

**ISSUES RAISED AND SUGGESTIONS RECEIVED IN STAKEHOLDERS' MEETING
HELD ON 03-08-2018 AT IPO DELHI**

PATENT OFFICE

SL. NO.	ISSUES RAISED BY STAKEHOLDERS	SUGGESTIONS RECEIVED	RESPONSE OF OFFICE OF CGPDTM REGARDING STEPS TAKEN
	(A) E-FILING, E-COMMUNICATION , UPLOADING OF DOCUMENTS AND WEBSITE-RELATED ISSUES		
1	E-mail communication <ul style="list-style-type: none"> • FERs are not being intimated/notified to applicants (and Agents) due to which several applications have been erroneously abandoned. • Backdated FERs are often received by e-mail • LPD documents/notifications are not reaching the applicant/ Agent due to errors at IPO's end after patents are allowed. 	<ul style="list-style-type: none"> • This error should be fixed in the IPOs computer systems. • A specific person should be designated by IPO for attending to the cases that are getting erroneously abandoned 	IT Support Cell is already functioning to provide necessary help and resolve the problems. Such errors on the part of IPO are reduced to less than 1%. Applicants need to ensure that e-mails from IPO do not go into their Spam account. Specific instances when brought to notice are immediately acted upon and necessary action taken.
2	Online filing and uploading of documents <ul style="list-style-type: none"> • Sequence Listing uploading in txt format is not available • Online module does not provide for filing of formal drawings after filing Indian Patent Application/ prior to responding to first examination report. • Foreign filing authorizations • Certified copy not available online 	<ul style="list-style-type: none"> • Facility to upload sequence listing in txt format to be provided in Form-30 and for uploading as a separate txt document along with response to FER and Written Submission • Online module should have entry for filing formal drawings prior to responding to FER • Foreign filing authorization and Certified copy should be made available online. 	These issues will be resolved once IPO-2 version of patent database is implemented, which is under development
3	Module and IPO website related issues <ul style="list-style-type: none"> • Documents do not have any discernible nomenclature/ chronology/ sequence. • Cause list indicates hearing date and time but hearing notice not issued / not visible on IPO's website • Granted patents do not accompany the final set of claims. • Dynamic FER view Utility is displayed by "groups and locations" 	<ul style="list-style-type: none"> • IPO's document retrieval system should be updated to categorize/ classify documents that are uploaded on the Patent Office website (e.g., by Type, Chronology etc.) to improve accessibility. • Granted patents should accompany the final set of claims • There should be one single table listing out 	

	<p>creating a total of 16 hyperlink cells in a tabulated format. Each cell link has to be clicked open which leads to a series of separate pages.</p> <ul style="list-style-type: none"> • There is no mechanism by which we can track and determine the status of post-grant amendments. 	all the cases with group, location, etc., in columns	
4	<p>FORM 30 :</p> <p>Drop down list for activities/documents to be uploaded under Form 30 does not cover certain “necessary” activities. For example,</p> <ul style="list-style-type: none"> • An option for follow-up communication with the Controller after filing of response/written submission of hearing. • Functionality to upload sequence listing in txt • LPD Correction Request. 	Options under Form-30 should be provided	Suggestions are under consideration
5	<p>Entity Type Selection Option:</p> <ul style="list-style-type: none"> • Due to incorrect entity type in the e-Filing module, a lesser official fee is reflected as compared to a higher official fee payable by a large entity. • Entity type selection option is not available under extension for response filing (Form 4), adjournment of hearing, Form-8, Rule 94 etc. 	<ul style="list-style-type: none"> • Correct entity type in the e-Filing module should be provided under all actions where fee is payable including for Extension for response filing (Form 4), adjournment of hearing, Form-8, Rule 94 etc. 	Under process
	B) PROCESSING OF APPLICATION , HEARING, VIDEO-CONFERENCING		
6	<p>Documents Required From Foreign Entity For Claiming Small Entity Status not specified. The Patents Rules simply mention “<i>In case of a foreign entity: Any other document</i>” in the Form-28.</p>	<p>Clarification is required regarding document to be submitted by a foreign entity for claiming Small Entity status(MSME)</p> <p>Balance sheet may be accepted as a proof in place of certificate.</p>	<p>Any other document <u>means</u> the financial statement showing foreign company’s annual turnover (<i>which complies with the provisions stipulated under MSME Act 2006 of India</i>)</p>
7	<p>Secrecy directions:</p> <p>Delay in processing of patent application and its scrutiny for issuing direction of secrecy</p> <p>According to Section 39, it gives 6 weeks waiting time to the applicant for filing similar patent outside India. Post completion of 6 weeks, the applicant assumes such express permission is not required (under section 39) and if secrecy directions not issued</p>	<p>The patent office is supposed to check the invention filed in India (provisional / complete) within 6 weeks and issue instruction if found to be related to defence / atomic energy</p>	<p>Issued within the stipulated time-limit in most cases, unless there is some problem in the application.</p> <p>Any specific instance may be brought to notice.</p>

