

Patent Rules, 2003: Ushers in the Patent (Amendment) Act 2002

Wednesday, July 09, 2003 08:00 IST
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It is time to sit up and take note. After 7 years of driving on the TRIPs highway, our lawmakers are learning to put the "horse before the cart" and riding it in style.

The January 1, 1995, notification for the first Amendment had fallen through to surface in 1999. While the second Amendment of 1999 did not get to the Gazette till 2002, the corresponding Rules of 1999 had got prematurely notified. Consequently the Patents (Amendment) Act, 2002 had to wait for a fresh release of Patent Rules. The Draft Rules were notified in 2002. Thereafter, objections were received and studied leading to the Patent Rules, 2003 being notified in Gazette on May 1, 2003. There was still the attendant uncertainty. There was no mention of the effective date for the Act and the Rules. Now, the Government has notified the date on which the Patents (Amendment) Act 2002 and the Patent Rules, 2003, comes into force as May 20, 2003.

This announcement has brought smiles on the face of a few and consternation for many. Patent Life has now got extended to 20 years. All patents including pharma patents (which earlier had life of 5 years from date of sealing or 7 years from date of grant) will now enjoy protection for 20 years from the date of application or date of priority. Those patents who have even one day remaining of valid protection (out of the 7 years for pharma or 14 years for general category), will now get the extension of life for remaining period of 20 years. This is indeed a bonus worth a smile, of course at a cost (of maintaining year after year).

Government fees and levies only go up and never come down? Only Indian Airlines and Jet can give Apex Fares? The Patent application fees can also come down and Patent Rules have announced just that. For single priority applicants fees has come down in case of individual (natural persons) applicants from Rs.1,500/- to Rs.750/- and in case of corporates from Rs.5,000/- to Rs.3,000/-. For every additional priority similar fees will need to be paid.

For the first time in India, examination of complete applications cease to be automatic from 20th May 2003. All unexamined applications, will be abandoned, if request for examination is not filed within 48 months of application. Request for examination in Form-19 will need to be accompanied by a fee of Rs.1,000/- by natural persons and Rs.3,000/- by corporates. However, there is a small hitch here. The request for examination can be made by any "interested person". It may have been a well-intended provision to allow over and above the authorized agent, the applicant or any of the inventors to apply for examination with proof of interest. Questions prop up, if an opponent or a person keen to shoot down the patent applied as an "interested person"?

Here the "common sense" discretion of the Controller comes into play. In the absence of clear guidelines, this provision could keep the Patent Office running for cover. This amendment was incidentally, introduced between the Draft Rules and Final Rules.

Another exciting impact effective May 20, 2003 is that all pending applications will be published in 18 months (This is another first). Till now applications were published only after acceptance. This opens up enormous opportunities and new challenges. Interested persons could apply to the Patent Office, on payment of fees, to examine the full application, once the abstract and other details are published on 18 months.

For the first time, PCT (Patent Co-operation Treaty) has come into our lives through these amendments. Various PCT provisions have been incorporated into the Rules, 2003. In line with our commitments to international treaties, the new rules confirm "in case of conflict between the Indian Patent Rules provisions and the PCT provisions, the PCT provisions shall apply in relation to International applications".

The lawmakers need special compliments this time. The "Rule - Drafters" have shown that they are sensibly responsive to genuine and constructive suggestions. Without any "complex" or lack of self-confidence, the draft Rules have been amended extensively to accommodate the suggestions made from the field. For the first time large number of "road-shows" and get-togethers (even at the cost of the patent office) were held. The Patent Controllers went to meet Industry Associations to elicit their views. It was not just a formality. Many of the suggestions found place in the final notification. Examples are innumerable (about 30 to 40).

The most important indication that "law" is trying to bridge the gap with "technology", is visible in the new Patent Rules. Between the draft rules and final Rules, the provisions have been incorporated for "electronic transmission duly authenticated". Now the Patent Office is truly gearing up to meet the challenges of the new emerging era.