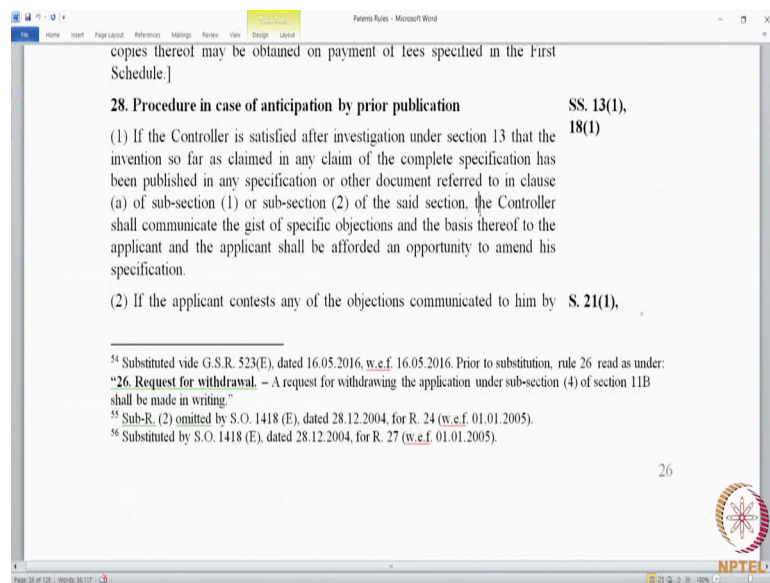


Patent Law for Engineers and Scientists
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Lecture - 32
Patent Prosecution: Publication and Examination - II
Procedure in case of Anticipation

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Rule 28: procedure in case of anticipation by prior publication. Rule 28 describes what should be the procedure that the controller should follow in cases of anticipation. And we saw in section 18 the powers of a controller in cases of anticipation and we saw that where there is a case of anticipation. The applicant can either show to the satisfaction of the controller that the claim is actually the priority of the claim of his application is before the date of the prior art document that is sited against him or he can amend his complete specification to get over the objection. These are the two things the applicant can do.

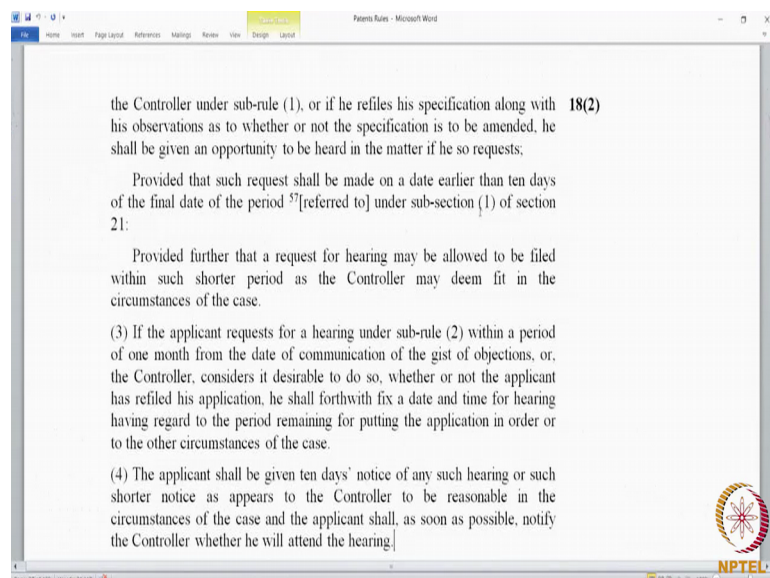
In some cases we also saw in section 18 the controller can add a reference to an application which was published after the priority date, but which was filed before the priority date of the applicant's patent. Now in rule 28 the procedure is described. Rule 28 1 states that- if the controller is satisfied after investigation under section 13 that the inventions so far as claimed in any complete specification has been published in any

specification or other document refer to in clause A of subsection 1 or sub section 2 of the said section they were section 13. So, 13 1 A or 13 2 any of the documents mentioned in this which are largely we know that a documents in the form of a complete specification or any other document. The controller shall communicate the gist of the specific objections and the basis thereof to the applicant and the applicant shall be afforded an opportunity to amend his specification.