	by then, he may file patent application outside India. This delay in issuing secrecy direction defeats the very purpose of putting application on secrecy direction u/s 35 of the Patent Act.		
8	<ul style="list-style-type: none"> • Inconsistency and procedural issues exist in case of formal and technical examination amongst all four Patent Offices. • All four patent offices do not follow same procedure for Formal Examination, for example, cases where petition is required. • Objections raised under Section 3 to be made consistent. Also, monoclonal antibodies being rejected under etc. 	There is a need to bring in consistency in case of formal and technical examination amongst all the four Patent Offices. Section 3 objections require to be made consistent. Guidelines on formality are required.	Objections under section 3 are raised as per legal provisions. Examiners/ Controllers have been directed to follow uniform practice. However, specific cases may be brought to notice.
9	<p>Examination of CRIs:</p> <p>One of main objectives of guidelines for examination of computer related inventions (CRIs) was to bring in uniformity and consistency in standard in examination of CRIs among four Patent Offices in India. However, we still observe lack of uniformity and consistency in examination of patent applications in the field of CRIs among four branches of patent offices. While one branch of patent office only grants "apparatus/ system/ device claims", other patent office grant only "method claims".</p>	There is a need to resolve this lack of uniformity and inconsistency among four branches of the Patent Office.	Latest Guidelines on CRI issued by the office are clear in this regard.
10	<p>Multiple Extensions under Rule 24 B(6):</p> <p>Do multiple extensions for filing of the response to FER is allowed under Rule 24 B(6) of the Patents Rules, 2003 (as amended) e.g. by three requests for one month each? Or extension can be taken only once?</p>	Clarification is required as to whether such multiple extensions for filing of the response to FER is allowed under Rule 24 B(6) .	Up to three months' extension can be taken only once.
11	<p>Filing priority documents:</p> <p>There is a need of clarification whether Applicant need to submit a petition for filing priority documents and verified English translation within three months from the invitation for the same by the Controller under Rule 21 of the Patents Rules, 2003 (as amended).</p> <p>In many instances, the Controllers demand petition along with prescribed official fees from the Applicants even if they comply with the requirement by filing said documents within three months from the date of invitation by the Controller.</p>	A clarification needs to be provided.	Circular already issued. Specific instances may be brought to notice

12	<p>HEARING:</p> <p>a) Hearing notices are issued without giving adequate time as required by the Patent Rules in several instances</p> <p>b) Hearing notices are not received and the application is treated as abandoned or refused, if the hearing is not attended</p> <p>c) Hearings are pending in respect of post grant matters and review petitions</p>	<p>a) Sufficient time should be given for hearings and adjournments</p> <p>b) Except in cases where an applicant has specifically indicated that the hearing will not be attended, a second opportunity may be given.</p> <p>c) Necessary action required regarding pending hearings in post grant matters</p>	<p>Circular has already been issued to give sufficient time for hearing and adjournment</p> <p>Agents/applicants need to ensure that e-mails from IPO do not go into their spam account.</p> <p>Depending upon the workload in FER, amended cases and post-grant matters, hearings are appointed by Controllers. However, specific cases may be brought to notice.</p>
13	Availability of extension for filing of the hearing submission within 15 days from the date of hearing as per Rule 28 (7) of the Patents Rules, 2003 (as amended).	Rule 28(7) is not covered under exception to Rule 138, therefore, extension of one month for filing of hearing submission should be available.	Extension can be availed, if there is due justification.
14	Video Conference Link / Notification does not have the patent application number making it difficult to determine the patent application for which it pertains to.	It would be extremely efficient if the video conferencing notifications mention the "Application Number."	Already provided
15	Recordal of Assignment for Granted Patents (Form-16): Even when Patent Assignment, duly executed by the parties, which clearly evidences the Proof of Title, is submitted at the IPO along with the requests (Form-16), Chennai IPO and Kolkata IPO invariably ask for multiple other documents, such as any previous contract, agreement, etc.	For the purposes of recoding at the IPO, the Patent Assignment as per Section 68 should meet the requirements.	Specific instances may be brought to notice
16	Objection with respect to e-filed document not being physically signed is raised quite often in the FERs. Where the document/form is e-Filed, it is already digitally signed and then only it gets transmitted into the IPO's module.	There should be no requirement for physical signature in ink by hand for such documents or forms which are e-filed using digital signature.	Specific instances may be brought to notice
17	Proof of rights documents are required to be filed as per Section 7(2) of the Patents Act read with Rule 10 of the Patents Rules, 2003 (as amended) within six months of filing of Indian Patent Application. However, a few Controllers refused to take on record such proof of rights documents executed after national phase entry.	There is a need to issue necessary clarification in this regard.	Specific instances may be brought to notice for need of issuing such clarification, as rules are very clear in this regard.

