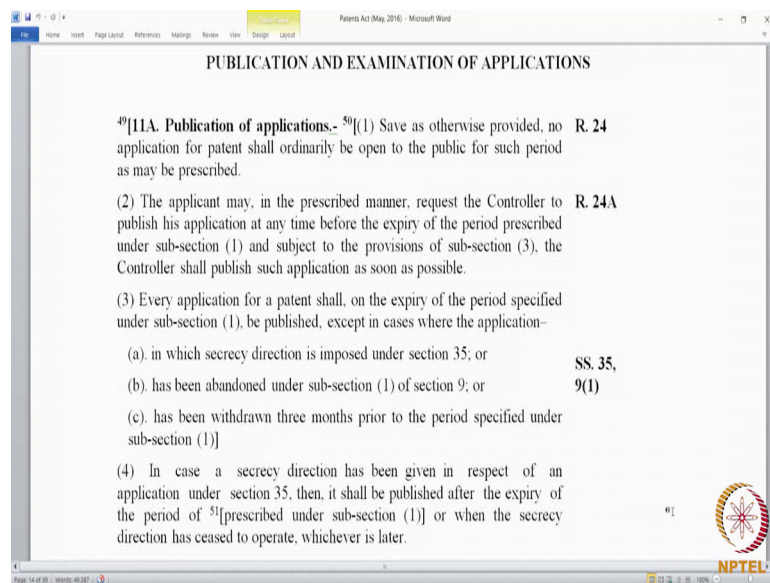


Patent Law for Engineers and Scientists
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Lecture – 27
Patent Prosecution: Publication and Examination - I
Publication of Application

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Publication and examination of applications; all this while we were looking at the process of making those application; what are the forms that need to be used; what is the structure of a complete specification; the difference between a provisional and a complete what form we will use for provisional or a complete; we were looking at the preparatory part of filing an application; we also saw some instance of who can prefer an application who are the people who are qualified to be an applicant under the patterns act. So, all these things pertain to the preparatory part creating an application complying with the procedural requirements we also saw some bit on priority because priority is important because when you are filing we when you are making disclosures and claims at different points in time though concept of priority becomes relevant if you make the disclosure and the claim at one point then the date of priority is the date of filing of the complete specification, it is a clear cut case.

So, section 1 to 11. So, far what we have seen apart from the a disk a preliminary and the definition sections deal with the preparatory part; what amounts to an invention, what are the exceptions to patent ability, who can apply, what should be the form to apply, what are the different types of specification when you can follow one specification with another and the priority rules. 11 capital A onwards we get into the patent office in the sense that the process of scrutinizing applications at the pattern office or what the term which we can formally use patent prosecution starts from 11 A and it goes on till 43 where the patent gets granting and your are still at the patent office for various other reasons till section 81 because till section 81 deals with various things that will happen soon after the grant of a pattern 82 still which talks about compulsory licenses is a procedure that happens as the patent office. So, from here on till the chapter on compulsory licenses we regard that as patent prosecution things that happen at the patent office.

So, once the application is filed. So, we know the relevant forms it has to be form one plus form 2 and form one at the end tells us about various other supplementary documents that you need to keep once the application is filed the application the first instance of action or rather the first instance of official action that happens from the side of the patent office is publication of this application. So, what you have done. So, far your filled in forms you put it inside the patent office the patent office gets interested in application in the official sense only when the application is published.

Now, I use the word in the official sense because there is also a scrutiny that happens for every application you file though it is not a scrutiny of the merit of your application it is a scrutiny for to ensure whether some secrecy provision should be applied now there is a scrutiny that happens to every application to see whether there are certain sensitive inventions pertaining to national security and defense that are covered in that invention. So, that scrutiny happens it is not a scrutiny of the merit of the application it is to ensure that what pertains to national security and defense of this country are not covered in a patent application and there is also a scrutiny that happens if you file a foreign filing license if you want to file a foreign filing license or if you seek permission to file abroad first then again your request will be looked at in not for the merit, but just it will be scrutinized quickly. So, apart from these officially the patent office takes up the application for scrutiny only after the publication of the application. So, 11 A 1 states

save as otherwise provided no application for patent shall ordinarily be open to public for such period as may be prescribed.

Now, again we have the prescriptions coming in now the prescription is described what is that such period you will find it in rule 24 and rule 24 is conveniently cross reference there. So, this period is 18 months from the date of filing the application. So, when you file an application ordinarily which means when the word ordinarily is mentioned they could be exceptions they could be extraordinary cases too ordinarily it shall not be opened to the public for a period of 18 months.

So, after 18 months the application is published now what is the merit of this 18 month period where nothing gets published it is just a matter of convenience that if the applicant wants to file applications in other jurisdiction he gets the time to do that. So, the 18 months period gives the applicant the time to file applications and prosecute them in other jurisdictions the 18 month period because the application is not published the information mention in the application will not come in to the public domain the advantage of the information not coming into the public domain is that the disclosure made in the patent application will be kept within the patent office and it will not be used for questioning novelty of the invention.