So, once the controller finds that there is a case of anticipation the controller shall communicate the gist of the specific objections. Now we do not understand or the rule here is not clear as to how that communication can happen. It just says the controller shall communicate the gist of the specific objections and the basis thereof. Why those objections were raised? Which means, if there is a prior art document kind of the document is prior filed patents specification the controller will have to give the number, and if there is a particular claim then he should he would mention that claim so and so of your application is anticipated by claim so and so of this prior.

So, that is what we understand as gist of specific objections and the basis thereof, so that the controller will have to communicate to the applicant.

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So, when the applicant receives this if the a 28 rule 28 2 says if the applicant contest any of the objections communicated to him by the controller under sub rule 1 or if he re files his specification along with his observation as to whether or not the specification is to be

amended he shall be given an opportunity to be heard in the manner if he; so, request. So, we saw that the controller communicates the applicant can respond to the objections and he can also request for an hearing opportunity to be heard; yes if he makes a request for hearing the controller will have to hearing.

So, in this process is could come as an objection raised by a controller and wherever an objection is raised by the controller the applicant is afforded an opportunity to clarify the objection in addition the applicant can also request for a hearing. And there are provisions under the patents act where a hearing can be requested and the manner in which hearing should be conducted.

Provided that such request shall be made on a date earlier than 10 days of the final date of the period refer to an subsection one of section 21. Now section 21; we have not come to that section yet deals with the timelines for putting a patent, in order section 21 is title time for putting application in order for grant section 21 fundamental premise is when the offers communicates an objection by way of the FAR or by subsequent objections there is a time within which the applicant will have to respond the time line is given in section 21.

And now that we have an expedited examination some of the timelines have even become shortened. So, there are timelines have become shortened in the case of an expedited examination. So, section 21 talks about the timelines for putting the application in order for grant the time that is given to put the application in order. So, that it can be granted which means the time given to the applicant to carry out the objections raised by the controller to respond to the objections in a manner in which the controller satisfied to grant the patent.

So, this timeline the proviso here tells us that between before the request for hearing has to be made 10 days earlier to the final date of the period refer to an section 21 1 hearing when you make a request for a hearing the it takes when you make a request for a hearing the controller will have to make an arrangement for the applicant to be present in his office, so hearing take some time. So, that is why you find a 10 day period that is given before the expiry of the final date you have to make a request for hearing there are other provisions of the patents act where if you request for a hearing say in a or when a

hearing is communicated there is a similar notice period so that the parties and the controller can prepare for a hearing.

So, hearing is not something that is given without advance notice hearing should under the act always be proceeded by a notice period sub rule 2 further continuous provided further that is request for hearing may be allowed to be filed within such shorter period as a controller may deem fit in the circumstances of the case or the controller may have a shorter period for the applicant to request for a hearing and that is left to the discretion of the controller.

In a normal case you can make a request 10 days before the final date of the period under section 21, but in some cases the controller can allow a shorter period. So, the controller when he communicates the gist of the specific objections the controller can also say respond to me in 30 days time or respond to me in 2 weeks time. So, this provision allows the controller to set a shorter period for instant if the controller feels that the objection can be adjust much quicker he need not wait for the entire time period to end or if the controller feels that there are other applications of similar nature pending and he wants to take them all together he can ask response to be given at a shorter notice.

So, there could be various administrative reason why a controller can insist on a shorter period, but the power is given under sub rule 2 sub rule 3 if the applicant request for a hearing under sub rule 2 within a period of one month from the date of communication of the gist of objections or the controller consider to desirable to do. So, whether or not the applicant has re filed his application he shall forthwith fix a date and time for hearing having regard to the period remaining for putting the application in order or to the other circumstances of the case.

Now, if a request for hearing is made within one month. So, the gist of objections is communicated to the applicant by the controller the applicant receive the gist of objections and within one month he request for a hearing. So, there is a one month time period for him to request for a hearing the request shall be made within the period stipulated in an 21 there is a period stipulated within which the prosecution has to end 10 days before that is the time line it is the last time period given for the applicant to make the request he cannot make if the time line is ending on January 31st of a particular

month he cannot make a request for hearing 2 or 3 days before that the rest be a clear 10 days before which he can make a request.

