

COMMENTS TO THE MANUAL OF PATENT OFFICE PRACTICE AND PROCEDURE BY ANAND AND ANAND

Our comments to are in relation to the specification Sections of the Draft Manual which have been highlighted in red text.

Chapter 02: Key definitions

02.02.12 [Section 2(1)(t)] (Page 9 of the Manual)

"Person interested" includes a person engaged in, or in promoting, research in the same field as that to which the invention relates. (In the matter of 'Indian network for people living with HIV/AIDS' v/s 'Union of India' the Madras high court widened the ambit of "person interested" by including person/persons who has a concern for public interest in the area of public health and nutrition.

A&A Comments:

Reference to the case of Indian network for people living with HIV/AIDS v. Union of India of the Madras High Court suggesting that it widens the ambit of "person interested" needs to be corrected.

The Manual incorrectly refers to the decision of the Madras High Court in "Indian Network for People living with HIV/AIDS and Ors. Vs Union of India (UOI) and Ors."

In this decision, the court in the context **"any person"** used in the pre-grant opposition proceedings was of the view the objector (any person) can raise his objection on much wider grounds of public policy and public interest. That is why the right to raise pre-grant objection has been given to 'any person'. Further, the Hon'ble Supreme Court in construing the pre-grant and post-grant proceedings under the said Act held in **J. Mitra & Co. Pvt. Ltd.** that the provision of pre-grant under Section 25(1) is wider than the provisions of post-grant under Section 25(2). So, the concept **of lis** has to be construed in the context of wider right given to the objector. Such objection may not stem from any business or commercial interest, but such objection can be raised on a wider concept of public health and nutrition and the issue of affordability of medicine at a reasonable rate to those persons who are affected by disease. Therefore, it cannot be said that a person opposing the grant has no interest.

The Court further held that a perusal of the Statement of Objects and Reasons of the said amended Act would clarify the legislative intent of giving right of objection to 'any person', whereas prior to the said amendment such right of opposition at a pre-grant stage was only given to any person interested. The reason for giving the said right to any persons appears from Statement of Objects and Reasons behind the same amendment. From the objects and reasons it is clear that changes brought by the said amendment were done consciously and after thorough interaction with various cross sections of society, and those amendments are based on a broad consensus of public interest relating to nutrition and public health. Therefore, advisedly right to object at a pre-grant stage has been given to 'any person' by the said

amendment. This is an illustration of statutorily broadening the concept of locus standi and widening the scope of objection procedure by giving access to 'any person', who has a concern for public interest in the area of public health and nutrition, to raise an objection. The grant of patent is virtually a grant of monopoly right against the whole world and that is why such wide ranging right of objection has been designedly given at a pre-grant stage.

02.02.17 (Rule 2(fb)) (Page 11 of the Manual)

"Startup" means

(a) an entity in India recognised as a startup by the competent authority under Startup India initiative. (b) In case of a foreign entity, an entity fulfilling the criteria for turnover and period of incorporation/ registration as per Startup India Initiative and submitting declaration to that effect.

Explanation: In calculating the turnover, reference rates of foreign currency of Reserve Bank of India shall prevail.

A&A Comments:

The definition of start-up has been updated vide notification GSR No. 127 (E) dated February 19, 2019. Since, the Patent (Amendment) Rules 2017 state "an entity in India recognised as a startup by the competent authority under Startup India initiative," the new definition of startup vide GSR No. 127 (E) is applicable to Patent Rules in India as well. This will affect the number of companies that are eligible to apply for expedited examination and/or reduced fee. Since the SIPP scheme (Startup Facilitation Scheme) takes the same definition of Startup from Gazette Notification No. G.S.R. 180 (E), which is now superseded by GSR No. 127 (E), the new definition of Startup is also applicable to SIPP scheme. A foreign entity can also avail the benefits provided in the Patent Rules to Startups, if it falls within the definition of Startup and submits a declaration to that effect. By the said notification, **GSR No. 127 (E) dated February 19, 2019**, the following changes were made in the definition:

- An entity shall be a startup up to a period of **ten years** from its incorporation or registration.
- Turnover for the entity has not exceeded **one hundred crore rupees** in any of previous financial year since its incorporation or registration.
- The segregation of entities based on the nature of industry was excluded and a general period of **10 years from the date of incorporation or registration was applied.**

Chapter 03: Filing of Patent Application

03.02 Jurisdiction [Section 16, 74, Rule 4, 5] (Page 14 of the Manual)

A&A Comments:

The appropriate office for filing divisional application with the main application is filed may be **deleted** as it already is mentioned on page 14.

