



**THE INSTITUTE OF
Company Secretaries of India**

भारतीय कम्पनी सचिव संस्थान

IN PURSUIT OF PROFESSIONAL EXCELLENCE

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SUPPLEMENT FOR JUNE, 2020 EXAMINATION

PROFESSIONAL PROGRAMME

INTELLECTUAL PROPERTY RIGHTS- LAWS AND PRACTICES

MODULE 3

PAPER 9.3

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Lesson 5

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(Dec2018), that is;

In the amended rule(2019), clause (b) has been further revised with the followings 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.**