

# PATENT FILING PROCEDURE

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# OVERALL VIEW

- Filing an application for Patent
- Date of priority is the date of filing
- Filing a request for examination
- No examination without receiving a request for examination
- Date of filing the request for examination of an application is the basis for the prosecution

# PROVISIONAL SPECIFICATION

- FILED WHEN INVENTION IS NOT COMPLETE
- FILED TO OBTAIN A PRIORITY DATE
- NOT SURE TO WHAT EXTENT THE CLAIMS SHOULD BE AS INVENTION IS NOT COMPLETE. HENCE GENERALLY NO CLAIM PORTION
- CLAIMS IN PROVISIONAL IS POSSIBLE WHEN THE APPLICANT REQUESTS TO CONVERT THE COMPLETE SPECIFICATION INTO A PROVISIONAL SPECIFICATION
- FILING MULTIPLE PROVISIONAL SPECIFICATIONS FOR THE SAME INVENTION IS POSSIBLE [PLEASE DO NOT GET CONFUSED WITH PATENT OF ADDITION]

# COMPLETE SPECIFICATION

- CAN BE FILED WITHOUT FILING COMPLETE SPECIFICATION [WHEN THE APPLICANT FEELS THAT INVENTION IS COMPLETE]
- IF FILED AFTER PROVISIONAL SHALL DO SO WITHIN NON-EXTENDABLE TIME PERIOD OF 12 MONTHS
- IF NOT FILED WITHIN 12 MONTH STATURORY PERIOD THE APPLICATION IS DEEMED TO BE ABANDONED UNDER SECTION 9(1) OF THE PATENTS ACT.
- COGNATION OF MULTIPLE PROVISIONAL SPECIFICATIONS IS ALLOWABLE, IF SO THE COMPLETE SPECIFICATION SHALL BE FILED WITHIN NON-EXTENDABLE TIME PERIOD OF 12 MONTHS CALCULATED FROM THE EARLIEST PRIORITY
- IF FILED AFTER PROVISIONAL THE SCOPE OF THE INVENTION SHALL NOT GO BEYOND THE SCOPE OF THE INVENTION AS DISCLOSED IN PROVISIONAL SPECIFICATION(S)
- THE COMPLETE SPECIFICATION SHALL BE IN CONFORMITY WITH SECTION 10 OF THE PATENTS ACT

# TYPES OF APPLICATIONS

- 1) ORDINARY APPLICATIONS
- 2) DIVISIONAL APPLICATIONS
- 3) PATENT OF ADDITION
- 4) CONVENTION APPLICATION
- 5) PCT NATIONAL PHASE

# MANDATORY FORMS

- FORM – 1 [REQUEST FOR GRANT OF PATENT RIGHT]
- FORM – 2 [SPECIFICATION]
- FORM – 18 [REQUEST FOR EXAMINATION]

# OPTIONAL FORM

- FORM – 9 [REQUEST FOR EARLY PUBLICATION]
- PATENT WILL NOT BE GRANTED WITHIN 6 MONTHS FROM THE DATE OF PUBLICATION
- PUBLICATION DOES NOT DESTROY THE PRIORITY DATE
- PROVISIONAL RIGHT STARTS FROM THE DATE OF PUBLICATION BUT CAN NOT SUE AN INFRINGER IN THE COURT OF LAW TILL THE ACTUAL GRANT OF PATENT
- GUESS THEN WHAT IS EFFECTIVE TERM OF PATENT?

# FORM – 1

- Application for grant of patent
- Application for ordinary, convention, divisional, patent of addition and National application through PCT.
- Can be filed by an inventor or assignee or assignee to assignee
- Can be filed by any individual or legal entity
- No restriction on the number of applicants
- A combination of individual & legal entity is allowed
- Jurisdiction is decided on the address of the first applicant
- Fee for an individual is Rs. 1000/- and for the legal entity or if one of the applicants is a legal entity is Rs.4000/-
- Has a provision for endorsement / assignment



# PROOF OF RIGHT

- Proof of right to make an application shall be furnished either along with form – 1 or within 6 months from the date of filing the application.
- Extension of time till the date of acceptance is possible by filing a petition under section 7 (2) and by remitting the fee of Rs. 4000/-.

