

ROADMAP FOR PATENT CREATION

PATENT FILING PROCEDURE IN INDIA

LECTURE 22

A very warm welcome in the second module of week 5 of the Course, roadmap for patent creation, titled "Patent filing procedure in India"

In this module we will see how the patent system works in India. So let us start So the first step is applicant will create a document that may be provisional specification or complete specification. This may be drafted by the patent attorney/agent or the applicant himself. He/she will file this specification in respective patent office as per the jurisdiction. Here also applicant himself/herself can visit the patent office and file the patent The other way is he/she may take help of agent. The other way is on behalf of applicant someone else can file the document. So it is not necessary that applicant or inventor himself should visit. The document with all the forms duly signed and the cheque of the requisite fee can be handed over to the officer in the patent office by anyone. We know in India four patent offices are present and for every patent office jurisdiction is fixed. So if anyone is filing the application physically kindly visit the patent office as per the jurisdiction. The other way is online filing. We have seen IP india site. There we have noted title, "comprehensive e-filing" through this anyone can file the patent online provided the applicant should have digital signature.

So in this way it can be physical filing or online filing. At the time of filing you have to give /upload all requisite forms. Then next is publication What is the meaning of publication. Here after 18 months the patent application will be published Bibliographic information, abstract, no. of claims and no. drawings this information will be published Published where In the official Gazette Where every friday the gazette will published Anyone can visit the IP india site and check the publications... On first page of the website you can see the title ' " Journal" You can click on it where you will get all publications Whether publication is automatic or any fees you have to give Publication is automatic after 18 months However, if anyone want to publish the patent application earlier then he/she has to give requisite statutory fee and file requisite form This filing also anyone can do physically or online Again follow same rules Check your jurisdiction So wherever application is filed in same patent office you have to file the request for early publication Again either applicant himself or anyone on behalf of applicant can file this request by giving the requisite forms and fees to the officer in the patent office Or any applicant can use online mode if she/he have the digital signature So this is the publication step.

The second step Now next examination Whether this is automatic or your require to give fees Here the applicant have to give the request for examination along with the requisite fees

Unless until this request is received by the patent office the application can not be considered for the patent examination. So here note publication that normal not express is automatic but the examination is not automatic Applicant has to file the request Here again same rules The applicant should fill the requisite form Draw a cheque of requisite a month and file the request for examination Again on behalf of applicant patent agent/attorney can do this Also on behalf of applicant any one can deposit the forms and fee in the patent office where the patent is filed Again fourth way is applicant can choose online route and can give online request for examination

So next question is if there is any timeline for this Yes The timeline is of 48 months So anyone who have filed a patent application then from priority date the time for filing the request for examination is 48 months If that timeline is not followed applicant will loose on the patent and patent may enter in public domain So again remember it is mandatory to follow the timeline diligently when anyone is dealing with patent Ok so patent is filed It is published Now request for examination is also filed Then Next is as per the workload your patent application will be queued up and then in due course it will be allocated to examiner.

Examiner is expert in the file So if the patent application is related to mechanical engineering then application will be allocated to the examiner who is expert in mechanical engineering If the patent application is related to chemistry then the patent application will be allocated to patent examiner who is expert in chemistry Thus in this way the patent application is now under examination Patent examiner will now do the thorough examination of your patent What it will include First examiner will check if the patent follow the criteria of patent What are these criteria Yes Do you remember Novelty Nonobviousness and Industrial applicability So as discussed in detail in earlier module Examiner will check the patent databases Other literature and check if your patent application and the claims you claimed in the document are novel

He will check the nonobviousness aspect and then the industrial applicability Along with this three main things He will also check the document in a view of other guidelines Which are these There are many such guidelines I will cite a few here The first whether the invention is not following in the category which are mentioned in section 3 What is this sections Here Section 3 of India patent act deals with inventions which are not patentable in India We have dedicated one module for this so we will see these details there The other thing examiner will check if the invention is not following under section 4..of Indian patent act Then the check will regarding earlier use of the patented information before filing So you might have noted if you have contacted attorney for patent filing He/she will ask you whether the product is in market.

