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23-May-2016

Dear Colleagues,

## NEWS FLASH

### Re: INDIA - The Patents (Amendment) Rules, 2016

Patents (Amendment) Rules, 2016 were published on 16th May 2016 by the Government of India, Ministry of Commerce and Industry (Department of Industrial Policy and Promotion) and were made effective from the date of publication. The following major changes have been implemented in a haste.

#### Filing of Documents

1. No correspondence to or from the Patent Office will be via "courier service". Registered Post and Speed Post (EMS) only may be used.
2. A patent agent must file all documents only by electronic format, via a dedicated Patent Office E-filing module, which has to be duly authenticated by a digital signature. This includes scanned copies of documents that are to be submitted in original. The original documents must be submitted within 15 days. The following documents are required to be now

submitted by the Patent Agent in original after filing them electronically :

- Power of Authority
  - Proof of Right to make an application (Assignment from inventors to applicant)
  - Deed of assignment, certificate regarding change in name of the applicant, license agreement, etc.
  - Declaration regarding inventorship
  - Priority document
3. The Controller may condone the delay in transmitting or resubmitting documents to Patent Office if a petition for such condonation of delay is made along with a statement regarding fact and evidence in support of the statement that the delay was due to a general unavailability of electronic communication services amongst other reasons.
  4. Liability or burden of proof regarding authenticity of any document filed, including electronically transmitted documents, shall lie only with the party filing such document.

### **Power of Authority**

5. Power will have to be submitted within 3 months of the Patent application filing date, failing which no action will be taken for further processing of the application.

### **Refund of Fees**

6. For online filing, if fee has been paid more than once, then excess fee will be refunded. However, if any excess fee is paid in the same transactions, then it shall not be refunded.
7. Upon withdrawal of an application for which request for examination has been filed but before issuance of the First Examination Report, 90% of the fee may be refunded on a request made on Form 29.

### **Forms**

8. A specific Form 30 has been provided for any purpose for which no form has been specified.

### **Specification**

9. Reference numerals must be incorporated in description and claims.

### **Amendment to Specifications**

10. When amendments are made, the pages incorporating such amendments shall be retyped and submitted to form a continuous document.
11. A marked up copy clearly identifying the amendments carried out and a statement clearly indicating the portion (page number and line number) of the specification or drawing being amended along with the reason shall also be filed.
12. Amendments shall not be made by slips pasted on, or as footnotes or by writing in the margin of any of the said documents.
13. When a retyped page or pages incorporating amendments are submitted, the corresponding earlier page shall be deemed to have been superseded and cancelled by the applicant.

### **Amendment/Deletion of claims at the time of entering national phase into India**

14. No amendment of specification is possible at the time of national phase entry into India. Only deletion of claims at the time of national phase entry is now possible, by filing request for amendment and submitting marked up copy and statement, as indicated above.

### **Examination of application - Time limit for grant reduced**

15. Time for putting an application in order for grant will be 6 months from the date on which the first statement of objection (First Examination Report) is issued. This period was 12 months earlier. The time for putting the application in order for grant in cases where First Examination Report has been issued before 16 May 2016 shall remain 12 months from the date on

which the said Examination Report was issued. The time for putting an application in order for grant in cases where First Examination Report has been issued on or after 16 May 2016 shall be 6 months from the date on which the said First Examination Report is issued.

16. Where the parent application has already been examined, a request for examination for a divisional application will have to be filed while filing the divisional application.
17. The time for putting an application in order for grant may be extended by three months by filing a request on Form 4 along with extension fee of Rs. 4000 per month. The request for extension must be filed before expiry of the six months period.

### **Request for Withdrawal**

18. The Patent Office has now introduced a provision where the applicant may withdraw the application by filing Form 29 after filing request for examination but before the First Examination Report is issued on the application, in which case 90% of the examination fee shall be refunded. [Official fee paid before 16th May 2016 in respect of filing request for examination may not be refunded]

### **Hearings**

19. Hearings may be conducted by video conferencing or other audio-visual communication devices. [Not expected to be implemented any time soon]
20. Written note must be submitted via the e-filing module, pursuant to a Hearing within 15 working days from the Hearing date. This has to be strictly followed as no written note will be accepted if filed later than 15 days from the hearing date.
21. Adjournment of Hearing is possible if requested at least 3 working days before the Hearing date and by paying prescribed fee of Rs. 5000 per extension. Hearing can not be adjourned more than twice and each adjournment shall not be for more than 30 days.

### **Pre Grant Opposition**

22. Pre grant opposition can only be filed along with Form 7A.

23. Copy of reply statement filed by the applicant must also be provided to the opponent. Earlier this was not required. Documents may be served to the opponent using registered mail and speed post mail (EMS), but not courier.
24. The Controller, after hearing the pre grant opposition, may either reject the representation or require the complete specification or other documents to be amended before the patent is granted or refused and must also simultaneously carry out the examination of the application and decide on the application within one month from the completion of the proceedings.

### **Urgent supply of certified copies and certificates**

25. Certified copies can now be obtained expeditiously ordinarily within a period of one week by paying Rs. 12000, as opposed to Rs. 5000 for normal request for certified copies.

### **No extension of time will be possible for the following :**

26. For extending national phase entry deadline
27. For extending the time prescribed to file translation of specification
28. For extending the time prescribed to file translation of priority documents
29. For extending the time prescribed for filing response to First Examination Report and Request for examination
30. For extending the time prescribed for filing reply statement in a pre grant opposition
31. For further extension beyond six months already allowed for renewal fee payment
32. For extending the time prescribed for review of Controller's decision

### **Some other changes in Fee Schedule**

33. Reduced official fee for online filing or E-filing will have to be paid.
34. Page fee for sequence listing has been made applicable @ US\$ 12 per sequence listing page upto a maximum cap of US\$ 1818.

### **New data required for incorporating in Application Form**

35. IPC classification of priority application.

Our office is fully geared and capable to handle the new system. In the meanwhile, we have located and reported to the Patent Office over 60 issues, errors, glitches and problems in the E-filing module, most of which are being rectified. We are continuing to file new patent applications including divisional applications through the E-filing module. All work is being handled without any interruption. The Indian Patent Office is co-operating closely with us in solving the issues which are arising. With 4 self owned offices in Delhi, Pune, Chennai and Calcutta, we are able to file, prosecute, make amendments, record assignments and changes, pay for renewals as well as attend hearings in all jurisdictions with ease.

Best Regards,

Sudhir D. Ahuja  
**D.P. AHUJA & CO.**

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