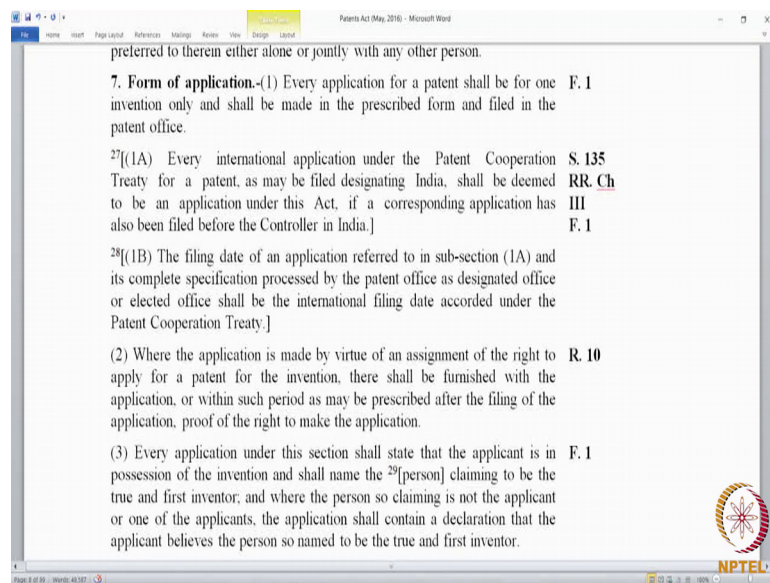


Patent Law for Engineers and Scientists
Prof. Feroz Ali
Department of Management
Indian Institute of Technology, Madras

Lecture - 21
Patent Prosecution: Patent Applications
Form of Application

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Now, we come to section 7. Section 6 told us the categories of persons who can apply for a patent, section 7 deals with the form of application. Now in what because as we had already mentioned the prescribed forms are contained in the second schedule of the rules and for everything there is a form, almost for anything that you need to do there is a form and there is also a form if you are not sure which form to use, there is a form to use where there is no form prescribed. So, it is quite comprehensive in that in that sense form 30 is to be used where it is a miscellaneous form 30 is to be used where no form is prescribed.

So, for everything that you do before the patent office, there is a prescribed form and if no form is prescribed then you could use form 30. 718 deals with the international application under the PCT or the patent cooperation treaty, which states that an application filed designating India shall be deemed to be an application under the Patents Act provided a corresponding application has been filed before the controller in India. PCT

requires corresponding applications to be filed; the patent cooperation treaty is a mechanism which facilitates filing for an application, you can file an application in a PCT receiving office and then you could take up the application in multiple jurisdictions and prosecute them we shall be dealing with this in detail when we discuss international arrangements.

Section 7(1)(b) mentions that the date of filing the application referred to in subsection (1)(a) and its complete specification processed by the patent office as designated office or elected office these terms which are used in international filings, shall be the international filing date accorded under the patent cooperation treaty. So, the date of filing you will find that the date of filing is an important concept in patent law; the date of filing of an international application shall be the international filing date. Now there are cross references which are relevant at this point.

Section 45(1) and section 45 talks about the date of patent; section 45(1) says subject to other provisions contained in this act every patent shall be dated as of the date on which the application for the patent was filed. So, date of filing the patent is what we call the date of patent section 45 refers to it as the date of patent. The mention of international filing date in section 7(1)(b) can also be seen in section 138 sub clause 5, which states the filing date of an application for patent and it is complete specification processed by the patent office as designated office shall be the international filing date accorded under the patent cooperation treaty. So, you find that international filing date concept appearing again. So, we will discuss that in detail when we come to the chapter on international arrangements.

Section 7(2) states that 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 within such period as may be prescribed after filing of the application proof of right to make the application. Proof of right is a concept which arises only when the application is made by a person other than the true and first inventor. When the true and first inventor makes an application there is no need to produce the proof of right because the fact that the inventor makes a declaration that they are the true and first inventor is sufficient, but if any other person who derives their right from the true and first inventor makes the application, which could be an assignee or the legal representative will be just like the true and first inventor lastly the assignee. The assignee should show that the

rights in the invention and the right to make an application have been assigned to them by virtue of an assignment.

