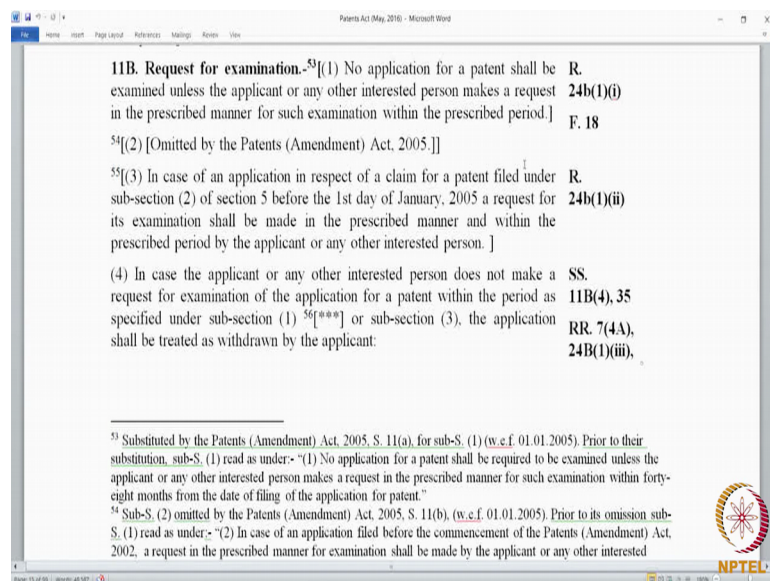


Patent Law for Engineers and Scientists
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Lecture – 28
Patent Prosecution: Publication and Examination - I
Request for Examination

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Section 11B: request for examination, 11B 1 states that no application for a patent shall be examined unless the applicant or any other interested person makes a request in the prescribed manner for such examination within the prescribed period. Now the request for examination tells us that the patent office will not examine an application that is filed unless someone makes a request for the examination.

So, we saw the series of events that happens before the patent office, an application is prepared by an applicant the application is filed before the patent office and the patent of the patent application remains dormant for a particular period of time. The patent applicant could make a request for publication and we had mentioned this request for publication is done under rule 24 a using form 9 if the patent applicant needs a quicker publication then he could make a request for publication using form 9. So, when he does that then the publication is expedited.

So, the publication part is done if the applicant takes request under form 9. If the applicant does not make a request under form 9 then the default case is that upon the expiry of the 18 month period it is published there is yet another exception where secrecy directions are pending in which case if the secrecy directions operate beyond the 18 month period, then the application is published only after the secrecy directions seems to exist. So, we understand this publication timeline as the default case being an 18 month period, but you could use form 9 to expedite the publication. So, you could if you file a form 9 along with form one and two when you file the application it gets published immediately.

If you do not file form 9 then the default case that is the application gets published after the 18 month period; and in case there is a secrecy direction pending then the application gets published only after those directions sees to operate. Publication is mandatory for examination to happen. If an application is not published then the patent office will not examine we have multiple evidences towards this one part of the act which points us towards that is section 9 1 where a provisional specification which is not followed by a complete specification within the time period of 12 months is treated as abandoned.

And what is abandoned is not published; and there is another provision in the act where you could withdraw a provisional and if you withdraw that is under 9 3 if you withdraw the provisional specification again it is not published. So, something which is abandoned is not published, something which is withdrawn is not published. Again in 11 a 3 we saw that if you withdraw the application 3 months before the expiry of the 18 month period again that is not published.

So, we understand that the patent office will examine an application only if publication happens. So, the publication can vary publication is bound to happen if you do not do anything at the expiry of the mandatory period of 18 months, and if you do something like expedite the publication it could happen earlier publication can also get delayed if there are secrecy directions pending. So, once the application is published either the applicant or a person interested and the person interested is defined under the act if you look at section 2 1 t a person interested includes a person engaged in or in promoting research in the same field as that to which the invention relates. A person who is in the same field act to which the invention relate relates to. So, a competitor of a company can be regarded as a person interested.

So, 11B 1 tells us that an application for a patent shall not be examined unless the applicant or a person interested makes a request for examination. Now the request for examination is detailed in rule 24 B 1 sub clauses Romans 1, a request for examination under section 11B shall be made in form 18. So, the form that is used for the request for examination is form 18 and the request for publication is form 9. Within 48 months from the date of priority of the application or from the date of filing of the application whichever is earlier.

So, what is this say you could make a request for examination using form 18 within 48 months from the date of priority and we saw what priority is or from the date of filing of application whichever is earlier. So, we choose the earlier date. So, the 48 months starts from the earlier date if the priority is earlier, and we saw that priority could be different from the date of filing of application if there is a priority document like a provisional specification and we saw the cases in section 11 where if the disclosure is made in a document which is different from the document in which the claims are then the priority rules will apply, and priority can be acclaimed from the earlier disclosure for that particular claim.