Now, sub rule 3 tells us that when the gist of the objections is communicated the applicant can make a request for hearing within one month from the date of communication. Now if the applicant makes a request it as to be within one month of receiving the communication containing the gist of objections the controller shall fix a date regardless of whether the applicant has re filed his papers. Now, when an objections comes saying that there is a particular prior art one recues for the applicant is to amend his specification.

So, that is what we call refilling the his application he has to re file his application he has to file that amendment whether or not he has refilled it whether or not he has carried out the amendment the controller can go ahead and fix date and time of hearing. Now the date and time of hearing will be fixed taking into consideration the remaining time for putting the application in order for a grant. Now I will give you a hypothetical situation.

Assume that when the FAR assigned for the first time the applicant has one year to reply now let us say 6 months to reply the applicant replies within a month. So, there is still 5 more months time period left the controller further communicates and says that there is an objection on anticipation. Now this happens in the second month the applicant can make an amendment and request for a hearing within the third month he is entitled to do that. Now when he does that when he makes a request the controller will now have to said the hearing keeping the final date in mind he knows that there is a 6 month period beyond which within which the changes have to be carried out.

So, the controller will always fix the time period keeping this time in at what stage is the patent application in and how much longer does the applicant have to put the application in order for a grant we saw that in rule 24 B examination of application we saw the timelines, we also saw in rule 24 C what are the timelines in the case of an expedited examination now rule 24 B and 24 C actually expand on the timelines mentioned in section 21.

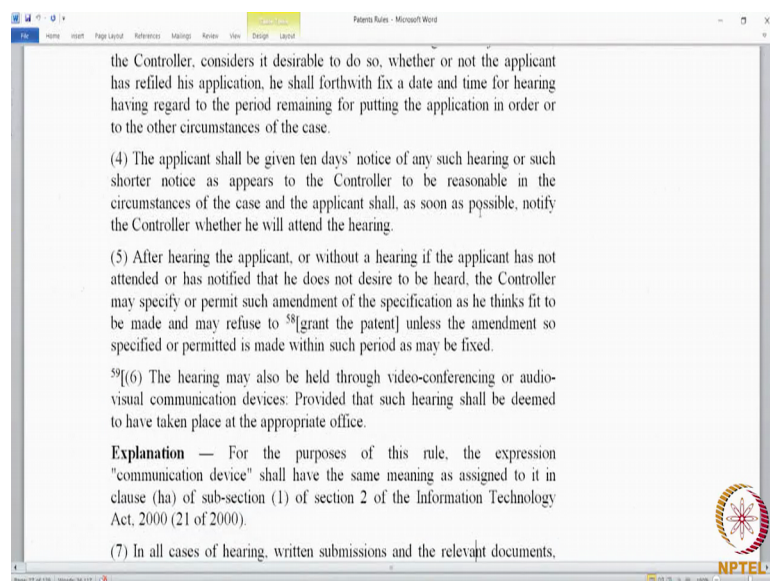
Section 21 tells you that if the controller gives you time to do something you have to do something within that time. If you do not do it your application will be treated as abandoned in this a hearing when a specific objection is raised on anticipation the

applicant can't reply to them and also request for a hearing when the applicant requests for a hearing it should not be at the end of the time that is allocated to it should be at least 10 days before the end of the time allocated to him that is one thing.

Secondly when you receive your objection the hearing has to be requested within one month of receiving the objection. So, these are 2 different things I receive the communication from the controller within one month I will have to request for a hearing, but that request should not be in the end of the time period allotted to me if there are only 10 days left. Then I should do it immediately upon receive I should not wait for a longer time, because the law says that there has to be a 10 day period before which you can before the expiry of your allocated time to make this request.

Now, the date and the time will be fixed by the controller keeping this time line in mind. So, the timeline will largely depend on section 21 rule 24 B and rule 24 C this will decide how much time an applicant has to put the application in order for a grant 20.

