

S.O.S.

A Patent Perspective



THE PERSPECTIVE

While we celebrate our Global Innovation Index (GII) Performance YoY, we should crave for opportunities to sustain this growth and scope of further improvement in years to come. When a national perspective and outlook on a policy is assessed, we aim to look after all stakeholders. When it comes to innovation and protection of Intellectual Assets, one, for sure, cannot afford to overlook the most important stakeholder: Innovator. A pro-innovator approach leads to encouragement of overall fraternity, and the message of supportive ecosystem has a long-lasting impact. Resulting into overall strengthening of foundation for a thought process that involves innovation, creativity, and inclusiveness.

The actionable policy, when it comes to Intellectual Property and mechanism of its proper protection, must address the ease of doing innovation along with business. Patents are most often in spotlight whenever there is a discussion on these aspects. Rightly so, this particular asset assists a nation to create an identity for

itself. Therefore, GII scores countries on multiple aspects that includes Patents, among others.

To enhance the performance, a nation must explore ways to encourage creativity, innovation, and the very thought process. Creating a conducive ecosystem, including innovator-friendly legal framework should be on highest priority of policy makers. To keep up with the expectations, we need to put our best foot forward when it comes to international forums, while strongly defending the soul of the legal framework itself. With new avenues unfolding, our IP laws need modernisation with a balanced approach.

Through this White Paper, we are attempting to correlate India's positioning in comparison to the countries ahead of us on GII, focussing on approach towards innovators (read as Applicants) in Patent timeline. We are attempting to highlight how strict or lenient Indian Patent Act is for an Applicant, in comparison to the fellow countries.



