

27-Nov-15

Via Email and Courier

Secretary,  
Ministry of Commerce & Industry  
Government of India  
Udyog Bhawan, New Delhi – 110011  
[rajiv.aggarwal@nic.in](mailto:rajiv.aggarwal@nic.in)

**Sub: Comments on Draft Patent (Amendment) Rules, 2015 dated 26-Oct-15**

Dear Sir:

We are pleased to submit our comments on the Draft Patent (Amendment) Rules, 2015 patent dated 26-Oct-15.

At first, we would like to take this opportunity to thank the patent office for the recent set of measures to improve the existing patent system. We sincerely welcome all these reforms.

Regarding the present rules, we note that the most of the proposed changes relate to reducing the prosecution time in the examination system, and streamlining the prosecution process. This is a step in the right direction. The most significant proposal is introduction of the expedited examination system regime will be highly welcomed by everyone.

Having said the above, we would also like to point that in addition to the instant measures, a strong set measures of measures are required for reducing the existing backlog of patent applications.

In this regard, we would like to suggest that the patent office should immediately undertake steps to clear the pendency of patent applications at the patent office. Some of the measures could be making special rules authorizing the examiners to conduct “trademark office type” special drives to clear the huge backlog. Other steps could be organizing hearing camps, where mass hearings are conducted for pending matters. We believe these measures are highly imperative in order to build trust and confidence amongst the users of our patent system, especially the much wanted domestic inventors, SMEs and start ups.

Coming to the subject in hand, the next paras set forth our point by point comments to various new provisions that are proposed in the Draft Patent (Amendment) Rules, 2015. In the draft rules:-

Comments suggestions

Point No.	Our Feedback/ Suggestion
1-2	Nothing in particular
3	We welcome proposal of quoting email ID and mobile number while filing patent applications. This will reduce time lag in communicating with

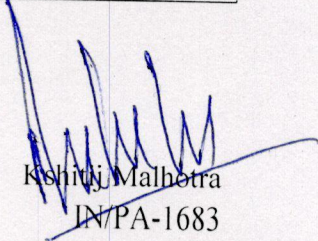


	applicants, especially on critical communications like Issuance of FER etc.
4	It is a welcome proposal and would help in streamlining the process.
5	<p>The provision of refund of fees in case of double payment is a welcome move.</p> <p>Further, we understand the intention behind non refund clause in the new rules. However, considering the increased fees, the patent office should also introduce alternate provisions, such as fees adjustments.</p> <p>In other words, the patent office should provide for new rules which could allow the applicant to adjust the excess fees in future actions. For example, excess fees paid at time of the filing could be adjusted while the applicant decides to make request for examination etc at the patent office.</p> <p>The patent office should also provide a choice of special account facility to applicants as provided by major patent offices, such as USPTO and EPO.</p> <p>In this facility, similar to e-stamp system by Delhi government, the applicants and agents who file at IPO regularly may create "special pre-paid accounts" with the patent office. The parties can prepay or deposit money in these accounts in advance. When the parties do any transaction, the patent office can debit their special accounts.</p> <p>In this manner, the patent office will be able to retain a substantial corpus of money at all time and the applicants <u>will be saved by unnecessary bank charges and credit card charges, while making payments for their patent cases at the IPO.</u></p>
6	Introduction of new form will streamline the process.
7-8	No comments
9	<p>We request the patent office to clarify on the fees applicable in case of national phase entry in India, where the applicant intends to reduce the number of claims for the Indian entry as compared to the PCT application.</p> <p>For example, if a PCT application is filed with 50 claims and the applicant intends to make an entry in India with a reduced set of claims, say only 10 claims, the patent office should institute for a procedure to allow the applicant to pay for only 10 claims rather than total 50 claims. Right now the procedure requires the applicant to pay the fees for entire 50 claims, which is burdensome and unjust to the applicant.</p>
10 and 12	<p><b>Withdrawal of RFE and refund of fees:</b> This is a very good proposed rule and will allow the applicant to save time, money an effort during patent prosecution.</p> <p><b>Acceptance period reduction:</b> We welcome the rule for acceptance period reduction provided that the applicant is expeditiously informed about the issuance of the FER and subsequent examination report.</p>



	<p>It is suggested that the patent office mandatorily uses electronic means (like email) to communicate with the applicant or his agent to communicate the FER and other important notices, such as SER etc.</p> <p>New proposed Rule 24B (7) is unclear and requires more clarity.</p>
11	<p><b>Expedited Examination System:</b> We welcome the said proposal specially with reference to prioritizing expeditious grant of those patents in which the patented products are to be produced in India as enshrined by qualifying criteria (b) and (c).</p> <p>Further, the proposal of expediting examination for those applications in which the Indian patent office is the ISR is also an ingenious way of making applicants use the Indian patent office as the ISR.</p> <p>However, having said the above, the said proposal does not fully cater to applications that are already in backlog, especially to applications in which the PCT applications were filed before IPO started working as an ISA. Those applicants will be bereft of their rights.</p> <p>Moreover, the fees for expedited examination system is quite hefty and can come in way of using the system, especially for Indian small and medium enterprise. Fees of up to Rs. 25,000/- for individuals and up to Rs. 75,000/- for SMEs seem reasonable. <u>It is requested to the patent office to reconsider the fees and reduce the fees.</u></p> <p>It is also suggested that the patent office should charge the applicable expedited RFE fees in a two tier manner. At the first instance, the applicant should be required to pay a basic fees for entering the procedure, allowing him/ her to submit the required qualification documents. Thereafter, the patent office should scrutinize the documents, and if they are found in order, the applicant should be required to pay the remainder fees. This will remove the discretion and the monetary risk involved in the procedure.</p>
13	This is a very good proposal.
14-21	No particular suggestions or comments.
22-24	No particular suggestions or comments.
25-26	These proposals will streamline the process.
27	No comments

Please let us know if you need any clarifications on the above?

  
 Kshiti Malhotra  
 IN/PA-1683  
 Adv. Delhi High Court