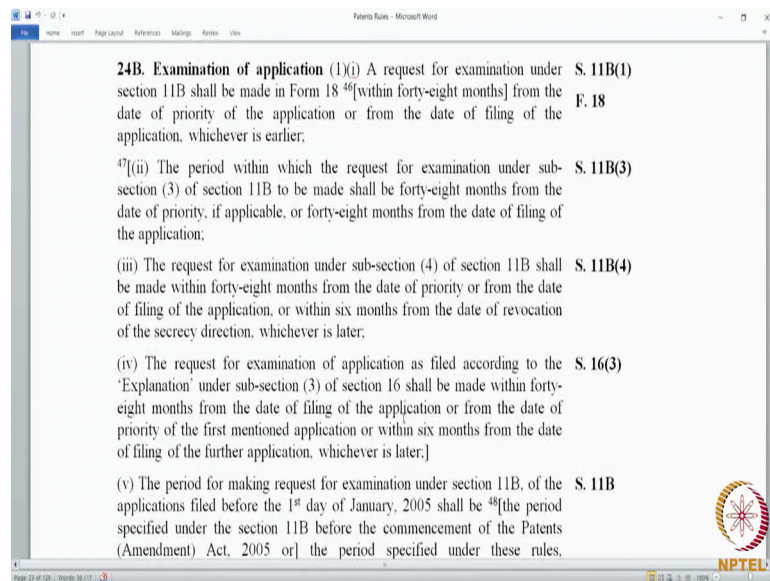
So, 24 B 1 1 tells us that the request for examination has to be main if the patent office needs to examine the application with in a 48 month period, and it has to be done using form 18 and this 48 month period starts either from the date of priority or from the date of filing of the application whichever is earlier. And in section 11 on the lecture on priority we had seen that the date of priority can be different from the date of filing the application. So, we choose the earliest date from that date 40 either the priority date or date of application, the request for examination has to be filed within a period of 48 months. 24 B 1 2 and the following provisions tells us the various other details that in which we will determine this time period.

Now, the 48 month time period can vary we saw in 24 B 1 1 it can start in case there is a priority document then it can start from the date of priority or in normal cases where the invention is first disclosed in a complete specification it starts from the date of filing. So, if you file if there is a no priority document and the first filing is through the complete specification, then we regard the priority date as the date of filing the date of filing becomes the priority date because the there is no earlier disclosure of the invention. In

other cases where there is a priority document there is a provisional specification which has a disclosure that goes earlier in time then we need to apply the priority rules.

So, coming back to 11B 11 b 3 states in case of an application in respect of a claim for a patent filed under subsection 2 of 5. Before the first day of January 2005 a request for it is examination shall be made in the prescribed manner and within the prescribed period by the applicant or any other interested person.

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Now, the relevant rule as you can see is rule 24 B that should be capital B. 24 B 1 Roman two states the period within which the request for examination under subsection 3 of 11B to be made shall be 48 months from the date of priority if applicable or 48 months from the date of filing of application. Now this is the same rule as you saw in 24 B 1 1, but in this case it is specifically tied to section 5 2 applications and we are already mentioned that section 5 2 applications whereas, special sect of applications which were filed during the transitory period between 1995 and 2005 and the time period for making a request in those cases will run from the date of priority or from a 48 month period from the date of filing what this means? Here it does not say whichever is earlier what this means is that you could file the request for examination within a period of 48 months from the date of priority, and in the case of a application that comes from a pharmaceutical company having international operations it is quite likely that that application could have had an earlier priority date based on an international application p c t has certain priority rules

and the priority document that is filed for a p c t application could be much earlier than the filing of the application in India. So, the priority date could be much earlier sometimes even before the application is actually taken up for examination.

So, in this case there is no mention that the 48 month period could either be from the date of priority or from the date of filing there is no mention that it has to be the earlier priority the earlier date. It if there is no statement whichever is earlier in this sub clause whereas, in the earlier one we found that there was a statement whichever is earlier which gives the liberty to the applicant to file the request for examination either within the 48 month period from the date of priority which is likely to be different from the date of filing because in most cases in 5 2, you will have an application that is filed abroad and the Indian application is in follow up application based on an earlier filing. So, in the case of international application where there is an earlier filing the date of priority will definitely be different from the date of filing.

So, in this case the liberty is given to the applicant either to choose the 48 month period from the date of priority or to choose the 48 month period from the date of filing the application and there is no mandate in this provision that it has to be the earlier one unlike 24 B 1 1. 11B 4 states that in case the applicant or any interested person does not make a request for a examination for the application for a patent within the period specified in subsection one or subsection 3 the application shall be treated as withdrawn by the applicant.

Now, here is the prof that the patent office will not do anything unless a request for application sorry the patent office will not do anything unless a request for examination is filed. So, 11B 4 tells us unless a request for examination is done the patent office will not look into the application, rather the application will be treated as withdrawn by the applicant. Now there are two things that we need to explain at this point the patent office procedures are structured in such a way that the burden of doing something is always shifted to the applicant if the applicant does not do certain actions then the patent office will deemed that as the patent office will deem that in action by the applicant as something which amounts to a withdrawal or something which amounts to abandoning the application.

