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- Patent Law
- Licensing
- Data Management
- Copyright
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- Balance for Rights & Obligations

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## EDITORIAL

### Sun (Moon also) rises over India in time for Global Leadership

*Prof (Dr.) Unnat P. Pandit, Controller General of Patents, Designs and Trade Marks has come up with timely proposals for Amendments to Patent Rules, as well as for acceding to Strasbourg Treaty (Patent classification), Hague Treaty (Geneva Act) and Lisbon Treaty (Geneva Act). Controller General has also issued a Public Notice regarding revision of IP manual and guidelines. We compliment and congratulate the CG, Dr. Unnat P. Pandit and the DPIIT office for these bold and timely initiatives. Wherever we felt the need for response, both positive and negative, we will be responding appropriately.*

*The proposed draft amendments to Patent Rules are indirectly responding to the concerns expressed by countries with whom we are negotiating for FTA (Free Trade Agreements). However, diluting the provisions of the Patents Act, 1970 which was extensively discussed, debated, negotiated on the floor of the house and vetted by both houses of the Parliament unanimously, through Patent (Amendment) Rules, 2023 provisions may not only be not morally and ethically correct, but also may be subject to judicial challenge. The Amendments to the Rules may need to be revisited after receiving the comments, views and responses from the IP users and the practitioners.*

### INDIAN GOVERNMENT PROPOSES AMENDMENTS IN THE PATENTS RULES

The Department for Promotion of Industry and Internal Trade (DPIIT), Ministry of Commerce & Industry, the body responsible for administering Indian IP laws has, on August 22, 2023, published the Draft Patents (Amendment), Rules, 2023 (Draft Rules). The Draft Rules propose to amend the Patents Rules, 2003 and the DPIIT has sought comments from the stakeholders on these Draft Rules.

Some of the important changes proposed under the Draft Rules are as under:

**Duty to file details of corresponding applications on Form 3 (Section 8(1)):** The Draft Rules propose to relax the current continuous duty of the applicant to provide details of the corresponding application within six months of filing such application. The Draft proposes that the details of all corresponding applications be provided only once within 2 months from the date of issuance of the First Examination Report (FER). The Controller is also mandated to monitor the prosecution of corresponding applications based on publicly available information and can ask the applicant to submit details only with reasons to be recorded in writing.

**Divisional application proposed to be filed based on invention disclosed in provisional application:** The filing of Divisional applications has been liberalized as per Rule 13 sub rule 2. Rule 13 sub rule (2A) has been included stating that a divisional application may be filed based on disclosures in the provisional specification. This proposed amendment in the draft rules for divisional applications emanates from recent High Court Judgements.

**Reduced timeline for Request for Examination (RFE):** The date for filing of RFE is proposed to be reduced from the current 48 months to 31 months from the earliest priority date. This timeline will apply only to the applications filed after the notification of the new Rules.

**Separate application to be filed for availing grace period:** The Draft Rules have introduced Form 31 for filing an application to avail the grace period provided under Section 31 of the Act and prescribe an official fee of INR 84000 (approx. USD 1000) for such an application.

**Major amendments proposed in procedure related to Pre-Grant Opposition:**

For filing representation under S.25(1) in the Form 7A aggregate of various amounts actually paid by the Patentee for filing the Patent Application such as request for publication/ request for examination/ request for expedited examination etc. will need to be paid by the Pre-Grant Opponent at the time of filing a Pre-Grant Opposition.

The Pre-Grant Opposition filed by a Pre-Grant Opponent will now be subjected to the Controller deciding the “maintainability” of the Pre-Grant Opposition. The “maintainability” will be at the discretion of the Controller or as subject to the internal instructions to the Controller. The personal discretion of the Controller could be a matter of concern after payment of such heavy fees.

The timeline to file a reply to the pre-grant Opposition by the applicant is proposed to be reduced from 3 months to 2 months from the date of notice.

The Controller has to issue a decision ordinarily within 3 months.

The hearing procedure currently applicable to the post-grant opposition is to be applied to the pre-grant opposition.

If the pre-grant opposition is found to be maintainable, then the Controller has to follow the expedited examination procedure prescribed under Rule 24C.

The official fee proposed for filing pre-grant opposition and such fees will cover the patent filing cost, including fees applicable for Form-2, Form-9, and Form-18.

**Timeline reduced for the Opposition Board to submit the report:** For post-grant oppositions, the Opposition Board is proposed to submit its report within 2 months, instead of the current 3 months.

**Increased Fees for Post-grant Opposition:** Increased official fee proposed for filing Post-grant Opposition, fee will be equal to the aggregate patent filing cost, including Form-2, Form-9, and Form-18.

