

インド特許庁の特許実務及び手続手引(2019)の 2011年版からの主要な改正点について

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**New Manual of Patent Office Practice and Procedure (2019) –
Key changes over the older version of 2011**

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The Patent Office has been committed to revise the Manual of Patent Office Practice and Procedure (hereinafter the Manual) from time to time based on interpretations by a Court of Law, statutory amendments and valuable inputs from the stakeholders. Accordingly, after a long gap of around 8 years, the new Manual has been published on November 26, 2019 by the Controller General of Patents.

Since 2011, multiple amendments have been made in the Patents Rules 2003, and considerable changes have been made in the patent practice and procedure, including automation and electronic work flow, and it was the need of the hour to revise the manual to capture these developments and provide more transparency in the functioning of the Patent Office.

While there are numerous changes over the older version of the manual, to capture the developments and also to provide further clarifications over the already covered provisions, the key changes are highlighted below:

Reference	Key Feature
Chapter 1 - Introduction	
Paragraph 13	<p>The Manual describes the common procedures and practices regarding type and submission of documents, like affidavits, only a single copy of any original document, and appropriate stamp duty for Form 26, under the Indian Stamps Act.</p> <p>The Manual clarifies that self-declaration signed before the Controller would also be acceptable as evidence, if the Controller so allows.</p> <p>The Manual also clarifies that, in case of multiple filing of a document, the latest document shall be considered as final and the corresponding earlier document shall be considered as superseded and cancelled.</p>
Chapter 2 - Key definitions	
Para 02.02.17 and 02.02.18	The new Manual includes the definition of small entity and start up in line with the amendments made in Patents Rules, 2003.
Para 02.02.10	<p>The definition of “Opposition Board” has been included in the Manual based on the provisions under Section 25(3) and 2(1a) of the Patents Act, 1970. However, the Section for reference provided in the Manual is Section 1(1a) which seems to be a mistake.</p> <p>While the draft manual published on March 1, 2019, had proposed to include definition of “new invention” “International Application”; and had cited case law for explaining “person interested”, such proposals are not</p>

Reference	Key Feature
	included in the new Manual.
Chapter 3 - Filing of Patent Application	
Para 03.04.01	<p>The new Manual clarifies that a proof of right is required in all applications, irrespective of whether it is a convention application or a national phase application. Similar clarification has been issued with respect to filing of Declaration as to inventorship in Form 5, which is required to be filed with even convention applications and national phase applications, and where complete is filed after provisional application.</p> <p>Form of Authorisation The new Manual also seems to make it mandatory to file a self-attested copy of a general power of attorney, if it has already been filed in another application.</p> <p>Priority Document It is clarified that for National phase applications, if the requirement under PCT Rule 17.1(a) or (b) is not complied, then the certified priority document would be required to be submitted within 31 months from the earliest priority.</p> <p>Ink Signature Copy Not required It has been clarified that, where the documents have been digitally signed by the Applicant/Patent Agent, there will be no requirement of physical signature of the agent or applicant.</p>
Para 03.04.02	<p>Online payment defined Online payment of fees can be made through a payment gateway with all the prevalent major modes of payment like Net banking, Credit Cards, Debit Cards and Unified Payments Interface (UPI).</p>
Para 03.04.03	<p>It was already present in the rules, and now has been clarified in the new Manual that a patent agent has to file, leave, make or give all documents only by electronic transmission duly authenticated.</p> <p>Applicants/Agents sometime face difficulty in filing documents online due to online transaction failures. It is clarified that, whenever an applicant is unable to submit the documents in time due to failure of server/Bharat Kosh/IT infrastructure on part of the Office, the applicant/patent agent is required to take screen shot of the problem and submit the same to the Office along with a statement regarding the circumstances of the facts as evidence in support as per Rule 6(5), whereupon such delay may be condoned after due verification by the Office.</p> <p>It has also been explained that, the condonation of such delay can also be made for reasons of war, revolution, civil disorder,</p>

