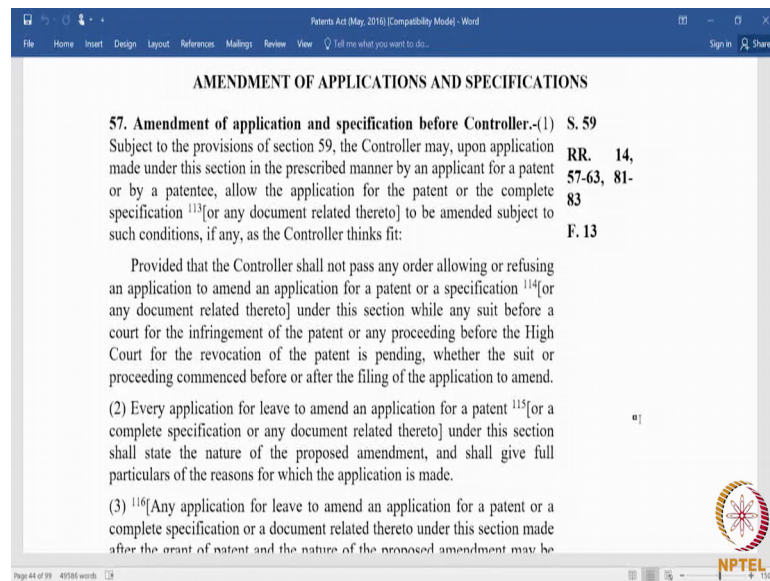


Patent Law for Engineers and Scientists
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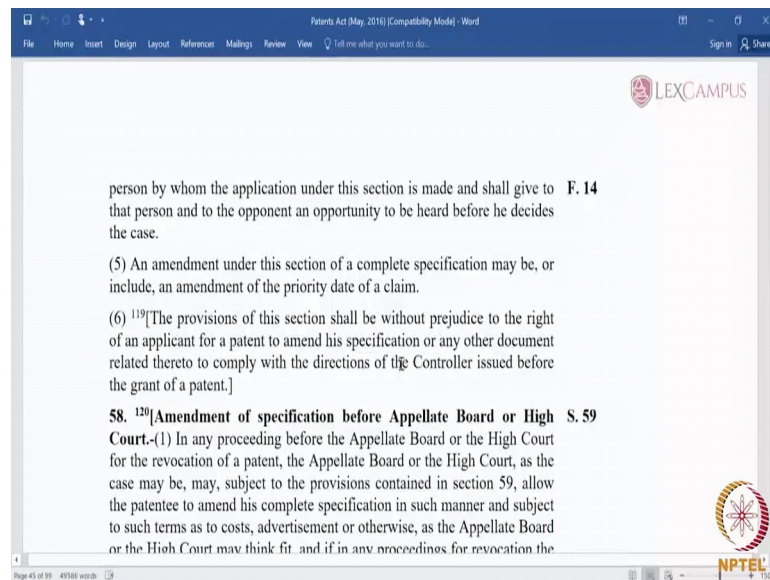
Lecture - 39
Patent Prosecution: Powers of Controller
Amendments during Prosecution

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Amendments during prosecution: chapter 10 of the patents act deals with amendments of application and specification, 57 talks about amendment of an application and specification before the controller generally, what are the kinds of amendments and what is the procedure to be followed.

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57 states in subsection 6, the provision of the section shall be without prejudice to the right of an applicant for a patent to amend this specification or any other document related thereto to comply with the directions of a controller issued before the grant of a patent. So, if the controller issues a direction for amendment before the grant of a patent, which is what we call amendment during prosecution, then it shall be without prejudice to the provisions of 57.