So, rule 10 is the corresponding rule, now 7 2 tells us that the proof of right has to be made has to be furnished either with the application or within such period as may be prescribed after filing the application; that is prescribed in rule 10. Rule 10 states where in an application for a patent made by virtue of an assignment of a right to apply for a patent for an invention, if the proof of right to make the application is not furnished with the application, the applicant shall within the period of 6 months after filing such application furnished such proof. Explanation for the purpose of this rule 6 months period in the case of an application corresponding to an international application and which India is designated shall be returned from the actual date on which the corresponding application is filed in India. How do you compute the 6 months in the case of international application as mentioned in the explanation.

The proof of right in a normal case will be an assignment deed if you do not call it an assignment deed, but it is any document that shows the assignee has derived the right to make the application on behalf of the or from the true and first inventor. It could be a special assignment deed, it could be the terms of employment between the true and first inventor and the assignee if the assignee, is the employer of the inventor it could be a formal letter saying that I assign. So, any kind of proof the act and the rules do not describe or do not specify a particular kind of an assignment deed or a particular kind of an assignment, it just says you just need to produce the proof of right.

How is that you are making this application when you have you are not the inventor. So, any assignee who makes an application needs to show that he has a proof of right and the proof of right could be an assignment deed, could be an employment contract, could be some kind of a instrument through which they can demonstrate that the true and first inventor has assigned the right to make the application. And if it is not filed if the proof of right to make the application is not filed along with the application, then it has to be done within 6 months of filing the application Subsection 3 states that 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 and where the person so claiming is not the applicant or one of the applicants, the application shall contain the

declaration that the applicant believes the person. So, name to be the true and first inventor.

Now, all these details you can find in form 1. Now just largely described certain things that are contained in form 1; there is a requirement that the applicant who makes the application has to show that the applicant is not possession of the invention. This is the concept to show that the invention was in a form or the invention at attend the one way to explain this is to the concept of possession of the invention is required by law to ensure that the invention was in a form in which it could be put to practice, that is one explanation. The other explanation is to show that the person who made the application was actually incomplete possession and control of the invention.

So, there was no possible ownership disputes that could arise because the person at made a declaration that they are in possession. So, this could be understood in 2 ways. So, if you look at form 1 again clause 12 on declarations, sub clause 3 declaration by the applicant the first declaration is I am slash v or in possession of the above named invention. So, there is a declaration on possession of the invention that the applicant; it is just not the inventor the applicant needs to make because the law assumes that you can make an application only if you possess the invention. Now this is we may not conceive this as a physical possession of the invention, this is the possession which enables or gives the person the right to make an application.

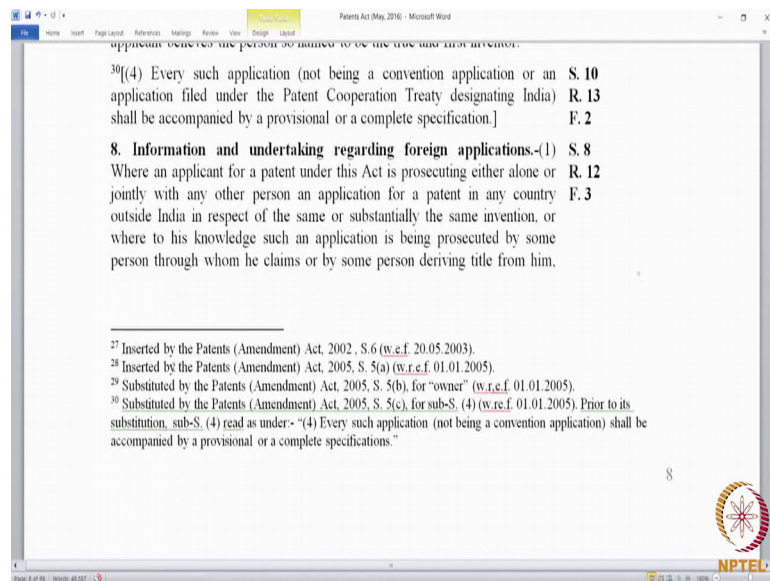
So, this declaration is required this is not something which applicants worry about, this is very not a controversial provision at all, but nevertheless this as remained in our act that an applicant who makes application for patent needs to make a statement that he or she is in possession of the invention. Then the second requirement on the on the subsection 3 is that the true and first inventor needs to be mentioned the name of the person claiming to be the true and first may inventor has to be mentioned; again this is a requirement in clause 4 of form 1 and where the true and first inventor is not the applicant or is not one of the applicants or not making the application and we discuss this earlier the status of an inventor is different from the status of an applicant.

