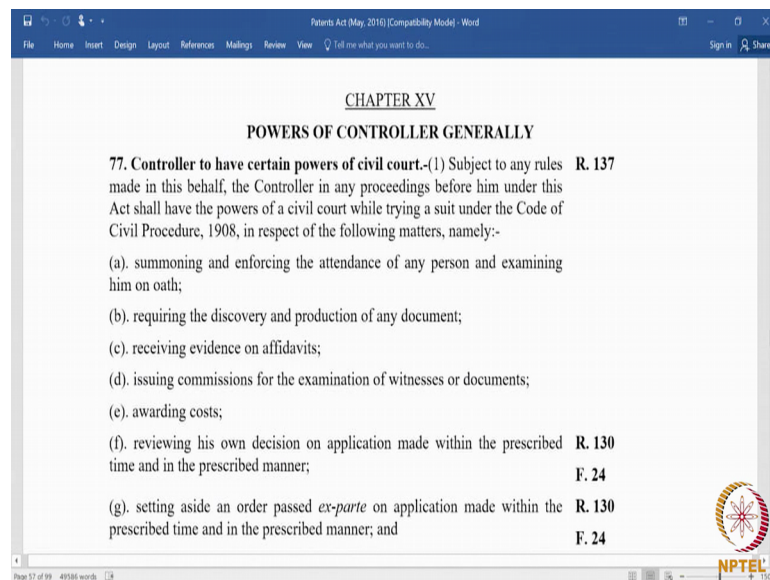


Patent Law for Engineers and Scientists
Prof. Feroz Ali
Department of Management
Indian Institute of Technology, Madras

Lecture – 23
Patent Prosecution: Patent Application
Powers of Controller: Generally

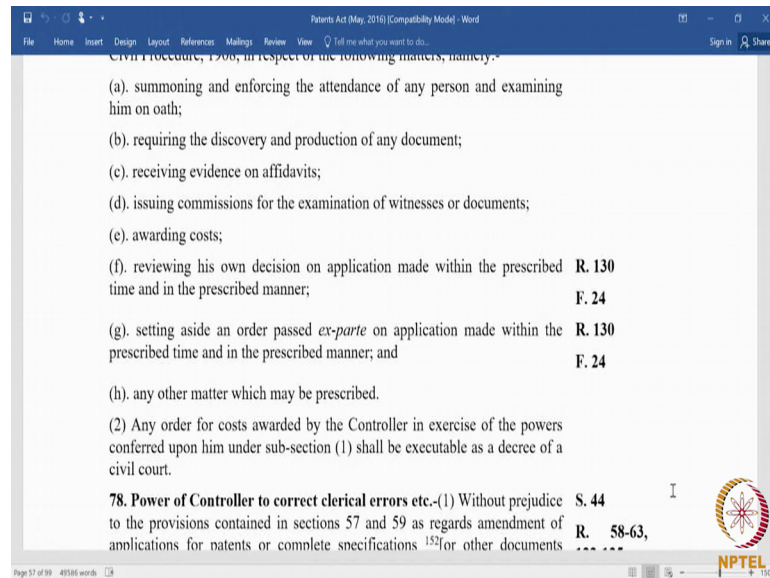
“Powers of controller; generally”; chapter 15 deals with the powers of the controller generally, we have just seen that the controller has certain special powers in certain circumstances. Now this lists the general powers of the controller powers of the controller generally.

(Refer Slide Time: 00:33)



Section 77; detail some of the powers that the controller has that are similar to the powers of a civil court. 77 once tells us that subject to any rules made in this behalf the controller in any proceeding before him under this act shall have powers of a civil court while trying a suit under the code of civil procedure, in respect of the following matters namely one a summoning and enforcing the attendance of any person and examining him on oath; b requiring the discovery and production of any document: c receiving evidence on affidavits: d issuing commissions for an examination of witness or documents: e avoiding cost f reviewing his own decision: g setting aside an order passed ex parte and h any other matter which may be prescribed.

