

Movement towards a paperless system: what does this mean for patent rules?

DPS Parmar, Special Counsel at LexOrbis, seeks clarity on “electronic transmission duly authenticated” in light of increasing use and COVID-19.

When the Patent Office adopted the paperless system, its aim was to do away with any practice which promote filing of original or signed in ink or paper documents. The amendment in 2003 of the Patent Rule 6, relating to leaving and serving documents to include “by electronic transmission duly authenticated”, was supposed to be deemed sufficient to meet the requirement of leaving or serving the document at the Patent Office. Later amendment to this rule in 2006 did away with submitting the original copies in paper form within one month. Certain requirements, like submission of Power of Attorney, submission of certified documents of priority and submission



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of verified translation of priority document, need a signature in ink and the Office accept the scanned copies thereof through e-transmission. There is still some hesitation in the IPO to accept the e-signed or authenticated documents. The Indian Patent Office in certain cases raise objections and insist to submit the duly signed paper copies as well.

The meaning of “electronic transmission duly authenticated”

The Patent Rule 2003 do not seek to define what is meant by “electronic transmission duly authenticated”. An attempt to provide meaning to this term was made through the draft Patent amendment rules 2015 under Rule 2(ca):

“Electronic transmission duly authenticated” means authentication by digital signature as per section 5 of the Information Technology Act, 2000 (21 of 2000)”

However, this definition was not adopted in the final text of the Patent (amendment) Rules 2016, leaving it at the discretion of IPO to interpret and determine the scope of its application under the Patent Act. In absence of any definition different interpretations are given to “electronic transmission duly authenticated”, and at times the objections are raised to resubmit the duly signed paper documents as well even after filing such document using e-filing route. According to the Patent Office Manual:

“A patent agent shall file, leave, make or give all documents only by electronic transmission duly authenticated, including scanned copies of documents that are required to be submitted in original.

Résumé

Mr. DPS Parmar, Special Counsel

Mr. DPS Parmar heads the Intellectual Property Appellate Board (IPAB) practice group at LexOrbis. After joining the IPAB as Technical Member (Patents) in 2011, he has been instrumental in writing some path breaking and insightful decisions on Indian patent law issues. These include establishing legal positions on excluded subject matter under Section 3(d), 3(i) and 3(k), divisional applications, disclosure requirements under Section 8, working statements and compulsory license, to name a few. Before joining IPAB, Mr. Parmar worked with the Indian Patent Office (IPO) for over 27 years and had played a vital role both at the administrative and policy levels. He represented India at various rounds of discussions organized by the World Intellectual Property Organization (WIPO) and attended follow-on programs at the European and Japanese Patent Offices. He was instrumental in the recognition of IPO as the 15th ISA and IPEA under the Patent Cooperation Treaty (PCT). He also served as the head of the Intellectual Property Training Institute (IPTI) in Nagpur, which was responsible for providing training to new examiners at the IPO.

Provided that the original documents that are required to be submitted in original, shall be submitted within a period of fifteen days, failing which such documents shall be deemed not to have been filed."

Authentication of electronic records under The IT Act 2000

It must be noted that when the Patent Act does not describe the preconditions for a valid authentication, it is a matter that would be decided by the court in which such authentication is questioned based on local law. If we see section 5 and 6 of the IT Act 2000, we find clearly the position of legal recognition of electronic signature that clearly and unambiguously provides for acceptance of electronically signed documents under any law in force in India which requires the said document to be signed by affixing a hand written signature.

"[5.] Legal recognition of [electronic signatures].— Where any law provides that information or any other matter shall be authenticated by affixing the signature or any document shall be signed or bear the signature of any person, then, notwithstanding anything contained in such law, such requirement shall be deemed to have been satisfied, if such information or matter is authenticated by means of [electronic signature] affixed in such manner as may be prescribed by the Central Government.

Explanation.—For the purposes of this section, signed, with its grammatical variations and cognate expressions, shall, with reference to a person, mean affixing of his hand written signature or any mark on any document and the expression signature shall be construed accordingly."

Additionally, the provisions of Section 6 of the IT Act 2000, which applies to the Government and its

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Any
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the
electronic
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made after
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such
signature is
detectable.”

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agencies mandates the acceptance of any form, application or any other document filed with any office, authority, body or agency, if the said form, application or documents is signed with electronic signature and filed electronically.

"[6.] Use of electronic records and [electronic signatures] in Government and its agencies. (1) Where any law provides for:

- (a) The filing of any form, application or any other document with any office, authority, body or agency owned or controlled by the appropriate Government in a particular manner.
- (b) The issue or grant of any licence, permit, sanction or approval by whatever name called in a particular manner.
- (c) The receipt or payment of money in a particular manner, then, notwithstanding anything contained in any other law for the time being in force, such requirement shall be deemed to have been satisfied if such filing, issue, grant, receipt or payment, as the case may be, is effected by means of such electronic form as may be prescribed by the appropriate Government."

