



## PATENT LAW - POST-DATING DECODED

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Postdating as discussed under Sections 9(4) and 17(1) of the Indian Patents Act, 1970, provides the advantage to the Applicant to push the Priority Date to any later date thereby giving the Applicant additional time to file the additional and/or necessary modifications in the complete after provisional patent application or some more time to conduct the experimentation and complete the invention. However, the Applicant may lose his priority date and inventiveness in the patent application to other Applicants who have filed patent applications relating to the same or substantially same invention or even by use of the patent under consideration in the period between the filing and the post-dating.

### Legislative Intent behind Post-Dating

Shri Justice N. Rajagopala Ayyangar in the Ayyangar Committee Report first discussed the matter of post-dating of a patent application in September 1959 by referring to the laws present in Australia and the UK. Section 5 of the UK Patent Act, 1959 discussed the separation of priority date for claims for the purpose of determining novelty from the date from which the patent should be effective. This section formed the base of clause 10 that detailed the '*Priority dates of claims of Complete Specification*'. Additionally, Section 44 of the Australian Patent Act, 1952 implemented these provisions. Though the 1952 Act was repealed by the 1990 Act, the basic provisions relevant to patent priority dating remained the same and the repealed Act defined what Priority date actually included under Section 43 and additionally stated that the priority date of a claim of a

specification may be different from the priority date of any other claim of the specification. The above mentioned sections have been noted below:

**5. Priority date of Claims of Complete Specification** (UK PATENTS ACT, 1949) -

*(1) Every claim of a complete specification shall have effect from the date prescribed by this section in relation to that claim (in this Act referred to as the priority date); and a patent shall not be invalidated by reason only of the publication or use of the invention so far as claimed in any claim of the complete specification, on or after the priority date of that claim, or by the grant of another patent upon a specification claiming the same invention in a claim of the same or later priority date.*

*(2) Where the complete specification is filed in pursuance of; a single application accompanied by a provisional specification or by a specification which is treated by virtue of a direction under subsection (4) of section three of this Act as a provisional specification, and the claim is fairly based on the matter disclosed in that specification, the priority date of that claim shall be the date of filing of the application.*

*(3) Where the complete specification is filed or proceeded with in pursuance of two or more applications accompanied by such specifications as are mentioned in the last foregoing subsection, and the claim is fairly based on the matter disclosed in one of those specifications, the priority date of that claim shall be the date of filing of the application accompanied by that specification.*

*(4) Where the complete specification is filed in pursuance of a convention application and the claim is fairly based on the matter disclosed in the application for protection in a convention country or, where the convention application is founded upon more than one such application for protection, in one of those applications, the priority date of that claim shall be the date of the relevant application for protection.*

*(5) Where, under the foregoing provisions of this section, any claim of a complete specification would, but for this provision, have two or more priority dates, the priority date of that claim shall be the earlier or earliest of those dates.*

*(6) In any case to which subsections (2) to (5) of this section do not apply, the priority date of a claim shall be the date of filing of the complete specification.*

**44. Each claim of Complete Specification to have priority date** (AUSTRALIA PATENT ACT 1952 – repealed by 1990 Act) -

*(1) There shall be a priority date for each claim of a complete specification*

*(2) A claim of a complete specification shall indicate the date which the applicant considers to be the priority date of that claim*

**43. Priority Dates** (AUSTRALIA PATENT ACT 1990 – repealed 1952 Act) -

(1) *Each claim of a specification must have a priority date.*

(2) *The priority date of a claim is:*

*(a) the date of filing of application; or*

*(b) where the regulations provide for the determination of a different date as the priority date – the date determined under the regulations.*

(3) *Where a claim defines more than one form of an invention, then, for the purposes of determining the priority date of the claim, it must be treated as if it were a separate claim for each form of the invention that is defined.*

(4) *The priority date of a claim of a specification may be different from the priority date of any other claim of the specification.*

The Ayyangar Committee Report suggested additional provisions which were stated neither in clause 10 of the Patents Bill 1953 nor Section 5 of the UK Act 1949. The first suggestion dealt with the effect of post-dating on the application of a patent as has been stated by Terrell in 'Law of Patents' on Page 39 as given below paragraph. This puts forward the advantage to the applicant to extend the time period in situations when he wants to make certain amendments or additions to the filed application accompanied by the specifications as well as in situations when he has failed to file the Complete Specification in the required time period. On the contrary, the limitation faced by the applicant when he applies for post-dating, his patent application include losing out on inventiveness when other applicants file for their patents and/or use and/or publication of the patent in the time period that the application has been post-dated.

