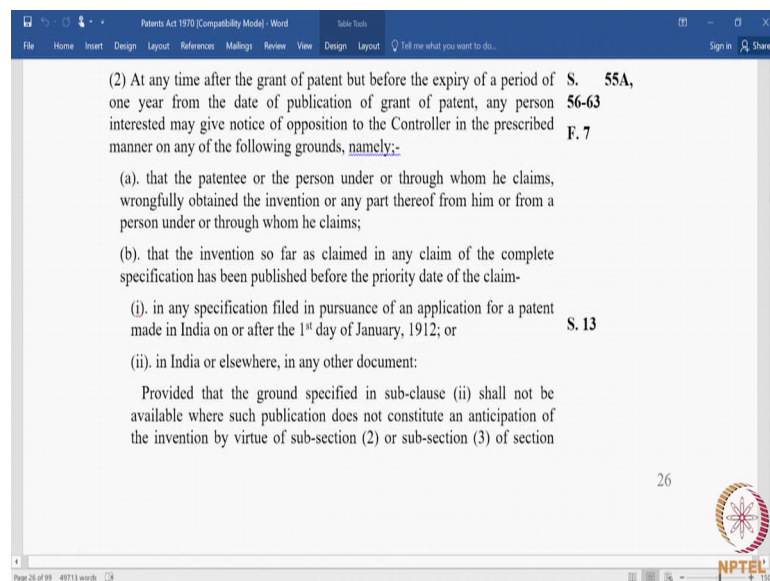


Patent Law for Engineers and Scientists
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Lecture - 42
Patent Prosecution: Opposition
Post - Grant Opposition

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Opposition after the grant of the patent: we had just seen how opposition operates before the grant of a patent what we commonly call pre grant opposition and we had also mentioned the grounds of pre grant opposition are the same when it comes to post grant opposition or opposition after the grant of the patent, but the only difference is that these grounds will now be applied to a granted patent. In pre grant opposition the same grounds were applied to a patent that was in the applications form that is the patent application, a grant had not materialized which means the patentee did not have the rights of a patentee he did not have any rights that were conferred by the patent. But it was still in the application stage.

Once it moved from the stage of application now there is a grant. So, there are certain conditions that will change the grounds remain the same, but the point of intervention of the ground is post grant it happens after the grant. But the rights of the parties are now different. In pre grant opposition the opponent was questioning something that would

materialize into a right it had not had materialized into a right the application is still in the process of prosecution and the opponent has raised various grounds for challenging it and because the opponent is seen as a person who aids the examination those are the words of the Delhi high court.

The opponent is a person who aids the examination the question of burden of proof could be different when we have post grant opposition because an opponent in a pre grant opposition does not have a party status. He is not a formal party and the proceedings are not regarded as proceedings between two parties a pre grant opposition is not regarded as a proceeding between the opponent and the applicant it is not. So, we understand the status of an opponent has been different in pre grant and post grant and because the status of an opponent is different the burden of proof by which we mean the burden to discharge or prove the case is also different.

Now, we will understand these things as we look at the procedure of post grant in greater detail, but the grounds tend to be the same. Now let us look at the provision 25 - 2 deals with post grant opposition. Now 25 tells us at any time after the grant of a patent, so the time for filing a post grant of opposition is the prerequisite is the patent should have been granted. Now how does the post grant opponent come to know about the patent grant? Obviously, the grants are published in the official journal. So, what is published in the official journal as a granted patent which means a patent will now have a patent number? Earlier in pre grant opposition there is no patent number there is only an application number by which the application is known.

So, in this case it has already been published and the publication of the grant happens in the official journal that is kept by the patent office, the official journal is an online journal now it is the online version is published every Friday. At any time after the grant of the patent, but before the expiry of a period of one year from the date of publication of the grant of patent, just how we saw a window period for pre grant opposition there is a window period for post grant opposition also. In the post grant opposition the window period starts from the grant of the patent. And the grant of the patent has multiple meanings it could be as granted at the patent office it could be the certificate that is issued to the patentee that could also it is also part of the grant it could be the publication of the grant in the official journal.

So, here what is being referred to as grant of a patent is the publication of the grant in the official journal. So, if you look at the official journal the online copies are available you will find at one section of the official journal all the grants are published, all the patents that were granted in that week will be published with their patent number what were the number is. So, the grants are known by the publication the publication in the official journal is a means by which the grant or the fact that a patent is granted is communicated.

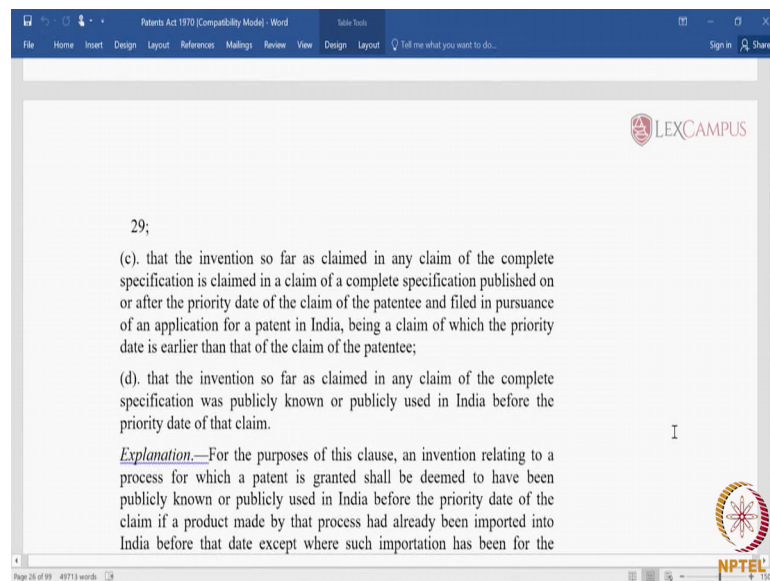
So, that is the time by which we determine the window period for filing a post grant opposition. So, from the date of grant as published in the official journal till a 1 year before the expiry of a 1 year period from the date of publication of grant again in the official journal a patent can be a opposition to a granted pattern can be filed what we call a post grant opposition. So, post grant opposition the timeline opens from the date of grant and the as I said date of grant means many things, but from the date the grant is communicated to the world at large to third parties which is publication in the official journal what you call the date of publication of grant that is a word used here.

You have a 1 year time period for filing a post grant opposition. So, the window period starts from the date of publication of grant it extends upto 1 year and the publication of grant is known by the publication of the official journal the provision of the act is silent we understand that from the practice. The section continues. Any person interested may give notice of opposition to the controller in the prescribed manner on any of the following grounds namely you need not worry the ground, because the grounds are the same we will just quickly go through the grounds are the same as we discussed in pre grant opposition only thing now they are going to be applied after the grant, so the point at of intervention the point at which this grounds are going to applied are now going to be after the grant.

