

## **Patents 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 CO-OPERATION 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. .

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

24. Publication of application
- 24A. Request for publication
- 24B. Examination of application

25. Identification of published applications.
26. Request for withdrawal
27. Inspection and supply of published documents
28. Procedure in case of anticipation by prior publication.
- 28A. Procedure in relation to consideration of report of examiner under Sec. 14
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 the grant of patent
38. Inspection of application, specification, etc.

## **CHAPTER 5 :-**

39. .
40. .
41. .
42. .
43. .
44. .
45. .
46. .
47. .
48. .
49. .
50. .
51. .
52. .
53. .
54. .

## **CHAPTER 6 :- OPPOSITION PROCEEDINGS**

55. Opposition by representation against the grant of patent
- 55A. Filing of notice of opposition
56. Constitution of Opposition Board and its proceeding
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
- 63A. Request made under Sec. 26(1)
64. .

65. .
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 Sec. 28
70. Mention of inventor.

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

71. Permission for making patent application outside India under Sec. 39
71. Permission for making patent application outside India under Section 39
72. Communication of result of reconsideration under Section 36(2).

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

73. .
74. Form of patent.
- 74A. Inspection of documents related to grant 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 Sec. 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 thereto.
82. Preparation of amended specifications, etc.
83. Publication of the amendment allowed

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

84. Restoration of patents.
85. Opposition to restoration under Sec. 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. .
90. Registration of title and interest in patents.
91. Presentation of assignment, etc. of patent to the 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
- 96A. 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 publication 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.
- 111A. issue of duplicate certificate 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. Period within which copies of specification etc. are to be filed
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. K281Exercise 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 in certain cases

**SCHEDULE 1 :- FEES**

**SCHEDULE 2 :- List of Forms**

**SCHEDULE 3 :- Government of India The Parent Office**

**SCHEDULE 4 :- Government of India The Parent Office**

**Patents Rules, 2003**

Whereas certain draft rules were published in exercise of the powers conferred by Section 159 of the Patents Act, 1970 (39 of 1970) vide notification of the Government of India in Ministry of Commerce and Industry (Department of Industrial Policy and Promotion) vide S.O. 1018(E) dated 20th September, 2002, in Part II, Section 3, sub-section (ii) of the Gazette of India (Extraordinary), dated 20th September, 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 notification were made available to the public on 3rd October, 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 (39 of 1970) and in supersession of the Patents Rules, 1972 published in the Gazette of India, vide S.O. 301(E) dated 20th April, 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 the 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, <sup>2</sup>[\*\*\*] <sup>2</sup>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 <sup>3</sup> Sections 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.

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), in rule 4, in sub-rule (1), in clauses (i), the words and figures "other than under sections 39,65 and 125" is to be omitted, by the Patents Act, 1970 (39 of 1970).

In Rule 4, in sub-rule (1), in clauses (i) and (ii), the figures and letters "24-A, 24-B and 24-C" occurring at both the places shall be omitted, by the Patents (Amendment) Rules, 2005

#### **5. Address for service. :-**

Every person, concerned in any proceedings to which the Act or these [and the controller may take suo-motu decision in the matter] rules relate and every patentee, shall furnish to the Controller an 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. :-**

<sup>5</sup>(1) Any application, notice or other document authorized 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 mail 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 mail was properly addressed and transmitted :

6 [\*\*\*] 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 or paper copy, as the case may be, is submitted to the appropriate office within one month from the date of receipt of the 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 by 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 in 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.

In Rule 6 of the principal rules, for sub-rule (1), the following sub-rule shall be substituted, by the Patents (Amendment) Rules, 2005 In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 6 of the principal rules, in sub-rule (1), the proviso is to be omitted , to be written as: "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 or paper copy, as the case may be, is submitted to the appropriate office within one month from the date of receipt of the such fax or by electronic transmission duly authenticated." by the Patents Act, 1970 (39 of 1970).

## **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 <sup>7</sup>"or through electronic means" 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 <sup>8</sup>[\*\*\*], shall be accepted only at the discretion of the Controller.

<sup>9</sup>(c) Where a fee is payable in respect of a document, the entire fee shall accompany 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.

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

(5) (0 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.

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 7 of the principal rules, in sub-rule (2), in clause (a), after the words "paid in cash", the words "or through electronic means" shall be inserted by the Patents Act, 1970 (39 of 1970).