Reference	Key Feature
	<p>strike, natural calamity, a general unavailability of electronic communication services or other similar reasons occurred in the locality where the applicant/agent resides or has place of business. The delay can be allowed when the applicant/agent files a petition for condonation of such delay to the Controller provided the situation was of such severity that it disrupted the normal communication in that area and that the petition is filed within maximum one month from the date of cessation of such situation.</p>
<p>Para 03.04.05</p>	<p>Language and Paper-size etc. All documents and copies of the documents, except affidavits and drawings, filed with patent office, shall be:</p> <p>On such paper which is flexible, strong, white, smooth, non-shiny, and durable of size A4 of <u>approximately 29.7 centimetre by 21centimetre with a margin</u> of at least 4 centimetre on the top and left hand part and 3 centimetre on the bottom and right hand part thereof</p> <p>Containing numbering to <u>every fifth line of each page of the description and claims</u> at right half of the left margin.</p>
<p>Para 03.04.06</p>	<p>A nucleotide sequence shall be listed with a maximum of 60 bases per line, with a space between each group of 10 bases. The bases of a nucleotide sequence (including introns) shall be listed in groups of 10 bases, except in the coding parts of the sequence. Leftover bases, fewer than 10 in number at the end of non-coding parts of a sequence, should be grouped together and separated from adjacent groups by a space. The bases of the coding parts of a nucleotide sequence shall be listed as triplets (codons).</p> <p>Any sequence listing in electronic form shall be contained within one electronic file encoded using IBM 39 Code Page 437, IBM Code Page 93240 or a compatible code page to represent the sequence listing with no other codes included. Any sequence listing in the electronic document format as specified shall preferably be created by dedicated software such as PatentIn.</p> <p>(REFERENCE: WIPO STANDARD ST.25 FOR THE PRESENTATION OF NUCLEOTIDE AND AMINO ACID. URL: https://www.wipo.int/export/sites/www/standards/en/pdf/03-25-01.pdf)</p>
<p>Para 03.04.07</p>	<p>It is clarified that, when a small entity/start up is an applicant, every subsequent document for which a fee has been specified, shall be accompanied by Form 28 with duly authenticated copy</p>

Reference	Key Feature
	<p>of the evidence of small entity/start up.</p> <p>When a patent application is transferred from one applicant category to another applicant category of different status, wherein there is a difference in the official fee, then such differential official fee has to be paid. However, if a start-up ceases to be a start-up either by completion of 7/10 years or crossing the financial threshold, then no differential fee is to be paid.</p>
<p>Para 03.05.02</p>	<p>The numbering system for applications has been explained</p> <p>FORMAT: YYYY J T NNNNNN, Where, "YYYY" is Four digit fixed length "Year of filing"</p> <p>"J" is fixed length single digit "Jurisdiction" in numerals: (1 for Delhi, 2 for Mumbai, 3 for Kolkata, 4 for Chennai)</p> <p>"T" is fixed length single digit "Type of Application" in numerals: (1 for Ordinary; 2 for Ordinary-Divisional; 3 for Ordinary-Patent of Addition; 4 for Convention; 5 for Convention-Divisional; 6 for Convention-Patent of Addition; 7 for PCT NP; 8 for PCT NP-Divisional and 9 for PCT NP-Patent of Addition)</p> <p>"NNNNNN" is 6 digits fixed length common continuous running serial number of applications applicable for all Patent Offices in India</p> <p>Thus, 1st application (Ordinary) filed in Delhi in 2019 will be numbered as 201911000001. If 2nd application in 2019 is "Convention" application from Mumbai it would be numbered as 201924000002.</p> <p>Numbering Format for Request for Examination Format: RYYYYJNNNNN, where,</p> <p>"R" denotes Request for examination u/r 24B(1)(i) "YYYY" denotes four digit fixed length "Year of filing"</p> <p>"J" denotes Jurisdiction for Patent Application against which Request of Examination has been filed</p> <p>"NNNNNN" denotes 6 digits fixed length common continuous running serial number applicable for all Patent Offices in India.</p> <p>Numbering Format for Request for Expedited Examination • Format: EYYYYJNNNNN where, "E" denotes Request for Expedited Examination under rule 24 (C).</p>