The status of a person who can file a post grant opposition is a person interested and the person interested is defined under the act the definition of a person interested is already there in section 2 this is defined in section 2. May give notice of opposition your notice of a position is given in form 7 you can see the cross reference there F 7 to the controller in the prescribed manner on the following grounds. So, we find that there is a procedure there is a notice that has to be issued and when you look at the fees there is also a fee that the opponent has to pay. So, there is a fee for filing post grant opposition.

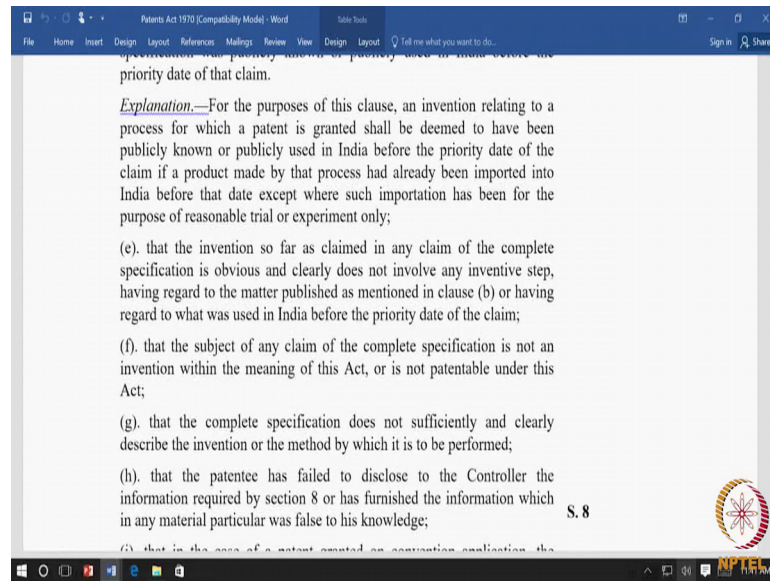
The status of a person is slightly different because you will find that in pre grant opposition we saw that any person could file a pre grant opposition whereas, here it is any interested person. Now what are the grounds? The first ground a that the patentee or other person under power through whom he claims wrongfully obtain the invention these are the same ground for pre grant opposition as well, b that the invention as claimed in any claim of a complete specification has been published before the priority date this is anticipation by prior claim in a specification or any other document.

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So, anticipation by prior publication published before the priority data, c is anticipation by a pending application we saw a similar ground in pre grant opposition as well. 4 that is d is anticipation by prior knowledge or prior use publicly known or publicly used.

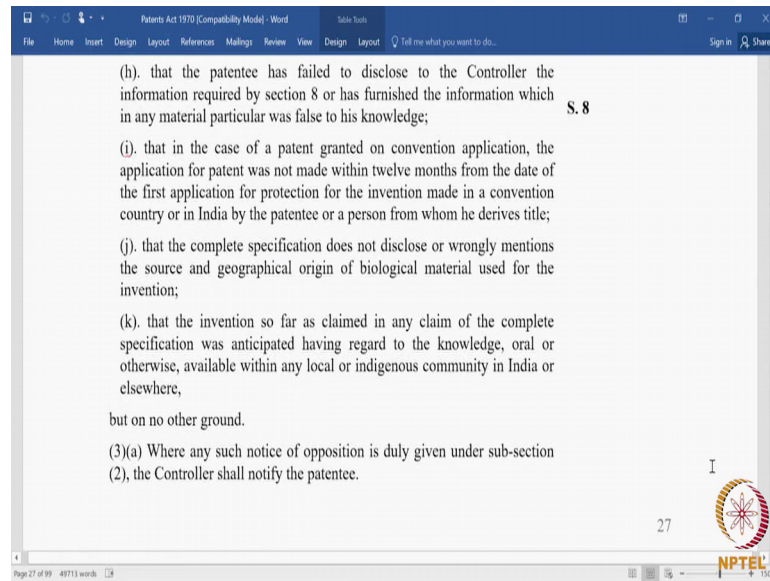
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Then e is lack of inventive step fact that what was claimed was obvious to a person skilled in the art or did not involve an inventive step it just mentions obvious here, but we understand that obviousness is a standard that is determined from the viewpoint of a person skilled in the art.

F the subject matter of any claim is not an invention within the meaning of this act or is not patentable under the act section 3 section 4, g that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed the requirements under section 10, so is the requirements under section 10 are not satisfied it could be a ground for post grant opposition as well. H the patentees fail to disclose information under section 8 that is filing of form three or he has furnished information which is in any material particular was false to his knowledge. Again we mention this as ground that is tied to the conduct of a patentee in pre grant this tied to the conduct of an applicant in this case it is straight to the conduct of a patentee.

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In case of the patent granted on convention application the application was not made within 12 months of the first application or the basic application, this is preserving the timeline in filing international application. So, if a basic application was preferred abroad and it is followed up by a convention application and it enters India through a convention application the timeline of 12 months was not honored or the patentee filed beyond 12 months.

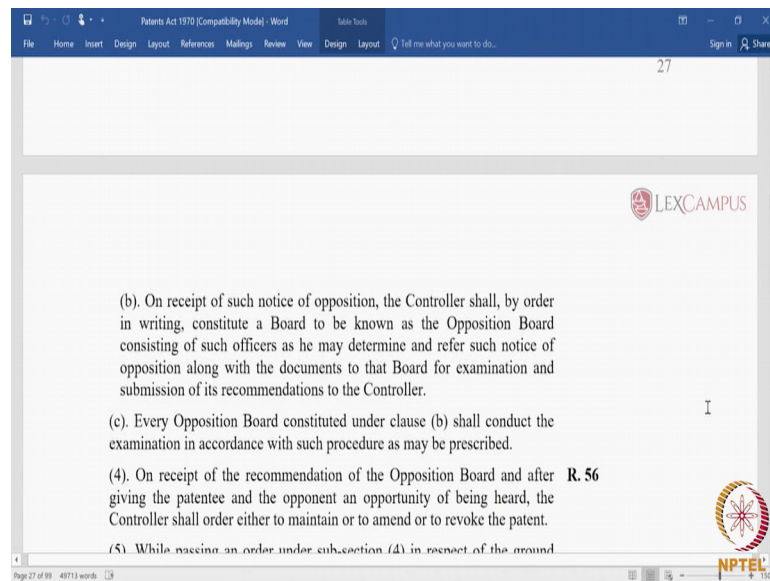
Now, this becomes a ground of opposition in post grant means that the patent has already been granted the patent office has overlooked the fact that the convention application timeline was not kept, but still it is open for the post grant opponent to raise this as a ground. So, that if the patent office had by oversight granted the patent it could be a ground for revocation. If the patent specification does not disclose or wrongly mentions the source and geographical origin of the biological material, k what was claimed was anticipated having regard to knowledge oral or otherwise available with any local or indigenous community in India or elsewhere what could generally we call anticipation by traditional knowledge. But on no other ground it just concludes with a 2 k and it says there cannot be any further ground than these grounds.