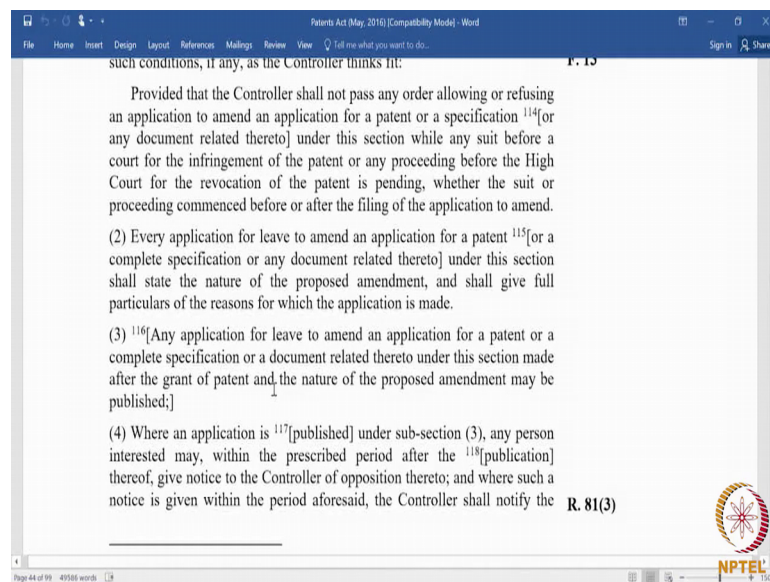
So, you will find under section 15 the controller may ask the applicant to amend the applicant can amend. So, that need not follow the procedure it is without prejudice to the procedure mentioned in section 57, and the controller may ask an amendment in cases of potential infringement, a controller may ask a reference to be made in case of anticipation, in all these cases the amendments that occur are amendments that are conduct or carried out during prosecution and that comes under section 57 6. Those amendments that are carried before the grant of a patent shall be without prejudice to the right of an applicant.

Amendment of application and specifications; section 57 amendment of application and specification before controller, under section 57 when an application is made under this section in a prescribed manner by an applicant for a patent or by a paternity, which means section 57 is applicable for amendments before the grant applicant and amendments after the grant by the paternity, allow the application for the patent or

complete specification or any document. Now these are the three categories of amendments, you can amend the application for a patent the com that is form 1, and a company in documents you can amend a complete specification that is form 2, and you can amend any other document like drawings or any other document that you will file along with your patent applications. To be amended subject to such conditions if any as a controller things fit.

Now, the provisor says that it shall be the controller shall not pass any order allowing or refusing amendment, while a suit is for infringement is pending before a high court so, that is an exception.

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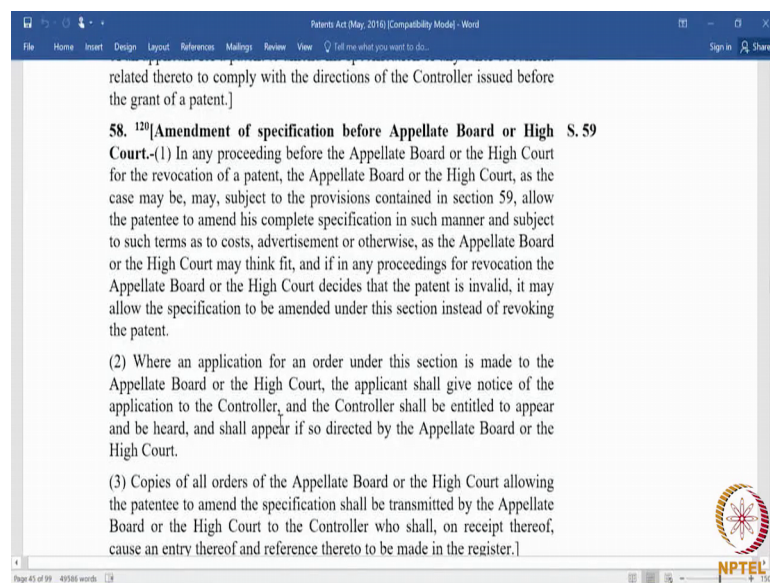
Now every application for leave to amend an application for a patent or a complete specification or any document, under the section shall state the nature of the proposed amendment. So, leave to amend means the permission to amend. So, the procedure requires you to take permission before an amendment, and there you have to mention the nature of the proposed amendment. What is the nature of the proposed amendment and shall give full particulars for the reasons for which the application is made. So, the natures of the proposed amendment and the reasons for the amendment have to be mentioned.