(Refer Slide Time: 01:34)



Two any order for cost avoided by the controller in exercise of the powers conferred upon him under sub section 1 shall be executable as a decree of a civil court. Now these are powers which the controller would exercise when there is some proceeding before him in 77 1, it says that controller in any proceedings before him under this act. So, we can understand that as re grant opposition or a post grant opposition which have proceeding before him proceeding to surrender the patent, proceeding for an application for a compulsory license, a proceeding for amendment of a patent after the grant which can be opposed. Now so we have different kinds of proceeding before the controller.

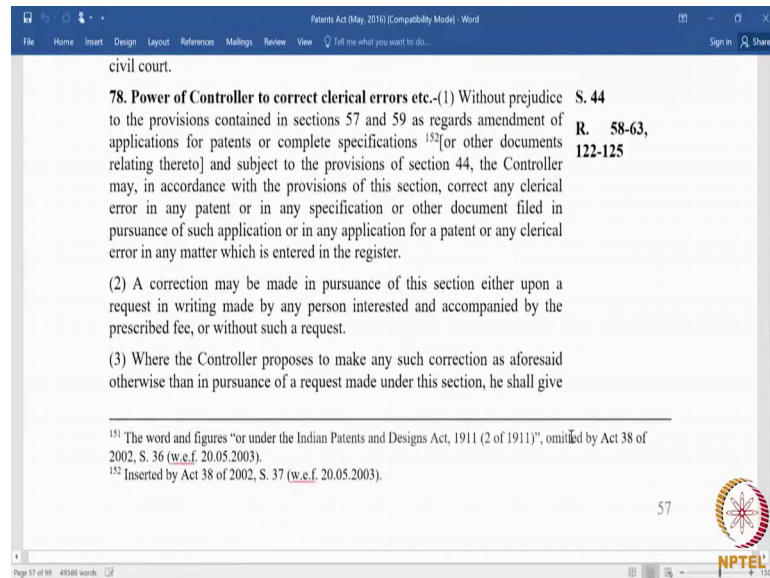
Now, the controller is given the powers of a civil court as a civil court has powers under the CPC or the code of civil procedure. Now what are those powers? He has the power to summon and enforce attendance of any person and examine him on oath. So, like a coat of law he can summon somebody to attend before him and examine the person, he can require the discovery or production of any document the power to discover documents the controller can receive evidence on affidavits evidence can be received on affidavits his own affidavit in fact, you will find that there is a provision under the rules with regard to the form of affidavit. Rule 126 tells us in what form the affidavits should be if the affidavits are so on in India or if they are so on outside India, in what form they should be and what are the requirement that has to be satisfied?

So, the controller has the power to receive evidence on affidavits, and he also has the power to issue commissions for the examination of witness or documents. Now commissions are normally issued when the controller or in a normal case when the court has to go to another place or the court has to do the examination of a witness or a document which is not before it. So, commissions can be issued, commission could be a person whom; trustworthy person whom the court or the controller can entrust the task with.

The controller at the end of the proceeding normally courts would award costs to the succeeding party, the party who fails as to award cost to the succeeding party, so the controller also has the power to award costs. The controller has the power to review his own decision codes of law have the power to review their own decision, similar power is given the rule 130 deals with the review of the decisions passed by the controller, and the power controller can also set aside an order passed ex parte. Ex parte is an order passed with by hearing only one side or without hearing the other side. The controller also has power to set aside an order passed ex parte that is in the absence of the party, on application made within the prescribed time the prescribed time is mentioned in rule 130.

And the controller also has general powers on matters which may be prescribed. Now when the controller awards cost in a proceeding, the same shall be executable as a decree of a civil court which means the fact that the controller has computed cost to the succeeding party, the award on cost could be executed as a decree of court. So, you can have a execution proceeding file directly to recover the cost from the other party.

(Refer Slide Time: 05:43)



Now, section 78 enumerates some powers of the controller to correct clerical and other types of errors.

Now, normally if a document needs to be amended then the powers of the controller to amend the document comes under section 57. But in section 57 we look at section 57 and 59 as sub stand to the amendments, amendments made to correct a document or a complete specification. 78 gives the power for the controller to correct clerical errors, clerical errors we understand that as minor corrections which say a typographical error or a grammatical error or something that is not clear at which we when compare with section 57 and 59 we will look at those amendments as pertaining to some substantive aspect of the document. 78 1 begins without prejudice to the provisions contained in section 57 and 59 which pertain to amendment of documents and complete specification.

