

**2024**

## **FREQUENTLY ASKED QUESTIONS- PATENTS**

**Disclaimer:-**The replies given to the probable questions are for the purpose of guiding public and cannot be quoted in any legal proceedings. They will have no legal purpose. The users are advised to refer to the provisions of the Patents Act 1970 as amended and the Patents Rules 2003 as amended including the latest fee schedules, available at [www.ipindia.gov.in](http://www.ipindia.gov.in)

**GENERAL INFORMATION:**

### 1. What is a Patent?

A Patent is a statutory right for an invention granted for a limited period of time to the patentee by the Government, in exchange of full disclosure of his invention for excluding others, from making, using, selling, importing the patented product or process for producing that product for those purposes without his consent.

### 2. What is the term of a patent in the Indian system?

The term of every patent granted is 20 years from the date of filing of application. However, for application filed under national phase under Patent Cooperation Treaty (PCT), the term of patent will be 20 years from the international filing date accorded under PCT.

### 3. Which Act governs the patent system in India?

The patent system in India is governed by the Patents Act, 1970 (No.39 of 1970) as amended by the Patents (Amendment) Act, 2005 and the Patents Rules, 2003. The Patent Rules are regularly amended in consonance with the changing environment, most recent being in 2024.

### 4. Does Indian Patent give protection worldwide?

No. Patent protection is a territorial right and therefore it is effective only within the territory of India. There is no concept of global/world patent.

However, filing an application in India enables the applicant to file a corresponding application for same invention in convention countries or under PCT, within or before expiry of twelve months from the filing date in India. Patents should be obtained in each country where the applicant requires protection of his invention.

### 5. What can be patented?

An invention relating either to a product or process that is new, involving an inventive step and capable of industrial application can be patented. However, it must not fall into the categories of inventions that are non- patentable under sections 3 and 4 of the Act.

### 6. What are the criteria of patentability?

An invention is patentable subject matter if it meets the following criteria –

- i) It should be novel.
- ii) It should have inventive step.
- iii) It should be capable of Industrial application.
- iv) It should not attract the provisions of section 3 and 4 of the Patents Act 1970.

### 7. What types of inventions are not patentable in India?

An invention may satisfy the condition of novelty, inventiveness and industrial applicability but it may not qualify for a patent under the following situations:

- 1) an invention which is frivolous or which claims anything obviously contrary to well established natural laws;

- 2) an invention the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment;
- 3) the mere discovery of scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature;
- 4) the mere discovery of a new form of a known substance which does not result in 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;

**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 regards to efficacy;

- 5) a substance obtained by mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;
- 6) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;
- 7) a method of agriculture or horticulture;
- 8) any process for 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;
- 9) plants and animals in whole or any part thereof other than microorganisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;
- 10) a mathematical or business method or a computer program per se or algorithms;
- 11) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;
- 12) a mere scheme or rule or method of performing mental act or method of playing game;
- 13) a presentation of information;
- 14) topography of integrated circuits;
- 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;
- 16) inventions relating to atomic energy;

#### 8. When should an application for a patent be filed?

An application for a patent can be filed at the earliest possible date and should not be delayed. An application filed with provisional specification, disclosing the essence of the nature of the invention helps to register the priority of the invention. Delay in filing an application may entail some risks such as (i) some other inventor may file a patent application on the said invention and (ii) there may be either an inadvertent publication of the invention by the inventor himself/herself or by others independently of him/her.

9. Can any invention be patented after publication or display in the public exhibition?

Generally, an invention which has been either published or publicly displayed cannot be patented as such publication or public display leads to lack of novelty. However, under certain circumstances, the Patents Act provides a **grace period of 12 months** for filing of patent application from the date of its publication in a journal or its public display in an exhibition organised by the Government or disclosure before any learned society or published by applicant. The detailed conditions are provided under Chapter VI of the Act (Section 29-34).

10. Does the Patent Office keep information of the invention secret?

Yes. All the patent applications are kept secret upto publication of the application in the Official Journal of the Patent Office, which is published every week and also available on the IPO website. After its publication, public can inspect the documents and also may take the photocopy thereof on payment of the fee as prescribed.

11. Is it necessary to visit the Indian Patent Office to transact any business relating to patent application?

It is not necessary to visit the patent office to file the application as online filing facility is provided. Only in case the application is required to be filed offline, the same can be filed physically at the counter of the Office or can be sent by post to the Patent Office. Moreover, all the communications by the office are made through emails.

12. Where can one find the information relating to published/ granted patent application?

The information relating to the patent application is published in the Patent office Journal issued on every Friday. This is also available in electronic form on the website of the Patent Office, [www.ipindia.gov.in](http://www.ipindia.gov.in)

13. What are the contents of the Patent office Journal?

The Patent office Journal contains information relating to patent applications which are published u/s 11A, post grant publication, restoration of patent, notifications, list of non-working patents and public notices issued by the Patent Office.

14. Can one subscribe a copy of the Patent office Journal?

There is no need to subscribe the Patent Office journal as same is published online and is available free of cost on patent office site i.e. [www.ipindia.gov.in](http://www.ipindia.gov.in)

## **FILING RELATED INFORMATION:**

15. Who can apply for a patent?

A patent application can be filed either by true and first inventor or his assignee, either alone or jointly with any other person. However, legal representative of any deceased person can also make an application for patent.

16. How can I apply for a patent?

A patent application can be filed with Indian Patent Office either with provisional specification or with complete specification along with fee as prescribed in schedule I.

In case the application is filed with provisional specification, then one has to file complete specification within 12 months from the date of filing of the provisional specification. There is no further extension of time to file complete specification after expiry of said period.

17. Is there provision for filing patent application electronically by online system?

Yes, one can file patent applications through comprehensive online filing system at <https://ipronline.ipindia.gov.in/epatentfiling/goForLogin/doLogin>. More information for filing online application is available on the website of Patent Office i.e. [www.ipindia.gov.in](http://www.ipindia.gov.in).

18. How can one register for online filing of patent application?

To register for filing of patent application, the applicant can use DSC or E-sign as per their conveniences. If user wants to use DSC then the user is required to obtain the Class II/III digital signature without Encryption from the authorized vendors and the list of vendors is given in below table. User can visit the E-filing website where the whole information is available. These are the website links for the information about

a) Regarding information for use of DSC is available Digital Signature([https://ipronline.ipindia.gov.in/epatentfiling/Extras/Digital\\_Signatures\\_Information.aspx](https://ipronline.ipindia.gov.in/epatentfiling/Extras/Digital_Signatures_Information.aspx) )

b) General FAQs(<https://ipronline.ipindia.gov.in/epatentfiling/faqs/index.html> )

c) Component (User can download the component by clicking on component)

d) Digital signature manual  
(<https://ipronline.ipindia.gov.in/epatentfiling/UsefullDownloads/DSCManual.pdf> )

If user wants to use E-signature then the complete information is available under different tabs. The user will have to procure the E-sign from the authorized vendor using Aadhar number or PAN number. These are the website links for the information about

