

KARNATAK



UNIVERSITY

DHARWAD

(University with Potential for Excellence)



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## PATENTS & COMMERCIALIZATION POLICY

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2021

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## **PREAMBLE**

The Bombay legislature of the erstwhile Bombay Presidency established Karnataka University through the Karnataka University Act 1949 and it became a statutory University on 1<sup>st</sup> March 1950. It has now 52 P.G. Departments and 12 Study Chairs and offering courses in the faculties of Arts, Commerce, Education, Law, Management, Science and Technology and Social Sciences. Faculty, staff and students of the University are engaged in Research & Development work of diverse nature. Many of these R &D activities result in the evolution of intellectual property (IP) in the form of Patents, know-how, copyrights, designs, devices, methods, specimens and other inventions, which can be commercially exploited either with or without registration under the Patents Act / Copyright Act. Such a commercial exploitation can be of considerable socio-economic benefit to country in general and University in particular.

The University, therefore, encourages the protection and licensing of such Patents which can be effectively utilized for commercial exploitation. This would yield financial returns to the University, and partially support the R&D activities.

Patents could result from research supported by the University/industry/independent research organizations/ different funding agencies /State Govt /Central Govt etc. Funded research may impose contractual obligations on the University with respect to ownership/licensing of intellectual property, which have to be agreed upon clearly and explicitly at the time the contracts are entered into. This document states the policy of the University with respect to protection, ownership and licensing, of Patents that is generated with/without external funding.

The present policy facilitates protection of the right of the Inventor(s) of the University i.e. faculty/students/project staff/ supporting staff etc through the option of Intellectual property protection on a novel work or to keep it in public domain as they may deem fit. In alignment with the Vision and Mission of the University, the policy favors outreach of the novel technologies developed at the University. At the same time, it motivates the faculty, students and researchers of the University for patenting their novel and applied inventions and initiate technology transfer.

Patent law is the branch of intellectual property law that deals with new inventions. Traditional patents protect tangible scientific inventions. Inventions arising from the creative work of human beings acquire considerable commercial value, in view of the possibility of their use by large sections of the society, not only within the country but also in other parts of the World. Patent is one of the ways through which the scientific inventions which have a potential for industrial application are being protected and thus promoted. In India, the law relating to Patents is contained in the Patents Act, 1970. This Act has been amended several times to meet the challenges of changing times and also to meet India's obligations under the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) which forms a part of the Agreement establishing the World Trade Organization (WTO). The Patents Act, 1970 is now conceived as fully compliant with India's obligations under the TRIPS Agreement of the WTO. Further, as regards the Rules framed under the Act, earlier the Patents Rules, 1972, which were in place for close to three decades, were substituted by the Patents Rules, 2003. The Patents Rules, 2003 have also been amended from time to time in order to keep them in line with the international trends and requirements. The importance of Patents has increased tremendously over last few decades which is evident from the fact that every organization is now creating its own strong Patent portfolio. It is thus important to know the advantages involved in getting a Patent and also as to how does the Patent benefit an Inventor.

The objective is to develop among the researchers a greater awareness about the Patent law in India and spell out the procedural mechanism involved in obtaining a Patent, besides explaining the concepts of Assignment, Licensing of Patents etc.

## **OBJECTIVES**

The objectives of this policy document are to

- Foster, stimulate and encourage creative/inventive activities in the areas of sciences, humanities and technology.
- Protect the legitimate interests of faculty/ scholars /students of the University and the society and to avoid as far as possible conflict of opposing interests.
- Lay down a transparent administration system for the ownership control and assignment of Patents and sharing of the revenues generated by the Patents generated and owned by the University.

## **OWNERSHIP**

### **Inventions, Designs, Fabrications and other Creative works**

- (i) University shall be the owner of all Patents unless specific agreements/contracts are entered into by the University as described below, prior to the creation of the Patent, with an agency funding the research leading to the creation of the Patent, or with a temporary employee or student.
- (ii) Specific provisions related to Patents made in contracts governing the collaborative activity shall determine the ownership of Patents among non sponsored or collaborative research or consultancy assignment. The MOU/ contract for such a project may require (a) joint ownership of such Patent between KUD and the sponsor, or (b) full ownership of such Patent by the sponsor or (c) exclusive licensing of such Patent owned by the University to the sponsor or its nominees, or (d) a separate agreement / contract to be entered into a later date consequent to creation of such Patent for exclusive / non-exclusive ownership / licensing of the Patent. In all these cases, the contract / agreement / MOU will specify conditions such as right of first refusal to such Patent if applicable, the fee/royalty payable for ownership / licensing of such Patent as applicable, and also specify how the patent filing, registration and maintenance costs will be borne by the sponsor and / or the University. When faculty / staff enter into an agreement for undertaking sponsored research or consultancy, they are required to assist the University to determine which of the above options is applicable to the particular Project given the nature of research proposed to be undertaken, the degree to which the facilities are leveraged, and the amount of funding provided.
- (iii) If a patent is created as a result of a sponsored research project or consultancy assignment/ project where the contract / MOU / agreement does not specify the ownership and / or licensing of such patents, university and the sponsor shall jointly own the patents. University may however, if it deems appropriate, enter into a separate agreement / contract with the sponsor for licensing the patents to it, which will specify payment of additional fees / royalty.
- (iv) An employee of university who is on sabbatical or other forms of long leave, or a student who is on leave or is permitted by university to be employed in an organization while being registered as a student, and who is engaged in research in an/the organization with the permission of University, will be permitted to directly negotiate with the organization, the terms of any patents sharing that is generated, in its entirety and without any use of University resources, during the duration of the engagement in that organization. However, any revenue that is received by the employee/student subsequently while on duty at University, as royalty / fees for the patents

generated as above, shall be subjected to the prevailing patents revenue sharing norms of University. Patents developed by the said employee or student during this period without involvement of creators who are employees or students of University will be outside the purview of this policy. However, in case the patents so created by the employee/student, during the leave period as described above, is based in part or full on prior patents developed at University, the employee/student is required to inform University and enable University to enter into a licensing agreement with the organization in which the employee/student is temporarily engaged.

## **COPYRIGHTABLE WORKS**

Ownership of copyright of all copyrightable work including books and publications shall rest with the creator of the original work with the following exceptions:

- i) If the work is produced during the course of sponsored and/or collaborative activity, specific provisions related to Patent made in contracts governing such activity shall determine the ownership of the copyright.
- ii) University shall be the owner of the copyright of work, including software, created with significant use of University resources.
- iii) University shall be the owner of the copyright on all teaching material developed as part of any of the academic/distance learning programs of University. However, the creator(s) shall have the right to use the material in her/his professional capacity.

## **Trade Mark(s) / Service Mark(s)**

Ownership of trademark(s), service mark(s) logos created for University shall be with the University. In cases of all Patents produced at the University, the University strongly desires to retain a non-exclusive, free, irrevocable license to copy/ use the Patent for teaching and research purposes only, consistent with confidentiality agreements entered into by the University. This is to enable the University to benefit from Patent created by its staff and students for carrying out its teaching and research functions.

## **EVALUATION AND MANAGEMENT OF PATENT**

The patent cell at University is responsible for evaluating, protecting, marketing, licensing and managing the patents generated at University. University mandates disclosure of all potential patents / Inventions / Innovations generated (conceived or reduced to practice in whole or in part) by members of the faculty or staff (including research staff, doctoral students, students and visiting scholars) of University in the course of their University related activities. University identifies the relevant statutory and other mechanisms not limited to Patent, Copyright, Trademark, Design Rights, Integrated Circuit, Plant Varieties and rest towards registration. Disclosure enables prompt action by University to appropriately protect and disseminate the research activities occurring at University. The creators of the patents shall thus provide all the necessary information to University Patent Cell in writing to enable it to determine whether University desires to own and manage the patents. An Invention will typically be patented by University if it has ultimate commercial motivation and viability, even if it is not in the immediate future. If University decides not to own and manage the patents, it shall permit the creator(s) to file patents and protect the patents on their own. However, share of University in revenue resulting from the employee / student from licensing from such patents will be determined as described in Section 9. In the case of patentable patents, it is essential that patent protection is filed before publication or disclosure in any other form in the

public domain of the patentable patents. The Patents Committee will examine the patents application and will then make specific recommendations regarding Patentability/Registration of the proposal by University. The committee may seek the assistance of experts for this purpose. In all these endeavors confidentiality of the patents shall be strictly ensured. In case the contract / agreement / MOU with a sponsor specifies that the sponsor will manage the process of filing of patents and bear the associated costs, the creators will provide information to the Patent Cell / Office of each such filing / application. Details of the invention need not be provided in such cases in the interest of confidentiality, if so desired. Progress of the application through various stages, such as Patent Cooperation Treaty (PCT), national phase, etc will be informed to the Patent Cell / Office by the creators as and when the creators become aware of such progress.

## **REGISTRATION OF PATENTS/COPYRIGHTS**

### **Filing of Applications in India**

Creators of the know how/designs/ instruments/ devices/ processes/ specimens and other such patents, who want to get patent(s) for the patentable patents are required to make an application for the purpose to the co-coordinator/Head, Patent cell as per the procedure specified by University at the time. In case, a sponsor of the research leading to the patents has contractually undertaken the responsibility of filing of applications, the creator may interact with the sponsor for the filing, after informing the Patent Cell / Office of the same. The creator is required to keep the Cell / Office informed of the progress of the application as it goes through various stages. The details of the application such as title, names of inventors, etc must be provided, although the invention details need not be provided as long as the details are not public knowledge in the patenting process. Creator(s) are encouraged to file a provisional patent as soon as possible in order to protect their rights to the patents. If the creator(s) can pay for the cost of provisional filing from (a) the funds of the research project resulting in the patents, or (b) the professional development fund (PDF) of the creator(s), or (c) personal financial resources of the creator(s), the permission for filing of provisional patent will be given automatically before evaluation of the application made by the creator(s) by the Patents Committee. In such cases, the technical details of the invention need not be provided to the Patent Cell at this stage in the interest of confidentiality. However, should University after due evaluation decide not to manage the patents, the provisional application will lapse, unless the creator(s) decide to take up the subsequent stages on their own. In such cases, University will waive its rights to the ownership of the patent rights. If University decides to jointly or fully own and manage the patents, it will bear all costs related to filing and protection after the date on which it decides to do so. In case, the creator(s) paid for the provisional filing from personal financial resources or PDF, these costs will be reimbursed after University decides to own and manage the patents. Patents related information will either not be disclosed at all, or be provided on a need-to-know basis to certain employees of University. All University employees associated with any activity of University shall treat all such patents-related information, which they may have access to as part of their official duties, as confidential. Such confidentiality shall be maintained till such time as required by University or by the relevant contract, if any, between University and concerned parties, unless such knowledge is in the public domain or is generally available to the public.

### **Filing of Applications in Foreign Countries**

Filing of Applications in Foreign Countries University may consider requests for registration of Patents in foreign countries, based on the merit of the patents. Typically, the process to be followed in such cases is the filing of a provisional application, detailed evaluation of the commercial

potential of the patents in the countries proposed for filing, filing of PCT application in case such potential is present, followed by national phase filing in the selected countries. During the time before the process reaches the national phase, the commercial potential will be continually assessed, and if at any time it appears that the commercial potential in a foreign country appears to be low, University may decide to not file in the particular country. During this period, the creator(s) are also encouraged to apply for financial support for international filing being provided by several ministries to public institutions. If University decides not to file such a patent in any foreign country, University may require that the patent be filed in the name of University without the requirement payment of fees or in its sole discretion, license the rights for the patents in that country to the creator(s) and permit the creator(s) to protect the patents in that country either on their own or in partnership with a sponsor. Any revenue accruing to the creator(s) as a result of exploitation of the rights licensed to the creator(s) in that country will be subject to the rules for sharing of revenue with University that are applicable to the creator(s) as per their employment / enrollment contracts. The creator(s) may seek reimbursement of the costs borne by them for protection of the patents in that country from the revenue prior to sharing with University. In case the patenting costs are borne by the sponsor of a research project as agreed upon in the contract / agreement, the Patent Cell only needs to be kept informed of the progress of the international patent application(s) through various phases such as PCT, national phases, etc. The sponsor may choose any legal firm of their choice for the filing. If University takes up the filing, the creator(s) are required to engage one of the legal firms approved for filing from time to time.

## **RENEWAL OF PATENTS**

University will pay the Patent Fees for the first seven years in all cases where the patent is taken by University. If it is a joint patent with a sponsoring agency the patenting costs may be equally shared. If the patent has been commercially exploited within the first seven years, University shall pay the Patent Fees for the remaining period of the life of the patent. If the patent has not been commercially exploited within the first seven years, University and the creator(s) shall share the subsequent installments of renewal fees on a 50:50 basis. The creator(s) are permitted to pay their share of the costs from their Professional Development Fund (PDF). If the creator does not show interest in such renewals, University can either continue maintenance of the patent by paying the fees for its full term or withdraw application for Patent protection at its discretion.

## **CONFIDENTIALITY OF PATENT**

Every creator in the group as well as everyone involved in the protection process will not disclose the details of the patents to any person/organization without prior written permission of University. In case of thesis and other such written documents containing details of patentable patents, all measures to avoid attracting the public disclosure clause leading to denial of patent may be taken by creators. It is best if the creators make provisional patent filings before documenting the details of the patents in theses, papers and other documents.

## **REVENUE SHARING**

Except as otherwise provided in this policy, the following scale would apply to apportion, among the Inventor(s) and the University, any Technology Transfer Fees, Lump sum payments, and Royalty(ies) received through the Technology Transfer, Licensing, and Commercialization efforts of the University-owned patent, on a half yearly basis in the months of October and April

of each financial year. For all Revenues (Technology Transfer Fees plus Lump sum payments plus Royalties) up to Rs. 50 Lakhs, a 60/40 ratio may be used with 60% being in favour of the Inventor(s) and 40% to the University after deducting the expenses involved in patents protection and Technology Transfer if any.

### **For all Revenues in excess of Rs. 50 Lakhs**

For the first Rs. 50 lakhs a 60/40 ratio as above will be used.

For the amounts in excess of 50 Lakhs, 10% of the Revenues in excess of Rs. 50 lakhs will be remitted as Overheads to the University. To the balance amount a 60/40 ratio will be used with 60% being in favour of the Inventor(s) and 40% to the University.

The University may at times accept equity in the Licensee Company as part of the license fee. The inventor's share in such equity granted to the University shall be decided on a case-by-case basis.

In the event of any inconsistency with national legislation or government policies concerning patent revenue sharing, the respective legislation or government policies shall prevail.

**Apportionment amongst Individual Inventors:** Where more than one Inventor is involved, initial responsibility for agreeing to the division of the Inventors' share of revenue amongst them shall lie with those Inventors.

Cessation of employment either by resignation, retirement, or completion of project/ course, under normal circumstances, will not affect an individual's right to receive a share of "Royalty(ies)", provided the patent was generated during the due course of their employment or association with the University. Such cessation shall not also absolve the University Personnel from their obligations towards confidentiality or the procurement/registration of patent in so far as executing necessary documents and/or assisting attorneys/patent agents of the University towards the objectives of the University are concerned.

In the case of the death of the Inventor, any due share of the revenue will be paid to the legal representatives of the deceased.

### **Exception in case of Patent unrelated to official work**

Creator(s) may apply to University for permission to patent/license know-how to organizations by themselves, when such patents are not related to the official duties and roles of the creator in University. Such patents will typically be in an area totally unrelated to the professional expertise of the creator for which University has employed him/her. Patents Committee will examine the proposal and recommend whether or not the request by the creator(s) can be acceded to. If on the recommendations of the Committee the Director permits the creator(s) to own / protect / license the patents independently, the creators may be permitted to be the sole beneficiary of all earnings from such patents and no amount therefrom will be payable by the creator(s) to University Copyright

All Ph.D Theses are to be copyrighted with a copyright note: © KARNATAK UNIVERSITY, DHARWAD (year). All rights are reserved. The technical reports, review works, M.Sc. dissertations may also be copyrighted, if the author wishes to copyright.

(b) While copy righting the thesis, it is the responsibility of the creator to ensure that the contents do not violate any copyright rules. If any materials including diagrams, tables, schemes, text etc are reproduced from any other copyrighted work, prior permission is to be obtained by the creators from the owner of the copyright document from where the material is taken.

(d) If information from some other sources are included, appropriate acknowledgement has to be given to this source, as per copy right law.

### **(a) Exceptions**

(i) The ownership of the copyrights by University in no way deprives the claims of the creators / authors to publish the contributions in scholarly and intellectual work, and their authority to improve, publish and propagate the work. When a journal that accepts a paper submitted by an employee/student requires copyright for the paper to be given to them before publishing the said paper, the employee/student may do so.

(ii) The university may waive ownership of copyrights it owns in favour of the author(s), contributor(s) on request

(iii) Students and scholars may be allowed ownership of the copyrights to their works provided

- they do not result from works for which they had received financial or supervisory support of any form from or through University
- the work does not include any material generated entirely or partially with the help of University facility or ongoing research programme or the intellectual input of any employee of University.

