



Intellectual Property
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INFORMATION TO CLIENTS AND ASSOCIATES

INDIA: Patents

- Indian Patent Act amended with effect from 01 January 2005
- Pharmaceutical products are now patentable
- Microorganisms, Chemical, Agro-chemical and Food products are also patentable
- Software in combination with hardware is now patentable
- Software program having technical application in Industry is also patentable, now
- Official Fees increase astronomically

The Indian Patent Act has been amended on 31 December 2004 and a new Patent law has come into force on 01 January 2005.

The Highlights of the new law are as follows:

LAW

- Product patents in respect of novel compositions, drugs, chemicals, agrochemicals, food and new micro-organisms will now be allowed.
- Mathematical methods, business methods and algorithms remain not patentable. However, technical application of computer software in industry and software in combination with hardware will be patentable. In that context the Indian statute has been amended more or less in line with the European Patent Office practice in this field. However, in absence of any case law or examination guidelines in this field in India, it will take some time for Indian practice to evolve on patenting of software applications.
- Second use of a known chemical or pharmaceutical compound exhibiting unexpected properties may now be patentable as composition claims, as under the amended Act, only "... mere new use for a known substance ..." remains not patentable.
- Patent applications for all Inventions made by anybody resident in India (by Indians or otherwise) have to be now filed in India first before filing elsewhere in the world. Thus patent applications based on collaborative research and research work being done in India have to be filed in India first before filing elsewhere in the world, including the PCT.
- Provisions related to Exclusive Marketing Rights (EMR) have been abolished. All EMR applications already filed shall be treated as applications for Request for Examination. EMR already granted will continue to remain valid till Examination and Grant/Refusal of the relevant patent.
- A provision for *ex parte* pre-Grant Opposition has been inserted to allow any third party to agitate against Grant of a patent on grounds of lack of novelty (prior publication), inventive step and industrial applicability. No hearing may be granted to the Petitioner in this regard.
- Opposition can now be filed after grant within one year of grant on all available grounds as before.
- A Patentee will now be able to claim damages from the date of Publication of the patent application, should infringement be established after Grant. It will also be possible to enforce a Granted Patent even though it may be under opposition.
- Import of any patented product (including those relating to pharmaceuticals, chemicals, agrochemicals, food and microorganisms) and such product made by a patented process in India, without the consent of the patent owner, will now be construed as an infringement along with manufacture, sale and use of the product in India.
- Import, Sale or use of a patent product for obtaining approval from a regulatory authority will not be considered infringement.

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- Compulsory License – grounds further expanded: The newly inserted Section 92A(1) of the Bill expands the scope of issuance of Compulsory Licenses for manufacture and export of patented pharmaceutical products to countries having insufficient manufacturing capacity in the pharmaceutical sector, if that country has by notification allowed such importation.

FEES

- Patent Office fees have increased in respect of Filing a new patent application, Request for Examination, request for Extension of Time (of 3 months) to place the application in order for grant
- There is no Grant Fee or Sealing Fee (earlier US\$240)
- Extra official fees in respect of claims in excess of the first 10 claims.
- Extra official fees in respect of pages in excess of the first 30 pages in the specification.

TIME PERIODS and PROCEDURES

- The prescribed time for putting a patent application in order for Grant (the onus remaining on the Applicant) has now been curtailed to 6 months from the date of the First Examination Report (FER). The earlier period was 12 months. For patent applications where the FER has already issued before 01 January 2005, the period remains 12 months.
- Request for Examination has to be filed within 36 months from the first priority date, instead of 48 months from the filing date as applicable for patent applications filed prior to 01 January 2005.
- No period has been specified for the Examiner to take up examination after the Request has been filed. A new Rule has been added which provides that the Examiner will examine the application within 3 months from the date of referral by the Controller of Patents to the Examiner. *This peculiar provision is purposeless and meaningless to the applicant.*
- All patent applications filed will be published after expiry of 18 months from the priority date.
- Time limit for recording Assignments in respect of granted patents has been withdrawn.
- Certified copies of Priority documents will not be required. Instead notary verified copies will suffice.

PATENT APPLICATIONS FILED ON OR BEFORE 31 DECEMBER, 2004

Transition Provisions (expressed or implied)

- Differential fee as a result of hike in Official Fees is not payable in respect of fees already paid on or before 31 December 2004. For example, Filing fee and Subsequent Filing fee, Examination fee.
- The deadlines for filing Request for Examination for applications filed on or before 31 December 2004 will be as follows:
 - *Normal applications* : 48 months from the filing date
 - *Black Box applications*: 48 months from the filing date or 31 December 2005, whichever period expires later.
- No sealing fee will be payable when the patent is granted in respect of applications filed/pending on 31 December 2004. (Cost saving of US\$240)
- Prosecution Period for Patent Applications pending on 31 December 2004
 - 12 months from the date of First Examination Report (FER) where the FER has been issued by the Patent Office on or before 31 December 2004
 - 6 months from the date of FER (3 months extension is available on payment of extension fees of US\$560) where the FER is issued after 31 December 2004

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