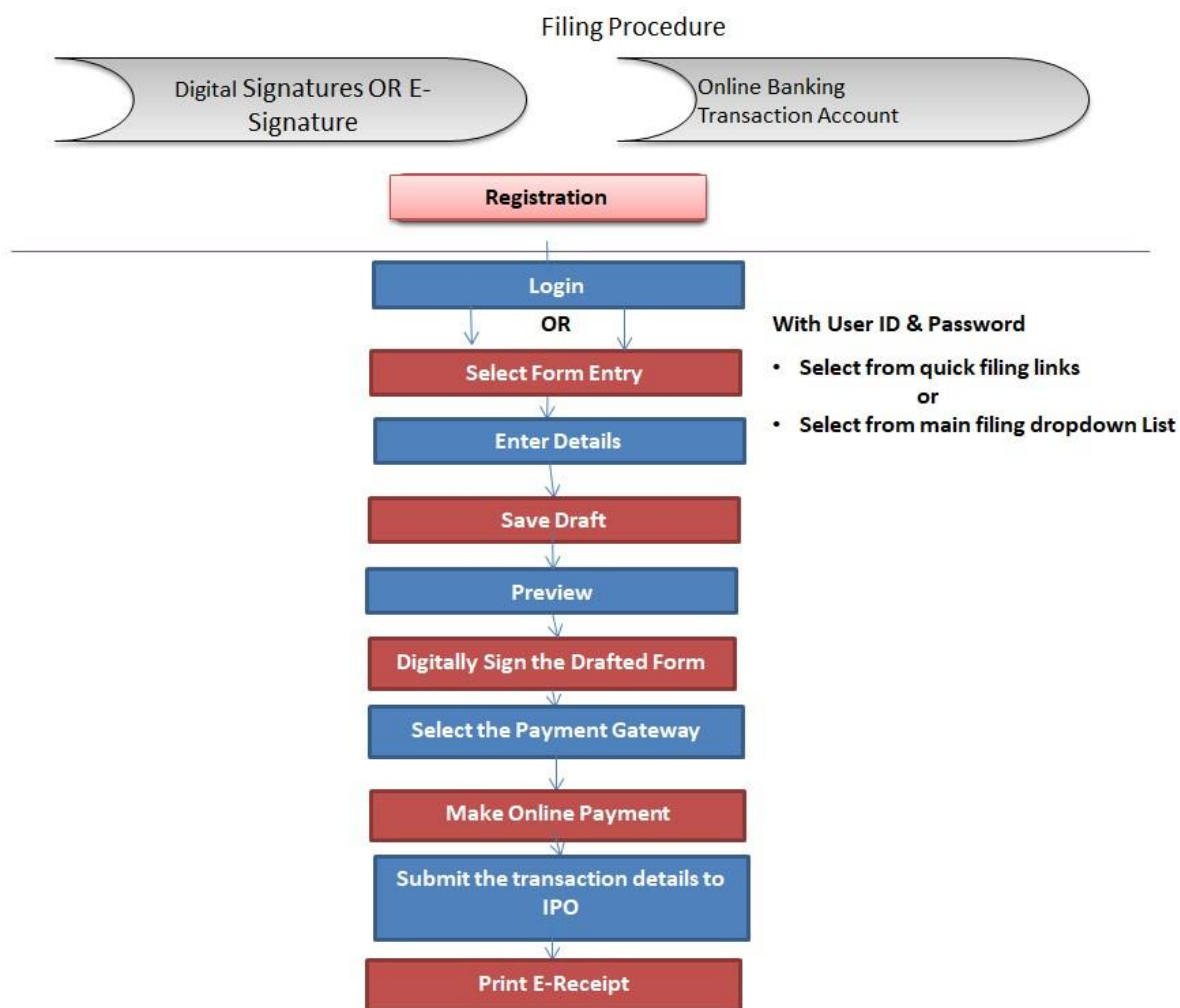
a) E-sign Introduction -  
<https://ipronline.ipindia.gov.in/epatentfiling/Extras/FAQESign.aspx>

b) Registration and installation details -  
<https://ipronline.ipindia.gov.in/epatentfiling/Extras/RegistrationSteps.aspx>

c) Web URL to procure E-sign for individual or Organization -  
<https://app.emudhra.com/createNewUser.jsp?src=c44ead5fdecd48ecac24f>

After obtaining the digital signature or the E-sign, the user can register herself/himself on the Patent Office website by creating user ID and password. User can login using user id and password. After logging into the e-filing account user can select any form fill all the details save the draft, then upload the all the relevant documents then go for Esigning through DSC or E-sign as the case may be. After digitally signing all the documents will be reflected under the “payment” Tab. User can click on payment tab and select the particular form to make payment. After making payment an acknowledgement receipt would be

generated for the successful filing of the form or document. All the previously drafted forms are available under tab “Form History” and then under the “Drafted forms” Tab and if user discarded some forms that are available under the “Discarded Forms”. User can find all the previously drafted forms using the particular date range. User can update the mobile number and email through e-filing module under the Tab “User Panel”.



#### 19. How to obtain digital signature?

The digital signatures can be obtained from the certifying authorities empaneled by Controller of Certifying Authorities of India and who are integrated with the e-filing system of Patent Office. List of such CAs is available on the website of Controller General of Patents, Designs & Trade Marks ([www.ipindia.gov.in](http://www.ipindia.gov.in)) and include:

Vendor	URL:
Vendor's list along with their URL	<a href="https://ipronline.ipindia.gov.in/patentfiling/faqs/index.html">https://ipronline.ipindia.gov.in/patentfiling/faqs/index.html</a>
	<a href="https://app.e-mudhra.com/createNewUser.jsp?src=c44ead5fdecd48ecac24f">https://app.e-mudhra.com/createNewUser.jsp?src=c44ead5fdecd48ecac24f</a>

20. In which language can an application for patent be filed with the Indian Patent Office?

An application for patent can be filed either in Hindi or English.

21. Is there any jurisdiction for filing patent application in India?

Yes, India has four patent offices located at Chennai, Kolkata, Mumbai and New Delhi. Each office has a separate territorial jurisdiction. The appropriate office for all proceedings including filing of the application depends normally where the applicant/first mentioned applicant resides/has domicile/has place of business/has origin of invention. In case of foreign applicants, it depends on the address for service in India given by such applicant.

22. When can an applicant withdraw patent application in India?

An applicant can withdraw the application any time before the grant of patent by making a request. There is no fee for withdrawing the application. The applicant has to file form 29 for withdrawal of application.

If a request for the withdrawal of the application is filed within 15 months of the date of filing or date of priority, whichever is earlier, the application will not be published and be treated as withdrawn.

If an application is withdrawn before the issuance of the First Examination Report a refund of up to 90% of examination fees can be claimed.

23. What are the types of applications?

The types of applications that can be filed are:

#### A) ORDINARY APPLICATION

An application for patent filed in the Patent Office without claiming any priority either in a convention country or without any reference to any other earlier application under process in the office. Such type of application is known as an ordinary application.

Ordinary application can be filed by way of filing

(i) Provisional specification: Indian Patent Law follows first to file system. A provisional specification can be filed if the invention is still under experimentation stage. Filing a provisional specification provides the advantage to the inventor since it helps in establishing a priority date of the invention. Further, the inventor gets 12 months' time to fully develop the invention and ascertain its market potential and to file the complete specification.

(ii) Complete specification: An applicant may directly file the complete specification if the invention is fully developed.

#### B) CONVENTION APPLICATION

An application for patent filed in the Patent Office, claiming a priority date based on the same or substantially similar application filed in one or more of the convention countries is known as a convention application. In order to get convention status, an applicant should file the application in the Indian Patent Office within 12 months from the date of first filing of a similar application in the convention country.

### C) PCT INTERNATIONAL APPLICATION

An Application filed in India as Receiving Office (RO) under Patent Cooperation Treaty is an international application which can be considered as deemed filed in more than 150 countries (member of PCT) by a single application.

### D) PCT NATIONAL PHASE APPLICATION

When an international application is made according to PCT designating India, an applicant can file the national phase application in India within 31 months from the international filing date or the priority date, whichever is earlier.

### E) PATENT OF ADDITION

where an application is made for a patent in respect of any improvement in or modification of an invention described or disclosed in the complete specification filed therefor for which he has already applied for or has obtained patent, the applicant can go for patent of addition if the improvement or modification in the invention is new. One of the benefits of filing patent of addition is that there no need to pay separate renewal fee for the patent of addition during the term of the main patent and it expires along with the main patent.

### F) DIVISIONAL APPLICATION

When an application claims more than one invention, the applicant on his own or to meet the official objection on the ground of plurality or distinct invention may divide the application and file a further application, as the case may be for each of the inventions. This type of application, divided out of the parent one, is known as a Divisional Application. The priority date for all the divisional applications will be same as that of the main (the Parent) Application (Ante-dating).

24. Is it necessary to file a provisional specification?

Generally, when an invention is not complete, an application can be filed with provisional specification. This is useful in establishing a priority date for your invention. Moreover, it also gives sufficient time to the applicant to assess and evaluate the market potential of his invention before filing complete specification. However, it is not necessary to file an application with provisional specification and one can file application directly with complete specification.

25. When is an application for patent published?

Every application for patent is published after expiry of 18 months from the date of its filing or priority date whichever is earlier. However, following applications are not published.

A) Application in which secrecy direction is imposed

B) Application which has been abandoned u/s 9(1) and i.e when a provisional application has been filed and the complete application has not been filed within 12 months from the filing of the provisional specification



C) Application which has been withdrawn 3 months prior to 18 months

26. Is there any provision in the Patents Act for early publication?

Yes, the applicant can make a request for early publication in Form 9 along with the prescribed fee. After receiving such request the Patent Office ordinarily publishes such application within a period of one month provided that secrecy direction is not imposed on the said application.

27. What are the facilities available for an applicant to pay the fees?

The applicant can pay the fee either at cash counter by cash, banker's cheque or by Demand draft or UPI or pay online through a comprehensive payment gateway which includes net banking, payment by Debit/Credit card/UPI.

User can use only the integrated comprehensive payment gateway (BharatKosh) of Non-Tax Receipt Portal (NTRP) of Govt. of India for Payment of Fees on portal. The gateway provides payment options of internet banking of multiple banks, UPI and Credit/debit cards payment options.

Note: The payment gateway is not available between 23:00 HOURS and 00:30 HOURS in the e-filing module due to bank reconciliation process.

