

# PRIORITY DOCUMENTS PRACTICE IN INDIA



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An applicant filing national phase PCT entry in India may claim priority from the earlier filed PCT application while filing the same application in India. Such claiming of priority retains the novelty of a claim. Generally speaking, anything published on or after the date of priority of a claim cannot be cited to affect the novelty of that invention.

## Priority document requirements in National Phase Applications in India:

While filing a PCT national phase application in India, the applicant is entitled to claim priority from the earlier PCT application if the applicant has complied with [Rule 17.1](#) of the PCT regulations in the international phase of the PCT application.

In such situations, where the applicant has complied with the requirements under Rule 17.1 of the PCT Regulations, the applicant may furnish a copy of form PCT/IB/304 issued by the International Bureau, to the Indian patent office (IPO), at the time of filing of PCT National Phase application. This is a notice to the IPO that the patent applicant has met the requirements of Rule 17.1 of the PCT, and the priority document is available for access to the IPO.

However, in case the applicant has been unable to comply with said Rule 17.1 of the PCT regulations, the applicant still has an opportunity to validly claim the priority for the national phase in India. According to [sub-rule 1 of Rule 21](#) of the Indian Patents Act, if the applicant has not complied with the requirements of Rule 17.1 of PCT Regulations, then the applicant can furnish a certified copy of priority document at the IPO. In such cases, the deadline for filing the certified copy is taken as 31 months from the date of such priority.

Where the priority document in such a case is not in English, a translation into English must be provided to validly claim the priority supported by a declaration by the applicant or a person duly authorized by the applicant about the contents of the translation is required.

In case, if the applicant has failed to submit the priority document within the time limit of 31 months, the patent office may still call for the said document at the time of prosecution of the patent application. In such scenario, the applicant is required to file the certified priority document along with verified

English translation (if any) within a period of 3 months from such communication from the patent office.

If the applicant fails to submit the priority document within the time frame, the claim of the applicant for the priority shall be disregarded for the purposes of the Act, as per [Sub Rule 3 of Rule 21](#) of the Indian Patents Act.

## Priority document requirements in Convention Applications in India:

A convention patent application is required to be filed in India, within twelve months from the earliest priority date.

Usually, a certified copy of priority document along with verified English translation (if non-English) should be filed at the time of filing of the convention application. However, there are no specific time limits prescribed in the Patents Act for such submission as mentioned below, and accordingly the priority document could be submitted any-time after the filing of the application in India.

Moreover, if the priority document is not filed at the IPO, the Controller may communicate to the applicant for such requirement. The applicant is required to file the certified copy of the priority document within 3 months from the date of such communication from the patent office.

## Issues regarding Non-English Priority Documents:

There may be a case where the English translated specification filed for convention application or PCT national phase application in India is an exact translation of the claimed priority application. Then in this particular case, there would be no extra translation cost for translation of priority application because the English specification has already been submitted at the time of filing. The applicant is only required to provide the verification certificate and the certified copy of the non-English priority document as the case may be.

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However, inconvenience arises when the English specification filed for the convention application in India is not an exact translation of the priority application, as in such a case, the applicant has to bear an additional cost of translating the priority application along with obtaining the certified copy of the same. This means, the applicant ends up translating two specifications. The first one used for the convention filing in India, while the other is the earlier filed basic application or priority application. This might be cumbersome in many situations, especially in cases where the Indian application is not exactly the same as the priority application.

However, for the PCT national phase entry, the applicant might be saved from the inconvenience of submitting two separate translations in case when the patent office calls for a translation of the priority document. According to [Rule 51 bis 1 \(e\)](#) of the PCT, an applicant is required to furnish the translation of the priority document in the following limited scenarios:-

**Scenario 1:** When there arises a question of validity of the priority claim in order to determine the patentability of the claimed invention;

**OR**

**Scenario 2:** When there is any reference made in the PCT application for a certain element which was earlier disclosed in the priority application.

Except in these scenarios, if the Examiner calls for a translation of priority document for a National Phase Application, then the applicant may argue upon this point and request for waiver of the objection.

Below we summarize what is required to be done by the applicant while filing PCT or convention entry in India:

- ◆ **For PCT entries:** Submit IB/304 or submit the doc before entry. In case the patent office asks for submitting priority documents for non-English priority, the applicant may argue limitations under [Rule 51 bis 1](#) to waive off the objection.
- ◆ **For Convention entries:** Submit the priority document any time during the prosecution. However, for non-English priority, the applicant is required to submit verified English translation of the priority document along with certified copy.

