

Patent Opposition Checklist (India)

Step-by-step checklist for filing pre-grant or post-grant patent opposition at the Indian Patent Office

HOW TO USE THIS TEMPLATE

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| 1. | This document: Patent Opposition Checklist (India). |
| 2. | Fill all bracketed fields before use. |
| 3. | Template only — not a substitute for qualified legal advice. |

1. OPPOSITION FUNDAMENTALS AND STRATEGY

Two Windows. Pre-grant opposition under Section 25(1) — filed by any person from publication of the application until grant. Post-grant opposition under Section 25(2) — filed within 12 months of the date of advertisement of grant, by any 'person interested'. The 12-month post-grant deadline is absolute and cannot be extended.

Grounds Available. Both pre-grant and post-grant share the same grounds: prior publication; prior claim in an earlier Indian application; prior public knowledge or use in India before the priority date; obviousness; non-patentable subject matter under Section 3 or Section 4; insufficient disclosure; wrongful obtaining; and ambiguity in claims.

Strategic Value. Opposition is one of the most cost-effective IP tools: it can cancel a competitor's patent before grant (pre-grant) or after grant (post-grant); narrow scope through forced claim amendments; delay competitor's enforcement ability; and establish a prior art record that limits future claim scope interpretations.

Prior Art Search Strategy. A strong opposition requires comprehensive prior art. Search simultaneously: Indian Patent Office database at ipindiaonline.gov.in; Google Patents (patents.google.com — covers 120+ jurisdictions); Espacenet (worldwide.espacenet.com); relevant academic papers, conference proceedings, technical manuals, and product datasheets published before the priority date. Document each reference with its exact publication date, source URL or publication details, and the specific passage relevant to each claim element.

2. CLAIM CHART PREPARATION

The Claim Chart Is the Centrepiece. Map each element of the patent's independent claims to prior art. For each claim element: identify the prior art document disclosing it; note the exact passage or figure number; assess whether the element is anticipated (disclosed identically) or rendered obvious (disclosed in combination with other prior art). A prior art reference that anticipates every element of Claim 1 (the broadest independent claim) is the strongest single-document opposition.

Obviousness Analysis. If no single document anticipates the claim, analyse whether the claimed invention would have been obvious to a person skilled in the art based on a combination of prior art. The key questions: (a) does each reference teach the relevant element?; (b) would a skilled person have been motivated to combine these references?; and (c) would combining them lead predictably to the claimed invention? Use the KSR framework — if the combination involves only known elements with predictable results, obviousness is strong.

Section 3 Non-Patentable Subject Matter. If the patent covers subject matter excluded under Section 3 — including computer programmes per se and mathematical methods (Section 3(k)); business methods (Section 3(k)); traditional knowledge (Section 3(p)); or new forms of a known substance without enhanced efficacy (Section

3(d)) — this is a powerful ground independent of prior art. Section 3 challenges have succeeded in landmark cases including *Novartis v Union of India*.

Expert Declaration. For technically complex matters, an expert declaration from a qualified person in the relevant field (professor, senior engineer, industry expert) significantly strengthens the opposition. The expert should confirm: the technical meaning of key claim terms as understood by a person skilled in the art; that the claimed invention was anticipated or obvious from the cited prior art; and any specific technical evidence supporting the opposition arguments.

3. FILING PROCEDURES AND AFTER

Forms and Fees (startup rates). Pre-grant: Form 7 (Notice of Opposition) — Rs. 1,500. Post-grant: Form 7A (Notice of Opposition with Statement and Evidence) — Rs. 3,000. File online at ipindiaonline.gov.in. Power of Attorney Form 26 required if filed through an attorney.

After Filing — Timeline. (a) Controller transmits copy of opposition to applicant/patentee; (b) applicant/patentee has 2 months to file reply statement with evidence; (c) opponent may file evidence in rejoinder within 1 month of reply; (d) hearing scheduled; (e) Controller issues written decision. Full process: 6–24 months. Budget Rs. 1,50,000–5,00,000 for a contested opposition including attorney fees.

Pre-Grant Monitor Protocol. For competitor patent applications identified as threats: (a) set IPO Journal alerts for the application number; (b) diary the publication date and calculate the opposition window carefully — the window opens on the publication date and closes on the grant date (no fixed end date for pre-grant); (c) the grant can happen at any time — monitor the IPO Journal weekly for the grant of concern.

