21 March 2019

To:

OP Gupta

Controller General of Patents, Designs & Trade Marks

Boudhik Sampada Bhavan,

Antop Hill, S.M. Road, Mumbai-400037

A civil society submission on draft Manual of Patent Office Practice and Procedure, Version 3, published on 1 March 2019

Dear Mr. Gupta,

On behalf of the accessibsa project (www.accessibsa.org), the Médecins Sans Frontières Access Campaign (https://msfaccess.org/) and the Centre for Internet and Society (www.cis-india.org) , as well as numerous endorsing organisations and individuals across Indian Civil Society, we are pleased to present our comments, feedback and suggestions on the draft Manual of Patent Office Practice and Procedure, Version 3, published on 1 March 2019, to which your office invited comment from all stakeholders.

SUMMARY:

The Indian Patent Office (IPO) on 1 March 2019, published a draft of the "Manual of Patent Office Practice and Procedure, Version 3.0" (hereafter, the "Manual"). This draft extends upon the previous Manual, Version 01.11, dated 22 March 2011, which is currently the Manual in force.

At the outset, we should note that the current draft Manual does not differ substantially from the version in force. Aside from a few updations (for instance, noting the Indian Supreme Court decision in the Novartis case of 2013, as regarding Section 3(d) of Indian patent law), the current Manual under consideration is similar in most aspects to the Manual in force. However, given that several provisions in the current Manual in force were insufficient to implement Indian patent law as it was intended even in 2011, as well as the fact that there have been numerous developments in law, scholarship and practice since the time the Manual was last updated in 2011, we urge the IPO to take this opportunity to reflect upon the developments in patent law and practice, as well as the extensive scholarship now available to us.

Preamble: Indian patent law was substantially amended in 2005, and we began the process of implementing this law a few years later. Today, in 2019, we have data and evidence from almost 14 years of practice, and we suggest that the IPO fully incorporate all learnings available to us, to bring the full force of Indian patent law into effect, as originally intended. The Manual of the Patent Office has the potential to be a comprehensive handbook on implementing patent law for all stakeholders including patent agents,

applicants and the courts. The current version, in the manner proposed, is not. Our suggestions, if adopted in entirety, would make this so: furthermore, our suggestions provide a much-needed opportunity to correct course, by understanding and correcting the failures of the system to implement the original and far-sighted provisions in the Indian patent law amendment of 2005.

Overarching themes: Several of our suggestions for the current Manual under consideration are systemic, and, as such, require broad and serious attention to completely overhaul.

Structure: The Manual under consideration is badly composed and incomplete. Tabular columns are an inappropriate format for a patent manual. Furthermore and separately, the IPO makes use of several instances of "Guidelines" when examining patents. The IPO currently consults, among others, Guidelines for pharmaceuticals, biotechnology and computer related inventions. These guidelines are randomly categorized, badly deployed, hard to locate and amended haphazardly, without notice or any attention. There is no excuse for the IPO Guidelines to not form a part of the Patent Office Manual, thus giving them stability, and subjecting them to a transparent and participative process, like the rest of the Manual. Lastly, the Guidelines should evolve to covering the examination of Biologics as a distinct category, as we should with other frontier technology, such as Artificial Intelligence and Synthetic Biology.

Coherence: We have three inter-locking layers in the patent system in India: the patents act, the patent rules and the patent manual (which should incorporate the patent examination guidelines). The IPO is currently soliciting suggestions for the draft Patent Office Manual, while it has an ongoing amendment to the Patents (Amendment) Rules, 2018. We expect the final Rules to be published shortly; however, we are also being asked to provide suggestions on the Manual, without any knowledge of what the IPO's final version of the Rules will look like. (For instance, the Patent Rules have suggested a procedural change in how pre-grant patent oppositions will be conducted in India; however, since the Rules are not final, it is unclear how they integrate with the Manual, and how we can comment on the process, since the status of the Patent Rules remains unclear). Furthermore, the Manual makes no reference to the Rules. As such, the IPO should decide and publish a final version of the Rules, and only then solicit feedback on the Manual (which it could do in the current time by extending the date of feedback on the Manual). Regardless, the IPO must achieve coherence and cohesion between its many layers, including the patents act, the patent rules, and the patent manual. This coherence, if achieved, would allow the Manual to serve as a handbook for all stakeholders involved in the patent system, including serving as a basis for open-book exams for patent agents.

Updation: Patent law and practice are fast evolving fields. The IPO necessarily needs to keep up with the pace of technology, as well as evolving interpretations of existing patent law provisions. For instance, the Indian Supreme judgment in the Novartis case was announced in 2013; however, it has taken over 6 years for this important judgment to formally reflect in the work of the Patent Office Manual, despite being Indian law for these 6 years. The IPO, therefore, needs to update the Manual and the examination guidelines, frequently – at least as frequently as major events in technology and the law require.

Transparency & Accountability: In the current time, stakeholders in the Indian patent system, be they multinational corporations or ordinary members of Indian society, are faced with considerable challenges when attempting to view patent information. Despite the IPO having made information

available online for some years, the information on Indian patents is needlessly limited, often inaccurate, often incomplete, and frequently unavailable. On occasion, this is due to insufficient disclosure on the part of the applicant, but overwhelmingly, it is because the IPO is not well organized and insufficiently invested in transparency or accountability. For instance, mandating pharmaceutical patent applicants to provide an INN (International non-proprietary name) on all applications where the information is available, would invaluably assist in extending the transparency and utility of the IPO's functioning with the Indian public. Patent information in India is the right of every Indian citizen to have, and we have made several suggestions by which the IPO can move towards complying with our constitutional right to information.

Specific themes: Drawing from law, scholarship and practice over the last 14 years of Indian patent law, we strongly urge the IPO to consider these very specific suggestions on having their work comply with the spirit and letter of Indian patent law.

Focus on Biologics: Biologics are a relatively new category of therapy that have quickly become the world's most expensive medicines emerging as critical therapies in areas like cancer. 7 out of 10 of the world's best-selling medicines are biologics, and they will play only an increasingly important part in public health in India. Therefore, identifying, understanding and examining patent applications on biologics is of crucial importance to Indian citizens. The IPO would benefit from identifying biologics as a critical category; providing them their distinct field of invention; as well as developing guidelines and practices for evaluating biologics, along with other frontier technology that emerges.

Expedited examination: Since 2016, expedited examination of patents has been the law. More recently, there are reports that the IPO is considering PPH partnerships with some rich country economies such as Japan. This is unwise, especially since even in the extended examination currently underway, the IPO has faced several challenges. We strongly suggest that the IPO needs to evidence the ability to manage the ordinary processes in place with accuracy and compliance with Indian law, before attempting to expedite the said processes, especially since the non-functioning of the patents side of the Intellectual Property Appellate Board (IPAB) has meant that India has not had a corrective mechanism for any incorrect grants that may have been made at the IPO since May 2016.

Check exceptions to patentability first: The law, as has evolved in the Novartis Case in the Supreme Court, and the Roche vs Cipla case before the Delhi High Court, clearly points towards applying all exceptions to patentability under Sections 3 & 4 of the Indian Patents Act, first, before applying the test of patentability under Section 2 (1)(j). Such a procedure would make the work of the IPO more efficient, as well as fair.

Making anti-evergreening provisions work: The Manual currently does not capture the guidelines explicitly laid out in the Indian Supreme Court's judgment in the Novartis case. Specific principles relating to how to apply Section 3(d) were laid out in the judgment which have no reflection in the Manual. Like with Section 3(d), applicants also routinely circumvent other anti-evergreening provisions in Indian law, such as Section 3(e) and 3(i). Sometimes, these provisions are circumvented alone; other times, when combined, applicants take advantage of the confusion and adduce evidence on one ground, and then use that as a basis to circumvent the other grounds. To apply anti-evergreening provisions in Indian patent law efficiently and fairly, we suggest an anti-

evergreening checklist that will facilitate this process, and which we recommend be an official part of the examiner's report, both within the process and as a reported output.

Computer related inventions: The Manual currently does not adequately regulate Computer Related Inventions (CRIs). We suggest the introduction of a 3-step test to comprehensively regulate the patentability of mathematical methods, business methods, computer programmes and algorithms as laid down in the Indian Patents Act. Furthermore, we suggest ways in which the law can be applied more carefully within the Manual to detect camouflaging of claims, with an intent to confuse the IPO and Indian patent examiners, especially when conjoined to computer technology, by noting that (1) mathematical methods may sometimes be claimed as "technological development", (2) that business methods must be evaluated as such, regardless of their application through computers, computer programmes, computer networks or other programmable apparatus, and that (3) that the scope of algorithms needs to be extended to any invention where the function claimed to be performed can only be carried out by means of a computer programme.

Finally, while the nature of our comments and suggestions are deep and extensive, we are aware that we have also asked for the system to be evaluated in full, rather than in parts. As such, the Indian Patent ecosystem is large and complex, and the IPO has been engaged with setting the Patent Rules (under finalization), the Patent Office Manual (the subject of our commentary in this communication) as well as the Examining Guidelines (which we recommend move from being arbitrarily categorized and extended to becoming a formal part of the Patent Office Manual).

In order to comprehensively react to changes to the Indian Patent ecosystem, we require the opportunity to comment comprehensively on a range of inter-linked proposals.

In this spirit, we hope you will allow us – as civil society – to react, once more, to the Patent Rules (as connected to the Patent Office Manual) as well as each of the Examining Guidelines (old and new, i.e. including those intended such as for biologics), in the interests of fairness and transparency. We look forward to assisting you at every step of this process.

Thank you for your time. We trust that, as civil society researchers, activists and academics, who have devoted a considerable number of years towards the research of intellectual property, and the protection of public interests and human rights in India, our submission will be considered seriously and acted upon. We remain, of course, at your disposal, should you or your office have any questions – which we will gladly answer.

Sincerely,

Achal Prabhala, Feroz Ali, Ramya Sheshadri, Roshan John & Anubha Sinha

On behalf of the **accessibsa project** (www.accessibsa.org), the **Médecins Sans Frontières Access Campaign** (https://msfaccess.org/) and the **Centre for Internet and Society** (www.cis-india.org)

This submission is endorsed by the following institutions & individuals:

No	Name	Address	Contact Person
1	Third World Network	J 17, II Floor, Lajpat Nagar III, New Delhi	K.M. Gopakumar kumargopakm@gmail.com
2	Delhi Network of Positive People (DNP+)	A 1-5, H/No.141. Gali No.3, NEB SARAI (near IGNOU), New Delhi 1100 68	Loon Gangte dnpplus@yahoo.co.in
3	Drug Action Forum-Karnataka	57, Tejasvi Nagar, Dharwad, Karnataka-580003	Gopal Dabade drdabade@gmail.com
4	Mira Shiva	A-60, Hauz Khas, New Delhi	mirashiva@yahoo.com
5	S Srinivasan	I Tejas Apts, 53 Haribhakti Colony, Vadodara 390 007	chinusrinivasan.x@gmail.com
6	Malini Aisola	All India Drug Action Network, New Delhi	malini.aisola@gmail.com
7	Venkata Subramanian Raman	Patent Agent, Chennai	venkyiitm@gmail.com
8	Mudabbir Adnan	Patent Analyst, Chennai	mudabbiradnan@gmail.com
9	Govind Kumar	Patent Professional, Delhi	https://www.linkedin.com/in/91govindkumar/
10	Akash Palkar	Patent Professional, Hyderabad	https://www.linkedin.com/in/akash-palkar-54787267/

Explanation & Key

BLACK TEXT refers to undisputed text of the 2019 Draft Manual of Patent Office Practice and Procedure

HIGHLIGHTED TEXT refers to the specific sections of the Manual to which changes need to be made

RED TEXT refers to problems contained within the highlighted text, with explanations as to the nature and effect of the problem

GREEN TEXT refers to suggestions that can overcome the problems posed

BLUE TEXT refers to specific solution text that needs to replace the text highlighted in yellow

Specific sections of the Draft Manual that we suggest changes to:

Chapter 1, paras 2, 12
03.05.01
04.04
05.03.08
05.03.10
09.01.02
09.03
09.03.05.04
09.03.05.05
09.03.05.08
09.03.05.10
09.03.06
09.03.07
09.04

Specific additions to the Draft Manual we suggest:

Annexures

MANUAL OF PATENT OFFICE

PRACTICE AND PROCEDURE

Version 3.0

March 1, 2019

PUBLISHED BY:

THE OFFICE OF CONTROLLER GENERAL OF PATENTS, DESIGNS & TRADEMARKS

BOUDHIK SAMPADA BHAWAN, S. M. ROAD, ANTOP HILL,

MUMBAI (INDIA)

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 and 2017. India became signatory to PCT in 1998. Consequently, patent filing in India including National Phase applications under PCT has increased exponentially. Indian Patent Office is a major PCT applications 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 the 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 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 actical 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.

(O.P. Gupta)

Controller General of Patents, Designs and Trademarks

INDEX [Chapters with substantive changes are highlighted]

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 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 substantial uniformity and transparency in functioning. 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 uniform practices in the patent office.

Problem: Though the draft Patent Office Manual suggests that the public has access to the complete file wrapper related to a published patent application, this is not the reality. There are several problems: (1) The file wrapper frequently does not include all the information relating to the published patent application in question, for e.g. the FER (first examination report), Section 15 orders, Form 2 documents, and other relevant findings are often not made available in the file wrapper. (2) The file wrapper contains several individual documents that are connected to one particular patent application, but they are not available to download at one go, in a comprehensive file, as is the case with the European Patent Office (EPO) or several other patent offices in the world. (3) The inPASS website currently restricts users from downloading more than one entry at a time, by use of a "captcha" which physically prevents large format data downloading. While this may have been once intended as a security feature, in the present day, it is outdated and counter-productive (for instance, the USPTO and EPO, all allow for mass downloading of patent data, thereby making themselves more useful for researchers) - and actively prevents stakeholders in the patent system, especially in legal scholarship, from analysing the work of the IPO through mass data analysis. (4) The inPASS website, which relays IPO information to the public, does not have a feedback system to encourage users to report bugs, inconsistencies and errors. (5) Each of the 4 offices of the IPO follows a different naming structure for their uploaded files, which makes it difficult to search, locate and identify relevant documents.

Suggestion: (1) The IPO needs to re-evaluate its public publishing process to ensure quality control of information, as well as accuracy and cohesion of documents related to any particular application. (2) The IPO needs to institute a comprehensive download option for a user to download all relevant documents connected to one particular patent application in one go. (3) The IPO needs to immediately remove the "captcha" system it institutes on the inPASS website and actively encourage mass data analysis. (4) The inPASS system needs to immediately feature a feedback and bug reporting

process on each url/page of the website, by which the Indian public can report errors, and have them seen, processed and fixed by the IPO in real time. (5) The IPO must institute a uniform naming structure for all of the kinds of files it publishes on the inPASS website, as well as institute this uniform naming process across all its offices to ensure consistency and cohesion.

Solution: Replace highlighted text with the text below (specific changes underlined)

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 will be made available to the public in a manner that is (a) comprehensive, (b) error-free, (c) employs a feedback/correction mechanism to report and fix bugs, (d) amenable to mass data analysis without any special permissions involved, (e) and uses a uniform and consistent convention for file-naming across all Indian Patent offices, thereby promoting usability and transparency of the information published by the IPO.

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. Examiner and Controller of Patents on one side and Applicant/Agent and general public on the other are involved in the patenting process. This Manual explains rights, functions and responsibilities of all stakeholders so as to ensure smooth functioning of the patent system.

4. This manual is intended to spell out patent office practices and procedure and bridge any information gap that may currently exist in this regard. It is not intended to be an interpretation of the Indian Patent Law.

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 deal with the procedure for filing of patent applications including ordinary and PCT national phase applications, convention and PCT international applications, patent of

8. Chapters 9 to 11 relate to examination, grant, pre-grant and post grant oppositions.

9. Chapters 12 to 14 cover 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 specifically dealt with separately in Chapter 22.

12. The Officers functioning under the Act have been vested with statutory powers. They also have some discretionary powers under the Act, which are to be exercised judiciously. As regards the patentability of any subject matter under consideration by an Officer empowered under the Act, he shall not be guided solely by the contents of this manual but shall take judicious decisions based on the Act, Rules and judicial decisions on the matter. However, all officers of Patent Office shall follow the procedure set forth in the Manual.

Problem: For officers empowered by the Indian Patents Act, and engaged in examining patents at the IPO, it is imperative that they follow a fair, transparent and publicly available set of processes, that are – at the same time – up to date with current developments in Indian law and legal scholarship as relates to patents. By saying that officers of the IPO need not be solely guided by the Manual, in effect, this provides the entry of all manner of seemingly arbitrary lessons and decisions, which might not necessarily be consistent or fair.