So, in form 1 you will find there is a column where you need to mention the inventors, there is also a column where you give the details as an applicant you sign as an applicant the declaration made as an applicant. If you see clause 12 on declaration, there is a

separate declaration made by the inventors and a separate declaration made by the applicant. So, the status of an inventor is different from the status of an applicant the inventor in some cases could be the applicant, but it is not necessary that in all cases the inventor has to be the applicant. So, where the inventor is not the applicant, then the application shall contain a declaration that the applicant believes the persons who name to be the inventor or the first inventor; believes the persons who name to be the true and first inventor.

Clause 4 of form 1 covers both the categories of inventors; inventors who are applicants and inventors who need not be the applicant. So, in cases where the inventors are the applicant they have to show that they are also applying in the status of an applicant. In clause 4 there is also a column with says if no furnished the details of the inventors. So, where the inventors are not applying for the patent, say the patent is being applied by an assignee then the details of the inventors need to be mentioned in clause 4.

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So, the part of the form 1 which has a reference to 7 3 is clause 4. 7 4 talks about the form 7 4 talks about what should accompany and application when a patent is 5.

So, the rule in patent law is that form 1 has to be filed along with form 2. Form 1 is the form that is used for making an application for grant of a patent, and form 2 is the form that is used for a provisional or a complete specification. Patent specification is the document that encompasses or describes the invention there is the whole lot of parts in a

patent specification, the patent specification describes the invention and it ends with one or more claims it has a title there is an abstract.

So, the formal document that encompasses the invention for which a patent is sort for, is what we call the patent specification and the patent specification can either be a provisional or a complete. Now here in 7 4 it is mentioned that every such application not being a convention application or an application filed under the PCT patent cooperation treaty does not dating India. So, these 2 are the kinds of international applications. And international application can either be a convention application or can be an application under the PCT for patent cooperation treaty. Except for these 2 every such application shall be accompanied by a provisional or a complete specification which is what I mentioned as a rule you cannot file form 1 without form 2, or form 1 should always be filed along with form 2.

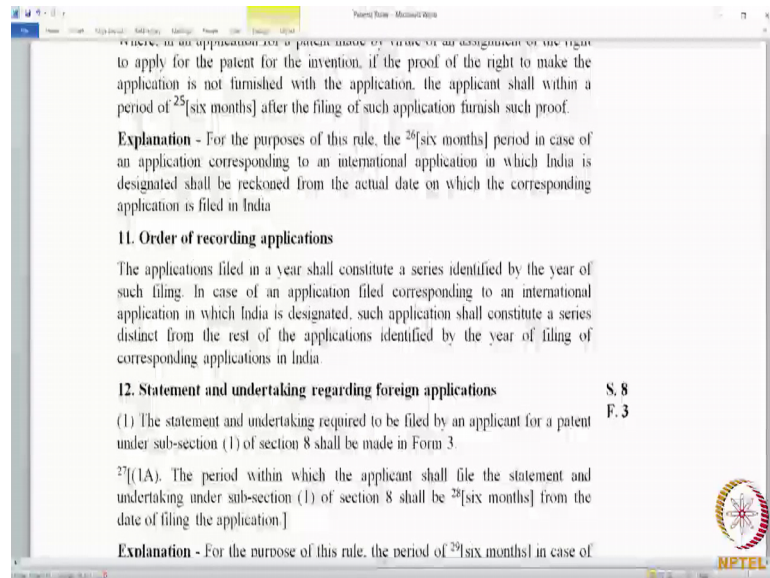
So, if you prefer an application for a patent, it is essential that you have a copy of the provisional or the complete specification and to file the provisional or the complete specification you need to use form 2. Why is this exception made, why is inverted in this fashion? The section could have said every such application shall be accompanied by a complete specification why provisional or complete. The reason for this can be found in section 136 1 a which talks about convention application, it is mentioned that every convention application shall be accompanied by a complete specification. So, you cannot file a convention application based on a provisional. So, that is why a convention application and the same rule apply for PCT 2, the convention application and a PCT when it is applied it can only be done with complete specification.

