

**Standing Committee on Patents**

**Questionnaire on the Publication of Patent Applications  
India Section**

**I. Analysis of current law and case law**

1. Please provide a brief description of your law concerning publication of patent applications and identify the statute, rule or other authority that establishes this law.

Under the Indian Patent Act and Rules, 18 month publications are effected pursuant to which all the information relating to the patent application are open for public inspection (Section 11(A) of the Indian Patents Act, 1970 read with Rule 24 of the Indian Patent Rules, 2003). The relevant sections have been reproduced herein below:

***11A. Publication of applications.—***

- (1) Save as otherwise provided, no application for patent shall ordinarily be open to the public for such period as may be prescribed.*
- (2) The applicant may, in the prescribed manner, request the Controller to publish his application at any time before the expiry of the period prescribed under sub-section (1) and subject to the provisions of sub-section (3), the Controller shall publish such application as soon as possible.*
- (3) Every application for a patent shall, on the expiry of the period specified under sub-section (1), be published, except in cases where the application—*
  - (a) in which secrecy direction is- imposed under section 35; or*
  - (b) has been abandoned under sub-section (1) of section 9; or*
  - (c) has been withdrawn three months prior to the period specified under sub-section (1).*
- (4) In case a secrecy direction has been given in respect of an application under section 35, then it shall be published after the expiry of the period prescribed under sub-section (1) or when the secrecy direction has ceased to operate, whichever is later.*

(5) *The publication, of every application under this section shall include the particulars of the date of application, number of application, name and address of the applicant identifying the application and an abstract.*

(6) *Upon publication of an application for a patent under this section—*

(a) *the depository institution shall make the biological material mentioned in the specification available to the public;*

(b) *the patent office may, on payment of such fee as may be prescribed, make the specification and drawings, if any, of such application available to the public.*

(7) *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:*

*Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been granted:*

*Provided further that the rights of a patentee in respect of applications made under sub-section (2) of section 5 before the 1st day of January, 2005 shall accrue from the date of grant of the patent: Provided also that after a patent is granted in respect of applications made under sub-section (2) of section 5, the patent-holder shall only be entitled to receive reasonable royalty from such enterprises which have made significant investment and were producing and marketing the concerned product prior to the 1st day of January, 2005 and which continue to manufacture the product covered by the patent on the date of grant of the patent and no infringement proceedings shall be instituted against such enterprises.*

**24. Publication of application.**—*The period for which an application for patent shall not ordinarily be open to public under sub-section ( 1 ) of section 11A shall be eighteen months from the date of filing of application or the date of priority of the application, whichever is earlier.*

*Provided that the period within which the Controller shall publish the application in the journal shall ordinarily be one month from the date of expiry of said period, or one month from the date of request for publication under rule 24A.*

**24A. Request for publication.**—*A request for publication under sub-section (2) of section 11A shall be made in Form 9.*

**24B. Examination of application.**—(1) (i) A request for examination under section 11B shall be made in Form 18 within forty-eight months from the date of priority of the application or from the date of filing of the application, whichever is earlier;

(ii) The period within which the request for examination under sub-section (3) of section 11B to be made shall be forty-eight months from the date of priority if applicable, or forty-eight months from the date of filing of the application;

(iii) The request for examination under sub-section (4) of section 11B shall be made within forty-eight months from the date of priority or from the date of filing of the application, or within six months from the date of revocation of the secrecy direction, whichever is later;

(iv) The request for examination of application as filed according to the 'Explanation' under sub-section (3) of section 16 shall be made within forty-eight months from the date of filing of the application or from the date of priority of the first mentioned application or within six months from the date of filing of the further application, whichever is later;

(v) The period for making request for examination under section 11B, of the applications filed before the 1st day of January, 2005 shall be the period specified under the section 11B before the commencement of the Patents (Amendment) Act, 2005 or the period specified under these rules, whichever expires later.

(2)(i) The period within which the Controller shall refer the application and specification and other documents to the examiner in respect of the applications where the request for examination has been received shall ordinarily be one month from the date its publication or one month from the date of the request for examination whichever is later: Provided that such reference shall be made in order in which the request is filed under subrule (1).