Suggestion: The Patent Office Manual should be a central handbook and a central resource that is relied upon by all officers of the IPO in entirety. For the Manual to be such a resource, it needs to be updated frequently, as developments in the law, in legal scholarship and other related practice, necessitate. However, in the process of frequent updation of the Manual, the IPO also needs to be able to as frequently invite public opinion on proposed changes being made to the Manual.

Solution: Replace highlighted text with the text below (specific changes underlined)

As regards the patentability of any subject matter under consideration by an Officer empowered under the Act, she shall be guided primarily by the contents of this manual, which will consolidate not only the provisions of the Act and the Rules, but also – through frequent updates – judicial decisions and the evolving practice of the IPO on the matter.

Chapter 02: Key definitions

02.01	**General**	
	For better appreciation of this 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	"Controller" means the Controller General of Patents, Designs and Trade Marks referred to in Section 73 (1). 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 Patents Act, 1970. The Central Government may appoint examiners and other officers with designations as deemed fit, who 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. Controller shall be construed as including a reference to any officer discharging such functions of the Controller in pursuance of Section 73 (3). The Controller General has authorized Assistant Controllers, Deputy Controllers, Joint Controllers and Senior Joint Controllers to discharge most of the functions under the Act. The Controller General has the power to withdraw any matter pending before an officer, by an order in writing	Section 2(1)(b), 2(2)(a), and 73; Section 3 of Trademarks Act, 1999

	and for reasons to be recorded therein, and deal with such matter himself, either de novo 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 de novo or from the stage it was so transferred.	
02.02.02	"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
02.02.03	"Invention" means a new product or process involving an inventive step and capable of industrial application.	Section 2(1)(j)
02.02.03A	"New invention" means any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification, i.e. the subject matter has not fallen in public domain or that it does not form part of the state of the art.	Section 2(1)(l)
02.02.04	"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)
02.02.05	"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)

02.02.06	"Legal representative" means a person who in law represents the estate of a deceased person.	Section 2(1)(k)
02.02.07	"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)
02.02.08	"Patentee" means the person for the time being entered on the register as the grantee or proprietor of the patent.	Section 2(1)(p)
02.02.09	"Patent office" means the patent office referred to in section 74. Unlike many other Countries, for the purpose of facilitating the registration of patents, Indian Patent Office functions from four locations *viz.* Kolkata, Delhi, Chennai and Mumbai.	Section 2(1)(r), 2 (2) (b), 74
02.02.10	"Appropriate office" means the appropriate office of the patent office as specified in rule 4.	Rule 2(b), 4
02.02.11	"Person" includes the Government.	Section 2(1) (s)
02.02.12	"Person interested" includes a person engaged in, or in promoting, research in the same field as that to which the invention relates. (In the matter of 'Indian network for people living with HIV/AIDS' v/s 'Union of India' the Madras high court widened the ambit of "person interested" by including person/persons who has a concern for public interest in the area of public health and nutrition.	Section 2(1)(t)
02.02.13	"Prescribed" means prescribed by rules made under this Act.	Section 2(1)(u)
02.02.14	"Opposition Board" means an Opposition Board constituted under sub - section (3) of section 25.	Section 25 (3), 2(1) (la)
02.02.14	"Prescribed manner" includes the payment of the prescribed fee.	Section 2(1)(v)
02.02.15	"True and first inventor" does not include either the	Section

	first Importer of an invention into India, or a person to whom an invention is first communicated from outside India.	2(1)(y)
02.02.16	"small entity" means, - (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 (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. 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. 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. Explanation 3: The reference rates of foreign currency of the Reserve Bank of India shall prevail.	Rule 2(fa), Section 7 (1) (b) of MSME Development Act, 2006

02.02.17	"Startup" means (a) an entity in India recognised as a startup by the competent authority under Startup India initiative. (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. **Explanation**: In calculating the turnover, reference rates of foreign currency of Reserve Bank of India shall prevail.	Rule 2(fb)
02.02.18	"International Application" means an application for patent made with accordance with the Patent Co-operation Treaty.	Section 2(1)(ia)

Chapter 03: Filing of Patent Application

03.01	**Applicant** 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: True and first inventor True and first inventor 's assignee Legal representative of deceased true and first inventor or his/her assignee The term "person" as defined in the Patents Act includes Government. The term "person" as defined in the General Clauses Act, 1897 includes any company or association or body of individuals, whether incorporated or not. In the case of a limited partnership, the application may be in the names of all personally responsible partners. 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. The applicant is required to disclose the name, address and nationality of the true and first inventor(s). Assignee can be a natural person or a legal person such as a registered company, small entity, startup, a research organization, an educational institute or Government. Assignee includes assignee of an assignee also. Wherever, the inventor(s) is/are not the applicant, a proof of right to apply, by way of an endorsement in the Application form (Form 1) or an assignment deed, shall be submitted. Natural person means any individual or a group of individuals. Other than natural person includes a registered company, small	Section 6, 134, 135; Form-1

	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.	
03.01.01	**Procedure to be followed in case of death of applicant, or in case the legal entity ceases to exist- substitution or addition of applicant.** a. If the applicant dies before the grant of patent, a request may be made by a person who would, by virtue of an assignment or agreement made in writing, or by operation of law, be entitled to interest in the patent. If one or more of the joint applicant(s) die(s) before the grant of the patent, the survivor(s) may, with the consent of the legal representative of the deceased, request for proceeding the application in the name of survivor(s). b. This procedure is also applicable to a legal entity which has ceased to exist before the grant of patent as well as to joint applicants where one of the applicants has died. In all these cases, when a request is made in Form-6, the Controller may allow such substitution. However, in case of joint applicants, the substitution can only be made with the consent of all the other joint applicants. c. When there is a dispute between joint applicants regarding such substitution, the Controller, after giving opportunity of being heard to all the applicants, may give such directions as he thinks fit for enabling the application to proceed. Accordingly, the Controller may direct that the application shall proceed in the name of one or more of the parties. Such directions may also relate to the manner in	Section 20 Form-6

	which the application should proceed. Further, the Controller shall not issue any such direction unless: i. the invention is identified in the agreement or assignment by reference to the number of applications 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 sub-section (5) of section 20.	
03.02	**Jurisdiction** 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. An application for patent shall be filed with the Patent Office having appropriate jurisdiction. Territorial jurisdiction of patent office in respect of a patent application is decided based on any of the following: i. Place of residence, domicile or business of the applicant (first mentioned applicant in case of joint applicants) or, 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). 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.	Section 16, 74. Rule 4, 5.

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, Jammu and Kashmir, Punjab, Rajasthan, Uttar Pradesh, Uttarakhand, National Capital Territory of Delhi and the Union Territory of Chandigarh.
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.

The appropriate office for filing a divisional patent application is the office where the main application is filed.

An applicant is required to give an address for service in India including a postal address in India and an email address.

However, a patent agent shall also be required to furnish a mobile number registered in India and an email address. Such address for service shall be considered for all proceedings under the Act and Rules.

	Appropriate office in relation to International Applications under Patent Co-operation Treaty and National Phase Applications: (1) The receiving office, designated office and elected office for the purpose of International Applications filed under the Treaty shall be the appropriate office in accordance with Rule 4. (2) An International Application under the PCT shall be filed at and processed by the appropriate office in accordance with the provisions of Chapter III of the Patents Rules, the Treaty and the Regulations established under the PCT.	
03.03	**Types of Patent Applications** 1. Ordinary Application, i.e., an application which has been filed directly in the Indian Patent Office without claiming priority. 2. Convention Application. 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 patent application has already been filed or Patent has been granted.	Section 7, 16, 54, 135
03.04	**Filing of patent application** Every application for a patent shall be for one invention only and shall be filed in Form-1 along with Provisional/Complete Specification, accompanied with the prescribed fee as given in First Schedule, at an appropriate office. However, a provisional specification cannot be filed in case of Convention Application or application filed under PCT designating India (For further description of Provisional / Complete Specifications	Section 7, First Schedule

	refer Chapter 5). Normal fee shall be applicable for applications containing up to thirty pages in specification and up to 10 claims. If the specification exceeds thirty pages or claims are more than ten in number, additional fee as given in First Schedule is payable. 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. **E-Filing of Patent Application:** IPO has developed comprehensive e-filing system for patents, wherein, in addition to online filing of new applications, subsequent filing of all the documents has also been integrated. New and enhanced features of Comprehensive E –filing services include: • 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 (https://ipindiaonline.gov.in/epatentfiling/goForLogin/doLogin)	

03.04.01	**Documents required for filing Patent Application** **A patent application should contain:** 1. Application for grant of patent in Form-1. 2. A proof of right from the inventor(s) by way of endorsement in the appropriate column of Form-1 or as an assignment duly authenticated. It shall be filed within 6 months from the date of filing of the application in India. 3. Provisional / Complete specification in Form-2. Statement and undertaking under Section 8 (1) in Form-3: An applicant must file Form 3 either along with the application or within 6 months from the date of application. 4. Declaration as to inventorship shall be filed in Form-5 along with the complete specification filed after provisional specification. 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. 5. If an applicant is MSME/ Startup, Form 28, accompanied with appropriate evidence of being MSME/ Startup, shall be submitted in accordance with rule Rule 2(fa)/ 2(fb), respectively. 6. **Form of Authorisation:** The 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 along with Form 26 by the authorized Patent Agent. **7. Priority document is required in the following cases:** a. Convention Application (under Paris Convention).	Section 7. Rule 2(fa)/ 2(fb), Rule 8, 10, 12, 13, 135. Form-1, 2, 3, 5, 26, 28. Section 6 of Biological Diversity Act, 2002. Rule 17.1 of PCT Regulations

	b. PCT National Phase Application wherein requirements of Rule 17.1 (a or b) of regulations made under the PCT have not been fulfilled. The priority document should be filed along with the 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. 10. The Specification shall be signed by the applicant or his authorized person / 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. 11. If the application pertains to a 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. 12. The application shall disclose in the Specification the source of geographical origin of any biological material, when used in the invention.	
03.04.02	**Comprehensive E-filing:** E-filing Portal of Patent Office, available in the official website of Controller General of Patents, Designs & Trade Marks (www.ipindia.nic.in), provides a comprehensive platform for online submission of patent applications and subsequent forms in a secure and authenticated electronic way. Authentication of the 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. (List is given on website).	Rule 6

	Online payment of fees is effected through a payment gateway with all the prevalent major modes of payment, like Net banking, Credit Cards, Debit Cards or ATM Cards. The portal provides flexibility to applicants or their authorized agents to work from their premises on 24x7 basis, even on holidays. **Steps of e-filing:** 1. Visit –www.ipindia.gov.in and proceed to E-Gateways 2. Register for New User and creation of "userid" 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 6. Draft the new application or any subsequent forms 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 payment acknowledgement receipt would be generated. Submitted forms would then proceed to the respective section of the Patent Office for processing and official actions.	

03.04.03	**Leaving and serving documents at Patent Office** 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. A patent agent shall file, leave, make or give all documents only by electronic transmission duly authenticated, including scanned copies of documents that are required to be submitted in original. Provided that the original documents that are required 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. 3. If it 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. 4. In case of a postal delay, the Controller follows the provisions of the above paragraph with regard to the date of receipt of the document. 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	Rule 6

	to any applicant or opponent in any proceedings under the Act or the rules, at the postal address or 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. 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 in support of the statement: Provided that the 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. 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.	
03.04.04	**Receiving documents in Office:** 1. The application and any other documents with or without accompanying fees is received at the Patent Office at separate counters known as Fee Counter (FC) and Non-Fee Counter (NFC), respectively. 2. The fee bearing documents are sent to the fee counter and the non-fee bearing documents are sent to the non-fee counter. 3. 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. 4. The staff at the non-fee counter makes relevant entry in the document receipt module and stamps the documents 5. The documents from both the counters are sent on an hourly basis to the Electronic Data Processing (EDP) Section for digitization. 6. Documents requiring no digitization are sent to the	

	concerned section on daily basis.	
03.04.05	**Language and Paper size etc.** All documents and copies of the documents, except affidavits and drawings, filed with patent office, shall be - 1. Filed in 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. Filed on such paper which is flexible, strong, white, smooth, non-shiny, and durable of size A4 of approximately 29.7 centimetre by 21 centimetre 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. Filed with numbers in consecutive Arabic numerals in the centre of the bottom of the sheet; and 4. Filed with the numbering to every fifth line of each page of the description and each page of the claims at right half of the left margin. 5. Additional copies of all documents shall be filed at the appropriate office as may be required by the Controller. 6. Names and addresses of applicant and other persons shall be given in full, together with their nationality and such other particulars, if any, as are necessary for their identification. **Signature** 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.	Rule 9

03.04.06	**Sequence listing** If the application for patent discloses sequence listing of nucleotides or amino acid sequences, the sequence listing of nucleotides or amino acid sequences shall be filed in computer readable text format along with the application, and no print form of the sequence listing of nucleotides or amino acid sequences is required to be given. 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 noncoding 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). Any sequence listing in electronic form shall be contained within one electronic file encoded using IBM39 Code Page 437, IBM Code Page 93240 or a compatible code page to represent the sequence listing with no other codes included. Any sequence listing in the electronic document format as specified shall preferably be created by dedicated software such as PatentIn. (Reference: WIPO STANDARD ST.25 STANDARD FOR THE PRESENTATION OF NUCLEOTIDE AND AMINO ACID SEQUENCE LISTINGS IN PATENT APPLICATIONS URL: https://www.wipo.int/export/sites/www/standards/en/pdf/03-25-01.pdf)	Rule 9

03.04.07	**Fee:** 1. Fee payable under the Act in case of offline filing may either be 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. 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 is effected 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 duly authenticated copy 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	Section 142, Rule 7, First Schedule

	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 When an application is filed by a startup is fully or partly 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.: **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. 9. Where a fee is payable in respect of a document, the entire fee shall accompany the document. 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. 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. 8. Prescribed fee for various proceedings under the Act is given in First Schedule.	

03.05 **03.05.01**	**Processing of Applications** **Initial processing** 1. On receipt of an application, the Office accords a date and serial number to it. Requests for examination are accorded separate serial numbers. 2. Applications and other documents filed in physical form are digitized, verified, screened, classified and uploaded to the internal server of the Office. 3. Patent applications and other documents are arranged in a e-wrapper. 4. The Application is screened for: 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. Correct/complete abstract. If found not proper, the abstract will be amended suitably, 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. **Problem**: The dynamic utilities section of the inPASS website of the IPO show 23 fields of invention currently under employment. However, fields of invention are a category of technology, which is fast evolving, and as such need to keep up with the times, for instance, by including a category for biologics. **Suggestion**: Change the provision for allotting categories and fields of invention to be subject to changes in technology and society, by, for instance, including biologics as a distinct category. **Solution**: Replace highlighted text with the text below (specific changes underlined) Technical field of invention for allocation to an examiner in the respective field, as updated regularly, beginning with the inclusion of biologics as a distinct field of invention.	