So, the cross reference to this part of the section is 136 subsection 1 a. Since a convention application and a PCT application cannot be filed by up by filing a provisional specification those 2 things are exempted here. So, you will understand the full import of 7 4 by looking at 136 1 a and 136 1 a clearly mentions for an international application which includes a convention and a PCT application it shall be accompanied by a complete specification.

So, you cannot file those applications by a provisional by or by using a provisional. Where as in India if you are preferring an application in India alone, what we call a application at domestic application or a local application filed in India alone, then you

could have a provisional filing that the form 2 can contain a provisional and still your application will be taken into account. So, 7 4 talks about 2 types of application; 7 4 talks about 2 kinds of specifications that can be used, and 7 4 very clearly says that if you are filing a convention application or a PCT then compulsory specific at the then complete specification is mandatory.

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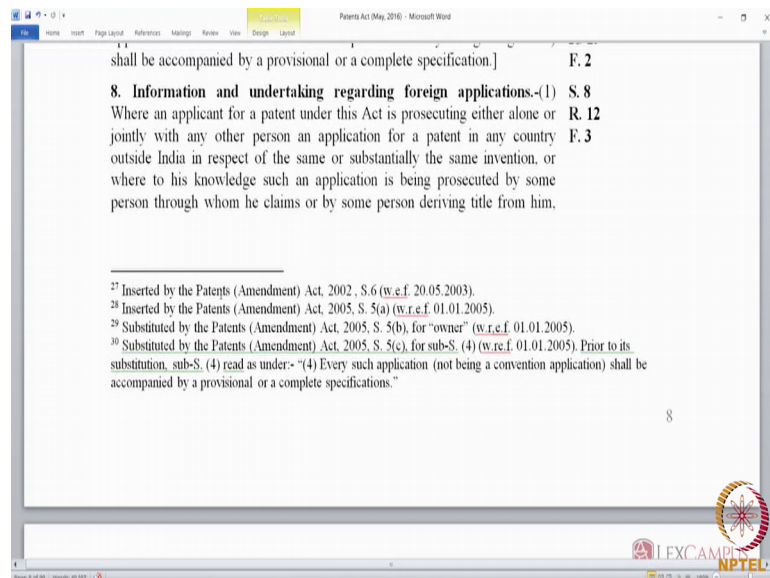
Section 7 which deals with form of application gives us a rough idea about kinds of application, now we understand that there is an Indian application which you can make for which you will get a grant in India where the patent is granted, and there are also 2 types of international applications that can be made; one is the convention application and the other is the PCT or the patent cooperation treaty and application made under the patent cooperation treaty.

We also understand that the requirements for filing these 2 applications are different. You could file an Indian application based on a provisional where as an international application cannot be file based on a provisional specification it as always it should always be accompanied by a complete specification. And we will come to the details about what a provisional is and what a complete specification is we will discuss those details in section 9. Now we can rough understanding of how the patent system works; section 6 talked about who are the applicants who are the people who can apply then 7

tells us about the forms to be used and we saw that form 1 has to be used along with form 2, section 6 tells us about the persons and section 7 tells us about the procedure.

Now, what these 2 provisions are silent about is the fact that with the applications will be filed in a patent office and soon after filing them the patent office will have it is own procedure to follow in accumulating these application. You find some detail in rule eleven order of recording applications. Now once the application is filed then the patent of his needs to record those applications in the order in which it received it. So, order 11 tells us that the applications filed in a year shall constitute a series identified by the year of such filing. In case of an application file corresponding to an international application in which India is designated, such applications have constitute a series distinct from the rest of the application identified by the year of filing of the corresponding applications in India which simply means that if you file an Indian application it gets numbers sequentially based on the year, but if it is a foreign application or an international application the numbering is different. Now we will show you some instances we will take you through the website.

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And show you how this works section 8 information and undertaking regarding foreign applications. Now section 8 is applicable only in instances where an applicant who makes an application in India, also files an application in a country outside India that is a foreign application in respect of something which is similar to the invention or

substantially the same, it has to be the same invention or slight modification largely the invention is the same. So, if the invention is same and if an application has been filed in India if there are any corresponding foreign applications, there is a duty cast on the applicant to furnish some information with regard to foreign application.

