

## **Patent Rules, 2003**

### CONTENTS

#### **CHAPTER 1 :- PRELIMINARY**

1. Short Title And Commencement
2. Definitions
3. Prescribed Particulars
4. Appropriate Office
5. Address For Service
6. Leaving And Serving Documents
7. Fees
8. Forms
9. Size Etc. Of Documents

#### **CHAPTER 2 :- APPLICATION FOR PATENTS**

10. Period Within Which Proof Of The Right Under Section 7(2) To Make The Application Shall Be Furnished
11. Order Of Recording Applications
12. Statement And Undertaking Regarding Foreign Applications
13. Specifications
14. Amendments To Specifications
15. Drawings
16. Models

#### **CHAPTER 3 :-INTERNATIONALAPPLICATIONS UNDER PATENT COOPERATION TREATY (PCT)**

17. Definitions
18. Appropriate Office In Relation To International Applications
19. International Applications Filed With Appropriate Office As Receiving Office
20. International Applications Designating Or Designating And Electing India
21. Filing Of Priority Document
22. Effect Of Non-Compliance With Certain Requirements
23. The Requirements Under This Chapter To Be Supplemental Of The Regulations, Etc., Under The Treaty

#### **CHAPTER 4 :-PUBLICATIONAND EXAMINATION OF APPLICATIONS**

24. Examination Of Application
25. Identification Of Published Applications

26. Request For Withdrawal
27. Inspection Of Published Applications
28. Procedure In Case Of Anticipation By Prior Publication
29. Procedure In Case Of Anticipation By Prior Claiming
30. Amendment Of The Complete Specification In Case Of Anticipation
31. Form Of Reference To Another Specification
32. Procedure In Case Of Potential Infringement
33. Form Of Reference To Another Patent
34. Manner In Which A Claim Under Section 20(1) Shall Be Made
35. Manner In Which A Request May Be Made Under Section 20(4)
36. Manner Of Application Under Section 20(5)
37. Numbering Of Applications On Acceptance Of The Complete Specification
38. Inspection Of Application, Specification, Etc.

## **CHAPTER 5 :- EXCLUSIVE MARKETING RIGHTS**

39. Filing Of Application
40. The Application For Grant Of Exclusive Marketing Right
41. Controller To Refer Application
42. Report Of Examiner
43. Notifying Of Grant Or Refusal Of Exclusive Marketing Rights
44. Personal Documents, Etc., In Relation To Inventions
45. Appropriate Tests
46. Form For Grant Of Exclusive Marketing Rights
47. Application For Compulsory Licence To Sell Or Distribute Or For Revocation Of Exclusive Marketing Rights
48. When A Prima Facie Case Is Not Made Out
49. Notice Of Opposition Against Grant Of Compulsory Licence Or Revocation Of Exclusive Marketing Rights
50. Manner Of Advertisement Of The Order For Revocation Of Exclusive Marketing Rights
51. Application For The Revision Of The Terms And Conditions Of A Licence
52. Procedure To Be Followed In Case Of Application Under Rule 51
53. References To Public Interest
54. Register Of Exclusive Marketing Rights

## **CHAPTER 6 :- OPPOSITION TO GRANT OF PATENTS**

55. Filing Of Notice Of Opposition
56. Application For Extension Of Time Under Section 25(1)
57. Filing Of Written Statement Of Opposition And Evidence
58. Filing Of Reply Statement And Evidence
59. Filing Of Reply Evidence By Opponent
60. Further Evidence To Be Left With The Leave Of The Controller
61. Copies Of Documents To Be Supplied
62. Hearing
63. Determination Of Costs
64. Time Within Which Complete Specification Is To Be Amended

## Under Section 27

65. Procedure To Be Followed

66. Form Of Making A Request Under Section 28(2)

67. Form Of Making A Claim Under Section 28(3)

68. Form Of Application To Be Made Under Section 28(7)

69. Procedure For The Hearing Of Claim Or An Application Under Section 28

70. Mention Of Inventor

## **CHAPTER 7 :- SECRECY DIRECTIONS**

71. Permission For Making Patent Application Outside India Under Section 39

72. Communication Of Result Of Reconsideration Under Section 36(2)

## **CHAPTER 8 :- SEALING OF PATENTS**

73. Sealing Of Patents

74. Form Of Patent

75. Amendment Of Patent Under Section 44

76. Manner Of Applying For Direction Under Section 51(1)

77. Manner Of Application Under Section 51(2)

78. Procedure For The Hearing Of Proceedings Under Section 51

79. Request Under Section 52(2)

80. Renewal Fees Under Section 53

## **CHAPTER 9 :- AMENDMENT OF APPLICATION, SPECIFICATION OR ANY DOCUMENT RELATING THERETO**

81. Amendment Of Application, Specification Or Any Document Relating

82. Preparation Of Amended Specifications, Etc.

83. Advertisement Of The Amendment Allowed

## **CHAPTER 10 :- RESTORATION OF PATENTS**

84. Restoration Of Patents

85. Opposition To Restoration Under Section 61

86. Payment Of Unpaid Renewal Fees

## **CHAPTER 11 :- SURRENDER OF PATENTS**

87. Surrender Of Patents

## **CHAPTER 12 :- REGISTER OF PATENTS**

88. Register Of Patents Under Section 67

89. Registration Of Documents Under Section 68

90. Registration Of Title And Interest In Patents

91. Presentation Of Assignment, Etc. Of Patent To Controller

92. Registration Of Title Or Interest In A Patent

93. Entry Of Renewal Fee

94. Alteration Of Address

95. Inspection Of Register Of Patents Under Section 72 And Fees Payable Therefor

### **CHAPTER 13 :-COMPULSORY LICENCE AND REVOCATION OF PATENT**

96. Application For Compulsory Licence Etc

97. When A Prima Facie Case Is Not Made Out

98. Notice Of Opposition Under Section 87(2)

99. Manner Of Advertisement Of The Revocation Order

100. Application Under Section 88(4)

101. Procedure To Be Followed In Case Of Applications Under Section 88(4)

102. Application For Termination Of Compulsory Licence Under Section 94

### **CHAPTER 14 :- SCIENTIFIC ADVISERS**

103. Roll Of Scientific Advisers

104. Manner Of Application For Inclusion In The Roll Of Scientific Advisers

105. Inclusion Of The Name Of Any Other Person In The Roll Of Scientific Advisers

106. Power To Relax

107. Removal Of Names From The Roll Of Scientific Advisers

### **CHAPTER 15 :- PATENT AGENTS**

108. Particulars To Be Contained In The Register Of Patent Agents

109. Application For Registration Of Patent Agents

110. Particulars Of The Qualifying Examination For Patent Agents

111. Registration Of Patent Agents

112. Details To Be Included In An Application For The Registration Of A Patent Agent

113. Registration Of Patent Agents Under Section 126(2)

114. Disqualifications For Registration As A Patent Agent

115. Payment Of Fees

116. Removal Of A Name From The Register Of Patent Agents

117. Restoration Of Name Of Persons Removed From The Register Of Patent Agents

118. Alteration Of Names Etc. In The Register Of Patent Agents

119. Refusal To Recognise As Patent Agent

120. Publication Of The Names Of Patent Agents, Registered Under The Act

### **CHAPTER 16 :- MISCELLANEOUS**

121. Address For Communications

122. Correction Of Clerical Errors

123. Manner Of Advertisement Of The Proposed Correction Of Any Error

124. Manner And Time Of Opposition To The Making Of Corrections
125. Notification Of Corrections
126. Form, Etc. Of Affidavits
127. Exhibits
128. Directions Not Otherwise Prescribed
129. Exercise Of Discretionary Power By The Controller
130. Application For Review Of Decisions Or Setting Aside Of Orders Of The Controller
131. Form And Manner In Which Statements Required Under Section 146(2) To Be Furnished
132. Form Of Application For The Issue Of A Duplicate Patent
133. Supply Of Certified Copies And Certificates Under Sections 72 And 147
134. Request For Information Under Section 153
135. Agency
136. Scale Of Costs
137. Powers Of Controller Generally
138. Power To Extend Time Prescribed
139. Hearing Before The Controller To Be In Public Certain Cases

**SCHEDULE 1 :- SCHEDULE I**

**SCHEDULE 2 :- SCHEDULE II**

**Patent Rules, 2003**

Whereas certain draft rules were published in exercise of the powers conferred by section 159 of the Patents Act, 1970 vide Noti. of the Govt. of India in Ministry of Commerce and Industry (Dept. of Indl. Policy and Promotion) vide Number SO 1018(E), dt. 20-9-2002, in Part II, section 3, sub-section (ii) of the Gazette of India (Extra.), dt. 20-9-2002, for inviting objections and suggestions from persons likely to be affected thereby before expiry of a period of thirty days from the date on which copies of the Gazette containing the Notification were made available to the public; And whereas the copies of the Gazette containing the said Noti. were made available to the public on 3-10-2002; And whereas objections and suggestions received from the public on the said draft rules have been considered by the Central Government; Now, therefore, in exercise of the powers conferred by section 159 of the Patents Act, 1970 and in supersession of the Patents Rules, 1972 published in the Gazette of India, vide S.O. 301(E), dt. 20-4-1972 in Part II, section 3, sub-section (ii), except as respect things done or omitted to be done before such supersession, Central Government hereby makes the following rules, namely:-

**CHAPTER 1 PRELIMINARY**

## **1. Short Title And Commencement :-**

- (1) These rules may be called the Patents Rules, 2003.
- (2) They shall come into force on the date on which the Patents (Amendment) Act, 2002 comes into force.

## **2. Definitions :-**

In these rules, unless the context otherwise requires,-

- (a) "Act" means the Patents Act, 1970 (39 of 1970);
- (b) "appropriate office" means the appropriate office of the patent office as specified in rule 4;
- (c) "article" includes any substance or material, and any plant, machinery or apparatus, whether affixed to land or not;
- (d) "Form" means a Form specified in the Second Schedule;
- (e) "Schedule" means Schedule to these rules;
- (f) "section" means a section of the Act;
- (g) words and expressions used, but not defined in these rules, shall have the meanings respectively assigned to them in the Act.

## **3. Prescribed Particulars :-**

Save as otherwise provided in these rules, the particulars contained in a Form are hereby prescribed as the particulars, if any, required under the relevant provision or provisions of the Act.

