

**Frequently Asked Questions (FAQ)<sup>1</sup>****GENERAL QUESTIONS:****1. Does NIT Rourkela has a written Policy, Rules and Regulations on IPR? Where can I find it?**

Yes. It can be downloaded from URL:  
<http://nitrkl.ac.in/FacultyStaff/9SRICCE/IPR.aspx> .

**2. What can be patented?**

An invention relating either to a product or process that is new, involving inventive step and capable of industrial application can be patented. If answer to all the following questions are 'YES', you can apply for patent: i) Is it novel? ii) Does it involve inventive step which is non-obvious? iii) Is there an Industrial application? However, there are some categories of inventions that are non- patentable and can be found listed under section 3 and 4 of the Indian Patent Act, 1970.

**3. What is considered as an invention/innovation?**

An invention means: a new product or process involving an inventive step and capable of industrial application.

An innovation means: the successful exploitation of new ideas in the form of a useful machinery or process, by any person, using own intellect is called as innovation. Every innovation may not be patentable invention but every invention is an innovation.

All the inventions are the innovations and are patentable, but all the innovations are not the patentable inventions.

**4. What is considered as novel?**

An invention is considered to be novel if it has not been disclosed to the public at the time that the patent application was made. As long as the date of the patent application precedes any disclosure of details of the invention to the public, the invention can be validly patented. If however, details of the invention have been disclosed to the public before applying for a patent, then the invention is no longer considered to be novel in a patenting sense and it will not be possible to protect it validly through the patent system.

**5. What is considered as non-obvious?**

An invention is considered obvious if somebody knowledgeable in the subject area, when familiarised with all earlier patents or other technology in the area, would have immediately been led to the same conclusion.

**6. Why is Industrial Application important for patenting?**

Patents are of no value unless the commercial worth of the product or technology can be demonstrated and exploited. Many patentable inventions have failed because

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<sup>1</sup> Disclaimer:-The answers given in this document for the probable questions are for the purpose of guiding only and are collected from IPO and other sources. No copyright is claimed. The users are advised to refer the provisions of the Patents Act 1970 as amended and the Patents Rules 2003 as amended including the latest fee schedules.

inventor was unable to exploit them commercially. Unless inventor demonstrates the commercial value of the product/process, they are not recommended for patent filing by the IPR Cell.

#### **7. What is not patentable invention? Can you give some examples?**

Novel, non-obvious inventions of industrial applications are generally patentable. However, there are some categories of inventions that are non-patentable and can be found listed under section 3 and 4 of the Indian Patent Act, 1970. Some common examples of non-patentable inventions are as follows:

- An invention which is frivolous or which claims anything obviously contrary to whole established natural laws.
- An invention the primary or intended use or commercial exploitation of which could be contrary to public.
- The mere discovery of a scientific principle or the formulation of an abstract theory.
- The mere discovery of any new property or new use for known substance or of the mere use of known process, machine or apparatus unless such known process result in a new product or employ one new reactant.
- A substance obtained from mere admixture resulting into aggregation of properties.
- Mere arrangement or re-arrangement or duplication of known devices each functioning independently.
- A method of agriculture or horticulture.
- Any process for the medicinal, surgical, curative, prophylactic or other treatment of human beings or animals.
- Plants and animals in whole or any part in whole or any part thereof other than micro organism but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals.
- A computer programme per se other than its technical application to industry or combination with hardware
- A mathematical method or business method or algorithms
- A literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions.
- A mere scheme or rule or method of performing mental act or method of playing game.
- A presentation of information
- Topography of integrated circuits
- An invention which, in effect is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components.
- Invention relating to atomic energy.

#### **8. I have an idea. Can I patent it?**

According to Indian Patent Act, one cannot get a patent for mere an idea. One has to either build the product or clearly mention the process involved in making it. Without some identifiable embodiment of the idea there can be no intellectual property protection. It is true that, Indian Patent Rules do not require having a prototype of the

product/process for applying the patent, but it is essential that we are able to describe the invention so that others could make and use it.