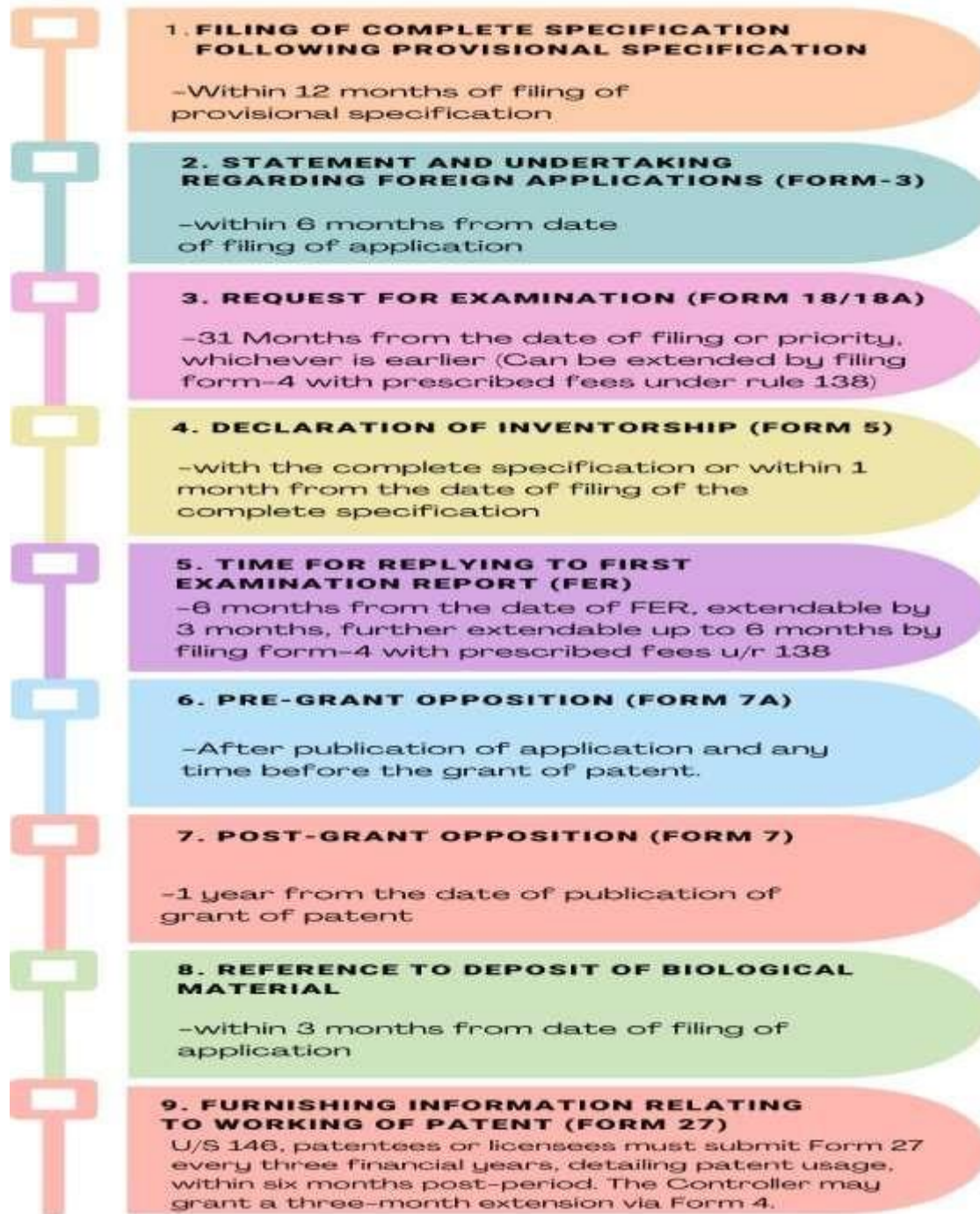
28. What are the forms required to be filled for filing a patent application in India?

Generally, in order to file an application, an applicant is required to file Form 1 which is a request for filing an application and Form 2 which is either a provisional or complete specification with drawings, if any. In addition to these, an abstract of the invention is also required. If the application is filed through a registered patent agent, a power of authority in favour of the said agent in Form 26 is also required. The application can be examined only after receipt of request for examination on Form 18/18A. The complete list of forms is available on the website [www.ipindia.gov.in](http://www.ipindia.gov.in)

29. What time lines are to be adhered to while prosecuting a patent application

in India? Following are some of the important time lines during the prosecution of a patent application.

# TIMELINE



30. Is patent application once filed examined automatically?

A patent application is not examined automatically after its filing. The examination is done only after receipt of the request of examination in Form 18 either from the applicant or from third party or Form 18A for expedited examination (under conditions as prescribed in the Rule 24C of the Patents Rules 2003 as amended.)

31. When can the request for examination be filed?

The request for examination can be filed within a period of 31 months from the date of priority or date of filing of the application whichever is earlier. For more details kindly refer to rule 24B and 24C of the Patents Rules 2003 as amended.

32. Is there any provision for expedited examination?

Yes, as per Rule 24C of the Patent Rules as amended in 2016, a request for expedited examination can be filed with the prescribed fees in Form 18A along with the fee as specified in the first schedule only by electronic transmission duly authenticated within the period prescribed in rule 24B on any of the following grounds, namely:

- a) that India has been indicated as the competent International Searching Authority or elected as an International Preliminary Examining Authority in the corresponding international application.
- b) that the applicant is a startup
- c) that the applicant is a small entity
- d) that the applicant is a natural person or in the case of joint applicants, all the applicants are natural persons, then applicant or at least one of the applicants is female
- e) that the applicant is a department of the Government
- f) that the applicant is an institute established by a Central, Provincial or State Act, which is owned or controlled by the Government
- g) that the applicant is a Government company as defined in clause (45) of section 2 of the Companies Act, 2013 (18 of 2013)
- h) that the applicant is an institution wholly or substantially financed by the Government
- i) that the application pertains to a sector which has been notified by the Central Government, on the basis of a request from the head of department of the Central Government
- j) that the applicant is eligible under an arrangement for processing a patent application pursuant to an agreement between Indian Patent Office and a foreign Patent Office

33. What happens to a patent application once it is examined?

After examination, the Patent office issues an examination report to the applicant which is generally known as First Examination Report (FER). Thereafter the applicant is required to comply with the requirements within a period of 6 months from the date of FER which can be extended by 3 months which can be further extended upto 6 months by filing form-4 with prescribed fees under rule 138 as amended by the patents amendment rules, 2024. In case, the application is found to be in order for grant, the patent is granted, provided there no pre-grant opposition is filed or pending. A letter patent is issued to the applicant. However, in case a pre-grant opposition is pending, the further action is taken after disposition of the pre-grant opposition.

34. What happens when applicant is not able to meet the requirement within the prescribed time?

If the applicant does not file a reply within 6 months or does not take an extension of 3 months rule 24(6) (plus up to 6 months by filing form-4 with prescribed fees under rule 138), the application is deemed to have been abandoned.

35. Is there provision for extension beyond time limit of 9 months?

Yes, It can be further extended upto 6 months by filing form-4 with prescribed fees under rule 138 as amended by the patents amendment rules, 2024

36. Does an applicant get an opportunity of being heard before his application is refused?

If applicant has not complied with the requirements within the prescribed time, the Controller shall provide an opportunity of being heard to the applicant before refusing his application if a request for such hearing has been made by the applicant at least 10 days in advance before expiry of the statutory period.

37. What is time limit for filing the representation for pre-grant opposition?

A representation for pre-grant opposition under section 25(1) of Patents Act, 1970 can be filed, on Form 7A at any time before the grant of patent.

38. Is there any fee for filing such representation for pre-grant opposition?

This can be filed by any person. There is fees for the Pre-grant opposition as mentioned in First Schedule of Patent Rules, 2003 (as amended by patent amendment rules, 2024).

39. What are the grounds for filing representation for pre-grant opposition?

The grounds for filing pre-grant opposition are contained in section 25(1) of the Patents Act 1970.

40. Is it possible to file pre-grant opposition even though there is no request for examination filed?

Yes, it is possible to file representation for pre-grant opposition even though there is no request for examination has been filed. However, the representation will be considered only when a request for examination is received within the prescribed period.

41. What is the time limit for filing post-grant opposition in the patent office?

The time for filing post-grant opposition is 12 months from the date of publication of the grant of patent in the official journal of the patent office.

