

## INDIA IP SME HELPDESK

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# GUIDE TO PATENT PROTECTION



### 1. Introduction

Patents are exclusive rights granted for an invention – a solution to a technical problem – which entitles the patent holder to prevent third parties from commercially exploiting (making, using, selling or importing) the invention. Inventions allow many businesses to be successful because they develop new or better processes or products that offer a competitive advantage in the marketplace.

Like all IP rights, patents are territorial in nature, which means that they are only valid where they have been successfully registered. A patent registered in Europe has no legal effect in India and can therefore not be enforced there. Consequently, any European SME looking to do business in India, and wishing to protect its exclusive rights in its inventions on this market should make use of the Indian patent system. EU SMEs should note that the patent granting process may take between 4 to 6 years to be completed, from date of filing of the patent application to date of grant of the patent.

The Indian Patent Office (IPO), administered by the Office of the Controller General of Patents, Designs and Trademarks (CGPDTM), is the authority in charge of granting patents in India.

The Head Office of the IPO is located in Kolkata, and counts three additional branches located in Delhi, Chennai and Mumbai. Depending on the address of the applicants (or their legal representative), any patent applications should be filed in one of the four offices having territorial jurisdiction. Although there are four offices, the substantive and formal procedures for granting the patent remain the same across all four offices. The Controller may even allocate the prosecution of the application to any of the four Patent Offices.

## 2. Patent applications in India: what you need to know

### A. What can be patented

In India, as in Europe, any invention must satisfy three basic requirements in order to be patentable: it must be new, inventive and it must be capable of industrial application.

**Novelty** – the invention should be new, i.e. it may not have been previously disclosed to the public anywhere in the world, in any form, or through any medium. The invention is considered as novel if it has not been anticipated by prior use or prior public knowledge in India.

This requirement is strict, with only a few caveats. Disclosure by third parties who received the information from the patent applicant and disclosed it without its consent and infringing an obligation of confidentiality is one such exception.

Furthermore, a grace period of 12 months is provided prior to the filing of the application during which novelty of an invention will not be hurt provided the disclosure falls within one of the following categories:

- Public display in an exhibition organised by the government and notified to IPO;
- Description of the invention in a paper read by the inventor before a learned society;
- Public working of the invention for a necessary trial, due to the nature of the invention.

**Inventive step / non-obviousness** – the invention should be substantially different from previously known technology in the field. To determine this, the claimed invention should not be a development over existing technology/ies which would be obvious to an expert in the field.

**Industrial Application** – the new product or process should be capable of being made or used in an industry.

#### TIPS AND WATCH-OUTS:

##### Claiming priority

*The date on which a first patent application for a certain invention was filed is considered as the 'priority date'. This first filing creates a 'priority right' that ensures, in respect of subsequent patent applications filed within 12 months for the same invention, that all disclosures made after this priority date will be ignored in the examination of an invention's novelty.*

### B. What cannot be patented

Besides complying with the patentability criteria, the claimed invention must not fall within certain categories which are not considered patentable as such. Under the India Patent Act, unpatentable subject matter includes the following:

- inventions which are considered frivolous or contrary to public order, morality, public health, etc.
- mere discovery of scientific principle, or any living or non-living substance occurring in nature
- mere discoveries of new forms of known substances not resulting in enhanced efficacy, or discovery of a new property or new use of a known substance.
- methods of agriculture or horticulture
- medical, surgical, diagnostic or therapeutic methods for the treatment of humans or animals
- plants and animals other than micro-organisms
- mathematical or business methods or computer programs per se or algorithms
- schemes, rules or methods of performing mental acts or methods of playing games
- any piece of traditional knowledge - the Indian Patent Office maintains a Traditional Knowledge Digital Library (TKDL).

The scope of what can be patented in India is very similar to the one which applies across Europe – and indeed the world. The most notable differences lie in some elements which are patentable in Europe but not in India, such as secondary use of a known substance (which is particularly relevant in relation to secondary medical use of pharmaceuticals which are patentable in Europe), methods of agriculture and inventions related to atomic energy.