## **PROCEDURE FOR LICENSING AND COMMERCIALIZATION**

The University, through its Patent Cell, or its agents, or the creator(s) may approach external agencies for licensing of Patent owned by it. All agreements shall be signed by the Coordinator/Head of Patent cell and the creator(s) of the Patent being transferred, on behalf of the University.

In case of Patent involving more than one creator, a person among the creator(s) shall be identified by the creators, for Patent protection. At this stage, all members of the group of creators shall sign a revenue sharing agreement for the Patent being transferred. This revenue sharing agreement may be modified at any time on mutual consent among the creators and intimated to the Coordinator/Head of Patent cell. Any conflict with regard to revenue sharing among the creators will be resolved by the University which is binding on all the creators of the Patent.

### **Procedure for Licensing**

An open patent policy will be pursued for all patents including patents/patent applications that are older than five years and have been published. The open license policy enables the interested industries to commercialize university patents without upfront payment of fees as would be required in a Trial licensing policy. Interested companies need to register at the university portal before embarking on such a process and get a permission to do so. Such permission in the form of a non-exclusive license agreement will be granted at the earliest of such a request being received. If such a company decides they would need to engage with university to take the evaluation/commercialization forward they will have to sign a suitable licensing agreement.

### **Patent generated from University funded projects**

**Trial Licensing:** The companies/organizations interested in seeking a trial license, may approach university for a Trial Licensing agreement. A exclusive or non-exclusive trial license

can be obtained by paying a nominal fee for a certain period of time, to be decided on a case by case basis but limited to a maximum period of 12 months before finalizing on the terms and conditions of the full license agreement.

### **The trial license evaluation period may be as follows**

When the patent is yet to be verified: 1 to 12 months.

When the patent is tested but yet to be scaled: 6 to 12 months

When the patent has been tested (high TRL) and is meeting industry requirements: 1 to 6 months

The company/organization licensing the patent, in addition to the fee associated with the trial licensing, will bear the cost of faculty time, the cost of preparing any material and the cost of shipping/transportation in addition to other contingent costs that may be required to execute the Trial license at university. The costing details shall be provided on a case to basis.

The Company shall at the end of the Trial License period provide university a detailed evaluation report of the patent.

As and when such a Trial licensing opportunity provides itself, university faculty members will have to commit to spending a fraction of their time towards supporting the licensing activity if they wish to receive 60% of the licensing fee as per the university patent Policy. University faculty can choose to not participate. In such a case they will not receive the 60% due to them as per the patent policy during trial licensing. If after the trial licensing period there is successful licensing then faculty will be entitled to 20% of the revenue generated during the Trial licensing period.

If the Company wishes to enter into an exclusive license agreement post the Trial evaluation period, it shall submit to university a 5-year business plan. Post licensing, university will monitor the ability of the company/organization to Commercialize the patent licensed against the plan submitted. If university feels that the company/organization is not able to Commercialize the patent, then the university may revoke the exclusive license.

**Full License:** If more than one company/organization approaches university for the same patent before an exclusive license is granted to a particular company/organization, a non-exclusive license may be considered or a bidding process may be floated and the highest bidder shall get the priority. The aforesaid option shall be exercised solely by university on a case by case basis. If university decides on the bidding option, the companies will be given an opportunity to participate in the bidding only if they qualify to meet the parameters such as the technical expertise, financial capabilities, infrastructure, capacity to develop and commercialize the patent. The required parameters for qualifying to participate in the bidding process will be uploaded on university website and if required through other public sources on a case by case basis. A technical committee appointed by the Vice-Chancellor will evaluate the ability of interested companies to participate based on the parameters above and/or additional parameters provided on cases by basis and this committee has the discretion to disqualify those that they may deem to not meet the required criteria.

### **Patents generated from projects supported by funding agencies**

With regard to research conducted with substantial support from external funding agencies, ownership of patent shall be determined as per the terms and conditions in the agreement signed between the University and external funding agency.

In the absence of a specific agreement between the University and the external funding agency that is providing substantial support for research, the University and external funding agency shall

resolve the issue of joint ownership of copyright for sharing the benefits in the proportion of 60:40 for the university and external funding agency. However, in the event of commercialization of these research outputs, the revenue shall be shared similarly with the University and external agency as per the agreement/resolved.

### **Sole and Joint patent generated from industry funded projects**

University will first offer the Industry the right to seek a license based on the type of project funded by the Industry.

Under the offer for a license approach, patent cell of university shall inform the Industry as soon as patent is generated at a designated email address to be included in the Project agreement.

**University Sole patent:** Industry shall respond to university within six months (Evaluation period) if they intend to pursue an exclusive or a non-exclusive license offer for university Sole patent. If Industry does not respond to university within six months to pursue the exclusive /non-exclusive license option university shall be free to license the university sole patent to any third party without accounting to the Industry and such patent shall be dealt as university in-house Project patent and licensed.

**Joint patent:** Industry shall respond to university within six months (Evaluation period) if they intend to pursue an exclusive license option for university Joint patent. If Industry does not respond to university within six months to pursue the exclusive license Option, university and the Industry may independently license to a third party without accounting to each other **or** University and the Industry will be free to license the patent to any third party and agree to share the revenue generated equally.

In the event of Joint patent, both Industry and university shall not assign the rights to any third party without informing the other Party.

## **PUBLICATION BASED ON PATENT**

(a) Faculty members, scientific staff, research scholars disseminate their creative work through publications for which they generally have unrestricted freedom. Publications constitute only a part of the body of knowledge generated. University policy is to encourage transfer and dissemination of knowledge in as complete a form as possible subjected to the following restrictions namely (i) In the case of publications based on externally sponsored work permission from the sponsoring agency may sometimes be contractually required. University's agreement with the sponsor usually requires that this permission may not be normally denied except so far as to protect any tangible patents which may be of commercial value or of security interest to the sponsor, and the sponsor will act within a reasonable time to give the permission to publish. (ii) All publications based on sponsored projects shall also acknowledge the sponsor's support for the work reported in the publications and

(iii) All the contracted obligations have to be adhered to by the creators in the case of patents generated through sponsored work.

b) In case of patentable patents, it is desirable to obtain the patent protection at least in the form of a provisional application before such patent is either published or exchanged so that both academic and commercial value of the patents is protected.

c) In order to protect the commercial value of patents without affecting the exchange of information, a special confidentiality agreement may be signed between interacting parties before exchanging the information about any patents.

## **AGREEMENTS AND CONTRACTS**

### **Agreement categories and authorized signatories**

All agreements related to the following categories, are to be approved by the University:

- (i) Confidentiality Agreement or any other Agreement does not render the University liable in any manner for breach of the agreement. Since such agreements often need to be entered quickly to enable progress in collaboration/interaction, the University has to respond promptly if the Agreement is entirely between the external party and the employee or student, and the University is not directly or indirectly made liable by the Agreement in any manner.
- (ii) Revenue Sharing Agreement, Indemnity agreement.
- (iii) Evaluation Agreement, Consultation Agreement, Research and Development Agreement (R&DA/MOU)
- (iv) Technology Transfer Agreement, License Agreement, Patent assignment agreement
- (v) Alternative Dispute Resolve Agreement

The Coordinator/Head of Patent Cell acts as the final signing authority in all the categories of agreements listed above, except confidentiality agreement which may be signed by the Patentee/creator with the consent of The Coordinator/Head of Patent Cell.

### **Infringements, Damages, Liability and Indemnity Insurance**

In any contract with the licensee, University shall obtain indemnity from legal proceedings against University including its employees, without limitation, due to reasons including but not limited to manufacturing defects, production problems, design guarantee, upgradation, content created and debugging obligation.

Generally, University shall obtain, through appropriate agreement, indemnification from the organization to which patents is transferred, against any direct or third-party legal liability arising out of commercial exploitation of patents.

Any computer software developed and distributed by University either through public domain or commercially, shall have explicit disclaimer against any liability arising out of the use of software by any user. University shall retain the right to engage in any litigation concerning patents and license infringements.

### **CONFLICT OF INTEREST**

- (i) The creator (s) are required to disclose any conflict of interest or potential conflict of interest.
- (ii) A license or an assignment of rights of any Patent to accompany in which the inventors have a stake shall be subject to the approval of the Coordinator/Head of Patent cell taking in to consideration the fact.

### **DISPUTE RESOLUTION**

In case of any dispute with regard to Patents policy, the decision of the University shall be deemed final and binding.

### **Jurisdiction**

As a policy, all agreements to be signed by the University will have the jurisdiction of the courts in Dharwad and shall be governed by appropriate laws in India. Exceptions to this may be allowed in certain cases by the University if necessary.

## **PATENT RULES**

The provisions of the Patent Act, 1970 (herein after referred to as the “1970 Act”) govern the procurement and grant of patents in India (Non-substantive procedural issues relating to the procurement & granting of patents are governed by the Patent Rules and not the 1970 Act). Section 159 of the Act, requires the Central Government to frame rules 2 to administer and carry out the intent of the Act. The Act was kept in abeyance till the formulation of rules. The rules came into force on April 20, 1972. Thus, the 1970 Act (except for certain sections) came into force on April 20, 1972 . The remaining sections of the Act came into force on April 1, 1978. Since its enactment, the Act has been amended on five occasions by:

- The Repealing and Amending Act, 1974 (Act 56 of 1974)
- The Delegated Legislation Provisions (Amendment) Act, 1985 (Act 4 of 1985)
- The Patents (Amendment) Act, 1999 (17 of 1999)
- The Patents (Amendment) Act, 2002 (38 of 2002)
- The Patents (Amendment) Act, 2005 (15 of 2005)

Rules were formulated based on above Act and their amendments.

## PRELIMINARY

### **Short title, extent and commencement:**

- (a) These guidelines may be called as the Karnataka University Patent regulations.
- (b) It extends to all the Post Graduate Departments of Karnataka University (including those at PG centers), its constituent colleges and Study Chairs
- (c) It shall come into force on such a date as approved by the Syndicate through notification.

### **Definitions and interpretation**

- (1) In these guidelines, unless the context otherwise requires.
  - (a) "Appellate Board" means the Board appointed by the Vice-Chancellor
  - (ab) "Assignee" includes an assignee of the assignee and the legal representative of a deceased assignee
  - (ac) "Capable of industrial application", in relation to an invention, means that the invention is capable of being made or used in an industry
  - (c) "Convention application" means an application for a patent made by virtue of section 135, The Patents Act, 1970
  - (f) "Exclusive license" means a license from a patentee which confers on the licensee, on the licensee and persons authorized by him, to the exclusion of all other persons (including the patentee), any right in respect of the patented invention, and exclusive licensee shall be construed accordingly.
  - (h) "Government undertaking" means any industrial undertaking carried on
    - (i) by a department of the Government
    - (ii) by a corporation established by a Central, Provincial or State Act, which is owned or controlled by the Government
    - (iii) by a Government company as defined in section 617 of the Companies Act, 1956 (1 of 1956)
    - (iv) by an institution wholly or substantially financed by the Government
  - (j) "Invention" means a new product or process involving an inventive step and capable of industrial application;
  - (ja) "Inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art
  - (k) "Legal representative" means a person who in law represents the estate of a deceased person
  - (l) "New invention" means any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date

of filing of patent application with complete specification, i.e., the subject matter has not fallen in public domain or that it does not form part of the state of the art

- (la) "Opposition Board" means an Opposition Board constituted under sub-section (3) of section 25, The Patents Act, 1970
- (m) "Patent" means a patent for any invention granted under the provisions of the Indian Patents Act, 1970
- (n) "Patent agent" means a person for the time being registered under this Act as a patent agent.
- (o) "Patented article" and "patented process" means respectively an article or process in respect of which a patent is in force
- (p) "Patentee" means the person for the time being entered on the register as the grantee or proprietor of the patent
- (q) "Patent of addition" means a patent granted in accordance with section 54;
- (r) "Patent office" means the patent office referred to in section 74 The Patents Act, 1970
- (s) "Person" includes University/Government
- (t) "Person interested" includes a person engaged in, or in promoting, research in the same field as that to which the invention relates
- (ta) "Pharmaceutical substance" means any new entity involving one or more inventive steps
- (u) "Prescribed" means in relation to proceedings before the Appellate Board, prescribed by rules made by the Appellate Board
  - (B) In other cases, prescribed by rules made under this Act;
- (v) "Prescribed manner" includes the payment of the prescribed fee;
- (w) "Priority date" has the meaning assigned to it by section 11, The Patents Act, 1970
- (x) "Register" means the register of patents referred to in section 67, The Patents Act, 1970

## **What are not inventions?**

The following are not inventions within the meaning of The Patents Act, 1970.

- (a) An invention which is frivolous or which claims anything obviously contrary to well established natural laws
- (b) an invention the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment
- (c) the mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature;
- (d) the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new

property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

- (e) a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;
- (f) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;
- (g) Omitted by the Patents (Amendment) Act, 2002
- (h) a method of agriculture or horticulture;
- (i) any process for the medicinal, surgical, curative, prophylactic diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products.
- (j) plants and animals in whole or any part thereof other than micro organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;
- (k) a mathematical or business method or a computer programme
- (l) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;
- (m) a mere scheme or rule or method of performing mental act or method of playing game;
- (n) a presentation of information;
- (o) topography of integrated circuits;
- (p) an invention which in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components.

Inventions relating to atomic energy not patentable: No patent shall be granted in respect of an invention relating to atomic energy falling within sub section (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962).

## APPLICATIONS FOR PATENTS

### **Persons entitled to apply for patents**

- (1) Subject to the provisions contained in section 134, an application for a patent for an invention may be made by any of the following persons, that is to say,
  - (a) by any person (s) [teaching staff and/or research scholar] of the University claiming to be the true and first inventor of the invention;
  - (b) by any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application;
  - (c) by the legal representative of any deceased person who immediately before his death was entitled to make such an application.
- (2) An application under sub-section (1) may be made by any of the persons referred to therein either alone or jointly with any other person.

### **Form of application**

- (1) Every application for a patent shall be for one invention only and shall be made in the prescribed form and filed in the patent office of the University.
- (1A) Every international application under the Patent Cooperation Treaty for a patent, as may be filed designating India shall be deemed to be an application under this Act, if a corresponding application has also been filed before the Controller in India.
- (1B) The filing date of an application referred to in sub-section (1A) and its complete specification processed by the patent office as designated office or elected office shall be the international filing date accorded under the Patent Cooperation Treaty.
- (2) Where the application is made by virtue of an assignment of the right to apply for a patent for the invention, there shall be furnished with the application, or within such period as may be prescribed after the filing of the application, proof of the right to make the application.
- (3) Every application under this section shall state that the applicant is in possession of the invention and shall name the person claiming to be the true and first inventor. If the person is not the applicant or one of the applicants, the application shall contain a declaration that the applicant believes the person so named to be the true and first inventor.
- (4) Every such application shall be accompanied by a provisional or a complete specification.

### **Information and undertaking regarding foreign applications**

- (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.

### **Provisional and complete specifications**

- (1) Where an application for a patent is accompanied by a provisional specification, a complete specification shall be filed within twelve months from the date of filing of the application, and if the complete specification is not so filed, the application shall be deemed to be abandoned.
- (2) Where two or more applications in the name of the same applicant are accompanied by provisional specifications in respect of inventions which are cognate or of which one is a modification of another and the Controller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may allow one complete specification to be filed in respect of all such provisional specifications.
- (3) Where an application for a patent is accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant requests at any time within twelve months from the date of filing of the application, direct that such specification shall be treated, for the purposes of this Act, as a provisional specification and proceed with the application accordingly.
- (4) Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under sub-section (3) as a provisional specification, the Controller may, if the applicant so requests at any time before grant of patent, cancel the provisional specification and post-date the application to the date of filing of the complete specification.

### **Contents of specifications**

- (1) Every specification, whether provisional or complete, shall describe the invention and shall begin with a title sufficiently indicating the subject-matter to which the invention relates.
- (2) If, in any particular case, the Controller considers that an application should be further supplemented by a model or sample of anything illustrating the invention or alleged to constitute an invention, such model or sample as he may require shall be furnished before the application is found in order for grant of a patent, but such model or sample shall not be deemed to form part of the specification.
- (3) Every complete specification shall
  - (a) fully and particularly describe the invention and its operation or use and the method by which it is to be performed;

- (b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and
  - (c) end with a claim or claims defining the scope of the invention for which protection is claimed;
  - (d) be accompanied by an abstract to provide technical information on the invention: Provided that
    - (i) the Controller may amend the abstract for providing better information to third parties; and
    - (ii) if the applicant mentions a biological material in the specification which may not be described in such a way as to satisfy clauses (a) and (b), and if such material is not available to the public, the application shall be completed by depositing the material to an international depository authority under the Budapest Treaty and by fulfilling the following conditions, namely:
      - (A) the deposit of the material shall be made not later than the date of filing the patent application in India and a reference thereof shall be made in the specification within the prescribed period;
      - (B) all the available characteristics of the material required for it to be correctly identified or indicated are included in the specification including the name, address of the depository institution and the date and number of the deposit of the material at the institution;
      - (C) access to the material is available in the depository institution only after the date of the application of patent in India or if a priority is claimed after the date of the priority;
      - (D) disclose the source and geographical origin of the biological material in the specification, when used in an invention.
- (4) In case of an international application designating' India, the title, description, drawings, abstract and claims filed with the application shall be taken as the complete specification for thepurposes of this Act.
- (5) The claim or claims of a complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification.
- (6) A declaration as to the inventorship of the invention shall, in such cases as may be prescribed, be furnished in the prescribed form with the complete specification or within such period as may be prescribed after the filing of that specification.

