



**THE INSTITUTE OF
Company Secretaries of India**

भारतीय कम्पनी सचिव संस्थान

IN PURSUIT OF PROFESSIONAL EXCELLENCE

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SUPPLEMENT PROFESSIONAL PROGRAMME

INTELLECTUAL PROPERTY RIGHTS –LAWS AND PRACTICES

(Supplement Covers Amendments / Developments from December 01,2022 to November May 31, 2023)

MODULE 3

PAPER 9.3

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Lesson – 5
INDIAN PATENT LAW

THE PATENTS (AMENDMENT) RULES, 2021

The Central Government published the amended rules on 21st September, 2021 which are based on the objections and the suggestions received from the public in respect of the amended draft rules as issued on 09th February, 2021.

The **first Amendment** states that the changes in **The Patents (Amendment) Rules, 2021** shall come into force from the date of its publication in the Official Gazette.

The **second amendment** states that in the Patents Rules, 2003 (hereinafter referred to as the principal rules), in rule 2, after sub-rule (c), the following shall be inserted, namely:-

“(ca) “educational institution” means a university established or incorporated by or under Central Act, a Provincial Act, or a State Act, and includes any other educational institution as recognised by an authority designated by the Central Government or the State Government or the Union territories in this regard;”.

The **third amendment** states that in the principal rules, in rule 7,-
(i) in sub-rule (1), for the second proviso, the following proviso shall be substituted, namely:-

“Provided further that in the case of a small entity, or startup, or educational institution, every document for which a fee has been specified shall be accompanied by Form-28.”;

(ii) for sub-rule (3), the following sub-rule shall be substituted, namely:-

“(3) In case an application processed by a natural person, startup, small entity or educational institution is fully or partly transferred to a person other than a natural person, startup, small entity or educational institution, the difference, if any, in the scale of fees between the fees charged from the natural person, startup, small entity or educational institution and the fees chargeable from the person other than a natural person, startup, small entity or educational institution, shall be paid by the new applicant along with the request for transfer.”.

The **fourth amendment** states that the principal rules, in the FIRST SCHEDULE, in Table 1, for the headings and sub-headings,

Number of Entry	On what payable	Number of the relevant Form	For e-filing		For physical filing	
			Natural person(s) or Startup(s) or Small entit(y)/(ies)	Other(s), alone or with natural person(s) or Startup(s) or Small entit(y)/(ies)	Natural person(s) or Startup(s) or Small entit(y)/(ies)	Other(s), alone or with natural person(s) or Startup(s) or Small entit(y)/(ies)

the following headings and sub-headings shall be substituted, namely:—

Number of Entry	On what payable	Number of the relevant Form	For e-filing		For physical filing	
			Natural person(s) or Startup(s) or Small entit(y)/(ies) or educational institution(s)	Other(s), alone or with natural person(s) or Startup(s) or Small entit(y)/(ies) or educational institution(s)	Natural person(s) or Startup(s) or Small entit(y)/(ies) or educational institution(s)	Other(s), alone or with natural person(s) or Startup(s) or Small entit(y)/(ies) or educational institution(s)

The **fifth amendment** states that in principal rules, in the SECOND SCHEDULE, for Form 28 the following form shall be substituted, namely:-

<p>FORM 28</p> <p>THE PATENTS ACT, 1970</p> <p>(39 of 1970)</p> <p>AND</p> <p>THE PATENTS RULES, 2003</p> <p>TO BE SUBMITTED BY A SMALL ENTITY /STARTUP/EDUCATIONAL INSTITUTION</p> <p>[See rules 2 (fa), 2(fb), 2(ca) and 7]</p>		
1	Insert name, address and nationality.	<p>I/We.....</p> <p>applicant/patentee in respect of the patent application no. or patent no.....hereby declare that I/we am/are a small entity in accordance with rule 2(fa) or a startup in accordance with rule 2(fb) or an educational institution</p> <p style="text-align: center;">i</p> <p>n accordance with rule 2(ca) and submit the following document(s) as proof:</p>