03.05.02	**Numbering System for Applications** • **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	**i. Numbering Format for Request for Examination** • **Format: RYYYYJNNNNNN** • 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. **ii. Numbering Format for Request for Expedited Examination** • **Format: EYYYYJNNNNNN** Where, "E denotes Request for expedited examination under rule 24 (C)	
03.05.04	**Scrutiny of application** 1. The Office checks whether the Application has been filed in appropriate jurisdiction (see **03.02**). If the jurisdiction is not appropriate, the application shall not be taken on record and the applicant is informed accordingly. 2. The Office checks for Proof of Right to file the application (See **03.04**). If the proof of right is not filed along with the application, it 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. 3. 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. 4. Further, the Office checks whether: a. the documents are prepared on a proper sized paper, 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, e. whether, Authoristion 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. f whether, Form-5 has been filed, if required. g. whether the invention has been assigned to another person and 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.	
03.05.05	**Secrecy Directions and consequences thereof** 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, the Controller, issues secrecy directions prohibiting the publication of the application to the applicant and refers the matter to the Central Government for their consideration as to whether the application is prejudicial to the defence of India. 2. The Central Government, after considering the merits of the secrecy direction, may give notice to the Controller as to whether the secrecy direction needs to be continued or not. 3. The Central Government reviews the matter at an interval of	Section 35, 36, 37, 38

	six months. The applicant may request for a reconsideration of the secrecy direction and, if the same is found reasonable by the Controller, he may request the Central Government for a review. 4. 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). 5. So long as any directions under Section 35 are in force, the Controller shall not take a decision on grant/refusal of the application.	
03.05.06	**Inventions relating to Atomic Energy** 1. 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. 2. 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. 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 3. Upon screening, if an Application is found to be falling within the purview of the Atomic Energy Act, the Controller refers	Section 4 of the Patents Act, 1970; Section 2 of the Atomic Energy Act, 1962. S.O.61(E)

	the Application to the Central Government. 4. The Central Government upon consideration may issue a direction to the Controller, which is final. 5. The opinion of the Central Government is not open to an appeal.	
03.06	**Withdrawal of patent application** 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 writing. A request for withdrawing the application under sub-section (4) of section 11B shall be made in Form 29. 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. **Withdrawal and Refund of Fees:** 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.	Section 11A(3)(c), 11B(4), Rule 7(4A) and 26, Form 29, First Schedule

Chapter – 4: Publication of Application

04.01	**Publication of Patent Application** 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. b) At the end of 18 months period from the date of filing or from the date of priority whichever is earlier, the Application is published in the Official Journal except in the cases, where: 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 publication period, i.e., before the end of 15th month from the date of filing or priority, whichever is earlier. This will apply for PCT National Phase Applications as well, if such application has been filed in India before the expiry of 15 months from the date of priority. c) The Patent Office publishes the application in the official e-Journal, ordinarily within one month from the date of expiry of 18 months from the date of filing or priority, whichever is earlier. d) Where a secrecy direction has been given, the application will be published only when the secrecy direction is revoked, subject to the expiry of the 18- month period from the date of filing or priority. 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.	Section 11A, Rule 24

04.02	**Early Publication** a) A request for early publication may be made in Form-9 with the prescribed fee. b) The request for early publication will be considered if the patent application does not pertain to subject matter relevant for defence purpose. The application is published within one month from the date of such request.	Section11A(2), Rule 24A Form-9, First Schedule
04.03	**Particulars of Publication** The Patent Office Journal is published on every Friday with the following particulars: i. Application number ii. Date of filing iii. Title of invention iv. Publication date v. International Patent Classification vi. Name and address of the applicant vii. Name of the inventor(s) viii. Priority details like priority document number, number, date, country etc. ix. Reference to Patent of Addition /Divisional Application along with filing date of the parent Application. x. Abstract xi. No. of claims xii. Drawings (if any)	Section 11A
04.04	**Effects of Publication** 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, if such a request is filed.	Section 11A(6), Rule 27, 55(1A).

	Problem: The information published on any particular patent application on the inPASS website frequently does not include all the information relating to the published patent application in question, for e.g. the FER (first examination report), Section 15 orders, Form 2 documents, and other relevant findings are often not made available or are missing. **Suggestion**: Mandate a process re-evaluation, quality control, and a public feedback option by which the IPO can ensure quality, accuracy and cohesion of information, as well as the ability to have errors reported and fixed. Furthermore, there should be no difference between certified copies of the documents (available on payment from the IPO) and downloadable online information available on the inPASS website. **Solution**: Replace highlighted text with the text below (specific changes underlined) 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, if such a request is filed; ensuring consistency between what is available online, and what is available as certified copies on payment of a fee. b) After publication of the application for Patent, the depository institution will make the biological material, mentioned in the specification, available to the public. 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: Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been granted: d) No patent shall be granted before the expiry of six months from the date of publication of the application.	

Chapter - 5: Provisional and Complete Specification

05.01	**Specification**	
	The Specification is a techno-legal document containing full scientific details of the invention and claims to the patent rights. The Specification, thus, forms a crucial part of the Patent Application. **The Specification may be filed either as a Provisional or complete Specification.** Provisional or Complete Specification shall be submitted in Form-2 along with the Application Form-1 and other documents, in duplicate, accompanied with the prescribed fee as given in the First Schedule. The first page of the Form 2 shall contain: a) Title of the invention; b) Name, address and nationality of each of the applicants for the Patent; and c) Preamble to the description. Title of the invention shall disclose the specific features of the invention normally in not more than fifteen words. The applicant shall submit drawings, wherever required. 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. **Filing amendments in the specification:** 1) When amendments are made to a provisional or complete	Section 9, 10, 57, 59. Rule 13, 14, 24A, Form-1, 2

	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 shall be deemed to have been superseded and cancelled by the applicant.	
05.02	**Provisional Specification** a) When the applicant finds that his invention has reached a stage wherein 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 Provisional Specification. b) A Provisional Specification secures a priority date for the application over any other application which is likely to be filed in respect of the same invention being developed concurrently. 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 provisional specifications filed by an applicant are cognate or if one is a modification of the other, he may allow the applicant to file	Section 9, 11A(3)(b), 17

	one complete specification covering both the provisional applications. 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 application is the date of filing of the earliest provisional specification and shall bear the number of that application. [S 9 (2)] e) An applicant may, within twelve months from the filing of a complete specification (not being a convention application or a PCT National Phase Application), convert the same into a provisional specification. Consequently, the applicant has to file a complete specification within twelve months from the date of first filing. [(S. 9 (3)] f) After filing complete Specification, he may 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)), and request for post- dating of application to the Date of filing of the complete specification.	
05.02.02	**Contents of Provisional Specification:** A Provisional Specification is not a rough draft or a skeleton of the complete specification. A complete specification, which follows later, does not replace the Provisional Specification. Both are permanent and separate documents. a) A Provisional Specification shall essentially contain the title and description of the invention and shall start with a preamble: "The following Specification describes the invention". Claims should not be included in the Provisional Specification as the purpose of filing a Provisional Specification is to claim a priority date. b) The description starts from the second page starting with the field of invention and containing the background of	

	the invention, object of the invention and statement of the invention. c) It is advisable to include in the Provisional Specification as much information as the applicant has at the time of filing. d) It may be noted that a Provisional Specification cannot be filed in case of a Divisional, Convention or a PCT National Phase Application. In such cases, filing a Complete Specification is a mandatory requirement.	
05.03	**Complete Specification** The Complete Specification is a techno-legal document which fully and particularly describes the invention and discloses the best method of performing the invention. As the Complete Specification is an important document in the patent proceedings, it is advised that it should be drafted with utmost care without any ambiguity. It is mandatory on the part of an applicant to disclose fully and particularly various features constituting the invention. The disclosure of the invention in a complete specification must be such that a person skilled in the art should be able to perform the invention. **Important elements of the Complete Specification are discussed below.**	Section 10
05.03.01	**Contents of Complete Specification** Every complete specification shall: 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	Section 10(4)

	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; and e) be accompanied by an abstract. f) Irrelevant or other matter, not necessary in the opinion of the Controller for elucidation of the invention, shall be excluded from the title, description, claims and drawings.	
05.03.02	**National phase applications** 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. 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. (For further details of the PCT National Phase Applications, please see Chapter 7)	Section 10(4A), Rule 20(1)
05.03.03	**Title** 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.	Rule 13(7)(a)
05.03.04	**Field of the Invention and use of Invention** 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.	
05.03.05	**Prior Art and problem to be solved** This part should 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, 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 a closest prior art, known to the applicant.	
05.03.06	**Objects of the Invention** The purpose of this part is to clearly bring out the necessity of 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 "The principal object of this invention is……", "Another object of this invention is…… ", "A further object of this invention is……" etc.	
05.03.07	**Summary of the Invention** The description should include a summary of invention before giving the details of the invention and the method of performing it. The statement should clearly set forth the distinguishing	

	novel features of the invention for which protection is desired. This part is intended to declare different aspects of the invention.	
05.03.08	**Detailed Description of the Invention** 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. b) The details of invention described should be sufficient for a person skilled in the art to perform the invention without further experimentation. 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, in order to make the application complete, with the International Depository Authority under the Budapest Treaty, on or before the date of filing. 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/

- National Centre for Cell Science, Pune (NCCS)

  For further information on NCCS please visit - http://www.nccs.res.in/

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.

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.

i) Further, the source and geographical origin of the biological material specified in the Specification shall also be disclosed.

j) Access to the material in the depository institution is available only after the date of application of patent in India.

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.

	Problem: With regards to biologics, the patent claim, to be sufficient, needs to entail an enabling disclosure across the scope of the claim; without this, the patent claim might not satisfy the requirement of sufficiency. **Suggestion**: For any biologics patent claim to be valid, i.e. to satisfy the requirement of sufficiency, the claim should entail an enabling disclosure across the scope of the claim, and this specifically needs to be mandated and required by the Patent Office in order to evaluate said biologics. **Solution**: Add following text to the text highlighted above (specific changes underlined) l) For biologics claims to be sufficient, they must involve a provision for enabling disclosure across the scope of the claim.	

05.03.09	**Drawings** 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). b) Drawings shall be prepared neatly and clearly on durable paper sheet. 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. d) Drawings shall be on a scale sufficiently large to show the inventions clearly and dimensions shall not be marked on the drawings. e) Drawings shall be sequentially or systematically numbered and shall bear— 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. f) No descriptive matter shall appear on the drawings except in the flow diagrams.	Rule 15
05.03.10	**Abstract** 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. b) The abstract shall be so drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical field.	Rule 13(7)

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.

Problem: Patent applications in general, but especially for chemical compounds, are worded in technical language that is very complex, often making it impossible to ascertain which chemical compound is being referred to in a particular patent application. This in turn, makes it impossible for persons other than those with advanced technical expertise, to understand the scope of disclosure in a patent application, thereby decreasing the ability of stakeholders to participate in the work of the IPO and assess patent applications.

Suggestion: Patent information, especially when it comes to chemical compounds such as pharmaceuticals, must be readily available to people with minimal technical expertise, i.e. all stakeholders, including patient groups and public health professionals. If, however, the IPO insisted on the inclusion of commonly identifiers such as international non-proprietary names (INN) and those employed by the CAS Registry (Chemical and Abstract Services) and the International Union of Pure and Applied Chemistry (IUPAC) in abstracts related to chemical compounds such as pharmaceuticals, that would greatly improve the usability and transparency of the IPO's work with regards to public participation by all stakeholders.

Solution: Replace highlighted text with the text below (specific changes underlined)

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, as well as the commonly identifiable non-proprietary names and/or numbers.

c) The abstract may not contain more than one hundred and fifty words.

	d) 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. e) The Controller may amend the abstract for providing better information to third parties.	
05.03.11	**Best Method** 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.	Section 10
05.03.12	**Claims** 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 define the scope of legal protection, they should be drafted carefully to cover all the aspects of the protection being sought; at the same time adequately distinguishing the prior art from the claimed invention.	Section 10(4)(c)

05.03.13	**Unity of invention and clarity of claims** a) Claim(s) of a Complete Specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept. b) Claims shall be clear and succinct and fairly based on the matter disclosed in the specification.	Section 10(5)
05.03.14	**Significance of Claims** a) A claim is a statement of technical facts expressed in legal terms defining the scope of the invention sought 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 stands disclaimed and is open to public use, even if the matter is disclosed in the description. 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. 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. 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.	
05.03.15	**Scope of claims** 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. 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. c) Having many claims, where each claim has a different scope, allows the applicant to have a legal title to different aspects of the invention. A good drafting may begin with broad claims and develops towards claims that are narrower in scope. 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.	
05.03.16	**Structure of Claims** a) The description of invention in the complete specification is to be followed by a 'statement of Claims' preceded by the prescribed preamble, 'I / We Claim' as the case may be. b) Claims should start from a fresh page, after detailed description of the invention and should be serially numbered. c) Each claim should be in a single sentence and should be clearly worded. d) A claim should not be verbose. e) There is no restriction as to the number of claims that can be incorporated in the specification. Applicant has to pay additional fee, if total number of claims are more than ten. f) Each claim should be fairly based on matter disclosed in the specification. This means that all the characteristics of the	

	invention that form part of the Claims must be fully explained in the description. g) A claim should be clear in the sense that it should not cause the reader to speculate. For example, if words like 'thin', 'strong', 'a major part', 'such as', 'when required' or 'any' are used, the reader may make a subjective judgment unless such expression follows some definite value. h) 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. i) In Addition, any term which is used in the claim, must be either found in the description or fairly inferred from the description. j) 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. Where Marks that are registered are mentioned, they should be acknowledged as such. If a Trade Mark is not registered, its owner should be indicated. k) A Claim usually consists of three parts: - Preamble, - Transitional phrase; and - Body. l) An introductory phrase identifies the category of invention and sometimes the purpose (for example, a machine for waxing paper, and a composition for fertilizing soil). m) The transition phrase may be words and phrases such as: - comprising of	

	- including - consisting of - consisting essentially of n) If the invention is an improvement on a product or a process existing in the prior art, the invention should be distinguished very clearly by characterizing the claim with respect to the prior art. In such cases, the claim will have two parts separated by the word 'characterized by' or 'wherein'. o) The first claim is always an independent claim also known as 'Principal Claim'. It should clearly define the essential novel features of the most preferred embodiment of the process/product that constitutes the invention. The claim may 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, operation or utility to establish that the invention achieves the intended objectives. p) 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 application so that the claims are all of cognate character and are linked so as to form a single inventive concept. Inclusion of multiple independent claims directed at non- cognate aspects of the claimed invention is not desirable. If claims relate to a plurality of distinct inventions, it may be objected on ground of lack of unity of invention. q) Further independent claims are justified where the single inventive concept covers more than one category e.g. process, product, complementary versions within one category e.g. plug and socket, transmitter and receiver,	

	which work only together. r) A dependent claim derives antecedence from an independent claim and reads into it the features of the independent claim and may contain additional non-essential features and even the minute aspects and optional features. For example: - A wrapper as claimed in Claim 1, wherein a narrow area of the tear tape, spaced from each edge of the tear-tape, is united to a narrow area of the wrapper defined on each side by a line of perforations which are covered by the outer portions of the tear-tape, the perforations facilitating tearing of the wrapper to remove the portion bounded to the tear-tape. - A gramophone record according to Claim 1, wherein the percentage of filler employed in the record is from 1 to 70 per cent. - A tool according to Claim 1, wherein the means for guiding the tool and facilitating the removal of the waste metal and the means for preventing the distortion of the spindle comprise two separate plates slidable and removable mounted on the spindle. s. A claim which is unsearchable due to number of alternatives embraced or the choice of characterizing parameters should be avoided. t. 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. s) 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. As such	

	omnibus claims are unclear, vague and unsearchable, and hence, it is desirable to avoid omnibus claims in a patent application.	
05.04	**Priority of a claim** Each claim of a complete specification shall have a priority date. If the 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.	Section 2(1)(w), 11
05.04.01	**Priority dates- General** 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. 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. c) When a complete specification is converted into a 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. 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. 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	Section 9, 11

	the claim shall be the date of the later filed Specification. 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. g) A claim in a complete specification of a patent shall not be invalidated by the reason only of: 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	**Divisional application** In case of a Divisional Application, priority date of the claim(s) is the date of filing of the first mentioned application.	Section 11(4)
05.04.03	**Convention application** 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.	Section 11(6), 135
05.04.04	**Effect of Priority Date of a Claim** 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.	Section 11(8)

Chapter- 6: Divisional Application and Patent of Addition

06.01	**Divisional Application**	
06.01.01	**General** 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 divide the application and file further application(s) in respect of invention disclosed in the provisional or complete specification already filed. 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. The whole patent family, in such cases, is available to the Examiner on the official database. 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. 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 National phase application under PCT. No divisional application can be filed, the claims of which is/are identical to claims of the parent application (first mentioned application).	Section 16(1)
06.01.02	**Contents** A Divisional Application(s) shall be accompanied by a Complete Specification and shall not include any matter not in substance	Section 16(2), 16(3)

	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.	
06.01.03	**Priority** 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 of 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: 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	**Appropriate office** The divisional application shall be filed at the appropriate office of the first mentioned application only. **[Rule 24B(2) for reference to Examination]**	Rule 4
06.01.05	**Reference** The Complete Specification accompanying the Divisional Application shall contain a specific reference to the original application from which the divisional application is made.	Rule 13(2)
06.01.06	**Fee** For all purposes under the Patents Act, the Divisional	Section 16

	Application is treated as a substantive application and, hence, all fees applicable to a patent application, shall be payable.	
06.02	**Patent Of Addition**	
06.02.01	**General** 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. 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. c) A Patent of Addition shall be granted only after the grant of the main patent. 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. e) There is no need to pay separate renewal fee for the Patent of addition during the term of the main patent. 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. g) Date of filing shall be the date on which the application for patent of addition has been filed.	Section 54, 55
06.02.02	**Novelty and inventive step** An application for Patent of Addition cannot be challenged on the ground of lack of inventive step with respect to the	Section 56

