

INDIA HAS INTRODUCED INNOVATIVE UPDATES TO PATENT RULES, 2024

On March 15, 2024, the Ministry of Commerce and Industry (Department for Promotion of Industry and Internal Trade) notified the Patents (Amendment) Rules, 2024 in the Official Gazette of India, and these amendments took effect immediately upon publication. The revised rules aim to align more closely with international standards, encourage innovation, and strengthen the protection of inventors' rights. They address key areas of concern in Indian patent practices and procedures, and are expected to lead to increased patent filings and more efficient processing within the country.

The amendments include significant changes in various aspects of patent law. For instance, the requirement for applicants to periodically update information regarding corresponding patent applications on Form-3 has been relaxed. Now, applicants must file Form-3 within six months from the patent application date, and updates on foreign filings are required within three months of the first statement of objections rather than within six months of filing in each foreign country. The Controller also has the authority to use available databases to assess foreign applications, reducing the burden on applicants to submit information about objections related to novelty, patentability, and claims allowed in other jurisdictions. However, in some cases, the Controller may still require the applicant to provide updated information on Form-3 within two months of such a request.

Furthermore, a new provision clarifies the filing of divisional applications under Section 16, allowing for such applications to be based on inventions disclosed in the provisional or complete specification, or any previously filed divisional application. The time frame for filing a request for examination (Form-18/Form-18A) has been shortened from 48 months to 31 months from the filing date or priority date, applicable to applications filed after March 15, 2024.

In response to the First Examination Report (FER), applicants can now request an extension even after the initial six-month deadline, up to nine months from the FER issuance date. This change allows more flexibility in responding to FERs but requires payment of additional fees based on the extension period. Additionally, inventors now have the option to file Form-31 to claim a 12-month grace period for patent applications after public disclosures of their inventions at exhibitions, society meetings, or publications, thus protecting their rights while allowing time to file patent applications.

The amendments also introduce changes to the opposition process. In pre-grant opposition, a new scrutiny process ensures that only representations with a prima facie case are considered. If the Controller finds the representation lacking, the opponent is given an opportunity to be heard, and a decision must be made within one month of the hearing. The fee structure for

filing both pre-grant and post-grant oppositions has been revised to reduce frivolous filings and expedite the opposition process.

Additionally, inventors can now request a certificate of inventorship for patents in force by submitting Form-8A, with applicable fees for obtaining original or duplicate certificates. The renewal fee for patents has been reduced by 10% for those who pay for at least four years in advance electronically.

Particulars	Earlier Fees	New/Updated Fees	Inference
Rule 138: Power to extend time specified or condone delay	Individual/Small Entity/Startup/Educational Institution: INR 1600 Large Entity: INR 8000	Individual/Small Entity/Startup/Educational Institution: INR 10,000/month Large Entity: INR 50,000/month	The fees have been increased more than 6-fold.
Filing of Pre-Grant Opposition – Form 7 A	No fee	Individual/Small Entity/Startup/Educational Institution: INR 4000 Large Entity: INR 20,000	The fee introduction can reduce the number of oppositions particularly the oppositions which are filed by opponents just to delay the examination procure of a patent application.
Filing of Post-Grant Opposition – Form 7	Individual/Small Entity/Startup/Educational Institution: INR 2400 Large Entity: INR 12,000	Individual/Small Entity/Startup/Educational Institution: INR 8000 Large Entity: INR 40,000	-

Addition of Inventor [under Section 28(2)] – Form 8	Individual/Small Entity/Startup/Educational Institution: INR 800 Large Entity: INR 4000	No Fee	
Rule 70A: Certificate of inventorship	Provision not available earlier.	Individual: INR 900	
Patent of Addition	Individual/Small Entity/Startup/Educational Institution: INR 1600 Large Entity: INR 8000	Individual/Small Entity/Startup/Educational Institution: INR 800 Large Entity: INR 4000	50% reduction in fee.

The Patent Agent Examination syllabus has been updated to include both the Patents Act and Rules and the Designs Act and Rules. Moreover, patentees and licensees are now required to submit a statement of working every three financial years instead of annually, providing information on the commercial use of the patent and its availability for licensing.

Certain irregularities, such as delays in filing Form-3 or responses to FER, are excluded from condonation under Rule 137(2). However, the Controller may extend timelines or condone delays for up to six months upon request, with fees varying based on the applicant's entity type.

The amendments also include a 50% discount on the official fee for patents filed under Section 54. In a move towards inclusivity, a new gender-neutral category has been introduced in the patent application form (Form-1), recognizing non-binary individuals and their rights. Finally, the amendments bring changes to the fee structure, reflecting the updates made to various provisions in the Patents (Amendment) Rules, 2024.