So, a section 8 will apply only in cases where there are corresponding foreign application is filed, it will not apply in a case where a person prefers Indian application alone. So, it will not apply in those cases. Now why is this provision there? One of the reason for this provision is that not all patent offices have some duty to cooperate with the each other or do they have an arrangement where they can share information filed by different applicants before them. For instance the Indian patent office will not have any arrangement with the Japanese patent office or the European patent office, to understand who is filing what invention and to disclose that; obviously, many of the filings once they get published get into the public domain, but there is no duty of cooperation between the patent offices.

So, in such cases the duty to share information about a pending foreign application is casted on the applicant. Now why should the applicant disclose, this why cannot the applicant just file an application in India; prosecuted and not disclose this to the patent office as to what is happening to is other application which you would have filed in other jurisdictions. One reason behind this provision is that at the patent office needs to be kept informed as to what is happening in other jurisdictions with regard to the same application. It does not mean that the patent office will follow a decision taken by another patent office or in another country or it will be or the in the decision whether to grant or reject the application will be influenced by the decision of another patent office, it merely means that there is a duty casted on the applicant to share information on what has happened to his other applications, which are substantially the same.

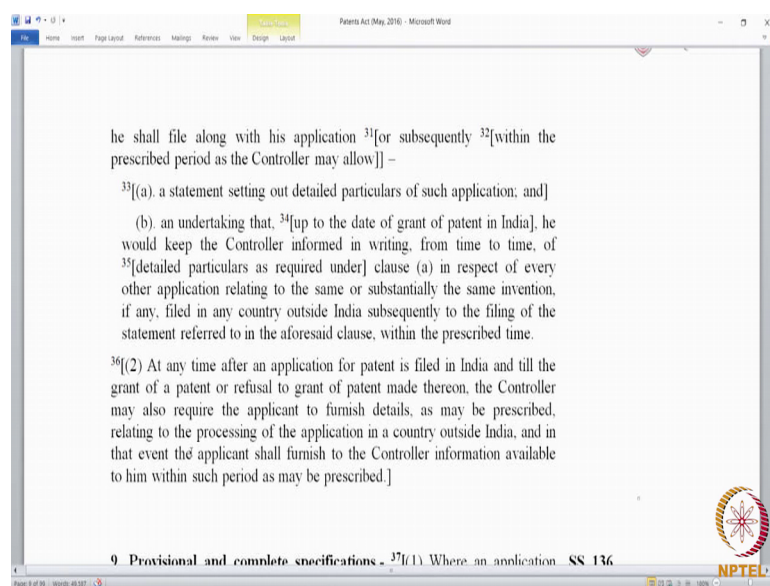
Section 8 reads section 8 subsection 1 where an applicant is for a patterned under this act is prosecuting either alone or jointly with other person with any other person and application for a patent in any country outside India in respect of the same or substantially the same invention. So, the invention can be same or it could also be substantially the same because you will know that patents are ever granted in the manner in which they are applied for; in very rare cases they are granted in the way in which they are applied for. Prosecution or this scrutiny by the patent office will require the

applicant to make some changes to give up certain things to narrow down the scope of invention and all these things could happen based on the objections raised by the patent office and patent offices because they do not co operate and work with each other their objection is that a patent office would raise on a same invention can substantially vary from one patent office to another.

So, then end result of an invention that is granted based on the same patent application would look different in different jurisdictions. For instance in India a method of treatment cannot be the subject matter of a patent. So, if there is a claim on a method of treatment most likely that will be struck off by the Indian patent office whereas, claim for a method of treatment may get granted in by the United States and it could be one of the claims that is covered for the invention.

So, even though the method of treatment is just one of the many claims in that invention, it will still be regarded as substantially the same invention, though the corresponding application in India may not have the method of treatment claim. So, that is why the wording in section 8 refers to not only the same invention, but it also refers to substantially the same meaning which even a small changes have occurred in the course of prosecution or even before filing the applications, still it will be regarded as the same invention.

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Section 8 1 continuous 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 this application or subsequently within the prescribed time as a controller may allow. So, it is not necessary that the applicant should be prosecuting the application, it could be somebody who claims through him still there is a duty cast on the applicant to give the following information. Now this could be filed the information that is required could be filed along with the application that is an option given to the applicant or subsequently within the period prescribed. And we are already mentioned this wherever you find this term period prescribed time, prescribed form, prescribed then the details are most likely to be in the rules.