### C. Types of patent applications

There exist several types of patent applications which can be filed in India, and several routes to filing a patent application. While the substantive requirements for patentability of a patent remain the same for each of the modalities presented under, it can be useful for EU SMEs to be aware of the existence of these different options available to them at the time of protecting their innovations in India.

The first option is to file a **definitive application** directly in India: a patent application filed with the India Patent Office, with complete specifications and patent claims on the basis of which a patent is to be granted.

Another option is to file a **provisional application**: i.e. a temporary application filed with the India Patent Office at the time the invention is under development stage and not yet fully completed. The specification of this patent application should be as complete as possible, but the patent claims are optional at first. Complete specifications (including claims) must be filed within 12 months from the filing of the provisional application.

Finally, EU SMEs should note that there also exists the possibility to file a **Patent Convention Treaty application**, also called 'international application', designating India. India must be designated within 31 months from the international filing date or priority date (whichever is earlier). For more information on PCT applications, you may consult the "[Patent Cooperation Treaty Guide](#)" developed by the International IP SME Helpdesks.

## D. Who can file a patent?

An application for a patent can be filed by either the true and first inventor of the invention, assignee of the inventor (typically the inventor's employer – this is the most frequent case), or legal representative in case of a deceased person.

The Application may be filed by any of the persons mentioned above either alone, or jointly with any other person ('joint ownership').

### TIPS AND WATCH-OUTS: Need for a representative for foreign applicants

*An address of service in India is required for communication with the Indian Patent Office. Therefore, a foreign applicant without an Indian address must engage the services of an Indian patent agent for filing and prosecuting the Application.*

## E. Categories of applicants: advantages for SMEs

The Indian Patent Office categorises applicants into three categories:

- Natural Person/s: i.e. an individual human being, and the patent application can be filed by one or many individuals jointly.
- Small Entity and Start-ups: Small Entities are businesses with an annual investment in machinery/equipment which does not exceed 100,000,000 INR (approximately 1,140,000 EUR) and an annual turnover which does not exceed 5,00,000,000 INR (approximately 5,700,000 EUR). Start-ups are entities which have been in existence for less than 10 years, and have a turnover which does not exceeded 1,000,000,000 INR (approximately 11,402,120 EUR).

A foreign entity can prove start-up or small entity status by providing a (notarised) self-declaration containing a) proof of incorporation as a start-up or small entity, or b) a document such as a copy of Balance Sheet highlighting the expenditure on plant & machinery (with calculation sheet converting into INR).

- Other entities: All entities not falling under the above category fall under other entities.

The Indian Government has provided benefits and concessions for patent filing to Start-ups and Small entities to encourage innovation, notably related to the fees which must be paid and the possibility to fast-track the application process.

**Fee Reduction:** 80% fee reduction compared to other entities. This makes the fee payable by start-ups and small entity at par with a natural person.

When the entity ceases to be a start-up / small entity, the difference in the fees shall not be payable.

**Fast-Track Examination:** Certain applicants, including Start-up and Small entity, can request expedited prosecution of the patent application. Through this it will obtain the following: a) publication of the patent application within one month from the date of filing a request for publication; b) first examination report is issued within three and a half months from the date of request, and c) the application should be disposed within a period of three months from the date of receipt of the last reply.

Even if applicant's status of start-up / small entity ceases after filing a request for expedited examination, the request made for expedited examination will not be questioned, and the expedited request remains.

### TIPS AND WATCH-OUTS: Fast Track Examinations in India

*Expedited prosecution is extended to applicants other than SMEs including: PCT application with India as Search Authority; application with one or more women applicant; applications where the applicant is either a Government agency or Government funded institutes.*

## F. First filing Requirement

Under Indian Law, if an invention includes at least one inventor resident in India at the time the invention was made, then a patent application must be first filed in India (either a national Indian patent application or a PCT application with India as Receiving Office). Alternatively, a 'foreign filing license' can be requested from the Indian Patent Office, granting permission to file abroad.

