

Column No.19

Preparation for Accelerated Examination of Patent Application in India

【2013/6/19】

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Recently, for Japanese enterprises, India is positioned as not only a production base aimed at the Indian domestic market but also as an exporting base for Africa and the Middle East, taking advantage of its geographical location. Also, law offices dealing with intellectual properties in India are taking advantage of the country's geographical strengths to not merely provide services relating to intellectual property protection within India. In addition, they have positively built up a network including neighboring countries, and are seeking retention of overseas customers. In light of these circumstances alone, the significance of India is great as a base for IP strategy from South East Asia to the west, and many Japanese enterprises focus attention on the importance of obtaining intellectual property rights, such as patents, in India.

However, under current circumstances, from initial application to the start of an examination takes a long time in India so applicants face a problem in trying to accelerate important applications. Therefore, we propose measures that can contribute to accelerated examination of patent applications in India.

**It takes on average 7 years from application to registration in India,
which has no accelerated examination system**

India has four Patent Offices (Calcutta, Mumbai, Delhi, and Chennai) and enables overseas residents to file a patent application with any of the Patent Offices by selecting a local agent (patent attorney). In India, it takes on average 7 years from filing to registration of a patent application. Further, it takes 4 years or so from initial request to starting of examination of the application ([Related Information: up-to-the-date examination circumstances](#)).

On the other hand, in Japan, there is an "accelerated examination system" and the like for

starting an examination early in preference to other patent applications if a certain condition is met, and similar systems operate in Europe and the U. S. (PACE of the European Patent Office; AEP and PEP in the US Patent and Trademark Office). However, in India, there is no such accelerated examination system. As mentioned above, because of a relatively long period of time from request to the start of examination, there are demands by applicants for accelerated examination of at least important patent applications.

Then, what types of measures can be considered to accelerate examination of a patent application in India where no accelerated examination system exists? We would like to propose separate measures for the international application (PCT application) case and the Paris Convention route application case.



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[Case of International Application (PCT Application)]

(1) Enter Indian National Phase of PCT Application as early as possible

- It is ideal to enter the national phase immediately after issuance (18 months from the priority date) of an international publication of a PCT application.
- To make a later-described "demand for accelerated examination" effectively function, we consider it preferable to enter the national phase at the latest within 25 months from the priority date as a goal (that is, half a year before the time limit for entering the national phase in India).

(2) In addition to a request for examination of the application after entering the national

phase of (1), file: a request for early re-publication in India; and an express request for examination.

- Payment of fees to the Indian Patent Office is required for filing a request for early re-publication as well as an express request for examination.

- By taking the procedures in (1) and (2), the Indian Patent Office can start examination of the PCT application before 31 months elapses from the priority date, under the provision of PATENTS RULES Article 20(4) (ii). However, the provision of PATENTS RULES Section 20(4) (ii) does not impose an obligation to accelerate examination on the Indian Patent Office. Related clauses are shown below.

- **PATENTS ACT, 1970, Section 11A Publication of applications**

(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.

- **PATENTS RULES, 2003, Rule 20 International applications designating or designating and electing India**