	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. In the matter of **Ravi Kamal Bali v/s Kala Tech (2008 (110) Bom L.R. 2167) 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. **Correction**: Highlighted text includes full citation, which was not previously mentioned.	
06.02.03	**Reference** 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.	Rule 13(3)

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

07.01	**Convention Application**	
07.01.01	**Paris Convention and WTO Agreement** 1. Paris Convention of 1883 provides reciprocity in filing with the right of priority. India became member of the Paris Convention in 1998. 2. India became a member of WTO Agreement in 1995 and member of Patent Co-operation Treaty in 1998. 3. India is a member of Budapest Treaty (2001) on the International recognition of the deposit of micro-organism for the purpose of patent procedure (1977) and provides a mechanism for depositing biological material in the internationally recognized depository authorities for the purposes of supplementing the description of a Specification.	Section 133
07.01.02	**Convention Country** 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. At present, India is a member of WTO and a member country in the Paris Convention and a contracting state to the PCT. Any country, union of countries or inter-governmental	Section 2(1)(d), 133, 134

	organizations, which are members/contracting states to the above convention/ treaty/ agreement, are convention countries for the purposes of the Act.	
07.01.03	**Convention Application** a) Where a person has made an application for 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 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. 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. 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.	Section 135
07.01.04	**Documents to be submitted** Every convention application shall: a) be accompanied by a complete specification;	Section 136, 138. Rule 121

	b) an abstract; c) specify the date on which and the convention country in which, the application for protection, or as the case may be, the first of such applications was made; and d) 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. e) include claims in respect of developments or, additions to, the invention in respect of which the application for protection was made in a Convention country. f) If the Controller requires, a certified copy of the priority document has to be filed within 3 months from the date of communication by the Controller, of such requirement. If the priority document is in a language other than English, a verified English translation shall be submitted.	
07.01.05	**Multiple priorities** 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. b) The priority date of a claim is the date on which the matter was first disclosed in a patent application.	Section 135(2), 137
07.01.06	**Other conditions** a) The term of patent of a convention application shall be twenty years from the date of filing of the Application in India. b) A Convention Application can be divided, and the divided Application shall have the same priority date.	Section 136, 139

	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 application could have been made under the provisions of this Act.	
07.02	**International Application under PCT**	
07.02.01	**PCT International application by Indian applicant** An Indian applicant can file a PCT International application in the following manner: i. If the international application is filed before 6 weeks from the date of the priority in India, the foreign filling permission under section 39 has to be procured from the appropriate patent office. ii. If the international application is filed directly at RO/IB or RO/IN, foreign filling permission under section 39 has to be procured from the appropriate patent office. If the applicant fails to procure the foreign filling permission under section 39, the application will not be considered as international application. 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.	Section 39, 118, Rule 4
07.02.02	**Indian Patent Office as Receiving Office and requirements:** **1. Online filing:** 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 DIPP certificate in case of startup for claiming fee reduction in	Section 2(1)(ia), 7(1A), 39 PCT/RO/101

	transmittal and priority fees. **2. Offline filing:** a) 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 (Incase of agents), MSME Certificate in case of small entity OR DIPP certificate in case of start up for claiming fee reduction in transmittal and priority fees. Foreign filing permission should be submitted as per requirement. a) 90% Fee reduction, in case of International filing fees, for natural persons can be availed only if the nationality and residence of the applicant is India. b) In case the search authority is ISA/US, the applicant has to submit the following documents. ➢ Micro entity certificate in form 15A of USPTO for claiming micro entity fee reduction. ➢ Small entity assertion/declaration for claiming small entity fee reduction. ➢ In USA, Universities are automatically considered as small entity and hence applicant can avail search fee reduction by mentioning the same in RO/101. **International Bureau as Receiving Office** An international patent application can be directly filed in 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 an application may also be filed electronically.	

07.02.03	**Functions of Indian Patent Office as Receiving Office** • **<u>Receiving office (RO) –Receives the International Application (IA) and does the following verifications:</u>** ✓ 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 not satisfied, IA is referred to IB for further processing. ✓ Accords or refuses international filing date(Article 11(1)) • Checks the technical elements of International application. The application must contain at least: ✓ 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) ✓ 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)	Section 35, Article 3, 4, 11, 14, 16 of PCT. PCT Receiving Office Guidelines

	• Specifies the *International Searching Authority* • Specifies *the International Preliminary Examining Authority* • 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 and Rules 22.1 and 23.1) • Forwards and receives correspondence from applicants and the international authorities • Establishes priority documents of PCT applications filed with it (Rule 21.2) • **COMPETENT INTERNATIONAL SEARCHING AUTHORITIES (ISAs) (Article 16, Rule 35*)*** ✓ INDIAN PATENT OFFICE (IN) ✓ AUSTRIAN PATENT OFFICE (AT) ✓ AUSTRALIAN PATENT OFFICE(AU) ✓ EUROPEAN PATENT OFFICE (EP) ✓ CHINESE INTELLECTUAL PROPERTY OFFICE (CN) ✓ UNITED STATES PATENT & TRADEMARK OFFICE(US) ✓ SWEDISH PATENT OFFICE (SE) Updated Information is available on WIPO Website (www.wipo.int) • **Fees payable to the receiving Office (RO)** ➢ **transmittal fee** ➢ **international filing fee** (for IB) ➢ **search fee** (for ISA) ➢ **supplement per sheet in excess of 30** (for IB) ➢ *fee for priority document* (Now can be paid through WIPO DAS)	

<table>
<tr>
<td></td>
<td>

late payment fee
late furnishing fee (translation of international application)
fee for copies of documents

(Fees indicated in italics are to be paid only as per instructions from RO

Intimation of Fee payment: RO /102

After request is filed, the Fees to be paid towards International filing, search, priority and transmittal fees are calculated by RO.
Demand letter (PCT/ RO/102) issued

Demand letter (PCT/ RO/102) with the INR equivalent towards calculation of IB fee and a mode of payment letter is dispatched to applicant (hardcopy/email) on the same day by RO.

</td>
<td></td>
</tr>
<tr>
<td>07.02.04</td>
<td>
<u>PCT Fee (may vary from time to time)</u>

All PCT fees are subject to change periodically. For latest fees, please refer the latest PCT newsletter at URL www.wipo.int.

<table>
<tr><td>International Filing Fee</td><td></td><td>USD 1,366 **</td></tr>
<tr><td>Search Fees</td><td></td><td></td></tr>
<tr><td>(AT)</td><td></td><td>USD 2,202***</td></tr>
<tr><td>(AU)</td><td></td><td>USD 1,631</td></tr>
<tr><td>(CN)</td><td></td><td>USD 309</td></tr>
<tr><td>(EP)</td><td></td><td>USD 2095***</td></tr>
<tr><td>(SE)</td><td></td><td>USD 2095***</td></tr>
<tr><td>(US)</td><td></td><td>USD 2080
For small entity
USD 1,040
For micro entity:</td></tr>
</table>
</td>
<td>Rule 16bis of

Regulations under the PCT</td>
</tr>
</table>

			USD 520		
	(IN)	INR 10000 INR 2500*	USD 153 USD 38*		

- The applicant can make payment towards IB fee and ISA (except ISA/IN) fees 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 payment subsequently to IB and ISA and also intimate the same through e mail to all International authorities.

07.02.05	**International Search** 1. International Search report is established by the International Searching Authority designated by the applicant in International Application. The International Searching Authority provides a written opinion on patentability along with the 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	Article 15, 16, 17, 18, 19 of PCT.

	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 Examining Authority (IPEA) at the meeting of the General Assemblies of WIPO held in September – October, 2007. 6. The Indian Patent Office started functioning as an International Searching Authority (ISA) and an International Preliminary Examining Authority (IPEA) from October 2013.	
07.02.06	**Withdrawals in International Application**	
	Withdrawal of Application 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	Article 8(1), 20(1), 21(2)(a),

	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. **Withdrawal of Designations** 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 the 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 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	23(2), 39(1), 40(2) of PCT. Rule 4.15(b), 45*bis*.8, 53.8(b), 90*bis*, 90.2(b) of Regulations under the PCT.

	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 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 90*bis*3, 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 90*bis*.3*bis*, 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 90*bis*.3*bis*, 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 the 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 90*bis*.1 to 90bis.4 shall, subject to paragraph (b) of PCT Rule 90bis.5, 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, subject to paragraph (b), will not be entitled to sign such a notice on behalf of the other applicants. 2. Where two or more applicants file an international application which designates a State whose national law requires that national applications be filed by the inventor and where an applicant for that designated State who is an inventor could not be found or reached after diligent effort, a notice of withdrawal referred to in Rules 90bis.1 to 90bis.4 need not be signed by that applicant (the applicant concerned) if it is signed by at least one applicant and i. a statement is furnished explaining, to the satisfaction of the Receiving Office, the International Bureau, the Authority carrying out the supplementary international search or the International Preliminary Examining Authority, as the case may be, the lack of signature of the applicant concerned, or ii. in the case of a notice of withdrawal referred to in Rule 90*bis*.1(b), 90*bis*.2(d), 90*bis*.3(c) or 90*bis*.3*bis*(b), the applicant concerned did not sign the request but the requirements of Rule 4.15(b) were complied with, or iii. in the case of a notice of withdrawal referred to in Rule 90*bis*.4(b), the applicant concerned did not sign the demand but the requirements of Rule 53.8(b) were complied with. **Effect of Withdrawal** 1. Withdrawal under Rule 90bis of the international application, any designation, any priority claim, the demand or any election shall 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). 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**	
	Significance 1. International Preliminary Examination is useful in many ways. It 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 and foreign Agents 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. **International Preliminary Examining Authorities** For an Indian Applicant, the following are competent International Preliminary Examining Authorities (IPEAs): 1. Austrian Patent Office (AT)	Article 33, 34, 35, 17(2)

	2. Australian Patent Office (AU) 3. European Patent Office (EP) (Only if ISA was AT, EP or SE) 4. China Intellectual Property Office (CN) 5. United States Patent & Trademark Office (US) 6. Swedish Patent Office (SE) 7. Indian Patent Office (IN) Updated Information is available on WIPO Website (www.wipo.int) **Demand for International Preliminary Examination** 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, 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 the payment of the prescribed fees within the prescribed time limit. 4. The demand for International Preliminary Examination has to be made: 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. The fees to be paid by the applicant is given in the PCT Newsletter which is available on the WIPO website, www.wipo.int.	

07.03	**PCT National Phase Application**	
07.03.01	**General** 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 months from the priority date. However, this time limit may be increased through National Laws by each member Country. 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. 2. For making a national phase application before a Designated Office, the applicant shall: a. pay the prescribed national fee; and b. file a duly verified translation of the basic application, if necessary. 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. 4. The international filing allows the preservation of priority from the date of filing of first application in the convention country.	Article 22, 23 of PCT Rule 20 of The Patent Rules, 2003
07.03.02	**Basic Requirements to enter National Phase in India** 1. The applicant has to file the National Phase Application within 31 months from the priority date or International Application date, whichever is earlier. The application with respect to the National Phase Application may be made in Form -1. 2. The jurisdiction of filing is the same as that of the ordinary Application. Address for service in India shall be filed.	Rule 14, 20, 21

	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 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 Application on the date of filing in India. 6. If the applicant makes an amendment for 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 in accordance with the provisions contained in Rule 14, 8. In case of a change in applicant, if the change has occurred after the international filing date and has not been	

	reflected in a notification from the International Bureau (Form PCT/IB/306), the change may be effected by filing Form 6 and/or Form 13, 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 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. 10. However, if the applicant has not complied with the requirements of rule 17.1 paragraph [a or 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. 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. 12. All other formalities that are required for filing and processing an ordinary patent application shall apply to a National Phase Application.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 processing before 31 months, in Form 18 under Rule 20 (4)(ii). 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 may do so	

	after filing express request under Rule 20 (4)(ii).15. International Application filed under the PCT designating India is considered as a Convention Application under Section 135 for which the filing date is the date of International Application.	

Chapter - 8: Indian International Searching Authority and Indian International Preliminary Examination Authority

08.01	**India as ISA/IPEA** The Patent Cooperation Treaty, the international patent filing system, administered by the World Intellectual Property Organization (WIPO) provides the applicants from member countries, a facility for filing single international application for grant of patent in 152 countries of the world. 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. The Indian Patent Office was recognized as an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) under the PCT and, accordingly, started functioning from 15th October 2013 as ISA and IPEA. As per requirement for ISA/IPEA IPO has access to the comprehensive collection of patent and non-patent literature 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 . Fully electronic processing system ensures speedy disposal and dissemination of information on real time basis.	
08.02	**Applicants in ISA/IPEA** The applicants of PCT International Applications who are	

	nationals/residents of India and Iran can select the Indian Patent Office as ISA/IPEA. The type of Indian applicants choosing IPO as ISA/IPEA include individual inventors, Start-ups, premier 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.	
08.03	**Indian International Searching Authority** 1) The Patent Office, Delhi performs the functions of the Indian International Searching Authority under the treaty in accordance with an agreement between the Indian Patent Office and the International Bureau. 2) The fees payable to the Searching Authority includes the 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.	Rule 19A
08.04	**International search report** 1) The Searching Authority, on receipt of the search copy, notifies the 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	Rule 19B

	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(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 notifies the applicant and the International Bureau that no international search report has been established. 4) In a case where any situation referred to in clause (a) or clause (b) of rule 19 (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 for 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 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 the 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. 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. 10) Where the applicant has not paid the 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. 11) The protest fee is refunded to the applicant where the	

	Review Committee referred to in sub-rule (8) finds that the protest was entirely justified. 12)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 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.	
08.05	**Time limit for establishing international search report** 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.	Rule 19C
08.06	**Transmittal of International Search Report and written opinion** 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.	Rule 19D
08.07	**Confidential treatment** All matters pertaining to international applications are kept confidential in accordance with the treaty and the regulations under the Treaty.	Rule 19E

08.08	**Indian International Preliminary Examining Authority** 1) The Patent Office, Delhi branch performs the functions of the International Preliminary Examining Authority under the Treaty in accordance with an agreement between the Indian Patent Office and the International Bureau. 2) The Examining Authority establishes- a) the International Preliminary Examination Report in respect of all international applications electing India as an International Preliminary Examining Authority; 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; 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.	Rule 19F
08.09	**Period for making a demand** 1) The demand for international preliminary examination is made within the period specified in the Treaty or regulations under the Treaty. 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 is prepared.	Rule 19G
08.10	**Fees payable to Examining Authority** 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.	Rule 19H

08.11	**Manner of making a demand** A demand shall be made in accordance with the provisions contained in the rules, the Treaty and the regulations under the Treaty.	Rule 19I
08.12	**Processing of demands for international preliminary examination** 1) 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. 2) 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.	Rule 19J
08.13	**International Preliminary Examination Report** 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-	Rule 19K

	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, the claims, or the 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, 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. 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: 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. 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. 7) The examination of the protest is carried out by a Review Committee constituted by the Controller. 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. 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.	
08.14	**Period for establishing international preliminary examination report and its transmission** The period for establishing the International Preliminary Examination Report shall be: 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	Rule 19L

	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	**Transmittal of International Preliminary Examination Report** 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.	Rule 19M
08.16	**Conditions for and extent of refund** 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.	Rule 19N

Chapter- 9: Examination & Grant

09.01	**Request for Examination** 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. 3) 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 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. In the matter of **Nippon Steel Corporation vs. Union of India (UOI) - W.P. (C) 801/2011 (08.02.2011):** the Delhi High Court held that once application is deemed to have been withdrawn by applicant in terms of Section 11B(4) of Act, Controller of Patents cannot entertain application for amending any portion of such application - It is not possible to accept submission of petitioner	Section 11B, 35. Rule 24B, 24C.

	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. **Correction**: Highlighted text includes full citation, which was not previously mentioned. In the matter of **Sphaera Pharma, Pte. Ltd And Anr. vs Union Of India And Anr. – (WPC 1469/2018) 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 are request for examination in Form 18), as no such application for extension of time was made prior to expiry of the prescribed time. **Correction**: Highlighted text includes full citation, which was not previously mentioned.	

