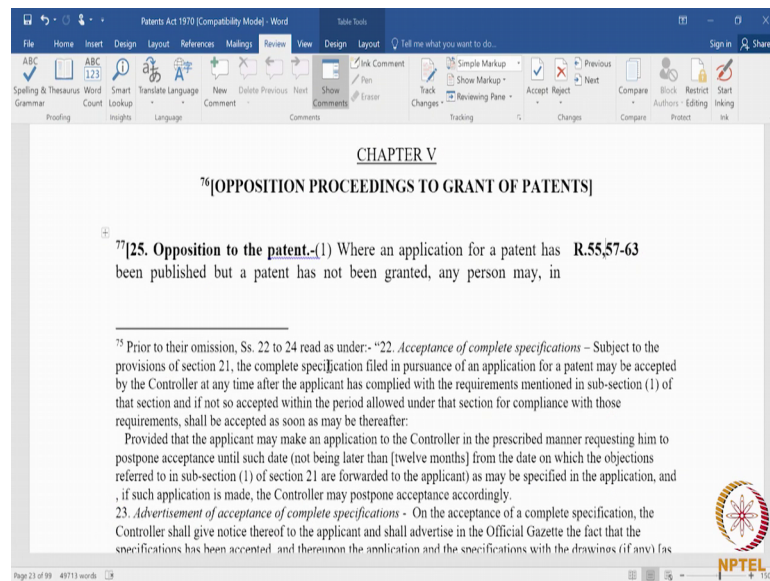


Patent Law for Engineers and Scientists
Prof. Feroz Ali
Department of Management
Indian Institute of Technology, Madras

Lecture - 41
Patent Prosecution: Opposition
Pre - Grant Opposition

(Refer Slide Time: 00:17)

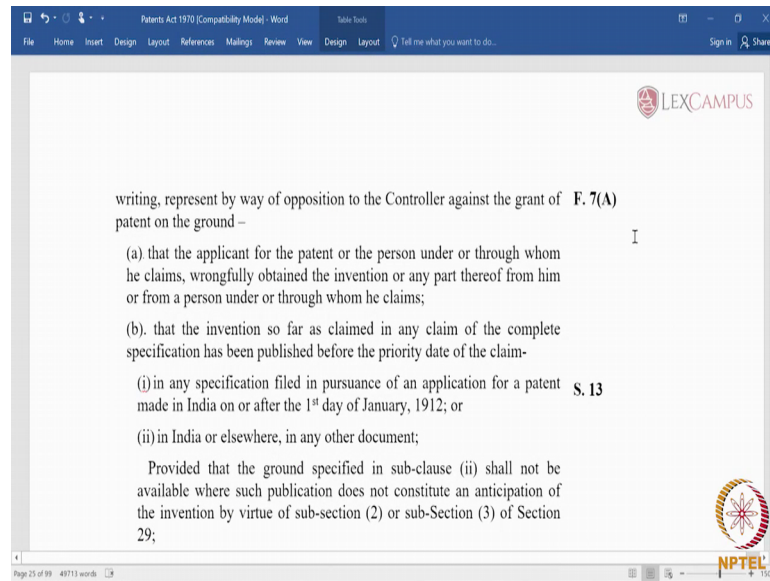


So, first let us start with pre grant opposition. So, 25 1 deals with pre grant opposition or opposition before the grant 25 1 where an application for a patent has been published, but a patent has not been granted. So, which means application is published and there is no patent that has been granted.

Now this is the time frame or this is the window period between which you can file a pre grant opposition the patent should be published you cannot agitate a patent which is not published. And it should be a point before the grant. So, the time frame being after publication of the application and anytime before the grant the status of the person is mentioned it is mentioned as any person.

So, a pre grant opposition can be filed by any person when you contrast this with post grant opposition you will find that any person interested can file a post grant opposition.

(Refer Slide Time: 01:35)



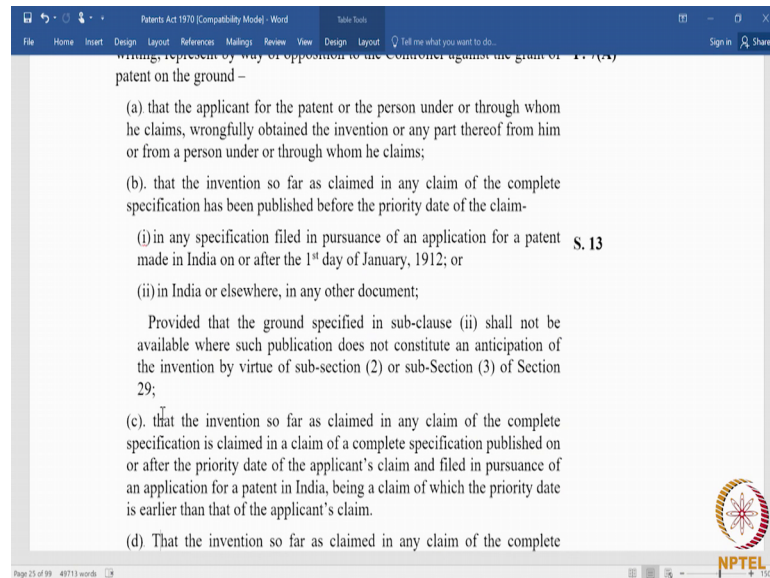
So, for a post grant opposition we require a person to be an interested person whereas, that is not there for pre grant opposition any person may in writing represent by way of opposition to the controller against the grant of a patent on the ground. Now the grounds are mentioned a b c d e, we will go through the grounds, but what is the important here is the opposition in pre grant has to be in writing and it has to be a opposition that is made before the controller.

Now in the earlier page you had there is a lengthy foot note in between there are cross references to rule 55 and rule 57 to 63. Now if you look at rule 55 we will be coming to that in detail, but there is a small detail that needs to be introduced here rule 55 was amended by the patents amendment act 2016, rule 65 was amended and now you have form 7 A which the pre grant opponent has to file form 7 A was not there before. In fact, the act only says in writing you saw 25 1 and 25 1 it says any person may in writing the in writing tells us that the opposition should be a statement of position.

But before 2016 there was no particular form to be used the 2016 amendment to the patents act has introduced form 7 A. So, henceforth after the 2016 amendment any pre grant opposition has to be filed in this form. So, that is the detail and the only rule that governs pre grant opposition is rule 55. So, we had given that cross reference on top and this opposition is made to the controller on particular grounds. And as I mentioned any

person can make an opposition and there is no need for the payment of any fees. So, the opposition is proceeding without any fees now here are the grounds.

(Refer Slide Time: 03:50)



Now, we will go through the grounds quickly because these grounds also appear in section 64 grounds on which you could revoke a patent and all the concepts such as lack of novelty lack of inventive step and other grounds of anticipation will be discussed in detail under section 64.

So, we will just make a pass in reference to the grounds here. So, 25 1 A; the applicant for a patent or the person under or through whom he claims wrongfully obtain the invention or any part there off from him or from a person under or through whom he claims. So, if the patent is wrongfully obtained. Now that is the concept in patent law if a patent is wrongfully obtained then they can be an opposition on that ground now the ground has to be proved now the person who files the opposition should either say it was wrongfully obtained from me or wrongfully obtained from a person through whom the opponent is claiming.

