

MINISTRY OF COMMERCE AND INDUSTRY
(Department of Industrial Policy and Promotion)

NOTIFICATION

New Delhi, the 23rd April, 2013.

S.O.1029 (E).—WHEREAS, certain draft rules were published in exercise of the powers conferred by section 159 of the Patents Act, 1970 (39 of 1970), vide notification of the Government of India in the Ministry of Commerce and Industry (Department of Industrial Policy and Promotion), bearing number S.O. 189 (E) in Part II, Section 3, sub-section (ii) of the Gazette of India, Extraordinary, dated the 17th January, 2013, for inviting objections and suggestions from persons likely to be affected thereby before the expiry of a period of fifteen days from the date on which copies of the Gazette containing the notification were made available to the public;

AND WHEREAS, the copies of the Gazette containing the said notification were made available to the public on the 17th January, 2013;

AND WHEREAS, no objection or suggestion has been received from the public on the said draft rules, by the Central Government;

NOW, THEREFORE, in exercise of the powers conferred by section 159 of the Patents Act, 1970 (39 of 1970), the Central Government hereby makes the following rules further to amend the Patents Rules, 2003, namely:-

1. (1) These rules may be called the Patents (Amendment) Rules, 2013.
(2) They shall come into force on such date as the Central Government may, by notification in the Official Gazette, appoint.

2. In the Patents Rules, 2003 (hereinafter referred to as the said rules), in rule 4, in sub-rule (2), the following sub-rules shall be inserted, namely: -

“(3) Notwithstanding anything contained in sub-rule (2), the Controller may transfer an application for patent so filed, to head office or, as the case may be, branch office of the Patent Office.

(4) Notwithstanding anything contained in sub-rule (1), further application referred to in section 16 of the Act, shall be filed at the appropriate office of the first mentioned application only.

(5) All further applications referred to section 16 of the Act filed in an office other than the appropriate office of the first mentioned application, before the commencement of the Patents (Amendment) Rules, 2013, shall be transferred to the appropriate office of the first mentioned application.”

3. For rule 9 of the said rules, the following rule shall be substituted, namely:-

“9. **Filing of documents and copies, etc.**- (1) All documents and copies of the documents, except affidavits and drawings, filed with patent office, shall -

(a) be typewritten or printed in Hindi or English (unless otherwise directed or allowed by the Controller) in large and legible characters not less than 0.28 centimetre high with deep indelible ink with lines widely spaced not less than one and half spaced only upon one side of the paper;

(b) be on such paper which is flexible, strong, white, smooth, non-shiny, and durable of size A4 of approximately 29.7 centimetre by 21 centimetre with a margin of at least 4 centimetre on the top and left hand part and 3 centimetre on the bottom and right hand part thereof;

(c) be numbered in consecutive Arabic numerals in the centre of the bottom of the sheet; and

(d) contain the numbering to every fifth line of each page of the description and each page of the claims at right half of the left margin.

(2) Any signature which is not legible or which is written in a script other than English or Hindi shall be accompanied by a transcription of the name either in Hindi or English in capital letters.

(3) In case, the application for patent discloses sequence listing of nucleotides or amino acid sequences, the sequence listing of nucleotides or amino acid sequences shall be filed in computer readable text format along with the application, and no print form of the sequence listing of nucleotides or amino acid sequences is required to be given.

(4) Additional copies of all documents shall be filed at the appropriate office as may be required by the Controller.

(5) Names and addresses of applicant and other persons shall be given in full together with their nationality and such other particulars, if any, as are necessary for their identification."

4. In rule 17 of the said rules, after clause (a), the following clauses shall be inserted, namely:-

'(aa) "Examining Authority" means the Indian International Preliminary Examining Authority referred to in sub-rule (1) of rule 19F;

(ab) "International Bureau" means the International Bureau of World Intellectual Property Organisation;

(ac) "Searching Authority" means the Indian International Searching Authority referred to in sub-rule (1) of rule 19A;'

5. For rule 18 of the said rules, the following rule shall be substituted, namely: —

"18. Appropriate office in relation to international applications. —(1) The receiving office, the designated office and the elected office, as the case may be, for the purposes of international applications shall be the appropriate office referred to in rule 4.

(2) Notwithstanding anything contained in sub-rule (1), the Patent Office, Delhi branch shall be the appropriate office for dealing with the International Bureau and any other International Searching Authority and International Preliminary Examining Authority.

(3) An international application shall be filed at and processed by the appropriate office, referred to in sub-rule (1), in accordance with the provisions of this Chapter, the Treaty and the regulations under the Treaty.

