UNIT V PATENTS

A patent is an exclusive right granted for an invention, which is a product or a process that provides, in general, a new way of doing something, or offers a new technical solution to a problem. To get a patent, technical information about the invention must be disclosed to the public in a patent application.

A patent for an invention is the grant of a property right to the inventor, issued by the United States Patent and Trademark Office. Generally, the term of a new patent is 20 years from the date on which the application for the patent was filed in the United States or, in special cases, from the date an earlier related application was filed, subject to the payment of maintenance fees. U.S. patent grants are effective only within the United States, U.S. territories, and U.S. possessions. Under certain circumstances, patent term extensions or adjustments may be available.

The right conferred by the patent grant is, in the language of the statute and of the grant itself, “the right to exclude others from making, using, offering for sale, or selling” the invention in the United States or “importing” the invention into the United States. What is granted is not the right to make, use, offer for sale, sell or import, but the right to exclude others from making, using, offering for sale, selling or importing the invention. Once a patent is issued, the patentee must enforce the patent without aid of the USPTO.

There are three types of patents:

1) Utility patents may be granted to anyone who invents or discovers any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof;  
2) Design patents may be granted to anyone who invents a new, original, and ornamental design for an article of manufacture; and  
3) Plant patents may be granted to anyone who invents or discovers and asexually reproduces any distinct and new variety of plant.

Patent Laws

The Constitution of the United States gives Congress the power to enact laws relating to patents, in Article I, section 8, which reads "Congress shall have power . . . to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." Under this power Congress has from time to time enacted various laws relating to patents. The first patent law was enacted in 1790. The patent laws underwent a general revision which was enacted July 19, 1952, and which came into effect January 1, 1953. It is codified in Title 35, United States Code. Additionally, on November 29, 1999, Congress enacted the American Inventors Protection Act of 1999 (AIPA), which further revised the patent laws. See Public Law 106-113, 113 Stat. 1501 (1999).  
 The patent law specifies the subject matter for which a patent may be obtained and the conditions for patentability. The law establishes the United States Patent and Trademark Office to administer the law relating to the granting of patents and contains various other provisions relating to patents.

What Can Be Patented:

The patent law specifies the general field of subject matter that can be patented and the conditions under which a patent may be obtained.

In the language of the statute, any person who “invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent,” subject to the conditions and requirements of the law. The word “process” is defined by law as a process, act, or method, and primarily includes industrial or technical processes. The term “machine” used in the statute needs no explanation. The term “manufacture” refers to articles that are made, and includes all manufactured articles. The term “composition of matter” relates to chemical compositions and may include mixtures of ingredients as well as new chemical compounds. These classes of subject matter taken together include practically everything that is made by man and the processes for making the products.

The Atomic Energy Act of 1954 excludes the patenting of inventions useful solely in the utilization of special nuclear material or atomic energy in an atomic weapon. See 42 U.S.C. 2181(a).

The patent law specifies that the subject matter must be “useful.” The term “useful” in this connection refers to the condition that the subject matter has a useful purpose and also includes operativeness, that is, a machine which will not operate to perform the intended purpose would not be called useful, and therefore would not be granted a patent.

Interpretations of the statute by the courts have defined the limits of the field of subject matter that can be patented, thus it has been held that the laws of nature, physical phenomena, and abstract ideas are not patentable subject matter.

A patent cannot be obtained upon a mere idea or suggestion. The patent is granted upon the new machine, manufacture, etc., as has been said, and not upon the idea or suggestion of the new machine. A complete description of the actual machine or other subject matter for which a patent is sought is required.

Novelty And Non-Obviousness, Conditions For Obtaining A Patent

In order for an invention to be patentable it must be new as defined in the patent law, which provides that an invention cannot be patented if:

“(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention” or

“(2) the claimed invention was described in a patent issued [by the U.S.] or in an application for patent published or deemed published [by the U.S.], in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.”

There are certain limited patent law exceptions to patent prohibitions (1) and (2) above. Notably, an exception may apply to a “disclosure made 1 year or less before the effective filing date of the claimed invention,” but only if “the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed… from the inventor or a joint inventor.”

In patent prohibition (1), the term “otherwise available to the public” refers to other types of disclosures of the claimed invention such as, for example, an oral presentation at a scientific meeting, a demonstration at a trade show, a lecture or speech, a statement made on a radio talk show, a YouTube™ video, or a website or other on-line material.

Effective filing date of the claimed invention: This term appears in patent prohibitions (1) and (2). For a U.S. nonprovisional patent application that is the first application containing the claimed subject matter, the term “effective filing date of the claimed invention” means the actual filing date of the U.S. nonprovisional patent application. For a U.S. nonprovisional application that claims the benefit of a corresponding prior-filed U.S. provisional application, “effective filing date of the claimed invention” can be the filing date of the prior-filed provisional application provided the provisional application sufficiently describes the claimed invention. Similarly, for a U.S. nonprovisional application that is a continuation or division of a prior-filed U.S. nonprovisional application, “effective filing date of the claimed invention” can be the filing date of the prior filed nonprovisional application that sufficiently describes the claimed invention. Finally, “effective filing date of the claimed invention” may be the filing date of a prior-filed foreign patent application to which foreign priority is claimed provided the foreign patent application sufficiently describes the claimed invention.

Even if the subject matter sought to be patented is not exactly shown by the prior art, and involves one or more differences over the most nearly similar thing already known, a patent may still be refused if the differences would be obvious. The subject matter sought to be patented must be sufficiently different from what has been used or described before that it may be said to be non-obvious to a person having ordinary skill in the area of technology related to the invention. For example, the substitution of one color for another, or changes in size, are ordinarily not patentable.

Utility patents

A utility patent is a patent that covers the creation of a new or improved—and useful—product, process, or machine. A utility patent, also known as a "patent for invention," prohibits other individuals or companies from making, using, or selling the invention without authorization. When most people refer to a patent, they are most likely referring to a utility patent.

Utility patents are very valuable assets because they give inventors exclusive commercial rights to producing and utilizing the latest technology. In turn, utility patents are difficult to obtain. For one, they are hard to write, the process may be time consuming and expensive to undertake, and their complexity may make them difficult to understand.

The nature of a utility patent is covered in Title 35, Part II, Chapter 10, Subsection 101 of the United States Code, which defines it as any invention for which a patent may be obtained. It reads: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."2﻿

Utility patents are issued by the U.S. Patent and Trademark Office (USPTO) and last for up to 20 years.1﻿However, the patent holder may have to pay maintenance fees over that time period.3﻿Individuals who want to search whether a patent for an idea they have already exists can use the USPTO's patent search feature. Once a utility patent has been issued, inventors have the right to stop others from manufacturing, using, or selling their invention.

Get a Utility Patent

As you begin to describe your invention, break it down into a series of essential and nonessential parts. For example, your new mechanism to drive a 10-speed bicycle may contain most of the parts of a standard bicycle: the gears, the chain, and the pedals. However, it also contains a new design for a tensioner that is inspired from a chainsaw.

