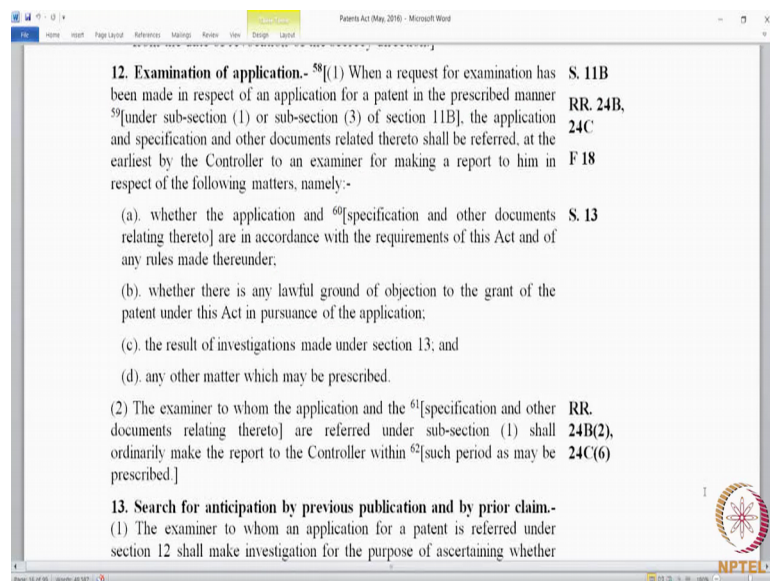


Patent Law for Engineers and Scientists
Prof. Feroz Ali
Department of Management
Indian Institute of Technology, Madras

Lecture - 29
Patent Prosecution: Publication and Examination - I
Examination of Application

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Section 12: examination of application. 12 1 states where a request for examination has been made in respect of an application for a patent in the prescribed manner, under sub section 1 or sub section 3 of 11 section 11B. The application and specification and other documents related thereto shall be referred at the earliest by the controller to an examiner for making a report to him in respect of the following matters namely. So, once a request for the examination is made, the controller shall refer at the earliest to an examiner based on the examiners expertise and the domain to make a report back to the controller on the following matters. So, this is called the examiner's report, the examiner makes the report to the controller and the report pertains to the following matters.

There are 4 things: a whether the application or specification or other documents thereto are in accordance with the requirements of that act and the rules made there under procedural complaints with the act and the rules that is a; b whether there is any lawful ground of objection of the grant of a patent under this act in pursuance of the application.

Lawful ground of objection are objections we understand this as objections based on patent ability objections relating to section 3 and 4 which are exceptions to what exceptions are which gives the statutory exception and as what are not inventions and they could also be objections pertaining to satisfying the requirements of a complete specification which are lastly mentioned in section 10.

So, the lawful objection could come from a provision of the patents act which requires the applicant to satisfy those provisions, in the absence of the applicant not satisfying these provisions they could be construed as an objection for the grant of a patent. So, while a talks about requirements under the act and the rules that is whether the applications specification and the documents where in there is a requirement that a particular margin should be given for the complete specification, drawings should not have writings within them, except in the case of flow diagrams claim should start in a separate sheet.

Now, these are all requirements that an application has to satisfy under the act and the rules, and the timeline requirements the fee requirements this are requirements under the act and the rule. Lawful ground of objection could be an substantial objection not a procedural objection, substantial objection for not granting a patent for instance lack of novelty the invention does not have novelty or the invention does not involve in inventor step the invention is obvious to a person's skill in the art. These are lawful objections because a patent office cannot grant a patent over an invention, which is obvious to a person's skill in the art. So, these objections are termed has lawful ground for objections. C the results of investigations made under section.

Thirteen we will see in under section 13, the examiner shall make a report on anticipation it is a largely a novelty report. So, the search for anticipation is done by the examiner and the result of the investigation is communicated to the controller. So, the examiner also gives in report on the search it is a search report search on anticipation, and d any other matter which may be prescribed. So, the examiner has to look into these 4 things and make a report on these 4 things to the controller; and the report that the examiner makes to the controller shall be confidential. Section 144 states that report of examiners to be confidential, the report of examiners to the controller under this act which is made under the sections 12 shall not be open to public inspection or be published by the controller, and such reports shall not be liable to production or

