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भारतीय कम्पनी सचिव संस्थान

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for

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INTELLECTUAL PROPERTY RIGHTS – LAWS AND PRACTICES

MODULE 3

PAPER 9.3

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LESSON 5

INDIAN PATENT LAW

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