**9. My product or process is not yet ready. Can I patent it?**

Yes. A patent application can be made as Provisional Application with provisional specifications. However, this is useful only in establishing a priority date for your invention. It must be followed by a complete specification describing the details of the invention along with a statement of claims within 12 months after filing of the provisional application. If the complete specification is not filed within the prescribed period, the application is treated as abandoned.

**10. I have published my research work in a Journal. Can I patent it now?**

The application for patent should be filed before the publication of the invention and till then it should not be disclosed or published. Disclosure of invention by publication before filing of the patent application may be detrimental to novelty of the invention as it may no longer be considered novel due to such publication. However, under certain conditions, there is grace period of 12 months for filing application even after publication. These exceptions are : i) Anticipation by previous publication (Sec. 29); ii) Anticipation by previous communication to the government (Sec. 30); iii) Anticipation by public display (Sec. 31); iv) Anticipation by public working (Sec. 32); v) Anticipation by use and publication after provisional specification (Sec. 33).

**11. I have presented my research work in a conference and is published as abstract. Can I patent it now?**

The application for patent should not have been disclosed in a conference or published as abstract. However, under certain conditions, there is grace period of 12 months for filing application even after publication. These exceptions are : i) Anticipation by previous publication (Sec. 29); ii) Anticipation by previous communication to the government (Sec. 30); iii) Anticipation by public display (Sec. 31); iv) Anticipation by public working (Sec. 32); v) Anticipation by use and publication after provisional specification (Sec. 33).

**12. Can any invention be patented after publication or display in the public exhibition?**

The application for patent should be filed before the publication or display in the public exhibition. However, under certain conditions, there is grace period of 12 months for filing application even after publication. These exceptions are : i) Anticipation by previous publication (Sec. 29); ii) Anticipation by previous communication to the government (Sec. 30); iii) Anticipation by public display (Sec. 31); iv) Anticipation by public working (Sec. 32); v) Anticipation by use and publication after provisional specification (Sec. 33).

**13. I have developed a software. Can I patent it?**

NO. Software cannot be patented. The source code and object code can be copyrighted.

Applications related to computer inventions may broadly fall under the following categories: (a) Method/process; (b) Apparatus/system; (c) Computer program product. The following aspects should be looked into while dealing with such applications:

The method/process claim should have a technical character. i.e. it should solve a technical problem. Technical applicability of the software claimed as a process or method claim, is required to be defined in relation with the particular hardware components. Thus, the “software per se” is differentiated from the software having its technical application in the industry. For example, “a method for processing seismic data, comprising the steps of collecting the time varying seismic detector output signals for a plurality of seismic sensors placed in a cable.” Here the signals are collected from a definite recited structure and hence allowable.

The apparatus claim should clearly define the inventive constructional hardware features. The claim for an apparatus should incorporate a “process limitation” for an apparatus, where “limitation” means defining the specific application and not the general application. For example, in a computer comprising means for storing signal data and a first resistor for storing data, the clause starting with “for” describes the function or process carried out by the apparatus, and form the part of “process limitation” here.

The claims relating to software programme product are nothing but computer programme per se simply expressed on a computer readable storage medium and as such are not allowable. For example, if the new feature comprises a set of instructions (programme) designed to control a known computer to cause it to perform desired operations, without special adoption or modification of its hardware or organization, then no matter whether claimed as “a computer arranged to operate etc” or as “a method of operating a computer”, etc., is not patentable. The claim might stipulate that the instructions were encoded in a particular way on a particular known medium but this would not affect the issue. e.g., a program to evaluate the value of PI or to find the square root of a number is held not allowable. An invention consisting of hardware along with software or computer program in order to perform the function of the hardware may be considered patentable. e.g., embedded systems.

