the examiner ordinarily within one month from the date of the receipt of such report and a gist of objections, if any, is sent to the applicant in the form of a report-First Examination Report (FER)-along with the application and specification, if required. If there is no objection to the grant of patent and no pre-grant opposition under Section 25 (1) is pending, the patent is granted at the earliest.</p> <p>2) The FER is sent to the applicant, even when the request for examination has been filed by a person interested. An intimation</p>	Section 14, 15, 18, 21, Rule 24B, 28, 28 A

regarding the issue of FER is given to such person interested.

- 3) First Examination Report (FER) may contain office objections relating to:
 - a) Lack of novelty, inventive step and industrial applicability.
 - b) Subject matter relating to a category, which falls within the purview of Sections 3 and 4.
 - c) Non-fulfillment of any other requirement under the Act & Rules.
- 4) The applicant is required to comply with all the requirements imposed upon him by the Act as communicated through FER. However, if applicant fails to respond to the FER within six months from the date of issuance of FER or within an extended period of 3 months, the application is deemed to have been abandoned under Section 21(1) of the Act. A communication to that effect is sent to the applicant for information.
- 5) The period of 6 months is extendable only once for a maximum period of three months, if requested in Form 4 within the prescribed period of 6 months, along with fees.
- 6) When the applicant re-files the documents within stipulated time, the application is examined in a fresh manner by the examiner, whereupon the examiner sends the report to the Controller with his observations. If it is found that the requirements of the Act and Rules have been met, the Controller grants a patent.
- 7) If the response/amendment(s) filed by the applicant do not satisfy the requirements laid down by the Act or if the applicant contests any of the objections communicated by the Controller to him, the Controller shall offer an opportunity of hearing and decide the case on merits.
- 8) Hearing may also be held through video-conferencing or audio-visual communication devices. Such hearing shall be deemed to have taken place at the appropriate office.

Explanation.—For the purposes of this rule, the expression communication device shall have the same meaning as assigned to it in clause (ha) of sub-section (1) of section 2 of the Information Technology Act, 2000 (21 of 2000).

	<p>9) In all cases of hearing, written submissions and the relevant documents, if any, shall be filed by the applicant within fifteen days from the date of hearing.</p> <p>10) After hearing the applicant, the Controller may specify or permit such amendment as he thinks fit and grant the patent.</p> <p>11) If the requirements of the Act and Rules are not complied with, the application is refused by the controller under Section 15 of the Act. A decision by the Controller for refusal of patent shall be a speaking order.</p> <p>12) No patent is refused without giving an opportunity of being heard under Section 14 of the Act.</p> <p>13) An order of Controller for refusal of patent under Section 15 is appealable before the Intellectual Property Appellate Board.</p>	
<p>09.05</p>	<p>Post-dating of Application for Patent</p> <p>1) The application for patent may be post-dated to a date not later than six months from the date of filing of application for patent on a request made by the applicant at any time before the grant of patent along with the prescribed fee[Section 17 (1)].</p> <p>a) Where such request is made before the examination of application, the same may be allowed and the examination shall be conducted with reference to the date so post-dated.</p> <p>b) Where such request is made after the issuance of First Examination Report, the same may be allowed subject to fresh examination with reference to the date so post-dated.</p> <p>2) If the application or specification (or drawings, if any) or any document is required to be amended under section 15 to comply with the requirements of the Act or the Rules, the Controller may direct that the application or specification or other documents related thereto be deemed to have been made on the date on which the requirements are complied with or the date on which it is re-filed after complying with the requirements [Section 17(2)].</p> <p>While invoking the above provision, the controller shall direct to republish the application and examine it afresh with reference to</p>	<p>Section 9(3), 9(4), 15, 17</p>

the date of filing of such specification and documents.

3) Regarding date of filing in case of Post-dating of application, the following should be kept in mind:

- i) Applicant can file an application with Provisional Specification and then file Complete Specification within the prescribed period of 12 months. **In this case, the date of filing of application with provisional specification will be the date of application.**
- ii) Applicant can file an application with Complete Specification and, thereafter, request to convert it into Provisional Specification within 12 months from the original filing date and file Complete Specification within 12 months from the original filing date. **In this case, the date of filing of application will still be the original filing date [Section 9(3)].**
- iii) After filing the complete specification, the applicant may cancel the provisional specification [i.e. the one filed directly under Section 9(1) or the one converted from a complete specification under Section 9(3)], and may request the Controller to post-date the application to the date of filing of the complete specification. **In this case, the date of application will be the date on which such complete specification is filed [Section 9(4)].**
- iv) **Section 17 (1):** Subject to the provisions of section 9, at any time after the filing of application and before the grant of patent, the Controller may, at the request of applicant made in the prescribed manner, direct that the application shall be post-dated to the maximum period of six months from the date of filing the application.

Therefore, the said period of six months as provided in section 17(1), shall be counted from the Date of application as stated above in (i) , (ii) or (iii) , as the case may be.

If postdating is allowed after publication of the application, the fact of postdating should be published in the Official Journal to specify a new date of filing.

<p>09.06</p>	<p>Pre-Grant Opposition</p> <ol style="list-style-type: none"> 1) Any person may file an opposition by way of representation (Pre-Grant Opposition) to the Controller in Form 7A against the grant of Patent, at the appropriate office, at any time after publication of patent application u/s 11A but before the grant of Patent on any of the grounds mentioned in Section 25(1) with a copy to the applicant. 2) The date of grant of Patent is the date on which the Controller orders the grant of patent in the file. For the purposes of Section 43(1) of the Patent Act, patent is 'granted' on the date on which the Controller passes a final order to that effect on the file. 3) If any pre-grant opposition is received after the grant of the patent, the Controller shall return the pre-grant opposition to the opponent and shall intimate such opponent about the fact of grant of the patent. If the opponent is a person interested, he may file a formal post grant opposition. 4) A patent is not granted before the expiry of six months from the date of publication under Section 11A. Therefore, a person may file a pre-grant opposition within the assured period of six months from the date of Publication, to make sure that the pre-grant opposition is filed before the grant of patent. 5) The representation shall include a statement and evidence, if any, in support of such representation and a request for hearing, if so desired. 6) The Controller shall consider the representation only after a Request for Examination for that Application has been filed. 7) Any pre-grant opposition, if available on record, is considered by the Controller along with the report of the Examiner. 8) On consideration of the representation, if the Controller is of the opinion that pre-grant opposition has merit and the application shall be refused or amended, a notice is given to the applicant. 9) The applicant shall, if he so desires, reply to the notice to the Controller by filing his statement and evidence, if any, in support 	<p>Section 11A, 25(1). Rule 55.</p>
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	<p>of his application within three months from the date of the notice, with a copy to the opponent.</p> <p>10) On consideration of the statement and evidence filed by the applicant, the representation including the statement and evidence filed by the opponent, submissions made by the parties, and after hearing the parties, if so requested, the Controller may either reject the representation or require the complete specification and other documents to be amended to his satisfaction before the patent is granted or refuse to grant a patent on the application, by passing a speaking order under Section 15, to simultaneously decide on the application and the representation, ordinarily within one month from the completion of above proceedings.</p> <p>In the matter of Neon Laboratories Pvt. Ltd. vs. Troikaa Pharma Limited and Ors. (Writ Petition No. 211 of 2010), the Bombay High Court held that "When the law consciously confers a right on a person that right must be protected in the way it has been granted." "Section 25(1) of Patents(Amendment) Act and Rule 55 of Patent Rules contemplate that, if the original claim/application for grant of patent is amended and the amendments are opposed, then, a personal hearing to the objector on the amended claims is required to be given if specifically requested"</p>	
09.07	Grant of Patent	
09.07.01	<p>Compliance of conditions under the Act</p> <p>A Patent is granted as expeditiously as possible when,</p> <ol style="list-style-type: none"> i. the application has not been refused by the Controller by virtue of any power vested in him by this Actor Rules, or ii. the application has not been found to be in contravention of any of the provisions of the Act or Rules; <p>The date of grant of patent is the date on which the patent is granted by the Controller. The date on which the patent is granted shall be entered in the register. The fact that the patent has been granted is published in the official journal of the Patent Office.</p> <p>As the Patent Office has moved to electronic processing, the fact of grant of patent by the Controller, Patent Number is reflected on the</p>	Section 43, Rule 74

	official website on real time basis. The patent certificate is also made available in the website.	
09.07.02	<p>Consequences of grant</p> <ol style="list-style-type: none"> 1) On the grant of patent, every patent is allotted a serial number by the electronic system. A Certificate of Patent is generated in the prescribed format and an entry in the e-register is made simultaneously. In the present electronic system, the date of recordal of Patent in the Register of Patents is the same as the date of grant of Patent by the Controller. 2) The complete specification as granted is made available to public through official website. 3) The application, specification and other related documents are open for public inspection on payment of prescribed fee. 4) On grant of patent, the patentee is required to pay the accumulated fee within 3 months from the date of recordal of patent in the Register of Patents, which is now the same as the date of grant of patent. The said period is extendable by six months, provided the request is made before the expiry of extendable period. 5) Post-grant opposition can be filed under section 25(2) by any person interested, within one year from the date of publication of grant. 6) Every patentee and licensee has to furnish a statement regarding working of the patented invention on commercial scale in India at regular intervals (not less than six months) in the prescribed format. 	Section 43, 45, 146 (2) Rule 74-A, 131(Form-27)
09.07.03	<p>Date of Patent</p> <ol style="list-style-type: none"> 1) The date of Patent is the date of filing of the Application. However, in case of a PCT National Phase application, the date of patent is the date of filing of the PCT international application. 2) Notwithstanding anything contained in this section, no suit or other proceeding shall be commenced or prosecuted in respect of an infringement committed before the date of publication of the application. <p>However, 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</p>	Section 45, 7(1-B)

	<p>application, the applicant shall have the like privileges and rights as if a patent for the invention had been granted on the date of publication of the application.</p>	
09.07.04	<p>Conditions subject to which Patent is granted</p> <ol style="list-style-type: none"> 1) any machine, apparatus or other article in respect of which the patent is granted or any article made by using a process in respect of which the patent is granted, may be imported or made by or on behalf of the government for the purpose merely of its own use; 2) any process in respect of which the patent is granted may be used by or on behalf of the government for the purpose merely of its own use; 3) any machine, apparatus or other article in respect of which the patent is granted or any article made by the use of the process in respect of which the patent is granted, may be made or used, and any process in respect of which the patent is granted may be used, by any person, for the purpose merely of experiment or research including the imparting of instructions to pupils; and 4) in the case of a patent in respect of any medicine or drug, the medicine or drug may be imported by the government for the purpose merely of its own use or for distribution in any dispensary, hospital or other medical institution maintained by or on behalf of the government or any other dispensary, hospital or medical institution which the Central Government may, having regard to the public service that such dispensary, hospital or medical institution renders, specify in this behalf by notification in the Official Gazette. 	Section 47
09.07.05	<p>Rights of Patentee</p> <ol style="list-style-type: none"> 1) In case of a patented product, the patentee shall have the exclusive right to prevent third parties from the act of making, using, offering for sale, selling or importing for those purposes that product in India. 2) In case of a patented process, the patentee shall have the exclusive right to prevent third parties from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in 	Section 48

	India.	
09.07.06	<p>Rights of co-owners</p> <ol style="list-style-type: none"> 1) Where a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent. 2) Subject to the provisions contained in this section and in Section 51, where two or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to the rights conferred by Section 48 for his own benefit without accounting to the other person or persons. 3) Subject to the provisions contained in this section and in section 51 and to any agreement for the time being in force, where two or more persons are registered as grantee or proprietor of a patent, then, a licence under the patent shall not be granted and a share in the patent shall not be assigned by one of such persons except with the consent of the other person or persons. 4) Where a patented article is sold by one of two or more persons registered as grantee or proprietor of a patent, the purchaser and any person claiming through him shall be entitled to deal with the article in the same manner as if the article had been sold by a sole patentee. 5) Subject to the provisions contained in this section, the rules of law applicable to ownership and devolution of movable property generally, shall apply in relation to patents, and nothing contained in sub-section (1) or sub-section (2) of section 50 shall affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or their rights or obligations as such. 6) Nothing under section 50 shall affect the rights of the assignees of partial interest in a patent created before commencement of this Act. 	Section 50
09.07.07	<p>Term of Patent</p> <p>The term of Patent is 20 years from the date of filing of application in</p>	Section 53

