



**INTELLECTUAL
PROPERTY INDIA**

PATENTS/DESIGNS/
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GEOGRAPHICAL
INDICATIONS.



सत्यमेव जयते

Government of India

Office of The Controller General
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on

Examination of Patent Applications and consideration of Report of Examiner by the Controller.

It has been observed that there is a considerable delay in the examination process and issue of the First Examination Report as well as final disposal of Patent Applications. It is further observed that the files are shuttled electronically between the Examiner and Controller without any reason, thereby contributing to the delay.

In order to arrive at a conclusion regarding the patentability of an application, every patent application is referred to an Examiner for conducting investigations under Section 12 of the Patents Act, 1970. Under the scheme of the Act, this investigation shall have to be comprehensive in nature. Being an important and distinct statutory authority under the Patents Act, 1970, an Examiner is required to discharge his statutory duties with due diligence, keeping in mind that a wrongly granted patent can be detrimental to the public, in general, and the industry, in particular. Likewise, a wrongly refused patent application may cause irreparable loss to the applicant and may discourage innovation and public disclosure of inventions.

As such under the Act, the basic responsibility of examining the patentability of an application rests with the Examiner. It has been noticed that the officers acting as

Controllers are unduly spending considerable time in reinvestigating the Report of the Examiner and at times over-rule the opinion of Examiner without recording sufficient reasons for such over-ruling in the file. The Controller is expected to apply his mind judiciously on the reply submitted by the Applicant, with respect to the Examination Report, and is expected take decision to grant or refuse the application for patent after giving an opportunity of being heard.

In view thereof, the following instructions are hereby issued to improve the quality of examination and to avoid duplication of work. These instructions are further intended to clarify the role of Examiner and Controller in the examination and grant process of patent applications.

Instructions

1. Classification of Patent Applications

- a. Upon receiving an application from the Controller under Section 12, the Examiner shall check the classification already done by the RECS section and reclassify, if necessary.
- b. In case of reclassification, if the subject matter falls within the jurisdiction of another Group, the Examiner shall refer the application to the concerned Controller with justification. The decision of the concerned Controller shall be binding upon the Examiner. If the concerned Controller concurs with the view of Examiner, the application shall be referred to the Group Leader, who in consultation with the Technical Head, shall decide the matter and refer the application to the appropriate group.

2. Priority date

If an application claims priority from:

- i. a previously filed application accompanied by a provisional specification, or
- ii. an application filed in a convention country, or
- iii. more than one application,

the Examiner shall, under Section 11, determine the priority date of each claim, before conducting search under Section 13.

3. Examination of Patent Application

Examiner:

- a. The Examiner shall conduct a comprehensive investigation through prior art patent and non-patent literature search and shall prepare a report under Section 12 of the Act, while adhering to the highest standards of quality.
- b. The Examiner shall in his report quote the relevant paragraphs of prior art citations, which adversely affect the patentability of a claim, with an extract of the same. The Examiner shall raise objections on novelty and/or inventive step with reasons only. Frivolous objections without any reason / explanation cause delay in prosecution of an application. Further, raising an objection without justifying the same in the report is violative of the principles of natural justice.
- c. The Examiner shall also conduct an inter-office search, covering all the four Patent Offices, to avoid the possible malpractice of multiple filing on the same subject matter of invention.
- d. Objections such as “Form-3 was not submitted within the prescribed time period” shall be raised instead of objections of the kind “The applicant shall file a petition for condoning the delay / obviating the irregularity”. It is for the applicant to approach the Controller for condonation etc. in response to the objections.
- e. The report of Examiner under Section 12 of the Act shall form a permanent part of the note sheet and shall not be editable at the Controller’s end.
- f. The Examiner shall also put up a ‘draft gist of objections’ (FER) along with the report under Section 12, which will ordinarily be analogous to report of the Examiner. The ‘draft gist of objections’ shall also include any other lawful objection to the grant of a Patent under the Act. This ‘draft gist of objections’ shall be editable electronically at the Controller’s end.
- g. The Examiner shall also examine and report on any amendment of complete specification and submit his report and ‘draft gist of objections’ in the same manner as described above. If objections raised in the FER have been complied by the Applicant through explanation or amendment,

such fact shall be recorded in the Examiner's report giving reasons therefor.

