

STEPS BY IPO – PROGRESSIVE INITIATIVES



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Steps by IPO – Progressive Initiatives

The Indian Patent Office [IPO] has been tirelessly working over past few years to streamline patent process, clear backlog and become user friendly.

Their aim is to reach a stage where examination report is issued within 6 months from date of filing of request for examination (RFE).

To achieve their target a number of initiatives have been taken by IPO. Some of the major steps taken by IPO over past few years have been discussed hereafter.

Categorizing Initiatives by IPO

We may classify different initiatives into following categories:

- Procedural Initiatives: These are initiatives that directly impact how Patent Office as an organization operates and how it processes applications on day to day basis. We may sub-classify them in following 2 categories:
 - Internal Changes
 - Initiatives impacting processing of applications
- Technical Initiatives: These are initiatives aimed to iron out long standing legal conundrums and bring uniformity in decision making in legal affairs

Procedural Initiatives – Internal Changes

Before an organization aims to scale heights of success, it is important to clean its own house. Taking cue from the same, IPO has taken some of the following major steps towards internal changes:

Increase in strength of office personnel:

To maintain healthy examiner to case ratio, Indian Patent Office [IPO] has recruited nearly 500 examiners! Boost of 500 examiners is bound to result in faster clearance of backlog.

MoU executed by IPO with major patent offices like EPO & JPO:

Indian Patent Office has over past few years executed Memorandum of Understanding or Future Action Plans with major patent offices like European Patent Office [EPO] and Japanese Patent Office [JPO] towards bilateral co-operation establishing a framework for structured work relations. Share of knowledge and training of examiners under exchange programs indicates towards brighter future of IPO.

IPO becomes ISA and IPEA:

An immediate acknowledgment of improved examination standards at IPO is its recognition by the World Intellectual Property Organization [WIPO] as the 17th International Search Authority [ISA] and International Preliminary Examining Authority [IPEA] in the world.

This would enable Indian companies to apply for PCT applications by filing the same in India.

Being the only English speaking country in the Asian region to be recognized as an ISA and IPEA should attract applicants from other English speaking Asian regions.

Lower official fees compared to corresponding ISA and IPEA should also work as one of the primary attractions for opting India as ISA and / or IPEA.

Auto-allotment of cases to Controllers of all 4 offices:

In order to rationalize the allotment of patent application to examiners for examination, an auto-allotment system has been implemented by Indian Patent Office [IPO].

Under present system, a pending application may be examined by any of the 4 patent offices. However, the response to Examination Reports will have to be filed with the Patent Office having original jurisdiction.

To ensure smooth processing of the application, Applicant / Agents on Records will have to ensure that their e-mail address for each case is updated in the records of IPO.

Launch of Dynamic Utilities:

To bring transparency in their operations, IPO has launched dynamic utilities which allow stakeholders to:

- Conduct searches on the granted and published patent databases;
- Conduct searches to ascertain the status of patent;
- Access the desired information on a real-time basis;
- Search the patent information using combination of various search parameters;
- Access on real-time basis the examination reports issued by the office.

Launch of Public Grievance / Feedback Portal:

In a welcomed move, IPO has launched grievance / feedback portal on its website. Present step brings IPO closer to stakeholders and add a personal touch to services provided by them.

Inviting suggestions from stakeholders prior to taking decisions:

Acknowledging importance of inputs from stakeholders, IPO now encourages and calls for feedbacks from stakeholders prior to issuing major technical guidelines and / or issuing legal amendments. This helps in ironing out flaws at nascent stage itself.

Procedural Initiatives – Processing of Applications

Just like initiatives taken to set house in order, IPO has taken some of the following steps to improve their day to day processing of applications:

Gradual introduction of e-filing system:

Latest Amended Patent Rules have made e-filing mandatory for Authorized agent. However, introduction of e-filing system has been a gradual process. Gradual introduction has assisted in ironing out flaws in e-filing system and helped stakeholders acclimatize to new system prior to making it compulsory.

Controllers are authorized to officially communicate using e-mails:

Official communication like Examination Reports, Notices and Letters Patents are being issued electronically by the Controllers and are being sent to Applicants / Agents on Records through e-mails only. This has assisted in avoiding delay in official communications and made Controllers more accessible.

