

# **INDUSTRIAL PROPERTY RULES, 2001**

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## **INDUSTRIAL PROPERTY RULES, 2001**

### **PRELIMINARY :**

#### **1. Short Title and Entry into Force**

These Rules may be cited as the Industrial Property Rules, 2001, and they shall come into force on the date the Regulations come into force.

#### **2. Interpretation**

In these rules, unless the context otherwise requires,

- (i) “Section” refers to the specified section of the Regulations
- (ii) “Registrar” means the Head of the Industrial Property Registry appointed in accordance with Section 36 (2);
- (iii) “Rules” means these Rules

#### **3. Fees**

The fees to be paid in respect of matters arising under the Regulations or the Rules shall be those specified in the Schedule of Fees in Schedule I annexed to and forming part of these Rules.

#### **4. Forms**

- (i) The forms referred to in these Rules are those set out in Schedule II annexed to and forming part of these Rules.
- (ii) Copies of the printed forms shall be provided free of charge by the Registrar.

#### **5. Language of Documents and Translations**

Applications shall be in the English language, and any document forming part of an application or submitted to the Registrar pursuant to the Regulations or these Rules which is in a language other than English shall be accompanied by a translation into English.

**6. Indication of Name, Address, Nationality and Residence**

- (1) Names of natural persons shall be indicated by the person's family name and given name(s), the family name being indicated before the given name(s); the names of legal entities shall be indicated by their full, official designations.
- (2) Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, shall consist of all the relevant administrative units, including the house number, if any; addresses shall also indicate telegraphic and telex addresses and facsimile and telephone numbers.
- (3) Nationality shall be indicated by the name of the State of which a person is a national; legal entities shall indicate the name of the State under whose laws they are constituted and their Registered Office.
- (4) Residence shall be indicated by the name of the State of which a person is a resident.

**7. Signature by Partnerships, Companies and Associations**

- (1) A document purporting to be signed for or on behalf of a partnership shall contain the names of all the partners in full and shall be signed by all the partners or by any partner qualified to sign, stating that he signs on behalf of the partnership, or by any other person who satisfies the Registrar that he is authorized to sign the document; a document purporting to be signed for or on behalf of a body corporate shall be signed by a director or by the secretary or other principal officer of the body corporate or by any other person who satisfies the Registrar that he is authorised to sign the document and shall bear the seal of the body corporate; a document purporting to be signed for or on behalf of an association of persons may be signed by any person who satisfies the Registrar that he is duly authorized.
- (2) The Registrar may, whenever he deems it necessary, request evidence of authorization to sign.

**8. Representation by Agent**

The power of attorney appointing an agent may be filed together with the application or within two months from its filing date; if the appointment is not thus made and is not in accordance with Section 35 and Rule 53, any procedural steps taken by the agent, other than the filing of the application, shall be deemed not to have been taken.

**PART I : PATENTS**

**APPLICATION AND PROCEDURE FOR GRANT OF PATENTS**

**9. Classification of Patents**

The Registrar shall apply the International Patent Classification, as adopted under the Strasbourg Agreement of March 24, 1971 and updated in its subsequent editions, for all purposes relating to the grant and publication of patents, as well as for the maintenance of classified search files.

**10. Request for Grant of Patent**

- (1) The request for the grant of a patent shall be made on Form No.1 and shall be signed by each applicant.
- (2) The request shall indicate each applicant's name, address, nationality and residence.

- (3) Where the applicant is the inventor, the request shall contain a statement to that effect, and where he is not, it shall indicate each inventor's name and address and be accompanied by the statement justifying the applicant's right to the patent.
- (4) If the applicant is represented by an agent, the request shall so indicate and state the agent's name and address.
- (5) The title of the invention shall be short (preferably from two to seven words) and precise.

## **11. Description**

- (1) the description shall first state the title of the invention as appearing in the request and shall
  - (i) specify the technical field to which the invention relates;
  - (ii) indicate the background art which, as far as known to the applicant, can be regarded as useful for the understanding of the invention, and, preferably, cite the documents reflecting such art;
  - (iii) disclose the invention in such terms that it can be understood and state its advantageous effects, if any, with reference to the background art;
  - (iv) briefly describe the figures in the drawings, if any;
  - (v) set forth at least one mode for carrying out the invention; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any;
  - (vi) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is industrially applicable and the way in which it can be made and used, or, if it can only be used, the way in which it can be used.
- (2) The manner and order specified in paragraph (1) shall be followed except when, because of the nature of the invention, a different manner or a different order would result in a better understanding and a more concise presentation.

## **12. Claims**

- (1) The number of the claims shall be reasonable taking into account the nature of the invention; if there are several claims, they shall be numbered consecutively in Arabic numerals.
- (2) The claims shall define the invention in terms of the technical features of the invention.
- (3) Whenever appropriate, claims shall contain :
  - (i) a statement indicating those technical features of the invention which are necessary for the definition of the latter but which, in combination, are part of the prior art;
  - (ii) a characterizing portion-- preceded by the words "characterized in that," "characterized by," "wherein the improvement comprises," or any other words to the same effect-- stating concisely the technical features which, in combination with the features stated under (i), it is desired to protect.
- (4) Claims shall not, except where absolutely necessary, rely in respect of the technical features of the invention on references to the description or drawings; in particular, they shall not rely on such references as "as described in part ...of the description," or "as illustrated in figure...of the drawings."