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), in In rule 7 of the principal rules, in sub-rule (2), clause (b), the words "within the time allowed for payment of the fees" shall be omitted by the Patents Act, 1970 (39 of 1970).

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), in clause (c), shall be substituted, in place of : " (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:" by the Patents Act, 1970 (39 of 1970).

In Rule 7 of the principal rules, for sub-rule (4), the following sub-rule shall be substituted, by the Patents (Amendment) Rules, 2005

## **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 centimeters 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 <sup>11</sup> "six 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.

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 7 of the principal rules, in sub-rule (2), in clause (a), after the words "paid in cash", the words "or through electronic means" shall be inserted by the Patents Act, 1970 (39 of 1970).

**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.

<sup>12</sup>(1-A). The period within which the applicant shall file the statement and undertaking under sub-sec. (1) of Sec. 8 shall be three months from the date of filing the application.

Explanation. For the purpose of this rule, the period of <sup>13</sup>"six months" 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.

(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 <sup>14</sup>"six months" from the date of such filing.

<sup>15</sup>(3) When so required by the Controller under sub-sec. (2) of Sec. 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 within <sup>16</sup> "six months" from the date of such communication by the Controller.

In Rule 12, after sub-rule (1), the following sub-rule shall be inserted, by the Patents (Amendment) Rules, 2005

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 12 of the principal rules, in rule (1A) and in the explanation, for the words "three months", the words "six months" shall respectively be substituted, by the Patents Act, 1970 (39 of 1970).

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), in rule 12 of the principal rules, in rule (2), for the words "three months", the words "six months" shall be substituted by the Patents Act, 1970 (39 of 1970).

In Rule 12, sub-rules (3) and (4), the following sub-rule shall be substituted, by the Patents (Amendment) Rules, 2005

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), in rule 12 of the principal rules, in rule (3) for the words "three months", the words "six months" shall be substituted by the Patents Act, 1970 (39 of 1970).

### **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 the case of an application (other than a convention application or an application filed under the Patent Cooperation Treaty designating India) 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.

(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.

(8) The period within which reference to the deposit shall be made

in the specification under sub-clause (A) of clause (ii) of sub-sec. (4) of Sec. 10 shall be three months from the date of filing of the application.

#### **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, and amendment is duly made thereon, the page incorporating such amendment shall be retyped and submitted 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 initialed 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.

#### **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 centimeters on the top and left hand and 3 centimeters 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 CO-OPERATION 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 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(1-A) may be made in [Form 1].

(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)(i)].

(3) An applicant in respect of an international application designating India shall, before the time-limit prescribed in [sub-rule (4)(i)],

(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 [or the person duly authorized by him] that the contents

thereof are correct and complete.

(4)

(i) The time limit referred to in sub-rule (2) shall be thirty one months from the priority date as referred to in Art. 2(xi);

(ii) Notwithstanding anything contained in clause (i), the Patent Office may, on the express request filed in Form-18 along with the fee specified in first schedule, process or examine the application at any time before thirty one months.

(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 [or the person duly authorized by him] 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) 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. Publication of application :-**

**26** The period for which an application for patent shall not ordinarily be open to public under sub-sec. (1) of Sec. 11-A shall be eighteen months from the date of filing of application or the date of priority of the application, whichever is earlier.

**27** "Provided that the period within which the Controller shall publish the application in the Journal shall ordinarily be one month from the date of expiry of said period, or one month from the date of request for publication under rule 24A.";

In Rule 24, the Rule 24, 24-A and 24-B shall be substituted, by the Patents (Amendment) Rules, 2005

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 24 of the principal rules, the following proviso shall be added, namely:- "Provided that the period within which the Controller shall publish the application in the Journal shall ordinarily be one month from the date of expiry of said period, or one month from the date of request for publication under rule 24A."; be substituted by the Patents Act, 1970 (39 of 1970).

**24A. Request for publication :-**

A request for publication under sub-sec. (2) of Sec. 11-A shall be made in Form 9.