2	Documents to be submitted	
	i. For claiming the status of a small entity:	
	A. For an Indian applicant: Evidence of registration under the Micro, Small and Medium Enterprises Development Act, 2006(27 of 2006).	
	B. In case of a foreign entity: Any other document.	
	ii. For claiming the status of a startup	
	A. For an Indian applicant: Any document as evidence of eligibility, as defined in rule 2(fb).	
	B. In case of a foreign entity: Any other document.	
	iii For claiming the status of an educational institution	
	A. For an Indian applicant: Any document as evidence of eligibility, as defined in rule 2(ca).	
	B. In case of a foreign educational institution: Any other document.	
3	To be signed by the applicant(s) /patentee(s)/authorized registered patent agent.	The information provided herein is correct to the best of my/our knowledge and belief. Dated this ... day of..... ..20
4	Name of the natural person who has signed.	Signature.....

For further details, refer-

https://ipindia.gov.in/writereaddata/Portal/Images/pdf/Patents_Amendment_Rules_2021.pdf

Lesson -12
COPYRIGHTS

COPYRIGHT (AMENDMENT) RULES, 2021

The Central Government hereby makes the following rules, further to amend the Copyright Rules, 2013, namely:-

The **first Amendment** states that the changes in **Copyright (Amendment) Rules, 2021** shall come into force from the date of its publication in the Official Gazette.

The **second amendment** states that in the Copyright Rules, 2013 (herein after referred to as the principal rules) in rule 2, in sub-rule (1),-

(i) in clause (b) for the words “a Copyright Board as defined in sub-section (1) of ” the words “the Appellate Board as provided in” shall be substituted;

(ii) after clause (d), the following shall be inserted, namely: -

“(da) “journal” means the Copyright Journal, made available at the official website of the Copyright Office;”.

The **third amendment** states that in the principal rules, in Chapter II, for the title “THE COPYRIGHT BOARD” the title “THE APPELLATE BOARD” shall be substituted.

The **fourth amendment** states that in the principal rules for the rule 3, the following rule shall be substituted, namely:-

“3. Appellate Board.-The Chairman and other members of the Board shall be appointed as per the provisions of the Trade Marks Act, 1999;

Provided that the Technical Member of the Board for the purposes of the Act shall have the qualifications as specified in the Tribunal, Appellate Tribunal and other Authorities (Qualifications, Experience and other Conditions of Service of Members) Rules, 2020”.

The **fifth amendment** states that in the principal rules , in rule 7,-

(i) in sub-rule(1), after the words “the owner of the copyright”, the words “through electronic means or” shall be inserted;

(ii) in sub-rule (5), for the words “notified in the Official Gazette”, the words “published in journal” shall be substituted.

The **sixth amendment** states that in the principal rules, in rule 11,-

(I) in sub rule (4), for the words “Register of Copyrights”, the words “Registrar of Copyrights” shall be substituted;

(ii) in sub-rule (6), for the words “notified in the Official Gazette and”, the words “published in journal” shall be substituted.

The **seventh amendment** states that in the principal rules, in rule 16, for the words “if decides to make a request”, the words “as required” shall be substituted.

The **eighth amendment** states that in the principal rules, in rule 18,-

(i) in sub-rule (1), after the words “shall be served” on both places where they occur, the words “through electronic means or” shall be inserted;

(ii) in sub-rule (5), for the words “notified in the Official Gazette”, the words “published in journal” shall be substituted.

The **ninth amendment** states that in the principal rules, in rule 19, for the words “Copyright Board”, on both the places where they occur, the word “Board” shall be substituted.

The **tenth amendment** states that in the principal rules, in rule 23, in sub-rule (1), in second proviso, for the words “Official Gazette”, the word “journal” shall be substituted.

The **eleventh amendment** states that in the principal rules, in rule 27, in sub-rule (2), for the words “Official Gazette”, the word “journal” shall be substituted.

The **twelfth amendment** states that in the principal rules, in rule 29, in sub-rule (1), in the last proviso, for the words “Official Gazette”, the word “journal” shall be substituted.