Three; any application for leave to amend which is the permission to amend an application for a patent or a complete specification or a document, made after the grant

of a patent and the nature of the proposed amendment may be published. So, an amendment after the grant needs to be published. Now this is a critical distinction between amendments made before the grant and after the grant. Amendments before the grant are much easier, it can be done before the patent office and those amendments need not be published. But all amendments after the grant require publication and once proposed amendment is published, it could also trigger opposition proceedings you find that in the next subsection. When an application is published under subsection 3, any person interested may give notice to the controller of opposition. So, amendments can also be opposed.

But the amendments that can be opposed are only amendment after the grant. 5 an amendment under the section of a complete specification may be or include an amendment to the priority date of a claim. So, not only can you amend forms form 1 and form 2, the accompanying details of a patent the substantive details of an invention you could also carry an amendment to the priority date of a claim. And we are already seen subsection 6, which says that this provision is without prejudice to the amendments that are carried before the controller in pursuance to the directions issued by the controller before the grant of a patent.

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Now, 58 deal with amendment of specification before the appellate board or the high court; now 58 tells us that if the amendment has to be done before the appellate board or

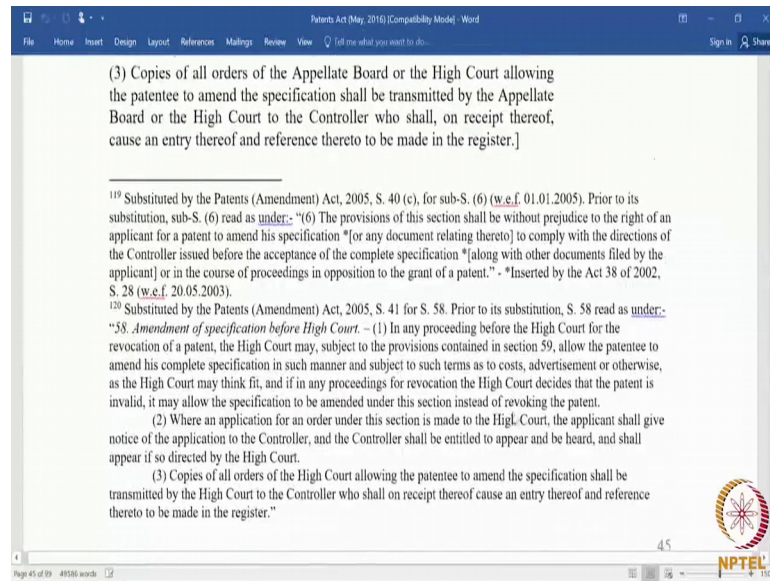
the high court, it already tells us that there is a grant of a patent. So, before the appellate board or before the controller where there are revocation proceedings in any proceeding before the appellate board or high court for the revocation of a patent, now the appellate board proceedings which have come up on appeal now if an application is rejected under section 15, that could be taken up before the appellate board and in the proceeding there could be an amendment to that application.

But in cases of revocation the appellate board also has revocation powers, in case of revocation of a patent the appellate board and the high court will be looking at a granted patent. As the case may be may subject to provisions of subsection of section 59, allow the patentee to amend his complete specification in such manner and subject to such terms as to cost advertise or advertisement or otherwise as appellate board or the high court may think fit. And if any proceedings for revocation the appellate court may decide the patent is invalid it may allow the specification to be amended under the section instead of revoking the patent.

This provision tells us that wherever there is an amendment it has to be advertised and in case court or the appellate board comes to a conclusion that the patent is invalid instead of revoking the patent, if the patentee offers an amendment and if the an amendment can be carried out and if the patent can be allowed, then the appellate board of the high court instead of revoking it would allow the amendment.