**24B. Examination of application :-**

(1)

(i) A request for examination under Sec. 11-B shall be made in Form-18 <sup>28</sup>"within forty-eight months" from the date of priority of the application or from the date of filing of the application, whichever is earlier;

<sup>29</sup>"(ii) The period within which the request for examination under sub-section (3) of section 11B to be made shall be forty-eight months from the date of priority, if applicable, or forty-eight months from the date of filing of the application;

<sup>30</sup>(iii)" The request for examination under sub-section (4) of section 11B shall be made within forty-eight months from the date of priority or from the date of filing of the application, or within six months from the date of revocation of the secrecy direction, whichever is later;"

<sup>31</sup>(iv) The request for examination of application as filed according to the "Explanation' under sub-section (3) of section 16 shall be made within forty-eight months from the date of filing of the application or from the date of priority of the first mentioned application or within six months from the date of filing of the further application, whichever is later;

(v) The period for making request for examination under Sec. 11-B, of the applications filed before 1.1.2005 shall be the <sup>32</sup>"the period specified under the section 11B before the commencement of the Patents (Amendment) Act, 2005 or" the period specified under these rules, whichever expires later.

(2)

(i)<sup>33</sup>" The period within which the Controller shall refer the application and specification and other documents to the examiner in respect of the applications where the request for examination has been received shall ordinarily be one month from the date its publication or one month from the date of the request for examination whichever is later: Provided that such reference shall be made in order in which the request is filed under sub-rule (1).

(ii) The period within which the examiner shall make the report under sub-sec. (2) of Sec. 12, shall ordinarily be one month but not exceeding three months from the date of reference of the application to him by the Controller.

<sup>34</sup>"(iii) the period within which the Controller shall dispose off the report of the examiner shall ordinarily be one month from the date of the receipt of the such report by the Controller.";

(3) A first examination report along with the application and specification shall be sent to the applicant or <sup>35</sup>"his authorised agent ordinarily within six months from the date of the request for examination or six months from date of publication whichever is later". In case other interested person files the request for examination, an intimation of such examination may be sent to such interested person.

<sup>36</sup> "(4) The time for putting an application in order for grant under section 21 shall be twelve months from the date on which the first statement of objection is issued to the applicant to comply with the requirements."

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 24B of the principal rules, in sub-rule (1), in clause (i), for the words "after the publication (If the application but within thirty-six months", the words "within forty-eight months" shall be substituted, by the Patents Act, 1970 (39 of 1970).

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 24B of the principal rules, in sub-rule (1), clause (ii), shall be substituted, in place of old clause :- "(ii) The period within which the request for examination under sub-sec. (3) of Sec. 11-B to be made shall be thirty-six months from the date of priority or from the date of filing of the application or twelve months from 1.1.2005;" by the Patents Act, 1970 (39 of 1970).

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 24B of the principal rules, in sub-rule (1), clause (iii),

shall be substituted, in place of old clause :- "(iii) The request for examination under sub-sec. (4) of Sec. 11-B shall be made after the publication of the application, but within thirty-six months from the date of priority or from the date of filing of the application, or within six months from the date of revocation of the secrecy direction, whichever is later;" by the Patents Act, 1970 (39 of 1970).

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 24B of the principal rules, in sub-rule (1), clause (iv), shall be substituted, in place of old clause :- "(iv) The request for examination of application as filed according to the 'Explanation' under sub-sec. (3) of Sec. 16 shall be made after the publication of the first mentioned application, but within thirty-six months from the date of filing of the application or from the date of priority of the first mentioned application or within six months from the date of filing of the further application, whichever is later;" by the Patents Act, 1970 (39 of 1970).

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 24B of the principal rules, in sub-rule (1), clause (v) for the words, figures and letter "the period specified under the section 11B or", the words, figures and letter "the period specified under the section 11B before the commencement of the Patents (Amendment) Act, 2005 or" shall be substituted; by the Patents Act, 1970 (39 of 1970).

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 24B of the principal rules, in sub-rule (2), clause (i) shall be substituted, in place of : "(i) The period within which the Controller shall refer the application and specification and other documents to the examiner in respect of the applications where the request for examination has been received shall ordinarily be one month from the date its publication or one month from the date of the request for examination whichever is later: Provided that such reference shall be made in order in which the request is filed under sub-rule (1), " by the Patents Act, 1970 (39 of 1970).

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 24B of the principal rules, after clause (ii), the following clause shall be inserted, namely: - "(iii) the period within which the Controller shall dispose off the report of the examiner shall ordinarily be one month from the date of the receipt of the such report by the Controller."; by the Patents Act, 1970 (39 of 1970).