09.01.02	**Expedited examination of applications** 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: 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. 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. 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.	Rule 24B, 24C, First Schedule

	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. 5) The Controller shall refer the request for expedited examination 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. 5) 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. 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. 6) 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. 7) 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. 8) 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. 9) 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. 10) 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). 11) 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 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. 12) Notwithstanding anything contained in 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. **Problem**: There are two main problems with this section of the Patent Office Manual. (1) Expedition of patent examination in general is a process the IPO should undertake only when the ordinary (non-expedited) process is working smoothly and without error. Recent legal scholarship on the working of the IPO, cited below, identifies a high error rate in the granting of pharmaceutical patents by the IPO. Under these circumstances, it would be advisable to wait until the errors and non-compliance under the ordinary examination process can be minimised, before providing expedited examination. (2) While expedited examination is allowed under law since 2016, through an amendment to the Patent Rules, we are yet to see the evidence of the success of this expedited process due to the recent nature of this amendment. Yet, even as the ordinary examination process has been identified as having an unreasonably high error rate, the IPO has proposed an expansion of the expedited process to 4 new	

	categories, under the Patents (Amendments) Rules, 2018 – including a category where applicants can benefit from a PPH (patent prosecution highway). (3) Under the circumstances, it is inadvisable to retain, or expand, the current allowances for expedited examination. Furthermore, comments on the Manual in reference to expedited examination are also being submitted while amendments to the Rules (which seek to expand expedited examination) are currently in process, but not finalised, which makes the situation untenable. **Suggestion**: Prior to any expansion of current allowances for expedited examination of patents, the IPO would be advised to publish an analysis of the success of the current phase of expedited examination. The IPO would be further advised to proceed incrementally: to re-evaluate the ordinary examination process and learn from the recent use of the expedited process, in consultation with stakeholders, prior to embarking on any expansion of expedited examination to new categories, especially through Patent Prosecution Highways. [See "Pharmaceutical Patent Grants in India: How our safeguards against evergreening have failed, and why the system must be reformed", accessibsa.org, April 2018: hyperlink available here.] **Solution**: Replace highlighted text with the text below (specific changes underlined) Notwithstanding anything contained in 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, and may also limit the process by evaluating the initial phase of expedited examination, before expanding the program any further.	
09.02	**Reference for Examination** 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. Provided that in case of a further application filed under	Section 11A, 12. Rule 24B(2)(i)

	section 16, the order of reference of such further application shall be the same as that of the first mentioned application. 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. 3) 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: 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. 4) 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.: a) Chemistry and allied subjects. b) Biotechnology, Microbiology and allied subjects. c) Electrical, Electronics & related subject d) Mechanical and other subjects. 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.	

	5) 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.	
09.03	**Examination of application** **Problem 1**: Presently, there are 4 Guidelines for patent examination of different fields of technology – the current categories comprise (1) Pharmaceuticals (2) Biotechnology (3) Computer Related Inventions and (4) Traditional Knowledge and Biological Materials – as well as supplementary Guidelines for specific procedures of the IPO. The problem is that none of these Guidelines are formally referenced anywhere in the Patent Office Manual. As a result, it is difficult for any stakeholder to know how patents are examined by the IPO, given that the primary reference for examination are the Guidelines for examination. A related problem is that the complete system that outlines the working of the IPO – the Manual, the Rules and the Guidelines – have not been put through cohesive public consultation, rather, have been published individually, and sometimes in conflict with each other – as is the current case, where recommendations for the Manual are being sought while recommendations for the Rules are under process and therefore not publicly known. A final problem is that the Guidelines are especially necessary for frontier technology – such as biologics or Artificial Intelligence – where the officers of the IPO require additional support and guidance in examining unprecedented technology and the peculiar challenges it poses to patent law. **Suggestion**: (1) Include all Guidelines – whether for fields of technology or procedural – as annexures to the Patent Office Manual and cross-reference them within the text. This will ensure consistency and consolidation across the various layers of regulation and policy that determine the working of the IPO. (2) Open up all inter-linked layers of the patent system – once consolidated – such as the Rules, the Manual, as well as the included Guidelines – to public consultation, but in a cohesive manner, to allow stakeholders to respond to the system in full, rather than merely in part, without a full understanding of the connected issues. (3) Formally incorporate guidelines for examining biologics, following an earlier suggestion to categorise biologics as a specific field of invention by the IPO. The same process must be applied to all crucial frontier technologies, such as Artificial Intelligene, that have an immediate and large impact on the health of the Indian society and economy. **Solution**: Add following text to the text highlighted above (specific changes underlined)	

	The present Manual consolidates all the earlier Guidelines issued by the IPO, by, first, adding them as annexures to the Manual, and, secondly, by cross-referring the relevant provisions within the Manual. **Problem 2**: The sequence of steps to be employed while examining a patent are not clear in the Manual. However, the law as laid down by the courts clearly stipulates a series of steps to be followed in the examination of patents. These steps need to be clearly and simply outlined at the outset of the examination process described in the Manual. **Suggestion 2**: As laid out in Novartis AG vs Union of India & Ors. (CA No 2728/2013 and CA Nos. 2717-2727/2013) and F. Hoffmann-La-Roche Ltd & Anr. Vs. Cipla Ltd (RFA(OS) 103/2012), the tests of "invention" and "patentability" are two distinct concepts. These two concepts reflect the provisions of Section 2(1)(j), i.e. conditions to patentability, and Sections 3&4, i.e. exceptions to patentability. Though the Supreme Court mentions the two distinct tests, it does not state the order in which the tests should be applied (paragraph 91), the Delhi High Court in the Hoffman-La-Roche case (paragraph 61) explicitly states that the exceptions to patentability have to be applied first. In other words, should a patent application fail the test of exceptions to patentability, there is no further need to apply the test of conditions to patentability, as such an application would be rejected in the first stage. The benefit of following this process, as confirmed by the courts, is that the IPO can significantly streamline its examination process, and vastly improve efficiency as a result. **Solution 2**: Add following text to the text highlighted above (specific changes underlined) In the process of examining patents, the procedure to be followed is to apply the test of exceptions to patentability (Sections 3 & 4) first, and only then – if the application is found to pass the test – apply the test of conditions to patentability (Section 2(1)(j)).	

09.03.01	**Search for anticipation by previous publication and prior claiming** 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. The search is conducted to find out any publication which may anticipate the claimed subject matter. 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. 2) The search is conducted with respect to the date of filing of complete specification. 3) The examiner ascertains the following: 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.	Section 13

09.03.02	**Novelty** 1) An invention is considered as new if it is not anticipated by prior publication in patent and non-patent literature, prior use or prior public knowledge. An invention is new (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 of complete specification. 2) 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. 3) While ascertaining novelty, the Examiner takes into consideration, inter alia, the following documents: • 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 the same subject matter. • The Examiner may also consider such documents which have been published before in a transaction of a learned society or exhibited before in an authorized manner as designated by the Government within one year from the date of such filing. 4) 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.	Section 2(1)(j), 13, 29, 30, 31, 32, 33, 34

	5) The prior art should disclose the invention either in explicit or implicit manner. Mosaicing of prior art documents is not allowed in the rejection of novelty. 6) 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. 7) 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. 8) In a case where a prior art is cited as an anticipation in the Examination Report, the onus of proving that the same is deemed not to be an anticipation by reason of Section 29- 34, is on the applicant.	
09.03.03	**Inventive step**	
09.03.03.01	**General principle** 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. 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.	Section 2(1)(j), 2(1)(ja)
09.03.03.02	**Determination of inventive step** 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, citing a mosaic of prior arts is permissible. 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. Hon'ble Supreme Court of India on inventive step: In **Biswanath Prasad Radhey Shyam vs Hindustan Metal Industries Ltd decided on 13-12-1978 (AIR 1982 SC 1444),** it was held that "The expression "does not involve any inventive step" used in Section 26(1) (a) of the Act and its equivalent word "obvious", 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. The one suggested by **Salmond L.J. in Rado v. John Tye & Son Ltd (4 (1967) RPC 297 .** 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 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?" (Encyclopaedia 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 ?" **Correction**: Highlighted text includes full citations, which were not previously mentioned. 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. It must be ensured that inventive step must be a feature which is not an excluded subject itself. Otherwise, the patentee by citing economic significance or technical advance in relation to any of the excluded subjects can insist upon grant of patent thereto. Therefore, this technical advance comparison should be done with the subject matter of invention and it should be found it is not related to any of the excluded subjects. 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:	

	1) Identify the "person skilled in the art", i.e competent craftsman or engineer as distinguished from a mere artisan; 2) Identify the relevant common general knowledge of that person at the priority date; 3) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it; 4) 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; 5) 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	**Industrial Applicability** 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. Usually industrial applicability is self-evident. 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)(ac)
09.03.05	**Inventions not patentable** 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	Section 3

	on the subject. Objective decisions may be taken on case to case basis.	
09.03.05.01	***An invention which is frivolous or which claims anything obviously contrary to well established laws is not an invention.*** Some examples of a frivolous nature and contrary to natural laws are:- • A machine purporting to produce perpetual motion. • A machine alleged to be giving output without any input. • A machine allegedly giving 100% efficiency.	Section 3(a)
09.03.05.02	***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.*** Some examples are: 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,	Section 3(b)

	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.	
09.03.05.03	***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.*** a) 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 an invention. b) 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. c) 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.	Section 3(c)

	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. d) Similarly, finding of a new substance or micro-organism occurring freely in nature is a discovery and not an invention.	
09.03.05.04	***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.*** ***"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".*** According to this provision, the following are not inventions and hence not patentable: a) mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance; b) the mere discovery of any new property of a known substance; c) the mere discovery of new use for a known substance; d) the mere discovery of use of a known process, ***machine or apparatus*** unless such known process	Section 3(d)

	results in a new product or employs at least one new reactant; . ***Explanation to Se***ction 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 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. Section 3(d) stipulates that an incremental invention, based upon an already known substance, having established medicinal activity shall be deemed to be treated as a same substance, and shall fall foul of patentability, if the invention in question fails to demonstrate significantly improved therapeutic efficacy with respect to the known substance. 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 (para...).

It was further held by the Apex Court –

" in the case of medicines, efficacy means "therapeutic efficacy" and physico-chemical properties of substances do not meet the requirement of "therapeutic efficacy".

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.

Problem: The observations of the Supreme Court with regard to the manner in which Section 3(d) needs to be applied has not been fully captured in the Manual. Evidence previously referenced within this submission has shown that a failure to take full cognizance of the Supreme Court's decision in the Novartis case has led to confusion and under-application of Section 3(d) by the IPO, resulting in numerous erroneous grants.

Suggestion: The Supreme Court took pains in the Novartis case to lay down detailed principles and guidelines for the IPO when implementing Indian patent law, especially Section 3(d), which need to be a guiding factor while assessing secondary patent applications. The IPO should follow these standards while granting pharmaceutical patents. Furthermore, the IPO should formally implement an anti-evergreening checklist, a sample of which we include in the suggested Annexures, along with the Patent Examination Guidelines, as referenced earlier.

Solution: Add following text to the text highlighted above (specific changes underlined)

Specifically, the Supreme Court identified the following principles to be applied in cases involving new forms of known substances:

(1) Identifying the new form of the known substance and its pharmacological properties such as efficacy (Paras. 157; 160; 161);
(2) Comparing the pharmacological properties of the known substance with the new form of the known substance (Para. 163);

	(3) Requiring that comparative material on enhanced efficacy in the patent application or by affidavits is provided (Para. 171); (4) Excluding physico-chemical properties like "more beneficial flow properties", "better thermodynamic stability", and "lower hygroscopicity" in considering therapeutic efficacy (Paras. 173, 187); (5) In the case of medicines, requiring that the test of efficacy must only be therapeutic efficacy, which needs to be evaluated strictly and narrowly (Para. 180); (6) Requiring that the applicant has to specifically claim and establish by research data which has to correlate bioavailability to enhanced therapeutic efficacy (Para. 189); (7) For patents involving new forms of known substances in chemicals and pharmaceuticals, requiring that the test of enhanced efficacy should be proved in addition to the fact that the patent application is an "invention" and involves an "inventive step" (Para. 192)	

09.03.05.05	***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.*** An admixture resulting in synergistic properties is not considered as mere admixture. Hence, substances like soap, detergent, lubricants, may be considered as patentable. 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. 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 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	Section 3(e)

	further support of synergy. However, such submitted data may be incorporated in the Specification, subject to the provisions of Section 59. **Problem**: When Sections 3(d) and 3(e) of Indian patent law are raised together, applicants have frequently tended to satisfy only Section 3(e) and make an argument that the same justification is enough to get over objections under Section 3(d). From the recent study on the working of the IPO previously referenced within this document, it was found there were 50 cases where the applicants argued that the relevant provision applicable for the patent application was Section 3(e) and not Section 3(d), or alternatively, used Section 3(e) to divert the IPO's focus from objections raised under Section 3(d). By shifting focus between different provisions of Section 3, applicants often took advantage of the confusion, resulting in a misled grant. Under Section 3(e), the applicant needs only show synergistic effect in the combination drugs that the section applies to; therefore, a common strategy has been for applicants to draft a formulation/composition/combination claim to move the application away from the implications of Section 3(d). **Suggestion**: A common misperception of the IPAB decision in **Ajantha Pharma Ltd v. Allergan Inc, IPAB, ORA/21/2011/PT/KOL of Order No. 173/2013** is that Section 3(d) of Indian patent law is inapplicable in situations where the patent application relates to a pharmaceutical combination. This misperception has been propagated widely, within the IPO as well, as reflected in the citation and reference to this case in the Guidelines for examination of pharmaceutical patents. However, the decision made by the IPAB in the above-mentioned case was based upon grounds of patentability, Section 2(1)(j) of Indian patent law, and the observation around combinations and Section 3(e) was only made in passing. As such, it is not a binding precedent since the subject matter of the case was not decided with Section 3(e). Therefore, references to the IPAB case in question should be removed forthwith. Therefore, the suggestion we strongly advance, is that in cases where a patent application is being scrutinized under Section 3(d) and Section 3(e), the IPO must ensure that the application can independently satisfy both provisions, without linking them, as each test is independent of the other and distinct, especially in the case of pharmaceutical combinations. **Solution**: Add following text to the text highlighted above (specific changes underlined) Furthermore, in cases where the combination attracts scrutiny under Section 3(d) and Section 3(e), the IPO will independently examine the application under both provisions, disregarding any	

	misperceptions as may exist on the precedent set by the IPAB decision in **Ajantha Pharma Ltd v. Allergan Inc, IPAB, ORA/21/2011/PT/KOL of Order No. 173/2013,** and require the applicant in all such cases to pass scrutiny under both of the provisions.	
09.03.05.06	***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.*** 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**). 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.)** 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	Section 3(f)

	performs its own function independently of the others is not a patentable combination. [As for example: a flour mill provided with sieving means]. However, where the old integers when placed together have some 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. 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. 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. 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**).	
09.03.05.07	***A method of agriculture or horticulture is not an invention.*** Examples of subject matters excluded from patentability under this provision are: a) A method of producing a plant, even if it involved a 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 specified phosphorathioates. c) A method of producing mushrooms. d) A method for cultivation of algae. e) A method for removal of weeds.	Section 3(h)
09.03.05.08	***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.*** This provision excludes from patentability, the following: a) Medicinal methods: for example a process of administering medicines orally, or through injectables, or topically or through a dermal patch. b) Surgical methods: for example a stitch-free incision for cataract removal. c) Curative methods: for example a method of cleaning plaque from teeth. d) Prophylactic methods: for example a method of	Section 3(i)

	vaccination. 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. 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. 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. 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 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. i) Application of substances to the body for purely cosmetic purposes is not therapy. j) Patent may however be obtained for surgical, therapeutic or diagnostic instrument or apparatus.	

	k) Also the manufacture of prostheses or artificial limbs and taking measurements thereof on the human body are patentable. **Problem**: "Method of Treatment" is an internationally allowable form of claiming patent protection. In India, however, Section 3(i) of the Indian Patents Act, expressly bars method of treatment claims. Evidence from a recent study on the workings of the IPO identifies an overwhelming number of cases where objections raised initially by the IPO on method of treatment claims have been overcome on the part of the applicants, by them merely changing the language of the claim from "method of treatment" to "composition". This is a problem, as it is a blatant and unfortunately successful way of overcoming provisions in Indian patent law designed to fight ever-greening and protect public health. **Suggestion**: Due to the nature of abuse of the patent system in India by overwhelmingly foreign patent applicants on Section 3(i), we strongly suggest that in cases where any patent application includes, in the first instance, a "method of treatment" claim, these claims will be examined as method of treatment claims by the examining officers at the IPO, until a decision is made on the application, regardless of how the wording subsequently might change after initial objections are raised. **Solution**: Add following text to the text highlighted above (specific changes underlined) (l) In any situation where the IPO offers an initial objection, using Section 3(i), on a patent application that contains a "method of treatment" claim, the IPO shall continue to examine such an application on the basis of the initial assessment, i.e. containing a "method of treatment" claim, throughout the duration of examination, regardless of any subsequent changes in the wording of the originally submitted claim, especially to the extent that the changes apply to amending the words "method of treatment" to "composition" or otherwise.	

