

## **CONVENTION AND PCT FILING IN INDIA**

### **CONVENTION APPLICATION**

**The following information and documents are required for filing a Convention application:**

1. All documents and information required for filing a patent application are filed via the e-filing portal of the IPO. If the IPO asks for any document in original, it has to be filed within 15 days of such a request, failing which such a document is deemed not to have been filed.
2. Complete specification that includes title, description, drawings, if any, claims and abstract in English. If the specification is in a language other than English, then a verified English translation is to be submitted. The complete specification may include claims that are in respect of development or addition to the invention in respect of which the application was made in the Convention country.
3. Name, address and nationality of the applicant(s) and the inventor(s).
4. Basic home application number(s), date(s) and name of the Convention Country. In case of multiple priorities, the Convention application has to be made within 12 months of the date of filing of the earliest priority application.
5. Sequence listing (if applicable). This has to be submitted electronically to the Indian Patent Office. Fees with respect to equivalent number of pages is payable with a maximum prescribed limit, depending upon the category of the applicant.

6. Power of Authority (POA). We shall furnish the format. This has to be filed within three months of filing the application, failing which no action is taken by the IPO till the deficiency is removed. In cases where a General Power of Attorney from the applicant has already been filed, a copy attested by the agent/attorney can be filed for subsequent filings.
7. Priority document and for non-English document, its verified English translation. DAS Code: In the alternative, if the priority document is available through DAS, the DAS code can be shared with IPO that will enable the IPO to access the priority document.
8. Form 3 (particulars of corresponding applications in other countries viz. country name, application number, filing date and present status). We will provide the template.
9. Assignment: Proof of the right to file the application (assignment from the inventor(s) to the applicant(s), if they are different). Either executed Form 1 (prescribed for filing of patent application in India), executed by the inventors or a Deed of Assignment (DoA) assigning rights globally or in India. DoA should be either original or certified copy or notarized copy thereof.
10. The geographical origin of any biological material used in the specification needs to be indicated. If the biological material is obtained from India, permission from the National Biodiversity Authority is required prior to the grant of patent.
11. If biological material is deposited with an International Depository Authority, it is necessary to include its details in the specification that includes the name and

address of the depository institution and date and number of the deposit of the material.

To obtain a filing date we require items 2-4 and 5, if applicable. Item 6 needs to be filed within three months of filing in India. Item 7 should reach us within 3 months of filing in India. Items 8-9 need to be submitted to the Patent Office within six months of filing in India. The reference pertaining to item 11 may be made within 3 months of filing in India. It is pertinent to add here that any delay in filing information/document under items 8-9 incurs a heavy penalty of INR 50,000/ (~USD 600, for a large entity) / INR 10,000/ (~USD 120, for individuals and other applicants) for a month. Hence it is advised that timelines be adhered to strictly in furnishing information under these items.

**Additional information:** The official filing fees is a fixed amount for a specification that is 30 pages long and up to 10 claims. Additional official fees are payable for every extra page in addition to 30 and for every extra claim in addition to 10. Every application must be for one invention only. On filing, the application is accorded a date and a serial number. The government fees are subsidized for the following applicants: natural person, small entity, start-up and educational institution.

- **Request for Examination**

Request for Examination (RFE) can be filed within 31 months of the date of the earliest priority in the prescribed format, along with the prescribed fees. The RFE can also be filed along with the filing of the application.

## **PCT APPLICATION**

**The following information and documents are required for a PCT application:**

1. National phase entry in India is at 31 months of the earliest priority date.

2. The International application (IA) as filed under PCT is taken as complete specification that includes the title, description, claims, drawings, if any, and abstract. If claims have been amended either under Chapter I and/or Chapter II of the PCT, such amended specification is considered as complete specification for filing in India. Claims can be deleted at the time of national phase entry, to reduce the number of claims. However, for any amendments in the claims of the IA, a separate request is required to be filed, either at the time of national phase entry or later.
3. PCT application number and publication pamphlet containing the front page.
4. If the international application is in a language other than English, then verified English translation of the complete specification including title, description, claims (if amended, both as originally filed and amended) and abstract.
5. Sequence listing (if applicable). This has to be filed electronically at the Indian Patent Office. Fees with respect to equivalent number of pages is payable. Fees with respect to equivalent number of pages is payable with a maximum prescribed limit, depending upon the category of the applicant.
6. Power of Authority (POA). We will furnish the format. This has to be filed within three months of filing the application, failing which no action is taken by the IPO till the deficiency is removed. In cases where a General Power of Attorney from the applicant has already been filed, a copy attested by the agent/attorney can be filed for subsequent filings.
7. Form 3 (particulars of corresponding applications in other countries viz. country name, application number, filing date and present status). We will furnish the format.

8. Assignment: Proof of the right to file the application (assignment from the inventor(s) to the applicant(s), if they are different). Either executed Form 1 (prescribed for filing of patent application in India), executed by the inventors or a Deed of Assignment (DoA) assigning rights globally or in India. DoA should be either original or certified copy or notarized copy thereof.
9. Priority Document: this is required to be submitted at the time of national phase entry if:
  - a. If the priority document is not submitted during the international phase, i.e. IB/304 is not generated; OR
  - b. If the priority document is in a language other than English, a duly verified English translation of the same.
10. The geographical origin of any biological material used in the specification needs to be indicated. If the biological material is obtained from India, permission from the National Biodiversity Authority is required prior to the grant of patent.

#### **11. Request for Examination**

Request for Examination (RFE) can be filed within 31 months of the date of the earliest priority in the prescribed format, along with the prescribed fees. Since there is an overlap between timelines of national phase entry into India and RFE filing, we advise filing the RFE along with the filing of the application.

We require items 2-4 and 5, if applicable for national phase entry in India. PoA needs to be filed within three months from the date of filing the application in India, failing which no action will be taken by the IPO till it is filed. For items 7 and 8, documents need to be filed at the Indian Patent Office within six months of filing in India. For item

9, if the priority document is not filed at the time of national phase entry, then it has to be filed within 3 months of IPO's invitation to file, failing which the priority will be disregarded. It is pertinent to add here that any delay in filing information/document under items 7-8 incurs a heavy penalty of INR 50,000/ (~USD 600, for a large entity) / INR 10,000/ (~USD 120, for individuals and other applicants) per month. Hence it is advised that timelines be adhered to strictly in furnishing information under these items.

**Additional information:** The official filing fees is a fixed amount for a specification that is 30 pages long and up to 10 claims. Additional official fees are payable for every extra page in addition to 30 and for every extra claim in addition to 10. Every application must be for one invention only. On filing, the application is accorded a date and a serial number. The government fees are subsidized for the following applicants: natural person, small entity, start-up and educational institution. Proof, as applicable in the country of origin, is required to be submitted to claim the status of a small entity or an educational institution.