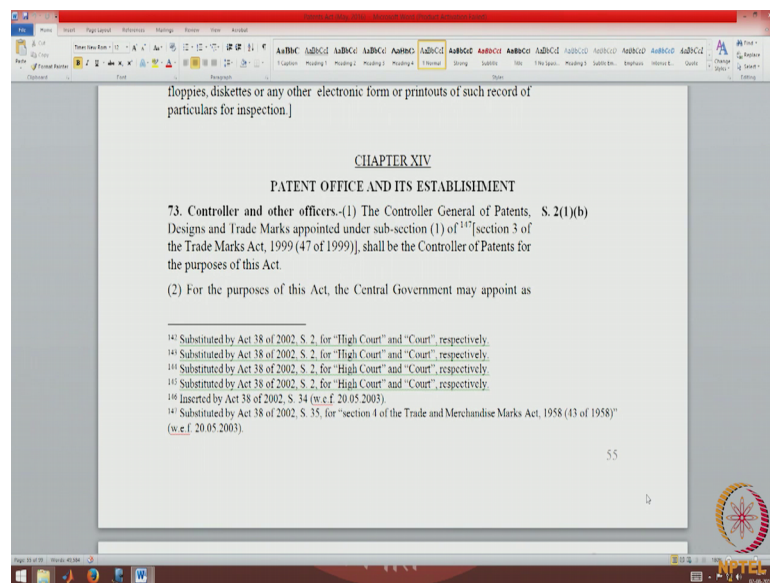


**Patent Law for Engineers and Scientists**  
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**Lecture - 56**  
**Patent Office and Patent Prosecution**  
**Patent Office and its Establishment**

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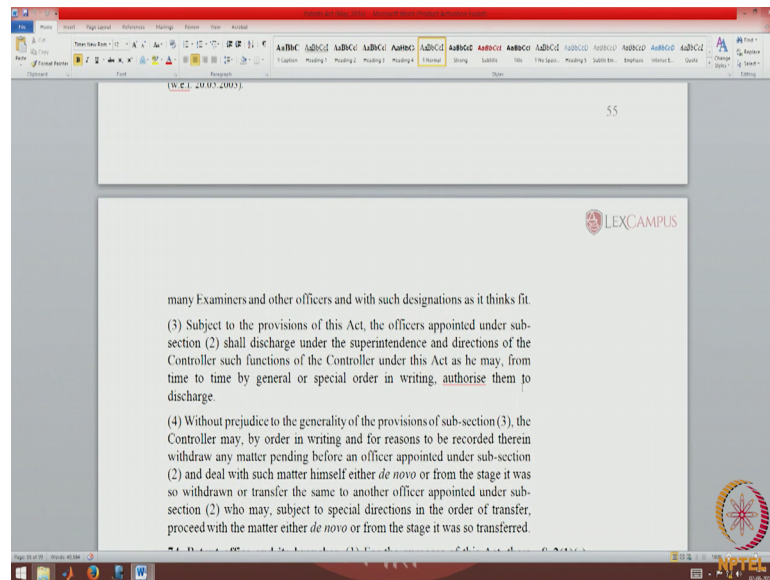


Patent office and its establishment. Section 73 deals with the 2 kinds of offices who man the patent office, the controller and the examiners. Section 73 tells us that the controller general of patents designs and trademarks appointed under section 3 of the trade marks act 1999 has it was amended shall be the controller of patent for the purpose of this act. So, the controller general for patents is the same person who is the controller general for patents designs and trademarks. So, it is a joint port folio and the person who holds the port folio of the controller general of patents design and trademarks shall be refer to as the controller of patents when it comes to the matters or the duties he has to discharge under the patents act.

So, the designation control a general of patent designs and trademarks, is the common designation and that was created under the trademarks act 1999. So, that person shall continue to hold the position of a controller of patents. In fact, if you see the patents act in every place the controller was refer to as a controller of patents. But in reality the

controller of patent is also the controller of designs and the controller of trademarks. 2 for the purpose of this act the central government may appoint as many examiners and other offices and with such designations as it thinks fit.