(4) The appropriate office referred to in sub-rule (1), shall, on receipt of an international application,

(a) keep one copy of the application to be called the "home copy" in its office;

(b) transmit one copy to be called the "record copy" to the International Bureau; and

(c) transmit one copy to be called "search copy" to the competent International Searching Authority referred to in Article 16 of the Treaty,

And simultaneously furnish complete details of such application to the Patent Office, Delhi branch."

6. For rule 19 of the said rules, the following rules shall be substituted, namely: —

"19. International applications filed with appropriate office as receiving office. — (1) An international application shall be filed with the appropriate office in triplicate either in English or Hindi language.

(2) The fees payable in respect of an international application shall, in addition to the fees specified in the regulations under the Treaty, be the fees as specified in the First Schedule and the Fifth Schedule.

(3) Where an international application has not been filed in triplicate, the appropriate office shall, upon payment of fees specified in the First Schedule, prepare the required additional copies.

(4) On receipt of a request from the applicant and on payment of the fees specified in the First Schedule, the appropriate office shall prepare a certified copy of the priority document and promptly transmit the same to the International Bureau and intimate the applicant and the Patent Office, Delhi branch."

19A. Indian International Searching Authority.—(1) The Patent Office, Delhi branch shall perform the functions of the Indian International Searching Authority under the treaty in accordance with an agreement between the Indian Patent Office and the International Bureau.

(2) The fees payable to the Searching Authority shall, in addition to the fees specified in the regulations made under the Treaty, be the fees as specified in the Fifth Schedule.

(3) The Searching Authority referred to in sub-rule (1), shall establish international search report in respect of international applications, or, as the case may be, declare in accordance with sub-rule (3) of rule 19B, in cases where India has been indicated as a competent International Searching Authority.

19 B. International search report.— (1) The Searching Authority shall, on receipt of the search copy, notify the International Bureau and the applicant about the receipt of search copy with identification mark 'ISA/IN' along with the international application number and its serial number and the date of receipt of the search copy.

(2) Notwithstanding anything contained in the proviso to item (i) of sub-rule (2) of rule 24B, the Searching Authority shall, upon receipt of the search copy, refer the international application, in the order in which the search copy was received, to an examiner or any other officer appointed under sub-section (2) of Section 73 of the Act for preparing an international search report, in accordance with the provisions contained in the Treaty and the regulations under the Treaty, ordinarily within a period of one month but not exceeding two months from the date of such reference.

(3) The Searching Authority, if it considers that-

- (a) the international application relates to a subject matter which the Searching Authority is not required to search and accordingly decides not to search; or
- (b) the description, claims or drawings fail to comply with the requirements prescribed under the regulations under the Treaty to such an extent that a meaningful search could not be carried out,

the Authority shall so declare and notify the applicant and the International Bureau that no international search report shall be established.

(4) In a case where any situation referred to in clause (a) or clause (b) of sub-rule (3) is found to exist in connection with certain claims only, the Searching Authority shall indicate this fact in the International Search Report in respect of such claims, and for other claims, it shall establish the International Search Report.

(5) The Searching Authority, if it considers that the international application does not comply with the requirement of unity of invention, in accordance with the provisions contained in Rule 13 of the regulations under the Treaty, shall send a notice specifying the reasons for which the international application is not considered as complying with the requirement of unity of invention and inviting the applicant-

- (a) to pay the additional fees specified in the Fifth Schedule, indicating the amount of fees to be paid, within a period of one month from the date of such invitation; and
- (b) to pay, where applicable, the protest fee specified in the Fifth Schedule, indicating the amount of fee to be paid, within a period of one month from the date of such invitation.

(6) The Searching Authority shall establish the International Search Report on those parts of the international application which relate to the invention first mentioned in the claims ("main invention") and subject to payment of additional fee within the period specified in sub-rule (5), on those parts of the international application which relate to inventions in respect of which such additional fees were paid.

