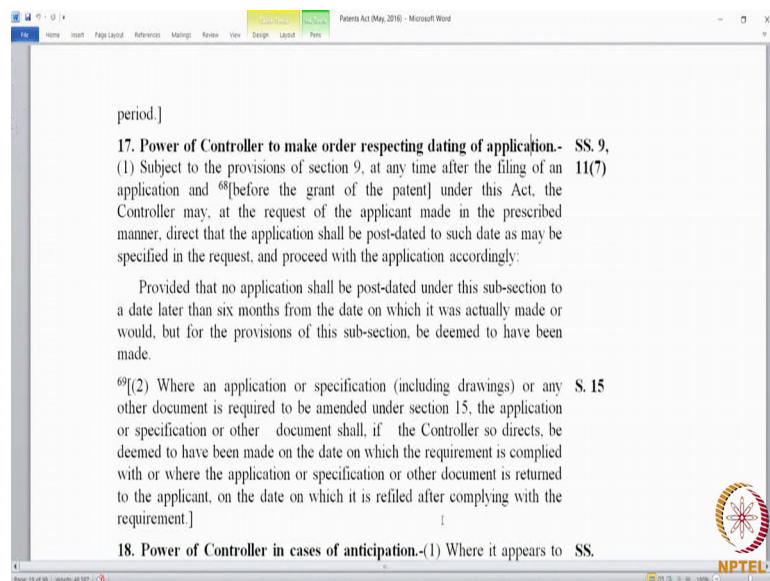


Patent Law for Engineers and Scientists
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Lecture - 35
Patent Prosecution: Powers of Controller
Dating of Application and Anticipating

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Section 17, power of controller to make order respecting dating of application. We have already seen with regard to an application they can be two types of dating, they be post dating where an earlier date is given up for a later date or it could be anti dating where a later application gets the priority of an earlier filed application. The easiest example for anti dating is when a divisional is filed the divisional gets the date priority date of the parent, it is a clear cut case of divisional getting the date of the parent this is an anti dating. Anti dating in the sense that the later filed application gets the priority of an earlier because the discloser is the same.

Post dating when you file a provisional and you withdraw the provisional for whatever reason, you file a provisional you withdraw the provisional and you file a complaint. So, the complaint does not get the priority of the provisional because of the provisional is withdrawn in that case the earlier date is given up and the invention gets the date of complete. So, it gets post dated.

The idea of filing a provisional was to preserve priority, but now if you withdraw it then there is no point in claiming that priority because you have withdrawn the application it is not there in the system. So, see these are the two cases where the date of priority can either be ante-dated or it can be post-dated. Ante-dated we understand it as divisional application post-dated one instance of post-dating is where a provisional is filed and the priority is given up, it is withdrawn. The provisional is withdrawn, so the only priority will be the priority from the date of filing the complaint. Now there are some powers the controller has with respect to dating.

Now 17 - 1 states that subject to provision of section 9 and section 9 talks about post-dating section 9 specifically refers to the post-dating at any time after filing of an application and before the grant of the patent under this act the controller may at the request of the applicant made in the prescribed manner direct the application that the application shall be post-dated to such date as may be specified in the request and proceed with the application accordingly.

So, if a request is made by the applicant saying that I do not want my earlier priority I want the priority from later part it is called post-dating. It is done voluntarily for whatever reason the discloser may not have been perfect for whatever reason or it is difficult for the applicant to show facts, it is difficult for the applicant to show because if the discloser was not good for whatever reason or they do not want any disclosure they made in the provisional to be later published whatever be the reason the applicant and there is a risk in post-dating, the risk is from that time till it is post-dated if there is going to be any intervening prior art that can affect the novelty. That is a risk, it there is always a risk in post-dating because you are shifting the point of priority from an earlier date to a later date. So, there is always a risk accompanied by that and risk may be there it may not be there the risk could be in the way of an intervening prior art.

So, under 9, if an applicant makes a request in the prescribed manner it shall be post-dated and the date once it is post-dated for all practical purposes that date of priority will be from that date. Date of priority will be that date, date of filing the application if it is date of filing the application we already mentioned if you file for the first time if you file a complete then the date of filing the application as the priority, then we do not use the word priority we just say date of filing because that is the time at which it starts. So, it is an easier terminology date filing there was nothing filed before, so we say date filing.