	<p>respect of all the patents, including those for which the term had not expired on 20th May, 2003, when the Patent (Amendment) Act, 2002 came into force, provided that the renewal fee is paid every year before the due date or within the extended period (maximum six months).</p>	
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Chapter - 10: Post Grant Opposition

10.01	<p>Post-grant Opposition</p> <ol style="list-style-type: none"> 1) Any person interested can give a notice of opposition against the grant of Patent in Form 7 at the appropriate Office, any time after the grant but within one year from the date of publication of grant of patent. 2) The opponent shall, along with the notice of opposition, send a written statement setting out the nature of opponent's interest, the facts upon which he bases his case and relief which he seeks and evidence, if any. 3) The post-grant opposition can be filed on any of the grounds as mentioned in Section 25(2), but on no other grounds. 4) After receipt of the notice of opposition, the Controller shall notify the patentee about the fact of receipt of such notice, without any delay. 5) A copy of the statement and evidence, if any, shall also be delivered to the patentee by the opponent. 6) If the patentee desires to contest the opposition, he shall file a reply statement setting out fully the grounds upon which the opposition is contested and evidence, if any, in support of his case within a period of two months from the date of receipt of the copy of opponent's written statement and evidence, if any, and also deliver a copy to the opponent. 7) If the patentee does not desire to contest or does not file his reply and evidence within two months, the patent shall be deemed to have been abandoned and the Controller shall issue the order of revocation of Patent and the fact of revocation shall be entered in the register of patents. 8) After receipt of reply from the patentee, the opponent may file his evidence in reply within one month from the date of delivery to him of a copy of the patentee's reply statement and evidence. The evidence in reply by the opponent shall be strictly confined to the matters in the patentee's evidence. The opponent shall also deliver a 	<p>Section 2(1)(t), 25(2). Rule 55A, 60, 126, 127. Form 7.</p>
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	<p>copy of his reply evidence to the patentee.</p> <p>9) No further evidence shall be delivered by either party, except with the leave or direction of Controller.</p> <p>10) Further evidence can be filed by either party if the same is prayed before the hearing is fixed by the Controller under rule 62, whereupon the Controller shall dispose of the petition by either allowing or rejecting it.</p> <p>11) Where a specification or other document in a language other than English is referred to in the notice of opposition or any statement or evidence, an attested translation thereof in English should be furnished along with such notice, statement or evidence, as the case may be.</p> <p>12) Evidence shall be filed on affidavits as required under Rule 126.</p> <p>13) Exhibits shall be filed as required under Rule 127.</p>	
<p>10.02</p>	<p>Constitution of Opposition Board</p> <p>1) After receipt of a notice of opposition, an Opposition Board is constituted by the Controller, by order, to examine such notice including all documents filed under rule 57-60 in connection with the opposition by the opponent as well as patentee.</p> <p>2) The Opposition Board consists of three members with one of them as Chairman.</p> <p>3) The Examiner may be a member of the Board. However, the Examiner who has dealt with the application for patent during the prosecution proceedings for grant of patent thereon shall not be included as a member of the Board.</p> <p>4. The Board shall submit the report with reasons on each ground taken in the notice of opposition, after examining the notice along with all statements, documents and evidence submitted by the parties as a joint recommendation within three months from the date on which all such documents were forwarded to them.</p> <p>5. A copy of the recommendation of opposition board should be provided to the parties to the proceedings by the Controller along with the hearing notice.</p>	<p>Section 25(3) Rule 56, 57, 58, 59, 60</p>

10.03	<p>Hearing</p> <ol style="list-style-type: none"> 1) On completion of the presentation of evidence, if any, and after receiving the recommendation of Opposition Board, the Controller shall fix a date and time for the hearing of opposition and inform the parties at least ten days in advance. 2) On receipt of the notice of hearing, if either party desires to be heard, he shall inform the Controller by a notice along with the prescribed fee. 3) The Controller may require the members of Opposition Board to be present in the hearing 4) The Controller may refuse to hear any party, which has not given such notice and not paid the prescribed fee. 5) If either party intends to rely on any Publication at the hearing not already mentioned in the notice of opposition, statement or evidence, he shall give to the other party and to the Controller a notice of his intention to do so, together with details of such publication. Such notice shall be given at least five days before the date of hearing. 6) After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing and after taking into consideration the recommendation of Opposition Board, the Controller shall decide the opposition, i.e. revoke the patent or order amendments in the Patent or refuse the opposition by issuing a speaking order accordingly. 7) If amendment of specification or any other document is ordered by the Controller, the patentee shall submit such amended documents to the office within a reasonable time, as directed by the Controller. 	Rule 62
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Chapter 11: Post-grant procedures

11.01	<p>i. Maintenance of Patent – Renewal:</p> <p>To keep a patent in force, the renewal fees shall be payable at the expiration of the second year from the date of the patent or of any succeeding year and the same shall be remitted to the Patent Office before the expiration of the second or the succeeding year.</p> <p>ii. Further, renewal of a patent can be done beyond the due date in the extended period of six months from the due date by filing Form-4 along with the prescribed fee.</p> <p>iii. Where a patent is granted later than two years from the date of filing of the application, the fees which have become due in the meantime shall be paid within a period of three months from the date of recording of the patent in the Register of Patents. If a patent is granted before the expiry of two years from the date of filing of application, the first renewal fee becomes due in respect of the third year. However, the same shall be paid before the expiry of second year. First Renewal fee for a patent becomes due in respect of the third year counted from the date of filing of application for patent. However, the renewal fee for third year has to be paid before the expiry of second year. For clarification, the renewal fee may be paid before the expiration of the fourth year from the date of Patent for the fifth year and so on.</p> <p>iv. While paying the renewal fee, the patentee shall quote the correct patent number and the year in respect of which the renewal fee is being paid. Any mistake in the above said particulars may lead to a lapse of patent.</p> <p>v. A renewal fee is not required to be paid in respect of a patent of addition. However, if any such patent becomes an independent patent the same fees shall thereafter be payable.</p> <p>vi. Annual renewal fee can be paid for more than one year in advance.</p>	<p>Section 53, 55(2), 142 (4). Rule 80. Form-4.</p>
11.02	<p>Restoration of Lapsed Patents</p> <p>1) When a Patent has ceased to have effect due to non-payment of renewal fees within the prescribed time, the Patent may be restored by filing an application for restoration in Form-15</p>	<p>Section 60. Rule 84, 94. Form-15.</p>

	<p>within eighteen months from the date on which the patent ceased to have effect. Such application for restoration can be made by the patentee/assignee, or his legal representative and in case of joint applicants, then, with the leave of the Controller, any one or more of them without joining the others.</p> <p>2) The applicant has to state, the circumstances which led to the failure of payment of renewal fees. The application must include a statement fully setting out such circumstances that led to the failure to pay the renewal fee. This statement is to be supported by evidence along with copies of relevant documents.</p> <p>3) The evidence must support the patentee's claim that the failure to pay was unintentional and there has been no undue delay in applying for the restoration.</p> <p>4) The Controller may call for further evidence to justify that the failure to pay was unintentional and that there has been no undue delay for making the application.</p> <p>5) If a patentee has failed to register a change of name or new address of service before cessation, he shall first apply under Rule 94 for such alteration(s) in the register. If he changed his name after cessation he must prove his identity. In both cases he must draw and sign the application in his new name but in the latter case must add 'formerly known as' to his identification.</p>	
11.02.01	<p>Procedure for disposal of application for Restoration</p> <p>1) When the Controller is <i>prima facie</i> satisfied after verification of evidence submitted in support of Form 15 that the failure to pay the renewal fee was unintentional and there had been no undue delay, the application for restoration will be published in the official journal under rule 84(3).</p> <p>2) If the Controller is satisfied that <i>prima facie</i> case for restoration has not been made, the Controller may issue a notice to the applicant to that effect. Within one month from the date of notice, if the applicant makes a request to be heard on the matter, a hearing shall be given and the restoration application may be disposed. If no request for hearing is received within one month from the date of</p>	Section 61, 62. Rule 84, 85, 86. Form-14, 15.

	<p>notice by the Controller, the application for restoration will be refused. In case of rejection of the application for restoration, a speaking order shall be issued.</p> <p>3) Any person interested may give notice of opposition in Form 14, in the prescribed manner, to the application for restoration within two months of the date of publication in the official journal on the grounds that the failure to pay the renewal fee was not unintentional or that there has been undue delay in the making of the application.</p> <p>4) The notice of opposition shall include a statement setting out the nature of the opponent's interest, the grounds of opposition and the facts relied upon. The notice of opposition shall be sent to the applicant by the Controller.</p> <p>5) The procedure specified in rules 57 to 63 for post grant opposition relating to filing of written statement, reply statement, reply evidence, hearing and cost shall apply in this case, except the procedural part related to Opposition Board provided under rule 62 (1) and 62 (5).</p> <p>6) When no opposition is received within a period of two months from the date of publication of application for restoration, or opposition, if any, is disposed of in favour of the applicant for restoration, the Controller shall issue an order allowing the application for restoration. The unpaid renewal fee and the additional fee, as mentioned in the first schedule, shall be paid within one month from the date of order of the Controller.</p> <p>7) The fact that a patent has been restored shall be published in the official journal.</p> <p>8) To protect the persons who have begun to use the applicant's invention between the date when the patent ceased to have effect and the date of publication of the application for restoration, every order for restoration shall include the provisions and other conditions, as the Controller may impose for protection and compensation of above-mentioned persons. No suit or other proceeding shall be commenced or prosecuted in respect of an infringement of a patent committed between the date on which the</p>	
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	Patent ceased to have effect and the date of the Publication of the Application for restoration of the patent.	
11.03	<p>Registration of Assignments/Transfer of Right</p> <ol style="list-style-type: none"> 1) An assignment of a patent or of a share in a patent, a mortgage, licence or the creation of any other interest in a patent shall be valid only if the same were in writing and the agreement between the parties concerned is reduced to the form of a document embodying all the terms and conditions governing their rights and obligations and has been duly executed. 2) Any person who becomes entitled by assignment, transmission or operation of law to a patent or to a share in patent or becomes entitled as a mortgagee, licensee or otherwise to any other interest in a patent, may apply in writing in Form-16 to the Controller for the registration of his title or notice of his interest in the register, as the case may be. Such an application can also be made by the assignor, mortgagor, licensor or other party as the case may be. Provided that in the case of a license granted under a patent, the Controller shall, if so requested by the patentee or licensee, take steps for securing that the terms of the license are not disclosed to any person except under the order of a court. 3) Where such application is made for the registration of title or notice of interest of any person, the Controller, upon proof of title or interest to his satisfaction, shall enter in the register such particulars as are appropriate. 4) If there is any dispute between the parties, the Controller may refuse to take any action to make an entry in the register until the rights of the parties have been determined by a competent court. 5) Except for the purpose of making an application for registration of right, title or interest in the register of patents, or for an application for rectification of the register of patents in the Appellate Board, a document in respect of which no entry has been made in the register, shall not be admitted by the Controller or by any court as evidence of the title of any person to a patent or to a share or interest therein unless the Controller or the court, for 	Section 68, 69. Rule 90, 91, 92. Form-16.

