



## ERGO

*Analysing developments impacting business*

### PATENT (AMENDMENT) RULES 2020 COME INTO FORCE

22 October 2020

The Patent (Amendment) Rules 2020 (Revised Rules 2020) have come into force from 20 October 2020. The key highlights of the Revised Rules 2020 are broadly set out below:

- The statement of commercial working of a patented invention will have to be filed by every patentee and every licensee for every financial year (1 April to 31 March) within 6 months from the start of the following financial year i.e. by 30 September of the following year.
- The prescribed form (Form 27) to file the statement regarding commercial working of a patented invention has also been amended whereby one form can be submitted for related patents with the following information:
  - In case the patented invention has been worked, approximate revenue / value (instead of quantum and value) accrued in India to the patentee through manufacturing and/or importing along with a brief write-up on the same will have to be provided.
  - In case the patented invention has not been worked, reasons for not working the patented invention and steps being taken for working of the patented invention will have to be provided.
- The requirements of submitting information regarding licensees and sub-licensees granted in a year; and information regarding extent of working (partly, adequately, fullest) of the patented invention has also been done away with in the amended form.
- While patentees can jointly file the statement of commercial working, each licensee will have to file the statement of commercial working individually.

Further, the rules in relation to filing of priority document and English translation (if applicable) for Indian national phase patent applications has been amended to include certain PCT regulations. However, the timeline for submission of the priority document and English translation remains the same.

#### Comments:

Before the Revised Rules 2020, patentees and licensees were required to submit statement of commercial working for every calendar year (January to December). Considering balance sheets and income statements in India are generally prepared for

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a financial year (from 1 April to 31 March), the Revised Rules 2020 will significantly ease filing of statement of commercial working of a patented invention for every financial year.

- Adheesh Nargolkar (Partner) and Janaksinh Jhala (Principal Associate)

For any queries please contact: [editors@khaitanco.com](mailto:editors@khaitanco.com)

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**Mumbai**

One Indiabulls Centre, 13<sup>th</sup> Floor  
Tower 1 841, Senapati Bapat Marg  
Mumbai 400 013, India

T: +91 22 6636 5000  
E: [mumbai@khaitanco.com](mailto:mumbai@khaitanco.com)

**New Delhi**

Ashoka Estate, 12th Floor  
24 Barakhamba Road  
New Delhi 110 001, India

T: +91 11 4151 5454  
E: [delhi@khaitanco.com](mailto:delhi@khaitanco.com)

**Bengaluru**

Simal, 2nd Floor  
7/1, Ulsoor Road  
Bengaluru 560 042, India

T: +91 80 4339 7000  
E: [bengaluru@khaitanco.com](mailto:bengaluru@khaitanco.com)

**Kolkata**

Emerald House  
1 B Old Post Office Street  
Kolkata 700 001, India

T: +91 33 2248 7000  
E: [kolkata@khaitanco.com](mailto:kolkata@khaitanco.com)