Tips to prepare for

Indian Patent Agent Examination
Preface

It gives us immense pleasure to present this booklet, “Tips to prepare for Indian Patent Agent Examination”. Conducted by Indian Patent Office under the Department of Ministry of Law, Indian Patent Agent Examination is written by the candidates, who wish to register themselves as registered patent agents. The booklet outlines the eligibility criteria for appearing in the Patent Agent Examination and tips to prepare for the examination.

The role of a patent agent has been a source of curiosity since enactment of the Patents Act 1970 (the Act). The provisions relating the patent agents have been comprehensively amended in 2002 amendment enforced from 20th May 2003. One of the most commonly asked questions is whether is it important to be patent agent especially when there is huge scope for people who are expert in patent searches, who may or may not be patent agent. In this booklet we have tried to address queries related to this examination and provided tips to prepare for the examination.
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A. Introduction

A patent is one of the most complex legal documents that is techno-legal in nature. Drafting and prosecution of patent application needs technical skills as well as thorough knowledge of patent law. There is a provision in the Patents Act for appointment of a Patent Agent by the inventor/applicant to assist him in filing and other modalities in the Patent Office.

A patent agent or a patent attorney is person who has the specialized qualifications necessary for representing clients in obtaining patents and acting in all matters and procedures relating to patent law and practice. A Patent agent may be appointed by the inventor/applicant to perform various actions before the patent office on behalf of the applicant and in consultation with him.

The term patent agent is used differently in different countries. In some jurisdictions, the terms patent agent and patent attorney are interchangeable and used as synonym but in others, the latter is generally used only if the person is qualified as a lawyer and additionally is registered as patent agent. This means that a patent attorney can not only practice before Indian Patent Office but also is eligible to practice in the Courts. Some jurisdictions also use the term “patent attorney” to include attorneys, who are not admitted to practice before the Patent Office, but who represent parties in patent litigation and other legal matters. Such attorneys may or may not have technical backgrounds.

An attorney, who is not admitted to practice before the Patent Office may represent parties in patent litigation but may not be qualified to prosecute patent applications. On the other hand, a patent agent may prosecute patent applications but may not be qualified to represent parties in patent litigation. Indian Patent Act, 1970 (Section-132) does not stop an advocate, not being a patent agent, from taking part in any hearing before the Controller on behalf of a party who is taking part in any proceeding under the Act.

B. Frequently asked questions: Indian Patent Agent Examination

1. Who is a patent agent?

In India, a person registered to practice before Indian Patent Office (IPO) is called as "Registered Patent Agent" or a "Patent agent". Indian Patent Office conducts a qualifying examination for patent agent registration once or twice a year and the candidates qualifying the examination are registered as patent agents and are authorized to practice before IPO.
2. Who can become a patent agent?

A person for being eligible to register himself in the register of the Patent Agents under the Act must have qualification prescribed under section 126. These qualifications are as follows:

- The person shall be a Citizen of India;
- He/she must have completed 21 years of age;
- He/she shall possess a Degree in Science, engineering or technology from recognized university or other equivalent qualification as prescribed by the Government; and
- He/she should have passed the qualifying examination conducted by the Patent Office or Should have worked as examiner or discharged functions of Controller for not less than ten years.

Additionally, he also must have paid such fee as prescribed. terms are open to interpretation.

3. What is meant by Register of Patent Agents?

It is mandatory to maintain a Register of Patent Agents for the purpose of identifying, who are the persons registered as patent agents and are entitled to work for the purpose of prosecuting the application for patent on behalf of the applicant. The name and other details of the registered patent agents are maintained at the patent office in a register called as “Register of Patent Agents”. The register also gives the details of the active patent agents. The list of registered patent agents is available on the official web-site of Indian Patent Office.

4. What are rights of a patent agent?

Every patent agent whose name is entered in the register shall be entitled:

(a) To practice before the Controller during prosecution process such as at the time of opposition to the grant of patent, he can practice before the Controller; and
(b) To prepare all documents, transact all business and discharge such other functions [such as filing of patent, sending request for early publication or examination, reply to examination report, paying renewal fee etc] as may be prescribed in connection with any proceeding before the Controller under this Act.

A registered patent agent under this Act can draft, file and prosecute patent application at Indian patent office. Additionally, the registered patent agent can

take authorization from his client on Form-26\(^2\) [Form of authorization] so that he can act on behalf of his client. All applications and communications to the Controller may be signed by an authorized patent agent.

5. **What are the restriction to practice as a patent agent**

No person shall practice as a patent agent or call himself a registered patent agent if he is not registered in the Register of Patent Agent.

(1) No person either alone or in partnership with any other person, shall practice, describe or hold himself out as a patent agent, or permit himself to be so described or held out, unless he is registered as a patent agent or he and all his partners are registered.

(2) No company or other body corporate shall practice, describe itself or hold itself out as patent agents or permit itself to be so described or held out.

Practice as a patent agent includes any of the following acts, namely:

(a) Applying for or obtaining patents in India or elsewhere;
(b) Preparing specifications or other documents for the purposes of this Act or of the patent law of any other country;
(c) Giving advice other than of a scientific or technical nature as to the validity of patents or their infringement.

