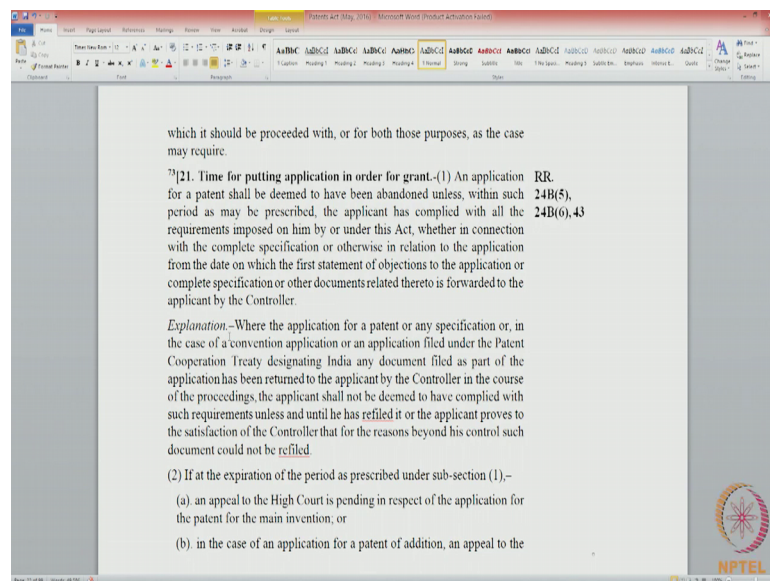


Patent Law for Engineers and Scientists
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Lecture - 38
Patent Prosecution: Powers of Controller
Putting Applications in Order for Grant

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Section 21: time for putting application in order for grant. Section 21 is important because the patents act and the rules are structured upon various time lines, almost for everything that needs to be done under the act, and the rules there is a time frame within which the applicant will have to do it and the burden of doing the act constantly shifts upon the applicant.

There are time frames for the patent office to do certain things, but those time frames may be if there is a delay in doing certain things from the patents act, it does not affect the application. In other words if there is a delay by the controller in allocating the file to the examiner, it does not affect the application that delay there may be a delay in the grant of the patent eventually, but it does not affect the patent application in a manner it will not affect the interest of the applicant, but if there is a delay on the part of the applicant in responding to the first examination report or the first statement of objection, that delay can actually lead to the patent being treated as abandoned.

So, 21 is the provision which applies for almost every part of the patent prosecution process, where the applicant is required to do an act within a particular time frame and he fails to do the act then the patent office can deem or can assume that the patent has been abandoned. So, it is a fiction created under section 21, if the applicant does not comply with any of the gridlines the applicants can be rejected and the ground of rejection is because you did not respond within the time, we will treat it as though you have abandoned. So, deem to have been abandoned means the patent office assuming that the application has been abandoned because the applicant did not respond within the specified time.

21 1 the application for a patent shall be deemed to have been abandoned this gives the power it gives it is a fiction it gives the power to deem that an application has been abandoned within such period as may be prescribed, again wherever we see a period as may be prescribed we will have to see what is the time given for that. The application unless the application is complied with all the requires requirements imposed on him or under this act.

So, this simply says that if the applicant does not comply with the requirements imposed him by the controller, or the requirements imposed on him by the act. If he does not comply with the requirements then it will be within a time period that is the second clause within such period as may be prescribed within that time period if the applicant does not comply with the requirements the application is deemed to be abandoned.

So, application is deemed to have been abandoned there is a period and the applicant has to comply with all the requirements imposed on him under the act. Now what are these kinds of requirements?

The requirements can be the clause continues, whether in connection with the complete specification or otherwise in relation to the application from the date on which the first statement of objection to the application or the complete specification or other documents related thereto is forwarded to the applicant by the controller. Again very critical thing to note section 21 is a tool or a power for the app for the controller to reject patent applications, if they need not be when an order that is the interesting part of the provision the controller need not even given order. The fact that you can just

communicate to the applicant that you did not reply on time or you not do an act on time I am treating is at deemed as abandoned.