But if you file a provisional and then follow it up with the complaint we do not use the word data filing because the data filing may mean two things then we use the word priority date. So, the priority language comes in if you saw the priority rules and section 11, priority language comes in when there is an earlier discloser and later claim. So, if the claim and the discloser are in one go we refer to the data of filing.

And in international applications you cannot file an international based on provisional we saw that it is a requirement that you file the complete. So, in all that do you will find the language date of filing, date of filing is the date of patent date of filing, so date of filing because this it comes in one go. Now there was a (Refer Time: 05:28) to 17 - 1 provided that no application shall be post dated under the subsection to a date later than 6 months from the date on which it actually made or would, but for the provisions of the subsection we deem to have been made.

Now the post dating cannot happen for more than 6 months. So, if you plan to post dated there is a time line. If you file an earlier application and if you want to post dated the post dating has to happen in the context of section 9. So, you remember post dating can be in the contest of section 9; it could also be on section 9. In the context of section 9 section 9 - 4 talks about post dating.

Where a complete specifications has been filed in pursuance of an application for a patent accompanied by a provisional specification that is a provisional followed by a complete or a specification treated by virtue of direction under a subsection under 3 that is the (Refer Time: 06:38) complete we had already dealt with that. As a provisional the controller may if the applicant, so request post dating is always another requesting of the control under section 9 the post dating is done at the request of the applicant at any time. So, request at any time before a grant of a patent cancel the provisional and posted the application to the data filling of the complaint

Now this canceling or this request for postdating has to happen within 6 months of filing. So, 17 we get that that the post dating under the subsection to a date later than 6 month from the date shall not be allowed. So, the post dating can only happen within 6 month, we need not look at what is a logic of 6 month period we can just say that the post dating would we can assume that if the post dating is allowed for a period for many years one it cannot be allowed be on 12 months because the provisional has to be followed by a

complete within 12 month. We can understand that 6 month may be a period with in which they may not be substantial intervention by prior art that is one understanding I mean that is one assumption we can make, 6 months period is given, so that in any field it may not be any intervening prior art, but in some cases they can be, but we can understand time line to say that the post dating has to be happen within 6 month from the date of making the application.

17 – 2, states that where an application or specification including drawings or any other document is required to be amended under section 15. The application specification or other document shall is the controller. So, direct we deem to have been made on the date on which the requirement is complied with or way the application specification or document is return to the applicant on the rate on which it is re filed after complying with the requirement. Now this is not in the context of provisionals, rather this is after a complete specification is filed because section 15 comes into play only after complete specification as filed.

Now in section 15 as you know section 15 comes into play when the controller is unhappy with an application, he finds that there are reasons to reject and he asks the applicant to make certain amendments. The applicant makes certain amendment and refiles it, and assumes that the invention is disclosed earlier, but based on the objections and another part of the invention is for the first time included based on the controllers objections, so that part what was included based on the controllers objections that discloser happens for the first time.

You cannot now claim an earlier priority on that. So, that discloser when you put in to the patent office it will get the priority date from their own. So, in a sense there is a post date is here because whenever files were an amendment based on an objection from the controller and you introduced a new matter, when you introduced a new matter then your priority is going to change from there for instance there are 10 claims filed in an application. The controller rises certain objections and all the claims have now to be the controller is no willing to allow even one claimant. So, based on the objections in a section 15 proceeding the applicant drafts a new set of claims completely different from the ten which he had filed and he also makes appropriate amendments in the discloser.