- h. A non-exhaustive checklist covering legal and technical points shall be provided in the electronic module. The Examiner shall check, amongst other miscellaneous issues, this checklist exhaustively and a log shall be maintained in the server. The System Administrator shall ensure that the Examiner will not be able submit the report to the Controller until all these points have been verified by the Examiner.

Controller:

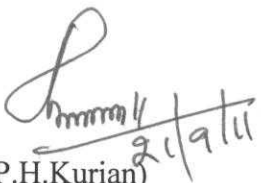
- i. On receipt of the report and the 'draft gist of objections' from the Examiner, the Controller shall consider the report *prima facie* on the assumption that the Examiner's report is exhaustive.
- j. However, from his professional vast experience, if the Controller is of the opinion that any major point on patentability has been inadvertently missed by the Examiner, he may add such objection(s) to the 'gist of objections' (FER). Similarly, the Controller may also over-rule any objection raised by the Examiner. But, the Controller shall justify such addition / deletion in the note sheet.
- k. If upon Examination of the response submitted by the Applicant, the Examiner reports that some objections are still outstanding or raises further objection(s), such objections shall be communicated along with the notice of hearing, giving reasonable time to the Applicant. It is clarified that there is no need to send a second examination report.
- l.
 - i. At the time of hearing, the Examiner may be present. However, the Examiner shall not communicate with the Applicant and no further objections can be raised at the time of hearing.
 - ii. The Controller shall record in the electronic note sheet, a brief of what transpired in the hearing and shall take a decision in consultation with the Examiner (if present) in the hearing itself. The Examiner shall also sign in the physical note sheet as a token of his presence. However, the Controller shall keep in mind that the responsibility of accepting or rejecting the application at this stage rests with the Controller.

- iii. In case, an amendment of specification is required by the Controller in response to the submissions of the applicant and the applicant agrees to the same, such requirement shall be noted in the electronic note sheet by the Controller. A reasonable period of time shall be given to the Applicant for submission of a fair copy of amended documents, failing which the application shall be refused. There shall be no scope of further examination or hearing.
- iv. In case the Controller refuses the application, the same shall be mentioned in the note sheet and a reasoned order of refusal shall follow within a reasonable period of time. Such period shall not exceed one month, in any case.
- m. The following matters fall within the exclusive jurisdiction of the Controller and the Examiner is not required to report on the same:
 - i. Petition under rule 137;
 - ii. Petition under rule 138;
 - iii. Form-4;
 - iv. Form-6;
 - v. Form-8; and
 - vi. Form-13, if it does not relate to amendment of complete specification.
- n. While deciding a petition under Rule 137:
 - i. the decision of the Hon'ble High Court of Delhi delivered in the matter of Chemtura Corporation Vs. Union of India and Nippon Steel Corporation Vs. Union of India shall mandatorily be considered.
 - ii. the Controller shall keep in mind that the applicant is seeking a monopoly against the public at large and, under the scheme of the Act, is required to be diligent in prosecuting the application.
 - iii. the phrase 'without detriment to the interests of any person' shall be given due consideration.
 - iv. regular statements like 'the applicant was unable to submit the information in time' without any corroboration, shall not be accepted.

- o. The Controller shall dispose of every petition under Rule 137 by a speaking order recorded in the physical file as well as 'remarks' section of the electronic module.

Both the Controller and Examiner shall keep in mind that the report of the Examiner and the decisions of the Controller are auditable for quality purposes by Quality Auditors appointed by the Controller General of Patents, Designs and Trade Marks.

Necessary modifications shall be carried out in the electronic module by the System Administrator.


(P.H.Kurian)

Controller General of Patents, Designs and Trade Marks

To,

1. All Officials of Patent Office,
Mumbai / Delhi / Kolkata / Chennai.
2. IT Division, IPO, New Delhi.
3. Guard file.