Assume that if an application is published immediately in India the day on which it is filed it is published on the same day or within a week after a month if the same applicant takes an application say in Sri Lanka or in Bangladesh or in the neighboring country then the fact that his own application which he filed in India was disclosed and published could be used for questioning the novelty in the application that he filed in a foreign country say in Sri Lanka or in Bangladesh the reason being that your own application can if published prior in time can kill the novelty of your applications which you file in other jurisdictions. So, the logic of the 18 month period is that you get enough time to have your applications in place before the first publication happens.

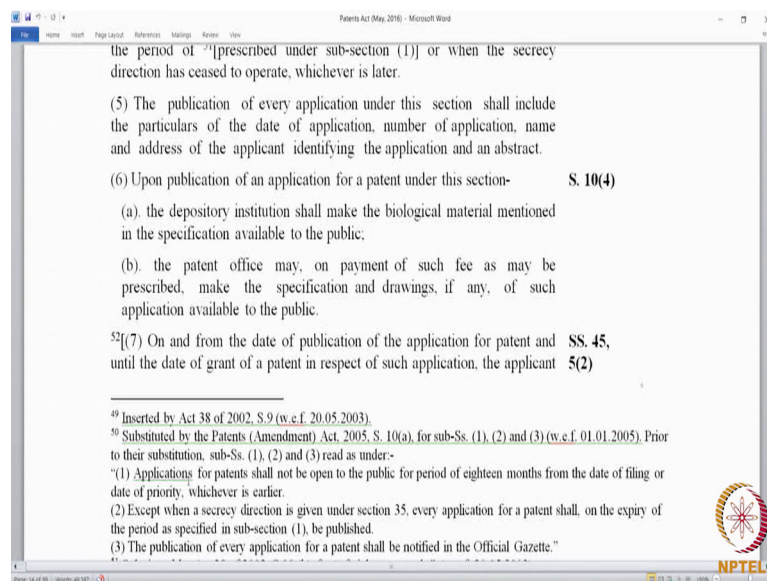
Now, assume that in applicant does not want the benefit of this 18 months assume an applicant wants to file an application only in India and is not bothered about going elsewhere and he is in a hurry he wants a grant quickly for whatever reason then the law allows him to take a request for publication which he can do on the date of filing the application itself. So, if you take a request for publication there is a provision by which

you can expedite the publication without having to wait for the 18 month period. So, the 18 month period the wisdom behind the 18 month period is to ensure that you get enough time if you are interested in filing applications in other jurisdictions.

11 A 2 states that the applicant may in the prescribed manner request the controller to publish his application at any time before the expiry of the period this is what we just mentioned the controller shall publish such application as soon as possible now this is covered in 24 A. So, rule 24 A is an exception to rule 24 A request for publication under subtraction 2 of 11 A shall be made in form nine. So, form 9 is the relevant form which has to be red in reference to 11 2 A and rule 24 A. So, form 9 is relevant for 11 A 2 and for rule 24 A.

So, when an applicant takes files; form 9 the application is published immediately. So, there is a way to circumvent the 18 month period or 18 month dormant period where the applicant lies dormant no activity on the applicant because the patent office will start scrutinizing it only after the application is published. So, if you want to expedite your prosecution process then you could make a request for publication if you do not make a request for publication; obviously, it get published at the end of 18 months. So, once you prefer an application it gets published whether you like it or not after 18 months if you are in a hurry you could take form 9 and form 9 is a form which is used for to request in early publication.

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Now, there are some exceptions the exceptions are covered in sub section 3 every application for a patent on expiry of the periods specified in subsection one that is 18 months shall be published except in cases vary application 1 2 and 3, there are 3 instances where in application will not automatically be published at the expiry of the 18 month period at the first instance is in which secret c direction is imposed under section 35, now I mentioned that there officially the patent office starts looking at the application only after the application is published now I use the word official because that is where the process of scrutinizing application on the merit begins, but the patent office does look in to the application to see whether any secrecy direction should be passed under section 35 if there is something covered in the patent which could affect the national security or defense of the country.

Now, if a secrecy direction has to be passed then there has to be some scrutiny some level of scrutiny because without that you are not going to pass that. So, that is done in most cases or it is presumed to be done whenever an application has filed. So, if there is a secrecy direction passed under section 35 that application is not revealed to the public domain it does not come into the public domain it is not published the publication is withheld. So, the 3 cases where a publication can be withheld the 18 month publication can be withheld which largely means that the invention is now in the public domain the invention is disclosed it comes out in the public domain the first instance is where a secrecy direction is passed under section 35 and the secrecy direction presumes that the application is looked in to by the patent office though not with the objective of scrutinizing it on merit it is a preliminary analysis has done.