## **4. Appropriate Office :-**

- (1) The appropriate office of the patent office shall-
  - (i) for all the proceedings under the Act, other than those under sections 24A, 24B, 24C, 39, 65 and 125 be the head office of the patent office or the branch office, as the case may be, within whose territorial limits-
    - (a) the applicant or first mentioned applicant in case of joint applicants for a patent, normally resides or has his domicile or has a place of business or the place from where the invention actually originated; or
    - (b) the applicant for a patent or party in a proceeding if he has no place of business or domicile in India, the address for service in India given by such applicant or party is situated; and
  - (ii) for proceedings under sections 24A, 24B, 24C, 39, 65 and 125 be the head office of the patent office.
- (2) The appropriate office once decided in respect of any

proceedings under the Act shall not ordinarily be changed.

#### **5. Address For Service :-**

Every person, concerned in any proceedings to which the Act or these rules relate and every patentee, shall furnish to the Controller and address for service in India and that address may be treated for all purposes connected with such proceedings or patent as the address of the person concerned in the proceedings or of the patentee. Unless such an address is given, the Controller shall be under no obligation either to proceed or deal with any proceeding, or patent or to send any notice that may be required to be given under the Act or these rules.

#### **6. Leaving And Serving Documents :-**

(1) Any application, notice or other document authorised or required to be filed, left, made or given at the patent office, or to the Controller or to any other person under the Act or these rules, may be tendered by hand or sent by a letter addressed to the Controller at the appropriate office or to that person through post or registered post or speed post or courier service or by electronic transmission duly authenticated. If it is sent by post or registered post or speed post or courier service or by electronic transmission duly authenticated, it shall be deemed to have been filed, left, made or given at the time when the letter containing the same would have been delivered in the ordinary course of post or registered post or speed post or courier service, or by electronic transmission duly authenticated, as the case may be. In proving such sending, it shall be sufficient to show that the letter was properly addressed and mailed:

PROVIDED that any application, notice or the document sent through fax or by electronic transmission duly authenticated, shall also be deemed to have been filed, left, made or given if the same is clear and fully legible and its original is submitted to the appropriate office within fifteen days from the date of receipt of such fax or by electronic transmission duly authenticated.

(2) Any written communication addressed to a patentee at his address as it appears on the register of patents or at his address for service given under rule 5, or to any applicant or opponent in any proceedings under the Act or these rules, at the address appearing on the application or notice of opposition, or given for service, shall be deemed to be properly addressed.

(3) All notices and all written communications addressed to a patentee, or to any applicant or opponent in any proceedings under the Act or these rules, and all documents forwarded to the patentee or to the said applicant or opponent, shall, except when they are sent by special messenger, be sent by registered post or speed post or courier service or by electronic transmission duly authenticated.

(4) The date of a notice or a written communication addressed to a patentee or to any applicant or opponent in any proceedings under the Act and these rules shall be the date of dispatch of the said notice or written communication, by registered post or speed post or courier or fax or electronic transmission duly authenticated, as the case may be, unless otherwise specified under the Act or these rules.

(5) In case of delay in receipt of a document or a communication sent by the patent office to a party to any proceedings under the Act or these rules, the delay in transmitting or resubmitting a document to the patent office or doing any act by the party may be condoned by the Controller if a petition for such condonation of delay is made by the party to the Controller immediately after the receipt of the document or a communication along with a statement regarding the circumstances of the fact and evidence in support of the statement:

PROVIDED that the delay condoned by the Controller shall not exceed the period between the date on which the party was supposed to have received the document or communication by ordinary course of mail or electronic transmission and the actual date of receipt of the same.

## **7. Fees :-**

(1) The fees payable under section 142 in respect of the grant of patents and applications therefor, and in respect of other matters for which fees are required to be payable under the Act shall be as specified in the First Schedule.

(2) (a) The fees payable under the Act may either be paid in cash or may be sent by bank draft or cheque payable to the Controller of Patents and drawn on a scheduled bank at the place where the appropriate office is situated. If the draft or cheque is sent by post, the fees shall be deemed to have been paid on the date on which the draft or cheque would have reached the Controller in the ordinary course of mail.

( b ) Cheques or drafts not including the correct amount of commission and cheques on which the full value specified therein cannot be collected in cash within the time allowed for payment of the fees, shall be accepted only at the discretion of the Controller.

(c) Where a fee is payable in respect of a document, the entire fee shall accompany the document or shall be paid within one month from the date of filing of the document:

PROVIDED that the Controller may accept the fee in part and allow remaining part of the fee to be paid at any time within one month from the date of filing of the document notwithstanding the expiry of the due date for filing of such document and on such payment the document shall be taken on record from the date of its filing.

(3) In case an application processed by a natural person is fully or partly transferred to a person other than a natural person, the difference, if any, in the scale of fee(s) between the fee(s) charged from a natural person and the fee(s) chargeable from the person other than the natural person in the same matter shall be paid by the new applicant with the request for transfer.

(4) Fees once paid in respect of any proceeding shall not be refunded irrespective of whether the proceeding has taken place or not.

(5) (i) Subject to the approval of the Controller, any person may deposit money in advance and request the Controller to realise any fee payable by him from the said deposit and in such case the date of the receipt of the request to realise the fee or the date on which the request to realise the fee is deemed to have been received, whichever is earlier, shall be taken as the date of payment of the fee:

PROVIDED that the requisite amount of money is available at the credit of the person making such request.

(ii) Subject to the approval of the Controller, any person may discontinue the deposit of money in advance and in such case the balance, if any, shall be refunded.

## **8. Forms :-**

(1) The Forms set forth in the Second Schedule with such variations as the circumstances of each case may require shall be used for the purposes mentioned therein.

(2) Where no Form is so specified for any purpose, the applicant may adopt any Form specified in the Second Schedule with such modifications and variations as may be required.

## **9. Size Etc. Of Documents :-**

(1) All documents and copies of documents, except affidavits and drawings, sent to or left at the patent office or otherwise furnished to the Controller shall be written or typewritten or printed either in Hindi or in English language (unless otherwise directed or allowed by the Controller) in large and legible characters with deep indelible ink with lines widely spaced upon one side only of strong white paper of a size A4 of approximately 29.7 centimeters by 21 centimeters with a margin of at least 4 centimeters on the top and left hand part and 3 cm on the bottom and right hand part thereof. Any signature which is not legible or which is written in a script other than Hindi or English shall be accompanied by a transcription of the name either in Hindi or in English in block letters:

PROVIDED that any document including drawing, if any, may also be filed in electronic form along with a copy of it on white paper:

PROVIDED FURTHER that in case the application for patent discloses sequence listing of nucleotides and/or amino acids, the same shall be filed in electronic form.

(2) Additional copies of all documents shall be filed at the appropriate office, if required by the Controller.

(3) Names and addresses of applicants and other persons shall be given in full together with their nationality and such other particulars, if any, as are necessary for identification.

## **CHAPTER 2 APPLICATION FOR PATENTS**

### **10. Period Within Which Proof Of The Right Under Section 7(2) To Make The Application Shall Be Furnished :-**

Where, in an application for a patent made by virtue of an assignment of the right to apply for the patent for the invention, if the proof of the right to make the application is not furnished with the application, the applicant shall within a period of three months after the filing of such application furnish such proof.

Explanation : For the purposes of this rule, the three months period in case of an application corresponding to an international application in which India is designated shall be reckoned from the actual date on which the corresponding application is filed in India.

### **11. Order Of Recording Applications :-**

The applications filed in a year shall constitute a series identified by

the year of such filing. In case of an application filed corresponding to an international application in which India is designated, such application shall constitute a series distinct from the rest of the applications identified by the year of filing of corresponding applications in India.

## **12. Statement And Undertaking Regarding Foreign Applications :-**

(1) The statement and undertaking required to be filed by an applicant for a patent under sub-section (1) of section 8 shall be made in Form 3.

(2) 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 three months from the date of such filing.

(3) When so required by the Controller under sub-section (2) of section 8, the applicant shall furnish information relating to objections, if any, in respect of novelty and patentability of the invention and any other particulars as the Controller may require which may include claims of application allowed.

(4) An application for extension of time specified in sub-section (2) of section 8 shall be made in Form 4.

## **13. Specifications :-**

(1) Every specification, whether provisional or complete, shall be made in Form 2.

(2) A specification in respect of a divisional application under section 16 shall contain specific reference to the number of the original application from which the divisional application is made.

(3) A specification in respect of a patent of addition under section 54 shall contain a specific reference to the number of the main patent, or the application for the main patent, as the case may be, and a definite statement that the invention comprises an improvement in, or a modification of, the invention claimed in the specification of the main patent granted or applied for.

(4) Where the invention requires explanation through drawings, such drawings shall be prepared in accordance with the provisions of rule 15 and shall be supplied with, and referred to in detail, in the specification:

PROVIDED that in the case of a complete specification, if the

applicant desires to adopt the drawings filed with his provisional specification as the drawings or part of the drawings for the complete specification, it shall be sufficient to refer to them in the complete specification as those left with the provisional specification.

(5) Irrelevant or other matter, not necessary, in the opinion of the Controller, for elucidation of the invention, shall be excluded from the title, description, claims and drawings.

(6) Except in case of an application (other than a convention application) which is accompanied by a complete specification, a declaration as to the inventorship of the invention shall be filed in Form 5 with the complete specification or at any time before the expiration of one month from the date of filing of the complete specification, as the Controller may allow on an application made in Form 4.

Explanation : For the purposes of this rule, the date of filing of the complete specification with respect to an application corresponding to an international application in which India is designated shall be reckoned from the actual date on which the corresponding application is filed in India.

(7) (a) The abstract as specified under clause (d) of sub-section (4) of section 10, accompanying the specification shall commence with the title of the invention. The title of the invention shall disclose the specific features of the invention normally in not more than fifteen words.

(b) The abstract shall contain a concise summary of the matter contained in the specification. The summary shall indicate clearly the technical field to which the invention belongs, technical problem to which the invention relates and the solution to the problem through the invention and principal use or uses of the invention. Where necessary, the abstract shall contain the chemical formula, which characterises the invention.

(c) The abstract may not contain more than one hundred and fifty words.

(d) If the specification contains any drawing, the applicant shall indicate on the abstract the figure, or exceptionally, the figures of the drawings which may accompany the abstract when published. Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by the reference sign used in that drawing.

(e) The abstract shall be so drafted that it constitutes an efficient instrument for the purposes of searching in the particular technical

field, in particular by making it possible to assess whether there is a need to consult the specification itself.

