

**ISSUES RAISED AND SUGGESTIONS RECEIVED FROM STAKEHOLDERS AND STEPS TAKEN BY THE OFFICE OF CGPDTM
FOR IMPROVEMENT IN PROCESSES IN IPO**

[STAKEHOLDERS' MEETING WITH SIPP ON 7-12-2017 AT DIPP, DELHI]

PATENT OFFICE

Sl.No.	Issues raised and suggestions received from Stakeholders	Response of office of CGPDTM regarding steps taken/being taken for improvement in processes and resolving issues
1.	<p>18 month Publication information may be sent by email: As a part of automation process and public friendly service by the Patent Office, the 18 month publication information service can be automated like FER, Grant, Renewal details are being sent through the email</p>	Published in journal. SMS alert also started
2.	<p>E-mail ID not properly updated in the PO database when there is change in address of service. Email ID of the new agent should replace the email ID of the previous agent. No correspondence should be sent to previous agent e-mail.</p>	<p>Suggestion accepted. Normally appropriate action is taken. However, specific cases remaining may be brought to the notice for action from the office. Database for email IDs is already being maintained and refinement/improvement is done routinely.</p>
3.	<p>Update of email address of the current Agent/Attorney in the system: The IPO should send the communication to the Attorney on record. Also, the portal is allowing the attorneys/ agents to edit the email address. There are cases where the email address has been updated by attorneys for the wrong application. Therefore, update of email ids should be done by the Patent Office IT department so that IPO has a control over it and can avoid several such issues.</p>	
4.	<p>Last Date Reminder services should be sent through email for example: 1. Request for Examination Filing, 2. FER, 3. Renewal Filing, 4. Form 27</p>	SMS alert has been started
5.	<p>Delivery of FER through emails: There are cases where FER has been issued and not sent to the correct email address of the Applicant's agent.</p>	<p>Besides alternatively cross checking the issued FERs and Hearing Letters, IPO has also undertaken re-issuing FERs owing to the error in email or otherwise on the part of IPO. SMS alert also started</p>
6.	<p>It would be appreciated if IPO creates a delivery receipt system or monitoring system that the Attorney on record received the FER.</p>	
7.	<p>Non-receipt of FERs/hearing notices by e-mail continues despite various complaints/follow-ups, due to which the applications have been erroneously abandoned. Substantial time is lost in following up to revive the application.</p>	

8.	<p>Designs: Form 1: Examiners are asking Form-1 and all other documents in hard copies when application is filed online. Representation Sheets: Line diagrams are still not being considered and we are being asked photographic representations which are not available in certain cases. Documents On Record: Sometimes documents are sent by post [like priority documents/responses etc.] which show delivered in tracking databases, but they do not reach respective examiners. There should be Option of online submission of design FER response.</p>	<p>Specific cases should be cited for para 1 & 2. Option of online submission of response to design FERs online has been developed and being implemented..</p>
9.	<p>Disposal: Cases where FER issued and responses filed before 1st January 2017 and no action has been taken needs to be disposed of by March 2018. Everyone can provide the Patent office with such list. Some very old cases have not been disposed as files are lost or not digitized.</p>	<p>Old cases already taken up for disposal on priority.</p>
10.	<p>Disposal of old cases is a challenge and the Patent office should create a mechanism to dispose of old cases at the earliest.</p>	
11.	<p>Erroneous abandonment letters have been issued: Abandonment letters under Section 21 received even when FER not received or Hearing Notices not received. Received duplicate examination reports , although never received the original examination report.</p>	<p>The suggestion would be worked upon and suitable provision shall be made. Specific cases bearing problem may be reported for resolution and further improvement.</p>
12.	<p>Abandonment letter should not be issued without a prior show cause notice to the applicant/agent.</p>	<p>No such requirement under law. Corrective action is taken in cases if wrong abandonment letter is issued.</p>
13.	<p>There should be some procedure for escalation of matters which remain pending at the patent office's end. For example after hearing and written submission, matters still remain pending, in many cases for years together.</p>	<p>Escalation may not be of much help as disposal depends on number of amended cases with each controller.</p>
14.	<p>In many instances, there is an undue delay of more than a year or even more than a couple of years in issuance of decision, even if hearing has been conducted. Some timeline should be set for issuance of decision after the hearing is conducted, and written submissions are filed.</p>	<p>Suggestion agreed. Necessary action to expedite timely disposal is being taken up on priority.</p>
15.	<p>Hard Copies of documents: Subsequent to filing of soft copies of POA, Proof of Right, Assignment, Priority Document via e- filing, the front office of Patent Office often refuses to accept original documents with the oral comments that soft copies have not been uploaded on PO module. However, subsequently, when screen shots of uploaded documents are shown to get hard copies accepted, the prescribed 15 days' time limit is over and petitions are called for. Rectify the module so that Front Office can view uploaded documents instantly. Front office should accept original documents when CBR is provided as proof of uploading the documents.</p>	<p>Provision to view file wrapper is already available in Patent Office intranet module. Necessary corrective action is being taken to ensure acceptance of original documents at Front Office</p>

