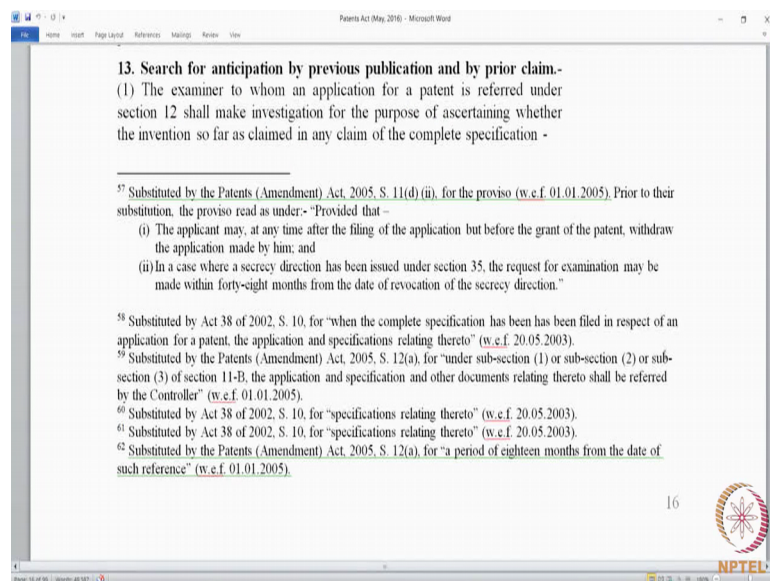


Patent Law for Engineers and Scientists
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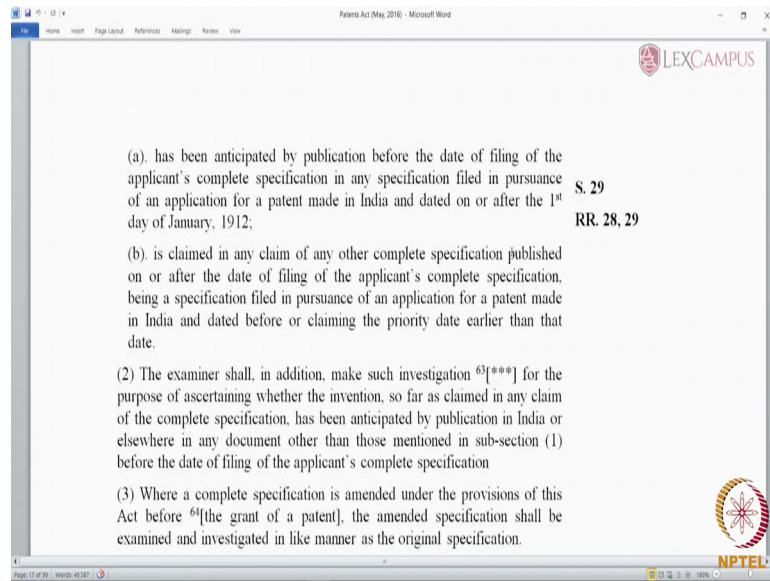
Lecture - 31
Patent Prosecution: Publication and Examination - II
Consideration of Report of Examiner

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Now, we come to section 13. We had seen the sequence of events that happens after a request for examination is made. The controller refers the documents it is the file to a examiner. The examiner files a report to the controller. Section 13 gives the details of what the examiner would do. 13 1 states that the examiner to whom an application for a patent is referred under section 12, shall make an investigation forward the purpose of ascertaining whether the invention so far as claimed in any claim of the completed specification.

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A, has been anticipated by publication before the date of filing of the applicants completes specification in any specification filed in pursuance of an application for a patent made in India and dated on or after the 1st date of January, 1912. B is claimed in any claim of any other complete specification published on or after the date of filing of the applicants complete specification, being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.

Anticipation: now, a and b talks about 2 concepts in patent law. A talks about lack of novelty by the fact that the invention is anticipated by a publication before the date of filing of applicant's complete specification. Now we had already seen the date of filing is normally considered as the priority date. The date of filing is normally considered as the priority date.

The priority date can move to an earlier point and time if there is a priority document say, a provisional specification in which there is a disclosure made and a claimers filed at a later point and time. Any publication before the date of priority of the matter contained in a claim of a specification can anticipate the invention. Anticipation is described as the disclosure of an invention before the date of priority or before the filing date.