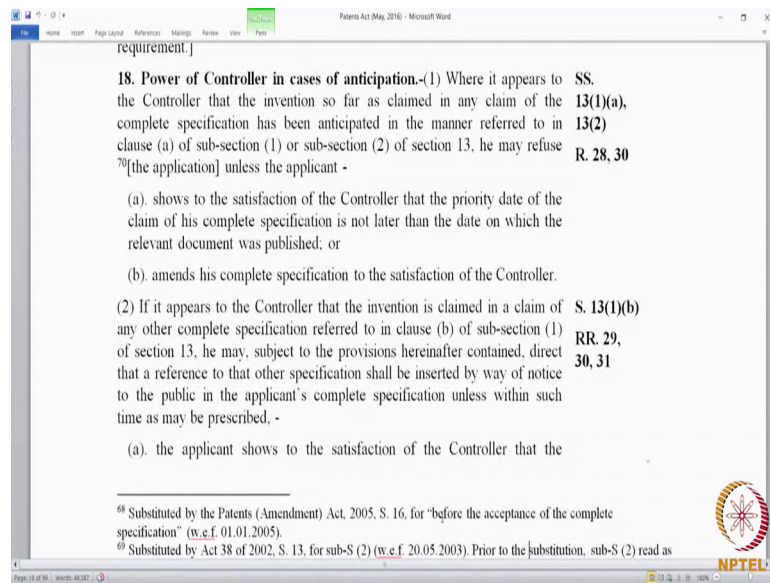
Now, all these new claims will take a date different from the claims that were filed in the first instance because these claims were not there. So, the dating of this claim will be different from the date of the claims that were initially filed because of all those claims were rejected by the controller. So, the claims that were file later will take the date on which it was filed that is what the language says (Refer Time: 11:17) deem to have been filed on the date on which is the requirement is complied with.

The controller feels that 10 claims cannot be granted the ten claims have to be amended say they were amended. So, it will be deem to have been made on the date on which the amendments were made if compliance was through amendment or if document are return to the applicant. If the controller returns the document to the applicant on the date on which it was refilled after complaining with the requirement.

Say form one was not completed form one that information was deficient and it was given back to the applicant the applicant fills those applications and files it back then the date of filing is the date on which he complied with a requirement, it will not be a date on which he initially filed. So, any complaints that happens, so ideally 17 - 2 tells us that whatever you do in the patent office it has to be perfect for you to get the priority. If it is not in order and if you have to make amendments then things can get post dated. So, post dating of documents is there and post dating of priority date is there, in 17 - 1 we saw the priority being post dated based on a provisional.

Here we 17 - 2 is on post dating it includes specification document drawing post dating documents.

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Section 18 powers of a controller in case cases of anticipation we saw that under section 12 and 13 the controller can direct the applications to be examine by an examiner and under section 12 it is stated that the examiner shall make a report on various things and one of the that thing that the examiner will make a report will include the results of investigations made under section 13.

And we saw in section 13 the examiner can make a report on anticipation by previous publication or by priority and we saw the instance in which the report can cover cases of anticipation and when we talk about anticipation we are only talking about the first requirement in patentability which is novelty. So, when we say something is anticipated then we mean that it lacks novelty, novelty is not that the fact that the invention has to be new is not satisfied.

So, in section 13 the examiner can look at any previous patent, any patent that is granted earlier and which would mean any claim that is granted earlier. So, prior claiming is covered in section 13, section 13 also covers prior publications. So, in section 13 there are two kinds of document you can look at one is an earlier filed patent application or a earlier file specification which will have a claim. So, when there is a claim that overlaps with the present claim we call it prior claiming, the claim was already claimed in another application. If your mapping the invention with any other discloser like a discloser

in a scientific journal or in a text book or in a review article then we call that prior publication.

So, prior claiming is where the invention is claimed in another patent specification so that you can match one claim with another where as prior publications is you do not actually map a claim with in another claim because that discloser may be in a other document it can may be in a text book it may be in a scientific review it came it may be in a journal article. So, so when that happens we call it prior publication. So, 13 covers both these instances it includes prior claiming and prior publication. Publication we understand as a non patent document, in prior art search we do a non patent search non patent literature where as patent literature or patent search is what covers prior claiming.

Now 18 tells us that 18 - 1 states that where it appears to the controller that the invention. So, far as claimed in any claim of a complete specification or this language often repeats itself in various parts of the act, invention so far has claimed in any claim of complete specification we just means what is claimed it just we are talking about the claim. Some objection may come on to the descriptive part for instance objections under section 10 may come to the descriptive part, the description is does not the claims are not fairly based on description, but wherever you see this language invention so far as claimed in any claim of a complete specification we are just talking about the claims it just means claim. So, where the claim as been anticipated, you can you substitute that entire statement, inventions so far as claimed in any claim of a complete specification with the word claim.