16.	In case of uploaded patent documents, select multiple document option to be provided so that multiple documents can be downloaded simultaneously.	Provision to download multiple documents of an application is under development.
17.	Limitation in the size of uploaded documents : Increase the upload size or provide provision to upload Zip files.	Upload size has been increased to 30 MB with effect from Dec. 2017
18.	National Phase Application : At the time of entering into India, if a minor error has occurred while typing the PCT Application number in e-filing module, even though all the Forms and documents relate to correct PCT Application number, it is not possible to correct the PCT number. Provision should be made to correct an obvious error in the PCT Application number based on the documents uploaded at the time of e-filing.	Provision to correct obvious errors is available under section 78(2) (through E-filing Form 30-Entry No. 37 in the first Schedule).
19.	Uploading of Sequence listing in text format: Separate provision can be provided for this purpose.	Provision is already present in e-filing along with uploading of Complete Specification/Forms
20.	Unable to upload general letters during prosecution . Include option to file "General letter" at least during examination stage of the application (for Reminder to disposal, Correction in Patent Certificate etc.)	E-filing portal provides for submission of forms, fees and other documents that are prescribed in Patent Rules. Documents that do not bear any particular head under the Patent Rules cause problems in the work-flow. Therefore, they may be communicated to Patent Office as general email communication.
21.	The website link provided to verify the PCT application number should directly take the applicant to the WIPO webpage of the application	Provision already present in e-filing
22.	Aadhar- based e-filing system may be introduced.	In process
23.	Alternative to e-filing on unavoidable circumstances : There could be alternative options for physical filing of documents in unavoidable circumstances such as internet connectivity, power failure, e-portal issues on uploading etc. Or there could be some remedy for filing documents late in such unavoidable circumstances.	Alternate remedy always provided in such circumstances, if brought to the notice with sufficient evidence for the same.
24.	Preparation and Uploading of Form 1 : In case of national phase applications, we understand that all the information is taken from PCT application (WIPO). However, still, we are required to prepare Form 1 and upload it. Similarly, for ordinary applications, apart from filling in the information on online module, a prepared Form 1 is to be uploaded. Unless such form is not uploaded, the application cannot be filed. Earlier, such uploading of Form 1 was not mandatory. This may be seen as duplication of work. Either we should be required to fill in the details online, or just upload the prepared forms. Please suggest.	One of the objectives of e-filing is to eliminate human intervention at least on the part of documents being filed by applicant. The documents that are submitted online need textual as well as Image/PDF data which requires the e-filer to submit data in both forms. However, efforts will be made to reduce duplication to larger extent.

25.	Biotech inventions: Please issue clear guidelines setting out examples regarding the subject matter not patentable under Section 3, so that there is no ambiguity and that there is a uniform practice throughout IPO.	Guidelines already available in IPO website
26.	All NPL, non-English citations and Paid citations should be provided by the patent office along with the examination report.	Copy right issues are involved in downloads; therefore only reference is given
27.	Stricter interpretation of patentability standards:- We urge to adopt stricter examination while scrutinizing the patentability standards and reject un-deserving patent applications on essential vaccines.	Examiner and Controller, who decide and Interpret patentability of an invention within the framework of Patents Act and Rules, are competent for the purpose.
28.	Controller contact details: Controller email id and contact number should be included in FER, SER and Hearing Notice.	Email IDs of all Controllers in Patent Office have been updated on the website (under“ Contact Us”)
29.	Names of Examiner and Controller should be provided on the website once the examination starts and whenever there is a change in the Controller.	
30.	Section 8 information- Cases during prosecution are rejected on Section 8 despite compliance during the pendency of the application. In case the there is a delay in filing Form 3 or status, 99. 5 % of the Controllers exercise their discretion always in favour of the application and allow petitions filed under the provisions of the Indian Patents Act. Despite the Courts having watered down this provision EVEN AFTER GRANT OF A PATENT, it is disappointing to see cases rejected during pendency of the application and petitions being disallowed.	Specific cases need to be highlighted
31.	Section 8 (2): "Controllers are aware of the prosecution history of other countries. In addition, IPO has signed agreement to access WIPO CASE. But still few Controllers ask in FER, Section 8(2) details of “all foreign countries” or “USA, EPO, JPO and other major patent offices. "If a Controller requires documents under Section 8(2), he should specify the name of the country instead of using “all countries” or “major patent offices”.	It is requirement of law on the part of applicant.
32.	Filing of Reply to the First Examination Report (FER). Problem: Once Reply to the Examination report is filed by the applicant, 2 nd or further chances are not available to him to file Modified Reply within the permitted period of 6 months (i.e. Last Date). Section 21 limits the time period (within six months) to put the application in order for grant to the satisfaction of Controller (Section 15), but section 21 does not bar to file a reply only once. To put the application in order of grant means applicant have liberty to file further reply	If the suggestion is accepted, the system cannot show the receipt of reply till the statutory period is over and processing all applications, including expedited examination cases, will get unnecessarily delayed. After filing a reply to FER within the prescribed time, an applicant can meet outstanding

	<p>to the Examination report within six month period.</p> <p>Reasons for again filing reply to the FER within 6 months by the applicant:</p> <p>If the corresponding Patent granted in USA, EPO or other major countries, the applicant wish to amend the claims on the line of granted claims with reasoning's submitted at the EPO, USPTO for novelty and inventive steps.</p> <p>Sometime applicant approach Attorney or change of different Attorney, the modified reply to FER need to be filed by newly appointed Attorney.</p> <p>Applicant have liberty to amend the specification any time before the grant under section 59 to meet the office objection.</p>	<p>objections during the hearing proceeding, as hearing is always offered by the Patent Office along with issuance of FER .</p> <p>During the hearing procedure, along with amendments/ submissions to meet outstanding objections as stated in the hearing notice, the amendments desired under the circumstances cited here can be submitted as voluntary amendments for controller's consideration.</p>
33.	<p>Uniformity of Patent Examination: Steps need to be taken to have uniform examination system in all the branches of the patent offices and within the branches.</p> <p>Clarity on "Non-Patentable" Objections in Examination Reports:</p> <p>There is no uniformity in the approach of raising objection under Section 3 and Section 4 of the Patents Act, 1970 among the branch offices. The objections are raised without reasoning.</p> <p>Mere repetition of objections in FER /Hearing Notices:</p> <p>Objections have been repeated without considering any claim amendments filed by the applicant at the time of filing in India. Further, objections raised in the Examination Reports are repeated in the Hearing notices. In most of the cases, objections of Examination Reports are rendered moot due to claim amendments; still objections are maintained in the hearing notices.</p>	<p>Guidelines for examination already provided. Quasi-judicial authorities apply mind and interpret/decide cases based on available documents on record within law.</p>
34.	<p>Format of Examination Reports:</p> <p>The Examination Reports can be modified to include only the objections, which are required to be attended to by the Applicant. The parts of the Examination Reports that are "Not Applicable" can be removed for clarity of the reports.</p>	<p>Already done.</p>
35.	<p>In Expedited Examination, despite reply to FERs, no actions taken by Patent Office. Hearing of amended cases, following examination of expedited cases, has not been provided by module</p>	<p>Further processing of expedited cases taken after receipt of reply to FER on priority as per rule 24(c)</p>
36.	<p>Currently, provision of Expedited examination can be utilized only by Indian applicants. Provision should be made so that even foreign applicant can be benefited by expedited examination.</p>	<p>Applicants, irrespective of country of origin, are eligible under rule 24 (C)</p>
37.	<p>In cases where the technology underlining a patent application is vulnerable to infringement or under process for licensing, there is requirement for expedited examination of the application</p>	<p>Expedited examination available under rule 24 (C)</p>

