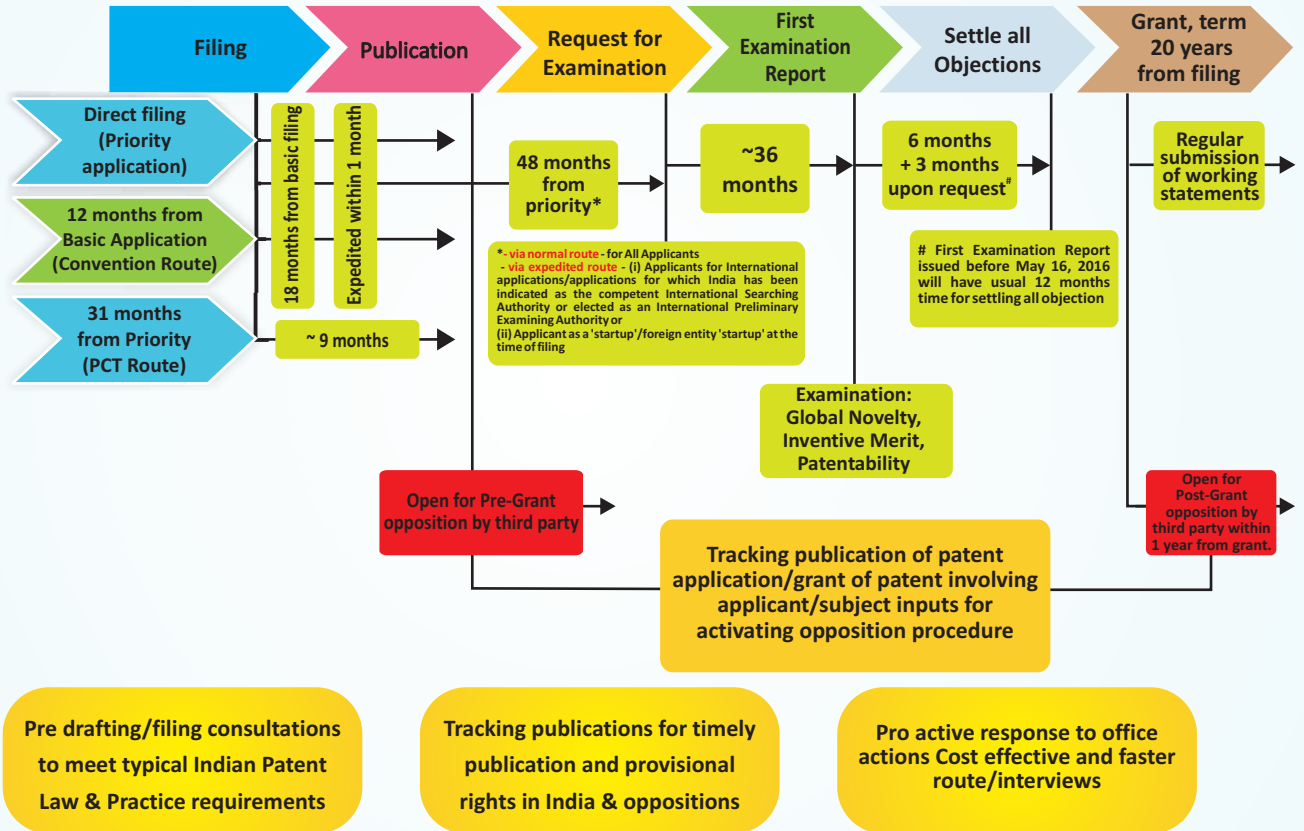


INDIAN PATENTS

INDIAN PATENT PROSECUTION

ASA FACILITATION



RECENT CHANGES IN THE INDIAN PATENT SCENARIO

I. Implementation of **NATIONAL INTELLECTUAL PROPERTY RIGHTS POLICY** on May 12, 2016 by Government of India, Ministry of Commerce and Industry, Department of Industrial Policy & Promotion to stimulate a dynamic, vibrant and balanced intellectual property rights system in India.

Objectives:

To have strong and effective IPR laws and constituting a Cell for IPR Promotion and Management (CIPAM) to facilitate promotion, creation and commercialization of the IP assets.

Exploring the possibility of expedited examination and grant of IP rights.

To strengthen the enforcement and adjudicatory mechanisms for combating IPR infringements/IPR disputes through specialized commercial courts.

