EDITION ONE

# RASPREP

*Module 3*

## The Patents Rules, 2003 – Simplified

## Part I

Rule-wise Analysis of the Indian Patents Rules, 2003 (Chapter 1–5)

# PREFACE

This book titled "The Patents Rules, 2003 – Simplified (Part-1)," outlines the rules for patent applications and grants in India.
The rules are divided into sixteen chapters, covering a wide range of topics. In this book we will be covering first 5 Chapters.

- **Chapter I: Preliminary -** Defines key terms and sets the foundation for the rules.
- **Chapter II: Application for Patents -** Details the process of applying for a patent, including requirements for forms, drawings, and specifications.
- **Chapter III: International Applications under Patent Cooperation Treaty (PCT) -** Explains the procedures for international applications under the PCT, including definitions, appropriate offices, and fees.
- **Chapter IV: Publication and Examination of Applications -** Outlines the publication and examination process for patent applications.
- **Chapter V: Exclusive Marketing Rights -** This chapter has been omitted.

# REFERENCE

The explanations and commentary in this book are based on the Indian Patents Rules, 2003, including all subsequent amendments. Rules cited in this book are reproduced from the Indian Patents Rules, 2003 while the explanations and commentary are original, provided for clarity and understanding.

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RAS Intellect Pvt Ltd

MOHALI | NOIDA | AMBALA

Info@rasintellect.com

510-513, 5th floor, Jubilee Walk, Sector 70, Mohali, 160071

+ 91 7009846630 | +91 6280302834

www.rasintellect.com

## About Us

At RAS Intellect, we specialize in patents, trademarks, copyrights, and everything that protects your brainchild. From solo inventors to growing startups and global enterprises, we empower creators to secure, protect, and profit from their innovation. Our team of skilled professionals is dedicated to guiding organizations through the complexities of IP processes, ensuring that valuable assets are effectively protected and leveraged for maximum benefit. We operate across multiple verticals to cater to the unique challenges faced by organizations in promoting innovation while ensuring effective protection and management of intellectual assets. We also offer end-to-end support for research paper writing and publication, enabling impactful dissemination of innovative ideas in reputed journals.

## Vision

Our vision is to become a leading innovation and intellectual property enabler across India by empowering startups, universities, researchers, and enterprises with technology-driven IP, research, and commercialization solutions that transform ideas into impactful innovations.

## Mission

To empower innovators and creators by protecting and maximizing the value of their intellectual property through strategic, tailored solutions, while advancing research excellence by enabling high-quality publications in globally recognized and reputed journals.

## Charting the Course to Success

Our services are focused on strengthening measurable research, innovation, IPR, publication, and documentation outcomes for NIRF, NAAC and IIC.

**1. IPR and Patent Filing Support**

- Patentability assessment of faculty/student research
- Prior art searching and patent landscape reports
- Provisional and complete patent specification drafting
- Patent filing
- Early publication request support
- Request for examination filing support
- FER response drafting and prosecution assistance
- Patent grant tracking and reporting
- Design registration filing
- Copyright filing for software, manuals, literary works, lab content and academic material
- Trademark support for university innovation cells, incubation centres and institutional brands

**2.NIRF Research Parameter Support**

- Annual NIRF research data audit
- Patent published/granted tracking
- Research publication tracking
- Scopus publication mapping
- Citation and H-index monitoring
- Faculty-wise research output mapping
- Department-wise research performance reports

**3. NAAC Criterion III Support**

- Criterion III gap analysis
- Research policy drafting
- IPR policy drafting or revision
- Innovation and startup policy drafting
- Seed money policy documentation
- Research promotion mechanism documentation
- Faculty research incentive policy support
- Patent and publication evidence compilation
- MoU and collaboration evidence structuring
- Extension activity documentation
- Innovation ecosystem documentation

**4. IIC and Innovation Cell Support**

- IIC annual activity calendar planning
- Innovation and IP awareness sessions
- Patent search workshops
- Idea-to-IP mentoring
- Student innovation screening
- Hackathon planning and execution
- Prototype documentation support
- Startup mentoring sessions
- Entrepreneurship and commercialization workshops.

**5. Research Paper and Publication Support**

- Research topic selection support
- Literature review guidance
- Research paper structuring
- Journal selection guidance
- Scopus-indexed journal identification
- Plagiarism and AI-similarity reduction guidance
- Manuscript formatting as per journal guidelines
- Citation and referencing support
- Response to reviewer comments

**6. Faculty Development and Student Training Programs**

- Patent drafting workshop
- Patent search workshop
- Research methodology workshop
- Scopus publication workshop
- Copyright and design registration workshop
- Innovation-to-commercialization workshop
- Technology transfer and licensing session
- Startup and entrepreneurship bootcamp
- Patent Agent career awareness session
- IP for faculty research advancement
- IP for Ph.D. scholars and research supervisors

**7. University IP Cell Setup and Management**

- IP Cell formation support
- IP Cell SOP drafting
- Invention disclosure form preparation
- Patent review committee formation support
- IP ownership and revenue-sharing policy
- Faculty/student disclosure workflow
- Patent filing calendar
- IP awareness schedule
- Department-wise IP coordinators' training

**8. Incubation and Commercialization Support**

- Technology readiness assessment
- Commercial potential assessment
- Startup idea screening
- IP-based startup mentoring
- Licensing strategy
- Technology transfer documentation
- MoU drafting support
- Pitch deck preparation
- Innovation portfolio preparation

**RASPREP University Training Programs**

RAS Intellect offers structured IP training and internship programs for universities through 1-week, 6-week, and 6-month formats. These programs cover IP fundamentals, patent searching, patent drafting, legal understanding, innovation awareness, and career readiness in the intellectual property domain. The modules can be delivered in virtual, hybrid, or offline mode and may also be customized as credit-based, vocational, or skill-development programs for students and faculty. This initiative supports universities in strengthening innovation culture, student employability, academic enrichment, and evidence-based contribution towards NAAC, NIRF and IIC-related research and innovation parameters.

**How this supports Universities**

- NAAC Criterion III: research, innovation, extension, skill development, and institutional innovation ecosystem.
- IIC activities: IP awareness, innovation training, patent search workshops, idea-to-IP mentoring, and entrepreneurship-linked activities.
- NIRF support areas: research culture, professional practice, IPR awareness, patent filing pipeline, and student/faculty innovation outcomes.
- Employability and academic enrichment: by creating technically trained students for IP, patent drafting, research analysis, and innovation-based career roles.

## Recent Milestones

*Recognitions and Contributions from 2024–2025*

- **National IP Outreach Mission – Viksit Bharat**

Dr. Ruchi represented RAS Intellect Solutions as a panelist in the "IPR for Women in Business" session organized by PHDCCI, contributing to the national dialogue on IP for inclusive innovation.

- **National IP Yatra 2025 – ASSOCHAM & MSME Ministry**

As co-panelist at this MSME Ministry-supported event, Dr. Ruchi addressed "Maximizing IP Value for Startups & MSMEs," underscoring the firm's expertise in IP commercialization.

- **National Intellectual Property Awards 2024 – Ministry of Commerce & CGPDTM**

Dr. Ruchi was invited to the prestigious IP Awards held at Bharat Mandapam, New Delhi, recognizing RAS Intellect's national contribution to IP literacy and strategy.

- **Leadership & Innovation Milestone – TiECON 2025**

Honoured by the Governor of Punjab, Dr. Ruchi received an award at TiECON 2025 for excellence in research and innovation leadership.

## Building IP Foundations for Viksit Bharat

*A visionary collaboration with Punjab School Education Board (PSEB)*

In alignment with the national vision of **Viksit Bharat@2047**, RAS Intellect is collaborating with the **Punjab School Education Board (PSEB)** to introduce Intellectual Property (IP) education in schools across Punjab.

This initiative aims to embed IP awareness and foundational knowledge within the school curriculum — empowering students and educators to understand, create, and protect innovation from an early age. By nurturing IP consciousness at the grassroots level, we are shaping a generation of future-ready innovators equipped to lead India toward self-reliance and global competitiveness.