**14. I have developed a process/product in collaboration with another investigator in another institute. Who shall file the patent?**

Joint patent can be filed through either collaborative institute or IPR Cell of NIT Rourkela. However, 50% of total patent filing cost will be borne by NIT Rourkela to keep the control over the intellectual property. Any excessive cost has to be paid by applicants from project fund.

**15. I have developed a process/product in collaboration with another investigator in NIT Rourkela. Who shall file the patent?**

Joint patent can be filed.

**16. I have developed a process/product in collaboration with another investigator in NIT Rourkela/another institute. Who shall be holder of the patent rights?**

Joint patent can be filed. Sharing of patent rights has to be worked out prior to IPR application and has to be as per the Memorandum of Understanding (MoU) signed between the two institute for joint work.

**17. Can I file the patent myself without going through the IPR cell?**

No. NIT Rourkela policy does not permit IPR filing without the recommendation of the IPR Cell and approval of the Director.

**18. I do not want any financial support in filing the patent from NIT Rourkela. Can I file the patent myself without going through the IPR Cell?**

No. NIT Rourkela policy does not permit IPR filing without the recommendation of the IPR Cell and approval of the Director.

**19. Can I hire patent attorney? Will NIT Rourkela pay for it?**

Currently, NIT Rourkela does not pay for patent attorney.

**20. Does NIT Rourkela reimburse all expenditure in patent filing?**

SRICC Office of NIT Rourkela reimburses all expenditure for patent filing and examination. However, expenditure incurred towards patent publication is not reimbursable. The TA/DA for travel to IPO, Kolkata are to be claimed under Professional Development Allowance (PDA) as per the appropriate rules and regulations.

**21. Does Indian Patent give protection worldwide?**

Patent protection is territorial right and therefore it is effective only within the territory of India. However, filing an application in India enables the applicant to file a corresponding application for same invention in convention countries, within or before expiry of twelve months from the filing date in India. Therefore, separate patents should be obtained in each country where the applicant requires protection of his invention in those countries. There is no patent valid worldwide.

**22. What is a PCT?**

PCT abbreviated, from the Patent Cooperation Treaty, is an International treaty, which provides facility to the applicant to file a single patent application and designate the countries in which he/she wants to protect his IP rights. Thus a single patent application is filed for the purpose of an international search report and to claim the priority date in all the designated countries. After receiving the international examination report, the applicant has to file a request in each designated country to take on record his/her application and this is called national phase of a patent application. A PCT application also provides an international filing date through a single patent application. India is a member country to PCT.

**23. Is it possible to file international application under Patent Cooperation Treaty (PCT) in India?**

It is possible to file an international application known as PCT application in India. Contact IPR Cell for details.

**24. Is it necessary to obtain prior permission from the IPO to file application for patent outside India or abroad?**

Yes AND No, depending on the circumstances. It is not necessary to obtain prior permission from the IPO to file patent application abroad under following circumstances: i) a patent application has been filed in India and six weeks period is over from that date; iii) The invention does not belong to Atomic Energy or defence purpose. In other circumstances, the prior permission is required. The prior permission from the IPO is certainly required under following circumstances.: i) the applicant is Indian resident and invention is originated in India; ii) Applicant does not wish to file patent application in India prior to filing abroad; iii) If the applicant is Indian resident, a patent application has been filed in India and six weeks period is not

yet over from that date; iv) The invention relates to atomic energy or defence purpose. For further details kindly refer to section 39 of the Patents Act, 1970.

**25. My invention uses a biological material which is new. Is it essential to deposit biological material in the international depository authority?**

If the invention uses a biological material which is new, it is essential to deposit the same in the International Depository Authority (IDA) prior to the filing of the application in India in order to supplement the description. The description in the specification should contain the name and address of the International Depository Authority and, date and number of deposition of Biological material. If such biological material is already known, in such case it is not essential to deposit the same.

**26. Is there any International Depository Authority in India?**

Yes, there is an International Depository Authority in India located at Chandigarh which is known as Institute of Microbial Technology (IMTECH). The more details about this depository authority can be had on its website <http://imtech.res.in/>.