03.04 Filing of patent application [Section 7, First Schedule] (Page 16 of the Manual)

A&A Comments:

Every application for a patent shall be filed with Form-2 (and not form-1) this needs to be corrected.

03.04.01 Documents required for filing Patent Application [Section 7. Rule 2(fa)/ 2(fb), Rule 8, 10, 12, 13, 135. Form-1, 2, 3, 5, 26, 28. Section 6 of Biological Diversity Act, 2002. Rule 17.1 of PCT Regulations] (Page 18 of the Manual)

8. Priority document is required in the following cases:

b. PCT National Phase Application wherein requirements of Rule 17.1 (a or b) of regulations made under the PCT have not been fulfilled.

The priority document should be filed along with the PCT National phase application before the expiry of 31 months from the date of priority.

A&A Comments:

This needs to be added:

“According to Rule 21(3) of the Patent Rules, 2003, where the applicant has not complied with the requirement of sub rule 1 or 2 the appropriate office shall invite the applicant to file the priority document or the translation thereof, as the case maybe, within three months from the date of such invitation, and if the applicant fails to do so, the claim of applicant for the priority shall be disregarded for the purposes of the Act.”

03.04.03 Leaving and serving documents at Patent Office [Rule 6] [Page 21 of the Manual]

“Provided that the original documents that are required to be submitted in original, shall be submitted within a period of fifteen days, failing which such documents shall be deemed not to have been filed.”

A&A Comments:

Since, the only mode for sending documents is by speed post, clarification needs to be made that if the original documents are sent by speed post within 15 days from the date of e-filing of the document and if the said document reach after the expiry of 15 days (normally speed post take 3 to 5 days to reach) no petition is necessary or resubmission of documents.

03.05 Processing of Application

03.05.01 Initial processing [Page 27 of the Manual]

4(c) The Application is screened for:

c. Relevance to defence or atomic energy.

A&A Comments:

Proper guidelines, which should also be known to the applicant for the sake of transparency need to be issued as to how an application is to be screened that relates to defence as atomic energy. The current letter which is sent to the Department of Atomic Energy or Defence Ministry does not provide any reasoning whatsoever. Section 4 of the Indian Patents Act clearly provides as follows:

“4. Inventions relating to atomic energy not patentable

No patent shall be granted in respect of an invention relating to atomic energy falling within sub-section (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962).”

Therefore, merely the use of compounds that might find mention in the notification by the Government of India, Department of Atomic Energy vide. S.O.61 (E) **cannot and is not** the criteria to deny patentability or refer the case to DoAE.

The mere reference or use of such compounds does not imply that the invention relates to atomic energy as what is to be determined is whether the **INVENTION** falls under the prohibited category. Very often, the Patent office does not look at the invention as a whole but seem to refer cases based on keyword searches.

03.05.03 (Page 29 of the Manual)

Numbering for request for expedited examination

A&A Comments:

A third category needs to be included i.e numbering format for **express request** for processing of an application before 31 months in Form-18 under Rule 20(40(ii)).

03.05.04 Scrutiny of application (Page 29 of the Manual)

1. The Office checks whether the Application has been filed in appropriate jurisdiction (see 03.02). If the jurisdiction is not appropriate, the application shall not be taken on record and the applicant is informed accordingly.

A&A Comments:

In the event, the application has been incorrectly filed in the wrong jurisdiction, the applicant should be informed before the expiry of due date so that the applicant can refile in the correct jurisdiction without losing rights in the invention.

4. Further, the Office checks whether:

d. meaningful claim(s) are present in a complete specification,

A&A Comments:

The expression 'meaningful' should be deleted from the expression meaningful claims as this is a very relative expression.

**03.05.05 Secrecy Directions and consequences thereof (Section 35, 36, 37, 38)
[Page 30 of the Manual]**

A&A Comments:

Please refer to comments to Section 03.05.01 in relation to Atomic Energy.

**03.06 Withdrawal of patent application (Section 11A(3)(c), 11B(4), Rule 7(4A) and 26,
Form 29, First Schedule) [Page 32 of the Manual]**

Refund of Fees

A&A Comments:

A time frame may be needed within which the applicant can expect to receive the refund of examination fee as, as of now this period is approximately 12 months to 3 years.

Chapter – 4: Publication of Application

04.02 Early Publication (Section 11A(2), Rule 24A Form-9, First Schedule) [Page 34 of the Manual]

A&A Comments:

An additional clause may be added that in case of an application that is filed by foreign applicant is published outside India, the application can then be published [Section 36(1)].