The second instance is where the application is abandoned under section 9 one we had seen if you file a provisional come specification and do not follow it with a complete specification the provisional is deemed to have been abandoned because you did not close the loop you file the provisional you did not follow it up with the complete the law mandates you to file a complete at any time within 12 months of filing the provisional you did not do that. So, what happens to the provisional the provisional is deemed to be abandoned because there was no follow up on the provisional now this again is not published a provisional which is not followed by a complete is not published for that matter the provisional is never published what gets published is the complete and because the complete covers the disclosure made in the provisional the disclosure comes

out because it is captured in the complete. So, the provisional is never published, but because the complete covers the matters that are mentioned in the provisional the publication of the complete is a deemed publication of the provisional.

Once a complete is published it is possible for you to approach the patent office because you can make a request for information and you can ask for copies of the provisional it is possible for you to get in any case if there is a provisional after the complete is published you could request for a copy of the provisional, but the provisional in itself is not published. So, the second case where an application will not be published after 18 months is a case where an application was not followed a provisional was not followed by a complete.

So, a provisional is regarded as abandoned and that abandoned provisional is not published which means the matters disclosed in that provisional cannot be used as prior art for the sure fact that it is not published the third instance where an application is not published after the mandatory 18 month period is where it has been withdrawn 3 months prior to the specified period under subsection one now 3 months before the end of the 18 month period the application is withdrawn the form for withdrawal of the application is form 29.

11 A 4 states that in case a secrecy direction has been given in respect of an application under section 35 then it shall be published after the expiry of the period prescribed in subsection one or when the secrecy direction as ceased to operate whichever is later we will see when we discuss section 35 that there are certain things that you cannot do pertaining to a patent application when a secrecy direction is in operation you cannot publish the application you cannot disseminate information relating to the application that is the reason we call it a secrecy direction the direction is given to keep the matters contained in the application a secret.

Now, if a secrecy direction is issued under section 35 then the eventual publication of that application can happen one at the expiry of the 18 month period which is the default case or if the secrecy direction is still pending when the secrecy direction ceases to operate or has ceased to operate now whichever happens later the application would get published only after that point. So, if within the first 18 month period the secrecy direction ceases to operate then the application will be published at the end of the 18

month period if the secrecy direction continues beyond the 18 month period then the application will only be published when the secrecy direction ceases now this is just to protect the application from getting in to the public domain. So, 11 A 5 deals with the publication of an application and the corresponding provision where the application and the corresponding provision where the grant is published can be found in section 43 2 43 2 states that on the grant of the patent the controller shall publish the fact that the patent has been granted and there upon the application specification and other documents related thereto shall be open for public inspection.

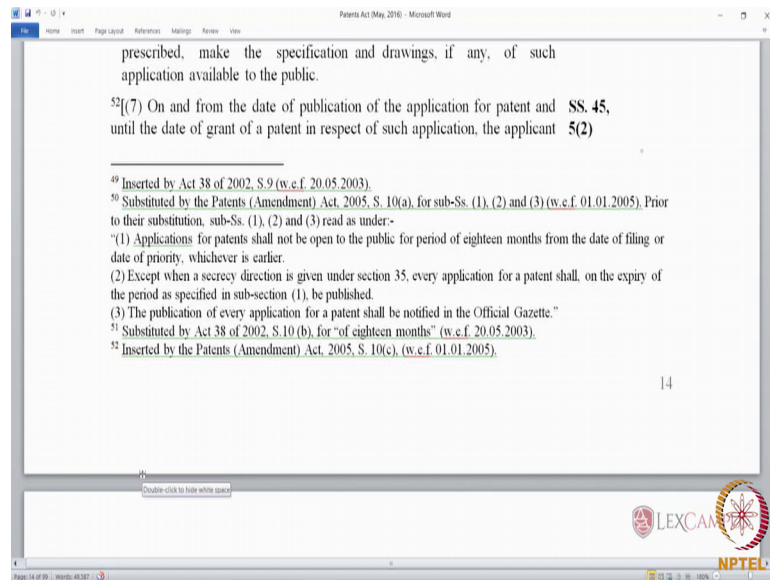
Now, this indicates that the details of the grant are at the grant is published and the details of the grant the final form in which the complete specification was granted if there is a provisional specification and all these things will be open to public for inspection and there is a procedure before the patent office where you can seek further information on patents by paying the required fees

So, as we mentioned the patent application goes through 2 publications the first publication is the publication of the application as filed which happens under 11 A 5 and this second publication is the publication of the grant which happens under section 43 2 11 A states that upon publication of an application for a patent under this section A; the depository institution shall make the biological material mentioned in this specification available to the public that we saw that under section ten 4 where in certain cases you have to deposit the biological material before a depository. So, once the application is published it the material will be made available to the public till such time the material is also kept in the dormant state b the patent office may on payment of such fee as may be prescribed makes this specification and drawings if any of such application available to the public.