So, in the life of a patent starting with the filing of a patent application there are various timelines which an application has to keep and there are various things then applicant has to do, and when the applicant does not keep the timeline or do that particular action the patent office will presume that the patentee or the patent applicant is not interested in pursuing the application. This is largely done because patents are filed in most cases where the technology covered by the patent is in its initial or the nascent phase. There will be occasions where a patent is filed or a provisional application is filed and later work done on that particular area would deem that it is not a viable invention or it is not cost effective to come out with invention or the business interest of the applicant could change for multiple reasons the patent applicant may not want to pursue a patent application, and because of its nature you have to file it early in time further research or further r n d may or further changes in the business environment may lead the patent applicant to give up the inventions.

So, the patent office is structured in a way in which the patent applicant needs to take certain action, feeling which the default position will be that the patent will be regarded as abandoned or it will be deemed as or treated as withdrawn. So, 11B 4 gives you one instance there are many other instances which we will see as we go by gives you one instance, where the inaction of the patent applicant results in the withdrawal of the application. If you actually see the patent app withdrawal can be seen as a conscious act you do something withdrawal can be seen like you go to the ATM and withdraw the money it is a conscious act you do something, but here it is treated as withdrawn by your inaction because a timeline was given for you to do certain things and you saw the timeline is largely 48 months from either the priority date or the date of filing and if you did not do that thing of making a request, paying the required fee the patent office will regard that you have withdrawn the application that is the first thing.

The second thing that should have struck you is that why is it that the patent office requires a request for examination to be filed by the applicant or an interested person; because if you look at every other thing that needs to be done for a patent application to move forward are things which the applicant needs to do. The applicant needs to file it the applicant needs to prosecute it when objections come from the patent office what we call the first statement of objections or the first examination report as it was earlier called the applicant needs to address it if there is a hearing called for by the patent controller

under section 14, the applicant needs to go there and address a for the hearing or the applicant needs to send his representative all these things are pegged on the applicant.

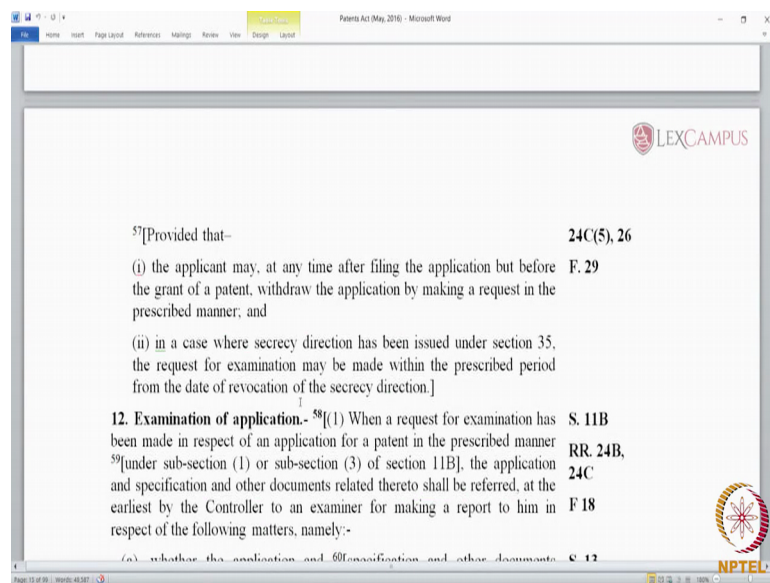
Why request for examination alone is pegged on the applicant or other interested person they could be multiple explanations for this, but one reason that we can find is that the duty one reason that we can find is that request for examination is what sets an application in to it is examination mode till the request is not filed the application is not examined. So, by enabling an interested person to file a request for examination an interested person could also be a competitor, the patent office gives the interested person the ability or the power to start the process of prosecution.

So, if there is a patent pending over a matter which can affect the interest of a competitor the competitor could take a request for examination so that the application is examined and either granted or dismissed. So, the uncertainty on a pending application could be resolved by taking a request for examination or by making the request because it is the request that sets the prosecution in motion if the request is not happen the prosecution does not happen at all. With regard to the second point interested person is understood as a person who could be a competitor we get that from the language of section 25 2 which talks about post grant opposition or opposition after the grant where it is mentioned that at any time after the grant of a patent, but before the expiry of a period of one year from the date of publication of grant of a patent any person interested may give notice of opposing the patent it is goes on continuous.

So, any person interested under the act could mean a person who has a competitive interest. So, a patent can be opposed by a person who has a competitive interest and that person could be entitled to make the request for examination under 11B 1 as we saw. If you look at form 18, if the request for examination is made by an interested person then the interested person is required to give evidence of interest in the application for the patent. Now in this context you could also assume that an interested person could be a further assignee of the patent, a person who had applied it the applicant assigned it later on to another party and that party now becomes the interested person or it could be a person who has an interest in the application we will find that you could transfer an interest in the application as you can transfer an interest in the patent, and because of the interest in the application the person now wants the application to proceed.

So, a person interested could be understood as a person who has a competing interest and also who has an interest in the application itself interest could be by a future assignment or it could be say by the interest that is accrued through a legal process see there was a company which went into bankruptcy and it was later acquired by another company. So, there could be or by merger. So, there could be various mechanisms by which a person could become an interested person. Form 18 requires the interested person to demonstrate is interest by filing evidence. Now 11B 4 states that if there is no request made the application shall be treated as withdrawn.