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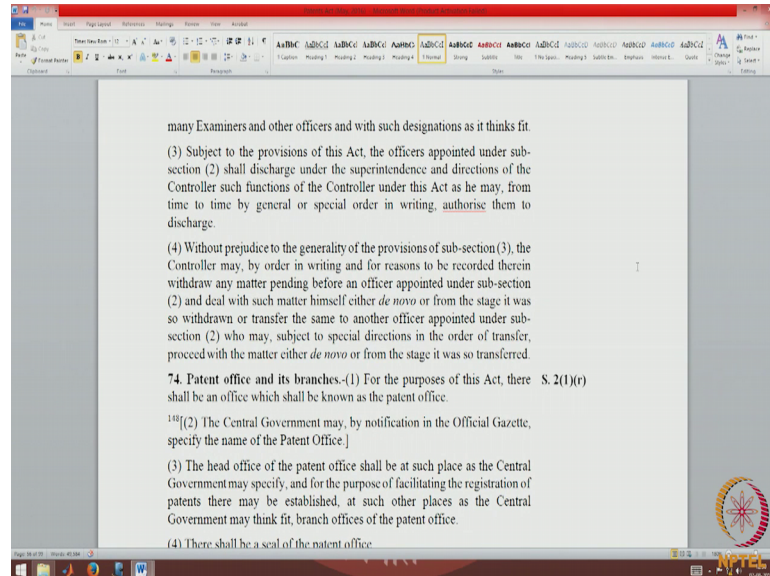
So, we have controller and we have examiner. So, these are the 2 deferent types of officials designated officials who man the patent office. Now controller could be a deputy controller could be a assistant controllers they could be other levels of controllers and examiners are people who are subordinate to them and who report to the controller.

Now, the controllers have specialized expertise, because the patent office has various expertise mechanical inventions are examined and scrutinize by group of examiners who report to a controller. Chemical inventions have a different group of examiners all specialize in that field. They all report to a controller whose specialty is also in that field. So, similarly you will find that the patent office comprises of groups were examiners who have a particular whose specialize in a particular area report to a controller whose specializes in that area. 3 subject to the provisions of this act officers appointed under subsection 2 shall discharge under the superintendence and directions of the controller such functions of the controller. Under this act as he may from time to time by general or specific order in writing authorize them to discharge.

So, the examiners we understand from this provision shall be under the superintendence and directions of the controller which means the examiners are subordinate to the

controllers and the examiner's report to the controllers. And the controller is allowed from time to time to give specific instructions in writing what we call orders.

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They can be general orders and special orders authorizing them to discharge their duties. 4, without prejudice to the generality of provisions in subsection 3 the controller may by order in writing and for reasons to be recorded therein withdraw any matter pending before an officer appointed under subsection 2 and deal with such matter himself either *de novo* or from the stage it was So withdrawn or transfer the same to another officer appointed under subsection 2 who may subject to special directions in the order of transfer proceed with the matter either *de novo* or from the stage it was So transferred.

This is a very simple administrative provision were the controller because he is the superior authority has the power to withdraw any file from a junior officer we understand that is an examiner. And either the proceed with it himself or transfer that file to another examiner. This could be done for various administrative reasons it could be done for managing the work load it could be done to if there is an expedited examination. And something is to be done quickly this are administrative manners, but this gives the power to the controller to take any matter that is pending before say examiner a and transfer it to examiner b or examiner c.

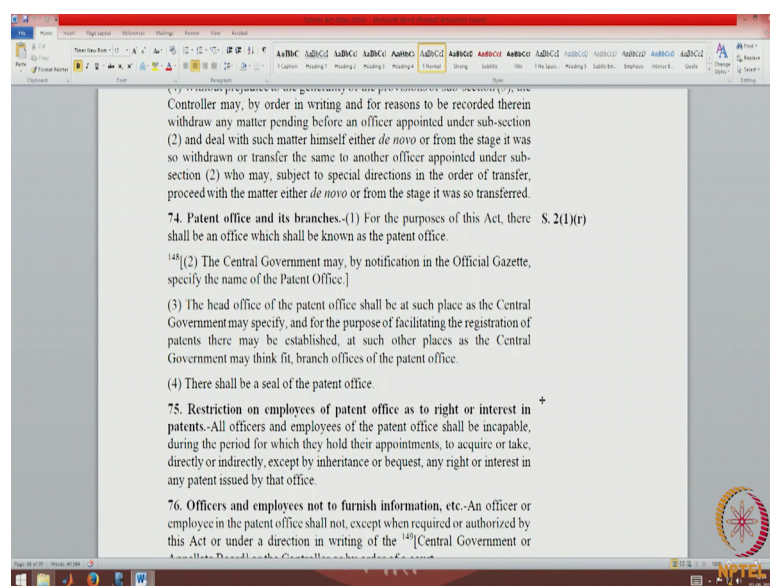
Alternatively the controller can take the matter from examiner a and decided himself, because he has all the powers the controller is empowered with all the powers an

examiner is entitled to do. The examiner can search and file a report, but the controller is the one who is going to work on the report work up to the report and make a first examination report or a first statement of objection. So, the controller in effect can do everything that the examiner can do. So, he could take a file either look into the file on his own and do whatever needs to be done or he can allocate the file to another examiner.