So, this proceeding is unique because this ground of opposition is unique, because they could be some action that follows out of this section because in a case of a the patent act refers to this as a case of obtaining if the obtaining happens after the grant of a patent then there can be a further proceeding or there can be certain actions that the controller can take under section 26.

Now, section 26 covers section 25 2 A, but we are currently discussing only section 25 1 A, if a person wrongfully obtains a patent under section 26, the controller can take some measures to correct it, but in the pre grant of stage if the person has not wrongfully obtained the patent he has not yet wrong wrongfully obtained the patent, what has happened is that he has wrongfully obtained the invention, but that application has not materialized into a patent. So, it is a; you should understand all the interventions at the pre grant stage as interventions before the grant of a patent. So, because an patent has not been granted the remedy under 26 is not open for the pre grant opponent whereas, the remedy under 26 is open to a post grant opponent because a patent has already been granted.

So, this you should understand under the scheme of the act all the things that you do in a pre grant opposition is prior to the grant prior to the grant means there is no right that has been granted to the patentee, whereas all the ground you raise the same grounds you raise after the grant the patentee now already has a right his name is entered in the register of patent as the patentee.

So, it is much difficult for you or for an opponent to challenge a right that is been granted because that will involve different procedures the evidence that he will have to introduce we will be different though the grounds have the same words the procedure you will understand the involvement of an opposition board elaborate hearings all these things point towards a much more rigorous procedure and the fact that 26. Section 26 is not applicable to section 25 1 A is further proof that the rigor of a pre grant opposition is different from the rigor of a post grant opposition.

So, as we go by we will understand pros grant opposition to be a different procedure it is much more detail than the pre grant, but the grounds continue to be the same. So, in case a person alleges that the applicant wrongfully obtains the invention like they all worked on a project. And one person the applicant went and filed a patent alone without taking their interest into account or the applicant was working in a firm which had an NDA and a confidentiality agreement and they were working on an invention he left the firm resigned from the firm and filed the patent. So, they could be n number of instances where a person can make a charge that the invention was a wrongfully obtained wrongfully obtained in a sense means that a person who filed the application was not the person who was entitled to be the applicant.

So, wrongfully obtained the invention can have different I mean it can be there could be an allegation that he is not the true and first inventor and he is neither and assignee nor a legal representative there can be an allegation that the idea or the invention was stolen it was stolen the idea was stolen while he was working on a project and he filed an application though he did not have a right to do it. So, to ascertain whether an invention was wrongfully obtained the controller.

We will have to get into the details of employment to see whether there are non disclosure agreements between the parties to see what was the relation between the parties and to understand the scheme of things in which the dispute evolved. As I mentioned they could have been working as a team than one person came out of the team and filed an application it could be an application filed by an x employee or an x partner there are n number of circumstances that would come in.

But the ground of wrongful obtainment or wrongfully obtained that the invention was wrongfully obtained pertains to disputes with regard to ownership of the application disputes with regard to who can make an application if the applicant did not have the right to make it then we say that it was wrongfully obtained. So, these are not a disputes or this is not a ground wrongful obtained is not a ground where we attack the substantive merit of the patent in an anticipation we attack the substantial merit of the patent in inventive lack of inventive step we attack the substantial merit of the patent this is actually on the conduct of a applicant how the applicant behaved. So, in Indian law just as in the US law you can attack the validity of a patent based on the conduct of the applicant of the patentee conduct of the patentee can be a ground in US for attacking the validity of patent.

So, this ground is pinned to the conduct of an applicant it has nothing to do with the substantial merit of the invention itself, because you will be not even produce any prior art if your raising this ground an employment agreement and in NDA can actually resolve this issue if they strongly show who was actually the owner of the invention. So, this is we look at this as a ownership dispute this is not a dispute with regard to substantive merit of the patent 25 1 B, that the invention so far has claimed in any claim of the complete specification has been published before the priority date of the claim one in any specification filed in pursuance of an application of a patent made in India on or after the first day of January 1912 or in India or elsewhere in any document provided the

ground specified into shall not be available may such publication does not constitute anticipation under 29 3 2; 29 3 2 is an exception to anticipation in. In fact, 29 and all the sections near it or deal with exceptions to anticipation instances where something we will not be from 29 to 34 you have instances where certain x will not amount to anticipation.

So, this cross reference in sub clause B is 2 29 says that in instances where certain x do not constitute anticipation that has to be factor 2 and here the specific reference is to 29 3 2; 29 3 2 is the cross reference to this provision. Now we had already seen section 13 this language is very similar to section 13.

In section 13 the examiner has to make a report on anticipation what is called the search for anticipation by previous publication and in there you had 2 categories one is anticipation by any specification filed in pursuance of the application for patent made in India on or after 1 1 1912. And we had mentioned as this is to show this is to include all the applications that were filed in the Indian patent office we had also mentioned that the sequence of patents that are numbered currently. In rule 37 we had mentioned that we are still following the numbering sequence that was given under the 1911 act the Indian patents and designs act 1911 came into effect on first January 1912.

So, wherever you see this phrase first day of January 1912 it refers to the coming into force of the Indian patents and designs act 1911 the act is 1911 it came into force on first January 1912. So, all the reference simply means that since the Indian patent office was established. So, any specification filed in persons of an application for a patent made in India on or after the first of January 1912 means any patent application made in India because the nineteen seventy act repealed the 1911 act in section 162, we had seen that the 1970 act repealed the 1911 act.

So, the significance of this date first January 1912 is that it tells us that the patent applications if you read section 162 along with rule 37 and section 13 and section 25 1 B you will get the impression that the 1911 act came into force on the first January of 1912 and all the applications filed under that act since the first of January 1912 could be used as documents to prove anticipation.

So, this simply means any specification filed in India which has been published before the priority date can be used for proving anticipation B is a ground of anticipation you can also call it a ground of lack of novelty there are 4 types of lack of novelty we will

discuss that in detail this anticipation by a prior published document is one type of lack of novelty challenge. So, B 1 simply says any document filed in India that is since 1912 can be used to challenge the claim of an application. So, though b does not start by saying anticipation we understand it has not ground for anticipation because the language any claim has been published before the priority date is something its published before the priority date it anticipates the invention now that is B 1- B 2 says in India or elsewhere in any other document.

Now, this covers the world one only said specification made in India after 1912 which means right from the first patent have specification made in India you could look into the specification for determining anticipation 2 covers the entire world anything above that which is any document in India or elsewhere this relates to section 13 2 India or elsewhere you will find the same mention in section 13 2 anything any material if the invention is covered in any other document in India or elsewhere which means the entire world can also anticipate.

