client alert

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ahead of the curve

Patent (Amendment) Rules, 2024

The Department for Promotion of Industry and Internal Trade (**DPIIT**) notified the Patent (Amendment) Rules 2024 on March 15, 2024, after taking stakeholder comments into consideration. These amendments are certainly an impressive revamp of the Patent Rules and emphasise on simplifying processes for applicants and patentees, while expediting disposal.

Provided below is a concise summary of the Draft (Amendment) Patent Rules 2024:

Key Highlights

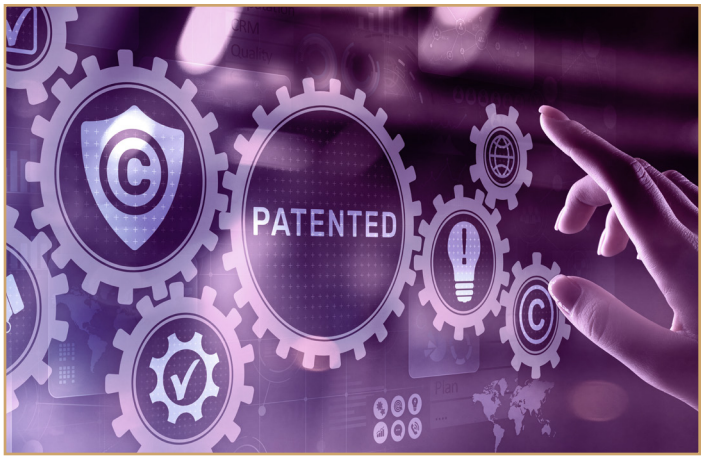
- Form 3 must be submitted within three months from the date of issuance of FER, further extendable by three months.
- Request for examination timeline reduced to 31 months from the earliest priority date.
- Controller to first assess the maintainability of pre-grant oppositions.
- Simplified Form 27 with objective response options for submission of working statement once every three financial year.
- Possibility of extension of critical deadlines up to six months upon payment of additional fees.

Summary of Patent (Amendment) Rules

1. Form 3 – Statement and Undertaking:

a. Applicants are required to file a

i. A Form-3 within six months from the date of filing the application.



ii. An updated Form 3 earlier was required to be filed (to keep the Controller informed of the details of foreign applications) within six months from the date of such filing. Under revised ***rule 12(2)***, *the applicant is now required to submit such updated details within* **3 months** from the date of issuance of First statement of objection (or First examination report).

2. Information under Section 8(2)

a. Under unamended rule 12 (3), the controller under sub-section (2) of Section 8, could ask the applicant to furnish information relating to objections, if any, in respect of novelty and patentability of the invention, claims of application allowed, etc., in respect of any foreign application. The said information was then

required to be submitted within six months from the date of such communication by the Controller.

b. Under revised ***rule 12(3)***, the *"Controllers may use accessible and available databases for considering the information relating to applications filed in a country outside India"*.

c. Under Section 8(2), the Controller may also direct the applicant to furnish a fresh Form 3 within **2 months** from the date of such communication under the new ***rule 12(4)***.

d. Under the ***new rule 12(5)***, timeline for filing Form-3 can be further extended by three months upon a request made in Form 4.

3. Divisional Applications under Section 16:

a. New sub-rule (2A) inserted after ***rule 13(2)***, for clarification of scope of divisional applications. According to the said sub-rule, an applicant can file one or more further applications under Section 16, including in respect of an invention disclosed in the provisional or complete specification or a further application filed under Section 16.

4. Request for Examination (RFE):

a. Timeline for filing request for examination of patent application reduced from forty-eight months to **thirty-one months (from the date of earliest priority).**

b. The amendment also clarifies that in respect of an application filed before the commencement of present amendments, the period for making request for examination would be 48 months.

5. Extension of time to file a response to the examination report:

a. In ***Rule 24B (6)***: The text *"The time for putting an application in order for grant under Section 21 as prescribed under sub-rule (5) may be further extended for a period of three months on a request in Form 4 for extension of time along with prescribed fee, made to the Controller before expiry of the period specified under sub-rule (5)" is replaced with "The time for putting an application in order for grant under Section 21 as prescribed under sub-rule (5) may be further extended for a period of three months on a request in Form 4 for extension of time along with prescribed fee, made to the Controller before expiry of the period specified* ***herein***."

b. Similarly, in rule 24C(11): The text *"The time for putting an application in order for grant under Section 21, as prescribed in sub-rule (10) may be further extended for a period of three months on a request for extension made in Form 4 along with the prescribed fee, made to the Controller before the expiry of the period specified under sub-rule (10)" is replaced with text "The time for putting an application in order for grant under Section 21, as prescribed in sub-rule (10) may be further extended for a period of three months on a request for extension made in Form 4 along with the prescribed fee, made to the Controller before the expiry of the period specified under* ***herein***."