- (5) Where the application contains drawings, the technical features mentioned in the claims shall preferably be followed by the reference signs relating to such features; when used, the reference signs shall preferably be placed between parentheses; if inclusion of reference signs does not particularly facilitate quicker understanding of a claim, it should not be made.
- (6) The deletion of any claim previously appearing in the application shall be made by indicating the number of the previous claim followed by the word “cancelled”.

### 13. Drawings

- (1) Drawings forming part of an application for a patent shall be on sheets the usable surface area of which shall not exceed [26.2 cm by 17 cm]. The sheets shall not contain frames round the usable of used surface. The minimum margins shall be as follows :

top	-	2.5 cm
left side	-	2.5 cm
right side	-	1.5 cm
Bottom	-	1.0 cm

- (2) Drawings shall be executed as follows :
  - a) Without colouring in durable, black sufficiently dense and dark, uniformly thick and well defined lines and strokes to permit satisfactory reproduction;
  - b) Cross-section shall be indicated by hatching which does not impede the clear reading of the reference signs and leading lines;
  - c) The scale of the drawings and the distinctness of their graphical execution shall be such that a photographic reproduction with a linear reduction in size to two-thirds would enable all details to be distinguished without difficulty. If, as an exception, the scale is given on a drawing it shall be represented graphically;
  - d) All numbers, letters and reference signs appearing in the drawings shall be simple and clear and brackets, circles and inverted commas shall not be used in association with numbers and letters;
  - e) Elements of the same figure shall be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the figure;
  - f) The height of the numbers and letters shall not be less than [0.32 cm] and for the lettering of drawings, the Latin and, where customary, the Greek alphabets shall be used;
  - g) The same sheet of drawings may contain several figures. Where figures drawn on two or more sheets are intended to form one whole figure, the figures on the several sheets shall be so arranged that the whole figure can be assembled without concealing any part of the partial figures.

The different figures shall be arranged without wasting space, clearly separated from one another. The different figures shall be numbered consecutively in Arabic numerals, independently of the numbering of the sheets;

- h) Reference signs not mentioned in the description or claims shall not appear in the drawings, or vice versa. The same features, when denoted by reference signs, shall, throughout the application, be denoted by the same signs;
- i) the drawings shall not contain textual matter, except, when required for the understanding of the drawings, a single word or words such as “water” “stream”, “open”, “closed”, “section on AA” and in the case of electric circuits and block

schematic or flow sheet diagrams, a few short catchwords;

j) The sheets of the drawings shall be numbered in accordance with Rule 16 (7) below).

(3) Flow sheets and diagrams are considered drawings.

#### **14. Abstract**

(1) The abstract shall be so drafted that it can efficiently serve as a scanning tool for purposes of searching in the particular art.

(2) The abstract shall consist of the following :

(i) a summary of the disclosure as contained in the description, the claims, and any drawings, indicating the technical field to which the invention pertains and drafted in a way which allows the clear understanding of the technical problem through the invention and the principal use or uses of the invention; and

(ii) where applicable, the chemical formula which, among all the formulae contained in the application, best characterizes the invention.

(3) The abstract shall be as concise as the disclosure permits (preferably 50 to 150 words).

(4) The abstract shall not contain statements on the alleged merits or value of the invention or on its speculative application.

(5) Each main technical feature mentioned in the abstract and illustrated by a drawing in the application shall be followed by a reference sign, placed between parentheses.

(6) The abstract shall be accompanied by the most illustrative of any drawings furnished by the applicant.

#### **15. Measures, Terminology and Signs**

(1) Units of weights and measures shall be expressed in terms of the metric system.

(2) Temperatures shall be expressed in degrees centigrade (Celsius).

(3) Density shall be expressed in metric units.

(4) For indications of heat, energy light, sound, and magnetism, as well as for mathematical formulae and electrical units, rules in general use shall be observed; for chemical formulae, the symbols, atomic weights, and modular formulae, in general use, shall be employed.

(5) In general, only such technical terms, signs and symbols should be used as are generally accepted in the art.

(6) The terminology and the signs shall be consistent throughout the application.

#### **16. Number of Copies and Physical Requirements**

(1) Subject to Rule 20(7), the application and any accompanying statements or documents shall be filed in three copies, but the Registrar may require the applicant to supply additional copies.

(2) All elements of the application shall be so presented as to admit of direct reproduction by photography, electrostatic processes, photo offset and microfilming.

(3) Only one side of each sheet contained in the application shall be used.

- (4) All elements of the application shall be on paper which is flexible, strong, white, smooth, non-shiny and durable.
- (5) The size of the sheets shall be [A4(29.7cm x 21cm)], although the Registrar may accept sheets of other sizes.
- (6) The minimum margins of sheets shall be as follows :
  - (i) upper margin of each page, except the first page: 20 mm
  - (ii) upper margin of the first page: 30 mm
  - (iii) side margin adjacent to the binding: 25 mm
  - (iv) other side margin: 20 mm
  - (v) bottom margin: 20 mm
- (7)
  - (a) All sheets shall be numbered at the top of the sheet, in the middle, in consecutive Arabic numerals.
  - (b) In effecting the sequential numbering of the sheets, the elements of the application shall be placed in the following order : the request, the description, the claims, the abstract, the drawings.
  - (c) The sequential numbering of the sheets, shall be effected by using three separate series of numbering, the first series applying to the request only and commencing with the first sheet of the request, the second series commencing with the first sheet of the description and continuing through the claims until the last sheet of the abstract, and the third series being applicable to the sheets of the drawings only and commencing with the first sheet of the drawings.
- (8) The text matter of the application shall be typed; graphic symbols, chemical or mathematical formulae and certain characters if necessary, may be handwritten or drawn.
- (9) Drawings shall be executed in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes without colouring.