#### **14. Amendments To Specifications :-**

(1) When a provisional or complete specification or any drawing accompanying it has been received by the applicant or his agent for amendment, the necessary alterations shall be made thereon as far as possible. Additional matter may be interpolated if necessary, by rewriting such pages as are required to form a continuous document. Amendments shall not be made by slips pasted on, or as footnotes or by writing in the margin of any of the said documents.

(2) The amended documents shall be returned to the Controller together with the superseded pages or drawings, if any, duly marked, cancelled and initialled by the applicant or his agent. Copies of any pages that have been retyped or added and of any drawing that has been added or substantially amended shall be sent in duplicate. Amendments, alterations or additions shall be initialled in the margin by the applicant or his agent.

#### **15. Drawings :-**

(1) Drawings, when furnished under section 10 by the applicants otherwise than on requisition made by the Controller, shall accompany the specifications to which they relate.

(2) No drawings or sketch, which would require a special illustration of the specification, shall appear in the specification itself.

(3) At least one copy of the drawing shall be prepared neatly and clearly on a durable paper sheet.

(4) Drawings shall be on standard A4 size sheets with a clear margin of at least 4 cm on the top and left hand and 3 cm at the bottom and right hand of every sheet.

(5) Drawings shall be on a scale sufficiently large to show the inventions clearly and dimensions shall not be marked on the drawings.

(6) Drawing shall be sequentially or systematically numbered and shall bear-

(i) in the left hand top corner the name of the applicant;

(ii) in the right hand top corner, the number of the sheets of drawings, and the consecutive number of each sheet; and

(iii) in the right hand bottom corner, the signature of the applicant or his agent.

(7) No descriptive matter shall appear on the drawings except in

the flow diagrams.

### **16. Models :-**

Models or samples shall be furnished under section 10 only when required by the Controller.

## **CHAPTER 3 INTERNATIONAL APPLICATIONS UNDER PATENT COOPERATION TREATY (PCT)**

### **17. Definitions :-**

In this Chapter, unless the context otherwise requires,-

- (a) "Article" means an Article of the Treaty;
- (b) "Treaty" or "PCT" means the Patent Cooperation Treaty;
- (c) All other words and expressions used herein and not defined but defined in the PCT shall have the same meaning as assigned to them in that Treaty.

### **18. Appropriate Office In Relation To International Applications :-**

(1) The receiving office, designated office and elected office for the purposes of international applications filed under the Treaty shall be the appropriate office in accordance with rule 4.

(2) The head office of the patent office shall be the appropriate office for dealing with the International Bureau of the World Intellectual Property Organisation, International Searching Authorities and International Preliminary Examining Authorities.

(3) An international application under the Treaty shall be filed at and processed by the appropriate office in accordance with the provisions of this Chapter, the Treaty and the regulations established under the PCT.

(4) Notwithstanding anything contained in sub-rule (2), on receipt of an international application, the appropriate office shall transmit one copy as record copy of such application to International Bureau of the World Intellectual Property Organisation and another copy as search copy to Competent International Searching Authority. The appropriate office shall simultaneously furnish complete details of such application to the head office of the patent offices.

### **19. International Applications Filed With Appropriate Office As Receiving Office :-**

- (1) An international application shall be filed with the appropriate office in triplicate in respect of head office and quadruplicate in respect of branch offices, either in English or in Hindi language.
- (2) The fees payable in respect of an international application filed with the appropriate office shall be, in addition to the fees as specified in the regulations under the Treaty, the fees as specified in the First Schedule.
- (3) Where an international application filed with the appropriate office has not been filed as specified under sub-rule (1) and the applicant desires that the appropriate office should prepare the additional copies required, the fee for making such copies shall be paid by the applicant.
- (4) On receipt of a request from the applicant and on payment of the prescribed fee by him, the appropriate office shall prepare a certified copy of the priority document and promptly transmit the same to the International Bureau of the World Intellectual Property Organisation for the purpose of an international application filed with the appropriate office with an intimation to the applicant and the head office.

## **20. International Applications Designating Or Designating And Electing India :-**

- (1) An application corresponding to an international application under the Patent Cooperation Treaty under section 7(1A) may be made in Form IA.
- (2) The Patent Office shall not commence processing of an application filed corresponding to international application designating India before the expiration of the time-limit prescribed under sub-rule (4).
- (3) An applicant in respect of an international application designating India shall, before the time-limit prescribed in sub-rule (4),-
  - (a) pay the prescribed national fee and other fees to the patent office in the manner prescribed under these rules and under the regulations made under the Treaty;
  - (b) and where the international application was either not filed or has not been published in English, file with the patent office, a translation of the application in English, duly verified by the applicant that the contents thereof are correct and complete.
- (4) The time limit referred to in sub-rule (2) shall be, where the applicant has or has not, before the expiration of nineteen months

from the priority date referred to in Article 2(xi), elected India for the purpose of the use of the result of international preliminary examination, thirty one months from the said priority date.

(5) The translation of the international application referred to in sub-rule (3) shall include a translation in English of,-

(i) the description;

(ii) the claims as filed;

(iii) any text matter of the drawings;

(iv) the abstract;

(v) in case the applicant has not elected India and if the claims have been amended under Article 19, then the amended claims together with any statement filed under the said Article; and

(vi) in case the applicant has elected India and any amendments to the description, the claims and text matter of the drawings that are annexed to the international preliminary examination report.

(6) If the applicant fails to file a translation of the amended claims and annexures referred to in sub-rule (5), even after invitation from the appropriate office to do so, within a time limit as may be fixed by that office having regard to the time left for meeting the requirements, the amended claims and annexures shall be disregarded in the course of further processing the application by the appropriate office.

(7) The applicant in respect of an international application designating India shall when complying with sub-rule (3), preferably use Forms set out in the Second Schedule before the appropriate office as designated office.

## **21. Filing Of Priority Document :-**

(1) Where the applicant in respect of an international application designating India has not complied with the requirements of paragraph (a) or paragraph (b) of rule 17.1 of the regulations under the Treaty, the applicant shall file with the patent office the priority document referred to in that rule before the expiration of the time limit referred to in sub-rule (4) of rule 20.

(2) Where priority document referred to in sub-rule (1) is not in the English language, an English translation thereof duly verified by the applicant shall be filed within the time limit specified in sub-rule (4) of rule 20.

(3) Where the applicant does not comply with the requirements of sub-rule (1) or sub-rule (2), the appropriate office shall invite the applicant to file the priority document or the translation thereof, as

the case may be, within three months from the date of such invitation, and if the applicant fails to do so, the claim of applicant for the priority shall be disregarded for the purposes of the Act.

## **22. Effect Of Non-Compliance With Certain Requirements :-**

An international application designating India shall be deemed to be withdrawn if the applicant does not comply with the requirements of rule 20.

## **23. The Requirements Under This Chapter To Be Supplemental Of The Regulations, Etc., Under The Treaty :-**

(1) The provisions of this Chapter shall be supplemental to the PCT and the regulation and the administrative instructions made thereunder.

(2) In case of a conflict between any provisions of the rules contained in this Chapter and provisions of the Treaty and the regulations and the administrative instructions made thereunder, the provisions of the Treaty and the regulations and administrative instructions made thereunder shall apply in relation to international applications.

## **CHAPTER 4 PUBLICATION AND EXAMINATION OF APPLICATIONS**

### **24. Examination Of Application :-**

(1) A request for examination under section 11B shall be made in Form 19.

(2) A request for examination of application for patent filed under sub-rule (1) shall be taken up for examination in the order in which the request is filed.

(3) A first examination report along with the application and specification shall be sent to the applicant or his authorised agent. In case any other interested person files a request for examination, an intimation of such examination may be sent to such interested person.

(4) An applicant shall submit his first reply to the first examination report within a period of four months from the date of issue of such statement.

(5) The time for putting, all the applications in order for acceptance which have been examined before the commencement of the Patents (Amendment) Act, 2002, shall be fifteen months or eighteen months as the case may be, from the date on which the

first statement of objections is issued to the applicant to comply with the requirements.

**25. Identification Of Published Applications :-**

Publication of application under sub-sections (2) and (5) of section 11A shall be identified by the letter `A along with the number of application.

**26. Request For Withdrawal :-**

(1) A request for withdrawing the application under sub-section (4) of section 11B shall be made in writing.

(2) In case the request for withdrawing the application under sub-section (4) of section 11B has been made at least three months prior to the expiry of the period specified in sub-section (1) of section 11A, the application shall not be published.

**27. Inspection Of Published Applications :-**

After the date of publication of the application under section 11A, the application together with the complete specification and provisional specification, if any, the drawing, if any, and the abstract filed in respect of the application may be inspected at the appropriate office by making a written request to the Controller on payment of the fee specified in the First Schedule in that behalf.

**28. Procedure In Case Of Anticipation By Prior Publication :-**

(1) If the Controller is satisfied after investigation under section 13 that the invention so far as claimed in any claim of the complete specification has been published in any specification or other document referred to in clause (a) of sub-section (1) or sub-section (2) of the said section, the Controller shall communicate the gist of specific objections and the basis thereof to the applicant and the applicant shall be afforded an opportunity to amend his specification.

(2) If the applicant contests any of the objections communicated to him by the Controller under sub-rule (1), or if he refiles his specification along with his observations as to whether or not the specification is to be amended, he shall be given an opportunity to be heard in the matter if he so requests:

PROVIDED that such request shall be made on a date earlier than

ten days of the final date of the period specified under sub-section (1) of section 21:

PROVIDED FURTHER that a request for hearing may be allowed to be filed within such shorter period as the Controller may deem fit in the circumstances of the case.

(3) If the applicant requests for a hearing under sub-rule (2) within a period of one month from the date of communication of the gist of objections, or, the Controller, considers it desirable to do so, whether or not the applicant has refiled his application, he shall forthwith fix a date and time for hearing having regard to the period remaining for putting the application in order or to the other circumstances of the case.

(4) The applicant shall be given ten days notice of any such hearing or such shorter notice as appears to the Controller to be reasonable in the circumstances of the case and the applicant shall, as soon as possible, notify the Controller whether he will attend the hearing.

(5) After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Controller may specify or permit such amendment of the specification as he thinks fit to be made and may refuse to accept the specification unless the amendment so specified or permitted is made within such period as may be fixed.