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- (7) Any applicant may pay the additional fees under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fees is excessive.
- (8) The examination of the protest referred to in sub-rule (7) shall be carried out by a Review Committee constituted by the Controller.
- (9) The Review Committee constituted under sub-rule (8) shall examine the extent to which the protest is justified and shall accordingly order for the total or partial reimbursement of the additional fee to the applicant.
- (10) Where the applicant has not paid the fees for the protest in accordance with clause (b) of sub-rule (5), the protest shall be considered not to have been made and the Searching Authority shall so declare.
- (11) The protest fee shall be refunded to the applicant where the Review Committee referred to in sub-rule (8) finds that the protest was entirely justified.
- (12) Where the international application contains the disclosure of one or more nucleotide or amino acid sequences and the sequences are not furnished in computer-readable text format, the Searching Authority shall send a notice to the applicant to submit the sequence listing in computer-readable text format and pay the late furnishing fee specified in the Fifth Schedule, within a period of one month from the date of such notice and if the applicant fails to comply with the notice, the Searching Authority shall search the international application to the extent that a meaningful search can be carried out without the sequence listing.

19 C. Time limit for establishing international search report. – The Searching Authority shall establish the International Search Report and written opinion or, as the case may be, the declaration referred to in sub-rule (3) of rule 19B within a period of three months from the date of receipt of the search copy by the Searching Authority, or within a period of nine months from the date of priority, whichever expires later.

19D. Transmittal of the International Search Report and written opinion,–

The Searching Authority shall transmit one copy of the International Search Report or of the declaration referred to in Article 17(2)(a) of the Treaty, and one copy of the written opinion established under Rule 43bis.1 of the regulations under the Treaty, to the International Bureau and one copy to the applicant, on the same day.

19E. Confidential treatment.–All matters pertaining to international applications shall be kept confidential in accordance with the treaty and the regulations under the Treaty.

19F. Indian International Preliminary Examining Authority. - (1) The Patent Office, Delhi branch shall perform the functions of the International Preliminary Examining Authority under the Treaty in accordance with an agreement between the Indian Patent Office and the International Bureau.

(2) The Examining Authority referred to in sub-rule (1), shall establish—

- (a) the International Preliminary Examination Report in respect of all international applications electing India as an International Preliminary Examining Authority;
- (b) the International Preliminary Examination Report in respect of the demands filed by the nationals or residents of other countries in accordance with an agreement between Indian Patent Office and the International Bureau, upon being notified by the International Bureau;
- (c) the International Preliminary Examination in respect of demands made by the nationals or residents of other countries not party to the Treaty or not bound by Chapter II of the Treaty, if the Assembly has so approves.

19G. Period for making a demand. – (1) The demand for international preliminary examination shall be made within the period specified in the Treaty or regulations under the Treaty.

(2) In case the demand is made after the expiry of the period specified in sub-rule (1), it shall be considered to have not been made and no International Preliminary Examination Report shall be prepared.

19H. Fees payable to Examining Authority. –The fees payable to the Examining Authority shall, in addition to the fees specified in the regulations under the Treaty, be the fees specified in the Fifth Schedule.

19I. Manner of making a demand. –A demand shall be made in accordance with the provisions contained in these rules, the Treaty and the regulations under the Treaty.

19J. Processing of demands for international preliminary examination. – (1) The Examining Authority, on receipt of the demand for international preliminary examination, if the Examining Authority is competent to conduct an international preliminary examination, shall assign the identification mark 'IPEA/IN' and shall notify the Applicant and the International Bureau.

(2) In case where the Examining Authority is not competent to conduct the international preliminary examination of the international application, it shall transmit the demand promptly to the International Bureau.

19K. International Preliminary Examination Report. – (1) Notwithstanding anything contained in the proviso to item (i) of sub-rule (2) of rule 24B, the Examining Authority shall refer the international application, in accordance with the provisions contained in the Treaty and the regulations under the Treaty, in the order in which the demand was received in the Examining Authority to an examiner or any other officer appointed under sub-section (2) of section 73 of the Act for preparing an International Preliminary Examination Report ordinarily within a period of three months but not exceeding four months from the date of such reference.

(2) Claims relating to inventions in respect of which no International Search Report has been established shall not be the subject of international preliminary examination.

(3) The Examining Authority, if considers that –

- (a) the international application relates to a subject matter on which the Examining Authority is not required to carry out an international preliminary examination, and, decides not to carry out such examination; or
- (b) that the description, the claims, or the drawings, are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the questions of novelty, inventive step (non-obviousness), or industrial applicability, the Examining Authority shall not go into these questions and shall inform the applicant of this opinion and the reasons therefor.

(4) In a case where any situation referred to in clause (a) or clause (b) of sub-rule (3) is found to exist in connection with certain claims only, the Examining Authority shall indicate this fact in the International Preliminary Examination Report in respect of such claims, and for other claims, it shall establish the International Preliminary Examination Report.