09.03.05.09	***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.*** The subject matters excluded under this provision are: a) plants in whole or in part b) animals in whole or in part c) seeds d) varieties and species of plants and animals e) essentially biological process(es) for production or propagation of plants and animals. 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. Plant varieties are provided protection in India under the provisions of the '**Protection of Plant Varieties and Farmers' Rights Act, 2002**'.	Section 3(j)
09.03.05.10	***A mathematical or business method or a computer programme per se or algorithms are not inventions and hence not patentable.*** Under this provision, mathematical methods, business methods, computer programmes per se and algorithms are not considered as patentable subject matter. **Problem**: The proposed text lacks the specificity to regulate CRIs. **Suggestion:** Reinstate the below-mentioned test, which is a slight variation of the three step test to determine applicability of section 3(k), as proposed in the 2016 CRI Guidelines by the Controller. **Solution:** Add following text to the text highlighted above (specific changes underlined) "Examiners may rely on the following three stage test in examining applications to determine the patentability of inventions that contain at least one claim with mathematical methods, business	Section 3(k)

methods, computer programmes per se or algorithms as its substance:

(1) Properly construe the claim and identify the actual contribution;

(2) If the contribution lies only in mathematical method, business method or algorithm, deny the claim;

(3) If the contribution lies in the field of computer programme, check whether it is claimed in conjunction with a novel hardware and proceed to other steps to determine patentability with respect to the invention. The computer programme in itself is never patentable. If the contribution lies solely in the computer programme, deny the claim. If the contribution lies in both the computer programme as well as hardware, proceed to other steps of patentability."

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.

Problem: Unfortunately, the practice of camouflaging inventions as one related to technological development rather than the mathematical method itself has proliferated and continues to be used by applicant/ agent to this day. This problem is especially exacerbated when the invention involves the use of computers, computer networks, computer programmes or other similar

	programmable apparatus. Such a practice is in contravention to the legislative spirit of section 3(k) and thus merits strict language in the draft Manual to prevent it. **Suggestion:** It is crucial to expressly indicate that examiners and applicant/ agents should not camouflage inventions that consist of excluded claims such as mathematical methods. It is well-established that in patentability cases, the focus should be on the underlying substance of the invention, not the particular form in which it is claimed (as discussed in p. 14 of 2017 CRI Guidelines). Further, the examples highlighted in the text are vague and invalid in light of section 3(k). **Solution**: Replace highlighted text with the text below (specific changes underlined) 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. With the development in computer technology, mathematical methods are used for writing algorithms and computer programmes for different applications and the claimed invention is sometimes camouflaged as one relating to the technological development rather than the mathematical method itself. These methods, claimed in any form, are considered to be not patentable.	

	3) **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 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. **Problem**: There is documented, widespread disguise of what are essentially business methods, that nevertheless misleadingly present themselves as patentable inventions. **Suggestion**: Clarify the language of exclusion under business methods to prevent misuse of the provision. **Solution**: Replace highlighted text with the text below (specific changes underlined) 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 carrying out business/ trade/ financial activity/ transaction and/or a method of buying/selling goods through use of computers, computer networks, computer programmes or other similar programmable apparatus, the same should be treated as business method and shall not be patentable, in keeping with the decision of the IPAB on business methods in **Yahoo Inc vs Controller of Patents, IPAB, OA/22/2010/PT/CH**"	

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.

Problem: There is documented, widespread disguise of what are essentially algorithms, that nevertheless misleadingly present themselves as patentable inventions.

Suggestion: The Manual should additionally make it clear that in algorithm-related claims, if the function claimed to be performed by the invention can be done only by means of a computer programme, such claims are not patentable.

Solution: Replace highlighted text with the text below (specific changes underlined):

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. Furthermore, any invention where the function claimed to be performed by such invention can only be done by means of a computer programme, is not patentable.

4) **Claims directed as "Computer Programme per se":** Claims which are directed towards computer programs per se are excluded from patentability, like,

   a) Claims directed at computer programmes/ set of instructions/ Routines and/or Sub-routines.

   b) Claims directed at "computer programme products" / "Storage Medium having instructions" / "Database" / "Computer Memory with instruction" stored in a computer readable medium.

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."	
09.03.05.11	***A literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions is not an invention.*** Writings, music, works of fine arts, paintings, sculptures, computer programmes, electronic databases, pamphlets, lectures, drawings, architecture, engravings, lithography, photographic works, applied art, illustrations, maps, plans, sketches, topography, translations, adaptations, etc. are not patentable. Such works fall within the domain of the Copyright Act, 1957.	Section 3(l)

09.03.05.12	***A mere scheme or rule or method of performing mental act or method of playing game is not an invention.*** 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, a) Method of playing chess. b) Method of teaching. c) Method of learning.	Section 3(m)
09.03.05.13	***A presentation of information is not an invention.*** Anymanner, 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.	Section 3(n)
09.03.05.14	***Topography of integrated circuits is not an invention.*** 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.	Section 3(o)
09.03.05.15	***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.***	Section

	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. The Examiner conducts an investigation by using the Traditional Knowledge Digital Library (TKDL) and other resources to decide as to whether the claimed subject matter falls within the purview of this provision.	3(p)
09.03.06	**Information and undertaking regarding foreign applications** • One of the criteria 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. • **Provisions in Section 8 : Filing of Information regarding foreign applications :** (1) The applicant shall file along with his application or within six months from the date of filing the application- (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;	Section 8, Rule 12

	and (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. 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. (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 filing.. • If Form 3 is filed after the period specified it may be considered by the Office in accordance with the powers of the Controller generally provided in rule 137 /138. • **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 AND EXAMINATION (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 mandatorily 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, 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.

Problem: Global, proprietary closed-door disclosure systems, such as DAS (which are inaccessible, even by payment to the public) are being increasingly used to circumvent specific disclosure requirements in sovereign patent laws. The inaccessibility of DAS information, for instance, would conceal the fact that a certain patent application might contain far fewer claims in India, for instance, over a country with a less stringent patent system like Japan.

Suggestion: Section 153 of the Indian Patents Act, read with Rule 134 of the Patent Rules, mandates that any third party seeking full access on disclosures made by the patent applicant under Section 8, is entitled to receive that information in full. When the IPO uses the DAS system to allow applicants to fulfil their obligations under Section 8, the IPO is effectively circumventing its own obligations to the Indian public as well as shifting the onus of disclosure from the patent applicant onto itself. Therefore, a solution to this circumvention and abdication

	of responsibility would be for the IPO, under the guidance of Section 153 of the Indian Patents Act, read with Rule 134 of the Indian Patent Rules, to provide all relevant disclosures under Section 8, whether made directly or through the DAS system, on the inPASS website in full, so that they may be available at all times to stakeholders in the Indian patent system. **Solution**: Replace highlighted text with the text below (specific changes underlined) 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, and the same information (as available in full on DAS) will be updated on inPASS, for each application under question, to enable public access to the disclosures thereby made. 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 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.	

09.03.07	**Sufficiency of Disclosure** Sufficiency of disclosure is yet another aspect, which is checked by the Examiner while examining a patent application. The Examiner will look for whether: b) the specification is properly titled. c) the subject matter is fully and particularly described in the specification. d) the claims define the scope of the invention properly. e) the Specification describes the best method of performing the invention or not. f) the source and geographical origin, in case of inventions related to biological materials, has been disclosed. g) approval obtained from Biodiversity Authority, wherever applicable. h) accession number and other details of the depository are given, if applicable **Problem**: With regards to biologics, the patent claim, to be sufficient, needs to entail an enabling disclosure across the scope of the claim; without this, it is not clear to the examiners that the patent claim satisfies the requirement of sufficiency. **Suggestion**: For any biologics patent claim to be valid, i.e. to satisfy the requirement of sufficiency, the claim should entail an enabling disclosure across the scope of the claim; this needs to be clarified explicitly when it comes to biologics. **Solution**: Replace highlighted text with the text below (specific changes underlined) the claims define the scope of the invention properly; and, for biologics, that they involve a provision for enabling disclosure across the scope of the claim.	Section 10

09.03.08	**Unity of Invention** 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 application may be divided in order to meet the objection of plurality of distinct inventions. 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, or at least a step of the process. 4) Independent claims of different categories may relate to a single inventive concept. 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/	Section 10(5)

	Amino Acid sequence, a method of expressing the sequence, an antibody against that protein/sequence, a kit containing such antibody/ sequence. 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.	

09.03.09	**Report of Examiner** 1) The examiner makes a report after carrying out detailed examination with respect to the following matters: 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; b) whether there is any lawful ground of objection to the grant of patent under the Act; c) the result of investigations under Section 13. 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. 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.	Section 3, 4, 12, 13

09.04	**Consideration of Report by Controller and issuance of First statement of objection/ First Examination Report (FER)** 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. 2) The FER is sent to the applicant, even when the request for examination has been filed by a person interested. An intimation regarding the issue of FER is given to such person interested. 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-fulfilment of any other requirement under the Act & Rules. **Problem**: Without the formal adoption of a checklist that enables officers of the IPO to implement all the several anti-evergreening provisions in Indian patent law, it is likely (as shown by a recent study on the subject) that provisions may be missed or ignored. **Suggestion**: Implement an anti-evergreening checklist, which forms a formal part of the Patent Office Manual, that is then used in the examination process, both within the IPO (examiner's report, internal to the Patent Controller) as well as in the FER (which is public communication on the initial examination). **Solution**: Replace highlighted text with the text below (specific changes underlined) Subject matter relating to a category, which falls within the purview of Sections 3 and 4; as well as any subject matter that	Section 3, 4, 14, 15, 18, 21

	falls within any of the provisions listed in the anti-evergreening checklist that are contained in the Annexures to the Patent Office Manual. d. The applicant is required to comply with all the requirements imposed upon him by the Act as communicated through FER or subsequent communication, at the earliest. 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). A communication to that effect is sent to the applicant for information. 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. e. If the response / amendment filed by the applicant do not satisfy the requirements laid down by the Act, the Controller offers an opportunity of hearing and decides the case on merits. 6. The 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). In all cases of hearing, written submissions and the relevant documents, if any, shall be filed within fifteen days from the date of hearing.	

	7. When the applicant re-files the documents within stipulated time, the application has to be examined in a fresh manner by the examiner. Upon examination, if it is found that the requirements of the Act have been met, the Patent is granted. 8. If the applicant contests any of the objections communicated to him by the Controller or he re-files his specification or other documents, along with his observations as to whether or not the specification is to be amended, an opportunity of being heard is given. 9. After hearing the applicant, the Controller may specify or permit such amendment as he thinks fit and grant the patent. The Controller may refuse to grant the patent if requirements of the Act and Rules are not complied with. 10. No patent is refused without giving an opportunity of being heard under Section 14. A decision by the Controller under Section 15 for refusal of patent shall be a speaking order. 11. Such an order of Controller under Section 15 is appealable before the Intellectual Property Appellate Board.	
09.05	**Post-dating of Application** 1) The application for patent may be post-dated to a date not later than six months from the date of application on a request made by the applicant at any time before the grant of patent along with the prescribed fee. 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. 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.	Section 9(4), 15, 17

	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. In case this provision is invoked, the application shall be examined afresh with reference to the date as directed by the Controller (Section 17(2)). 3) Following may be instances in which Section 17(2) may be invoked by the Controller: a) A missing part is brought-in through an amendment, for the purpose of meeting the office objections during Section 15 proceedings, by the applicant. b) A new drawing is brought-in through an amendment for the purpose of explaining the amended specification, and without such amended drawing the amended specification cannot be explained. **4) Regarding Date of filing for 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 stipulated period of 12 months. **In this case, his date of filing with provisional application will be the date of application.** **ii)** Applicant can file an application with Complete Specification and request to convert it into Provisional Specification within 12 months of original filing date (Section 9 (3)) and file Complete Specification within 12 months from the first filing date, **then the date of filing will still be the date of first filing.**	

	(iii) After filing 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 can post-date the application to the date of filing of the complete specification (Section 9 (3)). **In this case, the date of application will be the date on which such Complete Specification is filed.** (iv) **Section 17 (1)**: Subject to the provisions of section 9, at any time after the filing of an application and before the grant of the patent, the Controller may, at the request of the applicant made in the prescribed manner, direct that the application shall be post-dated to 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.**	
09.06	**Pre-Grant Opposition** 1) Any person may file an opposition by way of representation 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. The date of grant of Patent is the date on which the Controller orders the grant of patent in the file. Simultaneously, the patent number is generated and the fact of granting the patent is available on the official website. 2) 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	Section 11A, 25(1). Rule 55.

	interested, he may file a formal post grant opposition. 3) A Patent is not granted before the expiry of six months from the date of publication under Section 11A. Therefore, a person may file the 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. 4) The representation shall include a statement and evidence, if any, in support of such representation and a request for hearing, if so desired. 5) The Controller shall consider the representation only after a Request for Examination for that Application has been filed. 6) The Pre-Grant Opposition, if available on record, is considered by the Controller along with the report of the Examiner. 7) On consideration of the opposition, if the Controller is of the opinion that the opposition is devoid of any merit, an opportunity of hearing shall be granted to the opponent. After hearing the opponent, if the Controller is still of the opinion that the opposition shall be refused, a speaking order shall be issued rejecting the pre-grant opposition, ordinarily within one month. 8) However, 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 along with a copy of the representation. The applicant shall, if he so desires, give reply to that representation along with his statement and evidence, if any, in support of his application within three months from the date of the notice. 9) The Controller shall consider the statement and evidence filed by the applicant and may either refuse the grant of patent or ask for amendment of the complete specification to	

	his satisfaction before the grant of patent.	

	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 to simultaneously decide on the application and the representation ordinarily within one month from the completion of above proceedings. If the application for patent is to be refused on consideration of the pre-grant opposition u/s 25(1), a speaking order of refusal shall be issued under Section 15. 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) and Rule 55 of Patent Amendment Act and 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" In the matter of **Snehlata C. Gupte vs. Union of India (UOI) and Ors (W.P. (C) No 3516 and 3517 of 2007),** the Delhi High Court held the pre grant representation proceedings on the same pedestal as per court hearing despite the fact that patent being techno-legal in nature and involving complexities. **Correction**: Highlighted text includes full citations, which were not previously mentioned "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."	

09.07	**Grant of Patent**	
09.07.01	**Compliance of conditions under the Act** The Patent is granted as expeditiously as possible when 1) the application has not been refused by the Controller by virtue of any power vested in him by this Act, or 2) the application has not been found to be in contravention of any of the provisions of the Act, or **For instance,** a) All objections raised by the examiner have been met and documents returned with the FER have been resubmitted after complying with the requirements, within 6 months from the date of the FER or within the extended period. b) In cases where the FER contains reference to a prior art which was published before the date of filing of complete specification but after the date of priority of the application, the applicant will have to prove that the priority date of the claim of his complete specification is earlier than the date on which the relevant document was published. The priority date of such claim is the date on which the matter was first disclosed in the relevant specification. In the alternative, the applicant may amend his complete specification to overcome the objection in respect of such document. In the absence of above mentioned proof or amendment, the application is liable to be refused, after following the procedure elaborated in Rule 28, 28-A. c) In cases where the FER contains reference to a prior art which was published after the date of filing of his complete specification but claiming an earlier priority date, the applicant will have to prove that the priority date of the claim of his complete specification is earlier than the date on which such document was published.	Section 18, 43. Rule 28, 28A, 29, 30, 31.