	<p>reasons to be recorded in writing, otherwise directs.</p> <p>6) If requested by the patentee / licensee, the terms of the license shall be kept confidential and not disclosed to any person, except under the order of Court.</p> <p>7) Every assignment and every other document giving effect to or being evidence of the transfer of a patent or affecting the proprietorship thereof or creating an interest therein as claimed in such application, shall, unless the Controller otherwise directs, be presented to him together with the application which shall be accompanied by a copy (scanned) of the assignment or other document certified to be true copies by the applicant or his agent and the Controller may call for such other proof of title or written consent as he may require.</p>	
11.04	<p>Surrender Of Patents</p> <p>1) The patentee may at any time offer to surrender his patent through an application on plain paper. On receipt of such an offer, the Controller shall publish the offer in the Official Journal and also notifies every person (other than the patentee) whose name appears in the register as having an interest in the patent.</p> <p>2) An opposition against the offer to surrender the patent may be filed by any person interested in Form 14 within 3 months from the date of publication of such offer in the Official Journal. The Controller shall inform the Patentee on receipt of such notice.</p> <p>3) The procedure relating to filing of written statement, reply statement, leaving evidence, hearing and cost of the opposition is similar to that of post-grant opposition as per Rules 57-63, except the procedural part related to Opposition Board included under rule 62 (1) and 62 (5).</p> <p>4) In case, the Controller accepts the patentee's offer to surrender the patent, he may revoke it and publish such revocation in the official journal.</p>	Section 63. Rules 57-63 and 87. Form-14.
11.05	<p>Working of Patents</p> <p>1) Patents are granted to encourage inventions and to secure that the inventions are worked in India on a commercial scale and to the</p>	Section 83, 146. Rule 131(2)

	<p>fullest extent that is reasonably practicable without undue delay.</p> <p>2) The Controller has the power to call for the information such as periodical statements as to the extent to which the patented invention has been commercially worked in India, as may be specified in the notice issued to that effect at any time during the continuance of the Patent.</p> <p>3) A patentee or a licensee shall furnish such information within two months from the date of such notice or within such further time as the Controller may allow.</p> <p>4) The patentee and every licensee shall furnish a statement as to the extent to which the patented invention has been worked on a commercial scale in India, in Form 27, in respect of every calendar year, within three months of the end of each year.</p>	Form-27
11.06	<p>Amendments after the grant of patents</p> <p>1) After the grant of patent, the patentee may apply for an amendment of the application for patent, complete specification or any document relating thereto subject to such conditions, if any, and as the Controller thinks fit. Such a request may be filed in Form-13 with the prescribed fee.</p> <p>2) An amendment of a complete specification may be, or include, an amendment of the priority date of a claim, as per Section 57 (5).</p> <p>3) The request shall state the nature of the proposed amendment, highlighted in an annexed copy along with the reasons. The amendments are allowable only by way of disclaimer, correction or explanation. Such amendments shall be for the purpose of incorporation of actual fact only. Further, 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 the amended claim(s) do not fall wholly within the scope of claim(s) of the specification before the amendment.</p> <p>4) If the nature of proposed amendment is substantive, the application for amendment shall be published. For instance, any application for amending the complete specification or the claims or the application</p>	Section 57, 59. Rules 57-63 and 81-83. Form-13, 14.

	<p>for patent shall be published.</p> <ol style="list-style-type: none"> 5) The amended pages have to be filed by the applicant. 6) Any person interested may give a notice of opposition in Form-14 within three months from the date of publication of the application for amendment. Where such a notice of opposition is filed, the Controller shall notify the applicant for amendment. 7) After giving an opportunity to the applicant and opponent, if any, the Controller shall dispose of the case. The procedure specified in rules 57 to 63 for post grant opposition for filing of written statement, reply statement, reply evidence, hearing and costs shall apply in this case, except the procedural part related to Opposition Board included under rule 62 (1) and 62 (5). 8) Amendments allowed after the grant of patent shall be published. 9) A leave to amend the complete specification obtained by fraud is a ground for revocation of patent under Section 64(1)(o). 10) If any suit for infringement is pending before a Court or any proceeding for revocation of the Patent is pending before the High Court, the Controller shall not pass any order allowing or refusing the application for amendment. 	
11.07	<p>Amendment of patent granted to deceased applicant/ceased body corporate.</p> <ol style="list-style-type: none"> 1) Where, at any time after a patent has been granted in pursuance of an application under this Act, the Controller is satisfied that the person to whom the patent was granted had died before the patent was granted, the Controller may amend the patent by substituting for the name of that person the name of the person to whom the patent ought to have been granted, and the patent shall have effect, and shall be deemed always to have had effect, accordingly. 2) Similar procedure is to be followed in case of a body corporate ceases to exist. <p>An application for above said amendment of a patent is to be made in Form 10 along with substantiating evidence. Upon such application, the Controller may amend the patent with the name of such claimant by substituting the name of the deceased applicant/the ceased body corporate.</p>	Section 44 Rule 75. Form-10,.

11.08	<p>Register of Patents</p> <ol style="list-style-type: none"> 1) Patent Office maintains the Register of Patents in electronic form, which is under the control and management of the Controller of Patents and the same is also available on the office website as e-Register of Patents. 2) E-register of patents contains details about the grantee/patentee, notifications in respect of assignments, transmissions of patents, licenses under patents, and amendments, extension and revocations of patents. 3) A copy of, or extracts from, the register of patents, certified to be a true copy under the hand of the Controller or any officer duly authorized by the Controller is admissible in evidence in all legal proceedings. 4) Upon the grant of a patent, the Controller shall enter in the register of patents, the name, address and nationality of the grantee as the patentee thereof, the title of the invention (including the categories to which the invention relates), the date of the patent and the date of grant thereof together with the address for service of the patentee. The fact of payment of renewal fee shall also be entered in the E-register. The Register of patents also contains particulars regarding proceedings under the Act, before the Controller or in the Courts in respect of every patent. 5) An application for alteration of name, nationality, address or address for service as entered in the register of patents may be made to the Controller in respect of any Patent. The Controller may require such proof of the alteration as he may think fit before acting on the request. If the Controller allows such a request, entries in the e-Register are altered accordingly. 6) If a patentee makes a request in writing along with the prescribed fees for entering an additional address for service in India and the Controller is satisfied that the request shall be allowed, the additional address shall be entered in the e-Register. 7) Entries in the register for each patent are available to the public on the official website through e-Register of Patents. 	<p>Section 67.</p> <p>Rule 88, 93, 94.</p>
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11.09	<p>Rectification of Register of Patents</p> <ol style="list-style-type: none"> 1) An application for rectification of register of patents may be made to the Intellectual Property Appellate Board (IPAB) by any person aggrieved: <ol style="list-style-type: none"> a) by the absence or omission from the register of any entry; or b) by any entry made in the register without sufficient cause; or c) by any entry wrongly remaining on the register; or d) by any error or defect in any entry in the register. 2) Notice of such application made before the IPAB is given to the Controller, who is entitled to be heard on the application. Besides, if so ordered, the Controller shall appear before the IPAB. 3) If IPAB passes any order rectifying the register, a notice of rectification is served upon the Controller, who, upon such receipt, shall rectify the register. 	Section 71
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Chapter-12: Appeals

12.01	Appellate Board and Appeals	
12.01.01	<p>Intellectual Property Appellate Board (IPAB)</p> <p>Intellectual Property Appellate Board (IPAB), established under Section 83 of the Trade Marks Act, 1999, is the Appellate Board for the purposes of the Patents Act, 1970. An appeal lies to the Appellate Board from any decision, order or directions of the Controller or of the Central Government passed under the provisions mentioned in Section 117A (2) only, and not against any other decision or direction.</p>	Section 116, 117A(2)
12.01.02	<p>Appeals</p> <p>a) No appeal to IPAB shall lie from any order or direction of the Central Government, or of the Controller, except in case of orders/decisions, issued by the Controller or Central Government under Sections 15, 16,17, 18, 19, 20, 25(4), 28, 51, 54, 57, 60, 61, 63, 66, 69(3), 78,84(1) to (5), 85, 88, 91, 92 and 94 of the Act.</p> <p>b) No appeal lies from an Order of the Controller granting extension of time when such extension is provided in any provision of the Act or of the rules made thereunder.</p>	Section 117A(2), 81.
12.02	<p>Appeal procedure</p> <p>a. Every appeal from the decision of the Controller under relevant sections as mentioned in Section 117A (2) shall be accompanied by the certified copy of the decision, order or direction appealed against. Such application shall be filed in the form and fee prescribed under the IPAB Rules , 2011.</p> <p>b. Every appeal should be made within three months from the date of the decision, order or direction of the Controller or of the Central Government, as the case may be, or within such further time as the IPAB may allow in accordance with the Rules.</p> <p>c. The Controller shall have the right to appear and be heard-</p> <p style="padding-left: 20px;">i. in any legal proceedings before the IPAB in which the relief sought includes alteration or rectification of the register or in which any question relating to the practice of the patent office is raised;</p>	Section 117E, 117F.

	<ul style="list-style-type: none">ii. in any appeal to the IPAB from an order of the Controller on an application for patent—<ul style="list-style-type: none">A. which is not opposed and the application is either refused by the Controller or accepted for grant by him subject to any amendments, modifications, conditions or limitations, orB. which has been opposed and the Controller considers that his appearance is necessary in the public interest.d. The Controller shall appear in any case, if so directed by the IPAB.e. The Controller may, in lieu of appearing, unless the IPAB otherwise directs, submit a statement in writing signed by him, giving such particulars as he thinks proper, of the proceedings before him relating to the matter in issue or of the grounds of any decision given by him or of the practice of the patent office in like cases, or of other matters relevant to the issues and, within his knowledge as the Controller, may deem it necessary, and such statement shall be evidence in the proceedings.	
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Chapter-13: Revocation of Patent

13.01	Revocation of Patent	
13.01.01	<p>Revocation before the High Court or Appellate Board</p> <p>a. Any person interested or the Central Government may make a petition on any of the grounds, specified for revocation of Patent under Section 64 of the Patents Act, before the IPAB. A Patent may also be revoked by the High Court on a counter-claim in a suit for infringement of patent.</p> <p>b. Grounds for revocation of the patent before the IPAB as well as the High Court are elaborated in Section 64.</p> <p>c. Without prejudice to the provisions contained in (a) above, a patent may be revoked by the High Court on the petition of the Central Government, if the High Court is satisfied that the patentee has without reasonable cause failed to comply with the request of the Central Government to make, use or exercise the patented invention for the purposes of government within the meaning of Section 99 upon reasonable terms.</p>	Section 64, 99
13.01.02	<p>Revocation by the Controller on direction of the Central Government</p> <p>a. Where at any time after grant of a patent, the Central Government is satisfied that a patent is for an invention relating to atomic energy for which no patent can be granted under sub-section (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962), it may direct the Controller to revoke the patent, and thereupon the Controller, after giving notice, to the patentee and every other person whose name has been entered in the register of patents as having an interest in the patent, and after giving them an opportunity of being heard, may revoke the patent.</p> <p>b. In such proceedings, the Controller may allow the patentee to amend the complete specification in such manner as he considers necessary instead of revoking the patent.</p>	Section 65
13.01.03	<p>Revocation by the Central Government in public interest</p> <p>Where the Central Government is of opinion that a patent or the mode in which it is exercised is mischievous to the State or generally prejudicial to</p>	Section 66

	the public, it may, after giving the patentee an opportunity to be heard, make a declaration to that effect in the Official Gazette and thereupon the patent shall be deemed to be revoked.	
13.01.04	<p>Revocation by Controller for non-working</p> <p>a. Where, in respect of a patent, a compulsory license has been granted, the Central Government or any person interested may, after the expiration of two years from the date of the order granting the first compulsory license, apply to the Controller for an order revoking the patent on the ground:</p> <ul style="list-style-type: none"> i. that the patented invention has not been worked in the territory of India, or ii. that reasonable requirements of the public with respect to the patented invention have not been satisfied, or iii. that the patented invention is not available to the public at a reasonably affordable price. <p>b. Such an application shall contain such particulars, as may be prescribed, the facts upon which the application is based and, in the case of an application other than the one made by the Central Government, it shall also set out the nature of the applicant's interest.</p> <p>c. Such applications shall ordinarily be decided within one year from the date of presentation to the Controller.</p>	Section 85

Chapter 14: Compulsory Licensing

14.01	<p>Working of patents - General principles</p> <ol style="list-style-type: none"> a. Patents are granted to encourage inventions and to secure that the inventions are worked in India on a commercial scale and to the fullest extent that is reasonably practicable without undue delay. b. Patents are not granted merely to enable patentees to enjoy a monopoly for the importation of the patented article. c. The protection and enforcement of Patent rights contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations. d. Patents granted do not impede protection of public health and nutrition and should act as instrument to promote public interest especially in sectors of vital importance for socio-economic and technological development of India. e. Patents granted do not in any way prohibit Central Government in taking measures to protect public health. f. The Patent right shall not be abused by the patentee or person deriving title or interest in patent from the patentee, and the patentee or a person deriving title or interest in patent from the patentee does not resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology. g. Patents are granted to make the benefit of the patented invention available at reasonably affordable prices to the public. 	Section 83
14.02	<p>Compulsory License</p> <p>An application for grant of a compulsory license may be made under the following provisions:</p> <ol style="list-style-type: none"> a. Section 84. b. Section 92. c. Section 92A. 	
14.02.01	<p>Compulsory License under Section 84</p> <ol style="list-style-type: none"> a. Any person interested may make an application to the Controller for grant of Compulsory License for a patent after the expiry of three 	Section 84 Form-17

