

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?**

The legislations regulating Patent and Trade mark are different so it would not be unconstitutional or unreasonable to split it into two independent offices in a view to reduce the work load and enhance the efficiency of the administration.

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

The office of Controller General of Patents Design and Trade mark shall split into Controller General of Patents and Design, and Controller General of Trademarks and GI. The registry offices at Delhi, Mumbai, Kolkata and Chennai are already differentiated at this level and shall report to their respective offices of the Controller General which in turn report to the Ministry.

- 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?**

Yes

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

Section 2(b), section 73, of Indian Act, 1970, and every likewise sections whereby the meaning and establishment of the office of the CGPTDM / Controller shares contents similar both for trade marks and patents shall be redrafted and enforced.

- 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, amendments are required.

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

In fact the word “strengthened” herein give the ambiguous meaning as to whether the aforesaid word used for, in terms of powers, or in terms of efficiency of administrations. To the extent if it is germane to power, amendments shall be made in those sections which express the power of controller. So far the efficiency of administration is concerned recruitments on deputation shall be ordinate in an expeditious manner, recruitment of examiner to disburse the work load, efficient mechanisms shall be developed for an efficient prior art search in lesser duration, formats of patent applications shall be amended to filter the infructuous applications *in limine*.

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?

Various funding bodies that promotes research may be considered. The department shall measure due care regarding the quality of landscaping of patents before reporting to the controller. This is very much feasible if the recruitments of examiner for the particular purpose shall be unbiased, and follows strict norms in terms of competency. The department must ensure that none of the provisions of section 35 to 42 of the Indian Patent Act, 1970, shall be contravened by the aforesaid alliance.

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?

Yes, the explanation is very much same as above (issue no 7)

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

- Creations of advanced databases which in turn result into effective search/s for new applications.
- Formats shall be amended upon extensive researches so that the infructuous applications shall be filtered *in limine*.
- Recruitments of efficient and competent examiners shall be made in order to disburse the work load.
- Private agencies (related to IPR experience and practice) may be invited for outsourcing alliances.

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

Yes , this will not only provide extension infrastructure for processing of Intellectual properties but also generate awareness for the word “intellectual property” among the grass root level, if the extension offices shall be located in cities other than metropolitan and developed cities.

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 may be.

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?

Yes. Grounds like work load; efficiency of administration makes it constitutional to address the issue for redressal. No course of action is amicable enough rather than negotiation rounds between appropriate authorities.

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?

Retired judges, administrators, experienced advocates and legal consultants, or any such competent person shall be invited on deputation basis, or vide recruitment whichever be suitable as per the circumstances.

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 comments!

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. If it is demanded for the independent control of different type of IPRs then it sound a bit unreasonable to propose for a single window for those applications even which qualify for different type of IPRs because it shall not be overlooked that different legislations regulates patents and trade marks and this is one of the ground that leads to proposal for independent existence of offices. Now, at the same instant proposal for single window for the aforesaid types of IPRs would lead to overlapping in the processing of the types of Intellectual property as aforesaid even after the Department is set to autonomy.

16. Any other views on the subject.

At this instant it is worthless to discuss the importance of IPR but I would like to place a piece of information that I discovered throughout my four years work experience in techno-legal sector as a self employed. It is a fact beyond any reasonable doubt that IP plays a great role in the development of any Nation. Thus I would like to confine myself more on the issue of lack of manpower in the processing of intellectual property. One of the possible reason for the aforesaid I discovered is lack of detailed education germane to IPR at the very root level, say, bachelor's and Master's in technology and Science. At both these level a student knows something about IPR, but knows very little about the career prospects in IPR. The above discussion paper that raised issue of lack of manpower justify this at its best. If we go a bit further it is revealed that institutes offering training courses for Examination like Patent Agent are countable and majority of them are situated in metropolitan/ developed cities, thus a large number of students from science/ technology background comes to know something about career in IPR after having some professional experience in research organization/ MNC say for 3 or 4 years later. It would not be unreasonable to say that a science/ technology background student do not foresee his career in IPR inasmuch to career in Research or MNC at the instant being as a student due to lack of this awareness. Indeed, since past decade it has been evident that various seminars/ workshop has been organized in the name of awareness in IPR but the important issues herein for consideration is whether it fulfills its very objective of awareness by motivating students to join IPR as a career. Unless and until the budding technologist foresee his/ her career in IPR it is not possible to overcome

the problem of lack of manpower in IP processing and management, and the department has to be dependent for recruitment mainly on deputation basis for the want of experienced manpower. Thus with the increasing pace of globalization it is very much important that the office of CGPTDM shall take initiatives to generate and train the manpower in this sector either in independent capacity or with the alliance with ministries or with any such appropriate authorities.

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The Author Ajitabha Pandey is M.Sc. Biotchnology by qualification, and pursuing law. The author has a four years experience in the techno-legal sector, legal research and drafting as a self employed. Recently the author in view to propagate career awareness in IPR started a batch for classroom coaching for patent agent examination at Gwalior.

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