The **thirteenth amendment** states that in the principal rules, in rule 31,-

- (i) In sub-rule(1), the words “immediately after its constitution” shall be omitted;
- (ii) in sub rule (2), for the words “Official Gazette”, the word “journal” shall be substituted;
- (iii) in sub-rule (3), for the words “public notice”, the words “such notice” shall be substituted.

The **fourteenth amendment** states that in the principal rules, in rule 33, in sub-rule(1), for the words “Official Gazette”, the word “journal” shall be substituted.

The **fifteenth amendment** states that in the principal rules, in rule 34,-

- (i) in sub-rule(1), for the words “Official Gazette”, the word “journal” shall be substituted;
- (ii) in sub-rule (3), for the words “Official Gazette”, the word “journal” shall be substituted;
- (iii) in sub-rule (6), for the words “notified in the Official Gazette” the words “published in journal” shall be substituted.

The **sixteenth amendment** states that in the principal rules, in rule 39,-

- (i) in sub-rule(1), after the words “application shall be served”, the words “through electronic means or” shall be inserted;
- (ii) in sub-rule (5), for the words “notified in the Official Gazette”, the words “published in journal” shall be substituted.

The **seventeenth amendment** states that in the principal rules, in rule 49, in sub-rule (1) ,for the words “sixty days”, the word “one hundred and eighty days” shall be substituted.

The **eighteenth amendment** states that in the principal rules, in rule 50, in sub-rule(2),in clause(a), the words “not below the rank of Deputy Secretary to the Government of India” shall be omitted.

The **nineteenth amendment** states that in the principal rules, in rule 55,-

- (i) in sub-rule(2), for the words and figures, “rule 71” the words and figures “rule 67” shall be substituted;

(ii) after sub-rule (2),the following sub-rule shall be inserted, namely:-

“(3) The copyright society in relation to collection of royalty under sub-rule (1) and distribution of royalty under sub-rule (2) of this rule, shall create a system of payment through electronic modes and shall establish a system through which the payments so made are traceable.”

The **twentieth amendment** states that in the principal rules, in rule 56, in sub-rule(1), after the word “frame” the words “and publish” shall be inserted.

The **twenty first amendment** states that in the principal rules, in rule 58, after sub-rule(10), the following sub-rules shall be inserted, namely: –

“(11) A copyright society must ensure that where the royalty cannot be distributed within the time specified in sub-rule (8) as the relevant author or other owner could not be identified or located; such royalties are kept separate in the accounts of the copyright society.

(12) A copyright society must take all necessary measures to identify and locate the authors and other owners and must publish on its website, at the end of every quarter, the following information:

(a) the title of the work;

(b) the name of the author and other right owners of the work, as available; and

(c) any other relevant information available which could assist in identifying the right holder.

(13) In case the royalty due to author and other owners remains undistributed at the end of the period of three years from the end of the financial year in which collection of the royalty occurred, the copyright society shall transfer such amount to the welfare fund of the copyright society.”

The **twenty second amendment** states that in the principal rules, in rule 59, for sub-rule (7), the following sub-rule shall be substituted, namely:-

“(7) The Chairman and other members of the Governing Council shall be elected for a term of two years and shall be eligible for re-election”.

The **twenty third amendment** states that in the principal rules, in rule 62, after clause (viii), the following new clause shall be inserted, namely:-

“(ix) The annual transparency report as provided under rule 65A”.

The **twenty fourth amendment** states that in the principal rules, in rule 64, after the words “maintain the following registers” the words “in physical or digital format,” shall be inserted.

The **twenty fifth amendment** states that in the principal rules,-

(i) in rule 65, after clause(vii),the following new clause shall be inserted, namely:- “(viii) The annual transparency report as provided under Rule 65A.”;

(ii) after rule 65, the following new rule shall be inserted, namely:

“65A. Annual transparency report. —(1) The copyright society must draw up and make public a special report to be referred to as the annual transparency report for each financial year within six months following the end of that financial year. The copyright society shall publish on its website the annual transparency report and ensure that the annual transparency report remains available on its website for at least three years.

