

AIPPI • JAPAN



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International Association for the Protection of Intellectual Property of Japan

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The Office of the Controller General of Patents, Designs & Trade Marks
Department of Industrial Policy & Promotion
Ministry of Commerce & Industry
Boudhik Sampada Bhawan
S.M. Road, Antop Hill
Mumbai – 400 037
India

sukhdeep.ipo@nic.in

Re: The Draft Manual of Patent Office Practice and Procedure

Dear Sirs,

The Japanese Group of AIPPI (AIPPI Japan) appreciates the opportunity to offer comments regarding the Draft Manual of Patent Office Practice and Procedure.

AIPPI Japan is the local group in Japan of AIPPI, The International Association for the Protection of Intellectual Property, which has more than 8,000 members worldwide. The Japanese group was founded in 1956 and currently has about 1,100 members (approximately 900 individuals and 200 corporate members). It is the largest national/regional group of AIPPI. Its members include patent attorneys, lawyers and other patent practitioners in private and corporate practice, and in the academic community. AIPPI Japan represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property.

AIPPI Japan, as a user organization, deeply appreciates every effort made by the India Patent Office (IPO) to improve the patent system in India. Recently, interest in the Indian patent system has increased tremendously in Japan because of a higher level of investments in India from Japan and a bright perspective of economical developments in India.

We would like to offer comments on the Draft Manual of Patent Office Practice and

Procedure.

Regarding Divisional Application

First, we would like to point out the most important and substantive issue, according to our view, in the proposed guidelines. In Chapter 6, section 06.01.03, it is stated that: “While a patent application can be divided into multiple divisional applications at one instance, a divisional application cannot be further divided.” In view of practices in other countries, these provisions are very restrictive and will deprive the applicant of flexibility in prosecuting patent applications. At the least, a second chance of dividing from a divisional application should be allowed. Since the Indian patent law does not provide for US-style continuing applications, we believe that the second chance of dividing from a divisional application may be used to reset examination for the benefit of the applicant while the first divisional applications may be required in response to the lack of unity the examiner may find.

We strongly recommend revising Chapter 6, section 06.01.03.

In the following, we would like to offer our opinions and comments to possibly improve the proposed guidelines.

As to Chapter 2 “Key Definitions”

Section 02.02.04

In the definition of “inventive step”, the nature and meaning of “existing knowledge” and “economic significance” should be clarified. This problem is not resolved even if we look at “Determination of inventive step” in 08.03.04.02. What the economic significance may mean is difficult to grasp because it is not a generally recognized element in the determination of inventive step among jurisdictions outside India. It is probably desirable to define precisely what “existing knowledge” means and provide some examples of “economic significance”.

Section 02.02.05

We believe that what “industrial” means should be clarified especially in view of the TRIPS Agreement, so as to make it clear that the Indian patent law and practice are in fact TRIPS compliant.

As to Chapter 3 “Filing of Patent Application”

Section 03.02 Jurisdiction

The territorial jurisdiction of a patent office is noted to be decided based on the three

factors: (1) the place of residence, etc., (2) the place from where the invention is originated, and (3) the address for service in India. It is not clear which criteria prevails when two or more of the above three categories are applicable. Also, for foreign applicants, it is better to explicitly state that the address of the administrator (patent agent) of a patent application dictates when neither of factors (1) and (2) is applicable.

Section 03.05.04 “Invention relating to Atomic Energy”

At item 3 in section 03.05.04, it is stated that: Any person desiring to apply for a patent abroad.” We believe that this “any person” should be qualified in terms of the address of the applicant or the origin of the invention. We do not believe that these provisions are meant for applicants who reside outside India and/or inventions made outside India.

Section 03.04.01 Contents of Patent Application

We believe that certain provisions are desirable in connection with the late filing of a priority document and/or a power of authority, so that the applicant is clearly informed of his or her responsibility when such document has to be filed late.

As to Chapter 4 “Publication of Application”

Section 04.04 “Effects of Publication”

At item 3 in section 04.04, it is stated that: “A patentee can claim damages from the date of publication of his/her application. However, the patentee can institute a suit for infringement only after a patent is granted.” These provisions probably should have more preciseness in view of practices adopted outside India. For example, in order to claim damages, is a warning to an alleged infringer required? From what point in time damages may accrue?

As to Chapter 7 “Convention Application, International Application and National Phase Application”

Section 07.01.04

At item 6 in this section, it should be clarified when and under what circumstances the Controller may decide to require a certified copy of the priority document, so that the application may be well prepared of such requirement.

As to Chapter 8 “Examination & Grant”

Section 08.03.03 Novelty

It is not clear if the filing date of the application under examination is the same as the

publication date of a publication or the filing date of another application. No provisions are found in the current draft as to how the examiner would deal with the two applications that have the same filing date. Also, it is not clear whether a publication is “published” or otherwise disclosed if it is made publicly accessible, but not actually accessed by a third party.

Section 08.03.06.10 A mathematical or business method or a computer programme per se or algorithms are not patentable.

More examples should be provided in this section. For example, what “Business Methods” in item c may mean should be clarified with examples. Also, “some hardware” should be supported by some examples.

It is noted in the draft at item d that claims directed at “computer program product” is not allowed as a claim category because they are computer program *per se*. It should be noted, however, that computer software products in claim language are a medium that stores a program for realizing specific function using hardware, and are different from computer program in, say, C, Fortran or other computer languages, *per se*. At item e, on the other hand, it is stated if a claim is not directed at a computer program *per se*, it could be patentable. It is not clear what types or categories or expressions should be used to claim processes that are embodied in computer programs. It should be clarified with specific examples in order to make examination consistent and predictable.

Also, it is stated at item g, “A computer programme which may work on any general purpose known computer does not meet the requirement of patentability.” We believe that this statement may in effect disallow any software invention unpatentable and feel overly restrictive. We believe that this statement may contradict other statements in this section and should be deleted.

Section 08.03.08 Unity of Invention

In item a) in this section, it is stated that: “a group of inventions is so inked as to form a single general inventive concept”, but it is not clear how such a group is determined. For example, it is not clear whether inventions need to be related through a common object or problem to be solved, or they need to be related through common major elements or features of the inventions.

Section 08.04 Consideration of the Report by Controller and issuance of FER

At item 4 in this section, for the benefit of the applicant, what type of steps or measures may possibly be taken by the applicant should be discussed as a recourse to the abandonment of the application when the twelve months period has passed from the date of forwarding of FER to the applicant. Also, it should be clarified what would be examples for “reasons beyond the control of the applicant”. We believe that the extent of “beyond

control” can be clarified by way of specific examples.

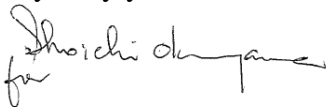
Chapter 11 Appeals

Section 11.01.01

It is not clear from this section that, as a result of appeal proceedings, the original decision, order, or direction is cancelled or the case is remanded or both. Is the Appellate Board capable of making its own decision on merit replacing the original decision?

We appreciate this opportunity to submit the above comments in response to the Draft Manual, and would be pleased to answer any questions that our comments may raise.

Very truly yours,

A handwritten signature in black ink, appearing to read "Yoshio Kumakura".

Yoshio Kumakura
President
The Japanese Group of AIPPI