PATENT EXAMINATION MANUAL

2023

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Royal Government of Bhutan

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CHAPTER I: INTRODUCTION

The Patent Registry under the Department of Media, Creative Industry and Intellectual Property is responsible for the registration and protection of inventions in the country through grant of Patent. The registry was established in March 2012 by Executive order of the erstwhile Ministry of Economic Affairs that brought into force Part I of the Industrial Property Act of Kingdom of Bhutan, 2001 and Rules thereto. The registration system is administered by the Industrial Property Act of the Kingdom of Bhutan 2001, Industrial Property Rules 2001, and the Paris Convention for Protection of Industrial Property, 1883 to which Bhutan is a member since 2000.

The core function of the registry is to provide an efficient registration system for protection of inventions in Bhutan in line with the provisions of the Act and the Rule. The development of this manual is mainly intended to enhance the competencies of the examiners in various aspects of examination and to maintain uniformity in the application of the Act and the Rules to the examination procedure.

The manual explains the procedure for filing patent applications and its processing up to grant/refusal, maintenance etc. in the following chapters. The Registry expects that for all concerned, there will be a learning process through this manual.

CHAPTER 2: GENERAL INFORMATION

2.1. Contacts of the Office

Industrial Property Division
Department of Media, Creative Industry and Intellectual Property
Ministry of Industry, Commerce and Employment
Thimphu
P.O Box 140

2.2. Business hours

The Registry is open to the public from 9.00 am to 1.00pm and 2.00 pm to 5.00 pm each day from Monday to Friday. If the last day for filing a document falls on a Saturday, a Sunday or on a public holiday, the document may be filed on the next day following the Saturday, Sunday or the public holiday.

2.3. International conventions and treaties

Bhutan has been a member of the Paris Convention for the Protection of Industrial Property since 2000. The Convention contains provisions in regard to national treatment and right of priority which are domesticated in the Industrial Property Act 2001.

2.4. Fees

The Act and the Rules prescribe a "Schedule of Fees" which includes all the fees that are payable to the Office for various services. Fees must be paid in Ngultrum by both local applicants and foreign applicants. Payments made in other currencies will not be accepted. The fees should be paid to the Regional Office of Economic Affairs and the applicants must provide a fee receipt at the Patent Registry for processing the application.

Fees once paid in respect of any proceedings should not be refunded irrespective of whether the processing has taken place or not.

2.5. Filing of documents.

Patent applications and any other related documents should be submitted in person to the Patent Registry, IPD, DoMCIIP, MoICE with a letter addressed to the Registrar of Industrial Property. Once documents are properly received and stamped, they become part of the file kept by the Office and may not be returned unless they were submitted by error.

2.6. Industrial Property Journal

The Industrial Property Journal (the Journal), is a statutory publication of the Office for the purpose of advertising industrial property applications and for publishing other matters required to be published under the Act. The journal is published on the office website www.moice.gov.bt and www.ipbhutan.gov.bt

2.7. Representation before the Office

Section 35, Rule 8

Any natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in Bhutan must appoint a registered IP agent with DoMCIIP to act for them in all proceedings. If an application is made in these circumstances and an agent has not been appointed, the applicant will be requested in the formal examination report to do so.

A representative should be appointed through Form PT-14 for each application filed.

CHAPTER 3: FILING OF DOCUMENTS AND FILING DATE EXAMINATION

Section 11(1) (a)

Bhutan being a member of the Paris Convention for the Protection of Industrial Property since 2000 follows a **first-to-file** rule for filing of patent applications. Therefore, an application for a Patent should be filed at the earliest possible or before the invention is disclosed to the public.

3.1 Persons entitled to file an application

Section 7 (2) (b)

An application for the grant and registration of a patent may be filed by the inventor or any other person to whom s/he has transferred the right. It is presumed that a legal entity does not have the ability to invent or create but rather it is the natural persons working for the legal entity. It is on this basis that it is necessary when a legal entity is filing the application, the application must be accompanied by a Statement justifying the applicant's right to a patent.

3.2. Patent application and specification

A patent application is made on Form PT-1 which must be accompanied by specification comprising of Title of Invention, Description, Claims, Abstract and Drawings.

3.2.1. Request for Grant of Patent

Rule 10

a. The request for the grant of a patent should be made on Form No.PT-1 and shall be signed by each applicant.
b. The request shall indicate each applicant's name, address, nationality and residence.
c. Where the applicant is the inventor, the request should contain a statement to that effect, and where s/he is not, it shall indicate each inventor's name and address and be accompanied by the statement justifying the applicant's right to the patent.
d. If the applicant is represented by an agent, the request shall so indicate and state the agent's name and address.

3.2.2. Title of the Invention

Rule 10

The title of the invention shall be short (preferably from two to seven words) and precise.

3.2.3. Description

Rule 11

The description shall first state the title of the invention as appearing in the request and should

a. specify the technical field to which the invention relates;
b. indicate the background art which, as far as known to the applicant, can be regarded as useful for the understanding of the invention, and, preferably, cite the documents reflecting such art;
c. disclose the invention in such terms that it can be understood and state its advantageous effects, if any, with reference to the background art;
d. briefly describe the figures in the drawings, if any;
e. set forth at least one mode for carrying out the invention; this shall be done in terms of examples, where appropriate, and with reference to the drawings, if any;
f. indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is industrially applicable and the way in which it can be made and used, or, if it can only be used, the way in which it can be used.

The manner and order specified above shall be followed except when, because of the nature of the invention, a different manner or a different order would result in a better understanding and a more concise presentation.

3.2.4. Claims

Rule 12

a. The number of claims shall be reasonable considering the nature of the invention; if there are several claims, they shall be numbered consecutively in Arabic numerals.
b. The claims shall define the invention in terms of the technical features of the invention.
c. Whenever appropriate, claims shall contain:

(i) a statement indicating those technical features of the invention which are necessary for the definition of the latter but which, in combination, are part of the prior art;

(ii) a characterizing portion-- preceded by the words "characterized in that, "characterized by," "wherein the improvement comprises," or any other words to the same effect-- stating concisely the technical features which, in combination with the features stated under (i), it is desired to protect.

d. Claims shall not, except where absolutely necessary, rely in respect of the technical features of the invention on references to the description or drawings; in particular, they shall not rely on such references as "as described in part ...of the description, "or "as illustrated in figure...of the drawings."

e. Where the application contains drawings, the technical features mentioned in the claims shall preferably be followed by the reference signs relating to such features; when used, the reference signs shall preferably be placed between parentheses; if inclusion of reference signs does not particularly facilitate quicker understanding of a claim, it should not be made.

f. The deletion of any claim previously appearing in the application shall be made by indicating the number of the previous claim followed by the word "cancelled".

3.2.5. Drawings

Rule 13

1. Drawings forming part of an application for a patent shall be on sheets the usable surface area of which shall not exceed [26.2 cm by 17 cm]. The sheets shall not contain frames round the usable of used surface. The minimum margins shall be as follows: top - 2.5 cm left side - 2.5 cm right side - 1.5 cm Bottom - 1.0 cm

2. Drawings shall be executed as follows:

   a. Without coloring in durable, black sufficiently dense and dark, uniformly thick and well-defined lines and strokes to permit satisfactory reproduction;
   b. Cross-section shall be indicated by hatching which does not impede the clear reading of the reference signs and leading lines;
   c. The scale of the drawings and the distinctness of their graphical execution shall be such that a photographic reproduction with a linear reduction in size to two-thirds would enable all details to be distinguished without difficulty. If, as an exception, the scale is given on a drawing it shall be represented graphically;
   d. All numbers, letters and reference signs appearing in the drawings shall be simple and clear and brackets, circles and inverted commas shall not be used in association with numbers and letters;
   e. Elements of the same figure shall be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the figure;

f. The height of the numbers and letters shall not be less than [0.32 cm] and for the lettering of drawings, the Latin and, where customary, the Greek alphabets shall be used;
g. The same sheet of drawings may contain several figures. Where figures drawn on two or more sheets are intended to form one whole figure, the figures on the several sheets shall be so arranged that the whole figure can be assembled without concealing any part of the partial figures. The different figures shall be arranged without wasting space, clearly separated from one another. The different figures shall be numbered consecutively in Arabic numerals, independently of the numbering of the sheets;
h. Reference signs not mentioned in the description or claims shall not appear in the drawings, or vice versa. The same features, when denoted by reference signs, shall, throughout the application, be denoted by the same signs;
i. the drawings shall not contain textual matter, except, when required for the understanding of the drawings, a single word or words such as "water" "stream", "open", "closed", "section on AA" and in the case of electric circuits and block schematic or flow sheet diagrams, a few short catchwords;
j. The sheets of the drawings shall be numbered in accordance with Rule 16 (7).

3. Flow sheets and diagrams are considered drawings.

3.2.6. Abstract

Rule 14

1. The abstract shall be so drafted that it can efficiently serve as a scanning tool for purposes of searching in the particular art.
2. The abstract shall consist of the following:

    a) a summary of the disclosure as contained in the description, the claims, and any drawings, indicating the technical field to which the invention pertains and drafted in a way which allows the clear understanding of the technical problem through the invention and the principal use or uses of the invention; and
    b) where applicable, the chemical formula which, among all the formulae contained in the application, best characterizes the invention.
3. The abstract shall be as concise as the disclosure permits (preferably 50 to 150 words).
4. The abstract shall not contain statements on the alleged merits or value of the invention or on its speculative application.
5. Each main technical feature mentioned in the abstract and illustrated by a drawing in the application shall be followed by a reference sign, placed between parentheses.
6. The abstract shall be accompanied by the most illustrative of any drawings furnished by the applicant.

3.2.7. Measures, Terminology and Signs

Rule 15

1. Units of weights and measures shall be expressed in terms of the metric system.
2. Temperatures shall be expressed in degrees centigrade (Celsius).

3. Density shall be expressed in metric units.
4. For indications of heat, energy light, sound, and magnetism, as well as for mathematical formulae and electrical units, rules in general use shall be observed; for chemical formulae, the symbols, atomic weights, and modular formulae, in general use, shall be employed.
5. In general, only such technical terms, signs and symbols should be used as are generally accepted in the art.
6. The terminology and the signs shall be consistent throughout the application.

3.2.8. Number of Copies and Physical Requirements

Rule 16

1. The application and any accompanying statements or documents shall be filed in two copies, but the Registrar may require the applicant to supply additional copies.
2. All elements of the application shall be so presented as to admit of direct reproduction by photography, electrostatic processes, photo offset and microfilming.
3. Only one side of each sheet contained in the application shall be used.
4. All elements of the application shall be on paper which is flexible, strong, white, smooth, non-shiny and durable.
5. The size of the sheets shall be [A4(29.7cm x 21cm)], although the Registrar may accept sheets of other sizes.
6. The minimum margins of sheets shall be as follows:
   (i) upper margin of each page, except the first page: 20 mm
   (ii) upper margin of the first page: 30 mm
   (iii) side margin adjacent to the binding: 25 mm
   (iv) other side margin: 20 mm
   (v) bottom margin: 20 mm

7. All sheets shall be numbered at the top of the sheet, in the middle, in consecutive Arabic numerals.
8. In effecting the sequential numbering of the sheets, the elements of the application shall be placed in the following order:

   the request,
   the description,
   the claims,
   the abstract, and
   the drawings.