**17. Unity of Invention**

- (1) Section 8 (1) shall be construed as permitting, in particular, one of the following three possibilities :
  - (i) in addition to an independent claim for a given product, the inclusion in the same application of an independent claim for a process specially adapted for the manufacture of the said product and the inclusion in the same application of an independent claim for a use of the said product; or

- (ii) in addition to an independent claim for a given product, the inclusion in the same application of an independent claim for a process specially adapted for the manufacture of the product, and the inclusion in the same application of an independent claim for an apparatus or means specifically designed for carrying out the said process;
  - (iii) in addition to an independent claim for a given product, the inclusion in the same application of an independent claim for an apparatus or means specifically designed for carrying out the said process; or
- (2) Subject to the Section 8 (1), it shall be permitted to include in the same application two or more independent claims of the same category which cannot readily be covered by a single generic claim.
  - (3) Subject to the Section 8(1), it shall be permitted to include in the same application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim.

**18. Division of Application**

- (1) A divisional application shall contain a reference to the initial application.
- (2) If the applicant wishes a divisional application to benefit from any priority claimed for the initial application, the divisional application must contain a request to that effect; in such a case, the declaration of priority and the documents furnished in accordance with Rule 20 for the initial application shall be deemed to relate also to the divisional application.
- (3) Where the priorities of two or more earlier applications were claimed for the initial application, a divisional application may benefit only from the priority or priorities that are applicable to it.

**19. Disclosures to be Disregarded for Prior Art Purposes**

An applicant who wishes a disclosure of the invention to be disregarded, in accordance with Section 5 (2) (c), for prior art purposes, shall so indicate on the application and shall furnish, in writing, with the application or within one month of filing the application, full particulars of the disclosure; where the disclosure was made at an exhibition, the applicant shall file, within the same period, a duly authenticated certificate issued by the authority responsible for the exhibition containing particulars of the exhibition and stating that the invention was in fact exhibited there.

**20. Declaration of Priority and Translation of Earlier Application**

- (1) The declaration referred to in Section 6(1) shall indicate :
  - (i) the date of the earlier application;
  - (ii) the number of the earlier application, subject to paragraph (2)
  - (iii) the symbol of the International Patent Classification, if any, which has been allocated to the earlier application, subject to paragraph (3)
  - (iv) the State in which the earlier application was filed or, where the earlier application is a regional or an international application, the State or States for which it was filed.
  - (v) where the earlier application is a regional or international application, the Office with which it was filed.
- (2) Where at the time of filing the declaration referred to in paragraph (1) the number of the earlier application is not known, that number shall be furnished within three months from the date on which the application containing the declaration was filed.

- (3) Where a symbol of the International Patent Classification has not been allocated to the earlier application, or had not yet been allocated at the time of filing the declaration referred to in paragraph (1), the applicant shall state this fact in the said declaration and shall communicate such symbol as soon as it has been allocated.
- (4) The applicant may, at any time before the grant of the patent, amend the contents of the declaration referred to in paragraph (1) hereof.
- (5) The period for furnishing the certified copy of the earlier application, referred to in Section 9 (2), shall be three months from the date of the request by the Registrar; where a copy has already been furnished for another application, the applicant may respond by making a reference to that other application.
- (6) Where the earlier application is in a language other than English, the applicant shall within six months from the aforementioned request furnish a translation in English of the earlier application.
- (7) Unless the Registrar requests otherwise, the earlier application and any translation thereof shall be filed in one copy.

**21. Time for Furnishing Information Concerning Corresponding Foreign Applications, Patents and Other Titles of Protection**

- (1) The time limits to be specified for furnishing the information requested under Section 10 shall not be less than two or more than six months from the date such a request is made; upon a reasoned request by the applicant, the Registrar may extend such time limit.
- (2) If the applicant replies that the documents requested under Section 10 are not yet available, the Registrar may suspend the procedure for the examination of the application until such time as the documents are furnished.

**22. Withdrawal of Application**

- (1) The application shall be withdrawn by written declaration submitted to the Registrar and signed by each applicant.
- (2) The application fee shall not be refunded if the application is withdrawn.

**23. Marking Application**

- (1) Upon receipt, the Registrar shall mark, on each document making up the application, the actual date of receipt and the application number consisting of the letters BT, slant, the letter "P", slant, the last two numbers of the year in which the initial papers were received, slant, and a five-digit number allotted in the sequential order in which applications are received; where any corrections or other later filed documents are received on different dates, of the Registrar shall also mark their actual date of receipt in the appropriate place of the request for grant of the patent on Form No. 1.
- (2) The application number allotted under paragraph (1) shall be quoted in all subsequent communications concerning the application.

**24. According and Notifying Filing Date**

- (1) The Registrar shall examine whether the application fulfills the requirements of Section 11 (1) (a).
- (2) The invitation to file any correction, under Section 11(1)(b), shall be in writing; it shall specify the correction or corrections required and request that these be filed within two months from the

date of invitation, together with the payment of the prescribed fee.

- (3) Once the Registrar accords a filing date, he shall notify the applicant in writing; if the application is treated as if it had not been filed, under Section 11(1)(b), the Registrar shall notify the applicant in writing, specifying the reasons.