Now, the corresponding provision you saw in section 43 2 where we saw the application specification and other documents related thereto shall be open for public inspection. So, you understand that under the patents act when a thing gets published it becomes open or it becomes available to the public. So, this is an important concept even when we understand prior publication for the case of determining novelty when a something made available to the public a prior art is relevant when it is made available to the public.

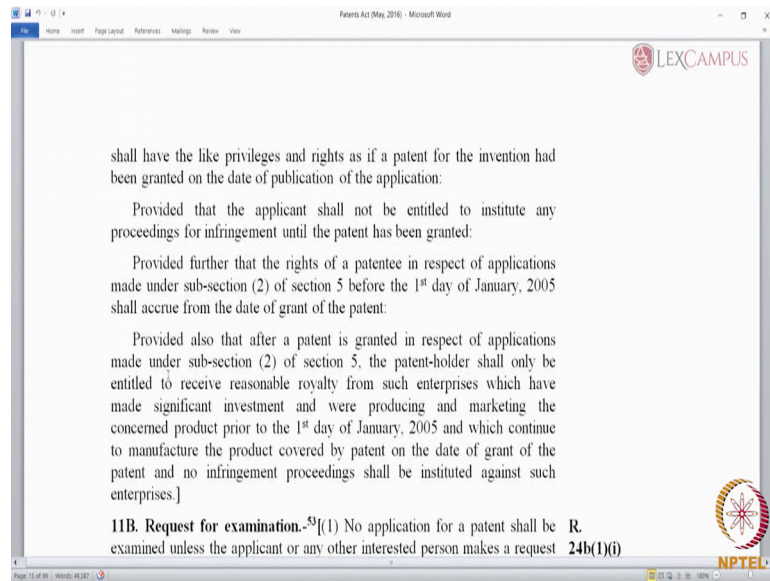
So, publication is one of the ways by which something is made available to the public and you can actually see the language in 11 A 6 b its states that upon publication things will be made available to the public. So, 11 A 6 b can be compared with section 43 2 where again the matter where it is mentioned that it shall be open for public inspection.

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11 A 7 states that on and from the date of publication of the application for patent and until the grant of a patent in respect of such application the applicant shall have like privileges and rights as if a patent for the invention has been granted on the date of publication of the application and there are 3 provisos.

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Now, just look at this, this provision states that from the date of publication of the application we had already mentioned that the first publication here we are still about the first publication where the application as filed as published there are certain things that happen upon the first publication now this states that on and from the date of the first publication and until the date of grant in respect of such application the applicant shall have like privileges and rights as if the patent for an invention has been granted on the date of publication of the application now this one provision tells you that there are 2 publications one the first publication is the date of publication of the application and the second publication is the patent for the invention has been granted on the date of publication of the application.

So, this provision itself tells us that there are 2 timelines the first timeline being the time for time for publication of the application that is the first timeline and the second timeline is time for publication of the grant. So, we can look at these timelines as TPA that is time for publication of application and the other timeline as the time for publication of grant which happens immediately at the time of the grant or soon after the grant. Now let us look at what are these rights this provision clearly states that the application shall have like privileges and rights as if the patent has been granted. So, on TPA that is time for publication of the application what we call the first publication the patent applicant will have certain rights and privileges as if the patent has been granted.

Now, we know that that phrase as if the patent has been granted means TPG the time of publication of the grant when the grant is published which is the second publication now this provision says in the upon the first publication you will have certain rights and privileges as if the patent itself has been granted. Now it is this is a deeming fiction that there are certain things that have been created by the law to grant similar rights and privileges even before the patent is actually granted when we look into the details we will understand that upon the grant of a patent there are a set of rights that can be enforced by the patentee when a patent is granted a patent can enforce the right in the patent now the enforcement action it comes by way of an infringement suit an infringement suit is a case filed by the patentee against infringer that the rights in the patents mentioned in section forty eight have been violated on that ground an infringement suit is filed section 104 allows the patentee to file an infringement suit.

The reliefs in an infringement suit are mentioned in 108; section 108 and 108 tells us that in case of an infringement, an infringement suits can only be filed after the grant of a patent in case of an infringement a patentee could have the reliefs which could include in junction which is a release way by you stop the person from doing the infringing activity. So, the relief that you could claim is in junction and 108 1 tells us that an at the option of the (Refer Time: 24:59) if either damages or accounts of profit. So, going by the reliefs in a 108 one you could either have a relief of injunction stopping the person from doing that activity or compensation which is damages or accounts of profit 108 2 talks about certain other reliefs like what happens to the infringing goods that are seized whether they can be forfeited or destroyed and directions pertaining to that so, 108 2 talks about certain other reliefs.

Now, let us look at them regard 108 1 as pertaining to the main relief. So, at the point where the patent has granted the patentee is entitled to either stop the person from doing things or to claim compensation for the wrong done now 11 A 7 tells us that upon the first publication which is TPA the applicant will have certain rights and privileges similar to that of a person who has a granted patent and in 108 1 we saw that those privileges and rights are largely right to stop a person from doing something or right to claim compensation.