*“The applicant gets more time for filing a complete specification for putting his application in order but at the risk of having his patent wholly or partially invalidated by some disclosure or application made meanwhile”. (Terrell in 'Law of Patents' on Page 39)*

While another provision suggested by the Ayyangar Committee Report in determining the Priority date where Complete Specification is preceded by more than one Provisional Specifications and the claim is based on matter fairly discussed partly in one and partly in another Provisional Specification. The committee stated that in the

absence of such provision the Priority date would be the date of filing Complete Specification which they felt to be not proper.

clause 10 was redrafted to consider the above provisions and below paragraph is the final clause as put forward in the Patents Bill 1953.

**10. Priority dates of claims of a complete specification –**

*(1) There shall be a priority date for each claim of a complete specification.*

*(2) Each claim of a complete specification shall indicate the date which the applicant considers to be the priority date of that claim.*

*(3) Where a complete specification is filed in pursuance of a single application accompanied by –*

*(a) a provisional specification, or;*

*(b) by a specification which is treated by virtue of a direction under sub-section (3) of section 8 as a provisional specification;*

*and the claim is fairly based on the matter disclosed in the specification referred to in (a) or (b) above, the priority date of that claim shall be the date of the filing of the relevant Specification.*

*(4) Where the complete specification is filed or proceeded with, in pursuance of two or more applications accompanied by such specifications as are mentioned in the preceding sub-section and the claim is fairly based on the matter disclosed*

*(a) in one of those specifications, the priority date of that claim shall be the date of filing of the application accompanied by that specification,*

*(b) partly in one and partly in another the priority date of that claim shall be the date of the filing of the application accompanied by the specification of the later date.*

*(5) Where the complete specification has been filed in pursuance of a further application made by virtue of Section 16 (1) of this Act and the claim is fairly based on matter disclosed in any of the earlier specifications, provisional or complete, as the case may be, the priority date of that claim shall be the date of the filing of that specification in which the matter was first disclosed.*

*(6) Where, under the foregoing provisions of this section, any claim of a complete specification would, but for the provisions of this sub-section, have two or more priority dates, the priority date of that claim shall be the earlier or earliest of those dates.*

*(7) In any case to which sub-sections (3) to (6) do not apply, the priority date of a claim shall, subject to the provisions of section 83, be the date of filing of the complete specification.*

*(8) The reference to the date of the filing of the application or of the complete specification in this section shall in cases where there has been a post-dating under subsections (2) or (3) of Section 16 of this Act, be a reference to the date as so post-dated.*

*(9) A claim in a complete specification of a patent shall not be invalid by reason only of—*

*(a) the publication or use of the invention so far as claimed in that claim on or after the priority date of that claim; or*

*(b) the grant of another patent which claims the invention, so far as claimed in the first mentioned claim, in a claim of the same or a later priority date.*

Analyzing the above-mentioned sections and clauses, we clearly observe that in a situation where there is available a provisional specification filed along with the application prior to filing the complete specification, the priority date would be the date of filing of provisional specification. On the other hand, in a situation when complete specification has been filed in the absence of provisional specification then the Priority date would be the date of filing of complete specification. It is this Priority date, i.e. the date of earliest filing of the relevant specification that would be post-dated when requested by the applicant.

### **Post-dating in the present scenario**

We cite the relevant parts of Sections 9 and 17 of the Indian Patent Act 1970 as under to provide a foundation to the analysis undertaken in this article.

#### ***9. Provisional and complete specifications. –***

*(1) Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) is accompanied by a provisional specification, a complete specification shall be filed within twelve months from the date of filing of the application, and if the complete specification is not so filed, the application shall be deemed to be abandoned.*

*(3) Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) is accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant so requests at any time within twelve months from the date of filing of the application, direct that such specification shall be treated, for the purposes of this Act, as a provisional specification and proceed with the application accordingly.*

*(4) Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under sub-section (3) as a provisional specification, the Controller may, if the applicant so requests at any time before grant of patent, cancel the provisional specification and post-date the application to the date of filing of the complete specification.*

**17. Power of Controller to make orders respecting dating of application. –**

*(1) Subject to the provisions of section 9, at any time after the filing of an application and before the grant of the patent under this Act, the Controller may, at the request of the -applicant made in the prescribed manner, direct that the application shall be post-dated to such date as may be specified in the request, and proceed with the application accordingly:*

*Provided that no application shall be post-dated under this sub-section to a date later than six months from the date on which it was actually made or would, but for the provisions of this sub-section, be deemed to have been made.*

Briefly looking at Sections 9(1) and 9(3), we form a base to the concept of Post-dating. Analyzing Section 9(1), we see that the Act establishing the ground rule of setting the time period of 12 months within which the Applicant should file the Complete Patent Application from date of filing of Provisional Patent Application, failing which the patent application shall be deemed to be abandoned.