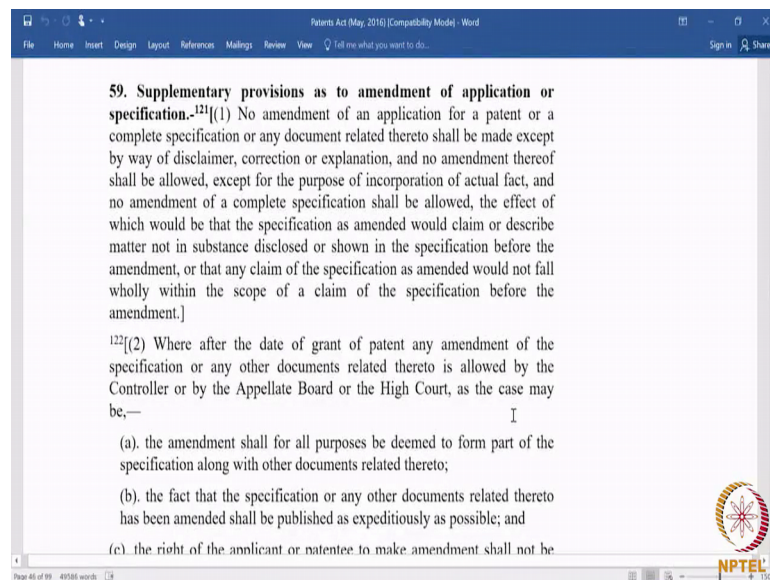
Now, this option is there in section 15 as well as in section 25 4. The controller has the power instead of revoking or refusing an application or revoking a patent, he has the power to amend and maintain the patent. So, similar power is given to the appellate board and the high court.

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Now, the appellate board or the high court shall give notice to the application to the controller, and the copies of all orders shall be passed on transmitted to the controller and the controller shall correct the register.

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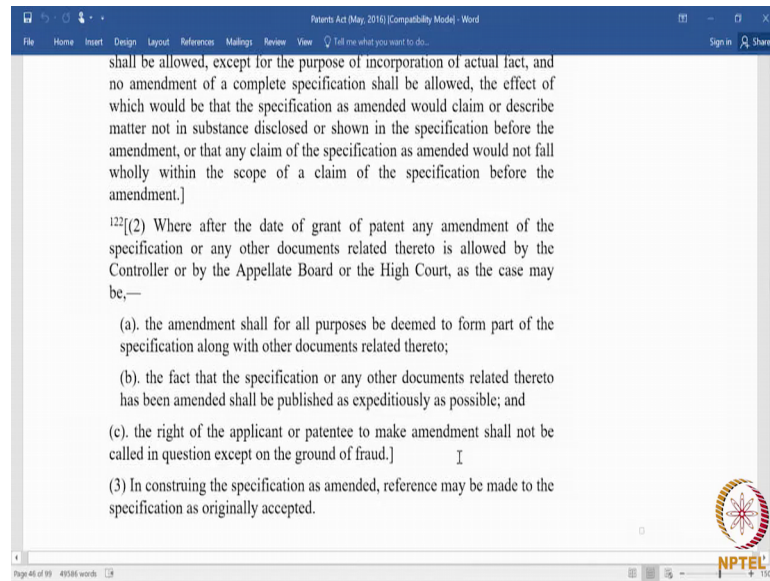
So, if there is some amendment the register needs to be corrected. 59 talks about the scope of amendment, what can be amended and what cannot be amended. 59 supplementary provisions as to amendment of application or specification, amendments can only be made by way of a disclaimer correction or an explanation. So, the kind of

permitted amendments are disclaimer by which you give up something, correction by which you carry out a error which is corrected or explanation something is not clear you explain it. It also says that no amendments shall be allowed except for the purpose of incorporation of an actual fact. So, what you include in an amendment is an actual fact, amendment is only for errors of fact or omissions of fact and further 59 says that no amendment shall be allowed the effect of which would be that specification as amended would claim or describe matter not in substance disclosed or shown in this specification before the amendment.

