

# Patent Prosecution

Presentation at:

**The APTDC Training Program**

**September 28, 2004**

# Types of Patent Applications

- Provisional Patent Applications
- Complete Patent Application
- Patents of Addition
- Divisional Application

# Filing Routes

- **Paris Convention Application**
- **Regular Non-priority Application**
- **PCT First Filing**
- **PCT Entering National Phase**

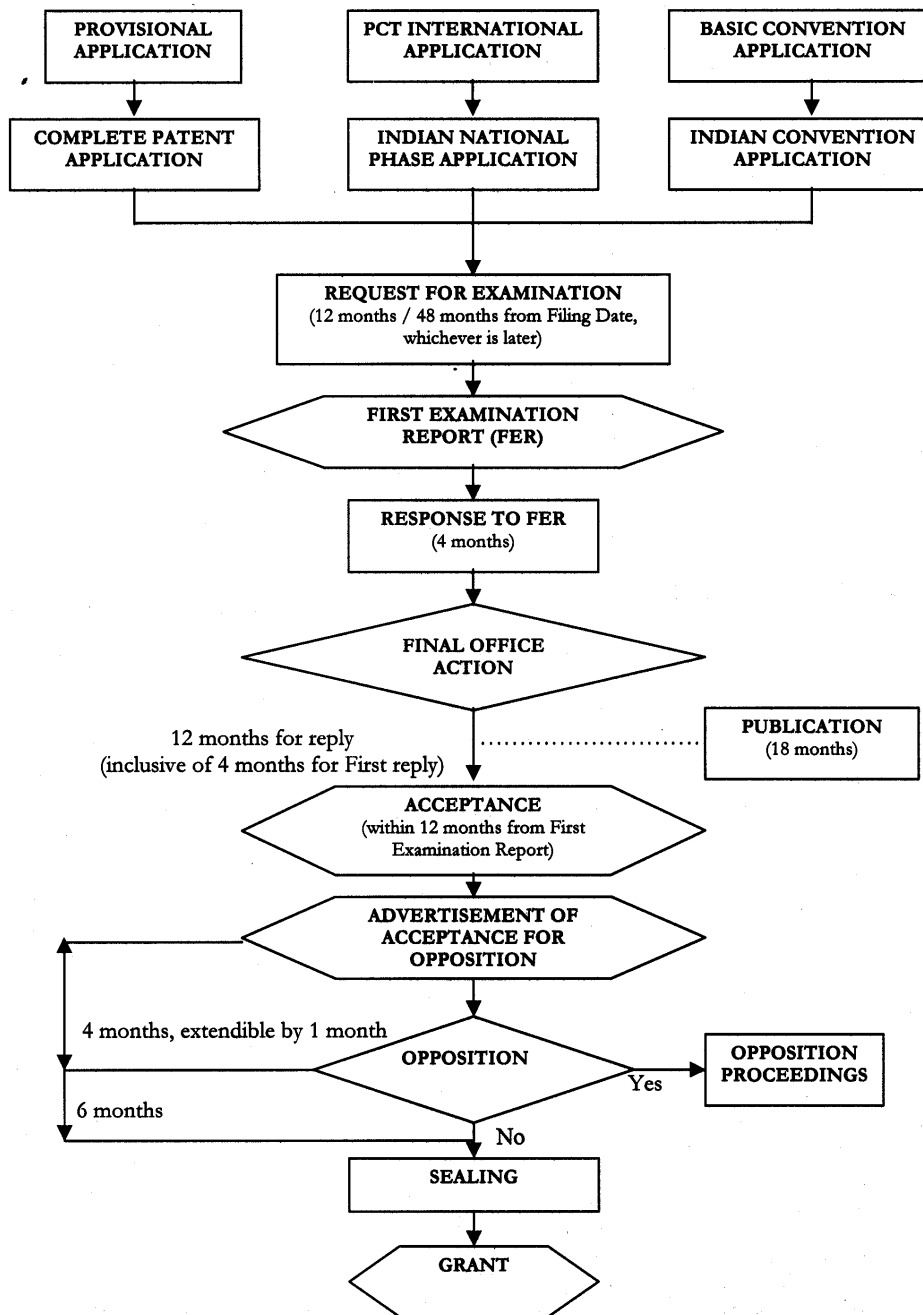
# Application Document

- Application Form
- Patent Specification
- Information Disclosure Statement
- Inventors' Declaration
- Assignment
- Authorization of the Agent
- Priority Document
- Fee