Conduct a utility patent search to see if anyone has ever patented or published a similar design. You will readily find most of the elements of a standard bicycle. The trick will be to find a bicycle that uses your new, chainsaw-inspired tensioner as well.

A patent search is critical before you file your patent. If you find a patent that uses the same tensioner, then you are going to have hard time getting a patent. It is better to find out before you go through the cost of filing a utility patent application than afterwards.

Filing a Utility Patent

Patents are teaching documents. The government grants inventors rights in their inventions so that inventors will tell the public how to use their inventions. A utility patent application has several formal requirements. It contains multiple sections, each with its own rules for formatting. It requires drawings or diagrams to explain how your invention works. These requirements help ensure the public learns how to use your invention.

This teaching requirement is well illustrated by the difference between utility and design patents:

Design patents require only a drawing(s) of the design and limited text.

Utility patents require a thorough explanation of how the invention works. The inventor should discuss alternative ways to make the invention and provide enough detail so that another person in the same technical field could readily reproduce the results.

In looking at a utility patent vs. design patent, it is clear how much more work goes into a utility patent.

Staking Your Claims

Inventors file patents to get issued claims. In return for teaching the public how to use the invention, the patent office issues the inventor the right to stop others from making, using, or selling the inventor's invention. Utility patents contain a series of numbered sentences that claim the invention. If another person makes, uses, or sells the exact thing described in a patent claim, then that person is infringing the inventor's patent.

The claims recite the essential elements of the invention. The patent examiner will argue with the inventor that the combination of elements in the patent claim must be both novel and non-obvious. Returning to the bicycle utility patent example, your bike chain invention will recite all the parts of a chain, the gears, and your chainsaw-inspired tensioner.

Your invention is novel if all of these elements do not appear in any one published reference. To reject your invention as not novel, the examiner will have to find a patent, patent application, or other publication that includes all the elements of your invention: the bicycle, the chain, the gears, and the chainsaw tensioner.

Your invention is non-obvious if all of these elements do not appear in any set of published references. This means that if the examiner finds half of the elements in one reference and half of the elements in another reference, then he can combine the two references and reject your invention.

For example, the examiner may not find a bicycle with your chainsaw-inspired tensioner, but he can find the tensioner on a chainsaw. The examiner can combine a bicycle patent along with a patent application for a new chainsaw—that includes the same tensioner—to reject your invention as obvious.

Unlike a rejection based on novelty, you can argue that no one would ever think to combine a chainsaw and a bicycle or that combining the two produces results no one would have anticipated.

Working Around Rejection

For a rejection based in novelty or obviousness, you can always amend your claims to get around the rejection.

For example, mounting the chainsaw tensioner onto a bicycle might require a particular kind of bracket. If you include the bracket in your claims, and if that bracket is not in the chainsaw patent or the bicycle patent, then you may get around the rejection. Just remember, the more things you put into your claims, the easier it will be for a competitor to get around your patent.

Utility patents are among some of the most valuable assets in the world. They give inventors the exclusive commercial rights to the latest technology, in exchange for which they also are difficult to write, expensive to get, and complicated to understand.

Design patents

A design patent is a form of legal protection of the unique visual qualities of a manufactured item. A design patent may be granted if the product has a distinct configuration, distinct surface ornamentation or both. In other words, a design patent provides protection for the ornamental design of something that has a practical utility.

In the United States, that means an item that is substantially similar to something that has the protection of a design patent may not be made, copied, used or imported into the country. In other countries, a registered design may act as an alternative to a design patent. In certain European countries, patent protection for designs may be obtained for a fee and by meeting basic registration requirements.

Design Patent Works

An item or object that is protected by a design patent carries broad protection from copyright infringement. A design that was not intended to be a copy and which was devised independently from an existing, design patent-protected item may still infringe upon that design patent.

In some countries, such as the U.S., Canada, China, Japan, and South Africa, applications for design patents are kept secret until they are granted. In Japan, secrecy can be extended to three years after registration is granted. The first U.S. design patent was awarded in 1842 for printing typefaces and border (fonts).

Design Patent vs. Utility Patent

A design patent should not be confused with a utility patent, which safeguards an item’s unique way of operating or functionality. A design patent protects how an object looks. A single product may have both a design patent and a utility patent at the same time. One of the key differences between the two patents is their lifespan.

While a design patent may last 14 or 15 years, depending on its filing. A utility patent lasts for 20 years and requires periodic maintenance fees. A design patent does not require maintenance fees.

Design Patent Examples

Some examples of design patents include ornamental designs on jewelry, automobiles or furniture, as well as packaging, fonts and computer icons (such as emojis). Some famous design patent objects include the original curvy Coca-Cola bottle (1915) and the Statue of Liberty (1879).

When a company’s product design has substantial cachet, a design patent solidifies its competitive advantage by penalizing other firms that try to develop similar-looking items. For example, Apple has been awarded damages reportedly totaling more than $900 million from Samsung, which violated its iPhone design patents.

Plant patents

A plant patent is an intellectual property right that protects a new and unique plant’s key characteristics from being copied, sold or used by others. A plant patent can help an inventor secure higher profits during the patent protection period by preventing competitors from using the plant. Plant patents in the United States are granted by the United States Patent and Trademark Office (USPTO) to the inventor or the inventor’s heirs.1

How a Plant Patent Works

A patentable plant can be natural, bred or somatic (created from non-reproductive cells of the plant). It can be invented or discovered, but a plant patent will only be granted to a discovered plant if the discovery is made in a cultivated area.

The plant must be asexually reproducible, and the reproduction must be genetically identical to the original and performed through methods such as root cuttings, bulbs, division, or grafting and budding to establish the plant’s stability. Tubers, such as potatoes and Jerusalem artichokes, are also not eligible for plant patents, nor are plants that are unique only because of growing conditions or soil fertility.

Like any invention, a plant must be non-obvious to qualify for patentability. A different type of patent, the utility patent, applies to certain plants, seeds, and plant-reproduction processes.

Requirements for a Plant Patent

An inventor has one year within selling or releasing the plant to apply for a plant patent. The USPTO will only grant a plant patent if the inventor provides a full and complete botanical description that explains how the plant is unique and includes drawings showing the plant’s unique features. The applicant must also comply with the other detailed requirements for a patent application and pay the relevant fees.

A plant patent can have two named inventors: one who discovered the plant and one who asexually reproduced it. If the invention is a team effort, every member of the team can be named as a co-inventor.

While a plant patent protects the inventor’s intellectual property rights for 20 years from the patent-application-filing date, the patent application itself becomes public 18 months after the earliest patent filing date, which means competitors will be able to learn the details of the invention much sooner.3

In addition to applying for a plant patent, an inventor might also need to apply for a utility patent or a design patent to fully protect the plant. For example, if the new plant variety has a unique appearance, the inventor would want both a plant patent and a design patent.

Inventive steps of Patent

An invention, so far as claimed in a claim, involves an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the prior art base.

