

CLIENT ALERT

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INTELLECTUAL PROPERTY

INDIAN PATENT OFFICE PAVES WAY FOR FASTER AND CHEAPER INTERNATIONAL PATENT APPLICATIONS

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On December 4, 2018, the Indian Ministry of Commerce and Industry published draft amendments to the existing Patent Rules, 2003 (the "Patent Rules"), for notice and comment from the public. This period ended on January 3, 2018 after a thirty day window. These rules, if subsequently adopted, would make the process of filing an international applicant faster, cheaper, and favorable for certain types of filers.

E-Filing

The proposed rules make it mandatory for a patent agent representing an international applicant to file all application documents, including copies of those documents that are to be filed in their original form, electronically through the e-PCT System. This system is the World Intellectual Property Organization's (WIPO) online portal for filing and managing patent applications. Documents that are required by the Patent Rules to be filed in their original form shall then be mailed by the patent agent to the appropriate office in India within 15 days of the online submission. Otherwise, the application shall be deemed to have been not filed. Bringing this rule into effect would make it consistent with the existing rules applicable to domestic applications, and limit the burden of an international filer to only mail those documents that are required in their original form.

Filing Fee

The transmittal fee for a patent application filed through the e-PCT System is proposed to be reduced to zero. The current provision requires a payment between 3,200 Rupees (USD 46) and 16,000 Rupees (USD 229) through an e-filing process, and slightly more for a physical filing process. Similarly, the fee for preparation of a certified copy of a priority document and for transmission of the same to the International Bureau of WIPO has been reduced to zero. The current provision requires a payment between Rupees 1000 (\$14) and 5000 (USD 71). The collective reduction of both transmittal and certification fee to nil is certainly a welcoming move.

Addition of applicants to the expedited examination of patent applications

Where an applicant desires an examination of his patent application by an examiner (in case of rejection to grant a patent for e.g.), the applicant may request examination to the Controller of the Indian Patent Office within the period specified therein. An application for expedited examination may also be requested, but is currently limited only to (i) a start-up entity and (ii) cases where India has been indicated as a competent International Searching Authority or elected as an International Preliminary Examining Authority in the corresponding international

application. The proposed rules expand the types of applicants who can request an expedited examination for an application to the following:

1. a small entity as defined in the Patent Rules;
2. in case of natural persons only, the applicant or at least one of the applicants is a female;
3. the applicant is a government undertaking as defined in the Indian Patents Act of 1970 in case of an Indian applicant, or is a similar entity in case of a foreign applicant; or
4. the applicant is eligible for processing an international application pursuant to an agreement between Indian Patent Office and another participating patent office (PPH arrangement).

In order to claim this benefit, necessary documents must be produced to establish the eligibility by filing a requisite application.

Bench consideration for post-grant opposition

In considering an opposition to the grant of a patent, the Controller may delegate the decision-making to a two-member bench constituted by the Controller, which shall proceed to dispose of the patent application and the opposition accordingly. However, 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. The proposed rule aims to make the post-grant opposition consistent with the pre-grant opposition process currently laid down in the Patent Rules.

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