


Intellectual Property
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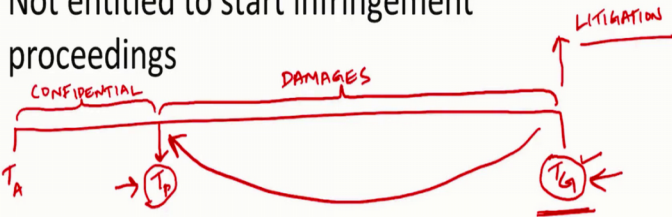
Lecture – 29
Patent Prosecution: Publication, Examination, Grant - Part 2

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Publication of Application: Rights of Applicant



- Like rights from date of publication as if patent granted
- Not entitled to start infringement proceedings



The diagram illustrates the timeline of patent rights. It starts at T_A (Application) and ends at T_G (Grant). A point T_P (Publication) is marked between T_A and T_G . The period from T_A to T_P is labeled 'CONFIDENTIAL'. The period from T_P to T_G is labeled 'DAMAGES'. An arrow labeled 'LITIGATION' points to the end of the 'DAMAGES' period at T_G .

When the application is published, there are certain rights that accrue on the applicant. From the date of publication, there are rights that the applicant can claim as though he had a patent granted in his name. Now, the patent applicant is not entitled to sue for infringement from the date of publication, but he is entitled to claim certain privileges. Now, let us look at those privileges.

Now, this is the time of application and you have the time of grant. Now, the time for publication happens let us say after 18 months. From the date of publication, the from the date of publication the applicant can assume that notice about his patent is given to the world at large. So, an applicant can claim damages for actions. So, this is damages is a relief that an applicant can claim, compensation

If somebody uses his invention during this time the time between T_P and the time between T_G time of grant, but a case can only be filed at this point litigation can only be started at the time after the grant; till such time no litigation can take place, but when a case is filed at the point of T_G , the applicant can go back in time and ask for damages

that happened during this time period. The time period between T P and T G is something which the applicant can consider for damages. So, if there is any act infringing act between this time T P and T G, the applicant can claim compensation or damages for those acts, but the applicant can only file a case at this point at T G the applicant can only file a case at T G, because the applicant will not be allowed to file a case before a grant. The reason is quite simple.

If you have to file a case before the court of law say the High Court or the district court, the law allows you to file a patent infringement case before the High Court or the district court, the first thing the court is going to ask is that what has been infringed. And the applicant will have to say that I have a patent I had filed an application for a patent and the patent has been infringed. An application which materializes into a grant has clear boundaries the claims have been verified by the patent office. If there was a challenge say in the pre grant stage by a third party, the patent has now overcome the challenge; and the claims as granted clearly stipulate the boundaries of the patent is right. Now, that it is been granted, the applicant will be now called a patentee.

Whereas, application that is still pending, it is very uncertain or it cannot be said what are the boundaries of that invention, because they could be changes that is made during prosecution, the applicant himself may withdraw certain claims, there is quite a lot of possibilities there. And we say that for an application the claim or the status of the application is uncertain until the application is granted into a patent.

So, because of this requirement, law requires a sue to be instituted only at this point the time for grant T G; till the time for the grant it is not clear as to what an applicant can enforce. So, after grant the patent is granted; it is again published and the claims are clear and the claims form notice to the world at large. So, when you have the claims, which are now being crystallized by the grant process, then an infringement suit can be filed. And again in an infringement suit, the relief that you claim you could ask the infringer to stop this acts you could ask for damages as we have just seen or compensation.

Your claim for damages is going to be based on the fact that the infringer infringed your invention; and your invention is as you have described in your claims. So, the claims will be interpreted; and the act of the infringer will be analyzed. And if the act of the infringer falls within the scope of the claims, the court will hold that there is infringement. So,

these are the rights that accrue upon publication. The time for publication is the time at which there is notice to the world because this time period that time for application and that time till it has published is confidential. So, all rights naturally starts accruing from this point from T P and the right can only be claimed at T G.