### **III. INTERNATIONAL APPLICATIONS UNDER PATENT COOPERATION TREATY (PCT)**

Definitions: Here, 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.

#### **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 completed details of such application to the Patent Office, Delhi branch.

#### **International applications filed with appropriate office as receiving office.**

- (1) An international application shall be filed with the appropriate office in triplicate either in English or Hindi language.
- (2) The fees payable in respect of an international application shall, in addition to the fees specified in the regulations under the Treaty, be the fees as specified in the First Schedule and the Fifth Schedule.

- (3) Where an international application has not been filed in triplicate, the appropriate office shall, upon payment of fees specified in the First Schedule, prepare the required additional copies.
- (4) On receipt of a request from the applicant and on payment of the fees specified in the First Schedule, the appropriate office shall prepare a certified copy of the priority document and promptly transmit the same to the International Bureau and intimate the applicant and the Patent Office, Delhi branch.

## **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.

## **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.

### **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.

## **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 43bis.1 of the regulations under the Treaty, to the International Bureau and one copy to the applicant, on the same day.

## **Confidential treatment.**

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

## **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 applicationselecting 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 approved.**

## **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.**

## **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.

## **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.

## **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 'patents EA/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.

## **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 dateof 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 or as one 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.

### **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.

### **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.

### **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.

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

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.

### **Filing of priority document.**

- (1) Where the applicant in respect of an international application designating India has not complied with the requirements of paragraph (a) or paragraph (b) of rule 17.1 of the regulations under the Treaty, the applicant shall file with the patent office the priority document referred to in that rule before the expiration of the time limit referred to in sub-rule (4) of rule 20.
- (2) Where priority document referred to in sub-rule (1) is not in the English language, an English translation thereof duly verified by the applicant or the person duly authorized by him shall be filed within the time limit specified in sub-rule (4) of rule 20.
- (3) Where the applicant does not comply with the requirements of sub-rule 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.

### **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.

### **The requirements 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 there under, the provisions of the Treat and the regulations and administrative instructions made thereunder shall apply in relation to international applications.

## **IV.**

## **PUBLICATION AND EXAMINATION OF APPLICATIONS**

### **Publication of applications**

- (1) No application for patent shall ordinarily be open to the public for such period as may be prescribed.
- (2) The applicant may, in the prescribed manner, request the Controller to publish his application at any time before the expiry of the period subject to the provisions of sub-section (3). The Controller shall publish such application as soon as possible.
- (3) Every application for a patent shall, on the expiry of the period be published, except in cases where the application
  - (a) in which secrecy direction is imposed under section 35; or
  - (b) has been abandoned under sub-section (1) of section 9; or
  - (c) has been withdrawn 3 months prior to the period specified under sub-section (1).
- (4) In case a secrecy direction has been given in respect of an application under section 35, then it shall be published after the expiry of the period or when the secrecy direction has ceased to operate, whichever is later.
- (5) The publication, of every application under this section shall include the particulars of the date of application, number of application, name and address of the applicant identifying the application and an abstract.
- (6) Upon publication of an application for a patent under this section
  - (a) The depository institution shall make the biological material mentioned in the specification available to the public;
  - (b) The patent office may, on payment of such fee as may be prescribed, make the specification and drawings, if any, of such application available to the public.

(7) On and from the date of publication of the application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for the invention had been granted on the date of publication of the application

Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been granted:

Provided further that the rights of a patentee in respect of applications made under sub-section (2) of section 5 before the 1<sup>st</sup> day of January shall accrue from the date of grant of the patent:

Provided also that after a patent is granted in respect of applications made under sub-section (2) of section 5, the patent-holder shall only be entitled to receive reasonable royalty from such enterprises which have made significant investment and were producing and marketing the concerned product prior to the 1<sup>st</sup> day of January of the year and which continue to manufacture the product covered by the patent on the date of grant of the patent and no infringement proceedings shall be instituted against such enterprises.

### **Request for examination**

(1) No application for a patent shall be examined unless the applicant or any other interested person makes a request in the prescribed manner for such examination within the prescribed period.

(2) In case of an application in respect of a claim for a patent filed under sub-section (2) of section 5 before the 1<sup>st</sup> day of January, a request for its examination shall be made in the prescribed manner and within the prescribed period by the applicant or any other interested person.

(3) In case the applicant or any other interested person does not make a request for examination of the application for a patent within the period as specified under sub section (1) or sub-section (3), the application shall be treated as withdrawn by the applicant:

### **Provided that**

- (i) the applicant may, at any time after filing the application but before the grant of a patent, withdraw the application by making a request in the prescribed manner; and
- (ii) in a case where secrecy direction has been issued under section 35, the request for examination may be made within the prescribed period from the date of revocation of the secrecy direction.

### **Examination of application**

(1) When a request for examination is made for a patent in the prescribed manner under sub- section (1) or sub section (3) of section 11B, the application and specification and other documents related thereto shall be referred at the earliest by the Controller to an examiner for making a report to him by considering the following:

- (a) whether the application and the specification and other documents relating thereto are in accordance with the requirements of this Act and of any rules made thereunder;
- (b) whether there is any lawful ground of objection to the grant of the patent under this Act in pursuance of the application;
- (c) the result of investigations made under section 13; and
- (d) any other matter which may be prescribed.

- (2) The examiner to whom the application and the specification and other documents relating thereto are referred under sub-section (1) shall ordinarily make the report to the Controller within such period as may be prescribed.

### **Search for anticipation by previous publication and by prior claim**

- (1) The examiner to whom an application for a patent is referred shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification has been anticipated by publication before the date of filing of the applicant's complete specification in any specification filed in pursuance of an application for a patentmade in India
- (2) The examiner shall, in addition, make such investigation for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been anticipated by publication in India or elsewhere in any document other than those mentioned in sub-section  
(1) before the date of filing of the applicant's complete specification.
- (3) The examination and investigations required under section 12 and this section shall not be deemed in any way to warrant the validity of any patent, and no liability shall be incurred by the Central Government or any officer thereof by reason of, or in connection with, any such examination or investigation or any report or other proceedings consequent thereon.

### **Consideration of the report of examiner by Controller**

Where, in respect of an application for a patent, the report of the examiner received by the Controller is adverse to the applicant or requires any amendment of the application, the specification or other documents to ensure compliance with the provisions of this Act or of the rules made thereunder, the Controller, before proceeding to dispose of the application in accordance with the provisions hereinafter appearing, shall communicate as expeditiously as possible the gist of the objections to the applicant and shall give him an opportunity of being heard.

### **Power of Controller to refuse or require amended applications, etc., in certain case**

Where the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may refuse the application or may require the application, specification or the other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application and refuse the application on failure to do so.

### **Power of Controller to make orders respecting division of application**

- (1) A person who has made an application for a patent under this Act may, at any time before the grant of the patent, if he so desires, or with a view to remedy the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first mentioned application.
- (2) The Controller may require such amendment of the complete specification filed in pursuance of either the original or the further application as may be necessary to ensure that neither of the said complete specifications includes a claim for any matter claimed in the other.

### **Power of Controller to make orders respecting dating of application**

- (1) The Controller may, at the request of the applicant made in the prescribed manner, at any time after the filing of an application and before the grant of the patent under this Act, direct that the

application shall be post-dated to such date as may be specified in the request, and proceed with the application accordingly:

Provided that no application shall be post-dated under this sub-section to a date later than six months from the date on which it was actually made or would.

- (2) Where an application or specification or any other document is required to be amended under section 15, the application or specification or other document shall, if the Controller so directs, be deemed to have been made on the date on which the requirement is complied with or where the application or specification or other document is returned to the applicant on the date on which it is re-filed after complying with the requirement.

### **Powers of Controller in cases of anticipation**

- (1) The Controller may refuse the application unless the applicant—
- shows to the satisfaction of the Controller that the priority date of the claim of his complete specification is not later than the date on which the relevant document was published; or
  - amends his complete specification to the satisfaction of the Controller.
- (2) If it appears to the Controller that the invention is claimed in a claim of any other complete specification then he may subject to the provisions hereinafter contained, direct that a reference to that other specification shall be inserted by way of notice to the public in the applicant's complete specification unless within such time as may be prescribed,
- the applicant shows to the satisfaction of the Controller that the priority date of his claim is not later than the priority date of the claim of the said other specification;
- or
- the complete specification is amended to the satisfaction of the Controller

### **Powers of Controller in case of potential infringement**

- (1) If, in consequence of the investigations required under this Act, it appears to the Controller that an invention in respect of which an application for a patent has been made cannot be performed without substantial risk of infringement of a claim of any other patent, he may direct that a reference to that other patent shall be inserted in the applicant's complete specification by way of notice to the public, unless within such time as may be prescribed—
- the applicant shows to the satisfaction of the Controller that there are reasonable grounds for contesting the validity of the said claim of the other patent; or
  - the complete specification is amended to the satisfaction of the Controller.
- (2) Where, after a reference to another patent has been inserted in a complete specification in pursuance of a direction under sub-section (1)
- that other patent is revoked or otherwise ceases to be in force; or
  - the specification of that other patent is amended by the deletion of the relevant claim;  
or
  - it is found, in proceedings before the court or the Controller, that the relevant claim of that other patent is invalid or is not infringed by any working of the applicant's invention, the Controller may, on the application of the applicant, delete the reference to that other patent.

## **Powers of Controller to make orders regarding substitution of applicants**

- (1) If the Controller is satisfied, on a claim made in the prescribed manner at any time before a patent has been granted, that by virtue of any assignment or agreement in writing made by the applicant or one of the applicants for the patent or by operation of law, the claimant would, if the patent were then granted, be entitled thereto or to the interest of the applicant therein, or to an undivided share of the patent or of that interest, the Controller may, subject to the provisions of this section, direct that the application shall proceed in the name of the claimant or in the names of the claimants and the applicant or the other joint applicant or applicants, accordingly as the case may require.
- (2) No such direction as aforesaid shall be given by virtue of any assignment or agreement made by one of two or more joint applicants for a patent except with the consent of the other joint applicant or applicants.
- (3) No such direction as aforesaid shall be given by virtue of any assignment or agreement for the assignment of the benefit of an invention unless—
  - (a) the invention is identified therein by reference to the number of the application for the patent; or
  - (b) there is produced to the Controller an acknowledgement by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made; or
  - (c) the rights of the claimant in respect of the invention have been finally established by the decision of a court; or
  - (d) the Controller gives directions for enabling the application to proceed or for regulating the manner in which it should be proceeded with under sub-section (5).
- (4) Where one of two or more joint applicants for a patent dies at any time before the patent has been granted, the Controller may, upon a request in that behalf made by the survivor or survivors, and with the consent of the legal representative of the deceased, direct that the application shall proceed in the name of the survivor or survivors alone.
- (5) If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the Controller may, upon application made to him in the prescribed manner by any of the parties, and after giving to all parties concerned an opportunity to be heard, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be proceeded with, or for both those purposes, as the case may require.

## **Time for putting application in order for grant**

- (1) An application for a patent shall be deemed to have been abandoned unless, within such period as may be prescribed, the applicant has complied with all the requirements imposed on him by or under this Act, whether in connection with the complete specification or otherwise in relation to the application from the date on which the first statement of objections to the application or complete specification or other documents related thereto is forwarded to the applicant by the Controller.
- (2) If at the expiration of the period as prescribed under sub section (1)

- (a) an appeal to the High Court is pending in respect of the application for the patent for the main invention;  
or
  - (b) in the case of an application for a patent of addition, an appeal to the High Court is pending in respect of either that application or the application for the main invention, the time within which the requirements of the Controller shall be complied with shall, on an application made by the applicant before the expiration of the period as prescribed under sub-section (1), be extended until such date as the High Court may determine.
- (3) If the time within which the appeal mentioned in sub-section (2) may be instituted has not expired, the Controller may extend the period as prescribed under subsection (1), to such further period as he may determine: Provided that if an appeal has been filed during the said further period, and the High Court has granted any extension of time for complying with the requirements of the Controller, then the requirements may be complied with within the time granted by the Court.

## **V. OPPOSITION PROCEEDINGS TO GRANT OF PATENTS**

According to Section 25 (1) of the Patents Act 1970 and Patent Rules 2003, any person interested can file a post-grant opposition within 12 months of the date of publication of the grant of a patent on any of the grounds prescribed, by giving a notice of opposition to the controller. An opposition may be filed by any person (or any third party), while a patent revocation procedure in court may be initiated only by a party who fulfills certain conditions, for example, being an interested party or being adversely affected by the decision subject to the appeal.

Representation for opposition shall be filed in prescribed format at the appropriate office with a copy to the applicant, and shall include a statement and evidence, if any, in support of the representation and a request for hearing, if so desired. No patent shall be granted before the expiry of a period of six months from the date of publication of the application under section 11A of patent act.

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

On consideration of the representation if the Controller is of the opinion that application for patent shall be refused or the complete specification requires amendment, he shall give a notice to the applicant to that effect.

On receiving the notice under sub-rule (3), the applicant shall, if he so desires, file his statement and evidence, if any, in support of his application within three months from the date of the notice, with a copy to the opponent.

On consideration of the statement and evidence filed by the applicant, the representation including the statement and evidence filed by the opponent, submissions made by the parties, and after hearing the parties, if so requested, the Controller may either reject the representation or require the complete specification and other documents to be amended to his satisfaction before the patent is granted or refuse to grant a patent on the application, by passing a speaking order to simultaneously decide on the application and the representation ordinarily within one month from the completion of above proceedings.

## **Filing of Notice of Opposition**

The notice of opposition to be given under sub-section (2) of section 25 shall be made in Form 7 and sent to the Controller in duplicate at the appropriate office.

### **Constitution of Opposition Board and its Proceeding**

On receipt of notice of opposition under rule 55A, the Controller shall, by order, constitute an Opposition Board consisting of three members and nominate one of the members as the Chairman of the Board.

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

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

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

### **Filing of written statement of opposition and evidence**

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

### **Filing of reply statement and evidence**

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

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

### **Filing of reply evidence by opponent**

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

### **Further evidence to be left with the leave of the Controller**

No further evidence shall be delivered by either party except with the leave or directions of the Controller provided that such leave or direction is prayed before the Controller has fixed the hearing under rule.

## **Copies of documents to be supplied**

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

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

## **Hearing**

On the completion of the presentation of evidence, if any, and on receiving the recommendation of Opposition Board or at such other time as the Controller may think fit, he shall fix a date and time for the hearing of the opposition and shall give the parties not less than ten days' notice of such hearing and may require members of Opposition Board to be present in the hearing.

If either party to the proceeding desires to be heard, he shall inform the Controller by a notice along with the fee.

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

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

After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing, and after taking into consideration the recommendation of Opposition Board, the Controller shall decide the opposition and notify his decision to the parties giving reasons therefor.

## **Determination of Costs**

If the patentee notifies the Controller that he desires to withdraw the patent after notice of opposition is given, the Controller, depending on the merits of the case, may decide whether costs should be awarded to the opponent.

### **Request made under sections 26 and 28**

Request under section 26(1) shall be made on Form 12 within three months from the date of the order of the Controller and shall be accompanied by a statement setting out the facts upon which the petitioner relies and relief he claims.

A request under subsection (2) of section 28 shall be made in Form 8. A claim under sub section (3)of section 28 shall be made in Form 8, and shall be accompanied by a statement setting out the circumstances under which the claim is made. A copy of the claim and the statement shall be sent by the Controller to every applicant for the patent (not being the claimant) and to any other person whom the Controller may consider to be interested.

An application under sub-section (7) of section 28 shall be made in Form 8 and shall be accompanied by a statement setting out the circumstances under which the application is made. A copy of the application and the statement shall be sent by the Controller to each patentee or the applicant for patent, as the case may be, and to any other person whom the Controller may consider to be interested.

## **Procedure for the hearing of claim or an application under section 28**

The procedure specified in rules 55A and 57 to 63 relating to the filing of notice of opposition, written statement, reply, statement, leaving evidence, hearing and cost shall, so far as may be, apply to the hearing of a claim or an application under section 28 as they apply to the opposition proceedings subject to the modification that reference to patentee shall be construed as the person making the claim, or an application. Any mention of the inventor under sub-section (1) of section 28 shall be made in the relevant documents in the following form namely "The inventor of this invention/substantial part of this invention within the meaning of section 28 of the Patents Act, 1970, is..... .....of .....".

## **VI. SECRECY DIRECTIONS**

Permission for making patent application outside India under section 39

Request for permission for making patent application outside India shall be made in Form 25.

The Controller shall dispose of the request made under sub-rule (1) within a period of twenty-onedays from the date of filing of such request

Provided that in case of inventions relating to defense or atomic energy, the period of twenty-onedays shall be counted from the date of receipt of consent from the Central Government.