## Meet the Founder

*Visionary leadership driving India's IP revolution*

### Dr. Ruchi Singla

*Director & CEO, RAS Intellect Solutions Pvt. Ltd*

- Over 20 years of experience in academic research, intellectual property strategy, and innovation leadership
- Recognized among the **Top 50 Mentors in India** for contributions to national mentoring initiatives
- Serves as a **Regional Mentor of Change** under the **Atal Innovation Mission**, NITI Aayog
- Successfully guided **over 2,300 patent filings** across diverse fields, including AI, drones, and cybersecurity
- Established **three Centres of Excellence** during her academic leadership, fostering innovation ecosystems
- Licensed Indian Patent Agent (No. 5887) and Certified Canadian Patent Administrator by **the Intellectual Property Institute of Canada**
- Secured **over ₹15 crores** in funding for research, innovation, and startup incubation projects
- Empaneled as an **IP Facilitator under the Startup India Scheme (SIIP)** to support early-stage ventures
- Regular speaker and co-panelist at national forums including **TiECON, ASSOCHAM, and PHDCCI**
- Former **Director of Research & Innovation at CGC Landran** and **Director at ACIC RISE Association,** supported by NITI Aayog
- Recognized as a **scientific advisor** to the GOI

*At the intersection of policy, education, and intellectual property, Dr. Ruchi Singla is building a more innovation-ready India.*

# 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.

**Explanation:**

The Patents Act 1970 is a territorial act which extents to the whole of India and not beyond that. Each country has their own patents act. Indian patent rules are the procedural rules made under Indian Patent Act that provide procedural guidelines for the various aspects of patent registration and prosecution in India.

## 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;

**(ca)**"educational institution" means a university established or incorporated by or under Central Act, a Provincial Act, or a State Act, and includes any other educational institution as recognised by an authority designated by the Central Government or the State Government or the Union territories in this regard;

**(d)** "Form" means a Form specified in the Second Schedule;

**(da)** "person other than a natural person" shall include a "small entity";

**(db)** "Request for examination" means a request for examination, including expedited examination, made under section 11B in respect of rule 24B or rule 24C;

**(e)** "Schedule" means Schedule to these rules;

**(f)** "section" means a section of the Act;

**(fa)** "small entity" means,-

**(i)**in case of an enterprise engaged in the manufacture or production of goods, an enterprise where the investment in plant and machinery does not exceed the limit specified for a medium enterprise under clause (a) of sub-section (1) of section 7 of the Micro, Small and Medium Enterprises Development Act, 2006 (27 of 2006); and

**(ii)**in case of an enterprise engaged in providing or rendering of services, an enterprise where the investment in equipment is not more than the limit specified for medium enterprises under clause (b) of sub-section ( I ) of Section 7 of the Micro, Small and Medium Enterprises Development Act, 2006.

Explanation 1. - For the purpose of this clause, "enterprise" means an industrial undertaking or a business concern or any other establishment, by whatever name called, engaged in the manufacture or production of goods, in any manner, pertaining to any industry specified in the First Schedule to the Industries (Development and Regulation) Act, 1951 (65 of 1951) or engaged in providing or rendering of any service or services in such an industry.

Explanation 2. - In calculating the investment in plant and machinery, the cost of pollution control, research and development, industrial safety devices and such other things as may be specified by notification under the Micro, Small and Medium Enterprises Development Act, 2006 (27 of 2006); shall be excluded.
Explanation 3.- The reference rates of foreign currency of the Reserve Bank of India shall prevail.
**(fb)** (i) "Startup" means
**(a)** an entity in India recognised as a startup by the competent authority under Startup India initiative.
**(b)** In case of a foreign entity, an entity fulfilling the criteria for turnover and period of incorporation/ registration as per Startup India Initiative and submitting declaration to that effect.
Explanation: In calculating the turnover, reference rates of foreign currency of Reserve Bank of India shall prevail.
**(g)** words and expressions used, but not defined in these rules, shall have the meanings respectively assigned to them in the Act.

**Explanation:**
This is the most crucial part of the chapter. It provides the meaning for various terms used in the rules, such as "Act," "Article," "appropriate office," "Small Entity," "Startup," "Form," and "Section." These definitions are essential for understanding the rest of the document.

## 3

**Prescribed particulars:**

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

**Explanation:**
When the Patents Act requires specific details or particulars, the forms are to be referred as provided in the Patents Rules. The information filled in the form is officially recognized as meeting the legal requirement.

## 4

**Appropriate office:**

**(1)** The appropriate office of the patent office shall-
**(i)** for all the proceedings under the Act, 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

**(2)** The appropriate office once decided in respect of any proceedings under the Act shall not ordinarily be changed.
**(3)** Notwithstanding anything contained in sub-rule (2), the Controller may transfer an application for patent so filed, to head office or, as the case may be, branch office of the Patent Office.
**(4)** Notwithstanding anything contained in sub-rule (1), further application referred to in section 16 of the Act, shall be filed at the appropriate office of the first mentioned application only.
**(5)** All further applications referred to section 16 of the Act filed in an office other than the appropriate office of the first mentioned application, before the commencement of the Patents (Amendment) Rules, 2013, shall be transferred to the appropriate office of the first mentioned application.

**Explanation:**
The "appropriate office" means the Patent Office (head office or branch office) that will handle a particular application or proceeding, which depends on:
(a) Where the applicant (or first-named applicant in case of joint applicants) lives, is domiciled, has a business, or where the invention actually originated.
(b) If the applicant/party has no place of business or domicile in India, then it depends on the address for service in India given by the applicant/party.
Once an "appropriate office" is decided for a proceeding, it will not be changed. The Controller of Patents has the power to transfer an application to the head office or another branch office, if needed. If a divisional application (a further application out of an original one because of more than one invention) is filed, it must be filed in the same "appropriate office" as the original application. If a divisional application was mistakenly filed in a different office before the 2013 Amendment Rules, it will be transferred to the office of the original application.

## 5

**Address for service:**
Every person, concerned in any proceedings to which the Act or these rules relate and every patentee, shall furnish to the Controller an address for service, including a postal address in India and an e-mail address, and such address for service shall 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 for service 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 and the Controller may take Suo motu decision in the matter: Provided that a patent agent shall also be required to furnish to the Controller a mobile number registered in India.

**Explanation:**
Anyone dealing with the Patent Office must give a valid postal address in India, email, and (for agents) a mobile number. Without this, the Patent Office is not required to act on their requests or even send them notices.

# 6

**Leaving or Serving Documents:**

**(1)**Any application, notice or other document authorised or required to be filed, left, made or given at the patent office, or to the Controller or to any other person under the Act or these rules, may be tendered by hand or sent by a letter addressed to the Controller at the appropriate office or to that person through post or registered post or speed post or by electronic transmission duly authenticated. If it is sent by post or registered post or speed post 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 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:

**(1A)** Notwithstanding anything contained in sub-rule (1), a patent agent shall file, leave, make or give all documents only by electronic transmission duly authenticated, including scanned copies of documents that are required to be submitted in original:

Provided that the original documents that are required to be submitted in original, shall be submitted within a period of fifteen days, failing which such documents shall be deemed not to have been filed.

**(2)** Any written communication addressed to a patentee at his postal address or e-mail 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 postal address or e-mail 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 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 fax or electronic transmission duly authenticated, as the case may be, unless otherwise specified under the Act or these rules.

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

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

**(6)** Without prejudice to sub-rule (5) and notwithstanding anything contained in sub-rule (2) of rule 138, the Controller may condone the delay in transmitting or resubmitting a document to the patent office or performing any act by a party, if a petition for such condonation of delay is made by the party to the Controller along with a statement regarding the circumstances of the

fact and evidence in support of the statement, to the satisfaction of the Controller, that the delay was due to war, revolution, civil disorder, strike, natural calamity, a general unavailability of electronic communication services or other like reason in the locality where the party resides or has place of business, and that such situation was of such severity that it disrupted the normal communication in that area and that the relevant action was taken as soon as reasonably possible not later than one month from the date when such situation had ceased to exist: Provided that the delay condoned by the Controller shall not exceed the period for which the national emergency was in force, or six months from the expiry of the prescribed period, whichever is earlier.

**(7)** Any liability or burden of proof regarding the authenticity of any document filed, left, made or given under these rules, including electronically transmitted documents, shall lie only with the party filing, leaving, making or giving the document.

