



Guidelines for filing Patent Application in Pakistan



Contents

❖ Introduction

Step 1

How to prepare your complete Patent specification

- Title of invention
- Abstract
- Field of the invention
- Background of the invention
- Detailed Description
- Drawings
- Claims

How to prepare your provisional Patent specification

Step 2

How to fill the forms

- ◇ For Non- Convention applications
- ◇ For Convention applications

Step 3

How to pay the filing fee

- ❖ Check list
- ❖ Feedback if any

Introduction

These guidelines contain the information to help you to file a patent application in Pakistan's Patent Office. The purpose of these Guidelines is to provide applicants with a better understanding to prepare and file a patent application in accordance to prescribed legal requirements. Please take note that this Guideline is neither exhaustive nor authoritative. For details please refer to the Patents Ordinance, 2000 (amended in 2002 & 2007) and the Patents Rules, 2003.

First, it is important to know what inventions and patents are. "Invention" means any new and useful product or process, in any field of technology and includes any new and useful improvement of either of them. An invention can be, for example, a product, a process or an apparatus. To be patentable, an invention must be new, involves inventive step and capable for industrial application.

Patent is a set of exclusive rights granted by the government to an inventor or assignee for a limited period of time in exchange for detailed public disclosure of an invention.

A Patent is valid for the term of 20 years from the date of filing in the territory (Country/Region) where the

patent was granted. Patent confers the right to prevent third parties from making, using or selling the invention without their owner's consent i.e. Patentee.

Before applying for a patent, it is advised to carry out a patent search in patent databases and non-patent literature.

File first – publish later

Another important aspect when you possess an invention, is that you do not publish the invention in any way before filing the patent application. A patent can only be granted for an invention that has not yet been disclosed to the public, neither in writing nor orally. The right way is to first file application and then publish.

Novelty is destroyed with your own publications, lectures, posters, thesis, dissertations and other academic papers (if published), final reports (if published), research applications (if published), guided tours, press releases, presentations at fairs, user instructions and prior use known to the public.

Should it be necessary to present your invention to business partners or investors? It is advisable to conclude a confidentiality agreement, since even publications by third parties relating to your invention prevent the awarding of a patent.

STEP 1

Preparation of complete Patent specification:

The first step in filing Patent application is to prepare a patent specification. Writing a high-quality patent application is important because it sets out in a clear manner the terms by which the patent owner and others will be bound. In this sense, drafting a patent application is different from writing a scientific paper.

Every specification, whether provisional or complete, shall begin with title and be signed, and dated at the end by the applicant or his Patent agent. Only use one side of the sheet for writing specification. Please write specification in English language, in at least 1^{1/2} line spacing, on white A4 size paper with minimum margins 2 cm from top and bottom, 2.5cm from left side and 2 cm from right side.

A complete patent specification can be structured in a number of ways, but there are some features that are almost always present. Please draft your patent_specification with following contents:

1. Title of invention: Title of the invention sufficiently indicates the subject matter of the invention. It is best to avoid being overly narrow or broad in the invention's title.

2. Abstract: It includes all the important technical aspects of your invention. Abstract shall commence on a new sheet. The abstract

normally consists of not more than 2 pages. Abstract should mention those technical features of invention which are disclosed in detailed description part of the invention. It is advisable after writing abstract check all this disclosed in description part of the specification.

3. Field of the invention: what area does the invention relate to? For example, for a new accessory for a motor car you may write "this invention relates to motor cars, more specifically an accessory for a motor car".

4. Background of the invention: why is the invention necessary or useful, and what has it developed out of? Continuing with the motor car accessory example, it may be that your accessory is an improvement on a previously existing accessory. Here you can discuss why the improvement is needed. It is important to discuss some '**prior art**' here - patents that have already been filed by someone else relating to your idea. The background part may conclude with a short, crisp statement about the shortcomings of the prior art but this must be written in a manner that does not disclose the solution to be described later in the application. It should instead be written in a manner that makes the typical reader think:

How anyone could ever solve this problem!

It is advised don't spend too much time preparing the background. A good rule of thumb is no more than a maximum of two pages and/or no more than 10 percent of the total content of the application. To find relevant prior art it is advised to perform a patent search in patent databases and non Patent literature.

5. Detailed Description: How exactly does your invention work? Here you should describe in detail the exact components, systems,

methods and so on that make your invention work so that someone else skilled in the area would be able to reproduce it using your instructions. In drafting the detailed description part, avoid using phrases such as “the invention is...” instead of it use phrases like “in an embodiment of the invention.” This will ensure that patent claims receive the broadest interpretation possible. This part of the specification is generally presumed to disclose “an embodiment” of the invention rather than the invention itself.

Please note that an embodiment by definition is a manner in which an invention can be made, used, practiced or expressed.

6. Claims: precise legal statements in the form of single sentence that define the scope of your invention. Claims shall commence on a new sheet. The Patent application must end with one or more claims, at least one **independent claim** and other **dependent claims**. Usually begin with “I or We claim,” and should be sequentially numbered and be presented in order from broadest to narrowest.

It is advisable that one of the first things to do is to prepare the claims for the invention. If the claims are prepared before drafting the other parts of specification you will know better which terms need to be described in the specification.

Preamble or opening statement of the claim(s) must indicate whether a process or product feature of invention is claimed.

Example

I claim

1. A device, comprising:
a pencil; and
a light attached to the pencil.
2. The device as claimed in claim 1 wherein the light is detachably attached to the pencil.
3. The device as claimed in claim 2 wherein the pencil is made of wood.

