

Topic: Roles and Responsibilities of the Position holder

Concept: - Appointment of Examiners and Controller as per the Act
- Role of Examiner of Patents

Objective: To understand the roles and responsibilities of the officers

1. Appointment of Controller and Examiner under the Act

The Patent Office functions under the superintendence and control of the Controller General of Patents, Designs and Trade Marks (CGPDTM), Mumbai. The Office of CGPDTM is a sub-ordinate office under the Department for Promotion of Industry and Internal Trade (DPIIT), Government of India. The Patent Office discharges its statutory functions in accordance with the provisions of the Patents Act, 1970 (as amended) and corresponding Patents Rules, 2003 (as amended) and the Designs Act, 2000 and corresponding Designs Rules, 2001 (as amended), respectively.

Under the Patents Act, 1970 (India), the Controller refers to the Controller General of Patents, Designs, and Trade Marks (CGPDTM). The Controller is the head of the Indian Patent Office and is responsible for administering the provisions of the Patents Act, 1970.

CGPDTM is appointed by the Central Govt under section 3(1) of the Trade Marks Act, 1999 (47 of 1999) which states as follows-

3. Appointment of Registrar and other officers.—

(1)The Central Government may, by notification in the Official Gazette, appoint a person to be known as the Controller-General of Patents, Designs and Trade Marks, who shall be the Registrar of Trade Marks for the purposes of this Act.

Section 2(b) of the Patents Act, 1970 defines ‘Controller’ as follows-

“Controller” means the Controller-General of Patents, Designs and Trade Marks referred to in section 73

Section 73 (1) of Patents Act, 1970 states that

The Controller General of Patents, Designs and Trade Marks appointed under sub-section (1) of [section 3 of the Trade Marks Act, 1999 (47 of 1999)] shall be the Controller of the Patents for the purpose of this Act

Therefore, the CGPDTM appointed under the Trade Marks Act is the “Controller” for the purpose of the Patents Act. The Controller may delegate his powers to the officers (Group-A) as mentioned below

- Senior Joint Assistant Controller of Patents and Designs (Sr, JC)
- Joint Controller of Patents and Designs (JC)
- Deputy Controller of Patents and Designs (DC)
- Assistant Controller of Patents and Designs (AC)

All the above mentioned officers exercise the delegated powers of the Controller under the Act.

The other statutory post under the Group A category is the Examiner of Patents & Designs (Examiner). The Examiners are appointed by the Central Govt. under section 73(2) of The Patents Act, 1970, which states as follows-

*For the purposes of this Act, the Central Government may appoint as many **examiners** and other officers and with such designations as it thinks fit.*

The Examiners so appointed discharge under the superintendence and direction of the Controller such functions of the Controller under the Act which the Controller may authorize them to discharge from time to time by a general or special order.

The Controller has the authority to withdraw any matter pending before the Examiner by an order in writing and recording the reasons thereof. The matter may be dealt by the Controller himself or transferred to some other Examiner/officer to proceed either *de novo* or from the stage it was transferred, as the case may be.

2. Role of Examiner of Patents

The general role of the Examiners are defined in section 73(3) of the Patents Act which states-

Subject to the provisions of this Act, the officers appointed under subsection (2) shall discharge under the superintendence and directions of the Controller such

functions of the Controller under this Act as he may, from time to time by general or special order in writing, authorise them to discharge.

An Examiner assists in the examination of patent applications. Examiners play a crucial role in assessing whether an invention satisfies the legal requirements for patentability and submits a report to the Controller. Examiners also assist the Controllers in all procedural, administrative and supervisory functions connected with various proceedings under the said Act and the Rules.

The role and duties of Examiners under the Patents Act, 1970 (as amended) are primarily defined in Section 12 and Section 13 of the Act.

Section 12: Examination of Application

- This section outlines the responsibilities of the Examiner in examining a patent application.
- It mandates the Examiner to make a report on the following
 - whether the application and the [specification and other documents relating thereto] are in accordance with the requirements of this Act and of any rules made thereunder;
 - whether there is any lawful ground of objection to the grant of the patent under this Act in pursuance of the application;
 - the result of investigations made under section 13; and
 - any other matter which may be prescribed.

Section 13: Search for Anticipation by Previous Publication and by Prior Claim

- This section focuses on the prior art search conducted by the Examiner.
- The Examiner is required to search for previous publications and existing claims to determine whether the invention has already been disclosed or patented.
- The report of this search is submitted to the Controller as part of the examination process.

At present, the Indian Patent Office has four examination groups based on the broad area of specialization viz.:

- Group 1: Chemistry and allied subjects.
- Group 2: Biotechnology, Microbiology and allied subjects.
- Group 3: Electrical, Electronics & related subject
- Group 4: Mechanical and other subjects.

Based on their educational background and specialization, patent applications of relevant field are allotted to the concerned Examiner for examination.

The Examiner's role is central to ensuring that only inventions meeting the statutory requirements for patentability are granted protection, maintaining the integrity of the patent system. One of the most important tasks of a patent examiner is to review the disclosure in the application and to compare it to the prior art. This involves reading and understanding a patent application, searching the prior art (including prior patent applications and patents, scientific literature databases, etc.), to determine what contribution the invention has made over the prior art. Subsequently, the Examiner makes a report of the same to the Controller, which is further communicated to the applicant. The report of the Examiner contains the collection of the objections that may exist against the grant of a patent. Examiners are also involved in screening and classification of patent applications, preparation of detailed examination reports, consideration of observation/submissions and proposed amendments, can act as chairman/member of opposition board, assisting Controllers in opposition matters, administrative supervision of staff working under them etc. In other words, an examiner reviews a patent application substantively to determine whether it complies with the legal requirements for granting of a patent.

On an application being referred to him by the Controller, the Examiner makes a report on the patentability as well as other matters to the Controller ordinarily within one month but not exceeding three months from the date of such reference.

India is also recognized as International Search Authority (ISA) and International Preliminary Examining Authority (IPEA) under PCT. Examiners and Officers appointed under section 73(2) to work as ISA/IPEA Examiner conducts international search and examination procedures under PCT to establish international search reports (ISR), Written Opinion (WO)

of ISA, and International Preliminary Report on Patentability (IPRP) under various provision of PCT rules and regulation for international patent application choosing India as ISA/IPEA.

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