38.	Fee for Certified Documents : If we seek a certified copy of the complete file documents of a patent, what would be the fee 1. 5000 + 150 for each page in excess of 30, or 2. 5000 for each document, like 5000 for each Form 27 + 5000 for specification as filed + 5000 for Form 18 as filed + 5000 for FER + 5000 for Reply to FER, etc.	Fee is as per first Schedule, which has clear provisions in this regard.
39.	Where the Provisional Specification comprises of more than 30 pages, the applicant has to pay additional fees for those additional pages. subsequent to it when the complete specification is filed comprising more than 30 pages the applicant has to again pay for additional pages. In such a situation the applicant should be allowed to pay only for the pages which exceed the number of pages already paid for at the time of filling the provisional application.	Provisional specification (PS) and Complete specification (CS) are two separate documents and cannot replace each other or CS is not merely an extension of PS. Filing of PS and Cs is complete only when filed with payment of the prescribed fees.
40.	Undue financial burden in accessing information: Consider requests from persons applying for information from NGO as natural person and accordingly charge nominal fees.	Fees are prescribed for natural person , MSME, startups and legal entity in the first schedule.
41.	Form 30- No provision in Form 30 for uploading correspondence of general nature. Prescribe a format for the manner in which miscellaneous correspondence/documents need to be uploaded so that they appear in a similar fashion on the website. <reminder, additional evidence>	Form 30 has already been categorized. However, a guide will be issued to help applicants/agents to channelize the documents through Form 30.
42.	Drop down list for activities/documents to be uploaded under Form 30 as provided by IPO is not exhaustive. There are still many activities that are not covered by the specific heads fixed by the IPO. An open option should be provided for miscellaneous activity not covered by the list.	Categorization of Form 30 has been done to eliminate pure miscellaneous entries that are difficult to track / channelize otherwise. All efforts have been done to accommodate submission of documents/fees enlisted under Patents Rules. Any specific entry/provision under the ambit of Patent Rules may be brought to the notice.
43.	Inconvenience and communication gap during online hearing:- Online hearings are sometimes not smooth due to interruption or slow speed of the internet. There should be an interface where the applicant can indicate the portion of claim or specification that could help the Controller to understand applicant's point clearly during hearing.	The suggestion is not very clear as the option of personal hearing is always available with the applicant
44.	Since Hearing notices are being issued for long pending cases , applicants need time for preparation to attend the hearing at IPO, Therefore at least one month notice may be given in advance for hearing and one month time may be given for filing written submission.	Directions already issued in this regard.

45.	<p>Adjournments: Even though a request for adjournment is filed with a specific request to adjourn the hearing at least for 3 weeks, Controller adjourns only for 7 to 10 days. "As the rule provides adjournment by 30 days, Controllers may be requested to adjourn at least by 20 days. It is also requested to intimate the new date within 3 days from the date of request."</p>	Timelines are well-defined. However, specific problem, if any, should be stated.
46.	In case of contested matters, the hearing should be appointed in original jurisdiction .	Place of hearing has been clarified through administrative directions.
47.	<p>Time lag between the submission of FER and the issuance of the Hearing notice still is not fixed and has to be worked out to avoid long waiting period for the decision of the cases.</p>	It depends on number of amended cases with each controller
48.	<p>In case of applications with joint applicants, it sometimes become difficult to file executed Form 26 within the statutory time limit of 3 months of filing of the application. The time limit to file form 26 may be extended to 12 months.</p>	Increased time limit will only delay the process
49.	Filing of complete specification after provisional in module is not complete.	Implemented.
50.	Priority details : When an Application claims more than one priority, only the earliest priority details is displayed in AFR and Publication.	Suggestion to include all priorities is accepted. There is a size restriction in journal. However, in application details and file wrapper, all priorities are displayed.
51.	<p>When the biological resources are taken from India:</p> <p>With regard to the issue of mentioning the source and geographical origin of Bio-resources in the complete specification and requirement of NBA permission, when said biological resources are taken from India:</p> <p>A clear guideline is requested on whether the bio-resources can be said to be exempted from permission requirements from NBA when it is sourced as a packaged product and hence value added (such as packaged oils including castor oil, palm oil and when the oil cannot be traced back to its original form such kernel of the seeds/pulp etc. from where it is obtained and hence in indistinguishable form as it cannot be related to its natural counterpart), waste material of any kind including household waste or procured from industries).</p>	Guidelines already issued
52.	<p>Guidelines on NBA linkage to Patent Applications :</p> <p>There are inconsistencies regarding NBA issues within the IPOs and the branch offices leading to uncertainty and unnecessary delay in granting the patents. IPO can work with NBA with respect to timelines on issuing permission to file patent applications to reduce the delay in obtaining the grant of a patent.</p>	