	<p>years from the date of grant of the patent on the following grounds:</p> <ol style="list-style-type: none"> i. that the reasonable requirements of public with respect to the patented invention have not been satisfied, or ii. that the patented invention is not available to the public at reasonably affordable price, or iii. that the patented invention is not worked in the territory of India. <p>Such an application may also be made by the licensee.</p> <p>b. No person shall be stopped from alleging the grounds i-iii above by reason of any admission made by him in the licence or otherwise or by reason of his having accepted such a licence.</p> <p>c. In considering such an application, the Controller shall take into account-</p> <ol style="list-style-type: none"> i. the nature of the invention, the time which has elapsed since the sealing of the patent and the measures already taken by the patentee or any licensee to make full use of the invention; ii. the ability of the applicant to work the invention to the public advantage; iii. the capacity of the applicant to undertake the risk in providing capital and working the invention, if the application were granted; iv. as to whether the applicant has made efforts to obtain a license from the patentee on reasonable terms and conditions and such efforts have not been successful within a reasonable period as the Controller may deem fit. Reasonable period shall be construed as a period not ordinarily exceeding a period of six months. However, these circumstances shall not be applicable in case of national emergency or other circumstances of extreme urgency or in case of public non-commercial use or on establishment of a ground of anti-competitive practices adopted by the patentee, but shall not be required to take into account matters subsequent to the making of the application. 	
14.02.01.01	<p>Reasonable requirements of the public</p> <p>The reasonable requirements of the public shall be deemed not to have been satisfied—</p>	Section 84(7)

	<p>I. if, by reason of the refusal of the patentee to grant a licence or licences on reasonable terms,—</p> <ul style="list-style-type: none"> i. an existing trade or industry or the development thereof or the establishment of any new trade or industry in India or the trade or industry in India or the trade or industry of any person or class of persons trading or manufacturing in India is prejudiced; or ii. the demand for the patented article has not been met to an adequate extent or on reasonable terms; or iii. a market for export of the patented article manufactured in India is not being supplied or developed; or iv. the establishment or development of commercial activities in India is prejudiced; or <p>II. if, by reason of conditions imposed by the patentee upon the grant of licences under the patent or upon the purchase, hire or use of the patented article or process, the manufacture, use or sale of materials not protected by the patent, or the establishment or development of any trade or industry in India, is prejudiced; or</p> <p>III. if the patentee imposes a condition upon the grant of licences under the patent to provide exclusive grant back, prevention to challenges to the validity of patent or coercive package licensing; or</p> <p>IV. if the patented invention is not being worked in the territory of India on a commercial scale to an adequate extent or is not being so worked to the fullest extent that is reasonably practicable; or</p> <p>V. if the working of the patented invention in the territory of India on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by-</p> <ul style="list-style-type: none"> i. the patentee or persons claiming under him; or ii. persons directly or indirectly purchasing from him; or iii. other persons against whom the patentee is not taking or has not taken proceedings for infringement. 	
<p>14.02.01.02</p>	<p>Contents of application</p> <p>Such an application shall contain a statement setting out the nature of the applicant's interest, facts upon which the application is based and terms and conditions of the licence the applicant is willing to accept.</p>	<p>Section 84</p> <p>Form-17</p>

14.02.01.03	<p>Adjournment of application for compulsory licence in certain cases:</p> <p>(1) Where an application under section 84 or section 85, as the case may be, is made on the grounds that the patented invention has not been worked in the territory of India or on the ground mentioned in clause (d) of sub-section (7) of section 84 and the Controller is satisfied that the time which has elapsed since the sealing of the patent has for any reason been insufficient to enable the invention to be worked on a commercial scale to an adequate extent or to enable the invention to be so worked to the fullest extent that is reasonably practicable, he may, by order, adjourn the further hearing of the application for such period not exceeding twelve months in the aggregate as appears to him to be sufficient for the invention to be so worked:</p> <p>Provided that in any case where the patentee establishes that the reason why a patented invention could not be worked as aforesaid before the date of the application was due to any State or Central Act or any rule or regulation made thereunder or any order of the Government imposed otherwise than by way of a condition for the working of the invention in the territory of India or for the disposal of the patented articles or of the articles made, by the process or by the use of the patented plant, machinery, or apparatus, then, the period of adjournment ordered under this sub-section shall be reckoned from the date on which the period during which the working of the invention was prevented by such Act, rule or regulation or order of Government as computed from the date of the application, expires.</p> <p>(2) No adjournment under sub-section (1) shall be ordered unless the Controller is satisfied that the patentee has taken with promptitude adequate or reasonable steps to start the working of the invention in the territory of India on a commercial scale and to an adequate extent.</p>	Section 86
14.02.01.04	<p>Procedure for dealing with application for Compulsory Licence:</p> <p>a. Where the Controller is satisfied upon consideration of an application for compulsory licence that <i>prima facie</i> case has been made out, he shall direct the applicant to serve copies of the application upon the patentee and any other person appearing from the register</p>	Section 87, 88 - Rules 62,

	<p>of patents to be interested in the patent in respect of which the application is made, and shall publish the application in the official journal.</p> <p>b. The patentee or any other person desiring to oppose the application may, within two months from the date of publication of the application or within such further time as the Controller may on application (made either before or after the expiration of the prescribed time) allow, give to the Controller notice of opposition.</p> <p>c. The notice of opposition shall include grounds on which the application is opposed and the terms and conditions of the licence, if any, the opponent is prepared to grant to the applicant and shall be accompanied by evidence in support of the opposition.</p> <p>d. The opponent shall serve a copy of his notice of opposition and evidence on the applicant and notify the Controller when such service has been effected.</p> <p>e. No further statement or evidence shall be delivered by either party except with the leave of or on requisition by the Controller.</p> <p>f. The Controller shall forthwith fix a date and time for the hearing of the case and shall give the parties not less than ten days notice of such hearing.</p> <p>g. The procedure specified in sub-rules (2) to (5) of rule 62, shall, so far as may be, apply to the procedure for hearing under this rule as they apply to the hearing in opposition proceedings.</p> <p>h. If, upon consideration of the evidence, the Controller is satisfied that a prima facie case has not been made out, he shall notify the applicant accordingly, and unless the applicant requests to be heard in the matter, the Controller shall refuse the application. The applicant shall make such a request within one month from the date of such notification.</p> <p>i. If the applicant requests for a hearing within the time allowed, the Controller shall, after giving the applicant an opportunity of being heard, determine whether the application may be proceeded with or whether it shall be refused and issue a speaking order on the matter as expeditiously as possible.</p>	<p>96-101, Form-14</p>
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14.02.01.04 Terms and Conditions

Section 90

In settling the terms and conditions of a licence, the Controller endeavors to secure -

- a. that the royalty and other remuneration, if any, reserved to the patentee or other person beneficially entitled to the patent, is reasonable, having regard to the nature of the invention, the expenditure incurred by the patentee in making the invention or in developing it and obtaining a patent and keeping it in force and other relevant factors;
- b. that the patented invention is worked to the fullest extent by the person to whom the licence is granted and with reasonable profit to him;
- c. that the patented articles are made available to the public at reasonably affordable prices;
- d. that the licence granted is a non-exclusive licence;
- e. that the right of the licensee is non-assignable;
- f. that the licence is for the balance term of the patent unless a shorter term is consistent with public interest;
- g. that the licence is granted with a predominant purpose of supply in the Indian market and that the licensee may also export the patented product, if need be in accordance with the provisions of sub-clause (iii) of clause (a) of sub-section (7) of section 84;
- h. that in the case of semi-conductor technology, the licence granted is to work the invention for public non-commercial use;
- i. that in case the licence is granted to remedy a practice determined after judicial or administrative process to be anti-competitive, the licensee shall be permitted to export the patented product, if need be.

The terms and conditions of a licence settled by the Controller, may be revised upon Application by the licensee after he has worked the invention on a commercial scale for at least twelve months, on the ground that the terms and conditions settled have proved to be more onerous than originally expected and that in consequence thereof the licensee is unable to work the invention except at a loss. However, no such application shall be entertained a second time.

14.02.01.05	<p>Application by licensee</p> <p>a. Where the Controller is satisfied on an application for compulsory license that the manufacture, use or sale of materials not protected by the patent is prejudiced by reason of conditions imposed by the patentee upon the grant of licenses under the patent, or upon the purchase, hire or use of the patented article or process, he may, subject to the provisions of Section 84, order the grant of licenses under the patent to such customers of the applicant as he thinks fit as well as to the applicant.</p> <p>b. Where an application for compulsory license is made by a person being the holder of a license under the patent, the Controller may, if he makes an order for the grant of a license to the applicant, order the existing license to be cancelled, or may, if he thinks fit, instead of making an order for the grant of a license to the applicant, order the existing license to be amended.</p>	Section 88
14.02.01.06	<p>Compulsory license in case of two or more patents held by the same patentee</p> <p>Where two or more patents are held by the same patentee and an applicant for a compulsory license establishes that the reasonable requirements of the public have not been satisfied with respect to some only of the said patents, then, if the Controller is satisfied that the applicant cannot efficiently or satisfactorily work the license granted to him under those patents without infringing the other patents held by the patentee and if those patents involve important technical advancement or considerable economic significance in relation to the other patents, he may, by order, direct the grant of a license in respect of the other patents also to enable the licensee to work the patent or patents in regard to which a license is granted under section 84.</p>	Section 88
14.02.02	<p>License for related patents</p> <p>a. At any time after the grant of a patent, any person who has the right to work any other patented invention, either as patentee or as licensee thereof, exclusive or otherwise, may apply to the Controller for the grant of a license of the first mentioned patent on the ground that he is prevented or hindered without such license from working the other invention efficiently or to the best</p>	Section 91 Form-17

	<p>advantage possible.</p> <p>b. No order under such an application shall be made unless the Controller is satisfied –</p> <p>i. that the applicant is able and willing to grant, or procure the grant to the patentee and his licensees if they so desire, of a license in respect of the other invention on reasonable terms; and</p> <p>ii. that the other invention has made a substantial contribution to the establishment or development of commercial or industrial activities in the territory of India.</p> <p>c. Controller, if satisfied, that the grounds alleged have been established by the applicant, he may make an order on such terms as he thinks fit granting a license under the first mentioned patent and a similar order under the other patent if so requested by the proprietor of the first mentioned patent or his licensee.</p> <p>However, such a license granted by the Controller shall be non-assignable except with the assignment of the respective patents.</p> <p>d. The provisions of sections 87-90 shall apply to licenses granted under this section as they apply to licenses granted under section 84.</p>	
<p>14.02.03</p>	<p>Compulsory licence on Notification by Central Government</p> <p>1. If the Central Government is satisfied, in respect of any patent in force in circumstances of national emergency or in circumstances of extreme urgency or in case of public non-commercial use, that it is necessary that compulsory licenses should be granted at any time after the grant thereof to work the invention, it may make a declaration to that effect, by notification in the Official Gazette, and thereupon the following provisions shall have effect, that is to say -</p> <p>i. the Controller shall, on application made at any time after the notification by any person interested, grant to the applicant a license under the patent on such terms and conditions as he thinks fit;</p> <p>ii. in settling the terms and conditions of a license granted under this section, the Controller shall endeavour to secure that the articles manufactured under the patent shall be available to the public at the lowest prices consistent with the patentees</p>	<p>Section 92</p> <p>Form-17</p>