9. The sequential numbering of the sheets, shall be effected by using three separate series of numbering, the first series applying to the request only and commencing with the first sheet of the request, the second series commencing with the first sheet of the description and continuing through the claims until the last sheet of the abstract, and the third series being applicable to the sheets of the drawings only and commencing with the first sheet of the drawings.
10. The text matter of the application shall be typed; graphic symbols, chemical or mathematical formulae and certain characters if necessary, may be handwritten or drawn.

11. Drawings shall be executed in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes without coloring.

3.2.9. Unity of Invention

Section 8 (1), Rule 17

1) The claims should be confined to one or single inventive concept, however, following should be allowed:

    a. in addition to an independent claim for a given product, the inclusion in the same application of an independent claim for a process specially adapted for the manufacture of the said product and the inclusion in the same application of an independent claim for a use of the said product; or
    b. in addition to an independent claim for a given product, the inclusion in the same application of an independent claim for a process specially adapted for the manufacture of the product, and the inclusion in the same application of an independent claim for an apparatus or means specifically designed for carrying out the said process;
    c. in addition to an independent claim for a given product, the inclusion in the same application of an independent claim for an apparatus or means specifically designed for carrying out the said process; or

2) It should be permitted to include in the same application two or more independent claims of the same category which cannot readily be covered by a single generic claim.
3) It should be permitted to include in the same application a reasonable number of dependent claims, claiming specific forms of the invention claimed in an independent claim.

3.2.10. Division of Application

Section 8 (3), Rule 18

1) A divisional application shall contain a reference to the initial application.
2) If the applicant wishes a divisional application to benefit from any priority claimed for the initial application, the divisional application must contain a request to that effect; in such a case, the declaration of priority and the documents furnished for the initial application shall be deemed to relate also to the divisional application.
3) Where the priorities of two or more earlier applications were claimed for the initial application, a divisional application may benefit only from the priority or priorities that are applicable to it.

3.2.11. Disclosures to be Disregarded for Prior Art Purposes

Section 5 (2) (c), Rule 19

An applicant who wishes a disclosure of the invention to be disregarded, for prior art purposes, should indicate on the application and furnish in writing, with the application or within one month of filing the application, full particulars of the disclosure; where the disclosure was made at an exhibition, the applicant should file, within the same period, a duly authenticated certificate issued by the authority responsible for the exhibition containing particulars of the exhibition and stating that the invention was in fact exhibited there.

3.2.12. Declaration of Priority and Translation of Earlier Application

Rule 20

1. The declaration of priority should indicate:
   a) the date of the earlier application;
   b) the number of the earlier application;
   c) the symbol of the International Patent Classification, if any, which has been allocated to the earlier application;
   d) the State in which the earlier application was filed or, where the earlier application is a regional or an international application, the State or States for which it was filed.
   e) where the earlier application is a regional or international application, the Office with which it was filed.

2. Where at the time of filing the declaration the number of the earlier application is not known, that number shall be furnished within three months from the date on which the application containing the declaration was filed.
3. Where a symbol of the International Patent Classification has not been allocated to the earlier application, or had not yet been allocated at the time of filing the declaration, the applicant shall state this fact in the said declaration and shall communicate such symbol as soon as it has been allocated.
4. The applicant may, at any time before the grant of the patent, amend the contents of the declaration.
5. The period for furnishing the certified copy of the priority application, shall be three months from the date of the request by the Registrar; where a copy has already been furnished for another application, the applicant may respond by making a reference to that other application.
6. Where the earlier application is in a language other than English, the applicant shall within six months from the aforementioned request furnish a translation in English of the earlier application.
7. Unless the Registrar requests otherwise, the earlier application and any translation thereof shall be filed in one copy.

3.3 Reception of documents

Rule 23

All patents applications as well as other Patent Forms are received by the Patent Registry using the Industrial Property Automation System (IPAS) following the steps prescribed in *Annexure I*. Upon receiving the application, the system generates application number which is “BT”, “P”

followed by the year and serial number, for eg. BT-P-2023-1 and fee payment authorization based on the amount to be paid which is then issued to the applicant. Once the applicant has paid the fees, a copy of fees receipt is submitted to the office and the receipt number is captured in the system followed by generation of an acknowledgement of receipt. The application number allotted should be quoted in all subsequent communication concerning the application.

After receiving of the documents is completed, application and forms/user documents are scanned and data in the application and user documents are captured in the IPAS system following the steps in *Annexure II*. A physical file is also opened and numbered as per the file number generated by the system.

Copies of all correspondence issued by the office should be included in the file, filed in chronological order in which the correspondence is sent to the applicant.

3.4 Filing date Examination

Section 11 (a), Rule 24

The first task for the examiner is to determine whether the application meets the requirements for assigning a filing date. The Examiner should check whether the name of the applicant, description, claims and drawings, where necessary are submitted and the applicable fees are paid.

The aforementioned documents referred to above should be in English but do not have to meet any particular requirements as to form or presentation. It is essential however to be sufficiently legible to enable the information to be discerned. The applicant should be sufficiently identified whenever it is possible to establish the identity of the applicant beyond reasonable doubt on the basis of all data contained in the documents filed. Where there is more than one applicant, each applicant must be similarly identified. No objection should be raised at this stage with regard to the status of the applicant or his entitlement to apply. The contents of the description and claims do not require close scrutiny. It will be sufficient to identify a document which appears to include description and one or more claims.

When the applicant meets all of the above requirements, the application is processed and notification **PT-B** on accord of filing date is issued.

If the application does not fulfil these requirements, the examiner is required to invite the applicant vide PT-B, to submit the required correction within **14 days** from the date of the notification. The invitation should indicate that the applicant has 60 days or two months to comply. If the applicant does not comply with the invitation and, as a result, the examiner treats the application as if it had not been filed, the examiner should, within 14 days, inform the applicant vide **PT-D** that the application is deemed as not filed.

Where an application meets the aforementioned requirements, the receiving date becomes the filing date and the same must be so communicated to the applicant vide **PT- B**.

CHAPTER 4: FORMALITIES EXAMINATION OF PATENT APPLICATIONS

Section 7 (1), (2), (34) and Rules 5, 6, 7, 8, 15 and 16

Introduction

Before the application is accepted to proceed for search and substantive examination, the examiner will carry out formality examination to determine whether the application complies with the provisions of the Act and the Rules as detailed below. The purpose of formality examination is to ascertain conformity of the application to the physical requirements and for the comprehension of the subject matter of the application.

The examiner should examine the following in addition to the contents of Form PT-1 and the specification requirements specified in Chapter 2 above.

4.1. Language of Documents and Translations

Rule 5

Applications shall be filed in English language, and any document forming part of an application or submitted to the Registrar in a language other than English shall be accompanied by a translation into English.

4.2. Indication of Name, Address, Nationality and Residence

Rule 6

a) Names of natural persons shall be indicated by the person's family name and given name(s), the family name being indicated before the given name(s); the names of legal entities shall be indicated by their full, official designations.
b) Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, shall consist of all the relevant administrative units, including the house number, if any; addresses shall also indicate telegraphic and telex addresses.
c) Nationality shall be indicated by the name of the State of which a person is a national; legal entities shall indicate the name of the State under whose laws they are constituted and their Registered Office.
d) Residence shall be indicated by the name of the State of which a person is a resident.

4.3. Signature by Partnerships, Companies and Associations

Rule 7

a) A document purporting to be signed for or on behalf of a partnership should contain the names of all the partners in full and shall be signed by all the partners or by any partner qualified to sign, stating that s/he signs on behalf of the partnership, or by any other person who satisfies the Registrar that s/he is authorized to sign the document; a document purporting to be signed for or on behalf of a body corporate shall be signed by a director or by the secretary or other principal officer of the body corporate or by any other person who satisfies the Registrar that s/he is authorized to sign the document and shall bear the seal of the body corporate; a document purporting to be signed for or on behalf of an association of persons may be signed by any person who satisfies the Registrar that he is duly authorized.

b) The Registrar may, whenever it is deemed necessary, request evidence of authorization to sign.

4.4. Representation by Agent

Section 35 and Rule 53

The Power of Attorney appointing an agent may be filed together with the application or within two months from its filing date; if the appointment is not thus made, any procedural steps taken by the agent, other than the filing of the application, shall be deemed not to have been taken.

4.7. Declaration of Priority

Section 9, Rule 20

In case of application where priority is claimed, the following should be checked:

a) the application was filed within the prescribed timeline?
b) the priority document was filed at the time of filing? If not, whether the priority document was filed within the extendable period of three months from date of filing application.

4.8. Matters excluded from patentability

Section 4 (3)

The application shall not belong to the following categories of invention which are excluded from patentability.

(i) a discoveries, scientific theories and mathematical methods;

The fact that a known material has an unknown property is a discovery and as such is not itself patentable, but an application or use of that material may be patentable eg. in a particular process. Similarly, finding a new substance or micro-organism occurring in nature is a discovery, but the process of isolating and extracting it, and the material so obtained, could be patentable.

(ii) schemes, rules or methods for doing business, performing purely mental acts or playing games;

- although rules for games cannot be patented (again they are covered by copyright), apparatus for playing a particular game (eg. comprising board, pieces and rules) may be patentable.
- methods of doing business is an exclusion of importance. Methods of book keeping, trading stocks and shares etc. are generally not patentable.

(iii) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practiced on the human or animal body; and

Probably the most important exclusions, as indicated above, are business methods and methods of medically treating humans and animals.

However, the equipment for use in medicine and surgery (eg scalpels, operating tables) is patentable.

(iv) Inventions, the commercial exploitation of which would be contrary to public order or morality.

Inventions whose commercial exploitation would be contrary to public order or morality, or prejudicial to humans, animals or plant life or health, or to the environment are excluded from patentability. What is excluded here will probably be decided by government policy, for instance, land mines, mantraps and letter bombs might be excluded here, or methods for cloning human beings.

4.9. Inventions relating to biological resources or Traditional Knowledge associated to biological resources.

If an application relates to biological resources or Traditional Knowledge associated to biological resources, it should be accompanied with the permission of use from the competent authority, the National Biodiversity Center, Ministry of Agriculture and Livestock. The supporting documents such as the Prior Informed Consent (PIC) and Access and Benefit Sharing Agreement (ABS) shall be submitted by the applicant.