Now the procedure for post grant opposition as we mentioned is different from pre grant opposition. In pre grant you had only one rule which determine the entire procedure we saw that rule 55 was the only rule and earlier there was no form for filing a

pre grant opposition, but after the 2016 amendments to the patent rules they have introduced form 7 a. So, form 7 a was introduced recently.

So, now you have a form again pre grant opposition is without fees whereas, post grant opposition the procedure is more detailed and you also have payment of fees. Now 3 tells us about what happens when a post grant opposition is filed 3 a, where a notice of opposition is duly given under subsection 2 the controller shall notify the patentee.

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So, once a notice of opposition is given the controller will communicate that to the patentee there is no room for the exercise of the controller's discretion. Whereas in pre grant opposition we saw that in rule 55 three it is mentioned that on consideration of the representation if the controller is of the opinion that the patent shall be refused or complete specification requires amendment he shall give notice to the applicant to that effect. So, the controller's opinion is important in pre grant opposition he will give notice to the applicant only if the controller forms an opinion that the patent shall be refused or the complete specification requires an amendment.

Exercise of his opinion is not required when it comes to post grant, the fact that a post grant opposition is filed the notice goes to the patentee, b on receipt of the notice of opposition the controller shall by order in writing constitute a board to be known as the opposition board consisting of such officers as he may determine or refer to such

notice of opposition along with the documents to the board of examination and submission of its recommendations to the controller.

Now, this is yet another new feature which is not found in pre grant opposition the controller on receipt of notice of opposition has to constitute a board, a board comprising of three examiners, you will find the details of what the board is. Now the board comprises of examiners who the constitution of the board and its proceedings are spelt out in detail in rule 56. So, we will come to rule 56 soon. So, this is a significant departure in procedure from what we saw in the pre grant opposition, in pre grant opposition there are only three entities to participate in the proceeding - one the controller, two the applicant whose application is in question and three the pre grant opponent.

Now, you saw that the grounds of pre grant and post grant are the same. So, the question that you may ask is that why do we need post grant review because if the grounds are the same and the office before which the grounds are going to be raised that is a patent office continues to be the same what is the need for a post grant opposition because if the patent office is already decided a pre grant and it has come to a decision to grant the patent why should the patent office again entertain on the same grounds and probably on the same material another opposition.

Now to get over that technical objection- probably to get over that technical objection you now have another layer of review which is through the opposition board. So, in a normal case there is a controller who issues the statement of first objections there is an examiner who assesses the controller and this completes the process, but in post grant there is an entirely new set of examiners three of them who have not seen the application before, so they were not a party to the grant, they were not a party to prosecuting the application which happened before the grant there is an entirely new set of people three examiners who constitute the opposition who come up with an opinion on the granted pattern. So, this is the distinguishing feature the grounds are not distinguishing feature there are three examiners who constitute a board who will now come to a conclusion as to whether the grounds raised in the notice of opposition have a case against the patent.

So, this is how by looking at the policy and by looking at the law we can justify the existence of post grant opposition because the grounds are the same, the invention is the

same, the office is the same. The only thing that is going to be different here is that there is an extra layer of scrutiny by the opposition board. C every opposition board constitute an under clause b shall conduct the examination in accordance with such procedure as maybe prescribed and we saw that the procedure we will soon see that the procedure is what has been prescribed in rule 56.

4 on receipt of the recommendation of the opposition board, so the word recommendation is important because the function of the opposition board is to make a recommendation to the controller. So, when we say the opposition board makes a recommendation the opposition board's recommendation need not be binding on the controller because we understand there is a hierarchy in the patent office, the examiner's report to the controller. So, the examiner's report can at best have a recommendatory effect on the controller it cannot be binding on the controller. So, it is a recommendation. Just like examiners report will constitute a recommendation to the controller similarly the opposition board which is nothing, but a group of three examiners they would make a recommendation after studying the documents.

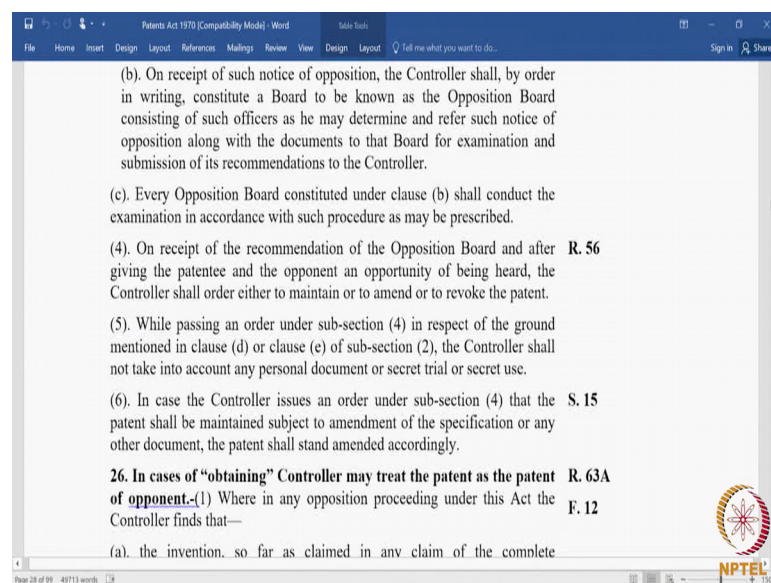
On receipt of that recommendation of the opposition board and after giving the patentee and the opponent in opportunity of being heard the controller shall order either to maintain or to amend or to revoke the patent. Now these are three things that can happen to any patent whenever an objection is raised, the objection could be raised under section 15, the objection could be raised under opposition under 25 - 1 or a objection could be raised at the patent office under section 25 – 2. In all these three cases wherever an objection is raised the patent office can overcome then objection and maintain the patent if the patent is granted, if it is not granted it is in the application state it meant it may grant the patent. So, maintain or grant.

2 is something is wrong the patent office can ask the applicant or the patentee to amend, 3 it can revoke the patent or reject the application. So, maintain amend revoke would also mean grant amend or reject the application if it is in the application stage we would say that three things can happen the controller can ground the patent the controller can amend the patent, the controller can reject the application. When it is a granted patent we say that the controller can maintain the patent because it is already granted by overcoming the objections, the controller can amend the patent if something is wrong and something can be corrected or the patent controller can revoke the pattern.

