

**INTERPAT Comments on DIPP Discussion Paper on the Organisational Structure of the Office of the
Controller General of Patents , Designs, Trade Marks and Geographical Indications**

| Q No | | INTERPAT Comment |
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| 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 CGPDTM, is it desirable to establish an independent office for the Trade Marks and GI registry? | We do not see a clear rationale for separating the patent and trademark functions into autonomous units. In most countries cited in the DIPP paper, Patent/Design and Trade Mark/GI services function independently of one another, but are normally organized, as is the situation now in India, under the auspices of a single IP office, in the interests of efficiency, shared costs and resources, and consistency of policies and best practices related to the registration of IP rights. We therefore do not believe that the DIPP has presented a cogent argument for changing this <i>status quo</i> in India by creating two autonomous offices, and, contrary to the assertion in the DIPP paper, we believe that both offices are required to manage both legal and technical issues. |
| 2 | If so, what should be the organizational and reporting structure for each office? | We would welcome a structure which would allow the different functional sections of the office to work independently and more effectively, with staff organised into independent reporting lines and selected for skills which are aligned closely with their individual functions. Examples of independent organisational reporting lines might be the Prior Art Searching, Examination and Opposition Sections. In line with our response to Q1, however, we believe that all of these Sections should report ultimately to the 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 organizations? | We reiterate our position stated in the response to Q1 above that no cogent case has been made for bifurcation of the Patent and Trademark Offices, and that they should remain under the Office of the CGPDTM. We do, however, support making the CGPDTM itself into an autonomous office with a very clear mandate to protect valid IPRs. Such autonomy would allow the office to generate and retain the important revenue from its functions, and, given the surplus of revenue that was generated in 2010-2011, this would allow the office to invest in human resources and information technology systems beyond current levels, to help carry it into the 21 st century. |
| 4 | What legal changes are required? What changes are required to the rules? | No comment |
| 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 comment |
| 6 | How should the office of the Controller be strengthened? | Currently, the CGPDTM is directly responsible for the eleven branch offices of Patents, Trademarks, GI and NIIPM. The Controller General is assisted by one officer of the patent office and has limited support to carry out his administrative functions. We believe that providing more support to CGPDTM is necessary by |

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| | | <p>appointing more qualified personnel to help. For example, consideration could be given to hiring a Commissioner for Patents responsible for the four Patent/Design offices, and a Commissioner for Trade Marks & GI for the six TM/GI offices, who could manage day-to-day issues. The autonomy advocated in our response to Q3 would, in addition, strengthen the Controller's position by minimising or avoiding undue influence by any particular ministry.</p> |
| 7 | <p>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?</p> | <p>As the Office of the CGPDTM has been designated as an International Search Authority / International Preliminary Examination Authority (ISA/IPEA) under the Patent Cooperation Treaty, we support the idea that CGPDTM should tap into WIPO resources as it provides the service of prior art searching for PCT member states. As for the possible pitfalls of outsourcing, and since the Council of Scientific and Industrial Research (CSIR) is an autonomous body constituted by the legislative assembly, then mechanisms need to be put into place to ensure that high standards are set for eligibility of personnel conducting the prior art searches, such as a requirement for a minimum number of years of experience in the relevant field of research. Moreover, mechanisms are needed to ensure that strict confidentiality of information and unpublished patent applications is maintained, and to avoid the influencing of searching personnel by external interests. We also recommend that the Indian Patent Office should consider entering into agreements similar to the Patent Prosecution Highway, to facilitate reliance upon search and examination reports prepared in other countries. This would also contribute to a reduction of pendency to grant and the examination backlog.</p> |
| 8 | <p>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?</p> | <p>We think that an initiative to outsource examination of Trade Mark applications is a possibility. However, we recommend that high standards be set for the selection of temporary personnel. For example, a minimum experience of at least 5 years of practice in the relevant field, or equivalent criteria, should be met.</p> |
| 9 | <p>What other measures can be used to improve the base of examination of applications within the framework of the existing legislation?</p> | <p>It is our understanding that the key challenge with Patent and Trade Mark applications is dealing with the existing backlog and, therefore, the hiring of additional qualified personnel should effectively overcome the major hurdles. Moreover, some actions could be taken to improve the efficiency of communication which could result in a decrease in future backlogs of applications. For example, the examiners could provide more specific and reasoned requests, with proper reference to the relevant Sections or Rules, when issuing Official Actions to Patent Applicants in office actions to enable Applicants to respond more effectively. This practice would also strengthen the skill-sets of the Examiners in reviewing applications in the light of relevant prior art. The presence of different Trade Mark and Patent Offices in different sites has led to non-uniformity of examination reports. This could be corrected by establishing minimum guidelines to be followed by all Trade Mark and Patent offices, and by provision of more training for Examiners</p> |

