

ROADMAP FOR PATENT CREATION

STATUTORY EXCEPTIONS (ANTICIPATION)

LECTURE 33

A very warm welcome in the third module of week 7 of the Course, roadmap for patent creation, titled "Statutory Exceptions (anticipation)" In this module we will be discussing what are different Statutory Exceptions which are allowed. We know first to file rule ...however.....there are a few exceptions ...so which are these exceptions Let us check that India follows the principle of absolute novelty we can refer to **sections 2 (1) and 13** of the Indian Patents Act, 1970.

What section 2 (1) is about

We know section 2 is for definitions.

And section 2 (1) is the definition of new invention

What is that definition we have gone through this definition... several times...It says

*(1) "new invention" means any invention or technology **which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification, i.e., the subject matter has not fallen in public domain or that it does not form part of the state of the art;***

So we can understand from this definition the absolute novelty is mandatory...NO publication NO use So is there any procedure for searching anticipation...is there any guidelines...Yes

Section 13, provides procedures for searching anticipation.

***Section 13 of India Patents Act** is titled as Search for anticipation by previous publication and by prior claim.— now it says there are two important things the first important thing is*

(1) The examiner shall make investigation for the purpose of ascertaining whether the claimed in—

first

*(a) has been **anticipated by publication** before the date of filing of the applicant's complete specification And second*

*(b) is claimed in any claim of **any other complete specification published** on or after the date of filing of the applicant's complete specification, and being a specification filed in pursuance of an application for a patent **made in India** and dated before or claiming the **priority date earlier than that date.** Now the second important thing is*

- (2) *it is suggested that The examiner shall, in addition, to above mentioned search that is*
- a. *publication and*
 - b. *application on or after the date of filing of applicant ..however having reference of claiming priority of earlier patent do the further search as*

*whether the invention, so far as claimed in any claim of the complete specification, has been **anticipated by publication in India or elsewhere in any document other than those mentioned in sub-section (1)** before the date of filing of the applicant's complete specification.*

And we know what are the other resources we have checked this in wee4 in one of the modules Thus for a patent to qualify the test of absolute novelty, it must be determined that it is not anticipated. Now please concentrate...one point we know that patent is published after 18 months....so at any point that 18 months window is very critical..

I have mentioned earlier also that when we prepare search report...we clearly mention that we cannot give any idea about this 18 months window that is which patent applications related to applicant's patent are filed in those 18 months are totally not known to anyone....thus Prior Claim will cover instances where one application which is still in the dormant phase that is in the 18-month unpublished phase; ..so please note this will also may anticipate applicant's patent Fine....now as we know procedure for examining anticipation...let us check ***a few exceptions...which are mentone din the act***

18. Powers of Controller in cases of anticipation.—

(1) Controller will outright reject the application if as above mentioned

- a. *there will be prior publication and*
- b. *or publication of application on or after the date of filing of applicant ..however having reference of claiming priority of earlier patent*
- c. *examiner will search in all literature to confirm this...*
- d. *thus any prior publication...affects novelty and application will not be considered for patent grant*

this is what subsection 1 of section 18 says

sp as mentioned controller will refuse the application ...now there are some important points and if applicant proves that then controller may consider the application...which are these points applicant must

(a) satisfy that the priority date of the claim of his complete specification is not later than the date on which the relevant document was published; or

(b) applicant must ***amend his complete specification to the satisfaction of the Controller***

Now what is the procedure followed by the patent office to communicate to applicant.

Rule 28. Provides Procedure in case of anticipation by prior publication.—

(1) ***The Controller shall communicate the gist of specific objections and the basis to the applicant and the applicant shall be afforded an opportunity to amend his specification.***

As per Rule 29..The Controller allows a period of two months for removing the objection.

(2) If the ***applicant contests any of the objections*** or if he ***refiles his specification along with his observations*** as to whether or not the specification is to be amended, he shall be given an opportunity to be heard.To give such opportunity hearing will be fixed

(3)The Controller, ***will fix a date and time for hearing.***

(4)The applicant shall be given ten days' notice of any such hearing.

(5) ***After hearing*** the applicant, or without a hearing if the applicant has not attended or has notified that he does not desire to be heard, the ***Controller may specify or permit such amendment of the specification as he thinks fit to be made and may refuse to grant*** patent unless the amendment so specified or permitted is made within stipulated time period as decided

Now adays all these hearings as said are organised through ***video-conferencing or audio-visual communication devices.***

The Indian Patents Act expressly does not define what anticipation is;

however, it mentions what are not anticipations in Sections 29 to 34.

1. **Anticipation by previous publication (Sec 29):** If the invention has been published prior to filing of the patent application, And if the applicant or the patentee proves that the matter published was obtained from him without his consent then a complete specification filed shall not be deemed to have been anticipated

2. **Anticipation by previous communication to the government (Sec 30):** If the invention has been **communicated to the government or any person authorised by the government for the purpose of investigation of the invention**, then a complete specification filed shall not be deemed to have been anticipated.

3. **Anticipation by public display (Sec 31):**If the invention has been displayed in an exhibition; or the invention is described in a publication in consequence of display of the invention in such an exhibition; or the invention has been used by any person without the consent of the true and first inventor or a person deriving title from him after it has been

displayed in such an exhibition; or disclosing the invention before a learned society or publishing the invention in the transaction of such society; provided the application is filed within 12 months from aforementioned public display, then a complete specification filed shall not be deemed to have been anticipated.

4. **Anticipation by public working (sec 32):** If the invention has been filed within 12 months after the invention has been publicly worked for the purpose of ***reasonable trial considering the nature of the invention***, then a complete specification filed shall not be deemed to have been anticipated.

5. **Anticipation by use and publication after provisional specification (sec 33):** If the invention has been used and published after filing a provisional application, then a complete specification filed shall not be deemed to have been anticipated. So this what all about the anticipation...With this we come to the end of this session. See you in the next session

thank you!