Compare: Patents Act 1977 s 3 (UK)

1. The Patents Act 2013 requires that a claim for an invention involves an inventive step. A claim involves an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the prior art base.
2. An overview of inventive step was provided by Lord Hoffmann in Biogen Inc v Medeva plc [1997] RPC 1 at 34:  
   “Whenever anything inventive is done for the first time it is the result of the addition of a new idea to the existing stock of knowledge. Sometimes, it is the idea of using established techniques to do something which no one had previously thought of doing. In that case the inventive idea will be doing the new thing. Sometimes it is finding a way of doing something which people had wanted to do but could not think how. The inventive idea would be the way of achieving the goal. In yet other cases, many people may have a general idea of how they might achieve a goal but not know how to solve a particular problem which stands in their way. If someone devises a way of solving the problem, his inventive step will be that solution, but not the goal itself or the general method of achieving it.”
3. Whether or not a particular claimed invention is inventive requires investigation using an objective test which can be applied to any claim. The test needs to use a specific method that is standardised and structured, rather than impressionistic and general, so that a consistent approach can be taken from case to case. The test is to be decided not on general legal principles (though these inform the approach taken) but on the technical facts of the claim at issue.

The four-step approach of Windsurfing

1. The key case which relates to inventive step, and which has been regularly applied in opposition and revocation cases under the New Zealand Patents Act 1953, is Windsurfing International Inc. v Tabur Marine (Great Britain) Ltd, [1985] RPC 59. In this case, in considering whether claims to a sailboard were obvious, the Court of Appeal stated that:“the question of whether the alleged invention was obvious has to be answered objectively by reference to whether, at the material time (that is, immediately prior to the priority date), the allegedly inventive step or concept would have been obvious to a skilled addressee.”
2. In the same case, the Court stated that the question of obviousness “has to be answered, not by looking with the benefit of hindsight at what is known now and what was known at the priority date and asking whether the former flows naturally and obviously from the latter, but by hypothesizing what would have been obvious at the priority date to a person skilled in the art to which the patent in suit relates.”
3. The Court set out a four-step approach to assess obviousness:   
   (1) Identify the claimed inventive concept.   
   (2) Assume the mantle of the normally skilled but unimaginative addressee in the art at the priority date and to impute to him what was, at that date, common general knowledge of the art in question.   
   (3) Identify what, if any, differences exist between the matter cited as being “known or used” and the alleged invention.   
   (4) Decide, without any knowledge of the alleged invention, whether these differences constitute steps which would have been obvious to the skilled man or whether they require any degree of invention.
4. In DSM NV’s Patent [2001] RPC 35, Neuberger J identified the value of adopting the four-step Windsurfing approach as ensuring   
   “that one does not go straight to the question of obviousness by reference to a general impression as to the evidence as a whole. By adopting the structured approach one ensures that there is a measure of discipline, reasoning and method in one’s approach. Indeed, it helps to ensure that there is consistency of approach in different cases involving the issue of obviousness.”

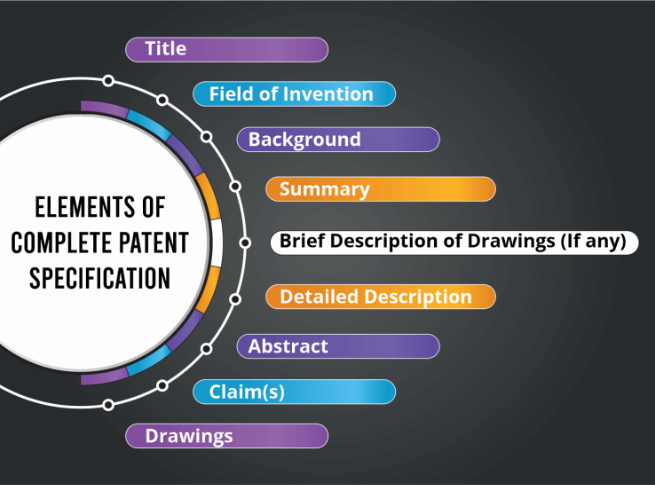
Patent Specification

A patent specification can be defined as a highly technical and legal document that discloses the invention to the public along with the best method of performing it. The language and the content of the patent specification has to be such that it enables the person ordinarily skilled in the art to practice the invention. Secondly, patent specifications should identify the subject matter over which the patent owner intends to claim exclusivity. The language of the document is generally full of technical and legal jargon as it contains scientific details of the invention.

Patent specifications must be drafted carefully from both legal and technical perspective. If the document does not sufficiently disclose the means to recreate the invention, the owner of the patent stands the risk of losing the grant. Similarly, if the scope of the invention is not defined accurately, it allows competitors to circumvent the patent and benefit from it. Therefore, one needs to draft technically sound patent specifications with due care.

Drafting Specifications Based on Type of Patent Application

1. Provisional Patent Application: This type of patent application is filed by an applicant only to secure a patent filing date with the United States Patent and Trademark Office (USPTO). It is filed when the inventor needs more time to perfect his/her invention. While filing a provisional application, the applicant is required to file only provisional patent specifications, which broadly, though not completely, disclose the inventive concept.
2. Non-Provisional Patent Application: Also known as a regular patent application, a non-provisional patent application is filed within 12 months of filing a provisional application to secure patent rights for an invention. Regular patent application must include a complete specification of patent wherein the applicant discloses all details of an invention in a sufficiently clear and complete manner. In contrast to the provisional specifications, complete specification concludes at least one claim for which the protection is sought.



* **Title:** The first part of the complete patent specification should be the title of the invention. The applicant/patent agent must ensure that it fairly captures specific features of the invention. Secondly, the title shouldn’t include abbreviations, the word “patent”, etc. It must clearly spell the objective of the invention and should be between 10-15 words.
* **Field of Invention:** This is the section that highlights general and specific fields in which the subject matter of the invention falls. The field of invention helps the examiner to decide which search fields he/she can look into to find similar published technology, if any. This portion of the specification should ideally start with a general statement on invention to indicate the subject matter that the invention is related to.
* **Background:** This section briefly discusses [prior arts](https://www.uspto.gov/sites/default/files/documents/May%20Info%20Chat%20slides%20%28003%29.pdf) and their drawbacks or disadvantages, if any. The main objective behind providing this information is to distinguish the invention at hand from the ones that are already being practiced in the targeted industry. The background section sets the stage for describing the invention in detail at a later stage.
* **Summary**: As the name suggests, summary gives a gist of the invention – its nature, objective, composition and operation. Most importantly, summary of the invention should come before the description of the claimed invention. Furthermore, the summary briefly mentions solutions to the problems talked about in the background section.
* **Brief Description of Drawings, if any:** Though not mandatory, patent applications often include drawings/flowcharts/figures to visually describe the invention, helping examiner to understand the innovation better. So this section presents a brief overview of the drawings. As per the guidelines of the USPTO, the figures should be clean black-and-white line drawings that accurately illustrate the invention.
* **Detailed Description**: This section focuses on providing sufficient details of the invention, including the structural details, how it is used, its objectives and advantages. Solutions achieved by the invention are covered in depth in this section. Most importantly, the detailed description should be provided in a manner that any person with ordinary skill in the art is able to practice the invention. Furthermore, this part may also include examples explaining the overall working of the invention in different environments and possible variations. Also, the description is written from a perspective that every claim is sufficiently enabled.
* **Abstract:** The complete specification of patent includes an abstract that gives technical information about the invention. Essentially, it’s a summary of the matter in the patent specification. The abstract should not be more than 150 words.
* **Claim(s):** To say the least, claims section is the most critical part of a patent application. This is because the patentability of an invention is determined by them. Claims clearly lay out the scope of the invention for which protection is sought. Claims should cover important aspects of the invention, such as novelty. This section should be written in a manner to provide the broadest possible coverage and protection for the invention, while remaining novel and non-obvious in light of the existing technologies or art.
* **Drawings:**A patent specification document also contains drawings that help in aiding the examiner’s understanding of theinvention. Drawings can be diagrams, flowcharts or figures with numeral labeling that identify components or features of the invention described in the claims and detailed description.