Foreign companies employing contractual inventors residing in India should also meet this requirement. Failure to comply will result in a refusal or a revocation of the Indian patent and incur other penal provisions.

To obtain a Foreign filing license, a request should be made, including i) a brief write-up of the invention with a title, ii) details of the inventor(s), iii) a power of authority, iv) applicant details in case the invention has been assigned, and v) country where the Application is to be filed and the reasons.

Unless the subject matter of the invention is relevant to national defence, the Patent Office normally grants permission within 21 days from the date of the request.



### 3. Patent Application Procedure in India

#### A. Patent Application

The application must be filed with the Indian Patent Office (IPO), either online or in person by presenting the physical documents at the relevant office. The documents to be submitted – in addition to the text of the application itself (see below) – are the following:

- Application for Grant of Patent.
- Complete/Provisional specification in prescribed format and drawings, if any;
- A duly signed Power of Attorney, if the Application is filed through an Agent/Attorney
- Declaration of Inventorship
- Proof of status, for Start-up/Small Entity, if any.
- If the Application pertains to a biological material obtained from India, the Applicant is required to submit the permission from the National Biodiversity Authority any time before the grant of the patent.
- Where the priority of a first filing is claimed, the priority document must be filed. The priority document has to be in English, or a certified copy of a translated document in English. However, in case the priority application is a PCT application (published by WIPO), the same can be submitted as a priority document.

The patent application must contain the following:

- Title of the invention
- Field of the invention
- Background of the invention
- Summary of the Invention (a summary of the description and drawings within the application) [NOTE: So this is different from the abstract ?]
- Description of the invention taking support of drawings, if any. The description should disclose enablement details of the claimed invention as well as best mode for practicing the invention. [NOTE: Is the best mode required in India ?]
- Claim(s)
- Abstract (a short paragraph describing the invention)
- Sequence listing, if any

#### B. Patent Examination

**Publication:** The patent application is published automatically 18 months from the filing date, or from the priority date, if any.

**Request for Examination:** Patent applications are not examined unless a request for examination is filed. If such a request is not made within 48 months following the application date, the application is considered abandoned.

**Examination:** Once the request for examination has been filed, the Indian IP Office will conduct a substantive examination, after which it will send its report to the applicant, known as a the **First Examination Report (FER)**.

The Applicant must answer to the FER within 6 months if there are any changes required (very often, the applicant will need to amend the claims). It is possible to apply for an extension of the period for answering to the FER for up to an extra three months.

#### TIPS AND WATCH-OUTS: Answering IP Office notifications

*Unlike other offices where the deadline is triggered each time an official communication is issued, the deadline at the Indian Patent Office is fixed based on the First Examination Report, and a number of Examination reports may be issued. If a further Examination report is issued in response to the applicant's response to the First Examination Report, the due date to responding to this further examination report remains the same (i.e. 6 months from the date of First Examination Report).*

*Therefore, to meet all the requirements within the deadline, the applicant should file the response as soon as possible to allow the Examiner to issue further Examination Reports if necessary.*

If the answer to the Examiner's report is not deemed satisfactory in that it does not lift the objections which were stated, a last opportunity may be provided to the applicant to argue his or her case. Following the hearing, the Controller then issues a final decision to either grant or refuse the application.



### C. Patent Oppositions

In India, unlike most of the other countries, third parties can file an opposition to a patent application both before and after the patent in question has been granted (in most countries, e.g. in Europe, oppositions may be filed within a specific timeframe after the patent is granted).

**Pre-grant Opposition:** Once the patent application is published, any party can file a pre-grant opposition. This is similar to the third-party observations in other jurisdictions (e.g. before the EPO), with the additional advantage that the party filing the opposition remains a party to the proceedings (i.e. they can be heard). The grounds for opposition include lack of novelty, obviousness and lack of inventive step, non-patentable subject matter, wrongfully obtaining the invention, insufficiency of description, non-disclosure of information.