The important thing to consider here is section 21 starts operating only after the first statement of objections is communicated to the controller. So, you can if I ask you a question the applicant refuses to take a request for examination within the stipulated period we know that 48 month period, then what is the consequent that follows? A under 11 b 4 it is deemed to be abandoned under section 21 it is deemed to be abandoned under section 9 1 now in 11 b 4 they do not use the word deemed to be abandoned the words used is treated as withdrawn by applicant. So, I can give all these options and I can ask; what is the consequence.

So, 11 b 4 comes in before the first statement of objection is file. So, the 11 b 4 treated as withdrawn. So, this is a distinction between the phrase treated as withdrawn by the applicant under 11 b 4, that stage is before the statement of objection is issued. Once a statement of objection is issued or the (Refer Time: 06:22) as they used to called it before once a first statement of objection is issued any inaction by the applicant the applicant does not respond on time, applicant does not carry out the corrections, applicant does not comply with certain requirement the controller going to treated as an abandonment under 21 why so the abandonment under 21 starts after the FERS issued not before that.

So, this is the important to understand. So, if a patent is filed as a provisional specification, and it is not followed by a complete specification within 12 months it is treated as abandoned, but under 9 1, not its we do not call it as section 21 abandonment (Refer Time: 07:13). So, section 21 abandonment will come in only in cases where the f e r has been issued or the statement of first statement of objections has been issued.

Which tells us that there are two kinds of abandonment, there is an abandonment which you do before the patents office works on your application, they have not done any work it still in the dormant face 18 months unpublished face, you can withdraw it will even get a portion of your fees back. It crosses the 18 month it is published before the request for ab you do not take a request for examination it is treated as withdrawn still the patent office has not done any work, but when the patent office issues a first statement of objection it is first statement of objection is issued after in examiners report followed by the controllers communication.

So, the first statement of objection is communicated by the controller. So, there is an examination report the controller has considered it and then issued the first statement of objection anything that happens after that is treated as 21 under 21, we need to understand this well because they need not be an order written order under 21 its not require. The one of the consequences of not having a written order under section 21 is that, there are appeal provisions under the patents act 117 a appeals to the appellate board clause to list a whole lot of provisions based on which you can file an appeal to the appellate board.

When the patent office treats an application as deemed to be abandoned under 21 is not appealable to the appellate code, you cannot file an appeal there is a policy reason for that, why is that you cannot file an appeal because the patent office when it exercises its discretion we use this word before, it has to hear the party and discretion is where it can apply its mind one way or the other.

Then we have an appeal remedy, because the patent office applied its mind in one way the applicant can say no I wanted the patent office to apply its mind the other way there is a cost for appeal and IPAB is their intellectual property appellate board is there you could take the matter and appeal where the controller does not exercise discretion it is an automatic process there is an first statement of objection file there is a time period within which you respond you do not respond. So, it is a procedural thing there is no discretion by the controller.

So, that is the reason there is no order required here, it is an systemic thing its an automatic thing you are given two months to respond to an objection on prior claiming, you saw the two months period within which you had to correct it, you do not reply back the controller cannot be keep sending you and the controller finds that, because you did not reply back there not be an order the controller can say that it comes under the language of 21. You were required to do something and you did not do within that period, the applicant did not comply with the all the requirements imposed under him imposed on him or under this act.

So, we saw that the two month time period that is imposed for correcting an objection on prior publication, which is imposed by the controller it is a condition imposed under the act. So, if he does not comply with that then there is a period then the act will deem that

the application has been abandoned this is deeming provision it will assume it will treat the application has abandoned without any order from the controller because there is no discretion we do not require an order and because there is no discretion, this provision cannot be appealed.

So, the only way is to comply with the timeline, but if you had a genuine reason you asked your agent to do something, the agent could not do it or there was a calamity in the town say there were floods in the town and everything was you could not comply with the time, then you can write to the controller to say that this could not be done because of these reasons it was beyond my control and it is open to the controller to consider that.