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Provided that the applicant may at any time after the filing of the application, but before the grant of the patent with draw the application by making a request in the prescribed manner. Now this is a blanket provision and this withdrawal is done under by using form 29. Form 29 talks about withdrawal of application and the language is quite clear any time after filing the application, but before the grant if you need to with draw an application after filing it; obviously, any time before the grant you are going to use this form.

Now, the question may arise how do you with draw an application before the expiry of the 18 month period. Now section 11 a 3 tells us that you could withdraw an application 3 months before the expiry of the 18 month period how do you do that? Form 29 though form 29 is mentioned in the context of 11B 4. The wording in form in 11B 4 1 tells us

that it is broad enough to cover any withdrawal at any time before the grant. So, the language of 11B 4 is broad enough to cover any withdrawal at any time after filing the application, but before the grant and the form 29 is the form that you would use and two in any case where secrecy direction has been issued under section 35, the request for examination may be made within the prescribed period from the date of revocation of the secrecy direction. When we come to section 35 we will see that once the secrecy direction is made it can either be renewed or it can be revoked.

So, if it is renewed after a period of time then it continues to exist or if it is revoked then the request for examination has to be made within the prescribed period. Now this prescribed period is also mentioned in rule 24 B. Rule 24 B 1 3 it is again try to understand this the request for examination as a rule has to be made within 48 months, when the 48 months starts is what you need to understand it starts from the priority date if there is a priority document, it may start from the date of filing the application if that is the first disclosure, it may start from the date of revocation of the secrecy direction that is what is mentioned in 24 B 1 3.

The request for examination under subsection 4 of section 11B shall be made within 48 months from the date of priority or from the date of filing the application or within 6 months from the date of revocation of the secrecy direction whichever is later. So, the default provision is 48 months from the date of priority or from the date of publication date of filing, where a secrecy direction is issued 6 months from the date of revocation of the secrecy direction. So, that is the third element whichever is later.

Now, if the secrecy direction continues beyond the 48 month period then it has to be 6 months from the revocation of the secrecy direction. So, after the secrecy direction is revoked within 6 months you need to make the request for examination. So, 24 B 1 3 continues the same rule as mentioned in 24 B 1 1 which is a request for examination of an application shall be made within 48 month period, and that period can start either from the priority date or from the date of filing. If there is a secrecy direction and if it goes beyond this period then when the secrecy direction is revoked whenever it is revoked within 6 months you can take the request for examination.

Now, though 11B does not talk about divisional application, rule 24 B has also provided for the other cases where the timeline for making a request for examination can change

that is mentioned in rule 24 B 1 Roman 4. A request for examination of application as filed according to the explanation under sub section 3 of 16 shall be made within 48 months from the date of filing the application or from the date of priority of the first mentioned application or within 6 months from the date of filing the further application whichever is later when divisional are filed based on a main application or apparent application. In a normal case the request for examination shall be made within 48 months from the priority date or from the date of filing the application or within 6 months from the date of filing the further application which is the divisional.

So, if a divisional is filed then you have time to make the request for examination divisional is normally filed after the main application you have time to make the request for examination within 6 months of filing the divisional that is what it says and 24 B 1 5 states that the period for making the request for examination under section 11B of the applications filed before first of January 2005 shall be the periods specified under 11B. Before the commencement of the patents amendment act 2005 or the periods specified under these rules whichever expires later.

Now, patents amendment act provided for when the request for examination has to be made for applications filed under section 5 2, and if they do not apply then the rules prescribed here in will apply whichever expires later again this is a transitional provision for section 5 2 application.

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whichever expires later.

(2) ⁴⁹(i) Where the request for examination has been filed under sub-rule (1) SS. 11A, and application has been published under section 11A, the Controller shall refer the application, specification and other documents related thereto to the examiner and such reference shall be made in the order in which the request whichever expires later.

⁴⁶ Substituted by S.O. 657(E), dated 05.05.2006, for "after the publication of the application but within thirty-six months" (w.e.f. 05.05.2006).

⁴⁷ Substituted by S.O. 657(E), dated 05.05.2006, for Cls. (ii), (iii) and (iv) (w.e.f. 05.05.2006). Prior to their substitution, Cls. (ii), (iii) and (iv) read as under:- "(ii) The period within which the request for examination under sub-section (3) of section 11-B to be made shall be thirty-six months from the date of priority or from the date of filing of the application or twelve months from the 1st day of January, 2005.

(iii) The request for examination under sub-section (4) of section 11-B shall be made after the publication of the application, but within thirty-six months from the date of priority or from the date of filing of the application or within six months from the date of revocation of the secrecy direction, whichever is later.

(iv) The request for examination of application as filed according to the *Explanation* under sub-section (3) of section 16 shall be made after the publication of the first mentioned application, but within thirty-six months from the date of filing of the application or from the date of priority of the first mentioned application or within six months from the date of filing of the further application, whichever is later."

⁴⁸ Substituted by S.O. 657(E), dated 05.05.2006, for "the period specified under the section 11-B or" (w.e.f. 05.05.2006).

