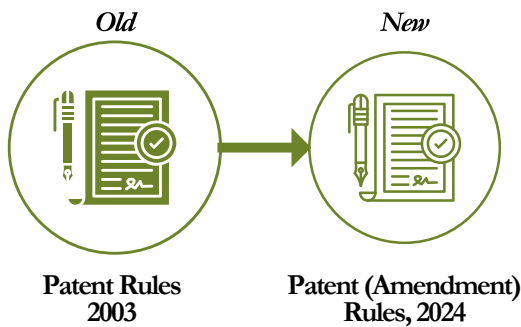


**PATENT UPDATE**

# PATENT (AMENDMENT) RULES, 2024





The Ministry of Commerce and Industry (Department for Promotion of Industry and Internal Trade) has notified the **Patent (Amendment) Rule 2024** with effect from 15th March 2024

## Key Highlights

- **Request for Examination (RFE)**  
Due date reduced from “48-months” to “31-months” for new applications.
- **Statement and Undertaking under Section 8**
  - Foreign filing details (Form-3) to be submitted within 6-months after filing is maintained.
  - Foreign filing details (Form-3) to be furnished within 3 months (as opposed to 6-months) from the date of First Examination Report (FER) or within 2 months from the date of communication of the Patent Office.
  - No obligation to submit Foreign filing details (Form-3) every 6-months.
- **Divisional application**  
Permitted to be filed for an invention disclosed in provisional or complete specification and need not be restricted to the claims of parent application only. (This follows the decision in decision of Division Bench in Syngenta V. Union of India)
- **Renewals / Annuities**  
Ten percent reduction in official fees for renewal if fee is paid in advance for 4 years or more.
- **Pre-grant Oppositions & Post-Grant Oppositions**
  - Introduction of Official fees in pre-grant opposition and increased fees in case of post-grant opposition.
  - Reduction in timelines to expedite the procedure.
  - Prima facie assessment in pre-grant opposition.
- **Commercial Working Statements**  
Submission of Working statements (Form-27) relaxed as once in 3 years as opposed to every year.
- **Condonation of Delays & Extensions**  
Timeline extensions are provided subject to increased official fees.

Previous Rule (Summary)	New (Amended) Rule, 2024	Remarks
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**RULE 12 (2)**

**Statement and Undertaking regarding Foreign Applications**

<p>Details of corresponding foreign application to be furnished in Form-3 within <u>six months from the date of such filing.</u></p>	<p>The time within which the applicant for a patent shall keep the Controller informed of the details in respect of other applications filed in any country in the undertaking to be given by him under clause (b) of sub-section (1) of section 8 shall be <u>three months from the date of issuance of first statement of objections under sub-rule (3) of rule 24B or sub-rule (8) of rule 24C.</u></p>	<ul style="list-style-type: none"> <li>• New Rule places obligation on the applicant to furnish foreign filing details (Form-3) <u>within 3 months from the date of first examination report (FER).</u></li> <li>• Form-3 details now need to be submitted within 6 months from filing (Rule 12 (1A)); and within 3 months from FER (New Rule 12(2)).</li> </ul>
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**RULE 12 (3)**

<p>Documents u/s 8(2) to be furnished within <u>six months from the date of such communication by the Controller.</u></p>	<p>3. The Controller may, use <u>accessible and available databases,</u> for considering the information relating to applications filed in a country outside India.</p>	<ul style="list-style-type: none"> <li>• Patent Office to consider information relating to foreign applications from publicly available databases rather than seeking information from applicant.</li> </ul>
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Previous Rule (Summary)	New (Amended) Rule, 2024	Remarks
	<p>4. <u>The Controller may, under sub-section (2) of section 8, for reasons to be recorded in writing, direct the applicant to furnish a fresh statement and undertaking in Form 3 within two months from the date of such communication by the Controller.</u></p> <p>5. <u>Notwithstanding anything contained in these rules, the Controller may condone the delay or extend the time for filing Form 3 for a period of up to three months upon a request made on Form 4.</u></p>	<ul style="list-style-type: none"> <li>• This reduces the burden on the application is submit such information as available in publicly available databases such as USPTO, EPO, and the like.</li> <li>• Patent Office to issue communication to seek fresh information in Form-3, which needs to be complied within 2 months from the date of such communication.</li> <li>• Delay in submission of any information in Form-3 can be condoned up to a period of 3-months upon a request in Form-4.</li> </ul> <p>Official fees for such extension/condonation: INR 2000 / INR 10000 (small entity / large entity)</p>