Chapter - 5: Provisional and Complete Specification

05.01 Specification (Section 9, 10, 57, 59) (Rule 13, 14, 24A) (Form-1, 2) [Page 36 of the Manual]

A&A Comments:

The title of the invention should be indicative of the subject matter and need not include the specific features of the invention as this aspect is already covered by the Abstract.

05.02.02 Contents of Provisional Specification: [Page 38 of the Manual]

A&A Comments:

That claim should not be included in the provisional application needs to be corrected. A provisional application for a patent may include claims even in a provisional application which may then forms a part of a description.

05.03.02 National phase applications (Section 10(4A), Rule 20(1)) [Page 40 of the Manual]

A&A Comments:

A statute or a provision of law cannot given retrospective effect unless the statute expressly provides for the same. Even if the application for patent has been filed prior to the 2016 amendment to the Patent Rules, the Controller's at the patent office ask for fees for the claims that were deleted.

This is not correct and against the Act and Rules and therefore needs clarification. Every the application is examined under the current law and if under the current law claim deletion is permissible, the Controller should not ask for official fee for deleted claims for an application filed prior to 2016 amendment.

05.03.03 Title [Rule 13(7)(a)] [Page 40 of the Manual]

A&A Comments:

Please refer to comments in Section 05.01.

05.03.05 Prior Art and problem to be solved [Page 41 of the Manual]

This part should indicate the status of technology in the field of invention with reference to developments in the field including patents and pending patent applications in the specific art. When the invention relates to improvement over the existing product or process, a short statement of the closest prior art known to the applicant in that respect shall also be given. However, the description should fully and particularly describe the invention, by clearly distinguishing it from such a closest prior art, known to the applicant.

A&A Comments:

Under Section 10, there is no requirement for the applicant to provide information with regard to reference to the development in the field of the invention including reference to patents and pending application and also to include a short statement of the closest prior art this is not necessary.

Since most applications are national phase applications, in case during the prosecution of the application, the Controller requires reference to the relevant prior art to be mentioned in the background section, the same may be considered and allowed under Section 57(6) as is done during EP prosecution.

05.03.14 Significance of Claims [Page 46 of the Manual]

a) A claim is a statement of technical facts expressed in legal terms defining the scope of the invention sought to be protected. No exclusivity is obtained for any matter described in the Complete Specification unless it is claimed in the claims. What is not claimed in the claims stands disclaimed and is open to public use, even if the matter is disclosed in the description.

A&A Comments:

The invention of the applicant is also disclosed in the patent specification. During the pendency of the application, the applicant should be allowed to introduce subject matter from the description which form a part of the invention. What is not claimed is disclaimed can only be observed once the boundaries of legal protection have crystallised i.e after grant.

05.03.15 Scope of claims [Page 46 of the Manual]

A&A Comments:

This entire section may be replaced by para 34 of the decision of the Hon'ble Division bench Roche Vs. Cipla (RFA (OS) Nos.92/2012 & 103/2012) in Para 34,

- (i) Claims define the territory or scope of protection (Section 10(4) (c) of the Patents Act, 1970.*
- (ii) There is no limit to the number of claims except that after ten claims there is an additional fee per claim (1st Schedule of the Act).*
- (iii) Claims can be independent or dependent.*
- (iv) The broad structure of set of claims is an inverted pyramid with the broadest at the top and the narrowest at the bottom (Manual of Patents Office – Practice and procedure).*
- (v) Patent laws of various countries lay down rules for drafting of claims and these rules are used by Courts while interpreting claims.*
- (vi) One rule is that claims are a single sentence defining an invention or an inventive concept.*
- (vii) Different claims define different embodiments of same inventive concept.*
- (viii) The first claim is a parent or mother claim while remaining claims are referred to as subsidiary claims.*
- (ix) If subsidiary claims contain an independent inventive concept different from the main claim then the Patent office will insist on the filing of a divisional application.*
- (x) Subject matter of claims can be product, substances, apparatus or articles; alternatively methods or process for producing said products etc. They may be formulations, mixtures of*

various substance including recipes Dosage regimes or in some countries methods of use or treatment may also be claimed.

(xi) Where claims are dependent 'it incorporates by reference everything in the parent claim, and adds some further statement, limitations or restrictions'. (Landis on Mechanics of Patent Claim Drafting).