Since no official fees are involved, a pre-grant opposition is a cost-effective procedure to attack a competitor's application even before the grant of a patent.

**Post-grant opposition:** Once a patent is granted, any "interested person" may file an opposition within one year from the grant of the patent.

The grounds of opposition are similar to those in pre-grant opposition. The difference being that the post-grant opposition can only be filed by a 'person interested', i.e. a person engaged in business or research in the same field as that to which the invention relates; this includes organisations that have a manufacturing or trading/financial interest in the goods related to the patented product. Community groups and NGOs with a sufficient interest in the relevant patent groups also fall under "person interested".

### D. Official Fees

The costs of registering a patent in India are set out in the table below:

Particulars	Natural person(s) / start-up / Small Entity	Others
<b>Patent Application</b>		
Filing of a provisional or complete specification	18 EUR	92 EUR
For each additional priority claimed	18 EUR	92 EUR
For each sheet of specification in addition to 30, excluding sequence listing of nucleotides and/or amino acid sequence	2 EUR	9 EUR
For each claim in addition to 10	4 EUR	18 EUR
For each page of sequence listing of nucleotide and/or amino acid sequence	2 EUR	9 EUR
<b>Patent Examination</b>		
Request for early publication	29 EUR	145 EUR
Request for examination	46 EUR	231 EUR
Expedited request for examination	92 EUR	694 EUR
Express request for examination	65 EUR	324 EUR

Note: A 10% surcharge is levied on physical filing (i.e., not online filing).



## 4. After the patent is granted

### A. Patent Renewal

Patents are granted in India for a term of 20 years from the filing date of the patent application. In case of applications filed under PCT, the term of 20 years begins from the international filing date.

In order to keep the patent in force, a renewal fee should be paid each year. If not paid in time, the patent will lapse. Restoration of the patent is possible if the request is made within the deadline. The patentee cannot take any action against infringements unless the patent is in force.

You will find in the table below the amount to be paid annually to ensure the patent right remains in force:

	SMEs	Large entities / all other entities
<b>Patent Renewals</b>		
Renewal Fees (Year 2 to 5)	9 EUR	46 EUR
Renewal Fees (Year 6 to 9)	28 EUR	139 EUR
Renewal Fees (Year 10 to 14)	55 EUR	277 EUR
Renewal Fees (Year 15 to 20)	92 EUR	462 EUR

### B. Annual Working Statement

It is mandatory for every patentee and his/her licensee to make an annual disclosure as to how far and up to what extent they have commercially worked their patent in India.

The statement of working is used as a basis for determining if the patent is being used in India. Failure to comply with this requirement may lead to a compulsory licence being granted to third parties wishing to use the patented invention. Additionally, a fine of up to 11350EUR may have to be paid by the patent holder for failure to comply with this requirement. That statement may be made public.

### C. Patent licensing and assignment in India

Once a patent has been granted, the holder may use it as he or she wishes. He may choose to exploit the invention directly, or to commercialise it via licensing agreements with partners, or by selling the patent (through what is called a patent assignment) outright in order to capitalise as quickly as possible on the invention's commercial potential.

Licences can be exclusive or non-exclusive. Under an Exclusive License, the patent holder licenses the patented technology to a third party under certain terms and conditions agreed between the two. An exclusive license is granted to only one licensee. In a non-exclusive license, the patent holder can license the patented technology to one or more licensees under certain terms and conditions.

The agreement must be in writing, properly executed by (all) the owner(s) of the patent and should be registered within six months of the execution of such agreement by filing an Application for Registration of the Agreement with the CGPDTM of Patents at the Indian Patent Office. The terms of the agreement must be clear and explicit.