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Publication of Application: Rights of Applicant

- Like rights from date of publication as if patent granted
- Not entitled to start infringement proceedings
- Reasonable royalty


The patent applicant can also claim for royalty in some cases where they were some acts of infringement that were committed during the pendency of his application. Before the application got granted, there were some manufacturers who were involved in manufacturing what the patent applicant had covered in its application. This is a provision that came into being during a time when the Indian patent laws were in a transitionary phase.

Between 1995 to 2005, the laws in India with went through an transition. Indian law did not grant patent protection for pharmaceutical products in 1995. In 1999, we came up with an amendment saying that we will start granting protection for pharmaceutical products in 2005. So, during this time, if there was an application pending and if some manufacturers local manufacturers were already using the invention, then the only remedy for the applicant would be upon grant to claim reasonable royalty and not to stop the manufacturers. Now, this was an arrangement which was which does not have any relevance anymore because the time period for this arrangement to certain was between 1995 and 2005.

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Request for Examination


- **Form 18:** Request after publication of application
- Within 48 months from date of application
- If no request made-application deemed to be withdrawn



Now, once the application is published, the applicant has to make a request for examination. Now, it is the duty of the applicant to request that his application be examined. In case the applicant does not take the request for examination, the patent office will treat that the application has been withdrawn; it will be treated as withdrawn. Now, the request itself can be done by form 18 can be used to request the application to be examined.

Now, the time period within which this has to be done is 48 months from the date of application which means from the date of filing the application or the priority the application has to be examined. So, a request for examination has to be taken within the first two years of filing the application. As we mentioned if no request is made then the application will be treated as withdrawn.

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Examination of Application

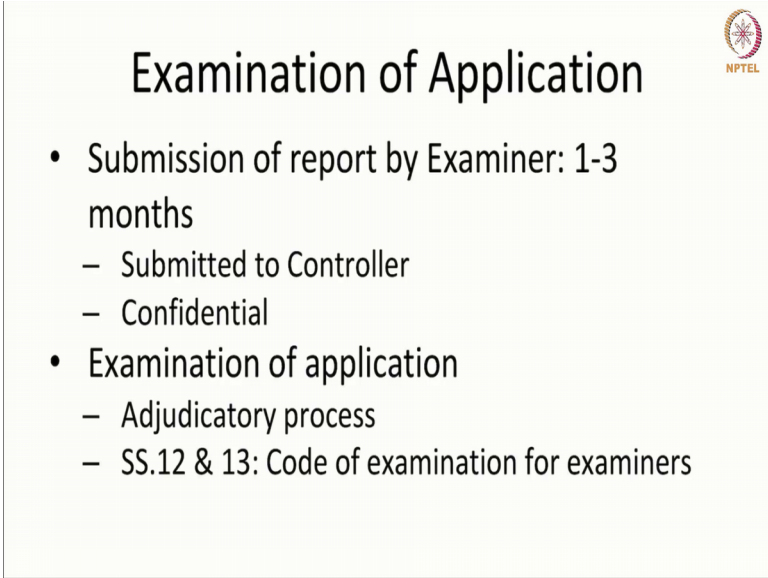
- Application referred to an examiner: First Examination Report (FER)
 - Within 1 month from publication or after request for examination
- FER contents
 - Application and specification as per Act and Rules
 - Lawful grounds of objections
 - Result of investigation

Now, once the applicant takes the request for examination that is the point at which the patent office will be looking into the application. So, till this time, till a request for application till this time, till a request for examination is taken by the applicant, the patent office does not do anything on the application. Now, this is a strict this is a structure that has been evolved to ensure that the patent office only looks into the applications which the applicant wants to pursue. There could be instances where the applicant files certain applications and later on they are not interested in pursuing them. So, there is a way in which they are automatically abandoned or they are deemed to be abandoned because of the inaction of the applicant.

So, once a request for examination is taken, then the application is referred to the examiner. The controller who is in charge will refer to an examiner and the examiner will give his report. Now, based on the examiner's report, the controller will issue a first examination report what is also called the FER; FER or the first examination report. Now, this is done within 1 month from the publication or the request for the examination is made. Now, as for the contents of the FER, the FER will ensure that the application satisfy as per the act and the rules, there are requirements that the application has to satisfy by application we are referring to form 1 and specification is usually filed in form 2. These are special forms which the patent office use uses.