**Explanation:**

1. Applications, notices, or documents authorised or required to be filed, left, made or given at the patent office, or to the Controller or to any other person may be hand-delivered, sent by post/registered post/speed post or sent by authenticated electronic transmission (e-filing portal).
2. If sent by post or electronic means, they are considered filed at the time they would normally be delivered. Proof of that the document has been sent made is given by showing that it was correctly addressed and transmitted.
3. Patent agents are required to file all documents only electronically (duly authenticated).
4. A scanned copy must be filed electronically first, and the original must be submitted within 15 days. If the documents are not submitted on time, the application is deemed not filed.
5. Any written communication is valid if sent to the address or email:
   - Mentioned in the register of patents (for patentees)
   - Mentioned in the application/notice of opposition (for applicants or opponents)
   - Or provided under Rule 5 (address for service)
6. Notices and documents are sent by Registered post, speed post, authenticated electronic transmission or special messenger only in exceptional cases. The date of a notice/communication is the date of dispatch (by post, speed post, fax, or electronic transmission), unless otherwise specified.
7. If a party receives a late document or there is delay in the communication by the patent Office, 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 the fact and evidence in support of the statement. The Controller may condone the delay, but only up to the period between:
   - The date it should have been received (ordinary course) AND
   - The actual date of receipt.
8. The Controller may condone delays caused by events like War, revolution, strike, civil disorder, natural calamity, failure of communication services, etc. on the following conditions:
   - The situation was severe enough to disrupt normal communication.
   - The party acted as soon as reasonably possible (within 1 month after the situation ended).
   - Delay condoned is maximum duration of the emergency or 6 months from the deadline, whichever is earlier.
9. The party filing/submitting a document is fully responsible for proving its authenticity, including electronically transmitted documents.

# 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. Provided that ten per cent additional fee shall be payable when the applications for patent and other documents are filed through physical mode, namely, in hard copy format: Provided further that in the case of a small entity, every document, for which a fee has been specified, shall be accompanied by Form-28.

**(2)(a)** The fees payable under the Act or these rules may be paid at the appropriate office either in cash or through electronic means or may be sent by bank draft or banker's cheque payable to the Controller of Patents and drawn on a scheduled bank at the place where the appropriate office is situated and if the draft or banker's cheque is sent by post, the fees shall be deemed to have been paid on the date on which the draft or banker's cheque has actually reached the Controller.

**(b)** omitted

**(c)** Where a fee is payable in respect of a document, the entire fee shall accompany the document.

**(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.

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

**(3B)** In case an application processed by a startup is fully or partly transferred to any person other than a natural person or a startup, the difference, if any, in the scale of fees between the fees charged from a startup and such person to whom the application is transferred, shall be paid by the new applicant along with the request for transfer: Explanation.— Where the startup ceases to be a startup after having filed an application for patent due to lapse of more than five years from the date of its incorporation or registration or the turnover subsequently crosses the financial threshold limit as defined, no such difference in the scale of fees shall be payable.

**(4)** Fees once paid in respect of any proceeding shall not ordinarily be refunded irrespective of whether the proceeding has taken place or not: Provided that, if the Controller is satisfied that during the online filing process, the fee was paid more than once for the same proceeding, the excess fee shall be refunded

**(4A)** Notwithstanding anything contained in sub-rule (4), upon the withdrawal of an application in respect of which a request for examination has been filed, but before issuance of first statement of objection, the fee may be refunded to the extent prescribed in the First Schedule on a request made by the applicant in Form 29.

**(5) (i)** Subject to the approval of the Controller, any person may deposit money in advance and request the Controller to realise any fee payable by him from the said deposit and in such case the date of the receipt of the request to realise the fee or the date on which the request to realise the fee is deemed to have been received, whichever is earlier, shall be taken as the date of payment of the fee: Provided that the requisite amount of money is available at the credit of the person making such request.
**(ii)** Subject to the approval of the Controller, any person may discontinue the deposit of money in advance and in such case the balance, if any, shall be refunded.

**Explanation:**
(1) The fees to be paid in respect of the grant of patents and applications and in respect of other matters for which fees are required to be paid is mentioned in the First Schedule. Ten percent additional fee is incurred when the applications for patent and other documents are filed through physical mode i.e. in hard copy format: in the case of a small entity, every document, for which a fee has been required, should be accompanied by Form-28.
(2) The fees should be paid at the appropriate office either in cash or through electronic means or may be sent by bank draft or banker's cheque payable to the Controller of Patents and drawn on a scheduled bank at the place where the appropriate office is situated.
(3) In case the draft or cheque is sent by post, the fees shall be considered to have been paid on the date on which the draft or cheque has actually reached the Controller.
(4) The document sent to the patent office should be accompanied by full fee.
(5) In case an application processed by a natural person is fully or partly transferred to anyone other than a natural person, the difference shall be paid by the new applicant with the request for transfer. In case an application processed by a small entity is fully or partly transferred to a person other than a natural person, the difference of fee shall be paid by the new applicant with the request for transfer. In case an application processed by a startup is fully or partly transferred to any person other than a natural person or a startup, the difference shall be paid by the new applicant along with the request for transfer.
(6)The fees once paid in respect of any proceeding shall not ordinarily be refunded. If the Controller is satisfied that during the online filing process, the fee was paid more than once for the same proceeding, the excess fee shall be refunded.
(7) In case of the withdrawal of an application in respect of which a request for examination has been filed before issuance of first statement of objection, the fee may be refunded to the extent prescribed in the First Schedule. (The request is made by the applicant in Form 29).
(8) A person (such as an applicant, patentee, or agent) can, with the Controller's approval, deposit money in advance with the Patent Office. Later, when a fee is due, the person can request the Controller to deduct (realise) the fee from that advance deposit. The date of payment of the fee will be considered as either:

- The date the request to use the deposit is received by the Controller, or
- The date the request is deemed to have been received (under the rules), whichever is earlier.

This is valid only if sufficient balance is available in the person's account at the time of deduction.
(9) With the Controller's approval, a person may choose to stop maintaining such an advance deposit system. In that case, the remaining balance, if any, must be refunded to the person.

# 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 use Form 30 specified in the Second Schedule.

**Explanation:**
The rules include a set of official forms listed in the Second Schedule which can be used for any given procedure under the Patents Act/Rules. The applicant can use Form 30 in case there is no specific form prescribed in the Second Schedule for any given procedure.

# 9

**Filing of documents and copies, etc.:**

**(1)** All documents and copies of the documents, except affidavits and drawings, filed with patent office, shall –
**(a)** be typewritten or printed in Hindi or English (unless otherwise directed or allowed by the Controller) in large and legible characters not less than 0.28 centimetre high with deep indelible ink with lines widely spaced not less than one and half spaced only upon one side of the paper;
**(b)** be on such paper which is flexible, strong, white, smooth, non-shiny, and durable of size A4 of approximately 29.7 centimetre by 21 centimetre with a margin of at least 4 centimetre on the top and left hand part, and 3 centimetre on the bottom and right hand part thereof;
**(c)** be numbered in consecutive Arabic numerals in the centre of the bottom of the sheet; and
**(d)** contain the numbering to every fifth line of each page of the description and each page of the claims at right half of the left margin.
**(2)** Any signature which is not legible or which is written in a script other than English or Hindi shall be accompanied by a transcription of the name either in Hindi or English in capital letters.
**(3)** In case, the application for patent discloses sequence listing of nucleotides or amino acid sequences, the sequence listing of nucleotides or amino acid sequences shall be filed in computer readable text format along with the application, and no print form of the sequence listing of nucleotides or amino acid sequences is required to be given.
**(4)** Additional copies of all documents shall be filed at the appropriate office as may be required by the Controller.
**(5)** Names and addresses of applicant and other persons shall be given in full together with their nationality and such other particulars, if any, as are necessary for their identification.

**Explanation:**
This rule explains the submission and formatting requirements for documents filed with the Patent Office.

- The documents must be typed/printed in Hindi or English (unless Controller allows otherwise), in large, clear letters (≥0.28 cm height), using deep indelible ink, with 1.5 line spacing, on one side only.