	<p>deriving a reasonable advantage from their patent rights.</p> <p>iii. The procedure as mentioned in Sections 83, 87, 88, 89 and 90 shall apply in relation to the grant of such licenses as they apply in relation to the grant of licenses under Sec. 84.</p> <p>2. Notwithstanding anything contained in a-iii above, if the Controller is satisfied on consideration of the application that, it is necessary in-</p> <p>a. a circumstance of national emergency; or</p> <p>b. a circumstance of extreme urgency; or</p> <p>c. a case of public non-commercial use,</p> <p>which may arise or is required, as the case may be, including public health crisis relating to Acquired Immuno-Deficiency Syndrome, Human Immune Deficiency Virus, Tuberculosis, Malaria or other epidemics, the procedure as mentioned in Section 87 shall not apply; provided the Controller shall, as soon as may be practicable, inform the patentee of the patent relating to the application for such non-application of Section 87.</p>	
14.02.04	<p>Compulsory license for export of patented pharmaceutical products in certain exceptional circumstances</p> <p>a) Compulsory license shall be available for manufacture and export of patented pharmaceutical product to any country having insufficient or no manufacturing capacity in the pharmaceutical sector for the concerned product to address public health problems, provided compulsory license has been granted by such country or such country has, by notification or otherwise, allowed importation of the patented pharmaceutical products from India.</p> <p>b) The Controller shall, on receipt of an application in the prescribed manner, grant a compulsory license solely for manufacture and export of the concerned pharmaceutical product to such country under such terms and conditions as may be specified and published by him.</p> <p>c) The provisions of (a) and (b) shall be without prejudice to the extent to which pharmaceutical products produced under a compulsory license can be exported under any other provision of this Act.</p>	Section 92A Form-17

	<p>d) 'Pharmaceutical products' means any patented product, or product manufactured through a patented process, of the pharmaceutical sector needed to address public health problems and shall be inclusive of ingredients necessary for their manufacture and diagnostic kits required for their use.</p>	
14.02.05	<p>Termination of Compulsory License</p> <p>a) Patentee or any other person deriving title or interest in the patent, may make an application in Form 21 along with the evidence in support of the application for termination of compulsory licence granted under Section 84 on the ground that the circumstances that gave rise to the grant thereof no longer exist and such circumstances are unlikely to recur.</p> <p>b) The holder of the compulsory licence shall have the right to object to such termination.</p> <p>c) The procedure as elaborated under rule 102 for dealing with such application for termination of compulsory licence, including conducting hearing involving the both the parties, shall apply.</p> <p>d) While considering such an application, the Controller shall take into account that the interest of the person, who had previously been granted the licence, is not unduly prejudiced.</p> <p>e) If the Controller decides to terminate the compulsory licence he shall forthwith issue an order giving terms and conditions, if any, of such termination and serve copies of the order to both the parties.</p>	Section 94

Chapter 15: Use of inventions for purposes of Government and Acquisition of inventions by Central Government

15.01	<p>Use of inventions for the purposes of Government</p> <p>An invention is said to be used for the purpose of Government if it is made, used, exercised or vended for the purposes of Central Government, a State Government or a Government undertaking.</p>	Section 99, 100
15.02	<p>Power of Central Government to use inventions for purpose of Government</p> <p>a. Where an invention has, before the priority date of the relevant claim of the complete specification, been duly recorded in a document or tested or tried, by or on behalf of the government or a government undertaking, otherwise than in consequence of the communication of the invention directly or indirectly by the patentee or by a person from whom he derives title, any use of the invention by the Central Government or any person authorized in writing by it for the purposes of government may be made free of any royalty or other remuneration to the patentee.</p> <p>b. If and so far as the invention has not been so recorded or tried or tested as aforesaid, any use of the invention made by the Central Government or any person authorized by it as above said at any time after grant of the patent or in consequence of any such communication as aforesaid, shall be made upon the terms as may be agreed upon either before or after the use, between the Central Government or any person authorised by Central Government and the patentee or as may in default of agreement be determined by the High Court on a reference under Section 103.</p> <p style="padding-left: 20px;">In case of any such use of any patent, the patentee shall be paid not more than adequate remuneration in the circumstances of each case, taking into account the economic value of the use of the patent.</p> <p>c. The authorisation by the Central Government in respect of an invention may be given either before or after the patent is granted and either before or after the acts in respect of which such authorisation is given or done, and may be given to any person, whether or not he is authorised directly or indirectly by the applicant or the patentee to</p>	

make, use, exercise or vend the invention or import the machine, apparatus or other article or medicine or drug covered by such patent.

- d. Where an invention has been used by or with the authority of the Central Government for the purposes of government then except in case of national emergency or other circumstances of extreme urgency or for non-commercial use, the government shall notify the patentee as soon as practicable of the fact and furnish him with such information as to the extent of the use of the invention as he may, from time to time, reasonably require. Where the invention has been used for the purposes of a government undertaking, the Central Government may call for such information as may be necessary for this purpose from such undertaking.
- e. The right to make, use, exercise and vend an invention for the purposes of government shall include the right to sell on non-commercial basis the goods which have been made in exercise of that right and a purchaser of goods so sold, and a person claiming through him, shall have the power to deal with the goods as if the Central Government or the person authorised by the Central Government were the patentee of the invention.
- f. Where in respect of a patent, which has been the subject of an authorisation, there is an exclusive licensee or where such patent has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention (including payments by way of minimum royalty), the notice shall also be given to such exclusive licensee or assignor, as the case may be, and the reference to the patentee shall be deemed to include a reference to such assignor or exclusive licensee.
- g. However, the provisions for use of invention by the Government specified in this chapter shall not apply in respect of any such importation, making or using of any machine, apparatus or other article or of any such using of any process or of any such importation, using or distribution of any medicine or drug, as may be made by virtue of one or more of the conditions specified in section 47.

15.03	<p>Rights of third parties</p> <p>a. In relation to any use of a patented invention, or an invention in respect of which an application for a patent is pending, made for the purposes of government-</p> <ul style="list-style-type: none"> i. by the Central Government or any person authorised by the Central Government under section 100; or ii. by the patentee or applicant for the patent to the order made by the Central Government, <p>the provisions of any licence, assignment or agreement granted or made between the patentee or applicant for the patent (or any person who derives title from him or from whom he derives title) and any person other than the Central Government, shall be of no effect so far as those provisions -</p> <ul style="list-style-type: none"> i. restrict or regulate the use for the purposes of government of the invention, or of any model, document or information relating thereto, or ii. provide for the making of payments in respect of any use of the invention or of the model, document or information relating thereto for the purposes of government, <p>and the reproduction or publication of any model or document in connection with the said use for the purposes of government shall not be deemed to be an infringement of any copyright subsisting in the model or document.</p> <p>b. Where the patent, or the right to apply for or obtain the patent, has been assigned to the patentee in consideration of royalties or other benefits determined by reference to the use of the invention then, in relation to any use of the invention made for the purposes of government by the patentee to the order of the Central Government, sub-section (3) of section 100 shall have effect as if that use were made by virtue of an authority given under that section, and any use of the invention for the purposes of government by virtue of sub-section (3) of that section shall have effect as if the reference to the patentee included a reference to the assignor of the patent, and any sum payable by virtue of that sub-section shall be divided between the patentee and the assignor in such proportion as may be</p>	Section 101
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	<p>agreed upon between them or as may in default of agreement be determined by the High Court on a reference under Section 103.</p> <p>c. Where by virtue of sub-section (3) of section 100, payments are required to be made by the Central Government or persons authorised under sub-section (1) of that section in respect of the use of an invention for the purposes of government, and where in respect of such patent there is an exclusive licensee authorised under his licence to use the invention for the purposes of government, such sum shall be shared by the patentee and such licensee in such proportions, if any, as may be agreed upon between them or as may in default of agreement be determined by the High Court on a reference under section 103 to be just, having regard to any expenditure incurred by the licensee—</p> <ul style="list-style-type: none"> i. in developing the said invention; or ii. in making payments to the patentees other than royalties or other benefits determined by reference to the use of the invention in consideration of the license. 	
15.04	<p>Acquisition of inventions and patents by the Central government</p> <p>a. The Central Government may, if satisfied that it is necessary that an invention which is the subject of an application for a patent or a patent should be acquired from the applicant or the patentee for a public purpose, publish a notification to that effect in the Official Gazette, and thereupon the invention or patent and all rights in respect of the invention or patent shall, by force of this section, stand transferred to and be vested in the Central Government.</p> <p>b. Notice of the acquisition shall be given to the applicant, and, where a patent has been granted, to the patentee and other persons, if any, appearing in the register as having an interest in the patent.</p> <p>c. The Central Government shall pay to the applicant, or as the case may be, the patentee and other persons appearing on the register as having an interest in the patent such other compensation as may be agreed upon between the Central Government and the applicant or the patentee and other persons; or, as may, in default of agreement, be determined by the High Court on a reference under</p>	Section 102

	<p>section 103 to be just having regard to the expenditure incurred in connection with the invention and, in the case of a patent, the term thereof, the period during which and the manner in which it has already been worked (including the profits made during such period by the patentee or by his licensee whether exclusive or otherwise) and other relevant factors.</p>	
<p>15.05</p>	<p>Reference of disputes to High Court regarding use/acquisition</p> <p>a. Any dispute as to the exercise by the Central Government or a person authorised by it of the powers conferred by section 100, or as to terms for the use of an invention for the purposes of government thereunder or as to the right of any person to receive any part of a payment made in pursuance of sub-section (3) of that section or as to the amount of compensation payable for the acquisition of an invention or a patent under section 102, may be referred to the High Court by either party to the dispute in such manner as may be prescribed by the rules of the High Court.</p> <p>b. In any proceedings under this section to which the Central Government is a party, the Central Government may—</p> <ol style="list-style-type: none"> i. if the patentee is a party to the proceedings, petition by way of counter-claim for revocation of the patent on any ground upon which a patent may be revoked under section 64; and ii. whether a patentee is or is not a party to the proceedings, put in issue the validity of the patent without petitioning for its revocation. <p>c. If in such proceedings as aforesaid any question arises whether an invention has been recorded, tested or tried as is mentioned in section 100, and the disclosure of any document regarding the invention, or of any evidence of the test or trial thereof, would, in the opinion of the Central Government, be prejudicial to the public interest, the disclosure may be made confidentially to the advocate of the other party or to an independent expert mutually agreed upon.</p> <p>d. In determining under this section any dispute between the Central Government and any person as to terms for the use of an invention for the purposes of government, the High Court shall have</p>	<p>Section 102, 103</p>

regard to any benefit or compensation which that person or any person from whom he derives title, may have received, or may be entitled to receive, directly or indirectly in respect of the use of the invention in question for the purposes of government.

- e. In any proceedings under this section, the High Court may at any time order the whole proceedings or any question or issue of fact arising therein to be referred to an official referee, commissioner or an arbitrator on such terms as the High Court may direct, and references to the High Court in the foregoing provisions of this section shall be construed accordingly.
- f. Where the invention claimed in a patent was made by a person who at time it was made was in the service of the Central Government or of a State Government or was an employee of a government undertaking and the subject-matter of the invention is certified by the relevant government or the principal officer of the government undertaking to be connected with the work done in the course of the normal duties of the government servant or employee of the government undertaking, then, notwithstanding anything contained in this section, any dispute of the nature referred to in sub-section (1) relating to the invention shall be disposed of by the Central Government conformably to the provisions of this section so far as may be applicable, but before doing so the Central Government shall give an opportunity to the patentee and such other parties as it considers have an interest in the matter to be heard.