# FORM – 2

Form – 2  
THE PATENTS ACT, 1970  
(39 OF 1970)  
AND  
THE PATENTS RULES, 2003  
PROVISIONAL / COMPLETE SPECIFICATION  
(See Section 10; rule 13)

TITLE OF THE INVENTION

APPLICANT(S)

Name:

Nationality:

Address:

Preamble: The following specification  
Describes the invention (for provisional)  
Preamble: The following specification particularly  
Describes the invention and the manner in  
Which it is to be performed ( for complete)

# FORM – 2

- Fee for each sheet of specification in addition to 30 is Rs. 100/- or Rs.400/-
- Fee for each claim in addition to 10 is Rs.200/- or Rs. 800/-
- Provisional filing is optional, if filed, the complete specification shall be filed within 12 months from the date of filing the provisional
- No extension of time is allowed
- No claims are allowed in the provisional specification
- **Cognition of different provisional specifications filed by the same applicant is allowed**

# REQUEST FOR EXAMINATION FORM -- 18

- Can be filed along with the complete specification
- Can be filed within 48 months from the date of filing the specification
- Can not be filed along with provisional specification
- Fee of Rs.2500/- or Rs.10000/- shall be paid
- For early examination of National Phase applications under PCT a fee of Rs. 3500/- or Rs.14000/- shall be paid
- No examination / prosecution without Form 18

# SPECIAL MANDATORY FORMS

- FORM – 3 [FOREIGN FILING PARTICULARS]
- FORM – 5 [POSSIBILITY OF ADDITION OF INVENTORS & MANDATORY WHEN
  - a) COMPLETE FOLLOWED BY PROVISIONAL
  - b) CONVENTION APPLICATION
  - c) NATIONAL PHASE OF PCT APPLICATIONARE FILED]

# FORM – 3

- Mandatory if the applicant has filed in foreign country(ies) either filing before or filing after the date of filing in India
- The details of foreign filing, filed before the date of filing shall be furnished either along with the application or within 6 months as allowed by the Controller
- The details of foreign filing, filed after the date of filing in India, shall be filed within 6 months from the date of filing in that foreign country
- Extention of time is allowable by filing a petition under rule 138
- Petition under rule 138 shall be filed before the expiry of 6 month period and maximum extention is allowed by ONLY ONE MONTH.
- The details includes the name of the country, the application number and the status of the application
- The details shall be provided till the date of grant
- Failure to do so becomes one of the grounds for the opposition

# DECLARATION OF INVENTORSHIP

## (Form – 5 )

- Shall be filed along with the complete specification which is filed after provisional specification
- Shall be filed along with convention application [no possibility of filing provisional]
- Shall be filed along with National Phase application [under PCT] [ no possibility of filing provisional specification]
- Only opportunity to add additional inventors

# FORM AND OR PETITION FOR SEEKING EXTENTION OF TIME

- FORM – 4
  - a) CAN BE FILED DURING ALLOWABLE EXTENTION OF TIME
  - b) APPLICABLE ONLY TO SECTION 53(2) & 142(4) [RENEWAL FEE & RECORDAL FEE RESPECTIVELY] & RULES 13 (6) [FORM-5 FILING] & 130 [REVIEW PETITION]
  - c) MONTHLY FEE [300/1200] NEED TO BE PAID
- PETITION UNDER RULE 138
  - a) SHALL BE FILED BEFORE THE STIPULATED PERIOD
  - b) MAXIMUM EXTENTION OF ONE MONTH PER RQUEST IS ALLOWED
  - c) FIXED FEE [1000/4000] NEED TO BE PAID
  - d) MULTIPLE REQUESTS ARE ALLOWABLE