- If a signature is illegible or in a script other than Hindi/English, it must be accompanied by a transcription of the name in Hindi/English, in capital letters.
- If the patent involves nucleotide or amino acid sequences, they must be submitted in computer-readable text format. No printed copy of the sequence listing is required.
- The Controller may require applicants to file extra copies of documents at the appropriate office.
- Full names and addresses of applicants and other persons must be given, along with their nationality and any other details necessary for identification.

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# 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 six months after the filing of such application furnish such proof. Explanation —For the purposes of this rule, the 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.

**Explanation:**

This provision relates to applications filed through assignment of rights. If a person files a patent application as an assignee (i.e., someone to whom the inventor has transferred the right to apply), they need to provide proof of that assignment (such as an assignment deed). If the proof is not submitted along with the application, it must be submitted within 6 months from the date of filing the application. If the proof is not furnished within this 6-month period (or within an extended period if allowed by the Controller), the application could face objections or even risk being refused because the applicant's right to apply has not been established. If proof is not submitted within the stipulated time (or extended time), the Controller may raise objections during examination. Failure to resolve these objections can lead to refusal of the application. Even if a patent is granted, third parties may challenge its validity due to lack of proof of right.

## 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.

**Explanation:**

Every patent application filed in India is assigned a unique number that includes the year of filing. This helps in organizing and tracking applications chronologically.

# 12

**Statement and undertaking regarding foreign applications:**

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

**(1A)** The period within which the applicant shall file the statement and undertaking under sub-section (1) of section 8 shall be six months from the date of filing the application.

Explanation- For the purpose of this rule, the period of 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 six months from the date of such filing.

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

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**Explanation:**

| Section | Obligation | When to Comply | How to Comply |
|---|---|---|---|
| 8(1)(a) | Furnish a statement setting out detailed particulars of applications for a patent for the same or substantially the same invention filed in any country outside India. | At the time of filing the application for patent in India or within six months thereafter. | Furnish the requisite details in prescribed Form 3. |
| 8(1)(b) | Undertaking to furnish information of 'every other application,' if any, filed elsewhere subsequent to the filing of the statement under Section 8(1)(a). | Within six months of filing such new application. | Furnish the new application information by updating Form 3. Status of previously included applications may be updated, if desired. |
| 8(2) | Furnish details, as may be prescribed, relating to the processing of the application in a country outside India upon requisition by the Controller. | Within six months of the Controller's requisition. | No prescribed format. But provide all relevant details as required by the Controller, including but outside India upon requisition by the Controller not limited to, copies of Office Actions, Notice of Allowances/Rejections, allowed/granted claims etc. Form 3 with updated status may also be submitted, if desired. |

**Form 3 Filing Timelines**

# 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, including the claims where the features illustrated in the drawings shall be followed by their respective reference signs in parentheses: Provided that in case of a complete specification, if the applicant desires to adopt the drawings filed with the 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 or filed 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.

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

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

**(b)** The abstract shall contain a concise summary of the matter contained in the specification and the summary shall indicate clearly the technical field to which the invention belongs, technical advancement of the invention as compared to the existing Knowledge and principal use of the invention excluding any speculative use and 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-section (4) of section 10 shall be three months from the date of filing of the application: Provided that in case of a request for publication under rule 24A, such reference shall be made on or before the date of filing of such request.

**Explanation:**
Rule 13 gives the clarity, completeness, and searchability of specifications, covering Form 2, divisional/patent of addition, drawings, inventorship, abstract, and biological deposits.

| Requirement | Applicable Form | Deadline | Notes |
|---|---|---|---|
| Specification must be in Form 2 | Form 2 | At time of filing | Mandatory for all specifications |
| Divisional application must reference original application | N/A | With divisional application | Must include original application number |
| Patent of addition must reference main patent and depict improvement | N/A | With patent of addition | Must include main patent number and improvement statement |
| Drawings must follow Rule 15 and should be referenced in specification | N/A | With specification | Drawings must be detailed and referenced with signs |
| Exclude irrelevant matter from title, description, claims, drawings | N/A | -- | Controller may exclude unnecessary content |
| Inventorship declaration in Form 5 with complete specification | Form 5 (or Form 4 for extension) | With complete specification or within 1 month (extendable) | Required unless application is convention or PCT |
| Abstract must start with title (Title ≤15 words) | N/A | With abstract | Title must reflect specific features |
| Abstract must summarize invention, field, advancement, use | N/A | With abstract | Exclude uses; include chemical formula if needed |
| Abstract must be ≤150 words | N/A | With abstract | Concise summary required |
| Indicate drawing figure(s) in abstract if applicable | N/A | With abstract | Reference signs must match drawing features |
| Abstract must aid technical search | N/A | With abstract | Should help understand the concise summary of the specification |
| Reference to deposit of Biological material must be made within 3 months of filing | N/A | Within 3 months of filing or with publication request | Required under Section 10(4)(ii)(A) |

## 14

**Amendments to Specifications:**

**(1)** When amendments are made to a provisional or complete specification or any drawing accompanying it, the pages incorporating such amendments shall be retyped and submitted to form a continuous document.

**(2)** A marked copy clearly identifying the amendments carried out and a statement clearly indicating the portion (page number and line number) of the specification or drawing being amended along with the reason shall also be filed.

**(3)** Amendments shall not be made by slips pasted on, or as footnotes or by writing in the margin of any of the said documents.

**(4)** When a retyped page or pages incorporating amendments are submitted, the corresponding earlier page shall be deemed to have been superseded and cancelled by the applicant.

## 15

**Drawings:**

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

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

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

**(4)** Drawings shall be on standard A4 size sheets with a clear margin of at least 4 cm on the top and left hand and 3cm 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)**Drawings 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 COOPERATON TREATY (PCT)

## 17

**Definitions:**

In this Chapter, unless the context otherwise requires,—

**(a)** "Article" means an Article of the Treaty;

**(aa)** "Examining Authority" means the Indian International Preliminary Examining Authority referred to in sub-rule (1) of rule 19F;

**(ab)** "International Bureau" means the International Bureau of World Intellectual Property Organisation;

**(ac)** "Searching Authority" means the Indian International Searching Authority referred to in sub-rule (1) of rule 19A;

**(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.

**Explanation:**

Rule 17 is a glossary of the keywords used within this chapter.

## 18

**Appropriate office in relation to international applications:**

**(1)** The receiving office, the designated office and the elected office for the purposes of international applications shall be the appropriate office referred to in rule 4.

**(2)** Notwithstanding anything contained in sub-rule (1), the Patent Office, Delhi branch shall be the appropriate office for dealing with the International Bureau and any other International Searching Authority and International Preliminary Examining Authority.

**(3)** An international application shall be filed at and processed by the appropriate office, referred to in sub-rule (1), in accordance with the provisions of this Chapter, the Treaty and the regulation under the Treaty.

**(4)** The appropriate office referred to in sub-rule (1), shall, on receipt of an international application, **(a)** keep one copy of the application to be called the “home copy” in its office;

**(b)** transmit one copy to be called the "record copy" to the International Bureau; and

**(c)** transmit one copy to be called "search copy" to the competent International Searching Authority referred to in Article 16 of the Treaty. And simultaneously furnish complete details of such application to the Patent Office, Delhi branch.

**Explanation:**
The appropriate Patent Office (as per Rule 4) will act as:

- Receiving Office (RO) where the international application (PCT application) is filed.
- Designated Office (DO), a national office designated under the PCT for granting patents.
- Elected Office (EO) for handling international preliminary examination if the applicant elects India.

Although the appropriate office is usually based on territorial jurisdiction of the applicant/agent, the Delhi Patent Office has exclusive responsibility for:

- Dealing with the International Bureau (IB).
- Coordinating with any International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA).
- International applications filed in India are processed by the appropriate office in accordance with the Patent Cooperation Treaty (PCT) & the Regulations under the PCT.

When an international application is filed, the appropriate office must:

- Retain one copy in the office (Home Copy).
- Send to the International Bureau of WIPO (Record Copy).
- Send to the competent International Searching Authority (Search Copy).

The appropriate office must furnish complete details simultaneously to the Patent Office, Delhi Branch.