**25. Examination as to Form**

- (1) In addition to the requirements of Section 7(1) and (2) and the Rules pertaining thereto, the requirements of Section 34 and Rules 5, 6, 7, 8, 15 and 16, to the extent applicable, shall be considered formal requirements for the purposes of the Regulation.
- (2) Where the Registrar finds that the conditions referred to in Section 11(3) are not fulfilled, he shall invite the applicant, in writing, on Form 2 to file the required correction within two months from the date of the invitation, together with the payment of the prescribed fee; if the applicant does not comply with the invitation to correct a deficiency, or where, despite the corrections submitted by the applicant, the Registrar is of the opinion that the conditions referred to in Section 11(3) are not fulfilled, he shall reject the application and notify the applicant, in writing, stating the reasons.
- (3) Rejection of the application shall not affect its filing date which shall remain valid.

**26. Grant of Patent; Publication of Reference Thereto; Issuance of Certificate**

- (1)
  - (a) The Registrar shall notify the applicant, in writing, of his decision to grant a patent, requesting the applicant to pay the grant and publication fee within three months from the date of the notification.
  - (b) Subject to the payment of the grant and publication fee within the period prescribed in paragraph (a), the Registrar shall grant the patent in accordance with Section 12 and this Rule.
- (2)
  - (a) The Registrar shall allot to each patent he grants a number (i.e., publication number of the patent) in the sequential order of grant.
  - (b) The patent shall be granted on Form No. 3 and shall contain, in addition to the information indicated in paragraph (3), the date of publication of the patent, the documents or references cited of the prior art, the description, the claims and the drawings, if any.
  - (c) The patent shall be deemed to be granted on the date the Registrar publishes a reference to the grant in accordance with Section 12 (2)(i).
- (3) The publication of the reference to the grant of the patent shall include :
  - (i) the number of the patent;
  - (ii) the name and address of the owner of the patent;
  - (iii) the name and address of the inventor, except where he has asked not to be named in the patent;
  - (iv) the name and address of the agent if any;
  - (v) the filing date and number of the application;

- (vi) if priority has been claimed and the claim has been accepted, a statement of the priority, the priority date and the name of the country or countries in which or for which the earlier application was filed;
  - (vii) the effective date of grant of the patent;
  - (viii) the title of the invention;
  - (ix) the abstract;
  - (x) the most illustrative of the drawings, if any; and
  - (xi) the symbol of the International Patent Classification if indicated.
- (4) The certificate of grant shall be issued on Form 4, shall be signed by the Registrar and shall contain :
- (i) the number of the patent;
  - (ii) the name and address of the owner of the patent;
  - (iii) the filing date and, where applicable, priority date of the application;
  - (iv) the effective date of grant of the patent; and
  - (v) the title of the invention.

**27. Exploitation of Patented Invention by Government or by Third Persons Authorized by Government**

- (1) The Minister shall, before making a decision under Section 15, consult the Registrar, and give the owner of the patent, beneficiaries of non-voluntary licenses, and any other persons whose participation he considers useful, at least 21 days' written notice of the date on which they may be heard; the owner of the patent shall give all licensees written notice of the hearing and they shall have the right to participate therein.
- (2) The Minister shall make his decision after the hearing, in writing, stating the grounds upon which it is based, and, if he has decided that the invention shall be exploited under Section 15(5), stating the terms of exploitation, and shall transmit the decision to the Registrar.
- (3) The Registrar shall record and publish the decision of the Minister and notify, in writing, the owner of the patent and the other participants in the hearing.
- (4) If the decision of the Minister with regard to remuneration is the subject of an appeal, the Registrar of the Court shall notify the Registrar of the Court's decision once it becomes final, and the Registrar shall record the decision and publish it.

**28. Annual Fees**

- (1) Upon payment of an annual fee in accordance with Section 14(2), the Registrar shall, within two weeks from the date payment is received, furnish or send to the applicant or to the owner of the patent a receipt of payment.
- (4) The Registrar shall record and publish a notification of the lapse of a patent.
- (3) Annual fees shall not be refundable.

**29. Invalidation**

- (1) Where the provisions of Section 16 (2) apply only to some of the claims or some parts of a claim, such claims or parts of a claim shall be invalidated.
- (2) The patent owner shall, in writing, notify any licensee of any Court proceeding instituted for the invalidation of the patent; and, where the ground of invalidity invoked is that the patent owner is not the inventor or his successor in title, also the person alleged to have the right to the patent.

## **PART II : INDUSTRIAL DESIGNS**

### **30. Application of Provisions Relating to Patents**

Rules 20 to 23, shall apply, *mutatis mutandis*, to industrial designs and for this purpose the letter “P”, in Rule 23, shall be read as the letter “D”.

### **31. Application for Registration of an Industrial Design**

- (1) The application for the registration of an industrial design shall be made on Form 5 and shall be signed by each applicant.
- (2) The application shall indicate each applicant’s name, address, nationality and residence.
- (3) Where the applicant is the creator, the request shall contain a statement to that effect, and, where he is not, it shall indicate each creator’s name and address and be accompanied by the statement justifying the applicant’s right to the registration of the industrial design.
- (4) If the applicant is represented by an agent, the request shall so indicate and state the agent’s name and address.