Communication of result of reconsideration under section 36 (2)

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

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

## **VII. GRANT OF PATENTS**

Once the application meets all the requirements of Patentability and overcomes all the objections of the examiner, the patent is granted to the inventor with the seal from patent office and is notified in the journal from time to time.

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

The patent certificate shall ordinarily be issued within seven days from the date of grant of patent under section 43.

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

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

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

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

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

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

### **Procedure for the hearing of proceedings under section 51**

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

A request under sub-section (2) of section 52 shall be made in Form 12 within three months from the date of the order of the Appellate Board or court referred to in sub-section (1) of the said section and shall be accompanied by a statement setting out the facts upon which the petitioner relies and the relief he claims and a certified copy of the order of the Appellate Board or court. Where the Appellate Board or court has ordered the grant of patent to the applicant only for a part of the invention, the new patent granted shall be accorded a number in the same series of numbers accorded to the complete specifications accepted on the same day as the patent is granted.

### **Renewal fees under section 53**

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

The period for payment of renewal fees so specified in sub-rule (1) may be extended to such period not being more than six months if the request for such extension of time is made in Form 4 with the fee specified in the First Schedule. While paying the renewal fee, the number and date of the patent concerned and the year in respect of which the fee is paid shall be quoted. The annual renewal fees payable in respect of two or more years may be paid in advance. The Controller shall, after making such enquiry as he may deem necessary, credit any renewal fee and issue a certificate that the fee has been paid.

## **VIII. AMENDMENT OF APPLICATION, SPECIFICATION OR ANY DOCUMENT RELATING THERETO**

In general, amendments to patents and applications are governed by Sections 57 and 59 of the Act, which stipulate that such amendments can be made only by way of disclaimer, correction or explanation without addition of new subject matter.

An application for amendment of an application for a patent or a complete specification or any document related to amend a claim can be filed using Form 13 under section 57, alongside payment of the prescribed fee. Further, according to Patent Manual 2019, the application must state the nature of proposed amendment, highlighted in an annexed copy along with reasons.

If the application for amendment under sub-rule (1) relates to an application for a patent which has not been granted, the Controller shall determine whether and subject to what conditions, if any, the amendment shall be allowed. If the application for amendment under sub-rule (1) is made after grant of patent and the nature of the proposed amendment is substantive, the application shall be published.

Any person interested in opposing the application for amendment shall give a notice of opposition in Form 14 within three months from the date of publication of the application.

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

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

## **IX. RESTORATION OF PATENTS**

The Patents Act provides certain safeguards for restoring a lapsed patent. Accordingly, a patent that is ceased to have effect because of failure to pay the prescribed fees within the prescribed period under Section 53 of the Act or within such period, allowed under Section 142 of the Act.

The patentee or his legal representative, may, make an application in the prescribed manner for the restoration of the lapsed patent. In the case where the patent was held by two or more persons jointly then with the leave of the Controller one or more of them without joining others may submit the application for restoration within 18 months from the date on which the patent is ceased to have effect.

Though the renewal fees can be paid by any person, the application for the restoration of a lapsed patent, the application has to be made by the patentee or his legal representative. If the patentee fails to pay the renewal fee within the prescribed period and also within the extendable period of six months by requesting extension of time, the patent ceases to have effect or lapses from the date of expiration. Patent lapsed, due to non-payment of renewal/maintenance fee can be restored within eighteen months from the date of lapse.

An application for the restoration of a patent under section 60 shall be made in Form 15, where the Controller is satisfied that a *prima facie* case for the restoration of any patent has not been made out, he shall intimate the applicant accordingly and unless the applicant makes a request to be heard in the matter within one month from the date of such intimation, the Controller shall refuse the application.

Where applicant requests for a hearing within the time allowed and the Controller, after giving the applicant such a hearing, is *prima facie* satisfied that the failure to pay the renewal fees was unintentional, he shall publish the application.

### **Opposition to restoration under section 61**

At any time, within two months from the date of publication of the application under sub-rule (3) of rule 84, any person interested may give notice of opposition thereto in Form 14. A copy of the notice of opposition shall be sent by the Controller to the applicant. The procedure specified in rules

57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 60 as they apply to the hearing in the opposition proceeding.

### **Payment of Unpaid Renewal Fees**

When a decision in favour of the applicant has been made by the controller, the applicant can proceed to pay the unpaid renewal and additional fees according to the specifications of the First Schedule, within a month's time from the date of the Controller's Order permitting the application for restoration. The Controller shall publish his decision.

X.

## **SURRENDER OF PATENTS**

### **Application for surrender of patents**

- (1) The Controller shall publish the notice of an offer given under section 63.
- (2) Any person interested may, within three months from the date of publication of the notice, give notice of opposition to the Controller in Form 14 in duplicate.
- (3) The procedure specified in rules 57 to 63 relating to the filing of written statement, reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 63 as they apply to the hearing in opposition proceeding.
- (4) If the Controller accepts the patentee's offer to surrender the patent, he may direct the patentee to return the patent, and on receipt of such patent, the Controller shall by order revoke it and publish the revocation of the patent.

XI.

## **REGISTER OF PATENTS**

### **Register of patents under section 67**

- (1) Upon the grant of a patent, the Controller shall enter in the register of patents at each appropriate office, the name, address and nationality of the grantee as the patentee thereof, the title of the invention (including the categories to which the invention relates), the date of the patent and the date of grant thereof together with the address for service of the patentee.
- (2) The Controller shall also enter in the register of patents particulars regarding proceedings under the Act before the Controller or Appellate Board or the courts in respect of every patent.
- (3) Where the register of patents or any part thereof is in a computer or any other electronic form it shall be maintained and accessed only by the person who is duly authorized by the Controller and no entry or alteration of any entry or rectification of any entry in the said register shall be made by any person who is not so authorized by the Controller.

### **Registration of title and interest in patents**

- (1) An application referred to in sub-section (1) or sub-section (2) of section 69 shall be made in Form 16.
- (2) An application for an entry in the register of patents of any other document purporting to affect the proprietorship of the patent by the person benefiting under the document shall be made in Form 16.

## **Presentation of assignment, etc., of patent to Controller**

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

## **Registration of title or interest in a patent**

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

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

## **Entry of Renewal fee**

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

## **Alteration of address**

- (1) A patentee may make a request in writing along with fee payable to the Controller for the alteration of his name, nationality, address or address for service as entered in the register of patents in respect of any patent granted to him. The Controller may require such proof of the alteration as he may think fit before acting on a request to alter the name or nationality.
- (2) If the Controller allows a request made under sub-rule (1), he shall cause the entries in the register to be altered accordingly.
- (3) If a patentee makes a request in writing along with fee payable for entering an additional address or service in India and if the Controller is satisfied that the request should be allowed, he shall have the additional address for service entered in the register.

## **Inspection of register of patents under section 72 and fees payable therefor**

- (1) The register of patents shall be open for public inspection during office hours on payment of the fees specified therefor in the First Schedule.
- (2) When register of patents or any part thereof is in a computer or any other electronic form the person authorized by the Controller under sub-rule (3) of rule 88 shall provide access to the computer or other electronic form or printouts of the records thereof.

## **COMPULSORY LICENSE AND REVOCATION OF PATENT**

### **Application for compulsory license**

An application to the Controller for an order under section 84, section 85, section 91 or section 92 or section 92A shall be in Form 17, or Form 19, as the case may be. Except in the case of an application made by the Central Government, the application shall set out the nature of the applicant's interest and terms and conditions of the license the applicant is willing to accept.

When a prima facie case is not made out

- (1) If, upon consideration of the evidence, the Controller is satisfied that a prima facie case has not been made out for the making of an order under any of the sections referred to in rule 96, he shall notify the applicant accordingly, and unless the applicant requests to be heard in the matter, within one month from the date of such notification, the Controller shall refuse the application.
- (2) If the applicant requests for a hearing within the time allowed under sub-rule (1), the Controller shall, after giving the applicant an opportunity of being heard, determine whether the application may be proceeded with or whether it shall be refused.

### **Notice of opposition under section 87(2)**

- (1) A notice of opposition under sub-section (2) of section 87 shall be given in Form 14 and shall be sent to the Controller within two months from the date of the publication of the application under sub-section (1) of the said section.
- (2) The notice of opposition referred to in sub-rule (1) shall include the terms and conditions of the license, if any, the opponent is prepared to grant to the applicant and shall be accompanied by evidence in support of the opposition.
- (3) The opponent shall serve a copy of his notice of opposition and evidence on the applicant and notify the Controller when such service has been effected.
- (4) No further statement or evidence shall be delivered by either party except with the leave of or on requisition by the Controller.
- (5) The Controller shall forthwith fix a date and time for the hearing of the case and shall give the parties not less than ten days' notice of such hearing.
- (6) The procedure specified in sub-rules (2) to (5) of rule 62, shall, so far as may be, apply to the procedure for hearing under this rule as they apply to the hearing in opposition proceedings.

### **Manner of publication of the revocation order**

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

### **Application under section 88(4)**

- (1) An application under sub-section (4) of section 88 for the revision of the terms and conditions of a license which have been settled by the Controller shall be in Form 20 and shall state the facts relied upon by the applicant and the relief he seeks and shall be accompanied by evidence in support of the application.

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

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

#### **Procedure to be followed in case of applications under section 88(4):**

- (1) If the Controller allows the application to be proceeded with, he shall direct the applicant to serve copies of the application and of the evidence in support thereof upon the patentee or any other person appearing in the register to be interested in the patent or upon any other person on whom, in his opinion such copies should be so served.
- (2) The applicant shall inform the Controller the date on which the service of copies of application and of the evidence on the patentee and other persons referred to in sub-rule has been effected.
- (3) The patentee or any other person on whom copies of the application and of the evidence have been served, may give to the Controller notice of opposition in Form 14 within one month from the date of such service. Such notice shall contain the grounds relied upon by the opponent and shall be accompanied by evidence in support of the opposition.
- (4) The opponent shall serve copies of the notice of opposition and his evidence on the applicant and inform the Controller the date on which such service has been affected.
- (5) No further evidence or statement shall be filed by either party except with special leave of or on requisition by the Controller.
- (6) On completion of the above proceedings, the Controller shall forthwith fix a date and the time for the hearing of the case and shall give the parties not less than ten days' notice of such hearing.
- (7) The procedure specified in sub-rules (2) to (5) of rule 62 shall, so far as may be, apply to the procedure for hearing under this rule as they apply to the hearing in opposition proceedings.
- (8) If the Controller decides to revise the terms and conditions of license he shall forthwith amend the license granted to the applicant in such manner, as he may deem necessary

#### **Application for termination of compulsory license under section 94**

- (1) An application for termination of compulsory license under section 94(1) shall be made in Form 21 by the patentee or any other person deriving title or interest in the patent. The application shall be accompanied by the evidence in support of the application.
- (2) The applicant shall serve a copy of the application and evidence on the holder of the compulsory license and shall inform the Controller the date on which the service has been effected.
- (3) The holder of the compulsory license may file his objection along with evidence, if any, to the application within one month from the date of receipt of the application and evidence by him to the Controller and serve a copy thereof to the applicant.

- (3) No further evidence or statement shall be filed by either party except with special leave of or on requisition by the Controller.
- (4) On completion of the above proceedings, the Controller shall forthwith fix a date and the time for the hearing of the case and shall give the parties not less than ten days' notice of such hearing.
- (5) The procedure specified in sub-rules (2) to (5) of rule 62 so far as may be, apply to the procedure for hearing under this rule as they apply to the hearing in opposition proceedings.
- (6) If the Controller decides to terminate the compulsory license he shall forthwith issue an order giving terms and conditions, if any, of such termination and serve copies of the order to both the parties.

## **XIII. SCIENTIFIC ADVISERS**

### **Roll of scientific advisers**

- (1) The Controller shall maintain a roll of scientific advisers for the purpose of section 115. The roll shall be updated annually. The roll shall contain the names, addresses, specimen signatures and photographs of scientific advisers, their designations, information regarding their educational qualifications, the disciplines of their specialization and their technical, practical and research experience.
- (2) A person shall be qualified to have his name entered in the roll of scientific advisers, if he—
  - (i) holds a degree in science, engineering or technology or equivalent;
  - (ii) has at least fifteen years' technical, practical or research experience; and
  - (iii) he holds or has held a responsible post in a scientific or technical department of the Central or State Government or in any organization.

### **Disqualifications for inclusion in the roll of scientific advisers:**

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

### **Manner of application for inclusion in the roll of scientific advisers**

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

Inclusion of the name of any other person in the roll of scientific advisers

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

### **Power to relax**

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

### **Removal of names from the roll of scientific advisers**

The Controller may remove the name of any person from the roll of scientific advisers, if such person makes a request for such removal; or

the Controller is satisfied that his name has been entered in the roll by error or on account of misrepresentation or suppression of any material fact; or

such person has been convicted of an offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity and the Controller is of the opinion that his name should be removed from the roll; or such person is dead:

Provided that except in the cases falling under clause (a) and (d) above, before removing the name of any person from the roll of scientific advisers under this rule, such person shall be given a reasonable opportunity of being heard.

## **PATENT AGENTS**

### **Particulars to be contained in the register of patent agents**

(1) The register of patent agents maintained under section 125 shall contain the name, nationality, address of the principal place of business, addresses of branch offices, if any, the qualifications, the date of registration of every registered patent agent and the details of their renewal of registration and any other particulars so specified by the Controller.

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

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

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

## **Application for registration of patent agents:**

- (1) Every person who desires to be registered as a patent agent shall make an application in Form22.
- (2) The applicant shall furnish such other information as may be required by the Controller.
- (3) A person desirous to appear in the qualifying examination under rule 110 shall make a request to the Controller along with the fee specified in the First Schedule after announcement of such examination and within the period as may be specified in the announcement.

## **Particulars of the qualifying examination for patent agents**

- (1) The qualifying examination referred to in clause (c) (ii) of sub-section (1) of section 126 shall consist of a written test and a viva voce examination.
- (2) The qualifying examination shall consist of the following papers and marks, namely:

Paper I —Patents Act and Rules	100
Paper II—Drafting and interpretation of patent specifications and other	100
Viva Voce	50

- (3) A candidate shall be required to secure a minimum of fifty marks in paper I and paper II and shall be declared to have passed the examination only, if he obtains an aggregate of sixty percent of the total marks.

## **Registration of patent agents**

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

## **Issue of duplicate certificate of patent agents**

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

Details to be included in an application for the registration of a patent agent

An application by a person entitled to be registered as a patent agent under sub- section (2) of section 126 shall also be made in Form22.

## **Registration of patent agents under section 126 (2)**

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

Disqualifications for registration as a patent agent.—

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

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

### **Payment of fees**

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

Removal of a name from the register of patent agents

- (1) The Controller may delete from the register of patent agents, the name of any patent agent from whom a request has been received to that effect;or
- (b) when he is dead;or
- (c) when the Controller has removed the name of a person under subsection (1) of section 130;or
- (d) if he has defaulted in the payment of fees specified in rule 115, by more than three months after they are due;or
- (e) if he ceases to be a citizen of India:

Provided that except under clause (a) and (b), before removing the name of any person from the register of patent agents under this rule, such person shall be given a reasonable opportunity of being heard.

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

### **Restoration of name of persons removed from the register of patent agents**

- (1) An application for the restoration of the name of any person removed from the register of patent agents under sub-section (2) of section 130 shall be made in Form 23 within two months from the date of such removal.
- (2) If the name of a person is restored to the register of patent agents, his name shall be continued therein for a period of one year from the date on which his last annual fee became due.
- (3) The restoration of a name to the register of patent agents shall be communicated to the patent agent and also published on the official website.

## **Alteration of names, etc., in the register of patent agents**

- (1) A patent agent may apply for the alteration of his name, address of the principal place of business and branch offices, if any, or the qualifications entered in the register of patent agents, e-mail address, telephone number, fax number or any other particulars under sub-section (1) of section 125. On receipt of such application and the fee specified therefor in the First Schedule for such request for alteration of particulars, the Controller shall cause the necessary alterations to be made in the register of patent agents.
- (2) Every alteration made in the register of patent agents shall be published.

## **Refusal to recognize as patent agent**

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

Publication of the names of patent agents, registered under the Act. — The names and addresses of persons registered as patent agents shall from time to time be published.

## **XV. MISCELLANEOUS**

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

### **Address of Communications**

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

Correction of clerical errors:

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

Manner of advertisement of the proposed correction of any error:

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

### **Manner and time of opposition to the making of corrections**

- (1) Any person interested may, at any time, within three months from the date of the advertisement of the request for correction give notice of opposition to the Controller in Form 14 in duplicate.
- (2) Such notice of opposition shall be accompanied by a statement in duplicate setting out the nature of the opponent's interest, the facts on which he relies and the relief which he seeks.

- (3) A copy of the notice and of the statement shall be sent by the Controller to the person making the request.
- (4) The procedure specified in rules 58 to 63 relating to the filing of reply statement, leaving evidence, hearing and costs shall, so far as may be, apply to the hearing of the opposition under section 78 as they apply in the hearing of the opposition proceeding.