### **29. Procedure In Case Of Anticipation By Prior Claiming :-**

(1) When it is found that the invention so far as claimed in any claim of the complete specification, is claimed in any claim of any other specification falling within clause (b) of sub-section (1) of section 13, the applicant shall be so informed and shall be afforded an opportunity to amend his specification.

(2) If the applicants specification is otherwise in order for acceptance and an objection under clause (b) of sub-section (1) of section 13 is outstanding, the Controller may accept the specification and allow a period of two months from the date of its acceptance for removing the objection.

### **30. Amendment Of The Complete Specification In Case Of Anticipation :-**

(1) If the applicant so requests at any time, or if the Controller is satisfied that the objection has not been removed within the period referred to in sub-clause (2) of rule 29, a date for hearing the applicant shall be fixed forthwith and the applicant shall be given at

least ten days notice of the date so fixed. The applicant shall, as soon as possible, notify the Controller whether he will attend the hearing.

(2) After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Controller may specify or permit such amendment of the specification as will be to his satisfaction to be made and may direct that reference to such other specification, as he shall mention shall be inserted in the applicants specification unless the amendment is made or agreed to within such period as he may fix.

### **31. Form Of Reference To Another Specification :-**

When in pursuance of rule 30, the Controller directs that a reference to another specification shall be inserted in the applicants complete specification, such reference shall be inserted after the claims and shall be in the following form, namely:-

"Reference has been directed, in pursuance of section 18(2) of the Patents Act, 1970, to the specification filed in pursuance of application No. ...."

### **32. Procedure In Case Of Potential Infringement :-**

If in consequence of an investigation made under section 13 or section 25, it appears to the Controller that the applicants invention cannot be performed without substantial risk of infringement of a claim of another patent, the applicant shall be so informed and the procedure provided in rule 29 shall, so far as may be necessary, be applicable.

### **33. Form Of Reference To Another Patent :-**

Where the Controller directs that a reference to another patent shall be inserted in the applicants complete specification under sub-section (1) of section 19, such reference shall be inserted after the claims in the following form, namely-

"Reference has been directed, in pursuance of section 19(1) of the Patents Act, 1970, to Patent No. ...."

### **34. Manner In Which A Claim Under Section 20(1) Shall Be Made :-**

(1) A claim under sub-section (1) of section 20 shall be made in Form 6.

(2) The original assignment or agreement or an official copy or notarized copy thereof shall also be produced for the Controller's inspection and the Controller may call for such other proof of title or written consent as he may require.

**35. Manner In Which A Request May Be Made Under Section 20(4) :-**

(1) A request under sub-section (4) of section 20 shall be made in Form 6.

(2) The request shall be accompanied by proof of death of the joint applicant and a certified copy of the probate of the will of the deceased or letters of administration in respect of his estate or any other document to prove that the person who gives the consent is the legal representative of the deceased applicant.

**36. Manner Of Application Under Section 20(5) :-**

(1) An application under sub-section (5) of section 20 shall be made in Form 6 in duplicate and shall be accompanied by a statement setting out fully the facts upon which the applicant relies and the directions which he seeks.

(2) A copy of the application and statement shall be sent by the Controller to every other joint applicant.

**37. Numbering Of Applications On Acceptance Of The Complete Specification :-**

On the acceptance of a complete specification filed in respect of an application, the application shall be accorded a number (called serial number) in the series of numbers accorded to patents under the Indian Patents and Designs Act, 1911 (2 of 1911) which shall be the number of the patent which may be sealed in pursuance of the application.

**38. Inspection Of Application, Specification, Etc. :-**

After the date of advertisement of the acceptance of a complete specification under section 23, the application together with the complete specification and provisional specification, if any, the drawings and other documents, if any, as accepted by the Controller may be inspected at the appropriate office by making a written request to the Controller in that behalf along with the fee specified in the First Schedule.

## **CHAPTER 5 EXCLUSIVE MARKETING RIGHTS**

### **39. Filing Of Application :-**

An application for grant of a patent in respect of an invention covered under sub-section (2) of section 5 shall be made to the Controller in Form I along with the fee as specified in the First Schedule.

### **40. The Application For Grant Of Exclusive Marketing Right :-**

An application for grant of exclusive right to sell or distribute the article or substance shall be made to the Controller in Form 27 along with the fee as specified in the First Schedule and the Controller shall notify the filing of the application in the Official Gazette and to the authority of the Central Government that is responsible for the grant of approval to sell or distribute the article or the substance for which the application has been made.

### **41. Controller To Refer Application :-**

On receipt of an application under rule 40, the Controller shall refer the application relating to the patent to an examiner for making a report to him.

### **42. Report Of Examiner :-**

The examiner to whom an application has been referred shall make the report to the Controller within three months from the date of such reference.

### **43. Notifying Of Grant Or Refusal Of Exclusive Marketing Rights :-**

When the Controller grants or refuses an application for grant of exclusive right to sell or distribute the article or substance, he shall notify the same in the Official Gazette and to the authority of the Central Government that has granted approval to sell or distribute the article or the substance.

### **44. Personal Documents, Etc., In Relation To Inventions :-**

The recording in a document relating to specifications and trial or use as referred to in sub-section (2) of section 24B shall include

public document, public trial or use but shall not include a personal document or secret trial or use.

**45. Appropriate Tests :-**

The appropriate tests conducted or on after the 1st day of January, 1995 and referred to in section 24B shall be the tests either the whole or a part of which had been conducted for the purposes of this Chapter.

**46. Form For Grant Of Exclusive Marketing Rights :-**

Exclusive marketing rights shall be granted in Form 28.

**47. Application For Compulsory Licence To Sell Or Distribute Or For Revocation Of Exclusive Marketing Rights :-**

(1) An application to the Controller for the grant of compulsory licence under section 84, section 85, or section 92, as modified by section 24C, shall be in Form 18 or, as the case may be, in Form 20, to be modified as deemed necessary. Except in the case of an application made by the Central Government, the application shall set out the nature of the applicants interest and the terms and conditions of the licence to which the applicant is willing to accept.

(2) For the purpose of sub-section (6) of section 84, as modified by section 24C, the Controller may call for statements and evidences from the applicant.

(3) On receiving an order from the Controller, the applicant shall furnish the statement and evidences within a period of three months from the date of the order of the Controller.

**48. When A Prima Facie Case Is Not Made Out :-**

(1) If upon consideration of the evidence, the Controller is satisfied that a prima facie case has not been made out for making an order under any of the sections referred to in rule 47, he shall notify the applicant accordingly. Unless the applicant makes a request to be heard in the matter, the Controller shall refuse the application after the expiry of a period of one month from the date of issue of the notice.

(2) If the applicant makes a request of hearing within the time allowed under sub-rule (1), the Controller shall, after giving the applicant an opportunity of being heard, determine whether the application may be proceeded with or it shall be refused.

#### **49. Notice Of Opposition Against Grant Of Compulsory Licence Or Revocation Of Exclusive Marketing Rights :-**

(1) A notice of opposition under sub-section (2) of section 87, as modified by section 24C shall be given in Form 14 and shall be submitted to the Controller within three months from the date of the advertisement of the application under sub-section (1) of the said section.

(2) The notice of opposition referred to in sub-rule (1) shall include the terms and conditions of the licence, if any, which the opponent is prepared to grant to the applicant and shall be accompanied by evidence in support of opposition.

(3) The Controller may by order call for further evidence from the opponent if he so desires.

(4) On receipt of the order under sub-rule (3), the opponent shall furnish the further evidence within a period of three months from the date of such receipt.

(5) The opponent shall serve a copy of his notice of opposition and evidence on the applicant and notify the Controller when such service has been effected.

(6) No further statement or evidence shall be delivered by either party except with the leave of or on requisition by the Controller.

(7) the Controller shall thereafter appoint a date and time for the hearing of the case and shall give the parties not less than ten days notice of such hearing.

(8) The procedure specified in sub-rules (2) to (5) of rule 62, shall, so far as may be, apply to the procedure for hearing under this rule, as they apply to the hearing of opposition to the grant of patents.

(9) The provision of clause (f) of sub-section (1) of section 77 for review of the decision of the Controller shall be applicable to any decision of the grant or refusal to grant of compulsory licence by the Controller.

(10) When the opponent makes the application for review of the decision of the Controller, the Controller shall suspend the operation of the decision for which the review is being requested till the disposal of the application for review.

#### **50. Manner Of Advertisement Of The Order For Revocation Of Exclusive Marketing Rights :-**

The Controller shall advertise, in the Official Gazette, the order

made by him under sub-section (3) of section 85 as modified by section 24C, for revoking exclusive marketing rights to sell or distribute the article or substance.

### **51. Application For The Revision Of The Terms And Conditions Of A Licence :-**

(1) An application under sub-section (4) of section 88 as modified by section 24C for the revision of the terms and conditions of a licence which has been settled by the Controller shall be in Form 21 as may be modified as deemed necessary and shall state the facts relied upon by the applicant and the relief he seeks and shall be accompanied by evidence in support of the application.

(2) If the Controller is satisfied that a prima facie case has not been made out for the revision of the terms and conditions of the licence, he may notify the applicant accordingly and unless within a period of one month the applicant requests to be heard in the matter, the Controller may refuse the application.

(3) The Controller, after giving the applicant an opportunity of being heard, shall determine whether the application shall be proceeded with or shall be refused.

### **52. Procedure To Be Followed In Case Of Application Under Rule 51 :-**

(1) If the Controller allows the application to be proceeded with, he shall direct the applicant to serve copies of the application and of the evidence in support thereof upon the holder of exclusive marketing rights or upon any other person on whom, in his opinion, such copies should be served.

(2) The applicant shall inform the Controller the date on which the service of copies of application and of the evidence on the holder of exclusive marketing right and other persons referred to in sub-rule (1) has effected.

(3) The holder of the exclusive marketing right or any other person on whom copies of the application and of the evidence have been served may give the Controller a notice of opposition in Form 14 as may be modified as deemed necessary, within two months from the date of such service. Such notice shall contain the grounds relied upon by the opponent and shall be accompanied by evidence in support of the opposition.

(4) The opponent shall serve copies of the notice of opposition and his evidence on the applicant and inform the Controller the date on

which service has been made.

(5) No further evidence or statement shall be filed by either party except with special leave or requisition by the Controller.

(6) On completion of the proceedings specified under sub-rules (1) to (5) or at such other time as he may deem fit, the Controller shall forthwith fix a date and the time for the hearing of the case and shall give the parties not less than ten days notice of such hearing.