Where a claim or what is claim has been anticipated in a manner refer to in clause a of subsection 1 or subsection 2 of 13 he may refuse the application, Now in 13 - 1 and 2 we saw that 13 - 1 talks about documents that are in the nature of a complete specification and 13 - 2 talks about any other document in document other than those mentioned in subsection 1. So, we mention this there are two categories of documents in section 13; 13 - 1 talks about complete specifications where you can do a claim to a claim mapping and 13 - 2 talks about any other document which could mean scientific journals and other kind of non patent literature.

So, 13 - 1 talks about patent literature, 13 - 2 talks about non patent literature and now 18 says if a claim is anticipated then the controller may refuse the application. So, very clear

cut say it if the controller finds that the claim is anticipated either by an earlier application or by some non patent literature he may refuse it.

Unless the applicant there are two things the applicant can do when the controller raises an objection the applicant can do two things one he shows to the satisfaction of the controller that the priority date of the claim of his complete specification is not later than the date on which the relevant document was published to show that his priority is on the same date or before. If it is a same day also the controller will allow or it is the before the date of that prior art document because anything that is published after my application cannot be used as a priority document to challenge my application it cannot be used as a prior art document. The second thing he amends his complete specification to the satisfaction of the controller.

Now, a and b largely gives the option that are opened to an applicant the applicants first option is always to convince the controller. Only if then controller is not convinced will you want to amend the application no applicant would want to amended at the first instance, he would try to convince a controller to say that how does that convincing comes because here it says shows to the satisfaction of the controller now this involves claim interpretation.

One the applicant can say that the scope of the document which you have sighted as prior art it has to be interpreted this way if it is interpreted this way my invention will not fall within this scope of way one way to do that. Second if you have a priority document earlier to the date of prior art then you can say that say for instance you are exhibited your invention in an exhibition in a technical exhibition there are rules.

There are provisions in patent act which allows you even after public display file an application within 1 year. But that information of your public display and that fact that after public display you file an application within one year is not there to the controller the controller just merely sights a prior art. But if you are able to show that before that you had actually disclosed in a public display or you had disclose something what we called transactions of learner society there are various protected categories of anticipation then you are able to convince the controller that that discloser was actually a protected discloser and because it is was a protected discloser you are entitle to claim

priority from that day onwards because you made a disclosure which was a protected disclosure and you are able to follow it up with an application.

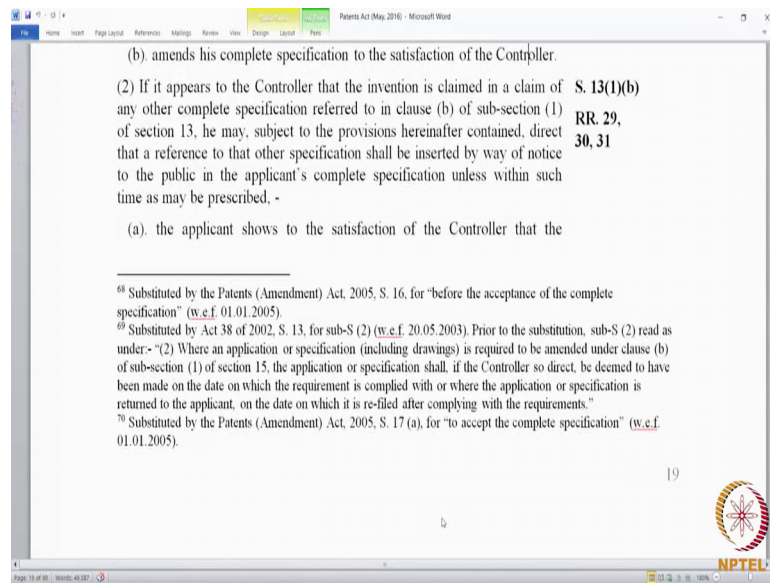
So, all or you made an application abroad, based on a priority document filed abroad and you are claiming your priority from there in all these cases if you can show to the controller to the satisfaction that the application that is filed is actually not hit by the prior art either by a matter pertaining to the claim and saying that this what is claimed is different from what I am claiming or by showing that you have a valid reason for being before the date of prior art. So, either way either by interpretation or by showing that your specification is not later than the date on which the relevant document was published.