### **Notification of corrections**

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

### **Form, etc., of affidavits**

- (1) The affidavits required by the Act or these rules to be filed at the patent office or furnished to Controller shall be duly sworn to in the manner as prescribed in sub-rule(3).
- (2) Affidavits shall be confined to such facts as the deponent is able, of his own knowledge, to prove except in interlocutory matters, where statements of belief of the deponent may be admitted, provided that the grounds thereof are given.
- (3) Affidavits shall be sworn to as follows:—
  - (a) in India—before any court or person having by law authority to receive evidence, or before any officer empowered by such court as aforesaid to administer oaths or to take affidavits;
  - (b) in any country or place outside India—before a diplomatic or consular officer, within the meaning of the Diplomatic and Consular Officers (Oaths and Fees) Act, 1948 (41 of 1948) in such country or place or before a notary of the country or place, recognized by the Central Government under section 14 of the Notaries Act, 1952 (53 of 1952), or before a judge or magistrate of the country or place.

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

### **Exhibits**

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

### **Directions not otherwise prescribed**

- (1) Where for the proper prosecution or completion of any proceedings under the Act or these rules, the Controller is of the opinion that it is necessary for a party to such proceedings to perform an act, file a document or produce evidence, for which provision has not been made in the Act or these rules, he may, by notice in writing, require such party to perform the act, file the document or produce the evidence specified in such notice.
- (2) Where an applicant or a party to a proceeding desires to be heard or not heard, the Controller may, at any time, require him to submit his statement in writing giving such information as the Controller may deem necessary within the time specified by him.

## **Exercise of discretionary power by the Controller**

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

## **Adjournment of hearing**

An applicant for patent or a party to a proceeding may make a request for adjournment of the hearing with reasonable cause along with the prescribed fee prescribed in First Schedule, at least three days before the date of hearing and the Controller, if he thinks fit to do so, and upon such terms as he may direct, may adjourn the hearing and intimate the parties accordingly:

Provided that no party shall be given more than two adjournments and each adjournment shall not be for more than thirty days.

## **Application for review of decisions or setting aside of orders of the Controller**

(1) An application to the Controller for the review of his decision under clause (f) of sub-section (1) of section 77 shall be made in Form 24 within one month from the date of communication of such decision to the applicant or within such further period not exceeding one month thereafter as the Controller may on a request made in Form 4 allow and shall be accompanied by a statement setting forth the grounds on which the review is sought. Where the decision in question concerns any other person in addition to the applicant, the Controller shall forthwith transmit a copy of each of the application and the statement to the other person concerned.

(1) An application to the Controller for setting aside an order passed by him ex parte under clause (g) of sub-section (1) of section 77 shall be made in Form 24 within one month from the date of communication of such order to the applicant or within such further period not exceeding one month as the Controller may on a request made in Form 4 allow and shall be accompanied by a statement setting forth the grounds on which the application is based. Where the order concerns any other person in addition to the applicant, the Controller shall, forthwith transmit a copy each of the application and the statement to the other person concerned.

Form and manner in which statements required under section 146(2) to be furnished: (1) The statements which shall be furnished by every patentee and every licensee under sub- section (2) of section 146 in Form 27 which shall be duly verified by the patentee or the licensee or his authorised agent.

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

(3) The Controller may publish the information received by him under subsection (1) or subsection (2) of section 146.

## **Form of application for the issue of a duplicate patent**

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

Supply of certified copies and certificates under sections 72 and 147

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

Provided that certified copies shall be issued in the order in which the request is filed.

- (2) Notwithstanding anything contained in sub-rule (1), certified copies shall be furnished within a period of one week if such request is made along with the fee specified therefore in the First Schedule.

#### Request for information under section 153

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

- (a) as to when a complete specification following a provisional specification has been filed or an application for patent has been deemed to have been abandoned; (aa) as to when the information under section 8 has been filed.
- (b) as to when publication of application has been made under section 11A; (c) as to when an application has been withdrawn under section 11B;
- (c) as to when a request for examination has been made under section 11B;
- (d) as to when the examination report has been issued under section 12;
- (e) as to when an application for patent has been refused;
- (f) as to when a patent has been granted;
- (g) as to when a renewal fee has been paid;
- (h) as to when the term of a patent has expired or shall expire;
- (i) as to when an entry has been made in the register or application has been made for the making of such entry; or
- (j) as to when any application is made or action taken involving an entry in the register, publication in the Official Journal or otherwise, if the nature of the application or action is specified in the request.

- (2) Separate request shall be made in respect of each item of information required.

- (3) The fee payable on a request to be made under section 153 shall be as set out in the First Schedule.

#### Agency

- (1) The authorization of an agent for the purposes of the Act and these rules shall be filed in Form 26 or in the form of a power of attorney within a period of three months from the date of filing of such application or document, failing which no action shall be taken on such application or documents for further processing till such deficiency is removed.

(2) Where any authorization has been made under sub-rule (1), service upon the agent of any document relating to any proceeding or matter under the Act or these rules shall be deemed to be service upon the person so authorizing him and all communications directed to be made to a person in respect of any proceeding or matter may be addressed to such agent, and all appearances before the Controller relating thereto may be made by or through such agent.

(3) Notwithstanding anything contained in sub-rule (1) and (2), the Controller may, if it is considered necessary, require the personal signature or presence of an applicant, opponent or party to such proceeding or matter.

### **Scale of costs**

(1) In all proceedings before the Controller, he may, subject to rule 63, award costs as he considers reasonable, having regard to all the circumstances of the case:

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

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

### **Powers of Controller generally**

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

### **Power to extend time prescribed**

- (1) Except for the time prescribed in clause (i) of sub-rule (4) of rule 20, sub-rule (6) of rule 20, rule 21, sub-rules (1), (5) and (6) of rule 24B, sub-rules (10) and (11) of rule 24C, sub-rule (4) of rule 55, sub-rule (1A) of rule 80 and sub-rules (1) and (2) of rule 130, the time prescribed by these rules for doing of any act or the taking of any proceeding there under may be extended by the Controller for a period of one month, if he thinks it fit to do so and upon such terms as he may direct.
- (2) Any request for extension of time prescribed by these rules for the doing of any act or the taking of any proceeding thereunder shall be made before the expiry of such time prescribed in these rules.

### **Hearing before the Controller to be in public in certain cases**

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

# APPLICATIONS AND FORMATS RELATED TO PATENTS

## "THE FIRST SCHEDULE

*(See rule 7)*

**Table I - FEES PAYABLE**

Number of entry	On what payable	Number of the relevant Form	For e-filing			For physical filing		
			Natural person(s) and/ or Startup	Small entity, alone or with natural person(s) and/ or Startup	Others, alone or with natural person(s) and/ or Startup and/ or small entity	Natural person(s) and/ or Startup	Small entity, alone or with natural person(s) and/ or Startup	Others, alone or with natural person(s) and/ or Startup and/ or small entity
1	2	3	4	5	6	7	8	9
			Rupees	Rupees	Rupees	Rupees	Rupees	Rupees
1.	On application for a patent under sections 7, 54 or 135 and rule 20(1) accompanied by provisional or complete specification—  (i) for each sheet of specification in addition to 30, excluding sequence listing of nucleotides and/ or amino acid sequences under sub-rule (3) of rule (9); (ii) for each claim in addition to 10; (iii) for each page of sequence listing of nucleotides and/ or amino acid sequences under sub-rule (3) of rule (9).	1	1600  Multiple of 1600 in case of every multiple priority.  (i) 160  (ii) 320  (iii) 160 subject to a maximum of 24000	4000  Multiple of 4000 in case of every multiple priority.  (i) 400  (ii) 800  (iii) 400 subject to a maximum of 60000	8000  Multiple of 8000 in case of every multiple priority.  (i) 800  (ii) 1600  (iii) 800 subject to a maximum of 120000	1750  Multiple of 1750 in case of every multiple priority.  (i) 180  (ii) 350  (iii) Not allowed	4400  Multiple of 4400 in case of every multiple priority.  (i) 440  (ii) 880  (iii) Not allowed	8800  Multiple of 8800 in case of every multiple priority.  (i) 880  (ii) 1750  (iii) Not allowed
2.	On filing complete specification after provisional up to 30 pages having up to 10 claims –  (i) for each sheet of specification in addition to 30, excluding sequence listing of nucleotides and/ or amino acid sequences under sub-rule (3)	2	No fee  (i) 160	No fee  (i) 400	No fee  (i) 800	No fee  (i) 180	No fee  (i) 440	No fee  (i) 880

	of rule (9);  (ii) for each claim in addition to 10.		(ii) 320	(ii) 800	(ii) 1600	(ii) 350	(ii) 880	(ii) 1800
	(iii) for each page of sequence listing of nucleotides and/ or amino acid sequences under sub-rule (3) of rule (9).		(iii) 160 subject to a maximum of 24000	(iii) 400 subject to a maximum of 60000	(iii) 800 subject to a maximum of 120000	Not allowed	Not allowed	Not allowed
3.	On filing a statement and undertaking under section 8.	3	No fee	No fee	No fee	No fee	No fee	No fee
4.	i) On request for extension of time under sections 53(2) and 142(4), rules 13(6), 80(1A) and 130 (per month).  ii) On request for extension of time under sub-rule (5) of rule 24B (per month).  iii) On request for extension of time under sub-rule (11) of rule 24C (per month).	4	480	1200	2400	530	1300	2600
		4	1000	2000	4000	1100	2200	4400
		4	2000	5000	10000	2200	5500	11000
5.	On filing a declaration as to inventorship under sub-rule (6) of rule 13.	5	No fee	No fee	No fee	No fee	No fee	No fee
6.	On application for postdating.	-	800	2000	4000	880	2200	4400
7.	On application for deletion of reference under section 19 (2).	-	800	2000	4000	880	2200	4400
8.	(i) On claim under section 20(1);  (ii) On request for direction under section 20 (4) or 20 (5).	6	800	2000	4000	880	2200	4400
		6	800	2000	4000	880	2200	4400
9.	(i) On notice of opposition to grant of patent under section 25(2);  (ii) On filing representation opposing grant of patent under section 25(1).	7	2400	6000	12000	2600	6600	13200
		7A	No fee	No fee	No fee	No fee	No fee	No fee
10.	On giving notice that hearing before Controller shall be attended under rule 62(2).	-	1500	3800	7500	1700	4100	8300
11.	On application under sections 28(2), 28(3) or 28(7).	8	800	2000	4000	880	2200	4400
12.	Request for publication under section 11A(2) and rule 24A.	9	2500	6250	12500	2750	6900	13750

13.	Application for withdrawing the application under section 11B(4), and rules 7(4A) and 26.	29	No fee	No fee	No fee	No fee	No fee	No fee
14.	On request for examination of application for patent— (i) under section 11B and rule 24(1); (ii) under rule 20(4)(ii).	18	4000 5600	10000 14000	20000 28000	4400 6150	11000 15400	22000 30800
14A.	On request for expedited examination of application for patent under rule 24C.	18A	8000	25000	60000	Not allowed	Not allowed	Not allowed
14B.	Conversion of the request for examination filed under rule 24B to request for expedited examination under rule 24C.	18 A	4000	15000	40000	Not allowed	Not allowed	Not allowed
15.	On application under section 44 for amendment of patent.	10	2400	6000	12000	2650	6600	13200
16.	On application for directions under section 51(1) or 51(2).	11	2400	6000	12000	2650	6600	13200
17.	On request for grant of a patent under sections 26(1) and 52(2).	12	2400	6000	12000	2650	6600	13200
18.	On request for converting a patent of addition to an independent patent under section 55 (1).	-	2400	6000	12000	2650	6600	13200
19.	For renewal of a patent under section 53—							
(i)	before the expiration of the 2nd year from the date of patent in respect of 3rd year;	-	800	2000	4000	880	2200	4400
(ii)	before the expiration of the 3rd year in respect of the 4th year;	-	800	2000	4000	880	2200	4400
(iii)	before the expiration of the 4th year in respect of the 5th year;	-	800	2000	4000	880	2200	4400
(iv)	before the expiration of the 5th year in respect of the 6th year;	-	800	2000	4000	880	2200	4400
(v)	before the expiration of the 6th year in respect of the 7th year;	-	2400	6000	12000	2650	6600	13200
(vi)	before the expiration of the 7th year in respect of the 8th year;	-	2400	6000	12000	2650	6600	13200

(vii)	before the expiration of the 8th year in respect of the 9th year;	-	2400	6000	12000	2650	6600	13200
(viii)	before the expiration of the 9th year in respect of the 10th year;	-	2400	6000	12000	2650	6600	13200
(ix)	before the expiration of the 10th year in respect of the 11th year;	-	4800	12000	24000	5300	13200	26400
(x)	before the expiration of the 11th year in respect of the 12th year;	-	4800	12000	24000	5300	13200	26400
(xi)	before the expiration of the 12th year in respect of the 13th year;	-	4800	12000	24000	5300	13200	26400
(xii)	before the expiration of the 13th year in respect of the 14th year;	-	4800	12000	24000	5300	13200	26400
(xiii)	before the expiration of the 14th year in respect of the 15th year;	-	4800	12000	24000	5300	13200	26400
(xiv)	before the expiration of the 15th year in respect of the 16th year;	-	8000	20000	40000	8800	22000	44000
(xv)	before the expiration of the 16th year in respect of the 17th year;	-	8000	20000	40000	8800	22000	44000
(xvi)	before the expiration of the 17th year in respect of the 18th year;	-	8000	20000	40000	8800	22000	44000
(xvii)	before the expiration of the 18th year in respect of the 19th year;	-	8000	20000	40000	8800	22000	44000
(xvii) )	before the expiration of the 19th year in respect of the 20th year.		8000	20000	40000	8800	22000	44000
20.	On application for amendment of application for patent or complete specification or other related documents under section 57—	13						
(i)	before grant of patent:		800	2000	4000	880	2200	4400
(ii)	after grant of patent:		1600	4000	8000	1750	4400	8800

(iii)	where amendment is for changing name or address or nationality or address for service.		320	800	1600	350	880	1750
21.	On notice of opposition to an application under sections 57(4), 61(1) and 87(2) or to surrender a patent under section 63(3) or to a request under section 78(5).	14	2400	6000	12000	2650	6600	13200
22.	On application for restoration of a patent under section 60.	15	2400	6000	12000	2650	6600	13200
23.	Additional fee for restoration under section 61(3) and rule 86(1).	—	4800	12000	24000	5300	13200	26400
24.	On notice of offer to surrender a patent under section 63.	—	1000	2500	5000	1100	2750	5500
25.	On application for the entry in the register of patents of the name of a person entitled to a patent or as a share or as a mortgage or as licensee or as otherwise or for the entry in the register of patents of notification of a document under sections 69(1) or 69(2) and rules 90(1) or 90(2).	16	1600 (In respect of each patent)	4000 (In respect of each patent)	8000 (In respect of each patent)	1750 (In respect of each patent)	4400 (In respect of each patent)	8800 (In respect of each patent)
26.	On application for alteration of an entry in the register of patents or register of patent agents under rules 94(1) or rule 118(1).	—	320	800	1600	350	880	1750
27.	On request for entry of an additional address for service in the Register of Patents under rule 94(3).	—	800	2000	4000	880	2200	4400
28.	On application for compulsory license under sections 84(1), 91(1), 92(1) and 92A.	17	2400	6000	12000	2650	6600	13200
29.	On application for revocation of a patent under section 85(1).	19	2400	6000	12000	2650	6600	13200
30.	On application for revision of terms and conditions of licence under section 88(4).	20	2400	6000	12000	2650	6600	13200

31.	On request for termination of compulsory licence under section 94.	21	2400	6000	12000	2650	6600	13200
32.	On application for registration as a patent agent under rule 109(1) or rule 112.	22	3200	Not applicable	Not applicable	3500	Not applicable	Not applicable
33.	On request for appearing in the qualifying examination under rule 109(3).	—	1600	Not applicable	Not applicable	1750	Not applicable	Not applicable
34.	For continuance of the name of a person in the register of patent agents— (i) for the 1st year to be paid along with registration; (ii) for every year excluding the 1st year to be paid on the 1st April in each year.	—	800	Not applicable	Not applicable	880	Not applicable	Not applicable
35.	On application for duplicate certificate of patent agent under rule 111A.	--	1600	Not applicable	Not applicable	1750	Not applicable	Not applicable
36.	On application for restoration of the name of a person in the register of patent agents under rule 117(1).	23	1600 (Plus continuation fee under entry number 34)	Not applicable	Not applicable	1750 (Plus continuation fee under entry number 34)	Not applicable	Not applicable
37.	On a request for correction of clerical error under section 78(2).	—	800	2000	4000	880	2200	4400
38.	On application for review or setting aside the decision or order of the controller under section 77(1)(f) or 77(1)(g).	24	1600	4000	8000	1750	4400	8800
39.	On application for permission for applying patent outside India under section 39 and rule 71(1).	25	1600	4000	8000	1750	4400	8800
40.	On application for duplicate patent under section 154 and rule 132.	—	1600	4000	8000	1750	4400	8800

41.	(i) On request for certified copies under section 72 or for certificate under section 147 and rule 133(1).	—	1000 (up to 30 pages and, thereafter, 30 for each extra page)	2500 (up to 30 pages and, thereafter, 75 for each extra page)	5000 (up to 30 pages and, thereafter, 150 for each extra page)	1100 (up to 30 pages and, thereafter, 30 for each extra page)	2750 (up to 30 pages and, thereafter, 75 for each extra page)	5500 (up to 30 pages and, thereafter, 150 for each extra page)
	(ii) On request for certified copies under section 72 or for certificate under section 147 and rule 133(2).	--	2400 (up to 30 pages and, thereafter, 30 for each extra page)	6000 (up to 30 pages and, thereafter, 30 for each extra page)	12000 (up to 30 pages and, thereafter, 30 for each extra page)	3300 (up to 30 pages and, thereafter, 30 for each extra page)	6600 (up to 30 pages and, thereafter, 30 for each extra page)	13200 (up to 30 pages and, thereafter, 30 for each extra page)
42.	For certifying office copies, printed each.	—	800	2000	4000	880	2200	4400
43.	On request for inspection of register under section 72, inspection under rule 27 or rule 74A.	—	320	800	1600	350	880	1750
44.	On request for information under section 153 and rule 134.	—	480	1200	2400	530	1300	2650
45.	On form of authorisation of a patent agent.	26	No fee	No fee	No fee	No fee	No fee	No fee
46.	On petition not otherwise provided for.	—	1600	4000	8000	1750	4400	8800
47.	For supplying of photocopies of the documents, per page.	—	10	10	10	10	10	10
48.	Transmittal fee for International application.	—	3200	8000	16000	3500	8800	17600
49.	For preparation of certified copy of priority document and for transmission of the same to the International Bureau of World Intellectual Property Organization.	—	1000 (up to 30 pages and, thereafter, 30 for each extra page)	2500 (up to 30 pages and, thereafter, 75 for each extra page)	5000 (up to 30 pages and, thereafter, 150 for each extra page)	1100 (up to 30 pages and, thereafter, 30 for each extra page)	2750 (up to 30 pages and, thereafter, 75 for each extra page)	5500 (up to 30 pages and, thereafter, 150 for each extra page)
50.	On statement regarding working of a patented invention on a commercial scale in India under section 146(2) and rule 131(1).	27	No fee	No fee	No fee	No fee	No fee	No fee
51.	To be submitted for claiming the status of a small entity or startup	28	No fee	No fee	No fee	No fee	No fee	No fee
52.	Request for adjournment of hearing under rule 129A (for each adjournment).	-	1000	2500	5000	1100	2750	5500
53.	Miscellaneous form under rule 8(2), to be used when no other form is prescribed.	30	As applicable					

Table II - FEES REFUNDABLE

On what account fee refundable	Refund of fees
Refund of fees under sub-rule (4A) of rule 7	90% of fee paid for request for examination or request for expedited examination”.