**Discount on payment of multiple advance annuities:** The patentees may avail a 10% discount on the official fee if they make online payment in advance for 4 or more years to maintain the patent.

**Relaxed Requirements for working statement:** Working statements which currently are required to be filed annually are proposed to be filed only once every 3 years, for the previous 3 financial years. A provision to condone the delay in filing the statement is also introduced. Under the changes proposed in Form 27, the format of the working statement, the patentee and licensees are only required to state whether the patent is worked or not worked. No additional information as to the value or amount of working is required under the proposed changes.

**Rule 138 extension allowed on request:** The amendment proposed in Rule 138 is to cover all the provisions for which extension can be taken, for a period of up to 6 months. This would include extension for national phase entry and RFE which may be extended up to 6 months if a request for extension is filed before the expiry of the prescribed period. However, the Controller’s discretion would still apply to such requests. Missing out on procedural deadlines has been a major concern for paralegals. The following procedures have been included under the ambit of this rule:

1. National Phase entry and translations
2. Request for examination
3. Response to FER
4. Filing of documents in the Pre-Grant Opposition
5. Review Petition
6. Annuity payment

**Age of Natural Persons:** New format of Form 1: Application of Patent will require the details regarding age of natural persons.

**Renewal fee discounts under Rule 80 (3):** if and when renewal fee is paid in advance through e-filing for a combined period of 4 years, a 10 % (ten percent) reduction is proposed to be allowed to the patentee or request.

The changes proposed under the Draft Rules are highly significant and a result of long winding discussions of the stakeholders with the Government of India. The DPIIT has now sought comments on the Draft Rules by September 22, 2023, and we are hopeful that the spirit of the proposed rules will be carried forward in the final Rules to be notified by the Government.

Objections, views, suggestions and/or responses may be forwarded direct to the Secretary, Department for promotion of Industry and Internal Trade, Ministry of Commerce and Industry, Government of India, Vanijya Bhawan, New Delhi-110001 on [bikram.87@nic.in](mailto:bikram.87@nic.in) and [ipr-patents@gov.in](mailto:ipr-patents@gov.in) or may be forwarded to Dr. Gopakumar

G. Nair, Chairman, IPR committee, IDMA at [gopanair@gnaipr.net](mailto:gopanair@gnaipr.net).

Source: [https://www.mondaq.com/india/patent/1360066/government-proposes-amendments-in-indian-patents-rules#:~:text=The%20Department%20for%20Promotion%20of,%2C%202023%20\(Draft%20Rules\)](https://www.mondaq.com/india/patent/1360066/government-proposes-amendments-in-indian-patents-rules#:~:text=The%20Department%20for%20Promotion%20of,%2C%202023%20(Draft%20Rules).).

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## RECENT DEVELOPMENTS FROM THE OFFICE OF CGPDTM AND DPIIT

The Controller General of Patents, Designs and Trademarks, Prof. (Dr.) Unnat Pandit recently called for a public notice instructing the stakeholders regarding the desirability of acceding to the Hague Agreement, Lisbon Agreement and Strasbourg Agreement administered by WIPO.

The released public notice stated the following:-

*“As part of our continuous commitment to support innovation and creativity, views of stakeholders are invited regarding the desirability of acceding to (i) Strasbourg Agreement Concerning the International Patent Classification as amended on September 28, 1979, (ii) Geneva Act of Hague Agreement Concerning the International Registration of Industrial Designs adopted on Geneva on July 2, 1999 and (iii) Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications adopted at Geneva on May 20, 2015.*

*All the stakeholders are invited to share their views via VC on 28/08/2023, from 11:00 a.m. to 12 noon.”*

The stakeholders meeting was conducted on 28/08/2023 and views, suggestions and discussions on following agreements were invited:-

- (i) Strasbourg Agreement concerning the Indian Patent Classification
- (ii) Geneva Act of Hague Agreement Concerning the International Registration of Industrial Designs
- (iii) Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications

**Summary on Strasbourg Agreement concerning the Indian Patent Classification:** The Strasbourg Agreement establishes the International Patent Classification (IPC) which divides technology into eight sections with approximately 80,000 subdivisions. Each subdivision is denoted by a symbol consisting of Arabic numerals and letters of the Latin alphabet. For PCT applications, IPC symbols are allotted by the International Searching Authority. Classification is indispensable for the retrieval of patent documents in the search for “prior art”. The Strasbourg Agreement created a

Union, which has an Assembly. Every State that is a member of the Union is a member of the Assembly. Among the most important tasks of the Assembly is the adoption of the biennial program and budget of the Union. The Agreement – commonly referred to as the IPC Agreement – was concluded in 1971 and amended in 1979. It is open to States party to the Paris Convention for the Protection of Industrial Property (1883).