In a situation, when a Complete Specification is filed along with the Application instead of the Provisional Specification as stated in Section 9(1), Section 9(3) gives the opportunity to the Applicant of converting such Complete Specification into a Provisional Specification by making a request for the same to the Controller. However, said request must be made within 12 months from the filing of patent application. This section can be availed by the Applicant when he wishes to make additions or changes to the already filed patent application and hence gain another chance to file the Complete Specification at a later stage within the prescribed time limit.

**Illustrations:**

- (a) 'A' filed for a patent application accompanied with the Provisional Specification on January 1, 2016. Sec 9(1) states that 'A' should file the Complete Specification by December 31, 2016.*

*(b) 'A' has filed a patent application for a mechanical process accompanied with a Complete Specification on January 1, 2016. He makes a gadget in October 2016 which can be added to the patent applied for in order to make the process quicker. He can convert the said Complete Specification into a Provisional Specification under Section 9(3) by putting forth a request to the Controller till December 31, 2016 after which such provision will not be available to him. Henceforth he shall have till December 31, 2016 to file the Complete Specification as the previous Complete Specification will be treated as a Provisional Specification.*

The most interesting aspect of Section 9 is sub-section (4) which is also a key factor under the Patents Act, 1970 influencing the concept of Post-Dating. Under this sub-section, the Applicant is faced with a situation where he has invented a device and/or method/process which he wants to add to the patent application already filed. He may have filed either a Complete Specification within the prescribed time period soon after filing the Patent Application accompanied with the Provisional Specification or he may have filed a Specification which has been treated as a Provisional Specification on request of the Applicant as prescribed under Section 9(3). In either of these situations, the Applicant can put in a request to the Controller to cancel the date of filing of the Provisional Specification and instead post-date the application to the date of filing Complete Specification. What would result from this post-dating request is that two (2) Provisional Specifications would be created, the first being the original one that was filed on the Filing date and the second being the Post-dated Complete Specification that has been converted to the Provisional Specification. Hereinafter, the Applicant would be required to file a single Complete Specification claiming the priority of both the Provisional Specifications. Here the earlier priority date will no longer be valid and instead the post-dated date will be treated as the Priority date thereby giving the additional time to the Applicant to file the Complete Specification. This provision is available to the Applicant only till before the patent is granted after which this provision will no longer be available to the Applicant.

There are many discussions and questions that come to the forefront while analyzing Section 9(4). The most important point to consider here is that the law is pretty clear in

stating that the date of post-dating cannot exceed nor go beyond the date of filing Complete Specification and there can be no other perspective on reading this subsection.

#### Illustration:

- (a) 'A' files a patent application accompanied with the Complete Specification on January 1, 2016. On June 1, 2016 he invents a device that will reduce the time taken for manufacturing a particular item the particulars of which, he wants to add to the filed patent application. He requests the Controller to convert the Complete Specification into a Provisional Specification as per Section 9(3) and under Section 9(4) requests for post-dating the said application to May 1, 2016. The Applicant has a time period of 12 months from May 1, 2016 to file the Complete Specification as per Section 9(1).
- (b) 'A' files a patent application on January 1, 2016 accompanied with a Specification which he requests to be treated as a Provisional Specification. On June 1, 2016 he invents a device that will reduce the time taken for manufacturing a particular item the particulars of which he wants to add to the filed patent application. He requests the Controller to cancel the previous Provisional Specification and post-date the said application to May 1, 2016 under Section 9(4). The Applicant has a time period of 12 months from May 1, 2016 to file the Complete Specification as per Section 9(1).

#### Case Laws:

The concept of post-dating has been discussed in *Standipack Private Limited and Another vs. M/s. Oswal Trading Co. Ltd* [AIR2000Delhi23, 1999(19)PTC479(Del)] wherein the judgment given by the Single Judge Bench as stated in Paragraph 8 deemed that the correct post-dating was on the 11.10.1990 when the Complete Specification was filed and not on 11.07.1989 as stated by the Controller after the patent application was filed on 11.04.1989. Unfortunately, after this judgment there has been no other case where the post-dating issues have been discussed in India in order to further analyze this section.

From the above interpretation of Section 9(4), we can state that when an application for post-dating is affected or influenced by the filing of the Provisional and/or Complete Specifications, Section 9(4) takes priority over Section 17.