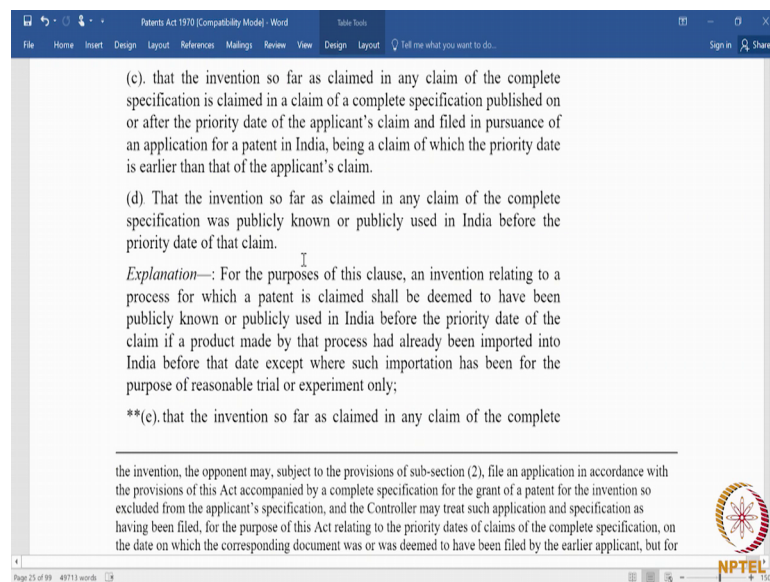
So, anticipation by specifications filed in the Indian patent office are covered in B 1 and b 2 covers any document prior publication means prior publication by any document prior claiming alone means the claim should be claimed in another document. So, prior publication and prior claiming are 2 types of anticipation 2 covers prior publication and in anticipation the Indian patent office, like most other patent office is follows a global standard we can look into documents from any country it need not be a patent document it could also be a non patent documents.

So, any other document means any document other than a specification and India and elsewhere covers the entire world. So, we have an absolute standard for novelty what is called the absolute novelty standard regardless of what is filed in India the Indian patent office can look at any prior art to challenge the novelty of an application the proviso deals with instances where a publication does not constitute anticipation by virtue of 29 2 or by virtue of 29 3, 29 2 and 29 3 we will come to it in greater detail, but for the time being you need to understand that there are certain instances where certain publication that you do will not amount to anticipation you could make certain publications and follow up with a patent application at a later point and time and still get the benefit of this period you can call it a grace period in India there is a grace period the grace period

allows you to make a publication and follow it up with an application for a patent within one year in most occasions its one year.

So, India has a grace period and this nearly says that if a publication was made during that grace period that cannot be used as ground for anticipation. So, when we come to 29 we will look at 29 2 and 29 3. So, any publication that can be used to challenge a patent under b should not fall under section 29 2 and section 29 3. So, the cross reference to this provision is section 29 2 and section 29 3. So, as we mentioned this is a one of the grounds of anticipation and anticipation is link to the concept of novelty. So, when we say something is anticipated we mean something lacks novelty the claim lacks novelty.

(Refer Slide Time: 20:08)



See the invention. So, far as claimed in any claim of a complete specification this entire freeze can be summarized as the claimed invention or what is claimed or in just we can say the claim the claim in the application.

The claim in the application is claimed in a claim of a complete specification published on or after the priority date of the applicants claim and filed in pursuance of an application for a patent in India being a claim of which the priority date is earlier than the applicants claim now you will remember that when we were discussing section 13; 13 1 b. We had seen a situation where a claim in any claim of a complete specification published on or after the date of filing, but having an earlier priority claiming a priority earlier than that day. Now, this is what we call anticipation by a pending application

normally for something to anticipate the thing has to be published and only you can get the benefit of anticipation the document on which you are going to compare the claim has to be in the public domain it has to be already published.

But in patent law we understand that there is a domain period what we call the period during which the application is not published normally it is 18 months that is a default domain period. So, if, but the domain period does not accept the priority the domain period though the application is not published still the priority is preserved. So, if assume that a person files an application on Jan first 2017 another person files a similar application on Feb first 2017.

And let us also assume that they are almost verbatim though they did not have the benefit of each application there are almost verbatim they map on each other the person who files the Feb application would not have the benefit of the Jan first application when if it does a prior art search the Jan first application in normal course we will get published only after 18 months and any prior art search is going to throw you documents that have been published after 18 months of its filing.

So, there is always a gap in your prior art no matter how effective your prior art searches it cannot come it cannot or it will not throw the documents that remain unpublished. So, this is the gap and everybody understands this, but nevertheless from the viewpoint of the patent office if there is a prior art in the intervening period the prior art has been considered. So, this provision allows the controller to look at documents which were published later, but which had an earlier priority because world over the patent office follows the rule of first to file whoever filed first will get the patent.

So, if 2 people mailed parallel inventions they found they came up with the same invention and they filed. One filed in January and the other person filed in February the person who filed later when the January publication gets published that can be used as prior art. So, that is what is mentioned here and in 13 also you have that situation. So, many a times people ask hypothetical questions about what happens if 2 inventions are invented by 2 people in a different place, but they did not know about it the answer is whoever files first gets the patent and this is the reason the stamp of the patent office also has a time stamp it not only acknowledges a time the date on which the application was

received there is also a time stamp and by the time stamp we will get to know who is prior and time.

The applicants claim has been claimed in another specification which was published after the priority date, but which had an earlier priority. So, how we will this happen this will happen because of the dormant period the 18 month period applications are not published, but nevertheless if somebody filed an application on the same invention before you he will get the patent and the controller can rely on that. And understand that by the time pre grant opposition is filed all applications are published the Feb application would have been published because otherwise a person cannot challenge it and the other application the Jan application would have also been published by that time.

Then the applicant who filed the Jan application or any person who wants to sight the Jan January application can sight it challenge the latter filed applications this again is a kind of anticipation we refer to this anticipation as anticipation by a pending application d the invention. So, far as claimed in any claim of a complete specification was publicly known or publicly used in India before the priority date of the claim this is the third kind of anticipation this is anticipation by public knowledge or public use anticipation by public knowledge or public use is where the invention that you have claimed was known publicly or it was used publicly.

So, public knowledge and public use need may not be through documents whereas, in b and c either we were looking at a complete specification in b or we were looking at any other document again a published document in c we were looking at a complete specification again. So, in b and c all the documents that we had to compare or we had to look at to determine anticipation were published documents and it is easy to map a publisher document with a claim d.

However, cover something beyond published documents something that has publicly known or publicly used say a particular technology a machine was publicly used in India you could use that to challenge a claim if you are able to prove that machine actually encompass the invention that is now covered in the claim or there was a disclosure of the invention say in a conference publicly and people knew about the invention publicly. But there was no record of it, it was not documented it was not written it was not captured it

was not video graphed assume that it was not recorded in anyway, but a group of people knew it in those cases you will have to produce evidence to show that people knew it.

A news report showing that the event happened a news report showing that the description of the event or you could even file affidavits before the controller saying that. So, and. So, was there in the conference he and. So, many other people were there they all understood this to be the invention. So, this invention should not be granted. So, public knowledge publicly known or publicly used public use the burden of proof maybe different from merely producing a document.