(xii) Where claims are independent' although relating to the same inventive concept this implies that the independent claim stands alone, includes all its necessary limitations, and is not dependent upon and does not include limitations from any other claim to make it complete An independent Claim can be the broadest scope claim. It has fewer limitations than any dependent claim which is dependent upon it'. (Landis on Mechanics of Patent Claim Drafting)

(xiii) For someone wishing to invalidate a patent the said person must invalidate each claim separately and independently as it is quite likely that some claims may be valid even while some are invalid.

(xiv) At the beginning of an infringement action the Courts in the United States conduct what is known as a Markman hearing' to define the scope of the claims or to throw light on certain ambiguous terms used in the claims.

Although this is not technically done in India but functionally most Judges will resort to a similar exercise in trying to understand the scope and meaning of the claims including its terms.

In the case of (52 F.3d 967 also 517 US 370) Herbert Markman Vs. Westview the Courts held that an infringement analysis entails two steps:-

(a) First step is to determine the meaning and scope of the patent claims asserted to be infringed.

(b) Second step is to compare the properly construed claim with the device accused of infringing.

(xv) The parts of the claim include its preamble, transition phrase and the body. The transition phrase' includes terms like:- (a) Comprising; (b) Consisting; (c) Consisting essentially of; (d) Having; (e) Wherein; (f) Characterised by; Of these terms some are open ended, such as comprising' which means that if the claim contains three elements A', B' and C' it would still be an infringement for someone to add a fourth element D'. Further some terms are close ended such as consisting of, i.e. in a claim of three elements, A', B' and C' a defendant would infringe if he has all three elements. In case the defendant adds a fourth element D'he would escape infringement.

(xvi) Each claim has a priority date so that in a group of claims in a specification you could have multiple priority dates. This only means that if a patent application with certain priority date and claims was followed by another application with different claims and different priority dates, then if they were consolidated or cognate with another application, each claim would retain the original priority date [Section 11(1)].

g) A claim should be clear in the sense that it should not cause the reader to speculate. For example, if words like ‘thin’, ‘strong’, ‘a major part’, ‘such as’, ‘when required’ or ‘any’ are used, the reader may make a subjective judgment unless such expression follows some definite value.

A&A Comments:

A patent specification is addressed to a person skilled in the art and expression such as “thin”, “about” etc should be allowed and determined on a case to case basis.

h) A claim must be specific and not vague, ambiguous or hypothetical in nature. Each claim should be complete so that it covers the inventive feature and enough elements around it to put the invention in the proper context. [Page 48 of the Manual]

A&A Comments:

Each claim cannot include inventive feature as they may be dependent claims. In accordance with Roche vs. CIPLA decision, when a claim is a dependent claim, it incorporates by reference everything in the parent claim and add some further statement limitation or restriction.

n) If the invention is an improvement on a product or a process existing in the prior art, the invention should be distinguished very clearly by characterizing the claim with respect to the prior art. In such cases, the claim will have two parts separated by the word ‘characterized by’ or ‘wherein’. [Page 49 of the Manual]

A&A Comments:

‘Wherein’ and ‘characterized by’ are not interchangeable.

(i) Use of words such as “wherein” is recognized in claim drafting as a mechanism to “further define a structure or provide a function associated with the given structure”. [see, for e.g. (1) WIPO Patent Drafting Manual, at internal Pg. 76; (2) WIPO, Patent Claim Formats and Types of Claims, Slide No. 32:

8. Claim Phrases

- ❖ Use of special words such as “wherein”. “whereby”. “such that” to further define a structure or provide a function associated with a given structure

Claim 1.

An apparatus, comprising:
a plurality of printed pages;
a binding configured to hold the printed pages together;
and
a cover attached to the binding, wherein the cover is detachable from the binding.

(ii) **US MPEP (Manual of Patent Examining Procedure) Guidelines, Chapter 2110, Section 2111** also makes it clear that there is no absolute rule of law which mandates that all text prior to ‘wherein’ are the prior art and all text post ‘wherein’ is the invention. On the contrary, these guidelines make it clear that, firstly, the purpose of the word ‘wherein’ is not to make such demarcation; secondly that it all depends on the facts of a particular case; thereby, thirdly, meaning that there is no absolute rule of law in that regard.

(iii) It may be possible that when the word “wherein” is used in conjunction with the word “improvement”, it may constitute a dividing line between the prior art and the actual invention (See, Landis on the Mechanics of Patent Claim Drafting, 5th Edn., @ Pg. 40). However, again the determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case.