Reference	Key Feature
Para 03.05.06	For inventions relating to atomic energy, the Manual has provided the link for the updated list of prescribed substances, under Atomic Energy Act 1962, published vide notification dated 28 th April, 2016, which may be accessed at http://dae.nic.in/writereaddata/Prescribed-eng.pdf
Chapter 4 - Publication of Application	
Para 04.01	<p>While the old Manual had provided a clarification that even a National phase application can be withdrawn, if National Phase application has been filed prior to expiry of 15 months from the date of earliest priority. Such clarification has been removed from the new Manual. But this does not change the position and it is understood that, for withdrawing a national phase application for avoiding publication, it should have been filed within 15 months of earliest priority date.</p> <p>The clarification provided in the old Manual that an application will not be published unless a power of authority (PoA) has been filed, is removed. This is understood to be consistent with the fact that under the new Manual, it is clarified under para 21.05, page 169, that if PoA is not filed within 3 months of filing of the application or document, no further processing would be done on such application or document.</p> <p>The New Manual clarifies that the publication of application shall be identified by the letter 'A' along with the number of Application.</p>
Para 04.02	<p>The new Manual provides additional clarification that even under request for early publication an application would be published only if complete specification has been filed.</p> <p>While the old manual described that an invention relevant for defence or atomic energy would not be considered for publication, the new manual only puts this restriction for inventions relevant for defence.</p>
Chapter 5 - Provisional and Complete Specification	
05.01	<p>The direction for filing of forms or documents in duplicate has been removed, in view of the e-filings.</p> <p>A paragraph on Filing amendments to the specification has been included based on the rules.</p>
05.03.01	<p>While there are many other changes for clarification purposes, for the contents of complete specification, additional clarifications have been provided, that complete specification shall:</p>

Reference	Key Feature
05.03.09	<ul style="list-style-type: none"> • not include irrelevant or other matter, not necessary for elucidation of the invention, from the title, description, claims and drawings. • in case of a specification for Divisional Application, shall contain specific reference to the number of original application from which the divisional application is made. • in case of a specification for Patent of Addition, shall contain a specific reference to the number of main patent or application for patent, as the case may be, and a definite statement that invention comprises an improvement in or a modification of the invention claimed in the specification of the main patent granted or applied for. <p>With respect to deposition of biological matters, the Manual has mentioned the depository authorities as:</p> <ul style="list-style-type: none"> • Microbial Type Culture Collection and Gene Bank (MTCC) Chandigarh. For further information on Microbial Type Culture Collection and Gene Bank (MTCC) please visit- https://mtccindia.res.in/ • Microbial Culture Collection (MCC), Pune For further information on NCCS please visit- http://www.nccs.res.in/g) Reference to such biological material shall be made in the Specification within three months from the date of filing, giving all the available characteristics of the material required for it to be correctly identified or indicated including the name, address of the depository institution and the date and number of the deposit of the material at the institution.
Chapter 6 - Divisional Application and Patent of Addition	
06.01.01	<p>It is clarified that, if Power of Attorney (PoA) filed in the parent application provides authorization to file divisional application as well then <u>no copy of PoA would be required to be filed in the divisional application(s).</u></p> <p>Similarly, if the requirement of Proof of Right is met on parent application, <u>filing of Proof of Right would not be required for divisional application(s).</u></p> <p>Under general guideline for Divisional applications, a new paragraph has been introduced that “<i>Claims of divisional</i></p>

Reference	Key Feature
	<p><i>application(s) shall be based on the claims of first mentioned (or earlier application for that matter) from which instant application is divided out and no addition of claims, which do not fall within the scope of said claims, is allowable.”</i></p> <p>The new content seems to be an arbitrary extension of provisions for divisional application and imposes restriction on claims that can be filed in a divisional application.</p>
06.01.04	It has been clarified that the divisional application shall be filed at the appropriate office of the first mentioned application only.
06.02.02	<p>Case law has been cited, that does not require the patent of addition to be inventive over the main patent: <i>“In the matter of Ravi Kamal Bali v/s Kala Tech and others the Bombay High Court on 12th February, 2008 dismissed the defendant’s arguments that Patent of addition can only be granted if it has an inventive step over the main application”.</i></p>
<p>Chapter 7 - Convention Application, International Application and National Phase Application</p>	
Para 07.02 - International Application under PCT	The new Manual captures the new rules and e-filing procedure for the PCT International application and also indicates about Indian Patent Office as ISA/IPEA
Para 07.03.02	<p>Deletion of claims at National Phase Entry The new Manual clarifies that claims may be deleted at the time of National Phase entry, to reduce the total number of claims, and for such deletion, filing of request for amendment (Form 13) is not required.</p> <p>It is further clarified that, only deletion of claims is allowable and no other amendment, such as addition, revision or modification of claims, is allowable. However, correction of dependency of claims remaining after deletion of claims is allowable without separate request for amendment.</p> <p>The new Manual also clarifies that this provision of deletion of claims without amendment is not applicable for the national phase application filed before May 16, 2016.</p> <p>Certified Priority Document It is clarified that, if the priority document has been submitted through WIPO-DAS, then the code for accessing the priority document can be submitted with the Patent Office and it would be sufficient.</p> <p>Expedited and Express Examination The new Manual clarifies that, if an applicant desires for an expedited examination in a national phase application prior to the expiry of 31 months from the earliest priority, then along</p>