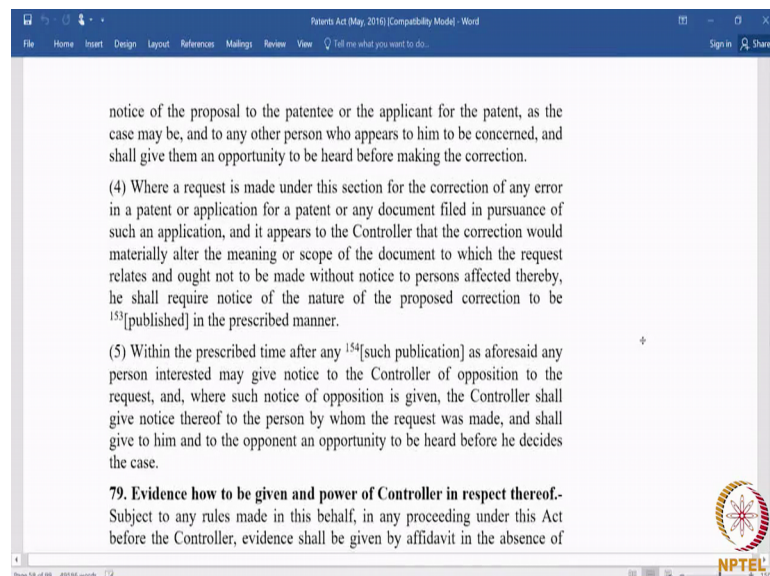
And subject to provisions of section 44, and 44 is amendment that is carried out after one of the applicant dies. So, amendment to carry out the change in the name of a diseased applicant; now baring or without prejudice to the amendment under section 57 and 59 and the amendment under section 44, which is the amendment that is carried on when the applicant dies. The controller name in accordance with the provisions of this section correct any clerical error in any patent or in any specification or other document, file will pursuance of such application or in any application for a patent or any clerical error in any manner which is entered in the register. So, the controller has wide powers to correct

not only specification or a patent or any document filed along with the application, but he also has the power to correct clerical errors in the register. Now if the register needs to be rectified say there is a substantial omission, a person's name was left out or a person's name was entered into the register without sufficient cost, now we regard those things have a substantial correction for that there is a separate provision for rectification under section 71.

Now, this rectification or this correction is for a clerical error. So, 78 1 can be used for correcting clerical errors entered in the register. 78 2 a correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by prescribed fee or without such request. So, 78 2 tells us that the correction can be made by a request made by a party or without any request so being made.

78 3 tells us that when the controller proposes to make a correction in pursuance of a request made under the section, he shall give notice of the proposal to the patentee or the applicant for the patent as the case may be or any other person to who appears to him to be concerned and shall give opportunity to be heard before making the correction.

(Refer Slide Time: 09:08)



Now, we saw that the request for correction is made by a person interested. So, when a person interested makes that is a third party other than the applicant or the patentee, when a third party makes a request the controller has to hear the patentee or the applicant

as the case may be. If the patent is granted then becomes the patentee, if the patent is not granted any correction has to be made by hearing the applicant. Now if the clerical error or the correction is not routine or a correction pertaining to a clerical error and if it would materially alter the scope of the document then the controller has to publish the proposed correction. Now just like in an amendment under section 57 the amendment needs to be published because amendments are normally understood as substantive changes to an existing document.