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Now, sub rule 4 the application shall be given 10 days notice of such hearing I already mentioned that the normal there is a notice period for hearing and its 10 days in this case or such shorter notice period as appears to the controller to be reasonable in the circumstances of the case and the applicant shall as soon as possible notify the controller whether he will be attending the hearing.

Now, once a request for hearing is made by the applicant the controller can give notice of the time and date of hearing. So, I as an applicant if I make a request I cannot make a request and end up in the patent office, because I am only making a request for the hearing I am not going to ask the controller to fix the date fixing the date and time we saw in the earlier sub rule is given it is a discretion of the controller, because the controller has his own administrative duties the controller now, and he has many applications on which he is which is prosecuting.

So, the fixing the date and time has to be done by the controller and that is communicated to the applicant when that is communicated the controller can either give a 10 days notice period notice period is he sends a letter saying the hearing will be after 10 days or if the circumstances require it can be a shorter period. Now assume that everything is going to happen an objection is raised just 15 days before the allocated time the allocated time ends in 15 days controller sends an objection just 15 days before that now the one month period will have no meaning. Now you have to move very quickly because you only have 15 days period and the applicant knows that he has only 15 days period and say he communicates on the 5th day. Now the controller will not have time to give a 10 days notice.

So, in such cases he make and give a shorter notice. So, that is the power is given in sub rule 4 ideally the notice period for a hearing the letter communicating the date and venue of the hearing will have a 10 day before the hearing ideally, but if the controller needs to give a shorter period he can do that sub rule 5 after hearing the applicant or without a hearing if the applicant has not attended or has notify that he does not decided to be heard the controller may specify or permit such amendment of the specification as he thinks fit to be made and may refuse to grant the patent unless the amendment to the specified or permitted unless amendment. So, specified or permitted is made within the period as may be fixed.

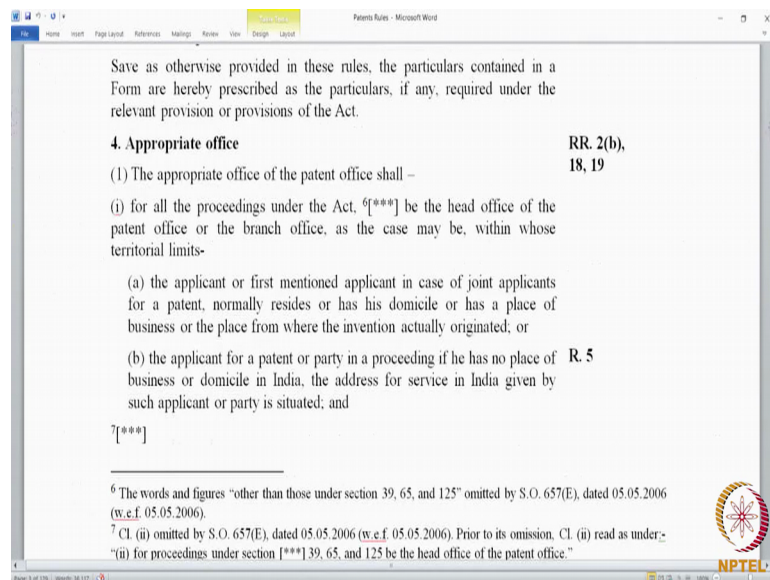
So, after the hearing in the hearing the applicant will put forward the case that he has submitted either trying to satisfy the controller that the prior art is different and does not affect his priority or filing an amendment. So, once the applicant does that sub rule 5 says that the controller may specify or permit such amendment as he thinks it controller may ask for another amendment or the controller made allow that amendment that is one

thing he can do or if the controller is not satisfied he may refuse to grant the patent unless the amendment.

So, specified is made within such period as may be fixed now this language is taken from the language of section 15. And we saw in section 15 the controller can require an amendment if the amendment is filed then the patent is granted if the amendment filed is not satisfactory or no amendment is filed then the controller can refuse to grant the patent. So, this sub rule is though it comes in the context of anticipation the hearing happens under section 15 and the order that is passed also happens under section 15. So, this sub rule talks about the power of the controller to amend and the power of the controller to refuse to grant and patent.