Previous Rule (Summary)	New (Amended) Rule, 2024	Remarks
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**NEW RULE 13 (2A)**

<b>Divisional Application</b>		
(NA)	(2A) A patent applicant may, if he so desires, file one or more further applications under section 16, <u>including in respect of an invention disclosed in the <u>provisional or complete specification or a further application filed under section 16.</u></u>	<ul style="list-style-type: none"> <li>In continuation of the decision of Division Bench in <i>Syngenta V. UOI</i>, new rule stipulates that a divisional application may be filed for an invention <u>disclosed in provisional or complete specification</u>, thereby extending the earlier scope of limiting divisional application to the claims of parent application.</li> </ul>

**RULE 24B/24C**

<b>Request for Examination (RFE)</b>		
Request for Examination to be submitted within forty-eight months from date of priority or date of such filing,	1 (i). A request for examination under section 11B shall be made on Form 18 within <u>thirty-one months</u> from the date of priority of the application or from the	<ul style="list-style-type: none"> <li>Time period for submitting reduced from <b>48-months</b> to <b>31-months</b>.</li> <li>Applications before commencement of said New Rules (before 15th</li> </ul>

Previous Rule (Summary)	New (Amended) Rule, 2024	Remarks
whichever is earlier.	date of filing of the application, whichever is earlier.	<p>March 2024) however would follow RFE due date of 48-months.</p> <ul style="list-style-type: none"> <li>Such a new provision would result in speedy disposal of application.</li> </ul>

**NEW RULE 29A**

<b>Grace period for Anticipation by public display</b>		
(NA)	<p>29A. Grace period- An application to avail the grace period under section 31 shall be filed in Form 31.</p>	<ul style="list-style-type: none"> <li>New Form-31 introduced in view of said rule for the applicant who wishes to avail grace period for filing patent application for invention already disclosed by public display (sec 31).</li> </ul> <p>Official Fees: INR 500/ INR 2500 (small entity/ large entity)</p>

**RULE 55**

<b>Pre-Grant Opposition</b>		
New subrule 3(A)	(3) On consideration of the representation if the	<ul style="list-style-type: none"> <li>To combat frivolous oppositions, the new</li> </ul>

Previous Rule (Summary)	New (Amended) Rule, 2024	Remarks
(NA)	<p>Controller is satisfied that,</p> <p>- (a) no prima facie case is made out in the representation, he shall notify the opponent accordingly, and -</p> <p>(i) unless the opponent requests to be heard in the matter, the Controller shall, within one month from the date of such notification, pass an order recording the grounds for refusal of the representation;</p> <p>(ii) if opponent requests for a hearing, 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.</p> <p>(b) a prima facie case is made out in the represent-</p>	<p>provision stipulates prima facie assessment to admit the pre-grant opposition before notifying the applicant.</p>

Previous Rule (Summary)	New (Amended) Rule, 2024	Remarks
	<p>ation, the Controller shall, within one month of receiving the representation, pass an order recording his reasons and notify the applicant accordingly</p>	
<p>Reply statement and evidence to be submitted by the applicant within <b><u>3 months from the date of notice.</u></b></p>	<p>(4) On receiving the notice under sub-rule (3), the applicant shall, if he so desires, file his statement and evidence, if any, in support of his application <b><u>within two months</u></b> from the date of the notice, with a copy to the opponent.</p>	<ul style="list-style-type: none"> <li>• Timeline for submitting Reply statement and evidence by the applicant <b><u>shortened to two-months.</u></b></li> </ul>
<p>New subrule 5A</p>	<p>New Rule Inserted: (5A.) The procedure specified in sub-rules (2) to (4) of rule 62 shall, as far as it may be, apply to the procedure for hearing under this rule. (5B) An application for a patent, in which a representation for opposition has been filed and notice has been issued</p>	<ul style="list-style-type: none"> <li>• Stricter timelines for the Patent Office</li> </ul>



Previous Rule (Summary)	New (Amended) Rule, 2024	Remarks
	by the Controller under rule 3, shall be examined in accordance with rule 24C.	

