

MEETING WITH IP STAKEHOLDERS ON STEPS TAKEN FOR IMPROVEMENT IN PROCESSES IN IPO AND THEIR IMPACT

Sl.No.	Office	Issues raised and suggestions received from stakeholders	Response of office of CGPDTM regarding steps taken/being taken for improvement in processes and resolving issues
1	TMR	Trade mark applications under Madrid that are in PARM (show cause) need to be expedited.	Relevant steps are being taken to expedite backlog of applications in PARM and Show cause hearing modules.
2	TMR	Under the new Trade Marks Rules, in respect of well-known marks, will the proprietors of such marks have to apply again for registration as well-known marks.	No. It has already been clarified in the meeting.
3	TMR	In trade marks, registration certificates are being sent by email. The earlier practice of sending physical certificates need to be restored.	As the office is moving towards delivery of more e-services, this request is unwarranted. Stakeholders are requested to take a printout on a suitable quality paper.
4	PO	Most patent offices do not charge any fee for change in address for service in India. Attorneys have to pay an exorbitant fee for changing their address and the attorneys have to bear those expenses.	As per law, any request for change in address for service has to be accompanied by the prescribed fee and, therefore, the fee is required. However, for providing additional email address in the record, a provision has been made available on the official website of IPO. For this purpose, no fee is required to be paid.
5	PO	There are some patent applications where decisions are awaited for many years even after hearing/rehearing.	Rule 24- C (12) of the Patents (Amendment) Rules, 2016 provides for disposal of post-examined applications by the Controller in a timely manner. After detailed review of pendency, specific instructions are being issued to the Controllers to ensure timely disposal and avoid undue delay.
6	PO	Some patent applications have been abandoned even though a response was filed within time.	Some cases were abandoned wrongfully because, even though the reply was filed by the Applicant within the prescribed time, the same was recorded in the electronic system of the Patent Office in wrong head of the entry; one of the reasons for this wrong entry could be that it was so recorded in the correspondence form too. Necessary action is being taken in this regard and abandonment orders have been recalled in such instances. Applicants are advised to bring such instances to the notice of the respective Patent Office.

7	PO	In patents, after hearing, the file wrappers are not updated, that is, the communications between the Controller and the Applicant are not uploaded.	Such communications will be uploaded. Necessary provision is being made for the same.
8	PO	There is an inconsistency in the implementation of the guidelines related to CRIs. The inconsistency is present in the Patent Office, Delhi. The other offices are consistent. The Delhi Office encourages forum shopping and the Applicants are not willing to file in Delhi.	As informed in the meeting, Government has formed a committee to look into the issues related to CRI guidelines and committee has already submitted the report and same is under review by the department.
9	PO	Video-conferencing works well when the Applicant is represented by a Patent Agent. But in cases where the Applicant for instance is an individual inventor and is not represented by a Patent Agent, the Applicant may face hardships.	1. Individual applicants can make a request to post the matter for hearing at the respective Patent Office. 2. Feasibility is being explored to extend the video-conferencing facility whereby Applicant/ Agent can attend the hearing through video-conferencing using his own computer from anywhere using internet based protocols.
10	PO	Multiple hearings are being appointed in patent applications, particularly, where the Controller was transferred to another jurisdiction. This is happening even in opposition matters.	Steps are being taken to ensure that, in case the Controller has been transferred from one location to another location after hearing the matter, such Controller shall be required to issue the decision in the said matter to avoid such multiple hearings.
11	PO	A clarification is needed in respect of the newly introduced 3 months extension in Patents Rules. Can the extension be taken for one month thrice or it has to be taken at once for 3 months.	It is clarified that a single request for extension, subject to maximum of three months, is expected as per rules. Fee to be paid for the total period of extension requested through one time application, on a per- month fee basis, as per rules.
12	PO	IPAB is not working for last 6 months.	As informed in the stakeholders meeting, the Govt. is aware about the issue and necessary action is being taken by the Department in this regard.
13	PO	Examination of divisional and parent patent applications is still not happening in accordance with the Patents (Amendment) Rules, 2016.	This happens due to inconsistency in the data available in the electronic systems of the Patent Office. Allotment procedure is being streamlined to take care of such issues. Necessary steps are being taken in this regard to ensure that the rules are duly followed in such matters.

