

Intellectual Property advocacy in the fields of:

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WORKING OF THE PATENTED INVENTION (Form-27)- FREQUENTLY ASKED QUESTIONS ADDRESSED BY THE INDIAN PATENT OFFICE

On 26th August, 2024, the Office of the Controller General of Patents, Designs and Trade Marks (CGPDTM) took a significant step towards enhancing clarity and transparency in the patent filing process by releasing a comprehensive set of Frequently Asked Questions (FAQs) regarding Form 27 under the newly implemented Patent Amendment Rules 2024. This initiative is particularly aimed at addressing the concerns and uncertainties faced by patent holders in India regarding the submission of working statements, which are essential for demonstrating the commercial utilization of patented inventions.

The FAQs provide detailed guidance on various aspects of the filing process, including the specific procedures that patent holders must follow when submitting their working statements. This includes information on the required documentation, the format of the submissions, and any necessary declarations that must accompany the filings. By outlining these procedures, the office of CGPDTM aims to eliminate confusion and streamline the process, making it more accessible for patent holders, especially those who may be navigating the system for the first time.

In addition to filing procedures, the FAQs also address critical timelines associated with different scenarios that patent holders may encounter. This includes timelines for submitting working statements for newly granted patents, as well as for those that are nearing expiration. The office of CGPDTM recognizes that timely submissions are crucial for maintaining patent rights and ensuring compliance with legal requirements, and thus, providing clear timelines helps patent holders plan their submissions effectively.

Moreover, the FAQs tackle issues related to expiring patents and the potential delays that may arise in the submission process. By clarifying the implications of these delays and offering guidance on how to manage them, the office of CGPDTM seeks to mitigate the risks associated with non-compliance, which can lead to the loss of patent rights. This proactive approach is intended to foster a more robust patent ecosystem in India, where patent holders can confidently navigate their obligations with

out fear of inadvertently jeopardizing their intellectual property.

Overall, by providing clear and concise answers to the common questions, office of CGPDTM aims to simplify the process for all stakeholders involved in the patent system. This includes not only patent holders but also legal practitioners, researchers, and businesses that rely on patents for innovation and competitive advantage. The release of these FAQs marks a positive development in the ongoing efforts to enhance the efficiency and effectiveness of the patent system in India, ultimately contributing to a more conducive environment for innovation and economic growth.

The FAQs provided by the office of CGPDTM is reproduced below:

1) What is Form-27?

Answer: Form-27 is a statutory requirement under Section 146(2) of the Patents Act, 1970 (as amended) and Rule 131(1) of the Patents Rules, 2003 (as amended) for submission of a statement regarding the working of the patented invention on a commercial scale in India.

2) Who needs to file Form-27?

Answer: Every patentee and every licensee in India shall file Form-27, a statement of working of the patented invention on a commercial scale in India:

- In case of multiple patents, one Form 27 may be filed in respect of multiple patents, provided all of them are related patents and are granted to the same patentee(s).
- Patentee/licensee may authorize a registered Patent Agent or attorney to file Form 27 on their behalf.

3) What is the deadline to file Form-27?

Answer: Form-27 shall be filed once in respect of every period of three financial years, beginning from the financial year right after the patent is granted and within six months following the end of each three-year period.

4) Is there any possibility of extending the deadline to file Form-27?

Answer: Yes. The deadline to file Form-27 may be extended up to three months upon a request made in Form 4 in the prescribed manner under Rule 131(2) of the Patents Rules and further for a period of up to six months upon a request made in Form-4 in the prescribed manner under Rule 138 of the Patents Rules.

5) Is filing of Form-27 mandatory? What are the penalties for non-compliance?

Answer: Yes. The filing of Form 27 is mandatory. Non-filing of Form-27 may lead to imposition of a penalty under section 122 of the Patents Act, 1970 [as amended through the Jan Vishwas (Amendment of Provisions) Act, 2023].

6) Can Form-27 be filed for multiple patents?

Answer: Yes. A single Form-27 can be filed for submitting details regarding the multiple patents, provided that all are related patents and are granted to the same patentee(s).