Recognition to Start-ups and Small Entities:

Patent Act has now given special recognition to Small Entities and Start-ups. Special fee is applicable for Applicants claiming small entity status. Further, attorney fee has been capped for attorneys enrolled as start-up

facilitators and extending services to start-ups. This initiative had a direct positive impact on number of patent filings originating from India.

Introduction of Expedited Request for Examination:

Expedited Request for Examination for patent applications in India was introduced under latest amendment of Patent Rules of India.

Under said examination, Application is taken for examination on priority to the applications where regular to express examination has already been requested. However, expedited examination is applicable only if one of the following two conditions is fulfilled:

- that India has been indicated as the competent International Searching Authority or elected as an International Preliminary Examining Authority in the corresponding international application; or
- that the applicant is a Start-up entity.

Introduction of Expedited Examination with conditions appears to encourage IP owners to use India as searching authority during PCT Phase and Start-ups in general.

Launch of Mobile Application:

A mobile app has been launched by IPO and same is available on their website and Google play store. App is an information dissemination tool.

The current version includes the information with respect to but not limited to the following office: Patents Office, Designs Wing of Patent Office, Trade Marks Registry, Geographical Indications Registry, Copyright office, Semiconductor Integrated Circuits Layout-Design Registry & Rajiv Gandhi National Institute of Intellectual Property Management. The Application provides various tools to know about the Application status, Patent & Trade Mark register, relevant Acts & Rules etc.

SMS alert service:

The Indian Patent Office [IPO] has started the SMS alert facility for the applicants and patent agents whereby they will receive alerts informing them about the progress of applications at various stages of processing. The alerts will also be indicating the timelines, non-compliance of which may lead to refusal / abandonment of application.

Publication of Examination Report in Official Journal:

In step towards streamlining the electronic processing of applications, the IPO has started publishing details of First Examination Report [FER] generated in their weekly Official Journal.

Availability of WIPO Digital Access Service (DAS) under WIPO-India Cooperation Agreement:

The Indian Patent Office has started the WIPO Digital Access Service (DAS) for priority documents submitted by Applicants from the participating Patent Offices under WIPO-INDIA Co-operation agreement.

Some of the salient features of WIPO DAS are as under:

- Applicant can simply request the office of first filing to deposit / add the priority document into the WIPO DAS system, and request offices of second filing to use service for obtaining access of such documents;
- Use of an access code provided by WIPO DAS to authorize access;
- Documents are exchanged via secure channels;
- The DAS Service is hosted and administered by WIPO;
- No need to provide a certified copy of a priority document separately to each office of second filing; and
- No need to pay for multiple copies of paper priority documents.

Issuance of electronic patent certificates:

The generation and issuance of Patent Certificates has been fully automated now.

The IPO now issues only Electronic Patent certificates to the applicants or their authorised agents through email and will be available through website for print.

Hearing conducted via video-conferencing:

In a major step towards digitization, IPO has initiated hearing during examination of an application via video-conferencing.

In its initial stage, facility for video conferencing was available only at respective office thereby avoiding travel requirement to different cities for conducting a hearing.

However, recently IPO has made it possible to conduct hearing via video-conferencing directly through agent's office. Further, opting for video-conferencing now comes as an option which an Applicant / Attorney may opt for while filing replying to First Examination Report.

This step is bound to considerably bring down expenditure of time and energy utilized in travelling to IPO for conducting hearing.

Technical Initiatives

Being a quasi-judicial body, it is imperative on the part of IPO to clarify existing legal doubts and bring consistency in decision making by its Controllers and Examiners.

To achieve this aim, various initiatives have been taken by IPO and some of the major ones have been briefly discussed hereafter.

Proposed revision of format for filing of Working Statement:

Recently the Indian Patent Office requested all stakeholders to submit comments on issues related to filing of working statement and later also held a stakeholders meeting to discuss the suggestions.

Some of the important proposed revisions to format of filing of working statement are as follows:

- Waiving of requirement of quantum and value of Patent Product;
- Waiving of requirement of country wise division of imported goods; and
- Acknowledgment of confidentiality of information given in working statement under section 146(1) of Indian Patents Act, 1970. In view of the same, prior to publication of a Working Statement, IPO will take into consideration request of Patentee to stop publication of the same.

Currently this matter is sub judice in view of a Public Interest Litigation filed in front of Delhi High Court. So we may experience some delay before proposed revisions are enforced. But present proposal appears to be in a positive direction and appears to have been taken after duly considering hardships faced by Patentees and Licensees at large.