53.	<p>NBA Requirement</p> <p>In some cases, agents have been asked to seek clarification from NBA, on whether permission is required from NBA or not in the specific application.</p> <p>It is suggested that Patent Office may co-ordinate with NBA for such clarifications, and specific training be imparted to Examiners to resolve such issues during examination stage, instead of raising such issues during hearing stage.</p>	<p>Examiners/Controllers are well-trained in examination of applications pertaining to cases where permission from NBA is required. Guidelines have already been issued in this regard. However, any specific case can be brought to notice.</p>
54.	<p>"No uniformity in the mode as well as in the format of the Notice issued under Rule 55 (3) about the pre-grant opposition. it is important to follow a standard practice and format. Notice under Rule 55(3) should not be combined with FER.</p>	<p>Suggestion to implement standard practice and format is accepted. Module for Pre/Post Grant Oppositions is already under development.</p>
55.	<p>Opposition matters: It is very difficult to track/view opposition, if any, filed against any patent/patent application. Pre-grant oppositions remain unserved on the applicants for years. A separate listing option for oppositions documents should be made and the status of the patent/patent application should indicate if an opposition is presently pending.</p>	<p>Development of Modules for Pre/Post grant oppositions is underway.</p>
56.	<p>Form-16 changes not reflected in module (i.e. online patent register).</p>	<p>Already reflected on E-register.</p>
57.	<p>Form 6: At the time of filing Form 6, we cannot file fresh Forms in the name of claimant. Provisions can be made under Form 6 to upload fresh Forms in the name of claimant.</p>	<p>As per rules, fresh form can be filed only after acceptance of form-6. Necessary action taken to clear pendency in processing of Form-6.</p>
58.	<p>Record in module is not updated after Post-dating of applications</p>	<p>Post-dating module has been revamped to overcome the said problem.</p>
59.	<p>There is some confusion in Requesting Certified Copies or Patent Status for the third party applications, in choosing Applicant Status, i.e. Requester status or a Patent applicant status?</p>	<p>It is Requester's status.</p>
60.	<p>Patent Office could issue guidelines for the documentary proof that can be accepted to claim, 'Small Entity', particularly for foreign applicants.</p>	<p>Defined in the Rules. Any specific instance should be brought to notice.</p>
61.	<p>A circular may please be issued so that all the Controllers accept a sworn affidavit by the claimant as sufficient supporting document to claim MSME status under Patents Rules.</p>	
62.	<p>A circular can be issued clarifying the prescribed time limit for filing various documents/ information to avoid unnecessary confusion.</p>	<p>Timelines are well-defined. However, specific problem, if any, be brought to notice, so that the same can be resolved.</p>
63.	<p>Recordal of change of name /address for services/transfer of rights are not being updated promptly causing inconvenience to Applicants and unnecessary delay in case of licensing/technology transfer etc.</p>	<p>Already expedited and pendency under clearance.</p>

64.	If PCT Application is not published, we are not able to take any action for the national phase application filed in India.	Request for early publication of PCT Application shall be made to WIPO IB under article 21(2) (b) to achieve this.
65.	Display of PCT Application Number in important documents: "PCT Application number can be displayed in status screen and in FER"	Suggestion accepted. International PCT application number shall be made available in FER.
66.	Refund: Even after receiving the message "payment success", we get refund after couple of days due to some error. Any payment error should be resolved on the same day including the intimation of refund.	This is an issue between the bank and the applicant. Each bank conducts a reconciliation of transactions at their own scheduled time period and, thereafter, they make refund of unsuccessful transactions.
67.	Introduce Renewal fee system form 3rd year onwards irrespective of the Applications is Granted or under Examination or yet to be Examined like in Europe.	Legal provisions do not permit this.
68.	The Patent Act provides an opportunity to the applicant to add inventor(s) if required at the time of filing Complete Specification and a statement signed by the additional inventor(s) has to be provided in Form 5. As per present practice, such a change in the list of inventors requires filing of form 13 along with fresh application form 1. Since the Patent Act provides opportunity to the applicant to add inventor(s) if required at this stage, no form 13 should be required.	Since Application (Form 1) is amended under section 57 of the Act, Form 13 is required.
69.	Cognate applications- In case of cognate applications, patent office module is abandoning the first filed provisional application and updating the records in the last filed application. This is incorrect in accordance with section 9(2) of the Act. Needs to be corrected.	Issue is being reviewed and the same shall be rectified if discrepancy is found.
70.	During patent prosecution, can an applicant go back & forth with respect to scope of claims? What I mean is, during prosecution, can an applicant narrow down the scope and subsequently again broaden the scope? If this is allowed, one can file opposition based on which set of claims?	During prosecution of an application, an applicant can submit voluntary amendments to the claims- (a) in a reply to FER, (b) in the written submission against hearing notice issued for outstanding objections and (c) during hearing proceeding before the controller. However, voluntary amendments are subject to approval by the controller. Pre- grant Opposition can be filed against the claims published under section 11(A) (originally filed as well as subsequently amended). A copy

		of amendments/ amended claims filed before/during the hearing proceedings, shall be necessarily given to the opponent.
71.	If a patent applicant wrongfully amends claims, what is the remedy? There is no ground available u/S. 25(1) or 25(2) for pre- or post-grant opposition for taking objection as to wrongful amendment of claims.	Any amendment to the claims published under section 11 (A) shall be shared/made available to the opponent during pre/post-grant opposition proceedings and, hence, the words, “Wrongful amendment of claims” have no meaning.
72.	Errors need to be rectified in publication of patent applications	Publication correction option being provided in Form 30 as drop- down menu.
73.	There has been a lot of delay in publication of patent applications.	As seen from the following table, applications published during 2016-17 were 86766 against annual average of about 32000 for 2012-13 to 2015-16. 2012-13 2013-14 2014-15 2015-16 2016-2017 26,159 31,413 26,934 44,068 86,766 This year 32100 applications have been published up to Nov. 2017. As of now, about 1800 applications (matured RQs) are awaiting publication and the same will be completed this month.
74.	Digital Family Patent option for Indian Patent Applications.	InPASS caters to the database of Indian Patent applications only. Therefore, It is currently restricted to provide information of Indian Patents, rather than Patent family from different Patent offices.
75.	The file wrapper available on the website can be improved by chronological upload of documents and uniform and classified nomenclature of the documents. We expect the file wrapper to be like EPO/USPTO that is user friendly.	Provision to view file wrapper is already available in Patent Office intranet module. Necessary corrective action is being taken to ensure acceptance of original documents at Front Office.
76.	Email Communication to be linked to file wrapper:	Public Private Pair needs to be implemented.