7) What are different possible scenarios and their associated timelines for filing Form- 27?

Answer: Form-27 must be filed once in respect of every period of three financial years, beginning from the financial year right after the patent is granted

and within six months following the end of each three-year period.

As the Patents (Amendment) Rules, 2024 come into effect from 15th March, 2024; the period of three years would be applicable prospectively. If a patentee/licensee did not submit Form 27 details for

the financial year 2022-2023 or earlier within the prescribed time limit under the previous rules, they cannot file Form 27 for these missed years by clubbing the lapsed period with the time available for financial year 2023-2024 as a three-year block under the new rules.

For clarity, following illustrations are provided:

| Scenarios | Illustration |
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| In respect of patents granted before 2022-23 | <ul style="list-style-type: none"> • As per the earlier rules, Form-27 for these patents in respect of the period FY 2023-24 would have been due from 1st April, 2024 (assuming that Form-27 for FY 2022-23 has been filed in time). • As per the Patents (Amendment) Rules, 2024, window period for filing of Form-27 in respect of a period of three financial years, i.e. FY 2023-24 to FY 2025-26, without extension of deadline will be 1st April, 2026 to 30th September, 2026. • Deadline for filing Form-27 can be extended up to 31st December, 2026 by filing Form 4 under rule 131(2). • Deadline for filing of Form-27 can be further extended up to 30th June, 2027 under rule 138. • Where Patentee/Licensee has failed to avail an extension of three months under rule 131(2), deadline for filing Form-27 can be extended up to 31st March, 2027 under rule 138. • If patentee has failed to provide Form-27 details for the period of FY 2022-23 or earlier within the time limit prescribed under the earlier rules, Form 27 cannot be filed under the new rules for the lapsed FYs (FY 2021-22, FY 2022-23) by clubbing the lapsed period with the time period available for FY 2023-24 as a block of 3 years. |
| In respect of patents granted in 2022-23 | <p>In all these cases, irrespective of the date of grant of a patent, a period of three-years starts from FY 2023-24.</p> <ul style="list-style-type: none"> • Window period for filing Form-27 without extension of deadline will be 1st April, 2026 to 30th September, 2026. • Deadline for filing Form-27 can be extended up to 31st December, 2026 by filing Form 4 under rule 131(2). • Deadline for filing Form-27 can be further extended up to 30th June, 2027 under rule 138. |

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| | <ul style="list-style-type: none"> Where Patentee/Licensee has failed to avail an extension of three months under rule 131(2), deadline for filing Form-27 can be extended up to 31st March, 2027 under rule 138. |
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| <p>In respect of patents granted in or after 2023-24</p> | <p>Case 1:</p> <p>For patents granted in FY 2023-24, counting of a period of three-years starts from FY 2024-25.</p> <ul style="list-style-type: none"> Window period for filing Form-27 without extension of deadline will be 1st April, 2027 to 30th September, 2027. Deadline for filing Form-27 can be extended up to 31st December, 2027 by filing Form 4 under rule 131(2). Deadline for filing Form-27 can be further extended up to 30th June, 2028 under rule 138. Where Patentee/Licensee has failed to avail an extension of three months under rule 131(2), deadline for filing Form-27 can be extended up to 31st March, 2028 under rule 138. <p>Case 2:</p> <p>For patents granted in FY 2024-25, counting of three-year period starts from FY 2025-26.</p> <ul style="list-style-type: none"> Window period for filing Form-27 without extension of deadline will be 1st April, 2028 to 30th September, 2028. Deadline for filing Form-27 can be extended up to 31st December, 2028 by filing Form 4 under rule 131(2). Deadline for filing Form-27 can be further extended up to 30th June, 2029 under rule 138. <p>Where Patentee/Licensee has failed to avail an extension of three months under rule 131(2), deadline for filing Form-27 can be extended up to 31st March, 2029 under rule 138.</p> |
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8)What will be the scenario in the case of patents going to be expired in the FYs 2023-24 and 2024-25?

