

## DRAFT PATENT (AMENDMENT) RULES, 2018: A STEP AHEAD?

### 1. INTRODUCTION

The first week of December witnessed a rather significant intellectual property development, benefitting particularly small-sized patent applicants in India. On 4<sup>th</sup> December 2018, the draft Patent (Amendment) Rules, 2018 (the “**Draft Rules**”) were published by the Department of Industrial Policy and Promotion of the Ministry of Commerce and Industry for comments and feedback from the general public and relevant members.

### 2. KEY FEATURES OF THE DRAFT RULES

The key features of the Draft Rules are discussed below.

#### 2.1 International Applications under the Patent Co-operation Treaty

Should the Draft Rules come into effect, all documents including scanned copies relating to Patent Co-operation Treaty (“**PCT**”) applications will be required to be submitted only by way of electronic transmission. Moreover, the original documents will have to be submitted within 15 days from the date of submission of the scanned copies.<sup>1</sup>

The requirement of paying the transmittal fee for an international application as well as the fee with respect to the preparation of certified copies of priority documents and e-transmission through WIPO’s software (which were payable to the Indian Patent Office along with the filing fees towards PCT applications) has been done away with.<sup>2</sup>

#### 2.2 Prosecution of Indian Applications

The existing rule<sup>3</sup> on *expedited examination*, which kept the facility available for *start-ups* and PCT applicants who choose the Indian Patent Office as the International Search or Examining Authority, has been substituted.

Now applicants *eligible to file* a request for *expedited examination* will include a small entity; a female applicant or at least one of the applicants being a female (*in case of natural persons only*); a government undertaking; and applicants from countries who have entered into a Patent Prosecution Highway agreement with the Indian Patent Office.

The existing rule, that a request for expedited examination can be dealt with like a request for regular *examination*, if the request *does not comply* with the requirements of the rule, has been amended.

<sup>1</sup> Insertion of a ‘Proviso’ to Rule 18(2) of the principle Patent Rules, 2003

<sup>2</sup> Insertion of Entries 48A and 49A in the First Schedule of the principle Patent Rules, 2003

<sup>3</sup> Rule 24C (1)(b) of the principle Patent Rules, 2003

Now if the requirements of the rule on *expedited examination* are not complied with in a *request for expedited examination* initially, but such requirements are complied with prior to the issuance of the First Examination Report, then the *request for expedited examination* will be considered as such.<sup>4</sup>

### 2.3 Pre-grant Oppositions

A bench comprising of 2 members will be constituted for hearing pre-grant opposition cases. If there is a deadlock, then a third member shall be nominated by the Controller, and the decision of the majority shall be final.<sup>5</sup>

## 3. INDUSLAW VIEW

The removal of the payment of *transmittal fees* and *fees toward obtaining priority documents* for use in PCT applications, charged by the Indian Patent Office, will remove an additional and rather unnecessary expense incurred by PCT applicants from India.

In addition to *start-ups* getting the facility of *expedited examination* of patent applications, the facility will also be available for small enterprises and female applicants, notably. This amendment is with a view to *foster innovation* and *patent filing* by small and medium sized innovators and entrepreneurs, and particularly *women innovators and entrepreneurs*.

The proposed amendments are a positive way ahead to promote PCT applications originating from India and also easing the process of patent registration in India.

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<sup>4</sup> Insertion of a 'Proviso' to Rule 24-C (4) of the principle Patent Rules, 2003

<sup>5</sup> Insertion of new Rule 55(2A) in the principle Patent Rules, 2003