Now, the FER will also see whether there are any lawful grounds for objections if the patent cannot be granted if there are issues with regard to regarding the invention as a patentable invention under section 3 and 4. There are various other lawful objections that can be raised against an invention if those lawful objections are not there then the patent can be granted. So, FER the first examination report is the opportunity for the patent office to look into whether the invention is something which can be granted legally. And the result of investigation the examiner conducts investigations they are also covered in the FER.

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Examination of Application

- Submission of report by Examiner: 1-3 months
 - Submitted to Controller
 - Confidential
- Examination of application
 - Adjudicatory process
 - SS.12 & 13: Code of examination for examiners

NPTEL

Now, the examiner is expected to file the report within 1 to 3 months, there are some timelines within the patent rules. And the report is submitted to the controller. Now, this report is a confidential report. The examiner sending a report to the controller is confidential. Based on the examiner's report the controller issues the FER, the first examination report. The examination of the application itself is a process by which decisions are made, so it is adjudicatory in nature. Section 12 and 13 together forms a code for examination. The examiners will have to look into aspects of novelty; they will have to look into lawful objections under the act and the rules. And so it is a kind of a code which tells the examiner what needs to be done for a patent application.

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The slide is titled "What is FER?" in a large, bold, black font. Below the title is a red underline. The slide contains a bulleted list of points. The second bullet point, "Issued by the controller [R. 24B(3)]", has a red box around "EXAMINER" with an arrow pointing to "R. 24B(3)". The third bullet point, "Pursuant to examination under SS. 12 & 13", has two sub-bullets: "– Examination of Application [S. 12] ✓" and "– Search for Anticipation [S. 13] ✓". In the top right corner, there is a small circular logo with a star and the text "NPTEL" below it.

- First statement of objections
- Issued by the controller [R. 24B(3)]
- Pursuant to examination under SS. 12 & 13
 - Examination of Application [S. 12] ✓
 - Search for Anticipation [S. 13] ✓

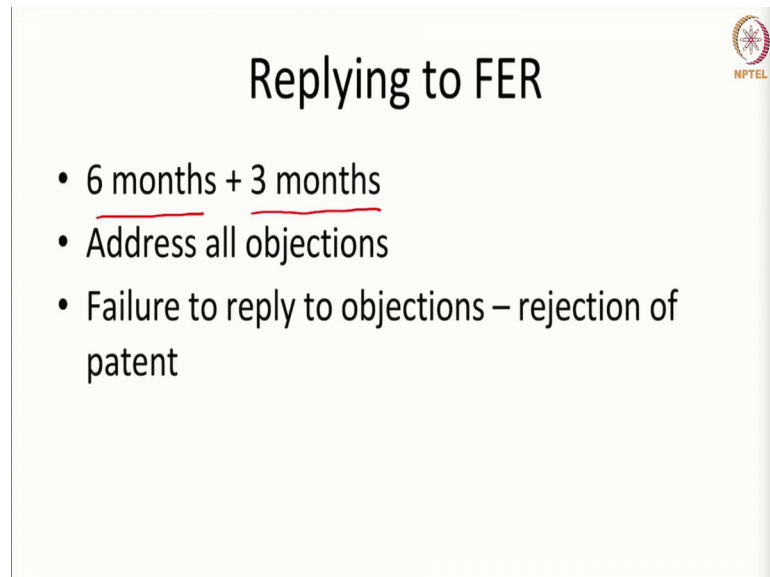
What is the FER? FER earlier used to be referred to as the first examination report. The first examination report is the report that is file filed upon the examination of the application. It used to be called the first examination report, but now the state the act and the rules refer to it as the first statement of objections. Now, this is understandable. When an application is filed the patent office examines it; and sends its first statement of objections. In the sense that if there are things that are objectionable there are procedural irregularities, there are laws, provisions, which the applicant does not comply with or the patent itself has certainly lawful grounds for rejection. Now, these objections are raised in the first statement of objection. Now, this is issued by the controller; and this is issued pursuant to the examination.