II. Enforcing Patents (Amendment) Rules, 2016 from May 16, 2016. Major changes are summarized as hereunder:

A new category of Applicants for patent in India has been introduced namely "STARTUP" thus expanding the category of Patent Applicants in India as:

Individual	Startup	Legal Entity as a Small Entity	Legal Entity other than a Small Entity
Any Natural Person	An entity for which (i) more than five years have not lapsed from the date of its incorporation or registration, (ii) the turnover for any of the financial years, out of the aforementioned five years, did not exceed INR 25 crores or equivalent in foreign currency and (iii) is working towards innovation, development, deployment or commercialization of new products, processes or services driven by technology or intellectual property.	An entity is entitled as a small entity if it is a Manufacture related enterprise with investment in plant and machinery does not exceed INR 10 crore or equivalent in foreign currency OR a Service related Enterprise where the investment in equipment does not exceed INR 5 crore or equivalent in foreign currency.	Any legal entity which are not qualified as Startup or Small Entity

- The official fees for Startup will be similar to Natural Person.
- An application corresponding to a PCT should include amendments made by the applicant under Article 19 or Article 34 of the Treaty, provided that the applicant, while filing such application corresponding to PCT application designating India, may delete a claim.
- An application can be withdrawn any time before grant. Fees for request for examination, upto 90% of fees paid can also be refunded if examination report not issued.

RELEVANT POINTS TO BE KEPT IN MIND TO AVOID LOSS OF RIGHTS WHILE ENTERING INDIA BASED ON ADVANCEMENTS OUTSIDE INDIA

- I. Content Consistency for NP applications required by the Indian Patent Office- the NP application should be consistent with PCT application/amendments thereto on record before IB (WIPO). Only amendments by way of deletion of claims of international phase are allowed at time of filing NP application.
- II. Submit information on all corresponding foreign filings outside India - within 6 months. Failure may lead to rejection, opposition, revocation.
- III. Indian Patent Office traverses prosecution details of corresponding applications outside India. In case India jurisdiction claim coverage is of importance, you should ensure that while prosecuting outside India your responses do not include or direct to any technical issues which can be in conflict for allowability in India.
- IV. Strict regulations on post filing amendments in India by way of only disclaimer, correction or explanation only and claim amendments limited to the scope of the original claims – use claims cannot be redirected to product or processes. Thus scope of the use should be evaluated from all angles for any possible alternative statutorily allowable claim in India while drafting.

POINTS TO REMEMBER WHILE DRAFTING PATENT SPECIFICATIONS APPLICABLE FOR INDIA COVERAGE AND TO HAVE ALLOWABLE CLAIMS ON COMPOSITIONS AND PROCESSES:

Chemical advancements:-

Compositions including combination of actives/drugs - efficacy, synergy/ therapeutic efficacy essential

New forms of known substances such as chemicals, biotech/ drugs - efficacy /therapeutic efficacy essential (in case of bioavailability data link it to therapeutic efficacy to qualify)