14	PO	Controllers in some instances are not ready to proceed with the examination of a divisional application if the parent application has been rejected or withdrawn. There is no clarity among the Controllers on the legal aspect of this issue and it is a big challenge.	Necessary directions are being issued to examine the divisional application in accordance with the Patents (Amendment) Rules, 2016, including the cases where parent application has been rejected or withdrawn, since the parent application is only for the priority purpose whereas the divisional application is based on multiple inventions in the parent application which needs to be examined on merit.
15	PO	Once the last date for a patent application is over there are no timelines. Intention to grant with the text intended to be granted may be sent to the Applicant.	There is no such provision for issuing the intention to grant under the law. Further, as per the Patents (Amendment) Rules, 2016, the reply to the first statement of objections and subsequent reply, if any, is required to be processed in the order in which such reply is received. Steps will be taken to ensure timely disposal of post-examined applications.
16	PO	Examination of amended cases - new Patents (Amendment) Rules, 2016 provide that amended cases will be examined in the order in which the responses are filed. That is not being implemented.	Electronic procedure is being modified and an algorithm has been designed to ensure the compliance of the provisions of Patents (Amendments) Rules, 2016. In addition, further directions are also being issued to Controllers/Examiners to ensure compliance of the Patents (Amendments) Rules, 2016 in respect of pending amended cases.
17	PO	Pre grant opposition procedure is being abused. Controllers and opponents in the guise of public interest are allowing abuse to happen. More clear procedures are required to prevent the abuse.	Rule 55 has been amended by way of Patents (Amendments) Rules, 2016 to provide more clarity. All the Controllers are being directed to abide by the same.
18	PO	Atomic energy related cases - there is no application of mind while recommending a patent application to the Atomic Energy Department. No hearing is offered to the Applicant. Hearing is necessary before recommending to the Atomic Energy Department.	It is a legal matter and matters are referred on the basis of prima facie observations. The procedure given in law is followed by the Patent Office. However, sometimes, due to dual use technology, the related inventions get referred to DAE for clarification. Necessary directions are also being issued to concerned officials to avoid unnecessary references.

19	PO	Biotechnology related applications - great cause of concern that monoclonal anti-bodies related applications are being rejected under section 3(c) and 3(e). 9000 patents have been granted in India, but the Chennai Patent Office has started rejecting applications related to monoclonal anti-bodies. It is a fundamentally incorrect stance.	The office of CGPD TM has put in place Manual of Patent Office Procedure and Practices for uniformity and transparency in the application of the Patents Act. This has been further clarified by the guidelines issued for examination of applications related to Biotechnology, so that uniform practice is followed by all four Patent Offices, including Chennai Patent Office. However, if there is any specific issue, the same can be brought to the notice of CGPD TM.
20	PO	Sequence listing fees has a cap now. The Office should not charge any fee for sequence listings.	Indian Patent office is not the only office which charges such fee. There are number of Patent Office which are charging the fee for sequence listing. However, by capping the fee, the Government has resolved the issue of excessive fee charging for sequence listing.
21	PO	NBA permission - no application of mind while raising objections on patent applications. Frivolous objections are raised.	Permission from NBA is a legal requirement under the Biological Diversity Act. The procedure given in law is followed by the Patent Office on the basis of prima facie observations. However, specific issues raised by the stakeholders will be considered by the Government for resolution.
22	PO	Working of patents – The information required and format is vague and is pain for the applicants to submit electronically.	It is a legal requirement under the law. The procedure given in law is followed by the Patent Office. However necessary changes have been brought in the electronic procedure so as to upload the information in .pdf with given information
23	PO	More time is required to prepare for hearing. Hearing notices provide 2 weeks which is short.	Instructions have been issued to provide more time in hearing notice (4 weeks).
24	PO	We may start formality examination before substantive examination and the FER is issued.	Pre-examination of applications is not legally permissible. However, steps are being taken to do the formality check of applications in RECS section so that applications are not unnecessarily delayed during examination because of formal requirements.
25	PO	NBA is issuing notice as to why the criminal proceedings should not be initiated against the applicants. Two timelines are running concurrently for the patent applicants, one under patents and other under NBA. Applicants at time abandon their applications because of fear of such action	NBA issues received from stakeholders will be considered by the Government for resolution.

26	PO	NBA - Form 3 in respect of NBA given in the bare Act is different from the electronic form available online.	The matter is being referred to the DIPP and the competent authority in NBA and respective ministry.
27	PO	There are a number of volatile technologies that require expedited examination as they have a short life, for instance, of 6 months.	As per existing rules, technology-based expedited examination cannot be done.
28	PO	Collaborative research - if an Applicant notices that by entering India in National Phase, they will face criminal action, the Applicants drops the Indian Inventor's name. Foreign filing permission should therefore be allowed with retrospective effect so that Indian inventors do not suffer.	It is a legal requirement. The procedure given in law is followed by the Patent Office. Moreover there is no provision in the Act for issue of permission with retrospective effect
29	PO	A discussion with the examiner may be allowed as it may reduce the number of objections.	As per the provisions under the Patents Act, the examiner is responsible for sending the examination report to controller and, hence, he has no authority to discuss the case with applicant or agent. The final adjudication is done by the controller and, hence, the procedure given in law is followed by the Patent Office.
30	PO	Can a facility be provided whereby a SMS is also sent to Applicant / Inventor in addition to email communications being sent by the Office.	This facility will be provided by the Patent Office in due course of time.
31	PO	Procuring a startup certificate is very difficult.	Generally not true. However, specific instances may be brought to the notice of DIPP.
32	PO	Patent Office, Delhi has rejected a number of CRI related patent applications. These guidelines may be kept in abeyance until the new ones are issued.	As informed in the meeting, Government has formed a committee to look into the issues related to CRI . The Committee has already submitted the report and the same is under review by the department.
33	PO	Certified copies are not being received in patents in 21 days (specifically in Chennai office).	The issue, which is specifically related to Patent Office Chennai, has been rectified. Therefore, any specific instances in future may be brought to the notice of HO Patent Office Chennai.
34	PO	Emails may be uploaded into the respective file wrappers.	This facility will be explored so as to include E-mails as correspondence in the View Applications details. However, there are some technical issues involved which are required to be resolved .