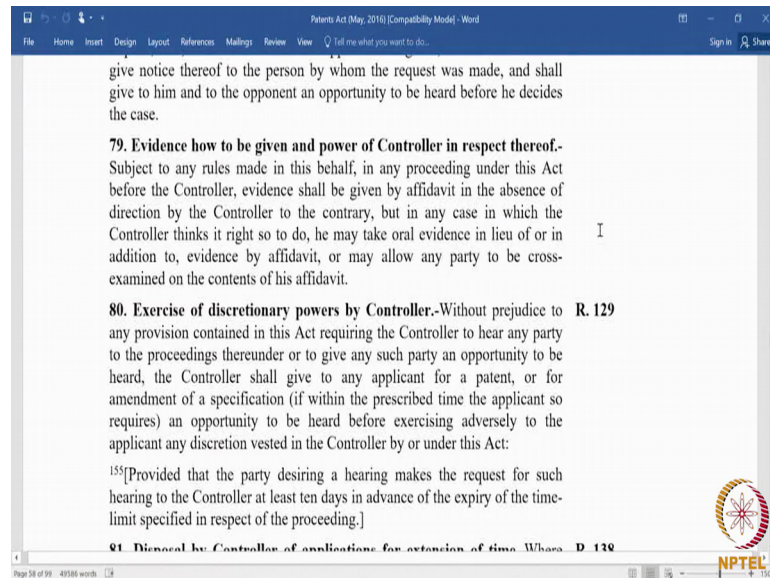
So, in 57 we have a procedure for publishing the proposed amendment. Similarly if the correction is a substantive correction and we understand it as a substantive correction because 78 4 uses the word materially alters the meaning or scope of the document. So, in something materially alters the meaning or scope of a document, we do not understand that as a mere clerical correction, we understand that as a substantive correction. In substantive corrections have to be done this procedure becomes something similar to the procedure under section 57. 57 an amendment has to be published proposed amendment has to be published in 78 4 the proposed correction has to be published.

78 4 treats where request is made under the section for the correction of an error in a patent or a application for a patent or any document filed in pursuance of such application, and it appears to the controller that the correction would materially alter the meaning or scope of the document. To which the request is released and ought not to be made without notice to the persons affected by, he shall require notice of the nature of the proposed correction to be published in a prescribed manner. So, the notice of the proposed correction needs to be published. 5 within the prescribed time after any such publication as aforesaid any person interested may give notice to the controller of opposition of the request.

Now this brings in opposition proceedings. So, if there is a material alteration or a correction that can materially alter the meaning and or scope of a document, if there is a notice given for such a proposed correction a person can oppose it. So, just how a person can oppose an amendment under section 57, we will soon see how amendments under section 57 operate, a person can also oppose a proposed correction. And where such notice of a opposition is given the controller shall give notice thereof to the person by whom the request was made and shall give to him and to the opponent an opportunity to be heard before he decides the case.

So, the proceeding from once an opposition is instituted against a proposed correction then the rules mentioned in chapter 6 of the patent rules will apply to those cases. This the chapter 6 of the patent rules deals with opposition proceeding to grant of patent, and you have section 55 a and section 57, 58, 59 and so on detailing the procedure of a post grant opposition the same procedures will apply in this case to.

(Refer Slide Time: 13:34)



Now, 79 tells us how evidence can be given and the power of the controller in respect thereof. We saw that the controller has the power to accept evidence in the form of affidavits. Receiving evidence on affidavits we saw that in section 77. Now subject to any rules made in this behalf in any proceeding under this act before the controller evidence shall be given by affidavit in the absence of the direction by a controller to the contrary.

So, in a normal case evidence is given by affidavit, but in any case in which the controller thinks it right so to do he may take oral evidence in lieu or in addition of evidence by affidavit or may allow any party to be cross examine on the content of his affidavit. Now in a normal case the controller will only take evidence by affidavit, but he could also allow evidence in the form of oral evidence either in lieu instead of an evidence by affidavit or in addition to evidence by affidavit, and may also allow any party to be cross examined on the contents of it his affidavit. So, if a person files an affidavit and the person appears before the controller, if there is a case for cross

examining that person the controller has the power to allow that person to be cross examined.

Eighty deals with the exercise of discretionary powers by the controller, without prejudice to any of the provisions contained in the act requiring the controller to hear any party to the proceeding there under or to give any such party an opportunity to be heard, the controller shall give to any applicant for a patent or for amendment of specification an opportunity to be heard before exercising adversely to the applicant any discretion vested in the controller by or under this act provided that the party desiring a hearing makes the request for such hearing to the controller at least 10 days in advance of the expiry of the time limits specified in respect of the proceeding.