So, if the knowledge or use was not available in a published form still you can prove these things, but you will have to adduce evidence of a different kind we will have to ask people to file affidavits its slightly different from what you saw in b and c in b and c we were only looking at documents either specification or any other document here it needs not be a document as I mentioned if a machine was used publicly in India. And it was not recorded in any document you could still file affidavits from people and you could prove it through the evidence of people who had witnessed it people who are known it people who are seen it being used or people who had used it.

This is an explanation to d for by the purpose of this clause an invention relating to the process for which a patent is claimed shall be deemed to have been publicly known or publicly used in India before the priority date of the claim, if the product made by that process had already been imported in into India before the date except where such importation has been for a purpose for reasonable trial or experiment only.

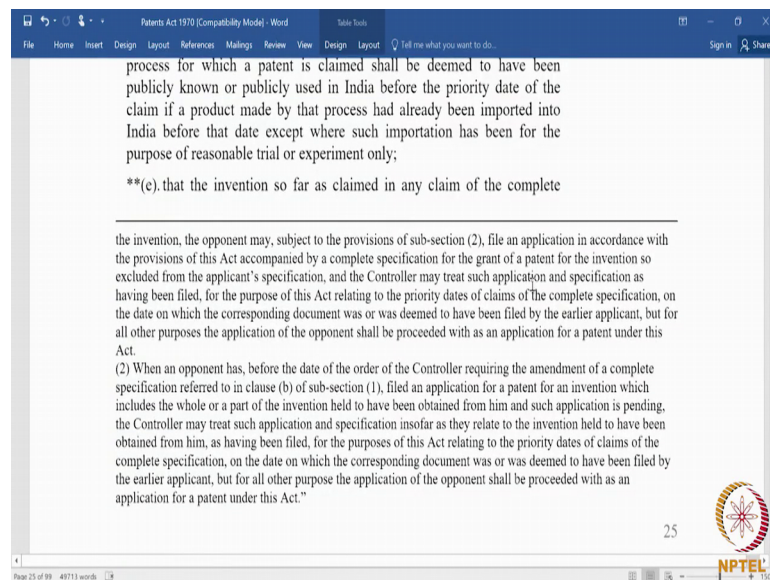
Now it simply means for understanding publicly known or publicly used we will also consider imported things something that was imported, and it was publicly known still it will be considered as a part of public knowledge or public use it need not be an invention that was developed in India it need not be something which people in India made it even things that are imported can be considered, but the only exception is if the thing that was imported was important for reasonable trial or experiment only say there was a machine that was used to excavate the land to drill holes into the ground.

Just was used brought into India nobody made that machine, but this was only on a reasonable trial say the Indian government wanted to know whether they can drill a type of rock whether it can be used for drilling a rock they tried it they found that it was not

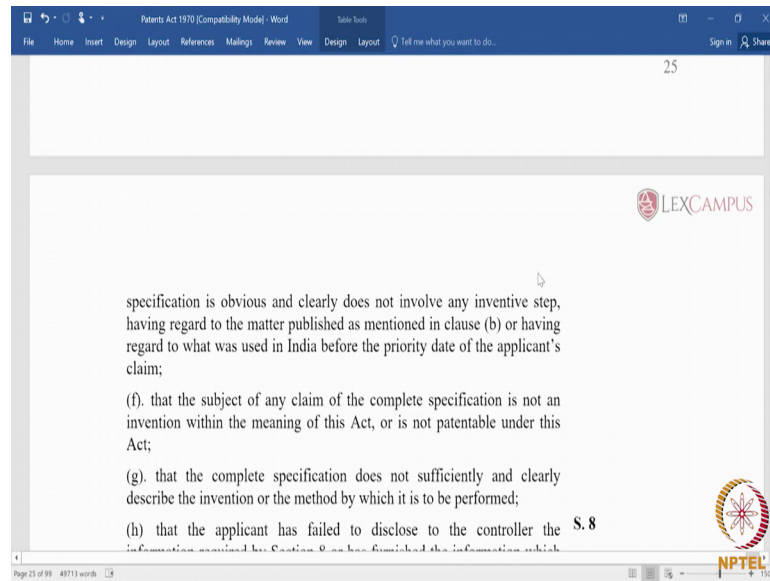
successful or it was too expensive or they had issues and they sent it back. Now that can be regarded as a reasonable trial or experiment it is not large scale commercial use thus such uses cannot be used for challenging novelty again, like the grace period that we saw this is an exception that is given similar exceptions are there throughout the patents act section 49 the fact that foreign vessels come into India temporarily vessels like aircrafts or ships that come into India they may have in the vessel it could be an aircraft it could be a land vehicle or a vessel a sea going vehicle a sea going right a ship or boat.

The fact that they came into India and they had some part of it which was patented cannot be a cause for infringement. So, if an aircraft came and landed in India and there was a patented part inside the aircraft you cannot file a case of infringement for the simple reason that the aircraft which will live India we do not call that commercial operation it is not that that machine was made or copied or disseminated within India in the vessel or the aircraft or the vehicle came to India and it just left and just to bring an analogy from section 49. Similarly, something which came into India by importation, but for reasonable trailer or experimentation, and which eventually left India cannot be the ground for an anticipation challenge.

(Refer Slide Time: 32:20)



(Refer Slide Time: 32:29)



Now, we come to e that the invention so far as claimed in any invention of a complete specification is obvious or clearly does not involve inventive step having regard to the matter published as mentioned in b or having regard to what was used in India before the priority date of the applicants claim this is the very interesting provision because a what we are dealing here is with the lack of inventive step the earlier 3 provisions were on lack of novelty or anticipation novelty and anticipation are related concepts.

Here it says the claim was obvious or clearly does not involve an inventive step now if you look at the definition of inventive step in section 2 1 j a you will find that the definition of inventive step again refers to obviousness last part of 2 1 j a says not obvious to a person skilled in the art. So, there is. So, you find that obviousness or the fact that an invention is obvious is repeated twice obvious and clearly does not involve in inventive step and the definition of inventive step again says obvious to a person skilled in the art; so does not double emphasis here. So, it would have been if the wording of this section was specification clearly does not involve an inventive step that would have been sufficient, but the emphasis on obvious is unnecessary because anyway what does not involve an inventive step the definition of inventive step anyway has reference to what is not obvious to a person skilled in the art.

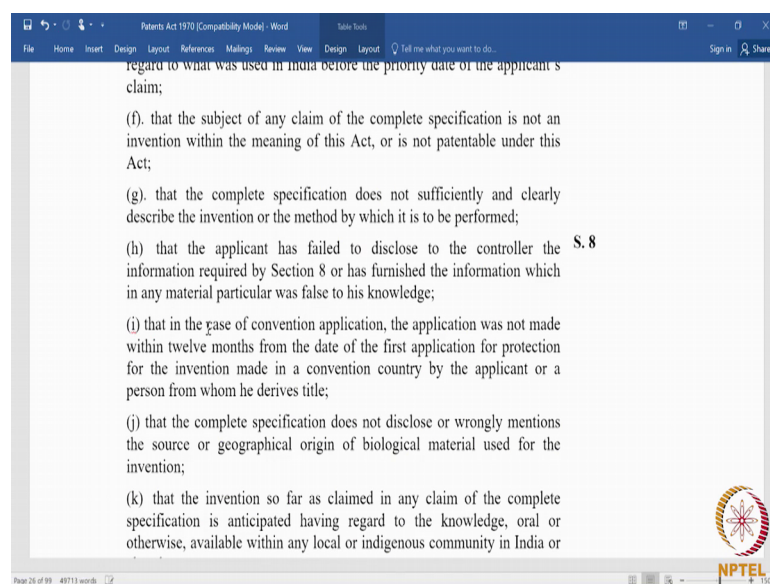
Now, though we say this pertains to lack of inventive step or this is a ground on which lack of inventive steps can be challenged this appears to be a limited ground you have to

compare this with say the ground for lack of inventive step in section 64 in section 64 is a very elaborate ground you will find that section 64 1 f the cross reference to this provision will be section 64 1 f. So, this section says having regard to matter published as mentioned in clause b or having regard to what was used in India before the priority date.

