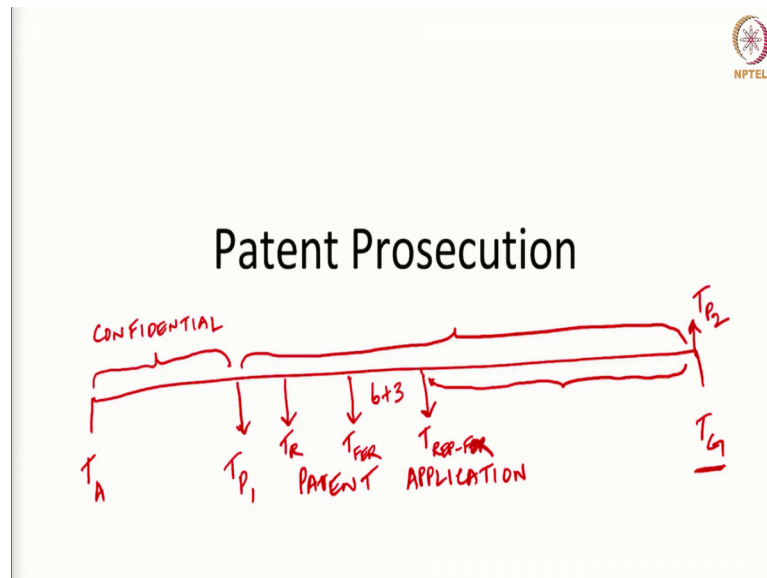


Intellectual Property
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Lecture – 28
Patent Prosecution: Publication, Examination, Grant - Part 1

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Patent prosecution; when we refer to the term prosecution, we refer to the continuation of a course of action with the view of its completion. Prosecution means the continuation of a course of action, which results in something. When we talk about patent prosecution, we are referring to what happens to an patent application that is filed before the patent office; and it is continuation within the patent office up until it results in a grant.

So, we traditionally understand prosecution as things that happen between two timelines. The first time line is the time for application and resulting in the time for grant. Now, this timeline the time between time of application and the time of grant is what we refer to as patent prosecution. Now, this is true for a patent application. Any application we will have these two timelines and whatever happens within this timeline is what we refer to as patent prosecution. There are many things that happen between these timelines.


Now, within the time for the grant, you will find that there are publications that happen. First there is a time for publication one what we call the pre grant publication; and there is also a publication that happens at this point itself. Along with the time for the grant

there is another publication that is T P 2, there is a second publication, upon grant the application gets published. Now, this time period is the time within which the patent application remains dormant what we call this is the patent application has a confidential status.

The patent application is kept confidential, it is not published. So, this time period nothing happens at the patent office. Soon after publication during this time there are couple of events that can happen. They can be a after publication, they can be a request for examination, there is a time for request for examination. Then after the time for request for examination, they can be time for filing the FER - the first examination report. Within 6 plus 3 months you can get an extension of up to 3 months, there has to be a time for reply to the FER. Now, reply to FER.

Now, after this there will be a period during which the patent office will look into it. And this can continue the patent office actions requiring certain things to be set right, and then the patent eventually results in a grant. Now, let us look at the stages the application goes through in the process of a prosecution.

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Publication of Application

- Open to public after 18 months from date of application
- **Form 9:** Request for publication for early publication
- No publication:
 - Secrecy direction imposed
 - Patent abandoned
 - Withdrawn 3 months prior to 18 month period

Now, first as we said there is an application, the patent application is published. Now, it is not published normally for a period of 18 months; during from the data filing till 18 months the application is not published, this is because there is a period of dormancy, the period where the application is kept confidential. The reason it is kept confidential is

because of certain international arrangements where the applicant we will get 18 months to decide which jurisdictions the applicant needs to enter.

Again the confidential status is required because of the design of patent law patent law has a concept called novelty which we have already discussed. And novelty means they should not be any disclosure of your invention before filing the patent application. So, an application which you file say in India, if it is published soon after you file it say within a month, if you were to if you choose to file an application in China say after 2 months, your own publication in India of your application can act as a prior art can anticipate your Chinese application.

So, because the world follows a global novelty standard; anything that is disclosed and published in any part of the world can be used to anticipate a potential invention, there is a requirement to keep things confidential. So, the 18 month period is a confidential period during which no publication happens which gives the applicant the time to move to other jurisdictions and put an application in place. Now, the 18 month period which is standard period across the globe tells us that the application will be open to public only after this 18 month period. And the 18 month period as I mentioned starts from the date of application.

Now, there is a particular form by which in case you do not want to wait for the 18 month period. There is a form which you can use under the patterns rules which is called the form 9. And you can request for an early publication. Now, the publication can be before the 18 months. Now, why would somebody do this? Now, somebody would do this if the applicant needs an expeditious grant. So, rather than waiting for the 18 months period, you can take a request for early publication. So, the application may get published to say in a few weeks or in a months time. And then you have cut down the timeline by say of 18 months and you are now moved to the next phase.

Now, once the application is published, then it follows up by the applicant taking a request for examination. Once the application takes the request for examination, the patent office examines it and grants the patent. So, in cases where an applicant needs an expeditious grant, then there is a provision by which the applicant can take an application under form 9 requesting an early publication. Now, there are certain exceptions to this 18 month rule.

Now, 18 month is the rule where in a normal case and an application is filed; it is not published it is kept dormant or it enjoys confidential status for 18 months. The exceptions to that rule are where cases where an application is not published even after the 18 month is one where a secrecy direction is imposed. The government imposes a secrecy direction because the invention could be something that affects national security or as relevant from a defense perspective. So, the government imposes a secrecy direction. So, as long as the secrecy direction continues the application will not be published.

To the patent application is abandoned. Now, this arises in the situation where a provisional is filed and the provisional is not continued through a complete. So, when the patent application is abandoned at the provisional stage, there is no need for a publication. And the third instance is where the patent application is withdrawn prior to the 18 month period. Now, 3 months prior to the 18 month period, the applicant has the right to withdraw his application. So, if the application is withdrawn by the applicant, then again there is no need to publish it.