4.10. Information concerning corresponding foreign applications for patents.

Section 10, Rule 21

The applicant at the request of the Registrar, should submit the following details of any application filed abroad which is the same or essentially the same invention as that claimed in the application filed with the registry within two to six months. Such documents may be used only for facilitating the evaluation of the novelty and inventive step, i.e. such documents do not themselves provide the applicant with any rights in Bhutan and the applicant too may be invited to comment on any of the documents s/he has furnished.

a) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;
b) a copy of the patent granted on the basis of the foreign application;
c) a copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application; and
d) a copy of any final decision invalidating the patent granted on the basis of the foreign application.

A formal examination report must be issued on **PT-E** stating the findings of the assessment conducted on the above areas. If there are deficiencies in the application, the applicant should be notified to correct the deficiencies within two months or 60 days from the date of the formal examination report. If the applicant fails to comply with this invitation, the application should be rejected vide **PT-F** within 14 days of expiry of two months.

An application will proceed to the next stage for substantive examination only after remedying the deficiencies in compliance with the notification.

CHAPTER 5: SUBSTANTIVE EXAMINATION

Introduction

The purpose of examination is to ensure that the application meets the requirements set out in Sections 4(2) and (3), 5, 7(4), (5) and (6) and 8, and the Rules. The prime task of the Examiner at this stage is to deal with the substantive requirements of the Act and the Rules for the grant of a Patent.

Separate procedures are followed for the substantive examination of applications which are locally filed and those filed by international applicants claiming priority of an earlier filed application in one of the members of the Paris Convention for the Protection of Industrial Property.

5.1. General Procedure for Substantive Search and Examination

During substantive examination main areas of focus for the examiner is to determine whether the invention fulfills novelty, inventive step, and industrial applicability, and if it is against the public order and morality.

5.1.1. Novelty

Section 5 (2)

An invention is considered as new if it is not anticipated by prior publication in patent and non-patent literature, prior use or prior public knowledge. An invention is new (novel) if it has not been disclosed in the prior art, where the prior art means everything that has been published, presented or otherwise disclosed to the public before the date of filing of complete specification.

For the purpose of determining novelty, an application for patent filed at the Patent Registry before the date of filing of complete specification of a later filed application, but published after the same, is considered for the purposes of prior claiming.

While ascertaining novelty, the Examiner takes into consideration, inter alia, the following documents:

- which have been published before the date of filing of the application in any of the specifications filed in pursuance of application for patent in Bhutan on or after 01 March, 2012.
- such Patent Applications which have been filed before the date of filing of complete specification and published on or after the date of filing of the complete specification, but claims the same subject matter.

A prior art is considered as anticipating novelty if all the features of the invention under examination are present in the cited prior art document. The prior art should disclose the invention

either in explicit or implicit manner. Mosaicking of prior art documents is not allowed in the rejection of novelty.

A generic disclosure in the prior art may not necessarily take away the novelty of a specific disclosure. For instance, a metal spring may not take away the novelty of a copper spring.
A specific disclosure in the prior art takes away the novelty of a generic disclosure. For instance, a copper spring takes away the novelty of a metal spring.

In a case where a prior art is cited as an anticipation in the Examination Report, the onus of proving that the same is deemed not to be an anticipation is on the applicant.

5.1.1.2. Search for anticipation by previous publication and prior claiming

The examiner conducts a search in all the available databases including patent /non-patent literature. In addition, PCT Minimum documentation is searched. The search is conducted to find out any publication which may anticipate the claimed subject matter. Another objective of the search is to ascertain whether an invention as claimed in any of the claims of the complete specification has been claimed in any claim of any other complete specification, filed in Bhutan, which has been published on or after the date of filing of the applicant's complete specification.

The search is conducted with respect to the date of filing of complete specification. The examiner ascertains the following:

a) International Patent classification.
b) Search strategy.
c) Keyword(s) used.
d) Databases consulted for both Patent and non-Patent literature.
e) Prior art findings and analysis regarding the patentability.
f) Limitation on search if any, such as non-clarity of claims or multiplicity of inventions or any other reason due to which a reasonable search cannot be conducted.

5.1.2. Inventive step

Section 5 (3)

Inventive step is a feature of an invention that involves technical advance compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art. While determining patentability of the invention, an Examiner first conducts investigation as to whether the novelty of the claimed invention is established and then proceeds to conduct examination on whether the claimed invention involves the inventive step.

5.1.2.1. Determination of inventive step

For determination of inventive step, the prior art as a whole, revealed during the search process, is relied upon to assess if such prior art(s) disclose(s) the claimed invention. Invention as a whole shall be considered. In other words, it is not sufficient to draw the conclusion that a claimed invention is obvious merely because individual parts of the claims taken separately are known or might be found to be obvious.

If an invention lies merely in verifying the previous predictions, without substantially adding anything for technical advancement or economic significance in the art, the inventive step is lacking.

For the purpose of establishing obviousness of the invention, citing a mosaic of prior arts is permissible.

If the invention is predictable based on the available prior art, merely requiring workshop improvement by a person skilled in the art, the inventive step is lacking.

Hon'ble Supreme Court of India on inventive step:

In Biswanath Prasad Radhey Shyam vs Hindustan Metal Industries Ltd it was held that "The expression "does not involve any inventive step" used in Section 26(1) (a) of the Act and its equivalent word "obvious", have acquired special significance in the terminology of Patent Law. The 'obviousness' has to be strictly and objectively judged.

For this determination several forms of the question have been suggested. The one suggested by Salmond L. J. in Rado v. John Tye & Son Ltd. is apposite. It is: "Whether the alleged discovery lies so much out of the Track of what was known before as not naturally to suggest itself to a person thinking on the subject, it must not be the obvious or natural suggestion of what was previously known."

"Another test of whether a document is a publication which would negative existence of novelty or an "inventive step" is suggested, as under: "Had the document been placed in the hands of a competent craftsman (or engineer as distinguished from a mere artisan), endowed with the common general knowledge at the 'priority date', who was faced with the problem solved by the patentee but without knowledge of the patented invention, would he have said, "this gives me what I want?" (Encyclopaedia Britannica; ibid).

To put it in another form: "Was it for practical purposes obvious to a skilled worker, in the field concerned, in the state of knowledge existing at the date of the patent to be found in the literature then available to him, that he would or should make the invention the subject of the claim concerned?"

In the F.Hoffman la Roche v Cipla case the Hon"ble Delhi High Court had observed that the obviousness test is what is laid down in Biswanath Prasad Radhey Shyam vs Hindustan Metal Industries Ltd (AIR 1982 SC 1444) and that "Such observations made in the foreign judgments

are not the guiding factors in the true sense of the term as to what qualities that person skilled in the art should possess. The reading of the said qualities would mean qualifying the said statement and the test laid down by the Supreme Court." Hon"ble High Court further added "From the bare reading of the afore quoted observations of Supreme Court, it is manifest that the Hon'ble Supreme Court has laid down the test for the purposes of ascertaining as to what constitutes an inventive step which is to be seen from the standpoint of technological advancement as well as obviousness to a person who is skilled in the art. It is to be emphasized that what is required to be seen is that the invention should not be obvious to the person skilled in art. These are exactly the wordings of New Patents Act, 2005 u/s Section 2(ja) as seen above. Therefore, the same cannot be read to mean that there has to exist other qualities in the said person like unimaginary nature of the person or any other kind of person having distinct qualities…….. Normal and grammatical meaning of the said person who is skilled in art would presuppose that the said person would have the knowledge and the skill in the said field of art and will not be unknown to a particular field of art and it is from that angle one has to see that if the said document which is prior patent if placed in the hands of the said person skilled in art whether he will be able to work upon the same in the workshop and achieve the desired result leading to patent which is under challenge. If the answer comes in affirmative, then certainly the said invention under challenge is anticipated by the prior art or in other words, obvious to the person skilled in art as a mere workshop result and otherwise it is not. The said view propounded by Hon'ble Supreme Court in Biswanath Prasad (supra) holds the field till date and has been followed from time to time by this Court till recently without any variance.

Therefore, it is proper and legally warranted to apply the same very test for testing the patent; be it any kind of patent. It would be improper to import any further doctrinal approach by making the test modified or qualified what has been laid down by the Hon'ble Supreme Court in of Biswanath Prasad (supra)." The "obviousness" must be strictly and objectively judged. While determining inventive step, it is important to look at the invention as a whole. It must be ensured that inventive step must be a feature which is not an excluded subject itself. Otherwise, the patentee by citing economic significance or technical advance in relation to any of the excluded subjects can insist upon grant of patent thereto. Therefore, this technical advance comparison should be done with the subject matter of invention and it should be found it is not related to any of the excluded subjects.

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

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

5.1.3. Industrial Applicability

Section 5 (4)

In order for an invention to be patentable, an invention must be capable of industrial application. An invention should be considered industrially applicable if it can be made or used in any kind of industry, including handicraft, agriculture, fisheries and services.

"Industry" should be understood in its broad sense as including any physical activity of "technical character", that is an activity which belongs to the useful or practical arts as distinct from the aesthetic arts; it does not necessarily imply the use of a machine or the manufacture of an article and could cover e.g. a process for dispersing fog or for converting energy from one form to another.

The Examiner shall assess if the claimed invention is capable of use in any industry or made using an industrial process. Typically, the specification explains the industrial applicability of the disclosed invention in a self-evident manner. Usually industrial applicability is self-evident. If it is not, a mere suggestion that the matter would be industrially applicable is not sufficient. A specific utility should be indicated in the specification supported by the disclosure. For example, indicating that a compound may be useful in treating unspecified disorders, or that the compound has useful biological properties, would not be sufficient to define a specific utility for the compound. The specific usefulness has to be indicated.

5.1.4. Sufficiency of Disclosure

Sufficiency of disclosure is yet another aspect, which is checked by the Examiner while examining a patent application. The Examiner will look for whether:

a) the specification is properly titled.

b) the subject matter is fully and particularly described in the specification.

c) the claims define the scope of the invention properly.

d) the Specification describes the best method of performing the invention or not.

5.1.5. Unity of Invention

Section 8, Rule 17

1) The Claims of a Specification shall relate to a single inventive concept. In case, an application comprises a plurality of inventive concepts, the examiner refers to the same in the report. The application may be divided in order to meet the objection of plurality of distinct inventions.
2) The determination whether a group of inventions is so linked as to form a single inventive concept shall be made without regard to whether the inventions are claimed as separate claims or as alternatives within a single claim.

3) Unity of invention between process and apparatus or means requires that the apparatus or means have been specifically designed for carrying out the process, or at least a step of the process.
4) Independent claims of different categories may relate to a single inventive concept.

For example:

a) Claims for a product and process specially adapted for manufacture of the product.
b) Claims for a process and apparatus or means specifically designed for carrying out the process.
c) A mould for casting an article, a method of making that mould, a process of casting the article by using the said mould will constitute a single invention.
d) A locking system containing plug and socket wherein separate independent claims for a plug and socket may constitute a single inventive concept.
e) A broadcasting system comprising transmitter and receiver.
f) If an invention relates to a new type of spray bottle, claims may be directed to the spray bottle itself (a product) and a method of making the spray bottle (a process).
g) In case of a genetically modified Gene Sequence/Amino Acid Sequence claims may be directed to a Gene sequence/ Amino Acid sequence, a method of expressing the sequence, an antibody against that protein/sequence, a kit containing such antibody/ sequence.
h) In case of a drug or pharmaceutical product, claims may be directed to a drug or pharmaceutical product, a process of making the product, a composition containing the drug.