**Reference:** [https://www.wipo.int/treaties/en/classification/strasbourg/summary\\_strasbourg.html](https://www.wipo.int/treaties/en/classification/strasbourg/summary_strasbourg.html)

**Summary on Geneva Act of Hague Agreement Concerning the International Registration of Industrial Designs:** The Hague Agreement is an international registration system which offers the possibility of obtaining protection for up to 100 industrial designs in designated member countries and intergovernmental organizations, referred to as contracting parties. As of 2023, there are 79 contracting parties under the Hague Agreement. An applicant can file a single international application for design protection, in a single language, either directly with the International Bureau of the World Intellectual Property Organization (WIPO) or indirectly, through the office of the appropriate contracting party.

The Geneva Act of 1999 has a two-fold objective, namely:

- i. on the one hand, to extend the Hague system to new members; to do that, the Geneva Act has introduced a certain number of features into the Hague system with a view to allowing or facilitating the accession of States whose legislation provides for a novelty examination;
- ii. on the other hand, to preserve the fundamental simplicity of the Hague system and make it more attractive to applicants.

**Reference :** [https://www.wipo.int/edocs/pubdocs/en/designs/911/wipo\\_pub\\_911.pdf](https://www.wipo.int/edocs/pubdocs/en/designs/911/wipo_pub_911.pdf)

**Summary on Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications:** The Geneva Act allows the international registration of geographical indications (GIs), in addition to appellations of

origin, and permits the accession to the Lisbon Agreement by certain intergovernmental organizations. The Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, adopted May 20, 2015, entered into force on February 26, 2020. The Geneva Act updates and enhances the existing international registration system protecting names that identify the geographic origin of products: the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of 1958. The Lisbon Agreement applies only to appellations of origin – a special kind of geographical indication for products that have a particularly strong link with their place of origin. The Geneva Act extends that protection to geographical indications alongside appellations of origin, to better take into account existing national or regional systems for the protection of distinctive designations in respect of origin-based quality products.

**Reference:**<https://www.wipo.int/export/sites/www/treaties/en/registration/lisbon/mainprovisions.pdf>

There was a general consensus for India joining the above-mentioned agreements. It is to be noted that all participants have welcomed India's decision to accede all the three agreements; it was further highlighted that appropriate amendments may be required to Indian Legislations such as Industrial Designs Act to make it compliant to the Geneva Acts of Hague Agreements among others.

Dr. Gopakumar G. Nair welcomed the decision and initiative of the Controller General and the government to accede to these agreements especially since India is aspiring to move from 5<sup>th</sup> position on the economic front globally to the 3<sup>rd</sup> position. India needs to approach the International IP community with self-confidence and pride of India's technological capabilities and potential and needs to fall in line and comply with International rules and regulations.

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## PUBLIC NOTICE IN RESPECT OF REVISION OF INTELLECTUAL PROPERTY MANUAL AND GUIDELINES

A public notice was released on the Indian Patent Office website by Prof. (Dr.) Unnat Pandit, the Controller General of Patents, Designs and Trade Marks on 30.08.2023 stating the following :-

*"All stakeholders are hereby invited to submit their suggestions/comments regarding revision of existing manuals and guidelines or for issuance of fresh manuals and guidelines in respect of Patents, Designs, Trade Marks, Geographical Indications and Copyrights by 15.10.2023 to [cgooffice-mh@nic.in](mailto:cgooffice-mh@nic.in).*

*The suggestions/comments will be placed before expert committees for consideration and necessary action."*

Stakeholders are encouraged to provide well-articulated, evidence-supported suggestions and comments. These could include:

- I. Identifying limitations or gaps in current guidelines;
- II. Proposing new topics or issues that should be covered in the guidelines;
- III. Making recommendations for updating existing sections to reflect current legal or technological considerations.

Stakeholders have until October 15, 2023, to submit their detailed feedback. All such contributions should be directed to the official email address: [cgooffice-mh@nic.in](mailto:cgooffice-mh@nic.in). Upon receipt, these submissions will be forwarded to expert committees for comprehensive review and further action.

Source:[https://ipindia.gov.in/writereaddata/Portal/Images/pdf/Public\\_Notice\\_Manual-guidelines.pdf](https://ipindia.gov.in/writereaddata/Portal/Images/pdf/Public_Notice_Manual-guidelines.pdf)