Chapter 16: Patent Agents

16.01	<p>Patent Agents</p> <p>a. A patent application can be filed and prosecuted by an Applicant himself or through a registered Indian patent agent. The Register of Patent Agents containing the names and addresses of all the registered patent agents is available at: www.ipindia.nic.in</p> <p>b. The Patents Act read with the Patents Rules prescribe the qualifications and the eligibility for becoming a patent agent. In order to get registered as a patent agent one has to pass an examination conducted by the Controller General of Patents annually. The notification concerning the examination is published in the official website www.ipindia.nic.in and also in at least one prominent newspaper.</p> <p>c. In order to apply for registration as a patent agent, one has to be a citizen of India, above the age of 21, and should have a Bachelor's degree in Science or Engineering from a recognized Indian University or possesses such other equivalent qualifications as the Central Government may specify in this behalf.</p> <p>d. All matters relating to registration and subsequent procedures regarding patent agents are dealt by the Office of the Controller General of Patents, Designs and Trademarks, Mumbai.</p> <p>Particulars to be contained in the Register of Patent Agents:</p> <p>1) The register of patent agents maintained under section 125 shall contain the name, nationality, address of the principal place of business, addresses of branch offices, if any, the qualifications, the date of registration of every registered patent agent and the details of their renewal of registration and any other particulars so specified by the Controller.</p> <p>2) Where the register of patent agents is in computer floppies, diskettes or any other electronic form, it shall be maintained and accessed only by the person who is duly authorised by the Controller and no entry or alteration of any entry or rectification of any entry in the said register shall be made by any person who is not so authorised by the Controller.</p>	<p>Section 125, 126, 127</p> <p>Rule 108, 109</p>
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	<p>3) Register of patent agents shall contain specimen signatures and photographs of persons registered as patent agents.</p> <p>Application for Registration of Patent Agents :</p> <p>(1) Every person who desires to be registered as a patent agent shall make an application in Form 22.</p> <p>(2) The applicant shall furnish such other information as may be required by the Controller.</p> <p>(3) A person desirous to appear in the qualifying examination under rule 110 shall make a request to the Controller along with the fee specified in the First Schedule after announcement of such examination and within the period as may be specified in the announcement.</p>	
16.02	<p>Disqualifications for Registration as Patent Agent</p> <p>A person shall not be eligible to be registered as s patent agent, if he–</p> <p>a. has been adjudged by a competent court to be of unsound mind;</p> <p>b. is an undischarged insolvent;</p> <p>c. being a discharged insolvent, has not obtained from the court a certificate to the effect that his insolvency was caused by misfortune without any misconduct on his part;</p> <p>d. has been convicted by a competent court, whether within or outside India of an offence to undergo a term of imprisonment, unless the offence of which he has been convicted has been pardoned or unless on an application made by him, the Central Government has, by order in this behalf, removed the disability;</p> <p>e. being a legal practitioner, has been guilty of professional misconduct; or</p> <p>f. being a chartered accountant, has been guilty of negligence or misconduct .</p>	Rule 114
16.03	<p>Rights of patent agents</p> <p>A patent agent is entitled-</p> <p>a. to practice before the Controller; and</p> <p>b. to prepare all documents, transact all business and discharge such other functions as may be prescribed in connection with any proceedings before the Controller under this Act.</p>	Section 127

16.04	<p>Subscription and verification of certain documents by a Patent Agent</p> <p>All applications and communications to the Controller under this Act may be signed by a patent agent authorized in writing in this behalf by the person concerned.</p>	Section 128
16.05	<p>Restrictions on Practice as Patent Agents</p> <p>Only a person registered as a patent agent is authorized to practice. In the case of a partnership, the firm may be described or held out as Patent Agent, only if all of the partners of the Firm are registered as patent agents. No company or other body corporate shall practice, describe itself or hold itself out as Patent Agents or permit itself to be so described or held out.</p>	Section 129
16.06	<p>Power of Controller to refuse to deal with certain agents</p> <p>The Controller may refuse to recognize as agent in respect of any business under this Act:</p> <ol style="list-style-type: none"> a. any individual whose name has been removed from, and not restored to, the register; b. any person who has been convicted of an offence under section 123 of the Act; c. any person, not being registered as a patent agent, who in the opinion of the Controller is engaged wholly or mainly in acting as agent in applying for patents in India or elsewhere in the name or for the benefit of the person by whom he is employed; d. any company or firm, if any person whom the Controller could refuse to recognize as agent in respect of any business under this Act, is acting as a director or manager of the company or is a partner in the firm. e. any person who neither resides nor has a place of business in India. 	Section 131
16.07	<p>Power of Controller to remove the name of a Patent Agent:</p> <ol style="list-style-type: none"> a. The name of any person from the Register can be removed if the Controller is satisfied that:– <ol style="list-style-type: none"> i. his/her name has been entered in the Register by error on account of misrepresentation or suppression of material fact; or 	Section 130. Rule 116.

	<p>ii. he/she has been convicted of any offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity which in the opinion of the Controller renders him unfit to be kept in the register.</p> <p>b. The Controller shall take such decision after giving that person a reasonable opportunity of being heard and after any further inquiry, as he thinks fit to make.</p> <p>Removal of a name from the Register of patent agents-</p> <p>1) The Controller may delete from the register of patent agents, the name of any patent agent-</p> <p>(a) from whom a request has been received to that effect; or</p> <p>(b) when he is dead; or</p> <p>(c) when the Controller has removed the name of a person under sub-section (1) of section 130; or</p> <p>(d) if he has defaulted in the payment of fees specified in rule 115, by more than three months after they are due; or</p> <p>(e) if he ceases to be a citizen of India:</p> <p>Provided that except under clause(a) and (b), before removing the name of any person from the register of patent agents under this rule, such person shall be given a reasonable opportunity of being heard.</p> <p>2) The decision of the removal of the name of any person from the Register of Patent Agents shall be published and shall be communicated to the person concerned.</p>	
16.08	<p>Restoration of names of Patent Agents</p> <p>a. Restoration of names of persons removed from the register of Patent Agents can be made by the Controller on Application made in form 23 within two months from the date of such removal.</p> <p>b. The restoration of name to the register shall be published on official website and communicated to the person concerned.</p> <p>c. If the name of a person is entered in the register of Patents Agents, his name shall be continued therein for a period of one year from the date on which his last annual fee became due.</p>	<p>Rule 117</p> <p>Form-23</p>

16.09	<p>Alteration of names of Patent Agents</p> <p>1) A patent agent may apply for the alteration of his name, address of the principal place of business and branch offices, if any, or the qualifications entered in the register of patent agents, e-mail address, telephone number, fax number or any other particulars under subsection (1) of section 125. On receipt of such application and the fee specified therefor in the First Schedule for such request for alteration of particulars, the Controller shall cause the necessary alterations to be made in the register of patent agents.</p> <p>2) Every alteration made in the register of patent agents shall be published.</p>	<p>Section 125</p> <p>Rule 118</p>
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Chapter 17: Offences and Penalties

17.01	<p>Contravention of Section 35 or 39</p> <p>If any person fails to comply with any direction given under section 35 or makes or causes to be made an application for the grant of a patent in contravention of section 39, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.</p>	Section 118
17.02	<p>Falsification of entries in register, etc.</p> <p>If any person makes, a false entry in any register kept under the Patents Act or provides any writing or evidence as a result of which the entry in the register results into a false entry, knowing the entry or writing to be false, then he is punishable with imprisonment for a term that may extend to two years or with fine or with both.</p>	Section 119
17.03	<p>Unauthorized Claim of Patent Rights</p> <p>If any person falsely represents that any article sold by him is patented in India or is the subject of an Application for a Patent in India, he shall be punishable with fine that may extend to rupees one lakh.</p>	Section 120
17.04	<p>Wrongful use of words, "Patent Office"</p> <p>If any person uses on his place of business or any document issued by him which would reasonably lead to the belief that either his place of business is the Patent Office or is officially connected with the Patent Office, he shall be punishable with imprisonment for a term that may extend to 6 months, or with fine, or with both.</p>	Section 121
17.05	<p>Refusal or failure to supply information</p> <p>If any person refuses or fails to furnish information as required under Sections 100(5) and 146, he shall be punishable with fine which may go up to rupees ten lakh.</p> <p>Section 100(5) provides that any person including Government undertaking using a patented invention for the purpose of Government has to furnish any information on the use of invention as required by the Central Government and Section 146 provides that the patentee has to furnish a statement regarding the working of the patented invention in a commercial</p>	Section 122 Form-27

	scale in India in Form 27. This has to be done annually within 3 months of the end of each calendar year for that calendar year. If he furnishes false information knowingly he shall be punishable with imprisonment that may extend to 6 months or with fine or with both.	
17.06	<p>Practice by non-registered persons</p> <p>Any person practicing as a Patent Agent without registering himself as such is liable to be punished with a fine of rupees one lakh for the first offence and rupees five lakh for subsequent offence.</p>	Section 123
17.07	<p>Offences by Companies</p> <p>a. When an offence is committed by a company, the company as well as every person in charge of, and responsible to the company for the conduct of its business at the time of the commission of the offence, shall be deemed to be guilty and shall be liable to be proceeded against and punished accordingly.</p> <p>However, if such person proves that the offence was committed without his knowledge or that he exercised all due diligence to prevent the commission of the office, he shall not be liable.</p> <p>b. Notwithstanding anything contained above, where an offence under this Act has been committed by a company and it is proved that the offence has been committed with the consent, connivance or that the commission of the offence is attributable to any neglect on the part of any director, manager, secretary or other office of the company, such director, manager, secretary or other officer shall also be deemed to be guilty of that offence and shall be liable to be proceeded against and punished accordingly.</p>	Section 124

Chapter 18: General Powers of Controller

18.01	<p>Certain Powers of Civil Court to Controllers:</p> <p>Subject to any rules made in this behalf, the Controller in any proceedings before him under this Act, have the powers of a Civil Court while trying a suit under the Code of Civil Procedure, 1908 (Act No. 5 of 1908) in respect of the following matters, namely:</p> <ol style="list-style-type: none"> a. Summoning and enforcing the attendance of any person and examining him on oath; b. Requiring the discovery and production of any document; c. Receiving evidence on affidavits; d. Issuing commissions for the examination of witnesses of documents; e. Awarding costs; f. Reviewing his own decision on application made within the prescribed time and in the prescribed manner; g. Setting aside an order passed ex-parte on application made within the prescribed time and in the prescribed manner; h. Any other matter which may be prescribed. 	<p>Section 77 Rule 136 Order XLVII of CPC, 1908.</p>
18.02	<p>Awarding Costs</p> <ol style="list-style-type: none"> a. Any order for costs awarded by the Controller in exercise of the powers conferred upon him is executable as a decree of a civil court. In all proceedings before the Controller, costs may be awarded by the Controller, as he considers reasonable, having regard to all the circumstances of the case. b. However, the amount of costs awarded in respect of any matter set forth in the Fourth Schedule shall not exceed the amount specified therein. c. Notwithstanding anything contained in (a) above, the Controller may, in his discretion, award a compensatory cost in any proceeding before him which in his opinion is false or vexatious. 	<p>Section 77(1)(e) Rule 63, 136</p>
18.03	<p>Review</p> <ol style="list-style-type: none"> a. Any person considering himself aggrieved by any order or decree 	<p>Section</p>

	<p>of the Controller from which an appeal is allowed but no appeal has been preferred, or from which no appeal is allowed, and who, from the discovery of new and important matter or evidence which, after the exercise of due diligence was not within his knowledge or could not be produced by him at the time when the order or decree was passed or order made, or on account of some mistake or error apparent on the face of the record or for any other sufficient reason, desires to obtain a review of the decree passed or order made against him, may apply for a review of the order or decree to the Controller.</p> <p>b. An application to the Controller for the review of his decision under clause (f) of sub-section (1) of section 77 shall be made within one month from the date of communication of such decision to the applicant or within such further period not exceeding one month thereafter as the Controller may on a request allow.</p> <p>c. An application for review shall be accompanied by a statement setting forth the grounds on which the review is sought.</p> <p>d. Where the decision in question concerns any other person in addition to the applicant, the Controller shall forthwith transmit a copy of each of the application and the statement to the other person concerned.</p> <p>e. An application to the Controller for setting aside an order passed by him ex-parte under clause (g) of sub-section (1) of section 77 shall be made within one month from the date of communication of such order to the applicant or within such further period not exceeding one month as the Controller may on a request allow and shall be accompanied by a statement setting forth the grounds on which the application is based. Where the order concerns any other person in addition to the applicant, the Controller shall, forthwith transmit a copy each of the application and the statement to the other person concerned.</p>	<p>77(1)(f). Rule 130. Form-4, 24. Section 114 & Order XLVII of CPC, 1908.</p>
<p>18.04</p>	<p>Petition for Obviating an Irregularity Any document for the amendment of which no special provision is made in the Act may be amended and any irregularity in procedure,</p>	<p>Rule 137. Nippon Steel</p>