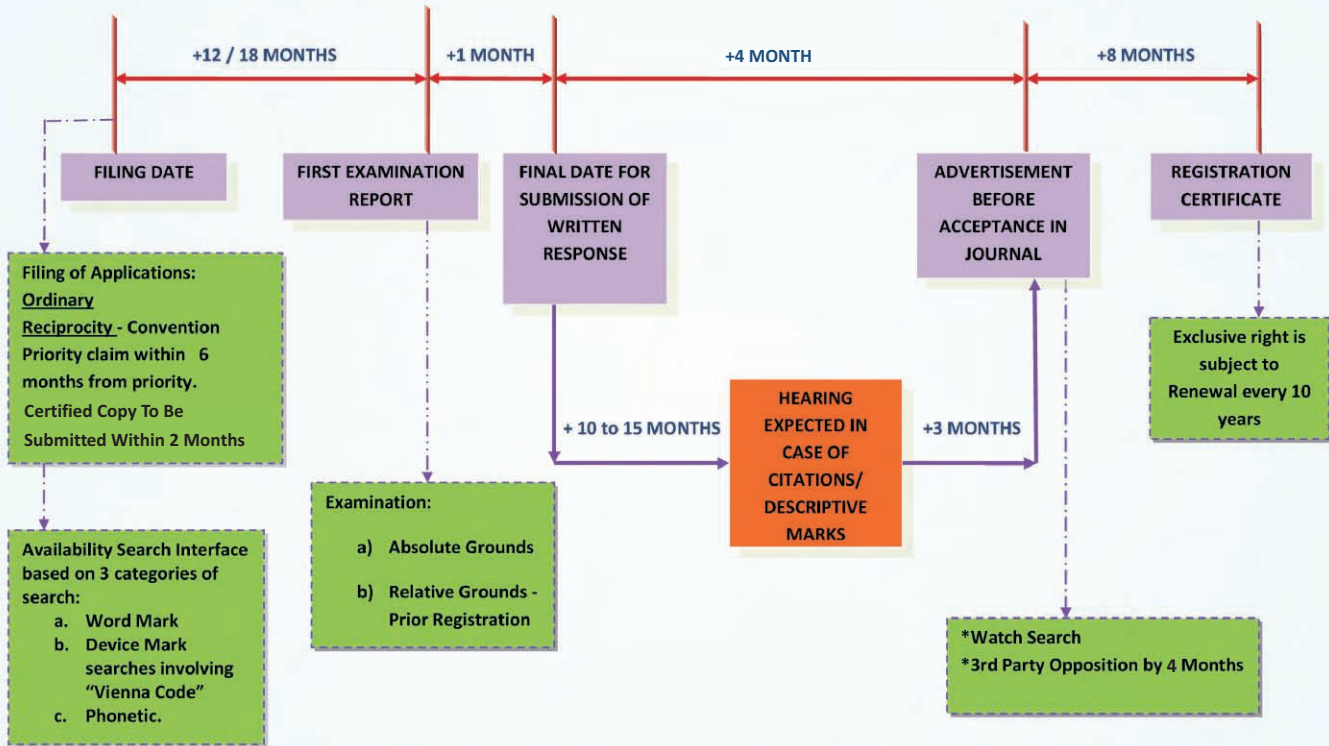
Bio-resource based advancements:-

Biomaterial use should be supplemented by its geographical origin and source - Indian National Biodiversity Authority permission not required if biomaterial is sourced from outside India. Thus for joint ventures, involvement of bio-resource sourced from outside India while exemplifying the invention is desired.

Computer related advancement:-

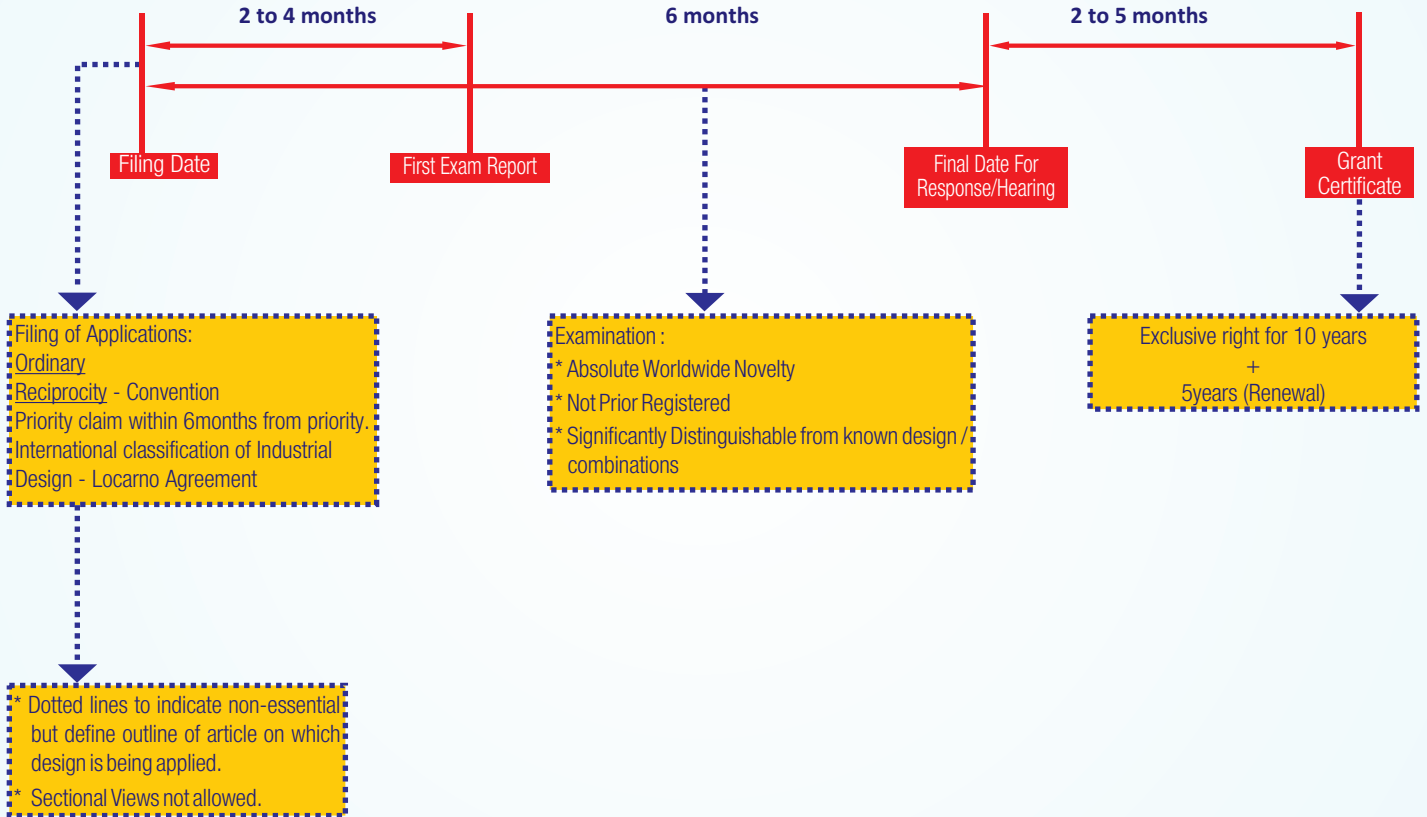
Technical effect should be based on hardware-software integration and specification should be framed on the same lines.

