

Detailed Comments and Suggestions:

Proposed Draft Amendment Rules, 2023

Submitted to:

The Secretary, Department for Promotion of Industry and Internal Trade,
Ministry of Commerce and Industry, Government of India,
Vanijya Bhawan,
New Delhi- 110001

Submitted by:

BananaIP Counsels

Draft Rule 13(2A):

"13(2A) A patent applicant may, if he so desires, file a divisional application under section 16, including in respect of an invention disclosed in the provisional specification."

Comments:

The modification is a welcome change, wherein under Rule 13(2A) enables an Applicant to file a divisional patent application in respect of an invention disclosed in a provisional patent application henceforth. According to the proposed clause, the Applicant can file a divisional patent application from a provisional patent application, which can be construed to mean that the Applicant can file **one** divisional patent application from the provisional patent application.

It will be helpful if the Applicant can be provided with an option to file one or more divisional patent application(s) in respect of one or more invention(s) disclosed in a provisional patent application.

Proposed modification:

The Rule may be modified as follows:

"13(2A). A patent applicant may, if he so desires, file one or more divisional applications under section 16, including in respect of one or more inventions disclosed in the provisional specification."

Draft Rule 29A:

"29A. Grace period.- An application to avail the grace period under section 31 shall be filed in Form 31."

Comments:

The modification is a welcome change, wherein Rule 29A enables an Applicant to avail the grace period under Section 31 (ANTICIPATION BY PUBLIC DISPLAY, ETC.) by

filing Form 31. However, the proposed Rule does not specify as to when the Applicant is to file the proposed Form 31. It would be advisable to provide a timeline for filing the same.

Define a timeline as to when the Form 31 is to be filed. In our opinion, the filing of Form 31 may be permitted at any point of time before the grant/refusal of the patent application voluntarily or based on an objection relating to anticipation by prior display/publication/working etc.

Proposed modification:

The Rule may be modified as follows:

“29A. Grace period.- An application to avail the grace period under section 31 may be filed at any time before the grant or refusal of the patent application in Form 31.”

Draft Rule 55(3):

55(3). On consideration of the representation, the Controller shall first decide the maintainability of the representation and thereafter if the Controller is of the opinion that application for patent shall be refused or the complete specification requires amendment, he shall give a notice to the applicant to that effect.

Comments:

While the modification to sub rule 3 is a check against filing of frivolous representation, this modification may put undue burden on the Controller to examine the application and the representation in their entirety before giving notice to the Applicant. Such undue burden on the Controller may result in the delay of opposition proceedings and eventually, a significant delay in the disposal of the Application. To reduce any delay and to prevent frivolous filing of representation, the sub rule 3 may be modified to require

the Controller to only ascertain whether the **submissions/pleadings set forth in the representation are Prima facie made on valid grounds.**

Proposed modification:

The Rule may be modified as follows:

55(3). On consideration of the representation, the Controller shall first decide the maintainability of the representation by ascertaining prima facie validity of the submissions and/or pleadings in the statement of representation made on grounds under Section 25(1) and thereafter if the Controller is of the opinion that application for patent shall be refused or the complete specification requires amendment, he shall give a notice to the applicant to that effect.

Draft Rule 55(6):

“55(6). After considering the representation and submission made during the hearing if so requested, the Controller shall proceed to either reject the representation and granting the patent or accepting the representation and refusing the grant of patent on that application, ordinarily within three months from completion of above proceedings.”

Comments:

The scope of this sub-rule ***overlaps and/or is similar*** to the scope of sub rule 5. In order to avoid confusion, this sub-rule may be deleted.

Proposed Modification:

Delete/omit draft sub-rule 6.

Draft Rule 55(8):

“55(8). An application for a patent, in which a representation for opposition has been filed and found maintainable, shall be examined in accordance with rule 24C”

Comments:

While the new sub rule 8 is a welcome change in terms of expediting the application disposal process, the scope may be modified to make the application *eligible* for expedited examination in accordance with rule 24C.