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| | | regarding the application of laws and rules on a uniform basis. |
| 10 | In spite of e-filing for patents etc. and streamlining of the examination process, is there a need for setting up additional offices? | We would favour the use of available resources for improving and increasing the level of both IT infrastructure and human resources rather than for the establishment of additional offices. In particular, a focus on IT infrastructure, the digitisation of documents, and improved administrative processes would allow users to interact more efficiently, transparently and cost-effectively with the existing offices, reducing the need for additional ones. Such improvements might also encourage the opening of patent attorney firms in locations other than the cities hosting the four Patent Offices, allowing, for example, users in Bangalore to interact as efficiently as those in Chennai, Mumbai, Delhi or Kolkata. |
| 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? | We believe NIIPM should continue as one of the offices of CGPDTM so that any training or awareness programs it runs relating to Intellectual Property Rights (IPRs) are more responsive to the actual needs of IPR users as expressed by the Patent, Design, Trade Mark and GI Offices, and by applicants. CGPDTM would then retain financial and administrative authority under specified mandates to do what is needed to achieve the stated goals of NIIPM. Retaining supervision by CGPDTM would also ensure better alignment of the two bodies, facilitate training plans for NIIPM, and simplify administrative matters. |
| 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 goal should be to get qualified people on board and keep the administrative aspects of the recruitment process as simple as possible. This will allow recruiting managers to focus their energies on things that really matter, i.e. the recruitment and retention of high quality staff with relevant skills and experience. |
| 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? | We believe that both patent registration and trade mark registration have a legal component. With respect to the immediate shortage of Assistant registrars and above, we would suggest that retired Assistant Registrars and Examiners could be called upon to serve on a temporary basis. We would also recommend that practising lawyers could be invited to serve temporarily whilst vacant positions are filled permanently. |
| 14 | Considering the importance of trademarks in India and the fact | We suggest a larger budgetary allocation to enhance and expedite the integration and digitisation of the trade mark database to |

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| | 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? | increase transparency and efficiency. We are not in a position to comment on the appropriate structure. |
| 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? | Whilst a single front-end window for all types of IPR application might be a step too far, we would recommend a single window for Patents and Design applications, and a second window for Trade Marks and GIs, reflecting the related nature of each pairing. Increased digitisation, particularly for Patent and Design applications, would further simplify administrative issues at the front end. |
| 16 | Any other views on the subject. | <p>Transparency of the examination and opposition processes: Patent searching is performed by an Examiner who generates a report for a review by a Controller, who then issues the Examination report to the Applicant. The report generated by the Examiner is not open to the public. Therefore, there is no transparency on the strategies used by the Examiner to generate the report for the Controller. This process needs to be made transparent. In addition, prior to hearing a pre grant and/or post grant opposition, a panel submits its opinion to the Controller. This opinion is not currently open to the applicant or to the opponent, but should be made available to increase transparency of the opposition process.</p> <p>Time periods and resources for oppositions: we recommend that a time period be fixed for the disposal of pre-grant oppositions, as they are causing an inordinate delay in the grant of patents. We recommend a rule requiring that all pre-grant oppositions must be disposed of within 3 months from the time of notice to the applicant; currently, about 8 to 9 months elapse before any hearing is scheduled on a pre- grant opposition. It may also help to have 2 members (controller and examiner, or 2 controllers) hearing all oppositions and, especially, post-grant oppositions.</p> <p>Madrid Protocol: we look forward to notification of the date of implementation of the Madrid Protocol in India, under the provisions of the Trade Marks (Amendment) Act, 2010, as we believe this will provide significant enhancements in trade mark registration procedures.</p> |