And that any claim of the specification as amended would not fall wholly within the scope of the claim of the specification before the amendment. This incorporates the principle of fare basis if you amend your specification by amending you should not be claiming or describing matter that was not disclosed in the specification before the amendment. And if you make some change to the claim the claim will still have to be fairly based on what you have disclosed before the amendment. So, you cannot in other words expand the scope of your invention, which brings a principal in patent amendments is that the amendments can only be done to narrow down the scope of an invention you cannot expand the scope of an invention.

Now, what do you need to do if you want to expand the scope of an invention? You simply file a patent of addition or if it warrants you file another patent application. So, if the object is to expand the scope you want to include another modification or you want to include another improvement to an existing invention, then you do not carry an amendment for that what you do is you file a patent of addition.

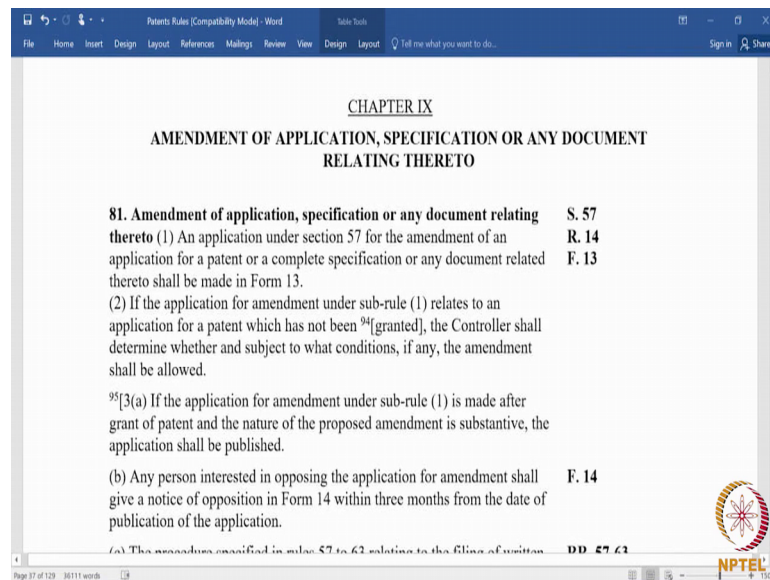
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So, patent of addition in that way is connected to amendment itself. Now subsection 2 says that then after the grant of a patent any amendment is done is allowed by the controller or the appellate board or the high court, the amendment shall deem to form a part of the specification along with other documents, the fact that the other documents relate thereto (Refer Time: 11:26) shall be shall be published there shall be publication the right of the applicant of patentee to make an amendment shall not be called to question except on ground of fraud.

Now, in construing the specification as amended reference shall be made to the specification as originally accepted. So, these are the principles that normally follow an amendment. An amendment cannot be questioned except on ground of fraud. So, fraud vitiates an amendment that is carried to the patent. Section 64 1 o states that as one of the grounds of revocation of a patent that they leave to amend the complete specification under section 57 or section 15 and was obtained by fraud.

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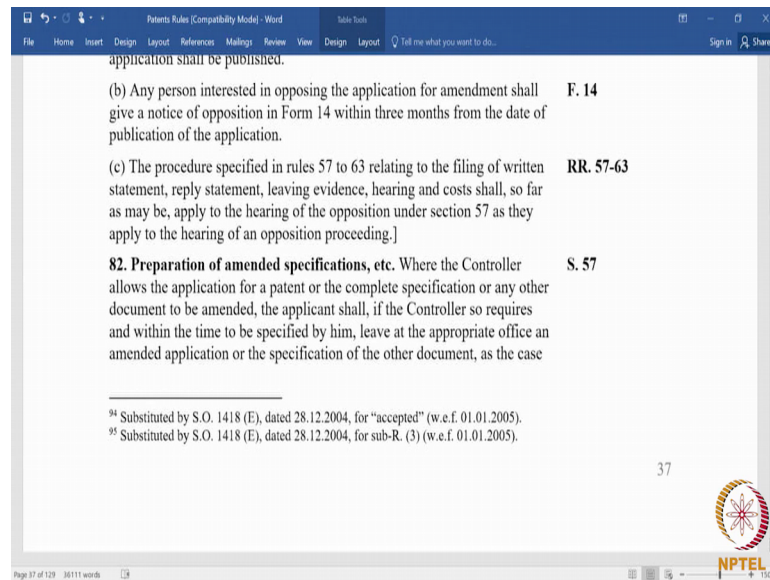