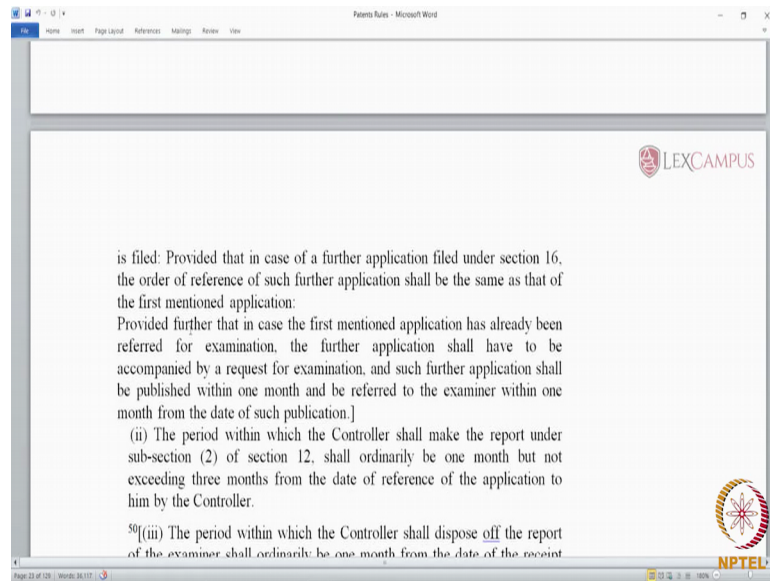
⁴⁹ Substituted vide G.S.R. 523(E), dated 16.05.2016, w.e.f. 16.05.2016. Prior to substitution, clause (i) read as under: "(i) The period within which the Controller shall refer the application and specification and other documents to the examiner in respect of the applications where the request for examination has been received shall ordinarily be one month from the date its publication or one month from the date of the request for examination whichever is later.

Decided that such reference shall be made in order in which the request is filed under sub-rule (1) "

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Now, let us look at 24 B 2; now 24 B 2 tells us then where a request for examination has been filed under sub rule 1 and an application has been published under section 11 A, the controller shall refer to the refer the applications specification and other documents related there to the examiner and such reference shall be made in the order in which the request is filed.

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Provided that in case of a further application filed under sub section 16 that is a divisional the order for reference for such further application shall be the same as that of the first mentioned application, which means the order for reference shall be the same as the parent application where a divisional is filed. Provided further that in case of a first mentioned application as already been referred for examination the further application shall have to be accompanied by a request for examination and such further application shall be published within one month and referred to the examiner within one month from the date of publication. This again pertains to what happens if parent application is has already been refereed for examination it is in the process of examination request has been made and it is been referred by the controller and a divisional is filed.

Now, if the divisional is filed and if the divisional is treated as a separate application then the 48 month period and further the request for examination coming within that period it is most likely that the divisional will be examined separately. So, this provision ensures that if the parent application has got into examination, then if you file a divisional and

the applicant is going to know whether it has already got into examination then the applicant has to take a request for examination along with the divisional. So, the request for examination has to accompany the application.

Now, this could be the only case under the patents act, where a request for examination has to accompany the application itself. Now if a question is asked what is the instance in which a form 18 has to be filed mandatorily along with form one then this is the case, because it clearly says the further application shall have to be accompanied by a request for examination and request for examination is filed under form 18 and the application itself is filed under form 1.

So, this is the only scenario where a form 18 and a form 1 has to be mandatorily it is optional you could file it in an due course you in an normal case you could file it is optional for you to file the form 18 along with form 1, but in this case it has to be mandatorily filed along the form 18 has to be filed with form 1 and the reason being the parent application because this being a divisional the parent application has already been referred for a examination.

Once this happens the further application which is the divisional shall be published within one month and referred to the examiner meaning the examiner was already examining the parent application within one month from the date of such publication. So, this is a what you what we call it is a fast track process which is used only for divisional; because the parent is already in their examination mode the divisional will have to be accompanied by a request and application has to be published within one month and referred with within one month. So, within two months their divisional will now end up before the examiner, for examination along with the parent application. So, that is you objective. So, this is the only case where form 18 has to be filed along with form one mandatorily, in every other case you could file a form 18 with form one that is optional. So, this is the only case where the law mandates you to file a form 18 and form 1 together.

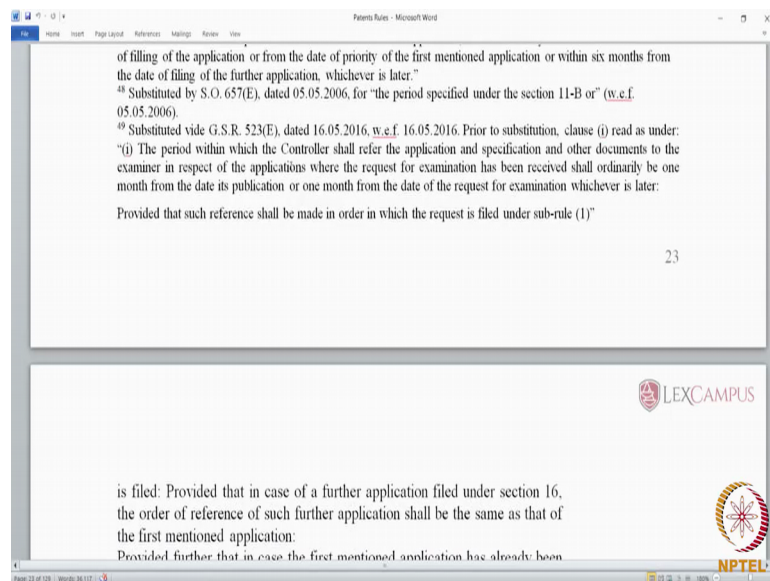
Now, coming back to 24 B 2- 24 B 2 tells us what happens after a request for examination is filed. Now a rule 24 B 1 gave the various timelines for filing the request now the request is filed what happens now this is how the prosecution moves forward. Once the request is filed the controller shall refer the applications specification and the