Reference	Key Feature
	with request for expedited examination, the applicant would have to file a request for express examination as well.
Chapter 8 - Indian International Searching Authority and Indian International Preliminary Examination Authority	
	<p>In 2011, the Indian Patent Office was not functional as International Searching authority (ISA) or International Preliminary Examining Authority (IPEA). Hence, this chapter is newly included in the Manual.</p> <p>Manual explains that the Indian Patent Office started functioning as ISA and IPEA from October 15, 2013.</p> <p>At present, Indian Patent Office is competent as ISA/IPEA only for applicants who are nationals/residents of Indian and/or Iran.</p> <p>The chapter describes the procedure and timelines for the functioning of Indian Patent Office as ISA/IPEA.</p>
Chapter 9 - Examination & Grant	
Para 09.01	In addition to Rule 24B, new rules namely, Rule 20(2), 20(4)(ii), and 24C are included in examination procedure. Earlier only Rule 24B was mentioned.
1	New Form 18A apart from Form 18 is included for requesting Examination. Earlier only Form 18 was mentioned. Form 18A is already in practice.
2	Point 3 of earlier manual is merged in point 2 of the new manual. Further, a paragraph (i.e., Rule 24B(iv)) relating to timeline for filing request for examination of divisional application is added. Timeline for filing divisional application is already in practice
3	<p>This new point is added relating to examination of national phase application of international application:</p> <ul style="list-style-type: none"> • Generally, Patent office will not examine the national phase application before 31 months from the date of priority of that application. <p>However, Patent office can examine the national phase application before 31 months, upon filing express request in Form 18 along with prescribed official fee.</p>
5	<p>Two case laws inserted regarding Examination of Patent Application.</p> <ul style="list-style-type: none"> • <i>Nippon Steel Corporation vs. Union of India (UOI)-W.P. (C) 801 Of 2011 (08.02.2011): Manu/De/07/12/2011</i>, is cited to clarify that once application is deemed to have been withdrawn by applicant in terms of Section 11B(4) of Act, the Controller of Patents cannot entertain application on the further request. • <i>Sphaera Pharma, Pte. Ltd And Anr. vs Union Of India</i>

Reference	Key Feature
	<p><i>And Anr. on 16 February, 2018</i> is cited to clarify that the benefit of Rule 138 would not be available to the petitioner (who requested for extension of time under Rule 138 to file a request for examination in Form 18), as no such application for extension of time was made prior to expiry of the prescribed time.</p>
09.01.01	New Point 09.01.01 is added for Expedited examination of applications (Rule 24B, 24C).
1-14	Taken from revised Rule 24C(1)-(13) and already in practice from September 17, 2019
09.02	Reference for Examination
2-4	New points 2-4 are added in new manual and taken from Rule 24B(2)(i) and already in practice.
8-10	New points 8-10 are added and have been taken from Rule 24B(2)(iii) and 24B(3) and already in practice
09.03	Examination of application
1	<p>Expressions of old manual “<i>and all the patent databases of other countries such as: EPO database, WIPO database, USPTO database, JPO DATABASE, TKDL (Traditional Knowledge Digital Library) and other paid databases</i>” have been replaced with the expression “<i>and all the available databases including patent/non patent literature</i>” in the new manual. Further, the old expression <i>PCT Minimum required patent and non-patent literature is searched</i>” is replaced with the new expression “<i>PCT Minimum documentation is searched</i>”.</p> <p>Changes are only for the clarity.</p>
3	<p>New point 3 is a part of old point 1 with the added expression <i>being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.</i> (This is related to prior claiming (Section 13)).</p> <p>Changes are only for the clarity</p>
09.03.02	Novelty
1	<p>Point 1 of new manual is part of point a) of old manual with some clarification like <i>prior art means everything that has been published, presented or otherwise disclosed to the public before the date of filing/<u>priority date</u> of complete specification.</i> The highlighted term <i>priority</i> is added in new manual.</p> <p>Changes are only for the clarity</p>
2	<p>Point 2 of new manual is part of point b) of old manual and related to <i>An invention is considered as novel, if it has not been anticipated by prior use or prior public knowledge <u>in India</u></i></p> <p>Changes are only for the clarity</p>
09.03.03	Inventive step