## **How to Draft Error-free Patent Specifications**

* **Avoid Beating Around the Bush**: One of the goals while drafting patent specifications is to eliminate ambiguity. As, it poses a challenge during prosecution. The patent drafter must strike a balance between writing information in detail and keeping it specific at the same time.
* **Stick to Patent Trademark Office (PTO) Guidelines:**Patent offices in various jurisdictions may have their own guidelines for patent drafting. So it is vital to follow them right from the beginning of the drafting process. Additionally, special attention should be given to maintaining the order/sequence of the elements while drafting specifications.
* **Seek Professional Assistance:**Businesses should never hesitate to [seek professional assistance](https://patentdraftingcatalyst.com/) from strategic intellectual property (IP) partners who hold technical and legal prowess in various domains. Furthermore, such IP partners are well-versed with the guidelines of PTOs in various jurisdictions. They provide cost-effective and timely drafting solutions without compromising on quality.

Patent Application

A patent application is a plea for the grant of a patent for the invention described and claimed by the applicant. An application for this purpose generally comprises of a description of the invention, added with official forms and correspondence relevant to the application. Patent applications are of several types, and each one of them caters to a unique purpose.

The types of patent application are:

1. Provisional Application
2. Ordinary or Non-Provisional Application
3. Convention Application
4. PCT International Application
5. PCT National Phase Application
6. Patent of Addition
7. Divisional Application

## Provisional Application

A provisional application, also known as a temporary application, is filed when an invention is under experimentation and isn’t finalized. Moreover, it is a preliminary application which is filed before the patent office for claiming priority, as the Indian Patent Office follows the ‘First to File’ system (known popularly as the First-Come-First-Served-Basis). In technical terms, early filing of an invention will prevent the occurrence of any other related inventions from being designated as prior art to the inventor’s application.

To add more, this type of patent application is filed when an invention requires additional time for development. If an application is supported by a provisional specification, the applicant is necessitated to file a complete specification within twelve months from the date of filing a provisional application. A failure in this part would render the application void.

An application for this purpose must include a brief explanation of the invention and must be drafted in a meticulous manner so as to ensure that the priority rights are secured for the invention.

## Ordinary or Non-Provisional Application

This type of application is filed if the applicant doesn’t have any priority to claim or if the application is not filed in pursuance of any preceding convention application. It must be supported by a complete specification, the likes of which must depict the invention in detail.

Complete specification can be filed through:

* **Direct Filing** – wherein complete specification is initially filed with the Indian Patent Office without filing any corresponding provisional specification.
* **Subsequent Filing** – wherein complete specification is filed subsequent to the filing of the corresponding provisional specification and claiming priority from the filed provisional specification.

A complete specification entails the following:

1. Title
2. A preamble to the invention.
3. The technical field of the invention.
4. Background of the invention.
5. Objects of the invention.
6. Statement of the invention.
7. A brief description of the drawings
8. A detailed description of the invention.
9. Claims
10. Abstract

## Convention Application

A convention application is filed for claiming a priority date based on the same or substantially similar application filed in any of the convention countries. To avail a status of convention, an applicant is required to file an application in the Indian Patent Office within a year from the date of the initial filing of a similar application in the convention country. To re-iterate in simpler terms, a convention application entitles the applicant to claim priority in all the convention countries.

## PCT International Application

As can be deciphered from its name, a PCT Application is an international application. Though the application does not provide for the grant of an international patent, it paves the way for a streamlined patent application process in many countries at one go. It is governed by the Patent Corporation Treaty and can be validated in up to 142 countries. Filing this application would protect an invention from being replicated in these designated countries.

Unlike other applications, it renders the application a time-frame of 30-31 months to enter into various countries from the international filing date or the priority date, thereby affording the applicant with additional time to access the viability of the invention.

Apart from this, it renders the following other benefits:

* The application provides an International Search Report citing prior art, which discloses whether or not the invention is novel.
* It provides an option for requesting an International Preliminary Examination Report, which is a report that contains an option on the patentability of the invention.
* The aforementioned reports facilitate the applicant to make more informed choices early in the patent process, as he/she can amend the application to deal with any conflicting material. Also, the applicant would receive a glimpse of the patentability of the invention before incurring charges for filing and prosecuting the application in each country.

An applicant from India can file this application at:

* The Indian Patent Office (IPO), which acts as the receiving office.
* The International Bureau of WIPO, either after availing a foreign filing permit from IPO or after six weeks and 12 months of filing an application in India.

## PCT National Phase Application

It is considered essential for an applicant to file a national phase application in each of the country wherein protection is sought for. The time-frame for filing the same is scheduled within 31 months from the priority date or the international filing date, whichever is earlier. The time-limit could be enhanced through National Laws by each member country.

With respect to the National Phase Application, the title, description, abstract and claims as filed in the International Application under PCT shall be considered as the Complete Specification. Apart from this, the regulations applicable for filing and processing an ordinary patent application is also applied here.

## Patent of Addition

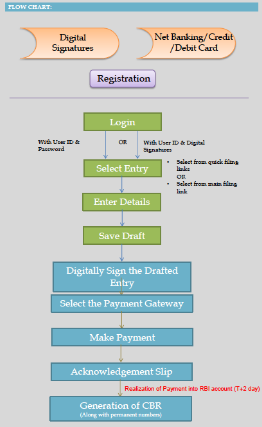
This application must be filed if the applicant discovers that he has come across an invention which is a slight modification of the invention which has already been applied for or patented by the applicant. It can only be filed if the invention doesn’t involve a substantial inventive step.

A patent of addition is only granted after the grant of the parent patent, and hence no separate renewal fee should be remitted during the term of the main patent. Moreover, it shall be granted for a term equal to that of the patent for the main invention, and therefore expires along with the main patent.  The date of filing here shall be the date on which the application for patent of addition has been filed.

## Divisional Application

An applicant may choose to divide an application and furnish two or more applications if a particular application claims for more than one invention. The priority date for these applications is similar to that of the parent application.