# PCT National Phase

- In addition to the ones mentioned before:-
  - Claim amendments under Art. 19 (if any)
  - Claim amendments under Art. 34 (if any)
  - IB Transmittal Notification of Assignment Document (if any)
  - Verified English Translation of Priority Document
  - Copy of International Search Report
  - Copy of International Preliminary Examination Report

# PATENT REGISTRATION PROCEDURE IN INDIA



# Indian Patents Law – towards TRIPS Compliance

- India is a W T O Member and a TRIPS Signatory
- On January 1, 1995 when India joined W T O , Indian patent law was far behind the TRIPS norms
- No product patent protection was available for inventions respecting 'food', 'drug' and 'medicine'
- India failed to comply with the TRIPS obligations under Art. 70. to provide transitional protection in the form of EMRs, and receive Mail Box Applications
- India lost a dispute at the WTO – both at the level of DSB and the AB
- In 1999, India amended the Patents Act to provide for EMRs and Mail Box Applications
- A Second Amendment was also introduced in 1999, which came into force in May 2003. The second amendment brought the national law closer to the TRIPS
- A Third Amendments to make the national patent law fully TRIPS compliant is currently pending before the Indian Parliament

# Inventions not Patentable

- Invention contrary to well established natural laws
- Invention the use of which is contrary to public order or morality
- Mere discovery of a scientific principle
- New Use of a Known Substance
- Substance obtained by mere admixture
- Method of agriculture, horticulture
- Methods of treatment; medicinal, surgical, curative, prophylactic, diagnostic, therapeutic, or other treatments of human beings and animals,

# Inventions not Patentable

- Seeds, varieties and species;
- Essentially biological processes for production or propagation of plants or animals;
- Mathematical methods, business methods, algorithms and computer program per se;
- Literary, dramatic, artistic work or any other aesthetic creation;
- Methods of playing a mental act or method of playing games;
- A presentation of information;
- Topography of IC Chips;
- Invention which in effect is traditional knowledge.

# Patentable Inventions

“Invention” means any **new**, product or process involving an **inventive step** and **capable of industrial application**

## **Unity of Invention/Single Inventive Concept**

The principle of “Unity of Invention” has been made flexible to cover all aspects of an invention under “a Single Inventive Concept” in a single application.

Multiple independent claims will be allowed.

# Term of Patent

The term of Patent will be 20 years from the date of filing for all patents granted after commencement of the Act (including unexpired patents on the date of commencement of the Act).

# Request for Examination

Request for Examination of applications is required within 48 months of filing date

Within 12 months from 31st December, 2004 or 48 months from the filing date whichever is later for "Black Box" pending applications

Within 12 months from the date of commencement of the Act (the Act came into force on May 20, 2003, hence this period is already over) or 48 months from filing date whichever is later for other pending applications

If a request for examination is not filed the application shall be deemed to be withdrawn

# Publication

As per the current law, an application for a patent will be open to the public for a period of 18 months from the priority date or the date of filing, whichever is earlier, unless a secrecy direction has been imposed on the subject matter of the invention.

Following the expiry of the 18-month period, every application for a patent will be published in the Official Gazette.

# Highlights of the Procedural Amendments

- Filing Fee has been reduced
- Forms have been amended – For PCT National Phase Applications Form 1A applies
- Request for Examination Mandatory (within 48 months from the date of filing)
- All Patent Applications will be published after 18 months from the date of priority
- The time limit to file reply to the first office action is reduced to 12 months from 15+3 months
- Time limit to restore a lapsed patent (lapsed due to non-payment of annuity) has been extended from 12 months to 18 months

# Patent System Getting Streamlined

- The Indian Patent System is getting streamlined
- The Patent Offices have been fully automated
- 350 new Patent Examiners have joined
- A Training Institute has been set up in Nagpur at the Patent Information Bureau
- The backlog of pending patent application will be cleared soon
- An Intellectual Property Appellate Tribunal has been set up. The IP Appellate Tribunal will hear appeal from the decision of the Controller of Patents
- The Institute of Microbial Technology, Chandigarh has been designated as an International Depository Authority under the Budapest Treaty