Now, the right to stop a person from doing something cannot accrue before the grant because the act clearly says that you can only stop a person from doing something upon

the grant of a patent because that is the requirement for filing an infringement suit you need a granted patent. So, there is no way that relief of injunction can be claimed before the grant of a patent. So, there is no way that relief can be claimed at the first publication or from the point of the first publication, but damages which pertains to compensation which is a relief in money can be claimed from this point. So, this is entire objective of the language in 11 A 7 is to tell us that from the point of first publication a patentee after he gets his patent granted will be able to claim damages for events that happened after the first publication because the first publication serves notice of a pending patent.

So, the words used here like privileges and rights as if the patent for an invention has been granted can be understood as the right to claim damages from this point from TPA that is the first publication because the first publication serves notice to the world and if the person does not seize stopping the infringing activity and if the patentee has informed the infringer that there is a patent pending the patentee may be able to claim damages from this point proviso one states provided that the applicant shall not be entitled to institute any proceeding for infringement until the grant until the patent has been granted now it made very clear that you cannot institute infringement suits which is under section 104 and you cannot claim a relief in section 108 until the patent has been granted.

So, of these 2 publications the first publication and the second publication it is only on second publication that is the time where of publication of the grant TPG only at TPG can you file an infringement suit. So, the proviso makes it very clear though some rights and privileges are granted at the first publication TPA it does not mean you can file an infringement suit after the publication of the application the first publication does not allow you to file an infringement suit for the simple reason that the patent office has not yet analyzed your patent.

So, this scrutiny by the patent office does not happen at the point of the first publication. In fact, the patent office is starts looking in to the patent application only after the first publication materializes whereas, the second publication is noticed to the world that the patent office has scrutinized it and the patent office deems it to be ready for a grant section 43 uses the word that after the scrutiny of the patent application the patent office finds it to be in order for grant this is the word used this is the phrase used to be in order for grant. So, when the patent office finds the patent application to be in order for a grant it gets granted and eventually published.

So, the second publication tells us that the patent office has applied its mind it has raised objections in most cases and the patent office and the patent applicant has addressed those objections and hence the patent was granted and the grant was published. So, this publication that is the second publication TPG allows the patentee to initiate an infringement suit because now he has a right that is been verified or scrutinized by the patent office whereas, in TPA the first publication it is a mere publication of the application has filed no scrutiny by the patent office has taken place at that point. So, that is the reason the proviso says that an applicant shall not institute any proceedings until the grant of a patent which means an applicant cannot file an infringement suit only a patentee can file an infringement suit.

So, a person who files an application is called the applicant up until the patent is granted upon the grant is called a patentee or a patent holder. So, only a patentee or a patent holder can file an infringement suit an applicant because the right is still not verified in scrutinized by the patent office cannot file a infringement suit the second proviso provided further that the rights of a patentee in respect of an application made under subsection 2 of section 5 before first day of January 2005 shall accrue from the date of the grant of the patent section 5 is no longer there in the act it is now been omitted section 5 when it existed before 2005 it is removed by the 2005 amendment was a transition provision which allowed for applications to be filed in a mail box pertaining to food and drugs pertaining to product patents on food drugs and medicines

Now, this was the scope of 5 2; 5 2 was an arrangement section 5 2 was an arrangement by which you could file mail box applications before 2005 that is the time between 1995 and 2005, but India was able to only bring that provision by the 1999 amendment. So, by the 1999 amendment we had a mechanism of taking applications for pharmaceutical products which was not the case under the 1970 act and this was introduced by the trips as an obligation that came under the trips agreement.

So, we had a mail box provision which allowed the Indian patent office to receive applications for product patents pertaining to pharmaceuticals or commonly it was earlier called food medicine and drug now this provision now this provision allowed pharmaceutical companies to file patent application seeking product patents for pharmaceuticals between 1999 when the provision came in to force and 2005 with the

hope that it will be examined post 2005, now 2005 was the timeline for India to bring in product protection measures for pharmaceuticals under the patents act.

The 1970 act the patents act ninety seven originally did not offer product protection for pharmaceuticals, but upon becoming a member of the WTO, India was obliged to bring product protection for pharmaceuticals. So, the earlier law only allowed for process patents for pharmaceuticals now after we became a member of the w t o we had to bring in this change into the act and as we mentioned earlier India took the benefit of a ten year transition period between 1995 to 2005 to bring these changes. So, using the transition period India brought about a series of amendments the first amendment in 1999 the second in 2 thousand 2 and the final one in 2005 and it was with the 2005 amendment we broke the full mechanism for granting product patents for pharmaceuticals.