### **32. Number and Size of Representation and Specimen**

- (1) The application shall be accompanied by the following :
  - (i) if the industrial design is two-dimensional, by four graphic representations or four drawings or tracings; or
  - (ii) if the industrial design is three-dimensional, by four graphic representations or four drawings or tracings of each of the different sides of the industrial design; and
- (2) A specimen shall be of a size not exceeding [20 centimetres x 20 centimetres x 20 centimetres]. No graphic representation, drawing or tracing of the industrial design shall exceed [10 centimetres x 20 centimetres]. Such representations, drawings or tracings, shall be affixed on four sheets of hard and durable paper of [A4 size]. Drawings and tracings shall be in black ink.

### **33. According and Notifying Filing Date; Examination; Decision to Grant or Refuse Application**

- (1) The Registrar shall examine whether the application fulfills the requirements of Section 20(1).
- (2) (a) If the Registrar finds that the application did not, at the time of receipt, fulfill the requirements referred to in paragraph (a), he shall invite the applicant to file the required correction and shall accord as the filing date the date of receipt of the required correction, but if no correction is made, the application shall be treated as if it had not been filed.

- (b) The invitation to file any correction, under paragraph (a), shall be in writing; it shall specify the correction or corrections required and request that these be filed within two months from the date of the said invitation, together with the payment of the prescribed fee.
- (3) Once the Registrar accords a filing date, he shall so notify the applicant in writing; if the application is treated as if it had not been filed, under paragraph (2) (a), the Registrar shall notify the applicant in writing, specifying the reasons.
- (4) Where the Registrar finds that the requirements set out in Sections 17, 18, and 20(1) and (2) are not fulfilled, he shall invite the applicant, in writing, to file the required correction within two months from the date of the invitation, together with the payment of the prescribed fee; if the applicant does not comply with the invitation to correct deficiency, or where, despite correction submitted by the applicant, the Registrar is of the opinion that the said requirements are not fulfilled, he shall reject the application and notify the applicant, in writing, stating the reasons.
- (5) Refusal of the application shall not affect its filing date which shall remain valid.
- (6) The Registrar shall notify the applicant, in writing, of his decision to grant or to refuse the application, and, in the case of a decision to grant the application, he shall request the applicant to pay the registration and publication fee within one month from the date of the notification.

**34. Registration of Industrial Design; Publication of Reference Thereto; Issuance of Certificate**

- (1) Subject to the payment of the registration and publication fee within the period prescribed in Rule 33(6), the Registrar shall register the industrial design in accordance with Section 21(3) and this Rule.
- (2) The Registrar shall allot to each industrial design he registers a number in the sequential order of registration.
- (3) The registration of an industrial design shall include a representation of the industrial design and shall specify :
  - (i) the number of the industrial design;
  - (ii) the name and address of the registered owner;
  - (iii) the name and address of the agent, if any;
  - (iv) the name and address of the creator, except where he has asked not to be named in the registration;
  - (v) if the priority has been claimed, and the claim has been accepted, the priority date and the country or countries in which or for which the earlier application was filed; and
  - (vi) the kind of products for which the industrial design is to be used.
- (4) The publication of the reference to the registration of an industrial design, under Section 21 (3), shall contain the particulars specified in paragraph (3) hereof.
- (5) The certificate of registration of an industrial design shall be issued on Form 6.

**35. Renewal of Registration**

- (1) The renewal of the registration of an industrial design under Section 22(5) may be made by the registered owner or his agent during the six-month period preceding the expiry of the registration.

- (2) The renewal shall be made by payment of the renewal fee within the period specified in paragraph (1) hereof or, upon payment of the prescribed surcharge, within the grace period allowed under Section 22(5).
- (3) The renewal of an industrial design registration shall be recorded in the register and shall be published.
- (4) The Registrar shall issue to the registered owner a certificate of renewal which shall contain :
  - (i) the registration number of the industrial design;
  - (ii) the date of renewal and the date of expiry;
  - (iii) the name and address of the registered owner; and
  - (iv) an indication of the kind of products for which the industrial design has been registered.

### **PART III : MARKS**

#### **36. Classification of Marks**

The Registrar may apply the International Classification of Goods and Services for the Purposes of the Registration of Marks adopted by the Nice Agreement of June 15, 1957, as updated subsequently, for all purposes relating to the registration and publication of marks.

#### **37. Application for Registration of a Mark**

The application for the registration of a mark shall be made on Form 7 and shall be signed by the applicant or his agent. An application may be made for the registration of a mark in respect of goods or services in one or more classes of the International Classification, but when a single application relate to goods/services in more than one class, the fees payable shall be multiplied by the number of classes.

#### **38. Reproduction of the Mark**

- (1) The application shall contain a durable graphic reproduction of the mark in the space provided therefor on Form 7. Where the reproduction exceeds the space in size, it shall be mounted upon hard and durable paper. Part of the mounting shall be affixed in the space aforesaid and the rest may be folded. The reproduction should not be larger than A4 size, and should be of such quality as suitable for scanning and being stored on a computer file at a resolution of 300dpi.
- (2) With all applications for the registration of a mark, three additional reproductions of the mark shall be submitted. The reproduction of the mark on the application and the additional reproductions shall be identical. The additional reproductions shall in all cases be noted with all such particulars as may from time to time be required by the Registrar on Form 7 A. Such particulars shall, if required, be signed by the applicant or his authorized agent.
- (3) If the Registrar considers any reproduction of a mark unsuitable he may, at any time, require a suitable reproduction to be substituted.
- (4) Where a drawing or other reproduction cannot be given in the aforesaid manner, a specimen or copy of the mark may be sent either of full size or on a reduced scale and in such a form as the Registrar may consider appropriate.