	<p>which in the opinion of the Controller may be obviated without detriment to the interests of any person, may be corrected if the Controller thinks fit and upon such terms as he may direct.</p>	<p>Corporation Vs. Union of India</p>
<p>18.05</p>	<p>Mention of Inventor in Patent</p> <p>If the controller is satisfied, upon a request or claim made in accordance with the provisions of this section,</p> <ul style="list-style-type: none"> i) that the person in respect of or by whom the request or claim is made is the inventor of an invention in respect of which application for a patent has been made, or of a substantial part of that invention; and ii) that the application for the patent is a direct consequence of his being the inventor, <p>the Controller shall, subject to the provisions of this section, cause him to be mentioned as inventor in any patent granted in pursuance of the application in the complete specification and in the Register of patents:</p> <ul style="list-style-type: none"> a. Such a request or claim shall be accompanied by a statement setting out the circumstances under which the claim is made. b. However, the mention of any person as inventor under this section shall not confer or derogate from any rights under the patent. c. A request that any person shall be mentioned as aforesaid may be made in the prescribed manner by the applicant for the patent or (where the person alleged to be the inventor is not the applicant or one of the applicants) by the applicant and that person. d. If any person [other than a person in respect of whom a request in relation to the application in question has been made under sub- section (2)] desires to be mentioned as aforesaid, he may make a claim in the prescribed manner in that behalf. e. A request or claim under the foregoing provisions of this 	<p>Section 28.</p> <p>Rules 57-63, 66-70.</p> <p>Form 8.</p>

	<p>section shall be made before the grant of patent.</p> <p>f. Where such a claim is made, the Controller shall give notice of the claim to every applicant for the patent (not being the claimant) and to any other person whom the Controller may consider to be interested and before deciding upon any such request or claim, the Controller shall, if required, hear the person in respect of or by whom the request or claim is made, and also any person to whom notice of the claim has been given as aforesaid.</p> <p>g. Where any person has been mentioned as inventor in pursuance of such an application, any other person who alleges that he ought not to have been so mentioned may at any time apply to the Controller for a certificate to that effect, and the Controller may, after hearing, if required, any person whom he may consider to be interested, issue such a certificate, and if he does so, he shall rectify the specification and the register accordingly.</p> <p>h. The procedure specified in rules 55A and 57 to 63 relating to the filing of notice of opposition, written statement, reply statement, leaving evidence, hearing and cost (except the procedural part related to Opposition Board included under rule 62 (1) and 62 (5)) shall, so far as the case may be, apply to the hearing of such a claim or application as they apply to the opposition proceedings subject to the modification that reference to patentee shall be construed as the person making the claim, or an application, as the case may be.</p> <p>i. Any mention of the inventor under sub-section (1) of section 28 shall be made in the relevant documents in the following form namely:-</p> <p style="padding-left: 40px;">The inventor of this invention/substantial part of this invention within the meaning of section 28 of the Patents Act,1970, is.....of.....</p>	
18.06	<p>Directions Not Otherwise Prescribed</p> <p>a. Where for the proper prosecution or completion of any</p>	Rule 128

	<p>proceedings under the Act or these rules, the Controller is of the opinion that it is necessary for a party to such proceedings to perform an Act, file a document or produce evidence, for which provision has not been made in the Act or these rules, he may, by notice in writing, require such party to perform the Act, file the document or produce the evidence specified in such notice.</p> <p>b. Where an applicant or a party to a proceeding desires to be heard or not heard, the Controller may, at any time, require him to submit his statement in writing giving such information as the Controller may deem necessary within the time specified by him.</p>	
<p>18.07</p>	<p>Exercise of Discretionary Power by the Controller</p> <p>a. Before acting adverse to any party, the Controller shall give an opportunity of being heard to the party. The discretionary powers shall be exercised with due care and caution and not in an arbitrary manner. Such reasons shall be taken judiciously and the reasons shall be recorded in the file. However, this will not apply to actions resulting from provisions in the Act and Rules.</p> <p>b. A party desiring a hearing shall make the request for such hearing to the Controller at least ten days in advance of the expiry of the time-limit specified in respect of the proceeding.</p> <p>c. Before exercising any discretionary power under the Act or these rules which is likely to affect an applicant for a patent or a party to a proceeding adversely, the Controller shall give such applicant or party, a hearing, after giving him or them, ten days' notice of such hearing ordinarily.</p> <p>d. An applicant for patent or a party to a proceeding may make a request for adjournment of the hearing with reasonable cause along with the prescribed fee prescribed in First Schedule, at least three days before the date of hearing.</p> <p>e. The Controller, if he thinks fit to do so, and upon such terms as he may direct, may adjourn the hearing not more than twice and intimate the parties accordingly. Each adjournment shall not be for more than thirty days.</p>	<p>Section 80. Rule 129, 129A.</p>

18.08	<p>Power of Controller to Correct Clerical Errors, etc.</p> <p>a. Without prejudice to the provisions contained in sections 57 and 59 as regards amendment of applications for patents or complete specifications or other documents relating 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.</p> <p>b. 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.</p> <p>c. Where the Controller proposes to make any such correction as aforesaid otherwise than in pursuance of a request, 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.</p> <p>d. Where a request is made under section 78 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 official journal.</p> <p>e. Such a request for the correction of a clerical error in any document shall be accompanied by a copy of the document highlighting the corrections clearly along with the prescribed fees.</p> <p>f. 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</p>	<p>Section 78. Rule 122, 124.</p>
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	<p>whom the request was made, and shall give to him and to the opponent an opportunity to be heard before he decides the case.</p> <p>g. The procedure specified in rules 58 to 63 relating to the filing of reply statement, leaving evidence, hearing and costs shall, so far as may be, will be applicable to the above proceedings, except the procedural part related to Opposition Board provided under rule 62 (1) and 62 (5).</p>	
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Chapter 19: General Services

19.01	<p>General Services</p> <p>a. Patent Office provides certain statutory and non- statutory services for the dissemination of information related to patent processing.</p> <p>b. It may be noted that references to some of these services have already been made in the relevant Chapters.</p> <p>c. These services are enumerated in the following paragraphs as per standards set by the Patent Office.</p>	
19.02	<p>Official Journal</p> <p>Every Friday the Controller publishes the Official Patent Journal electronically, which is made available on the official website of the Patent Office (www.ipindia.nic.in).</p>	Section 145
19.03	<p>Information relating to Patent Applications and Patents</p> <p>a. At the request of a person (on plain paper), the Controller provides the following information regarding a Patent or an Application for a Patent. Separate requests shall be made in respect of each item:</p> <ol style="list-style-type: none"> i. as to when a Complete Specification following Provisional Specification has been filed or an Application for Patent is deemed to be abandoned; ii. as to when the information under Section 8 has been filed; iii. as to when Publication of Application has been made under Section 11 A; iv. as to when an Application has been withdrawn under Section 11B; v. as to when a request for examination has been made under Section 11B; vi. as to when the examination report has been issued under Section 12; vii. as to when an Application for Patent has been refused; viii. as to when a Patent has been granted; ix. as to when a renewal fee has been paid; x. as to when the term of a Patent has expired or shall expire; xi. as to when an entry has been made in the Register or Application has been made for the making of such entry; or 	Section 153. Rule 134.

	<p>xii. as to when any Application is made or action taken involving an entry in the Register, publication in the Official Journal or otherwise, if the nature of the Application or action is specified in the request.</p> <p>b. The report of the Examiner to the Controller under Section 12 is not open to public unless directed by a Court of Law.</p> <p>c. Except (b) above, most of the information relating to patents is available on the official website. However, the information available on the official website of the Patent Office would not be sufficient for legal proceedings, for which a person may take recourse to (a) above.</p>	
<p>19.04</p>	<p>Inspection and supply of copies of documents</p> <p>a. After the publication of application, the application along with the complete specification, provisional specification, drawing, if any, and the abstract may be inspected at the appropriate Patent Office.</p> <p>b. After the grant of a patent, the application along with the complete specification, provisional specification, drawing, if any, and abstract and related thereto may be inspected at the concerned Patent Office.</p> <p>c. Request for inspection may be made in Form-30 along with the prescribed fee.</p> <p>d. A person may obtain copies of any document open to public upon payment of the prescribed fee.</p> <p>e. Certified copy of any document open to public may be obtained upon payment of prescribed fee. The certified copy of any document issued by the Patent Office with its seal is admitted in evidence in all Courts and in all proceedings in lieu of the original document.</p> <p>f. Register of Patents may be inspected during the working hours of the Patent Office by making a written application along with the prescribed fee.</p> <p>g. Certified copies of any entry in the Register is available upon the payment of prescribed fee.</p>	<p>Section 72, 147,. Rule 27, 74- A, , 133 Form 30</p>

	<p>h. Certified copies of any entry in the register, or certificates of, or extracts from patents, specifications and other public documents in the patent office, or from registers and other records including records in computer floppies, diskettes or any other electronic form kept there, may be furnished by the Controller on a request therefor made to him and on payment of the fee specified therefor in the First Schedule: Provided that certified copies shall be issued in the order in which the request is filed.</p> <p>i. Notwithstanding anything contained above, certified copies can be furnished within a period of one week if such request is made along with the fee specified therefore in the First Schedule.</p>	
19.05	<p>Annual Report of the Patent Office</p> <p>The Patent Office publishes an annual report comprising statistical information pertaining to the activities of Patent Office. Such report is placed before both the Houses of Parliament, whereupon the report is made available on the official website.</p>	Section 155
19.06	<p>Information available at the Website</p> <p>The official website (www.ipindia.nic.in) provides the following information:</p> <p>a. Indian Patent Advanced Search System (inPASS) provides information on:</p> <ol style="list-style-type: none"> i. Granted Patents; ii. Details of Published Patent Applications with status; iii. Status of granted patents iv. e-Register of Patents <p>In addition, the following information is also available :</p> <ul style="list-style-type: none"> • News & Events/ Circulars by the Controller General • Manuals/ Guidelines • Act & Rules. • Controller’s decisions. • Ceased and Lapsed patents • Dynamic patent utilities • List of registered Patent Agents. • Mobile App. A mobile App named “Intellectual Property 	

	<p>India” has been developed and link is available on website for both android and iOS versions. Android version could also be downloaded from Google play store.</p> <ul style="list-style-type: none">• A link for video conferencing on website.• Feedback system	
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Chapter 20 : Scientific Advisors

20.01	<p>Scientific Advisors</p> <p>a. In any suit for infringement or in any proceeding before a Court under this Act, the Court may at any time, suo-moto or on an application made by a party, appoint an independent Scientific Advisor to assist the Court or to inquire and report upon any such questions of fact or of opinion (not involving a question of interpretation of law) as it may formulate for the purpose.</p> <p>b. The remuneration of the Scientific Advisor shall be fixed by the Court and shall include the cost of preparing/making a report and appropriate fee for Scientific Advisor for any day on which he/she may be required to attend the hearing of the Court, and such remuneration shall be defrayed out of funds provided by the Parliament under law for such purpose.</p>	Section 115
20.02	<p>Roll of Scientific Advisors</p> <p>(1) The Controller shall maintain a roll of scientific advisers for the purpose of section 115. The roll shall be updated annually. The roll shall contain the names, addresses, specimen signatures and photographs of scientific advisers, their designations, information regarding their educational qualifications, the disciplines of their specialisation and their technical, practical and research experience.</p> <p>(2) A person shall be qualified to have his name entered in the roll of scientific advisers, if he-</p> <ul style="list-style-type: none"> (i) holds a degree in science, engineering or technology or equivalent; (ii) has at least fifteen years' technical, practical or research experience; and (iii) he holds or has held a responsible post in a scientific or technical department of the Central or State Government or in any organisation. <p>The panel/list is also accessible / made available on the official website of the Patent Office at url: www.ipindia.nic.in.</p>	Rule 103, 103A

	<p>(3) Disqualifications for inclusion in the roll of scientific advisers</p> <p>A person shall not be eligible to be included in the roll of scientific advisers, if he -</p> <ul style="list-style-type: none"> (i) has been adjudged by a competent court to be of unsound mind; (ii) is an undischarged insolvent; (iii) being a discharged insolvent, has not obtained from the court a certificate to the effect that his insolvency was caused by misfortune without any misconduct on his part; (iv) has been convicted by a competent court, whether within or outside India of an offence to undergo a term of imprisonment, unless the offence of which he has been convicted has been pardoned or unless on an application made by him, the Central Government has, by order in this behalf, removed the disability; or (v) has been guilty of professional misconduct. 	
20.03	<p>Qualifications and Procedure for empanelment/enrollment</p> <p>a. Any person who is qualified to have his/her name entered in the panel/list/roll of scientific advisers. However, where the Controller is of the opinion that it is necessary or expedient to do so, he may, by order, for reasons to be recorded in writing, relax any of the qualifications specified above, with respect to any person, if such person is otherwise well qualified.</p> <p>b. Any person interested may apply at any time to the Controller for inclusion of his/her name in the roll of scientific advisers by furnishing his/her bio-data.</p> <p>c. The list/roll is updated and published annually.</p>	Rule 103, 104,105, 106
20.04	<p>Removal from the roll/panel of Scientific Advisor</p> <p>a. The Controller may remove the name of any person from the roll of scientific advisers, if—</p> <ul style="list-style-type: none"> i. such person makes a request for such removal; or ii. the Controller is satisfied that his/her name has been entered in the roll by error or account of misrepresentation or suppression of any material fact; or 	Rule 107