So, under 18 - 1 a, the applicant's hand over will be to show that the priority date of the application is earlier than the prior art. Now assume that the applicant is not able to demonstrate there is a prior art much ahead in time and the applicant is not able to show that his priority. If he did not know about it he found that application was anticipated by an earlier prior art much ahead in time then the option open to him is he can amend his specification to tear clear of the prior if the technology covering the patent allows him to make an amendment and if the prior art also allows him to do that then he may amend his specification to the satisfaction of the controller that many a times people just narrow down the scope of the invention in order to get a grant.

There may be difficulties in enforcing that patent, but never the less the patent officer's concern is there was a prior art we cannot grant you if you narrow down the scope of your invention we may be able to grant and they may get a patent granted just for that narrow claim. So, that is a second response.

If you are not able to demonstrate to the controller that your priority date is before date of the prior art the next option is to amend your specification. So, a and b under 18, one tells you the two responses to anticipation. The two responses to anticipation is one to show to the controller to satisfy the controller that the priority date is not later than the date on which the relevant document was published if that is not possible then you try to amend the specification to the satisfaction of the controller. So, these are only two ways in which you can get over an objection of anticipation.

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Now, 18 - 2 if it appears to the controller that the invention is claimed in a claim of a complete specification refer to in clause b of subsection one of 13 he may subject to provisions here and after contain direct reference to that other specification shall be inserted by way of notice to the public in the applicants complete specification unless with in such time period as prescribed the applicant may do either of the two things, he shows to the satisfaction or he amends the same thing he amends the specification.

Now, here this provision date pack to 13 - 1 b, now 13 - 1 b is where a claim is anticipated by an application for a patent made in India and dated before the priority date. So, if there is an application made before the priority date and the application anticipates the present application, then the controller has an option of directing a reference to be made to the other specification this is called a reference and the reference only operates where there is a pending application.

Because in 13 - 1 b we know then it is a case where the anticipating claim is in a complete specification that was published on or after the date of filing the complete specification applicant specification being as specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority earlier than that day. So, though it was published on or after the date of filing it is priority was before the applicants' priority of the applicant's application.

So, we understand that in this case it was not a document that was already there the day I filed it was not there, but it was published either on the date I filed my application or soon after I filed my application. So, there is no way I could have known about that application at all because the day I filed it, it got published by most of the time I would have taken the time printout or (Refer Time: 26:35) of e filing I would not make a prior art sage on the day on which I am filing, my prior art such everything done earlier. The day on which I filed a soon after I filed it gets published, but it was pending all the while, but it is reference was to an earlier date, the priority was to an earlier date that mien.

So, there is no way me as an applicant could have checked or could have known about that prior art because it got published the day I filed or soon after I filed in such cases the controller way may allow for reference because this is not the fault of the applicant he did not know about this. So, the idea of a reference is that to give notice to the public that the earlier application which the applicant did not know about any file covers or anticipates it is a reference, but the reference can be damaging because then the earlier person can come and sue for infringement and say that you have filed a similar invention as mine so any other issues can come.

But an applicant can again get over that reference if he shows to the again two conditions shows to the satisfaction of the controller that the priority date is earlier or he amends to the satisfaction of the controller the same two options are there, but here the only differences the day on which the applicant file the application he did not know about the earlier prior art. It was published on that day or after his filing, in such cases the controller can insert a reference, but the reference, but the reference can be avoided if the applicant show to the satisfaction of the controller that the priority is earlier or the applicant amends the complete specification.

