
New Patent Rules come into force

The Patent (Amendment) Rules, 2016 were published for comments by stakeholders on 26th October, 2015. This followed a series of consultation by the Patent office and representation from IP Practitioners and IP owners. Finally the Rules have now been notified to come into effect from May 16, 2016. The new Rules are a step towards expediting grant of Patent and increasing technology interface in filing and prosecution of the application. At the same time, the Patent office while implementing the Rules, based on representation of stakeholders, reduced the fees for expedited examination by a legal entity from INR 250,000 (approx US\$ 3788 (originally proposed in draft Rules) to INR 60,000 (approx. US \$ 910) which has been widely welcomed. The complete amended rules can be accessed [here](#).

The key changes are listed below:

a) **Steps to expedite the patent grant**

- Timeline for putting application in order for acceptance has been reduced from 12 months to 6 months. A further extension of 3 months can be obtained on filing a request. (This shall not have retrospective effect, however would be applicable only for First Examination Reports issued post the Final Rules came into effect i.e. on or after May 16, 2016)
- An obligation has been cast on the Controller to dispose off the Application within 3 months of filing of last response or final date of acceptance, whichever is earlier.
- An applicant may request for adjournment of hearing with reasonable cause at least 3 working days before the due date. Adjournment can be for a maximum of 2 occasions and each for not more than 30 days.

b) **Expedited examination of applications**

- An applicant may file a request for expedited examination (in a new Form 18A) on the grounds, namely i) that India has been indicated as the competent International Searching Authority or elected as an International Preliminary Examining Authority in the corresponding international application; or ii) that the applicant is a startup. (It is important to note here that Final Rules have dropped out the basis of "Invention manufacturing in India" for availing the Expedited Examination which was proposed in the draft Rules earlier)

c) Amendment to International Application

- The rules allow applicant to delete claims at the time of filing the PCT national phase application in India which were not permitted earlier.
- In case of duplicate payment during electronic transfer, the Rules provide for refund of excess amount.
- The fee for Request for Examination may be refunded (upto 90%) in case the applicant withdraws its Request for Examination (by filing Form 29).

d) Boost for Start ups

- To encourage innovation, Startups have been permitted to pay the discounted official fee, for all purposes, as payable by a natural person, where the invention is filed by startup alone or with a natural person/s.

e) Towards Digital Advancement

- Patent agents/Applicants are required to compulsorily furnish e-mail address and mobile number in addition to postal address for service
- A patent agent/applicant is required to file all documents only by electronic transmission after due authentication. Scanned copies of any document that is normally required to be submitted in original must also be submitted electronically.
- Any liability or burden of proof regarding the authenticity of any document filed, left, made or given under these rules, including electronically transmitted documents, shall lie only with the party filing, leaving, making or giving the document (i.e. Applicant/Agent).
- Hearing may be performed by video conferencing.
- Certificate of Renewal would be simultaneously issued with the payment of renewal fee

f) Miscellaneous

- Power of Attorney or Authorisation of Patent Agent (Form 26) is required to be submitted within 3 months
- During opposition procedure, a copy of statement and evidence is required to be sent to the applicant/patentee

- A request for examination (General course request) filed may be converted to a request for expedited examination by paying the relevant fees
- The Certified Copies could be obtained on an expedited basis, normally within a period of one week from the date of making such request along with a specific fee
- Divisional applications shall be examined together with the Parent Application, if Request for Examination is already filed for the same

g) Specification

The abstract shall contain a concise summary of the matter contained in the specification, particularly the technical field, technical advancement of the invention as compared to the existing knowledge and principal use of the invention excluding any speculative use.

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