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### **PRACTICE UPDATE**

#### **Patents (Amendment) Rules, 2024**

On March 15, 2024, Patents (Amendment) Rules, 2024 came into force in India. A summary of these amendments and corresponding updates in patents practice in India is provided below:

#### **I. Information, Statement, and Undertaking regarding Foreign Applications (Form – 3) – Rule 12**

##### ***Changes in Form-3 (Statement & Undertaking under Section 8)***

- The language of undertaking in Form-3 is revised wherein the underlined part of “*I undertake that ... I would keep...informed ...regarding the details of corresponding applications for patents filed outside India within six months from the date of filing of such application.*” is replaced with “*in accordance with the provisions contained in section 8 and rule 12*”. This is to accommodate the corresponding changes in the Rule 12, wherein the requirement of filing the Form-3 within 6 months of filing corresponding foreign application is done away with.
- In the table of particulars, the heading “*Date of grant*” is replaced with more accommodating phrase “*Date of disposal*”; and there are minor clarificatory changes.

##### ***Changes in timelines / frequency for filing Form-3 under Rules 12***

###### ***First Form-3 filing –***

There is no change in the requirement and timeline for filing the first Form-3, and the Applicants are required to continue filing the first Form-3 (revised) featuring details of corresponding applications in respect of same or substantially the same invention filed outside India (“foreign applications”) within 6 months of filing the patent application in India.

###### ***Subsequent Form-3 filings –***

Prior to the amendment, Applicants were under obligation (until the grant of patent in India) to keep the Controller informed (under Form-3) with respect to detailed particulars of foreign applications by filing a fresh Form-3 within 6 months of filing of foreign applications. As a matter of practice, the Controllers also expected

the Applicants to update the statuses (and not just filing details) of such foreign applications by filing Form-3 within 6 months of the status update.

As per the amendment, the Applicant's obligation of continuously keeping a track of foreign applications and regularly filing fresh Form-3 (towards compliance with updating Controller within 6 months of each such foreign filing and/or update) is done away with. As per amended Rule 12(3), Controllers are now expected to "*use accessible and available databases, for considering the information relating to applications filed in a country outside India.*" In light of this, the burden of patent applicants in India with respect to filing subsequent Form-3 (viz. after first Form-3) has been reduced and modified as below:

- Rule 12(2) – The Applicant is required to furnish a Form-3 within 3 months of date of issuance of the First Examination Report (FER).

It appears that an applicant is required to file Form-3 within 3 months of FER date irrespective of whether or not an objection or demand is made by the Controller in the FER with respect to filing of Form-3.

- Rule 12(4) – At any time, from the date of filing of application until disposal thereof in India, the Controller may, with reasons recorded in writing, demand the Applicant to furnish details of foreign applications under Form-3 within 2 months from the date of communication.

### ***Extension of time and condonation of delay in filing Form-3***

As per Rule 12(5), a statutory extension of up to 3 months is now available upon filing a request under Form-4 at the Patent Office. As per the amendment, the Controller may also condone the delay in filing Form-3, in case the extension is not requested in time.

## **II. Statement of Working – Rule 131**

### ***Changes in Form-27 (Statement Regarding the working of Patented inventions on a commercial scale in India)***

- Details to be furnished under Form-27 have been amended as per below:
  - *Worked* - For the patented inventions are identified as 'Worked', no other details are required to be provided.

Prior to this amendment, patentees / licensees were required to furnish details and figures of "*approximate revenue / value accrued*" in India with respect to working of inventions through manufacturing in India and importing into India (separately), along with brief details. All these requirements are now removed under the amended Form-27.

- *Not Worked* – For the patented inventions are identified as 'Not worked', patentees / licensees may now select one of the following reasons:
  - Patented Invention is under development / commercial trial

- Patented Invention is under Review / approval with Regulatory authorities
- Exploring commercial licensing
- Any other, may specify

Prior to the amendment, patentees / licensees were required to provide a brief note on reasons for not working and steps being taken for working of the inventions.

- *Availability of patented invention for licensing* – Amended Form-27 now features an additional entry where the patentee / licensee is required to confirm (as YES / NO) “*whether the patent is available for licensing*”.

In case YES is selected, patentee / licensee may share details of email address and contact number on which patentee / licensee would be interested in receiving communications from any person interested in seeking a license.

- *Importing into India to be considered as ‘Worked’* – The amended Form-27 features a new note that “*Subject to conditions specified under the Patent Act, 1970 a patented invention shall not be considered as ‘not worked’ merely on the ground that the patented product has been imported in India.*”
- *Licensees may also file Form-27 jointly* – In the amended Form-27, the note “however, each licensee shall file this Form individually” has been omitted, thereby indicating that it should now be possible for licensees to also file the Form-27 jointly.

### ***Changes in timelines / frequency for filing Form-27***

- Patentees / licensees are now required to file Statement of Working (under Form-27) “*once in respect of every period of three financial years*”. The Form-27 is to be furnished within 6 months from the expiry of said period. The year in which patent is granted is exempted from calculation.

Earlier, the Form-27 was required to be filed for each financial year.

### ***Extension of time and condonation of delay in filing Form-27***

- Amended Rule 131(2) now specifically provides that the Controller may condone the delay or extend the time for filing such statement for a period of up to 3 months upon a request made under the statutory Form-4.