	Significant communication with the agent should be effected through email and all email communications with the Patent Office should form a part of the file wrapper. The Patent Office, should accept email communication for correspondence. Email Communication to be linked to file wrapper:	Under consideration
77.	Indexing of patent documents need to be provided	Entire bibliographic contents of Patent applications is now indexed and efforts are on to further improve the display of applications.
78.	Since the Controller/Registrars orders are the orders from quasi-judicial authority, these orders to be made available date-wise on IPO website.	Controllers' decisions are displayed according to the dates, as required
79.	Search of Controller decisions: Current search options are limited, not user friendly and lead to a cumbersome search. It is not possible to search the controller's decisions on the basis of the names of the controllers and technology area. Do a proper classification of orders according to technology domain; section and key rejections like in a Court order (synopsis)	New version/interface is under consideration
80.	IPO search facility: The features of this search facility have been constrained and utility has been narrowed in the recent years. Currently broad details from 'invention title' up to 'abstract' are in one frame. Complete specifications are extracted from what seems to be a different table in the second frame. Third window displays the rest of the 'details'. We cannot navigate to even next record from this display. This feature introduced in the recent years has made the search function of the patent database primitive. This new version has made download of the records for any offline analysis impossible. Many research analysis would need download patent records to understand innovation trends and such features in the national context. Captcha Code requirement for every search introduced seem to reflect a 'siege mentality'. Please modify your interface to facilitate record download for creating off load database of Indian patents. This would offset the load on IPO server, among other things. We have moved from what seemed to be an OK version of search to a 'bad' one, as we changed from previous search interface. Can we please get back to the previous version of the search, where the details appeared on the click for details?	Differences in the display/features/ procedures have been noticed in current and previous versions of INPASS due to technical issues involved in Indexing of Database. However, the suggestion/feedbacks from stakeholders have been taken and compiled to resolve the reported issues. The work on the same has been started for resolution.

81.	Journal publication page not readily available when Search is done. Revert to previously available option, where journal publication page was visible when search was made in InPASS module; essential to cross check various details of the application, including number of claims etc.	Journal number is available as publication number in InPASS
82.	Non-availability of records of old patents/applications on the IPO website. In many instances, the application/patent number does not exist on the portal and thus, online actions cannot be taken in such cases for e.g. Requests for certified copies, photocopies, inspection of register etc.	The InPASS is being worked upon to address various issues and shall be made available upon completion of development.
83.	Unavailability of complete set of patent documents in InPASS database: The uploaded documents are incomplete, in particular the form 2 documents (complete specifications) are mostly unavailable. At times documents which are available initially, are later deleted by the patent office from the website. Transparent and accessible InPASS with access to complete set of documents including specifications is recommended.	
84.	Under Dynamic Utilities , RQ status of issued FERs and Stock & flow of Patents should be reinstated.	
85.	Patent Office website not user friendly & Inefficient. For downloading file wrapper, have to go to application status. Patent Office website not user friendly & Inefficient. For downloading file wrapper, have to go to application status. There should be an option to download the complete file wrapper in ONE-GO as in EP. Currently, one has to click each link.	The suggestion is already being worked upon and shall be available upon completion of testing.
86.	Hearing via Videoconferencing can be allowed to Applicant/Agent from their location.	Suggestions noted and technical parameters are being studied to upgrade the existing videoconferencing facility. New Video Conferencing facility should resolve the problems.
87.	With the FERs and Hearings issued by a patent office where the application was not filed, to attend the hearing the Attorney/Agent has to travel to the concerned patent office. This involves time and money for the attorney to attend the hearing. Skype calls and other ways of conference calls can be allowed to work efficiently.	
88.	A telephonic hearing or hearing through a video-conference need to be made a RULE and not an exception irrespective where the application is filed or where the controller is based.	
89.	Sometimes, the video conference facility is not well equipped between certain patent offices. For. e.g., between Delhi and Chennai. Also, it would be very convenient for both, the Controllers and the Agents, if the video-conference facility can be provided on the respective desktops.	

90.	<p>Non-responsiveness of the Patent Office: There is no response of enquiries made by the applicant which is extremely frustrating.</p> <p>A helpdesk email should be created and all correspondence in relation to status, name of Controller/examiner, post refiling status; post hearing status; Form 6 etc can be directed to the helpdesk and then a response can be generated and sent from the helpdesk</p>	Helpdesk email is already functional (IPO-helpdesk). Suggestions are welcome to improve the Helpdesk services.
91.	<p>Hindi version: Our request is to include a clause in patent rules so that publication of patent document shall be in Hindi also.</p>	Will be taken up in due course
92.	<p>Patent/Patent Application status linkup to the Patent Search : Serial Numbers for the listed Applications, view documents (as previous) should be introduced in patent search.</p>	Suggestion noted and will be worked upon
93.	<p>Single path for Application Status and Patent e-Register if the patent is Granted (As Previous)</p>	Suggestion noted and will be worked upon
94.	<p>Single Captcha Code for moving into Patent e-Register/Application Status instead of every time.</p>	Suggestion noted and will be worked upon
95.	<p>Application Status when RQ not Filed: Status of the Application showing as “Application Published” for which Request for Examination not filed within the due time. Actual Status of the Applications would be “Deemed to be Withdrawn .</p>	Suggestion accepted; correction being done.
96.	<p>Uploading PCT translation:</p> <p>Currently no place for uploading PCT translation is found in the e-filing module. The same may please be included.</p>	Suggestion noted and shall be worked upon
97.	<p>There is no option of submitting the sequence listing in text format in the online module, at a later stage during the prosecution (after filing response to FER) , e.g., during the hearing.</p>	Suggestion noted and shall be worked upon
98.	<p>Filing of Responses/ documents:</p> <p>After uploading the documents for filing response, usually we check the uploaded documents before submission. During checking, if we find any document uploaded wrongly we cannot delete it from this page, since in this page only “View Content” option is available. In that case we have to go to home page and then we have to discard the full entry and upload it again.</p> <p>It is suggested that if any delete or discard option can be inserted in this page for each and every entry it would be helpful. Further an option of uploading the correct document may be provided.</p>	Suggestion noted and shall be worked upon
99.	<p>E-filing of Annual Working Statements Under Patents Act 1970:</p> <p>Working requirements of Chapter XVI of the Patents Act, 1970 are satisfied in ways not contemplated by the Current FORM- 27. It is accordingly respectfully prayed that Current FORM- 27 be suitably amended to enable Applicant to specify the working information, as applicable to their business context.</p> <p>We have observed recently that FORM-30 has been redesigned and does not permit FORM-27 to</p>	Will be looked into within the framework of the Act and Rules .