It should be borne in mind that while patent licences are limited geographically to the patent to which they are attached: licencing an Indian patent only grants to the licensee the right to use on the Indian territory the invention as described in the licence agreement. Any extension of that right beyond the Indian territory must be subject to specific clauses in the agreement (referring to the patent(s) in force in the other countries concerned).

Compulsory licences are authorisations granted by the state permitting a third party to make, use, or sell a patented invention without the patent owner's consent. Compulsory licences in India can only be granted in two specific cases:

- In case of national emergency. This license is issued in exceptional situations in case of extreme urgency such as public health crisis, on the notification of the Government. Any person interested and can then request and obtain a license under terms set by the Government.
- On request by an interested person where the patented invention is not being used in India by the patent owner, and is not made available to the public at an affordable price.

When the circumstances under which the compulsory licence was issued ceases to exist, the compulsory licence can be revoked.

#### TIPS and WATCH OUTS Compulsory Licences in India

*In India, the first compulsory license (Natco Pharmed. V. Bayer Corporation) was granted in 2012 by the CGPDTM/IPO to Natco Pharma Ltd. for generic production of Bayer Corporation's Nexavar, a life-saving medicine for treating liver and kidney cancer. The CGPDTM held that all the grounds stated above were fulfilled: it was not available to public at an affordable price as Bayer charged INR 2.8 lakhs, whereas Natco claimed to sell the same at INR 9000 only; and Bayer failed to demonstrate why it could not manufacture the medicine locally in India.*

## D. Enforcement of Patent Rights in India

Once the patent is granted, the patent holder can enforce its rights against any third party infringing the patent by making, using, offering for sale or importing the patented product, or in the case of process patents, by using that process, or using, offering for sale, or importing products obtained directly by that process. In India, only a patent holder, or his exclusive licensee if any, can bring actions for patent infringement.

The only route of enforcement of patents against infringer is through civil actions, seeking relief from the court in the form of permanent injunctions to stop the infringing activity, claims for damages and accounts of profits to reclaim the economic benefit from the infringement conducted by the third party. Furthermore, infringing goods can be seized and destroyed by order of the court. There is no criminal action against patent infringers.

In general, it is deemed preferable to bring a civil case for patent infringement before the New Delhi High Court, since its judges are much more experienced in the handling of patent infringement claims.

A defendant in a patent infringement lawsuit can counterclaim by challenging the validity of the patent. In such a case, the action is transferred to a High Court. Arguing the invalidity of a patent when accused of its infringement is a classic defence strategy used in India as well as in Europe. For this reason, whenever a patent holder is notified of potentially infringing activity, the first step should be to go consult a specialised lawyer in the field in order to assess not only the allegedly infringing activity, but also the strength of the patent on which the claim will be based.

### TIPS and WATCH OUTS Interim Injunctions

*As an immediate measure, patent owners can request an ex-parte order for interim injunction to stop the allegedly infringing party from carrying its infringement acts while the matter is being decided.*





## GUIDE TO PATENT PROTECTION

Download Guide



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**HELPLINE** First-line advisory service on IP protection and enforcement for EU SMEs working or planning to operate in India.



**TRAINING** Targeted trainings and webinars on IPR protection and enforcement for EU SMEs (including sector- specific approaches).



**IP CONTENT** State-of-the-art publications (factsheets, learning modules, videos, IP glossary, info graphics, case studies and newsletters) on the protection and enforcement of IPR in India – specifically addressing IP matters from the SME business needs point of view.



**AWARENESS RAISING EVENTS** Participation in events attended by EU SMEs to increase the awareness of IP and of the visibility of the services provided by the Helpdesk.



**IP ANALYSIS** Analysis of IP challenges faced by EU SMEs in the target markets.



**IP DIAGNOSTIC TOOLKIT** Toolkit for self-evaluation of the IP-status of the user in terms of IP knowledge and management.



**IP COST TOOL** Online tool that allows the user to pre evaluate the costs related to IP management in India.

If you have any queries on how to protect your Intellectual Property in India contact our Helpdesk service:

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