42. Is there any fee for filing post-grant opposition?

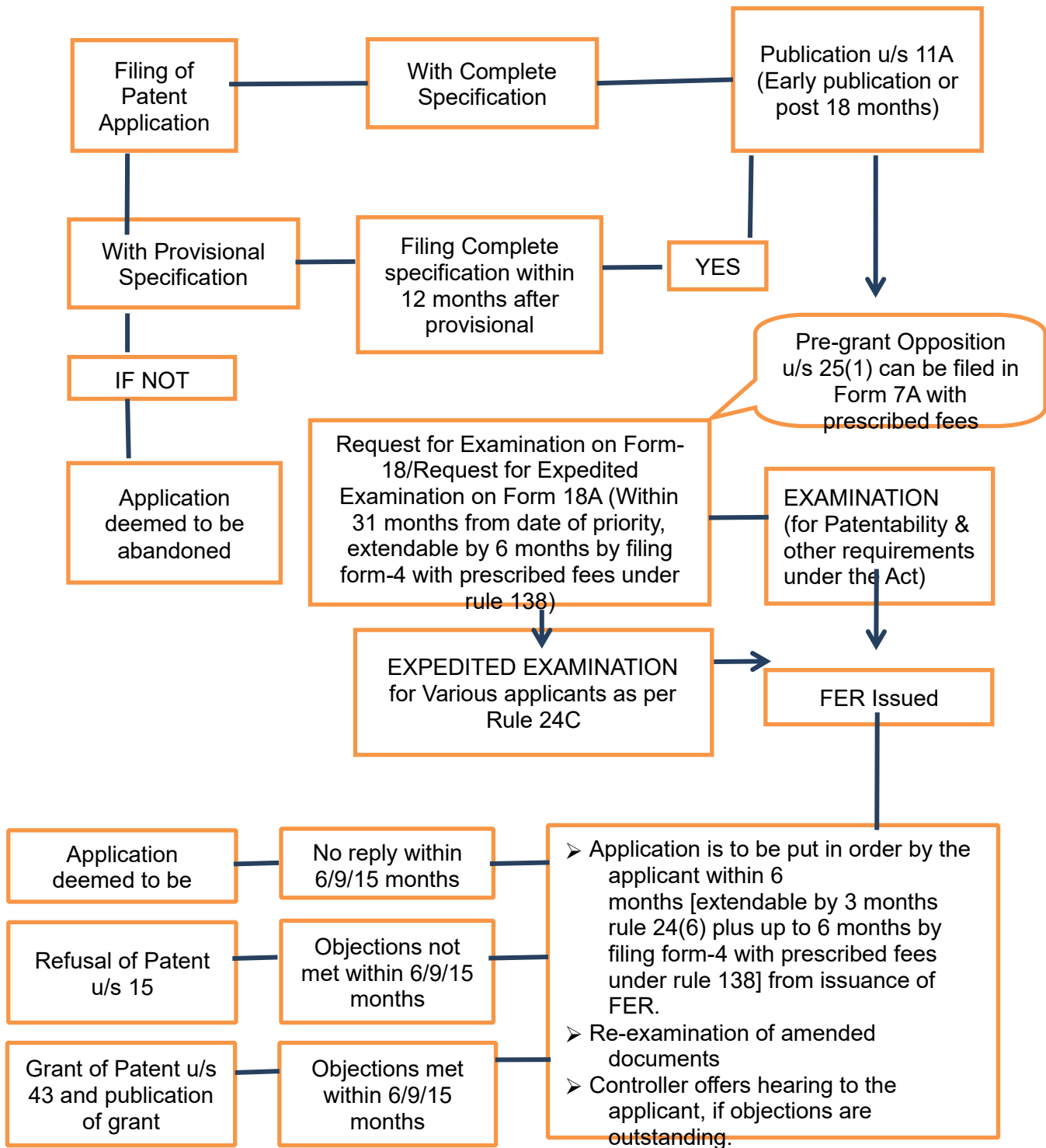
Yes, the post grant opposition has to be filed in the prescribed Form 7 along with prescribed fees as mentioned in First Schedule in Patents Rules 2003. The post grant opposition has to be filed by the person interested and not by any other person.

43. What are the grounds for filing the post grant opposition?

The grounds for filing post-grant opposition are contained in section 25(2) of the Patents Act 1970.

## **LIFE CYCLE OF A PATENT APPLICATION**

## Patent Flow Chart



### OTHER INFORMATION:

44. What are the e-filing facilities available at

<https://ipronline.ipindia.gov.in/epatentfiling/goForLogin/doLogin> ?

The following are the e-filing facilities available for an applicant:

- Comprehensive e-filing facility for Patents and Designs,

- Comprehensive payment gate way including net banking, payment by Debit/Credit card/UPI
- Web based Simple Registration process and filing procedure
- Real time Validations with IPO Patent database
- Manage User Profile and Folders
- 10% fee reduction on online filing compared to offline filing to promote online filing.
- Request for expedited examination, sequence listing, pre grant Opposition, Post grant Opposition, Transmittal fee for international application (for ePCT filing), and Preparation of certified copy of priority document and e-transmission through WIPO DAS- only through e-filing

45. Does patent office help in finding users for patent?

The Patent Office has no role beyond grant of patent. Since patents are private rights the patent owner is responsible for commercializing the patent either himself or through licensee. However, the information relating to grant of patent is published in the Patent Office journal and also published on the Patent Office website which is accessible to the public worldwide. This may help the applicant to attract potential user or licensee. The patent office also compiles and updates a list of patents which are lapsed / ceased in India.

46. Is Indian patent database searchable? How can one find out whether an invention is already patented?

The person concerned can perform a search free of cost on Indian Patent database consisting of published patent applications and granted patents. The said database is available on Patent Office website as **inPASS** <https://iprsearch.ipindia.gov.in/publicsearch>. Further, the website ([www.ipindia.gov.in](http://www.ipindia.gov.in)) contains innovative tools under **DYNAMIC UTILITIES** which gives information about the patent applications at various stages of processing.

47. Is there any difference in the amount of fees to be paid by an individual or a legal entity for filing a patent application?

Yes, the Patent Rules provides for different fee for individuals/Startups, SME's and legal entity. Details can be seen in the [First Schedule](#) of the Patents Rules, 2003 as amended from time to time.

48. What are obligations of the patentee after the grant of patent?

After the grant of patent, every patentee has to maintain the patent by paying renewal fee every year as prescribed in the [First Schedule](#). For first two years, there is no renewal fee. The renewal fee is payable from 3rd year onwards. In case the renewal fee is not paid the patent will be ceased.

49. Can the patentee pay renewal fee at a time or has to pay every year?

The patentee has choice to pay the renewal fees every year or he can pay in lump sum as well. The annual renewal fees payable in respect of two or more years may be paid in

advance: Provided that where the renewal fees is paid in advance through electronic mode for a period of at least 4 years, a ten per cent reduction in fee shall be applicable for such renewal.

50. When can a patent be restored after its cessation?

A request for restoration of patent can be filed within 18 months from the date of cessation of patent along with the prescribed fee. After receipt of the request the matter is notified in the official journal for further processing of the request.

51. What is meant by patent agent and what are the eligibility criteria of becoming a patent agent?

A Patent agent is a person registered with Indian Patent Office whose name is entered in the patent agent register after being declared qualified in the patent agent examination conducted by the patent office and who 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 proceeding before the Controller under this Act.

52. Eligibility conditions for registration as patent agents are below.-

A person shall be qualified to have his name entered in the register of patent agents if he fulfills the following conditions, namely—

(a) he is a citizen of India;

(b) he has completed the age of 21 years;

(c) he has obtained a degree in science, engineering or technology from any university established under law for the time being in force in the territory of India or possesses such other equivalent qualifications as the Central Government may specify in this behalf,

and, in addition,—

i) has passed the qualifying examination prescribed for the purpose; or

ii) has, for a total period of not less than ten years, functioned either as an examiner or discharged the functions of the Controller under section 73 or both, but ceased to hold any such capacity.

53. Is it necessary to engage a registered patent agent for filing an application for patent?

It is not necessary under the patent law to engage a registered patent agent for filing an application for patent. The applicant is free to file an application by himself or through the patent agent. However, an applicant who is not a resident of India is required to file either through the registered patent agent or must give an address for service in India

54. Does the Patent Office help to select a patent attorney or agent to make patent search or to prepare and prosecute patent application?

No, Patent Office does not make any recommendations regarding selection of a patent agent. However, a list of patent agents is maintained by the office. This list can also be viewed at Patent Office website. The applicant is free to appoint any patent agent from the said list.

55. Does the patent office ascertain fees charged by the patent agents for their services?

No. This is a matter between the applicant and the patent agent. The Patent Office has no role in ascertaining the fee charged by a patent agent. However, for assisting startups to file the patent applications, the Patent Office has enrolled the facilitators and prescribed a certain limit of fee reimbursement to be paid to the facilitators under the SIPP scheme. The details of the scheme can be seen on [www.ipindia.gov.in](http://www.ipindia.gov.in).

56. Is it mandatory to obtain prior permission from the Patent Office to file application for patent outside India?

Yes, it is mandatory for Indian resident to obtain prior permission from the Patent Office to file application for patent outside India.