## WRITING PATENT DOCUMENTS

**1. How do I proceed to file a patent?**

Follow the steps given [here](#).

**2. There are a number of IPO Forms available in the NIT Rourkela website. Which forms should I submit while applying to IPR cell for process/product patent?**

IPR Cell require soft (PDF and MS Word) and hard copies of the i) “Proposal for Filing Indian Patent” (Downloadable from IPR website of the Institute: <http://nitrkl.ac.in/FacultyStaff/9SRICCE/IPR.aspx>); ii) Appropriate IPO forms for patent/design/copyright filing (Downloadable from IPR website of the Institute: <http://nitrkl.ac.in/FacultyStaff/9SRICCE/IPR.aspx>). A product or process patent filing will require Form – 1, Form – 2, Form – 3, Form – 9 and Form – 18.

**3. Where can I find guidelines for filling the IPO Forms?**

Brief guidelines can be downloaded from IPR website of the Institute: <http://nitrkl.ac.in/FacultyStaff/9SRICCE/IPR.aspx>.

**4. Where can I get more information on writing patent documents?**

Grater details of IPO Acts and Rules etc. can be seen at [www.ipindia.nic.in](http://www.ipindia.nic.in).

**5. Where can I search existing patents?**

A list of patent search data base can be seen [here](#).

## SUBMITTING PATENT DOCUMENTS

**1. I have prepared the patent documents as per the NIT Rourkela guidelines. Where to submit them?**



Soft copies (PDF and MS Word) of documents should be sent to the AR (CN) by E-mail. Two hard printed copies of the above documents to the PIC, IPR Cell.

**2. I have submitted the patent documents to the IPR Cell. What to do now?**

Wait for communication from the IPR Cell. The recommendation of the IPR Cell could be one of the following: i) Proposal is recommended for processing and filing; ii) Proposal is recommended for revision. The proposer may be requested to give a presentation and/or show the patentable product to the IPR committee; iii) Proposal is rejected.

**3. How long does it take to get a response from the IPR Cell?**

Usually, IPR Cell meeting is convened within 5 working days of receiving the proposal. Proposal is sent to Reviewers for detailed evaluation with a request to submit their report within 5 days to the PIC, IPR Cell. So, typically you can expect the response within 1-2 weeks.

**4. I got an approval from the IPR cell for filing the patent. What do I do now?**

Proposing faculty of approved applications files the patent in the IPO Office, Kolkata.

**5. Does the NIT Rourkela support my TA/DA for travel to Indian Patent Office? How to apply?**

Yes. TA/DA can be claimed from the Professional Development Allowance (PDA) of the concerned faculty.

**6. How do I pay the money for patent filing?**

NIT Rourkela supports fee for patent application and examination. However, fee for publication has to be paid by the faculty, which may be from their project. With a letter of approval from IPR Cell, faculty can apply to SRICCE Office for advance towards payment of patent filing.

**7. My patent filing was approved by IPR cell. I filed the patent at IPO and paid the filing fee myself. Can I get reimbursement?**

Yes. If the faculty desires, he/she may make the drafts himself/herself and later, reimburse the amount from SRICC Office.

**8. Does NIT Rourkela reimburse all expenditure in patent filing?**

No. NIT Rourkela supports fee for patent application and examination. However, fee for publication has to be paid by the faculty, which may be from their project.

**9. Does the Indian Patent Office Keep information of the invention Secret?**

Yes. All the patent applications are kept secret up to 18 months from the date of filing or priority date whichever is earlier and thereafter they are published in the Official Journal of the Patent Office which is published every week and also available on the IPO website. After its publication, public can inspect the documents and also may take the photocopy thereof on payment of the fee as prescribed.

