

HOW TO FILE A PATENT APPLICATION

Step 1:

An application for a patent in the prescribed form along with the prescribed fee should be filed in the appropriate office of the patent office (Indian patent offices are located at Delhi, Kolkata, Mumbai and Chennai). The patent application has to be filed in the appropriate office based on your/ yours company's location. An application for patent may be made by

- 1) The true and first inventor (a person who is first to convert the ideas and scientific principles into a working invention), either alone or jointly with another, or
- 2) His or their assignee
- 3) Legal representative of deceased inventor or assignee

The person who applies first for a same invention gets the patent. In case an inventor is first to invent but applies for a patent later any time after another inventor has made an application, he will not be entitled to get the patent. ***Every application for patent shall be for one invention only.***

Every application should state that the application is in the possession of the invention and should name the person claiming to be the true and first inventor.

Step 2:

The application should be accompanied by a provisional or complete specification. A provisional specification need describe the invention only briefly and need not contain the claims. Where an application is accompanied by a provisional specification, a complete specification shall be filed within 12 months from the date of filing of an application. If not filed within the prescribed time given, the application is deemed to be abandoned. The object of filing specification is to make available the invention to the public on expiry of term of patent.

Provisional specification is a specification which gives the initial description of an invention. It should contain drawing, if necessary. **Complete specification** gives the full and sufficient details of an invention in such a manner that a person skilled in the art can use the invention when he reads such

invention.

Claims shall be a precise legal statement of a technical fact and expresses in legal terms the scope of invention. The main claim should state what the invention is in the broadest form possible and permissible. The claims should be broad to avoid competitors trying to design around the patent.

Contents of specification

- 1) Every specification (provisional or complete) should describe the invention. begin with a title sufficiently indicating the subject matter to which the invention relates.
- 2) If necessary, drawing may be supplied for the specification
- 3) If the patent office requires that an application should be supplemented by a model or sample of anything illustrating the invention, the same should be furnished. The model or sample however is not deemed to form part of the specification
- 4) Every complete specification shall have fully and particularly describe the invention and its operation or use and the method by which it is to be performed. Disclose the best method of performing the invention. End with claim or claims defining the scope of invention. Be accompanied by an abstract to provide technical information on the invention. The claims of a complete specification shall relate to single invention.

Step 3:

Ordinarily no application for patent shall be opened to the public till the prescribed period. (18 months from the date of filing or date of priority whichever is earlier). The applicant may, in the prescribed manner, request the patent office to publish his application at any time before the expiry of 18 months from the date of filing. And within one month the patent office will publish the patent application in the public journal. The publication of the application will include the particulars of the date of application, application number, name and address of the applicant along with the abstract.

After the publication of the application within the prescribed period a request for examination of application should be made by the applicant or the interested person failing which the application will be treated as withdrawn. No application for a patent will be examined if no request is made by the applicant or any other interested person in the prescribed manner and within the prescribed period. It shall be made within a period of 48 months from the date of filing application.

The examiner in the patent office shall make the report stating objections and requirements within 1 month and not exceeding 3 months and send it to the applicant. The objections, generally relate to the drafting of the specifications and claims, anticipation of any of the claims in the prior publication of any specification or claims, or documents. The applicant has to submit his reply to the report within 12 months. If the applicant is required to comply with some requirements, he shall do the same within a period of 12 months from the time the statement of objection and requirement was communicated.

When the applicant has satisfactorily removed the official objection (if any) the patent office will accept the complete specification and advertise it in the public journal. From the date of acceptance to the date of grant of the patent the applicant will get the benefits of the grant except that he will not be entitled to institute infringement proceedings until the patent is granted.

Step 4:

A person interested may give notice of opposition within three months from the date of publication in the public journal. The patent office will then send a notice of opposition to the applicant who may file a reply statement within one month from the date of receipt of the copy. The parties may file their evidence in support of their respective cases and the matter will be heard and decided.

