

**Office Practice and
Procedure Manual for
Patent Registration System,
2012**

**Intellectual Property Division
Ministry of Economic Affairs**

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INTRODUCTION

The Office Practice and Procedure Manual for Patent Registration System, 2012 is a practical guide for effective prosecution of Patent applications in Bhutan. It is developed with the objective of bringing about effective, efficient and timely delivery of quality services and ensuring transparency and accountability. It is intended to serve as a practical guide for patent examiners, applicants, agents, and the public to the operational procedures and examination practices of the Intellectual Property Division. Procedures and practices outlined in the manual are based on this Division's interpretation of the Industrial Property Act, 2001 (IPA 2001) and the Industrial Property Rules, 2001 (IPR 2001). In the event of any inconsistency between this manual and the applicable legislation, the applicable legislation shall prevail over this manual. The manual will be updated periodically to reflect ground realities in ensuring the effective implementation of the IPA 2001 and IPR 2001.

I. Reception and Accord of Filing Date.

1. The request for the grant of a Patent by the applicant shall be made on Form No. **PT-1 (3 copies)** with a fee as prescribed in the Schedule of Fees.
2. A minimum check shall be carried out by the office as per **Section 11** of the Act.
3. If the Patent application is found not to fulfill the minimum check, a notification including the corrections required shall be sent to the applicant on Form **PT-C** specifying the corrections required and inviting the applicant to submit the required corrections within two months from the date of the notification for the submission of corrections. The applicant shall submit the required corrections on Form No. **PT-2** along with a prescribed fee within the stipulated time frame. Subsequently, an acknowledgement vide Form **PT-A** shall be sent to the applicant for the receipt of Form No. **PT-2**.
4. A filing date shall be accorded to the Patent application after it has fulfilled the minimum check and a notification of the same shall be sent to the applicant vide Form **PT-B**.
5. The Patent application shall be deemed as not filed if the applicant fails to submit the required correction on time. A notification for the application deemed as not filed shall be sent to the applicant on Form **PT-D** after two months from the date of the notification vide Form **PT-C** or after the expiry of the time extension granted vide Form No. **PT- R**.
6. The Registrar shall mark as per **Rule 23** on each document making up the application.
7. The application number shall be quoted in all subsequent communications concerning the application.
8. A formality examination shall then be carried out on Patent applications with filing dates.

II. Formality Examination.

1. A formality examination shall be carried out as per **Section 11** of the Act, 2001 and the rules pertaining thereto.

2. If the Patent application is found not to fulfill the formality requirements, a notification for necessary corrections to that effect shall be sent to the applicant on Form **PT-E**.
3. The applicant shall submit the required corrections on Form No. **PT-3** alongwith a fee as prescribed in the Schedule of Fees within two months from the date of the invitation.
4. Subsequently, an acknowledgement vide Form **PT-A** shall be sent to the applicant for the receipt of Form No. **PT-3**.
5. The Patent application shall be rejected if the applicant fails to submit the required correction(s) during the given time period or despite the correction(s) if the Registrar is of the opinion that the correction(s) do not meet the requirements of **Section 11** of the Act and rules pertaining thereto.
6. A notification for the rejection of Patent application shall be sent to the applicant on Form **PT-F**.
7. The application that has fulfilled the formality examination shall then be sent to the WIPO Bureau for Substantive Search and Examination.

III. Substantive Search and Examination.

1. A notification to submit **WIPO-Form** for Substantive Search and Examination shall be sent to the applicant on Form **PT-G** along with **WIPO-Form** after the completion of the formality examination.
2. The applicant shall submit a dully filled **WIPO-Form** for Substantive Search and Examination along with Form No. **PT-3A** within two months from the date of the notification.
3. An acknowledgement vide Form **PT-A** shall be sent to the applicant for the receipt of Form No. **PT-3A** and dully filled WIPO Form.
4. The office shall send this dully filled form along with other relevant documents in a format and means acceptable to WIPO Bureau.
5. The original and a copy of the sent documents shall be maintained in both hard and electronic copies with the Patent Registry.