**THE SECOND SCHEDULE**

(See rule 8)

**FORMS**

**LIST OF FORMS**

<b>Form No.</b>	<b>Section and rule</b>	<b>Title</b>
1	2	3
1.	Sections 7, 54 and 135 and rule 20(i).	Application for grant of a patent.
2.	Section 10; rule 13.	Provisional/Complete Specification.
3.	Section 8 and rule 12.	Statement and undertaking.
4.	Sections 53(2) and 142(4), rules 13(6), 24B(4)(ii), 80(1A) and 130.	Request for extension for time.
5.	Section 10(6) and rule 13(6).	Declaration as to inventorship.
6.	Sections 20(1), 20(4), 20(5) and rules 34(1), 35(1) or 36(1).	Claim or request regarding any change in applicant for patent.
7.	Section 25(3) and rule 55A.	Notice of opposition on grant of a patent.
7A.	Section 25(1) and rule 55(1)	For filing a representation opposing grant of a patent under sub-section (1) of section 25.
8.	Sections 28(2), 28(3) or 28(7) and rules 66, 67, 68.	Request or claim regarding mention of inventor as such in a patent.
9.	Section 11A(2) and rule 24A.	Request for publication.
10.	Section 44 and rule 75.	Application for amendment of patent.
11.	Sections 51(1), 51(2) and rules 76, 77.	Application for direction of the Controller.
12.	Sections 26(1) & 52(2) and rules 63A and 79.	Request for grant of patent.
13.	Section 57 and rule 81(1).	Application for amendment of the application for patent/complete specification.

1	2	3
14.	Sections 57(4), 61(1), 63(3), 78(5) and 87(2) and rules 81(3)(b), 85(1), 87(2), 98(1), 101(3) or 124	Notice of opposition to amendment/ restoration/surrender of patent/grant of compulsory licence or revision of terms thereof or to a correction of clerical errors.
15.	Section 60 and rule 84.	Application for restoration of patents.
16.	Sections 69(1) or 69(2) and rules 90(1) and 90(2).	Application for registration of a title/ interest in a patent or share in it or registration of any document purporting to affect proprietorship of the patent.
17.	Sections 84(1), 91, 92 or 92(A) and rule 96.	Application for compulsory licence.
18.	Section 11B and rules 20(4)(ii) and 24B(1)(i).	Request for examination of application for patent.
19.	Section 85(1) and rule 96.	Application for revocation of a patent for non-working.
20.	Section 88(4) and rule 100.	Application for revision of terms and conditions of licence.
21.	Section 94, rule 102(1).	Request for termination of compulsory licence.
22.	Rules 109(1) and 112.	Application for registration of Patent Agent.
23.	Section 130(2) and rule 117(1).	Application for the restoration of the name in the register of Patent Agents.
24.	Sections 77(1)(f), 77(1)(g) and rules 130(1) and 130(2).	Application for review/setting aside controller's decision/order.
25.	Section 39 and rule 71(1).	Request for permission for making patent application outside India.
26.	Sections 127, 132 and rule 135.	Form of authorisation of a Patent Agent/ or any person in a matter or proceeding under the Act.
27.	Section 146(2) and rule 131(1).	Statement regarding the working of the Patented invention on commercial scale in India.
28.	Rules 2(fa) and 7	To be submitted by a small entity with every document for which a fee has been specified.

**(iii) Declaration by the applicant(s)**

I/We the applicant(s) hereby declare(s) that: -

- I am/ We are in possession of the above-mentioned invention.
- The provisional/complete specification relating to the invention is filed with this application.
- The invention as disclosed in the specification uses the biological material from India and the necessary permission from the competent authority shall be submitted by me/us before the grant of patent to me/us.
- There is no lawful ground of objection(s) to the grant of the Patent to me/us.
- I am/we are the true & first inventor(s).
- I am/we are the assignee or legal representative of true & first inventor(s).
- The application or each of the applications, particulars of which are given in Paragraph-8, was the first application in convention country/countries in respect of my/our invention(s).
- I/We claim the priority from the above mentioned application(s) filed in convention country/countries and state that no application for protection in respect of the invention had been made in a convention country before that date by me/us or by any person from which I/We derive the title.
- My/our application in India is based on international application under Patent Cooperation Treaty (PCT) as mentioned in Paragraph-9.
- The application is divided out of my /our application particulars of which is given in Paragraph-10 and pray that this application may be treated as deemed to have been filed on DD/MM/YYYY under section 16 of the Act.
- The said invention is an improvement in or modification of the invention particulars of which are given in Paragraph-11.

**13. FOLLOWING ARE THE ATTACHMENTS WITH THE APPLICATION**

(a) Form 2

Item	Details	Fee	Remarks
Complete/ provisional specification) #	No. of pages		
No. of Claim(s)	No. of claims and No. of pages		
Abstract	No. of pages		
No. of Drawing(s)	No. of drawings and No. of pages		

# In case of a complete specification, if the applicant desires to adopt the drawings filed with his provisional specification as the drawings or part of the drawings for the complete specification under rule 13(4), the number of such pages filed with the provisional specification are required to be mentioned here.

- (b) Complete specification (in conformation with the international application)/as amended before the International Preliminary Examination Authority (IPEA), as applicable (2 copies).
- (c) Sequence listing in electronic form
- (d) Drawings (in conformation with the international application)/as amended before the International Preliminary Examination Authority (IPEA), as applicable (2 copies).
- (e) Priority document(s) or a request to retrieve the priority document(s) from DAS (Digital Access Service) if the applicant had already requested the office of first filing to make the priority document(s) available to DAS.
- (f) Translation of priority document/Specification/International Search Report/International Preliminary Report on Patentability.
- (g) Statement and Undertaking on Form 3
- (h) Declaration of Inventorship on Form 5
- (i) Power of Authority
- (j).....

**Total fee**  .....in Cash/ Banker's Cheque /Bank Draft bearing No.....      **Date**.....on  
.....**Bank**.

I/We hereby declare that to the best of my/our knowledge, information and belief the fact and matters slated herein are correct and I/We request that a patent may be granted to me/us for the said invention.

Dated this.....day of.....20.....

Signature:

Name:

To,

The Controller of Patents

The Patent Office, at.....

Note: -

\* Repeat boxes in case of more than one entry.

\* To be signed by the applicant(s) or by authorized registered patent agent otherwise where mentioned.

\* Tick (✓)/cross (x) whichever is applicable/not applicable in declaration in paragraph-12.

\* Name of the inventor and applicant should be given in full, family name in the beginning.

\* Strike out the portion which is/are not applicable.

\* For fee: See First Schedule";

**FORM 2**  
**THE PATENT ACT 1970**  
(39 of 1970)  
&  
The Patents Rules, 2003  
**PROVISIONAL/COMPLETE SPECIFICATION**  
(See section 10 and rule 13)

<b>1. TITLE OF THE INVENTION</b>	
<b>2. APPLICANT (S)</b> (a) NAME: (b) NATIONALITY: (c) ADDRESS:	
<b>3. PREAMBLE TO THE DESCRIPTION</b>	
<b>PROVISIONAL</b>	<b>COMPLETE</b>
The following specification describes the invention.	The following specification particularly describes the invention and the manner in which it is to be performed.
<b>4. DESCRIPTION</b> (Description shall start from next page.)	
<b>5. CLAIMS</b> (not applicable for provisional specification. Claims should start with the preamble — “I/we claim” on separate page)	
<b>6. DATE AND SIGNATURE</b> (to be given at the end of last page of specification)	
<b>7. ABSTRACT OF THE INVENTION</b> (to be given along with complete specification on separate page)	
<p><b>Note:</b> -</p> <p>*Repeat boxes in case of more than one entry.</p> <p>*To be signed by the applicant(s) or by authorized registered patent agent.</p> <p>*Name of the applicant should be given in full, family name in the beginning.</p> <p>*Complete address of the applicant should be given stating the postal index no./code, state and country.</p> <p>*Strike out the column which is/are not applicable</p>	

**FORM 3**

THE PATENTS ACT, 1970

(39 of 1970)

and

THE PATENTS RULES, 2003

**STATEMENT AND UNDERTAKING UNDER SECTION 8**

(See section 8; Rule 12)

1. Name of the applicant(s).		I/We..... ..... .....			
		..... ..... hereby declare:			
2. Name, address and nationality of the joint applicant.		(i) that I/We have not made any application for the same/substantially the same invention outside India Or (ii) that I/We who have made this application No.....dated .....alone/jointly with ....., made for the same/ substantially same invention, application(s) for patent in the other countries, the particulars of which are given below:			
Name of the country	Date of application	Application No.	Status of the application	Date of publication	Date of grant
3. Name and address of the assignee		(iii) that the rights in the application(s) has/have been assigned to..... ..... ..... ..... that I/We undertake that upto the date of grant of the patent by the Controller, I/We would keep him informed in writing the details regarding corresponding applications for patents filed outside India within six months from the date of filing of such application.			
		Dated this.....day of.....20....			
4. To be signed by the applicant or his authorized registered patent agent.		Signature.....			
5. Name of the natural person who has signed.		(.....).			
		To The Controller of Patents, The Patent Office, at.....			
Note.- Strike out whichever is not applicable;					

**FORM 4**  
**THE PATENTS ACT, 1970**  
**(39 of 1970)**  
**and**  
**THE PATENTS RULES, 2003**  
**REQUEST FOR EXTENSION OF TIME**

[See sections 53(2), and 142 (4); rules 13(6), 24B(6), 24C(11) and 80(1A), 130]

1. Name of the applicant	I/We.....   hereby request for extension of time for .....months(s) under section/rule.....in connection with my/our/application/Patent No..... The reasons for making the request are as follows:-   ....  ....  Dated this.....day of .....20....
2. To be signed by the applicant or his authorized registered patent agent	Signature (.....)
3. Name of the natural person who has signed	
	To The Controller of Patents, The Patent Office, at.....
Note.- For fee: See First Schedule."	

**FORM 5**  
**THE PATENTS ACT, 1970**  
(39 of 1970)

&

**The Patents Rules, 2003**  
**DECLARATION AS TO INVENTORSHIP**  
[See section 10(6) and rule 13(6)]

**1. NAME OF APPLICANT (S)**

hereby declare that the true and first inventor(s) of the invention disclosed in the complete specification filed in pursuance of my /our application numbered dated is/are

**2. INVENTOR (S)**

- (a) NAME
- (b) NATIONALITY
- (c) ADDRESS

Dated this ..... day of ..... 20 .....

Signature: -

Name of the signatory: -

**3. DECLARATION TO BE GIVEN WHEN THE APPLICATION IN INDIA IS FILED BY THE APPLICANT (S) IN THE CONVENTION COUNTRY: -**

We the applicant(s) in the convention country hereby declare that our right to apply for a patent in India is by way of assignment from the true and first inventor(s).

Dated this ..... day of ..... 20 .....

Signature: -

Name of the signatory: -

**4. STATEMENT (to be signed by the additional inventor(s) not mentioned in the application form)**

I/We assent to the invention referred to in the above declaration, being included in the complete specification filed in pursuance of the stated application.

Dated this ..... day of ..... 20 .....

Signature of the additional inventor(s): -

Name: -

To, The Controller of Patents

The Patent Office, at.....

**Note**

\*Repeat boxes in case of more than one entry.

\*To be signed by the applicant(s) or by authorized registered patent agent otherwise where mentioned.

\*Name of the inventor and applicant should be given in full, family name in the beginning .

\*Complete address of the inventor should be given stating the postal index no./code, state and country.

\*Strike out the column which is/ are not applicable

**FORM 6**  
**THE PATENTS ACT, 1970**  
(39 of 1970)  
&  
The Patents Rules, 2003

**CLAIM OR REQUEST REGARDING ANY CHANGE IN APPLICANT  
FOR PATENT**

[ See sections 20(1), 20(4) and 20(5); rules 34(1), 35(1) and 36(1) ]

1. Repeat the columns (a) to (c) if there are more than one applicant.
2. Insert the name in full. The family or principal name in the beginning if the applicant is a natural person.
3. Insert the complete address including postal index number/code and state and/or country.
4. Insert the nationality.
5. State the name of the applicant(s) for patent.
6. Original and certified copies of the documents shall accompany the claim or request. Consent by the legal representative of the deceased joint applicant shall be filed whenever required.
7. Insert the details of the documents.
8. Complete address including postal index number/code and state along with Telephone and fax number(s).
9. To be signed by the applicant(s) or authorized registered patent agent.
10. Name of the natural person who has signed.

I/We,<sup>1</sup> \_\_\_\_\_  
(a)<sup>2</sup> \_\_\_\_\_  
(b)<sup>3</sup> \_\_\_\_\_  
(c)<sup>4</sup> \_\_\_\_\_

hereby request that the application for patent No..... dated ..... made by<sup>5</sup> \_\_\_\_\_

may proceed in my/our name and further request that direction of the Controller, if necessary be made in that effect

Reasons for making the above request are as follows:-  
\_\_\_\_\_  
\_\_\_\_\_

I furnish the following document(s) in support of my above request:<sup>6</sup>

(a)<sup>7</sup> \_\_\_\_\_  
(b)<sup>7</sup> \_\_\_\_\_  
(c)<sup>7</sup> \_\_\_\_\_

My/our address for service in India is:<sup>8</sup>

\_\_\_\_\_  
\_\_\_\_\_

Dated this ..... day of ....., 200

Signature<sup>9</sup> ..  
(-----) <sup>10</sup>..

To  
The Controller of Patents,  
The Patent Office,  
At .....

**N.B.:** This form is not applicable for mere change of name.

Note: (a) Strike out whichever is not applicable.

(b) For fee:-See First Schedule.

**FORM 7**  
**THE PATENTS ACT, 1970**  
(39 of 1970)  
&  
The Patents Rules, 2003  
**NOTICE OF OPPOSITION**  
[ See sections 25(2) and rule 55A]

1. State names, address and nationality. I/We,<sup>1</sup>.....  
\_\_\_\_\_  
\_\_\_\_\_

hereby give notice of opposition to  
patent No. ....) granted on  
application No. ....dated.....  
published      on      dated.....made  
by.....  
on the grounds <sup>2</sup>.  
\_\_\_\_\_  
\_\_\_\_\_

3. Complete address including postal index number/code and state along with Telephone and fax number.

My/Our address for services in India is.<sup>3</sup>  
.....  
.....

4. To be signed by the opponent or by his authorized registered patent agent.

Signature <sup>4</sup>....  
(.....) <sup>5</sup>....

5. Name of the natural person who has signed.

To  
The Controller of Patents,  
The Patent Office,  
At .....

For fee : See First Schedule.