(ii) The period within which the examiner shall make the report under sub-section (2) of section 12, shall ordinarily be one month but not exceeding three months from the date of reference of the application to him by the Controller;

(iii) the period within which the Controller shall dispose off the report of the examiner shall ordinarily be one month from the date of the receipt of the such report by the Controller.

(3) A first examination report along with the application and specification shall be sent to the applicant or his authorized agent ordinarily within six months from the date of the request for examination or six months from date of publication whichever is later. In case other interested person files the request, for examination, an intimation of such examination may be sent to such interested person.

*(4) The time for putting an application in order for grant under section 21 shall be twelve months from the date on which the first statement of objection is issued to the applicant to comply with the requirements.*

2. Does publication of patent applications occur automatically in your jurisdiction? If so, when does publication take place? If not, what are the requirements to effect publication?

Anytime after the expiry of 18 months from the priority date, the publication of the application is effected automatically except in case of 11(A)(3) referred to above. In other words, if secrecy directions have been imposed or a provisional application has been abandoned by failing to file complete specification within 12 months or wherein the application has been actively withdrawn 3 months prior to the expiry of 18 months from the priority date.

3. If a patent application claims priority from or the benefit of an earlier application how, if at all, does this affect the timing of publication?

The 18 month period for effecting publication under Section 11(A) is calculated from the priority date.

4. Is there a specific point in time up to which the applicant can withdraw its application without it being published?

As mentioned above, an Applicant can withdraw their application three months prior to the 18 months in order to avoid publication.

5. What parts of a pending patent application are published?

The following details are published in the official journal namely the date of application, application number, name and address of the Applicant and abstract. Once such details are published, the Application for patent is open for public inspection. Under Rule 27 of the Patent Rules, after the application is published under Section 11(A), the application along with its complete specification and provisional application, drawings and abstract and any other documents can be inspected and a copy can be obtained thereof upon payment of prescribed fee. Also, once the application is published, all documents in relation thereto are also available on the Indian Patent Office website: <http://ipindiaservices.gov.in/publicsearch/>

6. Does a published pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

An Applicant specifically under Section 11(A)(7) is entitled to provisional rights from the date of publication of the application. However, the Applicant can institute infringement proceedings only after the patent has been granted.

7. Does an unpublished pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

No, an unpublished pending patent application does not give rise to any provisional rights.

8. Is 'early publication' allowed in your jurisdiction? If so, what are the conditions for such early publication? How is the request for early publication made? What is the effect of an early publication on a pending patent application?

Yes, an early publication of an application is permissible under Section 11(A)(2) of the Indian Patents Act upon payment of the prescribed official fee. Once such a request is made, the patent office has to publish the application ordinarily within one month from the date of request for publication.

9. Is non-publication possible in your jurisdiction? In other words, can a pending patent application remain confidential? If so, under what conditions is such allowed? How is the request for non-publication made?

Except for the circumstances under which an application cannot be published, a pending application cannot remain confidential.

10. Will a lapsed, abandoned or withdrawn patent application be published? If not, is that automatic or by the request of the applicant? If it would otherwise be published, can the applicant request non-publication?

An abandoned or lapsed application will be published. However, if there is a special request for withdrawal of the application before the publication under those circumstances, publications will not be effected.

11. What is the position in your jurisdiction regarding the publication of continuation, continuation-in-part and divisional applications?

In India, there is no provision for continuation or continuation in part applications. Divisional applications are also published in accordance with Section 11(A) read with Rule 24(B).

## **II. Policy considerations and proposals for improvements to your current system**

12. Should there be a requirement for automatic publication of pending applications by a particular deadline?

Automatic publication of pending applications by a particular deadline can be considered at least for national phase applications. Given the fact that the national phase application is published within 18 months from the priority date, the date of publication of the international application can be considered as being the deemed publication date in India rather than having it republished. Only the fact that the application has entered national phase should be immediately be notified as on the date of national phase filing.

