

Recent Amendments in Indian Patent Rules

(Effective: 15th March 2024)

1. Statement and Undertaking u/s 8 regarding foreign applications (Form 3): Rule 12

Initial Form 3

- **No change**
- **Deadline:** 6 months from the date of filing of the Application

Updated Form 3

- **Modified:** Not a regular compliance anymore
- **Deadline:** 3 months from issuance of FER

Fresh Form 3 Requisition

- **Modified:** Prosecution history to be self-checked by the Controller
- Controller may request fresh Form 3 in this scenario
- **Deadline:** 2 months from the date of request

Extension of Time

- Extension available up to 3 months
- Form 4 with prescribed fee (~USD 120 large entity) to be filed for each month

**Format of Form 3 modified accordingly.*

2. Divisional Applications: Rule 13

Clarification provided by way of insertion of sub-rule 2A in rule 13 with respect to the content of the divisional application.

A patent applicant may now file **one or more further divisional applications** in respect of an invention disclosed in either a **provisional or complete specification or a further application** filed u/s 16.

As a result of the change – The divisional need not be restricted to the subject matter/claims of the complete specification only. Further, A divisional to a divisional is also permitted.

3. Examination of Application: Rule 24B, 24C

Previous Requirement	New Requirement
Timeline to file a request for examination under was within forty-eight months from the date of priority of the application or from the date of filing of the application, whichever is earlier.	Timeline to file a request for examination now reduced to thirty-one months from the date of priority of the application or from the date of filing of the application, whichever is earlier.



Amendments are prospective in nature: The amended deadline of 31 months is applicable only to applications filed on or after 15th March 2024.

4. Grace period in case of Anticipation by Public Display: Rule 29A

Previous Position	New Requirement
No separate form for availing the grace period in case of anticipation by public display u/s 31.	• New Form 31 introduced with prescribed official fee of ~USD 31 (large entity) to avail the grace period. • To be filed within 12 months of the public display.

5. Opposition Proceedings (Rules 55 & 56): Streamlined

Opposition	Key Changes
Pre-grant	• Official fee prescribed for filing of pre-grant opposition ~USD 250 (large entity) [earlier: no fee] • Consideration of the Opposition by the Controller only if a prima facie case exists • <u>If no prima facie case:</u> (i) In case of absence of request by the Opponent to be heard – Controller to pass the order of refusal within 1 month of receiving the representation; (ii) In case Opponent requested to be heard – Controller to pass the order of refusal within 1 month of the date of hearing • <u>If prima facie case made out:</u> (i) Controller to pass the order and notify the Applicant within 1 month of receiving the representation (ii) Time limit for submitting a reply and evidence by the Applicant reduced to 2 months (earlier: 3 months) (iii) Request for hearing and fee now also applicable to pre-grant oppositions
Post-grant	• Time limit for examining the post-grant opposition by the Opposition Board of IPO reduced to 2 months (earlier: 3 months) • Official fee increased to ~USD 500 (large entity)

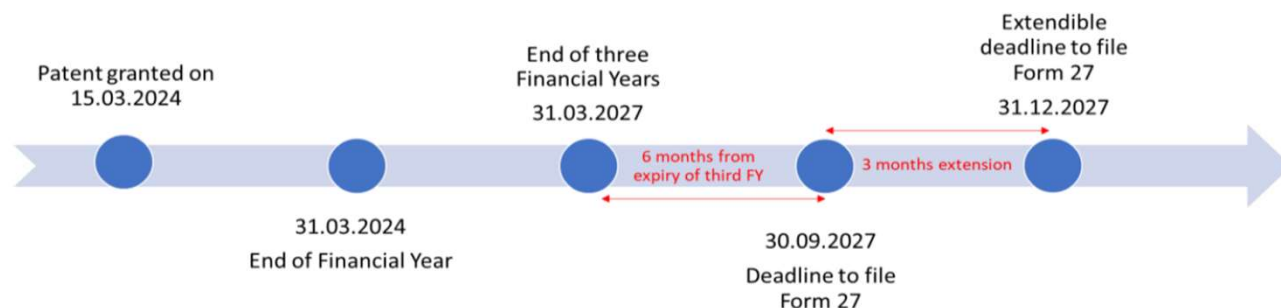
6. Certificate of Inventorship: Rule 70A

Request to be made by the inventor in Form-8A along with the prescribed official fee of INR 900 at any time when the patent is in force.

Duplicate certificate may be issued in cases where the original certificate of inventorship is lost, destroyed, damaged or cannot be produced.

7. Statement of Working of Patents (Form 27): Rule 131

Previous Requirement	New Requirement
Rule 131: Form and manner in which statements required under section 146(2) to be furnished (2) The statements referred to in sub-rule (1) shall be furnished once in respect of every financial year, 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 financial year.	Rule 131: Form and manner in which statements required under section 146(2) to be furnished “(2) The statements referred to in sub-rule (1) shall be furnished once in respect of every period of three financial year, 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. 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.” <i>*(Format of Form 27 modified)</i>



8. Irregularities, Extensions & Condonation: Rule 137 & 138

Rule 138	Exclusions:
Earlier: Extension of only 1 month permitted for certain acts. Post-Amendment: Controller may now extend or condone delay up to 6 months. Request must be made in Form 4 on payment of prescribed official fee of ₹50,000/- (~USD 625) per month [large entity].	• National phase entry (31-month deadline) • Filing English translation of PCT application • Submission of priority document/translation • Request for Examination (RFE) • Renewal fees (except where already extendible) • Response to FER beyond allowed Form 4 extension • Statement of Working (Form 27) beyond allowed Form 4 extension • Review petition deadlines

9. Fee Revisions & Form Changes

Particulars	Old Fee (large entity)	New Fee (large entity)
Pre-grant Opposition	----	INR 20,000/-
Post-grant Opposition	INR 12,000/-	INR 40,000/-
Patent of Addition	As applicable on the filing	50% reduction available
Renewal Fee	No concessions	10% concession when renewal fee paid in advance for at least 4 years.
Mention of Inventor on LPD (Form 8)	INR 4,000 (~USD 48)	---- (Removed)

Formats of following forms have been modified:

Form 1: Gender, Age & Contact number are optional additions; Entries of Educational Institutions & PPH; Email -OTP verification mandatory.

Form 3: New Form 3 (date of disposal to be mentioned).

Form 4: Additionally applicable for rules 12(5), 131(2) and 138.

Form 27: Revenue details removed; Indication of intention to license introduced

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