So, it refers to only the documents in clause b or what is used in India whereas, f of 64 1 talks about having regard to what was publicly known or publicly used or what is published in India or elsewhere before the priority date of a claim exhaustive the 64 1 f is not confined to documents alone whereas, in 25 1 e appears to be confined to documents alone because it refers to clause b. Clause b is nothing but specifications and any other document, but it also goes further to say mentioned in clause b or having regard to what was used in India before the priority data.

So, we understand this to prove lack of inventive step as a ground for opposition you could rely on any document published anywhere, but when it comes to use it has to be used in India, whereas n 64 1 f where you raise the same lack of inventive step as a ground for revocation you can rely on public use in India publicly known in India and what was published in India or elsewhere how this is different from the ground for revocation is public knowledge is not covered in this part lack of inventive step is we will be dealing with it in great detail when we cover section 64.

(Refer Slide Time: 36:41)



F that the subject of any claim of a complete specification is not an invention within the meaning of the act or not patentable under this act invention not an invention within the meaning of the act the cross reference to that will be section 3; as if we take section there the title of section 3 is what is not an invention and or what is not patentable under the act the cross references section 4.

So, the cross reference to this section will be section 3 and 4 section 4 you could take a broader view and say that what is not an invention means what does not fall within the definition of an invention in section 2 1 j, but there is no need to take that view because what is not an invention is already covered in the other aspects of the act lack of novelty lack of inventive step is already covered, but it is open to say that what is not an invention could also mean what does not fall within the purview of an invention. And you could also raise issues on lack of utility there is no separate ground here on challenging utility that the invention is not useful you could also bring that to say that utility or capable of industrial application is a requirement of an invention and this definition could be used to raise that, but going by the word meaning not an invention you will find is and the title of section 3 not patentable something which we will find in the title of section 4.

So, we will just understand this has 2 things which cannot be granted and hence section 3 and 4 refers to exceptions to patentability we will understand f as a provision which covers exceptions to patentability now if you compare the corresponding provision in section 64 on grounds of revocation these 2 things are mentioned in different sections different clauses not an invention is different and not patentable is mentioned in separate clauses g that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed.

Now, this is an objection that goes to the way in which the patent is drafted. So, this objection is an objection that was not satisfied we will call it an internal objection all the objections which we saw before you had to compare the patent application with an external document a prior art or a public knowledge or public use you have to compare the application which something outside it wrong full obtainment or the fact that the invention was wrongfully obtained is again you will have to show it through documentation you have to show that there was an employment contract or an NDA again you have to do something external.

G says that the complete specification does not sufficiently or clearly describe. So, the descriptive part and the illustrations put together the complete specification the claims everything together does not sufficiently and clearly described now clearly described to whom to a person skilled in the art. Now the person skilled in the art we saw in the definition in the act he is a person to whom the patent specifications are addressed he is the hypothetical addressee all specifications are addressed to him. So, a person skilled in the art when he read the specification it did not sufficiently or clearly describe the invention.

Now, or by which it is to be performed the method by which it is to be performed in section 10 the cross reference to this will be provisions of section 10 section 10 4 a and section 10 4 b . So, if you do not describe the method of performing the invention or making the invention or what you have described the complete specification is not sufficient in its description or it is not clear in its description that can be a ground for challenge there is a concept in patent law that a disclosure made in a specification should be enabling disclosure.

Now, this is the provision that can be used to say that there is no enabling disclosure the disclosure should be sufficient and clear and describing the invention and the method in which it is perform if it is not sufficient and clear and a person who reads it does not understand how to do it then you can say that the specification has not made an enabling disclosure there is disclosure, but it does not enable the person to make the invention now this is the requirement under the patents act that the 20 year exclusivity is granted in return of the patentee the inventor teaching the invention.

So, that is why you find the prior or teachers you find that language that has got into the patent law jurisprudence the prior art teaches this particular aspect of the invention that is because, patents have a teaching element when you file a patent you get a 20 year exclusivity in return you will have to teach the people how to do this invention.

So, you cannot file an unambiguous patent or an obscure patent without clear details in it and expect to have a 20 year exclusivity the question arises in an ambiguous patent where nothing is clear nobody reads and understands it what did you teach others we do not say somebody has thought someone or somebody has thought somebody a way to do

it if the person who to whom it is addressed did not understand. So, a part of teaching is that the person who receives the knowledge understands how to do it.

So, if that element is not there we would say that he has not taught that person he did not teach that person how to do it for instance there are certain things which do not come to human beings naturally like swimming; swimming has to be thought. So, in swimming if you go for a class to an instructor and after a long period of time say 3 months you are still not able to swim you cannot say that the instructor taught you swimming because you have not learnt it you are not still not able to do it and this repeatedly say a person wrote a book on how to swim just no practical experience a book on how to swim and many people brought that book and they tried and nobody was able to swim based on reading that book.

We cannot say that the book has thought people how to swim enabling disclosure requires a person to teach the invention in such a way people can perform it people can come up with the invention. So, if a person cannot come up with the invention he would say that there is no enabling disclosure made and he will use this ground if he is a pre grant opponent to say that the specification does not sufficiently or clearly describe the invention or the method by which it is to be performed now just applied to the swimming analogy the disclosure does not allow me to do what you are teaching me what you teaching me you are teaching me to swim it does not help me to do that. So, if the disclosure does not allow a person to do what the invention claims to be this ground can be used.

So, we understand this has an internal requirement it is an internal ground there is no comparison no prior art involved there is no conduct involved you see that conduct the behavior of a person wrongfully obtained could be a ground for challenge this is no conduct involved this is no prior document or prior art document or any kind of document that needs to be compared here it is this is why we call this is an internal requirement we call this sufficiency in patent law this ground is called sufficiency. Sufficiency is an internal ground it has to be proved its a requirement that the specification has to satisfy each that the applicant had failed to disclose to the controller the information required by section 8 or has furnished the information which in any material particular was falls to his knowledge. Now the cross reference to this section 8

we had already seen that section 8 requires you to make certain information's regarding foreign applications foreign filing to the patent office.