Both the powers are contained in section 15 sub rule 6 which was introduced recently states that the hearing may also be held through video conferencing or audio visual communication devices provided that such hearing shall be deemed to have been taken place at the appropriate office appropriate office is defined as the office where the application is filed and the office that is prosecuting the application.

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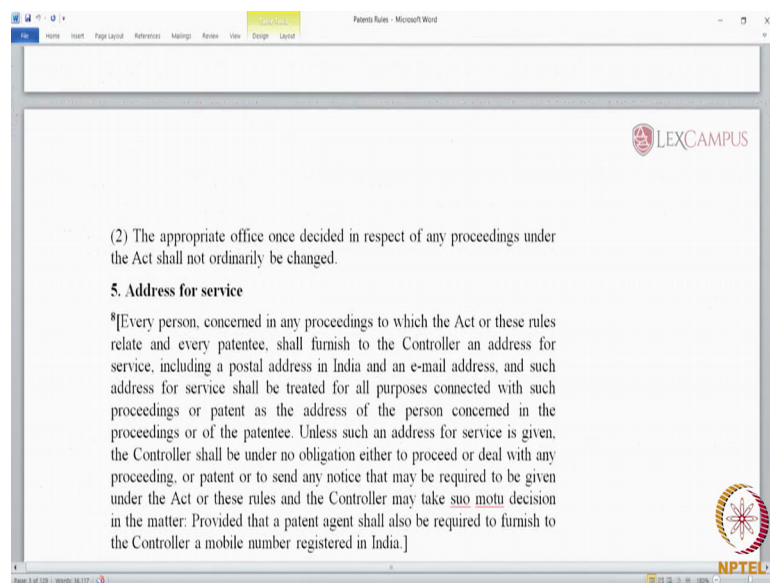
Rule 4 appropriate office the appropriate office of the patent office shall one for all proceedings under the act be the head office or the patent office or the branch office as the case may be within whose territorial limits a the applicant or the first mentioned

applicant in case of joint application normally resides or has his domicile or has a place of business or the place from where the invention actually originated.

Now, if all these things are there appropriate office will be where the applicant resides or has his domicile or has a place of business or where the invention actually originated or the applicant for a patent or a party in the proceeding if he has no place or business or domicile in India the address for service in India given by such applicant or party is situated now.

So, if the applicant does not have a place in India he does not do business in India he does not reside in India or he is not domiciled in India we know that foreigners can file applications here then the appropriate office will be decided by the address for service in India. Now if a multinational company engages law firm based in Chennai then the address for service in India will be thus address of the law firm in Chennai so; obviously, the application will be filed in the Chennai branch of the patent office. So, the same multinational company for a different application can engage a law firm based out of Kolkata in that case they will give the address of communication as that of the law firm in Kolkata and the appropriate office for that application is going to be the branch of the Kolkata branch office.

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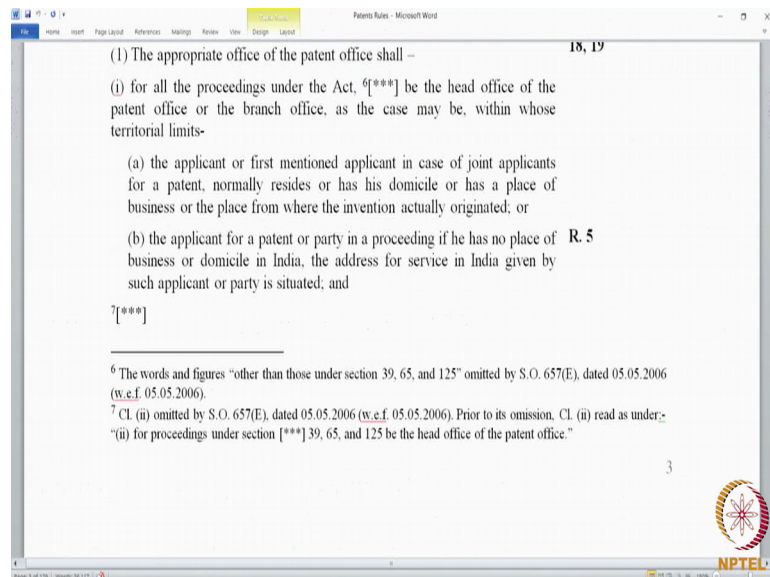


The appropriate office once decided in respect of any proceeding shall not ordinarily be changed. So, if an application is filed in Chennai because the multinational company

engaged a law firm based in Chennai and that was the address given later on the address the law the multinational company feels that we should now engage with the Calcutta law firm and it wants to transfer the file from here.