## 19

**International applications filed with appropriate office as receiving office:**

**(1)** Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file along with his application or subsequently within the prescribed period as the Controller may allow —

**(a)** a statement setting out detailed particulars of such application; and

**(b)** an undertaking that, up to the date of grant of patent in India, he would keep the Controller informed in writing, from time to time, of detailed particulars as required under clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequently to the filing of the statement referred to in the aforesaid clause within the prescribed time.

**(2)** At any time after an application for patent is filed in India and till the grant of a patent or refusal to grant of a patent made thereon, the Controller may also require the applicant to furnish details, as may be prescribed, relating to the processing of the application in a country outside India, and in that event the applicant shall furnish to the Controller information available to him within such period as may be prescribed.

# 19A

**Indian International Searching Authority:**

**(1)** The Patent Office, Delhi branch shall perform the functions of the Indian International Searching Authority under the treaty in accordance with an agreement between the Indian Patent Office and the International Bureau.

**(2)** The fees payable to the Searching Authority shall, in addition to the fees specified in the regulations made under the Treaty, be the fees as specified in the Fifth Schedule.

**(3)** The Searching Authority referred to in sub-rule (1), shall establish international search report in respect of international applications, or, as the case may be, declare in accordance with sub-rule (3) of rule 19B, in cases where India has been indicated as a competent International Searching Authority.

# 19B

**International search report:**

**(1)** The Searching Authority shall, on receipt of the search copy, notify the International Bureau and the applicant about the receipt of search copy with identification mark 'ISA/IN' along with the international application number and its serial number and the date of receipt of the search copy.

**(2)** Notwithstanding anything contained in the proviso to item (i) of sub-rule (2) of rule 24B, the Searching Authority shall, upon receipt of the search copy, refer the international application, in the order in which the search copy was received, to an examiner or any other officer appointed under sub-section (2) of Section 73 of the Act for preparing an international search report, in accordance with the provisions contained in the Treaty and the regulations under the Treaty, ordinarily within a period of one month but not exceeding two months from the date of such reference.

**(3)** The Searching Authority, if it considers that-

**(a)** the international application relates to a subject matter which the Searching Authority is not required to search and accordingly decides not to search; or

**(b)**the description, claims or drawings fail to comply with the requirements prescribed under the regulation under the Treaty to such an extent that a meaningful search could not be carried out, the Authority shall so declare and notify the applicant and the International Bureau that no international search report shall be established.

**(4)** In a case where any situation referred to in clause (a) or clause (b) of sub-rule (3) is found to exist in connection with certain claims only, the Searching Authority shall indicate this fact in the International Search Report in respect of such claims, and for other claims, it shall establish the International Search Report.

**(5)** The Searching Authority, if it considers that the international application does not comply with the requirement of unity of invention, in accordance with the provisions contained in Rule 13 of the regulations under the Treaty, shall send a notice specifying the reasons for which the international application is not considered as complying with the requirement of unity of invention and inviting the applicant-

**(a)** to pay the additional fees specified in the Fifth Schedule, indicating the amount of fees to be paid, within a period of one month from the date of such invitation, and

**(b)**to pay, where applicable, the protest fee specified in the Fifth Schedule, indicating the amount of fee to be paid, within a period of one month from the date of such invitation.

**(6)** The Searching Authority shall establish the International Search Report on those parts of the international application which relate to the invention first mentioned in the claims ("main invention") and subject to payment of additional fee within the period specified in sub-rule (5), on those parts of the international application which relate to inventions in respect of which such additional fees were paid.
**(7)** Any applicant may pay the additional fees under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fees is excessive.
**(8)** The examination of the protest referred to in sub-rule (7) shall be carried out by a Review Committee constituted by the Controller.
**(9)** The Review Committee constituted under sub-rule (8) shall examine the extent to which the protest is justified and shall accordingly order for the total or partial reimbursement of the additional fee to the applicant.
**(10)** Where the applicant has not paid the fees for the protest in accordance with clause (b) of sub-rule (5), the protest shall be considered not to have been made and the Searching Authority shall so declare.
**(11)** The protest fee shall be refunded to the applicant where the Review Committee referred to in sub-rule (8) finds that the protest was entirely justified.
**(12)** Where the international application contains the disclosure of one or more nucleotide or amino acid sequences and the sequences are not furnished in computer- readable text format, the Searching Authority shall send a notice to the applicant to submit the sequence listing in computer-readable text format and pay the late furnishing fee specified in the Fifth Schedule, within a period of one month from the date of such notice and if the applicant fails to comply with the notice, the Searching Authority shall search the international application to the extent that a meaningful search can be carried out without the sequence listing.

## 19C

**Time limit for establishing international search report:**

The Searching Authority shall establish the International Search Report and written opinion or, as the case may be, the declaration referred to in sub-rule (3) of rule 19B within a period of three months from the date of receipt of the search copy by the Searching Authority, or within a period of nine months from the date of priority, whichever expires later.

## 19D

**Transmittal of the International Search Report and written opinion:**

The Searching Authority shall transmit one copy of the International Search Report or of the declaration referred to in Article 17(2)(a) of the Treaty, and one copy of the written opinion established under Rule 43 bis.1 of the regulations under the Treaty, to the International Bureau and one copy to the applicant, on the same day.

## 19E

**Confidential treatment:**

All matters pertaining to international applications shall be kept confidential in accordance with the treaty and the regulations under the Treaty.

## 19F

**Indian International Preliminary Examining Authority:**

**(1)** The Patent Office, Delhi branch shall perform the functions of the International Preliminary Examining Authority under the Treaty in accordance with an agreement between the Indian Patent Office and the International Bureau.

**(2)** The Examining Authority referred to in sub-rule (1), shall establish-

**(a)** the International Preliminary Examination Report in respect of all international applications electing India as an International Preliminary Examining Authority;

**(b)** the International Preliminary Examination Report in respect of the demands filed by the nationals or residents of other countries in accordance with an agreement between Indian Patent Office and the International Bureau, upon being notified by the International Bureau;

**(c)** the International Preliminary Examination in respect of demands made by the nationals or residents of other countries not party to the Treaty or not bound by Chapter II of the Treaty, if the Assembly has so approves.

## 19G

**Period for making a demand:**

**(1)** The demand for international preliminary examination shall be made within the period specified in the Treaty or regulations under the Treaty.

**(2)** In case the demand is made after the expiry of the period specified in sub-rule (1), it shall be considered to have not been made and no International Preliminary Examination Report shall be prepared.

## 19H

**Fees payable to Examining Authority:**

The fees payable to the Examining Authority shall, in addition to the fees specified in the regulations under the Treaty, be the fees specified in the Fifth Schedule.

## 19I

**Manner of making a demand:**

A demand shall be made in accordance with the provisions contained in these rules, the Treaty and the regulations under the Treaty.

## 19J

**Processing of demands for International preliminary examination:**

**(1)** The Examining Authority, on receipt of the demand for international preliminary examination, if the Examining Authority is competent to conduct an international preliminary examination, shall assign the identification mark 'IPEA/IN' and shall notify the Applicant and the International Bureau.

**(2)** In case where the Examining Authority is not competent to conduct the international preliminary examination of the international application, it shall transmit the demand promptly to the International Bureau.

## 19K

**International Preliminary Examination Report:**

**(1)** Notwithstanding anything contained in the proviso to item (i) of sub-rule (2) of rule 24B, the Examining Authority shall refer the international application, in accordance with the provisions contained in the Treaty and the regulations under the Treaty, in the order in which the demand was received in the Examining Authority to an examiner or any other officer appointed under sub-section (2) of section 73 of the Act for preparing an International Preliminary Examination Report ordinarily within a period of three months but not exceeding four months from the date of such reference.

**(2)** Claims relating to inventions in respect of which no International Search Report has been established shall not be the subject of international preliminary examination.

**(3)** The Examining Authority, if considers that- (a) the international application relates to a subject-matter on which the Examining Authority is not required to carry out an international preliminary examination, and, decides not to carry out such examination; or (b) that the description, the claims, or the drawings, are so unclear, or the claims are so inadequately supported by the description, that no meaningful opinion can be formed on the questions of novelty, inventive step (non-obviousness), or industrial applicability, the Examining Authority shall not go into these questions and shall inform the applicant of this opinion and the reasons therefor.