6. **When is the Patent Agent Examination conducted?**

The qualifying patent agent examination is conducted by the office of the Controller. The particulars of the examination, the curriculum and qualifying marks are given in Rule 110. Upon passing the examination with a prescribed score, the successful candidates are required to follow a registration process as provided in chapter XV of Patent Rules.

The examination consists of two written exams and viva. Paper 1 relates to Patent Act and Rules, Paper II relates to drafting and interpretation of patent specifications and other documents. Each written paper carries maximum 100 marks. The Viva carries 50 marks.

The Rule 110 (3) regarding qualifying marks has been amended after the decision of the Delhi High Court in Anvita Singh V/s Union of India and Others in 2012 and Renu Bala case. The amended rule 110(3) reads as follows:

\(^2\) Form-26 shall be executed on stamp paper of 100 INR denominations.
A candidate shall be required to secure a minimum of fifty marks each in paper I and paper II and shall be declared to have passed the examination only if he obtains an aggregate of sixty percent of total marks.

The amended rule has practically reduced the viva redundant as one need to only have compulsory appearance in the viva. If a candidate secures 150 marks in both the written papers and only appears for viva.

The detailed nature of the paper I and paper II is as follows:

**Paper 1: 2 hours**

It is Objective type; Multiple Choice Questions having one and/or more than one option correct. You require to pick the right answer(s) from amongst given choices. You must answer all questions in this part.

**Paper 2: 3 hours**

Descriptive

7. **Job opportunities for a patent agent**

A patent agent, being an expert in patent law as well as technology shall have good opportunities not only in IP department of any R&D oriented firm but also in the law firm. Areas of work could be patent specification drafting, filing, prosecution and performing patent searches of various kinds. However, clearing the patent agent exam and registration as a patent agent alone is no more than a certification. In the super specialised area like patents, one need to work really hard and acquire skills and expertise for long term and sustainable career growth. Career of a patent agent can always extend to more specialised areas, such as, patent valuation, technology commercialisation, IP management etc.

8. **Is a law degree necessary to become Patent Agent?**

No. To become a patent agent one need not be a lawyer.

9. **How many times one can appear for the examination?**

Till date no maximum number of allowed attempts has been notified by the Indian Patent Office. One can appear for the exam as many times as he/she wish.
10. Can one practice outside India once he/she a registered patent agent?

No. This certification is for Indian citizens and recognized only by the Indian Patent Office and PCT. If anybody wishes to practice outside India like US and Europe, he or she has to qualify the patent agent examination or equivalent examination for the respective countries.

11. What is the process to apply for this examination?

Candidates interested in applying for the examination may visit the Indian Patent Office official website www.ipindia.nic.in to keep themselves updated regarding the notification of the examination. The detailed instructions are provided on the website and applications will be required to be filed strictly in accordance with the said instructions. The candidates will be required to enter the details into the online system and take a printout of the application form.

The said application form along with the necessary enclosures and examination fee should reach the following address on or before the deadline.

“The Controller General of Patents, Designs and Trade Marks

Boudhik Sampada Bhawan, S.M. Road, Antop Hill

Mumbai – 400037”

12. What are the certificates or documents needed to apply for examination?

Following enclosures are required to be sent to Patent Office along with the application:

i. Proof of age (attested by a Gazetted Officer);

ii. Degree certificate (attested by a Gazetted Officer);

iii. Proof of Citizenship;

iv. Two recent passport size photographs.

v. Demand Draft of INR 1600/-.

13. How to register the name as registered patent agent after clearing the examination?

After passing the Patent Agent Examination, the successful candidate shall request the Controller to register him/her as a patent agent in the Register of Patent agents.
(1) Every person who desires to be registered as a patent agent shall make an application in Form-22 [Application for registration of patent agent under rule 109 (i) or 112]. This form is required to be filled and sent only after the patent agent examination result has been declared and the person is declared as successful (pass).

(2) The applicant shall furnish the additional information required by the Controller such as attested copy of degree certificate or character certificate.

(3) A person desirous to appear in the qualifying examination [Rule 110, Particulars of the qualifying examination for patent agents], shall make a request to the Controller along with the fee of 1760 INR.

Application for the qualifying examination shall be made on plain paper addressed to “The Controller of Patents” in the prescribed manner along with requisite fee in cash / cheque / D.D. in favour of “The Controller of Patents” and payable at any of the four branches and shall be submitted to the nearest Patent Office along with two copies of passport size photos and with relevant documents [character certificate and copy of attested degree certificate].

14. Can the name of a registered patent agent be removed from the register?
The name of a patent agent may be removed by the Controller under certain circumstances.

(1) The Controller may delete the name of a patent agent from the register of patent agents if:

(a) A request has been received to that effect from him, or
(b) He is dead, or
(c) Controller has removed the name of a person under Section 130 (1) [Removal from register of patent agents and restoration] for the reason that:

i. He/she has been convicted of any offence and sentenced to a term of imprisonment; or
ii. Has been guilty of misconduct in his professional capacity which in the opinion of the Controller renders him unfit to be kept in the register.