So, if the applicant has failed to make that disclosure and the corresponding form is form 3. So, you file form 3 to make the disclosure under section eight. So, the corresponding reference should be form 3. So, if a person does not file a form 3 that could be ground for Revoca ground for opposition under this ground or he has filed form 3 he has furnish the information which in any material particular was false to his knowledge. Now he said that an application which I filed in Australia has been granted the opponent files that it is not been granted it is actually been rejected the opponent can reach the ground to say that he file form 8 saying he got a grant in Australia, but his Australia was actually rejected showing the relevant documents showing that it is been rejected from the Australian patent office website.

So, this is the ambit of section 8 section 8 is not on the substantial merit of the application it has nothing to do with comparing it with an external document it is again on the conduct of the applicant the applicant did not do something or he with something, but what he disclosure the patent office was wrong. So, that could be a ground for. So, so again patents can be revoked applications can be opposed not just on its substantial merit it can also be revoked based on the behavior of the conduct of the applicant. So, this is the second ground which we see have seen which goes to the conduct of the applicant I that in the case of a convention application the application was not made within 12 months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he drives title.

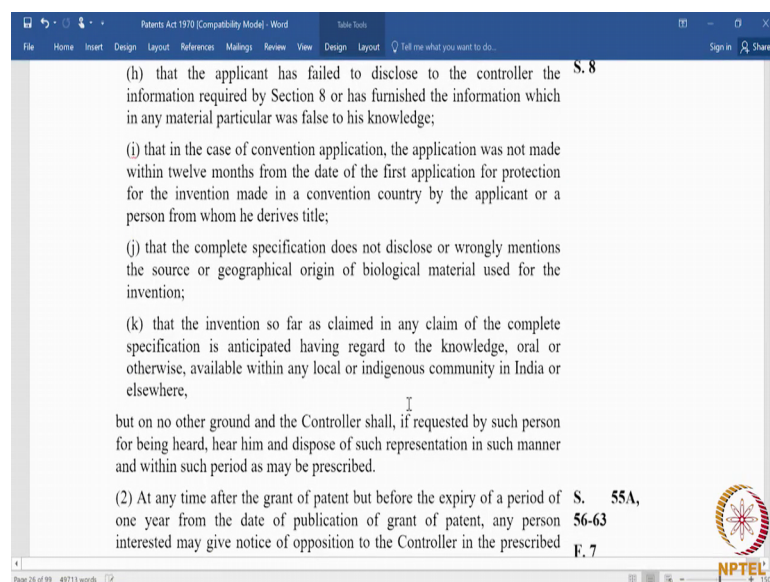
Now, in the case of a convention application which enters India the application in India has to be made within 12 months of making the first application that is a what we call the basic application. Now if the 12 month period is not kept it can be a ground for challenge the analytic similar to what we saw in section 9 1 if a provisional specification is filed if it is not followed within 12 months by a complete the professional is treated as abandoned if a complete is filed after 12 months the complete.

We will not get the benefit of the provisional, because the provisional is treated as abandoned in a same way the convention application has to be followed by an application in India within 12 months if the 12 month period is not maintained that can

be a ground for challenge. Again this is going on the conduct it is not on the substantial merit of the application it has nothing to do with comparing it with a prior art document the applicant for whatever reason he will do a particular thing on time.

So, that again comes to is conduct how the applicant behaved when we say conduct we are referring to how the applicant behaved and the behavior of the applicant can lead to a dismissal it maybe a procedural behavior it is not that we are not alleging that by this the applicant can be deemed to have been committed some fraud on the patent office it is not the thing, but the applicant was required to do something and he did not do it in that fashion. So, again the third ground going back to the conduct of the applicant.

(Refer Slide Time: 49:48)



J where the complete specification does not disclose or wrongly mentions this source of geo geographical origin of biological material used in the invention the source of biological the source or the origin of the biological material has to be mentioned properly if it does not disclose it properly no mention of it or it is wrongly mentioned again this goes to the conduct of the applicant there applicant can may say that it was a error typographical error or it was a by mention, but again what contributes to this ground is an action of the applicant.

So, this is the fourth ground which goes to the conduct of the applicant and some of these objections if the applicant is able to show that the error was not because of him and consultant or an agent was involved in it or he can prove that these are things which was

beyond him and the error krypton, then maybe the controller may allow by way of an amendment for it to proceed k that the invention.

So, far has claimed in any claim of a complete specification is anticipated having regard to the knowledge oral or otherwise available within any local or indigenous community in India or elsewhere this is the fourth type of a anticipation this is what we call anticipation by traditional knowledge what is meant here as knowledge oral or otherwise available with the local or indigenous community is knowledge that was we can use the word traditional.

Now, anticipation by traditional knowledge like the other anticipation they all go back to the claim now one way we can understand a lack of novelty lack of novelty is attacked on the claim it is an attack on the claim claims lack novelty lack of inventive step is again attack on a claim. So, all the grounds where something is an attack on a claim like and lack of novelty attack or a lack of inventive step attack you will see those grounds will begin with the language the invention. So, far has claimed any in any claim of a complete specification.

So, that is an attack on the claim whereas, if you see j the complete specification does not disclose its an attack on the descriptive part of the complete specification. So, you can see that the specifications or a patent application can be attacked some attacks are on the claim some attacks are the complete specification itself some attacks are on the behavior of the person something that did not happen on time.

So, you can classify all the grounds based on whether it was an attack on the way the applicant behaved whether it was an attack on the way the patent was drafted which goes back to the specification whether it was an attack on the claim. So, all anticipation grounds by which I mean lack of novelty grounds and lack of inventive step grounds are attacks on the claim which tells us to prove novel lack of novelty or lack of inventive step you have to compare the claims to prove sufficiency. You have to look at the complete specification to prove whether the source of geographical origin was correctly mentioned you will have to look at the complete specification not at the claims because the disclosure is going to come. So, there is a disclosure part in the specification for which you need to look to prove certain grounds there is a claim part of the complete specification for which you need to see to prove other ground. So, understand and

specification has different parts and an attack can come on the different parts using different grounds.

So, when you are raising these grounds you will have to be very clear on what you are attacking you cannot say the complete specification is anticipated you cannot say that you have to say that a particular claim point that claim and attack that claim for the next claim you may have to use some other argument. So, claims just as we mentioned have their own priority they had mentioned that each claim has its own priority claims have also to be individually attacked in opposition proceedings or in revocation proceedings now the section continues to say that, but on no other ground.

So, the a to k other limited grounds on which you can attack it, but on no other grounds. So, it kind of closes your ability to attack for instance if there are more than 2 inventions in an application what we call the unity of invention has violated it cannot be a ground for opposition you can always bring it to the notice of the controller, but you cannot get a patent rejected on that ground why because that is something which is remedy able you can correct it, it is a mistake you can correct the patent office you will have you to correct it.

There are 2 inventions in one application patent office we will say file a divisional, but that cannot be used because it is not in the ground listed the and the controller shall if requested by such person for being heard hear him and dispose of the representation in such manner and within such period as may be prescribed now this tells us I mean this is the end of the grounds of pre grant opposition now to the post grant starts.

