

## IP Hotline

September 13, 2017

### EXPEDITED GRANT OF PATENT IN INDIA – A MYTH OR REALITY?

In 2016, an amendment to the Patent (Amendment) Rules, 2005 (“**2016 Amendment Rules**”) was brought about. This was done primarily to remove bottlenecks in the patent process, clear pendency of cases, and encourage more filings with a view to give impetus to protection of technological advancement and innovation. When the 2016 Amendment Rules were notified, there were several doubts if the amendments would, in fact, speedup patent registration. It seems that’s these doubts have been put to rest as the Indian Patent Office (“**IPO**”) has outperformed itself and has granted a patent<sup>1</sup> within less than 4 months from the date of filing an application for expedited examination. In this matter, the applicant had filed a request for expedited examination on March 21, 2017, and the IPO issued the first examination report within less than two weeks on March 31, 2017 to which a reply was filed on May 4, 2017, after which the hearing was held on June 23, 2017, the patent was granted on July 12, 2017.

### WHAT IS A REQUEST FOR EXPEDITED EXAMINATION AND WHO CAN FILE SUCH AN APPLICATION?

A request for expedited examination is an application filed by an applicant requesting the IPO to expedite the examination of the relevant patent application.

An application for expedited examination maybe filed by<sup>2</sup>

- a Patent Co-operation Treaty (“**PCT**”) applicant nominating the IPO as its International Searching Authority (“**ISA**”) or as an International Preliminary Examining Authority (“**IPEA**”) in the corresponding international application; or
- a Startup.<sup>3</sup>

### PROCEDURE FOR FILING AN EXPEDITED APPLICATION

#### A. Request of Examination

A request for expedited examination maybe filed online in Form 18A within 48 months of the date of priority of the application or the date of filing the patent application whichever is earlier.<sup>4</sup>

However, if

- a request for normal examination has already been filed, the same can be converted into an application of expedited examination upon the payment of the balance fees.<sup>5</sup>
- the application has already been published or an application for publication has been filed, a request for expedited examination is required to be accompanied by such a request for publication.<sup>6</sup>

#### B. Examination by the IPO and Reply to such office action

For the purpose of examination<sup>7</sup>

- the examiner is required to examine the patent application and make his report within one month but not exceeding two months from the date of reference of the application to him.
- The Controller is required to dispose of such a report of the examiner within one month of receipt of such report; and
- the first statement of objections, if required, are to be issued within fifteen days from the date of disposal of the report by the Controller.

A reply to such office action is due to be filed within 6 months from the date of the examination report or within an extended period of 3 months (additional). However, it would be in the interest of the applicant to file their response at their earliest as the reply would be examined in the order in which such it is received by IPO.<sup>8</sup>

#### C. Examination by the IPO of the Reply and proceeding towards grant

The Controller is required to dispose of the application of expedited examination within a period of three months from the date of receipt of the last response to the first examination report or within three months from the last date to put the application in order for grant.<sup>9</sup>

However, such timelines do not envisage a pre-grant opposition which may be filed. Further, the IPO may by a notification limit the number of applications it will examine under the expedited examination route each year.

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Depending on the type of applicant, the fees for filing such an application online shall be as below:

Natural person(s) and/or start up	Small entity, alone or with natural person(s) and/or Start up	Others, alone or with natural person(s) and/or Start up and/or small entity
8000	25000	60000

ANALYSIS

While the expedited examination process is a welcome step in India, it needs to be kept in mind that while there are strict timelines notified under the 2016 Amendment Rules for expedited examination by the IPO, there are no expedited timelines (regular timelines however apply) for the applicant to reply to such office actions. In the instant case, the patent granted within 4 months was granted due to willingness and promptness of both the parties to expeditiously dispose the application. The process could however take longer if the applicant replied to the office actions as per the regular longer timelines.

Further, the option to file for expedited application is currently available only to start ups and applicants who nominate the IPO as its ISA or IPEA in the international PCT application. However, this option is currently not available to other applications filed by applicants who do not fit the above criteria and have already filed the application under national route and are awaiting examination. While the IPO has definitely made and is making all its efforts in expediting the process for such applications, it is to be seen if the miracle of granting a patent in short timelines can become an ongoing reality.

– Pooja Kapadia & Aarushi Jain  
You can direct your queries or comments to the authors

<sup>1</sup>IN285091 granted for 'A process for the preparation of Apixaban'

<sup>2</sup>Rule 24(C)(1) of the 2016 Amendment Rules

<sup>3</sup>Rule 2(fb) of the 2016 Rules: Startup means an entity, where-

- (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 rupees twenty-five crores; and
- (iii) it is working towards innovation, development, deployment or commercialisation of new products, processes or services driven by technology or intellectual property:

Provided that any such entity formed by splitting up or reconstruction of a business already in existence shall not be considered as a startup.

Provided further that the mere act of developing:

- a. products or services or processes which do not have potential for commercialisation, or
- b. undifferentiated products or services or processes, or
- c. products or services or processes with no or limited incremental value for customers or workflow, would not be covered under this definition.

<sup>4</sup>Supra 2

<sup>5</sup>Rule 24(C)(2) of the 2016 Amendment Rules

<sup>6</sup>Rule 24(C)(3) of the 2016 Amendment Rules

<sup>7</sup>Rule 24(C)(6) to (8) of the 2016 Amendment Rules

<sup>8</sup>Rule 24(C)(9) to (11) of the 2016 Amendment Rules

<sup>9</sup>Rule 24(C)(12) of the 2016 Amendment Rules

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Vaibhav Parikh, Partner, Nishith Desai Associate on Tech, M&A, and Ease of Doing Business

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