(d) He has defaulted in the payment of fees specified in rule 115 [Payment of fees], by more than three months after they are due.
15. Can the controller refuse to deal with certain patent agents?

In connection with the patent application(s) filed by the patent agent, there may be several communications between the patent agent and the Controller. However, the Controller may refuse to deal with certain patent agents under specific circumstances.

(1) The Controller may refuse to recognize as agent in respect of any business:

   (a) Any individual whose name has been removed from the register and not restored.
   (b) Any person who has been convicted of an offence under Section-123 [Practice by non-registered patent agents]
   (c) Any person who is not registered as a patent agent but is engaged wholly or mainly in acting as agent in applying for patents in India or elsewhere in the name or for the benefit of the person by whom he is employed.
   (d) any company or firm, if any person whom the Controller could refuse to recognize as agent in respect of any business under this Act, is acting as a director or manager of the company or is a partner in the firm.

(2) The Controller shall refuse to recognize as agent in respect of any business, any person who neither resides nor has a place of business in India.

16. Can the name of registered patent be restored after removal from the register of patent agent?

Yes. The name of the patent agent may be removed from the register of patent agents for various reasons as mentioned in Section-130 (2) [Removal from register of patent agents and restoration] but he can request the Controller for restoration of his name in the register. The Controller may, on application and on sufficient cause being shown, restore the name in the register of patent agent.

(1) An application for the restoration of the name in the register of patent agents shall be made in Form-233[On application for restoration of the name of a person in the register of patent agents under rule 117 (1)] within 2 months from the date of such removal.

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3 Fee payable is 1600 INR (continuation under entry number 34).
(2) If the name of a person is restored to the register of patent agents, his name shall be continued for a period of one year from the date on which his last annual fee became due.

(3) The restoration of a name to the register of patent agents shall be published and communicated to the person concerned.

C. Tips: Preparing for Indian Patent Agent Examination

1. Preparation of Paper I

- First get familiar with all terminologies in all the aspects of Intellectual Property Rights and learn basics of all forms of Intellectual Property, like, Patent, Trademark, Copyright, Design and Geographical Indication etc.
- Read the latest version of The Patents Act thoroughly including all the amendments and refer Patent Manual published by Indian Patent Office.
- Understand what are Sections and Rules. Interpret the difference and co-ordination between the sections and the rules.
- Analysis of each and every section and their interpretations is important.
- Correlate each rule with a respective section.
- Read the updated annexure for the forms and fees.
- Go through recent case-laws to understand the subject in details. You may expect case-law based questions during Viva.

Important Tip

- While answering questions from Paper I, it is advisable to mention appropriate rules, sections, forms, fee etc. This will help you fetch more marks.
- Map appropriate rules with the sections.
- Solve previous year question papers and identify frequently asked questions.

Suggested reading

- Indian Patents Act 1970
- Manual of Patent practice and procedures
- Recent case laws

2. Preparation of Paper II

- Learn about all the treaties and conventions with respect to Patent law and other forms of Intellectual Property (PCT, Budapest treaty, Paris convention, Madrid convention, CDB, GATT, WTO etc).
- Understand basic concept of drafting patent specifications including claims. Understand the process and procedures of PCT.
**Important Tip**

- Download some patents from free platforms and understand anatomy and construction of patent specifications.
- Practice drafting patent specifications including the claims.
- Visit official website of WIPO and understand PCT process and procedures and don’t miss out fee structure applicable.
- Solve previous year question papers and identify frequently asked questions.
- Learn to manage time well especially in case of patent specification drafting questions.

**Suggested reading**

- Manual of Patent practice and procedures
- Official website of WIPO to know about PCT process and procedures.

**D. Indian Patent Agent Examination training at OIPA**

Purpose of this training is to provide extensive training programme to patent agent aspirants in order to successfully clear the Indian Patent Agent Examination conducted by IPO

**Modes of learning and fee**

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<th>SN</th>
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<th>Distance Education (PAE Distance)</th>
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<tr>
<td>Course duration</td>
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<tr>
<td>Fee</td>
<td>25,000 INR</td>
<td>18,000 INR</td>
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<tr>
<td>Location</td>
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**Study material**

**Module I** - Interpretation of each and every Section/Rule of Indian Patent Act 1970.

**Module II** - Convention and Treaties related to Patent Law, PCT procedures, Patent drafting skills, Licence Agreements, Tips for Viva

**Module III** - Solutions to Previous Years Question Papers

- The Indian Patent Act 1970 (Bare Act) with latest amendments
How to enrol

You may download Registration Form from Origiin IP Academy LLP website (www.origiinipa.com) and contact us at info@origiinipa.com.

About OIPA

Origiin IP Academy or OIPA is India’s premier institute for IP or Intellectual Property learning. Main objective of OIPA is to provide a platform for IP learning, not only for the corporates but also for the domain experts to learn various skills needed in the industry such as patent search, patent specification drafting etc.

Our mission is to provide a wholesome IP education by giving an insight into the practical applications of IP practices and enable the participants to work independently and immediately after completion of the course.

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