Following its preamble, the *Jepson* claim includes a transition clause that states, “wherein the improvement comprises,” or “the combination with the old article, etc. of.”

The following body of the claim recites only the new elements or the modified elements or tells of the new forms of connection or co-operation between all of the elements by reciting the improvements.

Jepson claims may be used when there is an improvement in one element of an otherwise old combination.

Sub-point p) and q)

It would be incorrect to have any kind of limitation of the number of independent claims, as the Applicant pays fees for each claim at the time of filing and the examiner is under an obligation to examine each and every claim independently.

Sub-point t)

Dependent claims can define additional feature, or even different embodiments of an invention, which may omit, substitute or replace an ingredient. Different claims can define different embodiments of the same inventive concept. (See point (vii) of Para 34 of Roche decision referred above). The point t) would therefore be incorrect.

Chapter- 6: Divisional Application and Patent of Addition

06.01 Divisional Application

06.01.01 General Section 16(1) [Page 53 of the Manual]

No divisional application can be filed, the claims of which is/are identical to claims of the parent application (first mentioned application).

A&A Comments:

The purpose of Section 16(3) is that there should be no overlap of claims such that the complete specification of the divisional application includes a claim for any matter **claimed** in parent application. Therefore, an applicant is allowed to file a divisional application with claims identical to the parent application and can later revise the claims of the divisional application once the parent has been granted in order to ensure that the subject matter of the divisional application is not already claimed in the parent. This is the legislative intent of Section 16. The expression '**claimed**' used in Section 16 (3) would mean that the claims of the patent application have already been crystallized (as granted)

06.01.03 Priority [Section 16, Explanation Section 11(4)] [Page 54 of the Manual]

The claims of divisional application shall have the same priority date as that of the first mentioned application. A divisional application shall be examined vis-à-vis the first mentioned application so as to avoid claim overlap resulting in double patenting.

A&A Comments:

It would be incorrect to state that *the claims of divisional application shall have the same priority date as that of the first mentioned application*. Each claim in the parent and the divisional can have different priority dates depending on when the subject matter was first disclosed. For instance, the claims granted in parent may be based on Priority application 1 and have priority date 1. The claims in divisional may be based on priority application 2 and have priority date 2. (See Section 11(4))

Chapter 7: Convention Application, International Application and National Phase Application

07.02.02 Indian patent office as receiving office and requirements Section
2(1)(ia)

2. Offline Filing [Page 61 of the Manual]

A&A Comments:

Clarification is required to sub-point a) and b) relating to offline filing. Why is the fee reduction applicable only for offline filing.

07.03 PCT National Phase Application

07.03.02. Basic requirement to enter National Phase in India Rule 14, 20, 21
[Page 73 of the Manual]

A&A Comments:

In point 7, it has been stated that “at the time of filing the national phase application corresponding to International application designating India, the applicant may delete claim in accordance with the provisions contained in Rule 14”.

Please refer comments to Section 05.03.02.

Also refer to the IPAB order “OA/60/2012/PT/DEL”

Chapter- 9: Examination & Grant

09.03 Examination of application

09.03.02 Novelty (Section 2(1)(j), 13, 29, 30, 31, 32, 33, 34) [Page 93 of the Manual]

1) An invention is considered as new if it is not anticipated by prior publication in patent and non-patent literature, prior use or prior public knowledge **in India**.

An invention is new (novel) if it has not been disclosed in the prior art, where the prior art means everything that has been published, presented or otherwise disclosed to the public before the ~~date of filing~~ **priority date** of complete specification.

A&A Comments:

Please see corrections in red **[Section 11(8)]**

4) A prior art is considered as anticipating novelty if all the features of the invention under examination are present in the cited prior art document **in the same order**.

A&A Comments:

Please add the text in red above. Also in view of the IPAB order in Ideal Cures Vs. M/S.Colorcon Ltd it was held that for anticipation the matter relied upon as prior art must disclose subject matter which, if performed, would necessarily result in an infringement of the patent. Second, that disclosure must have been enabling, that is to say the ordinary skilled person would have been able to perform the invention if he attempted to do so by using the disclosed matter and the common general knowledge. The entire prior patent must provide enough information to allow a person skilled in the art to perform or make the subsequently claimed invention without "undue burden".

Determination of inventive step:

Accordingly, the following points need to be objectively judged to ascertain whether, looking at the invention as a whole, the invention does have inventive step or not:

- 1) Identify the "person skilled in the art", i.e competent craftsman or engineer as distinguished from a mere artisan;
- 2) Identify the relevant common general knowledge of that person at the priority date;
- 3) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- 4) Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;
- 5) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of inventive ingenuity?