But though the applications could only be examined post 2005 we had made an arrangement to receive these applications now the objective behind that arrangement was India will start securitizing applications for pharmaceutical products after 2005. But there will be an interim arrangement to receive these applications because companies would have been inventing and filing applications around the world for pharmaceutical products and India. Since it would start open its gates for granting pharmaceutical products it was felt by the member countries that the countries in transition should also have a mechanism for receiving these applications these applications can definitely be prosecuted after 2005 which is the timeline for the transition period, but there had to be a mechanism to receive these applications and as we saw applications are tied to the priority by which they are disclosed for the first time.

So, there was an issue on priority and to preserve the priority we allowed applications to be filed within the patent office, but on the condition that they will be scrutinized they will be taken up for examination and granted after 2005. So, this arrangement was called the mail box system or the black box system; there are different phrases for it. So, the mail box or the black box was a transitory provision which allow the Indian patent office to receive applications for pharmaceutical products on the condition that it would be scrutinized and granted after 2005. So, this was an interim arrangement. So, 5 2 provided the regime section 5 2 provided the arrangement for receiving those applications and keeping them in the mail box for examination after 2005.

Now, with the amendment in 2005 the provisions of 5 2 were no longer relevant and they were repealed, but this is a passing reference which says that the rights of a patentee in respect of an application made under 5 2 before the first of January 2005 shall accrue from the date of grant of the patent which means there is an exception in the case of a mail box application the rights accrue only after the grant whereas, in a normal application some rights and privileges could accrue upon the date of publication of the applications. So, this is making where we had an arrangement for accepting applications through the mail box it is made very clear that the right shall accrue only from the date of grant of the patent.

There is a third proviso to 11 A 7 states that provided also that after a patent is granted in respect of applications made under 5 2 the patent or holder shall only be entitled to receive reasonable royalty from such enterprises which have made significant investment and where producing and marketing the concerned product prior to one one 2005 and which continue to manufacture the product covered by the patent on the date of grant of the patent and no infringement proceedings shall be instituted against such enterprises

Now, this is again a transitory provision it is no longer relevant because you could reasonably expect all the 5 2 applications to be disposed of by now, now post 2005 it's been 12 years post 2005. So, you could reasonably expect all the applications which were filed using the mail box procedure to have been either prosecuted and granted or prosecuted and rejected. So, this is this proviso is no longer replicable and they were probably just a handful of cases where this proviso was attracted and one such case was the Novartis K versus Cipla or Novartis versus Ranbaxy they were a they were a set of cases which Novartis had filed against a couple of Indian generic companies in exercise of a right that Novartis had after it filed its application in India this right is called the exclusive marketing right or EMR.

Now the EMR is again a provision which is now been deleted from the patents act earlier there was a chapter called chapter 4 a which contained provisions from section 24 capital A to 24 capital F which detail how an EMR operates now the EMR was a parallel right which was created along with the mail box arrangement. So, this was the right which was created where if a patent is granted in a foreign country which India recognizes and a drug regulatory approval is also granted for that particular drug then the applicant in India in this case it was Novartis will have certain exclusive marketing rights EMR by

which it could enforce those rights now Novartis in this case file cases against certain generics which included Cipla Ranbaxy and sun pharmaceuticals stating that the grant of an EMR which was again done by the patent office entitles it to stop certain generic companies from infringing its right.

Now, if you look at it there was no right granted by the patent office because the patent application was still under scrutiny, but by virtue of the EMR provision exclusive marketing rights were granted based on a pending application now there are some details to this case which there are some materials which you can also find on how the EMR provisions operated, but this provisions merely tells that the patent holder who files an application under 5 2 shall be entitled to receive shall only be entitled to receive reasonable royalty from such enterprises which means a the relief a patentee can claim for infringement a relief a patentee can claim with regard to an application filed under section 5 2 is only reasonable royalty.

Now, we saw in a patent infringement suit the release could be broadly of 2 types a 108 one tells us that you could stop the person from doing the infringing activity that is what we call injunction or you could have compensation a relief in money a relief in money could be damages or account of profits now here this proviso says that if it is a 5 2 application and understand a 5 2 application as in application for a pharmaceutical product which is received in a mail box and which is not scrutinized upon the condition that it will be scrutinized and examined by the patent of his only after 2005. So, till 2005 nobody is going to know what is there in the mail box and that is the reason some people call their mail box as the black box. So, you do not know what is there in the mail box a normal application gets published after 18 months, but a mail box application gets scrutinized only after it is taken up for publication post 2005.