Pre- grant opposition by any person before grant of patent

- 1) the applicant for the patent wrongfully obtained the invention or any part thereof from him or from a person under or thorough whom he claims
- 2) prior publication in any Indian specification or prior publication in any other document in India or elsewhere
- 3) The invention has been the subject matter of a prior claim in an application, which is prior in time that the applicants claim.
- 4) That the invention as claimed in the complete specification was publically know or used in India
- 5) The applicant's invention in his complete specification is obvious and clearly does not involve any inventive step or industrial application.
- 6) The complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed.
- 7) The complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention
- 8) The invention is in the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.

Post Grant opposition

- 1) At any time after the grant of patent but before the expiry of one year from the date of publication of grant of patent, any person interested may give notice of opposition to the patent office, on any grounds.
- 2) Where any such notice of opposition is duly given, the Patent office shall notify the patentee (inventor) and shall constitute a board, and refer such notice of opposition along with the documents for examination and submission of its recommendations to the Office.
- 3) The Board, after giving the patentee and the opponent, an opportunity of being heard, shall submit its recommendations to the Office, and the Office shall order either to maintain, or to amend, or to revoke the patent. Though while passing an order, the controller shall not take into account any personal document or secret trial or secret use.

Step 5:

Where the application is accepted either without opposition or after opposition, a patent will be granted if a request for sealing is made by the applicant. After the publication of grant, the application, specification and other documents shall be open for public inspection upon a written request and upon payment of fee.

The patentee (applicant) if so desires, may make a request for mentioning his name in the patent. The patent office when satisfied will cause his name to be mentioned as an inventor in the patent granted, in the complete specification and in the register of patents. The mention of the inventor's name in the patent will not confer, or derogate from, any rights under the patent.

Date of patent shall be dated as of the date on which the application for patent was filed.

The term of every patent is 20 years in India from the date of filing of application. The patent shall cease to have effect on the expiration of the period prescribed for the payment of any renewal fee, if the renewal fee is not paid within prescribed period or within such extended period as prescribed.

Patent of addition

In respect of any improvement in or modification of a previous invention already patented, a patent called the patent of addition may be obtained. The term of the patent of addition will run concurrently and terminate with the main patent. No renewal fee is payable so long as the main patent remains in force.

Cost of filing Patent in India

S.No	Description	Fees (INR)	Time line
1	Filing of provisional specification	1000	
2	Filing of complete specification	1000 (if no provisional specification)	Within 12 months from date of filling provisional specification
3	For each sheet in addition to 30	100 per page	
4	For each claim in addition to 10	200 per claim	
5	Early publication fee	2500	The application is published within one month from the date of such request
6	Request for examination of patent application	2500	Forty eight months from the date of filing or priority, whichever is earlier

- A fee of INR 1000 for natural person has to be paid while submitting the patent application in the Indian patent office (IPO).
- In order to speed up the patent process in IPO, the applicant has to request for early publication, a request for early publication made in form 9 with prescribed fee of INR 2500 for a natural person. If this request is not made, then the IPO publishes your patent application after 18 months from priority date.
- Once the patent application is published, the applicant immediately can apply requesting for examination process. A fee of INR 2500 has to be paid, requesting the IPO to examine your patent application. The IPO puts your application in queue for examination only after receiving this fee. Hence, if you want to accelerate the patent process, it is advisable to pay this fee at the earliest.

- Apart from depositing the official fee for getting the patent, one has to deposit patent maintenance fee from time to time to keep patent active during its term of 20 years.

Rights of the Patentee

- 1) When the subject matter of the patent is a product, the exclusive right to prevent the third parties, who do not have patentee's consent, from the act of making, using, offering for sale, selling or importing for those purposes that product in India.
- 2) When the subject matter of patent is process, the exclusive right to prevent the third parties, who do not have the consent, from the act of using that process, and form the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India.