Revised Guidelines for Computer Related Inventions (CRIs) and Patentability under Section 3(k) of the Indian Patents Act, 1970:

The patentability of CRIs and uncertain nature of law in this area has been a long debatable issue in many jurisdictions including India.

The relevant section 3(k) of the Act, which renders certain inventions as non-patentable, reads as follows:

“a mathematical or business method or a computer program per se or algorithms;”

The noteworthy features of Revised Guidelines are as follows:

- Removal of requirement of “novel hardware” to assess patentability of CRIs; and
- Doing away with the requirement of “contribution lying in both the computer program as well as hardware”.

Form and substance test - The Revised Guidelines propose that patentability under section 3(k) of the Act is to be assessed based on the substance of the underlying invention rather than its form and such judgment should be reached by construing the claims as a whole. As per the guidelines, if any claim in any form such as method/process, apparatus/system/device, and / or computer program product/computer readable medium falls within any excluded category, the subject matter would not be patentable. Hence it becomes essential to define means with physical constructional features along with reference numerals.

In addition to form and substance test / analysis, the Revised Guidelines further provide broad categories of subject matter which would qualify as a computer program per se, and hence would not be patentable:

- Claims directed at computer programs / set of instructions / Routines and / or Sub-routines;
- Claims directed at “computer program products” / “Storage Medium having instructions” / “Database” / “Computer Memory with instructions” stored in a computer readable medium.

The changes under the Revised Guidelines appear to follow more liberal approach and should have substantial impact as to how the patentability for CRIs is to be assessed.

Streamlining of examination of applications requiring permission from National Biodiversity Authority [NBA]:

Through an official notification, Indian Patent Office had provided *guidelines* to streamline processing of patent applications dealing with biological materials from India.

Under Biological Diversity Act, permission from NBA is required before a patent application based on any research or information on a biological resource obtained from India is granted.

Key points of the modified procedure given in the notice are as follows:

- If the invention resides in a value added product, then the Controller / Examiner should avoid raising objection with respect to NBA approval while issuing First Examination Report;
- NBA approval may not be sought for an invention when it merely uses such bio-wastes (*for example incineration, gas burner, etc.*);
- If the invention resides in synthetic material and an explicit declaration is made by the applicant to this effect supported by sufficient disclosure in the specification, then the Controller / Examiner should avoid raising objection with respect to NBA approval while issuing First Examination Report;
- When the invention is based on any research or information on a biological resource not obtained from India, no approval from NBA is necessary. Therefore, when an applicant makes unequivocal declaration in application for a patent that the biological material used in the invention is neither obtained from India nor sourced from India, then the Controller / Examiner should avoid raising objection with respect to NBA approval while issuing First Examination Report.

Present notice definitely come as a reprieve for applicants of patent applications dealing with biological materials from India.

Clarification on requirement of Form – 13 for amendments filed in response to First Examination Report (FER):

To bring consistency in examination process, Indian Patent Office has issued guidelines stating that formal request for amendment on Form – 13 is not required if amendment of claims have been made in response to FER to overcome the Controller's objections.

Impact of Initiatives

Some of the direct and visible impacts of initiatives taken by IPO are as follows:

- Backlog Clearance: First Examination Reports [FER] are now issued after reduced time delays. Now Examination Reports are being issued for cases where regular Examination was requested as recently as in mid of year 2015. Further, once a response to FER has been filed, second office action / hearing notices are being issued within six to nine months.
- Transparency: Digitization of records, uploading of official orders on IPO's website, start of stock and flow utilities, etc. has made Controllers and Examiners more accountable and processing of Applications at IPO more transparent.
- IPO is now more approachable: With allowance of email communication and launch of feedback portal, IPO and Controllers in general have become more approachable thereby adding a personal touch to the services extended by IPO.
- Faster Processing: Applications are now processed at a faster speed. A prime example will be where IPO granted a patent within 9 months from filing of expedited request for examination.

- Improvement in quality of Examination Report: A visible change in quality of Examination Report is visible. It is better structured and more informed. A clear indicator will be promotion of IPO to ISA & IPEA.

Conclusion

Above initiatives or more may not confirm that Indian Patent Office has reached a stage of perfection. But a constant effort to improve to outperform its own standards and backed by a billion plus population of India as potential market does make Indian IP regime more lucrative than before to IP holders across globe.

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*Assuring you of our Professionalized, Personalized,
Pro-active and Prompt (P⁴) Services*

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