So, it will give a fresh authorization to the law firm based in Kolkata, but the file will not be transferred the file will continue to be a Chennai file it will not be ordinarily be changed just, because we saw that the sub rule 2 deals with instances where the appropriate office is decided based on where the appropriate office is decided based on the address of service.

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So, 4 2 just says that just because the address of service keeps changing the appropriate office will not change its only the address of service as on date of filing after that it will remain the same four 3 states that notwithstanding anything contained in sub rule 2 the controller may transfer an application for patent. So, filed to head office or as the case may be branch office of the patent office.

The controller has power to transfer files regardless of the fact that once a file is filed in a particular office it remains the appropriate office regardless of that the controller has power in some cases to transfer files 4-4 states that notwithstanding anything contained in sub rule 1 further applications filed in section 16 of the act shall be filed at the appropriate office or the first mentioned application only this is a requirement only for divisional application a divisional application has to be filed in the same office as where

the parent is filed there is some cases where the divisional was filed in a different office and the parent was in a filed in a different office.

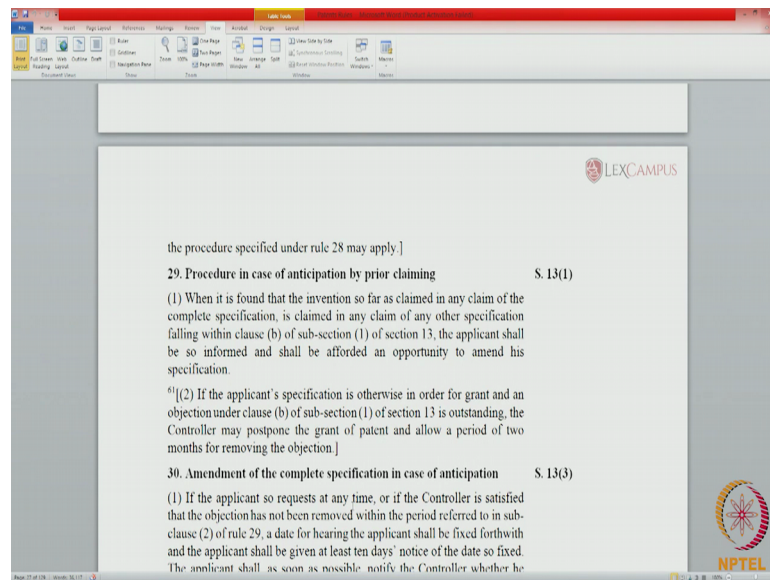
Now this creates some administrative difficulties because the controller or the patent office may not know that there is a divisional and we saw in 24 B that if a divisional is filed later on then the divisional should get into a fast track publication and examination. So, that they can be examined together the parent and the divisional can be examined together there is a provision in 24 B to expedite that.

So, here the patent office clearly says that you cannot file a parent application in one office and chose another office for filing a divisional this came in 2013. Before 2013 there was some cases, where there was cases where an applicant would file a parent application in one office and chose to file a divisional in an entirely different office. So, this adjusts that issue.

5 5 all further application refer to section 16 of the act filed in an office other than the appropriate office of the first mentioned application before the commencement of the patents act twenty twelve shall be transferred to the appropriate office of the first mentioned application which means the patent office acknowledges that there was a problem 5 actually acknowledges problem for which sub rule 4 is the solution sub rule 4 says we cannot file a divisional in a different office, than the parent where the parent was filed 5 says there were some cases where it was filed we will transfer it to the where the parent is.

So, the child will be transfer to the office where the parent is. So, 5 only takes care of that. So, this acknowledges a problem that it shall be the divisional and the parents have to be in the same appropriate office now let us come back to the rule.

