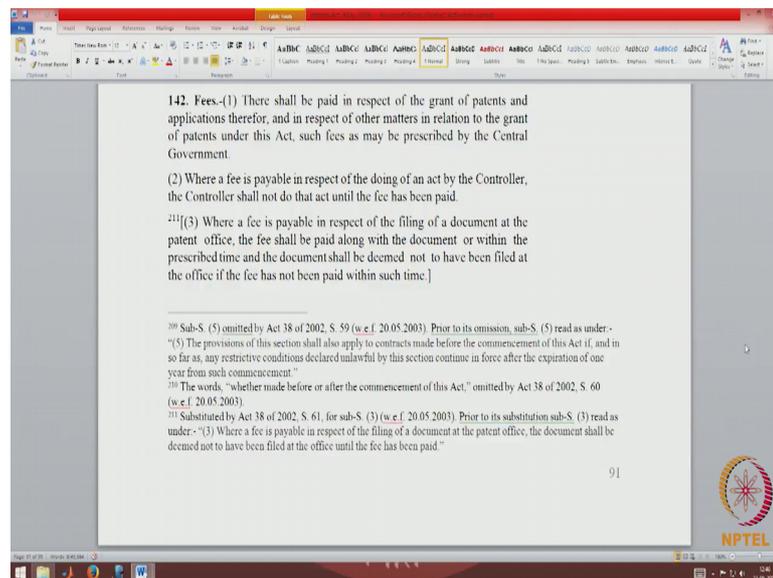


Patent Law for Engineers and Scientists
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Lecture - 78
Patent Enforcement, International Arrangements & Other Miscellaneous
Provisions
Fees

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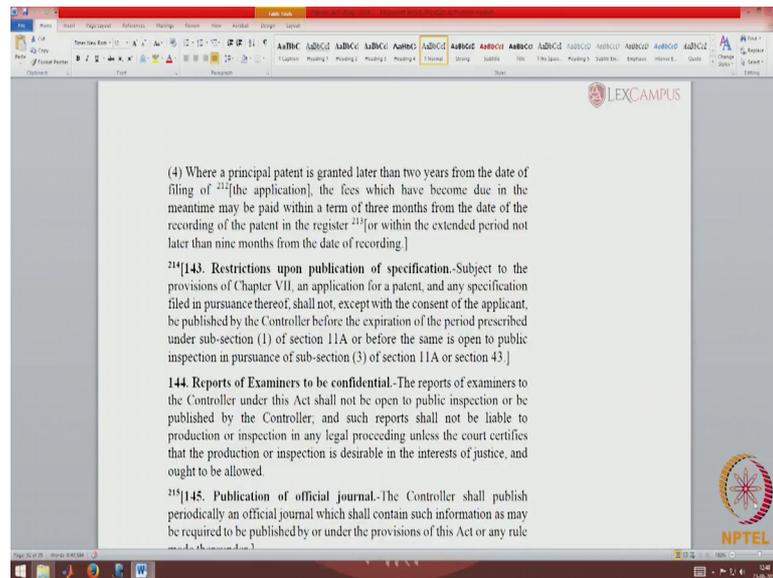
We had seen that for almost many of the things that you need to do before the patent office, there is a prescribed fee. And we had seen that in the act you saw various phrases like as may be prescribed or the prescribed fees and the details of those fees, we had already mentioned that you would find the details in the rules.

Section 142 tells us that there shall be paid in respect of grant of patents and application in respect of other matters, such fees as may be prescribed by the central government. So, the fee that has to be paid the official fee will be prescribed by the central government, and if fee is payable in respective doing of an act by the controller, the controller shall not do that act until the fee has been paid. So, unless the official fee is paid the patent office will not look into the matter.

And 3 tells us that where a fees is payable in respect of filing of a document, the fee shall be paid along with the document and within the prescribed time and the documents shall

deem not to have been filed at the patent office if the fee has not been paid. So, the controller the office will not do certain things if the fee is not paid if they are required to do certain things, they will not take the document on record unless the fee that is required to be paid along with the document.

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Now, 4 talks about a case where a principal patent is granted later than 2 years from the date of filing, the fee which have become due in the meantime maybe paid with an atom of 3 months, from the date of recording and the period of register or within the period extended not later than 9 months from the date of recording.

Now, this is a peculiar provision because when you file a patent application, you do not know whether the patent will get granted that all. There are many instances where a patent is file, the patent office may reject it or the patent is file and you decide down the line that there is no need to even file a request for a publication, and after 18months period when it gets published, the person who files a patent losses interest in that technology and he may not even file a request for examination.

So, it may get abandoned or it may get abandoned due to certain procedural access an s c r s filed, a reply is not given within the stipulated time. So, there are many conditions which could come into play for an application not materializing into a grant. So, the fee is payable or becomes payable, the renewal fee become payable only at the point of grant, but the life of a patent start from the date of filing the application.