#### **39. Transliteration and Translation of the Mark**

Where a mark consists of or contains a word or words in characters other than English the application on Form 7, and the additional reproductions of the mark on Form 7 A shall be accompanied, by a transliteration and translation of each of such words, stating the language to which each word belongs.

**40. Declaration of Priority and Translation of Earlier Application**

- (1) The declaration referred to in Section 26(2) shall indicate :
  - (i) the date of the earlier application,
  - (ii) the number of the earlier application, subject to paragraph 2; and
  - (iii) the State in which the earlier application was filed or, where the earlier application is a regional or an international application, the Office with which it was filed and the country or countries for which it was filed.
- (2) Where at the time of filing the declaration referred to in paragraph (1), the number of any earlier application is not known, that number shall be furnished within three months from the date on which the application containing the declaration was filed. The Registrar may extend the time limit referred to in this paragraph for an additional period of three months, if the applicant supplies evidence that, due to circumstances beyond his control, he was not able to comply within the prescribed time limit.
- (3) Where the priorities of two or more earlier applications are claimed, in accordance with paragraph (1), the indication relating to those earlier applications may be included in a single declaration.
- (4) The applicant may, at any time before the registration of the mark, amend the contents of the declaration referred to in the preceding paragraphs.

**41. Copy of Earlier Application**

The period for furnishing the certified copy of the earlier application referred to in Section 26(2)(a) shall be three months from the date of the requirement by the Registrar.

**42. Withdrawal of Application**

- (1) The withdrawal of the application shall be made by a written declaration signed by the applicant and submitted to the Registrar.
- (2) The application fee shall not be refunded if the application is withdrawn.

**43. Marking Application; Filing Date**

- (1) Rule 23 shall apply, *mutatis mutandis*, to marks and the letter “A” therein shall be read as the letter “M”.
- (2) The Registrar shall accord as the filing date of the application the date on which the following elements are received :
  - (i) the name of the applicant;
  - (ii) an address to which communications can be directed;
  - (iii) a reproduction of the mark
  - (iv) the list of goods and/or services for which the registration is sought
  - (v) the required filing fee.

- (3) The Registrar shall, in writing, notify the application number and the filing date, or issue a fee receipt indicating the application number and the filing date.

**44. Objection to or Conditional Acceptance of Application; Hearing**

- (1) If, upon examination in accordance with Section 27, the Registrar objects to the application for registration of a mark, he shall notify the applicant in writing of his objections with all the relevant details and invite the applicant to amend the application, to submit his observations in writing or to apply for a hearing within two months from the date of the notification. If the applicant does not comply with the invitation within the set period, he shall be deemed to have withdrawn his application.
- (2) If, upon examination in accordance with Section 27, the Registrar decides to accept the application subject to amendments, modifications, conditions, disclaimers or limitations, he shall communicate the decision to the applicant in writing. If the applicant objects to the amendments, modifications, conditions, disclaimers or limitations, he shall, within two months from the date of the communication, apply for a hearing or submit observations in writing. If the applicant does not object to such amendments, modifications, conditions, disclaimers or limitations, he shall notify the Registrar in writing and wherever necessary amend his application accordingly. If the applicant does not respond in one way or the other within the said period, he shall be deemed to have withdrawn his application.
- (3) The request for a hearing, which shall be accompanied by the prescribed fee, shall be made in writing on Form 8 to the Registrar who, upon receiving the same, shall give the applicant at least one month's notice in writing of the date and time when he may be heard.

**45. Refusal of Application or Conditional Acceptance to which Applicant Objects**

If, after a hearing or after consideration of the applicant's amendments or observations in writing, the Registrar refuses the application, he shall communicate his decision to the applicant in writing. The applicant may, within one month from the date of such communication, upon payment of the prescribed fee, request on Form 9, the Registrar to state in writing the grounds of his decision and the materials used by him in arriving thereat.

**46. Acceptance of Application; Publication; Supply of Printing Block**

- (1) If the Registrar accepts the application unconditionally or accepts it subject to any conditions or limitations to which the applicant does not object, he shall proceed to publish the application in the official bulletin setting out :
  - (i) the filing date and, where applicable, priority date;
  - (ii) the representation of the mark;
  - (iii) the goods or services in respect of which the registration of the mark is requested with an indication of the corresponding class or classes of the International Classification;
  - (iv) the name and address of applicant; and
  - (vi) the name and address of the local agent, if any, in the case of a foreign applicant;
  - (vii) and such other particulars as the Registrar may consider necessary.

- (2) For the purposes of the publication required under Section 27 and this Rule, the Registrar may, in writing, require the applicant to supply a printing block of such dimensions as he may consider appropriate.

**47. Opposition**

- (1) The notice of opposition under Section 27 (2)(b) shall be given by any person interested within three months from the date of the publication referred to in Rule 46 on Form No. 10, together with payment of the prescribed fee and accompanied by supporting evidence, if any.
- (2) The counter-statement referred to in Section 27(2)(c) shall be subject to payment of the prescribed fee and shall be given on Form 11 within two months from the date the notice of opposition is sent to the applicant, in writing, stating the grounds upon which the applicant relies for his application and accompanied by supporting evidence, if any.