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In sub rule (3), for the words "his authorised agent", the words "his authorised agent ordinarily within six months from the date of the request for examination or six months from date of publication whichever is later." shall be substituted, by the Patents Act, 1970 (39 of 1970).

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 24B of the principal rules, for sub-rule (4), the following sub-rule shall be substituted, in place of :- " (4)(i) The

time for putting an application in order for grant under Sec. 21 shall be six months from the date on which the first statement of objection is issued to the applicant to comply with the requirements; (ii) Notwithstanding anything contained in these rules, the period specified in clause (i) may be extended for a further period not exceeding three months by the Controller in circumstances beyond the control of the applicant, on a request made in Form-4 by the applicant along with fee specified in the First Schedule before expiry of the time specified in clause (i); (iii) The time for putting an application in order for grant which has been examined before 1.1.2005, shall be twelve months from the date on which the first statement of objections has been issued to the applicant to comply with the requirements." by the Patents Act, 1970 (39 of 1970).

**25. Identification of published applications. :-**

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

**26. Request for withdrawal :-**

**37(1)<sup>38</sup> [\*\*\*]**

In Rule 26, sub-rule (2) shall be omitted, by the Patents (Amendment) Rules, 2005

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 24B, In rule 26 of the principal rules, the figure and brackets "(1)" shall be omitted as follows : " (1) A request for withdrawing the application under sub-section (4) of Section 11-B shall be made in writing." by the Patents Act, 1970 (39 of 1970).

**27. Inspection and supply of published documents :-**

After the date of publication of the application under Sec. 11-A, 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 in that behalf and copies thereof may be obtained on payment of fees specified in the First Schedule.

**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 [referred to] 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 [grant the patent] unless the amendment so specified or permitted is made within such period as may be fixed.

**28A. Procedure in relation to consideration of report of examiner under Sec. 14 :-**

In case the applicant contests any of the objections communicated to him, the procedure specified under Rule 28 may apply.

**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 applicant's specification is otherwise in order for grant and an objection under clause (b) of sub-sec. (1) of Sec. 13 is outstanding, the Controller may postpone the grant of patent and allow a period of two months 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 applicant's 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 applicant's 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], it appears to the Controller that the applicant's 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 applicant's 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 the grant of patent :-**

<sup>1</sup> On the grant of a patent, 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 so granted.

1. In Rule 37, the following rule shall be substituted, by the Patents (Amendment) Rules, 2005

**38. . :-**

**1**

1. Rule 38 shall be omitted, by the Patents (Amendment) Rules, 2005

CHAPTER 5

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**39. . :-**

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

**40. . :-**

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

**41. . :-**

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

**42. . :-**

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

**43. . :-**

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

**44. . :-**

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

**45. . :-**

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

**46.** . :-

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

**47.** . :-

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

**48.** . :-

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

**49.** . :-

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

**50.** . :-

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

**51.** . :-

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

**52.** . :-

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

**53.** . :-

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

**54.** . :-

**1**

1. In Chapter V, (rules 39 to 54) shall be omitted, by the Patents (Amendment) Rules, 2005

CHAPTER 6

OPPOSITION PROCEEDINGS

**55. Opposition by representation against the grant of patent :-**

**67**"(1)Representation for opposition under sub-section (1) of Section 25 shall be filled at the appropriate office and shall include a statement and evidence, if any, in support of the representation and request for hearing if so desired.

(1A) Notwithstanding anything contained in sub-rule(1), no patent shall be granted before the expiry of a period a six months from the date of publication of the application under Section 11-A."

(2) The Controller shall consider such representation only when a request for examination of the application has been filed.

(3) On consideration of the representation if the Controller is of the opinion that application for patent shall be refused or the complete specification requires amendment, he shall give a notice to the applicant to that **68**"effect along with a copy of such representation".

(4) On receiving the notice under sub-rule (3), the applicant shall, if he so desires file his statement and evidence, if any in support of his application within **69** "three months" from the date of the notice.

(5) On consideration of the statement and evidence filed by the applicant the Controller may either refuse to grant a patent on the application or require the complete specification to be amended to his satisfaction before the patent is granted.