18	Section 8(1): Many Controllers demand petition to be filed if updates, in the sense of status change of the foreign application, details of which have already been filed in the patent office, are not filed within six months of such status change.	Procedure under Section 8(1) requires updates	Provisions of section 8 and Rule 12 are clear in this regard .
19	Section 8(2) Requirements: Access to search and examination reports of countries participating in WIPO CASE, which include all major patent offices that conduct substantive examination is now available to IPO. Despite the above facility, still in many cases, copies of search and/or examination reports are being demanded without specifying the countries for which such reports are to submitted, sometimes from all the major patent offices.	It is recommended that, while demanding documents under Section 8(2), name of specific country is indicated in FER	
20	Express request for examination under PCT National phase: There is no separate mechanism for examination of national phase of PCT application where express request for examination under Rule 20(4)(ii) of the Patents Rules, 2003 (as amended) has been filed. Lack of any separate mechanism renders this provision redundant despite the fact that Applicants pay additional fees to avail benefit of this mechanism.	Does express request actually results in faster processing of national phase of PCT application as mentioned in the aforementioned rule?	Yes; applicant needs to file Request for expedited examination in Form 18 under Rule 20 (4) (ii) of patent Rules.
(C) OPPOSITION PROCEEDINGS			
21	It is very difficult to track/view an opposition, if any, filed against a patent/patent application. Additionally, Pre-grant oppositions remain unserved on the applicant for years. The Patent Office should come out with a process for more transparent and robust handling and tracking of oppositions	<ul style="list-style-type: none"> • A separate option for “opposition” documents should be made on the IPO portal. • Status of the patent/patent application should indicate if an opposition is presently pending to enable tracking the status or progress of oppositions • Time bound disposal of pre-grant oppositions. 	Separate module for opposition is under development
(D) OTHER ISSUES			
22	FAQ with regard to Start-up , NBA and TKDL related issues will be helpful.	FAQs should be made available	Stakeholders are requested to submit a list of FAQs based upon the common queries they receive from clients and which they would like the office to include in the proposed FAQs.

23	User satisfaction survey on quality of examination (concept borrowed from Japan) Inputs sought from stakeholders may also include various know-how/methods/techniques of conducting search, improve quality, knowledge sharing sessions, etc.	Conduct user satisfaction survey on quality of examination	Creation of a separate window in the IPO website for facilitating User satisfaction survey on quality of examination is under consideration.
TRADE MARKS			
	(A) E- FILING		
1	Applicants cannot directly make payment of statutory fee on IP India e-Filing portal. Payment can only be made through agent/attorney's account.	To further government's policy of Ease of Doing Business, the payment may be permitted by the applicants	At present, statutory fee on IP India e-Filing portal can be paid by the agent/ applicant who is submitting the application.
	(B) EXAMINATION AND DISPOSAL PROCEDURES		
2	Refusal of user amendment request : TMR is not allowing any user amendment request	User amendment request should be allowed as the same is directed by Delhi HC through decision	Delhi HC through decision has directed to decide the request on case to case basis and no administrative direction can be issued in this regard. It is not feasible to provide hearing in all such requests. However, only those matters are refused where sufficient supporting documents are not provided.
3	No request related to registered user is being processed	Processing registered user request	Preparation of Module for the purpose is under process
4	First Examination Report to include all objections and no new objections to be raised at the time of hearing.	The issue should be resolved	Subsequent objections during examination are raised when specifically noted by the examiner or in subsequent proceedings, as may be required by law
5	INN is not checked during examination.	Should be properly checked in reference to class 5 in examination	It is regular practice to check INN while examining under class 5. However, any specific case may be brought to notice.
6	Expedited application – Request for expedited application can be filed online only if it is filed immediately after filing the new application. Once the application is processed further then the request cannot be e-filed.	The request for expedited application should be allowed to be filed at any stage	Not feasible to open expedited proceedings after application is processed.