(5) Where the Examining Authority finds that the international application does not comply with the requirement of unity of invention, in accordance with the provisions contained in Rule 13 of the regulations under the Treaty and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees, it shall issue a notice to the applicant:

- (a) specifying at least one possibility of restriction which, in the opinion of the Examining Authority, would be in compliance with the applicable requirement;

- (b) specifying the reasons for which the international application is not considered as complying with the requirement of unity of invention;
- (c) inviting the applicant to comply with the invitation within one month from the date of such notice;
- (d) indicating the amount of the required additional fees to be paid in case the applicant so chooses; and
- (e) inviting the applicant to pay, the protest fee within one month from the date of such notice, and indicate the amount to be paid, as specified in the Fifth Schedule.

(6) Any applicant may pay the additional fees under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fees is excessive.

(7) The examination of the protest referred to in sub-rule (5) shall be carried out by a Review Committee constituted by the Controller.

(8) The Review Committee constituted under sub-rule (7) shall examine the extent to which the protest is justified and shall accordingly order for the total or partial reimbursement to the applicant of the additional fee.

(9) The protest fee shall be refunded to the applicant where the Review Committee referred to in sub-rule (6) finds that the protest was entirely justified.

19 L. Period for establishing international preliminary examination report and its transmission. – The period for establishing the International Preliminary Examination Report shall be:

- (i) twenty eight months from the priority date; or
- (ii) six months from the period specified under Rule 69.1 of the regulations under the Treaty for the start of the international preliminary examination; or
- (iii) six months from the date of receipt by the Examining Authority of the translation furnished under Rule 55.2 of the regulations under the Treaty,

whichever expires last.

19M. Transmittal of the International Preliminary Examination Report.—The Examining Authority shall transmit one copy of the International Preliminary Examination Report and its annexures, if any, to the International Bureau, and one copy to the applicant, on the same day.

19N. Conditions for and extent of refund. – The fee paid by the applicant may be refunded, waived or reduced to the extent and in accordance with the conditions specified in the Treaty or the regulations under the Treaty and the agreement entered between the Indian Patent Office and the International Bureau.”

7. In rule 27 of the said rules, for the words “and the abstract”, the words “the abstract and any other document” shall be substituted.

8. In rule 138 of the said rules, in sub-rule (1), for the word, figures and letter “rules 24B”, the words, figures and letters “Chapter III of these rules, rule 24B,” shall be substituted.

9. After the FOURTH SCHEDULE to the said rules and the entries relating thereto, the following SCHEDULE and entries shall be inserted, namely:—

"THE FIFTH SCHEDULE**[See rules 19(2), 19A(1)(b), 19B(5),19B(12), 19H, 19K(5)]**

Sl. No.	On what payable (Relevant provision of Patents Rules, 2003, if any)	Relevant Rule of regulations under the Treaty	For Natural Person	Other than natural person either alone or jointly with natural person
(1)	(2)	(3)	(4)	(5)
			(In Rupees)	(In Rupees)
1.	Search fee	Rule 16.1(a)	2500	10000
2.	Additional fee under rule 19B (5)	Rule 40.2	2500	10000
3.	Protest fee under rules 19B (5) and 19J(5)	Rules 40.2(e) and 68.3(e)	1000	4000
4.	Preliminary examination fee	Rule 58.1	3000	12000
5.	Additional fee under rule 19J(5)	Rule 68.3	3000	12000
6.	Preliminary examination fee, if the International Search Report was prepared by the Indian International Searching Authority		2500	10000
7.	Additional fee under rule 19J(5), if the International Search Report was prepared by the Indian International Searching Authority		2500	10000
8.	Handling fee to be paid to be IB	Rule 57	As specified in the schedule of fee annexed to the regulations made under the Treaty	
9.	Late furnishing fee	Rule 13ter.1(c),1 3ter.2, 12.3(e), 12.4(e)	1000	4000
10.	Late payment fee	Rule 58bis.2, 16bis.2	In accordance with the regulations made under the Treaty	
11.	Copy of Results of Earlier Search and of Earlier Application	12bis.1(c)	1000	4000"

[F. No. 14/1/2008-IPR-III]

D. V. PRASAD, Jt. Secy.

Note. – The principal rules were published in the Gazette of India, Extraordinary, vide notification number S.O. 493 (E), dated the 2nd May, 2003 and subsequently amended vide notification numbers –

- (i) S.O. 1418(E), dated the 28th December, 2004;
- (ii) S.O. 657 (E), dated the 5th May, 2006; and
- (iii) S.O. 2296 (E), dated the 25th September, 2012.