

Patent Law for Engineers and Scientists
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Lecture - 14
Patent Specifications
Complete and Provisional Specifications

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Patent Specifications

- Written document in which invention is described
- Form 2
- Specifications: Two kinds; S.9
 - Provisional specification
 - Complete Specification



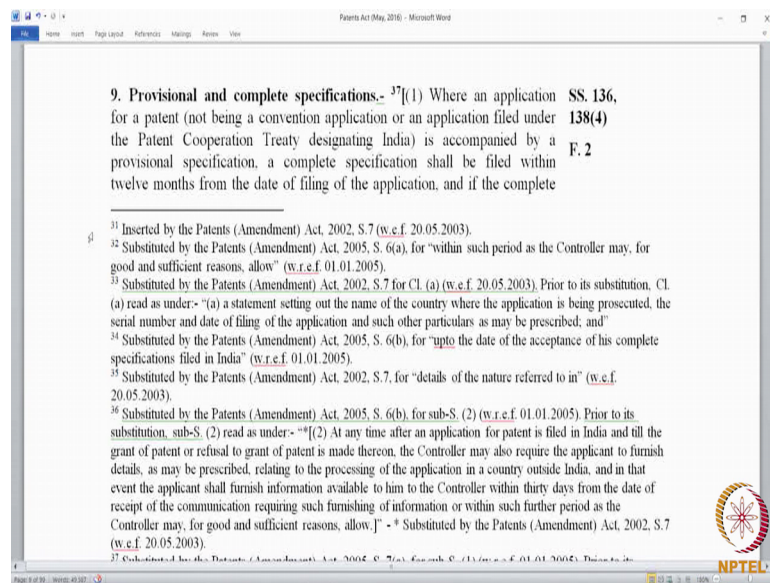
Patent specification: patent specification is the document that encompasses the invention, but the patent specification is the written document in which the invention is described. Under the various forms that have to be filed for getting a patent, form 1 is the form that is used for filing the patent application itself where you have details about inventors, about the applicant about the filing requirements, the capacity in which the applicant is filing so on and so forth.

Form 2 is a separate form which will contain the patent specification, the specification is will encompasses the details of the invention where as form one will have details about the inventor about the type of application, the mode in which the application is filed and the fees that is to be paid, the form one will have all the administrative details about the invention where as form 2 will have the substantive details about what the invention is. So, form 2 the structure of the form 2 is different. So, when we say a patent specification, we are talking about the document that is encompassed in form 2 of the patent rules.

Patent specifications are broadly of 2 types, section 9 talks about 2 types of patent specifications provisional and complete and you use the same form for provisional and for complete.

So, when you look at form 2, form 2 is titled provisional slash complete specification. Now the only difference between form 2 which is filed for provisional and the complete is that when it is filed for a complete you have claims in it, the claim column is filled in the case of a complete specification and if you see the entry number 5 in form 2, you will find that claims not applicable for provisional specification. So, the claims are the ones or that part of form 2 which distinguishes a provisional from a complete. In a provisional there is no need to file a claim whereas in a complete for us to regard something as a complete there has to be the claim and the claim is the concluding part of the specification; section 9 provisional and complete specifications.

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The patents act makes a distinction between a provisional and a complete specification, though both these specifications can be filed using the same form.

So, the form that has to be used for filing a provisional or a complete specification is form 2. The distinction between a provisional and a complete specification may not be clear upon reading of the section 9, but the form makes it clear as to what could be the possibility distinction between the provisional and a complete specification, and the provisional and complete specification are not terms that have been define under the act

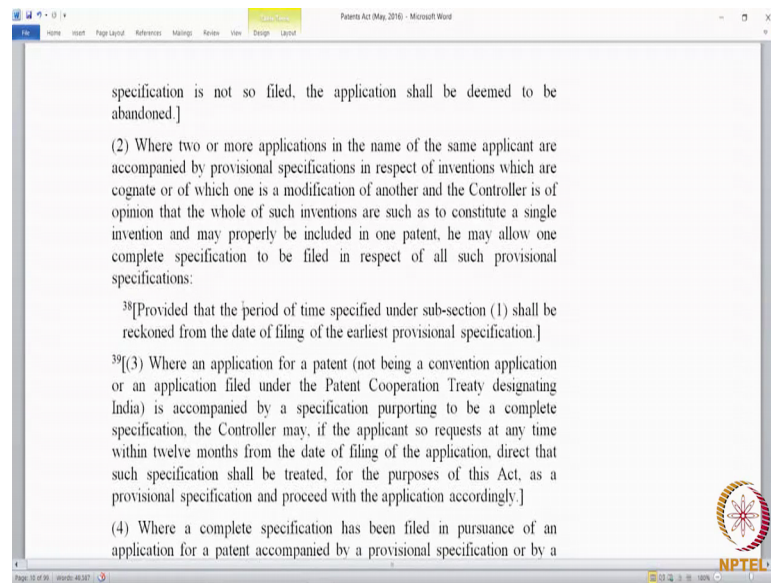
there is no definitions. So, as we mentioned in the earlier lecture if there is no definition in the act then we go by the normal common meaning. Provisional is something that is being done as a temporary measure and provisional also means that it will be followed up by a something which is complete.