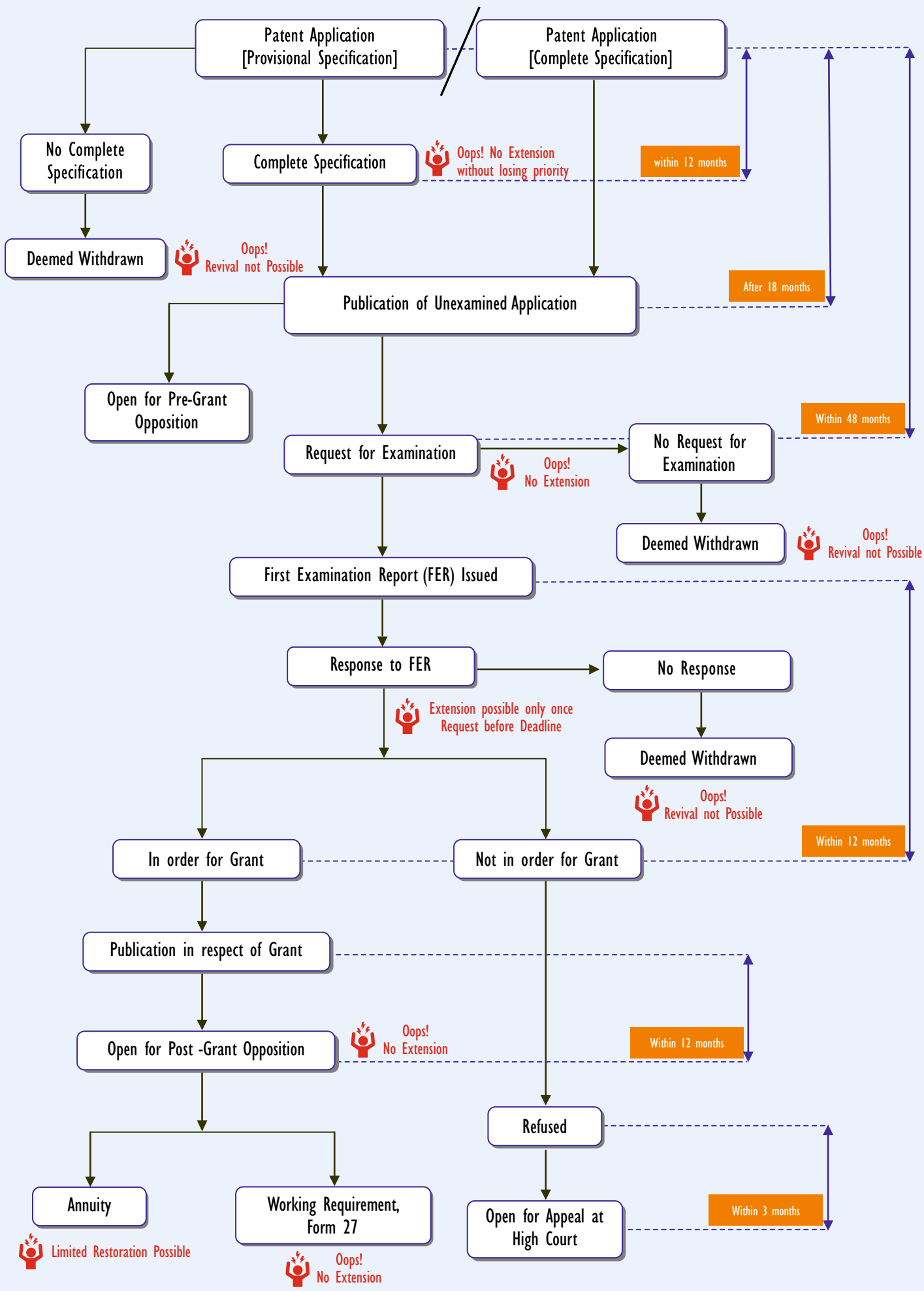
Global Innovation Index 2022



What is the future of innovation-driven growth?

#GlobalInnovationIndex

INDIAN PATENT PROSECUTION – FLOW CHART





EXTENSION FOR NATIONAL PHASE FILING

United States

30 months from priority date | Extension available with petition

Europe

31 months from priority date | No Extension

Canada

30 months from priority date | Extension may be taken within 12 months after the deadline

Singapore

30 months from priority date | Late national phase entry into the Singapore national phase is possible up to 48 months from the earliest claimed priority date.

India

31 months from priority date | No Extension

Australia

31 months from priority date | Extension is present in case an error or omission by the applicant or their attorney; or circumstances beyond the control of the applicant.

Japan

30 months from priority date | Extension is possible if Form 53 anytime within two months prior to the expiration of the "time limit for submitting national documents" is filed

Korea

31 months from priority date | Extension provision is present with payment of the applicable fee.

China

30 months from priority date | Extension of 2 months

United Kingdom

31 months from priority date | Extension up to 2 months



REQUEST FOR EXAMINATION

United States

RQE is filed during filing | No extension

Europe

6 months from the search report | Extension up to 1 month

Canada

4/ 5 years from the international filing date* | Extension up to 2 months from the notification by the Office to request examination and pay the fee alongside the surcharge.

Singapore

36 months from the earliest claimed priority date (or the filing date, if no priority has been claimed) | No extension

India