Answer:

| Scenarios | Illustration |
|-----------|--------------|
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|------------------------------------|--|
| Patents expired in FY 2023-24 | <p>Patentee/Licensee can file Form-27 only for the remaining period, i.e. for FY 2023-24.</p> <p>Form-27 to be submitted for FY 2023-24:</p> <ul style="list-style-type: none"> • Window period for filing Form-27 without extension of deadline will be 1st April, 2024 to 30th September, 2024. • Deadline for filing Form-27 can be extended up to 31st December, 2024 by filing Form 4 under rule 131(2). • Deadline for filing Form-27 can be further extended up to 30th June, 2025 under rule 138. • Where Patentee/Licensee has failed to avail an extension of three months under rule 131(2), deadline for filing Form-27 can be extended up to 31st March, 2025 under rule 138. |
| Patents expiring in the FY 2024-25 | <p>Patentee/Licensee can file Form-27 only for the remaining period, i.e. FY 2023-24 and 2024-25.</p> <p>Form-27 to be submitted for FY 2023-24 to 2024-25:</p> |
| | <ul style="list-style-type: none"> • Window period for filing of Form-27 without extension of deadline will be 1st April, 2025 to 30th September, 2025. • Deadline for filing Form-27 can be extended up to 31st December, 2025 by filing Form 4 under rule 131(2). • Deadline for filing Form-27 can be further extended up to 30th June, 2026 under rule 138. • Where Patentee/Licensee has failed to avail an extension of three months under rule 131(2), deadline for filing Form-27 can be extended up to 31st March, 2026 under rule 138. |

9) Can multiple stakeholders (like patentees, exclusive or non-exclusive licensees) file Form-27 separately for same patent or a group of patents?

Answer: Yes. Patentees and exclusive or non-exclusive licensees can file Form-27 separately for the same patent or a group of patents.

10) What are the possibilities available for filing Form-27 where deadline to file it has expired before the commencement of the Patents (Amendment) Rules, 2024?

Answer: No. It is not possible to file Form 27 where the due date for filing was over before the commencement of the Patents (Amendment) Rules, 2024.

11) Whether delay in filing of Form-27 can be condoned by filing a petition under rule 137?

Answer: No. Provision under rule 137(2) bars the Patentee/Licensee from seeking the condonation of delay in filing of Form-27.

12) As per Rule 131(2), Form-27 shall be furnished once in respect of every period of three financial years. Whether Form 27 needs to be filed separately for each financial year in the block of three financial years?

Answer: No. Single Form 27 can be filed in respect of every period of three financial years.

APPOINTMENT OF SUBHASH CHANDRA KAROL, DIRECTOR OF THE DPIIT, AS THE HEAD OF THE IT OFFICE OF THE CGPDTM

On August 27, 2024, a formal notification was released announcing that Mr. Subhash Chandra Karol, who currently serves as the Director of the Department for Promotion of Industry and Internal Trade (DPIIT), has been entrusted with the additional responsibility of managing the Information Technology (IT) office of the Controller General of Patents, Designs, and Trade Marks (CGPDTM).

To read the complete report, please visit Spicy IP at the following link:

<https://spicyip.com/2024/08/spicyip-tidbit-cgpdtm-in-spotlight-dpiit-head-takes-over-cgpdtm-it-division.html>

GNANLEX IN INTERNATIONAL EXHIBITION FOR PHARMA AND HEALTHCARE (IPHEX), DELHI

Adv. Praveen Singh, a representative of GNANLex Associates LLP, had the esteemed opportunity to participate in the International Exhibition for



Pharma and Healthcare (Iphex), a significant event that was held in Delhi from August 28th to 30th.

This exhibition served as a prominent platform for industry professionals and innovators to come together and showcase the latest advancements, products, and services in the pharmaceutical and healthcare sectors.

The Iphex event allowed GNANLex to showcase its expertise and engage with potential clients, and professionals, reinforcing its



commitment to excellence in legal matters. The event also facilitated valuable networking opportunities, enabling meaningful discussions and potential collaborations.