(7) The procedure specified in sub-rules (2) to (5) of rule 62 shall, so far as may be, apply to the procedure for hearings under this rule as they apply to the hearing of opposition to the grant of a patent.

(8) If the Controller decides to revise the terms and conditions of licence he shall amend the licence granted to the applicant in such manner as he may deem necessary.

### **53. References To Public Interest :-**

Reference to public interest in sub-section (1) of section 24D shall mean the requirement of the public in a national emergency or other circumstances of extreme urgency.

### **54. Register Of Exclusive Marketing Rights :-**

(1) There shall be kept a register to be called the Register of Exclusive Marketing Rights and all entries relating to exclusive marketing rights shall be made therein.

(2) The register kept under sub-rule (1) shall be open to the public on a request to be made to that effect to the Controller in writing along with the fee as specified in the First Schedule.

(3) Certified copy of any entry in the Register of exclusive marketing rights shall be supplied on a request to the Controller in writing along with the fee as specified in the First Schedule.

## **CHAPTER 6 OPPOSITION TO GRANT OF PATENTS**

### **55. Filing Of Notice Of Opposition :-**

The notice of opposition to be given under sub-section (1) of section 25 shall be made in Form 7 and sent to the Controller in duplicate.

### **56. Application For Extension Of Time Under Section 25(1)**

:-

(1) An application for extension of time for giving notice of opposition to the grant of patent under sub-section (1) of section 25 shall be made in Form 4 in duplicate and left at the appropriate office within four months from the date of advertisement of the acceptance of the complete specification stating the reasons for the grant of extension of time.

(2) One copy of the application for extension of time shall be sent by the Controller to the applicant for patent.

### **57. Filing Of Written Statement Of Opposition And Evidence**

:-

The opponent shall send a written statement in duplicate setting out the nature of the opponents interest, the facts upon which he bases his case and relief which he seeks and evidence, if any, along with notice of opposition or within two months from the date of the notice of opposition and shall deliver to the applicant a copy of the statement and the evidence.

### **58. Filing Of Reply Statement And Evidence :-**

(1) If the applicant desires to contest the opposition, he shall leave at the appropriate office a reply statement setting out fully the grounds upon which the opposition is contested and evidence if any, in support of his case within a period of two months from the date of receipt of the copy of the written statement and opponents evidence, if any by him under rule 57 and deliver to the opponent a copy thereof.

(2) If the applicant does not desire to contest or leave his reply and evidence within the period as specified in sub-rule (1), the application for patent shall be deemed to have been abandoned.

### **59. Filing Of Reply Evidence By Opponent :-**

The opponent may, within one month from the date of delivery to him of a copy of the applicants reply statement and evidence under rule 58, leave at the appropriate office evidence in reply strictly confined to matters in the applicants evidence and shall deliver to the applicant a copy of such evidence.

### **60. Further Evidence To Be Left With The Leave Of The Controller :-**

No further evidence shall be delivered by either party except with

the leave or directions of the Controller:

PROVIDED that such leave or direction is prayed before the Controller has fixed the hearing under rule 62.

**61. Copies Of Documents To Be Supplied :-**

(1) Copies of all documents referred to in the notice of opposition or in any statement or evidence filed in connection with the opposition and authenticated to the satisfaction of the Controller, shall be simultaneously furnished in duplicate unless the Controller otherwise directs.

(2) Where a specification or other document in a language other than English is referred to in the notice, statement or evidence, an attested translation thereof, in duplicate, in English shall be furnished along with such notice, statement or evidence, as the case may be.

**62. Hearing :-**

(1) On the completion of the presentation of evidence, if any, or at such other time as the Controller may think fit, he shall forthwith fix a date and time for the hearing of the opposition and shall give the parties not less than ten days notice of such hearing.

(2) If either party to the proceeding desires to be heard, he shall inform the Controller by a notice along with the fee as specified in the First Schedule.

(3) The Controller may refuse to hear any party who has not given notice under sub-rule (2).

(4) If either party intends to rely on any publication at the hearing not already mentioned in the notice, statement or evidence, he shall give to the other party and to the Controller not less than five days notice of his intention, together with details of such publication.

(5) After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing, the Controller shall forthwith decide the opposition and notify his decision to the parties giving reasons therefor.

**63. Determination Of Costs :-**

If the applicant notifies the Controller that he does not desire to proceed with the application after notice of opposition is given, the Controller, depending on the merits of the case, may decide

whether costs should be awarded to the opponent.

**64. Time Within Which Complete Specification Is To Be Amended Under Section 27 :-**

The time within which an applicant shall amend his complete specification to the satisfaction of the Controller under section 27 shall be two months from the date of such intimation by the Controller.

**65. Procedure To Be Followed :-**

(1) If the specification has not been amended to the satisfaction of the Controller within the time allowed under rule 64, he shall forthwith fix a date and time for hearing and the applicant shall be given at least ten days notice of such date of hearing.

(2) After hearing the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the Controller may prescribe or permit such amendment of the specification as determined and may refuse to grant a patent unless the amendment is made within ten days from the date of the order.

**66. Form Of Making A Request Under Section 28(2) :-**

A request under sub-section (2) of section 28 shall be made in Form 8.

**67. Form Of Making A Claim Under Section 28(3) :-**

(1) A claim under sub-section (3) of section 28 shall be made in Form 8, and shall be accompanied by a statement setting out the circumstances under which the claim is made.

(2) A copy of the claim and the statement shall be sent by the Controller to every applicant for the patent (not being the claimant) and to any other person whom the Controller may consider to be interested.

**68. Form Of Application To Be Made Under Section 28(7) :-**

(1) An application under sub-section (7) of section 28 shall be made in Form 8 and shall be accompanied by a statement setting out the circumstances under which the application is made.

(2) A copy of the application and the statement shall be sent by

the Controller to each patentee or the applicant for patent, as the case may be, and to any other person whom the Controller may consider to be interested.

### **69. Procedure For The Hearing Of Claim Or An Application Under Section 28 :-**

The procedure specified in rules 55 and 57 to 63 relating to the filing of notice of opposition, written statement, reply statement, leaving evidence, hearing and cost shall, so far as may be, apply to the hearing of a claim or an application under section 28 as they apply to the proceedings in opposition to the grant of patents subject to the modification that reference to applicant shall be construed as the person making the claim or an application as the case may be.

### **70. Mention Of Inventor :-**

Any mention of the inventor under sub-section (1) of section 28 shall be made in the relevant documents in the following form, namely:-

"The inventor of this invention/substantial part of this invention within the meaning of section 28 of the Patents Act, 1970, is ..... of ....."

## **CHAPTER 7 SECRECY DIRECTIONS**

### **71. Permission For Making Patent Application Outside India Under Section 39 :-**

Request for permission for making patent application outside India shall be made on Form 30.

### **72. Communication Of Result Of Reconsideration Under Section 36(2) :-**

(1) The result of every reconsideration under sub-section (1) of section 36 shall be communicated to the applicant for patent within fifteen days of the receipt of the notice by the Controller.

(2) Extension of time on revocation of secrecy directions under section 38-The extension of time to be given for doing anything required or authorised to be done under section 38 shall not exceed the period of which directions given by the Central Government under sub-section (1) of section 35 were in force.

## **CHAPTER 8 SEALING OF PATENTS**

### **73. Sealing Of Patents :-**

(1) A request for the sealing of a patent under sub-section (1) of section 43 shall be made in Form 9.

(2) The period within which a request for the sealing of a patent may be made under clause (a) of the proviso to sub-section (2) of section 43 shall be two months after the final determination to the proceeding referred to in that clause.

(3) An application under sub-section (3) of section 43 shall be made in Form 4.

(4) On receipt of a request for sealing of patent under sub-rule (1) or sub-rule (2), as the case may be, the patent shall be sealed even if the term of patent has expired.

### **74. Form Of Patent :-**

A patent shall be in the form as specified in the Third Schedule with such modifications as the circumstances of each case may require and shall bear the number accorded to the application under rule 37.

### **75. Amendment Of Patent Under Section 44 :-**

An application under section 44 for the amendment of a patent shall be made in Form 10 along with substantiating evidence and be accompanied by the patent.

### **76. Manner Of Applying For Direction Under Section 51(1) :-**

(1) An application for directions under sub-section (1) of section 51 shall be made in Form 11 and shall be accompanied by a statement setting out the facts upon which the applicant relies.

(2) A copy of the application and of the statement shall be sent by the Controller to every other person registered as grantee or proprietor of the patent.

### **77. Manner Of Application Under Section 51(2) :-**

(1) An application for directions under sub-section (2) of section 51 shall be made in Form 11 and shall be accompanied by a statement setting out the facts upon which the applicant relies.

(2) A copy of the application and statement shall be sent by the Controller to the person in default.

**78. Procedure For The Hearing Of Proceedings Under Section 51 :-**

The procedure specified in rules 55 and 57 to 63 relating to the filing of notice of opposition, written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of an application under section 51 as they apply to the hearing of an opposition to the grant of patents.

**79. Request Under Section 52(2) :-**

(1) A request under sub-section (2) of section 52 shall be made in Form 12 within three months from the date of the order of the court referred to in sub-section (1) of the said section and shall be accompanied by a statement setting out the facts upon which the petitioner relies and the relief he claims and a certified copy of the order of the court.

(2) Where the court has ordered the grant of patent to the applicant only for a part of the invention, the new patent granted shall be accorded a number in the same series of numbers accorded to the complete specifications accepted on the same day as the patent is granted.

**80. Renewal Fees Under Section 53 :-**

(1) To keep a patent in force, the renewal fees specified in the First Schedule shall be payable at the expiration of the second year from the date of the patent or of any succeeding year and the same shall be remitted to the patent office before the expiration of the second or the succeeding year.

(2) While paying the renewal fee, the number and date of the patent concerned and the year in respect of which the fee is paid shall be quoted.

(3) The annual renewal fees payable in respect of two or more years may be paid in advance.

(4) The Controller shall, after making such enquiry as he may deem necessary, credit any renewal fee and issue a certificate that the fee has been paid.

**CHAPTER 9 AMENDMENT OF APPLICATION, SPECIFICATION OR ANY DOCUMENT RELATING THERETO**

### **81. Amendment Of Application, Specification Or Any Document Relating :-**

thereto

(1) An application under section 57 for the amendment of an application for a patent or a complete specification or any document related thereto shall be made in Form 13.