So, there is an anomaly between the day on which the life of a patent starts, and the day on which the fee can be collected on a granted patent. So, the fee is always connected after the grant, but will cover the years that have passed in the process of grant. So, now, when you read 4 you will find that, where a principal patent is granted later than 2 years from the date of filing. After 2 years of filing the fee which has become due in the meantime, maybe paid with a term of 3 months from the date of recording the patent in the register which means three months from the date of grant, you have to pay the fee that becomes due. So, you actually go back in time. So, if the prosecution of a patent goes on for say 5 years or 7 years, then you will have to go back in time and pay the fee for from the date of the application because the patent right is for 20 years from the date of application.

So, this provision you can take some instances, you can look at a granted patent in the patent office go to the information on the granted patent, you can actually see the table on which the fees have been paid. For every application the patent office has a table showing when the fee has been paid and when it is due. So, you will find the first payment or comes after the grant, but it also covers the time period before the grant when the patent was not prosecuted.

So, 4 actually describes a case where the patent office can collect fees after the grant, but pertaining to years that were before the grant. The time between or let us put it this way the time between the date of filing of application and date of grant, the patent office has the right to collect the fees even for that period.

As I explained this is being done because the number of applications filed and the number of grants are very different, not every application file materialises into a grant. So, that is why the system structure not only in India even a broad, based on paying the back fees after a patent is granted.

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|⁴⁵THE FIRST SCHEDULE
(See Rule 7)
Table 1 – FEES PAYABLE

Number of entry	On what payable	Number of the relevant Form	For e-filing			For Physical Filing		
			Natural person(s) and/or Startup	Small entity, alone or with natural person(s) and/or Startup	Others, alone or with natural person(s) and/or Startup and/or small entity	Natural person(s) and/or Startup	Small entity, alone or with natural person(s) and/or Startup	Others, alone or with natural person(s) and/or Startup and/or small entity
1	2	3	4	5	6	7	8	9
1	On application for a patent under sections 7, 54 or 135 and rule 20(1) accompanied by provisional or complete specifications— (i) for each sheet of specification in addition to 30, excluding sequence listing of nucleotide and/or amino acid sequences under sub-rule (3) of rule (7)	1	Rupees 1600 Multiple of 1600 in case of every multiple priority. (i) 160	Rupees 4000 Multiple of 8000 in case of every multiple priority. (i) 800	Rupees 8000 Multiple of 8000 in case of every multiple priority. (i) 180	Rupees 1750 Multiple of 1750 in case of every multiple priority. (i) 180	Rupees 4400 Multiple of 4400 in case of every multiple priority. (i) 440	Rupees 8800 Multiple of 8800 in case of every multiple priority. (i) 880

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Now, fee is decided or stipulated in schedule one of the patent rules. Now you can see there are at least 2 broad categories of fees, there is e filing fee which is cheaper we can see that and there is a physical filing fee. Now there is a tremendous focus on e filing. So, e filing is the most preferred way and probably to incentivize e filing there is a small difference in the fee for e-filing. So, these are the two broad categories.

So, if you do e filing you follow a particular fee structure, and if you do a physical filing you follow a different fee structure. Now there are three categories under each of these two broad types. In e filing there are three categories three different fee structures and same for physical file. Now from e filing you could either be a natural person or a startup; then your fee is going to be in a particular level or that is first category.

The second category you could be a small entity along with the natural person on startup. So, if you are a small entity, small entity is defined or you are a small entity acting with natural person or a startup you have a the second layer or the second type of fees, then the third type of fee accrues on a person who does not fall into the first to category is not an natural person or a startup or small entity, then all body corporate companies organisations fall into this category. So, these are the three categories of fee and the same categories carry on even for physical filing. So, totally you have 6 categories of fees for anything that you could do before the party office.

Now, the form numbers are given. So, you can look at the form, form 1 if you are a natural person doing e filing 1600 is the fee that you have to pay, and for small entity its higher and for any entity other than a small entity and natural person it is even higher similarly for physical filing.

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	(i) 160 Subject to a Maximum of 25000	(ii) 400 Subject to a Maximum of 60000	(iii) 800 subject to a maximum of 120000	Not allowed	Not allowed	Not allowed
3. On filing a statement and undertaking under section 8	No fee	No fee	No fee	No fee	No fee	No fee
4. (i) On request for extension of time under sections 4(2) and 142(A), rules 136), 80(A) and 130, 138 (four months)	480	1200	2400	530	1300	2600
(ii) On request for extension of time under sub-rule (5) of rule 24B (four months)	1000	2000	4000	1100	2200	4400
(iii) On request for extension of time under sub-rule (11) of rule 24C (two months)	2000	5000	10000	2200	5500	11000
5. On filing a declaration as to inventorship under sub-rule (6) of rule 13.	No fee	No fee	No fee	No fee	No fee	No fee
6. On application for granting	800	2000	4000	880	2200	4400
7. On application for deferral of reference	800	2000	4000	880	2200	4400