Patent process E-filling



The Indian Patent Office has introduced E-filing of patent services way back in 2007 in order to ease the process of filing. Manual filing required submission of hard copies of all the required documents to the appropriate authority. This usually proved to be a long complicated process that was very time-consuming. With the introduction of e-filing, the process became more user-friendly and relatively faster. Though first introduced in the year 2007 e-filing has been made compulsory as per the Patent (Amendment) Rules 2016. Therefore, the Indian Patent office has increased an additional 10% statutory fees for accepting manual filing for patents with effect from 16th May 2016.

Firstly, E-filing of patent services was first introduced in India in the year 2007. This was revamped as the Comprehensive Online Patent Filing Services in the year 2012. All filings are in accordance with Schedule 1 of the Patents Rules, 2003.

1) The first step is to register at Online Filing of Patents platform.  After registering, the user ID and password are generated.

2) The Comprehensive Online Patent Filing Services has a dual login facility. This means that an Applicant or Agent can login either using the User ID and password or the digital signature.

3) Thereafter, logging in the website has a list of comprehensive steps that allow the Applicant to download client software on which he can create and sign the patent application.

4) After uploading the digitally signed patent application the (auto-calculated) payment must be made.

5) The status of the application can be checked.

6) The acknowledgment will generate after receipt of the payment.

This, put in a nutshell, is the process for patent e filing of applications.

###### **Benefits of e-filing of patents in India**:

i. The foremost advantage of e-filing of patent applications is its flexibility. In the sense that a patent application can be filed at any time and at any place.

ii. Increase in speed in another benefit. The electronic medium ensures that the application is filed immediately. There can be no delays as is usual in the case of manual filing. This also ensures that an acknowledgment is generated immediately.

iii. Additionally, even at the patent office, the accuracy increases, given the fact that there is no scope for manual entry of any of the details. This reduction in the margin of error ensures a more efficient review.

iv. While [drafting patent](https://www.intepat.com/ip-services/patent-prosecution/patent-drafting-india/) applications the primary concern for most applicants is adherence to the format. E-filing makes this process easy owing to the available software that can cross-check the format of the application in order to ensure that they comply with the required format. [E-PCT](https://pct.wipo.int/authpage/signin.xhtml) is an online platform that can be used for filing PCT applications. Moreover, e-filing allows for validation with the IPO database.

v. In addition, the introduction of the Comprehensive Online Patent Filing Services has ensured that there are minimum transaction errors.

vi. After registration, each Applicant or Agent will have a unique user profile where he can add and update his digital signature.

Thus, making e-filing of patents compulsory is a welcome move as the transactions will be faster with lesser chances of errors. If you find it difficult to file your patent electronically, you can always engage [professional help](https://www.intepat.com/ip-services/patent-prosecution/patent-filing-in-india/)to guide you through the process and E-filing patent application in India.

Examination of patent

|  |  |
| --- | --- |
| [The Request for Examination](http://www.jurisdiction.com/exam.htm#request)  [The Examination Process](http://www.jurisdiction.com/exam.htm#process)  [Disclosure of Information to the Examiner](http://www.jurisdiction.com/exam.htm#disclosure)  [Advancement of the Application](http://www.jurisdiction.com/exam.htm#advancement)  [The "Office Action"](http://www.jurisdiction.com/exam.htm#officeaction)  [Amendments to the Application](http://www.jurisdiction.com/exam.htm#amendments)   * [introduction](http://www.jurisdiction.com/exam.htm#amendintro) * [adding or subtracting applicants](http://www.jurisdiction.com/exam.htm#amendapplicants) * [amendments to drawings](http://www.jurisdiction.com/exam.htm#drawings) * [dividing subject matter](http://www.jurisdiction.com/exam.htm#dividing) * [adding subject matter: supplementary disclosures](http://www.jurisdiction.com/exam.htm#suppdiscl) * [amendments after allowance](http://www.jurisdiction.com/exam.htm#afterallowance)   [Laying Open of the Application](http://www.jurisdiction.com/exam.htm#layingopen) | [Abandonment & Reinstatement](http://www.jurisdiction.com/abanrein.htm)  [Protests](http://www.jurisdiction.com/exam.htm#protests)  [Conflict Proceedings](http://www.jurisdiction.com/exam.htm#conflict)  [Final Rejection and Rights of Appeal](http://www.jurisdiction.com/exam.htm#final)  [The Approval of the patent application](http://www.jurisdiction.com/exam.htm#approval)  [Issuance of the Patent](http://www.jurisdiction.com/exam.htm#issuance)  [Re-examination](http://www.jurisdiction.com/exam.htm#re-examination)   * [step 1: raising a question](http://www.jurisdiction.com/exam.htm#step1) * [step 2. the re-examination](http://www.jurisdiction.com/exam.htm#step2) * [step 3. the certificate of re-examination](http://www.jurisdiction.com/exam.htm#step3)   [Reissue of Patents](http://www.jurisdiction.com/exam.htm#reissue)  [Disclaimers](http://www.jurisdiction.com/exam.htm#disclaimers) |

#### The Request for Examination

Examination is initiated by filing with the Patent Office a Request for Examination together with the necessary fee [[Patent Act, s. 35(1)](http://www.jurisdiction.com/pact.htm#s35(1))]. The government fee for requesting examination is $200.00 for a [small entity](http://www.jurisdiction.com/sentity.htm); $400.00 for a large entity [Tariff of Fees, Schedule II, Part I, item 3].

Examination must be requested within a certain time period:

* for October 1, 1989 to September 30, 1996 filed applications, within seven (7) years of the Canadian filing date [[Patent Rules, s. 150](http://www.jurisdiction.com/prules.htm#s150)].
* for applications filed on or after October 1, 1996, within five (5) years of the Canadian filing date [[Patent Rules, s. 96](http://www.jurisdiction.com/prules.htm#s96)]

or else the application will be treated as abandoned .

If the application was divided from a parent application, examination must be requested within the same time period as the parent application, or within 6 months of filing the divisional, whichever is later [Patent Rules,[s. 150(2)](http://www.jurisdiction.com/prules.htm) and [96(2)](http://www.jurisdiction.com/prules.htm#s96(2))]. The Commissioner may notify the Applicant to require the filing of a request for examination [[Patent Act, s. 35(2)](http://www.jurisdiction.com/pact.htm#s35(2))].

The Request for Examination can be made by the Applicant or by any other party and must contain the necessary information for the Patent Office to recognize what application is being requested to be examined [Patent Rules, [s. 149](http://www.jurisdiction.com/prules.htm#s149) and [95](http://www.jurisdiction.com/prules.htm#s95)).

Where a timely Request is not filed, and the application goes abandoned [[Patent Act, s. 73(1)(d)](http://www.jurisdiction.com/pact.htm#s73(1)(d)) and [73(1)(e)](http://www.jurisdiction.com/pact.htm#s73(1)(e))], the Patent Office may reinstate the application upon Request for Reinstatement, Request for Examination and payment of the prescribed fee of $200.00 [[Patent Act, s. 73(3)](http://www.jurisdiction.com/pact.htm#s73(3)), [Tariff, Schedule II, Part I, item 7](http://www.jurisdiction.com/prules.htm#schedII_I_7))].