**FORM 7A**  
**THE PATENTS ACT, 1970 (39 OF 1970)**  
**AND**  
**THE PATENTS RULES, 2003**  
**REPRESENTATION FOR OPPOSITION TO GRANT OF PATENT**  
**{see rule 55}**

1. State names, address and nationality.

I/We,.....

.....  
hereby give representation by way of  
opposition to the grant of patent in  
respect of application  
no.....dated.....  
made by.....and published on  
.....

2. State the grounds taken one after  
another.

on the grounds .....,  
.....  
.....

3. Complete address including postal  
index number/code and state along  
with telephone and fax number.

My/our address for service in India is  
.....  
.....  
.....

4. To be signed by the opponent or by his/her  
authorized registered patent agent.

Signature

5. Name and designation of the natural person who has signed.

(.....)

To  
The Controller of Patents,  
The Patent Office,  
At .....

**FORM 8**  
**THE PATENTS ACT, 1970**  
(39 of 1970)  
&  
The Patents Rules, 2003  
**REQUEST OR CLAIM REGARDING MENTION OF**  
**INVENTOR AS SUCH IN A PATENT**  
[ See sections 28(2), 28(3) and 28(7); rules 66, 67 and 68 ]

1. State names, address and nationality of the person making this application. I/We,<sup>1</sup>.....  
.....  
.....  
hereby state/claim that the following person(s) be mentioned as inventor(s) in the patent application No. .... dated ..... made by \_\_\_\_\_ or hereby declare that<sup>2</sup>.  
.....  
.....  
.....  
ought not to have mentioned as inventor in the application for Patent No. .... dated ..... made by ..... and I/We hereby apply for a certificate to that effect.
2. Insert the name of the person mentioned as inventor.
3. Complete address including postal index number/code and state along with Telephone and fax number(s). A Statement setting out the circumstances under which this application is made is attached together with the copy/copies thereof as required under the rules.
4. To be signed by the applicant or his authorized registered patent agent. My/Our address for service in India is<sup>3</sup>,  
\_\_\_\_\_

Dated this ..... day of ..... 20

5. Name of the natural person who has signed. Signature..<sup>4</sup>...  
(.....)<sup>5</sup>  
To  
The Controller of Patents,  
The Patent Office,  
At .....

Note :- For fee : See First Schedule.

**FORM 9**  
**THE PATENTS ACT, 1970**  
**(39 of 1970)**  
**&**  
**The Patents Rules, 2003**  
**REQUEST FOR PUBLICATION**  
[ See section 11A(2); rule 24A ]

1. Name, address and nationality of  
the applicant(s). I/We<sup>1</sup>.....

.....  
.....  
.....

2. To be signed by the applicant or  
his authorized registered patent  
agent. hereby request for early publication of my/our  
Patent application No ..... dated  
.....under section 11A(2) of the  
Act.

Dated this ..... day of ..... 20

3. Name of the natural person who  
has signed. Signature ..<sup>2</sup>...  
(.....).<sup>3</sup>...

To  
The Controller of Patents,  
The Patent Office,  
At .....

Note: - For fee : See First Schedule

**FORM 10**  
**THE PATENTS ACT, 1970**  
**(39 of 1970)**  
**&**  
**The Patents Rules, 2003**  
**APPLICATION FOR AMENDMENT OF PATENT**  
**[ See section 44; rule 75]**

1. Repeat the columns (a) to (c) if there are more than one applicant.

I/We.<sup>1</sup>..

(a).<sup>2</sup>.....

(b).<sup>3</sup>.....

(c).<sup>4</sup>.....

(a).<sup>2</sup>.....

(b).<sup>3</sup>.....

(c).<sup>4</sup>.....

(a).<sup>2</sup>.....

(b).<sup>3</sup>.....

(c).<sup>4</sup>.....

2. Insert the name in full, Family or principal name in the beginning if the applicant is a natural person.

3. Insert the complete address including postal index number/code and state and/or country.

4. Insert the nationality.

hereby request that Patent No.-----

dated \_\_\_\_\_ granted to

5. Complete address including postal index number/code and state along with Telephone and fax number(s).

may be amended by substituting my/our name for the name of the grantee and in support to my/our request, I/We furnish the following documents :

.....  
My/our address for service in India is.<sup>5</sup>  
.....  
.....

Dated this ..... day of ..... 20

6. To be signed by the applicant(s) or his authorised registered patent agent.

Signature.. 6.....

7. Name of the natural person who has signed.

(-----)..<sup>7</sup>...

To  
The Controller of Patents,  
The Patent Office,  
At.....

Note : - For fee : See First Schedule

**FORM 11**  
**THE PATENTS ACT, 1970**  
(39 of 1970)  
&

The Patents Rules, 2003

**APPLICATION FOR DIRECTION OF THE CONTROLLER**  
[ See sections 51(1) and 51(2); rules 76 and 77 ]

1. State the name in full, address  
and nationality.

I/We<sup>1</sup>.....  
.....

hereby apply for the following direction in respect  
of patent No. -----

dated..... grant to-----

2. Complete address including  
postal index number/code and  
state along with Telephone and  
fax number(s).

The reasons for making this application are as  
follows :

3. To be signed by the applicant(s)  
or his authorised registered patent  
agent.

My/Our address for service in India  
is:..<sup>2</sup>.....

Dated this ..... day of ..... 20

4. Name of the natural person who  
has signed.

Signature ..<sup>3</sup>...  
(-----) <sup>4</sup>

To  
The Controller of Patents,  
The Patent Office,  
At .....

Note: - For fee : See First Schedule

**FORM 12**  
**THE PATENTS ACT, 1970**

(39 of 1970)

&

The Patents Rules, 2003

**REQUEST FOR GRANT OF PATENT UNDER SECTION 26(1) & 52(2)**

[ See sections 26(1) & 52(2); rules 63A and 79]

1. Repeat the columns (a) to (c) if there are more than one applicant.  
I/We<sup>1</sup>.....  
.....  
(a).<sup>2</sup>.....  
.....  
(b).<sup>3</sup>.....  
.....  
(c).<sup>4</sup>.....  
hereby declare :  
that I/We made opposition under section 25(3)  
before the Controller or a petition under Section 64  
of the Act before the Appellate Board or High Court  
of<sup>5</sup>.....  
.....  
and the details of the patent and the opposition for  
the petition are given below :  
Patent No. ..... dated  
..... Grantee / Patentee  
..... Oppositio  
n  
Notice dated ..... or Petition No.  
..... dated.....  
(ii ) that I/We have claimed to be the true  
and first inventor(s)/assignee(s)/legal  
representative(s) of<sup>6</sup>
2. Insert the name in full. Family or principal name in the beginning, if the applicant is a natural person.
3. Insert the complete address including postal code and state and/or country.
4. Nationality of the person. (i)
5. Name of the High Court.
6. Name, address and nationality of the true and first inventor.
7. Complete address including postal index number code and state along with Telephone and fax number(s).
8. To be signed by the applicant(s)

or his authorised registered patent agent. ....  
.....  
.....

the true and first inventor of the invention for which the said patent was granted.

- (iii) that by an order in the said opposition or petition the patent was revoked/the complete specification of the patent was directed to be amended by exclusion of ..... claims thereof.
- (iv) that the Controller or Appellate Board or Court ordered to grant to me a patent in lieu of the said patent/part of the invention excluded by the amendment.
- (v) that I/We submit a statement and certified copy of the order of the Controller or Appellate Board or Court in support of my application and request that a patent be granted to me in accordance with the order of the Appellate Board or Court.

9. Name of the natural person who has signed.

My/Our address for service in India is : .<sup>7</sup>

.....  
.....

Dated this ..... day of ..... 200

Signature <sup>8</sup>

(-----) <sup>9</sup> ....  
To  
The Controller of Patents,  
The Patent Office,  
At .....

Note: -(a) Strike out whichever is not applicable.

(b) For fee : See First Schedule.

**FORM 13**  
**THE PATENTS ACT, 1970**  
**(39 of 1970)**  
**and**  
**THE PATENTS RULES, 2003**

**APPLICATION FOR AMENDMENT OF THE APPLICATION FOR PATENT/  
COMPLETE SPECIFICATION/ANY DOCUMENT RELATED THERETO**

[See section 57; sub-rule (1) of rule 81]

1. Name of the applicant(s).	<p>I/We.....          .....          request leave to amend the application/any document related thereto/complete specification with respect to application for patent No.....dated.....as highlighted in the copy hereto annexed.</p> <p>My/Our reason for making this request are as follows:-          .....          .....</p> <p>I/We declare that no action for infringement or for the revocation of the patent in question is pending before Appellate Board or a Court.</p> <p>I/We declare that the facts and matters stated herein are true to the best of my/our knowledge information and belief.</p>
2. To be signed by the applicant(s) or patentee(s) or by his authorized registered patent agent	<p>Dated this.....day of.....20.....</p> <p>Signature.....</p>
3. Name of the natural person who has signed	<p>(.....)</p>
	<p>To          The Controller of Patents,          The Patent Office,          at.....</p>
<p>Note - For fee: See First Schedule.”;</p>	

**FORM 14**  
**THE PATENTS ACT, 1970**  
**(39 of 1970)**  
**&**

**The Patents Rules, 2003**

**NOTICE OF OPPOSITION TO AMENDMENT / RESTORATION / SURRENDER  
OF PATENT/GRA NT OF COMPULSORY LICENCE OR REVISION OF TERMS  
THEREOF OR TO CORRECTION OF CLERICAL ERRORS**

**[See sections 57(4), 61(1), 63(3), 78(5) and 87(2); rules 81(3)(b), 85(1), 87(2),  
98(1), 101(3) and 124]**

1. State the name, address and nationality.

I/We<sup>1</sup>.....  
.....

hereby give notice of opposition: -  
to the amendment of the application/specification with respect to application for Patent No. ..... dated .....

OR

to the application for restoration of Patent No. .... dated .....

OR

to the offer to surrender the Patent No. .... dated .....

OR

for the grant of compulsory licence, or revocation of Patent No. .... dated .....

OR

-for the revision of the terms and conditions of licence in respect of Patent No. .... dated .....

OR

for correction of a clerical error in Patent No. .... dated .....

..... / Specification No. .... dated .....

..... in respect of Patent No. .... dated .....

..... or Patent application No. .... dated .....

The grounds in which the said opposition is made are as follows:

.....

My / Our address for service in India is: <sup>2</sup> .....

.....

Dated this ..... day of ..... 20

Signature . 3. ....

(-----) <sup>4</sup> ....

To

The Controller of Patents,

The Patent Office,

At .....

Note: -(a) Strike out whichever is not applicable.

(b) For fee : See First Schedule.

**FORM 15**  
**THE PATENTS ACT, 1970**  
(39 of 1970)  
&  
The Patents Rules, 2003  
**APPLICATION FOR THE RESTORATION OF PATENT**  
[See section 60; rule 84]

1. Insert the name, address,  
nationality of the applicant(s).  
I/We<sup>1</sup>.....  
.....  
.....

hereby apply for an order of the Controller for the  
restoration of Patent No. .... dated  
..... granted to.....  
.....

The circumstances which led to the failure to pay  
the renewal fee to pay the renewal fee for the year  
.....  
on or before ..... are as follows:  
.....

I/We declare that I/We have not assigned the patent  
to any other person(s) and that the facts and  
matters stated herein are true to the best of my/our  
knowledge information and belief.

Dated this ..... day of ..... 20

2. To be signed by the applicant(s) or  
by his authorised registered patent  
agent.  
Signature<sup>2</sup>.....  
(-----)<sup>3</sup>

3. Name of the natural person who  
has signed.  
To  
The Controller of Patents,  
The Patent Office,  
At .....

Note: For fee : See First Schedule.

**FORM 16**  
**THE PATENTS ACT, 1970**  
(39 of 1970)  
&

The Patents Rules, 2003

**APPLICATION FOR REGISTRATION OF TITLE/INTEREST IN A  
PATENT OR SHARE IN IT OR REGISTRATION OF ANY  
DOCUMENT PURPORTING TO AFFECT PROPRIETORSHIP OF  
THE PATENT**

[See sections 69(1), 69(2); rules 90(1) and 90(2)]

1. Insert the name, address and nationality of the applicant(s).

I/We<sup>1</sup>.  
.....  
.....

hereby apply that my/our name(s) may be registered in the register of patent as a person entitled to the patent/a share in the patent/an interest in the patent details of which are specified below:

Patent No. .... dated .....  
Grantee.....Patentee .....  
and in proof thereof we transmit the accompanying<sup>2</sup>.....  
.....with a certified copy thereof.

OR

Transmit herewith an attested copy of<sup>2</sup>  
.....in respect of Patent  
No(s).....dated .....  
granted to .....  
of which the patentee is .....  
.....as  
well as the original document for verification and  
I/We hereby apply that a notification thereof may  
be entered in the register of patents.

My/Our address for service in India is<sup>3</sup>.  
.....  
.....

Dated this ..... day of ..... 20

Signature . 4.....  
(-----) <sup>5</sup>

To  
The Controller of Patents,  
The Patent Office,  
At .....

Note : - (a) For fee : See First Schedule.

(b) Strike out whichever is not applicable.

**FORM 17**  
**THE PATENTS ACT, 1970**  
**(39 of 1970)**  
**&**  
**The Patents Rules, 2003**  
**APPLICATION FOR COMPULSORY LICENCE**  
**[See sections 84(1), 91, 92(1) or 92A; rule 96]**

1. Name, address and I/We.<sup>1</sup>.....  
nationality of the applicant(s).  
.....  
hereby apply for the grant of a compulsory licence  
under Patent No. .... dated .....  
granted to .....  
..... for which the patentee is  
..... on the following  
grounds, namely :  
.....  
.....  
I/We declare that the facts and matters stated  
herein are true to the best of my/our  
knowledge, information and belief.  
The details of documentary evidence in support of  
my/our interest and the grounds stated above are  
given below<sup>2</sup> .....  
(a) .....  
(b) .....  
(c) .....  
My/Our address for service in India is: <sup>3</sup> .....  
Dated this ..... day of ..... 20

5. Name of the natural person  
who has signed.

Signature <sup>4</sup> .....

(..... ) <sup>5</sup> .....

To  
The Controller of Patents,  
The Patent Office,  
At .....

Note: For fee : See First Schedule.

<b>FORM 18</b> <b>THE PATENTS ACT, 1970</b> (39 of 1970) & <b>The Patents Rules, 2003</b> <b>REQUEST/EXPRESS REQUEST FOR EXAMINATION</b> <b>OF APPLICATION FOR PATENT</b> <b>[See section 11B and rule 20(4)(ii), 24B(1)(i)]</b>	<b>(FOR OFFICE USE ONLY)</b> RQ. No: Filing Date: Amount of Fee Paid: CBR No: Signature:
<p><b>1. APPLICANT (S)/OTHER INTERESTED PERSON</b></p> <p>(a) NAME : _____</p> <p>(b) NATIONALITY : _____</p> <p>(c) ADDRESS : _____</p> <p>(d) date of publication of the application under section 11A ..... _____</p> <p><b>2. Statement in case of request for examination made by the applicant(s)</b></p> <p>I/We hereby request that my/our application for patent no. _____ filed on _____  for _____ the _____ invention  titled _____ shall be  examined under sections 12 and 13 of the Act.</p> <p>Or</p> <p>I/We hereby make an express request that my/our application for patent no. _____ filed on _____  based on Patent Cooperation Treaty (PCT) application no. _____  dated _____  made in country _____ shall be examined under sections 12 and 13 of the  Act, immediately without waiting for the expiry of 31 months as specified in rule 20(4)(ii).</p> <p><b>3. Statement in case of request for examination made by any other interested person</b></p> <p>I/We the interested person request for the examination of the application no. _____ dated _____  filed by the applicant _____ titled _____  under sections 12 and 13 of the Act.</p> <p>As an evidence of my/our interest in the application for patent following documents are submitted.</p> <p>(a) _____</p> <p><b>4. ADDRESS FOR SERVICE</b></p> <p>Dated this _____ day of _____ 20_____</p> <p style="text-align: center;">Signature Name of the signatory</p> <p>To, The Controller of Patents  The Patent Office, at .....</p> <p><b>NOTE:</b>  *To be signed by the applicant(s) or by his authorized registered patent agent  *Strike out the column which is/are not applicable  * For fee : See First Schedule</p>	

<p><b>"FORM 18 A</b></p> <p><b>THE PATENTS ACT,1970</b></p> <p><b>and THE PATENT RULES,2003</b></p> <p><b>REQUEST FOR EXPEDITED EXAMINATION OF</b></p> <p><b>APPLICATION FOR PATENT</b></p> <p>[See section 11B and Rule 24C]</p>	<p>(FOR OFFICE USE ONLY)</p> <p>RQ. No.:</p> <p>Filing Date:</p> <p>Amount of fee Paid:</p> <p>CBR no:</p> <p>Signature:</p>
<p>1. APPLICANT(s)</p> <p>(A) NAME:</p> <p>(B) NATIONALITY:</p> <p>(C) ADDRESS:</p>	
<p>2. I/We ----- hereby request that my/our application for patent no.----- filed on----- for ----- the ----- invention titled ----- shall be examined under sections 12 and 13 of the Act.</p> <p style="text-align: center;">or</p> <p>I/We ----- hereby request that my/our application for patent no.----- filed on----- for ----- the ----- invention titled ----- based on Patent Cooperation Treaty (PCT) application no..... dated..... made in country ..... shall be examined under sections 12 and 13 of the Act, immediately without waiting for the expiry of 31 months as specified in rule 20(4)(ii).</p> <p style="text-align: center;">or</p> <p>I/We hereby request that my/our request for examination bearing no.----- for application for patent no.----- filed on----- for ----- the ----- invention titled ----- may be converted to a request for expedited examination of patent application under rule 24C and the application shall be examined under sections 12 and 13 of the Act.</p>	
<p>3. The applicant(s) to indicate (by ticking the appropriate box) any of the grounds applicable in case of request for expedited examination made by on any of the following grounds:</p> <p><input type="checkbox"/> that the applicant is a startup, or</p> <p><input type="checkbox"/> that India has been indicated as the competent International Searching Authority or elected as an International Preliminary Examining Authority in the corresponding international application.</p>	
<p>ADDRESS FOR SERVICE IN INDIA:</p> <p>..... ..... .....</p>	
<p>Dated this    day of 20</p> <p>Signature</p> <p>Name of the signatory</p> <p>To</p> <p>The Controller of Patent</p> <p>The Patent Office, at .....</p> <p>NOTE:</p> <p>To be signed by the applicant(s) or by his/ their authorized registered patent agent</p> <p>"Strike out the column(s) which is/ are not applicable.";</p> <p>For fee: See First Schedule.";</p>	

**FORM 19**  
**THE PATENTS ACT, 1970**

(39 of 1970)

&

The Patents Rules, 2003

**APPLICATION FOR REVOCATION OF A PATENT  
FOR NON WORKING**

[See section 85(1); rule 96.]