Accordingly, in absence of any definition or meaning given to "by electronic transmission duly authenticated" in patent acts and rule, the provision of the IT Act 2000 shall apply for submission of documents through the e-filing route. Interestingly, a patent agent can file, leave, make, or give all documents only by electronic transmission duly authenticated. Accordingly, only the documents where the submission of original document is mandatory, the e-filing of the scanned copy shall be followed by sending the paper copy within 15 days from submission of e-copy. That means certified copy of the priority document and POA shall be filed in original even after filing the scanned e-copy.



Form and scope of digital signature

If we look at the form and scope digital signature in the IT Act 2000, it provides definition of "digital signature", "electronic signature", and provision on Authentication of electronic records.

"(p) "Digital signature" means authentication of any electronic record by a subscriber by means of an electronic method or procedure in accordance with the provisions of section 3.

(ta) "Electronic signature" means authentication of any electronic record by a subscriber by means of the electronic technique specified in the Second Schedule and includes digital signature.

(3) Authentication of electronic records.

- (1) Subject to the provisions of this section, any subscriber may authenticate an electronic record by affixing his digital signature.
- (2) Any person by the use of a public key of the subscriber can verify the electronic record.
- (3) The private key and the public key are unique to the subscriber and constitute a functioning key pair."

(3A) Electronic signature. -

"(1) Notwithstanding anything contained in section 3, but subject to the provisions of sub-section (2), a subscriber may authenticate any electronic record by such electronic signature or electronic authentication technique which:

- (a) Is considered reliable.
- (b) May be specified in the Second Schedule.
- (2) For the purposes of this section any electronic signature or electronic authentication technique shall be considered reliable if:
 - (a) The signature creation data or the authentication data are, within the context in which they are used, linked to the signatory or, as the case may be, the authenticator and to no other person.
 - (b) The signature creation data or the authentication data were, at the time of signing, under the control of the signatory or, as the case may be, the authenticator and of no other person.
 - (c) Any alteration to the electronic signature made after affixing such signature is detectable.
 - (d) Any alteration to the information made after its authentication by electronic signature is detectable.
 - (e) It fulfils such other conditions which may be prescribed.

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- (3) The Central Government may prescribe the procedure for the purpose of ascertaining **whether electronic signature is that of the person by whom it is purported to have been affixed or authenticated.**
- (4) The Central Government may, by notification in the Official Gazette, add to or omit any electronic signature or electronic authentication technique and the procedure for affixing such signature from the Second Schedule: Provided that no electronic signature or authentication technique shall be specified in the Second Schedule unless such signature or technique is reliable."

That being the provision of affixing digital signature and electronic signature, the procedure of Rule 6 for submission of document "by electronic transmission duly authenticated" would be deemed to be satisfied, if the provisions of the IT Act 2000 have been followed. The only condition the submitted document must satisfy is that the procedure prescribe by The Central Government/or IPO, for the purpose of ascertaining whether electronic signature is that of the person by whom it is purported to have been affixed or authenticated by, is followed.

Typing of documents mandatory

According to rule 9: "All documents and copies of the documents, except affidavits and drawings, filed with patent office, shall:

- (a) **be typewritten or printed in Hindi or English** (unless otherwise directed or ... allowed by the Controller) ..."

That means handwritten manuscripts of any document, even if bearing the signature of the sender, will not be accepted except where the Controller so directs. That includes the scanned copy of such document. In normal situation, such procedural requirements can be met but when in a lockdown situation, like one due to COVID-19 pandemic, where all persons are confined to work from home, one cannot expect every person to have a printer or scanner. Moreover, due to security reasons and the electronic system used, particularly by patent law firms, the use of copying on other devices is forbidden. In such situations, the only option left would be to digitally sign the electronic document. It is not possible to get the printed copy for signing in ink and then scan and send such document as required by the patent rules.

Digitally signed documents as evidence

It may also be seen that the provision of digital signature mandate match with provisions of section



3(2), 47A and 67A of The Indian Evidence Act 1872 .
Section 3: interpretation – clause

"2. All documents including electronic records produced for the inspection of the Court; such documents are called documentary evidence."

Section 47A: opinion as to digital signature where relevant

"When the Court has to form an opinion as to **the electronic signature of any person, the opinion of the Certifying Authority** which has issued the electronic Signature Certificate is a relevant fact."

Section 67A: proof as to electronic signature

"Except in the case of a secure electronic signature, if the electronic signature of any subscriber is alleged to have been affixed to an electronic record the fact that such electronic signature is the electronic signature of the subscriber must be proved."

Combine reading of both the IT Act 2000 and The Indian Evidence Act allows the use of digital signature for authentication of documents. Therefore, IPO should give a meaningful interpretation for digital signature applied on the documents sent through the e-filing route without raising objections. Additional enquiry to obtain the original signed

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An expert's advice in this matter would be handy to avoid objections from IPO.

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copy require by IPO can be avoided at least during COVID-19 situations.

Way forward

It is not possible to change the rules immediately to accommodate the difficulty faced in meeting certain requirement of the rules where verification or authentication of document is required. However, in a paperless system there is a need to interpret the rules, which facilitate the inventors to meet the requirement of rules. Therefore, it is imperative for IPO to allow all digitally signed document filed in connection patent applications at least until the normal working is resumed. A PDF of the document signed using Digital Signature Certificate (DSC) is normally preferred. An expert's advice in this matter would be handy to avoid objections from IPO.

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