	<p>iii. such person has been convicted for an offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity and the Controller is of the opinion that his/her name should be removed from the roll:</p> <p>iv. such person is dead: Provided that except in the cases falling under clause (i) and (iv) above, before removing the name of any person from the roll of scientific advisers under this rule, such person shall be given a reasonable opportunity of being heard.</p> <p>b. Before removing the name of any person from the roll of scientific advisers under this rule, such person shall be given a reasonable opportunity of being heard.</p>	
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Chapter 21: Miscellaneous provisions

21.01	<p>Affidavits</p> <p>a. Notwithstanding anything to the contrary as and when directed by the Controller, in all proceedings before the Controller under this Act, evidence shall be given by way of an affidavit.</p> <p>b. In cases where the Controller deems it appropriate to do so, he may take oral evidence in lieu of, or in addition to, evidence by way of an affidavit, or may allow any party to be cross-examined on the contents stated in his/her affidavit.</p> <p>c. The affidavits required to be filed before the Controller of Patents under the Act or rules shall be duly sworn in the manner as prescribed under Clause (e) below.</p> <p>d. Affidavits shall be confined to such facts as the deponent is able, of his own knowledge, to prove except in interlocutory matters, where statements of belief of the deponent may be admitted, provided the grounds thereof are given.</p> <p>e. Affidavits shall be sworn to as follows:</p> <p style="padding-left: 20px;">i) In India - before any Court or person having by law authority to receive evidence, or before any officer empowered by such court as aforesaid to administer oaths or to take affidavits;</p> <p style="padding-left: 20px;">ii) In any country or place outside India - before a diplomatic or consular officer, within the meaning of the Diplomatic and Consular Officers (Oaths and Fees) Act, 1948 (41 of 1948); in such country or place or before a notary public of the country or place, recognised by the Central Government under section 14 of the Notaries Act, 1952 (53 of 1952); or before a Judge or Magistrate of the country or place.</p> <p>f. Alterations and interlineations shall, before an Affidavit is sworn to or affirmed to be authenticated by the initials of the person before whom the Affidavit is sworn to.</p>	<p>Section 79. Rule 126.</p> <p>Diplomatic and Consular Officers (Oaths and Fees) Act, 1948.</p> <p>Notification s u/s 14 of the Notaries Act, 1952.</p>
21.02	<p>Exhibits</p> <p>Where there are exhibits to be filed in an opposition matter or any</p>	<p>Rule 127</p>

	<p>other proceeding, a copy or impression of each exhibit shall be supplied to the other party at his request and expense; if copies or impressions of the exhibits cannot conveniently be furnished, the originals shall be left with the Controller for inspection by the person interested by prior appointment. The exhibits in original, if not already left with Controller, shall be produced at the hearing.</p>	
21.03	<p>Officers and employees of Patent Office – Duties</p> <p>An officer or employee of the Patent Office shall not, except when required or authorised by this Act or under a direction in writing of the Central Government or Appellate Board or the Controller or by order of a Court—</p> <ol style="list-style-type: none"> a. furnish information on a matter which is being, or has been, dealt with under this Act; or b. prepare to assist in the preparation of a document required or permitted by or under this Act to be lodged in the Patent Office ; or c. conduct a search in the records of the Patent Office. 	Section 76
21.04	<p>Hearing to be in public</p> <p>Where the hearing is held before the Controller in respect of any dispute between two or more parties relating to an application for a patent or to any matter in connection with a patent after the date of the publication of the complete specification, the hearing of the dispute shall be in public unless the Controller, after consultation with the parties to the dispute who appear in person or are represented at the hearing, otherwise directs.</p>	Rule 139
21.05	<p>Agency – Power of Attorney</p> <ol style="list-style-type: none"> a) Authorisation of an agent for the purposes of the Act and the rules shall be made in Form 26 or in the form of a Power of Attorney within a period of 3 months from the date of filing of such application or document, failing which no action shall be taken on such application or documents for further processing, till such deficiency is removed. b) Where any such authorisation has been made, service upon the agent of any document relating to the proceeding or matter under the Act or the rules shall be deemed to be the service 	Rule 135. Form-26.

	<p>upon the person so authorising and all communications directed to be made to a person in respect of the proceeding or matter may be addressed to such agent, and all appearances before the Controller relating thereto may be made by or through such agent.</p> <p>c. If it is considered necessary, the office can require the personal signature or presence of an applicant, opponent or party to such proceeding or matter.</p>	
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Chapter 22: Time Limits

22.01	Time limits Time limits for various actions while prosecuting a patent application and also for post grant procedures have been either specifically provided in the Patents Act or prescribed through the Patents Rules. These time limits are required to be followed strictly by every person concerned. Failure to adhere to the legally imposed time limits may turn out to be detrimental to the interests of the applicants, patentees or any other person interested.	
22.02	Petition for extension of time (1) Except for the time prescribed in clause (i) of sub-rule (4) of rule 20, sub-rule (6) of rule 20, rule 21, sub-rules (1), (5) and (6) of rule 24B, sub-rules (10) and (11) of rule 24C, sub-rule (4) of rule 55, sub-rule (1A) of rule 80 and sub-rules (1) and (2) of rule 130, the time prescribed by these rules for doing of any act or the taking of any proceeding thereunder may be extended by the Controller for a period of one month, if he thinks it fit to do so and upon such terms as he may direct. (2) Any request for extension of time prescribed by these rules for doing of any act or the taking of any proceeding thereunder shall be made before the expiry of such time prescribed in these rules.	Rule 138

22.03: Time limits prescribed by the Patents Act, 1970 and Patents Rules, 2003

S.N.	Description	Time	Provision
1.	Proof of right to make an application	Six months from the date of Filing of application	Section 7(2) Rule10
2.	Statement and undertaking Regarding foreign applications	Six months from the date of Filing of application	Section 8(1)(a) Rule 12(1A)
3.	Subsequent information Corresponding to foreign filing	Six months from the date of Filing of application outside India	Section 8(1)(b) Rule 12(2)
4.	Information relating to objections in respect of novelty, patentability etc. in foreign filing	Six months from the date of communication by Controller	Section 8(2) Rule 12(3)
5.	Filing a complete specification after filing provisional specification	Twelve months from the date of filling of the Provisional Specification	Section 9(1)
6.	Declaration of Inventorship (Form 5)	With the complete specification or within one month from the date of filing of the complete specification as the Controller may allow on an application made in Form-4	Rule 13(6)
7.	Reference to deposit of biological material	Three months from the date of filing of application	Section10(4) Rule 13(8)
8.	Convention application	Twelve months from the date of filing of the basic application	Section 135(1)
9.	Convention application (in case of multiple priorities)	Twelve months from the date of filing of first filed basic application	Section 135(1)
10.	Convention application (cognate)	Twelve months from the date of earliest filed application	Section 135(2)
11.	PCT national phase application	Thirty one months from the Priority date	Rule 20(4)(i)
12.	Priority document (for convention application)	Three months from the date of communication from the Controller	Section 138(1) Rule 121
13.	Publication of application	Ordinarily within one month from the expiry of eighteen months from the date of filing or priority date, whichever is earlier, or within one month from the date of request for early publication.	Rule 24, Rule 24-A
14.	Withdrawal of application to prevent publication	Fifteen months from date of Filing or priority, whichever is earlier	Section 11-A(3)(c)
	Request for withdrawal of application	Any time before the grant of Patent	Section 11-B(4), Rule 26
	Request for withdrawal and refund of Fee	In case withdrawal is requested after filing Request for examination but before issuance of FER, then fee is refunded as prescribed in the First Schedule	Rule 7(4A) , Rule 26

15.	Request for examination	Forty eight months from the date of filing or priority, whichever is earlier	Section 11-B Rule 24-B
16.	Request for examination, where secrecy direction imposed	Forty eight months from the date of filing or priority or within six months from the date of revocation of secrecy direction, whichever expires later	Rule 24-B(1)(iii)
17.	Request for examination (Divisional Application)	Forty eight months from date of filing or priority of first mentioned application, or within six months from date of filing of further application, which ever expires later.	Rule 24-B(1)(iv)
18.	Time within which Examiner makes report to Controller	Ordinarily within one month but not exceeding three months from the date of such reference	Rule 24-B(2)(ii)
19.	Controller disposes off the report of Examiner	Ordinarily within one month from the date of receipt of report	Rule 24-B(2)(iii)
20.	First Examination Report (FER) to be sent by the Controller to applicant	Within one month from the date of disposal of the report of examiner by the Controller	Rule 24-B(3)
21.	Time for complying with all requirements imposed by the Act	Six months from the date Of issuance of the FER	Section 21(1) Rule 24-B(5)
22.	Extension Time for complying with all requirements	Maximum extension up to three months can be availed only once, on a request made in Form 4 , if requested before the expiry of prescribed time under Rule 24B(5)	Section 21(1) Rule 24-B(6)
23.	Time, after publication, before Expiry of which no patent is granted	Six months from the date of publication	Rule 55(1A)
24.	Pre-grant opposition	Any time before the grant of patent	Section 25(1)
25.	Reply statement and evidence by applicant (pre-grant opposition)	Three months from the date Of notice of the Controller	Rule 55(4)
26.	Decision by Controller upon pre-grant opposition	Ordinarily within one month from completion of the proceedings	Rule 55(5)
27.	Notice of opposition (post-grant opposition)	Before the expiry of one year from the date of publication of grant of patent	Section 25(2)
28.	Reply statement by patentee	Two months from receipt of opponent's written statement	Rule 58(1)
29.	Reply evidence by opponent	One month from date of delivery of patentee's reply statement	Rule 59
30.	Opposition Board submits report	Three months from the date on which documents were forwarded to the Board	Rule 56(4)
31.	Periodical review of secrecy directions	Every six months	Section 36(1)
32.	Controller disposes permission	Within a period of twenty-one days	Section 39

	for filing abroad	from the date of filing of such request	Rule 71
33.	Time after which no permission is required for filing abroad	Six weeks after filing the application in India, where no direction for secrecy is imposed or application has not been referred to Department of Atomic Energy (DAE)	Section 39(1)
34.	Payment of due renewal fee, where patent has been granted after the expiry of two years from date of filing	Three months from the date of recordal in Register of Patents	Section 142(4)
35.	Extension in time for payment of renewal fee, where patent has been granted after expiry of two years from date of filing	Extendable by maximum six months	Section 142(4)
36.	Time for payment of the renewal fee	Before expiry of the nth year from date of patent in respect of the (n+1)th year	Rule 80(1)
37.	Extension in time for payment of renewal fee	Maximum six months	Rule 80(1A)
38.	Application for restoration of patent	Eighteen months from the date of cessation of the patent	Section 60
39.	Request for hearing by an applicant for restoration, where prima facie case has not been made out	One month from date of intimation by the Controller	Rule 84(2)
40.	Notice of Opposition against restoration	One month from date of publication of application for restoration	Rule 85(1)
41.	Payment of the unpaid renewal fee and additional fee when restoration allowed	One month from date of order	Rule 86(1)
42.	Notice of Opposition against an offer to surrender a patent	Three months from the date Of publication of offer	Rule 87(2)
43.	Notice of Opposition against application for post-grant amendment	Three months from the date of publication of such application	Rule 81(3)(b)
44.	Furnishing information relating to working of patent in respect of the calendar year	Three months from the end of each calendar year	Section 146(2), Rule 131 (2)
45.	Furnishing information relating to working of patent, upon notice of Controller	Two months from the date of notice	Section 146(1)