- (2) The annual transparency report must contain the following information, namely:—
- (a) report on the activities in the financial year;
 - (b) number of refusals to grant a licence;
 - (c) financial information on total royalties collected;
 - (d) the total royalties paid to author and other owners;
 - (e) the total royalties collected but not yet attributed to author and other owners;
 - (f) the total administrative deductions made from royalty collected;
 - (g) the details and use of the amounts deducted for the activities conducted under the welfare scheme as provided under rule 67; and
 - (h) Information on amounts received from and paid to the foreign societies or organisation”.

The **twenty sixth amendment** states that in the principal rules, in rule 66, in sub-rule (1), after clause(l), the following new clauses shall be inserted, namely:—

- “(m) the facility to search from the database of works forming part of the repertoire of the copyright society;
- (n) the annual transparency report as approved by the General Body; and
 - (o) the details of the undistributed royalties on account of the work belonging to authors and other owners who could not be identified or located”.

The **twenty seventh amendment** states that in the principal rules, in rule 69, in sub-rule (1),-

- (i) for the words, “physical and electronic”, the words “physical or electronic” shall be substituted;
- (ii) in Part VI, the words “tables and compilations including computer databases” shall be omitted.

The **twenty eighth amendment** states that in the principal rules, in rule 70, in sub-rule(5), for the words “the source and object code”, the words “at least first 10 and last 10 pages of source code, or the entire source code if less than 20 pages, with no blocked out or redacted portions”, shall be substituted.

The **twenty ninth amendment** states that in the principal rules, in rule 72,-

- (i) in sub-rule(1), for the words “both in physical and electronic”, the word “in physical or electronic” shall be substituted;
- (ii) sub-rule (2) shall be omitted.

The **thirtieth amendment** states that in the principal rules, CHAPTER XVI, shall be omitted.

The **thirty first amendment** states that in the principal rules, for rule 82, the following rule shall be substituted, namely:-

“82. Mode of Communication by the Copyright Office, etc.— Every written intimation from the Board, the Copyright Office or the Registrar of Copyrights shall be deemed to have been duly

communicated to any person if such intimation is sent to the known address of such person through electronic means or by registered post.”

The **thirty second amendment** states that in the principal rules, for rule 83 the following rule shall be substituted, namely:-

“83. Fees.- (1) The fees to be paid in respect of applications or any other matters under the Act and the rules shall be those as specified in the Second Schedule.

(2) Where in respect of any matter, a fee is required to be paid under the rules, the form or the application or the request of the petition thereof, it shall be accompanied by the prescribed fee.

(3) Fees may be paid electronically or by demand draft or Banker's Cheque in favour of the Registrar of Copyrights drawn on a scheduled bank at New Delhi.

(4) Where a fee is payable in respect of filing of a document and where the document is filed without such fee or with insufficient fee, such document shall be deemed not to have been filed for the purposes of any proceedings under these rules.

(5) No fee is required to be paid for taking extracts from Register of Copyrights or indexes for official purposes by the Central Government or the State Government.

The **thirty third amendment** states that in the principal rules, in the First Schedule,-

(i) in FORMS II, III, V, VI and VII,-

(a) the words and punctuation “Registrar of Copyrights/”, wherever they occur, shall be omitted;

(b) for the words “Copyright Board” wherever they occur, the words “Appellate Board” shall be substituted;

(c) the words “Copyright Office” wherever they occur, shall be omitted;

(ii) in Form XIV, for the words and figures "the Copyright Rules, 2012", the words and figures, "the Copyright Rules, 2013", shall be substituted.

The **thirty fourth amendment** states that in the principal rules, in SECOND SCHEDULE, in serial number 9, in clause (b),-

(i) the word “Literary or” shall be omitted;

(ii) after the word “goods”, the words “or services” shall be inserted.

The **thirty fifth amendment** states that in the principal rules, in SECOND SCHEDULE, in serial number 10, in clause (b),-

(i) the word “Literary or” shall be omitted;

(ii) after the word “goods”, the words “or services” shall be inserted.

The **thirty sixth amendment** states that in the principal rules, in SECOND SCHEDULE, serial number 19 and the entries relating thereto shall be omitted.