(2) If the application for amendment under sub-rule (1) relates to an application for a patent which has not been accepted, the Controller shall determine whether and subject to what conditions, if any, the amendment shall be allowed.

(3) (a) If the application for amendment under sub-rule (1) is made after the acceptance of the complete specification and the nature of the proposed amendment is substantive, the application shall be advertised in the Official Gazette.

(b) Any person interested in opposing the application for amendment shall give a notice of opposition in Form 14 within three months from the date of advertisement of the application in the Official Gazette.

(c) The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 57 as they apply to the hearing of the opposition to the grant of patents.

### **82. Preparation Of Amended Specifications, Etc. :-**

Where the Controller allows the application for a patent or the complete specification or any other document to be amended, the applicant shall, if the Controller so requires and within the time to be specified by him, leave at the appropriate office an amended application or the specification or the other document, as the case may be, in accordance with the provisions of these rules.

### **83. Advertisement Of The Amendment Allowed :-**

The amendments allowed after a complete specification has been accepted, shall be advertised in the Official Gazette.

## **CHAPTER 10 RESTORATION OF PATENTS**

### **84. Restoration Of Patents :-**

(1) An application for the restoration of a patent under section 60 shall be made in Form 15.

(2) Where the Controller is satisfied that a prima facie case for the restoration of any patent has not been made out, he shall intimate the applicant accordingly and unless the applicant makes a request to be heard in the matter within one month from the date of such intimation the Controller shall refuse the application.

(3) Where applicant requests for a hearing within the time allowed and the Controller, after giving the applicant such a hearing, is prima facie satisfied that the failure to pay the renewal fees was unintentional he shall advertise the application in the Official Gazette.

### **85. Opposition To Restoration Under Section 61 :-**

(1) At any time within two months from the date of advertisement of the application in the Official Gazette under sub-rule (3) of rule 84, any person interested may give notice of opposition thereto in Form 14.

(2) A copy of the notice of opposition shall be sent by the Controller to the applicant.

(3) The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 60 as they apply to the hearing of the opposition to the grant of patents.

### **86. Payment Of Unpaid Renewal Fees :-**

(1) Where the Controller decides in favour of the applicant, the applicant shall pay the unpaid renewal fees and the additional fee specified in the First Schedule, within a month from the date of the order of the Controller allowing the application for restoration.

(2) The Controller shall advertise his decision in the Official Gazette.

## **CHAPTER 11 SURRENDER OF PATENTS**

### **87. Surrender Of Patents :-**

(1) The Controller shall advertise the notice of an offer given under section 63 in the Official Gazette.

(2) Any person interested may within three months from the date of advertisement of the notice in the Official Gazette give notice of opposition to the Controller in Form 14 in duplicate.

(3) The procedure specified in rules 57 to 63 relating to the filing of

written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 63 as they apply to the hearing of the opposition to the grant of patents.

(4) If the Controller accepts the patentees offer to surrender the patent, he may direct the patentee to return the patent and on receipt of such patent, the Controller shall by order revoke it and notify the revocation of the patent in the Official Gazette.

## **CHAPTER 12 REGISTER OF PATENTS**

### **88. Register Of Patents Under Section 67 :-**

(1) Upon the sealing of a patent, the Controller shall enter in the register of patents at each appropriate office, the name, address and nationality of the grantee as the patentee thereof, the title of the invention (including the categories to which the invention relates), the date of the patent and the date of sealing thereof together with the address for service of the patentee.

(2) The Controller shall also enter in the register of patents particulars regarding proceedings under the Act before the Controller or the courts in respect of every patent.

(3) Where the register of patents or any part thereof is in computer floppies, diskettes or any other electronic form it shall be maintained and accessed only by the person who is duly authorised by the Controller and no entry or alteration of any entry or rectification of any entry in the said register shall be made by any person who is not so authorised by the Controller.

### **89. Registration Of Documents Under Section 68 :-**

An application for the registration of a document under section 68 shall be made in Form 16.

### **90. Registration Of Title And Interest In Patents :-**

(1) An application referred to in sub-section (1) or sub-section (2) of section 69 shall be made in Form 17.

(2) An application for an entry in the register of patents of any other document purporting to affect the proprietorship of the patent by the person benefiting under the document shall be made in Form 17.

### **91. Presentation Of Assignment, Etc. Of Patent To**

## **Controller :-**

Every assignment and every other document giving effect to or being evidence of the transfer of a patent or affecting the proprietorship thereof or creating an interest therein as claimed in such application, shall, unless the Controller otherwise directs, be presented to him together with the application which shall be accompanied by two copies of the assignment or other document certified to be true copies by the applicant or his agent and the Controller may call for such other proof of title or written consent as he may require.

## **92. Registration Of Title Or Interest In A Patent :-**

After the receipt of an application under sub-section (1) or sub-section (2) of section 69, the Controller shall register the title of the person concerned or his interest in a patent, as the case may be, and an entry in the following form shall be made in the register, namely:-

"In pursuance of an application received on the  
Proprietor Assignment  
registered as licensee by virtue of licence  
Mortgagee etc. Mortgage deed etc.  
dated and made between  
of the one part and of the  
other part".

## **93. Entry Of Renewal Fee :-**

Upon receipt of the payment of the prescribed renewal fee in respect of a patent, the Controller shall enter in the register of patents the fact that the fee has been paid and the date of payment of such fee and issue a certificate of the payment.

## **94. Alteration Of Address :-**

(1) A patentee may make a request in writing along with fee payable to the Controller for the alteration of his name, nationality, address or address for service as entered in the register of patents in respect of any patent granted to him. The Controller may require such proof of the alteration as he may think fit before acting on a request to alter the name or nationality.

(2) If the Controller allows a request made under sub-rule (1), he

shall cause the entries in the register to be altered accordingly.

(3) If a patentee makes a request in writing along with fee payable for entering an additional address for service in India and if the Controller is satisfied that the request should be allowed, he shall have the additional address for service entered in the register.

### **95. Inspection Of Register Of Patents Under Section 72 And Fees Payable Therefor :-**

(1) The register of patents shall be open for public inspection during office hours on payment of the fees specified therefor in the First Schedule.

(2) When register of patents or any part thereof is in computer floppies, diskettes or any other electronic form the person authorised by the Controller under sub-rule (3) of rule 88 shall provide access to the computer floppies, diskettes or other electronic form or printouts of the records thereof.

## **CHAPTER 13 COMPULSORY LICENCE AND REVOCATION OF PATENT**

### **96. Application For Compulsory Licence Etc :-**

An application to the Controller for an order under section 84, section 85, section 91 or section 92 shall be in Form 18, or in Form 20, as the case may be. Except in the case of an application made by the Central Government, the application shall set out the nature of the applicants interest and terms and conditions of the licence the applicant is willing to accept.

### **97. When A Prima Facie Case Is Not Made Out :-**

(1) If, upon consideration of the evidence, the Controller is satisfied that a prima facie case has not been made out for the making of an order under any of the sections referred to in rule 96, he shall notify the applicant accordingly, and unless the applicant requests to be heard in the matter, within one month from the date of such notification, the Controller shall refuse the application.

(2) If the applicant requests for a hearing within the time allowed under sub-rule (1), the Controller shall, after giving the applicant an opportunity of being heard, determine whether the application may be proceeded with or whether it shall be refused.

### **98. Notice Of Opposition Under Section 87(2) :-**

(1) A notice of opposition under sub-section (2) of section 87 shall be given in Form 14 and shall be sent to the Controller within two months from the date of the advertisement of the application under sub-section (1) of the said section.

(2) The notice of opposition referred to in sub-rule (1) shall include the terms and conditions of the licence, if any, the opponent is prepared to grant to the applicant and shall be accompanied by evidence in support of the opposition.

(3) The opponent shall serve a copy of his notice of opposition and evidence on the applicant and notify the Controller when such service has been effected.

(4) No further statement or evidence shall be delivered by either party except with the leave of or on requisition by the Controller.

(5) The Controller shall forthwith fix a date and time for the hearing of the case and shall give the parties not less than ten days notice of such hearing.

(6) The procedure specified in sub-rules (2) to (5) of rule 62, shall, so far as may be, apply to the procedure for hearing under this rule as they apply to the hearing of opposition to the grant of patents.

#### **99. Manner Of Advertisement Of The Revocation Order :-**

The Controller shall advertise in the Official Gazette the order made by him under sub-section (3) of section 85 revoking a patent.

#### **100. Application Under Section 88(4) :-**

(1) An application under sub-section (4) of section 88 for the revision of the terms and conditions of a licence which have been settled by the Controller shall be in Form 21 and shall state the facts relied upon by the applicant and the relief he seeks and shall be accompanied by evidence in support of the application.

(2) If the Controller is satisfied that a prima facie case has not been made out for the revision of the terms and conditions of the licence, he may notify the applicant accordingly and unless within a month the applicant requests to be heard in the matter, the Controller may refuse the application.

(3) The Controller, after giving the applicant an opportunity of being heard, shall determine whether the application shall be proceeded with or whether the application shall be refused.

#### **101. Procedure To Be Followed In Case Of Applications**

### **Under Section 88(4) :-**

(1) If the Controller allows the application to be proceeded with, he shall direct the applicant to serve copies of the application and of the evidence in support thereof upon the patentee or any other person appearing in the register to be interested in the patent or upon any other person on whom, in his opinion such copies should be so served.

(2) The applicant shall inform the Controller the date on which the service of copies of application and of the evidence on the patentee and other persons referred to in sub-rule (1) has been effected.

(3) The patentee or any other person on whom copies of the application and of the evidence have been served, may give to the Controller notice of opposition in Form 14 within one month from the date of such service. Such notice shall contain the grounds relied upon by the opponent and shall be accompanied by evidence in support of the opposition.

(4) The opponent shall serve copies of the notice of opposition and his evidence on the applicant and inform the Controller the date on which such service has been effected.

(5) No further evidence or statement shall be filed by either party except with special leave of or on requisition by the Controller.

(6) On completion of the above proceedings, the Controller shall forthwith fix a date and the time for the hearing of the case and shall give the parties not less than ten days notice of such hearing.

(7) The procedure specified in sub-rules (2) to (5) of rule 62 shall, so far as may be, apply to the procedure for hearing under this rule as they apply to the hearing of opposition to the grant of a patent.

(8) If the controller decides to revise the terms and conditions of licence he shall forthwith amend the licence granted to the applicant in such manner, as he may deem necessary.