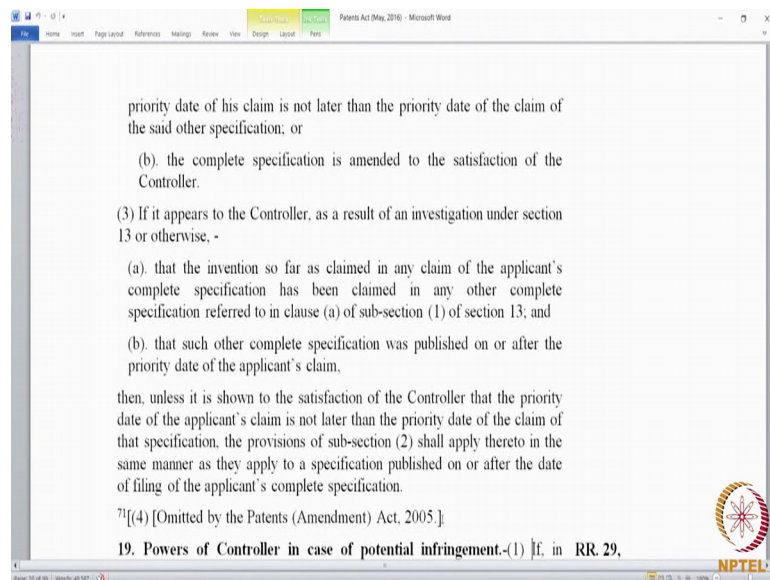
So, when he amends a complete specification again the references avoided because if the scope of the prior art is covering certain things the amendment if it gets over that objection there is no need for a reference. So, there is a power for the controller to insert a reference and it comes under section 13 - 1 b and the power is confine to cases where an application got published on day in which I filed my application or soon afterwards.

So, it only covers situations where the applicant could not have seen that prior art because the day on which he filed it got published or after he filed it got published. So,

this is what we called prior art that was about to be published or prior art that was in the dormant mode, the prior art is already there priority was also here, but it does not be dormant mode we know that there is a dormant mode 18 month period where the things not be published during that time they could be prior art that props up which nobody can search.

And there is a danger in patent law because that whatever is filed and not published for 18 months can still be prior art that effects you and there is no way you can know the controller can had a reference if he comes to know because it was not done to applicant, and if you want to avoid the reference you can demonstrate to the controller that your priority is much earlier or you can carry out an amendment.

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18 - 3 if it appears to the controller as a result of investigation under section 13 or otherwise that the invention so far has claim that is the claim has been claimed in any other complete specification refer to in clause a of 13 - 1 or such other complete specification was published on or after the priority date of the applicants claimed. Then unless it is shown to the satisfaction of the controller there the priority date of the applicant claim is not later than the priority date of the claim of the that specification the provisions of section 2 shall apply in the same manner as the applied to the provisions published on or after the date of filing after applicants complete specification. They just says what apply to 13 - 1 b can also apply to cases where 13 - 1 a is also mentioned.

So, situation is similar that if something does been claimed is covered by a complete specification mentioned in 13 - 1 a and 13 - 1 a we saw that 13 - 1 a is all the application that were filed in the old regime that was in the 1911 regime because in 1911 act came into effect on the first of January 1912. So, any application that was published before the date of filing of the applicant's complete specification in any specification filed in pursuance of an specification for a patent made in India and dated on or after the first date of January 1912 which means all the applications made under the 1911 act could also anticipate.

Now if it appears to the controller that the result of an investigation that an application made under the 1911 act anticipates invention or such other complete specification was published on or after the priority date of the applicants claimed this is may not happen at all because an applicant ion that is filed and understand that this provision came in to effect in 1970.

It came the act was passed in 1970 and it came into effect in 1972. So, all the application that were filed before this provision came into effect say in 1969 if an application was filed it was filed under the 1911 act. So, applications, so this covers the transaction period application that is filed in 1969 because the act came into act was passed in 1970 came into effect in 1972 if the complete specification was published on or after the priority date of the applicants claim.

So, similarly just how we saw they could be applications that are filed or that get published after you filed similarly they could be applications that are published after you filed a application or after your priority date, but this is under the 1911 act in 1972 act the new act came into effect and you file your application in 1972 claiming priority on the date of you are filing.

They could be application filed under the 1911 act which are still pending, but which get published on or after your priority date same rule applies the controller can insert a reference just how it is happens in the patent office today for the 18 month period this is the just the regime under the 1911 act because 1911 act was replaced by the 1972 act, it is the same principle is the same. They, but it was in under two different acts when we talk about the 18 month period it is under the same act correct 1917 act is an 18 month

period I file an application on the day I file the application the other persons application is published.