other documents what is called the file, the file will have all it is its one file shall refer the application specification and the other documents related thereto to the examiner.

Now, this is something which the controller passes there is a direction that upon the request for examination the controller shall refer the application to an examiner. The controller is an official who sits in a supervisory position to the examiners the examiners are officials of the patent office who discharge the function of examining the application under section 11 and yes under section 12 and 13 we will come to that. Now the examiners are recruited by the patent office based on certain domain knowledge. So, an examiner who is examining biotechnological applications will have a biotech background a examiner who is examining mechanical applications will have a mechanical or an engineering background. So, examiners in the patent office and we will come to the provision on examiners and how they are supervised by the controller, many examiners report to a controller that could be an assistant controller or it could be an assistant controller or deputy controller.

So, at the patent office is structured in a way in which many examiners report to the controller. Now once the controller refers the matter to the examiner such reference shall be made in order in which the request is filed.

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So, the controller is going to refer the matters for examination to the examiner in the manner in which the request is filed. So, the request for examination will determine how

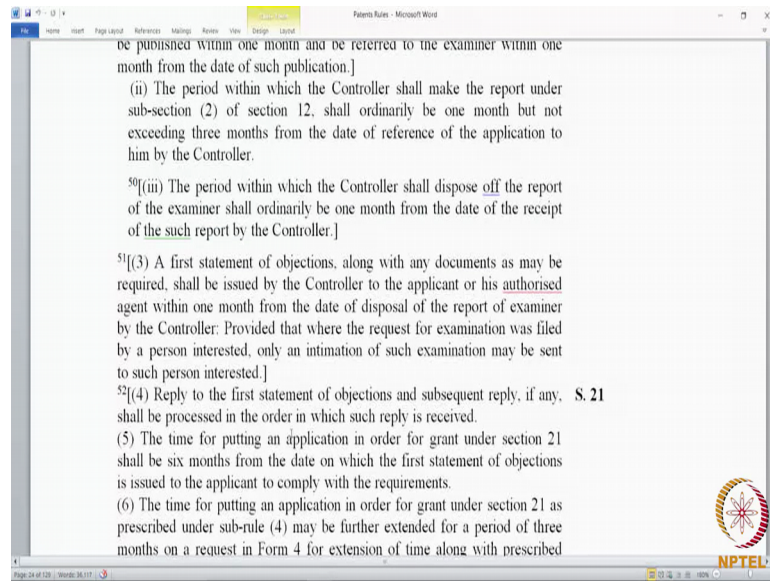
the matter moves for prosecution not the order in which you file the patent application this is an important point because patent applications can be filed to preserve priority, but examination request for examination will determine how quickly your patent application moves within the patent office.

So, if someone files a patent application say in the year 2017 and does not take a request for examination up until the expiry of the last month within that 48 month period and then makes the request, then the application starts its examination process only at that point the 48 month just before the 48 month. So, this is 48 month period nothing happens for the application whereas, another applicant who files soon after this applicant in 2017, but he wants to expedite the examination he could file a request for form under form 18 along with the application, and when that happens his application would be taken up for examination much before the applicant who filed before him. This is because priority preservation is one thing preserving the priority by going to the patent office is one thing and making a request for examination and standing in the queue of the examination is another thing. So, the patent controller will refer the matters based on the order in which the request for examination was filed, and not in the order in which the patent applications were filed.

Now, the only exception to this rule that the patent controller shall refer the matters for examination in the order in which the request for examination is filed is a matter pertaining to divisional application. It is mentioned provided that in case of a further application filed under section 16 which means a divisional application filed based on a parent, the order of reference of such application shall be the same as that of the first mentioned application the divisional which is also called a child is always tied to the parent. So, the divisional because it is tied to the parent will get into the priority the divisional because it is tied to the parent will be examined along with the parent. So, it just says that the normal rule is that the order in which applications will be examined will be based on the filing of request for divisional alone because they are tied to the parent it will be the date on which the request for examining the patent was filed.