Now when a file is taken probably the examiner has already done some work say his report on section 13 is over or just some a little bit of work is left or he has raised an objection under section 14. Or if the examiner has already given a report and there is a reply to the first examination report the examiner is now about to raise further objections based on the reply filed by the applicant, could be many scenarios. Now the controller can either start a fresh saying that all the work the controller did does not matter I will start de novo, de novo is to start a fresh he can start from scratch or he can start from this stage where the examiner had left.

So, these 2 powers are given to the controller, he can if he takes up the matter he can do these 2 things on his own he can start a fresh or he can continue with the stage in which it was left. Or if we want to assign the matter to examiner b to another examiner that examiner can also be directed to start a fresh de novo means starting a fresh starting from scratch or to continue from the stage in which it was transferred.

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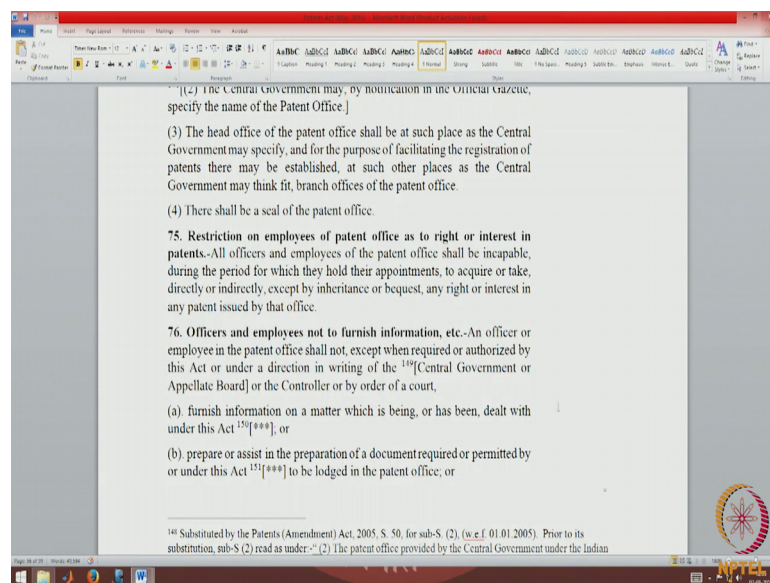


Now the patent office has branches 74 tells that the patent office they shall be an office which shall be known as the patent office. So, we have only one patent office in India, it has various branches the Delhi is a branch Chennai is a branch Mumbai Calcutta they are all branches. The central government day by notification in the official gazette specify the name of the patent office. The head of the patent office shall be at a place as the central government may specify and for the purpose of facilitating the registration of patents that may be established, at such other places as the central government made thing fit branch offices of the patent office.

So, it can established it can say way the main offices and it can also decide what are will be the branch offices and the patent office shall have a seal. Earlier we had a provision for ceiling of a patent, now that provision is removed. But the patent office has a seal and it operates by a seal in the since that that documents that have been issued by the patent office will be issued with the seal of the patent office. Just to show that the issuing authority is clearly known.

And there is some history behind because earlier when patents were granted by the kings and the queens then it had the royal seal on it, because they were privileges that was granted by the king by the sovereign.

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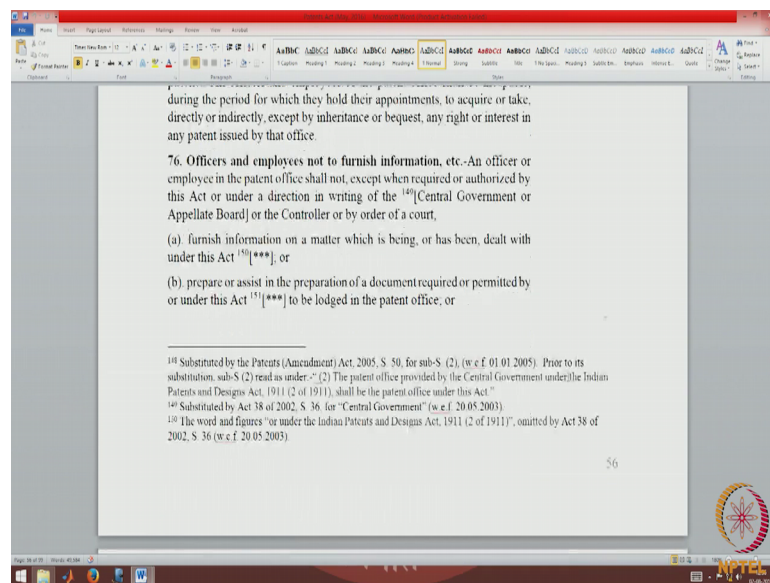