(6) After considering the representation and submission made during the hearing if so requested, the Controller shall proceed further simultaneously either rejecting the representation and granting the patent or accepting the representation and refusing the grant of patent on that application, ordinarily within one month from the completion of above proceedings.

In the Patents Rules, 2003, in Rule 55 of the principal rules, sub-rule(1) substituted in place of :- "(1) Representation for opposition under sub-sec. (1) of Sec. 25 shall be filed at the appropriate office

within a period not exceeding three months from the date of publication of the application under Sec. 11-A of the Act, or before the grant of patent, whichever is later and shall include a statement and evidence, if any, in support of the representation and a request for hearing if so desired." by the Patents (Amendment) Rules, 2006.

In the Patents Rules, 2003, in Rule 55 of the principal rules, sub-rule (3), for the word "effect" the word "effect along with a copy of such representation", by the Patents (Amendment) Rules, 2006.

In the Patents Rules, 2003, in Rule 55 of the principal rules, sub-rule (4), for the word "one month" the word "three month", shall be substituted, by the Patents (Amendment) Rules, 2006.

#### **55A. Filing of notice of opposition :-**

The notice of opposition to be given under <sup>70</sup> "sub-sec. (2) of Sec. 25" shall be made in Form-7 and sent to the Controller in duplicate at the appropriate office.

In the Patents Rules, 2003, in Rule 55A of the principal rules, for the word "sub-sec. (3) of Sec. 25" the word "sub-sec. (2) of Sec. 25", shall be substituted, by the Patents (Amendment) Rules, 2006.

#### **56. Constitution of Opposition Board and its proceeding :-**

(1) On receipt of <sup>71</sup>"notice of opposition under Rule 55-A", the Controller shall, by order, constitute an Opposition Board consisting of three members and nominate one of the members as the Chairman of the Board.

(2) An examiner appointed under sub-sec. (2) of Sec. 73 shall be eligible to be a member of the Opposition Board.

(3) The examiner, who has dealt with the application for patent during the proceeding for grant of patent thereon shall not be eligible as member of Opposition Board as specified in sub-rule (2) for that application.

(4) The Opposition Board shall conduct the examination of the notice of opposition along with documents filed under Rules 57 to 60 referred to under <sup>72</sup> "sub-sec. (3) of Sec. 25", submit a report with reasons on each ground taken in the notice of opposition with its joint recommendation within three months from the date on which the documents were forwarded to them.

In the Patents Rules, 2003, in Rule 56 of the principal rules, in sub-rule (1) for the word "notice of opposition" the word "notice of opposition for sub-rule 55-A", shall be substituted, by the Patents

(Amendment) Rules, 2006.

In the Patents Rules, 2003, in Rule 56 of the principal rules, in sub-rule (3), for the word "sub-sec. (4) of Sec. 25" the word "sub-sec. (3) of Sec. 25", shall be substituted, by the Patents (Amendment) Rules, 2006.

**57. Filing of written statement of opposition and evidence :-**

The opponent shall send a written statement in duplicate setting out the nature of the opponent's interest, the facts upon which he bases his case and relief which he seeks and evidence, if any, along with notice of opposition and shall deliver to the patentee a copy of the statement and the evidence, if any.

**58. Filing of reply statement and evidence. :-**

(1) If the [patentee] 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 opponent's evidence, if any by him under Rule 57 and deliver to the opponent a copy thereof.

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

**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 [patentee's] reply statement and evidence under Rule 58, leave at the appropriate office evidence in reply strictly confined to matters in the [patentee's] evidence and shall deliver to the [patentee] 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, and on receiving the recommendation of Opposition Board or at such other time as the Controller may think fit, he shall 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 and may require members of Opposition Board to be present in the 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, and after taking into consideration the recommendation of Opposition Board, the Controller shall decide the opposition and notify his decision to the parties giving reasons therefor.

**63. Determination of costs :-**

If the patentee notifies the Controller that he desires to withdraw the patent 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.

**63A. Request made under Sec. 26(1) :-**

Request under Sec. 26(1) shall be made on Form-12 within three months from the date of the order of the Controller and shall be

accompanied by a statement setting out the facts upon which the petitioner relies and relief he claims.