A&A Comments:

This should be replaced with para 118 of the decision of the Division Bench in Roche Vs. CIPLA which is as follows:

To determine obviousness/lack of inventive steps the following inquiries are required to be conducted:

Step No.1 To identify an ordinary person skilled in the art,

Step No.2 To identify the inventive concept embodied in the patent,

Step No.3 To impute to a normal skilled but unimaginative ordinary person skilled in the art what was common general knowledge in the art at the priority date.

Step No.4 To identify the differences, if any, between the matter cited and the alleged invention and ascertain whether the differences are ordinary application of law or involve various different steps requiring multiple, theoretical and practical applications,

Step No.5 To decide whether those differences, viewed in the knowledge of alleged invention, constituted steps which would have been obvious to the ordinary person skilled in the art and rule out a hindsight approach.

09.03.04 Industrial Applicability [Section 2(1)(ac)] [Page 98 of the Manual]

This section needs to be deleted in view of decision of **Farbwerke Hoechst vs Unichem Laboratories and Ors** and of the Division bench in Roche Vs. CIPLA that state as follows:

"Not useful" in patent law means that the invention will not work, either in the sense that it will not operate at all or more broadly, that it will not do what the specification promises that it will do. If the invention will give the result promised at all, the objection on the ground of want of utility must fail. It is further stated in the said passage that the practical usefulness or commercial utility of the invention does not matter, nor does it matter whether the invention is of any real benefit to the public, or particularly suitable for the purposes suggested, and that it is only failure to produce the results promised that will invalidate the patent, not misstatements as to the purposes to which such results might be applied.

09.03.05 Inventions not patentable [Section 3]

09.03.05.04 [Section 3(d)] [Page 101 of the Manual]

A&A Comments

This may be added under Section 3(d).

Incremental Invention: The Division Bench in Roche further held that the purpose of Section 3(d) is to encourage incremental innovation in pharmaceuticals. It lays down a threshold for what subject matter would qualify as the 'same' or 'known' substance and what would qualify as a new substance. Section 3(d) is a positive provision that in fact recognizes incremental innovation while cautioning that the incremental steps may sometimes be so little that the resultant product is no different from the original.

09.03.05.08 [Section 3(i)] [Page 106 of the Manual]

A&A Comments

An additional clause (l) may be added in view of the amendment of Section 3(i) of the Indian Patents Act by the Amendment Act 38 of 2002 by which method for treatment of plants was removed from the excluded category.

09.03.05.09 [Section 3(j)] [Page 108 of the Manual]

A&A Comments

Vectors, host cells and cell lines should be permissible and should not be considered as being a part of a plant or animal unless it is shown that they have the ability to regenerate into a part of a plant or animal/plant as a whole.

09.03.05.10 [Section 3(k)] [Page 108 of the Manual]

4) Claims directed as “Computer Programme per se”: Claims which are directed towards computer programs per se are excluded from patentability, like,

a) Claims directed at computer programmes/ set of instructions/ Routines and/or Sub-routines.

b) Claims directed at “computer programme products” / “Storage Medium having instructions” / “Database” / “Computer Memory with instruction” stored in a computer readable medium.

A&A Comments

Computer program product claims /CRM claim/ Beauregard claim should be allowed if the invention does not fall under Section 3(k). An embodiment of the invention written as a CRM claim does not make the invention as being ineligible under Section 3(k) if the invention is otherwise patent eligible.

09.03.06 Information and Undertaking regarding foreign applications [Section 8, rule 12] [Page 112 of the Manual]

The Controller may also require the applicant to furnish, as far as may be available to the applicant, details relating to the objections, if any, taken to any such application as is referred to in sub-section (1) on the ground that the invention is lacking in novelty or patentability, the amendments effected in the specifications, the claims allowed in respect thereof and such other particulars as he may require, within six months from the date of such filing.

A&A Comments

Whenever information under Section 8.2 is required by the Controller, the countries of which the Controller require the applicant to submit the said information should clearly be specified in view of the order of IPAB, Glaxo vs Fresenius Kabi, order 172/2013 which require the Controller to notify the applicant of the information that they requested.