THE ABOVE FORM 4 & PETITION ARE NOT ALLOWABLE FOR NON EXTANDABLE TIME LIMITS SUCH AS FILING COMPLETE AFTER PROVISIONAL, CONVENTION APPLICATION, NATIONAL PHASE ENTRY, FORM -18 FILING, 12 MONTH PERIOD TO COMPLY WITH REQUIREMENTS OF FIRST EXAMINATION REPORT ETC.,



Section/ Rule	Purpose	Free time available	Maximum extension time allowable	When to file	Fees
S53(2) & R80(1-A)	Renewal fee	NIL	6 months	During Extendable period	Rs 300/- Or Rs1200/- per month
S142(4)	Renewal fee immediately after the grant	3 months from the date of recordal	6 months	During Extendable period	Rs 300/- Or Rs1200/- per month
R13(6)	Filing of Form- 5	NIL	1 Month plus	During first month	Rs 300/- Or Rs1200/- per month
R130	To file review petition	ONE month	ONE month	During Extendable period	Rs 300/- Or Rs1200/- per month

# DRAWINGS / FIGURES/ FLOW CHARTS

- No drawings or sketch, which would require a special illustration of the specification, shall appear in the specification itself
- At least one copy of the drawing shall be prepared neatly and clearly on a durable paper sheet
- Drawings shall be on a scale sufficiently large to show the inventions clearly and dimensions shall not be marked on the drawings

# DRAWINGS / FIGURES/ FLOW CHARTS

- Drawings shall be sequentially or systematically numbered and shall bear—
  - (i) in the left hand top corner, the name of the applicant
  - (ii) in the right hand top corner, the number of the sheets of drawings, and the consecutive number of each sheet; and
  - (iii) in the right hand bottom corner, the signature of the applicant or his agent
- No descriptive matter shall appear on the drawings except in the flow diagrams.

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# ABSTRACT

- To provide technical information on the invention
- Shall commence with the title of the invention and normally not more than 15 words
- The summary shall indicate clearly the technical field to which the invention belongs, technical problem to which the invention relates and the solution to the problem through the invention and principal use or uses of the invention and contain not more than 150 words
- If necessary, shall contain chemical formula, which characterizes the invention

# ABSTRACT

- If the specification contains any drawing, the applicant shall indicate on the abstract the figure, or exceptionally, the figures of the drawings in the abstract
- The indicated drawings shall be published along with the abstract
- The abstract is the efficient instrument for the purposes of search in the particular technical field, in particular by making it possible to assess whether there is a need to consult the specification itself

# PUBLICATIONS

- Date of filing is the date of filing either provisional or complete specification
- First publication in the patent journal is as soon as at the expiry of 18 months from the date of filing
- The period of 18 month can be shortened by filing Form– 9
- Ordinarily published within ONE month from the expiry period
- No Publication when secrecy is clamped or abandoned under S 9(1) or application is withdrawn within 15 months from the date of filing
- Effect of 18 month publication are
  - (a) The patent specification opens to public
  - (b) the depository institution shall make the biological material mentioned in the specification available to the public
  - (c) open invitation to file pre-grant opposition by way of representation by any person within 6 months from the date of publication or before the date of grant which ever is later.
  - ( d) Loss of Novelty