Ordinarily, under the following circumstances, it is not necessary to obtain prior permission from the Patent Office to file patent application outside India:

- a) Applicant is not Indian resident ,
- b) If the applicant is Indian resident and first filed patent application in India, then after six weeks from the filing of such application file an application for the same invention outside India and no secrecy direction is invoked u/s 35 of the Act in relation to that application, c ) if the invention for which an application for protection has first been filed in a country outside India by a person resident outside India,

57. Under what circumstances, it is necessary to obtain a prior permission from the Patent Office?

Residents of India require prior permission to apply for patents outside India under section 39 of the Patents Act, 1970 under following circumstances:

- (a) The applicant or inventor is Indian resident,
- (b) Applicant does not wish to file patent application in India prior to filing outside India.
- (c) If the applicant is Indian resident, a patent application has been filed in India and six weeks period is not yet over from that date

It may be noted that if the invention is relevant for Defence or Atomic Energy purpose, no permission shall be granted without the consent of Central Government.

58. Is there any additional requirement for filing of patent applications in respect of microbiological inventions?

In addition to the various forms required to be filed at the time of filing the patent application, the applicant is also required to deposit the new strain of a microorganism used in the invention (if it is not described in the specification in such a way as to satisfy



clauses (a) and (b) of section 10(4) of the Patents Act and if such material is not available to the public), in a recognized depository which assigns a registration number to the deposited microorganism, before filing for the patent application. This number needs to be quoted in the patent application.

59. Are there any specific instructions to inventors in respect of filing for patent applications where their invention lies in biological material?

The Patents Act, 1970 as well as the Biological Diversity Act, 2002 stipulates that the source and geographical origin of the biological material should be clearly disclosed in the patent specification. Further, according to the provision of Section 6 of the Biological Diversity Act, if the biological material used in the invention is from India, permission from the National Biological Authority has to be obtained by the applicant, and the same should be submitted to the Patent Office before the grant of patent.

60. Is it essential to deposit biological material in the international depository authority?

If the invention uses a biological material which is new and not described in the specification in such a way as to satisfy clauses (a) and (b) of section 10(4) of the Patents Act and if such material is not available to the public, it is essential to deposit the same in the International Depository Authority (IDA) prior to the filing of the application in India in order to supplement the description. The description in the specification should contain the name and address of the International Depository Authority and, date and number of deposition of Biological material. If such biological material is already known, in such case it is not essential to deposit the same. For more details log on to [www.ipindia.gov.in](http://www.ipindia.gov.in)

61. Is there any International Depository Authority in India? Yes, there are three International Depository Authorities in India

1. Microbial Culture Collection (MCC), National Centre for Cell Science (NCCS), Savitribai Phule Pune University Campus, Ganeshkhind, Pune-411007 (Web site <http://www.nccs.res.in>)
2. Microbial Type Culture Collection and Gene Bank (MTCC), Institute of Microbial Technology (IMTECH), Council of Scientific and Industrial Research (CSIR), Sector 39-A, Chandigarh - 160 036 (Web site <https://mtccindia.res.in>)
3. National Agriculturally Important Microbial Culture Collection (NAIMCC), ICAR National Bureau of Agriculturally Important Microorganisms, Kausi, Mau Nath Bhanjan 275 103, Uttar Pradesh (Web site <https://nbaim.icar.gov.in>)

62. Under what circumstances fees paid can be refunded?

As per the Patents (Amendment) Rules 2016, sub-rule (4) of rule 7 provides that if the Controller is satisfied that during the process of online payment, the fees was paid more than once for the same proceedings, the excess fees shall be refunded.

The newly inserted sub-rule 4A provides that in case of withdrawal of patent applications for which request for examination has been filed but first statement of objections have not been issued, 90% of fees for non-expedited or expedited request for examination may be refunded to Applicant if he/she requests in newly inserted form 29 (which requires zero fees).

63. What are the changes made to the submission of the Power of attorneys?

Now, the deadline for filing a power of attorney is 3 months from the date of filing of patent application and failing of which no action shall be taken on such applications or document till such deficiency is removed.

64. Are there any restrictions with respect to the hearing adjournments?

The Amended rules, 2016 provides for restriction on the number of hearing adjournments to two and each adjournment shall not be more than thirty days each. These adjournments have to be requested at least three days before the date of hearing.

65. Have there been any amendments with respect to national phase applications based on the international patent application:

The rule 20 has been amended to explain an application corresponding to an International application which clarifies that an application corresponding to an international application under PCT can include amendments made under Article 19 or article 34 of PCT, provided that the applicant while filing such application may delete a claim in accordance with Rule 14.

66. What are the instructions to patent agents regarding submission of all documents by electronic transmission?

Now Patent Agents are required to submit even those documents by electronic transmission that need to be submitted in original i.e. through scanned copies and any document, if asked to be submitted in original, shall be submitted within a period of fifteen days, failing which such documents shall be deemed not to have been filed.

67. Are there any schemes available for MSME's and Start-ups with respect to IPRs?

Yes, the Government of India has formulated schemes to spur the innovative capabilities of the innovators who are from MSME'S and Start-ups.

i) MSME's: A 80% fee concession as per patent amendment rules, 2020 is provided for MSMEs vis-à-vis large entities on patent filing fees.

ii) A Scheme for facilitating Startups Intellectual Property Protection (SIPP) has been launched for encouraging innovation and creativity of Startups.

For effective implementation of the scheme, facilitators have been empanelled by the Controller General of Patent, Trademark and Design (CGPDTM). The list of facilitators in Patent & Designs and Trademarks is available on the website of Controller General of Patents, Designs & Trade Marks ([www.ipindia.gov.in](http://www.ipindia.gov.in)). Startups are provided a rebate of 80% on patent fees as compared to the fee paid by legal entity.

68. What is start up criteria?

Start-up means an entity, incorporated or registered in India under the Start-up India: Stand-Up India” initiative of the Government of India. [You can refer: https://www.startupindia.gov.in/content/sih/en/startup-scheme.html](https://www.startupindia.gov.in/content/sih/en/startup-scheme.html)

69. What are the benefits provided by the Government of India to Startup applicants for filing patent applications?

Government of India provides the following benefits to Start Ups in filing patent application in India under Scheme for Facilitating Start-ups Intellectual Property Protection (SIPP):

- An entity qualifying as a “start up” under Stand-Up India initiative of the Government of India can avail the facility of expedited examination.
- The Government reimburses the expenditure to the facilitator who assists the startup for filing and prosecuting the patent application is as given below:
- At the time of filing of Application- INR 15000
- At the time of final disposal of Applications Without Opposition-INR 25000 • At the time of final disposal of Applications With Opposition-INR 35000

70. What is the relevant date from the infringement perspective?

As per section 11A, the applicant shall have privileges as if patent is granted on the date of publication of application. Thus, in case of suit for infringement, the patent owner can claim damages from the date of publication of patent application or date of infringement whichever is earlier. However the suit for infringement can be filed only after a patent is granted.

71. What are the rights of a patentee once the patent is granted?

A patentee enjoys the exclusive right to make and use the patented invention. The patentee also has the right to assign the patent, grant licences, or otherwise deal with the patent, for any consideration. These rights, created by statute, are circumscribed by various conditions and limitations as prescribed under the Patents Act. 1970.

72. Is it necessary to show working of a patent after grant?

Under the provisions of section 146, every patentee or a licensee, is required to furnish the information relating to working of patent, statement as to the extent to which the patented invention has been worked. This must be submitted on Form 27 once in respect of every period of three financial year, starting from the financial year commencing immediately after the financial year in which the patent was granted, and

shall be furnished within six months from the expiry of each such period. Provided that the Controller may condone the delay or extend the time in filing of such statement for a period up to three months upon a request made in Form 4.

## **INTERNATIONAL ARRANGEMENTS:**

### **73. What is the Budapest Treaty?**

This is an international treaty governing the deposition of microorganisms, cell lines etc in international approved authority approved by WIPO for the purpose of patent applications in any country that is a party to it. Because of the difficulties and, on occasion, of virtual impossibility of reproducing a microorganism from a description of it in a patent specification, it is essential to deposit a strain in a culture collection centre for testing and examination by others. There are many international depositories in many countries, which are recognized under the Budapest Treaty. IMTECH Chandigarh, MCC Pune and NAIMCC Mau Nath Bhanjan are recognized depositories in India. ([Reference: https://www.wipo.int/budapest/en/idadb/index.jsp](https://www.wipo.int/budapest/en/idadb/index.jsp))

### **74. What are the modes of filing a patent application in foreign countries?**

Since there is no worldwide patent, the applicant has to file his patent application in respective countries separately to obtain protection on his invention. The following are the routes available to the applicant to file his International application in foreign country.

**Paris Convention:** The Paris Convention for the Protection of Industrial Property, established in 1883, provides for 12 months time to file the patent application in the member countries from the date of filing of the earliest application.