So, what is critical here is that if a request is made by a person for hearing the controller will hear in and then dispose of the representation either asking saying that valid grounds for a patent to be rejected he may do 3 things he may reject the patent application based on the opposition is something can be corrected and he can grant it he will ask the applicant to amend it based on the opposition and post amendment if the amendment is satisfied he would grant or he will say that the grounds raised by the opponent are not substantives and he may reject the opposition and grant the patent.

So, 3 things can happen understand that the pre grant opposition comes after the application is made ready for a grant the statement of objections is filed by the is communicated by the controller the applicant has addressed it all the concerns it is made

ready for a grant only then the controller opens the opposition. So, when it reaches the opposition stage the controller has every reason to grant it except for the pending opposition between the applicant and the controller.

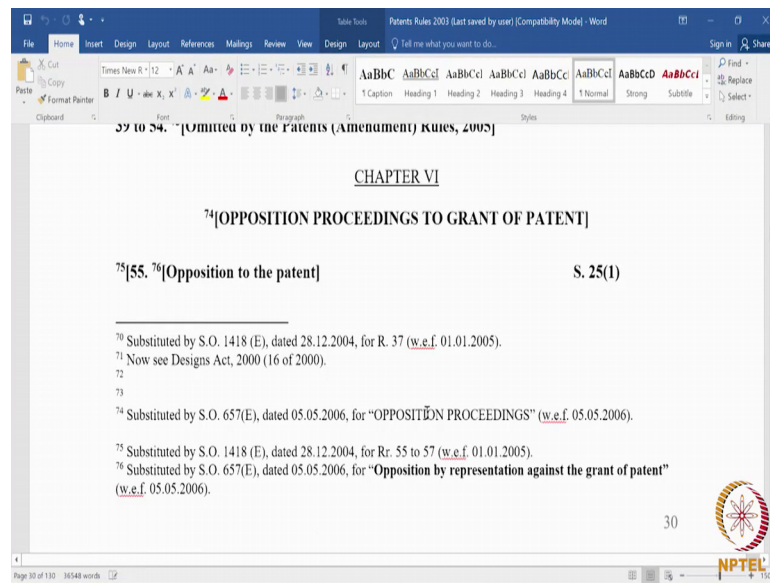
The controller has the applicant has satisfied every objection raised by the controller there is no further objection the controller otherwise if the if the controller has objections he would have refuse to it under section 15. So, this the controller, we can assume if a matter has taken up on this is the practice if a matters taken upon pre grant opposition we can assume that the applicant has satisfied every objection under the act or those that we are raised by the controller and then they get into pre grant opposition. So, if the pre grant opposition is rejected it results in the grant.

So, 3 things that the controller can do he can accept the opposition and reject the patent he can ask the applicant to amend based on the objections and if the amendments are made to his satisfaction he may grant or he can directly grant if the objections raised in the opposition are not substantive when the controller grants a patent after considering all these opposition the controller may directly grant the patent and you may asked the applicant to make an amendment.

And eventually grant it when the controller refuses this provision does not say that the controller can refuse the act if you see 25 1 there is no mention of refuse it when the controller refuses. We will understand that as a refusal under section 15, because section 15 gives wide power for the controller to refuse and a refusal of an application pursuant to a pre grant opposition is still understood as a refusal under section 15, because what is refused still an application and the only power for the controller to refuse an application comes from section 15.

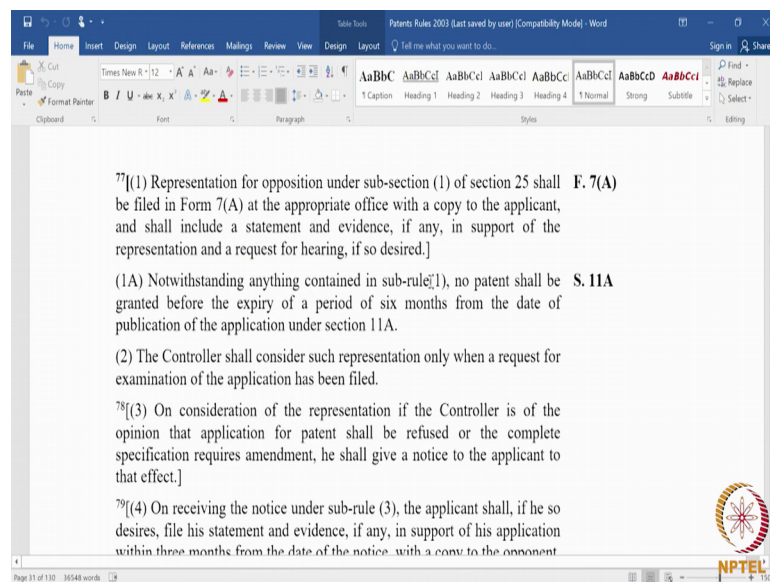
So, somebody ask you a question pursuant to a pre grant opposition if the application has refused the controller does that under his powers under section 20 1 section fourteen section 15 section we will let us not mention section 25 1, because that we confusing because there is no power and it there is only procedure here the power comes from 25 and say another section. Section 16 the answer will be section 15, because the power to refuse comes only from that provision.

(Refer Slide Time: 59:06)



Now, let us look at the rules there is only one rule and the rule was recently introduced by the 2016 amendment.

(Refer Slide Time: 59:16)



55 1 says representation for opposition under 25 1 shall be in form 7 A; 7 A was recently introduced at the appropriate office appropriate office is the office where the patent is pending and a copy to the applicant with the copy to the applicant and shall include a statement and evidence if any in support of representation and a request for hearing if so desired.

Now, with a copy to the applicant it could be understood as a copy to be sent to the applicant or it could be understood as a copy for the applicant to be filed. Now if you look at the 55 before it was amended it just said we will find that a copy to the applicant refers to sending a copy to the applicant, because otherwise the controller would have said or the act would have mentioned with filed in duplicate which means 2 copies or filed in triplicate this is the normal practice.

Now we are this was not the norm before earlier the controller used to forward the copy we will find that in the earlier provision 55 3 of the earlier provision meant that said 55 3 of the earlier provision mention that he shall give notice to the applicant to the effect along with the copy of such representation. So, there is the small change in procedure earlier the controller would read the opposition he had to be convinced and then he will forward it to the applicant now when you filed you have to serve a copy.

So, this is the change between the earlier law and the present law now when you file this form 7 A you have to serve a copy to the applicant and shall include a statement and evidence if any in support of the representation and a request for hearing. So, normally on opposition is accompanied by a statement and evidence statement and evidence is if you say that- this is anticipated by prior art that is a statement you have to make that statement you have to mention the number of the specification the prior art and you will also have to keep the evidence the evidence will be the prior art document. So, statement and evidence is statement is the allegation that something is covered by a ground of opposition mentioning what that something is and evidence is the document that you are relying on.

So, you cannot say that this is anticipated by a publication made in the US 10 years ago without producing that. So, that is the evidence; evidence is production of the document statement is an allegation that you make a factual allegation one a notwithstanding anything contains in sub rule 1, no patent shall be granted before the expiry of a period of 6 months from the date of publication of the application under 11 a now we know that once it is published only then you can file a pre grant opposition we saw in the languages 25 1 after publication of the application till anytime before the grant that is the window period this specifically says you should not grant a patent within 6 months of publication no patent shall be granted before the expiry of the 6 months from the date of publication which simply tells us that you cannot grant a patent within 6 months of publication and

even if say in after publication in 3 months the application is made ready for a grant assume in and there is a pre grant opposition filed within that window period in 3 months.