48 months from priority date | No extension

Australia

5 years from the international filing date or, where the Office directs the applicant to request examination, within two months of the date of the notice of the Office to that effect | No extension

Japan

Three years of the filing date of the patent application | No extension

Korea

3 years from the date of filing a patent application in Korea if filed on or after March 1, 2017; or within 5 years when the application was filed on or before February 28, 2017 | No extension

China

3 years from the priority date | No extension

United Kingdom

No later than 6 months from the date of publication | Extension up to 2 month (where no such request has been made previously) to a time period



FER / OFFICE ACTION EXTENSION

United States

3 months from the date of Office Action | Extendable upto 3 months after deadline by filing request at the time of filing the response to Office Action

Europe

4 months from date of First Office Action | Extendable by 2 months by filing request prior to deadline

Canada

4 months from the date of First Office Action | Extendable by 2 months by filing a request prior to the deadline

Singapore

5 months from the date of Written Opinion | Non-Extendable

India

6 months from the date of FER | Extendable upto 3 months by filing request prior to deadline

Australia

12 months from the date of FER | Non-Extendable

Japan

3 months from the date of Notice of Reasons for Refusal | Extendable upto 2 months, if the request is filed at the time of filing of response

Korea

2 months from the date of Notice of Rejection | Extendable upto 4 months on monthly basis

China

4 months from the date of Notice of First Office Action | Extendable upto 2 months by filing the request prior to the deadline