7. Drawings: what does your invention look like? Patent application is required to contain drawings, if drawings are necessary to describe the invention especially product inventions other than chemicals. Drawing(s) should commence on separate sheet(s) and the minimum margins shall be as follows,-

Top 2.5 cm

Left side 2.5 cm

Right side 1.5 cm

Bottom 1.0 cm

Execute the drawings without coloring in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes to permit satisfactory reproduction. Flow sheets and diagrams are also considered as drawings for this purpose. Please write in the left-hand top corner of the drawing the name of the applicant and in the right-hand top corner the number of sheets or drawings and the words 'original' or 'true copy' as the case may require. Similarly in the right-hand bottom corner the signature of the applicant or his Agent is required. Please do not write the title of the invention or any descriptive matter on the drawings. Only numeral references may indicate different parts of diagram (For further details, please see Rule 11 of the Patent Rules 2003).

You have to mention reference to the drawing(s) in specification under the heading *Brief description of drawings* and further elaborate your invention with the help of drawings.

Preparation of Provisional Patent Specification:

Option for filing provisional specification is a quick and inexpensive way for inventors to establish a filing date for their in-process invention, which can be claimed later, by filing a complete specification within 12 months. You can file a provisional specification without many of the

formalities required for a complete specification. Provisional specification must include contents of complete specification but you may file claims and drawings later on, because provisional specifications are not examined in the Patent Office. An applicant who decides to initially file a provisional specification must file a corresponding complete specification during the 12-month from the filing date, failure to which the provisional specification will automatically abandoned after 12 months of its filing date. A complete specification is examined by a patent examiner. If your invention does not meet the prescribed requirements of patentability or if your application has other limitation, the patent examiner will send you an official communication which is generally referred as *Examination Report* informing you of any deficiencies. You then have the opportunity to respond and to remedy deficiencies. When all the requirements are met, the patent application proceeds for acceptance.

STEP 2

How to fill the Forms:

Please submit two (02) copies of duly filled in Application Forms which are as follows:-

For Non-Convention applications (application without priority)

- I. Duly filled in Form P-1 (in case when inventor is sole or joint applicant) **or** Form P-1A (in case when inventor or inventors is not a party to application and application is being filed by assignee or company / organization etc).
- II. Duly filled-in Form P-3A (in case of Complete Specification) **or** P-3 (in case of Provisional/Incomplete Specification). Please note that Form P-3/P-3A is the first page of the specification.
- III. Form P-28 for authorization of patent Attorney/Agent (if any).

- IV. For applicant being a student or employee of institution like University, Research institutes and organizations, a NO OBJECTION CERTIFICATE (NOC) from the respective department should be produced.

For Convention applications (application with priority)

Convention application means an application made in Pakistan within twelve months after the date of an application made in a Convention country, whether claiming single or multiple priorities from such application. Convention country means a member country of the World Trade Organization or a country declared as such under section 86.

- I. Duly filled in Form P-2 (in case when inventor is sole or joint applicant) **or** Form P-2A (in case when inventor or inventors is not a party to application).
- II. Duly filled in Form P-3A (complete specification)
- III. Form P-28 for authorization of patent Attorney/Agent.
- V. Priority document (if the document is in any other language then English translation verified by the affidavit should be provided)

It is recommended that an e-mail or telephone number of the applicant should also be given, in case of any concerns or questions regarding your documents.

Note: Instructions to fill the Forms is attached as Appendix-A.

STEP 3

How to pay the filing Fee:

The following filing fees are applicable in the form of **pay order or demand draft** from scheduled bank in favor of Director General, IPO-Pakistan:

- In case of complete specification Pak. Rs. 4500/- and in case of provisional specification Pak. Rs. 1350/-.
- For each additional page of specification beyond 40 pages Pak. Rs. 60/-
- For each additional claim beyond 20 claims Pak. Rs 150

Basic filing fee Rs 4500/- is acceptable for complete specification having 40 pages and 20 claims. You have to pay additional filing fee if specification exceeds 40 pages and claims are more than 20 as mentioned above.

Please note that filing fee is non refundable. List of all Patent Forms and Fees is available on IPO's website www.ipo.gov.pk

Checklist:

◇ Form P-1 or Form P-1A application without priority	02 copies
◇ Form P-2 or Form P-2A application with priority	02 copies
◇ Form P-3 or Form P-3A (for provisional or complete specification)	02 copies
◇ Patent Specification.....	02 copies
◇ Drawing(s), if any.....	02 copies
◇ Pay order or demand draft	01 original+01copy
◇ Form P-28 (power of Attorney) if any.....	01 original+01copy
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◇ Priority document (for convention application).....	01 copy
◇ NOC	01 copy

Patent application can be filed by mail or hand delivery on the following addresses:

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- *Incharge, IPO Regional Office, House No. 15, Block E-1, Shahre –e-Iman Hussain, Gulberg III (near Qadafi stadium) Lahore,*
 - *IPO HQs, 3rd Floor NTC building, sector G-5/2, Islamabad and*
 - *Controller of Patents, the Patent office, 2nd floor, Kandawala Building, M.A. Jinnah road, Karachi.*
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For the purpose of facilitating the applicants, IPO Pakistan other than the Patent Office, Karachi receives applications from two locations viz. IPO-HQs Islamabad and IPO Regional Office, Lahore. Application receiving counters stand closed at 03:00pm for facilitating further processing and no papers will be received after 03:00pm. Please note that you will get cash receipt if you file patent application in IPO-HQs, Islamabad and Regional Office, Lahore. Further correspondence with the applicant or agent shall be carried out by the Patent Office, Karachi.

Feedback if any:

This Guideline is prepared by the Patent desk (IPO-HQs) in collaboration with the Patent Office, Karachi. If you have any suggestions or feedback in relation to these Guidelines, please drop us an e-mail on patent@ipo.gov.pk and shakra.khurshid@ipo.gov.pk

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