**Patent Cooperation Treaty System:** PCT is a system which allows an applicant to file in PCT contracting states within 30/31 months from priority date instead of 12 months. Not only does the PCT enable extended time period, it also simplifies filing procedure through a single application. The PCT system also provides for publication of application, International Search and International Preliminary Examination before entering the national phase.

### **75. What is the Patent Cooperation Treaty (PCT)?**

The PCT is an international treaty with more than 150 Contracting States which are bound with certain formal requirements set out in the Treaty and Regulations. The PCT makes it possible to seek patent protection for an invention simultaneously in a large number of countries by filing a single

—international patent application instead of filing several separate national or regional patent applications however, granting of patents remains under the control of the national or regional patent offices after the corresponding —national phase application has been filed and the national phase application is assessed as per patent law of that jurisdiction.

As per Indian Patent Act 1970 as amended and the Patents Rules 2003 as amended by (amendment) rules 2016, any PCT international application may be filed designating India and it shall be deemed to be an application if the corresponding national phase application has also been filed.

## 76. What is the procedure of PCT?

The PCT procedure

includes:

a. Filing: An international application can be filed with RO/IN national patent Office or directly with International Bureau (IB) of WIPO, complying with the PCT formality requirements and fees. In India PCT application are filed at appropriate patent offices decided on the basis of territorial limits (Rule 4, Indian Patent Act 1970 as amended and patent Rules 2003 as amended).

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 filing permission under section 39 has to be obtained from the appropriate patent office.
- (ii) If the international application is filed directly at RO/IB or RO/IN (i.e. filed without a priority claim or filed within 6 weeks from the date of priority), foreign filing permission under section 39 has to be obtained from the appropriate patent office.

If the applicant fails to obtain the foreign filing permission under section 39, the application will not be considered as international application by RO/IN. 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.

b. International Search: An International Searching Authority (ISA) identifies the published patent documents and technical literatures (prior arts) which may have an influence on the patentability of the invention, and establishes a written opinion on invention's potential patentability. Indian Patent office, Delhi Branch performs the function of ISA on receipt of prescribed fee specified in Fifth Schedule of patent rules 2003 as amended.

c. International Publication: After expiration of 18 months from the earliest filing date (Priority Date), the content of your international application is disclosed to the world.

d. International Preliminary Examination (optional): one of the ISAs on request carries out an additional patentability analysis, usually on an amended version of your application. Indian Patent office, Delhi Branch performs the function of International Preliminary Examination (IPEA) on receipt of prescribed fee specified in Fifth Schedule of patent rules 2003 as amended.

e. National Phase: After the end of the international PCT procedure, usually at 30/31 months from the earliest filing date of your initial application, from which you claim priority, you start to pursue the grant of your patents directly before the national (or regional) patent Offices of the countries in which you want to obtain them.

f. In India, 31 months is the time limit to enter national phase (Which can be extended for a period upto 6 months by filing form-4 under rule 138 of Patent rules 2003, as amended by patent amendment rules, 2024). To enter national phase an application corresponding to an international application is made in Form 1.

77. Who has the right to file an international patent application under the PCT?

PCT international patent application may be filed by a national or resident of a PCT Contracting State. If there are several applicants named in the international application, only one of them needs to comply with this requirement.

78. Can I file PCT applications electronically?

YES, PCT applications can be filed electronically with RO/IN or RO/IB which accepts such filings. WIPO web service (ePCT- filing) helps to prepare applications by automatically validating the entered data and drawing your attention to incorrectly or inconsistently completed parts. Applicants are also entitled to certain PCT fee reductions when filing electronically (<https://pct.wipo.int/>). WIPO's PCT-SAFE software offers PCT user to prepare international application in electronic form (<http://www.wipo.int/pct-safe/en/>).

An International patent application can be filed in Indian Patent Office as a Receiving Office, in request form (PCT/RO/101), through the e-PCT module of WIPO (<https://pct.wipo.int>) along with application body, declaration, PoA (In case of agents), MSME Certificate in case of small entity or certificate of recognition as Startup issued by DPIIT for claiming fee reduction in transmittal and priority document fees.

79. In which language can a PCT application be filed?

PCT international application in India shall be filed with the appropriate office in triplicate either in English or Hindi. However, the request can be filed only in English.

80. What are the costs associated with the filing and processing of an international application under the PCT? What are the costs for entering the national phase?

PCT applicants generally pay three types of fees when they file their international applications:

(a) An international filing fee

(b) A search fee which can vary depending on the ISA chosen, and

(c) A transmittal fee which varies depending on the receiving Office.

All PCT fees are subject to change periodically. For latest fees, please refer the latest PCT newsletter at URL [www.wipo.int](http://www.wipo.int).

Refer, Fifth Schedule of patent rules 2003 as amended for fee structure for an international application designating India.

81. Are there any fee reductions available under the PCT?

PCT fee reductions are available to applicants who file electronically, based on the type of filing and the format of the application submitted. Also, there is no transmittal fee for international application if filed electronically (for ePCT filing).

In addition, to encourage the use of the PCT System by applicants from developing countries fee reductions of 90% for certain fees, including the international filing fee, are available to natural persons.

Some ISAs also provide for a reduction of the international search fee if the applicant or applicants are nationals or residents from certain countries (see Annex D of the PCT Applicant's Guide WIPO).

## 82. How long does the PCT process take?

In most cases, up to an additional 18 months from the time you file your international patent application (or usually 30/31 months from the filing date of the initial patent application of which you claim priority) before starting of national phase procedures with individual patent Offices and to fulfil the national requirements.

i. This additional time can be useful for evaluating the chances of obtaining patents and exploiting invention commercially in the countries in which you plan to pursue patent protection, and for assessing both the technical value of your invention and the continued need for protection in those countries.

ii. It is important to note, however, that you do not have to wait for the expiration of 30/31 months from the earliest filing date of your patent application (priority date) before you enter the national phase you can always request an early entry into the national phase.

iii. Since, in the national phase, each patent Office is responsible for examining your application in accordance with national or regional patent laws, regulations and practices, the time required for the examination and grant of a patent varies across patent Offices.

## 83. What does it mean to “claim priority” of an earlier patent application?

Generally, patent applicants who wish to protect their invention in more than one country usually first file a national or regional patent application with their national or regional patent Office, and within 12 months from the filing date of that first application, they file their international application under the PCT.

The effect of claiming the priority of an earlier patent application is that a patent shall not be invalidated by reasons of any acts accomplished in the interval, such as another filing, the publication or sale of the invention.

## INTERNATIONAL SEARCH

### 84. Can an applicant opt for Indian Patent Office as ISA/IPEA for the international search of PCT application?

Yes, the Indian Patent Office was recognized as an International Searching Authority and International Preliminary Examining Authority under the PCT and started functioning from 15th October 2013. The advantages of search in Indian ISA are:

i. Having access to a comprehensive collection of patent and non-patent literature that covers the PCT minimum documentation.

- ii. Professionally qualified and skilled Examiners are our assets.
- iii. PO has established a Quality Management System covering technical and administrative tasks of the office. Fully electronic processing system ensures speedy disposal and dissemination of information on real time basis.
- iv. The fees for conducting a search under ISA/IPEA are the lowest among the other offices offering the same facilities.
- v. Further, if the applicant chooses the Indian ISA/IPEA, he gets an additional advantage to enter the Expedited Examination System which ensures a grant of his application within 12 months (provided no pre-grant opposition is filed).

85. Which are the other offices which are appointed by the PCT to conduct searches?

The following have been appointed by the PCT Contracting States as International Searching Authorities (ISAs): the national Offices of Australia, Austria, Brazil, Canada, China, Chile, Egypt, Finland, India, Israel, Japan, the Republic of Korea, the Russian Federation, Spain, Sweden, Ukraine and the United States of America, and the following regional Offices, the European Patent Office and the Nordic Patent Institute. For complete list please refer to the link ([https://www.wipo.int/pct/en/access/isa\\_ipea\\_agreements.html](https://www.wipo.int/pct/en/access/isa_ipea_agreements.html)). The availability of a particular ISA to the nationals or residents of a country is determined by the receiving Office where the international application was filed. Some receiving Offices provide a choice of more than one competent ISAs. If your receiving Office is one of those, you can choose any one of them, taking into account differing requirements relating to language, fees, etc.

86. What is a PCT international search?

A PCT international search is a high quality search of the relevant patent documents and other technical literature in those languages in which most patent applications are filed (Chinese, English, German and Japanese, and in certain cases, French, Korean, Russian and Spanish). The high quality of the search is assured by the standards prescribed in the PCT for the documentation to be consulted, and by the qualified staff and uniform search methods of the ISAs, which are all experienced patent Offices. The results are published in an international search report and a written opinion of the ISA on the potential patentability of your invention.