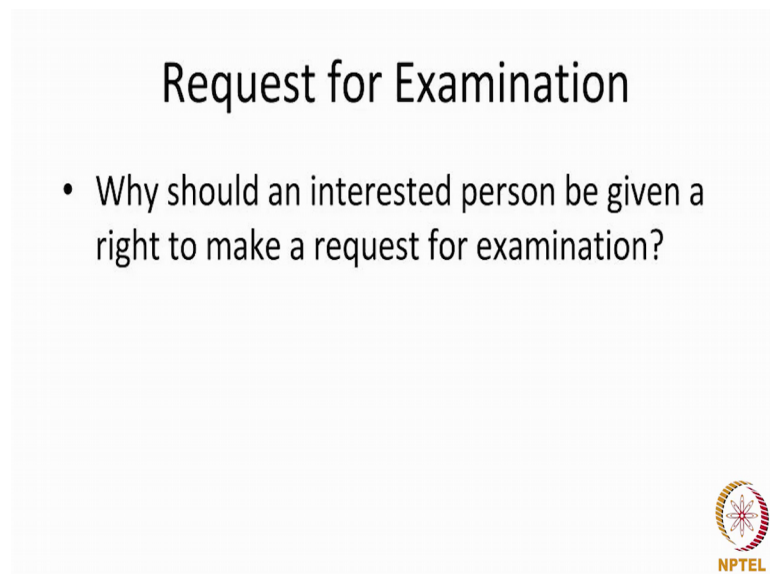
So, as long as it is possible to club divisional application with its parent it will be examined with the parent. So, that is the only exception. So, the only exception where the order of examination is different from the request file is where a divisional application is involved under section 16.

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24 B Roman 2 states that the period within which the controller shall make the report under sub section 2 of 12 shall ordinarily be one month, but not exceeding 3 month from the date of reference of the application to the application to him by the controller. Now we saw that the controller refers the application to the examiner that is the process once a request for examination is made the controller refers the application to the examiner at that point the examiner begins to examine the application that is mentioned in section 12.

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Now, let us take section 12 requests for examination, we had seen in section 11B that a request for examination can be filed by the applicant or by an interested person the act refers to the person as any other interested person because the applicant is obviously, a person who is interested in the application. So, 11B tells us that there are two people who can initiate the request for an examination. Now the applicants side of the case is quite a straight forward case the applicant is the one who files the application. So, the applicant should have the right to initiate the request for examination the question arises why should an interested person also be given this right to make a request for examination; because an interested person is understood under the act as a person who has a competing interest because a section 2 1 defines an interested person the section 2 1 t defines a person interested to include a person engaged in or in promoting research in the same field as that to which the invention relates.

Now, this is the definition of a person interested, whereas the language that is used in 11B is that of an interested person and these are language used is definitely a different one, and you can compare the language with section 25 2 which is on post grant opposition. Section 25 2 states that at any time after the grant of a patent, but before the expiry of a period of one year from the date of publication of the grant of a patent a person interested may give notice. So, there the terminology used is person interested and in 11B if you see a 11B 3 and 11B 4 the language used there is interested person. So, in essence it could mean the same, but the language that comes in section 25 2 talks about a person interested whereas, 11B talks about an interested person. Now a person interested is clearly defined as the person who has a competing interest who is interested in the invention and it is defined as the person who can who is engaged in or is in promoting research in the same fields as to which the invention in relates.

So, somebody who is interested in the same field may be a person who has a competing interest. So, and that is the reason why a person interested can initiate a post grant opposition or an opposition after the grant interested person could be understood as a person who has an interest in the invention it need not be a competing interest you could construe it to be a competing interest, but in this case we can give an explanation that a person interested is different from an interested person, because when we look at the corresponding form which is form 18. In clause 3 of form 18 the interested person has to make a statement. We the interested person requires for the examination of the

application number so and so, dated so and so, filed by the applicant so and so titled. So, and so, under section 12 and 13 of the act as an evidence of my or interest in the application for the patent following documents are submitted.

So, here the interest is in the application it is not in the research area or it is not in the field. So, here we can understand an interested person as being some way connected to the invention itself who has some kind of an interest may be he could be a beneficiary of the technology, may be it could be an investor in to the invested into the technology a person who finances the invention cannot have any rights of an applicant, unless they have taken an assignment from the inventor. So, somebody who has an interest who wants this application to be to move quickly could be understood as a or a the creditor of a company, the company is about to get into bankruptcy and they want to expedite the applications or the company is already in to bankruptcy proceeding it is being taken over the company has been taken over by a liquidator or an administrator.

So, in all these cases the person is interested in the invention in a positive way, not as a competitor. So, when the person is interested in a positive way that person has to demonstrate by evidence submit documents to show why he is an interested person. So, this we understand as an demonstration of interest in proceeding with the application. So, we understand the language in 11B that an interested person we understand that in the light of form 18 where document or evidence of interest has to be demonstrated and we understand that as an interest in the application.

Now, there is another interpretation you could give because when an application is filed and an application does not move forward unless a request for examination is made. if a party wants to proceed with an opposition if a party wants to proceed with a pre grant opposition then that party that files a pre grant opposition will not be able to proceed with the opposition unless a request for examination is filed because unless the application is examined the opposition proceedings will not be considered because in the sequence of events if you see the language of section 43 only when the application is made ready for a grant. 43 says that where the application is found to be in order for grant when the application is found to be in order for a grant then the controller will see whether there are any objections for not granting the application. He can look at whether the application has not been refused by the controller by virtue of any of the power

wasted by him or the application has not been found to be in contravention of any of the provisions of the act.