Let us assume that, priority in the default case is the date of filing. So, anticipation is a publication of the matter covered in the claim before the date of filing the application. If

the day on which you filed your application, the day on which you filed your application the law requires the invention to be novel, then invention to be new or novel. The test of novelty requires the invention to have not been anticipated by any publication before. a tells us that if there is any publication before the date of filing, That could amount to anticipation or that could kill the novelty of an invention, provided what is claimed in the application was covered by that document by that publication.

Now the language here is that whether the invention so far as claimed in the claim of the complete specification has been anticipated by publication. And what is cut off line there? Before the date of filing the complete specification in any specification filed in pursuance of an application of patent made in India and dated on or after the 1st of January 1912. So, any claim made in any specification filed in India. So, it is India's specific, after the 1st of January 1912.

Now the 1st of January 1912 was the time when the 1911 act came into being. So, that was the start of the patent regime in India. So, any claim that was filed in the Indian patent office, would anticipate an invention if what is claimed in that invention is covered by the earlier publication.

So, we will look at b and then we will look at the definition of new invention so that the concept of anticipation and lack of novelty is much more clearer. B states that is claimed in any claim of any other complete specification published on or after the date of filing the applicants' complete specification, being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.

Now a considers a scenario where any specification filed in India after 1912, but before the date of filing of the applicants complete specification can be a subject matter of anticipation. Anything that is filed in India let us forget 1912 as a timeline. Any application filed in an Indian patent office because, that is when the 1911 act was the 1st formal patent act for India.

So, the patent office everything was created with that. So, before that we had some executive orders. So, any patent filed in India before the date of filing can anticipate an invention. So, the examiner is going to check on all the specifications filed in India before the date on which the applicants specification was made to see, whether what is

claimed by the applicant has been claimed before. So, anticipation is a check to see whether what is been claimed in the applicants complete specification was covered by a publication of any specification filed in India. So, the timeline is 1912 because, that is when the Indian patent regime started. B talks about what is not covered in a.

Now let us assume an application was filed on 1st January 2017. So, as per a the examiner has to look at every specification that was published before the date of filing which was one day before 1st January 2017. That is from December 31st 2016 onwards the controller can look at all the specifications filed in India before that day, the controller can check to see what is claimed in this application whether it was claimed before, whether it was anticipated by the publication which happened before.

So, what the controller will do? As per a, is to look at all the documents before Jan 1st 2017 filed before the patent office in India. In b, the controller will look at documents published on or after the date of filing the applicant's complete specification. Now in a only the documents before the date of filing will be considered. In b, the documents which are published on or after the date of filing the complete applicant complete specification. In b the examiner will look at documents filed on Jan 1st 2017 or after Jan 1st 2017 this is the publication in pursuance of an application made for a patent term made in India, and dated before or claiming the priority date earlier than that date. The only condition is though the publication happens after Jan 1st the priority date should have been earlier than that date.

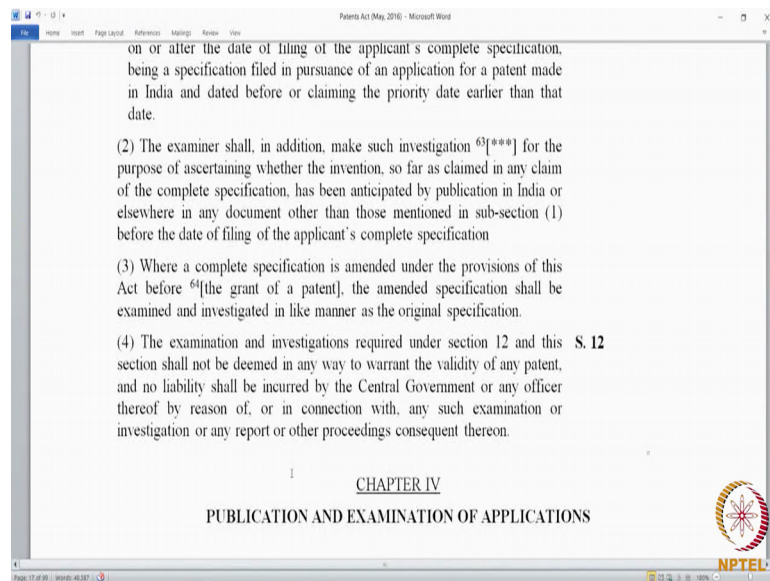
So, which simply tells us that the controller can look at a document which is published after the filing of the applicants complete specification, if it is priority is before the applicants complete specification. Because, still there will be a case of anticipation. So, anticipation can sometime happen when applications are pending. Say, a person files an application on Jan 1st, and other person files an application on Feb 1st.