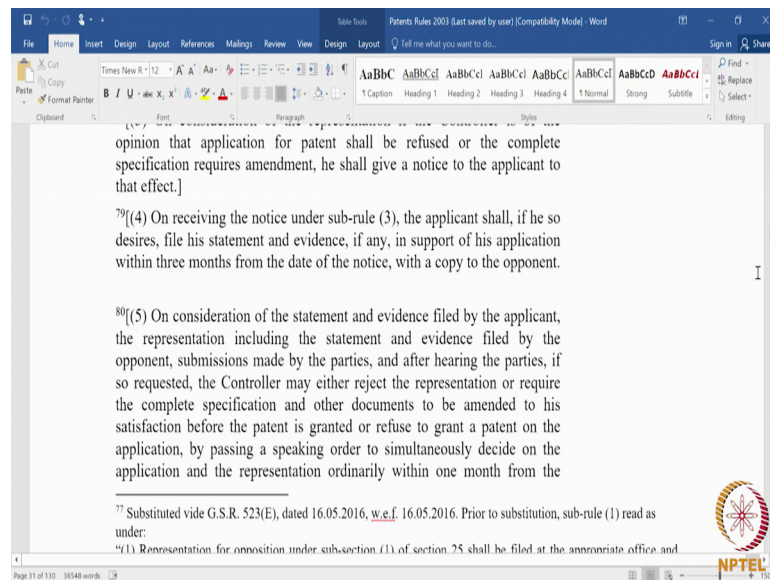
You still cannot grant it without waiting for 6 months the idea behind this is you get a 6 month window period for definitely filing pre grant positions you understand if you say what is the safe period for filing a pre grant opposition it is 6 months from the date of publication because the rule says 1 a you cannot grant the patent office even if it wants to do a fast track or expedited examination still it cannot grant there is a statutory prohibition that it cannot grant within 6 months.

So, somebody asked you what is the safe period for filing a pre grant opposition and the multiple choices are 6 months from the publication of the application anytime after the publication of application, but before the grant 6 months before the grant or any other choice of that nature which is related to which is meant to make the decision making difficult then the answer we will be the safe period we are not saying there could be a risky period the safe period is 6 months because of 11 1 a.

So, within 6 months you know for a; you know for sure the patent we will not have been granted 7th month it could get granted. So, the best practice for filing opposition is keep track of the official journal if something is granted work on it for the next 6 month if something is published work on it for the next 6 months and file your pre grant do not wait beyond that because the safe period is 6 months.

Why do we call it a safe period because during that time a patent we will never be granted 2 consider such representation only when a request for examination of their application has been filed?

(Refer Slide Time: 65:11)



Now, we saw that a request for examination can be filed either by the applicant or by a person interested they their though language used first interested person. Now here it says an opposition shall not be taken into consideration till and request for examination is filed which means till the application is taken on prosecution that is why prosecution starts the patent office starts looking into it pre grant opposition is not a concern for the patent office.

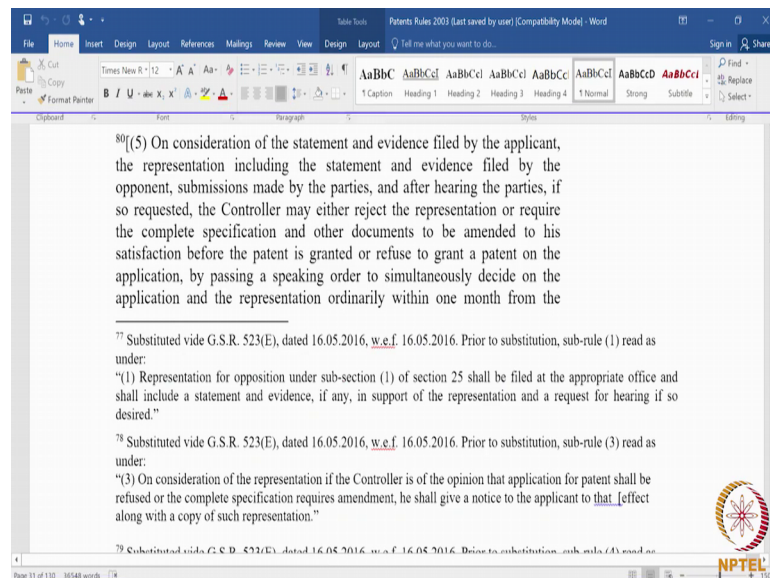
So, this says it will only start. So, so if an applicant files an application and tries to extend the time for examination till the end an opponent who wants to expedited can file a request for examination on the face of it you can say that- you can file and in the statement you will say that I want to oppose this I do not want this to go through the forty 8 period or whatever period then I want opposite quickly.

So, the moment it is published the opponent technically going by the wording of the act and the rules the opponent can take an application request for publication and he could ask the application to be examined. So, that his opposition can be taken up 3 on conservation of the representation of the controller is of the opinion that applications for patent shall be refused for completes specification requires amendment he shall give notice to the applicant to that effect. Now he considers the pre grant opposition the statement and the evidence and he need not bother the applicant if the pre grant opposition is not substantive.

There are some grounds raised, but the grounds are not relevant he will not even communicate it he can just throw away the pre grant opposition, but if he feels that there is an in his opinion if is of the opinion that it can be refused or it requires an amendment then he will notify the applicant. So, what is the condition for a notice to be issued by the controller to the applicant in his opinion he should feel that there is a ground for refusal or a ground for amendment if there is no of opinion if he does if we forms an opinion that the patent is strong and it is beyond the pre grant opposition he may not even give notice to the applicant.

Four on receiving the notice under sub rule 3 the applicant shall if he. So, desires file his statement and evidence this is different from the statement and evidence file by the opponent if any in support of his application within 3 months from the date of notice with the copy to the opponent. Now copy to the opponent means the copy sent directly to the opponent not through the patent office. So, he gets the applicant gets 3 months to defend the pre grant the pre grant opponent gets 6 month to file the pre grant the applicant gets 3 months from the day he receives the notice.

(Refer Slide Time: 68:21)



Now, 5 on consideration of the statement and evidence filed by the applicant the representation including the statement and evidence filed by the opponent submissions made by the parties and after hearing the parties. So, if there is a hearing requested he has to hear the parties if. So, requested the controller may either reject the representation

by representation we mean the opposition and require the complete specification and documents to be amended to a satisfaction before the patent is granted. So, he can reject the opposition require amendment and grant the patent or refuse the grant on the application by a speaking order.

So, wherever an controller refuses an application pursuant to a pre grant opposition there has to be a written order a speaking order. Speaking order is just not a written order he gives the decision, he gives the reasons for us decision a speaking order is a recent order with reasons to simultaneously decide the application and the representation ordinarily within one month from the completion of the above proceedings.