5.2. Examination of applications filed by local applicants and without a PCT family/Priority.

Upon successful formal examination, applications which are filed by local applicants are requested to fill in Form PT-3A which is a request for substantive examination. The form along with the application is transmitted to World Intellectual Property Organization for substantive search and examination.

The Substantive Examination is conducted by one of the Patent Office designated by WIPO as the International Searching and Examining Authority (ISEA). The Examination report received from WIPO is reviewed in the Patent Technical Committee for compliance with requirements of Section 4(3) and 5 (5). Accordingly, an Examination report is issued to the applicant on PT-H stating the observations and objections, if any. If the examination is successful, the application proceeds to grant stage, and if it does not meet the requirements, applicant will be notified of refusal.

If there are amendments required, the applicant is invited to submit the amendments/corrections within six months from the date of the notification.

5.3. Examination of applications filed by international applicants with a PCT family/Priority.

Foreign applications are usually filed through the Paris Convention route claiming priority of an earlier filed application. Very often there is also an international application in the patent family, in particular for commercially interesting technologies, where applicants seek protection in many jurisdictions using the PCT system.

Therefore, examination of such applications involves retrieving and utilizing examination work products for members of the patent family prepared in other jurisdictions which is known as work sharing.

Utilizing examination work products from members of the patent family (work-sharing) comprises the following steps:

a) identifying the relevant patent family, in particular the PCT family;
b) researching examination status of family members;
c) retrieval of work products of family members of interest;
d) comparison of work products and claim sets on which examination was based to assess utility of work products;
e) selection of suitable and relevant work products, compatible with national legislation.

5.3.1. Understanding and researching Patent family relations

Knowing the patent family (or the families) is the rock bottom for work-sharing because the family tells in which jurisdictions examiners may, or may have to, examine similar applications. This may, for example, facilitate regional or sub-regional cooperation on examination. Unfortunately, many offices still don't systematically share bibliographic data or PCT national phase entry data with database hosts for family building.

Work-sharing in the PCT national phase would usually focus on using examination work products from members of the PCT patent family. However, approximately 10% of the PCT applications are also members of larger (extended) families which include several PCT families. Work-products from family members outside the proper PCT family may be of limited use; it may therefore be important to understand family relations and how databases present family information to select suitable family members from the proper PCT family.

5.3.2. Sources for family information

Compiling comprehensive patent family information for a given application still requires researching a variety of databases as no single database includes information on all family members. Furthermore, some databases do not distinguish between different types of patent families and present only one type of family. Here is a table of sources which include at least one family table for each application recorded in the database.

Sources of patent family information

Source	Family types viewable	Public
Espacenet (classic or new)	Extended/INPADOC Simple Domestic	Yes
EP Register	Extended/INPADOC Simple Domestic EP validations	Yes

Sources of patent family information

Source	Family types viewable	Public
Common Citation Document (CCD)	Extended/INPADOC Simple Domestic	Yes
USPTO Global Dossier	Extended/INPADOC Domestic	Yes
WIPO PATENTSCOPE - PCT national phase entries	PCT	Yes
WIPO PATENTSCOPE - family build	'Simple'	Yes
WIPO CASE	Complex [Domestic]	No
Commercial patent information databases	Extended/INPADOC Proprietary Domestic	No
India (not a database but a resource publicly accessible via inPASS of IP INDIA)	PCT or Simple	Yes

5.3.2.1. Why can family information change with time?

Databases may only show information for applications for which information has been recorded in the database. Aggregating (secondary) databases depend on information they receive from the primary (authoritative) sources. They build patent families either through comparing priority data or PCT application numbers.

As such, additional family members are added to an existing family when offices share bibliographic data of newly published publications, or when they commence at all with sharing such data.

Furthermore, database hosts sometimes retrieve and exploit information published on register websites or in Gazettes when offices do not share such data. When such data are included in the database, family members may be added to an existing family.

Another reason why family members are sometimes added or removed at a later stage is that some database hosts manually curate automatically built families. For example, the EPO INPADOC family is based on the concept of the extended family but is manually curated, for example if data errors are detected, or if an application is technically linked to an existing family (technical family) but does not share priorities.

5.3.2.2. Why is there not yet a single comprehensive source of family information?

This is linked to the question why family information provided by different databases still differs. One explanation is that aggregating databases draw on different sources, and that primary sources don't always share their data with any aggregating database provider; for example, as of August 2020, Indian applications are only included in WIPO databases.

Furthermore, some primary sources may not authorize the recipients of their data to share them further. Even though family data are owned by those that build them, sharing such data may be of limited use if the bibliographic data associated with a family member may not be shared.

Furthermore, providers of aggregating databases apply at least partly proprietary family building processes, for example such including manual curation. Family building requires as well data

cleaning and therefore is a rather complex process. Other database providers may not be given permission to use such data, may not wish to pay for it or may not trust the data.
The said complexity of family building of course also impacts the use of foreign family data, in particular, the aligning one's one data with those of others. Limited resources for such alignment may be another reason for not integrating foreign family data.
Finally, one may speculate if some database providers rather follow a competitive approach than a collaborative one.
Most likely, the best intermediary solution would be if all providers of aggregating databases had access to the same raw data on which they could apply their own family building process. Users of family information could then use the source where they would trust most the family building process or where they would find the best user interface and variety of viewing options.

5.3.2. Examination Status and Prosecution History

Prosecution history is the sequence of office and applicant actions, while examination status usually derives from the last office or applicant action in this sequence, or the lack of such action.
For an examiner still having to examine an application (for example, when treating backlog), it may be quite instructive to know and compare examination status of family members:
For example, if one finds that family members have been rejected or been withdrawn in some jurisdiction(s); this may be an indicator that important prior art has been identified in these jurisdictions.
Several withdrawals in other jurisdictions may be an indicator that the applicant is not really interested anymore in continuing an application and that the applicant may not even respond to an office action. In such case, the examiner should confirm the applicant's interest to continue prosecution prior to embarking on a search.
If several grants have already been published in other jurisdictions, then most likely a grant is also likely; however, one would still need to see if the scope of protection of the various grants is largely equivalent or if there are substantial differences.
An analysis of prosecution histories may reveal, for example, by when another work product may become available, or whether it is worth to await perhaps a final decision in a given jurisdiction where examination is still pending because important aspects of patentability are still under discussion.

5.3.3. Understanding and researching examination status

The type of legal status which are relevant for work-sharing and their implications for work-sharing objectives are explained below.

5.3.3.1. Terminology

The terminology used to address status is not harmonized. Some jurisdictions may use the same terms to address a certain status while other jurisdictions may use different terms to address similar or equivalent status (for example, 'refused' or 'rejected'). The terminology is usually defined by the applicable patent law or regulations which determine the conditions for a given legal status and the implications of a legal status.
It should therefore be noted that jurisdictions may use the same terminology for a status (or translations thereof) although the conditions for and/or implications of that status, as defined by the respective legislation of each jurisdiction, may differ. On the other hand, terminology may differ while the same conditions and/or implications apply.

5.3.3.2. Finality of status

It should also be noted that the finality of a status may also differ because some legislations may provide for 'reinstatement' or similar instruments while others don't. An applicant may then request - based on proper justification or payment of fees - the status to be reversed to the status before the event which changed the status; for example, if the deadline for a required action - like the payment of a maintenance fee, or the response to an office action - was missed inadvertently and/or due to reasons for which the applicant or the representative are not responsible.

Application status: Pending

After an application has been validly filed, that is, after all the basic requirements for allocating a filing date were met, its status is considered to be pending. In all jurisdictions, pending applications are subject to formality examination provided that all applicable fees have been paid.

Depending on the applicable legislation, an application may be pending either as

- Pending without request for substantive examination: in some jurisdictions, the applicant is expected to request substantive examination (and pay a separate examination fee) within a prescribed time after the filing date. Examination is therefore effectively deferred. If no such action is taken within the prescribed time, the application is then deemed to be abandoned/withdrawn/etc.
- Pending with request for substantive examination: the application will then be subject to substantive examination, i.e. a search for prior art and an assessment of the patentability of the claimed invention. Often but not always substantive examination is conducted only after formality examination has been completed. In some jurisdictions, the application may be pending for examination with an additional request for accelerated examination, for example, if agreements related to the Patent Prosecution Highway (PPH) are in place, or if the applicant argues that it is important for commercializing the invention.

Application status: Published

For work-sharing, the important implications of this status is that only published applications will be visible as members of a patent family, and that the respective dossiers or file wrappers become publicly accessible (some jurisdictions use the term 'laid open for public inspection' to indicate a similar status).

Application status: Withdrawn or deemed to be withdrawn

This status implies that an application will not be processed further. For some jurisdictions it is however possible, under certain conditions to reinstate an application that is deemed to be withdrawn.

For work-sharing, many family members with such status may be an indication that the applicant has lost interest in the grant of a patent. In such case, if a family member is still to be examined in another national phase, it may be recommended to assure the continued interest of the applicant prior to embarking on resource consuming activities like a prior art search.

Application status: (finally) Rejected

A rejection usually terminates the substantive examination procedures. An application is rejected if the applicant had been given the right to be heard at least once; that is, an opportunity to respond to the explanation of the examiner why the claimed invention is not patentable. This also includes the opportunity to amend the claims found unpatentable. There may even be a series of such opportunities for the applicant to amend claims. When the examiner finds that the matter has been sufficiently discussed, the application is rejected.

An applicant may file an appeal against the rejection decision for an appeal board to review the refection decision. At the USPTO an applicant may file a request for continuation of examination

in which case and upon payment of a fee the examination may continue with a further set of amendments. This may be repeated several times with fees increasing for each new request for continuation.

Application status: Intention to grant

If an examiner or registrar etc. finds claimed subject matter patentable, a notification of an intention of grant is issued which invites further actions by the applicant such as the payment of fees etc. in order to meet all requirements for the publication of the grant.

For work-sharing, such a communication is similarly useful like the actual publication of a grant because the claim set that was found patentable is already known. It is usually the last set of (amended) claims that have been filed before to this communication was issued by the office.

Patent status: Granted

A patent is usually considered as granted when the publication of the grant has taken place to inform the public of the protection being in force. In some jurisdictions, only granted applications are published and that therefore intermediary examination work products may only become available after the grant.

Patent status: Opposition procedure pending or completed

The opportunity for third parties to oppose a patent grant is an important component of patent prosecution because an examiner, despite all due care, may not find relevant prior art because it is not part of the documentation to be searched, or may not be aware of other reasons why a grant should be invalid. An opposition may usually be filed during a certain time period after the publication of the grant by any third party. The importance of oppositions for work-sharing lies in the fact that they are frequently filed by competitors which know the technology very well and therefore may cite peculiar prior art which was not discovered by the examiner; for example disclosures made at exhibitions, fairs or conferences.