IV. Review of Substantive Search and Examination Report and Decision thereafter.

1. On receipt of the Substantive Search and Examination Report from WIPO, the office shall review the report as per **Section 11** of the Act.
2. The Examiner(s) shall submit an Examination Report to the Registrar providing details as to whether or not the provisions of **Section 11** of the Act are fulfilled.
3. While reviewing the Examiner's Report, if there are objections and clarifications to be sought from the applicant, the Registrar shall issue a notification vide Form **PT-H** to the applicant to submit clarifications(s)/amendment(s)/correction(s) as necessary.
4. The applicant shall submit clarification/amendment/correction along with Form No. **PT-3** and a fee as prescribed in the Schedule of Fees.
5. An acknowledgement vide Form **PT-A** shall be sent to the applicant for the receipt of Form No. **PT-3**.
6. The Examiner(s) will review the clarification(s)/amendment(s)/correction(s) submitted vide Form No. **PT-3** and resubmit the final Report to the Registrar.
7. If the decision is in favor of grant, follow the procedures outlined in **Part V** on Grant and Publication.
8. If the clarification(s)/amendment(s)/correction(s) submitted by the applicant doesn't clear the objection, the office shall send a notification of refusal of Patent on Form **PT-I**.

V. Grant and Publication.

1. A notification **PT-J** shall be sent to the applicant notifying the decision of the office to grant a Patent and to submit the grant and publication fees within three months from the date of notification.
2. The applicant shall submit the Form No. **PT-4** along with the grant and publication fees within three months from the date of notification.
3. An acknowledgement vide Form **PT-A** shall be sent to the applicant for the receipt of Form No. **PT-4**.
4. A reference to the grant of a Patent shall be published as per **Section 12** of the Act and **Rule 26** after the receipt of the grant and publication fees. The Patent shall be deemed to be granted on the date the Registrar publishes a reference to the grant.

5. The Registrar shall issue a certificate of the grant of the Patent and a copy of the Patent documents in accordance with the provisions relating to the grant of Patent as provided for in **Section 12** of the Act and **Rule 26**.
6. The Patent Certificate and Patent documents shall be accompanied by a forwarding note from the Registrar.

VI. Annual Fees

A Patent shall expire twenty years from the filing date of the application for the patent. In order to maintain the Patent application or Patent, an annual fee shall be paid as prescribed in the Schedule of Fees in advance to the Registrar for each year starting one year after the filing date of the application or the grant of the patent.

1. In accordance with **Section 14** of the Act and **Rule 28**, the applicant shall submit a request for the maintenance of the Patent application or Patent in advance, before the expiry of the date for the payment of the annual maintenance fee on Form No. **PT-5** with an annual fee as prescribed in the Schedule of Fees.
2. A period of grace of six months shall be allowed for the late payment of the annual fee on payment of a surcharge as prescribed in the Schedule of Fees. The applicant shall submit a request on Form No. **PT-6** along with the annual maintenance fee and the surcharge.
3. An acknowledgement letter shall be sent to the applicant notifying the validity of the Patent for the year under reference upon receipt of annual maintenance fee along with form PT-5 or PT-6.
4. If an annual fee is not paid in accordance with the provisions of **Section 14** of the Act and **Rule 28**, the Patent application shall be deemed to have been withdrawn or the Patent shall lapse.
5. A notification vide Form **PT-K** for the withdrawal of the application/lapse of a Patent shall be sent to the applicant after the expiry of the grace period.
6. The Registrar shall record and publish the notification of the lapse of a Patent.

VII. Invalidation.

1. Any interested person may request the Court or the Registrar anytime to invalidate a Patent as per **Section 16** of the Act.
2. If the request for invalidation is made to the Registrar, the request shall be made on Form No. **PT-7** along with a fee as prescribed in the Schedule of Fees.
3. An acknowledgement vide Form **PT-A** shall be sent to the applicant for the receipt of Form No. **PT-7**.
4. A notification vide Form **PT-L** inviting counter statement shall be sent to the Patent owner after the receipt of the request for invalidation along with a copy of Form No. **PT-7** filed by the person requesting for invalidation.
5. Upon receiving Form **PT-L**, the Patent owner may file counter statement on Form No. **PT-7A**.
6. An acknowledgement vide Form **PT-A** shall be sent to the applicant for the receipt of Form No. **PT-7A**.
7. The Registrar shall examine the statements submitted by both the parties as per **Section 16** of the Act and **Rule 29** and communicate the decision to them on Form **PT-M**.
8. The decision of the Court or the Registrar shall be recorded and published.