	<p>be uploaded in scanned format.</p> <p>One suggestion is to permit scanned copy of FORM-27 to be submitted (either by itself or in conjunction with FORM-30 as in 2017 January-March). Another suggestion is to add a new field, which permits the patentee the flexibility to explain in free-text format their basis for assertion of having met working requirements. When the basis is other than manufacturing or importing, the patentee should be able to explain that basis in this new suggested field.</p>	
100.	C.B.R receipt issued on filing of a patent application should also provide the details of enclosures filed with the application.	Suggestions accepted and being worked upon
101.	A separate tab for hearing notices or a drop list on the 'View Examination Reports' tab will help access the notices easily instead of searching the notice in the file wrapper.	Will be considered
102.	It is requested to provide Cause list of all the four offices	Will be considered
103.	<p>Setting some timeline for issuance of decision after hearing:</p> <p>It is recommended that some timeline be set for issuance of decision after the hearing is conducted, and written submissions have been filed.</p> <p>In many instances, we see an undue delay of more than a year, or even more than a couple of years in issuance of decision, even if the hearing has been conducted.</p>	Suggestion agreed. Necessary action to expedite timely disposal is being taken up on priority.
104.	A separate tab for hearing notices or a drop list on the 'View Examination Reports' tab will help access the notices easily instead of searching the notice in the file wrapper.	Will be considered
105.	It is requested to provide Cause list of all the four offices	Will be considered
106.	E-register should be updated particularly for old cases to enable smooth renewal process.	Suggestion is welcome.
107.	Patent Certificate should be accompanied with the granted specification including claims or at least the granted claims.	Suggestion is welcome; will be worked upon
108.	<p>Intention of grant with the allowed text of the claim should be forwarded to the Applicant and give a 15 days window period for the grant to happen. This will facilitate:</p> <p>a) verification of the claims and correct any errors that might have arisen;</p> <p>b) To file one or more divisional applications before grant; and</p> <p>c) To file updated information in relation to Section 8.</p>	Not practical as of now. Can be thought of in future
109.	Unity of invention: All claims should be examined irrespective of the objection of lack of unity, in view of the fact that the applicant has paid fee for all the claims. In case patent office chooses not to examine all the claims, then the fee for unexamined claims should be refunded	Suggestion will be considered for administrative directions
110.	Divisional applications: There is an increasing trend at the Patent Office of not granting the divisional application (subject to compliance of Section 16) where the parent application is rejected, abandoned or withdrawn.	Specific cases shall be mentioned

111.	Renewal certificates should be made available in downloadable form like patent documents.	Suggestion noted and shall be worked upon
112.	Reintroduce the availability of HTML version of the specification .	Suggestion accepted. Display in HTML shall be made available.
113.	There is a need of listing the documents in order of the uploading / date wise in the order of prosecution to understand the exact status of the Patent / Patent Application which will be helpful in long run of the functioning. (if possible, by separating date and name of the document uploaded in the prosecution history).	The suggestion is welcome and the technical solution for the same will be developed
114.	INN (International Non-Proprietary Names) in pharmaceutical patent applications:- The applications are worded in a language which is highly technical which makes it almost impossible to ascertain which chemical compound is being referred to in a said patent application. We recommend improving the transparency of the Indian patent system by introducing a mandatory requirement that all patent applications (particularly their title and abstracts) related to pharmaceuticals should include the disclosure of the INN or INNs.	Suggestion noted.
115.	Patentability of inventions relating to atomic energy Given the nature of the provision and lack of right to appeal the question arises as to what inventions qualify as non-patentable under the Act. How much atomic energy or radioactive substance would trigger this provision? Was the intention of the legislature to ensure security and prosper research or something more ? The Patent Office refers a case to DAE without assigning any reason or without reviewing the subject matter of the application. There is no mechanism to ensure that the inventor/applicant is given a chance to defend his stance. A notice period of 15 to 30 days is proposed before the reference to the Atomic energy Board so as to give the applicant a chance to defend their case.	Controller/examiner is the competent authority to decide. The office coordinates and communicates with the Department of Atomic Energy (DAE) on regular basis to review difficulties
116.	Examination of Atomic Energy related Inventions: Even if the inventions do not relate to atomic energy, only because the application refers to some specific elements (like Thorium), the applications are being referred to DAE by Patent Office. Further, despite clearance from DAE of certain inventions, like catalyst system utilizing Thorium, similar types of inventions (catalysts) are repeatedly being referred to DAE. Also, most of the times, such applications are being referred at the time of examination, or sometimes, even during the hearing stage, which unnecessarily delays the prosecution. If such screening is to be done, it should be done well before the issuance of examination report, or even before the publication of the application. It is also recommended that some guidelines are issued in this respect.	

