Seeking Patent in India: Things to Keep in Mind

Thought Leadership • December 15, 2020

By Vidisha Garg. India has risen the charts of World Bank's ease of doing business ranking from 100 in 2017 to 63 in 2019. It has also become one of the top ten most preferred country for foreign investment. Patent filing in India has also increased from 47854 patent applications in 2017-18 to about 50667 patent applications filed in 2018-19. These statistics clearly show that India has become an important jurisdiction for doing business and therefore, for obtaining patent protection. This being the case, the present articles provides a glimpse into the peculiarities of the Indian patent laws in respect of process and procedure. India being a member of the various convention and international treaty accepts four types of patent applications, namely, ordinary application, which are first filed application; convention applications claiming priority from a previously filed application in a Paris Convention member country; PCT international application, India being the receiving office; and national phase applications in respect of the PCT international application, where India is a designated state. There are a few basic requirements that need to be complied while filing the application in India. The critical ones are discussed herein below: **Proof of Right:** While filing the patent application it is necessary for the applicant to establish his proof of right for making the application. As per section 6 read with section 7(2)of the Patents Act, 1970, along with Rule 10 of the Patent Rules, 2003, the it is mandatory to submit the Proof of Right' when an application for a patent is made by virtue of an assignment of the right. The Intellectual Property Appellate Board (IPAB) in *NTT Docomo Inc. vs. The Controller of Patents and Designs,* had held that the "proof of right" must be filed for all applications filed in India where the applicants are not the true inventors. The documents which can be filed to establish the proof of right may include:

1. Original or notarized copy of the assignment agreements wherein the inventors assign the invention to their company and the company applies for the patent;
2. Employment contract between the inventors and the company stating that all inventions made during the term of employment will belong to the company;
3. Certified or notarized copies of assignments filed in corresponding foreign applications;
4. Filing executed Form 1, under the Patent Rules, 2003 duly signed by inventors;
5. Notarized declaration by the applicant in cases where the applicant is not able to obtain signatures from the inventors.

Proof of right has to be filed along with the application or within six months from the date of filing of the application in India. Failure to comply with the said requirement may lead to the abandonment of the application. **Priority document:** In case of convention applications and national phase applications, it is obligatory to file the priority document along with the application. The *Patents (Amendment) Rules, 2020*, which came into force on October 19, 2020, amended Rule 21. Now in case the applicant has not submitted the 'priority document' in accordance with the requirements of paragraphs (a), (b) or (b-bis) of rule 17.1 of the regulations under the PCT, the same can be

submitted at the time of filing the national phase application in India or within thirty months from the date of priority. Where the priority document is in a language other than English, the applicant is required to submit the English translation thereof duly verified by the applicant or the person duly authorised by him within thirty months from the date of priority. If the applicant is not able to comply with any of the afore-said requirements, the Patent Office shall invite the applicant to file the priority document or the translation thereof, as the case may be. Normally, such invitation is made in the office action. In such case, the applicant will be required to file the priority document or the translation thereof, as the case may be, within three months from the date of such invitation, and if the applicant fails to do so, the claim of the applicant for the priority shall be disregarded. **Details of the corresponding foreign patent applications:** Indian patent laws lay down a very peculiar requirement under section 8(1) of the Act. Any applicant for a patent in India who has made an application for the same or substantially the same invention, has to file along with the application or within six months from the filing of the application in other jurisdictions, the details of corresponding foreign applications and keep the Controller informed until the date of grant of their status from time to time. While Section 8(1) does not stipulate updating the status of the corresponding applications by filing updated statement and undertaking forms, the practice and legal precedents that has evolved require the applicant for the patent to submit the filing information and also the status of the application in the corresponding jurisdictions from time to time for the same and substantially the same invention. Thus, obligation under section 8(1) is a continuous one. Failure to comply with the requirement may lead to the abandonment of the application. Also, non-compliance of said requirement is a ground for opposition and revocation of the patent. The second obligation is that under Section 8(2) of the Act and arises upon a request being made by the Controller of Patents which is usually at the time of issuance of the office action. The Controller may require the applicant to furnish details as may be prescribed relating to the processing of the application in a country outside India. Such information can include search report, office actions, allowed claims etc. **First filing requirement:** Section 39 requires the first filing of a patent application in India. As per Section 39 of the Indian Patents Act, if the invention has been made by a person resident in India, the applicants have two options, namely:

- First file the application in India, wait for six weeks and thereafter file applications outside India; or in the alternative,
- Obtain a foreign filing license from the patent office.

In *Puneet Kaushik vs. UOI and ors.,* the Delhi High Court had held the filing of a PCT application with India as receiving office does not tantamount to first filing of an application in India. In such cases Section 39 of the Indian Patents Act is applicable and the applicant needs to obtain the foreign filing license. For the purpose of defining 'who is resident of India', we usually adopt the definition as provided in Section 6 of the Income Tax Act, according to which a person is said to be a "resident" in India if he spends one hundred and eighty two days or more in any year in India. A year, according to the said Act, is the period from 1st April of any year to the 31st of March of the following year.

Contravention of section 39 of the Act attracts two kind of punishments. Firstly under section 40 of the Act, the application if made in contravention of section 39, is deemed as abandoned and if patent has been granted, the same is liable to be revoked under section 64 of the Act. Secondly, under section 118 of the Act, contravention of section 39 is punishable with imprisonment for a term which may extend up to two years or with fine or with both. **Conclusion:** The above discussed provisions are critical in Indian patent system as non-compliance has severe consequences. It is therefore suggested that these critical requirements are complied with strictly to ensure your patenting experience is as smooth as possible. Happy Patenting. This article was first published by IP Gorilla



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