**64. . :-**

**65. . :-**

**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 Sec. 28 :-**

The procedure specified in Rules 55-A 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 Sec. 28 as they apply to the opposition proceedings subject to the modification that reference to patentee 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

##### SECURITY DIRECTIONS

### **71. Permission for making patent application outside India under Sec. 39 :-**

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

### **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 for which directions given by the Central Government under sub-section (1) of Section 35 were in force.

#### CHAPTER 8

##### GRANT OF PATENTS

### **73. . :-**

### **74. Form of patent. :-**

**89** (1)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.

(2) A patent certificate shall ordinarily be issued within seven days from the date of grant of patent under Section 43.

In the Patents Rules, 2003, Rule 74 shall be substituted, in place of :- "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." by the Patents (Amendment) Rules,

2006.

**74A. Inspection of documents related to grant of patent :-**

After the date of publication of a grant of a patent, the application together with the complete specification and provisional specification, if any, the drawing if any, abstract and other documents related thereto may be inspected at the appropriate office by making a written request to the Controller and on payment of fee and may obtain copies on payment of fee specified in the First Schedule.

**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). :-**

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 Sec. 51**

**:-**

**1** The procedure specified in Rules 55-A 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 Sec. 51 as they apply to the hearing of an opposition proceeding.

1. In Rule 78, the following rule shall be substituted, by the Patents (Amendment) Rules, 2005

**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 <sup>1</sup>[Appellate Board or] 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 <sup>1</sup> [Appellate Board or] 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.

1. In Rule 79, before the word "court" wherever it occurs, the words "Appellate Board or" shall be inserted, by the Patents (Amendment) Rules, 2005

### **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.

<sup>1</sup> (1-A) The period for payment of renewal fees so specified in sub-rule (1) may be extended to such period not being more than six months if the request for such extension of time is made in Form-4 with the fee specified in the First Schedule.

(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.

1. In Rule 80, after sub-rule (1), the following sub-rule 80-A shall be inserted, by the Patents (Amendment) Rules, 2005

#### 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 <sup>1</sup>[granted], the Controller shall determine whether and subject to what conditions, if any, the amendment shall be allowed.

<sup>2</sup> (3)

(a) If the application for amendment under sub-rule (1) is made after grant of patent and the nature of the proposed amendment is substantive, the application shall be published.

(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 publication of the application.

(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 Sec. 57 as they apply to the hearing of an opposition proceeding.

1. In Rule 81, sub-rule (2), for the word "accepted", the word "granted" shall be substituted, by the Patents (Amendment) Rules, 2005

2. In Rule 81, sub-rule (3), the following sub-rule shall be substituted, by the Patents (Amendment) Rules, 2005

**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. Publication of the amendment allowed :-**

<sup>1</sup> The amendments allowed after a patent has been granted, shall be published.

1. In Rule 83, the following rule shall be substituted, by the

## Patents (Amendment) Rules, 2005

### 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.

<sup>1</sup> (3) Where applicant requests for a hearing within the time allowed and the Controller, after giving the applicant such a hearing, is prime facia satisfied that the failure to pay the renewal fees was unintentional, he shall publish the application.

1. In Rule 84, sub-rule (3), the following sub-rule shall be substituted, by the Patents (Amendment) Rules, 2005

#### **85. Opposition to restoration under Sec. 61 :-**

<sup>1</sup>

(1) At any time, within two months from the date of publication of the application 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 Sec. 60 as they apply to the hearing in the opposition proceeding.

1. In Rule 85, the following rule shall be substituted, by the Patents (Amendment) Rules, 2005

#### **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.

**1** (2) The Controller shall publish his decision.

1. In Rule 86, sub-rule (2), the following sub-rule shall be substituted, by the Patents (Amendment) Rules, 2005

CHAPTER 11

SURRENDER OF PATENTS

**87. Surrender of Patents :-**

**1**

(1) The Controller shall publish the notice of an offer given under Sec. 63.

(2) Any person interested may, within three months from the date of publication of the notice, 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 Sec. 63 as they apply to the hearing in opposition proceeding.

(4) If the Controller accepts the patentee's 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 publish the revocation of the patent.

1. In Rule 87, the following rules shall be substituted, by the Patents (Amendment) Rules, 2005

CHAPTER 12

REGISTER OF PATENTS

**88. Register of patents under Section 67. :-**

(1) Upon the <sup>97</sup>"grant" 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 <sup>98</sup>"grant" 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 <sup>99</sup> [the Controller or Appellate Board 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.