So, on receipt of the recommendation of the opposition board the controller has to hear the parties the patentee and the opponent and then the controller has to pass order. So, this is the procedure of a post grant opposition. A notice of opposition is filed with the statement of opposition and evidences the patentee has an opportunity to reply to that within a timeframe if the opponent has rejoined the if yes reply to the patentees reply he is given time to do that then the controller fixes a date of hearing there is a hearing both the parties are heard and the controller gives an order in writing.

Now, before the controller fixes the date of hearing the controller also makes a reference to the opposition board he constitutes an opposition board comprising of three examiners and they submit a report what is called the submit a recommendation to the controller. So, this is the procedure.

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Fine while passing an order under sub section four in respect of the ground mentioned in clause d or clause e of subsection 2 the controller shall not take into account any personal document or secret trial or secret use. Now this is with regard to anticipation d mentions if you look at 25 - 2 d it refers to one of the grounds of anticipation 25 - 2 d publicly known or publicly used in India anticipation by prior knowledge or prior use.

And e is inventive step lack of inventive step and in do it this provision mentions that in these two cases the controller shall not take into account any personal document or secret trial or secret use. Now trial secret use personal document by which NPTEL mean something

which is capable of kept as a confidential information. So, anything that is confidential between parties they are bound by a non disclosure agreement or something which is not meant for public disclosure like notes kept in a private diary these things cannot be used for proving anticipation or lack of inventive step.

So, this when we come to section 64 we will see the details of what kinds of personal documents are excluded what the secret trial and secret use and we also have some exceptions in anticipation that if you test something or if you experiment something before launching it then that test if it can only be done in a public space like a certain instruments can only be used or experimented in the public space then there is a protection that comes to you by way of a grace period.

So, in India we do have grace period there is a provision for beta testing things and we also now have a judgment which says that beta testing software would not disclose or would not kill the or will not anticipate the invention this is the yahoo case which was decided by the intellectual property appellate board. So, the controller will exclude any personal document or secret trail or secret use before determining anticipation by prior knowledge or prior views and determining invented step obviousness or lack of or lack of inventive step.

6, in case the controller issues an order under subsection 4 that the patent shall be maintained subject to amendment amend of the specification or any other document the patent shall stand amended accordingly. Now whenever the patent is amended the patent in force becomes the amended patent. So, amendments as we know are of different types there are various amendments that can happen to the application and all those things are not published because what has published is at the time of grant, but any amendment that happens after a grant needs to be specially published. So, if you look at the official journal you will also find that amendments carried out after the grant are published. Now amendments carried out after the grant can come by various means it could come pursuant to an objection raised under section 55 - 2 post grant and there is an amendment.

But when amendments happen after the grant they need to be separately published. It could also come in a revocation proceeding under section 64 say that as the revocation application filed before the intellectual property appellate board and post went to the

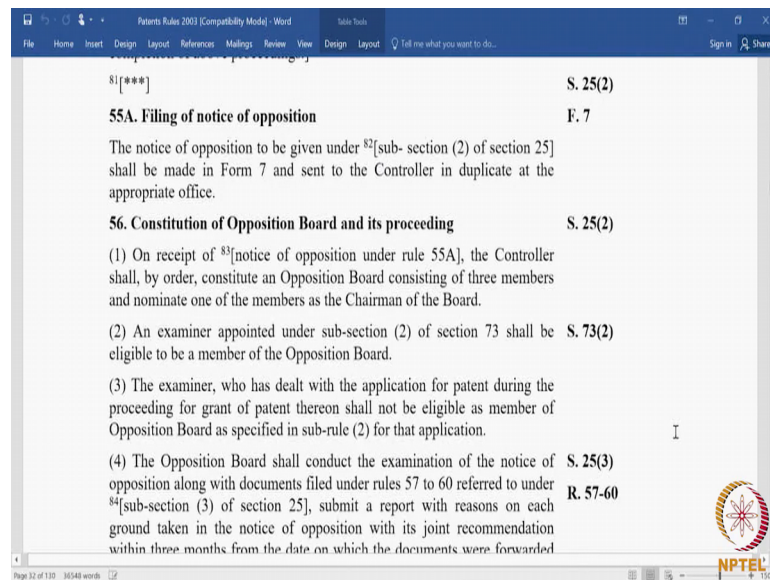
ground raised under section 64 the intellectual property appellate board amends the patent or allows an amendment and sustains the patent. Now again that should be published and when the intellectual property appellate board allows an amendment the patent will be the patent as it stands amended.

So, for all practical purposes for determining infringement for invalidity analysis it will be the amended patent that will be, that will be considered as the patent in force. So, that is what this statement says the patent shall stand amended accordingly. If the amendment happens before the controller then it is an in house affair it happens within the patent office which is also the fees where the register has kept which is also the place where which publishes the amendments through the official journals.

So, publishing the amendments done after the grant at the patent office there is a procedure and it will normally get done, but amendments that happened before the high court in an infringement trial where in invalidity counterclaim of invalidity is raised all the amendments that happened before an itb in a revocation proceeding needs to be communicated. So, many a times even a patent is amended by the intellectual property appellate board you will find a direction to the controller to complete the formalities of the amendment which means publication correcting the register and other official things which the controller would normally do if the amendment way to happen within the patent office.

So, understand amendment after the grant can happen before the parent office for instance under section 25 - 2 it can happen in the high court in an infringement suit where the infringer that is the defendant in the patent infringement suit raises a counterclaim to invalidate the patent and pursuant to the counter claim the court allows the patent, but in an amended form or the amendment can happen in a revocation proceeding where the IPAB feels that rather than revoking the patent they would allow an amended version of the claim in the patent to survive. So, amendment could happen in three places, post grant.

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Now, let us look at the corresponding rules 55 a says that the notice of opposition shall be filed in form 7 in duplicate at the appropriate office now appropriate office is the patent has been filed. Now we saw that once a notice of opposition is issued the controller will constitute an opposition board, now the details of constitution of the opposition board are mentioned in 56, rule 56. If you look at rule 56, 56 - 1 tells us that on receipt of oppose notice of a post in the controller by order earlier we saw in writing which means there has to be a written order it is an office order, but it is a written order.

Constitute an opposition board consisting of three members and nominate one of the members as the chairmen of the board, three members are appointed as members of the board, and one person is the chairman. 2 an examiner appointed under subsection two of 73 shall be eligible to a member of an opposition board. Now 73, section 73 generally deals with examiners it is titled of controllers and other officers and in the patent office there are only two officers whom we need to know one is a controller and the subordinate officers who are called the examiners. Now, 73 - 2 says us that for the purpose of this act the central government may appoint as many examiners and other officers and with such designation as it thinks fit. So, we understand that the members of the opposition board are should be only examiners.

3 examiner who has dealt with the application for a patent during the proceeding for the grant of a patent their own shall not be eligible as a member of the opposition board as

specified in sub rule 2 of for that application. So, the members of the opposition board should not have been a party or should not have been a part of the examination process before the patent was granted.