INDIA TRADEMARK



India joins the International Trademark System by signing the Madrid Protocol. The treaty will enter into force with respect to India on 8th July, 2013.

INDIA DESIGN



OUR SERVICE SPECIALITIES

For Patents

- Reviewing patent specification prior filing and consulting on patentability issues to suit different subject based requirements in compliance with the Indian Patent Act, Patent Manuals & Procedures.
- Guiding on prosecution of patent application including Filing – Formality requirement - Examination – Grant - Maintenance – Enforcement – Licensing/Assignments/Agreement.
- Field specific patent/patent application watch search/patent landscaping/FTO/monitoring patenting activity of opponents/interested parties in India and strategizing & appearing patent opposition/revocation procedure.



For Trademark

- Free search for prospective new application with opinion – International Nice Classification and Indian Local Classification.
- Watch services to spot contestable marks notified for registration.
- Guiding prosecution of application on documentation for qualifying mark under Indian Trademarks Acts and Rules.



For Design

- Guiding foreign applicants as to allowable representations under the Indian Designs Law;
- Framing novelty clauses in accordance with the Indian Laws for best coverage and protection under local laws;
- Guiding on proper classification of articles for the purposes of registration.



INFORMATION REQUIRED FOR FILING

PATENT

The Basic Documents And Information Required For Initial Filing:

- i) Full Name, Address & Nationality of the Applicants, Inventors;
- ii) Copy of the Complete Specification, Drawings, if any, and Abstract in English;
- iii) Details of any priority claim based on the basic filing in the home country;

In case of National Phase Application based on a PCT International Filing:

- i) Full Name, Address & Nationality of the Applicants, Inventors;
- ii) Details of priority claims;
- iii) Particulars of the International Publication and copy in English;
- iv) Any amendments under Article 19, 34, 41 of PCT;

Supporting Documents Required Post Filing:

- i) A Power of Attorney - simple signature, no legalization or notarization.
- ii) Proof of Right of Applicant, if applicable.
- iii) Priority document, if applicable.

TRADEMARK

The Documents Required For Initial Filing:

- i) A copy/sample of the mark to be applied;
- ii) Details of the specification of goods to be covered;
- iii) Details of any User of the Mark in India;
- iv) Particulars of the Applicant including Full name, nationality and address;
- v) Details of any convention priority claims in case of filing within 6 months from the filing in the home country;

Supporting Documents Required Post Filing:

- i) A Power of Attorney - simple signature, no legalization or notarization.
- ii) Priority document, if applicable.

DESIGN

The Documents And Information Required:

- i) Full Name, Address and Nationality of the Applicants;
- ii) Clear representations of the design applied to the product/article by way of photographs or drawings of the finished form of the article with the design applied thereon covering the following views : (a) Front (b) Back (c) Perspective and (d) Side Views.
- iii) Name of the Article on which the design is applied.
- iv) Identification of Novelty in the design. Since a design can be registered based on anyone or more of the novelty residing in the features of (a) shape and configuration (b) surface pattern/ornament, or (c) composition of lines or colours, please identify the novelty residing in the design.

Supporting Documents Required Post Filing:

- i) A Power of Attorney - simple signature, no legalization or notarization.
- ii) Priority document, if applicable.