### **102. Application For Termination Of Compulsory Licence Under Section 94 :-**

(1) An application for termination of compulsory licence under section 94(1) shall be made in Form 22 by the patentee or any other person deriving title or interest in the patent. The application shall be accompanied by the evidence in support of the application.

(2) The applicant shall serve a copy of the application and evidence on the holder of the compulsory licence and shall inform the Controller the date on which the service has been effected.

(3) The holder of the compulsory licence may file his objection along with evidence, if any, to the application within one month from the date of receipt of the application and evidence by him to the Controller and serve a copy thereof to the applicant.

(4) No further evidence or statement shall be filed by either party except with special leave of or on requisition by the Controller.

(5) On completion of the above proceedings, the Controller shall forthwith fix a date and the time for the hearing of the case and shall give the parties not less than ten days notice of such hearing.

(6) The procedure specified in sub-rules (2) to (5) of rule 62 so far as may be, apply to the procedure for hearing under this rule as they apply to the hearing of opposition to the grant of a patent.

(7) If the Controller decides to terminate the compulsory licence he shall forthwith issue an order giving terms and conditions, if any, of such termination and serve copies of the order to both the parties.

## **CHAPTER 14 SCIENTIFIC ADVISERS**

### **103. Roll Of Scientific Advisers :-**

(1) The Controller shall maintain a roll of scientific advisers for the purpose of section 115. The roll shall be updated annually. The roll shall contain the names and addresses of scientific advisers, their designations, information regarding their educational qualifications, the disciplines of their specialisation and their technical, practical and research experience.

(2) A person shall be qualified to have his name entered in the roll of scientific advisers, if he-

(i) holds a degree in science, engineering, technology or equivalent;

(ii) has at least fifteen years practical or research experience; and

(iii) he holds or has held a responsible post in a scientific or technical department of the Central or State Government or in any organisation.

### **104. Manner Of Application For Inclusion In The Roll Of Scientific Advisers :-**

Any interested person may apply to the Controller for inclusion of his name in the roll of scientific advisers furnishing his bio-data.

### **105. Inclusion Of The Name Of Any Other Person In The Roll Of Scientific Advisers :-**

The Controller may, notwithstanding anything contained in rules 103 and 104, enter the name of any person in the roll of scientific advisers, if he is of the opinion after such inquiry as he deems fit, that such person should be entered in the roll of scientific advisers.

**106. Power To Relax :-**

Where the Controller is of the opinion that it is necessary or expedient so to do, he may, by order, for reasons to be recorded in writing, relax any of the qualifications specified in sub-rule (2) of rule 103 with respect to any person, if such person is otherwise well qualified.

**107. Removal Of Names From The Roll Of Scientific Advisers :-**

The Controller may remove the name of any person from the roll of scientific advisers, if-

- (a) such person makes a request for such removal; or
- (b) the Controller is satisfied that his name has been entered in the roll by error or on account of misrepresentation or suppression of any material fact; or
- (c) such person has been convicted of an offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity and the Controller is of the opinion that his name should be removed from the roll:

PROVIDED that, before removing the name of any person from the roll of scientific advisers under this rule, such person shall be given a reasonable opportunity of being heard.

**CHAPTER 15 PATENT AGENTS**

**108. Particulars To Be Contained In The Register Of Patent Agents :-**

(1) The register of patent agents maintained under section 125 shall contain the name, nationality, address of the principal place of business, addresses of branch offices, if any, the qualifications and the date of registration of every registered patent agent.

(2) Where the register of patent agents is in computer floppies, diskettes or any other electronic form, it shall be maintained and accessed only by the person who is duly authorised by the Controller and no entry or alteration of any entry or rectification of any entry in the said register shall be made by any person who is

not so authorised by the Controller.

### **109. Application For Registration Of Patent Agents :-**

(1) Every person who desires to be registered as a patent agent shall make an application in Form 23.

(2) The applicant shall furnish such other information as may be required by the Controller.

(3) A person desirous to appear in the qualifying examination under rule 110 shall make a request to the Controller along with the fee as specified in the First Schedule.

### **110. Particulars Of The Qualifying Examination For Patent Agents :-**

(1) The qualifying examination referred to in clause (c)(ii) of sub-section (1) of section 126 shall consist of a written test and a viva voce examination.

(2) The qualifying examination shall consist of the following papers and marks, namely :

Paper I - Patents Act and Rules 100

Paper II - Drafting and interpretation of patent specifications and other documents 100

Viva Voce 100

(3) The qualifying marks for each written paper and for the viva voce examination shall be fifty per cent each, and a candidate shall be declared to have passed the examination only if he obtains an aggregate of sixty per cent of the qualifying marks.

### **111. Registration Of Patent Agents :-**

After a candidate passes the qualifying examination specified in rule 110 and after obtaining any further information which the Controller considers necessary he shall, on receipt of the fee specified therefor in the First Schedule, enter the candidates name in the register of patent agents and issue to him a certificate of registration as a patent agent.

### **112. Details To Be Included In An Application For The Registration Of A Patent Agent :-**

An application by a person entitled to be registered as a patent agent under sub-section (2) of section 126 shall also be made in Form 23.

### **113. Registration Of Patent Agents Under Section 126(2) :-**

On receipt of an application for the registration of a person as a patent agent under rule 112, the Controller may if he is satisfied that the said person fulfils the conditions specified in sub-section (2) of section 126 enter his name in the register of patent agents.

### **114. Disqualifications For Registration As A Patent Agent :-**

A person shall not be eligible to be registered as a patent agent, if he-

- (i) has been adjudged by a competent court to be of unsound mind;
- (ii) is an undischarged insolvent;
- (iii) being a discharged insolvent, has not obtained from the court a certificate to the effect that his insolvency was caused by misfortune without any misconduct on his part;
- (iv) has been convicted by a competent court, whether within or outside India of an offence to undergo a term of imprisonment, unless the offence of which he has been convicted has been pardoned or unless on an application made by him, the Central Government has, by order in this behalf, removed the disability;
- (v) being a legal practitioner has been guilty of professional misconduct; or
- (vi) being a chartered accountant, has been guilty of negligence or misconduct.

### **115. Payment Of Fees :-**

The continuance of a persons name in the register of patent agents shall be subject to the payment of the fees specified therefor in the First Schedule.

### **116. Removal Of A Name From The Register Of Patent Agents :-**

- (1) The Controller may delete from the register of patent agents, the name of any patent agent-
  - (a) from whom a request has been received to that effect; or
  - (b) when he is dead; or
  - (c) when the Controller has removed the name of a person under sub-section (1) of section 130; or
  - (d) if he has defaulted in the payment of fees specified in rule 115,

by more than three months after they are due.

(2) The removal of the name of any person from the register of patent agents shall be notified in the Official Gazette and shall be, where relevant forthwith communicated to the person concerned.

### **117. Restoration Of Name Of Persons Removed From The Register Of Patent Agents :-**

(1) An application for the restoration of the name of any person removed from the register of patent agents under sub-section (2) of section 130 shall be made in Form 24 within two months from the date of such removal.

(2) If the name of a person is restored to the register of patent agents, his name shall be continued therein for a period of one year from the date on which his last annual fee became due.

(3) The restoration of name to the register of patent agents shall be notified by the Controller in the Official Gazette and communicated to the person concerned.

### **118. Alteration Of Names Etc. In The Register Of Patent Agents :-**

(1) A patent agent may apply for the alteration of his name, address of the principal place of business and branch offices, if any, or the qualifications entered in the register of patent agents. On receipt of such application and the fee specified therefor in the First Schedule, the Controller shall cause the necessary alterations to be made in the register of patents agents.

(2) Every alteration made in the register of patent agents shall be notified in the Official Gazette.

### **119. Refusal To Recognise As Patent Agent :-**

If the Controller is of the opinion that any person should not be recognised as a patent agent in respect of any business under the Act as provided in sub-section (1) of section 131 thereof, he shall communicate his reasons to that person and direct him to show-cause why he should not refuse to recognise him as such agent, within such time as he may allow, and after considering the reply, if any, of that person and giving him an opportunity of being heard, the Controller may pass such orders as he may deem fit.

### **120. Publication Of The Names Of Patent Agents, Registered Under The Act :-**

The names and addresses of persons registered as patent agents shall from time to time be published in the Official Gazette and in such other manner as the Controller may deem fit.

## **CHAPTER 16 MISCELLANEOUS**

### **121. Address For Communications :-**

All communications in relation to any proceeding under the Act or these rules shall be addressed to the Controller at the appropriate office.

### **122. Correction Of Clerical Errors :-**

A request for the correction of a clerical error in any document referred to in section 78 shall be accompanied by a copy of the document highlighting the corrections clearly along with the fees payable therefor as specified in the First Schedule.

### **123. Manner Of Advertisement Of The Proposed Correction Of Any Error :-**

Where the Controller requires a notice of the nature of the proposed correction to be advertised, the request and the nature of the proposed correction shall be published in the Official Gazette and the person making the request shall also serve copies of the request and the copies of the document showing the proposed corrections to such persons who, in the opinion of the Controller, may be interested.

### **124. Manner And Time Of Opposition To The Making Of Corrections :-**

(1) Any person interested may, at any time, within three months from the date of the advertisement of the request for correction in the Official Gazette give notice of opposition to the Controller in Form 14 in duplicate.

(2) Such notice of opposition shall be accompanied by a statement in duplicate setting out the nature of the opponents interest, the facts on which he relies and the relief which he seeks.

(3) A copy of the notice and of the statement shall be sent by the Controller to the person making the request.

(4) The procedure specified in rules 58 to 63 relating to the filing of

reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 78 as they apply to the hearing of the opposition to the grant of patents.

### **125. Notification Of Corrections :-**

The Controller shall notify the person making a request for the correction and the opponent, if any, of the corrections made in the relevant document.

### **126. Form, Etc. Of Affidavits :-**

(1) The affidavits required by the Act or these rules to be filed at the patent office or furnished to the Controller shall be duly sworn to in the manner as prescribed in sub-rule (3).

(2) Affidavits shall be confined to such facts as the deponent is able, of his own knowledge, to prove except in interlocutory matters, where statements of belief of the deponent may be admitted, provided that the grounds thereof are given.

(3) Affidavits shall be sworn to as follows :-

(a) in India - before any court or person having by law authority to receive evidence, or before any officer empowered by such court as aforesaid to administer oaths or to take affidavits;

(b) in any country or place outside India - before a diplomatic or consular officer, within the meaning of the Diplomatic and Consular Officers (Oaths and Fees) Act, 1948 (41 of 1948) in such country or place or before a notary of the country or place, recognised by the Central Government under section 14 of the Notaries Act, 1952 (53 of 1952), or before a Judge or Magistrate of the country or place.