*“The office must remember it. **The FER requires the patentee to give the details mentioned therein in any one of the major Patent offices such as USPTO, EPO or JPO as per S.8 (2) of the Patents Act. What is meant by “such as”? This request is vague and gives room for manipulation.**”*

Point 1 under the FOURTH BULLET which defines the period of six months “The period of six months in case of an application corresponding to an international application in which India is designated shall be reckoned from the actual date on which the corresponding application is filed in India.” should additionally state that:

ADDITIONAL POINT FOR INCLUSION IN THE DRAFT: *“For corresponding foreign applications filed after the filing of the statement and undertaking in form 3, the period of six months shall be reckoned from the date of filing of said corresponding foreign application.”*

1. Point 2 under the FOURTH BULLET which relates to section 8(2) should be corrected as follows:

CORRECTION: “(2) The Controller may also require the applicant to furnish, as far as may be available to the applicant, details relating to the objections, if any, taken to any such application as is referred to in sub-section (1) on the ground that the invention is lacking in novelty or patentability, the amendments effected in the specifications, the claims allowed in respect thereof and such other particulars as he may require, within six months from the date of such filing request.”

09.03.09 Report of Examiner [Section 3, 4, 12, 13] [Page 118 of the Manual]

The Examiner also examines whether the invention belongs to one of the categories of non-patentable inventions coming under Section 3 and 4, and whether the application is in conformity with all the provisions of the Act.

A&A Comments

Please refer to Section 03.05.01 in relation to determination as to whether an invention relates to Section 20(1) of the Atomic Energy Act.

09.06. Pre-grant Opposition Section 11A, 25(1), Rule 55 [Page 123 of the Manual]

A&A Comments

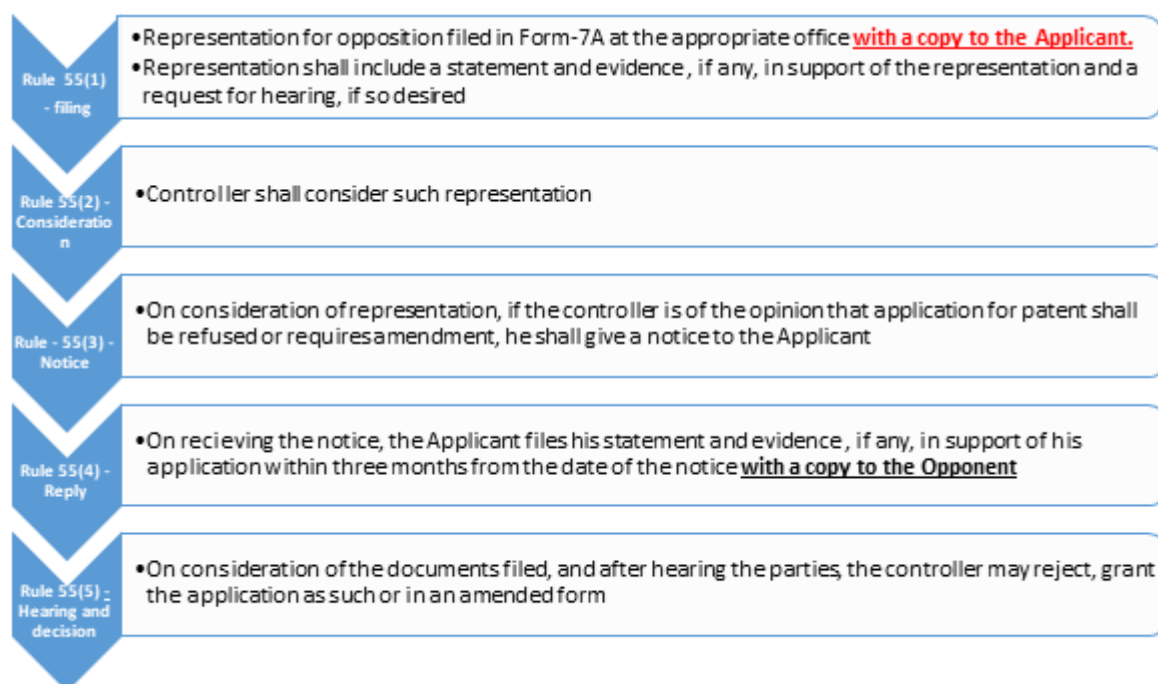
To add the following in the pre-grant opposition in view of Glochem Industries vs Cadila Healthcare Ltd, WP 1605/2009 of the Bombay High Court

“According to Respondent No. 1, however, the procedure to be adopted in pre-grant objection enquiry under Section 25(1) is a summary procedure. The requirement as per Section 25(1) read with Rule-55 is that on filing of representation by way of opposition, the applicant has to file his reply statement. There is no provision for any rejoinder being filed by the person opposing the grant of Patent, Production of any further documents or evidence either by the applicant or by the person opposing the grant of Patent. The objective of Rule-55 is to decide

the pre-grant opposition expeditiously, whereas the post-grant opposition stage contemplates more elaborate procedure as is evidenced from Rules 55A to 62