7	Practice by TMR in show cause hearing is inconsistent related to interpretation of law	uniform practice is required	Regular basis training is being provided to all concerned hearing officers so as to bring consistency in the proceedings.
8	Process of declaring a trademark well-known by courts (is) inconsistent with Rule 124, Trade Mark Rules 2017.	Rule 124 requires Registrar to invite objections from general public before declaring a trademark well-known	Rule 124, Trade Mark Rules 2017 is very clear in this regard
9	Request for processing of Well-known Trade Mark cases are not streamlined.	Clarification regarding procedure to be provided.	Circular for filing of request for Well-known Trade Mark has already been issued and guidelines for processing such requests are issued.
10	Request for Amendment is refused without any hearing.	Request should not be refused without hearing	It is not feasible to provide hearing in all such requests. However, only those matters are refused where sufficient supporting documents are not provided.
11	Video Conferencing in TMR	Video Conferencing in Trade Marks should be implemented	Under trial
12	Conversion of class from 42 to 43, 44, 45 are not yet done, due to which trademark search does not reveal the correct information unless search is conducted in class 42	Create an appropriate module for change of class and accept requests which have been filed	Specific issue where conversion request is pending may be brought to notice
13	<p>Division of application:</p> <p>Rule 42(2) of the Trade Marks Rules, 2017 clearly states that where in respect of a single application for the registration of a trade mark no notice of opposition is filed in a class or classes, the application in respect of such class or classes shall proceed to registration after the division of the application in the class or classes in respect of which an opposition is pending.</p> <p>However, as per the module of the Trade Marks Registry the divisional application has to be filed for the classes which are unopposed.</p> <p>Due to such discrepancy and not any clear guidelines, such matters where the divisional applications have been filed for the opposed classes, are still pending and are a cause for the Attorneys as well as the Applicants.</p>	Procedure for registration of divisional applications should be streamlined.	Provisions under Rule 42(3) of Trade Marks Rules 2017 are clear in this regard
14	Withdrawal of applications by Trade Marks Registry after allowing the mark at a show cause hearing	The practice is not desirable	If any mark is inadvertently accepted for registration, the same may be withdrawn by the Registrar under section 19 of the Trade

			Marks Act, giving opportunity of hearing to the applicant before taking final decision.
15	Problems pertaining to post registration matters: Refusal orders are sent even after filing the required documents. TMR Chennai is not handling post-registration matters.	The issue should be resolved without delay	Appropriate action is being taken and pendency has reduced substantially. Any specific matter may be brought to notice.
16	Unnecessary comment exists in the certificate that "cannot be used for legal purpose"	The comment should be deleted	Not possible to delete the comments in view of future legal repercussions
17	Registered trademarks which have not been renewed continue to remain on the Register for years and are cited as conflicting marks during examination of applications	The issue should be resolved without delay.	Concern noted. Appropriate action will be taken.
	(C) OPPOSITION AND POST – REGISTRATION PROCEEDINGS		
18	Wrongly service of documents to Attorney of Applicant In cases where a settlement agreement has been entered by the two parties in an opposition matter and the same has been communicated to the Registry, notice of opposition should not be served to Applicant. If served by mistake, immediate action should be taken. In absence of which, Applicant as well as the Opponent has to unnecessary file counter statements as well as take action under Rule 45-47 just to save the Applicant/Opposition which put unnecessary pressure on both the parties.	Such notice of opposition should not be served to Applicant. If served by mistake, immediate action should be taken.	Noted
19	Amendment of specification of goods/services during opposition may lead to speedier dispute resolution and reduction in pendency	Permit amendment of specification of goods/services during opposition	Already exists in the system
20	Fee for each class opposed or counter-statement filed. In the first schedule of the Trade Marks Rules, 2017 it's clearly mentioned that the fee has to be paid for each class opposed or counter-statement filed. Whereas the module of the Indian Trade Marks Registry doesn't allow to pay the fee for each class. It takes the fees for one class only. In view of above, we are filing the counter statement via physical copy which is putting extra financial burden as well as is time consuming.	Necessary facility should be provided	Opposition needs to be filed according to the class; however counter statement is filed according to each opposition and not according to each class