TRADE MARKS

Sl.No.	Issues raised and suggestions received from Stakeholders	Response of office of CGPDTM regarding steps taken/being taken for improvement in processes and resolving issues.
1	<p>Doing away with the requirement to apply for grounds of refusal of a mark by passing speaking orders (Under the current practice only the fact that a mark is disallowed is communicated and the applicant has to apply for the grounds for refusal. There is no time period prescribed for the communication of the grounds and in many instances repeated correspondence in this regard is simply unanswered. This practice needs to be urgently changed as natural justice necessitates that the ground for refusal of a mark be communicated as a matter of course to the Applicant.)</p>	<p>Suggestion is good. We will ensure that all refusal orders are uploaded in electronic register and also send to the applicant as well.</p>
2	<p>Reducing avoidable re-advertisement of marks: (In case any request for amendment in a pending application is filed before advertisement, such requests should be disposed of before the mark is advertised. Failure to dispose of such requests leads to two rounds of advertisements in several instances. Certainly, if any amendments are made post advertisement, then the application should be re-advertised.)</p>	<p>Normally, re-advertisement is done when amendment request is filed after the advertisement. Provision is already made not to proceed for publication if any amendment request is pending.</p>
3	<p>Statement as to use of the mark in IR: Till date no provision has been made for inserting user claim in IR which contradicts the Guidelines for functioning under Madrid Protocol, which state that every publication of IR shall contain inter alia following particulars: "Statement as to use of the trademark in India"</p>	<p>Form provided by the WIPO for International registrations under Madrid System does not mention about use of the trademark. Record management of IR application is done by WIPO only. In case the International registrations under Madrid System is notified to India for ensuring protection of the trademark and the mark is treated as proposed to be used in India. In case, an applicant claims prior use in India prior to the international registration, he will have to file form TM-M along with evidence.</p>
4	<p>Capturing proceedings before hearing officer in writing</p>	<p>As part of the quasi- judicial processing, a party</p>

	(Often there are several requirements communicated during hearings in relation to a mark (such as disclaimers etc.) which do not have a basis in law. As there is no practice of authentically capturing the proceedings or recording the hearing officer's requirements in writing, the Applicant does not get an opportunity to submit its response in writing leading to repeated hearings being fixed.)	can always submit written submission for hearing and the same will be uploaded in e-register.
5	Opportunity should be given to applicant to revive abandoned application	Statutory provision is prescribed. No provision is provided for reconsideration on late fee.
6	Corrections of wrong entries such as date of filing, validity, names, list of goods: -- No proper procedure.	Processing of TM-M is clearly defined. If any specific instance exists, the same may be brought to notice.
7	Limit of 5 MB for upload creates difficulty, particularly for filing evidence. Request for enhancement of the upload limit.	For smooth functioning of the system, such limit is prescribed.
8	As a precautionary measure, the Office should consider publishing lists of applications examined and appointed for hearings on a weekly basis in the Trademarks Journal so that applicants can crosscheck their matters;	A dedicated space is provided for the purpose and checking / cross checking may be done from there also.
9	The Office should look into improving the general soundness of official objections that are issued by trademark examiners in the first instance. An improvement on this front will lead to fewer objections/oppositions and thus, decreased backlogs;	The Office has already standardized the processing. Specific suggestions may be brought to notice.
10	The requirement of examination report and its objections under section 9 & 11 are not required when there is an "user affidavit" filed (section 9 & 12) According to the above provisions under the Act, if any applicant shows that he is using the mark, or well- known mark or honest concurrent user, then the registration of the mark shall not be objected.	Requirement of user affidavit is made to support your claim, but acceptance of the mark is subject to provisions of the Trade Marks Act only.
11	Registration and Renewal: Often, no notification of registration is sent to the applicant/ agent and in many cases registrations are notified in the Trade Marks Journal after the actual due date (after 10 years). Applicants/ Agents are not given the time of 6 months from the sealing date to renew the mark and are instead expected to pay a surcharge which is contrary to Rule 58(2).	Registration certificate is sent to the email ID provided, and simultaneously uploaded in the TM system. The System itself provides six months' time to renew the mark, if registered after the due date. If any specific instance exists, the same may be provided for verification.

12	<p>Trademark Filing. Association Trademark of same proprietor filed in same class has not been defined in Trademark Amendment Rule, 2017.</p>	<p>Concept of association fee is deleted but association condition may be imposed, if decided by the registrar.</p>
13	<p>Errors in Form TM-M/ TM-P (If there is an error in the form used by an agent seeking to come on record for a registered or pending trademark (for e.g. Form TM-M is filed for a registered trademark or Form TM-P is filed for a pending trademark) the same should be condoned without requiring the agent to pay the fee afresh or without rejecting the request and necessitating re-filing.)</p>	<p>Request needs to be made as per prescribed procedure, as the same is related to change in register details.</p>
14	<p>The Office should plan and communicate steps it will take to resolve the trademarks opposition and rectification backlogs;</p>	<p>Clearance of Pendency is taken stage- wise. By the end of March, 2018, the pendency , except show-cause and opposition, will be set down to nil. In the next FY, the Office will target the clearance of pendency in such area.</p>
15	<p>Opposition: In opposition proceedings, evidentiary timelines are as follows: - Rule 45 (Evidence in support of Opposition) (Time period - 2 months from service) - Rule 46 (Evidence in support of Application) (Time period - 2 months from service) The additional extension of 1 month for each of the above stages has been done away with. The current prescribed time is generally insufficient to file evidence. Along with the date of release of the Journal, the opposition deadline may also be indicated. This would resolve controversies regarding months having 28/29, 30 or 31 days. Also, the Registry’s servers often hang starting around 1-2 pm on the deadline day and we have to call the Registry to have this sorted. Thus, the hardware infrastructure may be suitably strengthened.</p>	<p>For smooth functioning of the system, such limit is prescribed. It may be noted that Four months’ time does not vary in accordance with the days in the month.</p>
16	<p>SMS vs email communication/service (The Registry is requested to follow one mode of communication as communication on multiple platforms creates problem in docketing deadlines.)</p>	<p>Communication through email only; SMS alerts are only for information.</p>
17	<p>Address for service in International Registration (For the sake of clarity, the Registry is requested to indicate if filing a request for coming on record as agent will have any benefit for attorneys handling International registrations designating India. For instance, will further communication (such as hearing, advertisement, grant of protection, etc.) pertaining to such IR be directed to attorneys on record in India or will such for communication still</p>	<p>Address of service is important for communication related to pending proceedings in opposition or show cause hearing.</p>