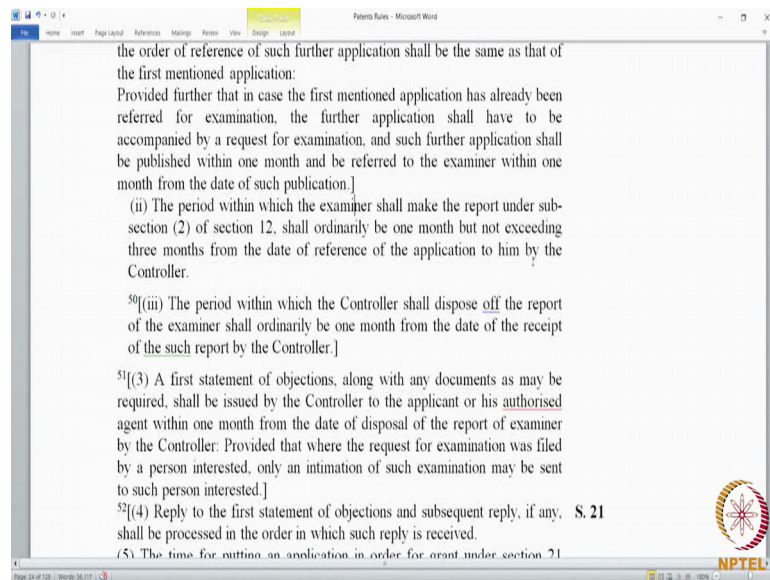
inspection in any legal proceeding unless the court certifies that the production and inspection is desirable in the interest of justice and or to be allowed.

So, the normal rule is that the report made by an examiner to the controller under section 12 is confidential, and this report is not the first examination report or the first statement of objection; because based on this report the controller will issue the first statement of objection or the first examination report. So, it is easy to get miss led by the fact that the examiner's report is the first examiner examination report it is not so, the first examination report is issued by the controller whereas, what is issued by the examiner is an internal document which goes to the controller based on which the controller mixes first examination report.

So, the first examination report is not the report made by the examiner to the controller, rather it is a report that is issued by the controller and now it is called the first statement of objections. Section 12 2 says that the examiner to whom the application or the specification and other documents relating thereto are referred under sub section 1 shall ordinarily make the report to the controller within a period as may be prescribed.

Now, this is just the internal procedure, once the file or the specification the application and the documents are referred to the examiner, the examiner has a time period within which he shall make his report. The time period we will see will change based on the nature of examination if the examination is an ordinary examination then there is a time period for that if it is an expedited examination under 24 C there is a different time period for that. So, we will just see the corresponding rules now.

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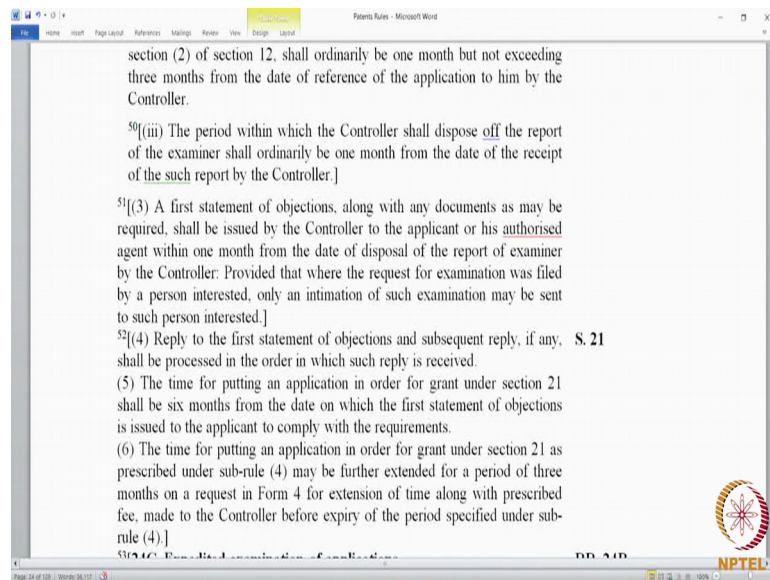
Rule 24 b 2 roman two the period within which the examiner shall make the report under sub section 2 of section 12 shall ordinarily be one month, but not exceeding 3 months from the date of reference of the application to him by the controller.

So, the examiner once the references are made by the controller has to make this report within one month, but not exceeding 3 month. So, the examiner has 3 months to make this report under section 12. 3 states that the period within which the controller shall dispose of the report of the examiner shall ordinarily be one month from the date of receipt of such report by the controller this are all timelines by which the applications moves within the patent office.