If you say yes...he /she will refuse to file the patent as you have already brought the product in market.... So novelty aspect is not followed So such guidelines are there which will be checked by the examiner Ok next anything else examiner will examine Yes He/she will check the if there are any clerical mistakes Mistakes related to standard to be followed while filing the patent application So if such mistakes are there That will be noted Then he/she will check the drawings So if the application contains drawing sheets Then he/she will check the drawing sheet She/she will check if you have followed the guidelines while drawing the figures Also there are some standard guidelines that is paper size, labelling of drawing, writing the applicant name, writing information about the sheet And so on all such information will be checked by the examiner Then next step he/she will create the first examination report based on these all above mentioned observations And then the applicant receives this detailed report on examination Now a days everything is online

So you will get email from office and the first examination report will be there as an attachment to the email If you have asked for physical communication then you will also get the report through Indian postal service Okay So examination report is now in your hand Now applicant has to go through his report and give reply to report Is there any time line for this Yes Six

months So within six months applicant has to give reply to FER Here applicant himself can draft

the reply or again he can hire a attorney or patent agent for this draft Then you have to send this reply online or by physical filing So if physical filing then in the same patent office anyone on behalf of applicant or applicant himself can submit the reply to the examination. Okay so patent application Publication Examination Reply to examination Now what next Next is if examiner is satisfied by your reply So if your reply is sufficiently explains and clears all queries then examiner will accept the invention However, if he/she require further clarifications then there will be next step that is hearing So what is this hearing Hearing is the process where applicant have to visit patent office and answers the queries and explain the invention in much detail and clarify all queries raised by the examiner Now a days this step also you can do online

So through video conferencing the hearing will be conducted The other important thing is it is not necessary that the same patent office where you have filed the patent will issue the FER so as the system is centralised the FER will be issued any of the office and hearing may be at any of the four offices

So again here applicant himself or on behalf of him patent agent or patent attorney can present himself for hearing either physically or online. Ok After that now there can be three situations Examiner is totally satisfied by your clarification and he will grant the patent and proceed for advertisement accordingly Second you may not be able to establish the case and due to any of the reason like novelty issue, industrial applicability issue or like the patent will not be granted The third scenario will be Out of say 10 claims only 3 will be accepted and remaining 7 will be rejected Thus partial acceptance of the invention Here you have to then amend the application according and then resubmit Patent examiner will recheck the same and then after it will be accepted as partially accepted and then published according in the official gazette So the process started with application then publication then examination then FER and reply and then hearing Okay anything else is there

Yes there is system called opposition Now what is this In India there are two stages where opposition can be filed

1. Pregrant opposition
2. Post grant opposition

We will not in much details of that here But briefly I will explain it here Pregrant is the stage where patent is not still granted but it is published So here anyone who feel that this application should not be granted can file the request to patent office by filing requisite form this pregrant opposition The next is postgrant opposition So what is this? This is a process where the person skilled in art (phosita), you remember Right So the person who is skilled in that art So the invention if related to mechanical engineering then the person who is mechanical engineer can file the opposition on requisite form to the patent office with all the proofs supporting his oppositions and mention the grounds of opposition Now Again examiner will consider both these oppositions For post grant opposition is there any timeline Yes It is one year

So once the acceptance of the invention for grant is published in the official gazette then from that date one year is the timeline for postgrant opposition Remember here someone is challenging the patent examination.... So post grant opposition is very serious stage. Again if

opposition is dismissed the patent will be granted if opposition is upheld patent will not be granted Is there any further remedy in patent act if any party is aggrieved of the decision of patent examiner Yes there is that patent appellate board.

So whole this procedure takes almost 5 years to grant a patent But remember if your search report is positive while filing your patent then you need not to worry about this timeline Rather search report is positive or negative once you file patent you can start working on the invention About grant you will come to know at the end of 4 or 5 years and if you have opted express way may be in 2 year Remember you can execute your rights only if your patent is granted. So if there is any infringement then you get the right of action only after grant of the patent not before that We will not go in these details here Just check this procedure as Provisional or complete specification filing Then publication Then examination Then fee And then grant Then two oppositions As pregrant and post grant opposition Ok So let us watch this video... with this we come to the end of this session. See you in the next session

thank you!