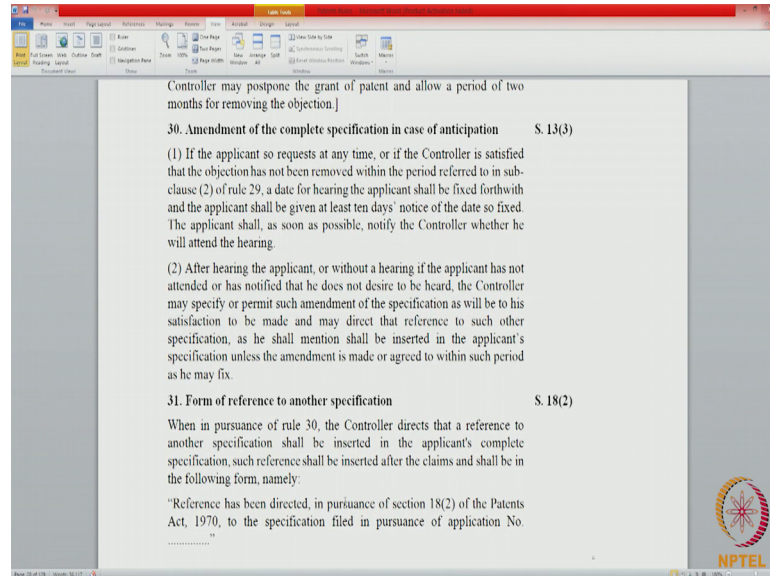
Here it is under two different acts try to understand that is only difference the two different acts are the 1917 act and the 1911 act. So, if you file an application under the 1970 act the and there was a pending application under the 1911 act which got published on or after the priority date of your application have you able to understand this. Though it was filed under the earlier act it is published after the date of your priority out of the date on which you file, let us assume that your priority date on which you have filed. In such cases again the controller can insert a reference. So, in the earlier provisions reference was for a case were something was lying dormant in the 18 month period here the references for something filed under in a different act because 1911 act was replaced by the 1970 act.

So, if you file an application under 1970 act and there is an application filed under the 1911 act say 1969 and 1968 which as still laying dormant, after your priority date it gets published the controller can ask for a reference of to that act. So, the earlier provision under 18 - 2 the cross reference, if someone ask you this question what does the reference between the reference made under 18 - 2 and 18 - 3 both talk about reference to be made by the controller. The difference is that the reference under 18 - 2 is to the same act application filed under the same act where as the reference under 18 - 3 is to an application filed under earlier act this is an 1911 act and we get all these information if you look at 162 if you look at the last section in the patents act repeal of act 2 of 1911. So, the earlier act the Indian patent and design act is here by repealed. So, this act came to replace that act.

So, the question arises one day before this act came into effect applications were filed under that act. So, that is why when you see this is not clear, if you see the provision of section one they just say that all applications that were filed on or after the first day of January 1912 that is all it says it does not say the Indian patents act patents and designed act 1911, but we understand because we know the scheme of things that the Indian patents and designs act 1911 came in to effect on Jan 1912 we understand that. So, the difference between 18 - 2 and 18 - 3 is that 18 - 2 refers to instances were under the same act were within the domain period were the applications are unpublished if you file an application the day on which you file an application prior art is published controller can

ask for a reference. In 18 - 3 the day on which you claim your priority the prior art is published, but the prior art is the under the 1911 act this is only difference.

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Rule 31 tells us in what form that reference can be made. Rule 31, form of reference to another specification when in pursuance of rule 30 the controller directs that a reference to another specification shall be inserted in the applicants' complete specification such reference shall be inserted after the claims and shall be in the following form. Now a question can be asked under section 18 if the controller makes a reference where will you find it in this specification; the reference has to be made after the claims.

So, where is the position controllers reference under section will be, it will be after the claims and what is the form of reference form of a reference is this. Reference has been directed in pursuance of section 18 - 2 of the patents act 1972, the specification filed in pursuance of application number so and so. So then that number is given here.