87. What is an international search report?

The international search report consists mainly of a listing of references to published patent documents and technical journal articles which might affect the patentability of the invention disclosed in the international application. The report contains indications for each of the documents listed as to their possible relevance to the critical patentability questions of novelty and inventive step (non-obviousness). Together with the search report, the ISA prepares a written opinion on patentability, which will give you a detailed analysis of the potential patentability of your invention. The international search report and the written opinion are sent to the applicant by the ISA.

88. What is the value of the international search report?



The report enables you to evaluate your chances of obtaining patents in PCT Contracting States. An international search report which is favourable, that is, in which the documents (prior art) cited would appear not to prevent the grant of a patent, assists you in the further processing of your application in those countries in which you wish to obtain protection. If a search report is unfavourable (for example, if it lists documents which challenge the novelty and/or inventive step of your invention), you have the opportunity to amend the claims in your international patent application (to better distinguish your invention from those documents), and have them published, or to withdraw the application before it is published.

89. Will an international search be carried out for all international applications?

iii) As a rule, an international search is carried out for all international applications. There are instances, however, where the ISA will not be able to carry out a search. For example, where the international application relates to subject matter which the ISA is not required searching or if the description, claims or drawings are not sufficiently clear for it to carry out a meaningful search. In such cases, the ISA will issue a declaration that no international search report will be issued.

iv) There are also circumstances where the ISA will issue a partial search report. This can occur when, in the view of the ISA, the international application contains multiple inventions but the applicant has not paid additional search fees to cover the work required to search those additional invention(s).

90. What is the written opinion of the International Searching Authority?

For every international application, the ISA will establish, at the same time that it establishes the international search report, a preliminary and non-binding opinion on whether the invention appears to meet the patentability criteria in light of the search report results. The written opinion, which is sent to you together with the international search report, helps you understand and interpret the results of the search report with specific reference to the text of your international application, being of special help to you in evaluating your chances of obtaining a patent. The written opinion is made available to the public at the same time as the application.

## **INTERNATIONAL PUBLICATION**

91. What does international publication under the PCT consist of?

WIPO publishes the international application shortly after the expiration of 18 months from the priority date (if it has not been withdrawn earlier), together with the international search report. PCT international applications are published online on PATENTSCOPE, a powerful, fully searchable database with flexible, multilingual interfaces and translation tools to assist users and the public in understanding the content of published applications.

92. Can third parties access the documents contained in the file of the international application? If so, when?

Until international publication (18 months after the priority date), no third party is allowed access to your international application unless you as applicant request or authorize it.

If you wish to withdraw your application (and you do so before international publication), international publication does not take place and, as a consequence, no access by third parties is permitted. However, when international publication occurs, certain documents in the international application file are made available on PATENTSCOPE together with the published international application, for example, the written opinion of the ISA and any informal comments on the written opinion.

## **INTERNATIONAL PRELIMINARY EXAMINATION**

93. What is international preliminary examination?

International preliminary examination is a second evaluation of the potential patentability of the invention, using the same standards on which the written opinion of the ISA was based. If you wish to make amendments to your international application in order to overcome documents identified in the international search report and conclusions made in the written opinion of the ISA, international preliminary examination provides the only possibility to actively participate in the examination process and potentially influence the findings of the examiner before entering the national phase – you can submit amendments and arguments and are entitled to an interview with the examiner. At the end of the procedure, an international preliminary report on patentability (IPRP Chapter II) will be issued. The International Preliminary Examining Authorities (IPEAs) which carry out the international preliminary examination are the ISAs mentioned above. For a given PCT application, there may be one or more competent IPEAs; your receiving Office can supply details or you may consult the PCT Applicant's Guide and the PCT Newsletter.

94. What is the value of the international preliminary report on patentability (Chapter II)?

The IPRP (Chapter II) consists of an opinion on the compliance with the international patentability criteria of each of the claims which have been searched. It provides you with an even stronger basis to evaluate your chances of obtaining patents, in most cases on an amended application, and, if the report is favourable, a stronger basis to continue with your application before the national and regional patent Offices. The decision on the granting of a patent remains the responsibility of each of the national or regional Offices in which you enter the national phase; the IPRP (Chapter II) should be considered by the Offices but is not binding on them.

**NATIONAL PHASE** 95. How do I enter the national phase?

It is only after you have decided whether, and in respect of which States, you wish to proceed further with your international application that you must fulfil the requirements for entry into the national phase. These requirements include paying national fees and, in some cases, filing translations of the application. These steps must be taken, in relation to the majority of PCT Contracting States' patent Offices, before the end of the Other(s), alone or with natural person(s) or Startup(s) or Small entit(y)/ (ies) or educational institution(s)".1<sup>st</sup> month from the priority date. There may also be other requirements in connection with the entry into the national phase for example, the appointment of local agents. More general information on national phase entry can be found in the PCT Applicant's Guide, National Phase, and specific information

concerning fees and national requirements can be found in the national chapters for each PCT Contracting State in the same Guide.

#### 96. What happens to my application in the national phase?

Once you have entered the national phase, the national or regional patent Offices concerned begin the process of determining whether they will grant you a patent. Any examination which these Offices may undertake should be made easier by the PCT international search report and the written opinion and even more by an international preliminary examination report.

#### 97. What are the advantages of the Patent Cooperation Treaty?

The PCT System has many advantages for an applicant, for the patent Offices and for the general public:

- (a) You have up to 18 months more than if you had not used the PCT to reflect on the desirability of seeking protection in foreign countries, to appoint local patent agents in each foreign country, to prepare the necessary translations and to pay the national fees;
- (b) If your international application is in the form prescribed by the PCT, it cannot be rejected on formal grounds by any PCT Contracting State patent Office during the national phase of the processing of the application;
- (c) The international search report and written opinion contain important information about the potential patentability of your invention, providing a strong basis for you to make business decisions about how to proceed;
- (d) You have the possibility during the optional international preliminary examination to amend the international application, enter into dialogue with the examiner to fully argue your case and put the application in order before processing by the various national patent Offices;
- (e) The search and examination work of patent Offices in the national phase can be considerably reduced due to the international search report, the written opinion and, where applicable, the international preliminary report on patentability that accompany the international application;
- (f) You may be able to fast-track examination procedures in the national phase in Contracting States that have PCT-Patent Prosecution Highway (PCT-PPH) agreements or similar arrangements;
- (g) Since each international application is published together with an international search report, third parties are in a better position to evaluate the potential patentability of the claimed invention;
- (h) For an applicant, international publication online puts the world on notice of your invention. You may also highlight your interest in concluding licensing agreements on PATENTSCOPE, which can be an effective means of advertising and looking for potential licensees;
- (i) You also achieve other savings in document preparation, communication and translations because the work done during the international processing is generally not

repeated before each Office (for example, you submit only one copy of the priority document instead of having to submit several copies); and

(j) if your invention appears to be not patentable at the end of the international phase, you may abandon the PCT application and save the costs you would otherwise have incurred by directly seeking protection in foreign countries, appointing local patent agents in each foreign country, preparing the necessary translations and paying the national fees.

98. What is ePCT?

ePCT is a WIPO online service that provides secure electronic access to the files of international applications filed under the PCT as maintained by the International Bureau. The applicants can file international applications using ePCT-Filing, with RO/IN as well as RO/IB.

99. What are the benefits of filing through ePCT?

- Applicants can avail a fee reduction as fixed by PCT division of WIPO from time to time.
- Less cumbersome, for both RO as well as for the applicant.
- Fast processing
- Record copy transmitted to the IB on the same day.

100. Are there fees associated with obtaining certified copies and transmission of priority documents from the India Patent and Design Office for submission to WIPO.

No, India Patent and Design office does not charge any fees in providing and transmitting certified copy of priority document through WIPO DAS system (Digital Access System). The Applicant can request the India patent/design office (Office to first filing) to deposit or add priority documents into WIPO DAS System and thus there is no need to submit a certified copy of priority documents separately to each office of second filing. Upon request the India patent/design office provide an access code through email to the applicant which can be shared with the accessing office for retrieval of the certified copies of the priority document from DAS. The entire procedure is online and facilitates easy, secure, quick and inexpensive submission of the priority documents.

100. How to conduct patent search other than in InPASS?

Here are some options for conducting patent searches besides the Indian Patent Office's

InPASS system, WIPO's PATENTSCOPE, EPO's Espacenet, Google Patents, etc

101. How IPO is incentivizing the applicant for patent/design filing?

The Indian Patent Office (IPO) incentivizes patent and design filings through:

- Fee reductions for startups, small entities, and e-filers.

- Expedited examination for startups, MSMEs, etc as per Rule 24C.
- Innovation support via workshops and IPR awareness programs such as NIPAM.
- Simplified procedures with online tools.
- Financial assistance and reimbursement schemes such as SIPP.
- Patent Facilitation Centres (PFCs) for guidance.