	be directed to WIPO?)	
18	The service of documents is ad hoc and electronic communications are not being sent for all matters. Examination reports and hearing notices are often uploaded online, however electronic intimations are not sent to the concerned applicants and agents. The Office should take steps to standardize the practice of sending electronic communications in all such matters.	If the office compliance is made before sending of the communication by the applicant on the basis of details available on website, communication is not sent in the matter.
19	E-filing does not give us an opportunity to upload miscellaneous letters online such as withdrawal letters or follow up letters, supplementary or additional response to examinations, etc.)	E-filing facility includes reply related to formality check fail and reply to examination report. Facility related to uploading of withdrawal letter is being provided. No facility required for letter not related to application processing
20	Certain minor issues are requested to be ironed out in the e-filing module. For instance, (i) in the amendment module relating to TM-M and TM-A, there is a character restriction which affects inclusion of lengthy names and specifications of goods, (ii) in case of LLP applications, partner names are still required whereas the law does not require the same.	Specific issue may be provided. No limit exists relating to specification of goods. Requirement of partner details in LL.P is not compulsory.
21	Well-known trademarks vs. trademark with reputation (The Registry is requested to clarify the distinction between well-known trademarks and trademark with reputation. While the Act provides for definition of well-known trademark, no such express meaning has been given to trademark with reputation. The two are distinct concepts.)	A well Known TM is clearly defined in TM Act under section 2 (1) (zg). As far as concept of trademark with reputation is concerned, the same depends upon the interpretation on case to case basis.
22	Issue related to Well-Known Trademark (a) Clear definition (b) Protection across the class and process and (C) Fee	Well-Known TM is already defined under TM Act, 1999. Restriction is imposed on registrar against refusal of such mark under section 11(5) of TM Act, 1999.
23	Applications for 'well known' trademarks are not being examined and there is no progress since their filing before the Trademark Registry. Urgent action requested.	Concerns taken note of. All representations made before 06/03/2017 are disposed of. Scrutiny is completed in all 41 applications

		received by 30/11/2017 and further process will be completed expeditiously. A detailed notice is made available in relation to processing of such application at: http://www.ipindia.nic.in/newsdetail.htm?333/
24	That, once a trade mark is registered/declared as well known trade mark then the Registrar should not take anybody else's application in this connection for any class then it will be useful to register as a well- known trade mark.	A very clear statutory provision in this regard is under Trade Marks Act, 1999 and, the same cannot be overruled.
25	IRDI examination/objection Files. (No update is found in the site after filing response. No indication whether or not response has been considered, or whether application is refused, or hearing is being offered. Corrective action may please be taken to get over this problem/shortcoming of the site.)	Pendency before hearing stage is getting clear. The issue will have no relevance.
26	The Madrid Protocol has provisions for transformation of an International Registration into a national or regional application and specifically provides that each contracting party to the Madrid Protocol shall determine the modalities for giving effect to such transformation.	Amendment in TM Act, 1999 required for the same, which is under consideration.
27	There is no provision for filing Divisional Application for IRDI Applications . Several other contracting parties to the Madrid protocol have made provision for division of an application filed under Madrid protocol. We submit that similar provisions be made in India also.	Amendment related to IR application can be filed to WIPO only. This office has no role to play.
28	In an International Registration Designating India (IRDI), applications are filed on an 'Intent to Use' basis and no provision to claim use is available . It is requested that that the Office look into this issue and provide clarification;	No such provision exists under Indian statute.
29	It is requested that the Office should provide clarity on permitting and handling of amendment of trademarks filed via the Madrid route . WIPO does not have a provision to amend trademarks and expects that the National Office attend to the amendments of a trademark (if required) as per their local law;	Current legal provisions do not permit amendment of trademarks.
30	It is requested that under the provisions governing Madrid Protocol applications, processes be included for addressing applications for transformation and replacements, which are currently not available;	Amendment in the Act is under consideration.

31	<p>In case of oppositions being filed against published/advertised Madrid designations in India, some oppositions have not been taken on record, allowing the designation to proceed to grant It is requested that the Office should look into such cases;</p>	Details may be provided for specific response.
32	<p>Madrid applications: The Official fee has undergone a significant change and subsequent to the amendment in the Trade Mark Rules, the filing fee is now INR 10,000 and 9,000 (for e-filing). However, the change has not been made for international registrations designating India and the official fee there is still INR 4000. There should be parity on this front and official fee may be revised for Madrid applications as well; Transformation: Although the Act and the Rules make available provisions for transformation of an International Application – [Section 36E (8) and Rule 71], currently, there are no laid down procedures for the same. Such procedures should be clarified and laid down.</p>	New fee is already notified. WIPO website may be referred.
33	<p>In case of applications designating India under the Madrid Protocol, the Office should clarify how it intends to handle opposition documents (especially affidavits under Rule 50/51/52);</p>	Clarification will be issued after examining the legal provisions
34	<p>video conference : Hearings over video conference</p>	Under consideration.
35	<p>A consolidated post registration recordal request in respect of more than one trademark is only uploaded against the first trademark and not in respect of the subsequent trademarks. This creates a practical difficulty in following up of the recordal in respect of the subsequent trademarks and also for filing a request for further changes in respect of the subsequent trademarks. We request that the Database be equipped to upload a copy of the request against all the trademarks involved.</p>	Your suggestion is taken note of and appropriate action will be taken in this regard.
36	<p>Current e-TMR Comprehensive Filing System be upgraded with a facility giving a page / window / tab where every attorney / agent could see those trademark applications live which is carrying any new communication / notification or change of status of a trademark.</p>	Suggestions will be considered for further development of e-filing system.
37	<p>For multiple offices or attorneys under a firm, we need to create multiple Login Credential Creation and adoption of multiple DSC. A system may be developed enabling an attorney to give separate access to his I'd as maker who can see the details or create new detail at their end and final submission to the system may be made by the principal / officially authorized person. Such works done by any other staff member must show who has done it.</p>	