So, there are two parties involved here. One is the controller; and the other one is the examiner. Now, examiners report to the controller. Now, the controller is the higher authority in the patent office; and examiners work under the controller, and they make their reports to the controller. Now, the controller issues the FER or what is now called the first statement of objection based on the report submitted by the examiner. And we have already seen that the examiner's report this confidential.

Now, the examination is done as per the requirement of section 12. And a search for anticipation whether the invention is anticipated by an earlier publication or by an earlier application. This is also done. So, there are two things that the examiner searches for; he

examines the application for certain requirements whether there is a log full ground for objection, whether it satisfies the acts and the rules; and he also searches for anticipation. So, these are the two things that the examiner would do and pass on a report to the controller.

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The slide is titled "Replying to FER" and features the NPTEL logo in the top right corner. It contains a bulleted list of three items:

- 6 months + 3 months
- Address all objections
- Failure to reply to objections – rejection of patent

Now, once the FER is issued, the applicant has to reply to the FER. Earlier it used to be 12 months, now the time has been brought down to 6 months, which can be extended by a maximum of 3 months. Now, in replying to the FER the applicant has to address all the objections that have been raised by the patent office. So, if the applicant partially addresses it that could result even in the rejection of the patent, but the applicant has to address all the objections.

And the objections have to be done based on what has been required by the patent office. If the patent office requires amendment, then the applicant has to amend if the patent office requires certain procedural irregularities to be corrected then that has to be done. Now, failure to reply to the objections as I mentioned could read to the rejection of the application itself.

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Rights on Grant

- Grant of patent confers exclusive rights on the patentee - S.48
- Right to prevent third parties from making, using, offering for sale, selling or importing, for those purposes, that product in India
- Done without consent, infringement


Rights on grant; what happens when a patent is granted. The grant of a patent confers exclusive rights on the patentee; now these rights are contained in section 48 of the patents act. Now, these rights include the right to prevent third parties from making that is manufacture using that is used offering for sale say marketing, sale itself and importing. So, if a patentee has a right over an invention, then he has exclusive right to import that invention into India. So, these are the five rights, making or manufacture, use or using, offering for sale, marketing, four – selling, and five-importing. Now, there are no rights beyond this. So, when you are granted a patent by the patent office, these are the sets of rights that you have pertaining to your invention.

Now, infringement is the term that is used when people do any of these actions, they make, they use, the offer for sale, they are selling or they are importing without your consent. So, this is what said infringement. So, if they are doing it with your consent, they are your licensees, you have licensed it to them, and probably you have an arrangement where you make some revenue out of it; but if they are doing it without your consent we refer to it as infringement. So, patent infringement is doing any of these five acts which the law protects under section 48 without the consent, then we would say the person who does those act without the consent pertaining to an invention, we would say that that person infringes the patent.

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Grant of Patents: When? [S.43]

- Patent shall be granted expeditiously
 - Found to be in order for grant
 - Application not been refused by Controller; or
 - Application not in contravention of the Act



When the application is ready, then the patent has to be granted expeditiously. We saw that the timeline for granting a patent is between T_A time for application and time for grant. So, when all the objections are met at this point, the patent has to be granted expeditiously. So, this is what we called when a patent is made or found to be in order for a grant. So, at this point, the patent office has raised two objections, but all those objections have been answered successfully by the applicant, and there are no pending issues, for instance there is no pre ground opposition pending, no third party has opposed the patent and there is no other issue why the patent should not be granted at that point the application has to be granted expeditiously.

So, the application will be granted, if the application has not been refused by the controller, the controller did not find any reasons pursuant to the FER to refuse it, and the application is not in contravention of the act there are no provisions of the act that cont the application violates. So, it results in a grant.

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Grant of Patents: When? [S.43]


- Patent shall be granted expeditiously
 - Found to be in order for grant
 - Application not been refused by Controller; or
 - Application not in contravention of the Act
- Upon Grant: Published

The diagram illustrates the timeline of patent prosecution. It begins with T_A (Application), followed by T_{P1} (Pre-grant publication). A bracketed period labeled 'PROSECUTION' follows, leading to T_G (Grant) and T_{P2} (Post-grant publication). Handwritten red annotations include '1 PRE-GRANT PUBLICATION' above T_{P1} and '2 POST-GRANT PUBLICATION' above T_{P2} .