## OPEN HOUSE

**102.** How can one reach to IPO for their grievances related to any of 6 IPs (Patents, Designs, Trademarks, Copyright, Geographical Indication and SICLD)?

The stakeholder can send their queries related to any of 6 IPs (Patents, Designs, Trademarks, Copyright, Geographical Indication and SICLD) through “Open House Helpdesk Portal”.

**103.** What is “Open House Helpdesk Portal”, how is it working and how the stakeholders will get benefitted from this portal?

The Open House Helpdesk Portal is developed for enhancing the services of IPOs and improving stakeholder engagement. This revolutionary platform is poised to transform the way applicants and stakeholders interact with the IPOs.

The Open House Helpdesk Portal now offers a single window for communication that will provide swift and effective resolution to the queries and grievances of applicants and stakeholders across the six key areas of intellectual property: Patents, Designs, Trademarks, Geographical Indications, Copyrights, and SICLD (Semiconductor Integrated Circuits Layout-Designs) which are administered by the O/o CGPDTM

### Key Features of the Open House Helpdesk Portal:

- 1. User-Friendly Registration:** Applicants and stakeholders can register themselves on the Open House Helpdesk Portal through a simplified process by using only their email IDs. This will give access to the applicant/stakeholder to raise a grievance ticket.
- 2. Tickets and Real-Time Notifications:** Once a ticket is raised, the users will receive timely notifications for every response from the relevant department within the Intellectual Property Office, ensuring transparency and accountability in the resolution process. The ticket will be responded by IPO officials as soon as possible. After response from IPO the applicant has further query then they can send further query under the same ticket with same subject matter other they can close the ticket if satisfied with the IPO response. If applicant does not respond the response of IPO further then the ticket will automatically closed after the expiry of 7 days from the date of response from IPO.
- 3. Self-Paced Issue Resolution:** The Open House Helpdesk Portal grants applicants the freedom to close their support tickets once they believe that their concerns have been satisfactorily addressed, putting control back in the hands of the stakeholders.

This initiative is in line with the Government of India's commitment to creating a conducive environment for innovation, creativity, and entrepreneurship. By providing a dedicated platform for communication, the Intellectual Property Office aims to foster a collaborative ecosystem where applicants and stakeholders can seek guidance and clarification in a transparent and efficient manner.

Link for the portal - <https://iprsearch.ipindia.gov.in/openhousehelpdesk/Login/Login>

### Stage 1: Application Filing

The first stage in patent prosecution is, of course, the filing of the application itself. Different kinds of applications have varying timelines, as can be seen below. For more information on the documents required and the process of filing an application, please visit: <https://www.obhanandassociates.com/blog/putting-an-indian-patent-application-together-documents-and-information/>.

S. No.	Task	Timeline	Extensions
1.	Complete Specification' after a 'Provisional Specification'	Within 12 months of the date of filing of the Provisional Specification.	No
2.	National Phase application	Within 31 months of the priority date	No
3.	Convention application	Within 12 months of the priority date	No
4.	Divisional application	Any time before the grant of the parent application	No
5.	Application for a patent of addition	Any time during the term of the parent application	No

### Stage 2: Publication

The second stage is when the Indian Patent Office (IPO) publishes an application in the office journal with all pertinent details related to the application.

6.	Publication of an application by IPO	On or after the expiry of 18 months from the filing date or the priority date, whichever is earlier.	-
7.	Request for early publication	Any time after the filing of the complete specification but before the expiry of 18 months from the filing date or the priority date.	-
8	Publication after request for early publication is filed	Within one month of the filing of the request	-

### Stage 3: Examination

The next stage involves the IPO examining an application to determine whether the invention claimed in the patent application is patentable or not, testing for factors such as inventiveness and novelty.

9.	Request for examination	Within 48 months from the filing date or the priority date, whichever is earlier.	No
10.	Request for expedited examination	Within 48 months from the filing date or the priority date, whichever is earlier.	No
11.	Filing response to examination report	Within 6 months from the date of issuance of the examination report.	Up to 3 months, provided a request for extension is filed before expiry of the 6 months' period.

### Stage 4: Hearing

After the examination of an application, a Controller, who is an officer senior to a Patent Examiner, issues a notice of hearing inviting the applicant to attend the hearing on a scheduled date.

12.	Written submissions pursuant to a hearing of a patent application in India	Within 15 days of the hearing	Up to 1 month provided a request for extension is filed before expiry of 15 days. Extension subject to Controller's discretion.
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### Stage 5: Renewal

The final stage in patent prosecution entails keeping the patent alive over the course of the term of the patent, by way of renewal, through the periodic payment of a renewal fee.

13.	Payment of renewal fee	<p>The renewal fee is payable only after the grant of the patent. The schedule is as follows:</p> <ul style="list-style-type: none"><li>- Within 3 months of grant: All annuity payments that are due, calculated from the third year from the filing date.</li><li>- Before each subsequent anniversary of the filing date: Annuity payments.</li></ul> <p>Note: For a PCT National Phase application, the international filing date is the filing date in India. For a complete application filed after provisional, the filing date is the filing date of the provisional application.</p>	Extension of 6 months upon payment of the prescribed fee.
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#### **104. Patent Application filing Mode**

**Yes**, one can file patent applications through comprehensive online filing system at <https://ipronline.ipindia.gov.in/epatentfiling/goForLogin/doLogin>.

## **SIPP**

### **Scheme/Initiatives**

#### **105. Are there any Government initiatives that promote Intellectual Property protection for Startups in India?**

Yes, DPIIT has launched a scheme called Scheme for Facilitating Start-Ups Intellectual Property Protection (SIPP). It is designed to encourage startups to protect their intellectual property rights at low costs. The key features of the scheme are:

- The scheme provides financial assistance to eligible startups, in filing and prosecuting patents, trademarks, and designs. This support helps startups in covering the costs associated with IP protection.
- The scheme has been facilitating startups in filing and processing of their patent, design, or trademark application through the assistance of empanelled IP Facilitators, whose fee is borne by the Office of the Controller General of Patents,

Designs and Trademarks (CGPDTM). Thus, under the scheme the start-ups can take assistance of qualified IPR professionals for filing and prosecution of their IPR and they do not have to pay any fees to the IP facilitator. However, Statutory/Official fees are to be borne by the start-up itself.

- The list of facilitators in Patent & Designs and Trademarks is available on the website of Controller General of Patents, Designs & Trade Marks ([www.ipindia.gov.in](http://www.ipindia.gov.in)). As of 2022, 510 Patent & 392 Trademark facilitators are empanelled.

**106. Does one have to visit the Intellectual property office for filing of applications or submission of other related documents and fees?**

- No, it is not required to visit the intellectual property office to file the application or submit the documents. The e-filing facility is provided to the applicant or to his agent for filing of an application and other documents including response to office actions for almost all forms of IPR including patents, trademarks, designs and copyrights. Furthermore, a 10% fee reduction is provided to the applicant in case of online filing as compared to physical/offline filing.
- Only in case the original document is required to be filed offline, the same can be filed physically at the counter of the Office or can be sent through post or courier.
- Additionally, all the communications with the office can be made through emails. Moreover, the fees can also be submitted through online mode via net-banking, UPI, payment by debit/credit card, etc. Furthermore, the hearing proceedings relating to patent and trademark applications can be attended online with prior intimation by the IP Office.

**107. Are there any specific categories or sectors of startups that are prioritized under the SIPP program?**

- The Scheme is applicable to any startup recognized in terms of the notification GSR 127(E) published in the Gazette of India. The Certificate of Recognition given to a startup by DPIIT may be verified from the Startup India web portal <http://www.startupindia.gov.in>.
- However, startups will be required to give a self-declaration that they have not availed funds under any other Government scheme for the purpose of paying the facilitator/patent agent/ trademark agent for filing and prosecuting their IP application.

**108. What are the services provided by the Facilitators under SIPP?**

The SIPP Facilitators provide the following services:

- Information on protecting and promoting IPRs in other countries.
- Assistance in filing to disposal of the IP applications related to patents, trademarks, and designs under relevant Acts at the national IP offices under the CGPDTM.

- Filing of an international patent application by an eligible applicant filed before Receiving Office, India (RO/IN) or International Bureau, WIPO (RO/IB), electing India as International Search Authority (ISA).
- Drafting provisional & complete patent specifications and an ISA patent application for inventions.
- Assistance in filing to disposal of International Trade Mark application originating from India under the Madrid Protocol.
- Preparing and filing responses to search & examination reports and other queries, notices or letters by the IP Office India, or WIPO.
- Appearing on behalf of an eligible applicant at hearings, as may be scheduled; contesting opposition, if any, by other parties; and ensuring final disposal of the IPR application.