So, we understand that in every patent before it gets granted there is a report generated by an examiner under section 12 and 13 that report if an examiner has worked on that report then he is ineligible he is disqualified from being in the opposition board. This is just to ensure that a fresh set of people a fresh set of examiners get to look at the case again.

4, the opposition board shall conduct the examination of the notice of opposition along with the documents filed under rules 50 to 57 to 60 referred to under sub section 25 3; sub section 3 of section 25. Submit a report, so they shall conduct an examination submit a report with reasons on each ground taken in the notice of opposition with their joint recommendation within three months from the date on which the documents were forwarded to them. So, there is a window period there is a report and in the report they shall cover every ground raised and more importantly it has to be a joint recommendation. So, they cannot be split opinions when it says that joint recommendation the rules actually want the opposition board to speak as one it has to be, so that is what they mean by a joint recommendation.

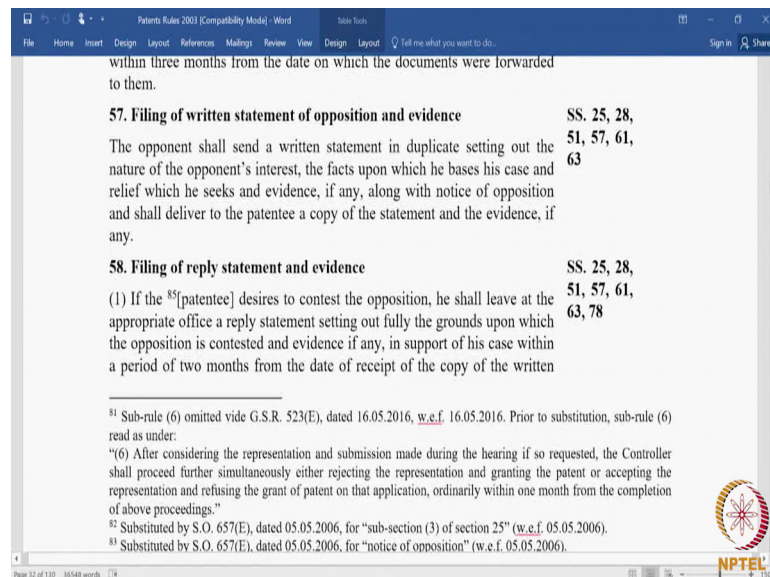
We have not seen instances where examiners is decent like how we see dissenting judgements given by judges, but in case there is a decent still the chairman's vote if the chairman takes we can expect if there are a group of three members we can expect a majority decision two people may give a decision and one way. So, there could be a major the decision. So, we have not seen any case to that effect, but when it is mentioned that it is a joint recommendation the understanding is that the opposition board speaks as one even if they do not speak as one at least there is a majority opinion. So, that is how we can justify the odd number of examiners constituting the opposition board.

So, the opposition board will look into the documents filed under rules 57 to 60 which is nothing, but statement of a position with evidences and reply of the patentee and the rejoinder or what or the opponent files on seeing the counter of the patentee. All these documents and evidence put together the opposition go, board will go through it submit a

report on every ground of a position whether this ground is valid invalid reasons and give it is joint recommendation.

Now this entire process has to be done within three months from the date on which the documents have forwarded to them. So, we understand that there is a timeline for filing the post grant which is one year after the grant of grant is published, then the documents are communicated by the controller to the other side the patentee then the controller constitutes about the controller also forwards the documents to them. From that point they have three months after they receive the documents to come up with their report.

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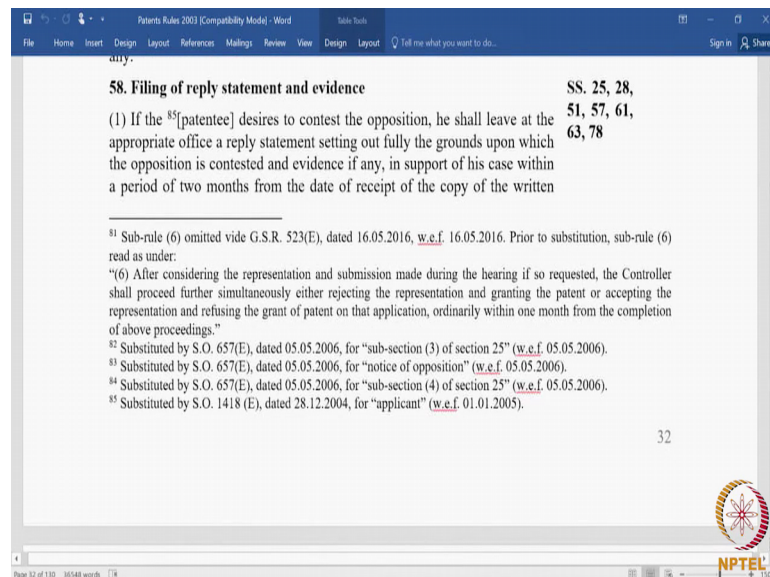
Now, how does the opposition start? A post grant oppositions with the filing of the notice of opposition rule 57 says that the opponent shall send a written statement in duplicate setting of the nature of the opponents interest that is important because in the written statement the opponent has to show that he is a person interested.

So, opponents interest is important opponents interest is not important or it may not be disclosed in the case of pre grant that this is tied to the status of a person this seems a pre grant can be filed by any person it does not requires demonstration of interest. The facts upon which basis seeks and the relief which he seeks and evidence if any along with the notice of opposition and shall deliver to the patentee a copy of the statement and the evidence if any. So, when the notice of opposition is filed the opponent also files what is called the written statement demonstrating his interest showing the facts on which he

basis his case bringing out the relief in most cases it will be to revoke the patent or in some cases it will be to revoke certain claims of an existing pattern which he seeks and evidence.

So, these four things have to be spelt out in the written statement and it has to be filed along with the form 7 which is the notice of opposition. So, what are the four things that the written statement should contain? One an opponents interest demonstrating that he is a person interested, the facts this should be a description of facts on which he basis case, he has to claim certain reliefs and he have to adduce evidence.

