

Measures for Expediting Patent Examination in India

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XXXVI

Congresso Internacional da Propriedade Intelectual - ABPI
International Congress on Intellectual Property - ABPI



Indian phase entry time line

☐ Do's:

PCT National Phase
Application In India

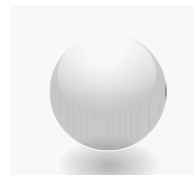
Within thirty one months
from the date of priority

Conventional Application In
India

Within twelve months from
the date on which the basic
application was made

☐ Taboo:

- Priority can not be claimed under IPA



Examination Request

Do's:

- Examination request must be filed within 48 months from the date of priority

Taboo:

- Failure to do- application is considered as withdrawn



Express Examination Request

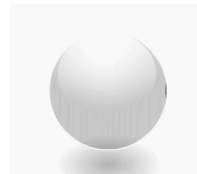
- An express request PCT Indian National Phase Application
- Application shall be examined immediately without waiting for the expiry of 31 months



Expedite Request for Examination

- The application can be accelerated by filing Expedite Request for Examination;

“If the applicant in their corresponding international application select **India** as an “International Search Authority” or International Preliminary Examining Authority”



Action by the IPO	Normal /Express Examination	Expedite Examination
Period within which the Examiner shall made the report	Ordinarily one months but not exceeding three months from the date of reference of the application to him by the controller	Ordinarily one months but not exceeding two months from the date of reference of the application to him by the controller
Period within which the Controller dispose off the report of the examiner	Ordinarily one month from the date of the receipt of the report	One month from the date of the receipt of the report
First statement of objections	One month from the date of disposal of the report of the examiner by the controller	15 days from the date of disposal of the report of the examiner by the controller

- An ordinary request for examination may be converted into Expedite Request by paying difference amount of fees
- *“The Controller may limit the number of request for examination to be received during the year by way of notice to be published in the official Journal.”*



Statement and Undertaking regarding foreign applications

Do's:

- Applicant has to submit information regarding status of same application in other foreign countries till grant (i.e. Under examination, Published or Granted, Objected).
- Applicant has to submit detail particular regarding foreign application when demanded by controller (i.e. objection raised respect of novelty and patentability)

Taboo:

- If requirement is not filed or it contains false information then application can subject to revocation or opposition under IPA 1970

Chemtura Corporation V/s the Union of India

- Chemtura filed infringement of its patent
- Defendants- revocation application- not a valid patent as it failed to disclose the information required under Section 8 of the Act to the Controller
- The Court - vacated the interim injunction granted originally- while vulnerability of a patent was an issue



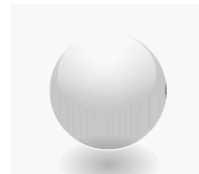
Maj. (Retd.) Suresh Behl & Anr. And Koninklijke Phillips Electronics

- Defendants in - written statement - denied the plaintiff allegations but also made a counter claim for revocation of the suit Patent on the ground of failure of the plaintiff to disclose to the Controller of Patents (CPO) the information as required by Section 8
- The plaintiff on 14.09.2012 –submitted information U/S 8 requesting to consider it along with an attorney’s affidavit – stating information printed on the reverse of the first page was inadvertently omitted



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- The defendants contested -letter dated 14.09.2012 filed by the Patent Attorney - amounts to admission of suppression of vital information and patent should be revoked
- Held “that though any violation of the requirement under Section 8 may attract Section 64(1)(m) for revocation of the patent, such revocation is not automatic”



Amendments

- The amendment - allowed only if it is by way of disclaimer, correction or explanation.
- Only for the purpose of incorporation of actual fact.
- Amendment -not -allowed if the specification as amended describes matter not in substance disclosed or shown in the specification before the amendment or the amended claims do not fall wholly within the scope of a claim of the specification before the amendment



Divisional Application

- If claims relating to more than one invention (i.e. question of Unity must be questioned) and such defect may be remedied by filing a further application.
- At any time before the grant of patent either by applicant, if so desires or with a view to remedy the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention.



Time for putting application for grant

- Previously the time for putting grant was 12 Months from First report of objection without any extension
- Now the time is reduced to 6 Months from the date of First Report of objection
- Extension upto 3 Months; allowable with requisite fees
- Extension has to be filed before the expiration of requisite period



THANK YOU

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