So, if you obtain the leave to amend by fraud that could be a ground for challenge. The relevant rules for amendment of application specification or any other document is contained in rule 81. Rule 81 amendment of application specification or any other document relating thereto. The amendment of an application under section 57 has to be done in form 13. Form 13 is the form that is used for amending specifications or document or the application for patent itself. 81 2 states that if the application for the amendment has not been granted, the controller shall determine whether and such and subject to conditions if any the amended should be allowed.

Three a says if the amendment under rule one is made after the grant then the nature of the proposed amendment is substantive. So, two things the amendment is after the grant and the proposed amendment is substantive. So, I kept using the word substantive as supposed to clerical. Now we understand that if it is after the grant and the amendment is substantive the applications shall be published. So, publication comes in not in every case where the amendment happens after the grant, there is an additional requirement that though the amendment happens after the grant the nature of the post amendment has to be substantive. So, if it is not substantive it need not be published; b any person can give notice of opposition in form 14 within 3 months from the date of publication of the application.

So, form 14 is used for notice of opposition of amendment. Now the form fourteen is a common form for notice of opposition of a amendment of restoration surrender of patent grant of compulsory license and correction of clerical errors. So, all these provisions has form 14, but form 7 is used for notice of opposition in the case of a post grant opposition.

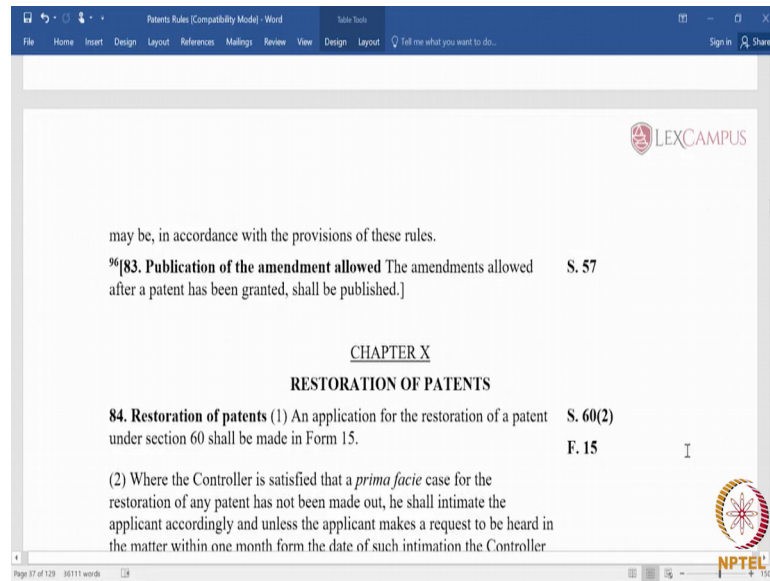
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So, form 4 form 7 and form 14 are used for different kinds of oppositions. The procedure specified in rule 57 to 63 relating to return statement reply statement leaving evidence hearing and cause. So, far as maybe apply for a hearing of a position under section 57.

Now, we saw that rules 57 to 63 are provisions pertaining to how post grant opposition has to be conducted, the same procedure will follow for opposition of amendments 2 82 preparation of amendment specification etcetera. Where the controller allows the application for a patent or any other document the applicant shall if the controller. So, requires and within the time speed it is specified by him leave at the appropriate office an amended application or specification as the case may be in accordance with the rules.

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So, and copy of the amended document be it application specification or any other document, has to be left at the appropriate office. Now 83 publication of amendments allowed the amendment allowed after the patent has been granted shall be published we saw this in section 57.