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 88 of the principal rules, sub-rule(1), for the word "sealing", shall be substituted for the the word "grant", by the Patents Act, 1970 (39 of 1970).

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 88 of the principal rules, sub-rule(1), for the word "sealing", shall be substituted for the the word "grant" , by the Patents Act, 1970 (39 of 1970).

In sub-rule (2) of Rule 88, for the words "Controller or the courts", the words "Controller or Appellate Board or the courts" shall be substituted, by the Patents (Amendment) Rules, 2005

#### **89. . :-**

#### **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 16].

(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 benefitting under the document shall be made in [Form 16].

#### **91. Presentation of assignment, etc. of patent to the 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:

**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 Sec. 84, Sec. 85, Sec. 91 or Sec. 92 or Sec. 92-A shall be in Form-17, or Form-19, 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

applicant's interest and terms and conditions of the licence the applicant is willing to accept.

**96A. 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 applicant's 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 [publication] 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 [in opposition proceedings].

**99. Manner of publication of the revocation order :-**

The Controller shall publish the order made by him under sub-sec. (3) of Sec. 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 20] 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 <sup>1</sup> [in opposition proceedings].

(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.

1. In Rule 101, sub-rule (7), for the words "of opposition to the grant of patents", the words "in opposition proceedings" shall be substituted, by the Patents (Amendment) Rules, 2005

**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 <sup>1</sup>[Form 21] 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 <sup>2</sup> [in opposition proceeding].

(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.

1. In Rule 102, sub-rule (1), for the word and figures "Form-22", the word and figures "Form 21" shall be substituted, by the Patents (Amendment) Rules, 2005

2. In Rule 102, sub-rule (6), for the words "of opposition to the grant of a patent", the words "in opposition proceeding" shall be substituted, by the Patents (Amendment) Rules, 2005

#### 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, addresses, specimen signatures and photographs] 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.

(3)

(i) Copies of register of patent agents shall be maintained in each of the branch offices;

(ii) The register of patent agents shall also contain specimen signatures and photographs of the persons registered as patent agents.

**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 22].

(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 subsection (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:

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

(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 candidate's name in the register of patent agents and issue to him a certificate of registration as a patent agent.

**111A. issue of duplicate certificate of patent agents :-**

The Controller may issue a duplicate certificate of registration as patent agent on a request made by the person so registered as patent agent along with fee specified in the first schedule and contain a statement setting out the circumstances in which the original certificate issued under Rule 111 was lost, destroyed and can not be produced.

**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 22].

**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 person's 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 published] 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 23] 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 a name to the register of patent agents [shall be published] 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 office, 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 patent agents.

(2) Every alteration made in the register of patent agents [shall be published].

**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<sup>1</sup> .

1. In Rule 120, the words "in the Official Gazette and in such other manner as the Controller may deem fit" shall be omitted, by the Patents (Amendment) Rules, 2005

CHAPTER 16

MISCELLANEOUS

**121. Period within which copies of specification etc. are to be filed :-**

The period within which copies of specification or corresponding documents to be filed by the applicant under sub-sec. (1) of Sec. 138 shall be three months from the date of communication by the Controller.

**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 and the person making the request shall also serve copies of the request and the copies of the document showing the proposed correction 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 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 opponent's 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 [in the hearing of the opposition proceeding].

**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 the 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. K281 Exercise of discretionary power by the Controller :-**

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

**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 24] 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 24] 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 statements shall be furnished by every patentee and every licensee under sub-section (2) of Section 146 in [Form 27] 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.

**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;

**2**"(aa) as to when the information under section 8 has been filed.";

(c) as to when an application has been withdrawn under Section 11-B;

(d) as to when a request for examination has been made under Section 11-B;

(e) as to when the examination report has been issued under Section 12;

**2**(f) as to 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;

**132**(g) as to when a patent has been granted;

(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

**133**(k) as to when any application is made or action taken involving an entry in the register, publication in the **134** "Official Journal" or otherwise, 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.

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 134 of the principal rules, in sub rule (1), after clause (a), the following clause shall be inserted, namely: - "(aa) as to when the information under section 8 has been filed."; by the Patents Act, 1970 (39 of 1970).

