

From:
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Dear Sir/Madam,

Sub: Comments/Suggestions on the Discussion Paper

Reg: Review of Organizational Structure of the Office of the Controller General of Patents, Designs, Trade Marks and Geographical Indications.

This has reference to the captioned subject matter released by your Department and the issues for consideration therein. While, I will be briefly dealing with individual points and issues raised therein, I request your kind attention to the general scenario in the Global as well as Indian context. In a globalized environment, the IPRs play most important role especially Patents which will serve as an indicator of the technological development of Country. Hence, the Government should create proper environment for grant of patent (or IPR) which will help in developing the country's economy. The environment should support the authorities who are actually examining and granting the Patent (or IPRs) to get better services from them.

The following are my comments on the issues raised in the Discussion paper for consideration:

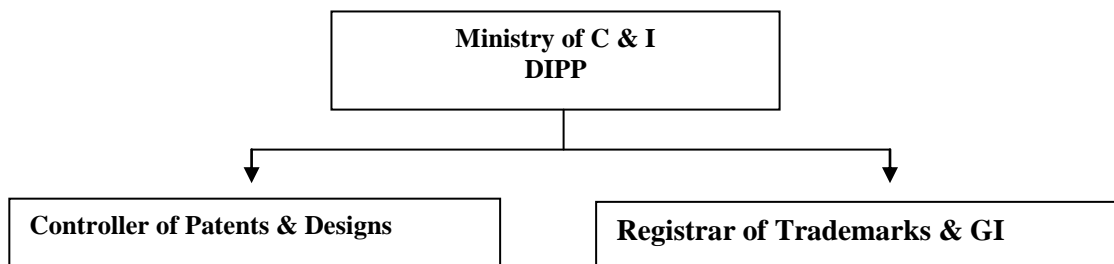
ISSUES FOR CONSIDERATION

1. Given the radically different skill requirements of trade mark and patent office staff, the operational 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?

YES, a separate full-fledged Registry for Trademarks and Geographical Indications as a distinct and independent entity from the office of the Controller of Patents and Designs shall be created. This creation could help in consolidating its functioning and bring synergy in its operations. It will also help in improving the services to public.

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

The structure of Office should as following:



Presently, the rate of attrition of Examiners in the Patent Office is very high and the things which are commonly heard in the Patent Office are that, there is no proper promotion prospect in place as exists in the other countries Patent Offices such as USPTO, EPO, and JPO etc. or in other Science and Technology Institutes in India. Hence, retaining the trained manpower is the biggest challenge faced by the Patent Office and always suffering from lack/insufficient examiners. Considering the scientific nature of work which is carried by the Patent examiners and Controllers, there should be time bound promotion scheme (or alternatives FCS as in other Govt. scientific Departments and institutes in India) to be implemented and the residential period of five years may be considered at each grade, which will help to retain highly qualified and trained manpower in the office to serve for the

betterment of Patent system. I feel the entry level Grade Pay for the post of Examiner of Patents & Designs would be up-graded to Rs. 6600/- from existing Rs. 5400/- since presently in most of the scientific Institutes the entry level grade pay starts from Rs.6600/-.

Considering the growing importance of patent rights in India and recurring requirement of highly skilled scientific man power, there can be a separate organized service cadre namely “Indian Patent Service”, which was also recommended in the “Report on Revision of Patents Law” by Shri. Justice N. Rajagopala Ayyangar, September 1959. An excerpt from the said report is reproduced as “.... *The examiners recruited on this basis should all be classified as gazetted class I service and may constitute a separate all India service to be named Indian Patents Service (class I) just as in the case of other all India services*”. It is pertinent to note that almost all the recommendations made in the said report were accepted by the Govt. of India.

The 88th Report on “PATENTS AND TRADE MARKS SYSTEMS IN INDIA” submitted by Department related parliamentary standing Committee on Commerce presented to Rajya Sabha on 24th October 2008 has recommended the implementation of Flexible Complementary Scheme (FCS) for promotion of all the Examiners. An excerpt from the said report is reproduced as “2.14 *With the 10th Five Year Plan ending, the posts which were on temporary basis, had to be discontinued, particularly for trademarks. The Department had been able to get approval from the Ministry of Finance that all the Examiners can be treated under the Flexible Complementary Scheme for promotion and appointment as if they are scientific personnel. A fresh set of recruitment rules, which did not require that their recruitment be done by the UPSC, was prepared, which will make it possible to do that departmentally. A recruitment drive will now be started with all these things in position, to fill not only the vacant posts but also for 500 additional posts in the 11th Five Year Plan. It is proposed that five hundred posts of Examiners and 190 posts of Trademarks Examiners be sanctioned. These are against only 56 posts of Trademarks Examiners sanctioned at present. Forty-five of them have been filled and eleven posts*

are vacant. Permission has been sought from the Government that 190 more posts be filled, as the workload has increased". Even after the recommendation in 2008, the said promotion scheme (FCS) has not been implemented and because of that the public is suffering as huge backlog of pending applications piling up.