However, for other applications, a deadline by which the application has to be published is necessary. One such reason is that examination of the application is dependent on the publication of the application. In other words, if the publication has not been effected, examination of the application will not commence.

13. Should there be a right for the patentee to request early publication? If so, on what basis and with what consequence?

There is already a provision under the Indian Patents Act wherein the Applicant can request early publication.

14. If your answer to question 13 is yes, should all the applications deriving from the same priority application be subject to the early publication if one application is published early?

Every application would be treated independently of the other and one member of the family. If one application is published, it should not automatically result in the publication of the other members of the family.

15. Should there be a right for the patentee to withdraw the application before publication?

Such a provision already exists.

16. If your answer to question 15 is yes, what should be the consequence of such withdrawal:

- a. with respect to the patentee's own subsequent patent applications; and
- b. with respect to third party patent applications?

If the Applicant has withdrawn their application before publication, it cannot be considered as prior art by way of prior claiming or publication either for 3<sup>rd</sup> party applications or patentees own subsequent patent applications. Prior claiming is

very unique to India which is a ground of anticipation and is applicable only once there is a corresponding patent application in India.

However, if any one member of this family is published elsewhere that can be considered as prior art if the publication was effected prior to the priority date/filing date of patentees own subsequent application or with respect to 3<sup>rd</sup> party patent application.

17. If your answer to question 15 is yes, should the patent office be required to provide its initial assessment of the validity of the patent (if granted) before the applicant is required to decide whether to withdraw?

Not necessary

18. In light of your answers to the previous policy questions, what would be appropriate time limits for:
- a. the patent office to provide the results of its initial assessment?;
  - b. the applicant to decide whether to withdraw the application?; and
  - c. the application to be published?

As stated earlier, the validity assessment of patent application by the patent office is only effected during the examination process of the application and the examination process is initiated only after the request for examination has been filed. Therefore, it is unlikely that under the current provisions, the Patent Office will provide an initial validity assessment prior to the withdrawal of the application by the Applicant.

However, such services can be included by the Indian Patent Office (similar process is available in UK) where patent office carries out an initial assessment for the applicant if requested, the results of which are kept confidential.

19. Should there be any exceptions to automatic publication, and if so what on what grounds, for example:
- a. on the initiative of the patentee;
  - b. on the initiative of the patent office; or
  - c. on the initiative of third parties (such as other governmental agencies)?

Only cases which are prejudicial to the security of the country should not be published even upon the request of the Applicant. Having said this, under the current rules, a request for non-publication is a *sine-qua-non* will automatically result in the withdrawal of the application. We should have a provision to prevent publication of the application yet keep the application alive. Further, prevention of publication should only be for limited period.

20. If your answer to question 19 is yes, who should decide on whether such

exception is applied?

The Indian Patent Office.

21. Should there be different rules for the publication of continuation, continuation-in-part and divisional applications?

Not necessary

22. What proposals would you make to improve your current system?

The Indian Patent Office has already geared up and the publications of the patent applications are being effected on a regular basis.

### III. Proposals for harmonization

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the publication of patent applications. More specifically, the Groups are invited to answer the following questions:

23. Should patent offices be required to provide examination results or at least search results prior to publication so that applicants can make an informed decision whether to pursue obtaining a patent or to withdraw the application and protect the invention idea as a trade secret?

We could in India propose an initial validity assessment of the application by paying an initial examination fee request which would be distinct from the request for examination for substantive examination or in the alternate instead of an examination; we could have a search report followed by an examination report.

24. Should there be any exception to publication of applications, for example by the applicant's opt-out?

We have already replied to this question.

25. How should exceptional circumstances be defined, e.g., public order, morality or national security where the patent office delays or suppresses publication? To what extent should these exceptional circumstances be specifically defined?

The Indian Patents Act already contains provisions where publication of an application can be withheld in order to protect the national security of the country.

26. What is an appropriate period for publication after filing an application or after the priority date? Is 18 months an appropriate period?

18 months appears to be reasonable.