So, the professional is something that is a time bound specification which has the short life and by its nature the provisional has to be followed by something that is complete. Now for those who have graduated will know that soon after graduation you get a provisional degree certificates and the original or the degree certificate will follow through later; we do not call it as complete degree certificate it is the understanding that provisional is meant for a short period till the original is issued. In patent law a provisional specification does the similar function.

The provisional specification can be filed but you have to follow up with the complete specification within one year. So, that is the time period that is being given for you to find the complete. So, as soon as you file a provisional you have to follow it up anytime it can be much before the one year period, but the maximum time period allowed for filing or following it up with the complete is one year; in case you do not follow a provisional with the complete then the provisional will lapse.

Now section 9 1 tells at where an application for a patent not being a convention application or pct application those are international applications. So, this provision excludes international application is accompanied by a provisional specification, a complete specification shall be filed within 12 months from date of filing the application. So, it says if a provisional is filed within 12 months a complete has to be filed, and if the complete is not filed the application shall be deemed to be abandoned.

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Now, this is a phrase which you need to understand because this phrase appears in other parts of the act and there is also a parallel phrase which is called deemed to be withdrawn. Deemed to be abandoned is a phrase which we will understand as the patent application expiring because of the in action of the applicant. Something was required to be done by the applicant the applicant did not do it, which lead to the cancellation or the expiry of that application that cancellation or that in action is deemed as an abandonment by the applicant. So, this is a fiction the law uses a fiction a legal fiction that the in action of the applicant is treated as though he had abundant the application and you will find that patent system is structured with legal fictions, where in actions will be treated as something else.

So, the fact that you did not file a renewal fee on a timely basis will lead to the rejection of your patent itself, your patent will lapse if you do not file the that is again a fiction you do not file the fee the patent will lapse, you do not reply to the controllers objections your patent will be deemed to have been abundant. You do not file a request for examination your patent applications will be deemed to have been withdrawn. So, all these fictions are done in such a way that patent office is always interested in shifting the burden on to the applicant; it is the task of the applicant to ensure that he does everything within the time line to get the application granted.

So, the patent system itself is structured in such a way that there are timelines for doing things, if you fail to do those things during those timelines your application will be treated as abandoned or withdrawn. So, this is something which will appear in other parts of the act in the rules as well. So, 9 1 tells us if provisional application is filed it has to be followed by a complete specification. 9 1 tells us that if a provisional specification is filed it has to be followed by a complete specification within one year.

If it is not followed by a complete specification then the application will be treated as abandoned. 9 2 says where 2 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 the modification of other, and the controller of the 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, provided that the period of time specified in sub section one shall be taken from the date of filing the earliest provisional specification.

There has to be a cross reference to this to section 10 5. 10 5 again talks about the concept of the single inventive concept or the fact that the invention constitute a single invention 10 5; this provision tells us that there could be if there are many provisional specifications filed by the same applicant covering a related aspect of an invention, say there is a mechanical device which is the combination of many devices and it can do a particular function a provision is filed for that.

There is another functionality after a few months the applicant files another provision for the same device or same combination of devices another functionality. And after a few months the applicant again files another provisional covering yet another functionality of that device. Now if the controller feels that all these 3 provisional applications cover the same invention, but different aspects of it and if the controller is of the opinion that they all constitute a single invention, then the controller can allow the applicant to file one complete to cover the 3 provisional's. So, this provision tells you that there could be multiple provisional specifications filed covering various aspects of one invention; you can follow multiple provisional specifications with one complete.