The outcome of an opposition may be:

- the patent is maintained as is
- the patent is maintained with amended claims restricting the scope of protection
- the patent is complete revoked

It should be noted that some jurisdictions, for example India, also know a pre-grant opposition where third parties may already oppose an application for certain reasons. For example, if the invention was misappropriated by the applicant. Such pre-grant opposition is usually settled before substantive examination commences.

Application or patent status: Appeal pending or completed

While an opposition is a procedural instrument for third parties which are not party to the examination procedures, the appeal is an instrument for a party being party to a procedure to request the review of a previous final decision taken in the course of this procedure, for example the rejection of an application or of an opposition by the subsequent instance foreseen by the legislation therefor.

Patent status: Invalidation procedure pending or completed

Same considerations regarding prior art or possible outcomes apply like for opposition procedures. The difference is that invalidation may be requested anytime during the life cycle of patent; however, in some jurisdictions it may only be requested by parties which can demonstrate a valid interest in the invalidation, for example because of an impending litigation.

It should be noted that patent owners may also voluntarily restrict their patent by filing a respective request with the patent office.

5.3.4. Researching status - information sources

Patent Registers

The patent register of a national or regional jurisdiction represents the authoritative source for patent information of that jurisdiction. The patent law of each jurisdiction includes provisions for the authority in charge of patent prosecution (patent office) to publish respective information, including status, about new patent applications having been validly filed or patents having been granted. Many jurisdictions have implemented such publication by electronic means. The register is then usually a database that can be publicly accessed via the internet.

Dossiers

To some extent, an approximate status can be inferred from the latest communications in the dossier if the status is based on actions taken which involve the exchange of communications between office and applicant. This option of deriving status is important because many work-sharing platforms (family tables) providing access to dossiers do not provide direct status information. While they often retrieve dossiers on the fly, they don't retrieve status at the same time (as of yet), even though it would be possible.

INPADOC legal status

Many patent offices share their data of published applications or patents with other patent information sources which aggregate such information from various national authoritative sources and make them available for searches; such sources may be called secondary sources of patent information in contrast to the primary or official sources. The INPADOC database hosted by the EPO is the most comprehensive such source for legal status which is publicly accessible.

Gazettes or bulletins

Jurisdictions which do not have any online patent register or other online publication database meet the legal obligations to publish information related to patents and patent applications by publishing at least a Gazette or another official publication. Such publications are usually available in an electronic format and downloadable from a public website of the IP Office of the jurisdiction.

5.3.5. Analyzing prosecution history

Prosecution history reflects the evolution of examination in the national phases and is the sequence of office or applicant actions.

In some online registers it is presented as a separate list of actions or events; or it can readily be derived from the sequence of documents or communications between office and applicant which are linked to such actions or events, and which are listed in dossiers. It informs on, for example:

- claim evolution, in particular the claim set currently under investigation or the claim set intended for grant;
- whether and how many top-up searches were conducted and on which claim sets they were based;
- why examination is still pending in an office while it is completed in others, for example, whether the ongoing discussion between examiner and applicant is based on prior art or peculiar aspects of patentability, which were not considered in already completed national phases; or
- the determination of applicants to obtain a patent, for example because they repeatedly amended claims, submitted auxiliary requests, requested hearings or requested continued examination;
- whether oppositions or appeals are pending.

5.4. Examination of Work-Products and their Retrieval

One may distinguish final examination work products, such as claims that were granted or claims that were refused or abandoned, from intermediary work products which were established during the course of examination and eventually led to the final grant or rejection decisions, or the decision of the applicant to withdraw or abandon an application.

The most important intermediary work products are search reports or simply citations as they may be useful even when the set of claims examined by another examiner in another national phase are not exactly the same claims. This unit therefore includes a special focus on citations.

The utility of foreign examination work products depends on how similar the claimed subject matter was/is. This unit therefore includes a special focus on comparing claims.

5.4.1. Types of examination work products and their utility

Utility of search reports and citations

Prior art searches for substantive examination are based on the claims to be examined. They are therefore focused on the various characteristics of the claimed subject matter. Subject matter disclosed only in the description is normally not searched. Enriched search reports usually point out to which claim a given citation is directed and what category it is with respect to that claim.

If claims examined in different national phases differ, it may be that a category X citation in the one national phase may be a category Y citation or even A in another national phase, depending on how similar the claims are. Similarly, the category of a citation may also change during the prosecution history of an individual application, for example with a claim amendment.

Although the subject matter claimed for different family members may differ to a larger or lesser extent, there may still be certain similarities or they may even have some characteristics in common; foreign search reports and citations are therefore usually at least somehow useful. It may even be possible that a category A citation may turn out to be a category X citation for another family member.

Searches done by other examiners from foreign patent offices may also be valuable complements because they may have access to different search platforms, which include further documentation searchable, or dispose of search interfaces which enable other search queries; or else, they may be able to do key word searches in other languages.

For applications filed via the Paris Convention rout this need not be the case. The flexibilities of the Paris Convention permit descriptions that differ from the description of the priority application(s); for more, see these explanations.

Utility of opinions

The utility of opinions depends much more on the equality or close similarity of the examined claim sets than the utility of search reports. A novelty analysis applies only if the claims are equivalent. However, an analysis of obviousness or of the appropriate expert or the expert's knowledge may still apply partially if the claimed subject matter is not equivalent but similar, i.e. has a majority of characteristics in common.

In this context, it matters also that offices have quite often different practices for such analysis in place and apply different case law. Therefore, certain explanations given in one opinion would not equally apply in another one even if the subject was the same.

While the provisions of patent laws regarding novelty, inventive step and industrial applicability are usually very similar, there are further criteria for patentability (e.g., exclusions and exemptions) where patent laws may differ, and consequently respective parts of opinions are not applicable in other jurisdictions.

Nevertheless, foreign opinions may provide certain guidance and may be useful because another examiner, for example, because of his/her personal experience of professional background, may gain additional insights or views on certain subject matter.

Utility of claim sets granted in other jurisdictions

Patent laws usually include a provision that claims need to be supported by the description. Therefore, claim sets granted in other jurisdictions for family members may only be considered for grant in another jurisdiction if they are also supported by the description of that other application. For PCT national phase entries this is usually the case.

A particular aspect relates to publications of kind code T (sometimes a number is added, e.g. T2) which represent translations of European grants and may be useful for offices having other working languages than the EPO.

Utility for examination at smaller patent offices with limited capacities

As explained above, the utility of foreign intermediary work products such as search reports and opinions differs. Smaller patent offices may anyway not have the capacities to assess novelty and, and in particular, obviousness themselves. It may be far more efficient to rely on external assessments done by examiners who have the necessary knowledge in the respective area of technology band access to appropriate search tools. That is to rely on what was found patentable or what was rejected in the end.

5.4.2. Retrieving examination work products

National Registers

National patent registers are the authoritative source of legal status of the respective national patent applications and other related patent information. Many patent registers therefore also provide access to the electronic dossier of the applications.

This aspect is further described in the lesson which addresses the researching of legal status in its part related to national registers, where a table of national registers includes information on dossier access via a register and links to the register.

Here is an example of the dossier of an application accessible via EP Register, the register of the EPO.

National registers as indirect source for work-products from other national phases

A peculiar aspect of retrieval concerns jurisdictions which have in place both an online dossier and a disclosure requirement for patent family related information, for example:

- Through the public patent register of **India** inPASS it may be possible to obtain copies of foreign examination reports which would not be available otherwise because the dossier of such jurisdiction is not accessible online. This is based on the disclosure requirement of subsection 2 of Section 8 of the Patent Law of India. Unlike the generic family disclosure requirement of subsection 1 the disclosure according subsection 2 is based on an express request of the controller.
- The **United States** legislation has in place a very strictly implemented disclosure requirement for relevant prior art. Therefore, the US dossier of an application usually always includes communications from the applicant informing the examiner of prior art discovered in other national phases. See this example.

5.5. Citations of prior art

Prior art which is relevant for examining patentability of a claimed invention may be discovered or identified by:

- Examiners who discover them when they conduct prior art searches during the course of examination.
- Inventors who usually develop innovations based on existing prior art, and applicants who may want to conducted their own prior art searches when preparing an application in order to assess the potential success; they may disclose some of the relevant prior art in the application; or may even be obliged, in some jurisdictions like the US, to disclose all prior art known to them to the examiner.
- Third parties, such as competitors in the market who know the state of the art very well, in particular, disclosures that are difficult to search like non-written disclosures.

To this variety of origins or originators of prior art citations corresponds an even larger variety of primary or aggregating sources where such prior art related to an individual application or its patent family is cited, for example:

- citations in search reports prepared by examiners;
- citations listed in opinions prepared by examiners;
- citations listed under INID code 56 on front pages of publications of granted patents;
- tables of citations in registers;
- (backward) citations aggregated for several family members in the Common Citation Document;
- (backward or forward) citations (backward or forward) in public or professional patent database; ...

Citations may be more or less relevant, or apply to certain aspects of patentability (novelty, obviousness). Some sources like search reports established at some offices therefore distinguish different categories of citations, and some aggregating sources also indicate those categories.

5.5.1. Categories of citations

Some search reports like the International Search Report (ISR) of the international phase of the PCT include not only citations but additional information related to each citation. They are therefore sometimes called enriched search reports.

The additional information relates in particular to the so-called citation categories. Each citation in an enriched search report is usually labelled with the category or categories to which it belongs. The definition of each category is explained in the below table.

Category	Explanation
X	Relevant if taken alone, in particular for assessing novelty of claimed subject matter, or obviousness in combination with the knowledge of an expert skilled in the art
Y	Relevant for assessing obviousness of claimed subject matter in combination with other documents or the knowledge of an expert skilled in the art.
A	A document describing state of the art which is not prejudicial to novelty or obviousness.
T	A document useful for understanding the theory or principle underlying a claimed invention or showing that the reasoning or facts underlying the invention are incorrect.
P	A publication which was published after the earliest priority date but before the filing date of the application. Such publications may play a role if the priority is not valid for certain claimed subject

Category	Explanation
	matter. It should be alloted in combination with X, Y and/or A depending on what category applies if the priority would be invalid.
E	A publication which was published after the filing date of the application and which may be relevant for assessing novelty (or obviousness) in jurisdictions which expressly authorize the consideration of such publications
D	A publication which is mentioned in the description of the application as filed. Should be alloted in combination with X, Y and/or A.
O	Non-written disclosure

It should be noted that the category of each citation is dependent on the claimed subject matter which was searched. When a claim is amended during examination, the category of a citation may change accordingly, for example from X to Y.
In older search reports of the EPO one finds occasionally the category I. Its use has been abandoned by the EPO after the PCT WG had decided that it would not be applied for ISRs.