Once a request for examination is made the controller shall refer the matter to the controller shall refer the matter to the examiner. Section 12 does not give a timeline for the controller making the reference to the examiner, it nearly states at the earliest. So, section 12. So, the first thing that will happen after the request for the examination is made is that the controller will refer the matter to the examiner what is the timeline for that? The act does not say any timeline it nearly says at the earliest.

So, the controller mix the reference to the examiner, once the examiner receives the reference and the files the examiner shall file is report between 1to 3 months. So, that is the timeline for the examiner to file the report which is a confidential report back to the controller.

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Once the controller receives that report the controller shall dispose of the report of the examiner within one month from the receipt of such report. So, the controller has to act on the report within one month of receiving it. Now what does the controller do? Rule 24 b 3 tells us that the first statement of objections along with any document as may be a required shall be issued by the controller to the applicant or his authorized agent within one month from the date of disposal of the report of the examiner by the controller.

So, the report of the examiner has to be disposed of within one month of receiving it, and within one month from the date of disposal the controller shall issue the statement of objection the first statement of objection, which was earlier called the first examination report it is now called the first statement of objection. So, the controller shall issue the first statement of objection, within one month of disposing of the report of the examiner and this is issued to the applicant or the authorized agent of the applicant.

So, now we are able to see the timelines request for examination is made within 48 months of the date of priority or from the date of filing the application in a normal case, once the request for the examination is made the controller at the earliest possible time refers it to and the examiner now there is no timeline mentioned on the act it is just set at the earliest occasion it is not time is not prescribed. So, that is one part in the prosecution where there is no prescribed time, where the controller refers the application to the examiner there is no time. (Refer Time: 11:09) just mentioned at the earliest.

Once it is referred to the examiner the examiner within a period between 1 to 3 months shall file his report back to the controller, when the controller receives the report within one month he shall dispose the report, and from one month of disposing the report the controller shall issue the first statement of objections to the applicant or the agent of the applicant. So, this gives you the timeline of what happens once an request for examination is filed. Sub rule 3 of rule 24 b states that provided that where a request for examination was filed by a person interested only an intimation of such examination may be sent to the person interested.

Now, we at pointed this out as an anomaly a person interested does not do anything in prosecution except that he gets the power to initiate the examination by filing a request for examination. We had already pointed this out to you that the person interested could be a person who has an competitive interest or in affirming interest or in interest in the patent itself either has an person who acquires an interest later on, and when he makes a request for examination only an intimation of such examination is sent to the person interested.

The first statement of objection is not sent to the person interested, only an intimation is sent. So, this clearly states that the applicant is still the person who gets to drive the examination process, because if the applicant does not do assume that the first statement of objection has issued and the applicant does not proceed with it, he does not reply to the first statement of the objection within the timeline prescribe again the patent application will be dream deemed to have been abundant.

So, though one of the reasons for giving the right to initiate an examination or to initiate or file the request for examination could be that, open failure to file the request for examination the application will be treated as withdrawn by the applicant. Where has when a request for examination is filed either by the applicant or by a interested person, and then the applicant fails to respond to the first statement of the objections the application will be now treated as something that I have been deemed to be abundant.

So, the law uses two different phrases where there is inaction by the applicant in that the applicant does not make a request for examination, the law treats the application as withdrawn by the applicant. Whereas, if the examination proceeds and the first examination report is file by the applicant, and the first examination report or the first

statement of objection is filed by the controller the applicant does not respond to that then the applicant is deemed to have been abundant. Now we get this from the language of section 21 and when we deal with section 21 we will see the difference between instances where something is deemed to be withdrawn and instances where something is deemed to be abandoned.

Twenty 4 b 4 states that a reply to the first statement of objection then subsequent reply if any shall be proceeded; section 24 b 4 states that a reply to the first statement of objections and subsequent reply if any shall be processed in the order in which such reply is received, because patent prosecution is a process which happens for multiple applications at the same time before the patent office, the patent office will only deal with things in the order in which the reply is received.

So, your date of filing the application your date of filing the request for examination are not relevant when it comes to replying to (Refer Time: 15:49) the first statement of the objections. So, whenever the reply is it will be in shall be processed in the order in which the reply is received. For instance if the applicant files reply to the first statement of objections within a week's time of receiving the objections this application will move forward based on the reply received. If the applicant prolongs the reply and waits till the expiry of the till one week before the expiry of the period and then files it then it will be processed in the order in which the reply is received.