So, the disclosure made in the provisional as far as it relates to a single invention can be followed up by one complete. So, it is not necessary that every provisional should be followed up by one complete specification, you can club provisional specifications provided they relate to the same invention till the section 9 2 uses the language cognate provided they are cognate or they one is a modification of the other, in such cases the controller can allow one complete to be filed based on multiple provisional specification. The catchers' complete specification has to be filed within 12 months from the date of the first filed provisional specification; the act called is the earliest provisional specification.

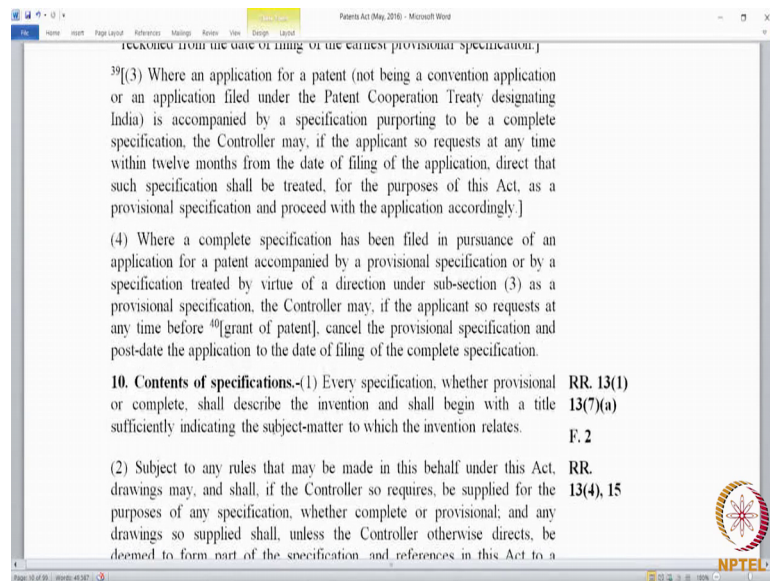
So, the timeline so there could be a hypothetical instance where a person files a provisional specification in the month of January. On the first of every month he follows it up with the provisional covering another aspect a modification or a related aspect of the same invention. So, in February you have one in March first you have another provisional file in April first so on till December. Before December 31st the applicant can file one complete specification covering all the aspects covered in the provisionals filed over the period of 12 months, and it will be allowed by the controller provided they are all cognate they are all related. Now this gives the flexibility for the applicant to file multiple provisionals as and when he comes up with his invention or he discovers that there is a new aspect to this invention and follow it up with the single complete.

The advantage of this provision is that as and when you come up with the discovery you can disclose it and you have priority and this is a concept which we will discuss in great detail later, the priority will be ascribe to the date on which the particular provisional was filed. So, if an aspect of the invention was it is closed on January first by a provisional specification, then that disclosure when it becomes a claim in soon we will mention in a detail the difference between claiming and a disclosure that claim in the complete specification will get the priority from the January first provisional specification. Another aspect of the invention which was disclosed on February first by another provisional specification if there is a claim that comes through that, then that claim will have the priority from February first because that was when that aspect of the invention was first disclosed.

So, the priority is based on the first disclosure and the priority can result in the disclosure being formulated as a claim. So, when we look at the scheme in 9 2, 9 2 allows the

applicant to find multiple provisional specifications with different disclosures. But within the period of 12 months from his earliest provisional specification he has to file a complete and the complete will have probably 12 claims if there have been 12 disclosures different disclosures and each claim will have a different a priority, because each claim is based on the disclosure made in a provisional specification at a particular point in time 9 3.

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So, 9 1 was the simple case of provisional following one provisional following one complete that has to be done within 12 months, 9 2 there is a case of multiple provisionals being followed by one complete that again has to be done within 12 months, but from the date of the earliest specification earliest provisional specification; 9 3 deals with the case where an application for a patent, not being an international application, is accompanied by a specification purporting to be a complete specification. The controller may if the applicant so request at the time within 12 months from date of filing the application direct such specification to be treated for with the purposes of this act as a provisional specification and proceed with the application accordingly.