	The priority date of such claim is the date on which the matter was first disclosed in the relevant specification. In the alternative, the applicant may amend his complete specification to overcome the objection in respect of such document. In the absence of above mentioned proof or amendment, a reference to the other specification shall be inserted by way of notice to the public in the applicant's specification, after following the procedure elaborated in Rule 29-31. d) When there is no pre-grant representation pending before the grant of Patent or when the Pre-Grant Opposition has been disposed of in favor of the applicant, the date of grant of patent is the date on which the patent is granted by the Controller in the file. The patent number is simultaneously generated. As the Patent Office has moved to complete electronic processing, the fact of grant of Patent by the Controller and the Patent Number is reflected on the official website on real time basis.	
09.07.02	**Consequences of grant** 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) The fact that the patent has been granted is published in the official journal of the Patent Office.	Section 43, Form-27

	5) On the 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. 6) A post-grant opposition under section 25(2) can be filed by any person interested within 12 months from the date of publication of grant. 7) Every patentee and licensee has to furnish a statement regarding the working of the patented invention on commercial scale in India at regular intervals (not less than six months) in the prescribed format.	
09.07.03	**Date of Patent** 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 filing is the international filing date. 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 grant of patent.	Section 45
09.07.04	**Conditions subject to which Patent is granted** 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	Section 47

	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.	
09.07.05	**Rights of Patentee** 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 India.	Section 48
09.07.06	**Rights of co-owners** 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	Section 50, 51

	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 the ownership and devolution of movable property generally shall apply in relation to patents, and nothing contained in sub-section (1) or sub-section (2) 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 in this section shall affect the rights of the assignees of a partial interest in a patent created before the commencement of this Act.	
09.07.07	**Term of Patent** The term of Patent is 20 years from the date of filing of application in respect of all the patents, including those for which the term had not expired on 20th May, 2003, when 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).	Section 53

Chapter - 10: Opposition Proceedings

10.01	**Post-grant opposition** 1) Any person interested can file a Notice of Opposition against the grant of Patent in the prescribed format, in duplicate, any time after the grant but within twelve months from the date of publication of grant of patent at the appropriate Office. 2) The opponent shall state the nature of his interest in the matter. 3) The post-grant opposition can be filed on the grounds as mentioned in Section 25(2), but no other grounds. 4) After receipt of 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 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 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 is 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	Section 2(1)(t), 25(2). Rule 55A, 60, 126, 127. Form 7.

	statement and evidence. Evidence in reply of the opponent shall be strictly confined to the matters in the patentee's evidence. The opponent shall deliver a copy of his reply statement and evidence to the patentee. 9) No further evidence shall be delivered by either party, except with the leave or direction of Controller. 10) With respect to further evidence filing, either party shall do so before the Controller's notification on the fixation of the date of hearing. 11) Where a specification or other document in a language other than English is referred to in the notice, statement or evidence, an attested translation thereof in duplicate in English should be furnished along with such notice, statement or evidence, as the case may be. 12) Evidence shall be filed on affidavits as required under Rule 126. 13) Exhibits shall be filed as required under Rule 127.	
10.02	**Constitution of Opposition Board** 1) After receipt of Notice of Opposition, an Opposition Board is constituted by the Controller, by order, to examine such notice including all the documents filed under rule 57-60 in connection with opposition by the opponent as well as patentee. 2) The Board shall submit the report with reasons on each ground taken in the Notice of Opposition after examining 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. 3) The Opposition Board consists of three members with one of them as Chairman. 4) The examiner may be a member of the Board. But, the examiner who has dealt with the application for patent	Rule 56, 57, 58, 59, 60

	during the prosecution proceedings for grant of patent thereon shall not be included as a member of the Board.	
10.03	**Hearing** 1) On the 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 the 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 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., he may revoke the patent, or order amendments in the Patent or refuse the opposition and issue a speaking order. 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

Chapter 11: Post-grant procedures

11.01	**Maintenance of Patent – renewal** 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. Further, renewal of a patent can be done beyond the due date in the extended period of six months from that date by filing Form-4 along with the prescribed fee. This period of six months is not further extendable. 1) 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 may be paid within a period of three months from the date of the recording of the patent in the register. The date of recording of patent in the register of patents is communicated to the applicant through an email mentioned in file records. 2) 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. 3) While paying the renewal fee, the patentee shall quote correctly the patent number, date of patent and the year in respect of which the renewal fee is being paid. Any mistake	Section 53, 142 (4). Rule 80. Form-4.

	in the above said particulars may lead to a lapse of patent. 4) For the Patent of Addition no renewal fee is required to be paid. 5) Annual renewal fee may be paid for more than one year in advance.	
11.02	**Restoration of Lapsed Patents** 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, within eighteen months from the date on which the patent ceased to have effect. Such an application 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. 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 and copies of relevant documents. 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 restoration. 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. 5) If a patentee has failed to register a change of name before cessation he must first apply under Rule 94 for alteration 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.	Section 60. Rule 84, 94. Form-15.

11.02.01	**Procedure for disposal of application for restoration** 1) When the Controller is prima facie satisfied after verification of evidence submitted in support of in Form 15 that the failure to pay 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). 2) If the Controller is satisfied that a prima facie 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 notice by the Controller, the application for restoration is refused. In case of rejection of the application for restoration, a speaking order shall be issued. 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. 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 expeditiously by the Controller. 5) The procedure specified in rules 57 to 63 for post grant opposition for filing of written statement, reply statement; reply evidence, hearing and cost shall apply in this case. 6) When no opposition is received within a period of two months from the date of publication of the application for	Section 60, 61, 62. Rule 84, 85, 86. Form-14, 15.

	restoration, or opposition, if any, is disposed of in favour of the Patentee, 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. 7) The fact that a patent has been restored shall be published in the official journal. 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 includes the provisions and other conditions, as the Controller may impose, for protection and compensation of the 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 Patent ceased to have effect and the date of the Publication of the Application for restoration of the patent.	
11.03	**Registration of assignments/Transfer of Right** 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	Section 68, 69. Rule 90, 91, 92. Form-16.

	his title or as the case may be of notice of his interest in the register. 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 licence granted under a patent, the Controller shall, if so requested by the patentee or licensee, take steps for securing that the terms of the licence 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 IPAB, 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 reasons to be recorded in writing, otherwise directs. 6) If requested by the patentee / licensee, the terms of the license may be kept confidential and not disclosed to any person, except under the order of a Court.	
11.04	**Surrender Of Patents** 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 publishes the offer in the Official	Section 63. Rule 57, 58, 59, 60, 61, 62, 63.

	Journal and also notifies every person (other than the patentee) whose name appears in the register as having an interest in the patent. 2) An opposition against the offer to surrender the patent may be filed by any person interested in Form 14 (in duplicate) 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. 3) The procedure relating to filing of written statement, reply statement leaving evidence and hearing of the opposition is similar to that of the opposition to the grant of Patents as per Rules 57-63 [See Chapter 10- Post-grant opposition]. 4) In case, the Controller accepts the patentee's offer to surrender the patent, he may direct the patentee to return the patent and on the receipt of which, the Controller shall by order, revoke it and publish such revocation in the official journal.	Form-14.
11.05	**Working of Patents** 1) 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. 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 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. 4) The patentee and every licensee shall furnish a statement as	Section 83, 146. Rule 131(2) Form-27

	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.	
11.06	**Amendments after the grant of patents** 1) After the grant of patent, the patentee may apply in Form-13 for an amendment of the application for patent, complete specification or any document relating thereto to be amended subject to such conditions, if any, and as the Controller thinks fit. Such a request may be filed in Form-13 with prescribed fee. 2) 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. 3) An application for amendment may be published along with the nature of proposed amendment. However, 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 for patent shall be published. 4) The amended pages have to be filed in duplicate by the applicant along with duly cancelled original pages. 5) Any person interested may file a notice of opposition in	Section 57, 59. Rule 57, 58, 59, 60, 61, 62, 63, 81, 82, 83. Form-13, 14.

	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 notifies the applicant for amendment. 6) After giving an opportunity to the applicant and opponent, if any, the Controller shall dispose off 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. 7) Amendments allowed after the grant of patent shall be published. 8) A leave to amend the complete specification obtained by fraud is a ground for revocation of patent under Section 64. 9) 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	**Procedure to be followed, after the grant of patent, in case of death of an applicant** 1) If the applicant had died before the grant of patent, but the patent was granted in his name, a person in whose name the patent ought to have been granted may make a request to the Controller for substitution. The Controller may amend the patent by substituting the name of the deceased applicant with the name of such claimant. Such a request has to be made in Form-10. 2) If the applicant dies after the patent has been granted, any person who becomes entitled to the patent or to a share in the patent, by operation of law, may make a request for registration of his title. Such a request shall be made in Form-16.	Section 44. Rule 75. Form-10, 16.

11.08	**Register of Patents** 1) Patent Office maintains Electronic Register of Patents which is under the control and management of the Controller of Patents and same is available in the office website. 2) 2. E- register of patents contains details about the patentee, notifications in respect of assignments, transmissions, patents, licences under patents, and amendments, extension and revocations of patents and is available to public. 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. 3) Upon grant of a patent, the entries of name, address and nationality of the patentee, title of the invention including the categories to which the invention relates, date of the patent, date of granting thereof and address for service of the patentee are entered in the E-Register of Patents through the module. The fact of payment of renewal fee shall is also 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. 4) 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. 5) 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	Section 67, 72. Rule 88, 93, 94.

	request shall be allowed, the additional address shall be entered in the E- Register. 6) Entries in the register for each patent are available to the public on the official website.	
11.09	**Rectification of register of patents** 1) An application for rectification of register of patents may be made to the Intellectual Property Appellate Board (IPAB) by any person aggrieved: 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. Further, 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, rectifies the register.	Section 71

Chapter-12: Appeals

12.01	**Appellate Board and Appeals**	
12.01.01	**Appellate Board** a. An Appellate board established under the Section 83 of the Trade Marks Act, 1999, is the Appellate Board for the purposes of Patents Act, 1970. An appeal lies to the Appellate Board from any decision, order or directions of the Controller or Central Government passed under the provisions mentioned in Section 117A(2) only and not against any other decision or direction. The Board has been constituted for speeding up legal proceedings. b. The Appellate Board became operational on and from 2nd April, 2007 vide S.O. 507(E) published in the Gazette of India, Part II, Section 3, Sub-section (ii).	Section 116, 117A(2)
12.01.02	**Appeals** a. An appeal lies from the decision, order or direction made or issued under the Patents Act by the Central Government or any act or order of the Controller for the purpose of giving effect to any such decision order or direction. b. Further, an appeal shall lie from any decision, order or direction of 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 Patents Act. c. 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.	Section 117A(2), 81.

12.02	**Appeal procedure** 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 in the form and fee prescribed. 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 Appellate Board may in accordance with the Rules made by it allow. c. The Controller shall have the right to appear and be heard- i. in any legal proceedings before the Appellate Board 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; ii. in any appeal to the Appellate Board from an order of the Controller on an application for grant of patent— A. which is not opposed, and the application is either refused by the Controller or is accepted by him subject to any amendments, modifications, conditions or limitations, or B. 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 Appellate Board. e. The Controller may, in lieu of appearing, unless the Appellate Board otherwise directs, submit a statement in writing signed by him, giving such particulars as he thinks	Section 117E, 117F.

	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.	

Chapter-13: Revocation of Patent

13.01	**Revocation of Patent**	
13.01.01	**Revocation before High Court or Appellate Board** 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 Appellate Board. A Patent may also be revoked by the High Court on a counter-claim in a suit for infringement of patent. b. Grounds for revocation before the Appellate Board as well as the High Court are elaborated in Section 64. 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.	Section 64

13.01.02	**Revocation by Controller on direction of Central Government** 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 as having an interest in the patent, and after giving them an opportunity of being heard, may revoke the patent. 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.	Section 65

13.01.03	**Revocation by Central Government** 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 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.	Section 66
13.01.04	**Revocation by Controller for non-working** a. Where, in respect of a patent, a compulsory licence has been granted, the Central Government or any person interested may, apply to the Controller for an order revoking the patent on the ground: 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. b. Such an application can be made only after the expiration of two years from the date of the order granting the first compulsory licence. c. 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. d. Such applications shall ordinarily be decided within one year from the date of presentation to the Controller.	Section 85

Chapter 14: Compulsory Licensing

14.01	**Working of patents - General principles** 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 on Patent from the patentee, and the patentee or a person deriving title or interest on Patent from the patentee does not resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology.	Section 83, 89

	g. Patents are granted to make the benefit of the patented invention available at reasonably affordable prices to the public. h. Patented inventions are worked on a commercial scale in the territory of India without undue delay and to the fullest extent that is reasonably practicable; i. The interests of any person for the time being working or developing an invention in the territory of India under the protection of a patent are not unfairly prejudiced.	
14.02	**Compulsory License** An application for grant of a compulsory license may be made under the following provisions: a. Section 84. b. Section 91. c. Section 92. d. Section 92A.	
14.02.01	**Compulsory License under Section 84** a. Any person interested may make an application to the Controller for grant of Compulsory License for a patent after the expiry of three years from the ―date of grant‖ of the patent on the following grounds: 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. Such an application may also be made by the licensee.	Section 84 Form-17

	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. c. In considering such an application, the Controller shall take into account- 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 licence 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.	
14.02.01.01	**Reasonable requirements of the public** The reasonable requirements of the public shall be deemed not to have been satisfied—	Section 84(7)

	I. if, by reason of the refusal of the patentee to grant a licence or licences on reasonable terms,— 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 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 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 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 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— 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.	
14.02.01.02	**Contents of application** Such an application shall contain a statement setting out the nature of the applicant's interest, the facts upon which the application is based and the terms and conditions of the licence the applicant is willing to accept.	Section 84 Form-17
14.02.01.03	**Procedure** a. Where the Controller is satisfied, upon consideration of an application for compulsory licence, that a prima facie 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 to be interested in the patent in respect of which the application is made, and shall publish the application in the official journal. 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. c. The notice of opposition shall include grounds on	Section 86, 87,88, 89, 90. Rule 62, 96, 97,98, 99, 100, 101. Form-14

	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. 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. e. No further statement or evidence shall be delivered by either party except with the leave of or on requisition by the Controller. 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. 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. 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. 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.	
14.02.01.04	**Terms and conditions**	Section 90

	In settling the terms and conditions of a licence, the Controller endeavours 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	**Application by licencee** 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 licences 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 licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant. b. Where an application for compulsory license is made by a person being the holder of a licence under the patent, the Controller may, if he makes an order for the grant of a licence to the applicant, order the existing licence to be cancelled, or may, if the thinks fit, instead of making an order for the grant of a licence to the applicant, order the existing licence to be amended.	Section 88
14.02.01.06	**Compulsory license in case of two or more patents held by the same patentee** Where two or more patents are held by the same patentee and an applicant for a compulsory licence 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	Section 88

	the applicant cannot efficiently or satisfactorily work the licence 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 licence in respect of the other patents also to enable the licensee to work the patent or patents in regard to which a licence is granted under section 84.	
14.02.02	**License for related patents** 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 licence of the first mentioned patent on the ground that he is prevented or hindered without such licence from working the other invention efficiently or to the best advantage possible. b. No order under such an application shall be made unless the Controller is satisfied – 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 licence in respect of the other invention on reasonable terms; and 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. c. Controller, if satisfied, that the grounds alleged have been established by the applicant,	Section 87, 88,89, 90, 91 Form-17

	he may make an order on such terms as he thinks fit granting a licence 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. However, such a licence granted by the Controller shall be non- assignable except with the assignment of the respective patents. d. The procedure as mentioned in Sections 87, 88, 89 and 90 shall apply to licences a licence granted under this provision.	
14.02.03	**Compulsory licence on notification by Central Government** a. 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 sealing 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 - i. the Controller shall, on application made at any time after the notification by any person interested, grant to the applicant a licence under the patent on such terms and conditions as he thinks fit; ii. in settling the terms and conditions of a licence 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 deriving a reasonable advantage from their patent	Section 83, 87,88, 89, 90, 92 Form-17

	rights. iii. The procedure as mentioned in Sections 83, 87, 88, 89 and 90 shall apply in relation to the grant of such licences as they apply in relation to the grant of licences under Sec. 84. iv. However, where the Controller is satisfied on consideration of the application that it is necessary in- I. a circumstance of national emergency; or II. a circumstance of extreme urgency; or III. a case of public non-commercial use, 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. However, 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.	
14.02.04	**Compulsory licence for export of patented pharmaceutical products in certain exceptional circumstances** a. Compulsory licence 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 licence has been granted by such country or such country has, by notification or otherwise, allowed importation of the patented pharmaceutical products from India.	Section 92A Form-17

	b. The Controller shall, on receipt of an application in the prescribed manner, grant a compulsory licence 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. c. The provisions of (a) and (b) shall be without prejudice to the extent to which pharmaceutical products produced under a compulsory licence can be exported under any other provision of this Act. 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.	
14.02.05	**Termination of Compulsory License** a. Patentee or any other person deriving title or interest in the patent, may make an 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. b. The holder of the compulsory licence shall have the right to object to such termination. c. 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.	Section 94

Chapter 15: Use of patent for purposes of Government

15.02	**Use of patent for the purpose of Government** 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.	Section 99
15.02	**Power of Central Government to use inventions** 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. 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 of 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 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. 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.	Section 100