Post-Grant Deadline Protection. File a caveat (no official form — submit a letter to the relevant Patent Office branch) requesting to be notified before any order affecting the patent is made. This supplements the 12-month post-grant opposition window with additional protection. Also set a calendar alert immediately when a competitor's patent appears in the IPO Gazette as 'granted'.

4. OPPOSITION FILING CHECKLIST

Pre-filing — confirm all items complete:

- Patent application publication number confirmed; IPO database status checked
- All prior art references compiled, numbered, and certified true copies prepared
- Claim chart completed — all independent claims mapped to prior art
- Statement of Opposition drafted — all grounds stated with full particulars
- Expert declaration obtained if technical complexity warrants
- Power of Attorney (Form 26) signed if filing through attorney
- Form 7 (pre-grant) or Form 7A (post-grant) completed
- Filing fee paid; receipt obtained
- Copy of opposition with exhibits served on patentee / applicant
- Calendar alert set for patentee's 2-month reply deadline
- Budget approved for full prosecution of the opposition

IMPORTANT NOTE

Working template for Patent Opposition Checklist (India). Verify requirements with a qualified IP advocate before use.

ADVANCED OPPOSITION STRATEGY

Monitoring Competitor Applications Systematically. Set up a structured watch programme for competitor patent applications at the Indian Patent Office. Subscribe to IPO Journal alerts for technology classification codes (IPC codes) relevant to your product space. Review new publications weekly to identify applications that threaten your freedom to operate or directly cover your existing products. The time from publication to grant can be as short as 6 months for applications on the expedited track — so monitoring must be continuous.

Coordinating Opposition With FTO Analysis. Your freedom-to-operate analysis should include a live monitoring component that flags newly published applications in your technology space. When the FTO identifies a threatening published application: (a) assess the claim scope against your products; (b) conduct a targeted prior art search for that specific application; (c) make a go or no-go decision on filing a pre-grant opposition; and (d) brief the IP committee on the decision and rationale. A well-run FTO programme converts into a pre-grant opposition pipeline.

Building a Prior Art Library. Proactively build and maintain a prior art library for your key technology areas: collect and organise academic papers, conference proceedings, technical manuals, and product datasheets by publication date and technology topic; index key disclosures with their publication dates and technical content; and maintain this library as a resource for opposition proceedings, FTO analyses, and your own patent prosecution. The prior art library pays dividends in every opposition and prosecution proceeding.

Post-Opposition Monitoring. A successful opposition that results in the patent being refused or claims being narrowed does not mean the threat is over. The applicant may: file a divisional application covering related technology; amend and re-file with a different claim set; or file new applications covering design-arounds to their original application. Continue monitoring the applicant's patent filings after a successful opposition to prevent a flanking strategy.

Opposition as a Negotiation Lever. A pending opposition creates commercial leverage. Many opposition disputes are resolved through: a licence from the patentee on favourable terms; a cross-licence exchanging access to each party's technology; a technology collaboration agreement; or a settlement payment. When an opposition is filed, prepare a licensing term sheet that you could use to settle on acceptable terms if the patentee approaches you. Opposition as leverage is a legitimate and frequently used commercial strategy.

INDIAN PATENT OFFICE — OPERATIONS AND BEST PRACTICES

The Indian Patent Office processes approximately 50,000 applications annually, with technology and pharmaceutical applications dominating filings. Understanding the IPO's examination guidelines and the specific examiners assigned to your technology area can meaningfully improve prosecution outcomes. Examination is conducted by technical examiners with engineering or science backgrounds — drafting

claims with technical precision and providing detailed technical rebuttals to objections is more effective than purely legal arguments. Each First Examination Report (FER) must be responded to within 6 months from issuance, extendable to 9 months on request with a fee. Extensions must be applied for before the original deadline expires. A failure to respond within the extended period results in th

e application being deemed to have been abandoned. On receiving a FER: read every objection carefully; prepare a technical rebuttal addressing each objection specifically; consider whether claim amendments are appropriate to distinguish the prior art cited; and brief your patent advocate fully on the technical distinctions between your invention and the cited prior art. The prosecution history of

a patent — all FERs and responses — is part of the public record and becomes relevant in infringement and invalidity proceedings (prosecution history estoppel). Avoid making admissions in FER responses that unnecessarily limit claim scope. For international applications filed through PCT and entering the Indian national phase, be aware that the PCT international search report and written opinion a

re considered during Indian examination. A positive PCT search report (where the ISA found no relevant prior art) facilitates Indian examination. A negative PCT search report does not prevent grant in India but requires specific technical arguments distinguishing the cited references.