#### The Examination Process

The application is usually referred to Examiners who are familiar with the particular technology of the invention.

The invention described and claimed in the invention is compared by the Examiner in the Patent Office, to the prior art.

The prior art comes from a search done by the Examiner, prior art cited in foreign Patent Offices during examination of corresponding applications and/or documentary materials supplied by anyone to the Patent Office under a Protest [[Patent Act, s. 34.1](http://www.jurisdiction.com/pact.htm#s34.1)].   In the United States, the Applicant has the obligation to disclose relevant prior art to the U.S. Patent Office.

To obtain his or her own prior art, the Examiner reviews patents or patent applications on file in the same or related areas. There is an international classification system for categories of inventions which aids in searching.

There are computerized databases of issued patents and technical and scientific articles which can be searched using "keywords". Caution must be exercised when selecting the appropriate keywords since different words may be used to describe the same kind of invention.

#### Disclosure of Information to the Examiner

An Examiner can formally ask an Applicant to provide copies of prior art cited in foreign corresponding applications [[Patent Rules, s. 29](http://www.jurisdiction.com/prules.htm#s29)]. Where, for example, the United States Patent Office has already done a prior art search and cited prior art against the corresponding U.S. patent application, the job of the Canadian Examiner is made easier by invoking [Patent Rule s.29](http://www.jurisdiction.com/prules.htm#s29): the Canadian Examiner gets the benefit of the search done by the U.S. Patent Offices. The Examiner can also ask for particulars of interference proceedings [[Patent Rules, s. 29(1)(c)](http://www.jurisdiction.com/prules.htm#s29(1)(c))].

The Examiner can also ask for information concerning the first publication of the invention or the first patent for the invention [[Patent Rules, s. 29(2)](http://www.jurisdiction.com/prules.htm#s29(2))]. It is usually in the Applicant’s interest to report the successful issuance of a corresponding patent as it may encourage the Patent Office to issue a patent of similar scope.

If the Applicant cannot supply the information requested, the Applicant must state why the information is not forthcoming [[Patent Rules, s. 29(3)](http://www.jurisdiction.com/prules.htm#s29(3))].

#### Advancement of the Application

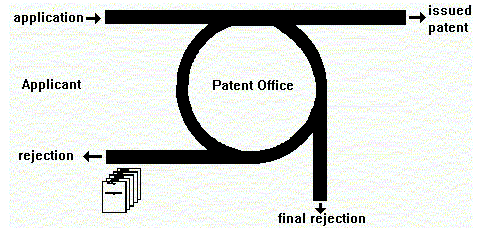
Normally, an application will proceed along with the other applications, in order of its receipt at the Patent Office.

The queue can be "jumped" by requesting in writing **advanced examination** on the ground that a failure to advance the application will likely prejudice the rights of that person [[Patent Rules, s. 28](http://www.jurisdiction.com/prules.htm#s28)].  Evidence must be supplied setting out the facts upon which the request for advancement is based. A government fee of $100.00 is charged [[Patent Rules, Schedule II, Part I, Item 4](http://www.jurisdiction.com/prules.htm#schedII_I_4)].

The request for advancement must be preceded by, or accompanied by, a request for examination of the application. The application must be complete, open to public inspection and have met the formalities (MPOP, s. 13.03).

#### The "Office Action"

After reviewing the application, the Examiner may conclude that the Applicant is required under the Patent Act or Patent Rules to amend the application and will issue a letter to the Applicant setting out the requirements. The letter is referred to as an **Office Action** [[Patent Rules, s. 30(2)](http://www.jurisdiction.com/prules.htm#s30(2))].



**responses to Office Actions**

Applicants are obliged to reply to an office action within 6  months to avoid [abandonment](http://www.jurisdiction.com/abanrein.htm#abandonment) of the application.  They must reply in good faith in an attempt to answer the objection to advance the application to allowance [[Patent Act, s. 73(1)(a)](http://www.jurisdiction.com/pact.htm#s73(1)(a))].  This obligation is usually performed by making the change requested by the Examiner or by arguing with the Examiner that the requirement is not necessary and the objection should be withdrawn.

#### Amendments to the Application

#### Introduction

An application may be amended before it issues either voluntarily or to overcome an objection made by an Examiner in an Office Action [[Patent Act, s. 38.2](http://www.jurisdiction.com/pact.htm#s38.2)].

No amendment can be made to the specification that describes matter not reasonably to be inferred from the specification or drawings [[Patent Act, s. 38.2(2](http://www.jurisdiction.com/pact.htm#s38.2(2)))].

Every amendment must be accompanied by a statement explaining the nature and purpose of the amendment so as to satisfy the Examiner that it is permissible. [[Patent Rules, s. 34](http://www.jurisdiction.com/pact.htm#s34)].

Amendments must be made by providing new pages replacing those altered by the amendment [[Patent Rules, s. 34](http://www.jurisdiction.com/prules.htm#s34)].

#### Adding or Subtracting Applicants

Where there are two or more inventors, and one refuses to assist in the prosecution of the application, or cannot be found, the remaining inventors can proceed without the reluctant or missing inventor. They must satisfy the Commissioner as to the facts, usually by affidavit. The patent will issue to the remaining inventors [[Patent Act, s. 31(1)](http://www.jurisdiction.com/pact.htm#s31(1))].

The situation is similar where too many Applicants were named. The "superfluous" inventor/Applicant can retire and the application will proceed with the remaining Applicants. Affidavit evidence must be submitted to the Commissioner [[Patent Act, s. 31(3)](http://www.jurisdiction.com/pact.htm#s31(3))].

Where not enough Applicants were named, the further Applicants can be joined by satisfying the Commissioner that they should be joined and that their omission was due to inadvertence or mistake and not for the purpose of delay [[Patent Act, s. 31(4)](http://www.jurisdiction.com/pact.htm#s31(4))].

Where joint Applicants cannot agree on how to proceed with an application, or where someone has agreed to assign a patent, when granted, and has not proceeded with the application, the Commissioner can allow the other person to proceed with the application and can grant the patent to that other person [[Patent Act, s. 31(2)](http://www.jurisdiction.com/pact.htm#s31(2))].

There are no provisions for the replacement of a sole applicant.

#### Amendments to drawings

No amendment can be made to the drawings that adds matter not reasonably to be inferred from the specifiaction or drawings as originaly filed, except in so far as it is admitted in the specification that the matter is prior art [[Patent Act, s. 38.2(3)](http://www.jurisdiction.com/pact.htm#38.2(3))].

#### Dividing Subject Matter

A patent is supposed to protect **one** invention [[Patent Act, s. 36(1)](http://www.jurisdiction.com/pact.htm#s36(1))]. In Canada, a patent can contain apparatus and method claims. No division is required where a patent application claims:

1. a product and a process for making the product;
2. a product and a use of the product;
3. a product, a process for making the product and a use of the product;
4. a process and an apparatus specially adapted to carry out the process;
5. a product, a process for making the product and an apparatus specially adapted to carry out the process; or
6. a product, a process for making the product and an apparatus specially adapted to carry out the process and a use of the product [MPOP, s. 14.02].