In Rule 134, sub-rule (1), for clauses (f), (g) and (k), the following clauses shall respectively be substituted, by the Patents

(Amendment) Rules, 2005

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), in rule 134 of the principal rules, in sub rule (1), in clause (k), for the words "Official Gazette", the words "Official Journal" shall be substituted, by the Patents Act, 1970 (39 of 1970).

**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 :-**

**135**(1) Save as otherwise provided in the **136** "in the rules 24B, sub-rule (4) of rule 55 and sub-rule (1A) of rule 80" , the time prescribed by these rules for doing of any act or the taking of any proceeding thereunder may be extended by the Controller for a period of one month, if he thinks it fit to do so and upon such terms as he may direct.

(2) Any request for extension of time made under these rules shall be made before the expiry of prescribed period.

In Rule 138 of the principal rules, the following rule shall be substituted, by the Patents (Amendment) Rules, 2005

In the Patents Rules, 2003 (hereinafter referred to as the principal rules), In rule 138 of the principal rules, in sub-rule (1), for the words, figures and brackets "in the rules 24,55 and 80(1A)", the words, figures and brackets "in the rules 24B, sub-rule (4) of rule 55 and sub-rule (1A) of rule 80 shall be substituted, be substituted, by the Patents Act, 1970 (39 of 1970).

**139. Hearing before the Controller to be in public in 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

FEES

SCHEDULE 2

List of Forms

SCHEDULE 3

Government of India The Parent Office

**THE THIRD SCHEDULE**

**FORM OF PATENT**

**Government of India The Parent Office**

No.....of.....20.....

Whereas ..... has declared that he is in possession of an invention for

..... and that he is the  
 ..... true and fir

inventor thereof (or the legal representative or assignee of the true and the first inventor) and that he is entitle to a patent for the said invention, having regard to the provisions of the Patents Act, 1970, as amended and the there is no objection to the grant of a patent to him;

And whereas he has, by an application, requested that a patent may be granted to him for the said invention;

And whereas he has by and in his complete specification particularly described the said invention and the manner in which the same is to be performed;

Now, these presents that the abovesaid applicant (including his legal representatives and assignees or any of them) shall, subject to the provisions of the Patents Act, 1970, as amended and the conditions specified in Section 47 of the said Act, and to the conditions and provisions specified by any other law for the time being in force, have the exclusive right to prevent third parties from making, using, offering for sale, selling or importing patented product in India/using the process in India and offering for sale, selling or importing for those purpose;

the product obtained directly by that process in India, for a term of twenty years from the .... day of.....

20.....and of authorizing any other person to do so, subject to the conditions that the validity of this patent it

not guaranteed and that the fee prescribed for the continuance of this patent is duly paid.

In witness thereof, the Controller has caused this patent to be sealed as of the ..... date of.....20.....

Controller of Patents, Date of Sealing.....

**SCHEDULE 4**

Government of India The Parent Office

<b>THE FOURTH SCHEDULE</b>			
No. of	Matter in respect of which cost is to be	Amount of fees (in Rupees)	
entry	awarded	For natural person(s)	For other than natural person(s) either alone or jointly
			with natural person(s)

1	2	3	4
1.	For notice of opposition:		
	(a) under Sections 25, 57, 61, 63, 78, 87(2) or 88(4); and	1500	5000
	(b) under Sections 87(2), 88(4) as modified by Section 24-C	10,000	30,000
2.	For application for compulsory licence:		
	(a) under Sections 84(1), 91(1) or 92(1); and	1500	5000
	(b) under Sections 84(1) and 92(1) as modified by Section 24-C	25,000	75,000
3.	For application for revision of terms and conditions of licence:		
	(a) under Section 88(4) and	1500	5000
	(b) under Section 88(4) as modified by Section 24-C	10,000	30,000
4.	For notice of intention to attend the hearing under Rule 62(2)	1500	5000
5.	Stamp fee for power of attorney, where a patent agent or other person has been appointed or stamp fee in respect of relevant affidavits	The amount actually paid	The amount actually paid
6.	For written statement under Rule 57 or reply statement under Rule 58 or for each affidavit, if relevant	2500	2500
7.	For each document or publication produced in the proceedings, if relevant	1000	1000
8.	For each unnecessary or irrelevant affidavit or citation	1000	1000
9.	For every day or part day of hearing	2500	2500

before the Controller

Note.—Strike out whichever is not applicable