	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 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.	
15.03	**Rights of third parties** 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 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, 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— 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, and the reproduction or publication of any model or document in connection with the said use for the purposes of government shall not been deemed to be an infringement of any copyright subsisting in the model or document.	Section 101

	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 agreed upon between them or as may in default of agreement be determined by the High Court on a reference under Section 103. 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— 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 licence.	
15.04	**Acquisition of inventions** 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. 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. 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 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.	Section 102
15.05	**Reference of disputes to High Court** a. Any dispute as to the exercise by the Central Government or a person authorised by it of the powers	Section 103

	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. b. In any proceedings under this section to which the Central Government is a party, the Central Government may— 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. 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. 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 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	**Patent Agents** 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 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. 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. d. All matters relating to registration and subsequent procedures are dealt with in the Office of The Controller General of Patents, Designs and Trademarks, Mumbai. Particulars to be contained in the register of patent agents (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	Section 126, 127 Rule 108, 109

	and any other particulars so specified by the Controller. (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. (3) (i) Copies of register of patent agents shall be maintained in each of the branch offices; (ii) The register of patent agents shall also contain specimen signatures and photographs of the persons registered as patent agents. Application for registration of patent agents (1) Every person who desires to be registered as a patent agent shall make an application in Form 22. (2) The applicant shall furnish such other information as may be required by the Controller. (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.	
16.02	**Disqualifications for registration as a patent agent** A person shall not be eligible to be registered as a patent agent, if he – a. has been adjudged by a competent court to be of unsound mind; b. is an undischarged insolvent; c. being a discharged insolvent, has not obtained from the court a certificate to the effect that his insolvency	Rule 114

	was caused by misfortune without any misconduct on his part; 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; e. being a legal practitioner has been guilty of professional misconduct; or f. being a chartered accountant, has been guilty of negligence or misconduct.	
16.03	**Rights of patent agents** A patent agent is entitled- a. to practice before the Controller; and 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.	Section 127
16.04	**Subscription and verification of certain documents by a Patent Agent** 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.	Section 128
16.05	**Restrictions on Practice as Patent Agents** 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	Section 129

	so described or held out. Each person in the associate group if any constituted should be a registered Agent and duly authorized by the concerned person on behalf they act.	
16.06	**Power of Controller to refuse to deal with certain agents** The Controller may refuse to recognize as agent in respect of any business under this Act: 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; 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	**Power of Controller to remove the name of a Patent Agent** Removal of a name from the register of patent agents (1) The Controller may delete from the register of patent agents, the name of any patent agent- (a) from whom a request has been received to that effect; or (b) when he is dead; or (c) when the Controller has removed the name of a person under sub-section (1) of section 130; or	Section 130. Rule 116.

	(d) if he has defaulted in the payment of fees specified in rule 115, by more than three months after they are due; or (e) if he ceases to be a citizen of India: 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. (2) The removal of the name of any person from the register of patent agents shall be published and shall be, where relevant forthwith communicated to the person concerned. a. The name of any person from the Register can be removed if the Controller is satisfied that: – i. his/her name has been entered in the Register by error on account of misrepresentation or suppression of material fact; or 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. 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. d. The decision of the removal of the name of any person from the Register of Patent Agents shall be published and will be communicated to the person concerned.	
16.08	**Restoration of names of Patent Agents** 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. b. The restoration of name to the register shall be published on official website and communicated to the person concerned.	Rule 117 Form-23

	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.	
16.09	**Alteration of names of Patent Agents** (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 sub-section (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. (2) Every alteration made in the register of patent agents shall be published.	Section 125

Chapter 17: Offences and Penalties

17.01	**Contravention of S.35 or 39** 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.	Section 118
17.02	**Falsification of entries in register, etc.** 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.	Section 119
17.03	**Unauthorized Claim of Patent Rights** 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.	Section 120
17.04	**Wrongful use of words, "Patent Office"** 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.	Section 121
17.05	**Refusal or failure to supply information** 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 (one million). Section 100(5) provides that any person including Government undertaking using a patented invention for the	Section 122 Form-27

	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 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	**Practice by non-registered persons** 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.	Section 123
17.07	**Offences by Companies** 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. 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. 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.	Section 124

Chapter 18: General Powers of Controller

18.01	**Powers of a Civil Court** 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: — 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.	Section 77 Rule 136 Order XLVII of CPC, 1908.
18.02	**Awarding Costs** 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	Section 77(1)(e) Rule 63, 136

	Controller may, in his discretion, award a compensatory cost in any proceeding before him which in his opinion is false or vexatious.	
18.03	**Review** a. Any person considering himself aggrieved by any order or decree 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. 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. c. An application for review shall be accompanied by a statement setting forth the grounds on which the review is sought. d. Where the decision in question concerns any other personin addition to the applicant, the Controller shall forthwith transmit a copy of each of the application and the statement to the other person concerned. 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	Section 77(1)(f). Rule 130. Form-4, 24. Section 114 & Order XLVII of CPC, 1908.

	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.	
18.04	**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, 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. While considering a petition under Rule 137, only such an irregularity is allowed to be obviated which is without detriment to the interests of any person. Further, only such amendments for which there is no special provision in the Act and which may be made without detriment to the interests of any person are allowable. Generally, a failure to Act within prescribed time shall not be considered as an irregularity which can be obviated under this Rule, as the Patents Act and Rules clearly mentions, wherever extensions are allowed	Rule 137. Nippon Steel Corporation Vs. Union of India, Delhi High Court W.P (C)801 of 2011. **Correction**: Highlighted text includes full citations, which were not previously mentioned.
18.05	**Mention of Inventor in Patent** If the controller is satisfied, upon a request or claim made in accordance with the provisions of this section — 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	Section 28. Rule 57, 58, 59, 60, 61, 62, 63. Form 8.

	substantial part of that invention; and ii) that the application for the patent is a direct consequence of his being the inventor, 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: 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 section shall be made before the grant of patent. 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. 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. 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 shall, so far as 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. 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:- -The inventor of this invention/substantial part of this invention within the meaning of section 28 of the Patents Act, 1970, is…of….	
18.06	**Directions Not Otherwise Prescribed** a. Where for the proper prosecution or completion of any 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	Rule 128

	specified in such notice. 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.	
18.07	**Exercise of Discretionary Power by the Controller** 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. 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. 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. 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. 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.	Section 80. Rule 129, 129A.
18.08	**Power of Controller to Correct Clerical Errors, etc.**	Section 78.

	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. 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. 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. d. Where a request is made 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. 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.	Rule 122.

	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 whom the request was made, and shall give to him and to the opponent an opportunity to be heard before he decides the case. 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.	
18.09	**Ex-parte decision** Before proceeding ex-parte against any party, the Controller shall issue a notice to the concerned party clearly stating therein that if the party fails to attend the hearing so fixed, he shall be proceeded ex- parte. Such notice shall be sent by Registered Post with acknowledgment due.	

Chapter 19: General Services

19.01	**General Services** a. Patent Office provides certain statutory and non-statutory services for the dissemination of information related to patent processing. b. It may be noted that references to some of these services have already been made in the relevant Chapters. c. These services are enumerated in the following paragraphs as per standards set by the Patent Office.	
19.02	**Official Journal** a. Every Friday the Controller publishes the Official Patent Journal electronically, which is made available on the official website of the Patent Office. b. The journal contains the following information: i. Section 11A publication, including early publication. ii. Withdrawal of Patent Applications. iii. Cessation of Patents. iv. Restoration of lapsed Patents. v. Post-Grant amendments. vi. Amendment of Patent granted to a deceased applicant. vii. Assignment after grant. viii. Post-Grant Oppositions. ix. Working of Patents. x. Revocation of Patents. xi. Compulsory Licences. xii. Rectification of Register by the Appellate Board. xiii. Details of Government use.	Section 145

	xiv. General matters. xv. Surrender of patents. c. Publications under the Designs Act form the last part of the Journal published.	
19.03	**Information relating to Patent Applications and Patents** 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: i. as to when a Complete Specification following a 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 xii.as to when any	Section 153. Rule 134.

	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. b. The report of the Examiner to the Controller under Section 12 is not open to public unless directed by a Court of Law. 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.	
19.04	**Inspection and supply of copies of documents** 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. 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. c. Request for inspection may be made in plain paper along with the prescribed fee. d. A person may obtain copies of any document open to public upon payment of the prescribed fee. e. Certified copy (as may be required for legal proceedings) of any document open to public may be obtained upon payment of prescribed fee. f. Register of Patents may be inspected during the	Section 72, 147, 154. Rule 27, 74A, 132, 133.

	working hours of the Patent Office by making a written application along with the prescribed fee. g. Certified copies of any entry in the Register is available upon the payment of prescribed fee. 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. i. Certified copies shall be furnished within a period of one week if such request is made along with the fee specified therefore in the First Schedule.	
19.05	**Annual report of the Patent Office** 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.	Section 155
19.06	**Information available at the Website** The official website provides the following information: a. Indian Patent Advanced Search System (inPASS) provides information on: i. Granted Patents; ii. Published Patent Applications; E-Register iii. Application/Documents Details	

	vi. Patent Application status. In addition, the following information is also available : • News & Events/ Circulars by the Controller General • Manuals/ Guidelines • Act & Rules. e-version • Controller's decisions d. • e- Journals • Dynamic utilities • List of registered Patent Agents. • Mobile App. A mobile App named "Intellectual Property 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. • A link for video conferencing on website. • h. Feedback system	

Chapter 20: Scientific Advisors

20.01	**Scientific Advisors** 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. 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.	Section 115
20.02	**Roll of Scientific Advisors** (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. (2) A person shall be qualified to have his name entered in the roll of scientific advisers, if he- (i) holds a degree in science, engineering or technology or equivalent; (ii) has at least fifteen years' technical, practical or research	Rule 103, 103A

	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. The Controller maintains a panel/list of scientific advisors for the purpose of Section 115. The panel/list is updated annually. The panel/list contains the names, addresses, specimen signatures and photographs of scientific advisors, their designations, information regarding their educational qualifications, the disciplines of their specialisation and their technical, practical and research experience. The panel/list is also accessible / made available on the official website of the Patent Office at url: www.ipindia.nic.in (3). Disqualifications for inclusion in the roll of scientific advisers A person shall not be eligible to be included in the roll of scientific advisors, if he (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	**Qualifications and procedure for empanelment / enrollment** a. Any person who- i. holds a degree in science, engineering, technology or equivalent; ii. has at least fifteen years' practical or research experience; and iii. holds or has held a responsible post in a scientific or technical department of the Central or State Government or in any other organization, is qualified to have his/her name entered in the panel/list/roll of scientific advisors. 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. b. Any person interested may apply at any time to the Controller for inclusion of his/her name in the roll of scientific advisors by furnishing his/her bio-data. c. The list/roll is updated and published annually.	Rule 103, 104,105, 106
20.04	**Removal from the roll/panel of Scientific Advisor** a. The Controller may remove the name of any person from the roll of scientific advisors, if— 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 iii. such person has been convicted for an offence and sentenced to a term of imprisonment or has been guilty	Rule 107

	of misconduct in his professional capacity and the Controller is of the opinion that his/her name should be removed from the roll: b. Before removing the name of any person from the roll of scientific advisors under this rule, such person shall be given a reasonable opportunity of being heard. (c) such person has been convicted of 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 name should be removed from the roll; or (d) such person is dead: Provided that except in the cases falling under clause (a) and (d) 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.	

Chapter 21: Miscellaneous provisions

21.01	**Affidavits** 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. 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. 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. 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. e. Affidavits shall be sworn to as follows: 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; 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 of1948); 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);	Section 79. Rule 126. Diplomatic and Consular Officers (Oaths and Fees) Act, 1948. Notifications u/s 14 of the Notaries Act, 1952.

	or before a Judge or Magistrate of the country or place. 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.	
21.02	**Exhibits** Where there are exhibits to be filed in an opposition matter or any 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.	Rule 127
21.03	**Officers and employees of Patent Office – Duties** 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— 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	**Hearing to be in public** 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	Rule 139

	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.	
21.05	**Agency – Power of Attorney** 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 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. 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. d. As a matter of practice, an application may be accepted without a Power of Attorney, for the purpose of saving priority. However, any subsequent papers can be filed only after submitting the required Power of Authority. The Office will not take any action if a Form-26 / authorisation of agent is not present on the record.	Rule 135. Form-26.

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

	Description	Time	Provision
1.	Proof of right to make an application	Six months from the date of filling 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) Rule 12(1A)
3.	Subsequent information corresponding to foreign filing	Six months from the date of filing of application outside India	Section 8(1)(a) 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	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 specification	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	Rule 24, 24A

		months from the date of filing or priority date, whichever is earlier, or within one month from the date of request for early publication.	
14.	Withdrawal of application to prevent publication	Fifteen months from date of filing or priority, whichever is earlier	Sec 11A(3)(c)
	Request for withdrawal of application	Any time before the grant of Patent	Sec 11B(4), Rule 26
	Request for withdrawal and refund of Fee	In case withdrawal is requested after filing the Request for examination but before issuance of FER, then the 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 11B Rule 24B
16.	Request for examination, where secrecy direction imposed	Forty eight months from the date of filing or priority or within sixth months from the date of revocation of secrecy direction, whichever expires later	Rule 24B(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, whichever expires later.	Rule 24B(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 24B(2)(ii)
19.	Controller disposes off the report of Examiner	Ordinarily within one month from the date of receipt of report	Rule 24B(2)(iii)
20.	First Examination Report (FER) sent by the Controller to applicant	Within one month from the date of disposal of the report of examiner by the Controller	Rule 24B(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 24B(5)
22	Extension Time for	Three months on a request in	Section

	complying with all requirements	Form 4 if requested before expiry of time prescribed under Rule 24B(5)	21(1) Rule 24B(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 (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(6)
27.	Notice of Opposition (post-grant opposition)	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 for filing abroad	Within a period of twenty-one days from the date of filing of such request	Section 39 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 in present	Section 39(1)
34.	Payment of first 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	Extendable by maximum six months	Section 142(4)

	years from date of filing		
36.	Time for payment of the renewal fee	Before the 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 on which the Patent ceased to have effect	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	Two months from the 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)

Annexures

Note: All annexures listed here need to be added to the Patent Office Manual. The Annxures consist of (1) Existing Guidelines, for e.g. for Biotechnology & Pharmaceuticals, as well as (2) Intended Guidelines, such as for Biologics, and (3) Procedural imperatives for examination, such as the Anti-Evergreening Checklist.

It is important to note here that ALL Guidelines for examination, regardless of field of technology, need updation and the opportunity for public comment and participation, especially as seen in a coherent form along with the Patent Office Manual, and the revised Patent Rules (pending). As such, the opportunity to include examination Guidelines within the formal boundaries of the Patent Office Manual should also be an opportunity for the IPO to seek fresh comment on every aspect of the coherently linked layers that make up the Indian patent system.

Existing Guidelines

Note: Existing Guidelines are linked to for brevity; however, while these Guidelines exist and are in force, they need to be opened to public consultation once more, as they have not been considered within the patent ecosystem as a whole, i.e. as a part of the Patent Office Manual, and alongside Patent Rules, and ultimately, the Indian Patents Act.

Annexure 1: Guidelines for Examination of Computer-related Inventions

Annexure 2: Guidelines for Processing of Patent Applications relating to Traditional Knowledge and Biological Material

Annexure 3: Guidelines for Examination of Biotechnology Applications for Patent

Annexure 4: Guidelines for Examination of Patent Applications in the field of Pharmaceuticals

Annexure 5: Draft Guidelines for Search and Examination of Patent Application

Intended Guidelines

Note: Intended Guidelines need to be developed, as well as be open to public consultation by all stakeholders before finalization and publishing

Annexure 6: Guidelines for Examination of Biologics

Procedural Imperatives for Examination

Note: The anti-evergreening checklist is referenced from the Patent Office Manual, and we include a sample of what an appropriate and efficiency-increasing checklist would look like.

Annexure 7: Anti-evergreening Checklist for Examiners

1.	Section 3(d): the mere discovery of a new form of a known substance	Yes	No
	If (1) is Yes, then whether Data on enhanced efficacy provided?	Yes	No
2.	Section 3(d): the mere use of a known process, machine or apparatus	Yes	No
	If (2) is Yes, then whether evidence is provided as per Act?	Yes	No
3.	Section 3(e): category of invention obtained by a mere admixture	Yes	No
	If (3) is Yes, then whether Data on synergistic effect provided?	Yes	No
4.	Section 3(d): the mere discovery of any new property or new use for a known substance	Yes	No
5.	Section 3(i): any process for the medicinal, surgical curative, prophylactic, diagnostic.	Yes	No