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Rule 29: procedure in case of anticipation by prior claiming. Rule 29 1 deals with a procedure that has to be followed when there is an anticipation by prior claiming in rule 28 we saw that rule 28 1 there is an investigation and the controller is satisfied that the investigation that there are certain objections the objections are communicated and the gist of the specific objections are communicated. And an opportunity is given to amend now the applicant can contest that or re-file his specification. And he can request for an opportunity to be heard and he shall be given an opportunity to be heard and there are timelines for the hearing.

After the hearing the controller may either accept the amendments to the specification or refuse the amendment now this is broadly the procedure under rule 28 rule 29 one states that when it is found that an invention. So, far as claimed in any invention of a complete specification which means I have said this is a the short form; form this is when it is found that a claim if claim did not any claim of any other specification falling within 13 1 b the applicant shall be.

So, informed and shall be afforded an opportunity to amend. So, here the procedure is quite simple there we saw in 28 to understand 29 in detail you will always have to compare it with rule 28 in rule 28 we saw that what is communicated is the gist of the objections and the objection comes under section 13 the gist of the specific objection is communicated here what is communicated is the fact that something is prior claimed

what is claimed in the applicants specification has been claimed in another specification that is all it is a case of prior claiming. So, the applicant shall. So, be informed and shall be afforded an opportunity to amend just 2 things here inform the applicant that it is there is a prior claim and give him an opportunity to amend.

29 2 if the applicants specification is otherwise in order for grant and other wise in order for grant you will always go back to section 43 section 43 is the cross reference for rule 29 2, because whenever we see the word other order for grant an application is made ready for a grant or made in order for a grant or becomes ready for a grant under section 43; section 43 is a provision which grants it and it has to satisfy all the objections that could be raised and only when it overcomes all the objections it is in order for a grant and an objection under clause B of subsection one of section 13 is outstanding the controller may postpone the grant of the patent and allow a period of 2 months for removing the objection.

So, when there is an outstanding objection we understand this as it is otherwise its ready for a grant, but in objection is outstanding a 13 one b a objection is outstanding the controller will postpone the grant and give a period of 2 months for removing the objection. So, you could have a question that under rule 29 or under section 13 1 b if there is an outstanding objection under section 13 1 b what is the time period that the controller shall give for removing the objection.

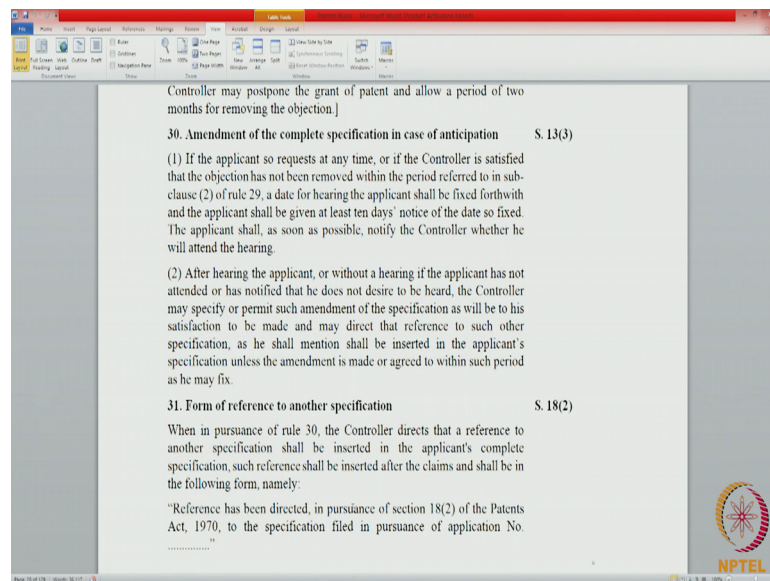
So, 1 month 2 moth 3 month 4 month, so, you could you could have a objective type question based on this because it is a very particular provision it is much different from rule 28; rule 28 the controller does not give any time. Now the reason is under rule 28 it is an investigation of anticipation by prior publication and prior publication will involve mapping the claim of the applicants specification to a published material it need not be a claim whereas, in 29 there is an existing claim existing claim is to be. So, in 29 we are talking about a claim to claim comparison.