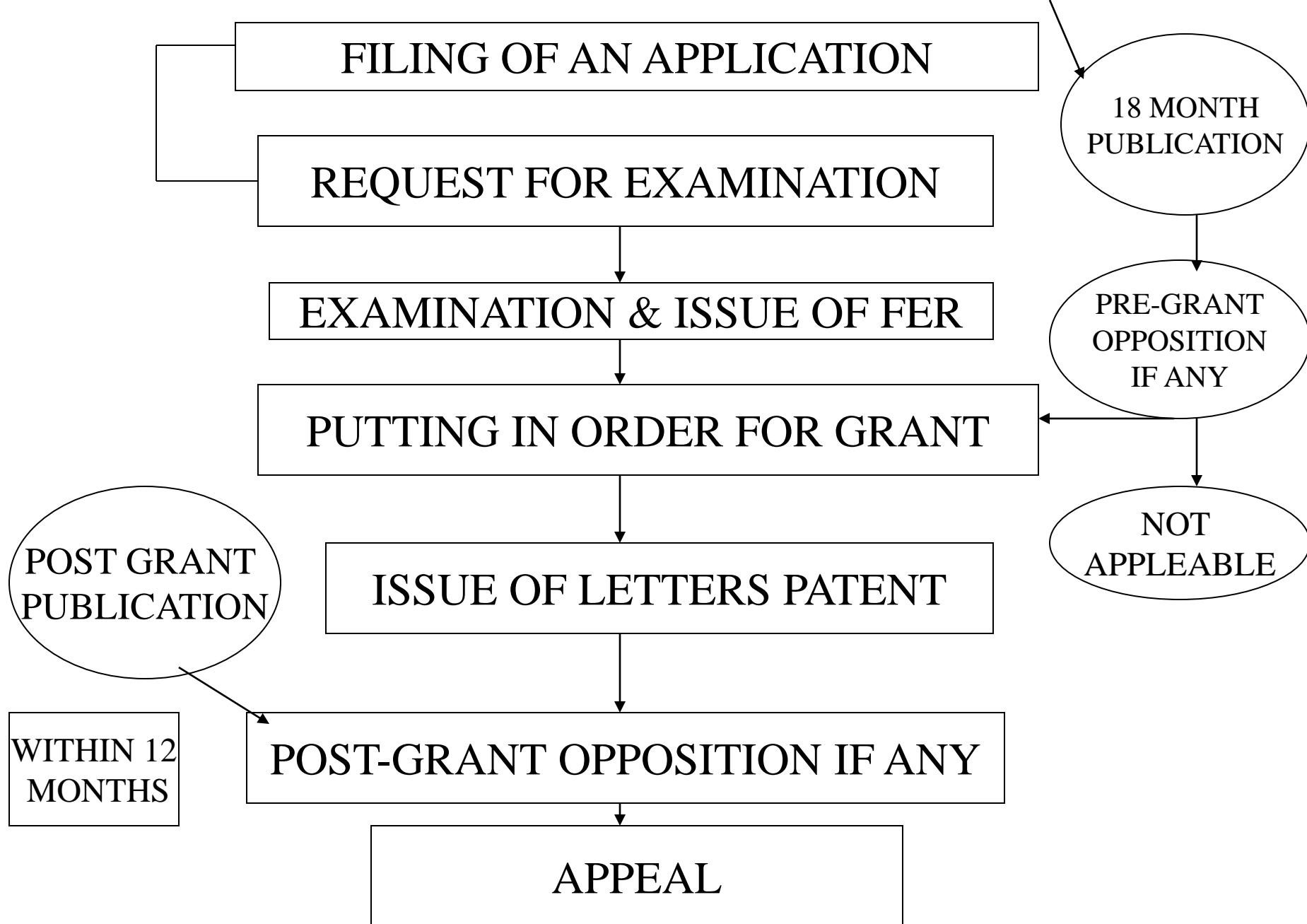
# PUBLICATIONS

- The fact of grant of patent will be published in the patent journal as soon as patent is granted
- The applicant / patentee is entitled to institute any proceedings for infringement with retrospective effect from the 18 month publication
- Post-grant opposition can be filed within 12 months from the date of publication of grant of patent

# TECHNICAL REQUIREMENTS

# COMPLETE SPECIFICATION

- Contents of the specification
- The opening line should read as, "This invention relates to (Title of the Invention)"
- Technical field of invention.
- Prior art with short comings
- Problem with the existing art.
- Proposed technical solution.
- Brief description of the accompanying drawings, if any.
- Detailed description of the invention
- Examples
- Claims.



**THANK YOU**

The image features the words "THANK YOU" in a very bold, black, sans-serif font. The letters are thick and have a slight 3D effect, with a soft grey shadow cast beneath them, giving the impression that the text is floating or standing on a surface. The letters are slightly slanted to the right. The word "THANK" is in all caps, while "YOU" is in a mix of caps and lowercase, with the 'Y' and 'O' being particularly large and rounded. The overall style is clean, modern, and impactful.