Status of use of citation categories

Citation categories are not yet used systematically by all jurisdictions. They have been applied for International and European Search Reports for many years. The CNIPA, JPO and USPTO have started applying them to the list of citations reported to the CCD.

Backward - forward citations

For a given application, all the documents which were found as a result of a prior art search and which are therefore cited in the search report(s) or in the opinion(s) or in the description of that given application are sometimes called the **backward citations** of that given application. The term backward alludes to the fact that the citation(s) was(were) published in the past, so to speak backwards in time, as seen from the time of search or citation.
This term was coined to distinguish such citations from the so-called **forward citations** of the given application: For a given document a forward citation would be any published patent application or patent for which the given document was cited as relevant prior art.
With other words (and a bit simplified):

- backward citations of application A: all documents cited in a search and examination report for application A;
- forward citations of A: all documents having a search report in which A is cited (as a backward citation).

It is evident that inventions described both in backward and forward citations of an application may be quite similar or technically related to the technology covered by A, and may therefore be further potentially relevant documents in any search that would, in future, identify A as a relevant document. Some patent databases like Espacenet therefore include both backward and forward citations of an application.
For work-sharing purposes, forward citations of family members, if some already existed at all, don't play a role because they are published after the relevant date of prior art of the application to be examined.

5.5.2. Origins of citations

Prior art disclosed by examiners

Substantive examination of applications usually always includes at least one prior art search carried out by an examiner or a team of examiners.
Further searches, so-called top-up searches, may have to be carried out if applicants amend claims that were in a previous opinion considered as not patentable. In some jurisdictions a final top-up search prior to grant is obligatory. Dossiers may therefore include several lists of citations which were established at different stages of prosecution.
For national phase entries of an international application, top-up searches of prior art contained in the national patent documentation may also be obligatory when the international search did not include the national patent documentation.
In many jurisdictions the result of the search is recorded in distinct documents which are frequently called search reports.
However, that is not always the case. For some jurisdictions the prior art considered by the examiner is only cited in the examination reports (opinions; for varying terminology, see here).
Opinions (examination reports) are therefore an important source for citations. When reading an opinion, one may also infer the category of a citation; in particular, for jurisdictions which do not indicate the category of citations in their search reports. Opinions often focus on the citations which are most important for the patentability analysis while search reports often include additional citations which are not (yet) used for raising objections regarding claimed subject matter, but which may become relevant at a later stage when amended claims are to be examined, or which could be used as an alternative for construing objections, that is, instead of the prior art used in the first place.

Prior art disclosed by applicants

For the drafting of patent applications, it is often recommended to compare the invention with prior art known to the applicant or inventor. Therefore, descriptions of patent applications often include references to such prior art. Search reports may cite such references as category D citations although they are not the result of a search.
It should be noted that the respective parts of descriptions which address the state of the art prior to the invention may change and read differently in the description of the patent granted. That is because some legislations require the applicant to amend those parts in view of prior art discovered during examination, for example with a view to the prior art identified as the closest prior art during examination.
In addition to that, the legislation of some jurisdictions has legal provisions for an obligation of the applicant to disclose any prior art that was known to the inventor(s) or applicants when developing the invention, i.e. beyond what was included in the description, as well as any potentially relevant prior art that comes to their knowledge afterwards and even during the examination of the application.
Such disclosure requirements may even include any foreign search report established for members of the patent family. In dossiers one may therefore find repeat disclosures of this kind.
In the US jurisdiction applicants comply very strictly with such obligation and the dossier of an application includes repeat documents labelled 'list of references cited by the applicant and considered by the examiner.

Prior art cited by third parties

Opposition procedures after grant of a patent as well as revocation/nullification procedures for patents in force are very important sources for additional citations of prior art that were not discovered during examination. They may be extremely pertinent because they stem from third

parties that have a keen interest in the revocation of the grant and who know the technology at stake and its state of the art very well because they are often competitors in the market.
Although any disclosure in any form which was disclosed anywhere in the world before the date relevant for prior art constitutes prior art, an examiner cannot search any such disclosures because of natural limitations, such as time, access to search platforms, the information included therein, language, the non-written form of disclosure, etc. For example, for the International Search, only the so-called PCT minimum documentation need to be searched. Opposition and invalidation are therefore important remedies of this deficient situation.
In addition to opposition and invalidation, some jurisdictions also permit so-called 'Third Party Observations' already before grant, in order to enhance the validity of patent grants and prevent opposition procedures after grant. In contrast to parties filing oppositions or request invalidation, such third parties filing an observation do not become parties to the examination procedure and will not be heard before a final decision.

5.5.3. Sources of citations

Original sources for prior art disclosed by examiners

- Original search reports (backward citations)
- search reports of top-up searches
- searches for divisional applications
- Examination Reports (opinions)
- IPRP Chapter II
- Rejection Rulings (Decisions)

Original sources for prior art disclosed by applicants

- Dedicated parts of description
- Documents disclosing prior art complying with legal obligations (US 'documents cited by applicant and considered by examiner'

Original sources for prior art cited by third parties

- Opposition procedures
- Invalidation/Nullification procedures
- Citations per application, citations per family

The sources where one finds citations do not always specify the originator of a citation.

5.6. Comparing claim sets

The utility of foreign examination work products depends on the similarity of the claim sets examined in each respective national phase. It is generally recommended to compare, in particular, independent claims prior to using intermediary work products from other national phases to assure the other examiner examined the same or similar subject matter.
Comparing individual claims or claim sets plays an important role on two distinct occasions:

- **Citations from foreign search reports**: searches are primarily based on claims and do usually not cover subject matter only specified in descriptions. If one utilizes citations found by another examiner one may therefore wish to check if the other examiner searched a similar claim set. If the claim set searched by the other examiner is different and certain technical features are not included therein, a top-up search may be necessary.
- **Grants in several national phases**: If patents have (already) been granted in several national phases of a given PCT application, it may be useful to compare the claim sets granted, in particular the independent claims. It has been demonstrated that claim sets granted in different jurisdictions frequently differ substantially, that is, their scope of

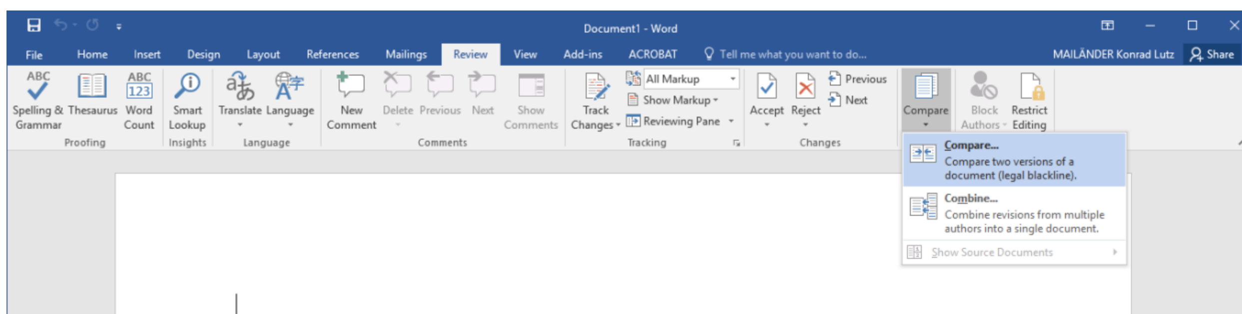
protection is different. Aspects of comparing and utilizing granted claim sets are further discussed here.

The comparison may be done by using a 'compare documents' function of WORD, or other word processing software having such functionality, which returns a track changes version of the claims selected for comparison; please see the following page for more explanations. Full text of claims can be obtained, for example, from Espacenet full text where available.

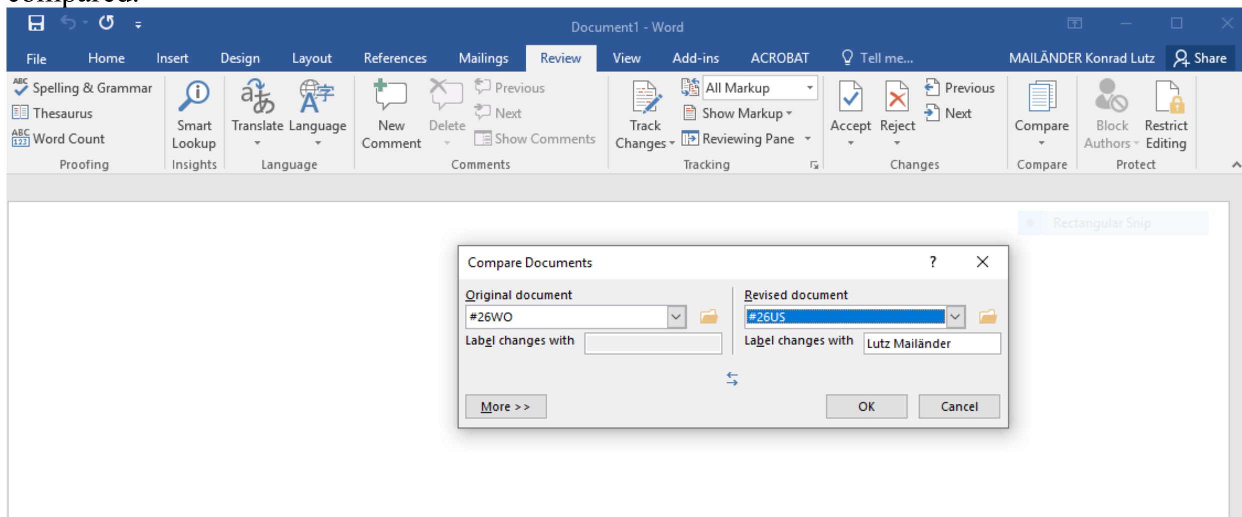
5.6.1. Comparing claim sets by using WORD

The following briefly explains how two claims can be compared by using a special functionality of WORD. It requires that the two claims are available in two distinct WORD documents (here labelled #26WO and #26US).