**NEW FEES**

(NA)	<p>Official Fees for filing of Oppositions and attending hearing u/s 62(2) introduced.</p> <p>Filing of Opposition: INR 4000 / INR 20000            Notice to attend hearing: INR 1500 / INR 7500 (small entity / large entity)</p>	<ul style="list-style-type: none"> <li>To invite serious opposition and discourage frivolous opposition.</li> </ul>
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**RULE 56 (4)**

<b>Post-Grant Opposition</b>		
<p>Opposition Board to provide joint recommendation <b>within three-months</b> from the date on which documents are</p>	<p>(4) The Opposition Board shall conduct the examination of the notice of opposition along with documents filed under rules 57 to 60 referred to under sub-section (3) of</p>	<ul style="list-style-type: none"> <li>Stricter timelines for the Patent Office to expedite disposal of oppositions.</li> </ul>

Previous Rule (Summary)	New (Amended) Rule, 2024	Remarks
forwarded.	section 25, submit a report with reasons on each ground taken in the notice of opposition with its joint recommendation <b><u>within two months</u></b> from the date on which the documents were forwarded to them.	

**ENHANCED FEES**

<p>Official Fees for filing of Opposition:</p> <p>INR 2400 / INR 12000 (small entity / large entity)</p>	<p>New Official Fees for filing of Opposition.</p> <p>INR 8000 / INR 40000 (small entity / large entity)</p>	<ul style="list-style-type: none"> <li>• To invite serious oppositions and discourage frivolous opposition</li> </ul>
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**NEW RULE 70A**

(NA)	<p>70A. Certificate of inventorship</p> <p>(1) The Controller may issue a certificate of inventorship to an inventor in respect of a patent in force, on a request made by the</p>	<ul style="list-style-type: none"> <li>• To enable inventors to be duly identified with their inventions.</li> <li>• Enables inventors to avail a duplicate certificate provided they submit a statement along with Form 8A and make the necessary payment.</li> </ul>
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Previous Rule (Summary)	New (Amended) Rule, 2024	Remarks
	<p>inventor in Form-8A along with fee specified in the First Schedule.</p> <p>(2) The Controller may issue a duplicate certificate of inventorship to an inventor in respect of a patent in force on a request made by the inventor in Form-8A along with the fee specified in the First Schedule and such request shall contain a statement setting out the circumstances in which the original certificate of inventorship was lost, destroyed, damaged or cannot be produced.</p>	

**RULE 80 (3)**

<b>Renewal / Annuities</b>		
<p>The annual renewal fees payable in respect of two or more years may be paid in advance.</p>	<p>(3) The annual renewal fees payable in respect of two or more years may be paid in advance: Provided that where the renewal fees are paid in advance</p>	<ul style="list-style-type: none"> <li>To incentivize patentees to make advance payments of at least four years for their patent renewal, following which they</li> </ul>

Previous Rule (Summary)	New (Amended) Rule, 2024	Remarks
	<p>via e-filing in respect of a period of at least 4 years, <b><u>a ten per cent reduction</u></b> in fee shall be applicable upon such a payment.</p>	<p>can benefit from the deduction.</p>

**RULE 131 (2)**

<b>Commercial Working Statement</b>		
<p>Commercial working statements to be submitted every year</p>	<p>(2) The statements referred to in sub-rule (1) shall be furnished once in respect of <b><u>every period of three financial year</u></b>, starting from the financial year commencing immediately after the financial year in which the patent was granted, and shall be furnished within six months from the expiry of each such period. <b><u>Provided that the Controller may condone the delay or extend the time in filing of such statement for a period up to three months upon a request made in Form 4.</u></b></p>	<ul style="list-style-type: none"> <li>• Reducing the burden on applicants to submit such statements once in three years.</li> <li>• Option of condoning the delay or extending the timeline for such submissions.</li> </ul> <p>Official Fees: INR 2000 / INR 10000 (small entity / large entity)</p>

