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Patents (Amendment) Rules, 2024 and Patent (Second Amendment) Rules, 2024 come into Force

INTRODUCTION

The Patents (Amendment) Rules, 2024 and the Patent (Second Amendment) Rules, 2024 have been notified and have come into force from the date of Publication in the Official Gazette i.e. 15 March 2024 and 16 March 2024 respectively. The key highlights of the Patents (Amendment) Rules, 2024 and the Patent (Second Amendment) Rules, 2024 (Revised Rules 2024) are broadly set out below:

1. Information of corresponding foreign applications

The continuing obligation to keep furnishing updated details from time to time in relation to corresponding patent applications (on Form 3) post filing of the patent applications has been relaxed. Form 3 as being done currently will have to be first submitted at filing stage, and thereafter updated details of corresponding patent applications (on Form 3) are to be submitted (i) within 3 (three) months from the date of issuance of the first examination report (FER); and (ii) within 2 (two) months from date of request from Controller.

2. Request for examination

The time period for filing a request for examination, for applications filed before 15 March 2024 shall remain the same - 48 months from the earliest priority date. However, for all applications filed on or after 15 March 2024, the time period has been reduced to 31 months from the earliest priority date.

3. Statement of Working

Statement of working (on Form 27) is to be filed once every three financial years, starting from the financial year commencing immediately after the financial year in which the patent was granted, and shall be furnished within 6 (six) months from the expiry of each such period.

The Form 27 has also been amended whereby the Patentee / Licensee has to provide the following:

- Information on whether the patent has been worked or not worked.
- If patent has been worked, only a confirmation/indication in this regard - no further information such as quantum or value to be provided if patent has been worked.
- If patent has not been worked, reason for non-working of the patent to be provided.
- Whether the patent is available for licensing.

4. Delay or Extension of timelines

A petition under Rule 137 of The Patent Rules, 2003 cannot be filed for obviating delay in filing Form 3, delay in entry of PCT national phase application, delay in filing translations of PCT specification and priority document, delay in filing request for examination, delay in filing response to FER, delay in filing reply statement to pre-grant opposition, delay in filing renewal fee, delay in filing review petition and delay in filing working statement.

By way of the Revised Rules 2024, a formal request on Form 4 can be filed for following delay or extension of timelines:

- The timeline to file response to first examination report can be extended for a period of 3 (three) months after the prescribed timeline of 6 (six) months by way of a formal request (on Form 4) and official fee (of INR 1,000 per month for individual/small entity / startup / educational institutes and INR 4,000 per month for others for normal examination and INR 2,000 per month for individual/small entity / startup / educational institutes and INR 10,000 per month for expedited examination).
- The timeline to file statement of working can be extended for a period of 3 (three) months after the prescribed timeline of 6 (six) months from financial year end by way of a formal request (on Form 4) and official fee (of INR 2,000 per month for individual/small entity / startup / educational institutes and INR 10,000 per month for others).

- The timeline to file details of corresponding applications (on Form 3) can be condoned/extended by period of 3 (three) months by filing of a formal request (on Form 4) and official fee (of INR 2,000 per month for individual / small entity / startup / educational institutes and INR 10,000 per month for others).
- The formal request on Form 4 can be filed within the extended timeline.

It is pertinent to mention that the rules before the Revised Rules 2024 already provides for request of extension on Form 4 for filing renewal fee and request for extension for filing review petition, the timelines and fee for which remain the same.

In addition to the above, the Revised Rules 2024 also confers the Controller with the power to condone the delay or extend the time for any activity by a period of up to six (6) months upon a formal request (on Form 4) and official fee (INR 10,000 for individual / small entity / startup / educational institutes and INR 50,000 for others) which should be filed within the extended period.

5. Pre-grant opposition

Introduction of fee (INR 4,000 for individual / small entity / startup / educational institutes and INR 20,000 for others) for filing pre-grant oppositions.

Pre-grant opposition shall be first determined for prima facie maintainability, and if no prima facie case is made, the pre-grant opposition shall be rejected after hearing the opponent, provided the opponent requests for a hearing. If the pre-grant opposition is found to be maintainable, the pre-grant opposition shall be taken up as per expedited examination procedure. The hearing procedure for pre-grant opposition will now be aligned with hearing procedure of post-grant opposition.

Further, time period for applicant to reply to pre-grant opposition has been reduced from 3 (three) months to 2 (two) months.

6. Post-grant opposition

Official fee for filing a post-grant opposition increased to INR 20,000 for individual/small entity/startup/educational institutes and INR 40,000 for others.

The Opposition Board to now provide its report within 2 (two) months instead of 3 (three) months from the date on which the documents were forwarded to the Board.

7. Divisional applications

One or more divisional application(s) can now be filed based on an invention disclosed in provisional specification or complete specification or even a previously filed divisional application.

8. Anticipation by public display

As per the existing provisions, there would be no anticipation in cases of public display (extended by the Central Government by notification in the Official Gazette) if the patent application was filed within a grace period of 12 (twelve) months. The Revised Rules 2024 now requires a formal request (on Form 31) and official fee (of INR 500 for individual /small entity / startup / educational institutes and INR 2,500 for others) to be filed to avail the grace period of 12 (twelve) months.

9. Renewal fees

In case renewal fees is paid in advance through electronic mode for a period of at least 4 (four) years, a 10% discount in fee will be provided.

10. Certificate of inventorship

A certificate of inventorship may now be obtained by an inventor by filing a formal request along with official fee.

11. Patent Agent Qualifying Exam

The Patent Agent qualifying exam in addition to the Patents Act and Patent Rules will include the Designs Act and Design Rules.

12. Complaints in relation to contravention of certain provisions

The Revised Rules 2024 includes forms and procedure for filing complaints in relation to contravention of provisions such as unauthorized claim of patent rights; refusal to provide information pertaining to working of patents; and practise by non-registered agents.

COMMENT

The Revised Rules 2024 are being introduced at the backdrop of the efforts being taken to reduce backlog of patent applications, and ease procedures before the Indian Patent Office. While immediate implementation of the Revised Rules 2024 may pose certain challenges, the amendments pertaining to filing of updated Form 3 upon issuance of examination report and/or upon request

from the Controller; and filing of Form 27 once every 3 (three) financial years, especially without details of quantum and value will be preferred by applicants. As regards applicants filing a PCT national phase application, they will have to be mindful of filing a request for examination by the 31 months' deadline or pay an additional extension fee. The amendments in relation to condonation of delay and extension of timelines will provide more leeway to applicants. However, the fees associated to address certain delays / extension of timelines are substantially high.

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