Now, this arrangement could lead to certain tricky situations where generic companies in India where already manufacturing that drug. So, you can have instances like the Novartis case when Novartis filed the application in 1998 soon after Novartis filed its application some Indian generic companies started manufacturing the drug covering imatinibmesylate which is known by Novartis and refers to it by its trade Mark Gleevec this drug though an application was spending since 1998 this drug was manufactured by Indian generic companies because there was no patent protection during that time period till 2005 there was no patent protection after 2005 when the application was taken up for

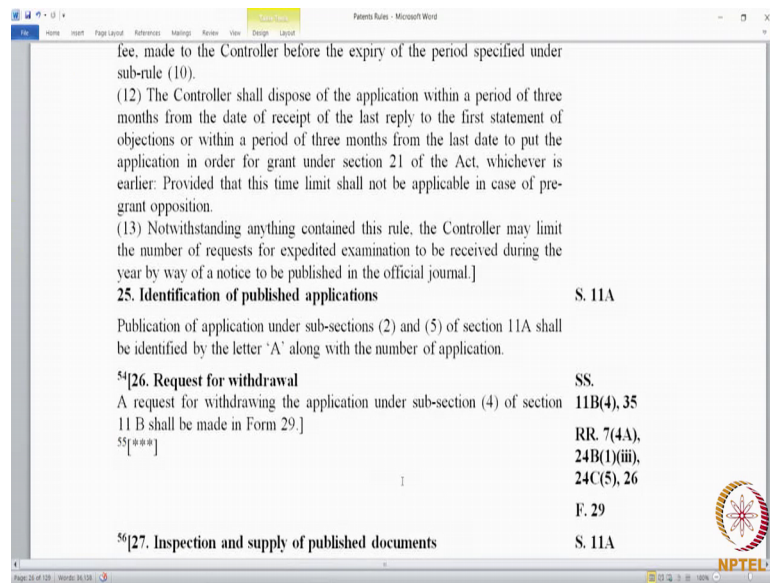
scrutiny Novartis received an EMR an exclusive marketing right while the application was pending. Novartis received an EMR an exclusive marketing right based on the exclusive marketing right.

Novartis was able to file infringement suits against these generic companies who were already manufacturing that product now EMR the provisions of exclusive marketing right which are now been repealed also provided for filing infringement suits based on the grant. Now this provision says that in such cases where manufacturers are already manufacturing the drug and the patent gets granted at a later point in time which is quite possible in a 5 2 scenario then the relief that the patentee can claim is only reasonable royalty the patentee cannot claim in junction in other words. So, you cannot stop a person and we saw an 108 1; the 2 broad reliefs that a person can claim are a relief to stop the infringing activity or a relief in money compensation.

Now, this proviso makes it very clear in a 5 2 scenario where the application is scrutinized after 2005 if there are manufacturers. In fact, the language used is enterprises in the proviso if there are enterprises which have made significant investment and where producing and marketing the concern product prior to 1 1 2005. So, if they were Indian generic companies who were manufacturing that particular drug prior to 2005 first of January 2005 and which continue to manufacture the product covered by the patent on the grant date of grant of the patent they were not only manufacturing it prior to 1 1 2005, but they continue to do. So, till the patent was granted this provision protects those enterprises in the Indian context Indian generic companies from an infringement proceeding because it clearly states no infringement proceeding shall be instituted against such enterprises yet Novartis instituted an infringement proceeding because Novartis had and other right by name the exclusive marketing rights.

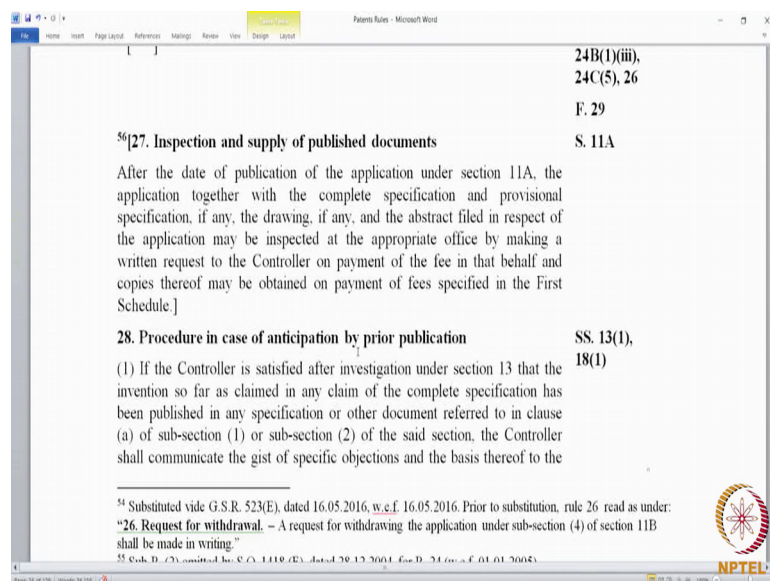
Because Novartis got an EMR granted that EMR allowed Novartis to file an infringement suit because the provision of the EMR allowed for filing of infringement suits. So, this provision was came for judicial scrutiny only in few cases and one of the cases was the case pertaining to Novartis.

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And the grant of EMR exclusive marketing rights to Novartis rule 25 deals with identification of published applications when an application is published under subsection 2 and 5 of 11 A it shall be identified by the letter a along with the number of application. Now the applications will have a number the published application will have the alphabet a after it request for withdrawal shall be made in form 29 and the instances where a request for withdrawal shall be made can be at any time after the filing of the application before the grant.

