

Intellectual Property advocacy in the fields of:

- IP Infrastructure
- IP Valuation
- M & A
- IP Policy
- Technology Transfer
- Innovation Research
- Patent Law
- Licensing
- Data Management
- Copyright
- Collaborations
- Balance for Rights & Obligations

EDITORIAL

India scores “One Lakh Patents” in 2023 - 2024, under new dynamic IP leadership

Anchoring the IP leadership, Prof. (Dr.) Unnat Pandit, the Controller General of Patents and IP India, and his team actively supported by DPIIT (Department of Promotion of Industry and Internal Trade), and the vibrant and vocal mentoring by Shri. Piyush Goyal, Minister of Industry and Commerce (and others), have successfully granted over 1 Lakh patents in 2023-2024. We have pleasure to congratulate all who made this possible including Indian inventor. It is heartening to note that the share of the Indian patent filing by Indian patent applicants have gone up, substantially overtaking foreign filings.

The newly notified Patents (Amendment) Rules, 2024 has substantially curtailed procedural timelines and streamlined processes for filing, prosecution, responses and post grant oppositions as per revised rules, are expected to substantially hasten and speed up the patent grants in coming years.

The pending proposals to grant limited protection to utility patents (jugaads), if introduced, India will be able to surpass China in coming years. Having introduced the new feature of “Certificate of Inventorship”, in the amended rules, including the DPIIT (Department of Promotion of Industry and Internal Trade) / CGPDTM (Controller General of Patents, Designs, and Trade Marks) may consider granting “Certificate of Inventorship” as a first step for recognising utility patents or jugaads too.

Indian Patent (Amendment) Rules, 2024

On 15th March 2024, the new “Patents (Amendment) Rules 2024 has been notified. It is heartening to note that many impracticable ideas and proposals including calculations of fees for pre grant oppositions based on total expenditure incurred by patent applicants, as proposed in the Draft Patent (Amendment) Rules 2023 has been omitted, consequent to widespread objections.

Consequently, we welcome the new Rules as notified. The Salient features of the “Patent (Amendment) Rules, 2024 are presented, herein.

The feedback provided by stakeholders following the publication of the Draft Rules has been thoroughly reviewed and taken into account by the DPIIT and CGPDTM, addressing their various concerns and suggestions.

These objections and comments have been carefully reviewed and analysed to ensure that the final version of the Patent Amendment Rules, 2024 addresses them effectively.

By incorporating these valuable inputs, the DPIIT and CGPDTM have demonstrated their commitment to creating a regulatory framework that is responsive to the needs and concerns of the patent community. The Patent Amendment Rules, 2024 reflects a collaborative effort between the government and

stakeholders to create a more transparent, efficient, and user-friendly patent system.

Overall, the recognition and incorporation of feedback into the final rules highlight the government's dedication to fostering innovation and promoting a conducive environment for patent protection in India.

| Amendment | Details |
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| New Rule 29A | A new provision, Rule 29-A, has been added regarding the Grace Period For section 31 by using Form-31. |
| Amendments to Forms and Format of Forms | Changes have been made to Form 1, Form 3, Form 27 and Form 4. |
| Fees | Payment of fees is required for filing a pre-grant representation, as well as for the newly introduced application for a certificate of inventorship and the request for a grace period under section 31. |
| Amendments to Rule 80 | If a Patentee opts to prepay renewal fees digitally for a minimum of four years, they are eligible for a ten percent discount on the fees. |

| Amendment | Details |
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| <p>Amendments to Rule 55</p> <p>Changes & Fees introduced In Pre-Grant Opposition.</p> | <ol style="list-style-type: none"> 1. The controller must verify if a prima facie case has been established in a pre-grant representation and if the opponent has requested a hearing. 2. If a prima facie case is not established and no hearing is requested, the controller must inform the opponent and issue an order stating the grounds for refusal within one month of Pre-Grant Opposition. 3. If a prima facie case is not established but a hearing is requested, the controller must provide a hearing and issue an order within one month, stating the reasons for refusal or acceptance of the representation by way of Pre-Grant Opposition. 4. If a prima facie case is established, the controller must issue an order within one month, stating the acceptance of the representation. 5. Upon receiving the acceptance notice, the applicant must submit their statement, evidence, and a copy to the opponent within two months. |
| <p>New Rule 70A</p> | <p>Inventors can now request a Certificate of Inventorship for their active patents. The request for the certificate must be made using Form 8A, which is a newly introduced form.</p> |
| <p>Amendments to Rule 110</p> | <p>Patent Agent candidates must now prepare for the inclusion of questions on design specifications and drafting in Paper II of the examination.</p> |
| <p>Amendments to Rule 13</p> | <p>Rule 13 has been updated to include sub-rule 2A, allowing patent applicants to submit additional divisional applications under section 16 for disclosed inventions, providing more flexibility for protection.</p> |
| <p>Amendments to Rule 56</p> | <p>The recent amendments to sub-rule 4 of rule 56 have given the Opposition Board the power to review the opposition notice and documents submitted under rules 57 to 60. The Board must now provide a detailed report with reasons for each ground cited in the notice, along with a joint recommendation. This process must be completed within two months from the date of document submission.</p> |

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| Amendments to Rule 12 | <ol style="list-style-type: none"> 1. The need for multiple submissions of Form 3 by applicants has been removed. 2. Applicants must now provide details of any corresponding foreign application using Form 3 within three months of receiving the first statement of objections. 3. The Controller can use accessible databases to review information on applications filed outside India. 4. Two new sub-rules have been added. 5. Sub-rule 4 requires applicants to submit a new statement and undertaking in Form 3 within two months of communication, with documented reasons. 6. Sub-rule 5 allows the Controller to grant a three-month extension for submitting Form 3 upon request using Form 4. |
| Amendments to Rule 131 Relaxation/ Liberation regarding Form 27. | <ol style="list-style-type: none"> 1. Statements of Working (Form 27) are no longer required annually after patent grant, but must be filed once every three years. 2. The initial working statement must be submitted within six months after the third financial year. 3. For example, if a patent is granted in the financial year 2020-2021, the first period for submitting working statements would start from the subsequent financial year, 2021-2022. 4. The patent holder must provide the statements within six months from the end of this three-year period, by September 30, 2024. |
| Amendments to Rule 137 | The scope of rule 137 will no longer extend to certain actions. |
| Amendments to Rule 24B | The timeline for filing a request for examination has been shortened to thirty-one months from forty-eight months. |
| Amendments to Rule 138 | Under Rule 138, the Controller is empowered with greater authority to approve delays or extend timelines for a period of up to six months. |

Case Law

Ericsson v. Lava - Lava has been directed by the Delhi High Court to compensate INR 244 Crores as damages.

A link to the detailed report in Spicy IP is given below:

<https://spicyip.com/2024/03/delhi-high-court-imposes-damages-worth-inr-244-crores-on-lava-in-the-ericsson-lava-sep-dispute.html>