Reference	Key Feature
	<p>Earlier there no case laws were cited in the manual, however now following case laws are included for inventive step, Biswanath Prasad Radhey Shyam vs Hindustan Metal Industries Ltd Salmond L. J. in Rado v. John Tye & Son Ltd. F. Hoffman la Roche v Cipla</p> <p>Further, following points or test for inventive step are described now: <i>The —obviousness must be strictly and objectively judged. While determining inventive step, it is important to look at the invention as a whole.</i> <i>Accordingly, the following points need to be objectively judged to ascertain whether, looking at the invention as a whole, the invention does have inventive step or not:</i></p> <ul style="list-style-type: none"> <i>i. Identify the "person skilled in the art", i.e. competent craftsman or engineer as distinguished from a mere artisan;</i> <i>ii. Identify the relevant common general knowledge of that person at the priority date;</i> <i>iii. Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;</i> <i>iv. Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;</i> <i>v. Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of inventive ingenuity?</i>
09.03.05	<p>Inventions not patentable</p> <p>List of following guidelines are included, which were not included in earlier manual. <i>In addition to the illustrations in the instant Manual, the following subject-specific Guidelines have been issued and the same are hyperlinked as under:</i></p> <ul style="list-style-type: none"> <i>1) Revised Guidelines for Examination of Computer-related Inventions (CRIs)</i> <i>2) Guidelines for Processing of Patent Applications relating to Traditional Knowledge and Biological Material</i> <i>3) Guidelines for Examination of Biotechnology Applications for Patent</i> <i>4) Guidelines for examination of patent applications in the field of Pharmaceuticals</i>
09.03.05.04	<p>Section 3(d) Case law of Novartis AG Vs. Union of India, W.P.No. 24760/06 (Supreme court) is cited for therapeutic efficacy. Earlier Madras High Court decision was cited for this.</p>
09.03.05.10	<p>Section 3(k) Revised Guidelines for Examination of Computer-related</p>

Reference	Key Feature
	Inventions (CRIs), 2017 and brief of the Guidelines are included which was not mentioned in old manual.
09.03.06	<p>Information and undertaking regarding foreign applications has been included. Further, recent arrangement with WIPO regarding access to Patent Information has been included</p> <p>A. WIPO DIGITAL ACCESS SERVICE - Electronic system allowing priority documents and similar documents to be securely exchanged between participating intellectual property (IP) offices</p> <p>B. WIPO CENTRALIZED ACCESS TO SEARCH AND EXAMINATION (WIPO CASE) - Enables patent offices to securely share search and examination documentation related to patent applications in order to facilitate work sharing programs.</p> <p>Thus, Indian Patent Office has now access to search and examination reports of the corresponding applications filed in major patent offices.</p> <p>Legal jurisprudence: of Section 8 is discussed:</p> <ul style="list-style-type: none"> • the provision for revocation of patent under section 64(1) (m) on the ground of non-compliance of Section 8 should not be exercised solely and automatically just because it exists in the Act, as there lies a discretion in the Court not to revoke the patent on the peculiar facts and circumstances of the present case. The said discretion exists by use of the word, —may under Section 64 of the Act. • It is also necessary to consider the question whether there was deliberate or willful suppression and whether the undisclosed information was —material to the grant of the patent. The Court can decide the fate of revocation petition only after considering such issues at trial on the basis of evidence submitted. <p>Reference of case laws are listed regarding Section 8</p> <p>Guiding Principles to Patent Examiners and Controllers regarding requirement Under Section 8 are discussed</p> <p><i>1. The examiner/Controller shall check whether the applicant has filed a statement to the effect that the stipulated documents are available in WIPO CASE and DAS, from where the Office can access the documents. If such a statement has not been filed, then the applicant is required to provide all relevant documents and/or information, without fail.</i></p> <p><i>2. The examiner/Controller shall check and ascertain whether the priority documents and similar documents pertaining to the</i></p>