## POST-SUBMISSION OF PATENT DOCUMENTS

**1. What are the various stages involved in the grant of patent?**

After filing the application to the IPO, for the grant of patent, a request for examination is required to be made by the applicant or by third party and thereafter it is taken up for examination by the Patent office. After examination, the First Examination Report (FER) is issued and the applicant is given an opportunity to correct the deficiencies in order to meet the objections raised in the said report. The applicant must comply with the requirements within the prescribed time (usually 12 months) otherwise his application would be treated as abandoned. When all the requirements are met, the patent is granted and notified in the Patent office Journal.

**2. Are patent applications once filed examined automatically by the IPO?**

No. The patent application is not examined automatically after its filing in the IPO. The examination is done only after receipt of the request of examination either from the applicant or from third party. Normally, NIT Rourkela encourages applying for publication and examination along with the submission itself to avoid the hassle.

**3. When the request for examination can be filed?**

The request for examination can be made to IPO in an appropriate form with prescribed fee within a period of 48 months from the date of priority or date of filing of the application whichever is earlier. Normally, NIT Rourkela encourages applying for publication and examination along with the submission itself to avoid the hassle.

**4. Is there any provision for early examination?**

There is no provision for filing a request for early examination. The applications are examined in the order in which requests for examination are filed. However, an express request for examination before expiry of 31 months in an appropriate form with prescribed fee can be made in respect of the applications filed under Patent Cooperation Treaty known as National Phase applications by payment of the prescribed fee. Normally, NIT Rourkela encourages applying for publication and examination along with the submission itself to avoid the hassle.

**5. What happens to a patent application once it is examined?**

After examination, the Patent office issues an examination report to the applicant which is generally known as First Examination Report (FER). Thereafter the applicant is required to comply with the requirements within a period of 12 months from the date of FER. In case, the application is found to be in order for grant, the patent is granted, provided there is no pre-grant opposition is filed or pending. A letter patent is issued to the applicant. However, in case a pre-grant opposition is pending, the further action is taken after disposition of the pre-grant opposition.

**6. What happens when applicant is not able to meet the requirement within the prescribed time?**

If the applicant is not able to comply with or meet the requirement within 12 months, or does not submit the documents which were sent to him for compliance within the said period, the application is deemed to have been abandoned.

**7. Is there provision for extension beyond time limit of 12 months?**

There is no provision for extension of time beyond the period of 12 months.

**8. Does applicant get an opportunity of being heard before his application is refused?**



If applicant has not complied with the requirements within the prescribed time, and no request for hearing has been made by the applicant, the controller may not provide the opportunity of being heard. However the Controller shall provide an opportunity of being heard to the applicant before refusing his application if a request for such hearing has been made by the applicant at least 10 days in advance before expiry of the statutory period.

**9. Can one use the words "Patent Pending" or "Patent Applied For"?**

These words are normally used by the patent applicant to their products after filing his application for patent so that the public is made aware that a patent application has been filed in respect of that invention. Use of these words where no application has been made is prohibited under the Patent law. However, use of such words by the patent applicant does not prohibit the third party to plead as innocent unless the patent number is indicated.

## AFTER OBTAINING THE PATENT

**1. How long my patent is valid?**

Term of every patent in India is 20 years from the date of filing of patent application, irrespective of whether it is filled with provisional or complete specification. However, in case of applications filed under PCT the term of 20 years begins from International filing date.

**2. What are obligations of the patentee after the grant of patent?**

After the grant of patent, every patentee has to maintain the patent by paying prescribed renewal fee every year. For first two years, there is no renewal fee. The renewal fee is payable from 3rd year onwards. In case the renewal fee is not paid the patent will be ceased.

**3. Can the patentee pay renewal fee at a time or has to pay every year?**

The patentee has choice to pay the renewal fees every year or he can pay in lump sum as well.

**4. How to restore a cessed patent?**

A request for restoration of patent can be filed within 18 months from the date of cessation of patent along with the prescribed fee. After receipt of the request the matter is notified in the official journal for further processing of the request.