**48. Registration of Mark; Publication of Reference thereto; Issuance of Certificate**

- (1) If the Registrar accepts the application unconditionally or accepts it subject to any conditions or limitations to which the applicant does not object, or where the opposition is decided in the applicant's favour, the Registrar shall register the mark in accordance with Section 23 (3) and this Rule.
- (2) The registration of a mark shall include :
  - (i) the representation of the mark
  - (ii) the number of the mark;
  - (iii) the name and address of the registered owner;
  - (iv) the name and address of the agent, if any;
  - (v) the filing date and date of registration;
  - (vi) if priority has been claimed and the claim has been accepted, the priority date, and the country or countries in which or for which the earlier application was filed; and
  - (vii) the list of goods or services in respect of which the registration of the mark had been made with an indication of the corresponding class or classes or the International Classification.
- (3) The certificate of registration of a mark shall be issued on Form 12 A after receipt of prescribed registration fee on Form 12 which shall be called for by the Registrar.
- (4) The publication of reference to the registration of a mark under paragraph (1) shall contain the particulars specified in paragraph 2 (ii) to (vii).

**49. Renewal of Registration**

- (1) The request for renewal of the registration of a mark under Section 28 (4) may be made on Form 13 during the six month period preceding the expiry of the registration and shall be signed by the registered owner or his agent.
- (2) The renewal shall be subject to payment of the renewal fee which shall be made within the period specified in paragraph (1) hereof or, upon payment of the prescribed surcharge, within the grace period allowed under Section 28(4)(c).

- (3) The renewal of the registration of a mark shall be recorded in the register and shall be published.
- (4) The Registrar shall issue to the registered owner a certificate of renewal on Form 13 A which shall contain :
  - (i) the registration number of the mark;
  - (ii) the date of renewal and the date of expiry;
  - (iii) the name and address of the registered owner; and
  - (iv) the list of goods or services in respect of which the mark has been registered with an indication of the corresponding class or classes of the International Classification.

#### **50. Collective Marks**

Rules 36 to 49 shall apply, mutatis mutandis, to collective marks subject to the following:

- (i) an application for registration of a collective mark shall not be accepted unless, in the application for registration, the mark is designated as a collective mark, and unless the application is accompanied by a copy of the regulations governing the use of the mark, duly certified by the applicant. No legalization of such certification shall be required;
- (ii) the regulations governing the use of the collective mark shall define the common characteristics or quality of the goods or services which the collective mark shall designate and the conditions under which and the persons by whom it may be used; they shall provide for the exercise of effective control of the use of the mark in compliance with those regulations, and shall determine adequate sanctions for any use contrary to the said regulations;
- (iii) a copy of the regulations governing the use of the mark shall be appended to the registration of a collective mark;
- (iv) publication of a reference to the registration of the collective mark, in accordance with Rule 46(1), shall include a summary of the regulations appended to the registration;
- (v) notification of changes effected in the regulations governing the use of the mark shall be in writing;
- (vi) all notifications of such changes shall be recorded in the Register. Changes in the regulations shall have no effect until such recording. A summary of the recorded changes shall be published;
- (vii) for the purposes of use of the collective mark in connection with Section 29(2), the registered owner of a collective mark may use the mark himself provided it is also used by other authorized persons in accordance with the regulations governing such use; use by such persons shall be deemed to be use by the registered owner.

#### **51. Invalidation, removal on ground of non-use**

- (1) An application to the Registrar for invalidation of a mark under Section 29(1) or for removal of a mark from the Register under Section 29(2) shall be made on Form 14, accompanied by the prescribed fees, and accompanied by supporting evidence, if any.
- (2) The Registrar shall forthwith send a copy of such application to the registered proprietor and any registered licensed user. The Registered Proprietor shall, within 2 months after receipt of the copy of the application, send a counter statement on Form 11 stating the grounds on which he relies in support of the registration, and accompanied by supporting evidence if any.

- (3) Thereafter, the Registrar, after hearing the parties, if either or latter wish to be heard and considering the merits of the case, should decide the matter.
- (4) Where the Registrar allows the application for invalidation, he shall record the invalidation of the registration of the mark under Section 29(1) and publish a reference thereto.
- (5) Where the Registrar decides under Section 29(2), that the mark shall be taken off the register in respect of any of the goods or services for which it is registered, the Registrar shall, to that extent remove the mark from the register.
- (6) The Registrar shall record the removal of the mark from the register on the grounds of non-use reference thereto.

## **52. Changes in ownership**

- (1) The request, under Section 34, for the recording of a change of ownership of a title granted under the Act or of an application therefor shall be made to the Registrar on Form 15 and shall be subject to payment of the prescribed fee.
- (2) The publication of the change of ownership shall specify :
  - (i) the title of protection concerned;
  - (ii) the filing date, the priority date, where applicable, and the date of registration or grant;
  - (iii) the owner and the new owner; and
  - (iv) the nature of the change of ownership;

## **53. Appointment of Agent; Address for Service**

The appointment of an agent shall be by a power of attorney on Form 16 which shall be signed by the applicant or, if there are more than one, by each applicant. The address of the agent shall, for all purposes connected with the Regulations and these Rules be treated as the address to which communications to the person or persons who appointed the agent shall be transmitted.

## **54. Excluded day**

When the last day for doing any act or taking any proceeding falls on a day when the Registrar's Office is not open to the public for business, it shall be lawful to do the act or to take the proceeding on the day when the Registrar's Office is next open for business.