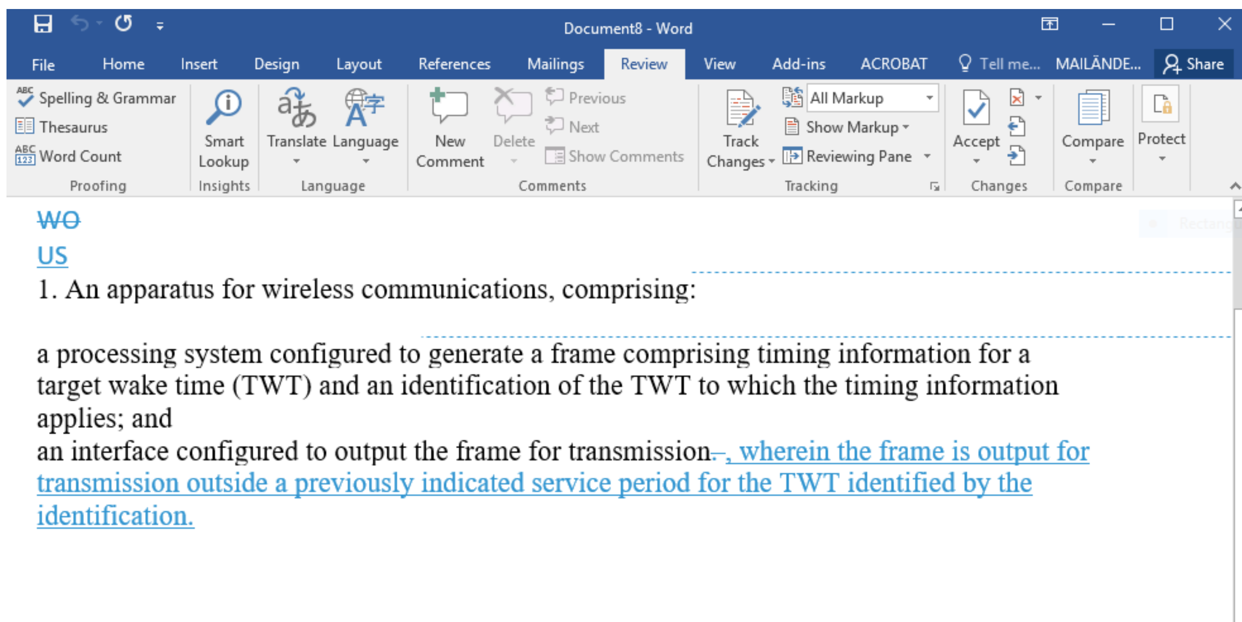
WORD includes a 'compare document' function which is available in the 'Review' tab.



After you have selected the option 'Compare...' you have to choose the two documents to be compared.



After selection and clicking 'Ok' you get the comparison in track changes format in a new document.



For the above example, the one document (#26WO) included the original main claim as published in WO2015099965A1, and the other document (#26US) included the main claim granted by the USPTO and published in US9363752B2. The comparison shows that the US main claim was amended before grant by adding one technical feature (limitation).
For each document, the claim text was obtained by copying the respective full (html) text, for example in Espacenet, and pasting it into the document:

WO2015099965 (A1)
Bibliographic data
Description
Claims
Mosaics
Original document
Cited documents
Citing documents
INPADOC legal status
INPADOC patent family

Quick help
- What is meant by high quality text as facsimile?
- What happens if I click on "In my patents list"?
- What happens if I click on the "Register" button?
- What happens if I click on the red "patent translate" button?
- How can I view the claim structure?
- Why are the claims sometimes in French or German or another language altogether?
- How can I search in the text of the claims?
- How can I view chemical structures in the full text?
- What is Global Dossier?

Claims: WO2015099965 (A1) — 2015-07-02

In my patents list | EP Register | Report data error | Print

TARGET WAKE TIME FLOW IDENTIFICATION IN TWT ACKNOWLEDGEMENT

Claims of WO2015099965 (A1)

A high quality text as facsimile in your desired language may be available amongst the following family members:

CA2932116 (A1) CN105850191 (A) CR20160341 (A) ES2653707 (T3) HUE035423 (T2) JP2017509180 (A) TN2016000217 (A1) US9363752 (B2)

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Select language | patenttranslate powered by EPO and Google

Original claims | Claims tree

The EPO does not accept any responsibility for the accuracy of data and information originating from other authorities than the EPO; in particular, the EPO does not guarantee that they are complete, up-to-date or fit for specific purposes.

CLAIMS
1. An apparatus for wireless communications, comprising:
a processing system configured to:
generate a frame comprising timing information for a target wake time (TWT) and an identification of the TWT to which the timing information applies; and
an interface configured to output the frame for transmission.
2. The apparatus of claim 1, wherein the frame is output for transmission outside a previously indicated service period for the TWT identified by the identification.

Unfortunately, the PDF publications, although representing, for many jurisdictions, the official publications, do not permit such copy/paste. One therefore needs to be aware that the full (html) text may include errors, in particular, with respect to chemical or mathematical formulae.

Another option would be to open a PDF with WORD which automatically triggers a conversion and creates a WORD document that includes the respective claim wording. This conversion may however introduce some errors and need some manual revision before using the compare document function.

5.6.2. Assessing differences of claims

If the comparison of main claims granted by different jurisdictions exhibits differences of the main claims, a further analysis is often needed. In particular, if one considered to grant one of the respective claims sets in one's own jurisdiction, it would be necessary to know whether

1) the differences are of substantial nature, that is, the scope of protection differs; and if so:
   a) whether one can determine that the scope of protection of one main claim is more restricted (limited) than the other;
2) are not substantial, for example:
   a) all characteristics defining the invention being the same but being differently ordered, for example:
      - a one-part claim instead of a two-part claim;
   b) using slightly different but essentially synonymous terminology;
   c) using reference numerals.

If a suitable equivalent patent i.e. one granted by an appropriate Patent Office (or an equivalent application) has been noted through the search conducted above, then a report should be issued suggesting amendment in accordance with the foreign patent. If the application has not yet been granted, the letter should be amended accordingly. The requirements of Section 4(3) and 5 (5) should also be checked.

If a suitable equivalent has not been found, then the applicant should be invited to submit details of equivalent patents (or patent applications).

5.7. Recommendation to Grant/Refuse

If the examiner considers that the application satisfies the requirements of the Act and is thus in order to proceed to grant, he/she should make a brief written report on the findings. These should be a summary of the search and examination report.

When making a report for an application which is not in order for grant of a patent, the examiner should set out the points at issue, the case history to the extent necessary to enable a quick grasp of the essential facts, and recommend the action to be taken, e.g. refusal, or grant conditional upon certain further amendments.

If, on the other hand, the examiner is satisfied that the applicant has had sufficient opportunity to amend and that all the requirements are still not met, he/she should issue a decision to refuse the application. The grounds of refusal must be stated and full reasons must be given.

Refusal may be based only on grounds on which the applicant has had an opportunity to put forward comments. In addition, the applicant's attention must be directed to the provisions for appeal laid down in Section 40.

5.9. Classification of Patents

The International Patent Classification (IPC), as adopted under the Strasbourg Agreement of March 24, 1971 and updated in its subsequent editions, is applied for all purposes relating to the grant and publication of patents, as well as for the maintenance of classified search files.

The IPC is used in over 100 countries to classify the content of patents in a uniform manner. Inventions are classified into eight Sections pertaining to their field of invention, which is further classified into Class, Subclass, Group and Subgroup.

5.10. Withdrawal of application

An applicant may withdraw his/her application anytime during its pendency. A written declaration, signed by each applicant should be submitted to the Registrar. The application fee is not refunded if the application is withdrawn.

CHAPTER 6: GRANT AND PUBLICATION

Section 12, Rule 26

6.1 Grant of Patent

If the applicant has fulfilled the requirements of the Act, a patent is granted, provided that the application is active with updated annuities payment. The applicant is notified on PT-J of the intention to grant and is requested to pay the grant and publication fee within three months from the notification date. Failure to pay the fees within this period, will result in application being refused.

6.2. Patent Certificate

Once the grant and publication fee are received, a certificate of grant of a patent signed by the Registrar should be issued. The number of the patent is a four-digit serial number assigned in a sequential order of grant and the effective date of grant is the date on which the Registrar publishes a reference to the grant. The certificate should be accompanied with a copy of the patent documents (abstract, disclosure/description and claims) as at the time of grant.

The Certificate should contain following details:

a) the number of the patent;
b) the name and address of the owner of the patent;
c) the filing date and, where applicable, priority date of the application;
d) the effective date of grant of the patent; and
e) the title of the invention

6.3 Publication of reference of Patent grant

Every patent granted shall be registered, and published in the Journal. The publication of the reference to the grant of the patent shall include:

i. the number of the patent;
ii. the name and address of the owner of the patent;
iii. the name and address of the inventor, except where he has asked not to be named in the patent;
iv. the name and address of the agent if any;
v. the filing date and number of the application;
vi. if priority has been claimed and the claim has been accepted, a statement of the priority, the priority date, name of the country for which the earlier application was filed;
vii. the effective date of grant of the patent;
viii. the title of the invention;
ix. the abstract;
x. the most illustrative of the drawings, if any; and
xi. the symbol of the International Patent Classification if indicated.

CHAPTER 7: ANNUAL FEES

Section 14 (2)

In order to keep a patent application or a granted patent active, an annual fee is due in advance by or before the anniversary of the filing date, starting one year after the filing date. The annual maintenance request is made on PT-5 by the applicant. The fee is also payable within a grace period of six months provided that the applicant pays the prescribed surcharge using PT-6. Once fee is received, renewal Notification PT-T is sent to the applicant informing the annuity year and next due date for annuity payment.

Failure to pay annual or maintenance fee will result in the application being deemed withdrawn or the Patent being considered lapsed. The applicant is notified of this action taken on their application on PT-K.

The lapse of a patent should be entered in the register and published in Industrial Property Journal.

CHAPTER 8: DEFINITIONS

Sl. No.	Definitions	Statutory Basis
1.	**Registrar**	**Section 44**
	"Registrar" means the registrar of the Industrial Property. In Bhutan the Department of Media, Creative Industry & Intellectual Property is headed by a Director/Director General and is the authorized	

	person to carry out works of the Registrar or the person assigned by him/her.	
2.	**Agent**	**Section 35 and Rule 53**
	"Agent" means a legal representative practicing and resident in Bhutan and a person registered as IP agent in prescribed manner.	
3.	**Patent Cooperation Treaty (PCT)**	
	It is an international treaty with more than 155 contracting states. The PCT makes it possible to seek patent protection for an invention simultaneously in a large number of countries by filing a single international patent application instead of filing several separate national or regional patent applications. The granting of patents remains under the control of the national or regional patent offices during the national phase. Bhutan is currently not a member to the PCT.	
4.	**Priority date**	**Section 9**
	"Priority date" is the earliest filing date of a design application in any of the countries party to the Paris Convention for Protection of Industrial Property(PCPIP). The "Right of Priority" means if an applicant has a corresponding design application* filed earlier in a Paris Convention country(other than Bhutan), he/she may claim priority from this first-filed application, provided the Bhutan registration is filed within six months from the date of the first filing. * *A corresponding application is a separate application filed outside Bhutan for the same design in respect of the same article.*	

References

1. Industrial Property Act of Kingdom of Bhutan 2001
2. Industrial Property Rules, 2001
3. Guidelines for Examination in the Indian Patent Office.
4. Work Sharing and Examination in the PCT national phase, WIPO.