**(4)** In a case where any situation referred to in clause (a) or clause (b) of sub-rule (3) is found to exist in connection with certain claims only, the Examining Authority shall indicate this fact in the International Preliminary Examination Report in respect of such claims, and for other claims, it shall establish the International Preliminary Examination Report.

**(5)** Where the Examining Authority finds that the international application does not comply with the requirement of unity of invention, in accordance with the provisions contained in Rule 13 of the regulations under the Treaty and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees, it shall issue a notice to the applicant:

**(a)** specifying at least one possibility of restriction which in the opinion of the Examining Authority, would be in compliance with the applicable requirement;

**(b)** specifying the reasons for which the international application is not considered as complying with the requirement of unity of invention;

**(c)** inviting the applicant to comply with the invitation within one month from the date of such notice;

**(d)** indicating the amount of the required additional fees to be paid in case the applicant so chooses; and

**(e)** inviting the applicant to pay, the protest fee within one month from the date of such notice, and indicate the amount to be paid, as specified in the Fifth Schedule.
**(6)** Any applicant may pay the additional fees under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fees is excessive.
**(7)** The examination of the protest referred to in sub-rule (5) shall be carried out by a Review Committee constituted by the Controller.
**(8)** The Review Committee constituted under sub-rule (7) shall examine the extent to which the protest is justified and shall accordingly order for the total or partial reimbursement to the applicant of the additional fee.
**(9)** The protest fee shall be refunded to the applicant where the Review Committee referred to in sub-rule (6) finds that the protest was entirely justified.

## 19L

**Period for establishing international preliminary examination report and its transmission:**
The period for establishing the International Preliminary Examination Report shall be:
**(i)** Twenty-eight months from the priority date; or
**(ii)** Six months from the period specified under Rule 69.1 of the regulations under the Treaty for the start of the international preliminary examination; or
**(iii)** Six months from the date of receipt by the Examining Authority of the translation furnished under Rule 55.2 of the regulations under the Treaty, whichever expires last.

## 19M

**Transmittal of the International Preliminary Examination Report:**
The Examining Authority shall transmit one copy of the International Preliminary Examination Report and its annexure, if any, to the International Bureau, and one copy to the applicant, on the same day.

## 19N

**Conditions for and extent of refund:**
The fee paid by the applicant may be refunded, waived or reduced to the extent and in accordance with the conditions specified in the Treaty or the regulations under the Treaty and the agreement entered between the Indian Patent Office and the International Bureau.

**Explanation:**
Rule 19 covers time limits, refusal grounds, partial examination, unity of Invention, deadlines and the refund rules for an application filed under PCT. The following table gives a clarity of the actions and the timelines as covered under Rule 19

| Action | Responsible Authority | Time Limit | Notes |
|---|---|---|---|
| Filing of Demand for IPE | Applicant routes it to IPEA (Indian Patent Office) | Within 3 months, but not exceeding 4 months from reference date | Demand must be in prescribed form with fee. |
| Check for ISR availability | IPEA | Before starting IPE | Claims with no ISR cannot be examined. |
| Refusal of IPE (if applicable) | IPEA | Anytime during IPE | If subject matter excluded OR description/claims unclear, IPEA issues notice with reasons. |
| Partial examination | IPEA | During IPE | If issue applies only to some claims mentioned in IPER; other claims still required to be examined. |
| Unity of invention objection notice | IPEA forwards it to the Applicant | 1 month from date of notice | Notice must specify restriction option, reasons, additional fee amount, and protest option. |
| Payment of additional fees (under protest, if desired) | Applicant | Within 1 month from notice | Applicant may submit reasoned statement if protesting unity objection or fee. |
| Review of protest | Review Committee (constituted by Controller) | After protest filing | Committee examines justification, orders refund (partial/full). |
| Refund of protest fee | Review Committee | After decision | If protest entirely justified then the protest fee is refunded. |
| Establishing IPER | IPEA | Latest of: (i) 28 months from priority date, OR (ii) 6 months from start of IPE OR (iii) 6 months from receipt of translation | Deadline for preparing IPER. |
| Transmission of IPER | IPEA forwards it to IB (WIPO) & Applicant | Same day of issue | One copy to IB, one to applicant. |
| Refund/Waiver/Reduction of fees | IPEA (as per PCT & Agreement with IB) | As applicable | Refund/waiver possible under PCT, Regs, and agreements. |

# 20

**International applications designating or designating and electing India:**

**(1)** An application corresponding to an international application filed under Patent Cooperation Treaty may be made in Form 1 under sub-section (1A) of section 7.

Explanation- For the purpose of this rule, "an application corresponding to an international application means" an international application as filed under Patent Cooperation Treaty which includes any amendments made by the applicant under Article 19 and communicated to Designated Office under Article 20 or any amendment made under sub-clause (b) of clause (2) of Article 34 of the Treaty: Provided that the applicant, while filing such application corresponding to an international application designating India, may delete a claim, in accordance with the provisions contained in rule 14.||.

**(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 authorised 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 Article 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; and

**(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;

**(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.

**Explanation:**

Rule 20 of the Indian Patent Rules, 2003, deals with international patent applications that designate or elect India under the Patent Cooperation Treaty (PCT). This rule governs the transition of a PCT patent application into the Indian patent system, specifying the mandatory actions and deadlines for the applicant to successfully pursue their patent in India.

Filing a National Phase Application: If you have filed a PCT application and designated India, you can file a corresponding national application in India using a specific form (Form 1). When filing in India (national phase entry), the applicant may delete a claim in accordance with Rule 14 of the Indian Patent Rules, which is done to streamline the prosecution and to reduce the financial burden on the applicant.

Inclusion of amendments:

Article 19 amendments: Amendments to the claims can be done after receiving the International Search Report (ISR). These are then communicated to the Designated Office (like India) under Article 20.

Article 34(2)(b) amendments: Amendments to the description, claims, and drawings made during the International Preliminary Examination stage.

Earlier to this, there was provision to accept the amendments as filed in International Phase Application, meaning thereby if the desired amendments in claims including addition and deletion are already filed with International Application, then the same amendments were accepted at India National Phase and there was no need to file amendment application in India and applicant could proceed directly with filing amended application.

Time Limit: You have a specific deadline to enter the Indian national phase. This deadline is 31 months from the earliest priority date of your international application.

Requirements at Filing: Before this deadline, you must:

1. Pay the required national fees.
2. If your international application was not originally filed or published in English, you must provide a verified English translation of the application. This includes the description, claims, drawings, and abstract.

Early Examination: Although the deadline is 31 months, you can request an earlier examination of your application by filing a separate request (Form 18) and paying the specified fee. This can help speed up the process.

Translations of Amendments: If you have amended your claims during the international phase (under PCT Article 19), you must also provide a translation of those amended claims and any related statements when you enter the Indian national phase.

Consequences of Non-Compliance: If you fail to file the required translations or other documents, the Patent Office may invite you to do so within a certain time frame. If you still don't comply, the amended claims or annexures may not be considered.

While complying with sub-rule (3), applicant should preferably use forms in Second Schedule before the Indian Patent 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 authorised 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) or sub-rule (2), the appropriate office shall invite the applicant to file the priority document or the translation thereof, as the case may be, within three months from the date of such invitation, and if the applicant fails to do so, the claim of the applicant for the priority shall be disregarded for the purposes of the Act.

**Explanation:**
If an applicant of an international application designating India has not complied with Rule 17.1(a) or (b) of the PCT Regulations (which deal with filing the priority document),then, the applicant must file the priority document with the Indian Patent Office before the deadline specified in Rule 20(4)(31 months). The applicant must file an English translation of the priority document, if the document is not in English. This translation must be duly verified by the applicant or their authorised person and must also be filed within the same Rule 20(4) time limit. The Patent Office will issue an invitation to comply (to file the priority document or its translation) in case the requirements are not met. The applicant then gets three months from the date of invitation to comply. If the applicant still does not comply, the priority claim will be disregarded under the Indian Patents 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 Treat and the regulations and administrative instructions made thereunder shall apply in relation to international applications.