So, we will get to the corresponding rule soon, now what is the information that is required. A: statements starting out detailed particulars of such application the statement showing the application details of the application, application number the patent office in which it is preferred date of filing all the details and an undertaking that up to the date of grant of the patent in India he would keep the controller informed in writing from time to time of detail 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 subsequent to the filing of the statement referred to in the aforesaid clause within the prescribed time.

Now, the first one is the statement that the applicant discloses all the pending or other applications which are substantially the same, that the application number the patent office before which it is filed the details, the date on which it is file. In the second thing is that the applicant gives an undertaking; the undertaking is that he will hold or he will keep the controller informed in writing from time to time. The status of every other application he has filed outside India. So, there are instances where some pharmaceutical companies file 30 odd or 50 odd applications around the world using the PCT mechanism or the convention mechanism in all those cases if there is an application pending in India, the applicant is duty bound to disclose the status of all the other 30 odd or 50 odd applications that are pending elsewhere. And this undertaking will hold good or the applicant will have to keep the undertaking up until the grant of the patent in India.

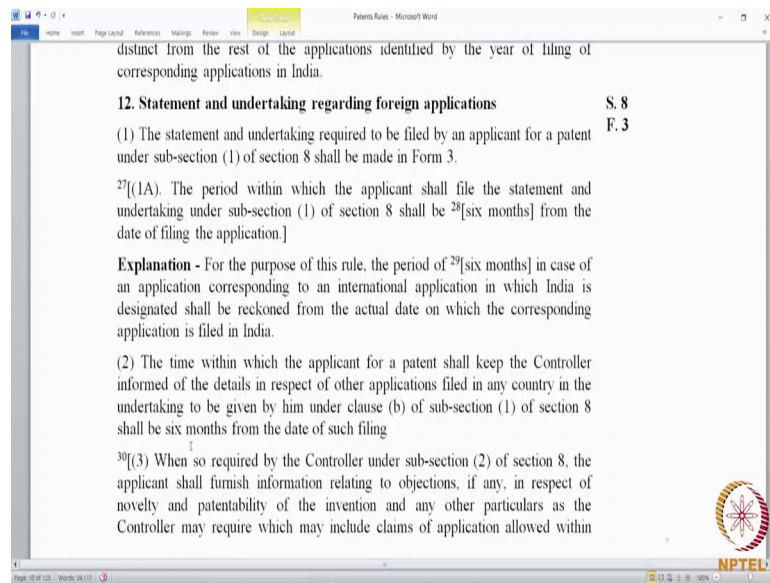
So, as I said this gives the patent office the benefit of what is happening in other jurisdictions. So, let us take hypothetical instance where an application is filed in ten

jurisdictions including India; and during the course of the prosecution 7 major jurisdictions have rejected that application, and when the application comes for examination in India this will give the patent office an extra information that if 7 major patent offices have rejected this application, in the patent office will probably look at that application more seriously or it will take much more studied view of that application, because now the patent office knows this status of what happened to the same application and 7 other major jurisdictions.

So, this is a way in which the patent office can know what is happening to similar applications in other jurisdictions, but this is not through a cooperation between the patent offices rather the duty is casted on the applicant to furnish this information. 8 2 says at any time after the application for the patent is filed in India and till the grant of the patent or refusal to grant the patent made there on, the controller may also require the applicant to furnish details as may be prescribed relating to the processing of application in a country outside India, and in that even the applicant self furnish to the controller information available with him within such period as may be prescribed.

Now, 8 2 gives the controller the power to require the applicant to furnish details. The first one 8 1 is where the applicant has to for it is certain details, 8 2 gives the controller the power to require the applicant to furnish details. So, the first one we will understand 8 1 as the voluntary act which the applicant has to do within the stipulated time, 8 2 gives the right for the controller to ask for details.