Now, this provision allows the applicant to file a specification which looks like a complete a purported complete, that the act uses the word purporting to be a complete specification, once this is filed I understand that you should be having this doubt as to what is the difference between a provisional and a complete now to give you a very

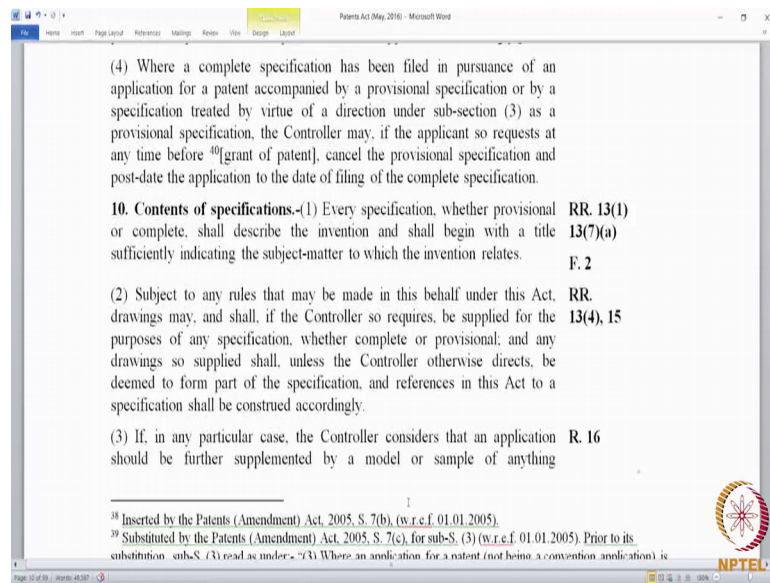
quick answer, the complete should have claims provisional need not have claims it could also have claims, but if you file an application under form 2 without drafting the claims it will automatically be deemed as a provisional specification. If the claims are there it could be considered as a provisional or a complete it depends on how you prosecute it.

So, assume for the purposes of 9 3, assume that you file a complete specification with the claims it is a complete specification, but 6 months down the line you write to the controller and request him to downgrade your complete because you understood it as complete and for all practical purposes you are going to use the same form and you want the controller now to downgrade your so called complete or what you purported to be a complete into a provisional.

The controller can do that provided you do that within the 12 month period, the controller can do that and downgrade your provide or your complete as the provisional and it proceeds as a provisional. So, what you have done in this case is you had filed something that looked like a complete and your asked the controller to treat it as the provisional which would give you time, but the time is again computed from the first disclosure which would give you some time, but which will also give you an opportunity to file more claims when you eventually follow it up with the complete.

So, in this scenario you have a purported complete that is filed that becomes a provisional because you requested the patent office to treat it as the provisional, and that provisional should be followed up by another complete and all this should happen within the 12 month time. Now 9 3 should not be understood as a cheeky method to get more time to file the complete it is not so, it is just a provision which allows the controller to treat a complete that is not really ready as a provisional and allow the applicant to move forward.

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9 4 states that where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by provisional specification treated by a virtue of direction under sub section 3 as a provisional, that is the purported converted into a provisional what we saw in the earlier subsection.

The controller may if the applicant so request at any time before grant of a patent, cancel the provisional specification and post date the application to the date of filing the complete specification. Now post dating there is also a concept called anti dating, post dating is where you change the date of priority to another date. You filed an application normally the date of filing is regarded as a date of priority, but if of a some reason you want to post date it the law allows you to do that given certain conditions.

9 4 talks about an instance where a provisional is filed for the first time and within the close of 12 months when you have to file the complete you realize that there are certain things disclosures made in the provisional which you do not want to come out in the public domain for whatever reason. You could write to the controller and ask the controller to cancel the provisional because once the provisional is cancelled it is not shared it does not become a part of the patent documentation. So, at a later point if somebody is makes a request for the information regarding to the patent this cancel provision will not be there. Cancel the provision specification and post date the application. So now, let us assume a case where a provisional is filed on January first and

in June first a complete is filed because complete could be filed anytime before December 31st the 12 month period. Say on June first an complete is filed based on the provisional, the applicant feels that the disclosure made in the provisional should not be available to the public for whatever reason may be the provisional was badly worded otherwise some confidential data that got into the provisional, because most of the time provisional specifications are filed in a hurry for whatever the reason the applicant feels that the provisional should not become a part of the patent documentation.

So, the applicant can write to the controller requesting the provisional to be cancelled. So, once you cancel then automatically the priority of Jan first is not available for you. With the cancellation of the provisional the application now has to be post dated. So, the date of priority moves from January first to June first which is the date on which the complete was filed.

So, the advantage or the league time in preserving the priority which the applicant had is now lost because of post dating. So, post dating is done for some very specific reasons there could be strategic reasons for post dating things, but when post dating is done the applicant loses the priority that the initially claimed through his provisional specification.