There is **no difficulty in accepting the argument of the Respondent No. 1 that the enquiry contemplated at the stage of pre-grant opposition is a summary enquiry.**"

The pre-grant procedure is a summary proceedings and rejoinders are not permissible in summary proceedings. Further, the procedure prescribed for conducting pre-grant opposition is prescribed by Rule 55 (1 to 5) and can schematically be represented hereinbelow:



Therefore, a notice in relation to pre-grant opposition cannot be issued prior to the date on which the opponent sends the applicant a copy of the opposition. Further, failure to provide a copy of the representation of the applicant should mean that the said opposition cannot be taken on record or is deemed not filed.

It is suggested that paragraph mentioning case of *Neon Laboratories Pvt. Ltd. vs. Troikaa Pharma Limited and Ors* (Writ Petition No. 211 of 2010) should be removed.

In this case, the petitioner as an opponent in pre grant proceedings was not sent notice regarding amendment of the claims, at the time of filing such amendment, made by applicant in response to first examination report issued by Controller. The opponent got aware of said amendment only when the applicant's response to second examination report raised by Controller with respect to amended claims was forwarded to the opponent. The opponent aggrieved by such development had filed another opposition in the same patent application

which was rejected by the Controller. Further, the Controller has also rejected the opponent's request for personal hearing regarding the second opposition.

The Court has held that while deciding pre grant opposition proceedings under Section 25(1) of the act, Office of Controller of Patent is acting as quasi judicial body. The Court had decided the issue of whether grant of patent by Controller to Respondent without affording an opportunity of hearing to Petitioner (opponent) is valid. The Court had noticed that 2005 amendment had widened the scope of right of opponent by granting such right to "any person" and held the object of amended Act is to broadening the concept of locus standi and widening the scope of objection procedure.

The Court looking at the scheme of provision of Section 25(1) of the Act has observed that restriction of opportunity to oppose patent under Section 25 (1) to originally filed application is not valid. The Court also held that breach of principle of natural justice in pre grant opposition proceeding would vitiate the proceedings to such extent as would render the final order void, hence invalidating the patent.

However, the Court has restricted the opportunity of being heard to petitioners only, barring any other person to file any objection regarding amended claims (please refer to Para 55 of judgement). We request the Patent Office to remove the case law or provide clarification on rights of opponent in opposition proceeding under Section 25(1), where the applicant has amended the claims in prosecution proceedings, considering these proceedings need to be decided simultaneously.

Chapter - 10: Opposition Proceedings

10.01 Post-grant opposition [Section 2(1)(t), 25(2), Rule 55A, 60, 126, 127. Form 7] [Page 131 of the Manual]

7) If the patentee does not desire to contest or does not file his reply and evidence within two months, the patent shall be deemed to have been ~~abandoned~~ **revoked** and the Controller shall issue the order of revocation of Patent and the fact of revocation is entered in the register of patents.

A&A Comments

The changes have been highlighted in red.

10.03 Hearing [Rule 62] [Page 133 of the Manual]

1) On the completion of the presentation of evidence, if any, and after receiving the recommendation of Opposition Board the Controller shall fix, a date and time for the hearing of the opposition and inform the parties, at least ten days in advance. **That the recommendations of the Opposition Board to the proceedings should be provided to the parties prior to the hearing.**

A&A Comments

The changes have been highlighted in red.

Chapter 11: Post-grant procedures

11.06 Amendments after the grant of patents [Section 57, 59, Rule 57, 58, 59, 60, 61, 62, 63, 81, 82, 83. Form-13, 14]

2) The request shall state the nature of the proposed amendment, highlighted in an annexed copy along with the reasons. The amendments are allowable only by way of disclaimer, correction or explanation. Such amendments shall be for the purpose of incorporation of actual fact only. Further, no amendment of a complete specification shall be allowed the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or the amended claim(s) do not fall wholly within the scope of claim(s) of the specification before the amendment.

A&A Comments

When deciding as to whether the amendment is permissible under Section 57 to 59 or not, the **SCOPE** of the amendment, whether it is description or claims has to be determined and not the **existence of a claim**. A claim may be added which has the effect of narrowing the scope of the invention by way of disclaimer. That does not mean that the said claim is not permissible because such a claim does not exist.

End of document