21	Many cases of frivolous oppositions being filed causing unnecessary delay in proceedings – scrutiny will help in filtering out oppositions that are not <i>prima facie</i> maintainable.	Provide for pre-admission scrutiny in opposition (concept akin to Summary suit under CPC / Commercial Courts Act).	Pre-admission scrutiny in opposition is not provided in the TM Act and Rules
22	Orders passed by officers are not uploaded on IP office website/ docketed against respective applications in the E-Register.	Orders passed by officers should be uploaded on IP office website/ docketed	Already provided
	(D) Madrid Protocol		
23	No form is available for claiming use in Madrid application designation India. As per our discussion with WIPO the Indian Trade Marks Registry would be required to draft a form and submit it with WIPO so that the option of claiming use can be made available. Form MM18 is being used in USA.	Form and procedure needs to be created by Indian IPO	Provision not provided through Madrid. User claim can be made by filing TM-M
24	Hearing in International matters- Hearings in international matters are being held at Mumbai Trade Marks Registry only. However, Section 36C states that an international application shall be dealt with by the head office of the Trade Marks Registry or such branch office of the Registry, as the Central Government may, by notification in the Official Gazette, specify.	Such hearings should be conducted by the branch offices as the above stated situation is putting undue financial pressure on Attorneys as well as Applicants.	Noted. Video-conferencing facility will also be provided for this purpose.
DESIGNS			
1	<p>Online filing -Technical Issues:</p> <p>Application forms drafted using the online portal are non-editable. In case of any amendments/changes in the form, a fresh form is to be created each time.</p> <p>The fee receipt issued for online applications does not mention the sub-class in which the article has been classified.</p> <p>The online portal of the Design Office can only be used for filing of an application and applying for certified copy of an application. Other forms are not available.</p> <p>In case when applications are filed online, objections are raised to submit original application form and representations, thereby, duplicating efforts and increasing timelines.</p> <p>Any amendments/assignments made in the design post-registration are not reflected on the online portal.</p>	Problems in online filing should be removed	Module is being updated to resolve these issues.

2	No provision for start-up applicant in design applications.	Start-up as applicant should be provided in designs	Facilitation for Design applications filed by startup is provided under SIPP scheme.
3	Clarification required on acceptance of Graphical user Interface (GUI) Applications- Examiner/Controller does not grant protection to GUI in class 14-04 which includes (screen displays and icons). It may be noted that class 14-04 is specifically included in the classification of the Designs Act.	Clarification required on acceptance of GUI Applications In view of era of Information Technology, clear guidelines need to be issued for the protection of GUI under the Indian Designs Act, 2000.	Applications are examined as per provisions of Designs Act and Rules made thereunder and necessary action is taken. Specific instances , if clarification is required , may be brought to notice.
COPYRIGHT			
1	<p>Currently, we do not get acknowledgment/ timely response from Copyright office (especially in the case of code copyrights). In many cases, response received from copyright office after a long gap and asking to re-submit copyright work without providing clarity on what happened to the earlier submitted work.</p>	<p>We suggest IPO to bring certain efficiency and transparency measures (currently in place for patents and trademark) for copyrights as well</p>	<p>Now, it is very rare, that too under specific circumstances, where works are not available on our record and the applicants are requested to resubmit the work</p> <p>The Copyright Office has taken various steps to reduce the pendency of applications and accordingly, the pendency has been reduced to one month excluding the mandatory waiting period of one month. In order to increase transparency and stakeholder's participation, the Copyright office has started to display the applications received on its website on a monthly basis. The applicants can also track the status of their application online.</p> <p>Further, the Discrepancy Letter and the Register of Copyrights (R.O.C) are now being transmitted to the Applicant via emails registered on: www.copyright.gov.in.</p> <p>The applicants can also upload their response against the discrepancy letter by using their Copyright login account. Copyright Office has also published the Practice and Procedure Manual for examination of Literary, Artistic, Musical, Sound Recording and Cinematograph Films.</p>

2	Data in general may not be subject to copyright protection - but in the context of AI, can processed/ labeled/ classified data used for training/ testing/ tuning AI models be protected by copyright?	We suggest IPO to provide explicit clarification on whether "processed" data used in AI context is copyrightable	The Copyright Act, 1957 protects only original literary works which includes database. If any work qualifies the pre requisites as provided under the Act then it may qualify for copyright protection.
3	Copyright – Searchable data is not available	Searchable data should be there	The suggestion given by stakeholders is well taken. The Copyright Office during the last one year is providing the details of the copyright registration application received in the office on the official website of the Copyright Office on regular basis to facilitate for stakeholders information and providing them an opportunity to file an objection if any before the Registrar of Copyrights. Preparation of database for past copyright register for search purpose is under consideration.