



**THE INSTITUTE OF
Company Secretaries of India**

भारतीय कम्पनी सचिव संस्थान

IN PURSUIT OF PROFESSIONAL EXCELLENCE

Statutory body under an Act of Parliament

(Under the jurisdiction of Ministry of Corporate Affairs)

SUPPLEMENT PROFESSIONAL PROGRAMME

INTELLECTUAL PROPERTY RIGHTS –LAWS AND PRACTICES

(Supplement Covers Amendments / Developments from August 2021 to November 2022)

MODULE 3

PAPER 9.3

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LESSON 5
INDIAN PATENT LAW

The Patents (Amendment) Rules, 2019

The Central Government published the amended rules on 17th September 2019 which are based on the objections and the suggestions received from the public in respect of the amended draft rules as issued on 5th December 2018.

1. The first Amendment states that the changes in **The Patents (Amendment) Rules, 2019** shall come into force from the date of its publication in the Official Gazette.

2. The second Amendment states changes in Rule 6 sub-rule (1), that is ;

In the former rule, the scanned copies of original documents were also required to be submitted by electronic transmission, whereas in the amended rule the requirement of scanned copies of original document has been omitted.

3. The third Amendment states changes in rule 7 sub-rule (1), that is ;

In the amended rule, the second proviso widens the scope by including startups as an option for small entities, whereas the former rule mentioned only small entities.

4. The fourth Amendment states changes in clause (b), sub-rule (1) of rule 24C of the former amended draft (Dec 2018), that is;

In the amended rule (2019), clause (b) has been further revised with the following clauses along with the Explanations;

"(b) that the applicant is a startup; or

(c) that the applicant is a small entity; or

(d) that if the applicant is a natural person or in the case of joint applicants, all the applicants are natural persons, then the applicant or at least one of the applicants is a female; or

(e) that the applicant is a department of the Government; or

(f) that the applicant is an institution established by a Central, Provincial or State Act, which is owned or controlled by the Government; or

(g) that the applicant is a Government company as defined in clause (45) of section 2 of the Companies Act, 2013 (18 of 2013); or

(h) that the applicant is an institution wholly or substantially financed by the Government"

Explanation: For the purpose of this clause, the term 'substantially financed' shall have the same meaning as in the Explanation to sub-section (1) of section 14 of the Comptroller and Auditor General's (Duties, Powers and Conditions of Service) Act, 1971(56 of 1971); or

(i) that the application pertains to a sector which is notified by the Central Government on the basis of a request from the head of a department of the Central Government: Provided that public comments are invited before any such notification; or

(j) that the applicant is eligible under an arrangement for processing a patent application pursuant to an agreement between Indian Patent Office and a foreign Patent Office.

Explanation: The patentability of patent applications filed under clause (j) above will be in accordance with the relevant provisions of the Act."

5. The fifth Amendment states changes in the FIRST SCHEDULE with respect to the PCT International Application, which are as below:

(a) The following row has been inserted which mentions that no transmittal fee is payable for the international application:

"48 A	Transmittal fee for International application (for ePCT filing).	-	No fee	No fee	No fee	Not applicable	Not applicable	Not applicable"
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(b) The following row has been inserted to clarify that the Applicant is not required to pay a fees for preparation of certified priority document copy any more:

"49 A	For preparation of certified copy of priority document and e- transmission through WIPO DAS.	-	No fee	No fee	No fee	Not applicable	Not applicable	Not applicable"
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(A column has been inserted in the rows by "Number of the relevant form" keeping it blank, which was not mentioned in the former amended draft rules).

6. The sixth Amendment states changes in the SECOND SCHEDULE Form 18A which are:

(a) Paragraph 3 has been substituted with clauses as per sub-rule 1, Rule 24C which lists **the grounds applicable/available to the applicants who wish to request for an expedited examination.**

(b) Paragraph 4 has been added which lists **the Documents that are to be mandatorily submitted as evidence of eligibility for availing expedited examination.**

1. Patents (Amendment) Rules, 2020

According to the Patent (Amendment) Rules 2020, Rule 21 of the Patents Rules, 2003 reads as under:

21. Filing of priority document –

(1) Where the applicant in respect of an international application designating India has not complied with the requirements of paragraphs (a), (b) or (b-bis) of rule 17.1 of the regulations under the Patent Cooperation Treaty, and subject to paragraph (d) of the said rule 17.1 of regulations under the Treaty, the applicant shall file the priority document referred to in that rule before the expiration of the time limit referred to in sub-rule (4) of rule 20 in the Patent Office.

(2) Where sub-paragraph (i) or sub-paragraph (ii) of paragraph (e) of rule 51bis.1 of the regulations under the Patent Cooperation Treaty is applicable, an English translation thereof duly verified by the applicant or the person duly authorised by him shall be filed within the time limit specified in sub-rule (4) of rule 20.

(3) Where the applicant does not comply with the requirements of sub-rule (1) or sub-rule (2), the Patent Office shall invite the applicant to file the priority document or the translation thereof, as the case may be, within three months from the date of such invitation, and if the applicant fails to do so, the claim of the applicant for the priority shall be disregarded for the purposes of the Act.”

Further, Rule 131(2) read as under:

“(2) The statements referred to in sub-rule (1) shall be furnished once in respect of every financial year, starting from the financial year commencing immediately after the financial year in which the patent was granted, and shall be furnished within six months from the expiry of each such financial year.”

The Patents (Amendment) Rules, 2020, have further streamlined the requirements related to filing of Form 27 and submission of verified English translation of priority documents, which is not in English language.

Impact: If the priority document is available in WIPO's digital library, the applicant would not be required to submit the same in the Indian Patent Office. Applicant would be required to submit verified English translation of a priority document, where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable or not.

For Details:

https://ipindia.gov.in/writereaddata/Portal/Images/pdf/patents_amendment_rules_2020.pdf

2. Patents (2nd Amendment) Rules, 2020

According to the Patents (2nd Amendment) Rules, 2020, Rule 3(3) of the Patents Rules, 2003 reads as under:

In case an application processed by a natural person or startup 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.

Explanation— Where a startup or small entity, having filed an application for a patent, ceases to be a startup or small entity due to the lapse of the period during which it is recognized 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.

Impact: The fees applicable to small entities for filing patent applications have been reduced and made at par with those of natural persons / start-ups.

For Details:

https://ipindia.gov.in/writereaddata/Portal/Images/pdf/Patents_2nd_Amendment_Rules_2020.pdf