(4) Alterations and interlineations shall, before an affidavit is sworn to or affirmed be authenticated by the initials of the person before whom the affidavit is sworn to.

### **127. Exhibits :-**

Where there are exhibits to be filed in an opposition or any other proceedings, a copy or impression of each exhibit shall be supplied to the other party at his request and expense; if copies or impressions of the exhibits cannot conveniently be furnished, the originals shall be left with the Controller for inspection by the person interested by prior appointment. The exhibits in original if not already left with Controller shall be produced at the hearing.

### **128. Directions Not Otherwise Prescribed :-**

(1) Where for the proper prosecution or completion of any proceedings under the Act or these rules, the Controller is of the opinion that it is necessary for a party to such proceedings to perform an act, file a document or produce evidence, for which provision has not been made in the Act or these rules, he may, by notice in writing, require such party to perform the act, file the document or produce the evidence specified in such notice.

(2) Where an applicant or a party to a proceeding desires to be heard or not heard, the Controller may, at any time, require him to submit his statement in writing giving such information as the Controller may deem necessary within the time specified by him.

### **129. Exercise Of Discretionary Power By The Controller :-**

Before exercising any discretionary power under the Act or these rules adversely to an applicant for a patent or a party to a proceeding the Controller shall give such applicant or party, a hearing, after giving him at least ten days notice of such hearing.

### **130. Application For Review Of Decisions Or Setting Aside Of Orders Of The Controller :-**

(1) An application to the Controller for the review of his decision under clause (f) of sub-section (1) of section 77 shall be made in Form 25 within one month from the date of communication of such decision to the applicant or within such further period not exceeding one month thereafter as the Controller may on a request made in Form 4 allow and shall be accompanied by a statement setting forth the grounds on which the review is sought. Where the decision in question concerns any other person in addition to the applicant, the Controller shall forthwith transmit a copy of each of the application and the statement to the other person concerned.

(2) An application to the Controller for setting aside an order passed by him ex parte under clause (g) of sub-section (1) of section 77 shall be made in Form 25 within one month from the date of communication of such order to the applicant or within such further period not exceeding one month as the Controller may on a request made in Form 4 allow and shall be accompanied by a statement setting forth the grounds on which the application is based. Where the order concerns any other person in addition to the applicant, the Controller shall, forthwith transmit a copy each of the application and the statement to the other person concerned.

**131. Form And Manner In Which Statements Required Under Section 146(2) To Be Furnished :-**

(1) The statement shall be furnished by every patentee and every licensee under sub-section (2) of section 146 in Form 29 which shall be duly verified by the patentee or the licensee or his authorised agent.

(2) The statements referred to in sub-rule (1) shall be furnished in respect of every calendar year within three months of the end of each year.

(3) The Controller may publish the information received by him under sub-section (1) or sub-section (2) of section 146 in the Official Gazette and in such other manner as he may deem fit.

**132. Form Of Application For The Issue Of A Duplicate Patent :-**

An application for the issue of a duplicate patent under section 154 shall contain a statement setting out the circumstances in which the patent was lost or destroyed or cannot be produced together with the fee as specified therefor in the First Schedule.

**133. Supply Of Certified Copies And Certificates Under Sections 72 And 147 :-**

Certified copies of any entry in the register, or certificates of, or extracts from patents, specifications and other public documents in the patent office, or from registers and other records including records in computer floppies, diskettes or any other electronic form kept there, may be furnished by the Controller on a request therefor made to him and on payment of the fee specified therefor in the First Schedule.

**134. Request For Information Under Section 153 :-**

(1) A request for information in respect of the following matters relating to any patent or application for patent shall be admissible, namely :-

(a) as to when a complete specification following a provisional specification has been filed or an application for patent has been deemed to have been abandoned;

(b) as to when publication of application has been made under section 11A;

- (c) as to when an application has been withdrawn under section 11B;
  - (d) as to when a request for examination has been made under section 11B;
  - (e) as to when the examination report has been issued under section 12;
  - (f) as to when a complete specification has been accepted or when an application for patent has been refused;
  - (g) as to when a patent has been sealed, or when the time for requesting sealing has expired;
  - (h) as to when a renewal fee has been paid;
  - (i) as to when a term of a patent has expired or shall expire;
  - (j) as to when an entry has been made in the register or application has been made for the making of such entry; or
  - (k) as to when any application is made or action taken involving an entry in the register or advertisement in the Official Gazette, if the nature of the application or action is specified in the request.
- (2) Separate request shall be made in respect of each item of information required.
- (3) The fee payable on a request to be made under section 153 shall be as set out in the First Schedule.

**135. Agency :-**

- (1) The authorisation of an agent for the purposes of the Act and these rules shall be in Form 26 or in the form of a power of attorney.
- (2) Where any authorisation has been made under sub-rule (1), service upon the agent of any document relating to any proceeding or matter under the Act or these rules shall be deemed to be service upon the person so authorising him and all communications directed to be made to a person in respect of any proceeding or matter may be addressed to such agent, and all appearances before the Controller relating thereto may be made by or through such agent.
- (3) Notwithstanding anything contained in sub-rules (1) and (2), the Controller may, if it is considered necessary, require the personal signature or presence of an applicant, opponent or party to such proceeding or matter.

**136. Scale Of Costs :-**

- (1) In all proceedings before the Controller, he may, subject to rule

63, award costs as he considers reasonable, having regard to all the circumstances of the case :

PROVIDED that the amount of costs awarded in respect of any matter set forth in the Fourth Schedule shall not exceed the amount specified therein.

( 2 ) Notwithstanding anything contained in sub-rule (1), the Controller may, in his discretion award a compensatory cost in any proceeding before him which in his opinion is false or vexatious.

### **137. Powers Of Controller Generally :-**

Any document for the amendment of which no special provision is made in the Act may be amended and any irregularity in procedure which in the opinion of the Controller may be obviated without detriment to the interests of any person, may be corrected if the Controller thinks fit and upon such terms as he may direct.

### **138. Power To Extend Time Prescribed :-**

(1) The time prescribed by these rules for doing of any act or the taking of any proceeding thereunder may be extended by the Controller normally not more than three months, if he thinks it fit to do so and upon such terms as he may direct:

PROVIDED that only one such extension shall be granted by the Controller in every matter before him.

(2) Any request for extension of time made under these rules shall be made within the extendable period by request unless otherwise provided in these rules.

### **139. Hearing Before The Controller To Be In Public Certain Cases :-**

Where the hearing before the Controller of any dispute between two or more parties relating to an application for a patent or to any matter in connection with a patent takes place after the date of the publication of the complete specification, the hearing of the dispute shall be in public unless the Controller, after consultation with the parties to the dispute who appear in person or are represented at the hearing, otherwise directs.

### **SCHEDULE 1**

SCHEDULE I

(Refer rule 7)

FEES

**SCHEDULE 2**

## SCHEDULE II

(Refer rule 8)

## FORMS

## List of Forms

<b>Form No.</b>	<b>Section and rule</b>	<b>Title</b>
1.	2.	3.
1.	Sections 5(2), 7, 54, 135 and rule 39	Application for grant of a patent
1A.	Section 7(1A); rule 20(1)	Application for grant of patent on an application corresponding to an International application under PCT
2.	Section 10; rule 13	Provisional/Complete Specification
3.	Section 8 and rule 12	Statement and undertaking
4.	Sections 8(2), 9(1), 25(1), 28(4), 43(3), 53(3) and rule 12(4), 13(6), 24(5), 56(1), 73(3) or 130.	Request for extension for time
5.	Section 10(6) and rule 13(6)	Declaration as inventorship
6.	Sections 20(1), 20(4), 20(5) and rule 34(1), 35 or 36	Claim or request regarding any change in applicant for patent
7.	Section 25 and rule 55	Notice of opposition to grant of a patent
8.	Sections 28(2), 28(3) or 28(4) and rules 66, 67, 68	Request or claim regarding mention of inventor as such in a patent
9.	Section 43 and rule 73(1)	Request for sealing of a patent
10.	Section 44 and rule 75	Application for amendment of patent
11.	Section 51(1), 51(2) and rules 76, 77	Application for direction of the controller
12.	Section 52(2) and rule 79	Request for grant of patent
13.	Section 57 and rule 81(1)	Application for amendment of the application for patent/complete specification
14.	Sections 57(4), 61(1), 63(3), 78(5) and 87(2) and rule 49(1), 52(3), 81(3)(b), 85(1), 87(2), 98(1), 101(3) or 124 and also section 87(2) as modified by section 24C	Notice of opposition to amendment/restoration/surrender of patent/grant of compulsory licence or revision of terms thereof or to a correction of clerical errors.
15.	Section 60 and rule 84	Application for restoration of patents
16.	Section 68 and rule 89	Application for registration of a document
17.	Section 69(1) or 69(2) and rules 90(1) and 90(2)	Application for registration of title/interest in a patent or share in it or registration of any document purporting to affect proprietorship of the patent

18.	Section 84(1), 91 or 92(1) and rules 47, 96 and also sections 84 and 92 as modified by section 24C	Application for compulsory licence
19.	Section 11B and rule 24(1)	Request for examination of application for patent
20.	Section 85(1) and rules 47, 96 and also section 85(1) as modified by section 24C	Application for revocation of a patent or exclusive marketing right
21.	Section 88(4) and rules 51, 100 and also section 88(4) as modified by section 24C	Application for revision of terms and conditions of licence
22.	Section 94 and rule 102(1) and also section 94 as modified by section 24C	Request for termination of compulsory licence.
23.	Rules 109 and 112	Application for registration of Patent Agent
24.	Section 130(2) and rule 117	Application for the restoration of the name in the register of Patent Agents
25.	Section 77(1)(f), 77(1)(g) and rule 130(1) or 130(2)	Application for review/setting aside controllers decision/order
26.	Sections 127, 132 and rule 135	Form of authorisation of a Patent Agent/or any person in a matter or proceeding under the Act
27.	Section 24A and rule 40	Application for grant of exclusive marketing rights
28.	Rule 46	Form for the grant of exclusive marketing rights
29.	Section 146(2) and rule 131(1)	Statement regarding the working of the Patented invention
30.	Section 39	Request for permission for making patent application outside India