In the United States, separate patents are often obtained for devices and methods.

Where a patent application discloses and claims more than one invention, the application must be limited to one invention and the applicant may **divide**out the other invention [[Patent Act, s. 36(2)](http://www.jurisdiction.com/pact.htm#s36(2))].

Both the original application and the **divisional application**, share a common filing date, but the Patent Office requires a second set of fees in respect of the divisional application [[Patent Act, s. 36(4)](http://www.jurisdiction.com/pact.htm#s36(4))].

#### Adding Subject Matter: Supplementary Disclosures - Pre-October 1, 1989 applications only [Pre-Oct. 1, 1989 Patent Rules, s. 57.1)

New matter, which is intimately associated with the matter described in the existing disclosure, can be made the subject of a **Supplementary Disclosure**[Pre Oct.1, 1989 Patent Rules, s. 53] (so long as the application has not yet been allowed [Pre Oct.1, 1989 Patent Rules, s. 55]. Only one supplementary disclosure is allowed per application [Pre Oct.1, 1989 Patent Rules, s. 56].

The supplementary disclosure forms part of the patent as issued and is taken as having been filed on the date the amendment was applied for [Pre Oct.1, 1989 Patent Rules, s. 53].

If there are claims in an application that are fully supported only by he supplementary disclosure, then they are identified as such and are separated from other claims in the application [Pre Oct.1, 1989 Patent Rules, s. 54]. There must be other claims supported by the original disclosure [Pre Oct.1, 1989 Patent Rules, s. 57].

#### Amendments after allowance

Amendments (other than clerical errors) cannot be made after allowance unless:

* + the amended application complies with the Act and Rules
  + the amendment does not require a further search by the Examiner; and
  + a fee of $200 is paid [[Schedule II, Part I, Item 5](http://www.jurisdiction.com/prules.htm#schedII_I_5)] [[Patent Rules, s. 32](http://www.jurisdiction.com/prules.htm#32)].

#### Laying Open of the Application

The patent application is laid open for public inspection on the earliest of the following dates:

(a)    18 months from its Canadian filing date;

(b)    18 months from its priority date (if it has one); or

(c)    earlier when requested by the Applicant [[Patent Act, s. 10(2)](http://www.jurisdiction.com/pact.htm#10(2))].

A request for priority may be withdrawn to create a later laying-open date.

#### Protests

Third parties can object to the grant of a patent by means of a **protest**. The third party files prior art and explains its pertinence to the application [[Patent Act, s. 34.1](http://www.jurisdiction.com/pact.htm#s34.1)].

The third party’s protest is acknowledged by the Patent Office, but it is not given information as to the action taken on it [[Patent Rules, s. 10](http://www.jurisdiction.com/prules.htm#s10)].

#### Conflict Proceedings - Old Patent Rules 66-74

Under the "old" Patent Act, (prior to October 1, 1989) the patent was to be granted to the Applicant who was the **first-to-invent**. Where there were two applications for the same invention, or overlapping inventions:

where each application contained one or more claims defining substantially the same invention; or

where one or more claims from one application described the invention disclosed in the other application,

the Commissioner of Patents would declare that a conflict existed. A mini-trial within the Patent Office would follow, to determine who was the first inventor (Pre-Oct. 1, 1989 Patent Act s. 43).

The current **first-to-file** system awards the patent to the first person to apply to patent the invention, thus doing away with the need for conflict proceedings.

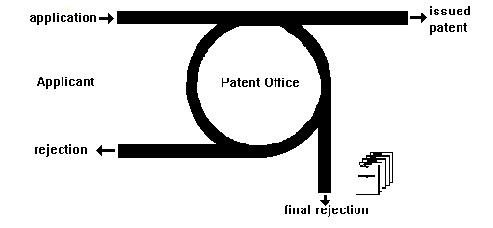
#### Final Rejection and Rights of Appeal

If the Applicant does not satisfy the Examiner’s objection, then the Examiner can issue a second office action on the same ground.

If the Examiner makes the action a **Final Action**, and the Applicant amends the application or provides acceptable arguments that the application should be allowed, the rejection is withdrawn [[Patent Rules, s. 30(5)](http://www.jurisdiction.com/prules.htm#s30(5))].

If the rejection is not withdrawn, then the application is forwarded to the Patent Appeal Board and the Applicant is given an opportunity to be heard [[Patent Rules, s. 30(6)](http://www.jurisdiction.com/prules.htm#s30(6)), MPOP 21.04]

The Patent Appeal Board’s findings are given to the Commissioner for consideration [MPOP, s. 21.06].



After the Applicant has received a **Final Action**, the application cannot be amended other than:

* by amending as required by the Examiner in the Final Action,
* where the Commissioner withdraws the rejection after review,
* where the Commissioer informs the Applicant of a required amendment or
* by order of the Federal Court or Supreme Court of Canada [[Patent Rules, s. 31](http://www.jurisdiction.com/prules.htm#s31)].

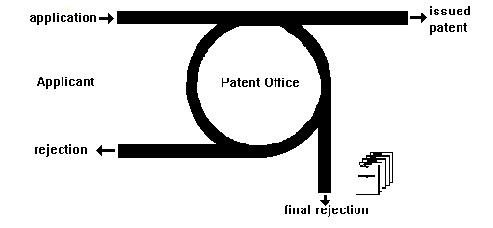
#### The approval of the patent application

When the application is found to be allowable, a notice of allowance is given to the Applicant together with notice of the deadline for paying the **final fee**[[Patent Rules, s. 30(1)](http://www.jurisdiction.com/prules.htm#s30(1))].

If after allowance, the Commissioner finds that the application should not be allowed, he will withdraw the notice of allowance and notify the Applicant, returning any final fee [Patent Rules, [s. 30(7)](http://www.jurisdiction.com/prules.htm#s30(7)) & [4(10)(a)](http://www.jurisdiction.com/prules.htm#s4(10))].

#### Issuance of the Patent

The patent will issue between approximately 6 and 12 weeks from the date of payment of the final fee.



All documents evidencing the title to the invention should be filed on or before the day the final fee is paid so that the patent issues to the proper owner [[Patent Rules, s. 41](http://www.jurisdiction.com/prules.htm#s41)].  The patent will issue to the inventor and his legal representative (in other words the party having title to the patent) according to their interests as evidenced in documents filed (and acceptable for registration) as of the day the final fee is paid.  In the case of joint Applicants, the patent is granted in the name of all the Applicants [[Patent Act, s. 31(5)](http://www.jurisdiction.com/pact.htm#s31.5)].  The person to whom the patent issues is referred to as the **Grantee** or **Patentee**.