35	TMR	Oppositions in trade marks - wherever counter statements have not been filed, some action needs to be taken as the oppositions may be frivolous.	Agreed. Necessary action is being taken in this regard.
36	PO	Before the electronic modules were created, some requests were filed and the offices reply that since modules are not there, such requests cannot be processed.	Such instances may be brought to the notice of this office and necessary action will be taken.
37	PO	What is our official stand on PPH?	At present, PPH is not under consideration of the Government. However, an alternative by way of expedited examination has been provided.
38	PO	Universities - they are treated as large entities and there is huge financial burden that has to be incurred by them if filing/prosecuting patent applications.	The suggestion is well-taken. Administrative measures will be explored in this regard.
39	TMR	For a copyright filing that can be used as a trade mark a NOC is required from the TMR Registry. This should be expedited. affidavit stating that there is no pending litigation at the time of filing of request. In spite of an internal order issued 3 years ago, Examiners insist on latest affidavit.	This issue has been streamlined. However, earlier pending cases may be brought to the notice of TMR Registry for necessary action.
40	PO	There are a large number of uploaded documents. They should be indexed and classified properly.	The possibility of indexing as suggested is being explored. Technical issues are being investigated.
41	PO	Sometimes, we don't receive hearing notices by email in patents.	The issue has already been clarified in the presentation of the CGPDTM and steps taken to avoid such cases. However, specific instances, if any, may be brought to the notice of the Patent Office, for corrective action.
42	PO	All hearing notices may be uploaded in respective file wrappers.	This facility will be made available by the Patent Office.
43	DS	Designs - objections are raised after the last date is over that you should have contemplated that an objection will be raised and therefore a request for extension should have been filed.	Necessary guidelines are being issued separately to Design controllers.

44	PO	Chennai Patent Office - some of the records are not available as they were destroyed in floods.	All records are available in the digitized form. However, specific instances may be brought to the notice of Patent Office, Chennai and necessary action will be taken.
45	PO	Private PAIR should be contemplated for providing access to the Applicant before publication.	The facility of Private PAIR is being explored. Technical issues are involved in this.
46	PO	An opposition division should be created as patent oppositions have been pending for years. Officials with legal background should be taken in such divisions as sometime the Controllers fail to appreciate legal aspects and aspects related to evidence.	Suggestion is not feasible within the existing legal framework. Necessary steps are being taken for capacity building and skill development of Controllers, which will ensure quality disposal.
47	CR	ISBN issuance online process was not working for last 6 months in Copyright office.	Copyright Office has been made subordinate office under the CGPDTM. Therefore, the activity of shifting of office caused delay in start of functioning. The office has however resumed its functioning now.
48	CR	Copyright - There is an overlap between content carriage on the broadcast sector side. The Copyright Act was amended in 2012 and TRAI is not informed of that. There has to be some degree of sensitization of the TRAI as it is exercising to the effect that amounts to rate setting in copyrights.	This issue is sub-judice at present.
49	CR	Copyright - When the rules were made because of the amendments an anomaly has been created in respect of performers' rights.	Stakeholders are requested to submit a detailed representation specifying details of this issue, so that necessary action can be considered in this regard.
50	PO	Digital signatures for e-filing - why should individuals need digital signatures for e-filing.	The digital signature requirement is being replaced by Aadhar Card based authorization. Hence, this problem will therefore be resolved in due course.
51	PO	<u>Suggestions relating to examination and process :</u> If before the examination of an application is initiated, the Applicant has filed an amended set of claims, it is important that the Controller considers the said amended set of claims when issuing the FER.	It is a standard practice by the Controller to take on record the amended set of claims filed before the application is taken for examination at the time of issuing FER, if the set of amended claims are submitted along with Form 13 and the requisite fees. Such amended claims are taken into consideration during the examination as per provisions of section 57 and 59 of the Act.