Implying essentially that an extension to respond to the examination report can be filed anytime before nine months from the issuance of the examination report, instead of six months from the issuance of the examination report.

6. Public disclosure Section 31: Applicants must submit Form 31 under a new ***rule 29A*** for making a declaration/ recordal of public disclosure of invention under Section 31 within a *grace period* of 12 months from such public disclosure.

7. Pre-grant Opposition:

a. Under ***rule 55(3)***, the Controller shall notify the opponent if no *prima facie* case is made out in the representation based on the Controller's consideration of the representation. The Controller shall pass an order recording the grounds for refusal of the representation within one month from the date of notification to the opponent.

b. In case the opponent requests to be heard in the matter, the *"Controller shall, after giving the opponent an opportunity of being heard, pass an order within one month from the date of hearing, recording his reasons for refusal or prima facie acceptance of the representation and the applicant shall be notified accordingly"*.

c. Upon consideration of the representation, if the Controller is satisfied that a *prima facie* case is made out in the representation, the Controller shall, within one month of receiving the representation, pass an

order recording his reasons and notify the applicant accordingly.

d. Timeline for filing statement or evidence by the applicant, after receiving notice under ***rule 55(3)***, reduced from three months to **two months**.

e. ***Sub-rule 5A*** and ***5B*** inserted in ***rule 55(5)***: According to ***sub-rule 5A*** *"procedure specified in sub-rules (2) to (4) of rule 62 shall, as far as may be, apply to the procedure for hearing under this rule"*. ***Sub-rule 5B****, states that "an application for a patent, in which a representation for opposition has been filed and notice has been issued by the Controller under rule 3, shall be examined in accordance with rule 24C."* (the application would be disposed of like an application where expedited examination request is filed)

f. Under ***rule 56(4)***, the timeline for submission of Opposition Board recommendation is reduced from three months to **two months**.

8. Certificate of Inventorship:

a. New ***rule 70A*** inserted after rule 70 wherein the Controller may issue a certificate of inventorship to an inventor for a patent in force on a request made in Form 8A.

9. Renewal Fee:

a. Advance renewal fee can be paid for two or more years under ***rule 80(3)***. Ten percent reduction will be provided on applicable renewal fee in case advance renewal fee is submitted through the electronic mode for at least four years.

10. Patent Agent Examination:

a. Under ***rule 110(2)***, the patent agent examination Paper-1 shall be based on Patents Act, 1970, Patents Rules, 2003, Designs Act, 2000 and Designs Rules, 2001. Paper-2 shall be based on Drafting and interpretation of patent and design specifications.

11. Working of Patents:

a. Form-27 for submission of working statement of patents is simplified and includes objective response options for providing details of working of patent.

b. The working statement is required to be submitted once every three financial year, beginning with the financial year commencing immediately after the financial year in which the patent was granted. Said working statement is required to be submitted within six months from the expiry of each such period.

c. For example, for patent granted in financial year 2023-24, working statement is required to be submitted for three financial years, that is, 2024-25, 2025-26 and 2026-27. The working statement for said period would be required to be submitted by **September 2027**.

d. The time period for submission of working statement can be further extended for up to three months upon a request made in Form 4 upon condonation of delay by the Controller.

12. Petitions under rule 137:

a. ***Rule 137*** re-numbered as ***rule 137(1)*** and ***sub-rule 2*** included. According to sub-rule 2, the provisions of amendments and correction of irregularity provided under existing rule 137 shall not be applicable for matters related to – *i) extension of time or condonation of delay under sub-rule (5) of rule 12 (for form-3) ; (ii) clause (i) of sub-rule (4) and sub-rule (6) of rule 20 (filing national phase application); (iii) rule 21 (filing priority doc and translation); (iv) sub-rules (1), (5) and (6) of rule 24B (requesting examination,*

responding to exam report); (v) sub-rules (10) and (11) of rule 24C (requesting examination, responding to exam report); (vi) sub-rule (4) of Rule 55 (responding to pre-grant opposition); (vii) sub-rule (1A) of rule 80 (renewal fee); (viii) sub-rules (1) and (2) of rule 130 filing of (review petition); (ix) sub-rule(2) of rule 131 (filing of working statement)".

13. Power of Controller to extend specified time or condone delay:

a. Without any exception, time specified for doing any act may be extended and any delay may be condoned by the Controller for a period of up to six months, upon a request made in Form 4.

b. Such a request in Form 4 is required to be made before the expiry of the said period of six months.

c. Such request may be made any number of times within the specified period of six months.

d. All in-extendible deadlines like the following are now extendible – like sub-rule (4) of rule 20, [31-months' time limit for entering national phase], filing a request for examination or responding to the examination report [sub-rules (1), (5) and (6) of rule 24B, sub-rules (10) and (11) of rule 24C], Responding to the pre-grant opposition [sub-rule (4) of rule 55], filing of review petition [sub-rules (1) and (2) of rule 130], etc.

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