



## ORGANISATION OF PHARMACEUTICAL PRODUCERS OF INDIA

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### Views and Suggestions on

### DIPP Discussion Paper on 'Review of Organisational Structure of the Office of the Controller General of Patents, Designs, Trade Marks and Geographical Indication'

**Section VIII – Issues for Consideration** of the DIPP Discussion Paper on 'Review of Organisational Structure of the Office of the Controller General of Patents, Designs, Trade Marks and Geographical Indication':

1. *Given the radically different skill requirements of trade mark and patent office staff, the operation difficulties and the present challenges being faced by the O/o. CGPDTM, is it desirable to establish an independent office for the Trade Marks and GI registry?*

**Suggestion:**

*To add speed and effectiveness to the CGPDTM, there is a need to establish an independent office for the Trade Marks and GI Registry, if required, may be considered.*

2. *If so, what should be the organisational and reporting structure for each office?*

**Suggestion:**

*Heads of both, Trade Marks and GI Registry should report to CGPDTM.*

3. *Given the sensitivity of Patent law and practice in India and also the experience in other major IP offices such as the USPTO, would it be appropriate to consider making the Office of CGPDTM autonomous? Is it possible to bifurcate the two offices and make the Trade Marks Registry and the Patent and Design Office two autonomous organisations?*

**Suggestion:**

*It is desirable that the office of the CGPDTM is made autonomous with Trade Marks Registry and Patent and Design Office reporting to him. For better efficiencies, a competent and qualified work force should be put in place. The CGPDTM may design a system wherein the vast number of law graduates of the country, willing to find an alternative career, can be recruited for the post of examiners. This will not only increase the quality of examination but also ensure that a competent work force is available to tackle the challenges the Madrid Protocol is likely to bring into place.*



*Alternatively, in view of the high degree of attrition of Examiners and the difficulty in retaining qualified and experienced Examiners faced by the Indian Patent Office, it should work towards an alternative way of getting applications examined with lesser dependency on in-house workforce. For example, collaboration with the technical and scientific institutes in India like the IIT or the IISc to build a platform for effective and quicker examination.*

4. *What legal changes are required? What changes are required to the rules?*

**Suggestion:**

**A. Section 5 of the Trade Marks Act, 1999 which deals with the establishment of the Trade Marks Registry and its offices may need to be amended suitably to make the Trade Marks registry an autonomous body.**

**B. The scheme of legislations, as below can be adopted for the same:**

**(i) The Securities and Exchange Board of India Act, 1992 (SEBI Act, 1992)**

**(ii) The Telecom Regulatory Authority of India Act, 1997 (TRAI Act, 1997)**

**An appellate tribunal should also be strengthened, having sufficient expertise, to provide an efficacious appellate mechanism for the Patent, Designs and Trade Marks, and for matters connected therewith or incidental thereto.**

5. *Can the reorganization of the office of CGPDTM be taken up within the existing framework without seeking any amendments to the law? If so, what can be an ideal model?*

**Suggestion:**

**We believe, if the office of CGPDTM is made autonomous, the relevant laws need to be changed accordingly. Some illustrations of the legislations have been suggested as above.**

6. *How should the office of the Controller be strengthened?*

**Suggestion:**

**(i) To effectively cope with its growing workload, the Patent Office needs to further upgrade its IT facilities and ensure that adequate numbers of properly qualified patent examiners are trained to handle the filing and prosecution of patent applications.**



- (ii) The Patent office has in the past experienced problems in locating and managing physical application files. It is therefore recommended that the Patent Office introduces system for better management and storage of physical files. Using a system of bar codes on the physical files could be one such initiative.*
  - (iii) The Patent Office should digitize all of its physical files so that file histories of each application will be available online.*
  - (iv) The Patent Office should provide direct linkage to granted patents and published application.*
  - (v) The Indian Patents Database and the Indian Designs Database should be regularly updated with consistent frequency and released periodically.*
  - (vi) The Patent Office does not have any centre to provide assistance to applicants for filing or prosecuting applications. It is, therefore, recommended that assistance centres should be established to help applicants to file and prosecute applications in India.*
  - (vii) Making available appropriate Search Engines to facilitate worldwide patent searches.*
  - (viii) Advisory Services on Patents may be provided to Indian Scientists to help filing patents in other countries.*
7. *The Department had taken an initiative to outsource some part of the prior art search of the Patent office to CSIR. This project is proving to be beneficial. Which other organizations could be tapped for the purpose. Are there likely pitfalls that the department must take precautions against? What could be such precautions?*

**Suggestion:**

*Outsourcing of some part of the prior art search can be extended to research oriented institutions like NIPER, Haffkine Institute and various other reputed academic institutions engaged in research.*

*It will be worthwhile to establish standards for evaluation and proper system for periodic monitoring of the research work. The system set should be transparent, uniform, fair and consistent to all.*



8. *Is a similar outsourcing (including employment of temporary but qualified personnel) exercise possible in case of trademarks where more than 400,000 trademark applications are pending at various stages? If so, what could be the safeguards that should be put in place?*

