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20 September 2023

Secretary  
Department for Promotion of Industry and Internal Trade  
Ministry of Commerce and Industry  
Government of India  
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New Delhi- 110001  
India

*Submitted via email to [bikram.87@nic.in](mailto:bikram.87@nic.in) and [ipr-patents@gov.in](mailto:ipr-patents@gov.in)*

Dear Secretary:

Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the Notification of “The Draft Patents (Amendment), Rules, 2023,” published in New Delhi on August 22, 2023.

IPO is an international trade association representing a “big tent” of diverse companies, law firms, service providers and individuals in all industries and fields of technology that own, or are interested in, intellectual property rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; supporting and advocating for diversity, equity, and inclusion in IP and innovation; and disseminating information to the public on the importance of IP rights.

IPO’s vision is the global acceleration of innovation, creativity, and investment necessary to improve lives. The Board of Directors has adopted a strategic objective to foster diverse engagement in the innovation ecosystem and to integrate diversity, equity, and inclusion in all its work to complement IPO’s mission of promoting high quality and enforceable IP rights and predictable legal systems for all industries and technologies.

IPO welcomes the Amendments. They provide needed improvements to and clarity about the process for applying for patents in India. IPO makes some comments and suggestions for the Department’s consideration organized below by Rule or Form number.

## **Rule 12**

IPO supports and applauds the proposed changes in Rule 12, as the changes will lessen the burdens on Applicants by significantly reducing the Applicants’ obligation to regularly file Form-3 during the prosecution of patent applications in India.

**Rule 55**

IPO appreciates the Ministry's intent to encourage speedy disposal of applications that have been opposed by way of pre-grant representations. However, IPO believes that the amendments should address core problems with the pre-grant opposition provision, namely, the lack of a deadline to file pre-grant oppositions and the potential for serial oppositions to indefinitely delay grant of a patent. IPO also believes that many of the proposed amendments should be clarified and amended, and makes suggestions below for your consideration.

***Rule 55, sub-rule (3)***

The proposed amendment to Rule 55, sub-rule (3) prescribes procedure for screening out frivolous oppositions by mandating the Controller to decide the maintainability of the opposition and to issue notice to the patent applicant only if the opposition is found maintainable.

The proposed amendment that allows the Controller to dispense with non-meritorious petitions quickly could be useful, if practically applied. However, if a mandatory time limit for the Controller to decide the maintainability of the representation for opposition is not defined, this provision could add to the delay in examination instead of facilitating the same.

Further, the proposed amendment does not clarify if the decision on maintainability of the representation for opposition could be appealed. Since decisions of the Controller under section 25(1) are not appealable under section 117A of the Patents Act, and even under established jurisprudence such decisions can only be challenged through a writ petition by the Opponent, the Rule could be clarified to state that the decision of the Controller with regard to maintainability will not be appealable, in the interest of time.

In view of the foregoing, IPO suggests the following changes to amended Rule 55(3):

“On consideration of the representation, the Controller shall first decide the maintainability of the representation within three months from the date of filing of the representation, and thereafter 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. The decision of the Controller in this regard shall be non-appealable.”

***Rule 55, sub-rule (4)***

IPO is concerned about the proposed reduction in time for filing the reply statement from three months to two months. IPO believes that the delay in prosecution of applications due to the filing of pre-grant oppositions cannot be attributed to any delay on the part of the applicants who have to currently comply with and file their reply statement within the prescribed three months' deadline. A reduction in the time period from three months to two months would be prejudicial to the applicant as more time is generally needed in

arranging for evidence and drafting pleadings in inter partes proceedings. Moreover, seeking an extension of time through a petition under rule 138 is a financially burdensome option with an extremely high charge of INR 50,000 per month and will only add to the costs incurred by the applicant whose application is being opposed.

Given that three months is a reasonable time frame for arranging evidence and drafting and filing a reply statement and given that the proposed amendments are now providing more time (three months) as opposed to the earlier recommended time of one month for deciding pre-grant representations to the Controller, IPO believes that it is only fair that the time period for filing the reply statement that is available to the applicant not be reduced.

Therefore, IPO suggests that sub-rule (4) of Rule 55 not be amended.

***Rule 55, sub-rule (6)***

The amendment proposes the insertion of sub-rule (6) after sub-rule (5). However, both sub-rule (5) and sub-rule (6) deal with the same subject, that is, disposal of pre-grant oppositions. IPO believes this creates ambiguity. However, the sub-rules are not completely redundant with each other, and each has an element IPO supports.

Sub-rule 5 allows for the possibility of amendments, while sub-rule 6 does not. In fairness, patent owners should be able to amend their patents in opposition rather than be forced to accept a final rejection.

Sub-rule 6 provides 3 months to render a decision, in contrast to sub-rule 5 which allows only 1 month. Patent examiners face difficult issues in oppositions and should be given enough time to render well-reasoned decisions. IPO believes that three months are necessary.

Therefore, IPO suggests deleting sub-rule (6) and amending sub-rule 5 as shown:

"(5) 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~~ three months from the completion of above proceedings."

***Rule 55, sub-rule (8)***

IPO appreciates the Ministry's intent to expedite examination of any opposed application to avoid delays and laches. However, IPO suggests that proposed sub-rule (8) should clarify the following points:

1. Whether any party to the proceeding will have to pay the fee difference between an expedited request for examination and an ordinary request for examination?
2. If the answer to point 1 above is in the affirmative, then which party will pay the difference?