VIII. Changes in the Ownership.

1. Changes in the ownership of a Patent application or a Patent shall be made on Form No. **PT-8** along with a fee as prescribed in the Schedule of Fees. The Registrar shall record the change and publish as per **Section 34** of the Act.
2. An acknowledgement vide Form **PT-A** shall be sent to both the parties on receipt of Form No. **PT-8**.
3. A notification vide **PT-N** shall be sent to both the parties notifying the changes that has been made to the Patent application or Patent.

IX. License Contract.

1. The Patent owner shall request the Registrar for the recording and publishing of any contract licenses concerning a Patent application or a Patent. The request shall be made on Form No. **PT-9** with a fee as prescribed in the Schedule of Fees.
2. An acknowledgement vide Form **PT-A** shall be sent to the Patent owner for the receipt of Form No. **PT-9**.
3. A notification vide Form **PT-O** shall be sent to the Patent owner and the Licensee notifying the recording and publication of the contract license of a Patent application or a Patent.

X. Register.

1. A Patent Register shall be maintained within the Industrial Property Registry of the Intellectual Property Division as per **Section 37** of the Act.
2. Any person shall request for the consultation/extracts from the Register on Form No. **PT-12** anytime along with a fee as prescribed in the Schedule of Fees.
3. An acknowledgement vide Form **PT-P** along with the certified copy or certificate shall be sent to the applicant.
4. Any documents or decisions taken on a Patent application or a Patent must be recorded in the Patent Register including the following:
 - a) Changes in the ownership of a Patent application or a Patent.
 - b) Any contract licenses concerning a Patent application or a Patent.
 - c) Correction of any clerical error in the application or document filed with the Industrial Property Registry.
 - d) The notification of the lapse of a Patent.
 - e) The final decision of the court after invalidation.

XI. Official Bulletin.

1. The Industrial Property Registry shall publish in the Official Bulletin all the publications provided for in the Act including the following:
 - a) A reference to the grant of a Patent.
 - b) The notification of lapse of a Patent.
 - c) The final decision of the court after invalidation.

XII. Correction of Errors.

1. The applicant can request for the correction of any clerical error in the application or document filed with the Industrial Property Registry or in any recording effected pursuant to **Section 38** of the Act and **Rule 56**. The request shall be made on Form No. **PT-10** along with a fee as prescribed in the Schedule of Fees.
2. An acknowledgement vide Form **PT-A** shall be sent to the applicant for the receipt of Form No. **PT-10**.
3. A notification vide Form **PT-Q** shall be sent to the applicant notifying the changes that has been made to his Patent or Patent application.

XIII. Extension of Time.

1. An applicant can request for the extension of time on Form No. **PT- 11** along with a fee as prescribed in the Schedule of Fees before the expiry of the required time period.
2. An acknowledgement vide Form **PT-A** shall be sent to the applicant for the receipt of Form No. **PT-11**.
3. The Registrar may extend the time for doing any act or taking any proceeding under the **Section 38** of the Act and rules pertaining thereto.
4. A notification in response to Form No. **PT-11** shall be sent to the applicant vide Form **PT-R**.

XIV. Withdrawal of Application.

1. An applicant may withdraw application for a Patent anytime during its pendency. He shall submit the request in writing.
2. An acknowledgement vide Form **PT-A** shall be sent to the applicant for the receipt of written request for the withdrawal of Patent application.
3. A notification to that effect shall be sent to the applicant vide Form **PT-S**.

XV. Request for Hearing.

1. Any interested party to a proceeding may request the Registrar for an opportunity to be heard vide Form **PT-13** before exercising adversely to that party any discretionary powers vested in the Registrar as per **Section 39** of the Act.
2. Notification acknowledging the request for hearing may be sent vide **PT-A**.

XVI. Appeal.

1. Any action taken by the Registrar under this Act, in particular the grant of a Patent or the refusal of an application for such a grant or registration may be the subject of an appeal by any interested party before the Court and such appeal shall be filed within two months of the date of the decision as per **Section 40** of the Act.