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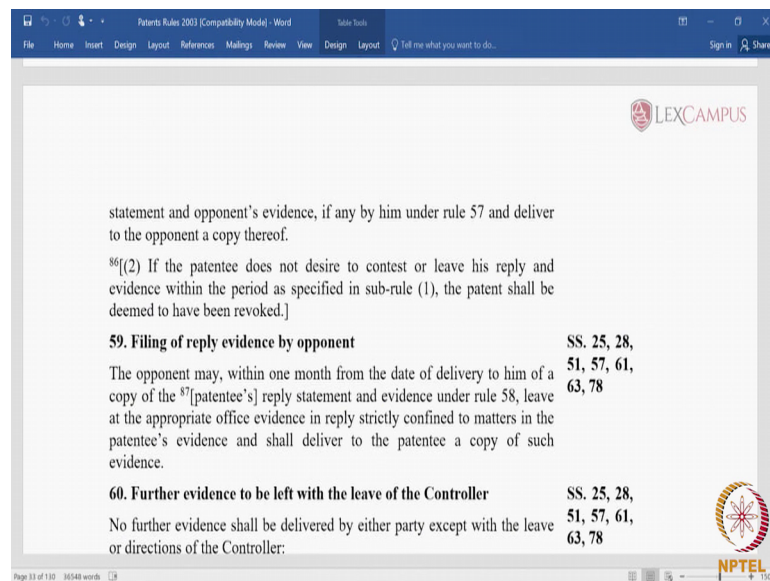


Now, once this is communicated to the patentee if the patentee decides to contest the opposition, now 58, rule 58 tells us what happens after this is done.

The opponent creates his case files all the documents and serves a copy to the patentee, it is easy to serve a copy to the patentee because the patentees name can be ascertained from the register, you could even go to the patent office website look at the details of grant and you will find the name and address of the patentee and the agent. So, you could serve to the last known address of the patentee or along with the last known address you could also which you take from the patent office website you could also serve a copy to the agents address as well.

If the patentee decides to contest an opposition he shall leave at the appropriate office reply statement setting out fully the grounds upon which the opponent is contested an evidence if any in support of his case within a period of 2 months from the receipt of a copy of the written statement and opponents evidence if any by him under rule 57 and deliver to the opponent the copy there of. So, when the patentee receives this statement of opposition the patentee can create a reply, now the reply will set out the grounds on which the opposition is contested along with the evidence.

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Now, if a ground of lack of inventive step is raised the reply will try to say that this is not obvious to a person skilled in the art give reasons for that and if the reply wants to rely on evidence the evidence will also be there for instance the patentee takes a ground that this is not obvious to a person in the art because the prior art was teaching in a different way. So, he will list of all the prior art before his invention to show that the current teaching was in a particular way and invention thought otherwise or the invention word uses teaches away from the prior art.

So, this the patentee will try to demonstrate and insert another objections the patentee will try to say that the scope of the claim is different and we saw that when we were looking at sections 17 and 18 we saw that the first approach of a patent attorney whose prosecuting an application will be first to convince the controller to his satisfaction that the invention is not anticipated. So, the first approach in prosecution is to convince a

controller that there is no anticipation, as the controller is not convinced then the second thing you would try to do is to amend your application.

So, how do you convince a controller that to his satisfaction that the invention is not anticipation anticipated you would tell the controller that this is not the relevant prior art one way to do it. Secondly, you would say that this could be the relevant prior art, but the claim in the relevant prior art when it is interpreted does not fall within the scope of the claim of your invention. So, you could go on claim interpretation to say that the scope of your claim is different from the scope of the claim in the prior art. So, that is another approach.

Third approach could be is the facts I love you to do that to show that your priority bi annually your disclosure either in a foreign country or by using the grace period you try to show that this prior art does not affect me because I am prior in time. So, there could be multiple approaches what you are doing in all these instances are trying to prove to the satisfaction of the controller that you are not hit by this ground. So, similarly when a patentee response to a post grant opposition the patentee tries to prove to the satisfaction of the controller that the evidence based on each ground opponent has raised does not affect (Refer Time: 38:30), does not affect the granted patent. For that he would make a statement to that effect and also adduce evidence and as I said depending on how you are going to prosecute the patent the evidence that you had used may change.

For instance the objection raised by the opponent is under section 25 - 2 f section, 25 to f allows you to take an objection to an invention under section 3 and section 4. So, if it is a pharmaceutical patent the patent has been granted and it covers a pharmaceutical substance assume that the opponent raises an objection that the patent as it is claimed in claim is covered under section 3 d. The patentee if he has not already done that the patentee can adduce evidence to get over an objection of section 3 d and he can give evidence to show that his product or the substance that is covered in his claim has enhanced efficacy compared to the prior art.

So, enhancement of efficacy you need to allow evidence if the evidence is or not already in place. So, we understand evidence by looking at the kind of objection that came from the opponent. So, the evidence will differ from different grounds and the patentee will have to counter each ground raised with his statement and with his evidence. So, the time

period given for this is two months from the receipt of the written statement from the opponent. So, this the patentee needs to do only if he wishes to contest the opposition.

Assume that in a case the patentee the after the patent is granted a few years of elapsed do the patentee has been paying the renewal fee and keeping the patent alive in the light of an objection the patentee feels that there is no need to keep this patent alive, he just receives the notice of opposition and as a business entity the patentee decides not to pursue it. So, a notice of opposition he has received the grounds. So, all the patentee needs to do is not file a reply if the patentee fails to file a reply then the path post grant opposition will proceed without the involvement of the patentee based on the grounds raised by the opponent and the evidence submitted by him the controller will decide the case even without the patentee. So, there is a provision for that.

So, it is not that if what happens if the patentee does not respond because the act the rules very clearly states that if the patentee decides to contest the opposition. So, if the patentee decides not to contest the opposition he will simply not respond to the opposition notice and the documents and the controller will go by the evidence that has been let in

58 – 2 tells us that if the patentee does not decide to contest or leave his reply the evidence within the period specified the patent shall be deemed to have been revoked. Now, deemed to have been revoked is probably used only once in the act and the rules here we see deemed to have been abandoned, a deemed to have been withdrawn there are various deeming provisions this is the only place where a patent is deemed to be revoked. So, in the sense that there is a challenge to an existing patent and you do not reply to it the controller will understand that you have given up your pattern. So, we had already mentioned the pattern system structure in such a way that any objection that come to you either from the patent office or from a third party if you do not respond to it, it is literally kind of a defense, if you do not defend the objection that comes there will be various deeming provision by which you would be assumed that you had given up your right.