So, when India moved and became a democratic country we still have a patent office has it is seal though it is not the seal of the king of the queen it is still has a seal, just to show

the authority and there is some history behind this practice. Now restriction on employees of the patent office as to right or interest in a patent all officers and employees of the patent office shall be incapable during the period for which they hold their appointments to acquire or take directly or indirectly except by inheritance or request any right or interest in a any patent issued by that office.

So, if you are an employee of a patent office you cannot file patents. It is as simple as that. You cannot file a patent you may have to take retirement come out and do it that you cannot file a patent if you are in employee, but if your father filed a patent you could definitely after the time of your father you could inherit. That is not prohibited, but you cannot be the true and first inventor or the assignee 76, officers and employees not to furnish information.

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An officers on an employee in a patent office shall not except when required or authorized under this act or direction in writing of the central government or the appellate board or the controller or by the order of a court furnish information or assist from the preparation of a document permitted under the act to be lodged in the patent office or conduct search in the records of the patent office.

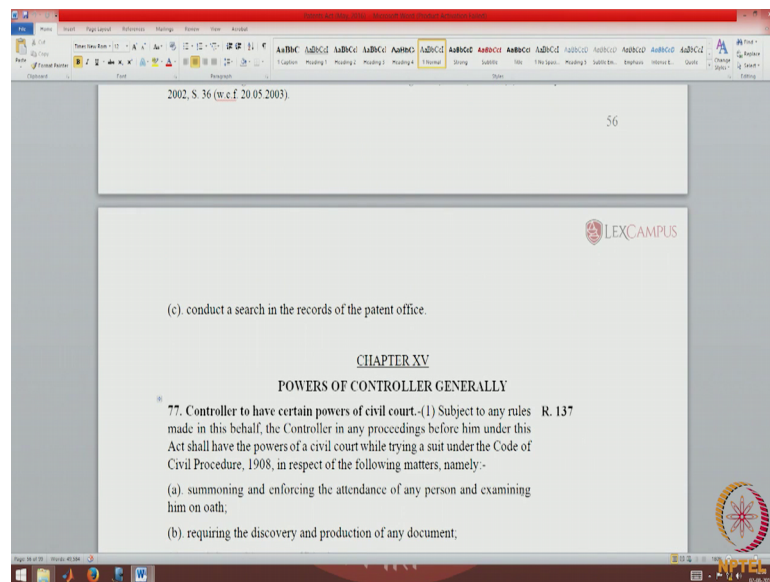
Now these 3 are functions that they discharged as government servants. So, a person cannot be asked to do what he is doing on behalf of the government. So, an officer or an employee shall not accept authorized by the act or by the central government appellate

board controller or by the order of an court, which are all superior bodies authorities under the patents act. Unless they tell them they are not obliges to furnish information on matter which is being or dealt with under the act.

So, they have to maintain confidentiality of their work, they shall not prepare or assist in the preparation of a document required to be filed or lodged at the patent office. So, if you come across some person in the patent office telling you that I can help you with the drafting of the patent. There is a bar he should not be doing that that. That is the conflict of interest; he cannot be helping you in drafting and also prosecuting the patent. They logic is the same for not allowing government servants who are working with the patent office to file inventions of their own, it is the same logic. They are a part of the office they should not be a conflict in interest. So, if some controller or some examiner tells you that I can prepare you or I can assist you in the preparation of a document or he can help you in drafting in there is a bar in doing that.

And search of the records of the patent office because the search that they do is a search that is confidential.

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The examiners search report which they examiner files to the controller, that report is confidential. A section 144 tells us that the report of examiners have to be confidential. So, the nature of their work the report that they create under section 13 is a confidential

report. The examiner's report is not the first examination report, for the first statement of objection because the first statement of objection is issued by the controller.

So, the controller exercise his desecration and then he prepares the first examination report or the first statement of objection. So, there is a prevailing misconception that the examiner's report is the first examination in report that is not the case and the examination report under 144 has to be confidential.