Now this provision says that wherever the controller exercises his discretionary power now discretionary power can be exercised under section 15, where he has to reject an application require the application to be amended or grant an application. So, wherever the; and the controller can take a call on these things he can either reject the application ask the application to be amended or he can grant the application. Similarly under section 25 4 post grant opposition, he can either revoke the patent he can ask for the patent to be amended or he can allow the patent to continue.

He can either maintain the patent amend the patent or revoke the patent. Now in all these instances the controller is in reality exercising as discretionary power. On the same set of facts the controller may reject a patent application on similar set of facts the controller can also maintain the patent which is already been granted. Now the controller will obviously, give reasons for doing that, but this is what we understand as exercise of the controller's discretion. Now there are also certain things where the controller cannot exercise his discretion, now if a patent application is filed and a request for examination is made and the application has been published, the controller has to forward the application to an examiner. There is no discretion there the controller cannot withhold the application from being forwarded or allotted to an examiner for the examiner's report.

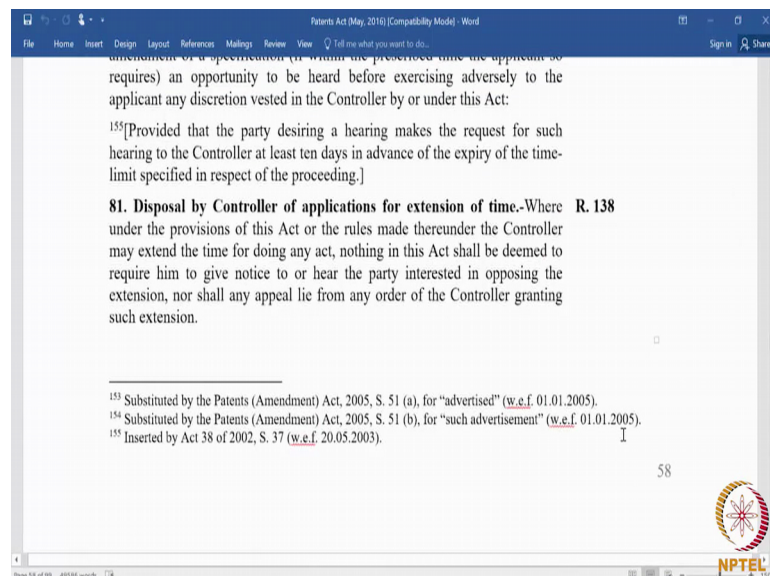
Now, he could only do that if there is a secrecy provision, even if there is a secrecy provision the controller cannot exercise his discretion. Similarly the examiner files a report and the controller applies as mind on the report and he prepare the statement of

first objection. Once the statement of first objection is prepared it has to be sent to the applicant, the controller cannot hold it back now. So, we understand that there are certain things where the controller does not have discretion, but there are other things under the act where the controller has the power to exercise his discretion.

So, wherever the controller has an chance to exercise his discretion adversely to the applicant, adversely in the sense that the application is filed the controller is inclined to refuse it under section 15, the controller has heard the post grant opposition and he is inclined to revoke the patent. So, again those are instants where he would be exercising his discretion adversely to the applicant, in such cases the controller shall give the applicant for a patent or the amendment of a specification applicant for the amendment of a specification an opportunity to be heard.

So, power to hear an applicant would come any time before the application is granted, and the power to hear upon an amendment would come any time before the amendment is allowed or amendment is refused. If a party request a hearing then the party should give notice to the controller at least 10 days in advance of the expiry of the time specified in respect of the proceedings.

(Refer Slide Time: 19:28)



The controller also has power to dispose of applications for extension of time. Now extension of time is normally filed using form 4; form 4 is the form that is used for seeking an extension on time request for extension of time. Where under the provisions

of this act or the rules made there under the controller may extend the time for doing any act nothing in this act shall be deemed to require him to give notice to or hear the party interested in opposing the extension, nor shall any appeal lie from any order of the controller granting such extension.

So, the controller has gentle power to extend the time for doing any act and if he does extend the time there is nothing in this act that shall require him to give notice or hear the party who may be interested in opposing the extension of time, nor shall an appeal lie to the intellectual property appealable. The corresponding rule is 138; and 138 list the other provisions which are time bounder, there are certain time bound things which are mentioned in rule 138.