**Explanation:**
The provisions in this Chapter of the Indian Patent Rules are meant to support and supplement, not replace, the PCT framework. If there is any conflict or inconsistency, , the PCT and its Regulations override Indian provisions for international applications.

# Chapter 4
# PUBLICATION AND EXAMINATION OF APPLICATIONS

## 24

**Publication of application:**

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

**Explanation:**

The application is published after eighteen months from the date of filing or the date of priority of the application whichever is the earlier date. After this 18-month period expires, the Controller will publish the application within 1 month in the Patent Office Journal. If the applicant makes a request for early publication, the Controller will publish the application within 1 month from the date of such request.

## 24A

**Request for publication:**

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

## 24B

**Examination of application:**

**1(i)** A request for examination under section 11B shall be made in Form 18 within forty-eight months from the date of priority of the application or from the date of filing of the application, whichever is earlier;

**(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;

**(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;

**(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 section 11B, of the applications filed before the 1st day of January, 2005 shall be 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)** Where the request for examination has been filed under sub-rule (1) and application has been published under section 11A, the Controller shall refer the application, specification and other documents related thereto to the examiner and such reference shall be made in the order in which the request is filed:

Provided that in case of a further application filed under section 16, the order of reference of such further application shall be the same as that of the first mentioned application:

Provided further that in case the first mentioned application has already been referred for examination, the further application shall have to be accompanied by a request for examination, and such further application shall be published within one month and be referred to the examiner within one month from the date of such publication.

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

**(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 statement of objections, along with any documents as may be required, shall be issued by the Controller to the applicant or his authorised agent within one month from the date of disposal of the report of examiner by the Controller: Provided that where the request for examination was filed by a person interested, only an intimation of such examination may be sent to such person interested.

**(4)** Reply to the first statement of objections and subsequent reply, if any, shall be processed in the order in which such reply is received.

**(5)** The time for putting an application in order for grant under section 21 shall be six months from the date on which the first statement of objections is issued to the applicant to comply with the requirements.

**(6)** The time for putting an application in order for grant under section 21 as prescribed under sub-rule (5) may be further extended for a period of three months on a request in Form 4 for extension of time along with prescribed fee, made to the Controller before expiry of the period specified under sub-rule (5).

**Explanation:**

1. A request for examination (RFE) is made on Form 18 within forty-eight months (amended to thirty one months) from the date of priority of the application or from the date of filing of the application, whichever is earlier. If secrecy directions are imposed (Sec. 35) on the application, then RFE is made within 48 months(amended to 31 months) or 6 months from revocation of secrecy, whichever is later. For a divisional application filed under Section 16, RFE is made within 48 months(amended to 31 months) from priority of the parent application OR 6 months from filing of divisional, whichever is later. For the application filed before 1 Jan, 2005 the applicable period for making RFE will be:The old time limit under Section 11B (pre-2005 law), OR forty-eight months, under the amended Rules (post-2005), whichever is later.
2. Once the application is published and request for examination is made, the Controller refers the application to the examiner. In case of Divisional application, the RFE follows the order of the parent application. If the parent application is already examined, then the divisional must also be accompanied with RFE and gets published within 1 month, then referred within 1 month.
3. The Examiner must submit report ordinarily within 1 month, 3 months from date of reference.
4. The Controller must ordinarily dispose of examiner's report within 1 month.

5.The First Statement of Objections is issued to applicant within 1 month of Controller's disposal of examiner's report.If RFE is filed by a "person interested," only intimation is sent.
6. Reply to the first statement of objections and subsequent reply shall be processed in the order in which such reply is received.
7. Time for Putting Application in Order for Grant (Sec. 21) is 6 months from the date of FER issuance, which is extendable by 3 months (Form 4 + fee) if request is made before expiry of initial 6 months.

# 24C

**Expedited examination of applications:**

**(1)** An applicant may file a request for expedited examination in Form 18A along with the fee as specified in the first schedule only by electronic transmission duly authenticated within the period prescribed in rule 24B on any of the following grounds, namely:-

**(a)** that India has been indicated as the competent International Searching Authority or elected as an International Preliminary Examining Authority in the corresponding international application; or

**(b)** that the applicant is a startup.

**(2)** A request for examination filed under rule 24B may be converted to a request for expedited examination under sub-rule (1) of rule 24C by paying the relevant fees and submitting requisite documents as required under sub-rule (1).

**(3)** Except where the application has already been published under sub-section (2) of section 11A or a request for publication under rule 24A has already been filed, a request for expedited examination shall be accompanied by a request for publication under rule 24A.

**(4)** Where the request for expedited examination does not comply with the requirements of this rule, such a request shall be processed in accordance with the provisions contained in rule 24B, with an intimation to the applicant, and shall be deemed to have been filed on the date on which the request for expedited examination was filed.

**(5)** The Controller shall refer the request for expedited examination along with the application and specification and other documents to the examiner, in respect of the applications where the request for expedited examination has been received, in the order of filing of such requests. Provided that a request for expedited examination under this rule filed by a startup shall not be questioned merely on the ground that the startup ceased to be a startup after having filed an application for patent due to the lapse of more than five years from the date of its incorporation or registration, or the turnover subsequently crossed the financial threshold limit, as defined.

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

**(7)** The period within which the Controller shall dispose of the report of the examiner shall be one month from the date of receipt of such report by the Controller.

**(8)** A first statement of objections along with any document, if required, shall be issued by the Controller to the applicant or his authorised agent within fifteen days from the date of disposal of the report of examiner by the Controller.

**(9)** Reply to the first statement of objections and subsequent reply, if any, in respect of an application where the request for expedited examination was filed, shall be processed in the order in which such reply for such application is received.

**(10)** The time for putting an application in order for grant under section 21 shall be six months from the date on which the first statement of objections is issued to the applicant.

**(11)** The time for putting an application in order for grant under section 21, as prescribed in sub-rule (10) may be further extended for a period of three months on a request for extension made in Form 4 along with the prescribed fee, made to the Controller before the expiry of the period specified under sub-rule (10).
**(12)** The Controller shall dispose of the application within a period of three months from the date of receipt of the last reply to the first statement of objections or within a period of three months from the last date to put the application in order for grant under section 21 of the Act, whichever is earlier: Provided that this time limit shall not be applicable in case of pre-grant opposition.
**(13)** Notwithstanding anything contained this rule, the Controller may limit the number of requests for expedited examination to be received during the year by way of a notice to be published in the official journal.

**Explanation:**
Rule 24C covers the expedited examination for startups and PCT applications, designating India as ISA/IPEA. This rule explains about shortened timelines at each stage, though the Controller has the power to limit expedited requests accepted per year by issuing a notice which will be published in the official journal.
1. An applicant may file request for expedited examination on Form 18A along with the fee as specified in the first schedule only by electronic transmission duly authenticated within thirty one months(Key changes introduced under the Patents Amendment Rules 2024 includes the revised Due Date for Request for Examination. The deadline for filing a Request for Examination (RFE) in a patent application has been reduced from 48 months to 31 months from the earliest priority date) on any of the following grounds:
(a) If India is indicated as the ISA (International Searching Authority) or IPEA (International Preliminary Examining Authority) in a corresponding PCT application.
(b) The applicant is a startup.
2. Request for examination (Form 18) under Rule 24B can be converted into an expedited request under Rule 24C, by paying the relevant fee and submitting the required documents.
3. The request for expedited examination must be accompanied by a request for publication (Form 9), in case the patent application has not published.
4. If the request for expedited examination doesn't meet requirements, it will be treated as a normal examination request (Rule 24B) with an intimation to the applicant. The filing date of the expedited request will be considered the filing date for normal examination.
5. The Controller shall refer expedited requests to the examiner in the order received. Startup request for the expedited examination will not be disqualified even if the applicant later ceases to be a startup (beyond 5 years of incorporation or exceeding turnover limits).
6. Timelines

- Submission of report by the examiner :One month but not exceeding two months
- Controller disposes examiner's report: within 1 month of receiving it.
- First statement of objections (First Examination Report, FER) issued by the Controller to the applicant: Within 15 days of disposal of report by the examiner.
- Reply to objections: processed in the order received.
- Time to put in order for grant (Sec. 21): 6 months by the applicant is 6 months from the date of objections received, which is further extendable by 3 months by making a request on Form 4 and submitting the required fee.
- Controller's final disposal of application: within 3 months from receipt of last reply, OR last date for putting application in order for grant, whichever is earlier.
- (Not applicable if pre-grant opposition is filed.)