So, it is much more specific there is no need for anyone to read a document understand the scope of the document interpret the document here it is just claim to claim mapping, because its claim to claim mapping the controller can be very specific in his requirement within 2 months overcome the objection I am postponing the grant for 2 months

overcome it by remove the objection. So, so the procedure is shorter and much more specific because it is a claim to claim mapping.

Whereas, in anticipation by publication it need not be a claim to claim mapping in most cases it is going to be a claim mapped with another document another publication rule 30 amendment of complete specification in case of anticipation.

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31 states that if the applicant. So, request at any time or if the controller is satisfy that the objection is not removed within the period refer to in 29 2 which we just saw a date of hearing the applicant shall be fixed forthwith and the applicant shall be given at least 10 days notice of the date. So, fixed the applicant shall as soon as possible notify the controller whether he will attend the hearing. Now you can draw a list of types of hearing under the patents act and you will be surprised to see under how many provisions you can have different hearings.

The default hearing provision is under section 15 any objection a controller is incline to refuse an application he can call for a hearing and by based on that if he asks the applicant to amend the specification or if he asks the applicant or if he rejects the application or if he grants the application, if he is going to write an order I am granting application because of this reason they overcome it I want the application to be amended based on this reason or I am rejecting the application based on this reason they will all be orders under section 15, because the power to refuse an application comes only under

section 15. And we know that the controller shall not exercise his discretion without giving a hearing.

So, in 15 hearing is compulsory or mandatory we can say that in under section 15 if the controller has a section 15 proceeding hearing is mandatory because there is a provision under the patents rules rule 1 29 which states that the exercise of discretionary power by the controller shall be done only after affording a hearing to the party who would be affected. So, rule 1 29 mandates the controller to have a hearing. So, under section 15 if the controller asks the applicant to amend the specification he is exercising his discretionary power or if he wants to refuse the application; again he will be exercising his discretionary power he has a choice to do things in different ways that is where discretion comes in.

So, wherever he can exercise his discretion there he has to give a hearing now there are cases where the controller cannot exercise discretion there; there is no need for a hearing the applicant files a request for examination there is no discretion required on the controller has to posted for examination he cannot now here the request for a hearing or I want to know why you want this to be examined that question does not arise. So, there is no discretionary power when for many things under the patents act it is a procedure there is rule the controller has to do the next thing.

But wherever he can exercise discretion; discretion we understand discretion as a choice either to do one thing or another thing under 15 we can grant a patent ask for amendment refuse the patent application. So, you can do 3 things. So, that is why discretion comes in. So, where he exercise his discretion under rule 1 29: we know that he has to give the applicant or a party a hearing this is to satisfy the principles of natural justice where it is a principle in law.

And the Indian legal system recognizes that principle; that if you have to take a decision if a government authority has to take a decision in a matter pertaining to a third party an applicant who has gone before the government authority he has to hear the other side without whatever decision he passes without hearing the other side without hearing the party concern, if he passes a decision. Then that is what we call there is a violation of the principle of natural justice the that the principle of natural justice tells us that you should not pass any order without hearing the party who will be affected that is a principle in

law which says that you should not pass any order without hearing the give him an opportunity you have to call that person give him an opportunity hear his case and then pass the order.

So, this provision 1 29 tells us that there has to a hearing. So, we were on the point that if you enlist the hearings under the act and the rules you will be surprised to find that there are there could be a hearing under section 15 they could be a hearing under section 14 you could have hearings under section 25 1 hearings are mandatory under section 25 2 we saw in rule 30 they could be a hearing. So, this specific hearing and this is for removing an objection under rule 29 2 they can be a hearing. So, this is a specific hearing we understand this is a specific hearing.

32 states that after hearing the applicant and without a hearing if the applicant has not attended or as not or as notify that he does not decided to be heard the controller may specify or permit the amendment of the specification, as will be to his satisfaction to be made and may direct the reference to such other specification. As he shall mentioned, shall be inserted in the applicants specification unless the amendment is made or agreed to within such period as he may fix.

So, after the hearing the controller may specify or permit the amendment to his satisfaction or he may direct a reference to be made inserted in the specification, because we had seen that the controller also has the power to make the references in case of anticipation.