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Now, what are the consequences of publication what happens if an application is published that was mentioned in rule 27 after the date of publication of an application under section 11 A the application together with the complete specification and provisional specification if any the drawing if any and the abstract filed in respect of the application may be inspected at the path appropriate office by making a written request to the controller on payment of a fee in that behalf and copies thereof may be obtained on payment of fees specified in the first schedule.

Now, the consequence of publication is that you will now be allowed to inspect these documents and also obtain copies of the same on the payment of a fee now this provision clearly states that even the provisional will now be available for inspection and a copy can be given to a person who makes a request provisionals are not published, but if a provisional is followed by a complete and the complete is published then the provisional can be examined at the patent office and a copy of the provisional can be procured now when a request is made to the controller for information relating to patents the request is made under section 153 of the act read with rule one thirty 4 of the rules. So, rule one thirty 4 one b allows a request for information to be done as to when publication of application has been made under section 11 A there is no specific form to be used when a request for information under section 153 read with rule one to thirty 4 is made, but the fees structure is defined in entry forty 4 of the first schedule that is the reason rule 27 mentions the making of a written request. So, it is a written request with the payment of fee and the payment of fee is mentioned in entry forty 4 of the first schedule of fees rule 27 inspection and supply of published documents

When an application is published it immediately becomes open for the public to get information about that application. So, the period in which the application remains unpublished is what we call a dormant period where the information that is covered by the application is not disclosed to the public. In fact, during the 18 month period the dormant period an applicant is allowed to withdraw the application from the patent office 3 months before that period expires. So, we saw that under section 11 an applicant can withdraw the application and we also mentioned that there is a common form for withdrawal the withdrawal that is mentioned in 11 b 4 can be done by filing form 29, but the language in section 11 b 4 is open enough for any kind of withdrawal because we

saw that in that language in the proviso its stated that the applicant may at any time after filing the application, but before the grant withdraw the application.

So, any time after filing includes the 18 month period where it lies dormant. So, and if we compare that with 11 A 3; 11 capital A 3 sub clause c where have an application has been withdrawn 3 months prior to the period specified under sub section one which is the 18 month period. So, 3 months prior to the ending of the 18 month period an application can be withdrawn and 11 b 4 proviso tells us that if you are going to withdraw any time after the application is filed and before the grant you would use form 29. So, form 29 is the form that you would use for any withdrawal and that we get from the language of 11 b 4 that any withdrawal you can withdraw the application at any time after filing, but before grant and for that there is a common form that is form 29.

Now, the effect of a publication is that upon publication the public is given notice of the application and all the information covered in the application which means the public can now people who have an interesting in knowing more information about the patent can now get the information from the patent office. Now rule 27 exactly gives the details after the date of publication of the application under section 11 A the application together with the complete specification and provisional if any the drawing if any and the abstract file in respect of the application may be inspected at the appropriate office by making a written request to the controller on payment of fees in that behalf and copies there are of may be obtained on payment of fees specified in the first schedule. So, once the application is published you can approach the appropriate office which is the patent office where it is filed making a return request to the controller and paying fees the fees are mentioned in the schedule per copy there is a particular fee.

Now, this provision clearly says now this rule; rule 27 is an statement that supports the proposition that provisional specifications are also published there is no part in the act which says that the provisional specification will be published there is nothing which expressly says that on this day the provisional will be published provisional if it is not followed up by a complete will be abandoned and not published that much we know we have seen that a provisional specification in rule in section 9 if it is not followed up by a complete specification within the 12 month period it will be a deemed to be abandoned in 9 1 the language that is used is a provisional that is not followed up.

By complete within 12 months will be deemed to be abandoned and there is also reference to say that this application will not be published and we get that from 11 A 3 11 A 3 says every application for a patent shall on expiry of the period be published except the following which means what is covered under 9 1 will not be published. So, we have evidence in 11 A 3 that applications under 9 one which are not followed up by a complete specification will not be published because 11 A 3 says that the following will be published except for one 2 3 a b and c and 9 1 comes as b.

So, we know that provisional specification which is not followed by a complete will not be published, but there is no express statement that the provisional itself will be published there is no express statement. In fact, the publication is only of in 11 A 5 only of certain bibliographical details 11 A 5 tells us the publication of every application under this section shall include particulars relating to date of application number name address and abstract it does not say that the provisional will be published.

But rule 27 very clearly says that after the complete is published then you could approach the patent office after the date of publication which is where the abstract details are published abstract and other details are published you can approach the patent office and get copies of provisional. So, provisional is expressly mentioned in rule 27 and rule 27 is evidence to show that provisionals will be published rule 27 tells us that after the date of publication you could get copies of the provisional. So, provisionals will be circulated after the date of publication if anyone approaches the patent office and pays the required fees.