So, we saw that if you do not pay the fees on time, renewal fees is on time then you would have been deemed to have abandoned your patent, if you do not respond to the objections raised by the patent office it will be deemed to have been abandoned under

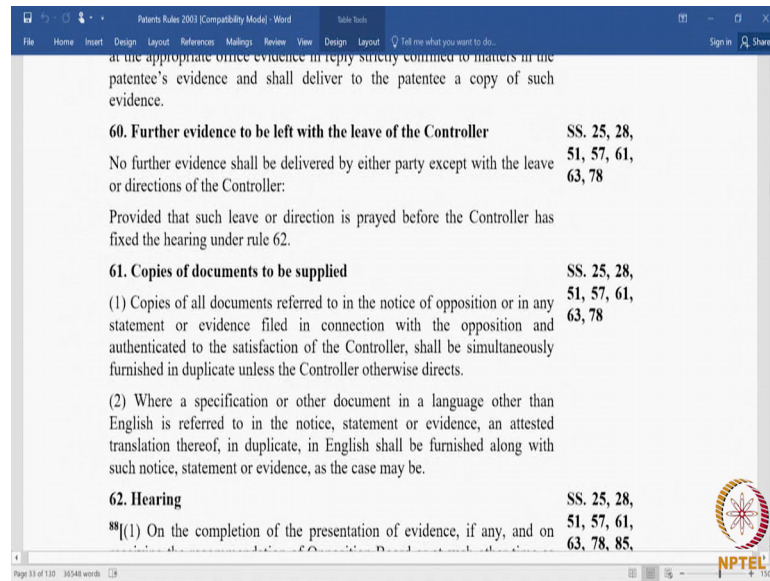
section 21, if you do not comply with the timelines stipulated by the controller the controller again deem that you have abandoned it, if you do not file a request for examination the controller will deem that you have withdrawn. So, all these provision tells us that whenever the ball is hit back to the applicant or the patentee there is a responsibility on the patentee to hit the ball back to the controller or to the whoever raise that objection.

If the applicant or the patentee fails to hit the ball back, so to speak then he loses the game. So, you understand that the pattern system is structured in such a way that the burden is always on the person who will benefit from a grant which is the patentee or the applicant.

59, tells us what happens if the patentee files his reply now if the patentee chooses not to contest it is deemed to be revoked, but he if he contest he files his reply within two months and sends copy on the opponent then the opponent gets a chance to file a reply to the patentee, that is in 59 we see that the opponent may return one month from the date of delivery to him of a copy of the patentees reply statement and evidence under rule 58. Leave at the appropriate office evidence and reply strictly confined to the matters in the patentees evidence and shall deliver to the patentee a copy of such leaves.

So, the scope of the reply is only to the matters that the patentee has raised. So, if there is a objection on lack of inventive step which the opponent raised and the only reply on that point by the patentee is that the prior art teaches in a particular way my invention teaches away from the prior art, then the scope in your reply is going to be only to that argument that the patentee has raised you cannot start a new case. That is what 59 tells us, you cannot start a new case because you can only give reply strictly confined to matters in the patentee's evidence.

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So, whatever the patentee has said with his evidence you have to strictly confine yourself to that. So, once that happens. So, let us go through the process again there is the opponent files his statement and evidence the patentee in return files his statement and evidence what we call the reply. So, opponent gets one more chance to file his reply to the patentee's statement and evidence that completes the process. 60, tells us further evidence to be left with the leave of the controller. Once these three steps are over no further evidence shall be delivered by either party except by the leave or direction of the controller provided as such leave or direction is prayed before the controller has fixed the hearing under rule 62.

So, once I have the process of exchanging documents and evidence and statement is over you cannot bring in new evidence because that once the controller moves into the hearing mode it will be very difficult for the controller to appreciate new (Refer Time: 46:26) and new documents coming in because in most cases documents can be technical in nature it may require time to read and understand them and it may also require some work to be done by the controller and by the opposition board.

So, there is a timeline given for (Refer Time: 46:44) evidence. So, once the process of submitting documents are over no further evidence shall be delivered the only case where the controller will allow is cases where the permission of the controller is sought for and the permission has to be sought for before the controller starts the hearing. So, it

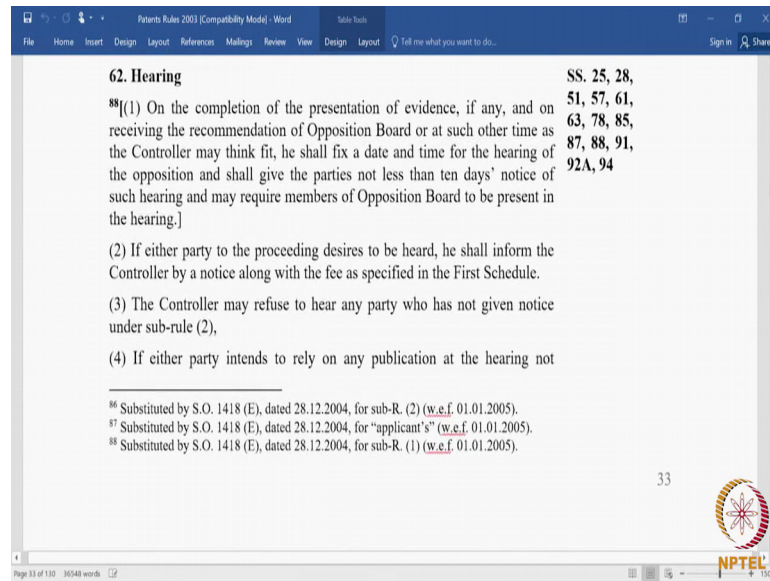
is very simple to understand because once the controller starts hearing the case or fixes a date for hearing if new documents or new evidence is put in it becomes difficult for the parties and the controller to read and come up to speed on those documents.

So, 61 tells us that copies of the document to be supplied one copies of all documents referred in the notice of opposition or any statement on evidence filed in connection with the opposition and authenticated to the satisfaction of the controller shall be simultaneously furnished in duplicate unless the controller otherwise directs. So, there is a all copies file have to be in duplicate where a specification or document in a language other than English is referred to in the notice statement or evidence and attested translation thereof in duplicate in English shall be furnished along with such notice statement or evidence as the case maybe.

Now, many a times we find that the patent would be objected based on a Chinese patent or a Japanese patent because the numbers of patents filed in China are definitely more than what are files in India. So, you could find a prior art in the form of a Chinese patent. Now normally if you do a prior art search the Chinese patent has it is abstract in English the abstract with sometimes is a machine translated abstract is available for search and if the terms in your claim maps with the terms in the extract the abstract will show the these terms or the invention the concept of an invention covered are covered in the abstract of a Chinese patent.

So, in that case you cannot nearly print the machine translation of the abstract and file it as a document in (Refer Time: 49:13) position, because under rule 61. If you are relying on any document in an language other than English you will have to get it translated first and get it attested and serve to the parties and the controller. So, any document in a language other than English needs to be translated and the translation has to be attested.