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 organizations?

Office of Controller of Patents & Designs or Trade Marks Registry should not be made full-fledged autonomous statutory offices; instead these Offices can be given complete administrative and financial autonomy with minor modifications in the rules, which can increase efficiency and gives flexibility in decision making.

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

For providing autonomy in respect of administrative and financial matters no legal changes are required to be made IP laws. However, a notification for granting enhanced administrative and financial powers to the Office of the Controller of Patents & Designs may be required and similar notification for the Office of Registrar of Trademarks & GI may also be required.

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

No. For reorganizing the Office of CGPDTM the amendments of laws in respect of Patents, Designs, Trademarks and GI are required. The said amendments could be substituting the words "The Controller General of Patents, Designs & Trademarks" by words "The Controller of Patents & Designs" in the Patents & Designs Acts and by words "The Registrar of Trademarks & GI" in the Trademarks & GI Acts.

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

The office of the Controller may be strengthened by creating therein different divisions such as:

- **Administrative & Establishment Division,**
- **Finance, Accounts and Budget Division,**
- **Public relation & RTI matters Division,**
- **IT, Automation,**
- **Human Resource & Statistics Division,**
- **Legal Division,**
- **Strategic Planning, Policy Issues and Quality Assurance Division and**
- **Overseas Affairs & WIPO Matters Division.**

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?

The Department should refrain from outsourcing the prior art search from external agencies such as URDIP or other organization because the Examiner mandatorily require to carried out search for anticipation under Section 13 of the Patents Act, 1970. Therefore, the outsourcing the prior art search is a gross violation of the Patents Act and the same has been noted in the findings number of court orders (for example, the recent order No. CS (OS) Nos.1989/2010 & 1993/2010 by Hon'ble High Court of Delhi). The outsourcing will degrade the quality of examination.

8. Is a similar outsourcing (including employment of temporary but qualified personnel) exercise possible in case of trademarks where more than 400000 trademark applications are pending at various stages? If so, what could be the safeguards that should be put in place?

Outsourcing is not the solution and which will degrade the quality of service. Hence, the office has to have full-fledged staff to take up the work. Recruitment should be done regularly.

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

Unlike the present scenario, a single patent application and a request for examination number system for Indian Patent Office irrespective of location of the filing to be adopted so that the subject-wise manpower located at four different locations can effectively be utilized for the examination specialized fields of invention as per the seniority of the request for examination in India. This effort not only will improve the quality of examination in the specialized field but also remove imparity in the seniority of the request of examination at all four locations.

The improvement in the examination system within the framework of the existing legislation has been evident from recent creation of specialized Groups for the examination of patent applications at four locations. Therefore, the above proposed measure will further improve the base of examination of applications within the framework of the existing legislation.

There should be continuous training to the Patent Officials on the legal (case laws) as well as technical aspects which will enable them to give quality service to the public.

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

No need to set up any additional office but there should be e-filing for all the forms and for filing any other documents. However, receiving centers can be opened at every state capital of India.

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 be better for such an institution to be directly controlled by the Ministry or should it continue as one of the offices of CGPDTM?

Yes, it should be continued with the Office of Controller of Patents & Designs because Patent Office requires continuous learning program for the officers and awareness and training for the patent agents and public.

The Patent agents should also be provided a regular training on the current practices of the Patent Office.

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?

The recruitment of the examiners is the biggest problem faced presently and due to that there is huge backlog of pending cases. In spite of huge manpower requirement in the patent office, the recruitment has not been done regularly. Even though the recruitment has been done in the past there is very high attrition rate which created the shortage of man power, consequently increase in pendency and delay in the services. To overcome such long standing problems, as already suggested under Para's 2 and 3 above, if the enhanced administrative and financial autonomy could be granted to the Office of Controller of Patents & Designs the problem of inordinate delay in obtaining administrative as well as financial sanctions for regularly creating and recruiting the required manpower would be avoided/minimized and also if the proper promotion policy in place will retain the trained manpower.

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?

No comment to offer.

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?

No comment to offer.

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 ?

No. Practically, single window concept for different kinds of IPRs is not required and even not possible because the requirements of each IPR law are different.

16. Any other views on the subject.

The patent officials as well as patent agents should be imparted advanced training at national as well as international levels so that they will deliver the best services to public at par with International Standards.

Disclaimer: Comments or Suggestions are my personal and not of Institute where I am presently working.