Reference	Key Feature
	<p><i>application being processed in the Indian Patent Office are available in the WIPO Digital Access Service (DAS). If such documents are available, further information with regards to priority may not be sought for, from the applicant.</i></p> <p><i>3. The examiner/Controller shall utilise all the facilities available in WIPO CASE regarding processing of corresponding patent applications in other countries, including access to Search and Examination reports, and other information available with Patent Offices that are part of WIPO CASE (currently Australia, Brunei Darussalam, Canada, Chile, European Patent Office (EPO), India, Israel, Japan, New Zealand, Republic of Korea, Singapore, International Bureau of WIPO, United Kingdom, United States of America).</i></p> <p><i>4. Notwithstanding any of the steps mentioned above, the Controller may seek details as stipulated under Section 8(2) of the Patents Act, 1970 relating to the processing of the application in a country outside India, including but not limited to, Search and/or examination reports, Claims of application allowed/ disallowed, Amendments made, if any, etc. n other Patent offices.</i></p> <p><i>5. Wherever, the Controller accepts fulfillment of section 8 and 138 requirements through the documents available in WIPO Case and WIPO DAS, all such documents therefrom shall be uploaded in a file wrapper by the office.</i></p> <p>In view of the above guidelines, the applicant is expected to submit a statement that the stipulated documents are available in WIPO CASE and WIPO DAS. In absence of such a statement, the applicant is liable to submit such documents with the Patent Office.</p> <p>While it is described that the examiner/Controllers shall access the search and examination reports from WIPO CASE, but they still have the right to ask the applicant to submit such documents.</p>
09.03.07	<p>Sufficiency of Disclosure (Section 10)</p> <p>Basically, similar to old manual with explaining how much details are required to mention in the complete specification relating to deposition of the biological material, which are as following:</p> <p><i>g) if the applicant mentions a biological material in the specification which may not be described and if such material is not available to the public, the application shall be completed by depositing the material to international depository authority under the Budapest treaty.</i></p> <p><i>h) Accession Number and date of deposition of the material in the depository institution along with name and address of the depository authority shall be given, if applicable.</i></p> <p>Section</p>

Reference	Key Feature
09.04	<p>Consideration of Report by Controller and issuance of First statement of objection/ First Examination Report (FER) Section 3, and 4 are deleted. However, Rules 24B, 28, and 28 A are added.</p> <p>Following points are substantially new in new manual</p> <p>5) <i>The period of 6 months is extendable only once for a maximum period of three months, if requested in Form 4 within the prescribed period of 6 months, along with fees.</i></p> <p>8) <i>Hearing may also be held through video-conferencing or audiovisual communication devices. Such hearing shall be deemed to have taken place at the appropriate office.</i> <i>Explanation.–For the purposes of this rule, the expression communication device shall have the same meaning as assigned to it in clause (ha) of sub-section (1) of section 2 of the Information Technology Act, 2000 (21 of 2000).</i></p> <p>107</p> <p>9) <i>In all cases of hearing, written submissions and the relevant documents, if any, shall be filed by the applicant within fifteen days from the date of hearing.</i></p> <p>Following point of old manual is deleted:</p> <p>10. <i>If the Controller differs with the report of the Examiner at any stage of the Examination and Grant Process, he shall record the reasons for such disagreement in the file.</i></p> <p>The above changes are already in practice.</p>
09.05	<p>Post-dating of Application for Patent</p> <p>Basically, similar to old manual. However, below points are added:</p> <p>3) <i>Regarding date of filing in case of Post-dating of application, the following should be kept in mind:</i></p> <p>i) <i>Applicant can file an application with Provisional Specification and then file Complete Specification within the prescribed period of 12 months. In this case, the date of filing of application with provisional specification will be the date of application.</i></p> <p>ii) <i>Applicant can file an application with Complete Specification and, thereafter, request to convert it into Provisional Specification within 12 months from the original filing date and file Complete Specification within 12 months from the original filing date. In this case, the date of filing of application will still be the original filing date [Section 9(3)].</i></p> <p>iii) <i>After filing the complete specification, the applicant may cancel the provisional specification [i.e. the one filed directly under Section 9(1) or the one converted from a complete specification under Section 9(3)], and may request the Controller to post-date the application to the date of filing of the complete specification. In this case, the date of application will be the date on which such complete specification is filed</i></p>

