



**SUBMISSION ON
THE DRAFT PATENT (AMENDMENT) RULES, 2018**

2nd January 2019

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The Federation of Indian Chambers of Commerce and Industry (FICCI) welcomes the opportunity provided by the Government for industry comments/inputs on the Draft Patent (amendment) Rules 2018, released on 4th December 2018.

In this regard, FICCI proposes to make the following comments on the Draft Patent Rules, 2018, which are based on suggestions received from industry members and stakeholders, for the consideration of the Government:

S. No.	Proposed Draft Rules	FICCI's Comments
1	<p>In rule 18, after sub rule (2), following proviso is to be added –</p> <p><i>“Provided that, in respect of international application, a patent agent shall file, leave, make or give all documents including scanned copies that are required to be submitted in original, only by electronic transmission duly authenticated;”</i></p> <p><i>“Provided further that the original documents, if required to be submitted in original, shall be submitted within a period of fifteen days; failing which such documents shall be deemed not to have been filed”.</i></p>	<p>The proposed amendment aims at facilitating online filing of document during filing of a PCT application and submitting the original documents, if required within a period of 15 days thereof.</p> <p>Comments</p> <p>The amendment would be beneficial to applicants as it will save money and time. Online filing is easy and would save time and effort as opposed to Physical Filing.</p> <p>This will also reduce the risks of submission of forged documents and shall serve as a cross-check to the filed documents and its execution.</p> <p>In addition, requirement for submission of original documents is a positive step as the Indian Patent Office should maintain authenticated records of all the documents filed.</p> <p>Suggestion</p> <p>The proposed time of 15 days may be extended in justified circumstances.</p>
2	<p>In the principal rules, in sub-rule (1) of rule 24 C, clause (b) shall be substituted, as follows:-</p>	<p>The draft amendment rules add more categories of applicants who would be eligible for expedited examination</p>

	<p><i>“(b) that the applicant is a startup; or</i></p> <p><i>(c) that the applicant is a small entity as defined in rule 2(fa) of the principal rules; or</i></p> <p><i>(d) that in case of natural persons only, the applicant or at least one of the applicants is a female; or</i></p> <p><i>(e) that the applicant is a government undertaking in accordance with clause (h) of sub-section (1) of section 2 of the Act in case of an Indian applicant, or is a similar entity in case of a foreign applicant.</i></p> <p><i>Explanation: - The term ‘substantially financed’ in sub-clause (iv) of clause (h) of sub-section (1) of section 2 of the Act 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, or</i></p> <p><i>(f) that the applicant is eligible under an arrangement for processing an international application pursuant to an agreement between Indian Patent Office with another participating patent office.</i></p> <p><i>Explanation: The patentability of patent applications filed under clause (f) above will be in accordance with the relevant provisions of the Act.”</i></p>	<p>and who have chosen India as the ISA for their International applications.</p> <p>Comments</p> <p>FICCI welcomes this amendment as it will help in boosting innovation within the government undertakings, new and emerging entrepreneurs and the public at large.</p> <p>Further, the addition of female applicants will help in increasing the number of patents filed by women-led businesses since presently, despite the higher number of women entrepreneurs in the country, few come to seek patents.</p> <p>As for section (f), the move will help to further speed up the prosecution and grant processes. <i>Also, the industry will be keen to understand how this proposal would be executed, including the process, steps and timelines.</i></p>
3	<p><i>(4) In the principal rules, in sub-rule (4) of rule 24-C, the following proviso shall be inserted:</i></p> <p><i>Provided that if such requirements are met before issuance of FER, the application shall be processed for</i></p>	<p>Comment</p> <p>FICCI welcomes the amendment as it will help small companies, female applicants. It will also be useful in developing better relationship with other countries offering similar facilities to Indian applicants.</p>

	<i>expedited examination in accordance with the provisions of rule 24-C.</i>	<p>Suggestion</p> <p>The official records of the Indian Patent office shows that large number of patent applications are filed by big companies or foreign companies. A similar opportunity should also be provided to them.</p>
4	<p>(5) In rule 55 of the principal rules, (i) after sub-rule (2), the following sub-rule shall be inserted, namely: -</p> <p><i>“(2A) The Controller shall, by order, constitute a bench comprising two members, who shall proceed to dispose of the application and the representation jointly:</i></p> <p><i>Provided that if the members of the bench differ in opinion on any issue, the Controller shall nominate a third member to the bench and subsequently the majority decision will be treated as final.”</i></p> <p><i>(ii) in sub-rules (3) and (5), for the word “Controller”, wherever it occurs, the word “bench” shall be substituted.</i></p>	<p>Comment</p> <p>FICCI welcomes the draft amendment as it will prove effective towards granting a reasoned and justified decision in pre-grant opposition.</p> <p>Suggestion</p> <p>FICCI suggests that there should be clarity on the eligibility of the members forming part of the bench.</p> <p>Additionally, it is suggested that in order to avoid further postponement and to facilitate speedy disposal of such proceedings, a 3-member bench shall be constituted at the outset and the order given by the bench in the majority shall be considered as final.</p>
5	<i>Removal of transmittal fee for international application (for e-PCT filing) and for preparation of certified copy of priority document and e-transmission through WIPO DAS</i>	<p>Comment</p> <p>FICCI welcomes the move for removal of official fees as this will be well appreciated by the PCT applicants and other relevant stakeholders.</p>
6	<i>Form 18A amended in accordance with the proposed amendment in sub rule 1 of Rule 24 (C)</i>	<p>Comment</p> <p>FICCI welcomes the amendment</p>

7	(iii) In the Note portion of Form 18A, the following shall be added, namely: <i>“Form 28 is to be mandatorily submitted if applicant avails expedited examination under any of the clauses (b) to (f) of sub-rule (1) of rule 24C”</i>	Comment FICCI welcomes the amendment
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