



## **PATENT PROCEDURE IN INDIA**

### **1. Invention Consolidation**

This step involves invention disclosure submission by inventor, feedback by Patent Attorney for clarifications, and conducting inventor interview. There may be various iterations between the Inventor and the Patent Attorney, till sufficient information regarding invention is received by the Patent Attorney to carry out Novelty Search, or preparing Patent Specification.

### **2. Novelty Search**

Although not mandatory, but it is always advisable to conduct a Novelty Search before going for filing a Patent Application. This helps in knowing how strong the invention is, and what strategy should be followed while drafting, for enhancing chances of a patent grant.

### **3. Drafting of Patent Specification**

After completion of the search report, once the Inventors have enhanced the Invention Disclosure details (if required) based on the report, drafting of the Patent Specification is taken up. In India, the Patent Office accepts the Patent Application with either a Provisional Specification, or a Complete Specification. A provisional specification can be filed in cases where the inventor requires more time for the development of invention, which is followed by a complete specification, to be filed within 12 months from the date of filing the provisional specification. A direct Complete Specification can also be filed in cases where the inventor feels that the invention is complete.



#### **4. Preparing and Filing of Patent Application**

After the draft is complete, and is approved by the inventor/applicant, the application preparation starts. This involves preparing Patent Specifications and associated Drawings in required format, as per the Patent Rules, preparing Power Authority (PoA), preparing Proof of Rights (PoR), and all other forms which are mandatory to be filed along with the application. Once all the documents to be executed by the Applicant and Inventors are received, the Patent Application is prepared on the E-filing portal of Controller General of Patents, Designs and Trademarks of India. Thereafter, the Application is given a final review, before completing the filing of the Application, along with requisite fee. The costs of filing a Patent Application depend on the entity status of the Applicant.

#### **5. Publication**

After filing of a Patent Application is complete, the Patent office publishes the Abstract of the invention together with the details of the applicant and inventors, in their weekly journal, subject to filing of the complete specification. This publication happens within 18 months of the priority date (date of filing the provisional specification/direct complete specification), unless an Early Publication request is made. In case of Early Publication requests, the Application is generally published within 1 month of filing the Request. The rights of the Applicant to claim damages begin from the date of publication. Another importance of Publication is that the subject matter filed and published, also becomes a prior art for anyone who is working over similar concepts in the world, and may deteriorate the chances for them to get a Patent on similar subject matter.



## **6. Examining of Patent Application**

After filing of Complete Specification, a Request for Examination is required to be filed within 48 months of the priority date, which is mandatory. A Request for Examination can either be a Normal Request, or an Expedited Request. An expedited request for examination can be filed in cases where the Applicant is a Start-up, a Small Entity, filed with one of co-applicant is a Female when all other applicants are Natural Persons, or in cases where the Application has chosen India as International Search Authority while filing a PCT International Phase Application. An Expedited Request for Examination helps to expedite the process of examination by avoiding the queue for examination through normal requests. Once the request for examination is filed, it is referred to the Controller u/s 12 of the Patents Act, who examines the Application to ensure that it is in accordance with the provisions of the Indian Patent Act and Rules. After this, First Examination Report is issued, which is to be responded within six months of issuance of the Report. The filing of response can be delayed for a period of three further months, by filing a request for extension for responding to the FER.

## **7. Hearing**

The Controller reviews the response to FER, together with the amendments made to the application, if any. In case, any of the objections are still sustaining, or in case if there are any further objections the Controller has, the Controller issues a Hearing Notice, wherein a date is mentioned for hearing. The Applicant's Agent has to prepare for the hearing, and depose before the Controller with oral arguments to the objections raised in the Hearing Notice. In some cases, the Controller also counter argues to any of the oral arguments deposed by the Applicant's



Agent. Based on such Arguments, a Written Submission is to be prepared and filed, along with any amendments or Form filings as required, within fifteen days of attending the hearing.

### **8. Disposal of Patent Application**

The Patent may be granted after filing of the Response to FER, if the Examiner doesn't have any further objections, or after filing of the Written Submission after Hearing. The Patent Application may even be refused in case the Controller doesn't feel that the Application is suitable for grant.

### **9. Review or Appeal**

In case the Controller refuses to grant a Patent even after hearing, and the Applicant feels that the decision of refusal has been wrongly made, then he can request the Controller to review the decision of refusal to grant of such a Patent. The Controller has the power to review his own decision u/s 77 of the Patents Act, 1970. Further, in case the Patent is still refused, the Applicant may, if still interested to pursue the Application, file an appeal before the Intellectual Property Appellate Board (IPAB) as per Section 117A(4) of the Patents Act, 1970, within three months of the receipt of such an order of refusal from the Controller.

**Flow Chart to understand the steps involved in Grant of Patent in India:**