Reference	Key Feature
	<p><i>[Section 9(4)].</i></p> <p><i>iv) Section 17 (1): Subject to the provisions of section 9, at any time after the filing of application and before the grant of patent, the Controller may, at the request of applicant made in the prescribed manner, direct that the application shall be post-dated to the maximum period of six months from the date of filing the application.</i></p> <p><i>Therefore, the said period of six months as provided in section 17(1), shall be counted from the Date of application as stated above in (i), (ii) or (iii), as the case may be.</i></p> <p><i>If postdating is allowed after publication of the application, the fact of postdating should be published in the Official Journal to specify a new date of filing.</i></p> <p>In view of the above, an application can be post-dated for a maximum period of 6 months from the date of application. Considering that post-dating would be applicable for an application under Section 9(4), for a period of 6 months from the date of application, then in such circumstances, the actual post-dating may be for a maximum of 18 months, viz. first post-dating by cancelling the provisional and post-dating to the date of filing of complete application, and then applying for post-dating under Section 17(1) for another 6 months from the date of application. Some clarifications might be required in this regard.</p>
09.06	Pre-Grant Opposition
	Point 1 is same except mentioning Form 7A, and serving a copy of pre-grant opposition representation to the applicant. This is already in practice.
	Point 2 is similar to old manual except clarification that patent is 'granted' on the date on which the Controller passes a final order to that effect on the file.
	A case law is cited viz., Neon Laboratories Pvt. Ltd. vs. Troikaa Pharma Limited and Ors. (Writ Petition No. 211 of 2010) , wherein the Bombay High Court held that "When the law consciously confers a right on a person that right must be protected in the way it has been granted." "Section 25(1) of Patents (Amendment) Act and Rule 55 of Patent Rules contemplate that, if the original claim/application for grant of patent is amended and the amendments are opposed, then, a personal hearing to the objector on the amended claims is required to be given if specifically requested"
09.07	Grant of Patent
09.07.01	Compliance of conditions under the Act Some point of old manual is removed and below points are added:

Reference	Key Feature
	<p><i>The date of grant of patent is the date on which the patent is granted by the Controller. The date on which the patent is granted shall be entered in the register. The fact that the patent has been granted is published in the official journal of the Patent Office.</i></p> <p><i>As the Patent Office has moved to electronic processing, the fact of grant of patent by the Controller, Patent Number is reflected on the official website on real time basis. The patent certificate is also made available in the website.</i></p>
<p>09.07.03</p>	<p>Date of Patent Point 1 is similar to old manual. However, changes in point 2 as below:</p> <p><i>2) Notwithstanding anything contained in this section, no suit or other proceeding shall be commenced or prosecuted in respect of an infringement committed before the date of publication of the application.</i></p> <p><i>However, on and from the date of publication of the application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for the invention had been granted on the date of publication of the application.</i></p>
<p>Chapter 14 - Compulsory Licensing</p>	
<p>Para 14.01</p>	<p>Working of patents - General principles</p> <p>The new manual has removed clause (h) saying “Patented inventions are worked on a commercial scale in the territory of India without undue delay and to the fullest extent that is reasonably practicable”.</p> <p>The new manual has also removed clause (i) indicating “The interests of any person for the time being working or developing an invention in the territory of India under the protection of a patent are not unfairly prejudiced.”</p> <ul style="list-style-type: none"> • Thus the workability of the patent is now independent of these clauses. • No significant impact since the summary of clauses (h) and (i) is already present in the remaining clauses (a) to (g).
<p>Para 14.02.01</p>	<p>Compulsory License under Section 84</p> <p>As per the new manual, while considering an application for compulsory license, the Controller shall take into account all the grounds i-iv as mentioned in the previous manual with an addition that “but shall not be required to take into account matters subsequent to the making of the application”.</p>