IPO believes that that applicants should not be forced to pay additional fees for expedited examination which becomes due because of the action of third parties such as opponents. IPO suggests the following options that could be considered:

1. No fee be charged to any party for examining the opposed application in accordance with rule 24C. To clarify this situation, proposed sub-rule (8) of rule 55 could be worded as follows:

“An application for a patent, in which a representation for opposition has been filed and found maintainable shall be examined in accordance with ~~rule 24C~~ the procedure prescribed in rule 24C(6) to 24C(12).”

OR

2. If a fee has to be charged, the opponent should bear the burden for any change in fee that occurs because of their act of filing the pre-grant opposition. Accordingly, proposed sub-rule (8) of rule 55 could be worded as follows:

“An application for a patent, in which a representation for opposition has been filed and found maintainable shall be examined in accordance with rule 24C and the fee, if any, that becomes due under Rule 24C(2) shall be borne by the opponent who shall pay such fee at the time of filing of the representation for opposition.”

### **Rule 56**

The amendment to this rule changes the time limit for the Opposition Board’s report from three months to two months. IPO supports the proposed change which will likely reduce the timeframe for disposal of the post-grant patent oppositions.

### **Rule 131**

The draft Rules propose that the Statement of Working (under Form-27) is to be filed in respect of every period of three financial years starting from the financial year commencing immediately after the financial year in which the patent was granted. (Currently this is to be filed for every financial year.) While IPO supports removing the working requirement altogether from existing law, it also believes that the proposed change to Rule 131 to require filing working statements only once every 3 financial years would be a positive change because it would reduce the burdens on patent owners. The decreased frequency will not negatively impact the public because the working statements will still provide the public with notice of whether a given invention is being practiced in India at reasonable intervals during patents' terms.

**Rule 138**

IPO appreciates and applauds the proposed amendment which will enable the Applicants/Patentees to seek extension of any and all timelines prescribed under the Patent Rules without any exclusion or exception. This will prevent undesired and unwarranted loss of rights in applications / patents. In particular, the proposed amendments allow the scope for seeking extension of time with respect to filing PCT national phase application in India (after 31 months) as well as for filing Requests for Examination, which have been very strict and non-extendible deadlines until now.

However, it is noted that several Patent Rules already provide a scope of extension, and in some instances that there is a limitation of maximum possible extension that can be sought (under Form-4) which may be inconsistent with the maximum extension of 6 months provided under the proposed amendment to Rule 138. For instance:

- Rule 130(1) and (2) appears to provide an extension “not exceeding one month” to file an application for review or setting aside of the Controller’s decision;
- Rule 13(6) appears to provide a maximum of 1 month extension (when filed under Form-4) to file Declaration of Inventorship (Form-5); and
- Rule 24B(6) and 24C(11) appears to provide a specific extension of only up to 3 months (maximum) to file a response to the first office action and putting the application in order for grant.

Accordingly, IPO suggests that it be clarified whether the extension (of up to 6 months) under Rule 138 is over and above the other specific extensions provided under different Rules. If the extension is not over and above the extensions provided under the existing Rules, then it is recommended that a phrase such as “Notwithstanding anything to the contrary” be added in Rule 138 to avoid a scope of inconsistency in the maximum extension that can be sought, and to confirm that despite the limits under other Rules, it is possible to seek an extension of up to 6 months under Rule 138.

Further, the proposed amendment to Rule 138 does not indicate whether or not multiple extensions can be sought, since “time prescribed by these rules” can possibly be interpreted to include the time obtained under Rule 138 after extension, thereby enabling a scope of multiple extensions. It is suggested that clarity be provided with respect to multiple extensions.

**Form 27**

IPO applauds the Ministry’s proposal to reduce the burden on patentees by permitting submission of working statements once in three years as well as the move to substantially reduce the information demanded from patentees. The proposed changes to Form 27 are also positive because they (1) simplify the disclosures required from an applicant and (2) clarify that importation of a product into India qualifies as working an invention.

The proposal to remove the requirements for declaration of revenue for “worked” inventions and declaration of reasons for “not-worked” inventions allows patent owners

to file simpler working statements. At the same time, these changes would allow patent owners to avoid disclosing potentially sensitive and confidential information regarding revenue and strategy. Moreover, we appreciate the clarification in new Form 27 that "a Patented invention shall not be considered as "not worked" merely on the ground that the patented product has been imported in India." Patent owners should not be punished for choosing alternative means to bring the benefits of an invention into India.

IPO suggests that one point be clarified. Form 27 as proposed does not provide clarity on whether: (1) the patentee should mention "worked" or "not-worked" for each year, or (2) if working the invention in any one year out of the three years for which the statement is being submitted will be treated as "worked"? IPO would suggest, for efficiency, that the second interpretation be adopted and stated; otherwise, appropriate modifications of the format of form 27 would be required for clarity.

IPO thanks the Secretary for the opportunity to share these comments.

Sincerely,

A handwritten signature in black ink, appearing to read 'Karen Cochran', is centered on the page. The signature is fluid and cursive, with a large initial 'K' and 'C'.

Karen Cochran  
President