## **III. Request for Examination**

### ***Deadline to file Request for Examination of patent application***

- The deadline to file Request for Examination (RfE) is now changed from 48 months (from the date of priority) to 31 months (from the date of priority). Thus, the deadline to file RfE is now concurrent with the deadline to file PCT national phase application in India.

- It is, however, clarified, that for the applications filed prior to March 15, 2024 (viz. the date on which the amendments came into effect), the deadline to file RfE shall continue to be 48 months.

#### **IV. Divisional Applications**

##### ***Multiple and suo moto divisional applications***

- As per newly inserted Rule 13(2A): “*patent applicant may, if he so desires, 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”.*
- This provides clarification to Section 16 that divisional application(s) can be filed: (i) voluntarily (viz. without having received an objection from Controller); and (ii) claiming subject matter disclosed in provisional or complete specification or any previously filed divisional application (viz. a divisional out of a divisional).

#### **V. Pre-grant Opposition**

##### ***Prime facie examination and decision***

- As per the amended Rule 55(3), the Controller, upon receiving a representation of pre-grant opposition, is required to act depending upon whether or not a *prima facie* case is made out or not, as per below:
  - *Prima facie* case is made out: “*the Controller shall, within one month of receiving the representation, pass an Order recording his reasons and notify the Applicant”.*
  - No *prima facie* case is made out, the Controller shall notify the Opponent, and shall dispose of the representation depending upon:
    - If the Opponent requests for a hearing, the Controller shall give the Opponent an opportunity to be heard, and pass an Order within one month of the hearing, recording the reasons for refusal or *prima facie* acceptance of the representation and the Applicant is notified accordingly; or
    - If the Opponent does not request for a hearing, the Controller, within one month of such notification, pass an order recording the grounds of refusal of the representation.
- Prior to the amendments, in a pre-grant opposition, if the Controller was of the opinion that the application should be refused or amended in light of the pre-grant opposition, a notice was issued to the Applicant.

##### ***Time period for the Applicant to reply***

- As per the amended Rule 55(4), the time period for the Applicant to file its reply statement along with evidence in support of application is reduced from 3 months to 2 months (from the date of notice).

***Expedited Examination of Applications where prima facie case of pre-grant opposition is made out***

- As per newly inserted Rule 55(5B), the patent applications where a representation of pre-grant opposition is filed and a notice is issued by the Controller to the Applicant (after a *prima facie* case is made out), the application will be examined under the provisions applicable to those cases where expedited examination of application is requested. In cases of expedited examination, First Examination Report (FER) is to be issued within 2-4 months.

***Procedure for hearings in pre-grant oppositions***

- As per newly incorporated Rule 55(5A), procedure specified for hearings in post-grant oppositions [under Rules 62(2) – 62(4)] shall also apply to hearings in pre-grant oppositions.

**VI. Post-grant Opposition**

***Time period for the Opposition Board to submit report with recommendations***

- As per the amended Rule 56(4), the time period for the Opposition Board to conduct examination of the opposition with all evidence and submit its report with reasons on each ground along with its recommendations is reduced to 2 months from 3 months.

**VII. Certificate of Inventorship**

- As per newly incorporated Rule 70A, the Controller may issue a certificate of inventorship to an inventor in respect of a patent in force, on a request made in Form-8A.

**VIII. Concession on Renewal Fee**

- In case renewal fee is paid in advance for a period of at least 4 years, a ten per cent reduction in fee will be applicable.

**IX. Request for Grace Period**

***Special Form for seeking grace period for public display of invention***

- Under newly inserted Rule 29A, a form (Form-31) is now available to request for grace period (of up to 12 months) from the first public display of the invention for the purposes of filing patent application.

**X. General Extension of Time and Condonation of Delay for all Deadlines**

***General powers of Controller to obviate irregularity in procedure***

- General powers of Controller to allow amendment and obviate irregularity in procedure are curtailed with respect to the certain provisions, as listed below:

- a. extension of time or condonation of delay for filing Form 3;
- b. filing of national phase applications (beyond 31 months);
- c. filing of an English translation of international application or certified copy of priority document;
- d. filing a request for examination,
- e. filing response to the first examination report, and extension related thereto for regular examination as well as expedited examination;
- f. filing a reply statement in reply and evidence in a pre-grant opposition;
- g. extension for payment of annuity beyond six months;
- h. filing a review of the Controller's decision and for filing an application to set aside the Controller's decision if passed *ex parte* in review proceedings; and
- i. extension beyond six months for filing Statement of Working.

### ***Extension of time by 6 months for all deadlines***

- Rule 138 is amended to read as: *“Notwithstanding anything contained in these rules, the time specified for doing any act or taking any proceeding thereunder may be extended or any delay may be condoned by the Controller for a period of up to six months, upon a request made in Form 4, where such request is made before the expiry of the said period of six months”*.

It is also provided that *“such request may be made any number of times within the specified period of six months”*.

- While it appears that an extension of up to 6 months is available for all deadlines under the Rules, the cost for such extension is INR 50,000/- (approx. USD 600) per month (for large entity).

### **XI. Other Changes in Fees and Forms**

- Fee for Educational Institutions is now same as the fee for individuals, start-ups, and small entities (which is usually at a concession of about 80% over the fee for large entities).
- Application Form-1 now features categories such as PPH; educational institution; gender and age of applicant(s) and inventor(s).

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