



Effective Measures for Expediting Allowance of Patent in India

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India has been greatly criticized for the delayed grant process and poor rate of grant. Prior to 2016, the average time for the grant of a patent was more than five years and in some cases it took over ten years for the grant of the patent. There were cases where the term of twenty years had expired and the patent applications were not disposed of by the Patent office. In order to deal with this widespread criticism, a major overhaul of both the patent office systems and patent laws was done. Patent Rules were amended and timelines for the prosecution phase were reduced and new provisions such as expedited examination were brought in the grant and disposal of patent applications increased respectively by 17.15% and 6.69 % in 2018-19.

Apart from the legal timelines, there are certain measures which the applicants can take in order to expedite the grant of patent. In the last few years, we have seen the Indian patent office granting patents in 7 to 11 months. In this article, we shall discuss effective measures for expediting the allowance of a patent.

Completion of all formal requirements at the time of filing

In order to complete the filing process, it is advisable to file formal documents at the time of filing of the application. Such formal documents include the following:

- Proof of right and/or assignment;
- Details of the corresponding patent application;
- Priority document(s) or DAS code or PCT/IB/304;
- Verified English translation of priority document(s) (in case the said document is not in the English language);
- Verified English translation of PCT specification (in case the said document is not in the English language);
- Power of attorney, in case the application is filed through a patent agent.

Amendments of claims and specification

In order to ease the examination, it is advised that the claims are amended prior to examination of the application. Such amendment can be done either while filing the application or after filing but prior to initiation of the examination process.

In case the application has claims which relate to the non-patentable subject matter under sections 3 and 4 of the Act, such claims may be deleted while filing the application. This not only sanitizes the application, it also helps in controlling the cost of filing the application. The claims can also be amended to avoid possible objections to substantive issues of anticipation, obviousness, and non-patentable subject matter. Also, in case there is one or more corresponding foreign patent application, it is advisable to conform the claims to those granted in another jurisdiction, preferably Europe or USA. Such amendments also help in expediting the examination process. However, all amendments need to be in accordance with the requirements of sections 57 and 59 of the Act.

Requesting early publication and examination

An application is taken up for examination, only after a request for substantive examination has been filed. According to the patent statutes, a request for examination under section 11B may be made within forty eight months from the date of priority of the application or date of filing of the application, whichever is later. Further, the patent applications are examined in the serial order in which the requests have been filed. Therefore, in order for the application to be examined early, it is advisable to file the request for examination as early as possible, preferably at the time of filing of the application.

In case of a national phase application, the application is taken up for examination only after expiry of the 31 months' period from the priority date. Therefore, to expedite the examination process of a national phase application, an express request for examination may be filed before the expiry of 31 months from the priority date, so that the Patent Office may examine the application at the earliest. It is to be noted that there is no separate queue for normal and express requests for examination.

However, it is to be noted that applications are only taken up for examination, once they are published under section 11A of the Act. In other words, the first requirement is the publication of application and thereafter examination. Under normal circumstances, the applications are published after eighteen months from the date of priority of the application or date of filing of the application, whichever is earlier. Therefore, if the applicant wants his application to be examined at the earliest, a request for early publication under section 11A (2) may be filed.

Expedited examination

The provision of expedited examination under rule 24C was introduced for the purpose of accelerating the examination of patent applications. As per the said provision, the applicant can file a request for expedited examination, provided the applicant fulfils any of the following criteria:

- the applicant has elected India as an International Searching Authority (ISA) or as an International Preliminary Examining Authority (IPEA) in a corresponding PCT application; or
- the applicant is a start-up as defined in rule 2(fb) of the Patent Rules, 2003; or
- the applicant is a small entity as defined in rule 2(fa) of the Patent Rules, 2003; or
- where all the applicants are natural persons and at least one of the applicant is a female; or
- the applicant is a government undertaking in accordance with section 2(1)(h) of the Patent Act, 1970; or
- the applicant is eligible under an arrangement for processing an international application pursuant to an agreement between the Indian patent office with another participating patent office. Currently, the India Patent Office has bilateral 'Patent Prosecution Highway' (PPH) program with the Japan Patent Office (JPO). Patent applications only in the technical fields of Electrical, Electronics, Computer Science, Information Technology, Physics, Civil, Mechanical, Textiles, Automobiles, and Metallurgy are accepted under this program.

The queue for the expedited examination is separate from that of the normal examination and therefore the applications where expedited examination is requested are examined within one to two months from the date of filing such request. Also, the disposal of the applications is done within three months from the date of receipt of the last reply from the applicant. Therefore, the provision of expedited examination is very helpful in accelerating the allowance of the patent application.

Reply to the examination report

Once the first examination report is issued, the applicant has six months' time to file a reply to the said examination report. If required, an extension of three months can be taken for filing such reply. However, it is in the interest of the applicant that a response is filed as soon as possible. Also, at this stage, the applicant must check if all the technical and formal requirements are met with. In case there is any irregularity in filing any formal document, necessary petitions must be filed for condonation of irregularities. Regarding the technical objection, the submissions w.r.t. novelty and inventive step should be on the same lines as made in the other jurisdictions.



Conclusion

The Indian patent office has gone a long way in plugging the loop holes and making the process smooth. A little awareness and effective measures as discussed above can help in securing the quick grant of patents. What are you waiting for then, go ahead and file your patent application.