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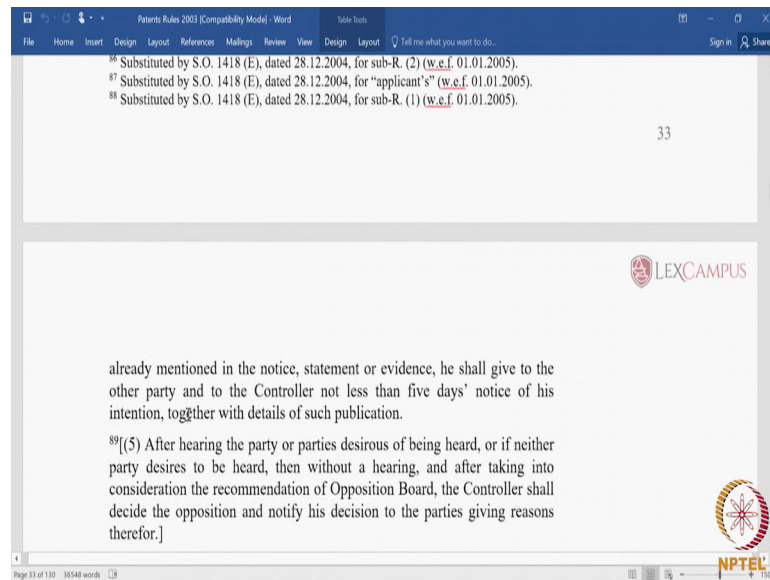
Hearing, now when the documentation is completed the statements file by all the parties are in place the evidence is completed there is no further evidence and any documents which requires translation the translated copies, the attested translated copies are all in place the controller will can now fix a hearing of the case. 62 – 1, tells us on completion of presentation of evidence if any and on receiving the recommendation of the opposition board or at such time as a controller may think fit he shall fix a date and time for hearing of the opposition and the parties 10 days notice and may require the members of the opposition board to be presented the hearing.

So, the evidence is complete, the recommendation of the opposite board has come in the path the controller shall fix a date of hearing and give 10 days notice and the controller also has the option of asking the members of the opposition board to be present at the hearing. Now why should he do that optional he may require just in case there are objections raised during the hearing which can be overcome by an amendment when an amendment is filed the controller can still pass the amendment back to the opposition board for the consideration or assume that new grounds of oppositions has been raised. The controller can get the benefit of a further recommendation from the opposition board.

62 -2, if either party to the proceeding decides to be heard he shall inform the controller by notice along with a c as specified in the first schedule. So, the controller issues notice

of hearing the parties will have to indicate if they are attending the hearing. 3, the controller may refuse to hear any party who has not given any notice under sub rule 2. So, a party who has not given notice under sub rule 2 which is has not informed the controller and does not pay the fee the controller may refuse to hear that person.

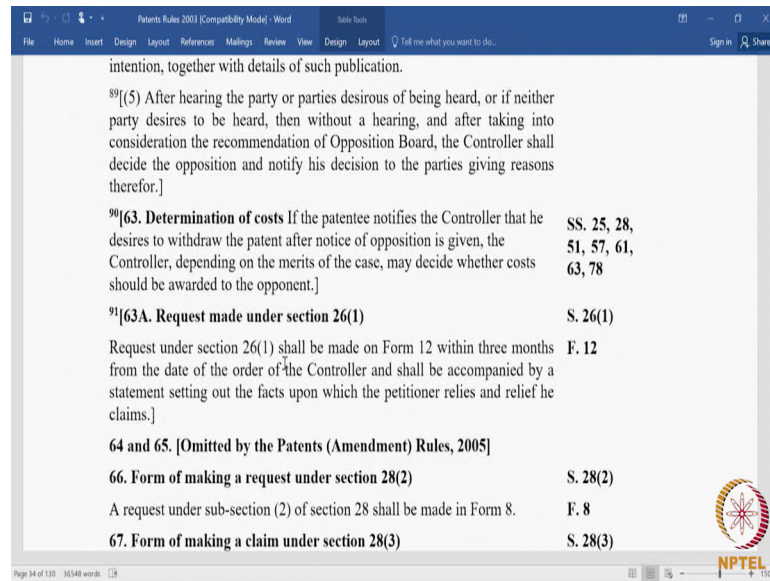
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Sub rule 4 says that if either party intends to rely on any publication at the hearing not already mentioned in the notice statement or evidence you shall give to the other party and to the controller not less than 5 days notice of his intention together with the details of such publication. Now we had seen that there is an end to the evidence, but after that point if a party wants to rely on publication at the hearing. So, there is a new document adduce which they had not given before then that party will have to give the controller and the other party 5 days notice, so that they can scrutinize the document and give their reply at that point of hearing.

Now, this is where I mentioned that having the opposition board sitting in the hearing may be useful. So, the controller can easily ask the opposition board to come prepared with their views with their recommendation on the newly introduced document, so this is on the introduction of new documents.

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5, after hearing the party or parties desirous of being heard or if neither party desires to be heard then without a hearing and after taking into consideration the recommendation of the opposition board the controllers had decide the opposition and notify his decision to the party is giving reasons thereof.

So, once an opposition is filed whether the parties come for the hearing or not the controller shall consider the recommendation of the opposition board and he shall give a decision which has to be in writing and the decision has to be communicated to all the parties.

Rule 63, if the patentee notifies the controller that he desires to withdraw the pattern after notice of a position is given the controller depending on the merits of the case may decide whether cost should be awarded to the opponent. Now, cost is something that is awarded to the succeeding party in a legal proceeding, if there is a legal proceeding between two parties party a and b, party a files the case against party b and party a succeeds he gets the release that he wants against party b, party a can because he is the succeeding party who succeeds party a can ask for legal cost, the cost of conducting the legal proceedings. So, in post grant opposition the opponent is entitled to cause if the patentee withdraws the patent after the opposition is given.

So, this is a clear provision that if the patentee withdraws patent after the notice is given then the controller has the power to decide whether the cost should be awarded to the

opponent. It is not an automatic process the controller will still look at the merits of the case and see whether cause have to be awarded. Now compare this with the earlier provision where the patentee chooses not to contest the case we saw that patentee has an opportunity to file his reply if the party does not file his reply under rule 52 to patent shall be deemed to have been revoked.

But if he withdraw his application in that case he is not withdrawing his patent, he is only not filing a reply to the opposition. If he fails to file a reply to the opposition it is deemed as though he has it is deemed that the patent is revoked, but under 63 if the patentee withdraws the patent that is a conscious act is withdrawing the patent after the notice of opposition is given and there is no procedure for withdrawing the patent there is no procedure. So, withdraw the patent it is there is a procedure for withdrawing an application and there is a procedure for surrendering a patent.

There is as such the word withdraw a patent there is no procedure for this, but assume that he withdraws it or he makes it clear that he wants to withdraw the patent and we can understand that withdraw after grant could be surrender that is one way to understand because there is no procedure of the drawing a pattern there is only procedure to surrender the patent or there is a procedure to abandon the pattern which is why not paying the renewal fees. So, we understand withdraw as a conscious act, not nonpayment of renewal fee is not a conscious act we are just letting something go away a deadline to go away.

So, if you withdraw it we understand withdraw as surrender. So, if a question is asked how do you surrender a patent or what is meant by withdrawal of a patent under rule 63 and if the choice has surrender of patent then that would be the appropriate answer because there is no other procedure by which you can we draw the patent.