Upon grant, again the patent is published. So, this is the second publication. So, we had mentioned, there are two publications. The time for application soon after that there is the first publication which is called the time for publication before grant this is the pre grant publication. The object of the pre grant publication is to put notice about the application to the world at large. So, now, the pre grant publication happens before the examination. Now, so this entire period is where the examination happens; and there is T G the time for grant. So, the time for grant is the post grant publication.

So, the here we can also call it T P 2, which is the second publication. So, the first publication is a pre grant publication which happens before the grant. Before the patent office looks into the application to put the world at large to notice that there is an application filed at the patent office which is requiring a patent to be granted, so that is the first publication. Then we have what we call the prosecution. The patent office raises the objection and the patent applicant overcomes it. So, when it is ready for a grant at this point T G, the second publication happens T P 2. So, this is the second publication the post grant publication. So, there are two kinds of publication pre grant publication and post grant publication.

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Grant of Patents: When? [S.43]

- Patent shall be granted expeditiously
 - Found to be in order for grant
 - Application not been refused by Controller; or
 - Application not in contravention of the Act
- Upon Grant: Published
- Application, specification and other documents open for public inspection

The application specification and other documents upon publication will now be open for public inspection. Now, on publication, people can pay the required fee and get copies of the application, specification and all the documents that accompany a patent application.

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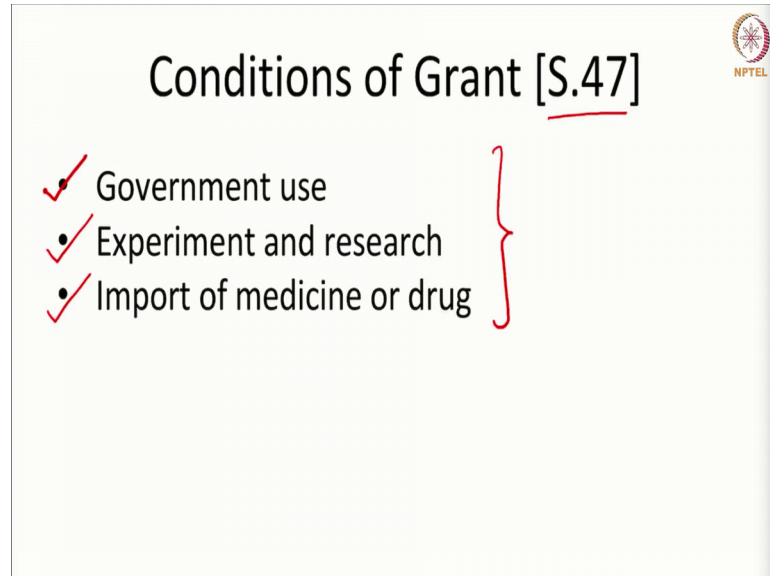
Amendment of Patent Granted [S.44]

- Person died or body corporate ceased to exist
- Controller may amend the patent
- Substitute to the name of the person to whom the patent ought to have been granted

Now, there are instances where a patent can be amended after the grant. For instance, a person dies or a body corporate a company or our registered firm ceases to exist. In those cases the controller may amend the patent and substitute the name of the person to whom

the patent or to have been granted, the legal heirs or the legal representatives who succeed them assignees their name can be granted. And this is done by section 44.

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Every grant comes with certain conditions. Now, the Indian patents act lays certain conditions under section 47 as to the grant, is subject to the following conditions. The grant is subject to the condition that the government if it requires it can use the invention that the grant the subject to experiment and research the invention can be put for experimental use and for research for imparting instruction to students.

And if necessary the grant is subject to the condition that in case the government requires it, it will be allowed to import a patent covering a medicine or a drug. So, these are the three conditions which every grant is subject to. So, the government can use it if required; the grant does not affect experimentation and research; and the grant does not affect import of a drug or a medicine in case of a need.