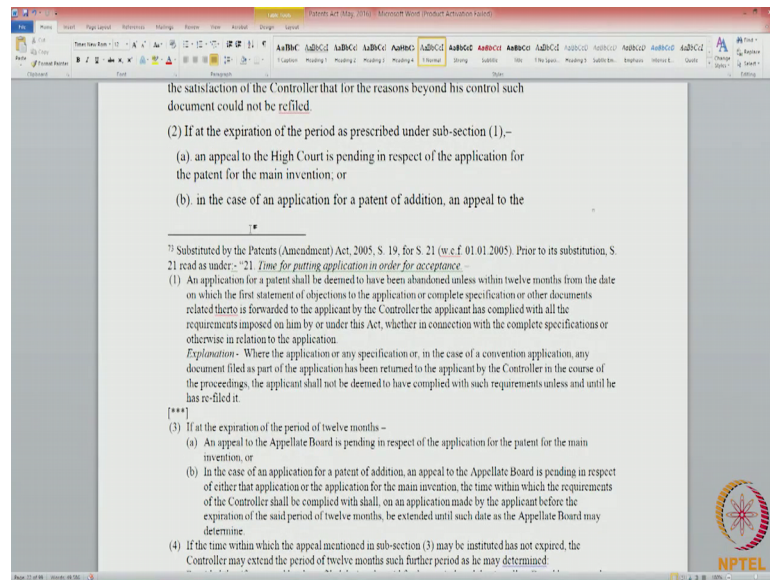
But normal cases you are expected to do it within that particular time. So, section 21 comes into operation after the issuance of the first treatment of objections, and it applies to any requirement. So, the language used in 21 1 is all the requirements imposed on the applicant all the requirements.

Now, there is an explanation to 21 1 explanation where the application for a patent or any specification or in case of a convention application or an application file on the pct any document file as a part of the application has been returned to the applicant by the controller in the course of the proceeding, the applicant shall not be deemed to have been complied with such requirements unless and until he has refilled it or the applicant proves to the satisfaction of the controller for the reasons beyond its control such documents could not be refilled.

So, when documents are returned this constantly happens in the patent office, the controller will return a document saying you have not complied. So, you have to correct the document and refill it. So, this also includes complying with the requirements within a period also includes refilling of documents. The only case where you will be exempted is where you can proved to the satisfaction of the controller for the reasons beyond its control such document could not be filed, there to be a case where you have assign the matter to a patent agent, the patent agent may either leave this country or he may die or it or he is not contactable or he leaves the profession whatever be the reason, in such cases you have to tell the controller that it was reasons beyond your control, death of a patent agent is a reason beyond the control of the applicant, that it was not done on time.

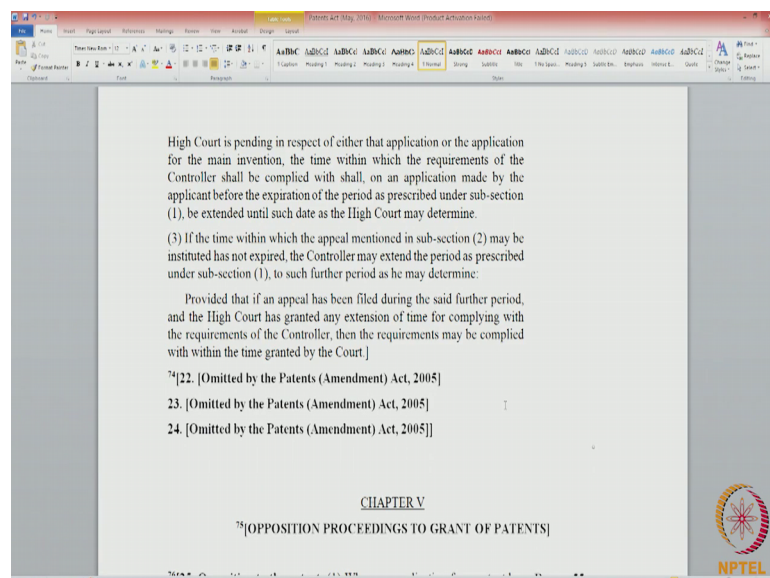
So, explanation says some document is returned then it also applies to re filing of documents, fact that the application has to comply with all the requirements includes re filing of documents within the allocated time 21 2.