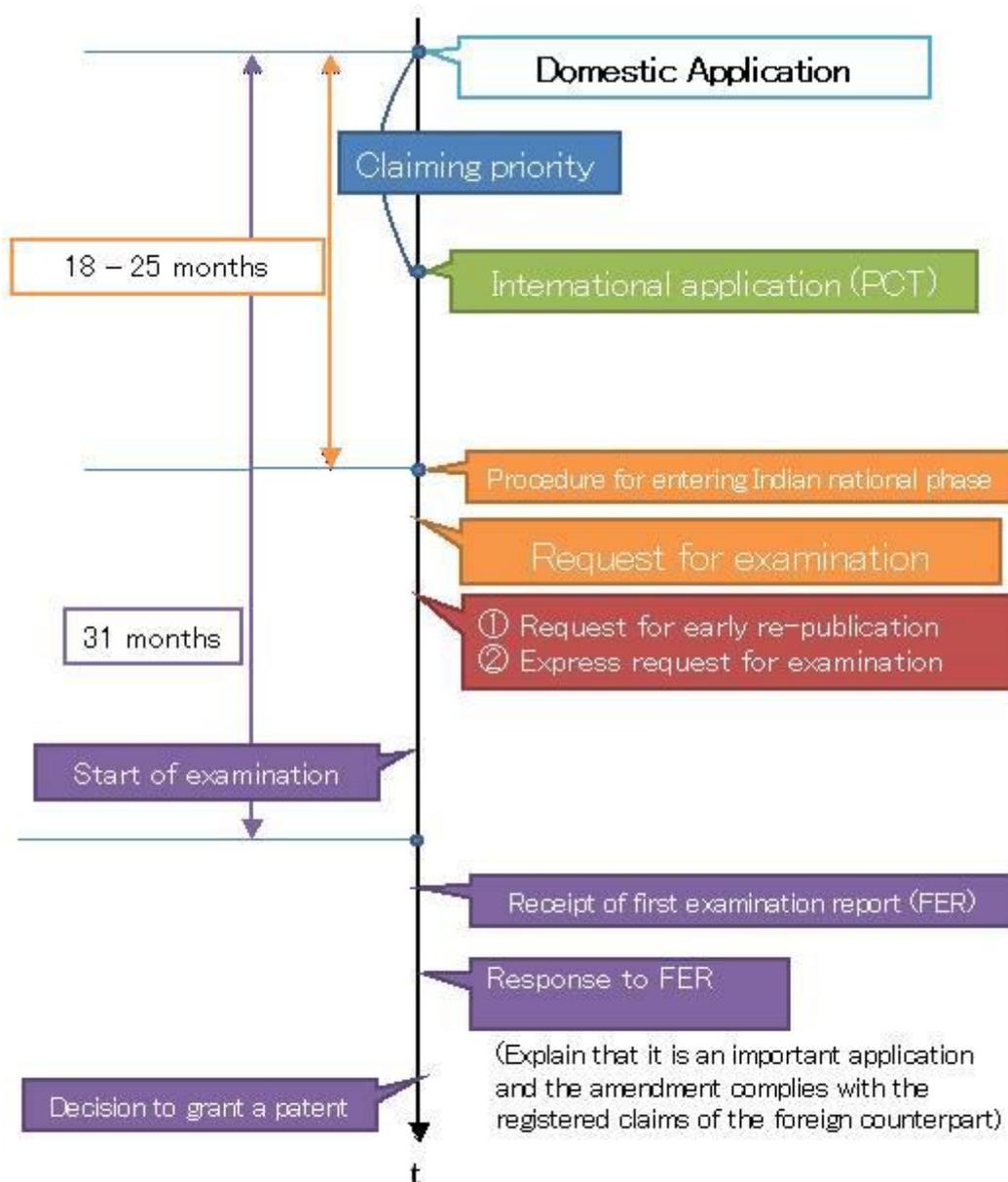
(4)(ii) Notwithstanding anything contained in clause (i), the Patent Office may, on the express request filed in Form 18 along with the fee specified in First Schedule, process or examine the application at any time before thirty one months.

(3) Response to First Examination Report (FER)

- When responding to the First Examination Report (FER) from the Indian Patent Office, appeal to an examiner in charge that it is an important patent application and that you desire an accelerated examination.

- If a foreign counterpart of the Indian patent application has been registered and an amendment was made in compliance with the registered claim(s) of the foreign counterpart, argue to that effect.

Such an argument is considered to have no effect according to territoriality principles, but in view of the purport to utilize an examination report of another country, it is considered that there is a certain effect. In particular, when an amendment is made in compliance with registered claims of corresponding European and US applications, such an argument is considered effective.



Flow Diagram of Accelerated Examination of Patent Application in India (in the case of PCT Application)

[Case of Paris Convention Patent Application]

- The above-mentioned request for early laid-open publication, accelerated examination by filing of an express request for examination, targets at PCT applications. Thus, in the case of Paris Convention patent applications, it is not possible to accelerate examination by filing such a request.
- In the case of Paris Convention patent applications, the present state of affairs is that

there is no other measure to accelerate examination than to file a written request for examination as soon as possible (within 48 months from the priority date) and to respond according to (3) above when the examination result is received.

In the case of an international application (PCT application), there are possibilities of accelerating examination by ① requesting an early laid-open publication within India and ② filing an express request for examination; however, these do not impose an obligation of accelerated examination on the Indian Patent Office and, seemingly, are not always effective for accelerated examination. Nevertheless, with regard to important applications, it is considered crucial to take an attitude of aiming at an accelerated examination, if only a little, by such measures as mentioned above.



View of the Calcutta Patent Office
(Taken by Mr.Kubori of Miyoshi & Miyoshi)