For further details, refer- <https://copyright.gov.in/Documents/Notification/Copyright-Rules Amendment 2021.pdf>

Lesson 13
INDUSTRIAL DESIGNS

DESIGNS (AMENDMENT) RULES, 2021

The **first Amendment** states that the changes in **Designs (Amendment) Rules, 2021** shall come into force from the date of its publication in the Official Gazette.

The **second amendment** states that in rule 2 of the Designs Rules 2001, (hereinafter referred to as the principal rules), after clause (ea), the following clause shall be inserted, namely:-

‘(eb) “startup” means-

‘(a) an entity in India recognised as a startup by the competent authority under Startup India initiative; and

(b) in case of a foreign entity, an entity fulfilling the criteria for turnover and period of incorporation or registration as per Startup India Initiative and submitting declaration to that effect. Explanation: In calculating the turnover, reference rates of foreign currency of the Reserve Bank of India shall prevail.’

The **third amendment** states that in rule 4 of the principal rules, for the proviso, the following proviso shall be substituted, namely:-

“Provided that such address for service shall include e-mail address and mobile number registered in India, of the agent or applicant”.

The **fourth amendment** states that in rule 5 of the principal rules, in sub-rule (2),

(i) for the clause (e), the following clause shall be substituted, namely:-

“(e) In case an application processed by a natural person and/ or startup and/ or small entity is fully or partly transferred to a person other than a natural person, startup or small entity, the difference, if any, in the scale of fees between the fees charged from the natural person, startup or small entity and the fees chargeable from the person other than a natural person, startup or small entity in the same matter, shall be paid by the new applicant with the request for transfer.”:

(ii) clause (f) shall be omitted. (iii) after sub-rule (e), the following explanation shall be inserted namely:- “Explanation--Where a startup or small entity, having filed an application for a design, ceases to be a startup or small entity due to the lapse of the period during which it is recognised by the competent authority, or its turnover subsequently crosses the financial threshold limit as notified by the competent authority, no such difference in the scale of fees shall be payable”.

The **fifth amendment** states that in rule 10 of the principal rules, for the sub-rule (1) the following sub-rule shall be substituted, namely:-

For the purposes of the registration of designs and of these rules, articles shall be classified as per current edition of “International Classification for Industrial Designs (Locarno Classification)” published by World Intellectual Property Organization (WIPO):” Provided that registration of any design would be subject to the fulfillment of provisions of the Act specifically 2(a) and 2(d).

The **sixth amendment** states that in the principal rules, for the FIRST SCHEDULE the following Schedule shall be substituted the same can be referred from:

https://ipindia.gov.in/writereaddata/Portal/Images/pdf/The_Designs_amendment__Rules_2021.pdf

The **seventh amendment** states that in principal rules, in the SECOND SCHEDULE- (i) for the Form No.1 titled Application for Registration of Designs (See Sections 5 and 44) shall be substituted. The form can be referred from-

https://ipindia.gov.in/writereaddata/Portal/Images/pdf/The_Designs_amendment__Rules_2021.pdf

* Strike out the words if no previous registration or priority claim has been effected”.

(ii) Form 24 shall be substituted, the form can be referred from-

https://ipindia.gov.in/writereaddata/Portal/Images/pdf/The_Designs_amendment__Rules_2021.pdf

Note:

1. Availing of benefit of reduction in fee on the basis of incorrect information/misrepresentation of facts with regard to status as a small entity or startup would mean that the entire fee did not accompany the document, as mandated by rule 5(2)(b). In such a case, in accordance with section 24(2), the filing of the document shall be of no effect unless the fee has been fully paid.

2. A registered design entered into the Register of designs by making any false suggestion or false representation as to the status as small entity or startup may attract the provisions of section 31 of the Designs Act, 2000”

The **eighth amendment** states that in the principal rules, THIRD SCHEDULE shall be omitted.

The **ninth amendment** states that in the principal rules, for the FOURTH SCHEDULE the following S c h e d u l e shall be substituted, the same can be referred from:

https://ipindia.gov.in/writereaddata/Portal/Images/pdf/The_Designs_amendment_Rules_2021.pdf

For further details, refer-

https://ipindia.gov.in/writereaddata/Portal/Images/pdf/The_Designs_amendment_Rules_2021.pdf