The provisions of Section 9 should be kept in mind while reading Section 17(1) which discusses the power of the Controller while dealing with requests for post-dating the application before the grant of patent application+. The Controller, on request by the Applicant, shall post-date the application to a period of not more than 6 months from the date on which such application is made or deemed to be made. An in-depth reading shows that this sub-section is silent on the words 'Complete Specification' and/or 'Provisional Specification' as are noted in Section 9 and deals only with the "patent application" and its post-dating.

Reading and interpreting Sections 9(4) and 17(1) together, we see that when the Applicant converts or cancels the existing Complete Specification or Provisional Specification as the case may be, there will be a shift in the date of filing of the patent application by a period of 6 months from the original filing date. This 6 months limit is what has been specified under Section 17(1) in the words "*Provided that no application shall be post-dated under this sub-section to a date later than six months from the date on which it was actually made or would, but for the provisions of this sub-section, be deemed to have been made.*" As has been discussed earlier in the present study paper, this section includes only the "patent application" and hence is not influenced by the dates of filing of either the Provisional and/or the Complete Specification(s).

#### Illustration:

- (a) 'A' files a patent application accompanied with a Complete Specification on January 1, 2016. On June 1, 2016 he invents a device that will reduce the time taken for manufacturing a particular item the particulars of which, he wants to add to the filed patent application. He requests the Controller to convert the Complete Specification into a Provisional Specification as per Section 9(3) and under Section 9(4) requests for post-dating the said application to May 1, 2016. The Applicant has a time period of 12 months from May 1, 2016 to file the Complete Specification as per Section 9(1).
- (b) 'A' files a patent application on January 1, 2016 accompanied with a Specification which he requests to be treated as a Provisional Specification. On June 1, 2016 he invents a device that will reduce the time taken for manufacturing a particular item the particulars of which he wants to add to the filed patent application. He requests the Controller to cancel the previous Provisional Specification and post-date

*the said application to May 1, 2016 under Section 9(4). The Applicant has a time period of 12 months from May 1, 2016 to file the Complete Specification as per Section 9(1).*

It is seen from illustrations (a) and (b) that the Priority date of the patent application gets shifted to a later date by a maximum period of 6 months from the previous application date. It is from this date that the Complete Specification needs to be filed within a period of 12 months as is provided under Section 9(1).

The above explained provision of Section 17(1) will apply in all and/or any of the cases when the Applicant decides to request for post-dating during the period of 12 months within which the Complete Specification has to be filed even if the same request is made on the last day/date of filing such Specification.

#### Illustration:

(a) *'A' filed an application for grant for Patent along with the Complete Specification on January 1, 2016 and later realizes he wants to add/make amendments to the Specification. He will be able to request for conversion of the said Complete Specification to a Provisional Specification within 12 months, i.e. till January 1, 2017. The conversion is requested for and completed on December 1, 2016. Henceforth, he will be able to file the Complete Specification till December 31, 2016.*

*However, due to certain circumstances he is unable to file the said Complete Specification within time and hence requests for post-dating the application. The application gets post-dated from January 1, 2016 to May 1, 2016. The Applicant will have an extended period till May 1, 2017 to file the Complete Specification.*

(b) *'A' filed an application for grant for Patent along with the Provisional Specification on January 1, 2016. In May 2016 he files the Complete Specification and later realizes he wants to add/make amendments to the Specification. He will be able to request for conversion of the said Complete Specification to a Provisional Specification within 12 months, i.e. till January 1, 2017. The conversion is requested for and completed on December 1, 2016. Henceforth, he has two (2) Provisional Specifications for which he will have to file one (1) Complete Specification till December 31, 2016.*

*However, due to certain circumstances he is unable to file the said Complete Specification within time and hence requests for post-dating the application. The application gets post-dated from January 1, 2016 to May 1, 2016. The Applicant will have an extended period till May 1, 2017 to file the Complete Specification.*

In situations where a patent needs to be filed under Patent Cooperation Treaties (PCT) where the Applicant is unable to file the Complete Specification in the specified time-period of 12 months or where he wished to add to the specifications after the filing of Complete Specification and the time period of 12 months to make any of the aforesaid amendments has passed, the Applicant can make a request to the Controller to post date the patent application in a situation similar to that stated in the illustrations and explanations given in the preceding paragraphs of this article. However as stated earlier, due to the absence of the words 'Complete Specification' and/or 'Provisional Specification', Section 17(1) would be more relevant and would take importance over Section 9 when it comes to the post-dating of a patent application under PCT.

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