So, again the phase of prosecution is determined by the action of the applicant, if the applicant moves quickly the prosecution is likely to move faster if the applicant moves slowly then the prosecution will move in the order in which the reply was received. So, again the burden of moving the prosecution quickly is partly shifted on the applicant. Sub rule 5 says that the time for putting an application in order for grant under section 21 shall be 6 month from the date on which the first statement of objection is issued to the applicant to comply with the requirements, within 6 months of the first statement of the objection being issued the applicant has to comply with the requirements.

Now, if the 6 month period a period that is set on stone in the sense that if you do not reply within this period or if you reply within this period and your is not perfect will you get an additional period beyond 6 months or in other words can the 6 months period we

understood as a 6 month period for a reply for the first statement of objection such that any further statement of objection follows through it can go beyond the 6 month period.

Now there are two ways to look at it, if you look at the next rule that is rule 24 c which talks about expedited examination and compared it with this provision you may get an impression that this is not open ended timeline the time for putting the application for grant under section 21 shall be 6 month from the date, on which the first exam statement of objection is issued to the applicant.

Now, when I say it is an open timeline it could be construed as you should need to respond to the first statement of objection within 6 months, and any further responses can have it is own timeline. It is not that all the objections have to be complied within the 6 month period because we could get this impression when we look at the language used in the next rule and we will compare that when we come to expedited examination in 24 c.

So, the 6 month period can be understood as the 6 months within which you respond to the first statement of objection, and if there are further objections based on that it could be argued that you can go beyond the 6 month period to address those issues it is a matter of argument the other way in which this provision can be interpreted is that every objection that comes out of the first statement of the objection has to be addressed within the first 6 months of the date on which the first statement of objection is issued.

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of the such report by the Controller.]

⁵¹[(3) A first statement of objections, along with any documents as may be required, shall be issued by the Controller to the applicant or his authorised agent within one month from the date of disposal of the report of examiner by the Controller: Provided that where the request for examination was filed by a person interested, only an intimation of such examination may be sent to such person interested.]


⁵²[(4) Reply to the first statement of objections and subsequent reply, if any, S. 21 shall be processed in the order in which such reply is received.

(5) The time for putting an application in order for grant under section 21 shall be six months from the date on which the first statement of objections is issued to the applicant to comply with the requirements.

(6) The time for putting an application in order for grant under section 21 as prescribed under sub-rule (4) may be further extended for a period of three months on a request in Form 4 for extension of time along with prescribed fee, made to the Controller before expiry of the period specified under sub-rule (4).]

⁵³**24C. Expedited examination of applications** **RR. 24B,**
(1) An applicant may file a request for expedited examination in Form 18A **2(b), 19B,**

⁵⁰ Inserted by S.O. 657(E), dated 05.05.2006 (w.e.f. 05.05.2006).
⁵¹ Substituted vide G.S.R. 523(E), dated 16.05.2016, w.e.f. 16.05.2016. Prior to substitution, sub-rule (3) read as under:



There will be a strict interpretation of the provision, and patent applicants are likely to have issues in prosecuting applications if a strict application of this provision is applied. Section 24(6) tells that the time for putting the application for grant under section 21 as prescribed in sub rule 4 may be further extended to a period of 3 months, on a request in form 4. Form 4 is a general form used for any extension of time along with the prescribed fee made to the controller before the expiry of the period under sub rule 4.

Now, you could extend the time for filing a reply which is normally 6 months, before the expiry of the 6 months provided you make a request for extension of time under form 4 you can seek an additional 3 months. So, 6 plus 3 whether you can file further forms one after the other and extend the timeline is debatable, but the sub rule 6 tells us that before the 6 month period expires, you could file a further extension of 3 months.

So, on paper you could say that prosecution of the entire process of objections of replying to the first statement of objection has to be completed within a maximum of 9 months you could say this, you could say this by an interpretation of rule sub rules 5 sub rule 4, 5 and 6 put together you could say that the patent applicant has to respond to all the objections that have come in the first statement of objection within a period of 9 months, and recently we had the minister of commerce make a statement that the applications will be examined within a smaller time frame than it was done before and we should be able to have grants within 18 months of the start of the prosecution process.

So, there was a policy which the Indian patent office's, now moving towards to expedite the grants. So, this provision could be seen in line that if the applicant can only take time of up to 9 months for addressing the first statement of objections then. Obviously, the process of grant is going to become much quicker.