United Kingdom

4 months from the date of FER | Non-Extendable



REQUEST FOR EXTENSION OF TIME

United States

Available, Extension Petition can be filed After Due date

Europe

Limited Available, Extension Petition should be filed Before Due date

Canada

Available, Extension Petition can be filed After Due date

Singapore

Available, Extension Petition can be filed After Due date

India

Limited Availability and to be made
Before the Deadline

Australia

Available, Extension Petition can be filed After Due date

Japan

Limited Available, Extension Petition should be filed Before Due date

Korea

Limited Available, Extension Petition should be filed Before Due date

China

Available, Extension Petition can be filed after Due date

United Kingdom

Available, Extension Petition can be filed After Due date



HEARING ADJOURNMENT AND EXTENSION

United States

Option of Examiner interview upon request of Applicant

Europe

No hearing procedure except opposition proceedings

Canada

One adjournment allowed | Request for adjournment to be filed as soon as possible before the hearing date

Singapore

Hearing optional upon request of party

India

2 Adjournment requests allowed | Request to be filed at least 3 days before hearing date

Australia

Multiple Adjournments allowed with reasonable cause | Request to be made before hearing date

Japan

No hearing procedure except Invalidation or opposition | Adjournment request filed before hearing date

Korea

No hearing procedure except Invalidation or opposition | Adjournment request filed before hearing date

China

No hearing procedure except Invalidation or opposition | Adjournment request filed before hearing date

United Kingdom

Hearing Adjournment allowed | short period which should not exceed 28 day



EXTENSION IN FILING OF RENEWAL FEES

United States

3.5 years, 7.5 years and 11.5 years after grant | Extendable upto 6 months after due date

Europe

Annually from 2nd year of filing | Extendable upto 6 months after due date

Canada

Annually after grant | Grace period of 2 months upon payment of fee after the due date

Singapore

Annually after grant | Extendable upto 6 months after due date

India

Annually after grant | Extendable upto 6 months after due date

Australia

Annually from 4th year | Extendable upto 6 months after due date

Japan

Annually after grant | Extendable upto 6 months after due date

Korea

Annually after grant | Extendable upto 6 months after due date

China

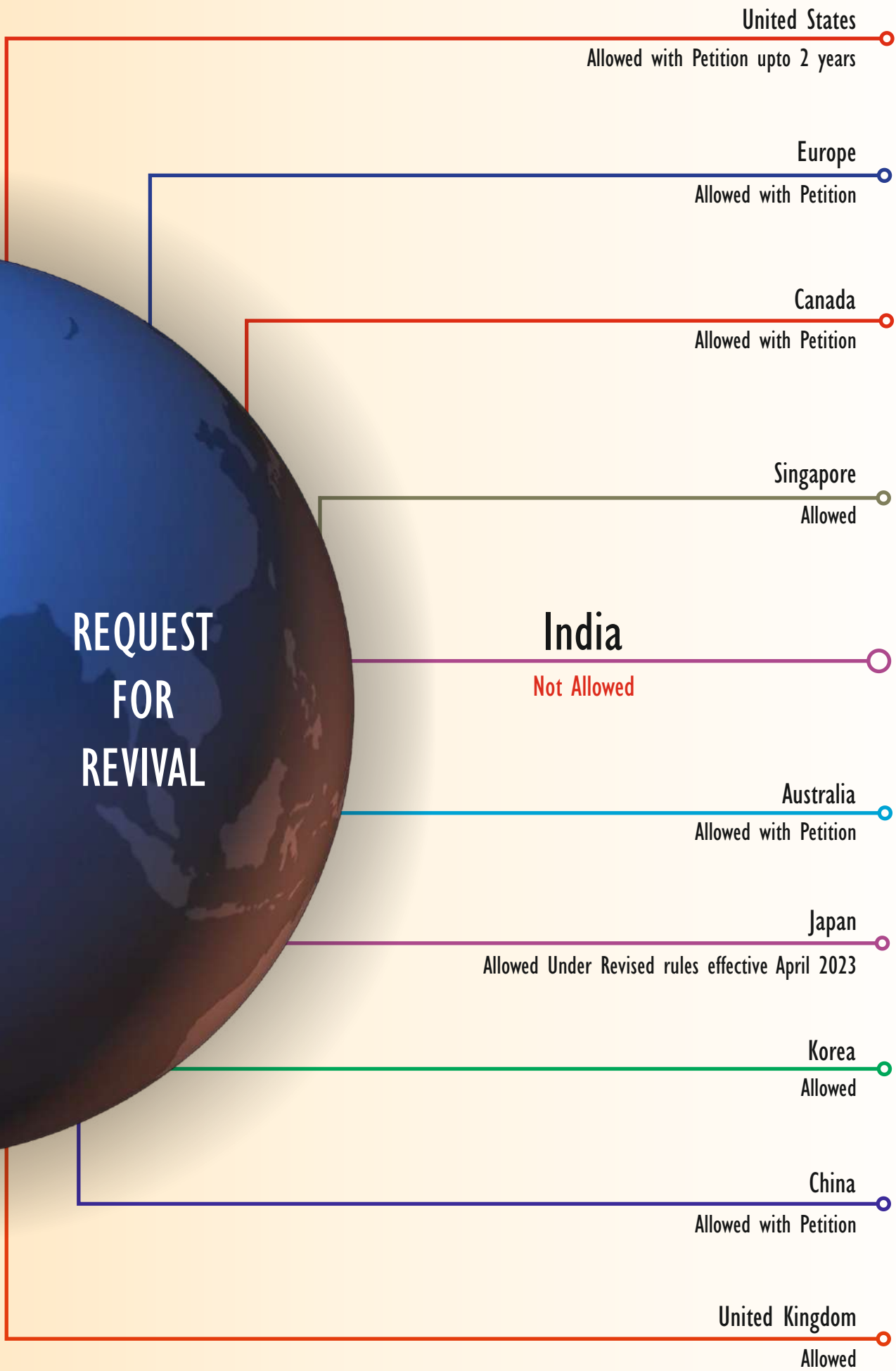
Annually after grant | Extendable upto 6 months from due date