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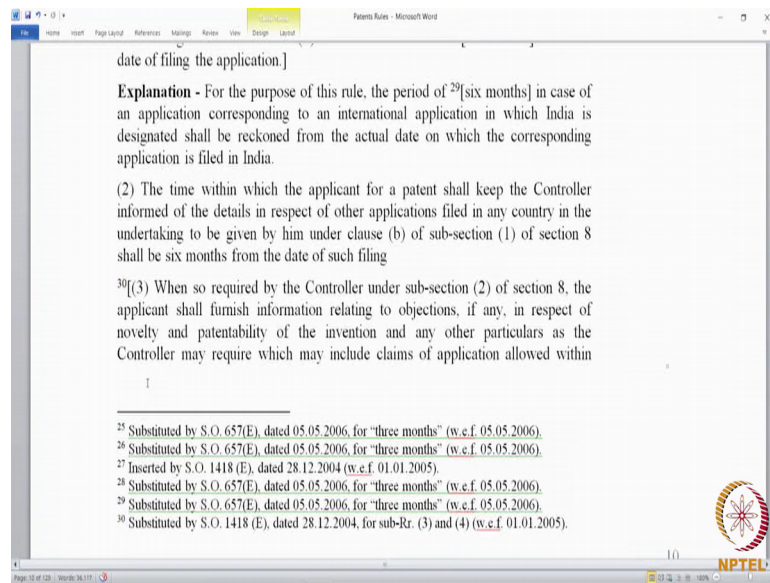


The corresponding rule is rule 12 and the corresponding form is form 3. Form 3 is the form in which a statement and undertaking under section 8 is made the corresponding rule is rule 12.

Now, rule 12 1 tells us that it shall be made in form 3 and the period within which the applicant shall file the statement shall be 6 months from the date of filing. The act said shall be filed within the time prescribed there is an option to file it immediately along with the application or if that is not done within 6 months time it has to be done; and the explanation says how the 6 month has to be computed in case of an international application, it will be reckoned from the actual date on which the corresponding application is filed in India.

Now, rule 12 2 states that the time within which the applicant for a patent shall keep the controller in form in respect of other application filed in any other country, shall be 6 months from the date of such filing. So, the time within which the applicant shall keep the patent office informed. So, if there is an application is filed in a jurisdiction then within 6 months the information has to be communicated to the controller.

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And rule 12 3 says that when so, required by the controller under subsection 2 of section 8. So, we mentioned that 8 1 is cause a duty on the applicant to file it voluntarily he has to rule it on his own, 8 2 gives the power to the controller to asked for information. So, when so required by the controller under 8 2 the applicant shall furnish information relating to objections if any in respect of novelty and patentability of an invention, and any other particular as the controller may require which may include claims of application allowed within 6 months from the date of such communication to the controller.

Now, the 8 1 cause the duty to share the application details and undertaking that he will give further information. If once that is done the controller can look at the form 3 and if the controller finds that there are multiple applications pending in other jurisdictions; obviously, the controller will have the over right to a such and find out what is the status and those jurisdictions. Now assume that there is been an objection on patentability a novelty objection or an inventive step objection in a foreign patent office and the controller comes to know that this has happened. The controller can ask the applicant to furnish information relating to those objections, because in some cases these documents may not be in the public domain. So, the 8 2 allows the controller to ask for those documents. So, again as we said the legislative objective and having this provision is to allow the patent office in India to take informed decision.

So, if there is something that has gone wrong on the same application in another jurisdictions, then the controller can get the benefit of that decision. Again the time period prescribed in 12 3 is 6 months from the date of communication by the controller. So, when the controller sense request asking details to be furnished that has to be done within 6 months.

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The screenshot shows a Microsoft Word document with the following content:

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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 applicant 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 _____


NPTEL

Now, let us come to form 3 you will find that these are the details that the applicant has to be furnish; name of the country, date of application, application number, status of application, date of publication, date of grant in all the jurisdictions where it is pending. So, the clause 2 deals with the information on the application and clause 3 here talks about the declaration.

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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 _____ _____		
			*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__		

155 Substituted by the Patents (Amendment) Rules, 2016 vide G.S.R. 523(E), dated 16.05.2016, w.e.f.



Now, the declaration is I we undertake that up to the date of grant of the patent of the controller, I we would keep in informed in writing the details regarding corresponding applications for patents filed outside India within 6 months from the date of filing of such application. So, this is the undertaking. So, we solve in the language of section 8 there is a statement and an undertaking; the statement is in clause 2 or form 3 and they undertaking is in clause 3.