

AIPPI • JAPAN



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International Association for the Protection of Intellectual Property of Japan

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Mr. Chaitanya Prasad
Office of The Controller General
Patents, Designs & Trade Marks
Boudhik Sampada Bhavan,
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AIPPI Japan's Comments on Draft Guidelines for Search and Examination of
Patent Applications

Dear Sirs,

The Japanese Group of AIPPI (AIPPI Japan) appreciates the opportunity to offer comments regarding the “AIPPI Japan's Comments on Draft Guidelines for Search and Examination of Patent Applications”

AIPPI Japan is the local group in Japan of AIPPI, The International Association for the Protection of Intellectual Property, which has more than 9,000 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.

Our comments are attached hereto.

very truly yours,

Eiji Katayama
President
The Japanese Group of AIPPI

Comments to Indian Patent Office on Draft Examination Guidelines

To the Draft Patent Examination Guidelines that were made available to the public on 3 March 2015 (hereinafter called the "Draft"), we hope the following modifications and improvements will be made:

oSection8

•Treatment of information submitted under Section 8

<Possible improvements>

- 1) The Examination Guidelines should stipulate how the Examiner/Controller shall treat information submitted under Section 8 of the Patent Act.
- 2) The Guidelines should specify what "detailed particulars" in Section 8(1) refer to.
- 3) Concerning information required by an Examination report, as under Section 8(2), the Guidelines should specify which countries the applicant needs to furnish information about, instead of "major countries."

<Reason>

- 1) The Patent Acts or Rules has no provisions on how the Examiner/Controller shall treat such information submitted by applicants who spend time and effort for its preparation.
- 2) It is not certain what the term "detailed particulars" refers to in related foreign applications.
- 3) The term "major countries" is also vague and therefore, should be clearly specified.

oChapter7

•Guidance on amendments

<Possible improvements>

Guidance on amendments should be given more clearly.

<Reason>

In the case "patent no.133689... Orissa Cement (applicant) v. Belpahar Refractories (opponent)" on page 73, the guidance says "(i) the amended claims cover matter disclosed "in substance" in the original specification, whether or not originally claimed." This can be interpreted as meaning that elements in the amended claims do not have to be included in the original claims.

On the other hand, in the case "OA/4/2009/PT/CH [189/2012] IPAB" on page 75, the guidance says "None of these elements were claimed in the originally filed claims. Therefore such inclusions by way of amendments are not permissible under section 59." This can be interpreted as meaning that the elements in the amended claims have to be included in the original claims.

In these two examples, it seems totally opposite to each other how the amended claim element should be or should not be covered by original claims.

oChapter 11

Abandoning, refusal and grant procedure

- Report on working of patented invention

The 7th item in the list of "Consequences of grant" on page 84:

"Every patentee and licensee has to furnish a statement regarding the working of the patented invention on commercial scale in India at regular intervals (not less than six months) in the prescribed format."

<Possible improvements>

This statement (report) should be abolished.

<Reason>

An excessive burden will be imposed on a patentee, if every year, he/she has to check the status of working, prepare information needed for a report, and bear the cost to do so. In an extreme case, even if a patentee abandons his/her rights, he/she might have to submit such a report for that year.

oChapter12

- Periods for notice relating to post-grant opposition

<Possible improvements>

The periods for advance notice (of the date of hearing, of intention to use yet-to-be-submitted publications) should be longer. Alternatively, there should be a new system, under which such a period may be extended on the grounds that the applicant is a foreigner.

<Reason>

Concerning post-grant opposition, the periods for notice are too short for foreign applicants: the period for notice of the date of hearing ("at least ten days in advance" on page 87), and the period for notice of intention to rely on Publication at the hearing not already mentioned... ("at least five days before the date of hearing").

oAnnexure 1

- Priority documents

"Table Showing the time provided under the patents Act and Rules" on page 30

(Item 3) "Submission of priority document duly certified by the competent authority. If the priority document is not in English, corresponding in English duly certified."

<Possible improvements>

- (1) We hope the Indian Patent Office will start to use the WIPO's Digital Access Service (DAS) for electronic exchange of priority documents.
- (2) Translation of priority documents should be required only when a decision to refuse the application may be avoided by the submission of said translation.

<Reason>

(1) Through the use of such an effective service, the amount of time devoted by applicants for the application procedures is expected to be reduced.

(2) Currently in many cases, a priority certificate, its translation and the translator's oath are required all together by an Office action in a "fixed" format, regardless of whether the Examiner's decision of refusal may be avoided by the submission. The preparation of a

translation and its translator's oath places a large burden on applicants.