Now, when there are no objections on the application only then the controller grants the application. In practice we know that once the examination process is over and the application is found ready to be in order for a grant then that the controller will look at whether there are any pending pre grant oppositions. So, pre grant opposition in practice is considered after the prosecution process is over, because whatever the office has to do the office has done it the applicant has got over all the objections raised by the office that is the controller and it is found to be in order for a grant there is nothing that stops the application from being ordered. At that point the software system now we will raise an thing that you cannot grant this because there is an pre grant opposition pending either one or multiple then it is then that the controller starts hearing the pre grant opposition.

Now, this is how the practice is set and if you look at various orders of the controller on pre grant opposition you will understand that the f e r was filed, objections to the f e r were met and only then the pre grant opposition was considered. So, pre grant opposition in practice is not considered while the applicant is prosecuting the patent. In India we do not have a case where the copy of the pre grant opposition is sent along with the f e r that is now the case here the f e r is sent based on a report of the examiner the applicant gives responses to the f e r that happens back and forth, then it reaches a point if there are objections under 14 and 15, it is overcome and the controller is in claimed the grant the patent only then he looks at the whether there is a pre grant because if the controller rejects the patent on his own using his powers of prosecution then there is no need to look into the pre grant at all because any way it is going to get rejected.

So, there are many cases where including the case involving giliers drug sovaldi, where the controller at independently rejected the patent application even when there was an pre grant opposition pending he had independently rejected, but later on it came to be granted because of some other proceedings. But in a case where there is a pre grant opposition pending the controller will still try to address all the issues on his own before he looks into the pre grant opposition. So, in every case a pre grant opposition is taken up for consideration in all the cases we can assume that the applicant has got over all the objections raised by the controller. So, that is the sequence of events controller raises

objections based on the examiner's report the applicant gets over it only then they consider pre grant.

So, pre grant is that is that is a way also to ensure that the work flows managed in a better way rather than sending a pre grant objection in parallel, also sending the f e r in parallel just to find out that the f e r has already raised and the patent will not get granted not just that, there are various cases where the applicant may abandoned the application after the f e r is sent they will not reply back or they will not comply with the timeline within section 21; if you do not do with in something with in a timeline it is automatically deemed to be abandoned.

So, the controller will allow all these things to pass, if the applicant is interested in still prosecuting it he gets over all the objections only then they will consider the pre grant. So, the pre grant is normally considered after the application is made ready for a grant. So, now, assume a case where there is a pre grant is filed and the application is spending no request for examination you know that there is a 48 month period for you to file the (Refer Time: 51:41) request for examination no request for examination is filed, but assume that the pre grant opponent is in a hurry he wants he is sure that this patent will get a revoked so he wants to expedite it. In that case if the pre grant opponent also is a person interested then he may file a request for a examination using form 18, but the only problem is the patent office will have to understand these two terms as one and the same a person interested and interested person though there been used in different context, if the patent office understands a person interested as an interested person.

Then we can say that an person interested can file a request for examination there is no clarity on this, we have not seen any decisions of either the controller or the high quotes on this to say that a person interested and in interested person are one and the same. If we take that line it means that a person who has filed an opposition pre grant can be find by any person it need not be an person interested any person, but if that person has an interest then that person can actually expedite the examination by taking an request for examination. So, if the applicant wants to delay examination say he wants to take the examination request only after 40 months or just before the 48 month period, an opponent who has already filed a pre grant because pre grant can be filed by any person including a person interested say a competitor files a pre grant the competitor can if this

interpretation is allowed that a person interested and interested person as one and the same.

In the English language they are one and the same if under the act also it is understood that the person interested and interested person are one and the same then a person who has filed a pre grant, can take an application to start the examination process because the examination sources only starts with the request for examination; because we saw that the queue for the examination is different from the queue of filing, filing is based on priority date and you get the priority date based on filing, but what gets taken up for examination is completely different that is based on the date on which you took a request for examination.

So, if you filed late, but you filed a request for a examination on the date of filing itself and a request for publication, then your application will be published and it will take up for examination, your examination will be much quicker than the person who file before you, but waited for 48 months. So, we would understand this provision that an interested person in common English language an interested person and person interested means the same, but if you look at form 18 an interested person has to have an interest in the application that again is you could say that an a opponent is also interested in the application he has some interest business interest you needs to show through documentation that he is interested. If you look at form seven which is the form that is used for filing a post grant opposition there is no demonstration of interest or any document that is required the form does not say that whereas, in the statement of opposition you have to demonstrate your interest in the statement, but the form does not say that whereas, in form 18 it asks you to demonstrate your interest.

So, we understand this in two ways one it could be understood that an interested person for this purpose is different from a person interested going by the meaning, the other way is to say that interested person and the person interested are one and the same because going by the English language meaning. So, both these interpretations are possible and it is possible to say based on the act that a person interested who files pre grant opposition because pre grant opposition can be filed by any person. Assume that the any person is also a person interested who as an interest competing interest then it will be possible for that person to start the examination process, because he need not wait for 48 months and he can quicken the process because he has the pre grant that is pending.

So, this is a provision which allows a person other than the applicant to start the prosecution because we know that prosecution starts only when an request for examination is made. So, act clearly allows a person other than the applicant to start the process.