So, we will not know unless these publications are published we will not know. So, once the Jan 1st application gets published then that can be because the priority date is earlier it can be used for questioning the novelty of the latter filed complete specification. So, in b the examiner is going to look at any complete specification published on or after the date of filing of the applicant's complete specification. Whereas, in a the examiner will look at specifications filed before the date of filing of the applicants complete

specification. Now the only requirement in b is that though the document was published late afterwards after the filing of the applicants complete specification, the priority should have been earlier to the applicant's complete specification.

So, the report on a and b will cover both publication before the date of filing and publications after the date of filing, but in the case of publication after the date of filing the controller will see whether the priority was an earlier priority.

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Now, the examiner shall in addition to making such investigation for the purpose of ascertaining whether the inventions so far as has claimed in any claim of the complete specification, has been anticipated by publication in India or elsewhere in any document other than those mentioned in subsection one before the date of filing of the applicants complete specification.

Now in subsection one we were only talking about complete specifications. We were talking about complete specification filed in India before the date of the applicant's complete specification, and we were also looking at complete specifications filed in India after the date of the filing of the applicants complete specification provided it as a earlier priority. 2, talks about every other document; in a section subsection one deals with what we call cases of prior claiming. A claim that was made before anticipates a latter claim, this is called prior claiming. 2, covers prior publication: publication can be in a claim, it could be also in a document other than a claim. If there is research article or a scientific

literature which discloses this invention then, that may not be a case of prior claiming because, the discloser not an earlier claim of a complete specification rather the discloser was in a prior publication.

So, this is a kind of anticipation. Anticipation has different categories this is anticipation by a prior publication. So, 2 captures everything else that other than what one pertains to. 1 covers only complete specifications which means the claim has to be disclosed in an earlier claim. So, 1 talks about mapping claims you look at the claim as filed by the applicant and look for an earlier claim and try to see whether the claims are one and the same or similar, and whether one claim could have anticipated the other. 2 talks about any document it specifically says has been anticipated by publication in India or elsewhere in any document other than those mentioned in subsection 1 The documents mentioned in subsection 1 where only complete specifications and if is a complete specification you are going to look at the claim. And this concept is called prior claiming.

If it is not a complete specification say, it is an journalarticle or it is a paper published in a scientific conference or it is an instruction manual of a new product. In all these cases, you would look at anticipation, but not you will not do the, you will there will there are simply no claims for you to look for. So, this is what we call as anticipation by prior publication. So, this is a different category and when we look at a the language in section 25 which details the grounds of opposition and section 64 which gives a grounds revocation you will see that, anticipation comes in different categories. The anticipation could be by prior claiming, anticipation could be by prior publication, and anticipation could also be by prior use.

So, we will look at those categories when we come to that section, but 1 talks about complete specification anticipation by complete specification, both published before the date of filing of the applicant's specification and after the date. 2 talks about every other document, which is not covered in 1 The subsection 3 states that, where a complete specification is amended under the provisions of this act before the grant of a patent the amended specification shall be examined and investigated in a like manner as the original specification. Now any amendment before the grant will be examined by the controller. It is just that while an application is pending, the applicant carries an amendment the amendment should also be examined in the same manner. A report under 13 is required even for a an amendment.

Subsection 4 states that the examination and investigations required under section 12 and this section there is, 13 shall be deemed shall not be deemed in any way to warrant the validity of any patent and no liability shall be incurred by the central government or any officer thereof by reason of or in connection with any such examination or investigation or any report or other proceeding consequence there on.

Now this is an immunity provision which protects the central government and the officers. It just says that, an examination done will not warrant the validity of a patent. So, even if the examiner makes a statement that the patent can be granted because it does not it is satisfies the test of novelty and inventive state and later on if the patent is challenged in a court of law or before the applied board and if it is invalidated they cannot be any action against the patent office or it is officers.

So, it is to protect them it is it is an official protection that is required to say that, they investigations that they would do not warrant the validity of a patent. So, we can understand the examination as a preliminary validity. You know, the examination actually comprises of a preliminary validity, they do a validity check, but it is a preliminary check.

So, if you come up with better evidence or better prior art and if you are able to challenge the patent the courts of law will definitely look into. They will not say that no the patent officers already granted we will not look into. This provision actually protects the patent office that they cannot be any liability incurred on the central government on any officer by the fact that they granted a patent which was valid and which was later which could be challenged as invalid.