Annexures

1. *Annexure I*-Patent Fee Schedule
2. *Annexure II*-Patent Registration Work Flow in IPAS
3. *Annexure III*-Office Document (Notifications from IP Office) Processing in IPAS
4. *Annexure IV*-User Document (Forms submitted by clients/agents) Processing in IPAS
5. *Annexure V*-Patents Notifications
6. *Annexure VI*-Patents Forms

Annexure I-Patent Fee Schedule

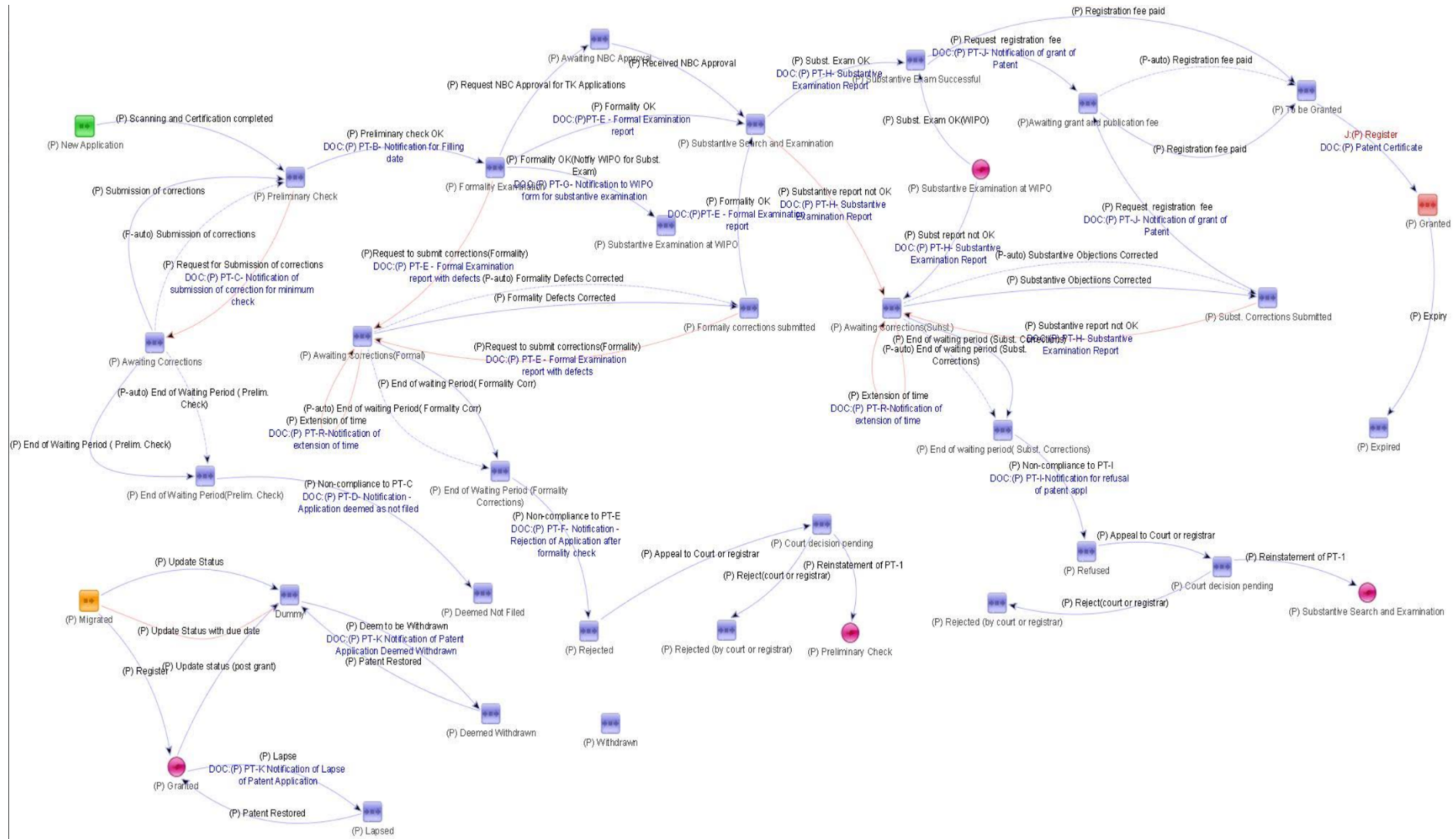
Sl/ no	Form No	Form Description	Amount of Fees (in Ngultrum)	
			Natural Person	**Legal Entity**
1	**PT-1**	Request for grant of Patent.	1000	4000
			Multiple of Nu. 1000 in case of every multiple priority. If the specification exceeds 30 pages, Nu. 100 shall be charged for each additional page. If the number of claims exceeds 10, Nu. 200 shall be charged for each additional claim.	Multiple of Nu. 4000 in case of every multiple priority. If the specification exceeds 30 pages, Nu. 400 shall be charged for each additional page. If the number of claim exceeds 10, Nu. 800 shall be charged for each additional claim.
2	**PT-2**	Filing of corrections for minimum check.	200	800

3	**PT-3**	Filing of correction for Formality/Substantive Search and Examination.	500	2000
4	**PT-4**	Submission of grant and publication fee.	2500	10,000
5	**PT-5**	Maintenance of Patent.		
		Before the expiration of the 1st year from the date of patent in respect of the 2nd year	500	2000
		Before the expiration of the 2nd year from the date of patent in respect of the 3rd year	500	2000
		Before the expiration of the 3rd year from the date of patent in respect of the 4th year	500	2000
		Before the expiration of the 4th year from the date of patent in respect of the 5th year	500	2000
		Before the expiration of the 5th year from the date of patent in respect of the 6th year	500	2000
		Before the expiration of the 6th year from the date of patent in respect of the 7th year	1500	6000
		Before the expiration of the 7th year from the date of patent in respect of the 8th year	1500	6000
		Before the expiration of the 8th year from the date of patent in respect of the 9th year	1500	6000
		Before the expiration of the 9th year from the date of patent in respect of the 10th year	1500	6000

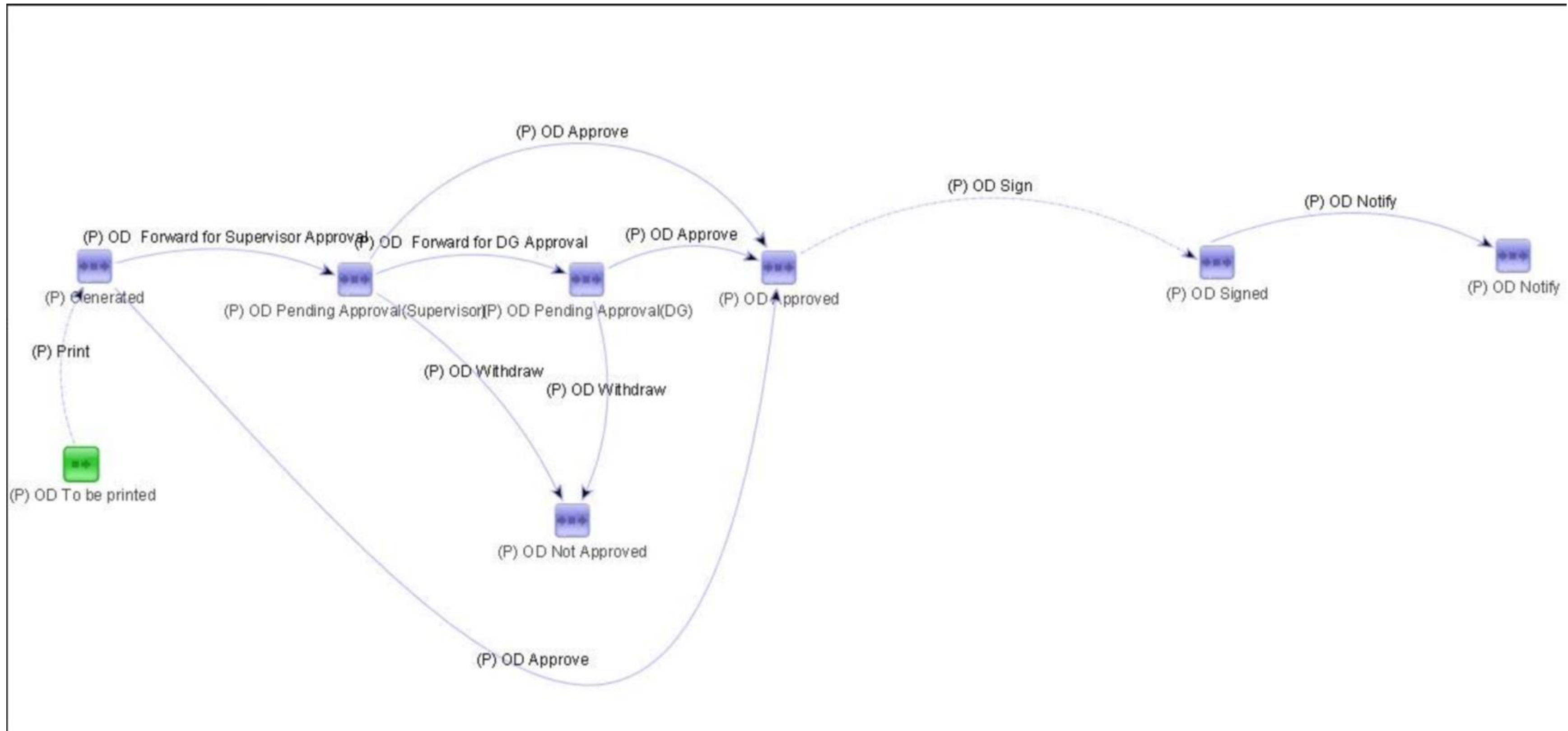
		Before the expiration of the 10th year from the date of patent in respect of the 11th year	3000	12, 000
		Before the expiration of the 11th year from the date of patent in respect of the 12th year	3000	12, 000
		Before the expiration of the 12th year from the date of patent in respect of the 13th year	3000	12, 000
		Before the expiration of the 13th year from the date of patent in respect of the 14th year	3000	12, 000
		Before the expiration of the 14th year from the date of patent in respect of the 15th year	3000	12, 000
		Before the expiration of the 15th year from the date of patent in respect of the 16th year	5000	20, 000
		Before the expiration of the 16th year from the date of patent in respect of the 17th year	5000	20, 000
		Before the expiration of the 17th year from the date of patent in respect of the 18th year	5000	20, 000
		Before the expiration of the 18th year from the date of patent in respect of the 19th year	5000	20, 000
		Before the expiration of the 19th year from the date of patent in respect of the 20th year	5000	20, 000
6	**PT-6**	Surcharge for late payment of annual maintenance fee.	600	9000
7	**PT-7**	Request for invalidation of Patent.	1500	6000

8	**PT-8**	Changes in Ownership.	1500	6000
9	**PT-9**	Request for recording of licenses.	1000	4000
10	**PT-10**	Correction of clerical errors.	1500	6000
11	**PT-11**	Request for extension of time for a month or part thereof.	Nu. 300 per month.	Nu. 1200 per month.
12	**PT-12**	Request for consultation of register.	500	2000
13	**PT-13**	Request for hearing before the Registrar.	1000	400

Annexure II- Patent Registration Work Flow in IPAS



Annexure III- Office Document (Forms) Processing in IPAS



Annexure IV- User Document (Notifications) Processing in IPAS