**Suggestion:**

*In view of the huge pendency of trade marks applications and the scope of revenue generation by the Trade Marks Registry, all vacancies for the permanent employees need to be filled-up as early as possible. It is high time that the Government stops thinking about short-term measures, as any qualified personnel can never be retained by any employer on a temporary commitment. We do not foresee any reduction in the number of fresh applications and recruiting and training of qualified permanent personnel should be the immediate responsibility of the Government.*

9. *What other measures can be used to improve the base of examination of applications within the framework of the existing legislation?*

**Suggestion:**

- (i) Since electronic filing of patent applications has been introduced, there should be facility for paying the fees online. This facility, if introduced, will make it more convenient for applicants to file application online. This will also enhance speed to the process.*
- (ii) Electronic prosecution of patent applications should be introduced to make the patent prosecution paperless and more efficient.*
- (iii) To encourage applicants to file applications electronically, incentives such as reduced fees should be offered to applicants.*
- (iv) An efficient system should be introduced to ensure timely publication of all patent applications and proceedings that are eligible for publication in the technical journal of the IPO.*
- (v) Patent applications that are published in the official gazette have minimal information. It is therefore recommended that the official gazette includes more details of the applications in order to avoid any frivolous or unnecessary oppositions being filed.*
- (vi) Clear guidelines should be issued for conducting pre-grant and post grant opposition proceedings.*
- (vii) The timeline for an application that will be taken up for examination should be clearly defined. Currently, there is no time defined for taking up the applications for examination.*



10. *In spite of e-filing for patents etc. and streamlining of the examination process, is there a need for setting up additional offices?*

**Suggestion:**

***There is no need to set up additional offices. Technological advancement can be leveraged to connect electronically since distance is not a problem in today's world.***

11. *The National Institute of Intellectual Property and Management, which is housed in Nagpur, is at present under the supervision of the CGPDTM. This institute needs to be developed into a world class institution for research and training in the field of IP. Would it better for such an institution to be directly controlled by the Ministry or should it continue as one of the offices of CGPDTM?*

**Suggestion:**

***It would be worthwhile to continue The National Institute of Intellectual Property and Management, Nagpur, under the supervision of CGPDTM since controlling by the Ministry may delay the regular procedures and systems may get halted for want of approval from the Ministry due to bureaucracy.***

12. *The recruitment of officers has been delayed inordinately by the complicated, prolonged procedures involving interdepartmental approval. What could be the options to address this problem? Should a special dispensation be sought to address this issue. If so, what could be the possible course of action?*

**Suggestion:**

- (i) Continue outsourcing***
- (ii) Remove undue inter-dependability so that the procedures will be faster.***
- (iii) There are 'multiple counters' for retrieving information on progress in prosecution and status of applications. The system should improve towards a single point of entry.***
- (iv) IPO is setting up an internet-based system. Further improvement of direct linkage to granted patents and published applications will speed up the operation.***



13. *Since Trademark registration is a quasi judicial process involving opposition cases and hearings, what can be done to address the large number of vacancies for the post of Assistant Registrar and above? If it is not possible to select new officers immediately, what can be done to remedy the situation?*

**Suggestion:**

*A system can be developed wherein practicing advocates with at least 5 years of experience at the bar can appear for a written examination followed by an interview by a panel. Upon selection such candidates can undertake a year's training under the existing Assistant Registrars. Such workforce can easily be recruited from the vast number of practicing lawyers in our country.*

14. *Considering the importance of trademarks in India and the fact that a majority of the application are made by Indian applicants, should the size of the Registry be addressed in the XII Plan? What could be an appropriate structure?*

**Suggestion:**

*XII Plan is already under consideration. However, the size of the trademarks registry surely needs to be increased by recruiting more number of examiners and double the number of Assistant Registrars of Trade Marks.*

15. *In view of the fact that some innovations can qualify for different kinds of IPRs, would it be better to have a single window at the front end for applicants for all kind of IPRs while the specific IPR issues could be handled by different offices at the back-end?*

**Suggestion:**

*A single window at the front end for applicants for all kind of IPRs would hasten the process.*

16. *Any other views on the subject.*

**Suggestion:**

- (i) *The scheme of the Act needs to be refined, whereby any infringement suit need not be tagged with revocation application, which is filed subsequently (illustration Germany). IPR rights need to be respected in wider economic interest of the country.*
- (ii) *In order to introduce an efficient system of patent prosecution, it is recommended that the Patent Office adjust patent term to compensate patentees for any delay in the grant of the patent that reduces the term of the patent, when such delay is caused solely by the Patent Office.*



- (iii) Decision making and its communication to all concerned should be speedy at the IPO. A system needs to be instituted for issuing the operative part of the decision first, followed by details of the decision taken. These should be advertised immediately in the technical journal to close proceedings at the earliest. Administrative process delays the grant of patents even if the proceedings have been concluded (opposition or otherwise) attracting serial and frivolous pre-grant oppositions. Such delays also prevent the patent applicants to get their grants and are, therefore, unable to initiate infringement proceedings against infringers quickly, defeating the very purpose of the patent and trademark system.*

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