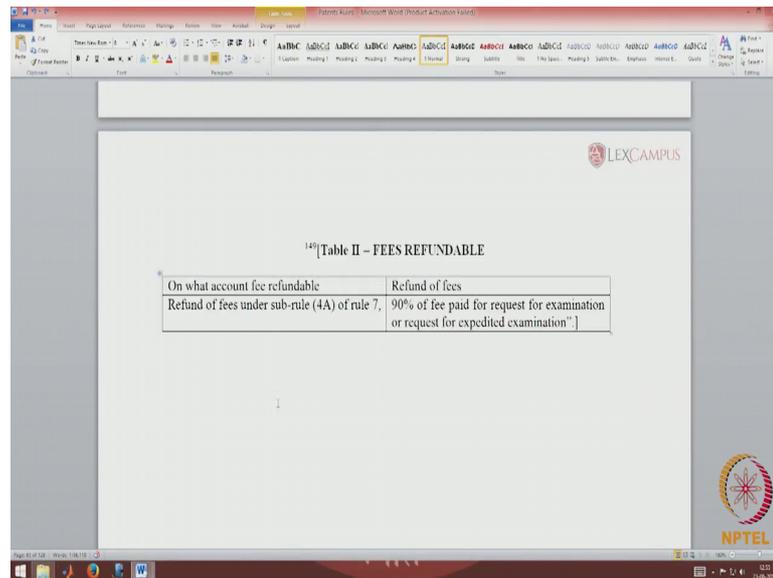
Now you have various entries here on different things and you could either go by search of the forms or you could go by the details at a given here.

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	(i) 160 Subject to a Maximum of 25000	(ii) 400 Subject to a Maximum of 60000	(iii) 800 subject to a maximum of 120000	Not allowed	Not allowed	Not allowed
16. On application for director under section 51(1) or 51(2)	2400	6000	12000	2650	6600	13200
17. On request for grant of a patent under sections 26(1) and 52(2)	2400	6000	12000	2650	6600	13200
18. On request for converting a patent of addition to an independent patent under section 55(1)	2400	6000	12000	2650	6600	13200
(b) For renewal of a patent under section 53—						
(i) Before the expiration of the 2 nd year from the date of patent in respect of 3 rd year	800	2000	4000	880	2200	4400
(ii) Before the expiration of the 3 rd year in respect of the 4 th year	800	2000	4000	880	2200	4400
(iii) Before the expiration of the 4 th year in respect of the 5 th year	800	2000	4000	880	2200	4400
(iv) Before the expiration of the 5 th year in respect of the 6 th year	2400	6000	12000	2650	6600	13200
(v) Before the expiration of the 6 th year in respect of the 7 th year	2400	6000	12000	2650	6600	13200
(vi) Before the expiration of the 7 th year in respect of the 8 th year	2400	6000	12000	2650	6600	13200

And you find all the renewal fees in entry 19, you will find the renewal fees when it becomes payable before the expiration of the second year from the date of the patent in respect of the third year. So, and you will find various other instances where the fees have to be paid.

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149] Table II - FEES REFUNDABLE

On what account fee refundable	Refund of fees
Refund of fees under sub-rule (4A) of rule 7,	90% of fee paid for request for examination or request for expedited examination"]

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Now, table two talks about the refund of fees. So, that the refund is can happen only in one case, where the matter has not been taken up for examination the patent office has not filed first examination report in such cases you can have a refund.

Now, apart from the first schedule, we also have the fifth schedule which deals with fees. Now the fifth schedule deals with fees pertaining to certain international arrangements.

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(1)	(2)	(3) regulations under the Treaty	(4) (In Rupees)	(5) either alone or jointly with Natural Person (In Rupees)
1.	Search fee	Rule 16.1(a)	2,500	10,000
2.	Additional fee under rule 19B(5)	Rule 40.2	2,500	10,000
3.	Protest fee under rules 19B(5) and 19J(5)	Rules 40.2(c) and 68.3(e)	1,000	4,000
4.	Preliminary examination fee	Rule 58.1	3,000	12,000
5.	Additional free under rule 19J(5)	Rule 68.3	3,000	12,000
6.	Preliminary examination fee, if the International Search Report was prepared by the Indian International Searching Authority		2,500	10,000
7.	Additional fee under rule 19J(5), if the international Search Report was prepared by the Indian International Searching Authority		2,500	10,000
8.	Handling fee to be paid to the ID	Rule 57	As specified in the Schedule of fee annexed to the regulations	

So, this is different from the schedule, but this pertains only to international arrangement under rule 19.