#### Re-examination

The examination process can be re-visited by a procedure called re-examination. Re-examination is limited to providing the Patent Office with:

* prior art in the form of patents, applications for patents open to the public and printed publications [[Patent Act, s. 48.1(1)](http://www.jurisdiction.com/pact.htm#s48.1(1))];
* one set of submissions with respect to the pertinence of the prior art and the manner of applying the prior art to the claim for which re-examination is requested [[Patent Act, s. 48.1(2)](http://www.jurisdiction.com/pact.htm#s48.1(2))]; and
* the necessary fee ($1000.00 where requested by a [small entity](http://www.jurisdiction.com/sentity.htm); $2000.00 for a large entity).

Unless the re-examination is requested by the Patentee, the request for re-examination and the prior art must be submitted in duplicate [[Patent Rules, s. 45](http://www.jurisdiction.com/prules.htm#s45)].

After receiving a request for re-examination from a third party, the Commissioner sends a copy of it to the Patentee [[Patent Act, s. 48.1(3)](http://www.jurisdiction.com/pact.htm#s48.1(3))].

#### step 1: raising a question

The Commissioner establishes a Re-examination Board (with at least three members, at least two of whom are Patent Office employees) who will determine the re-examination [[Patent Act, s. 48.2(1)](http://www.jurisdiction.com/pact.htm#s48.2(1))] within three months of the request [[Patent Act, s. 48.2(2)](http://www.jurisdiction.com/pact.htm#s48.2(2))]. The Board must determine whether the request raises "a substantial new question of patentability affecting any claim of the patent" [[Patent Act, s. 48.2(2)](http://www.jurisdiction.com/pact.htm#s48.2(2))].

If the Board finds that there is **no**substantial new question raised, they advise the person who requested re-examination. The decision of the Board is final and is not subject to appeal or review by any Court [[Patent Act, s. 48.2(3)](http://www.jurisdiction.com/pact.htm#s48.2(3))].

#### step 2. the re-examination

If the Board finds that there **is** a substantial new question raised by the request, the Board so notifies the Patentee together with their reasons [[Patent Act, s. 48.2(4)](http://www.jurisdiction.com/pact,htm#s48.2(4))]. The Patentee may, within 3 months of the Board’s notice submit to the Board a Reply setting out submissions as to the patentability of the claim of the patent in issue [Patent Act, s. 48.2(5)]. The Patentee may propose an amendment to the patent or any new claims, so long as nothing is done to enlarge the scope of a claim [[Patent Act, s. 48.3(2)](http://www.jurisdiction.com/pact.htm#s48.3(2))].

Upon receiving the Reply (or after 3 months, if no Reply is received), a Re-examination Board will commence a re-examination [[Patent Act, s. 48.3(1)](http://www.jurisdiction.com/pact.htm#s48.3(1))].

The re-examination proceeding must be completed within 12 months of the commencement of the re-examination [[Patent Act, s. 48.3(3)](http://www.jurisdiction.com/pact.htm#s48.3(3))].

#### step 3. the certificate of re-examination

The final decision of the Re-examination Board takes the form of a certificate. The certificate:

* confirms the claim to be patentable;
* cancels the claim if it is "unpatentable"; or
* incorporates into the patent the proposed amended or new claim [[Patent Act, s. 48.4](http://www.jurisdiction.com/pact.htm#s48.4)).

A copy of the certificate is attached to the patent and made part of it by reference. A copy is also mailed to the Patentee [[Patent Act, s. 48.4(2)](http://www.jurisdiction.com/pact.htm#s48.4(2))].

The decision of the Re-examination Board can be appealed to the Federal Court [[Patent Act, s. 48.5(1)](http://www.jurisdiction.com/pact.htm#s48.5(1))] within 3 months from the date the certificate is mailed to the Patentee [[Patent Act, s. 48.5(2)](http://www.jurisdiction.com/pact.htm#s48.5(2))].

The certificate gives the change retroactive effect. Where the claim is canceled, the claim is to be treated as if it had never been granted. Other claims remain unaffected. New or amended claims are to be treated as if they issued on the date of the certificate, for the unexpired term of the patent [[Patent Act, s. 48.4(3)](http://www.jurisdiction.com/pact.htm#s48.4(3))].

#### Reissue of Patents

The Reissue procedure is used to fix certain types of mistakes in issued patents. The Reissuance must be sought within 4 years from the date of issuance of the patent [[Patent Act, s. 47(1)](http://www.jurisdiction.com/pact.htm#s47(1))]. The Patentee must surrender the patent to the Commissioner and pay a fee [[Patent Act, s. 47(1)](http://www.jurisdiction.com/pact.htm#s47(1))] of $800.00 [[Patent Rules, Schedule II, Item 12](http://www.jurisdiction.com/prules.htm#schedII-I-12)]. The Commissioner will cause a new patent to issue, with an amended description and specification, which will last for the unexpired term of the original patent [[Patent Act, s. 47(1)](http://www.jurisdiction.com/pact.htm#s47(1))].

To be entitled to a reissuance, the Patentee must show that the patent is defective or inoperative by reason of:

* insufficient description and specification, or
* the Patentee having claimed more or less than he had a right to claim as new;

- and -

* the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention.

When the reissue patent issues, the original patent is surrendered. A revised claim of the reissue patent has the effect as if they had been originally filed in that form before the issuance of the earlier patent [[Patent Act, s. 47(2)](http://www.jurisdiction.com/pact.htm#s47(2))]. The reissuance has no effect on claims which were not amended - they constitute a continuation and have effect from the date of the original patent [[Patent Act, s. 47(2)](http://www.jurisdiction.com/pact.htm#s47(2))].

The mistake can be that of the patent agent where he failed to make the Canadian patent application the same as the corresponding American application ([Mobil Oil at p. 10](http://www.jurisdiction.com/mob-oil2.htm#10)).

#### Disclaimers

Whenever, by any mistake, accident or inadvertance, and without any wilful intent to defraud or mislead the public, a Patentee has a patent that:

* claims more than what the inventor invented [[Patent Act, s. 48(1)(a)](http://www.jurisdiction.com/pact.htm#s48(1)(a))]; or
* claimed that someone was an inventor of a material or substantial part of the invention patented, but the Patentee has no lawful right to that material or substantial part [[Patent Act, s. 48(1)(b)](http://www.jurisdiction.com/pact.htm#s48(1)(b))]

the Patentee may**make a disclaimer** of such parts that the Patentee does not claim to hold [[Patent Act, s. 48(1)](http://www.jurisdiction.com/PACT.HTM#s48(1))].

The disclaimer is made by submitting a completed copy of Form 2, Schedule I [[Patent Rules, s. 44](http://www.jurisdiction.com/prules.htm#s44)] accompanied by the fee [[Patent Act, s. 48(1)](http://www.jurisdiction.com/pact.htm#s48(1))] of $100.00 [[Patent Rules, Schedule II, item 13](http://www.jurisdiction.com/prules.htm#schedII-I-13)].

Following the making of a disclaimer, the patent is valid for such material and substantial part of the invention as is not disclaimed [[Patent Act, s. 48(6)](http://www.jurisdiction.com/pact.htm#s48(6))]. The disclaimer does not affect any pending action [[Patent Act, s. 48(4)](http://www.jurisdiction.com/pact.htm#s48(4))].