| Stage | Normal Examination (Rule 24B) | Expedited Examination (Rule 24C) |
|---|---|---|
| Form | Form 18 (Request for Examination) | Form 18A (Request for Expedited Examination) |
| Mode of Filing | Physical or electronic | Electronic only |
| Eligibility | Any applicant | Only if:<br>(a) India was chosen as ISA/IPEA in PCT application, OR<br>(b) Applicant is a startup |
| Conversion | N/A | Form 18 request can be converted into Form 18A by paying the fee and submitting the required documents |
| Publication requirement | Not mandatory with RFE | If not already published, must be accompanied by Form 9 (request for publication) |
| Reference to Examiner | Applications referred in the order of filing of examination requests | Expedited requests are expedited, in order received |
| Examiner's Report (Sec. 12(2)) | Within 3 months but not exceeding 6 months | Within 1–2 months |
| Controller disposes report | Within 1 month of examiner's report | Within 1 month of examiner's report |
| First Examination Report (FER) | Issued ordinarily within 6 months from RFE date | FER issued within 15 days after Controller disposes examiner's report |
| Reply to FER | 6 months from FER date (extendable by 3 months) | 6 months (extendable by 3 months) |
| Processing replies | Processed in order of receipt | Processed in order received |
| Final disposal by Controller | No fixed statutory deadline; depends on workflow | Within 3 months from last reply or last date to put in order for grant (whichever earlier) |
| Limit on requests | No limit | Controller may cap the number of expedited requests per year (via Official Journal) |
| Startup relaxation | N/A | Startup request not invalidated if applicant later ceases to be a startup (beyond 5 years / turnover limit crossed) |

Normal vs. Expedited Examination of Patent Applications

## 25

**Identification of published applications:**

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

**Explanation:**

When a patent application is published under section 11A(2) (Early publication) or section 11A(5) (early publication on request), the published application is given an identification mark — The application number will be followed by the letter "A".

## 26

**Request for withdrawal:**

A request for withdrawing the application under sub-section (4) of section 11B shall be made in Form 29.

## 27

**Inspection and supply of published documents:**

After the date of publication of the application under section 11A, the application together with the complete specification and provisional specification, if any, the drawing, if any, the abstract and any other document 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.

**Explanation:**

Rule 27 ensures transparency after publication. The application remains confidential before publication. Once a patent application is published , the following documents become open to public inspection at the Patent Office:

1. The application
2. The complete specification (and provisional, if filed)
3. Any drawings filed
4. The abstract
5. Any other documents filed with respect to the application

In order to inspect the application, anyone can make a written request to the Controller by paying the prescribed fee. The copies of the documents can also be obtained by paying the fees mentioned 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 subsection (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 preferred 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.
**(6)** The hearing may also be held through video-conferencing or audio-visual communication devices: Provided that such hearing shall be deemed to have taken place at the appropriate office.
Explanation.– For the purposes of this rule, the expression “communication device” shall have the same meaning as assigned to it in clause (ha) of sub-section (1) of section 2 of the Information Technology Act, 2000 (21 of 2000). (7) In all cases of hearing, written submissions and the relevant documents, if any, shall be filed within fifteen days from the date of hearing.

**Explanation:**
Rule 28 gives the applicant a fair chance to contest prior art objections, amend claims, and be heard before refusal. It also provides flexibility by allowing virtual hearings and written submissions. If the Controller finds out that the invention (as claimed) has already been published (prior art under Section 13(1)(a) or 13(2)), he will communicate the gist of objections and their basis to the applicant. The applicant is given an opportunity to amend the specification. The applicant may contest the objections, or refile the specification with observations (with/without amendment). If the applicant requests a hearing, it must be done at least 10 days before the expiry of the Section 21 period (i.e., the deadline for putting the application in order - The time for putting an application in order for grant under section 21 is six months from the date on which the first statement of objections is issued to the applicant to comply with the requirements.). The Controller may allow a shorter period if justified. If the applicant requests a hearing within 1 month from the communication of objections, or if the Controller finds it justified, a hearing date will be fixed, considering the time left to put the application in order. Applicant is given 10 days’ notice (or shorter if reasonable). Applicant must confirm whether he will attend. After hearing (or if the applicant doesn’t attend), the Controller may allow/require specific amendments, or refuse the patent if amendments are not made within the fixed time.
Hearings may also be conducted via video-conferencing / audio-visual communication devices. Such hearings are deemed to have taken place at the appropriate Patent Office. In all hearings, written submissions & relevant documents must be filed within 15 days from the date of hearing.

# 28A

**Procedure in relation to consideration of report of examiner under section 14:**
In case the applicant contests any of the objections communicated to him, the procedure specified under rule 28 may apply.

**Explanation:**
Rule 28A explains the procedure when the applicant contests the examiner's objections.

# 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-section (1) of section 13 is outstanding, the Controller may postpone the grant of patent and allow a period of two months for removing the objection.

**Explanation:**
During examination under Section 13(1)(b), if it is found that the invention (as claimed) is already claimed in another patent application that has an earlier filing/priority date, the applicant is informed of this objection and the applicant is given an opportunity to amend his specification (to avoid overlap/double claiming).If the applicant's specification is otherwise ready for grant but this objection under Section 13(1)(b) remains, the Controller may postpone the grant of patent and give the applicant 2 months to remove the objection.

# 30

**Amendment of the complete specification in case of anticipation:**
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-rule (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.
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.

**Explanation:**
If the applicant requests at any time, or if the Controller is satisfied that the objection has not been removed within the period referred to in sub-rule (2) of rule 29, the Controller will fix a date for hearing. The applicant must be given at least 10 days' notice of the hearing date and the applicant must promptly notify the Controller whether he will attend. After hearing (or if the applicant chooses not to attend), the Controller may specify or permit amendments to the specification to his satisfaction. The Controller may also direct that a reference to the other (earlier) specification be inserted in the applicant's specification. If the amendment is not made/agreed to within the fixed time, the Controller may refuse to proceed with the grant.

## 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……."

**Explanation:**

If the Controller directs to add a reference of another specification in the applicant's complete specification, The reference should be inserted after the claims in the form as prescribed in Rule 31.

## 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.

**Explanation:**

If it appears to the Controller that there is a risk of claim infringement of another patent because of the applicant's invention, then the applicant is informed and the procedure as prescribed in Rule 29 will be followed.

## 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 subsection (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…… "

**Explanation:**

If the Controller directs to add a reference of another patent in the applicant's complete specification, The reference should be inserted after the claims in the form as prescribed in Rule 33.

## 34

**Manner in which a claim under section 20(1) shall be made:**

**(1)** A claim under subsection (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.

**Explanation:**

A claim for substitution of applicant under Section 20(1) of the Patents Act (i.e., when a person other than the original applicant becomes entitled to the patent) must be made in Form 6. The claimant must produce the original assignment/agreement showing transfer of rights, or an official copy or notarized copy of such document. The Controller may also call for additional proof of title, or written consent from the parties involved.

## 35

**Manner in which a request may be made under section 20(4):**

**(1)** A request under subsection (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.

**Explanation:**

A request for the substitution of the legal representative in case of the death of a joint applicant under Section 20(4) of the Patents Act must be made in Form 6. The request must be accompanied by:

- Proof of death of the joint applicant (e.g., death certificate).
- A certified copy of:

(1) The probate of the will of the deceased, OR

(2) Letters of administration in respect of the estate, OR

(3) Any other document proving that the person giving 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.

**Explanation:**

Rule 36 provides the mechanism for resolving disputes among joint applicants (for example, when there's disagreement over how the patent rights should be exercised). The Controller issues the directions after hearing all parties.

## 37

**Numbering of applications on the grant of patent:**

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.

## 38

**[Omitted ]**

# Chapter 5 (Omitted)

# EXCLUSIVE MARKETING RIGHTS

**Rules 39 to 54 [Omitted by Patents (Amendment) Rules, 2005]**

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# Notes

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