

Patent Law for Engineers and Scientists
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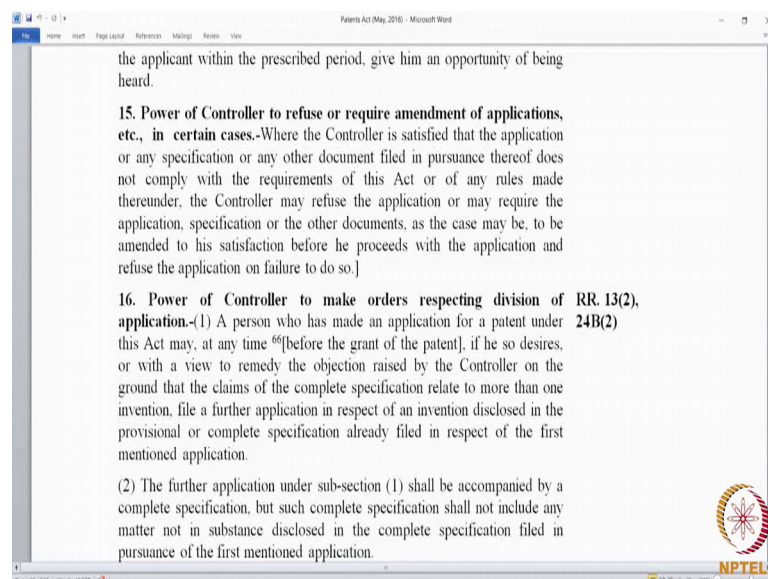
Lecture - 34
Patent Prosecution: Powers of Controller
Refuse, Require Amendment, & Division of Applications

Powers of controller: the controller has certain specific powers that is being wasted on the controller under certain provisions of the act, and he also has certain general power. So, let us first look at the specific powers that the controller has.

Section 16: details the powers of the controllers to make orders respecting division of application. In case of an application having more than one invention the controller can make some directions to divide to required applicant to divide the application. 17: contains the powers of the controller to make orders respecting dating of application. That application could be antedated or post dated. 18: details of powers of the controller in cases of anticipation. And 19: details the powers of the controller in case of potential infringement. 20: details the powers of the controllers to make orders regarding substitution of applicants.

Now these are some of the specific powers, where the controller is allowed to exercise those powers in detail. We will look at these sections in detail.

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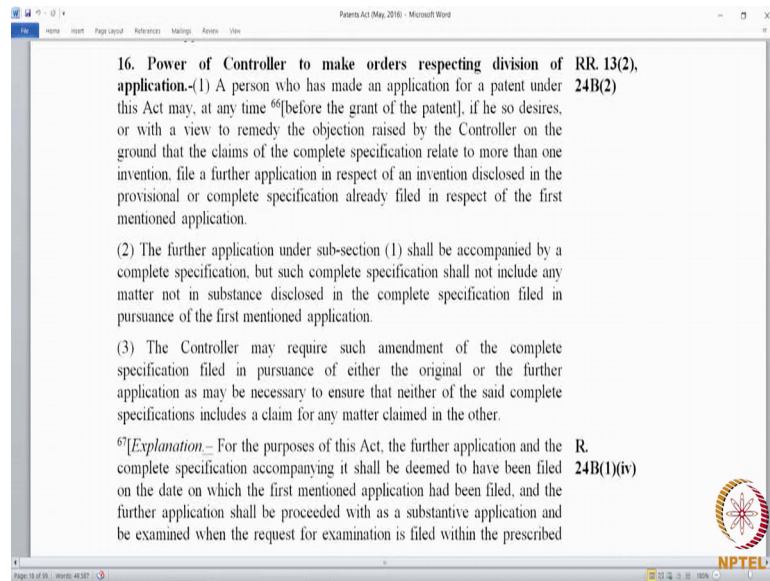


Section 15 power of the controller to refuse or requires amendments amendment of application etcetera in certain cases where the controller is satisfy that the application or any specification or any other documents filed in person that of does not comply with the requirements of the act or any rules made there under. So, we have gone beyond 14. 14 is a state where there is an adverse report the objections are communicated to the applicant and the applicant assumed the applicants come for the hearing. At the hearing the applicant is expected to clarify stand and to clear these objections.

The applicant can come for the hearing and give your submissions or orally or and also given return submission on the objection raised by the controller. Now after the hearing the controller feels that the application does not comply with the requirements of the actor that controller still feels that, even after having a (Refer Time: 02:44) that hearing there are still certain things that are not in order under the act and rules. Then the controller may refuse the application that is one option to the controller or may require the application and the documents to be amended to satisfaction before he proceeds with the application and refused the application on failure to do so. Controller can either refuse the application upfront or give an opportunity to amend if the amendment does not happen to satisfy can he can still refuse.

So, section 15 gives the power for the controller to make any refusal of an application, and the ground for the refusal is going to be it does not comply with the requirements of the act and the rules, the controller can make an upfront refusal or given opportunity for the applicant to carry out amendment, if the amendments are carried out to satisfaction it results in a grant, if the amendment is not carried out to the satisfaction of the controller he can proceed to refuse the application.

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Section 16: power of controller to make orders respecting division application. Divisional applications can be filed when one or more inventions are claimed in a single application there is a rule on the unity of inventions every application should only cover one invention or a group of inventions, which are linked by what we call as single inventive concept.