United Kingdom

Renew up to 3 months before, or within one month after, the due date | Extension possible up to 6 months after the due date by paying pay £24 on top of the renewal fee for each extra month.



REQUEST FOR REVIVAL





Time for change

Timelines hold an importance when it comes to business, strategy, planning, and above all, competition. In present time, obtaining IP rights in timely manner is as important as creating an IP. Stakeholders appreciate, acknowledge, and practice time sensitivity of IP matters.

However, it is also the fact of matter that not every delay is an intentional one. When as a nation we are supportive of start-up culture, promoting innovation at grassroot level, we cannot overlook other challenges at those fronts. It is very human and natural process to have things delayed. But we really need to think what price of delay we are imposing on our innovators, when the pendency at respective offices is already very high! As entrepreneurial journey is already highly demanding, our legal framework must accommodate opportunity to hear the reasoning from an Applicant perspective.

When it comes to statutory timeline pressures, more than one category of stakeholders is adversely affected. For instance, apart from Applicant's risk of loss of rights, it is a psychological pressure on Agents and Attorneys, an occupational hazard which cannot be ignored. Ex-chequer is at loss of opportunity to have additional revenue. And, most importantly, the efforts of innovators go in vain when we deny them opportunity to revive

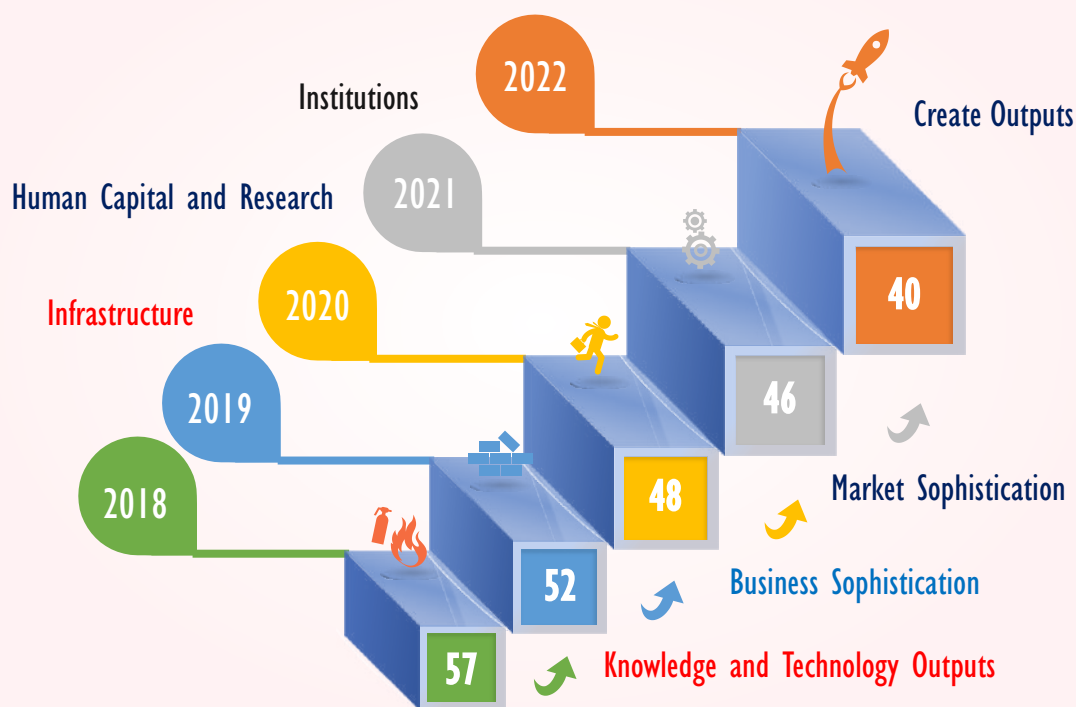
an application/IP right. It is a serious matter which should be openly debated to find a balanced approach and outcome, where every stakeholder is a winner. Thus, creating a vibrant, conducive, and victorious IP ecosystem.

It is need of the hour to debate on:

- Pros & cons of allowing revival of abandoned matters.
- Pros & cons of allowing extension petitions after the statutory deadline is over.
- Pros & cons of allowing revival petition with penalty.
- Pros & cons of notifying loss of right to Applicants in advance to provide opportunity to save the case.
- Pros & cons of exploring Office's revenue generation.
- Above and all “Addressing Psychological Pressure” of managing deadlines faced only by Patent Agents/Attorneys.

Based on the foregoing comparison, can we achieve single digit rank in Global Innovation Index without addressing these issues?

Global Innovation Index: Parameters & India's Positioning



Authors



Lalit Ambastha
Patent Attorney



Shruti Kaushik
Patent Attorney



Anju Rani
Patent Attorney



Nivedita Das
Patent Agent



Shubham Jain
Patent Attorney

Disclaimer

Patentwire has used reasonable endeavours to ensure that contents of this report were correct at the time the relevant pages were created, modified and published. Patentwire does not make any warranty, express or implied, or assumes any legal liability or responsibility for the accuracy, completeness, or usefulness of any information. The views and opinions of authors expressed herein do not necessarily state or reflect those of the Patentwire.

About Patentwire

Patentwire, an Independent Patent & Technology Consulting Firm, is based in New Delhi, India, with focus on Intellectual Property (IP) protection, enforcement and commercialization. We believe in knowledge driven economy and utility based technology. We endeavor at Patentwire to achieve excellence in patent and technology services. We believe in business and market oriented Research & Development, strategic protection & management of IP, technology market place search, identifying & analyzing new opportunity areas, technology transfers, and commercialization. The expertise at Patentwire includes a wide range of technical fields including Pharmaceuticals, Chemicals, Mechanical, Electrical, Life Sciences, Biotechnology, Electronics, Telecommunication, Software, Information Technology and more.

About Reinforce Intellectual Property Association

RIPA is a Not for profit organization with an aim to promote and facilitate indigenous Intellectual Property (IP) at National and International level. RIPA aims at meeting the present and future requirements for growth and development of indigenous IP. RIPA further strengthens and complements the efforts of indigenous R&D and innovations.



Where Inventions Live Long

PATENTWIRE CONSULTANTS PVT. LTD.

A199 Ground Floor, Defence Colony, New Delhi – 110024, India

Mobile: +91 98113 67838 | Telephone: +91-011-40366109

Fax: +91-11-24330039

Email: desk@patentwire.co.in

www.patentwire.co.in

© Patentwire 2022. All Rights Reserved.

This report is for informational purposes and is not intended to constitute legal advice.