1. Name, address and nationality of the applicant(s). I/We.<sup>1</sup>.....  
.....  
.....  
hereby apply for revocation of Patent No.....dated..... granted to .....for which the patentee/applicant for patent is.....  
.....for the following reason, namely:  
<sup>2</sup>.....  
.....  
.....  
The details of documentary evidence in support of my/our interest and the reasons stated above are given below :<sup>3</sup>.....  
(a) .....  
(b) .....  
(c) .....
2. State the nature of the applicant's interest, the facts on which he relies and the grounds on which the application is made.
3. Certified copies of all the documents are to be enclosed in duplicate.
4. Complete address including postal index number/ code and state along with telephone and fax number(s). I/We declare that the facts and matters stated herein are true to the best of my/our knowledge, information and belief.
5. To be signed by the applicant(s) or his authorized registered patent agent. My/Our address for service in India is.<sup>4</sup>  
.....  
.....  
.....

Dated this ..... day of ..... 20

Signature .<sup>5</sup>.....

(-----) <sup>6</sup>

To  
The Controller of Patents,  
The Patent Office,  
At .....

Note : (a) For fee : See First Schedule.

(b) Strike out whichever is not applicable

**FORM 20**  
**THE PATENTS ACT, 1970**  
(39 of 1970)  
&  
The Patents Rules, 2003  
**APPLICATION FOR REVISION OF**  
**TERMS AND CONDITIONS OF LICENCE**  
[See section 88(4); rule 100]

1. Name, address and nationality of I/We<sup>1</sup>.....  
the applicant(s).  
.....  
.....

hereby declare :

- (i) that Patent No.....dated .....  
was granted to .....for which  
the patentee is .....
- (ii) that I/We am/are holding licence under the  
patent, granted by the Controller by an order  
dated.....
- (iii) that the terms and conditions settled by the  
Controller have proved to be more onerous than  
originally expected and we are unable to work the  
invention.
- (iv) that the circumstances in which this application is  
made are set forth in the accompanying statement  
in duplicate.  
I/ We request the Controller to revise the terms and  
conditions of the licence.

Dated this ..... day of ..... 20

Signature <sup>2</sup>.....  
(-----) <sup>3</sup>

To  
The Controller of Patents,  
The Patent Office,  
At .....

---

Note : (a) For fee : See First Schedule.  
(b) Strike out whichever is not applicable.

**FORM 21**  
**THE PATENTS ACT, 1970**  
**(39 of 1970)**  
**&**  
**The Patents Rules, 2003**  
**REQUEST FOR TERMINATION OF COMPULSORY LICENCE**  
[See section 94; rule 102(1)]

1. Name, address and nationality of the applicant(s). I/We<sup>1</sup>.....  
..... hereby apply for the termination of the compulsory licence granted to ..... by the order of the Controller dated ..... under Patent No ..... dated ..... granted to ..... for which the patentee .....
- I/we declare that I am/We are the patentee for the above mentioned patent  
I/we declare that I/we derive title/interest in the patent.  
I/we make the above mentioned request for termination on the following grounds, namely:  
.....  
.....  
I/we declare that the facts and matters stated herein are true to the best of my/our knowledge, information and belief.  
The details of documentary evidence in support of my/our interest and the grounds stated above are given below:<sup>2</sup>  
(a) .....  
(b) .....  
(c) .....  
My/our address for service in India is:<sup>3</sup> .....
4. To be signed by the applicant(s) or by his authorized registered patent agent.
5. Name of the natural person who has signed.

Dated this ..... day of ..... 20

Signature<sup>4</sup>  
( )<sup>5</sup>  
To  
The Controller of Patents,  
The Patent Office,  
At .....

Note : (a) For fee : See First Schedule. (b) Strike out whichever is not applicable.

**FORM 22**  
**THE PATENTS ACT, 1970**  
**(39 of 1970)**

&

**The Patents Rules, 2003**

**APPLICATION FOR REGISTRATION OF PATENT AGENT**

**[See rules 109(1) and 112]**

- 1 Certificate testifying to the character of the applicant should be from a person not related to him and being a Gazetted Officer or any other Person whom the Controller thinks fit.

I beg to apply for registration as a patent agent under the Patents Act, 1970

A certificate of character<sup>1</sup>

From.....

.....

.....

is enclosed herewith.

- 2 Family or principal name in the beginning.

I hereby declare that I am not subject to any of the dis-qualifications specified in rule 114 of the Patents Rules 2003 and that the information given below is true to the best of my knowledge and belief.

Name:<sup>2</sup>.....

.....

Address/place of residence: .....

.....

.....

Principal place of business: .....

.....

.....

Address of the branch office if any: .....

.....

.....

Father's name: .....

.....

Nationality: .....

Date and place of birth: .....

.....

Occupation: .....

.....

.....

Particulars of qualification for registration as patent agent.<sup>3</sup>

(a) .....

(b) .....

(c) .....

Dated this ..... day of ..... 20 .....

- 4 To be signed by the applicant.

Signature<sup>4</sup> .....

- 5 Name or the natural person who has signed.

(-----) <sup>5</sup>

To

The Controller of Patents

The Patent Office

at .....

**FORM 23**  
**THE PATENTS ACT, 1970**  
**(39 of 1970)**  
**&**

**The Patents Rules, 2003**

**APPLICATION FOR THE RESTORATION OF THE NAME IN THE  
REGISTER OF PATENT AGENTS**  
*[See section 130(2); rule 117(1)]*

I, .....  
hereby apply for the restoration of my name in the  
register of patent agent which was removed on  
..... under section 130 or Rule 116. My  
name was originally entered in the register on  
.....under No  
.....

Dated this ..... day of ..... 20 .....

- 1 To be signed by the ..... Signature<sup>1</sup> .....
- 2 Name of the natural person (-----) <sup>2</sup>  
who has signed.  
To  
The Controller of Patents  
The Patent Office  
at .....

Note: For fee: See First Schedule.

**FORM 24**  
**THE PATENTS ACT, 1970**  
**(39 of 1970)**

&

**The Patents Rules, 2003**

**APPLICATION FOR REVIEW/SETTING ASIDE**

**CONTROLLER'S DECISION/ORDER**

**[See sections 77(1)(f) and 77(1)(g) and rules 130(1) and 130(2)]**

1. State the number of patent or patent application number and the relevant proceeding.

In the matter of<sup>1</sup> .....

.....

.....

2. Name, address and nationality of the applicant(s).

I/We<sup>2</sup> .....

.....

.....

being the applicant(s)/opponent/party in the above matter hereby apply for the review/setting aside of the Controller's decision/order dated the ..... in the above matter.

The grounds for making the application are set forth in the accompanying statement submitted in duplicate.

Dated this ..... day of ..... 20 .....

3. To be signed by the applicant(s) or his authorized registered patent agent.

Signature<sup>3</sup> .....

4. Name of the natural person who has signed.

(-----)<sup>4</sup>

To  
The Controller of Patents  
The Patent Office  
at .....

---

Note: For fee: See First Schedule.

**FORM 25**  
**THE PATENTS ACT, 1970**  
**(39 of 1970)**  
**&**  
**The Patents Rules, 2003**

**REQUEST FOR PERMISSION FOR MAKING PATENT APPLICATION OUTSIDE  
INDIA**

**[See section 39 and Rule 71(1)]**

- |   |  |
|---|--|
| <p>1. State the title of the invention.</p>   | <p>I am/We are in possession of an invention for<br/>.....<br/>.....</p> <p>I/We have made an application for the grant of a patent for the said invention, its number being No.....of<br/>.....Dated.....</p>                                   |
| <p>2. Name and address of the person (s)</p>  | <p>I/we hereby attach the brief description of the invention.</p> <p>I/We intend to make application (s) alone/jointly with<sup>2</sup>.....<br/>.....<br/>.....</p>   |
| <p>3. Name and address of the assignee</p>  | <p>for the same/substantially same invention for patent in the following country/countries/convention countries, namely:-<br/>.....<br/>..... I/We declare that the rights in the application (s) has/have been assigned to<sup>3</sup>.....</p> |
| <hr/> <p>I/We request that I/We may be granted permission to make application (s) for the said invention in the said country/countries. The reasons for making this application, are as follows:-</p> <p>The facts and matters stated above are true to the best of my/our knowledge, information and belief.</p> <p>Dated this .....day of .....20 .....</p> |  |
| <p>4. To be signed by the applicant (s) or authorised patent agent.</p>   | <p>Signature<sup>4</sup>.....</p>  |

To  
The Controller of Patents  
The Patent Office  
at .....

Note: (a) Strike out whichever is not applicable.  
(b) For fee. See First Schedule.

**FORM 26**  
**THE PATENTS ACT, 1970**  
**(39 of 1970)**  
**&**

**The Patents Rules, 2003**

**FORM FOR AUTHORISATION OF A PATENT AGENT/OR ANY  
PERSON IN A MATTER OR PROCEEDING UNDER THE ACT**

*[See sections 127 and 132; and rule 135]*

1. Insert name, I/We<sup>1</sup> .....  
address and .....  
nationality. ....
2. Insert the name, hereby authorise<sup>2</sup> .....  
address and .....  
nationality of the .....  
person(s) to be .....  
authorized. ....
3. State the particular to act on my/our behalf in connection with<sup>3</sup>  
matter or .....  
proceeding for .....  
which the .....  
authorisation is .....  
made. ....  
and request that all notices, requisitions and communication  
relating thereto may be sent to such person at the above  
address unless otherwise specified.

I/We hereby revoke all previous authorisation, if any made, in  
respect of same matter or proceeding.

I/We hereby assent to the action already taken by the said  
person in the above-matter.

Dated this ..... day of ..... /20 .....

4. To be signed by the person(s) making this authorisation. Signature<sup>4</sup> .....
5. Name of the natural person who has signed along with designation and official seal, if any. (-----)<sup>5</sup>

To  
The Controller of Patents  
The Patent Office  
at .....

---

To be stamped under the Indian Stamp Act, 1899 (2 of 1899).

---

**FORM 27**  
**THE PATENTS ACT, 1970**  
**(39 of 1970)**

**No Fee**

**The Patents Rules, 2003**

**Statement regarding the working of the patented  
invention on commercial scale in India  
[See section 146(2) and rule 131(1)]**

1. Insert name,  
address and  
nationality.  
In the matter of Patent No.....of .....
- I/We<sup>1</sup> .....
- .....
- .....
2. State the year to  
which the  
statement relates  
The patentee (s) or licensee (s) under Patent  
No..... hereby furnish the following  
statement regarding the working of the  
patented invention referred to above on a  
commercial scale in India for the  
year<sup>2</sup>.....
3. Give whatever  
details are  
available.  
(i) The patented invention:  
{  Worked {  Not worked [Tick (✓)mark the relevant  
box]  
(a) if not worked: reasons for not working and steps being  
taken for working of the invention.  
(b) If worked: quantum and value (in Rupees), of the  
patented product:  
i) manufactured in India  
ii) imported from other countries. (give  
country wise details)  
(ii) the licenses and sub-licenses granted during the year;  
(iii) state whether public requirement has been met  
partly/adequately/to the fullest extent at reasonable price.

The facts and matters stated above are true to the  
best of my/our knowledge, information and belief.

Dated this ..... day of ..... 200 .....

4. To be signed by  
person(s) giving  
the statement.

Signature<sup>4</sup> .....

To  
The Controller of Patents  
The Patent Office  
at .....

Note: (a) Strike out whichever is not applicable."

**"FORM 28**  
**THE PATENTS ACT, 1970**  
**(39 of 1970)**  
**AND**  
**THE PATENTS RULES, 2003**  
**TO BE SUBMITTED BY A SMALL ENTITY / STARTUP**  
**[See rules 2 (fa), 2(fb) and 7]**

1	Insert name, address and nationality.	I/We ..... ..... applicant/ patentee in respect of the patent application no. .....or patent no..... hereby declare that I/we am/are a small entity in accordance with rule 2(fa) or a startup in accordance with rule 2(fb) and submit the following document(s) as proof.
2	Documents to be submitted	
	i. For claiming the status of a small entity:	
	A. For an Indian applicant: Evidence of registration under the Micro, Small and Medium Enterprises Act, 2006 (27 of 2006).	
	B. In case of a foreign entity: Any other document.	
	ii. For claiming the status of a startup	
	A. For an Indian applicant: Any document as evidence of eligibility, as defined in rule 2(fb).	
	B. In case of a foreign entity: Any other document.	
3	To be signed by the applicant(s) / patentee (s) / authorised registered patent agent.	The information provided herein is correct to the best of my/our knowledge and belief.  Dated this .....day of ..... 20...  Signature .....
4	Name of the natural person who has signed. Designation and official seal, if any, of the person who has signed.	(Name) ..... (Designation) .....  To The Controller of Patents, The Patent Office, At.....";

**"FORM 29**

THE PATENTS ACT, 1970  
(39 of 1970)  
and  
THE PATENTS RULES, 2003

**REQUEST FOR WITHDRAWAL OF THE APPLICATION FOR PATENT**

[See Section 11B(4) and rules 7(4A), 26]

1. Name of the applicant	I/ We _____ request that the application for patent numbered ..... _____ dated _____ filed by me/us, if applicable, having the request for examination / request for expedited examination numbered..... _____ dated _____, be treated as withdrawn under rule 7(4A) / 26.
2. To be signed by the applicant or his authorized registered patent agent	
3. Name of the natural person who has signed	Dated ----- day of -----  Signature ( _____ ) (Name) ..... (Designation) .....
N.B. strike out whichever not applicable	To The Controller of Patents Patent Office at _____

**FORM 30**  
**THE PATENTS ACT ,1970**  
**(39 of 1970)**  
**and**  
**THE PATENTS RULES,2003**  
**TO BE USED WHEN NO OTHER FORM IS PRESCRIBED**  
[See sub-rule (2) of Rule 8 ]

1. Name of the Applicant/Patentee/Other	I/We .....		
	House No. Street	-- --	Telephone No. Mobile No.
	City State Country	-- -- --	Fax No.
	Pin code	--	E-mail ID
3. Application No. / Patent No.			
4. Relevant section / rules			
5. Purpose of request			
6. Details of request			
7. To be signed by applicant	Signature.....		
8. Name of the natural person who has signed along with designation and official seal, if any.	(.....)		
	To, The Controller of Patents, The Patent Office, at .....”.		

## **REFERENCES**

- 1) The Patents Act, 1970 (**Act ID: 197039**, An Act to amend and consolidate the law relating to patents) by Ministry of Commerce and Industry, Government of India ([https://www.indiacode.nic.in/handle/123456789/1392?view\\_type=browse&sam\\_handle=123456789/1362](https://www.indiacode.nic.in/handle/123456789/1392?view_type=browse&sam_handle=123456789/1362))
- 2) The patents rules 2003 formulated by Intellectual Property of India (<https://ipindia.gov.in/writereaddata/Portal/ev/rules-index.html>)
- 3) Patents (Amendment) Rules, 2020, by Ministry of Commerce and Industry, Government of India (<https://pib.gov.in/Pressreleaseshare.aspx?PRID=1668081>)
- 4) Intellectual property of India, Department of promotion of Industry and Internal Trade (<https://ipindia.gov.in/>)

## **DISCLAIMER**

### **To whomsoever it may concern**

It is hereby declared that some part of the content herein may reflect the essence of national patents policy and other institutes and it is being duly acknowledged though the exact text is not copied or plagiarized, the essence of and framework has been captured in no intention to intentionally copy or infringe the intellectual property.