So, you can only file one application for one invention, if there are more than one invention in an application the controller would require the invention that to be separated so that they can be a divisional application failed to separate that invention. So, if there are two inventions in a specification as file and the controller feels that they the second invention which is also mentioned in the complete specifications should become a separate application then the controller can ask the applicant to file a divisional application the applicant could also voluntary file it. So, 16 one says that a person who has made an application for a pattern under this act at any time before the grant of a patent if you. So, desire or with a view to remedy and objection raised by the controller.

So, if you so, desires means it can be done voluntarily or with a view to remedies the objection raised by the controller means that it can also be directed by the controller on the grounds that the claims of a complete specification relate to more than one invention. Now this is the only ground on which you can file the divisional, the claim in the complete specification relate to more than one invention the law requires you to file only

one application per invention this is mentioned section 10 5. File further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first mentioned application.

Now, the 16 1 allows the applicant to file a further application in respect of the invention disclosed in the provisional or a complete specification already filed. So, the disclosures is already made the claims have to be separated. So, the claims contain more than one invention, all the claims say the claims contain two inventions a and b the applicant when he files the divisional what is called here the further application will now remove all the claims pertaining to invention b and put it in his further application. But the disclosure made in the provisional or the complete which was filed earlier will remain the same. So, it is a divisional is a process of separating the claims, because they pertain to more than one invention.

16 2 states are the further application under subsection one shall be accompanied by a complete specification, but such complete specification shall not include any matter not in substance disclose in the complete specification filed in pursuance of the first mentioned application. Now when you make a divisional the divisional shall have a complete specification, it is not just a case of filing near claims it should have a complete specification, but the complete specification shall not include any matter not in substance disclosed in the complete specification filed earlier, which means the disclosure is going to be the same. If you file a divisional based on an earlier filed application you are going to move the claims which pertain to the second invention what we call invention b, but the disclosure is going to be the same you cannot include a matter not in substance disclosed in the earlier specification, this is the wording in 16 2.

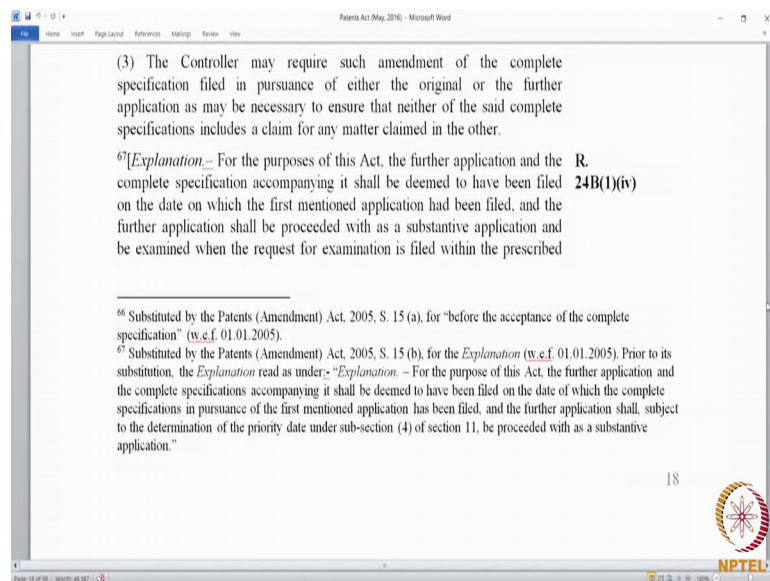
So, the disclosure is going to be the same the claims are will look different the disclosure will be the same the claims will look different. If you compare a first mentioned application wherever the language first mentioned application is used, we call the parent or the first application and wherever the further application is mentioned in this section we call it the divisional or the child.

So, this is a parent and a child and a child is created from the parent, the claims of the child and the parent will not match because that was the objective of filing a divisional there is all the claims that pertain to the second invention has to be removed, but the

disclosure will be the same, because you cannot add while filing a divisional, you cannot add any new substance because the divisional will take the priority from the parent, the child will take the priority from the parent for that reason you cannot add you matter into the divisional.

16 3 the controller may require such amendment to the complete specification file in pursuance of either the original or the further application as may be necessary to ensure that neither of the set complete specification includes a claim of any matter claimed in the other. So, the controller can ensure that the claims do not match. 13 simply states that the claims in the parents and the claims in the child will be different. The claims in it to refuse it in using the language of the act the claims in the first mentioned application and the claims made in the further application will be different. So, 16 3 allows the controller to make amendments to ensure that, what is claimed one is not claimed in the other.

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Explanation to 16 three states that for the purposes of this act the further application and the complete specification of accompanying it shall be deemed to have been filed on the date on which the first mentioned application has been filed which is what I meant the child will take the priority from the parent and the further application shall be proceeded with as a substantive application and we examined when the request for examination is filed within the prescribe period.

A we saw instances in which a request for examination for a divisional has to be accompanied by a request for publication, for the simple fact that examination of the child can be clubbed with the examination of the parent. We saw this in 24 b sub rule two roman one we saw that when there is a parents that is being currently examined if a divisional is filed, then the divisional should be accompanied by a request for examination, this is to expedite the examination so that the examiner who's looking at the parent can also examine the divisional.

So, divisional are treated as a substantive application, substantive application. In the sense that they are numbered differently they are treated as a separate application they have a complete specification and it is treated as a substantive application, but it will take the priority from its parent.