Reference	Key Feature
	<ul style="list-style-type: none"> Further clarifies that the consideration for the application of a compulsory licence would not take into account any condition that arises after making the application.
Para 14.02.01.03	<p>Adjournment of application for compulsory licence in certain cases</p> <p>In the new manual, this section related to the adjournment of application for compulsory licenses under section 86 of the Patents act has now been added.</p> <ul style="list-style-type: none"> The conditions related to the adjournment of applications were already present in the Patents Act. Inclusion of these conditions in the manual would further emphasize the workability of this section.
Para 14.02.02	<p>License for related patents</p> <p>In the new manual, sections 87-90 are no more considered under the License for related patents, only section 91 is considered.</p> <ul style="list-style-type: none"> Change made in accordance with the Patents Act wherein section 91 specifically relates to licensing of related patents.
Para 14.02.03	<p>Compulsory licence on Notification by Central Government</p> <p>In the new manual, the term “sealing” has been replaced with the term “grant”.</p> <ul style="list-style-type: none"> Thus while considering applications for compulsory license, the Central Government would take into consideration the time from the grant of the invention. No significant impact since both the terms refers to the same meaning. Moreover, the term sealing is no more used now and is not used in any of the remaining sections.
Para 14.02.05	<p>Termination of Compulsory License</p> <p>In the new manual, it has been added that the patentee needs to “make an application in Form 21 along with the evidence in support of the application for termination of compulsory licence granted under Section 84 on the ground that the circumstances that gave rise to the grant thereof no longer exist and such circumstances are unlikely to recur”.</p> <p>The new manual adds a new clause (c) related to termination</p>

Reference	Key Feature
	<p>indicating “The procedure as elaborated under rule 102 for dealing with such application for termination of compulsory licence, including conducting hearing involving the both the parties, shall apply.”</p> <p>The new manual further adds a new clause (e) related to termination indicating “If the Controller decides to terminate the compulsory licence he shall forthwith issue an order giving terms and conditions, if any, of such termination and serve copies of the order to both the parties.”</p> <ul style="list-style-type: none"> • The change has been made in accordance with rule 102 of the Patents Act. • No significant impact, since the terms were already present in the Patents Act. Inclusion of these terms in the manual might emphasize on the workability of the process.
Chapter 22 - Time Limits	
22.03, 3, Serial No. 40	<p>While Rule 85(1) provides a period of 2 months for filing “Notice of Opposition against restoration”, the manual has indicated said timeline to be one month from the date of publication.</p> <p>This probably seems to be an error.</p>
22.03, Serial No. 1 and 2	<p>Subsection (a) is specifically mentioned for the statement and undertaking under rule 81 and subsection (b) is specifically mentioned for the subsequent information corresponding to foreign filing under rule 81.</p>
22.03, Serial No. 6	<p>For declaration of inventorship (form 5), specific mention is included that the time limit “within one month from the date of filing of the complete specification” is “as the Controller may allow on an application made in Form-4”.</p>
22.03, Serial No. 13	<p>For publication of application, wordings are amended for increasing clarity: Old “Ordinarily within one month from the expiry of eighteen months from the date of filing or priority or one month from the date of request for early publication, whichever is earlier” is replaced with New “Ordinarily within one month from the expiry of eighteen months from the date of filing or priority date, whichever is earlier, or within one month from the date of request for early publication.”</p>
22.03, Serial No. 27	<p>Time limit for “Notice of opposition (post-grant opposition)” is clarified that it is “Before the expiry of one year from the date</p>

Reference	Key Feature
	of publication of grant of patent”.
22.03, Serial No. 32	In “Controller disposes permission for filing abroad”, the statement is made more definite by deleting the word “Ordinarily” and clarified that the twenty one days is from filing of such request. The statement reads currently as: “Within a period of twenty-one days from the date of filing of such request”.
22.03, Serial No. 34	Wordings “first” Renewal fee is replaced by “due” renewal fee.
22.03, Serial No. 38	For “Application for restoration of patent”, wordings are changed from “Eighteen months from the date on which the Patent ceased to have effect” to “Eighteen months from the date of cessation of the patent”.
22.03, Serial No. 14	A new line item is added for “Request for withdrawal and refund of Fee” as “In case withdrawal is requested after filing Request for examination but before issuance of FER, then fee is refunded as prescribed in the First Schedule”.
22.03, Serial No. 33	In the “Time after which no permission is required for filing abroad”, explicit addition is made to include “or application has not been referred to Department of Atomic Energy (DAE)”. The statement now reads as “Six weeks after filing the application in India, where no direction for secrecy is imposed or application has not been referred to Department of Atomic Energy (DAE)”.

End of document