Previous Rule (Summary)	New (Amended) Rule, 2024	Remarks
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**RULE 137**

**Condoning Irregularity in Procedure (Petition)**

<p>New subrule 2</p>	<p>(2) The provisions contained in sub-rule (1) shall not be <b><u>applicable for matters related to-</u></b></p> <ul style="list-style-type: none"> <li>(i) extension of time or condonation of delay under sub-rule (5) of rule 12;</li> <li>(ii) clause (i) of sub-rule (4) and sub-rule (6) of rule 20;</li> <li>(iii) rule 21;</li> <li>(iv) sub-rules (1), (5) and (6) of rule 24B;</li> <li>(v) sub-rules (10) and (11) of rule 24C;</li> <li>(vi) sub-rule (4) of Rule 55;</li> <li>(vii) sub-rule (1A) of rule 80;</li> <li>(viii) sub-rules (1) and (2) of rule 130;</li> <li>(ix) sub-rule (2) of rule 131.</li> </ul>	<ul style="list-style-type: none"> <li>• Clarifying the rule to define where such petition to condone irregularity is NOT allowed:</li> </ul> <ol style="list-style-type: none"> <li>1. Form-3 (extension provided separately in Form-4)</li> <li>2. National Phase entry due date</li> <li>3. Submission of Priority document / translation of priority document</li> <li>4. RFE due date (no extension)</li> <li>5. Response to FER (extension provided separately in Form-4)</li> <li>6. Reply Statement and Evidence submitted by applicant in pre-grant opposition</li> <li>7. Renewal / Annuities (extension provided separately in Form-4)</li> <li>8. Review petition to review Patent Office's decision</li> </ol>
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Previous Rule (Summary)	New (Amended) Rule, 2024	Remarks
		<p>extension provided separately in Form-4)</p> <p>8. Review petition to review Patent Office’s decision (extension provided separately in Form-4)</p> <p>9. Working Statement (extension provided separately in Form-4)</p>

**RULE 138**

<b>Extension of time</b>		
<p>Extension of time for a period of one-month allowed for selective acts as prescribed.</p>	<p>1. <u>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</u></p>	<ul style="list-style-type: none"> <li>• New rule removes the exception contained therein.</li> <li>• New provision stipulates that <b>[any act or any delay]</b> shall be condoned for a period of six-months provided:               <ol style="list-style-type: none"> <li>1. Request is made before expiry of six-months; and</li> <li>2. Multiple requests within six months allowed.</li> </ol> </li> <li>• New provision extends the scope and possibility of extension to:</li> </ul>

Previous Rule (Summary)	New (Amended) Rule, 2024	Remarks
	<p><u>the said period of six months:</u>  <u>Provided that such request</u>  <u>may be made any number of</u>  <u>times within the specified</u>  <u>period of six months.</u></p>	<ol style="list-style-type: none"> <li>1. National Phase entry due date.</li> <li>2. Submission of Priority document / translation of priority document.</li> <li>3. RFE due date.</li> <li>4. Reply Statement and Evidence submitted by applicant in pre-grant opposition.</li> <li>5. Documents to be submitted under Rule 57 to 60 in a post grant procedure.</li> <li>6. Any other act               <ul style="list-style-type: none"> <li>• Enhanced official fees: INR 10000 / INR 50000 (small entity / large entity)</li> </ul> </li> </ol>

**FEES**

<b>Patent of Addition</b>		
(NA)	<p>A note in the First Schedule has been inserted:            An application for a patent made under section 54 shall be eligible for a reduction of 50 per cent in fee as compared to other applications.</p>	<ul style="list-style-type: none"> <li>• Reducing the burden on the Applicants with the reduction of fifty percent in official fees for Patent of Addition under section 54.</li> </ul>