## **55. Consultation of Registers; Request for Extracts therefrom and for Copies of Documents**

Consultation of the Registers and inspection of such other documents as may be permitted by the Registrar, shall be subject to payment of prescribed fee. Requests for consultation and requests for certified copies of extracts from a Register or for copies of documents shall be made to the Registrar in writing on Form 17 and shall be subject to payment of the prescribed fee.

## **56. Corrections of Errors; Extension of Time**

- (1) The Registrar may on his own correct any error or translation or transcription, clerical error or mistake in any application or document filed with the Industrial Property Registry or in any recording effected pursuant to the Regulations or the Rules.
- (2) Corrections of errors, under paragraph (1), or any change in name, address or description of the proprietor, or licensed user or striking out any goods/service from the stated specification may be

made by the Registrar upon receipt of a request in writing on Form 18 and subject to such terms as he may consider appropriate. Corrections made shall be communicated in writing to all interested persons, and, where considered necessary, shall be published by the Registrar.

- (3) A request for extension of time, under section 38 (2) may be made on Form 19 accompanied by prescribed fees.

**57. Hearing**

- (1) Before exercising adversely to any person any discretionary power given to the Registrar by the Regulations or these Rules, the Registrar shall notify such person, in writing, of the opportunity to be heard thereon, and indicating a time limit, which shall not be less than one month, for filing a request for a hearing.
- (2) The request for a hearing shall be in writing on Form 8 and shall be subject to payment of the prescribed fee.
- (3) Upon receiving such request, the Registrar shall give the person applying, and any other interested persons, at least two weeks' notice, in writing, of the date and time of the hearing.

**58. Service by Mail**

- (1) Any notice, application or other document sent to the Registrar by mail shall be deemed to have been given, made or filed at the time when it would be delivered in the ordinary course of the mail. In proving such sending, it shall be sufficient to prove that the letter containing such notice, application or other document was properly addressed and sent by registered mail.
- (2) Paragraph 1 does not apply to the accordance of the filing date.

**59. Recordal of Licence**

- (1) A request for recordal of the name of the licensee in respect of a patent, a design or a registered mark or an application therefor shall be made on Form 20 accompanied by the prescribed fee.
- (2) In the case of a Trade Mark, the licence contract shall be subject to the provisions of Section 31.

**60. Registration of Industrial Property Agent**

- (1) A legal practitioner or any person interested may apply on Form 21 for registration as industrial property agent. The essential qualifications for such registration are that the applicant must be :
  - (a) Citizen of Bhutan
  - (b) Not less than 22 years of age
  - (c) A graduate of University recognized by Bhutan or possessing an equivalent qualification or a certified JABMI licensed to practice in the courts in Bhutan.
  - (d) not a person convicted by a competent Court, whether within or outside Bhutan, of any offence punishable with imprisonment; or adjudged to be of unsound mind; or held guilty of any professional misconduct by competent authority.
- (2) The Registrar shall hold a written examination and viva-voce on the law and practice of industrial property to assess the suitability of the applicants for enrolment as industrial property agents.

- (3) These applicants who have obtained 50% or more marks in the aggregate shall be considered suitable for enrolment.
- (4) The Registrar shall issue a certificate of enrolment for those persons who have been enrolled as industrial property agents.
- (5) A person who is enrolled as an industrial property agent and practising before the Industrial Property Registry must at all times maintain a high degree of ethical and professional conduct generally applicable to Advocates and legal practitioners practising before the court. Any person violating the rules shall be disqualified from practising as industrial property agent and his name shall be removed from the Roll of industrial property agents after due process.

**Schedule I**  
**FEES**

Form	Title of the Form	Fee Amount
7	Application for registration of a mark (Rule 37)	1000.00
7A	Form for filing additional reproductions of mark	No Fee
8	Request for a hearing (Rule 44(3), 57(2))	100
9	Request for statement of grounds of decision (Rule 45)	100
10	Notice of opposition to an application for registration of a mark (Rule 47(1))	500
11	Form of counter statement (Rule 47 (2)/51(2))	500
12	Registration Fee (Rule 48(3))	1000
12A	Certificate of Registration of a mark (Rule 48 (3))	No Fee
13	Renewal of registration of a mark (Rule 49)	1000
	a. Fee paid under Rule 49(1)	1000
	b. Fee paid within grace period under section 28(4)c)	200
13A	Certificate of renewal (Rule 49 (4))	No Fee
14	Application for invalidation of a registered mark or for removal of a registered mark under Rule 51(1)	1000
15	Request for recording change of ownership of a title granted or of an application therefor(Rule 52(1))	1000
16	Appointment of an Agent by Power of Attorney (Rule 53)	No Fee
17	a. For consultation of Register and inspection of document under Rule 55 for every hour or part thereof	500
	b. On request for a certified copy of any entry in the register or any documents which are permitted for inspection (Rule 55)	500
18	On request for correction of any error or mistake (Rule 56)	500
19	On request for extension of time for a month or part thereof(Rule 56(3))	200
20	Request for recording of name of a Licensee under Rule 59	1000
21	Application for registration of a Person as an Industrial Property Agent (Rule 60)	50
	Note : 1) Forms 1 to 6 and the fees payable in respect of such forms will be published separately later.	
	2) The above stated fee in respect of Forms 7,12, 13,15,and 20 are applicable only in respect of association of persons, companies and partnerships. The fees in the case of individuals are :	
Forms		Nu.
7		500
12		500
13		500
	(when paid under Rule 49(1))	500.00 + 100 (surcharge) under rule 28 (4)(c)
15		500
20		500
	In all other cases, the fees payable are uniformly the same for all.	