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If at the expiration of the period as prescribed in subsection 1, A an appeal to the high court is spending in respect of the application for the patent of the main invention or in case of an application for a patent of addition and appeal to the high court is spending in respect of either the application or the application for the main invention.

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The time within which the requirements for the controller shall be complete shall on an application made by the applicant before the expiration of the period as prescribed under subsection one be extended until such date as the high court may determine.

Now, when you have court proceedings pertaining to the invention, either the invention or a patent of addition which is related to the main invention, then you could get an extension until such date as the high court may determine you can get a this is like a stay on your application your application is pending there and you need to do many things there are section 20 requirements which has to be constantly complied with, but for some reason if you are filed an appeal to the high court you are filed an appeal to the high court now the appeal to the high court made sense before the creation of the IPAB now that the IPAB has been created there is no appeal to the high court under the patents act.

Before the IPAB was created the appeals on matters on which we mentioned under section 117 a 2 use to go to the high court, now all those matters go to the IPAB. So, now, the one way we can understand this is if there is an appeal pending before the IPAB and the IPAB stays the application then it shall be such date as the IPAB made determine.

Now again like any other extension under the act the applicant has to make a request for extension and application made by the applicant before the expiration of the period before the actual period expires, he has to make an application and seek an extension and it shall be extended until such date as the high court may determine. So, if the high court says that the time shall be extended till we dispose this case, then that is proof to say that the timelines need not be complied till the case is disposed off.

21 3 if the time within which the appeal mentioned in subsection two may be instituted has not expired, the controller may extend the period as prescribed under subsection one to such period as he may determine, provided that if an appeal has been filed during the such period and the high court has granted an extension of time for complying with the requirements of the controller then the requirements may be complied with within the time granted by the court.

Now it says that if the time within which the appeal before the high court maybe institute and has not expired, normally there is a time period for filing an appeal. Now you will find that in section 117 a 4 that is why it is very hard to understand section 21 unless you

understand that appeal to the high court was under the old act it should now be appeal to the IPAB ok.

Four every appeal shall be made within 3 months from the date of decision order or direction as maybe of the controller central government or such for that time as the IPAB may in accordance with the rule made by it (Refer Time: 18:26), so within 3 months. So, in 21 3 when we refer to the time within which an appeal mentioned in subsection two maybe instituted has not expired which means the three month period has not expired, the controller may extend the period as prescribed section subsection 1 to such for the period as he may determine.

So, what the controller can extend the time because the time for within that period he needs to do something has not happened or the (Refer Time: 19:00) says if it is pending before the high court the high court can extend the time the professor says if the appeal has been filed during said period the high court has granted an extension of time, then the requirements I will be complete within the time granted by the court. So, 3 the first part says the controller can extend the time second part says if they approach the court and the court has extend the time then it will be that time that is being granted.

Now, all this you need to understand that 21 is very strict in its timelines the only way you can get out of a 21 is you are go to the appellate board it says appeal to the high court, and you get a direction from the appellate board that I need not comply with these time line or a direction that the time will stand extended till I comply with it or the controller himself gives an extension. So, you should either get an extension from the controller sighting certain provisions or you should get a extension from the appellate board the appeal to the high court as mentioned here we understand it as, because there is no appeal from the act to the high court there is no appeal, only way you can do is you can take if there is a section 21 rejection you can take that as a writ petition.

The writ petition that can be you can argue that a writ petition is what is meant as an appeal that is one part of the argument, but we understand this as the way to read this provision will be to say that appeal to the high court also includes writ petitions file to the high court and appeals to the intellectual property appellate board.