Proposed modification:

The Rule may be modified as follows:

55(8). An application for a patent, in which a representation for opposition has been filed and found maintainable, shall be examined, if so requested, in accordance with rule 24C.

Draft Rule 138:

"138. Power to extend time prescribed.- (1) The time prescribed by these Rules for the doing of any act or the taking of any proceeding thereunder may be extended by the Controller for a period of up to six months, if he thinks it fit to do so and upon such terms as he may direct.

(2) Any request for extension of time under this rule shall be made in Form 4 before the expiry of the period of up to six months mentioned in sub-rule."

Comments:

The modification with respect to extension of time is a welcome change, but sub-rule (2) is not very clear. It will be helpful if sub-rule (1) is mentioned in sub-rule (2) to avoid any confusion in the future.

Additionally, if persons with disabilities are seeking extensions of time to convert documents or review large sets of documents/cases in patent proceedings, extensions may be granted as per the Guidelines for Accessibility and Reasonable Accommodations issued by the Office of Controller General of Patents, Designs and Trademarks (CGPD TM). Such extensions may be granted based on an application for accessibility for which no fee may be prescribed as requiring payment of fee under Form 4 for this

purpose would amount to unequal treatment. Furthermore, the six (6) month timeline provided in Rule 138 may be made available in addition to the extensions provided based on accessibility/accommodations requests. A format of the accessibility/accommodations form that may be adopted through the Amended Patent Rules has been provided hereunder.

Proposed modification:

The Rule may be modified as follows:

138. Power to extend time prescribed.-

(1) The time prescribed by these Rules for the doing of any act or the taking of any proceeding thereunder may be extended by the Controller for a period of up to six months, if he thinks it fit to do so and upon such terms as he may direct.

(2) Any request for extension of time under sub-rule (1) shall be made in Form 4 before the expiry of the period of up to six months mentioned in sub-rule (1) of this Rule.

(3) The time prescribed by these Rules for the doing of any act or the taking of any proceeding thereunder may be extended by the Controller for a period of up to three (3) months if such an extension is required to facilitate accessibility, or to provide reasonable accommodations for persons with disabilities, upon such terms as he may direct.

(4) Any request for extension of time under sub-rule (3) shall be made in the accessibility or reasonable accommodation application form prescribed for this purpose.

Proposed Accessibility Form for Rule 138:

ACCESSIBILITY APPLICATION FORM

Name of the Patent Agent: _____

Patent Agent No.: _____

Patent Application/Grant Number: _____

Disability Information

Nature of Disability: _____

UDID No.: _____

Accommodation(s)/Accessibility Required (Please tick or highlight the relevant boxes):

- a. Request for accessible documents from the Controller of Patents.
- b. Request for extension of time if documents are not provided or uploaded in accessible formats.
- c. Request to submit documents through an accessible filing system such as by email to the Controller of Patents if the online filing system is not accessible.
- d. Request to conduct hearing on an accessible platform such as MS Teams, Zoom, or Google Meet.
- e. Request for adjournment of a hearing for accessibility reasons.
- f. Request for extension of timelines to carry out an activity for accessibility reasons.
- g. Other accommodations: _____

Signature:

Date:

Draft Form 1:

Given the ongoing debate about inventorship of Artificial Intelligence, we believe that this may be a good opportunity to clarify that only Natural Persons are eligible to be names as inventors. Towards this end, we propose a modification in Form 1 to reflect the fact that only Natural Persons can execute Form 1 as inventors. The form may be appropriately modified to reflect the same.

About BananaIP:

BananaIP's Attorneys have been filing & prosecuting patent applications over the last 20 years. The comments in this document are based on their experience in the field, ongoing research activities, and expertise in Patent Law.

Contact information:

Given the opportunity, we will be happy to give a presentation/clarifications regarding the comments in this document. For any questions/clarifications regarding the document, please feel free to contact us on: patent@bananaip.com and/or on +91-80-49536207/+91-80-26860414/24/34.